Judgment of the Lords of the Judicial Committee of the Privy Council on the Appeal of The National Starch Manufacturing Company and others v. *Munn's Patent Maizena and Starch Company and others, from the Supreme Court of New South Wales; delivered 28th April* 1894.

Present:

LORD WATSON.
LORD ASHBOURNE.
LORD MACNAGHTEN.
LORD MORRIS.
SIR RICHARD COUCH.

[*Delivered by Lord Ashbourne.*]

This is an appeal from a judgment of the Chief Judge in Equity of the Supreme Court of New South Wales in a suit in which the Appellants were Plaintiffs and the Respondents were Defendants, and in a Counter-Claim thereto in which the Respondents were Plaintiffs and the Appellants were Defendants. The Judge dismissed the suit with costs and allowed the Counter-Claim with costs.

In the suit the Appellants claimed to be entitled to the exclusive use in the Colony of New South Wales of the special and distinctive invented word "Maizena" as their trade mark; and that such word was properly registered in the Colony as their trade mark; and they charged the Respondents with having so got up and packed their goods as to lead to the belief that their goods were the goods of the Appellants,

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and to cause or enable their goods to be passed off as the goods of the appellants. The contention of the parties raised two distinct questions: their right to register in New South Wales the word "Maizena" as their trade-mark under the Trade Marks Act of 1865 (28 Vict. No. 9); and whether the respondents independently of that Act had violated the common law rights of the appellants by fraudulently making up their goods so as to deceive and pass them off as made by the appellants.

The suit was instituted to restrain the respondents from using the word "Maizena" for or in connection with their goods and for consequential relief.

The defendants in their counter-claim prayed, on the other hand, for a declaration that the term "Maizena" is and was previously to December, 1889, a word publici juris in the colony and should be ordered to be removed from the Register of Trade Marks.

The facts and dates in the case may be shortly stated.

In the year 1856 the appellants invented the word "Maizena" as their trade-mark for a starch or flour made from maize. In the year 1863 their agents, through Farrar & Co., of Melbourne, introduced "Maizena" into the Australian colonies. Large shipments were sent to those colonies for several years, but in consequence of a high tariff put on in 1871-72 the trade fell off, and it was alleged by the respondents that there was no evidence of any sales by the appellants of their "Maizena" between 1872 and 1885.

The appellants from time to time registered a trade-mark with this word "Maizena," and from time to time renewed the registration of their trade-mark in the United States of America, in the United Kingdom, and elsewhere.

They also took steps to assert their rights in those countries where their trade mark was registered.

The Appellants, however, did not register their trade mark "Maizena" in the Colony of New South Wales until December 1889, though the Trade Marks Act of 1865 permitted such registration, and provided in its second section that "a mark shall not be recognized or con-"sidered to be the trade mark of any person, "until the same has been registered by or on "behalf of the person claiming to be entitled "thereto as his trade mark."

The position of the Respondents may now be stated. A firm of Uric Munn and Young in Victoria began in 1864 to manufacture corn-flour under the name of "Maizena." In 1866 M. A. Munn retired from the firm, and in 1867 he came to New South Wales, and there established a manufactory of "Maizena" at Merimbula in partnership with T. S. Mort and Sir Wm. Manning. In August 1867 Munn obtained Letters Patent in New South Wales for improved machinery for the manufacture of maize into "Maizena" or corn-flour. In December 1867 he registered as his trade-mark a lion's head, with the motto "*Omnia vincit* "*veritas*," to be affixed to labels and packets of goods manufactured by him, "such as "Maizena."

Other firms besides the Appellants and Respondents used the word "Maizena" in Australia between 1864 and 1889. From 1867 until shortly before the commencement of this suit no claim was ever made by the Appellants to the exclusive use of the word "Maizena" in New South Wales.

The present question could not have arisen if the Appellants had more promptly availed themselves of the Act of 1865. They did not do

so until the year 1889, and the first substantial question in this case is, whether during the twenty-four years which elapsed between 1865 and 1889 the word had been so used in the colony as to make it no longer registerable as the appellants' trade-mark.

If during the period in question the word was only used in the colony for the fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trademark would not be impaired. If, on the contrary, it was used and understood before 1889 as a term descriptive of the article, as a product of maize, and did not denote such product to be of the manufacture or merchandize of a particular person, then it must be regarded as having become, in the sense of law, publici juris, and was no longer registerable by the appellants as their trade-mark.

Accordingly the important question upon the evidence is whether, between 1865 and 1889, the word was used by the appellants lawfully, and by the respondents and others fraudulently, to denote corn-flour of the appellants' manufacture; or whether it was used and generally understood by purchasers to denote, not the manufacture of any particular person, but the character and quality of the article.

The appellants argue that the doctrine of publici juris cannot apply, as the respondents were guilty of fraud in originally appropriating the appellants' trade-mark, and as the use of it was continued in fraud. But their Lordships cannot find any evidence to support this contention, and they cannot ignore the lapse of time and all that has occurred in a quarter of a century. The appellants never registered the word as their trade-mark for twenty-four years, they never during that long period took proceedings to restrain the respondents from using

it in New South Wales. Moreover, during that time other firms in Australia had also used the word. Mr. Langdon, a witness for the Appellants, and a partner of the firm of Farrar & Co., the sole consignees for the Australian Colonies of the Appellants' "Maizena" since 1863, said in his evidence "We looked on "'Maizena' as a natural product, not as a "trade mark belonging to anybody." In considering whether the word "Maizena" had become *publici juris* in New South Wales in 1889 the acts of the Appellants prior to that date must be carefully noted. They had taken proceedings against Munn and Young in Dublin in 1865 to prevent their selling "Maizena" in Ireland, and on the latter firm undertaking not to sell there the litigation ended. Again, similar proceedings were in 1881 taken before Mr. Justice Chitty in England (where their trade mark had been registered in 1876), with a similar result. Objection was also taken in 1876 at the Philadelphia Exhibition to the use of this word by the Respondents. It is to be fairly assumed that the Appellants knew that the Respondents were Australian merchants, manufacturing and selling "Maizena" in New South Wales, and until 1889 they gave no indication that they objected to the acts of the Respondents as long as they were confined to that Colony. It would thus appear that as far as they were concerned they left the word "Maizena" derelict there, leaving its use unfettered and free to become *publici juris*. It probably was not worth their while to interfere, for Mr. Palser in his evidence says that "the tariff of 1871 practically killed "the importation of foreign Maizena and corn "flower."

No full or exhaustive definition can be given of the circumstances which will make a word or

name publici juris, and each case must depend upon its own facts.

In considering the question, it is important to bear in mind that the appellants do not claim any special right to the manufacture of "Maizena," or any exceptional method in making their "Maizena," and that the respondents and all other people have just as much right as the appellants have to manufacture the thing—no matter whether it is called "Maizena," corn-flower, or any other name.

Having regard to all the facts and evidence in the case it is impossible to resist the conclusion that in December, 1889, the date of registration, and for many years previously, the word "Maizena" had become publici juris, and their Lordships are therefore clearly of opinion that it was at the date specified not registerable by the appellants as their trade-mark.

The second question remains: Did the respondents try to pass off their manufacture as that of the appellants, and deceive or try to deceive the public on the subject? Although this question is distinct from the first, many of the reasons for the conclusion already stated are of weight. Fraud or intention to deceive must be made out. The appellants insist that the form of packet sold by the respondents, its make up, its colour, and the words printed upon it, indicate an intention to deceive, and to pass off the goods of the respondents as their manufacture. They rely particularly upon the use by the respondents of the statement on their wrapper of the words: "Of all competing Corn Flowers Maizena alone received a prize medal at the International Exhibition, London, 1862." On the appellants' wrappers are the words: "Of all competing articles of its class prepared from corn for food Maizena alone received a prize medal at the International Exhibition, London, 1862." The

Appellants obtained this medal. The Respondents, it will be observed, are careful not to state that the medal was gained by them, and they enumerate in detail their own successes. If "Maizena" in the Colony had come to denote a certain article simply, there would be nothing wrong in any one in the trade advertising that such and such prizes had been awarded to "Maizena," though the successful article was not of his own manufacture. But then the advertiser ought to make it perfectly clear that he claims no connection with the successful article beyond similarity in the process of manufacture and practical identity in the substance produced.

In the course of the argument their Lordships expressed their disapproval of the way in which the Respondents were referring to the medal gained at the Exhibition of 1862, and they were glad to receive from Mr. Cozens Hardy at the close of the Appellants' case an undertaking (which will be embodied in their Lordships' Report to Her Majesty) binding the Respondents to discontinue the objectionable statement.

Their Lordships think it right to add that the statement in question would have demanded more serious consideration, and probably very different treatment, if in their Lordships' opinion it had formed part of a scheme designed with the view of appropriating the Appellants' custom, instead of being "an advertising trick," as Mr. Justice Owen describes it, not indeed very creditable to its authors, but yet one which could not in the circumstances deceive anybody into buying the Repondents' "Maizena" in the place of the Appellants'.

It was also contended that the use by the Respondents of the word "patented" was evidence of fraud. As a fact they had a patent for the machinery by which their "Maizena" was made,

and the representation, even if unfounded, would not bar the respondents' right to resist the appellants' claim.

Their Lordships have had before them, in the book of exhibits, copies of all the labels, and they have also seen samples of the packets used by both parties, and are themselves unable to arrive at the conclusion that the packets and labels of the respondents would or were likely to deceive the public. They state most clearly the names of the maker, place of manufacture, and other necessary particulars.

If the general effect of the labels and the words, colour, and make-up of the packets were calculated to mislead, liability could not be evaded by pointing out that if the words were spelt out and carefully examined and studied by a wary purchaser there would be no deception. But their Lordships can see no such general effect, and it is worthy of note that no evidence of any kind has been given shewing that any one was deceived.

Their Lordships will, for these reasons, humbly advise Her Majesty to affirm the judgment of the chief judge in equity and to dismiss this appeal. The appellants must pay the costs of this appeal.