

HOUSE OF LORDS.

Tuesday, April 11.

(Before Lord Macnaghten, Lord Robertson,
and Lord Lindley.)

WEINGARTEN BROTHERS v. BAYER
& COMPANY.

(ON APPEAL FROM THE COURT OF
APPEAL IN ENGLAND.)

*Trade Name—Goods Designated Simply
by Descriptive Name—Distinctive and
Peculiar Method of Printing Name—
Imitation.*

“No trader is justified in taking the peculiar symbol, device, or mark, or any ‘accompaniment’ by which another man distinguishes his goods on the market, and so attract to himself the custom which would otherwise flow to his rival”—*per* Lord Macnaghten.

The appellants, a firm of staymakers, whose principal place of business was in America, introduced into Great Britain a new make of corset which they called “Erect Form Corsets,” and on their showcards, boxes, and advertisements they printed the name in a peculiar and distinctive type upon a special “scroll.” The respondents, a well-known firm of British staymakers, copied this new design in stays and proceeded to sell them in boxes, having on their outside the name “Erect Form Corsets” printed on the identical form of scroll employed by the appellants, with the addition of the letters C.B. (their own trademark) placed upon the right and left of it.

Held (diss. Lord Robertson) that while the respondents were entitled to use the name, the appellants having acquired no special right therein, the latter were entitled to an injunction to restrain the respondents from using the scroll in connection with the goods.

This was an appeal from a judgment of the Court of Appeal (WILLIAMS and COZENS-HARDY, L.J.J., ROMER, L.J., *diss.*) which reversed a decision of JOYCE, J.

The facts of the case appear sufficiently from the judgements, *infra*.

LORD MACNAGHTEN—This case has divided equally the opinions of four learned Judges in the Courts below. It occupied your Lordships’ time for three whole days. But, after all, I cannot think that there is very much difficulty about it. There are no facts in dispute. There can be no controversy as to the law. The only possible questions are—(1) What has the respondent done? and (2) What relief are the appellants (the plaintiffs in the action) entitled to if their rights have really been invaded? Mr Charles Bayer, trading under the firm of Charles Bayer & Company, is the largest maker of corsets in this country. No other trader comes near him in that line. His

wares are on sale in every town in England. His advertisements are flaunted on the walls of every railway station in the United Kingdom. Most women, it is said, if not all, who have come to years of discretion are familiar with his trade-mark—the letters C.B., either standing alone or announced as “The celebrated” C.B. Much time was spent in demonstrating from the evidence of Mr Charles Bayer’s travellers and others the great position of his firm and the comparative insignificance of the appellants’ sales in England. So far from contesting Mr C. Bayer’s claim to pre-eminence in the corset trade, the appellants admitted it to the full, but they urged, with some show of reason, that the commanding position which he occupied made it all the more incumbent upon him to be very careful not to trespass on the rights of smaller men, beginners in the same line of business. The appellants, too, are corset manufacturers. They assert that they hold in America a position similar to that occupied by Mr Charles Bayer here. Until lately they had no footing in England. Not very long ago, about a year or so before the events occurred which led to this dispute, they designed an improved corset. It was an improvement in a make of corsets known to the initiated as “straight-fronted corsets.” They called their new make “Erect Form Corsets,” and they had the name printed in their advertisements and on their showcards and boxes in a very peculiar and distinctive form of type, displaying the word “Corsets” in white letters on a curved band, broad and black, which was made to form a tail to the initial letter of the word “Erect.” Their venture was successful in America. And then with this make of corset, and with the name thus applied to it, they essayed to try their fortune on the London market. They began in a very modest way, but their position improved very soon. Their design was quickly appreciated. Mr Charles Bayer admitted at the trial that “it was practically a new thing,” different from the corsets he had previously sold. In one of his advertisements after he had adopted and appropriated the results of the appellants’ skill and ingenuity, he described the erect form corset as “a departure in corset making which has instantly met with practical recognition.” The name, too, took the fancy of the public. It also was new. No one had known it applied to such a thing as a corset before. It was “a happy description,” as one of Mr Charles Bayer’s witnesses had said—happy, perhaps, because it left it uncertain whether the allusion was to the cut of the garment or to the graceful and stately carriage which the wearer was enabled or compelled to assume. Then the peculiar and distinctive form of type which in these proceedings has been referred to as “the scroll” was a novelty when the appellants’ goods were first introduced into this country. Up to that time, as far as the evidence goes, it had never been displayed in any advertisement of any goods of any sort or description in the English

market. It certainly presented a most striking appearance, well adapted so long as its novelty lasted to catch the eye and arrest the attention of anybody who happened to see it. By the summer of 1901 the appellants were making steady and substantial progress, when Mr Charles Bayer learned from one of his travellers what the American firm was doing. He was, it is said, "alive to the occasion." He procured some of the appellants' corsets. He examined their construction "very carefully indeed." He had them imitated exactly in his own works. The copies made were, he says, in some instances, "absolute copies to the one hundredth part of an inch." He took the name, too, and called the copies, which may or may not have been better than the originals, "Erect Form Corsets," and in one advertisement at least "Genuine" erect form corsets. He was determined to crush the foreign invasion, and, if possible, oust and supplant his American rivals. By the end of September he had placed in the hands of his travellers a stock of erect form corsets sufficient to answer any demand. Now, if he had done nothing more than this, if he had merely copied the article which the American firm had produced and called the copies by the name which they had been the first to use, he might have laughed at any threat of legal proceedings. This new departure in corset making was not protected by any patent. Everybody was free to copy it. The name "Erect Form Corsets" had not acquired any secondary meaning. The words were common English words and simply descriptive. No one could be prevented from using them. But the scroll is a different thing altogether. No trader is justified in taking the peculiar symbol, device, or mark, or any "accompaniment," to use an expression of Lord Langdale, M.R., by which another man distinguishes his goods on the market, and so attract to himself the custom which would otherwise flow to his rival. But Mr Charles Bayer took the scroll just as it appeared on the appellants' boxes. Placing C.B. on the right and C.B. on the left he made it the central and most conspicuous object on his own showcards and boxes. He took it, he said, "from Weingarten's box and his advertisements." He took it, he added, "because it was an effective and suitable form of putting the words." I agree with Romer, L.J. in thinking that there was no excuse or justification whatever for pirating this scroll. No excuse, indeed, was offered. In mitigation of the offence it was said at the Bar that it was a very stupid thing to do. But stupidity is about the last thing to be attributed to a shrewd and successful man of business like Mr Charles Bayer, who, as one of his most experienced travellers says, "knew more of the heart of things" than he did. I agree with Romer, L.J. when he says, "I cannot myself resist the conclusion that the defendants adopted this form of putting their goods on the market in order to make these goods like the plaintiffs' goods. And in my opinion the adoption of this form

at any rate cannot be justified as fair and legitimate competition, and I think that its effect would be to deceive to a substantial extent, not indeed the trade, but the ultimate purchasers, and to allow the defendants' goods to be passed off as and for the plaintiffs' goods to many customers who knew and wanted to buy the plaintiffs' goods." That is really the whole case, and if it had not been for the view taken in the Court of Appeal I should have thought that the action was in truth and reality an undefended action. I should like to know what would have been said if the position of the parties had been reversed—if Mr Charles Bayer had invented this new departure in corset making—if he had hit upon the happy description and applied it with the scroll to his goods, and then the appellants coming new to this country had copied his work, taken the name and pirated his scroll, adding, of course, their own initials, or some distinctive mark to attract purchasers to themselves, and indicate where the goods were to be obtained. Would any human being have believed them, however loudly they might have protested that what they had done was not calculated to deceive, and that they had never thought of deception? It only remains to say a few words about the arguments advanced on behalf of the respondent, especially those that found favour in the Court of Appeal. There was one extremely ingenious argument which, I think, deserves the foremost place. The learned counsel for the respondent contended that there were two distinct and separate grounds of action combined in the present case—one of the very highest importance, the other so insignificant as to be almost beneath contempt. These giants in the corset trade, it was said, knew what they were fighting for, and they were not fighting about trifles. Weingarten and his firm fought for a monopoly in the name "Erect Form Corsets." Mr Charles Bayer, on public as well as on private grounds, was determined that no such monopoly should be gained. He was resolved to throw the trade in the erect form corsets open to all British subjects. That was an honourable and praiseworthy object, it was said. As for the scroll, nobody cared about it. It was a minor point, a petty objection, a mere after-thought. Mr Charles Bayer had vanquished his antagonist on the main question. He was entitled to the spoils. He had carried off the real bone of contention. It was not worth while to make a fuss over the scroll—mere trimming and frippery—a trumpery trick of the printer's art. Mr Charles Bayer was stupid, ill-advised if you will, to carry off the scroll; but that was a venial error. The mistake, such as it was, should make no difference in the costs. At any rate, a very slight deduction would meet the justice of the case. Now, that argument seems to me to be founded on a complete misapprehension. It is quite true that when the contest was raging in the *Drapers' Record* and the other papers that minister to the caprices of fashion, Weingarten's firm claimed an exclusive right in

the name which they had invented. Probably few laymen would understand by the light of nature that it was permissible to take a name and wrong to take the garb in which it was presented to the public. But when the cause of action was formulated there was, I think, no claim to any exclusive right in the name except in connection with the scroll. The action was an ordinary action to prevent Mr Charles Bayer selling his goods as and for the goods of the plaintiffs. It was necessary to bring out all the circumstances of the case, but the scroll was the one thing on which the action was based. Certainly no claim was made at the Bar on the part of the plaintiffs to exclusive property in common English words, which in so short a space of time could not have possibly acquired a secondary meaning. It was also urged that if the plaintiffs really objected to Mr Charles Bayer taking their scroll they ought to have written to complain and told him what they complained of before taking legal proceedings. I cannot think that there is any substance in that objection. Why should a person assailed and injured by unfair competition teach his opponent how far he may safely go in undermining a rival business which he wishes to destroy? Why should he throw away the only chance of obtaining by process of law redress for injury already done? Then it was boldly asserted that all Mr Charles Bayer wanted was to show the public that his goods, English made, were better than any foreign goods and cheaper. That was the view of Vaughan Williams, L.J. "The real object of the defendant," says the Lord Justice, "was not to represent his corsets as being the plaintiff's corsets, but, on the contrary, to invite a comparison between the manufacture of his own goods and those of the plaintiffs." No doubt that is what Mr Charles Bayer said in advertisements in the *Draper's Record*. He was anxious to prove that notwithstanding the silly prejudice in favour of foreign fashions, English goods could hold the field. But when we come to the show cards and advertisements intended to attract customers and not simply addressed to the trade, all this flourish disappears. There is not a single word in any show card or label to tell the public that Mr Bayer's goods were English made, or to invite comparison between his goods and those of American origin. Anybody buying corsets which Mr Charles Bayer described as erect form corsets with the accompaniment of the scroll and the letters C.B. upon them might, I think, well suppose that the goods were the same as those which had been put on the market by the plaintiffs, but with the guarantee of C.B., whoever C.B. was, for their excellence. Lastly, a good deal was made of a statement by Mr Charles Bayer in his defence to the effect that he had ceased to print the scroll, and that, except for the purposes of using up his existing stock, he did not intend to resume its use. I cannot understand why that statement is supposed to tell in his favour. It seems to me to tell very much against him. The writ was

issued on the 15th November 1901, and then, at any rate, his attention was pointedly called to the improper use of the scroll. Still he went on using it; still he continued to print it. He did not cease to print it till the 25th January 1902. His defence was not delivered until the 4th March, and then he declared that the scroll was of no importance to him. I think that was very likely. The novelty of such tricks in advertising passes off very quickly, and they soon cease to be "effective." No doubt long before the defence was put in Mr Charles Bayer had gained all the advantage that could be derived from the improper use of the scroll. But even then he did not offer to pay the costs or to make any amends. He insisted on using the scroll so long as his existing stock might last. Now, it has been held over and over again that if a person persists in using the device of a rival trader which he had no right to use after he knows that it is wrong to use it, that is fraud, even if he originally used it inadvertently and innocently, a suggestion which can hardly be put forward in the present case on behalf of Mr C. Bayer. As regards the form of the injunction, I think that the injunction granted by Joyce, J., is open to objection. It seems to imply that the plaintiffs had some special right in the words "erect form corsets." I think that the order should restrain the defendants, their servants and agents, from selling or offering for sale corsets in boxes bearing the scroll, or an imitation of the scroll used by the plaintiffs in connection with their corsets, or any corsets designated by show cards or labels bearing such scroll, or imitation, or otherwise distinguished by such scroll or imitation, and should direct an account of the profits derived by the defendants from the sale of corsets in such boxes or so designated or distinguished. Ever since the case of *Edelsten v. Edelsten* (7 L. T. Rep. 768; 1 De G. J. & S. 185), in 1862, it has been the established rule that a plaintiff succeeding in a case of this sort may at his option take an inquiry as to damages or an inquiry as to profits. I do not see any ground for departing from that practice in the present case. I do not think that the variation which I have suggested ought to make any difference in costs; and I move your Lordships that the order appealed from be reversed, and that the order of Joyce, J., should be restored with the variation I have mentioned, and that the defendant should pay the costs both here and below.

LORD ROBERTSON — I agree with the judgment of the Court of Appeal. The grounds of my opinion may be stated in a few plain words. The case differs from most passing-off cases in several broad features. The party complaining is not in the position of one whose trade was established and well known in English repute when the respondents are said to have simulated it. Nor can it be suggested that the operations of the respondents were intentionally directed towards getting their goods mistaken for those of the appellants;

the opposite is the case. Nor, again, is the relief which your Lordships propose to give that for which the appellants asked, nor even that which the judge of first instance gave. Finally, the ground upon which your Lordships are to proceed does not represent any grievance felt by the appellants or known to the respondents until the writ was prepared; it was at once removed by the statement of defence; and it is not in truth or substance the question between the parties. In the tentative operations which constituted the trading of the appellants in this country the one thing which they regarded as essential in the description of their corsets was the phrase "erect form." At first the full title was "W.B. erect form corset." Driven out of this by a rival whose initials were also "W.B." they adopted the title "America's leading corset. Erect form corset." But the gist of their case has all along been to claim the description "erect form" as their own. This claim is bad in law for reasons which I do not elaborate, as they are common ground with your Lordships, but they have been borne in upon the appellants only in the course of this suit. But, such as it is, this has been the sole ground of complaint against the respondents, as against the other traders whom they have sued, until the acumen of counsel fished up from the sea of advertisements this scroll which is now the sole surviving part of the case. Now, in a passing-off case it is, of course, not necessary to prove intention to deceive or actual deception; but the absence of both (as in the present case) is highly important. Still more important is the fact that till the writ, and in all the correspondence down to the issue of the writ, there is no hint that the scroll was in fact calculated to deceive. And this is the more important because, such as it is, the scroll was patent and palpable to the appellants. Nor, in the absence of facts, is the attempt to conjure up imaginary deceived customers very successful, when in point of fact every one of the respondents' corsets has C.B., and nothing else, staring the purchaser in the face when she first sees them and every time she puts them on. Indeed, the same obtrusive frankness in revealing the identity of C.B. is to be observed in the scroll itself, on which C.B. is again as prominent as anything else. As I have said, however, when once objection was taken the respondents promptly withdrew the scroll; and, for my part, I put the incident to their credit. What is proposed now is to make the scroll the ground of judgment against the respondents, with costs. In this I cannot concur. I do not think that it is the duty of courts of equity, and still less of this House, to be astute in discovering unfelt grievances and administering one remedy when another is sought and for a different wrong.

LORD LINDLEY—If it were not for the scroll the plaintiffs, who are appellants, would have had no cause of action. But

the defendants cannot, in my opinion, justify their conduct in copying the scroll; and although they ceased to use it, its use gave the plaintiffs a cause of action, and this has not been put an end to. Its importance may have been magnified, but it cannot be ignored; and for the reasons given by Romer, L.J., in the Court of Appeal, and by Lord Macnaghten, whose judgment I have read and am content to adopt, I am of opinion that this appeal should be allowed with costs.

Order appealed from reversed and injunction granted.

Counsel for the Appellants—Neville, K.C. —Sebastian—Noad. Agent—C. Urquhart Fisher, Solicitor.

Counsel for the Respondents—Moulton, K.C. — Astbury, K.C. — Younger, K.C. — Kerby. Agents—Reed & Reed, Solicitors.

HOUSE OF LORDS.

Friday, April 14.

(Before the Lord Chancellor (Halsbury), Lords Macnaghten, Robertson, and Lindley.)

BRINTONS LIMITED v. TURVEY.

(ON APPEAL FROM THE COURT OF APPEAL IN ENGLAND.)

Master and Servant—Workmen's Compensation Act 1897 (60 and 61 Vict. c. 37), sec. 1—Injury by Accident—Disease of Anthrax Contracted in Course of Employment.

Held (diss. Lord Robertson) that a workman, who in the course of his employment as a woollorter contracted anthrax from infected wool, had sustained "personal injury by accident arising out of and in the course of his employment," within the meaning of section 1 of the Workmen's Compensation Act 1897.

The question in this case was whether a workman who contracted the disease called anthrax while employed in a wool-combing factory in which there was wool taken from sheep that had suffered from anthrax and infected with the bacillus of that disease, was injured by an accident arising out of and in the course of his employment within the meaning of section 1 of the Workmen's Compensation Act 1897.

The County Court Judge found that he had met with accidental injury and awarded compensation. His judgment was sustained by the Court of Appeal (COLLINS, M.R., MATHEW, and COZENS-HARDY, L.J.J.).

The County Court Judge found the following facts proved—"I find as a fact that the anthrax which was the immediate cause of death was caused by the accidental alighting of a bacillus from the infected wool on a part of the deceased person which afforded a harbour in which it could multiply and grow, and so cause malignant