

them. That the pursuer obtained these warrants from anyone with whom he contracted in November and December 1882 and in April 1883 he does not say. If he did not, the possession of the warrants which he had in November 1883, supposing the fact proved, which is doubtful enough, has no bearing whatever on this question. The same remark applies to the sale in April 1884, and indeed these last were certainly bought in the market. If the pursuer had explained where he got these warrants, and what he paid for them, probably some light would have been thrown on the transaction. Such warrants are always to be had in the market, on payment of the market price, but not otherwise. He will not say—it was not necessary that he should—that these last warrants were the same as those which he had in November 1883. They are not ear-marked, but there is nothing whatever proved to show that they were not purchased in the market the day before the sale. The pursuer in accepting the instructions of the defender was no doubt exposed to one or other of two alternative risks. These would have been of little consequence in an ordinary trade transaction, in which the object was the acquisition of the commodity for commercial purposes. But the pursuer could not have supposed that such was the object of this order. He might perhaps have taken the position under it of seller of the goods as his books represent him to have been, and of course in that case he would have been entitled in his own right to the differences and charges for which he sues. But the pursuer vehemently repudiates this position, for then he would have been the principal in the contract, or possibly liable in any exceptions pleadable against a principal. His statement, therefore, is—and it is the only state of fact on which he can prevail in this action—that he bought as broker from a third party. But he could only do so by becoming responsible to that third party for the differences and charges in question, whether he received them from his client or not. Hence perhaps the obscurity in which a very simple matter of fact has been veiled. I am of opinion that the pursuer has failed to establish the case alleged by him on this record, and that we should alter the judgment of the Sheriffs in the Court below and dismiss the action.

LORDS YOUNG and RUTHERFURD CLARK were absent.

The Court found that the pursuer had failed to prove that the purchases of iron libelled were made; therefore sustained the appeal, recalled the interlocutors of the Sheriffs, and dismissed the action, with expenses.

Counsel for Pursuer—R. V. Campbell—Jameson. Agents—C. & A. S. Douglas, W.S.

Counsel for Defender—Orr. Agents—W. Adam & Winchester, S.S.C.

Friday, October 16.

SECOND DIVISION.

STUART & COMPANY v. THE SCOTTISH VAL DE TRAVERS PAVING COMPANY (LIMITED).

*Trade-Mark—Trade-Marks Registration Act 1875 (38 and 39 Vict. c. 91)—Patents, Designs, and Trade-Marks Act 1883 (46 and 47 Vict. c. 57)—Distinctive Device—Common Use—Infringement of Trade-Mark.*

A firm of pavement manufacturers who had produced an artificial stone of concrete granite to which they had given the name "Granolithic," registered a trade-mark, under the Trade-Marks Registration Act of 1875, consisting of a device together with the words "Stuart's Granolithic." After the passing of the Patents, Designs, and Trade-Marks Act of 1883 they registered as their trade-mark the name "Granolithic" alone. By that time the word "granolithic" had come into common use as denoting a kind of concrete, irrespective of the maker. They sought to interdict a rival firm from the use in their trade circular of the word "granolithic" as describing a kind of artificial stone pavement, on the ground that this was an invasion of their trade-mark. *Held* that the defenders' circulars constituted no invasion of trade-mark, since the use of the word "granolithic" was only a description of a particular kind of article, and did not induce the public to believe that what was supplied was of the pursuers' manufacture.

In 1880 Messrs Stuart & Co., who had been successful in producing an artificial concrete stone for paving purposes, registered as their trade-mark a lion rampant holding a shield on which was inscribed the words "Stuart's Granolithic." This was done under the Trade-Marks Registration Act 1875. After the passing of the Patents, Designs, and Trade-Marks Act 1883 they determined to register a fancy name alone as their trade-mark, and they registered in 1884 as their trade-mark the word "Granolithic" alone.

They raised this action against the Scottish Val de Travers Paving Company (Limited), Glasgow, praying the Court "to interdict the defenders from using the word 'granolithic,' or any colourable imitation thereof, in connection with the manufacture and sale of artificial stone pavements, or otherwise infringing the pursuers' registered trade-marks," consisting of (1) the words "Stuart's Granolithic" on a shield held by a lion, and (2) the fancy word "Granolithic" alone, "by making or selling or using labels, wrappers, or invoices, or any other document with the said trade-mark thereon, or colourable imitation thereof, in connection with the manufacture or sale of the goods or class of goods included under class 17 of the first schedule, framed in virtue of section 7 of the Trade-Marks Registration Act 1875, and more particularly with reference to the manufacture and sale of artificial stone pavements." They also claimed £500 damages.

They averred as follows in Cond. 6—"The pursuers have recently learned that the defenders have been offering to supply artificial stone pavements under the name of 'granolithic,' and have issued circulars and price lists in which the

word 'granolithic' is used to describe a particular class of artificial stone pavement."

The defenders stated—They had, in common with various other manufacturers, made an artificial stone, which had been for several years commonly known, especially among architects and builders, as "granolithic" or "granitic." For many years prior to 1880 the word "granolithic" was used by manufacturers to describe a composition of a somewhat similar nature to the artificial stone referred to. They stated further—“(Stat. 4) The word ‘granolithic’ is a descriptive word, which accurately describes the nature of the artificial stone referred to, and is not a valid trade-mark within the meaning of the Patents, Designs, and Trade-Marks Act 1883, and was registered or is continued on the Register of Trade-Marks through error.” “(Stat. 5) Between the date of the pursuers’ first application to register on 2d February 1880 and their second registration in 1884 the word ‘granolithic’ was in common use by the public to describe the artificial stone referred to, and has no special application to the pursuers’ manufacture. Accordingly, prior to said registration the defenders issued to their customers and to the public the circular and price list complained of. Said circular merely intimates that ‘the laying of granolithic or granite-faced concrete in the monolithic form for foot-pavements, . . . &c., receives the special attention of the company,’ and then goes on to describe the composition and mode of laying the granolithic or granite-faced concrete pavement. This is the sole use which the defenders have made of the name ‘granolithic.’”

The pursuers pleaded—“(1) The pursuers, as owners of the said respective trade-marks, are entitled to protection against infringement thereof. (2) The pursuers, having coined the said fancy word ‘granolithic’ for the purpose of identifying their manufacture of artificial stone pavement, and so used it, are entitled at common law to prevent the use of the same for a like purpose by others. (3) The actings of the defenders complained of constitute an infringement of the pursuers’ rights in the said respective trade-marks, and the pursuers are entitled to interdict as craved.”

The defenders pleaded—“(1) The pursuers having no exclusive right to use the name ‘granolithic’ to describe the stone manufactured by them, interdict ought to be refused. (2) The defenders having committed no infringement of the pursuers’ rights, are entitled to absolvitor. (3) The word ‘granolithic’ does not come within the definition of a trade-mark under the ‘Patents, Designs, and Trade-Marks Act 1883.’ (4) The word ‘granolithic’ being only a colourable imitation of the word ‘granoline,’ which was in common use prior to 1880 for describing a composition almost identical with the pursuers’, is not entitled to be protected as a trade-mark. (5) The word ‘granolithic’ being a descriptive word in common use to describe a certain kind of artificial stone by whomsoever manufactured, and having no distinctive application to the pursuers’ manufacture, interdict should be refused.”

Proof was led, the import of which very fully appears in the Sheriff-Substitute’s note, and in the opinions of the Judges.

The Sheriff-Substitute (ERSKINE MURRAY) found

—“(1) That the pursuers Stuart & Company and the defenders the Val de Travers Company are rival manufacturers of a concrete formed of a combination of crushed granite and Portland cement: Finds (2) that pursuers registered in 1880 a trade-mark of a lion rampant holding a shield, on which was inscribed the words ‘Stuart’s Granolithic,’ the name granolithic being invented by pursuers and their friends: Finds (3) that thereafter the name came into common use by architects, measurers, and others issuing schedules, not only to pursuers, but to other manufacturers, as denoting a concrete of crushed granite and Portland cement irrespective of the makers: Finds (4) that a new Act having allowed the registration of a fancy name, the pursuers in 1884 registered as their trade-mark the name ‘Granolithic,’ pure and simple: Finds (5) that the defenders, since the issuers of schedules, as above, took to using the word, have been in the habit of offering under such schedules, and have also issued to their trade customers a circular, stating as part of their business the laying of ‘granolithic,’ which they describe, and of which they give their price: Finds (6) that pursuers have raised the present action, alleging that defenders are infringing their rights, to interdict them from doing so, and for damages: Finds on the whole case and in law, that the pursuers have failed to establish grounds for the granting of the interdict sought: Therefore assolvies defenders from the craving of the petition, and decerns, &c.

“*Note.*—The use of concrete for paving purposes is as old as the days of the Romans. Of late, however, it has taken a fresh start under various forms and names. The usual basis was a mixture of cement with sand or gravel. But by degrees it was found that crushed granite was a fully better material than either of the latter. It formed an element of the composition of Ransom’s Silicious Stone, of Buckwell’s ‘Granitic Breccia Stone,’ and of the defenders’ ‘Victoria Patent Silicated Granitic Stone,’ where it was mixed with Portland cement, which manufacture was commenced by the defenders the Scottish Val de Travers Company about 1879. The manufacture therefore of a concrete formed by a mixture of crushed granite and Portland cement laid on a foundation of various kinds is therefore a matter which is free to all the world.

“The pursuer Mr Stuart and his family have long been connected with the manufacture of concrete in Peterhead and Edinburgh. He adopted crushed granite mixed with Portland cement as his chief manufacture about 10 or 12 years ago. Till 1880 he made it under the name of granite concrete. Desiring to get a special name for his own manufacture he consulted various distinguished Greek scholars—one of them suggested ‘granilithic.’ By the mistake of a clerk this was written ‘granolithic.’ This was at once adopted by the pursuers, who got it registered as a trade-mark in November 1880, with the device of a lion rampant supporting a shield, on which the words ‘Stuart’s Granolithic’ were printed. The device was used in obedience to the Act then in force, by which the registration of a mere name was not sufficient. The pursuers had applied for this registration some months previously, and largely advertised their manufacture under the name ‘granolithic,’ not only in Scotland but all over the world.

“The name ‘granolithic’ was a great success. It not only implied that the material was granite, but that it was as hard as a stone. Even the mistaken ‘o’ added solidity and apparent strength. ‘Granolithic’ sounds better than ‘granite concrete,’ and explains what is wanted far better than ‘Victoria Stone.’ So the ink of pursuers’ registration of their new name was hardly dry before architects, builders, and measurers began to use it when they meant granite concrete. In issuing their schedules they inserted the word ‘granolithic’ when they wanted offers for granite concrete. In a few cases, no doubt, of those where the item was a small one in a large schedule sent out to a mason or builder, whose main work was of a different nature, it may have been in the contemplation of those who issued the schedule that the contractor would make a sub-contract with Stuart for the execution of the granolithic. But in the great bulk of cases the issuers of the schedules simply meant that they wanted offers to supply the thing which they knew by the name ‘granolithic,’ viz., a concrete of Portland cement and granite quite irrespective of the person who made it. Indeed they issued such schedules to various manufacturers, including pursuers and defenders, shewing unmistakably that what they meant by granolithic was the thing irrespective of the maker. This state of things lasted two or three years, and the name ‘granolithic’ thus came into general use as a name for the thing produced, viz., a granite concrete irrespective of the maker’s name. No doubt in places where no other granite concrete was known than pursuers’ the name ‘granolithic’ was only in connection with pursuers’ manufacture, but where other manufacturers made the same thing, architects and others asked them to offer for it under the name ‘granolithic,’ and the offers of many other offerers besides pursuers were accepted in such circumstances. In some quarters there seems to have existed a mistaken idea that the thing itself was patented, and therefore that the pursuers were the only people who had a right to make it. Mr Purchas, for instance, of Worcester, says that if he had got defenders’ circular he would have supposed that they had got a licence from pursuers to lay granolithic pavement. But this was not so in Glasgow, where a number of manufacturers have competed with pursuers for contracts for which granolithic was wanted.

“A new Act having passed authorising the registration of names as trade-marks, the pursuers on 29th April 1884 applied for registration of the word ‘granolithic’ by itself as a trade-mark, which was registered. By this time, however, the word was in general use among architects, builders, and measurers as applied to the manufacture not only of pursuers but of other manufacturers.

“In these circumstances the defenders the Scottish Val de Travers Paving Company have issued to their trade customers the circular or advertisement. Their name is set forth boldly on the title-page. After describing various modes of paving and concrete which they manufacture, they go on to say on their second page—‘The laying of granolithic or granite-faced concrete in the monolithic form receives the special attention of the company.’ Again on page 3, under their price list, they give a heading—

‘Granolithic or Granite-faced Concrete Pavement,’ which they then describe, and of which they give the price.

“The pursuers, considering the defenders’ act in ‘offering to supply artificial stone pavement under the name of granolithic, and in issuing circulars and price lists in which the name granolithic is used to describe a particular class of artificial stone pavement,’ an infringement of their trade-marks, have raised the present action to have them interdicted from doing so, and for damages. They do not, however, ask for more than nominal damages.

“Now, in the first place, it falls to be remarked, as matter of fact, that there is really no question here of the defenders misleading, whether intentionally or unintentionally, any person whatever into believing that they were getting Stuart’s article, when they were really getting the defenders’ article. As regards the offers in answer to schedules sent to them, the issuers knew well that what they would get from the defenders would be their own manufacture, not Stuart’s. As regards the circular, it is perfectly plain, and none but an idiot would suppose that the granolithic there referred to was anything but defenders’ own work. Even Mr Stuart himself cannot say that it would.

“Nor is this a case where, though the original wholesale buyers of an article are not deceived, subsequent retail buyers may be deceived, as in the cases of the Eureka shirt (*Ford v. Foster*, L.R. Ch. App. vii. 611), and the Elephant mark (*Johnston v. Orr Ewing*, 7 App. Ca. 219). In these cases the interdict was granted because retail buyers might be deceived. But here no such question can possibly arise. The article is laid down as between parties who knew well what it is and whose it is. After it is once laid down there is no question any more about it; it does not pass through any more hands at all. So the question of intentional or unintentional misleading, whether as regards the original parties contracting or any other purchaser, falls to be eliminated together. Such being the facts the law applicable to them falls to be considered.

“What is the essence of the right to the exclusive use of a trade-mark? The answer is to be found in the remarks of Mr Justice Mellish, in the Eureka case above quoted, when he explains that the right to a trade-mark is simply a trader’s right to prevent his being cheated by other people’s goods being sold as his goods. In the same case it is laid down that a fancy name originally appropriated by a maker to his own peculiar manufacture may become *publici juris*, so that anyone may use it, the test being, whether the use of it has ceased to deceive the public as to the maker of the article. On these two principles the whole law of trade-marks hangs, and the various decided cases may be strung on them like beads on a chain.

“In one class of cases, of which *Seixo*, L.R. Ch. App. i. 95, and *Wotherspoon*, L.R., H. of L., v. 508, are types, the evidence disclosed that there was a manifest intention by the use of a name, *Seixo* in the one case, *Glenfield* in the other, to induce purchasers to believe that they were getting an article made by the parties originally using the name, when they were really only getting an article made by imitators, and

were thus misled, to the original maker's disadvantage. Interdict was granted.

"In a second class of cases such as *Singer v. Wilson*, L.R. 3 App. Ca. 376, and *Dunnachie* (the *Glenboig* case), 10 R. 874, the intention to deceive was not so manifest. But it was held that by the adoption of the name by the second parties without any intention to deceive, buyers might nevertheless be deceived, and that the first parties had a right to protect themselves against the loss arising from such a misconception, by asserting their exclusive right to the name. Proof of actual injury was not required; but proof of a reasonable apprehension of injury. In this class falls also to be placed *Singer v. Kimball & Morton*, 11 Macph. 267; for though capable to a hasty reader of a wider interpretation, the House of Lords in *Singer v. Loog*, afterwards quoted, explain that this is the ground on which that judgment can be upheld. In these cases also interdict was granted.

"In a third class of cases, such as *Johnston v. Orr Ewing*, *Ford v. Foster* above quoted, and *Blair v. Stock*, L.T., 52 N.S. 123 (the *Strathmore Blend* case), the original buyers from the second parties could not have been deceived into believing that the articles were of the first parties' manufacture. They knew well whose goods they were getting. But then the general public, to whom they re-sold, might easily be deceived into believing that they were getting the manufacture of the original makers. Here also interdict was granted.

"But in the fourth class of cases, of which *Singer v. Loog*, 8 App. Ca. 15, is a type, there was neither an intention to deceive nor any reasonable ground for apprehension that any purchaser might be misled. It was there held that a trader has a right to make and sell machines similar in form and construction to those of a rival, and even in advertising to refer to his rival's machines and rival's name, as long as he does so in such a way as to obviate any reasonable possibility of misunderstanding or deception. He is not allowed, indeed, to put on his machines a brass plate with his rival's name, because that might deceive ordinary retail customers; but he may, in advertisements intended only for wholesale traders, and that would not be likely to come into private hands, advertise his goods associated with his rival's name, as Loog did, referring to 'our Singer Machine.' The reason is, that no purchaser of the class to whom alone these documents were issued could possibly be misled into supposing that the machines they referred to were the Singer Company's Machines. The Singer Company contended that deception or even unintentional misleading were not essential. But as Lord Selborne laid down—'The reputation acquired by machines of a particular form or construction is one thing; the reputation of the plaintiffs as manufacturers is another. If the defender has no right under colour of the former to invade the latter, neither have the plaintiffs under colour of the latter to claim in effect a monopoly of the former. If the defender has a right to make and sell articles similar to the plaintiffs, he has a right to say so, and to employ the terminology common in his trade, if he does this in a fair, distinct, and unequivocal way.'

"The fifth and last category is where a name, originally restricted to the goods of a particular

manufacturer, has come into such common use as to be *publici juris*, so that anybody is justified in using it for his own manufacture. Such a position of matters is referred to in several of the cases already quoted

"Now, the present case, if it does not fall under the last category, clearly falls under the fourth. There is neither intention to deceive nor any misleading at all. The parties getting defender's offers, or getting defenders' circular, knew whose goods were offered to them; so the first and second categories are excluded. By the very nature of things the third is excluded, as the article under consideration cannot pass from hand to hand like Eureka shirts, but when once laid, becomes a part of the premises and there is an end of the matter. Adjusting Lord Selborne's words in *Singer v. Loog* to the present case—'The reputation acquired by' a concrete formed of crushed granite and Portland cement, 'is one thing, the reputation of the pursuers as the manufacturers of it is another. If the defenders have no right, under colour of their right to take advantage of the former, really to take advantage of the latter, neither have the pursuers a right under colour of defending the latter to claim in effect a monopoly of the former. As the defenders have a right to make and sell a concrete similar to the pursuers, they have a right to say so, and to employ the terminology common in their trade, if they do this in a fair, distinct, and unequivocal way.' Here the fairness and distinctness of defenders' offers and circulars is undeniable. Interdict, therefore, cannot be granted.

"The defenders indeed go further, and maintain that the position of matters is that described under the last category of all. There is a good deal to be said for this contention. It must be remembered that up to 1884 a fancy name alone could not be registered as a trade-mark. Granolithic was not till then a registerable trade-mark, and by that time it was in pretty common use by architects, measurers, and builders as a name for concrete of crushed granite and Portland cement irrespective of the makers. Now a word in common use cannot be effectually registered. Against this, on the other hand, it may be argued that so far at least as manufacturers were concerned, the use of the word was in general only a half-hearted and timid sort of a use, as of something for which they were conscious they might be called to account. It is true that when Stuart & Co. knew that any manufacturers were openly using the word on their own account they have taken steps against them. But they have winked at its use by architects and other issuers of schedules for fear of injury to themselves. By so doing, however, they have more and more allowed the word to come into general use. For when the parties on one side of a contract are allowed to use it it is impossible to exclude the parties on the other side from doing so.

"On the whole, however, the Sheriff-Substitute prefers to base his judgment on the ground that the case comes under the fourth category, that of *Singer v. Loog*. The word 'granolithic' is perhaps in that stage of development rather than the fuller and more advanced stage of the fifth."

The pursuers appealed, and argued—The case must not be dealt with as a trade-name, in which case it would be necessary to consider the use to see whether it was calculated to deceive, but

simply as a trade-mark properly registered. The name was one private to the pursuers to begin with, and between 1880 and 1884 no one could have used it without tending to deceive on account of the pursuers' registration under the 1875 Act. Section 76 of the Patents, Designs, and Trade-Marks Act 1883 provides that subject to the provisions of the Act registration shall confer on the registered owners the exclusive right to use the trade-mark. After 1884, then, when registration was effected under this Act, the pursuers got the exclusive use of the name, and from that date such circulars as the defenders' were illegal. The pursuers could establish the two propositions which were essential to the idea of "exclusive right" in the sense of the statute—(1) That the trade-mark had not at the date of registration become *publici juris*, or in common use, and (2) that it had not been infringed. There was no real distinction to be drawn between advertisements and circulars containing the trade-mark and a trade-mark used upon the machine sold, the one being just as likely to be as injurious as the other, and it was not necessary for the pursuers to aver or prove fraud in order to obtain protection for their trade-mark—*Singer v. Wilson*, November and December 1877, 2 L.R., Ch. Div. 434, and 3 L.R., App. Ca. 377, especially the opinion of Lord Cairns, p. 389. Section 76 of the 1883 Act provides that registration of a trade-mark shall be *prima facie* evidence of the exclusive use of a trade-mark, and shall, after the expiration of five years from the date of registration, be conclusive evidence of right to the exclusive use of the trade-mark, subject to the provisions of the Act. While it might be competent to overcome the presumption by action here other than the statutory action of section 90, yet for the purposes of a mere possessory question such as interdict, the *prima facie* fact of registration must rule, and the question of the pursuers' exclusive right was not now open to challenge.

The defenders replied—The Acts did not allow a person to take any word to their exclusive use. Sub-section c of clause 64 of the 1883 Act provided that a trade-mark must consist of "a distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use." It was laid down in *Leonard & Ellis v. Wells*, February 1854, 26 L.R., Ch. Div. 288, that a distinctive word within the meaning of the Act must be a word intended to distinguish the article manufactured by one person from similar articles manufactured by others, and not a word merely descriptive of the articles themselves. The word here was merely descriptive of a particular kind of stone which was in common use in commercial circles. The pursuers' trade-mark was thus bad as lacking two essentials of the statute. But further, the defenders did not advertise the stone under any name which could create a reasonable possibility of misunderstanding or deception—*Singer v. Loog*, December 1882, 8 L.R., App. Ca. 15.

At advising—

**LORD JUSTICE-CLERK**—In this case the Sheriff-Substitute has applied himself to the subject-matter of dispute with very great care, and in his very able note has fully explained the grounds of the judgment which he has delivered. Without say-

ing that I altogether agree with all the observations he has made in his note, I think substantially the judgment is perfectly right, and that on the grounds which he has fully explained. I can express my own view very shortly.

This is not an action under the Act of 1875 for the vindication of a trade-mark exhibited by a design or a device. It is an action in respect of an alleged violation or infringement of a trade-name, used as a trade-mark, and registered under the Statute of 1883. Now, from the necessities of the case the questions which might arise under the former Act as to the use of trade-marks upon goods or packages, which cannot very well be used at all without an intention to deceive, are very different from questions arising under the Act of 1883, by which a word or a name may be adopted in place of a device or design with the view of distinguishing the goods of a particular manufacturer. It will depend very much on the nature of the name used as to the law which would be applicable, or may be applicable, in the determination of a case like this for the vindication of that name as a trade-name. Mr Stuart, who manifestly deserves great credit for his invention in regard to these flagstones, has apparently made a considerable reputation, and has acquired a very considerable business. After a deal of elaboration, after having previously registered under the Act of 1875 a trade-mark which embraced the design of a shield and the word "Granolithic," after a lapse of some years he abandoned that device or design, and as the Act of 1883 permitted him to register the trade-name as his trade-mark, he in the year 1884 registered the name "Granolithic" as his trade-mark. I think he was entitled to do that—at all events, I do not think that any question is raised here as to whether that was or was not legal under the statute. But it is quite clear that the word "granolithic" was capable of being used and indeed was used as a descriptive word as well as the trade-mark of Mr Stuart. It appears also that the word had been extensively used for several years before 1884, not as the trade-mark of Mr Stuart only, but as descriptive of a particular species of pavement which was current in commercial circles, and which was perfectly well known to architects and builders, and used by them constantly. If it were necessary in this case, and I do not think it is, I should have held, that as far as that was used by the public, that was all that was requisite for the defence in this case. I think the defenders have made that out quite reasonably, and I do not think it detracts from the very large body of practical evidence that we have here that some builders still consider the word to belong to, and to be descriptive solely of, Mr Stuart's manufacture. That there is a very large body of the trade who did not so consider it is quite certain. I should rather be disposed, if it were necessary, to have held that it was in public use before the registration in 1884, but I do not think it necessary to hold that. And what I would base my judgment on would simply be this. If a man adopts for registration under the Act of 1883 a name which is simply descriptive—a name which describes a certain mode of manufacture—we must look very closely to the alleged infringement, and if the alleged infringement is only the use of the name as descriptive of an article or manufacture, I do

not think that it is an infringement for which the remedy sought can be given. Now, that is the general opinion I have come to on this question. It admits no doubt of a good deal of argument, but I am very much moved by the opinion of Lord Selborne in the case of *Singer v. Loog*, which I have had an opportunity of seeing, where the distinction I have indicated was urged. Lord Selborne says—“The reputation acquired by machines of a particular form or construction is one thing, the reputation of the plaintiffs as manufacturers is another. If the defender has no right under colour of the former to invade the latter, neither have the plaintiffs under colour of the latter to claim in effect a monopoly of the former. If the defender has a right to make and sell articles similar to the plaintiffs, he has a right to say so, and to employ the terminology common in his trade, if he does this in a fair, distinct, and unequivocal way.” I think in the present case the mere entering of the word “granolithic” in the circular of the defenders, where they are simply stating what it is they are prepared to furnish to the public, is not an adoption of any trade-mark whatever, but is simply the reasonable description of the article itself, and a description of that article which was quite current in the market for years before this trade-mark was registered. Therefore I am for upholding the Sheriff’s judgment.

LORD YOUNG—I am of the same opinion, and substantially on the same grounds. The case as presented to us on the record lies within a very narrow compass indeed. The pursuers ask that the defenders shall be interdicted “from using the word granolithic or any imitation thereof in connection with the manufacture and sale of artificial stone pavements, or otherwise infringing the pursuers’ registered trade-marks.” The meaning plainly is, thereby or otherwise infringing the registered trade-marks of the pursuers. I say so in order to make the observation that the action concerns the alleged illegal use of a trade-mark, and nothing else, the prayer of the action being to interdict the defender from using a certain word in connection with a certain manufacture, and therefore “or otherwise infringing the pursuer’s registered trade-marks,” is a rather loose expression, because the pursuer has two registered trade-marks. They are both presented to us as registered. With respect to the first, although it gives rise to an observation which I shall make immediately, we need take no account of it so far as the complaint and remedy are concerned, for there is no allegation that that was used by the defender; it consists of a lion supporting a shield, and on the shield are the words “Stuart’s granolithic.” The other registered trade-mark consists of the word “Granolithic” alone. That word alone is said to have been illegally used by the defenders. “The pursuers have recently learned that the defenders have been offering to supply artificial stone pavements under the name of ‘granolithic,’ and have issued circulars and price lists in which the word ‘granolithic’ is used to describe a particular class of artificial stone pavement.” What I have thus read is the only charge against the defenders in the way of complaint of having violated the pursuer’s right, and it is obvious

that it refers to the second registered trade-mark, and to that alone. The case then which is presented to us is this—that the word “granolithic” is a good trade-mark, well registered, and that the pursuers alone may lawfully use it, and that the defenders have unlawfully used it, and against the pursuers’ legal right made use of it. The pursuer’s case, therefore, depends upon these propositions, both of which the defenders contest—first, that the word “granolithic,” registered as it has been, is a good trade-mark; and second, that the defender has used it. I say the defenders have denied both of these propositions. The pursuers must maintain them, and satisfy the Court that they are both well founded, or they cannot succeed. If it is a good trade-mark, and the defenders have used it, the pursuers must succeed—I mean if they have used it in the sense in which a trade-mark can be used. If it is not a good trade-mark, or if the defenders have not used it, the pursuers must fail. I do not think the case presents any other questions than these.

Thus the first question we have to consider is, Is it a good trade-mark? In considering that question the first trade-mark registered—registered four years ago—affords an illustration. The statute of 1883, which is substantially the same as its predecessors in this respect, makes this provision (clause 64)—“For the purposes of this Act a trade-mark must consist of or contain at least one of the following essential particulars. A name of an individual or firm printed, impressed, or woven, in some particular or distinctive manner.” I stop here just to observe that the first registered trade-mark of the pursuers complied with this exactly—“A name of an individual or firm printed, impressed, or woven, in some particular and distinctive manner.” It was imprinted in a particular and distinctive manner by being put upon a shield held up by a lion. I make this further observation that that first essential particular—or we may give them as essential particulars—plainly signifies a mark, something capable of being impressed upon goods, or upon a case containing goods. The name of an individual or firm, not spoken it is true, but accompanying the goods on a representation that these are the goods of that individual or firm, but printed, impressed, or woven in some particular or distinctive manner. That entirely corresponds with my idea of a trade-mark, and is in accordance with the judgment which we were referred to, of the late Master of the Rolls, Sir George Jessel, that a trade-mark does not consist of a name or anything else which may be spoken or written, but of something printed, impressed, or woven in some particular and distinctive manner. The next alternative is, “a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark.” Then *third*—and this is the alternative or essential particular with which we are immediately interested here in considering the validity of the second trade-mark registered by the pursuer—“or a distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.” Now, I think, here again, in accordance with what I have said already, and with the nature of the subject, it is a device, mark, brand, heading, and so on, somehow impressed upon

goods or upon packages containing goods and accompanying them. The validity of this trade-mark—I am not speaking upon the use of it just now—is challenged by the defenders upon the ground that the mere word “granolithic” is not a distinctive device, and is not a word which at the date of registration in 1884 was not in common use, but was a word in common use as the name of a particular article which it denoted, and therefore referring to clause 76 of the statute, while admitting that the registration is *prima facie* evidence of its being a particular mark, yet it is only *prima facie* evidence, and when a complaint is directed against the defenders for having used it, they are entitled to point out against that complaint that it is not a distinctive device, and is not even a word which was not in common use at the date of registration. And here again, the first registered trade-mark of the pursuer, which it is instructive to note is applicable to the very same thing and manufacture, is illustrative, and might be referred to with propriety, for although it appears—at least I think it does—that the pursuers were the first persons who applied the name “granolithic,” which is strictly a descriptive name, to this commodity, yet they did not originally assert any exclusive right to use the name which they were the first to publish. The article which that name was meant to describe had been manufactured pretty extensively before, and had gone by a variety of names. “Granite concrete,” which is a descriptive name, is not infrequent; “granitic” and “granoline” have also been applied to it. And a variety of names have, in short, been used to describe this article. The pursuer somehow stumbled upon this particular name. He consulted some Greek scholars, or some Greek scholars were consulted for him. Their advice seems to have been quite properly and successfully rejected, and not acted upon at all. The name stumbled upon was the composite but still strictly descriptive name “granolithic,” connoting—if one may use the expression without being thought at all pedantic—connoting the qualities of the article, that it was artificial stone made of granite. The two words out of which the composite word was made were the Latin word *granum*, I suppose, and the Greek word *lithos*. These two are connected together by the connecting vowel “o.” There is some curious evidence about its having been originally “i” and changed into “o” by mistake. Well there may be some rule for connecting “gran” with “lithic” by the vowel “i” rather than the vowel “o,” but I am not aware of it. I am not aware of any rule for connecting vowels except the one which will produce the most euphonious sound. We are quite familiar with Latin and Greek words being compounded into one in this way, and also with Saxon and Greek words being joined by some connecting vowel in the same way. There is a familiar example in the case of “gasometer.” I suppose “gas” is a Saxon word—at least it is not Greek. At all events the connecting vowel there is “o.” The word is ended by the Greek “metron.” Another word similarly illustrative is “gasogene,” indicating not a very old machine—a machine for making soda water. The same thing is observed here, the connecting vowel being an “o” before the “gen.” It just means the genesis of gas—a

thing for making gas. Well, this “granolithic” was not an unhappy name, and as they were fluctuating about this article which it denoted, it seemed to take people’s fancy. I say, it appears very clearly from Mr Stuart’s original registration of a trade-mark that he was claiming no property in the name, but, on the contrary, distinctly proclaiming it that it was a thing at the service of anybody, just as most people who stumble upon a happy word make the public a present of it; for, complying with the statute, he registered it with his individual name, printed, impressed, or woven in a particular and distinctive manner. “I call by this name my manufacture”—he may be imagined to say—“which anybody may make better or worse. I have no patent, but I claim that my manufactured article shall be distinguished by my name stamped upon a shield upheld by a lion in the face of the public”—“Stuart’s Granolithic.” He put the shield and the lion there to distinguish his granolithic from other people’s granolithic. The word comes into common use in that way. We have that in evidence. The manufacture of the article is progressive. Other manufacturers are at the same time engaging in it. Architects and builders put the name into their specifications and contracts. And then after four years, when it had been in common use, contracts made with reference to it, and specifications with that name sent out to the pursuer as one of the manufacturers of the article and to other people, and competing offers being, I suppose, received, in 1884, four years afterwards, it occurs to Mr Stuart to secure if he can the exclusive use of the name “granolithic.” I think it was then incompetent for him to do so, and I think further that the name was not then sufficiently distinctive. He might well have been content with his distinctive trade-mark, which certainly was not in common use—a lion and shield and “Stuart’s Granolithic.” That lion and shield, which may be considered superfluous, and Stuart’s Granolithic were a good trade-mark, and would have completely protected his manufacture. But I am disposed to think that this “Granolithic” is not a good trade-mark, and that upon the ground that it was distinguished from the first only in these two respects—fatal respects as it seems to me—that it was not distinctive, and that the name was then in common use.

But then the defenders further say—that is sufficient for the decision of the case if that view be sustained—but they say in addition, “I never used your trade-mark. The mark which I put upon my goods is ‘granitic,’ and I never put ‘granolithic’ on them. You do not allege that I ever put on the distinctive trade-mark which you registered first, although you comprehended that in the prayer of your application. You do not suggest that I did that, but you say I used ‘granolithic.’ Now, I never did use that word ‘granolithic,’ and the frequent use you complain of is not frequent use of your trade-mark at all.” The averment in article 6 your Lordships will remember—“The pursuers have recently learned that the defenders have been offering to supply artificial stone pavements under the name of ‘granolithic,’ and have issued circulars and price lists in which the word ‘granolithic’ is used to describe a particular class of artificial stone pavement.” Now, offering to supply goods ordered as granolithic, or for which an offer was

requested as granolithic, whether the offer or the answer to that request be made by word of mouth or by letter, does not at all correspond with any idea I ever heard of infringing a trade-mark. I do not infringe a trade-mark by saying, I supply granolithic. I may invade the party's right otherwise, but I do not use a trade-mark. The pursuer seeks to interdict the defenders from using his trade-mark. But they do not use his trade-mark by speaking the word. They do not use a trade-mark at all. I entirely agree with what the Master of the Rolls says in regard to the distinction which must here be drawn. Indeed I never heard of anything to the contrary. The allegation of use is made more precise and specific by referring to the circulars and price lists. The circular we were referred to was—"The laying of granolithic or granite-faced concrete in the monolithic form for foot-pavement, playgrounds, court-yards, stables, byres, workshop and store floors, &c., &c., receives the special attention of the company." Now, it is a startling proposition to me to say that is using a trade-mark. It is no use of a trade-mark at all. It is certain that architects and builders were in the habit of specifying for a granolithic pavement. They chose to call it so, but by calling it they were not using anybody's trade-mark. Calling it by that name they went to the defenders for an offer to supply it, I suppose; indeed they certainly might go to the pursuers at the same time and say, there is a certain amount of granolithic pavement which we desire to have executed, what will you do it for? They sent the same specification to the defenders and asked them what they would execute it for. And really the proposition involved in this complaint is that the pursuers' trade-mark is violated by the defenders answering that request—saying that they are willing to supply the article which the architect and builder calls "granolithic" at a certain cost. Now, I cannot assent to that. I do not think that by doing that—answering any such request—he is using the pursuers' trade-mark at all.

I do not need to consider the question whether it is violating the defenders' right in another respect, either fraudulently or innocently, to palm off their goods as the pursuers', or fraudulently or innocently mislead the public into the belief that they are supplying the pursuers' goods. That is not the case presented to us here. It is the illegal use of a trade-mark. But if I had to consider that other question, I should think it almost too clear for argument that the defenders were doing nothing whatever of that character—of the character, I mean, of palming off their goods as the goods of the pursuers, or deluding or misleading the public innocently or otherwise into the belief that the goods they supplied were the goods of the pursuers' manufacture. There is no room for such a suggestion at all, and the pursuers' own witnesses negative the notion, as any sensible man to whom the question is put must negative it,—the notion that if, seeing this advertisement, they went to the defenders to lay granolithic pavement, they would suppose they were getting the pursuers' goods. There is no room, I say, for any supposition on the subject. If I ordered the defenders to make it and lay it, I know that they make it and lay it, and not the pursuers. There is no case of that kind, and really that general law,

although it is only upon a special branch of it that the present action is founded, is at the bottom of the whole matter—for a trade-mark is just a particular or special branch of the general law, which affords reasonable protection to any manufacturer that he shall not be deprived by others of the legitimate advantage of the reputation which his manufacture has acquired. The law will always protect that advantage, and the law of trade-mark, with special rules superinduced by statute, just emphasises and makes more readily workable in particular cases that general law. Stamp your goods, or impress them or what contains them with some mark, and we shall protect you in the exclusive use of it; we will allow nobody else to put that mark on his own goods. That is a summary of the law of trade-mark. It is founded on the principle that every manufacturer is entitled to the legitimate property arising from the reputation which goods of his manufacture acquire.

Upon the whole matter, agreeing with your Lordship, and substantially upon the same grounds, I think we must uphold the judgment of the Sheriff. If I were to put my opinion and what I think is our judgment precisely, it would be thus, that this is not a good trade-mark, and that even if it were the defenders have taken no illegal use of it.

LORD CRAIGHILL—I agree with the Sheriff-Substitute in thinking that the grounds of the present action have not been made good, and consequently I am of opinion that this appeal ought to be dismissed.

The circumstances lie within a small compass. The appellant and the respondent have both been using the word "granolithic" for the purposes of their businesses, and the appellants, who are pursuers of the action, now lay claim to a right to the exclusive use of that word, and ask the Court to grant interdict against its use by the respondents, who are the defenders. The pretensions of the appellants are rested, first, on the ground that "granolithic" is a word which has become their property, because by virtue of registration subsequent to the passing of the Patents, Designs, and Trade-Marks Act 1833 (46 and 47 Vict. c. 57) the word has become a trade-mark; and secondly, because the use of the word by the defenders for any purposes of their business is an encroachment on the appellants' rights in the premises. Should the Court be of opinion either that the word was not made a trade-mark by registration, or that the use, such as it is, taken by the respondents is not an encroachment, the appellants' action must fail. My ground of judgment is, that the word which is in controversy has not been made a trade-mark of the appellants, and that consequently their claim to property in that word is unfounded. A condition upon which a word may be raised to the rank of a trade-mark, as provided for by section 64, sub-section c, of the statute, is that the word prior to registration has not been in common use. There is no dispute that this is a condition, but there is a controversy, and a keen controversy, on the question whether the word is proved to have been in common use. There are witnesses, and numerous witnesses, on both sides, but the conclusion to which I have come is that at which the Sheriff-Substitute has arrived. Common use as employed in the statute does not



necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. What is enough in my opinion to establish common use, in the sense of the statute, is this, if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the word has been applied. If architects, builders, masons, and others concerned with the laying down or with the use in other ways of cement or concrete, and were in the habit, prior to April 1884, when the word was registered by the appellants, of using "granolithic" as a word descriptive of the commodity manufactured, not by the pursuers only but by others, I cannot doubt that all has been established which was necessary to render "granolithic" a word which by virtue of registration could not be made a trade-mark. This is my view of the interpretation of the words "common use," but I may add that even if it were necessary to prove a wider use than that which in my opinion is sufficient to fill up the definition, there would, in the evidence that has been led, be enough to show that the statutory condition had not been fulfilled. The weight of evidence, as I think, is in favour of the contention of the respondents, and that is the view of the matter which upon this subject has been adopted by the Sheriff-Substitute. For that reason I approve of his judgment.

This is enough for the present case, and therefore I refrain from saying anything either upon the second of the questions I have particularised, or upon any subsidiary question which was raised in the course of the argument upon this appeal.

LORD RUTHERFURD CLARK—I also am of opinion that the judgment of the Sheriff-Substitute ought to be affirmed. But I confess I should rather place my judgment upon the single proposition that the pursuers have not established that the defenders have used their trade-mark. I do not go into the question whether the trade-mark as last registered is or is not a bad one, but I am satisfied that the circular of which the pursuers alone complain is not in any legal sense, or in any sense, a use of the pursuers' trade-mark.

The Court found "that the pursuers have failed to prove that the defenders have infringed their trade-mark," dismissed the appeal and affirmed the judgment, and of new assoilzied the defenders.

Counsel for Pursuers (Appellants)—Mackintosh—Orr. Agents—Martin & M'Glashan, S.S.C.

Counsel for Defenders (Respondents)—Pearson—Ure—Salvesen. Agents—M'Gregor & Cochran, S.S.C.

Saturday, October 17.

## WHOLE COURT.

[Sheriff-Substitute of Lanarkshire.

CAIRD *v.* SIME.

*Property—Literary Property—Copyright—University Lectures Delivered by a University Professor to his Class—Publication by a Bookseller from Notes taken by a Student—Interdict—Process—Form of Judgment in Appeal from Sheriff Court—Judicature Act (6 Geo. IV. c.120), sec. 40.*

A professor in a university sought and obtained from the Sheriff interdict against a bookseller from publishing certain works called "Aids" to the study of the subject of which he was professor, and which he alleged were reproductions of his lectures prepared and furnished by one of the students who attended his class. He maintained (1) that the "Aids" were a substantial reproduction of his lectures; (2) that he had a common law right of property in his lectures, which right he did not part with by delivering them to his class for their instruction.

On the first of these propositions, opinions in the affirmative were delivered by the Lord President, Lords Shand, Rutherford Clark, Adam, Kinnear, Lee, Fraser, M'Laren, and Trayner; opinions in the negative being delivered by Lords Mure, Young, and Craighill, the Lord Justice-Clerk giving no opinion. On the second, opinions in the affirmative were delivered by six Judges (Lords Shand, Adam, Rutherford Clark, Fraser, Kinnear, and Trayner); opinions in the negative being delivered by six Judges (the Lord President, Lord Justice-Clerk, Lords Mure, Young, Lee, and M'Laren), who held that the pursuer being a professor in a public university, had no right to prevent the publication by any student of the substance of the lectures delivered by him in the course of his public duty as professor—Lord Craighill giving no opinion, but resting his judgment on his opinion negative of the first proposition. On the case being advised by the Second Division a majority held that the question between the parties was in reality one of law, and that it was not necessary to set out in the interlocutor as a fact that the publication complained of was a substantial reproduction of the pursuer's lectures, and therefore an interlocutor was pronounced finding that the works the publication of which was complained of were compiled by a student who had attended the class and taken notes, but that such publication did not infringe the pursuer's legal rights, and therefore refusing the interdict.

Lord Rutherford Clark dissented on the ground that the question whether the works complained of were a reproduction of the pursuer's lectures was a mere question of fact; and that as the case came up as an appeal from the Sheriff Court, it was the duty of the Court to set out as a fact found by the majority of the whole Court that they were such, and thereafter to apply the law thereto.

In October 1883, Edward Caird, Master of Arts, Professor of Moral Philosophy in the University