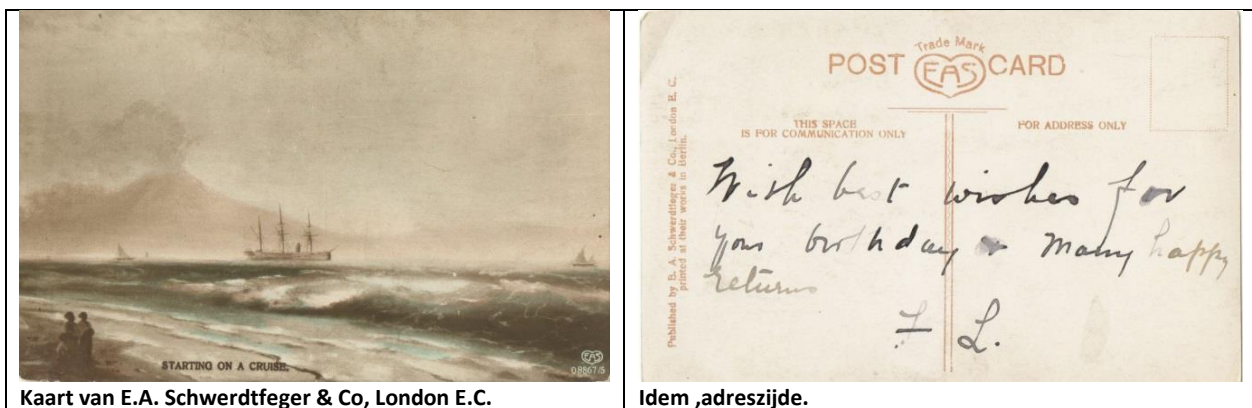


Rechtszaak van E.A. Schwerdtfeger tegen Hart Publishing Company

Concept versie 25 januari 2022

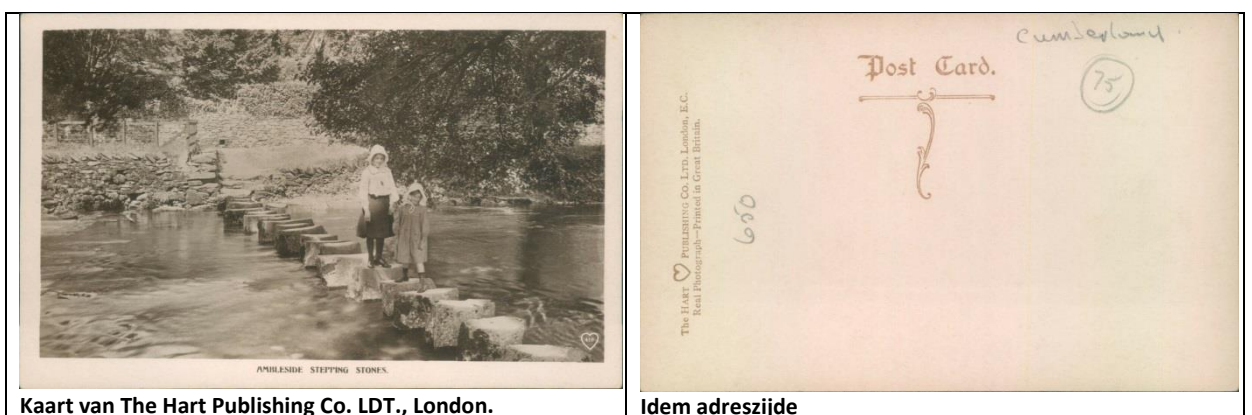
LODEWIJK VAN DUUREN

Van een rechtszaak is sprake als twee of meer partijen een geschil met elkaar hebben en dit geschil door de eiser aan een rechtbank aanhangig is gemaakt; de andere partij is de gedaagde of verweerder. Dit artikel is een samenvatting van de rechtszaak van E.A. Schwerdtfeger versus Hart Publishing Company Ltd. met betrekking tot het merk van beide uitgevers op hun prentbriefkaarten. De rechtszitting vond plaats in het Hooggerechtshof in Londen, afdeling civiele zaken op 16 en 19 februari 1912. Op 10 maart 1911 heeft *E. A. Schwerdtfeger & Co.* een vordering¹ ingesteld tegen de gedaagde *Hart Publishing Company Ltd.*, waarbij hij een rechterlijk verbod eist. De eiser acht het handelsmerk van de *Hart Publishing Company* een inbreuk op het handelsmerk van E.A. Schwerdtfeger en voert aan dat mensen worden misleid door het merk van de gedaagde.



Kaart van E.A. Schwerdtfeger & Co, London E.C.

Idem ,adreszijde.



Kaart van The Hart Publishing Co. LDT., London.

Idem adreszijde

Genoemde personen in het verslag

- De rechter *Parker*
- De eiser *E.A. Schwerdtfeger*

¹ action: a legal and formal demand for enforcement of one's rights against another party asserted in a court of justice.

- De gedaagde *Hart Publishing Company Ltd.*
- *K.C. Walter*² van het advocatenkantoor *Hulbert, Crowe, and Hulbert* , namens de eiser.
- *Colefax* van het advocatenkantoor *Cruessmann and Rouse*, namens de verdediging.
- *Karl Giesen*, de directeur van de Londense tak van *E.A. Schwerdtfeger*
- *Herbert Jones*, handelsreiziger in de groothandel van prentbriefkaarten, eerste getuige van de eiser.
- *P. Adams*, een groothandelaar van kantoor- en schrijfbehoeften in Birmingham, handelt al 10 jaar in prentbriefkaarten, tweede getuige.
- *W. Giesen*, Londense manager van de firma Paul Süß uit Dresden, derde getuige.
- *William Bennet*³, directeur van Bennet and Starling Ltd., kleinhandel in schrijf- en kantoorbehoeften in Enfield, handelt in prentbriefkaarten sedert 15 jaar, vierde getuige.
- *Charles Heath*, een uitgever van prentbriefkaarten en schone kunsten, hij zag de kaarten van de gedaagde in Paternoster Row in Londen, vijfde getuige.
- *Edward Haenel*, directeur van de *Hart Publishing Company* en van de *Rotary Photographic Company*.
- *Victor Rogers*, inkoper in de prentbriefkaartenhandel, eerste getuige van de verdediging.
- *Harry George Butler*, manager van de Regent Publishing Company Ltd., tweede getuige.
- *Walter George Pollard*, groothandelaar en handelaar van prentbriefkaarten, derde getuige.
- *Charles Price* stelt dat hij al vele jaren is verbonden met de boek- en kantoorboekhandel en handelt in prentbriefkaarten en deze in grote aantallen aan het publiek heeft verkocht, vierde getuige.
- *James Barnes*, groothandelaar in prentbriefkaarten. Vijf getuigde.
- *Mr. Hartmann*,⁴ vroeger betrokken in de handel in prentbriefkaarten van de *Hart Publishing Company*. Is dit *Frederick Hartmann* uit Londen met wie *Trenkler Co.* uit Leipzig samenwerkte?

² Eenmaal K.C. Walker gespeld.

³ De correcte naam is Bennett

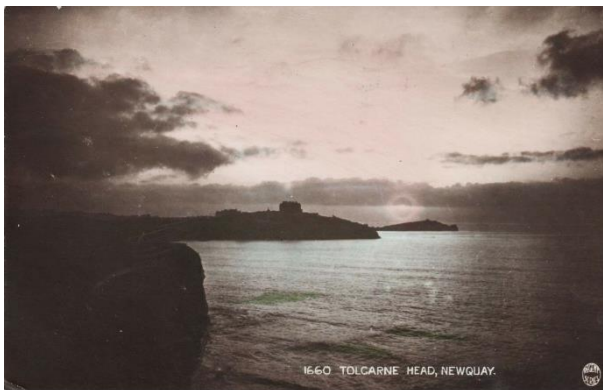
⁴ Eenmaal Hartman gespeld.



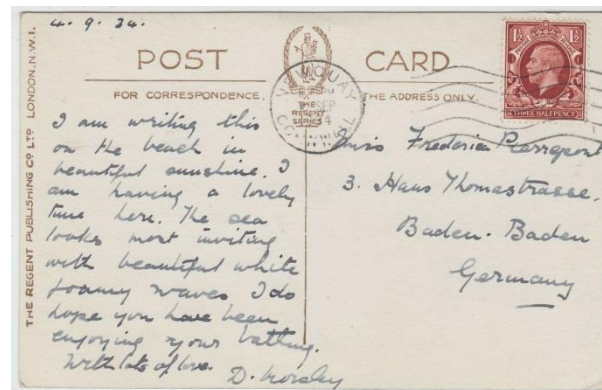
Published by Adams & Co., 48 Bristol Street, Birmingham.



Kaart van Bennett & Starling, Enfield



Kaart van de The Regent Publishing Co., London.



Adreszijde The Regent Publishing Co., London.

Merken

Het merk van beide uitgevers is uitvoerig beschreven in het verslag van de rechtbank omdat alles daarom draait. Het merk van Hart Publishing Company was een hart, met daarin klein gedrukt een letter en een nummer. Het nummer is het nummer van de foto, waaronder die bij de uitgever bekend is, en de letter indiceert de serie waartoe de foto behoort. Op de adreszijde staat tussen "Hart" en "Publishing" ook een hart afgebeeld.

Het ontwerp van het hart van het merk van de eiser was verschillend daarvan, namelijk veel breder dan hoog, terwijl het hart van de gedaagde de gebruikelijke vorm van een hart had. In het hart staan de letters EAS, een afkorting van E.A. Schwerdtfeger. In een van de Engelse advertenties van E.A. Schwerdtfeger waren de letters "E.A.S." een afkorting van "Excellent Achieved Success."

Het verslag maakt ook melding van de registratie van het handelsmerk van E. A. Schwerdtfeger & Co. met een afbeelding van het merk. Het merk is geregistreerd op 6 december 1909 onder No. 318,896 in klasse 38 met betrekking tot prentbriefkaarten.



Merk van E.A. Schwerdtfeger, rechtbankverslag 1912.



Merken van Hart Publishing Co. op kaart

In het verslag van de rechtszaak is elfmaal maal sprake van passing-off, ook als er geen merk of merken geregistreerd zijn. De eiser beschuldigt de tegenpartij dat deze zijn goederen voorstelt als

goederen verkocht door de eiser. Volgens het Engelse recht heeft niemand het recht zijn goederen door te laten gaan (passing-off) als die van een ander, zelfs als er geen sprake is van het gebruik van een (geregistreerd) merk.

Getuigen

De getuigen zijn vooral opgeroepen om zich uit te spreken over de gelijkens dan wel de verschillen tussen beide merken. Beide partijen hebben vijf getuigen laten oproepen. Alle getuigen hebben iets te maken met de uitgifte of handel in prentbriefkaarten. De getuigen van de eiser benadrukten vooral de overeenkomsten en de getuigen van de verdediging de verschillen. De meeste getuigen van de gedaagde benadrukken dat de kaarten van Schwerdtfeger bekend zijn als EAS-kaarten, terwijl die van de gedaagde bekend zijn als HART-kaarten. Een aantal getuigen is ook zelf uitgever van prentbriefkaarten, zoals te zien is in de afbeeldingen. De getuige Herbert Jones verklaarde in het kruisverhoor de sommige kaarten van de eisers een witte rand hebben, maar de meerderheid niet. Hij meende dat alle kaarten van beklagden een witte rand hadden.



Kaart uitgegeven door Paul Süß, Akt. Ges. Dresden.



Idem, adreszijde.

E.A. Schwerdtfeger

“Karl Giesen, de directeur van de Londense branch van de zaak van de eiser, deelde mee dat hij directeur sinds de eerste vestiging in Engeland op 1 januari 1910, maar dat hij heeft gehandeld in prentbriefkaarten van Schwerdtfeger in zijn land gedurende circa tien jaar. Het handelsmerk van Schwerdtfeger & Co. is voor het eerst aangenomen in 1906. Sinds 1910 is de zaak sterk uitgebreid. De kaarten hadden een zeer goede reputatie in de markt en verkocht voor een penny in de kleinhandel. Hij kende de Rotary Photographic Company; zij drukten en publiceerden prentbriefkaarten. Een vertegenwoordiger van de Rotary Photographic Company wendde zich tot hem. Zijn firma weigerde [echter] om de prijs van hun kaarten te wijzigen van een penny naar twee penny's. Hij had voor het eerst aandacht gevestigd op de kaarten van de gedaagde omstreeks het begin van september 1910.

Hij droeg de advocaten van de eisers op om in verbinding te treden met de gedaagden. [Monsters van verhandelde kaarten van de getuige voor 1910 zijn getoond aan de getuige.] Het merk op deze kaarten is hetzelfde als de eisers nu gebruikt. Kaarten met dit merk waren goed bekend bij het

publiek. Het merk was ook gebruikt voor de kantoorartikelen en publicaties⁵ van de eisers, maar, behalve dit, was het voor niets anders dan voor hun prentbriefkaarten gebruikt. De eisers adverteerden in de "British Empire Trades Journal" in 1910 en 1911. De eisers hadden geadverteerd in andere tijdschriften, zoals de "Home and Colonial and Stationers" en "Printers' Gazette." De eisers verkochten aan de groothandel in kantoor- en schrijfbehoeften, die aan winkeliers verkochten, maar in sommige gevallen leverden de eisers rechtstreeks aan de winkeliers.

Toen hij de kaarten van de gedaagde zag, wist hij dat net niet de kaarten van de eiser waren.

Tijdens het kruisverhoor verklaarde hij dat *E. A. Schwerdtfeger* voor vele jaren met de zaak van de eiser verbonden was. Tot eind 1909 hadden de eisers geen vestiging in Londen, maar zij verzonden wel kaarten naar dit land. Tot aan 1909 was de zaak gericht op in chromo-lithografie, maar dat jaar markeerde een sterke ontwikkeling naar glanzend (glossy).

Voor september 1910 verwezen de eisers naar "E.A.S." in hun advertenties als hun handelsmerk.

In februari of maart 1910 hadden de eisers geadverteerd met "E.A.S.", als zijnde hun handelsmerk. Het model om de letters was de omtrek van een hart, het was geen schild. Zowel schilden als harten waren gebruikelijk in de handel in kantoor- en schrijfbehoeften om initialen en namen te omsluiten. Hij wist niet dat de omtrek van een hart in de prentbriefkaartenhandel was gebruikt voor de eisers het in gebruik namen. De initialen zijn zeer bekend, als die van de eisers. In één van de advertenties van de eisers waren de letters "E.A.S." gebruikt voor "Excellent Achieved Success."

Een vertegenwoordiger van de *Rotary Photographic Company* belde in juli 1910 om de eisers er toe te bewegen de prijs van hun kaarten te verhogen. Hij kan niet zeggen of het idee om de Hart-kaarten van de gedaagde te publiceren was bedacht voor of na het interview in juli; zij waren voor het eerst uitgegeven na het interview."

Hart Publishing Company

"*Edward Haenel*, directeur van de gedaagde firma en ook van de *Rotary Photographic Company*, deelde mee dat de firma van de gedaagde is opgericht in augustus 1910. Het idee om prentbriefkaarten van de gedaagde firma uit te geven ontstond voor juli 1910. Hij gaf opdracht om de uitgifte van de kaarten voor te bereiden op 4 augustus 1910. Het verkopen van kaarten voor één penny was de voornaamste reden om de nieuwe firma op te richten, terwijl de *Rotary Company* alleen twee penny-kaarten verkocht. [zij voorkwamen op deze manier, dat bekend werd dat ze hun prijzen met 50% hadden verlaagd⁶]. Een hart is een populaire vorm bij veel ontwerpen van bedrijven en zij kozen een hart, als een deel van de achternaam Hartman(n), die vroeger in de prentbriefkaartenhandel zat. De gedaagden hadden niet de bedoeling de kaarten van de eiser na te maken. Hij had nooit gehoord dat er verwarring was tussen de kaarten van de eiser en die van de gedaagde.

In het kruisverhoor deelde hij mee, dat hij voor het eerst in het voorjaar van 1910 vernam, dat er een grote verkoop van de kaarten van de eiser was. Hij stuurde een vertegenwoordiger naar de eiser om een bepaalde serie te bespreken. De naam *Hart Publishing Company* is bedacht in april 1910. Hij koos voor het merk de hartvorm merk omdat het populair was."

Rotary Photographic Co. Ltd.

In het verslag is verscheidene malen sprake van de Rotary Photographic Co. Deze firma heeft in 1910 een nieuwe maatschappij opgericht onder de naam Hart Publishing Company Ltd.

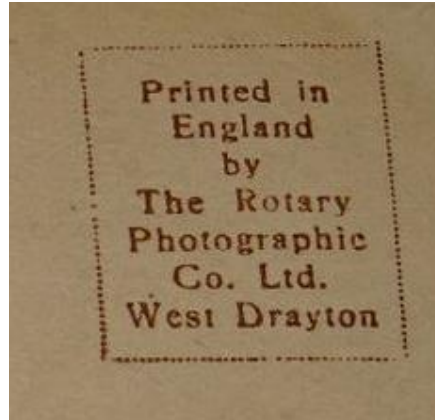
⁵ Waarschijnlijk is bedoeld briefpapier, enveloppen, facturen, prijslijsten e.d.

⁶ [toevoeging uit een ander deel van het verslag].

De Rotary Photographic Co. Ltd in London, geregistreerd als een “limited liability company” op 24 maart 1898, was een zustermaatschappij van de Duitse Neue Photographische Gesellschaft (NPG), gesticht in 1894 in Schöneberg door Arthur Schwarz. Edward Haenel, die is geboren omstreeks 1875 in Berlijn, werd directeur van de Rotary Photographic Co Ltd in West Drayton bij Londen in 1900.



Prentbriefkaart van The Rotary Photographic Co.



Tekst potzegelvak, kaart van The Rotary Photographic Co. Ltd. West Drayton.

Vonnis van de rechter

Een merkhouders kan een derde verbieden om een merk te gebruiken dat identiek is aan het merk van de merkhouders en wordt gebruikt in dezelfde branche als waarvoor het merk is gedeponeerd. De rechter oordeelde echter dat de eiser niet heeft kunnen aantonen dat er sprake was van merkinbreuk en verwerpt de vordering van de eiser.

Het duidelijkste onderdeel van het merk van Schwedtfeger zijn de letters E A S, het platte hart om deze letters is louter een soort ornament, het merk van de gedaagde heeft een nummer en letter in het hart staan, die je met een vergrootglas moet bekijken om deze goed te zien en de omlijsting heeft de gebruikelijke vorm van een hart. Je kunt van deze beide merken niet alleen de omtrek beoordelen, maar je moet het merk als een geheel zien. In dat opzicht zijn de merken naar het oordeel van de rechter voldoende verschillend en geven geen aanleiding tot verwarring.

Verder bracht de rechter de volgende twee gezichtspunten in van de handel in prentbriefkaarten. Ten eerste vanuit het gezichtspunt van het publiek. Wanneer zij kaarten kopen, letten zij niet op het merk, kijken alleen naar de aard van de afbeeldingen, en kopen de prentbriefkaarten die hun bevallen.

Ten tweede de kleinhandelaar of de kleinere groothandel, die bij de grotere groothandel of direct bij de uitgever koopt. Deze personen bestellen kaarten, waarvan ze menen dat ze in hun woonplaats of in hun tak van handel goed verkocht zullen worden. Ze bestellen deze kaarten door middel van het handelsmerk of nog gemakkelijker door middel van de naam van de fabrikant op de adreszijde.

Bronnen

- Anoniem, 1912. E. A. Schwerdfeger & Co. Aktiengesellschaft v. Hart Publishing Company Ld. The Illustrated Official Journal (Patents). May 8, 1912. Reports of Patent, Design and Trade Marks: Cases. Vol. XXIX: 236-244. [zie bijlage]
- Anoniem, 2021. Frederick Hartmann. https://en.wikipedia.org/wiki/Frederick_Hartmann

Bijlage

E. A. SCHWERDTFEGER & CO. AKTIENGESELLSCHAFT v. HART PUBLISHING COMPANY LD.

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Supplement.]

236 THE ILLUSTRATED OFFICIAL JOURNAL (PATENTS). [May 8, 1912
REPORTS OF PATENT, DESIGN AND TRADE MARKS: CASES [Vol. XXIX].

*E. A. Schwerdtfeger & Co. Aktiengesellschaft v. Hart Publishing
Company Ltd.*

IN THE HIGH COURT OF JUSTICE. –CHANCERY DIVISION.

Before MR. JUSTICE PARKER.

February 16th and 19th, 1912.

E. A. SCHWERDTFEGER & CO. AKTIENGESELLSCHAFT v. HART PUBLISHING
COMPANY LD.

5

*Trade Mark. –Action to restrain infringement and passing-off. –Alleged
similarity of design. –Intention. –Characteristics of the Plaintiffs' Trade
Mark. –Action dismissed with costs, except the costs of one issue, which were
given to the Plaintiffs.*

The Plaintiffs, who were a foreign firm and publishers of picture post-cards, 10

*in January 1910 opened a branch of their business in London and registered
as their Trade Mark a heart-shaped design with the initials " E.A.S." in the
centre. They had previously used this mark abroad on their photographs,
some of which had been sent to England and sold to wholesale dealers. Shortly
after the establishment by the Plaintiffs of the branch of their business in London* 15

*the Defendant Company was formed and registered for the purpose of publishing
picture post-cards, which had in the corner a heart, in the centre of which was
printed, very small, a letter and a number. The design of the Plaintiffs' heart
was somewhat different from the Defendants' design being considerably broader
than it was long, while the Defendants' design was the conventional shape of a* 20

*heart. The Plaintiff's brought an action against the Defendants for infringe-
ment of their Trade Mark and for passing-off, and alleged that people had been
misled by the mark on the Defendants' cards.*

*Held, that the characteristic feature of the Plaintiffs' Trade Mark was the
initials and not the design of a heart; that there was no likelihood of deception;* 25

*and that no one would be likely to mistake the Defendants' mark for the
Plaintiffs'.*

*The action was dismissed ,with costs, except that the costs of proving the
Plaintiffs' title, of which the Plaintiffs had given notice to admit, were given
to the Plaintiffs.*

30

On the 6th of December 1909 *E. A. Schwerdtfeger & Co.* registered under No. 318,896 in Class 38, in respect of pictorial post-cards, the following Trade Mark.



On the 10th of March 1911, *E. A. Schwerdtfeger & Co.* commenced an action against the *Hart Publishing Company Ltd.*, claiming an injunction to restrain

35

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them, their servants and agents, from infringing the Plaintiffs' registered Trade Mark No. 318,896, and from passing-off their goods as and for the goods sold by the Plaintiffs, and for consequential relief.

The Statement of Claim as amended was, so far as material for this report, as follows :—" (1) The Plaintiffs are a limited liability Company registered in
5 "Germany, and carry on their business in Berlin and London, (2) The
" Plaintiffs are the successors of *E. A. Schwerdtfeger & Co.*, and their business
" consists in the publication and sale of (*inter alia*) picture post-cards, and they
" have acquired a great reputation among the trade and the public, both in
10 "Germany and in England, for picture post-cards of their manufacture or
"merchandise. (3) In or about the year 1906 the Plaintiffs' predecessors, *E. A.*
" *Schwerdtfeger & Co.*, adopted and caused to be printed on all picture post-
cards of their manufacture or merchandise (so far as the same were published
" on their own account) a mark which consists of a design in the shape of a
15 "heart with the letters 'E.A.S.' inscribed therein, and the said *A. E. Schwerdt-*
feger & Co., and their successors the Plaintiffs, have since that date continuously
" applied the said design as a Trade Mark to all picture post-cards of their
" manufacture or merchandise so far as aforesaid. (4) The said Trade Mark
" was registered in England in the Register of Trade Marks under No. 318,896
20 "by the Plaintiffs' predecessors as the proprietors thereof on the 6th of
" December 1909, in Class 39 for pictorial post-cards. (5) The said *A. E.*
" *Schwerdtfeger & Co.*, by a document of title executed on or about the 5th of
" August 1910, transferred the whole of the assets of their business and the
" goodwill thereof to the Plaintiffs and, on or about the 5th of January 1911, at
25 "the joint request of the said *E. A. Schwerdtfeger & Co.* and of the Plaintiffs,
" the Plaintiffs were duly registered as proprietors of the said registered Trade
" Mark in the Register of Trade Marks and they are now the proprietors
" thereof. (6) The Plaintiffs, and their predecessors in the business carried on
" by the Plaintiffs as aforesaid, have extensively used the said mark as a Trade
30 " Mark upon picture post-cards sold by them in England since the year 1906,
" and on all their circulars, note-paper, invoices and advertising literature, and

" the Plaintiffs continue to extensively use the said Trade Mark as aforesaid.
 " (7) By reason of the user, alleged in the last paragraph, the Plaintiffs' picture
 "post-cards, marked with the said Trade Mark, have become known to
 35 "purchasers or intending purchasers within this realm as picture post-cards
 " published or sold by the Plaintiffs and by none other. (8) The Defendants
 " were registered on or about the 19th of August 1910 as a limited liability
 "Company. (9) The Plaintiffs have recently discovered, as the fact is, that
 40 "the Defendants are publishing and selling picture post-cards, not of the
 "Plaintiffs' manufacture and merchandise, bearing on their picture side a mark.
 " consisting of a design in the shape of a heart with small numerals and a
 " letter or letters inscribed therein, and on their address side the name of the
 " Defendants with the outline of a heart interposed between the words ' Hart'
 " and ' Publishing' ."
 45 The Plaintiffs claimed :—" (1) An injunction to restrain the Defendants, their
 " servants or agents, from infringing the Plaintiffs' registered Trade Mark (No.
 " 318,896), and from passing off picture post-cards, not of the Plaintiffs' manu-
 "facture or merchandise, as and for picture post-cards of the Plaintiffs. (2)
 " Delivery up to the Plaintiffs by the Defendants, upon oath, of all picture post-
 50 "cards not of the Plaintiffs' manufacture or merchandise in the Defendants'
 " possession, or under their control, which infringe the said registered Trade
 " Mark, or are marked with said device of a heart. (3) Damages or an account
 "of profits. (4) Costs."

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The Defendants by their Defence stated :—" (1) No admission is made as to
 " any allegation in the amended Statement of Claim. (2) The alleged assign-
 "ment, as to which no admission is made, referred to in paragraph 5 of the
 " amended Statement of Claim, was not a valid assignment of the alleged Trade
 " Mark, as the goodwill of the business concerned in the goods (if any) for
 " which the said Trade Mark was, if at all, registered, was not thereby assigned,
 " nor has it ever been assigned to the Plaintiffs, The Plaintiffs are not the
 " duly registered proprietors of the said alleged Trade Mark as alleged, or at all.
 " (3) The Defendants have not as alleged, or at all, infringed the said alleged
 "Trade Mark. (4) Every allegation in paragraph 12 of the amended State-
 " ment of Claim is denied as fully as if herein set forth and separately
 " traversed." 5 10

The action came on for trial before Mr. Justice PARKER on the 16th of
 February 1912.

Walter K.C. and *Hume* (instructed by *Hulbert, Crowe, and Hulbert*) appeared
 for the Plaintiffs ; *Colefax* (instructed by *Cruesmann and Rouse*) appeared for
 the Defendants. 15

Walter K.C. opened the Plaintiffs' case.—The Plaintiffs, having registered
 their Trade Mark on the 1st of January 1910, opened a branch of their business
 in England. They soon became well known for the beauty of their produc-
 tions, which acquired a large sale in this country. The *Rotary Photographic* 20

Company were largely concerned in the same sort of business, but whereas the Plaintiffs sold their cards for one penny, the *Rotary Photographic Company* charged two pence, and tried to induce the Plaintiffs to raise the price of theirs. This the Plaintiffs declined to do. The next step was the formation of a private Company, the Defendants in this action, in which there is no person of the name of Hart, and there never has been. This Company took over no existing business at all. They produced cards at one penny, and took a heart as their Trade Mark, The Defendant Company was registered on the 19th of August 1910. The word "Hart" has no association with the symbol of a heart, [It was admitted by Counsel that the goodwill was assigned to the Plaintiffs with the Trade Mark.] The Defendants do not attack the Plaintiffs' Trade Mark, but they deny infringement. [Reference was made to the judgment of *Cotton L.J.* in *Upper Assam Tea Company v. Herbert & Co.* (7 R.P.C. 183, at page 186; and to *Kerly on Trade Marks* (Third Edition, pages 399-401).] Complaints have been received from various people who have been deceived. The writ was issued on the 10th of March 1911. Evidence on behalf of the Plaintiffs was then given. *Karl Giesen*, manager of the London Branch of the Plaintiff Company, stated, that he had been manager since its first establishment in England on the 1st of January 1910, but had dealt in post-cards of *Schwerdtfeger* in this country for about ten years. The Trade Mark had been first adopted by *Schwerdtfeger & Co.* in 1906. The business had much increased since 1910. The cards had a very good reputation in the market and sold at one penny retail. He knew the *Rotary Photographic Company*; they printed and published post-cards. A representative from the Rotary Photographic Company called on him. His firm declined to alter the price of their cards from one penny to two pence. He first had his attention called to the Defendants' cards about the beginning of September 1910. He instructed the Plaintiffs' solicitors to communicate with the Defendants. [Samples of the cards dealt in by the witness before 1910 were shown to witness.] The mark on these is the same as the Plaintiffs now use. Cards bearing that mark were well known to the public. The mark was also used on the Plaintiffs' stationery and literature, but, except for this, it was

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used on nothing else but their post-cards. The Plaintiffs advertised in the "British Empire Trades Journal" in 1910 and 1911. The Plaintiffs had advertised in other journals, as for instance, the "Home and Colonial and Stationers' and Printers' Gazette." The Plaintiffs sold to wholesale stationers who sold to shopkeepers, but in some cases the Plaintiffs supplied shopkeepers direct. When he saw the Defendants' cards he knew that they were not the Plaintiffs'. In *cross-examination* he stated that *E. A. Schwerdtfeger* had been associated with the Plaintiffs' business for many years. Till the end of 1909 the Plaintiffs had no place of business in London, but they had sent cards to this country. Up to 1909 the business was more in chromo-lithograph, but that year marked a big development of glossy. Before September 1910 the Plaintiffs referred to the

" E.A.S." in their advertisements as their Trade Mark. In February or March 1910 the Plaintiffs had advertised with "E.A.S." stated to be their Trade Mark. The device enclosing the letters was the outline of a heart, it was not a shield.

15 Both shields and hearts were used in the stationery trade to enclose initials or names. He did not know that the outline of a heart had been used in the post-card trade previous to the Plaintiffs' use of it. The initials were well known to be those of the Plaintiffs. In one of the Plaintiffs' advertisements the letters" E.A.S." were used for "Excellent Achieved Success." A repre-

20 sentative from the *Rotary Photographic Company* called in July 1910 to induce the Plaintiffs to raise the price of their cards. He could not say whether the idea of publishing the "Hart" cards of the Defendants was conceived before or after this interview in July; they were published for the first time after the interview.

25 *Herbert Jones*, a traveller in the wholesale pictorial post-card trade, stated, that he dealt in both the Plaintiffs' and the Defendants' post-cards. When he first saw the Defendants' cards he thought that they were the "E.A.S." cards. He was not aware of any card, other than the Plaintiffs', on the market with a heart design until the Defendants' appeared. He had known doubts as

30 to whether certain cards were the Plaintiffs' or the Defendants'. In *cross-examination* he stated that some of the Plaintiffs' cards had a border and some had not, the majority had no border. He believed that all the Defendants' cards had a white border.

P. Adams, a wholesale stationer at Birmingham, stated, that he had dealt in

35 post-cards for ten years. He had first bought the Plaintiffs' cards in the beginning of 1910. In 1911 he saw some post-cards in a neighbour's window which he took to be publications of the Plaintiffs. He wrote a letter of the 22nd of February to the Plaintiffs, asking why they had not sent him samples. The Plaintiffs' manager then called on him. He got some of

40 the cards he had seen and sent them on to the Plaintiffs. In *cross-examination*. he stated, that he had never sold the Defendants' cards. The public did not ask for the Plaintiffs' cards by any particular name. It was the front of the Defendants' cards that he noticed in the window.

W. Giesen, London manager of *Paul Suss*, fine art publishers of Dresden,

45 stated, that he saw in Torquay, in 1911, a series of local view post-cards, and thought at first that they were the Plaintiffs', but on looking more closely he could not find the initials" E.A.S." there. In *cross-examination* he stated that on looking more closely he knew that they were not the Plaintiffs' cards.

William Bennet , a director of *Bennet and Starling Ltd.*, retail stationers at

50 Enfield, stated, that his Company had dealt in picture post-cards for fifteen years. They had dealt in the Plaintiffs' cards since they first came out. He first saw the Defendants' cards last July or August, when he thought that they were the Plaintiffs' and showed one of them to a customer by mistake for the

the Plaintiffs' on post-cards. In cross-examination he stated that he did not look to see if the letters" E.A.S." were on the card; it was a good card and had a heart mark on it, and he thought it was the Plaintiffs'.

Charles Heath, a post-card and fine art publisher, stated, that he first saw the Defendants' post-cards in Paternoster Row, when he thought they were the Plaintiffs.' He closely examined them, and found that they were not the Plaintiffs' cards. 5

Colefax for the Defendants.—No member of the public has been called to give evidence. The public purchase cards from the picture represented not from the mark on them. The characteristic of the Plaintiffs' Trade Mark is the initials" E.A.S." The Plaintiffs now seek to claim the monopoly of a heart device to which they have no right. They have always emphasised the initials in all their advertisements. [Reference was made to the judgment of *Cotton L.J.* in *Upper Assam Tea Company v, Herbert & Co.* (7 R.P.C.,183 at page 186).] Evidence on behalf of the Defendants was then given. 10 15

Edward Haenel, a director of the Defendant Company, and also of the *Rotary Photographic Company*, stated, that the Defendant Company was incorporated in August 1910. The idea of publishing the Defendants' cards had been conceived prior to July 1910. He gave instructions to prepare the cards on the 4th of August 1910. He principally conceived the idea of forming the Defendant Company. It was formed with the intention of selling penny cards, as the *Rotary Company* sold only two-penny cards. A heart was a popular form of design in many trades, and they took the name " Hart" from part of the name of *Hartman*, who was formerly in the post-card trade. The Defendants had no intention of copying the Plaintiffs' cards. He had never known any confusion between the Plaintiffs' and the Defendants' cards. In *cross-examination* he stated, that he first learnt that there was a large sale of the Plaintiffs' post cards in the spring of 1910. He sent a representative to the Plaintiffs to discuss a certain series. The name *Hart Publishing Company* was thought of by April 1910. He choose the heart shape for a mark because it was popular. 20 25 30

Victor Rogers. a buyer in the post-card trade, stated, that he had dealt in post-cards for fifteen years, and had bought the Plaintiffs' and Defendants' cards since they first came out. The Plaintiffs' cards were known as " E.A.S." cards. His firm sold to retailers as well as to the public. He had never heard of any confusion between the Plaintiffs' and the Defendants' cards, The Defendants' cards were asked for as the " .Hart" cards. I t was very easy to distinguish between the Plaintiffs' and the Defendants' cards. 35

Harry George Butler, manager of the *Regent Publishing Company Ltd.*, stated, that his Company made and bought post-cards and they dealt in cards made by the Plaintiffs and the Defendants. The Plaintiffs' cards were known by the mark "E.A.S." He had never heard them called the "Heart" cards. The Defendants' cards were called the "Hart" series. There was a great distinction in the appearance of the Plaintiffs' and the Defendants' cards. 40

Walter George Pollard, wholesale trader and dealer in picture post-cards, stated, that he had been in the trade for fifteen years and had dealt in both the 45

Plaintiffs' and the Defendants' cards, but he had not dealt in the Plaintiffs' since they opened a business in London. The Plaintiffs' cards were known as "E.A.S." cards, and the Defendants' as the "Hart" series. There was a great distinction between the two in tone, mark, and form.

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Charles Price stated that he had been connected with the bookselling and stationery business for many years, and had dealt in post-cards and sold very large numbers to the public. The public did not attach any importance to

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marks. He knew the Plaintiffs' cards as "E.A.S." and the Defendants as the "Hart."

James Barnes, a wholesale trader in picture post-cards, stated, that he sold to dealers. He had dealt in the Plaintiffs' cards; they were known as the

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"E.A.S." cards. The Defendants' cards were known as the "Hart" cards. *Colefax* summed up.—There has been no evidence to show that the public pay any attention to the marks, but, on the contrary, there is evidence showing that the public pay no attention to the marks. There is no evidence upon which it could be held that there has been any infringement of the Plaintiffs' Trade Mark. The heart shape of the Plaintiffs' mark has not impressed itself upon any of the witnesses as being the principal feature of the mark; the characteristic which has impressed them is the initials. Further, there is no evidence that anyone has in fact been deceived. [PARKER J. —The retailers do not purchase because of the publisher but because it is a particular line they think may sell.] That is so undoubtedly. The suggestions that people were deceived did not stand the test of cross-examination, for all the Plaintiffs' witnesses admitted that when they looked for "E.A.S." and failed to find it they knew that the card could not be the Plaintiffs'. The evidence given by the Defendants' witnesses entirely establishes the fact that there is no chance of the one mark being mistaken for the other. [The following cases were referred to:—*In the Matter of Bradley's Trade Mark* (9 R.P.C. 205); and *Edelsten v. Edelsten* (1 De G. J. & S. 185).] I submit that the Plaintiffs have failed to show any infringement of their Trade Mark, and that there has been no passing-off

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Walter K.C. replied.—I show that the Plaintiffs' have a registered Trade Mark which is not attacked, and then the question is whether the Defendants are placing on their goods a mark which is liable to be mistaken for the Plaintiffs' mark? [Reference was made to *Curtis and Harvey v. Pape* (5 R.P.C. 146).]

As to passing-off, I submit, that if the get-up is such as to lead to confusion it does not avail a defendant to show that he has put his name on his goods.

[PARKER J.—What is the test of infringement of Trade Mark? You have to compare the marks as used on the goods. Confusion has been caused in the minds of six traders who have given evidence. [PARKER J. —But they said that on looking closer they saw the difference.] Every Trade Mark could be destroyed in that way; of course there is always some feature which, when looked at closely, is somewhat different. [PARKER J. —The mark must be looked at as a

whole and not in separate parts.] The whole Trade Mark has to be considered. No trader has a right to label his goods so as to make them liable to be mistaken for the goods of another trader. The Defendants have used a mark which is indistinguishable from the Plaintiffs'. I submit that they have infringed and that the Plaintiffs are entitled to relief.

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PARKER J. –This is an action for infringement of a Trade Mark combined with a claim for passing off the Defendants' goods as the Plaintiffs', and, to a certain extent at any rate, the principles by which the Plaintiffs' rights in such an action are to be judged are the same, though in some respects there are differences.

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The Trade Mark of the Plaintiffs, which was registered under the Act of 1905 as a new mark - not as one used before 1875 - consists of the initials "E.A.S." with a framework design round it in the shape of a heart. It is not quite a heart in the ordinary conventional sense, but is much flattened out so as to be considerably broader than it is long, and inside it are the initials " E.A.S.," being the initials of the Plaintiff firm. There is evidence that before the registration of this mark the Plaintiffs, who are a foreign firm publishing

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picture post-cards, used it on their cards for the purpose of distinguishing their goods from the goods of other manufacturers, though at that time they had no branch in this country, confining their business here to selling to wholesale dealers. At the beginning of 1910, however, they started a branch of their business here, that branch being under the management of Mr. *Giesen*, who used in old times to be a buyer from them. That species of picture post-card for which they are famous are the bromide photographs, and they apparently have always sold them at a penny, whereas their rivals, the *Rotary Photographic Company*, sell a similar line of goods at two pence. There was at one time some negotiations between the *Rotary Photographic Company* and the Plaintiffs with a view of preventing prices being cut by the sale of the other goods at a penny, but those negotiations did not come to anything. In the spring of 1910 the *Rotary Photographic Company* appear to have taken measures for the formation and registration of a new Company, which they proposed to call the *Hart Publishing Company* Ltd., in order that that Company might publish a series of picture post-cards which they intended to sell at a penny instead of two pence, they themselves not wishing to be known as having reduced their price with regard to any of their wares by fifty per cent. Some suggestion has been put forward that the registration of this Company was in fact part of a fraudulent design, whereby the *Rotary Photographic Company* might, by infringement of the Plaintiffs' Trade Mark, get the advantage of a part of their trade. I do not think that any very clear or lucid reason has been given by the witnesses as to why the Company was called the *Hart Publishing Company*, Hart being spelt " Hart," but apparently it had something to do with the proposal of employing Mr. *Hartmann*, who before had been concerned with the same species of business. I do not think, however, that there is any

real ground for thinking that the adoption of the term "*Hart Publishing Company*" or the subsequent adoption of the heart pattern, for purposes which I shall hereafter describe, is evidence of any desire or intention on the part of the Defendants to act unfairly by the Plaintiffs. I believe Mr. *Haenel* when he says that he did not consider that what he was doing could in any way be construed as unfair to them or as an infringement of their mark. What was done, however, was this :—the *Hart Publishing Company* having been registered, that Company proceeded to sell photographs, in the corner of which there is a heart of the conventional shape, being considerably different from the Plaintiffs' heart, and in the centre of that heart, for the purpose it appears of identifying the particular photographs so that they might be ordered by a letter and number, they inserted in very small letters the number by which the photograph was to be known, and the letter which indicated the series of that photograph. So that anybody having seen a photograph, which they liked, might order it from the *Hart Publishing Company* by the letter and number, without going into any details or description, and such orders would be less liable to mistake than they otherwise might have been. That mark is on the face or the photographic side of the post-card. On the reverse or address side anybody, who chose to read, would see that the publishers were the *Hart Publishing Company Ltd.*, London, E.C., and the Hart, though spelt "Hart," is accompanied by the conventional heart which appears on the face of the photograph, and evidently indicates a desire on their part to connect in the mind of the public the heart shape with their name. I think there can be no doubt about that

For years prior to that, the Plaintiffs had also on the photographic side of their picture post-cards, their own flattened-out heart, with the letters " E.A.S." clearly marked in the centre. In fact on parts of two specimens which I have

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here, I find, even with my eyes, that I can see at a considerable distance that the prominent part of the Plaintiffs' mark is the letters "E.A.S." I cannot mistake them. If I were asked to describe the mark, those letters would strike me as the salient feature far more than the outline, which as I say, is nothing more than a conventional outline; it is an outline of a flattened-out heart which makes an ornamental margin for the three initials. On the other hand, if I look at the Defendants' mark what I see is merely the conventional heart and something inside, which my eyes cannot distinguish without a magnifying glass or a very strong light. But certainly I should not have said that they were the initials " E.A.S."

The point I have got to consider is, whether the Defendants' mark, so used, is in reality an infringement of the Plaintiffs' mark. It must be remembered that, being registered under the Act of 1905, the mark comes under that paragraph (5) of Section 9 which deals with distinctive marks other than those which have been mentioned before, and as a matter of fact it can only be as a distinctive mark – a mark which is adapted to distinguish the

Plaintiffs' goods from any other person's goods – that the Plaintiffs can register the mark at all. It appears to me that I 'cannot look at the outline without the initials, or the initials without the outline, as constituting the essential feature.

20 I must look at the mark as a whole – the combination of the letters with That particular device. It appears to me, looking at these two marks as an ordinary individual, that I personally should never have mistaken the one for the other, but certain evidence has been given, which may be material on the question of infringement as well as on the question of passing-off. It is said

25 that there has been actual deception, and that I must give much more weight to that actual deception than I do to what my own opinion may be on putting the two marks before me and asking if one was likely to be taken for the other, or is an imitation or colourable imitation of the other.

In the post-card trade there are two points of view that must be considered.

30 One is the point of view of the public when they buy for their own purposes because they want picture post-cards, and the other is the point of view of the tradesman– the retail tradesman or the smaller wholesale tradesman—who buys either from a bigger wholesale tradesman or from the publishers. I think it is common ground in this case that, as far as passing-off

35 is concerned, the outside public may be entirely neglected. They do not look at the marks; they simply look at the nature of the pictures, and if they like them they order particular post-cards. I think the evidence also points to this, that even the persons ordering the cards for the purposes of the retail trade buy those lines which, judging by the picture, they consider are

40 likely to go well in their particular locality or their particular branch of the trade, and that it is only when they have chosen the pictures they desire to buy, that they order them, sometimes identifying them by means of the Trade Mark on the face of the post-card, or, what is much more simple, looking at the address which is given on the back with the name of the

45 manufacturer. However, I have this evidence, that four or five persons have said in the witness-box that, when first they saw the Defendants' cards, misled by the white mark in the corner, they thought they that were the cards of the Plaintiffs. But each and everyone of those persons said that when they came to look at the cards they saw that it was not so. It was only their first

50 impression, and I think that first impression did not arise from any likeness between the two marks but from the fact of both having small marks on the face of the card; and these particular gentlemen not being familiar with other small marks of a like nature on the face of the card, their first impression was

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that these cards were the Plaintiffs' goods, an impression which could have led to no real deception, and an impression which was corrected immediately afterwards when they came actually to look at the cards. Am I, because of that, to ignore wholly what my own opinion is when I look at the marks, and to say that these marks are so used as to be calculated to be mistaken the one for the other, or as to lead to deception for which the usual remedy in a passing-off action

may be given, namely, an injunction? In my opinion this is not. I think that each witness was perfectly candid, and as I understood each witness all he meant was, that looking at cards sometimes through a shop window, sometimes casually on the counter, his first impression had been that they were the Plaintiffs' goods, but that that impression was immediately corrected without any difficulty, not by a prolonged examination through a magnifying glass, but by simply looking at them, when he noticed at once that, whatever was inside the heart mark on the Defendants' goods, it certainly was not the "E.A.S." which the witnesses considered to be the distinguishing part of the Plaintiffs' Trade Mark; and that that is the distinguishing part, or is considered to be the distinguishing part, of the Plaintiffs' Trade Mark, appears to me to be abundantly proved, not only by the evidence of the witnesses but by the line which the Plaintiffs themselves have taken in their own advertisements. It appears to me that they have done what they could to get, and have succeeded in getting, their goods known as the " E.A.S." goods, or the "E.A.S." cards, and that the heart which forms the outline round those letters, as appears in the advertisements and as appears also on the face of the cards, is not that part of the mark which strikes the trade, or, if the public are to be considered, the public. It is not the heart but the " E.A.S." that strikes them. Having regard to what I have said, it appears to me that certainly there can have been no deception and there can be no likelihood of deception, such as to induce me to grant an injunction. It also appears to me that, having regard to the nature of the evidence as to confusion between the two marks which has been given, I am not at liberty to ignore what I feel strongly upon myself, namely, that no one would be likely to mistake one mark for the other, and therefore it appears to me that the action fails.

Colefax.—The action will be dismissed with costs?

PARKER J.— Yes.

Walker K.C. asked that the Plaintiffs might have the costs of proving the document of the 5th of August referred to in paragraph 5 of the amended Statement of Claim and paragraph 2 of the Defence, which was a German document. He stated that notice to admit had been given to the Defendants on the 17th of October 1911, and that the Defendants had previously thereto had a copy of the document, so they had the opportunity of admitting the document if they liked. As they did not, the Plaintiffs were put to considerable expense in proving it.

Colefax submitted that as the document constituted the Plaintiffs' title it was for them to prove it.

PARKER J. —Having regard to the notice to admit, I think that the Plaintiffs are entitled to the costs of that particular issue, in accordance with the spirit of the Rule on the subject, particularly as the notice was given after the production of the document, so that the Defendants had the whole of the facts before them. There is a plea that the document is not valid.

