REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE PARKER.

June 7th, 8th, 9th, 14th, 15th, 16th, and July 5th, 1910.

IN THE MATTER OF AN APPLICATION BY THE GRAMOPHONE COMPANY LD. TO REGISTER "GRAMOPHONE" AS A TRADE MARK.

Trade Mark.—Special Application for registration of the word "Gramophone" as a distinctive mark.—Application referred to the Court by the Board of Trade. —Distinctive word.—Word the name of an article.—Application dismissed.—Trade Marks Act 1905, Sections 9 (5) and 44.

A Special Application was made under Section 9 (5) of the Trade Marks Act 1905 for registration of the word "Gramophone" as a Trade Mark in Class 8 in respect of "Gramophones and sound-recording and reproducing instruments, "records, parts and accessories." The Board of Trade referred the Application to the Court. The word "Gramophone" at one time designated a patented instrument with disc, as opposed to cylindrical, records. The Patent expiring in 1900 a number of disc instruments made by various makers came on the market; they were sold not as gramophones, but under various fancy names. The Applicant Company alone sold disc machines under the name of "Gramophone," and they adopted the policy, from the year 1900 up to the present day, of widely advertising their instruments as "Gramophones," and of claiming, in their dealings with the trade, monopoly rights in the word as denoting goods of their make only. A great deal of evidence was given on both sides.

Held—*(1) That to the general public the word "Gramophone" denoted a talking machine with disc, as opposed to cylinder, records, and denoted this without any connotation of the source of manufacture. (2) That to the trade the word, while still denoting a talking machine of a particular type, connoted also the source of manufacture. (3) That the word, being the name by which*

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

an article was popularly known, ought not to be admitted to registration as a Trade Mark for that article, although in the trade it had come to connote the source of manufacture.

The Application was accordingly dismissed with costs.

This was an Application by the *Gramophone Company Ld.*, under Section 9 (5) of the Trade Marks Act 1905, to register the word "Gramophone" as a Trade Mark in Class 8 "in respect of gramophones and sound-recording "and reproducing instruments, records, parts and accessories, being apparatus "included in Class 8." The Application in the ordinary course came before the Board of Trade, who, in accordance with the power given them by Rule 39 of the Trade Marks Rules 1906, required the Applicants to apply to the Court.

The following statement of facts relating to the history of the word "Gramophone" leading up to the present Application, is taken from the judgment of the learned Judge :—

The history of the word "Gramophone," so far as I can trace it on the evidence before me, is as follows :—The earliest talking machine was made under the *Edison* Patent of 1878, and was called a phonograph. According to *Edison's* invention the sound line was traced on the record by a process of indentation. In 1886 *Bell and Tainter* obtained a Patent for an improved machine in which the sound line was cut or graved on the record as opposed to being indented. In both machines the sound line was what has been called an up and down, or hill and valley, line. Both methods of tracing the sound line were applicable to disc as well as cylinder records, but as a matter of fact no disc records appear to have been made by either method, at any rate during the life of the Patents. *Tainter and Bell* called their machines "Graphophones" to distinguish them from phonographs, but to the ordinary observer there was little difference in appearance between the two. In 1887 *Berliner* invented and obtained a Patent for yet a third invention, in which the sound line was no longer an up and down, or hill and valley, line, but a sinuous line of even depth throughout, traced on the record either by the graving method of *Tainter and Bell* or by a method of his own, which I will call the etching method. *Berliner's* process was also applicable both to disc and cylinder records, but during the life of his Patent no records were made under it in cylinder form, and, further, indeed, during the life of the *Tainter-Bell* Patent no records could be made under it otherwise than by his etching method, the graving process being covered by the last-mentioned Patent. *Berliner* called instruments made under his Patent "Gramophones," to distinguish them from phonographs or graphophones, and I think it probable that he invented the word, though both in his English and American Specification he appears to use it as an already existing word for a sound recording and reproducing instrument. *Berliner's* real invention was the sinuous sound line of even depth, but the chief apparent distinction between the phonograph or graphophone made under the *Edison* or *Tainter and Bell* Patents, and the "Gramophone" made under the *Berliner* Patent, was that both the former, as actually made, operated a cylindrical record, while the latter, as actually made, operated a disc record. It was therefore quite natural that the word "Gramophone" should to the general public come to denote a disc, as opposed to a cylinder, talking-machine. Up to the year 1896 or 1897 *Berliner's* invention was not worked in England, though some of his machines, made in America, were imported into this country. There is in

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

evidence an invoice dated the 24th of November 1891, in which the *Foreign Novelty Company* describe themselves as importers of gramophones, and in which appears a drawing of what is evidently a *Berliner* disc machine, and there are Letters Patent of the 5th of December 1891 in which the inventor claims to have avoided certain difficulties incidental to both phonographs and gramophones. Before 1896, therefore, the word was known in this country, and in my opinion it was coming to denote, if it did not already denote, a machine operating a disc record as opposed to a phonograph or graphophone which operated a cylinder record. Experts in machinery might, as I think they still may, use the three words as connoting the three methods of tracing the sound line, but popularly "Gramophone" was coming to denote a disc machine, and phonograph a cylinder machine. The word "Graphophone" was never very widely used. In 1896 or 1897 *Berliner* sold his English Patent rights, including, I think—though the evidence is not quite clear—his rights in respect of certain patented improvements, to a private firm, which called itself the *Gramophone Company*, taking its name from the instrument, and sold talking machines made under *Berliner's* Patent as gramophones. In 1899 this firm transferred the business to a Company incorporated under the style of the *Gramophone Company Ld.*, the objects of which as defined by its Memorandum of Association included, *inter alia*, the manufacture and sale of gramophones and phonographs and gramophone discs and phonograph cylinders. This shows that the gramophone was then looked upon as a disc machine as opposed to the phonograph, which was a cylinder machine. The last-mentioned Company continued to sell machines made under *Berliner's* Patent as gramophones, but in 1900 it transferred its business to a Company with a larger capital which at the same time acquired a business in typewriters, and was incorporated as the *Gramophone and Typewriter Company Ld.* Its Memorandum of Association also included amongst its objects the manufacture and sale of gramophones and phonographs. The *Gramophone and Typewriter Company Ld.*, which, having dropped the typewriting business, is now called simply the *Gramophone Company Ld.*, and is the Applicant Company, continued to manufacture talking-machines under the *Berliner* Patent, and to sell them as gramophones. In 1900 the *Tainter and Bell* Patent expired, and the graving method being considered, as it no doubt is, superior to the etching method, the *Gramophone and Typewriter Company Ld.* abandoned the latter altogether and continued the former, continuing, however, to sell its talking machines as gramophones. There was nothing wrong in this, the essence of *Berliner's* invention being the sinuous sound line of even depth, and even had this not been so there is no evidence that the word "Gramophone" connoted to the public any particular method of tracing the sound line, and there is evidence that it had come to denote a disc talking machine as opposed to the phonograph or graphophone which operated a cylinder record. The *Berliner* Patent of 1887 expired shortly afterwards, and upon such expiry everybody became entitled to make disc machines according to *Berliner's* 1887 Patent either by the etching or the graving method, and so far as I can see to put them on the market as gramophones, the name given by the inventor to such machines. Both the *Tainter and Bell* Patent and the *Berliner* Patent having expired, a number of disc machines made by various manufacturers came on the market, but were not sold as gramophones, but under various fancy names such as "Dulcephone," "Coronophone," etc. No one except the Applicant Company sold disc talking-machines as "Gramophones."

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

The Application came on for hearing before Mr. Justice PARKER on the 7th of June 1910.

Walter K.C., *Mark Romer* K.C., and *J. H. Gray* (instructed by *Broad & Co.*) appeared for the Applicants; the Solicitor-General (Sir *Rufus Isaacs* K.C.) and *Sargant* (instructed by the *Solicitor to the Board of Trade*) appeared on behalf of the Board of Trade.

Walter K.C.—This is an Application under Section 9 (5) of the Trade Marks Act 1905 for leave to register the word "Gramophone." Apart from Section 9 (5), Sections 3 and 44 must be considered in connection with an application of this kind. [The three Sections were referred to in detail.] [PARKER *J.*—You are asking to register "Gramophone" in respect of what you call a gramophone.] Yes, that is perfectly true. The evidence will show that "Gramophone" means an instrument made by a particular firm. This case is similar to the cases of the Trade Marks "Kodak" and "Tabloid." In fact, the defences raised in the present case are all of them defences which were raised in the "Kodak" and the "Tabloid" cases. [PARKER *J.*—Were those Applications to put marks on the Register or to take off?] They were Applications to remove, but that makes no difference. There is no distinction whatever in law, whether the word was registered as a Trade Mark at the beginning of user, or afterwards, if the word is an invented word which has been associated throughout with the goods of the particular maker. [PARKER *J.*—That does not strike me as correct. It seems to me that to take a Mark off is essentially different from putting it on, because if the Application, that is made to take it off, is successful the Mark must have been put on wrongly in the first instance. The difficulty in cases, such as the "Tabloid" case and the "Vaseline" case, is that you have not to consider the state of affairs which existed at the date of the application to rectify, but the state of affairs when the mark was put on. None of this growth of popular usage is original.] What one has to consider is, whether or not there is a user of the word in connection with the trade, or whether it is a user due to the creation of a word which has achieved a great reputation. Is the penalty of success to be to deprive a person of his rights? [PARKER *J.*—What I have to decide in this case is simply and solely whether the word "Gramophone" at the present time is adapted to distinguish the Applicant Company's goods from the goods of others, and in considering that I must consider also the history of everything that has happened since the Applicant Company began business.] Yes, that is so. [Counsel then stated the history of the word "Gramophone," and also referred in detail to the "Tabloid" and "Kodak" cases (*Burroughs and Welcome* v. *Thompson and Capper* 21 R.P.C. 69, 22 R.P.C. 164; L.R. (1904) 1 Ch. 736; and *Kodak Ld.* v. *London Stereoscopic Company* 20 R.P.C. 337).]

Evidence was then given by *E. T. Lloyd Williams*, chairman of the Applicant Company, and by a large number of musical instrument dealers from different parts of the country. Their evidence was to the effect that in the trade "Gramophone" meant exclusively the machines produced and sold by the "Gramophone Company," and that it also meant the same to the public, though to a less universal extent.

Sir *Rufus Isaacs* S.G.—I think it will be best if I at once call my witnesses. But for the purpose of protection I take the point that on the evidence given on behalf of the Applicant Company no case is made out under the Section.

Evidence was given, on behalf of the Board of Trade, by *W. S. Samuel* assistant manager in the Phonograph and Gramophone Department of *Barnett*,

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

Samuel & Sons Ld., and by a considerable number of musical instrument dealers from different parts of the country. Their evidence was to the effect that the word "Gramophone" was a generic word, and was so used by the public.

Sargant.—No case has been shown for the Court to exercise its discretion in favour of allowing this registration. It is quite true that Section 44 safeguards any person from being interfered with who is already carrying on trade, and who in good faith uses any description of the character or quality of his goods, but Section 44 does not touch this case at all. The evidence clearly establishes that there was a word "Gramophone" in use as an English word long before the establishment of the Applicant Company. In *Berliner's* earlier American Patent of 1887 the word is undoubtedly used in the generic sense, so that the word must have been known in the English language earlier than that. In *Murray's* English Dictionary there is the use of it in 1888. In the "Times" newspaper of the 13th of January 1888 *Berliner's* "Gramophone" is spoken of. There is no evidence of the origin of the word, it is true, but of course it is clear enough what the derivation of the word is. In *Ogilvie's* Dictionary, both in 1902 and 1906, the word is used as a word of common meaning in the English language, without any sort of indication that it denotes the goods of one particular firm. The Applicant Company was formed in 1899, and in order to indicate the articles in which it was going to deal it called itself the *Gramophone and Typewriter Company*. In the Memorandum of Association the objects are described as "to deal in gramophones, phonographs," and so on, and throughout the Memorandum, and in the title of the Company, it is obvious that the word "Gramophone" is used generically. As time went on, this powerful Company made it part of its business to change the meaning of this word, and to filch the word for its own purposes from the English language. By actions, or threats of actions, it set itself to produce terror amongst the trade, and to establish that it was dangerous to use the word. It is plain on the evidence—particularly Mr. *Samuel's* evidence—that even among the trade in incautious moments the word is used generically. As regards the public, the attempt of the Company to appropriate the word has been entirely unsuccessful. It would seem that there are four possible different meanings of the word, but only one of them will do for the Applicant Company's case. First, the word means—and this is the widest meaning of all—"a sound-recording "and reproducing machine." Secondly, there is a more restricted meaning, viz., that of a sound-recording and reproducing machine which has the characteristic of employing a disc rather than a cylinder. Thirdly, it may mean a sound-recording and reproducing machine using a disc and made in special accordance with the *Berliner* Patent. Of course that is not sufficient for the Applicant Company, although they acquired that Patent, because ever since the "Linoleum" case (*Linoleum Company* v. *Nairn* L.R. 7 C.D. 834) it is recognized that if a name means the patented article, the owner of the Patent cannot at the expiration of his Patent say that the name of the article meant the article which he alone could make, and had reference to the article itself and not the manufacture thereof. That was quite recently recognized in *Bowden's Patent Syndicate* (26 R.P.C. 205). In order to succeed the Applicant Company must establish a fourth meaning of the word, viz., that it means the machine produced by themselves; and in their endeavours to prove that they have wholly failed as regards the public. In so far as this is an attempt to appropriate a portion of the English language, it is on all fours with the "Perfection" case (*Re Joseph Crosfield & Sons Ld. Application* 26 R.P.C. 837; L.R. (1910) 1 Ch. 130).

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

The question was also still more recently considered by the Court of Appeal in *Cassella's Application* (*ante*, p. 453.) The word must have entirely lost its original meaning before it can be registered (*Wotherspoon* v. *Currie* L.R. 5 H.L. 508 "Glenfield Starch"). The onus here is on the Applicant Company. They have to show that the word has been divorced from its original meaning in the English language and has assumed some artificial secondary meaning. That onus has not been discharged. On the question of the Court's discretion it would be *pessimi exempli* that wealthy traders should be encouraged to take a name from the article, and then seek to establish a monopoly of the name derived from the article itself. A great deal of stress has been laid on the immense expenditure incurred by the Applicant Company in advertising their goods and in pressing their claim to the word. That is a point against them; if the word by a natural process had come to denote their goods, and not goods of a class, that would have been a circumstance leading the Court to infer that the word was adapted to distinguish their goods from those of other people's; but, when whatever result there is, it has been produced by the methods the Court has heard of in this case, the circumstance that under those conditions a considerable body of persons have come to identify the word with the goods of the Applicant Company cannot really be considered. As to the point your Lordship raised during the course of the case, viz., that under the concluding words of Section 9 evidence cannot be adduced, unless the word has been used as a Trade Mark, there has not been any evidence whatever that the word "Gramophone" *simpliciter* has ever been used as a Trade Mark by the Applicant Company on any one of the articles manufactured by them.

Walter K.C. in reply.—The whole of this case and the evidence given in it has been framed upon the interpretation given to the Act by the Court of Appeal in the "Perfection" case (*ubi supra*). The evidence here comes up to the standard which was laid down by that Court as that in which the Court should order the Registrar to proceed to advertisement, and to allow the matter to come up for opposition in the ordinary course. This case has been fought by the Board of Trade on the assumption that the word "Gramophone" is part of the great territory of the English language. What evidence is there of this? There is no evidence of any user of the word until the advent of one *Berliner* in 1886 or 1887. The Company, from 1900 to 1910, have consistently by every means asserted the position that "Gramophone" meant their instruments. It seems to be argued that because they have done so their position is worse than if they had not done so. That view is contrary to every decision that has ever been given. Regard is always had to whether plaintiffs, in cases of this kind, have continuously been jealous to see that no infringements of their rights have taken place; it is only when they have been held to have slept upon their rights that they have been adjudged to have lost them. It is abundantly clear on the evidence that the whole trade uses the word "Gramophone" solely in connection with the goods of the Applicants. [PARKER *J.*—You cannot help using the word in a description of the nature of the goods. The registration of the Trade Mark must be in respect of certain specified goods, and the goods must be described. The registration confers the monopoly of the use of the registered word in respect of that class of goods. If "Gramophone" means only goods made by the Applicant Company, and is not here used in the descriptive sense, obviously the registration would be of no use to the Applicant Company, because it would not prevent anyone from using it for their own goods.] I quite agree that the word which connotes the Applicant Company's goods has also in fact denoted

a particular instrument. But until 1900 it never meant anything but a patented machine; it never had a wide general descriptive meaning. True it is that those who are wholly ignorant of what a "Gramophone" is have used the word to mean every speaking instrument. [PARKER *J.*—I think, in that case, the class of ignorant people is large and extends far. In a recent book of Mr. *Wells* he refers to three shops at the end of a village street "wallowing "in and out of insolvency in the hands of a bicycle repairer, a 'Gramophone' "dealer, and a tobacconist." He uses the word as meaning a dealer in a particular class of instruments.] Either he knows and uses the word rightly, or he does not know what a gramophone is and uses it in the loose sense in in which people talk of a pianola, a tabloid, or a kodak. The whole of the trade, both wholesale and retail, now recognise the Company's rights—how are traders to be put in any worse position than they are if the word is registered? As to the public, they had nothing at the time the Company's rights arose. The onus of establishing common user is on the Opponents. [PARKER *J.*—What do you say on the question as to how far advertising gramophones—meaning instruments of a certain class—is the use of the word as a Trade Mark? It is not as though they were called and advertised as "Gramophone Talking "Machines."] The word has always been used on the Company's packing cases, and it is also on the back of each record. That is clearly user of the word "Gramophone," and, on the evidence, I submit that the extent of the user of the word has been such that in fact the word has become sufficiently distinctive of the Company's goods to allow the Registrar to proceed to advertise.

Judgment was reserved, and delivered on the 5th of July 1910.

PARKER *J.*—An Application under Section 9 (5) of the Trade Marks Act, 1905, in effect admits that the word sought to be registered (not being a geographical name or surname) has some direct reference to the character or quality of the goods in respect of which it is proposed to be registered. The word which in the present case the Applicant Company proposes to register as a Trade Mark is the word "Gramophone," and the goods in respect of which the word is proposed to be registered are stated to be gramophones and sound recording and reproducing instruments, records, parts and accessories being apparatus in Class 8. Besides the admission involved in the Application it is in my opinion abundantly clear on the evidence that the word "Gramophone" has direct reference to the character of these goods. Whatever else it may connote it certainly denotes a talking-machine, and almost as certainly a talking-machine of a particular type. It can therefore only be registered in respect of talking-machines if, notwithstanding this, it be, in the opinion of the Board of Trade or the Court, a distinctive word, that is a word adapted to distinguish the talking-machines of the Applicants from those of other persons. In determining whether a word is distinctive the tribunal may, in the case of a Trade Mark in actual use, take into consideration the extent to which such user has rendered it in fact distinctive of the applicant's goods. The Applicant Company contends that the word "Gramophone" is a Trade Mark in actual use within the meaning of the Section, and has by such user become distinctive of the Applicant Company's goods, and is therefore adapted to distinguish such goods from those of other persons, and ought to be admitted to registration. [After stating the facts relating to the history of the word "Gramophone" ending with—"No one "except the Applicant Company sold disc talking-machines as 'Gramophones'" (see *ante*, page 690, line 16 to page 691, line 52) the learned Judge continued]: This may have been due, to some extent, to the fact that the Applicant Company

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

still held Patents for various improvements on *Berliner's* original invention, but it was also, in my opinion, largely due to the policy pursued by the Applicant Company. Ever since the expiry of *Berliner's* 1887 Patent the *Gramophone Company Ld.* has adopted the following policy:—On the one hand it has largely advertised its machines as "Gramophones," thus, so far as the public are concerned, continuing and emphasising the original use of the word "Gramophone" as the name of a particular sort of talking-machine, and its popular use as denoting a disc as opposed to a cylinder machine; on the other hand, in its dealings with the trade it has consistently claimed monopoly rights in the word as denoting goods of its own manufacture only, and by warning circulars, legal proceedings, and threats of legal proceedings, has done its best to support the monopoly claimed. This policy is quite intelligible, for no monopoly can be more valuable than a monopoly in a word which the public use as the name of a particular article, but the trade consider to be the name of that article when made, and only when made, by a particular manufacturer. I do not think I need examine in detail the mass of evidence produced at the hearing. It will, I think, be sufficient to say that upon the evidence before me I am satisfied that the *Gramophone Company Ld.* have met with a considerable degree of success in both branches of the policy adopted by them.

On the one hand, distinguishing the public from the trade, it is, in my opinion, clear that to the general public the word "Gramophone" now denotes a talking-machine with disc as opposed to cylindrical records, that is a particular type of talking-machine, and denotes this without any connotation of the source of manufacture. In this sense the word has found its way into Dictionaries, is used in Patent Specifications, Newspapers, and other current literature, and can be found even in the arguments of Counsel and the decisions of Judges of the High Court. On the other hand, I think it is equally clear that, to the trade generally, the word, while it still denotes a talking-machine of a particular type, connotes also the source of manufacture of such machines. A retail dealer enquiring of a wholesale firm the prices of "Gramophones" would almost certainly mean the prices of disc machines manufactured by the Applicant Company, but a member of the public making the same enquiry of a retail dealer would almost as certainly mean the prices of disc machines by whomsoever made. No doubt, as one would expect, it is easy to find exceptions to these generalisations. A member of the public who has had experience in the purchase of talking-machines, or has made enquiry with a view to such purchase, might easily become acquainted with the connotation involved in the word "Gramophone" among dealers, and, on the other hand, dealers in their transactions with members of the public might easily use the word, as the public use it, without any reference to the source of manufacture, whereas in their transactions with other dealers the connotation of the source of manufacture would be constantly present to their minds. Of course, too much stress ought not to be laid on occasional looseness of language, but I am satisfied that the use of the word "Gramophone" by the public as denoting the machine, without any connotation of the source of manufacture, is general and not occasional only, and I am equally satisfied that the use of the word by traders amongst themselves, without any connotation of the source of manufacture, is not general, but occasional only. For purposes other than trade purposes, however, even a person in the trade may readily use the word as denoting the article simply without further connotation. Indeed, how difficult it is even for those concerned in the trade to use the word "Gramophone" as always connoting the source of manufacture is well shown by the fact that

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

the Applicant Company has not been able to avoid the use of the word in describing the class of goods for which it seeks to register the word "Gramophone," and for which, some years ago, it applied for, and obtained, the registration of its Trade Mark known as "His Master's Voice." An Application to register a Trade Mark for gramophones contemplates that gramophones may be made by others; for to limit the class of goods in respect of which registration is sought to goods of the Applicants' manufacture would, of course, be absurd. Further, in both Applications the Applicant Company could apparently find no appropriate description of their business other than that of gramophone manufacturers.

Starting, therefore, with a word used to denote a particular sort of article from the manufacture of which the Applicant Company and their predecessors, one and all, derived their trade name, we find that the word in question, so far from losing its original signification, has become popularised, largely owing to the advertisements of the Company, as the name of that particular sort of article, though among traders the word, while still denoting the article, also generally connotes the manufacturer. The question is whether under these circumstances the word "Gramophone" ought to be admitted to registration as a word adapted to distinguish the Applicants' talking-machines from those of rival manufacturers.

Taking the word "Gramophone" on its own merits, and as it is used by the Applicant Company in their Application for registration, and finding that it is the name of a particular sort of article, I cannot see that it is in itself more adapted to distinguish that article when made by one person from the same article when made by another than, for example, the word "match" would be adapted to distinguish the matches of one manufacturer from the matches of another. In itself, therefore, the word "Gramophone" would be no more registrable for gramophones than the word "match" for matches. In other words it could not on its own merits be deemed distinctive within the meaning of Section 9 (5). Everything therefore turns upon the question whether the word has become distinctive by user, and, if so, how far the Court is to be influenced by that fact.

It is to be observed that it is only in the case of a Trade Mark in actual use that the Court or the Board of Trade is authorised to take into consideration how far a word has become distinctive, and its acquired distinctiveness must be due to "such user," that is, I think, to user as a Trade Mark. A Trade Mark is defined in Section 3 as including, first, a mark used and, secondly, a mark proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such mark. Apparently it is only in the former case that evidence of user is admissible under Section 9 (5), and therefore in my opinion the user, of which evidence is given, must be user upon or in connection with goods for the purpose of indicating that such goods are the goods of the person so using the mark, and the acquired distinctiveness must be due to such user.

I have considerable doubt whether the Applicant Company has ever used the word "Gramophone" upon or in connection with disc talking-machines for the purpose of indicating that such machines were of its manufacture. In advertising its gramophones it has used the word as the name of the article, and not to distinguish the article when made by it from the same article when made by others. This seems to me to be the very reverse of user as a Trade Mark. No talking-machine ever made by the Applicant Company has ever been marked with the word "Gramophone." On the contrary every machine so

made has been marked with one or other of the Applicant Company's registered marks such as "His Master's Voice." It is true that the records of the Applicant Company have borne the word "Gramophone," but only accompanied with some registered Trade Mark, and in such manner as to suggest a record for use on the instrument called the "Gramophone" and not a record made by the Applicant Company as distinguished from a record made by anyone else. The nearest approach that I can find in the evidence to the use of the word "Gramophone" as a Trade Mark is its use by the Applicant Company on their packing cases, which have always been marked "Gramophone" in large letters. Further upon the evidence before me the connotation, which the word "Gramophone" bears among dealers, seems to me to be due not to its use by the Applicant Company as a Trade Mark, but to the long continued insistence by the Applicant Company upon their monopoly rights in the word, backed by warning circulars, legal proceedings, and threats of legal proceedings. I am convinced that the risk of an expensive litigation with a wealthy Corporation has been no small inducement to dealers to acquiesce in the rights insisted on.

Assuming, however, that the word has in the trade become distinctive under circumstances which I can properly take into account, there still remains the question whether the application to register it as a Trade Mark ought to be allowed to proceed. As to this it appears from the judgments of the Court of Appeal in the *Perfection Soap* case (26 R.P.C., 854) that even where a word proposed to be registered has acquired a large degree of distinctiveness by user as a Trade Mark the Court has a wide discretion in granting or refusing permission to proceed with an Application for its registration. In that case the word "Perfection," as applied to soap, had acquired, by user as a Trade Mark, both in the trade, and to some degree also among the public, a secondary meaning connoting the soap of the persons applying for registration. The Application was refused in the exercise of the discretion of the Court. The word was a mere laudatory epithet likely to be required by others to describe their goods, and a monopoly in the use of which could not fairly be granted to any single manufacturer. It is to be observed that this reasoning prevailed notwithstanding Section 44 of the Act, under which, even after registration, any trader might have used the word "Perfection" in any *bonâ fide* description of his own wares. Lord Justice *Fletcher Moulton* was of opinion that the Court might well ask itself the question whether, having regard to the rights of others under Section 44, the registration of the mark would cause substantial difficulty or confusion, and apparently he was of opinion that it would.

The provisions of Section 44 were pressed upon me as affording a reason for allowing registration of the word "Gramophone." The rights of other traders, it was said, were fully protected by this Section. The argument is somewhat double-edged. It suggests that others may *bonâ fide* require to use the word "Gramophone" to describe the goods sold by them. In my opinion this is not at all unlikely. If the word "Gramophone" primarily means, as I think it does, a particular type of talking-machine irrespective of the maker, and if the public enquires, as I think they do, for this type of machine under this name, I can well believe that retail traders may desire to describe the goods they sell under the name by which such goods are known to the public. The circumstances may, of course, be such that it is incumbent upon them to make it clear that the goods, to which they apply the word, are not the goods of the Applicant Company, but if they do this I cannot see how the use of the word could be dishonest in the sense of likely to deceive.

REPORTS OF PATENT, DESIGN, AND TRADE MARK CASES.

In the Matter of an Application by the Gramophone Company Ld. to Register "Gramophone" as a Trade Mark.

It is, however, the use of the word to describe any instrument not made by it to which the Applicant Company objects, and which they have for years been seeking to stop, and there can be no doubt that, in spite of Section 44, the registration of the word as a Trade Mark would facilitate the end in view. If I were to advertise asking gramophone makers to tender for the construction of twenty gramophones of a particular size, and according to a particular specification, there would be nothing absurd or peculiar in the advertisement. Everyone would understand its meaning. No one would think the invitation to be addressed only to the Applicant Company. Suppose in answer to my advertisement someone wrote that he had in stock and could supply me with twenty gramophones of the exact size and make required, I should understand the answer perfectly, and should not necessarily expect goods of the Applicant Company's manufacture. There would be no room for a passing-off action based on some implied misrepresentation. Again, suppose a dealer advertised for sale "Gramophones by all the chief manufacturers, including the *Gramophone Company Ld.*," his meaning would to any ordinary members of the public be perfectly clear, and he would be guilty of no misrepresentation express or implied. On the other hand, if the word "Gramophone" were registered as a Trade Mark, I am not sure that in either of the cases which I have supposed the monopoly conferred by registration would not be infringed, and, if Section 44 were relied on as a defence, the question would at once arise whether the use of a word known to be on the Register as a Trade Mark could be *bonâ fide* within the meaning of the Section.

If a laudatory word such as "Perfection" ought not to be admitted to registration, although among the trade it has become distinctive of the goods of a particular manufacturer, it seems to me to follow *a fortiori* that the name by which an article is popularly known ought not to be admitted to registration as a Trade Mark for that article, although in the trade it may have come to connote the source of manufacture. It may be asked, and was in effect asked at the hearing, why such words as, for example, "Pianola" or "Vaseline" should be on the Register as Trade Marks if "Gramophone" were refused registration? The answer is not far to seek. None of the earlier Trade Mark Acts provided machinery for taking a mark off the Register, if once it had been properly put on, and it is quite unnecessary, in an action for infringement of a registered mark, to prove that such mark still remains distinctive of the goods of the registered proprietor. It may, therefore, be in the interests of the registered proprietor of a word mark (subject of course to any question arising under Section 37 of the Act of 1905) that the word should lose its distinctiveness so far as the public are concerned and become the popular name for the article. He thus obtains a practical and perpetual monopoly in the article itself, other manufacturers being precluded by the mark on the Register from selling their goods under the name by which they are commonly known. To induce the public to adopt a catching word as the name of the article to which it is applied, especially if the article be comparatively new, it is only necessary to advertise the article on a sufficiently large scale under that name, and this can be done by any rich Corporation. Such a procedure would be or might have been fatal to any remedy based upon common law rights, but (subject to Section 37) does not affect the value of a registered mark the distinctiveness of which is assumed and never need be proved. Indeed, in action for infringement, no evidence to prove that a registered mark was no longer distinctive would be in any way relevant. The old action for infringement of a common law Trade Mark was based only on the duty of the Courts to prevent fraud and deceit,

and the loss of distinctiveness was, therefore, fatal to its success. It is, however, one thing to put a word mark on the Register, and then proceed to induce the public to use it as the name of the article to which it is applied, and quite another thing to adopt a word already used to denote a particular article, and then proceed to identify it among the trade with the goods of a particular manufacturer, relying on such identification as a reason for registration. For the purpose of putting a mark on the Register distinctiveness is the all important point, and in my opinion if a word which has once been the name of an article ought never to be registered as a Trade Mark for that article, it can only be when the word has lost, or practically lost, its original meaning. As long as the word can appropriately be used in a description of the articles or class of articles in respect of which a Trade Mark is proposed to be registered, so long in my opinion ought the registration of that word for those articles, or that class of articles, to be refused. There was, and would be now, no inappropriateness in applying to register "His Master's Voice" as a Trade Mark for gramophones. Apparently the Applicant Company sees nothing inappropriate in applying to register the word "Gramophone" for gramophones. That this view seems to be supported by the trade only shows how profoundly the general notion of the functions of a Trade Mark has been modified by trade mark legislation. The notion of distinguishing gramophones made by the proprietor of the Trade Mark from gramophones made by others, in other words, the original and legitimate function of a Trade Mark, appears to be entirely lost in the idea of a trade monopoly in the name of an article, a monopoly which it appears to be thought anyone who can afford it may secure by spending enough on advertisement, and of which, quite apart from any deceit or misrepresentation it would be dishonest after such expenditure to attempt to deprive him. That it may be impossible to take a registered mark off the Register, even although it has ceased to be used for the legitimate purpose of a Trade Mark and has become merely the name of an article, is, I think, no reason for allowing one trader to register and secure a monopoly in what is already the name of an article, although every trader in the Kingdom might, for some reason or another, have already recognised or been willing to recognise such monopoly.

I have come to the conclusion, therefore, that the Application to register the word "Gramophone" ought not to be allowed to proceed, and I accordingly dismiss the Application with costs.

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