

[HIGH COURT OF AUSTRALIA.]

ECLIPSE SLEEP PRODUCTS INCORPORATED APPELLANT;

AND

THE REGISTRAR OF TRADE MARKS . . . RESPONDENT.

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS.

H. C. OF A. *Trade Mark—Registration—Condition—Imposition—Right to exclusive use—*
1957. *Disclaimer—Discretion of Registrar and of Court—Mark—Distinctiveness—*
“Adapted to distinguish”—Registrar—Opinion—Trade Marks Act 1905-1948,
ss. 16, 24, 35, 50, 53, 53A.

SYDNEY,
Sept. 25, 26;
Dec. 3.
Dixon C.J.,
Williams
and
Kitto JJ.

An application was made for the registration of a mark as a trade mark under the *Trade Marks Act* 1905-1948 in class 41 in respect of mattresses, etc. The representation was of a composite nature comprising on its left the back view of a naked man drawn so as to emphasise, it would seem, what were alleged in an advertisement of the applicant's mattresses, to be the four vital muscle centres (loins, pelvis, neck and trunk), which must be relaxed in order to get “really sound healthy sleep”, and on his right the design of an inner spring for a mattress having six sides so constructed that two of the sides would press against the walls of the mattress, *inter alia*, to prevent it from sagging, the device forming a border within which appear the words, one above the other, “SPRINGWALL MATTRESS”. The Deputy Registrar was prepared to grant the application provided the applicant agreed to endorse upon the application the disclaimer that “Registration of this trade mark shall give no right to the exclusive use of the device of a spring” and upon the applicant refusing to do so the Deputy Registrar refused the application. The applicant appealed under s. 35 of the *Trade Marks Act* 1905-1948 direct to the High Court.

Held, that the device of the border was an essential feature of the proposed trade mark; it was matter of a non-distinctive character, and it was therefore matter to the exclusive use of which the applicant should be held not to be entitled, therefore the application was one in which the tribunal would normally require a disclaimer.

Section 24 of the *Trade Marks Act* 1905-1948 prescribes the circumstances in which the discretion to require a disclaimer may be exercised and the kind of disclaimer that may be required, but even in cases falling within sub-s. (1), the tribunal still has a discretion to require a disclaimer or not. Before the disclaimer can be exercised at all the tribunal must be satisfied that the trade

mark contains either (1) parts not separately registered as trade marks, or (2) matter common to the trade, or (3) matter otherwise of a non-distinctive character. If this requirement is fulfilled the tribunal has a discretion to require the proprietor (a) to disclaim any right to the exclusive use of any of those parts or of that matter to the exclusive use of which it holds him not to be entitled, or (b) to make such other disclaimer as the tribunal thinks needful for the purposes of defining his rights under the registration.

"Springwall" is nothing more than a combination of two ordinary English words and could not, therefore, qualify as an invented word within the meaning of par. (c) of s. 16 (1) of the *Trade Marks Act* 1905-1948, and as it is a word which has a direct reference to the character or quality of the goods it could not qualify as a word or words within the meaning of par. (d) of s. 16 (1).

The words "adapted to distinguish" in s. 16 (2) of the *Trade Marks Act* 1905-1948 mean adapted to distinguish in Australia having regard to the practice and conditions of the trade here, the question being whether, quite apart from the effects of registration, the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it.

Distinctiveness in fact is not conclusive and inherent adaptability to distinguish, of which the fact that the mark has proved to be distinctive in use is but evidence, is the true test. *Yorkshire Copper Works Ltd.'s Application for a Trade Mark* (1953) 71 R.P.C. 150, at pp. 153, 154, referred to.

If the tribunal is left *in dubio* whether to grant an application for registration or not, the application should be refused: see *Eno v. Dunn* (1890) 15 App. Cas. 252, at p. 257.

In determining whether a proposed trade mark is distinctive and ought to be registered, great weight should be attached to the opinion of the Registrar. *In the Matter of Ford-Werke A.G.'s Applications for a Trade Mark* (1955) 72 R.P.C. 191, at p. 194, referred to.

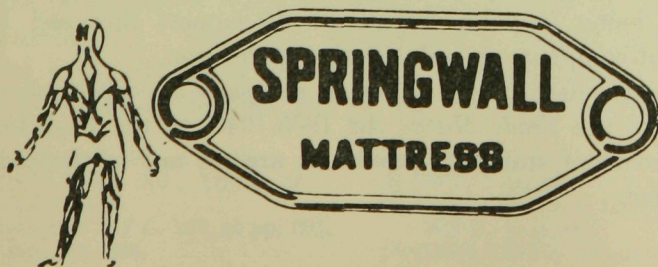
Decision of the Registrar of Trade Marks affirmed.

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APPEAL from the Deputy Registrar of Trade Marks.

This was an appeal from a refusal by the Deputy Registrar of Trade Marks to grant an application dated 8th September 1953, made under the *Trade Marks Act* 1905-1948 on behalf of Eclipse Sleep Products Inc. of 36 Milford Street, Brooklyn, New York, U.S.A., to register a trade mark in class 41 in respect of mattresses, sofas, settees and upholstered seats. The mark sought to be registered was in the following form:



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The deputy registrar was prepared to grant the application provided the applicant company agreed to disclaim the right to the exclusive use of the device of a spring appearing in the mark.

In a letter dated 14th September 1955, forwarded by the applicant company's Sydney agents to the registrar, it was stated, *inter alia*, that the mark included a six-sided border having circular ends, surrounding the words "SPRINGWALL MATTRESS" and on its left the back view of a naked man, and was an artistic conception derived from the form of a particular type of spring which may be used along the edges of a mattress or the like—a border stabilizer spring, but no spring, under any condition of lighting, would ever look like a six-sided border device. The said agents stated four proposals for disclaimer in their order of preference, thus:—1. "The applicant company recognises that registration of this trade mark will not give it the right to the exclusive use of a device of a spring except in the form depicted in the trade mark"; 2. "The applicant disclaims any right to the exclusive use of a device of a spring, except in the form depicted in the mark, by virtue of registration"; 3. "The applicant disclaims any right to the exclusive use of a device of a spring except in the form in which it appears in the mark"; and 4. "The applicant disclaims any right to the exclusive use of a device of a spring by virtue of this registration."

In the interim decision made on 23rd May 1956 it was stated that the applicant company should endorse on its application: "Registration of this trade mark shall give no right to the exclusive use of the device of a spring" and a period of two months was allowed for such indorsement to be made.

The applicant company did not accept the disclaimer that had been called for by the registrar whereupon the registrar proceeded to issue his decision in which he said, *inter alia*, that he was satisfied that the portion of the mark which, in the exercise of his discretion, the applicant company had been called upon to disclaim, was directly embraced by the terms of par. (b) of sub-s. 1 of s. 24 of the *Trade Marks Act* 1905-1948, and the applicant company having refused to accept the disclaimer which the registrar stipulated and he not being prepared to accept disclaimers proposed by the applicant company, he refused the application.

From that decision the applicant company appealed under ss. 34 and 35 of the *Trade Marks Act* 1905-1948, to the High Court.

The relevant statutory provisions are set out in the judgment hereunder.

R. J. A. Franki, for the appellant. The registrar should have granted registration without requiring any disclaimer. This mark is an "overall" mark, the registration of which would not necessarily give a right to the exclusive use of the representation of any part of it. The part of the spring depicted is not in fact an ordinary picture of a spring but is a special device. An unsuccessful claim to a monopoly of a combination of letters is not necessarily a ground for requiring a disclaimer of them (*Kerly on Trade Marks*, 7th ed. (1951), p. 206; *In re Albert Baker & Co.'s Application* (1)). It is only in exceptional cases and for some good reason that a disclaimer should be ordered. Merely because matter is common to the trade or otherwise falls within s. 24 of the *Trade Marks Act* 1905-1948 is no reason for disclaimer. The question of disclaimers was dealt with in *In re Cadbury Bros. Ltd.'s Application* (2). A disclaimer is, in effect, an invitation to the public to disregard the appellant's rights. The Court is, in effect, asked to make an order under s. 16 (1) (e). This is a distinctive mark within the meaning of par. (e). *Arthur Fairest Ltd.'s Application to Register a Trade Mark* (3) is important on the aspect of disclaimer and on the aspect of distinctiveness and falls very close to the matter now before the Court. The judge of first instance in *Innes v. Lincoln Motor Co.* (4) laid down no principles and on appeal the cases of *In re Cadbury Bros. Ltd.'s Application* (2) and *In re Albert Baker & Co.'s Application for a Trade Mark* (5) were not referred to. The onus is on the registrar to show good reason for requiring a disclaimer. The practice follows *In re Cadbury Bros. Ltd.'s Application* (2). There is no reason why in the interests of the public a disclaimer should be here required. Nor is there any reason why a disclaimer should be required to define the rights acquired by registration, in the case of a device of this sort, when it was not deemed necessary in the case of particular word marks which latter should, perhaps, be regarded with even more stringency. The appellant seeks registration of an overall device, and if it is adapted to distinguish the goods then the appellant should be entitled to registration of that device and only be required to submit to any disclaimer if in fact the disclaimer is really necessary (*In re Cadbury Bros. Ltd.'s Application* (6)). The right to disclaim is clearly limited. [He referred to *Re Smokeless Powder Co.'s Trade Mark* (7).] See also *Halsbury's Laws of England*, 2nd ed. vol. 32, p. 581, par. 884. *In re*

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(1) (1908) 2 Ch. 86, at p. 87.

(2) (1915) 2 Ch. 307; (1915) 32 R.P.C. 456.

(3) (1951) 68 R.P.C. 197, at pp. 201, 203, 204, 206.

(4) (1923) 32 C.L.R. 606.

(5) (1908) 2 Ch. 86.

(6) (1915) 2 Ch., at p. 312; (1915) 32 R.P.C., at p. 462.

(7) (1892) 9 R.P.C. 109, at p. 112.

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Diamond T Motor Car Co. (1) is distinguishable. If a disclaimer in any way suggests that the proprietor of the mark may not have a common law right to some element in the mark then that is likely to mislead any member of the public. The spring is completely distinctive. The shading is quite unique and bears no reference at all to the ordinary way of depicting a spring. There is a substantial difference between the patent representation and the trade mark representation. The device is a distinctive device, and as such the appellant should not be required to enter on the register a clear disclaimer of that device.

[He referred to *A. & F. Pears Ltd. v. Pearson Soap Co. Ltd.* (2) and *Jafferjee v. Scarlett* (3).]

[KITTO J. referred to *Innes v. Lincoln Motor Co.* (4).]

It has not been suggested that the mark is not a distinctive mark as a whole. At the very worst against the appellant the device is a fanciful rendering of a spring, and even following the registrar's practice he should have accepted one of the earlier disclaimers which preserved the particular device in this composite mark.

[DIXON C.J. referred to *Bowden Wire Ltd. v. Bowden Brake Co. Ltd.* [No. 1] (5) and *In re James' Trade Mark; James v. Soulby* (6).]

The shading is a very distinctive element in the device. The spring itself is not a "matter of a non-distinctive character" within the meaning of s. 24 (1) (b) of the *Trade Marks Act* 1905-1948; see *Kerly on Trade Marks*, 7th ed. (1951) p. 177 *et seq.* This device was registered in United States of America: that is a matter for consideration where the matter is reduced to a question of expediency: see *Re Application by National Cash Register Co. for Registration of a Trade Mark* (7).

[WILLIAMS J. referred to *In re Diamond T Motor Car Co.* (8).]

The matter for which the disclaimer was required was not within s. 24 (1) (a) or (b). The appeal should be allowed.

R. J. Ellicott, for the respondent. The application for registration is before the Court not only as to whether a disclaimer should be entered on the register, not only as to whether it contains non-distinctive matter, but also whether it comes within the provisions of s. 16. In that sense this Court deals with the matter originally. The registrar found that the mark was registrable as a whole. He took the view on the ground that it fell within par. (e). Originally

(1) (1921) 2 Ch. 583.

(2) (1925) 37 C.L.R. 340, at p. 345.

(3) (1937) 57 C.L.R. 115, at pp. 119, 126.

(4) (1928) 32 C.L.R. 606, at p. 613.

(5) (1913) 30 R.P.C. 580.

(6) (1886) 33 Ch.D. 392.

(7) (1917) 34 R.P.C. 273.

(8) (1921) 2 Ch., at p. 591.

this appellant agreed to disclaim this very thing, in the very same form, as the disclaimer now in question. That is important when the tribunal exercises its discretion under s. 24. The registrar relies on that matter before the Court as being material in the exercise of his discretion. The shading is the correct shading. Under s. 24 there are two matters to determine: the question of fact, whether the trade mark (i) contains parts not separately registered, or (ii) contains matter common to the trade. If that question of fact is established, then the second matter arises, viz. to determine whether a disclaimer should be entered. As to the question of fact this Court is in exactly the same position as the registrar. This Court will not interfere with the exercise by the registrar of the discretion unless that exercise was clearly wrong (*Re Application by F. Reddaway & Co. Ltd. to Register a Trade Mark* (1)).

[WILLIAMS J. referred to *Re Application by Edward Hack for the Registration of a Trade Mark* (2).]

Even though this Court may feel it would come to a different conclusion if it had to exercise the discretion if at the same time it feels that the registrar has come to a reasonable or a possible conclusion, then it will not interfere with his exercise of discretion. [He referred to *Jafferjee v. Scarlett* (3); *Kerly on Trade Marks*, 7th ed. (1951), pp. 41-53; *Re Application by J. & P. Coats Ltd. for Registration of a Trade Mark* (4) and *Re Application by the National Machinery Co. to Register a Trade Mark* (5).] The only relevant matter is whether, as a question of fact, there is non-distinctive matter in this mark—in the border device—in relation to this particular spring. In that there are possibly two questions: (i) Is it a representation of part of the object in respect of which the mark is going to be used? and (ii) If it is, is it non-distinctive? Question (i) is simply a question of fact. [He referred to *Kerly on Trade Marks*, 7th ed. (1951), at pp. 178-180; *In re James' Trade Marks*; *James v. Parry* (6); *Re Sphincter Grip Armoured Hose Co.'s Trade Mark* (7); *Goodyear Tyre & Rubber Co. v. Robertson Commissioner of Patents* (8) and *Derenberg on Trade-Mark Protection and Unfair Trading* (1936), p. 309.] The representation is a representation of part of the goods, and it is a relevant consideration that the appellant has a patent in relation to the spring device. Because of

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(1) (1926) 44 R.P.C. 27, at p. 36.
(2) (1940) 58 R.P.C. 91.
(3) (1937) 57 C.L.R., at p. 126.
(4) (1935) 53 R.P.C. 355, at p. 375.
(5) (1941) 58 R.P.C. 128, at pp. 134, 135.
(6) (1886) 31 Ch. D. 340, at p. 343;
(1886) 33 Ch. D. 392, at pp. 394, 395.
(7) (1893) 10 R.P.C. 84, at p. 85.
(8) (1923) 25 Fed. R. (2), p. 833.

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the existence of the patent it is not something that is capable of becoming distinctive because there is nothing to compare it with—the appellant being the only one who can use it (*Cellular Clothing Co. v. Maxton & Murray* (1)). There is no evidence before the Court that the work has become distinctive of the applicant's goods. It is an attempt on the part of the applicant to appropriate part of a man's right to depict his own goods and advantage them. The Court should hold that this device is non-distinctive because in fact it is a representation of the goods and because in law if it is a representation of part of the goods it cannot be the subject of a registrable mark in relation to those goods. The Court has a discretion to enter a disclaimer. The aim of the section is to define the rights of a proprietor under his registration with the object, as far as possible, of: (i) preventing extravagant claims by him; (ii) protecting other traders by making it clear that they, subject to passing-off, have equal rights to use the non-distinctive matter; and (iii) preventing the public from thinking that a mark containing the non-distinctive matter necessarily indicates that the goods on which they are used are the goods of the proprietor. They limit a proprietor's monopoly to its true extent. If it is a matter which comes under par. (a) the Court will be more inclined to allow the registration without a disclaimer than under par. (b). Where it contains non-distinctive matter that almost in itself is sufficient ground for the Court or the registrar requiring a disclaimer, or if it contains matter common to the trade instantly the need to limit the monopoly comes into existence. Also, the Court will consider whether the non-distinctive matter, or the matter common to the trade, is, or is not, a substantial part of the mark. Where the "objectionable" matter is a substantial part of the mark, then that would incline the Court or the registrar to require a disclaimer. [He referred to *de Cordova v. Vick Chemical Co.* (2).] Other relevant matters are: the applicant's conduct in relation to the mark and the non-distinctive or the objectionable portion thereof; prior disclaimers and possible deception; and the likelihood of the non-distinctive part ever becoming distinctive: see *Cellular Clothing Co. v. Maxton & Murray* (3). On the facts the registrar has exercised his discretion in a reasonable way and the Court will not interfere with it. If the Court comes to a different view, even though it thinks the registrar has acted reasonably, then it will require that a disclaimer be entered in the form set out in the case stated by the registrar. The spring device is an important part of the mark, and is not an incidental part of it. The Court will

(1) (1899) A.C. 326, at pp. 343, 344.

(2) (1951) 68 R.P.C. 103.

(3) (1899) A.C. 326.

regard as an important consideration the prior disclaimers. This case is similar to *Greers Ltd. v. Pearman & Corder Ltd.* (1). The manner in which the courts have approached the question of disclaimer is shown in *In re Diamond T Motor Car Co.* (2); *In re Innes' Trade Mark* (3); *Innes v. Lincoln Motor Co.* (4) and *Registrar of Trade Marks v. Ashop Chandra Rakhit* (5); see also *Kerly on Trade Marks*, 7th ed. (1951), p. 208, s. 8 of the *Trade Marks Act* 1938 (Imp.), and s. 53A of the *Trade Marks Act* 1905-1948.

[WILLIAMS J. referred to *Mark Foy's Ltd. v. Davies Coop & Co. Ltd.* (6).]

R. J. A. Franki, in reply. The position in this case is different from the position in *Re Application by F. Reddaway & Co. Ltd. to Register a Trade Mark* (7) and other cases referred to on behalf of the respondent. All those cases were cases dealing with the question of whether or not a mark was itself a registrable mark. It is the duty of the Court to decide the matter as upon an original application and not merely to decide whether the decision of the registrar can or cannot be supported (*Jafferjee v. Scarlett* (8)). [He referred to *In re James' Trade Mark*; *James v. Soulby* (9) and *In re Diamond T Motor Car Co.* (10).]

Cur. adv. vult.

THE COURT delivered the following written judgment:—

This is an appeal by the applicant, Eclipse Sleep Products Incorporated, a corporation incorporated in the United States of America, from a refusal by the Deputy Registrar of Trade Marks to register the mark the representation of which appears on Application No. 115432 dated 8th September 1953 as a trade mark under the provisions of the *Trade Marks Act* 1905-1948 in class 41 in respect of mattresses, sofas, settees, and upholstered seats. The deputy registrar was prepared to grant the application provided the applicant agreed to endorse upon the application the following disclaimer: "Registration of this trade mark shall give no right to the exclusive use of the device of a spring" but the applicant would not do so and the deputy registrar thereupon refused the application. The representation is of a composite nature comprising on its left the back view of a naked man drawn so as to

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(1) (1922) 39 R.P.C. 406.

(2) (1921) 2 Ch., at pp. 592, 593.

(3) (1923) V.L.R. 359, at pp. 368, 369.

(4) (1923) 32 C.L.R. 606.

(5) (1956) *Patent Design and Trade Mark View of India*, Vol. 12, Pt. 2, pp. 15, 19, 23.

(6) (1956) 96 C.L.R. 190.

(7) (1926) 44 R.P.C. 27.

(8) (1937) 57 C.L.R., at p. 119.

(9) (1886) 33 Ch. D., at p. 396.

(10) (1921) 2 Ch., at p. 586.

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emphasise, it would seem, what are alleged in an advertisement of the applicant's mattresses to be the four vital muscle centres (loins, pelvis, neck and trunk) which must be relaxed in order to get "really sound healthy sleep" and on his right the design of an inner spring for a mattress having six sides so constructed that two of the sides would press against the walls of the mattress *inter alia* to prevent it from sagging, the device forming a border within which appear the words, one above the other, "SPRINGWALL MATTRESS". The right of appeal to this Court, which is in truth a proceeding not in the appellate but in the original jurisdiction, is conferred by ss. 34 and 35 of the *Trade Marks Act*. The applicant has appealed direct from the registrar to this Court in accordance with s. 35 without any intervening appeal to the law officer. Section 34 (4) provides that "The Court shall hear the applicant and determine whether the application ought to be refused or ought to be accepted with or without any modifications or conditions". Sub-section (4) therefore confers on this Court original jurisdiction to determine judicially whether the application should succeed on the merits and not merely jurisdiction to determine whether the deputy registrar is lawfully discharging his duties. A similar hierarchy of discretions is conferred upon the registrar, the law officer, and the Court by ss. 16 (1) (e) and 24 (1) of the *Trade Marks Act*, provisions which, as will appear, play important roles in this appeal. But in exercising this original and independent discretion, due weight will of course be given to the opinion of the deputy registrar as that of a skilled and experienced person: *Innes v. Lincoln Motor Co.* (1); *Jafferjee v. Scarlett* (2); *In re Diamond T. Motor Car Co.* (3); *Re Application by Edward Hack for the Registration of a Trade Mark* (4).

Section 16 of the *Trade Marks Act* provides that "(1) A registrable trade mark must contain or consist of at least one of the following essential particulars:—(a) The name of a company, individual, or firm represented in a special or particular manner; (b) The signature of the applicant for registration or some predecessor in his business; (c) An invented word or invented words; (d) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary significance a geographical name or a surname; (e) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (a), (b), (c)

(1) (1923) 32 C.L.R. 606, at pp. 609, 610, 613, 614.

(2) (1937) 57 C.L.R. 115, at pp. 119, 126.

(3) (1921) 2 Ch. 583, at p. 587.

(4) (1940) 58 R.P.C., at p. 107.

and (d) shall not, except by order of the Registrar, Law Officer, or Court, be deemed a distinctive mark. (2) For the purposes of this section ‘distinctive’ means adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. (3) In determining whether a trade mark is so adapted, the Registrar, Law Officer or Court may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.” Section 24 provides that: “(1) If a trade mark—(a) contains parts not separately registered by the proprietor as trade marks, or (b) contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Law Officer or the Court, in deciding whether the trade mark shall be entered or shall remain upon the register, may in his or its discretion require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any of those parts, or of that matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they think needful for the purpose of defining his rights under the registration. Provided always that no such disclaimer shall affect any rights of the proprietor of the trade mark except such as depend upon its registration. (2) The fact that a mark or matter therein is publicly and honestly used by more than three several persons in any one State as a mark on or in connexion with similar goods shall be treated as conclusive evidence that it is common to the trade.”

The applicant’s proposed mark does not contain any of the particulars comprised in pars. (a) and (b) of sub-s. (1) of s. 16. Paragraphs (c), (d) and (e) of that sub-section are therefore the only paragraphs that need to be considered. The meaning of par. (c) was discussed in this Court in *Howard Auto-Cultivators Ltd. v. Webb Industries Pty. Ltd.* (1) and that of par. (d) in *Mark Foy’s Ltd. v. Davies Coop & Co. Ltd.* (2). Perhaps to the cases cited in *Mark Foy’s Case* (2) might be added, out of many other recent cases appearing in the Reports of Patent Cases that of *Cabin Crafts Inc.’s Application for a Trade Mark* (3) where the application to register “Needletuft” for goods capable of having a tufted or pile surface to obtain which involves the use of a needle was refused because the words “Needle” and “Tuft” conjoined would plainly connote, when used in relation to goods of the kind propounded, that those goods have a tufted or pile surface obtained by the

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(1) (1946) 72 C.L.R. 175.
(2) (1956) 95 C.L.R. 190.
(3) (1955) 72 R.P.C. 333.

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operation of a needle so that the word "Needletuft" had a direct reference to the quality or character of the goods. The word "SPRINGWALL" is nothing more than a combination of two ordinary English words "SPRING" and "WALL". It could not, therefore, in accordance with the principles discussed in the first of these cases qualify as an invented word within the meaning of par. (c). Further, it is a word which has a direct reference to the character or quality of the goods, that is to say, that the walls of the mattresses etc. contain a spring. It could not, therefore, qualify as a word or words within the meaning of par. (d). Thus, it is not a word which by itself could be registered as a trade mark unless it could be held to be a distinctive mark within the meaning of par. (e) and it could not be so held except by order of the registrar, law officer or Court. "Adapted to distinguish" in sub-s. (2) of s. 16 of the *Trade Marks Act* means adapted to distinguish in Australia having regard to the practice and conditions of the trade here, the question being whether, quite apart from the effects of registration, "the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, 'I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons,' and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. It is apparent from the history of trade marks in this country that both the legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the *Trade Marks Acts* a monopoly in what others may legitimately desire to use"; per Lord Parker of Waddington in *Registrar of Trade Marks v. W. & G. Du Cros Ltd.* (1); in *Re an application by F. Reddaway & Co. Ltd. to register a Trade Mark* (2). It is clear therefore that it would be extremely difficult for a word disqualified under par. (d) as descriptive nevertheless to qualify under par. (e) as distinctive. However no such order was sought in the proceedings before the registrar or is now sought before us so the subject need not be pursued. It is not sought to register the word by itself as a

(1) (1913) A.C. 624, at pp. 634, 635.

(2) (1926) 44 R.P.C., at pp. 36, 37.

trade mark. What is claimed to be a distinctive mark is the mark as a whole. The deputy registrar was satisfied that the mark as a whole would qualify as a distinctive mark within the meaning of par. (e). But he was also satisfied that it contained matter of a non-distinctive character, this matter being the device of the spring depicted as a six-sided border to the words. He was of opinion that this border, although it did not depict the spring as an engineering draftsman would depict it, was nevertheless so similar to an orthodox representation of the spring that the differences, while they would be apparent to such a draftsman, would certainly not be appreciated by members of the purchasing public. He considered that the only monopoly, if any, the applicant could obtain for the spring it was making would be under the *Patents Act* or the *Designs Act*, and that the registration of a trade mark containing as one of its essential features a representation of the device of a particular spring would interfere with the rights of other traders entitled to make and sell the same kind of spring to use a similar representation upon or in connexion with the goods they were making and selling. In other words he held that the mark, if registered, would contain matter of a non-distinctive character to the exclusive use of which the applicant was not entitled. He said: "I do not think that the applicant can claim that the differences in its representations when compared with a representation by orthodox draftsman's methods impart any distinctiveness." This led him in the exercise of his discretion to require as a condition of the mark's being entered on the register that the applicant should disclaim any right to the exclusive use of the device of a spring. He said: "In this matter it seems to me most important that I should require the applicant to meet my requirements respecting the disclaimer I have indicated, so that the rights of the public at large will be protected and that traders who have the right to use a spring device in their goods can show members of the purchasing public a fair representation of the spring device which they employ in their goods without being placed in the position of defending their rights in any infringement action taken under the *Trade Marks Act* by the applicant."

The argument for the appellant before us can be summarised under two heads, firstly, it was contended that the device of the six-sided border having circular ends as shown in the mark does not represent the applicant's spring as it would appear if it were drawn by a skilled draftsman but is merely a fanciful or artistic conception of the form of a spring which might be used along the edges of a mattress, sofa, settee, or upholstered seat. Accordingly the border is not a mere representation of the appearance of the

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actual spring used in the mattresses etc. manufactured and sold by the applicant but is a fanciful or artistic design adapted to distinguish the goods of the applicant from those of other traders, and suitable for registration as a distinctive mark under par. (e) of s. 16 (1) of the *Trade Marks Act*. Section 24 is therefore inapplicable because it could not be said that the applicant was not entitled to the exclusive use of that particular conception as a trade mark. Secondly, it was contended that even if the border is not distinctive but merely a descriptive representation of the goods or of a functional feature thereof and s. 24 is applicable, the border forms part only of a mark which is claimed to be distinctive only as a whole and that no sound reason had been advanced why, in the exercise of the discretion conferred by s. 24, the registrar, or the law officer, or the court exercising the discretion ought to require the applicant to submit to a disclaimer of any part of the mark.

In support of the first contention evidence was tendered that no draftsman drawing a border stabilizer spring would ever arrive at a figure resembling the six-sided device except in so far as it could have six sides and circular ends and that no such spring under any condition of lighting could ever look like the six-sided device. Particular reliance was placed on what was said to be the artistic shading of the device and it was claimed that, if any shading was used by a draftsman, a totally different effect would be produced. It was submitted that in the light of this evidence the deputy registrar should have held that the border was of a fanciful or artistic character adapted of itself to distinguish the goods of the applicant from those of other persons and therefore registrable as a separate trade mark. On the other hand, counsel for the registrar contended that the border was clearly not adapted of itself to distinguish the applicant's goods from those of other persons. It might be to some slight extent fancifully or artistically portrayed but it was in essence quite an accurate representation of the appearance of the actual border stabilizer spring used by the applicant in the walls of its mattresses, etc. He submitted that the word "SPRINGWALL" was calculated to attract attention to the fact that these walls contained such a spring and that the combination of the border and of this word was calculated to accentuate the impression that any mattresses etc., with such a spring were the goods of the applicant.

The first contention of the appellant cannot be sustained. Section 50 of the *Trade Marks Act*, so far as material, provides that the registration of a person as proprietor of a trade mark shall give to such a person the exclusive right to the use of the trade mark

upon or in connexion with the goods in respect of which it is registered. Section 53 extends this protection because it provides that the rights acquired by registration of a trade mark shall be deemed to be infringed by the use, in respect of the goods in respect of which it is registered, of a mark substantially identical with the trade mark or so nearly resembling it as to be likely to deceive. There is the gravest risk that the border, as represented in the mark, would as counsel for the registrar submitted, appear to the purchasing public to be an accurate representation of the appearance of the applicant's border stabilizer spring. If this border as depicted were registered as a separate trade mark it would be extremely difficult for any other trader to use a representation of a spring of a similar design upon or in connexion with mattresses, sofas, settees or upholstered seats he was manufacturing and selling containing inner springs without infringing the mark within the meaning of s. 50, or if not s. 50, at least within the meaning of s. 53 of the *Trade Marks Act*. Such meagre artistry as the shading gives to the representation of the border in the applicant's proposed mark appears merely to accentuate the particular shape of the spring and thus help to strengthen the impression that the applicant's mattresses have springs of that particular design. But the applicant is not entitled to the exclusive use of a means of describing mattresses by reference to their having such border stabilizer springs. The appellant relied upon the decision of the Court of Appeal in *In re James's Trade Mark; James v. Soulbby* (1). But that decision seems to have turned mainly upon the fact that the dome-shaped cylinder as a common law trade mark for their black lead had been used by the plaintiffs to denote their goods for twenty-five years and that it had become in fact distinctive of their goods. Whether the decision would have been the same to-day now that it is so clearly established that distinctiveness in fact is not conclusive and that inherent adaptability to distinguish, of which the fact that the mark has proved to be distinctive in use is but evidence, is the true test, *Yorkshire Copper Works Ltd.'s Application for a Trade Mark* (2), may be doubted. The Court of Appeal in *James's Case* (1) made it very clear that an applicant cannot by registering a trade mark protect the shape of his goods. *Lindley* L.J. said: "A mark must be something distinct from the thing marked. The thing itself cannot be a mark of itself, but here we have got the thing and we have got a mark on the thing, and the question is, whether that mark on the thing is or is not a distinctive mark within the meaning of the

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(1) (1886) 33 Ch. D. 392.

(2) (1952) 71 R.P.C. 150, at pp. 153,
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Act" (1). In *James's Case* (2) the trade mark had been registered for nine years whereas in the present case the appellant is applying for registration and at that stage is "*in petitorio*" and if the tribunal is left "*in dubio*" whether to grant the application or not the application should be refused: *Eno v. Dunn* (3). The device forming part of the mark now sought to be registered has not been used as a common law mark in Australia and has not become distinctive in fact. If therefore it was sought to register the border by itself the only question would be whether it was inherently adapted to distinguish the goods of the applicant from those of other persons. That question would have to be answered as the deputy registrar answered it—that is in the negative. Mattresses etc. are purchased by the general public and not merely by a select class of skilled draftsmen, and to the general public the device of the border by itself could easily appear to be nothing more than "a mere pictorial naming of the goods manufactured instead of using the language" per *Hamilton L.J.*, as Lord Sumner then was, in the *Bowden Wire Ltd. v. Bowden Brake Company Ltd.* (No. 1) (4) in the Court of Appeal.

The applicant must therefore succeed, if it is to succeed at all, upon its second contention. Section 24 of the *Trade Marks Act* prescribes the circumstances in which the discretion to require a disclaimer may be exercised and the kind of disclaimer that may be required. But it is clear that, even in cases falling within the subsection, the tribunal still has a discretion whether to require a disclaimer or not. Before the discretion can be exercised at all the tribunal must be satisfied that the trade mark contains either (1) parts not separately registered as trade marks or (2) matter common to the trade or (3) matter otherwise of a non-distinctive character. If this requirement is fulfilled the tribunal has a discretion to require the proprietor either (a) to disclaim any right to the exclusive use of any of those parts or of that matter to the exclusive use of which it holds him not to be entitled or (b) to make such other disclaimer as the tribunal thinks needful for the purpose of defining his rights under the registration.

The discretionary power conferred by (b) would appear to be somewhat wider than that conferred by (a) because, if any one or more of the above circumstances is present, the tribunal may require the applicant to make a disclaimer although it does not hold that the part or matter it requires him to disclaim is a part or matter to the exclusive use of which he is not entitled. But

(1) (1886) 33 Ch. D., at p. 395.

(2) (1886) 33 Ch. D. 392.

(3) (1890) 15 App. Cas. 252, at p. 257.

(4) (1913) 30 R.P.C. 580, at p. 596.

presumably the consideration which would carry most weight with the tribunal in deciding to require a disclaimer under either limb would be that the applicant for a trade mark should not be permitted by the entry of the trade mark on the register to represent to the public that he has the right to the exclusive use of parts or matter to the exclusive use of which the tribunal holds him not to be entitled and such parts or matter would presumably generally be those parts or matter not registrable *per se*. The language of par. (a) of sub-s. (1) of s. 24 of the *Trade Marks Act* would appear to be wide enough to include parts not separately registered by the proprietor of the trade mark either because though registrable the proprietor has not seen fit to apply for separate registration of those parts or because they are incapable of being registered. But presumably it would only be when the tribunal considered that a part was not of itself capable of registration as a trade mark that it would normally proceed to consider whether, in the exercise of its discretion, it should require a disclaimer. A trade mark may be infringed by another trader "if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features": *de Cordova v. Vick Chemical Co.* (1). It would seem therefore that the tribunal should carefully consider whether a disclaimer should not be required whenever the proposed trade mark contains parts or matter to the exclusive use of which the tribunal holds the applicant not to be entitled and those parts or matter appear to be likely to become in use regarded as essential features of the mark as a whole; but that it would not normally require a disclaimer where the parts or matter form an insignificant portion of the mark as a whole, because the risk that another trader who used such portion would infringe the registered mark would be trifling and to do so in such a case would only be to clutter up the register with unnecessary disclaimers. But where a part of a trade mark not separately registered is nevertheless itself of a distinctive character, although it is an essential feature of the trade mark, the tribunal could not hold the proprietor not to be entitled to the exclusive use of that part and therefore could only require a disclaimer if for some other reason, it thought that a disclaimer was needful for the purpose of defining his rights under the registration. The present case is, within those principles, one in which the tribunal would normally require a disclaimer. The device of the border is an essential feature of the proposed trade mark, it is matter of a non-distinctive character, and it is therefore matter

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(1) (1951) 68 R.P.C. 103, at pp. 105, 106.

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to the exclusive use of which the applicant should be held not to be entitled.

In some of the reported cases judges have referred to the manner in which the discretion should be exercised. In *In re Albert Baker & Co.'s Application* (1) *Eve J.* said: "The first observation which it occurs to me to make is that the object of the Legislature was to relieve traders from the necessity of disclaiming, and I think it follows from this that the condition is one for the imposition of which some good reason ought to be established rather than one which ought to be imposed, unless some good reason to the contrary is made out. This conclusion is, I think, fortified by the frame of the section, which is in an enabling form empowering the tribunal to impose the condition—a power which, I conclude, the tribunal would only exercise for good cause shown" (2). In *In re Cadbury Bros. Ltd's Application* (3), *Sargant J.* said that he agreed with the observations of *Eve J.* to the effect that the result of the Act is to throw the onus of justifying a disclaimer on those who seek to have it inserted. In *In re Diamond T Motor Car Co.* (4) *P. O. Lawrence J.* ordered that the applicant's mark should be registered but subject to disclaimers of the exclusive use of the diamond-shaped border and the letter T so that registration should not be thought to have conferred on the applicant any exclusive right to the use of the border or letter. In *Arthur Fairest Ltd.'s Application to Register a Trade Mark* (5) which appears to be the latest reported case in England on the subject, *Lloyd Jacob J.* said that the principles upon which disclaimers are entered upon the register are now thoroughly well settled but his Lordship did not state what those principles are. He said however that he could not detect any indication in the comprehensive and able decision of Mr. Chisholm (an Assistant-Comptroller in the Trade Marks Registry) of any failure to regard those principles and that he himself, if he were seeking to apply them *de novo*, would arrive at precisely the same conclusion as Mr. Chisholm. He said that in those circumstances he would content himself with adopting Mr. Chisholm's language and expressing his gratitude that it was unnecessary for him to formulate in his own language what was there so well expressed. In that case the application for the registration under s. 9 (1) (e) of the *Trade Marks Act 1938* (Imp.) was granted of a mark which his Lordship described as "consisting of the name of the applicant company, written in script form, above it and disposed substantially

(1) (1908) 2 Ch. 86.

(2) (1908) 2 Ch., at pp. 104, 105.

(3) (1915) 2 Ch. 307, at p. 312; (1915)
32 R.P.C. 456, at p. 462.

(4) (1921) 2 Ch. 583.

(5) (1951) 68 R.P.C., at p. 206.

centrally of it a device of a cock, depicted against a semi-circular background of rays with the words 'Cock o' the North' printed in a semi-circular above it" (1). Dealing with the question whether the words "Arthur Fairest Ltd." should be disclaimed because the name of the company could not be registered in Pt. A of the register unless it was represented in some special or particular manner, whereas in the mark the name "Arthur Fairest Ltd." was merely in an ordinary script form and therefore was not registrable (as to which see *Staines v. La Rosa* (2)) Mr. Chisholm said: "With regard to the company name 'Arthur Fairest Ltd.', I do not see why these words should be disclaimed merely because they would not be registrable *per se* as a new mark in Part A of the Register." (3) He then referred to the three circumstances already mentioned in which the registrar may require a disclaimer and proceeded, "In the present case, the requirement of a disclaimer of the name of the applicant company could be made under head (i) only, but if the registrar were to require a disclaimer of the name of an applicant company whenever its name appeared prominently upon a trade mark, the practice would result in what *Sargant J.* (as he then was) referred to in *In re Cadbury Bros. Ltd.'s Application* (4), as the placing on the register of a vast crop of unnecessary disclaimers." (3) After referring to the provisions of s. 10 of the *Patents, Designs, and Trade Mark Act 1888* (Imp.) he concluded "Moreover, the provisions of the various *Companies Acts* are probably sufficient to ensure that the name 'Arthur Fairest Ltd.' is at least unique in this country." (3) So that, with respect, Mr. Chisholm's decision does not appear to throw very much light on the well-settled principles to which his Lordship referred.

The only reported case in this Court relating to disclaimers, *Innes v. Lincoln Motor Co.* (5), was an appeal from the Supreme Court of Victoria (*Irvine C.J.*) (6). The appellant had applied for the registration of a trade mark consisting of a design of which the word "Lincoln" formed the most prominent feature. *Irvine C.J.*, varying the decision of the Deputy Registrar of Trade Marks, held that the mark as a whole was a distinctive mark within the meaning of s. 16 (1) (e) of the *Trade Marks Act 1905-1912* and ordered that it should be entered on the register provided the applicant disclaimed any right to the exclusive use of the word "Lincoln". His decision was upheld by this Court on appeal. His Honour,

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(1) (1951) 68 R.P.C., at p. 204.

(2) (1953) 70 R.P.C. 62, at p. 67.

(3) (1951) 68 R.P.C., at p. 201.

(4) (1915) 2 Ch. 307; (1915) 32 R.P.C. 456.

(5) (1923) 32 C.L.R. 606.

(6) (1923) V.L.R. 359.

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after referring to *inter alia*, *In re Albert Baker & Co.'s Application* (1); *In re Cadbury Bros. Ltd.'s Application* (2) and *In re Diamond T Motor Car Co.* (3) said, in reference to the exercise of the discretion vested in him by s. 24 of the *Trade Marks Act*, "Without attempting to formulate any general rules for the exercise of this decision (*sic* discretion) I think that a disclaimer of the exclusive right to the use of the word 'Lincoln' ought to be a condition of this registration. The word, though incapable of registration by itself, is by far the most distinctive and prominent feature in a label or design which, as a whole, I have considered fit for registration. I see no reason to believe, on the evidence before me, that the intimation to other manufacturers that this registration has not the effect, in itself, of preventing them from using the word 'Lincoln', is calculated to induce them to use that word in such a way as to pass off their cars as the manufacture of the applicant. It is unreasonable to suppose that the latter limitation expressly provided by the Act will be absent from the minds of them and their advisers when considering under what name they may propose to put their motor cars on the Australian market" (4). In this Court *Higgins J.* said: "He" (that is the appellant) "has a right to prevent infringement of the mark as a *tout ensemble*, an 'altogether'; but he has no exclusive right to the word 'Lincoln'. It may be that if there were no disclaimer of that exclusive right, the legal result would be the same; but the disclaimer is, as I understand, ordered for greater caution. Under the former system, before 1905, the applicant had to state, as in patents, what he claimed as distinctive; under the present system, he is relieved of that burden; but the Registrar, or the Law Officer, or the Court is enabled, if he or it see fit, in his or its discretion, to impose a disclaimer, substantially of what is not to be regarded as in itself distinctive" (5). In the joint judgment of *Gavan Duffy* and *Starke JJ.* it is said: "Now the *Trade Marks Act* 1905-1912, s. 24, enables the Court, in its discretion, to require a disclaimer of any right to the exclusive use of any matter of a non-distinctive character, if it holds that the proprietor or applicant for the registration of a mark is not entitled to the exclusive use of that matter. *Irvine C.J.* exercised this discretion against the appellant, and required a disclaimer; and, in the circumstances of the case, we see no reason for interfering with his decision" (6). The passages from the judgments of *Eve J.* in *In re Albert Baker & Co.'s Application* (7) and *Sargant J.* in *In re Cadbury Bros.*

(1) (1908) 2 Ch. 86.

(2) (1915) 2 Ch. 307; (1915) 32 R.P.C. 456.

(3) (1921) 2 Ch. 583.

(4) (1923) V.L.R., at pp. 369, 370.

(5) (1923) 32 C.L.R., at p. 611.

(6) (1923) 32 C.L.R., at pp. 613, 614.

(7) (1908) 2 Ch., at pp. 104, 105.

Ltd.'s Application (1) which have been cited should be read in the light of the particular facts of those cases. In the first case the evidence proved that the mark sought to be registered including the words A. B. C. in respect of which the disclaimer was sought had been used continuously for eleven years and more prior to the date of the application and that the applicant had come to be known to some members of the public as the A. B. C. Tobacconists, that persons so knowing them had in connexion with tobacco and kindred subjects become accustomed to speak of them as A. B. C. and of their shops as A. B. C. shops and that assistants in the shops had from time to time been asked for their goods as A. B. C. goods. Although there was other evidence which proved that the words A. B. C. had also been used by other traders in tobacco so that the proposed trade mark contained matter common to the trade his Lordship in the exercise of his discretion refused to require the proposed disclaimer. He said "During that period" (that is the eleven years prior to the date of the application) "the applicants have had no notice or knowledge that any other person was using any part of the combination which makes up the mark, and no complaint, mistake, or confusion has ever been made or arisen in relation thereto. Under all these circumstances I think I should not only be inflicting an unnecessary hardship on the applicants were I to exercise my discretion by imposing on them a condition requiring them to disclaim any part of their combination, but I should also be establishing a precedent that wherever a claim to monopoly is put forward and fails the condition of disclaimer ought to be imposed, and, as I have already said, I am not prepared to adopt any such general rule" (2). In *In re Cadbury Bros. Ltd.'s Application* (3) Sargant J. refused to require a disclaimer of any right to the exclusive use of the word "Tudor" appearing in the sentence "Tudor Chocolates made by Cadbury" the words being contained in a border consisting of Tudor roses. His Lordship said that he was satisfied that the registration of the whole device applied for could not by any possibility give to the applicants any exclusive right to the use of the word "Tudor" but he was also clearly of opinion on the evidence that the word "Tudor" was not common to the trade and that the word as used by Cadbury Bros. Ltd. in relation to chocolates was not matter of a non-distinctive character. He said: "It has denoted their goods, and therefore the jurisdiction of the Court arises, if at all, under the first branch of the hypothesis

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(1) (1915) 2 Ch., at p. 312; (1915) 32
R.P.C., at p. 462.
(2) (1908) 2 Ch., at p. 106.

(3) (1915) 2 Ch. 307; (1915) 32
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at the commencement of the section, namely, 'if a trade mark contains parts not separately registered by the proprietor as trade marks' " (1). After holding that the word "Tudor" was a part of the proposed trade mark within this branch, his Lordship said that he must proceed on the basis that the jurisdiction given by the section had arisen and that the registrar or the court had a discretion to impose in a proper case a disclaimer by the applicants as a condition of the registration of the trade mark. He said: "I think that the commercial case made on behalf of the applicants is also well founded, namely, that they would by disclaiming on their trade mark any right to the exclusive use of the word 'Tudor' practically be inviting the public to disregard such common law rights as they may have acquired to the use of the name, so that the result would be to give rise to a crop of passing-off actions" (2). His Lordship proceeded: "It is quite true that s. 15 contains an ultimate proviso 'that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made'; but commercial persons do not go about with their heads full of the provisos to sections of Acts of Parliament, and I can quite see that the disadvantage to the applicants of the insertion on the register of such a disclaimer, unless it is really necessary, might well outweigh the advantage to be derived by the public in general from the impossibility of its being said that there was some statutory right as distinguished from a common law right to the exclusive use of the word 'Tudor' in connection with chocolates" (3). But, with all respect to his Lordship, the proviso to s. 24 of the *Trade Marks Act*, which is in the same terms as the proviso in s. 15 of the *Trade Marks Act* 1905 (Imp.), makes it perfectly clear that no disclaimer shall affect any rights of the proprietor of the trade mark except such as depend upon its registration so that the common law right of the proprietor to prevent any other trader passing off his goods as and for the goods of the proprietor of the trade mark is expressly protected. *In the matter of Garrett's Applications To Register a Trade Mark* (4) decided six months later, *Sargant J.* directed that the word "Ogee" should be registered as a trade mark but only upon condition that the applicant disclaimed any right to the use of the letters "O & G." or either of them by virtue of the registration which is some indication

(1) (1915) 2 Ch., at p. 310; (1915) 32 R.P.C., at p. 461.

(2) (1915) 2 Ch., at p. 311; (1915) 32 R.P.C., at p. 461.

(3) (1915) 2 Ch., at pp. 311, 312; (1915) 32 R.P.C., at pp. 461, 462.

(4) (1915) 33 R.P.C. 48.

of the extent to which his Lordship's statements in the *Cadbury Case* (1) were based upon its particular facts. *Irvine C.J.* must surely have been right when he said in *Innes's Case* (2): "It seems to me, with all respect for the opinion of so able a Judge, that the discretion given by s. 24 ought not to be exercised on the assumption that commercial men engaged in the trade affected, and their advisers, are ignorant of the effect which the Legislature has, in the most explicit and definite terms, attached to the insertion of such a disclaimer" (3).

In the present case there has been no prior user in Australia of the mark now sought to be registered in Application No. 115,432, so it could not be suggested that the acceptance by the applicant of the proposed disclaimer could lead to a crop of passing-off actions. The fact is that the proposed mark, even as a whole, consisting as it does mainly of a border and a word each descriptive, the former graphically and the latter verbally, of the character or quality of the goods upon or in connexion with which it is to be used does not rise far above the low water mark of distinctiveness. The back view of the naked man adds little if anything to this distinctiveness. Unassisted by the fact that such an experienced officer as the registrar has found that the mark as a whole is distinctive and to a lesser extent by the fact that it has been registered as a trade mark both in the United States of America, the country of its origin, and in the United Kingdom, after in the latter country the same applicant had agreed to the endorsement on its application of the same disclaimer as the registrar now requires, it might be difficult to form an independent opinion that the proposed mark as a whole is distinctive within the meaning of s. 16 (1) (e) of the *Trade Marks Act*. But it is now well settled that, in determining whether a proposed trade mark is distinctive and ought to be registered, great weight should be attached to the opinion of the registrar. On this aspect see some recent remarks of *Lloyd Jacob J.* in *In the matter of Ford-Werke A.G.'s Applications for a Trade Mark* (4). He said: "By reason of his familiarity with trade usages in this country, a familiarity which stems not only from an examination of marks applied for and of the many trade journals which he sees, but from the perusal and consideration of trade declarations and the hearing of applications or oppositions, the Registrar is peculiarly well fitted to assess the standards by which the trade and public must be expected to estimate the uniqueness of particular indications of

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(2) (1923) V.L.R. 359. (4) (1955) 72 R.P.C. 191.

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trade origin" (1). His Lordship added: "In the consideration of what constituted the distinctive element or elements in the mark, if any, I am satisfied that the Registrar was not required to investigate the trade usages outside this realm, nor to allow his judgment to be displaced by the conclusions of other trade mark registries in other jurisdictions, operating under other systems of law" (2). The Assistant-Comptroller in that case had said: "There has not hitherto been any use of the Applicants' mark in the United Kingdom, and had this case to my mind presented any question of doubt the fact of registration in other countries would have constituted a surrounding circumstance that would have been of importance in favour of the admission to registration of the Applicants' trade mark" (3). Such a circumstance is in cases of doubt of considerable importance, even where there has hitherto been no user of the mark in Australia: *National Cash Register Co.'s Case* (4); *In re Diamond T Motor Car Co.* (5). Accepting the mark as a whole as adapted to distinguish the goods of the applicant from those of other persons its distinctiveness must depend, as has been said, essentially upon the combination of the border and the word "SPRINGWALL". Neither the border nor the word could by itself be registered as a separate trade mark. It would not in these circumstances be fair to rival traders or to the public to place the applicant by registration of the proposed trade mark in a position to acquire a monopoly in the use of the device of the border or of the words "SPRING" or "WALL". Something can be said in favour of the Court's requiring the applicant as a condition of granting the application to disclaim any right to the exclusive use not only of the device of the border but also of these words. But it is just possible that the word "SPRINGWALL", although incapable of registration under s. 16 (1) (d), might by order of the registrar or the law officer or the Court be deemed a distinctive mark within the meaning of s. 16 (1) (e), the tribunal taking care not to forget that, as Lord *Simonds* L.C. said in *Yorkshire Copper Works Case* (6) "paradoxically perhaps, the more apt a word is to describe the goods of a manufacturer, the less apt it is to distinguish them: for a word that is apt to describe the goods of A, is likely to be apt to describe the similar goods of B" (7). See the remarks of *Fletcher Moulton* L.J. in *In re Joseph Crosfield & Sons Ltd.* (8). Section 53A of the *Trade Marks Act*, however, the meaning of which was

(1) (1955) 72 R.P.C., at p. 194.

(2) (1955) 72 R.P.C., at p. 195.

(3) (1955) 72 R.P.C., at p. 192.

(4) (1917) 34 R.P.C. 273.

(5) (1921) 2 Ch., at pp. 591, 592.

(6) (1954) 71 R.P.C. 150.

(7) (1954) 71 R.P.C., at p. 154.

(8) (1910) 1 Ch. 130, at pp. 146-149.

discussed to some extent in *Mark Foy's Ltd. v. Davies Coop & Co. Ltd.* (1), provides that no registration under the Act shall interfere with the use by any person of any bona fide description of the character or quality of his goods. The object of this section is not to afford a guide as to whether a word is adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. It is intended only to protect traders in the bona fide use of a word which has been registered and must be treated as adapted to distinguish such goods. "I do not ignore that some protection is given by s. 8 of the Act (the section of the *Trade Marks Act 1938* (Imp.) similar to s. 53A) but I accept the view frequently expressed in regard to this section, and to s. 44 of the earlier Act which it replaced, and in particular by Lord *Maugham*, Lord *Atkin* and Lord *Russell of Killowen* in the *A. Bailey & Co. Ltd. v. Clerk, Son & Morland Ltd.* (*Gladstonbury Case*) (2), that it should not afford a guide as to whether a name should be registered or not" (3), per Lord *Simonds* L.C. in *Yorkshire Copper Works Case* (4). Section 53A would however protect the bona fide use by other traders of the words "SPRING" and "WALL" in order to describe the character or quality of their goods, assuming the compound word to be an essential feature of the applicant's mark. Accordingly there does not appear to be any sound reason for requiring the applicant to disclaim any right to the exclusive use of the words "SPRING" and "WALL" as a condition of granting the application. But, as s. 53A applies only to verbal descriptions, not to require the applicant to disclaim any right to the exclusive use of the device of the border might well result in the applicant's acquiring the exclusive right to use upon mattresses containing border stabilizer springs a device indicating that they do contain such springs.

For these reasons the deputy registrar was right in refusing the application except subject to the disclaimer he required and the only order that should now be made is to direct the registrar to accept it provided the applicant agrees to endorse this disclaimer on the application. More than one appropriate form of disclaimer could be suggested, for instance, "The proprietor disclaims any right to rely on the registration of this mark as entitling him to the exclusive use of that part thereof which consists of the device of a spring." But the form required by the deputy registrar is quite suitable. It is the same as that endorsed on the application for the same trade mark recently granted to the appellant in the United Kingdom. In Australia the appellant has already agreed

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(1) (1956) 95 C.L.R. 190.

(2) (1938) 55 R.P.C. 253.

(3) (1954) 71 R.P.C., at p. 154.

(4) (1954) 71 R.P.C. 150.

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to endorse the same form on application numbered 111,047 made on 25th August 1952 for a trade mark which has now been granted having the same features as the present application except for the naked man. It is a form which is in common use in trade mark registries in Australia, the United Kingdom and other parts of the British Commonwealth. It has the advantage, as the registrar states, that it disclaims the device in a manner which neither implies nor denies any common law rights. The appellant should be ordered to pay the costs of the registrar of the appeal.

Affirm the refusal of the registrar to accept application number 115,432 dated 8th September 1953 unless the applicant Eclipse Sleep Products Inc., agrees to endorse thereon the following disclaimer "registration of this trade mark shall give no right to the exclusive use of the device of a spring". Direct the registrar to accept the application provided this condition is fulfilled. Applicant to pay the costs of the registrar of this appeal.

Solicitors for the appellant, *T. J. Purcell & Clapin.*

Solicitor for the respondent, *H. E. Renfree*, Crown Solicitor for the Commonwealth.

J. B.