

NEW HORIZONS IN "PASSING-OFF"

The intervention by a court to protect proprietary rights previously unrecognized by the law is an event as significant as it is infrequent. For this reason the decision of the Full Supreme Court of New South Wales in *Henderson and Anor. v. Radio Corporation Pty. Ltd.*¹ is worthy of note, the learned judges involved² having therein evidenced their passing (even if only temporarily) from the company of "timorous souls" to the ranks of "bold spirits"³ in an endeavour to adapt the traditional principles of what is called "passing-off" to changing social and commercial attitudes.

I. *The Facts of Henderson's Case*

The plaintiffs, husband and wife, were professional ballroom dancers and well known as such. The defendant company was engaged in producing and distributing gramophone records including certain recordings of dance music, upon the cover of which appeared, *inter alia*, a photograph of the plaintiffs in a dancing pose. Until the plaintiffs complained, the defendant was unaware that the photograph on its record covers was that of the plaintiffs, and indeed had never heard of the plaintiffs. However, when investigation had shown the plaintiffs' allegation to be true, the defendant refused to accede to a request that distribution of the offending covers be stopped. The plaintiffs then instituted proceedings in equity for an injunction and other relief including damages.⁴

II. *Fundamental Principles of Relief*

"Passing-off" is a cause of action at law,⁵ and thus gives rise to a legal right. Protection of this same legal right is given in equity in certain cases by the remedy of injunction, but such cases "are merely instances of the application by the court of a much wider principle, the principle being that the court will always interfere by injunction to restrain irreparable injury⁶ being done to the

¹ (1960) 77 W.N. (N.S.W.) 585; (1960) N.S.W.R. 279 (*sub. nom. Radio Corp'n. Pty. Ltd. v. Henderson and anor.*). Hereunder the *Weekly Notes* page references will be given first, followed in brackets by the corresponding *New South Wales Reports* reference.

² Evatt, C.J., Myers and Manning, JJ.

³ See *Candler v. Crane, Christmas & Co.* (1951) 2 K.B. 164, 178, 195.

⁴ The plaintiffs claimed:

(1) THAT the Defendant its servants and agents may be restrained from printing and selling and distributing to retail traders or causing to be printed and sold and distributed to retail traders the gramophone record cover entitled "Strictly for Dancing; Vol. 1" having upon it the picture of the Plaintiffs. (2) THAT the Defendant its servants and agents may be ordered to withdraw from distribution all copies of the gramophone record cover entitled "Strictly for Dancing; Vol. 1" having upon it the picture of the Plaintiffs that have been distributed by the Defendant to retail traders and which are still in the possession of the said retail traders. (3) THAT the Defendant may be ordered to pay to the Plaintiffs damages for the committing of the wrongful acts hereinbefore complained of. (4) THAT the Defendant may be ordered to pay the Plaintiffs' costs of this suit. (5) THAT the Plaintiffs may have such further or other relief as the nature of the case may require.

⁵ For a lucid historical analysis of the tort, see W. L. Morison, "Unfair Competition and 'Passing-off': The Flexibility of a Formula" (1956) 2 *Sydney L.R.* 50.

⁶ I.e. "injury which cannot be properly compensated by damages" (*Henderson's Case* at 598 (284) per Evatt, C.J. and Myers, J.). See *infra* n. 28.

plaintiff's property".⁷

The equity raised by irreparable injury (or the risk thereof) to property, although firmly established,⁸ becomes difficult to apply in the "passing-off" type of situation, where it is not always clear what is, and what is not, "property". The question that frequently demands an answer is "property in what"?⁹ Lord Parker continues: "Some authorities say property in the mark, name, or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured . . . and . . . there are strong reasons for preferring the latter."¹⁰ The view there preferred by the House of Lords appears to have prevailed, and "the right of property in the plaintiff . . . to the goodwill of his business" has now been described in the Court of Appeal as "the true basis" of "passing-off".¹¹

With these principles in mind (a) that "passing-off" suits in equity are not a distinct species of proceeding, but part of the general jurisdiction to protect proprietary rights by injunction, and (b) that the property of the plaintiff protected by a "passing-off" suit is his business goodwill, the several judgments given in *Henderson's Case* both at first instance and on appeal can now be considered.

III. *The Approach Adopted by Mr. Justice Sugerman*

The reasons for judgment given by Sugerman, J.¹² the trial judge are important (a) because of his Honour's helpful analysis of the authorities, and (b) because the "traditional" views applied by his Honour are in marked contrast to, and serve to highlight, the somewhat novel or "progressive" approach of the Full Court. Sugerman, J. considered that the following are prerequisites to relief in equity against "passing-off":

1. *Injury to Property* ("an invasion of a proprietary right . . ."). His Honour pointed out that "property in this context has received an extensive denotation", and includes, *inter alia*, "the potential capacity which one may have, although as yet unrealised, to engage in the future in activities sufficiently closely associated and connected with those at present carried on".¹³ In accordance with this doctrine the *Hendersons* were found to have a proprietary right in their "capacity to place upon a ballroom dancing record the seal of their approval".¹⁴

⁷ *Samuelson v. Producers' Distributing Company Ltd.* (1932) 1 Ch. 201, 210, *per* Romer, L.J., cited in *Henderson's Case* by Sugerman, J., and by Evatt, C.J. and Myers, J. at 284.

⁸ E.g., see W. W. Kerr, *A Treatise on the Law and Practice of Injunctions* (6 ed. 1927) 335 and cases there cited, and also the following: *A.-G. v. Sheffield Gas Consumers' Co.* (1853) 3 De G.M. & G. 304, 320; *The Emperor of Austria v. Day and Anor.* (1861) 3 De G.F. & J. 217, 253; *Edelsten v. Edelsten* (1863) 1 De G.J. and S. 185, 199; *Walter v. Ashton* (1902) 2 Ch. 282, 293; *Springhead Spinning Co. v. Riley* (1868) L.R. 6 Eq. 551, 558-563; *Dixon v. Holden* (1869) L.R. 7 Eq. 483, 492-94. The last two cited cases must be read in the light of *Prudential Assurance Co. v. Knott* (1875) L.R. 10 Ch. App. 142.

⁹ *A. G. Spalding & Bros. v. A. W. Gamage Ltd.* (1915) 32 R.P.C. 273, 284 *per* Lord Parker.

¹⁰ *Id.*, citing *Reddaway v. Banham* (1896) A.C. 199, 209 *per* Lord Herschell.

¹¹ *Draper v. Trist and anor.* (1939) 56 R.P.C. 429, 442 *per* Goddard, L.J. See also 32 Halsbury's *Laws of England* (2 ed. 1939) 619 and *J. Bollinger and Ors. v. Costa Brava Wine Co. Ltd.* (1959) 3 W.L.R. 966, 974 *per* Danckwerts, J.

¹² Reported only in the *Weekly Notes* (77 W.N. 585).

¹³ At 590, citing *The Eastman Photographic Materials Company Ltd. and Anor. v. The John Griffiths Cycle Corp. Ltd. and anor.* (1898) 15 R.P.C. 105, and *Hulton Press Ltd. v. White Eagle Youth Holiday Camp Ltd. and anor.* (1951) 68 R.P.C. 126.

¹⁴ At 592. Insofar as "capacity" suggests a mere privilege rather than a right this phrase cannot be treated as definitive of what the court will protect. In any case, the right in question is more accurately a right that others should not do something, rather than a right to do something oneself.

2. *Damage*¹⁵ ("... not necessarily actual damage in the past but a real and tangible risk of damage...")¹⁶. The "risk of damage" was found by his Honour to be "that if the defendant's cover remains in circulation, some manufacturer, otherwise willing to do so, might well be deterred from producing a record sponsored by the plaintiffs because of the risk of confusion between the two covers, or, because of such confusion, sales might be lost if such a record were produced".

3. *Confusion* ("... not necessarily actual confusion in the past but risk of confusion; confusion not necessarily limited to the carrying on of another's business but extending to any connection with that business...")¹⁷. This element was established by uncontroverted evidence¹⁸ of actual confusion.

4. *A Common Field of Activity*¹⁹ ("... confusion in relation to a common field of activity in which both parties are engaged.")²⁰. His Honour remarked that "a common field of activity may be found to exist where, although the defendant's activities differ from the actual present activities of the plaintiff, they are within the range of the plaintiff's potential capacity...". The "capacity" to sponsor or endorse gramophone records was "appurtenant to, or potentially appurtenant to, the profession or business of ballroom dancing", which was found to lie in a common field of activity with "the production and sale of a ballroom dancing record".

Having found each element to have been established, his Honour granted an injunction²¹ but refused an enquiry as to damages on the ground that any damages would be too small to warrant the expense of enquiry. From this decision the defendant appealed to the Full Supreme Court. There was no cross-appeal on the question of damages.

IV. *The Approach Adopted by the Full Court*

The Chief Justice and Mr. Justice Myers delivered a joint judgment. Mr. Justice Manning's judgment, although separate, did not substantially differ from that of the other two learned judges on the main questions of law.

The chief points in the Full Court decision can be classified under two principal heads, each combining two of the four concepts discussed by Sugerman, J.

1. *Injury to Property, and Damage*. The injury to the plaintiffs' property which Evatt, C.J. and Myers, J. considered sufficient to justify the Court's intervention was "the wrongful appropriation" of the plaintiffs' "professional or business reputation", or the deprivation of the plaintiffs' right "to withhold or bestow at will" their professional recommendation.²² This was stated to be "as

¹⁵ Nowhere, in applying the law to the facts before him, did Sugerman, J. expressly consider the (it is submitted) very real distinction between "damage" and "irreparable damage".

¹⁶ At 589, citing *British Legion v. British Legion Club (Street) Ltd.* (1931) 48 R.P.C. 555, 563.

¹⁷ At 589, citing the *British Legion Case supra* n. 16.

¹⁸ By the president of an association of dancing teachers, the secretary of another such association, a theatrical agent, and the assistant secretary of the trade union to which professional dancers belong.

¹⁹ This element as a separate criterion for relief was rejected by the Full Court; see *infra*.

²⁰ At 589, citing *McCulloch v. Lewis A. May (Produce Distributors) Ltd.* (1947) 65 R.P.C. 58.

²¹ "Restraining the defendant from selling, distributing or supplying to retail traders or other persons, or causing to be sold distributed or supplied, any copy or copies of the record cover or container of the gramophone record entitled 'Strictly for Dancing; Vol. 1' having upon it a reproduction of a photograph of the plaintiffs."

²² At 599 (285).

much an injury as if [the defendant] had paid [the plaintiffs] for their recommendation and then robbed them of the money."²³ The plaintiffs were held to have thereby suffered damage since they were deprived of "the payment or reward on which, if they had been minded to give their approval to the appellant's record, they could have insisted".²⁴ All three judges considered that the possibility of damage to the plaintiffs' goodwill and future business dealings (the basis on which Sugerman, J. placed their right to relief) was "too remote"²⁵ and did not amount to "a real and tangible risk".²⁶

It can be seen that the Court was concerned to protect the plaintiffs' property in their reputation as ballroom dancers. Insofar as business reputation is part and parcel of business goodwill,²⁷ then this alone was no departure from the traditional view. However, it is submitted that there *was* such a departure by the Court in its determination of the kind of rights which are recognised to be incidental to, or embraced by, the "property" of business goodwill, i.e. of the kind of *injuria*²⁸ which is capable of being suffered in respect of such property.

One can distinguish three classes of possible *injuria* by B to the property of A: (a) where B destroys A's property so that neither A nor B has the benefit thereof; (b) where B takes A's property so that B gains and A loses the benefit thereof; (c) where B uses A's property so that B gains but A does not lose the benefit thereof.

It is submitted that in the past equitable relief has depended upon the proof of an *injuria* within either class (a) or class (b), and, except perhaps in the case of certain statutory property,²⁹ the court has not restrained by injunction the infliction of a class (c) *injuria*. In the context of *Henderson's Case*, this can be established by a consideration of two important cases.³⁰

In *Clark v. Freeman*³¹ the Master of the Rolls, Lord Langdale, refused an injunction to restrain a chemist from advertising a quack medicine under the name of an eminent physician, on the ground that (apart from the question of defamation which his Lordship held should be first established at law) it must first be shown "that an injury is . . . done to the plaintiff's property, or to his means of subsistence or of gaining a livelihood", and it had not been established that the plaintiff had "been seriously injured in his reputation".³² That his Lordship used the word "reputation" here in the sense of "goodwill" is demonstrated by his next remark: "It is one of the taxes to which persons in (the plaintiff's) station become subjected, by the very eminence they have acquired in the world. Other persons try to avail themselves of their names and reputa-

²³ *Ibid.*

²⁴ *Ibid.* In like manner, Manning, J. described the injury to the plaintiffs' property as "the unauthorised use by the defendant of the commercially valuable reputation of the plaintiffs" (at 605 (293)). The result of this was "to deprive the plaintiffs of the fee or remuneration they would have earned if they had been asked for their authority to do what was done" (at 604 (292)).

²⁵ *Ibid.*

²⁶ *Id.*, at 598 (285).

²⁷ See, e.g., Lord Macnaghten's oft-quoted definition of "goodwill" as "the benefit and advantage of the good name, reputation, and connection of business" in *I.R.C. v. Muller & Co.'s Margarine* (1901) A.C. 217, 223.

²⁸ The word "injury" is ambiguous: it may mean "injury in law", or "injury in fact", or both. It occurs very frequently in the cases, in many of which there seems to be the implication that the two concepts are co-extensive. It is submitted (see *infra*) that *Henderson's Case* shows them to be not co-extensive, and a need thus arises for more precise terminology. Consequently in this Note, whenever the context permits, the term "*injuria*" is used to stress the notion of a *legal* wrong, whether or not arising from factual damage or loss.

²⁹ E.g., originating from the Trade Marks Act, Patents Act, Copyright Act, or Industrial Designs Act.

³⁰ *Clark v. Freeman* (1848) Beav. 112, and *Dockrell v. Dougall* (1899) 80 L.T.R. 556. The latter case was not mentioned in any of the judgments in *Henderson's Case*. The former was referred to by the judge at first instance (at 590-1), and by Manning, J., at 601 (288).

³¹ (1848) Beav. 112.

³² *Id.*, at 118.

tions for the purpose of making profit for themselves; that unfortunately continually happens."³³ *Clark v. Freeman* has been criticised in some later decisions, but, with one exception, only on the ground expressed in Lord Selbourne's observation on the case: "Could not a professional man be injured in his profession by having his name associated with a quack medicine?"³⁴ This remark, and others along the same lines, it is suggested, serve only to emphasise the requirement of a class (a) or class (b) *injuria*. The exception referred to is the remark of Lord Cairns³⁵ (*arguendo* and *obiter*) in *Maxwell v. Hogg*³⁶ to the effect that "It has always appeared to me that *Clark v. Freeman* might have been decided in favour of the plaintiff on the ground that he had a property in his own name."³⁷

However, it is thought that the decision of the Court of Appeal in *Dockrell v. Dougall*³⁸ has deprived Lord Cairns' observation of any validity and has firmly established the principle of *Clark v. Freeman*. The facts were similar to those of the latter case, the plaintiff being a physician whose name had been used, without his authority, to advertise a quack medicine.³⁹ The plaintiff brought an action for libel, but, having failed to establish this before the jury, he then sought an injunction to restrain publication of the advertisements, relying on the general equitable principle of protection of property rights. Ridley, J. refused this relief, whereupon the plaintiff appealed to the Court of Appeal.

In dismissing the appeal, A. L. Smith, L.J. said: "In order . . . to be entitled to an injunction, it seems to me that the plaintiff must show injury to him in his property, business or profession."⁴⁰ His Lordship then stated that the plaintiff must fail, since he had no property in his own name *per se*, and no injury of the requisite type had been established. Concurring, Vaughan Williams, L.J. said:

. . . it is impossible to say that there are not cases in which a man would have a cause of action if there has been an unauthorised user of his name to the injury of his rights of property . . . not only . . . as to rights of property in the general sense of the word, but also as to the rights of a man with a profession or business whose pecuniary advantage may be interfered with by a wrongful user of his name. . . . The plaintiff has failed to prove anything more than the user of his name by the defendant without authority. The plaintiff has failed to prove any infraction of his rights of property, or any injury to him in his property, business, or profession. . . .⁴¹

Romer, L.J. also agreed, and described as unsound the proposition "that there is right of property in a man's name so that any use of that name by another will be actionable if the use is unauthorised and may be⁴² to the detriment of the plaintiff in his profession".⁴³

These cases⁴⁴ demonstrate, it is thought, that prior to *Henderson's Case* in order to obtain an injunction it was necessary to show by way of *injuria* a

³³ *Ibid.*

³⁴ *In re Rivière's Trade-Mark* (1884) 26 Ch. D. 48, 53, *arguendo*.

³⁵ Receiving the qualified support of Malins V-C, in *Springhead Spinning Company v. Riley* (1868) L.R. 6 Eq. 551, 561-2, and Kekewich, J. in *Lee v. Gibbings* (1892) 67 L.T.R. 263, 265.

³⁶ (1867) L.R. 2 Ch. App. 307.

³⁷ *Id.* at 310.

³⁸ (1899) 80 L.T.R. 556.

³⁹ The actual words used were: "Dr. Morgan Dockrell, physician to St. John's Hospital, London, and many of the leading physicians are prescribing 'Sallyco' as a habitual drink. Dr. Dockrell says 'Nothing has done his gout so much good.'"

⁴⁰ (1899) 80 L.T.R. 556, 557.

⁴¹ *Id.*, at 558.

⁴² Implying "but is not proved to be".

⁴³ (1899) 80 L.T.R. 556, 558.

⁴⁴ See also *British Medical Assn. v. Marsh* (1931) 48 R.P.C. 565 where Maugham, J. reviews and discusses most of the relevant authorities and comes to the conclusion here expressed.

deleterious effect on the plaintiff's property. The Full Court in *Henderson's Case* found no such deleterious effect of any significance, and yet gave the plaintiffs relief. This suggests a new kind of *injuria* (class (c)) and as a corollary, a new right incidental to the property of goodwill.⁴⁵

It appears that Manning, J. recognised the novelty of this proprietary right, since his Honour appealed to "the change that has taken place in the attitude of the community to new and altered standards of conduct which have developed consequent upon the new and altered methods of advertising and marketing"⁴⁶ as justifying its acceptance, because "the new and altered standards must be accepted by the courts once it is apparent that they have been accepted by the community".⁴⁷ The community's acceptance of the change is evidenced by the opening up of

a new field of gainful employment for many persons who, by reason not only of their sporting but of their social, artistic or other activities which have attracted notoriety, have found themselves in a position to earn substantial sums of money by lending their recommendation or sponsorship to an almost infinite variety of commodities.⁴⁸

This seems indeed to be a frank recognition of the creative nature of the decision (placing it squarely on sociological grounds). On the other hand, the reasoning in the majority judgment may with respect be thought to be somewhat circuitous on this point. In the hypothetical illustration, given by their Honours, of the defendant paying the plaintiffs for their recommendation and then robbing them of the money, presumably the plaintiffs are assumed to have a legally protected economic interest in the *res* before the transaction, similar to their undoubted legally protected economic interest in the money after the transaction. But the very question for decision in *Henderson's Case* was whether the plaintiffs *did* have such an interest in the *res* (the exclusive benefit of their reputation).⁴⁹

2. *Confusion and A Common Field of Activity.* The concept of "a common field of activity in which . . . the plaintiff and the defendant were engaged",

⁴⁵ There are certain *dicta* suggesting the non-existence of such a right:

"But unless a man's photograph, caricature, or name be published in such a context that the publication can be said to be defamatory within the law of libel, it cannot be made the subject-matter of complaint, by action at law." *per* Greer, L.J. in *Tolley v. J. S. Fry and Son Ltd.* (1930) 1 K. B. 467, 478 (rev. on other grounds (1931) A.C. 333).

"It is clear, I think, that the opponents could on their part obtain no injunction for the protection of such an interest as that arising from the mere celebrity or reputation of (their) productions." *per* Dixon, J. in *Radio Corporation Pty. Ltd. v. Disney and ors.* (1937) 57 C.L.R. 448, 459.

See also the remarks of Swinfen Eady, J. in *Corelli v. Wall* (1906) 22 T.L.R. 532.

But in certain States of U.S.A., a similar right is recognized: see *Pavesich v. New England Life Insurance Co.* (1905) 122 Ga. 190, 50 S.E. 68, 106 Am. St. Rep. 104; *Foster-Milburn Co. v. Chinn* (1909) 134 Ky. 424, 120 S.W. 364, 135 Am. St. Rep. 417; although in some it has been denied: *Roberson v. Rochester Folding Box Co.* (1902) 171 N.Y. 538, 64 N.E. 442, 89 Am. St. Rep. 828; *Henry v. Cherry and Webb* (1909) 30 R.I. 13, 73 Atl. 97, 136 Am. St. Rep. 928; *Atkinson v. Doherty* (1899) 121 Mich. 372, 80 N.W. 285, 80 Am. St. Rep. 507.

In *Sim v. H. J. Heinz Co. Ltd. and anor.* (1959) 1 All E.R. 547, which was a motion for an interlocutory injunction to restrain the defendant from simulating the plaintiff's well-known voice for advertising purposes, McNair, J. said (at 551): "I am not going at this stage to rule on the question whether, in any circumstances, an action of passing off would lie for the unauthorised use of a man's voice, be he actor or not actor, though it would seem to me to be a grave defect in the law if it were possible for a party, for the purpose of commercial gain, to make use of the voice of another party without his consent." In the Court of Appeal, Hodson, L.J. after describing the proceedings as "a novel form of action for passing off", and describing as "an arguable case" the plaintiff's contention "that his voice as an actor is part of his stock-in-trade and therefore is something which he is entitled to protect as part of his goods", did not consider it right for the Court to express any opinion on such matters (at 549-50).

⁴⁶ At 604 (291).

⁴⁷ *Ibid.*

⁴⁸ *Ibid.*

⁴⁹ Use without consent or payment is wrongful provided there is a legal right to withhold consent or demand payment, but *semble* any such legal right, in the absence of statutory or judicial authority, must in turn depend on such use being legally wrongful.

first expressed as an independent and necessary element in "passing-off" by Wynn-Parry, J. in *McCulloch v. Lewis A. May (Produce Distributors) Ltd.*⁵⁰ and adopted by Sugerman, J. in the court below, found little favour with the Full Court.

Evatt, C.J. and Myers, J. did not accept the principle because of its "unjust consequences",⁵¹ illustrated by the present case: "If deception and damage are proved, it is not easy to see the justification for introducing another factor as a condition of the court's power to intervene."⁵² Manning, J. likewise regarded the only relevance of the existence or otherwise of a common field of activity as bearing on the questions (a) whether deception is likely and (b) whether the plaintiff has suffered damage.⁵³

V. Possible Scope of the Right to the Exclusive Use of One's Reputation

1. *The Status of the Plaintiff.* Evatt, C.J. and Myers, J. did appear to place some limitation on the kind of person in whom this right vests: "The remedy in passing off is necessarily only available where the parties are engaged in business, using that expression in its widest sense to include professions and callings."⁵⁴ The *injuria* suffered by the Hendersons was to their right "to withhold or bestow at will" their "professional recommendation".⁵⁵ But if one accepts the view that the equity court does not regard "passing-off" as a special or definitive type of proceeding, but merely as a more or less vague category of factual situations giving grounds for an injunction in pursuance of the general jurisdiction to restrain irreparable injury to property rights,⁵⁶ then the restrictions suggested above may not be of general application and may apply only to "passing-off in the popular and usual sense".⁵⁷

Who, then, have this proprietary right in respect of their reputations? It seems that Manning, J. at least, considered that the right vested in those who are "in a position to earn . . . money by lending their . . . sponsorship to . . . commodities".⁵⁸ If the principle is as broad as this (and there appears to be no logical reason why it should not be), the range of potential plaintiffs is very wide indeed, particularly if (as seems to be indicated) mere capacity to engage in sponsorship in the future is sufficient, without evidence of either actual sponsorship in the past or an intention to sponsor in the future.

If, as Manning, J. appears to suggest, the right vests in those whose reputation or recommendation is "a saleable commodity",⁵⁹ including "leading amateur sportsmen",⁶⁰ it seems logical that it should vest in all who come before the public eye in whatever sphere they may be engaged, that, for instance, a poli-

An interesting case by way of contrast to the present decision is *Day v. Brownrigg* (1878) 10 Ch. D. 294, where the defendant "appropriated" the long-standing and well-known name of the plaintiff's house and used it for his own house, next door. The Court of Appeal upheld a demurrer to the statement of claim, on the basis that a right to the exclusive use of a name of a house is unknown to the law.

⁵⁰ (1949) 65 R.P.C. 58, 67.

⁵¹ At 597 (283).

⁵² *Ibid.*

⁵³ *Id.*, at 603 (291).

⁵⁴ *Id.*, at 597 (283).

⁵⁵ *Id.* at 599 (285) (italics supplied).

⁵⁶ See *supra*.

⁵⁷ See *per Romer, L.J.* in *Samuelson v. Producers' Distributing Co. Ltd.* (1932) 1 Ch. 201, 210.

⁵⁸ *Henderson's Case* at 604 (292).

⁵⁹ *Ibid.*

⁶⁰ *Ibid.*

tician is as much entitled to the court's protection as a tennis player. But such inferences must be always subject to the *caveat* implicit in the remark of Holmes, J. that "the life of the law has not been logic: it has been experience".⁶¹

There is also room, of course, for much judicial flexibility in the determination in a particular case whether the plaintiff's reputation or recommendation is or is not "a saleable commodity". *Henderson's Case* does not provide a clear definition of this concept. "Saleable" must suggest the existence of a *right* rather than a *privilege* (in the Hohfeldian sense⁶²) and probably a *right in rem* or *multital right*,⁶³ but this may be just another way of saying that the plaintiff's *property* must be affected. It is conceivable (to put it at its highest) that every person's reputation or recommendation is "saleable". If so, *Henderson's Case* might be the threshold of a part-realization of Professor Winfield's desire that "offensive invasion of the personal privacy of another" be a tort.⁶⁴ However, we must await the further elucidation by the courts of the criteria of "saleability".

2. *A Challenge to the Element of Deception or Confusion.* At common law, the action for "passing-off" evolved from the action for deceit,⁶⁵ and it was necessary to prove a fraudulent intent on the part of the defendant.⁶⁶ The jurisdiction of the Court of Chancery was based on the loss incurred by the plaintiff in respect of his property rather than the motives of the defendant,⁶⁷ and equity did not insist on actual fraud being shown, provided that the result of the defendant's act was to deceive or confuse third parties.⁶⁸ In England, as a result of the Judicature Acts,⁶⁹ the equitable doctrine has probably superseded the stringencies of the common law.⁷⁰ In New South Wales the positions at common law and in equity may well remain distinct, but the distinction is largely academic since no one nowadays bothers to bring an action at law for "passing-off".⁷¹

The decision in *Henderson's Case* may have the effect of removing the requirement of showing actual deception or confusion (or a real and tangible risk thereof) as a condition precedent to equitable relief, and this notwithstanding the assertion by all four judges who considered the case that deception or confusion was essential. It is suggested that the whole basis of a "deleterious" (class (a) or (b))⁷² *injuria* to a man's goodwill and reputation in the "passing-off" situation, lies in the confusion in the public mind as to the connection or relation between the defendant, his goods or his business, and the plaintiff, his goods or his business. If there were no such confusion (or deception) there would be no *injuria of that kind*. Consequently as long as the courts confined their attention to a "deleterious" *injuria*, they rightly insisted on confusion or deception being shown. But a "non-deleterious" (class (c))⁷³ *injuria* is not dependent upon confusion. Consequently in cases (such as *Henderson's Case*) where a "non-deleterious" *injuria* is established, the element of confusion or

⁶¹ O. W. Holmes, Jr., *The Common Law* (1938 ed.) 1, quoted by Lord Macmillan in *Read v. J. Lyons and Co. Ltd.* (1947) A.C. 156, 175.

⁶² W. N. Hohfeld, *Fundamental Legal Conceptions and other Legal Essays* (1923 ed. Cook), Essays I and II; and see also J. Stone, *The Province and Function of Law* (1950), Ch. V.

⁶³ See Stone, *op. cit.* 124.

⁶⁴ P. H. Winfield, "Privacy" (1931) 47 *L.Q.R.* 23, 41.

⁶⁵ See W. L. Morison, *op. cit.* 53-4.

⁶⁶ See *Crawshaw v. Thompson* (1842) M. & G. 357; *Edelsten v. Edelsten* (1863) 1 De G.J. & S. 185.

⁶⁷ See cases referred to *supra* n. 8, and also *The "Singer" Machine Manufacturers v. Wilson* (1877) 3 A.C. 376, 391, *per* Lord Cairns, and at 397ff. *per* Lord Blackburn.

⁶⁸ See *Millington v. Fox* (1939) 3 My. & Cr. 338; *Cartier v. Carlyle* (1862) 31 *Beav.* 292.

⁶⁹ 36 & 37 Vict. c. 66 and 38 & 39 Vict. c. 77 consolidated and re-enacted by 15 & 16 Geo. 5, c. 49.

⁷⁰ See generally W. L. Morison, *op. cit.* 55 whose submission, however, that "it is now settled that fraud need not be shown" may be too sweeping, at least as regards an action at law in New South Wales.

⁷¹ Since the remedies in equity are more effective, and in any case include the granting of damages (under Lord Cairns' Act, now s.9 of the Equity Act 1901).

⁷² See *supra*.

⁷³ See *supra*.

deception may well be superfluous, since the *injuria* can be established without recourse thereto. This is another matter which must await further judicial comment.⁷⁴

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⁷⁴The possibilities which may be opened in future on this view of the principle in *Henderson's Case* can be illustrated by the following hypothetical situations where unauthorised use is made of another's business goodwill and reputation, but the element of deception or confusion is lacking: (a) A is a well-known popular pianist. B manufactures and sells a gramophone recording of music played by C, another pianist. On the cover of the record is a clear statement that although the recording is by C and not by A, C is playing in A's characteristic style. (b) A is the proprietor of a very large and well-known food emporium. B is the proprietor of a very small book shop adjacent to A's establishment. B advertises extensively that his shop is the one next door to A's emporium.