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## The Place of *Scienter* in Trade Mark Infringement in Nineteenth Century England: The Fall and Rise of *Millington v. Fox*.

Lionel Bently

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THE PLACE OF *SCIENTER* IN TRADE  
MARK INFRINGEMENT IN NINETEENTH  
CENTURY ENGLAND: THE FALL AND  
RISE OF *MILLINGTON V. FOX*.

*Lionel Bently*<sup>†</sup>

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INTRODUCTION

Today, it is taken for granted that trade mark infringement—whether of registered or unregistered marks (so-called “passing off”)—is a matter of strict liability.<sup>1</sup> A person infringes, irrespective of whether

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<sup>†</sup> Herchel Smith Professor of Intellectual Property Law, University of Cambridge. Thanks to Christina Angelopoulos, Chris Beauchamp, Jose Bellido, Bob Brauneis, Jennifer Davis, Rochelle Dreyfuss, Richard Epstein, Alex Ferguson, Dev Gangjee, Tomas Gomez-Arostegui, John Liddicoat, Paul Mitchell, Adam Mossoff and Kara Swanson for commenting on earlier drafts of this Article.

1. L. BENTLY, B. SHERMAN, D. GANGJEE & P. JOHNSON, *INTELLECTUAL PROPERTY LAW* 888–89 (5th ed. 2018) (passing off); *id.* at 1103 (registered marks); JAMES MELLOR, DAVID LLEWELYN, THOMAS MOODY-STUART,

they knew of the plaintiff's business or trade mark, irrespective of whether they copied an existing mark or developed their own, and irrespective of whether they believed the mark used by another trader was descriptive or generic. At the same time, it is widely assumed that modern trade mark law derived from the law of deceit for which *scierter*—specifically an intent to deceive—was a requirement.<sup>2</sup> The aim of this article is to try and gain an understanding of how this perceived shift from intent-based liability to strict liability came about,<sup>3</sup>

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- DAVID KEELING, IONA BERKELEY, ASHTON CHANTRIELLE & WILLIAM DUNCAN, *KERLY'S LAW OF TRADE MARKS AND TRADE NAMES* § 20-029 (16th ed. 2017) (footnote omitted) (describing passing off cases and stating “fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence”); CHRISTOPHER WADLOW, *THE LAW OF PASSING OFF: UNFAIR COMPETITION BY MISREPRESENTATION* §5-51 (5th ed. 2016) (“The defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing-off”); HAROLD G. FOX, *THE CANADIAN LAW OF TRADE MARKS AND UNFAIR COMPETITION* 403 (3d ed. 1972) (“As in the question of infringement of patents, a defendant's intention has no relevance”). For authorities, see *Marengo v. Daily Sketch & Sunday Graphic Ltd*, 65 RPC 242 (HL 1948) 242–43 (granting injunction against cartoonist using name “Kim,” because of likelihood of confusion with another cartoonist named “Kem,” though adoption of sign was innocent); *AG Spalding & Bros. v. AW Gamage Ltd.*, 32 RPC 273 (HL 1915) 283–88 (Lord Parker), 289–90 (Lord Parmoor); *Reed Exec. PLC. v. Reed Bus. Info. Ltd.* [2004] EWCA Civ 159, [2004] RPC 40, [109] (Jacob LJ) (“It is long and well settled that it is no defence to passing off that the defendant has or had no intention to deceive”). For the United States, see Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2108 (2004) (referring to trademark infringement as moving from intent-based to strict liability action); Alfred C. Yen, *Intent and Trademark Infringement*, 57 ARIZ. L. REV. 713, 714 (2015) (“It matters not whether the defendant created confusion intentionally or accidentally”).
2. See, e.g., *Marengo v. Daily Sketch & Sunday Graphic Ltd.*, 65 RPC 242 (HL 1948), 253–54 (Lord du Parc). However, even in the 1830s and 40s, different courts and judges operated different conceptions of precisely what was required to establish deceit. Compare Michael Lobban, *Intentional and Economic Torts*, in 12 THE OXFORD HISTORY OF THE LAWS OF ENGLAND 1040–41 (2010) (tort of deceit), with Michael Lobban, *Misrepresentation*, in 12 THE OXFORD HISTORY OF THE LAWS OF ENGLAND 411–32 (2010) (misrepresentation in contract); see also Michael Lobban, *Contractual Fraud in Law and Equity, c1750–c1850*, 17 OXFORD J. LEGAL STUD. 441, 472–3 (1997).
  3. The definition of strict liability has generated a considerable literature. See, e.g., Stuart P. Green, *Six Senses of Strict Liability: A Plea for Formalism*, in APPRAISING STRICT LIABILITY 1–20 (A.P. Simester ed., 2005); Larry Alexander, *Is There a Case for Strict Liability?*, 12 CRIM. L. & PHIL. 531, 531–32 (2018) (distinguishing between culpable wrongs and non-culpable ones, including negligence based liability); Jules L. Coleman, *Moral Theories of Torts: Their Scope and Limits: Part I*, 1 L. & Phil. 371, 376–78 (1982) (distinguishing senses of strict liability); John

and, more generally, the changing significance of *scierter*, in particular intention to deceive, in nineteenth-century trade mark law in England and Wales.

Hitherto, the story has been told largely in terms of a simple, evolutionary logic. Trade mark protection, it is said, was first recognised at common law, and the common law courts required a plaintiff to prove an intent to deceive. Later, probably as late as the early nineteenth century, the courts of equity gave assistance by way of an injunction. As the chief forum for litigating trade mark infringement shifted from law to equity, the latter abandoned the requirement of an intent to deceive, following a key decision of the Lord Chancellor in *Millington v. Fox* in 1838.<sup>4</sup> Thereafter, proceedings for trade mark infringement were in essence equitable.<sup>5</sup> It is true that by the end of the

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C. P. Goldberg & Benjamin C. Zipursky, *The Strict Liability in Fault and the Fault in Strict Liability*, 85 *FORDHAM L. REV.* 743 (2016) (arguing that many scholars mischaracterize strict liability in distinguishing it from fault-based liability). On a different standard which might be applied in patent cases, and the concept of strict liability, see Roger D. Blair & Thomas F. Cotter, *Strict Liability and Its Alternatives in Patent Law*, 17 *BERKELEY TECH. L.J.* 799, 807–08 (2002). For a careful analysis of the concepts of strict liability and fault-based liability in copyright see Patrick R. Goold, *Is Copyright Infringement a Strict Liability Tort?*, 30 *BERKELEY TECH. L.J.* 305, 312–19 (2015).

4. *Millington v. Fox*, 3 My. & Cr. 338 (Ch. 1838). For classic accounts that assume *Millington* was a turning point, see D.M. KERLY, *THE LAW OF TRADE-MARKS, TRADE-NAME, AND MERCHANDISE MARKS* 2–5 (1st ed. 1894); LEWIS BOYD SEBASTIAN, *THE LAW OF TRADE MARKS AND THEIR REGISTRATION AND MATTERS CONNECTED THEREWITH* 7–8, 12 (Lewis Boyd Sebastian, Harry Baird Hemming & S. Raymond Sebastian eds., 5th ed. 1911) (arguing that the need “to prove knowledge . . . and intentional deception” has not been required “to obtain an injunction in Chancery . . . since *Millington v. Fox* [], in 1833 [sic]”); Grover C. Grismore, *Fraudulent Intent in Trade Mark Cases*, 27 *MICH. L. REV.* 857, 860 (1929) (explaining that the *Millington* decision “worked a fundamental change in the theory of trade mark protection”); FOX, *supra* note 1, at 1 (3d ed. 1972); WADLOW, *supra* note 1, § 5-50, at 287 (footnote omitted) (“From 1838 equity . . . would . . . grant an injunction . . . irrespective of the defendant’s initial state of mind.”); KENNETH R. SWAN, *PATENTS, DESIGNS, AND TRADE MARKS* 279–80 (1908) (“The case of *Millington v. Fox*, decided in 1834 [sic], definitely established the principle that a trader has a good right of action against any person who wrongfully assumes his trade mark, even in the absence of proof of fraudulent intent.”).
5. J.D. HEYDON, M.J. LEEMING & P.G. TURNER, MEAGHER, GUMMOW AND LEHANE’S EQUITY: DOCTRINES & REMEDIES § 43-005 (5th ed. 2015) (“What is generally regarded as the modern tort of passing off is in truth the product of equity as much as if not more than of law.”).

century,<sup>6</sup> *scierter* was not required in most cases (and certainly not for registered marks, after the introduction of registration in 1876),<sup>7</sup> but a closer look suggests that the conventional account is much too simplistic and the development of the law in the period from 1830 to 1875 was much messier, contested, and *ad hoc*.

My goal in revisiting this history is not to suggest that adoption of strict liability was a false turn.<sup>8</sup> Rather, the goal is to understand how the modern law came to be as it is. Indeed, this may have implications for a number of current legal questions, the answers to which are very muddled. Is there a distinction between primary and accessory liability in the law of trade marks, the latter requiring a showing of *scierter*?<sup>9</sup> Is there a defence of using one's own name, and, if so, what is its scope?<sup>10</sup>

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6. Kerly called it “well-settled law.” KERLY, *supra* note 4, at 316; D.M. KERLY, THE LAW OF TRADE-MARKS, TRADE-NAME, AND MERCHANDISE MARKS 375 (D.M. Kerly & F.G. Underhay eds., 2nd ed. 1901); D.M. KERLY, THE LAW OF TRADE-MARKS AND TRADE-NAME 402 (D.M. Kerly & F.G. Underhay eds., 3rd ed. 1908). Even today, the treatise uses the same language. MELLOR ET AL., *supra* note 1, § 20-029.
  7. See Trade Mark Registration Act 1875, 38 & 39 Vict. c. 91, § 5 (U.K.). For background, see generally Lionel Bently, *The Making of Modern Trade Mark Law: The Construction of the Legal Concept of Trade Mark (1860–1880)*, in TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE 1–41 (Lionel Bently, Jennifer Davis & Jane C. Ginsburg eds., 2008).
  8. Cf. Dane S. Ciolino & Erin A. Donelon, *Questioning Strict Liability in Copyright*, 54 RUTGERS L. REV. 351 (2002) (criticizing strict liability in copyright); Jacqueline D. Lipton, *Cyberspace, Exceptionalism, and Innocent Copyright Infringement*, 13 VAND. J. ENT. & TECH. L. 767, 775–84 (2011) (arguing the same); Roger D. Blair & Thomas F. Cotter, *Strict Liability and Its Alternatives in Patent Law*, 17 BERKELEY TECH. L.J. 799 (2002) (approving strict liability for patents for the most part, though with a *scierter*-based standard for liability in damages); Patrick R. Goad, *Patent Accidents: Questioning Strict Liability in Patent Law*, 95 IND. L.J. 1075, 1079 (2020) (arguing that “a negligence rule is preferable because it creates incentives for *both* technology users and patentees to adopt reasonable, cost-justified care to avoid accidents”).
  9. See Lionel Bently, *The Doctrine of Instruments of Fraud in Historical Perspective*, in THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW 468, 468–81 (Irene Calboli & Jane C. Ginsburg eds., 2020).
  10. See Gilbert Kodilinye, *Passing Off and the Use of Personal Names*, 26 N. IR. LEGAL Q. 177 (1975) (arguing for such a defence); Christopher Wadlow, *Is There an Own-Name Defence in the Common Law Tort of Passing-off? The Implications of Asprey, Reed and Newman v. Adlem*, in TRADE MARK LAW AND SHARING NAMES 129 (Ilanah Simon Fhima ed., 2009); Christopher Wadlow, *The Own-Name Defence in Passing-off: Six Pennyworth of Thoughts from the Other Side*, 1 QUEEN MARY J. INTELL. PROP. 130 (2011) (seeking to explain divergent approaches to answering

Is a successful claimant in a trade mark action entitled either to damages or an account of profits?<sup>11</sup> Contemporary lawyers who pick authorities from the past, without engaging with the broader shifts in trade mark thinking, are likely to misunderstand these authorities or be misled by them. This article aims to unpick the history and thereby to offer some guidance.

The article begins with a brief account of *Millington v. Fox* itself. I suggest that while it has been positioned as a landmark in a seamless transition from intent-based liability to strict liability (and from law to equity), the court likely thought it was carrying out a mere clarification of the standard applicable both at common law and in equity. However, in the years following *Millington*, the courts of common law did, indeed, make clear that *scier* was required to establish trade mark infringement, and chancery courts also moved in that direction. In many respects, in the 1840s, *Millington* became not a landmark so much as a loose-end. Section II describes how, at the end of the 1850s, a number of judges embraced *Millington* and strict liability (in the sense that innocence or ignorance at the time of adopting the mark is no bar to injunctive relief). Section III offers some reasons as to why this occurred.

## I. MILLINGTON V. FOX

### A. *Millington*

*Millington v. Fox* concerned the use of words “CROWLEY” and “MILLINGTON,” as well as some associated marks, on steel.<sup>12</sup> The plaintiffs, Thomas Isaac Millington and Crowley Millington, were successors to the partnership “Crowley Millington & Co,” making steel near Newcastle in the North East of England,<sup>13</sup> much of which was

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the question). Such a defence exists in relation to use of registered trade marks. Trade Marks Act 1994, c. 26 § 11(2)(a).

11. See *Marengo v. Daily Sketch & Sunday Graphic Ltd.*, 65 RPC 242 (HL 1948), 247 (expressing no view as to the question raised in argument regarding whether a defendant can be held liable in damages for an innocent “passing off” due to ignorance of material facts, on the basis that equity has established a rule that every “passing off” is an invasion of property); *Gillette UK v. Edenwest*, 111 RPC 279, 293 (Ch. 1994) (Blackburne J) (“[D]ishonesty on the defendant’s part is not necessary before a plaintiff can recover damages . . . for passing off.”).
12. *Millington v. Fox*, 3 My. & Cr. 338, 338–40 (Ch. 1838).
13. *Id.* at 338–39, 351. For an extended history, see M.W. FLINN, *MEN OF IRON: THE CROWLEYS IN THE EARLY IRON INDUSTRY* (1962). The firm was founded by Ambrose Crowley III (1658–1713), and its products included axes, chisels, files, forks, tongs and anchors, for which it developed a stellar reputation. *Id.* at 55. According to Flinn, Swalwell was probably

exported to America. The defendants, James and Samuel Fox, were partners in a relatively newly established firm called “Fox Bros” in Sheffield.<sup>14</sup> The plaintiff had been alerted to the defendant’s sale of steel stamped with the marks and, on 7 August 1834, issued a bill in the Court of Chancery seeking discovery, injunctive relief, and an account.<sup>15</sup> The bill alleged that “for fraudulent purposes on steel manufactured by them the said Defendants used and imitated the said marks . . . in order to enable the said steel to be passed off in the market as steel manufactured by your Orators.”<sup>16</sup> A preliminary injunction was granted *ex parte*, and the defendants entered their answer,<sup>17</sup> explaining that

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the largest “industrial unit in the country at this time apart from the naval dockyards.” *Id.* at 54.

From 1782, one of the salaried managers, Isaiah Millington (the grandfather of the claimants) entered the partnership, and a succession of Millingtons managed the business from then until 1863. *Id.* at 88–91. Isaiah died in 1806, and eventually his grandson Crowley Millington ran the business until he died in 1849. FLINN, *supra*, at 91.

While it had been a huge success in the eighteenth century, the business gradually went into decline. Flinn has suggested this resulted from a combination of factors: the replacement of hand-forged nails with machine-made nails; the reduced importance of Swedish and Russian bar iron to steel-making; the absence of Admiralty business after the end of the Napoleonic war; the introduction of rail transport (and reduced advantage of being on the North Sea); and a failure to innovate. *Id.* at 94–95.

Quite how quick the decline was is difficult to say. A more recent study by David Cranstone has contested Flinn’s account and suggests that “Mr. Crowley Millington’s tenure can be seen as an attempted rally, unsuccessful for the manual workshop side of the business but much more successful for steel-making.” David Cranstone, *From Slitting Mill to Alloy Steel: The Development of Swalwell Ironworks*, 33 *INDUS. ARCHAEOLOGY REV.* 40, 55 (2011).

14. The defendants had in 1831 set up in Sheffield as steel manufacturers and merchants under the name Fox Brothers. *Millington v. Fox*, 3 *My. & Cr.* at 342. For the first year, the partners operated a steel-converting furnace making steel which they marked “Fox Brothers.” *Id.* Thereafter they operated merely as merchants and dealers in steel and files, though in that capacity it seems they would commission third parties to make steel. *Id.* Their goods were sold almost entirely in North America, where it was said by the plaintiff to be undercutting the plaintiff’s sales. *Id.* The bill and answer do not even disclose the address of the Fox Brothers’ works.
15. *Millington v. Fox*, C13/1872/1 (bill filed 7 August 1834).
16. *Id.*
17. *Id.* In fact, initially Samuel Fox entered an answer dated 13 December 1834, prompting Millington to amend its bill, which it did on 8 April 1835. Once James Fox had returned from America, Samuel and James entered a joint answer dated 7 July 1835 and a further one, in response to a ruling

they had understood the terms CROWLEY and MILLINGTON to indicate particular types of steel,<sup>18</sup> and that they had never heard of the plaintiffs. While the defendants had agreed to cease using the words (even before the plaintiffs entered their bill), the plaintiffs pursued the matter and there followed a commission to examine witnesses,<sup>19</sup> a process that took up most of 1836, and ultimately a hearing, seeking a perpetual injunction and account.<sup>20</sup>

At the hearing before Lord Cottenham LC, counsel for the defendants argued that it had not been proved that the defendants had made use of the Plaintiffs' marks "knowingly and wilfully."<sup>21</sup> Although the claim to an account was abandoned,<sup>22</sup> Lord Cottenham LC awarded the injunction. He explained:

I see no reason to believe that there has, in this case, been a fraudulent use of the Plaintiffs' marks. It is positively denied by the answer; and there is no evidence to shew that the Defendants were even aware of the existence of the Plaintiffs, as a company manufacturing steel; for although there is no evidence to shew that the terms "*Crowley*," and "*Crowley Millington*," were merely

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to produce correspondence between the two brothers, on 19 November 1835. Samuel Fox's Answer, *Fox*, C13/1862/1 (Dec. 13, 1834).

18. This is explained in a letter from Luke Palfreyman, solicitor, to Crowley Millington, dated 2 August 1834. *Millington*, 3 My. & Cr. at 343–44. More specifically, Samuel Fox's answer stated, "by the term 'Crowley' steel, the Defendant always understood tilted, rolled, or single shear, or sheared steel, made up in a bundle of one hundred weight, and manufactured from a bar of steel; and by the term 'Crowley Millington' steel, shear or sheared steel, made up in bundles of one hundred weight and manufactured from several bars." Samuel Fox's Answer, *Fox*, C13/1862/1, f. 4 (Dec. 13, 1834).
19. TNA: C33/874, f. 541v (May 3, 1836) (determining the period during which the commission could take evidence).
20. *Millington*, 3 My. & Cr. at 350–51.
21. *Id.* at 350–51. Counsel arguing on Defendant's behalf included the Solicitor General, Robert Rolfe (later, Lord Cranworth LC). See G.F. Russell Barker, *Rolfe, Robert Monsey*, in 49 DICTIONARY OF NATIONAL BIOGRAPHY 158–61 (Sidney Lee, ed. 1897). Chancery Bills, like common law declarations, typically alleged fraud. See, e.g., *Knott v. Morgan*, 2 Keen 213 (Ch. 1836) (stating in the bill that the Defendant did certain acts "with the view and design of fraudulently procuring the custom of persons who were in the habit of using the omnibuses of the Plaintiffs").
22. In fact, Wigram, Plaintiff's counsel, abandoned the claim in response to Lord Cottenham LC's prompting, and Lord Cottenham later observed that he had been very sensible to do so. *Id.* at 350–51. Fox had admitted selling 43 cwt of steel to purchasers in Montreal, Lower Canada, for a value of £128 and a profit of £6 10 shillings.



technical terms, yet there is sufficient to shew that they were very generally used, in conversation at least, as descriptive of particular qualities of steel. In short, it does not appear to me that there was any fraudulent intention in the use of the marks. That circumstance, however, does not deprive the Plaintiffs of their right to the exclusive use of those names; and therefore I stated, that the case is so made out as to entitle the Plaintiffs to have the injunction made perpetual.<sup>23</sup>

Lord Cottenham LC thus awarded injunctive relief on the same terms as the interim order, that is to say:

to restrain the Dfts & each of them their & each of their Servants & Agents from stamping and impress<sup>s</sup> or caus<sup>s</sup> to be stamped or impressed on any Bars of Steel or o<sup>r</sup> pieces of Steel the names Crowley Millington or either of them or any other the Names or Marks or any Material part of any of the Marks in the Pets Bill ment<sup>d</sup> to be stamped by the Pets on Steel manufact<sup>d</sup> by the Pets & from manufactur<sup>s</sup> or causing to be manufact<sup>d</sup> & also from sell<sup>s</sup> or contract<sup>s</sup> to sell and Bars of Steel or o<sup>r</sup> pieces of steel stamped with any of the s<sup>d</sup> Names of Marks or any mater<sup>l</sup> part of any of the s<sup>d</sup> Marks or any Name or mark in Imitation of any of the s<sup>d</sup> names or any material part of any of s<sup>d</sup> Marks.<sup>24</sup>

However, the Lord Chancellor declined to order costs in favour of either party.

#### *B. Not a Revolution*

As noted in the introduction, the decision has long been regarded as a key moment in the evolution of trade mark law. This is because, for the first time, the Court of Chancery treated trade mark violations as ones of strict liability, in the sense that injunctive relief would be awarded irrespective of the *scier* of the user at the time the mark was adopted.<sup>25</sup> This case, it is said, introduced a divergence between law and equity. This part suggests that such an account is historically inaccurate, or at least a considerable over-simplification. It argues that, in fact, the position ‘at law’ was unclear and, almost certainly, Lord Cottenham thought that while he might have been clarifying the law, he was not creating a divergence between law and equity.<sup>26</sup> Rather, he

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23. *Id.* at 352.

24. TNA: C33/886, f. 454<sup>r</sup>.

25. *See supra* notes 1–5 and accompanying text.

26. *Cf.* HENRY LUDLOW & HENRY JENKYNs, A TREATISE ON THE LAW OF TRADE-MARKS AND TRADE-NAMES 7–12 (London, 1873) (explaining that trade-mark was somewhat hard to distinguish from misrepresentation which provided equitable remedies).

understood his holding in *Millington* as an incremental development. The radical nature of the decision only became apparent later when common law courts made clear that *scier* was a prerequisite to trade mark infringement.

1. The State of the Case-law

When *Millington v. Fox* was decided, in 1838, there was relatively little reported case-law concerning trade marks. At this point, there were no treatises that focussed on trade mark law and the topic was hardly touched in digests, journals, and other published works.

Most famously (to trade mark historians at least) there were the three reports of a non-trade mark case, *Southern v. How*, which recounted, each in a different way, how Dodderidge J recalled a case (now commonly known as “the *Gloucestershire Clothier’s Case*”) from the time of Elizabeth I in which an action had been brought at common law relating to the unauthorised use of one clothier’s mark by another clothier.<sup>27</sup> In addition, there were at least three reports of other cases at common law: *Singleton v. Bolton*, where the plaintiff had been nonsuited, decided in 1783 but only reported in 1831;<sup>28</sup> and two, in 1824 and 1833, in which a plaintiff had succeeded—*Sykes v. Sykes*<sup>29</sup> and *Blofeld v. Payne*.<sup>30</sup> Although the action at law was by 1838 well-established, there were so few reports because there was no tradition of reporting cases at nisi prius, where most common law cases were concluded.<sup>31</sup>

In addition there were nine reported cases in Chancery: the oldest was *Blanchard v. Hill*, where Lord Hardwicke LC had refused injunctive

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27. *Southern v. How*, Cro. Jac. 468 (K.B. 1618), 471; Poph. 143 (K.B. 1618); 2 Rolle Rep. 28 (K.B. 1619). For discussion on the three reports of *Southern v. How*, see FRANK I. SCHECHTER, THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS 6–10, 123–24 (1925). For a discussion of the Gloucestershire Clothier’s case, *JG v. Samford*, see SIR JOHN BAKER, SOURCES OF ENGLISH LEGAL HISTORY PRIVATE LAW TO 1750, at 673–76 (2d ed. 2010).

28. *Singleton v. Bolton*, 3 Doug. 293 (K.B. 1783). For further discussion of the reporting of this case, see Lionel Bently, *The First Trademark Case at Common Law? The Story of Singleton v. Bolton (1783)*, 47 U.C. Davis L. Rev. 969, 986–88 (2014).

29. *Sykes v. Sykes*, 3 B. & C. 541, 541–43 (K.B. 1824).

30. *Blofeld v. Payne*, 4 B. & Ad. 410, 410–12 (K.B. 1833).

31. The first nisi prius reports were from Thomas Peake (1790–95) and Isaac Espinasse (1793–1810). See SIR JOHN BAKER, AN INTRODUCTION TO ENGLISH LEGAL HISTORY 439 n.72 (5th ed. 2019).

relief in relation to an image mark for playing cards.<sup>32</sup> In a second, *Canham v. Jones*, the defendant's demurrer succeeded;<sup>33</sup> while in *Motley v. Downman*, the Lord Chancellor dissolved an injunction that had been initially awarded, sending the parties to try the action at law.<sup>34</sup> In the other six reported cases the plaintiffs had been granted preliminary injunctions. These were *Hogg v. Irby*;<sup>35</sup> *Day v. Billing*;<sup>36</sup> *Henry v. Price*;<sup>37</sup> *Gout v. Aleplogphu*;<sup>38</sup> *Ransome v. Bentall*;<sup>39</sup> and *Knott v. Morgan*.<sup>40</sup> By 1838, there was no report of a case in which a trade mark owner had been awarded a perpetual injunction; though it is not surprising that interim injunctive was sufficient to conclude proceedings in most cases.

Some of these reports hinted at a requirement that to succeed a plaintiff must demonstrate fraud. For example, Popham's account of Dodderidge J's memory of the *Gloucestershire Clothiers Case* (according to which the trader, rather than the deceived purchaser succeeded), the judge described the defendant as having used the mark on cloth "on purpose to deceive him."<sup>41</sup> However, the report does not make clear whether the judge was recalling the facts in front of the court, or specifying pre-requisites that the Elizabethan Court of Common Pleas had been establishing. In *Singleton v. Bolton*, in 1783, Lord Mansfield refused relief to the purveyor of "DR JOHNSON'S YELLOW

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32. 2 Atk. 484, 484–87 (Ch. 1742) (Hardwicke LC) (the "Great Mogul" playing card).
  33. 2 Ves. & B. 218 (Ch. 1813) (Sir Thomas Plumer VC) (injunction refused in case where defendant had sold "Velno's Vegetable Syrup," the court inferring that this was an indication as to the quality of the defendant's goods, their origin with the defendant rather than the plaintiff being clear).
  34. 3 My. & Cr. 1, 14–17 (Ch. 1837) (Cottenham LC) (where the plaintiff had marked its tin plates "M.C." before relocating its manufactory, the new occupier of the plaintiff's old premises claimed to be entitled to stamp "M.C." on its tin plates).
  35. 8 Ves. Jun. 215, 215–28 (Ch. 1803) (Eldon LC) (granting an injunction against presenting magazine as continuation of an existing title).
  36. 1 C.C. Cooper's Rep. 489, Day v Binning (sic) 1 Leg. Obs. 205 (Ch. 1831) (Shadwell VC) (injunction awarded to makers of "Day and Martin" boot polish against defendant, Edward Billing of Bermondsey, who labelled his boot polish "equal to Day and Martin", with "equal to" in smaller lettering "so as not to be clearly perceptible").
  37. 1 Leg. Obs. 364 (Ch. 1831) (Shadwell VC) ("Henry's Calcined Magnesia").
  38. 5 Leg. Obs. 495 (Ch. 1833), 1 Chit. Gen. Prac. 721, 6 Beav. 69, at fn. (watches).
  39. 3 LJR 161 (Ch. 1834) (Shadwell VC) ("HH6" for ploughs).
  40. 2 Keen 213, 219 (Ch. 1836) (Langdale MR) (name and appearance of buses).
  41. *Southern v. How*, Poph 143, 143–44 (K.B. 1618).

OINTMENT,” but acknowledged that “if the defendant had sold a medicine of his own under the plaintiff’s name or mark, that would be a fraud for which an action would lie.”<sup>42</sup> Again, it is not clear whether the reference to fraud is a conclusion or implies that intent is a prerequisite to the action. In *Sykes v. Sykes*, in 1824, where the plaintiff succeeded at common law in preventing the sale of shotbelts and flasks marked “SYKES PATENT,” the defendant was reported to have marked its shotbelts “in order to denote they were the genuine manufacture of the plaintiff.”<sup>43</sup> At least one digest mentioned *scienter*, but in terms of intent to injure rather than intent to deceive, thus making the picture even more confused.<sup>44</sup>

Significantly, one report of the most recently decided common law case, *Blofeld v. Payne*, suggested that common law protection related to an exclusive right, thus marginalising the importance of intention.<sup>45</sup> There the defendant had wrapped his goods in the plaintiff’s packaging, and the jury, though finding the defendant’s goods not to be inferior, held the defendant liable (albeit awarding only a farthing in damages). When the defendant moved to enter a non-suit, the Court of King’s Bench affirmed the verdict. According to one report, a number of judges implied that there was damage because Blofeld had some sort of “right.”<sup>46</sup> Littledale J was reported to have stated that “[t]he act of the defendants was a fraud against the plaintiff; and if it occasioned him no specific damage, it was still, to a certain extent, an injury to his right.”<sup>47</sup> The same reporter quoted Patteson J as having stated that

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42. Singleton v. Bolton, 3 Doug. 293, 293 (K.B. 1783).
43. Sykes v. Sykes, 3 B. & C. 541, 541–43 (K.B. 1824). For an alternate report by James Dowling and Archer Ryland, see Sykes v. Sykes, 5 Dowl. & Ry. 292 (K.B. 1824).
44. GILES JACOB, A NEW LAW DICTIONARY (8th ed. London, 1762) (citing 2 Cro. 471) (“And if one Man shall use the *Mark* of another, to the Intent to do him Damage, Action upon the Case lieth.”). See also THOMAS POTTS, A COMPENDIOUS LAW DICTIONARY 444 (London, 1803) (citing 2 Cro. 471) (“Mark of goods, is used to ascertain their property or quality, [etc.] and if one man shall use the *mark* of another, with intent to do him damage, upon injury proved, an action on the case will lie.”) (emphasis added). Some commentaries do not mention *scienter*. See, e.g., 1 JOHN MALLORY, MODERN ENTRIES IN ENGLISH 418 (Dublin, 1791) (citing 2 Rolle Rep. 28) (an action “lies against a tradesman for putting another’s mark to his own commodities.”).
45. Blofeld v. Payne, 4 B. & Ad. 410 (K.B. 1833).
46. *Id.* at 411–12.
47. *Id.* at 411 (Littledale J). But see Blofeld v. Payne, 1 N. & M. 353, 354 (K.B. 1833) (reporting Mr. Justice Littledale as stating “by the fraudulent act of the defendant the plaintiff may possibly have been prevented from selling so many of his hones as he otherwise might have sold”).

“[t]he defendants used the plaintiff’s envelope, and pretended it was their own: they had no right to do that, and the plaintiff was entitled to recover some damages in consequence.”<sup>48</sup> Although these statements are replete with ambiguity as to the requirements treating trade mark infringement as violation of a right could have been read as making *scierter* irrelevant.

One interpretation of *Blofeld v Payne* was that the common law courts were rejecting a requirement of intention. If so, this might have seemed to contemporaries to be consistent with ongoing developments in the law of defamation in this period. As explained by legal historian Paul Mitchell,<sup>49</sup> while at the start of the Nineteenth century it was necessary for a plaintiff in defamation proceedings to establish “malice,”<sup>50</sup> in 1824 this was diluted into a requirement of “malice in law,” that is, “a wrongful act, done intentionally, without just cause or excuse;”<sup>51</sup> and within a decade the courts had further explained that the defendant’s intention could be established by means of the presumption that “every man must be presumed to intend the natural and ordinary consequences of his own act.”<sup>52</sup> The effect of this shift was

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48. *Blofeld v. Payne*, 4 B. & Ad. at 412 (Patteson J).

49. For a historical analysis of defamation law, see PAUL MITCHELL, *THE MAKING OF THE MODERN LAW OF DEFAMATION* (2005) [hereinafter MITCHELL, *MODERN LAW OF DEFAMATION*]. For more on the analytical flaws underlying modern, strict-liability defamation law, see Paul Mitchell, *Malice in Defamation*, 114 L.Q. REV. 639 (1998).

50. MITCHELL, *MODERN LAW OF DEFAMATION*, *supra* note 49, at 101–08. Mitchell says that the orthodox position before 1824 was that presented by Judge Park at nisi prius in *Bromage v. Prosser*:

To support an action for words, malice is essential; but malice may be presumed by the jury, either from their being false, from the nature of the words themselves, from the manner of the speaking of them, or from other evidence; but then the absence of malice may be shown on the other side: and if it were not competent to the jury to consider the question of malice or no malice, and for the defendant to show that he was not actuated by any malice, the communications of society must be at an end.

*Id.* at 102 (quoting *Bromage v. Prosser*, 1 Car. & P. 475, 476 (K.B. 1824)).

51. *Bromage v. Prosser*, 4 B & C 247, 255 (K.B. 1825) (Bayley J). Sir John Bayley, who sat in Kings Bench from 1808–1830, was the Judge at nisi prius in the case of *Sykes v. Sykes*, 3 B. & C. 541 (K.B. 1824).

52. *Haire v. Wilson*, 9 B & C 643, 645 (K.B. 1829) (Lord Tenterden CJ); *see also Fisher v. Clement*, 10 B & C 472, 475 (K.B. 1830) (Lord Tenterden CJ). According to Littledale J in *Haire v. Wilson*, “[i]f the tendency of the publication was injurious to the plaintiff, then the law will presume that the defendant, by publishing it, intended to produce that injury which it was calculated to effect.” 9 B & C at 645.

that intention could be presumed from the defamatory nature of the expression itself—virtually eliminating the *scier* element, unless the defendant raised a defence.<sup>53</sup>

In 1838, when Lord Cottenham LC came to decide *Millington v. Fox* the authorities suggesting a *scier* requirement at law were thus far from compelling.<sup>54</sup> Indeed, writing in 1839, having reviewed the reported common law cases, one commentator summed up the position as follows:

From these authorities it may be considered as clearly established, that the exclusive enjoyment of a particular sign, mark or label, is the subject of a legal right, and that an action at law may be brought for an invasion of the right, even though no special damage have been sustained thereby.<sup>55</sup>

While it was true that some of the Chancery cases, such as *Knott v. Morgan*, had operated under the assumption that common law required a showing of *scier*, that assumption was not obviously well-founded.<sup>56</sup>

## 2. The Nature of the Action and the Role of the Declaration

Whatever the *reports* of the cases at common law said, one might have thought a requirement of *scier* was self-evident for at least two other reasons: either because (i) the action at common law was said to derive from the action for deceit, where such *scier* was required; and

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53. The defendant's intention was to be inferred "from the libel itself." *Fisher*, 10 B & C at 476 (Bayley J). Accordingly, Lord Tenterden CJ made the presumption appear to be irrebuttable when he observed that "a person who publishes matter injurious to the character of another must be considered, in point of law, to have intended the consequences resulting from that act." *Id.* at 475.

54. LUDLOW & JENKINS, *supra* note 26, at 10–12 ("In each of these four cases [*Singleton*, *Skyes*, *Morison*, and *Blofeld*] expressions occur indicating that some of the judges thought the action to be founded upon the defendant's fraud. . . . [I]n none of them was there any necessity for strict accuracy of expression. . . . [I]n several of the cases successful fraud upon any one does not appear to have been proved."). The third case referenced, *Morison v. Salmon*, 2 Man. & Gr. 385 (C.P., *in banco* 1841), was decided on January 14, 1841, about three years after *Millington v. Fox*, 3 My. & Cr. 338 (Ch. 1838).

55. *Piracy of Marks or Signs of Merchants and Traders*, 22 L. MAG. Q. REV. JURIS. 148, 148–50 (1839) (discussing the account of the Gloucestershire Clothier's case in the report of *Southern v. How*, Poph 143 (K.B. 1618); *Sykes v. Sykes*, 3 B. & C. 541 (K.B. 1824); and *Blofeld v. Payne*, 4 B. & Ad. 410 (K.B. 1833)).

56. *See Knott v. Morgan*, 2 Keen 213, 217–18 (Ch. 1836).

(ii) the declaration—the document in which a plaintiff described the wrongful act for which he sought recompense—ritually referred to *scienter*. However, as of 1838, there was no settled view as to the character of the common law action for Infringing traders' marks; and the declaration was a poor guide to the substantive legal requirements.

By the time of *Millington*, the character of the action for trade mark infringement had not been seriously addressed in any of the cases, and the commentaries were far from unanimous. For the most part, the question of categorisation fell to the many abridgments of the law, and the task had been to find a place for the *Gloucestershire Clothier's Case* within the framework of actions. There was no question that this was an action on the case, but this was a very broad field, encompassing much of what we would now regard as “tort law.” Some authors placed the case under the category of deceit. Most notably this was the classification in Sir John Comyns's digest of 1762.<sup>57</sup> Under the heading “Action upon the Case for a Deceit” Comyns provided a sub-category, “Or other falsity,” where he stated, such action would lie “if a Clothier sell bad cloths, upon which he put the mark of another, who made good cloths.”<sup>58</sup> In contrast, other treatises placed the *Gloucestershire Clothier's Case* under other rubrics: for example, merely as a miscellaneous “Actions on the case,”<sup>59</sup> or, in one instance, under the heading “Actions on the Case for Injuries to a Man's Person, Property, Right, or Privilege.”<sup>60</sup>

In interpreting these classifications, it is important to recall the divergences in the accounts of the *Gloucestershire Clothier's Case* provided by the different reports of *Southern v. How*. Comyns cites the description of the *Gloucestershire Clothier's Case* in Sir George Croke's

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57. SIR JOHN COMYNS, A DIGEST OF THE LAWS OF ENGLAND 179 (1762). The same text is contained in the fifth edition. 1 SIR JOHN COMYNS, A DIGEST OF THE LAWS OF ENGLAND 351 (Anthony Hammond ed., 5th ed. 1822). See also JOHN LILLY, THE PRACTICAL REGISTER: OR, A GENERAL ABRIDGMENT OF THE LAW, AS IT IS NOW PRACTISED IN THE SEVERAL COURTS OF CHANCERY, KING'S BENCH, COMMON PLEAS AND EXCHEQUER 464 (1719) (citing *Southern v. How*, Cro. Jac. 468, 471 (K.B. 1618)) (categorizing the case as deceit, but treating it as availing the purchaser not the trade mark owner).

58. COMYNS (1762), *supra* note 57, at 179 (citing *Southern v. How*, Cro. Jac. 468, 471 (K.B. 1618)).

59. 1 T. CUNNINGHAM, A NEW AND COMPLETE LAW DICTIONARY, OR, GENERAL ABRIDGMENT OF THE LAW (1764); see also 1 KNIGHTLEY D'ANVERS, A GENERAL ABRIDGMENT OF THE COMMON LAW 202 (1705) (referring to all three reports of *Southern v. How* under “Actions Upon the Case . . . (N) For what (a) Things it Lies”).

60. 1 MATTHEW BACON & HENRY GWILLIM, A NEW ABRIDGMENT OF THE LAW 82 (6th ed. 1807).

report, where it was stated the action would lie in favour of the deceived purchaser rather than the clothier with whose mark the reputation was associated.<sup>61</sup> It is a mistake therefore to think of Comyns as classifying trade mark infringement at all, and entirely unsurprising that he treats what was established the *Gloucestershire Clothier's Case* as deceit. The report of *Southern v. How* that described the *Gloucestershire Clothier's Case* as establishing a right of the trader to bring proceedings is that designated "Popham."<sup>62</sup> The digests that refer to this report do not designate the action for misuse of another's trade mark as one for deceit. As of 1838, then, the view that the action for trade mark infringement at common law was inextricably tethered to the action for deceit—a view that would come to prevail amongst judges in the middle of the century—had yet to be established.

With respect to the declaration, it is true both that the form of declaration was a crucial facet of procedure at common law<sup>63</sup> and that these mentioned *scienter*. For example, the declaration in *Sykes v. Sykes* had alleged:

[D]efendants, knowing the premises, and contriving, &c., did wrongfully, knowing, and fraudulently, against the will and without the licence and consent of the plaintiff, make a great quantity of shot-belts and powder-flasks, and cause them to be marked with the words "Sykes Patent," in imitation of the said

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61. COMYNS (1762), *supra* note 57, at 179; *Southern v. How*, Cro. Jac. 468, 471 (K.B. 1618).

62. *Southern v. How*, Poph. 143 (K.B. 1618). The preface to the volume explains that the later cases from the times of James and Charles were not Sir John Popham's reports but were "taken by judicious Pens." SIR JOHN POPHAM, REPORTS AND CASES A3 (1656).

63. The Preface to the sixth edition of Joseph Chitty's book on pleading, published in 1836, for example, explained:

[I]t is obvious that a very accurate knowledge of these subjects is essential not only to the *professed Special Pleader and Barrister*, but also to every *Attorney*, who is responsible to his client for the sufficiency of the proceedings, and who . . . by a timely suggestion might prevent a disastrous defeat, which would be as injurious to his own as his client's interest, and discreditable to the administration of justice.

1 JOSEPH CHITTY, TREATISE ON THE PARTIES TO ACTIONS, AND ON PLEADING A2 (6th ed. 1836). As we will see, some matters that were specified in a declaration had to be proved, but other matters were understood as surplusage, or defining parameters, for example, in relation to remedies. As an example, in *Rodgers v. Nowill*, 5 CB 109, 111 (C.P. 1847), the declaration alleged that Nowill manufactured "100,000 pen-knives and 100,000 pocket-knives, in imitation of those prepared and manufactured and made by the plaintiffs," but it was understood by all that these figures were notional.



mark so made by the plaintiff in that behalf as aforesaid, and in order to denote that the said shot-belts and powder-flasks, &c. were of the manufacture of the plaintiff; and did knowingly, wrongfully, and deceitfully sell, for their own lucre and gain, the said articles so made and marked as aforesaid, *as and for* shot-belts and powder-flasks, &c. of the manufacture of the plaintiff . . . .<sup>64</sup>

Nevertheless, these pleadings were not substantially different from those used in many actions on the case, and indeed in both patent and copyright cases.<sup>65</sup> In relation to the latter, it was relatively clear that there would be liability irrespective of *scierter*.<sup>66</sup> Thus, it was possible that these words were also unnecessary for a trade mark declaration and thus did not need to be established on the facts.<sup>67</sup> As Chitty

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64. Sykes v. Sykes, 3 B. & C. 541, 541 (K.B. 1824).
65. For pleadings in copyright and patent cases, see W. BOHUN, DECLARATIONS AND PLEADINGS 232 (1733) (charging in the copyright pleading that the defendant “being not ignorant of the premises, but contriving and fraudulently intending”); 1 JOHN LILLY, A COLLECTION OF MODERN ENTRIES: OR SELECT PLEADINGS IN THE COURTS OF KING’S BENCH, COMMON PLEAS AND EXCHEQUER 64 (6th ed. 1792) (pleading for invasion of printing patent charges that the defendant, “not ignorant of the premises but contriving and intending to deceive and defraud them . . . of the benefit of the privilege aforesaid”); 8 JOHN WENTWORTH, A COMPLETE SYSTEM OF PLEADING 431 (1798) (quoting Liardet v. Johnson, (K.B. 1780) (charging in invention patent that defendant “well knowing the premises, but contriving and fraudulently and maliciously intending to hurt, injure, and prejudice the said plaintiff”); 2 JOSEPH CHITTY, TREATISE ON PLEADING 579 (Henry Greening, ed., 7th ed. 1844) (charging defendant in invention patent case with “well knowing the premises, but contriving and wrongfully and injuriously intending to injure the plaintiff”); WENTWORTH, *supra*, at 434 (including entry concerning copyright in engravings that charged defendant with “well knowing the premises, but contriving and wrongfully and injuriously intending to injure and prejudice the said [plaintiff]”).
66. In relation to literary copyright under the Statute of Anne, Lord Ellenborough CJ stated in 1807 that “[t]he intention to pirate is not necessary in an action of this sort; it is enough that the publication complained of is in substance a copy, whereby a work vested in another is prejudiced.” Roworth v. Wilkes, 1 Camp. 94, 98 (K.B. 1807). For patents, see *Stead v. Anderson*, 4 C. B. 806, 834 (C.P. 1847) (Wilde, CJ) (“[T]he action is maintainable in respect of what the defendant does, not of what he intends.”). For later confirmation that ignorance is no defense to either patent or copyright infringement, see *Reade v. Lacy*, 1 J. & H. 524, 526 (Ch. 1861) (Page Wood, VC).
67. For a parallel argument identifying a number of other actions on the case, as well as for assumpsit, where fraud is mentioned in the declaration but not required to be proved, see *Bailiffs, etc. of Tewkesbury v. Diston*, 6 East, 438, 445–47 (K.B. 1805) (plaintiff’s counsel).

explained, “[i]f . . . a malicious or wrongful intent be unnecessarily stated, it need not be proved; and where there is evidence to prove the allegation, it may be advisable, in aggravation of damages, to state the defendant’s malicious intent.”<sup>68</sup> Chitty cited in support a case where the declaration alleged deceit, but the plaintiff succeeded on the basis of a breach of a contractual warranty for which a showing of malice was not required.<sup>69</sup> If the supposition is right that in 1838 at common law it was not necessary for a plaintiff to demonstrate a defendant’s fraudulent intent, the mere fact it was ritually included in the plaintiffs’ declarations would not have been regarded as precluding relief.

### 3. Lord Cottenham’s Understanding of the Law

Cottenham LC’s judgment in *Millington v. Fox* needs to be understood in the light of his decision the previous year in *Motley v. Downman*.<sup>70</sup> In that case, he offered a lengthy exegesis on the jurisdictional basis for Chancery’s intervention in trade mark cases. In doing so, he made clear that Chancery was acting in support of the common law: “The Court, when it interferes in cases of this sort, is exercising a jurisdiction over legal rights . . . the Court is only acting in aid of, and is only ancillary to, the legal right.”<sup>71</sup> Lord Cottenham did nothing to suggest there was an independent equitable jurisdiction in relation to trade marks.

Given this, we cannot read *Millington* as establishing a different test, or indeed basis, for equitable intervention. When Lord Cottenham LC declares that, even absent fraud, “the Plaintiffs [have a] right to the exclusive use of those names,” we should understand that this is how he understood the position at common law.<sup>72</sup> This conclusion is reinforced by the fact that the case was fully argued, by impressive counsel,<sup>73</sup> over three days with judgment given on Saturday, March 24,

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68. 1 JOSEPH CHITTY, A TREATISE ON PLEADING, AND PARTIES TO ACTIONS 390 (12th ed. 1855) (footnotes omitted).

69. *Williamson*, 2 East, 446 (K.B. 1802) (noting that if the averment of knowledge and intent could be struck out and the plaintiff could succeed, there was no need for it to be proved).

70. 3 My. & Cr. 1, 14 (Ch. 1837).

71. *Id.* at 14.

72. *Millington v. Fox*, 3 My. & Cr. 338, 351–52 (Ch. 1838).

73. *Millington*, 3 My. & Cr. at 350 (identifying Wigram and Russell for Millington, and the Solicitor General, Rolfe, and Stuart for Fox Brothers). Wigram and Stuart would later be Vice-Chancellors. See W. R. Williams, *Wigram, Sir James*, in 61 DICTIONARY OF NATIONAL BIOGRAPHY 198 (Sidney Lee ed., 1900). Rolfe, elevated under the title Lord Cranworth, would be Lord Chancellor. See G.F. Russell Barker, *supra* note 21, at 158–61.

1838.<sup>74</sup> According to a recent account of his judicial approach, Lord Cottenham “vigorously researched and analyzed precedents which could have any bearing on [a] case.”<sup>75</sup> Moreover, the Lord Chancellor gave off no hint that he was conscious that he might be doing anything remotely unexpected.<sup>76</sup> Indeed, it is telling in that regard that he said the only reason he reserved judgment was to consider the question of costs.<sup>77</sup> It is also worth noting that the parties to the litigation did not seem to regard the conclusion as surprising. In three previous proceedings brought by Millington concerning the very same marks, including one against a very sizeable Sheffield firm,<sup>78</sup> the proceedings had been settled, the defendants agreeing not to use the signs that Millington had claimed, to pay Millington’s costs, and to compensate it for its losses.<sup>79</sup> Indeed, the Fox Bros. had offered to cease using the

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74. The arguments were given on March 16, 17, and 23. *Millington*, 3 My. & Cr. at 338, 351.
75. Fiona R. Burns, *Lord Cottenham and the Court of Chancery*, 24 J. LEGAL HIST. 187, 200 (2003).
76. It might be said that this was precisely what one would expect of a judge who was doing something radical. For example, Lord Cottenham prefaced another of his time-honoured decisions by denying its significance. *See Prince Albert v. Strange*, 13 Jur. (OS) 109, 111 (Ch. 1850) (“The importance which has been attached to this case arises entirely from the exalted situation of the plaintiff, and cannot be referred to any difficulty in the case itself. The precise facts may not have occurred before; but those facts clearly fall within the established principles, and the application of them is not attended with any difficulty.”).
77. *Millington*, 3 My. & Cr. at 351–52.
78. William Greaves & Sons had been established in the late eighteenth century, but by the 1830s was thriving, having built the “Sheaf Works” in 1823 at a cost of £30,000 so as to integrate on a single site all the processes necessary to transform iron imported from Sweden into finished goods. ALFRED GATTY, *SHEFFIELD PAST AND PRESENT* 212–13 (1873) (identifying the necessary processes as “converting, casting, forging, tilling, rolling, grinding, and completing”). Greaves was regarded as the largest manufacturer of edge-tools, boasting a trade worth £80,000 per annum with the United States. *See Sheaf Works*, *SHEFFIELD INDEP.*, May 20, 1869 (on success); *Sheffield’s Growth: Interesting Links with the Past*, *SHEFFIELD DAILY TEL.*, Apr. 29, 1913 (identifying Greaves as the largest manufacturer of edge tools). The firm dissolved in 1850, but its name was used by its successors, Thomas Turton and Frederick T Mappin. *See SHEFFIELD DAILY TEL.*, Mar. 9, 1906 (reporting turnover with United States in 1850 when Greaves & Son was sold). For images, see K.C. BARRACLOUGH, *SHEFFIELD STEEL* (1976) 21, 62–63 (providing images of Sheaf Works in 1850, 1855, and 1858).
79. *See Millington v. Greaves*, TNA: C33/854 f. 2670<sup>v</sup> (Aug. 13, 1833) (interim injunction); Answer, *Greaves*, TNA: C33/854 (Nov. 20, 1833); *Millington v. Greaves*, TNA: C33/863 f. 1190 (July 17, 1834) (perpetual injunction); *Millington v. Smith*, TNA: C13/1861/23 (Feb. 19, 1834) (bill); *Millington*

disputed names CROWLEY and MILLINGTON even before Millington commenced proceedings, so the award of an injunction would likely have been anticipated.<sup>80</sup> Finally, we might note that the immediate reaction from the newspapers and legal press to the decision does not suggest that “the profession was taken by surprise.”<sup>81</sup>

Seen in this context, *Millington* was far from radical when it was decided. However, it soon came to be seen as such because, four years later, the common law courts established—at least to most peoples’ satisfaction—that *scierter* needed to be alleged and proved to sustain

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v. Smith, TNA: C33/861 f. 606<sup>v</sup> (Feb. 25, 1834) (interim injunction); Smith’s Answer, *Smith*, TNA C33/861 (June 20, 1834); *Smith*, TNA: C33/863 f. 1223<sup>r</sup> (July 30, 1834) (perpetual injunction); *Steel. Crowley and Crowley Millington Steel*, SHEFFIELD INDEP., Nov. 8, 1834 (also Nov. 15, 1834) (setting out terms of agreement, that both Greaves and Smith pay compensation, Millington’s costs and to permit Crowley Millington & Co’s advertising of the outcome of the litigation). A third complaint against William Oxley was settled on terms that Oxley pay compensation and advertise the outcome. SHEFFIELD INDEP., Nov. 8, 1834.

80. See *Millington*, 3 My. & Cr. at 338 (“[T]he Defendants stated . . . that they did not intend to use them again . . .”).

81. In fact, Lord Cottenham, LC, reiterated the position three years later, on February 5, 1841 in *Seeley v. Fisher*, in which the original publisher of a work now in the public domain objected to the defendant publishing a new edition of the work. 11 Sim. 581, 581–83 (Ch. 1841). Although best known through the report in 11 Sim. 581, the fuller report in the *Legal Observer* states that Lord Cottenham, LC, explained:

The question is not absolutely a question of fraud, because a party may represent that he is publishing or selling what truly belongs to another without intending fraud; but if he does so, the other party has a right to the protection of this court . . . [I]t must be made to appear to be an intentional misrepresentation, and calculated to lead others to believe that when they are buying that which the defendant offers for sale they are buying that which is, in fact, the exclusive property of the plaintiffs. This case . . . comes within the principle of those cases which have been decided upon tradesmen using the mark of the party complaining. . . . [I]t is a representation that he is holding out to the world that he is selling that which the other party alone has the right to sell, and has the right to be protected against the representation that others are selling those goods to persons, who buy them under the idea that they are buying the goods of the plaintiffs’. That is a principle which this Court acts upon by protecting parties by injunction, and it is a principle also which courts of law will enforce by giving damages, and, even where no injury has been sustained, by supporting the action, at least where it appears such a course of conduct has been pursued by the defendants.

*Seeley v. Fisher*, 21 Leg. Obs. 465, 475–76 (1841).

a common law action.<sup>82</sup> The action was indeed an action on the case “for deceit” and an “intention to deceive” was a core component.<sup>83</sup> The key case was *Crawshay v. Thompson*.

*C. Crawshay and the Requirement of Intent to Deceive at Common Law*

*Crawshay v. Thompson* was a dispute between two rival iron-masters of South Wales and concerned the stamping of bars of iron.<sup>84</sup> The claimant stamped their iron,<sup>85</sup> which they exported to Turkey, “WC.”<sup>86</sup> The defendant had been found shipping iron to Turkey marked “W•.”<sup>87</sup> It argued that it, in doing so, it was copying a mark used on iron of a particular type that was of Russian origin, and thus that there was no fraudulent intent to deceive purchasers of the iron into thinking they were getting Crawshay’s iron.<sup>88</sup> Crawshay had initially sought

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82. See, e.g., FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS 204–08 (1860).

83. *Crawshay v. Thompson*, 4 Man. & G. 357, 383–85 (C.P. 1842).

84. *Id.* at 357, 360–61.

85. *Id.* at 357–59. William Crawshay II, the owner of an ironworks in Cyfartha in Glamorgan in Wales (in today’s terms, Merthyr Tydfil), was an “iron-master” rather than an “iron manufacturer” (like Crowley). See G.C. Boase, *Crawshay, William (1788-1867)*, in 13 DICTIONARY OF NATIONAL BIOGRAPHY 63 (Leslie Stephen ed., 1897); Paula Watson & Sonya Wynne, *Crowley, Sir Ambrose (1658-1713), of Greenwich, Kent*, HIST. PARLIAMENT, <http://www.historyofparliamentonline.org/volume/1690-1715/member/crowley-sir-ambrose-1658-1713> [https://perma.cc/896Y-VPU P] (last visited Mar. 30, 2020). The firm produced bar iron, rather than converting bar-iron into steel or finished products. JOHN P. ADDIS, THE CRAWSHAY DYNASTY 15 (1957). The Cyfartha works dated back to the late eighteenth century, when Richard Crawshay, William’s grandfather, had been a partner in the firm that owned the works. *Id.* at 15–16. In 1803 it had been observed that the works were “by far the largest in this Kingdom; probably, indeed, the largest in Europe; and in that case, as far as we know, the largest in the world.” *Id.* at 16 (quoting 1 B.H. MALKIN, THE SCENERY, ANTIQUITIES AND BIOGRAPHY OF SOUTH WALES 175 (1804)). William Crawshay II had taken over as proprietor in 1834 on the death of his father William Crawshay I.

86. *Crawshay*, 4 Man. & G. at 357–58.

87. *Id.* at 361–63. The defendants, one of whom was Crawshay’s brother-in-law, Alderman Thompson, operated a nearby ironworks at Penydarran. *Penydarren Ironworks*, COFLEIN (Feb. 20, 2020), <https://coflein.gov.uk/en/site/34113/details/penydarren-ironworks> [https://perma.cc/GK4F-CN6F]; Margaret Taylor Stewart, *Merthyr’s Lost Landmarks: Penydarren House*, MELTING POT (July 9, 2018), <https://www.merthyr-history.com/?p=2057> [https://perma.cc/SG6C-KGBX].

88. *Crawshay*, 4 Man. & G. at 362–63. Counsel for Thompson asserted that “[t]here must be an actual copying, coupled with a fraudulent intention,”

injunctive relief in Chancery,<sup>89</sup> but Shadwell VC declined to grant the order, allowing Crawshay to retain the bill in Chancery while he established his legal rights.<sup>90</sup> Crawshay's declaration was in the usual form, alleging that Thompson had "wrongfully, knowingly and fraudulently" stamped the iron and then wrongfully, knowingly and fraudulently sold the iron so stamped "as and for and under the false colour and pretence that the same were respectively bars of iron of the genuine manufacture of the plaintiff . . . ."<sup>91</sup> At trial before Tindal CJ, the Lord Chief Justice left two issues to the jury.<sup>92</sup> The first was whether the marks were so similar as to be likely to deceive and thus to injure Crawshay's sales. The second—and more relevant for us—was whether the intention of the defendants in using the mark was for the purpose of supplanting the plaintiff, or done in the usual course of trade, and in execution of foreign orders sent to their house. Tindal CJ's view was that unless such a fraudulent intention were established, the defendant would not be liable. After less than an hour, the jury returned a verdict for the defendants.<sup>93</sup>

Crawshay sought to have the verdict set aside by the court sitting in banc.<sup>94</sup> Recognising that the issue of knowledge and intention was both complicated and important, the Court granted a rule nisi for a new trial.<sup>95</sup> Four months later, on 24 May, the issue was fully aired.<sup>96</sup> Serjeant Shee, for Crawshay, argued that the second question should not have been put to the jury:

[T]he motive or intention of the defendants in using the mark was immaterial, if the resemblance in fact existed, and the defendants were aware of it. If the defendants had received orders in express terms to mark their iron similarly to the plaintiffs, or in such a way as was calculated to make their iron pass for the plaintiff's, and if they had executed such orders, they would have been liable

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and that no fraud had been intended by Thompson. *Crawshay v. Thompson*, 20 Leg. Obs. 369, 382 (Ch. 1840). Rather, he explained, these were Russian characters long used by them. *Id.*

89. TNA C13/1286/9 (July 15, 1840) (bill).

90. *Crawshay*, 20 Leg. Obs. at 382–83.

91. *Crawshay*, 4 Man. & G. at 357–60.

92. *Id.* at 363.

93. *Id.* Times, Dec. 21, 1841 (reporting that the jury retired at 18.40 and delivered its verdict at 19.30)

94. *See Crawshay*, 4 Man. & G. at 364.

95. *Id.* at 364–66. Times, Jan. 14, 1841.

96. *Crawshay*, 4 Man. & G. at 357; *Crawshay v. Thompson*, Times, May 27, 1842 at 8 (C.P. 1842).

to this action, no matter from what motive they might have acted.<sup>97</sup>

On 26 May 1842, the Court ruled that the rule for a new trial should be discharged, and thus affirmed the verdict in the trial.<sup>98</sup> Coltman J referred to the plaintiff's declaration as key to the case:

The declaration alleges in substance that the defendants . . . sold those bars, with the intention that they should pass in the market as bearing the plaintiff's mark. That allegation gives rise to the questions left by my lord to the jury . . . whether the mark was used by the defendants with the intention to deceive. It appears to me that an intention to deceive is a necessary ingredient in this case. The intention is for the jury; and fraud must be made out by proof of an intention existing in the mind of the party . . .<sup>99</sup>

Interestingly, he seems to have thought that such intention would flow from knowledge of similarity:

If . . . the defendants were aware of the resemblance, and that it was calculated to mislead, the plaintiff would have been entitled to the verdict, for the intention to deceive would have been manifest.<sup>100</sup>

Maule J likewise began with the pleadings,<sup>101</sup> noting from the declaration:

[T]he gist of the action is the selling iron of the defendants' manufacture as and for iron of the plaintiff's manufacture; and that this allegation would have been sustained if it had been shewn that the defendants had sold their iron to their correspondents for the purpose of being retailed, as of the plaintiff's manufacture.<sup>102</sup>

However, Maule J observed that the declaration also alleged that the defendants knowingly manufactured their iron with a mark, in imitation of that used by the plaintiff, in order to denote that such iron was manufactured by the plaintiff. With respect to this allegation he commented:

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97. *Crawshay*, 4 Man. & G. at 372.

98. *Id.* at 388.

99. *Id.* at 377.

100. *Id.* at 377–78.

101. *Id.* at 379–80.

102. *Id.* at 380.

I think the declaration might have been good without that allegation; and if that be so, then the question arises, whether, that allegation having been inserted in the declaration, it would be necessary to prove it; and I think such proof would be necessary; for it is an allegation of a particular mode of effecting the wrong complained of, and ought therefore to be proved as alleged.<sup>103</sup>

Cresswell J in contrast focused not just on the declaration but also on the basis for the action. Relying on *Comyns Digest*,<sup>104</sup> he suggested that the action was to be understood as an action for deceit and inferred from this that “the declaration regularly ought to charge that the defendant was sciens of the matter by which he deceived; and that he did it *falsò et fraudulentè*.”<sup>105</sup> Furthermore, Cresswell J referred back to Popham’s report of the *Gloucestershire Clothier’s Case*, noting that “the gist of the action appears to have been the use of his mark ‘on purpose to deceive.’”<sup>106</sup>

The varied emphasis placed on the declaration by the different judges in Common Pleas might have left room for dispute as to whether the decision in *Crawshay* really established that intent to deceive was a necessary component of the action. Indeed, some would later argue that Maule J, in particular, had hinted that an action could have been sustained successfully by *Crawshay* if his counsel had formulated the declaration differently.<sup>107</sup> However, that is not how *Crawshay* was subsequently understood, either by courts of law or equity. Indeed, over the following decades, courts of different stripes seemed to take for granted the view that the common law regarded the action for trade mark infringement as a mutation of the action for deceit and, relatedly,

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103. *Id.*

104. *Id.* at 385. Ludlow and Jenkyns took issue with Cresswell J’s elision of the trade mark action with that of deceit. HENRY LUDLOW & HENRY JENKYNs, A TREATISE ON THE LAW OF TRADE-MARKS AND TRADE-NAMES 14–15 (1873). This, they said, occurred purely by accident, because there was no distinctive name in the English system under which such property could be placed. *Id.* at 14. Indeed, in the next big common law case, *Rodgers v. Nowill*, the issue was raised in argument by Maule J, Montagu Chambers responding that “[t]here is no other title under which such an action shall be classed.” 5 C. B. 109, 116 (C.P. 1847).

105. *Crawshay*, 4 Man. & G. at 385 (emphasis added).

106. *Id.* at 385–86 (quoting *Southern v. How*, Poph. 143, 144 (K.B. 1618)).

107. FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS 206 (1860) (“In the case of *Crawshay vs. Thompson* . . . it was held by Mr. Justice Maule, that the declaration of the plaintiff would have been good, without the express allegation of the *scier*, which it contained.”).



required a demonstration of *scierter*.<sup>108</sup> In fact, this “origin story” of the law became so engrained that when the House of Lords decided *Derry v. Peek* towards the end of the century,<sup>109</sup> commentators felt obliged to argue that the law of trade marks was by then so well established that it had acquired an independent character so that developments in the law of deceit were no longer of relevance to it.<sup>110</sup>

*D. Millington Becomes a Loose-End*

The ruling in *Crawshay* placed the Chancery judges in a difficult position. On the one hand they could apply *Motley v. Downman* and the principle that Chancery operated only in support of legal right, and thus require plaintiffs to establish *scierter*. Alternatively, they could adhere to *Millington v. Fox*, but doing so would cause the rules applicable at law and equity to diverge. Faced with this dilemma, the immediate response of the Chancery judges was to distance themselves from *Millington*.<sup>111</sup>

The boldest examples of such distancing came from the judgments of Lord Langdale MR. In *Knott v. Morgan*, two years prior to

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108. See, e.g., *Edelsten v. Edelsten*, 1 De G. J. & S. 185, 199 (Ch. 1863) (Lord Westbury, LC); *Douthwaite v. Wimble*, Times, Aug. 17, 1867, at 10–11 (Assizes, Martin B) (concerning two manufacturers of ink, the plaintiff being nonsuited because he had not established “willful infringement”); *Hickisson v. Ashton*, Times, Dec. 20, 1875 (Exch. 1875) (*nisi prius*) (describing a case heard one month after the Judicature Act came into operation between two sellers of ink who claimed to be successors to John Bond and Henry Bond and in which Cleasby B instructed jury to decide whether (i) a general resemblance between label and packs (for ink) and (ii) “whether there was such a particular resemblance between them as showed an intention to deceive and as was likely to mislead”).
109. 14 App. Cas. 337 (H.L. 1889) (stating that in an action for deceit, a plaintiff must establish that the defendant was conscious of the misleading character of the statement in issue).
110. See D. M. KERLY, THE LAW OF TRADE-MARKS, TRADE-NAME, AND MERCHANDISE MARKS 384 & n.r (1894); D. M. KERLY, THE LAW OF TRADE-MARKS, TRADE-NAME, AND MERCHANDISE MARKS 451–52 & n.u (2d ed. 1901).
111. That said, there were also some attempts to plot an intermediate course by retaining but diluting the *scierter* requirement, for example, by appealing to “objective fault” or employing presumptions. It was sometimes said that an intent to deceive could be inferred from the fact that a defendant’s sign so closely resembled the plaintiff’s as to be “calculated to deceive,” the latter phrase, itself confusingly implying *scierter*, but in fact understood by most lawyers as merely concerned with the closeness in resemblance between a plaintiff and defendant’s marks. See, e.g., *Bass v. Marlow & Beebe*, Irish Times, May 19, 1850 (Ir MR) (inferring intent from closeness of resemblance); *McDowell v. Standard Oil*, AC 632, 637 (K.B. 1927) (“calculated” does not mean “intended to” but “likely” or “reasonably likely” to deceive).

*Millington*, he had refused to discharge an injunction granted ex parte, clearly working on the assumption that fraud had to be (and had been) established.<sup>112</sup> Just over six months following the decision of the Court of Common Pleas in *Crawshay*, in *Perry v. Truefitt*,<sup>113</sup> a case concerning the designation “MEDICATED MEXICAN BALM” for hair-grease, Lord Langdale MR quickly reasserted his previous understanding of the law. Denying the plaintiff relief (on other grounds), Lord Langdale rejected any suggestion that there could be property “merely in a name or mark”, while indicating he had

no doubt that another person has not a right to use that name or mark *for the purposes of deception*, and *in order to attract to himself that course of trade, or that custom, which, without that improper act, would have flowed to the person who first used, or was alone in the habit of using the particular name or mark*.<sup>114</sup>

Referring to *Millington*, Lord Langdale MR said he was “not aware that any previous case carried the principle to that extent.”<sup>115</sup>

Such an explicit criticism of a decision of the head of the Court of Chancery might seem rather startling, but the secondary literature indicates that, prior to the 1850s, it was not unusual for the various Chancery judges—the three Vice-Chancellors as well as the Master of the Rolls—to disregard prior decisions, especially recent ones, and even those of a Lord Chancellor.<sup>116</sup> Moreover, there was little immediate

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112. *Knott v. Morgan*, 2 Keen 213, 219 (Lord Langdale MR) (Ch. 1836) (“The . . . question is, whether the Defendant *fraudulently imitated* the title and insignia used by the Plaintiffs *for the purpose* of injuring them in their trade; and, upon the affidavits and evidence before me, I have not the least doubt that the Defendant *did intend to induce the public* to believe that the omnibus which he painted and appointed, so as to resemble the carriages of the Plaintiffs, was, in fact, an omnibus belonging to the Plaintiffs . . .”).

113. 6 Beav. 66 (Ch. 1842).

114. *Id.* at 73 (emphasis added).

115. *Id.*

116. According to W.H.D. Winder, “[i]t was only slowly that a decision of the Lord Chancellor came to be held binding on a Vice-Chancellor, the Master of the Rolls or a Judge of the High Court.” W.H.D. Winder, *Precedent in Equity*, 57 LAW Q. REV. 245, 264 (1941). Victorian courts, in general, followed precedent, particularly in matters of property, but from time to time judges would deviate from those they regarded as problematic. JOHN H. BAKER, AN INTRODUCTION TO ENGLISH LEGAL HISTORY 207–12 (5th ed. 2019). The weight of different precedents depended on a host of considerations. Indeed, Sir John Baker argues that the idea of precedent as a “duty of repeating errors” was a result of the introduction of a hierarchical system of appellate courts in the Victorian period. *Id.* In any event, much turned on the age of decisions and how often they had been

potential for personal embarrassment: by 1843, the position of Lord Chancellor (being a political appointment) was held by Lord Lyndhurst LC.<sup>117</sup> In any case, Lord Langdale had differed from Lord Cottenham publicly before, and the two never had a warm relationship.<sup>118</sup>

In the decade following *Perry v. Truefitt*, a number of cases in Chancery would state the legal position in terms that appeared to require a demonstration of *scier*, while the Court of Common Pleas reiterated the requirement as a matter of common law in *Rodgers v. Nowill*.<sup>119</sup> Lord Langdale MR himself restated the position in *Croft v. Day* in 1843, and that restatement was quoted by Williams J when instructing the jury at nisi prius in the *Rodgers* case.<sup>120</sup> In *Franks v. Weaver* in 1847, counsel for the plaintiff did not even bother to cite *Millington v. Fox* before Lord Langdale MR.<sup>121</sup> In *Edelsten v. Vick*, Page-Wood VC stated:

I agree with the argument on the part of the Defendants there must be an intention to deceive the public, or this Court will not interfere. That was established in *Sykes v. Sykes* (3 B. & C. 541), which was followed by the case of *Crawshay v. Thompson* (4 Man. & Gr. 357); and in this case the Defendants have not denied, in a satisfactory way, that they intended such a deception.<sup>122</sup>

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followed, and being a recent decision, *Millington v. Fox* had not yet acquired much weight.

117. 1 THEODORE MARTIN, *A LIFE OF LORD LYNDHURST: FROM LETTERS AND PAPERS IN POSSESSION OF HIS FAMILY* 219, 396–406 (2d ed. 1884).
118. In Cottenham’s first stint as Lord Chancellor, 1836–41, the two judges did not see eye to eye, with Langdale criticising Cottenham’s bill proposing certain Chancery reforms. See 1 J.B. ATLAY, *THE VICTORIAN CHANCELLORS* 398 (1906); 2 THOMAS DUFFUS HARDY, *MEMOIRS OF THE RIGHT HONOURABLE HENRY LORD LANGDALE* 256 (1852) (“Between Lord Cottenham and Lord Langdale there was at one time a want of cordiality on the part of the former . . .”).
119. *Rodgers v. Nowill*, 5 CB 109, 124–125 (C.P. 1846) (Wilde CJ); *Id.* at 126 (Coltman J) (“[N]o man has a right to sell goods of his own manufacture, upon a false and deceitful representation that they are of the manufacture of another . . .”).
120. *Croft v. Day*, 7 Beav. 88, 89 (Ch. 1843); *Rodgers v. Nowill*, 6 Hare 325, 337 n.1 (C.P. 1846) (“The learned Judge, in directing the jury, read the judgment of Lord Langdale in *Croft v. Day* . . . as expressing the law applicable to the case.”).
121. *Franks v. Weaver*, 10 Beav. 297, 300 (Ch. 1847) (Kindersley, for plaintiff) (citing *Knott v. Morgan*, 2 Keen 213 (Ch. 1836), *Gout v. Aleploglu*, 6 Beav. 69 (Ch. 1833); and *Croft*, 7 Beav. 88 (Ch. 1843)).
122. 11 Hare 78, 84 (Ch. 1853). There was no mention of *Millington* in *Edelsten*. For another case that seems to assume a need for a showing of intent to

The reference to *Sykes* and *Crawshay* clearly indicates that, in 1853, Page-Wood VC was convinced that the rules applicable in equity did, and should, correspond with those at law, and it was by then clearly established that this required an intent to deceive. Moreover, two decisions of the Court of Appeal in Chancery, which had been established in 1851—*Burgess v. Burgess*<sup>123</sup> and *Allsopp v. Fraser*—also implied a requirement of fraud.<sup>124</sup>

The doubts raised over the authority of *Millington* were noted by commentators. In 1851, the barrister Thomas Turner, writing in *The Jurist*, noted that “no subsequent case has, up to the present time, I believe, followed” the decision in *Millington*.<sup>125</sup> In 1853, another observed, “the authority of [*Millington v. Fox*] has been doubted.”<sup>126</sup> An article on trade mark infringement in 1859 explicitly stated that of the

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deceive, see *Bass v. Marlow & Beebe*, Irish Times, May 19, 1850 (Ir MR) (inferring intent from closeness of resemblance).

123. 3 De G. M. & G. 896 (C.A. in Ch. 1853). In *Burgess*, the Court of Appeal in Chancery reversed a decision of Kindersley VC, refusing to award interim injunctive relief against the plaintiff’s own son, who like his father was involved in selling “essence of anchovies.” *Id.* at 903–04. Despite the plaintiff invoking *Millington v. Fox*, Lord Justice Knight Bruce suggested there needed to be evidence of fraud over and above the defendant’s use of his own name. *Id.*
124. *Allsopp v. Fraser*, Morning Post, Dec. 20, 1853, at 11, Times, Dec. 20, 1852, at 8 (C.A. in Ch.). In *Allsopp*, the Court of Appeal in Chancery dissolved the injunction awarded by the Master of the Rolls, Knight Bruce LJ stating: “there did not appear sufficient ground to attribute any fraud, dishonesty, or wrong intention to [the defendant], though it must be admitted he had not acted prudently.” Times, Dec. 20, 1853, at 11. As Fraser was merely involved in supplying imperfect beer to another person (Coombes) who labelled it with Allsopp’s labels, this case might alternatively be viewed (or retrospectively explained) as a case of accessory liability. *Id.*
125. Thomas Turner, *Trades Marks*, 14 JURIST 223 (1851). By this point, the closest a case had come to following *Millington* was probably *Thorne v. Butcher*, where the Vice-Chancellor is reported to have observed, “what degree of knowledge the defendants had of it did not signify.” Times, Jan. 12, 1850 (Shadwell VC) (awarding an injunction where defendant had used the name TURNER AND COMPANY, WARRANTED claiming he was ignorant that it was a mark). Note also *London and Provincial Law Assurance Co. v. London and Provincial Joint Stock Assurance Co.*, where Richard Bethell for the plaintiff argued that what mattered was the effect of the defendant’s representation, not its intention. Evening Mail, Nov. 10–12, 1847 (citing *Millington v. Fox*, 17 L.J. 37 (Ch. 1838)). According to the newspaper report, Shadwell VC indicated that he accepted the proposition in principle, but because of the differences between the two names in issues and the short period in which the plaintiff had used its mark, ordered the motion to stand over giving the plaintiff leave to bring proceedings at law. *London & Provincial L. Assurance Co.*, Evening Mail, Nov. 10–12, 1847.
126. *Untitled Article*, 17 JURIST 141, 141 (1853).

“three things to be proved,” one was “that the imitation was purposely made with a fraudulent intent.”<sup>127</sup> Giving evidence to a Parliamentary Select Committee,<sup>128</sup> leading barrister William Hindmarch declared that all English law possessed was “a law to prevent cheats.”<sup>129</sup> Rather than being a landmark, *Millington* now seemed like a road that would not be travelled. *Millington* was at best a loose-end, at worst a dead-end.

## II. MILLINGTON BECOMES A LANDMARK: THE TRIUMPH OF STRICT LIABILITY

By the time William Hindmarch offered his account to the Select Committee on Merchandise Marks, however, the position was starting to change. An increasing number of decisions of the Vice-Chancellors had begun to treat *Millington* as the controlling authority. Over the following decades, it would become accepted orthodoxy that Chancery would grant injunctive relief where the effect of continued use of a mark by the defendant would be deceptive, irrespective of their intention. This section seeks to chart, and Part III attempts to explain, this *volte face*.

The shift begins most visibly right at the end of 1857.<sup>130</sup> In *Welch v. Knott*,<sup>131</sup> the maker of aerated and mineral water which was sold under the name “Jacob Schwappe,”<sup>132</sup> sought to maintain an interim injunction that had been granted against the defendant prohibiting it from selling its water in bottles marked “Schwappe.” The defendant’s answer had explained that he had taken in secondhand Schwappe bottles, as was the custom, and now that he understood Welch did not want these to be re-used, he would desist. The report indicates that in arguing for the plaintiff, Hugh Cairns (later, Lord Chancellor Cairns)

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127. *Trade-Marks*, 12 CHAMBERS J. 218, 219 (1859).

128. SELECT COMMITTEE ON TRADE MARKS BILL AND MERCHANDISE MARKS BILL, MINUTES OF EVIDENCE, 1862, HC-12, at 128–55 (UK).

129. *Id.* at 128, Q. 2757 (W. Hindmarch).

130. *See Welch v. Knott*, 4 K & J 747, 751 (Ch. 1857) (Page-Wood VC) (indicating that the Vice Chancellor had already applied the rule in *Millington v. Fox* in the *Bass* case). However, the report in *The Jurist* is less specific on that point. 4 Jur. (N.S.) 330, 331.

131. 4 K & J 747.

132. *Id.* *Welch* and *Evill* brought proceedings in Chancery at least eight times in this period. *See Welch v. Clayton*, C15/347/W123 (1856), *Times*, June 27, 1856, at 11; *Welch v. Nevell*, C15/347/W124 (1856), *Times*, June 27, 1856, at 11; *Welch v. Selman*, *Times*, July 31, 1856, at 11; *Welch v. Luntley*, C15/347/W120 (1856); *Welch v. Ray*, C15/347/W135 (1856); *Welch v. Staniforth*, C15/229/R46; *Welch v. Cook*, C15/348/W150; *Welch v. Black*, C15/347/W139.

primarily contended that defendant was guilty of fraudulent use of the bottles with intent to deceive, but argued in the alternative that such fraudulent intent was not required in the light of *Millington*.<sup>133</sup> The report does not reference any of the common-law authorities. Although dissolving an injunction initially granted on the basis that the evidence was insufficient,<sup>134</sup> Page-Wood VC articulated his understanding of the law of trade mark infringement in terms quite different from those in his judgment in *Edelsten v. Vick* only four years before:

That the Defendant would not be entitled to use the Plaintiffs' bottles in such a manner as, in fact, to mislead the public, although there might be no intention on his part to mislead, is clear. In *Millington v. Fox* . . . Lord Cottenham felt satisfied that, in using the Plaintiffs' trade marks, the Defendants had no intention to mislead the public; yet, inasmuch as the public were, in fact, misled, he held that the Plaintiffs were entitled to a perpetual injunction. It was not sufficient for the Defendants to say that they used the marks in ignorance of their being the Plaintiffs' trade marks.

How far that doctrine is capable of being reconciled with cases at law in which the *scierter* has been held to be essential in order to enable the Plaintiff to recover, it is not material to consider. In this Court the rule is clear as laid down in *Millington v. Fox*.<sup>135</sup>

Two years later, Page-Wood VC sought to answer the question he had posed as to whether *Millington* could be reconciled with the cases at law.<sup>136</sup> In *Taylor v. Degatau*, a case to which we will return, he was clear—the rules were indeed different:

The law as to trade marks stood differently at law and in equity. The law regarded the question as simply one of fraud by a defendant in fraudulently injuring the plaintiff. A Court of equity looked further, considering a trade mark as a species of property, not like copyright, but which a man might have in his name, which was valuable to him, and which no one else had a right to

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133. See *Welch v. Knott*, 4 K & J at 749–50. See also J. A. Hamilton, *Cairns, Hugh McCalmont*, in 8 DICTIONARY OF NATIONAL BIOGRAPHY 217–20 (Leslie Stephen ed., 1886).

134. *Knott*, 4 K & J at 750–52. The evidence concerned a single sale of 12 bottles of mineral water, and only 5 of the bottles had carried the SCHWEPPE mark. *Id.* at 747–48. The Vice-Chancellor concluded that “it is manifest Mr. Chapple must have known that the Defendant was selling this soda water as his own, and not Schweppe’s . . .” *Id.* at 752.

135. *Id.* at 751 (citing *Millington v. Fox*, 3 My. & Cr. 338, 352 (Ch. 1838)).

136. *Id.*

use. Putting it on other grounds, this Court protected the right because the owner had so established his character that it was an injury to him if another party, whether done fraudulently or not, were to be allowed to pass off or lead the world to suppose that certain goods bearing his name had been really manufactured by him, when they had not.<sup>137</sup>

It was not just Page-Wood VC who took this view. In *Clement v. Maddick*,<sup>138</sup> in which an injunction was awarded protecting the title of a newspaper “Bell’s Life” (which sold for 5d) from incorporation in the defendant’s “Penny Bell’s Life and Sporting News” (which sold for 1d), Stuart VC explained:

I consider this application in the light of one to support a right to property. It has been argued on behalf of the defendants that, unless some fraudulent intention is made out, the plaintiffs are not entitled to relief. Lord Cottenham, however, in a judgment delivered by him (*Millington v. Fox . . .*) has expressed a totally different opinion, to the effect that when a trade mark has been made use of, even innocently and unconsciously, to the injury of another, that party is entitled to the interference and protection of this court.<sup>139</sup>

Perhaps most tellingly, in 1861, *Millington v. Fox* was recognised as being binding on a court of Chancery in a decision of a common law court in *Dixon v. Fawcus*.<sup>140</sup> This rather strange situation arose because of the intersection between a contract to supply goods and the rules on trade mark infringement. The plaintiff had agreed to supply the defendant with goods bearing a particular mark specified by the defendant, “Ramsey.” A maker of bricks who had been using the mark “Ramsey” brought proceedings in Chancery against Dixon, claiming an injunction

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137. *The Morality of Trade*, MANCHESTER GUARDIAN, Mar. 25, 1859, at 4. See also *Ainsworth v. Walmsley*, where Page-Wood VC stated: “The use, therefore, of the name of another manufacturer, whether done [with] *scierter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the Defendant is endeavouring to pass off the goods of his own, or somebody else’s manufacture, as the manufacture of the Plaintiff.” L.R. 1 Eq. 518, 525 (1865/66).

138. (Ch. 1859) (Stuart VC) 33 LT 117, 5 Jur. (N.S.) 592.

139. 33 LT 117 (citing *Millington*, 3 My. & Cr. 338), 5 Jur. (N.S.) 592. Counsel for the defendant, James Bacon had relied on *Burgess v. Burgess*, saying “the LJ refused the injunction on the very ground that no fraud had been shown.” 33 LT 117 (citing *Burgess v. Burgess*, 3 De G. M. & G. 896 (C.A. in Ch. 1853)).

140. *Dixon v. Fawcus*, 3 El & El 537 (C.P. 1861), 546 (citing *Millington*, 3 My. & Cr. 338), Times, Jan. 23, 1861, at 10.

and an account,<sup>141</sup> and these were settled, with Dixon agreeing to pay £150.<sup>142</sup> Dixon now brought an action in Common Pleas to reclaim compensation from Fawcus. Fawcus argued that he was not liable to reimburse Dixon as he (Dixon) was innocent and therefore not liable to Ramsey. The Court was thus required to assess how Chancery would have ruled. The Court of Common Pleas recognised that Dixon's innocence would not have provided him with a defence, and consequently found Fawcus liable. Referring to *Millington v. Fox*, Crompton J, said "That decision . . . has never been overruled; and is binding in this Court."<sup>143</sup> Similarly, Hill J, agreed that "however much [*Millington v. Fox*] may have been questioned, it has not been overruled."<sup>144</sup>

The view that the rule in *Millington* bound the chancery courts became the dominant one through the 1860s.<sup>145</sup> In *Singer v. Wilson*, decided by the House of Lords on appeal from a decision of the Court of Appeal in Chancery shortly before the Judicature Acts came into operation, Lord Cairns LC in the House of Lords reaffirmed the principle underpinning *Millington* and observing:

I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark . . . The action of the court must depend on the right of the plaintiff, and the injury that is done to that right . . . I have never known any serious doubt entertained on this subject since the case of *Millington v. Fox*.<sup>146</sup>

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141. *Ramsey v. Dixon*, TNA: C15/329/R36 (Ch. 1856).

142. *Ramsey v. Robert Fawcus*, C15/331/R62 (1856); *Ramsey v. Henry Fawcus*, C15/331/R63.

143. *Dixon*, 3 El & El at 546.

144. *Id.* at 547 (citing *Millington*, 3 My. & Cr. 338).

145. In *Kinahan v. Bolton*, for example, the Irish Lord Chancellor, Sir Maziere Brady observed that "Courts of Equity would now grant injunctions in cases where actions at law did not lie." 15 Ir. Ch. R. 75 (Ir. Ch. 1863), Newry Com. Tel., May 29, 1863. In *Standish v. Whitwell*, an injunction was awarded against a Cleveland-based firm of iron manufacturers which had innocently started using an image of an eagle (the family crest of the Whitwell's), because an image of an eagle with outspread wings had been used as a mark by the West Bromwich firm, the Eagle Coal and Iron Company, for twenty years. *Times*, Mar. 10, 1866 (Ch. 1866), 14 WR 512. Page-Wood VC explained that an injunction had been awarded because continuing use would be wrongful but that its scope should not cover "colourable imitation" as this implied the defendant *had been* guilty of fraud. *Standish*, *Times*, Mar. 10, 1866 (1866), 14 WR 512.

146. 3 App. Cas. 376 (H.L. 1877).



Indeed, by the 1870s the authority of *Millington v. Fox* was so firmly established that the memory of its ever having been controversial was lost. In *Singer Manufacturing Co. v. Loog*, for example, the amnesia affected Bacon VC, when he observed that *Millington* “has never been questioned.”<sup>147</sup>

### III. EXPLANATION

How are we to understand this remarkable reversal? In this section, I suggest that the main impetus was the desire to develop the law in a manner that the judge’s saw as appropriate to the changing social context. Divergences within the existing precedents, in particular the decision in *Millington v. Fox*, presented the possibility of developing the “law” in a different direction, and the judges took that opportunity.

In *Morality and the Market in Victorian England*,<sup>148</sup> an exploration of a wide range of business practices—excessive speculation, business frauds, as well as adulteration of foodstuffs—in mid-Victorian Britain, G R Searle identified an “outpouring of disquiet at the low standards of commercial morality.”<sup>149</sup> Another historian, James Taylor has argued that concern over trade morals was behind the opposition to more widespread use of “joint stock companies.”<sup>150</sup> In the 1850s, newspaper editorials,<sup>151</sup> public lectures, and religious sermons repeatedly addressed the question of commercial morality, reflecting on its relationship with individual morality<sup>152</sup> and its impact on the credit or trust that was said to lie behind the economic success of the nation.<sup>153</sup> For example, *The Huddersfield Chronicle*, at the turn of 1858 bemoaned:

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147. 18 Ch. D. 395, 407 (H.C. (Ch.D.) 1879).

148. G.R. SEARLE, *MORALITY AND THE MARKET IN VICTORIAN BRITAIN* (Oxford 1998).

149. *Id.* at 77. On food adulteration, see generally *id.* at 91–97; Sebastien Rioux, *Capitalist Food Production and the Rise of Legal Adulteration: Regulating Food Standards in 19th-Century Britain*, 19 J. AGRARIAN CHANGE 64 (2019).

150. JAMES TAYLOR, *CREATING CAPITALISM: JOINT-STOCK ENTERPRISE IN BRITISH POLITICS AND CULTURE, 1800-1870*, at 22 (2006) (“[C]entral to the case against companies was the charge that they undermined the importance of character in business.”)

151. *Few Subjects Occasion More Diatribes in the Journals than Trade Morality*, BRIGHTON GUARDIAN, Apr. 11, 1860; *Trade and Other Morality*, BRIGHTON GUARDIAN, Apr. 11, 1860; *The Treatment of Fraud*, 1 SATURDAY REV. POL. LITERATURE SCI. & ART 340 (1856) (criticising commercial morality and proposing generalised criminal law against fraud).

152. See *Trade and Other Morality*, *supra* note 151.

153. See *Commercial Morality*, PRESTON CHRON., Oct. 25, 1856.

[S]ince the Railway Mania of 1845, a steady declension in public morals, as regards commercial transactions, has set in, and has been working its way in many of the ramifications of commercial and trading society.<sup>154</sup>

Similar views were expressed a year later by the liberal MP and publisher, Adam Black (1784–1874), in a speech that was reported in nearly all the surviving newspapers, declaring that “a clever tradesman and a man of low cunning or acute selfishness, have come to be regarded as convertible terms.”<sup>155</sup>

Given this context, it is probably unsurprising that similar reactions occurred to cases of trade mark infringement.<sup>156</sup> In mid-Victorian Britain, it seems, an increasing array of goods bore marks, and ever greater sums of money were spent on advertising,<sup>157</sup> following the reduction in stamp duty on newspaper advertising in 1833 and its removal in 1855.<sup>158</sup> The famous preacher, Hugh Stowell, observed in 1854 that “the production of spurious and counterfeit goods forms an extensive branch of manufacture.”<sup>159</sup> Two particular incidents involving trade marks sparked sudden widespread media coverage in starkly moralizing tone, linking trade mark infringement to the broader moral malaise: the Collins Company cases and the Taylor Persian Thread litigation.<sup>160</sup>

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154. *The Commercial Convulsion and Commercial Morality*, HUDDERSFIELD CHRON., Jan. 2, 1858, at 4.

155. *The Morality of Trade*, TIMES, Dec. 29, 1858, at 5.

156. Of course, statements bemoaning the increase in use of counterfeit marks pre-date the 1850s. In *Franks v. Weaver*, Lord Langdale MR said that “[i]nstances of tradesmen endeavouring to obtain an advantage to themselves, by the use of the name and reputation of others, have, unfortunately, of late become too common.” 10 Beav. 297, 302 (Ch. 1847). In *Rodgers v. Nowill*, Wilde CJ observed that “[t]he action arises out of circumstances which, unfortunately, are of ordinary occurrence: and it would be a reproach to the law if it were not maintainable.” 5 CB 109, 122 (C.P. 1847).

157. The claimant in *Holloway v. Holloway*, for example, spent £150,000 on advertising, 13 Beav. 209, 209 (Ch. 1853), “a sum equal to the entire revenue of many a German principality,” *Advertisements*, 97 Q. REV. 183, 212 (1855).

158. Roy Church, *Advertising Consumer Goods in Nineteenth-Century Britain: Reinterpretations*, 53 ECON. HIST. REV. 621, 627, 632 (2000).

159. HUGH STOWELL, A MODEL FOR MEN OF BUSINESS 146 (1855).

160. These two were frequently referred to together. See, e.g., *Trade Marks*, MANCHESTER GUARDIAN, Mar. 17, 1861. However, they were not the only two cases that elicited comment in this period. See e.g., *Trade Morality*, JOHN BULL, May 16, 1857 (commenting on the “Elkington A” case).

*A. The Collins Company Cases*

The first spate of public comment arose when a tool-manufacturer, the Collins Company, from the United States, brought twenty-four cases in Chancery, all the bills being exhibited between March and July 1857.<sup>161</sup> Collins had, since 1826, been an axe and machete manufacturer in a town that soon took the name Collinsville in Connecticut.<sup>162</sup> Collins did not sell its goods in England, but had substantial markets in central and South America where it had obtained “a high reputation for the excellence of [its] goods.”<sup>163</sup> A practice had emerged of British manufacturers marking the edge-tools they made with the name “COLLINS” and “HERTFORD WORKS,” the merchants then supplying these goods to the United States, Australia, Cuba and elsewhere. The litigation, brought against eight manufacturers of falsely-stamped tools, seven printers of the offending labels, and nine merchants of the falsely-labelled goods,<sup>164</sup> initially prompted the (legally very interesting)

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161. The defendants were (in order of the filing of the suits): William Brookes, C15/362/C45; Richard Thomas, C15/362/C59; Charles Thomas, C15/362/C67; Arthur Linley, C15/362/C71; Thomas Henry Smith, C15/362/C73; Thomas Underwood, C15/362/C83; Edward Smith, C15/362/C84; Robert Boucher Moody, C15/362/C85; Edwin Hunt, C15/362/C86; Solomon Barr, C15/362/C87; Charles Brown, C15/363/C93; Frederick Cohen, C15/363/C110; Thomas Walker, C15/363/C113; Robert Mole, C15/363/C114; Henry van Wart, C15/363/C115; John and Henry Yates, C15/363/C116; Stephen Barker, C15/363/C117; William Walker, C15/363/C118; Charles Shaw, C15/363/C119; Frederick John Smith, C15/363/C120; John Poncia, C15/363/C121; Charles Reeves, C15/363/C122; James Bryce Perry, C15/363/C123; Abraham Dixon, C15/363/C124. *See also Trade of the Town and District*, BIRMINGHAM J., June 27, 1857, at 6 (reporting proceedings against Cohen and noting others). The first proceeding, against Brookes, a Sheffield firm, followed a letter Collins received from an informant, a grinder named Nicholas Howe. *Brookes*, C15/362/C45. Collins then employed agents, in particular a Mr. Eddowes of Liverpool, to discover those involved in the Birmingham area. *Id.*

162. For background on Collins Company, see JANET SISKIND, *RUM AND AXES: THE RISE OF A CONNECTICUT MERCHANT FAMILY, 1795-1850* (2002) (focusing primarily on labour relations). For earlier experiences of the Ames Company of Chicopee, Massachusetts, suffering at the hands of British and German manufacturers applying the “Ames” mark to compasses and swords, see MARTHA VAN HOESEN TABER, *A HISTORY OF THE CUTLERY INDUSTRY IN THE CONNECTICUT VALLEY* 17 (1955) (citing sources from as early as 1833).

163. *Illegally Striking Marks*, SHEFFIELD DAILY TELEGRAPH, June 12, 1857.

164. For those cases involving manufacturers, see *Brookes*, C15/362/C45; *Brown*, C15/363/C93; *Mole*, C15/363/C114; *Reeves*, C15/363/C122; *Smith*, C15/363/C120; *Thomas*, C15/362/C67; *Thomas*, C15/362/C59; *Yates*, C15/363/C116. For those cases involving merchants, see *Linley*, C15/362/C71; *van Wart*, C15/363/C115; *Dixon*, C15/363/C124; *Shaw*,

question of whether a U.S. business could sue in England, but this was quickly resolved in Collins' favour.<sup>165</sup> Thereafter, most of the printer and manufacturer defendants undertook to cease making such labels or stamping or selling their tools in this way as soon as Collins commenced proceedings and offered to pay the complainant's costs (and possibly compensation).<sup>166</sup> Some defendants, however, put in answers seeking to explain their actions on the basis that they had been commissioned by merchants to make goods bearing the mark and had been supplied by them with the labels and patterns. In a few of the cases a formal order was pursued—and mostly awarded by Page-Wood VC to whom nearly all the cases were allocated.<sup>167</sup> When so doing, often the Vice-Chancellor signaled his disapproval of the defendants' practices both as a matter of morals as well as law. Granting interim relief against Brown, Page-

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C15/363/C119; *Poncia*, C15/363/C121; *Perry*, C15/363/C123; *Barker*, C15/363/C117; *Walker*, C15/363/C113; *Walker*, C15/363/C118; *Cohen*, C15/363/C110. For those cases involving printers, see *Hunt*, C15/362/C86; *Underwood*, C15/362/C83; *Barr*, C15/362/C87; *Smith*, C15/362/C84; *Smith*, C15/362/C73; *Moody*, C15/362/C85.

165. Brown and Cohen both demurred on this ground, arguing that proceedings should have been brought in the place of the property or injury, as would have been the case with proceedings for copyright and patent infringement. *Collins Co. v. Brown*, 3 K & J 423 (Ch. 1857); *Collins Co. v. Cohen*, 3 K & J 428, Jur. 929, 29 LTR 245, 29 LT 205, 1 Law & Bank Bull. 8 (Ch. 1857). Page-Wood VC rejected these arguments on the basis that the acts involved fraud. *Collins Co. v. Cohen*, Times, June 12, 1857, at 11, Times, June 25, 1857 (Ch. 1857). It was reported that some of the Birmingham defendants had contemplated an appeal “to the House of Lords,” but had decided against it. *State of Trade*, BIRMINGHAM J., reprinted in MORNING POST, July 27, 1857. For earlier proceedings on this point, see *Farina v. Grossmith*, Times, Aug. 6, 1852, at 7 (Ch. 1857) (arguing unsuccessfully that German plaintiff had no locus standi when he distributed goods in England only through an exclusive agent).
166. There are answers in only 9 of the proceedings: *Mole*, C15/363/C114; *Barker*, C15/363/C117; *Yates*, C15/363/C116; *Walker*, C15/363/C118; *van Wart*, C15/363/C115; *Poncia*, C15/363/C121; *Reeves*, C15/363/C122; *Dixon*, C15/363/C124; *Cohen*, C15/363/C110. A demurrer was entered in *Brown*, C15/363/C93, and *Cohen*, C15/363/C110.
167. There are newspaper and law reports of the cases against Brown, Cohen, Walker, Thomas and Reeves: *Collins Co. v. Brown*, Times, June 12, 1857; 3 K & J 423 (1857); *Collins Co. v. Brown*, *Collins Co. v. Cohen*, *Sheffield Indep.*, June 13, 1857; *Collins Co. v. Cohen*, *Standard*, June 25, 1857; *Collins Co. v. Cohen* (1857) 30 LTR 62; 30 LT 77 (1857); *Collins Co. v. Cohen*, *Morning Chron.*, Jan. 13, 1858 (Page-Wood VC) (plea of privilege against self-incrimination rejected); *Collins Co. v. Thomas*, Times, July 7, 1858 (PWVC awarded injunction and account); *Collins Co. v. Thomas*, *Morning Post*, July 7, 1858; *Collins Co. v. Walker*, *Daily News*, Jan. 27, 1859 (Kindersley VC) (awarding Collins costs); *Collins Co. v. Walker*, Times, Jan. 27, 1859; *Collins Co. v. Walker*, 7 WR 222 (1859).

Wood VC observed that, “short of indictable offenses,” he knew of none “more discreditable than this,”<sup>168</sup> and a fortnight later, in a hearing against Cohen, he called the practice a “disgraceful subterfuge which no honest man . . . would resort to.”<sup>169</sup> In relation to a further case a year later the same judge said the “nefarious practices” which had taken place in this country were “impossible to justify.”<sup>170</sup> He elaborated:

The course of fraud had been so recklessly carried on, and the consciences of the manufacturers of these fraudulent goods had become so callous, that they looked upon the sale of them as part of their ordinary business, and made no distinction between the fraudulent and the genuine goods.<sup>171</sup>

It was not just the Vice-Chancellor who spoke out: even the trade recognised the impropriety of the practice.<sup>172</sup>

The matter garnered greater attention when a hearing came before Stuart VC in the middle of 1858. This case,<sup>173</sup> against a Birmingham tool maker, Charles Reeves, presented very much the same pattern. When Collins brought proceedings, Charles Reeves submitted to an injunction but put in an answer defending his actions.<sup>174</sup> Reeves explained that he had been asked by a merchant to manufacture machetes bearing the name “Collins & Co, Hartford, Conn.” and to apply a label advising customers to “Look for the stamp ‘Hartford,’ if you want the genuine Collins and Co.”<sup>175</sup> Reeves had not asked whether the merchant had permission, but merely assumed that the merchant had the right to utilise the mark either as agent or licensee of its proprietor. Moreover, it was the custom of the trade to take and comply with orders in this way, relying on the respectability of the merchant (knowing that to question the merchant’s authority would be regarded as “uncalled-for impertinent suspicion”).<sup>176</sup> At the hearing, counsel for Collins, James Bacon QC (later a vice-chancellor) argued that Reeves was liable because, having admitted to stamping the plaintiff’s mark,

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168. *Brown*, 3 K & J 423, 433 (1857); 1 Law & Bank Bull. 8.

169. *Collins Co. v. Cohen*, Chester Standard, June 25, 1857.

170. *Collins Co. v. Thomas*, Morning Post, July 7, 1858.

171. *Thomas*, Times, July 7, 1858.

172. *State of Trade*, *supra* note 165 (“[A] practice which they profess to reprobate.”).

173. *Collins Co. v. Reeves*, 28 LJR 56 (Ch. 1858), 4 Jur. 865, 12 Cnty. Crt. Rep. 39, 6 WR 717.

174. Charles Reeves, Letter to the Editor, TIMES, July 5, 1858, at 5.

175. Answer of Charles Reeves, *Reeves*, C15/363/C122 (Aug. 17, 1857).

176. *Collins Co. v. Reeves*, 28 LJR 56, 58 (Ch. 1858).

the court should presume fraud, or on the basis that there was “title to trade marks independently of fraud.”<sup>177</sup> Nevertheless, Reeves’ mitigation received a warmer reception from Stuart VC, who noted that important aspects of Reeves’s answer had been uncontested by Collins.<sup>178</sup> In particular, Collins had not denied the existence of the custom in Birmingham, nor the suggestion that Collins had authorised some manufacturers in England to make goods bearing the Collins stamps.<sup>179</sup> Consequently, the court proceeded on the assumption that Reeves had rebutted any presumption of fraud. Stuart VC commended Reeves’s behaviour in submitting to the injunction, and continued it, granting Collins leave to bring proceedings at law for damages.<sup>180</sup> The case eventually settled, Reeves paying £100 damages and costs.<sup>181</sup>

*The Times* was scandalised that Stuart VC had praised Reeves rather than condemned his behaviour. On 1 July 1858, it declared:

The day has come when you cannot judge facts from words. Commercial falsehood is actually creeping into our law; it is becoming legalized; it is becoming recognized as part of our jurisprudence. A lie is not a lie if it is told commercially, and for a commercial purpose; it is rather a creditable thing if it be told according to the “custom of merchants.”<sup>182</sup>

Saying it regarded Reeves’s actions as equivalent to coin-clipping, the paper wondered whether it was still operating under “very old-fashioned and obsolete notions about what is right and what is wrong in commercial morality.”<sup>183</sup> *The Times*’s views circulated widely, other papers lending their voices to the choir of disapproval. *The Globe* described the forgery of trade marks as a “growing evil.”<sup>184</sup> *The Sheffield Times* declared that “[t]he whole thing, from beginning to end, is

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177. *Id.* at 60.

178. *Collins Co. v. Reeves*, *Times*, June 30, 1858, at 11.

179. *Id.* See also *Reeves*, 28 LJR at 56–57.

180. *Reeves*, 28 LJR at 56–57, 60–61, 6 WR 717.

181. *Collins Co. v. Reeves*, *Times*, Aug. 5, 1858, at 9; *Daily News*, Aug. 5, 1858 (C.A. in Ch. 1858).

182. *TIMES*, July 1, 1858, at 9.

183. *Id.*

184. *London, GLOBE*, July 1, 1858, reprinted in *SHEFFIELD DAILY TEL.*, July 2, 1858.

indefensible, and ought to be repudiated.”<sup>185</sup> Even a Birmingham-based paper, *Aris’s Birmingham Gazette*, joined the chorus.<sup>186</sup>

Although Reeves defended himself,<sup>187</sup> the *Times’s* editorial generated widespread discussion that linked the question of trade mark infringement to matters of commercial morality in general. Some Birmingham traders, keen to protect the reputation of the city,<sup>188</sup> where it was alleged that all but three houses were involved,<sup>189</sup> responded by denying there was a custom of the kind that Reeves had alleged in his answer.<sup>190</sup> *The Sheffield Times* said it “rejoiced” at the denial from Birmingham, and proclaimed its certitude that “no such lax principles prevail in Sheffield, and we hope they will always be discountenanced and discouraged.”<sup>191</sup> The concern over moral “laxity” spread. *The Chambers Journal of Popular Literature Science and Arts* in 1858 published:

There is a laxity about all this which every right-minded person must regret. Many of the manufacturers who do these things are drawn into it by the custom of their trade, rather than by intentional roguery. Birmingham, perhaps, is about as honest as any of our large centres of industry; yet it is said to be a very frequent custom there for the manufacturers to receive orders from merchants to affix to the manufactured articles particular

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185. *Forged Trade Marks*, SHEFFIELD TIMES, July 12, 1858, at 11, reprinted in NOTTINGHAM GUARDIAN, July 15, 1858.

186. *Commercial Morality—The Collins Company v. Reeves*, ARIS’S BIRMINGHAM GAZETTE, July 5, 1858.

187. Reeves, *supra* note 174.

188. *Commercial Morality—The Collins Company v. Reeves*, *supra* note 186.

189. RICHARD OASTLER, CONVOCATION: THE CHURCH AND THE PEOPLE 73 (1860) (reporting Roebuck meeting with Milner Gibson of the Board of Trade). According to the Birmingham Journal, fifteen of the defendants in the Collins litigation were from Birmingham and one or two of the defendants were from Sheffield and Wolverhampton. *Trade of the Town and District*, *supra* note 161.

190. J. Scholefield et al., Letter to the Editor, TIMES, July 20, 1858, at 10.

191. *Forged Trade Marks*, *supra* note 185. This rather self-righteous stance overlooked the fact that four of the proceedings launched by Collins were against firms operating in that city: *Collins Co. v. Brookes*, C15/362/C45; *Collins Co. v. Brown*, C15/363/C93; *Collins Co. v. Linley*, C15/362/C71, reported as *Collins Co. v. Brown*, 3 K&J 423 (Ch 1857); *Collins Co. v. Cohen*, *Collins Co. v. Brown*, Times, June 12, 1857; SHEFFIELD TEL., June 12, 1857. Proceedings against Charles Brown also led to a criminal prosecution against James Davenport who, while collecting evidence for the Collins Company, had taken one of Brown’s saws: SHEFFIELD INDEP., May 16, 1857; SHEFFIELD INDEP., May 23, 1857.

trade-marks; the thing is done as a matter of course. The manufacturer either does not trouble himself about the morality of the matter, or he relies on the respectability of the merchant for his having authority to act as the agent of the persons whose trade-marks are thus used.<sup>192</sup>

When the Birmingham Chamber of Commerce came to discuss the matter,<sup>193</sup> it was keen to express that the practice of stamping other manufacturers' marks was "wrong and would be discouraged."<sup>194</sup> Nevertheless, questions were raised as to precisely where responsibility lay, or should lie, as between merchant and manufacturer. When a merchant insisted on the manufacturer supplying goods with a mark other than the manufacturer's own, which of the two parties was most likely to appreciate that a third party "owned" the mark and had not authorised its use? Which was most likely to recognise that it was a mark of a third party at all?

#### *B. Taylor's Persian Thread*

If the *Collins* litigation linked the specific practices of counterfeiting trade marks to general concerns of commercial morality, the intensity of concern was exacerbated significantly as a result of the litigation between *Taylor v. Degatau and Dalton*.<sup>195</sup> The plaintiff was the firm of John and William Taylor, a Leicester-based manufacturer of thread that had been in business since 1828 calling its product "J & W TAYLOR'S PERSIAN THREAD."<sup>196</sup> It had rapidly acquired a reputation and had brought successful cases against infringers both in England and internationally in the succeeding decades.<sup>197</sup> J. & W.

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192. *Trade-marks*, *supra* note 127, at 218–220.

193. *Half-Yearly Meeting of the Birmingham Chamber of Commerce*, DAILY NEWS, Aug. 2, 1858.

194. Earnktt Blake, *Trade Marks*, 6 J. SOC'Y ARTS 595, 595 (1858).

195. *Id.* at 596; Richard Ford, *To the Editor of the Manchester Guardian* (Mar. 30, 1859), *reprinted in* 1 DRAPER AND CLOTHIER 9–10.

196. Ford, *supra* note 195, at 9–10.

197. *Taylor v. Leaf*, Leicester Chron., Dec 12, 1834 (Ch. 1834) (VC) (granting an injunction against defendant, of Watling St, London, who was selling J. TAYLOR'S PERSIAN THREAD); *Taylor v. Taylor*, 28 LJR 255 (Ch. 1854) (Page-Wood VC), 2 Equity Rep. 290, 22 Eng. Rep. L. Equity 281, 22 LT 271, 47 Leg. Obs. 447, Times, Jan. 20, 1854, Leicester Chron., Jan. 21, 1854; Leicester Chron., Jan. 27, 1854 (injunction against defendant of Manchester, the court noting the falling off of the plaintiff's trade in the West Indies); *Taylor v. Carpenter*, 23 F. Cas. 742 (C.C.D. Mass. 1844) (No. 13,784); *Taylor v. Carpenter*, 11 Paige Ch. 292 (N.Y. Ch. 1844); *Taylor v. Carpenter*, 23 F. Cas. 744 (C.C.D. Mass. 1846) (No. 13,785).



Taylor was an established and highly regarded firm,<sup>198</sup> and had “acquired an immense reputation in almost every part of the world . . . without puffing or advertising, and simply from the worth of the article.”<sup>199</sup> William Taylor (as surviving partner) brought proceedings against Henry Degatau, a merchant in Manchester,<sup>200</sup> objecting to two incidents of Degatau’s use of the “TAYLOR’S PERSIAN THREAD” mark.<sup>201</sup> These were said to be violations of so “glaring, and at the same time so deeply designed a character,”<sup>202</sup> that Taylor felt obliged to take legal action. First, Degatau had commissioned a cotton manufacturer in Glasgow to make reels of cotton labelled with Taylor’s labels and to place only 200 yards on each reel yet mark them “300 yards”; and, secondly, Degatau was alleged to have asked a Manchester manufacturer, to make up reels with the name “P & F TESLOR’S PERSIAN THREAD.”<sup>203</sup> Taylor was awarded an interim injunction. The *Leicester Guardian* reported the matter under the heading “Mercantile Morality,”<sup>204</sup> associating Degatau’s behaviour with the more general moral malaise:

The frauds practised by corporations and individuals in a public and private point of view, which during the last twelve months have come to light, have attracted and indeed concentrated the attention of the public mind toward them . . . . View the matter in any way the mind can suggest, such practices elicit feelings of abhorrence and condemnation in the minds of those who are actuated by principles of honesty, and desire the extension of our commercial relations and maintenance of our prosperity.<sup>205</sup>

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198. *Trade Morality*, *supra* note 160 (“In almost every family of the middle class ‘Taylor’s Persian Thread’ is preferred to every other, and is continually used . . . .”); *Tricks of Trade* (“[H]ad acquired with every sempstress in the three kingdoms the best character for ‘good work’ and good measure . . . . Reels of it were to be found in every lady’s work box . . . .”).

199. LEICESTER GUARDIAN, May 22, 1858; Ford, *supra* note 195, at 9–10 (discussing how Taylor’s reputation had “hitherto been considered unimpeachable”).

200. According to Taylor’s amended bill, it seems Degatau was born in St. Thomas’s Island in the Danish West Indies. Taylor v. Degatau, C15/569/T45, f. 24 (Ch. 1858) (bill). Both original and amended bills sought a writ of “ne exeat regno.” *Id.* at ff. 24, 27 (amended bill).

201. *Degatau*, C15/569/T45 (bill filed Apr. 28, 1858).

202. LEICESTER GUARDIAN, May 22, 1858.

203. *Id.*

204. *Id.*

205. *Id.*

The paper then linked these concerns to smaller matters, such a trade marks:

The using a trade mark of any particular firm in a clandestine and dishonourable manner is, in fact, as great a transgression of every principle of honour and justice, and as pernicious in its effects as frauds of a greater magnitude. Say what you will it is fraud; and as such deserves severe reprehension and chastisement.<sup>206</sup>

Having given an account of the background to the court case, the paper asked:

Is the mercantile mind in this country becoming void of every principle of honour and justice? Is there nothing too gross, or too subtle to which it does not scruple to resort, to deprive their neighbours of their hardly earned and honest reputation which has taken years of exertion and much outlay to acquire? . . . It is time . . . that the commercial world should be purged . . . Let a higher standard of morality be cultivated by our merchants. Let them discard dealing with such as resort to such dishonourable and vicious practices . . . .<sup>207</sup>

However, this was not to turn out to be a simple trade mark case. As the judge, Page-Wood VC, explained this case was “one of the most painful that could come before the court.”<sup>208</sup> For, having submitted to the interim injunction, Degatau put in an answer and applied to the court for a hearing.<sup>209</sup> In its answer, Degatau explained that Taylor had formerly supplied Degatau, but their negotiations had broken down. What stunned the court was that negotiations had only broken down when Taylor refused to supply Degatau with “short lengths,” reels of cotton marked 300 yards with only 250 or 280 yards, as it had done on at least six occasions in the three prior years.<sup>210</sup> In short, J & W Taylor

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206. *Id.*

207. *Id.*

208. Taylor v. Degetau, Times, Mar. 24, 1859; *The Morality of Trade*, *supra* note 137; *Measurement in Thread and Cotton Winding*, LEICESTER GUARDIAN, Mar. 26, 1859.

209. Answer of Henry Dalton, Taylor v. Degetau, C15/569/T45 (July 8, 1858); Answer of Henry Degatau, *Degetau*, C15/569/T45 (July 14, 1858). In light of these, William Taylor filed an amended bill on 4 December 1858. Henry Dalton was a commission agent through whom Degatau secured the manufacturing of the thread by Thomas Jack.

210. Answer of Henry Degatau, *Degetau*, C15/569/T45, f. 2 (July 14, 1858) (answer to interrogatory [7]) (orders by Degatau, on behalf of the Manchester

had come to chancery to enjoin Degatau's dishonest behaviour when Taylor itself had been party to distinct, but related dishonesty in facilitating the sale of short lengths. Page-Wood VC appeared genuinely shocked and dismayed. The fact that this had been requested by the purchaser, and that Taylor had some months ago ceased to give in to these requests, was given no credit by the Vice-Chancellor whose response was to refuse injunctive relief to protect Taylor's marks, leaving Taylor only with the option to issue proceedings in the common law courts.<sup>211</sup>

The revelations produced by the litigation sparked a further outcry over "trade morality." According to *The Times*, "British character [has been] disgraced accordingly in every corner of the globe," and the reports of the case did, indeed, spread far and wide.<sup>212</sup> *The Saturday Review* bemoaned the "free-and-easy, matter-of-course style of the order" by Degatau for the short-lengths and linked these practices to those that had held the public eye over the previous year—banking frauds and food adulteration.<sup>213</sup> The *Review* worried that "the standard of commercial honour in the very highest rank of trade is perilously low."<sup>214</sup> Taylor was a model business with "a name for strict and scrupulous honesty."<sup>215</sup> If these were the practices of the honourable, it asked, what were those of the sinners?

As with the discussion of use of the Collins Company's marks, once again the question was raised whether this "disease" was prevalent in a particular locality, this time Manchester rather than Birmingham.<sup>216</sup>

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firm of Joseph Eller and Co, in June 1854, August 1854, October 1854, and July 1855).

211. Lest it seem that Degatau escaped unpunished, it may be of interest that subsequently in the same year he was declared bankrupt. JURIST, Sept. 24, 1859, at 350.

212. THE TIMES, April 3, 1860, at 9. At least as far as Bombay and Melbourne. See *Trade Morality*, THE BOMBAY TIMES AND JOURNAL OF COMMERCE, May 21, 1859; *Trade Morality—Taylor's Persian Thread*, ARGUS, June 16, 1859, at 5.

213. *The Cotton Lords, or Leicester and Manchester Measure*, 7 SATURDAY REV. POL. LITERATURE SCI. & ART 367, 367 (1859). See also *Trade Morality—Taylor's Persian Thread*, THE LEADER, No 470, (March 26, 1859) at 410 ("Such clear evidence of a fraudulent disposition generally prevalent . . . we have not before met with.").

214. *Id.*

215. *Id.*

216. *Trade Frauds and the Huddersfield Chamber of Commerce*, HUDDERSFIELD CHRON., Jan. 21, 1860, at 5 (attributing blame to Manchester, saying it was "a fair way to becoming celebrated not only for its advocacy of free trade, but for its practice of *unfair* trade"). In 1862, Matthew Clark of the Glasgow firm of John Clark, Junior & Co would

How far this sort of practice “infects other branches of Manchester industry is a very ugly and . . . painful suspicion.”<sup>217</sup> The *Leeds Mercury* warned:

[T]hey are doing all that in them lies to ruin the character of British commerce in the markets of the world—to lower our national reputation for honesty and fair dealing and thus eventually to ruin our and their own trade.<sup>218</sup>

*C. Commercial Immorality and Trade Mark Jurisprudence*

As a result of these two incidents, the question of trade mark infringement had become thoroughly entangled with general anxiety over the state of commercial morality. In a hugely influential article in the *Westminster Review*, entitled “The Morals of Trade,”<sup>219</sup> Herbert Spencer described a raft of immoral practices that possessed “various grades of flagitiousness and various degrees of prevalence.”<sup>220</sup> These included not just adulteration of food; exaggeration in advertising; spurious sales; provision of short measures; substituting cotton for silk; false representation of cheapness; bribing of servants; and “banking delinquencies.”<sup>221</sup> According to Spencer, these were practices that were not just those of the “lower classes of the commercial world,” but were pervasive.<sup>222</sup> These were practices which were “not only established, but defended,” most frequently by resort to claims of trade custom.<sup>223</sup> Having outlined a range of immoral practices of retailers, wholesalers, and manufacturers the article observed:

Among our notes of malpractices in trade, retail, wholesale, and manufacturing, we have many others which must be passed over. We cannot here enlarge upon the not uncommon practice of using false trade marks; or imitating another maker’s wrappers; and so

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report that the winding short lengths was “practised universally” for the US and Canadian market. SELECT COMMITTEE ON TRADE MARKS BILL AND MERCHANDIZE MARKS BILL, *supra* note 128, at 62.

217. *The Cotton Lords, or Leicester and Manchester Measure*, *supra* note 213, at 367.

218. *The Tricks of Trade*, LEEDS MERCURY, Mar. 26, 1859.

219. *The Morality of Trade*, WESTMINSTER REVIEW, Vol 70, No 149, 1859 (Apr), at 357.

220. *Id* at 358.

221. *Id* at 357–373, 376.

222. *Id*. See also *The Morality of Trade*, *supra* note 137 (suggesting Taylor and Degatau were “but sample of very large classes of British traders”).

223. *The Morality of Trade*, *supra* note 219.

deluding purchasers. We must be satisfied with simply referring to the disclosures that have been made relative to the doings of apparently reputable houses in the purchase of goods known to be dishonestly obtained. And we are obliged to refrain from particularizing certain established arrangements, existing under cover of the highest respectability, which seem intended to facilitate these nefarious transactions. The facts we have above detailed are given simply as samples of the system of things which it would take a volume to describe in full.<sup>224</sup>

The article saw deception of customers by misuse of trade marks as yet another example of commercial immorality. While acknowledging that there were many honest operators, the author was unable to resist the conclusion that the “state of things is very bad.”<sup>225</sup> Indeed, Spencer explained that in many cases a businessman was faced with the stark choice between maintaining their integrity and failing in business, or doing as their competitors did. Without adequate moral restraint, he argued, competition would inexorably descend into a form of “commercial cannibalism.”<sup>226</sup> Significantly, Spencer did not claim that the situation was necessarily worse than previously (recalling Defoe’s description from the turn of the eighteenth century that retailers could not live without lying). Rather, Spencer suggested that “while the great and direct frauds have been diminishing, the small and indirect frauds have been increasing; alike in variety and number.”<sup>227</sup> His objection was that these practices persisted at all given “this civilized state of ours.”<sup>228</sup> The cause, he posited, was valuing of wealth as an end in itself, and the remedy was “purified public opinion.”<sup>229</sup>

The moral outcry over misuse of trade marks soon generated a move for legal reform.<sup>230</sup> Professor Leone Levi appeared at the Society of Arts urging “let us purify our dealings—let us be perfectly clear of all such

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224. *Id.* at 373.

225. *Id.* at 380.

226. *Id.* at 381.

227. *Id.* at 384.

228. *Id.* at 384.

229. *Id.* at 389.

230. *See also* Editorial, *GLASGOW HERALD*, Dec. 23, 1859, at 4 (critiquing immoral commercial practices including false-marking); *The Immoralities of Trade*, *NONCONFORMIST*, reprinted in *GLASGOW FREE PRESS*, Jan. 7, 1860 (associating false marking with a range of immoral practices including adulteration).

imputations.”<sup>231</sup> *The Law Times* had observed that it was “[o]nly in England, where lax commercial morality receives an unhappy impulse from lax laws for the prevention and punishment of commercial fraud, has a rogue been permitted to steal his neighbour’s name and fame and affix them to his own names to deceive buyers.”<sup>232</sup> Charles Brooks, of Jonas Brooks, already irritated by third parties using its trade mark “GLACE” for thread,<sup>233</sup> organised an “Association for Suppressing the Practice of False Marking and Labelling of Goods for Sale.”<sup>234</sup> Local chapters of the Association were formed in Manchester, Liverpool, and Birmingham,<sup>235</sup> and a deputation met with Milner-Gibson, the President of the Board of Trade.<sup>236</sup> Simultaneously, local chambers of

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231. *Professor Leone Levi on Trade Marks*, BIRMINGHAM DAILY POST, Mar. 22, 1859 (describing a presentation by Professor Levi at the Royal Society of Arts).

232. *The Law and the Lawyers*, 33 LT 73, 73 (Apr. 30, 1859).

233. Charles Brooks had tolerated what he saw as misuse of the term by one competitor since 1855, but when others started to use the term, he launched proceedings against sewing cotton manufacturers in Derby. *Brooks v. Evans*, (Ch. 1860) C15/734/B144, *Guardian*, July 24, 1860 (Stuart VC), *Times*, 27 July 1860. Stuart VC refused relief because of delay in bringing the proceedings, but left Brooks to proceed at law. When Brooks publicized the litigation, Evans sought unsuccessfully injunctive relief to prohibit this: *Evans v. Brooks*LT(NS) 741 (Ch. 1860). *See also* SELECT COMMITTEE ON TRADE MARKS BILL AND MERCHANDIZE MARKS BILL, *supra* note 128, at 68.

234. Jonas Brooks, Letter to the Editor, *Fraudulent Labels*, LONDON EVENING STANDARD, Dec. 21, 1859, at 7, *reprinted in* MORNING POST, Dec. 22, 1859, at 3; *Frauds of the Trade*, LAW TIMES, Dec. 17, 1859; *Money and City Intelligence*, LAW TIMES, Dec. 17, 1859 (observing that it was a “national disgrace” that such an organization was necessary); Editorial, *In Our City Article Last Saturday*, LAW TIMES, Dec. 20, 1859; *Trade Frauds and the Huddersfield Chamber of Commerce*, *supra* note 216, at 5 (publishing the opinion of Coleridge on the possibility of prosecuting makers of short lengths for conspiracy); OASTLER, *supra* note 189, at 71.

235. *Falsely Labelling Goods*, COVENTRY HERALD & OBSERVER, Mar. 2, 1860, at 3, *reprinted in* HUDDERSFIELD CHRON., Mar. 3, 1860, at 6 (Manchester branch); *Falsely Labelling Goods*, DAILY POST, Mar. 10, 1860, at 3 (reporting on the establishment of the Liverpool branch); *Local Association*, GLOBE, Mar. 28, 1860 (reporting on the creation of the Birmingham chapter).

236. *Fraudulent Trade Marks*, BIRMINGHAM DAILY POST, Apr. 3, 1860, at 3; *Commercial Morality—Fraudulent Trade Marks*, LEICESTER GUARDIAN, Apr. 7, 1860 (reporting a meeting with Milner Gibson); *Fraudulent Trade Marks*, MORNING ADVERTISER, Oct. 26, 1860, at 6 (reporting on the annual meeting).

commerce took up the issue.<sup>237</sup> As the pressure grew,<sup>238</sup> bills were presented to Parliament, a Select Committee heard evidence, and a new criminal law was adopted, the Merchandise Marks Act 1862.<sup>239</sup>

The same pressures offer an explanation for the judicial shift towards a trade mark infringement rule based on *Millington v. Fox*, rather than on aligning the rules of equity with the common law, as expressed in *Crawshay* and *Rodgers v. Nowill*. The judges, in particular Page-Wood VC, were intimately involved in the cases that generated the outpouring of concern over trade mark misuse as a matter of commercial morality. As already noted, he made numerous observations relating to the moral impropriety of various actions.<sup>240</sup> In 1864, giving judgment in a contempt proceeding brought by Jean Maria Farina, a maker of Eau de Cologne, the judge reflected:

No one could rejoice more than he had done at the passing of the [Merchandise Marks Act 1862]; and certainly in this branch of the Court he had been on all occasions most anxious to correct the mischiefs against which the Act was directed. Perhaps in some instances he had gone too far. But, at any rate, there had been no slackness to interfere and the plaintiff had on many occasions assisted in the assertion of his rights.<sup>241</sup>

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237. *Trade Frauds and the Huddersfield Chamber of Commerce*, *supra* note 216 at 5; *The Huddersfield Chamber of Commerce*, LONDON EVENING STANDARD, Jan. 20, 1860, at 2 (reporting condemnation of this “serious evil”); GLOBE, Jan. 20, 1860, at 3 (reporting similar condemnation).

238. The Sheffield Chamber of Commerce had sent a delegation to meet with the Board of Trade on April 15, 1858. *Sheffield Chamber of Commerce Annual Meeting*, SHEFFIELD INDEP., Feb. 5, 1859, at 11.

239. Merchandise Marks Act, 1862, 25 & 26 Vict. C. 88 (Eng.); *see also* SELECT COMMITTEE ON TRADE MARKS BILL AND MERCHANDIZE MARKS BILL, *supra* note 128.

240. One might contrast Lord Herschell in *Derry v. Peek* [1889] 14 App. Cas. 337, 376 (having reasserted that deceit requires fraudulent intent, explaining that if it were desirable, as he thought it would be, that any person issuing company prospectus to investors should be under an obligation to ensure the representations were correct, this was a matter for the legislature, not the courts).

241. *Farina v. Meyerstein*, Times, Feb. 1, 1864, at 10. The defendant was a commission agent against whom an injunction had been issued in November 1857. *Id.* Page-Wood VC refused to commit him, instead ordering him to pay the costs of the motion. *Id.* By 1864, Farina had exhibited bills in Chancery on at least 15 occasions. *See* *Farina v. Carmouche*, C16/198/F27 (1864); *Farina v. Zadig*, C16/73/F63 (1862); *Farina v. Rockfort*, C15/751/F7 (1860); *Farina v. Loewe*, C15/753/F82 (1860); *Farina v. Meyerstein*, C15/374/F73 (1857); *Farina v. Silverlock* C15/195/F12 (1855); *Farina v. Spratt*, C15/27/F2 (1853); *Farina v.*

Clearly, this was a field where the courts of equity were happy to choose the most “trade mark owner friendly” rules available in order to instill a higher standard of commercial morality. The rule in *Millington v. Fox* was evidently the rule that would accord more closely with heightened commercial morality.

It may seem paradoxical that to promote more “moral” conduct, courts would adopt a standard that made irrelevant the specific “culpability” of a trader’s acts.<sup>242</sup> However a subjective *scierter* standard failed to give the desired protection where traders were collectively indifferent to the question of whether they were stamping marks that would be understood by end-purchasers as indicating that the goods had been made by a particular manufacturer.

By making liable anyone who applied a mark to goods or who sold or distributed goods with a mark so applied, the rule would give those manufacturers and distributors an incentive to ensure they were not using the marks of third parties. As Lord Romilly MR explained in *Cartier v. Carlile*:

It follows that equity will restrain the further use of the trade mark by the person imitating it, and will make him account for such advantage, if any, as he may have derived from its user. That is the principle which is laid down in *Millington v. Fox* (3 Myl. & Cr. 338), and if that principle were not followed, it would lead to serious consequences. A man by carefully abstaining from inquiring whose trade mark he was imitating, and by refusing to hear anything about it, might escape from all liability.<sup>243</sup>

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Mather, C15/28/F20 (1853); Farina v. Grossmith, C14/1324/F66 (1852); Farina v. Gebhardt, C14/1385/F10A (1852); Farina v. Gebhardt, C14/1391/F10A (1852); Farina v. Rossi, C14/1323/F35 (1852); Farina v. Shaw, C14/1323/F38 (1852); Farina v. Grossmith, C14/522/F43 (1846); Farina v. Florence, C14/522/F41 (1846); Farina v. Schooling, C14/522/F44 (1846).

242. For discussions as to whether strict liability is a morally appropriate standard, see ERNEST J. WEINRIB, *THE IDEA OF PRIVATE LAW* 171–203 (2012); Andrew Simester, *Is Strict Liability Always Wrong?*, in *APPRAISING STRICT LIABILITY* 21 (A.P. Semister ed., 2015) (discussing strict liability crimes and arguing that they might be defensible for “non-stigmatic” crimes).

243. *Cartier v. Carlile*, 31 Beav. 292, 298 (Ch. 1862) (Sir John Romilly MR) (citing *Millington v. Fox*, 3 Myl. & Cr. 338 (Ch. 1838)). The report in *The Jurist* does not include the assertion that “it would lead to serious consequences.” *Cartier v. Carlile*, 8 Jur. 183, 184 (1862). For Sir John Romilly M.R., this approach would also have been consistent with the broad conception that he promoted for equitable intervention for misrepresentation in contract. See Michael Lobban, *Misrepresentation*, in 12 *THE OXFORD HISTORY OF THE LAWS OF ENGLAND: VOLUME XII: 1820–1914*, at 400,



The manufacturers could not hide behind assertions of ignorance (that they had never heard of “Crowley Millington” or “Collins Company”), nor could they successfully plead they were intending to imitate a “Russian mark” (rather than that of the plaintiff), nor that they were merely complying with the orders of a merchant.<sup>244</sup>

All those involved in the distribution chain, including importers, wharfingers, wholesalers, middlemen, and consignees,<sup>245</sup> could no longer claim that they believed the goods they were selling had been marked with the authority of the mark owner for no other reason than that the goods bore the mark. Trade mark owners could stop the further distribution of all falsely-marked goods.<sup>246</sup> Retailers and commission agents would need to take care not to sell counterfeit goods,<sup>247</sup> or goods

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418, 427 (William Cornish, J. Stuart Anderson, Raymond Cocks, Michael Lobban, Patrick Polden & Keith Smith eds., 2010).

244. *See Cartier v. Carlile*, 31 Beav. 292, 297–99, 8 Jur. 183 (Ch. 1862) (awarding an injunction and account against thread-maker who, on instructions of purchaser, made imitations of plaintiff’s labels).
245. It was precisely these people who were, around this time, opposed to the introduction of criminal liability without an accompanying trade mark register. *See, e.g., Petition of the Manchester Guardian Society for the Protection of Trade*, App 627, in REPORT OF THE SELECT COMMITTEE ON PUBLIC PETITIONS, app. at 291 (in respect of petitions presented April 29–May 1, 1861) (“[Dealers] in goods which are so variously marked that it is impossible to ascertain in most cases whether any trade mark is interfered with, or even whether the mark is intended as a trade mark or not.”); *Petition of Wholesale Warehousemen Carrying on Business in the City of London*, in REPORT OF THE SELECT COMMITTEE ON PUBLIC PETITIONS, app. at 268 (presented April 22–24, 1861) (alleging that trade marks are “so numerous, so varied and so undefined that it is impossible . . . to know them”).
246. *See, e.g., Ponsardin v. Stear*, 32 Beav. 666 (Ch. 1863) (granting an injunction against wharfinger prohibiting further distribution of counterfeit CLQUOT champagne); *Ponsardin v. Peto*, 33 Beav. 642, 644, 33 LJ Ch 371, 10 Jur. (N.S.) 6 (Ch. 1863) (permitting release of goods to consignee once trade mark had been removed); *Hunt v. Maniere*, 34 Beav. 157, 157–58, 11 Jur. 28, 34 LJ Ch 142, Times, Dec. 9, 1864 (Ch. 1864) (Sir John Romilly MR); *Hunt v. Maniere* 11 Jur. 73, 34 LJ Ch 144, Times, Jan. 30, 1865 (C.A. in Ch. 1865) (proceedings to restrain action at law by consignee against wharfinger in relation to counterfeit CLIQUOT champagne the wharfinger had refused to release); *Moet v. Couston*, 33 Beav. 578, 581 (Ch. 1864) (Sir John Romilly MR) (enjoining an innocent distributor, but providing no account of profits).
247. *See, e.g., Burgess v. Hills*, 26 Beav. 244, 247–48 (Ch. 1858) (Sir John Romilly MR) (holding an innocent retailer of counterfeit anchovy sauce liable to injunction and costs, with the plaintiff waiving the account); *Burgess v. Hateley*, 26 Beav. 249, 249 (Ch. 1858) (same).

made by one manufacturer in the packaging of another.<sup>248</sup> The strict liability rule would also circumvent any problems that might have arisen in imputing “intention to deceive” to corporations,<sup>249</sup> a mode of business organisation that was destined to become much more common after the Companies Acts of 1855 and 1856.<sup>250</sup> Adopting the rule in *Millington v. Fox* also answered the question raised by the Birmingham Chamber of Commerce about whether responsibility should lie with manufacturer or merchant: it should lie with *both*.

But why should angst over the immorality of misuse of trade marks influence the development of trade mark infringement law when, commentators tell us, the legal system failed to respond to over the associated morality-based concerns about deceitful corporate prospectuses, food adulteration, and so forth? For example, George Robb’s groundbreaking investigation of *White Collar Crime in Victorian England*,<sup>251</sup> demonstrated that both courts and legislators adhered steadfastly to the tenets of *laissez-faire*, and this impeded proposals to reform company law. Ingeborg Paulus’s examination of responses to food adulteration described similar pressures against regulatory intervention.<sup>252</sup>

One answer is that judicial development was more straightforward for trade mark law than these other fields (where reforms required new legislation, coupled with a new regime of public enforcers). The key piece in the jigsaw, *Millington v. Fox*, was already decided, and arguably the weight of that decision, as one of the Lord Chancellor, grew as every year passed (and as the courts became increasingly formalistic in the handling of precedent).<sup>253</sup> Moreover, with trade mark

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248. See, e.g., *Barnett v. Leuchars*, 13 LT 495, 495–96 14 W.R. 166, 166–67 (Ch. 1865) (Stuart VC) (issuing an injunction against further sale of fireworks, but refusing to award costs).

249. See *Lawson v. Bank of London*, 18 C.B. 84, 84–85 (1856) (describing the proposition that a corporation could not be sued for such a cause of action, because it could not have a relevant intent to deceive). The Court accepted the demurrer, but on a different basis. Willes J intimated that he would not have accepted a defense merely grounded in corporate status. *Id.* at 1300–01.

250. Ron Harris, *The Private Origins of the Private Company: Britain 1862–1907*, 33 OXFORD J. LEGAL STUD. 339, 345 (2013).

251. GEORGE ROBB, *WHITE-COLLAR CRIME IN MODERN ENGLAND: FINANCIAL FRAUD AND BUSINESS MORALITY 1845-1929*, at 189 (1992).

252. See INGBORG PAULUS, *THE SEARCH FOR PURE FOOD: A SOCIOLOGY OF LEGISLATION IN BRITAIN* (1974).

253. See WILLIAM WILLIAMSON KERR, *A TREATISE ON THE LAW AND PRACTICE OF INJUNCTIONS IN EQUITY* 488–89 (1867) (“The doctrine . . . laid down in *Millington v. Fox* must be considered as law until the question comes before a higher tribunal.”).

infringement, there was always a private interest in prevention, so the problem “that what is everybody’s business is nobody’s business” was not an issue.<sup>254</sup> At the same time, the problems raised by a divergence in the rules between law and equity seemed likely to diminish as procedural reforms made it ever more clear that proceedings at law could and would be avoided.

More important than these reasons, however, was the fact that the rule in *Millington v. Fox* was not seen to be in tension with “laissez-faire.” Choosing one form of trade mark infringement rule over another certainly reallocated costs (and benefits), but these were as much between traders as between traders and, for example, consumers. Indeed, those who opposed regulation of trade to protect what we would today call the “consumer,” could stand behind enhanced protection of trade marks untroubled. The MP for Sheffield, John Roebuck,<sup>255</sup> for example, who opposed the legislative proposals to tackle food adulteration,<sup>256</sup> led the Sheffield deputation seeking stronger trade mark protection.<sup>257</sup> One reason why trade mark protection was viewed by some to have greater importance was that trade marks offered one form of “private law” answer to the protection of consumers. As the *London Review* observed, linking the problem of consumer deception in relation

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254. ROBB, *supra* note 251, at 160 (quoting REPORT OF THE SELECT COMMITTEE ON COMPANIES ACTS, 1877, at 125 (receiving evidence from Jessel MR)).
255. Roebuck was MP for Sheffield from May 3, 1849 until November 17, 1868, and January 31, 1874 until November 30, 1879. Fraser Rae, *Roebuck, John Arthur (1801-1879)*, in 49 DICTIONARY OF NATIONAL BIOGRAPHY 95–97 (Sidney Lee ed., 1897).
256. HC Deb (Feb. 29, 1860) (66) col. 2033 (opposing food Adulteration Bill); HC Deb (Mar. 14, 1860) (67) col. 544 (Adulteration of Food Bill, Committee Stage) (stating that “the buyer was the best person to protect himself, and so soon as a man was found to be selling impure and bad articles he lost his customers”).
257. *Sheffield Chamber of Commerce*, SHEFFIELD INDEP., Feb. 5, 1859, at 11 (reporting a meeting by the Sheffield delegation, comprising Robert Jackson, John Robert Smith, Alderman Matthews and John Roebuck, with the Board of Trade to discuss trade mark protection); HC Deb (Feb. 6, 1861) (161) cols. 115–16 (reporting Roebuck’s urging for the protection of trade marks); HC Deb (Feb. 18, 1862) (165) cols. 442–45 (reporting Roebuck seeking leave to introduce bill); HC Deb (Feb. 26, 1862) (165) col. 770 (reporting the second reading of Roebuck’s bill and its movement to the Select Committee). Roebuck then chaired the Select Committee on Trade Marks Bill and Merchandize Marks Bill, the outcome of which led to mere criminalization rather than to establishing a trade mark register. REPORTS OF THE SELECT COMMITTEE ON TRADE MARKS BILL AND MERCHANDIZE MARKS BILL, *supra* note 128.

to “experience goods” (e.g. short lengths) to the desirability of effective trade mark enforcement:

We reserve our commiseration for the purchasers of those articles which are not to be tested by inspection over the counter. In such cases no doubt it may be said that we should look to the trade mark. The name of a good maker is a guarantee of goodness in the article. Alas! For the purchaser who relies on such protection. What is the number of such goods which bear a genuine trade mark? Perhaps not one in ten.<sup>258</sup>

### CONCLUSION

By the last decades of the nineteenth century, few, if any, doubted the authority of *Millington v. Fox*. The position did, however, leave some matters unresolved. Perhaps most importantly, recognising *Millington* as authoritative required the courts to explain the relationship between the two systems of trade mark law at common law and in equity. Two theories emerged,<sup>259</sup> one which sought to reconcile the rules, at least superficially; the other which embraced the divergence and pointed towards a different basis for liability in equity than at law. I call these “prospective theory” and “property theory.”

According to “prospective theory,” the position at law and in equity were not inconsistent, but rather reflected the different viewpoints.<sup>260</sup> The common law was concerned with compensation for past wrongs, and thus was backward looking; equity was focused on preventing

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258. *Tricks of the Trade*, LONDON REV., reprinted in HERALD, Jul. 2, 1861 (Melbourne).

259. A third possibility was that both law and equity acted on the basis of fraud, but each had different views of what amounted to fraud. See e.g., *Earl of Aylesford v. Morris*, 8 Ch. App. 484, 490–91 (1872/73) (Lord Selbourne LC).

260. See, e.g., *Leather Cloth Co. v. Am. Leather Cloth Co.*, 1 H & M 271, 287 (Ch. 1863) (Page-Wood VC) (“A Court of law may well think a Defendant not liable to an action for an act done *absente animo malo*, and quite consistently with this a Court of Equity may hold that if he continue to do the act he will commit a fraud.”); *M’Andrew v. Bassett*, 33 LJ 561, 10 LT (N.S.) 445 (Ch. 1864) (“I never could understand why the case of *Millington v. Fox* introduced any difficulty. The principle of *Millington v. Fox* is this, that although a person has used another man’s trade mark perfectly innocently, if he continues for one moment after he has been told of it to use another man’s trade mark, he does so fraudulently . . .”). Compare the explanation offered as to why contracts might be rescinded in equity for innocent misrepresentation, in so far as it would be “fraudulent” for a person, once aware of the misrepresentation, “to insist upon keeping that contract”: *Redgrave v. Hurd*, 20 Ch. D. 1, 12–13 (H.C. (Ch.D) 1881) (Jessel MR).

continuation of behaviour that would cause harm, and was therefore forward looking. Reflecting this, the common law was concerned with *scierter* at the time of adoption of a mark; equity was concerned with whether continued use would be wrongful (the circumstances of adoption being irrelevant).<sup>261</sup> A defendant might have adopted a mark in ignorance or innocence, and thus would not be liable for past acts, but once deception was found, it would be wrong for that person to continue to use the mark. In this conception, both law and equity could be said to be concerned with fraud: past fraud and future fraud.<sup>262</sup>

According to “property theory,” the legal position in equity was different from that at law: the law was concerned with fraud, equity with protection of property.<sup>263</sup> Of course, the property in a mark was not a right of exclusivity for all uses, just for uses on such similar goods that purchasers would be deceived.<sup>264</sup>

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261. *Singer v. Wilson*, LR 3 HL 376, 400 (H.L. 1877) (Lord Blackburn) (“If he persevered, as he threatens to do, in this course, after learning that it does produce this effect, he would (unless in very exceptional cases) do a wrong injurious to the Plaintiffs, and should be prevented from doing that wrong.”); KERLY, *supra* note 4, at 16 (“[A person] does, in fact, commit a fraud when he continues his conduct after discovering its dangerous character.”); *Marengo v. Daily Sketch & Sunday Graphic Ltd*, 65 RPC 242, 253–54 (H.L. 1948) (Lord Du Parcq).

262. One difficulty with prospective theory is that it assumes knowledge implies intention, a matter that some judges have denied. *See Hendriks v. Montagu*, 17 Ch. D. 638, 647–48 (H.C. (Ch.D.) 1881) (Brett MR). Relatedly, it leaves open the question of whether, if ever, a person has a legitimate interest in continuing to use a mark which was adopted innocently, for example, where the mark relates to the person’s own name. *Id.*

263. For a detailed account of the emergence of property theory, see L. Bently, *From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property*, in *TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* 1, 20–28 (Graeme Dinwoodie & Mark D. Janis eds., 2008). *See also* KENNETH R. SWAN, *THE LAW AND COMMERCIAL USAGE OF PATENTS, DESIGNS, AND TRADE MARKS* 280 (1908) (“*Millington v. Fox* . . . signalises the full recognition, at least in the Chancery Courts, of trade marks as property capable of legal protection.”).

264. One problem with property theory would have been reconciling the conclusion with the many judicial statements that there is no property in a mark as such. This problem was only finally resolved when the House of Lords held that the property that was protected was goodwill associated with the mark: *AG Spalding & Bros. v. AW Gamage Ltd.*, [1915] 32 RPC 273 (H.L.) Another problem in applying the theory was identifying what could constitute a mark, i.e. when a sign might be “owned.” Exponents of property theory occasionally sought to bifurcate protection into “trade marks” (protected as property) and “analogous matters” (where protection depended on proof of intention to deceive). One such attempt by Jessel MR in *Singer v. Wilson* was rejected by the House of Lords. LR 3 HL 376 (H.L. 1877).

In principle, the choice between these two theories had (and may continue to have) implications.<sup>265</sup> The most obvious related to remedies: if prospective theory applied, financial remedies should only arise in respect to past uses that were fraudulent at the time;<sup>266</sup> if property theory applied, it might be open to courts at least to award an account of profits (and even damages) in relation to even innocent past uses on the basis that these profits derived from another's property.<sup>267</sup> As things

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265. According to Lewis Boyd Sebastian, the difference “may seem academic, but it is of real importance.” LEWIS BOYD SEBASTIAN, *THE LAW OF TRADE MARK REGISTRATION* 5 (2nd ed. 1922). For the suggestion that little flowed from property theory, see Bently, *supra* note 263, at 31–33.
266. *Moët v. Couston*, 33 Beav. 578, 578–79 (Ch. 1864) (Romilly MR) (distinguishing *Cartier v. Carlile*, 31 Beav. 292 (Ch. 1862) and refusing to order an account from a seller of Moët champagne who did not know the champagne was counterfeit); *Leech v. Bolland*, *Guardian*, July 4 1875 (Ch. 1875) (Bacon V.C.) (refusing account because bill did not allege fraud); *Ellen v. Slack*, 24 Sol. Jo. 290 (H.C. 1880) (refusing account); *AG Spalding & Bros. v. AW Gamage Ltd.*, 32 RPC 273 (H.L. 1915), 283, (Lord Parker) (“[T]he complete innocence of the party making it may be a reason for limiting the account of profits to the period subsequent to the date at which he becomes aware of the true facts.”).
267. *See Collins Co. v. Thomas*, *Times*, July 7, 1858 (Ch.) (Page-Wood V.C. awarding account against defendant who had been commissioned to mark machetes with plaintiff's mark); *Cartier v. Carlile*, 31 Beav. 292, 298 (1862) (Romilly MR) (“[T]he liability to account for the profits is incident to the injunction, and that the fact of the Defendant not knowing to whom the trade mark he copies belongs, does not, in the slightest degree, affect the right of the owner to an injunction and to an account of the profits, as soon as he ascertains that it is imitated and used.”); EDWARD LLOYD, *THE LAW OF TRADE MARKS: WITH SOME ACCOUNT OF ITS HISTORY AND DEVELOPMENT IN THE DECISIONS OF THE COURTS OF LAW AND EQUITY* 82–83 (2d ed. 1865) (“In ordering a defendant to account for profits, the Court of Equity is not affected by the consideration of fraud. . . . [*Cartier*] seems to be a natural result from the character of the equitable jurisdiction in such cases, although at law the plaintiff could not have recovered damages without proving the *scierter*.”); J. BIGLAND WOOD, *THE LAW OF TRADE MARKS: INCLUDING THE MERCHANDISE MARKS ACT, 1862, AND THE TRADE MARKS REGISTRATION ACT, 1875, WITH THE RULES THEREUNDER, AND PRACTICAL DIRECTIONS FOR OBTAINING REGISTRATION* 30–31 (1876) (footnote omitted) (“[H]owever hard it may appear upon an innocent infringer, and however ungenerous it may be for the plaintiff to insist upon an account in such cases, yet that a plaintiff who is not in any default, should be considered entitled to an account of the profits properly attributable to the improper use of the mark by the defendant.”). It is an oddity that in *Edelsten v. Edelsten*, where Lord Westbury LC embraced property theory, he took the view that there could be no account or compensation “except in respect of any user . . . after he became aware of the prior ownership.” 1 De G. J. & S. 185, 199 (Ch. 1863). *See also* LUDLOW & JENKYNs, *supra* note 26, 44–47

turned out, in England, in relation to registered trade marks, the position was reversed: damages came to be viewed as a right, an account of profits dependent on knowledge.<sup>268</sup> As for use of unregistered marks (so-called “passing off”), property theory has slowly prevailed: the question of damages remained unresolved in 1948, but the current tendency of lower courts is to ignore the history and allow damages and accounts against even innocent defendants.<sup>269</sup>

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(indicating that no account or damages as against an innocent defendant, despite seeing trade mark rights as proprietary).

268. *AG Spalding & Bros. v. AW Gamage Ltd.*, 32 RPC 273, 283 (H.L. 1915); *Henry Heath Ltd. v. Frederick Goringe Ltd.*, 41 RPC 457 (H.C.(Ch.D.) 1924) (Eve J) (finding that in a registered trade mark case, plaintiff was entitled to damages even against innocent defendant); A. BLANCO WHITE & ROBIN JACOB, *KERLY’S LAW OF TRADE MARKS AND TRADE NAMES* 15–80, 327–28 (12th ed. 1986).
269. *Young v. Holt*, 65 RPC 25, 26 (H.C. 1948) (ordering an account for passing off even though defendant adopted sign in ignorance); *Walker v. Ost*, 87 RPC 489, 512–13 (H.C. 1970) (Foster J) (conducting an inquiry as to damages in passing off case without fraud); *Gillette UK v. Edenwest Ltd.*, 111 RPC 279, 291–94 (H.C. (Ch.D.) 1994) (describing the absence of fraud as inadequate justification for the denial of damages); *Reed Exec. PLC v. Reed Bus. Info. Ltd.*, [2004] EWCA Civ 159 (C.A. 2004) (Jacob LJ) (holding that the unwitting defendant “will have to pay compensation both for passing off . . . for the past use, having . . . caused real damage”); *MELLOR ET AL.*, *supra* note 1, at 22–158 (16th ed. 2017) (“The claimant has a right to damages regardless of the defendant’s state of mind, and that is so regardless of whether the cause of action is infringement of a registered mark or passing off.”).