

immortalise that goodwill. To my mind the onus is on the plaintiffs to show that the goodwill of the old 'Evening Telegraph' is still unattractive force that would come into active operation if the defendants call their evening paper the 'Evening Telegraph'. I do not think they have discharged that onus.³⁵

In this context it is perhaps worth stressing that compliance with the *Registration of Business Names Act 1963* gives a person no proprietary rights in the name thus registered. Moreover, section 14(3) makes it plain that registration of a name under the Act does not authorise the use of the name if apart from that registration its use could be prohibited.

Businesses Not Trading in the State

The fact that a plaintiff's business does not trade in the State will not be a reason for denying it a remedy for passing off with regard to the use of its name, where it has acquired a goodwill in the State. In *C. & A. Mader v. C. & A. (Waterford) Ltd.*,³⁶ the Supreme Court strongly endorsed this proposition. The plaintiff company carried on a retail clothing business in a chain of 65 shops throughout Britain and Northern Ireland. The Belfast shop attracted many customers from the Republic, and the company advertised extensively on television and in newspapers which reached many people in the Republic. It did not, however, actually carry on business in the Republic.

In permitting an action for passing off, Henchy J. stated:

"Goodwill does not necessarily stop at a frontier . . . What has to be established for the success of the plaintiff's claim . . . is that by his business activities - be they by direct selling within the State or otherwise - he has generated within the State a property right in a goodwill which will be violated by the passing-off."³⁷

Kenny J. drew a distinction between passing off by the use of a name and passing off by the use of a given mark or get up. In the former case, a plaintiff could sue even though none of its products were on sale in the State; in the latter case it would be necessary to show that the disputed mark or get up had become by user in the State distinctive of the plaintiff's goods, so that the use of that mark or get up in relation to any goods of the kind dealt in by the plaintiff would be understood by the trade and the public here as meaning that the goods were the plaintiff's.³⁸

³⁵ *Id.*, at 628.

³⁶ [1976] I.R. 198 (Sup. Ct., aff'g High Ct., *Farley P.*, 1974).

³⁷ *Id.*, at 212. See also *Ramsay v. Nicol* [1939] V.L.R. 336, *Perinian Real A Co. Ltd. v. Budget Rent A Car Systems (1970) Ltd.* [1987] 2 N.Z. L.R. 395 (C.A.), and *Guinness, Carrying On Passing Off*, 3 Sydney L. Rev. 224, at 230-232 (1974).

³⁸ [1976] I.R. at 215-216.

the Courts arose in *Ragget v. Findlater*,³³ where it was held that a brewer accustomed to putting on the label of his bottles and words "nourishing stout" had no monopoly to this expression.

The assignee of a trade name is not debarred from seeking compensation for passing off in respect of that name even though the assignee has not in fact used the name subsequent to the assignment. It is always possible that the goodwill attaching to the name will have retained sufficient potency to be damaged even after a period of non-use. But the fact, or probability, of this damage must be established before an injunction will be ordered. Thus, in *"Independent" Newspapers Ltd v. "Irish Press" Ltd*,³⁴ in 1932, Meredith J. refused to grant a *quia timet* injunction against the defendant company, who had declared their intention of publishing the "Evening Press" under the title of the "Evening Telegraph". The plaintiff company had been assigned that title seven years previously from the "Freeman's Journal" which had published an "Evening Telegraph" for several years, the paper enjoying a large and steady circulation. The plaintiff company had never used the name for any of their publications.

Meredith J., in dismissing the plaintiffs' application, said:

"Property in the name of a business does not exist in the name *per se* but only *per accidera*. Hence if a firm discards a name that has no attractive force save as a good name, another has as much right to adopt it as to take vacated business premises for the purpose of carrying on a similar business therein. Many firms use names included to suggest the specific virtues of their goods and many such names have become household words. The rights acquired in respect of such names are, however, acquired by virtue of use and as indicating that the goods are the goods of the firm, and do not attach to the name as an appropriate and suggestive name. So the name, 'Evening Telegraph', may suggest the latest political news or sporting intelligence, but if it is only calculated to draw away custom from [the plaintiff's paper] the 'Evening Herald' by attractiveness of that kind the plaintiffs can have no grievance by reason of the defendants adopting the name . . . The exclusive right of the plaintiffs to the name 'Evening Telegraph' cannot survive the extinction of the goodwill of the old 'Evening Telegraph' as a practical reality. The conveyance of 1925 did not

³³ L.R. 17 Eq. 29 (1873). Cf. *Grand Hotel Co. of Caledonia Springs v. Wilson* [1904] A.C. 103, *Fels v. Hedley*, 20 T.L.R. 69 (1903). Cf. *Griffin v. Kelly's Strand Hotel*, unreported, High Ct., McWilliams J., 24 January 1980 (1970-7608P) (interlocutory injunction granted in respect of use of hotel name). Where a surname is adopted so as to cause confusion liability will generally follow: cf. *Dockrell & Co. v. Dockrell & Co.*, 75 T.L.R. 226 (High Ct., 1941), where Black J. conceded (at 227) that if the defendants had actually possessed the same surname, "the position might be considerably more difficult, because it might be said that they were entitled to the use of their own name, even though the result should be to confuse". See also *Valentine v. Valentine*, 31 L.R. (Ir.) 488 (Porter M.R., 1892), *Jamieson v. Dublin Distillers Company* [1901] 1 L.R. 43 (Chatterton V.-C., 1899), *Dickson (Alex.) & Sons Ltd v. Dickson (Alexander) & Sons* [1909] 1 L.R. 105 (C.A.). On this point generally see further CLERK & LINDSELL, *TRADE-MARKS*, 26 N.I.L.Q. 177 (1975).

³⁴ [1932] 1 L.R. 615 (High Ct., Meredith J.)

working on a new dairy spread, the judge observed that it was "axiomatic" that in most passing off actions damages would be an inadequate remedy for a successful plaintiff. An "additional factor of considerable importance" in this context was that the plaintiffs had been responsible for introducing a butter substitute on to the Irish market. They had informed the public that it was made from *fresh cream* and vegetable oil. The defendants' product was made from *butler* and vegetable oil, though they had said it was the same as the plaintiffs'. It was "quite impossible" to calculate what damage this might do to the reputation of the plaintiffs' product. An interlocutory injunction would not exclude the defendants from the market until the full trial of the action, since they could obtain an alternative form of packing within eight to ten weeks.

Future Developments

It is possible that the action for passing off may yet develop into a broader tort of misappropriation of business reputation.⁴⁸ The present limitations may be considered in some respects arbitrary. Why should traders but not private individuals have a right of action? Why should the tort not cover all cases of the wrongful invasion, for economic gain, of another's name or personality?⁴⁹ Should not there be compensation for invasions of dignitary and privacy interests?⁵⁰

Courts in the United States⁵¹ have extended tort law into these areas, under the rubric of unfair competition⁵² rather than passing off. An Australian decision⁵³ also favours this approach. In *Cudbury-Schweppes Pty Ltd v. Public Squash Co. Pty Ltd*⁵⁴ a claim on these lines was not pursued

⁴⁸ p. 7 of Costello J.'s judgment.

⁴⁹ *Id.*

⁵⁰ *Id.* See also *Player & Wills (Ireland) Ltd v. Gallagher (Dublin) Ltd*, unreported High Ct., Barton J., 26 September 1983 (1983-NO. 6196P). *Three Stripe International v. Charles O'Neill* [1989] I.L.R.M. 124 (High Ct., Costello J., 1988). *Denckert GmbH v. Fibrotal Service Ltd.*, High Ct., Costello J., 13 May 1988. *Dalepak Foods plc v. Freeman Daily Pack Ltd.*, *supra*, n. 28.

⁵¹ Cf. *Henderson v. Radio Corporation Pty Ltd* [1966] N.S.W.R. 576.

⁵² Cf. Fraser, *Appropriation of Personality - A New Tort*, 99 L.Q. Rev. 381 (1983) (a comprehensive recent analysis). See also Vaver, *What's Mine Is Not Yours: Commercial Appropriation of Personality under the Privacy Acts of British Columbia, Manitoba and Saskatchewan*, 15 U.B.C. L. Rev. 241 (1981); Teece, *Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 Tex. L. Rev. 637 (1973); Gordon, *Right of Property in Name, Likeness, Personality and History*, 55 Nw. U.L. Rev. 553 (1969); *Kraus v. Chrysler Canada Ltd*, 40 D.L.R. (3d) 15 (Ont. C.A., 1973); *Athans v. Canadian Adventure Camps Ltd*, 80 D.L.R. (3d) 583 (Ont. High Ct., Henry J., 1977); cf. *Canada Safe-way Ltd v. Kenioba Food & Commercial Workers Local 802*, 25 C.C.L.T. 1 (Man. C.A., 1983), analysed by Vincent, *id.*, at 10-18 (appropriation of symbol).

⁵³ Cf. Blount, *Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser*, 39 N.Y.U. L. Rev. 962 (1964).

⁵⁴ Cf. PROSSER & KEETON, 1013-1023, Chafetz, *Unfair Competition*, 53 Harv. L. Rev. 1289 (1940), *Handker, Fake and Misleading Advertising*, 39 Yale L.J. 22 (1929).

⁵² *International News Service v. Associated Press*, 248 U.S. 215 (1918).

⁵³ *Hecaton Pty Ltd v. Australian Broadcasting Commission* [1976] R.P.C. 621.

⁵⁴ [1981] 1 All E.R. 213 (P.C., 1980).

In the later decision of the Supreme Court, in *Adidas Sportsschuhfabriken Adi Dassler K.A. v. Charles O'Neill & Co. Ltd.*,³⁹ the majority endorsed this approach. The plaintiff, who manufactured sportswear with a distinctive triple stripe, claimed that the use by the defendant of a triple stripe design constituted passing off. The trial judge was not satisfied that the plaintiff had established in the State an exclusive association of this design with its garments; he found that no confusion had been caused. The majority of the Supreme Court came to the same conclusion. O'Higgins C.J. noted that, if the complaint had been that the name "Adidas" (or a name similar to it or an imitation of it) had been used in association with the defendant's goods, although no Adidas products were on sale in this country, he had no doubt that a goodwill and a potential in relation to customers would have been established and protection given:

"We are dealing, however, not with a well known name but with a particular design and its exclusive association with the goods of Adidas in Ireland must be established if the claim made is to succeed."⁴⁰

"Irreparable Damage" in Injunction Proceedings for Passing Off

In proceedings for an interlocutory injunction for passing off, the plaintiff must show that he would suffer irreparable damage if the injunction was not granted. But this requirement does not appear to be too stringently applied. In *Polycell Products Ltd v. O'Carroll and Others* *via* Dillon, O'Carroll, J. stated:

"The expression . . . means that the injury which is to be expected, if an injunction is not granted, would be material and one which could not be adequately remedied by damages. No one can tell what damage will result from a successful passing off of goods. It is impossible to prove what customers are lost. Further, the person 'passing off' goods may build up his trade on the reputation and advertising of his rival. Injury of that nature is almost impossible to assess in damages."

This approach suggests that the Court will lean towards granting an interlocutory injunction in "passing off" actions, at all events where the plaintiff's conduct is beyond reproach.⁴²

In *Mitchelstown Co-operative Agricultural Society Ltd v. Goldenvale Food Products Ltd.*,⁴³ where, as has been mentioned,⁴⁴ Costello J. granted an interlocutory injunction against the use of a form of packaging and

³⁹ [1983] I.L.R.M. 112 (Sup. Ct., 1982; O'Higgins C.J. and Hederman J., dissenting).

⁴⁰ *Id.*, at 117.

⁴¹ [1959] Ir. Jur. Rep. 34, at 39 (High Ct., Budd J.).

⁴² See *Valentine v. Valentine*, 31 L.R. (Ir.) 488 (Porter M.R., 1892). Cf. *Akjeselskabet Joul v. Waterford Ironfounders Ltd.*, Unreported, High Ct., McWilliam J., 3 November 1977 (1977-NO. 4377P).

⁴³ Unreported, High Ct., Costello J., 12 December 1985 (1985-9460P).

⁴⁴ *Supra*, p. 548.

unfair competition in trade principally in this that, instead of selling its own goods as those of complainant, it substitutes misappropriation in the place of misrepresentation, and sells complainant's goods as its own.⁵⁵

The development of such a tort has not escaped judicial criticism in the USA itself.⁵⁶ It has also been criticised in Australia.⁵⁷ Their Lordships prefer to express no opinion on it in a case such as the present where the facts do not require that it be considered.⁵⁸

Since *Pub Squash* was decided the High Court of Australia has decisively rejected a general action for unfair competition.⁵⁹ In spite of these authorities, the outcome of an Irish court's deliberation on the underlying policy issues is far from certain.⁶⁰

⁵⁵ *Cling Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118 at 140 (1905).
⁵⁶ *Cling Learned Hand J.*, in *Cherry Bros v. Doris Silk Corp.*, 35 F.2d 279 (1929).
⁵⁷ *Cling Victoria Park Reading and Recreation Grounds Co. Ltd v. Taylor* 8 C.L.R. 479 (1937), and, in particular, the criticism offered by Dixon J. at 508-509.
⁵⁸ [1981] 1 All E.R., at 218-219. Cf. *Institut National des Appréhensions d'Orpèbre des Yvins et Faur-de-Vie v. Andres Wines Ltd*, 40 D.L.R. (3th) 259, at 260 (Ont. High Ct., Dupont J., 1987).
⁵⁹ *Moorgate Tobacco Co. Ltd. v. Philip Morris Ltd.* (No. 2) 156 C.L.R. 414 (1984).
⁶⁰ See Terry, *Unfair Competition and the Misappropriation of a Competitor's Trade Values*, 51 *Modern L. Rev.* 296, at 306-319 (1988).

before the Privy Council.⁵⁵ Nevertheless, the tenor of the Judicial Committee's judgment was not supportive of recognition of a right of action for unfair competition outside the conventional parameters of misappropriation of the plaintiff's goodwill. Lord Scarman, speaking for the Committee, said:

"The width of the principle now authoritatively recognised . . . is . . . such that the tort is no longer anchored, as in its early nineteenth century formulation, to the name or trade mark of a product or business. It is wide enough to encompass other descriptive material, such as slogans or visual images, which radio, television or newspapers advertising campaigns can lead the market to associate with a plaintiff's product, provided always that such descriptive material has become part of the goodwill of the product. And the test is whether the product has derived from the advertising a distinctive character which the market recognises."

But competition must remain free; and competition is safeguarded by the necessity for the plaintiff to prove that he had built up an 'intangible property right' in the advertised descriptions of his product, or, in other words, that he has succeeded by such methods in giving his product a distinctive character accepted by the market. A defendant, however, does no wrong by entering a market created by another and there competing with its creator. The line may be difficult to draw; but, unless it is drawn, competition will be stifled . . .

The appellants' alternative case of unfair trading irrespective of whether the market was deceived or confused into mistaking the respondent's product for that of the appellants' need not be considered by the Board, since the appellants now restrict themselves to a case based on such confusion. For such a case to succeed it would be necessary to show that the law of Australia has developed a tort of unfair competition along the lines suggested in the well-known decision of the United States Supreme Court, *International News Service v. Associated Press*⁵⁶ in which Pitney J., delivering the majority opinion, said:

"It is said that the elements of unfair competition are lacking because there is no attempt by defendant to palm off its goods as those of the complainant, characteristic of the most familiar, if not the most typical, cases of unfair competition.⁵⁷ But, we cannot concede that the right to equitable relief is confined to that class of cases. In the present case the fraud upon complainant's rights is more direct and obvious. Regarding news matter as the mere material from which these two competing parties are endeavouring to make money, and treating it, therefore, as quasi property for the purposes of their business because they are both selling it as such, defendant's conduct differs from the ordinary case of

⁵⁵ Cf. the exasperated comments of Dworkin, *Note, Passing Off and Unfair Competition: An Opportunity Missed*, 43 *Modern L. Rev.* 564, at 567 (1981).

⁵⁶ 248 U.S. 215 at 241-242 (1918).

