

signature, J. Payson Williston, the original inventor and only manufacturer of the ink. The applicant set forth that the foregoing had been used to distinguish the said article for *thirty-five years*. The specification further recited, that “the indelible ink in a bottle is held within the metallic case covered by the wrapper, which, with the label, presents a combination of the two bright colors, yellow and red, so that the package or roll would look nearly the same were the label and the ground upon which it was pasted red; or were the red label left off entirely, the color of the roll, together with its size, would still be enough to indicate its character to any who would recognize it by this general characteristic, at a distance too great to read the printed matter.”

§ 272. The Office answered, that there was but a single element of a trade-mark in the case, and that that was the facsimile of the signature. The applicant insisted upon a right to the colors of the two labels or wrappers, or a single color, as mentioned. Such a case probably never before came up. It was a matter such as is usually noted in books of reports as *Curia advisare vult*. The case was taken before the Commissioner of Patents in person, and consultation had. The applicant, by counsel, strenuously insisted upon the colors, regardless of form. *Result*: Examiner's decision fully concurred in. A contrary opinion would virtually have conceded the right of any man to select a certain color by which his merchandise should be designated, a peculiarly colored paper in which his goods should be wrapped, and his exclusive right to that color. The effect would have been, if such a wild theory were maintained, gradually to throttle trade. No one would dare to send out his wares in red or in yellow papers, lest the vengeance of a prior adopter should light upon him. This case has its lesson.

§ 273. *As Exemplars of Words as Trade-Marks of Fancy*, we will consider some that have passed the Patent Office. “La Flor del Tropico,” for cigars, really manufactured from the flower of the tropics, was held not to be objectionable.<sup>1</sup> “Cashmere Bouquet,” for toilet-soap, does not convey any false

<sup>1</sup> Gaullieur & André, No. 927.

suggestion of origin or quality.<sup>1</sup> Nor does "Diamond," coupled with *soap*.<sup>2</sup> "Samson Brace," for suspenders, cannot imply anything more than strength of material and make.<sup>3</sup> "Deer Tongue," for tobacco, is clear enough.<sup>4</sup> So is "Royal Bats-wing," for ladies' corsets.<sup>5</sup> "Melaroma," for a beverage, might possibly intimate to a scholar that the article was compounded of honey and some other ingredient, fragrant and delicious; but whether true or not in a literal sense, it would not be likely to do the public much harm.<sup>6</sup> The words "Wild Black Berry Bitters" should not for an instant be thought of as a lawful trade-mark for the article they designate; but when, instead of the initial letters, B, we see three golden *bees*, the ingenious device commands our admiration.<sup>7</sup> We are not deceived into thinking that there is any "Gold Dust" in the whiskey that bears that name;<sup>8</sup> or that an illuminating-oil is verily "Mineral Sperm Oil";<sup>9</sup> or that pills are really "Everlasting."<sup>10</sup> Nothing but a sheer lack of charity would literally construe "Annihilator," as applied to a medicine;<sup>11</sup> and when considering the case of *Davis v. Kendall*,<sup>12</sup> we would deem the question as to its right of existence to be judicially settled, and pass as good the words "Pain Killer."<sup>13</sup> In this case, it appears by the specification that Perry Davis, the founder of the firm, and father of Edmund Davis and Sarah D. Dennis, copartners under the firm name of Perry Davis and Son, in or about the year 1839 originated and introduced the article of medicine to which he at that time applied the distinctive and suggestive name of "Pain Killer." There is also a recital of the fact that the said name has at various times been pirated by different persons, who have been promptly sued for their piracies; and that in all cases the said name as a trade-mark has been fully maintained by the decisions of the courts.— For a while there was doubt as to

<sup>1</sup> Colgate & Co., No. 914.

<sup>3</sup> Fisk, Clark, & Flagg, No. 744.

<sup>5</sup> Thomson, Langdon, & Co., No. 540.

<sup>7</sup> Landsberger & Co., No. 814.

<sup>8</sup> Barkhouse Brothers & Co., No. 626.

<sup>10</sup> Dunn & Co., No. 448.

<sup>12</sup> 2 R. I. 566.

<sup>2</sup> J. Buchan & Co., No. 924.

<sup>4</sup> L. L. Armistead, No. 512.

<sup>6</sup> E. J. Williamson, No. 401.

<sup>9</sup> R. S. Merrill & Co., No. 557.

<sup>11</sup> N. Jenkins, No. 746.

<sup>13</sup> Perry Davis & Son, No. 416.

the propriety of admitting to registration the word "Zero," as a mark for a water-cooler. The term seems to imply a low degree of temperature, and to be in the nature of a guaranty of great frigidity; but upon consideration it was allowed to pass.<sup>1</sup> "The Arctic," for soda apparatus, was also held to be valid.<sup>2</sup> "Valley Gem," for piano-fortes, was held not to be necessarily descriptive, while well adapted to its purpose.<sup>3</sup> "Sunny South" is not a term so common as to prevent its use as a mark for stoves.<sup>4</sup>

§ 274. When we see "Daylight"<sup>5</sup> upon a vessel containing illuminating-oil, or "Sunlight"<sup>6</sup> or "Gaslight"<sup>7</sup> upon a similar article, we instantly perceive that the word is used as a fanciful denomination; and so of "Water White,"<sup>8</sup> as applied to refined petroleum, for those words could not in such a case be descriptive, any more than could "Crystal"<sup>9</sup> be of castor-oil, or "Star of the West"<sup>10</sup> of a pump.

§ 275. Mowing, reaping, and harvesting tools bear the designations of "Red Racer,"<sup>11</sup> "Tip Top,"<sup>12</sup> "Queen of the Meadow,"<sup>13</sup> "Star of the West,"<sup>14</sup> "King of the Field,"<sup>15</sup> "Western Dutchman,"<sup>16</sup> and "Harvest Victor";<sup>17</sup> and many other names, which are understood to be purely arbitrary, identify certain articles as the manufacture of certain persons.

§ 276. *Rejected, as indicative of Quality.*—The following are instances of applications rejected, because the proposed trade-marks consisted of words denoting the quality or nature of the articles to which it was intended to apply them. The words "Parchment Deed," to be affixed to a peculiar kind of writing-paper.<sup>18</sup> *Held*, to be either purely descriptive, or else calculated to deceive. Affirmed on appeal. "Geyser Spring," for Saratoga mineral water.<sup>19</sup> The Examiner said in

<sup>1</sup> A. M. Lesley, No. 664.

<sup>3</sup> Ohio Valley Piano Co., No. 795.

<sup>6</sup> Bostwick & Tilford, No. 376.

<sup>7</sup> Bostwick & Tilford, No. 377.

<sup>9</sup> H. J. Baker & Brother, No. 373.

<sup>11</sup> Greenwoods Scythe Co., No. 749.

<sup>13</sup> Id., No. 751.

<sup>16</sup> Id., No. 753.

<sup>17</sup> Samuel B. Forbes, No. 843.

<sup>19</sup> Ex parte George S. Batcheller et al.

<sup>2</sup> James W. Tufts, No. 678.

<sup>4</sup> Abendroth Brothers, No. 307.

<sup>6</sup> W. H. Reed, No. 708.

<sup>8</sup> F. M. Backus, No. 640.

<sup>10</sup> H. Smith, No. 432.

<sup>12</sup> Id., No. 750.

<sup>14</sup> Id., No. 752.

<sup>16</sup> Id., No. 754.

<sup>18</sup> Ex parte Crane & Co.

his decision that the term "geyser" has a signification well known to the public in connection with certain springs. It is therefore generic and descriptive. The applicant asked for some evidence of the correctness of the decision. The reply was that the word "geyser" is a familiar geological term, as is shown by the standard dictionaries, books on geology, and many other printed authorities; that it is an English word, from the Icelandic verb *géysa*, to rage, boil, spout; meaning, in its restricted sense, a fountain common in Iceland which spouts forth boiling waters; and that by the natural growth of our language it has become common property to indicate any spring like the geyser springs of Iceland. The geysers of the Yellowstone Valley and of California, in our own country, might also have been mentioned. "Beeswax Oil" was in effect held by the Commissioner to be simply descriptive of quality.<sup>1</sup> The word "Razor" being purely descriptive, and "steel" a generic term, the compound word "Razor-steel" was refused registration.<sup>2</sup> The word "Invisible," applied to pearl-powder for beautifying the complexion, when used to indicate the character of the thing to which it is attached, becomes descriptive. The intention of the applicant was to intimate that the powder, when applied to the skin, is imperceptible or invisible.<sup>3</sup> The words "Calendar Watch,"<sup>4</sup> for watches having calendars, were rejected, and the rejection sustained on appeal. The applicant asked for a rehearing upon the case as amended by the addition of "Hall's." The petition was denied, for the reason that such addition could not strengthen a deficient symbol. "Cundurango Ointment, C. O.," is not a legitimate trade-mark. "Ointment" is a generic term, and "Cundurango" the name of a plant extensively known, and the initials "C. O." are immaterial, and not likely to be noticed.<sup>5</sup> "Lunch Milk Biscuit," to be applied to milk biscuit, for lunch or not, cannot be regarded as a trade-mark.<sup>6</sup>

<sup>1</sup> C. L. Hathaway & Sons, Com. Dec., 1871, p. 97.

<sup>2</sup> R. J. Roberts, Ibid. 113.

<sup>3</sup> Solon Palmer, Ibid. 289.

<sup>4</sup> Ex parte Daniel G. Hall.

<sup>5</sup> Blakeslee & Co., Com. Dec., 1871, p. 284.

<sup>6</sup> Ex parte C. D. Ross & Son.

§ 277. The words “The Woven Wire Mattress,” to be affixed to the very article designated, were claimed to be worthy of favorable consideration. The counsel for the applicant—a corporation formed under the laws of the State of Connecticut<sup>1</sup>—argued on its behalf: 1. That the said words, at the time of their adoption by the applicant as its trade-mark, had not been used in our language, that is, connected together to represent any known article or thing; and by themselves conveyed no meaning. 2. That they could not be considered to be descriptive, for the reason that the wires of the said mattress are coiled and interlacing together, rather than united in the manner ordinarily and technically known as “weaving.” 3. That the applicant had the sole right to manufacture goods with the above-mentioned name, and had that right at the time of the adoption of the words as a trade-mark, under a patent owned by it,—in which patent first occurred the word “weaving” in connection with the peculiar form and manner of interlacing coils of wire therein described, the same having been before then unknown in our language. The ingenuity of the argument did not save the case; for it could not be conceived what words more clearly descriptive could have been selected. The words were not newly coined, and are common property, notwithstanding the applicant first used them in that exact form.<sup>2</sup>

<sup>1</sup> Ex parte The Woven Wire Mattress Co.

<sup>2</sup> As to the necessary name of a product, see §§ 220 *et seq.*

## CHAPTER VI.

## FEDERAL TRADE-MARK LEGISLATION.

- § 278. Misconception as to power of Congress.
- § 279. Carelessness in examination of question.
- § 280. Act of 1870 discussed.
- § 281. Congress has authority to legislate on marks.
- § 282. Act of March 3, 1881, constitutional.
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- § 284. "Owner," — meaning of term, as used in act.
- § 285. Why act limited to foreign and Indian commerce.
- § 286. "Treaty, convention, or law" defined.
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- § 304. "Fac-similes," — meaning of term in this law.
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- § 327. "Registered or known trade-mark."
- § 328. Calculated to deceive.
- § 329. Statutory requirements must be fulfilled.

§ 278. *The Danger of Superficial Reading* has seldom been more strikingly exemplified than in connection with the subject matter of this chapter. A decision of the Supreme Court of the United States had commonly been misunderstood, and its meaning perverted.<sup>1</sup> The trumpet had not given an uncertain sound, but ears were dull of hearing. That decision had virtually annulled certain mal-legislation of Congress. The serious blunder was made of supposing that, because the legislature had carelessly exercised a power, no inherent power existed. A misconception of the true import of an oracular decree created a panic among owners of trade-marks. More than eight thousand merchants and manufacturers, whose special symbols of the genuineness of their merchandise had been recorded and registered under a supposed law, were told by steam-printed reports of lightning-tongued intelligence, that the nation was utterly without power to protect honest marks of commerce, — commerce, the integrity of faith in which concerns every man, woman, and child, for all are consumers. The registrants were even refused a return of moneys paid by them into the treasury, as a consideration for the promise that they might “obtain protection for such lawful trade-mark by complying with” certain requirements.<sup>2</sup> Imagination ran riot. Confidence in national honor was shaken. Infringers and counterfeiters thought that, so long as they eluded the grasp of the authorities of the individual States, they had full immunity. Confidence in the power and desire of Congress to protect honest commerce and manufacture was at length restored, but only after wearisome efforts by a few to extract and diffuse the essence of the judicial decision that had been the innocent cause of confusion.

§ 279. The necessity for examining the state of the law for ourselves is apparent, in view of the uncertainty in the mind of the multitude. Why was the scope of that decision beyond the comprehension of men who should understand it? Because comparatively few, of lawyers even, had had the

<sup>1</sup> In the Trade-Mark Cases, 100 U. S. 82.

<sup>2</sup> See Sect. 77, Registration Act of July 8, 1870.

patience to analyze the elaborate and somewhat involved opinion of the court, as delivered through the lips of one of its most able members. Misled by a superficial glance at some careless syllabus, or detached scraps of the opinion itself, or newspaper report, they jumped to a wrong conclusion, and contentedly rested there. A lack of judicious scrutiny has been especially observable in members of Congress, the very persons whose particular charge it was to con and sift the language of the court.<sup>1</sup>

§ 280. Lest we be misled by the same cause, let us review the antecedent state of the law, and thus obtain that understanding which, as says Lord Coke, is “the very lock and key to set open the windows of the statute.” — The first attempt by Congress to regulate the right in trade-marks is to be found in the act of July 8, 1870, entitled, “An Act to revise, consolidate, and amend the statutes relating to Patents and Copyrights.” These terms long since became technical, one referring exclusively to inventions, and the other to the writings of authors, the protection of the exclusive right to which comes within the powers given to Congress in the eighth clause of the eighth section of the first article of the Constitution. It is a reasonable inference that protection to trade-marks was in the opinion of Congress at that time an exercise of the power mentioned. It may be safely assumed that it was mainly, if not wholly, to that clause that the

<sup>1</sup> See Report No. 3, from the Committee on Manufactures, H. of Reps., Dec. 11, 1879; and also Report No. 561, from the Committee of the Judiciary, of same house, March 12, 1880. Said reports show that they who were responsible for them were utterly destitute of a knowledge of the essential nature of a symbol of commerce and manufactures, or were recklessly disregarding of the law, as decided by the very opinion of the Supreme Court that was copied in full in each of said reports. Report No. 561 recommended that the Constitution be amended, so as to provide as follows: “Congress, for promotion of trade and manufactures, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks.” This almost incredible suggestion was of course consigned to the sleep of death. It would not now be referred to but for the fact that it has been revived in subsequent sessions, and may, by some freak of legislative forbearance, be permitted to live. Perpetual-motion enthusiasts have not yet learned that the laws of gravitation cannot be overturned, and in the domain of legal science things that by nature are impossible are attempted.



advocates of the law looked for its support.<sup>1</sup> United States Circuit Courts had so understood it. In the Sixth Circuit, Judge Swing had pronounced the act to be constitutional under that clause.<sup>2</sup> In the Seventh, a contrary decision was made.<sup>3</sup> In two United States Circuit Courts the judges had made certificates of division of opinion in cases of indictment under the penal act of August 14, 1876.<sup>4</sup> By this means the question came into the Supreme Court of the United States. The confusion was owing to the fact that but few stopped to consider the irreconcilable incongruity between invention and literary authorship, and a thing that is essentially neither, but merely "one's commercial signature."<sup>5</sup> Even the Attorney-General in his brief said: "Undoubtedly in the legislative mind they were kindred subjects, and it was thought that the power of Congress over them might be derived from the same source"; although it is true that he relied more on the third clause of the eighth section of the first article of the Constitution, the authority "to regulate commerce with foreign nations, and among the several States, and with the Indian tribes." The Supreme Court soon settled the point upon which the whole discussion hinged, in the words, "The ordinary trade-mark has no necessary relation to invention or discovery." That being the case, the act of July 8, 1870, had no legal existence, as will presently be explained. As the court said, the exclusive right to a trade-mark does not depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. That being so, we can look alone to the power to regulate commerce. But under that power the act signally fails; for says the court: "When, therefore, Congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find

<sup>1</sup> See opinion of court, 100 U. S. 93.

<sup>2</sup> *Duwel v. Bohmer*, 14 Off. Gaz. 270; Cox's Manual, case 613.

<sup>3</sup> *Leidersdorf v. Flint*, 13 Am. L. Rev. 300; 8 Biss. 827; Cox's Manual, case 629.

<sup>4</sup> 19 Stat. 141; 1 Supp. R. S. 241.

<sup>5</sup> "One's commercial signature," — a phrase used by the writer in § 130.

on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it be apparent that it is designed to govern the commerce wholly between citizens of the same State, it is obviously the exercise of a power not confided to Congress." That is the fatal point. The act of 1870 did not require that the person desiring to obtain protection, by means of registration, should be engaged in the kind of commerce which Congress is authorized to regulate. The court said that it is manifest that its broad purpose was to establish a system of registration for the benefit of all who had already used a trade-mark, without regard to the character of trade. It also attempted to create a right to a trade-mark, and in advance of adoption required all who *intended* to adopt to swear that they had an exclusive right, which could only be obtained by adoption, i. e. by actual use on goods.

§ 281. *Has Congress Authority to legislate on Trade-Marks?* —It undoubtedly has. This naked question has not yet been presented to the court of last resort; but that court has given intimations which have thrice since been acted on by the law-making power. Said the court: "The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, is one which, in the present case, we propose to leave undecided. We adopt this course because, when this court is called on in the course of the administration of the law to consider whether an act of Congress, or of any other department of the government, is within the constitutional authority of that department, a due respect for a co-ordinate branch of the government requires that we shall decide that it has transcended its powers only when it is so plain that we cannot avoid that duty." The court in many cases has given a liberal construction of the term *commerce*, within the meaning of the Constitution. There is no difficulty in arriving at the

conclusion, that Congress has plenary power in the matter of trade-marks, as incidents of commerce. The act of 1870, although declared to be unconstitutional for one purpose, i. e. as a basis for the operation of the penal act of 1876 to punish the counterfeiting of trade-marks, &c., has a continuing vitality for other purposes. To what extent, has not been judicially or otherwise determined. By closely following the course of legislation subsequent to the decision of the Supreme Court, it will be seen that the act of 1870 was not in terms repealed by the law-making power, nor was it intended to be repealed. Congress, by its committees, took the ground that it needed only apt words of limitation. The executive branch of the government takes the same position. Registration, for what it was worth as evidence of a claim to priority, continued, notwithstanding the decision, until the act of 1881 reinvigorated previous legislative acts. — *Case*: The Minister of the German Empire, November 28, 1883, officially submitted to the Secretary of State of the United States certain interrogatories, one of which was this: "If persons have secured protection for their trade-marks, according to the law of July 8, 1870, only, have they lost such protection by the subsequent decision of the Supreme Court, declaring such law unconstitutional?" The Secretary of State communicated the matter to the Secretary of the Interior, who in turn referred it to the Commissioner of Patents, to whose province it especially belongs. His opinion — lucid and satisfactory — was concurred in by all concerned, and received the sanction of the German government, and was practically applied by the foreign tribunal from which the interrogatories had emanated. The facts are as follows. A manufacturing firm of citizens of the United States, doing business at Poughkeepsie, N. Y., applied to the *Handelsgericht* (Tribunal of Commerce) at Leipsic, Germany, for registration of a trade-mark for reaping and mowing machines. Section 20, subsect. 2, of the trade-mark law of the German Empire of November 30, 1874, requires proof that foreign applicants have fulfilled, in their native country, all conditions precedent to registration. As evidence thereof, the applicants presented their certificate of

registration in our Patent Office.<sup>1</sup> It was objected to, and the question thus raised. The official response of our government, on the point above mentioned, in a condensed form, was this: The effect of the decision of the Supreme Court was to deprive Federal courts of jurisdiction in a criminal case. The trade-mark convention of June 1, 1872, between this country and the German Empire, guaranteed reciprocity of protection. The German law above referred to requires certain formalities. The act of 1870 afforded the means whereby American citizens might furnish evidence required in other countries, and foreigners might also avail themselves of protection guaranteed by treaties, conventions, &c. To this extent at least, it was an act to carry out the treaty stipulations; and while Congress may have exceeded its jurisdiction in attempting to protect trade-marks in commerce within individual States, it certainly had power to legislate for the purpose of affording *evidence* of rights. There was no inhibition on the Patent Office from continuing to register and furnish certificates. On the contrary, Congress continued its annual appropriations to pay the salary of the only officer created to carry out the provisions of the act. — On this precise point, the language of Mr. Justice Miller, in pronouncing the opinion of the Supreme Court, was quoted,<sup>2</sup> to show that, for purposes other than those before the court, and pre-eminently for securing protection abroad, the operation of the machinery created by the statute of 1870 had lost none of its validity.

§ 282. The grounds of the unconstitutionality of the act of 1870 have been made clear. As was said by the Supreme Court in another case, “Congress cannot be supposed to have intended a vain thing.”<sup>3</sup> It had asserted an inherent power, without sufficiently limiting the sphere of its operation. The error was in the omission of apt words, to guard

<sup>1</sup> Re *Adriance, Platt, & Co.*, certificate No. 5480, dated January 8, 1878.

<sup>2</sup> “In what we have here said, we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of Congress to pass any laws necessary to carry any such treaties into effect.” — *Trade-Mark Cases*, 100 U. S. 99.

<sup>3</sup> *Heydenfeldt v. Davey, &c. Mining Co.*, 93 U. S. 634.

against trenching on reserved rights of the States. Since the inartificially drawn instrument has been expunged, Congress has thrice asserted the power, and has guarded against the former generality in phraseology. Now can intelligibly be discussed the corrected act,—Chapter 138 of the Supplement to the Revised Statutes of the United States, entitled, “An Act to authorize the Registration of Trade-Marks and protect the same,” approved March 3, 1881.<sup>1</sup>

§ 283. *By whom and how Registration may be obtained.* — “Be it enacted by the Senate and House of Representatives of the United States in Congress assembled, That owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes,<sup>2</sup> which, by treaty, convention,<sup>3</sup> or law,<sup>4</sup> affords similar

<sup>1</sup> In reporting the bill to the House of Representatives, the Judiciary Committee used these words: “It re-enacts the Sections 4937–4974 of the Revised Statutes almost *verbatim*, except that its operations are confined to trade-marks used in commerce with the Indian tribes and foreign nations.”

<sup>2</sup> These two absurd words, “or tribes,” were not in the original bill. It is not a brilliant conception that Sioux, Diggers, Nez Percés, or even the less savage tribes, can by trade-mark treaties afford reciprocal protection.

<sup>3</sup> The following is a list of the countries with which we have treaties, conventions, or agreements on this subject, with references to the books in which the full texts may be found.

COUNTRY.	DATE.	REFERENCE.
Austro-Hungarian Empire . . . . .	June 1, 1872	17 Stat. 917
Belgium . . . . .	July 30, 1869	16 Stat. 765
Do. . . . .	July 9, 1884	20 O. G. 452
Brazil . . . . .	Sept. 24, 1878	21 Stat. 659
France . . . . .	April 16, 1869	16 Stat. 771
German Empire . . . . .	June 1, 1872	17 Stat. 921
Great Britain . . . . .	July 17, 1878	14 O. G. 233
Italy . . . . .	March 19, 1884	27 O. G. 304
Russian Empire . . . . .	June 27, 1868	16 Stat. 725
Servia . . . . .	Dec. 27, 1882	22 Stat. 966
Spain . . . . .	April 19, 1883	25 O. G. 98
Switzerland . . . . .	May 16, 1883	23 O. G. 2237
The Netherlands . . . . .	Feb. 16, 1883	23 O. G. 1334

<sup>4</sup> In several countries, e. g. Switzerland, the Netherlands, and Japan, the laws are so formed as to afford reciprocal privileges by means of the mere exchange of diplomatic notes.

privileges to citizens of the United States, may obtain registration<sup>1</sup> of such trade-marks by complying with the following requirements:— First. By causing to be recorded in the Patent Office a statement specifying name, domicile,<sup>2</sup> location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.”

§ 284. *Owners.* — This word is definite and certain. In the act of 1870 are found the mischievous words, “or who intends to adopt and use.” The right to a trade-mark rests exclusively on actual adoption, i. e. the affixing of the emblem or symbol to merchandise; for an abstract symbol cannot in the nature of things be a trade-mark. One cannot be such owner until his goods bear the mark of which he claims the exclusive use. The word “owner” comprehends any person, firm, voluntary association, or corporation, engaged in the commerce mentioned; and includes not only the original adopter, but also an inheritor, or a successor in business, or an assignee.

§ 285. *Why limited to Commerce with Foreign Nations or with the Indian Tribes.* — The bill, when introduced into the House of Representatives, used the exact words of the third paragraph of the eighth section of the first article of the Constitution. The sub-committee having it in charge, partly through a misconception of the ruling of the Supreme Court, as is manifested by their report, and partly through a fear, which at that time had seized possession of some minds, as to national legislation having a tendency to interfere with the reserved rights of individual States, struck out the words

<sup>1</sup> “Protection” is the misleading word in the act of 1870.

<sup>2</sup> See §§ 291 *et seq.*

“and among the several States.”<sup>1</sup> To insist upon a restoration of these words at that time must have jeopardized the passage of the bill. The Senate would have corrected the error; but the slightest amendment must inevitably have defeated final action, as the term of Congress was near its expiration.

§ 286. *Treaty, Convention, or Law.*—The generic term “treaty” might not be deemed sufficiently clear. The stipulations on the subject bear various names. For examples, see the contract of 1868 with Russia, which is styled a *treaty*, as is also that of 1869 with Belgium; that of 1869 with France is styled a *convention*; that of 1878 with Great Britain, a *declaration*; and that of 1879 with Brazil, an *agreement*. *Law* is, therefore, the broadest term that can be used to express the matter, for within the spirit and reason of this act it may be said to include all kinds of governmental provisions on the subject. Reciprocity of protection is the object in view. Some nations have laws on the subject, written or unwritten, where no discrimination is made against those who are commercially our fellow citizens. The doctrine of commercial citizenship, as contradistinguished from that directly involving allegiance or political fidelity, is recognized by several nations besides our own.<sup>2</sup>

§ 287. This phraseology was conceived in a liberal spirit, looking to the encouragement of reciprocity. The Office has given to these words a very liberal construction; and, in all cases when the full scope and intent of a treaty of commerce is somewhat dubious, it presumes in favor of the applicant. Thus, where a British subject, resident in his own country, applied for registration, it was held that the English act of

<sup>1</sup> Of course, all persons will understand that this limitation does not affect common-law rights, although it excludes mere inter-state trade-marks from registration.

<sup>2</sup> As an illustrative instance, Art. 6 of the Belgian law of April 1, 1879, is in point: “Foreigners, who conduct in Belgium establishments of industry or of commerce, enjoy for the products of such establishments the benefit of the present law, by complying with the formalities that it prescribes. . . . It is the same with foreigners or Belgians who conduct beyond Belgium their industry or commerce, if, in the countries where their establishments are located, international conventions have stipulated reciprocity for Belgian trade-marks.”

Parliament entitled, "The Merchandise Marks Act of 1862," was equivalent to a convention. Indeed, the right of an alien friend to protection in the English courts did not depend upon the passage of that statute, for in many instances previous thereto, the said courts had recognized and enforced the doctrine.<sup>1</sup> In *Pisano v. Lawson*,<sup>2</sup> it was shown that at law, as well as in equity, an alien friend, not at any time a resident in England, might maintain a personal action for an injury done within the realm. It was held by Woodbury, J., in the United States Circuit Court for the District of Massachusetts, in 1846,<sup>3</sup> that British subjects had the same privileges in our judicial tribunals as our own citizens. The third article of our treaty of 1794, with England, gives the people of both powers the authority "freely to carry on trade and commerce with each other." "So," said that learned judge, "we are under treaty obligations to Great Britain, and most other European powers, to admit their merchandise on favorable terms, and to allow their merchants to trade here as those of favored nations. But it would be a mockery of such provisions and engagements, if we prevented them from selling their goods after arriving here (Ch. J. Marshall, in *Brown v. State of Maryland*, 12 Wheat. 447), unless noxious to health or morals; or if we made onerous discriminations against them, or prevented their receiving the proceeds of their goods, or abstained from yielding protection against injuries to them, or to their marks." This doctrine had previously been asserted by Story, J., in the same court.<sup>4</sup> Mr. Justice Woodbury, in the case above cited, said that an alien is not now regarded as "the outside barbarian" he is considered in China, and the struggle in all commercial countries for some centuries has been to enlarge his privileges and powers as to all matters of property and trade. So, too, heavy taxation of alien merchants was guarded against in Magna Charta, allowing them "to go and come, and buy and sell, without any evil tolls." It is hence, undoubtedly,

<sup>1</sup> *Collins Company v. Brown*, 3 K. & J. 423; *Collins Company v. Cohen*, id. 428; 5 W. R. 676.

<sup>2</sup> 6 Bing. N. C. 90.

<sup>3</sup> *Taylor v. Carpenter*, 2 Wood. & M. 1.

<sup>4</sup> *Taylor v. Carpenter*, 3 Story, 458.



that Montesquieu observed, that "the English have made the protection of foreign merchants an article of their national liberty"; and Thompson on Charters, p. 232, says, that once they enjoyed it even in war, "in common with the clergy and husbandmen, in order that those who prayed, ploughed, and trafficked might be at peace." Lord Ch. J. Hale said, so long ago as his time, that "the law of England rather contracts than extends the disability of aliens, because the shutting out of aliens tends to the loss of people, who, when laboriously employed, are the true riches of any country." Therefore, when we consider the spirit and reason of this law, which are the promotion of reciprocity, it would be manifestly illiberal, if not positively unjust, to refuse registration of the mark of a resident of England. We need not hesitate because the subjects of marks of commerce are not mentioned *eo nomine* in any treaty with England, nor in any convention; but, upon the principle of international comity, the presumption should be in favor of the residents of that country. It should be observed that the word "citizen" or "subject" of a foreign country is not used in the act of 1870; the language is, "any person, firm, or corporation resident of or located in." A citizen of the United States *resident* in such foreign country was, therefore, for the purposes of this act, deemed a foreigner. "Owner" is the term used in the act of 1881.

§ 288. Among commercial nations, there is a growing tendency to a general recognition of the emblems of commerce known as trade-marks; for such recognition operates as a safeguard against fraud on their own communities. Hence the many treaties and conventions upon this subject, and the liberal views entertained by the judicial courts of nearly all the enlightened countries. By the term "convention" we mean all kinds of contracts less formal than a treaty, and all pacts, understandings, or agreements,<sup>1</sup> the leading idea being the interchange of amicable relations and dealings. All nations are not alike liberal in respect to this matter, and require something more than a tacit understanding. Although a Frenchman in England had his rights as carefully protected

<sup>1</sup> Bouvier's Law Dict.; Webster's Dict., title Convention.

in the courts of that country as if he were a British subject, independently of any treaty or compact, the French nation did not display a similar spirit of justice to Englishmen. Rowland & Son, of England, sued in France for an infringement of their trade-mark. The court refused them redress because they were undomiciled foreigners. The cases of Stubs and of Spencer were decided against Englishmen on the same ground. The same ruling seems to have been uniformly made in the cases of all other foreigners under the same circumstances. In March, 1856, the Tribunal of Commerce of the Seine,<sup>1</sup> in an infringement case, held, that, inasmuch as the complainant, Jean Marie Farina, of Cologne-water fame, was a foreigner, not admitted to establish his domicile in France, conformably to Art. 13 of the Code Napoléon, and as he had not proved that the civil rights he demanded were accorded by his nation to Frenchmen, his case must be dismissed. This course was taken, although the court admitted that his proprietary mark for his flasks of *eau de Cologne* had been recognized by numerous judgments and injunctions, and the defendant intended to continue the piratical use of it and the name of the complainant. Our countrymen met with a reception quite as unfavorable. In the Court of Paris, in 1867,<sup>2</sup> the complainant, Kemp, an American, proprietor of "Florida Water" (*Eau de la Floride*), sold as "Agua Florida," had obtained in the court below a judgment for infringement of his trade-mark. It was held by the appellate court that, by Arts. 11 and 13 of the Code Napoléon, the foreigner, not permitted by authorization of the Emperor to establish his domicile in France, could enjoy only those rights accorded to Frenchmen by treaty with the nation to which such foreigner belongs.

§ 289. Whether a member of an Indian tribe resident within the territory of his nation, and subject to its laws, would be regarded as included within the provisions of this statute of 1881, is a question that may arise, but has not been officially passed upon. The language of Article I., sect. 8, subdiv. 3, of the Constitution, seems to imply that a treaty would be

<sup>1</sup> Farina *et al.* v. Camus, 2 Annales, 159.

<sup>2</sup> Kemp v. Herman, 13 Annales, 298.

necessary for the regulation of commerce with such tribes; and this law relates to commerce.<sup>1</sup>

§ 290. *Name.* — The rule of strict legal practice obtains in cases under the law. It is contemplated that the full name of every applicant shall appear in the statement, and with as much particularity as in a case of conveyance of lands.<sup>2</sup> Of course, one's autograph signature may be condensed, but even then mere initials are always more or less objectionable. J. Styles may mean James, Jedediah, Joseph, or John Styles, and thus raise a question of identity. If the applicant be a corporation, its full and exact title should be specified, with a reference to the State or nation under the laws of which it is incorporated.

§ 291. *Domicile.* — In certain cases, domicile is an essential prerequisite to registration; and, being essential, it should be set out in the application papers. When not averred distinctly, it will be inferred from circumstances. It is because the term "domicile" has not been understood, and has so often been confounded with a mere abiding-place, that the Office was led to demand an oath, showing of what country the applicant is a citizen, the same as in applications for patents.<sup>3</sup> The Office will then assume that a certain place or country is the party's domicile. What is the meaning of the word "domicile"? The definition of the term is not without difficulty; for although so many powerful minds have been applied to this question, there is no generally agreed definition of the word, nor any agreed enumeration of the ingredients which constitute domicile. Two things must concur to constitute it: first, residence; and, secondly, the intention of making a place the home of a person. There must be the fact and the intent. However, in many cases, actual residence is not indispensable to retain a domicile; but it is retained *animo solo* by the mere intention not to change

<sup>1</sup> See *Elk v. Wilkins*, 112 U. S. 94, as to the status of an Indian who has voluntarily separated himself from his tribe, but who is not naturalized.

<sup>2</sup> General Rule 43 of the Patent Office prescribes that full names of applicants and witnesses, in patent cases, must be given; and Trade-Mark Rule 4 also requires full names.

<sup>3</sup> Patent Office Regulation, Feb. 29, 1872.

it, or adopt another. Thus, if a person should go on a voyage, or to a foreign country, for health, or for pleasure, or for business of a temporary nature, with an intention to return, such a transitory residence would not constitute a new domicile, nor amount to an abandonment of the old one; for it is not the mere fact of inhabitancy in a place which makes it the domicile, but it is the fact, coupled with the intention of remaining there, *animo manendi*.<sup>1</sup>

§ 292. There is sometimes no small difficulty in deciding upon the place of domicile, in a strict and legal sense. Residence is oftentimes of a very equivocal nature, and an intention to return to a former residence is still more obscure. Both are sometimes to be gathered from slight circumstances of mere presumption, and from equivocal and conflicting acts.<sup>2</sup> Thus, at the Federal seat of government there are many office-holders in the civil service who claim domicile in States from which they have been absent many years, and in which they hold but the shadow of a nominal residence; and yet they assert and frequently exercise the right to vote in their respective States, just as our ministers to foreign courts and soldiers and sailors may do, when they return to homes from which they have long been absent. To complicate the question as to their fixed, true, and permanent residence, these office-holders sometimes voted at the municipal elections in the District of Columbia; and their right to do so has been maintained by high legal authority. Yet an inhabitant of one State does not acquire a domicile in another by merely coming to the latter to seek employment, with the intention of residing there only if he should find it.<sup>3</sup> In *Abington v. North Bridgewater*,<sup>4</sup> the learned Chief Justice Shaw said truly, that "Every one has a domicile of origin, which he retains until he acquires another, and the one thus acquired is in like manner retained. The supposition that a man can have two domiciles would lead to the absurdest consequences. If he had two domiciles within the limits of distant sovereign states, in case of war, what would be an act of imperative

<sup>1</sup> Story, Conflict of Laws, § 44.

<sup>3</sup> Ross v. Ross, 103 Mass. 575.

<sup>2</sup> Ibid., § 45.

<sup>4</sup> 23 Pick. 170, 177.

duty to one would make him a traitor to the other." He might thus, during a period of hostilities, become an enemy to himself, or be bound to do personal service in two military districts of the same State at the same time; or in two countries be compellable to serve on juries at the same moment; or, as in our late civil war, be held to duty as a conscript in one district when the quota of troops had actually been filled by him in another.

§ 293. Every person must have a domicile somewhere. First, the place of birth of a person is considered to be his domicile, if at the time of his birth it was the domicile of his parents. If his parents are then on a visit, or on a journey (*in itinere*), the home of his parents (at least if it be in the same country) will be deemed the domicile of birth or nativity. Persons born out of the limits and jurisdiction of the United States, whose fathers were at the time of their birth citizens of the United States, are citizens of the United States; but the rights of citizenship shall not descend to persons whose fathers never resided in the United States,<sup>1</sup> for their domicile would be abroad. An illegitimate child follows the condition of his mother. A child born on the high seas has his domicile in the country of his parents. The domicile of birth of minors continues until a new one is obtained. Minors are generally deemed incapable, *proprio Marte*, of changing domicile, and retain the domicile of their parents; and if the father die, his last domicile is that of the minor children. A married woman follows the domicile of her husband; but sometimes she may obtain one different from his, and institute proceedings for divorce.<sup>2</sup> A widow retains the domicile of her deceased husband until she obtains another domicile. *Prima facie*, the place where a person lives is taken to be his domicile until other facts establish the contrary. When one removes to another place, with an intention to make it his permanent residence, it instantaneously becomes his place of

<sup>1</sup> Act of Congress, Feb. 10, 1855.

<sup>2</sup> *Cheever v. Wilson*, 9 Wallace, 109. See authorities cited in Story, *Conflict of Laws*, note to § 46. See also Dr. Lieber's article "Domicile," in the *Encyclopædia Americana*.

domicile; and that although he may entertain a floating intention to return at some future period to his old home. It has so been considered in relation to the Chinese immigrants in the States of the Pacific, who nearly all hope to return to China during life, or to have their remains removed thither after death. The place of residence of a man's family is generally to be deemed his domicile, unless it be only a place of temporary establishment for his family. Residence, to produce a change of domicile, must be voluntary. If, therefore, it be by constraint, banishment, arrest, or imprisonment, the antecedent domicile remains; as in the case of the many thousand French soldiers who retreated into Switzerland, during the late war between their nation and Germany, and also that of Don Carlos, who more recently retreated with some of his soldiers into France from Spain. The removal was not a matter of choice. Still, probably, any of those persons could obtain a domicile by declaring an intention always to remain in the land of exile.<sup>1</sup>

§ 294. There is a *forensic* domicile (*forum domicilii*), or place where one can sue and be sued. It may happen, and it often does, that the political, the civil, and the forensic domicile are the same; but this is a matter not so much of general principle as of positive legislation in different countries. A person who resides in a foreign country for purposes of trade, is deemed an inhabitant of that country by foreign nations; and his character changes with that of his country. In peace he is deemed a neutral, in war an enemy; and his property is dealt with accordingly in prize courts.<sup>2</sup> The main point is this: Does the claimant, by engaging in manufacturing and commercial pursuits in our country, add to its prosperity and wealth? If so, this statute will give him additional protection and privileges. The policy of the law is to enhance our national prosperity. He whose actions have not that tendency cannot reasonably claim an advantage over any one else. As an example of the practical working of this theory, we will take a case recently submitted for advice.

<sup>1</sup> See title "National Domicile," Story, Conflict of Laws.

<sup>2</sup> *The Venus*, 8 Cranch, 278.

A native of the State of Rhode Island, a natural-born citizen of the United States, and still such citizen, continued to reside in this country for many years after attaining his majority. For about eighteen years he had been established in China, as a tea-merchant, and exported largely to this country. He desired to register his trade-mark for teas, but entertained doubts of the feasibility of his wish, on the ground of want of domicile. He was informed by the Patent Office, that, so far as the statute is concerned, he must be regarded as a Chinese subject; and as China does not by treaty afford similar privileges to citizens of the United States, he could not avail himself of the provisions of this act. His able counsel acquiesced in this view, and so the matter ended.

§ 295. One effect of the law of national domicile may be this: it may affect the validity of the transfer of a trade-mark by assignment, as provided for in Section 12. If by the law of the place where a person has his domicile he is of legal age at the age of twenty, and has the faculty of disposing of his property there situate, the same faculty will extend to his property situate in another country, where he would not be capable of alienating until he had reached the age of twenty-five years.<sup>1</sup> For example: the modern Civil Code of France expressly declares that the laws concerning the condition and capacity of persons govern Frenchmen, even if residing in a foreign country. Thus French minors, incapable of binding themselves by engagements of commerce unless they are emancipated or authorized, cannot bind themselves in commercial transactions in a foreign country, even when the law of that country does not require the like conditions. So does the personal incapacity of French married women follow them everywhere, so far as the French tribunals are concerned.<sup>2</sup> Any man obtaining an assignment of a trade-mark would prefer to be assured that he might assert his title the world over.

§ 296. *Location.* — This refers to the place where the business is carried on, which may be other than that of the place

<sup>1</sup> Story, Conflict of Laws, § 54.

<sup>2</sup> Pardessus, De Droit Commercial, vol. v. art. 1482, p. 248.

of domicile. Again, domicile may not be a fact involved, as in the case of a corporation. At all events, it must appear of record where the manufactory or mercantile house is situated; that is, in what country, or state, city, village, or even county. The office has never understood it to be necessary to state the street, or other exact locality.

§ 297. Citizenship is not an element to entitle or debar from registration under this statute. The question of fealty or allegiance does not arise. The citizen of the United States, resident and in commerce in a foreign country, — and if not in commerce why have a trade-mark? — is adding to the wealth and prosperity of that foreign country. He has there thrown in his lot. Commercially, he is a citizen of that country.<sup>1</sup> To be sure, he can resume his prior status. If he do not choose so to do, let him use his influence to secure to all of his fellow-citizens of the United States the privileges he now seeks here. One may for half a century have been a trader in the city of New York, and not be included within the meaning of this act; or he may not yet have been in the United States for more than an hour, and be included. What was his intention as to permanency?

§ 298. Let us consider a hypothetical case, to illustrate the idea of the necessity of a strict compliance with the statute and the rules of practice. The late Mr. Nicholas Bodisco, who died in 1872, while connected with the Russian Legation at the Brazilian Court, was born in Georgetown, D. C., in 1844, his mother being a natural-born citizen of the United States. Suppose that that gentleman had embarked in mercantile business in the city of Washington, and had applied for the registration of a trade-mark. Would it have been sufficient for him to merely allege his residence in Georgetown, and his place of business in Washington? No. He should also have averred his place of domicile, for such is a material fact, and therefore should always be alleged. Why? Because our government, and the public at large, have a right to know the exact status of every one to whom protection is

<sup>1</sup> *Field v. Adreon*, 7 Md. 209; *Risewick v. Davis*, 10 Id. 82; *Drake on Attachments*, § 59 a.



conditionally promised by this legislative enactment. If he had then alleged his domicile, the fact would have transpired that his domicile was in Russia. Why so? Because, at the time of his birth, his father was Envoy Extraordinary, &c. of the Emperor of Russia, and in legal contemplation his domicile was that of his father; and not having renounced his allegiance to his own country, but actually continued in the diplomatic service, he had not acquired a domicile here. The object of registration is protection in our courts; and the right to that protection might at any time be suspended by the supervention of a state of war between the countries. He would take the certificate, if at all, under an existing treaty, and subject to all legal conditions and contingencies.

§ 299. The national character which a man gains by residence may be thrown off at pleasure by a return to his native country, or even by turning his back on the country in which he has resided, on his way to another. It is an adventitious character gained by residence, and which ceases by mere residence.<sup>1</sup> It is manifest that the fact of mere citizenship is not conclusive on the question of domicile. An Englishman came to this country, and became naturalized, and two years afterward returned to England, where he continued to reside for sixteen years, with the exception of a few months spent in visiting this country. *Held*, that he must be regarded as having again become a British subject.<sup>2</sup> The same doctrine was held in the Supreme Court of the United States in 1814,<sup>3</sup> where a naturalized citizen, in time of peace, returned to his native country for the purpose of trade, but with the intention of returning to his adopted country. He remained in his native country for a year after the beginning of the war between the two countries; but only for the purpose of winding up his business. *Held*, that he had gained a domicile in his native country. In still another case, a residence of thirteen years in an enemy's country was held sufficient to invest the party with the character of an enemy.<sup>4</sup> In the civil war

<sup>1</sup> *The Venus*, 8 Cranch, 253 (1814).

<sup>2</sup> 2 Paine, 601.

<sup>3</sup> *The Frances*, 8 Cranch, 335.

<sup>4</sup> *Rogers v. The Amado*, 1 Newb. 400.

in the United States, property was condemned on the ground of domicile only. It was decided, first, that if a place was in the firm possession and under the control of the rebel enemies, it was, for the time, and in the technical sense of the prize law, enemy's territory; secondly, that the property of a person domiciled in that place at the time of capture was liable to condemnation as enemy's property, in the sense of the prize courts; and lastly, that although the owner was a citizen of the United States, and had always resided in that place, which was held to be of right a part of the United States, and of right a proper place of residence to constitute citizenship of the United States, yet the property of such a person was to be condemned without inquiring whether he was or was not, in his intentions or acts, loyal or disloyal. The same rule was applied to the property of foreigners domiciled in such places.<sup>1</sup>

§ 300. *Class of Merchandise.* — Much carelessness is manifested in the use of generic for specific terms. A general description of one's whole stock in trade is too loose and indefinite; for example, "groceries," "hardware," "perfumeries," "medicines," "oils," &c. The statute requires the *particular* description of goods; and if that be not given, a valid foundation will not have been laid for an action at law or suit in equity; and a court would probably reject the certificate of registration, just as it would a patent with a vague, indefinite specification of an invention or discovery. A man may affix the same symbol to many different articles; but in all cases he must be prepared to show the actual application of the mark or symbol to the article on which a rival shall have used it. It is true that applicants sometimes prefer such sweeping, comprehensive descriptions. The risk is their own. In one case in court,<sup>2</sup> the plaintiff — a corporation — conceded that it had never manufactured prints; but because it had placed its trade-mark on everything in the way of cotton goods *except prints*, it insisted that it also had the right to place it

<sup>1</sup> The Prize Cases, 2 Black's Rep. 635; Amy Warwick, 2 Sprague's Decisions, 2, and 24 Law Reporter, 335, 494.

<sup>2</sup> Amoskeag Manufacturing Co. v. Garner, 55 Barb. 151.

there, and that if any other person, however honestly, placed the same mark upon prints, it would be an infringement. The idea of the corporation was, that the class of cotton goods was broad enough to cover everything that might possibly be made out of cotton, however unlike their products. The judge who had the cause before him said: "I deny emphatically that the doctrine of trade-marks is capable of indefinite expansion; that where a word of meaning, a geographical word, is used as a trade-mark, and first applied to one branch of manufacturing cotton goods, when there are subsequently invented several distinct branches to it, like Aaron's rod, it swallows up all the subsequent branches. The doctrine of trade-marks must not be extended beyond its just limits; or, in a country like ours, filled as it is with enterprise, capital, skill, inventive genius, and with men possessed with progressive ideas, it will, in the end, be productive of greater injury than good."

§ 301. It seems scarcely necessary to remark that this statute is applicable to *merchandise* alone, — something to be sold, and not to be given away. The plaintiff claiming protection must prove that he has an exclusive right to use a particular mark or symbol in connection with some manufacture or vendible commodity; and, secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff's custom, and injure him in his trade or business. There is not any exclusive ownership of the symbols which constitute a trade-mark, apart from the use or application of them to a vendible commodity.<sup>1</sup> This is the settled doctrine of all the courts. Any other view of the matter would be wildly absurd. A symbol does not become a trade-mark until actually stamped upon or otherwise affixed to goods to be sold. It would not therefore be correct for one to say that his trade-mark is stamped upon his business cards, or other mere advertisements; for the impression of the symbol would be nothing more than a fac-simile or copy of his trade-mark. The public do not purchase signs, or circulars, or cards of business; but they buy the article of mer-

<sup>1</sup> The Lord Chancellor in the *Leather Cloth Co.* case, 11 Jur. (n. s.) 513.

chandise bearing upon it a certain known mark of genuineness. Yet, for all this, the dictates of common sense are set at defiance by solicitors, who will not think, How can a thing be a trade-mark if not used in trade? How can one's property be protected if he have no property?

§ 302. Lest the proposition enunciated above should not be considered authoritatively given, let us consult the Bench. Ludlow, J., in 1860,<sup>1</sup> said as follows: "It may be remarked, in general, that while an imitation or fac-simile, or a mere colorable artifice, will bring the offending party clearly within the rule, no decision has ever yet declared the right of a manufacturer to be absolute in a *name* as a *name* merely; it is only when that name is printed in a particular manner upon a particular label, and thus becomes identified with a particular style of goods, or when a name is used by a defendant in connection with his place of business (and not his manufactured goods), under such circumstances as to deceive the public and rob another of his individuality, and thus destroy his fame and injure his profits, . . . that it becomes a *trade-mark*, or in the nature of a trade-mark, and as such entitles its possessor or proprietor to the protection of courts of justice." Vice-Chancellor Wood, of England, in 1865,<sup>2</sup> said substantially that the law on this point, as laid down in the cases before Lord Westbury,<sup>3</sup> is as follows, and that he did not think that any one would be disposed to dissent from it. This court has taken on itself to protect a man in the use of a trade-mark as applied to a particular description of article. He has no property in that mark *per se*, any more than a person has in any fanciful denomination which he may assume for his own particular use without reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and when he has caused his goods to circulate with that mark, when that mark has become the known *indicium*

<sup>1</sup> Colladay v. Baird, 4 Phil. 139.

<sup>2</sup> Ainsworth v. Walmesley, 44 L. J. 252.

<sup>3</sup> Millington v. Fox, 3 Myl. & Cr. 338; Hall v. Barrows, 10 Jur. (n. s.) 55.

of their being his, the court has said that nobody shall defraud him by using that mark, and passing off the goods of another's manufacture as being the goods of the owner of the mark. And the Lord Chancellor in the same year said: "It is correct to say that there is no exclusive ownership of the symbols which constitute a trade-mark apart from the use or application of them; but the word 'trade-mark' is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such use or application is rightly called 'property.'"<sup>1</sup> This rule is as rigid and unalterable as the laws of the Medes and the Persians.

§ 303. *The Description* of the trade-mark itself should be so lucid and comprehensive, that the language of the statement or specification should require no extraneous aid in its interpretation, to identify the appropriate device, emblem, or symbol. The words "as shown in the drawing and fac-similes hereto annexed," or equivalent forms of expression, do not suffice; as in point of fact a fac-simile seldom appears in the body of the specification, unless it consists of words only, but with a copy of the specification is attached to the certificate of registration. In practice, sometimes a block or electrotype is furnished by the applicant for the purpose of being printed in the specification. An allegation that "the trade-mark consists of the representation of a schooner-yacht under full sail, in connection with the words *Middlesex Yacht-cloth*, as is more fully shown in the fac-simile hereto annexed," has been held to be unobjectionable.<sup>2</sup> Sometimes the so-called fac-simile consists principally of fanciful groupings of human or other figures, of pictures of ships and railway trains, and a number of words, while the essential feature lies in a single fancy word. The verbal description, that is, the phraseology of the statement, is therefore the only true guide; for a full, clear, and accurate description, distinguishing essentials from non-essentials, is a pre-requisite to registration.<sup>3</sup>

<sup>1</sup> *Leather Cloth Co. case*, 11 Jur. (n. s.) 513.

<sup>2</sup> *Re Middlesex Co.*, Registration No. 655.

<sup>3</sup> *Re Volta Belt Co.*, 8 Off. Gaz. 144.

§ 304. *Fac-similes*. — Rule 9 for trade-mark applications prescribes that, where a trade-mark can be represented by a fac-simile which conforms to the rules for drawings of mechanical patents, such a drawing may be furnished by applicant, and the additional copies will be produced by the photolithographic process at the expense of the Office. Or the applicant may furnish one fac-simile, mounted on a card ten by fifteen inches in size, and ten additional copies upon flexible paper, not mounted; but in all cases the sheet containing the mounted fac-simile or the drawing must be signed by the applicant or his authorized attorney, and authenticated by two witnesses. — All this is very plain, but cases sometimes occur that puzzle the Office greatly. What is a fac-simile? Skeat's Etymological Dictionary defines it as follows: "An exact copy. Short for *factum simile*. 'Copied *per factum simile*'; see quotation in Todd's Johnson. — Lat. *factum*, neut. of *factus*, made; and *simile*, neut. of *similis*, like." Webster's Dictionary gives substantially the same derivation, and adds: "An exact copy or likeness, as of handwriting." Worcester's Dictionary further gives: "That which is made exactly like; an exact copy of any writing, engraving, or other work of art." It is not so easy to define the term as used in the statute. Where an applicant claims any device, such as may be, and generally is, printed on labels, there is no difficulty; for the thing presented is necessarily exactly like other impressions from the same type, plate, or block. But where the symbol is moulded in the glass of bottles, or stamped by a die in heavy metal, then the rule of common sense requires that as exact a copy as possible under the circumstances should be made on paper, so as to be attached to the statement, just as in a design-patent application a drawing is made of ornamental configurations for bulky articles of manufacture, as stoves, furniture, or terra-cotta work. The object of the statute is sufficiently to describe and identify the mark, the right to the exclusive use of which is asserted. Instances come up where it is very inconvenient to attach a fac-simile to the certificate of registration. Take as an example the peculiarly formed stick of wood, made in two pieces, with the

ends shaped into octagonal rings, upon which certain carpet manufacturers were in the habit of rolling their carpets. The length of the said stick equalled the width of the carpeting. Yet that stick was registered as a trade-mark, and was subsequently recognized as valid in a suit in a Circuit Court of the United States.<sup>1</sup> The defendants in the suit began to roll their carpets on similar sticks, and an injunction was granted to restrain them from thus infringing the complainants' rights. — Or take another case, where the applicant set forth that to the neck of each bottle of his champagne wine he attached, by a ribbon, a miniature metallic bell.<sup>2</sup> That bell, intended exactly to represent the famous great bell of Moscow, constituted his trade-mark. If the bell were a portion of the merchandise, then it was not a technical trade-mark. But the merchandise consisted of wine. The Office suggested that a picture of the bell might be regarded as a fac-simile in the eye of the law. The applicant insisted that the certificate of registration to be issued to him should bear one of the eleven bells furnished as fac-similes. In the process of issuance of the document the bell was somewhat crushed, but it was attached to it as an aid to the verbal description. Other extraordinary cases may occur in practice, until it shall be judicially settled as to what is a compliance with the statute.

§ 305. *Mode of Application or Use of Mark.* — This may be set forth thus: “by marking each article with blue ink by means of a stencil-plate”; “by printing the mark upon tags to be fixed to the cloth”; “by branding the top of each box containing the goods with a hot iron”; “by painting or stencilling the mark upon each article”; or in any other language which will clearly show the mode of affixing the same. Sometimes, the articles intended to be protected are too minute to bear the mark, as needles, when the box will perform that office; or pins, when the paper in which they are fastened will serve the purpose; and so of a myriad of those articles

<sup>1</sup> Lowell Manufacturing Co. v. Larned, Cox's Manual, case 428; Codd. Dig. 341.

<sup>2</sup> Re Charles Narcisse Farre, Certificate No. 8,939.

to which the emblem cannot be affixed, except by means of envelopes, wrappers, boxes, and other enclosures.

§ 306. *Length of Time of Use.*—This means the period during which the symbol has been applied and affixed to merchandise sold, or offered for sale, the only possible way in which a trade-mark can be used. If it has not so been used at all by the applicant, or by the person or persons under whom he claims by succession or assignment, then the application for registration must fail. Preciseness on the point of fixing date of adoption in that way may be an important item, especially in a contest for ownership. Priority may be but of a single day. A neglect accurately to state the length of time may operate as an estoppel in the event of conflicting claims of title. One who does not date back as far as he truthfully might, with extremely rare exceptions, finds it to be impossible afterwards to correct the error of the record that he has made. On the other hand, if he state that he has used the mark for ten years, and the proof be that he has used it but five, would not that be evincive of bad faith? Here is a matter that should carefully be looked into by an applicant before registry, and by his antagonist at a trial of title: Has the application, as originally filed, alleged a certain time of use which is afterwards sought to be varied?<sup>1</sup> The statute requires an oath, or its equivalent, that the applicant has at the time of application a right to the use of *the* trade-mark. What trade-mark? Clearly, that which was used for the time alleged. But suppose that, after filing the case, by reason of an afterthought, the description is amended so as to materially change the description of the symbol itself, and no new verification has been made. An irregularity in this respect may be fatal to a plaintiff who relies on his registry to establish title. The requirement of a verification is mandatory.

§ 307. *Government Fee.*—The payment of the sum of twenty-five dollars is an essential pre-requisite. An application is not

<sup>1</sup> In a suit in North Carolina, involving the title of a very valuable trade-mark, this very point has been raised. *McElwee v. Blackwell*, Iredell Superior Court, still pending in 1885.



deemed to be filed until that is done. The fee may be paid to the Commissioner direct, in current funds, or by a postal money-order, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositories, national banks, or receivers of public moneys designated by the Secretary of the Treasury for that purpose, who will give the depositor a receipt or certificate of deposit therefor, to be transmitted to the Patent Office. The payment of this fee is not by instalments, as in applications for patents. When once paid, it is not a pledge or deposit of the money, but an absolute and unconditional payment into the treasury;<sup>1</sup> and it cannot be reclaimed unless paid through actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the Office. A mere change of purpose on the part of the applicant will not be sufficient to entitle him to a return.<sup>2</sup>

§ 308. *Regulations prescribed by the Commissioner.* — Although the Patent Office is a bureau of the Department of the Interior, it seems that it was intended that the officer charged with the registry of trade-marks should be alone responsible for regulations. That was so in the Registration Act of 1870. It may be that the Revised Statutes, making the establishment of regulations in general subject to the approval of the Secretary of the Interior, operated as an amendment thereof. Be that as it may, the present law places the matter in charge of the Commissioner alone. This may become an important point, as regulations have all the force of statutory enactments, and, until repealed, are as binding on the Office as on private parties.<sup>3</sup> As a matter of practice, regulations in trade-mark matters are submitted to the Secretary for approval, but probably they would not be void if not approved by him. The regulations are published in a pamphlet separate from the general rules of patent practice.

<sup>1</sup> 9 Opinions of Attorneys-General, 64.

<sup>2</sup> Patent Office, Rule 215; Rev. Stat., sect. 4936.

<sup>3</sup> *Arnold v. Bishop*, MSS. Appeal cases, Cranch, Ch. J., D. C. 1841; also *O'Hara v. Hawes*, MSS. Appeal cases, Morsell, J., D. C. 1859.

§ 309. *Application must be verified, and what the Declaration must contain.* — “Sect. 2. That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and fac-similes presented for registry truly represent the trade-mark sought to be registered.”

§ 310. “*Create any right.*” — That is, a right of using it in evidence, or as the foundation of an action or suit. The verification may be by oath, or affirmation, or any equivalent, in accordance with the laws or religious observances of any nation in which it may be made.

§ 311. *How verified.* — The mode of making the verification has necessarily been left to the discretion of the applicant. It is an asseveration made under the solemnity of an oath, or affirmation, or some act equivalent thereto, for it may be that in some countries general oaths are by law abolished, and a declaration substituted. The provision of Trade-Mark Rule 7 of the Patent Office, that “the declaration should be in the form of an oath,” is therefore applicable only to those who have no scruple against taking an oath.

§ 312. *The Manner of administering the Oath,* affirmation, or its substitute by whatever name it may be called, must, of course, be left to circumstances, and national, local, or religious peculiarities and customs. Peoples of all nations, tongues, and creeds come within the contemplation of this law. No distinction can be made in a commercial matter between Christians and Buddhists, Confucians, or semi-savage idol-worshippers. The affirmation or the equivalent of an oath may be made in the United States before any officer author-

ized to administer oaths for general purposes, as justices of the peace, notaries public, commissioners of deeds of cities, or of judicial courts, and clerks and judges of the same; or, in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent holding a commission under the government of the United States, or before a notary public of the foreign country in which the applicant may be. The signature of a notary public must, in all cases, be attested by his proper official seal. Sometimes the official seal is dispensed with by State laws; but under Federal laws it cannot be.<sup>1</sup> Of course the oath prescribed in this act cannot be taken by any one who has been convicted of perjury, or who for any other reason is not a competent witness in a court of justice in the State or Territory where the party proposes to take it; and if, upon interference or other trial it appeared that a person legally incompetent had sworn to the declaration, the case would stand exactly as if no oath had been made. Lapse of time could not cure a defect so radical.

§ 313. *Strictness of Verification.*—It is not sufficient to swear or affirm that no other person, firm, or corporation has a right to the use of the trade-mark sought to be registered; but the whole remaining part of Section 2 of the act must be complied with, so as to make out a *prima facie* case beyond doubt. It is true that the party has, in one sense, to swear to a conclusion of law, to wit, that he has at the time a *right* to the use; but that is a matter that he must determine in his own mind, from facts and circumstances within his knowledge. He is presumed to know how and when he affixed the symbol to merchandise, and that his claim is prior in time to that of rivals in trade. As is said elsewhere, no absolute right of property in the mark is created by this law, and his claim to the exclusive right may be overturned by the Office, or by a court. In an analogous case of a patent, it was held that an oath of an applicant for a re-issue, that an original patent “is not fully valid and available” to the patentee, is

<sup>1</sup> Act of Congress, Sept. 16, 1850; Rev. Stat., sect. 1778. See also *Blake Crusher Co. v. Ward*, U. S. Cir. Ct., E. D. Mich., 1 Am. L. T. 423, citing and approving *Goodyear v. Hullihen*, 3 Fisher, 251, 254.

not such an oath as is required by law; and that it was an excess of authority on the part of the Commissioner to grant a reissued patent upon such an oath;<sup>1</sup> but the act is properly complied with by a declaration under oath that no other person has a right to the use of said trade-mark, or of *one substantially* the same.<sup>2</sup>

§ 314. *Certificate of Officer.* — The authentication must be clear. Thus, in a case where that officer has not a seal of office, as an ordinary justice of the peace, it is usual for a clerk of a court of record to attach his certificate of official character under the seal of his court. It has been questioned whether a notary public has complied with the act of Congress of September 16, 1850, which allows oaths for general purposes to be taken before a notary public, and, when certified under the hand and official seal of such notary, gives them the same force and effect as if taken or made before such justice or justices of the peace. He had not stated in his certificate that he was a notary public, and that such certificate was given under his official seal, but signed the same, and affixed his seal. It was held to be sufficient.<sup>3</sup> It has even been held that a jurat to an application is not a nullity because not dated.<sup>4</sup> If the facts intelligently appear, mere form is not insisted on.

§ 315. *Where there is no Evidence of an Oath or its Equivalent on File.* — Under the present strictness of practice, it is not probable that such could be the case; yet it is possible that the declaration may lack the formalities that constitute a legal verification. In an analogous case of a patent, it was held that the fact that a blank form of oath was found among the papers on file cannot overcome the direct recital of the letters patent that the oath was taken, or the presumption that the requirements of the law were complied with in issuing the patent.<sup>5</sup> And suppose the oath had not been taken at all, would the patent be void on that account? Story, J.,

<sup>1</sup> *Whitely v. Swayne*, 4 Fish. 117.

<sup>2</sup> *Re Vidoard et al.*, 8 Off. Gaz. 143.

<sup>3</sup> *Goodyear v. Hullihen*, 3 Fish. 251; 2 Hughes, 492.

<sup>4</sup> *French v. Rogers*, 1 Fish. 133.

<sup>5</sup> *Crompton v. Belknap Mills*, 3 Fish. 536; *Preble's Patent Case Index*, 522.

in one case held otherwise.<sup>1</sup> The taking of the oath, it seems, though to be done prior to the granting of the patent, is not a *condition precedent*, failing which the patent must fail.<sup>2</sup> Notwithstanding the tenor of the foregoing decisions, no prudent applicant would neglect any of the formalities required, nor lay the flattering unction to his soul that he can eventually succeed if he do so. We have an opinion in the Crompton case, above cited, that even the requirement for the payment of fees is *directory*, and that the non-payment thereof would not invalidate a patent inadvertently granted. (*Obiter dictum.*)

§ 316. *Firm.* — By the word *firm* is meant the name, title, or style under which a company transacts business; hence, a partnership or house, as the firm of Hope & Co.<sup>3</sup> A firm may still legally exist although none of the original members of the house remains, or even not one of his name is a partner; and one person may conduct the business under the old name, or many may act under the name of an individual. When but one person constitutes the firm, he should describe himself by his own name, trading under the title or style of the firm; as Adolph C. Meyer, trading as A. C. Meyer & Co.

§ 317. *Corporation.* — By this term the statute now under consideration undoubtedly means a corporation aggregate, duly organized under the laws of some State or Territory of this Union, or of some foreign nation. It must necessarily be confined to a trading corporation. This assertion is not entirely superfluous in this place, for the contrary has been asserted in claiming a right to registration. Can the term, as herein used, embrace literally any and every corporation, sole and aggregate, ecclesiastical, municipal, manufacturing, and commercial, — corporations formed for scientific, educational, and a score of other purposes? Counsel have asserted that all kinds of corporations, however unconnected with commerce, are included. If not in *trade*, why have a *trade-mark*?

<sup>1</sup> *Whittemore v. Cutter*, 1 Gall. 429; 1 Robb. 48; *Preble's Patent Case Index*, 523.

<sup>2</sup> *Clifford and Clark, JJ., Crompton v. Belknap Mills, supra.*

<sup>3</sup> *Webster's Dictionary, Firm; Worcester's Do.*

If a non-trading corporation cannot have a trade-mark at common law, how can it possibly have one by virtue of this act of Congress? This statute does not create trade-marks, for no power to do so exists under the Constitution; and it would be an absurdity to attempt to create a symbol of commerce, which, being the emblem of its owner, each man must adopt for himself. The right to use a certain mark for goods does not depend upon statutory enactments, but has its foundation in the immutable law of nature. Congress had only authority to *regulate* commerce, and it did not attempt to transcend its powers. It could not change the natures of things. We are referred to the common law for the rules which govern those natures; and it has repeatedly been declared that statutes which alter common-law remedies, or affect common-law rights, must be strictly complied with. Witness the maxim, *Nihil quod est contra rationem est licitum*, for reason is the life of the law. And such statutes are to be construed sensibly, and with a view to the object aimed at by the legislature. An ancient and settled system ought not to be overturned, except by clear, unambiguous, and peremptory language.<sup>1</sup>

§ 318. This statute does not make valid any act on the part of a corporation which would not be valid without it, and does not in the slightest degree add breadth to the provisions of its charter; therefore, it is a corollary that an ecclesiastical, educational, eleemosynary, or other non-mercantile corporation, is not contemplated by this act. In one case, the applicant set forth that it was engaged in the "manufacture and distribution of pamphlets, circulars, and other publications," and that the proposed trade-mark was to be printed thereon, "and upon the notices which advertise the same and the business of the company to the public." It did not appear, nor could it be inferred, that the articles upon which the mark was intended to be applied were to be sold. Therefore they were not merchandise within the meaning of the statute. The application was rejected.<sup>2</sup> In

<sup>1</sup> Sedgwick, Stat. and Const. Law, 318.

<sup>2</sup> The Mercantile Loan and Warehouse Co., case 683.

another case, where a picture of a safe and a watch-dog was filed for registration by an insurance company, it met a similar fate. This picture was not intended to be sold as a work of art, — for then it might have come under the copyright law, and been entered in the office of the Librarian of Congress; nor was it to be affixed to merchandise to be sold, — for an insurance company does not traffic; but it was to be printed upon policies, renewals, bill-heads, &c., by way of ornament. The purpose of registering a mark under such circumstances is inconceivable. What beneficial end could it possibly serve? It could not be turned into a technical trade-mark until it should actually be affixed to merchandise; and this artificial person, a company formed to insure against loss by fire, had no power in law to affix it to merchandise. The sole object of registering a trade-mark is to obtain protection against infringement by a rival trader; and that protection could only be obtained through judicial process. How could such a corporation come into court as a trader? In this case, the Special Examiner having charge of the subject declined to receive it, for want of jurisdiction, and the fee was returned to the applicant.<sup>1</sup>

§ 319. If the Office had permitted registration in such cases, what absurd consequences might have flowed therefrom! Other corporations of a similar or analogous nature would perhaps have demanded the certificate, which to them might have seemed like the wand of an enchanter. A corporation sole is recognized as existing in the United States. Such is a minister of a parish seized of a freehold, as *persona ecclesie*, the same as in England; and the right once established cannot be divested even by an act of the State legislature.<sup>2</sup> In Massachusetts, a minister seized of parsonage lands, is a sole corporation for that purpose. Such a corporation sole cannot alienate, but has survivorship.<sup>3</sup> Now, if *any* and *every* corporation is intended to be embraced by this statute, why not let in such a minister of a parish, not in his individ-

<sup>1</sup> The Safeguard Fire Ins. Co. of the City of New York.

<sup>2</sup> Angell & Ames on Corporations. § 27, citing decisions of Story, J.

<sup>3</sup> Brunswick v. Dunning, 7 Mass. 447; Weston v. Hunt, 2 Mass. 501; Jansen v. Ostrander, 1 Cow. 670.

ual capacity as John Styles, but as rector? The proposition is too devoid of sense to warrant another word, and would be dropped but for one fact, — an appeal was taken in just such a case, and was decided against the applicant.

§ 320. Common sense and good faith are the leading stars of all genuine interpretation. We do not take language literally, but look at the reason which underlies it. The command, "Thou shalt not kill," does not prohibit killing in a just war, or in defence of one's person. When the minister in the pulpit tells us to sing three verses of a certain hymn, we do not take him literally, for his words do not mean exactly what they say. A hymn is in poetical form, and in poetry each line is a verse. Therefore we at once perceive that the careless speaker means that we shall sing three stanzas, as otherwise the sense would be incomplete and be turned into sheer nonsense. Dr. Lieber has given an illustration of the necessity of consulting the rules of reason in applying language. He takes the word *horse*, which means many different things.<sup>1</sup> In Webster's Dictionary we find that it may mean: 1. A hooped quadruped of the genus *Equus*; 2. The male of the genus; 3. Mounted soldiery; 4. A frame with legs for supporting something; 5. A mass of earthy matter in mining; 6. In nautical affairs, a foot-rope extending from the middle of a yard to its extremity; also a rope for hoisting a yard, or extending a sail on it. We always should take a word with its peculiar signification in the art, science, sect, &c., according to what is termed *usus loquendi*. When Congress used the word "corporation," in the same paragraph it was also said "who are entitled to the exclusive use of any lawful trade-mark," &c. The corporation must show that the law of its creation gave it authority to make such contracts as it seeks to enforce;<sup>2</sup> and the act of registration under this statute is a contract between the United States on the one side, and the proprietor of the trade-mark on the other, whereby protection is promised upon certain conditions precedent and subsequent.

<sup>1</sup> Legal and Political Hermeneutics, p. 100.

<sup>2</sup> Angell & Ames on Corporations, § 161.



§ 321. There are two published opinions, which, on a superficial reading, seem to affirm that the mere name of a corporation may constitute a lawful trade-mark, when used by the corporation itself, as a mark or sign upon merchandise. These opinions are worthy of examination at this moment, and especially so is the earlier one, as that has been cited in the Patent Office as an authority. It is the case of *Newby v. The Oregon Central Railway Co. et al.*, in the Circuit Court of the United States for the District of Oregon, in 1869.<sup>1</sup> The facts are briefly as follows. The corporation defendant was organized in 1867, under a general law of the State of Oregon (Code, 658, 659), for the purpose of constructing and operating a railway. Prior thereto, however, another company had been incorporated by the same name, and by authority of the law of the same State. It was alleged by the bill that the bonds and obligations of the senior corporation (of which the complainant was a stockholder) had become valuable and marketable as commercial paper, so that it was enabled by the sale of them to meet its liabilities; and it was charged that the individual members of the second corporation had confederated and conspired together to defraud and injure the senior corporation, by assuming the same corporate title; whereby they succeeded in putting their paper into market, to the injury of the credit of the original corporation. In short, the true and legal designation of an incorporated company had been fraudulently usurped. An injunction was asked for. The language of the judge in granting the prayer is in part this: "The corporate name of a corporation is a trade-mark, and from the necessity of the thing, and every consideration of private justice and public policy, deserves the same consideration and protection from a court of equity. Under the law, the corporate name is a necessary element of the corporation's existence. Without it, a corporation cannot exist. Any act which produces confusion or uncertainty concerning the name is calculated to injuriously affect the identity and business of a corporation." He found that the defendants were in the wrong, and administered the remedy

<sup>1</sup> Deady's Rep. (1859-69) p. 609.

applied for. What did the judgment decide? That the mere naked name of a corporation is a trade-mark at common law? If it did so decide, then the name of a corporation used *for* itself, and *by* itself, is not included within the prohibition of this section, provided the same was so used prior to the time of the passage of this act. Did the court decide that the name of a corporation is a technical trade-mark? Yes! exclaims the tyro. No! as emphatically says the lawyer. Let us carefully examine the language of Judge Deady, and theorize, if necessary. "The corporate name of a corporation is a trade-mark," said he, and "deserves *the same* consideration and protection." The *same* as what? The *same* as if it were really a technical trade-mark. That is undoubtedly what he meant to say, and by his decision virtually did say. Was the case before the court an alleged infringement of a trade-mark? No. How can that be demonstrated? By a very simple process. There was no charge that the mark of the original and genuine company had been violated. If the bill had so averred, and claimed relief on that ground, the defendants would have demurred thereto, and a dismissal of the bill would necessarily have followed. There would have been a defect in the party complainant. In case of infringement, the party injured by the wrongful conduct of the defendants would have been the corporation itself, and not an individual stockholder. There was no pretence that the defendants, or any one of their number, had imposed a false mark upon Newby. His ostensible reason for bringing the suit was to prevent a further depreciation of his stock by any wrongful act of the defendants. How came he to sue, instead of the corporation? The motive may readily be inferred. He was a citizen of the State of California; and the defendants were all citizens of Oregon. He could bring a suit in the Circuit Court of the United States, and the corporation could not; because in the latter case both parties would have belonged to the same State, and the court could not have had jurisdiction under the act of 1789. The senior corporation found that it was necessary to its own salvation that the pseudo corporation should be destroyed; and the expunging of its name

was annihilation. We have no right to quarrel with Judge Deady, except on one point, and that point is the careless misuse of a technical term, — “trade-mark”; and when we look back at the frequent instances of the same slip of the tongue or the pen, as shown in Chapter III. (on the definition and nature of the trade-mark), we find him to be in illustrious company. The case of *Newby v. The Oregon Central Railway Co. et al.* does not judicially decide that the mere name of a corporation is a trade-mark.

§ 322. The other corporation case which invites our attention is that of *Holmes et al. v. Holmes et al.*,<sup>1</sup> in the Supreme Court of Connecticut, in 1870, before all the justices but one. In delivering judgment, it was said by Carpenter, J.: “That any name, symbol, or device, adopted by an individual, corporation, or business firm, for the purpose of designating the origin and ownership of goods manufactured by them, will be protected as a trade-mark, is well-settled law. The name of a corporation or partnership accomplishing the same purpose will be protected upon the same principle.” When we study this case, the meaning of the language of the learned judge becomes perfectly clear. As in the foregoing Oregon case, both parties before the court were corporations created under laws of the same State, bearing the same title, and engaged in the same line of business. The coincidence was promotive of confusion. It became necessary to the welfare of one concern that the name of the other should be blotted out. It was not essential to the attainment of the object sought that the infringement of a trade-mark should be averred; but it was deemed necessary that the name of one of the parties should be suppressed, or modified. The only question before the court was, Which party has the best right to the name used? Did the court say, or mean to say, that the name of a corporation is a trade-mark? No. But it did virtually say that when the name of a corporation, &c. accomplishes the same purpose as a trade-mark (and in this instance it was shown that it did), it will be protected. How? “*Upon the same principle,*” not as *being* a trade-mark.

<sup>1</sup> 37 Conn. 278; 9 Am. R. 324.

§ 323. The term "corporation" has been taken by some applicants for registration to mean any voluntary association or aggregation of individuals, although they do not possess the general characteristics of a corporation. Thus, in one case, the claimants set forth that they were engaged in business under the name of the "Sorrento Wood-carving Company," and asked that a certificate should be issued to and in the name of such company.<sup>1</sup> *Held*, that the company has no legal existence by that name, not being incorporated, and is in reality a "firm." The grant should properly be made in the individual names of the applicants, as trading, manufacturing, or doing business under such or such a firm, title, or style. — But when a corporation is an applicant, its proper title or name must be given, and the papers must be signed by an officer thereof, viz. the president, vice-president, secretary, treasurer, or superintendent. It has been held by the Office that a mere director could not make the verification, he not being strictly an officer.<sup>2</sup> It should be one who has charge of the seal, and right to affix it.

§ 324. *Exclusive Right to Use.* — In his statement or specification, the applicant must set forth his title, whether by original adoption, by assignment, inheritance, survivorship, or by operation of law, as when one has acquired a right to carry on the business of a bankrupt. From the facts therein alleged will be deduced a conclusion as to the legality of the title claimed. The right to the use of the mark must be *exclusive* of all other persons.<sup>3</sup> A trade-mark is an emblem of a man just as much as his written signature, and is used to denote that an article of merchandise has been made by a certain person, or that it has been sold or offered for sale by him. If the same mark were to be used by different persons, for the same species of goods, it would lead to inextricable confusion; and its true and only legitimate purpose would be overturned, for then it would lack the essential element of an indication of origin or ownership.

<sup>1</sup> Hill & Hall's case, Certificate No. 639.

<sup>2</sup> Re Gullet Gin Manufacturing Co., 1873, case 1478.

<sup>3</sup> The Supreme Court of Wisconsin, in *Marshall et al. v. Pinkham*, 52 Wis. 572, cited the remainder of this section with approbation.

§ 325. *Time of Receipt of Application to be noted. Registration depends on lawful Use.* — “Sect. 3. That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person’s lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant,<sup>1</sup> or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.”

§ 326. “*Merely the Name.*” — The Court of Appeals of New York in one case<sup>2</sup> used this language: “A person cannot make a trade-mark of his own name, and thus obtain a monopoly of it which will debar all other persons of the same name from using their own names in their own business.” This is the enunciation of a well-settled common-sense doctrine. But the language is, “*merely* the name of the applicant.” This means his own proper name. In *Milner v. Reed*, decided by V. C. Wickens in Lancaster, England, in 1870,<sup>3</sup> it was held that a designation by which a person has in fact become known may be a trade-name entitled to protection, even though the person claiming it is not the person to

<sup>1</sup> “Registrant.” The author of this book devised this term because there was a need for some word of the kind. *Registrar* is an officer who makes an entry in a register. When an applicant’s claim has been allowed, he becomes a registrant. The word is formed just as *celebrant* is from *celebrate*. The Patent Office first, and then Congress, confirmed its use.

<sup>2</sup> *Meneely v. Meneely*, 62 N. Y. 427. See *ante*, §§ 195–202.

<sup>3</sup> Bryce on Trade-Marks, 90; Cox’s Man., case 328.

whom it was originally applied, and though the facts which caused it to be applied to him no longer exist. A surgeon T., who resided in Oldfield Lane, and who had acquired great fame under the name of the "Oldfield Lane Doctor," took an assistant as partner. The latter continued the business after T.'s death, and passed by the name of "Oldfield Lane Doctor." He was subsequently turned out by T.'s representatives, who leased the surgery to another surgeon, who practised there. The latter was restrained from using the name. — In a case where an applicant had used for the period of twenty-one years, as a trade-mark for bridle-bits and stirrups, the word "Daniel," as a fanciful name, it was admitted to registry.<sup>1</sup> If this word "Daniel" were the name of the applicant, it would not be valid for the purpose; but being a pure designation of fancy, — meaning, mayhap, him who was thrown into the den of lions, — there is no objection to it. Even if another person, whose real name is Daniel, were to set up in a similar business, he would not be permitted to stamp his goods with the simple name adopted as above stated; but would be compelled by a court of equity, if he used it at all, to use with it some distinguishing mark, or his initials, to avoid the possibility of confusion. — What is *merely* the name? Answer: the name used in the ordinary manner, having nothing in its arrangement to attract attention, and lead the public to inquiry, and having no feature indicative of an intention to make it a distinguishing emblem. But if one form his name into an anagram, or form a cross or crescent, or any other fancy figure of his name, then by the singularity of formation it acquires an individuality, and ceases to be merely his name, and becomes a lawful mark. The imitation of such a device would hardly be deemed the result of accident. One's autograph may be his commercial mark, if it possess striking peculiarities, so that it can be, and really is, recognized as his, and his only; but it is not every scrawl that would be deemed such. That involves a question of fact, whether such mark is sufficient to distinguish it from the same name when used by other persons.

<sup>1</sup> Re Kelita Broadhurst, Certificate No. 946.

§ 327. *Registered or known Trade-Mark.*—This undoubtedly refers to all marks registered under the act of 1870, as well as those under that of 1881.<sup>1</sup> The Office will take notice of its own records. The word “known” embraces all trade-marks of any country, a knowledge of the existence of which shall have come to attention. In making an examination, foreign and domestic publications are consulted, and in addition thereto knowledge on the subject is gleaned from any available source.

§ 328. *Calculated to deceive.*—However strong may be the asseveration of the applicant upon this point, the declaration will not be conclusive where the statement is obviously false. Motives will be keenly scrutinized. The Office will for itself determine when a proposed mark is calculated to deceive. Nor will motives be the sole test; for it is not essential to reprobation that a use shall have been with fraudulent intent. In *Petridge v. Wells*,<sup>2</sup> the “Balm of Thousand Flowers” case, Duer, J., said: “Without rejecting the evidence of my senses, I cannot doubt that the label or trade-mark which the defendants admit that they propose to use, from its general resemblance to that of the plaintiff and his firm, is well calculated to mislead the public, by inducing the belief that the articles to which it is affixed are in reality prepared or manufactured by the plaintiff’s firm. Nor can I doubt that the label was framed with this design, since the imitation is so close, minute, and exact, as, in my opinion, to exclude the supposition of any other motive. It is true that the name of R. H. Rice, as proprietor, is printed on the label, but it is so printed as not to attract, but almost certainly to elude, observation. A variation must be regarded as immaterial which requires a close inspection to detect, and which can scarcely be said to diminish the effect of the fac-simile which the simulated label in all other respects is found to exhibit.” The question of general resemblance, with variations in nearly all the *minutiæ*, was fully considered by the Office in an application for registration of a proposed trade-mark for paint, rejected upon registered case

<sup>1</sup> See *ante*, § 281.

<sup>2</sup> 4 Abb. Pr. 144; 13 How. Pr. 385; R. Cox, 188.

No. 1 of the "Averill Chemical Paint Company." The verbal description has been given in § 259. The applicant's specification presented the same general effect. "Omit the word 'Chemistry,'" said the Examiner, "add the Figure '&' to the ribbon, and substitute a globe for the rough rock, and the written description of Bradley is the same as that of the Averill Company. At a casual glance, one design might easily be mistaken for the other, an indistinct impression of which may have been left upon the memory; for each contains all the essential features of the other. Both devices are circular in form, are intended to be applied in the same mode, in the same color, and to the same class of goods. It is not to be supposed that opportunities for critical examination would commonly offer, nor even be sought; for the resemblance of the infringing to the genuine mark would lull suspicion; so that not only the general public, but even acute observers in the business of dealing in paints, might easily be misled."<sup>1</sup> If the affidavit filed in this case had been conclusive, the case could not have been rejected; for that affidavit states positively "that no other person, firm, or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive." This is by no means an uncommon kind of case. The moral of it is, that the Patent Office will examine, weigh, scrutinize, and decide in accordance with the rules of common sense.

§ 329. The statute, by defining the conditions under which the power it confers shall be exercised, necessarily excludes it in all others, except, perhaps, the correction of clerical errors. When a statute defines the extent of power to one who acts ministerially (as the Commissioner does under this section), the courts cannot extend it, nor validate acts done without or beyond its authority. The Commissioner cannot pardon a false suggestion, or excuse on the ground of innocent ignorance. If, for example, an alien, either through ignorance or intention, falsely represents himself to be a citizen, in order to obtain a patent, the patent so obtained is inoperative and

<sup>1</sup> Case of Henry W. Bradley, assignor to Young & Co., 355.



invalid to vest title. Where the taking of the oath is a condition precedent, the want of it may be pleaded in defence.<sup>1</sup> In another case, it was held that the Commissioner has clearly no power to dispense with what the statute declares to be the necessary prerequisites to a grant. And if it appears from the records and papers of the Office in evidence that the statutory requirements have not been complied with, it is within the power of a court, and its plain duty, to hold a patent to be void. It would be straining the doctrine of presumption in favor of the legality of the acts of a public officer to an unreasonable extent, to hold that a patent is legal and valid where the records and papers of the Office show conclusively that essential statutory provisions have been disregarded.<sup>2</sup>

<sup>1</sup> *Child v. Adams*, 1 Fish. 189; 3 Wall. Jr. 20.

<sup>2</sup> *Whitely v. Swayne*, 4 Fish. 117. See also *Smith v. Reynolds*, 10 Blatch. 85 and 100, ruling out trade-mark certificates on this ground.

## CHAPTER VII.

FEDERAL LEGISLATION (*continued*).

- § 330. Certificates of registry, — issue and effect.
- § 331. Term “Certificates” explained.
- § 332. Seal, — why of the Interior Department.
- § 333. Duration of certificate as evidence.
- § 334. Credit for fees paid under act of 1870.
- § 335. Who shall be credited for former fees.
- § 336. “Same Trade-Mark,” — meaning of phrase.
- § 337. Effect of registration, — remedies.
- § 338, 339. Registration *prima facie* evidence.
- § 340. “Trade-Mark Patent” a false term.
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- § 382. Meaning of "Prints," "Labels," etc.
- § 383. Accidental use by others of same emblem.
- § 384. Bad faith in anticipating adoption.

§ 330. *Certificates of Registry, how issued, and their Effect.* — "Sect. 4. That certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trade-marks shall be brought in controversy."

§ 331. *Term "Certificates."* — There is a reason for this expression. In the act of 1870 the term "certificate" was not used in this sense. There it applied only to the statement made by the applicant. It is here used to clearly distinguish the document issued on registry from letters patent, for which it was frequently mistaken. The true theory is that a trade-mark cannot be the subject of a grant, while a patent must always be.

§ 332. *Seal.* — One of the principal desires of the framer of the bill was to divorce emblems of commerce from a misleading companionship with patents for inventions. *Noscitur ex sociis.* Not only had sciolists frequently been misled thereby as to the essential nature of a trade-mark, but judges and legislators were sometimes led astray by the connection, just as a man is judged by the company that he keeps. The Supreme Court traces much evil to an improper classification in the act of 1870, where trade-marks were sandwiched

between patents and copyrights. While emblems of trade continue to be registered in the Patent Office, non-reflecting persons will liken them to inventions for which patents may be created.<sup>1</sup>

§ 333. *Duration of Certificate of Registry, as Matter of Evidence.*—“Sect. 5. That a certificate of registry shall remain in force for thirty years from this date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years, such registration may be renewed on the same terms and for a like period.”

It must be understood that this section does not mean to affect the vitality of the trade-mark, for it is beyond the power of the national legislature to create or to destroy an arbitrary symbol of manufacture or commerce, termed a trade-

<sup>1</sup> The committee on reporting the bill said: “They perceive no good reason for taking that matter from the Patent Office. One of the main reasons urged for any law on the subject is to comply with existing treaties. In each of these treaties owners of foreign trade-marks are required to deposit them in the Patent Office.” Why to be so deposited? Because the building designated had not only space, but fire-proof rooms. At various times, by authority of law, relics of the earlier days of the nation and of its leaders, swords, curiosities of the Wilkes Exploring Expedition, and other historical articles, have also been stored for convenience of display in that spacious building. It is well known to our citizens generally that, before the creation of the Agricultural Department, the Commissioner of Patents was charged with the distribution of agricultural seeds. He was also custodian of copyright books. In Canada, the Minister of Agriculture has charge of trade-marks and copyrights. No treaty ever required trade-marks to be registered or recorded in the Patent Office. The building so named is also occupied by the Department of the Interior, of which the office is a bureau. The bill intended to continue the business of registration in the same locality and department, while giving another officer charge of the peculiar arbitrary emblems, and the administration of subtle metaphysical distinctions that can but suffer when constantly confused with matters of quite another nature. In changing the bill, the members of the committee who did it overlooked the fact that the Patent Office has its own seal. Hence the anomaly as to the seal.

mark. It affects only what this act creates, a mere certificate as matter of evidence. The act of 1870 read that *the trade-mark shall remain in force*. That phraseology encouraged the supposition that such a representation of personality could be created or destroyed at legislative will. Now, it is merely the evidence of registry that can cease to have effect.

§ 334. *Credit given to Applicants for Fees heretofore paid.* — “Sect. 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the Treasury of the United States with intent to procure protection for the same trade-mark.”

§ 335. “*Credited for any Fee.*” — This applies to the case of any applicant whatever, whether the one who has registered, or attempted to register, or to his assignee, or his successor in business, and to an individual, a partnership, a company, or a corporation, holding legal title to the trade-mark sought to be registered. The Patent Office has decided, however, that an assignee claiming the benefit of this section must file a waiver by the party who paid the fee, or produce equivalent evidence of his right. A mere affidavit of the present applicant is not in itself sufficient to establish a right to the credit. Pursuant to a rule, under the old act, the sum of ten dollars was all that was required to be paid in filing a case. The Commissioner has construed the present act to require the whole fee to be paid in advance. Credit is given for the ten dollars formerly paid. If the case under this law should be rejected, the whole fee would be lost. There were many cases previously to the act of 1870 wherein design-patents were granted for trade-marks, under a misconception of law. As these so-called design-patents had no legal inception, fees paid therefor should, perhaps, be applied by virtue of this section. The same principle applies to so-called copyrights; but the fees in such latter-mentioned matters are too trivial to warrant the trouble of reclaiming them. All such fees go into the treasury, whatever be the channel.

§ 336. “*Same Trade-Mark.*” — This means an arbitrary symbol, essentially that which was originally filed, and affixed to the same class of merchandise. This section clearly con-

templates the use of the symbol on the same kind of goods, although the claim may be enlarged by inserting all the species of the same class that might have been embraced in the first instance; so, when one had in his original case described it as affixed to smoking-tobacco, he may now enlarge the class, by adding other species of manufactured tobacco, as chewing-tobacco, cigars, cigarettes, or snuff. So the Patent Office has decided in a large number of cases.

§ 337. *Effect of Registration. — Remedies.* — “Sect. 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act, and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.”

§ 338. *Evidence.* — The record operates as *prima facie* evidence of title, as in the case of letters patent.<sup>1</sup> Before the passage of this act, it was sometimes next to impossible to establish the date of adoption, and the exact description of a trade-mark, depending as those matters did upon the recollection of witnesses, who, when produced at perhaps a great expense, would disagree upon both points. It cannot, however, be contended that the evidence furnished by virtue of this section would be conclusive. Take an analogous case. A patent does not conclude anybody. It is, at most, a statement of what has appeared to the Commissioner to be

<sup>1</sup> See *Winans v. N. Y. & Erie R. R. Co.*, 1 Fisher, 213; *Ransom v. Mayor*, Ibid. 252; *Serrell v. Collins*, Ibid. 289; *Potter v. Holland*, Ibid. 382; and *Cahoon v. Ring*, Ibid. 397.

a new and useful invention by the patentee. That may, and often does, prove not to be the truth. The Commissioner makes a certificate of the *prima facie* right of the patentee to the exclusive use of what he alleges to be his own originally, and to which the patent gives exclusiveness of use in so far only as the property really existed in the first instance, and before the right was protected. The government does not warrant the act of the Commissioner.<sup>1</sup> The certificate is a convenient species of evidence of the claim, and the length of time that the right has been asserted. When employed to show the date of filing claim, and other facts which do not usually appear in the certificate, as issued in course, an exemplification of the whole record should be demanded. Whenever convenient, the defendant should for the greater caution examine the original file, with every paper in it. The papers contained in the file (excepting assignments, which may be found recorded in their appropriate books) constitute the sole record. This is a perpetual, intrinsic, and exclusively admissible testimony of all the transactions in the case. The slightest error of the transcript may materially affect important rights.<sup>2</sup>

§ 339. It was held in the Court of Metz, in France, in 1861, in the case of *Somborn v. Menser et al.*,<sup>3</sup> that the deposit of a trade-mark under the law of 1857 (which our act resembles in many features) creates a presumption in favor of the depositor, and nothing more than a presumption, which may be rebutted by proof that other manufacturers previously used the same mark for the same class of merchandise. Curry-combs, bearing the mark of a horse, had been seized. The evidence showed that the said mark had been used in Germany for nearly a century, and had long before the date of the suit fallen into the public domain, even in France, and was notoriously employed by the manufacturers of Paris to designate certain articles of hardware. The proof of foreign

<sup>1</sup> 8 Opinions of Attorneys-General, 277.

<sup>2</sup> See *Smith v. Reynolds*, 10 Blatch. 85, 100; 3 Off. Gaz. 213, 214; 13 Blatch. 458.

<sup>3</sup> 8 Annales, 78.

user, therefore, destroys the presumption created by registration.

§ 340. "*Trade-Mark Patent*" is a false term, frequently used to indicate the certificate given under the provisions of this section. The phrase is illogical and mischievous. A patent is an official document conferring a right or privilege on some person; especially a writing securing in a person for a term of years the exclusive right to an invention or discovery. A patent is a grant, — a new creation. It makes a right that did not previously exist, and one that must expire with it. A trade-mark is not granted by the government. Even if the certificate of registry should prove to be informal and worthless, that fact would not affect the vitality of the trade-mark at common law, but would simply deprive the person using it of convenient evidence. But if a patent should be found to lack any material allegation, or to be informal, the patentee is left without property in his invention. The patent is a modern contrivance; but the trade-mark is venerable for its antiquity, its origin being coeval with that of property itself. All the Patent Office does with the latter is to recognize and record it. The erroneous use of the word "patent," when applied to a certificate of registry, is apt to be the source of injury, for in such use we lose sight of a principle. We thereby admit what is not true, i. e. that government has conferred a right of user, and that that right may expire at the will of the government; whereas the symbol of commerce exists *ex proprio vigore*, by virtue of an immutable law. Words are the guardians of thought, language the amber in which are embedded and preserved precise and subtile ideas. Words, as living powers, have a relationship to the things they designate, and must not be taken at random. That would be to pull the bow at a venture. Again, there may be imposture in the use of the word "patent," when the correct term is "certificate of registry"; as when a man who has registered a trade-mark for some common article of merchandise stamps his goods with the mark, and adds the word "patented," with a date. The error may arise from ignorance, or, quite as likely, it is the result of a studied effort



to cheat the purchaser. If ignorantly done, the legal consequence may be to deprive the proprietor of the mark of any redress for a violation of what is truly his mark; but if intentionally done, it makes the person amenable to the penalty prescribed for false marking.<sup>1</sup> The following is an example of perfect good faith in the misapplication of the word "patented," as is evident by the candid admissions of the person as a party in an interference.<sup>2</sup> The dispute being as to the priority of adoption of the word "Centennial" as a mark for shirts, &c., the sworn preliminary statement says: "We first commenced using the word 'Centennial' on the 10th day of March, 1872. Our shirts were then exhibited in boxes on which were affixed our labels, represented in our patent dated May 7th, 1872. We did not, however, label the shirts until we received official notice that our patent was allowed. From the date of the patent, May 7, 1872, we have stamped our shirts thus: 'Centennial, Pat. May 7th, 1872.'" — In a case in the Supreme Court of Louisiana, the complainant had inadvertently used the word "patented" instead of "registered" on his trade-mark label; but the court held that to be of no importance, as it could not mislead.<sup>3</sup>

§ 341. "*Reproduce*," whether by his own hand or by means of any agency or instrumentality; or whether criminally, as is implied by the word "counterfeited," or "copy," as he may innocently or ignorantly do.

§ 342. "*Colorably*." — This word was not in the act of 1870. A specious, plausible imitation is meant, although it may not be a close copy.

§ 343. This statute does not create the right to judicial remedies generally; for that right has always existed, and occasionally has been enforced in one form or another during

<sup>1</sup> Sect. 39 of the patent law of July 8, 1870, says that if any person "shall in any manner mark upon or affix to any unpatented article the word 'patent,' or any word-importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such offence to a penalty of not less than one hundred dollars, with costs." Rev. Stat., sect. 4901.

<sup>2</sup> *Sternberger v. Thalheimer & Hirsch*, 3 Off. Gaz. 120.

<sup>3</sup> *Insurance Oil Tank Co. v. Scott*, 33 La. Ann. 946. — See § 72 as to the misuse of word "patented."

past ages. The penal portion of this section must be strictly construed. The law gives satisfaction for infringement whether the act of imitation be intentional or not. Under either aspect, if one be damaged by another in the use of his trade-mark, he is entitled to indemnification by way of compensation, although in the absence of evidence of a fraudulent intent, he is entitled to no more than nominal damages.<sup>1</sup> Such a tortious invasion of this kind of property, although unaccompanied by special damage, is maintainable.<sup>2</sup> A strict construction requires the plaintiff in an action on the case to prove that the mark was not only reproduced, counterfeited, copied, or imitated, but also that it was *affixed* to goods of substantially the same class and description as those referred to in the registration. The wrongful act will not have been consummated until the trade-mark has been used, and it cannot be used until affixed to the articles of merchandise. This is a common-law rule.

§ 344. The remedy given by this section is cumulative. The party wronged has undoubtedly a right to resort to the common law for damages sustained, independently of this statute. The common-law remedy is not taken away by this affirmative statute, without a negative, express or implied.<sup>3</sup> The primary right to a satisfaction for injuries is given by the law of nature, and the suit is only the means of ascertaining and recovering that satisfaction. The injured party has unquestionably a vague and indeterminate right to some damages or other, the instant he receives the injury; and the verdict of the jurors, and the judgment of the court thereupon, do not, in this case, so properly vest a new title in him as fix and ascertain the old one. They do not give, but they define the right.<sup>4</sup> The wrong implied by this section is deceit. From the very terms of the definition of deceit, there must be *fraud*, or the intention to deceive, for this is the very essence of the injury. If the party making the representation himself made a mistake,

<sup>1</sup> Sedgwick on the Measure of Damages.

<sup>2</sup> Broom's Commentaries on the Common Law, 3d ed., p. 88, and authorities cited.

<sup>3</sup> See Sedgwick, Stat. and Const. Law, p. 402.

<sup>4</sup> Bl. Com., book ii. chap. 29.

no degree of blame can be attached to him; as, for instance, in the use of a symbol which he did not know had been appropriated by another as his trade-mark; and, in that case, the principal feature to entitle the plaintiff to anything more than mere nominal damages would be wanting. In general, the representation must be *malo animo*; but whether the party making it is himself to gain by it is wholly immaterial,<sup>1</sup> nor is it necessary that the intent should be to defraud him to whom such false and fraudulent representation is made.<sup>2</sup> It is no answer to a suit for the violation of a trade-mark, that the simulated article is equal in quality to the genuine.<sup>3</sup> The injury is committed when one affixes the mark of another to articles of merchandise, and sells, or attempts to sell, said articles as the product of that other person.

§ 345. *Remedy* is a figurative expression, which signifies the means employed under the provisions of law to enforce a right, or to redress an injury. It is a maxim of the law that there is no wrong without a remedy,— *Ubi jus ibi remedium*;<sup>4</sup> and in theory, at least, this is indisputable. If one have a right, he must have the means to vindicate and maintain it; for want of a right and want of a remedy are in effect the same; therefore, *Lex semper dabit remedium*.<sup>5</sup> It is said that it is owing to these maxims that the action of trespass on the case for the redress of torts, wrongs, and grievances owes its origin. To avoid mistake in selecting a remedy, and consequent perplexing litigation, or utter failure of a just claim, this statute has prescribed the form of action. Although this form of remedy does not exist in some States, which, while preserving the essence, have abolished the distinguishing title and manner of expression, still in the Federal courts it remains unchanged in form and spirit. Indeed, had not the statute named the action, a trade-mark is such an incorporeal right,

<sup>1</sup> *Pasley v. Freeman*, 3 T. R. 51.

<sup>2</sup> *Boyd v. Browne*, 6 Penn. St. 310.

<sup>3</sup> *Coats v. Holbrook*, 2 Sand. Ch. 586; *Taylor v. Carpenter*, 2 Wood. & M. 1; 11 Paige, 292; and 2 Sand. Ch. 603.

<sup>4</sup> 1 T. R. 512; Co. Litt. 107 (b). See Bac. Abr., Actions in General, B; 1 Chitty, Gen. Prac., part i. c. 1.

<sup>5</sup> 2 Ld. Raymond, 953; Willes, 597.

that the violation of it by acts indirectly and consequentially injurious could not have looked to any other kind of legal redress. The equitable remedies of injunction, account, destruction of counterfeit marks, &c., are equally unaffected by the language of this statute.

§ 346. The first remedy prescribed is an "action on the case," sometimes called "trespass on the case," which is the same remedy that the common law affords.<sup>1</sup> The rules of pleading in this action are comparatively few and simple. It is founded upon the mere justice and conscience of the plaintiff's case, and is in the nature of a bill in equity, and in effect is such. Whatever will, in equity and conscience according to the circumstances of the case, bar the plaintiff's recovery, may, in this action, be given in evidence, because the plaintiff must recover upon the justice and conscience of his case.<sup>2</sup> To entitle the plaintiff to judgment, he must prove that the infringement has been consummated, which cannot be true unless the simulated mark has actually been affixed to goods of the same description as those to which he shall have appropriated the mark. But nevertheless, at any stage of the commission of the wrong, the owner of a lawful trade-mark has his remedy in equity by injunction against all persons, principals, workers, and agents; and the false marks, brands, stamps, labels, or plates may be decreed to be delivered up and destroyed under the direction of an officer of the court; and compensation may be decreed, *provided* the *legal* title be clear, for courts of equity will not interfere in doubtful cases.

§ 347. *Caution to be observed.* — Before rushing into litigation under the assumed sanction of this act, the aggrieved proprietor of a trade-mark should be cautious. His rights must be based upon a strict compliance with all the requirements of the law. The particular articles to which he has affixed his symbol should be described with clearness, lest under a loose and indefinite description there be loopholes through which a pirate may creep with impunity, under the strict construction to which the penal nature of this section

<sup>1</sup> Lord Mansfield, in *Bird v. Randall*, 3 Burr. 1353.

<sup>2</sup> See title "Remedies," Chapter IX

entitles him. To make the defendant liable, it must be shown, not only that he used the plaintiff's mark, but also that he applied it to the same kind of goods, for the purpose of selling them. If A. should have a mark for ladies' parasols, and B. should copy that mark, and affix it to a parasol *not* for sale, but merely as a fancy design, then the trade-mark will not have been pirated, for no pecuniary damage will have been inflicted; but if B., being in the same trade with A., put that mark upon a parasol exposed in his shop-window, to invite custom by means of that mark, that would be presumptive evidence of fraudulent intent, and the plaintiff should have nominal damages. Parties must not be misled by a fancied analogy of a trade-mark to a patent for an invention or discovery. The patentee has a grant of "the exclusive right to *make, use, and vend*" his invention or discovery during a limited term; and any one who shall make, use, or vend such invention or discovery without the license of the owner of the patent, will have committed a wrong on the said owner: for many inventions are of simple machines, which any one might make for himself, and thus defeat the patentee's just monopoly; and so might discoveries be easily applied when once made. To copy a patented invention, except for the purpose of philosophical experiment, would be an infringement.<sup>1</sup> But one may with impunity copy the symbol which another has adopted as his trade-mark, for there is not any right of property in the mere representation of that symbol; just as he might reproduce, copy, or imitate the autograph of another, as an illustration of the signature of a distinguished man. For the symbol in the abstract there is no protection: for the symbol in the concrete, i. e. as applied to the thing that is for sale as an indication of genuineness of the product, there is ample protection.

§ 348. *When a Trade-Mark is debarred from Protection.* — "Sect. 8. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of

<sup>1</sup> Curtis on Patents, "Infringement."

deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.”

§ 349. “*Unlawful Business.*” — To entitle one to favorable judicial interposition, in case of infringement, it is not only essential that the symbol claimed be his mark of manufacture or commerce; but the business in which it is used by him must be lawful. It is a broad principle of law that all transactions in violation of morality, and founded upon conditions *contra bonos mores*, are void. All duties enjoined by the divine law are not enforced, indeed, by the common or by the statute law, not only because the forms or modes of proceeding do not enable human tribunals to adjust nice questions of morals, but because strict rules as to ethical questions would tend to destroy freedom of opinion, and to afford opportunities for persecution. But no agreements to do acts forbidden by the law of God, or which are manifestly in furtherance of immorality and tend to contaminate the public mind, are tolerated, or can be enforced. Thus, if it be shown that the plaintiff’s trade-mark is used by him to stamp obscene publications, or articles used only in the commission of acts of vice, and the defendant has pirated the trade-mark to palm off similar publications or articles, the plaintiff could not recover damages. Two general maxims would be enforced against his demand,—*Ex turpi contractu non oritur actio*, and *In pari delicto, potior est conditio defendentis*. Any business which violates the rules of public policy is unlawful; yet, as Mr. Justice Story says,<sup>1</sup> public policy is in its nature so uncertain and fluctuating, varying with the habits and fashions of the day, that it is difficult to determine its limits with any degree of exactness. It has never been defined by the courts, but has been left loose and free of definition, in the same manner as fraud. This rule may, however, safely be laid down, that any business which conflicts with the morals of the time, and contravenes any established interest of society, is void, as being against public policy. A business originally lawful in itself may by peculiar circumstances be made unlawful. Thus trading with an enemy without a license from

<sup>1</sup> See Story on Contracts, “Void on Account of Immorality.”

one's own government is unlawful, for it is the policy of war for each party to injure the other party to its utmost ability, even though such injury be continually recoiling. All commercial partnerships existing between citizens of two countries at war with each other, are dissolved by war, so that no new contract can arise between them pending such war. Nor can an ally engage in trade with a common enemy, without rendering himself liable to the penalty of seizure and forfeiture of property so engaged. A business carried on in violation of a statute is unlawful, whether that statute *expressly* prohibit or enjoin an act, or *impliedly* prohibit or enjoin it, by affixing a penalty to the performance or omission thereof. Any business the object of which is the violation of the laws of another nation should, upon principle, be treated as unlawful, and as tainted with immorality, for no nation should connive at the infraction of the just laws of another. Honesty is the true policy of nations as well as of individuals, even if the higher obligations of morality were to be disregarded by the brotherhood of nations, every day the more closely drawn together by a community of interests. This being a commercial statute, it is not improbable that Congress meant to give to the term "unlawful" a comprehensive scope. At all events, courts should require the enforcement of the strict rules of morality in the application of this penal provision. In two early cases in the Patent Office, the applicants set forth that they manufactured boots for the Southern trade. The places of business were in the State of Massachusetts, and the merchandise to which the proposed trade-marks were to be affixed was expressly intended for sale in the States lately in rebellion against the United States. No doubts would have arisen of the entire lawfulness of the business of the applicants, but for certain *indicia* of bad faith. On the fronts of the legs of the boots of one party was stamped as a trade-mark the likeness of Robert E. Lee, with a copy of his signature, accompanied with six stars. The Office refused registration on two grounds: 1st. That the use of said likeness and the stars, signifying the States that led off in the rebellion, tended to foster prejudice

and keep alive a sectional feeling; 2d. That the concealment of the true origin of the manufacture was an attempt at imposition upon the people of the South. The other case was rejected upon substantially the same grounds. Under the peculiar circumstances, the business might well be held to be unlawful within the meaning of the statute. If Southern manufacturers had been the applicants, the Office would have made allowances for the admiration entertained for the memory of gallant officers, however mistaken the cause in which they had been engaged, and probably would have granted the registry.

§ 350. *Any Article Injurious in Itself.* — This obviously means any article designed for an evil purpose, as that instrument of the assassin, the slung-shot, the very possession of which, with intent to use, is made a felony in the State of New York, and other places. Such a weapon is not recognized as a legitimate means of defence, and is not deemed by the law to be susceptible of application to any good purpose. Poison, dynamite and other explosives, deadly weapons such as are used in honorable warfare, intoxicating liquors, and many other articles, may be perverted from lawful purposes, but they are not *per se* unlawful; but adulterated food, as flour containing gypsum, confectionery containing *terra alba* or other noxious ingredients, and a myriad of other unlawful articles of merchandise destructive of the health of consumers and the morals of producers, are injurious *per se*.

§ 351. *Deceiving the Public* in the purchase of merchandise, as by acting a lie by means of a false indication of origin, that the vendor may obtain the benefit of the reputation that certain goods may have, as when the signs on cigars made in New York indicated that they were made in Havana;<sup>1</sup> or when a quack medicine is held forth as a panacea for an incongruous group of diseases;<sup>2</sup> or when a man by the use of his own name attempts to impose upon the public his goods as those of another;<sup>3</sup> or when he falsely represents an article

<sup>1</sup> *Palmer v. Harris*, 60 Penn. 156.

<sup>2</sup> *Fowle v. Spear*, 7 Penn. L. J. 176.

<sup>3</sup> *Croft v. Day*, 7 Beav. 84.



to be protected by a patent;<sup>1</sup> or in many other cases that might be cited to illustrate this principle of the common law. And it will be no answer to the charge of deceiving the public that the deceit was really for the benefit of the public.<sup>2</sup> Truth is the standard required. The court said, in *Matsell v. Flanagan*,<sup>3</sup> that the enforcement of the doctrine that trade-marks shall not be simulated does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle that the public are entitled to protection from the use of previously appropriated names of symbols, in such a manner as may deceive them, by inducing to the purchase of one thing for another. In another case it was held that a mere false or exaggerated statement in a public advertisement, tending to recommend the manufactured article to the public, will not deprive the owner of a right to be protected in the exclusive use of his trade-mark; and the court further held, that the fraudulent imitator of the mark could not be heard to raise the objection.<sup>4</sup> It has also been held, that the fact that a trade-mark bears a fictitious name as the name of the manufacturer of the article, does not affect the owner's right to protection, when not used with a fraudulent intention to deceive the public.<sup>5</sup> Hoffman, J., said: "It is constantly insisted, and the position is sanctioned by some judges, that when the article in question is innocuous, or in some degree useful, no absurd panegyric, or extravagant price, is a reason for denying the interference. In short, as counsel once said before me, if a man should compound tallow with some high scent and beautiful coloring-matter, and term it 'The Ointment of Immortality,' he has a right to appropriate so much of the public credulity as he can to this designation."<sup>6</sup> These remarks do not inculcate as high a standard of morals as might be expected from so learned and upright a jurist; and in justice it must be said that they do not rep-

<sup>1</sup> The Leather Cloth Co. case, 11 Jur. (N. S.) 513.

<sup>2</sup> Partridge v. Menck, 1 How. App. Cases, 558.

<sup>3</sup> 2 Abb. Pr. (N. S.) 459.

<sup>4</sup> Curtis v. Bryan, 2 Daly, 212; 36 How. Pr. 83.

<sup>5</sup> Dale v. Smithson, 12 Abb. Pr. 237.

<sup>6</sup> Fetridge v. Merchant, 4 Abb. Pr. 156.

resent the sentiments generally entertained by judges. It was said by E. Darwin Smith, J., that individuals should not themselves attempt, or allow, any imposition upon the public by the false and fraudulent use of their genuine labels, devices, or names, for the sale of spurious or simulated articles. So when the plaintiffs sold to the defendant about twenty thousand empty seed-bags with the label of the plaintiffs upon them, and two thousand papers or bags of seeds bearing the same label, and so enabled the defendant to impose upon the public, which he did by violating his promise to fill the empty bags with seeds of good quality, the plaintiffs in effect deceived the public and were left without remedy.<sup>1</sup> When the defendant filled the empty seed-bags with seeds of a poor quality, the purchasers were defrauded, and through the fault of the plaintiffs.

§ 352. To guard as much as possible against the danger of deceiving the public, the Office avails itself of the implied judicial power granted to it by Section 3, and endeavors to fathom the motives of applicants for registration. It is immaterial whether the intention of fraud actually exists in the mind of the applicant, if there is a reasonable probability that the public may be misled. Therefore, when an application was made for the registry of the words "American Sardines," as a trade-mark to be placed upon boxes ordinarily used for the sardines of commerce, the case was rejected; and that, even although it was alleged that the native fish — which is *not* a sardine — is equal in nutritious qualities and delicacy of taste to the imported article.<sup>2</sup> The appearance of the package and the name were calculated to induce the public to buy one thing instead of another. In another case the proposed trade-mark consisted of the words "American Sterling," intended to be stamped on goods made from a peculiar metallic alloy closely resembling real silver both in color and weight. The Special Examiner declined to recognize the words as a valid trade-mark, for the reason that they were calculated to mislead. An appeal, *pro forma*, was taken to the Commissioner

<sup>1</sup> Bloss *v.* Bloomer, 23 Barb. 604.

<sup>2</sup> Re The American Sardine Co., 3 Off. Gaz. 495.

in person. He held thus: The mark may or may not mislead. That is a matter to be determined in the future, according to circumstances which may arise. A case of *prima facie* right to registry has been made out. — A case in a Circuit Court of the United States shows how equity regards this matter of “deceiving the public.” A trade-mark was claimed in the word “Capcine,” purporting to be the real name of a powerful medical remedy, whereas no such article existed. An injunction for a fraudulent imitation of the alleged mark was refused.<sup>1</sup> So, in England, a bill was dismissed on the ground that the plaintiff could have no right to the use of a name as a trade-mark on an article which was not in fact known to the public by that name, but was used by him to deceive the public.<sup>2</sup> In another case it was held that a use by the defendants of a mark that had been abandoned was necessarily to mislead and deceive the people purchasing as to the source of production and quality of the article bearing it.<sup>3</sup> Many instances of like decisions might aptly be cited in this place, but the foregoing sufficiently illustrate the point for the time.

§ 353. *Certificate fraudulently obtained.* — The act of 1870 used the words “any trade-mark which has been fraudulently obtained,”<sup>4</sup> thus carrying out the false theory that a trade-mark could be obtained from the government, whereas it is only the certificate of registry that can be obtained. It is always a proper subject of defence, that the certificate, relied on as *prima facie* evidence of title, was obtained by fraudulent means of any kind. The registration may be regarded as a contract between the United States and the registrant; and as fraud vitiates every contract into which it enters, the formal certificate may turn out to be a mere nullity. Any false entry, prejudicial to the rights of another, is actionable under Section 9 of this act of 1881; as, for example, a pretended or fraudulent assignment set up to vest title in an applicant. As

<sup>1</sup> *Seabury v. Johnson*, 14 Blatch. 262.

<sup>2</sup> *Cotton v. Gillard*, 44 L. J. Ch. 90.

<sup>3</sup> *Blackwell v. Dibrell*, 14 Off. Gaz. 633; 3 Hughes, 151.

<sup>4</sup> Rev. Stat., sect. 4943.

to the one claiming title under such circumstances, the trademark would not be "lawful," any more than the title of the holder of a promissory note with a forged indorsement, or one given for a consideration void at law. As to the meaning of this phraseology, *fraudulently obtained*, take the case of *Fetridge v. Wells*,<sup>1</sup> in which Duer, J., said that in the mode of acquiring his title the plaintiff was guilty of a deliberate attempt to deceive the public. The written agreement between him and the person whose recipe he purchased stated that the consideration of the transfer was the sum of \$7,500, to be paid in cash, and that of \$2,500, in promissory notes falling due at different periods. This statement, though not wholly false, was a very great exaggeration. Of the \$7,500 to be paid in cash, not one dollar was paid, or meant to be paid. The \$2,500 in notes was the whole consideration of the transfer. The advertisement to the public that the plaintiff had paid \$10,000 for the recipe was intended to create a false impression of the real value of the purchase. The agreement was framed to silence the doubts of those who might inquire, and to be used as conclusive proof that the advertisement was true. "I will not say," said the judge, "that the title thus acquired is not valid in law, but I cannot believe that it deserves to be aided by an injunction from a court of equity."

§ 354. It may safely be assumed that this Section 8 is but a reaffirmance of the doctrines of the common law, in that it is well settled that a claim founded upon a transaction which is either *malum prohibitum* or *malum in se* cannot be enforced in an action of any kind.<sup>2</sup> It has been held that an agreement on which an action was brought was invalid, as "contrary to public policy, and to open, upright, and fair dealing." A contract to do an illegal and immoral act is invalid, and will not be enforced in courts of justice, either of law or equity.<sup>3</sup> Fraud avoids a contract *ab initio*, both at law and in equity, whether the object be to deceive the public, or third persons, or one party endeavors thereby to cheat the other;

<sup>1</sup> 4 Abb. Pr. 144; 13 How. Pr. 385.

<sup>2</sup> *Eberman v. Reitzell*, 1 Watts & Serg. 181. See also 18 Pick. 472.

<sup>3</sup> *Forsythe v. State*, 6 Ham. 21; *Chitty on Contracts*, 678, and cases there cited.

for the law will not sanction dishonest views and practices, by enabling one to acquire, through the medium of deception, any right or interest. It is a question whether the title of the plaintiff can be inquired into by the defendant upon a plea of the general issue; or, indeed, whether he can examine a title not claimed under himself. Of course, if the plaintiff do not make out a *prima facie* title to the trade-mark alleged in the declaration, he must fail in any event. The difficulty of treating this question may be overcome, in this particular instance, by the answer that this section contemplates a case where a trade-mark has been registered by means of fraudulent representations.

§ 355. *Damages for False Representations.*—“Sect. 9. That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.”

§ 356. *New Right of Action.*—At common law, the wrongdoer would not have been liable unless he had actually used the trade-mark in palming off goods as the manufacture or merchandise of another; although equity would have enjoined against the contingency of use. This is an action upon the case for deceit, fraud being of the essence of the injury. Two main points must be proved: the fraudulent nature of the wrong committed by the defendant, and the nature of the injury suffered by the plaintiff. The nature of the wrong to be proved in a case of actual piracy is well defined by Wilde, C. J., in *Rodgers v. Nowill*.<sup>1</sup> He says: “Has more ever been necessary to be proved, in actions of this description, than that the plaintiff, being a manufacturer, has been accustomed to use a certain mark to denote that the goods so marked were of his manufacture, that such mark was well known and understood in the particular trade, and that the defendant had adopted the mark, and sold goods bearing it, as and for the

<sup>1</sup> 5 C. B. 109; 5 Man., Gr. & Sc. 109.

plaintiff's goods, with intent to deceive?" On these grounds, the action was held not to be maintainable in *Singleton v. Bolton*,<sup>1</sup> for there no sale was proved to have been made by the defendant of a medicament (yellow ointment) of his own under the name or mark of the plaintiff, but both the plaintiff and the defendant used the name of the original inventor (Dr. Johnson), and no evidence was given of the defendant having sold his ointment as if it had been prepared by the plaintiff.<sup>2</sup> Probably, by virtue of this section, the real owner of a mark would be entitled to nominal damages, sufficient to establish his title, the same as in ejectment, without proof of actual injury, for injury might well be inferred from the fact of false or fraudulent representations. The true owner's loss of time in procuring registry, the expense attending the interference made necessary by the fact of a plurality of claimants, and many other circumstances, — as, for example, the loss of reputation in the market, — might be urged as proper grounds upon which to base a demand for damages.

§ 357. *Rights are not lost by Registration.* — "Sect. 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed."

A proprietor of a trade-mark does not impair any common-law right by registration. He retains all that he had, waives nothing, and gains additional remedies. In a suit, he may combine claims for infringements antecedent to registering with those that occurred subsequently thereto.

§ 358. *Claim to a Trade-Mark unaffected by Expiration of Registry.* — *Suits in Federal Courts between Citizens of the same State.* — "Sect. 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign

<sup>1</sup> 3 Doug. 293.

<sup>2</sup> Lloyd on Trade Marks, "Remedies against Piracy."

country, or in lawful commercial intercourse with an Indian tribe.”

§ 359. *Unfavorably affecting a Claim.*— This means that, after the term, the owner is relegated to his common-law right. As registration cannot create or grant a trade-mark, the owner thereof cannot be deprived of his property therein by a mere expiration of a species of evidence.

§ 360. *Trade-Mark “on Goods . . . to be transported,” etc.*— The meaning of this language may not instantly be perceptible. Whose goods? Certainly the goods of the lawful owner of the trade-mark. The words are, that “the trade-mark in controversy is used”; not that the counterfeit or colorable imitation of it is so used. The words “lawful commercial intercourse” assist a solution of the apparent difficulty. The lawful owner and trader is the one who is to be protected. If such a one find that a citizen of his own State is infringing, he may call on a federal court for relief. The instant that the party complained of shall “reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to goods of substantially the same description,” he is liable to an action for damages and an injunction, even though he and the injured party be citizens of the same State. The purpose is not lawful where false representations are made. It is a trespass the moment a false signal is raised, for the false merchandise, once launched, is in a condition to float off into foreign commerce in competition with honest merchandise. All that a complainant need show is that he uses his registered mark on goods intended by him to be transported, although yet in his shop, or warehouse. It would be a mockery of justice to require that the owner prove that his dishonest rival intended to send his falsely-marked goods to a foreign country. That he ever so intended would probably not be manifest until too late. This statute is in the interest of fair dealing, and its spirit and reason must control.— Since the foregoing was written, in the United States Circuit Court for the Southern Dist. of N. Y., in 1884,<sup>1</sup> Wheeler, J., said: “The goods on

<sup>1</sup> *Luyties et al. v. Hollender et al.*, 21 Fed. R. 281.

which the trade-mark in question is used are not intended to be transported to any foreign country, nor for any Indian tribe; but are mineral waters for consumption in the city of New York; and the parties are all citizens of the State of New York." For that reason, a preliminary injunction was refused.—In the same court, in 1885,<sup>1</sup> Wallace, J., said: "Unless the complainant's trade-mark is used on goods intended to be transported to a foreign country, by the terms of the act of Congress, the court can take no cognizance of the wrong in a suit between citizens of the same State. If it is so used, the court will not be concluded by the result of an inquiry whether it is used with an intent to mislead purchasers in the country where the goods are to be ultimately sold; because the goods may be sold here or in some country other than the one where they are to be ultimately sold, and the act of Congress contemplates a complete protection to the right which it creates." This decision affirms the construction contended for.

§ 361. *Transfers of Trade-Marks and recording of the same.* — "Sect. 12. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office."

This tautological provision was inserted by the sub-committee aforementioned. The Commissioner has shown his appreciation of one part of it by saying, in Rule 15, concerning registration, that "No particular form of assignment or conveyance is prescribed, but the trade-mark should be identified by the certificate number." The rest of that rule reads thus: "The right to the use of any trade-mark is assignable by any instrument of writing,<sup>2</sup> and such assignment of a registered trade-mark must be recorded in the Patent Office within sixty days after its execution, in default of which it may be void as against any subsequent

<sup>1</sup> Glen Cove Manuf. Co. v. Ludeling, 22 Fed. R. 823.

<sup>2</sup> As matter of law, a trade-mark, whether registered or not, may be assigned or transferred by parol. This section is probably meant to apply to cases of recorded trade-marks only.



purchaser or mortgagee<sup>1</sup> for a valuable consideration, without notice.”<sup>2</sup>

§ 362. What trade-marks are intended to be embraced by Section 12? This section relates to form rather than substance. At common law, the transfer of such a right was usually an incident of the assignment of the good-will of a business, or the stock in trade of a manufacturer or merchant. It was sometimes a matter of doubt whether the successor of a trading firm, by the general transfer of the good-will and stock (whether the same were made voluntarily or by operation of law), carried with it also the right to the use of an established trade-mark. To remove all such doubt, it was desirable that the assignee of the mark might place his evidence of title upon record, and the most convenient place of record is the Patent Office. Assignments of common-law marks are sometimes recorded, it being the practice of the Office to record any instrument of the kind, without looking into the chain of title; just as a recorder of deeds will without hesitation record any conveyance, provided the fees be paid. Yet no one could pretend that the mere fact of transcribing into official records could breathe life into dry bones. *Lex non cogit ad impossibilia.*<sup>3</sup>—Particular attention is invited to the phraseology of this twelfth section, especially the words “forms,” “right to use,” and “trade-marks.” Forms may be made for the transmission of legal, tangible rights; but before the transfer can be made, the right must exist. How does such right exist? This question can best be answered by citing

<sup>1</sup> A patent may be mortgaged; but it is not understood how the intangible, incorporeal, perhaps personal right of use of an emblem of commerce can be mortgaged.

<sup>2</sup> This provision for the forfeiture of legal rights is, beyond doubt, *ultra vires*. It seems to have been inspired by a perusal of sect. 36 of the law of 1870 (Rev. Stat., sect. 4898), in relation to grants, assignments, and conveyances of patents, which are void as against any subsequent purchaser or mortgagee for a valuable consideration, unless recorded within three months from date, or it may partly owe its origin to Sect. 89 of the law of 1870 (Rev. Stat., sect. 4955), requiring instruments of assignment of copyrights to be recorded in the office of the Librarian of Congress within sixty days from date.

<sup>3</sup> The remainder of this section (by its original numbers) was cited with approbation by Colt, J., in the U. S. Cir. Ct., Dist. of R. I., in 1884. *Morgan v. Rogers*, 30 Alb. L. J. 135.

the opinions of learned judges and chancellors, who have had occasion judicially to consider the subject. The Court of Appeals of the State of New York, in the case of *The Congress and Empire Spring Company v. The High Rock Congress Spring Company*,<sup>1</sup> in 1871, passed upon this very point, and said: "A property in a trade-mark may be obtained by transfer from him who has made the primary acquisition, though it is essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade-mark has been attached."—In the same case, in the court below, it was held that property in trade-marks is not property in the words, letters, marks, or symbols, as things, or as signs of thought, or as productions of the mind, like that of patent or copyright; but simply and solely property as a means of designating things,—the things thus designated being the production of human skill or industry, whether of the mind or the hands, or a combination of both; and this property has no existence apart from the thing designated, or separable from its actual use in accomplishing the present and immediate purpose of its being. In *The Dixon Crucible Co. v. Guggenheim*,<sup>2</sup> in 1870, the court cited authorities, and said, that the true rule to be deduced from these cases would appear to be this: that the property or right to a trade-mark may pass by an assignment, or by operation of law, to any one who takes at the same time the right to manufacture or sell the particular merchandise to which said trade-mark has been attached. As a mere abstract right, having no reference to any particular person or property, it is conceded that it cannot exist, and so cannot pass by an assignment, or descend to a man's legal representatives. To the same effect is also the opinion of Daly, Ch. J., in *Lockwood v. Bostwick*,<sup>3</sup> in 1869. In the Supreme Court of California, in *Derringer v. Plate*,<sup>4</sup> in 1865, it was held that a person's right to a trade-mark accrues to him from its adoption and use for the purpose of designating the particular goods he manufactures or sells, and

<sup>1</sup> 57 Barb. 526, and 4 Am. L. T. R. (St.) 168.

<sup>2</sup> 8 Am. L. T. R. (St.) 288, and 2 Brewster, 321.

<sup>3</sup> 2 Daly, 521.

29 Cal. 292.

has no value except when so employed, and indeed has no separate abstract existence, but is appurtenant to the goods designated. In *Walton v. Crowley*,<sup>1</sup> in the United States Circuit Court, S. Dist. of New York, in 1856, the plaintiff was the assignee of the trade-mark and of the good-will of the trade. There are other American decisions all tending the same way; and it is believed that not one can be found which positively affirms a contrary notion. As to English decisions, in the *Leather Cloth Companies case*,<sup>2</sup> in the House of Lords, in 1865, Lord Cranworth said that the right to a trade-mark may in general, treating it as property, or as an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser; and in that opinion the remainder of the court concurred. Vice-Chancellor Wood, in *Ainsworth v. Walmesley*,<sup>3</sup> in 1865, said, substantially: Inasmuch as the court protects the owner of the mark, he is entitled to authorize another, when he hands over his business to him, to place that mark on his goods. Thus the mark is a thing bought and sold, a right recognized and protected in a court of equity, which can be disposed of for money. It is, therefore, in that sense of the word, property. In the Rolls Court, in *Hall v. Barrows*,<sup>4</sup> in 1863, it was held that a trade-mark could properly be sold with certain iron-works; and that it constituted a part of the partnership assets, and should be so treated. In all these cases — and they lay down the settled law — the transfer of the trade-mark was concurrent with the transfer of the business or goods. If by any possibility they be deemed not sufficiently conclusive, the reader for himself may examine other authorities.

§ 363. *Reasons why an Abstract Symbol cannot be transferred as a Trade-Mark.* — If the mere representation of a symbol adopted as a trade-mark could be changed from the

<sup>1</sup> 3 Blatch. 440.

<sup>2</sup> 11 Jur. (n. s.) 513.

<sup>3</sup> L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. (n. s.) 205; 14 L. T. (n. s.) 220; 14 W. R. 363.

<sup>4</sup> 10 Jur. (n. s.) 55. See also *The Collins Co. v. Cohen*, 3 K. & J. 428; *Wotherspoon v. Currie*, 23 L. T. R. (n. s.) 443; 18 W. R. 942.

possession of one person to that of another, in the same manner as is a patent for a design, or a copyright in a book or print, such a transfer would be productive of fraud upon the public. It is a matter of no consequence to the purchaser of an article protected by a design-patent as to who made it, nor to the purchaser of a book as to who published it; for the value of the thing could be tested by its intrinsic excellence. But a trade-mark is an index pointing to an article as the product of a certain person or place. The law would not permit it to be used as an instrument of falsehood. Take the case of *Samuel v. Berger*<sup>1</sup> as an illustration of judicial treatment of such a use of a mark. The plaintiffs said that one Brindle, a watchmaker, had acquired a reputation as such, and that all watches made by him were stamped with his name; that Sylvester J. Samuel purchased from Brindle the right to stamp Brindle's name on watches made by Samuel; and that Samuel assigned to the plaintiffs the right to stamp Brindle's name on watches made by them. The court held that the plaintiffs had no case of which a court should take cognizance. In the case of the *Leather Companies*,<sup>2</sup> Lord Kingsdown said, that, if an artist or an artisan has acquired, by his personal skill and ability, a reputation which gives to his works in the market a higher value than those of other artists or artisans, he cannot give to any other person the right to affix his name or mark to their goods; because he cannot give them the right to practise a fraud upon the public. In the same case, the Lord Chancellor regarded such an act as an imposition on the public. He put this hypothetical case. Suppose an individual, or a firm, to have gained credit for a particular manufacture, and that the goods are marked or stamped in such a way as to denote that they are made by such person or firm, and that the stamp has gained currency and credit in the market and become of great value (there being no secret process or invention), could such person or firm, on ceasing to carry on business, sell and assign the right to use such name and

<sup>1</sup> 24 Barb. 163; 13 How. Pr. 342; and 4 Abb. Pr. 88.

<sup>2</sup> *Ubi supra*.

mark to another firm carrying on the same business in a different place? Suppose a firm of A. B. & Co. to have been clothiers in Wiltshire for fifty years, and that broadcloth marked "A. B. & Co., Wilts," has obtained a great reputation in the market, and that A. B. & Co., on discontinuing business, sell and transfer the right to use their name and mark to a firm of C. D. & Co., who are clothiers in Yorkshire, would the latter be protected by a court of equity in their claim to the exclusive right to use the name and mark of A. B. & Co.? "I am of opinion that no such protection could be given," said he.

§ 364. On the formation of a partnership with one who owns a trade-mark, whether it becomes an asset of the partnership or not, depends on contract.<sup>1</sup> Where one allows the use of his mark on goods manufactured by the firm, that fact alone does not operate as a transfer of it, but it may remain the sole property of the individual owner.<sup>2</sup>

§ 365. *A Section that has no Meaning.* — "Sect. 13. That citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office."

This section, which has the same paternity as that last preceding, is a curiosity of legislative literature. Why wish the protection of a trade-mark in a foreign country? Because one has a trade-mark in such country. How? By the only possible means, that is to say, by having his peculiar emblem, his commercial signature so to speak, affixed to vendible commodities. Indeed! then he comes under the first section of this act, which applies to "owners of trade-marks used in commerce with foreign nations. . . . provided such owners shall be domiciled in the United States." If a citizen and

<sup>1</sup> See *ante*, § 57, "Title to a Trade-Mark by Assignment." *Bury v. Bedford*, 10 Jur. (N. S.) 503; 4 De G., J. & S. 352; 33 L. J. Ch. 465; 10 L. T. (N. S.) 470; 12 W. R. 726.

<sup>2</sup> *Kidd v. Johnson*, 100 U. S. 617.

resident here, is he not domiciled here? True, but may not all that be, and yet he have a commercial establishment in such foreign country? Undoubtedly. And may he not by agents or otherwise conduct business exclusively abroad, that is, have no commerce "with" a foreign nation? Certainly, for the preposition "with" implies union, conjunction, connection, transition, a sending of merchandise from this country to that; but then, if he have a commercial establishment, by the laws of all civilized nations he is considered to be, commercially speaking, a citizen of that nation. But suppose an extreme exceptional case to which this section would apply, what then? Well, take that case, and turn back to the first section. It says, "or located in any foreign country," (let the absurd words "or tribes" be omitted,) "which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration." If registration here be "a condition precedent to getting such protection there," the first section provides the means. *Quod erat demonstrandum.*

Before quitting the consideration of this section, the perplexed student may ask the meaning of the words, "for that purpose as is above allowed to foreigners." If anything, they mean, to satisfy a commercial law of another country with which the owner of the trade-mark has no commerce; for, as is shown, if he have commerce with it, he need not invoke the bald charity of this section. If he have not commerce with it, then this provision is in direct conflict with the constitutional authority "to regulate commerce with foreign nations." What mean the words "as is above allowed to foreigners"? Nothing. The foreigner, as such, does not appear on the scene. This act is in the interest of American commerce. Commercial domicile, and not political nationality, is the point. A foreigner, *eo nomine*, is allowed nothing. He and the citizen of the United States stand on the same footing, if not domiciled in this country. If domiciled here, they are equally regarded. If the foreigner's nation has treaty stipulations with this one, or affords tantamount means of protection, then he may take advantage of the protection of this act; and so may any one else "located" in the

reciprocating country. It does not seem possible to conceive a case in which this section could be operative. Therefore the certificate provided for would be a costly delusion and a snare. The books say of a statute, that "it can do no wrong; but it may do several things that look pretty odd," as Lord Holt expresses it.

§ 366. *A seemingly unnecessary Act.*—An act approved August 5, 1882, provides "that nothing contained in the law entitled 'An Act to authorize the Registration of Trade-Marks and protect the same,' approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act." This seems to be sheer surplusage. By the act, to which this is virtually an amendment, every possible species of trade-mark embraced by the foregoing is entitled to registration. The Patent Office has vainly sought means of giving force to this enactment of 1882. It does not in the slightest degree add to or take from the efficacy of the established practice.

§ 367. *Meaning of the Word "lawful" as here used.*—Who shall judge? Clearly the officer whose duty it is to register. The validity of a so-called arbitrary symbol is a matter to be judicially determined. He asks: Could the supposed mark be sustained in an action or suit? Is it the common-law symbol of commerce, which, as such, is entitled to recognition the world over, by reason of possessing all the essential characteristics of a trade-mark?<sup>1</sup> If either question requires a negative answer, the application must be rejected. And it must not only be a lawful trade-mark intrinsically, but it must, under the present statute, be rightfully used by the applicant, in the kind of commerce specified. The sworn statement cannot establish a conclusion of law. Some things are without the pale of adoption for the purpose. The following cases serve to illustrate a general principle. An applicant desired to register what was shown by the fac-similes and verbally described

<sup>1</sup> See Chapter III., on "Definition and Nature of a Trade-Mark," especially §§ 87-89, 143.

as "the masonic emblem of the square-and-compass."<sup>1</sup> Questions: Could such an emblem be exclusively appropriated? Could it be applied to the purpose of traffic? Is it in the nature of a technical mark, to be affixed to merchandise to denote its origin or guarantee its genuineness? No. It is the symbol of a fraternity known throughout the world, pervading all classes, and claiming great antiquity. As an ideogram, it virtually proclaims the one using it to be a member of a certain order of men, whether such be true or false. It appeals to fraternal feelings. It has been anathematized by one religious faith, and by many persons is held to be a sacred thing. It is not a suitable emblem for commerce, which avoids partisanship in religion, politics, or ethics. If now seen on the heads of flour-barrels, where the applicant has placed it, what meaning must it convey? That it is the arbitrary sign of a certain product? No. What then? That it is to be taken in its legitimate and ordinary sense. Words may sometimes be valid trade-marks.<sup>2</sup> Suppose the word "Christian" were impressed into the service of trade, would it be tolerated? Assuredly not. Yet certain emblems, which were primarily suggestive of a faith, or a nationality, have ceased to be limited. The cross, for example, has been used by Pagans as well as by Christians.<sup>3</sup> The crescent, the symbol of Mohammedan faith, was a component part of a valid mark used in trade with the Turks, as is shown by the case of *Gout v. Aleploglu*, and it seems that the most bigoted found no fault therewith.<sup>4</sup> But the masonic emblem has not been so used, and from its nature cannot be. Case rejected: On appeal, Thacher, Acting Commissioner, in 1872, said: "Applicant is a manufacturer and vendor of flour in the city of St. Louis, Mo. He has two establishments upon different streets, and he seeks to register, as trade-marks to be

<sup>1</sup> *Ex parte John F. Tolle*, two cases.

<sup>2</sup> See *ante*, § 89 a.

<sup>3</sup> The order of the Red Cross now includes in its membership many nationalities, some of whom are Mohammedans, others perhaps fire-worshippers. The members wear the symbol on their garb on the battle-field, as ministers of mercy.

<sup>4</sup> 6 Beav. 69, n.; 5 Leg. Obs. 495.



used upon the barrels containing his flour, the words, 'Cherry St. Mills' in one case, and 'Market St. Mills' in the other, combined respectively with a well-known masonic emblem, the square-and-compass. These combinations of words and symbols, it is strenuously maintained, embrace all the requisites, and come within none of the negative exceptions or limitations of the law defining a legal trade-mark. Applying the comprehensive test laid down by the Commissioner in *Ex parte Dawes & Fanning*,<sup>1</sup> it is said that neither of the combinations claimed is the name of a person, firm, or corporation, or is calculated to deceive the public as to the true origin or character of the article to which it is applied, or is generic or descriptive of quality; and, finally, it is asserted that each, when applied to the commodities for which it is adopted as a trade-mark, will distinguish them from others of the same class. The essence of these alleged trade-marks is the masonic symbol, the square-and-compass. It has already been determined that the words alone do not possess the characteristics of a legal trade-mark, and, in order to make it appear that the addition of the square-and-compass do confer these characteristics, it is also insisted that this masonic symbol is not used with its ordinary signification. . . . There was a time when the cross and crescent, and the red and white roses of the houses of York and Lancaster, possessed as symbols such a significance, and occupied such a place in the public mind, in portions of the old world, as would affect common affairs, and could not properly be disregarded, under whatever circumstances they should appear. If they were now held in the same estimation in this country, who imagines that they could be divested of their general significance so that they could successfully be adopted to constitute trade-marks, or parts of trade-marks, and be displayed before the public in that capacity? The case of these masonic symbols is in some respects different, to be sure, yet it is in important particulars similar, and the same objections lie to their use in the manner proposed. I am clearly of opinion, therefore, that the proposed combinations cannot properly subserve

<sup>1</sup> 1 Off. Gaz. 27.

the ends of a trade-mark. Among masons with whom this token has a moral significance, its use in that capacity would undoubtedly be regarded as a base prostitution of it to mercenary purposes, while with others its mystic force would often dissipate its virtues as a trade-mark, and perhaps in some instances place the article it appeared upon under a ban. Decision of the Examiner affirmed," Oct. 3, 1872. A still fresher matter now opportunely presents itself, to reinforce our position. It is an appeal from the Examiner. Thacher, Acting Commissioner: "This appeal covers two applications. The first is for the registration of the words and letters 'Parson's Purgative Pills, P. P. P.,' as a trade-mark. The decision in *Blakeslee & Co.*<sup>1</sup> indicates the action that should be taken in this case. In that case, the Commissioner held, that the addition of the initials 'C. O.' to 'Cundurango Ointment' was not sufficient to entitle applicants to registration. . . . The second application asks for the registration of the words, 'Johnson's American Anodyne Liniment, established A. D. 1810.' It is claimed that the phrase, 'Established A. D. 1810,' is an arbitrary distinguishing mark, and that by the addition thereof the whole is constituted a legal trade-mark. This view of the case does not seem to be correct. The additional phrase indicates the date of the discovery of the liniment, or the commencement of its manufacture, and to this extent is descriptive in nature. Any other person who made a similar liniment the same year would have as much right to use these particular words as the applicants in this case. . . . The decision of the Examiner is affirmed in both applications."<sup>2</sup>

§ 368. The effect of the foregoing and similar judgments is to correct an error prevalent in the minds of solicitors who have devoted themselves wholly to the practice of patent law. That error is the improper application of the theory of *combinations*. In reasoning from a supposed analogy, they deduce a wrong conclusion. A technical combination in machinery may be defined, not as a new machine, but as a new union

<sup>1</sup> Com. Dec., 1871, p. 284.

<sup>2</sup> Ex parte J. S. Johnson & Co., 2 Off. Gaz. 815.

of elemental parts not before brought together in that kind of machine. The machine itself may have previously existed; and so may the separate elements of the new combination; but if those elements have not before been united so as to produce a method of operation differing from what had been done before in that kind of machine, what is called a new combination is created.<sup>1</sup> Therefore they think that the combination of verbal elements, inefficacious when single, may constitute a new, and on that account a valid, symbol of trade. We can find applications on file, where line has been piled upon line and precept upon precept, in the vague idea that, because the combinations are new, they must perforce be deemed true symbols of commerce. As has been said in a previous chapter, the idea of *invention* does not enter into the contemplation of a trade-mark. An applicant<sup>2</sup> claimed as his mark the words "Chestnut Hill Bourbon," to be branded upon casks or packages containing whiskey. The Examiner questioned the right of the claimant to the exclusive use of the words, and asked, Where is said "Chestnut Hill"? What is the meaning of "Bourbon"? Is not the use of the word "Bourbon" calculated to create a wrong idea of origin? In reply to the official letter of inquiry, a written argument of counsel and a number of affidavits were filed. The affiants came up boldly to the task of proving a conclusion of law, and swore that the combination of words constitute a lawful trade-mark. The argument of the counsel affords a clew to the remarkable statements of the party and his witnesses. We find that he treats the case as if it were an application for a patent for an aggregation of useful elements in a machine, or the bringing together of various chemicals in a new composition of matter. A single extract will suffice to show the counsel's position. He says: "As in case of patenting a new machine, it is sufficient if this *combination* of old and well-known words embrace sufficient novelty and distinctiveness from all others, as to be readily and easily distinguishable therefrom, so that none is wronged

<sup>1</sup> Curtis on Patents, § 1.1 (3d ed.).

<sup>2</sup> Ex parte John E. Cassidy, Sept. 24, 1872.

or misled. This, I believe, the testimony fully establishes." It is manifest that the counsel intended to relieve the Office of the task of interpreting the plain, ordinary, and popular language of the claim. This proposition is clearly patentable as an invention, so far as *novelty* is concerned, and would be unobjectionable if it had *utility*. But we find a well-settled rule of evidence, that the *testimony of experts* cannot be adduced to aid a court in reading an instrument, unless it be non-decipherable by ordinary eyes, or has a hidden or technical meaning explainable only by parol evidence.<sup>1</sup> If the sworn testimony in this case were conclusive, the difficult ways would be made smooth. The applicant swears that "the words 'Chestnut Hill Bourbon,' if used alone, would be an entirely new, distinct, and unmistakable trade-mark," and the experts, dealers in spirituous liquors, say that the mark composed of the words claimed "is unobjectionable in all respects," that the applicant "is clearly entitled to its exclusive use," &c. One witness says that "the word 'Bourbon' is used to designate all whiskeys made from corn, rye, and malt, in contradistinction to those whiskeys made entirely of rye and known as 'rye whiskey';" and the applicant says that Chestnut Hill Reservoir is an outwork of the Boston city water-works, and from that place the name is adopted by him. From all the facts, a conclusion was drawn unfavorable to the application. Rejected.

§ 369. *Simulated Trade-Marks on Watches and other Articles of Foreign Manufacture.*—Section 2496 of the Revised Statutes, as amended March 3, 1883, is as follows: "No watches, watch-cases, watch-movements, or parts of watch-movements, or any other articles of foreign manufacture, which shall copy or simulate the name or trade-mark of any domestic manufacture [manufacturer], shall be admitted to entry at the custom-house of the United States, unless such domestic manufacturer is the importer of the same. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his

<sup>1</sup> 1 Greenl. Ev., Chapter XV.

trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department fac-similes of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs."

This is simply a safeguard against the fraudulent importation of certain merchandise bearing simulated trade-marks, and yet it is of sufficient importance to be noticed here. As matter of fact, not very strict attention has been paid to its provisions by our manufacturers. The reason of their seeming neglect may be traced to the falling away of this kind of fraud. The virtue of the statute reached across the Atlantic, and in a great measure dissuaded Swiss and other skilled artisans from an unprofitable trade.

§ 370. *Criminal Law of the United States in Respect to Trade-Marks, etc.* — Penal restraint in the matter of fraudulent imitations of trade-marks originated in stern necessity. Legislation on this subject is by no means novel, in most of the commercial nations of the world, although the first act of our Congress in this regard dates no farther back than August 14, 1876. Whenever any nation has provided a civil protection for authenticating emblems of manufacture and commerce, almost without exception has the civil enactment been upheld by the strong arm, and crime has shrunk from the terrors of confiscation of spurious merchandise, besides fines and imprisonment. Our own country, the United States of America, down to the above-mentioned date, had been a rich and almost unprotected victim of the trade-mark pirate. If the matter had been legislated on at all, it was by individual States. If an audacious pirate were attacked in one jurisdiction, he could step over the boundary line, and thence he could with impunity supply retailers with his spurious wares. Civil prosecutions were generally barren of results, at least so far as the worst class were concerned. Something was needed that could act instantaneously on persons, as well as merchandise, — something that could reach our

dividing lines of States, and exert a physical as well as moral power. A bill was modelled on a criminal statute of the State of Ohio, and was enacted by Congress into a law.

§ 371. "An Act to punish the Counterfeiting of Trade-Mark Goods, and the Sale or Dealing in of counterfeit Trade-Mark Goods," is the title of that law. It provides that every person who shall, with intent to defraud, deal in, or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment. For even affixing such trade-mark or imitation, the penalty is the same. So, also, for filling, or causing to be filled, any package bearing such trade-mark or imitation; or making, or having in possession, or dealing in, dies, &c.; or forging or counterfeiting things in the nature of trade-marks; or dealing in empty packages bearing trade-marks. Search-warrants may be issued, and plates, &c. may be destroyed. Persons aiding and abetting in the frauds incur a penalty of not exceeding five hundred dollars, or imprisonment for a year, or both such fine and imprisonment. The apparent severity of this sweeping law has sometimes caused committing magistrates to shrink from applying it. If examined carefully, it will be found sufficiently guarded and flexible to insure a due administration of justice. It is intended to operate solely on those who have reason to dread justice. This penal act is merely ancillary to the civil act or acts. It does not specify any particular statute, but refers to all registration laws of the United States. At the date of its passage, there was in contemplation of law no registration, for the so-called registration act of 1870 never legally existed. The lever of the penal statute was therefore inoperative for

want of a fulcrum. But an act of Congress may be inoperative, and yet not be void. It so remained until the 3d of March, 1881, the day on which the present registration act was approved. The Supreme Court has said that the suspension of an act cannot be construed to be a repeal of it. This is settled law. Even the revival act may be made to depend on a future event, and that event may be made known by proclamation, and when so revived it is in full force and effect. But this is not an instance of revival; for the penal act was not dead, but simply dormant. Its sleep was ended by the birth of the act of 1881. No words were required in the latter to set the penal law in motion. That which is implied in a statute is just as much a part of it as is that which is expressed. Nor is it repealed by the civil act of 1881.<sup>1</sup>

§ 372. *The Penal Act and the Civil Act in effect one.*— They are acts *in pari materia*, and therefore must be construed together. Chancellor Kent says that “the object of the rule is to ascertain and carry into effect the intention; and it is to be inferred that a code of statutes relating to one subject was governed by one spirit and policy, and was intended to be consistent and harmonious.” The Supreme Court of the United States has said: “The correct rule of interpretation is, that if divers statutes relate to the same thing, they ought all to be taken into consideration in construing any one of them, and it is an established rule of law, that all acts *in pari materia* are to be taken together, as if they were one law. If a thing contained within a subsequent statute be within the reason of the former statute, it shall be taken to be within the meaning of that statute; and if it can be gathered from a subsequent statute *in pari materia* what meaning the legislature attached to the reason of a former statute, they will amount to a legislative declaration of its meaning, and will govern the construction of the first statute.” The same court has said that a law is the best expositor of itself, that every part of the act is to be taken into view for the purpose of discovering the mind of the legislature. So it has said that the

<sup>1</sup> The edition of Rules of Practice issued by the Patent Office in 1885 contains this act of 1876 among the statutes in force.

act itself speaks the will of Congress, and that courts will properly recur to the history of the times to infer the sense and meaning. Lord Coke gives this rule for construing a statute: "Consider what was the common law before the act, what the mischief or defect to be remedied, and what remedy Parliament had resolved to adopt to cure the mischief or defect." The true reason and remedy being ascertained, such conclusion should be made as will suppress the mischief and advance the remedy; avoiding and suppressing subtle inventions and evasions advanced *pro privato commodo*, and giving life and vigor to the remedy proposed *pro bono publico*.

§ 373. *Advantages of Federal Registration.* — This seems to be the time for answering questions on this point. — 1. It creates testimony, as registration is *prima facie* evidence of ownership in the trade-mark. Not only the certified statement, or specification, and the declaration, fix the title in the registrant as against any other claimant, thereby throwing the burden of proof on an adverse claimant, if such there be; but the certificate is evidence in any suit or action in which it is brought in controversy, and establishes the precise description of the symbol claimed, defines the class of merchandise to which the trade-mark is applied and affixed, fixes the date of adoption as to all the facts alleged, and obviates what would otherwise be a necessity, i. e. the production of oral testimony, and that at perhaps great inconvenience and expense. — 2. Registration is a compliance with the requirements of foreign nations, prior registration here being a condition precedent to registration in such countries by a citizen or resident of this country. Here it must be remembered that, in most foreign nations, judicial redress for infringement of trade-marks cannot be had without registration. — 3. Registration is a means of effectuating treaty stipulations on this subject. — 4. It tends to uniformity of practice in suits in equity, and even in actions at law, notwithstanding that, when practicable, these are governed by the law of the State where pending. — 5. The fact of registration gives cognizance to courts of the United States in controversies between citizens of the same State, where a trade-mark used in for-



oreign commerce is involved. — 6. By registration, original and appellate jurisdiction is given to said courts without regard to the amount in controversy. — 7. It gives a right to damages sustained in consequence of false representations made by a rival registrant. — 8. A knowledge that a trade-mark has been registered has a strong moral effect in deterring infringements. — 9. The assertion of title on the national records gives an air of permanency to a trade-mark; and being on such records, the title may be traced through all assignments. — 10. Finally, registration is an indisputable prerequisite to a criminal prosecution for counterfeiting, or the selling of goods falsely marked, under the penal statute of August 14, 1876.

§ 374. *Effect of Registration.* — It has been contended by some able lawyers that the effect of the registration of a symbol, never before used as a trade-mark for the same class of merchandise, is to create property in that symbol, although it may not be sufficiently distinctive at common law. They mean that, while at common law the mark, to become a true index, must acquire a popularity, must become identified with the article that bears it, on the other hand the registration is notice to the whole world, and, *ex proprio vigore*, makes the symbol a lawful trade-mark. The maintenance of such a doctrine would make almost anything a trade-mark, however generic, or however likely not to be recognized by any peculiarity, and would inevitably lead to confusion, and result in the detriment of trade. If the most common or simple words or figures could be transmuted into exclusive signs by passing through the crucible of the Patent Office, who would be safe in using any word or letter until he has first ascertained whether some one has not appropriated it as his mark of manufacture? The whole language might thus by degrees be fettered, so that a merchant would not dare to call his wares by their right names. The correct doctrine is now better understood.

§ 375. The decision in “The Blanchard Churn”<sup>1</sup> case gave an impetus to this way of thinking. The Examiner

<sup>1</sup> Com. Dec., 1871, p. 97.

refused the application for registration of these words, to be stencilled on the side or lid of churns manufactured by persons of the name of Blanchard; and he insisted that the *words* should be accompanied by some *sign* or *mark* to distinguish the same from the mere words alone, to the use of which letters other possible parties of the same name in the like business might have an equal right. On appeal to the Commissioner, he said that the question, What constitutes a lawful trade-mark? is left by the statute just where the common law leaves it, with a simple limitation, that it shall not be the mere name of a person, firm, or corporation, unaccompanied by a *mark* sufficient to distinguish it from the same name when used by other persons. The only thing ambiguous about this limitation, said he, is the meaning of the word *mark*. The Examiner seemed to understand by this word some device, figure, or emblem, something other than mere words, from which he, the Commissioner, dissented. He was clearly of the opinion that the expression "The Blanchard Churn" is not the mere name of a person, but that the name is accompanied by the marks "The" and "Churn," and hence is not excluded by the limiting clause of the statute. *Held*, that the combination of the three words "The Blanchard Churn" seems to possess the necessary characteristics of a trade-mark, and is not excluded by the limitations. The decision of the Examiner was therefore reversed.

§ 376. The foregoing decision opened the door to many proposed trade-marks of an exceedingly doubtful nature. Finally, after the registration of combinations formed upon the model thus furnished, the question came up again before the same Commissioner. In this instance, the proposed mark consisted of the words "The Hall Calendar Watch," intended to be affixed to a watch sold by the applicant, named Hall.<sup>1</sup> The counsel for the appellant cited the Blanchard case, and relied upon it to sustain his position. Certainly, if one were valid, so must the other be. One of the points on appeal was this: "If a person adopts the words 'The Hall Calendar Watch' as a trade-mark, and is the first to do so, and *registers*

<sup>1</sup> Com. Dec., 1872, MS.

*such in the Patent Office, thereby notifying the public of such, he is the first to comply with the requisition of the law, and consequently should be protected. If another person by the name of Hall wishes a trade-mark for watches, he must adopt another symbol.*" The decision of the Examiner, rejecting the application on the ground that those words could not constitute a valid trade-mark, was affirmed by the Commissioner.

§ 377. In other cases, in his oral review of the statements made by him in the Blanchard matter, the Commissioner entirely receded from the position there taken by him. Thus the question may, so far at least as the Patent Office is concerned, be considered to have definitely been set at rest. This virtually decides, if a decision upon so obvious a point seems necessary, that the mere fact of placing on record the evidence of claim cannot operate to *create* a title to the exclusive use of a symbol which could not be a trade-mark *without registration*. In another appeal case,<sup>1</sup> the Commissioner said that, at common law, the trade-mark, to become legal, and to vest an exclusive right in the person adopting it, must have been so long in use as to be known and recognized in the market. That is, a person could not adopt a trade-mark to-day and successfully sue for infringement of it to-morrow; and he was of opinion that one object of the registry law was to settle this very question. *Registry*, said he, is notice to the world, and supplies the place of *long use* at common law.

§ 378. If the Commissioner meant to intimate, as he probably did, that the reason why one could not recover at common law upon a new mark is because he would lack evidence of its recognition in trade, and that one object of the statute was to furnish a convenient mode of proving adoption, then his decision is unquestionably sound. He is in effect prohibited from receiving and recording any marks but those which would be valid at common law.<sup>2</sup>

§ 379. Having easily become persuaded that Congress did not think of *creating* a trade-mark, — as is evident from the

<sup>1</sup> Re Dutcher Temple Co., Com. Dec., 1871, p. 248.

<sup>2</sup> Act of March 3, 1881, sect. 3.

whole of the legislation upon the subject, and especially by the language which prescribes that the applicant shall show that he "has at the time a right to the use of the trade-mark sought to be registered,"—we are led to the consideration of another point. It having been made tolerably clear to the shallowest apprehension that the act of recording is merely an act of recognition of a symbol affixed to merchandise, with the intent that the purchaser shall associate it with a certain product, or a particular vendor, we ask, When is that symbol to be deemed to be affixed? Must there be actual taction, i. e. a union of the symbol and the vendible article, or is the act of filing in the Patent Office *in law* an affixing? That is, does a man who *intends* to adopt a mark, and who complies with certain conditions and regulations, acquire a right to the exclusive use thereof as a mark for goods *before* he shall have stamped, branded, or painted the same upon his merchandise? It has been contended by respectable counsel that he does. It is well worth our while to discuss and settle this point, as upon it must frequently depend the question of priority of adoption.

§ 380. What does the claimant register,—his mark, or what he intends shall be his mark? But it is not a mark until actually *marked* upon something, and that something an article of commerce. He does not in any case *file* his mark, but he does file "a description of the trade-mark itself, with fac-similes thereof," and he makes oath, or its equivalent, "that the description and fac-similes presented for registry truly represent the trade-mark sought to be registered."<sup>1</sup> We see that he does not file his mark, for that he could not do unless he could at the same instant sell to the United States the article bearing the mark; but he does file the *representation* of his mark. Does that fact vest title? Is he excused from actual use? May he lay his certificate in a bureau drawer, as he would a patent, and for days, months, or years neglect to exhibit it to purchasers of the goods that he has specified, and at any time claim the right to exclusive use? If he may in one instance thus obtain title, he may adopt a

<sup>1</sup> See Sects. 1 and 2 of Act of March 3, 1881.

thousand emblems, and remain in a quiescent state until one or more of the number shall have acquired celebrity in connection with the merchandise of others, and then assert his paper title. Is the issuance of a certificate a symbolical delivery of property, as in the case of a deed of lands? For the sake of argument, we assume that the giving of a certificate is obligatory in all cases of registration. It is true that this is the practice; but as a legal truth, the registry is complete, even if no certificate ever be issued of that fact. The certificate is only evidence. We are not now indulging a speculative fancy, but considering a matter that has been argued again and again. The answer is this. The certificate has no analogy to a deed, for in a deed there must be a grantor as well as a grantee, and a thing to be granted. The government does not pretend to hold title in the symbol employed as a trade-mark, and therefore it is not a grantor. It merely makes a compact with the proprietor of the mark, and guarantees protection, for a consideration paid. If the certificate given upon registration were an investiture of title, a livery of seisin, what would be the logical effect? If a grant in one case, so must it be in another. If a man admit that he obtained a right to exclusive use by registering his mark, he also concedes that the mark that he has used for half a century had no legal existence, and he thereby makes himself the junior of any imitator who has used it for a less time, and destroys the antiquity of his mark. Being driven to the wall, the counsel say that the intention to adopt, the filing, and the recognition by the Patent Office, is an adoption. Rutherford, in his *Institutes*, (p. 25,) tells us that "a man's bare intention of acquiring a thing is not enough to make it his own till that intention is known; for without the consent of mankind no property could be gained justly, and there could be no ground for presuming that they consent to what they know nothing of. Now the act of occupancy is the outward mark by which his intention is made public. And this act is, therefore, understood to give him property." The act of occupancy of a symbol is that act which commerce throughout all ages, and in all countries, has imperatively

required, — the physical application of the same to merchandise. This view of the law was entertained by the Office in the well-contested case of *Schrauder v. Beresford & Co.*,<sup>1</sup> and was silently acquiesced in by the counsel for the losing party, one of which counsel had been Commissioner of Patents, and the other Acting Commissioner; and more recently it has been reaffirmed in the case of *Sternberger v. Thalheimer & Hirsch*.<sup>2</sup>

§ 381. *Registry of Prints or Labels for Articles of Manufacture.* — It seems to be necessary to consider in this place an enactment of Congress that has apparently no claim to constitutionality. It is the third section of the act of June 18, 1874,<sup>3</sup> which provides that no prints or labels to be used for any article of manufacture, other than pictorial illustrations or works connected with the fine arts, shall be entered under the copyright law, but may be registered in the Patent Office. By that section, the Commissioner was charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the registrations provided by law as to copyright or prints.<sup>4</sup> As this seeming law still stands on the statute-book, much error flowing from it can be counteracted by a consideration of its provisions. As a fact of history, it is generally known that, prior to the unconstitutional registration act of 1870, owners of proprietary emblems of all kinds, including technical trade-marks, were accustomed to file them with the clerk of a District Court of the United States, supposing them to be copyright matter. True it is, that Federal courts had long spoken to the contrary.<sup>5</sup> They became better informed when the Supreme Court, at the December term, 1879, used the language, "Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights or in patents for inventions."<sup>6</sup> This doctrine is not yet understood

<sup>1</sup> In chapter on Interferences.

<sup>2</sup> Interference, September, 1872.

<sup>3</sup> 18 Stat. at Large, 78; 1 Supp. Rev. Stat. 40.

<sup>4</sup> Rev. Stat., sects. 4952, 4962.

<sup>5</sup> *Scoville v. Toland*, 6 West. L. J. 84; *Osgood v. Allen*, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124.

<sup>6</sup> Trade-Mark Cases, 100 U. S. 82.

by all lawyers who have to deal with such matters. When the meaning of the word *authors* in the Constitution is finally filtered into their brain, it comes like a revelation. When the *omnium gatherum* act of July 8, 1870, was manufactured, and patents, trade-marks, and copyrights were treated as being all of one family, when not at all related, trade-marks were required to be lodged in the Patent Office, if anywhere. As that act did not include labels and prints, the files of the Library of Congress were constantly becoming more incumbered with the influx of all kinds of printed labels, advertisements, notices, etc., that had some relation to commerce, but not the slightest to literature. To relieve the library from matter that never in contemplation of law belonged to it, this third section was tacked on to the copyright bill. The mischievous consequences of the inconsiderate verbiage of that section must long be felt. The Commissioner, with the approval of the Secretary of the Interior, attempted to give the section some force, although from the first the Office had seen the difficulty of trying to make it valid. The provisions of that section cannot possibly stand the test that was applied to the trade-mark sections of the act of 1870.<sup>1</sup> The subject matters alike relate to commerce, and commerce only. The generalization of language is as fatal in the one case as in the other. The only jurisdiction that Congress has over the subject is derived from the power to "regulate commerce." The *ratio decidendi* of the Supreme Court in the Trade-Mark Cases is strictly applicable to this. Congress did not attempt to confine the registration of prints and labels to those used in the commerce over which it has control; viz. that with foreign nations, among the several States, and with the Indian tribes.<sup>2</sup> No judicial opinions bearing directly on the said objectionable section of the act of 1874 can be cited. But incidentally its operation has been noticed. In 1878, in the Circuit Court of the United States for the Northern District of Ohio, Baxter and Welker, JJ., the defence in a case of infringement of a trade-mark set up a registry of certain

<sup>1</sup> See Trade-Mark Cases, *supra*.

<sup>2</sup> Constitution, Art. I., sect. 8, clause 3.

labels under said section.<sup>1</sup> The writer, as counsel for the complainants, moved to exclude said labels from evidence. The ground for exclusion was expressly stated to be the lack of power in Congress to enact said section. On consideration, the court excluded them, but no written opinion was filed.<sup>2</sup> The Patent Office has frequently sought to obtain an authoritative ruling on the point of constitutionality. Opportunities were given to go to the courts. Such a ruling has not yet formally been made. Courts can only decide on issues presented. A learned judge (now of the court of last resort), in 1878, made this ruling: "The use of a label, in the sale of merchandise that it is intended to designate, prior to the registry of said label in the Patent Office, amounts to a publication thereof, and defeats registration."<sup>3</sup> That was because said third section applies the provisions of the copyright law to it. The Commissioner, in 1879, refused registration of a label because it contained trade-mark matter.<sup>4</sup> He did so in another case that contained the arbitrary word "Eddystone."<sup>5</sup> In another instance, he decided that "the presence in a label of matters registrable as a trade-mark excludes the whole from registration."<sup>6</sup> In still another, in 1881, he refused to register a label, as such, because it contained a monogram.<sup>7</sup> The applicants thereupon applied for a mandamus to compel the ministerial act of registration. The writ was allowed. The Commissioner could do nothing but register. In 1882, he refused registration for the same reason; i. e. that the label or print contained trade-mark matter, and was not a mere label, it being attached to merchandise (cigars). The very phraseology of the section seemed to justify his decision. What was the logical result of the refusal? If the thing were

<sup>1</sup> August Vogeler *et al.* v. Max Ernst, equity No. 3320. Decree for complainants, Sept. 27, 1878.

<sup>2</sup> Label Registrations, Nos. 512 and 539.

<sup>3</sup> Marsh *et al.* v. Warren *et al.*, 14 Off. Gaz. 678.

<sup>4</sup> Re The Dr. Harter Medicine Co., July 29, 1879, MS.

<sup>5</sup> Re Simpson & Sons, 10 Off. Gaz. 333.

<sup>6</sup> Re Thaddeus Davids & Co., 16 Id. 91.

<sup>7</sup> The United States *ex rel.* The Willcox & Gibbs Sewing-Machine Co. v. Marble, 22 Off. Gaz. 1366; 1 Mackey, 284. (The Office cited §§ 15 and 262 of this book.)



a trade-mark, it must be rejected as a mere label, and there was no denial of the fact that the label contained a trade-mark; and it could not possibly be a lawful trade-mark until it had been used on goods that had been sold or offered for sale. But said the court, in a case above referred to, in answer to a similar question: "The sale of the bottles of the medicine with the label on it was a publication of the label." Take either horn of the dilemma, the registration could not legally be made. An alternative mandamus was issued by the Supreme Court of the District of Columbia, in 1882. In that case the writer, as counsel for the Commissioner, distinctly raised the question of constitutionality. It was overruled.<sup>1</sup>

<sup>1</sup> It may be worth while to quote here the whole opinion of Mr. Chief Justice Cartter, speaking for the court in this case, *The United States ex rel. Schumacher & Ettlinger v. Marble* (to appear in 3 Mackey's Rep.):—

"It is objected in behalf of the Commissioner of Patents, that the act of Congress of June 18, 1874, providing for the registration of labels, is unconstitutional, and therefore void. A very elaborate, ingenious, and perhaps, under appropriate circumstances, successful argument, has been made to sustain this position. But we think the point raised has no application to this case. We do not think it lies in the mouth of a government official to call in question the constitutionality of a law directing him to perform a certain ministerial duty. If the question were raised between other parties, as, for instance, in a suit for infringement in the use of a label, and the constitutional rights of the parties were involved in it, that is to say, whether one man was prohibited from using it because another man had registered it as a label, the argument might be pertinent; but we do not think it is a question which can be raised here.

"The next reason assigned by the Commissioner for his refusal to comply with the petitioners' demand is, that the design offered for registration is a mere fanciful sketch, which, while it may be used as a trade-mark, has none of those descriptive features about it characteristic of a label. A label, it is contended, consists of a pictorial representation or a written description of the article to which it is affixed, and that a fancy picture, such as this, having no connection with its proper use or application, cannot be registered as a label. This question has been settled by this court in the case of *The Sewing-Machine Co. v. Marble*. We decided in that case that the duty of the Commissioner of Patents, on the application to him to register a label, is a purely ministerial one, as much so as the act of a recorder of deeds in placing upon public record a muniment of title. The statute has not defined what shall be considered a label,—whether it shall be descriptive of the article to which it is affixed, or whether it may be a mere arbitrary design. If the applicant produces it as a label, and appeals to the commissioner to give it the protection which the law provides for it as a label, the duty of the commissioner is to register it, and in doing so he gives it only the protection which the statute provides. It is not protected as a trade-mark nor as a copyright. The public at large may use

That ended the matter, for that case could not be brought to the notice of the Supreme Court of the United States. How does the matter now stand? *In statu quo*. Before leaving this subject, it must be obvious that labels, prints, and analogous things affixed to merchandise in the commerce over which Congress has exclusive control, may be protected by a future clearly defined legislative act.

§ 382. *Meaning of the Words "Prints," "Labels," etc.* — It early became necessary for the Commissioner to define the meaning of these words, as used in the act of Congress of June 18, 1874, because frequently they were not understood. To this day, many persons of intelligence forget that they have no relation to authorship, to be protected by copyright, but that they are mere instruments of manufacture and commerce. This is the definition: "The words 'prints' and 'labels,' as used in this act, so far as it relates to registration in the Patent Office, are construed as synonymous, and are defined as any device, picture, word or words, figure or figures, (not a trade-mark,) impressed or stamped directly upon the articles of manufacture, or upon a slip or piece of paper, or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the contents of the package, the name of the manufacturer or the place of manufacture, the quality of goods, directions for use, &c. By the words 'articles of manufacture' (to which such print or label is applicable by this act) is meant all vendible commodities produced by hand, machinery, or art. But no such print or label can be registered unless it properly belongs to an article of commerce, and be as above defined; nor can the same be registered as such print or label when it amounts to a lawful trade-mark, or when its use in connection with the article to which it is applied is arbitrary or fanciful.<sup>1</sup> To entitle the owner of any such print or label to register the same in this Office, it is and enjoy it; but *qua* label it is restricted to the use of the party who has registered it for that purpose and no other. With the character of the device the Commissioner is not at all concerned. His function is as purely ministerial as it is capable of being. The writ will issue."

<sup>1</sup> *Marsh et al. v. Warren, ante, § 380.*

necessary that five copies of the same be filed, one of which copies shall be certified under the seal of the Commissioner of Patents, and returned to the registrant. The certificate of such registration will continue in force for twenty-eight years.”<sup>1</sup>

§ 383. Priority will not be defeated because the same emblem has accidentally been used by others in the same business. This is reasonable, for a trade-mark cannot be adopted except intentionally. To reason from analogy, a patent for a machine could not be annulled, or deemed to be anticipated, merely because some one had previously by chance flung the elements together without beneficial result or a thought of invention. — In the Court of Cassation, in 1877,<sup>2</sup> it appeared in evidence that the plaintiff, a manufacturer of brushes and fancy goods had, in 1859, duly deposited a trade-mark, the representation of a lion, to be affixed to his goods. He renewed the deposit in 1876. The defendant alleged, in justification, that his predecessor had employed the mark of a lion in the same kind of business before the deposit by the plaintiff; and also that the heraldic lion with which he marked his products was completely different from that of the plaintiff. To establish the alleged priority of user, the defendant proved by witnesses that from the year 1844 his predecessor in business had used the mark in controversy; but the further fact was established, that the particular mark was but one of twenty marks that he was in the habit of affixing to goods on the order of his customers. The plaintiff rebutted, by showing that in the year 1845 his house had not ceased to mark with a lion a certain category of his products. The case had its inception in the Tribunal Correctionnel of the Seine. It was there *held* that, inasmuch as marks of fabrics or of commerce are signs or means by which a trader distinguishes his merchandise from that of his rivals in trade, to guarantee the origin of his goods, therefore a sign not intended to fulfil that object is not possessed of the essence of a trade-mark; that inasmuch as neither before the law of June 23, 1857,

<sup>1</sup> This period of time is arbitrarily fixed by the Office, following the statute in copyright cases. It has not the slightest sanction of law.

<sup>2</sup> *A. Dupont v. Debreye*, 23 *Annales*, 5.

which actually regulated the matter, nor afterwards, had the defendant or his predecessor ever asserted title in the lion as a trade-mark; and inasmuch as they did not specially mark the products of their house with the lion, but with different signs to the number of twenty, in which they did not even pretend to have property, as every purchaser selected a sign of his particular commerce, and ordered that it should be affixed to the things purchased by him, the finding must be for the plaintiff. On appeal by the defendant, the Court of Paris used substantially the same line of reasoning: that the defendant had used the lion not uniformly and constantly to distinguish the products of his fabric, but merely followed the fancy of his customers, in fact abandoning the whole number of emblems to the choice of other parties; and that the lion had not the character of a sign to distinguish the manufacture. On a final appeal, the Court of Cassation adopted the *ratio decidendi* of the courts below, and affirmed the judgment.—To the same effect was a decision in the Tribunal Correctionnel of the Seine, in 1878.<sup>1</sup> The prosecuting party caused to be seized cards of buttons bearing as a trade-mark a beehive substantially like his own, but surrounded by numerous accessories, among which were implements of agriculture and gardening, a vessel's anchor, a flag, and a cannon. The plea was that the defendant had borrowed the vignette from an old volume of poetry, and that besides his device differed essentially from the prosecutor's; but the judgment was against him for damages and costs. When such a defence is set up to defeat an honest trade-mark, the defendant who alleges the anteriority of his label should be held to strict proof.—In the Court of Bordeaux, on appeal, in 1878,<sup>2</sup> it appeared that the tribunal below had condemned the defendant to pay 10,000 francs damages, and restrained him from using the name "Guyot," or "Vallet," or the denomination "Perles d'Ether," and all labels tending to confusion. It was held that the books of a printer, establishing the delivery of a certain number of labels, cannot be evidence of

<sup>1</sup> Parent v. Chaumont, 23 Annales, 164.

<sup>2</sup> Torchin v. Cathrin, Ibid. 249.

priority of adoption by the defendant, unless those books contain a detailed description of the contents of said labels, so that the court may judge of their exactness.

§ 384. But this matter of adoption involves a refinement that we have not yet touched upon. Suppose A. to make a device, which he intends at a convenient time to stamp upon his goods as his distinctive symbol; and suppose that he has gone to great expense in procuring engravings, dies or brands, for the purpose of affixing his symbol, but before his labels shall have been delivered by the printer, or his dies or brands be put into actual use, B., learning A.'s intention, adopts that very symbol as his. B. is the first to actually use the mark; but is not his act of adoption tainted with fraud? A moral wrong has been committed by B. His conduct has, perhaps, been a breach of confidence. We agree that a title to property cannot be obtained by fraud. But the answer to this suggestion of fraud is, that A. must have had property before he could be despoiled of it. This unscrupulous act of B. is a wrong that must be adjudicated *in foro conscientiæ*, for no human tribunal can give redress. It is a clear instance of *damnum absque injuria*. We do not lack analogies to confirm this conclusion. It is a familiar fact, that, by the fiction of the settled English patent law, as it was up to January 1, 1884, he was deemed to be the first inventor who first communicated an invention to the public, although not so in any just sense, but who had been guilty of bad faith throughout. Hills, an American inventor of a machine for making brushes, embarked for England for the purpose of obtaining a patent. He had had confidential relations with one Sheldon in this country, and the latter conceived the idea of obtaining a patent for himself for the thing that Hills had invented, and actually reached England and secured a patent before Hills arrived there. Steps were immediately taken by the true inventor to enjoin the swift-footed sharper. *Held*, by the Lord Chancellor, to be a case of wrong without a remedy.<sup>1</sup>

<sup>1</sup> This case seems not to be embraced in any permanent report; but instances of the same nature are not rare. See Jacob's Fisher's Digest, title "Patents."

In a hearing before the Attorney-General (Sir R. P. Collier), in 1870,<sup>1</sup> counsel for the patentee successfully urged this rule against the real inventor (one Overend, of San Francisco, California), who not only lost his invention, but was also compelled to pay costs. — We may suppose a case wherein the actors are nations. It is ascertained by one nation that another nation is fitting out a fleet at great expense, with the intent of taking possession of a savage or an uninhabited country; and the nation first mentioned, without a moment's delay, pounces upon and holds the prey, and annexes the new territory. Who becomes the sovereign, — he who *intended* to seize, or he who actually occupied the new country? Spain obtained her title to a large portion of the Western Hemisphere by the planting of her flag; but what if, while Columbus, or Vespuccius, was drifting over the ocean, a more swiftly sailing flotilla had darted upon the coveted prize? Spain would have come to grief. The fact of first starting in the race would not avail. First come, first served. When a thing has no lawful owner, the first actual occupant obtains the exclusive right to it. This rule is as applicable to trade-marks as to any other property.<sup>2</sup> This ends the discussion of "Federal Legislation," and the principal rules applicable thereto.

<sup>1</sup> Dunn's Application, No. 2427, Int. Pat. Off. Circ., January, 1871.

<sup>2</sup> As an example of actual appropriation as against a mere intention to appropriate, see the interference case of *Schrauder v. Beresford & Co.*, *infra*, § 661.

## CHAPTER VIII.

## INFRINGEMENTS.

- § 385. What constitutes infringement.
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- § 407-410. “*Grande Chartreuse*” cases.
- § 411. “*Anchor-brand Wire*” case.
- § 412, 413. “*St. A \*\*\*\*\**” case.
- § 414. Colorable infringement, — chocolate case.
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- § 418, 419. Blending of trade-mark and other rights.
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- § 449. Theory of infringements.
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§ 385. *What constitutes Infringement.* — It may broadly be stated thus: one man has not a right to use a name, or other mark, for the purpose of attracting to himself the trade or custom that would have flowed to the person who first used, or was alone in the habit of using, that particular name or mark. This ruling by Lord Langdale, M. R., dates back to 1842, in *Perry v. Truefitt*,<sup>1</sup> and has ever since been followed, in language variously modified. Lord Langdale, again in 1843, in *Croft v. Day*,<sup>2</sup> said that two things are required for the accomplishment of a wrong such as is here contemplated. First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and secondly, a sufficient distinctive individuality must be preserved, to procure for the person himself the benefit of the deception which the general resemblance is calculated to produce. To have a copy of the thing would not do; for though it might mislead persons in one respect, it would lead them back to the place where they were to get the genuine article, an imitation of which is improperly sought to be sold. For the accomplishment of such a fraud, it is necessary, in the first instance, to mislead the public; and in the next place, to secure a benefit to the party practising the deception, by preserving his own individuality. It is enough that the representations employed bear such a resemblance to the genuine as to be calculated to mislead the public generally who are purchasers of the article, and make it pass for the genuine.<sup>3</sup> The New York Court of Appeals said that the question was whether there is such a resemblance between the two as to deceive a purchaser using ordinary caution; and the court is not bound to interfere where ordinary attention will enable purchasers to discriminate between the marks used by different parties.<sup>4</sup> — But it is not necessary that the symbol, figure, or device used, or printed and sold for use, should be a fac-simile or precise copy of the original trade-mark, or so close an imitation that the two cannot be distinguished.

<sup>1</sup> 6 Beav. 66; 1 L. T. 384.

<sup>2</sup> 7 Beav. 84.

<sup>3</sup> *Walton v. Crowley*, 8 Blatch. 440; R. Cox, 166.

<sup>4</sup> *Popham v. Cole*, 66 N. Y. 69; 23 Am. R. 22.



except by an expert, or upon a critical examination by one familiar with the genuine trademark.<sup>1</sup>

§ 386. *Fraudulent Intention* is not an essential element of infringement, although it may be, and probably is in the majority of cases, an element in awarding damages and costs. The defence may positively deny wilful wrong, and there may not be evidence that a defendant was even aware of the existence of the claim of a complainant to an exclusive right of user; but nevertheless the latter is entitled to his remedy, and an injunction will be granted. This ruling of Lord Cottenham, C., in *Millington v. Fox*,<sup>2</sup> in 1838, has been uniformly followed by courts of equity; for the injury is neither greater nor less by the knowledge of the defendant.<sup>3</sup> Stuart, V. C., said in such a case: "This is an application in support of the right of property. The absence of fraudulent intention is no defence against an application to the court for an injunction by the person whose property has been injured."<sup>4</sup> And it is enough, if, without any unfair intention, a defendant has done that which is calculated to mislead the public.<sup>5</sup> The liability to account for the profits is an incident to the injunction; but Lord Westbury, C., in 1863, held that an account would only be given with the injunction in respect of any use by a defendant *after* he had become aware of the prior ownership.<sup>6</sup> Proof of the absence of fraudulent intention in trespassing on trade-mark rights may avail a defendant in saving costs;<sup>7</sup> or prevent a recovery

<sup>1</sup> *Colman v. Crump*, 70 N. Y. 578; 16 Alb. L. J. 852. *McLean v. Fleming*, 96 U. S. 245; 18 Off. Gaz. 913.

<sup>2</sup> 3 My. & Cr. 838.

<sup>3</sup> *Coffeen v. Brunton*, 4 McLean, 516; 5 Id. 256.

<sup>4</sup> *Clement v. Maddick*, 1 Giff. 98; 5 Jur. (n. s.) 592; 33 L. T. 117.

<sup>5</sup> *Glenny v. Smith*, 2 Drew. & S. 476; 11 Jur. (n. s.) 964; 13 L. T. (n. s.) 11; 13 W. R. 1032; 6 N. R. 368. *Filley v. Fassett*, 44 Mo. 173; 8 Am. L. Reg. (n. s.) 402. *Graham & Co. v. Kerr, Dodson, & Co.*, 3 Beng. L. R. App. 4. *Holmes, Booth, & Haydens v. The Holmes, Booth, & Atwood Manufacturing Co.*, 37 Conn. 278; 9 Am. R. 324. *Blackwell v. Wright*, 78 N. C. 310. *The Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 876. *Amoskeag Manufacturing Co. v. Garner*, 4 Am. L. T. (n. s.) 176. *Colman v. Crump*, *supra*. *McLean v. Fleming*, *supra*. *Carroll v. Ertheiler*, 1 Fed. R. 688.

<sup>6</sup> *Cartier v. Carlile*, 31 Beav. 292; 8 Jur. (n. s.) 183.

<sup>7</sup> *Barnett v. Leuchars*, 13 L. T. (n. s.) 495; 14 W. R. 166.

of damages, where his acts have been perfectly *bona fide*.<sup>1</sup> A court may infer a bad intention from a comparison of the two marks, and may say, with Monell, J., that it was not by accident that the coincidence of two designs was effected;<sup>2</sup> but in absence of the proof of the intention to deceive, or that purchasers have actually been misled by a resemblance, if the two trade-marks are not to the eye of the court either altogether identical, or so similar that the court considers the difference unsubstantial, an injunction will be refused.<sup>3</sup> So a trade-mark consisting of the words "Flor Fina Prairie Superior Tabac" and the figure of a hunter was held not to be *prima facie* infringed by another mark consisting of the words "Flor de la Prairie" and the half-figure of a girl.<sup>4</sup>

§ 387. *Small Words, as Instruments of Fraud.* — In the Court of Cassation, in 1864, the arbitrary designation was the name "L'Elixir du Docteur Gallié."<sup>5</sup> It was not disputed that the manufacture and sale of the article had fallen into the public domain; but the peculiar designation remained private property. The defendant had preceded the name of "Docteur Gallié" with the words "suivant la formule de," and added his own name. The almost imperceptible notice of following the formula of him who had given celebrity to the article did not avail as a defence. *Per Curiam*: Although every pharmacist has a right to prepare a medicine that has fallen into the public domain, and to announce and sell it under the denomination that serves by usage to designate it, this right ceases when the use of the denomination constitutes a means of dishonest competition. The Court of Paris, in 1875, held it to be an infringement, although to the usurped label the defendant had added the word "system," and adjoined his proper name.<sup>6</sup> — In the Tribunal Correctionnel of the Seine, in 1874, the defendant had adopted a label of the same dimensions as in the genuine,

<sup>1</sup> Weed v. Peterson, 12 Abb. Pr. (N. S.) 178.

<sup>2</sup> Cook v. Starkweather, 13 Abb. Pr. (N. S.) 392.

<sup>3</sup> Coffeen v. Brunton, 5 McLean, 256; R. Cox, 132.

<sup>4</sup> Cope v. Evans, L. R. 18 Eq. 188; 30 L. T. (N. S.) 292; 22 W. R. 453.

<sup>5</sup> Cited by the late eminent authority, M. Pataille, 10 Annales, 209.

<sup>6</sup> Howe Machine Co. v. Maquaire *et al.*, 20 Id. 353.

printed in the same manner, in black on a white ground, and within the bordering had inserted in small type the words "Product approved by the Academy of Medicine."<sup>1</sup> It was held—possibly with undue severity—that the mention, itself illicit, far from constituting a distinctive difference, only aggravated the wrong, in the confusion that he sought to establish as to the origin of the article.—The Court of Montpellier, in 1875,<sup>2</sup> held it to be no defence that the defendant had sold an article bearing a simulated word-symbol as an "imitation"; and so, also, in the Tribunal Correctionnel of the Seine, in 1878,<sup>3</sup> it was similarly held in regard to the words "imitation" and "as"; and in the latter-named tribunal, in 1878,<sup>4</sup> the use of the words "imitation," "imitated," "called," "identical," or analogous expressions, were prohibited, although the labels differed essentially from those of the "Chartreuse," the use of which name was asserted to have been employed only by way of comparison.—In the same tribunal, and in the same year, an inscription on spurious sewing-machines was "System" in very small letters, and "HOWE" in prominent large ones. Conviction was the result.<sup>5</sup>—In the Tribunal Civil of the Seine, in 1879, it was held to be infringement to use the specious words "Ne pas confondre avec la grande Chartreuse," the intention to confound being too manifest;<sup>6</sup> and so, in the Court of Lyons, in that year, although there were adjoined to the name of the manufacturer the words "imitation," "imitated," or "made" by such a one;<sup>7</sup> and thus, also, in the Tribunal Civil of Marseilles, in the same year, and under similar circumstances;<sup>8</sup> and in the Court of Aix, in that year, it was held to be a fraudulent usurpation of a mark, although the name usurped was preceded by the words "called," "fashion

<sup>1</sup> *Gènevoix v. Pauliac*, 19 *Annales*, 209.

<sup>2</sup> *F. Prot & Co. v. Monganzi*, 20 *Id.* 365.

<sup>3</sup> *Grézier v. Lambert*, 23 *Id.* 145.

<sup>4</sup> *Grézier v. Cusenier et al.*, *Ibid.* 154. See "Chartreuse" cases, §§ 407 *et seq.*

<sup>5</sup> *Compagnie Howe v. Grimm*, 28 *Annales*, 160.

<sup>6</sup> *Grézier v. Poullain*, 24 *Id.* 327.

<sup>7</sup> *Grézier v. Gallifet*, *Ibid.* 330.

<sup>8</sup> *Grézier v. Rocca et al.*, *Ibid.* 339.

of," "system of," etc.<sup>1</sup> In the Tribunal Correctionnel of Nantes, in 1880,<sup>2</sup> the very minute lettering "Made as at" was decided to be evidence of fraud; and in the Tribunal of Commerce of Nantes, in 1880, the words "System of" were regarded in the same light.<sup>3</sup> — In the Court of Cassation, in 1881,<sup>4</sup> the defendant was not permitted to escape the just consequences of imitating the plaintiff's trade-mark, by the transparent use of words purporting that his manufacture accorded with the receipt of the inventor of the genuine product, thus: "Vinegar composed according to the receipt of Claude Bully, prepared by Leroux"; and in 1882, in the Tribunal Correctionnel of Rouen,<sup>5</sup> where, after all the foregoing examples in his own country, besides others that might be cited, the defendant used the shallow device of inserting the words "system of," and "fashion of," he was condemned, as were his predecessors in roguery. These decisions do not at the first glance seem to be harmonious with a case in the Court of Paris, in 1851,<sup>6</sup> where it was held not to be usurpation of a name of an inventor, (his invention having become public property by reason of the expiration of the patent,) where one joined his proper name, preceded by the words "Prepared by." Probably that was a case of fact in which fraud was not established; for certainly the current of decisions ever since has tended to the other direction. The French have not been without imitators in this style of trespassing. In the High Court of Hamburg, in 1878,<sup>7</sup> the usurped name of the plaintiff company was followed by the word "imitated"; and in letters so minute as not to be seen unless attention were especially directed to them.

§ 388. We have considered the meaning of the term "colorable variation,"<sup>8</sup> and had many illustrations thereof; and

<sup>1</sup> *Fumouze et al. v. Grosse et al.*, 26 *Annales*, 179.

<sup>2</sup> *Pellier et al. v. Trottier frères et al.*, 27 *Id.* 357.

<sup>3</sup> *Veuve Raymoudière v. Plesier et al.*, 28 *Id.* 37.

<sup>4</sup> *Landon v. Leroux*, *Ibid.* 183.

<sup>5</sup> *Hammelle et al. v. Doudiet*, *Ibid.* 30.

<sup>6</sup> *Landon v. Lamare*, *Blanc sur Contrefaçon*, 732.

<sup>7</sup> *Singer Manufacturing Co. v. Mestwerdt & Engel*, 24 *Annales*, 116. This case arose under Art. 14 of the German law of Nov. 30, 1874.

<sup>8</sup> *Ante*, § 33.

also discussed the principle on which infringement is prohibited.<sup>1</sup> Now, although a court will hold any imitation to be colorable which requires a careful inspection to distinguish its marks and appearance from the genuine, it will not interfere when ordinary attention might enable a purchaser to discriminate between the true and the false. It may be well to give instances more in detail. In *Clark v. Clark*,<sup>2</sup> in the Supreme Court of New York, in 1857, the facts were these. The plaintiffs were manufacturers, at Mile-End, Glasgow, of spool cotton. In 1843, they used their trade-mark, consisting of four concentric circles: the inner one in gold, and the next in silver; the whole bounded by two concentric black lines. In the inner circle is the number of the cotton; in the next, "J. Clark, Jr., & Co., Mile-End, Glasgow." In the next circle are the words, "Six Cord Cable Thread, warr'd 200 yards." In the outer circle are the words, "Sole Agent, Wm. Whitewright, New York." J. & J. Clark & Co. were also manufacturers of the same class of goods at Seed Hill, Paisley, and the defendant was their agent. They both sold largely in the United States. The defendant, some years after the plaintiff's trade-mark was well known, adopted one for his cotton to be sold in the United States, consisting of concentric spaces of precisely the same dimensions as those of the plaintiffs, of the same colors, in the same order, with the letters in black or in gold, as the plaintiffs'. There is the same number for the inner circle, with the same kind of stamp. In the next circle are the words, "Clark & Co., Seed Hill, Paisley," "Clark & Co." being at the top, as in the plaintiffs', and the same words, so far as they go, as in the plaintiffs', and the other words below and in the reverse order, as are also the plaintiffs'; though these last words are entirely different from those of the plaintiffs. Then, in the next circle, "Six Cord Cabled Thread, warr'd 200 yards," precisely as in the plaintiffs', in black ground and gold letters; and in the outer circle the words, "Sole Agent, George Clark, New York," the words, "Sole Agent, New York," being the same as in the plaintiffs', even as

<sup>1</sup> *Ante*, § 34.

<sup>2</sup> 25 Barb. 76; R. Cox, 206.

to their position; the place of their beginning and ending, and the stamp for the letters, being also exactly alike in both.

§ 389. There was thus an evident design to imitate the plaintiffs' mark, and it was successfully carried out by actually transferring the face of the plaintiffs' die to the defendants', in all respects, except that the plaintiffs have on theirs "Wm. Whitewright, Mile-End, Glasgow," "J. Clark, Jr., & Co.," where the defendant has "George Clark, Seed Hill, Paisley," "Clark & Co." The effect of this imitation was, that all, except very cautious persons, would be deceived. Some, who may have known that Wm. Whitewright was the agent of the plaintiffs, would naturally suppose that George Clark had been substituted; so that the difference in the names of the agents would not prevent deception. The name "Clark & Co." is so near to "J. Clark, Jr., & Co." that it would pass for the same; especially when placed in the same position, in the same kind of letters, and on the same ground. The difference in residence, being stamped so as to read in the reverse of the rest of that circle, might pass unnoticed.

§ 390. The court, in modifying an injunction previously granted, said of the defendants: "Their firm name is J. & J. Clark & Co. They manufacture six-cord cabled thread: they have George Clark as their agent in New York. All this they may express, as well as the number of their thread; but they should express it so as not to appear to imitate the plaintiffs'. This could be done by inserting their firm name, instead of only a part of it, by changing the order of the colors in the concentric circles, and the style of the lettering and figures, and the position of the letters. There will be still a similarity between the labels of the two that may mislead some. But this results from two persons of nearly the same name being engaged in the same business, and the undoubted right of each to use his own name, and to describe the article which he sells by its well-known name; but does not result from an imitation of the mark of the other."

§ 391. The foregoing suggestion of Mr. Justice Mitchell, in delivering the opinion of the court, must be taken *cum grano salis*. The court was not called upon to devise a label,

or a mark for the defendants. We must separate the judgment from the mere *obiter dictum*, or we may be sadly misled as to wherein consists the plaintiffs' trade-mark. The four concentric circles, the inner one in gold, and the next in silver, the whole bounded by two concentric black lines, constitute the essential elements of the technical trade-mark. That being the case, the defendants would not have any right to use them for the same class of merchandise, even by changing the order of the colors, and the style of the lettering.

§ 392. In the case of *McLean v. Fleming*,<sup>1</sup> the facts were as follows. As early as 1834, Dr. Charles McLane made and sold liver pills, putting them up in wooden boxes, labelled "Dr. McLane's Liver Pills." In 1844, Jonathan Kidd, having purchased the exclusive right from him, began, at Pittsburg, Pennsylvania, to make and sell them. In 1845, Kidd formed a partnership with John Fleming, under the name of Jonathan Kidd & Co. Kidd died in 1853, and Fleming, the surviving partner, and one Cochrane Fleming, having purchased from Kidd's executors all his interest in the business, entered into partnership, under the name of Fleming Brothers. The firm continued until 1865, when Cochrane retired. John continued in the business under the firm name until his death, in 1870, whereupon Cochrane succeeded under his will to all his rights in the business. From the year 1847 the pills were put up in boxes sealed on the top with a red seal, bearing the words "McLane's Liver Pills," and enclosed in a wrapper containing, among other things, the words "Dr. C. McLane's Celebrated Liver Pills." Other changes, not material here to be considered, were subsequently made. In 1851, James H. McLean began, at St. Louis, Missouri, to make and sell pills under the name of "Dr. McLean's" or "Dr. J. H. McLean's Universal Pills," and placed them in boxes sealed similarly to the plaintiff's, and in wrappers of color and appearance similar to his. In 1872, McLean changed his wrappers, on complaint of Fleming, and adopted new ones, which did not infringe on the label

<sup>1</sup> 96 U. S. 245; 13 Off. Gaz. 913.

of the latter. The court below decreed an injunction against the use by McLean of his name, etc., as above given, upon labels or wrappers similar to those of Fleming, and also decreed an account and costs. The Supreme Court of the United States affirmed the decree, as to injunction, but reversed it as to costs and damages, because of long continued acquiescence. There is but little instruction in this case on the point of infringement. McLean, of course, had a right to use his name as he did, if he had not imitated Fleming's labels and wrappers.

§ 393. "*In Equity*, the right to give relief to the trader whose trade had been injured by the piracy appears to have been originally assumed by reason of the inadequacy of the remedy at law, and the necessity of protecting property of this description by injunction. But although the jurisdiction is now well settled, there is still current in several recent cases language which seems to give an inaccurate statement of the true ground upon which it rests." Such is the language of the Lord Chancellor of England in 1865.<sup>1</sup> He then takes up *Croft v. Day*,<sup>2</sup> and *Perry v. Truefitt*,<sup>3</sup> where the late Lord Langdale is reported to have used words, which place the jurisdiction of courts of equity to grant relief, in cases of piracy of a trade-mark, entirely upon the ground of the fraud that is committed when one man sells his own goods as the goods of another. He also quotes the language attributed to Vice-Chancellor Wood:<sup>4</sup> "All these cases of trade-mark, therefore, turn not upon a question of property, but upon this, whether the act of the defendant is such as to hold out his goods as the goods of the plaintiff." This statement the Lord Chancellor pronounces to be inaccurate. For, "First, the goods of one man may be sold as the goods of another without giving to that other person a right to complain, unless he sustains, or is likely to sustain, from the wrongful act some pecuniary loss or damage. Thus in the case of *Clark v. Freeman*, 11 Beav. 112; 17 Law J. Rep. (N. S.) Ch. 142, the eminent physician, Sir James Clark, applied for an

<sup>1</sup> 11 Jur. (N. S.) 513.

<sup>2</sup> 7 Beav. 84.

<sup>3</sup> 6 Id. 58.

<sup>4</sup> 1 Hem. & M. 287; 32 L. J. R. (N. S.) Ch. 721.



injunction to restrain a chemist from publishing and selling a quack medicine under the name of ‘ Sir James Clark’s Consumption Pills ’; but the court refused to interfere, because it did not appear that Sir James Clark had sustained any pecuniary injury. Secondly, it is not requisite for the exercise of the jurisdiction that there should be fraud or imposition practised by the defendant at all. The court will grant relief, although the defendant has no intention of selling his own goods as the goods of the plaintiff, or of practising any fraud either on the plaintiff or the public. If the defendant adopt a mark, in ignorance of the plaintiff’s exclusive right to it, and without knowing that the symbols or words so adopted and used are current as a trade-mark in the market, his act, though innocently done, will be a sufficient ground for the interference of the court, as is plain from the decision of Lord Cottenham in the case of *Millington v. Fox*, to which I entirely assent, and from the learned Vice-Chancellor’s own opinion in the case of *Welch v. Knott*, 4 Kay & J. 747, 751. Imposition upon the public, occasioned by one man selling his goods as the goods of another, cannot be the ground of private action or suit. . . . The true principle, therefore, seems to be that the jurisdiction of the court in the protection given to trade-marks rests upon property; and that the court interferes by injunction because that is the only mode by which such property can be effectually protected. The same things are necessary to constitute a title to relief in equity in the case of the infringement of the right to a trade-mark, as in the case of the violation of any other right of property. First, the plaintiff must prove that he has an exclusive right to use some particular mark or symbol in connection with some manufacture or vendible commodity; and, secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff’s custom, and injure him in his trade or business.”

§ 394. Lord Cranworth, in the same case, fully concurred in the principle just enunciated; and intimated that to hold otherwise would be to make the Court of Chancery auxiliary to the protection of fraud; for the principle is founded on

honesty and good sense, and rests on authority. Lord Kingsdown, in the same case, also placed the right of a plaintiff in a suit for infringement upon the ground of property in the mark; and said that the fundamental rule is, that one man has no right to put off his goods for sale as the goods of a rival trader, by using his name, mark, or other *indicia* of origin or manufacture.

§ 395. The Supreme Court of Connecticut, in *Boardman v. The Meriden Britannia Co.*,<sup>1</sup> in 1868, said that the object or purpose of the law in protecting trade-marks is twofold; first, to secure to him who has been instrumental in bringing into market a superior article of merchandise, the fruit of his industry and skill; secondly, to protect the community from imposition, and furnish some guaranty that an article purchased as the manufacture of one who has appropriated to his own use a certain name, symbol, or device as a trade-mark, is genuine. Consequently, the violation of property in trade-marks works a twofold injury; the appropriator suffers, in failing to receive that remuneration for his labors to which he is justly entitled, and the public in being deceived, and induced to purchase articles manufactured by one man, under the belief that they are the production of another. Robertson, J., in *Corwin v. Daly*,<sup>2</sup> said that the origin of the favor shown to trade-marks was the protection of the public, and not merely of the individual dealer. The first case reported containing this doctrine, on which all the others seem to depend, is found in a note of Doderidge, J., to the case of *Southern v. How*,<sup>3</sup> and referred to by Lord Hardwicke, in *Blanchard v. Hill*,<sup>4</sup> and then the action was brought by a purchaser. In *Blanchard v. Hill*, Lord Hardwicke makes the right of action grow out of the fraudulent design both of putting off an inferior article and drawing away customers. He possibly may have meant that either was sufficient, and that both were not necessary. The doctrine was recognized as law by Lord Mansfield, in *Singleton v. Bolton*,<sup>5</sup> and enforced in

<sup>1</sup> 35 Conn. 402.

<sup>3</sup> Popham, 148, and Cro. Jac. 471.

<sup>6</sup> 3 Doug. 303.

<sup>2</sup> 7 Bos. 222.

<sup>4</sup> 2 Atk. 484.

*Sykes v. Sykes*,<sup>1</sup> and thoroughly sifted and defined in the elaborate and important case of *Crawshay v. Thompson*.<sup>2</sup> In this last case, a bold attempt was made to make the defendant liable for the use of trade-marks without reference to his intention, but it was thoroughly canvassed and rejected by the entire bench; so that, at common law, an action will not lie without proof of an intent to deceive. Courts of equity operate by their remedial powers to prevent the continuance of a wrong, and reach the past action of the offender by converting him into a trustee for the injured party; so that now, even though the article sold with the simulated mark be equally good with the genuine, the owner of the latter is entitled to preventive relief, although the public may not have been the sufferer. It seems impossible now to discover the first assumption of this jurisdiction, or its reasons.<sup>3</sup>

§ 396. In the case of *The Dixon Crucible Co. v. Guggenheim*,<sup>4</sup> the facts were as follows. The stove polish of the plaintiff was put up in small cubical blocks, and covered by a blue printed wrapper, with advertising matter, and directions for use on the four sides, with a yellow label at the ends. The defendant's article was put up in cubes of about the same size as the plaintiff's, with a blue wrapper and yellow ends. There were slight differences when the two cubes were placed side by side, but the general appearance was similar, so that persons not thoroughly familiar with both might easily mistake one for the other. The plaintiff's label read, "Stove Polish. Dixon's Prepared Carburet of Iron"; and the defendant's, "J. C. Dixon's Stove Polish, — Carburet of Iron." The testimony of witnesses was very conflicting as to the liability to mislead. The court decided on judicial inspection. The defendant's article was put up closely to resemble the plaintiff's article in shape, wrappers, and labels. The name "Joseph Dixon & Co." appears on the plaintiff's label; and "J. C. Dixon" on that of the defendant, who gave no explanation of the use of that name. If he did not mean to deceive, why

<sup>1</sup> 3 Barn. & C. 541.

<sup>2</sup> 4 Man. & Gr. 357.

<sup>3</sup> *Corwin v. Daly*, *supra*.

<sup>4</sup> 7 Phila. 408; 2 Brewst. 321; 3 Am. L. T. 288; R. Cox, 559.

did he use it, and at the same time so closely imitate the wrappers and stamp of the plaintiff? So reasoned Judge Paxson, in granting an injunction against the imitation of the so-called trade-mark.<sup>1</sup>

§ 397. In *Lockwood v. Bostwick*,<sup>2</sup> the court said, *inter alia*: An inspection of the two labels shows that the one used by the defendants, and the use of which the plaintiffs seek to restrain by injunction, is, in respect to form, color, words, and symbols, so like the former as to make it manifest that the design of the defendants in using it was to deceive, the resemblance being such as would be likely to impose upon ordinary purchasers. It was alike in the form and size of the label; in the color of the paper, — a peculiar, delicate, gray tint; the machine or apparatus represented was one that had no existence in fact, but resembling the real machine sufficiently for the difference to escape observation unless upon attentive examination; and the word "Bovina" was substituted for "Bovilene," printed in the same type, and in exactly the same place as the other, at the head of the label. The design evidently was to depart from the other sufficiently to constitute a difference when the two were compared, and yet to do it so skilfully that the difference would not be detected by an ordinary purchaser unless his attention were particularly called to it, and he had a very perfect recollection of the other label. The design was to deceive, and to obtain, in the manufacture and sale of the article, any benefit or advantage that might be gained by its being purchased for another article of the same description, which was known and distinguished by

<sup>1</sup> Attention is invited to the fact that the learned judge did not pass upon this as a pure common-law trade-mark. He used the term in a broad non-technical sense, referring to the Pennsylvania statute of March 31, 1860, for the punishment of forging or counterfeiting "any representation, likeness, similitude, copy, or imitation of the private stamps, wrappers, or labels usually affixed by any mechanic or manufacturer, or used by such mechanic or manufacturer, on or in the sale of any goods, wares, or merchandise, with intent," &c. Paxson, J., said in his opinion, "This act is very broad in its terms, and comprehends everything which could possibly be included under the term trade-mark." Yet, for our present purpose, it serves as an illustration of the principles applicable to trade-marks proper and quasi trade-marks.

<sup>2</sup> 2 Daly, 521; B. Cox, 555.

a particular trade-mark. There could be no other motive; and it was done with the shallow expectation that the law would not see through the motive, but pronounce that the two labels were not the same, by simply distinguishing the points of difference between them. So far as the object sought could be attained, it would operate to the plaintiffs' detriment by diminishing the sale of their articles in the market, and they are entitled to be protected by a court of equity from this attempt on the part of rivals to deprive them of the fruits of their industry or enterprise in making their own fabric known and recognizable by its distinctive trade-mark. In *Burnett v. Phalon*,<sup>1</sup> it was found as a fact, that the defendants well knew that the plaintiffs used the word "Cocoaine" as their trade-mark; yet the defendants took the word "Cocoïne" as their mark, to designate the same kind of merchandise, to wit, a preparation of cocoa-nut oil. The court, by Bosworth, C. J., said, in substance, that the defendants had been frequently experimenting with cocoa-nut oil, and selling it since 1840 (and the trial was in 1859), and vending it as a preparation of hair-oil. It was a simple matter to get up a label, and impress on it, and on the bottles containing their compound, the word "Cocoïne," omitting one letter only of the plaintiffs' word. But no plausible or rational explanation, except an intent to defraud, could be given of a transaction so bold as to take the word "Cocoaine." It was, undoubtedly, deemed wiser to instruct the chemist to compose a name somewhat indicative of the substantial ingredients of the compound, without informing him of the fact that Burnett was manufacturing and selling largely a similar article, which was known as "Cocoaine." In this case similarity between the labels of the parties could hardly be said to exist; and yet the piracy was manifest. A very similar case was decided in the Court of Paris, in 1862, — *Guislain & Co. v. Labrugnière*.<sup>2</sup> The plaintiffs made and sold a hair-dye, to which they had given the name "Eau de la Floride" (Florida Water). The defendant, for a product of the same nature made or sold by him, took the name of "Eau de la Fluoride" (the

<sup>1</sup> 9 Bos. 192; 5 Abb. Pr. (N. S.) 212; 3 Keyes, 504.

<sup>2</sup> 9 Annales, 40.

last word signifying a compound of fluorine with a metallic or combustible base). By this ingenious interpolation of a single letter, the defendant thought to escape the legitimate consequences of his roguery, while he deceived the public for his own profit. Having been defeated in the court below, he appealed. The appellant's counsel argued that there was really no conflict between the two trade-marks; for the plaintiffs represented their product as a natural water imported from Florida, whence its name; while the appellant offered his article only as a chemical composition, — a combination of fluorine with nitrate of lead or of silver, whence its name of *Fluoride*; and that this term of chemistry designates the combination of fluorine with bodies less electro-magnetic. Moreover, the appellant claimed to have always maintained a dissimilarity of flasks, labels, bills, advertisements, notices, etc. This pretence did not avail. The appellate court not only sustained the judgment, but, finding itself possessed of the elements necessary for making a new and more just appreciation, increased the damages given by the court below.

§ 398. In the Tribunal of Commerce of the Seine, in 1866 (*Bardou et al. v. Sabatou et al.*<sup>1</sup>), came up this interesting case. Bardou senior was the first manufacturer of cigarette-paper in France, in or about the year 1841. This paper was sold in little packets covered with glazed paper, having a brown ground, on which were printed in gold the letters J. B. separated by a lozenge. In consequence of an error on the part of the public, this lozenge was taken for the letter O, for which reason the paper became known only under the name of "JOB Paper." The maker, J. Bardou *père*, accepted this designation, and adopted the name "JOB" in the registration of his trade-mark. Many decisions of courts had confirmed his title to this word as his commercial emblem or mark. A lithographer of Toulouse made and sold similar packets of paper, having the same color, but bearing different ornaments, and over which he had inscribed in large characters this notice: "Guerre à Job Papier très supérieur.

<sup>1</sup> 14 Annales, 140.

Paris, 80, Rue de Rivoli, 80. Take notice. — Let no person be surprised. I am not the same mark of the cover which bears the title Job. But I guarantee that I enclose a paper superior to Job by the addition of hygienic substances." The sale of this paper was announced in Paris as well as in Toulouse, the prospectus affixed reading thus: "I possess the sole general use of the cigarette-paper Guerre à Job, incontestably the best paper that exists, the superiority of which is recognized not only by all consumers, but also by the Messrs. Bardou & Pauilhac, proprietors of the Job paper. The last observe silence to the defiance given to them to dare say that the paper Guerre à Job is not superior to theirs," etc. The defendants voluntarily withdrew from their notice the names of the plaintiffs. The design of the defendants in using the name of the article and the names of the true owners of the mark was too manifest. The court therefore enjoined them from using the name Job, saying, among other things: — "As to the suppression of the name Job: Whereas, Sabatou, a fabricant of cigarette-paper, sells his products under the same form as those of the plaintiffs, and employs a paper wrapper of the same color, bearing the inscription 'Guerre à Job'" (etc., as above stated); "whereas, the lawful competition which should exist between merchants cannot be extended to include a right to take the distinctive denomination of a rival even for advertisements and circulars, with the design of diverting his custom; whereas, it is manifest that Sabatou, in the use of the name Job, and in indicating the superiority of his paper, had no other object than to destroy the reputation enjoyed by the paper sold under the title Job, and to cause confusion by holding forth the said name; therefore, it is ordered that Sabatou cease for the future to use the name Job on his covers and prospectuses. As to damages: Inasmuch as, by the conduct of Sabatou, the plaintiffs have shown that they are entitled to reparation for injury received, and this tribunal possesses the elements for the appreciation of the same, let Sabatou be held to pay them the sum of five thousand francs, with costs." On appeal to the Court of Paris, which heard the matter in 1869, the

judgment was affirmed, although the damages were reduced to three thousand francs.<sup>1</sup>

§ 399. The foregoing case has a peculiarity worthy of the observations which the reporting editor makes upon it. He says that it should be remarked that, for the purpose of duly estimating the wrongful act, the tribunal took into consideration the fact that the defendant Sabatou had disparaged the products of the plaintiffs, wherefore it peremptorily ordered the suppression of the use of their names and the denomination *Job* by him. This he deems to be just, as it cannot be admitted that the liberty of industry and commerce authorizes such use of the name of a fabricant, or the denomination of a product, for the purpose of avowing superiority, and attracting the attention of the public. It is a usurpation, says he, from the instant one uses an acquired reputation to make known, and cause the acceptance of, his own products.

§ 400. The Court of Cassation, in 1867, — in *Lagarde v. Piper*,<sup>2</sup> — held: It is a fraudulent imitation of a mark, falling within the provisions of Art. 8 of the law of June 23, 1857, to servilely copy the label of another merchant, although a name or pseudonym be interpolated other than that of the true owner. The offence is committed in France, and not in a foreign country, even although the label bearing the mark, which has been in part fraudulently imitated, is not intended for use in France, but is intended to be sold in foreign countries, for the purpose of there being affixed by others.<sup>3</sup> The piracy consisted in the imitation in part, with the design of profiting by the reputation belonging to another.

§ 401. In *Gillott v. Esterbrook*,<sup>4</sup> the defendants took only a portion of the plaintiff's mark, viz. the numerals 303 (which by themselves probably could not be a lawful trade-mark),<sup>5</sup> and yet were found guilty of infringement. The defendants manufactured a pen in shape, color, size, and pattern so closely resembling the pen of the plaintiff that it required

<sup>1</sup> 15 *Annales*, 115.

<sup>2</sup> 18 *Id.* 293.

<sup>3</sup> See *Glen Cove Manuf. Co. v. Ludeling*, *ante*, § 360.

<sup>4</sup> 47 *Barb.* 455; 48 *N. Y.* 374; 8 *Am. R.* 553.

<sup>5</sup> See *ante*, §§ 225-233; also *Glen & Hall Manuf. Co. v. Hall*, 5 *Alb. L. J.* 109; 6 *N. Y. Sup. Ct.* (6 *Lans.*) 158; *Com. of App.*, 61 *N. Y.* 226; 19 *Am. R.* 278.



an expert to distinguish them. That much they had a perfect right to do; and if they had gone no farther toward imitation, no legal injury would have resulted. But they imitated the boxes used by the plaintiff, with a fancy-paper label similar to his, placed in the same position; took the number "303" by which the plaintiff designated his pen; and on the bottom of the box placed a "caution" somewhat similar. Potter, J., said, *inter alia*: "These labels and cautions (except the names of the parties) are composed of words in common use in our language, which cannot be exclusively appropriated as trade-marks. True, this selection of boxes, sizes, colors, labels, cautions, and style of lettering, may all be designed to aid in the perpetration of a fraud, and may be the most conclusive evidence of the intent to mislead the public, and to commit a fraud upon the plaintiff in relation to some device of his connected with a trade-mark; yet merely because they are such evidence, or because they have been used with such intent, it does not follow that their use can be legally enjoined and restrained. It is where the person designing to practise a fraud by pirating a trade-mark uses these evidences so connected with the trade-mark itself as to effect a fraud, that he can be reached by the powers of the court. True also it is, that it is the right of the plaintiff to be protected against frauds, yet the fraud must be one in relation to a substantial legal right of the party, and protection will not, in all cases, be extended to the mere evidence of fraud alone; and the courts are bound to be especially cautious that in the exercise of the power to restrain injustice they do not encroach upon the public interest, by giving an improper check to a worthy and laudable spirit of enterprise, emulation, and competition in any department of business. It must be admitted that every citizen has the right, if he will, to manufacture and to sell steel pens of any pattern, shape, color, size, state of flexibility, or fineness of point; he may sell them singly or in quantities, on cards or in boxes of large or small size, and with such ornamentation as fancy or interest may dictate; he may imitate any pattern or quality of pen, even if known to be made by any other manufacturer;

he may, if he can, make a superior article in material, pattern, or quality, and, if he can do so, he has the right to select a device or symbol, as a trade-mark, to designate his manufacture from others; and, if such device or symbol relates to the origin or ownership of the goods to which it is affixed, his legal right to protection is undoubted. Such protection is no restraint upon the freest exercise of talent, enterprise, and competition in trade, but rather a proper stimulant to encourage competition. His superior skill and enterprise give him the right to its profits and advantages, and this is giving no encouragement to monopolies so destructive to the freedom of trade. It may be that in this case the defendant's pen is equal in merit, or even superior to the plaintiff's. This was not an issue in the case."

§ 402. In *Walton v. Crowley*,<sup>1</sup> Betts, J., said: On ordinary observation, the labels used by the two parties in this case would not be apt to be distinguished the one from the other, — the size, shape, vignette, coloring, and marking being so nearly identical as to make them easily pass for the same; and the only difference discernible, on considerable scrutiny, being in the name of the warrantor, stamped upon them in letters so small as not readily to attract notice. It is this apparent similitude or counterfeiting which is the grievance complained of. A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular. It is enough for him to show that the representations employed bear such a resemblance to his as to be calculated to mislead the public generally who are purchasers of the article, and to make it pass with them for the one sold by him. If the *indicia* or signs used tend to that result, the party aggrieved will be allowed an injunction staying the aggression until the merits of the case can be ascertained and determined.

§ 403. In one case,<sup>2</sup> the plaintiffs, rectifiers of whiskey, had as a brand for their goods the representation of two anchors placed near together in an upright position, the upper parts

<sup>1</sup> 3 Blatch. 440; R. Cox, 166.

<sup>2</sup> *McCartney v. Garnhart*, 45 Missouri (4 Post's R.), 593.

inclining outward, with a rope attached. Over the device, in a circular form, were the initials "S. Mc." The device and letters were stencilled upon the heads of barrels containing a particular kind of whiskey known in the trade as "Double Anchor," or "Double-Anchor Whiskey." They brought suit to enjoin the defendant from using in his whiskey trade an alleged counterfeit in imitation of their trade-mark. The supposed imitation consisted in the representation of two picks placed near together in an upright position, with the handles inclining inward. Between the handles was suspended a pair of balances or scales. The defendant's name was placed over the picks, and the words "Old Bourbon" below; the whole inscription reading, "J. H. Garnhart's Old Bourbon." The defendant stencilled this brand upon the heads of the whiskey-barrels. He used the whiskey thus put up and branded for his mountain trade, and called it "Pick Brand."

§ 404. The picks were alleged to be an imitation of the anchors on the plaintiffs' barrels. That was the only point of resemblance insisted on. In all other particulars the court said that the marks were wholly dissimilar. Currier, J., in delivering the opinion of the Supreme Court of Missouri, said that "the defendant's 'picks' resembled the plaintiffs' 'anchors' substantially, as a real pick resembles a real anchor of reduced dimensions. One who would mistake a miner's pick for a diminutive anchor might confound the defendant's brand with that of the plaintiffs', and hardly otherwise. The pick in the defendant's brand is quite as good an imitation of the article intended to be represented, as is the anchor in the brand of the plaintiffs of the nautical instrument there sought to be represented. The resemblance between the two brands is too slight to be likely to mislead; and there is nothing in the testimony which shows that the defendant sought to dispose of his whiskey as that of the plaintiffs, or of the plaintiffs' rectification." We see here evolved the sole point: Was the pick made so nearly like the anchor-mark as to be likely to deceive the public? No. Therefore, the injunction was properly refused.

§ 405. Ever since the year 1848, a plaintiff, Baron Seixo,<sup>1</sup> had caused his casks to be stamped with his coronet on the top, and with his coronet and the word "Seixo" at the bung; and the evidence shows that his wine has thus acquired in the market the name of "Crown Seixo Wine." When, therefore, the defendants, in the year 1862, adopted as their device a coronet with the words "Seixo de Cima," meaning Upper Seixo, below it, the consequence was almost inevitable, that persons with only the ordinary knowledge of the uses of the wine trade from Oporto would suppose that, in purchasing a cask of wine, they were purchasing what was generally known in the market as "Crown Seixo" wine.

§ 406. A long and elaborate attempt was made to show that the defendants held a right to the use of the trade-mark which they had adopted. They held, either as owners or lessees, a vineyard adjoining that of the plaintiff, and several small vineyards on the opposite side of the river. "Seixo" means "pebbly" or "stony." *Vino de Seixo*, therefore, is only the same thing as *Vin de Grave* in French, or *Stein Wein* in German. "Even assuming the truth of what is contended for the defendants, i. e. that parts of their vineyards are known by the name of Seixo, that does not justify them in adopting a device or brand, the probable effect of which is to mislead the public when purchasing their wine to suppose that they are purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff. Cases may be imagined, though very unlikely to arise, in which a person bringing into the market for the first time the produce of a newly established manufacture, to come into competition with one already established, may really be embarrassed as to the mode in which he should describe it, so as not to interfere with the description adopted by a manufacturer who has been before him. If such a case should arise, it must be dealt with on its own merits." Appeal dismissed, with costs.

§ 407. A judgment of the Tribunal of Commerce having, so long ago as 1852, decided in principle that the father Gar-

<sup>1</sup> *Seixo v. Provezende*, 12 Jur. (n. s.) 215; L. R. 1 Ch. 192; 14 L. T. (n. s.) 314; 14 W. R. 357.

nier, in his own name, and in a representative capacity as Procureur of the Carthusian monks, was the sole possessor of the title to the *Liqueur de Chartreuse*, he frequently afterwards found himself involved in litigation in protecting his right. In the Tribunal Correctionnel of Grenoble, in 1857, came up one of the cases, *Garnier v. Berthe*.<sup>1</sup> The defendant had made liquors which he sold under the title *Liqueur de Grande Chartreuse*. His label — which he had duly deposited — was on the same colored paper as that of the prosecutor; of the same form, dimensions, disposition of characters and letters, with mottoes and phrases adopted by the monastery; and certain light clouds which disappeared at a little distance. This could not but cause confusion and error. Worse still, he had printed on his marks the very arms of the Chartreux, i. e. a globe surmounted by a cross. To escape the just consequences of his fraudulent imitation, the defendant set up: 1st. That his liquors were the same as those of the Chartreux, whose secret he had penetrated by the aid of magnetism (!), wherefore he called his liquors and elixirs *liqueurs et elixirs de la Chartreuse*; for, said he, to give them another name would be to deprive them of their special character. 2d. That he could not write his prospectuses in any way not conforming to those of the Chartreux, because his elixirs were similarly composed to theirs, and possessed the same virtues. 3d. That his marks, labels, etc. differed essentially from those of the monastery, because they did not bear *liqueur de la Chartreuse*, or *de la Grande Chartreuse*, but *liqueur fabriqué à Saint-Pierre-de-Chartreuse*, where he had established his place of business: and that he had on his labels his Exposition medal of 1855, his name, etc. The court was not beguiled with his oily blandishments, but ordered the confiscation of all his liquors and elixirs, and the destruction of his false labels and marks, with a fine of five hundred francs, six months' imprisonment, and the publication of his villany in eight public journals at Paris and other cities.

§ 408. In the Tribunal Correctionnel of the Seine, in 1868 (*Louis Garnier v. Paul Garnier*<sup>2</sup>), the same name as a sym-

<sup>1</sup> 4 Annales, 119.

<sup>2</sup> 14 Id. 252.

bol of trade was brought into controversy. On certain liquors, seized at the defendant's place at the demand of the plaintiff, was found this title, somewhat changed. The labels of the bottles bore marks of the same form, dimension, and color as those of the monastery of the Chartreux, but with a framing or border a little different, and the inscription, "Liquor Hygiénique de la Chartreuse," followed by the signature of P. Garnier. Held to be an infringement. The fraudulent design of the defendant was manifest from the circumstances. It did not matter that both parties bore the same surname, and that the signatures placed upon the bottles were distinguished by the initials of the baptismal names, and with entirely different flourishes.

§ 409. Upon reference to the case first referred to, — that in the Court of Grenoble, in 1852, *Garnier et al. Carthusians v. Rivoire*,<sup>1</sup> — we find that the question from the beginning was in this, Whether the name of *Chartreuse*, given by the Chartreux to the peculiar liquor manufactured by them, had not become a generic denomination that any one could lawfully employ to designate liquors of the same kind. The court decided that the plaintiffs had not the monopoly of the article of manufacture; wherefore the defendant had a right to make and vend a similar article, if he possessed the secret of manufacture, and in default of a name to give it one, even suggested by the resemblance, leaving the public to judge; but that the name *Chartreuse* must not be employed on labels, unless as a simple term of comparison, as, for example, *imitation de Chartreuse*, the whole in the same kind of characters; or if another denomination were used, the sense should not be equivocal, to draw to the defendant. His custom must depend upon his own merit, without diverting the trade of the plaintiffs, the Chartreux. The reputation of the delicate fluids seems to have kept the venerable brotherhood in constant litigation. One decision made in their favor affected all the manufacturers of similar articles in the department of Isère and the Rhone; and they combined to prove the name *Chartreuse* to be but generic. They signally failed, on appeal.

<sup>1</sup> 4 Annales, 155.

The court said that the term *Chartreuse*, which is but an abbreviation of the label of the Chartreux, is not a generic name, as would be a name derived from the nature of the liquor, or the substances of which it is composed; and the liquor would not have been so named, but that it had been invented at the monastery of the Grande Chartreuse, and made by the Carthusians; so that the name at once designated the *inventor*, the *maker*, and the *place of manufacture*, and constituted, in each of these particulars, a distinctive mark, *a specification which could not with verity be applied* by others to a similar or analogous product of Grenoble. The same doctrine was affirmed, in 1868, in *Garnier v. Lindière et al.*<sup>1</sup> M. Pataille, the counsel for the Chartreux, argued that the composition of the article made by them is a secret, and, even if chemistry could detect the presence of vegetable essences in a liquor, it is powerless to specify, in a complete manner, all the medicinal or aromatic plants entering into the composition, and still less to determine the proportions and the process of manufacture. As a consequence, if one had the right to make liquors more or less approaching in kind those of the Chartreux, no one could say that he made the identical liquor. He contended that therefore no one had the right to copy the idea embraced in the mark. The article not being the same, what right had any one to mislead by a label which implied that the liquors were identical? Then, the difference of price was injurious to the owners of the mark and makers of the genuine article; for the spurious was sold at one half or one third the price. The lowness of the price might not deceive merchants, who could not fail to know the cost of the genuine article; but, as to the public, that lowness is only the means of augmenting the sale of the false article. The depreciation of the reputation of the plaintiffs' article should be taken into consideration in adjusting damages.

§ 410. The case of *Louis Garnier v. Paul Garnier* came up in the Court of Paris, on appeal, in 1870,<sup>2</sup> and the judgment of the tribunal was affirmed. The court *held*, that property in a denomination or a mark is acquired by the first

<sup>1</sup> 14 *Annales*, 225.

<sup>2</sup> 17 *Id.* 241.

user thereof, independent of all deposit (equivalent to our registration), wherefore the special denomination of *Chartreuse* employed by the Carthusians to designate the *liqueurs* manufactured by them at their monastery is, as a trade-mark, their exclusive property. Consequently, they have a right to demand that other manufacturers or dealers be forbidden to use the word "Chartreux," or "Chartreuse," upon the class of merchandise that they, the plaintiffs, manufacture. Not to let the matter drop without exhausting all means of defence, the defendant carried his case to the court of last resort. In April, 1872, it was decided in the Court of Cassation,<sup>1</sup> where the claim of the Carthusian monks to the right of exclusive use of the word so much harped on was fully sustained. Therefore, we may regard the single word "Chartreuse" as possessing all the essential characteristics of a trade-mark;<sup>2</sup> and we may rest assured that any one is an infringer who varies that word, as did the defendant, in the futile hope that he might evade the penalty of the law.<sup>3</sup>

§ 411. In *Edelsten v. Edelsten*,<sup>4</sup> Court of Appeals in Chancery, 1863, the facts of the case were that the plaintiff, a wire manufacturer, with a view of distinguishing his wire from that of other manufacturers, in the year 1852 adopted as a trade-mark an anchor on the metal labels, called "tallies," which were attached to each bundle of wire sent into the market by the plaintiff's firm. For this reason the plaintiff's wire acquired the name of the "Anchor-brand Wire," by which it has since generally been known to the trade. The plaintiff complained of the defendant's use of a crown and an anchor as being a colorable simulation of his trade-mark. Judgment with costs, and an account of profits. Affirmed on appeal, with costs.

§ 412. In *Woolam v. Ratcliff*,<sup>5</sup> the plaintiff and the defendant were both large silk throwsters. The plaintiff was in the

<sup>1</sup> 17 Annales, 257.

<sup>2</sup> *Ante*, § 143.

<sup>3</sup> So held, virtually, in the U. S. Cir. Ct., S. D. of N. Y., in 1876, in four cases not reported: *Grézier v. Sage*, *Grézier v. Lieutand*, *Grézier v. Chalvin*, and *Grézier v. Girard*.

<sup>4</sup> 1 De G., J. & S. 185; 9 Jur. (n. s.) 479; 7 L. T. (n. s.) 768; 11 W. R. 328; 1 N. R. 300.

<sup>5</sup> 1 Hemming & Miller, 259.



habit of making up his bundles of silk in a particular form, with forty-eight heads of silk in each bundle, tied with five strings in different places, with the silk protected from the knots of the strings by pieces of foolscap paper of a particular form, the heads of silk being themselves tied with silken strings of different colors to mark the quality of silk, and containing the particular mark, "St. A \* \* \* \* \*," which represented *St. Alban's*, the place where the plaintiff's manufactory was situated, and which was well known in the trade as the plaintiff's trade-mark.

§ 413. The defendant made up a quantity of silk in bundles, in exact imitation of the plaintiff's bundles, and affixed to them a label exactly like that of the plaintiff, except that the mark "St. A \* \* \* \* \*" was omitted. V. C. Wood said, *inter alia*: "This is a very singular case. I have had considerable experience in cases of trade-marks, sometimes of trade-marks *simpliciter*, and sometimes of trade-marks as one of numerous *indicia* that a particular thing is the manufacture of a particular person." He then referred to the Omnibus Company case,<sup>1</sup> where the words "Conveyance Company," "the green omnibus," etc., were held sufficient to entitle the plaintiffs to an injunction. The defendant, said he, might have had those words painted on a yellow omnibus without objection; and so of the other resemblances: the wrong lay in the accumulation, not in any one of them alone. In conclusion, he said that "in this case the plaintiff has a peculiar mode of making up his goods. This is not precisely a trade-mark. . . . I think it has been established that in the *English* market the 'St. A \* \* \* \* \*' would have been necessary and sufficient as *indicia* of the plaintiff's goods." Although there was an express direction to the defendant to imitate the plaintiff's bundles, — an element of suspicion in itself, — he could not treat it as conclusive. Bill dismissed, with costs.

§ 414. In the Court of Caen, in 1872 (*Carpentier v. Canivet*<sup>2</sup>), it appeared that the plaintiffs, the brothers Carpentier, manufacturers of chocolate in Paris, had been in the practice of enclosing their products in envelopes bearing the fac-simile

<sup>1</sup> *Knott v. Morgan*, 2 Keen, 213.

<sup>2</sup> 17 *Annales*, 233.

of a bill of exchange. The better to imitate a bill of exchange, the label, which has a double bordering of arabesques, represents engine-turned paper of a gray tint, with a band a little depressed in the middle, on which are printed the words "Cinq Kilos de Chocolat" (*five kilograms of chocolate*), and the engine-turned work is so done as to let appear the words "Fabrique de Chocolat," as if imprinted in the pulp of the paper. Besides the immediate use of the label by themselves, the plaintiffs had been in the habit of authorizing the use of it by their agents in the provinces of France, with the addition thereto of the name of the agent vending the article, — the device always being claimed as the trade-mark of the plaintiffs. The defendant, for the chocolate sold by him, used a label also bearing the fac-simile of a bill of exchange, but in many respects it was quite dissimilar in appearance. In the Tribunal Civil of Caen, where the case was first heard, the defendant successfully relied upon the variations, and the complaint was dismissed, with costs. In the superior court that judgment was reversed. Among other matters, we find this upon the point of part infringement:—*Per Curiam*. "If, as matter of law, the act of June 23, 1857, which prohibits the fraudulent imitation of trade-marks, could be applied only in a case where the imitation is absolute and complete between the genuine and the counterfeited mark, it would constantly be evaded, and be illusory; and, in effect, fraud — always so ingenious in the choice of means to which it has recourse — would not fail to introduce in the execution of its work such modifications of detail as, while insuring the benefit of the counterfeit, would guarantee impunity. It suffices to bring it within the intendment of the above-cited act, that the imitation reproduces the characteristic traits of the original, so that, at the first view of the purchaser, who has not under his eye the points of comparison, and who cannot recollect all the details, he should naturally be led into error. In fact, the labels of the tablets of chocolate exposed for sale, and seized in the *magasin* of Canivet, reproduce in the *ensemble* the trade-mark of Carpentier Brothers; for the labels of both parties bear the fac-simile of a bill

of exchange; and the form, the dimension, and the position of one and the other on the tablets, are identical; and to him who has not under his direct gaze the mark of the Carpentier Brothers, the deceit is inevitable." The judgment below was reversed, with costs, etc.

§ 415. In the Tribunal of Commerce of the Seine, in 1868 (*Panckoucke v. Wittersheim*<sup>1</sup>), came up the case of the famous "Moniteur," of Paris. The facts are as follows. In 1789, the predecessors of the plaintiffs founded a political and literary journal, under the title of "Gazette Nationale," or "Moniteur Universel." In the eighth year of the Republic, it became the administration organ, and so continued to be until 1815. In 1816, it resumed its official relation. In 1852, the price of the journal was reduced; and in consideration of the superior advantages to the public occasioned by the increased publicity, it received the exemption of stamp and postage duties. In 1864, the "Moniteur" made a contract with the Minister of State for four years, as the official organ. It was during this period of time that the same owners commenced the publication of an evening edition of their paper, under the title of the "Petit Moniteur," which became exceedingly profitable to its publishers. In 1866, the Minister of State, not being inclined longer to submit to the inconvenience occasioned by the duality of the journal, authorized the publication of a new official paper by the defendant, and which paper assumed the name of "Moniteur Officiel de l'Empire Français." This act of the defendant was deemed by the owners of the old-established journal to be a usurpation of title; so suit was brought. For a defence, it was urged that the plaintiffs carried the inception of their journal back no farther than 1789; while, in fact, from the year 1760, other periodical publications had appeared under the same name; and that therefore the plaintiffs could not invoke the law applicable to the first occupant. Further, that the publication had long gone under the principal title of "Gazette Nationale"; and that it was not until the year 1811 that it took for principal title the denomination of

<sup>1</sup> 15 Annales, 5.

“Moniteur Universel”; but this title was so taken with a knowledge of the fact that that name, as applied to journals, had become public property, wherefore care was taken to adjoin the distinctive qualification of *universel*; and that under the general name of “Moniteur” more than one hundred and fifty journals had been published. Thus, said the defence, there is the “Moniteur de l’Armée,” the “Moniteur de la Flotte,” the “Moniteur de l’Industrie,” etc. The defendant claimed that in law, as in fact, he had the greatest degree of interest in avoiding confusion between the two journals; and that he had established a difference between them in taking the title of “Moniteur Officiel.” It was held, *inter alia*, by the Tribunal, that the title of a journal is property. It incontestably appears that the “Moniteur Universel,” whether as a daily political and literary sheet, or as an historical collection, has always been known under the simple title of “Moniteur”; and as in ordinary language, so in parliamentary, and even in official phraseology, this single denomination serves almost invariably to designate this journal, even for the periods when it was not the organ of the government, and was not charged with the publication of official acts; and this fact, which appears by all the documents, is also attested by the “Bibliographie Historique et Pratique de la Presse Française,” p. 125, in an article devoted to said sheet, of which the editor, Charles Joseph Panckoucke, was the founder; and the plaintiffs, or those through whom they derived title, have not since 1789 discontinued to publish the journal under the denomination which was and is their property. If the word “Moniteur” is within the public domain as a generic expression, it nevertheless constitutes, for those persons who have adopted it to denominate their publication, a right of exclusive application. If the word has figured in the titles of certain journals which have ceased to appear, and figures still in those of a great number of others which have made themselves the organs of special professional or local interests, it has never been applied to any of the great local political journals of Paris other than the “Moniteur Universel.” If it were now to be employed in carrying on a literary and political

journal other than that of the plaintiffs, an inevitable confusion between the two papers would result, whatever else might be the qualification adjoined thereto. This confusion is superabundantly demonstrated by the usage adopted, not only by the public but by the agency also of the defendant, of naming as the "Moniteur" the journal that the defendant proposes to publish under the title of "Le Moniteur Officiel de l'Empire Français." After some further reasoning upon the subject, the Tribunal gave judgment as follows. For these reasons, forbid Wittersheim to take the title of managing printer of "Le Moniteur Officiel de l'Empire Français," or to make use for the publication and carrying on of the journal under his charge of the title of the "Moniteur," either singly or with the qualification "Officiel," unless he acquire the right. Order the insertion of this judgment in three newspapers, at the choice of the plaintiffs and expense of the defendant. Condemn the defendant to costs. The defendant appealed; but the Minister of State, Rouher, recognizing the soundness of the foregoing judgment of the Tribunal of Commerce of the Seine, and in the name of the Emperor, revoked the authority that had been given to the defendant, and changed the name of the official paper to "Journal Officiel de l'Empire Français."

§ 416. In the Tribunal Civil of the Seine, in 1869, came up a case similar in principle to the foregoing.<sup>1</sup> The plaintiff, manager of the journal "La Presse," founded in 1836, brought suit to suppress the title of "La Presse Libre," which the defendant had given to a new political paper. The defence contended that the word "press" is a generic name, which all persons might lawfully use; and that the qualification of "free" (*libre*) adjoined to the word "press" constituted a different title; and that therefore confusion between the two sheets was impossible, especially as the said journals followed two different political parties, and addressed themselves to different classes of readers. Yet judgment was rendered in favor of the plaintiff, with three hundred francs damages and costs.

<sup>1</sup> Halbronn v. Malespine, 15 Annales, 142.

§ 417. In the Tribunal of Commerce of Lyons, in 1871 (*Millaud v. Marian et al.*<sup>1</sup>), the facts were as follows. Millaud founded at Paris, several years before the time of trial, a daily sheet bearing the name of "Petit Journal," which acquired considerable popularity. By reason of the investment of Paris by the German armies, the plaintiff brought out at Lyons a special edition of his journal for circulation in the provinces, and bearing the same name as that which he had established at Paris. The great success of the sheet seems to have excited the rivalry of the defendants, who formed a partnership to found a journal by the same title as the plaintiff's, and with the intention of selling it at Lyons, or in the departments, as if it were the journal of the plaintiff. The Tribunal said that that intention was manifest, as the defendants had not only taken the title of the publication, but had also servilely imitated, by successive transformations, either the form of the veritable "Petit Journal" or its typographical peculiarities. They had made a pretence of differentiating, by inscribing the words "de la France Centrale" in place of "Lyonnais," borne by the plaintiff's publication under the title of "Petit Journal." These substituted words were not in so plain a form as to prevent confusion and mistake in the mind of purchasers; and besides that, notices announcing the publication of a new *feuilleton*, or of an important article, copied the typography and form of the genuine paper, and the dimension and color of the sheet used by the plaintiff in placarding his publication. To make sure that the public should be deceived, even the strip of paper, or band, which covered the defendants' journal, bore only the inscription of "Petit Journal." Defendants enjoined, 500 francs damages and costs. In the Tribunal of Commerce of Amiens, in 1871 (*Millaud v. Caron*<sup>2</sup>), the plaintiff in the last suit found himself engaged. In this instance, the defendant took the title of "Petit Journal" for his paper, but, as a subtitle in the second line, and printed in smaller characters, added the words "de la Somme." The judgment says that the title of a journal is the exclusive property of its founder,

<sup>1</sup> 17 *Annales*, 101.

<sup>2</sup> *Ibid.* 104.

and to give to a new journal the title already belonging to another sheet is a usurpation of property, and consequently an act of unlawful competition. Judgment for plaintiff, with 100 francs damages and costs, and an injunction forbidding the further use by defendant of the words "Petit Journal." Again, in 1871, before the Tribunal of Commerce of Douai (*Millaud v. Le Petit Journal du Nord*<sup>1</sup>), we find substantially the same question of part infringement. The addition of the sub-title "du Nord" did not avail the defendants. They were forbidden to use the name "Petit Journal" with or without a sub-title, under penalty of 50 francs damages for each number that should be issued after that day, with 300 francs damages and costs.

§ 418. *Blending of Trade-Mark and Other Rights.*—At times it is difficult properly to classify cases according to their essential natures; and not unfrequently courts regard with indifference nice technical distinctions, when severe strictness of definition might defeat justice. A chancellor will not always stop to inquire, Is this a case of infringement of a technical trade-mark? Or, is it not rather a case of *unfair competition*?<sup>2</sup> Unless the pleadings have embarrassed the matter beyond the possibility of correction, substantial justice will be done, as will appear by a perusal of the cases following. In *Ellis v. Zeilin & Co.*, in the Supreme Court of Georgia, in 1871,<sup>3</sup> the matter in dispute was the phraseology of a label. The plaintiffs below (defendants in error) in their bill allege that they are entitled to the sole and exclusive manufacture and sale of certain medicinal preparations, known as "Dr. Simmons' Liver Regulator or Medicine," having acquired the right thereto by purchase from the son of Dr. A. Q. Simmons, the inventor. They allege that they have expended large sums of money in extending the reputation thereof, and that they "have adopted certain trade-marks in which their packages are put up, which have been entered, under the copyright law, in the District Court of the United States at Savannah."<sup>4</sup> They further allege that Ellis, the

<sup>1</sup> 17 Annales, 104.

<sup>2</sup> See *ante*, § 43.

<sup>3</sup> 42 Ga. 91.

<sup>4</sup> This passage is worthy of attention and re-perusal, if only as a curiosity

plaintiff in error, has commenced to sell a preparation which he calls "Simmons' Genuine Liver Medicine," and is putting it up in similar form and size of packages, and that the general appearance and pirated indorsements thereon are intended to convey a wrong impression, and to take advantage of the reputation which Zeilin & Co.'s preparation has acquired, and which they allege to be a fraud on their rights; wherefore they ask for an injunction, and such other relief as they may be entitled to under the circumstances. To the bill, the defendant below (Ellis) demurred, but the court overruled his demurrer. Error was assigned, and the case carried up. The question which we are discussing is one of alleged infringement. For the sake of argument, we will concede that the combination of words used by Zeilin & Co. constitutes a lawful trade-mark. Was that mark infringed by the imitation in part by Ellis? From the report of the case, we find that he used a large symbol which the others did not use. That symbol was probably sufficient to be in itself a trade-mark; and it doubtless created such a difference between the two labels that one could not well be mistaken for the other. Lochrane, C. J., said, *inter alia*: "We do not think there was equity in this bill, on the mere question of similarity of trade-marks. But as the demurrer admits that what was done was done intentionally to take advantage of the reputation of the 'Simmons' Liver Medicine,' we cannot hold that the judge below erred in retaining the bill for a hearing, to let the whole matter be determined upon the merits." If, therefore, the words set forth in the bill as a trade mark were so in reality, the use of some of those words by Ellis, as shown, did not amount to infringement; but as Ellis had admitted his guilt in unlawfully diverting the trade of Zeilin & Co., he was properly held to accountability therefor, although he did not trespass upon trade-mark property. — In the Court of Appeal

of literature and of pleading. Admitting the remote possibility of a mere necessary description of an article being transformed into an arbitrary symbol of trade, by what magical process could packages be put up in, i. e. *wrapped in*, trade-marks? And if that were actually done, by what construction of the Constitution of the United States, or statutes passed by authority thereof, could a label for medicine be deemed the work of an author?



of England, in 1880, a perplexing difficulty arose as to the exact description of the plaintiff's trade-mark for worsted goods, which had been described in the registration thereof as "a white selvage on each side of the piece, having a red and white mottled thread interwoven the full length of the selvage, between the edge of the piece and the edge of the selvage."<sup>1</sup> The Master of the Rolls had held that if, in dyeing, the colors were so affected that, on inspecting it, whiteness could not be predicated of the selvage, and that the twisted thread was mottled, red and white, as matter of law the particular trade-mark was not infringed, and that therefore the plaintiff had no remedy. But the appellate court, by James, L. J., said: "The question resolves itself into the old question which has always been the question to determine in these cases, — Are the defendants, not in words, but in acts, and by something on the face of the goods, representing their goods as being the goods of the plaintiff? that is to say, Are they using some mark which is calculated to pass off their goods as the goods of the plaintiff?"<sup>2</sup> This is undoubtedly the correct common-sense modern doctrine, where, stripping a case of all non-essential technicalities, the object of a court is to suppress fraud in diverting lawful business. Numerous recent examples of the enforcement of this doctrine may be adduced. Thus, in 1880, in a Circuit Court of the United States, *Bond and Morris, JJ.*, where the complainant had alleged that, to individualize and identify his bluing, he had adopted a peculiar and original form or style of package, consisting of a blue cylinder having a red top, his goods being known and identified by the peculiar appearance of the package, the question was raised whether the complainant had a technical trade-mark, as alleged by him. A necessity for deciding that question in exact terms did not arise. The court said that, "whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labelled boxes adopted by him, and as his goods have become known to purchasers, and are bought

<sup>1</sup> *Trade Marks Journal*, Jan. 13, 1877.

<sup>2</sup> *Mitchell v. Henry*, 15 Ch. D. 181.

as the goods of the complainant by reason of their peculiar shape, color, and label, no person has the right to use the complainant's form of package, color, or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality."<sup>1</sup>—In the same year, it was held in Missouri, that whether the thing infringed were a trade-mark or not was of no consequence, when rights were invaded.<sup>2</sup>—In the Court of Appeal of England, in 1880, Cotton, L. J., said: "We must, in dealing with questions of this kind, not look for minute differences, or even that which appears, when one hears the case argued thoroughly, with a mind directed to the particular differences, in some respects a substantial difference, but we must see what would be the effect upon the mind of the general class of buyers. . . . The defendants have not taken the actual trade-mark of the plaintiffs, but only used a ticket which is calculated to mislead. Therefore, to sustain the injunction, we must treat the case as one of fraud, that is, as a case turning on defendants' intent to use that which is calculated to deceive."<sup>3</sup> In the same case, in the House of Lords, in 1882, a similar course of reasoning was pursued. Per Lord Chancellor Selborne: "But although the mere appearance of the two tickets could not lead any one to mistake one of these for the other, it might easily happen that they might both be taken by natives of Aden or of India unable to read and understand the English language, as equally symbolical of the plaintiffs' goods. To such persons, or at least to many of them, even if they took notice of the difference between the two labels, it might possibly appear that they were only differences of ornamentation, position, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged." Lord Watson said that no man, however honest his intentions, has a right to adopt and use so much of his rival's trade-mark as will enable any dishonest trader, into whose hands his

<sup>1</sup> *Sawyer v. Horn*, 4 Hughes, 239.

<sup>2</sup> *Conrad v. Joseph Uhrig Brewing Co.*, 8 Mo. App. 277.

<sup>3</sup> *Orr, Ewing, & Co. v. Johnston & Co.*, 13 Ch. D. 463.

goods may come, to sell them as the goods of his rival.<sup>1</sup> — In the Supreme Court of New York, in 1880, the reasoning of Mr. Justice Barrett, in delivering the opinion of the court on appeal, is sound, although the facts upon which he reasoned were not, in the opinion of the court of last resort, borne out.<sup>2</sup> He said, *inter alia*, that, (according to the defendant's doctrine,) "it is only necessary for the dishonest trader to avoid the use of some special word or device, to which the *technical name* trade-mark has been given, and to gain his piratical end by imitating what really conveys to the public a belief in the genuineness of the article sought. It must have been this shallow, as well as unworthy idea, which was in Troxell's mind, when he declared his purpose of imitating 'Sapolio' as closely as possible, without actually making himself liable. The law of trade-marks has been gradually expanding so as to meet just such cases. The courts, in a long and unbroken line of decisions, have endeavored to uphold and enforce commercial morality, and have afforded their protection to honest enterprise and skill. It will not be necessary to go over these cases. They have in fact been too numerous for extended analysis. . . . It will be sufficient to state the general result, . . . so far as may be applicable to the case at bar. We deem it, then, to be well settled upon authority, that, to justify the interference by injunction of a court of equity, it is sufficient that there is a fraudulent intention of palming off the defendant's goods as those of the plaintiffs, and that such intention is being carried into execution. . . . The law does not limit the form of the pretence; that depends upon the facts of each particular case. The fraud, for such it was, was long planned, and its execution proceeded by regular and steadily advancing steps. When it was found that bars of soap were unsatisfactory, a pressed and stamped cake was resorted to. Then we have the polished pan and the face reflected therein, with the variation of a monkey for a man. Then came the various colored bands, none of which were found to answer the fraudulent purpose,

<sup>1</sup> 7 App. Cases, 219.

<sup>2</sup> Morgan's Sons Company v. Troxell, 23 Hun. 632.

culminating at last in the plaintiff's ultramarine blue. What was done was done artfully, with a view to reach thoughtless and ignorant buyers, and yet to evade the law by an apparent exhibition of mere rivalry. It was also done shrewdly, by enlisting the retail grocers, through the bait of reduced prices and increased profits, thus making allies of these men for the general diffusion of direct misrepresentation. It will not do to call this enterprise and energy, nor to stigmatize the demand for protection against such practice as an effort to limit legitimate competition, and to promote monopoly." — It was conceded throughout that the trade-mark of the plaintiff had not been violated. It was therefore not a trade-mark case. What kind of a case was it, then? It was clearly one of unlawful competition, and as applied to such a case the reasoning is perfectly sound. But the Court of Appeals did not think that the *allegata* and the *probata* agreed, and reversed the case, ordering a new trial.<sup>1</sup> Rapallo, J., in delivering the opinion, said: "We are clearly of opinion that there is too great dissimilarity . . . to sustain the judgment in this case. . . . The law of trade-marks has not yet gone so far as to enable a party to appropriate such a form of package and fashion of label, and exclude any one else from its use, or from the use of anything resembling it. . . . When there is a simulation of a trade-mark, and the intent becomes a subject of inquiry, the form, color, and general appearance of the package may be material; but to sustain an action, there must be an imitation of something that can legally be appropriated as a trade-mark. When we come to look at the brands or contents of the labels, they are entirely different. If, as we think, there was no imitation of any trade-mark of the plaintiff, the judgment cannot be sustained on the ground of fraudulent representations of devices on the part of the defendants to palm off their goods upon individuals as the goods of the plaintiff. What remedy there is for such a wrong, if proved, it is not necessary now to inquire, but the

<sup>1</sup> 89 N. Y. 292; 11 Abbott N. C. 86. It is worthy of note that the new trial never took place, for the reason that the defendant ceased to assert his claim to use his labels, and adopted new ones.

remedy clearly is not to restrain the defendants from selling their own goods in packages, and with labels which they have a legal right to use, and which do not infringe upon any trade-mark of the plaintiff." The judgment was therefore reversed, and a new trial ordered, with costs to abide the event. — What does this decision of the highest court establish? Does it contradict the doctrine contended for by the court below? No. On a question of fact, a new inquiry is ordered. No trade-mark came in question; and we have a right to infer that an action in the nature of an action for deceit by a purchaser, or one for dishonest rivalry, might have been more successful. It seems to be a decision as to practice and pleadings.

§ 419. In the Court of Paris, in 1877, a ruling seemingly more in harmony with the current decisions was made.<sup>1</sup> The complainants, manufacturers of lace at Paris, had a design for lace, called by them "Point de Valence," for which they had registered a trade-mark consisting of the words "Point de Valence," the arms of the city, and "L. D. L.," intended to be affixed to pieces of lace of their manufacture. The defendants were lace-manufacturers of Nottingham, England. The case being considered in the tribunal of first instance, it had been found that, inasmuch as Birkin Brothers had affixed to their products (which were the counterfeits introduced into France) a label bearing only the designation of "Point de Valence," — and in so doing had not, it is true, counterfeited the trade-mark of the complainants, but had made a fraudulent imitation of a nature to deceive the purchaser, — it was manifest that they had designated the products of their counterfeiting under the name of "Point de Valence" with the evident object to deceive the purchaser in affixing to their laces the special denomination of which the inventor had reserved the exclusive use. Damages, etc. were awarded. On appeal to the Court of Paris, the judgment was affirmed. Defendants finally appealed to the Court of Cassation, which also affirmed. The reasoning below was approved, although the technical trade-mark had not been

<sup>1</sup> Deneubourg-Ligier et Cliff v. Birkin frères, 23 Annales, 207.

copied, the court saying that the tort had legally been characterized when, by reason of analogies, of resemblances sufficiently pronounced, whether in their totality or in some of the constituent elements of the mark, confusion is possible, and of a nature to mislead the purchaser. — Here is a decision of a German court, in 1882.<sup>1</sup> The house of Menier, of Paris, brought suit in the Court of Commerce of the Imperial Tribunal of Mulhouse. It was demanded that the defendant be prohibited from preparing or putting on sale chocolate prepared by him, or offered under his name, with wrappers, marks, and signs similar to those of the plaintiff, or under the same forms employed by him, and above all, from the use of the same kind of paper, the same labels, open or closed, the same form of cake or tablet, viz. in six demi-cylindric divisions. The defendant was restrained, with damages and costs. — Many other authorities could readily be adduced to prove that unfair competition in business will be suppressed by courts of equity; but a few brief extracts from a single one in the Court of Appeals of Kentucky, in 1883, may suffice.<sup>2</sup> In the opinion, delivered by Chief Justice Hargis, may be found an epitome of the law of this matter. The complainants had sought to restrain the infringement of their so-called trade-mark for ploughs. In the court below, it was found that the technical trade-mark had not been imitated, and for that reason the suit was dismissed. In the belief that the great underlying principle of right had been overlooked, the complainants appealed. After ably discussing the law of trade-marks, the appellate court felt constrained to concur as to the fact found below; but it rose to a higher plane of morality, when the court said, *inter alia*: “The appellees have not used a single letter, figure, or word that belongs to appellants’ trade-mark proper, yet, by the exact simulation of the plough in every perceivable point exposed to an ordinary observer and purchaser, and the use of the same coloring and staining, the same relative position of the

<sup>1</sup> Menier v. Leblanc-Winckler, 28 Annales, 24.

<sup>2</sup> B. F. Avery & Sons v. Thos. Meikle & Co., Kent. L. R. and Journ., April, 1883; 23 Alb. L. J. 203.

letters and figures, as employed and used by the appellants, avoiding the literal appropriation of any part of their trade-mark, the appellees have obscured appellants' trade-mark, but at the same time sought to avoid detection and responsibility in doing so, and to cause their ploughs to be taken for and purchased as those of appellants." It must be observed that the court has treated this case as an infringement of a trade-mark, although the imitation of the arbitrary symbol itself had been studiously avoided, and only its non-essential accessories had been copied. "Thus by skilful combination of legal particles, taken one at a time and in the aggregate, leaving the mere trade-mark untouched, they have so confused its force and effect as to destroy its office and real efficiency to distinguish the appellants' ploughs from all others." The relief prayed for was therefore granted.

§ 420. *A Manufacturer has a Right to affix his own Name* to an article of his own production; and any injury which another manufacturer having the same surname may suffer in consequence thereof is *damnum absque injuria*. Said the New York Court of Appeals in *Meneely v. Meneely*:<sup>1</sup> "Every man has the absolute right to use his own name in his own business, even though he may thereby interfere with or injure the business of another person bearing the same name, provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead. Where the only confusion created is that which results from the similarity of the names, the courts will not interfere." We have here an enunciation of the general rule, with a suggestion as to the limitations and qualifications thereof. One may enjoy his property, including his name, in a manner to please himself, subject to the maxim, *Sic utere tuo ut alienum non lædas*. And it is not a legal injury to another properly to use one's own name.<sup>2</sup> So, if one's surname be Holloway, he has a right to constitute himself a vendor of Holloway's

<sup>1</sup> 62 N. Y. 427; 20 Am. R. 489; 2 Am. L. T. (n. s.) 482.

<sup>2</sup> *McLean v. Fleming*, 96 U. S. 245; 13 Off. Gaz. 913. *Burgess v. Burgess*, 3 De G., M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53.

pills and ointments;<sup>1</sup> or where M., having a recipe for a liniment (not his own invention, nor protected by a patent), communicated his secret to several members of his family, and permitted every one of them, for his own or her own benefit, to manufacture and sell the liniment with a certain label furnished by M. attached, any one of that family may lawfully use his or her surname as an affix to the article.<sup>2</sup> Equity will not enjoin against telling the truth.<sup>3</sup> The Supreme Court of Rhode Island went so far as to hold that a manufacturer has a right to attach his own name to his manufacture, even though a rival manufacturer of the same name has given it prestige in the market and may suffer in consequence.<sup>4</sup>—The foregoing citations are illustrations of the general rule. The exception to the rule has often been discussed judicially. One must so use his own name as not to create confusion in the public mind between his goods and those of another of the same name.<sup>5</sup> In the Holloway case, it was held that the defendant had no right to use his own name in such a way as to make the public believe that he was selling the goods of his brother, by using pill-boxes, pots, labels, and wrappers similar to his. — In *James v. James*, the plaintiffs, under an assignment from Robert James, the original inventor, manufactured and sold an ointment known as “Lieutenant James’ Horse Blister,” and the defendant, Robert Joseph James, began to sell an ointment under the same name, with the signature “Robert James.” He was enjoined from omitting the name Joseph from his signature.<sup>6</sup> — One may part with the right to use his name as an affix to certain merchandise, and will be restrained from so using it; as where one named Oakes sold the exclusive right to manufacture and sell “Oakes’ Candies.” The reason is, that the name thus used is but an adjective of quality or description, which is not understood by the public as a warranty that the person who

<sup>1</sup> *Holloway v. Holloway*, 18 Beav. 200.

<sup>2</sup> *Marshall et al. v. Pinkham*, 52 Wis. 572 (the court citing § 303 of this book).

<sup>3</sup> *Canal Co. v. Clark*, 13 Wall. 311; 1 Off. Gaz. 279; 5 Am. L. T. 135.

<sup>4</sup> *Carmichel v. Latimer*, 11 R. I. 895; 23 Am. R. 481; 16 Alb. L. J. 73.

<sup>5</sup> *Mencely v. Mencely*, *supra*. *Clark v. Clark*, 25 Barb. 76; R. Cox, 208.

<sup>6</sup> L. R. 13 Eq. 421; 41 L. J. Ch. 353; 2 L. T. (n. s.) 508; 20 W. R. 484.



bears the name is the maker of the article; but only that the article is made after the same formula as when he made it.<sup>1</sup> — Two persons, Holmes and Booth, having been principal promoters of a plaintiff corporation established under the name of Holmes, Booth, & Haydens, set up an opposition under the name of The Holmes, Booth, & Atwood Manufacturing Company, in the same business. By reason of the similarity, the latter-named company was enjoined.<sup>2</sup> — A plaintiff acquired from three brothers named Rogers the right to use a trade-mark, “1847, Rogers Bros., A 1,” and the defendant began to place on similar goods stamps containing the letters, words, and numeral, “C. Rogers Bros., A 1,” and “C. Rogers & Bros., A 1.” An injunction was granted against using such stamps, or any other stamp containing the words “Rogers Bros.,” although the defendant had used his stamps by the permission of three brothers of the name of Rogers.<sup>3</sup> — It is not an unusual circumstance, that, for the purpose of fraud, one sells the right to use his name. In *Thorley's Cattle Food Co. v. Massam*, in 1880,<sup>4</sup> it appeared that Joseph Thorley, the original maker of the cattle food, died in 1876, having by his will directed that his business should be carried on by his executors, with the assistance of his son, Joseph Thorley. J. W. Thorley, a brother of the deceased, was induced to join in getting up a company, and became a subscriber to a shilling share therein. The Court of Appeal, by James, L. J., said: “We have had nothing like a satisfactory explanation of how J. W. Thorley's company came into existence; how they came to form themselves into a company, unless it was that they thought that Thorley was making a very good thing; that they thought that Thorley's food was a very profitable thing; that it had got a very great reputation, and that some of them would like to steal the reputation which Thorley's article had acquired. In order to do that, they

<sup>1</sup> *Skinner v. Oakes*, 10 Mo. App. 45.

<sup>2</sup> *Holmes, Booth, & Haydens v. The Holmes, Booth, & Atwood Manufacturing Co.*, 37 Conn. 278; 9 Am. R. 824.

<sup>3</sup> *The Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Am. R. 401; 13 Am. L. Reg. (N. S.) 153.

<sup>4</sup> 42 L. T. R. (N. S.) 851; 14 Ch. D. 748.

seem to have somehow or other got into communication with a gentleman who was a relation of the late Joseph Thorley, and a connection of his executors, and who for some years had been in the service of Joseph Thorley, and during those years . . . had acquired a knowledge of the recipe, and had acquired the exact knowledge of the manufacture; . . . but having the name of Thorley, which was the distinguishing mark of food for cattle, he either tendered himself for sale, or was found for purchase by some person, in order that his name might be got into a joint-stock company, limited, for the sake of selling these goods. Why was that name got in there, except for the purpose of inducing the world to believe that it was the same concern, or that it was *the* Thorley whose name was the principal characteristic of the name of the article? The name of the company, I cannot help observing, was J. W. Thorley & Co., Limited, and that J. W. Thorley & Co., Limited, is, to my mind, to begin with, a fiction, an intentional fiction. . . . But here the J. W. Thorley was not a partner. J. W. Thorley was employed as an agent, as the manager; and J. W. Thorley's only connection with the company, *qua* company, is that he held a one-shilling share in it, the company itself having a capital of £200, or something of that kind. To my mind, that would really be exactly the same thing as if somebody were to establish a brewery at Burton, finding some one of the name of Bass, — because there is no law to prevent a man assuming any name he likes, — and then calling themselves J. Bass & Co., Limited, or W. Bass & Co., Limited, and advertising Bass & Co.'s pale ale." The court then went on to discuss the purpose of similarity of packages, in shape, size, color, all evidence of fraudulent intention, especially when taken in connection with the name assumed. — The rule as to prohibition from using one's own name applies also to a pseudonym. As was said by Bramwell, L. J., in the foregoing case, a surname is not a man's legal property, nor conferred upon him by law in any particular way. It is gained by reputation, and if he choose to adopt the name of Thorley, and other people call him by that name, he is Thorley to all intents and purposes, although his name originally was

John Doe. — In *Grow v. Seligman*, in the Supreme Court of Michigan, in 1882,<sup>1</sup> the defendant had established a business under the pseudonym of “Little Jake.” He sold the goodwill of his business, and stipulated not to use that fancy name in trade as a rival to his assignee, who was to have the exclusive benefit of the said name. The court held that there was no reason in public policy why the vendor should not be enjoined.

§ 420 a. *French Cases as to the Use of one's own Name.* — The Court of Paris said, in 1875, that when one has become known in a certain industry, or in connection with the preparation of a certain product, rivals who bear the *same name* should, above all others, avoid resemblances of marks tending to create confusion.<sup>2</sup> — In the Court of Lyons, in 1875, the plaintiffs were successors of Lubin, perfumer, of Paris, and owners of his trade-marks. Bottles bearing a counterfeit label had been placed on sale by divers retail merchants of that city. As to the use of the name “Lubin,” the defendants justified by the production of an agreement, duly registered, by the terms of which they had acquired from one Jean Lubin, hair-dresser and perfumer at Cahors, a number of formulas of perfumery products, with the right to use his name. The court said that the bad faith of the defendants was manifested by the circumstance that the label of the bottle not only does not make known the domicile and the identity of said Jean Lubin, whose name they pretend to be their property, but does not designate themselves, nor indicate the origin of the products placed by them on sale. They were nevertheless found amenable under Article 8 of the act of 1857, and mulcted in 5,000 francs, with costs, etc.<sup>3</sup> — In the Tribunal of Commerce of Lyons, soon after,<sup>4</sup> between the same parties, it was held to be dishonest competition to profit by a similarity of name tending to establish confusion between the respective products. For more than seventy-five years, the plaintiffs or their predecessors had constantly used the

<sup>1</sup> 47 Mich. 647.

<sup>2</sup> A. Boyer v. R. Boyer, 21 Annales, 20.

<sup>3</sup> For the registration law referred to, see Appendix.

<sup>4</sup> 20 Annales, 108.

name "Lubin" to designate their commercial house. In that name, reproduced in all their trade-marks, labels, letter-heads, and invoices, their products were known in France and abroad. The Tribunal further said that the name of Lubin had been adopted by the defendants to profit by the similitude of name; that they founded their perfumery house only with a view to organize an illicit and dishonest competition. — As to a wrongful use of one's name, this interesting case came up in the Court of Montpellier, in 1877.<sup>1</sup> Many times in the courts of France have been discussed infringements of the cigarette-paper known under the fanciful name of "JOB."<sup>2</sup> Jean Bardou died in 1852, leaving several children. Pierre Bardou, the plaintiff, became proprietor of the place of business and the trade-marks thereof, and especially of the stones, stamps, seals, etc., for the purpose of impressing the marks. But scarcely was he in possession than he was obliged to sue his elder brother, Joseph Bardou, who had founded a similar house, and claimed the right as soon as their father died to use his marks. The title was judicially declared to be in Pierre. Joseph was ordered to prefix his baptismal name. Peace seemed to be definitely assured, when, in 1875, Joseph and his son and associate, Léon, thought to create a new mark consisting principally of the name "Papier Bardou." To this they gave an immense publicity, notably by prospectuses in verse, having for an epigraph "Vox populi, vox Dei," in which verse the paper was boasted of as proceeding from M. Bardou.<sup>3</sup> Freely translated the verse runs thus: "The celebrated inventor, the sole manufacturer, who knew how to neutralize empyreumatical oil, and only in the vat purifying his paper, removed the dry taste which pricks the throat,

<sup>1</sup> Pierre Bardou and Pauilhac v. Joseph and Léon Bardou, 23 *Annales*, 49.

<sup>2</sup> See *ante*, § 398.

<sup>3</sup> "Ce célèbre inventeur, ce fabricant unique,  
 Qui sut neutraliser l'huile empyreumatique,  
 Et, dans la cuve seule épurant son papier,  
 Enleva ce goût sec qui picote au gosier,  
 Grand défaut que toujours la feuille à cigarette  
 Tient du chlore irritant, de la pâte incomplète.  
 De ce papier malsain ne faites aucun cas;  
 Mais comme Le Bardou, vous n'en trouverez pas."

that great defect which originates from irritating chlorine and deficient paste. Never make use of that unwholesome paper; and like Le Bardou you will not find any of it [empyreumatical oil]." This paper was also announced by placards, and by medallions of a blue color, on which the words "Papier Bardou" appeared in conspicuous characters, which placards were placed in tableau form among dealers, and the medallions pasted on the walls of Perpignan, Toulouse, Montpellier, etc. They bore an indication of the manufacturers, "MM. Jh. Bardou et fils," with the notice, "Ne pas confondre avec le JOB." The plaintiffs demanded the suppression of the words *Papier Bardou*, and of the specious warning not to confound the defendants' paper with that known as the JOB. The demand as to the warning was agreed to, but all other modification was refused by the defendants. The tribunal below had forbidden Joseph and Léon Bardou to designate in future their house under the sole name of *Maison Bardou*, and this cigarette-paper as *Papier Bardou*, and that they should not make use of these denominations on boxes and packages of cigarette-paper, letter-paper, labels, prospectuses, placards, and announcements, unless the prenomens *Joseph* should precede *Bardou*; and that the defendants should not in any mode employ the initials J. B., whether alone or together, in such a way that the products of the parties might be confused. Six months' time was allowed to make the changes, etc. Defendants appealed. The decision was affirmed; the appellate court holding that Pierre Bardou was the sole proprietor of the mark of Jean Bardou, the common father, and should be considered the veritable founder of the commerce and property which has attached to the manufacture of cigarette-paper, known either as *Papier JOB* or *Papier Bardou*. — Now comes a case where the names were not quite alike. In the Tribunal Correctionnel of the Seine, in 1877, the defendant, profiting by the analogy existing between his name and that of Bobœuf, affixed to bottles containing *phénol* prepared by him, a label, the *ensemble* of which presented the general appearance of that of the complaining party, the principal details thereof being manifestly

an imitation of the characteristic features thereof. Bœuf reproduced in the identical position the fac-simile of a medal, in size and interior disposition the labels agreeing. Under his medal, the defendant printed the name "P. C. Bœuf," in the same style of type and same number of letters as in the leading feature of the genuine "Phénol Bobœuf" label. Besides this, his signature, formed of the surname preceded by the initial letters P. C. and the *parafe* completing it, were combined in such a way as to present a sensible similarity to the signature and *parafe* of Bobœuf. 500 francs damages, destruction of labels, etc.<sup>1</sup>—In the Court of Paris, in 1879, the plaintiff was in business at No. 13, and defendant, his brother, set up a similar business at No. 28 of the same street. *Held*, that defendant must differentiate his name by a prefix or affix, so as to avoid confusion.<sup>2</sup>—The Court of Cassation of France, in 1878,<sup>3</sup> held, *inter alia*: Every one really personally exercising a commerce or an industry has the incontestable right to inscribe his patronymic name on his signs, announcements, invoices, and the products of his industry. Such use of his name is an essential attribute to the enjoyment of property. The Court of Paris, from which an appeal was taken, had established the existence of reprehensible devices and efforts manifesting unfair competition in the manufacture and sale of pianos, and for that reason had ordered the absolute suppression of the name of Nicolas Erard in all marks of commerce and manufacture, invoices, circulars, announcements, prospectuses, catch-words, exterior and interior signs, and all other particulars concerning the manufacture and sale of pianos. The appellate court said that the law of property had been misunderstood in the court below, and reversed the decree as being too broad in its scope.—But a few months later, in a case between the same parties in the Court of Amiens, it was held that Nicolas Erard should add to his nomen and prenomen affixed to his pianos, invoices, announcements, and other publications whatsoever, the words

<sup>1</sup> Héritiers Bobœuf v. Bœuf, 20 Annales, 138.

<sup>2</sup> Galand v. Galand, 27 Id. 128.

<sup>3</sup> Mme. Veuve Erard v. Nicolas Erard, 20 Id. 225.

“of Mulhouse”; and the surname should be six millimeters high and one wide, the prenomen Nicolas to be ten millimeters high and two wide, and each to be placed in certain positions. The complainant was awarded 15,000 francs damages and costs. The defendant appealed. The Court of Cassation, in 1879, affirmed the decree; and said that, in obliging Nicolas Erard to give more prominence to his prenomen than to his nomen, and to employ characters of certain dimensions, and to affix his trade-mark only in certain specified places, the court below had not transcended its legitimate powers.<sup>1</sup>

§ 421. In *Faber v. Faber*,<sup>2</sup> at a special term of the Supreme Court of New York, in 1867, this question came up on a motion to continue an injunction. The action was brought by John Lother Faber, the manufacturer of the article known as the “A. W. Faber” lead-pencil, against John H. Faber and his agent in this country, J. S. Frankenthal, for an injunction, and damages for violation of the trade-mark claimed by the plaintiff. The plaintiff then resided and carried on the manufacture of pencils at Stein, and the defendant J. H. Faber at Schweinau, both which places are near Nuremberg, Germany. At and near Nuremberg were many other manufacturers of lead-pencils. For the defence, it was contended that the plaintiff had no trade-mark in the name “Faber”; and that the method and style in which the pencils were manufactured and put up, the kind of wrappers, labels, etc. used, were not peculiar to the plaintiff, but were such as were generally employed by the manufacturers at Nuremberg. Sutherland, J., said that it was unfortunate for the plaintiff that he and the defendant J. H. Faber were both manufacturers of lead-pencils at or near the same place in Germany, and that both had the same name, Faber; for it was easy to see that this circumstance may have been an injury to the plaintiff; but the defendant Faber had a right to put or stamp his own name in gold, gilt, or other letters, on his pencils, and on the bands, wrappers, or covers in which they are put up, as described in the complaint; and any injury which the plaintiff had suffered, or might suffer, by such use of the

<sup>1</sup> 25 Annales, 386.

<sup>2</sup> 49 Barb. 357; 8 Abb. Pr. (n. s.) 115.

defendant Faber's name merely, must be viewed as an injury without a remedy; that the plaintiff certainly could not claim the exclusive right to manufacture lead-pencils for the American market, or the exclusive right to make them round, or to cover or polish them with black varnish, or to stamp gilt or gold numerals upon them to designate certain qualities; that it was plain to him that the plaintiff had no right to complain of the form or finish of the defendant J. H. Faber's pencils, or of any mark or stamp upon them, viewed singly, and out of their market-bands or enclosures. There was nothing but the name of the maker stamped upon the pencils, viewed singly, calculated to deceive the purchaser of a single pencil, or of any number less than a dozen. Nor could the plaintiff complain of the manner in which the defendant's pencils were put up for the wholesale market. The plaintiff certainly had no right to the exclusive use of a particular colored paper, or kind of paper, for covering or enclosing his pencils by the gross in a book form, or any other particular form; and the judge could not see how any wholesale purchaser, knowing that the plaintiff Faber and the defendant Faber both manufactured pencils, would be likely to be deceived by the gross envelopes or wrappers, and purchase the defendant's pencils by the gross for the plaintiff's; especially as it appeared that all the manufacturers of lead-pencils at Nuremberg, to the number of twenty or more, put up their pencils by the dozen, and by the gross, in substantially the same manner, using substantially the same color and kind of paper for the bands and for the outside gross envelopes or wrappers, with substantially the same devices, numerals, and words, with the exception of the maker's name stamped upon them. As to the bands or wrappers of black glazed paper in which the dozen and the ten dozen were enclosed or wrapped before the gross are put up in book form, considering the explanations of the answer, etc., as to the general use by pencil manufacturers of the words "Crayons Polygrades" and "Pour Dessiri, Architecture Bureau," etc., no complaint could be made of their use by the defendant Faber. Besides, these words, and the gilt parallelogram and ornamental