

Dunhill v. Bartlett & Bickley.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE RUSSELL.

June 29th and 30th, and July 3rd, 4th, 5th, 6th and 31st, 1922.

DUNHILL v. BARTLETT & BICKLEY.

Action for passing off.—Device.—Alleged similarity of devices.—White spot. 5
—Red spot.—Trade Name of goods.—Alleged fraudulent intention in adoption
of device disproved.—Probability of deception not established.—Action dis-
missed with costs.

The Plaintiff had since 1912 sold tobacco pipes of his own manufacture, marked 10
on the mouthpiece with a white spot with the addition of the words " Dunhill
" London," and had sold very large quantities of pipes and other smokers'
requisites so marked. The minimum price of the Plaintiff's pipes was £1 1s.
Evidence was given that a white spot on a pipe was identified in the minds of
the public with the Plaintiff's goods, and that the Plaintiff's pipes were asked
for as " white spot pipes " and sometimes, more particularly by ladies, as 15
" spot pipes." The business of the Defendant firm was purchased in 1901
by one J. who had continuously carried on business under the firm name since
that date. In May 1920 the Defendant registered the name " Barbic " as a
trade mark and in September of that year the Defendant put upon the market 20
a tobacco pipe manufactured for him and marked upon the mouthpiece with
a red spot, and also marked on the stem, on one side with the word " Barbic "
and on the other with the name and address of the Defendant firm. These
pipes were sold at 12s. 6d. The Plaintiff alleged that the spot on the
Defendant's pipe, though of a different colour from the Plaintiff's spot, was
calculated to deceive and brought an action for passing off. At the trial the 25
Plaintiff further alleged that the red spot had been adopted by J. with a
fraudulent intention.

Held, that a red spot was placed on the Defendant's pipes with no thought
or intention of confusing the Defendant's pipes with the Plaintiff's pipes; that
the identification mark of the Plaintiff's pipes was not a spot but a white spot; 30
that no clear case had been established of an intending purchaser of a Plaintiff's
pipe finding himself deceived by reason of the red spot into buying a Defendant's
pipe; that a trap display in a tobacconist's window consisting of three of the

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Plaintiff's pipes and three of the Defendant's pipes, each pipe bearing a similar price ticket, except as to price, which led to a customer asking for a 12s. 6d. Dunhill, was too well baited to assist in proving deception; that the Plaintiff never having put any spot on his pipes but a white spot and the only point
 5 *of similarity between the Plaintiff's and the Defendant's pipes being a spot, the evidence failed to justify the claim that, where the essence of a mark of origin is its particular colour, a similar mark of a wholly different colour would indicate the same origin, and that the action must be dismissed with costs.*

The Plaintiff, Arthur Dunhill, was a pipe manufacturer and tobacconist
 10 carrying on business at 31A Duke Street, St. James's, London, with factories at other places in London. Up to the year 1910 the business had been a purely retail one, but in 1910 the Plaintiff commenced to manufacture pipes, which were stamped "Dunhill, Duke Street, S.W." In 1912 he took out a Patent for a device comprising an inner tube to be inserted in the stem and
 15 mouthpiece of a pipe which he introduced with his pipes and at the same time he adopted as a special mark a white spot which he placed on the upper side of the mouthpiece near the junction of the mouthpiece and the stem. These pipes became very popular, and acquired a large and increasing sale. In the year ending the 30th June 1921 the sales amounted to over 276,000. Until
 20 November 1918 all pipes with the exception of about one half of one *per cent.* of the total output were marked with a white spot, and from that date the white spot was placed on all the Plaintiff's pipes whether they had the inner tube in them or not. The white spot was also used on other smokers' requisites such as cigarette holders, tobacco pouches and other goods.

The business carried on under the firm name of *Bartlett & Bickley* had
 25 belonged to *Charles David Jonas* since 1901 and it had been moved to Vigo Street in 1916. Before 1920 the Defendant had sold pipes of other people's manufacture, but in that year he brought out a pipe specially manufactured for him with a red spot on the mouthpiece similarly placed to the white spot
 30 on the Plaintiff's pipes. Such pipes were marked on the stem with the Defendant's trade mark "Barbic" which was registered in May 1920, they were also marked with the Defendant's firm name and address.

On the 22nd September 1921 the Plaintiff commenced an action against the Defendant firm claiming (1) An injunction to restrain the Defendants their
 35 servants or agents from selling or offering for sale any pipes not of the Plaintiff's manufacture having upon the mouthpiece a spot or other mark or device calculated to represent or lead to the belief that the pipes manufactured by the Defendants were of the Plaintiff's manufacture; (2) Damages; and (3) Delivery up.

By his Statement of Claim the Plaintiff alleged (1) that he was a manufacturer of briar tobacco pipes provided with a removable inner tube designed by him which admitted of the pipes being readily cleaned from time to time as occasion
 40 might require and that such tube was protected by Letters Patent No. 5681 of 1912 belonging to the firm. (2) That the pipes of his manufacture were distinguished by a small white spot placed upon the upper part of the mouth-
 45 piece thereof; that the said mouthpiece was slightly differently shaped on the upper and lower sides thereof respectively and besides distinguishing the pipes of his manufacture the white spot indicated the side of the mouthpiece

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which should be uppermost when the mouthpiece was replaced after being removed for the inner tube to be cleaned. (3) That by reason of the advantages derived from the adoption of the said tubes and the general quality of the materials and workmanship, his said pipes had acquired and enjoyed a wide reputation and were well known in the trade and among members of the public who smoked pipes and the presence of the spot had come to be regarded by all such persons as indicating a pipe of his (the Plaintiff's) manufacture. (4) That he had recently discovered and the fact was that the Defendants (who were also manufacturers of tobacco pipes) were manufacturing and offering for sale briar pipes of the same general character as those manufactured by the Plaintiff and having a red spot upon the mouthpiece substantially in the same position and of the same size as the Plaintiff's white spot. (5) That the spot upon the Defendant's pipes (though differing in colour from the Plaintiff's spot) was calculated to cause and did cause confusion between the pipes of the Plaintiff's and the Defendants' manufacture, and was calculated to lead and did lead to the belief that the Defendants' pipes were pipes of the Plaintiff's manufacture; that the Defendants were in fact endeavouring by placing such a spot on their pipes to take advantage of the reputation enjoyed by the Plaintiff's pipes. (6) That he had requested the Defendants to discontinue the use of such a spot on their pipes but that the Defendants had refused to do so and that they threatened and intended to continue to manufacture and sell pipes having such spot on the mouthpiece and would do so unless restrained by the Court. (7) That by reason of the Defendants' said wrongful acts the Plaintiff had suffered damage.

By their defence the Defendants *inter alia* (1) alleged that the distinctive feature of the Plaintiff's said pipes (if any) was the particular form of the inner tube the subject of the Letters Patent referred to in the Statement of Claim; (2) admitted that the Plaintiff placed a white spot on pipes of his manufacture and that the said spot indicated which side of the mouthpiece should be placed uppermost; denied that a white spot placed on the upper part of the mouthpiece distinguished pipes of the Plaintiff's manufacture and alternatively that if a spot so placed was distinctive of the Plaintiff's pipes (which was denied) such distinctiveness was strictly limited to spots which were small and white; (3) that the use of spots upon pipes and upon the mouthpiece of pipes was and for many years had been common to the trade in the United Kingdom, and that particulars of users of such spots were as follows: (a) Messrs. Frankel* of 119 Queen Victoria Street, E.C. sold pipes bearing a white spot from March 1913 to about 1915. (b) Messrs. Woolf Brothers of 142 Wardour Street W. had sold pipes bearing a spot on the mouthpiece from March 1920 to the then present time. (c) Messrs. F. Charatan & Son, Ltd. of 146 Minories E.C. had sold pipes bearing a spot on the mouthpiece from July 16th 1921 to the then present time. (4) Alleged that the presence of the spot was not distinctive of and did not indicate to the trade or public a pipe of the Plaintiff's manufacture as alleged or at all. (5) Admitted that they were manufacturing and offering for sale briar pipes and that the said pipes had a red spot placed upon the mouthpiece but that the said pipes had no inner tube and were not, as alleged, of the same general character as those manufactured by the Plaintiff and denied, save as in paragraph 4 of the defence expressly admitted, the allegations in paragraph 4 of the Statement of Claim. (6) Denied the allegations in paragraph 5 of the Statement of Claim

* Frankau.

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and alleged that the spot upon the Defendants' pipes was not calculated to cause and never had caused confusion as alleged or at all, and further denied that they were endeavouring to take advantage of the Plaintiff's alleged reputation as alleged or at all. (7) Admitted paragraph 6 of the Statement
 5 of Claim and (8) Alleged that the Plaintiffs had not suffered the alleged or any damage and that they were not entitled to any of the relief claimed.

The action came on for trial on the 29th June, 1922.

Sir Duncan M. Kerly K.C., G. B. Hurst K.C., M.P. and J. H. Stamp (instructed by J. B. and G. S. Burton) appeared for the Plaintiff; and W. H.
 10 Upjohn K.C. and J. Whitehead (instructed by Telfer Leviensky & Co.) appeared for the Defendants.

Sir Duncan Kerly K.C.—This is a passing off action to restrain the Defendants from imitating the get-up of the Plaintiff's goods in such a way that there will be a danger, intended or not intended, that their goods may be taken for
 15 those of the Plaintiff. The Plaintiff's pipes have secured a valuable reputation, they are invariably marked with a spot, a white spot, and the Defendants have elected to put on the market pipes, remarkably like the range of pipes sold by the Plaintiff, marked with a spot, a red spot. The consequence of
 20 the Defendants so marking their goods will be that people will, because of the spot, take the Defendants' goods for a variety of the Plaintiff's goods, even if they know (and some people do not know) that the Plaintiff uses a white spot. The spot is in many cases purely ornamental, it represents a material element in the goodwill of the Plaintiff. It is one thing to have, as the
 25 Plaintiff claims that he has, the only spot, but it is quite another thing to have a white spot among every colour of the rainbow, other people being able to put spots of various colours on their goods. The Plaintiff first put a spot upon the mouthpiece of pipes containing an aluminium tube which he had invented in 1912. At first the public objected to the spot and the Plaintiff gave as an explanation that it served a useful purpose, but later on customers began to recog-
 30 nise the Plaintiff's pipes by means of the spot and the Plaintiff found that had got, possibly without intending it, a distinctive trade mark. In 1916 the Plaintiff designed a particular form of mouthpiece which he registered. In that year his pipes began to be sold all over the world. From 1914 to 1921 the annual output of pipes increased from approximately 41,000 to 276,000. Up to November 1918
 35 the white spot was affixed to all pipes with the inner tube; from that date it was affixed to all of the Plaintiff's pipes. In 1917 one *Barling* put some pipes on the market with a white spot upon them and the Plaintiff commenced proceedings. The action would have been tried in March 1918, when conditions owing to the war were very difficult, and the Plaintiff accordingly served
 40 notice of discontinuance. This was the first challenge to the Plaintiff and has not been pleaded in the present action as one of the prior users. In March 1920 the Plaintiff was again challenged by a firm of *Wolf Brothers*, who issued, and claimed the right to issue, pipes with a silver spot upon the side of the mouthpiece. In their advertisements in the trade papers they drew
 45 attention to the spot in such terms as "our brightest spot." Proceedings were commenced but, after an attempt to prove prior user of white spots by other people, the Defendants consented to judgment for the injunction claimed and full relief with costs.*

* Before Mr. Justice Astbury, not reported.

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About the middle of 1921 the Defendant, who trades under the name of *Bartlett & Bickley*, commenced to sell a pipe with a red spot on the mouthpiece, and, after some correspondence, the Plaintiff commenced the present action. It is a familiar practice for manufacturers to use their distinguishing mark in different colours to distinguish different grades of their goods. [Upjohn K.C.—Is it permissible in this case to take evidence of this? 5
 RUSSELL J.—The evidence seems rather remote, but I do not see how I can stop Sir *Duncan Kerly* in his opening, at all events. Upjohn K.C.—I shall make formal objection to such evidence. RUSSELL J.—Very well. The objection can be taken when the evidence is tendered.] The point is that 10
 the substitution of any distinctive mark in a different colour may well suggest to the purchaser not that it is a different mark, but that it is used by the same maker with its usual significance for a special purpose. It is perfectly true that the Plaintiff puts his name on his pipes, but there are numerous decisions of the Courts to the effect that there is certainly no conclusion of law 15
 that the presence of the defendant's name, even if the plaintiff's name is usually or invariably used on the plaintiff's goods, will prevent infringement or danger of passing off. In fact, as proved in other cases, and will be proved in this case, though many people know the Plaintiff's name, all customers do not, 20
 and quite a large number of customers, some of them ladies, are people who buy pipes as presents and are perhaps not smokers themselves. They do not know anything about the pipe they want except that it has a spot or a white spot on it. There are other ways of marking pipes and one, the "Vacuette" pipe has come to the Plaintiff's notice since the commencement of this action. This has a device, the Egyptian key of life, on the mouthpiece, and it is 25
 used in two different colours, red and white, to denote different qualities or varieties of pipes. The Plaintiff's pipe is sold at one guinea as the lowest price and the Defendant's pipe is sold at 12s. 6d. Evidence will be given of a pipe being asked for as a 12s. 6d. "Dunhill." In most cases, possibly in every case which has come to the Plaintiff's knowledge, the prospective buyer has 30
 discovered on closer examination that the pipe was not really a Dunhill. There is an appreciable risk that people, seeing the Defendant's pipe with the Plaintiff's distinguishing mark on it, notwithstanding that the mark has hitherto been white, will believe that the goods are the Plaintiff's and will not be prevented from falling into that error by the mere difference in the colour 35
 of the marks. The Defendant's mark was intended to deceive; there can be no legitimate reason why, with all the marks in the world which one can imagine open to him, the Defendant should have chosen a spot, or why, with the whole of the pipe uncovered, he should have put that spot, a round spot of approximately the same size as the Plaintiff's, in the position where the 40
 Plaintiff puts it. I suggest that the Defendant hoped that his pipes would sell as "spot" pipes meaning Dunhill pipes, and that he hoped to establish a parasitic trade upon the business and reputation which was already the Plaintiff's. [A large number of orders written to the Plaintiff by customers in which the Plaintiff's pipes were referred to as "white spot pipes," and in 45
 three instances as "spot pipes," were then read.] As to the other prior users pleaded in the action, that by Messrs. *Frankau* was pleaded in the action relating to the *Wolfe* pipe and broke down hopelessly, and that alleged by Messrs. *Charatan* is the subject of pending proceedings.

The following witnesses gave evidence in support of the Plaintiff's case: 50
Herbert Edward Dunhill, brother of the Plaintiff and confidential manager of the Plaintiff's business; *Edmund Fortescue Gange* of the "Follies," Pontchope,

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Herefordshire, a company director and a smoker of pipes of the Plaintiff's manufacture; *Bertie John London*, manager to *Charles Morrison*, tobacconist and pipe dealer, of Newcastle-on-Tyne; *Thomas Sergeant Randy*, manager for *Burbridge and Company*, tobacconists, of 7, Market Street, Nottingham; *William Henry Parsons*, manager of *Finlay & Co.*; *John Persich*, manager of the Empire Theatre, Chiswick, a smoker of Dunhill pipes; *Herbert Stanley Cranfield*, in the employment of a firm of brokers at Lloyds, a smoker of Dunhill pipes; *Benjamin Davis*, retail tobacconist, of 30, Copthall Avenue, E.C.; *Harold Baskett*, claims assessor to the Railway Passengers' Assurance Company, a smoker of Dunhill pipes; *Augustus Martin*, retail tobacconist, London; *Alfred Henry Timms*, of Bedford Park, London, dentist; *Charles Henry Langdale*, Plaintiff's traveller for the district of London and the Southern Counties; *Charles Frederick Roed*, of the experimental department of the Plaintiff's business.

- 15 The following witnesses then gave evidence in support of the Defendant's case: *Vere Frederick Harold*, assistant in the employment of the Defendant; *Charles David Jonas*, carrying on business in Vigo Street, London, under the style of *Bartlett and Bickley* (the Defendant firm); *Charles James May*, assistant manager to *A. Baylin* of 81, Gracechurch Street, cigar merchant and pipe retailer; *Charles Ernest Catrell*, works manager of the *London Pipe Company, Ltd.*, Barking; *Harold William Simmons*, tobacconist and pipe maker, 62, Piccadilly, London; *Samuel Cohen*, wholesale and retail tobacconist, of 120, Newgate Street, London; *Francis Jules de Guingand*, director of *De Guingand and Sons, Ltd.*, pipe merchants, 5, Colonial Avenue, London; *Henry Arthur Sadleir*, manager in the employment of *Erappkin, Ltd.*, tobacconists.

Upjohn K.C. for the Defendant.—The first question and the only relevant question is: Has the Plaintiff satisfied the Court that the Defendant's pipes are so liable to be confused with the Plaintiff's pipes that a person of ordinary prudence, not a fool or an idiot, could be deceived? The Court does not interfere for the benefit of fools or idiots (*Singer Manufacturing Co. v. Wilson*, (1876) L.R. 2 C. D. 434), but only for the protection of the reasonably cautious purchaser (*Seixo v. Provizende*, (1865) L.R. 1 Ch. 192). Applying the principle of *Chivers v. Chivers*, (1900) 17 R.P.C. 420, what the Plaintiff has to prove is that either a person in the trade knowing what the public wants, or a member of the public who has knowledge of the Plaintiff's article, must say: "When I saw the Defendant's pipe the spot on it told me at once, 'That is a Dunhill pipe.'" There cannot be a monopoly in a spot. A spot may be put in just the same category as an ordinary word in the English language. In the previous action in which the Plaintiff was successful against Messrs. *Wolfe* the only relief which the Court would give was "without clearly distinguishing." The Plaintiff's witnesses have practically all said that there are such marks on the Defendant's pipes that they could not be deceived, and the utmost that Mr. *Dunhill* said was, "I imagine a person might mistake it." That is not sufficient, the Plaintiff must show that any spot misleads an ordinary cautious buyer of a Dunhill pipe, and a person who does not know the Dunhill pipe is not within the ambit at all. In this case it is the spot and nothing but the spot, all the other features of the pipe are common. Analysing the evidence, it is clear that the name *Dunhill* is on every pipe that has been manufactured by the Plaintiff, and one common way in which a man who knows of a Dunhill pipe and wants a Dunhill pipe asks for it is to ask for "a Dunhill pipe." A white spot is put by the Plaintiff not only on his pipes

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but on other goods, for example, cigarettes of which he sells ten millions a year and on tobacco of which he sells ten thousand packets a week. The spot has always been white. In the *Wolfe* action the Plaintiff's witnesses suppressed the fact that the pipe was referred to as "the White Spot." In the present action, where some of the same witnesses have been called, the white spot is carefully relegated, so far as its colour is concerned, to the background. It is now "the spot," or "a spot pipe." A purchaser who saw a red spot would at least be put on inquiry and would then look at the pipe and would not see any suggestion of *Dunhill* about it, but would find a fancy brand "Barbie" and the name "Bartlett & Bickley" on it. It is a fair result of the evidence that it is very unusual for a retailer to put his name on a pipe except as an addition to the name of the maker of the pipe. It is the white spot that is the sign manual and hall-mark of the Plaintiff's pipe. The Defendant's spot is red and much larger than the Plaintiff's. The inner tube is conspicuous in the Plaintiff's pipe and is absent in the Defendant's. The mouthpiece in the two pipes are different, and there is no resemblance in the get-up of the box or packing in which the Defendant's pipe is sold. Only fools or idiots could be misled and the Court will not interfere to protect them (*Singer Manufacturing Co. v. Wilson, ubi supra*); the persons to be considered are members of the trade and members of the public who have a certain familiarity with *Dunhill's* pipes, purchasing with ordinary caution (*Seizo v. Provizende* and *Chivers v. Chivers, ubi supra*). As to the evidence of actual deception, all the incidents happened within one month of the trial; there has been no evidence of any incident which happened before the issue of the writ. The surrounding circumstances were such as to focus the purchaser's mind on *Dunhill* pipes, and there were other extraneous inducements to make the purchase, and in the cases where retailers associated the red spot on a pipe with the Plaintiff, the pipes had been brought to them by the Plaintiff's own travellers, and the inference was a natural one. I admit that the Defendant must not put a spot pipe on the market without clearly distinguishing, but I submit that the Defendant has clearly distinguished his pipe and that the Plaintiff's witnesses have in terms admitted it. Dealing with the allegation of fraud on the part of the Defendant, the position on the mouthpiece on which he has placed his spot is perfectly irrelevant if the pipe is clearly distinguished, the Plaintiff has no right to that position as against all the world. A circular spot is the cheapest and most secure way of marking the mouthpiece. The cross-examination of the Defendant showed that he was such a fool that he could not be such a knave as he was represented.

The Plaintiff is not entitled to a monopoly of this cheap, secure and obvious way of distinguishing the upper part of the mouthpiece, it being common ground, as I submit, that it is desirable to mark the upper part. The Defendant is entitled to do so subject to the obligation to distinguish clearly. The Defendant first wished to mark the mouthpiece with a star or diamond and approached the manufacturer saying that he wanted something distinctive and asked for suggestions as to marking. The manufacturer then informed the Defendant that such a mark would be rather an expensive and difficult job and suggested the round spot as being much easier to put on and in the vulcanite. The Defendant suggested the colour. That is not like the action of a fraudulent man who wants to steal another man's trade by getting as near as possible to the well-known mark. As regards having the bore of a pipe made large enough to take a *Dunhill* inner tube, this was done after the *Barbie* pipe had been put on the market owing to complaint having been

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made that the bore was not big enough. The only evidence about this arose out of the cross-examination of the Defendant, and the suggestion that the bore was enlarged for a fraudulent purpose is a mare's nest. There is no monopoly in the size of *Dunhill's* bore. I submit that the Defendant is a
 5 perfectly honest tradesman, that whatever else happens the charge of fraud has failed, and that the Defendant has done his best even according to the Plaintiff's witnesses to distinguish his pipe from Mr. *Dunhill's*.

Sir *Duncan Kerly* K.C. replied.—The existence of the passing-off case and the care with which such a case is always considered by the Court has had
 10 a great and very valuable influence upon English trade, and has gone far to justify the claim that trade here is cleaner and more honest than it is in most countries. This is due to a great extent to the fact that no man is allowed to do what will pass off his goods as those of his rival, either deliberately or even without intending it. That which may be innocent in its incep-
 15 tion becomes fraudulent when the danger is pointed out and if such danger is still allowed to arise from the matter which is found to be or shown to be deceptive. I submit that it is not the law that a plaintiff in an action of this character has got to show that a person who knows all about the goods of the plaintiff, is familiar with their actual appearance and
 20 knows most of the things which might be characteristic of or which are in fact peculiar to them, will be deceived. The questions that the Court must ask itself are, What sort of persons are your hypothetical purchasers to be? What knowledge must you attribute to them? Secondly—In what circumstances are you to suppose that the defendant's goods are or will be offered to them? The
 25 Court has always said, "You, the defendant, shall not offer to retailers things " which will be traps for the unwary; you shall not put into the hands of the " trade means by which an unconscientious or unconscionable retailer may " deceive unwary purchasers." A man who means to deceive wants to get such resemblances as will enable his goods to be sold, and such differences as will
 30 provide him with cover when his practice is discovered. On the one hand he wants to blind the public, and on the other hand he wants to blind the Court. The person to be considered is the unwary purchaser (*Johnston v. Orr Ewing*, (1882) L.R. 7 App. Cas. 219, *Wotherspoon v. Currie*, (1872) L.R. 5 H.L. 508). The hypothetical purchaser must want goods which are in fact the Plaintiff's
 35 and he must have in his mind something which to him identifies those goods as being the Plaintiff's. It is not necessary that he should know who the maker is (*Reddaway v. Banham*, 13 R.P.C. 218; L.R. (1896) A.C. 199, *Montgomery v. Thompson*, (1891) 8 R.P.C. 361.) [RUSSELL J.—Was *Wotherspoon* in fact a trade mark case or was it a passing off case?] Before registration there was
 40 really no distinction between the two, the distinction only became material when certain things, certain only of the *indicia* could be registered, and then registered trade marks only were referred to as trade marks, other things might be called trade names, although they might not have been names, but it has long been appreciated that there may be what is now called a Common Law
 45 trade mark. It is merely something that is distinctive of the Plaintiff's goods. It may be one or more of several things, for example part of the get-up, the name which is on the goods or which has in some way become attached to the goods, or even the shape of the article. In the case of shape it must be remembered that, while a man who has the first user of something which is not
 50 necessary for his rivals may get a monopoly of that use, at any rate to the extent of putting it upon his rivals to distinguish if they use that feature, yet

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if a thing is wanted for other purposes than merely as something which is optional, then the Court is very careful in allowing a monopoly. No man may monopolise for example an ordinary descriptive word which his rival may honestly use, or a shape which his rival may want, without any idea of imitating his goods, because of its function. [*Edge v. Niccolls* 28 R.P.C. 582; L.R. (1911) A.C. 693 was referred to.] Patent monopolies and trade mark monopolies have nothing in common. In the case of patents the position is: Here is something you will want to do, something new and useful, but you must not because the law has said as a reward to the inventor that he alone shall use it for a long time, but in the case of trade marks the position is: Here is something you did not want to do until the Plaintiff did it and now you shall not do it so as to deceive. Before Mr. *Dunhill* adopted the spot the ground was open, anyone could have had one, but now no one can have a spot on a pipe which is liable to be mistaken for his spot. As to the second question comment has been made on behalf of the Defendant that the only instances where there was deception in this case were where the pipe with a red spot was offered in such circumstances as to make it deception. What must be dealt with is not the possible case of a careful retailer who is taking care that customers should not be deceived, but with the possible case of a man who is quite willing to profit by the desire of a customer to buy a *Dunhill* pipe at a cheaper price. It is a substantive part of the Plaintiff's case in this action that the Defendant is here putting into the hands of the trade something that will be a ready means of deception. (*Lever v. Goodwin*, (1887) 4 R.P.C. 492; L.R. 36 Ch. D. 1). Proof of intention to deceive is in no way essential, it is sufficient if the Defendant claims the right to go on, however honest he was at starting. Proof of intent to deceive or willingness to profit by probable deception is practically conclusive in the Plaintiff's favour. [RUSSELL J.—It is strong evidence that the thing is calculated to deceive.] Theoretically it should not be conclusive. *J. B. Williams Co. v. Brownley*, (1909) L.R. 26 R.P.C. 481, 765, is a solitary exception and is an eccentricity and an exception to the general rule. I submit that the Defendant is an untruthful witness, that he came into Court intending to deceive the Court. He has pleaded in this case that he used the spot for a functional purpose to show the top side of the mouthpiece, and has denied that the white spot is distinctive of the Plaintiff's pipes. [RUSSELL J.—The one thing that impressed me was that the cross-examination on behalf of the Defendant was trying its best to emphasise that it was a white spot that the Plaintiff relied on.] It has been pleaded and evidence has been given of the *Durbar* pipe and of the M.P. which disappeared seventeen years ago. The *Wolfe* pipe is also pleaded as a prior user or another user. I submit it is a matter of inference that the Defendant knew that pipe to be a fraud at the time of the pleadings in this action. As regards the interview between the Plaintiff's witness *Roed* and the Defendant, I submit that the Defendant is not to be relied on when he denies that he stated that he intended to put a pipe with an inner tube on the market after the case was over. The inner tube is one of the characteristics of the Plaintiff's pipes, and is one of the things that a retailer would desire who wanted to have a pipe which he thought could be taken for or sold as a *Dunhill*. The Defendant's explanation of the fact that he asked his manufacturer to make the bore of his pipe big enough to take a *Dunhill* tube because he wanted a bigger draught is unsatisfactory. A ridiculous explanation is often a badge of fraud. Why should the Defendant, with all sizes of bores open to him, select the particular bore of exactly the same size

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as the outside of the Dunhill tube? The absence of the inner tube in the Defendant's pipe has been relied on as a material distinction, he admits that he must distinguish yet he has made provision for an additional approximation. The Defendant is a wholesaler as well as a retailer, and the possible effect of the competition in the retail trade generally caused by a cheaper pipe which may be taken for a Dunhill is a matter of very considerable importance. The red spot was not necessary to show the top side in pipes having a flat bottom, the flat portion itself did that, nor is it necessary in the case of a curved mouthpiece. In any case there are many other ways of marking, for example by a stamp on the vulcanite. It is not the whiteness but the spottiness of the Plaintiff's spot which is with some customers material. The evidence shows that there is no room for doubt that the red spot pipe may be taken for a Dunhill's, even though the Plaintiff has hitherto never put anything but a white spot on his pipe. If the spot by itself was a registered trade mark it would be protected by the registration, in all colours.

Judgment was reserved and was delivered on the 31st day of July, 1922.

RUSSELL, J.—The Plaintiff, *Alfred Dunhill*, seeks, in this Action, to restrain the Defendant from selling tobacco pipes not of the Plaintiff's manufacture with a spot on the mouthpiece, upon the ground that the presence of a spot on the mouthpiece of the Defendant's pipes is calculated to lead to the belief that his pipes are pipes of the Plaintiff's manufacture. The Defendant is a person called *Charles David Jonas*, who carries on business in the firm name of *Bartlett & Bickley*.

The Plaintiff is the owner of a large business which in July 1910 was a purely retail business carried on at 31, Duke Street, Piccadilly. In that month he started manufacturing pipes which he stamped with the words "Dunhill, Duke Street, S.W." In 1912 he patented a device for an inner tube which he introduced into his pipes, and about the same time began to put a small white spot on the upper side of the mouthpiece, near the junction with the pipe stem. The white spot (which consists of imitation ivory inserted in the vulcanite) was placed on the pipe with a twofold object, namely, to indicate which was the upper side of the mouthpiece and to distinguish readily the whole pipe. So far as the white spot served any useful purpose its presence would, of course, not be necessary in the case of pipes with curved mouthpieces.

At the end of 1913 the Plaintiff extended his trade in pipes so as to include wholesale trade as well as retail. The Plaintiff's manufacturing business advanced rapidly and at the present time he owns two factories and has some 760 persons in his employ.

Until November 1918 the white spot appeared on substantially all his pipes. Since November 1918 the white spot has appeared on all his pipes without exception. In addition the words "Dunhill, London," are stamped on the wooden stem.

In what may be conveniently termed his trade literature (in which description I include catalogues, price lists, show cards and advertisements) the Plaintiff has spared neither trouble nor expense in identifying his pipes with the white spot. The pipes are sold under "the White Spot guarantee." The white spot is alluded to in catalogues and advertisements as "the famous white spot which is the hall-mark of excellence in pipe workmanship." It is similarly stated that "the little white spot indicating Dunhill's manufacture has come to be recognised by smokers the world over as a sure sign of supreme excellence." The Plaintiff's catalogues have the words "The White Spot" prominently at the foot of every page, and his advertisements

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are surrounded by a frame of white spots. The windows and sun blinds of his business premises proclaim to the world the identity between the white spot and the Dunhill pipe. The white spot appears moreover on the greater number of the Plaintiff's cigarettes and on practically all his packets of tobacco. Of cigarettes he sells about 10,000,000 in a year; of tobacco about 40,000 5 packets a week.

In the result the Plaintiff has successfully and completely identified the white spot with his goods. To quote from the evidence of Mr. *Herbert Dunhill* before me: "The white spot pipe means *Dunhill*. The white spot is quite 10 "distinctive of *Dunhill*. It is the sign manual of the *Dunhill*. The white spot "and *Dunhill* are one and indivisible. The white spot and *Dunhill* are "synonymous." "The white spot is the Alpha and Omega of our advertising."

This is borne out also by the evidence before me as to the manner in which would-be purchasers of the Plaintiff's pipes describe them. The witnesses called before me by the Plaintiff in many cases, in examination-in-chief, did 15 not disclose the real state of affairs, but rather emphasised the cases in which (and it was, they said, principally ladies who did it) customers called the Plaintiff's pipes "the pipe with a spot," or "the pipe with the spot." In cross-examination however they would admit that the ordinary name used for the Plaintiff's pipes (when not simply asked for as a *Dunhill* pipe) was 20 "a *Dunhill* white spot" or "the white spot pipe." Further, in a bundle of over 70 written communications from customers of the Plaintiff, ranging over a period of some four years, only two instances occur of reference to the spot apart from its whiteness. But, even in the case of a customer referring merely to a spot, that customer can only have meant a white spot. 25

I am quite satisfied on the evidence that with negligible exceptions (arising principally when ladies during the war purchased pipes for their absent friends and relations) a person desiring to buy a *Dunhill* pipe who does not simply know it as, and ask for it as, a *Dunhill* or a *Dunhill* pipe, will know it as, and ask for it as, the white spot pipe or under some similar description which includes 30 an allusion to the whiteness of the spot. In other words, the identification mark is not a spot but a *white* spot.

This is amply borne out by Mr. *Herbert Dunhill's* evidence before me, when he told me that the Plaintiff's pipes are almost invariably spoken of as the white spot pipe, and that, except to an extent not worth considering, the ordinary names in the trade and amongst smokers, for the Plaintiff's pipes are "the *Dunhill* pipe," "the white spot pipe," "the *Dunhill* white spot," 35 or "the white spot *Dunhill*." For some mysterious reason the presence of this little white spot has attractions for many smokers. It was introduced by the Plaintiff in 1912, his output of pipes rose from 41,000 for the year ending 30th June 1914 to 276,000 for the year ending the 30th June 1921. His pipes are, as to shape and general appearance, similar to the ordinary briar pipes with which all (including non-smokers) are familiar, except for the presence of the white spot on the mouthpiece; but his lowest price for a briar pipe is one guinea while (according to his catalogues) you may, if you feel so 40 disposed, pay as much as £6 10s. It seems difficult to believe that there should be enough people found in the world in one year and in the present times, of the requisite mental calibre to buy over a quarter of a million of briar pipes at the prices which I have mentioned. But I have Mr. *Herbert Dunhill's* evidence on the point. I must make an act of faith and accept it; 45 but surely if Thackeray had been writing his "Book of Snobs" to-day he would add the "pipe snob" to his collection. 50

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Other pipes have appeared with spots on the mouthpiece. One *Barling* produced a pipe with a white spot. The Plaintiff commenced proceedings to restrain him, but the action was formally discontinued in 1918. The Plaintiff says that no further *Barling* pipes with a white spot have been sold. In 1920 one *Wolf* was selling pipes with a white metal spot. The Plaintiff took proceedings in the course of which, I am told, it appeared that the Defendant was a fraudulent person. Eventually a consent order was made giving the Plaintiff the relief which he desired. In 1912 some 200 gross of a pipe called "the *Durbar*" with a white spot on the side of the mouthpiece were manufactured and placed upon the market in England. A second order was given but not executed owing to the war. The Plaintiff never heard of the existence of this pipe until one was produced in the course of the proceedings against *Wolf*. Reference was also made in the evidence to two other pipes with spots, which existed in former times, namely, the "*M.P.*" and the "*Press*." The "*M.P.*" was a pipe with a patent mouthpiece which opened on a rivet like a pair of scissors, the white metallic ends of the rivets forming white spots on the mouthpiece. About the "*Press*" I know little.

These are all the pipes with spots (other than the Defendant's pipe) about which the evidence tells me, with the exception of another red spot pipe called the "*Eversweet*," and a blue spot pipe, as to both of which proceedings are pending.

It would, I think, be correct to say that at the time when the Defendant placed his pipe upon the market the only pipe then on the market bearing a spot on the mouthpiece was the Plaintiff's white spot pipe.

Let me now say something of the Defendant, and the pipes of which the Plaintiff makes complaint. Mr. *Jonas* originally carried on business as a cigar merchant but in 1901 he purchased the business of a firm called *Bartlett & Bickley*. He sold pipes of other persons' manufacture. In May 1920 he registered the name "*Barbic*," a name obviously composed of the first syllables of his firm names; and determined to bring out a pipe under the name of "*Barbic*." He consulted Mr. *Gatrell*, the manager of the *London Pipe Company*, who were to manufacture the pipes; I will refer to the evidence in more detail later on, but at the moment it is sufficient to say that the pipes complained of were produced as the result of those consultations. They were put on the market in September 1920. In shape, size, and general appearance they are just like any other briar pipes, whether made by the Plaintiff or anyone else. They have on one side of the stem in clear script letters the word "*Barbic*" and on the other side in clear block letters the words "*Bartlett & Bickley*, 8, *Vigo Street*, W." They have on the top side of the vulcanite mouthpiece a spot (appreciably larger than the *Dunhill* white spot) and its colour is unmistakably red. The price is 12s. 6d.

Comparing the Plaintiff's pipes with the Defendant's pipes, it is evident that (apart from matters common to all briar pipes) the only point of similarity is that each has a spot on the top side of the mouthpiece; but the Defendant's spot differs from the Plaintiff's spot in the only respect in which two spots could differ from each other, namely, size and colour.

The Plaintiff, however, objects to the presence of the red spot. His case is, and must be, that the presence of any spot will indicate or suggest that the goods are of his manufacture. True it is that his pipes (when not merely known as *Dunhill* pipes) are known as white spot pipes, true it is that he has

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never put any spot on his pipes but a white spot, nevertheless he says people may be deceived into thinking that the red spot is a new Dunhill spot indicating a different grade of Dunhill goods. That is to say that the hypothetical purchaser in whose mind the Plaintiff's pipes are identified with a white spot only, and who sets out to buy and desires to buy a pipe with a white spot only, will be induced to buy a pipe which has not a white spot but a red spot, upon the footing that, though not the goods which he was seeking to buy, they are the goods of the same manufacturer. I must not, of course, form an unaided opinion whether such a contingency is likely to happen; I must form my opinion in the light of the evidence adduced before me.

Now the principles which govern passing off cases are clear. Apart from monopolies conferred by Patents, and apart from protection afforded by registration, it is open to anyone to adopt the ideas or devices of his neighbour and apply them to his own goods provided he clearly distinguishes his goods from those of his neighbour.

What amounts to clear distinction depends upon the facts of each case. If a device is exactly imitated, it may well be that in some cases it will be impossible to make the requisite clear distinction, for instance it may be that with the presence of a white spot on his pipes' mouthpiece it would be impossible for a trader clearly to distinguish his goods from the Plaintiff's. Further, initial fraudulent intent on the part of the Defendant is not a necessary ingredient for the success of a passing off action.

In the present case initial fraud, though not charged in the Pleadings, was charged at the trial, the basis of the charge being a conversation alleged to have taken place within a few days of the commencement of the trial. I will deal with this at once.

A Mr. *Roed* was called by the Plaintiff and he deposed to a conversation alleged to have taken place between himself and the Defendant in the latter's shop on the 20th June, 1922, in the course of which the Defendant said that when this case was decided they were putting a patent pipe on the market with a tube. The suggestion was that this was evidence of a deliberate fraudulent intent further to imitate the Plaintiff's goods and to facilitate the passing off of the Defendant's pipes as the Plaintiff's pipes. Mr. *Roed* gave his evidence on the 3rd July and stated that he had on the same day as the interview dictated a note of the interview, but that the transcript of the shorthand notes could not be found. It was suggested to him in cross-examination that nothing was said at all about a pipe with a tube. The Plaintiff's case was then closed and on the same 3rd July an assistant from the Defendant's shop, who was in the shop at the time of the conversation, was called, a Mr. *Harold*. He said he remembered nothing mentioned about patent pipes nor was anything said in his presence with regard to a tube; nor was any mention made of this case. When pressed, this witness once or twice went so far as to say that he must have heard the material portions of the conversation, but he admitted that he had moved a little distance away for the purpose of packing up and wrapping up some ten pipes which Mr. *Roed* had purchased.

The Defendant was called the same day but was not asked any questions about the interview until the following morning. In the meantime the missing transcript was found and was produced and read out by Sir *Duncan Kerly* immediately on the sitting of the Court. It confirmed Mr. *Roed*'s evidence

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in many respects. The evidence of the Defendant was then resumed. His evidence upon this point really only differs from that of Mr. *Roed* in this, that the Defendant says that he told Mr. *Roed* that he was contemplating putting a pipe on the market with a patent tube "later on." The Defendant
 5 may, in fact, have used the words "after the case was decided," or that may have been Mr. *Roed's* interpretation of the phrase "later on." Both Mr. *Roed* and the Defendant appeared to me to be saying what they believed to be true upon this point; but, even assuming Mr. *Roed's* version to be quite accurate, the conversation appears to me far too slender a basis upon which
 10 to construct a charge of fraud.

I am satisfied upon the evidence of the Defendant and of Mr. *Gatrell* that a red spot was placed upon the Defendant's pipes with no thought or intention of confusing the Defendant's pipes with the Plaintiff's pipes. Their evidence shows: (1) That the Defendant's original idea was to place upon the top of
 15 the mouthpiece a distinctive mark such as a square or a star or a diamond. (2) That Mr. *Gatrell* pointed out that it would be a rather difficult and expensive job to do that. (3) That such a mark involves stamping, which would render any inserted substance liable to fall out. (4) That Mr. *Gatrell* was the person who suggested a spot. (5) That the hole for a spot is drilled
 20 and the inserted substance is not liable to fall out. (6) That the Defendant suggested that the spot should be red. (7) That the Defendant had the Dunhill pipe in his mind and (8) That he selected the red colour in order to distinguish his pipes from the Dunhills. I accept the evidence of these two witnesses upon these points. Whether the red colour effects a sufficient
 25 distinction is, of course, another matter.

One further matter I mention for the purpose of dismissing it. There was at one time during the trial a further suggestion of fraud on the part of the Defendant upon the ground that at a later stage he caused the bore of his pipes to be enlarged so as to be capable of receiving a Dunhill inner tube.
 30 There is no foundation for this suggestion, which arose from a confusion between the wording of Counsel's question and the wording of the Defendant's reply. The Defendant had received complaints that the bore of his pipes was insufficiently large, and he merely instructed the manufacturers to enlarge the bore, taking the Dunhill pipe as an instance of the size required. There
 35 is no foundation for any suggestion against the Defendant in this regard.

I now turn to the question of deception or likelihood of deception.

The Defendant's pipe has been on the market now for nearly two years, namely, since September, 1920. The writ was issued a year later, namely, on the 22nd September 1921. No case of deception had occurred in that year;
 40 at all events no case of deception was alleged before me to have occurred earlier than May 1922. It is true that one witness (*Parsons*) stated that in June or July 1921 he saw one of his customers smoking a pipe with a red spot on the mouthpiece and he said that he "thought it probably might have been a Dunhill pipe." That is all. He had no conversation with the
 45 customer about it nor did he handle the pipe. There is nothing to show that the pipe was a pipe of the Defendant's. All the other incidents deposed to occurred in May or June 1922. I will refer to the evidence in detail but I may state that in no single case was I satisfied that the alleged mistaking of the Defendant's pipe for a pipe of the Plaintiff's manufacture, by reason
 50 of the spot, was satisfactorily established. Either I was not satisfied that deception, in fact, took place, or else the alleged deception was brought about, or materially assisted, by other circumstances. It is certainly remarkable,

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if confusion is likely to result, as the Plaintiff suggests, that in the course of nearly two years no clean case has been forthcoming of an intending purchaser of a Plaintiff's pipe finding himself deceived, by reason of the red spot, into buying a Defendant's pipe and communicating with, and making complaint to, the Plaintiff.

I pass over the first witness of this class, Mr. *Gange*. Each side treated his evidence with the merriment which it deserved. In addition to that witness eight witnesses were called, four from the trade and four from the public.

Mr. *London*, a gentleman in the trade, was shown one of the Defendant's pipes by a representative of *Dunhill* who asked him what he thought of it. In those circumstances it is possible to understand that a pipe produced by *Dunhill's* representative should suggest to Mr. *London* that it was a *Dunhill* pipe. Mr. *London*, however, declared that he thought it was a cheaper grade of *Dunhill* pipe because he associated the red spot, and would associate any coloured spot, with *Dunhill*. He further told me that having seen "*Barbie*" and *Bartlett & Bickley* on the pipe he thought that *Dunhill* was manufacturing an inferior pipe for someone else, that *Dunhill* had omitted his name in order to conceal from the public that the pipe was of *Dunhill* manufacture, but that he had put on the pipe a mark which at once identified the pipe as being of *Dunhill* manufacture. I cannot place much reliance upon a witness of his mentality. I am not satisfied that the impression of *Dunhill* origin arose from any cause beyond the fact that the pipe was produced by a *Dunhill* representative.

Mr. *Randy* was another trade witness. He, too, had a pipe of the Defendant's shown to him by a *Dunhill* traveller who, he thought, had come in on business. He thought it might be a pipe of *Dunhill's* manufacture; but as soon as he saw the names of *Bartlett & Bickley* on it he said: "I naturally came to the conclusion then that it would not be a *Dunhill*." He also seemed to have thought that *Dunhill* wished to conceal his connection with an inferior pipe by omitting his name therefrom and yet placing thereon a spot which must identify it with him. He stated however that most people in the trade, seeing *Bartlett & Bickley's* names on the pipe, would know that they were not *Dunhill's*. The same remarks apply to this witness as to Mr. *London*.

Mr. *Benjamin Davis* was another trade witness. He, too, was shown one of the Defendant's pipes by a representative of *Dunhill*. He said that at first sight, before he handled the pipe, he thought *Dunhill* had decided to bring out a pipe with a red spot of a different quality. He was then asked: "Why did you think it was a *Dunhill* pipe that was being shown to you?" His answer was: "In the first place it was shown to me by a *Dunhill* representative, and it appeared to be exactly the same." "It appeared in every shape and form to be a *Dunhill* pipe, except the red spot." Further he said: "I asked to see the pipe and examined the pipe, and I saw it was just an ordinary pipe with just a red spot. I saw it was not a *Dunhill* immediately." In cross-examination he said: "I thought it was a *Dunhill* pipe seeing it came from a *Dunhill* representative." Comment is superfluous upon this evidence, as evidence of deception caused by the red spot.

Mr. *Martin*, another trade witness, was shown one of the Defendant's pipes by *Dunhill's* sales manager in *Dunhill's* show rooms. The sales manager held it up and Mr. *Martin*, thinking he was going to be asked to stock it or do business, said: "What is this, a new grade, cheaper or dearer?" He was then told it was not a *Dunhill*, and to use his own words: "I examined the

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" thing more closely and, of course, I could see it was not." That exhausts the trade witnesses, and, in my opinion, the Plaintiff has wholly failed to show any likelihood of deception in the trade.

I now turn to the evidence of members of the public. Four only were
5 called to testify to cases of alleged actual deception; four in a period of nearly two years.

Mr. *Persich*, an old smoker of Dunhill pipes, manager of the Empire Theatre, Chiswick, went into a tobacconist's shop on business connected with his theatre, but with no idea of buying a pipe. The shop was an agency for
10 his theatre. He saw one of the Defendant's pipes marked 12s. 6d. and bought it. When he was receiving change for the £1 note he had paid, he asked: " How long is it since *Dunhills* have had the red spot on their pipes?" The tobacconist replied that it was not a Dunhill. The witness admitted that he always asks for the Plaintiff's pipes as Dunhill pipes or Dunhill white
15 spots; and that, in his mind *Dunhill* was always associated with the white spot and no other. When asked whether he ought not to have made enquiries from the shopman, the witness made this curious reply: " No, not considering the state of mind that I went into the shop in." It then turned out that, to use his own words, " it was not a matter which concerned me
20 " much, because the purchase of the pipe was a sprat to catch a mackerel." He wanted to make a purchase to propitiate the tobacconist for business purposes. " Seeing the pipe and realising that it was just the sort of pipe " that I would like, I thought that will provide a good excuse for going in " to see Mr. *Broadwood*," and he added that it did not really matter what
25 sort of sprat he used as a bait for his mackerel. I cannot accept this occurrence as evidence of a man really wanting and meaning to buy a Dunhill pipe and being deceived.

Mr. *Timm*'s evidence arose out of the same incident. He is a friend of Mr. *Persich*. He does not smoke Dunhills himself, but his friends, including
30 Mr. *Persich*, do. Most of his friends, he said, smoke the pipes and they always make a note about the white spot on the pipe; they belong to what was called the White Spot Brotherhood. He thought that Mr. *Persich*'s new purchase was " a new stunt of *Dunhill's*." This witness, seeing his friend, who always smoked *Dunhill's* pipes, smoking this one may well have thought
35 that his new pipe was a Dunhill also.

Mr. *Cranfield* was the only capture affected by a trap laid by the Plaintiff for the purpose of obtaining some evidence of deception for the purposes of this trial. At the request of the Plaintiff, Mr. *Parsons* arranged a display of pipes in his shop in the Earl's Court Road. A reproduction of the display
40 was produced to me. It consisted of six pipes fixed by clips to a glass shelf; three were *Dunhill's* and three were pipes of the Defendant. No other pipes were on the shelf. Each pipe had a circular price ticket sticking out of the bowl. The price tickets were exactly similar, except that the price of the *Dunhill's* was shewn as 21s., and the price of the Defendant's pipes was shewn as 12s. 6d. Mr. *Cranfield's* eye was caught by the display in
45 the shop window and he thought at first that the red spots were a cheaper brand of *Dunhill's*. He entered the shop and asked to see the 12s. 6d. *Dunhill's*, but was, of course, told that they were not *Dunhill's*. He did not handle the pipes. It seems to me that this trap was too well baited

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to be of assistance in proving deception. The witness sees, as it were, a shelf set apart for six pipes, side by side, three of which he at once knew as *Dunhill's* from the white spot. The display, as he said, got his mind on the Dunhill pipe, and with that frame of mind I can imagine that he thought that this display with similar tickets was a display of different Dunhill pipes. Indeed, I can well imagine that any pipe admitted to this private enclosure might at first sight (and whether spotted or spotless) be taken for a Dunhill. On a subsequent visit to the Plaintiff's solicitor Mr. *Cranfield* was again shewn a pipe with a red spot which he again said he thought was a Dunhill, but his evidence as to this was contradictory and unsatisfactory.

The last remaining witness of this class was Mr. *Baskett*, who saw in a shop window in Kingsway some pipes with a red spot, marked 12s. 6d. He entered the shop and said he wanted to buy a pipe for a friend. The shopman shewed him two Dunhills. He asked: "Have you not got one there with a red spot?" He was shown one and he again asked the price "to make sure." Having bought it he asked: "This is a Dunhill pipe, is not it?" because he was a little doubtful about it. He was told it was not a Dunhill. He then said it was a beastly crib—but as the pipe answered his purpose he took it away. I am not satisfied that this witness was really deceived. He himself admits he was doubtful about it. I think the true result of his evidence is that as he was only buying a pipe to give away, he did not really care whether it was a Dunhill or not. He admits that had he examined the pipe he would have known it was not a Dunhill.

That concludes the evidence of deception. It strikes me as meagre, but it apparently is the only evidence which can be produced in respect of the months which have elapsed since September 1920. Nor am I surprised that no better evidence is forthcoming; and that for two reasons: (1) The *Dunhill* customers are not drawn from an uneducated or humble class of life. They are persons prepared to pay Dunhill prices. The habits of purchasers of pipes were described to me by Mr. *Martin*, one of the Plaintiff's witnesses. As a rule they examine the pipes they are buying quite carefully, especially when they are examining a better class pipe. That is the case especially with men; though ladies are not so careful. A would-be purchaser of a Dunhill must, I should imagine, necessarily fall within this rule. (2) The rival pipes (except that each has a spot and, except for the features in which they must necessarily be alike) are quite different. I have already pointed out that the spots differ distinctly in the only two respects in which spots can differ. In all other respects the pipes differ completely.

When all is said and done, I am asked to hold on the evidence that a pipe with a large red spot bearing the words "*Barbic*" and "*Bartlett & Bickley*, 8, Vigo Street, W." distinctly on the stem is likely to deceive a purchaser who means and intends to buy a pipe with a smaller white spot and with the words "*Dunhill, London*" distinctly on the stem. I am unable to do so. The only point of similarity is a spot. The Plaintiff's case rests on the spot and on nothing else. He is, in fact, asking for a monopoly in all colours of the spot. After having dinned into the ears of the public that what earmarks his goods is a white spot, he now claims that any spot on the mouthpiece will indicate goods of his manufacture. Such a claim is, in my opinion, ill founded.

Reliance was placed upon the fact that in the tobacco trade (as, indeed, in others) different classes of goods are wrapped in and distinguished by different

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coloured labels. That is to say, the label with the design or device on it is printed on different coloured paper; but the design or device remains the same. In such cases the colour of the paper does not indicate origin. The design or device which remains unchanged indicates the origin: the different colours of
 5 paper merely indicate different classes of goods of the origin indicated by the design or device, though not necessarily different prices.

Two pipes were put in evidence, "Vacuette" pipes with the same mark on the top of the mouthpiece but in different colours, and the gentleman who bought them on the 12th June 1922 told me that he paid different prices for
 10 them. These are put forward as an instance of the same device in different colours indicating pipes of the same origin at different prices. It is so, I agree, but so far as I can gather they are quite recent apparitions on the market. A solitary and recent instance of the kind does not establish any custom or practice of that nature.

15 The evidence falls a long way short of justifying a claim that where, as was the case of the Plaintiff's pipe, the essence of a mark or origin is its particular colour, a similar mark of a wholly different colour will indicate the same origin.

It was further pointed out that retailers sometimes stamp their names on the stem of a pipe; and that accordingly the presence of a name on the pipe
 20 does not necessarily mean that it is the name of the manufacturer. That may be so. But the name *Dunhill* appears on all the Plaintiff's pipes and is never omitted nor obliterated, even though a retailer's name may occasionally be added.

The evidence leads me to the following conclusions. If a would-be purchaser
 25 of a Plaintiff's pipe knows it simply as a Dunhill pipe, the presence of the words "Barbic" and "*Bartlett & Bickley*, 8, Vigo St.," on the Defendant's pipe will clearly show that it is not a Dunhill pipe. If he knows it as "White spot pipe" or some similar description, the presence of a Red Spot on the Defendant's pipe will clearly show that the pipe is not a White Spot pipe.
 30 If he knows it as a Dunhill White Spot pipe, or a White Spot Dunhill, the presence on the Defendant's pipe of a red spot and the words "*Bartlett & Bickley*, 8, Vigo St., W." will clearly shew that the pipe is not a Dunhill White Spot pipe or a White Spot Dunhill. The cases where, notwithstanding the Plaintiff's efforts, it was known as a "spot" pipe or some similar description
 35 which omits a specific reference to the whiteness of the spot, are few and negligible; but even in these cases the description necessarily meant and involved that the pipe which it was desired to purchase was a pipe whose distinctive feature was a white spot.

The action fails and is dismissed with costs.