

Appl Berzins Specialty Bakeries v Monty's Continental Bakery (Vic) 15 FCR 402
Appl Quaker Oats Co, Re application by 14 IPR 481
Appl TGI Friday's of Minnesota v TGI Friday's Aust (1999) 48 IPR 65
Appl Clixby v Weston 93 FLR 7
Foll Mid Sydney Pty Ltd v Aust Tourism Co Ltd (1998) 42 IPR 561
Appl Benetton Group SpA, Re Application by 41 IPR 198
Appl Retail Nurserymens Products Co-op Ltd, Re Applications by 9 IPR 255
Appl Berzins Specialty Bakeries v Monty's Continental Bakery (Vic) 12 IPR 38
Appl JGL Investments Pty, Re Application by 13 IPR 347
Dist Advanced Hair Studio of America v Registrar of Trade Marks 10 IPR 583
Foll Advanced Hair Studio of America v Registrar of Trade Marks 12 IPR 1

190 HIGH COURT [1956.]

Foll Bowen v Koor Inter-Trade (Asia) Pty Ltd 15 IPR 252
Cons Springs Industries Inc, Re Application by (1991) 23 IPR 188
Appl Kolotex Glo Australia Pty Ltd v Sara Lee Personal Products (1993) 26 IPR 1
Appl Johnson & Johnson Aust Pty Ltd v Sterling Pharmaceuticals (1991) 30 FCR 326
Appl Johnson & Johnson Aust v Sterling Pharmaceuticals (1991) 101 ALR 700
Cons/Dist Corvina Quality Foods Pty Ltd, Re Application by (1991) 22 IPR 113
Appl Johnson & Johnson Aust v Sterling Pharmaceuticals (1991) 21 IPR 1
Cons/Dist Corvina Quality Foods Pty Ltd, Re Application by (1991) 22 IPR 66
Appl Trade Marks, Registrar of v Muller (1980) 144 CLR 37
Dist/Foll Sterling Pharmaceuticals Pty Ltd v Johnson & Johnson Aust 96 ALR 277
Foll RA & A Bailey & Co Ltd v Boccaccio Pty Ltd 6 IPR 279
Appl Levi Strauss & Co v Wingate Marketing Pty Ltd (1993) 116 ALR 298
Foll Levi Strauss & Co v Wingate Marketing Pty Ltd (1993) 116 ALR 298
Appl Paragold Distributors Pty Ltd, Re Application by (1993) 26 IPR 307
Appl Ziff Communications Co, Re Application by (1993) 26 IPR 601
Appl Pumps 'N' Pipes Pty Ltd, Re Application by 18 IPR 378
Dist/Foll Sterling Pharmaceuticals v Johnson & Johnson Aust 18 IPR 309
Appl Hans Continental Smallgoods Pty Ltd, Application by, Re (1993) 27 IPR 412
Appl Carnival Cruise Lines Inc v Simar Cruises Ltd (1994) 120 ALR 495

[HIGH COURT OF AUSTRALIA.]

Appl Kettle Chip Co Pty Ltd v Apand Pty Ltd (1993) 46 FCR 152
Appl Tansing (t/as Apple Music) v Musidor BV (1993) 28 IPR 111
Appl/Dist Armor All Products Corp v CRC Chemicals Aust (1993) 28 IPR 77
Appl Conde Nast Publications Pty Ltd v Mango Pty Ltd (1994) 28 IPR 374
Appl Nexoft Corporation, Application by, Re (1994) 28 IPR 427
Appl Musidor BV v Tansing (t/as Apple Music House) (1994) 29 IPR 203
Appl Mid Sydney Pty Ltd v Australian Tourism Company Ltd (1998) 40 IPR 20
Foll Effem Foods Pty Ltd v Unilever plc (2000) 50 IPR 627

MARK FOY'S LIMITED
PLAINTIFF,

AND

APPELLANT ;

DAVIES COOP AND COMPANY LIMITED
AND ANOTHER
DEFENDANTS.

RESPONDENTS,

ON APPEAL FROM THE SUPREME COURT OF
NEW SOUTH WALES.

Cons SA Brewing Co Pty Ltd v Carlton & United Breweries (2001) 53 IPR 90

H. C. OF A. Trade Mark—Infringement—Word mark—"Tub happy"—Registered in respect 1956.
SYDNEY,
April 12, 13 ;
Aug. 9.

Dixon C.J.,
Williams and
Kitto JJ.

Section 16 (1) of the Trade Marks Act 1905-1948 provides:—"A registrable trade mark must contain or consist of at least one of the following essential particulars— . . . (d) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname."

Held by Dixon C.J. and Williams J., Kitto J. dissenting, that the words "tub happy" being in the nature of a coined phrase with but the remotest reference to the character or quality of articles of clothing were validly registered as a trade mark in respect of such articles.

Section 50 of such Act provides:—" . . . the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of the trade mark upon or in connexion with the goods in respect of which it is registered . . ." whilst s. 53 provides: "The rights acquired by registration of a trade mark shall be deemed to be infringed by the use, in respect of the goods in respect of which it is registered, of a mark substantially identical with the trade mark or so nearly resembling it as to be likely to deceive . . .".

Held by Dixon C.J. and Williams J., Kitto J. expressing no opinion, (1) that the exclusive right given by s. 50 is an exclusive right to the use of the trade

Cons Musidor BV v Tansing (t/as Apple Music House) (1994) 52 FCR 363
Appl Choice Hotels International Inc, Re Application by (1994) 31 IPR 89
Foll Kettle Chip Company Pty Ltd v Pepsico Australia Pty Ltd (1995) 132 ALR 286
Dist/Apl Wella Aktiengesellschaft v Registrar of Trade Marks (1995) 33 IPR 374
Appl/Foll Top Heavy Pty Ltd v Killin (1996) 34 IPR 282
Refd to Eutectic Corporation v Registrar of Trade Marks (1980) 1A IPR 550
Appl Zeneca Ltd v Sanonda (Australia) Pty Ltd (1998) 41 IPR 587

Expl Powell v Glow Zone Products Pty Ltd (1996) 36 IPR 343
Appl Qantas Airways Ltd v Chandru International Pty Ltd (1998) 41 IPR 182
Appl Sara Lee Corp v My Size Pty Ltd (1998) 42 IPR 245
Appl Mid Sydney Pty Ltd v Australian Tourism Company Ltd (1998) 40 IPR 20
Foll Koninklijke Philips Elect v Remington Products Aust (1999) 44 IPR 551
Cons Unilever Aust Ltd v Karounos (2001) 52 IPR 361

mark as a trade mark ; (2) that s. 53 is an appendage to s. 50, its function being to widen the definition of infringement so as to include cases where the mark used is not the registered trade mark but one substantially identical with it or so nearly resembling it as to be likely to deceive ; (3) that the rights of a registered proprietor are infringed only where the use complained of, whether it be of the mark itself, or of a mark substantially identical with or so nearly resembling the registered mark as to be likely to deceive, is used as a trade mark.

Irving's Yeast-Vite Ltd. v. Horsenail (1934) 51 R.P.C. 110, applied.

Decision of the Supreme Court of New South Wales (*McLelland J.*), reversed.

H. C. OF A.

1956.

MARK
FOY'S
LTD.

v.
DAVIES
COOP
& Co.
LTD.

APPEAL from the Supreme Court of New South Wales.

On 15th October 1954 Mark Foy's Ltd. issued out of the Supreme Court of New South Wales in its equitable jurisdiction a statement of claim against Davies Coop & Co. Ltd. and Davies Coop (New South Wales) Pty. Ltd. seeking injunctions to restrain them (a) from infringing the plaintiff's registered trade mark No. 103308 dated 25th July 1950 registered in class 38 in respect of articles of clothing and consisting of the words "Tub Happy", (b) from advertising, offering for sale, distributing for sale and selling articles of clothing not being goods of the plaintiff under such trade mark or any trade mark or name which includes the words of such trade mark, and (c) from applying the words of such trade mark to any articles of clothing not being goods of the plaintiff.

The plaintiff moved in the suit for an interlocutory injunction which came before *McLelland J.* for hearing, when by consent the motion for injunction was turned into a motion for decree. *McLelland J.* dismissed the suit upon the ground that the acts of the defendants, of which complaint was made, amounted only to using a bona fide description of the character or quality of their goods within s. 53A of the *Trade Marks Act* 1905-1948 and accordingly was not an infringement of the mark.

From this decision the plaintiff appealed by special leave to the High Court.

The relevant facts and statutory provisions are fully set out in the judgment of *Williams J.* hereunder.

H. W. May (with him *G. B. Thomas*), for the appellant. The mark "tub happy" is entitled to registration under s. 16 (d) of the *Trade Marks Act* 1905-1948. The words convey no distinct impression and are not apt to describe any character or quality of articles of clothing. As to infringement the *Trade Marks Act* 1905-1948 gives to the registered proprietor of a trade mark, subject only

H. C. OF A.
1956.
MARK
FOY'S
LTD.
v.
DAVIES
COOP
& Co.
LTD.
—

to the express limitations contained in the Act, a virtual monopoly to the use of the words upon or in connection with goods. The *Trade Marks Act* 1905 (Cth.) was based on the Imperial Act of 1888 and not that of 1905, and the presence in our original Act of the first half of s. 53, which has no counterpart in the English Act, distinguishes the law of infringement in Australia from that applicable in England. Where identity is involved and a person other than the registered proprietor uses the actual word mark upon or in connection with goods, such user is sufficient to constitute infringement unless it can be shown that the user is a bona fide description of the character or quality of the goods in respect of which he uses them. It is unnecessary for the user to be in a trade mark sense under our Act. The origin of the doctrine in England that user must be in a trade mark sense is to be found in *Edward Young & Co. Ltd. v. Grierson Oldham & Co. Ltd.* (1). [He referred also to *J. B. Stone & Co. Ltd. v. Steelace Manufacturing Co. Ltd.* (2); *Irving's Yeast-Vite Ltd. v. Horsenail* (3).] Sections 50 and 53 are to be read together. The judgment of Lord Tomlin in the *Yeast-Vite Case* (4) would have been different had the legislation there in question contained a provision similar to s. 53. [He referred to *Bismag Ltd. v. Amblins (Chemists) Ltd.* (5); *Wrigley's (Australasia) Ltd. v. Life Savers (Australasia) Ltd.* (6); *James Minifie & Co. v. Edwin Davey & Sons* (7).] In the present case the use of "tub happy" upon or in connection with articles of clothing by anyone other than the registered proprietor of itself constitutes infringement. The amendment of the definition of "trade mark" effected by Act No. 76 of 1948, s. 3, and the introduction of s. 31A brought about by the same Act might lead to an inference being drawn against the respondent that persons might be lead to believe that the user here is a permitted user. In any event the evidence establishes that the user here was user as a trade mark. The public was counselled to buy "tub happy" goods. If the user is as a trade mark, then s. 53A affords the respondent no protection: *de Cordova v. Vick Chemical Co.* (8). It cannot be suggested that the use of the words by the respondent is descriptive of the character of the goods and accordingly s. 53A does not apply. In applying s. 53A an objective test must be adopted.

(1) (1924) 41 R.P.C. 548, at pp. 573-575.

(2) (1929) 46 R.P.C. 406, at pp. 411, 415-418.

(3) (1934) 51 R.P.C., at pp. 112, 113, 115.

(4) (1934) 51 R.P.C. 110.

(5) (1940) Ch. 667; (1940) 57 R.P.C. 209.

(6) (1936) 37 S.R. (N.S.W.) 9, at pp. 11, 12, 16; (1937) 54 W.N. 19.

(7) (1933) 49 C.L.R. 349, at pp. 356, 359, 360, 361.

(8) (1951) 68 R.P.C. 103, at pp. 105, 106.

J. D. Holmes Q.C. (with him *K. S. Jacobs*), for the respondents. The trial judge was correct in applying s. 53A to the facts of this case. The words "tub happy" are used in a descriptive sense and refer to the washable character of the goods. All the advertisements published show that the words were intended to refer to a characteristic of the goods. "Happy" is used not to describe an emotional state but to suggest the characteristic of easily washable. The words are not used to evoke an idea of adulation. If the words are held to mean easily washable, such a meaning is descriptive and a user of the words to impart this idea falls within s. 53A. If "tub happy" is simply a laudatory expression then it is not entitled to registration: *In re Joseph Crosfield & Sons, Ltd.'s Application* (1); *In re Keystone Knitting Mills Ltd.'s Application* (2); *In re Massachusetts Saw Works' Application* (3), and accordingly the registration is invalid. [He referred to *In re Colgate & Co.'s Application* (4); *Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd.* (5); *In re Seligmann's Application* (6).] The reasoning of Lord Tomlin in the *Yeast-Vite Case* (7) applies to s. 53. That section only applies where there has been a use of the words as a mark in respect of the goods and the phrase "in respect of the goods" confines the section to the use of something on the goods themselves, and a use in an advertisement would not be caught. There is here no use of the words "tub happy" as a mark, but the words are used either descriptively or in a laudatory sense in conjunction with the respondents' own mark "Exacto Cotton Garments". The presence of s. 53 in the local statute does not produce the result contended for by the appellant, nor does the reading together of ss. 50 and 53. *Bismag Ltd. v. Amblins (Chemists) Ltd.* (8) being a decision on the Imperial Act of 1938 which differs markedly from our own statute cannot assist in deciding the present problem. The appeal should be dismissed.

H. W. May, in reply.

Cur. adv. vult.

The following written judgments were delivered:—

DIXON C.J. I have had the advantage of reading the judgment prepared by *Williams J.* and also that prepared by *Kitto J.* I recognize the weight of the considerations which *Kitto J.* has

- | | |
|--|--|
| (1) (1910) 1 Ch. 118, 130; (1909) 26 R.P.C. 561, 837. | (5) (1938) 55 R.P.C. 125, at pp. 143, 144; (1938) 1 All E.R. 618, at pp. 628, 629. |
| (2) (1928) 45 R.P.C. 421. | (6) (1953) 71 R.P.C. 52. |
| (3) (1918) 35 R.P.C. 137. | (7) (1934) 51 R.P.C. 110. |
| (4) (1913) 30 R.P.C. 262, at p. 265; 29 T.L.R. 326, at p. 327. | (8) (1940) Ch. 667; (1940) 57 R.P.C. 209. |

H. C. OF A.

1956.

MARK
FOY'S
LTD.

v.
DAVIES
COOP
& Co.
LTD.

Aug. 9.

H. C. OF A.
1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& Co.
LTD.

Dixon C.J.

marshalled with so much force against the view that the words "tub happy" are words having no direct reference to the character or quality of the goods within the meaning of par. (d) of s. 16 (1) of the *Trade Marks Act* 1905-1948. But nevertheless I am unable to adopt the conclusion that these words are disqualified from forming a registrable trade mark under s. 16 (1) (d) because they directly refer to the character or quality of the goods.

It is, I think, a mistake first to assume that words like "Tub Happy" do convey a meaning either to people in general or to a particular class of persons and then on that assumption to inquire what exactly the meaning is. Indeed to institute a search for a meaning almost necessarily implies that in ordinary English speech the words do not possess a connotation sufficiently definite to amount to a direct reference to the character or quality of the goods. And that is true even when to standard English usage is added all the figurative idiomatic and slang phraseology that may be currently in use. Once, however, the question is asked what do the words mean and there is started a search for a meaning, a process of analysis and of reasoning by exclusion of alternatives is begun. No doubt such a search may, without any sacrifice of logic, end in construing the words as meaning that the garments will emerge happily from the washtub. But if they are so interpreted, the interpretation is chiefly the consequence of failure to find another meaning. I venture to think, however, that a man, or for that matter a woman, hearing for the first time the words used in combination and in connection with cotton garments, would not so understand the words at once. Certainly such a person would not so understand them intuitively and without stopping to reflect and ask himself or herself what meaning the words could really possess.

The fallacy of asking what is the meaning of the phrase lies in the basal assumption that the words are intended to convey some definite meaning and perhaps the further assumption that the meaning has reference to the garments or the cottons. The assumption is fallacious because it overlooks the fact that language is not always used to convey an idea. Many uses of words are purely emotive. A word or words are often employed for no purpose but to evoke in the reader or hearer some feeling, some mood, some mental attitude. This is true of much advertising, which common experience shows to be full of meaningless but emotive expressions supposedly capable of inducing a generally favourable inclination in the almost subconscious thought of the passing auditor or hasty reader. Words put forward as trade marks are very likely indeed to be chosen in the same way.

Though Mr. *Holmes* for the respondent did of course put forward the claim that “tub happy” means washable, it was a meaning it was necessary to suggest. It was not a meaning that had sprung unaided to the mind and it was not one which he was able to establish by reference to instances of known usage.

It is easy to say that the words are addressed to persons who are accustomed to speak an idiom to which courts are strangers and who are more sensitive than judges to allusive forms of speech, which, it is claimed, possess a greater efficacy in the lively communication of more or less definable ideas. But if the claim is that the words possess a meaning which courts might not be expected to know, it would have been easy enough to adduce evidence of the meaning; a thing which was not attempted.

The reason for introducing the word “direct” into the provision from which s. 16 (1) (d) comes was to check the tendency which had been disclosed by certain decisions to find a sufficient reference to the character or quality of goods in expressions from which it could only be spelled out. The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess.

I cannot think that the words now in question go further than, if as far as, suggesting in a vague and indefinable way a gladsome carelessness *à propos* of the tub. They may have an emotive tendency, but they do not appear to me to convey any meaning or idea sufficiently tangible to amount to a direct reference to the character or quality of the goods.

I agree in the judgment of *Williams J.* and I have added the foregoing only in an endeavour to make clear why I remain unconvinced by the judgment of *Kitto J.*

WILLIAMS J. This is an appeal by the plaintiff company from a decree of the Supreme Court of New South Wales in Equity (*McLelland J.*) dismissing with costs a suit brought by the plaintiff-appellant against the defendants-respondents to restrain the alleged infringement by the defendants of its registered trade mark No. 103308. This trade mark was registered under the provisions of the *Trade Marks Act* 1905-1948 on 25th July 1950 in class 38 in respect of articles of clothing and consists of the words “tub happy”. The plaintiff owns a large retail store at 143-147 Liverpool Street, Sydney where it has for more than forty years carried on an extensive retail business. This business consists principally of retailing clothing for men, women and children, materials for such clothing

H. C. OF A.
1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& Co.
LTD.

Dixon C.J.

H. C. OF A.
1956.

MARK
FOY'S
LTD.
v.
DAVIES
COOP
& CO.
LTD.

Williams J.

and draper's manchester and household requisites. The plaintiff also owns and operates in the vicinity woollen mills, a knitting mill and shirt factory and a clothing factory. Since the date of registration the plaintiff has used and advertised the trade mark extensively upon and in connection with articles of clothing, particularly cotton frocks of various designs and good quality, manufactured by itself for which there is a ready sale. Each frock has attached to it by sewing a label bearing in bright colours the words "Tub Happy Cottons by Mark Foy's Limited, Sydney". The plaintiff has also extensively advertised its cotton frocks under the trade mark in newspapers published in Sydney and has, in each summer since 1950, exclusively displayed "Tub Happy" frocks in one of its largest show windows and has used show cards in such windows and in its departments carrying these words in large type.

The defendant Davies Coop (N.S.W.) Pty Ltd., a New South Wales company which carries on business at Marrickville, is a subsidiary of the defendant Davies Coop & Co. Ltd., a Victorian company which carries on business at Swanston Street, Melbourne. In August or September 1953 the plaintiff received a letter from the Victorian company advising it of a projected 1954 sales promotion campaign of "Exacto Cotton Garments—Tub Happy Cotton Fresh Budget Wise" manufactured by this defendant. The circular stated that the weight of advertising would tell the public the story of "Exacto Cotton Garments—Tub Happy Cotton Fresh Budget Wise" and would ensure an immediate demand for Exacto products. One suggested advertisement was "Buy Tub Happy Windcheaters Skimps etc.". The plaintiff immediately drew this defendant's attention to the existence of its trade mark "Tub Happy" and claimed that any use by the defendant or any of its traders of these words in connection with any line of clothing would be an infringement. But the defendants through their patent attorney replied that they were not using the words "Tub Happy" as a trade mark and that the words "Tub Happy Cotton Fresh and Budget Wise" were being used "in a modern descriptive sense", whatever this may mean, and that these words when used in relation to Exacto garments referred to their good washing properties, freshness and economy. The defendants pointed out that their garments were in every instance prominently branded as Exacto goods, that this was their trade mark, and that it was this mark that was distinctive of their goods. Considerable correspondence followed, the plaintiff being desirous of avoiding litigation in the trade and hoping that the defendants would abandon the use of the controversial words. But they refused to do so, continuing to claim that the words "tub

happy ” were merely descriptive of a quality of their cotton goods and finally, in October 1954, the plaintiff commenced this suit.

There is ample evidence that the defendants are advertising various articles of clothing in which the words “ tub happy ” occupy a prominent position. The words “ Exacto Cotton Garments ” also appear in the advertisements or most of them in large type but in many instances in no larger type than the words “ tub happy ”, and the public are advised to buy Tub Happy—Cotton Fresh—Be Budget Wise—Buy Tubwise Tub Happy Exacto Cotton Garments. The defendants have left the Court in no doubt that they claim to use the words “ tub happy ” to indicate their cotton garments. Their Managing Director Mr. Fulphey in cross-examination said that the defendants did not consider the advisability of discontinuing the words “ tub happy ”, they relied on the advice of their patent attorney that the words were merely descriptive of the quality of the goods, and “ we considered the words ‘ tub happy ’ were essential to advertising cotton fibres as opposed to woollen fibre ”. There can therefore be no doubt that the plaintiff is entitled to an appropriate injunction if it has proved that its trade mark has been infringed and is in other respects able to sustain its claim to the exclusive use of the words as a mark.

The plaintiff filed a statement of claim and moved for an interlocutory injunction and by consent the motion was turned into a motion for a decree. His Honour dismissed the suit on the ground that the words were being used by the defendant as a bona fide description of the character or quality of the goods within the meaning of s. 53A of the *Trade Marks Act*. He said : “ In my opinion, the facts in this case bring the defendants within s. 53A, assuming otherwise a valid trade mark and facts showing an infringement. I have examined all the advertisements very carefully, but, in my opinion, each must be read as a whole, even bearing in mind the various elements to which Mr. *Hardie* directed my attention, and all must be read, I think, in the light of the evidence of Mr. Fulphey, which I accept. Reading the advertisements in the manner I have indicated, I am of opinion that the use up to this point of time by the defendants of the words ‘ Tub Happy ’ has been a use by the defendants of a bona fide description of the character or quality of the goods of the defendants.” We were informed by counsel for the defendants that his Honour said that he was prepared to dismiss the motion either on this ground or on the ground that the defendants had not used the words “ tub happy ” as a trade mark, that it was only if they were so doing that the plaintiff’s rights in the trade mark would be infringed, and that his Honour only adopted the former

H. C. OF A.
1956.

MARK
FOY’S
LTD.

v.
DAVIES
COOP
& CO.
LTD.

Williams J.

H. C. OF A.
1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& CO.
LTD.

Williams J.

ground after he had given counsel for the plaintiff the option to choose between them.

Before us the defendants have relied on both grounds. They have also challenged the validity of the registration of the trade mark on the ground that it is not registrable under the provisions of the *Trade Marks Act*, s. 16. All these grounds are disputed by the plaintiff and it will be advisable, before discussing them, to set out certain provisions of the *Trade Marks Act*. There is first s. 4 which contains the following definitions: "Mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. "Trade Mark" means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor . . . to use the mark whether with or without any indication of the identity of that person. (This definition was inserted by the *Trade Marks Act* 1948 in lieu of the definition inserted in the principal Act by the *Trade Marks Act* 1912. This definition read: "Trade Mark" means a mark used or proposed to be used upon or in connection with goods, for the purpose of indicating that they are the goods of the proprietor of the trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale.) Then there is s. 16 (1) which provides that a registrable trade mark must contain or consist of at least one of the following essential particulars . . . (d) a word or words having no direct reference to the character or quality of the goods The plaintiff claims that its mark trade is a registrable trade mark under this provision. Certain provisions of ss. 50, 51, 53, and 53A are also material. Section 50. Subject to the provisions of section fifty-one A of this Act, . . . the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of the trade mark upon or in connection with the goods in respect of which it is registered. Section 51. In all legal proceedings relating to a registered trade mark . . . the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark under this Act Section 53. The rights acquired by registration of a trade mark shall be deemed to be infringed by the use, in respect of the goods in respect of which it is registered, of a mark substantially identical with the trade mark or so nearly resembling it as to be likely to deceive. Section 53A. No registration under this Act shall interfere with . . . the use by any

person of any bona fide description of the character or quality of his goods. H. C. OF A. 1956.

The first question is whether the words "tub happy" are registrable as a trade mark under s. 16 (1) (d) of the *Trade Marks Act*. To qualify they must be words having no direct reference to the character or quality of articles of clothing. In his speech in *Eastman Photographic Materials Co. Ltd. v. Comptroller-General of Patents, Designs and Trade Marks* ("Solio" Case) (1) Lord Herschell explained the meaning of this qualification. He said: "any word in the English language may serve as a trade-mark—the commonest word in the language might be employed. In these circumstances it would obviously have been out of the question to permit a person by registering a trade-mark in respect of a particular class of goods to obtain a monopoly of the use of a word having reference to the character or quality of those goods. The vocabulary of the English language is common property: it belongs alike to all; and no one ought to be permitted to prevent the other members of the community from using for purposes of description a word which has reference to the character or quality of goods" (2). The introduction of the word "direct" into the paragraph is explained by the following passage in *Kerly on Trade Marks*, 7th ed. (1951), p. 127: At first the qualification was "A word or words having no reference to the character or quality of the goods, and not being a geographical name . . . The decisions on the clause, however, and especially those prior to the *Solio Case* (1), tended to prevent the registration of words having a merely indirect reference to the character or quality of the goods; the framers of the Act of 1905 therefore introduced the word 'direct' to qualify 'reference' with the object of extending the class of registrable words, or at all events of making the object of the Legislature more clear." One example of words that have been held to have a direct reference to the character or quality of the goods will be found in *Philippart v. William Whiteley Ltd.* ("Diabolo" Case) (3) where Parker J. (as he then was) held that this word denoted the top used in the well-known game of diabolo just as cricket applied to a set of stumps would directly suggest the use to which the stumps were to be put. Another example will be found in *In re Colgate & Co.'s Application* (4) to register the word "ribbon" in respect of a dentrifice. The same learned judge refused the application on the ground that the word referred to a character or quality of the goods because it described the manner in which the dental cream would

MARK
FOY'S
LTD.

v.
DAVIES
COOP
& CO.
LTD.

Williams J.

(1) (1898) A.C. 571.

(2) (1898) A.C., at p. 580.

(3) (1908) 25 R.P.C. 565.

(4) (1913) 30 R.P.C. 262; (1913) 29
T.L.R. 326.

H. C. OF A.
1956.

MARK
FOY'S
LTD.
v.
DAVIES
COOP
& CO.
LTD.

Williams J.

come out of the tube and lie on the brush in the shape of a ribbon. Reference may also be made to two cases in each of which ordinary English words were held to have a reference to the character or quality of the goods. In *In re Keystone Knitting Mills Ltd.'s Application* (1) the noun "charm" in respect of hosiery being wearing apparel was held to have the same significance as the adjective "charming" and to describe in a laudatory sense the character or quality of the goods. As Lord Hanworth said: "I think one has to look at the word which is registered, not in its strict grammatical significance, but as it would represent itself to the public at large who are to look at it and to form an opinion as to what it connotes" (2). In *In re Joseph Crosfield & Sons Ltd.'s Application* (3) the noun "perfection" when applied to household soap was held to have the same meaning as the adjective "perfect" and as such to be a mere laudatory epithet which could be used to describe the character or quality of any goods and as such open to all the world and incapable of being registered. On the other hand in *In re Compagnie Industrielle Des Pétroles' Application* (4) Warrington J. (as he then was) allowed "Motorine" to be registered in respect of lubricating oils, any exclusive use of the word "motor" being disclaimed. His Lordship said: "I cannot see how the word 'Motorine' has any direct reference to the character or quality of those goods. No doubt it suggests that in some way they are oils which are to be used in connection with a motor, but beyond that it has no reference either to their character or their quality, and such reference as the use of the two syllables of the word 'motor' in the word 'Motorine' as to the character or quality seems to me not to be that direct reference which the present Act contemplates" (5). So too in *In re la Marquise Footwear's Application* (6) Evershed J. (as he then was) held that the word "Oomphies" in relation to shoes was registrable. Although the word "oomph" had a meaning of sex appeal derived from a popular cinema actress it had no direct reference to any character or quality of ladies' footwear. His Lordship said: "where you take an ordinary word in common use properly applicable in its ordinary meaning to the class of goods to which it is sought to be applied by the applicant, the Court must be slow to give to the applicant in effect a monopoly of that epithet. Where you take a word which is exceedingly uncommon by comparison, I think that somewhat different considerations apply and, if you say that it has a direct reference, you are going to assume

(1) (1928) 45 R.P.C. 421.

(2) (1928) 45 R.P.C., at p. 426.

(3) (1909) 26 R.P.C. 837; (1910) 1
Ch. 130.

(4) (1907) 24 R.P.C. 585.

(5) (1907) 24 R.P.C., at p. 592.

(6) (1946) 64 R.P.C. 27; (1946) 2
All E.R. 497.

that this word, which I assume not to be an invented word, has a much more precise significance and a much greater circulation than, I think, on the evidence plainly it has " (1). Any reference that the words "Tub Happy" have to the character or quality of articles of clothing is very remote. They are in the nature of a coined phrase. Inanimate objects including articles of clothing cannot have the character or quality of happiness whether they are in a tub or not. But the defendants' case is that the common metaphorical use of the adjective would convey to prospective buyers of the fabrics that the cotton emerged from the wash tub more attractive than ever in appearance with fibres and colours as good if not better than ever. Therefore, so it is said, the words are a description of the character or quality of the goods and moreover are not entitled to registration. This claim gives far too specific a meaning to the vague figurative use of the word "happy" in connection with "tub". Like so many expressions used in advertisements no definite or actual meaning seems to belong to the combination "Tub Happy". There is a cloudy suggestion only about it that all will be well in a wash tub but that is all. The attitude of mind of those who glance at such advertisements may be affected favourably by some sort of vague association of ideas but it falls a long way short of conveying any meaning to them. To say that articles of clothing are tub happy is in the ordinary use of English meaningless. The words contain at most a "covert and skilful allusion" to the quality of washability which is characteristic of articles of clothing made of some kinds of material including cotton. At most they create an impression that this is what they are intended to convey. They do not trespass upon the rights of other traders to use any ordinary English words or phrases referring to the washable qualities of their goods. They do not attempt to "enclose and appropriate as private property certain little strips of the great open common of the English language". No doubt the words are intended to "contain a meaning—a meaning is wrapped up in them if you can only find it out." : see the speech of Lord *Macnaghten* in the *Solio Case* (2). And it may not be hard to find out that meaning but the words do not refer in any ordinary sense, laudatory or otherwise, to any character or quality of articles of clothing, still less do they do so directly.

The conclusion that the words "Tub Happy" are registrable under s. 16 (1) (d) of the *Trade Marks Act* because they have no direct reference to the character or quality of articles of clothing

H. C. OF A.

1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& Co.
LTD.

Williams J.

(1) (1946) 64 R.P.C., at p. 32 ; (1946) 2 All E.R., at pp. 499, 500.

(2) (1898) A.C., at p. 583.

H. C. OF A.
1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& Co.
LTD.

Williams J.

goes a long way towards deciding the ground on which his Honour ruled against the defendants. There is nothing in the registration of these words to prevent the defendants describing their cotton goods as having the qualities of washability, freshness and cheapness, and in particular the first of these qualities. The whole English language is open to them, even the most up to date English, if the defendants wish to refer to these qualities "in a modern descriptive sense". In *J. B. Stone & Co. Ltd. v. Steelace Manufacturing Co. Ltd.* (1) *Lawrence L.J.* said: "In my opinion the object of s. 44" (of the *English Trade Marks Act 1905* which corresponds to s. 53A of the *Commonwealth Act*) "was to safeguard traders in cases where the registered trade mark consisted of more or less descriptive words forming part of the ordinary English language, without the use of which other traders would find some difficulty in describing certain qualities of their goods; but was never intended and does not operate to enable a trader to make use of a rival trader's registered trade mark consisting of a fancy word having no reference to the character and quality of the goods in order more readily to sell his own goods" (2). In *de Cordova v. Vick Chemical Co.* (3) Lord *Radcliffe*, delivering the judgment of the Privy Council, said:—"However that may be, it seems plain on the facts of this case that 'Vapour Rub' cannot be regarded in Jamaica as a 'bona fide description' of the character or quality of the appellants' goods If the makers of the goods which the appellants are selling desire to inform their customers that the properties of their ointment are such that, if it is rubbed on the chest or throat, it will give off a healing vapour which can be inhaled through the mouth or nose, there is nothing to prevent them from doing so. But that would be something different from what they have done hitherto" (4). Section 53A of the *Trade Marks Act* protects the use by any person of any bona fide description of the character or quality of his goods. But that means a description and not a mere suggestion in fanciful language. It does not protect an attempt by the defendants to usurp a metaphorical phrase like "Tub Happy" however magnetic the force of its public appeal may be.

The remaining question is whether the rights conferred on the plaintiff by s. 50 have been infringed. The defendants have used the exact words of the plaintiff's trade mark so that the plaintiff need not rely on s. 53. It is contended that the plaintiff's rights have not been infringed because the defendants have not used the words as a trade mark at all, but only descriptively as a laudatory

(1) (1929) 46 R.P.C. 406.

(2) (1929) 46 R.P.C., at p. 417.

(3) (1951) 68 R.P.C. 103.

(4) (1951) 68 R.P.C., at pp. 107, 108.

or puffing expression to extol the goods. They rely on the speech of Lord *Tomlin*, concurred in by Lord *Atkin* and Lord *Russell of Killowen*, in the *Yeast-Vite Case* in the House of Lords (1). The Act there in question was the English *Trade Marks Act* 1905-1919 and the particular section under review was s. 39 which corresponds to s. 50 of the Commonwealth Act. The definition of "trade mark" in the English Act was the same as the definition in the Commonwealth Act of 1912. There was no section in the English Act corresponding to s. 53 of the Commonwealth Act. The plaintiffs were the proprietors of the registered trade mark "Yeast Vite" and it was held that this mark was not infringed by the defendant selling in his shop a preparation labelled "Yeast Tablets a substitute for Yeast-Vite" which was not the plaintiff's preparation. Lord *Tomlin* said: "Now the act which the appellants contend amounts in law to an infringement of their exclusive right as registered proprietors of the trade mark is the use by the respondent upon the bottles in which he sells his preparation of the phrase 'Yeast Tablets, a substitute for Yeast-Vite.' This is clearly a use of the word 'Yeast-Vite' on the respondent's preparation to indicate the appellant's preparation and to distinguish the respondent's preparation from it. It is not a use of the word as a trade mark, that is, to indicate the origin of the goods in the respondent by virtue of manufacture, selection, certification, dealing with or offering for sale" (2). His Lordship continued: "The question therefore here . . . is, what is the property right of the appellants and has it been infringed? It is true that the language of the definition of a trade mark contained in s. 3 of the Act of 1905 cannot without some change of form be read directly into s. 39, but it is equally true that the language of s. 39 must carry with it some implied limitation, unless it is to be given a meaning extending its operation altogether outside the scope of the *Trade Marks Acts*. The phrase 'the exclusive right to the use of such trade mark' carries in my opinion the implication of use of the mark for the purpose of indicating in relation to the goods upon or in connection with which the use takes place, the origin of such goods in the user of the mark by virtue of the matters indicated in the definition of 'trade mark' contained in s. 3" (3). Mr. *May* contended that the speech by Lord *Tomlin* is not applicable to the Commonwealth Act, first because of the difference between the two Acts in the definition of trade mark since the definition in the 1912 Act was omitted and the existing definition substituted for it, and secondly, because of the

H. C. OF A.
1956.

MARK
FOY'S
LTD.

v.
DAVIES
COOP
& Co.
LTD.

Williams J.

(1) (1934) 51 R.P.C. 110.

(3) (1934) 51 R.P.C., at p. 116.

(2) (1934) 51 R.P.C., at p. 115.

H. C. OF A.
1956.

MARK
FOY'S
LTD.
v.
DAVIES
COOP
& CO.
LTD.

Williams J.

presence in the Commonwealth Act of s. 53 which has no counterpart in the English Act. But the reasoning of his Lordship appears to be equally applicable to the Commonwealth Act despite these differences. If the defendants in the present case had advertised that their Exacto cotton frocks washed as well as the plaintiff's Tub Happy frocks it could not be said that the words "Tub Happy" were used by the defendants in relation to goods to indicate a connection in the course of trade between the goods and themselves. They would only be used in support of a claim that their cotton goods washed as well as the plaintiff's Tub Happy goods. In such a case the words "Tub Happy" would not be used as a trade mark within the meaning of the present definition. Section 50 states that the proprietor of a registered trade mark has the exclusive right to the use of the trade mark upon or in connection with the goods in respect of which it is registered. This appears on its face to mean that no one but the proprietor can use the trade mark upon or in connection with the goods in respect of which it is registered for any purpose. One purpose within the section would appear to be the use of the trade mark by an opponent for the purpose of claiming that his goods were a substitute for those of the proprietor. It does not matter that the identity of the proprietor of the trade mark is unknown to the public. It is the trade mark which identifies the goods and the sale of goods that have acquired a reputation could be seriously prejudiced by an opponent offering his goods as substitutes for them. But in the *Yeast-Vite Case* (1) the House of Lords narrowed the meaning of s. 50 by implying after the words "the exclusive right to the use of the trade mark" the words "as a trade mark". Their Lordships held that the exclusive rights of the registered proprietor are only infringed if the trade mark is used as a trade mark for the purpose mentioned in the definition. This construction must be applied to s. 50 of the Commonwealth Act and the presence of s. 53 in that Act can make no difference. Section 53 is really an appendage to s. 50 and its function is to widen the definition of infringement so as to include cases where the defendant does not use the identical trade mark but uses a mark substantially identical with it or so nearly resembling it as to be likely to deceive. But the alleged infringement must still be the use of the plaintiff's trade mark or some mark substantially identical with it as a trade mark.

But the *Yeast-Vite Case* (1) does not assist the defendants. They are not using the words "Tub Happy" in the same way as the defendant was using the words "Yeast-Vite" in that case. They

(1) (1934) 51 R.P.C. 110.

are advertising the words “ Tub Happy ” and emphasizing them in relation to their own cotton garments for the purpose of indicating a connection in the course of trade between the goods and themselves. The public are not being invited to compare the “ Exacto ” goods of the defendants with the “ Tub Happy ” goods of the plaintiff. They are being invited to purchase goods of the defendants which are to be distinguished from the goods of other traders partly because they are described as “ Tub Happy ” goods. In *Aristoc Ltd. v. Rysta Ltd.* (1) Viscount *Maugham* cites the following appropriate passage from the judgment of Lord *Greene* M.R. in *Saville Perfumery Ltd. v. June Perfect Ltd.* (2) : “ In an infringement action, once it is found that the defendant’s mark is used as a trade mark, the fact that he makes it clear that the commercial origin of the goods indicated by the trade mark is some business other than that of the plaintiff avails him nothing, since infringement consists in using the mark as a trade mark, that is, as indicating origin ” (3).

Needless to say, if the defendant uses the words of the plaintiff’s trade mark as indicating origin it is still an infringement notwithstanding that the defendant always adds his own name : *Kerly on Trade Marks*, 7th ed. (1951), p. 445.

For these reasons the appeal should be allowed.

KITTO J. The appellant was the plaintiff and the respondents were the defendants in a suit in the equitable jurisdiction of the Supreme Court of New South Wales. The object of the suit was to restrain apprehended infringements of a registered trade mark of which the appellant is the proprietor, and to obtain other relief. A motion in the suit for an interlocutory injunction came before *McLelland* J., and was turned by consent into a motion for decree. His Honour dismissed the suit upon the ground that what the respondents had done and threatened to do amounted only to using a bona fide description of the character or quality of their goods, within the meaning of s. 53A of the *Trade Marks Act* 1905-1948 (Cth.), and accordingly was not an infringement of the mark. Other grounds of opposition to the suit had also been relied upon by the respondents, namely that the registration of the appellant’s mark was invalid, and that the respondents’ user of the words of which the mark consists was not a user as a trade mark and for that reason was no infringement of it. Upon these last-mentioned defences his Honour gave no decision. From the decree which his Honour made this appeal is brought by special leave.

H. C. OF A.
1956.
MARK
FOY’S
LTD.
v.
DAVIES
COOP
& CO.
LTD.
Williams J.

(1) (1945) A.C. 68. (3) (1945) A.C., at p. 94.
(2) (1939) 58 R.P.C. 147, at p. 161.

H. C. OF A.
1956.

MARK
FOY'S
LTD.
v.

DAVIES
COOP
& CO.
LTD.

Kitto J.

In support of the decree the respondents have relied again upon all three of their defences, and I shall deal first with the challenge offered to the validity of the registration. The appellant's trade mark consists of the two words "Tub Happy", and the class of goods in respect of which it is registered comprises articles of clothing. Its deemed date of registration (see s. 47) is 25th July 1950. The respondents' contention is that the mark neither contains nor consists of any of the essential particulars prescribed by sub-s. (1) of s. 16 of the Act. The particulars are of five descriptions, each being stated in one of five lettered paragraphs in the section. Paragraphs (a), (b) and (c) need not be set out, for they are obviously inapplicable here. Paragraph (d) includes "A word or words having no direct reference to the character or quality of the goods . . ." (the rest of the paragraph is immaterial). Paragraph (e) brings in "Any other distinctive mark", and it adds: "but a . . . 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". The appellant has not suggested that the trade mark "Tub Happy" has been the subject of any order under par. (e). The validity of its registration therefore depends upon its having no direct reference to the character or quality of the appellant's goods.

That the mark has a reference to the quality of the goods, and to nothing else, appears to me to be clear. "Tub", in relation to garments, obviously refers to the wash-tub. "Happy", as applied to garments and in relation to the wash-tub, would readily convey, even to minds unprepared for it by acquaintance with the modern spate of synthetic expressions built by combining a noun with "-happy", that washing suits them well—that they come out of the wash in a condition of enhanced well-being, as if they actually took a delight in the tub. Of course it is uncommon to apply the adjective "happy" to an inanimate object; but to describe a garment as happy in respect of some process to which purchasers may wish to submit it would give, I should think, a perfectly clear intimation, even to any who may be wholly innocent of the vernacular, that the garment is so well fitted to undergo the process that it may be floridly described as taking pleasure in it. No doubt it is also unusual to identify the process to which the garment stands in so fortunate a relation by using adverbially the name of its chief instrument; but, again, the intimation would be clear, from the use of the word "tub", that the "happiness" ascribed to the garment is in respect of washing. It is important to observe that par. (d) of s. 16 (1) is concerned with any reference at all to the

character or quality of goods, so long as it be direct. What the paragraph asks is whether in truth the words refer directly to the character or quality of the goods. I shall consider later the meaning of "direct", for that word describes the manner in which the reference, if there be one, is made. The point at the moment is that the question whether there is any reference at all to character or quality in the words "Tub Happy", as applied to garments, is a question of the significance of the words to persons to whose attention the mark is likely to come in the course of its intended use. One has to look at the words as they would present themselves to the persons who are to look at them and form an opinion as to what they connote: *In re Keystone Knitting Mills Trade Mark* (1).

In my judgment it ought not to be said of the words here in question, as *Evershed J.* (as he then was) said of the word which he allowed to be registered in *In re La Marquise Footwear's Application* (2), that it would need a more precise significance and a greater circulation to enable it to be regarded as making a direct reference to the quality of the goods. I should think it certain that the majority of people in this country, the purchasers in whose minds the appellant company's mark is intended to distinguish its garments from those of other traders, seeing "Tub Happy" applied to a garment, would perceive a meaning in it readily enough, and would not need to spend much time working one out by painful reasoning. They are thoroughly familiar with expressions consisting of "-happy" preceded by the name of that to which the "happiness" is due or in regard to which it exists. Most frequently "-happy" is used in such expressions with something of the sense indicated in the sixth of the definitions given in the *Oxford English Dictionary*: "slightly drunk, 'elevated'"; or as it is put in *Webster's New World Dictionary of the American Language* (1953 College Edition): "(Slang) Intoxicated or as if intoxicated: sometimes used in hyphenated combinations as slap-happy, flak-happy." So "bomb-happy" is applied to a person in some degree out of his wits in consequence of his experiences under bomb attacks, while "trigger-happy" describes a person so fond of shooting, so intoxicated with it, that he is irresponsible in his handling of a rifle or gun.

The fashion in such verbal combinations is comparatively recent, but it is widespread and well-established in this country. It is a part of a wider fashion which is mentioned in *Thomas Pyles' Words and Ways of American English* (English edition published by Melrose (1954)). The author says, at pp. 142, 143: "Combinations with

H. C. OF A.

1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& CO.
LTD.

Kitto J.

(1) (1928) 45 R.P.C. 421, at p. 426. (2) (1946) 64 R.P.C. 27; (1946) 2 All E.R. 497.

H. C. OF A.
1956.

MARK
FOY'S
LTD.
v.

DAVIES
COOP
& CO.
LTD.

Kitto J.

-crazy, -happy, -wise, -conscious, -struck and -minded are freely made: girl-crazy (and boy-crazy), stage-crazy, slap-happy, bark-happy (of watchdogs), fight-happy, stripe-happy, (of a soldier itching for promotion), trigger-happy; market-wise, style-wise, budget-wise, fight-wise; social-conscious, class-conscious, race-conscious, profit-conscious; girl-struck, . . . stage-struck, movie-struck; social-minded, federation-minded—these are the merest sampling.” Consideration of this list and of the many other examples which will spring at once to anyone’s mind may suggest that the movement in favour of such expressions may be too narrowly viewed if its origin is attributed exclusively to what the author justifiably calls “the American talent for saying things pungently and expressively”. But however this may be, few will deny that modern English usage in general and American English usage in particular possess the qualities he acclaims in the latter: “a warmth, an enthusiasm, a youthfulness of spirit, that all the awesome powers of all the teachers and all the text books have failed to blight”. It seems to me safe to say that among Australians, surely no slower than other inheritors of the English tongue to admit new proofs of its plasticity, such an expression as “tub-happy”, though never used before, and whether used with or without capitals and with or without a hyphen, would be generally recognized, by its conformity to a known pattern, as meaning, when applied to garments, that they exhibit a veritable enthusiasm for being washed. So understood, it is of course an example of an advertiser’s exuberance, but exuberance does not convert a reference to quality into something else. Words as general in their laudatory reference as “Perfection”, “Good”, “Best”, “Superfine”, “Classic”, “Universal”, “Artistic” and “Charm” have been held not only to refer to quality but to belong inalienably to the ordinary vocabulary of description, so as to be incapable of achieving a distinctiveness enabling them to be allowed registration by an order under paragraph (e): *In re Joseph Crosfield & Sons Ltd.* (1); *In re J. & P. Coats Ltd.’s Application* (2); *In re Keystone Knitting Mills Trade Mark* (3). “Famous” and “Splendid” have been similarly regarded in the United States: *Sebastian, Law of Trade Marks*, 4th ed. (1899), p. 644. So, too, in Canada, “Superweave” has been disallowed in respect of textiles, on the ground that because it “clearly indicates and describes textiles that have a superior or superfine weave, an attribute . . . which a trader in textiles would naturally wish to emphasize

(1) (1910) 1 Ch. 130, at pp. 142, 148, 151.

(2) (1936) 2 All E.R. 975, at p. 984; 53 R.P.C. 355.

(3) (1928) 45 R.P.C. 421.

in offering his goods for sale. Such a word may not be commanded by one manufacturer and registered . . . so as to prevent others from claiming the same quality in their merchandise and using the same or a similar expression to describe it": *Registrar of Trade Marks v. G. A. Hardie & Co. Ltd.* (1).

It is in point to mention that the respondents' conduct of which the appellants here complain is a use of "tub happy" in extensively advertising cotton garments and obviously for the very purpose of emphasizing to the public the washable qualities of the goods. The words are used adjectivally and in conjunction with similarly-constructed expressions: "Tub-wise", "Budget-wise" (one of the very combinations mentioned by *Pyles*), and "Cotton-fresh". These, together with "Tub Happy", the respondents adopted in good faith (as the learned primary judge has found), after satisfying themselves on expert advice and after investigation that the main attractions of cotton goods for the consumer were, first, good washing properties, secondly durability and economy, and thirdly the freshness of cotton. I cannot believe that they were deceiving themselves in thinking, as plainly they did, that "Tub Happy" was worth using in expensive advertisements because it conveyed a meaning and conveyed it impressively. It compresses a sentence into three syllables, and if there is some lack of clarity at a first encounter it is the price of condensation. But the quaintness of the expression tends to hold the reader's attention, and its meaning seems to me to emerge clearly enough.

Then if, as I think is the case, the mark has a reference to the quality of the goods, is not the reference direct? The words do not, by pointing first to something else, lead the mind by a round-about route to the conclusion that some quality is intended to be claimed for the goods. They do not wrap up in a cunningly-devised name some echo of a directly descriptive word, or some distant allusion containing a hint of a quality. They do not depend for their descriptive force upon some overtone of meaning. They form an adjectival expression having one significance only, and that a significance which attributes a quality to the goods. Indeed, an obvious merit from an advertiser's point of view is that they come straight to the point—a merit which is all the greater because of the element of half-humour in the manner of their doing so. In mild and cheerful slang, with a good salesman's feeling for what is likely to appeal to his audience, they give a straight answer to the question: How are these goods for washing quality? It is a broad answer, without

H. C. OF A.
1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& Co.
LTD.

Kitto J.

(1) (1949) 4 D.L.R. 582, at p. 588.

H. C. OF A.
1956.

MARK
FOY'S
LTD.
v.
DAVIES
COOP
& Co.
LTD.

Kitto J.

particularity, but a direct answer nevertheless. A claim for superlative washability might easily be made with more restraint and dignity, but hardly, I should think, more directly.

Is there any special meaning to be given to "direct reference" in s. 16 (1) (d) which requires a different conclusion? Paragraphs (c) and (d), with the exception of the word "direct" in the latter, are derived ultimately from the English Act of 1888. That Act put them in the place of the earlier expression "fancy word or fancy words not in common use", which had been held by the courts to include no word which was not obviously non-descriptive. "The judges were, however, unable to remove from their minds the impression produced upon them by the rigidity with which the term 'fancy word' had been construed, and which had been carried so far as to exclude from registration, not merely words which contained direct statements as to the character or quality of the goods, but even invented words which had never been heard of before, but which were supposed to contain some remote suggestion of descriptiveness": *Sebastian, Law of Trade Marks*, 4th ed. (1899), pp. 41, 42. One of the most striking examples occurred in the *In re Farbenfabriken Application* (1), where registration was refused of a mark consisting of the word "Somatose" in respect of a pharmaceutical preparation of powdered meat. *Kay* L.J. thought that "having no reference to the character or quality of the goods", was more restrictive than "descriptive of the goods", and he and *A. L. Smith* L.J., against the dissent of *Lindley* L.J., held that the word, because of its derivation from the Greek *soma* (genitive, *somatos*) meaning a body, had a reference to the quality of being readily absorbed into the human body. It was in view of the results which the impression mentioned by *Sebastian* produced under the prototype of s. 16 (1) (d) that the English Act of 1905 inserted the word "direct". *Sebastian*, writing before that Act was passed (*Law of Trade Marks*, 4th ed. (1899), p. 44), having insisted upon the reasonableness of strictly maintaining the right of the public to use descriptive words in a descriptive sense, made the observation: "Whether it was necessary to discover a descriptive allusion in all the cases in which the court discovered it may perhaps be doubted, but it is clear from the decision of the House of Lords that no non-invented word which really is descriptive will be allowed to be registered as a new trade mark." The introduction of the word "direct" by the 1905 Act may be compared with *Sebastian's* use of the "really" in this passage. It appears to have had the effect of confirming his observation (*Law of Trade Marks*, 4th ed. (1899), p. 43)

that the amendment made in 1888 had been designed to include as registrable trade marks such terms as "Pharoah's Serpents" (on a kind of fireworks) and "United Service" (on soap), both of which are descriptive in the sense that, by associating the goods with other things, they suggest, without actually mentioning, some claimed quality of the goods. This is the kind of descriptive reference which may properly be called indirect. A good illustration of it may be found in *In re Meyerstein's Trade Mark* (1), where the word "Satinine", as a mark intended for starch, blue and other laundry preparations, was refused registration (under the law as it stood before 1905) because of its reference to the quality of producing a glossy surface on articles treated with such preparations. The direct reference of the word was to satin; but that reference suggested to the mind the quality of glossiness, and that in turn suggested a gloss-producing quality as the cause of glossiness in the articles upon which the preparations were intended to be used. A contrast may be suggested by taking up an illustration put by *Neville J.* in *Henry Thorne & Co. Ltd. v. Sandow* (2) and saying that although the word "Health" as applied to cocoa refers directly to the health-giving quality of the product, the same word as applied to fishing rods refers only indirectly to the quality of usefulness in the pursuit of a health-giving pastime, for it is indulgence in the pastime, and not the rod, which has a direct connection with health.

The case just cited, together with the "*Perfection*" Case (3), were regarded by *Younger J.* in *In re Massachusetts Saw Works' Application* (4) as having established that a word like "Victor", being no more than "an appropriately laudatory epithet", must be taken to have a direct reference to the quality of the goods, so that it cannot be deemed distinctive except after an order, on special case made, under the equivalent of our s. 16 (1) (e). I see no escape from this conclusion, either on the authorities or on the reason of the thing; and if it is true that such a word, used metaphorically to ascribe to goods a supremacy amongst competitors, has a direct reference to the general high quality of the goods, must it not also be true that a combination of words which attributes to goods an enthusiasm for being washed has a direct reference to their possessing in a highly satisfactory degree the particular quality of being washable? Surely to say of a garment that it "takes kindly to the tub" would be to refer with absolute directness to a quality of the garment, and none the less so because the language

H. C. OF A.

1956.

MARK
FOY'S
LTD.

v.

DAVIES
COOP
& CO.
LTD.

Kitto J.

(1) (1890) 43 Ch. D. 604.

(2) (1912) 29 R.P.C. 440, at pp. 451,
452.(3) (1910) 1 Ch. 118, 130; (1909) 26
R.P.C. 561, 837.

(4) (1918) 35 R.P.C. 137, at p. 146.

H. C. OF A. 1956.
 MARK
 FOY'S
 LTD.
 v.
 DAVIES
 COOP
 & CO.
 LTD.
 Kitto J.

is the language of persiflage. Does it make all the difference that the same tribute is paid more tersely, in words which, though unhallowed by literary precedent, have been formed by employing a known word-building device, and the garment is proclaimed "Tub Happy" ?

In my opinion the registration of the appellant's trade mark cannot be supported under s. 16 (1) (d) and accordingly is invalid. If that be so, the respondents do not need to rely upon their other defences.

I would dismiss the appeal.

Appeal allowed with costs. Decree of Supreme Court set aside. In lieu thereof order that the defendants their servants and agents be perpetually restrained from infringing the plaintiff's trade mark "Tub Happy" registered under the provisions of the Trade Marks Act 1905-1948 and in particular from using it or any phrase substantially identical with it or so nearly resembling it as to be likely to deceive for the purpose of advertising offering or distributing for sale or selling articles of clothing not being the goods of the plaintiff. Liberty to the plaintiff to apply to the Supreme Court for such account of profits or at its option for such inquiry as to damages as it may be advised. Remit the suit to the Supreme Court for this purpose. Order that the defendants pay the plaintiff's costs of the proceedings in the Supreme Court up to the date of this order, and that costs of any further proceedings in the Supreme Court be in the discretion of that court. Liberty to apply to the Supreme Court.

Solicitor for the appellant, J. R. Thomas.

Solicitors for the respondents, Baldick & Macpherson.

R. A. H.