A TREATISE

ON THE

LAW OF TRADE-MARKS.

A TREATISE

ON THE

LAW OF TRADE-MARKS

AND ANALOGOUS SUBJECTS,

(FIRM-NAMES, BUSINESS-SIGNS, GOOD-WILL, LABELS, &c.)

BY

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BOSTON:

LITTLE, BROWN, AND COMPANY.

1873.

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PREFACE.

A COMPREHENSIVE collation of authorities upon the Law of Trade-marks, with a clear enunciation of the settled principles which govern it, is not to be found in any language. A long-continued experience in the application of the Law of Trade-marks, has led the author to undertake to meet this want, so generally felt by the Bench and Bar. The attention of commercial nations is becoming more fully awakened to the great subject of protection to maker and consumer, that protection which guarantees the integrity of signs of trade. As evidence of this, witness the many commercial treaties and conventions between the principal governments, and the recent introduction of the term "Trade-mark" into diplomatic compacts; and witness the stringent remedial enactments of nearly all countries in regard to the symbol of trade.

Our first legislative recognition, as a nation, of the necessity for protection to Trade-marks, was the Act of Congress, July 8, 1870. It had a stimulating effect upon our own people; although the principal object that it had in view, it must be confessed, was the matter of reciprocity.

Producers are beginning, generally, to realize the truth that a Trade-mark is of value, far exceeding in worth a temporary and territorially-limited patent or copyright; and they open their understanding to the fact that the longevity of the symbol of trade is equal to that of trade itself; while it also has

a world-wide universality of operation. The natural *right* being conceded, the *remedy* for its violation must follow just so soon as the tribunals of justice shall have unbarred their portals to all alike. The members of the legal profession, including practitioners before the Patent Office, and all who have given the subject a thought, have a right to expect that some one will bring order out of Chaos, and reduce the theory and practice to well-defined rules, based upon adjudicated cases.

In 1860, Mr. Upton published his book on the Law of Trade-marks. Down to this time, that is the only American treatise upon the subject. That gentleman earned the gratitude of the profession for his extrication of the matter from the doubt and confusion in which it lay; for with us this portion of the law was then but poorly understood. Since Mr. Upton's book appeared, great progress has been made in the settlement of the rules and doctrines of Trade-marks and analogous subjects, as is attested by the fact that the greater number of adjudications thereon have since been made.

In England, Mr. Lloyd put forth an excellent little treatise on the Law of Trade-marks, &c., of about eighty pages duodecimo; the greater portion of which first appeared in the "Solicitor's Journal" during the year 1861, and the early part of 1862. A second edition was issued in 1865.

In France, in 1855, was published the *Code International de la Propriété Industrielle, Artistique et Littéraire*, by MM. Pataille and Huguet; and in 1865 appeared an *Appendice* to the same, by the former gentleman. This is a work of great merit, containing as it does much and various information in regard to treaties, commercial conventions, and other congruous matters; but to us it is limited in value, other than as a book for reference. In 1855, those gentlemen also commenced

the issue of a periodical entitled *Annales de la Propriété etc.*, principally composed of decisions of the tribunals of commerce and courts of France, and sometimes of Belgium, Switzerland, and other countries, in patent, copyright, and trade-mark cases. The publication still continues under the able editorship of M. Pataille, assisted by other jurists and writers of recognized ability. The seventeen volumes of this work contain a mine of wealth, not only in the terse, logical decisions of the courts, but also in the able contributions of essayists. It will be seen that many references thereto are made in the following treatise; for the principles involved in their deliberations are applicable to our own controversies.

In Belgium, in 1843, the zealous Jobard sent forth his *Création de la Propriété Intellectuale*, which, although mainly devoted to the discussion of patent and copyright matters, still incidentally furnishes food for reflection on the subject of our present investigation. The same may be said of more recent books by the same author.

Our libraries are not rich in the possession of German lore on this subject; and the few accessible books in the German language are mostly elementary, containing but little in the matter of judicial decisions. Klostermann's work, entitled *Die Patentgesetzgebung aller Länder, etc.* (Berlin, 1869), has enough upon the law of Trade-marks to satisfy any one that the principles thereof are understood and applied in all countries in the same way, and to the same extent.

In 1871 appeared a volume of nearly 800 pages, entitled "American Trade-mark Cases," gathered by Mr. Rowland Cox. This collection is convenient and valuable, inasmuch as it contains or embraces the principal published decisions of the courts of the various States of this Union; and in an Appendix the decisions of the English courts.

We have also Fisher's English Digest, and other Digests by able American editors. These all are useful, if they do no more than point the direction in which the inquirer shall seek more full and explicit authoritative enunciations of legal principles. It is, however, to be regretted that these collections of decisions are not carefully classified, so that a Trade-mark proper may at a glance be distinguished from analogous subjects. The titles are too general. This fault — for so it must be termed — is not attributable solely to the collectors of decisions, but in some measure to the judges and reporters, who do not properly label their wares before they send them forth to the world. These frequently bear false marks. In the hurry of practice, the counsel cites a case as authority, and to his chagrin finds that it will not bear the test of analysis. The supposed Trade-mark case turns out to be one of good-will of a hotel, a contest about the right to a sign over the door of a dry-goods shop, or something else quite valueless for the purpose required. Careless terminology is suspiciously like the outgrowth of a careless habit of thought.

The Law of Trade-marks must be gathered from the reports of judicial decisions of all civilized countries, not the least valuable of which are those of commercial tribunals of the Continent of Europe. In the discussion of ordinary legal topics, we must be content with the adjudications of courts under the sway of the common law of England; but in this matter, with Mansfield, we go below the surface, and seek the origin of the fundamental rules of our subject in the immutable law that Nature herself ordained. Local law could do no more than affect the remedy for a violation of a Trade-mark proper. Therefore, we go to the very foundation of right, to the law that has no place nor time.

This work would have been incomplete without a brief history of proprietary-marks of various kinds. It includes, also, a statement of the foundation of title to a Trade-mark; by whom, and how, the same may be acquired; the characteristics that entitle it to protection; what is deemed a violation of the right; the remedies, preventive, remunerative, vindicatory; and the practice and forms.

It also treats of analogous subjects, as mere labels, stamps, envelopes, advertisements, and other things frequently mistaken for and cited as the universal mark of commerce; and also of the names of establishments of trade, of inns, &c.; of names of firms; of names of literary publications, and other matters, all controlled, more or less, by the same principles, although variant in nature.

Perhaps not the least interesting matter will be the decisions of the Patent Office in the treatment of applications for registration, mostly never before printed. The rules and forms of practice in the Office must, it is believed, prove to be of some value to the practitioner.

Much valuable material may be found in the Appendix, including an alphabetical list of eleven hundred registered cases, with short descriptions, &c.

So far as possible, the latest decisions of the courts of England, France, and other European nations, as well as those of our own land, have been consulted and cited.

W. H. B.

WASHINGTON, D.C., January, 1873.

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* In the reports this name is spelled two ways: this is probably correct.

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LAW OF TRADE-MARKS.

CHAPTER I.

INTRODUCTION.

Antiquity of Proprietary Marks. — Some Ideas as to their Use by the Ancients. — Symbolical Language of Trade-marks. — Vouchers of Authenticity of Articles of Commerce. — Of what may Marks consist. — Seals, Coins, Emblems. — To be respected must be protected. — Use by Manufacturers, Traders, Booksellers, &c.

§ 1. **Antiquity of the Subject.** — The proprietary instinct is an implantation of nature. The claim to property is asserted by means of symbolism. A man may be permitted the free use of an estate; but his enjoyment of it must necessarily be imperfect unless his title be attested by the symbolical marks borne by the title-deed. Upon the genuineness of those marks, consisting of words, signatures, and seals, depends his faith. If any of those signs prove to be false, the absolute right to the property is illusory. Who would purchase even a toy for a child without feeling assured that he was being dealt with in good faith? He desires a particular article, the make of some especial manufacturer. He glances at a mark upon the thing offered. It is sufficient. It has a peculiar sign upon it. Faith guides him. The same faith has governed men in their commercial transactions through all past ages, and must continue to do so for all the future.

§ 2. Seals and emblems of ownership were coeval with the birth of traffic. The numerous relics of prehistoric antiquity,

which have floated down to us on the current of Time, fully authorize this conclusion. That such marks were always in use at less remote periods, we gather from the records of chroniclers, on whose lips the signet-royal of Death was impressed thousands of years agone. In truth, no organized system of trade could safely be conducted without the aid of symbols of ownership, or of origin; for the simplest mode of exchange of goods, to be trustworthy, must be subject to faith in the authenticity of emblems attesting the probity of the vendor. We may reasonably assume, therefore, that marks were found to serve an important purpose from the beginning of competition in manufactures and the incipiency of commercial spirit. What more natural than to affix a mark of identity to any thing we make or possess! It is not done through a churlish or selfish motive, but merely to avoid confusion and dispute.

§ 3. Such emblems had their origin in a general ignorance of reading the combinations of cabalistic characters that we call writing. A written certificate of the genuineness of any article of merchandise could not be understood by the nomadic peoples who desired to barter natural products for something made by the hand of skilled artisans. A simple emblem, as a crescent, a sun, a star, an animal, or other object copied from nature or devised by fancy, when once associated with a particular class of goods, or the handicraft of a certain man, would readily be understood. Perhaps Tubal-cain — he who in the first ages of the world was "the instructor of every artificer in brass and iron" — was wont to impress on his utensils and weapons a peculiar emblem of authenticity. Faith, the very soul of commerce, thus gave mutual advantages. The maker was protected against unfair competition of inferior workmen, and the purchaser had a guaranty of excellence. The mark was as easily read as were the marks that distinguished the cattle of Jacob from those of Laban. It spoke an emphatic language: When you see me, know that I have come

from So-and-so. From the day that such signs were used by artisans to indicate the product of their skill, or by merchants to vouch for the honesty of commodities sold or traded by them, base imitators must have existed, for dishonesty is not the junior of art. He who could forge a piece of metal could also forge a symbol. Thence arose the necessity for restrictive laws and retributive penalties; for from the beginning of the world the protection of the helpless and innocent has been a supreme object of legislation. "The law was made for transgressors," and to the law the wronged, the weak, the simple, look for redress from the rapacity of wicked men, and for the conservation of their rights. We can readily conceive how easy was the transition from the process of marking animate property to inanimate, from the branding of flocks and herds to the branding or otherwise marking of manufactures. The history of the word *chattel* informs us that in the early ages beasts constituted the chief part of a man's property. The word signifying cattle came to mean all other kinds of movable property the subject of bargain and sale, so the symbol of ownership might as well be applied to one kind of personal property as another. The object of affixing a mark was gain, just as it is now. It is meant to insure an adequate reward for acceptable workmanship, or to be evidence of authenticity.

§ 4. Seals are the most sacred of proprietary marks; and from early antiquity they have been used. The seal has ever been a distinguishing mark of ownership; of security, as in the case of sealing the den of lions upon Daniel, and the door of the sepulchre wherein was laid the body of the Saviour; of affection, as in the language of the Church to her Lord in the Song of Solomon: "Set me as a seal upon thy heart, as a seal upon thine arm;" of honor, of secrecy, of attestation, of authenticity. The *sigillum* or signet of a monarch or man in authority has always been deemed an instrument of power. Many noble families have in use ancestral seals which have descended to them from distant generations, and which they

regard with reverent pride. The seal is a figure frequently mentioned in Scripture. We read of the inscription on one, "The Lord knoweth them that are his;"[1] and St. John tells of the mighty host who were sealed in their foreheads.[2] We speak of the seal of baptism, the seal of holy communion, the seal of matrimony, and, most solemn of all, the seal of death.

§ 5. Soon after the Norman conquest, in consequence of their presence being required to give validity to every species of legal documents, SEALS became instruments of the greatest moment; and heraldic insignia, with a representation of the knightly shield, upon whose field they were displayed, were exactly suited to fulfil all the requirements of the seal-engraver. By such means heraldry became interwoven as well with the peaceful concerns of every-day life as with the display or martial splendor and turmoil of war. Heraldry may be regarded as a science, insomuch as it possesses a system, a classification, and a language of its own, — which language speaks forth in many a hundred trade-marks. But in this work it is simply as a token of proprietorship and authenticity, and as a fertile source of business emblems, that we regard the seal. Whether as a sign, a word, a brand, — in all cases the legal significance is the same. A *brand* (from the Anglo-Saxon, *brand*, to burn) is a seal of ownership imprinted on casks or other wood-work with hot iron; derived from the custom of burning criminals with heated metal. Seal-marks of rank, profession, trade, are infinite in style, but each is sacred to its possessor or originator. No man has any more right to plunder his neighbor's emblem, whether private or professional, than he has to steal his gold or his wife. In hereditary dignities, the seal, regarded as a precious jewel, attached to the title, and the most rare and exquisite gems are often employed in their construction. Heraldic devices are frequently highly prized as commemorative of family honors. Virgil assigns to Aventius "insigne

[1] 2 Tim. ii. 19.

[2] Rev. vii. 3.

fraternum" upon his shield,—his hereditary device, derived by him from his father.[1] Badges are likewise proprietary marks: "Might I but know thee by thy household badge,"[2] says Shakespeare; and again he says, "For sufferance is the badge of all our tribe."[3] The label, another heraldic term, is only connected with trade-marks so far as being a groundwork for figures or other devices.

§ 6. Sign-boards are yet another description of proprietary marks. The ancient Egyptians, Greeks, Romans, seized this idea of advertising, and displayed sign-boards with inscriptions denoting their trades, further embellished with the most striking emblems thereof. We have no reason to think that the shrewd Oriental and Latin merchants were in those ancient days a whit behind their successors in the great bazar of life in devices to influence trade. On the contrary, they seem to have been exceedingly fertile and ingenious in symbols and other adjuncts of popularity. Amongst the ruins of Herculaneum and Pompeii have been discovered signs crudely painted, or graven in stone, or modelled in *relievo* in terra-cotta and inserted in the pilasters at the side of the open shop-fronts. Thus there have been found a *goat*, the sign of a dairy; a *mule* drawing a mill, the sign of a baker; and, at the door of a school, the not very seductive sign of a *boy* undergoing a birching at the hand of the master. At the shop of a perfumer were represented various items of his traffic. There were also the signs of the anchor, the ship, a sort of chess, and chequers. In Herculaneum, at what was probably the door of a shoemaker, was a painted *Amorino*, or Cupid, carrying a pair of ladies' shoes, one on his head, the other in his hand. Complex or simple sign-boards seem to be indispensable to prudent trading, and the most illiterate rustic has sufficient tact to fashion a trade-mark peculiar to himself, and not to be infringed on by another. From the custom of setting up a green bush at the door of a vintner,

[1] Æneid, vii. [2] Henry VI., Part 2, Act 5. [3] Merchant of Venice, Act 1.

arose the Italian proverb, "Al buon vino non bisogna frasca." From the Romans undoubtedly our forefathers adopted the sign-board. A thousand-or-so years ago reading was a rare acquirement with the commonalty; consequently to write the trader's or owner's name would be of little avail. Those that could, advertised their names by rebuses; thus, for instance, a hare and a bottle stood for Harebottle, and two cocks for Cox. Others, whose names no rebus could represent, adopted pictorial objects according as genius or imagination suggested. What more convenient than for an innkeeper to emblazon on his sign-board the family crest of the lord of the estate whereon he lived! Luther was generally represented by the symbol of a swan; thus, "The Bible and Swan" was the characteristic sign of an inn in honor of Luther. Did not Lord Mountgarrat derive his title from the fact that one of his ancestors was a man of letters, probably a briefless barrister who had his dwelling in an attic? Temporary or accidental emblems have ofttimes become permanent associations, as in the case of the style of paper termed foolscap. In the reign of Charles the First, all English paper bore in water-marks the royal arms. Cromwell's parliament, to cast indignity upon the memory of that unhappy monarch, substituted the fool's cap and bells. Although in the course of time those symbols were discontinued, the name sticks.

§ 7. It may not seem irrelevant here to allude to the interesting law-case which was decided by a water-mark on paper. On the demise of a wealthy person, a forged will was produced so cunningly executed, that, although by the parties concerned it was known to be false, the fact could not be legally proven. As the counsel of the rightful heir sat studying the case over one night in his office, he chanced to hold the document up before the candle, and there, to his deep satisfaction, he discovered in water-marks the figures of the year in which the paper was made. It was a period of several years *after* the date in which the false will was said to have been executed.

§ 8. If one kind of workman might profitably employ individual marks, so might any other. The mechanics in the quarries, making ready stones for the temple of Solomon, availed themselves of this mode of proving their claims to wages. Recent discoveries confirm the tradition. The cinders of burnt Jerusalem have been cut through, and turned up to the light. The seal of Haggai, in ancient Hebrew characters, has been picked up out of the siftings of the rich moulds deposited by the treasures of Jewish pride. The first courses of stones, deposited by Phenician builders, have been reached. Quarry-marks, put on in vermilion, have been copied, — known to be quarry-marks by the trickling drops of the paint, still visible; only they are above the letters, showing that when they were affixed the stones lay with the underside uppermost.[1] The same practice continues in vogue to this very day where many men are employed. The engineer and the architect know each mark, and thus can instantly fix the origin of every piece of work. The practices of antiquity are exhibited and copied by our own artisans, who stop not to think whether they are not pursuing the practices of other forerunners of several thousand years ago. We see the tile-maker stamp his products with his private mark; and sometimes the common building-brick is impressed with its author's seal, rude though it be. The most ancient bricks recovered from the ruins of the temples of Nineveh and Egypt have many kinds of marks of origin.

§ 9. The condition of man as an inhabitant of the earth, and the relations and intercourse of men as members of a community, involved the necessity of a circulating medium. A *tertium quid* — a third commodity of a certain value — became necessary as a medium of exchange. At different periods the medium of exchange has been represented by various commodities, which at this day would be the very objects of barter.

[1] See the First Statement of the Palestine Exploration Society, 1871.

The ancient Greeks, with a limited commercial intercourse, used as a currency the cattle that grazed upon their land. These had one advantage, that of being able to transport themselves, under charge of drivers. Homer (in his episode of Glaucus and Diomed, where the former is represented as having given his golden armor, worth a *hundred oxen*, for the brazen armor of the latter, worth but *nine*[1]) chronicles the use of cattle as a medium of exchange. Yet at that time the Greeks had talents of gold, but they were too valuable to use as current specie. Then as the use of coin superseded the more cumbrous living standard of value, the term "oxen" or "cattle" was transferred to the representative coin. They used stamped bars, the rude mark serving the same end that the image and superscription did at a later period. That plan again failed to receive full confidence, so it was supplanted by actual coinage, which many authorities date from about seven centuries before the Christian era.[2] Homer, however, speaks of brass money as being in existence nearly twelve centuries B.C. To the Lydians is ascribed the invention of gold and silver coin. At Rome, under Servius Tullius, money was coined about 578 B.C. Julius Cæsar was the first person who obtained permission from the senate to stamp his image on the national coin; that honor having previously been reserved for the gods or defunct heroes. It was probably about the time that Daniel was cast into the lions' den that those famous pieces of gold called *Darics*, from Darius the Mede, were coined; their fineness and beauty causing them to be preferred to all other money throughout the whole East. Spanheim informs us that upon the coins of Tenedos and those of other cities a *field-mouse* is engraven; together with Apollo Smintheus, the driver away of field-mice, on account of his being supposed to have freed certain tracts of ground from those animals. Shekels that have Samaritan inscriptions were generally coined by Simon the

[1] Gillie's Ancient Greece, vol. i. p. 11.
[2] Snowden's Mint Manual of All Nations.

Maccabee. The first money coined in England was under the Romans at Colchester.

§ 10. There must have been an interval of over one thousand years during which the precious metals were known and used before the ingenuity of man was able to apply them to the purposes of coinage. 1860 years B.C., Abraham, for a burial-place for his wife Sarah, purchased the cave of Machpelah; "and," says inspired writ, "Abraham weighed to Ephron the silver which he had named in the audience of the sons of Heth, four hundred shekels of silver, *current money with the merchant*." [1] We must conjecture that the money alluded to was the simple bullion, perhaps marked but not coined. A currency of authenticated coin has always been an essential element of civilization.

§ 11. It is an indisputable fact that in all ages of the world, and among all races of men, some form of symbolical expression has been in use and in favor. It was the badge of good faith. *Caveat emptor!* Let the purchaser beware! See that the seal is on the bale of goods, the marks on the fabrics! The people of the ancient nations had need of symbols as well as we. Until within the last few years the arts practised in India were nearly as numerous as those known in Europe and America. The Persians, Babylonians, Assyrians, and the still more ancient Egyptians, had their multifarious products of skilled labor. In Nineveh, the people made warlike arms, and worked in gold. They glazed earth, made beads, and wrought famous embroideries. The Etruscans were eminently skilled in the arts both of use and beauty. All those nations maintained commerce. Much of the prosperity of the cities of Asia Minor was due to the trade with India. We find that the Hindoos, a manufacturing and mercantile people, 1200 or 1300 years B.C., had their emblematic marks for merchandise. Those persons who were unable to write used the most distin-

[1] Gen. xxiii. 14–16.

guishing symbol of their craft. Thus, the cultivator used the plough; the carpenter, the gimlet; the iron-smith, a pair of pincers; the shopkeeper, a pair of scales; the musical instrument maker, a lyre, a pipe, or a trumpet. The learned used symbols that might be intelligible to the unlearned. In short, a monogram a letter, some device drawn on the article made, to denote the place of its manufacture, the artist employed, the date, was all that was requisite to constitute a proprietary mark.

§ 12. Fragments of pottery bearing peculiar marks of workmen are everywhere found in the ancient cities of the East; "pottery," as Brogniart has remarked, "affording the best records of the early ages of man, as bones do of the earth."[1] Commerce required its hieroglyphics, and commerce was universal. The situation of Babylon, at the head of the Persian Gulf, was admirably adapted for trading purposes; hence, from the time of its destruction, it was succeeded by other cities until the foundation of Bagdad. Thus spices, ivory, ebony, dyes, gums, pearls, leather, silk, and cotton-stuffs, — every sort of serviceable commodity, were floated on the Euphrates and the Tigris, or brought in caravans of camels to the grand central mart, each species of product bearing some unmistakable impress of the mercantile enterprise which exported it. We read of Babylonish carpets and tapestry, and the various other tissues and cloths so famed for brilliancy and richness of hues; and as early as the time of Joshua, mention is made among the spoils of Jericho of "a goodly Babylonish garment."

§ 13. Many relics of pottery found in different parts of the Assyrian empire exhibit upon their surfaces marks which prove that an engraved mould had been employed in their manufacture. The Chinese, the only people who profess to possess an exact chronology from the remotest antiquity to the present

[1] See Lecture by Prof. J. Forbes Boyle, F.R.S., on Arts and Manufactures of India.

time, are our preceptors in the style and mode of affixing marks to articles of fictile manufacture. We do as they did long before the Christian era. Their official annals record, as the inventor of pottery, the Emperor Hoang-ti, to whom they assign a date of 2698 years B.C.; and they tell us that under his reign there was a superintendent of pottery named Ning-fong-tsee.[1] The Chinese had a priority of 1600 years over the invention of European porcelain; yet we find proofs of their trade-marks. These are of two sorts.[2] One kind is composed of Chinese characters, which tell under what reign the article was made; the other by designs in color, or engraved names of men, or of establishments, indicating the author of a vase, the place of manufacture, or the destination of the article, as for the use of the emperor or other dignity. On a piece of pure white china of great antiquity there was found stamped a factory-mark.

§ 14. When the pioneers in the art of printing were pondering their new invention, during the transition period from block-printing with detached letters, Gutenberg, in 1436, entered into an agreement with John Riffe, Anthony Heilman, and Andrew Dreizehn, in which affair the three associates were to furnish the necessary funds, while Gutenberg was to pay them one-half of any profits, the other half being for himself. After a time the association broke up, differences arose about the liquidation, and a lawsuit was the consequence. By the records of this suit, it appears that they kept their invention a secret, and called themselves "Spiegelmachers" (makers of looking-glasses). The speculum was their protecting symbol. Aldus Manutius, the famous Venetian printer, adopted the dolphin and anchor as his mark, borrowing the idea from a silver medal of the Emperor Titus, presented to him by Cardinal Bembo. In 1503, the olive-tree was the sign of Henry

[1] Marryat's Pottery and Porcelain. London, 1857.

[2] Histoire et Fabrication de la Porcelaine Chinoise. Translated from the Chinese by Julien. Paris, 1856.

Estienne, a bookseller and printer, whose firm for several generations continued to be the leading publishers and printers in Paris. The booksellers generally had a wood-cut of their signs for the colophon of their books, so that their shops might become known by the inspection of the cut. For that reason, Benedict Hector, one of the early Bolognese printers, gives this advice to buyers, in his "Justinus et Florus:" "Purchaser, beware, when you wish to purchase books from my printing-office. Look at my sign, which is represented on the title-page, and you can never mistake. For some evil-disposed printers have affixed my name to their incorrect and faulty works, in order to secure a better sale for them." Jodocus Badius, of Paris, gives a similar caution: "We beg the reader to notice the sign, for there are men who have adopted the same title, and the name of Badius, and so filch our labor." In the preface to the Livy of 1518, of Aldus, before mentioned, a similar fraud is exposed: "Lastly, I must draw the attention of the student to the fact that some Florentine printers, seeing that they could not equal our diligence in correcting and printing, have resorted to their usual artifices. To Aldus' Institutiones Grammaticæ, printed in this office, they have affixed our well-known sign of the dolphin wound round the anchor. But they have so managed, that any person who is in the least acquainted with the books of our production, cannot fail to observe that this is an impudent fraud; for the head of the dolphin is turned to the left, whereas that of ours is well known to be turned to the right."

§ 15. An acquaintance with booksellers' marks or signs, as expressed in the title-pages of their books, is of some use, because many books have no other designation of origin. We find an anchor, the mark of Raphelengius, at Leyden; the same, with a dolphin twisted around it, the mark of the Manutii, at Venice and Rome; the Arion, denoting a book published by Oporinus, at Basle; the Caduceus or the Pegasus, on the publications of the Wechelénses, at Paris and Frankfort;

the cranes of Cramoisey; the compass of Plantin of Antwerp; the sphere in a balance of Janson or Blaow, at Amsterdam; the lily of the juntas at Venice, Florence, Lyons, and Rome.[1] Many publishers also made use of monograms compounded of the initials or other letters of their names. These furnish a clew to the discovery of the printer, where they occur on books without the printers' names. He who desires to examine a treasure-house of lore upon this subject to assure himself how general was the adoption of proprietary marks by painters, designers, engravers, and sculptors, can consult the "Dictionnaire des Monogrammes, Marques figurées, Lettres initiales, Noms abrégés," &c., of François Brulliot, published at Munich in 1832–3–4, and to be found in the Astor Library in the city of New York, and in the Congressional Library.

§ 16. We can trace proprietary marks a long way back in the history of England. In the Archæologia for 1812, a roll of 219 swan-marks is given, together with the ordinances respecting swans in the river Witham, in Lincoln, the same belonging to various gentlemen. This paper bears the date of 1570. The marks consisted of nicks, the nicking being done by swan-herds, appointed by the king's license. A register of all the marks was kept. None but freeholders were to have marks, and those were to be perfectly distinct from those used by other gentlemen. For instance, the company of the vintners had two nicks on their bills. This mode of indicating exclusive proprietorship is still annually illustrated by the guilds of London, who are entitled to claim the cygnets found with their old birds.

§ 17. The case of *Southron* v. *Reynolds*,[2] in England, in 1865, was in regard to a violation of a trade-mark used on clay pipes made at Broseley. A "broseley" is a household word with thousands who use the thing while wholly ignorant of its deriva-

[1] Encyclop. Britannica, vol. v. p. 30.

[2] 12 L. T. R. (N.S.) 75.

tion, being unaware that they perpetuate the name of a quiet little village in Shropshire, on the banks of the Severn, whose chief reputation rests upon the excellence of the quality of the tobacco-pipes there made; although, singular to state, not made of the clay there found. Of the pipes collected near there two hundred have marks upon the spur, not two of which are alike. The manufactures at that place have been traced back to the year 1575, a time anterior to the introduction of tobacco into England, which suggests the inquiry as to what purpose said pipes could have been applied. One mark is of an open hand, with the initials S. D., probably Samuel Decon. Aubrey describes pipes made in his day by one Gauntlett, who marked the heels of them with a gauntlet, whence they were called Gauntlett pipes. It is not improbable, says the historian, that Decon might have learned the "whole art and mystery" of pipe-making from Gauntlett, and then have adopted his special mark with the addition of his own initials, as a coat of arms is differenced in heraldry. About eighty years ago, the pipe-makers there began to stamp their distinctive symbols upon the *stems* instead of the *spurs*.

§ 18. As a rule, trade-marks are optional in England and France, as well as in our own country; but there are exceptions in connection with various kinds of business. In England, an act of Parliament empowered the Goldsmiths' Company to call upon the manufacturers to bring all the articles made by them to their hall, for the purpose of being assayed and stamped with the hall-mark; but various exceptions from hall-stamping were sanctioned by law. In the same manner the Cutlers' Company, of Sheffield, were empowered to grant marks to persons carrying on any of the incorporated trades, with power of summary jurisdiction before two magistrates, to enforce such regulation. We perceive that extraordinary means have been required at all times to guard against the fraudulent use of marks of manufacture. The protection of innocent purchasers was the motive of legislation. Rogues dealt in the precious and useful wares then as now.

§ 19. The first instance on record of an attempt to reduce goldsmiths' work to a certain standard was in the reign of Henry III., A.D. 1238, when, in consequence of the frauds which had been practised by the gold and silver smiths, it became necessary to prescribe some regulation for their trade, because the mixing of too much alloy in the composition of their wares tended to encourage the melting down of the coin of the realm. A.D. 1300 (28 Edward I. c. 20), it was ordained that the precious metals be assayed; and further, that the articles be marked with the "leopard's head." By the goldsmiths' ordinance of the year 1336, three distinct marks are mentioned: 1. The goldsmith's mark, to wit, his initials; 2. The assay mark, probably a letter of the alphabet; and 3. The mark of the Goldsmiths' Hall, a leopard's head, crowned. A.D. 1379 (2 Richard II.), it was enacted by Parliament that every goldsmith should have his own proper mark upon his work, and the mark of the city or borough where it was assayed; and that, after the assay, the work should be stamped with another mark, to be appointed by the king. There were many subsequent statutes and ordinances upon the same subject, penal in their nature. Marks were obligatory as checks upon fraud. In 1739 (12 George II.) it was ordained that the manufacturers were to destroy their existing marks, which were the first two letters of their surnames, and to substitute the initials of their Christian names and surnames. The curious can find tables of all the marks recorded in Goldsmiths' Hall from the thirteenth to the nineteenth centuries; and also all the standard and assay stamps required by the French law of April 7th, 1838.[1]

[1] See William Chaffer's book (London, 1872), entitled, "Hall-marks on Gold and Silver Plate," &c.

CHAPTER II.

Right to Protection. — Mutual Confidence the Bond of Union. — The Pirate an Enemy to Mankind in General. — Legislation on Subject vague until of late. — Increased Importance of Trade-marks. — Wrong of imitating Marks. — Foundation of Title. — Rests upon Natural Law. — Time required for perfecting Title to a Mark. — Who may acquire Title. — Qualification as to Traders. — Natural and Artificial Persons. — Protection. — Whose Rights are protected. — *Caveat emptor* and *caveat venditor*. — Basis of Protection of a Mark. — Judges differ in Opinion. — Deceit shall debar from Protection, as when word "patented" wrongfully used. — How to judge a Mark.

§ 20. **Right to Protection.** — The United States' statutes promise "protection" to lawful trade-marks, upon certain conditions. In its ordinary acceptation, this word "protection" is sufficiently well understood. Its legal sense is not always so clear to the novice. Applicants for registration sometimes seem to think that a bit of ribbon and the official seal of the Patent Office possess a magical potency to ward off piracy, without requiring on their parts the slightest care or concern. In a recent case in the Patent Office, the proprietor of a registered trade-mark indignantly called attention to the fact that other persons were importing his class of goods, Havana cigars, and demanded the instant interposition of the government on his behalf. It was evident from his communications that he expected the Queen of the Antilles to be blockaded, and that an armed force should be maintained, on land and sea, to prevent any one from bringing in cigars like those to which he had affixed his mark. He said that he had paid his money for his certificate, and now he must be protected. He was in-

formed that the protection was not promised to be given in that way. Physical force was out of the question. He must look to the judicial branch of the government.

§ 21. **Alien Friends.**—In the courts of the United States, under the constitution and laws, foreigners are entitled, being alien friends, to the same protection of their rights as citizens.[1] And this does not depend upon reciprocity. "The cannibal of the Fejees may sue here in a penal action though having no courts at home for us to resort to."[2] "But an alien is not now regarded 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." Says Woodbury, J.: "Comity and courtesy are due to all friendly strangers, rather than imposition and pillage. Taking their marks and using them, as, and for theirs, to their damage, is like preying on a visitor, or inhospitably plundering a wreck on shore." It is a pity that the spirit of enlightened liberality does not exist in all civilized nations. In Luxembourg, foreigners not domiciliated have no action to recover damages for usurpation of marks and names.[3] So in some other countries.

§ 22. The comity of nations demands that all kinds of commercial property be protected, no matter what may be the nationality of the suppliant for justice. The case of *Christofle & Co.* v. *Deleiderrier*,[4] in the Tribunal of Commerce of Geneva, in 1859, shows that another nation may lay claim to enlightened liberality in this respect. It was substantially held that the name of a manufacturer, and his mark, are his property under the laws of nations. This doctrine has long been maintained by eminent jurists of France and Germany; and as the nations find it to be their best interests to throw down the barriers, it is fast approaching universal acknowledgment.

[1] Story and Sprague, JJ., 1844, Taylor *v.* Carpenter, 3 Story, 458. [2] Ibid.
[3] Müller *v.* Haymann: Annales de la Propriété, etc., tome v. p. 62.
[4] Annales de la Prop., tome vi. p. 29.

It is not governed by the same rules as analogous rights, like a copyright or a patent for an invention or discovery, for such property is held to be local in its character, as well as artificial, while a right to a distinctive emblem of one's individuality, as his signature or his mark, does not depend upon any thing beyond one's own will. He made it: it is his. So, it may be said, is a man's right to the children of his brain. True. But to them has never been applied the maxim, *Debitum et contractus sunt nullius loci.* They have not yet been brought into the domain of commerce. It is not regarded as piracy to steal such things from people of other nations, who are not protected by treaty. But whoever infringes a trade-mark in any part of the commercial world commits a tort, and the law should give redress.

§ 23. Although emphatically or tacitly admitting the justice of claimants' title as resting upon the law of nature, the legislatures and tribunals of some European States have stultified themselves by denying the right to protection. In 1841, the Tribunal of Commerce of the Seine, by two judgments, decided the principle that the commercial name of a merchant is a property that the laws of all countries should respect. Yet the plaintiffs, Messrs. Rowland & Son, of England, whose name as a mark for Macassar oil had been pirated, were eventually denied the aid of the court, because aliens.[1]

§ 24. Mutual confidence is the bond of union between nations. It follows, therefore, that whoever weakens it is an enemy to all mankind. He becomes a pirate, and whether preying directly upon commerce on the high seas, or by knavery and trickery upon the land, he is regarded as a common foe, to be dealt with, when coming within the iron grasp of the law, with a just rigor. Mutual reliance must be the rule. Every act of trade by which operations to an almost boundless extent are daily transacted, is essentially founded upon confidence. By

[1] Annales de la Prop., tome i. p. 36.

the simple delivery of bits of paper bearing certain signs, millions of dollars are hourly transferred; and contracts of the greatest magnitude are made upon the description of a mark or name. Being a common enemy, the robber of his neighbor's honor or property is pursued by the accredited protectors of commerce. It has been well said that the degree of civilization to which a people has arrived follows exactly the degree of guaranty that the law of that people affords to property.[1] The eternal principles of justice have been recognized; but an armed neutrality has been maintained, at the risk of sapping the foundations of morality and self-respect. Harmony of action may soon come. Jobard, in 1851, enthusiastically entered upon the contemplation of this subject, as he welcomed the humanitary palingenesis then preparing itself. Whilst deploring the state of things then existing, he indulged in a sad tone; but there is no doubt that the animadversions of such men as he greatly assisted in bringing about the desired change.

§ 25. Monsieur Jobard said that the age of shepherds succeeded the age of hunters, the age of cultivators that of shepherds, and we have entered upon the industrial age; but we enter thereon as foragers. We have free course, because the domain is still without hedges, without ditches, without enclosures; each encroaches on his neighbor, and hunts and kills him if he be the stronger; all means are good: trickery and theft, ambuscade and violence. It is a conquered country without laws, without rules, without magistrates, where capers the dishevelled anarchy that certain sophists decorate with the title of free competition, as certain others call robbery a just and courageous reclamation of the goods of his ancestors. After the lapse of twenty years, we see the bright dawn of a more hopeful day. Nearly all the states of Europe have combined to effectuate the desire of his heart. France itself has made more than thirty treaties and conventions on the subject

[1] Jobard, Organon de la Propriété Intellectuelle.

of the protection of the fruits of intellectual labor, and the enterprise of the manufacturer or merchant. Philosophers, moralists, jurisconsults, statesmen, political economists, — all have paid their tribute to this and kindred subjects, and now they see a clear horizon in the sphere of human activity, and behold the breaking down of the barriers of suicidal proscription.

§ 26. Legislation on this subject has until of late been vague, uncertain, incomplete. Jurisprudence, however, has resolved innumerable questions by the light of natural justice, the law written in men's consciences, that immutable code inscribed by the Great Legislator on the soul. France by her law of June 23d, 1857, England by the "Merchandise Marks Act" of 1862, and the United States by the law of July 8th, 1870, in relation to trade-marks, have concurred in recognizing the necessity for more adequate protection than that afforded by pre-existing statutes or the common law. The Austrian law of December 7th, 1858, that of Sardinia of March 12th, 1855, and the many treaties for the like purpose, all display the same spirit. Said an able writer [1] in France, in 1855: "The moment has now come for each state to prescribe in its legislation that the names and marks of manufacturers of its own nation or of foreigners shall be inviolable, and shall find equal protection before the tribunals." His dream has come true. Thanks to steam and electricity, which are annihilating distances, a noble and enlightened competition has been established. We are no longer in a time when each kind of commerce and of industry is centralized in one spot, in a city, or in a region. The new ideas of civilization now open to us the empire of Japan, and even the Flowery Kingdom has begun to smile upon outside barbarians. Verily, a trade-mark has become a thing of moment, for it spurns the thraldom of territorial limits.

§ 27. We may adopt the ideas of Professor Leone Levi,

[1] Annales de la Prop., etc., tome i. p. 33.

F.S.A., &c., in speaking of the lofty position gained by British manufacturers. He spoke some years before legislation had assumed definite proportions in this regard. He said substantially that the British manufacturers are well alive to the demands upon their skill and energies, and we see them everywhere striving to rival all competitors, and to maintain untarnished the reputation they have gained. Their aim is to produce articles which for their price may be unequalled and unexcelled in this or any other country; and whenever they stamp such articles with their names, ciphers, or labels, they enter into solemn guaranties that the goods so marked shall invariably be of the quality represented. Their endeavor is to establish such an intimate relationship between the manufacturer and the manufacture, that in whatever market such goods may be exposed for sale, the same may be received with the most implicit faith and reliance. A mark on a manufacture is like the impress of the sovereign's coin, — a sufficient evidence, universally accredited, that the coin is of a specific rate and fineness. Why should it not be now as in former times, when the mark was not simply the signature of the merchant or manufacturer, but also a certificate of quantity, given by public authority, touching the quality of the produce, its origin, weight, &c.? [1]

§ 28. Trade-marks are assuming increased importance from the fact that in Europe there is a growing tendency to abolish or greatly restrict the granting of patents for inventions and discoveries. This question of political economy has so far prevailed that in the empire of Germany, in Belgium, and in other countries, official inquiries are being made as to the working of the patent laws and their effect upon the general welfare, many statesmen and jurists believing that the system of monopolies, as they miscall it, has not met the expectations of the law-makers. In Holland, we

[1] Journal Soc. Arts, vol. vii. p. 262.

are informed, both legislative chambers have abolished the system entirely, the votes lacking but two voices of unanimity. Although such retrogression cannot be expected to occur in this developing country, with its myriads of ingenious artisans and earnest explorers of the inmost recesses of nature, minds intent upon releasing the human frame from the thraldom of drudgery, it is well to know what other nations think and do. It may be that in those countries labor is so cheap that human muscle and life rate with those of the beasts that perish. Be that as it may in regard to artificial property like patents, the rights of manufacturers and merchants rest on exterior signs, which have for an object to make known their industries and the products thereof. Lawful competition is open to all. All that is demanded is that encroachments upon the business-mark of another be prohibited. The Master of the Rolls, in *Croft* v. *Day*,[1] said: "The principle in these cases is this, that no one has a right to sell his own goods as the goods of another."

§ 29. The world-renowned Wedgwood produced many fine pieces of work, which only his master-hand could afterwards improve. He did not patent his inventions, but with a consciousness of his own superiority — which he ever maintained — he permitted all other potters to follow as nearly as they could in his footsteps. His trade-mark was ample protection, and indeed was more efficacious than any patent could be, unless we consider that he did possess an unencroachable patent, — that bestowed by excellence itself. By means of his symbol he secured a full reward for his industry, his toil, his genius. With the largest manufactory of china and queen's-ware in the known world, he could safely rely on this trade-mark to point out to the people of all countries the goods in which he so successfully combined the useful, the ornamental, and the ingenious.

[1] 7 Beav. 84.

§ 30. **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. This is a definitively-settled rule. We must not, however, dismiss this rule from further consideration until we are sure that we comprehend the scope of this brief enunciation. To speak more plainly, the mere fact of fraud upon the public will not induce a chancellor to interfere unless the plaintiff has sustained, or there is good reason to believe that he will sustain, pecuniary damages. Imposition on the public becomes the test of the property in a trade-mark having been invaded and injured, but it is not the ground on which the court rests its jurisdiction.[1]

§ 31. The Lord Chancellor, in *Spottiswoode* v. *Clark*,[2] in 1846, said that "These cases depend so much upon their own circumstances, that all that the court can do is to lay down principles under which such cases may fall. I have before this had occasion to express an opinion, that, unless the case be very clear, it is the duty of the court to see that the legal right is ascertained before it exercises its equitable jurisdiction. For this there are good reasons. The title to relief depends upon a legal right, and the court only exercises its jurisdiction on the ground that that legal right is established. Our objection to granting an injunction, in the first instance, is, that it promotes after-litigation. The order either grants an injunction, and compels the plaintiff to bring his action, or suspends the injunction, with liberty to the plaintiff to bring his action. If you compel him to go to a court of law, you promote litigation; and this course is forced upon parties when their feelings are deeply engaged in prosecuting their imaginary rights. There is also another objection, which is, that the court expresses a strong opinion, and it ought to be a strong opinion, and then sends the right to be tried. I think it better that the court should abstain from expressing such an opinion. But, after

[1] Lord Chancellor, in Leather Cloth case, 11 Jur. (N.S.) 513.
[2] 10 Jur. 1043.

all, the chief objection is, that the court runs the risk of doing the greatest possible injustice."

§ 32. When a person has adopted and used a particular mark, to indicate to those who deal with him that an article is manufactured or sold by him, or by his authority, others have no right, without his assent, with the view of deriving advantage from the same, to use such mark without change, or even with such colorable difference as is calculated to deceive the proprietor's customers, or the patrons of his trade or business. Such mark, when it has become known, is a species of property; and its owner will be protected against the attempt of others to appropriate to themselves, by its use, the benefit which such is entitled exclusively to enjoy. But there can be no harm done to the owner of which he has the right to complain, unless his trade-mark be appropriated without change, or unless it is simulated in such a manner as probably to mislead his customers, or the patrons of his trade or business, inducing them to suppose that in purchasing the article marked, they are purchasing that manufactured or sold by such owner.[1]

§ 33. It is frequently a difficult matter to determine what is an infringement. The two marks, which are supposed by the plaintiff in a case to conflict, may resemble each other, and yet be different. The question then arises, Is the difference only colorable? No general rule can be laid down as to what is or what is not a mere colorable variation. All that can be done is to ascertain, in every case as it occurs, whether there is such a resemblance as to deceive a purchaser, using ordinary caution.[2] In the case of the Leather Companies, in the House of Lords, in which remarks as follows were made, it was further said by Lord Cranworth for the court that in that case the difference was so palpable that no one could be deceived. "In the first place, the shape is different. The plaintiffs' trade-mark, if trade-mark it is to be called, is contained in a circle. The design of the defendants is a

[1] Partridge *v.* Menck, 1 How. App. Cases, 558.
[2] Lord Cranworth, 11 Jur. (N.S.) 513.

semicircle mounted on a parallelogram. It is said that the defendants' goods may be so rolled as to expose only the semicircle, and so lead to the belief that the device, in its integrity, is a circle. There might, however, be some force in the observation if the upper half were the same as, or even if it closely resembled, the upper half of the plaintiffs' device. But this is not so. The name of the company is different. The word 'Crockett' is prominently exhibited twice in the plaintiffs' upper half, not once in the defendants'. No one taking the trouble to read the two can say that he would be deceived."

§ 34. The ownership is allowed, that one may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public, as his, that which is not his. An imitation of his mark, with part differences, such as the public would not observe, does him the same harm as an entire counterfeit. If the wholesale buyer, who is most conversant with the mark, is not misled, but the small retailer or consumer is, the injury is the same in law, and differs only in degree. The right of action must exist for the last, as well as the first. If all consumers do not discriminate in the end, it would be indifferent, even to the wholesale buyers, from which of two they bought, and thus the extent of the injury would be as great as if they also were deceived.

§ 35. The question is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he now puts his trade-mark, or whether the article made and sold by the defendant under the complainant's trade-mark is an article of the same quality or value. But the court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade or business; and that having appropriated to himself a particular sign or mark, indicating to those who wish to give him their patronage that the article is manufactured and sold by him, or by his authority, or that he carries on business at a particular place,

he is entitled to protection against a defendant who attempts to pirate upon the good-will of the complainants' friends or customers, or the patrons of his trade or business, by sailing under his flag, without his authority or consent.[1]

§ 36. **The Public should be protected.** — Mr. Justice Duer, in his very able opinion in the case of the *Amoskeag Manuf. Co.* v. *Spear*,[2] enunciated as one ground for protection the benefit to the public at large. The plaintiff's trade-mark is an assurance to the public of the quality of the goods, and the pledge of his own integrity in their manufacture and sale. To protect him, therefore, in the exclusive use of the mark that he appropriates, is not only the evident duty of a court, as an act of justice, but the interests of the public, as well as of individuals, require that the necessary protection should be given. Brady, J., in *Matsell* v. *Flanagan*,[3] said 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 or symbols, in such manner as may deceive them, by inducing to the purchase of one thing for another. He took the extreme ground that it is not necessary to the exercise of judicial powers that the plaintiff should have any other property in the name used than that possessed by other persons. He said that there is neither honesty nor honorable competition in adopting, for a similar purpose, a name used by another, if it be employed in such a manner that the public may be imposed upon; and such a result must follow if the simulation be so successful that one article or creation is purchased or accepted for another. He regarded those principles as established by the adjudged cases of both England and this country. Robertson, C. J., in *Swift* v. *Dey*,[4] — which was a controversy in

[1] Chancellor Walworth, Partridge *v.* Menck, *supra*.
[2] 2 Sand. S. C. 599.
[3] 2 Abb. Pr. R. (N.S.) 459.
[4] 4 Robertson, 611.

regard to a trade-mark on match-boxes, — said that is eminently a question of fact, to be submitted to the practical experience of a jury, whether in a particular case a resemblance was likely to deceive the community. There is no article of more general consumption, less value, or more frequently bought by ignorant or careless purchasers, than friction-matches; none, perhaps, where their degrees of excellence are more widely apart. In such a case, the general appearance of whatever is adopted as a trade-mark must control; because it is the unwary, and not the wary, who are to be protected, as most likely to be taken in by its counterfeits. Bosworth, J., in *Gillott* v. *Kettle*,[1] said that the fraud complained of consists in selling an inferior article of the plaintiff's manufacture as being one of a superior quality. The fraud, to the extent that it may be successful, is twofold: the public is defrauded by being induced to buy the inferior for the superior article; the plaintiff is defrauded by an unjust destruction of confidence that his pens are put up for sale, and assorted, with reference to the quality, indicated to dealers by the labels on the boxes which contain them. By such a practice the defendant *endeavors* by a false representation to effect a dishonest purpose: he commits a fraud upon the public and upon the manufacturer. The purchaser has imposed upon him an article that he never meant to buy, and the manufacturer is robbed of the fruits of the reputation that he had successfully labored to earn. In such a case, there is a fraud coupled with damage; and a court of equity, in refusing to restrain the wrong-doer by injunction, would violate the principles upon which a large portion of its jurisdiction is founded, and abjure the exercise of its most important functions, — the suppression of fraud and the prevention of a mischief that otherwise may prove to be irreparable. This language — which has the ring of the true metal — is substantially that of Duer, J., of the same court, in the Amoskeag

[1] 3 Duer, 624.

case.[1] Fraud and damage resulting therefrom always entitle the injured party to relief; provided, of course, that he come into court with clean hands. The public, as an innocent party, — for a party it must be considered, although not directly on the record, — should be sedulously guarded by the action of the tribunal which holds the culprit within its grasp. Duer, J., in the Amoskeag case, said, that it is the evident duty of a court as an act of justice, and the interests of the public as well as of the individual purchasers require, that the trade-mark be protected. This does not operate as an injurious restraint upon the freedom of trade. Its direct tendency is to produce and encourage a competition, by which the interests of the public are sure to be promoted, — a competition that stimulates effort, and leads to excellence, from the certainty of an adequate reward. Vice-Chancellor Sandford, in *Coats* v. *Holbrook*,[2] laid considerable stress upon the duty of protecting the public as well as the complainant from the consequence of barefaced roguery; and Story, J., in *Taylor* v. *Carpenter*,[3] was no less emphatic; and Sandford, Ch., in *Snowden* v. *Noah*,[4] said that the injury for which redress is given in such cases results from the imposture practised upon the customers of an existing establishment, or upon the public. But we need not multiply instances to prove that courts will habitually regard the interests of the public at large, in acting upon particular cases, or applying the rules of justice to an individual wrong-doer.

§ 37. In the *Dixon Crucible Co.* v. *Guggenheim*[5] case, Paxson, J., remarked that "the jurisdiction of chancery in trade-mark cases attaches because of the injury to the one whose goods are simulated, by interference with his profits, not because of the deception upon the public. The fraud upon the public will not induce a chancellor to interfere, unless the plaintiff has sustained, or there is good reason to believe he will sustain, pecuniary damages."

[1] 2 Sand. S. C. 606. [2] 2 Sand. Ch. R. 586.
[3] 3 Story, 458. [4] Hopkins, Ch. R. 347. [5] 2 Brewster, 321.

§ 38. In *Comstock* v. *White*,[1] Sutherland, J., said, on the other hand, on a motion to dissolve an injunction: "As to the public, if these pills are an innocent humbug, by which both parties are trying to make money, I doubt whether it is my duty, on those questions of property, of right and wrong between the parties, to step outside of the case, and abridge the innocent individual liberty which all persons must be presumed to have in common, of suffering themselves to be humbugged." It did not appear that the pills were positively injurious. Hoffman, J., in *Fetridge* v. *Merchant*,[2] said the question of fraud by means of a false mark should be judged of solely as between the immediate parties, and that the public should be left to its own guardianship.

§ 39. James, J., in the case of the *Congress and Empire Spring Co.* v. *High Rock Congress Spring Co.*,[3] said that the doctrine of protection to trade-marks is now well established. The principle which underlies the doctrine is, that he who by his skill, industry, or enterprise has produced or brought into market or service some commodity or article of use, convenience, utility, or accommodation, and affixed to it a name, mark, device, or symbol, *which serves to designate it as his*, is entitled to be protected in that designation from encroachment, so that he may have the benefit of his skill, industry, or enterprise, and the public be protected from the fraud of imitators.

§ 40. An able French writer[4] remarks that it is clear that the fabricant who by the superiority of his products, or by the cleverness of his manufactures, has acquired a merited renown, has a great object in investing with his mark articles of his make, to the end that such mark, which certifies them to the preference of the public, may thus secure an assurance and facility of sale. It is clear that he who sees his mark sought for by the public, finds, in his own interest, strong reasons to

[1] 18 How. Pr. R. 421. [2] 4 Abb. Pr. R. 156.
[3] 57 Barb. 526; 4 Am. Law Times R. (St.) 168.
[4] Annales de la Prop., tome iv. pp. 19, 20.

make incessant efforts of intelligence, and of obedience to law, to conserve to himself the preference accorded to him. It is manifest, also, that the example of marks honored, eagerly looked for in commerce, and becoming for their possessors a source of fortune, is for others a powerful incitement to walk in the same path. But on what condition shall industry really find such signal advantages? On the condition that such marks shall be truly and efficaciously protected by the law; that the manufacturer shall find entire security in the use which he shall make of his mark; and finally, that he shall receive from the law sufficient guaranties for reclamation against the counterfeiter.

§ 41. In the House of Lords,[1] in 1865, Lord Kingsdown said: "The fundamental rule is, that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot, therefore, in the language of Lord Langdale in the case of *Perry* v. *Truefitt*, 'be allowed to use names, marks, letters, or other *indicia*, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.' A man may mark his own manufacture, either by his name, or by using for the purpose any symbol or emblem, however unmeaning in itself; and if such symbol or emblem comes by use to be recognized in trade as the mark of the goods of a particular person, no other trader has a right to stamp it upon his goods of a similar description. That is what I apprehend is usually meant by a trade-mark, just as the broad arrow has been adopted to mark government stores; a mark having no meaning in itself, but adopted by and appropriated to the government."

§ 42. **Wherein consists the Wrong in using the Trade-mark of Another.** — It is not in imitating a symbol, device, or fancy name, for in such act may not be involved the slightest turpitude. The wrong consists in unfair means to obtain from a person the fruits of his own ingenuity or industry, an injus-

[1] The Leather Cloth Co. *v.* The Amer. Leather Cloth Co., 11 Jur. (N.S.) 513.

tice that is in direct transgression of that command of the Decalogue: "Thou shalt not covet . . . any thing that is thy neighbor's." The most detestable kind of fraud underlies the filching of another's good name in connection with trafficking.

§ 43. A perfect system of trade-marks is ascribed by Jobard to the Chinese. They excel in this institution of commercial guaranty; for nearly all the goods exported from China are enclosed in boxes hermetically fastened by paper bands, and have upon them the mark of the makers. Every thing is stamped and indorsed with the firm and title of the furnisher, who is responsible for the quality of the contents of the packages bearing his name. A cargo of tea arrived one day from Canton at London, when it was found that the boxes were filled with nothing but rice-straw. The vessel and cargo were immediately sent back to China; the Hongs were speedily assembled, and recognized each their own marks. It was ascertained on examination that the adroit thieves, who had been employed to convey the tea from the warehouses to the ship, had slipped off with the chests to an island, and had there opened them, and for their precious contents had substituted packages of rice-straw. To preserve their commercial reputation, the Chinese merchants gladly made good the loss.

§ 44. In connection with patents and some other kinds of property, resemblance may be the result of accident, or of an honest difference of opinion; but in conflicts arising out of the invasion of proprietary marks, resemblance may generally be traced to meanness and cupidity. Truly did Senator Lott say in one case:[1] "A disguise is not generally assumed for an honest object. It is a mark more characteristic of deception and fraud. It defeats the very end and object contemplated by legitimate competitors, — the choice to the public to select between the articles for sale, — and operates as a deception and imposition on the dealer." He might have

[1] 11 Paige, 292.

further said that nearly always it is a witness against him who uses it.

§ 45. **Foundation of Title.** — Having satisfied our mind that the conventional sign of trade has a history, and an acknowledged right to protection, we next inquire upon what laws does the claim to property in it rest. How does the owner of a trade-mark obtain his exclusive right to its use in a particular manner, *i.e.*, in connection with certain articles of merchandise? Is it by act of law, vesting in him the sole right of user, or is it by mere volition? Let us attempt to answer.

§ 46. The right to a trade-mark is neither tangible nor visible, though the thing produced from the right is perfectly so. The subject-matter is not the symbol, but the exclusive privilege of continually using the same to impress or otherwise mark articles of merchandise, so that purchasers may instantly know the origin of such articles. Just as a person may by his autograph indicate his workmanship, or his ownership, so may he by any other sign as a substitute therefor do the same. The right to write one's name on a piece of personal property is a natural right; so, therefore, must be the right to use its substitute, any other emblem. This right is founded upon possession: and his possession rests upon the mere act of adoption and use; for, in contemplation of law, without use there is no adoption. That this is the true doctrine we may easily convince ourselves by reference to judicial decisions.

§ 47. Rhodes, J., in delivering the opinion of the Supreme Court of California in *Derringer* v. *Plate*,[1] in 1865, said: "The right of property does not in any manner depend for its inceptive existence or support upon statutory law, although its enjoyment may be better secured and guarded, and infringements upon the rights of the proprietor may be more effectually prevented or redressed by the aid of the statute than at common law. Its exercise may be limited or con-

[1] 29 Cal. 292.

trolled by statute, as in case of other property; but, like the title to the good-will of a trade, which it in some respects resembles, the right of property in a trade-mark accrues without the aid of the statute." The learned judge was discussing a local statute of his State, but the principle is quite as broad as he stated it. He further said that "the proprietor may assert and maintain his property-right wherever the common law affords remedies for wrongs." He might have put it more strongly, and have said that the right to the exclusive use of a man's commercial signature, or its analogue, the trade-mark, exists throughout the world. It is true that a remedy is not always promptly accorded, owing to the narrow jealousies of various nations in affording undue protection to their own manufactures and commerce; but the *right* is recognized. A foreigner's property in a promissory note, or any other kind of personal property, may be admitted; but the courts are shut to him as an alien, non-domiciliated. In this illiberal spirit some European nations have striven to extort reciprocity and privileges for their own citizens or subjects. Nevertheless, their conduct cannot affect the natural right.

§ 48. In the Court of Paris, in 1863 (*Aubertin* v. *Vix et al.*[1]), the court held the same doctrine, and said: The deposit of a mark of commerce is not necessary to acquire, and even conserve, the property of the mark; although the deposit is indispensable to enable one under the law of the 27th of June, 1857, to obtain the special guaranties which it institutes, and of the actions which it organizes. The same court, the next year, recognized the same doctrine, in *Stubs* v. *Astier et als.*;[2] and the Court of Cassation, by its final judgment on appeal, effectually shut the door in the face of confessedly just claims, for the reason of alienage alone.

§ 49. The Court of Cassation, in 1864 (*Leroy* v. *Calmel*[3]), held that the deposit does not constitute the exclusive right to the property of the mark; that deposit is necessary only for

[1] Annales de la Prop., etc., tome xi. p. 344. [2] Ibid., tome x. p. 212.
[3] Ibid., tome x. p. 193.

the purpose of enabling the proprietor to sue for damages for infringement; and that it was necessary to search whether the mark in controversy did not exist at a period anterior to that of deposit. Nothing can be plainer than this enunciation of the supreme court of France. The right to a thing may be perfect; but the right to claim reparation for an encroachment upon that right may not have any foundation!

§ 50. The Court of Paris, in 1867, in *Sargent* v. *Romeu*,[1] said that in ancient legislation as well as in the new, the legal deposit of marks was simply declarative, and not attributive; consequently, a deposit merely creates a presumption of proprietorship. In the same court, in 1868 (*Holtzer & Co.* v. *Lendenberg & Co.*[2]), it appeared that the plaintiffs, proprietors of certain steel-works in France, had ever since the year 1834 been using as a trade-mark the figure of a bell, and their products became known under the name *aciers à la cloche* (bell-steel), and acquired a reputation for superiority. After the treaty of 1862, between France and the Zollverein, the Prussian manufacturers, Lendenberg & Co., established a warehouse in Paris, near that of Holtzer & Co., and their wares were also marked with a bell. Holtzer & Co. sued them for infringement of their trade-mark. The Prussian house thereupon established the fact that ever since 1817 they had marked their products with the same device, and invoked on their behalf the benefit of the treaty aforementioned. They did not rest their claim to the exclusive right of user upon aught but possession. It was held that by virtue of the said treaty they had a right to prove their priority; and the court awarded them 300 francs as damages, and condemned the defendants to pay all the costs. The case was thereupon appealed. The appellants' counsel argued, *inter alia*, that the respondents' firm had not enjoyed any reputation in France until very recently; that it was not shown that their firm was established in France until after the date of the treaty; that therefore their title should not be per-

[1] Annales de la Prop., etc., tome xiii. p. 21.

[1] Ibid., tome xiv. p. 167.

mitted to conflict with one that had a recognized popularity ever since 1834; and that, in fact, their manufactures were inferior in quality to those of the appellants, as was shown at the Great Exposition, where they got nothing, while Holtzer & Co. received a gold medal. The respondents' counsel argued that they were the seniors in their line of business; that the possession of their mark had constantly been maintained in Germany, and was proven by all the documents that could possibly be procured in a country where property in emblematic marks was not regulated by law; that their possession was established as far back as 1817; and that their long user was conclusive, the act of deposit not being declarative of property, and not attributive of a new right. He further claimed judgment, irrespective of the said treaty, by the French law of 1857 (the sixth article of which provides that a foreigner whose establishment is outside of France, is admitted to enjoy the benefit of the law of deposit, if in the country where his establishment is situate diplomatic conventions had arranged reciprocity for Frenchmen). Concerning trade-marks the treaty says that "the subjects of each of the contracting states shall respectively enjoy in the other the same protection as the natives thereof." Therefore, Lendenberg & Co. had a right to invoke the protection of the French laws, the same as if they were French themselves; that by the law of 1857 the deposit of a trade-mark is not attributive, but simply declarative of property in that mark; that, in other words, the ownership of a trade-mark did not depend upon deposit, but that property existed independent of any species of deposit, although by not depositing one ran the risk of a use by others. Finally, Lendenberg & Co. had a pre-existing right: the treaty gave a remedy. The court concurred in these views as matters of law.

§ 51. The question thus raised was assuredly one of a most delicate and difficult nature, involving the effect of a treaty, affecting the rights of citizens of another country to

a mark long used, and to which up to the time of the treaty they had the sole right of protection. But for our present purpose, it is necessary only to cite it as authority for saying that a trade-mark is not the creature of arbitrary law. That point has been affirmed in other French cases, and may be said to be definitively settled. And this is the recognized law of all civilized nations. The Tribunal of Commerce of Geneva, in 1859 (*Christofle & Co.* v. *Deleiderrier*[1]), held that a manufacturer's mark is property under the law of nations; and other nations by their judicial decisions have repeatedly affirmed the same doctrine, one founded upon sound reason. Thus, in 1855,[2] the tribunal of Brussels held that a Frenchman, domiciled in Paris, might in a Belgian court pursue an infringer of his mark, although the plaintiff had no treaty to stand upon, and based his claim to his mark upon the law of natural justice.

§ 52. **What Time is required for the Perfection of Title.**— That is, how long does it take to adopt it? The answer is obviously this: The moment one who has selected a symbol to indicate his merchandise applies the mark to his goods, the act is complete. The avowal of his intention to adopt, his registration of the mark, and notice to the whole world, do not constitute adoption; but apply the mark to the articles for sale, and, *eo instanti*, the act is complete. In *McAndrew* v. *Bassett*,[3] the right of the plaintiff was disputed because of his recent appropriation of the symbol to stamp his liquorice, just as a claim based upon mere prescription might be challenged. The Lord Chancellor said that he had been much pressed by the defendants' counsel to declare that there was not sufficient time between the termination of the month of July and the 13th of September following for the plaintiffs to acquire a right of property in the particular trade-mark. The substance of the argument of defendants is this: that, supposing the court interfere upon the ground of property in a trade-mark, that

[1] Annales de la Prop., etc., tome vi. p. 29. [2] Ibid., tome i. p. 45.
[3] 10 Jur. (N.S.) 550.

property must be regarded as the offspring of such an antecedent user as will be sufficient to have acquired for the article stamped general notoriety and reputation in the market, and that the property cannot be held to exist until the fact of the general user, that notoriety and that public reputation have been proved to exist. The plaintiffs won.

§ 53. **Who may acquire Property in a Trade-mark.** — As a general proposition, any person who, in law, is capable of acquiring and holding any species of property, may hold a title to a trade-mark.

§ 54. Yet this sweeping assertion must be subjected to some qualification ; for unless the person be a trader, that is, unless he or she be engaged in mercantile business of some kind, such a title could not be acquired, as we shall hereafter more clearly see. The reason of such a condition is this: the object selected as a trade-mark does not become such by the mere act of selection. Something more is requisite to perfect an act of adoption. What is that something ? It is the union of the abstract representation of the object with a vendible commodity. Instantly the inchoate right becomes perfect, and title rests in the appropriator.

§ 55. But we shall see that certain persons cannot become traders, and consequently cannot place themselves in a position to obtain such a title. Take as an extreme hypothesis the case of the person holding the office of Archbishop of Canterbury. He could not become possessed of a title to a trade-mark, for the law inhibits him from engaging in secular pursuits of a mercantile nature. A corporation is an artificial person, and under an act of Congress of July 8, 1870, the right of a corporation to a trade-mark is distinctly recognized. But, when we come to consider the provisions of that act, we shall be easily convinced that it is not every corporation that can avail itself of the protection promised thereby. Why ? Because the corporation may not be a trading corporation. For instance, a rector of a parish in Massachusetts, New York,

Maryland, and other States where the Church of England once held legal sway, is a corporation sole. Yet no sane person would dream of such a corporation, or any other of a purely ecclesiastical nature, manufacturing or selling goods.

§ 56. Nor can every natural person hold title in a trade-mark; for some persons are under interdict, — are felons under sentence of death, or are not of sound mind. This phase we shall also more fully investigate hereafter.

§ 57. The conditions upon which a right can be enjoyed and guaranteed are few and simple. Be he citizen or alien, the owner has protection provided he is engaged in lawful business, conducted with sincerity.

§ 58. **Who is an Infringer.** — He who imitates in whole or in part the peculiar emblem or mark to which another has the right of exclusive use, *provided* he use it to indicate the same class of goods. The imitator may be the pirate himself, or he may be an innocent vendor of the article bearing the mark. Both are in intendment of law infringers, although the one may be guilty of gross roguery and the other be free from the imputation of turpitude. The law will correct the illegal act of either, but will deal more leniently with the unintentional trespasser.

§ 59. So similar in external appearance are different articles of merchandise, that, without peculiar indication of some kind, one would be in uncertainty. Some pledge of integrity is demanded. We see a curious mark: it is enough — it conveys to the mind full assurance of excellence, or what we are happy in believing to be such. Some such guaranty is required in these days when traffic moves swiftly, in harmony with agencies of steam and electricity. A glance! It is enough. Down goes the cash, and the change is effected. But what if the signal with its blazon of truth be false! Confidence is outraged, — and that is a thousand-fold worse than the immediate loss of money, for a scar of suspicion is left. Severe measures must be enforced to restrain the commission of crime which

has no small resemblance to that of wretches who display false signal-lights. Avarice and treachery! Piracy must be restrained by the iron grasp of justice, that laudable industry may flourish, and competition, the life of trade, be stimulated to ever-fresh efforts for excellence. An adequate security and protection may be found in the extension of the powers of courts of justice in the endeavor to uphold a high mercantile morality. In this there is no restraint of the freedom of trade, no fostering of monopolies. Each man stands upon his own merits, just as a knight at a tourney has his own color to identify him with valor and high emprise. Infamy would await the base dastard who took the pennon not belonging to him. So should it be in the mammoth contest for the well-earned meed of honorable and laborious enterprise.

§ 60. **Protection.** — What avails a mere naked title to any thing, unless the law protect it! Any man may copy an emblem or a mere representation of an object, — no matter whether it be of the rudest character or whether it be delineated with all the grace and beauty of accomplished art, — unless the exclusive property in it be secured by local law in another person. We say *local*, for a right to exclusively make and sell a representation of an object, or a fanciful picture, or other mark of taste, rests upon nothing more extensive than the laws of the country which has invested it with the ægis of defence. One nation does not respect the defensive law of another in respect to such work of art, unless bound to do so by a treaty or compact. The people of one country, then, may with impunity prey upon the people of any other in respect to works of genius, unless, upon the condition of reciprocity, mutual forbearance shall have been stipulated. This reflection begets an idea!

§ 61. It is not the act of *imitating* that is unlawful in regard to a trade-sign or mark. Then what is the wrongful act? It is this: the placing of that mark upon vendible goods, for the purpose of fraud. For *fraud*, actual or constructive. Of this

species of cheating, furtive and mean, the honest, the confiding, are the victims. But then the law protects the innocent against fraud? Yes! Now we perceive that fraud is the basis of the law's intervention: that kind of fraud which a person practises when he writes or paints or stamps or brands a certain sign upon articles for sale, with the design that the public shall take them to be the manufacture of some person else, or to have emanated from some place which is not the true one. This is a matter of property. A trader's business fails because another trader has illicitly copied his mark of honest dealing. He loses what should come to him as just profits, and the purchaser is deceived into paying for a false article. A double wrong is done. Unless the law intervene to preserve the credit of the mark, all faith in its integrity shall soon be destroyed. Commerce is wounded. Real tangible rights are struck at: money is lost. That in the eye of the law, as administered, is a greater wrong than to kidnap and sell the children of another's brain. *Property* has been despoiled, and that by the simple act of causing a certain symbol to utter a falsehood. Property must be protected.

§ 62. **Whose Rights are protected?** — Those of the manufacturer or merchant who has lost his just profits, or of him who has been cajoled out of his money? or both? We must examine into the theory of protection; for upon a right understanding of it frequently depends the possibility of redress.

§ 63. When we look at the case in Cro. Jac.,[1] we find that, for an imitation of a mark placed upon cloth, an action upon the case was brought *by him who bought the cloth*, for deceit, which action was adjudged to be maintainable. In *Southern* v. *How*,[2] which is believed to be the same case, a different version is given. In Comyn's Digest, "Action on the case for deceit," A. g., the case is thus cited: "So" (*i.e.*, an action will lie) "if a clothier sell bad cloths upon which he put *the mark* of another who made good cloths." Comyn does not say

[1] Cited by Upton, p. 10.

[2] 2 Popham, 144.

by whom the action may be maintained; but as he cites Cro. Jac. only, it may be inferred that he considered the case as establishing the right in the *purchaser*, which it certainly would, if that report is correct. In *Southern* v. *How* the case is certainly cited as a distinct affirmance of the right of a manufacturer to maintain an action for an unauthorized use of his trade-mark. Lord Rolle, however, expressly states that "Doderidge did not *say* whether the action was brought by the clothier or by the vendee;" but he adds, "semble que gist pur le vendee" (2 Roll. 28). Therefore, if we depend upon the old books, we are left in doubt as to who is the protected party. But, fortunately, the question may be said to be settled in these days; although in the minds of some chancellors there is a lingering doubt whether the public have any right to protection in such a case.

§ 64. We may safely assume that it is the moral, if not the legal, duty of a court to protect the public against fraud, perpetrated by means of false tokens. The maxim quoted by Lord Cranworth in the case of the Leather Companies[1] — "Vigilantibus non dormientibus leges subveniunt" — is not always approved doctrine; for not only the watchful but the careless should be guarded against wily craft and cunning. The morals of a nation are like those of an individual: they must be guarded by the supervising power, whatever that may be. In this matter it is the court of justice trying the question of infringement upon a mark of trade. The law of gravitation seems to operate in morals as in physics; there is an increased momentum at every stage of descent. Of this we have had melancholy proof in recent developments in some portions of our country, where corruption soiled even the ermine of the judge. When we read of excessive stickling for legality, we are apt to suspect that moral obligations have not due weight. When a rogue stands convicted of his offence, why not punish him to the extent of his merits? In trade-mark

[1] 11 Jur. (N.S.) p. 513.

cases there is a great laxity; as if the community at large had no interest in the upholding of mercantile honor. Spasmodic pretences to severity do not help the matter. Let punishment be sure, like the bodily pain which follows every excess as a manifestation of Divine will, and fraud must decrease. Whether by corporal pain or pecuniary mulct, the effect would be beneficent. The law should protect the weak and the simple.[1] Is the child or the illiterate clown to be plundered at the will of any charlatan or knave? Is the law to lend its aid only to the vigilant, who require it not? It must be that the exponents of justice have sometimes, by mistaking the intent of the law, become false oracles. If the reasoning sometimes used is good in one case, then why not in another? If the confiding purchaser of wares may be cheated with impunity, why not also suffer the pickpocket to ply his craft unmolested against the youthful, the thoughtless, the unsuspecting? Would it be a good defence for a vendor of brass watches bearing the mark of the American, the Elgin, or any other reputable watch company, to plead that prudent examination would have detected the fraud? Verily not. Does one prudent person in a thousand keenly scrutinize each article he buys? What percentage of ordinarily cautious persons closely examine the printed national currency, to see that it bears all its legitimate marks? We come to the conclusion that the rule of *caveat emptor* should be changed into *caveat venditor*, demanding sincerity in the seller, rather than extreme caution in the purchaser.

§ 65. There seems to be a contrariety of opinion among judges, both in law and equity, as to the real principle upon which is founded the duty of judicial intervention. Some judges, remarkable for probity in private life, appear to permit the ermine to stifle sentiments of the nobler morality, and to deal with the rigid letter of the law, rather than with its equitable spirit. They base their action entirely upon the legal

[1] See opinion of Kindersley, V. C., in Glenny *v.* Smith, 11 Jur. (N.S.) 964.

right of the party complainant, and treat as a matter of little or no consequence the fact that the public at large have some right to protection. Conceding that a court cannot go outside of the immediate case presented, is it not true that the rights of the public may be guarded and vindicated by holding the simulator of trade-marks to a rigid responsibility? Woodbury, J., in one case,[1] uttered the true doctrine: "To elevate our own character as a nation, and the purity of our judicial tribunals, it seems to me we ought to go as far in the redress and punishment of these deceptions as can be vindicated on any sound principle." Robertson, J., in the case of *Corwin* v. *Daly*,[2] said that "the origin of the favor shown to trade-marks was the protection of the public, and not merely of the individual dealer;" and in speaking of the scope or design of a bill in chancery, invoking protection for honest trade, Lott, Senator, said: "Its object is to prevent the commission of a fraud not only on them and to the prejudice of their rights, but on the public, by the sale of an article with an imitation of their trade-mark thereon in such a manner as to deceive purchasers, and through the false representations thus held out, to deprive the owners thereof of the profits of their skill and enterprise. Honest competition relies only on the intrinsic merit of the article brought into the market, and does not require a resort to a false or fraudulent device or token."[3] "It is undoubtedly the duty of courts to regard with disfavor every establishment having any tendency to corrupt the public morals, to create idle or dissipated habits, to encourage a craving for undue excitement, or to impair the taste for domestic attachments and domestic society," said another judge.[4]

§ 66. **Class of Goods.** — Protection will not be given unless in connection with the *class of goods* to which the mark has been applied. Vice-Chancellor Wood,[5] in 1865, remarked that

[1] Taylor *v.* Carpenter, 2 Wood. & M. 1. [2] 7 Bos. 222.
[3] Taylor *v.* Carpenter, N. Y. Ct. of Errors, 11 Paige, 292.
[4] Christy *v.* Murphy, 12 How. Pr. R. 77.
[5] Ainsworth *v.* Walmesley, 44 L. J. R. 252.

the court had 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* 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."

§ 67. As the first adopter of a mark does not acquire any exclusive right to its use, except in connection with the specific class to which he has applied it, it is not uncommon for the same mark to be placed upon different classes by different owners. The word "MAGNOLIA" may properly serve to indicate a certain manufacture of *gin* for one proprietor,[1] and a certain brand of *whiskey* for another;[2] for although both contain a large proportion of alcohol, the fluids cannot be said to belong to the same class; and the fanciful appellation of "BISMARCK" may in compliment to the statesman be used for *cement*,[3] notwithstanding the fact that another had previously appropriated it for *paper collars*.[4]

§ 68. The importance of a specific mention of the class of merchandise to which a certain emblem is to be attached as a trade-mark, may be illustrated by the letters "I X L" (*I excel*). To guard against looseness in practice, the statute requires that the class, "and the particular description of goods comprised in such class," shall be set forth in the application.

[1] C. & W. A. Waters, No. 544. [2] Mills, Johnson, & Co., No. 241.
[3] Wendt & Rammelsberg, No. 585.
[4] Messerole *v.* Tynberg, 4 Abb. Pr. R. (N.S.) 410, and 36 How. Pr. R. 14.

Time out of mind, the manufacturing establishment of Wostenholm, in England, has used the letters I X L upon cutlery. The exclusive right to the use of that symbol had at common law become vested in that firm, — so far as it was actually stamped upon certain articles. It could properly have been appropriated for marking all kinds of cutlery, fine and common, large and small. The mark was known all over the world, and by it was understood that the house of Wostenholm had manufactured the steel fabrics thus stamped. The Examiner was well aware of the existence of that mark, and recognized its import. It was his duty to refuse registration to any one else who claimed property in that mark, as applied to the particular class of goods made and so marked by the English house. It did not matter that no official notice of the use of the mark in a foreign country had been filed. It was enough that a claimant must have been the prior adopter of it.

§ 69. An American firm, doing business at Evansville, Ind., applied for registration of that mark for a *chopping-axe*. They did not pretend to have adopted the symbol before the year 1870, many years after it had acquired a universal reputation through the English firm of Wostenholm. *Held*, chopping-axes are not included in the particular class of goods in which the Wostenholms used the mark. Registration allowed.[1]

§ 70. In January, 1872, Wostenholm & Son, of England, filed an application for the registration of the said symbol, "I X L," as a trade-mark for *cutlery*. They set forth the long term of years during which their firm had used it for the same purpose. The certificate of registry was duly issued.[2] In March, 1872, a manufacturing company in Hartford, Conn., filed an application for a mark, newly adopted, of which the said symbol is the essential part. It was to be applied to scythes. The case was suspended until evidence was furnished that the English firm of Wostenholm did not make scythes. The adoption by the Hartford company was

[1] Boetticher, Kellogg, & Co., No. 83. [2] Wostenholm & Son, No. 666.

therefore lawful, and the mark was registered for the third time.[1]

§ 71. **A Lack of Truth** debars a trade-mark from protection. The tale told by the symbol must be sincere. The instant it ceases to be truthful, in spirit as well as in letter, it becomes an instrument of fraud, and is not lawful. A qualification, true in itself, may become fraudulent by the manner in which it is used. In a case before the Tribunal of Correction of Thionville,[2] in 1865, it was *held*, where a French gunmaker establishes himself and his manufactory in a foreign country, and places his name on his products as "of Paris," although really a Parisian, it is bad faith in him. His intention was evidently to cause purchasers to believe that he was the person of that name, who carried on business in that city. When his merchandise was brought into France to compete with honest goods, his deception was sufficient authority for confiscating it.

§ 72. **An Untrue Use of the word "Patented,"** or its equivalent. If a trade-mark represents an article as protected by a patent, when in fact it is not patented, such a statement *primâ facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the mark to relief in a court of equity against a pirate.[3] That is clearly so when the pretended patent had never existed.[4] In the case of *Edelston* v. *Vick*,[5] Vice-Chancellor Wood intimated a doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade-mark being true when first introduced, had been continued after it had ceased to be true. Lord Kingsdown, in the Leather Cloth case, declined to assent to that distinction. He thought that if the word "patent" be not so used as to indicate the existing protection of a

[1] Greenwoods Scythe Co., No. 788.

[2] Ministère Public et Bernard *v.* Compagnie de l'Est, Ann. de la Prop. tome xi. p. 202.

[3] Leather Cloth Co. *v.* Am. Leather Cloth Co., 11 Jur. (N.S.) 513.

[4] Flavel *v.* Harrison, 19 Eng. L. & Eq. 15. [5] 18 Jur. 7.

patent, but merely as part of the designation of an article known in the market by that term, then he quite agreed in that view. He said that a patent may have expired fifty years ago, and yet the name of "patent" may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represents the article as protected by patent, when in fact it is not so protected, it can make no difference whether the protection never existed or has ceased to exist. In the more recent case of *Marshall* v. *Ross*,[1] in 1869, it was held that the use of the word "patent" as part of the description in a label or trade-mark of goods not protected by a patent, is not such a misrepresentation as to deprive the owner of his right to be protected against an infringement of his label, where the goods have from the usage of many years acquired the designation in the trade generally of *patent*. Sir W. M. James, V. C., said that he could grant the plaintiff the relief which justice requires without interfering with the decision of the House of Lords in the Leather Cloth Company's case above cited; for the word "patent" may be used in such a way as not to deceive the public. For instance, he said, the term "patent-leather boots" is in constant use; but no one supposes that it is thereby intended to convey the impression that the leather is protected by any patent. In this case, it was shown that the term "patent thread" had been used in the trade for many years past, and was the name by which thread of a certain class is known by manufacturers, and in the trade. It had in fact, he said, become a word of art.

§ 73. The case of *Edelston* v. *Vick*, in the High Court of Chancery, in 1853, is as follows: T. took out letters-patent, which expired in 1844, for the manufacture of solid-headed pins, and carried on the business under the firm of T. & Co., till 1838. In such business T. used parti-colored labels, in pink and green, in which the pins were described as

[1] L. T Rep. 21 (N.S.) 260; Law Rep. (Eq.) 8, 651.

"Patent Pins, exclusively manufactured by T. & Co.," and had engraved plates and blocks for striking off said labels. In 1838, T. assigned to S. the letters-patent, together with his business and good-will, and the right to use the plates, labels, &c., and the name of "T. & Co." In 1839, S. became bankrupt. His assignees carried on the trade till 1841, when they assigned the business, patent, plates, labels, &c., with the right to use the name of "T. & Co.," to Edelston, the plaintiff, who continued the business and the use of the labels. In 1853, Edelston discovered that Vick, the defendant, was using labels like those of the plaintiff. *Held*, *first*, That Edelston was entitled to restrain such palpable imitation. *Secondly*, That Edelston was not disentitled to sue by reason of the representation on his label being no longer accurate, although the pins were not still protected by patent, nor manufactured strictly according to the patent, nor exclusively or at all by T., who had long since retired. *Thirdly*, That Vick was not to be precluded altogether from representing that his pins were manufactured according to T.'s (expired) patent, but he was not to do so in a manner liable to mislead.[1]

§ 74. Argument is not necessary to persuade any thinking person of the necessity that exists for the protecting instrumentalities of the law. In olden times in England, the trade-guilds and corporate bodies looked especially to the maintenance of a high character of workmanship on broadcloths, cutlery, hardwares, and other principal manufactures. The penal law of that country is severe upon the reprobates who turn the lawful weapon of defence into the weapon of the robber, by simulating the marks that commerce uses as a safeguard. The crown has its distinguishing broad-arrow for some kinds of property, and its yellow thread in cordage; and the possession of either kind by a private individual is presumptive evidence of felony, as much as the possession of false

[1] 18 Jur. 7.

dies or tools for counterfeiting the currency. Our own government finds it necessary by similar stringent measures to protect its own peculiar marks, as, for example, in the matter of the various-colored threads scattered through the fibre of the paper on which the national securities are printed. Nearly all nations have observed the absolute necessity of severe penal laws to the same end; while not a few have adopted the same rules as ours in regard to the fraudulent invasion of private rights. The more flourishing becomes commerce, the more general are piracies of this kind. While we may reasonably infer from circumstances that no ancient nation was exempt from such roguery, we have indubitable evidence that all nations of our own times are wonderfully enterprising in this respect. Almost all articles of merchandise possessing a high reputation in Europe are extensively imported into the United States. Their excellences and ready sale excites the cupidity of the fraudulent dealer; and therefore Heidseick champagne, other wines and brandies, Piesse and Lubin's extracts, and all the various descriptions of toilet articles, Rodgers's cutlery, Worcestershire sauce, Burton ales, Irish linen, French silks, Scotch shawls, in short the innumerable other articles of luxury or of necessity, are imitated, falsely marked, and sold. These frauds are committed under the very eyes of the honest manufacturer, and carried out with so much satanic skill as to elude any but the most vigilant search. Our country has probably been the greatest victim. Even fabrics in which our workshops excel have been brought from Belgium, France, Switzerland, and put into competition with the genuine goods. The reputation of American watches has brought an avalanche of miserable imitations from Geneva, till Congress has been compelled to pass a statute expressly for the purpose of interposing a barrier against them.[1] The Germans imitate the Irish marks on linen; the French, the English marks on ales, cutlery, &c.; the English, the French marks on

[1] Act of March 3, 1871.

wines. No nation can claim precedence of any other in such illicit competition, so far as means allow. In the Supreme Court of Calcutta, in 1854,[1] the native defendant was shown to have pirated the English trade-marks on gray shirtings of an inferior quality. That case developed the fact that such imitations had been carried to a considerable extent. We are told that it was the custom at Worcester, England, to copy a great variety of Chinese and Japanese patterns on porcelain, and with such good effect that the copies were frequently mistaken for originals. The marks were simulated exactly.[2]

§ 75. M. Jobard, more than a score of years since, expressed his sorrow that the revolution in France in 1793 had broken down the law of obligatory marks, that honorable source of confidence and of commercial prosperity, which lost to France all the openings of the Orient. The Levantines, habituated for centuries to the sincerity of the marks guaranteed by the arms of the city of Nimes, Avignon, Lyons, &c., with horror observed the inroads of counterfeiters. The Turkish merchants, no longer confiding in the honor of the French, themselves repaired to Marseilles, Beaucaire, Lyons. But they were cheated as easily near by as afar off; several of the principal ones having paid at Lyons for golden fabrics (*by order of the Grand Seigneur*) unwittingly delivered brass to him. He beheaded them. Thus much for implicit faith in trade-marks.[3]

§ 76. We may instance the injury done to national confidence by false coinage, the simulation of the mark of the sovereign. Private coinage is not allowed. Coin is intrinsically worth nothing, or next to nothing, beyond its weight of gold or silver, in mass. The public faith is a sufficient guaranty of the genuineness of a coin. Counterfeit coins are almost always of inferior composition and value, and are fabricated for the purpose of imposing them upon the public as

[1] Leech *v.* Doorgachurn Seal *et al.*, Journal So. Arts, vol. vii. p. 271.
[2] Binn's Century of Potting in Worcester (London, 1865), p. 93.
[3] Organon, etc.

genuine, and gaining the difference. And yet it is possible that the public may be deceived and at the same time not injured. This may be illustrated by a case which occurred in Tunis in 1828. A coinage of new piastres was effected under the direction of the Bey, and on account of his government, the sovereign reaping the enormous profit of more than forty per cent. Piastres of a similar impression, weight, and value, were fabricated in Europe, and found their way to Tunis, where they entered into the circulation, and procured for their makers a division of the spoils. Still the piracy was no less in law, even had the counterfeiters furnished a superior coin; the rule being that the public may not be deceived, even for its own benefit. Not many years ago, the base silver money of Hayti was imitated by artisans in this country, upon similar speculative ideas.[1] It may also be remembered that, during our late civil war of the rebellion, the worthless notes of the Confederate States were imitated by lithographers and printers in the North, and, being more artistically executed than were the genuine, were all the more greedily sought for. Yet the man who sold a cow for a pretty-looking counterfeit note, was declared in law to be cheated, even although the genuine note was doomed never to be redeemed; for his contract was for a genuine promise to pay. The cases fairly illustrate the principle of trade-marks, so far as the obligation to deliver to the purchaser the thing bargained for, whatever its intrinsic value.

§ 77. None of the actors in the following case would have had any standing in court, as applicants for protection. Years ago, the wine-growers of Mont Rachet and of Chablis heard that monks in Bourdeaux were exporting white wine to Turkey, under the name of mineral water. So thrifty an example was not to be despised; so white wine from Burgundy was sent to the Turks under the same disguise, and was declared by the consignees as well as by the exporters to be as good mineral water as that of Bourdeaux. Here was a case of competition

[1] Eckfeldt and Du Bois, Manual of Coins and Bullion.

in business by unfair means. Suppose that the pious fathers of Bourdeaux had prosecuted their rivals in trade for the imitation of their mark, to wit, the meaningless, arbitrary symbol, "Mineral Water," could a suit have been maintained? No! But nobody was deceived? True; but the business was immoral. Immoral to sell wine? No! but immoral to sell to Turks, because their religion forbids them to drink it.

§ 78. Manufactures and commerce are, it is plain to perceive, twin sisters. As they began life together, so in the race do they keep side by side. The plastic hand of the cunning workman moulds and fashions and shapes; while the merchant, scattering his products afar in all directions, by barter receives from afar the products of other countries. All the world should be enabled to test the genuineness of goods by the mark placed upon them. When the distinguishing symbol is once published, it should be susceptible of being read as easily as the child or the dog, by intuition or by instinct, reads the marks that nature has legibly written on the countenance of man. The first glance of the eye decides. This is a rule in connection with trade-marks.

§ 79. **How shall we judge a Mark?** — We must learn something of its peculiar nature; for it is not every heterogeneous assemblage of objects that comes within the category of trade-marks; nor every Protean representation, that may be one thing to-day, another thing to-morrow. We must apply a touchstone to any thing claiming to be the symbol of trade. We must learn to discern the true from the false, — *i.e.*, the one having the true essence from that which has but a faint semblance of reality. We need not err. There are certain tests. But this leads us to another chapter, which treats of the nature of the thing.

CHAPTER III.

DEFINITION AND NATURE OF A TRADE-MARK.

Necessity for Definition. — Difficulty of Defining. — All Nations use substantially the same Definition. — The Technical Mark not to be confounded with its Analogues. — Statutory Definitions. — Trade-marks as applied to Newspapers, Books, &c. — Mere Names of Hotels, Shops, &c., not Trade-marks. — So, also, of mere Labels, Advertisements, Notices. — No Abstract Right to Symbol of Manufactures or Commerce. — Merchandise: what? — *Résumé* — Essential Characteristics of a Trade-mark.

§ 80. A DEFINITION of the term trade-mark is requisite, in order that we may know exactly what we are discussing. This definition is not without difficulty. To arrive at certainty therein, we must examine the laws and the judicial decisions of various countries, whose jurisprudence on this subject is harmonious with that of our own tribunals. Indeed, this species of property cannot advantageously be considered simply in its relationship to a locality; but it must be viewed in connection with affinitive subjects embraced by the all-pervading spirit of commerce. Names sometimes deceive. The difficulty of defining this thing called a trade-mark has been recognized by the ablest minds.

§ 81. We must seek the differential quality by which a trade-mark is discriminated from its analogues, or we shall find our ideas tripped up by the improper use of names. Nomenclature does not consist in the mere naming of tools, but is the expression of distinctions which convey in a single word the nature of the thing meant. When we use the terms trade-mark, label, sign, envelope, design, etc., we mention

things which are analogues of each other, and are not similar in their natures.

§ 82. The exposition of the comprehension of a notion is called its definition, says Sir William Hamilton.[1] For example, the concepts *man*, *horse*, *dog*, &c., are contained under the general concept *animal;* and the concepts *triangle*, *square*, *circle*, *rhombus*, *rhomboid*, &c., are contained under the general concept *figure* (*concept* and *notion* being convertible terms). The same clear thinker says that conception, the act of which concept is the result, expresses the act of comprehending or grasping up into unity the various qualities by which an object is characterized. It has been for lack of a clear conception of the natures of the things which they had occasion to discuss or comment upon, that at times judges, essayists, and reporters have misused terms, and named one thing when they meant another. The uninitiated are misled by the wrongful use of terms; and find to their sorrow, in court, that what they supposed were veritable trade-marks, are mere labels or advertisements, not within the pale of the law's protection. The opinions abounding with fallacious *obiter dicta* remind one of the illustration used by Sir William Hamilton:[2] "In countries where bank-notes have not superseded the use of the precious metals, large payments are made in bags of money, purporting to contain a certain number of a certain denomination of coin, or at least a certain amount in value. Now these bags are often sealed up, and passed from one person to another, without the tedious process, at each transference, of counting out their contents, and this upon the faith that, if examined, they will be found actually to contain the number of pieces for which they are marked, and for which they pass current." Still the door is open to error and fraud. In the same way, we too frequently accept the loose sayings of a judge for law, because they bear the judicial impress; but when, from abundant caution, we open and examine the bag purporting to

[1] Logic, lect. viii.

[2] Logic, lect. x.

contain pure gold, we find but withered leaves. In no unkind spirit, we scan the words that should be the fortresses of thought, and find a heap of chaff. No one has the right to complain of our attempt to separate the chaff from the wheat. Locke tells us, in speaking "Of the Abuse of Words," that some take so little care to lay by words which in their primary notation have scarce any clear and distinct ideas which they are annexed to, that by an unpardonable negligence they familiarly use words which the propriety of language has fixed to very important ideas, without any distinct meaning at all. . . . Men having been accustomed from their cradles to learn words which are easily got and retained, before they knew or had framed the complex ideas to which they were annexed, or which were to be found in the things they were thought to stand for, they usually continue to do so all their lives; and, without taking the pains necessary to settle in their minds determined ideas, they use their words for such unsteady and confused notions as they have, contenting themselves with the same words other people use, as if their very sound necessarily carried with it constantly the same meaning.

§ 83. Thus, a careless speaker applies the term trade-mark to a mere label, although such mere label is not protected by law, unless by some local statute;[1] or to a mere advertisement;[2] or to the good-will of a shop;[3] or to the sign of an inn or hotel.[4] It is true that we may read and analyze for ourselves; and it is quite as true that we accept the phraseology of a judge on trust. The universality of a term, says Watt, in his book on logic, is many times restrained by the particular time, place, circumstance, &c., or the design of the speaker; as when it is said in the Gospel that "all men did marvel," it reaches to only those men who heard of the miracles of our Saviour. By a careful perusal of a case, we may

[1] Falkinburg *v.* Lucy, 35 Cal. 52.
[2] Leather Co. case, 11 Jur. (N.S.) 513.
[3] Howe *v.* Searing, 10 Abb. Pr. R. 264; 6 Bos. 354; and 19 How. Pr. R. 19.
[4] Howard *v.* Henriques, 3 Sand. S. C. 725.

generally ascertain the import of the language of a judge while he is attempting to expound the law; but, unfortunately, we find that he is sometimes completely in the mist. "The one exclusive sign," says Aristotle, "that a man is thoroughly cognizant of any thing, is that he is able to teach it." We may, therefore, conclude that if a judge cannot convey to the mind of another person an intelligent idea of his meaning, he must himself be deficient in the understanding of his subject. We require a definition, and that definition the analysis of a complex concept into its component parts or attributes.

§ 84. A definition is a brief enunciation of the law governing a particular subject, or branch of a subject, known by a particular name. Thus, the law of contracts is, in outline, stated in the definition of the word *contract*. Out of an accurate definition can be drawn a vast amount of law. But, in the nature of legal things, a definition can never be established by adjudication. The absolute truth of this proposition appears when we consider that the object of every law-suit is, so far as the law of the case is concerned, to determine the rights of the parties as growing out of certain facts admitted or proved. But facts, as shown in courts of justice, are just as variant in nature from a definition as is a triangle from an emanation of the mind. There is no concord or harmony between the one and the other. Yet, although a court cannot adjudge a definition to be so and so, it may, in assigning reasons for its judgment, take into the account the idea of the true principle of a definition. In other words, the judge, in giving the opinion of himself and his associates upon the law as applied to the facts, may state what he and they deem the true definition to be. But this statement is a mere *dictum*: it creates no law; it is of no higher authority than are similar statements made by text-writers; and indeed it is not so likely to be found correct as is theirs.[1] In his treatise on trade-marks, Lloyd[2] states his opinion that there would be much convenience in having a

[1] Bishop's First Book of the Law, §§ 261, 262. [2] Second ed., p. 33.

statutory definition of a trade-mark, which should distinguish, as was done by the old French law, between the *marques de fabriques*, or trade-marks properly so called, consisting of a stamp affixed to or incorporated with a manufactured article, and the use of a name, or label, or a sign-board, or placard, and all those less permanent marks of distinction which are used in trade; and again separating from them all cases which involve literary or industrial property.

§ 85. The French have probably given this subject as keen and thoughtful a scrutiny as any jurists in the world; and yet, in the report of the commission to examine the project which crystallized into their legislative act of the 23d of June, 1857, it is said: "In what do marks consist? The plan of the law, avoiding the peril of a definition, and leaving to doctrine and to jurisprudence the task of defining, has remained mute in this respect." The Council of State concurred in this idea of the impolicy of attempting an exact enunciation of the elements which constitute this thing, and said: "The mark is any sign serving to distinguish the products of a manufacturer, or the objects of commerce, and the law cannot enumerate the signs." The Court of Paris, in 1859, calls it the characteristic sign by means of which commerce distinguishes the products of one's manufacture, or the objects of his commerce.[1] By resorting to what was until lately the universal language of diplomacy, — the French, — and which is a safe guide to the meaning of all leading nations when speaking upon this subject, we find that the *trade-mark* of English-speaking countries is the same thing as the *marque de fabrique et de commerce* of continental Europe. This is placed beyond all question by the "Code International de la Propriété Industrielle," &c., by MM. Pataille and Huguet (Paris, 1855), and the Appendix thereto (1865), by the former eminent jurist. Our term is so translated, and so its synonym in the English "Merchandise Marks Act," of 1862. All treaties and conventions of com-

[1] Lalande et Liot *v.* Appel *et als.*, Ann. de la Prop., etc., tome v. p. 248.

merce agree in this respect. The uniformity of expression proves that the same thing is understood by all alike; and that in the minds of statesmen and jurists there is no doubt as to what is meant by the general comprehensive term *trade-mark*. As corroborating instances of this prevalent understanding, see our treaty with Russia,[1] where the phrase "trade-marks affixed to merchandise" is rendered in the counterpart *des marques de fabriques apposées dans l'autre sur certaines marchandises;* and see, also, our conventions with Belgium[2] and France.[3] The German term *Fabrikzeichen* is translated into the same words in French.[4] We find a more comprehensive definition of the term mark of trade, in German.[5]

§ 86. This perfect agreement leads to the inevitable conclusion that a trade-mark is not a new kind of creature; and that its meaning, purpose, and value are well known to all manufacturing and commercial peoples, and requires no definition in a treaty, every word of which is subjected before ratification to the most rigid scrutiny. The manifest object of the many national compacts was reciprocity of protection, and not to give vitality to the thing. When we come to fully consider the subject, it will be amply demonstrated that, as much as any other species of property, a right to a distinctive mark of authenticity has its foundation in immutable law; and we will perceive that any arbitrary law — as a treaty, a convention, or a statute — cannot be the parent of this ideographic sign. The *right* pre-existed: a compact only recognizes that right, and opens the door to a *remedy* for encroachment thereon.

§ 87. The mark may consist in the name of the manufacturer or the merchant (provided it be written, printed, branded, or stamped in a mode peculiar to itself); in a seal, a letter, a

[1] Jan. 27, 1868. [2] Dec. 20, 1868. [3] April 16, 1869.

[4] Technologisches Wörterbuch, in three languages. Paris, 1855.

[5] "Unter den Waarenbezeichnungen (Fabrikzeichen, Marken) werden diejenigen Zeichen verstanden, welche dazu bestimmt sind, die in den Handel gebrachten Erzeugnisse als von einem bestimmten Urheber oder Zwischenhändler herrührend zu bezeichnen." Klostermann on Trade-marks, &c. Berlin, 1869.

cipher, a monogram, or any other sign or symbol that can serve to distinguish the products of one man from those of another. It may be any symbol or emblem, however unmeaning in itself, as a cross, a bird, a quadruped, a castle, a star, a comet, a sun; or it may, and frequently does, consist of a combination of various objects, copied from nature, art, or fancy; and if such symbol or emblem comes by use to be recognized in trade as the mark of the goods of a particular person, no other trader has a right to affix it to goods of a similar description.[1] It may be adhesive or non-adhesive. It may be put inside of the article, or on the outside. It may be written, printed, stamped, painted, stencilled, branded, or otherwise, and either on the article itself, or on its case, covering, envelope, or wrapper.[2]

§ 88. We must not be misled by a sweeping definition. We must judiciously compare, reason, generalize. Mere words may deceive. The physiology of the thing called a trade-mark must be examined and carefully analyzed. It has an individuality of nature. Meaningless in itself, when placed in a certain juxtaposition, it involves an idea, as the digit 9 does not represent the word *nine*, but the idea itself of the number. It is the legitimate hieroglyph. It is the emblem of a man; and it virtually says that the vendible object to which it is attached is the workmanship, or the selected article, of the owner of the mark. It is intended to strike the eye by its clearly defined character, and sometimes the ear by its sound when spoken of, and thus excite inquiry; and for this reason it must be peculiar in form, although possibly not susceptible of utterance in sound.

§ 89. We may readily understand why a nondescript vignette,

[1] Leather Cloth Co. *v.* Am. Leather Cloth Co., 11 Jur. (N.S.) 513.

[2] The French law of June 23, 1857, says: "Sont considérés commes marques de fabrique et de commerce les noms sous une forme distinctive, les dénominations, emblèmes, empreintes, timbres, cachets, vignettes, reliefs, lettres, chiffres, enveloppes, et tous autres signes servant à distinguer les produits d'une fabrique ou les objets d'un commerce."

a grouping of flowers and fruits, an elaborate landscape having no striking features, or a mere advertisement, or common print of a man's name, should not be regarded as the distinctive mark that the law of commerce requires. It should possess such salient features as might at once arrest attention and put the intended purchaser on the alert. If such an undefined object could possibly be regarded as a valid trade-mark, what would be the consequences? There would be neither protection for the owner nor guaranty for the buyer; for any other combination of flowers and fruits, of houses and trees, having the same pictorial effect, might be mistaken for it.

§ 90. It is not very remarkable that casual readers should fall into the error of confounding the technical trade-mark of commerce with rights protected upon principles analogous to those upon which trade-mark decisions rest, — such as the good-will of an establishment of trade and literary rights, — especially when we find at times a judge, a commentator, or a reporter, falling into the same error. The importance of observing the distinction will be more manifest as we proceed in this investigation. It should be borne in mind that a trade-mark carries the idea of a man's personality, like his ordinary autograph, and therefore preserves its essential characteristics wherever it may go. This is not so with a *quasi* trade-mark, as the name of a hotel or shop of trade, or the title of a stage-coach, or mere literary property, or a patent for an invention or a discovery; for such things have no inherent extra-territorial force, and for recognition depend upon compact, or the tacit acknowledgment of nations other than those where such rights originated.

§ 91. With rare exceptions, this important distinction is observed. Mr. Lloyd, in his treatise on trade-marks,[1] preserves the line between the good-will of a trade so far as it is contained in the title and style of a partnership, or the name of a trader, or the description of his place of business,

[1] London, 1865.

and property in a name or distinguishing style, as connected with a literary publication or a work of art. So do also the continental writers and jurists; for although in their tribunals a single action may, it seems, embrace a claim for damages for infringement of a patent, a demand based on a trespass on the good-will property by false representations, the piracy of a label and violation of a mark, and may unite a demand for both civil and criminal penalties, — *i.e.*, when all the alleged wrongs shall have arisen from one transaction, — yet we find that the different classes of injuries are separately considered in arriving at a conclusion, although constituting the warp and woof of the same web; and in adjusting remedies each species has its own peculiar redress. This mode of procedure, so different from that of countries under the domination of the common law of England, springs from the flexibility of the *Code Napoléon*. Yet this complexity need cause no confusion of ideas, except in the minds of superficial readers and unreflecting dabblers in law.

§ 92. In the case of *Woodward* v. *Lazar*,[1] in the Supreme Court of California, in 1863, before all the justices, the name of a hotel was treated as a trade-mark. It was an appeal from an order refusing to dissolve an injunction by which the defendants were restrained from using the name of "What-Cheer House," as the title or name of a hotel in the city of San Francisco. Norton, J., in delivering the opinion of the court, said: "It has been decided, and with good reason, that the name established for a hotel is a trade-mark, in which the proprietor has a valuable interest, which a court of chancery will protect against infringement. *Howard* v. *Henriques*, 3 Sand. S. C. 725. The point of dispute in the case is as to whom the name 'What-Cheer House,' as a business-sign, belongs. The plaintiff claims that it belongs to him, as the keeper of the hotel, which he continued to conduct under that name after he surrendered the leased premises; while the

[1] 21 Cal. 448.

defendants claim that it is the designation of the building in which the business under that name was first conducted, and became theirs when they became owners of the building." Now let us examine the case cited by the judge, and decide for ourselves whether or not there was not a mistake made in the name of the thing, — a mistake quite as wide of the truth as would be the confusion of the terms freehold, mortgage, lease, all relating to landed property, yet distinct in their natures. Names are sometimes things.

§ 93. In *Amoskeag Manufacturing Co.* v. *Spear*,[1] in 1849, a distinguished jurist, Mr. Justice Duer, inadvertently misused terms. The defendant had pirated plaintiffs' label, making it correspond in size, color, fancy border, position, general arrangement and size of the letters, including the alleged trade-mark, the capital letters "A C A." These letters were decided not to be a trade-mark, being merely indicative of quality. What, then, was the trade-mark? Nothing. Compare the language of the two labels. That of the plaintiffs read thus: "AMOSKEAG MANUFACTURING COMPANY. POWER LOOM. *Yds.* ——. A C A. AMOSKEAG FALLS, N. H." That of the defendant read thus: "LOWELL PREMIUM TICKING. POWER LOOM. *Yds.* ——. A C A. WARRANTED INDIGO BLUE." The judge had a clear conception of all the principles involved, and his decision was unquestionably correct. The extraordinary powers of a court of equity had been invoked to prevent the continuance of fraud. In what did that fraud consist? In a "designed, studied, elaborate imitation" of the label of the plaintiffs, said his Honor. The defendant endeavored by a false representation to effect an unlawful purpose. To quote the judge's own words: "In this case there is a fraud coupled with a damage; and a court of equity, in refusing to restrain the wrong-doer by an injunction, would violate the principles upon which a large portion of its jurisdiction is founded, and abjure the exercise of its most important functions, — the suppression of

[1] 2 Sand. S. C. 599.

fraud, and the prevention of a mischief that otherwise may prove to be unbearable." The remedy could not be denied. The error of the judge manifestly consisted but in the loose use of one word for another, those words being in no sense convertible terms. The words were uttered more than twenty years before the first case of the kind had been reached in the highest court in the land, and were uttered in a case which required no definition of species. If there had been any need of a nice discrimination of technical terms, the acute mind of the judge would have seized upon it, and, by using the exact word, would have prevented the possibility of misunderstanding. The objectionable phraseology was this: "When I compare the original trade-mark of the plaintiffs," &c. The correct word was *label*, not *trade-mark*. It must be obvious at a glance to any one, who has acquainted himself with the law and principles of trade-marks, that the single element that could possibly be a trade-mark was the "A C A" symbol. The three letters were found not to constitute a lawful trade-mark, and were stricken from the injunction. Nothing, thereafter, remained but words in ordinary use, common to all the manufacturing world. But, if this was not a trade-mark case, what was it? Answer: it was a case of unlawful competition in trade, by means of a simulated label.

§ 94. In another place it will be seen that the Patent Office took action upon this question, and decided the three letters "A C A" to be at least a *primâ facie* trade-mark, from its long user and universal recognition.

§ 95. The case of *Howard* v. *Henriques*,[1] in 1851, was decided by five out of six judges of the Superior Court of the city of New York, when that court was composed of as able minds as any in the land. The plaintiff was proprietor of a hotel known as the "IRVING HOUSE," *or* "IRVING HOTEL," and which was opened and named by him "IRVING HOUSE," in 1848. The defendants opened another hotel in the same city, which

[1] 3 Sand. S. C. 725.

they named the "IRVING HOTEL." An injunction was granted, by one of the justices of the court, restraining the defendants from using the name thus taken by them. A motion was made to dissolve this injunction. Observe, the plaintiff's house, although originally designated by him as the Irving *House*, very soon became generally known also as the Irving *Hotel*, and was designated by both names indiscriminately for more than a year before the defendants opened their hotel. All these facts appear in the opinion of the court, delivered by Mr. Justice Campbell. It was urged by the defendants' counsel, *first*, that the plaintiff had not appropriated the name, because no such name appeared on the external walls of his house; and, *second*, even if it did so appear, the name was not the subject of appropriation, as applied to a hotel; that the principle upon which trade-marks and other similar rights had been protected, was applicable alone to personal property, to manufactured articles, to such things as were necessarily movable, and in reference to which frauds could be practised without being easily detected, or, at all events, frauds could be practised operating injuriously upon the party claiming the trade-mark, and also upon the public. The answer of the court was that there would be no more necessity for the plaintiff to place in large letters upon the front of his building, "This is the Irving House," in order to designate it and secure an appropriation of the name, than there would be to write on the public edifices of the city, "This is the City Hall," and "This is Trinity Church." As to the second objection of the defendants the court spoke thus: "We think that the principle of the rule is the same, to whatever subject it may be applied, and that a party will be protected in the use of a name which he has appropriated, and by his skill rendered valuable, whether the same is upon articles of personal property which he may manufacture, or applied to a hotel where he has built up a prosperous business. We are not disposed to interfere with the lawful pursuits of any one. Every man may, and

ought to be permitted to pursue a lawful calling in his own way, provided he does not encroach upon the rights of his neighbor or the public good. But he must not by any deceitful or other practice impose upon the public; and he must not, by dressing himself in another man's garments, and by assuming another man's name, endeavor to deprive that man of his own individuality, and thus despoil him of the gains to which by his industry and skill he is fairly entitled. To make the application: If one man has, by close attention to the comfort of his guests, and by superior energy, made his hotel desirable for the traveller, and caused its name to become popular throughout the land, another man ought not to be permitted to assume the same name in the same town, and thus deprive him who first appropriated the name, of some portion of the fruits of that good-will which honestly belongs to him alone."

§ 96. The perusal of this case of *Howard* v. *Henriques* relieves the mind from all doubt or embarrassment as to the meaning of the court. The counsel had been reasoning from analogy; and the court pursued the train of ideas thereby evolved. No one in that case assumed that the mere name of a hotel could be a trade-mark, but argued upon principle. How could any one so assume? Did the proprietor of the name affix it to any vendible article? No. But, it may be replied, he did use it upon all the bills rendered to his guests, on cards, and in numerous advertisements circulating throughout the country. True; but advertisements are not trade-marks.[1] Nothing short of the sheerest sophistry could twist the title of a hotel into a mark of commerce, a visible mark affixed to a thing sold, or for sale. We cannot detect the essential elements of the thing technically so known. Then, if not a case of trade-mark, what was it? It was exactly what the Superior Court, by the lips of Mr. Justice Campbell, called it, the "good-will" of the establishment. The case did not call for a definition. All that was required was substantial

[1] Lord Chancellor, in Leather Co. *v.* Am. Leather Co., 11 Jur. (N.S.) 513.

justice, upon the allegation of an invasion of an equitable right.

§ 97. *McCardel* v. *Peck*,[1] before the Supreme Court of New York, *in banc*, in 1864, is a case that is sometimes cited to prove that the name of a place of business is a trade-mark. The misconception is the fault of the syllabus of the reporter. The matter in dispute was the right to use the name of a restaurant known as the "McCardel House," in the city of Albany. The court certainly did not treat the case as any other than a question of the right to the good-will. The language of Miller, J., who delivered the opinion, misled the reporter. He said: "The use of names and trade-marks in business, when made valuable, has always been protected by the courts, and any improper appropriation of them without the authority of the owner will be restrained by injunction." He said in another place, "the use of a name or trade-mark." This is all that was said of trade-marks: "Names *and* trade-marks;" and "a name *or* trade-mark." It needs no great power of discrimination to perceive that the employment of the conjunctions implied a distinction between *name* and *mark*.

§ 98. *Howe v. Searing*, 1860,[2] is another case that is quoted in support of the theorem that the name of a place of business is essentially a trade-mark. But a careful examination of that case will show that the majority of the court placed it in its proper category. The plaintiff, a baker by trade, brought an action to restrain the defendant from designating the bakery-establishment kept by him, in the city of New York, as "Howe's Bakery," and from otherwise using the name of Howe, so as to induce the public to believe that the business carried on at his place was conducted by the plaintiff. It was not in anywise discussed as any thing other than what it really was,—"the *good-will* of the business of baking." All the authorities commented upon by the learned Judge Hoffmann, who delivered the opinion of the court, are good-will cases.

[1] 28 How. Pr. R. 120. [2] 10 Abb. Pr. R. 264; 6 Bos. 354; and 19 How. Pr. R. 14.

He adopted the language of Vice-Chancellor Wood, in *Clinton et al.* v. *Douglass*:[1] "The name of a firm is a very important part of the good-will of the business carried on by the firm. A person says, I have always bought articles at such a place of business; I know it by that name, and I send to the house of business identified by that name for that purpose." Moncrieff, J., *dissenting*, said: "The name or words 'Howe's Bakery' was nothing but a trade-mark, and, as such, is now sought to be protected by the plaintiff. The name or trade-mark passed by the assignment and transfer of the '*good-will*;' and, if it was not the thing itself, it was an integral part of it."

§ 99. What warrant had the dissenting judge to use the technical term trade-mark? We look in vain for any authority to sustain his remark. Consider the circumstances. The plaintiff, who had been doing a lucrative business as a baker at No. 432 Broadway, sold the lease of the premises, with all the stock, wagons, and fixtures, and the good-will of the concern, to one Baker. Baker subsequently sold back to Howe the right to resume business at another place, No. 850 Broadway, in the same city; and still later sold the lease to Searing, the defendant, subject, however, to Howe's right to conduct business in his own name. Searing continued the old sign-name, to the prejudice of the plaintiff's rights, and in a way calculated to mislead the public. Howe had a clear title to his own name; and so, indeed, had any other Howe the same right, and if he chose could put up a sign informing the public of the location of his place of business. Searing, the defendant, had no right to use Howe's name. Hence the suit. The mere name of Howe could not be a valid trade-mark, for it was not the exclusive property of the plaintiff. It was not a trade-mark unless intended to be stamped upon, or otherwise affixed to the articles sold. It was at best a mere advertising sign. Even if stamped upon the bread, it would not be a trade-mark; for it would not indicate origin. The purchasers

[1] 1 H. R. N. Johns. 176.

could not tell by the mere name what one of many persons of the same name had baked the bread. Conclusion: the remarks of Mr. Justice Moncrieff were not a judicial decision, and must be classed with unauthoritative *obiter dicta*.

§ 100. We must not infer from the foregoing decisions that the name of a place of business cannot become a valid trade-mark. If it possess the true characteristics of such a mark; if it be not generic, merely descriptive, or one that any other person in the same trade may truthfully use; and if it be affixed to a vendible article, then it may be made a trade-mark as well as any other symbol. The case of *Choynski* v. *Cohen*,[1] in the Supreme Court of California, in 1870, before all the justices, is in point. The plaintiff claimed the exclusive right to the name, "ANTIQUARIAN BOOK STORE," which name was placed upon his sign, *stamped upon all articles sold by him*, and used in his correspondence. *Held*, to be a mere designation of trade.

§ 101. It was of little or no moment in the cases cited what term a judge may have used to express an idea. Substantial justice did not depend upon preciseness of terminology. It is, however, of moment in our present purpose to accurately define, lest by looseness of language we fall into looseness of application of principles, and so end in egregious error. In judicial matters, a rose by any other name may not smell as sweet. A name is sometimes of the very essence. We could not arrive at any result other than this: the name of a hotel and a trade-mark are not convertible terms.

§ 102. The British "Merchandise Marks Act," of 1862, says that "the word 'mark' shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description; and the expression 'trade-mark' shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid lawfully used by any person to denote any chattel, or (in

[1] 39 Cal. 501.

Scotland) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, or production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person; and shall also include any name, signature, word, letter, number, figure, mark, or sign which in pursuance of any statute or statutes for the time being in force relating to registered designs is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes or any of them." This language savors more of enumeration than definition, and may possibly mislead by its breadth of expression, embracing as it does things incongruous in their several natures, as registered designs and copyright matters. Being a statute applicable only to British courts, its form of expression cannot be taken as an infallible guide for our present purpose. Many of the terms used cannot be understood unless taken with their judicial definitions, as name, word, label, &c. It should, however, be observed that the expression "trade-mark" not only includes every mark lawfully used by a person to denote any chattel to be an article of the manufacture, workmanship, or production of such person, but also to be an article of the *merchandise* of such person, or to be an article of any peculiar or particular description made or sold by such person. This will include such cases as *Mottley* v. *Downman*,[1] where it was contended that the right to use the trade-mark was attached to a particular place and works, and to cases where the articles are distinguished by the name of a person who did not manufacture them, and to similar cases.[2]

§ 103. Is the NAME OF A NEWSPAPER a trade-mark? This question has been thoroughly discussed *pro* and *con.* in the Patent Office, but has probably not been definitively decided

[1] 3 M. & C. 1.

[2] See notes of H. B. Poland, Esq., to the English Act of 1862.

by any court. Upon an application for registration, all the authorities bearing upon this point were examined. If a technical trade-mark, the application would be favorably acted on; if not, it would be rejected. The matter being *ex parte*, the pleasing task of collating judicial decisions devolved upon the Office. We will let the cases cited again pass in review.

§ 104. *Snowden* v. *Noah*, in the Court of Chancery of New York, before Sandford, Chancellor, in 1825,[1] was treated by counsel and by the court as a *good-will* case. The chancellor said: "The defendant Noah was the editor, but not the proprietor, of the newspaper establishment called the 'National Advocate;' and immediately after the sale of that establishment by its former proprietor to the complainant, Noah established another newspaper, under the title of the 'New York National Advocate.' This new gazette thus established is sent to the subscribers of the former 'National Advocate,' and Noah has solicited and continues to solicit the support of the patrons of the former paper and of the public to his newspaper. This is briefly and in substance the case upon which an injunction is now asked." After some other remarks, he continued: "The subject in respect to which an injunction is asked, is what is called the good-will of the establishment, or the custom and support which the 'National Advocate' had before received from its subscribers and patrons, or from the public. The effort of Noah is to obtain for his newspaper the support of the public in general, and especially the custom and good-will of the friends of the 'National Advocate.' This object is distinctly avowed; and an open appeal is made to the friends of the 'National Advocate' and to the public to give their support to the new paper. The question is, whether the acts of Noah are an invasion of the private rights of Snowden, as the proprietor of the 'National Advocate,' or merely an exercise of the common right to print and publish a new journal, and to obtain for it patronage. . . . The only circumstance in this

[1] Hopkins's Ch. R. 347.

case which has any appearance of an undue encroachment upon the rights of Snowden is, that Noah's new paper is published under a name nearly the same with that of Snowden; but the name of the new paper is sufficiently distinct from the name of Snowden's paper to apprise all persons that these are really different papers. . . . I do not perceive that any person can be misled in this respect. . . . The good-will of an established trade, the custom of an inn, and the right of a publisher of books, may be injured by acts of deception and piracy; but the injury for which redress is given in such cases results from the imposture practised upon the customers of an existing establishment, or upon the public." It is evident that the chancellor did not contemplate the case as a mere infringement of a trade-mark right, or he would not have mingled the matters of an injury to trade, to the custom of an inn, and the right of a publisher of books. If he had regarded the name "National Advocate" as a trade-mark, then he must necessarily have passed upon the question, whether the name that the defendant had adopted was not an infringement of that trade-mark. Yet he chose to discuss the question in controversy under the comprehensive idea of an injury to the good-will. Therefore that case does not solve our inquiry.

§ 105. *Bell* v. *Locke*,[1] in the same court, before Walworth, Chancellor, in 1840, was a similar case. This case came before the court upon an order for the defendant to show cause why an injunction should not issue, restraining him from printing, publishing, or circulating a newspaper under the name of the "New Era," it being contended that such name was an infringement of the rights of plaintiff, who published the "Democratic Republican New Era." THE CHANCELLOR: "The allegation in the complainant's bill is, that the defendant has assumed the name of the complainant's newspaper for the fraudulent purpose of imposing upon the public, and supplanting him in the good-will of his established paper, by simulating the name

[1] 8 Paige, 75.

and dress thereof, with the intent to cause it to be understood and believed by the community that the defendant's newspaper was the same as the complainant's, and thereby to injure the circulation of the latter. If this were in fact so, I should have no difficulty in making this order absolute." He observed, further on in his opinion, that "there could be very little excuse for the editor of a new paper who should adopt the precise name and dress of an old-established paper, which would be likely to interfere with the good-will of the latter by actually deceiving its patrons."[1] This case comes closer to our notions of one involving the mark of trade or commerce; and although the chancellor used the term good-will and did not mention the term trade-mark, we conclude that the latter term was strictly applicable.

§ 106. In *Dayton* v. *Wilkes*,[2] at a special term of the Superior Court of the City of New York, in 1859, Hoffman, J., in regard to the right to use the name of "Porter's Spirit of the Times," said: "It has been very correctly argued, by the counsel for the plaintiff, that the analogy of the rules as to trade-marks should apply to this case." It is manifest that the court did not regard the thing in controversy as a mere trade-mark; nor was it necessary for the solution of the matter. We must look further.

§ 107. *Matsell* v. *Flanagan*,[3] at a special term of the Court of Common Pleas, in 1867, is of assistance in elucidating the mooted question. The plaintiffs were, and had long been the publishers and proprietors of the "National Police Gazette," which was commonly known to the public as the "Police Gazette." The defendants prepared and published a newspaper, in imitation of the plaintiff's newspaper, with nearly the same title and device, which misled and deceived purchasers. So the complaint alleged, and so the court found. The language of Brady, J., relieves us from any doubt as to the

[1] 8 Paige, 75.

[2] 17 How. Pr. R. 510.

[3] 2 Abb. Pr. R. (N.S.) 459.

class of wrongs to which he assigned a case of the kind. After reciting the power of the court in trade-mark cases, he continued: "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 or symbols, in such manner as may deceive them, by inducing or leading to the purchase of one thing for another." This case was treated as purely an infringement of a trade-mark; and the court, in commenting upon *Snowden* v. *Noah* and *Bell* v. *Locke*, treated it as a parallel case.

§ 108. *Stephens* v. *De Conto*,[1] at a special term of the Superior Court of the City of New York, in 1868, has a somewhat different complexion. The plaintiffs owned and published a newspaper called "La Cronica." The single question in controversy was as to restraining the publication by the defendant of the paper called "El Cronista." Monell, J., discussed some of the general principles of "good-will," and assumed the case to be of that nature, if indeed any right at all existed; and, in delivering his opinion, he wandered off into fields foreign to the real nature of the case presented. He said: "If this case was to be determined solely upon whether the similarity, if it could be established there was any, of the names 'La Cronica' and 'El Cronista' could mislead the public into the belief that they were the same, I should have no difficulty in reaching the conclusion, upon the evidence, that no such effect could or would result. . . . I do not understand that the protection which the law affords to 'trade-marks,' even assuming the name of a newspaper to be a trade-mark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over any thing that was the subject of a patent or a copyright, but is confined to appropriations of names designating some

[1] 4 Abb. Pr. R. (N.S.) 47, and 7 Robertson, 343.

particular manufacture or business. There can be no such property in a newspaper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and when given to the public all literary proprietorship in them is lost. And the law of trade-marks, like the law of copyright, cannot be applied to a work of so fluctuating and fugitive a character. *Clayton* v. *Stone*, 2 Paine, 392. I do not mean to say that a newspaper proprietor cannot appropriate, and, by long use, acquire a property in a name, which the courts will protect against piracy. In this respect the analogy of trade-marks would apply. *Dayton* v. *Wilkes*, 17 How. Pr. R. 510. And I have no doubt that the names, so long appropriated and used, of 'The New York Herald,' or 'The Sun,' would be protected as trade-marks, against the assumption of those names by another proprietor. But that I understand to be the extent of the rule, and that any mere assimilation of the name — unless it was clearly to deceive the public — would not be unlawful." The injunction was accordingly dissolved, and the complaint dismissed with costs. This opinion has been quoted a number of times on each side of the question, which is evidence that it has misled. Let us hastily analyze it. What was the point? It was this: Was the use of the name "El Cronista" an infringement upon the exclusive right in the name of another newspaper, "La Cronica"? The general contents of the respective papers had nothing to do with the contest. The judge said the protection given to trade-marks had not been extended over any thing that was the subject of a *patent* or a *copyright*. Nothing more true. But the name of a newspaper is not the subject of a patent or of a copyright, as we shall see hereafter in this treatise. But the judge expressly conceded that the long-used names of certain papers would be protected as trade-marks. That is our case, so far as this decision goes. With it is exhausted our American authorities on this point. We look in vain for an English case

that exactly touches the present question. *Hogg* v. *Kirby* [1] was cited in each of the foregoing discussions; but it does not help us in reaching a determination. In no instance have we the opinion of more than one chancellor or judge. Let us think whether the true principle cannot be deduced therefrom.

§ 109. The question recurs, Is the name of a newspaper a trade-mark? If not, upon what principle is it protected? The question arose in the Patent Office upon an application to register the name of a paper. It was suggested that, as the name had been copyrighted, protection must be sought under section 86 of the law in relation to copyrights.[2] It is there provided, that any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, &c., may, upon complying with certain specified conditions, have the sole liberty of printing, publishing, and vending the same, &c. The heading of said paper consisted of an ornamental *engraving* on wood, commonly known as a wood-*cut*. It was also a *print*. Did those literal facts determine the right? We will examine for ourselves. The librarian of Congress, not being a judicial officer in any sense, was not required to pass upon the legality of copyrighting the thing presented to him for that purpose. The fee was paid: the act was done. But does a mere newspaper-heading come within the spirit and meaning of the law? The Constitution [3] gives power to Congress "to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries." We can nowhere else find the power to legislate upon copyrights. The rights of inventors and authors, as long settled in Great Britain, were familiar to the framers of the Constitution; and, as Mr. Justice Story

[1] 2 Ves. 226.

[2] An Act to revise, consolidate, and amend the statutes relating to patents and copyrights, July 8, 1870.

[3] Art. I. sec. 8, sub-sec. 8.

says,[1] it is doubtless to this knowledge of the common-law and statutable rights of authors and inventors that we are to attribute this constitutional provision, being beneficial to all parties. It was beneficial to authors and inventors, because it maintained their rights to the product of their intellectual labor; and beneficial to the public, as it would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint. In short, the only boon which could be offered to inventors to disclose the secrets of their discoveries would be the exclusive right and profit of them, as a monopoly, for a limited period. A copyright is limited by time: a trade-mark is not. A copyright is limited territorially, but a trade-mark acknowledges no boundaries. They are unlike in their natures.

§ 110. Literature, invention, and the fine arts needed a fostering hand, and found it. The consideration paid by them for a monopoly was a surrender to the public after a limited time. The consideration was the coin of their brains. Authors! What claim has the adopter of a trade-mark to be considered an author? He may adopt any symbol, the sign of any thing in heaven above or in the earth beneath; it may be a representation of a real object, or it may be entirely fabulous. It does not require any genius for one to call a newspaper by the name of sun, moon, or star. The name of a newspaper is a sign to arrest attention, as it catches the eye. It points to something else. The heading is not offered for sale. Its office is simply to inform the public that the paper on which it is printed is the Herald, the Sun, or the Globe, as the case may be. The public care not a straw whether the heading be ornamental or plain; for the advantage in buying it is the intelligence, the editorials, the advertisements. The purchaser does not glance at the heading, the title, the name, except to be assured that he is getting the newspaper of his

[1] Story on the Constitution, vol. ii. § 1152.

choice. He takes no delight in gazing upon the name or heading as a work of art. But the copyrighted article is the thing that is sold. The book, the map, the dramatic composition, the engraving, cut, photograph, &c., is the thing bought. The name of a newspaper is but the guide to the thing. In the case of the heading of a newspaper, if its owner should elect to abandon it after a certain period, what value would he render to the public? Nothing. If considered as a work of art, what would be the measure of damages for infringement?[1] As a penal law, the statute must be strictly construed. Again, it would be absurd to suppose that Congress intended to include such a thing, from the requirement of deposit in the mail before publication,[2] a description of the article, and within ten days after publication the transmission of two copies to enrich the library of the nation. The heading of the "Herald" as a work of art! We cannot conceive a mere newspaper heading to be a subject for copyright.

§ 111. In *Stephens* v. *De Conto*, the judge mentioned "the subject of a patent," — meaning, doubtless, a design-patent. Is such a heading the subject of a patent? Examine: Mr. Upton, in his work on Trade-marks,[3] has taken the correct position in the construction of the Act of 1842, for patents for designs. The language, "any new and useful *pattern*, or print, or *picture*, to be either worked into or worked on, or printed or painted or cast, or otherwise fixed on any article of manufacture," &c., has been relied on as conferring a right to an exclusive privilege that may be made to serve the purpose of designating articles of merchandise. He says: "It is quite obvious that such was not the purpose of the law; but, on the contrary, it was manifestly intended that the *design* for which such protection was provided, should constitute a portion of the manufactured article, either as an ornamental adjunct, or as controlling its figure or proportions, by no means as a mere

[1] See sec. 100 of Copyright Law of 1870. [2] Sec. 90 same act.
[3] Albany, N. Y., 1860, pp. 17, 18.

name or designation by which to identify or distinguish the article." He maintains that the right thus acquired is in no sense a trade-mark property.[1] We must agree with him that the construction sometimes given to that act was quite unwarrantable. The design that is patentable is æsthetic. The mark of manufactures or of commerce is not essentially a thing of taste. The abstract symbol has no intrinsic value. The value is in the article to which it is affixed.

§ 112. The Supreme Court of the United States in its first trade-mark case, in 1872, said: "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."[2]

§ 113. In *Swift* v. *Dey*,[3] Robertson, Ch. J., said: "A patented design may be adopted as a trade-mark, by consent of the patentee, and thereby its use by others for the same purpose prevented. There is no rule, however, which makes the test of the infringement of such rights the same in both cases. The defendants may be liable in both the Federal and State courts: in the former, for imitating the design; in the latter, for passing off, by means of such design, spurious wares as being the plaintiff's: and the cause of action would clearly not be the same."

§ 114. Paxson, J., in *The Dixon Crucible Co.* v. *Guggenheim*,[4] expressed an opinion that "the name of a newspaper is a trade-mark, as much so as a label stamped upon a bale of muslin," although it is true that that was not the exact question before the court.

§ 115. From the foregoing train of reasoning, we deduce this conclusion: A newspaper, being a vendible article, is as much a matter of merchandise as any thing can be. It would

[1] See case of Whyte, Comr's Dec., 1871, p. 374.

[2] President, Managers, &c., of Del. & Hudson Canal Co. *v.* Clark, Patent Office Official Gazette, March 26, 1872.

[3] 4 Robertson, 611.

[4] 3 Am. Law Times R. (St.) 288, and 2 Brewster, 321.

not be bought unless it contained or bore an authenticating sign. That sign is its name. Each issue may be ephemeral, and be at once consumed; but the name, its emblem, is permanent and invariable, and is the stamp of genuineness. We see, therefore, that the Office was unquestionably right in admitting the name of a newspaper to registration as a trade-mark.[1]

§ 116. **Trade-marks on Books.** — Can printed books be protected by trade-marks? Yes, as mere merchandise; no, as literary productions. They are articles of manufacture, and may bear a particular mark to designate their author, or the merchant who sells them. Sometimes they are impressed with a peculiar symbol, to indicate the place of sale: but not so much so as in preceding ages, especially the sixteenth and seventeenth centuries, and the earlier portion of the last; for then every shop had its emblematic sign, as a dolphin, a lion, the king, &c., and a representation of that sign indicated the place of sale quite as well as could the name of the merchant or publisher. The mark of the dolphin, for example, would satisfy the purchaser, for he would reflect that he had always obtained correct editions of books at that place — the Dolphin. In Savary's "Dictionnaire Universel de Commerce,"[2] we find that in France, and probably in other European countries, the legalized mark of a bookseller was an image placed by him under the title of a book, or on the first page thereof. This establishes the fact that books were regarded as proper objects for the reception of trade-marks.

§ 117. But it must be borne in mind that it is as merchandise merely, and not as intellectual creations, that books are protected by the mark of commerce. Why so? Because a book, as such, has its protection under the copyright law. If printed, ample remedy is afforded by the copyright law of July 8, 1870.

[1] F. C. Barksdale, No. 424 ("Our Society").

[2] Copenhagen, 1761, title *Marque*. (Under this head may be found much interesting information in regard to the compulsory use of trade-marks in the various branches of manufactures.)

That is the security which the Constitution and the statute provide for infringement upon works of literary genius, even though the pirate change the title of the book, and, as it were, hoist a false flag. It is the contents of the book that would be copied, and not its emblem, title, or mark.

§ 118. There seems to be no sufficient reason why the title of a book may not be deemed a valid trade-mark; *e. g.*, when, two centuries ago, in England, the five Presbyterian divines (Stephen Marshal, Edward Calamy, Thomas Young, Matthew Newcomen, and William Spurstow) combined the initials of their names, which made the word SMECTYMNU-US, and adopted it as their joint signature, they had a valid trade-mark if they had chosen to use it as such. It was good for the publication bearing that name, and would be entitled to protection as a trade-mark for any books the owners of the newly coined word might offer for sale.

§ 119. Here is a case which is usually classified with trade-mark cases; but, if we keenly scrutinize and analyze for ourselves, we may conclude that, although of the nature of a trade-mark, the thing in controversy has but little claim to the name. We examine *Williams* v. *Johnson*,[1] before the general term of the Superior Court of the City of New York, in 1857. Under the principle that a rose by any other name may smell as sweet, the court contented itself with rendering substantial justice, without caring about too much nicety in terms. We will soon be able to answer this pertinent question: Is not this an instance of unfair competition in trade, by means of false labels? A wrong was done. Let us try to name it.

§ 120. The plaintiff alleged that, in or about the year 1845, he and his brothers were manufacturers of soap at Manchester, Conn., and made a particular kind of soap, to which, in order to identify it as their manufacture, they gave the name of "GENUINE YANKEE SOAP." It was made in cakes of about two inches square, each cake covered with tin-foil; upon one side

[1] 2 Bos. 1.

of each cake was attached an octagonal pink label, with the words printed thereon: "GENUINE YANKEE SOAP, *manufactured at Manchester, Conn., by Williams & Brothers, Chemists and Apothecaries. To prevent counterfeits, their signature will be upon each cake.*" Upon the other side of each cake was attached another octagonal pink label, with the words printed thereon: "THE GENUINE YANKEE SOAP *is warranted superior to any foreign compound for shaving and the toilet, affording a copious and heavy lather, which does not dry on the face, leaving the skin soft and smooth.*" And at one end of each cake was attached another pink label with the words in writing, or in resemblance to writing: "*Williams & Bros.*" The said soap was put up in pasteboard boxes, containing one dozen cakes each, and each box was covered with a brown paper wrapper, with the words thereon: "One dozen Genuine Yankee Soap, warranted superior to any foreign compound for shaving and the toilet. Manufactured at Manchester, Conn., by Williams & Brothers, Chemists and Apothecaries. To prevent counterfeits, their signature will be upon each cake."

§ 121. It was alleged that the defendant manufactured soap of an inferior quality, put up in a style and manner precisely similar to the plaintiffs'; that it was cut up into cakes of the same size as those of the plaintiffs', each cake encased in tin-foil; and upon each cake were three labels of the same form as the plaintiffs'. Upon one were printed the words: "GENUINE YANKEE SOAP, *manufactured at New York, by L. Williams & Co. To prevent counterfeits, their signature will be upon each cake.*" Upon another were printed the words: "THE GENUINE YANKEE SOAP *is warranted superior to any foreign compound for shaving and the toilet, affording a copious and heavy lather, which does not dry on the face, leaving the skin soft and smooth.*" And upon the third were the words, in writing, or in a resemblance to writing: "L. WILLIAMS & Co." Each box was covered with a brown paper wrapper, with the words thereon: "*One Dozen Genuine Yankee Soap, warranted superior to any foreign*

compound for shaving and the toilet. Manufactured by L. Williams & Co., New York. To prevent counterfeits, their signature will be upon each label." Upon these several labels the arrangement of the lines, the form of the letters, and style of printing were, in almost every particular, an exact copy of the labels used by the plaintiffs. It was further alleged that the name of L. Williams & Co. was fictitious, and used to deceive.

§ 122. The defendant's answer denied that the plaintiffs had any exclusive right to use the designation "*Genuine Yankee Soap*," averring that that term described a particular style and quality of soap, and did not identify the person or persons by whom, or the place where, it was manufactured; and that the article known in the market by that name had been for years manufactured by different manufacturers of soap in different parts of the United States, and sold by that name, and could not be appropriated by the plaintiffs. It further denied that the name L. Williams & Co. was fictitious, or used as a colorable imitation, assimilating the trade-mark of the plaintiffs, and deduced the title of the defendant to its use from a firm of that name, who had assigned the business and name to the defendant.

§ 123. An injunction was granted at special term, restraining the defendant from "selling, or in any way disposing of any soap in boxes or otherwise, with labels or wrappers containing the words 'Genuine Yankee Soap' printed or written thereon; and from advertising, selling, or offering to sell, any soap whatever (unless the same has been manufactured by or procured from the plaintiffs), as and for the 'Genuine Yankee Soap,'" &c. From the order so made, the defendant appealed.

§ 124. In delivering the opinion of the court *in banc*, Woodruff, J., said: "The defendant is engaged in a gross and palpable endeavor, by imitating the marks and labels used by the plaintiffs, to deceive the public, and obtain patronage which would in all probability be attracted to the plaintiffs. This the defendant is doing, not only by closely imitating the plaintiffs'

marks and labels, but by falsely representing his soap as a Yankee manufacture, and made by persons named Williams, when, in truth, it is made in the city of New York by the defendant, William Johnson." After characterizing the acts of the defendant as a fraud upon the plaintiffs, the learned judge said of the latter: "They have adopted, in reference to *their* manufacture (of an article which any and every one may manufacture and sell, if he please), a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior handbill upon the box, and have so arranged the whole as to suggest to any one desiring to purchase their soap, upon an inspection, that the article is theirs, and made by them, like that heretofore made, sold, and known as their manufacture. All this the defendant has copied, with an exactness which is calculated to deceive even the wary, much more to entrap those who are not in the exercise of a rigid scrutiny. It is true that the defendant has put upon his labels New York as the place of manufacture, and L. Williams & Co., instead of Williams & Brothers, as manufacturers. But the latter designation imports a falsehood, and tends rather to create than destroy the impression that the soap is made by the plaintiffs; and the use of the word New York, in its obscure printing, if it be read, falls far short of suggesting to the public that it is not the soap manufactured by the plaintiffs. Whether upon taking the proofs in the cause it will appear that the particular words, 'Genuine Yankee Soap,' are to be deemed descriptive of the kind of soap which any one may make and sell by its proper name, or are terms properly designating the plaintiffs' manufacture, and so to be descriptive of their peculiar skill in making an article already in known and common use by its proper and only generic name — soap — is perhaps not free from doubt. It is quite clear that so far as it indicates the place of manufacture, it is a fraud on the part of the defendant to use it. . . . Without deciding whether the defendant may or may not use

either of the words 'Genuine' or 'Yankee' in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or handbills which he is using, nor any other like labels, devices, or handbills used by the plaintiffs, as set forth in the bill of complaint, or any other similar labels, devices, or handbills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap."

§ 125. A nutshell could contain this case, so far as trade-mark law is concerned. None of the words on the plaintiffs' labels are susceptible of being turned into trade-marks, except "Genuine" and "Yankee." The court did not decide their nature. It was not necessary so to do. We are warranted in going one step farther. Neither of those words can be made a trade-mark, nor are they such when combined.

§ 126. In the endeavor to ascertain the true nature of a trade-mark, we will examine *The Leather Cloth Co.* v. *The American Leather Cloth Co.*[1] The plaintiffs' alleged trade-mark reads as follows: "CROCKETT INTERNATIONAL LEATHER CLOTH COMPANY. NEWARK, N. J., U. S. A. WEST HAM, ESSEX, ENGLAND," which words formed a circle. Within and near the top of that circle is the representation of an American eagle, with outstretched wings, and, over the eagle, the word "Excelsior." Below the eagle are the words: "CROCKETT & CO. TANNED LEATHER CLOTH. PATENTED JANY. 24, 56. J. R. & C. P. CROCKETT, MANUFACTURERS. + 12 YDS. +." Besides that, within the circle are two other similar crosses, and this character from the printer's font: —+—

§ 127. To enable a party to obtain the intervention of a court for an infringement of a trade-mark, he must first establish the fact of his having a trade-mark. He cannot apply that name to any thing that he chooses, despite its utter lack of suitableness for the purpose. The law will examine and apply the proper term of the thing presented.

[1] 11 Jur. (N.S.) 513.

Now, what is the essential constituent element of this stamp? Is it the eagle, the words, or both? We must not be misled by the application of the term trade-mark to the whole stamp, or label, even by a court. In the House of Lords, on appeal from the Lord Chancellor, Lord Cranworth said: "The plaintiffs' trade-mark, if trade-mark it is to be called, is contained in a circle. . . . Each of the trade-marks, it is true, as well that of the plaintiffs as that of the defendants, contains within its periphery an eagle, but not at all resembling each other. The rest of the device, if it is to be called device, consists merely of words intended to indicate the nature or quality of the article, the place of its manufacture, and the names of the manufacturers." Lord Kingsdown, in the same case, uses this language: "The plaintiffs' trade-mark, or what they call such," &c. It is undeniable that he used the term trade-mark to indicate the subject before the court; but it was not necessary to define that particular subject. The term was a convenient one by which to express the collocation of words and the eagle. The real question under consideration was, whether the defendants had been guilty of a fraud upon the public, in selling their goods as the plaintiffs'. The Lord Chancellor, whose decision was in process of affirmation, then rose to speak. His language, as to the matter of defining, relieves us from embarrassment. He saw the necessity of giving the alleged trade-mark its true name. He said: "I am satisfied that I assigned for my decision in the court below a ground narrower than I might have taken as the basis of that judgment. There were circumstances which induced me to think that it was necessary to consider the case from the particular point of view which I adopted, and having found that the ground was sufficient for the judgment which I gave, I did not enter into the consideration of the wider view of the subject, which has been so forcibly urged by my noble and learned friends. But, in truth, my lords, not only do I concur with them, but I am satisfied that I ought to have regarded this affix to the plaintiffs'

goods, which is here denominated a 'trade-mark,' as something which, according to the anterior usage and application of the word 'trade-mark' by no means resembles or comes within the description of any thing that has hitherto been properly designated by that name. What is here called by the appellants a 'trade-mark' is, in reality, an advertisement of the character and quality of their goods; and, dropping for a moment all reference to the incorrect and untrue statements contained in that advertisement, I will take only what is called the 'trade-mark' of the plaintiffs and the rival or antagonistic trade-mark of the defendants, and compare them together, taking them as if they were simply — what in reality they are — two advertisements, each affixed, by way of label, to the articles manufactured by the parties respectively. . . . The advertisement is the sole foundation of the plaintiffs' case, and their allegations must be reduced in substance to this: that having advertised and described their goods in a particular manner, the defendants have borrowed their advertisements and described their goods in substantially the same manner."

§ 128. What language could more clearly convey the idea that, independent of the two eagles, there was not one ingredient of a real trade-mark in either of the labels presented? The distinction between a mere advertisement and the technical commercial emblem is important.

§ 129. An abstract right in a symbol has no existence. The subject must be considered in its concrete relation. Herein a trade-mark differs from a patent or a copyright. The former exists the instant it is issued; and the latter as soon as entered. The patentee, or the author, may not choose to immediately avail himself of the benefits of the grant; and still the right exists in full vigor, unless, of course, the invention or the book be dedicated to public use by abandonment. But the registry of a trade-mark does not *ipso facto* make the mark, but merely operates as evidence of adoption, and the right to it is inchoate, and does not become a perfect right until the owner con-

summate his intention and stamp the symbol upon an article of merchandise which he desires to sell. When that is done, he will have entered into possession of the exclusive right to affix that particular symbol to the class of goods to which it has been appropriated. The symbol and the article for sale are complements of each other; and it would be as illogical to term such symbol a trade-mark before affixing it to goods in trade as to term one's loose autograph his signature, although the exact representation of the signature which he intends to apply to an instrument in writing.

§ 130. A trade-mark is nothing more nor less than one's commercial signature to his goods; and the mark and the goods bear the same relation to one another as do the positive and the negative forces of electricity to each other; and in their apposition they mutually uphold and sustain. We must be cautious to discern between things whose natures differ, and assign to each its peculiar and appropriate sign, by words which fit close to the thoughts, or the mind will be confused by a jumble of marks of commerce, of patented designs, of copyrights, of labels, of advertisements, and other matters of incongruous natures. A definition should instantly convey the true idea of the thing, and indicate the precise species of a genus. A trade-mark is in its nature separate and distinct from every thing else in the world; and yet we frequently hear of writers, lawyers, judges, by the most heedless use of the term, leading others into error. Things must be called by their right names. A homicide may mean a murderer amenable to criminal law; or he may be one whose action was justifiable as necessary to the preservation of his own life; or a sheriff reluctantly carrying into execution the sentence of a court; or a soldier in the performance of imperious duty. *Astrology*, in its etymological signification, is the science of the stars, and among the ancients it was synonymous with *astronomy*; yet no thoughtful person would confound the two terms at the present day. Before the nice distinctions connected with

the law of trade-marks were well understood, learned jurists, who adorned the bench, might have been pardoned for ambiguity of expression, in confounding labels and marks; but the time for palliating such carelessness is past, and the particular symbol of commerce must be carefully distinguished from its analogues.

§ 131. The sciolist asks, Why need we seek the technical name? Cannot justice be applied under one name as well as under another? Rights are rights, says he, whatever name they bear; and the tendency of this utilitarian age is towards simplification, so that one comprehensive term may signify many things. Now, what necessity is there for the loose, indefinite application of a scientific designation, so that it may signify many things, perhaps of natures very unlike? It may be, indeed, that in some cases the paucity of terms of art or science compels a plurality of uses for one word; but as regards our present subject, no such necessity exists. We must be exact in specifying the name of any kind of legal right, in order to obtain the remedy that the law prescribes for a given case. Generic terms must be avoided. For example, in a statute to punish horse-stealing, we would not use "horse" and "animal" as convertible terms, for the word "animal" might mean a cow, a sheep, a hog, or a dog. To prevent confusion, we must say exactly what we mean. We would not charge a person with the commission of a crime; but would specify the exact offence imputed to him. We must seek to ascertain the peculiar physiology of the thing; then its proper designation is the key that unlocks many of the secret places of the law connected with it.[1]

§ 132. This question may be asked: If labels, *e. g.*, are not technical trade-marks, why permit evidence of their contents to be introduced, as is done in many cases? For this reason: although labels are not constituent elements of trade-marks, and are but vehicles for the same, all the details may

[1] See Physiology of Contracts: Anthon's Law Student.

be proven as surrounding facts, — *circum stantia*, — and should be brought forward as witnesses of a fraudulent intention. It must be conceded that any one may lawfully copy another's signature, or emblem of personality, and may publish it to the world; but if, in addition to the act of imitating, he use it in a peculiar manner to obtain a false credit, as by applying it to merchandise intended for sale, then his intent may be inferred from all the minor facts. The maxim, *noscitur a sociis*, is applicable. It is known by its companions: it is discoverable by what precedes and follows.

§ 133. We know that mere labels, notices, advertisements, and business-cards possess none of the essential characteristics of the common-law symbol of trade, and therefore are not entitled to registration. For that reason, a label reading, "For Sale at Record Office, Topeka;"[1] or one with "Gold Medal Clothing," for a legend to be affixed to wearing apparel;[2] or "Schenck's Water-proof Tags and Labels;"[3] or the name of manufacturer, place of business, and description of goods, stencilled or painted, or labelled on said goods, would be rejected by the Patent Office as not being technical marks of manufactures or commerce.

§ 134. In one case, the applicant, a corporation created by authority of the State of Pennsylvania,[4] for the purpose of manufacturing and selling "fruit-jars, bottles, and other vessels which are automatically and hermetically sealed when full," claimed the simple name of "Valve Jar," which was the true name of the thing made and sold by them. Those words on a label could not have the magical effect of transmuting the label into a thing of another nature. The application was rejected. So, also, where the proposed mark consisted of the words "Musical Note Paper," and the name and residence of the manufacturers of a certain kind of note-paper.[5] A few

[1] Crane & Byron, *ex parte*.
[2] Hammerslaugh & Co., *ex parte*.
[3] C. S. Schenck, *ex parte*; Atlantic White Lead Co., *ex parte*.
[4] Valve Jar Co., *ex parte*.
[5] Schmidt & Curtius, *ex parte*.

bars of music were printed upon the first page of each sheet, as a fanciful heading. The counsel ingeniously argued that there was nothing descriptive in this designation, as the paper could not truly be termed *musical*, and that the words were not a mere label, but in verity were an arbitrary symbol, — a good trade-mark. Rejected.

§ 135. The words "Johnson's American Anodyne Liniment" shared the fate of the preceding case, and upon the same grounds.[1] The answer to the application was that any person by the name of Johnson has a perfect right to make and vend liniment, anodyne liniment, American liniment; and, in offering it for sale, to call it by its proper name. The right to the use of the combination of words not being exclusive, said words could not be a trade-mark, being merely a label or advertisement, and nothing more.

§ 136. A slight degree of hesitation was felt in rejecting the words "True-fit Shirts," and "Cable-stitched Kid Gloves;" but upon reflection it was decided that these combinations of words expressed the correct names of the articles to which they were affixed, and were but the use of ordinary language, free to all who sell true-fitting shirts and gloves made with the cable-stitch.[2]

§ 137. And still more hesitation was experienced when were filed the words "James Hennessy, Cognac,"[3] as a mark used upon brandy by the applicants or their predecessors in business for fifty-five years. This seemed to be a matter of hardship. Yet for more than half a century the firm had mistaken a mere label for the time-honored, dignified trade-mark. Remedy for its violation must be sought under local laws, or under the general powers of a court of equity for unfair competition in trade.

§ 138. If one claim titles of firms, or names of manufactures, to which he shows no vested right, he will not be

[1] I. S. Johnson, *ex parte*. [2] Two cases, Fisk, Clark, & Flagg, *ex parte*.
[3] James Hennessy & Co., *ex parte*.

deemed to possess even a label. As an instance of persons seeking their own discomfiture, while swelling the revenue of the Patent Office by one hundred dollars, read this: Four applications.[1] Claims,—the words "Bristol Watch Co., Bristol, Mass.;" "G. M. Wilson, Chicago, Ill.;" "New England Watch Co., Providence, R. I.;" and "Chicago Watch Co., Chicago, Ill." These names, said the applicants, are used upon watches and watch-movements; and this same petition states that no other person, firm, or corporation has a right to the use of said trade-marks, or of marks substantially the same. Not even substantially the same! Rejected.

§ 139. **What is Merchandise?** — This seems at the first glance to be a puerile question; and yet it is one that has sometimes puzzled experienced men of business. We all know that it means the objects of commerce: whatever is usually bought or sold in trade, or market, or by merchants; wares, goods, commodities. Yet a case may easily be supposed where the question cannot be answered without hesitation, when considered in its relation to a trade-mark.

§ 140. This question came up in the Patent Office, in 1872, in an application for a design-patent for a label with a coupon attached.[2] The whole value of the label depended upon the peculiar configuration, and was intended to be sold to manufacturers of a certain kind of paper collars, &c. He who bought that label thereby obtained a license to sell that particular kind of goods, and at the same time he had furnished to him a certificate of good workmanship. Now, what was intended to be sold? It was the label. But the label would have been incomplete without a peculiar mark. Then that peculiar mark could not be considered to be a trade-mark, strictly speaking; for a trade-mark is merely the index to something that is offered for sale. In this case, it was actually incorporated into, and became an essential component part of the com-

[1] Louis Strasburger & Co., *ex parte*.
[2] C. C. Morgan, assignor to Union Paper Collar Co. of New York.

modity. That answers the requirement of the law in relation to designs. The label was a design, — a matter of configuration of a new and useful article of manufacture; and without the peculiar mark it would have no more served its destined purpose than would a college diploma without signature. After deliberation, the matter was decided to be a design.

§ 141. In the Court of Paris, in 1859, *Lalande et al.* v. *Appel et als.*,[1] it was decided that tickets or labels, composed and sold by a lithographic printer, could not be considered as trade-marks. The plaintiffs, lithographers, complained that the defendants had counterfeited the designs upon tickets or labels destined to be sold to vendors of liquors and cosmetics, to be placed by them upon flasks or bottles. The defendants, as a point of law, contended that the plaintiffs had no right to recover, for the reason that the designs upon the tickets were neither designs of manufactures, nor marks for the same in the sense of the law of 1793. The reasoning of the court is perfectly convincing. Among other matters, it was *held*, "That the plaintiffs' claim was ill-founded, because the tickets in question were the special objects of their commerce, and therefore could not be regarded as trade-marks; that the trade-mark, regulated by the law of the 25th of June, 1857, is the characteristic sign by means of which commerce distinguishes the products of fabric or objects of commerce; that the mark itself cannot be an object of commerce; that, by the use which a merchant makes of a ticket, in applying it to a vase containing the product of his manufacture, it is possible that the ticket may become for him a trade-mark, — subject to the fulfilment of all legal formalities, — for it may be then, as to him, a sign or distinctive seal of his products, without being the very object of his commerce: but, as to the plaintiffs, the tickets can be nothing but the special object of their industry. Judgment for defendants. On appeal, the decision was affirmed.

[1] Annales de la Prop., etc., tome 5, p. 248.

§ 142. The same question was considered in a case in the Patent Office, where a lithographer [1] applied for a trade-mark to be affixed to labels manufactured and sold by him to merchants and others. It appeared, however, that he intended the mark to be stamped or printed upon the label, not as a constituent element, but as a sign of authenticity. Under that view of the matter, a certificate of registry was allowed.

§ 143. **Essential Characteristics.** — There are certain infallible indicia of the nature of the symbol known to commerce and jurisprudence as a trade-mark. These are: 1. *Invariability*, *i.e.*, fixed, positive, unmistakable; 2. *Individuality*, such a difference from other symbols as to indicate origin and ownership; 3. *Universality* of a right to its use, *i.e.*, good as a representative of, or substitute for, the owner's signature all the world over; 4. *Exclusiveness* of the right to use; 5. *Application to merchandise;* 6. *Use in lawful business;* 7. *Truth and good faith;* 8. *Duration unlimited* but by the trade itself. (*Protection*, however, may sooner cease.) [2]

[1] Samuel Crump, Cert. No. 637.

[2] Sec. 78, Act of July 8, 1870.

CHAPTER IV.

INDICATION OF ORIGIN OR OWNERSHIP.

Meaning of Phrase. — Disagreement of Judges. — Name or Address of Manufacturer or Trader not necessary Ingredient of Mark. — Use of word "Quality." — Designation of Occupation or Trade cannot be exclusively appropriated. — Chemical Products, Names of. — A Man's Name may lose Idea of Personality. — Instances: Names of Medicines, Boots, Carriages, Guns. — Geographical Names as Trade-marks.

§ 144. **Indication of Origin or Ownership.** — This is a phrase that of late years has been the source of much perplexity, simply because not understood in its legal acceptation. The Supreme Court of the United States, in *The President, &c., of the Del. & Hudson Canal Co.* v. *Clark*,[1] repeated a proposition that as a rule has been frequently enunciated, and settled beyond question, viz.: The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer.

§ 145. The difficulty is this: What does distinctively indicate such origin or ownership? That question can be intelligently answered only after the examination and collation of many adjudications. Each case necessarily depends to a great extent upon its own peculiar surroundings. What might indicate origin in one matter might not in another. Sometimes the name of a proprietor or of a place is required to clearly convey the indication; again, any simple device may

[1] Patent-Office Official Gazette, March 26, 1872.

by association with a particular person or place convey all the information required. What impression does the mark of commerce leave upon the vision of the beholder? What associations are called up by the sound of a word? A purchaser usually instantly recognizes a symbol, and buys on its faith, just as one might purchase bonds of the United States upon the most superficial glance. He asks for a 10-40, a 5-20, or a 7-30, and does not think of keenly scrutinizing its various indicia of genuineness. Its origin is clearly indicated. He has not the slightest suspicion that the thing a broker sells to him has been simulated. One buys a barrel of flour or a fancy toilet article with the same apparent carelessness. The true test is confidence. The brand, or the mere name of the article, satisfies him. Good faith is the bond of commerce; and without it doubt and hesitation will fetter enterprise and restrain trade.

§ 146. The words "Congress Water" were held by the New York Court of Appeals, in *Congress and Empire Spring Co.* v. *High Rock Congress Spring Co.*,[1] to appropriately indicate both the origin and the ownership of the water flowing from Congress Spring, to which place the plaintiffs had the sole title. The defendants' counsel argued that the words, as applied to a natural element, were an inexplicit name, expressing no idea of property or origin, and that the said mark lacked the essential elements, being used to designate the article itself by its proper appellation, therefore not the subject of exclusive appropriation; that, in fact, it expressed no more than the name of the spring, like "Avon Springs," "Lebanon Springs," "Sharon Springs," and "Cheltenham Springs," being names of particular fountains, indicative only of the place whence they issue. It was also insisted that the doctrine of trade-marks has never been applied, and is not applicable, in letter or in spirit, to the sale of spontaneous natural products of substantially the same nature, being appropriate only to arti-

[1] 57 Barb. 526; 4 Am. Law Times R. (St.) 168.

ficial compounds, or products, originated by the science, or skill, or diligence of man; and that this water, not being the creation of man's skill or industry, but being the gift of nature to all, no one could bottle and name the elements, and claim exclusively the new appellation by which they have become known in the market. It was said by counsel that one might as well bottle the pure air of the mountain, and prevent another from selling the same air by the same name. A preliminary injunction having been dissolved at special term by Rosekranz, J., the plaintiff appealed to the general term, which affirmed the action of dissolution. James, J., in rendering the opinion of the court *in banc*, said that he was not aware that the question of the application of the law of trade-marks to names given to spontaneous or natural products had, prior to that time, ever come before the courts for adjudication; and that, in all the cases, the principle of the law is stated and restated, as applicable to protect the skill, industry, and enterprise of mechanics, manufacturers, and inventors, and hence only applicable to artificial products. He seems to have excluded from consideration the idea of commerce, which may deal in commodities with which the skilled industrial classes have nothing to do; and which, although natural products, as coal, marble, or animal deposits, like guano, have distinctive marks entitled to protection. The case went to the highest court. The true principle involved had by that time become clearly apparent.

§ 147. The Court of Appeals considered these two questions: 1. Can the owner of a peculiar product of nature be protected in the exclusive use of a name belonging to it alone, and employed by him as his trade-mark in the sale thereof? 2. Does the name or trade-mark used in the case before us by the plaintiffs indicate the origin, ownership, or place of that product, and is it one in the exclusive use of which the plaintiffs should be protected? The court, by Folger, J., said, *inter alia*, that here is a particular article of which the owners

of this spring possess the only source, and which can be had only from them. The violation and the wrong are the same whether the commodity is one which the hand has made, or which Nature has put into the hand of man. Certainly so, if into the hand of but one man has it been put. It is a matter of property, and the profitable use of property. If one use the name of another for the purpose of securing to himself, in the disposition of property, advantages which belong to that other, the fraud is complete, and the remedy ought to be complete. By the application of capital, business sagacity, and enterprise, this spring and its products have become extensively known, and favorably received. When one wishes for the medicinal water which he has used before, he inquires for it by its specific name. And it is this name, the trade-mark of the plaintiffs, which is the short phrase between buyer and seller which indicates the wish to buy and the power to sell water from that origin, that place, of that ownership. This phrase, this device, is the trade-mark of the plaintiffs, and is of value to them, as thus designating the verity of its origin. They have the right to be protected in its exclusive use, for none other can use it with equal truth, and none other has equal right to employ it for the same purpose. *Held*, the words "Congress Water" are, under the circumstances set forth, a valid trade-mark indicating origin, and also ownership. The judgment below was reversed, with costs, and a new trial ordered.

§ 148. In *Falkinburg* v. *Lucy*, before all the justices of the Supreme Court of California, in 1868,[1] the court said that the owner of a mark would be protected in its exclusive use, but only so far as it serves to indicate the origin, or ownership, of the goods to which it is affixed, to the *exclusion* of such symbols, figures, and combinations of words which may be interblended with it indicating the name, kind, or quality of the article. In this case, the plaintiffs claimed the entire label as their

[1] 35 Cal. 52.

trade-mark, and asked to be protected in the use of it as a whole. The court said: "Only so much of their label as serves to indicate that they are the manufacturers or vendors of the washing-powder can be considered as constituting the legitimate characteristics of a common-law trade-mark." The symbol must tell its own story. It does not serve its intended and true purpose until associated with a certain person or article. In *Filley* v. *Fassett*, before the Supreme Court of Missouri, *in banc*, in 1869,[1] it was held that the words "Charter Oak," cast on cooking-stoves, were sufficient to point out the true source and origin of the stoves, and were therefore possessed of the requisite characteristics of a trade-mark. In *Fetridge* v. *Wells*, in 1857,[2] Duer, J., held that the words — "The Balm of Thousand Flowers" — might suffice for this purpose, unless, of course, they were descriptive or fraudulent. *Boardman* v. *The Meriden Britannia Co.*, in the Supreme Court of Connecticut, in 1868,[3] fully recognizes and enunciates this doctrine.

§ 149. As an instance of the disagreement of judicial minds as to what in contemplation of law constitutes indication of origin, we will cite *Ferguson* v. *The Davol Mills*, in the Common Pleas of Philadelphia, in 1868.[4] The facts are briefly these: More than thirty years before, the complainants devised, and ever since used for certain goods, known as silesias or bleached and dyed cotton twillings, a certain mark, which consists of a circular label with the letter "K" in the centre, which letter is surrounded by plain lines and ornamental tracings, extending outward from the centre, and having nothing on it except the printed letters "No." at the top, and at the bottom of the same space the letters "Yds." By long use this mark had become identified with the said goods, and the goods came to be known in the markets of the world, and to the trade everywhere, by the said mark, and are

[1] 44 Mo. 173.
[2] 4 Abb. Pr. R. 144; 13 How. Pr. R. 385.
[3] 35 Conn. 402.
[4] 2 Brewster, 314; and Leg. Int., Jan. 1, 1869.

known and called by the name of the "K" silesias. The defendants manufactured and offered for sale goods similar in appearance, but greatly inferior in quality to the complainants' "K" silesias, put up in wrappers similar to theirs, and a counterfeit of their label and mark. The defendants asserted that the use of the letter "K" and accompanying device, as printed by the complainants and pasted on their goods, did not constitute a trade-mark such as the law will protect. Allison, P. J., said: "The device and letter 'K,' which constitute the alleged trade-mark, have no name, words, signs, marks, by which in any possible manner or degree the origin or ownership of the silesias manufactured by the complainants are indicated, or the place of sale or manufacture pointed out, to distinguish them as the goods manufactured or sold by the complainants. And, failing in this, it follows that this application for an injunction cannot be granted. And this will justify itself when it is remembered that these circular lines and spaces, and intervening ornamental tracings and letter 'K' in the centre, with elliptical cross lines upon its face, affords no protection to the public against imposition by the complainants from the sale of a spurious or inferior article of silesia. They could flood the market with such inferior article, stamped with what they call their trade-mark, and the public would be wholly unable to ascertain who had manufactured and sold the goods. Protection is given only in consideration of the guaranty of the integrity of the manufacturer or merchant, certified by his trade-mark. When the device fails to accomplish this end, it is no trade-mark, and all claims founded thereon must be rejected. The simplest case of a trade-mark is the name and address of the claimant; and it is absolutely requisite that a device or symbol should perform the office of a finger-board: should indicate the name and address of the manufacturer, to invest it with the attributes, and entitle it to the protection, of a trade-mark. The device of the complainants does not contain, within itself, a

declaration to the public that Ferguson Brothers are the manufacturers of the silesias stamped with their device: it points to any other person as clearly as to them, and therefore it is obvious that the Davol Mills, or Fales, Wharton, & Co., in imitating this device and placing it on an article of silesias of their own manufacture and sale, have committed no legal wrong of which Ferguson Brothers have any right to complain. The morality of the use by them of the simulated label is another question; for simulated it is, beyond all doubt,— so much like the original as to be scarcely distinguishable from it." Injunction refused.

§ 150. This decision is *sui generis*. The course of reasoning of the learned judge does not commend itself to any calm, thoughtful intellect. With all due deference to the opinion of Judge Allison, criticism is imperatively demanded; for it is the emanation of a respectable tribunal, and cannot be silently acquiesced in without positive injury to the cause of justice. It has been quoted in more than one case by counsel driven to desperate shifts, and has been strenuously urged as an authority. He has said that the device of concentric circles enclosing the letter "K" does not in any possible manner or degree indicate origin or ownership. Why not? Because, said he, the place of sale or manufacture is not pointed out; and he intimated that the device, to be a valid trade-mark, should contain the name and address of the claimant. If so, how could a great number of symbols reported in adjudicated cases have been recognized as perfectly valid, when those symbols were no more expressive than that under discussion? As instances, consider the distinctive names and designations "Excelsior," "Climax," "Empire," "Charter Oak," which were deemed perfectly good trade-marks for stoves;[1] the word "Excelsior," for soap;[2] "Ethiopian," for stockings;[3] "Cocoaine," for hair-oil;[4] "A C A,"[5] which the court virtually held might be a valid trade-mark.

[1] 44 Mo. 173. [2] 9 L. T. R. (N.S.) 199. [3] 10 Jur. 106.
[4] 3 Keyes, 594. [5] 2 Sand. S. C. 599.

§ 151. Not one of these cases indicated the name, or even the address, of the manufacturer, or of the merchant. Yet they fully answered the legitimate purposes of a trade-mark. The judge said that the symbol in the Davol Mills case was no protection to the public against imposition by the complainants from the sale of a spurious article; for they could flood the market with an inferior article, and the public would be wholly unable to ascertain who had manufactured the goods. Now, a trade-mark to be worth any thing must be recognized by the public, and must be associated with a particular person or firm, so that the purchaser instantly says in his own mind, That is the article I wish: I know it is genuine, because it bears the well-known mark of So-and-so. What is the logical deduction of the judge? The mark is not associated in the mind with anybody or any place. It has not the slightest intimation of origin. By looking at it, the public cannot possibly guess who made the goods, or where they were made, or who offered them for sale. It promises nothing. No faith is given to it; for it is absolutely meaningless. It is virtually a blank. Well! the public not recognizing the symbol as any man's manufacturing or commercial signature, and perceiving in it no guaranty of the integrity of the manufacturer or merchant, yet bestow upon it the most implicit confidence! Through their infatuation the market is flooded! We answer, if the public buy on the credit of the mark, that is the highest evidence of its validity. Knowing the currency of their mark, its owners strain every nerve to sustain its reputation. To send out spurious goods with its impress upon them, would be to kill the goose that lays the golden egg. We must conclude that his Honor erred. If its thirty-year-old reputation had not made the symbol valuable, it would not have been counterfeited. Yet it was simulated by the defendants, so that their false token was not distinguishable from the genuine. What essential ingredients of a lawful trade-mark did it lack? None!

§ 152. When there are several mints for coining money in one country, some distinctive letter or mark usually indicates at which one a piece was coined. In the United States the three branch mints at Charlotte, Dahlonega, and New Orleans have used the initials "C.," "D.," or "O.," respectively. The principal mint at Philadelphia had no such mark. Yet the single letter, when found upon a coin of precious metal, was a sufficient indication of its precise origin. In South America, some of the mints have used monograms, or involutions of letters, — one complex character indicating Lima, and another Potosi.[1] The metal in one coin may be finer than that in another of the same nominal value. Preference can be awarded by means of the mark. It is just the same with any other commodity. Two articles may be of the same outward appearance, the same color, weight, size. The purchaser has no guide to assist his judgment, except the reputation of a certain manufacturer. He discovers his mark of authenticity and guaranty. It is enough: he buys.

§ 153. The *Amoskeag Manufacturing Co.* v. *Spear*,[2] before Duer, J., in the Superior Court of the City of New York, in 1849, and already discussed, is a leading case. The plaintiff averred that the letters "A C A," relied upon as a valid trade-mark, were intended to denote as follows: "A C," Amoskeag Company, and "A," first quality. These letters were affixed to a kind of cloth called "tickings," which by much care and skill, and at great expense, the plaintiff had brought to such a state of perfection, that the best quality had obtained a high reputation throughout the country. The defendants denied the allegation of the meaning of the said letters, and averred that they referred altogether to the quality of the tickings; and they denied that the plaintiff's goods were known as the "A C A tickings," without the addition of the name or place of manufacture, but that they were known as the "Amoskeag

[1] Eckfeldt and Du Bois, Manual of Coins and Bullion, p. 17.

[2] 2 Sand. S. C. 599.

A C A tickings," in like manner as the defendants' goods were known as the "Lowell Premium A C A tickings." The answer also averred that all manufacturers of tickings used letters to denote the different qualities, and that, in every case, the name of the maker or place of manufacture was added, to enable the public to distinguish between articles of similar quality made by different manufacturers. The answer further denied that the defendants had used these letters to enable them to sell their tickings as those manufactured by the plaintiff, or that their use had produced that result; and admitting that they had sold their goods as the genuine "A C A tickings," it was always with the designation that they were "Lowell," and not "Amoskeag," tickings. The defendants, for five years before the action was brought, had used a label corresponding with that of the plaintiff in size, color, fancy border, position, general arrangement, and size of the letters; and also containing, in large capitals, the letters "A C A." A preliminary injunction was granted, restraining the defendants, according to the prayer of the complaint, from using on their tickings any label such as that which they had used, or any label similar to the plaintiff's, or an imitation of it, or having thereon the letters "A C A." This was a motion to dissolve or modify the injunction, which had been granted *ex parte*, on giving security.

§ 154. The legal title of the plaintiff in the present case to the exclusive use of these significant letters, "A C A," was denied. They were said to be but an indication of the quality of goods, and that they were used as all manufacturers use letters to denote the different qualities. If so, it is clear to any comprehension that they did not constitute a trade-mark. The question to be decided was whether they did merely denote quality, or whether they did not constitute the peculiar symbol that indicated origin. If the said letters, as used by the plaintiff, were merely an indication of the relative quality of its tickings, they must be expunged. As the plaintiff

could not have acquired, by prior occupation, an exclusive right in the use of the words "First Quality," or "Superfine," it could not have acquired by similar means a right to an exclusive use of any letters, marks, or other signs, which are merely a substitute for the words, and intended to convey the same meaning. It is immaterial, said the judge, whether words, or letters, or figures, or any other signs are used, if the single fact which they are used to indicate or declare is a truth that other manufacturers or dealers have an equal right to express and communicate. The judge found, as a fact, that its letters "A C A" were employed by the plaintiff to indicate quality, and for no other purpose. He said that "It is doubtless true, as is stated in the complaint, and sworn in many of its affidavits, that the tickings of the plaintiff to which its A C A is attached, have for many years been known in the market as the 'A C A tickings;' but this fact neither alters the meaning of the letters, nor takes from others the right to employ them. If the letters designate only the quality of the goods, and not their origin or ownership, the tickings of the defendants, if the best quality of those which they sell, are as truly 'A C A tickings' as those of the plaintiff. The words 'Power Loom' are found upon the label of the plaintiff, yet it is not contended that I could restrain the defendants from using the same words as they have done upon their own. If there exists a distinction, I am unable to perceive it. The claim of an exclusive right rests in both cases upon the same grounds: it is valid in both, or in neither." The learned judge held that the conclusion was irresistible, that the three letters were used to designate the best quality of tickings, and for no other purpose. He therefore struck from the injunction the words "or having thereon the letters 'A C A,'" but retained the rest.

§ 155. What conclusions are deduced from this Amoskeag case? Let us again glance at the facts. A preliminary injunction had been granted upon the *ex parte* application of

the plaintiff. It had made out a *primâ facie* right. Upon the coming in of the answer, which denied the plaintiff's allegation of an exclusive right to the letters "A C A," it was moved to dissolve or modify the injunction. As to the imitation of the label in all its features, there could be no gainsaying. It was apparent. Testimony could not countervail the evidence of ocular demonstration. But the label was not a technical trade-mark. Perhaps the three letters were. It was so asserted on one side, and denied on the other. It was an equipoise. In such a case, an equitable remedy would, by the rules of equity, be withheld. Take the language of the judge in rendering his decision: "I can give to the defendants, however, the benefit of the general rule, by so modifying the injunction as not to restrain them from using the letters A C A, until the legal right of the plaintiff shall have been established by the verdict of a jury in this suit, and I am satisfied that it is this course I should be bound to follow even were my opinion as to their legal right widely different from that which I have expressed." The court did not decide that the three letters could not be a lawful trade-mark. It decided that the case as presented did not establish the plaintiff's right. A jury must pass upon the disputed right.

§ 156. This matter had a sequel in the Patent Office, in 1872. The Amoskeag Manufacturing Company filed an application for registration of a trade-mark, consisting of the said three letters, A C A. The label on which the letters are printed is substantially that before described, — the same that has been used for thirty-six years. After a careful examination of authorities, the letters were recognized as containing in themselves the essential characteristics of the manufacturer's and merchant's symbol called a trade-mark; and the certificate of registration was duly issued.[1]

§ 157. In *Stokes* v. *Landgraff*, at a special term of the Supreme Court of New York, in 1853,[2] Strong, J., clearly laid

[1] No. 713, dated March 26, 1872.

[2] 17 Barb. 608.

down the doctrine of the Amoskeag case. In respect to words, marks, or devices, which do not denote the goods or property or particular place of business of a person, but only the nature, kind, or quality of the articles in which he deals, no property can be acquired. There is obviously no good reason why one person should have any better right to use them than another. They may be used by many different persons at the same time, in their brands, marks, or labels on their respective goods, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article could be defrauded. The plaintiff was a manufacturer of glass, at the village of Clyde, in the town of Galen, in the county of Wayne, State of New York. His complaint alleged that he was entitled to the exclusive use of the words GALEN, LAKE, CYLINDER, WAYNE, NEW YORK, which had long been used by his predecessors and himself to denote the qualities of glass made at his establishment, and to distinguish the same from that made by others. A temporary injunction was granted, which the defendants applied to have vacated. The question to be determined was whether the words so used by the plaintiff were embraced by the law of trade-marks. Did they indicate origin or ownership, or merely denote quality?

§ 158. In his complaint, the plaintiff alleged that the word "Galen" was used to denote the first quality; the word "Lake" to denote the second quality; the word "Cylinder" to denote the third quality; the word "Wayne" to denote the fourth quality; and the words "New York" to denote the fifth quality of glass manufactured at his works; and that the said marks or brands had ever been and still were used to denote and distinguish the respective qualities above mentioned. It was also alleged that the defendants "have manufactured for sale large quantities of window-glass, greatly inferior in quality and value to that manufactured by the plaintiff, and caused it to be put up in boxes or packages, and fraudulently caused the said boxes or packages to be branded or marked

with the words" mentioned, "in imitation of the several brands or marks used by the plaintiff, and with intent to cause it to be believed by the purchasers, builders, and the public, that such glass was manufactured at the glass-works belonging to the plaintiff, and to enable the defendants to sell the said glass as the manufacture of the plaintiff." The answer denied that the said words were used by the plaintiff to distinguish the glass manufactured by him from that manufactured by other persons, or at other manufactories; and insisted that they were used by both parties to distinguish the several qualities of their glass. They also denied any design to divest the plaintiff's trade, and that they made an inferior article.

§ 159. The court held, that in regard to the words "Cylinder," "Lake," and "New York," there was no propriety, or even plausibility, in the claim that they were used by the plaintiff, in part, to distinguish his glass, or glass of his manufacture: that they were not adapted to that end. Besides, the practice of manufacturers of glass, as above stated, and the appearance of the plaintiff's marks or brands in connection with it, showed that they were used to denote quality; and the plaintiff admitted that was, in part, his object. Some other of the words had not been used by the defendants. Injunction dissolved. This case was appealed to the general term, in 1854, and the decision was affirmed.

§ 160. Let us take another look at *Stokes* v. *Landgraff*. What principles governed the decision? Here are facts that will assist in the elucidation. The plaintiff's complaint was rather inartificial, to commence with. It admitted too much. The word "quality" was used in a loose sense. Did it mean merely to denote the different grades of a common article of manufacture? Was it not meant to be said that the words were employed only "to distinguish the glass manufactured by the plaintiff from that manufactured by other persons, or at other manufactories"? To say the least, the language was unhappy. Annexed to the answer are transcripts of the several

marks or brands both of the plaintiff and defendants, from which it appears that in each of the plaintiff's marks or brands, in addition to one of the words above named, are his name, and the village where his manufactory is situated, with a representation of the size and number of feet of glass, as "Stokes — Clyde — Galen, 8 × 12 — 50 feet;" or "Stokes — Clyde — Cylinder, 8 × 12 — 50 feet," &c.; and that each of the defendants' marks or brands, having either the words "Galen," "Lake," or "Cylinder," has, in addition, the name "Landgraff," with a representation of the size and quantity of glass, as "Landgraff's Galen, 8 × 12 — 50 feet;" or "Landgraff's Cylinder, 8 × 12 — 50 feet," &c. The brand of the defendants having the name "New York," is in this form: "Cleveland, New York," with a representation of size and quality as above given. Each party used the name of the place of manufacture, — Clyde, and Cleveland. The names in dispute were not so affixed as to be the salient points that would strike the purchaser's eye, arrest attention, and operate as a guaranty. No one would pin his faith to any one of the words by itself. The names had no blandishments to allure and captivate. They meant no more than would the numerals 1, 2, 3, &c.; indications of comparative quality. But the strongest objection is this: most of the words claimed are names of localities. No one can usurp geographical names which all in common have a right to use. But the rule as to the exclusive use of a name of a locality must be taken with its limitations and qualifications. If the plaintiff had owned the whole village or spot whose name was borrowed, he might have a right to the name, as in the Congress Spring case;[1] or if he had used a name which others in the same village had a right to use to denote a peculiar natural product, — one not found in any other place,[2] — although that would not be, strictly speaking, a trade-mark, for it would lack the essential element

[1] 57 Barb. 526, and 4 Am. Law Times R. (St.) 168.
[2] "Akron" case, 49 Barb. 588.

of exclusive right, he would have rights which a court of equity would protect. The plaintiff's case did not make out his claim to any remedy. The words were not used as trade-marks. It was therefore unnecessary to consider the question of priority.

§ 161. **Terms in Common Use to designate a Trade or Occupation,** in connection with other words indicating that a particular class of merchandise of the same general description is specially dealt in, cannot be exclusively appropriated by any one as a trade-mark. In *Choynski* v. *Cohen*,[1] Supreme Court of California, 1870, the plaintiff claimed the words "Antiquarian Book Store" as his peculiar symbol. The court said that the case depended upon the effect of the word "Antiquarian," as used in connection with the words "Book Store." As applied to a book-store, it can have no other meaning or effect than to indicate to the public that the proprietor deals in a certain class of books; to wit, ancient books, or books pertaining to antiquity. Any one reading the sign, "Antiquarian Book Store," over the door, would naturally expect to find there for sale either ancient books, or books treating on subjects connected with antiquity. . . . It could not, by even a forced construction, be made to signify that the plaintiff's business had been long established, and was of ancient origin; for the complaint informs us that the business was established in 1863, and that it had the name of the "Antiquarian Book Store" from the beginning. It was used precisely in the same sense that the words "Law Book Store," or "Medical Book Store," or "Divinity Book Store," would indicate that law, medical, or religious books were for sale. In all such cases, the words employed are but advertisements that certain goods are there sold.

§ 162. The case of R. W. English, appeal from the Examiner, November 2, 1870, to the Commissioner of Patents,[2] has been the source of error to all who cited it as an authority. The applicant offered for registration three so-called trade-marks.

[1] 39 Cal. 501.

[2] Commissioner's Decisions for 1870, p. 142.

The first reads thus: "R. W. English's X Brooms. Buffalo, N. Y. Order English's X Brooms." The two others are precisely the same, except that in one the character X X and in the other X X X are substituted for the X in the first. "X" was alleged to be the distinguishing feature. The applicant set forth as follows: "Heretofore I have been in the habit of using 'X' to distinguish my brooms, using 'X' for one quality, 'X X' for another quality, and 'X X X' for still another quality, by printing, stamping, or affixing the same to the brooms in any convenient manner." The Examiner rejected the applications. He said: "The label filed has no new or peculiar characteristic to make it a lawful trade-mark. The letters used in printing it are of the ordinary kind, set up in a common way, and the letter X, used to express quality, is commonly used for this purpose by all liquor dealers, particularly for marking the qualities of ale." A late commissioner, in his decision overruling the officer below, said: "The question, with reference to trade-marks, is not whether the particular mark is new in its application to goods of all kinds, but whether it is new in the special application proposed for it. In the case of this species of property a double use is permissible. The fact that a mark has been used for a bottle is no bar to its use by another for a broom, or by another for dry-goods, or by another for an agricultural implement, or for hardware. One man may choose to call his knives 'X L' knives, and another his baskets 'X L' baskets. The use of this mark in no way implies that the baskets were made by the manufacturer of the knives, or *vice versa*." He therefore held that the letter X, when employed to denote a particular article of manufacture, being in no way descriptive, but a new arbitrary character, which may, when adopted and used, indicate the origin and ownership of the goods to which it is applied, may well constitute a proper trade-mark. He further held that X X and X X X are as distinguishable from X as the latter is from Y or Z, or any other character. He also said that the

use of the letter X is not an ordinary mode of indicating quality. The three cases were thereupon registered.[1]

§ 163. The general legal proposition, that two men may adopt the same symbol, if to be used upon different classes of goods, requires no comment. The question is this: Did the letter X, under the circumstances presented, constitute a lawful trade-mark? If used merely to indicate quality, it clearly did not. That point is too well settled to be disputed. What idea is conveyed by the use of the letter X? Has it not from its long association come to be well recognized as a mere indication of quality, as much as the numerals 1, 2, 3? That is a pure question of fact. It was a bare assumption to hold the contrary in the absence of the slightest evidence. How could any tribunal take judicial note of the fact that it was otherwise? The case before the Office was one where the applicant positively alleged that he used the letter, single, doubled, or trebled, as an indication of the respective qualities of his brooms. The allegation of the specification was conclusive. The fact was there enunciated. The Commissioner travelled out of the record. His opinion, then, as to the doctrine that the letter X does not generally indicate quality, is but an *obiter dictum*, — a way-side opinion, not binding in other cases.

§ 164. There must be some word, or sign, or device, other than the generic name, and words descriptive of quality. Under this rule, the proposed trade-mark "Beeswax Oil" was refused registration.[2] The name "oil" is generic. The word "beeswax" is doubtless intended to be more or less descriptive of the quality or nature of the oil. The words "Razor Steel," as applied to the blades of knives, shears, and other cutlery, were rejected.[3] The word "razor" is purely descriptive, and the word "steel" a generic name, and being limited to neither person nor place, so as to indicate either origin or ownership, they cannot be regarded as constituting a legal trade-mark.

[1] Nos. 86, 87, and 88, Dec. 6, 1870.

[2] Commissioner's Decisions, 1871, p. 97.

[3] Ibid., p. 113.

"Cundurango Ointment, C. O.,"[1] is not a legitimate trade-mark; "ointment" being a generic term, and "Cundurango" the name of a plant extensively known, and the initials "C. O." immaterial, and not likely to be noticed. The applicant in another case sought to register the word "Invisible," to be applied to packages of powder intended for beautifying the complexion. Mr. Commissioner Leggett said: "That the word 'invisible' might be used as a lawful trade-mark, I have no doubt. But when used to indicate the character of the thing to which it is attached, it becomes descriptive, and cannot be monopolized. Such, without doubt, is the application of the word 'invisible' in this case. The intention of the applicant in the use of the word evidently is to indicate that the powder, when applied to the skin, is imperceptible or invisible; hence the word is used with its ordinary signification, as in the description of shades of colors, and when so used is, by the rulings of the courts, excluded from the list of devices that may become legitimate trade-marks."[2]

§ 165. The courts of France have made a number of decisions upon this point. In the Court of Colmar, in 1857 (*Rian* v. *Bernheim*[3]), it was *held*, the denomination *toile ménage* is not a special denomination which can become the exclusive property of a manufacturer. The term had by long use become common to commerce. The Tribunal of Commerce of the Seine, in 1858 (*Thibierge* v. *Dupont et als.*[4]), for the same reason rejected the words *benzine parfumée*. The Tribunal Civ. of the Seine, in 1861 (*Mauprivez* v. *Buchet et als.*[5]), had this case: The plaintiff's mint-drops were marked in relief, "Peppermint, London." The defendant, who had imitated the mark upon the same class of goods, for defence argued that the words were but an indication of the nature of the preparation, and therefore could not become private property. But

[1] Commissioner's Decisions, 1871, p. 284.
[2] Ibid., p. 289.
[3] Annales de la Prop., tome iv. p. 216.
[4] Ibid., p. 400.
[5] Ibid., tome vii. p. 335.

the court held that the union of the two words, placed in relief, and with characteristics determined and distinct, were a particular sign to indicate to the public that they belonged to the inventor thereof. This in effect decided that, by the manner of use, these words had acquired an individuality sufficient for the destined purpose. The same parties appeared before the Court of Paris, in 1864, on appeal.[1] *Held:* "peppermint" is but the English appellation, but by long use in France it has become common to commerce. The simple indication of this product, in one language or the other, cannot be protected. The court plainly intimated that a particular form or disposition of letters might make it valid as a personal sign. This would virtually make it a distinctive sign of origin.

§ 166. When a chemical product takes naturally, in certain given conditions, the form of a known object, its denomination cannot become private property. The case of *Barnett* v. *Wibler*, in the Court of Paris, in 1866,[2] illustrates this doctrine. Everybody knows, at least by name, the scientific toy called the "Serpent of Pharaoh." It is sold under the form of a little cone covered with tin-foil. When set on fire, it acquires an extraordinary development, and, with the movements, takes the form, length, and color of a real serpent. The demandant described its mode of manufacture. He employed the *sulphocyanide of mercury*, obtained by the action of nitrate of mercury on the *sulphocyanide of potassium*. The containing box had upon it a notice of "Poison." The demandant had patented the toy, but the patent had been invalidated, as being for a worthless invention. As inventor, he had given to it the name of "Serpent of Pharaoh." It was sometimes called the "Artificial Serpent" and the "Eggs of Pharaoh." The defendant sold a similar article under the name of "Magic Serpent." An action was brought for infringement of the alleged trade-mark. Among other things, the defence set up that the toy was

[1] Annales de la Prop., tome x. p. 320.

[2] Ibid., tome xii. p. 144.

poisonous, and consequently contrary to law, and to the public security; but on that point the court ruled, that as the attention of the Council of Health had several times been called to the article, and nothing had been done to prohibit the sale of it, the conclusion was warranted that it presented no serious danger, and therefore was not unlawful. The next question was this: Do the words "Serpent of Pharoah," as used, constitute a trade-mark? If yea, is the use by the defendant of the term "Magic Serpent" for a similar article an infringement upon that mark, as a colorable imitation? In support of the claim, the counsel, M. Pataille, eminent for learning in the law of the subject, argued thus: The words "eggs" and "serpent," employed to designate the thing which was neither eggs nor a serpent, but which, upon combustion, gave a resemblance more or less removed, are clearly fancy names, belonging to him who first makes use of them. In support of that theory, he cited the decisions of the Court of Paris and the Court of Cassation in the instance of "Pearls of Ether," a title given to ether-pills, which, as pharmaceutical products, belong to the public in general, and by their form and silvery envelope resemble pearls, and which words notwithstanding were held to be a trade-mark.[1] *Held*, the term "serpent" does not constitute a trade-mark, it being natural and necessary to describe the article. The use of the word "serpent" by the defendant is not piracy. So the words "Night Blooming Cereus" were held to be invalid as a mark, being the proper descriptive appellation of an article.[2] The same rule defeated the adoptor of the words "Desiccated Cod-fish."[3]

§ 167. Since the foregoing got into type, the following case arose. A claim was made to the exclusive use of the words, "CABLE-TWIST TOBACCO," as a trade-mark for plug chewing-tobacco. The applicants[4] set forth that they had used said words for that purpose for about two years last past, *i.e.*, from

[1] Annales de la Prop., tome x. p. 340.
[2] Phalon *v.* Wright, 5 Philadelphia, 464.
[3] 5 Abb. Pr. R. (n.s.) 218.
[4] Harris, Beebe, & Co.

about the year 1870. The Examiner rejected the application, on the ground that the words "Cable Twist" are purely descriptive of the goods to which they are attached. An interlocutory appeal was thereupon taken to the Commissioner, in person, the main question being this: Are those words the proper denomination of the article of manufacture?

§ 168. Upon the argument, the counsel for the applicants produced a piece of the manufactured tobacco, and a drawing filed in the Office in an application for a patent for their mechanical process of coiling the tobacco into the exact representation of an ocean-telegraph cable, which thing, said the counsel, had first suggested the name. The new article of manufacture consists of a strand or rope of tobacco coiled spirally about a "filler" or core, and then pressed flat, or into any other desired form. The object of the invention is alleged by the specification to be to provide a plug-tobacco in such shape, and of such arrangement, that the portion of it desired for use may be severed from it without uncoiling the remainder of the plug. After the coil is wound round the core, the bunch is placed in a mould, and reduced by hydraulic, or other, pressure to the shape of a flat plug. After this operation, a number of the plugs are placed in a tobacco-caddy and pressed; the process of filling and pressing being repeated until the caddy is full.

§ 169. It was conceded by the counsel that any article's appropriate name, which has become a part of our common language, cannot be registered or recognised as a valid trade-mark; but it was strenuously denied that the words "Cable-Twist," as here used, could be brought within the rule. It was admitted that the words "Cable," "Twist," and "Tobacco," are the common property of the public, and the words "Cable-Twist," when combined, are also in general use, designating as they do a kind or class of tobacco; but the counsel denied that such is the case in respect to the combination of the three words. "Cable-Twist Tobacco," it was contended, is a com-

bination quite unknown to the public, except as the mark or symbol of a particular firm, — the kind or class being *twist*, and the word *cable* being purely fanciful. The objection that the word *cable* is descriptive seemed to the counsel to be untenable. The case was instanced of the famous smoking-tobacco put up in green drums, and sealed with green wax, and having applied to it as a trade-mark the words "Green Seal Tobacco."

§ 170. The Examiner replied that the color of the drum and wax were mere marks or symbols of the merchandise; and as green paint or green wax cannot enter into the composition of tobacco, the color in such case cannot be deemed to be descriptive, any more than the color of wax on bottles, as illustrated in the French case of *Badoit* v. *André*, in the Court of Appeal of Lyons, in 1851.[1] (In that case, the parties both sold the water of Saint Galmier, though each drew from a different spring. They had adopted very dissimilar exterior signs to distinguish their bottles. Badoit used a *green seal*, bearing the inscription "Mineral Water of Saint Galmier, Badoit Spring," &c. André, who had quite another kind of designation, in 1850, without abandoning his peculiar mode of indication, all at once adopted the *green* wax. The court held that the color of the wax, as thus employed to seal bottles of mineral-water, constituted a trade-mark, and a sign of good-will worthy of protection as the exclusive property of the plaintiff; and the defendant was accordingly enjoined from using for that purpose wax of the same color as that used by the plaintiff.)

§ 171. The counsel further said, *inter alia*, that one might make candy, and color it to resemble a cable, and mould it into an exact representation of the applicants' tobacco, and use the words "Cable-Twist Candy," and enjoy the exclusive right of the employment thereof for that purpose. The words would necessarily be descriptive. The public would come to

[1] Le Technologiste, tome xiii. p. 213.

know the candy as "Cable-Twist Candy." The words might in time become the appropriate name of the article; and still the sole right to use the designation would remain in him who first applied it to candy. That is, that any person might apply the term *cable-twist* to any goods, as a fancy name, and hold the same as a valid trade-mark, although the words might possibly be to some extent descriptive.

§ 172. The case of "Brown's Jamaica Ginger" was cited as an illustration of the idea; and the remarks of Paxson, J., in the suit of *The Dixon Crucible Co.* v. *Guggenheim*,[1] were relied on as confirming the same. We turn to that case, and ascertain that what the judge said was this: "Our late fellow-townsman, Frederick Brown, for many years before his death, prepared and sold a valuable article of Jamaica ginger. It was known as his article, and protected by his trade-mark. His son continues its manufacture. No one doubts his right to do so, or that equity would restrain an unlawful interference with his rights." The article would be "protected by his trade-mark," says the judge. He did not say what that trade-mark was. Was it the mere appellation of "Brown's Jamaica Ginger," as the counsel contended? It assuredly was not. The Patent Office has answered that question. Upon the application of the very gentleman mentioned, as successor in business, the point was passed upon. Mr. Brown applied for the registration of a *fac-simile* of the signature of his father and predecessor, as his lawful trade-mark for Jamaica ginger; and his claim was allowed.[2] The name of the commodity does not constitute any essential part of that mark.

§ 173. The counsel then said, that a fine-cut chewing-tobacco of a bright-yellow color, might be properly marked "Yellow Moss Chewing-Tobacco." (*Conceded*, and for this reason: the first term is purely fanciful. Yellow moss does not enter into the composition of chewing-tobacco.)

[1] 3 Am. Law Times R. (St.) 288, and 2 Brewster, 321.
[2] Frederick Brown, No. 715.

§ 174. The counsel then suggested that the words "Snow-Flake Starch" would be a valid trade-mark, although applied to starch manufactured to resemble snow-flakes. (*Denied*, unless the claimant of a right to the exclusive use of the words have also the exclusive right, by virtue of a patent, to make starch of the appearance of snow-flakes; which is hardly a supposable case. If a person has a patent to make an article of any peculiar conformation, he may undoubtedly give it its proper descriptive name, and he would be protected therein. unless that name be generic, or broad enough to describe articles which others have an equal right to make and vend.) "Cable-Twist Tobacco," the counsel contended, "although used as a brand, is not yet properly a name, and cannot become a name until the diligence of the applicants make it such. It may doubtless pass into common use, and in time come to be a *quasi* generic term; but at present has nothing more than a fanciful significance. Perhaps every valuable (*word*) trade-mark in existence is more or less generic; and each may in the course of time take its appropriate place as a common noun, and be entered as such in the lexicons of future generations."

§ 175. The Commissioner of Patents affirmed the decision of the Examiner; and held that the words "Cable-Twist Tobacco" are descriptive, notwithstanding the transformation of the ropes or cables into rectangular blocks. He said that the words clearly indicate an article of chewing-tobacco manufactured in a peculiar manner, by twisting and coiling the plant into the form of a cable, just as hemp and other vegetables are manipulated. A cable continues to be a cable even if pressed out of shape. The idea is conveyed that the article offered for sale is tobacco, manufactured by the twisting or coiling process. No one would attach any other meaning to the term *cable-twist*, as used in connection with tobacco. It describes an article of merchandise that all manufacturers of tobacco have a right to make and sell. The applicants cannot

have the monopoly of all tobacco manufactured in the form of a cable, although they have made an application for a patent for a peculiar kind of cable-shaped tobacco pressed flat. They may have the sole right to make it in one way, and somebody else may have quite as good a right to make it in another way. If others have, or may acquire, a right to manufacture any other kind of cable-twist tobacco, they have the legal right to call the thing by its right name. But if the claim of these applicants were allowed that would not be so. They would to that extent control the use of words in common use.

§ 176. The applicants by their counsel made a motion before the Examiner for a re-hearing. Since the judgment of affirmance by the Commissioner, they had obtained the grant of a patent for seventeen years for their peculiar mode of manufacturing tobacco, as hereinbefore described; and it was argued that that fact put a new phase upon the matter, inasmuch as thereby they now had the sole right to make and vend chewing-tobacco made first in the form of a cable, and then pressed into flat plugs. The counsel urged the necessity of the recognition of the name as a trade-mark, as the applicants (stated to be the most extensive tobacco-manufacturers in the world) made a profit of twenty thousand dollars a year by the sale of *cable-twist tobacco*, and required the sole use of the name as a protection to their legal rights. Admitting that there is propriety in drawing a line of demarcation with nice discrimination in a case of mere description, it was said by the counsel that such an objection was obviated by the grant of a patent.

§ 177. The Examiner, in reply, referred to a patent [1] more than three years old, for another kind of improvement in the manufacture of chewing-tobacco. In that case, as is seen by the specification, the tobacco is spun or twisted together into one continuous "brake" or rope, and then coiled or pressed down into the keg, box, or other package, in which it is to be

[1] No. 85,613, to William & David Rineheart.

packed for market. The benefits claimed by the earlier patentees are the same as now set forth, — the convenience afforded to the consumer in breaking off only so much of the weed as he may need at the moment. The article manufactured under that patent is one kind of *cable-twist* tobacco. The public have a right to apply to it that descriptive name. The counsel insisted that the term was not understood by the trade to be descriptive; and asked leave to present evidence to that effect. The reply of the Examiner was, that the obvious and legitimate meaning of words in common use cannot be explained away by any possible amount of testimony. The Office must judge for itself. No cause for a re-hearing has been shown. Case dismissed.

§ 178. *The name of a man may lose the idea of personality*, and become a mere indication of quality. This point was decided by the Court of Cassation, the supreme judicial tribunal of France, in the case of *Stubs* v. *Astier et als.*, in 1865.[1] The plaintiff, a manufacturer in England, brought suit to restrain the use of his name upon articles of merchandise made and sold in France. Under the treaty made in 1860 between the two countries, he had a standing in court. His claim having been refused in the court below, on the ground that the name had attained a generic significance before the treaty of reciprocity had taken effect, the case was appealed to this, the court of last resort. It was contended on one side that the name of Stubs had lost its primary use, which was to indicate certain articles of hardware and cutlery as being his manufacture, and that by long user it had acquired a new attribute, and that to hold otherwise would be to take away rights that had become vested in the French people. On the other side, it was strenuously contended that a man's name is his distinct property, and remains a property sanctioned by the law of nations; and although the mark attached to it had fallen into the public domain from any cause, the name did

[1] Annales de la Prop., tome xi. p. 81.

not cease to be the exclusive property of him who bore it. The court said that, for more than sixty years, the French manufacturers had made a certain kind of saws and files, on which they placed the mark "Stubs," with the initials "P. S." inverted; that said mark had become, in France, the indication of a product of superior quality; that it was not the indication of the origin of the manufacture, but was rather the designation of the nature and the quality of a product, of which it was the denomination, so that a purchaser could not be deceived into the belief that to him was presented an English product of the manufactory of Peter Stubs; that the files seized at Astier & Lechevallier's place bear, independent of this mark, "Stubs, P. S.," inverted, the initials "G. S.," indicating the real maker; that the files and saws seized at Reinaud's were wrapped in labels which made known the real place of manufacture; and that those divers circumstances manifested good faith and the absence of wilful injury. The same court, in 1864, in *Spencer & Sons* v. *Peigney*,[1] held the same doctrine. In that case the English manufacturer's name had for fifty years been employed in France to indicate *not the origin*, but the nature of certain products. As foreigners, the parties in both cases had no privileges in the courts of France until the treaty of 1860, and that although the English courts were open to alien and subject alike. By the time they could be heard in the assertion of natural rights, their names had been turned to another than the original purpose, so far, at least, as the territory of France was concerned. The soundness of these decisions is questioned by distinguished jurists, among them M. Pataille.

§ 179. In the case of *Bournhonet & Basille* (successors of *la maison Ternaux*) v. *Tisseron et al.*, in the Court of Cassation, in 1869,[2] we have an instance in point. It was *held* that the successor of a merchant cannot prevent other merchants from using the name of his predecessor to designate

[1] Annales de la Prop., tome x. p. 197. [2] Ibid., tome xv. p. 90.

the products of their fabrication, when the name has long been used as the designation of a certain kind of products manufactured by the generality of the trade, and which has thus become public property as a qualifying term,—a mere adjective. It is especially so in the employment of the name of *Ternaux*, to designate a certain kind of *broché* shawls.

§ 180. The case of *Singleton* v. *Bolton*,[1] before Lord Mansfield, in 1783, is an illustration of the doctrine that a man's name may become a mere qualifying word. The plaintiff's father sold a medicine called "Dr. Johnson's Yellow Ointment." The plaintiff, after his father's death, continued to sell the medicine, marked in the same way. The defendant also sold the medicine, with the same mark; and for that alleged injury an action was brought. The plaintiff was nonsuited. A rule having been obtained for a new trial, Lord Mansfield said that if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud, for which an action would lie. But here, both the plaintiff and defendant use the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff. The only other ground on which the action could be maintained was that of property in the plaintiff, which was not pretended, there being no patent.

§ 181. We have familiar instances of a person's name becoming a mere indication of a certain article or class of goods. Wellington, Brougham, Stanhope, Blücher, and Manton are personal names that have given us the wellington boots, the brougham or the stanhope carriage, the blücher boots, and the manton fowling-piece. But it is not understood upon what principle a person's mercantile name can be wrested from him by the mere lapse of time. In the Stubs and Spencer cases, the fact was apparent that in England those names were regarded as marks of origin and warranty. If good for that purpose in one country, they were equally efficacious for the

[1] 3 Doug. 193.

same purpose in any other. The rights of their owners might be in abeyance, but they could not be lost.

§ 182. **Geographical Name.** — There are decisions which are supposed to justify the adoption of a mere geographical name as a trade-mark. One of these is *Neuman* v. *Alvord*.[1] The word "Akron" was the subject of the controversy. The plaintiffs were manufacturers of cement or water-lime, at the village of Akron, in the county of Erie, N. Y. The defendants were engaged in the same line of business at Syracuse, N. Y. The court, on appeal, held that this name, although geographical, designated the origin of the article made and dealt in by the plaintiffs, as well as the place of manufacture, and was appropriately used in these respects; for the material used by the plaintiffs was obtained and manufactured into water-lime cement at the village having that name. The doctrine that the name of a locality may be exclusively appropriated was distinctly enunciated; but it was also held that what may be claimed or used alike by all in the said place cannot be exclusively appropriated to advance the interests of one. Daniels, J., delivered the opinion of the general term. After reviewing various authorities bearing upon the question at issue, he said: "In the present case, the term selected to identify and distinguish the plaintiffs' manufacture from those of a similar character placed upon the market by others, had never been previously used for any such purpose. The use of it imposed a new attribute or office upon the word, which specially adapted it to indicate and distinguish the origin and place of the plaintiffs' manufacture; and it in no way entrenched upon the previous use or purpose to which the term had been in any way devoted by others. The term was made to bear and perform an entirely new duty or office, which could result in no embarrassment, prejudice, or injury to any other person whatsoever. And from the continued use made of it in that respect, it has become an important and valuable element in

[1] 49 Barb. 588.

promoting and securing the prosperity of the plaintiffs' business, and as such the defendants should be restrained from making a similar use of it." While, for the purposes of that controversy, the court upheld the doctrine that the name of a place does indicate origin, we must not be misled by the broad language of the court. The plaintiffs came into court with clean hands, asking redress for an attempted fraud by the misuse of the word "Akron." What did that case decide? It virtually decided that that word did not, as presented, possess all the ingredients of a lawful trade-mark, for it lacked exclusiveness of the right of user. Mr. Justice Strong, of the Supreme Court of the United States, in the case in that court, before cited, said that the decision in the Akron case substantially concedes that the plaintiffs by their prior appropriation of the name of the town in connection with the words "cement" and "lime," acquired no exclusive right to its use as against any one who could use it with truth. All the inhabitants of the village of Akron had the same right to brand or label their goods with the name as had the plaintiffs; therefore it was not purely a trade-mark in its broadest sense. As against a wrongdoer who had attempted by fraudulent means to divert custom from its legitimate channel, it was good. The important word is the name of the place where the cement is made. The article manufactured is taken from the earth. It is a bed or quarry of lime. There is no special art or skill in making it into cement. The cement taken from different beds differs greatly in value, as in quality. The reputation of the plaintiffs' cement arises from the reputation of the bed or quarry from which it is made, — the Akron bed. They speak the truth in using the name. They tell the public by their bills — This is Akron lime. It is made from the Akron beds or quarries. The public have used it for years, and appreciate its qualities. The defendants, at a distance of 150 miles, change the name of their quarry, and incorporate the most significant word used by the plaintiffs for many years, and then prepare bills with

this word prominent in them, and bring their article into markets in competition with the plaintiffs'. It was not necessary for the purposes of the particular case under discussion for the court to decide in so many words that the word "Akron" was a technical trade-mark. The concluding sentence of the decision is sufficient to determine what was really decided. *Held*, the plaintiffs' right to restrain the defendants from making use of the word "Akron" as their trade-mark is reasonably plain, and the judgment awarding the injunction should therefore be affirmed.

§ 183. *The Brooklyn White Lead Co.* v. *Masury*,[1] before the general term of the Supreme Court of New York, in 1857, said that it is to protect a man's right of selling his own that the law of trade-marks has been introduced. It must include the right to sell to all, — to the incautious as well as to the cautious. Any false name that is assumed in imitation of a prior true name is in violation of this right, and the use of it should be restrained by injunction. The plaintiffs had been engaged for more than twenty years in the manufacture of white lead, and had habitually marked their kegs with their name; adding the words, "premium lead, warranted pure." Both parties manufactured in the city of Brooklyn. As they both dealt in the same article, they had the same right to describe it as Brooklyn White Lead; and it was shown that many other companies had used the same designation. The defendant changed his mark, and assumed one to which he had no title, in imitation of the plaintiffs', with only a colorable difference, that of "Brooklyn White Lead and Zinc Company." He had no such company; and that part of his new title seems to have been adopted to imitate the plaintiffs', and to make his paint pass as theirs. This was a fraud. *Held*, the defendant should be enjoined from the use of the word "Company," or "Co." He may continue to use the title, "Brooklyn White Lead and Zinc," only omitting the word "Company."

[1] 25 Barb. 416.

§ 184. In *McAndrew* v. *Bassett*,[1] in 1863, the Lord Chancellor said: "I am told that this word 'Anatolia,' being a general expression, — being in point of fact the geographical designation of a whole country, — is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist; but property in that word, as applied by way of stamp upon a stick of liquorice, does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances, that render the article so stamped acceptable to the public." This is a recognition of the doctrine that a geographical name may cease to be merely such, and acquire a new function, as an arbitrary symbol. If it were not so, any word that might be found to be composed of the same letters in the same order, as the name of any country in the world, might be rejected as a trade-mark; and that although the adoptor of the word had never heard of the country bearing the name of his chosen word. The liquorice was stamped with the name "Anatolia" by way of contradistinction from other kinds of liquorice. It was not intended as a mere representation that the article was Anatolia liquorice. It acquired reputation. The defendant knew that, or he would not have simulated it. It was upon the same principle that, in 1862, the Tribunal Civ. of the Seine (*Faivre* v. *Duguaire et al.*) held that "Mount Carmel," although geographical, was good as a fancy name.[2] The case of *Wotherspoon* v. *Currie*,[3] in V.-C. Malin's court in England, in 1870, is sometimes cited as an authority upon the same point. It appeared on a motion for an injunction that, for several years before 1847, Messrs. Fulton & Co., of Glenfield, near Paisley,

[1] 10 Jur. (N.S.) 550.
[2] Annales de la Prop., tome viii. p. 238.
[3] 23 L. T. R.

manufactured powdered starch, principally from East India sago, called "*Glenfield Patent Double Refined Powder Starch*," commonly known as "*Glenfield Starch*." In January, 1847, the plaintiff, William Wotherspoon, purchased of Messrs. Fulton & Co. their business and works at Glenfield, and the exclusive right of manufacturing starch and selling it under the name of "*Glenfield Patent Starch*." The plaintiff afterward removed his manufactory to Maxwelton, near Paisley, where he made and sold his starch. The defendant, Currie, rented from Messrs. Fulton & Co. a small building attached to their dyeing-works at Glenfield, and manufactured starch, which was sold in packets of a size and appearance similar to the plaintiff's, and labelled "*The Royal Double-refined Patent Powder Starch, manufactured by Currie & Co., Glenfield.*" The plaintiff's case was that the defendant had taken the small building at Glenfield for the express purpose of inducing people to believe that his starch was the article made by the plaintiff. For the defendant, it was urged that, as he was an actual resident at Glenfield, and his manufactory was there, he had as much right to put his address upon the labels of the starch as had the plaintiff, who did not actually reside at Glenfield. An injunction was granted, the Vice-Chancellor remarking that he had never known a case in which a defendant had been guilty of more reprehensible conduct.

§ 185. This case came up on appeal before Lord Justice James, on a motion by the defendant to dissolve the injunction.[1] Lord Justice James said: "I am of opinion that the injunction in this case cannot be sustained. The word 'Glenfield' is not a fancy name, like the 'Victoria' or the 'Albert' or the 'Excelsior,' and various names of that kind, which were fancy names, actually constituting a trade-mark in themselves; but Glenfield, although it is not a place as big as London, Glasgow, or Paisley, and is not even a post-town, or a market-town, or village, is a place which has an actual existence as the site of

[1] 12 Jur. (N.S.) pt. 1; 23 L. T. (N. S.) 443.

some manufactory, is yet a place containing some few houses, and is a place at which the plaintiff's starch was manufactured. The defendant, no doubt moved by the great reputation which the plaintiff's 'Glenfield Starch' had acquired, was minded to establish works at Glenfield. That was what any one might do. Although the works of the plaintiff had been removed from Glenfield, Glenfield was not, as it seems to me, tabooed to all the world as a place or site for the manufacture of starch." The act of the defendant was legitimate. There are two classes of buyers, said the court. One is the class who can read, and the other is the class who cannot read. They who can read cannot be misled, if the language differs. To the persons who cannot read, the packets are dissimilar, and could not deceive.

§ 186. In *Colladay* v. *Baird*,[1] 1860, the complainant alleged that he was the manufacturer of a certain style of goods known in the market as "ARAMINGO CHECK." That, in 1854, he had devised a certain trade-mark, or name, to wit, the words "Aramingo Mills," which mark became identified with the goods manufactured by him, although his name did not appear upon the label as manufacturer; and that the defendant, intending to deprive him of the exclusive use and benefit of his trade-mark, cunningly devised a label upon which the words "Aramingo Mills" appeared; and thus by a colorable artifice succeeded in defrauding him of a portion of his well-earned reputation and profit. It appeared that both parties manufactured their checks at the same establishment, the defendant being in fact the lessor of the complainant. The defendant asserted his perfect right to use the words. The labels were of different size and color, so that the most ignorant could not fail to detect the differences in their general appearance; and the court said that there was not a colorable imitation, device, or artifice. The court refused a special injunction, leaving the complainant to maintain his title as best he could in an action at law.

[1] 4 Philadelphia, 139.

§ 187. In the Tribunal Civ. of Havre, in 1859 (*Levigoureux et al.* v. *Léon Lecompte & Co.*[1]), came up this matter: Both parties imported the same kind of merchandise. The plaintiffs' mark was "*Vallée d'Aure*," in a semicircle, and underneath in a straight line the words "Levigoureux et Postel;" that of the defendants' was "Vallée d'Aure," and the initials, "L. L. & Ce.," of their firm. It was shown that Vallée d'Aure was the name of a place in South America. The defendants truthfully employed it to indicate the origin of their products. *Held*, no infringement. In the Court of Paris, in 1859 (*Bisson-Aragon* v. *Aragon*[2]), the plaintiffs' mark was "Massy," their place of manufacture. *Held*, that defendant had a perfect right to use the words "*près* Massy," his manufactory being really *near* Massy, and that although others had previously adopted the word "*Massy*" as a distinctive symbol.

§ 188. *Newman* v. *Alvord*[3] resembles the last case. There it appeared that the complainants had been manufacturers of cement or water-lime at Akron for about thirteen years, and that they had always designated and sold their products as "Akron Cement," and "Akron Water-lime." The defendants commenced a similar business twelve years later, at a place far distant from Akron, and called their product "Onondaga *Akron* Cement or Water-lime." It was a fraud upon the complainants and upon the public. Consequently, an injunction was granted. The court substantially conceded that the complainants had not acquired an exclusive right to the name as against one who could use it with truth; and that, as no one had the exclusive right to the name, it was not a trade-mark.

§ 189. The question of the appropriation of the name of a region to the exclusion of others who produce, or who sell, a similar product of the same region, may be considered as definitively settled. The case of *The President (&c.) of the Dela-*

[1] Annales de la Prop., tome v. p. 279.
[2] Ibid, p. 216.
[3] 49 Barb. 588.

ware and Hudson Canal Co. v. *Clark*, already referred to, was well presented and argued in the Supreme Court of the United States, in 1872. The leading question was whether the complainants had an exclusive right to the use of the words "Lackawanna Coal" as a distinctive name or trade-mark for the coal mined and sold by them. The word "Lackawanna" was not devised by the complainants. They found it a settled and known appellative of the district in which their coal deposits, and those of others, were situated. The defendant invaded no right in employing the name, for he made no false representation. All the coal taken from that region is known in trade, and rated in public statistics, as "Lackawanna coal."

§ 190. The case of *Désiré Michel & Co.* v. *Achard & Co.*,[1] in the Court of Cassation (the supreme court of France), in 1863, bears a striking family-likeness to the Lackawanna case. Many years before, in the commune of Peypin, the plaintiffs had established a manufactory of cement, to which they gave the name "La Valentine." Their works were situated near a brook bearing this name, which it takes from the hamlet La Valentine, situated in the commune of Saint-Savournin, contiguous to that of Peypin. The defendants had recently constructed cement-works in the commune of Saint-Savournin, not far from the hamlet of La Valentine. Both parties took their limestone from the same quarry. The defendants advertised their product under the name of cement of "La haute Valentine." Was "La Valentine" a lawful trade-mark? If yea, did the defendants infringe it by the use of the words "La haute Valentine"? The court said that jurisprudence sanctions the doctrine that natural products, or even manufactures in the same place, may lawfully all be designated by the name of the locality where produced, unless encroaching on the name of a manufacturer, or his trade-mark. The name of "La Valentine Cement" is actually known to commerce as the proper designation of an article produced within certain boun-

[1] Annales de la Prop., tome ix. p. 328.

daries, embracing the works of both parties; for they both use the same quarry. The name, "La Valentine Cement," corresponds to the designation of Vassy, Roquefort, la Nerthe, &c., cement; therefore the plaintiffs cannot pretend that the name is restricted to themselves. The designation of a locality cannot serve as the foundation of an exclusive right.

§ 191. The Congress Spring case [1] is not an exception to the general rule; for in that it was shown that the plaintiff had the sole title to the place which was the source of the medicinal waters to which the name or mark was affixed. The same name could not be used with truth by other dealers in mineral waters. The Brooklyn White Lead case [2] is in point. There it was decided that all manufacturers in Brooklyn could properly use the name. The defendant was enjoined against the use of the word "Company" or "Co.," which was a fraudulent part-imitation of the plaintiff's label; but was permitted to use the name of his place of manufacture.

§ 192. **When is a Name merely Geographical?** — When we glance at the case of *Armistead* v. *Blackwell* (in the chapter on Interferences), and see how judicial officers disagreed as to the meaning of the word "Durham," we hesitate before making answer. A word may be considered to be geographical or not, according to the circumstances of the case. If *merely* geographical, we know that it cannot be a lawful trade-mark. It behooves us, therefore, to scan closely.

§ 193. This question frequently comes up in the Patent Office; and the rule for answering it is well-settled. If the word is not intended to be geographical, and is not taken to be such by the public, it is not such. It will have become, as an arbitrary symbol, as good an index as could be any other symbol. Thus the word "MARIELAND," although intended for a mark for merchandise manufactured in Maryland, is free from objection.[3] The change in the spelling, and slight differ-

[1] 57 Barb. 526, and 4 Am. Law Times R. (St.) 168.
[2] 25 Barb. 416.
[3] Malcolm Crichton, No. 925.

ence of sound, are sufficient to distinguish it from the usual and proper designation of the original *Terra Mariæ*, named for Henriette Marie, the queen of Charles I. of England. And no reasonable person would think that the use of the name "MONTICELLO," for whiskey, was intended to intimate that the article was distilled or sold at the home of the venerated "Sage of Monticello;"[1] or that the term "KENTUCKY PIONEER"[2] necessarily meant that it was made in Kentucky by the pioneer Daniel Boone; or that "BAY STATE" meant to imply Massachusetts.[3] At first it was thought that the words "VIEILLE MONTAGNE" were open to the objection of being a mere geographical designation, just as "Old Mountain" might be if the French were translated; but, upon reflection, it was concluded that the words could not, without straining their meaning, be taken to import that the green paint to which it was intended they should be affixed was manufactured at a place of that name.[4] So "WISCONSIN WOOD CHOPPER" could not mislead any reflecting mind into supposing that the axe bearing that mark was peculiar to, or made in any particular State.[5] The word "SCIOTO" is the name of the county, as Sciotoville is the name of the town, where the applicants make fire-brick, tiles, &c.; wherefore the Examiner rejected the application, as a geographical term, which any one in the county had a right to use. The Commissioner took another view of the matter, regarding it as an arbitrary symbol which no one else would be likely to impress on brick. Passed.[6] It is not understood upon what principle this decision in the Scioto case could possibly be sustained. It may be that it never shall be brought in controversy in a judicial proceeding. If others have an equal right to use the name upon the same kind of wares, then it cannot be a trade-mark, for the essential element of exclusive right is lacking. We can understand how, if one

[1] Malcolm Crichton, No. 877.
[2] Adams & Taylor, No. 692.
[3] Bay State Iron Co., No. 875.
[4] Walter & Fielding, No. 494.
[5] Biddle Hardware Co., No. 923.
[6] McConnell, Porter, & Co., No. 510; *Vide* Newman *v.* Alvord, *ubi supra*.

not in a place of that name should fraudulently usurp the word as a mark, a court of equity would be called on to enjoin the wrong-doer, as in the Akron case, as an ordinary case of fraud, — not for violation of a trade-mark.

§ 194. As an illustrative case we will take the application for the word "ANGOSTURA" to be used in combination with bitters. The Examiner answered the claim, thus: The article called "Angostura Bitters" is well known as such, to the commercial public at least. A tincture of Angostura Bitters is official in the Pharmacopœia of some European countries. Ure's Dictionary of Arts, &c., mentions the article among other bitter substances used in art and medicine, as quassia, wormwood, orange, gentian, tansy, coffee, &c. He also stated that he was credibly informed by experts, that a favorite drink called a "cock-tail" is composed in part of said bitters. The principal point was whether the word "Angostura" was not a geographical name; and it was held not to be, for the reason that the word "Angostura" had been first used by Dr. Siegert, under whom the applicant claimed. It had become a fancy name; and as the claimant proved his claim to the exclusive use of it, as the denomination of an article of which he was sole vendor, it was admitted to registration.[1]

[1] W. H. Knoepfel, No. 580.

CHAPTER V.

EXAMPLES OF TRADE-MARKS.

One's Own Name. — Autograph. — Fac-simile of Autograph. — Initials. — Pseudonym. — Derivative from Surname. — Fancy Names of Men. — Name of Man may become Generic. — Natural Product. — Pictures. — Heraldry. — Monograms and Ciphers. — Color as an Element. — Form Essential. — Exemplars of Registered Trade-marks. — Cases rejected as merely indicating Quality.

§ 195. **One's Own Name.** — To what extent will a person's name be protected as a trade-mark? This question has its difficulty. The Act of Congress of July 8, 1870, sec. 79, prohibits the registration of a proposed trade-mark "which is merely the name of a person, firm, or corporation;" but the same section provides that that "shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act." The proviso opens the door to evidence that such name had previously become a "lawful trade-mark rightfully used." As an abstract proposition, such a name would not be protected, if another might truthfully use it. We must take the judicial decisions on this point, with all their circumstances. One case might be sustained; another not.

§ 196. What is a name? This question, which will also arise under section 79 of the law, is not an idle one, nor ought an investigation into its legal meaning to be thought pedantic or far-fetching. It has been well settled that a middle name or initial is not part of a person's name. The law knows of but one Christian name.[1] The addition of "senior" or "junior" is

[1] Co. Littleton, 3 a; 1 Lord Raymond, 562; 5 Johns. 84; 2 Cow. 463.

a mere matter of description, — *descriptio personæ*, — and forms no part of one's name, it being a casual and temporary designation.[1] If J. Smith is no name, then a deed or other instrument conveys no title or right to protection. One baptismal or given name out of half a score would satisfy the demand of the law in this respect; but that one name must be given in full, not in an initial letter, which means nothing or many things, and therefore, on account of its uncertainty, is worthless for the purpose of identification. Probably the surname might legally be dispensed with, or changed at pleasure.[2] A man's name is an emblem or symbol of himself, — a mark by which he may be known and identified. Here is a curious case: About the year 1825, at the Hereford assizes, in England, a Welsh witness, John Jones, was examined. He said that he had always gone by that name, while admitting, on cross-examination, that in Wales he had gone by the name of Evan Evans. The discrepancy was explained by showing that Evan is the Welsh synonyme of John, and Evans that of Jones. So he was John Jones in England, but at home he was Evan Evans, just by the rule which turns François Blanc, the Gaul, into Francis White, the American citizen; or Wilhelm Schwarz, the Teuton, into William Black, American: the name of a grandee of the Flowery Kingdom into a sonorous English cognomen. The surname, as distinguished from the Christian name, is the name over and above, — not the sirename, or name received from the father, but sur'name (*super-nomen*). There never was a time when every baptized man had not a Christian name, inasmuch as his personality before God was recognized.[3] Upon good authority, it is stated that but few of the miners of Staffordshire, in England, choose to retain the names of their fathers; and we look in vain for a law to restrain them from the confusion that must frequently arise from severing this clew to

[1] 7 Johns. 549; 11 Wend. 522; 1 Hill, 102.
[2] See matter of Snook, 2 Hilton, 566.
[3] Trench, Study of Words.

their identity. A single name, generally, sufficed for the early Hebrews, for each name bore significance; as, for example, Adam, *i.e.*, "man in the image of God;" Seth, "substituted by;" Enos, "frail man." Our ancestors were as easily satisfied with personal names, until, amid the increasing multitudes, it became necessary to more clearly designate persons. The year 1000 is the proximate date for the assumption of family names. The practice commenced in Normandy, and gradually obtained in England, Ireland, and Scotland, although at an earlier period surnames were occasionally hereditary in Great Britain. After the Conquest, the down-trodden nations began to copy the customs of their oppressors, and soon, from the haughty noble down through the various grades of society, all asserted the right to a distinctive *nom de famille*. A patronymic, in its true and original sense, is a modification of the father's name borne by the child, as Tydides, the son of Tydeus. The ancients formed their patronymics by an addition to the father's name, and modern nations have sometimes done the same, as, for example, John-son, Paulo-witz, Peter-kins; or by a prefix, as O'Brien, MacIntosh, Fitz-Herbert, Ap-John. In discussing this subject, Camden says, "Neither have they seene (I fear) any deed or donation before the Conquest, but sub-signed with crosses, and single names, without surnames, in this manner, in England: '+ *Ego Eadredus confirmaui;*' and '+ *Ego Edmundus corroboraui*,' in Scotland."

§ 197. It is the opinion of the ablest jurists that a person's name cannot be an essential element of his trade-mark; and such is the settled doctrine of the Patent Office. That means his proper appellation, — the name by which he passes in every-day life, the baptismal name joined to that of his father; and he may have a fancy surname, or no surname at all, as in the case of an Indian, or one who was born in slavery with paternity unknown. Or, as has been mentioned in another place, the name may have been translated. The use of the Latin language in the Middle Ages led to the frequent translation of

names. The French was also changed into English equivalents, having at times similar sounds, with the slightest reference to the original signification. Who, for instance, now associates the well-known Mortimer with the forgotten exploit of an ancestor in the Crusades; a "*De Mortuo Mari*" with the *Dead Sea?*

§ 198. **Allusive Names** may be, and sometimes are, used for marks. In the time of Henry III., G. de Lucy had for his arms *three lucies*, — fish now known as pike; Robert Quincy had a *quintefeuil*, — a flower of five leaves; Thomas Corbett had two *corbeaux*, — ravens; Sir O. Heron had three *herons;* Falconer, a *falcon;* Butler, *cups;* Forester, *bugle-horns;* Shelley, *shells.* If sufficient for arms, the same fanciful designations may well serve as trade-marks; and although suggestive of the real names, they are not on that account objectionable.

§ 199. Vice-Chancellor Wood, in *Ainsworth* v. *Walmesley*, in 1865,[1] considered this question, and held that a man's own name is his trade-mark, when united with other words which in themselves might not be such. He therefore upheld the designation of "Ainsworth's Thread," the plaintiff being an extensive manufacturer of thread, and his goods being well known in market by that name. But inasmuch as the defendant was not shown to have misrepresented the goods sold as being those of the plaintiff, the bill was dismissed.

§ 200. Here is a case which shows how a man may, by the use of his true name, attempt to conceal a fraudulent conception. In the Tribunal Civ. of the Seine, in 1863,[2] Eugène Bernard sued the Emonds, father and son. The plaintiff, a French armorer, established at Liége, in Belgium, had registered his trade-mark in France, under a treaty made in 1861. The mark was, "*E. Bernard, Canonnier de Paris,*" with his initials, "E. B.," which he stamped upon the arms. The defendants had imitated that mark on the same class of merchandise. *Held*, that a trade-mark has no object but

[1] 44 L. J. R. 252.

[2] Annales de la Prop., tome x. p. 375.

that of distinguishing the products of manufacture of him who has adopted it; that the object of the law of 1857 is to guaranty against unfair competition, by one vending his products as emanating from another; that E. Bernard is not a cannonier of Paris, where he has no establishment, but is only a manufacturer in Belgium; that the mark taken by him has evidently for an object not to guaranty the identity of his products, but to deceive the public in France, by causing them to confound the cannon coming from Belgium with the important house of Bernard in Paris, who make similar products; and that the law was not made to protect such marks and such frauds.

§ 201. In *Curtis* v. *Bryan*,[1] before the general term of the Court of Common Pleas of the city of New York, in 1868, the following facts appeared: Previous to the year 1844, Mrs. Charlotte N. Winslow prepared a composition for children teething, which she used with success. In 1844, she gave the recipe to her son-in-law, Jeremiah Curtis, one of the plaintiffs, who continued to manufacture and sell it under the name of "*Mrs. Winslow's Soothing Syrup;*" and, with the approval of Mrs. Winslow, he made that his trade-mark. The defendant, in 1867, commenced the manufacture of a preparation, in color and appearance resembling that of the plaintiffs, under the name of "*Mrs. H. M. Winslow's Soothing Syrup*," and with a label of the same size, color, and style as that of the plaintiffs. The imitation was close in other respects, and was evidently intended to mislead the public. To justify the use by him of the name of "Winslow," the defendant claimed that a variety of soothing syrups had been made and sold by John M. Winslow, a certain druggist; that he had purchased the formula of his remedy from said Winslow, who had invented it as early as 1842. The court held the claim of the defendant to be fraudulent, and the injunction granted was sustained with costs. We must remember that this was a case of fraud, in a court of equity. The right of the plaintiffs to this remedy

[1] 2 Daly, 212, and 36 How. Pr. R. 33.

did not depend upon the fact that the words mentioned constituted a valid trade-mark. Anybody named Winslow had a right to make and vend soothing syrup, and to combine his name with the generic term, if the sale thereof were not attended by circumstances of fraud or deceit. In accordance with rules elsewhere laid down, we must conclude that the words, "Mrs. Winslow's Soothing Syrup," are not *per se* a "lawful trade-mark." In *Howe* v. *The Howe Machine Company*,[1] before a general term of the Supreme Court of New York, in 1867, Sutherland, J., said that it was clear that the plaintiff could adopt and appropriate the word "Howe" as a trade-mark as against Elias Howe, Jr. "The plaintiff had a right to adopt and appropriate his surname as a trade-mark, and it cannot be said that Elias Howe, Jr., though his surname was the same, had a right to use his own surname in such a way as to deceive the public, and deprive the plaintiff of the benefit of the notoriety and market which his machines had gained." Elias Howe, Jr., in 1846, obtained a patent for a certain combination of mechanism called a sewing-machine. His brother, the plaintiff, commenced manufacturing sewing-machines as early as 1854, using the said combination, as the licensee of the patentee. These are undisputed facts. The uncontradicted history of the claimed trade-mark is, that before 1857, the plaintiff placed on the machines the letters and word "A. B. Howe;" that, in 1857, the plaintiff adopted "Howe" as the substitute therefor, and subsequently every machine manufactured by the plaintiff had the word "Howe" on it, in a conspicuous place. The judge said that "the conclusion from the pleadings and affidavits is irresistible that the word 'Howe' was thus used to denote the plaintiff, as the manufacturer, and not to denote Elias Howe, Jr., as the inventor. . . . Elias Howe, Jr., granted to the plaintiff, to Singer & Co., to Grover & Baker, to Wheeler & Wilson, &c., the right to use his patented right or combination, in the manufacture of

[1] 50 Barb. 236.

sewing-machines. It is obvious that the circumstance that these licensees did use, and had to use, his patented right or combination, as his licensees, in manufacturing their machines, cannot have the remotest bearing on the question of the right of either of these licensees to adopt and appropriate a trade-mark, even as against Elias Howe, Jr., as a manufacturer of sewing-machines." The judge cited *Sykes* v. *Sykes*,[1] where the manufacture simulated was shot-belts and powder-flasks, stamped "Sykes' Patent;" also *Croft* v. *Day*,[2] which is as follows: A blacking manufactory had long been carried on under the firm of Day & Martin, at 97 High Holborn. The executors of the survivor continued the business under the same name. A person of the name of Day, having obtained the authority of one Martin to use his name, set up the same trade at 90½ Holborn Hill, and sold the blacking as of the manufacture of Day & Martin, 90½ Holborn Hill, in bottles and with labels having a general resemblance to those of the original firm. He was restrained.

§ 202. Can we regard these two English cases as furnishing apt illustrations of the doctrine of Judge Sutherland? The cases differ in this: in the Sykes and the Day suits, the fact of fraudulent intent was too manifest to admit of doubt; but in the Howe case the defendant had in good faith used the name of the inventor, the president of the company. Leonard, P. J., said: "There is no fraud upon the plaintiff in the use by the defendants of the name of 'Howe,' as designating a machine manufactured by them, which Elias Howe, Jr., had invented, and from which the defendants derive their right to use the name." The injunction was accordingly refused. Therefore, notwithstanding the language of Judge Sutherland, as stated, it was virtually decided that the name "Howe" was not a trade-mark. How could it be under the admitted facts? Several firms, wholly independent of each other, had, by license from the inventor, acquired the right to make and vend his

[1] 3 Barn. & Cres. 541.

[2] 7 Beav. 84.

machine. A lawful trade-mark is exclusive property. All had the right to use the name "Howe." Therefore that name was not a trade-mark. Yet, although not technically such, under circumstances of fraudulent usurpation, the infringement of it would be restrained, as would any other act of unlawful competition.

§ 203. In *Thomson* v. *Winchester*,[1] before the Supreme Judicial Court of Massachusetts, in 1837, it was alleged that the plaintiff had discovered valuable medicinal properties in various vegetable substances, and the best manner of compounding the same for medical purposes, to which substances so compounded he had given the name of "Thomsonian Medicines;" and that the defendant made an inferior article, to which he improperly applied the same name. *Held*, the plaintiff had no exclusive right or privilege to compound or vend the medicines called "Thomsonian," although he was the original inventor; and that he had no more right than the defendant to make and vend these medicines, or call them "Thomsonian," if his term had acquired a generic meaning, descriptive of a general kind, quality, and class of medicines; as, for instance, James's Powders, or Turlington's Balsam.

§ 204. **One's Autograph** is good for this purpose. The Act of Congress prohibits the Commissioner of Patents from receiving and recording any proposed trade-mark which is merely the name of a person, firm, or corporation, unless accompanied by a *mark* sufficient to distinguish it from the same name when used by others.[2] One's autograph is his emblem or symbol of himself. It is not merely his name. If another of the same name have the same signature for the same purpose, the coincidence may be embarrassing, and raise a question of fact for a jury to weigh and settle. The similarity may be fortuitous and without fraudulent intent. Unless a man can invent a peculiar flourish or other characteristic sign-manual, he had better adopt something else with it. The same may

[1] 19 Pick. 214.

[2] Sec. 79, Act of July 8, 1870.

be said of the name of a firm, or of a corporation. "Doe & Roe," or "The Smith Manufacturing Company," might possibly lead to a confusion of persons; for the public cannot be assumed to know which firm or corporation shall have affixed its name to merchandise. This is a universal rule; but it has its exceptions in all countries, and even the Act of Congress above cited provides for exceptional cases in saying "that this section shall not prevent the registry of any lawful trade-mark, rightfully used at the time of the passage of this act."

§ 205. In *Ainsworth* v. *Walmesley*,[1] in 1865, Vice-Chancellor Wood ably discussed this question. He said that if Mr. Jones, or Mr. Brown, relies on his name, he may find his name a very inadequate security, because there are several persons of the same name, it may be, *bonâ fide* carrying on the same trade. But he had not in evidence before him that any other person than the plaintiff has ever been heard of as manufacturing Ainsworth's thread; and therefore "Ainsworth's Thread" is as good a mark as "Anchor Thread," or "Lion Thread," or any other thread which may be described by a particular name. The fraud of the defendant, in palming off his thread as that of the plaintiff, had been clearly established, and justified the decision in favor of the plaintiff. It was contended on behalf of the defendant that the case was not one of trade-mark at all; that no trade-mark was used, or was alleged to have been used, there being nothing but a simple representation that the thread was sold by the defendant as Ainsworth's; that, it was argued, was not a case in which, if the representation had been innocently made, complaint could properly be urged in this court, because a trade-mark depends upon property; that, a trade-mark being property, the use of a man's name was a simple fraud of another description requiring the *scienter* in order to constitute a wrong in respect to which the court will relieve. But the Vice-Chancellor replied that a man's name is still stronger than any which can

[1] 44 L. J. R. 252.

well be devised, subject only to this inconvenience which a name has, and a trade-mark has not, that two people may be of the same name.

§ 206. The rule is that a man cannot turn his name into a trade-mark. Any other rule would lead to most absurd consequences. There are several *dicta* the other way; but they must be attributed to a loose habit of speech, or a want of acquaintance with the indispensable requisites of the technical mark. No wise man in these days would for an instant rely upon such an insecure tenure of title. If one man's name may be a trade-mark, so may any other man's name be also; John Smith is a man's name: therefore John Smith is a valid trade-mark. Syllogistic absurdity!

§ 207. **Fac-simile of Autograph.** — This is just as valid for the purposes of a trade-mark as is the original signature. A person may place his handwriting to each article he makes or sells, or he may make any other kind of a sign to identify it; and a copy of his autograph is therefore admirably adapted to the purpose. The national currency, Gillott's pen-boxes, and many other familiar objects may be brought forward as evidence of the practice. The Patent Office has in a number of instances accepted copies of signatures as legitimate marks. Thus, as a mark for a certain medicine, the secret of compounding of which the applicant derived from another, with the right to the use of the imitation of the signature upon an elaborate label;[1] as a mark for Jamaica Ginger, which for many years had enjoyed a reputation, the applicant's right to the fac-simile of his father, and predecessor in business, was recognized;[2] and the well-known firm signature of John Anderson & Co., upon chewing-tobacco, was registered for the claimants' successors in business of the original members of the partnership.[3]

§ 208. In these cases there could be no question as to the apparent right of the several claimants to make those copies

[1] Cochran Fleming, No. 756. [2] Fred. Brown, No. 715.
[3] Arthur Gillender & Co., No. 767.

essential elements of trade-marks; for they clearly deduced their titles from their ancestors or predecessors in business, and have such distinct labels and notices as cannot fail to enlighten the public as to their true position. But there have been instances of applications for copies of autographs which seemed to have been adopted for the sole design of deceiving the public into the belief that the original manufacturer still continued in business, and that the articles to which the fac-simile was to be attached was made by him. Superior excellence must have been attributed to such original manufacturer; and the purchaser must base a preference upon the fact of the thing being the fabric of the inventor, the compounder, or why would his name be used? It is done to gain credit. The article would not command a market without that peculiar mark. Fraud may lurk in such a case. Therefore, when a fac-simile of an autograph is offered for registration, unless accompanied by indubitable evidence of good faith, or under circumstances which create the presumption of a rightful use, the claim will be rejected, lest a false credit be thereby tolerated.

§ 209. The case of *Compere* v. *Bajou et als.*,[1] decided in the Tribunal of Commerce of Paris, in 1854, and affirmed on appeal, is one that is apt to stagger the judgment of a student. It appeared that the defendant, Bajou, had assigned his business as a glove-maker, and the good-will thereto attached. The assignee was authorized by Bajou to adopt, exclusively of every other person, the description of successor to Bajou, and to use, as the mark for his gloves, the stamp employed by him as the manufacturer's mark, being the fac-simile of his signature. It was also agreed that Bajou should not have the right to establish, to purchase, or be a partner in, any manufacture of this nature, either at Paris, or any other town in France, with the exception of Grenoble; and, moreover, that he might in Grenoble only deal in gloves called "Grenoble manufacture,"

[1] Copied in full in Upton, p. 73.

and marked with the stamp of that town. Bajou disregarded his agreement, and stamped a certain quantity of gloves with his manufacturer's mark, the fac-simile of his signature. He sent the gloves thus marked to New York. The tribunal said that the manufacturer's mark for this species of industry — the mark being advantageously known — is an indispensable auxiliary for insuring a sale, more especially in America; and that, besides, it is not the custom at Grenoble to mark with one's name the gloves manufactured there. It was also held, that in assigning for a certain sum his *good-will*, Bajou *really assigned all his right to the manufacturer's mark*, in which the true value of the business consisted, since it is upon the mark that the custom depended. Further, that it was in vain for Bajou to pretend that he had the right to apply to his new manufacture the manufacturer's mark which he had assigned; for that would be not only to seek to resume that which he had assigned, and of which he had received the price, but also to endeavor to apply for his own benefit the increased custom of the assignee. He was, therefore, prohibited from employing in the future his name as a manufacturer's mark upon his gloves, and heavily fined.

§ 210. To the casual observer, this might seem like an authority to commit a fraud upon the public, and upon purchasers in foreign countries, by the means of a misrepresentation, to wit, that Bajou himself had made the gloves. That was not the meaning of the judgment of the tribunal of first instance, nor of the Imperial Court of Appeals of Paris, which affirmed the decision. The latter held that the exclusive title to the mark had passed to the assignee, the right to the use of the stamp till then employed by Bajou being one of the essential ingredients of the contract; that the stamp, being the only means of establishing the source of the goods, and of retaining the custom depending on it, had become, by force of circumstances, an accessory of the good-will transferred; and that the arrangements adopted by Bajou, to make known abroad that he had

recommenced trade, had no other object than to take from the actual owners of the business a part of the benefits insured to them. This was as much as to say that the case is essentially one of good-will, and that the mark is an incident to it. It is a matter of unlawful competition in trade. It did not mean that the *mere* fac-simile of Bajou's signature could be used by the assignee; for that were to encourage fraud. The law of France is opposed to any such idea. The rule of commercial morality is far more stringent there than in many other countries. The 21st article of the Code of Commerce is, that "the name of the associates can alone constitute the firm name" (*la raison sociale*). This is intended to forbid persons who succeed to the business of another from continuing it under his name. Credit is altogether personal.[1] What, then, did the court mean?

§ 211. If we look back, we will see that Bajou authorized his assignee to adopt, exclusively of every other person, the description of *successor*. The law of France requires the words "successor of" to appear in such case. The public could not be misled, and the assignee of the mark would thereby be enabled to secure custom, as the successor of a reputable manufacturer; as the one who had availed himself of all the appliances and means of attaining excellence that the other had possessed.

§ 212. A designation may become a lawful trade-mark, although originally composed of simple initials. It may be accepted in commerce as indicating a name other than that of the manufacturer who claims it. It thus virtually becomes a pseudonym, or, more properly speaking, a fancy symbol. In the Tribunal of Commerce of the Seine, in 1857, came up the following case: Jean Bardou, the plaintiff, a manufacturer of cigarette-paper, has been in the habit of marking his products with his initials, "J. B.," separated by a lozenge, so that the

[1] See remarks of Hoffman, J., in Howe *v.* Searing, 10 Abb. Pr. R. 264; 6 Bos. 354; and 19 How. Pr. R. 14.

mark seemed to be composed of the word "JOB." The public soon became accustomed to the mark, but mistaking its component parts, asked for "*Job*" paper. Lassausée, the defendant, who was engaged in the same kind of business, took an associate named Job, and without hesitation took also the mark "Job." His defence to the suit was that he had a perfect right to use the genuine name of his partner. The court scouted so shallow a pretence, and punished him severely.[1]

§ 213. **Pseudonyms.** — During the Middle Ages it was rather the rule for an author not to publish under his real name, either from prudential motives or because of excessive modesty. When all serious works were written in Latin, Teutonic, and even Gallic, names had an awkward appearance among Ciceronian adjectives. They were therefore softened by Latinizing or Hellenizing them. When the name was significant, it might be literally translated. The great reformer of Germany, Philip Schwartzerde, not admiring an uncouth cognomen, signifying black-earth, changed it into the mellifluous Greek: and it has come floating down to us through three centuries, as Melancthon. England has furnished another conspicuous example in her "Nominis Umbra," as Byron calls him.[2] We need be at no loss for instances of feigned names among authors of our own century. Mr. Herbert takes as his *nom de plume* "Frank Forrester," Mrs. Judson took "Fanny Forrester," Dr. Holland figures as "Timothy Titcomb," Miss Dodge as "Gail Hamilton;" and many similar cases are familiar as household words. In England, a writer whose initials are H. N. B. recently put forth a novel purporting to have been written by "Mr. Aitchenbee." All such names would be protected as lawful proprietary marks. In 1838, Felix Tournachon took the pseudonym of "NADAR," which he affixed to all his productions, as an artistic and literary mark to the fruit of his toils. It was held by the Court of Paris, in *Tournachon* v. *Tournachon*,[3] that this feigned name was a valid trade-mark; and

[1] Annales de la Prop., tome iii. p. 125.
[2] Junius.
[3] Annales de la Prop., tome iv. 83.

that decision was affirmed by the highest court. So. in the Tribunal of Commerce of the Seine, in 1867, in the case of *Gravelet (dit Blondin)* v. *Arnault*,[1] it was decided that a pseudonym can become property in him who has given celebrity to it, and as well in the arts as in mechanical industries. PER CUR.: Gravelet took, many years since, the pseudonym of Blondin, under which he is generally known, and in various countries as an acrobat had gained a notoriety for his name. With the object of competition, Arnault, director of the Hippodrome, announced a spectacle in which should appear an acrobat to whom he gave the name of Blondin, and announced as the veritable Blondin. *Held*, to be an infringement. Enjoined. Damages, 500 francs. Publication in the newspapers at defendant's expense.

§ 214. There have been instances in the Patent Office of persons using sobriquets of themselves for trade-marks. One person, a manufacturer of clothing, uses the term "LITTLE JAKE," and has had it registered.[2] It is not very doubtful that the political editor known as "BRICK POMEROY" could claim the exclusive right to that classical title; for there is but one person in the whole of creation who could be meant thereby.

§ 215. In the reign of Chin-tsong in China, in the sixteenth century, lived a celebrated artist of the name of Ou, who withdrew from the world. He produced, in secret, porcelain remarkable alike for its quality and the beauty of its colors. Under the foot of his vases he engraved in the paste his peculiar mark, that by which his workmanship was identified. The translation of it is — "The old man Ou, who lives in solitude."[3] Whether regarded as a mere denomination of fancy, as a pseudonym, or as his genuine signature, this mark denoted origin and ownership, and carried with it a guaranty of excellence.

§ 216. **Fancy Names of Men.** — We have many instances of such names becoming valid trade-marks. In the case of *Barrows* v. *Knight*,[4] in the Supreme Court of Rhode Island, before all the

[1] Annales de la Prop., tome xiii. p. 303. [2] Jacob Seligman, No. 828.
[3] Marryat's Pottery and Porcelain. London, 1857. [4] 6 R. I. 434.

justices, it was *held*, that "Roger Williams," though the name of a famous person, long since dead, is, as applied to cotton cloth, a fancy name, as would be, so applied, the names of Washington, Greene, Perry, or of any other heroes, living or dead. Said Ames, C. J., in delivering the opinion of the court: "It is quite as peculiar and significant, in such an application as Persian Thread, Mexican Balm for Hair, Vegetable Pain Killer, Houqua's Mixture, for tea, or Ethiopian, for stockings, or the numerous other fanciful names which have been treated as appropriate trade-marks." In *Messerole* v. *Tynberg*,[1] the plaintiffs claimed an exclusive right to use the word "BISMARCK," in its application to paper collars. The court *held*, that the plaintiffs had the right to appropriate said name, in common with others, for a new purpose; and having done so, are entitled to avail themselves of all the advantages of their superior diligence and industry. In the Court of Paris (*Dalbanne & Petit* v. *Coleuille & Co.*[2]), where both parties used the name "LAMARTINE" for a certain elixir, the court said, on appeal: There is no doubt that proper names, other than those of the manufacturer, can be employed like any other sign, as a distinct mark of industrial products, and thus become veritable property, not as a title or mode of appellation, but as a commercial mark. In the case of *Wedgwood et .als.* v. *Smith et als.*, before the Vice-Chancellor of England, in the year 1848, the defendants were restrained from using the name of "Wedgwood," or "Wedgewood," on their wares, it having been shown that the name "Wedgwood" had been used as a trade-mark by the family of the Wedgwoods for centuries.[3] The Court of Paris, in 1867 (case of *Sargent* v. *Romeu*[4]), sustained the right of plaintiff to the words "ROYAL VICTORIA."

§ 217. The applicant, at times, by an addition to his patronymic, or variation thereof, makes a convenient and peculiar

[1] 4 Abb. Pr. Rep. (n.s.) 410; 36 How. Pr. Rep. 14.
[2] Annales de la Prop., tome vii. p. 414.
[3] Jewitt's Life of Josiah Wedgwood, p. 385.
[4] Annales de la Prop., tome xiii. p. 21.

mark. Thus "MAYOLINE,"[1] "EDGERLINE,"[2] and "ROSEBAUME"[3] have come into existence. Although perhaps suggestive of the names of their appropriators, they are sufficiently distinctive to serve their true purpose.

§ 218. Again, the name of some defunct person, or of some one whose creation sprang from the brain of the poet or novelist, is found to be serviceable. If understood by the public to be nothing more than a mere fancy designation,— one which has lost its original character and become an unmeaning symbol,— then it may be entitled to recognition as the veritable mark of commerce. When we see "DOLLY VARDEN"[4] upon fancy paper, we do not think of the charming daughter of the London locksmith, Gabriel Varden by name, who lived in the reign of George III., but we associate the name with a certain manufacture of goods. Thus, in or about the year 1871, the public recognized what were then known as "cretonnes" as the make of a certain inspired *modiste*, who had the name transformed into a mark. Silks, chintzes, and other dry-goods, now bear the title; and for each class of merchandise it is a mark that the law will protect, and secure the exclusive use of it to the first adoptor thereof. "PAUL JONES," the name of a somewhat famous naval hero in the early history of our nation, has been impressed into the service as a brand for whiskey.[5] So has the traditional "YOUNG AMERICA"[6] been placed upon writing-ink for the use of the scions symbolized by that appellation. "APOLLO"[7] indicates a certain species of gin; "RIP VAN WINKLE,"[8] a brand of whiskey; "FALLSTAFF,"[9] "GULLIVER,"[10] "UNCLE BOB LEE,"[11] "OUR FRITZ,"[12] "BROWN DICK,"[13] "LONE

[1] U. K. Mayo, No. 904.
[2] H. B. Edgerley, No. 610.
[3] J. Rose, No. 807.
[4] Bergen & Bainbridge, No. 838.
[5] Walsh, Brooks, & Kellogg, No. 702.
[6] Adams & Fay, No. 912.
[7] Gill & Lootz, No. 531.
[8] A. W. Balch & Co., No. 601.
[9] David Hirsch, No. 23.
[10] David Hirsch, No. 24.
[11] Winfree & Lyon, No. 402.
[12] J. W. Carroll, No. 156.
[13] J. W. Carroll, No. 157.

JACK,"[1] and "PHIL SHERIDAN"[2] authenticate particular manufacture of cigars, or of chewing or smoking tobacco.

§ 219. **New Words.** — The coiner of a new word, employed by him to designate an article made or sold by him, may obtain such a right to that name as to entitle him to the sole use of it, as against others who attempt its use for the sale of a similar article. The introducer of a new word, or of new words into a language, may by a parity of reasoning acquire the same right, on the same terms. He is virtually a coiner of a word who first applies it as an arbitrary symbol, to express the origin of the article of merchandise to which it is affixed. We need not strain a point to inquire into the question of the possible coincidence of a supposed neologism with a word or term used in some language other than our own. Is it new in its present application? Has it ever been used before as applicable to similar articles? Does the word proposed to be adopted denote only the nature, kind, or quality of the goods bearing it? If so, it cannot be exclusively appropriated, lest the whole language should gradually be laid under prohibition. Is it the necessary name of the article, — the term by which it is known to commerce in general? Yea. Then it cannot be made a private mark. The present nomenclature of chemistry is a remarkable instance of the formation of new words; yet no one would pretend that when a new term has been struck into definite form, by the rules laid down for the combination of scientific terms, that because he was perchance the first who used it, he could interdict all others from its use. If that could be done, the slightest modification of a word would vest in somebody an exclusive title, and fetter the common language, until it would not be safe to add a particle, or inflect a syllable. Has the claimant the exclusive right to make and vend the new article? If yes, he may coin for it a new name, and, so long as he continues to possess the monopoly, he has

[1] J. W. Carroll, No. 158. [2] Smith, Crosby, & Co., No. 244.

the sole title to the name. The following case will illustrate this well-settled doctrine.

§ 220. In *Caswell* v. *Davis*,[1] at a special term of the New York Common Pleas, in 1867, the plaintiffs claimed the name affixed by them to the medicine which was first compounded by them in 1861, — "FERRO-PHOSPHORATED ELIXIR OF CALISAYA BARK,"— as a trade-mark. They based their claim on priority of adoption. The plaintiffs did not seek to enjoin the defendant from manufacturing and selling his compound, or any other mixture composed of any elements; but insisted that he should not sell it with a label bearing upon it the name above given. There was some evidence tending to show that similar preparations, in some of the essential elements, had been made and were in use before the plaintiffs experimented on, or produced their article; but it was not established that any mixture composed of all the ingredients used by the plaintiffs, or having a name in all respects similar to that adopted and applied by them, was in use or known to the public before the plaintiffs introduced their medicine. The Elixir of Calisaya, or Peruvian Bark, was in use, and perhaps in solution with iron in some form. But this case shows that this composition, with its peculiar and specific substances, was first introduced by the plaintiffs under its peculiar name, "Ferro-phosphorated Elixir of Calisaya Bark," and that they first applied the specific word "ferro-phosphorated" to any medicine. The article compounded by the plaintiffs, as a whole, was original with them. In the condition in which it was presented to the public it was new. As it was a recent composition, it would, of necessity, require a characteristic name, if its elements were to be indicated in its appellation. Compounded of substances known principally in chemistry, which science has a nomenclature peculiar to itself, the words to distinguish it would be in a language familiar to chemists, and that limited class of persons who deal in drugs and chemicals. It is true that the meaning of the

[1] 4 Abb. Pr. R. (N.S.) 6, and 35 How. Pr. R. 75.

words, singly, which mark the compound in question, is known to a large class of persons other than those designated ; but, so far as the word "ferro-phosphorated" is concerned, it cannot be said that it is in common or general use, or that it is even understood by the great number of persons who take the remedy on the advice of physicians, as indicating the true nature and character of the mixture. They may, and doubtless do, in most cases, understand that the medicine prescribed contains Peruvian bark and iron ; but as they read the label on the bottle they do not learn from it what the article really is, although its elements generally are indicated by the words used. They are not like words in common use, in any true sense, words which carry to the mind of all classes of persons, the instant the eye lights on them, the true character of the contents of the package upon which they are placed. All understand what mean the words "tobacco," "gin," "brandy," "cotton yarn ;" but the words "Ferro-phosphorated Elixir of Calisaya Bark" would be unintelligible to most persons. Such is nearly the precise language of Van Vorst, J. In discussing the novelty of the term employed by the plaintiffs, he further said: "'Ferrum,' of which 'ferro' is a form, is a common word in the Latin ; and 'phosphorated' is recognized by Webster as an English word. But I am of the opinion that no such word as 'ferro' and 'phosphorated' in combination is to be found in any language, except the forming of it by the plaintiffs has had the effect to introduce it ; and if so, plaintiffs are entitled to the credit and use of it. The combined word, I am satisfied, is philologically incorrect. I do not suggest that the word is meaningless, or that its elements do not indicate in a general way some of the ingredients of the preparation ; but it does not do so chemically, or in an exact sense, and was doubtless arbitrarily arranged and invented by plaintiffs." There was a fact, also, which had some influence on the mind of the court. Several physicians testified that they had used this remedy for years ; and that when they prescribed "Ferro-phosphorated Elixir of Calisaya Bark" they intended

the medicine of that name manufactured and sold by the plaintiffs. Another fact appeared. The defendant was in the employment of the plaintiffs when the experiments were made which resulted in the production of the article. He availed himself of the information gained while in a confidential relation. *Held*, that the plaintiffs are entitled to the exclusive use of the word "ferro-phosphorated" alone or in combination with any other words, and that their label to that extent is a proper subject of a trade-mark.

§ 221. If the compound word thus protected by the court had been philologically correct, and were necessary to denote the article to which it was affixed, it could not have been sustained as a mark of commerce. It was a newly-coined arbitrary term, and a symbol not understood, unless by its association with a particular article of merchandise.

§ 222. Many authors, judges, and lawyers have cited *Gout* v. *Aleploglu*,[1] to show that an ordinary word in a foreign language, meaning *warranted* or *approved*, may be a trade-mark. They err in so doing. This case, heard in 1833 in England, seems to have been as follows: The plaintiff, Gout, had long manufactured watches for the Turkish market. These watches had acquired great repute in Turkey, and were known by certain marks engraved thereon. These marks consisted of words in Turkish characters, viz., the name of the maker, and the name "*Pessendede*," which in the Turkish signifies *warranted* or *approved*. There were also other marks: "R. G." and a crescent put in relief, and a sprig and crescent. Now it would be folly to say that the word *Pessendede*, which had no use except in the market to which the watches were sent, and which was of no use elsewhere, could be exclusively appropriated. The word might with truth be used by many fair dealers for its legitimate purpose; and, being a common word expressing quality, no one could claim it to the exclusion of all others. We must look closer, and ascertain the facts.

[1] 6 Beav. 69.

§ 223. In 1831, the defendant applied to the plaintiff to manufacture watches to be consigned to Constantinople; but conceiving that he might thereby injure his agent there, the plaintiff refused to execute the order. Subsequently, the defendant got the Messrs. Parkinson to manufacture watches for him. On these were engraved, in Turkish characters, the words "*Ralph Yout*," and "*Pessendede*," on the same parts of the watches as the plaintiff used for that purpose. The defendant then sent them to Constantinople, and sold them, to the injury of the plaintiff's trade. We see that he simulated the name of the plaintiff, in addition to copying a word that had doubtless become associated with the article. It was a *part*-imitation of the plaintiff's lawful commercial sign. The initials R. G., the crescent in relief, and the sprig and crescent, were omitted by the pirate, but he took enough of the plaintiff's mark to enable him to accomplish his object, which was to divert another man's trade into his own channel. The Vice-Chancellor granted an injunction, restraining the defendant from sending, or permitting to go to Turkey, or to any other place, and from selling and disposing of any watches with the name of the plaintiff thereon in Turkish characters, or the word "*Pessendede*" in Turkish characters, or any watches in imitation of the plaintiff's watches; and also restraining Aleplogln and the Messrs. Parkinson from manufacturing or vending such watches. In non-legal language this means just this, and no more: The defendant must discontinue his piratical tricks. He has imposed upon the public, and by his fraudulent acts has damaged the plaintiff by a part-imitation of his commercial marks. He cannot escape by mere evasion. But the court did *not* decide that the Turkish word "Pessendede" was a trade-mark.

§ 224. In the Tribunal of Commerce of the Seine, in 1861 (*Aludie & Co.* v. *Proudhon & Co.*[1]), the plaintiffs showed that they made in a particular manner cigarette-paper, called by them "PAPIER DE RIZ." This paper they put into the market

[1] Annales de la Prop., tome vii. p. 95.

enclosed in an envelope of salmon-colored paper. They claimed the name as their trade-mark, the same having been duly deposited or registered as such, and brought suit for an infringement of the same. PER CUR: Even if the plaintiffs have not an exclusive property in the paper, they have at least the right to sell it by the title which they have duly deposited and employed to indicate to commerce the cigarette-paper of their manufacture. The defendants have sold a similar paper in a roll covered with the same colored paper, and bearing the name of "PAPIER CRÈME DE RIZ." Even if the use of salmon-colored paper is common as a wrapper for all kinds of products, its employment, joined to the indication CRÈME DE RIZ, reveals an intentional imitation, susceptible of creating confusion with the products of the plaintiffs. Judgment accordingly for the plaintiffs.

§ 225. **Numerals as Marks.** — Among all the dubious signs suggested for recognition as trade-marks, the most untrustworthy are mere numerals. If a man adopt 1, 2, 3, or 123, or any other combination of these common figures, how can he reasonably look for protection in the exclusive use of them? Let us apply a test. A. has adopted "123" as his arbitrary mark. To him it is meaningless, except as a symbol to affix to his goods. B. is charmed to see the success that A. has achieved in selling his merchandise bearing this mystic symbol. He begins the manufacture and sale of the same class of goods, but of an inferior quality. The figures have a reputation, because all the articles bearing them have up to this time been found to be superior in quality. Now the mind of the public has become confused, for a worthless article is discovered to be stamped with the same numerals. If the inmost recesses of *B.*'s heart were explored, lurking roguery would there be found; but his outward semblance, like that of his trashy merchandise, bears no evidence of fraud. He keeps his own counsel; and in a suit for infringement of A.'s mark, "123," he does not assist his adversary by any admissions.

He feigns astonishment that his right should be disputed. He asserts a perfect right to stamp his candy or other articles with the figures "123," for that is the number of his shop; or he means thereby to warrant 123 lozenges to the pound; or each bale contains 123 pounds; or a thousand other variations, plausible and non-combatable. These numerals may truthfully import a myriad things. Any one has the right to speak the truth: *ergo*, the numerals aforesaid cannot be exclusively appropriated. A. replies that, although ordinarily a mere numeral cannot become a valid mark of origin or ownership, and at common law would be disregarded, in this particular instance it would be perfectly valid for the reason that he had duly registered it, and thus had given constructive notice to the world of his exclusive appropriation. Inconsequential deduction! The registry act did not create trade-marks, nor did it pretend to. It only protects valid marks. If invalid at common law, the mark has not become otherwise by the fact of registration.[1] Even long user and notoriety will not cure the inherent lack of stamina. (*Quod ab initio non valet, tractu temporis non convalescit.*) Could one acquire an exclusive right to use the name "Smith" as his trade-mark by going through certain formalities in the Patent Office? No one with a thimbleful of brain would contend that he could. Anybody bearing that time-honored cognomen would have an equal right to employ his true name. So may anybody lawfully stamp his packages with any numerals that shall truthfully express the idea to be conveyed. But he could not so use numerals if another person in the same line of business had it as his mark for merchandise. We will now inquire, Whence arose this by no means uncommon error? A judicial decision not understood. Here it is.

§ 226. *Gillott* v. *Esterbrook*,[2] before a general term of the Supreme Court of New York, in 1867, has been relied on to support the doctrine that mere numerals constitute a lawful

[1] See sec. 79, Act of Congress, July 8, 1870. [2] 47 Barb. 455.

trade-mark. The facts in that case were substantially as follows: The plaintiff was a manufacturer of steel pens in Birmingham, England, ever since 1825, and for more than twenty years had an agency in the city of New York. He manufactured and sent to the United States steel pens of various descriptions; and among them, as early as the year 1839, was a flexible bronzed double-grooved, extra-fine-pointed slip pen, on which was impressed the arbitrarily-selected numeral "303," and the words "JOSEPH GILLOTT, Extra Fine." Said pen became deservedly popular, was in great demand, and the most prominent pen in the market, producing large sales at high prices. This pen became known to stationers and other dealers by its number, 303, which distinguished it from other pens of the plaintiff's make. Those figures did not express quality or size; and no other pen was then known to have numerals upon it. The defendant manufactured and sold a pen, which in size, shape, color, pattern, flexibility, and fineness of point, so closely resembled the plaintiff's pen, as to require an expert or adept to distinguish them in these respects. The defendant also impressed upon his pen in the same place as did the plaintiff his, the number 303, and the name of defendant's firm, "ESTERBROOK & Co.," and the same words, "EXTRA FINE." The pen was put up in boxes of the same size as the plaintiff's, with a similar fancy-paper label; and in other respects was cunningly adapted to mislead as to the origin of the pen.

§ 227. What should a court do under such a state of facts? Would it not have been a mockery of justice to dismiss the complaint? This is what was said by Leonard, J., in delivering the opinion of the court: "The design to defraud by manufacturing and packing pens in all respects similar to the plaintiff's, excepting only in the use of the name, appears very plainly. I cannot reason so artificially as to disguise this conclusion from myself." The judgment obtained by the plaintiff was affirmed by two judges. Ingraham, J., dissented.

He doubted the validity of the numbers as a trade-mark. He said that it was in evidence that in all the boxes of plaintiff's pens, sold during more than twenty years, had been placed a notice stating that "other makers had adopted the above number (303) by which the original Gillott's Victoria pen is known." He considered this long user by others as having deprived the plaintiff of exclusive right to said figures, his silence being an acquiesence, even if he could be considered as having a right to it. He further said that "there was error in holding that the plaintiff, by the use of this number, became entitled to the exclusive use thereof and to the profits thereof, and that he is entitled to an injunction restraining the defendants from the use thereof."

§ 228. What did this judgment decide? That the numerals 303, as used, constituted a trade-mark? Not at all. An examination of the whole case will help us to a clear solution. Judge Potter, at special term, regarded them as being merely a *part* of a mark. He said: "These symbols or figures do not, of themselves, indicate any appropriate name of the pen, nor any mode or process by which it is manufactured. They do not indicate the quality of the pen; but, connected as they are with the plaintiff's name, they indicate the origin or ownership of the pen, and were intended by him, with the addition of the words 'Extra Fine' impressed thereon, to designate the pattern of this pen as distinguished from other pens of his manufacture represented by other numerals, and also to distinguish it as the pen of his manufacture by those peculiar marks or devices. The marks last named, except, perhaps, the words 'Extra Fine,' seem to be within the rule that allows a device to become a trade-mark. . . . It is true that the imitation is but partial. . . . It is not necessary for the plaintiff, in order to receive the protection of the court, that he show that his whole trade-mark has been pirated or simulated. A false impression can as well be conveyed to the mind of the public, and especially to the memory, by a partial

as by a total counterfeit. The design to defraud may be as apparent, and is generally more injurious, in the partial than in the entire imitation." The learned judge evidently regarded the figures as but an ingredient of the compound trade-mark. It was upon that theory that the case was discussed throughout. The question before the court was practically this: Did the defendants by unlawful means usurp any portion of the plaintiff's trade? This question was answered in the affirmative. How was the unlawful act accomplished? By the imitation of the pen itself, the box containing it, the label that enclosed it, and other means, one of which was the simulation of a part of his mark. That was the nail that clinched the matter. That made manifest the intention. Why copy this number 303 unless it had already obtained a good report? The conclusion was irresistible: the defendants sold their merchandise as that of the plaintiff's manufacture.

§ 229. Suppose that mere numerals could possibly constitute a mark of commerce, why adopt so perplexing a symbol? The whole realm of the imagination is open for the selection of emblems, to the exclusive appropriation of any of which there can be no dubiousness. Under pretended simplicity of taste may lurk fraud and disguise. When offered for registration in the Patent Office, attention is invited to the precarious nature of the claim to such a thing. The Office does not hold itself bound to anticipate all the legal objections that may arise in such a matter, and sometimes has issued certificates at the risk of applicants. They argue that they have paid the legal fee, and have a right to some kind of a *primâ facie* title.[1]

§ 230. In *Boardman* v. *The Meriden Britannia Company*,[2] before the Supreme Court of Connecticut, in 1868, both parties seem to have regarded the use of numbers as giving rise to the most important and most material question in the cause. The petitioners relied upon them as the most prominent, valu-

[1] See *ex parte* Dawes and Fanning, Comm'rs' Decisions, Official Gazette, 1872, p. 27.

[2] 35 Conn. 402.

able, and distinctive feature in their trade-mark. The respondent claimed that, if in any case numbers can be legally appropriated as trade-marks, they were not so appropriated in this case; and that, so far as they tend to indicate ownership, it is only so by an association of ideas, and by giving to them a meaning which they were not originally designed to have. The court said: "If this be so, or if the numbers were used solely to indicate the different patterns, styles, or sizes, it is clear, from the view we have taken of the law, that the respondents ought not to be restrained from their use. Whether in any case numbers alone may be legitimately appropriated as trade-marks, is a question not necessarily involved in the case. It may be difficult to give to bare numbers the effect of indicating origin or ownership; and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, it may not be easy to assign a reason why they should not receive the same protection, as trade-marks, as any other symbol or device. But in this case the numbers were associated with the name of the petitioner, and the form, color, and general arrangement of the labels; and, by virtue of that connection, form an important part of the trade-mark itself." It appeared that the goods of the petitioner contained labels with his name and the numbers thereon; that under these labels and numbers the goods had become known in market, and had obtained a good reputation; that they were known by their respective numbers, and were generally ordered, bought, and sold by the numbers on the labels. The most prominent feature of the label, and the one most likely to attract attention, would be the number. So said the court.

§ 231. We see that this case does not solve the question whether a bare numeral can be turned into a trade-mark. The counsel for the respondent took the proper view, which is that a trade-mark conveys the idea of the maker. It is designed to represent the maker in such a way that the moment a man

looks at it he shall know who made the article. It is designed to designate the origin of the article on which it is placed. All the authorities agree upon this. But there is nothing either in the common paper box or in the labels used by the petitioners, except the name, "*L. Boardman*," to indicate the origin of the goods. Take the name from the label, and there is nothing left to indicate to any one who was the maker. There is much plausibility in the counsel's argument that the numbers were used to indicate the different patterns; that they had reference to the patterns, not to the manufacturer; and that the petitioner adopted the numbers 12, 20, &c., for the same purpose that any other maker does, — to indicate different classes of goods.

§ 232. As matter of history, we find that numerals have been used for this purpose; but they were not the plain figures that have but one purpose, — that is, mere numbers. Thus, in Worcester, in England, the early specimens of china-ware, which generally had the Chinese and Japanese marks, in imitation of the genuine, bore a series of numerals from 1 to 9. These were disguised by flourishes, doubtless well understood by the wholesale dealers, but which were meant to deceive the general purchaser into the belief that they were Chinese and Japanese characters.[1] So may anybody use the same numerals, provided he turn them into arbitrary symbols. They then cease to be mere numerals. If in any manner the numbers indicate the origin or ownership of the goods, it is by an association of ideas. Certain figures suggest a meaning to the mind which the figures do not in reality bear, and were not designed to convey. A man has no right to appropriate words or figures in common use for the purpose of indicating ownership, and if he do, or if by the association of figures with his name they serve that purpose, that circumstance cannot prevent another person from using the same figures to indicate the pattern or size of goods made by him.

[1] Marryat's Pottery and Porcelain. London, 1857.

§ 233. Conclusion: It is believed that no court, in any country, has ever solemnly decided that a naked numeral can constitute a trade-mark; and it is confidently believed that no court upon calm deliberation would so decide.

§ 234. **Letters as Marks.** — In one case, the applicant sought to have registered, as a trade-mark, the "letter D, encompassed by the figure of a lozenge." The Examiner rejected the application, on the ground that the proposed mark had no feature that indicates "origin or ownership." This action was based upon the decision of Allison, P. J., in *Ferguson* v. *Davol Mills*,[1] in which the mark consisted of the letter K within two concentric circles, &c. The object of rejecting the application was that the question might be considered by the chief officer of the Patent Office, and, so far as it is concerned, be definitively settled. The Commissioner held, *inter alia*, that the very fact of the mark bearing evidence of being the manufacturer's or dealer's private mark, by means of which his goods are distinguished in the market, is sufficient indication of origin to warn against copying by competing dealers, and this answers the public demand. He further said that the applicant's device is not a generic one: it is not indicative of quality. It does not consist of words or devices that others in the same trade would be likely to select for a similar purpose, and no valid reason could be seen against admitting it to registry.[2] On the authority of this decision, the soundness of which is indisputable, the letter S, within a circle, was held to be a valid trade-mark, although being the initial of the surname of the principal member of the firm applying for registration.[3]

§ 235. The application for the registration of the letters "A C A" seemed to come within the principle of the foregoing cases; and yet there was cause for hesitation, as the

[1] 2 Brewster, 314, and Leg. Int., Jan. 1, 1869.
[2] Dutcher Temple Co., Comm'rs' Decisions, 1871, p. 248.
[3] H. D. Smith & Co., No. 521.

simple letters were claimed without any enclosing line. The letters were used upon an elaborate label, substantially that described in the case of the *Amoskeag Manufacturing Co.* v. *Spear*.[1] The ruling of the eminent jurist, Mr. Justice Duer, in that controversy, did not assist the determination of the question whether those letters, without adjuncts, constituted a good trade-mark at common law. He had taken cognizance of the matter as a chancellor, under circumstances of fraudulent misrepresentations. He was not called upon to say, in so many words, that "A C A" could be a valid mark of trade. Those letters had been employed by the applicant for the same purpose — *i.e.*, as a mark for tickings and cotton fabrics — ever since the year 1836, a period of thirty-six years. The mark is well known to the trade, and is generally respected. A *primâ facie* right to its exclusive use having been made out, it was registered.[2]

§ 236. **Fancy Names.** — The Court of Cassation, in 1864, in *Clerton et al.* v. *Charpentier*,[3] held that the denomination given by a manufacturer to a product of his industry, unless such denomination became an element usual and necessary for the designation of the product, becomes a legitimate mode of signifying to the public his industrial product. This means should be protected, and as much in pharmacy as in other kinds of industries. Therefore, the fancy name of "PERLES D'ETHER," applied to a certain pharmaceutical product, not being a generic term is a legal trade-mark. It was apparent that this name could not be the true designation, for no sane person could think that pearls entered into the composition. It was purely fanciful. The Tribunal Corr. of the Seine, in 1865, in *Nestor Michel* v. *Stremier*,[4] held that a designation of fancy as "TRAPPESTINE," as applied to liquor, was good. The community of religious trappists of the *Abbey de la Grace-Dieu* made and sold a *liqueur* with the new name "TRAPPESTINE."

[1] 2 Sand. (S. C.) 599. [2] Amoskeag Manuf. Co., No. 713.
[3] Annales de la Prop., tome x. p. 340. [4] Ibid., tome xi. p. 284.

The Tribunal of Commerce of Rouen, in 1867, in *Levy* v. *Bizet*,[1] held the words "CRÈME D'ARGENT" (Cream of Silver), applied to a chemical product, to be valid. The Court of Paris, in 1859, in *Gourbeyre* v. *Bodevin*,[2] held the same of "POUDRE BRÉSILIENNE" (Brazilian Powder). The Tribunal Corr. of the Seine, in 1858, in *Guerineau* v. *Mignon*,[3] held that the words "CAFÉ DES GOURMETS" was a good mark for packages of roasted coffee.

§ 237. *Burnett* v. *Phalon*,[4] in the Court of Appeals of New York, in 1867, is a leading case upon the subject of fancy names. In 1857, the plaintiffs commenced the manufacture and sale of an article of hair-oil, compounded of various ingredients, of which the essential element was cocoa-nut oil. It was supposed by them to be a new article; and they alleged that they invented for it a new name, which was "COCOAINE;" and that as soon as they commenced the sale of the article, they gave notice through the newspapers, and by their circulars, that they had adopted that word as their trade-mark. Phalon, one of the defendants, had, ever since 1840, sold a similar preparation of cocoa-nut oil. In 1858, the defendants commenced the manufacture and sale of such preparation, under the name of "Cocoïne." The plaintiffs brought this action to restrain the defendants from using the word "Cocoïne" in the sale of their article, claiming that the use of that word was an infringement of the exclusive right of the plaintiffs to the use of the word "Cocoaine." They also claimed damages for the injuries which they alleged they had sustained. The action was tried at a special term of the Superior Court of the City of New York, in 1859, before Mr. Justice Pierrepont; and the plaintiffs had a judgment perpetually restraining the defendants from using the word "Cocoïne." The defendants thereupon appealed to the court *in banc*. The judgment was there affirmed.

[1] Annales de la Prop., tome xiv. p. 105.
[2] Ibid., tome v. p. 250.
[3] Ibid., tome iv. p. 157.
[4] 3 Keyes, 594. Same case below in 9 Bos. 192 and 5 Abb. Pr. R. (n.s.) 212.

§ 238. Bosworth, Ch. J., in delivering the opinion of the court, said *inter alia* : "The defendants, according to their own testimony, had been selling, since 1840, substantially the same article, as they, in 1858, denominated 'Cocoïne;' and had been selling it as 'a preparation of cocoa-nut oil.' Why, after transacting this item of their business for some eighteen years, do they resort to the means employed in 1858 to bring it before the public under the designation of 'Cocoïne?' The answer is found in the reputation and extensive and largely increasing sales of Cocoaine. . . . 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. But no plausible or rational explanation, except an intent to defraud, could be given of a transaction so bold as that would be. . . . Burnett, by great outlay and effort, had succeeded in creating an extensive demand for his own manufacture, known as 'Cocoaine.' The defendants, in 1858, with the intent and for the purpose stated in the fifth finding of facts, impressed on the bottles and labels containing and covering their compound, the close imitation, 'Cocoïne.' . . . I think the judgment should be affirmed." Robertson, J., dissented, and entered upon a philological disquisition as to the meaning of the word 'Cocoïne.' He deduced it from the French adjective *cocoiné*. The accent upon the final letter renders the word different from that of the defendants, to say nothing of the diæresis; but still he held that the word is a proper term in chemistry, and would mean the finest part of the cocoa-nut oil; and that after such name had become public property as the true designation of the article, the plaintiffs could not rely upon a word so near it as "Cocoaine" to protect themselves against the danger of confusion of two articles. His argument is not convincing. The case then travelled to the court of last resort.

§ 239. In the Court of Appeals, Davies, Ch. J., in delivering the opinion of the court, in which all the judges concurred, said: "Upon the facts found by the court, the right of the

plaintiffs to the relief granted is clear and indisputable. The plaintiffs have adopted, appropriated, and used a certain trade-mark. This has become their property, and, for its protection from invasion or use by others, the plaintiffs are entitled to invoke the aid of courts of justice. We have the ascertained facts before us, that the defendants are using a spurious and unlawful imitation of the plaintiffs' trade-mark." The judgment was affirmed with costs.

§ 240. It requires nice discrimination to determine what falls within the category of fancy names. When a new preparation or compound is offered for sale, a distinctive and specific name must necessarily be given to it; and that name, no matter when or by whom imposed, becomes by use its proper appellation, and passes as such into our common language. Hence, all who have an equal right to make and sell the article have an equal right to designate and sell it by its proper name, the name by which alone it is distinguished and known, provided each person is careful to sell the article as prepared or made by himself, and not by another. When this caution is used, there is no deception of which a rival manufacturer, not even he by whom the distinctive name was first invented or adopted, can justly complain. So far from there being any imposition upon the public thereby, it is the use of the distinctive name that gives to purchasers the very information which they are entitled to have. In short, an exclusive right to use on a label the appropriate name of a manufactured article exists only in him who has an exclusive property in the article itself.

§ 241. In *Fetridge* v. *Wells*,[1] Duer, J., admitted that the name "Balm of Thousand Flowers" is in one sense a fancy name, but not in the sense for which the plaintiffs' counsel contended. It was not pretended that the plaintiffs or their firm had any exclusive property in the compound bearing the well-sounding name, which was used to convey to the minds

[1] 4 Abb. Pr. R. 144, and 13 How. Pr. R. 385.

of purchasers the assurance that the highly-scented liquid was in truth an extract or distillation from flowers, which was not true. He said that it was only the seductive name that they claim as their exclusive property, and doubtless from their experience of its value in the extension of their sales.

§ 242. What decided that it was not a fancy name? The judge's reasoning upon this point is convincing and indisputable. It was not a mere denomination of fancy, because it involved the idea of fraud. Around every bottle sold by the plaintiffs was a printed paper, ascribing manifold and almost miraculous virtues to the "Balm of Thousand Flowers." It said: "It is an innocent, safe, and efficacious compound, of purely vegetable, medicinal, and powerful substances, and *the very balm and extract of healing blossoms.*" These words, said the judge, "put an end to the refuge of a fancy name as an escape from the charge of an intention to deceive. . . . It appears, then, that this pretended balm is produced by a mixture, in certain fixed proportions, of palm-oil, ley or potashes, alcohol, and sugar; and that when this mixture has, by the operation of fire, been fully compounded and prepared, it is rendered fragrant, doubtless to favor the deceit of its name, by the addition of some strong perfume, such as lemon or bergamot, lavender or musk. The result is, that this 'Balm of Thousand Flowers' extracted from blossoms, redolent of health, is a soap — a liquid soap — highly scented it is true, and, it may be, as a soap, useful and valuable, but still a soap, possessing the usual and known qualities of soap, and nothing more. . . . The proof is therefore complete that the name was given, and is used, to deceive the public; to attract and impose upon purchasers; that in the sense that the plaintiffs mean it shall convey, it is a representation to the public that they find to be useful, and know to be false." Another action had grown out of the same state of facts which gave rise to the case of *Fetridge* v. *Wells*. The two cases should be read together. The other case, which was also in the Superior Court of the City

of New York, was, like the preceding, on a motion to dissolve a preliminary injunction granted by Mr. Justice Hoffman.[1] The latter differed materially with his associate judge. He 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 public credulity as he can in this designation. On the other side, it is well settled that when the deception consists in palming upon the public articles of the party's own manufacture or composition for those of another who has obtained celebrity or notoriety, the court will remain inactive."

§ 243. He very truthfully remarked, as a general principle, that the further removed an appellation is from actually representing the article in question, the more exclusive and decided becomes the right to it; and he cited the case of the "Medicated Mexican Balm,"[2] which had nothing in its composition peculiar to the land of Montezuma; and the case of "Chinese Liniment,"[3] which was in all its ingredients a stranger to the Celestial Empire. It seemed to him, that the term "Balm of Thousand Flowers" was of the same character. The article is a soap, or perfumed liquid soap. That name would be the name of the article, because it would indicate its nature. The term was, in his opinion, extrinsic and not indicative.

§ 244. The foregoing cases of *Fetridge* v. *Wells* and *Fetridge* v. *Merchant* have shown how under a similar state of facts two judges of the same court, and both men of high integrity, and of acknowledged ability as jurists, may differ in legal conclusions.

[1] Fetridge *v.* Merchant, 4 Abb. Pr. R. 156.
[2] 6 Beav. 66. [3] 4 McLean, 516.

§ 245. When A. introduces into the market an article which, although previously known to exist, is new as an article of commerce, and has acquired a reputation therefrom in the market by a name not merely descriptive of the article, B. will not be permitted to sell a similar article under the same name; and this, although the peculiarity of the name has long been in common use as applied to goods of a different kind.[1] Plaintiffs, soap manufacturers in London, introduced into the market a superior kind of white soft soap, which they sold under the name of "The Excelsior White Soft Soap." Vice-Chancellor Wood said, *inter alia*: "But though it is true that the court will not, if it can avoid it, be made the medium of a mere puffing advertisement; still, if, as here, the plaintiffs have a right of sufficient value to induce others to attempt a fraudulent violation of it, the court will intervene to prevent them from being cheated. . . . The defendants urge that 'Excelsior' is merely a mark of quality, like 'Superfine,' or 'Superior;' but there seems to me to be a double answer for this. In the first place, the plaintiffs do not sell two or three qualities of soap, calling one of them 'Excelsior,' and the others by some other name; but they have only one quality, which they denominate 'The Excelsior White Soft Soap,' and there is nothing except itself with which to compare it. But, in the second place, the manner in which, as has been proved, this name is generally used in the market, shows that it is more like such names as 'Victoria,' 'Albert,' 'Eureka,' &c., which are not names of quality, but simply designations for sake of distinction." Injunction granted.

§ 246. The combination of words, "MRS. MARPLE'S SALVE," is not in itself sufficient to warrant recognition, being merely descriptive of an article that any one might make and vend, unless it be protected by a patent. It was claimed by the daughter and successor of the inventor, and even in her hands the Office declined to admit it to registration. When, by an

[1] Braham *v.* Bustard, 1 Hem. & M. 447; 11 W. R. 1061; 9 L. T. (N.S.) 199.

amendment, it was enclosed in a cruciform figure, in each external re-entering angle of which appears the representation of a hand, with the index-finger pointing to the name, all objection was instantly removed.[1]

§ 247. "WILLOW SPRING ICE" could not be deemed a valid trade-mark, unless there were but one Willow Spring, and the applicant had the sole title thereto;[2] for there may be several places bearing the same name, and many persons entitled to take ice from them for the purpose of sale. Yet the applicants made a point of having the words placed upon a trade-mark. This was readily done by making a representation of a pair of ice-tongs grasping a cake of ice, upon which appears the names of the firm, and the words "Willow Spring Ice." It was suggested that another firm in the same place had gone into earnest competition with the claimants for the exclusive use of the name and a consequent monopoly. The mark as amended was registered.[3]

§ 248. The simple designation, "THOMPSON PURE RYE WHISKEY," would be just as objectionable; but when the mark is an exact representation of the handwriting of a proprietor, it becomes distinctive, and could not be imitated by another in the same trade without the clearest proof of a fraudulent intent. It is then an arbitrary symbol.[4]

§ 249. We know that the word *Damascus*, as applied to steel, implies a fine quality of steel originally made at Damascus, the ancient capital of Cœlesyria, and formerly much valued for sword-blades, from its great flexibility and tenacity: but the application of the words "DAMASCUS BLADE" to scythes made in the United States could not possibly convey any false idea of origin, nor could they be considered to be descriptive.[5]

§ 250. As a peculiar mark, one indicating origin and at the same time suggesting the character of the goods, the following

[1] Mary A. Paullin, No. 857.
[2] See Cong. & Empire Spring Co. case, 57 Barb. 526.
[3] Swett & Crouch, No. 798.
[4] Charles S. Ross & Co., No. 339. [5] Dunn Edge Tool Co., No. 563.

was proposed as a mark for fish: The representation of two fishes crossed in the form of the letter X. Any one seeing this sign could not fail to understand that the tin case hermetically sealed contained fish; for the label would tell the story without words. The Examiner rejected the proposed mark as purely descriptive. On appeal, it was allowed, the Commissioner regarding the emblem as being virtually the letter X made more complex by being constituted of two fishes.[1] An analogous case is that of the words "HUGHES AND KIMBER LITHOMACHINE." The applicant showed that he was the sole agent in this country of certain machines made in England for lithographic printing. The objection was that the firm name could not be an essential element of a trade-mark, and *Lithomachine* is generic. The application was amended, an arrow being placed back of the words, running the entire length of the line of letters, and connecting them into a single symbol. It was then registered.[2]

§ 251. Probably the most troublesome question that has arisen in connection with the right to registration was that of the words "CHEMICAL PAINT." These words form the main, special, and prominent feature of the mark claimed, the object of which is to produce a distinctive name by which to designate a specific kind of paint, known as the "Averill Chemical Paints," as distinguished from paints prepared in the ordinary mode. The paints manufactured and introduced under this name are produced, in the process of manufacture, by bringing together a part of all the materials in the form of solutions, which act upon each other chemically by interchange of bases and acids, in the manner well understood by chemists. Are not these words purely descriptive? Is not *chemical paint* a generic term? Can such words indicate origin and ownership, or either? The applicant based the claim to a right to an exclusive use of those words upon the fact of being owner of certain patents for making the compound

[1] J. H. Doxsee, No. 853.

[2] V. E. Mauger, No. 886.

designated. It was asserted that chemical paints had never been known to the arts or to trade, until invented by the person from whom the applicant deduced title. The sole right of making chemical paint, as distinguished from all mechanically-mixed oleaginous paints, was shown to be vested in the applicant. If the applicant had the sole right to manufacture the article, why not accord to it (an incorporated company) the sole right to use that name as a trade-mark? Could any one else truthfully employ that designation? The right of the applicant to recognition seemed manifest, unless one point upset all claim. The patents must expire at the end of a certain number of years. The invention would then become public property; and all persons might then manufacture and sell the article called chemical paint. The term would then be generic; and a generic term cannot be a valid trade-mark. But in the use of the word *generic* we must take one thing into consideration. As employed in the discussion of trade-mark law, it means something more than *very comprehensive*. When we speak of a genus, we employ the term as distinct from species; and the idea is conveyed that the articles of the genus are indefinite, and the claim to exclusive right in them quite as indefinite. At the expiration of the life of the patents, all persons may make and sell chemical paints, and the term *chemical paint* may come to mean all paints made by the patentee's process, or by any other mode. The term "chemical paint" is *now* specific, meaning no paint except that manufactured by the applicant. The application was therefore allowed and the words registered as a trade-mark.[1]

§ 252. **A Fancy Name may become Generic.** — The Court of Paris, on appeal, in *Cohen & Co.* v. *Maris* and the widow *Robert*, in 1863,[2] considered this proposition. It appeared, in the court below, that petroleum is daily sold in England and in France under the name "LUCILENE." The court held

[1] Averill Chemical Paint Co., No. 130.

[2] Annales de la Prop., tome x. p. 105.

that the said denomination had fallen into the public domain, and that the defendants could sell petroleum without committing an unlawful act; and that said name could not be considered a trade-mark applied to a new fabric, being merely the true denomination of a natural product, which any one has the right to sell. The plaintiff had established the fact that he was the first who had employed the name, which was to designate mineral oil purified by him. The appellate court affirmed the judgment against the plaintiffs, adopting the views of the lower tribunal, but based its decision somewhat on the ground that the term had become attached to the article before the plaintiffs had taken steps to secure their exclusive title thereto. It was said that the sale of petroleum belongs to commerce in general, under the various names it has conventionally received. This case seems to teach that as the originators of the name, so applied, had in effect abandoned it to the public, they could not subsequently by any formal acts recover the right to its exclusive use.

§ 253. **Name of Natural Object.** — In *Denis & Mounier* v. *Vignier, Dodart, & Co.*,[1] which came before the Court of Bourdeaux in 1865, on appeal, we find an interesting decision. The plaintiffs had duly registered, as a distinctive mark for the brandies which they sold in bottles, the following: A grape-leaf, in the middle of which was printed or stamped these words, — "G. Denis. H. Mounier et Ce. Cognac, *Eau-de-vie vielle*," or "*Eau-de-vie très-vielle*," or else "*Old Brandy*." The label containing the mark was lithographed in divers colors, but particularly with a ground of gold or silver, with the inscription in white letters. The defendants marked their bottled brandies with a grape-leaf in gold or silver, on which their names were inscribed in white letters, "Very Old Brandy," and certain ornamentation. The case was well argued before a highly-intelligent tribunal, versed in the consideration of questions of a commercial character, and this

[1] Annales de la Prop., tome xii. p. 430.

undoubtedly-sound judgment was the result. PER CUR.: Property in marks and labels of commerce, guaranteed by law and jurisprudence, upon the fulfilment of determined conditions, should always be restricted to the speciality of the deposited mark; thus, if it consist in a generic object of which the common type is furnished by nature, or by the work of man, that cannot interdict other merchants from employing the same for things of the same genus, provided there exist differences in form, details, or ornamentation. All that is necessary for the preservation of all legitimate rights is, that the differences shall be sufficiently striking to the least attentive eye that confusion, and consequent prejudice, be rendered impossible. An interdiction more ample, especially when acting upon marks signifying the nature of the product, would transcend the object of the law, and trammel all the interests of commerce. The mark of the plaintiffs consists of a simple leaf of a grape-vine, either in gold, silver, or color, and in which is inscribed the nature of the product, and the name of the commercial house. The mark used by the defendants consists also of a leaf of a grape-vine, which, if not a complete copy of the plaintiffs', at least has a strong resemblance to it; yet it has differences, with different names inscribed thereon, and additional ornamentation; and by its size, details, color, signification, forcibly attracts the eyes, and affords no possibility of mistake. Therefore, the use of the grape-leaf by Vignier & Co., under such conditions, cannot work a prejudice to the plaintiffs; and thus their action is unfounded.

§ 254. The foundation of this decision is in the fact that the grape-leaf was in its nature too indefinite and uncertain. One leaf might easily be mistaken for another, for the outlines of leaves of plants of a quite different species, or even genus, bear some resemblance to each other. In addition, the leaf, if recognized as a grape-leaf, was descriptive of the product, or at least suggestive. If in this instance it had been enclosed in a geometrical figure, it would not have been an ordinary

imitation of a common object in nature. When representations of plants and flowers were employed in heraldry, they were placed on shields, seals, or flags. We could not well misunderstand the purpose of the rose, the lily, the thistle, or the shamrock, when displayed on armorial bearings, or banners and flags. Such objects, so placed, speak an unmistakable language. They mark, distinguish, identify. We know the knight in armor by the mark upon his shield, although his face is concealed. Is not this the very purpose of a mark of commerce? We observe a clearly-defined object stamped, printed, painted, or impressed upon an article of merchandise. We have before this time purchased an article with that exact symbol upon it, and found it suited to our taste, at least, if not of unequalled excellence. But unless the symbol be recognized as, or mistaken for, that which we obtained before, we are in doubt. When there is reasonable ground for doubt, the mark has failed to accomplish its purpose, and is void for uncertainty. Suppose that on the day of a battle or a joust a mediæval knight had met an exact counterpart of himself. Each must have had distinct insignia, so that when he closed his vizor he could have been distinguished in the fray. The marks on goods, in the strife for pre-eminence, must be as recognizable as the device upon the knightly shield. Broom-corn is not a peculiarly-striking object, and the representation of a sprig of it would not attract much attention unless found upon heraldic equipments; but then we would recognize in it the *Planta-genista* which gave their name to the Plantagenets. It had been adopted for a specific, well-understood purpose. So was the *fleur-de-lis*, and so were an infinite number of other natural objects, which by their figurative imagery concentrated a wide range of thought within the narrow compass of an escutcheon.

§ 255. **A Picture** as a trade-mark. Can such be? Some judges have said to the contrary. We are left in doubt, until a full examination shall have elucidated the matter. A pass-

ing remark, or a careless syllabus, may mislead. We will be cautious. An elaborate picture, made up of many different objects in nature and art, is, to say the least, a very uncertain indication of exclusive proprietorship. Another picture may be composed of objects of quite a different nature, dissimilar in all the *minutiæ*, yet having the same general groupings, lights and shades, and general effect. There is a possibility of such a representation becoming so well-known as to be a veritable mark for merchandise; but that possibility is remote. In the case of *Falkinburg* v. *Lucy*,[1] in the Supreme Court of California, in 1868, it was doubted whether a picture could be made such mark. The plaintiffs' label has "a highly-colored picture, representing a washing-room, with tubs, baskets, clothes-lines, &c. There are two tubs painted yellow, at each of which stands a female of remarkably-muscular development, with arms uncovered, and clad in a red dress which is tucked up at the sides, exposing to view a red petticoat with three black stripes running around it near the lower extremity. Each is apparently actively engaged in washing; and clouds of steam are gracefully rolling up from the tubs, and dispersing along the ceiling. In the background is extended across the room a clothes-line, upon which are suspended stockings and other under-garments, which have evidently just been put to use in testing the cleansing properties of the plaintiffs' washing-powder. To the left of the washerwoman stands a lady in a yellow bonnet, red dress, green congress gaiters, and hoops of ample circumference: upon her left arm is suspended a yellow basket, and in her left hand is held a red parasol; while the other hand, which is encased in a green glove, is gracefully extended toward the nearest washerwoman in an attitude of earnest entreaty. In the immediate foreground is a yellow-and-green clothes-basket full of dirty linen, and a yellow-and-green soap packing-box, upon which are printed, in small capitals, the words 'Standard Co.'s Soap.' Each wash-tub is supported by

[1] 35 Cal. 52.

a four-legged stool, — some of the legs being yellow, some red, some green, and some all three. The floor of the room, as to color, is in part of a yellowish green, and in part of a greenish red, while the walls are of a grayish blue. This is but an imperfect description of the picture with which the plaintiffs' label is adorned. The design is good, for it is eminently suggestive of the character of the plaintiffs' goods."

§ 256. So said Sanderson, J., in delivering the opinion of the court. Yet it was only for the sake of argument that he conceded that it could be a trade-mark at common law. In support of his doubt, the judge cited *Partridge* v. *Menck*,[1] in which case both labels were embellished with wood-cuts of a bee-hive, yet the preliminary injunction was dissolved. When we examine for ourselves, we find that the plaintiff in that instance failed because his label contained upon its face a misrepresentation of fact. He claimed the exclusive right to impose upon the public friction-matches made by himself, as if made by A. Golsh. He had not come into court with clean hands. The judge also cited the *Merrimack Manufacturing Co.* v. *Garner*.[2] Attached to the complaint in this case were specimens of the tickets of both parties. They were of nearly the same size, each being about six inches long by four wide, and in the shape of a parallelogram scolloped at the corners. Both were printed on straw-colored paper, of almost precisely the same shade. Each had a border line with corner ornaments, an oval wreath of flowers within the border, and an inscription within the oval wreath. The border lines were almost precisely the same. The corner ornaments differed considerably. In the plaintiff's label there were light lines whose tendrils extended beyond each side of the parallelogram toward the opposite corner, with considerable space between. The defendant's corner ornaments were different, being much heavier, and the arms of each extended and met those of its neighbor in the opposite corner, so

[1] 2 Sand. Ch. R. 622.; 2 Barb. Ch. R. 101; and 1 How. App. Cases, 558.

[2] 2 Abb. Pr. R. 318, and 4 E. D. Smith, 387.

that the four together formed a continuous border around the label. The design of the oval wreath of flowers — which was the most conspicuous ornament in the plaintiff's label — was almost precisely the same in both tickets, but it was much more nicely executed in the plaintiff's label than in the defendant's. At the foot of each wreath was a blank space, left for the insertion of the number of yards in the piece. This number, in the plaintiff's label, was printed: in the defendant's it was written with a pen. The inscription in the plaintiff's label consisted of two lines curving with the sides of the wreath, and a sort of ornamental scroll between them. The upper lines contained the words "MERRIMACK PRINTS," the lower line the words "FAST COLORS,* LOWELL, MASS." The inscription in the defendant's label consisted of three lines, the upper and lower of which were curved like the lines in the plaintiff's inscription, and the middle one occupied the place of the scroll used by the plaintiff. The words were: "ENGLISH FREE TRADE. MERRIMACK STYLE. WARRANTED FAST COLORS." All the judges regarded the pictorial part of the label as of little consequence, basing their decisions upon the use of the words.

§ 257. In *Spottiswoode* v. *Clarke*,[1] an English case, the Lord Chancellor dissolved an injunction which the Vice-Chancellor had granted, with liberty to the plaintiff to bring an action at law, where the plaintiff was the owner of a publication called "The Pictorial Almanac," and the defendant of one called "Old Moore Family Pictorial Almanac," although the corners of each book were somewhat similar; both being decorated with a pictorial representation of the Observatory at Greenwich, and in the title, as printed on the cover, making use of nearly the same expressions. But that case does not throw much light upon this point.

§ 258. Here comes a French case that may help us. In the Court of Riom, in 1852 (*Bru* v. *Larband*[2]), it appeared that the plaintiff, a pharmacist of Vichy, had adopted as his mark

[1] 10 Jur. 1043.

[2] Journal du Palais, 1855, p. 244.

for his pharmaceutical product (a mineral salt of Vichy) a printed representation of the thermal establishment there situated. The defendant having imitated the said mark, the plaintiff sued. The court said that it mattered not that the vignette used by the plaintiff represented a public establishment belonging to the State, and one that before then had been used on scientific publications; and that it is allowable for any person to take and use such picture as his designation of commerce, provided he is the first to appropriate it to a particular class of goods. — This decision, it must be confessed, goes to an extreme length. But it is sufficient to show that a mere picture may be a trade-mark.

§ 259. A picture made up of many objects in various colors, may be a trade-mark. The Patent Office has, almost daily, passed upon the question. It is not, of course, every picture that will be registered; for many that have been presented have been refused, because either merely descriptive of the class of goods to which they were intended to be affixed, or not adapted to the purpose. The first trade-mark registered under the Act of 1870 was that of the Averill Chemical Paint Company. This consists of an elaborate pictorial representation. In the foreground is a rock with the word "CHEMISTRY" upon it; on the rock is an eagle, holding in his beak a paint-pot or canister and brush, and a ribbon or streamer on which are the words, "Economical, Beautiful, Durable." There is water, and upon it are a steamer and other vessels. In the background is a bridge, and a train of railway cars, besides houses of various kinds. Who could mistake such a picture for a mere specimen of artistical taste? It speaks plainly. It says, "I am a trade-mark." This very picture was soon afterwards imitated in its general effect, and the imitation presented for registration by one in the same line of business. Accident could not possibly have made the two marks so much alike. Both, at the distance of a few feet, would make the same impression upon the eye; and any but the most cautious purchaser

might take one for the other; but, upon close inspection, it appeared quite a different thing. The simulation was too evident. The second case was accordingly rejected.

§ 260. Trade-marks not unfrequently are borrowed from the mediæval heraldry of Europe, rich in a symbolical language, in which figures, devices, and colors were employed instead of letters. Caution must be observed in appropriating time-honored heraldic compositions, for each of such has its own definite and complete signification, conveyed through its direct connection with some particular individual, family, dignity, or office, and held by express right and title. As a mark of commerce should be good for the purpose all over the world, it would be well for him who purposes to adopt the crest of some ancient family to designate his wares to inquire whether a foreign court might not set it aside.

§ 261. In the Tribunal Civ. of the Seine, in 1870, in the case of *Christy* v. *Dande*,[1] the following was *held:* Although the national arms are not susceptible of private appropriation, they can concur with other distinctive signs (for example, the name of the merchant) to constitute an industrial mark. The trade-mark claimed by the plaintiff consisted of the arms of England, with a circular inscription on the ribbon of the garter, and the words "CHRISTY'S LONDON." The defendant, for the same class of merchandise as that sold by the plaintiff, took the same design of the arms, but on the ribbon substituted for "Christy's London" the words "QUALITY SUPERFINE LONDON." This was held to be an infringement.

§ 262. Monograms and ciphers have been used as proprietary marks for many centuries, especially by painters and engravers. Many great masters seldom or never signed their works in any other way. Michael Angelo and Raffaelle were examples. Although in a painting such a designation is no certain sign of authenticity, — for every master has his imitators, — in an engraving of old times it is generally trustworthy.

[1] Le Technologiste, No. 365, p. 286. 1870.

Some of them employed singular or fanciful marks, as birds, animals, houses, usually having some reference or allusion to the name of the artist. Thus Jerome Cock marked his plates with two cocks fighting; H. C. Bles, with an owl on a branch, or in a cage; Hans Adam, with a naked figure under a tree, with his initials; Hans Schaufflin, with a small shovel, or two shovels crossed, with his initials,—his name signifying in German, *small shovel;* Martin, with a little bird of that name; Leech, with a bottle containing a leech.[1]

§ 263. **Is Color ever an Essential Element** of a trade-mark? Yes. It may serve as the groundwork of a mark, or the mark may at the pleasure of its owner be made in any color, or in all colors. Nearly always in practice the mark is in black, which is not a color, except in heraldry. One trader may adopt a red cross as his symbol, and another may choose a black cross to designate the same class of goods. A large proportion of the marks of manufactures and commerce are borrowed from heraldry. Among the earliest shields and banners, all of them remarkable for simplicity, many are found to be without any device whatever, their distinction consisting in some peculiarity of coloring. The renowned banner of the Knights Templars, by them called *Beauseant*, is black above and white below, to denote that while fierce to their foes, they were gracious to their friends. In English heraldry five colors were used, — blue, red, black, green, purple.[2] When so used, one could not well be mistaken for the other; but that cannot always be said of small labels bearing the symbols of trade. The emblem of the *Blue* Bear might easily be confounded with that of the *Black* Bear. The impression left upon the retina of the eye is of an animal of a certain kind and physical conformation. If, by simply changing the hue, one man could take the same sign as a rival in trade, there would not be much safety. The sign which was originally

[1] Spooner's Dictionary of the Fine Arts.
[2] Boutell's English Heraldry, p. 13.

black, might, by exposure to the atmosphere, become blue or gray; and a blue might darken into a black.

§ 264. The disadvantages of a reliance upon color alone are so apparent, that preference is usually given to the device that is its vehicle. Black and white, which are accidental to each other, are not confounded. Red and blue in juxtaposition borrow from each other, and assume a purple hue when seen at some distance. Colors may be arranged so as to neutralize each other. The *death* of a color takes place when the primary colors come together in equal proportions. Two persons may not see the same colors alike. To give an eye for color is no more possible than to give an ear for sound. The defective vision called "color-blindness" confounds a color with its accidental one. It is said that, in England, one man in every seven hundred and fifty is unable to distinguish a certain color from another, as red from green. To some the soldier's red coat and the grass of a field are alike.[1] This is probably as true of our own country as any other. We have doubtless all known of such cases.

§ 265. Yet color may be of the essence of a mark of manufacture or commerce, known as a trade-mark. National flags are sometimes blended with other objects to catch the eye. They are admirably adapted to all purposes of heraldic display; and their rich glowing colors appeal to feelings of patriotism, and win purchasers of the merchandise to which they are affixed, albeit the while the wily vendor may laugh in his sleeve. One flag printed in green may catch the eye of the son of the Emerald Isle, who would turn with indifference from a flag of the same size and shape printed in red; another flag, with stars on a blue field and stripes of alternate red and white, may secure a preference for the commodity upon which it is stamped.

§ 266. A particular color may be made an essential feature of a mark, at the option of its adoptor; but it is taken subject

[1] Wilkinson on Color and Taste. London, 1858.

to some risks. If one select a red cross as his symbol, he is concluded by his choice, and cannot complain if another in the same line of business adopt the blue cross. It must be definite and certain. Caution should be observed in selecting an arbitrary color, which would conclude by its own limitation. For this reason, the delineation of the emblem is relied upon rather than the chromatic effect. A rose is a rose; for on a label stamped with fugitive colors the *red* rose of Lancaster might soon turn into the *white* rose of York.

§ 267. Color is frequently an important circumstance in determining the question of infringement. The fact that one trader has exactly imitated the tints of another's label may be conclusive, when there would otherwise be doubt. In practice, we find that such is ofttimes the case. The technical mark may be but partly simulated, and seem to be but an accidental coincidence. Then the use of the same colors in the same manner will advance and tell a tale of guilt. Look at a United States bank-note, printed mainly in one color, — that which has given it the name of "greenback." We may regard the red seal printed on the face of the note as one of the trade-marks of our Government. Suppose that an action were brought for an infringement. The general features of the print may be identical, so far as mere design is concerned. But the seal is printed in green, the back in red, and that which is black in the genuine in blue. Who could pronounce the copy of the figured lines a counterfeit? If not calculated to deceive, it would not be such.

§ 268. In the Court of Paris, in 1861 (*Ricque et als.* v. *Forges et al.*[1]), the question of color came up. To distinguish their manufacture from that of others, the plaintiffs had adopted, for the drillings made by them, a bordering composed of *four rose-colored* threads at the end of each piece. The defendants adopted as their mark for the same class of goods a bordering composed of *two red* threads. For this supposed infringement

[1] Annales de la Prop., tome viii. p. 25.

suit was brought. The court said that the *red* mark had an almost complete similarity with the *rose-colored* mark, — a similarity which was augmented or diminished according to the color of the texture; but the similarity was sufficient, when the textures of the two parties were not brought close together, to deceive consumers, and lead them into error as to the origin of the products: that the choice of a mark which, according to the disposition of the threads and the color of the tissue, can approach or remove in aspect from that of the plaintiffs', constitutes on the part of the defendants a precaution which reveals a fraudulent intention, especially as they did not make choice of a *red* thread until the success of the plaintiffs' drillings had become well established.

§ 269. **Form.** — The very term *mark* implies form rather than color. That form may be a geometrical figure, or the representation of an object having a fixed, definite shape, and susceptible of description. Thus, a circle, a square, a triangle; or an arrow, or anchor, or monogram; or an infinite variety of objects in nature or art, may easily be described and readily apprehended. But who could either impart or receive a precise idea of a tree, a cloud, or even a human being? A trade-mark must be something that impresses its peculiarity of configuration upon the memory, just as it is impressed, or otherwise affixed, to goods. We can describe and recognize a Maltese cross, a diamond within a circle, or a five-pointed star, or a flag with a certain number of stripes and stars, or other delineated things; but it is hardly within the range of possibility to convey an adequate idea of any thing that has no fixed, invariable limits.

§ 270. This seems like the veriest enunciation of truisms. Why waste ink and paper in such incontrovertible statements! Reserve your censure, kind reader, until you shall have read the matter following. All sorts of visionary notions are uttered in this world of ours. Even men of sense sometimes let their wits go wool-gathering.

§ 271. The applicant for registration of a supposed trade-mark for indelible ink thus described his mark: "My trade-mark consists of a bright, yellow-covered wrapper enveloping the metallic case holding the bottle of indelible ink, and forming the ground upon which is pasted or glued a bright red label upon which is inscribed the words, 'Payson's Indelible Ink, for marking Linen, Silk, and Cotton with a Common Pen without a Preparation. Price 37½ cts.'" Below this label, and upon the wrapper-paper, is a caution against spurious and worthless imitations, with the fac-simile of the 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 replied that there was but a single element of a trade-mark in the case, and that that was the fac-simile 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, to gradually throttle trade. No one would dare to send out his wares in red or in yellow papers, lest the vengeance of a prior adoptor 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.[1] "CASHMERE BOUQUET," for toilet-soap, do not convey any false suggestion of origin or quality.[2] Nor does "DIAMOND," coupled with *soap*.[3] "SAMSON BRACE," for suspenders, cannot imply any thing more than strength of material and make.[4] "DEER TONGUE," for tobacco, is clear enough.[5] So is "ROYAL BATSWING," for ladies' corsets.[6] "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.[7] 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.[8] We are not deceived into thinking that there is any "GOLD DUST" in the whiskey that bears that name;[9] or that an illuminating-oil is verily "MINERAL SPERM OIL;"[10] or that pills are really "EVERLASTING."[11] Nothing but a sheer lack of charity would literally construe "ANNIHILATOR," as applied to a medicine;[12] and when

[1] Gaullieur & André, No. 927.
[2] Colgate & Co., No. 914.
[3] J. Buchan & Co., No. 924.
[4] Fisk, Clark, & Flagg, No. 744.
[5] L. L. Armistead, No. 512.
[6] Thomson, Langdon, & Co., No. 540.
[7] E. J. Williamson, No. 401.
[8] Landsberger & Co., No. 814.
[9] Barkhouse Brothers & Co., No. 626.
[10] R. S. Merrill & Co., No. 557.
[11] Dunn & Co., No. 448.
[12] N. Jenkins, No. 746.

considering the case of *Davis* v. *Kendall*,[1] we would deem the question as to its right of existence to be judicially-settled, and pass as good the words, "PAIN KILLER."[2] 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, co-partners under the firm name of Perry Davis & 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 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.[3] "THE ARCTIC," for soda-apparatus, was also held to be valid.[4] "VALLEY GEM," for piano-fortes, was held not to be necessarily descriptive, while well adapted to its purpose.[5] "SUNNY SOUTH" is not a term so common as to prevent its use as a mark for stoves.[6]

§ 274. When we see "DAYLIGHT"[7] upon a vessel containing illuminating-oil, or "SUNLIGHT,"[8] or "GASLIGHT"[9] upon a similar article, we instantly perceive that the word is used as a fanciful denomination; and so of "WATER WHITE,"[10] as applied to refined petroleum, for those words could not in such a case be descriptive, any more than could "CRYSTAL"[11] be of castor-oil, or "STAR OF THE WEST"[12] of a pump.

§ 275. Mowing, reaping, and harvesting tools bear the

[1] 2 R. I. 566.
[2] Perry Davis & Son, No. 416.
[3] A. M. Lesley, No. 664.
[4] James W. Tufts, No. 678.
[5] Ohio Valley Piano Co., No. 795.
[6] Abendroth Brothers, No. 307.
[7] Bostwick & Tilford, No. 376.
[8] W. H. Reed, No. 708.
[9] Bostwick & Tilford, No. 377.
[10] F. M. Backus, No. 640.
[11] H. J. Baker & Brother, No. 373.
[12] H. Smith, No. 432.

designations of "RED RACER,"[1] "TIP TOP,"[2] "QUEEN OF THE MEADOW,"[3] "STAR OF THE WEST,"[4] "KING OF THE FIELD,"[5] "WESTERN DUTCHMAN,"[6] and "HARVEST VICTOR;"[7] and many other names which are understood to be purely arbitrary, to 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.[8] *Held*, to be either purely descriptive, or else calculated to deceive. Affirmed on Appeal. "Geyser Spring," for Saratoga mineral water.[9] The Examiner said in 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. He replied 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 Yellow-Stone Valley and of California, in our own country, might also have been mentioned. "Beeswax Oil" were in effect held by the Commissioner to be simply descriptive of quality.[10] The word "Razor" being purely descriptive, and "steel" a generic term, the compound word "Razor-steel" was refused registration.[11] The

[1] Greenwoods Scythe Co., No. 749. [2] Id., No. 750.
[3] Id., No. 751. [4] Id., No. 752. [5] Id., No. 753.
[6] Id., No. 754. [7] Samuel B. Forbes, No. 843.
[8] Crane & Co., *ex parte*. [9] George S. Batcheller *et als.*, *ex parte*.
[10] C. L. Hauthaway & Sons, Comm'rs' Dec., 1871, p. 97.
[11] R. J. Roberts, Ibid., p. 113.

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.[1] The words "Calendar Watch,"[2] 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.[3] "Lunch Milk Biscuit," to be applied to milk biscuit, for lunch or not, cannot be regarded as a trade-mark.[4]

§ 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[5] — 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 "weav-

[1] Solon Palmer, Comm'rs' Dec., 1871, p. 289.
[2] Daniel G. Hall, *ex parte*.
[3] Blakeslee & Co., Comm'rs' Dec., 1871, p. 284.
[4] C. D. Ross & Son, *ex parte*.
[5] The Woven Wire Mattress Co., *ex parte*.

ing" 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.

CHAPTER VI.

ACT OF CONGRESS OF JULY 8, 1870.

Danger of Superficial Reading. — Comparison with French Law. — Conditions Precedent to Registration. — Meaning of Words "Any Person." — Married Women. — Firm. — Domicile. — Meaning of Words "Any Corporation." — Treaty or Convention. — Entitled to Exclusive Use of Trade-Mark. — Protection. — Requirements, Antecedent to Registry. — What Statement to contain. — Residence and Place of Business. — Class of Merchandise. — Description of Trade-mark. — Fac-similes. — Mode of Application of Mark. — Length of Time used. — Payment of Fee. — Compliance with Regulations. — Filing of Declaration. — Requisites of Jurat and Certificate. — Oath, when not found on File, presumed. — Officer of Corporation.

§ 278. MERE superficial glances at the few sections in the act devoted to trade-marks have misled many persons, lawyers as well as laymen, as to the import of the language used in this scheme of protection to this species of incorporeal property. One erudite gentleman flung down the apparently-simple sentences, with the exclamation, "He that runs may read!" meaning that a sweep of the eye sufficed for a full comprehension of the subject. This faith in his own correctness, however, was much shaken, when the inaccuracy of even his Scripture quotation was turned against him as an illustration of carelessness; and he found that instead of being cursorily disposed of in a few enigmatical sentences, the law should be so plainly exhibited "that he may run that readeth it," and circulate its lessons. The most common language has been misunderstood, if not misread, and its spirit and reason utterly misconceived. The necessity of interpreting each line, and nearly every word, has been

demonstrated to the writer in his official capacity; so that the following exegetical commentary is little more nor less than the harmonious crystallization of innumerable decisions. Let us invoke the principles of legal interpretation and construction, in order to clearly ascertain the intention of the legislature in this Act of July 8, 1870.

§ 279. There are certain conditions precedent to registration, the non-fulfilment of any of which may prove a source of trouble to the proprietor of the trade-mark, and possibly avoid his right to protection.

§ 280. As many of the authorities cited in this treatise are decisions from the judicial tribunals of France, it will not be unprofitable to glance at the French Act, the basis of those decisions, where we will discern a strong resemblance to this:—

§ 281. The first article makes trade-marks optional, and gives a comprehensive definition of the term "*marques de fabrique et de commerce*," which our tongue shortens into the compound word "trade-mark." The second article prescribes that no one can maintain a suit to establish in himself the exclusive title to a trade-mark, unless he shall have deposited two copies of his symbol with the clerk of the Tribunal of Commerce of his domicile. The third article fixes the term of protection under that law for fifteen years, and provides for a renewal of deposit — equivalent to our registration — for a new term of fifteen years. By article fifth, all foreigners who possess in France establishments of industry, or of commerce, shall enjoy for their products the benefit of that law, upon the fulfilment by them of the conditions thereof. By article sixth, foreigners and Frenchmen whose establishments of business are outside of France shall equally enjoy the benefit of the said law for the products of their establishments, if in the countries where they are situated diplomatic conventions shall have granted reciprocity for French marks. In this case, the place of deposit of foreign marks shall be with the clerk of the Tribunal of Commerce of the Seine. There are penal provisions

which, being entirely local in character, cannot interest the general reader. It will be seen that there are striking points of resemblance between the French law and our own.

§ 282. The Congressional provisions in relation to the subject of trade-marks commence with section 77 of the Act aforementioned. We will take it up piecemeal, and endeavor to dispel the mists that obscure some portions of it, and which have innumerable times compelled this same pen to make expositions in an official way. The first paragraph runs thus: —

> § 77. *And be it further enacted*, That any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to wit:

§ 283. **Any Person.** — Do these words literally mean that any man, woman, or child; any citizen or alien; any resident, or non-resident, may obtain the protection of this law? Do they in effect include *any person* in the broadest sense of those words? This position has been strenuously insisted on before the Patent Office, by solicitors who had not the time nor the desire to think for their clients. We know that in law persons are divided into natural and artificial persons. Men, women, and children are called natural persons, and a corporation is an artificial person; but in another sense, by person is meant the part which a man plays in society.[1] In law, man and person are not exactly synonymous terms. Any human being is a man, whether a member of society or not. A slave, though a man, is in general considered not as a man, but as a thing — a chattel. Toullier[2] gives the derivation of the word

[1] Bouvier's Institutes, vol. i. p. 57.
[2] Droit Civ. Français, liv. i. n. 168.

"person." He says that, in its primitive and natural sense, it signifies the mask with which actors who played dramatic pieces in Rome and Greece covered their heads. In the vast amphitheatres it was impossible for a man to make himself heard by all the spectators. Recourse was had to art: the head of each actor was enveloped with a mask, the figure of which represented the part he was to play, and it was so contrived that the opening for the emission of his voice made the sounds clearer and more resounding, *vox personabat;* whence the name *persona* was given to the instrument or mask which facilitated the resounding of his voice. The name *persona* was afterwards applied to the part itself. It is in this latter sense of personage, or of the part which an individual plays, that the word *persona* is employed in jurisprudence, in opposition to the word man, *homo*. When we speak of a person, we only consider the state of the man, the part he plays in society, abstractedly, without considering the individual. Now, if the law-making body in this case had intended the words "any person" to be taken literally, without qualification or restriction, there would have been no need of mentioning any "corporation," a corporation being a person as much as is a human being. Nor could it have meant every human being, independent of his state and position; for such a broad construction would include a traitor in arms against the government, an outlaw, an alien enemy, one deemed to be civilly dead by reason of monastic vows, or judicial condemnation, or one under interdiction, — as one *non compos mentis* by the sentence of a competent tribunal, or a clergyman of the established church of England, who is inhibited from secular pursuits in which a trade-mark could be available. We must consider the object of this statute. It is to secure protection upon the fulfilment of certain conditions precedent. Protection can be awarded only through the instrumentality of judicial proceedings. No one "may obtain protection" who cannot place himself in a position to be protected. To grant, and to take, are correlative

terms. The phraseology is elliptical. By "person" is meant all men not under legal incapacity; or, as the paragraph explains itself, to apply to such as are "entitled to the exclusive use." To have no title, and not to be in a condition to assert it, have the same result. How could the alleged mark be "lawful," with no law to uphold it? One condition precedent to registration and consequent protection is the "filing of a declaration under the oath of the person," &c. By "person" is meant one who can legally take an oath. A perjured felon's oath cannot be accepted. Therefore, a perjured felon cannot be included by the general expression "*any* person," which consequently does not mean any and every man regardless to his position and character. The conclusion is obvious: the words "any person" include only such as are capable of taking and holding title.

§ 284. If we needed any further confirmation of the correctness of this interpretation of the word "any" as used in this section of the statute, we might adduce a parallel case furnished by this very same general Act.—Section 24 says, "That any person who has invented or discovered any new and useful art, machine," &c., &c., "may upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor." Does the word "*any*" mean literally any and every person, as is contended by the superficial reader? No! Why does it not embrace every person who shall have fulfilled all the conditions and requirements of the section? Because the general rule has an exception, as is obvious at a glance at section 16 of the statute. That says, "That all officers and employees of the Patent Office shall be incapable, during the period for which they shall hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by said Office." Just as one class of persons is expressly excepted by the words of the statute in one case, so is another class excepted by a necessary implication of law in the other case. Fragments

of laws are not law. *Any* person *having a right* to the exclusive use of a trade-mark may obtain protection. If the right exist, it will be recognized.

§ 285. **Married Women.** — By the common law of England and of this country, a married woman is wholly incapable of entering into mercantile contracts on her own account. By the fact of marriage all the personal property which she has in actual possession becomes absolutely her husband's, as entirely as if she had made a transfer of it to him. But in several of our States, the common law, which was of feudal origin, being considered inappropriate to our own state of society, has been essentially modified by statutory provisions, and married women become sole traders, with or without the consent of their husbands. There is a growing disposition both in the legislatures and in the courts to hold that a woman who is deserted by her husband, and who is laboring successfully as a trader to maintain herself, and perhaps her children, is in substance a sole trader, liable on her own contracts, and entitled to her own earnings.[1] If she may lawfully traffic in merchandise, it is because she has a property therein as a trader; and as an incident to her mercantile rights she is entitled to protection of her trade-mark. The Office will not inquire into the question of marriage. Nor will it question the age of any applicant. All other matters being regular, the certificate of registration will issue, leaving the subject of domestic relations to be settled in another tribunal.

§ 286. **Firm.** — A firm is the name, title, or style under which a company transacts business; hence, a partnership or house; as the firm of Hope & Co.[2] Seemingly there is an impropriety of language in using this word in connection with the word "domiciled," for the idea of domicile involves that of personality. A mere name, title, or style, could not be domiciled. However, we have the consoling reflection that a want

[1] See Parsons on Contracts, title Married Women.
[2] Webster's Un. Dic. and Worcester's Dic.: Firm.

of grammatical correctness will not vitiate, if the meaning can be gathered: *nam mala grammatica non vitiat chartam.* The term may be used in a corrupted sense to mean the aggregation of individuals represented by a certain title, *i.e.*, that the individuals comprising the house must be domiciled. If used elliptically, then it seems all the partners of the house must be meant. In that case, suppose that some of the partners are domiciled in one country and some in another, could the house be said to be domiciled in this country? A want of due care in this regard may possibly give rise to perplexing and complicated questions. Before applying for registration, it should be clearly ascertained whether a number of applicants constitute a partnership or not. If yea, the safer course would be for the domiciled members only to apply; for if the title to the mark be vested in individual names, the partnership may by license have all the benefit of it. This apparently-trifling point is worthy of consideration in order to guard the interests of owners claiming protection under this statute, even in cases where at common law the mark would be valid whether the owners were domiciled or not.

§ 287. **Domiciled.** — 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 has been led to demand an oath, showing of what country the applicant is a citizen, the same as in applications for patents.[1] 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 universally-agreed definition of the word, nor an agreed enumeration of the ingredients which constitute domicile.

[1] Patent Office Regulation, Feb. 29, 1872.

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 it, or adopt another. Thus, if a person should go on a voyage to sea, 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*.[1]

§ 288. 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.[2] 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 vote 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.[3] In *Abing-*

[1] Story, Conflict of Laws, § 44.

[2] Ibid., § 45.

[3] Ross *v.* Ross, 103 Mass. 575.

ton v. *North Bridgewater*,[1] 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 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.

§ 289. 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,[2] 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

[1] 23 Pick. 170, 177.

[2] Act of Congress, Feb. 10, 1855.

sometimes she may obtain one different from his, and institute proceedings for divorce.[1] A widow retains the domicile of her deceased husband until she obtain another domicile. *Primâ 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 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, or banishment, arrest, 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 North 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 intending to always remain in the land of exile.[2]

§ 290. 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, 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

[1] 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 Encyclop. Am.

[2] See title, National Domicile, Story, Conflict of Laws.

he is deemed a neutral, in war an enemy; and his property is dealt with accordingly in prize courts.[1] It is doubtless in this sense that the word "domiciled" is used in the act of July 8, 1870, as will be apparent upon a careful reading; for it was passed in the interest of commerce generally, and not with reference to the citizenship of applicants. 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 shall 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. 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 has been established in China, as a tea-merchant, and exports 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 through his counsel that so far as this statute is concerned, he must be regarded as a Chinese subject; and as such foreign country 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 fully acquiesced in this view, and so the matter ended.

§ 291. 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. To

[1] The Venus, 8 Cranch R. 278.

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 have yet been in the United States for more than an hour, and be included. What was his intention, as to permanency?

§ 292. 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 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. But what matter would that have been, since the residents of all foreign countries affording privileges of protection to trade-marks to our people are provided for in this act? Not at all. The object of registration is protection in our courts; and the right to that pro-

tection 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.

§ 293. 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 81. 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.[1] 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.[2] Any man obtaining an assignment of a trade-mark would prefer to be assured that he might assert his title the world over.

§ 294. 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 1870, is a question that may arise, but has not been officially passed upon. The language of subdivision 3, section 8, article 1, of the Constitution, seems to imply that a treaty would be necessary for the regulation of commerce with such tribes; and this law relates to commerce.

[1] Story, Conflict of Laws, § 54.

[2] Pardessus, De Droit Commercial, vol. v. art. 1482, p. 248.

§ 295. 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 had resided, on his way to another. It is an adventitious character gained by residence, and which ceases by mere residence.[1] 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.[2] The same doctrine was held in the Supreme Court of the United States in 1814,[3] 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 commencement 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.[4] In the civil war 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; *second*, 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,

[1] The Venus, 8 Cranch, 253 (1814).
[2] 2 Paine, 601.
[3] The Frances, 8 Cranch, 335.
[4] Rogers *v.* The Amado, 1 Newb. 400.

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.[1]

§ 296. As this law is in the interest of commerce, it may safely be assumed that the word "domiciled" will receive a favorable rather than a restricted stringent interpretation. It is a remedial and beneficial statute; and the words of such a statute are to be construed largely and beneficially, so as to suppress the mischief and advance the remedy.[2] Especially should this be the case in view of the fact that in the United States, as in England, and a few other countries, the courts are as open to the non-resident alien friend as to the resident citizen, *i.e.*, so far as regards common-law rights and remedies. It is only when one seeks to avail himself of the provisions of this particular statute that he is held to set forth domicile, and even then, it is probable that the courts would not require proof of any thing more than forensic domicile. Yet, at all events, the subject is worthy of attentive consideration.

§ 297. "**Any Corporation.**" — What do these words mean? Do they 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? 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.

[1] The Prize Cases, Black's Rep. ii. p. 635; Amy Warwick, Sprague's Decisions, ii.; and Law Reporter, xxiv. pp. 335, 494.

[2] Dwarris, p. 632; Sedg. on Stat. and Const. Law.

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 effect 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.[1]

§ 298. 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.[2] In 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

[1] Sedg., Stat. and Const. Law, p. 318.
[2] The Mercantile Loan and Warehouse Co. App. 683.

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.[1]

§ 299. 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 ecclesiæ*, the same as in England; and the right once established cannot be divested even by an act of the State legislature.[2] In Massachusetts, a minister seized of parsonage-lands, is a sole corporation for that purpose. Such a corporation sole cannot alienate, but has survivorship.[3] 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 individual 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

[1] The Safeguard Fire Ins. Co. of the City of New York.

[2] Angell & Ames on Corporations, § 27, citing decisions of Story, J.

[3] Brunswick *v.* Dunning, 7 Mass. 447; Weston *v.* Hunt, 2 Mass. 501; Jansen *v.* Ostrander, 1 Cow. 670.

fact,—an appeal has been taken in just such a case, and is still pending.

§ 300. 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.[1] In Webster's Dictionary we find that it may mean: 1. A hoofed 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;[2] 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.

[1] Legal and Political Hermeneutics, p. 100.
[2] Angell & Ames on Corporations, § 161.

§ 301. **Treaty, or Convention.** — 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 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.[1] In *Pisano* v. *Lawson*,[2] 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,[3] 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

[1] Collins Company *v.* Brown, 3 K. & J. 423; Collins Company *v.* Cohen, id. 428; 5 W. R. 676.

[2] 6 Bing. N. C. 90.

[3] Taylor *v.* Carpenter, 2 Wood. & M. 1.

marks." This doctrine had previously been asserted by Story, J., in the same court.[1] 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, 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: the language is, "any person, firm, or corporation resident of or located in." A citizen of the United States *resident* in such foreign country would, therefore, for the purposes of this act, be deemed a foreigner.

§ 302. Among commercial nations, there is a growing tendency to universal recognition of the emblems of commerce,

[1] Taylor *v.* Carpenter, 3 Story, 458.

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 of the enlightened countries. By the term "convention" we mean all kinds of contracts less formal than a treaty, and all pacts, understandings, or agreements,[1] 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 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,[2] 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,[3] the complainant, Kemp,

[1] Bouvier's Law Dic.; Webst. Dic., title Convention.
[2] Farina *et al. v.* Camus, Annales de la Prop., tome ii. p. 159.
[3] Kemp *v.* Herman, Annales de la Prop., tome xiii. p. 298.

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.

§ 303. **Entitled to the Exclusive Use of any Lawful Trade-mark.** — 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 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. 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.

§ 304. 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.[1] *Held*, 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

[1] Hill & Hall's case, Cert. No. 639.

individual names of the applicants, to avoid all question of legality.

§ 305. **Corollary.** — The meaning of the words ANY CORPORATION is this: any company organized for the purpose of manufacturing and vending articles of merchandise, or organized for trading purposes, and duly incorporated by the authority of the United States, or of any State or territory thereof; and also any incorporated company, located in any foreign country which affords protection to the trade-mark property of citizens of the United States. In the latter case without reciprocity it could not be deemed to be a *lawful* trade-mark. The words, "*exclusive use within the United States*," are not intended to restrict such to this country; but as the statute cannot have any extra-territorial force, it asserts protection only within the jurisdiction of our own tribunals. Protection beyond the limits of our own country is, of course, dependent upon treaty, convention, or national comity.

§ 306. **Protection.** — Persons have sometimes uttered strange ideas as to the meaning of this word, as here used. They have seemed to think that the seal of the Patent Office possesses a magical potency to blast any attempt at piracy, without the need of effort on the part of the owner of the mark. What does this term "protection" mean? It means that the power of the government, in its judicial branch, will be directed against infringers of lawful marks of commerce.[1] At common law protection was given in cases of encroachment upon an established trade-mark. A difficulty frequently presented itself, as to the evidence of adoption of the mark claimed. That difficulty may be stated in the language of the learned jurist, the late Mr. Justice Duer. "The right does not become established until the trade-mark be so often used, and so long employed, exclusively and uninterruptedly, as to create the presumption that everybody would know and acknowledge that it was the distinctive badge of the plaintiff's ownership,

[1] See chap. ii., *ante*.

and that the use of it by any one must have been intended to deceive purchasers." Registration enables a suitor to dispense with proof of long user, and the production of the certificate of registration creates *primâ facie* evidence of the plaintiff's title, *eo instanti;* and it operates as a notice, actual or constructive, to warn all other persons of the claim to exclusive ownership. Some judges have spoken of the act of registration as evincive of good faith, inasmuch as it fixes the date of adoption, describes the peculiar symbol, and tells to what particular class of merchandise the symbol is attached. The idea of a right to protection was no doubt founded on the notion that a reputation in the market for goods so marked could not be acquired until the sign which constituted the mark had been long used, and had acquired a currency like "the guinea's stamp." Protection will also be given under this statute when both parties reside in the same judicial district, which was not the case before.[1] It must be observed that protection is promised conditionally, upon compliance with certain requirements; therefore, if any of the things required to be done have been omitted, the plaintiff must fail. In a suit founded upon a certificate of registration, the defendant, unless heedless to the superlative degree, will procure from the Patent Office an exemplification of the whole record of the plaintiff's application, and use its weak points as a weapon of defence. It may appear upon the face of the petition, specification, or the oath, that the Office had never obtained jurisdiction, by reason of insufficient averments. Again, it may appear that such jurisdiction had never obtained, because the applicant had not presented a lawful trade-mark for registration. It would be folly to expect protection in such a case. The grant of letters of registration is in the nature of a contract between the public and the grantee; and a contract is a deliberate engagement between competent parties, upon a legal consideration. Such letters are as vulnerable as are

[1] See Judiciary Act of 1789.

defective patents. They bear but the merest semblance of a right, hardly serving the purpose of scarecrows. Unless the statute shall have been complied with in all its essential requirements, the certificate of registration shall prove as worthless as fairy money that crumbles into withered leaves, and be as false to hopes as the apples of Sodom, golden to the eye, turning to ashes in the mouth.

§ 307. The word "*may*" in this section should read "*shall*," this being a statute which directs the doing of a thing for the sake of justice or the public good, and to impose a positive and absolute duty.[1] The party, therefore, *shall* receive protection, provided he shall have fulfilled all the conditions on his part.

REQUIREMENTS, ANTECEDENT TO REGISTRY.

§ 308. First. By causing to be recorded in the Patent Office the names of the parties and their residences and place of business, who desire the protection of the trade-mark.

Names. — The same practice obtains in cases under this section, as in patent matters, as to the names of applicants. Upon some portion of the application-papers, the full names should appear, with as much particularity as in a conveyance of lands. The mere initials may do for an autograph. J. Styles may mean James, Jedediah, Joseph, or John Styles, and thus raise a question of identity. The full names of all the members of a firm should appear. In case of a corporation, the full and exact title should be given. The names of the witnesses should also appear in full in strict practice.[2]

§ 309. **Residences and Place of Business.** — By the term "residence" is obviously meant the fixed, permanent place of abode. A man sometimes has more than one place of residence, as his city residence and his country residence. If a citizen, where does he vote? If domiciled in some foreign country,

[1] Sedgwick on Stat. and Const. Law, p. 438.

[2] Rule 17, Rules of Practice in the U. S. Patent Office.

where is his temporary residence? We have seen, under the head of "domicile," that the latter term signifies something more than mere residence. A man may come to this country with the intention of engaging in business for a certain time, but with the resolve to return to his native country when he shall have effected certain results. His domicile may be in England, his residence in New Haven, in the State of Connecticut, and his place of business in the city of New York. All these three things should appear upon the record.[1]

§ 310. Second. The class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated.

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. It is doubtful whether more than one specific article can be included in the same registration. 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 letters 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,[2] the plaintiff — a corporation — conceded that it had never manufactured

[1] See the case of Capt. Marryatt, the novelist, who, being temporarily in this country, took the required oath of his intention to become a citizen of the United States, and then took a copyright for one of his books, which he then assigned to the plaintiff. *Held*, by Betts, J., in 1839, that he was not a "resident," within the meaning of the Act of 1831, so as to be entitled to a copyright. *Carey* v. *Collier*, Law's Digest, title Copyright (C. 2, 3).

[2] Amoskeag Manuf. Co. *v.* Garner, 55 Barb. 151.

prints; but because it had placed its trade-mark on every thing in the way of cotton goods, *except prints*, it insisted that it also had the right to place them 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 every thing 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."

§ 311. 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.[1] 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.[2] 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

[1] See Amoskeag Co. *v.* Garner, *supra*.

[2] The Lord Chancellor in the Leather Co. case, 11 Jur. (N.S.) 513.

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 merchandise bearing upon it a certain known mark of genuineness. Yet, for all this, the dictates of common sense are set at defiance by muddle-headed 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?

§ 312. Lest the proposition enunciated above should not be considered authoritatively given, let us consult the Bench. Ludlow, J., in 1860,[1] 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." These remarks are so consonant with the rules of common sense, that it would be unpardonable in a writer to produce additional authorities, were it not for the fact that the Office has been pestered with the declamatory nonsense of persons who contended to the contrary. To continue: Vice-Chancellor Wood, of England, in 1865,[2] said: "The law on this point, as

[1] Colladay *v.* Baird, 4 Phil. 139.
[2] Ainsworth *v.* Walmesley, 44 L. J. R. 252.

laid down in the cases before Lord Westbury,[1] I understand to be as follows, and I do 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* 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.'"[2] This rule is as rigid and unalterable as the laws of the Medes and the Persians.

§ 313. Third. A description of the trade-mark itself, with fac-similes thereof, and the mode in which it has been or is intended to be applied and used.

The Description should be so lucid and comprehensive that the language of the specification shall require no extraneous aid in its interpretation, to identify the appropriate device or symbol. The words, "as shown in the drawing and fac-similes hereto annexed," or equivalent forms of expression, will not suffice; as in point of fact the fac-simile is annexed only to the

[1] Millington *v.* Fox, 3 Myl. & Cr. 338; Hall *v.* Barrows, 10 Jur. (N.S.) 55.
[2] Leather Cloth Co. case, 11 Jur. (N.S.) 513.

certificate of registry, and does not appear in the specification, of which several hundred copies are printed for possible use. By a recent regulation, the representation of the trade-mark may be printed as a portion of the specification. In that case, it is not "annexed," but incorporated. An allegation that "the mark consists 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," would be unobjectionable.[1] Sometimes the representation filed consists of fanciful groupings of figures, or of ships and railway trains, and bridges, and a number of words, while the essential mark lies in a single word. The verbal description is, therefore, the only true guide.

§ 314. **Ten Fac-similes** must be filed, when the representation consists of an engraving, lithograph, letter-press, &c.; but when it consists of an original drawing, made in accordance with the Office-rules, and which may be photo-lithographed, that will be sufficient without fac-similes.[2]

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

§ 316. Fourth. The length of time, if any, during which the trade-mark has been used.

[1] Middlesex Co., No. 655.

[2] Office Rules of Practice, Nos. 83, 87.

Preciseness upon this point may become an important item in a contest for the establishment of priority of adoption. A neglect to accurately fix the time may operate as an estoppel in the event of conflicting claims, and limit the date of adoption to that of application for registry; and at all times it might justly be regarded as a suspicious circumstance, as, for example, when it is stated that the mark has been used for "a long time," or for "a number of years." If the applicant state that he "has adopted, and intends to use," &c., he would be precluded upon trial from going behind the record, and giving evidence of long user. If he state that he has used the mark for ten years, and the proof be that he has used it but five, would that not be regarded as evincive of bad faith? Here is one thing that should be carefully looked into by the applicant before registry, and by his antagonist at the trial. It frequently happens that the application, as filed, alleges that the mark therein described has been used for a certain time, or number of years; and then upon an after-thought, perhaps on account of rejection, the description is amended so as to materially change the symbol itself, and not upon oath. The seventh subdivision of the section we are now considering calls for a declaration under *oath* that the party has the right to the use of *the* trade-mark, and that the description is true, &c. What trade-mark? Clearly that which was used for such a time, and not that which appears in the amendment. An irregularity in this respect may be fatal to the plaintiff. Therefore, when an application is amended so as to alter the symbol in any essential feature, let the oath be renewed. It has been said upon very respectable authority that this part of the section as to oath is merely directory, and within the discretion of the Patent Office; and that consequently the issue of a certificate of registry would cure all defects. This is an error. When a patent has been issued, and the letters contain a recital that the inventor duly made oath, &c., that recital would be conclusive in case of not finding the required

affidavit on file; for it would fairly raise the presumption that the affidavit had been misplaced; but if the affidavit be found on file, and its statements be insufficient or repugnant, that would be conclusive evidence of the fact that the Office had no jurisdiction. So, in a trade-mark case, may the response be, *Coram non judice*. The Office does not arrogate to itself the doctrine of infallibility.

§ 317. Again, it is a sound doctrine that a symbol may be a lawful trade-mark, from the facts of long user and established reputation, which could not be so considered if but recently adopted. Judicial decisions may be invoked to prove that the thing has been involved in forensic strife where its legal sufficiency was brought into question, and affirmed. Notoriety from long continued user may give a currency and value that could not be predicated of a brand-new mark; just as a neologism, which in its inception was an unknown foundling, or cant, or slang, has been adopted into the family of legitimate words, and holds up its head with the stateliest words in the standard dictionaries. "The rank is but the guinea's stamp;" but the guinea gold would lack currency without the stamp. A hieroglyph, or a combination of letters, may pass almost without challenge on account of venerable age and universal recognition, which, were it to come unheralded and without indication of antiquity, would be subject to rigid scrutiny and criticism. A common word might be rejected unless it had come to denote merchandise as originating with some particular person. The association may save it. A title by prescription will have been acquired.

§ 318. Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

The payment of this fee is an essential prerequisite to placing upon file for examination. When once paid, as in case of duty paid upon an application for a patent, or on the filing of a *caveat*, it is not a pledge or deposit of the money,

but an absolute and unconditional payment into the treasury;[1] and it cannot be reclaimed unless it should have been paid by mistake,[2] as when one intending to apply for a copyright erroneously applied for the registry of a trade-mark, or in any other case where the Patent Office had no jurisdiction of the subject-matter.

§ 319. Sixth. The compliance with such regulations as may be prescribed by the Commissioner of Patents.

The Regulations may be found in the Rules of Practice of the Patent Office, established by the Commissioner, subject to the approval of the Secretary of the Interior;[3] and *perhaps* in orders made by the Commissioner alone under authority of this subdivision. Whether the approval of the Secretary is required in trade-mark cases is not settled, and indeed has never been formally called in question. Regulations have all the force of statutory enactments, and, until repealed, are as binding upon the Office as upon parties.[4]

§ 320. Seventh. The filing of a declaration, under the oath of the person, or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and 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, and that the description and facsimiles presented for record are true copies of the trade-mark sought to be protected.

It is not sufficient to make oath that no other person, firm, or corporation has the right to use such mark, or one substantially the same; but the remainder of the section must be included, so as to make out a *primâ facie* case beyond all peradventure. The term "oath" is used; but an affirmation is deemed to be equivalent thereto, and in accordance with the spirit and reason of the law. Statutes *in pari materia* are to be taken together. Section 30 of the same general act, where it relates

[1] Att'y-Gen's' Opinions, vol. ix. p. 64. [2] Pat. Office Rule 111.

[3] Sec. 19, Patent Law of July 8, 1870.

[4] 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.

to patents, uses the words "oath or affirmation." By a necessary implication, to prevent the failure of a right because of conscientious scruples, the word "affirmation" must be interpolated. The English laws concerning paupers, and the bankrupt acts, are construed together as if they were one statute, and as forming a united system; otherwise the system might, and probably would, be inharmonious and inconsistent.[1]

§ 321. The manner of administering the oath, or affirmation, must of course be left to national or local peculiarities and customs, as in the case of heathen idol-worshippers. The oath may be made in the United States before any officer authorized 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.[2] 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.

§ 322. **The Oath must comply with the Statute.** — In a patent case, it was held that an oath that an original patent "is not fully valid and available" to the patentee, is not such an oath as is required by law; and it was an excess of author-

[1] See Sedg. Stat. & Const. Law, p. 248.

[2] Act of Cong., Sept. 16, 1850; and Rule 10, Patent Office.

ity on the part of the Commissioner to grant a reissued patent upon such an oath.[1]

§ 323. **Jurat.** — There is no act that requires the *jurat* to an application to be dated.[2]

§ 324. **Certificate of Officer.** — In one case it was questioned whether a notary-public had complied with the Act of Congress of Sept. 16, 1850, which allows oaths to be taken before a notary-public, "and when certified under the hand and official seal of such notary, shall have the same force and effect as if taken or made before such justice or justices of the peace." He did not state 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. Held sufficient.[3]

§ 325. **Where there is no Oath on File,** the fact that a blank form of oath not executed is found among the papers 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.[4] And suppose the oath had not been taken at all, would the patent be void on that account? Story, J., in one case held otherwise.[5] 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.[6] 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.*)

§ 326. **Officer of the Corporation.** — The president, vice-presi-

[1] Whitely *v.* Swayne, 4 Fish. 117. [2] French *v.* Rogers, 1 Fish. 133.
[3] Goodyear *v.* Hullihen, 3 Fish. 251.
[4] Crompton *v.* Belknap Mills, 3 Fish. 536.
[5] Whittaker *v.* Cutter, 1 Gall. 429.
[6] Clifford and Clark, JJ., Crompton *v.* Belknap Mills, *supra*.

dent, secretary, superintendent, or the treasurer. It has been decided by the Special Examiner that the oath of a mere director could not be received, he not being in strict language an officer. The chief of the Office had never decided the question.

§ 327. **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 *Fetridge* v. *Wells*,[1] 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 plaintiffs' 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 No. 1 of the "Averill Chemical Paint Company." The verbal description of the Averill Co. reads as follows, viz: "In the foreground,

[1] 4 Abb. Pr. R. 144.

on a rock, with the word 'Chemistry' upon it, is an eagle holding in his mouth a paint-pot or canister, with a brush, and a ribbon or streamer, on which are the words, 'Economical, Beautiful, Durable.' Below the feet of the bird is represented water, upon which are a steamer and other vessels. In the background is a bridge or viaduct, with a train of railroad cars upon it. Further in the background are seen buildings and manufactories." The applicant's specification presented the same general effect. "Omit the word 'Chemistry,' said the Special 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."[1] 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.

§ 328. 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.

[1] Case of Henry W. Bradley, ass'r to Young & Co., *ex parte*, 355.

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 represent himself to be a citizen, in order to obtain a patent, the patent so obtained is inoperative and invalid to vest title. Where the taking of the oath is a condition precedent, the want of it may be pleaded in defence.[1]

§ 329. 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 the 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.[2]

[1] Child *v.* Adams *et als.*, 1 Fish. 189.
[2] Whitely *v.* Swayne, 4 Fish. 117.

CHAPTER VII.

ACT OF CONGRESS (*continued*) — PROTECTION AND REMEDIES.

Duration of Time of Protection. — How limited. — Penalties for Infringement. — Safeguard against Registration of Marks, not Lawful, or mere Name of Person, Firm, or Corporation. — "Remedy" a Figurative Expression. — Caution against Hasty Litigation. — Meaning of Term "Lawful Trade-mark." — *Mere* Name of Person, &c. — Proviso, Lawful Trade-marks not to be refused Registration. — Patent Office Certificate, Evidence. — Assignments and other Transfers. — Abstract Symbol cannot be transferred, why? — Form of Transfer. — Damages for False Registry, &c. — Court of Competent Jurisdiction, what? — Rights not abated by this Act. — Unlawful Business precludes Remedy. — Article . . . Injurious in Itself. — Fraudulent Registry. — Deceiving the Public. — Precaution of Patent Office. — Effect of Registration.

DURATION OF TIME OF PROTECTION UNDER THIS ACT.

§ 330. (Sec. 78.) *And be it further enacted*, That such trade-mark shall remain in force for thirty years from the date of such registration, *except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country and in which it receives protection under the laws of any 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 same time that it becomes of no effect elsewhere*, and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods: *Provided*, That six months prior to the expiration of said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents, and the fee for such renewal shall be the same as for the original registration; certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force

for a further term of thirty years: *And provided further*, That nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

To relieve this involved and perplexing sentence from some of its obscurity, a portion of it, for our present purpose, has been italicized.

§ 331. **Shall remain in Force for Thirty Years.** — What shall remain in force for thirty years? The trade-mark? No, clearly not, when we consider that this act cannot create a trade-mark, and for the same reason cannot destroy it. If we do not arrive at this conclusion by a process of reasoning, let us look to the ending of the section, and there we find abundant light. An ellipsis must be supplied to render plain this phraseology. It should read thus: "that *the protection hereby granted to the owner of* such trade-mark," &c. At the end of that time (thirty years), the claim for redress for encroachment is to be remitted to the common law.

§ 332. *The term of protection* under this statute *may be less* than THIRTY years. The portion of this section which we have italicized obviously means, that when the right to foreign protection shall have expired, it shall also cease here, so far as this act is concerned. This section has in contemplation the idea of reciprocity. We give protection to residents of other countries, when the laws of those foreign countries grant a similar protection to citizens of the United States. It must be observed that it matters not whether the person protected abroad be an American citizen or not, nor is his commercial or national domicile taken into consideration in construing this section. When the trade-mark is "applied to articles not manufactured in this country," &c., is the language.

§ 333. *When there are protections in several foreign countries*, and which expire at different times, when will the protection under this act expire? "It shall cease to have any force in

this country, by virtue of this act, at the same time that it becomes of no effect elsewhere," is the language used. This means *any*where. Take the analogous case of a patent which "shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term."[1] Therefore, a right to protection under and by virtue of this act may expire in a year, or a month, or a day, after registration, or it may continue for the full term of thirty years, with a right of renewal for thirty years more.

PENALTIES FOR INFRINGEMENT, AND SAFEGUARD AGAINST FALSE MARKS.

§ 334. (Sec. 79.) *And be it further enacted*, That any person or corporation who shall reproduce, counterfeit, copy, or imitate any such recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action in the case for damages for such wrongful use of said trade-mark, at the suit of the owner thereof, in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use. The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public: *Provided*, That this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act.

§ 335. 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 past ages. The penal portion of this section must be strictly construed. The law gives satisfaction for infringement whether

[1] Sec. 25, Patent Laws, July 8, 1870.

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.[1] Such a tortious invasion of this kind of property, although unaccompanied by special damage, is maintainable.[2] 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.

§ 336. 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.[3] 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.[4] 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, no degree

[1] Sedgwick on the Measure of Damages.

[2] Broom's Commentaries on the Common Law (3d ed.), p. 88, and authorities cited.

[3] See Sedg., Stat. and Const. Law, p. 402.

[4] Bl. Com. book ii. chap. 29.

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 any thing 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,[1] nor is it necessary that the intent should be to defraud him to whom such false and fraudulent representation is made.[2] 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.[3] 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.

§ 337. *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*;[4] 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*.[5] 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

[1] Pasley *v.* Freeman, 3 T. R. 51.

[2] Boyd *v.* Browne, 6 Penn. St. R. 310.

[3] Coats *v.* Holbrook, 2 Sand. Ch. R. 586; Taylor *v.* Carpenter, 2 Wood. & M. 1; 11 Paige, 292; and 2 Sand. Ch. R. 603.

[4] 1 T. R. 512; Co. Litt. 197 (b). See Bac. Abr. Actions in general, B; 1 Chitty, Gen. Prac., part i. c. 1.

[5] 2 Ld. Raymond, 953; Willes, 597.

in form and spirit. Indeed, had not the statute named the action, a trade-mark is such an incorporeal right, that the violation of it by acts indirectly and consequentially injurious could not have looked to any other kind of legal redress. The equitable remedy of injunction, account, destruction of counterfeit marks, &c., are equally unaffected by the language of this statute.

§ 338. The first remedy prescribed is an "action on the case," sometimes called "trespass on the case," and is the same remedy that the common law affords.[1] 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.[2] 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.

§ 339. **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

[1] Lord Mansfield, in Bird *v.* Randall, 3 Burr. 1353.
[2] See title, Remedies.

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 loop-holes through which a pirate may creep with impunity, under the strict construction to which the penal nature of this section 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 as 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.[1] 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

[1] Curtis on Patents: Infringement.

to the thing that is for sale as an indication of genuineness of the product, there is ample protection.

§ 340. Nice technical distinctions must arise from this section. If the party complaining shall have complied with all the imperative prerequisites to registration, then he may bring his action under this act; but if his application shall have been so inartificially prepared as to cause doubts as to regularity, he had better turn his attention to the common law, irrespective of the provisions contained in this statute. But a new difficulty may loom up if the aggrieved party is compelled to resort to the antecedent common law; for he may desire or find it necessary to resort to a federal tribunal, and both parties be citizens of the same State. If the action be brought under this statute, that fact of residence would not be an objection; but if brought at common law, the judiciary act of 1789 would be an insuperable bar.[1] It is true that under the practice of the Patent Office, though without any express statutory provision upon the subject, a certificate of registration of a trade-mark founded upon defective statements may be surrendered and reissued, as in case of a patent; but even that course has its disadvantages, besides the unavoidable expenditure of money. Can a plaintiff recover damages in an action under this act for an infringement before the time of registry? Can he declare for a wrong at common law, and a wrong under this statute in the same action? If so, he would not materially suffer by the fact of surrender and reissue; but, otherwise, he could not recover for an injury committed previously to the date of his valid certificate.

§ 341. **Lawful Trade-mark.** — The prohibition of registry of any proposed trade-mark which is not and cannot become a lawful trade-mark, implies the use of sound discretion and judicial examination. The questions for the Office to answer are these: Could this proposed mark be sustained in an action or suit? Is it the symbol of commerce that is entitled to

[1] Act of Congress, Sept. 24, 1789, sec. 11.

universal recognition, by reason of possessing all the essential characteristics of a right to exclusive use in its application to merchandise? has it the quality of distinct invariability? of individuality? and of truth and good-faith?[1] If any of these questions be answered in the negative, then it is not a "lawful trade-mark." All the inquiries incidental to an investigation in a court of justice must be anticipated in the Patent Office. It would be a grievous wrong to an applicant to permit him to register a rotten hulk of a case. There may be intrinsic merit in a proposed mark; but the preparation of it may have been confided to a heedless solicitor, who will present it in such a manner that it must fail in court. The claim may be too broad, or it may be ambiguous, or mean nothing at all. Hence the necessity for a strict, conscientious scrutiny on the part of the Office, lest a valuable cargo be sent to sea in a crazy bottom.

§ 342. In a previous chapter we have seen examples of proposed trade-marks, rejected as being insufficient to meet the requirements of the law. Here is a matter which came up for consideration after that chapter had been printed. The decision tells its own story. PER OFFICE: "It is proposed to adopt 'the masonic emblem of the square-and-compass,' and thereby to transform into a lawful trade-mark certain words which have hitherto been refused recognition as such mark. Can such an emblem be exclusively appropriated? Can it be applied to the purpose of traffic? Is it calculated to answer the purpose of a mark to be affixed to merchandise, so as to denote origin or ownership? These questions can best be answered after an inquiry into the meaning of the emblem. It is the symbol of a fraternity that is known throughout the world, — pervading all classes and conditions of society, — and which claims for itself a continuous existence from pre-historic times. As an ideogram, it virtually proclaims its possessor to

[1] See Moorman *v.* Hoge, U. S. Cir. Ct., Cal. Dist., 1871, on a registered trade-mark, Am. Law Review, vol. vi. p. 365.

be a member of a certain order of men, whether such be true or false. It is an ideographic appeal to fraternal feelings. It has been anathematized by the followers of one religious faith, at least, and has for centuries been regarded as the distinctive badge of a peculiar body. If now placed upon the head of a flour-barrel, as proposed by the applicant, what would the purchaser understand thereby? Would he be apt to associate it with the industrial product of a certain person? No. He would naturally think that the person who had applied it to such a purpose meant it to be taken in its legitimate and ordinary sense. Proposed amendment rejected."[1]

§ 343. The emblem was deemed to be unfitted to the legitimate office of a mark of trade, because it has always had but one signification. It is in the nature of an advertisement of sincerity. It imports no more when so used than truthfulness, good faith. If one might adopt it as his trade-mark for flour, others might adopt it as a mark for any other kind of merchandise, and wholly irrespective of membership in the order implied by its symbolical language. It would thus not only bring a certain class into contempt by the perversion of their emblem, but might also be made the instrument of the basest deception. This rule is applicable to the distinctive emblems of all creeds, — religious or political. We know that a word may be made to serve as a trade-mark; but suppose that the word "Christian" were proposed, would it be recognized as a lawful mark? Assuredly not. No person could exclusively enjoy the use of that or any other word meant as a mere recommendation, and which has no meaning except in its relation to a certain faith. The masonic symbol conveys an analogous idea, as is well known to all who have read books upon the subject. Yet there are certain emblems which, although suggestive of a faith, or a nationality, are not rigidly confined to their primitive limits. The cross, for example, has been used by Pagans as well as by Christians. The Maltese

[1] Two cases of John F. Tolle, *ex parte*.

cross has lost much of its original signification, so that it has many times been accepted as a valid mark for goods. Its use for such a purpose offends no one, so far as known. The crescent, the symbol of Mahommedan faith, was used for trade with the Turks, as is shown by the case of *Gout* v. *Aleplaglu*,[1] and it seems that the most bigoted found no fault therewith.

§ 344. After the foregoing had been printed, the following decision on appeal was made. The novel question is therein treated in a masterly manner. THACHER, *Acting Commissioner*: "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 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*, Official Gazette, vol. i. p. 27, 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 signifi-

[1] 6 Beav. 69.

cation. If this emblem were something other than precisely what it is, either less known, less significant, or fully and universally understood, all this might readily be admitted. But considering its peculiar character, and relation to the public, an anomalous question is presented. There can be no doubt that this device, so commonly worn and employed by masons, has an established mystic significance, universally recognized as existing; whether comprehended by all or not, is not material to this issue. Considering the antiquity, the traditional origin, the profound secrecy, the magnitude and extent, the flourishing condition, and the permanent character of the masonic organization, I seriously question whether its emblems are not to be regarded as its property, at least in such a sense, that no person can monopolize them as trade-mark devices. It is not proposed, however, to do more than raise the query, without entering upon the discussion here. The ground for this decision lies in another direction, and to my mind is obscured by no cloud of doubt. In view of the universality of masonry, — the mystic tie that binds all nationalities in one common fraternity, — and the unchangeable characteristics of emblems appealing with the same force to the brotherhood in all parts of the earth, it is impossible to divest these symbols, or at least this particular symbol, perhaps the best known of all, of its ordinary signification wherever displayed, either as an arbitrary character or otherwise. It will be universally understood or misunderstood as having a masonic significance, and therefore as a trade-mark must constantly work deception. Nothing could be more mischievous than to create as a monopoly, and uphold by the power of law, any thing so calculated, as applied to purposes of trade, to be misinterpreted, to mislead all classes, and to constantly foster suggestions of mystery in affairs of business. 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 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. Thus, if these trade-marks could be sanctioned, they would tend to defeat the fundamental object of the trade-mark law, which is an offshoot of the ancient 'law-merchant,' and like that designed to advance trade and manufactures. Decision of the Examiner affirmed." Oct. 3, 1872.

§ 345. Now opportunely presents itself a still fresher matter, 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., C. D., 1871, p. 284, 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. I am unable to make any distinction between these two cases: they appear to be perfectly analogous. In both instances, the letters themselves would probably be

regarded as a legal trade-mark; but when used in connection with words of which they are the initials they lose the characteristics of an arbitrary device; their precise meaning becomes evident from the words which they accompany, and they are as much descriptive as the words themselves. Hence initial letters can add nothing to a phrase which is not a lawful trade-mark without them. 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. It would be unjust to give one person or firm the monopoly of words used in a descriptive way, to which others might have the same right, as descriptive matter. The decision of the Examiner is affirmed in both applications. (Sept. 12, 1872.)[1]

§ 346. 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 of elemental parts not before brought together in that kind of machine. The machine itself may have existed before; and the separate elements of the new combination may have existed before; but if those elements have not been before united so as to produce a method of operation differing from what had

[1] J. S. Johnson & Co., *ex parte*, Official Gazette, vol. ii. p. 315.

been done before in that kind of machine, what is called a new combination is created.[1] 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.

§ 347. An applicant[2] 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, were filed a written argument of counsel and a number of affidavits. 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 are wronged or misled. This, I believe, the testimony fully establishes." It is manifest that the counsel intended to

[1] Curtis on Patents, § 111 (3d ed.).
[2] John E. Cassidy, *ex parte*, Sept. 24, 1872.

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.[1] 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 out-work 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.

§ 348. **Merely the Name of a Person, Firm, or Corporation.** — This has been construed to mean the name of the party applicant. In some instances, the courts have held that the names of historical persons of note could be used as fancy names, and therefore be valid trade-marks. In one instance, the proposed mark consisted of the word "Alexina." The Special Examiner refused registration, because "Alexina" is merely the name of a woman, and cited instances. This decision was reversed on appeal to the Commissioner in person, who held that the name was an arbitrary symbol as used by the applicant.[2]

§ 349. In another case, where an applicant had used for the

[1] 1 Greenl. Ev., ch. xv.

[2] Winslow & Rogers, No. 643.

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.[1] 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.

§ 350. 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. John Jones cannot claim the right to an exclusive use of his mere name to mark his merchandise, consisting of boots and shoes; for any other person of the same name, dealing in the same class of merchandise, has as good a right to so mark his goods. 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.

§ 351. When the proposed trade-mark is identical with one already registered and appropriated to the same class of mer-

[1] Kelita Brodhurst, No. 946.

chandise, or which so much resembles it as to be likely to deceive the public, it must be rejected, unless the junior applicant prove his priority of right. The mark may not have misled the public. It is sufficient to warrant rejection if it have a tendency to deceive. It may have craftily been designed for the express purpose of diverting the true owner's trade, or the similarity may be the result of accident. Coincidence is the point. The Office will not be confined to registered marks, nor to those which have been filed for registry, in protecting the owner of the genuine mark and the public from an impostor; but if it be ascertained from any source that the mark is entitled to protection at common law, or by the *lex mercatoria* of any country, the fraudulent applicant will be repulsed: for his mark proposed for registry will be obnoxious to the objection that it "is not, and cannot become a lawful trade-mark." Honesty of purpose is an indispensable requisite.

§ 352. **Proviso.** — This section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act. With what particularity is this proviso worded! The mark must have been "lawful" before the act of Congress. It is scarcely necessary to repeat in this place, that the essential ingredients of a trade-mark at common law were precisely what they are under this statute. This act does not pretend, nor has it the power, to expand or contract the inherent qualities of the symbol of commerce. The mark, therefore, must not only have been a *lawful* mark for some one; but it must also have been *rightfully* used by the claimant. The proviso means this: One applicant is not to be precluded from registering his mark because another has preceded him in making application. The junior applicant is not amenable to the charge of *laches;* for registration is not obligatory. The *primâ facie* title obtained by the grant of a certificate is liable to be overturned by proof of an older continuous title. It may possibly be the case that an applicant was delayed in

making application, for the lack of treaty or convention between our country and his. Whatever his reason may be, that is a matter with which the United States will have nothing to do. The right to a trade-mark has its foundation in immutable law, independent of arbitrary law or regulation. The want of treaty stipulations may have postponed his remedy to some degree, but could not extinguish the right. In patent cases, we speak of "the race of diligence" in making application for the necessary grants. That phrase is not applicable to the registry of trade-marks. When the owner of a mark appears, he is entitled to recognition, subject, of course, to the rule in regard to international reciprocity. An interference may be declared. Then both parties, the grantee and the petitioner, have an opportunity to test their respective claims. If the junior applicant be found to possess the older title, a certificate of registration issues to him. The Office does not hold the power of cancellation; therefore resort must be had to the courts, either for damages for improper use, or for an injunction, an account, and other redress.

§ 353. There are two recently-published opinions that, upon 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 als.*, in the Circuit Court of the United States for the District of Oregon, in 1869.[1] 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

[1] Deady's Rep. (1859–69), p. 609.

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 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; the defendants 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; for it must be remembered that this suit was instituted before the time of the passage of the Act of 1870, which permits both parties to belong to the same State, as in a patent or a copyright case. 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. A suit might well have been brought in a court of the State of Oregon; but for some reason, not apparent on the face of the record, it was desirable to submit the cause to another jurisdiction. A non-resident was found; so the necessity for a direct attack in a State tribunal was averted, and a skilful flank movement was planned and executed. 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 als.* does not judicially decide that the mere name of a corporation is a trade-mark.

§ 354. The other corporation case which invites our attention is that of *Holmes et als.* v. *Holmes et als.*,[1] 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

[1] 37 Conn. 278.

shown that it did), it will be protected. How? "*Upon the same principle*," not *as being* a trade-mark.

§ 355. (Sec. 80.) *And be it further enacted*, That the time of the receipt of any trade-mark at the Patent Office for registration shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the Patent Office, certified by the Commissioner, shall be evidence in any suit in which such trade-mark shall be brought in controversy.

Evidence. — The record operates as *primâ facie* evidence of title, as in the case of letters-patent.[1] Before the time of 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 a new and useful invention by the party. That may, and often does, prove not to be the fact. The Commissioner makes a certificate of the *primâ 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.[2] 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 de-

[1] 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.

[2] Att'y-Gen's' Op., vol. viii. p. 277.

fendant 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.

§ 356. It was held in the Court of Metz, in France, in 1861, in the case of *Somborn* v. *Menser et al.*,[1] 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 user, therefore, destroys the presumption created by registration.

§ 357. "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

[1] Annales de la Prop., tome viii. p. 78.

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 words "patented" on such 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.[1] 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.[2] The dispute being as

[1] Sec. 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."

[2] Sternberger *v.* Thalheimer & Hirsch, still pending.

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.'"

§ 358. As evidence that a certificate of registry is neither a patent nor a thing in the nature of a patent, we have a decision of Commissioner Leggett. A member of the examining corps of the Patent Office sought for means to protect a trade-mark used by him, and as a precautionary measure desired to register the same, provided he could legally do so; of which he had a doubt. The Commissioner had previously carefully studied the point. Section 16 of the patent law declares all officers and employees of the Office to be incapable to acquire, &c., any right or interest in any *patent*. *Held*, that there could not be the slightest possible objection to registration in such a case.

ASSIGNMENTS AND OTHER TRANSFERS.

§ 359. (Sec. 81.) *And be it further enacted*, That the Commissioner of Patents is authorized to make rules, regulations, and prescribe forms for the transfer of the right to the use of such trade-marks, conforming as nearly as practicable to the requirements of law respecting the transfer and transmission of copyrights.

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.

§ 360. Particular attention is invited to the phraseology of this section, especially the words "forms," "rights to the 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 the opinions of learned judges and chancellors, who have had occasion to judicially 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*,[1] 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,[2] in the Supreme Court, 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*,[3] in 1870, the court cited authorities, and said, 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,

[1] 57 Barb. 526, and 4 Am. Law Times R. (St.) 168. [2] Ibid.
[3] 3 Am. Law Times R. (St.) 288, and 2 Brewster, 321.

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*,[1] in 1869. In the Supreme Court of California, in *Derringer* v. *Plate*,[2] 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 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*,[3] in the United States Circuit Court, N. Y. Dist., 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 Co.[4] case, 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*,[5] in 1865, said: "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

[1] 2 Daly, 521.
[2] 29 Cal. 202.
[3] 3 Blatch. C. C. 440.
[4] 11 Jur. (N.S.) 513.
[5] 44 L. J. R. 252.

word, property." In the Rolls Court, in *Hall* v. *Barrows*,[1] 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 — if such he can find.

§ 361. **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 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*,[2] 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 Cos.,[3] Lord Kingsdown said that if an artist or an arti-

[1] 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.

[2] 24 Barb. 163; 13 How. Pr. R. 342; and 4 Abb. Pr. R. 88. [3] *Ubi supra.*

san 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 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 thus, "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.

§ 362. Upon the formation of a partnership with a person entitled to the benefit of a trade-mark, the trade-mark, in the absence of express provisions in relation to it, becomes an asset of the partnership — the trade-mark being but one element of the trade. It may also pass to trustees under a creditor's deed.[1]

§ 363. **The Commissioner to prescribe Forms** for the transfer of the right to use such trade-marks. This section probably does not contemplate any but registered trade-marks, as is evi-

[1] Bury *v.* Bedford, 10 Jur. (N.S.) part i. p. 503.

denced by the word "*such*." 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.* Reference is made to the requirements of law respecting the transfer and transmission of copyrights. We turn to the only provision of law upon the subject,[1] and find that an assignment must be recorded within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice. By the same section, copyrights are made "assignable in law, by *any* instrument in writing." This broad provision has not been in any wise modified by any rule or regulation of the Patent Office respecting trade-marks.[2]

§ 364. It has repeatedly been held that an agreement which operates as an assignment of a patent is good against the patentee, and those who purchase without notice, though not recorded.[3]

§ 365. An assignment of a patent, by one of two or more administrators, is good, and passes the entire interest.[4] This is applicable to the case of property in a trade-mark.

§ 366. **Personal** trade-mark. If this is in any respect less assignable than one referring to locality only, or a mere device, the distinction must be limited to mere cases where the mark is so clearly personal as to import that the goods bearing it are manufactured by a particular person.[5]

[1] Sec. 80, Act of Congress of July 8, 1870, in relation to patents and copyrights.

[2] Rule 88, Patent Office; Form 44, Office-Rules Appendix.

[3] 4 Fisher, 428.

[4] 1 Fisher, 239.

[5] Bury *v.* Bedford, 10 Jur. (N.S.) 503; 33 L. J. Chan., 465.

DAMAGES FOR FRAUDULENTLY PROCURING REGISTRY, ETC.

§ 367. (Sec. 82.) *And be it further enacted*, That any person who shall procure the *the* registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark in the Patent Office under this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case before any court of competent jurisdiction within the United States.

This section creates a right of action. At common law, the wrong-doer 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*.[1] He says: "Has more ever been necessary to be proved in actions of this description than that the plaintiff, being a manufac rer, 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 plaintiff's goods, with intent to deceive?" On these grounds, the action was held not to be maintainable in *Singleton* v. *Bolton*,[2] 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.[3] Probably, by virtue of this section, the real

[1] 5 C. B. 109; 5 Man., Gr. & S. C. 109. [2] 3 Doug. 293.
[3] Lloyd on Trade-marks: Remedies against Piracy.

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.

§ 368. **Any Court of Competent Jurisdiction.** — The full scope of this provision in regard to the forum is dubious. Does this section creating a new right of action give the courts of States jurisdiction of suits brought therefor? or does it apply only to federal tribunals?

§ 369. (Sec. 83.) *And be it further enacted*, 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 this act had not been passed.

The effect of this section — if it is not sheer surplusage — is, to say the least, problematical. Possibly, it means that any continuing wrong, for which a party had a remedy at common law, or in equity, shall not abate by reason of registration of a mark, infringed upon before July 8, 1870. It may be that it is intended to permit the joinder of causes of action arising before and since the registration.

§ 370. (Sec. 84.) *And be it further enacted*, That no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

To entitle the plaintiff to recover damages for infringement of his mark, it is essential that it be his mark of commerce, and that the business carried on by him be *lawful* in its nature. It is a broad principle of law that all contracts 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,[1] 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, be safely 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 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

[1] See Story on Contracts: Void on Account of Immorality.

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 recent 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 and 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.

§ 371. **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, 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*.

§ 372. **Fraudulently obtained.** — Fraudulent means of any kind would vitiate any certificate of registry granted in consequence thereof; and that whether the false declarations had been made in the statement presented originally, by amendment, by testimony furnished, orally or in writing, or indeed in any manner. The registry is a contract between the United States and the grantee of the certificate; and fraud destroys any contract into which it enters. Any false entry prejudicial to the rights of another is also actionable; as, for example, a pretended or fraudulent assignment placed upon record. As to the assignee claiming title under such an assignment the trade-mark 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*,[1] 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." It must be observed that this section uses the word "action," which must be taken in its technical sense as employed throughout this statute, meaning the legal remedy only, the "action on the case" mentioned in section 79. It could not be said that the title had been *fraudulently obtained*, for the plaintiff certainly took all the interest that his assignor had had, and he was the sole proprietor of the trade-mark. Nor was that mark obnoxious to the objection that it had "been *formed* and *used* with the design of deceiving the public;" for, if it was a trade-mark at all, its inception was free from any such imputation. There is no doubt, therefore, that on the law side of the court such objections under similar circumstances would be untenable.

§ 373. It may safely be assumed that this section (84) is

[1] 4 Abb. Pr. R. 144; 13 How. Pr. R. 385.

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.[1] 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.[2] 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: 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 *primâ 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 only a case where a trade-mark has been registered by means of fraudulent representations. This, however, is but a cutting of the Gordian knot; for a trade-mark cannot be *fraudulently obtained* from the Patent Office of the United States, inasmuch as no power resides in the Office, nor in the United States, to grant a trade-mark. All that is done by the authority of the Act of Congress is to issue a certificate of registration. The act regulates: it does not create. These remarks are intended to provoke investigation into the purpose and intent of this legislative provision, rather than to attempt to ascertain and define.

§ 374. **Deceiving the Public,** as by acting a lie by means of a

[1] Eberman *v.* Reitzell, 1 Watts & Serg. 181. See also 18 Pick. 472.

[2] Forsythe *v.* State, 6 Ham. 21; Chitty on Contracts, 678, and cases there cited.

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;[1] or when a quack medicine is held forth as a panacea for an incongruous group of diseases;[2] or when a man by the use of his own name attempts to impose upon the public his goods as those of another;[3] or when he falsely represents an article to be protected by a patent;[4] 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.[5] Truth is the standard required. The court said, in *Matsell* v. *Flanagan*,[6] 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.[7] 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.[8] Hoffman, J., said: "It is

[1] Palmer *v.* Harris, 60 Penn. 156.
[2] Fowle *v.* Spear, 7 Penn. L. J. 176.
[3] Croft *v.* Day, 7 Beav. 84.
[4] The Leather Cloth Co. case, 11 Jur. (N.S.) 513.
[5] Partridge *v.* Menck, 1 How. App. Cases, 558.
[6] 2 Abb. Pr. R. (N.S.) 459.
[7] Curtis *v.* Bryan, 2 Daly, 212; 36 How. Pr. R. 33.
[8] Dale *v.* Smithson, 12 Abb. Pr. R. 237.

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." [1] 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 represent 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.[2] 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.

§ 375. 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 79, and endeavors to fathom the motives of applicants for registration. It is immaterial whether the intention of fraud actually exist in the mind of the applicant, if there is a reasonable probability that the public may be misled. Therefore, when an application was made

[1] Fetridge *v.* Merchant, 4 Abb. Pr. R. 156.
[2] Bloss *v.* Bloomer, 23 Barb. 604.

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. 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 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 *primâ facie* right to registry has been made out.

§ 376. **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 any thing 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 had 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.

§ 377. The decision in "The Blanchard Churn"[1] case gave an impetus to this way of thinking. The Examiner 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 only, 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 only, 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*, 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 is therefore reversed.

§ 378. 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

[1] Commissioner's Decisions, 1871, 97.

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.[1] 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 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.

§ 379. 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 been definitely set at rest. This virtually decides, if a decision upon so obvious a point seem 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*.

§ 380. In another appeal case,[2] 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.

[1] Commissioner's MS. Decisions, 1872.

[2] Dutcher Temple Co., Commissioner's Decisions, 1871, p. 248.

§ 381. 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 prohibited from receiving and recording any marks but those which would be valid at common law.[1]

§ 382. Having easily become persuaded that Congress did not think of *creating* a trade-mark (as is evident from the whole of the legislation upon the subject, and especially by the language of the seventh subdivision of section 77, which prescribes that the applicant shall make oath that he "*has a right to the use of the same*"), 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, or to be 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.

§ 383. 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,

[1] Sec. 79, Act of July 8, 1870.

but he does file "a description of the trade-mark itself, with fac-similes thereof," and he makes oath "that the description and fac-similes presented for record are true *copies* of the trade-mark sought to be protected."[1] 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 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.
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 that 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 guaranties 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

[1] Sec. 77, third and seventh subdivisions.

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.*,[1] 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*.[2]

§ 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,

[1] In chapter on Interferences.

[2] Interference, Sept. 1872.

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 injuriâ*. We do not lack analogies to confirm this conclusion. It is a familiar fact that, by the fiction of the English patent-law, he is deemed to be the first inventor who first brings an invention into the realm, and that, although he is not the inventor in any sense. He has, in legal contemplation, been the first to find or discover the thing (a pleasant euphemism applied to theft). 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. (This case was cited by a legal gentleman in a trade-mark discussion. It is believed not to have been reported in print, the point having been decided in other instances.) In a hearing before the Attorney-General (Sir R. P. Collier), Nov. 26, 1870,[1] the counsel for the patentee in such a case argued: (1.) The law does not require the communicator to be the inventor. (2.) The non-resident inventor has no legal rights of invention. (3.) The person to whom the invention is communicated is the legal inventor. The adverse counsel, who represented the real inventor (one Overend, of San Francisco, Cal.), said that he could not controvert the argument. The Attorney-General dismissed the opposition, with costs against Overend. — We

[1] Dunn's application, No. 2427, Int. Pat. Off. circ., Jan. 1871.

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 did occupy 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 Vespucius, 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.

CHAPTER VIII.

INFRINGEMENTS.

Colorable Infringements. — At Law, and in Equity. — Whole Trade-mark need not be imitated to constitute Piracy. — As a General Rule, one may affix his Name to Product. — Exceptions. — One's own Name may be used as an Accessory to Fraud. — When Trader debarred from using a Trade-mark originated by Himself. — Use of Name of Old Commercial House. — Perversion of Mark.

§ 385. **What deemed Infringement.** — To entitle a trader to relief against the illegal use of his trade-mark, it is not necessary that the imitation thereof should be so close as to deceive persons seeing the two marks side by side; but the degree of resemblance must be such, that ordinary purchasers, proceeding with ordinary caution, are likely to be misled. Lord Cranworth, Chancellor, held:[1] The actual physical resemblance of the two marks is not the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of the rival as the actual copy of his device.

§ 386. In many cases, it may be difficult to determine whether the complainant's trade-mark has been actually pirated in such a manner as to be likely to deceive and impose upon his customers or the patrons of his manufactures or business, and in cases of doubt the court should not grant

[1] Seixo *v.* Provezende, 12 Jur. (N.S.) part i. p. 215; 14 W. R. 357.

or retain an injunction until the cause shall have been heard upon the pleadings and proofs, or until the complainant shall have established his right by an action at law. But if the court sees that the complainant's trade-mark is simulated in such a manner as probably to deceive his customers, or the patrons of his trade or business, the piracy should be checked at once by injunction.[1]

§ 387. Now, although a court will hold any imitation colorable which requires a careful inspection to distinguish its marks and appearance from those of the manufacture imitated, it is certainly not bound to interfere when ordinary attention may enable a purchaser to discriminate. It does not suffice to show that persons incapable of reading the labels bearing the mark might be deceived by the resemblance. It must appear that the mass of ordinary purchasers paying that attention that such persons usually do in buying the article would probably be deceived.[2]

§ 388. In *Clark* v. *Clark*;[3] in the Supreme Court of New York, at a general term, 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," at the bottom. 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

[1] Chancellor, in Partridge *v.* Menck, 2 Barb. Ch. R. 101; 1 How. App. Cases, 558.

[2] Partridge *v.* Menck, 2 Sand. Ch. R. 622.

[3] 25 Barb. 76.

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 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 to their position; the place of their beginning and ending, and the stamp for the letters, being exactly alike, also, 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, *they* 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. **At Law**, the remedy for piracy of a trade-mark is by an action on the case in the nature of a writ of deceit. This remedy is founded upon fraud; and it seems that originally an action was given not only to the trader whose mark had been pirated, but also to the buyer in the market, if he had been induced by fraud to buy goods of an inferior quality.

§ 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.[1] He then takes up *Croft* v. *Day*,[2] and *Perry* v. *Truefitt*,[3] 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:[4] "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; s. c. 17 Law J. Rep. (N. S.) Chanc. 142, the eminent physician, Sir James Clark, applied for an 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

[1] 11 Jur. (N.S.) 513. [2] 7 Beav. 84. [3] 6 ibid. 56.
[4] 1 Hem. & M. 287; 32 L. J. R. (N.S.) Chan. 721.

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.*,[1] 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; second, 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*,[2] said that the origin of the favor shown to trade-marks was the protection of the public, and not merely the individual dealer. The first case containing this doctrine reported, on which all the others seemed to depend, is found in a note of Doddridge, J., to the case of *Southern* v. *How*,[3] and referred to by Lord Hardwicke, in *Blanchard* v. *Hill*,[4] 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*,[5] and enforced in *Sykes* v. *Sykes*,[6] and thoroughly sifted and defined in the elaborate and important case of *Crawshay* v. *Thompson*.[7] 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

[1] 35 Conn. 402.
[2] 7 Bos. 222.
[3] Popham, 143, and Cro. Jac. 471.
[4] 2 Atk. 484.
[5] 3 Doug. 393.
[6] 3 Barn. & C. 541.
[7] 4 Man. & Gr. 357.

law, an action will not lie without proof of an intent to deceive, and it is by no means clearly settled that courts of equity will interfere without some evidence of fraud. They 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.[1]

§ 396. In the case of *The Dixon Crucible Co.* v. *Guggenheim*,[2] the judge said substantially: The stove-polish of the plaintiffs is put up in small cubical blocks, — say two inches by an inch and a quarter, — and covered with a blue printed wrapper, containing in printed letters upon one side of the cube the words, "Dixon's Prepared Carburet of Iron, for polishing stoves, grates, ranges, and every kind of cast and sheet iron work." The next side of the cube contains a statement of the superior character of the article. The third has the printed announcement that it is "prepared from pure Carburet of Iron only by Joseph Dixon & Co., black-lead crucible manufacturers and practical chemists, Jersey City, N. J.," while the fourth side of the cube contains the directions for the use of the article. The ends of said cube have a yellow label with the following words and figures thereon, viz.: "STOVE POLISH. DIXON'S PREPARED Carburet of Iron. Price 10 cents." So much for the plaintiffs' article. That of the defendant is also put up in cubes of about the same size as that of the plaintiffs', — with a blue wrapper and yellow ends. Slight differences exist when the two are placed side by side, but to one not thoroughly familiar with both, the one could easily be mistaken for the other, so far as the shape and

[1] Corwin *v.* Daly, 7 Bos. 222.
[2] 3 Am. Law Times R. (St.) 288, and 2 Brewster, 321.

general appearance are concerned. On one side of the cube are the printed words: "J. C. Dixon's Prepared Carburet of Iron, for polishing ranges, stoves," &c. On the next side, the virtues or merits of the article are set out; on the third are the words: "Prepared from pure Carburet of Iron by J. C. Dixon;" and on the fourth side are the directions. The ends have a yellow label, on which are the words: "J. C. DIXON'S STOVE POLISH. Carburet of Iron. Price 10 cents." There are differences in the types and the lettering, and the virtues of the respective articles, and the directions for their use are not stated in precisely the same terms, but the general effect is very similar. The defendant has varied his label somewhat, and in some instances the words "pure plumbago" are substituted for the words "carburet of iron;" but the general appearance and effect are substantially the same. A number of affidavits were read, on both sides, as to the closeness of the alleged imitation. Those of the plaintiffs say that the defendant's article is purchased and used to a very large amount by persons who supposed that they were buying the plaintiffs' polish; while the defendant's affidavits allege that both the Joseph Dixon and the J. C. Dixon polish are known to the trade, and that the defendant never sells the one for the other. Further, that any one of common understanding can distinguish between them, and that persons are not likely to be misled. But upon this point the testimony of the defendant is merely negative. That of the plaintiffs is positive and strong. The public have been misled. It is true that the wholesale dealers may generally understand the difference between the two articles, and may not sell the J. C. Dixon for the Joseph Dixon; but the small retail dealers, scattered all over the world, do not so understand this distinction, and if they did, might not regard it. Much less would their customers — many of whom are ignorant people, sometimes domestics sent to the store by their employers — recognize any difference between them, or know whether they were buying

the Dixon stove-polish which has been celebrated for so many years, or the article manufactured and sold by the defendant. In this case, I have the articles before me, and can judge by inspection as to the resemblance. The result of such a test has left no doubt upon my mind that defendant's article is put up in a shape and with wrappers and labels to closely resemble those of the plaintiffs. And, when to all this we add the fact that defendant has taken the name "Dixon," by which plaintiffs' article is known, the resemblance is complete. True it is that they are not exactly alike. But the whole trade-mark need not be counterfeited. And the court will examine to see if the very differences are not colorable. . . . The mere probabilities of deception justify the remedy by injunction. . . . The defendant's article, in my opinion, is, as I have before stated, a close and palpable imitation of that of the plaintiffs'. The defendant has no person of the name of Dixon in his firm. He does not pretend to have any authority from any one to use that name. He gives us no account of the "J. C. Dixon" whose name he uses. If there is no value in the name, and the defendant does not mean to deceive, why does he use a name to which it is clear he has no right, and at the same time imitate so closely the wrappers and stamps of the plaintiffs? That he does so for the sole purpose of enjoying the benefit of the name and reputation of the plaintiffs' article, there can hardly be a reasonable doubt. . . . It is proper to add that Joseph Dixon & Co. have established their right to the use of this trade-mark in the courts of several States. . . . I am clear that the injunction should go out.

NOTE. — 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 used by such mechanic or manufacturer, on or in the sale of any goods, wares, or merchandise, with intent," &c., &c. Paxson, J., said in his opinion: "This act is very broad in its terms, and comprehends every thing 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.

§ 397. In *Lockwood* v. *Bostwick*,[1] 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 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

[1] 2 Daly, 521.

and recognizable by its distinctive trade-mark. In *Burnett* v. *Phalon*[1] 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. *Labrugnère*.[2] 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 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-

[1] 9 Bos. 192; 5 Abb. Pr. R. (N.S.) 212; and 3 Keyes, 594.
[2] Annales de la Prop., tome ix. p. 40.

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, &c. This pretence did not avail. The appellate court not only sustained the judgment, but, finding that it possessed the elements necessary for making a new and more just appreciation, it increased the damages given by the court below.

§ 398. In the Tribunal of Commerce of the Seine, in 1866 (*Bardou et al.* v. *Subalou et als.*[1]), 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 was 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. 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 guaranty that I enclose a paper superior to* JOB *by the addition of hygienic substances.*" The sale of this paper was

[1] Annales de la Prop., tome xiv. p. 140.

announced as well in Paris 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," &c., &c. 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 follows: — *As to the suppression of the name of* 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" (&c., 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 of JOB, and in indicating the superiority of his paper, had no other object than to destroy the reputation enjoyed for the paper sold under the title of 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 of 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 5,000 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 3,000 francs.[1]

[1] Annales de la Prop., tome xv. p. 115.

§ 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 (the supreme court of France), in 1867, — *Lagarde* v. *Piper*,[1] — *Held:* It is a fraudulent imitation of a mark, falling within the provisions of art. 8 of the Law of 23 June, 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. The piracy consisted in the imitation in part, with the design of profiting by the reputation belonging to another.

§ 401. In *Gillott* v. *Esterbrook*,[2] 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),[3] 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 an

[1] Annales de la Prop., tome xiii. p. 293.

[2] 47 Barb. 455.

[3] See §§ 225–233, *ante*; and also Glen & Hall Man'g Co. *v.* Hall, Albany Law Jour. vol. v. p. 109 (1872).

expert to distinguish them apart. That much they had a perfect right to do; and if they had gone no further 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 orna-

mentation 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. . . . It is no hardship upon the defendants to have them stand upon the merits of their own pen, unaided by the reputation of the plaintiff as a manufacturer, or by the merits of his pen. . . . The design to defraud may be as apparent, and is generally more injurious, in the partial than in the entire imitation. When the trade-mark is a conspicuous device, connected with the name of the true proprietor, of course the imitator would desire to avoid the offence of forgery, and would omit on his own article the name of the true proprietor, and substitute his own.

§ 402. In *Walton* v. *Crowley*,[1] 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

[1] 3 Blatch. C. C. 440.

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,[1] 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 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" underneath; 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' head. 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

[1] McCartney *v.* Garnhart, 45 Missouri (IV. Post's R.), 593.

that "the defendant's 'picks' resemble 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,[1] 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

[1] Seixo *v.* Provezende, 12 Jur. (N.S.) part i. p. 215.

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 Garnier, 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 Correctional of Grenoble, in 1857, came up one of the cases, — *Garnier* v. *Berthe*.[1] 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, dispositions 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

[1] Annales de la Prop., tome iv. p. 119.

he had penetrated by the aid of magnetism (!), wherefore he called his liquors and elixirs *liqueurs et élixirs 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 possessing the same virtues. 3d. That his marks, labels, &c., 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, &c. 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 500 francs, six months' imprisonment, and the publication of his villainy in eight public journals at Paris and other cities.

§ 408. In the Tribunal Corr. of the Seine, in 1868 (*Louis Garnier* v. *Paul Garnier*[1]), the same name as a symbol 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, "*Liqueur Hygiénique de la Chartreuse*," followed by the signature of *P. Garnier*. *Held*, 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

[1] Annales de la Prop., tome xiv. p. 252.

in the court of Grenoble, in 1852: *Garnier et al. Carthusians* v. *Rivoire*,[1] — 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 of *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 Isere and the Rhone; and they combined to prove the name *chartreuse* to be but generic. They signally failed, on appeal. 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* to a similar or analogous product of Grenoble, by others. The same doctrine was affirmed

[1] Annales de la Prop., tome iv. p. 115.

in 1868, in *Garnier* v. *Lindière et als.*[1] 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 determine the proportions, and the process of manufacture. As a sequence, 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 liquor was 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,[2] and the judgment of the tribunal was affirmed. The court *held*, that property in a denomination or a mark is acquired by the first 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.

[1] Annales de la Prop., tome xiv. p. 225. [2] Ibid., tome xvii. p. 241.

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,[1] 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;[2] 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.

§ 411. In *Edelsten* v. *Edelsten*,[3] 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 been generally known to the trade. 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*,[4] the plaintiff and the defendant were both large silk throwsters. The plaintiff was in the 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 following particular mark: "St. A*****,"

[1] Annales de la Prop., tome xvii. p. 257. [2] § 143, *ante*.
[3] 1 De G., J. & S. 185. [4] 1 Hemming & Miller, p. 259.

which represented *St. Alban's*, the place where the plaintiff's manufactory was, 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,[1] where the words "Conveyance Company," "the green omnibus," &c., 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*[2]), it appeared that the plaintiffs, the Brothers Carpentier, manufacturers of chocolate in Paris, have been in the practice of enclosing their products in envelopes bearing the fac-simile 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

[1] Knott *v.* Morgan, 2 Keen, 213.

[2] Annales de la Prop., tome xvii. p. 233.

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 have 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 being always 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 as follows upon the point of part-infringement: — PER CUR. 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 ensuring the benefit of the counterfeit, would guaranty 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 eyes 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 is reversed, with costs, &c.

§ 415. In the Tribunal of Commerce of the Seine, in 1868 (*Panckoucke* v. *Wittersheim*[1]), 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 "THE 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 to longer 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

[1] Annales de la Prop., tome xv. p. 5.

that it took for principal title the denomination of "*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," &c. 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: 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 Civ. of the Seine, in 1869, came up a case similar in principle to the foregoing.[1] 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

[1] Halbronn *v.* Malespine, Annales de la Prop., tome xv. p. 142.

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 300 francs damages and costs.

§ 417. In the Tribunal of Commerce of Lyons, in 1871 (*Millaud* v. *Marian et als.*[1]), 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

[1] Annales de la Prop., tome xvii. p. 101.

francs damages and costs. In the Tribunal of Commerce of Amiens, in 1871 (*Millaud* v. *Caron*[1]), 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 sub-title 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, 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*[2]), 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, 300 francs damages and costs.

§ 418. The following case cannot properly be classified with technical trade-marks, as the matter in dispute is the phraseology of a label; still it will serve some useful purpose as an illustration. It is *Ellis* v. *Zeilin & Company*,[3] in the Supreme Court of Georgia, in 1871. 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

[1] Annales de la Prop., tome xvii. p. 104. [2] Ibid.
[3] 42 Georgia, 91.

entered, under the copyright-law, in the District Court of the United States at Savannah."[1] They further allege that Ellis, the 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.

§ 419. The question which we are discussing is one of alleged infringement. For argument sake, we will concede that the combination of words used by Zeilin & Co. constitute 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 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

[1] This passage is worthy of attention and re-perusal, if only as a curiosity 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?

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.

§ 420. **A Manufacturer has a Right to affix his own Name** to an article of his product; and any injury which another manufacturer of the same surname may suffer thereby is *damnum absque injuriâ*. This is a general rule; and yet it has its limits and qualifications. We may truthfully say that a man may enjoy his property in a manner to please himself; and so he may, unless in the enjoyment of his rights he cause a legal injury to another's rights. *Sic utere tuo, ut alienum non lædas*, is the maxim which governs this right to the use of what is one's own. It must be so used as not to injure another, in a legal sense. The rule shall be made clear by the cases which follow.

§ 421. In *Faber* v. *Faber*,[1] 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 Schweinaw, both of 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, &c., used were not peculiar to the plaintiff, but were such as were generally employed by the manufacturers at Nuremberg.

[1] 49 Barb. 357, and 3 Abb. Pr. R. (n.s.) 115.

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 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 inclosures. 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 inclosing 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 inclosed or wrapped before the gross are put up in book-form, considering the explanations of the answer, &c., as to the universal use by pencil manufacturers of the words "Crayons Polygrades" and "Pour Dessiri, Architecture Bureau," &c., no complaint could be made of their use by the defendant Faber. Besides, these words, and the gilt parallelogram and ornamental work, device, or design surrounding them, and the maker's name, could not deceive or mislead any purchaser by the dozen packages or bundles. The motion to continue the injunction was accordingly dismissed.

§ 422. The following case of *Howe* v. *The Howe Machine Co.*,[1] at a general term of the Supreme Court of New York, in 1867, illustrates the same doctrine. The facts sufficiently appear in the extract from the opinion of Sutherland, J., that Elias Howe, Jr., in 1846, obtained a patent for a certain combination of mechanism called a sewing-machine; that his brother, the plaintiff, commenced manufacturing sewing-machines as early as 1854, and continued to manufacture them at least up to the time of the arrangement between him and Elias Howe, Jr., in 1862; and that the plaintiff in their manufacture used the combination of mechanism patented by Elias Howe, Jr., as his licensee, are undisputed facts. Elias Howe, Jr., did not license the plaintiff to make sewing-machines, but he licensed him to use his patented right or combination in the manufacture of sewing-machines. There is nothing in the case to show that the plaintiff manufactured the machines as agent for Elias Howe, Jr. The fact that he

[1] 50 Barb. 236.

was his licensee, and that he could not have manufactured the machines without his license, does not tend to show the agency. . . . The uncontradicted history of the claimed trade-mark is, that before 1857 the plaintiff placed on the machines letters and word "A. B. Howe;" that in 1857, Taylor, the plaintiff's mechanic, suggested the substitution of "Howe" for "A. B. Howe," which suggestion was adopted by the plaintiff, and subsequently every machine manufactured by the plaintiff had the word "Howe" in a conspicuous place on it. . . . The conclusion from the pleadings and affidavits is irresistible, that the word "Howe" was thus used to denote the plaintiff as the manufacturer, and not to denote Elias Howe, Jr., as the inventor. It is obvious that the fact that the plaintiff was the licensee of Elias Howe, Jr., and that the plaintiff could not have manufactured his machines without using the patented combination of his brother, and therefore could not have manufactured them without his brother's license, did not, and could not interfere with or impair his right to adopt and appropriate a trade-mark, to mark or distinguish the machines manufactured by him from those manufactured by other licensees of his brother. . . . It is equally clear that the plaintiff could adopt and appropriate the word "Howe" as a trade-mark as against Elias Howe, Jr. . . . The plaintiff had a right to adopt and appropriate his surname as a trade-mark, and it cannot be said that Elias Howe, Jr., though his surname was the same, had a right to use his own surname in such a way as to deceive the public, and deprive the plaintiff of the benefit of the notoriety and market which his machines had gained.—This enunciation of the law the judge based upon the cases of *Sykes* v. *Sykes*, and *Croft* v. *Day*, especially the conclusion of the opinion of the Master of the Rolls in the latter case. He further said, that the words, "The Howe Machine," are descriptive of the trade-mark "Howe," or "Howe, N. Y.," used on the plaintiff's machines.

§ 423. **Commentary.** — This case is apt to mislead the superficial observer; and even for a moment staggers the preconceived notions of one used to critical examination. It has been cited more than once in support of this absurd proposition, to wit: When two men in the same trade have the same surname, one may employ that surname as a trade-mark to the exclusion of any such right by the other. That is, when the two brothers Howe made and sold sewing-machines, the one who first stamped his surname upon a machine was the sole possessor of the right to stamp his workmanship with his true name. This conclusion has no warrant from any authoritative source. In fact, when we again scan the opinion of Mr. Justice Sutherland, we doubt his intention to convey any such fallacious idea as his language seems to import. The question before the court did not require any expression of opinion as to the abstract right of the plaintiff to the name, in the absence of fraud on the part of the defendants; and the good faith of the defendants is manifest from the unanimous decision of the court, denying the demand for an injunction. Leonard, P. J., said: "There is no fraud upon the plaintiff in use, by the defendants, of the name of 'Howe,' in designating a machine manufactured by them, which Elias Howe, Jr., had invented, and from whom the defendants derive their right to use the name." We might abandon further investigation into the occult utterance of the judge first quoted, if it were not for the impression made by his citation of the two English cases, in support of his proposition that "the plaintiff had a right to adopt and appropriate his surname as a trade-mark," &c. Let us turn to *Sykes* v. *Sykes*. What were the circumstances of that case? Two men of the same name and trade, one, the plaintiff, with an established business reputation and a patent; the other, the defendant, stamping his shot-belts and powder-flasks with the words "Sykes' Patent," and so falsely representing his goods as manufactured by the plaintiff. We see that there is no analogy between the Sykes case and that of

Howe. Now read *Croft* v. *Day*. A blacking manufactory had long been carried on under the firm of Day & Martin, at No. 97 High Holborn, London. The executors of the survivor continued the business under the same name. A person of the name of Day, having obtained the authority of one Martin to use his name, set up the same trade at No. 90½ Holborn Hill, and sold their blacking as of the manufacture of Day & Martin, 90½ Holborn Hill, in bottles and with labels having a general resemblance to those of the original firm. An injunction was granted to restrain the continuance of so palpable a fraud. The Master of the Rolls, an able judge (Lord Langdale), said that "in such cases there must be a great variety of circumstances; and the court must deal with each case according to the nature of its peculiar circumstances. The accusation which is made against this defendant is this: that he is selling goods, under forms and symbols of such a nature and character as will induce the public to believe that he is selling the goods which are manufactured at the manufactory which belonged to the testator in this case. . . . My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the name of Day & Martin, but upon the fact of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself, to which he is not, in fair and honest dealing, entitled. Such being my opinion, I must grant the injunction restraining the defendant from carrying on that deception. He has a right to carry on the business of a blacking manufacturer honestly and fairly; he has a right to the use of his own name: I will not do any thing to debar him from the use of that, or any other name calculated to benefit himself in an honest way; but I must prevent him from using it in such a way as to deceive and defraud the public, and obtain for himself, at the expense of the plaintiffs, an undue and improper advantage." The Howe case lacked

the ingredient of fraud, or false suggestion. Howe, the inventor of the mechanical combination, had given it a name: it was "The Howe Sewing Machine;" and no other designation would have been so appropriate. Whoever had a right to make and vend the article had an equal right to call it by its proper appellation. That being conceded, it necessarily follows that that portion of the syllabus of the case which reads thus: "That the plaintiff had a right to adopt and appropriate the word 'Howe,' as a trade-mark, as against Elias Howe, Jr.," is erroneous in the superlative degree. The *mere* name of the manufacturer cannot in any case become a technical trade-mark, notwithstanding numerous *dicta* to the contrary. The error on the part of the judge was to use the term "trade-mark" in a vague, indefinite sense. We set out with the idea of demonstrating that *Howe* v. *The Howe Machine Co.* is not a trade-mark case, and at its worst phase nothing more than a possible case of unfair competition. This has been done.

§ 424. The case of *Derringer* v. *Plate*,[1] in the Supreme Court of California, in 1865, seems at the first glance to hold that a man's name may at common law be used by him as a trade-mark. Let us see if the court did so decide. This was an appeal from a District Court. The plaintiff averred that he was a resident of Philadelphia, and upwards of thirty years ago invented a pistol, known as "Derringer's pistol," and adopted as a trade-mark for the same the words "DERRINGER, PHILADEL.," which was and ever since had been his trade-mark, and which he had caused to be stamped on the breech of all pistols manufactured and sold by him, and that the defendant, since 1858, had been engaged in the manufacture of pistols, at San Francisco, similar to the plaintiff's, on the breech of which he had stamped plaintiff's trade-mark, &c. Defendant had judgment on demurrer, and plaintiff appealed. The question raised by the respondent in support of the demurrer to the complaint was: That the statute of California in relation to trade-marks

[1] 29 Cal. 292.

had, in effect, repealed the common law; and that the appellant, in order to maintain his action, must show affirmatively that he had complied with the requirements of the act passed April 3, 1853. The answer was, That the statute does not take away the remedy at common law; that it is an affirmative statute, and that an action might be maintained both at common law and under the statute. The substance of the rule as laid down in the cases is, that where a party has a remedy at common law for a wrong, and a statute shall have been passed giving a further remedy without a negative of the common-law remedy, expressed or implied, he may, notwithstanding the statute, have his remedy at common law.[1] The Supreme Court, by Rhodes, J., said, *inter alia:* The only question presented on the appeal is, whether the statute of 1863, concerning trade-marks, repealed or abrogated the remedies afforded by the common law in trade-mark cases. The plaintiff does not allege a compliance with the provisions of the statute. He contends that the remedies given by the statute are cumulative to those which a party was entitled to at common law; and the defendant insists that the statute forms a "complete scheme" in respect to trade-marks, and thereby repeals the common-law rules relating to the same subject-matter. — When we read the case for ourselves, we indeed find that the judge was strictly correct in stating that question to be the only one on appeal. The court was not called upon to pass upon the validity of a name of a manufacturer as a common-law trade-mark; nor indeed was the mere name presented, for it was coupled with the word "PHILADEL.;" and even if nothing more than the name of Derringer had been relied on as a mark or emblem, that name may possibly have been stamped on in peculiar characters, as a copy of his autograph, which would have given it a distinctive individuality, and have imparted to it the

[1] Wheaton *v.* Hubbard, 20 Johns. 192; 13 id. 322; Almy *v.* Harris, 5 id. 175; Clark *v.* Brown, 18 Wend.

essential characteristics of the symbol of commerce. We here have the words of the court in awarding judgment: "We do not fully agree with counsel for either party in his construction of the Act, in respect to its relation to and effect upon the common-law remedies. The remedies provided by the Act (at least those applicable to registered trade-marks) are not cumulative to those possessed at common law, but in that respect provision is made by the Act for a new case: nor do we think the Act forms a 'complete scheme' of itself, in the sense that counsel regards it, as requiring all trade-marks to be registered under the Act to entitle them to protection; though it may be regarded as a 'complete scheme' in the respect that it grants certain remedies in cases of registered trade-marks, and expressly reserves to the owners in other cases the usual remedies enjoyed at common law. Judgment reversed, and the cause remanded, with directions to the court below to overrule the demurrer." We must look further, if we think it possible that any court has solemnly decided otherwise. We rest, therefore, on the proposition that one cannot use his *mere* name as a trade-mark.

§ 425. The remarks of Paxson, J., in the case of *Gillis* v. *Hall*,[1] seem to countenance the notion that a man may turn his surname into a trade-mark; but if we scrutinize the whole record we will come to an opposite conclusion. It was there alleged, and not denied, that the defendant Hall had commenced the manufacture and sale of an article which he designated as "R. P. Hall's Improved Preparation for the Hair," and that upon the wrapper of his bottles were printed these words: "R. P. Hall's Improved Preparation for Restoring the Hair. This preparation is entirely different from Hall's Vegetable Sicilian Hair Renewer, but is compounded by the same inventor, R. P. Hall." If we refer to another case by the same title,[2] we find that the plaintiff and the defendant had been

[1] Believed not to be reported except in Cox's American Trade-mark Cases, p. 596.

[2] 2 Brewster, 342.

partners in business, in making and selling a certain preparation called "Hall's Vegetable Sicilian Hair Renewer." On the 15th of June, 1865, in consideration of the sum of $30,000, the defendant Hall sold to the plaintiff all his, said Hall's, interest in the firm, in the secret of said preparation, the right to make and vend the same, and the exclusive right to use his name therefor in the future sales thereof. This agreement contained covenants as follows: 1. That he will not use, or allow his name to be used, in the preparation of any similar articles; 2. That he will not engage in the manufacture thereof; 3. That he will not impart to any one the secret or recipe for the manufacture thereof; 4. That he will not engage in the manufacture of any article similar to this; 5. That he will allow the plaintiff the free, uninterrupted, and exclusive use of his name in the manufacture and sale of said preparation, — and a stipulation to forfeit the said sum of $30,000, if he violated any of said covenants. Upon a violation of the said covenants, Gillis applied for an injunction. Hall denied the right of the plaintiff to equitable relief, for the reasons that those covenants were in restraint of trade, and therefore void. The objection, so far as it applied to a general restraint of trade, was held to be well-taken, as against the policy of the law. Said Paxson, J.: "He may manufacture and sell as many articles as he may desire for the preservation of the hair; but he may not manufacture, or sell, any of such articles as and for "Hall's Vegetable Sicilian Hair Renewer." The right to make and vend an article with that particular name and trade-mark he has parted with. He has bartered away his name, so far as the right to apply it to this preparation is concerned." Thus we observe what question was before the court. The defendant had broken his agreement, and had gone into unlawful competition with his former partner. Now, upon a rule to show cause why he should not be punished for contempt, in disregarding the order and decree of the court in the above-mentioned case of injunction, the judge said: "The said defendant has certainly mis-

apprehended the scope of that decree, as well as the meaning of the term 'trade-mark.' He may lawfully make any article known to commerce, which is unpatented, but he may not apply the trade-mark of the plaintiff to any such article. It is also to be observed that there is a wide distinction between covenants not to engage in trade and covenants to restrain the use of a trade-mark. The former may be void as being against the policy of the law, while the latter, not being obnoxious to any such objection, will be enforced. In this case, the defendant Hall has taken from the plaintiff's trade-mark that which gives it its chief value, viz., the name of 'Hall,' and placed it upon his own. The plaintiff's article is known as 'Hall's Vegetable Sicilian Hair Renewer.' Strike the name of 'Hall' therefrom, and its distinctive characteristic as a trade-mark is gone." The general conclusions of the judge are indisputably correct; and the only error therein consisted in the improper use of the term "trade-mark." In the definition of the term, we find that the manufacturer's own name is not an essential part of the mark, although frequently combined with the symbol that constitutes its essence. What was the real trade-mark? Certainly not the words in common use to designate the name of the article, the words "vegetable hair renewer." The word "Sicilian" is the only word that can stand the test as a fancy appellation, an arbitrary symbol; and *it* would be worthless for the purpose of the law if it were called into requisition to imply that the article of hair-preparation was really Sicilian, *i.e.*, made in Sicily. The case is simply thus: The defendant indirectly violated the plaintiff's trade-mark by using the symbol "Sicilian" in a covert manner, calculated to deceive the public and divert custom from his rival in trade; and all the language of his advertisement upon the bottles was calculated to create the impression that he sold the well-known article, or one superior to it. Doubtless substantial justice was done in every respect, except the incautious use of technical phraseology.

§ 426. *Curtis* v. *Bryan* [1] is a case where the defendant simulated the label of the plaintiffs, adopted a stamp similar to the plaintiffs', and fraudulently sold the article under the name of the original inventor, as Mrs. Winslow's Soothing Syrup. The plaintiffs' preparation had been in public use for nearly twenty-five years, and had an established and very valuable reputation. The name of Mrs. Winslow may be said to have lost its primary signification, and to have become a mere emblem, as in the case of the use of the historic name of "Roger Williams." [2] The equity was clearly with the plaintiffs, and the defendant had, by unfair and dishonorable practices, sought to avail himself of, and turn to his own account, the labor and the expense which the plaintiffs had borne for years to bring their article into favorable notice and general use. He would have the public believe that the article he was selling was the plaintiffs'. It mattered not, so far as the principles of justice were concerned, whether the name did constitute a fancy denomination or not; for the general statute of the State embraced all cases of the kind, — the imitation of labels, stamps, &c., — and the controversy before the court did not need any nice distinction in terms. We will continue the search.

§ 427. In *Jurgensen* v. *Alexander* [3] it appeared that for twenty years previously to the suit the plaintiff was a manufacturer and vendor of watches in Switzerland and Copenhagen. It was found by the courts that the trade-mark used by the plaintiff for the purpose of distinguishing and designating the watches manufactured by him was "JULES JURGENSEN, COPENHAGEN," and that said trade-mark was so used and employed by him on all such watches so manufactured, or sold, by him, being inscribed on the cap or inside back of each watch; and that in the faith and credit of the said mark, the watches were bought, sold, and dealt in, and had acquired a wide-spread reputation and extensive sale. It was also found that the defendant, a dealer

[1] 2 Daly, 212, and 36 How. Pr. R. 33.
[2] Barrows *v.* Knight, 6 R. I. 434.
[3] 24 How. Pr. R. 269.

in watches and other merchandise, had exposed for sale four watches purporting to be manufactured by the plaintiff, and bearing the mark "Jules Jurgensen, Copenhagen," which mark thereon was false, simulated, and spurious. We are not told whether the said words were inscribed in any peculiar manner, or in any uncommon characters. It was a clear case of fraud, whether those words constituted a common-law trade-mark or not. That case therefore does not assist in the elucidation of the point under consideration. Nor does that of *Byass* v. *Sullivan*,[1] where the plaintiff averred that the defendants unlawfully copied and used his trade-mark or label on bottled porter, viz.: "Best Stout Porter, from R. B. Byass, London," with a *fac-simile* of his *signature* underwritten; for that copy of a signature itself was a good trade-mark. In *Clark* v. *Clark*,[2] it was held that a party will not be restrained by injunction from using his own name, unless the use by him be accompanied by circumstances indicating an intention to mislead the public. In *Ames* v. *King*,[3] the answer denied that the plaintiffs had the sole right to use the word "Ames" upon shovels, and denied that the defendants ever stamped or marked any shovels with the name "Ames" with intent to imitate the plaintiffs' shovels or their mark, or to represent the same to be the manufacture of the plaintiffs, or to injure, defraud, or deceive the public or the plaintiffs; but admitted that he had stamped two hundred dozen shovels for a dealer whose name was Edward B. Ames, and at his request had stamped the same "Ames," but not "O. Ames," and solely to denote that they were sold, or kept for sale, by Edward B. Ames. This alleged infringement was brought before the court under the Massachusetts statute of 1852, entitled "An Act further to protect trade-marks." That statute conferred upon the court the power to restrain by injunction the fraudulent use of trade-marks, and *other similar devices*, employed

[1] 21 How. Pr. R. 50.
[2] 25 Barb. 76.
[3] 2 Gray, 379.

"for the purpose of falsely representing any article to be manufactured by" a person or firm who did not in fact make it. In the case at bar, the bill stated a case clearly within the statute above cited. But the essential averments in the bill, of a fraudulent use of the plaintiffs' name by the defendant, for the purpose of falsely representing articles to have been made by them which were in fact manufactured by the defendant, are particularly and fully traversed by the answer. Bill dismissed. This not being a case falling within the principles of the common law, but resting upon a local statute, cannot avail us in our present investigation.

§ 428. *Rodgers* v. *Nowill*[1] is frequently misquoted. The facts of that case are short and simple. The defendants, manufacturers of cutlery at Sheffield, received an order from the Messrs. Lord & Son for a quantity of pen-knives and pocket-knives, to be stamped or marked with the letters V. R., with a crown between them, and the words "J. Rodgers & Sons, Sheffield," underneath. They accordingly made and marked the knives as ordered. The knives, when made, were, it is said, received by the defendants, accompanied by a bill of parcels describing them as purchased from John Rodgers & Sons. The plaintiffs brought their action; and, having proved the order for knives so marked as to resemble and pass for their manufacture, and its execution by the defendants in the manner stated, the case went to the jury. It was found that the defendants had adopted the plaintiffs' mark. We perceive that the infringement covered the whole of the mark, and not alone the names of the plaintiffs.

§ 429. The case of *Morison* v. *Salmon*,[2] in the Court of Common Pleas, in England, in 1841, appears at the first glance to throw light upon this question, but, in reality, it does not. The declaration, after stating that the plaintiffs prepared, and sold, for profit, a certain medicine called "*Morison's Universal Medi-*

[1] 5 Man., Gr. & Sc. 109; 11 Jur. 1039; 17 L. J., C. P. 52.
[2] 2 Scott, N. R. 449; 2 Man. & G. 385.

cine," which they were accustomed to sell in boxes wrapped up in paper, which had those words printed thereon, alleged that the defendant, intending to injure the plaintiffs in the sale of their said medicines, deceitfully and fraudulently prepared medicines in imitation of the medicines so prepared by the plaintiffs, and wrapped up the same in paper, with the words "*Morison's Universal Medicine*" printed thereon, in order to denote that such medicine was the genuine medicine prepared and sold by the plaintiffs, &c. *Held*, on a motion to arrest the judgment, that the declaration disclosed a sufficient cause of action. Looking at this as a trade-mark case, where do we locate the essence of the commercial symbol? It does not reside in the generic term "medicine," for that is common property, free to all who use the language; nor is it in the name of the plaintiffs, for any one else bearing the same surname had the same right to stamp it upon the same unpatented articles of merchandise. How could we hesitate to fix upon the word "universal" as the talisman! That word is used here as an arbitrary symbol, or fancy denomination. It does not pretend to intimate that the medicine to which it is affixed is *universal;* for then it would be obnoxious to the charge of quackery, and even though it might not deceive the most credulous, it would meet the fate of the marks in *Heath* v. *Wright* [1] and *Fowle* v. *Spear*.[2]

§ 430. In *Holloway* v. *Holloway*,[3] in the Rolls Court in England, in 1850, the plaintiff, Thomas Holloway, complained that his brother, the defendant, Henry Holloway, had commenced selling pills and ointment at 210 Strand, under the description of "H. Holloway's Pills and Ointment." The pill-boxes and pots were similar in form to, and the labels and wrappers were copied from those used by the plaintiff, whose place of business was at 244 Strand. The plaintiff prayed an injunction to restrain the defendant from selling any pills or ointment

[1] 3 Wall. Jr. 141.
[2] 7 Penn. L. J. 176.
[3] 13 Beav. 209.

described as, or purporting to be, "Holloway's Ointment," or "H. Holloway's Pills," or "H. Holloway's Ointment," in boxes or pots having labels so contrived or expressed, as by colorable imitation or otherwise to represent the pills or ointment sold by the defendant to be the same pills or ointment as were sold by the plaintiff.

§ 431. THE MASTER OF THE ROLLS (without hearing a reply). "This case, upon the evidence before me, is perfectly clear. The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment; and I do not intend to say any thing tending to abridge any such right. But he has no right to do so with such additions to his own name as to deceive the public, and make them believe that he is selling the plaintiff's pills and ointment."

§ 432. In *Burgess* v. *Burgess*,[1] in the English High Court of Chancery, in 1853, it appeared that, for upward of forty years prior to 1800, John Burgess, the father of William R. Burgess, the plaintiff, carried on business on his own account as an Italian warehouseman at No. 107 Strand, London. In 1800, the plaintiff was taken into partnership by his father, and from that time until 1820, when the father died, they continued the partnership business under the style or firm of "*John Burgess & Son*." The son, as sole executor and residuary-legatee, succeeded to the business, and continued it on his own account, but under the same style of "*John Burgess & Son*," and on the same premises at No. 107 Strand. Amongst the articles in which the firm originally, and afterward the plaintiff, had been in the habit of dealing, was a fish-sauce called "Essence of Anchovies," which had been originally manufactured by John Burgess, the father of the plaintiff, about forty years prior to 1800, and ever since sold by the firm under the name of "*Burgess' Essence of Anchovies*." The defendant, William Harding Burgess, the son of the plaintiff, after being for many years employed, at a salary, by his father

[1] 17 Jur. 292; 22 L. J. Chanc. 675.

in his business at the said place, upon the occasion of a disagreement left his father's service, and commenced trading on his own account, at No. 36 King William Street, same city. He caused to be placed over his shop-front the words, "W. H. BURGESS, *late of* 107 *Strand*," and on each side of the door of his shop fixed a metal-plate, with the words, "*Burgess' Fish-Sauce Warehouse, late of* 107 *Strand*." The bill complained also that the defendant was selling a fish-sauce purporting to be "*Burgess' Essence of Anchovies*," but at a lower price than that of the article sold by the plaintiff under the same description or title, and that such sauce was offered for sale by the defendant in bottles similar in size and shape to the bottles used by the plaintiff, accompanied with labels, wrappers, and catalogues bearing a general resemblance to those used by the plaintiff in the sale of his essence of anchovies; and in particular, that upon such labels, wrappers, and catalogues he used the title "*Burgess' Essence of Anchovies*," under which the article sold by the plaintiff was well known, and had long enjoyed a great celebrity in the market. It was alleged also that the said words had been used by the defendant with the fraudulent object of deceiving the public, and leading purchasers to believe that they were purchasing the plaintiff's article. Vice-Chancellor Kindersley ordered an injunction restraining the defendant from using the words "late of 107 Strand," and "Burgess' Fish-Sauce Warehouse, late of 107 Strand," but refused to restrain him from using the words "Burgess' Essence of Anchovies." The decision of the Vice-Chancellor was affirmed on appeal.

§ 433. This is so manifestly an instance of unfair competition in trade, and not a trade-mark case, that remark were supererogatory, unless to cite it as an additional illustration of the doctrine that a man's name cannot be transmuted into a technical trade-mark.

§ 434. In the Court of Paris, in 1863 (*Massez* v. *Joly*[1]),

[1] Annales de la Prop., tome x. p. 318; 11 Beav. 112; 11 Jur. (N.S.) 513.

the plaintiff, a shoemaker, had for a mark the name of "JOLY," surrounded by an oval. The defendant, Joly, used his own name in the same manner and with the same object. The court ordered that the defendant should modify his mark, either by joining his Christian name, or by omitting the oval form, so as to prevent a confusion in the mind of the public. The oval constituted the essence of the symbol. In the Leather Co. case, in the House of Lords, in 1865, both parties made conspicuous use of the surname "Crockett," being that of the inventors of a certain process, and yet the court did not entertain the notion that that name could be an essential part of a trade-mark. Nor does the following case sustain any such idea, although sometimes cited in support thereof.

§ 435. The complainant, Samuel Stonebraker,[1] being engaged in the manufacture of certain medicines and other preparations, adopted and used certain labels to distinguish his preparations from all others. These labels became generally known to the trade and consumers, so that by them the preparations were recognized, distinguished, and bought. The manufacture and sale became a source of profit and emolument to the complainant. Certain persons thereupon fraudulently engaged in the manufacture and sale of medicine and preparations, which they sold, bearing a similar label with only a colorable difference. Two of the defendants had employed in business another, a brother of the complainant, for no other reason than that his name was Stonebraker, and because they believed that by employing a person of that name they could with impunity consummate their intended frauds against the complainant and the public. Pinkney, J., who heard the case, said, that the evidence showed beyond all doubt that the agreement between the parties was but a combination to deceive the public, and to enable the parties to it to obtain for their medicines the benefit of the celebrity which those of the complainant had in the market, at the expense of the com-

[1] Stonebraker *v.* Stonebraker, 33 Maryland, 252.

plaintant, and in fraud of his rights. The defendant who had thus loaned his name was himself a medical man, and had a right to compound and vend medicines. His offence was in selling his medicines as those of his brother. The defendants copied the names given by the complainant to his medicines; and on their wrappers and labels the language that he had on his; and, as if to leave no doubt of their fraudulent intent, printed on the wrappers of some of their medicines and preparations the certificates given to the complainant, in recommendation of his medicines, &c., &c. This design became a perfect success, so that experienced druggists were deceived.

§ 436. The Circuit Court passed a decree perpetually enjoining and restraining defendant Stonebraker and his partners, their agents, and all persons claiming under them, from manufacturing or imitating any of the medicines, &c., which had been known as "Stonebraker's Medicines or Preparations," and from counterfeiting the labels, marks, &c. The Court of Appeals of Maryland affirmed the decree.

§ 437. A trader is sometimes debarred from using a trade-mark originated by himself; for by his own direct act, or by operation of law, the title to its use may have been alienated from him. In substance, there is no distinction between the sale of a business and good-will by a trader himself, and a sale by his assignees in bankruptcy. Therefore, on a sale by such assignees, the trader has no right, upon setting up a fresh business, after his discharge, to use the trade-mark of his old business, or in any other way to represent himself as carrying on the identical business which was sold; although he has a right to set up again in business of the same kind next door to his old place of business.[1] The principle of this ruling of Vice-Chancellor James is plain. A trade-mark is frequently an indication of place, and purchasers look rather to the locality than the person. If certain goods are associated with the shop bearing the sign of the Crescent, or the Elephant, or any other

[1] Hudson *v.* Osborne, 39 L. J., Chanc. 79.

fanciful emblem, and go forth to the public bearing the stamp of the Crescent, &c., then it is clearly an infringement for any one else in the same line to use the mark. But if the mark be so personal in its character that it is identified with the person, and import that the goods bearing it are manufactured by him, then the rule would be different; for the law will not lend itself to the perpetration of a fraud.[1]

§ 438. The employment by a firm of a name identical with that of an old commercial house is not illicit in itself, and the suppression of the name will not be decreed. But when to the use of this name are added abusive manœuvres, having for an object to deceive consumers, then it becomes necessary to order that modifications be made in marks and tickets, with the first name of the junior party, and sometimes the date of the formation of the new house. In the case of *Louis Rœderer & Co.* v. *Théophile Rœderer*,[2] in the Court of Paris, in 1865, the plaintiffs, the well-known vintners of Rheims, complained of the defendant's use of the surname of the head of their house to their prejudice. The plaintiffs had adopted a mark called *Carte Blanche* for their finest champagne-wines. The Tribunal of Commerce of Rheims found for the plaintiffs, and directed that on the labels, corks, brands, tickets, &c., to be used by the defendant's firm, the word *Théophile* should be placed in letters of the same size, shape, &c., as the name *Rœderer*. The plaintiffs, thinking the remedy insufficient, appealed, and produced before the appellate court prospectuses which, both before and after the judgment of the court of first instance, had been circulated not only in France, but also in Belgium and in England. The following shows the contents of said prospectuses: "*Grand vin de Champagne mousseux.* T. RŒDERER & CO., OF RHEIMS, CARTE BLANCHE, *qualité unique*, francs: 5. Merchants and consumers are requested not to confound this wine with that *of a similar house at Rheims, and to sus-*

[1] See Bury *v.* Bedford, 10 Jur. (N.S.) 503.
[2] Annales de la Prop., tome xi. p. 58.

pect fraudulent imitations. Corresponding depository in Belgium: A. Vernaelde, wine merchant, 29 Ommeganech Street, Antwerp."

"LONDON, October 13, 1864.

"GENTLEMEN, — *In remitting herein enclosed the circular of the* Messrs. TH. RŒDERER & COMPANY, *of Rheims*, who give us the title of sole agents for the sale of their CELEBRATED CHAMPAGNE-WINE, we request you to forward to us your orders.

"The mark 'Carte Blanche' of Th. R. & Co. is so well known that there is no need for us to recommend it to you," &c.

PER CUR.: As to the principal demand tending to the prohibition of the use by the defendants in their firm name, their marks and labels, of the name of *Rœderer*: — Considering that Théophile Rœderer, having formed with the brothers Bousigue (called Bley) an association under a collective name for the sale of sparkling champagne-wines, had a right to dispose of his name for the profit of the partnership, they consequently had a right to use it, as well in the firm title as in their marks, labels, and advertisements, beyond the reach of power to suppress the same, especially as against Rœderer himself, if he has created the house on his own account. As touching the subsidiary conclusions, directing that the name of Théophile Rœderer take precedence in the firm or title, marks, and labels: — Considering that an association under a collective title may borrow from among themselves that name of any one most suitable for their title, marks, and labels, they are not, however, at liberty to take a sign tending to divert to their own profit the good-will of an old house bearing the same name, one already made popular in the same trade; that this good-will should be the result of a free and legitimate competition and not of illicit actions, and that it is an illicit action to cause a coincidence of mercantile names to deceive the consumer: — Considering that the judges of the first instance have found as a fact that Théophile Rœderer's firm has established and organized for the purpose of appropriating, by means of the

name it bears, the favor enjoyed by the house of Louis Roederer: that, in fact, the antecedents of Théophile Roederer — a stranger in the city of Rheims, and to the commerce of champagne-wines — justify the conclusion that the part he plays in the partnership is solely to lend his name to imitate the labels and vignettes of Louis Roederer, the borrowing of the special designation of "Carte Blanche," the resemblance of the sealing-wax for the bottles, the similarity of marks upon the corks, and the announcements, scattered even through Belgium and England, in which the agents of the new concern felicitate themselves upon having received the agency for the celebrated champagne-wine, recommending not to confound it with another house of the same name, and retaining but the initial of the name Théophile to make more conspicuous the name of Roederer: all reveal and characterize an unlawful competition: — Considering that to remedy this abuse the judges below should not have limited themselves simply to direct that the marks, labels, and announcements of this new house should for the future bear the prenomen of Théophile written in full, and in characters of the same dimension as those of the surname Roederer; that that would be an incomplete and inefficacious remedy against confounding in commerce the name of the new house with that of the old, but that the same can be accomplished by diversifying them by exterior signs, without the necessity of modifying the firm title, — Théophile Roederer & Co.; that it will suffice for the future to direct that the defendants shall be bound to insert in their marks, labels, announcements, circulars, and bills, the mention following: "House founded in 1864," and to inscribe it thereon in characters of the same size, and of the same form as those of the name and prenomen of Théophile Roederer: For these reasons, the judgment appealed from is modified, in that it orders only that the marks, labels, announcements, and bills of the house of Théophile Roederer & Company shall bear for the future the prenomen Théophile in form and dimension the same as

those of the surname. . . . Ordered, that the defendants shall in future insert in their advertisements, bills, and prospectuses, as well as on their marks, labels, and corks, 1st, the prenomen of Théophile; 2d, the mention following: "House founded in 1864;" — Ordered, that said mention shall appear in characters of the same dimension and form as those of the surname Rederer; — Ordered, that the present judgment shall be inserted by extract containing the names and qualities of the parties, the reasons and disposition made, in the newspapers of the department of the Marne, in three newspapers of Paris, and in four foreign newspapers selected by the plaintiffs and at the expense of the defendants, &c.

§ 439. An Englishman established in Paris the sale of a certain manufacture from farina for food, to which he gave the name "ERVALENTA-WARTON," compounded from a word of fancy and his surname. Whatever may have been the intrinsic merit of this farina, through dint of advertising it had obtained in France as well as in England a grand success. Influenced by the renown gained by Warton for his product, another Englishman, named Klug, commenced the sale of a somewhat similar article of food, which he decorated with the name of "REVALENTA ARABICA." For a long time the competitors in business carried on business side-by-side without a legal contest; but eventually Warton died, and his widow succeeding to his affairs brought an action against Klug for usurpation of the denomination which had been adopted by her husband as a trade-mark. The Court of Paris affirmed the judgment of the court below, which had found the defendant guilty of infringement, in using the thinly-veiled expedient of slightly modifying the name of the thing.[1]

§ 440. It is a counterfeiting of a trade-mark to affix the symbol to a box or envelope, although the goods themselves, enclosed therein, do not bear the same mark as the genuine. Thus, where a manufacturer of gilt-headed nails had a star for his

[1] Warton *v.* Klug, Annales de la Prop., tome i. p. 40.

mark, which mark he impressed upon the boxes containing his products and his invoices, as well as on the goods; and another person placed the same mark on the outside of his boxes, but not upon the goods, it was held to be infringement. Such was the decision of the Court of Paris in 1872, in *Garmoy* v. *Samson*,[1] on appeal from a judgment of the Tribunal Civil of the Seine. The lower court had held that a five-pointed star, such as the plaintiff had adopted and the defendant had imitated, is a sign commonly employed in other branches of industry, and when isolated from all other distinctive characters is not susceptible of private appropriation. The defendant, therefore, had not encroached upon an exclusive right, especially as he had not actually stamped the merchandise itself. Judgment was rendered for the defendant, with costs. The appellate court not only regarded the star sufficient as a trade-mark, but found the defendant guilty of counterfeiting, by the external use thereof. His object was to deceive the purchaser, and he did it as effectually as if the star had been impressed upon each nail.

§ 441. As to who is the actual counterfeiter of a trade-mark, the Court of Cassation of Belgium, in 1865 (*Gilbert & Co.* v. *Benedictus*[2]), said: Inasmuch as the prohibition to counterfeit trade-marks has for its object the preservation from outrage of industrial property, it follows therefrom, 1. That the counterfeiter is not the agent who materially executes the simulated work, but he who causes it to be done with an intent to fraudulently traffic in counterfeited objects; 2. That the wrong is consummated at the place where the counterfeiter carries on the illicit traffic, although the act may have had its inception in a foreign country.

§ 442. As to the question of infringement by the use of numerals, we have a decision made at a general term of the Supreme Court of New York, in 1872.[3] It was there *held*:

[1] Annales de la Prop., tome xvii. p. 231. [2] Ibid., tome xii. p. 427.
[3] Glen and Hall Manuf. Co. *v.* Hall, Albany Law Jour., vol. v. p. 109.

That the use of a street number, or of a building in a street, for part of a person's trade-mark, where other persons have the same right to manufacture the same article in the same street, or at the same number or building, cannot be made exclusive, or the use by another be restrained by injunction. But where a person has the exclusive use of a street number or building, he may very properly use it as a part of his trade-mark.

§ 443. **Perversion of Mark.** — A genuine mark may virtually become a counterfeit by misapplication or transfer. Thus if a trader sell goods with his mark thereto attached as an evidence of genuineness, and the purchaser adulterate the goods, or use the same envelope for the purpose of selling a false article, he is a counterfeiter. So when one having a right to use a genuine mark upon paper bags for seeds, placed therein seeds of an inferior quality, he was guilty in the eye of the law of fraud, just as much as if he transferred a genuine signature from one paper to another.[1] This point may be considered as settled.

§ 444. This question was discussed in the *Corps Législatif* of France, when the bill that crystallized into the trade-mark law of 1857 was under consideration. One honorable member (M. Legrand) said that certain products exist on which by reason of their nature the trade-mark could not be immediately applied. These products are placed in an envelope on which is put the mark of the manufacturer; and the products find a sale more or less easy, according to the degree of credit that particular mark has in the market. He mentioned frauds of frequent occurrence, where certain vendors had made themselves the intermediaries between the manufacturer and the consumer. They address their attentions to the manufacturers the most renowned. In the beginning, to establish confidence, they render to their principals such as they have received; but soon afterwards, when the valuable products have become associated with certain marks, they open the packets and substitute an inferior kind of goods.[2]

[1] Bloss *v.* Bloomer, 23 Barb. 604.

[2] *Moniteur*, May 14, 1857.

§ 445. M. Levavasseur, in the same debate, said that in nearly all the cities where textile fabrics are made, and notably so in Rouen, there exist commission-merchants who buy to sell, generally under a form different from that the manufacturer has given; thus, they divide the stuffs in pieces, to make them assume new guises suited to the convenience of those to whom the merchandise is sent. These textile fabrics receive at the dressers an entirely new form, and the commission-merchant, to assure the sale thereon, places his mark, known only to his principals. It is in this manner that are dressed, exported, and sold the greater part of the stuffs of Rouen sold in America.

§ 446. In *Gillott* v. *Kettle*,[1] at a general term of the Superior Court of the city of New York, the fraud complained of consisted in selling an inferior article of the plaintiff's manufacture as being one of a superior quality. The case came up on appeal from an order enjoining the defendant, as hereinafter stated. The papers on which the injunction was granted showed that the plaintiff had for a long time been extensively engaged in the manufacture of steel-pens, at Birmingham, in England; that the pens made by him were well-known as such in the market, and were extensively sold, as well in the United States as in England; that large quantities of them were sold in boxes containing one gross each; that each box was labelled in a manner and with a label having devices upon it, which indicated that the plaintiff was the manufacturer of the pens, and in consequence of which they were bought and sold in the market, as pens made by him; and that the labels had numbers or marks[2] impressed on them which indicated, and which were recognized by dealers as indicating, an actual difference in the quality of the pens. The pens in boxes numbered 303 were bought and sold as being extra fine-pointed, and were in fact so. The pens in

[1] 3 Duer, 624.

[2] As to the numbers being trade-marks, see Gillott v. Esterbrook, 47 Barb. 455.

boxes numbered 753 were of an inferior quality, and were bought and sold as such, the number being understood by dealers to denote their inferior quality. The former were sold by the plaintiff at about seventy-five cents, and the latter at about eighteen cents a gross. From the boxes containing the plaintiff's label or trade-marks, and bearing the number 753, the defendant was in the habit of removing the plaintiff's label, and putting on in place thereof labels which he made or caused to be made closely imitating the genuine labels of the plaintiff, which bear the number 303. This act was productive of great injury to the plaintiff, by destroying public confidence in his honesty, and bringing the pens made by him into discredit, by reason of his inferior pens being disposed of as being his best pens.

§ 447. This case differs from those in which a manufacturer seeks to restrain others from placing upon articles made by themselves his trade-mark, by which goods of his own manufacture are known to be his, and are recognized as such in the market. Here the defendant has not attempted to sell an article made by himself, by fraudulently creating the impression that it was made by the plaintiff; but he has attempted to sell an inferior article — made by the plaintiff to be sold as an inferior one of his own manufacture — by using a label indicating a superior article. The fraud, so far as successful, is twofold. The public is defrauded, by being induced to buy the inferior for the superior article. The plaintiff is defrauded, by an unjust destruction of confidence that his pens are put up for sale and assorted with reference to the quality, indicated by the labels. Unless the fraud were checked by the intervention of a court of equity, the damage to the owner of the mark might be irreparable. The remedy by injunction is invariably granted when the nature of the injury is such that a preventive remedy is indispensable and should be permanent. Order affirmed, with costs.

§ 448. The following curious case was submitted to the

writer, for his opinion as counsel. C. J. M., a wine and liquor merchant in the city of New York, was threatened with a prosecution for imitating the trade-mark of Bass & Co., of England, upon ale and porter. "Then you do not sell a genuine article?" "Oh yes, we sell the very ale and porter that we purchased from the manufacturers themselves." "Then the labels are imitated by you; that is, false labels are used upon genuine goods?" "Not at all, for the labels also are genuine. The whole story is this: we bought the ales and porter at wholesale for the understood purpose of retailing in England; and also obtained from the agent of the firm of Bass & Co. a supply of their labels containing their trade-marks. Instead of selling in England, we chose to bring the ale and porter to this country, and by retailing here we reap the profits that the manufacturers expected to enure to themselves. *Query:* Have we made ourselves liable in an action for damages, or can we be enjoined?" The reply was that in the absence of any agreement, it could not be perceived how either an action at law or suit in equity could be maintained. It seemed like a naked question of morality and mercantile faith. It was nothing but a trick in trade. A bill in equity could not well be sustained under such a state of facts. The foreign firm may protect itself in the future by selling only to known confidential retailers. Legal remedy there is none.

§ 449. From an examination of the foregoing illustrations, we cannot have failed to gain a general idea of the correct theory of infringements. We observe that encroachments upon trade-mark rights have usually less of the characteristics of downright robbery than of mean, dissembling knavery. The craft of the fox is evinced more frequently than the boldness of the lion. The highwayman becomes respectable and dignified, in comparison with the trader who, by evasion or circumvention, would despoil a competitor of his just reputation. The colorable infringer is more apt to be visited with rigorous justice than is the trespasser who shows himself in the light of

day. The attempt to cover and conceal his tracks is evidence of intentional wrong. Two traders may take the same symbol, each in ignorance that the other uses it, or with an honest doubt as to which has the legal right therein. The conflict of claims may be the result of a difference of opinion as to the alleged imitation. At the first glance, it is not always easy to say what amounts to imitation. In the chapter on Interferences, hereafter, may be seen a remarkable instance of two things entirely unlike in appearance being adjudged to be alike in effect.[1] In that case, it was conceded by the able counsel on both sides, and found by the Patent Office, that the picture of a bouquet with elaborate ornamentation, and the simple word "Bouquet," interfered with each other, when used upon the same class of goods. If vision were the sole guide, the lack of physical resemblance would have decided that no interference existed. One delineation could not possibly be mistaken for the other. Here is the test: Would the use by different houses of the two things cause confusion? The ear is the medium to mislead a purchaser. He might ask this question, — "Have you the *Bouquet* ham?" and either of the traders could truthfully reply in the affirmative. The picture and the word could not lawfully coëxist as marks for rivals dealing in the same class of merchandise. The matter then resolves itself into a question of priority of adoption. We see how one may press closely upon the rights of another without the least thought of fraud; and yet be adjudged to be a wrongdoer.

§ 450. Again, the same symbol may be used by two persons having no interests in common, and still furnish no ground for legal conflict. We have heretofore seen that there is no property in an abstract symbol. It must be a mark upon a vendible commodity to entitle it to judicial attention. It does not signify if the emblem used by the different parties be exactly alike, — in fact, be printed from the same plate or impressed by

[1] Schrauder *v.* Beresford & Co.

the same brand, — unless it also be affixed to similar goods. Now arises a point of considerable difficulty. How shall we define the term *class*? A class is an order or division of objects, grouped together on account of their common characteristics. We must narrow the limitation, when applying the word to our present purpose. This point has already been discussed in this treatise, and some examples given of the construction of the word *class*. Cutting instruments may be classified generally as cutlery; and yet a chopping-axe, a pocket-knife, and a scythe be said to belong to three distinct classes. Wine, brandy, whiskey, gin, are all alcoholic liquors: but we see that the Patent Office has held that they do not come in the same class.[1] We read the decision in the case of the *Amoskeag Manufacturing Co.* v. *Garner*,[2] and learn, if we did not know it before, that *plain* cotton cloths and *printed* cotton cloths belong to different classes. Some latitude must be allowed in determining to what class an article should be assigned. If a manufacturer adopt a mark for a razor, and use it upon nothing else, can he subsequently claim that he had obtained the exclusive right to its use upon all sharp instruments of steel? Or if he adopt a mark for alcohol, does he thereby exclude every other manufacturer or trader from the use of the same symbol for whiskey or gin? Certainly not. The classification of commerce must be consulted. The *experimentum crucis* is this: What does a buyer ask for? An experienced tippler may say that he is at times unable to distinguish old whiskey from brandy, so much are they alike in taste, and that that circumstance is a good reason why the halo of a trade-mark for one article should be considered broad enough to embrace the other. That is a question of evidence rather than one of classifying. If the purchaser asks for brandy, he does not wish for whiskey. What does he believe he is getting? If he is misdirected by a symbol, the proprietor whose mark has been pirated loses a customer; and for the

[1] §§ 66–70, *ante*.

[2] 59 Barb. 151.

wrong so done him is entitled to legal satisfaction. The class of merchandise of the defendant may not be exactly that of the plaintiff, and yet the deceit be complete. We must apply the doctrine of analogous use. If a defendant show that the class of goods to which he has affixed the mark of the plaintiff, is not in all particulars the same as his, shall he thereby be screened from punishment? If there be two distinct classes of goods bearing the same emblem, are they so nearly alike that the public may naturally be misled? If one apply a symbol to corn-starch, can another evade it by applying it to a somewhat similar article of farinaceous food? In *Burnett* v. *Phalon*,[1] the essential element of each party's product was cocoa-nut oil, although in certain particulars the articles were not alike; but when a buyer saw the word "Cocoine" he thought that he was obtaining the genuine "Cocoaine." So, also, when one asked for the plaintiff's "Eau de la Floride," represented to be a natural water from Florida, he thought his wish was gratified when the defendant delivered a chemical compound marked "Eau de la Fluoride."[2] The object in each case was to deceive the public by the usurpation of the reputation of another person. It is eminently a question of fact for the practical experience of a jury, whether, in a particular case, a resemblance is likely to deceive the community.[3] In the "I X L" matter,[4] Wostenholm & Son had no right to complain of the application by others of the composition of letters first used by their house; for as those others did not manufacture the same kind of cutting instruments that they, the originators, did, no competition arose, and no custom was lost. The goods are of different classes.

[1] 9 Bos. 192; 5 Abb. Pr. R. (n.s.) 212, and 3 Keyes, 594.

[2] Guislain & Co. *v.* Labrugnère, *ante*.

[3] Per Robertson, C. J., in Swift *v.* Dey, 4 Robertson, 611.

[4] §§ 68–70, *ante*.

CHAPTER IX.

REMEDIES — LAW AND EQUITY.

Usually by Action on the Case, or Injunction. — State Legislation. — Indictment, when. — Court of Equity will not interfere unless Legal Title Clear. — Defendant Liable, although acting without Guilty Knowledge. — Discovery. — Costs.

§ 451. **The Remedies against Piracy** are usually by an action on the case for an injury done to a trader in respect to his trade-mark, being a personal injury to be compensated by damages; or else by injunction. The law remedy is sometimes sought under the common law, and sometimes under statutes. Many of the States of the Union have legislated more or less upon the subject, and some of them have passed stringent penal laws in regard thereto. The first Federal legislation in the matter is to be found in the trade-mark sections of the patent and copyright enactment of July 8, 1870; and the remedies therein prescribed are purely of a civil nature, being, indeed, a reaffirmance of the provisions of the pre-existing rules of common law and equity, and novel only in allowing an action for injuries resulting from false or fraudulent representations in the registry of a trade-mark.

§ 452. Sometimes a remedy may be found by criminal indictment, either at common law or by the statutes of States. There are two heads of crime under which it might be expected that the fraudulent imitation of a trade-mark would be indictable, — as a forgery, or as the obtaining of money under false pretences. The former of these methods was adopted in the

case of *Reg.* v. *J. Smith*, in England.[1] The imitation in this case consisted of a printed label, which was an exact imitation of the labels attached by the prosecutor, George Borwick, to packets of his powder, called "Borwick's Baking Powder," with this exception, that the signature, "George Borwick," was omitted in the counterfeit. It was contended, on the part of the prosecution, that the term *forgery* might be defined as the alteration or making of a false document with intent to defraud; and cases were cited in which the fraudulent imitation of a printed document, such as a diploma of the College of Surgeons, the good-conduct certificate of the master of a ship, and of a clergyman, as to the character of a schoolmaster, had been held to be forgeries. It was, however, unanimously held by the bench that the conviction was not sustainable; that the issuing of the wrapper or label, without the powder which it enclosed, would be no offence; and that, in the printing of the wrappers, there was no forgery committed by the printer. Bramwell, B., there said: "Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so efficacious for all purposes as the other," that, in the case before him, "one of the documents is as good as the other, — the one asserts what the other does, — the one is as true as the other; but one gets improperly used." Mr. Lloyd, in his work on trade-marks, says that he has not been able to find any case in the Reports, in which an indictment for obtaining money under false pretences has been sustained in the case of a fraudulent use of a trade-mark, although he had been referred to the cases of *Reg.* v. *Gray & Gosling*, in which the prisoners were sentenced to twelve months' hard labor for the fraudulent use of the Messrs. Allsop's labels; and to another case of *Reg.* v. *S. Jones*, where a sentence of three years' penal servitude was inflicted. He says that it is clear, however, that the principle is applicable; and, in the

[1] Dearsley & Bell, 566; 8 Cox, Crim. Cases, 32.

case first cited, Willes, J., says: "In cases like the present the remedy is well known: the prosecutor may, if he pleases, file a bill in equity to restrain the defendant from using the wrapper; or he may bring an action at law for damages: or he may indict him for obtaining money for false pretences." This opinion of Mr. Justice Willes was assented to, with more or less positiveness, by the other judges; and it seems strange, says Mr. Lloyd, that this form of indictment should not have come into use by manufacturers for the purpose of protecting their trade-marks. It may, however, be accounted for on the ground that an action at law for damages, if successful, gives a more ample compensation for the violation of their rights.

§ 453. Forgery at common law is defined to be "the fraudulent making or alteration of a writing to the prejudice of another man's right," or as a false making, a making *malo animo*, of any written instrument for the purpose of fraud or deceit. In the case of *Reg.* v. *J. Smith*, above cited, Pollock, C. B., in giving judgment, said, speaking of the labels: "They are merely wrappers, and, in their present shape, I doubt whether they are any thing like a document or instrument which is the subject of forgery at common law. To say that they belong to that class of instruments, seems to me to be confounding things together as alike which are essentially different. It might as well be said, that if one tradesman used brown paper for his wrappers, and another tradesman had his brown paper wrappers made in the same way, he could be accused of forging the brown paper." So in *Reg.* v. *Closs*,[1] it was decided that the painting an artist's name in the corner of a picture, in order to pass it off as an original picture by that artist, is not a forgery. Cockburn, C. J., in giving judgment, said: "We are all of opinion that there was no forgery. A forgery must be of some document or writing; and this was merely in the nature of a mark put upon the painting with a view of identifying it, and was no more than if the painter put any

[1] 7 Cox, Crim. Cases, 494.

other arbitrary mark as a recognition of the picture being his." In the course of the argument of this case it was stated by the counsel that "no case had gone the length of holding that to stamp the name of *Manton* on a gun would be forgery;" upon which Crompton, J., said: "That would be forgery of a trade-mark, and not of a name;" and Cockburn, C. J., said: "Stamping a name on a gun would not be a writing; it would be the imitation of a mark, not of a signature." Whether the common law embraced such cases or not, the subject, in England, is made clear; and the following offences are made misdemeanors by section 2 of the Merchandise Marks Act of 1862: 1. The forging or counterfeiting any trade-mark with intent to defraud. 2. The applying a *genuine*, or a forged trade-mark, with intent to defraud, to any thing not being the manufacture, &c., of any person denoted or intended to be denoted by such trade-mark, or not being the manufacture, &c., of the person whose trade-mark shall be forged. 3. The applying any *genuine* or forged trade-mark, with intent to defraud, to any thing not being the particular or peculiar description of manufacture, &c., denoted or intended to be denoted by such trade-mark; for instance, if a man has two trade-marks, one for a particular description of goods of a superior quality, and another for a different description of goods of an inferior quality, the applying the trade-mark for the goods of superior quality to the goods of inferior quality, will be a misdemeanor, if done "with intent to defraud," such intent being an essential ingredient in all such offences.

§ 454. Some of the States of this Union have passed statutes, declaring it to be a misdemeanor punishable by fine and imprisonment to forge or counterfeit, or cause to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label affixed by any mechanic or manufacturer to his goods, wares, or merchandise, or in the sale thereof, with intent to deceive or

defraud the purchaser or manufacturer of any goods, wares, or merchandise whatever. For our present purpose, it is hardly worth while to discuss these comprehensive enactments, which are not confined to technical trade-marks, but embrace wrappers, stamps, and labels. It may, however, be well worth while to have recourse to local statutes when other means are inapplicable, as when, although the technical symbol is not imitated, mischief is done by the ingenious simulation of a label or a wrapper, in color, size, shape, &c. In such cases, of course, a Federal court is not the proper forum; for such court possesses no power except such as both the Constitution and the Acts of Congress *concur* in conferring upon them.[1]

§ 455. The criminal law of some of the countries of Europe, especially France, is severe upon fraudulent imitators of trade-marks. In the Tribunal Corr. of Rheims, in 1863 (*Clicquot* v. *Roudeau et als.*[2]), these facts appeared: In 1863, the London journals contained an advertisement of wines of the house of *la veuve* Clicquot, of Rheims, at advantageous prices, at the Victoria Dock. Suspicions were aroused. The boxes and the casks were found to bear counterfeit marks. The Court of Queen's Bench ordered the seizure of the wines. It transpired that an association, composed of Cazin, a wine merchant, of Roudeau, his principal agent, and three Englishmen, were operating together, and selling wines under the counterfeited marks of Moët, d'Epernay, and Veuve Clicquot. All were deemed guilty in France (although the acts were consummated in England), and severely punished. So, also, in the Court of Paris, in 1867 (*Heidsieck* v. *Souris, Dresel, et als.*[3]), Souris, a commission-merchant, and Dresel, of Rheims, in September, 1866, formed a conspiracy with Theodore and George Bayaud, merchants at New York, to imitate and usurp the trade-mark of Charles Heidsieck, manu-

[1] U. S. *v.* Hudson & Goodwin, 7 Cranch, 32.
[2] Annales de la Prop., tome x. p. 101.
[3] Ibid., tome xiv. p. 95.

facturer of champagne-wine at Rheims, and to export the wine in large quantities to America. In pursuance of their plan, Souris caused to be engraved a mark like that of Charles Heidsieck, and to be reproduced on the cork of each bottle, with the sole substitution of the name of Herman for that of Charles, in the same characters, and the accessory ornament representing a comet. Souris then proposed to export wine in baskets, whose covers bore the four red bars, and all the external appearances of those of the house of Charles Heidsieck. Upon their arrival in America, labels were to be affixed, to complete the deception. It was shown that one Herman Heidsieck, residing at St. Louis, Mo., and not in the champagne-wine business, had loaned his name to guaranty success. The court said that the nefarious conspiracy had been organized on a vast scale. 10,000 francs damages, costs, &c., were allowed.

§ 456. In the Court of Paris, 1868 (*Martell & Co.* v. *Badoureau & Patte*[1]). The plaintiffs in this case were of Cognac, the products of which place are known in all the markets of Europe and America, and having been victims of numerous counterfeits, had seized in Badoureau's lithographic establishment in Paris 12,000 labels bearing their name, and entirely similar to those employed by them in their trade. Badoureau set up that he had made the false labels at the order of Patte. *Held*, that the counterfeiting was complete by making, it not being necessary that use should be shown. The lithographer who reproduces the mark or label by order of a third person, without assurance that he is either the proprietor, or the agent of the proprietor of the mark, cannot set up his good faith. Damages against both. The court further ordered that the labels and stone from which they were printed should be destroyed; and that the judgment should be published in public journals to be selected by the plaintiffs.

§ 457. It has been seen, that the form of action adopted in

[1] Annales de la Prop., tome xiv. p. 126.

vindication of the right to use a trade-mark, is that of an action on the case for deceit; that is, so far as the common-law forms have escaped the renovating inroads of the new school of pleaders; and that action still survives under some other name, or no name, under the simplified forms of pleadings of the codes of procedure. Under the United States statutes, the action remains purely the old action on the case.[1]

§ 458. In this action, fraud is of the essence of the injury. There are, therefore, two main points to 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 is well-defined by Wilde, C. J., in *Rodgers* v. *Nowill*,[2] where he says: "Has more ever been held 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 defendants had adopted the mark, and sold goods bearing it, as and for the plaintiff's goods, with intent to deceive?" On these grounds, the action was held not to be maintainable in *Singleton* v. *Bolton*;[3] for there no sale was proved to have been made by the defendant of a medicament of his own under the 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. So, also, in *Crawshay* v. *Thompson*,[4] it was held that the mark used by the defendants was not used with the intention of supplanting

[1] The Commissioners appointed by virtue of the Act of Congress (14 Stat. at L. 74) to revise, simplify, arrange, and consolidate all statutes of the United States, have printed their report, to be presented at the coming session of Congress; and in that report they amend the language of the law by making an infringer of a trade-mark "liable to an action in *the nature of an action of trespass on* the case."

[2] 5 Com. B. 109. [3] 3 Dougl. 298. [4] 4 Man. & Gr. 357.

the plaintiffs, but that it was applied to certain goods in the ordinary course of business, and in execution of orders. This decision is grounded on the evidence in the case, and turns on the question of what constituted such a fraudulent use. There was no proof of an intention on the part of the defendants to sell their manufacture as and for that of the plaintiffs; but it was contended that their motive in using the mark was immaterial, if the resemblance in fact existed, and they were aware of it. In *Blanchard* v. *Hill*,[1] Lord Hardwicke said: "It is not the single act of making use of the mark that was sufficient to maintain the action, but the doing it with a fraudulent design to put off bad cloths by this means, and to draw away customers from the other clothier." McLean, J., said, in *Coffeen* v. *Brunton*,[2] that from the cases theretofore decided it would seem that an intentional fraud is not necessary to entitle the plaintiff to protection, for the injury will be neither greater nor less by the knowledge of the party. "If he has adopted the same mark which will cause his article to be taken for another in the market, which is known and approved of, it is an injury which the law will redress. In commercial dealings, the utmost good faith should be observed, and no one is permitted to go into the market with a deception of this character, so as to profit by the good faith or established reputation of another." In *Dale* v. *Smithson*,[3] Hilton, J., held that the right of the plaintiffs to maintain the action did not in any degree depend upon the inquiry as to whether the defendants intended to appropriate to their use a trade-mark or label, known by them to have been devised and employed by the plaintiffs in their business; but that it was enough if it was made to appear that the defendants did the act complained of; and so, although they may have used the mark in ignorance of its being the exclusive property of any one. It must be observed that this case, although nominally an *action* under the code of procedure of the State of New York,

[1] 2 Atk. 484. [2] 4 McLean, 516. [3] 12 Abb. Pr. R. 237.

is not the technical *action on the case*, but was really a suit in equity to restrain an infringement; and equity will restrain independent of motive. This principle has been so uniformly maintained by the courts, that it is almost supererogatory to cite further illustrations; but, to place the question still more clearly before the reader, we will look at other cases. In *Blofield* v. *Payne*,[1] the declaration stated that the plaintiff, being the inventor and manufacturer of metallic hones, used certain envelopes for the same, denoting them to be his, and that the defendant wrongfully made other hones, wrapped them in envelopes resembling the plaintiff's, and sold them as his own, whereby the plaintiff was prevented from selling many of his hones, and they were depreciated in value and reputation, those of the defendant being inferior. The court held that the plaintiff was entitled to some damages for the invasion of his right by the fraud of the defendant, though he did not prove that the defendant's hones were inferior, or that he had sustained any specific damage. Where a right is invaded by a fraudulent act, though no specific injury be proved, some damages, at law, must be given; as when a publisher of a magazine or newspaper assumes the name of one previously published, or represents the new publication as a continuation of the former, when it is not so.[2] In *Marsh* v. *Billings*,[3] which was an action on the case, sounding in tort, and governed by the same principle which has been repeatedly recognized and acted on by courts, in reference to the fraudulent use of trade-marks, it was held that the use of the words "Revere House" on coaches was a fraud on the plaintiffs, and a violation of their rights, for which an action would lie, without proof of actual or specific damages. The same rule was observed in *Blofield* v. *Payne*,[4] where it was held that by the defendant's act the plaintiff was entitled to some damages, inasmuch as his right had been fraudulently invaded. So, also, in *Rodgers* v. *Nowill*.[5]

[1] 4 Barn. & Ad. 410. [2] Hogg v. Kirby, 8 Ves. 213.
[3] 7 Cush. 322. [4] 4 Barn. & Adol. 410. [5] 5 Com. B. 109.

§ 459. *To entitle him to recover*, it is necessary for the plaintiff to show that an actual damage has been suffered. But sometimes the law will presume damages, as where the defendant made and sold medicines, calling them "Thomsonian Medicines," as and for the medicines made and prepared by the plaintiff, so that persons purchasing the same supposed and believed that they were purchasing the medicines made and prepared by the plaintiff; for that was a fraud upon the plaintiff for which the law will presume some damage. Such a case, therefore, being proved, the plaintiff will be entitled to recover nominal damages, at least, and something more, if he can make it appear to the satisfaction of a jury that he has sustained more than nominal damage.[1]

§ 460. The nature of the wrong suffered by the trader whose mark is fraudulently used is twofold. It consists in the injury to his reputation where an article of inferior value is palmed off upon the purchaser; or else in the injury done to his trade by general diversion of custom. In *Coffeen* v. *Brunton*,[2] the court said, that if the defendant made representations that his liniment contained the same ingredients as that of the complainant, while in fact it was not only different from the "Chinese Liniment," but greatly inferior to it, the effect must be to destroy in the market the value of the complainant's liniment; and that would be ground for the equitable interposition of a court of equity. That is an injury for which a court of law cannot give adequate compensation. However valuable the complainant's invention may be, yet if it be discredited by a worthless article, it would be impossible, in any reasonable time, to restore the public confidence in the genuine article. In this consists the injury; and the fraud arises from the false representations that the composition is the same.

§ 461. Nor need the representations be *immediate* in order to give a ground of action, as is shown by the case of *Sykes* v.

[1] *Thomson v. Winchester*, 19 Pick. 214.
[2] 4 McLean, 516; and same case in 5 McLean, 156.

Sykes.[1] The defence there proved that the sale of the spurious article was made to retail dealers, who were aware of the fraud; but nevertheless it was held that the sale to them for the purpose of a resale to the public, who would be deceived by the printed stamp, was substantially the same thing as a direct fraud by the original vendor.

§ 462. **Remedy in Equity.** — As a general proposition, it is only when the legal title is clear that a court of equity will interfere by injunction to restrain the use, or the colorable infringement of a trade-mark. In cases of doubt the court should not grant or retain an injunction until the cause shall have been heard upon the pleadings and proofs, or until the complainant shall have established his right by an action at law. Such was the decision of the New York Court of Appeals, in 1848.[2] So the Lord Chancellor, in *Spottiswoode* v. *Clark*,[3] who said that, unless the case be very clear, it is the duty of the court to see that the legal right is ascertained before it exercises its equitable jurisdiction. And he said that for this there are good reasons: the title to relief depends on a legal right, and the court only exercises its jurisdiction on the ground that that legal right is established. The objection to granting an injunction in the first instance is, that it promotes after-litigation. The order either grants an injunction and compels the complainant to bring his action, or suspends the injunction, with liberty to the complainant to bring an action. If you compel him to go to a court of law, you promote litigation, and this course is forced upon parties at a time when their feelings are deeply engaged in prosecuting their imaginary rights. There is also, said he, another objection, which is, that the court expresses a strong opinion, and it ought to be a strong opinion, and then sends the right to be tried. It is better that the court should abstain from express-

[1] 3 Barn. & Cr. 541.

[2] Partridge *v.* Menck, 2 Sand. Ch. R. 622; 2 Barb. Ch. R. 101; and 1 How. App. Cases, 558.

[3] 10 Jur. 1043.

ing such an opinion. But, after all, the chief objection is, that the court runs the risk of doing the greatest possible injustice, in case its opinion upon the legal right should turn out to be erroneous. If the plaintiff prove his title by a successful action at law, he is indemnified by the defendant in the account which the court has directed the latter to keep. On the other hand, if the plaintiff fail in his proof at law, there are no means in his power for compensating the defendant for the loss he will have sustained by the suspension of his trade during the operation of the injunction. This is a sufficient reason for withholding that remedy, unless there be a very clear preponderance of proof in favor of the complainant in the first instance, or some conduct be shown on the part of the defendant which renders it unadvisable to permit him to continue his trade upon the footing of an account to be taken.[1] Mr. Justice McLean, in *Coffeen* v. *Brunton*,[2] said that the right of the party who claims protection must be clear; for, if it be controverted, chancery will leave the party to his remedy at law; or, at least, to such a proceeding as shall present the whole merits of the controversy, and enable the court to decide it. Mr. Justice Duer, in the case of the *Amoskeag Manufacturing Company* v. *Spear*,[3] said that the rule is fully settled, and is recognized in nearly all the cases, that, in suits for infringements of trade-marks, an injunction is never to be granted in the first instance, if the exclusive title of the plaintiff is denied, unless the grounds upon which it is denied are mainly frivolous. When the title is disputed, the course is to let the motion for an injunction stand over until the plaintiff has established his legal right in an action at law; and Mr. Justice Duer cited with approval the ruling of Lord Cottenham, in *Motley* v. *Downman*,[4] who used the strong expression that "he cannot conceive a case in which the court will interfere at once by an injunction so as to prevent the defendant from disputing the plaintiff's legal title."

[1] Lloyd on Trade-marks, p. 17.
[2] 5 McLean, 256.
[3] 2 Sand. S. C. 599.
[4] 3 Mylne & C. 14.

Daly, J., in *The Merrimack Manufacturing Company* v. *Garner*,[1] said that courts of equity have not interfered in cases of this kind, except in aid of a legal right; and if the fact of the plaintiff's property in the trade-mark, or if the defendant's interference with it has appeared at all doubtful, the plaintiff has been left to establish his case first by an action at law. Where the title of the plaintiff to appropriate a certain mark or name to himself was not made out, or considerable doubt existed respecting it, the court discharged an injunction order, upon the defendant's entering into an undertaking in a penalty to keep an account of their sales, and render the same when required by a competent court.[2]

§ 463. The same principle has been applied by courts in the exercise of their jurisdiction in patent and copyright cases, and on the same grounds. In *Stevens* v. *Keating*,[3] the learned judge said that "if the injunction, having been once granted, turns out to be unfounded, you are doing an irreparable injury to the parties restrained, whereas, by withholding it, you may be permitting some injustice, but certainly not an injustice at all equal to that which you are doing by improperly granting it." In this case, the court went so far as to fix the time within which the plaintiff was to bring his action; and on his failing to proceed to the trial of that action, upon grounds which by the court were considered to be insufficient to justify his delay, and upon a subsequent motion on the part of the defendant, the injunction which had been granted on the merits of the case was dissolved, and the defendant was directed to keep an account of his profits.

§ 464. The rendition of a verdict in a case in favor of plaintiff is *not* conclusive upon the right of such party to an injunction (where it is manifest that error has been done[4]); but the considerations which would justify a judge in renewing the dis-

[1] 2 Abb. Pr. R. 318, and 4 E. D. Smith, 387.
[2] Fetridge *v.* Merchant, 4 Abb. Pr. R. 156; also Spottiswoode *v.* Clark, *supra*.
[3] 2 Ph. 338.
[4] Many *v.* Sizer, 1 Fish. 31.

cussion of a patentee's title, after solemn hearing and judgment at law, should be such as, if presented to his view after a trial at law, would have induced him to set aside the verdict.[1] No interlocutory injunction should issue unless complainant's title be clear, or admitted, for the court is not bound to decide doubtful and difficult questions of law, or disputed questions of fact, nor to exercise this high and (if exerted rashly) dangerous power before the alleged offender has had an opportunity for a full and fair hearing. The chief object is to prevent irreparable mischief, not to give complainant means of coercing a compromise on his own terms.[2]

§ 465. If the defendant shows a belief that he has a just defence, and is not a wilful pirate, then the case should be one of evident mistake of law or fact, or both, in the defence which he sets up, which will justify the *festinum remedium*.[3]

§ 466. The constitutional right of a trial by jury applies only to actions at common law. In suits in equity, an inquiry by the jury depends upon the discretion of the court,[4] it not being conclusive, but only an aid to the conscience.

§ 467. Upon motions for preliminary injunction, if, after a careful and impartial examination of the case, the court be of opinion that the complainant is entitled by law to the writ, it is their duty to grant it without evasion.[5]

§ 468. In equity, if the defendant, without fraud, use the trade-mark of the complainant, he is still liable. If the right be violated, it matters not whether it be by fraud or by mistake. The whole question in such case is whether the defendant's label or mark is calculated to deceive the public, and to lead them to suppose that they are purchasing an article manufactured by the complainant instead of by the defendant.[6] To

[1] Parker *v.* Brant, 1 Fish. 58.
[2] Parker *v.* Sears, 1 Fish. 93; Goodyear *v.* Dunbar, ibid. 472.
[3] Ibid.
[4] Ely *v.* Monson, 4 Fish. 64.
[5] Blanchard *v.* Reeves, 1 Fish. 103.
[6] Millington *v.* Fox, 3 Myl. & C. 339; Davis *v.* Kendall, 2 R. I. 566.

entitle a complainant to protection against a false representation, it is not essential that the article should be inferior in quality, or that the individual should fraudulently represent it, so as to impose upon the public; but if, by representation, it be so assimilated as to be taken in the market for an established manufacture, or compound of another, the injured person is entitled to an injunction. The injury is not the less, though the false representations be made without a knowledge of such interference.[1]

§ 469. **Discovery, Account, Costs.** — Although it is not within the scope of this treatise to discuss matters which can be found more fully and more ably treated in books devoted to equity jurisprudence, and in books of practice, still this subject is worthy of observation, in its relation to trade-marks. In many cases, the aggrieved party might be at a great disadvantage, unless he had some means of access to his opponent's books and papers. To enable him to fix the amount of injury done by the wrongful conduct of the other, he must look to discovery. How shall he, in the majority of cases, ascertain the amount of sales, unless in this mode? But how shall he proceed?

§ 470. We find a statutory provision[2] by which all courts of the United States have power in the trial of actions at law, on motion and due notice thereof being given, to require the parties to produce books or writings in their possession or power, which contain evidence pertinent to the issue, in cases and under circumstances where they might be compelled to produce the same by the ordinary rules of proceeding in chancery. But this may really afford no remedy. On failure, judgment may be given against the defendant by default, and the plaintiff be left to grope in the dark. He must, then, resort to a court of equity. There the familiar canons of chancery jurisprudence stand in his way, if he seeks discovery

[1] Coffeen *v.* Brunton, 5 McLean, 256.

[2] Judiciary Act of Sept. 24, 1789.

to enable him to enforce a forfeiture; for equity does not favor forfeitures. But if he relinquish all claim to a penalty or forfeiture, he may entitle himself to a discovery in aid of an action at law for the recovery of damages.[1]

§ 471. Parties innocently bought and sold as genuine an article which was in fact spurious. They were restrained from selling it with the plaintiff's trade-mark; but were not ordered to account for profits, nor compelled to pay the plaintiff's costs. The Master of the Rolls said, substantially, that the right to an injunction usually carries with it the right to costs; but if a plaintiff asks for costs, and for something more than he is entitled to, he will lose the costs he might otherwise have received.[2]

§ 472. A common carrier, entirely innocent of fraudulent intent, but having certain falsely-marked goods in his possession for the purpose of transportation, may be enjoined; but the fact of good faith is ground for refusing costs. This was the ruling in *Upmann* v. *Elkan*,[3] in 1871, by Lord Chancellor Hatherly, affirming a decree of the Master of the Rolls. A firm of forwarding agents in London received from correspondents abroad a number of boxes of cigars, being counterfeit brands, to be delivered to several persons in England. On application by the makers whose brand had been imitated, the agents gave information against the consignors, and offered to either send back the cigars, or to remove the brand. The Lord Chancellor said: "It has been urged that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods which, though fraudulently marked, were not for their own use, nor to be sold for them for their own benefit, but were merely received for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine

[1] See authorities cited in 2 Abb. U. S. Cts. Practice, p. 92.

[2] Moet *v.* Couston, 10 L. T. R. (N.S.) 395.

[3] L. R. 7 Chanc. Appeals, 130; also, Amer. ed. of Eng. Reports (Moaks), 1872, p. 474.

more dangerous or mischievous, or more fatal to the authority of the court with respect to trade-marks. If that argument prevailed, persons being abroad, as was the case in this instance, and inclined to commit frauds upon an English trade-mark, could easily do so by sending their different consignments together to the possession of the defendants (who appear to be reputable agents and warehousemen), thereby committing an injury in a manner most convenient to themselves, and very mischievous to the person entitled to the benefit of the trade-mark."

§ 473. In such a case, the agent may be compelled by a court of equity to disclose the names of places to which goods bearing false marks had been transmitted by him, and all other information that is within his knowledge or may be gathered from his books tending to redress the grievance of the plaintiff, *except* the names of customers and the prices of the goods.[1]

[1] Carver *v.* Pinto Leite, L. R. 7 Chanc. 90.

CHAPTER X.

DEFENCES.

The Complainant must come with "Clean Hands." — Want of Truth. — Quack Medicines not protected. — What Courts regard as Falsehoods. — Mere Exaggeration in Advertisement does not disentitle to Relief. — Nor Fictitious Name of Manufacturer, in Absence of Fraud. — No Defence that Spurious Article is Equal to Genuine. — Laches of Complainant. — What not deemed Laches.

§ 474. The most important of the grounds of defence to a bill for infringement is the well-established rule of equity, that the protection of the court will not be extended to a person whose case is not founded in truth. That appears to have been first made use of as a ground of defence to a bill for an injunction to restrain the alleged violation of a right to use a trade-mark in *Hogg* v. *Kirby*.[1] The objection there taken was that the complainant, claiming the protection of the court for the title-page of his magazine, which professed to be "by William Granger, Esq.," was in fact guilty of an imposition on the public, it being shown that the name of the alleged author was fictitious. The excuse offered was that it was a custom of the trade; but Lord Eldon states in his judgment that he felt considerable difficulty on the question, and that this custom, though it might be very usual, appeared to him very much like a fraud on the public. His lordship, however, deciding the cause upon other grounds, left this question as an ingredient in an action for damages. In *Partridge* v. *Menck*,[2] the complainant claimed the exclusive right to impose upon the public

[1] 8 Ves. 215.

[2] 1 How. App. Cases, 158.

matches made by himself as those manufactured by one Golsh; and although the court decided the cause upon the ground of dissimilarity of the labels, a strong opinion was expressed against his right to recover, on the ground of his attempted deception. So, also, in *Samuel* v. *Berger*,[1] where the plaintiffs asked the court to aid them in passing off upon the public watches made by them, as those made by another person, from whom they had purchased authority to use his name.

§ 475. The manufacturer of a quack medicine is not entitled to invoke the intervention of a court of equity; for it is not the office of chancery to intervene, by its summary process, in controversies connected with the title to such a matter: "*non nostrum tantas componere;*"[2] and an injunction will be refused against the vendor of a patent medicine at the suit of his brother quack, who complained that his label and envelope of certificates had been imitated, for the special action of chancery cannot be involved in a controversy which has so little merit to commend it on either side.

§ 476. The court said, in *Smith* v. *Woodruff*,[3] that the justice and morality of this defence were not very high in that instance, yet the rule must be followed if the case were brought within its application: that it is a defence that ought to be suggested by the court in some cases, and probably would be in all cases where the imposition is flagrant. For instance, where a quack compounds noxious and dangerous drugs, hurtful to the human constitution, and advertises them as a safe and sure remedy for disease; or where some charlatan avails himself of the prejudice, superstition, or ignorance of some portion of the public, to palm off a worthless article, even when not injurious, the case falls beneath the dignity of a court of justice to lend its aid for the redress of such a party, who has been interfered with by the imitations of another quack or charlatan.

[1] 13 How. Pr. R. 342, and 4 Abb. Pr. R. 88.
[2] Fowle *v.* Spear, 7 Penn. L. J. 176; Heath *v.* Wright, 3 Wall. Jr. 141.
[3] 48 Barb. 438.

§ 477. The case of *The Leather Co.* v. *The American Leather Co.*,[1] in the House of Lords, in 1865, furnishes instruction upon more than one point, and it is well worthy of the expenditure of time in its perusal in regard to the question of truth in representations.

§ 478. The appellants and the respondents were rival joint-stock companies, engaged in the manufacture of leather cloth. The plaintiffs are an English company, formed in 1857, with limited liability, for the purpose of making and selling an article called leather cloth. They bought the business of an American company, which was formed for the purpose of carrying on this manufacture in New Jersey in the United States, and at West Ham, in the county of Essex, in England. The name of the company was "The Crockett International Leather Cloth Company." The original inventors and manufacturers of this article, called leather cloth, were a firm of "Crockett & Co." in the United States, who, upon the formation of the International Company, ceased to carry on a separate business, and became shareholders in that company, but have resumed business, and are manufacturers of leather cloth in the United States. The International Company by its agents obtained, in the month of January, 1856, an English patent for tanning the leather cloth, and having done so, they devised an elaborate label, to be attached to the goods manufactured by them, which, being in a circular form, had its circumference formed by the words "Crockett International Leather Cloth Company, Newark," with the initials "N. J., U. S. A.," meaning New Jersey, United States of America, and also the words "West Ham, Essex, England." These words and letters formed the periphery or outer rim of the label. Within the circle, at the top, is the word "Excelsior," below which is an eagle with expanded wings, and beneath the eagle are printed these words, — "Crockett & Co.'s Tanned Leather Cloth, Patented Jan. 24, 1856, J. R. & C. P.

[1] 11 Jur. (N.S.) 513.

Crockett, manufacturers." The International Leather Cloth Company carried on business as leather cloth manufacturers, both in the United States and in England, until May, 1857. They used the stamp or label which has been described, as a trade-mark, affixing it to the goods which they manufactured. In May, 1857, the plaintiff's company was incorporated; and the International Company sold and assigned to the plaintiffs the business carried on by them at West Ham, together with the English letters-patent, with full power and authority to use all and singular the trade-marks that had been used by the International Company in their business in England. From the time of this sale, the plaintiffs have carried on, at West Ham, the manufacture of leather cloth, according to the process originally introduced by Crockett & Co.; and they have constantly used the trade-mark which has been described, stamping it on their goods of the first quality. In August, 1861, the defendants were incorporated for the purpose of carrying on the manufacture and sale of leather cloth; and they have used as a trade-mark, on goods made by them of the first quality, a stamp or label which certainly appears to have been formed upon the model of the plaintiffs' trade-mark. They do not, however, make use of the word "patented," nor do they call their leather cloth "tanned." All these facts appear in the opinion of the Lord Chancellor on appeal to him from Vice-Chancellor Sir W. P. Wood. The Lord Chancellor said: "To continue the old style of a firm is a very different thing from making false representations with respect to a vendible commodity, in order to give it greater value, and to create a greater demand for it in the market. The plaintiffs impose upon the public by selling goods which are, in reality, manufactured by themselves at West Ham, as being the goods of the Crockett International Leather Cloth Company, and as having been manufactured by Messrs. Crockett, who were the original inventors and manufacturers; and further, they described their untanned goods as being tanned and protected

by the patent, which was not yet expired. Their request is to be protected, and therefore justified, in continuing to make these untrue statements to the public, in order to secure a monopoly for their commodity. There is a homely phrase, long current in this court, that a plaintiff must come into equity with clean hands: that is not so with the present plaintiffs, whose case is condemned by the principles to which they appeal." He thereupon, without hesitation, reversed the decision of the Vice-Chancellor, and dismissed the bill; but, in disapprobation of the conduct of the defendants, he did so without costs.

§ 479. In *Perry* v. *Truefitt*,[1] the plaintiff filed his bill, alleging that the name or designation of "*Medicated Mexican Balm*" had become of great value to him as a trade-mark; and prayed an injunction and account. According to his own statement, the plaintiff used a printed show-card, in which he represented the article in question in the following terms: "Medicated Mexican Balm, for restoring, nourishing, strengthening, and beautifying the hair. Perry, 12 and 13 Burlington Arcade, London. It is a highly concentrated extract, from vegetable balsamic productions, of that interesting but little-known country, Mexico, and possesses mild astringent properties, which give tone to weak and impoverished hair, and impart a glossy appearance to the naturally dull and harsh. Where there is a tendency to fall off, the Mexican Balm exerts its astringent qualities, and gradually, but infallibly, braces the pores of the cuticle, and arrests the deterioration of the most beautiful ornament of the human frame, — a fine head of hair. This admirable composition is made from an original recipe of the learned J. F. Von Blumenbach, and recently presented to the proprietor by a very near relation of that illustrious physiologist." The fact appeared that one Leathart had invented the preparation, and sold the recipe for making it to the plaintiff. The Master of the Rolls did not think it a favor-

[1] 6 Beav. 66.

able case for the interposition of the court, there not being the least evidence that the composition was formed of vegetable balsamic productions from Mexico. Yet, as it was a case of some doubt, he let the matter stand over, with liberty to the plaintiff to bring an action.

§ 480. The circumstances in *Pidding* v. *How*[1] were less dubious. The plaintiff, in his labels and advertisements, intimated that the tea sold by him as "*Howqua's Mixture*," was made by Howqua, in Canton, and was purchased from him and imported into England by the plaintiff, in the packages in which it was sold; that the tea which gave it its peculiar flavor was very rare and high-priced, even in China, and was grown in but one province of that country, viz., Kyiang Nan; and that it could not be procured in England at any price. On behalf of the defendants, affidavits were made by persons, some of whom had been acquainted with Howqua. They stated that the mixed tea sold by the plaintiff was neither made nor used by Howqua; that it was composed of scented orange pekoe (which gave it its peculiar flavor), and of other black teas of the ordinary kinds; that orange pekoe was not considered, in China, to be one of the best teas; and that that sort of tea had been imported and sold in England for several years, and was generally imported and sold by persons in the tea-trade; that no black tea was produced in the province aforesaid; and that the plaintiff purchased and mixed his teas in England. The Vice-Chancellor said, that on the part of the plaintiff there had been such a degree of representation which he took to be false, that, in his opinion, a court ought not to interfere to protect him, until he had established his title at law. As between the plaintiff and the defendant, the course pursued by the latter had not been a proper one (he having imitated the plaintiff's marks); but that it is a clear rule, laid down by courts of equity, not to extend protection to persons whose case is not founded on truth. "And,"

[1] 8 Sim. 477.

said the Vice-Chancellor, "as the plaintiff in this case has thought fit to mix up that which may be true with that which is false, in introducing his tea to the public, my opinion is, that unless he establish his title at law, the court cannot interfere on his behalf." He accordingly dissolved the injunction, with liberty to the plaintiff to bring an action, reserving the question of costs. In *Dixon Crucible Co.* v. *Guggenheim*,[1] the defendant made a point that the wrapper of the plaintiffs averred a falsehood in stating that the article sold by them is prepared from *pure carburet of iron*. The court replied that no intention to mislead appeared: that, at best, it is a question of science; that plumbago is undoubtedly the proper name of the article, though it was long known to science as carburet of iron; and that it was entirely too nice a question to be decided upon a motion for a special injunction. Another point was made, that the label states that the plaintiffs' article is prepared by Joseph Dixon & Co., whereas the bill avers that it is prepared and sold by a corporation, viz., The Joseph Dixon Crucible Co. The court said that that difference is not of such a character as to destroy the plaintiffs' right to equitable relief, there being nothing to indicate any attempt at deception or imposition, the corporation being the successor of the individuals.

§ 481. In *Palmer* v. *Harris*,[2] in the Supreme Court of Pennsylvania, in 1869, where an injunction had been refused below by reason of the plaintiff's false representation, the plaintiff claimed immunity from the strictness of the rule, because the falsehoods were in a foreign language, presumed not to be understood. The bill alleged that the plaintiff was a tobacco-merchant in New York, and made superior cigars, known as the "*Golden Crown*," which he sold in large quantities; that in 1858 he devised a trade-mark, to wit, a golden crown, and had labels with that mark lithographed and printed, which, for

[1] 3 Am. Law Times R. (St.) 288, and 2 Brewster, 321.
[2] 60 Penn. 156.

his protection, he entered on the 18th of December, 1858, in the office of the District Court of the Southern District of New York, in comformity with the Act of Congress respecting copyrights;[1] and that from that time this trade-mark had been used by him, and became identified with the golden crown cigars. The labels were used by placing a larger one inside of the cover of the cigar-box, and a smaller one over the edge of the box where the cover is opened. The defendant, who is a printer, made a great number of counterfeit labels of the plaintiff's trade-mark for persons unknown to the plaintiff, for the purpose of inducing purchasers to believe that they marked the "golden crown" cigars. Upon being notified, the defendant refused to discontinue the printing and sale of the counterfeit labels. The answer of the defendant admitted most of the allegations of the bill, but averred as follows: "It is true, as matter of fact, and I aver it to be so, that complainant's cigars are manufactured and sold in the city of New York, and not at Havana, and that, therefore, the announcement upon complainant's label, Exhibit A, in the words following: 'Fabrica de Tabacos de las Majores Vegas, de la Vuelta Abajo, Calle del Agua, No. 75, Habana,' is wholly untrue, and both calculated and intended to deceive, and being so calculated and intended, is not entitled to the aid of a court of equity for its protection."

§ 482. The genuine labels in this case were parallelograms, nearly square; on the smaller was inscribed "*Golden Crown*," below which was "*L. P.*," and below that "*Habana.*" The larger was enclosed in an ornamental border. On it were "*Golden Crown*," below that the figure of a golden crown; then the Spanish words above quoted; and below all, and outside of the border, in very small letters, "*Ent. according to Act of Congress, A.D.* 1858, *by Lorin Palmer, in the Cl'k's Office in D't'c't of the S. D't of N. Y.*" There was also a government revenue stamp on the box. The counterfeit was

[1] This act of entering as a copyright was a nullity in law.

of the larger label, and was very similar to it, but wanting the certificate of the entry of the copyright. The appellant — the plaintiff below — made a point that the taking out of the copyright, and declaring that fact on the label, neutralized the words in Spanish; also, that the internal revenue stamp stated the kind, quantity, and district where manufactured; and that the assertions were innocent in their effect on the public, and that the court should not canvass the motive.

§ 483. The court, by Sharswood, J., said, among other things: "The party who attempts to deceive the public by the use of a trade-mark, which contains on its face a falsehood as to the place where his goods are manufactured, in order to have the benefit of the reputation which such goods have acquired in the market, is guilty of the same fraud of which he complains in the defendant. He certainly can have no claim to the extraordinary interposition of a tribunal constituted to administer equity, for the purpose of securing to him the profits arising from his fraudulent act." As to the notice of the entry as a copyright, the court said: "Apart from the fact that this is in such very small type, and so abbreviated that it would probably escape the observation of every one whose attention was not specially directed to it, a circumstance which rather strengthens the evidence of an intention to mislead the public, what is there in the fact that the design or engraving had been copyrighted in the United States, inconsistent with the declaration that the cigars contained in the box were manufactured in Havana, of Cuban tobacco? But, again, it is said that the United States internal revenue stamp would at once undeceive the purchaser, there being a difference between the stamp used for articles imported and for those of domestic manufacture. Few persons would stop to notice this difference, and, besides, as it is alleged, the trade-mark is pasted on the inside of the lid, and when the box is open, for the purpose of retailing, the trade-mark is brought directly in the view of persons wishing to purchase, and the revenue-stamp is not seen unless the lid is turned

down, and the box examined on the outside. It is contended further, that the falsehood is in a foreign language, of which it is to be presumed that the plaintiff's customers are ignorant. Yet there is certainly enough to convey to every one who can read that the cigars are from 'Havana.' . . . It is not necessary that any one person has been actually deceived or defrauded: it is enough that it is a misrepresentation calculated to have that effect on the unwary and unsuspicious." The decree refusing an injunction was affirmed, and the appeal dismissed at the costs of the appellant.

§ 484. In *Phalon* v. *Wright*,[1] the plaintiff claimed to have compounded a new perfume, and to have invented a name for it, to wit, "Extract of Night Blooming Cereus." He did not claim any exclusive right in the perfume itself. He had thus chosen the name of a rare, though well-known flower, and claimed in the name alone an exclusive right, as his trade-mark. He admitted that name to be a deception, so far as used to indicate the real character of the compound; and that the perfume was not an extract from the flower, the mark being in that respect a pure invention. As an exhibit, the plaintiff produced an advertising card, used to give publicity to his preparation, upon which card he declared that the new perfume is the extract of the "Night Blooming Cereus, distilled from this rare and beautiful flower, from which it takes its name." Thompson, J., said that "this is a deception, intended to impose upon the public by exciting curiosity to learn the nature of the rare and beautiful flower. It may be that the deception is harmless. The manufactured perfume may be better than the genuine extract would be; but still it is a deception, and the plaintiff has no right to expect a court of equity to aid him in carrying it on. . . . Thus the case stands upon the plaintiff's own showing. The defendants, by their affidavits, deny fully that the name upon their labels was used to imitate the plaintiff's labels; and they show, by the affidavit of the lithog-

[1] 5 Philadelphia, 464.

rapher by whom the label was drawn and prepared, that he did not know of the existence of the plaintiff's label when he designed and drew that of the defendants. The labels are so little alike, and the name of the defendants so distinctly printed upon theirs, that, as has already been said, no one purchasing Wright's Night Blooming Cereus could suppose he was buying Phalon's. It is very manifest that the defendants did not sell their preparation as that of Phalon's; and they clearly marked it as their own production." The motion for an injunction was dismissed.

§ 485. In *Hobbs* v. *Francais*,[1] the plaintiff moved for an injunction to restrain the defendant from violating his trade-mark. It appeared that he and another, under the firm name of Fabian & Co., in 1846, commenced the manufacture and sale in the city of New York of a certain powder "for beautifying the complexion and skin;" that they had adopted as the name of the said article the words "Meen Fun," and devised a label bearing that name, with certain devices upon it, to put upon the boxes and packages containing said article; and that they had sold said article by the name of "Meen Fun," until 1848, when his partner, Fabian, transferred to the plaintiff his interest in business, and the right to use the firm name, label, devices, and marks. Further, that after the said article had acquired a reputation, and the sales had become large and profitable, the defendant had made and sold an article of skin-powder, put up in boxes like those of the plaintiff, and had placed on them labels closely imitating the plaintiff's, with the words "Meen Fun" thereon.

§ 486. The plaintiff's label read as follows: "Patronized by Her Majesty, the Queen. 'MEEN FUN,' the Celebrated Chinese Skin Powder for Restoring, Beautifying, and Preserving the Skin and Complexion, Preventing Cutaneous Eruptions, Chapping, and Obviating too Copious Perspiration. ADAPTED FOR ALL CLIMATES. Fabian & Co., Sole Proprietors, 24 Mark Lane, London," &c.

[1] 19 How. Pr. R. 567.

§ 487. PER CUR., Bosworth, C. J.: "The plaintiff's label is calculated to induce the belief, and probably was designed to induce the belief, that the article in the box on which it is pasted is manufactured in London; that the sole proprietors of it have their place of business at 24 Mark Lane, London; that it is intrinsically so excellent as to secure the patronage of her majesty, the Queen; and that the labels have paid the stamp-duty required by some English statute. The truth is, that it is made in New York, and that her majesty, the Queen, is probably ignorant of its virtues, or even of its existence. In this respect, there is a manifest intention to deceive and mislead the public. . . . The plaintiff's label, instead of indicating that he is the manufacturer of the article covered by it, represents him to be the sole agent in the United States of the proprietors of it, and that their place of business is in London. It appears by the defendant's affidavit, that it is the prevailing belief in this country that ladies' toilet articles of English or French manufacture are superior to those made in this country, and that the demand for the former is much better than for the latter. The plaintiff's labels, therefore, contain representations believed to be useful, and which must be known to be false; and to secure to the plaintiff by injunction an exclusive use of such a label, and the exclusive privilege of thereby deceiving the public, is an object to which a court of equity will not lend its aid. The court does not refuse its aid in such a case from any regard to the defendant, who is using the same efforts and misrepresentations to deceive the public, but on the principle that it will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and devices which are claimed to constitute wholly, or in part, such trade-marks. On this ground, the motion for injunction must be denied."

§ 488. Mr. Justice Duer applied this rule in *Fetridge* v.

Wells,[1] — the "Balm of Thousand Flowers" case, — that they who come into a court of equity seeking equity, must come with pure hands and a pure conscience. If they claim relief against the fraud of others, they must be free themselves from the imputation. The learned judge said, *inter alia*: "The position so strenuously insisted on, that the plaintiff's firm have an exclusive property in the words 'Balm of Thousand Flowers,' or, which is the same thing, an exclusive right to use those words as a trade-mark, I wholly reject. . . . It may be true that the defendants, if permitted to use in their contemplated sales a trade-mark apparently the same as that of Fetridge & Co., would commit a fraud upon the plaintiff and upon the public; but if the plaintiff and his firm are themselves engaged in the execution of a systematic plan for deceiving the public; if they have been, and are, endeavoring, constantly and daily, to multiply their sales, and swell their profits by false representations of the composition, qualities, and uses of the liquid compound which they invite the public to buy, it is strenuously insisted that a court of equity would violate its principles, and abuse its powers, by consenting to aid them, by an injunction or otherwise, in accomplishing their design; and to this proposition I yield my fullest assent. . . . An exclusive privilege for deceiving the public is assuredly not one that a court of equity can be required to aid or sanction. To do so, would be to forfeit its name and character." The injunction previously granted was therefore dissolved, but without costs, since, although the plaintiff might justly be required to pay costs, the defendants had certainly no title to receive them, being equally guilty of wrong.

§ 489. In *Partridge* v. *Menck*,[2] in the Court of Appeals of New York, in 1848, this question received a full consideration. This case came before the Vice-Chancellor of the first circuit on a motion founded on the bill and answer, to dissolve the preliminary injunction granted by an injunction-master, on

[1] 13 How. Pr. R. 385.

[2] 1 How. App. Cases, 558.

filing the bill. It appeared by the bill that one Golsh, who formerly resided in the city of New York, commenced the manufacture of a certain kind of friction-matches, usually known as "loco-foco matches," for which he acquired a great patronage. His matches were put up in small paper boxes, usually of brown paper, made with a cap or cover, which, when placed on the box, covered about a third of its length; and his trade-mark was a cut representing a straw bee-hive surrounded by flowers and foliage, with the words "A. GOLSH'S FRICTION MATCHES" above the hive. The cut and the words were printed on a label, which was pasted upon the front of each box. The complainant succeeded Golsh in his business, and continued to manufacture and sell the same kind of matches, using the same mark, the label being sometimes varied. His business had extended so that large quantities of his matches were exported to the West Indies, Mexico, and South America. The bill charged that the defendants, Menck & Backes, had been and were engaged in manufacturing friction-matches, purporting to be the Golsh matches. It set forth two labels as being used by the defendants upon the brown-paper boxes in which they put up their matches. One contained the bee-hive and foliage, over which were printed the words "MENCK & BACKES' FRICTION MATCHES, late chemist to A. GOLSH," the words "late chemist" being in letters smaller than the rest; and under the bee-hive were printed in two panels the number and street in which their manufactory was situated, &c. The other label was pretty-much the same, the words "A. Golsh" being much larger and more prominent than those above them. It was charged that this was a piratical and fraudulent invasion of the complainant's trade-mark. The Vice-Chancellor said that, taking the whole label together as it appeared on a single box of matches when offered for sale, the resemblance of the bee-hive was qualified by the distinct terms, "late chemist for A. Golsh," so that the article did not purport to emanate from either Golsh or from his successor. He

accordingly dissolved the injunction, placing his decision on the ground of dissimilarity in the labels of the respective parties. The complainant appealed to the Chancellor. He affirmed the decision, and upon the same grounds, not questioning the legal right of the complainant to use the mark set forth in his bill. The complainant thereupon appealed to the court of last resort. The Court of Appeals took a different view of the case, although the result was the same.

§ 490. PER CUR., Gardiner, J.: If the statements of the bill are analyzed, it will be found that the complainant claims the exclusive right to impose upon the public matches made by himself as those manufactured by A. Golsh. He alleges that "the label heretofore spoken of, which was used by said Golsh, had an imprint of a bee-hive, and the words 'A. Golsh, Friction Matches, 124 Twelfth Street, between 5th and 6th Avenues, New York,' which label has been and now is used by your orator without variation." In every essential particular, as it respected the complainant, the statement of the label was false. "The matches were not Golsh's matches, in the sense in which it was intended that purchasers should understand those terms. He was in Europe, and had no interest or agency in their manufacture. Verbal declarations to a purchaser of the same kind, with a view to a sale of this article, it was conceded, would have been fraudulent. That they were made to assume a more permanent form, and one better calculated to impose upon those who relied upon the reputation, personal skill, and integrity of Golsh, can make no difference in the character of the transaction. It is no sufficient answer to this view of the subject that the complainant obtained from Golsh the secret of the manner in which his matches were prepared, or that he manufactured an article in all respects equal to that offered by the former proprietor. So, also, did the defendants, if we may trust their answer. Nor does it alter the case that the complainant purchased the right to use the name of A. Golsh. The privilege of deceiving the public, even for their own benefit, is not

a legitimate subject of commerce; and at all events, if the maxim, that he who asks equity must come with pure hands, is not altogether obsolete, the complainant has no right to invoke the extraordinary jurisdiction of a court of chancery in favor of such a monopoly. The bill is therefore defective for want of equity; and for this reason, as well as for those assigned by the Vice-Chancellor and Chancellor, I think the order of the latter should be affirmed." Wright, J., said: "The label of the appellant is calculated to deceive the purchasers of matches, inducing all unacquainted with the agreement between him and Golsh to believe that they are purchasing an article manufactured and sold by Golsh himself, when, in truth, Golsh has no concern in the manufacture, nor interest in the business, and has left the country." The order was affirmed unanimously.

§ 491. A court of equity will not interfere to protect the trade-mark of a quack medicine. In *Fowle* v. *Spear*,[1] in the United States Circuit Court, E. D. of Pennsylvania, in 1847, the complainant applied for an injunction to restrain the defendant from using wrappers, labels, and bottles resembling those used by the complainant in his business of selling "Wistar's Balsam of Wild Cherry." Kane, J., refused the relief asked for. From his opinion, it appears that on one of the complainant's wrappers, which was made a part of the bill, the balsam was described as "a valuable family medicine for consumption of the lungs, coughs, colds, asthmas, bronchitis, croup, whooping-cough, difficulty of breathing, pains in the side or breast, liver complaints, &c.," to which another paper, also among the exhibits, adds "influenza, hoarseness, pains or soreness of the chest, &c." The judge said that "It is not the office of chancery to intervene, by its summary process, in controversies like this; '*non nostrum tantas componere*.' Looking at the incongruous group of diseases for which the balsam prescribes itself to public credulity, I must

[1] 7 Penn. L. J. 176.

apply the principle of the Vice-Chancellor's decision in *Pidding* v. *How*, 8 Sim. 477, that a complainant whose business is imposition cannot invoke the aid of equity against a piracy of his trade-mark. The only remedy in such a case is at law." In 1855, the same judge made a similar ruling in the case of *Heath* v. *Wright*,[1] where the complainant sought to restrain the defendant from using the word "KATHAIRON," of assumed prodigious efficacy in many diseases.

§ 492. **A mere False or Exaggerated Statement** in a public *advertisement* will not deprive the owner of his right to protection. In *Curtis* v. *Bryan*,[2] the defendant interposed the objection that the plaintiff's medicine was not what by the advertisement it purported to be; and that it was not perfectly safe or harmless, but that, on the other hand, it contained ingredients which are injurious and baneful to children. The court said that "It is difficult to conceive upon what principle of equity this defendant should be heard to raise this objection. His own conduct in regard to the subject-matter is an unequivocal concession to the goodness and value of the plaintiff's article. He interposes this objection to avoid an injunction which restrains him from imitating the plaintiff's article. After the plaintiff's preparation had been in use for nearly twenty-five years, its sale having steadily increased during all that time, the defendant appears, and places upon the market an article which, by the practices and arts to which he has had recourse, he would have the public purchase as the plaintiff's article. If the article was not a good one, why should the defendant imitate it? If it was injurious to health, it is not reasonable to suppose that a prudent man would venture to introduce a similar article under the same name, and hope to succeed. . . . Experience is an excellent teacher, and the fair trial of an article will furnish unerring evidence of its worthlessness or value. It is obviously true that if a

[1] 3 Wallace, Jr. 141.
[2] 2 Daly, 212; 36 How. Pr. R. 33.

medicine can stand the test of twenty years of experimental use, and grow steadily and constantly in favor, its properties cannot be injurious. But, as before observed, the good faith of this defendant, in raising the objection, may reasonably be questioned, and I am satisfied that it does not lie in his mouth to make it. If a man's acts are any indication of his belief, on any subject, the conduct and admissions of the defendant constitute a complete refutation to this objection. A man's faith is shown by his works." The defendant was accordingly restrained, with costs.

§ 493. In *Smith* v. *Woodruff*[1] the doctrine of estoppel was also applied. Admitting, for the sake of argument, that the plaintiffs' preparation was a fraud upon the public, the court said that that suggestion comes with a poor grace from one who has, by the imitation, been guilty of the same fraud upon the public, if such it happens to be. This case was an appeal from an order dissolving an injunction restraining the defendant from manufacturing and selling a perfume called "SWEET OPOPANAX OF MEXICO;" from selling any perfumery with that name; from using the name in connection with any perfumery; from using the plaintiffs' label, or any imitation or counterfeit thereof; and from using the label then employed by the defendant, as set out in the complaint. From the opinion of the court, in reversing the order above-mentioned, we learn that the plaintiffs, in connection with their label, put forth a puff, stating that "the opopanax is a native flower from Mexico, of rare and very rich fragrance, from which this extract is distilled," &c. On the part of the defendant, several perfumers made affidavit that they had examined the perfume of the plaintiffs; that they could tell, approximately, its ingredients; that it was not distilled from the flower of opopanax, but was a compound of several well-known tinctures or essential oils, combined with pure spirits. Others stated that there was a resinous *gum* in the market, of a disagreeable odor, but no

[1] 48 Barb. 438.

flowers of opopanax. The plaintiffs, and their chemists, swore that the said opopanax was used in the preparation, distillation, and manufacture of said perfume, and that the perfume was made from it. Several perfumers also made affidavits that it was not possible for any perfumer to tell the ingredients of the plaintiffs' perfume. Under this contradictory state of evidence, the rule was not available to the defendant. The injunction was restored with costs from defendant.

§ 494. **Fictitious Name of Manufacturer.** — The fact that a trade-mark bears a fictitious name as the name of the manufacturer does not affect the owner's right to protection, where it is shown that it is not used with any fraudulent intent, and does not in fact deceive the public. This point is illustrated by the case of *Dale* v. *Smithson*,[1] where Thomas Nelson Dale was adjudged to have a lawful right to the exclusive use of the following: "Courtria Flax, Thomas Nelson & Co. Warranted, Fast Colors and 16 oz." The defendants, who had closely imitated the plaintiffs' label (which strictly speaking is not a trade-mark), contended that the plaintiffs could not acquire an exclusive right to the use of said label, because it did not indicate the true origin or ownership of the thread to which it was affixed, — the name of Thomas Nelson & Co. being that of a fictitious firm; and that as the plaintiffs were thus practising a deception upon the public, by passing off the thread as being manufactured by persons who had no real existence, a court of equity should not interfere to protect them in their fraud.

§ 495. The court, by Hilton, J., said in reply, that "the label is manifestly one not intended to delude the public, by making any representations or asserting any thing in respect to its qualities or properties, which are untrue; therefore, it cannot be said that, in protecting the plaintiffs in its use, we are assisting in the perpetration of a fraud. It is not contended that the thread to which this label is affixed is an article without merit;

[1] 12 Abb. Pr. R. 237.

while, on the contrary, the testimony at the trial fully established the fact that by its excellence it had acquired a valuable celebrity among dealers, and, besides, has become well-known as the thread of the plaintiffs. . . . The use of the name was not with any fraudulent intent, but, as is stated by Mr. Dale, it arose from the fact that his Christian name is Thomas Nelson, and it is quite obvious that it was used for purposes of identification, and with about the same object as if, instead, he had adopted some familiar emblem, figure, or picture, by which the thread might be designated, and become generally known in the market. The public is not in fact deceived, as it is shown that no such firm exists as Thomas Nelson & Co., who are known to be manufacturers of thread; and the label does not pretend to hold out that any particular manner of manufacturing the thread is followed by which this pretended firm are enabled to furnish a better quality than any one else. Apart from the use of this fictitious firm name, it is not claimed that the label is false in any other respect; and, under the circumstances shown in this case, I think it would be a gross injustice to deny the plaintiffs protection in the use of a trade-mark [1] to which their title has been so clearly established." This is the doctrine held by the court in *Stewart* v. *Smithson*,[2] in the New York Common Pleas Court, *in banc*. After issue joined, the defendants move to amend their answer by adding the following allegations: "And the defendants, on information and belief, state that the mark claimed by the plaintiffs, and set out in the third section of the complaint, viz., 'Hall & Moody's patent thread, Barnsley,' was and is a false and fraudulent mark, used by the plaintiffs to deceive and defraud, and that the thread containing said mark, sold or kept for sale by the plaintiffs, was not and is not patent, and that no patent for said thread has ever existed; nor was said thread manufactured by Hall & Moody, nor by any person or persons their as-

[1] This term is improperly used here. See definition of "trade-mark

[2] 1 Hilt. 119.

signees or successors, nor was said thread manufactured at, or brought from, Barnsley, — all which the plaintiffs well knew." There was also another proposed amendment, involving the same point. The motion was denied, upon the ground that the proposed amendments contained no defence. The defendants appealed. The court, by Brady, J., said that "The mere fact that names used on a trade-mark are fictitious would not authorize the use of it by strangers. The question to be determined in these cases is, whether the mark used by the party claiming the protection of the court is owned by him, without regard to its form, which such party has a right to design according to his judgment or his fancy. If the defendants had alleged that the firm names used on the marks never existed, that would, for the reason stated, furnish no justification for their use of it, and it would not have presented a defence in this action. They have not done so, however, nor have they alleged that firms whose names do appear on the mark did exist, and that the use of their names by the plaintiffs was wholly unauthorized. If they had alleged this, then, in the application of the maxim, *potior est conditio defendentis*, the courts might relieve them from any disturbance by the plaintiffs."

§ 496. **No Defence that Spurious Article is equal to Genuine.** — It is no defence to a suit for assuming a trade-mark, that the simulated article is equal in quality to the genuine.[1] Upon this point the following distinctions are made: If a druggist prepare a certain kind of medicine, and designate it by the name of a superior medicine, invented, prepared, and sold by the plaintiff, and sells it *as and for* the medicine prepared by the plaintiff, the plaintiff may maintain an action against him, without proof of special damage. But where certain medicines are designated by the name of the inventor, as a *generic term*, descriptive of a kind or class, the inventor is not entitled to the exclusive right of compounding or vending them, unless he have

[1] Coats *v.* Holbrook, 2 Sandf. Ch. 586; Partridge *v.* Menck, ibid. 622; Taylor *v.* Carpenter, 11 Paige, 292.

obtained a patent therefor; and if another person prepare such medicines of an inferior quality, and by this means all medicines of this class be brought into disrepute, such inventor can maintain no action for any loss sustained by him in consequence thereof, unless they are sold as and for medicines prepared by him.[1] Moreover, it is no defence that the marks of the spurious goods, or the jobber who sells them to the retailers, inform those who purchase that the article is spurious or an imitation.[2]

§ 497. **Laches.** — So if a plaintiff lie by for a long time before filing his bill for an injunction, the while being aware of the encroachment, that exhibition of laches will be deemed equivalent to a want of good faith. The case of *Beard* v. *Turner*,[3] before Vice-Chancellor Wood, in 1866, affords such an instance. There, it seems, the plaintiff for two years before filing his bill saw done the identical thing of which he complained. The court said: "But suppose you wish to profit by the act of which you say you have a right to complain, and shall at some future period complain of, then I apprehend this court will say, You must come here at once, for this reason, that you ask in your bill for an account of the profits made by this gentleman upon the sale of these goods. The plaintiff may say: 'It may answer my purpose to let the defendant go on selling four or five years, and then at the end of that time to say he is my salesman, and I come for an account of profits.' I know of no instance in which the court has given relief with reference to a trade-mark except on a prompt application. By not complaining at the time when you might complain (I do not say that it is your intention: we must judge of the intention by the necessary result), you are lying by, the man continuing to use your property, with the hope (and such is the prayer in your bill filed two or three years afterward) of obtaining those profits which you stood by allowing him to make under this

[1] Thomson *v.* Winchester, 19 Pick. 214.
[2] Coats *v.* Holbrook, *supra.* [3] 13 L. T. R. (N.S.) 747.

designation, without apprising him of your intention to make any such use of it. On that ground it falls within the principle enunciated, . . . in which it is stated that it is a fraud to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief. You will assume, when he allows another wrongfully to use that which, in the plaintiff's judgment, would facilitate a rival in trade, that being so, unless you come quickly, you must make a rival in trade your agent, for the purpose of carrying on that business, and for the purpose of getting an account at the end of four years. . . . It appears to me, therefore, that if I had come to a different conclusion, it might have affected the question of costs, although it would not have affected the question of relief. I could not give a person an opportunity of lying by, and then asking for an account of the profits made by an injury committed." — In *Harrison* v. *Taylor*,[1] in 1865, the Vice-Chancellor refused an account of profits, on the ground of the plaintiff's delay before commencing suit, although the defendant had persevered in the use of the mark after having been cautioned. — In *The Amoskeag Manufacturing Co.* v. *Garner*,[2] before Barnard, J., at special term, in 1869, a delay of nine years in applying for an injunction to restrain the violation of a trade-mark, was held good cause for refusing relief. The plaintiff alleged that the defendants wrongfully used a trade-mark belonging to the plaintiff and used to stamp cotton cloths. The judge said that the plaintiff had by silence consented to, if it did not encourage, the defendants in the use of the mark in question upon their labels, introducing these prints to the trade generally throughout the country. That, under these circumstances, to deprive the defendants of the use of these labels would work to them great and irreparable injury, wrong, and hardship, and at the same time give to the plaintiff a dishonest and unconscientious advantage as the fruits of the plaintiff's own wrong and negligence. The rule is that the

[1] 11 Jur. (N.S.) 408.

[2] 55 Barb. 151.

plaintiff must not be guilty of any improper delay in applying for relief. He said, further, that the design and object of the plaintiff in enjoining the defendants, at that particular time, from using the said labels, was to produce financial embarrassment by destroying their profitable trade, immediately after the payment by the leading member of the defendants' firm, in pursuance of the terms of his father's will, of the sum of $3,225,000; that to uphold the injunction upon the papers before him would be grossly inequitable and unjust to the defendants; would enable the plaintiff to profit largely by its own wrong and negligence, and thus turn the court into an engine to oppress and destroy, when its true office is to relieve a party from hardship and oppression, and to protect him in the enjoyment of his rights, when they are illegally and wrongfully invaded, or threatened with injury. Injunction dissolved, with costs.

§ 498. **What not deemed Laches.** — When a trader believes that he has good ground for complaining of a colorable imitation of the style of his business, he is justified in waiting until he can collect a sufficient number of cases to show that the alleged attempt has succeeded, before he file his bill; inasmuch as it would not be safe for him to come into court until he could establish actual cases of deception.[1] (This the case of the *Guinea Coal Co.*, in 1869.)

[1] Lee *v.* Haley, L. T. Rep. 22 (N.S.) 251.

CHAPTER XI.

DAMAGES.

When Recoverable. — Presumed in some Cases. — No Fixed and Certain Rule for measuring. — Compensatory. — How measured. — Election of Remedies. — Intent. — Special. — Plaintiff's Negligence. — Exemplary.

§ 499. **When Damages are Recoverable.** — There must be loss legitimately resulting from the unlawful usurpation of a trade-mark, or the plaintiff cannot recover; for if there be no loss, the injury must go unredressed. *It is not sufficient that an* act unauthorized by law has been committed; because for *Injuria sine damno* there is no compensation. Substantial loss to the plaintiff must have ensued by the mal-appropriation of the mark, the right to the exclusive use of which was in the plaintiff, to entitle him to substantial relief. *De minimis non curat lex.*

§ 500. Thus, it would not be sufficient for the plaintiff to prove that the defendant had threatened to adopt his mark, or that he had actually — through an error as to the scope of the copyright law — filed it with the Librarian of Congress; or, through another blunder, had applied for a patent for the design, — for these acts could not have worked to the legal injury of the plaintiff. There being no property in the mere representation of the symbol constituting a trade-mark, as has been before stated and proved, no legal harm could have resulted from a mere imitation of the symbol. The wrong consists in affixing the mark to merchandise which the public purchase, thereby erroneously supposing that it is the product of the

plaintiff. That is the whole basis of a right to damages in such case.[1]

§ 501. **Damages will be presumed** in some cases; as where one intentionally uses or closely imitates another's trade-mark on merchandise or manufactures, the law presumes it to have been done for the fraudulent purpose of inducing the public, or those dealing in the article, to believe that the goods were those made or sold by the latter, and of supplanting him in the good-will of his trade.[2] In such a case at law, nominal damages will be given, although no specific injury shall have been proven.

§ 502. **No Fixed and Certain Rule** for damages can be established, applicable to all cases,[3] — no inflexible or unyielding guide, — but the rule generally recognized as the true one is to give as damages the amount of profits the defendant shall have made by his infringement.[4] As in trials at law the jury are the proper judges of damages where there is no certain measure of damages, the court ordinarily will not disturb their verdict, unless on grounds of prejudice, passion, or corruption in the jury.[5] In all actions on the case, the question is, What is the amount of damages sustained?[6] and that is within the especial province of the jury to answer, after weighing all the testimony; but, as a general principle, a party is entitled to damages corresponding with the amount of injury suffered, however small.

§ 503. **Compensatory** damages should be given. The criterion is indemnity;[7] and in estimating the actual damage, the

[1] Southern *v.* How, 2 Poph. 144; Blanchard *v.* Hill, 2 Atk. 484; Singleton *v.* Bolton, 3 Doug. 293; Blofield *v.* Payne, 4 Barn. & Adol. 410.

[2] Taylor *v.* Carpenter, 11 Paige, 292, and 2 Sand. Ch. R. 603; Blofield *v.* Payne, *supra;* Rogers *v.* Nowil', 5 Man., Gr. & Sc. 109; Coffeen *v.* Brunton, 4 McLean, 516; Marsh *v.* Billings, 7 Cush. 322.

[3] Ransom *v.* The Mayor, 1 Fisher, 252.

[4] Bell *v.* Daniels, ibid. 372.

[5] 2 Greenl. on Ev. § 255.

[6] West *v.* Rice, 9 Met. 564.

[7] Parker *v.* Helme, 1 Fisher, 44.

rule is to give the value of the use of the thing during the illegal user, or, in other words, the amount of profits,[1] as was said in analogous cases of patented machines. The proper measure of damages, in case of violation of a trade-mark, is generally the profit realized upon the sales of goods to which the spurious marks were attached. The actual damages for the infringement would seem, as a general rule, to be all that could be reasonably claimed. There may be exceptions. Cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement.[2] Each case must necessarily depend upon its own circumstances. Thus, where in an action on the case for imitating and using the trade-mark of the plaintiffs', on thread made by the defendant, and selling the same as and for the plaintiffs' thread, a verdict was found for the plaintiffs for eight hundred dollars;[3] and on a motion for a new trial, the court refused to disturb the verdict. Woodbury, J. (who had not tried the case), said that he had little doubt that there was material enough in the case from which to estimate actual damages, such as the probable extent of sales by the defendant under the marks, and the loss of sales and profits thereon to the plaintiffs; and that the jury would, in a case like that, of a known and deliberate intention, often renewed, and very prejudicial to the plaintiffs, not be very nice in their data and inferences, but be sure to give enough to cover all losses, and ample indemnity, — not "smart-money," or "vindictive damages," but full atonement for the wrong done. He said, further, that in a case like that, if in any, no reason exists for giving greater damages than have actually been sustained, or what have been called compensatory;[4] and that there was nothing peculiarly atrocious in the

[1] Wintermute *v.* Redington, ibid. 229; Page *v.* Ferry, ibid. 298; Taylor *v.* Carpenter, 2 Wood. & M. 1.

[2] Nelson, J., in Guyon *v.* Sewell, 1 Blatch. 244. See also Foote *v.* Silsbee, ibid. 445; and Seymour *v.* McCormick, 16 How. 480.

[3] Taylor *v.* Carpenter, *supra*.

[4] Citing Tracy *v.* Swartwout, 10 Pet. 81.

conduct of the defendant to be punished by damages, and in no other way, as a public example. It seems that Judge Sprague, who tried the case, in his charge to the jury, used the term "exemplary damages;" but that language was construed by the superior judge to mean a full indemnity for the individual wrong, in every equitable view, that by example might operate the more effectually in a preventive manner against a repetition of such injuries. He further expressed his opinion that the jury did not give more than was sufficient to make the plaintiffs whole, but rather less than the amount.

§ 504. **How measured.** — Every trespass on property gives a right, at least, to nominal damages.[1] All damages must be *the result* of the injury complained of, to wit, the simulation of the trade-mark of the plaintiff, those which *necessarily* result, termed general damages, being shown under the *ad dammum;* for the defendant must be presumed to be aware of the necessary consequences of his conduct, and therefore cannot be taken by surprise in the proof of them. Where the damages, though the *natural* consequences of the act complained of, are not the necessary result of it, they are termed *special damages*, and are not implied by the law. Therefore, in order to prevent a surprise upon the defendant, they must be particularly specified in the declaration, or the plaintiff will not be permitted to give evidence of them. But where the special damage is properly alleged, and is the natural consequence of the wrongful act, the jury may infer it from the principal fact.[2]

§ 505. But the damages must be proved from the evidence, not from mere conjecture, independent of the evidence.[3] A mere *possible* injury furnishes no ground of damages. In a recent English case,[4] where a bill in equity had been filed to restrain the infringement of a trade-mark, the court offered a decree for an account of profits; but the plaintiffs elected an

[1] Hilliard on Remedies for Torts, p. 404.
[2] 2 Greenl. Ev. § 254. [3] Carter *v.* Baker, 4 Fisher, 404.
[4] Leather, &c. *v.* Hirschfield, Law Rep. Eq. 1867, pp. 298–301.

inquiry as to damages. It was held that the law would not presume that the plaintiffs would have sold the amount of goods sold by the defendant; but the burden of proof was on the plaintiffs to show special damage by loss of custom, or otherwise. The remarks of the court have an important bearing on the subject of remote or contingent damages. "How can the court assume that the persons who bought what the plaintiffs aver were inferior articles, at an inferior price, would necessarily, if they had not done so, have bought the superior articles at the higher prices." In a case [1] where there was evidence that persons were, by false statements of the defendants' agent, induced to leave the plaintiffs' coach, and to go in that of the defendants', that was held to be a fraud on the plaintiffs, and a violation of their rights, for which an action would lie, without proof of actual or specific damages; and that the damages should not be confined to the loss of such passengers as the plaintiffs could prove had actually been diverted from their coaches to those of the defendants; but that the jury would be justified in making such inquiries as to the loss of passengers and injury sustained by the plaintiffs as they might think were warranted by the whole evidence in the case. When it was stated in the declaration, and proven on trial, that the defendants had obtained some of the plaintiff's wrappers, and used them to palm off inferior articles — metallic hones for sharpening razors, &c. — as the manufacture of the plaintiff, Denman, C. J., stated to the jury that even if the defendants' hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by the fraudulent acts of the defendants. The jury, having found for the plaintiff, with one farthing damages, stating that they thought the defendants' hones were not inferior to the plaintiff's, it was held, *in banc*, that the act of the defendants being a fraud upon the plaintiff, even if it occasioned him no specific damage, it was still, to a certain extent, an injury to

[1] Marsh *v.* Billings, 7 Cush. 322.

his right. This case makes it clear and conclusive that a plaintiff may recover without proof of special damage.[1]

§ 506. **Election of Remedies.** — He whose rights are infringed has his election of remedies. He may proceed in equity for the profits the defendant has made, or he may sue at law for the loss he has suffered.

§ 507. In the first case, if the defendant has realized no profit, there can be no recovery; in the second, he may recover the damage he has sustained, whether the defendant has made any profit or not. He may treat the infringer who illegally appropriates an invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. In such case, the plaintiff may recover those profits, be they more or less; and he can recover no more, however great the damages may be which the alleged interferer has occasioned. If, on an accounting, it should appear that the defendant used the invention so unskilfully that he realized no profit, there could be no recovery. On the other hand, the patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not.[2]

§ 508. **Intent.** — A wrongful or malicious intent, express or implied, is an essential and prominent element in determining the amount of damages to be awarded. The general rule is that it is of no consequence whether the defendant intended the injury or not. In civil actions, the law does not so much regard the intent of the actor as the loss or damage of the party suffering.[3] Yet in actions for the invasion of patent-rights, the intent is generally considered, as in a case where the maker of a machine appears in truth to be ignorant of the existence of the patent and does not intend any infringement;

[1] Blofield *v.* Payne, *supra*. See also Rogers *v.* Nowill, *supra*.
[2] Woodruff, J., in Cowing *v.* Rumsey *et al.*, 4 Fisher, 275.
[3] Johnson, J., in Auburn, &c. *v.* Douglass, 12 Barb. 557.

and though this will not altogether exonerate him, it will tend to mitigate the damages.[1]

§ 509. **Special Damages.** — The right to recover special damages, *i.e.*, damages additional to the amount of direct and immediate injury, often depends upon the allegations in the writ. Such damages must be specially alleged, solely for the purpose of giving the defendant notice of the plaintiff's demand with regard to them; while, as before said, he is held to take notice of such damage as is the necessary consequence of his act, without any special allegation, and without any statement of the particular circumstance of aggravation. It is rarely in actions for the violations of trade-marks that the right to such damages can be fairly established.

§ 510. **Plaintiff's Negligence.** — In assessing damages, the direct and immediate consequences of the injurious act are to be regarded, and not remote, speculative, and contingent consequences, which the party injured might easily have avoided by his own act. Suppose a man should enter his neighbor's field unlawfully, and leave the gate open; if, before the owner know it, cattle enter and destroy the crop, the trespasser is responsible. But if the owner see the gate open and pass it frequently, and wilfully or obstinately, or through gross negligence, leave it open all summer, and cattle get in, it is due to his own folly. So, if one throw a stone and break a window, the cost of repairing the window is the ordinary measure of damages. But if the owner suffer the window to remain unrepaired a great length of time after notice of the fact, and his furniture or pictures, or other valuable articles, sustain damage, or the rain beat in and rot the windows, the damage would be too remote.[2]

§ 511. We may apply the doctrine thus laid down by the eminent jurist to the case of one who stands by, and calmly

[1] Bryce *v.* Dorr, 3 McLean, 583; Whittemore *v.* Cutter, 1 Gallison, 429; Jones *v.* Pearce, Webster's Pat. Cases, 125; Hogg *v.* Emerson, 11 How. 587–607. See also Lowell *v.* Lewis, 1 Mason C. C. 182.

[2] Shaw, C. J., in Laker *v.* Damon, 17 Pick. 284.

sees another pirate his mark. He may sustain many injuries that by prompt action he might have avoided. Legal relief, at best, is but part indemnity. The law in fact aims not so much at satisfaction as at a division of the loss.

§ 512. After a review of the few cases bearing directly upon the question under discussion, — that is, the true principle for the measuring of damages in trade-mark infringements, — we relapse into uncertainty, and despair of finding any nicely-adjusted scheme to solve the problem. The infringement of a mark at one time may be destructive of the trade of the true proprietor; and at another time, and under similar circumstances, it may be comparatively harmless. An article of trade may have an ephemeral popularity which is an immediate fortune to its producer, or it may be a thing of limited sale, yet of continuing demand. All the surrounding facts must therefore be weighed by the jury, or referee, as the case may be, and although of as little account singly as the dust in the balance, yet in the aggregate they may cause the scale to kick the beam. Look at such a case as *Gillott* v. *Esterbrook*,[1] and the power of the grouping of seemingly insignificant minutiæ, to make a convincing proof of fraudulent intent, will be plainly perceptible.

§ 513. In many classes of cases of injury to property, the estimate of damage can easily be made, either by the value of an article destroyed or wrongfully converted, or by a previous liquidation. Thus for the infringement of a copyright, the legislature has laid down certain rules to meet all cases; but when we turn to infringements of patent-rights, and attempt to reason from analogy, we find great difficulty. In *Conover* v. *Rapp*,[2] Ingersoll, J., said that the plaintiff is entitled to such actual damages as he has sustained; and that the actual damages are the profits which the defendant has made. This was a case of infringement of a patent for a machine for splitting wood; and evidence having been given that the defendant used

[1] 47 Barb. 455.

[2] 4 Fisher, 57.

the machine, and also of the amount of wood split by him during each day, the plaintiff calculated from that what the actual damages were. The court instructed the jury that a plaintiff is not able, with the utmost accuracy, in cases of that kind, to give the exact amount of damages that he has sustained. It is beyond his power. He does the best he can. If he is wrong in his calculation, the defendant can put him right. The defendant knows the profit he has made. Therefore, said he, the jury must take the evidence as it is, and come to the best conclusion they can as to what are the actual damages. The jury having found a verdict for the plaintiff, the defendant moved for a new trial before Mr. Justice Nelson. He delivered the opinion that there was no error in the charge of the judge, and denied the motion. Sawyer, J., said, in *Carter* v. *Baker*,[1] that the profits made by the defendants are proper to be given as a part of the damages; and that the jury might take into consideration other losses caused by the infringement, beyond those profits actually received by the defendants. In a late patent case (*Cowing* v. *Rumsey et al.*[2]) Woodruff, J., laid down the rule somewhat more specifically, the true rule being what the plaintiff has lost, and not what the defendant has gained. He said that, "in such an action, it is precisely what is lost to the plaintiff, and not what the defendant has gained, which is the legal measure of the damages to be awarded. Under this rule it may often be entirely proper to prove the profits of the ordinary use of the invention, and the demand existing in the market, evidenced by sales made, and so, as an element of consideration, show the profits realized by the defendant, in order to furnish to the jury all proper materials for determining how much the plaintiff has lost. But I apprehend that they are to answer the precise question, How much loss has the plaintiff sustained by reason of the defendant's infringement? . . . There may be cases so peculiar that there are no means of proving the plaintiff's loss without proving the defend-

[1] 4 *Fisher*, 404.

[2] *Ibid.* 275.

ant's profits, and such proof becomes clearly admissible; but, even then, the recovery is what the jury shall find to be the plaintiff's loss, not because the defendant realized profits, but because, under all the circumstances, the jury infer, as a fact, but for the interference, the plaintiff would have realized those profits. It may be said, with some plausibility, that the plaintiff's damages may sometimes be greater than the profits which the defendants have made, but ought never to be considered less; and that the defendants having illegally infringed, should always be held to the presumption that the plaintiff would have made as much as they have realized, and should not be permitted to retain any of the fruits of their illegal conduct, by showing that the plaintiff could not have manufactured or used the invention so profitably." This reasoning is lucid and satisfactory, so far as applicable to a patent case, but should not be strictly applied to a trade-mark infringement.

§ 514. A patentee is presumed to have employed genius, or talent, at least, and to have expended time and money upon his invention; and in consideration thereof he is allowed, for a limited time, a monopoly of the thing invented. No one else in the country which grants the patent has a right to vend or use the article. All profits from its sale or use belong to the patentee or his assigns. The trade in it is absolutely his during the lifetime of the patent. Not so the traffic in merchandise to which a trade-mark may be attached; for a thousand persons may have a perfect right to manufacture and sell the same class of goods, and of the same quality and value, and yet but one person have a right to impress those goods with a certain peculiar symbol. It may be that the infringer has facilities for selling a hundred times as much as he whose mark is imitated. Would the small dealer be entitled to receive as damages a hundred times as much profit as he could possibly have made? Reason forbids it. Courts would regard such a rule in a trade-mark case as extravagant and mischievous.

§ 515. Trade-mark and patent cases, therefore, cannot be

controlled by the same inflexible rule of measurement of damages for infringement. We are unembarrassed in a patent case where the patentee has adopted a patent-fee as one mode of remuneration, and in the fee has fixed his own measure of the value of the use of the machine for the entire term, or until that particular machine is worn out, and the computation is readily made ;[1] for if the patentee has an established price in the market for his patent-right, or what is called a patent-fee, that sum with the interest constitutes the measure of damages.[2] In one case, the plaintiff insisted that he was entitled to recover for the infringement the full amount which he would himself have made on the articles sold, had he manufactured and sold them himself, upon his own established terms. He gave evidence showing the price at which he sold, and the profits realized upon sales at those prices ; and the court adopted those profits as the measure of damages, and gave him the benefit of the rule, so far as the damages could be ascertained from the testimony.[3] But notwithstanding this will not be applicable to all cases of trade-mark infringements, we can understand perfectly well how the analogy may be of assistance. Let us take an example : —

§ 516. The plaintiff has the exclusive right to vend by a fanciful designation a certain article, the secret of the manufacture of which he possesses. It is well-settled as matter of law, that he has no exclusive right of property in the compound itself, it not being patented ; consequently, if any one by fair means discover the secret of manufacture, he may go into competition with the inventor himself, in obtaining the patronage of the public in the sales of the very article.[4] But we set out with the fact that the plaintiff has the exclusive title in the name of the article, the said name being an arbi-

[1] Spaulding *v.* Page, 4 Fisher, 641.

[2] Sickles *v.* Borden, 3 Blatch. 536.

[3] Spaulding *v.* Tucker, 4 Fish. 633, as cited by the court in Spaulding *v.* Page, *supra*.

[4] Davis *v.* Kendall, 2 R. I. 566.

trary symbol, and possessing all the essentials of a lawful trade-mark. The public know the article by that name, and would not buy it under any other. If the defendant sell the identical compound, a knowledge of the ingredients of which he may have obtained by chemical analysis, he may do so without hindrance, provided he do not sell it under the name given to it by the plaintiff; but if he do so sell it, he is guilty of infringement of the mark. The number of articles sold by the defendant being ascertained, we have a means of measuring the damages, by applying the rule in patent cases. The presumption must be that the plaintiff would have made all the sales, had it not been for the alleged conduct of the defendant.

§ 517. The courts of equity seem to indicate a rule for measuring damages, by their practice of ordering the defendant to keep an account of sales of merchandise bearing the simulated mark, to the end that they may be paid as indemnity to the complainant. But that this is an exceedingly fallacious guide in actions at law must be manifest, for many circumstances may conspire to cause injury from the improper use of the mark, and many of such circumstances must be taken into consideration, in assessing damages. Unfair competition may cause a loss of reputation and good-will, and depreciation of the class of goods sold by the parties. Sawyer, J., in *Carter* v. *Baker*,[1] told the jury that they might take into consideration that fact that the plaintiffs, by the infringement, may have sold their articles at a higher price than the defendants had received; and yet, he said, that only those damages which directly and immediately flow from the wrongful act can be considered, and that remote consequential damages must be discarded.

§ 518. No wrong-doer can be allowed to apportion or qualify his own wrong. As a loss has actually happened whilst his wrongful act was in operation and force, and which is attribu-

[1] 4 Fisher, 404.

table to his wrongful act, he cannot set up as an answer to the action the bare possibility of a loss, if his wrongful act had not been done.[1] The disposition of the courts, in such case, is to make the wrong-doer liable for injurious consequences flowing from the illegal acts, although they be very remote.

§ 519. **Exemplary Damages.** — In the case of *Day* v. *Woodworth*, in the Supreme Court of the United States,[2] Mr. Justice Grier, in delivering the opinion of the court, said: "It is a well-established principle of the common law that in actions of trespass, and all actions in the case for torts, a jury may inflict what are called exemplary, punitory, or vindictive damages upon a defendant, having in view the enormity of his offence, rather than the measure of compensation to the plaintiff. . . . By the common, as well as by statute law, men are often punished for aggravated conduct or lawless acts by means of a civil action, and the damages inflicted by way of penalty or punishment given to the party injured. . . . And the damages assessed in the circumstances, showing the degree of moral turpitude or atrocity of defendant's conduct, may properly be termed exemplary or vindictive, rather than compensatory."

§ 520. Thus, one who shall counterfeit — a term implying deliberation and intent, as contradistinguished from a casual imitation — will be held to a more grave responsibility than another who unwittingly may have copied a rival's mark.

[1] Tindal, C. J., Davis *v.* Garrett, 6 Bing. Rep. 716 (19 Eng. C. L. R. 212).
[2] 13 How. 363.

CHAPTER XII.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS.

Classification. — Good-will of Trade. — Name of Firm, Business, &c. — Signs. — Firm-name on Dissolution of Partnership. — Representations on Shop-fronts. — Use of Word "Original," or Equivalent Expression. — Use of Firm-name after Dissolution of Partnership. — Labels and Wrappers. — Author or Publisher's Right to Name of Publication. — Names on Omnibus-coach. — Secret Process. — Breach of Faith.

§ 521. THERE are two species of property which are protected by courts, on principles analogous to those on which rest the decisions in cases of trade-marks proper. These are, the good-will of a trade, so far as it is contained in the style or title of a partnership, or the name of a trader, or the description of his place of business, or peculiar manufacture or product, and labels and wrappers of goods; and property in a name or distinguishing style, as connected with a literary publication, or a work of art. There is another class of cases, too, which must not be entirely omitted from consideration, — those in which the interference of a court has been grounded on the general doctrine of the prevention of damage arising from a breach of trust, or confidence. By this method of classification, many cases may be considered under one general head.

§ 522. **Good-will.** — The authorities in general describe the good-will of a trade as "a probability that the old customers will resort to the old place." [1] Judge Story [2] says that it may be described to be the advantage or benefit which is acquired by

[1] Howe *v.* Searing, 10 Abb. Pr. R. 264; 6 Bos. 354, and 19 How. Pr. R. 14.
[2] Partnership, § 99.

an establishment, beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position, or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices. Thus, a nursery of trees and shrubs, a favorite fashionable stand, or a newspaper establishment, may and often does enjoy a reputation and command a price beyond the intrinsic value of the property invested therein from the custom which it has obtained and secured for a long time; and this is commonly called the good-will of an establishment.

§ 523. The extent to which a good-will is protected is fully illustrated in *Crutwell* v. *Lye*,[1] as is also its nature. In that case, the good-will consisted in certain premises in Bath and in Bristol, which were sold by the assignees in bankruptcy of one of the defendants, Edward Lye, who had, for some years, together with his father, George Lye, carried on the business of a carrier from Bristol through Bath to London; the same parties having also a carrying business from Bristol through Salisbury and Warminster to London. At the sale, the whole of the premises of the Messrs. Lye, and their business as carriers from Bristol through Bath to London, and the good-will of that business, was sold in one lot to the plaintiffs; the carrying business from Bristol through Warminster and Salisbury being put up for sale separately, and eventually bought by friends of E. Lye, the defendant, who then set him up in that business. The question was, whether the defendant, according to the facts stated, was really carrying on his own trade, and not that of the plaintiff. A person having sold a house and stock in trade is, in the absence of any special covenant, at liberty to set up a similar business the very next door to his former shop or warehouse. That is merely a fair case of competition in

[1] 17 Ves. 335.

trade; but he must not, under color of chalking out a different course of trading, really carry on, for his own benefit, the trade of others. Lord Eldon considered that the facts in that case were not sufficient to prove a fraudulent design on the part of the defendant. He said that they amount to no more than that the defendant asserts a right to set up this trade (the carrying business), *and has set it up as the like, but not the same trade with that sold*, taking only those means that he had a right to take to improve it.

§ 524. In *Peterson* v. *Humphrey*,[1] it was held that an injunction will lie, at the suit of one against his former copartner, restraining the continuance of the use of the signs containing the old firm name, without sufficient alterations or additions to give distinct notice of a change in the firm. The parties were in business on Broadway, in the city of New York, and failed. Some arrangements were made with their creditors, by which they were enabled to enter into a new business, which each did on his own account, — Humphrey at the former store in Broadway, and Peterson in Canal Street. Before the failure, there was a broad sign above the second story of the store on Broadway, in the name of the firm, "Peterson & Humphrey," and another over the entrance-door. Peterson requested Humphrey to remove those signs, and receiving a refusal, obtained an injunction to prevent the use of them. Before that, the sign on the door had above it the name of the old firm, and the word "formerly," so as to read "Humphrey & Co., formerly Peterson & Humphrey." The court said that this last sign was true, and nobody could be deceived by the last words; but the sign above the door might mislead, and the injunction against it should be sustained. — In *Howe* v. *Searing*,[2] the plaintiff, a baker by trade, sought to restrain the defendant from designating the bakery establishment kept by him at No. 432 Broadway, in the city of New York, as

[1] 4 Abb. Pr. R. 394.

[2] 10 Abb. Pr. R. 264; 6 Bos. 354, and 19 How. Pr. R. 14.

"Howe's Bakery," and from otherwise using the name of "Howe" in the business, so as to induce the public to believe that the business carried on at 432 Broadway was conducted by the plaintiff. Upon the trial at special term, it was proved that, eight years before, the plaintiff carried on a large and lucrative business at 432 Broadway, and during all the time he carried on the business the premises had been known as "Howe's Bakery," and had gained great celebrity by that name. Howe then sold out his lease of the premises, and all the stock, wagons, and fixtures used by him in the business, together with the "good-will" of the concern. After the sale of the business-stand and good-will, Howe, by agreement with his vendee, obtained the privilege of resuming the business at another stand, covenanting not in any manner to interfere with the business carried on at the former stand, known as "Howe's Bakery." *Held*, that this was no recognition of the vendee's claim to use the name of "Howe." On appeal from the judgment in plaintiff's favor, the decision was affirmed by a majority of the court. Hoffman, J., said that the case was decided upon all the authorities found bearing upon it. But it is to be noticed that, under a statute of the State of New York, passed April 29, 1833, "to prevent persons from transacting business under fictitious names," no person has power to transact business in the name of a person not interested in his firm; and that act would have been sufficient to warrant the decision made. By a statute passed April 17, 1854, a copartnership name may be continued by some or any of the copartners, their assignees or appointees, upon filing and publishing a certificate; but that provision applies only to firms having business relations with foreign countries. The court, independent of any regard to the statute, recognized the principle, as one of public policy, that business must be transacted under the name of the real parties doing it, and not under other names.

§ 525. This decision fully accords with the law of France in relation to commercial partnerships. By the 21st article of

the Code of Commerce, the name of the associates can alone constitute the firm name (*la raison sociale*). This is intended to forbid persons who succeed to the business of a deceased merchant from continuing it under his name. "Credit," said Hoffman, J., in commenting upon said article, "is altogether personal. It does not transmit itself by cession or inheritance. It is won by actions and capacity. It is not right, then, that a successor should avail himself of a fallacious credit in appropriating a firm's name extinguished by the death of one of those who gave it the value."[1]

§ 526. It has been a question whether the right to use the firm name is a part of the good-will belonging to the partnership, or whether, in case of the dissolution thereof by the death of the partner, it belongs to the survivors. That the right to use the name of a known and celebrated firm in the case of manufactures is often a very valuable possession, is unquestionable; and, therefore, courts of equity will often interpose to protect the right against the abuse of third persons, in using it for their own advantage.[2] But it has been thought that this right does not fall within the true character and nature of good-will; but that it belongs to the surviving partner. The case of *Lewis* v. *Langdon*[3] illustrates the notion of property in a partnership-name, as a species of good-will attached, not to the place of business, but to the name of a firm, or of a trader. In this case, Vice-Chancellor Shadwell held that a surviving partner had, on the death of his copartner, a right to carry on the business under the designation of the original firm; for that the good-will arising from the use of a particular designation was, during the partnership, the joint property of the firm, and became on the death of one of the partners the sole

[1] See the case of Compere *v.* Bajon *et als.*, §§ 209–211, *ante*.

[2] Story on Partnership, § 100; Story on Eq. Jur. vol. ii. § 951; Eden on Inj. ch. 14; Motley *v.* Downman, 3 Mylne & Craig, 1, 14, 15; Millington *v.* Fox, ibid. 338; Knott *v.* Morgan, 2 Keen, 213, 219; Webster *v.* Webster, 3 Swanst. 490, n.

[3] 7 Sim. 421.

property of the survivor. He, however, while granting the injunction, directed the plaintiff to bring his action at law. — But this opinion does not seem to have been generally acquiesced in. Hoffman, J., in rendering the decision of the court in *Howe* v. *Searing*,[1] intimates that it is a well-settled rule that the good-will of a partnership business does not survive to a continuing partner; and that it belongs to the firm as much as the ordinary stock in trade. He said that the case of *Lewis* v. *Langdon*, which seems to assert a different rule, is not the law of the court on this point. He referred to the decision in *Hammond* v. *Douglass*,[2] which explicitly asserts a different doctrine, speaking of the good-will generally; and decides that a sale of it cannot be compelled by the representatives of the deceased partner; and that it is not partnership stock of which the executor may compel a division, but belongs of right to the survivor. But in the case of *Dougherty* v. *Van Nostrand*,[3] before him as assistant Vice-Chancellor, he had thought that case could not be supported; and the opinion in the last-mentioned case had been acted on and approved in other cases.[4] — Perhaps, says Lloyd,[5] *Churton* v. *Douglass*[6] approaches more nearly than any other of the numerous cases on good-will to the case of a trade-mark. There, the defendant had, in 1857, received a considerable sum from the plaintiff, upon a dissolution of partnership, for the purchase of "all his known rights and interests in the partnership business and the good-will thereof." The plaintiffs carried on the old business under the name of their new firm, "late John Douglass & Company." Four months afterwards, the defendant again set up his old business, in partnership with other persons, under the firm of "John Douglass & Company." The whole question, as in *Crutwell* v. *Lye*, before referred to, was whether, upon all the circumstances, this was an attempt to set up, not a business

[1] See *ante*. [2] 5 Ves. 539.
[3] 1 Hoffm. Ch. R. 68.
[4] Williams v. Wilson, 4 Sand. Ch. R. 379.
[5] Trade-marks, 35. [6] Johnson, 174, 7 W. R. 365.

similar to the old one, but the identical business : and the court coming to the conclusion that such was the defendant's intention, granted an injunction, although the defendant's name was John, and the style was genuine. — In *Howe* v. *Searing*, Monerieff, J., took the ground, in his dissenting opinion, that the words " Howe's Bakery " were nothing but a trade-mark, and as such passed by the assignment and transfer of the good-will, and, if not the thing itself, it was an integral part of it. He was unquestionably in error in the use of the term *trade-mark*, and in his conclusion of law he is without the support of authorities.

§ 527. In the Tribunal of Commerce of Paris, in 1857 (*Bautain* v. *Merecklein*[1]), it appeared that Bautain and wife had sold to Merecklein and wife their establishment as opticians. Among other conditions, it had been stipulated that the defendants, as successors, might avail themselves of the name of Bautain as found convenient ; but the Bautains reserved the right to continue to carry on another place of business which they had established in another street from that of their former place. The defendants used as a commercial designation the formula, — *Maison Bautain*, *Bautain Opticien*, without the addition of the words *Merecklein*, *successeur*, whereupon the plaintiffs brought suit for damages for violation of contract in making a false representation. It was held, in the first instance, that the defendants had obtained the right to use the name of Bautain on their signs, cards, &c., and the case was dismissed, plaintiffs to pay the costs. The plaintiffs appealed. The judgment below was reversed, on the ground that it was only in the quality of successors in business that the respondents had the right to use the name of Bautain ; but as no appreciable injury had resulted to the appellants, no damages were allowed. To suppress the evil for the future, the court forbid the respondents Merecklein to inscribe the name of Bautain on their invoices, addresses, and signs, otherwise than as successors of the said Bautain and

[1] Annales de la Prop., tome iii. p. 207.

wife, that quality to be expressly mentioned in conjunction with the name of Mercklein. The respondents were adjudged to pay the costs of the trial and the appeal. — In the Tribunal of Commerce of Marseilles, in 1861 (*Laurens* v. *Laurens*[1]), it appeared that the plaintiff, Gustave Laurens, had, ever since 1836, carried on the pharmacy founded by his uncle, Joseph Laurens, in 1814, with this sign: "PHARMACIE LAURENS." The plaintiff signed his name as "G. Laurens," and so was generally known. His cousin, the defendant, Paul Gustave Laurens, established a pharmacy in the vicinity of that of the plaintiff, and had for his sign "G. Laurens." The court ordered that the defendant should qualify his designation, suppressing the name of "Gustave." — In the Court of Bourdeaux, in 1865 (*Caminade & Co.* v. *Caminade*[2]), it was held, that although in case of similarity in the names of two merchants, in the same line of business, the later comer is not obliged to suppress the name of his firm on his marks and labels, nevertheless he can be adjudged as an instance of good-faith to add his distinctive designation. The defendant had announced in circulars that he had founded at Cognac a mercantile house, under the name of Ad. Caminade, for the purchase and sale of Cognac brandies. It was shown by him that, in his correspondence with his agents, he had notified them not to confound his house, just commenced, and the ancient house of Caminade, with which he had no connection, of either kinship or interest. Good-faith was shown. The court held that every person has a perfect right to use his patronymic, in commerce as in any thing else, subject, however, to the condition of being distinguished as much as possible from any other in the same trade. It was *ordered*, that the defendant's full name appear, thus: Adrien Caminade. This was affirmed on appeal, the defendant spontaneously agreeing to add to his labels, &c., the words "*Maison fondée en* 1864," so as to prevent any possible confusion. — So, also, in the Tribunal of Commerce of the Seine, in 1857 (case of *Pinaud & Amour*

[1] Annales de la Prop., tome viii. p. 221. [2] Ibid., tome xiii. p. 268.

v. *Pineau*[1]), where the names, although differently spelled, were *idem sonans*. It appeared that the plaintiffs had carried on a hat-store, founded twenty-five years before at No. 87 Richelieu Street, in Paris, by Juste Pinaud; and that the defendant quitted another street formerly occupied by him, and established a hat-store at No. 91 Richelieu Street. It was charged that he did this to profit by the similitude of name to draw away the custom of the plaintiffs. The defendant contended that he had a perfect right to remove into the street mentioned, and that the difference in the spelling of the two names was quite sufficient to avoid confusion; and, as a subsidiary precaution, he offered to prefix his baptismal name of *René*. PER CUR.: Whereas Pinaud & Amour are proprietors of a hat establishment in Paris, in Richelieu Street, 87, and known for twenty-five years under the name of "MAISON PINAUD;" and whereas Pineau, a hatter previously of the street Fossés-Montmartre, has recently established himself at No. 91 of the aforesaid street, and, with the intention of profiting by the similarity of names, he has placed over his store "MAISON PINEAU;" and whereas he employs for the lining of his hats an escutcheon which is a servile imitation of that adopted by Pinaud & Amour, all of which has been done to divert to himself the custom of the old house of Pinaud; now, although he has an incontestable right to establish himself under his true name, and to place that name upon his place of business, yet he must be interdicted from unlawful competition; and measures must be taken to prevent confusion in the mind of the public between the two houses. *Ordered*, that the defendant suppress the word *Maison*, which in the usages of commerce indicate an establishment of ancient date and reputation; also, that he change the escutcheons chosen by him and placed on the lining of his hats; and, finally, that the name of Pineau shall be preceded by the prenomen *René*, and that these two names shall be placed over both fronts of his store, and on his invoices and

[1] Annales de la Prop., tome iv. p. 86.

letters of commerce, on the same line, and in the same characters. This judgment was to be inserted in two newspapers selected by the plaintiffs, the defendant to pay costs of advertisement and suit. The defendant accepted the condemnation, but he executed it in a tardy manner, and in a way indicative of bad faith. He placed his name, René Pineau, on his principal sign; but on the glass of his entrance-door he left the sole name of Pineau. Besides that, his shop having two fronts, the one on Richelieu Street and the other on Saint-Marc Street, he had placed his surname on one street, and his baptismal name on the other, so that passengers on Richelieu Street, who were more numerous than those on Saint-Marc Street, would see but the name of Pineau. He was again brought into court. For his reprehensible subterfuge in attempting to continue his unfair competition to the damage of the plaintiffs, he was condemned to pay them 2,000 francs, and the costs. — In the same court, in 1858 (case of *Bonnet et als.* v. *Henry Delisle*[1]), it appeared that the sign of the *Maison Delisle* belonged for a long time to a house of commerce, to which name the founders and their successors the plaintiffs attached a very great importance. The defendant, whose place of business was *not* in the same street with that of the plaintiffs, used the same designation of "Maison Delisle," without any thing to distinguish his establishment from that of the plaintiffs. *Ordered*, that for the future the defendant cease to designate his place of business under the simple denomination of "Maison Delisle;" and that he pay the costs. — And in the same court, in 1857 (case of *Chevet* v. *Lemasson*[2]), it was held that when members of the same family, or merchants bearing the same name, have created rival establishments, the proprietor of the most ancient has the right to preserve the qualification of *Maison*, or *Ancienne Maison*, and in case of possible confusion, the junior should be compelled to add his quality of successor on his signs and prospectuses. — In the Court of Paris, in 1858 (case of *Ter-*

[1] Annales de la Prop., tome iv. p. 301.

[2] Ibid., tome iv. p. 330.

naux v. *Bournhonet*[1]), it was held that the successor, however far removed, of a house of commerce, has a right to put on his bills and signs the name under which his house was founded.

§ 528. Courts of equity will protect a party in the use of a sign of an inn, hotel, or other place of business, where the sign or the name is simulated so as to deceive, or be calculated to deceive customers. The adjudged cases proceed solely on the ground of a valuable interest acquired in the good-will of the trade or business. At the foundation of the principle is the idea of falsehood. If a man create a reputation for his business, it is as the keeper of some particular house at a known location, and it is piracy to draw off the custom of his friends or customers who have identified him with the name of his house. It is a personal right. By giving a particular name to a building, as a sign of the hotel business, a tenant does not thereby make the name a fixture to the building, and the property of the landlord upon the expiration of the lease, as was decided by the Supreme Court of California, in *Woodward* v. *Lazar*.[2] One may consent to the employment of his name to designate a place of refreshment; but if such consent be purely gratuitous, or unless there is some valid agreement binding upon the party who gives his consent, he may withdraw it at pleasure, and its further use will be enjoined, as in *McCardel* v. *Peck*.[3] And a court of equity will protect by injunction the name of an enterprise undertaken for the amusement of the public, as in *Christy* v. *Murphy*.[4] — Even although one's place be designated by two names indiscriminately, a colorable imitation of the title will be enjoined.[5]

§ 529. In France this protection is frequently granted. In the Tribunal of Commerce of the Seine, in 1857 (case of *Dorvault* v. *Hureaux*[6]), the plaintiffs had for about twenty-five

[1] Annales de la Prop., tome iv. p. 331.
[2] 21 Cal. 448.
[3] 28 How. Pr. R. 120.
[4] 12 How. Pr. R. 77.
[5] Howard v. Henriques, 3 Sand. S. C. 725.
[6] Annales de la Prop., tome iv. p. 125.

years used as a sign, and upon their labels, circulars, and prospectuses, the words "PHARMACIE CENTRALE DE FRANCE." The defendants had as their sign the words "PHARMACIE RATIONELLE," but added thereto the words "CENTRALE DE FRANCE." This fact was recognized by the court as an attempt to create confusion between the two establishments, and the defendants were prohibited from the further use of the latter-mentioned words, as was also done in a case between the same plaintiff and *Teissier & Co.*,[1] the year following. — In the same court, in 1858, came up the case of *Schorthose* v. *Hopp*,[2] two Englishmen, cousins-german and pharmacists, and former fellow-students in the office of one Robert. The plaintiff, as successor in business of Mr. Robert, claimed the designation of "LONDON DISPENSARY," under which his pharmacy was known, and also the title of "PHARMACIE DE L'AMBASSADE D'ANGLETERRE." The defendant pretended to have certain rights in Robert's pharmacy, and accordingly used similar names and titles at his store in another street from that in which the plaintiff's was situated. When summoned before the court, for encroachment upon the plaintiff's rights in that respect, the defendant disclaimed all right to the said name and title; but subsequently he took the designations of "LONDON DISPENSARY," and of "ENGLISH EMBASSY CHEMIST." This was held to be an infringement, and defendant was forbidden to further use those titles to designate his place of business, and condemned to pay 500 francs damages, and the costs. — In the same court, in 1859 (case of *Lemercier* v. *Millin*[3]), it was shown that Claude Bully had given his name to an aromatic toilet-vinegar, of which he had transmitted the recipe to Jean-Vincent Bully. The plaintiffs had purchased from the latter his business and the sign of the inventor. The defendant made and sold a toilet-vinegar under the name of "Bully," with the sign "AU TEMPLE DE FLORE." Judgment for plaintiffs. — In the court of Paris, in 1862 (case of *Muller* v. *Compagnie immobilière*[4]),

[1] Annales de la Prop., tome iv. p. 298.
[2] Ibid., p. 255.
[3] Ibid., tome v. p. 360.
[4] Ibid., tome viii. p. 265.

it appeared that the plaintiff had for more than fifteen years carried on a hotel known as the "HÔTEL DE LA PAIX," situate at the angle of the street *de la Paix* and the boulevard of the Capucines. The defendants built a hotel on the same boulevard, and gave it the same name as the plaintiff's. The court below — the Tribunal of Commerce of the Seine — had declined to completely suppress the name thus assumed by the defendants, but accepted their offer to adjoin the word "Grand," and ordered that their sign be altered within the period of two months, so that — in letters all of the same size — it should read "GRAND HÔTEL DE LA PAIX." On appeal, it was held that the words "HÔTEL DE LA PAIX" were indicative and characteristic of the hotel owned by Muller, and that those words could not be employed by others in the same business without violating his rights. A few weeks later, the same parties were again before the court. Muller complained that, notwithstanding the judgment in his favor, the defendants continued to announce in the newspapers their hotel under the interdicted name; and that the napkins and towels for table and toilet, the bills of fare, &c., of the new hotel were thus marked; and the letters "H. P." — an abridgement of the sign — were engraved upon the glass-ware, the bottles, and the plate. The defendants replied that the initials "H. P.," and even the words "Hôtel de la Paix" on the linen, all used in the interior of the establishment, could not prejudice the plaintiff, especially the use of the letters "H. P.," which had no precise sense. They also alleged that the interior arrangements had all been ordered and executed long before the first suit, and argued that the order of the court would not admit of such stringent interpretation as to prevent even the temporary use of the articles mentioned. *Held*, that the letters "H. P." on the porcelain, glass, vessels, silver, cutlery, and divers utensils placed at the disposition of guests, for a purely internal purpose, did not in contemplation of law prejudice the plaintiff. But, although the defendants acted without a fraudulent intent, the use of

the words "Hôtel de la Paix" was a damage to the plaintiff. They were accordingly forbidden to let those words appear on objects either on the exterior or in the interior of their new hotel. But in consideration of all the circumstances, and the hardship that would result from instant suppression, the court granted a delay of six months for the removal of the words "*de la Paix*" from the linen and furnishing-articles; and allowed the plaintiff his costs.

§ 530. **Partnership dissolved.** — Upon a dissolution of partnership, each of the partners has a right, in the absence of a stipulation to the contrary, to use the name and style of a partnership firm.[1] The principles of this case are very plain and simple, and are well-settled by authority. The name or style of the firm "Banks & Co." was an asset of the partnership; and if the whole concern, and the whole good-will had been sold, this was a trade-mark or asset which might have been sold with it. But if the partners chose to divide the partnership assets, each is at liberty to use the trade-mark just as much as before. *Held*, that both are entitled to use the style or firm of "Banks & Co."

§ 531. **Representations** contained on the blinds and brasses of a shop-front, calculated to induce the public to believe that the owner is conne[illegible]n business with a firm of established reputation, wil[illegible]sidered upon the same principles as govern rights i[illegible]-marks. In *Glenny* v. *Smith*,[2] it appeared that the defend[illegible]had been employed by the plaintiffs for three years in their shop, up to April, 1865, and that in May of that year he set up in a like business for himself. The defendant's name, Frank P. Smith, was posted immediately over his shop-window, in black letters upon a white ground, while upon the sun-blind and brass-plate under the window were the words "From Thresher & Glenny," the word "from" being printed diagonally to, and in smaller letters than, the rest. On the part

[1] Banks *v.* Gibson, 11 Jur. (N.S.) 680.

[2] 11 Jur. (N.S.) 964; 2 Drew & Sm. 476.

of the plaintiffs, the sun-blind and brass-plate were produced in court, and photographs of the shop-front, from which it appeared that when the sun-blind was drawn down the defendant's name was not visible, except to persons passing immediately under the window. They also proved four cases in which persons had actually been misled; and to show that the defendant had some misgivings as to the propriety of his conduct, a conversation between him and one of the plaintiff's assistants was given in evidence. The evidence of the defendant consisted of opinions of persons who had inspected his shop, to the effect that the public were not likely to be misled, and of his directions that nothing should be said to purchasers to induce them to think that Messrs. Thresher & Glenny were connected with his business.

§ 532. *Held*, by Kindersley, V. C.: The same rule that applies in the case of manufacturers applies also to tradesmen by retail. A man having been in the employment of a firm of reputation, has a right, in setting up in business for himself, in any way in which he thinks fit (subject to the restrictions of the rule laid down in the Leather Cloth Co. case, and in *Perry* v. *Truefitt*), to inform the public that he has been in such employment; and in that way he does appropriate to himself some of the benefit arising from the reputation of his former employers. This makes it the more necessary that he should not act in such a way as to mislead the public to the detriment of his former employers. For the purposes of the plaintiff's right to relief, the intention of the defendant is of no consequence: it is enough if, without any unfair intention, he has done that which is calculated to mislead.

§ 533. After commenting upon the nature of the evidence on each side, his Honor continued: That it was in vain for witnesses to say on defendant's part, that, in their opinion, persons could not be misled. When a person goes to try the effect of his own inspection, he knows what he will find, and is prepared to look for the word "from;" but the general public are off

their guard when they pass the shop. But further than this, it is not the question whether the public generally, or even a majority of them, are likely to be misled, but whether the unwary, the heedless, the incautious portion of the public would be likely to be misled. The injunction prayed for was accordingly granted.

§ 534. In the Tribunal of Commerce of the Seine, in 1867 (*Mondin & Co.* v. *Sari & als.*[1]), it appeared that the plaintiffs had adopted as a sign to indicate the nature of their business the words "AGENCE DES THÉATRES." It was held that another in the same line of business, who had adopted as his sign the words "OFFICE DES THÉATRES," did not infringe upon any right, the words being generic and common. It was no answer that the words might lead to confusion.

§ 535. It is unfair competition to indicate by one's sign an industrial product under a name very similar to that of another product, in such manner as to create confusion. In the case of *Berthelon* v. *Vergé*,[2] in the Tribunal Civ. of Lyons, in 1865, it appeared that the plaintiff was the patentee of an invention to which he had given the name of "CONFORMATEUR DU TAILLEUR." From the name, we may infer that the invention was embodied in an instrument for the shaping of garments to the person. Under this denomination, the machine was indicated in the sign, and in the prospectuses of the plaintiff. The defendant, also a patentee, with the evident intention of causing confusion between his machine and that of the plaintiff, placed upon his sign the words "CONFORMATEUR POUR HOMMES ET DAMES," in characters corresponding with those upon his rival's sign. *Per Tribunal:* This act on the part of Vergé does not constitute a counterfeiting or a usurpation of the trade-mark of the plaintiff, but it is an unlawful competition, and therefore the word "CONFORMATEUR" upon the business-sign of the defendant must be suppressed, as also upon his circulars and prospectuses.

[1] Annales de la Prop., tome xiv. 352. [2] Ibid., tome xi. p. 349.

§ 536. As another example of the judicial suppression of a fancy name upon a shop-sign, we have *Chaize* v. *Fromentelle*,[1] in the Tribunal of Commerce of the Seine, in 1865. The parties were tobacconists, carrying on business in the same neighborhood. The plaintiff's sign read, "La Civette" (civet-cat). He had previously been compelled in defence of his rights to attack a certain dame Pousse, who had erected a sign reading, "*A la* Civette *de la rue de Rivoli*," and had discomfited her by a judgment of suppression, with 200 francs damages and costs. This time it was the dame Fromentelle who thought to avail herself of the reputation of the plaintiff's wares, by putting up a sign reading, "*A la* Nouvelle Civette." As it was plain that her motive was to profit by the justly-gained popularity of the establishment of Chaize, a judgment was rendered similar to that in the other case.

§ 537. **Labels and Wrappers.** — We will now consider another class of cases, which seem to form a connecting link between those where the good-will of a trade has been protected, and those which may be characterized as relating to trade-marks proper. This is where the advantage in the market (or good-will) is due either to the name of the trader or trading-firm, or to his or their place of business, or to both these causes combined, but not being, as a good-will, allowed to rest merely *in nubibus*, is embodied in a label or wrapper, and affixed to the article sold. This name becomes then a *quasi* trade-mark.[2]

§ 538. *Croft* v. *Day*[3] is a very important case under this head. The *quasi* trade-mark there consisted in the name of Day & Martin, and their address, 97 High Holborn, with other devices on a printed label attached to the bottles of blacking made by the plaintiffs, the executors of the former firm of Day & Martin, and then carrying on the same business. This was so closely imitated by the defendant as to afford the fair presumption that he intended the public to be deceived into

[1] Annales de la Prop., tome xi. p. 350.
[2] Lloyd, p. 36. [3] 7 Beav. 84.

buying his blacking as and for that of the original firm. The Master of the Rolls, in his judgment, observes that the act complained of was equivalent to a sale by the defendant of his goods as those of the plaintiffs, and that two things were requisite for the accomplishment of this fraud. First, a general resemblance of the forms, words, symbols, and accompaniments, such as to mislead the public; secondly, a sufficient distinctive individuality was to be preserved, so as to procure for the person himself the benefit of that deception which the general resemblance was calculated to produce. — In *Coffeen* v. *Brunton*,[1] the defendant, in combination with others, fraudulently issued to others a preparation called "Ohio Liniment," having upon the bottles containing it labels with directions exactly similar to that used by the complainant for his "Chinese Liniment;" and he made representations to induce the public to believe that the composition sold by him contained the same ingredients as the "Chinese Liniment." McLean, J., said that from the body of the label and of the directions for the use of the medicine, it was clear that the language of the defendant was so assimilated to that of the plaintiff as to appear to be the same medicine, the alteration being only colorable, and was intended to avail himself of the favorable reputation acquired by the "Chinese Liniment." An injunction was granted to enjoin the defendant from using the labels or directions accompanying the liniment sold by him, or other labels or directions or advertisements or hand-bills tending to produce a false impression in the public mind that the liniment sold by him contained the same ingredients as the "Chinese Liniment." (It should be noted that this case is frequently referred to as one of trade-marks, but improperly so. The word "Chinese" was the only symbol capable of exclusive appropriation, and that was not pirated.) — *The Merrimack Manuf. Co.* v. *Garner*[2] case belongs to the label class. In that, the plaintiff's label was "Merrimack Prints, Fast Colors,

[1] 4 McLean, 516.

[2] 2 Abb. Pr. R. 318, and 4 E. D. Smith, 387.

* Lowell, Mass.;" and that of the defendant, "English Free Trade, Merrimack Style, warranted fast colors." The court, *in banc*, dissolved an injunction which had been granted at special term, and left the parties to try the issue of an actual imitation involving the question of fraudulent intent and actual injury. — So, also, does the case of *Dale* v. *Smithson*[1] belong to the label class. The plaintiff affixed to each package of thread sold by him a label, reading as follows: "Courtria Flax. Thomas Nelson & Co. Warranted. *Fast Colors* & 16 Oz." What word or symbol is here to constitute an exclusive emblem? "Courtria" might possibly, if it were a fancy denomination, and not descriptive. The defendants adopted and used in a similar manner upon their thread a label so closely imitating that of the plaintiff as to leave not the slightest doubt of the intention of fraud. The judgment of the judge at special term granting an injunction was, therefore, affirmed at general term. — *Newman* v. *Alvord*[2] is nothing more than a label case. Both parties used the word "Akron," the name of the place where the plaintiff had a manufactory, and the defendants had not. The name "Akron" being a mere geographical designation, could not be exclusively appropriated, for the reason that all inhabitants of the place had a perfect right to affix it to their goods. But as there was no room for doubt, in the mind of the court, that the said name was used by the defendants to enable them to avail themselves of the patronage justly belonging to others, an injunction granted at special term was sustained. — *Fallenbury* v. *Lucy*[3] is a label case, although frequently miscalled a trade-mark case. Sawyer, C. J., said: "Can there be any doubt that the verbatim copy of the entire label of plaintiff, except the heading, the name of the maker, and place of manufacture, and adopting it as the label of the defendants, was done for the purpose of inducing the public to believe that the defendants' was precisely the same thing as, and pos-

[1] 12 Abb. Pr. R. 237. [2] 49 Barb. 588. [3] 35 Cal. 52.

sessed the identical properties of the compound manufactured and sold by the plaintiff, and for the purpose of availing themselves of the reputation established by the plaintiff?" It was sought to protect an elaborate label under a statute of the State of California, including "any peculiar name, letters, marks, figures, or other trade-mark or name, cut, stamped, cast, or engraved upon, or in any manner attached to or connected with any article, or with the covering or wrapping thereof," &c. Comprehensive as is the language of the statute, and palpable as was the imitation of the plaintiff's label, yet the Supreme Court of California held that the label contained no peculiar names, marks, &c., in the sense of the statute which the defendants had copied: nor was the plaintiff entitled to any protection of the words in common use in our language which composed the profusely-worded label. The injunction granted below was accordingly dissolved. — The case of *Boardman* v. *The Meriden Britannia Co.*,[1] in the Supreme Court of Connecticut, in 1868, is a fair illustration of the protection which courts award to a mere label, which has been fraudulently imitated for the purpose of diverting custom from its legitimate channel. The labels used by the respondents were of the same size and color as the labels of the petitioners, and the same numerals were used for the same class of goods. The petitioners' label read thus: "1–2 Gross L. Boardman's No. 2340 Wire Strengthened, French Tipped Teaspoons;" and that of the respondents read: "1–2 Gross Meriden Brita. Co.'s No. 2340 Wire Strength'd, French Tipped, Oval Thread Teaspoons." Both parties seem to have regarded the use of the numerals 2340 as giving rise to the most important and most material question in the cause; but Carpenter, J., in delivering the opinion of the court, said that whether in any case numbers alone may be legitimately appropriated as trade-marks, was a question not necessarily involved in that case. It is apparent, at a glance, that neither of the

[1] 35 Conn. 402.

labels contained a single essential element of a technical trade-mark, although the court loosely used that convenient term. From the finding of facts, we can judge for ourselves of the class to which the case belongs. It was found that the respondents manufactured "spoons similar in character to those made by the petitioners, though differing somewhat in style and pattern, and prepared labels resembling those of the petitioners, and adopted the same numbers as had been adopted by the petitioners, adapting said numbers to similar kinds of spoons." We can classify the case as one of unfair competition in trade by means of a simulated label. A remedy was due, and the court awarded it. The court said: "Have the petitioners suffered damage? On this point, there is no room for doubt. The finding of the committee is explicit, 'that said respondents have sold large quantities of their spoons so put up, in place of spoons manufactured by the petitioners, as alleged in the petition.' It is also apparent, from what has already been said, that the petitioners are in danger of still further loss, unless protected by an injunction. The circumstance that the respondents now prefix a cipher to the numbers would hardly vary the result. Their motive is apparent. They may succeed in reaping some advantage from the numbers as thus used, but it is manifest that it will be at the expense of the petitioners." All the judges concurred in giving judgment for the petitioners.

§ 539. As to the right of property in the name of another, we have a case in the Court of Besançon, in 1861. — *Lorimier & Bovet* v. *Dubois*.[1] The house of Bovet, of Fleurier, a village of the canton of Neufchatel, in Switzerland, manufacturers of watches for exportation, especially to England and China, authorized M. Lorimier, a watchmaker at Besançon, in France, to use the name of "Bovet" as a trade-mark. Lorimier duly deposited the said name as his trade-mark. By authority of his right to use the same, he seized certain watches, then at the custom-

[1] Annales de la Prop., tome viii. p. 297.

house, *in transitu* for China. The Tribunal of Pontarlier rejected the demand for condemnation. Lorimier appealed. The appellate court said: For more than thirty years Lorimier has manufactured watches for the Bovet firm; from the beginning of his relation with that firm, he has been authorized to engrave upon the watches made by him the name of "Bovet;" and, for more than thirty years, he has constantly sold in China watches bearing the mark of "Bovet," the same being in Chinese characters. Said mark, considering the relation of the two houses, is as much the property of Lorimier as it is of the Bovet house. The defendant has usurped, by his products of an inferior quality, the confidence and the credit attaching to the merchandise of the plaintiffs. If tolerated, there would be no security for commerce. Two owners may use the same mark when their interests are united. The right to the use of the mark of "Bovet" in the Chinese is in both plaintiffs. Injunction. Damages, 1,000 francs, and costs. — Although this is a matter somewhat in the nature of a trade-mark proper, it should be classed with mere labels, and treated as such. Being the simple name of a manufacturer, it of course could not be treated in any part of the commercial-world as the peculiar arbitrary symbol that commerce requires. It serves our purpose as an illustration of the fact that a man may have a qualified right to the use of another's name as a mere sign.

§ 540. *Colton* v. *Thomas*[1] is to the same effect as the foregoing. The complaint charged an improper and fraudulent use of a name or designation of business, placed by the defendant upon cards and in advertisements, and also upon a sign hung out upon the street in front of his dental-rooms. The bill alleged that the plaintiff had purchased from Dr. Gardiner Q. Colton the right to use the name of the "*Colton Dental Association*" in connection with the use of nitrous-oxide gas to alleviate pain in extracting teeth; and that he used the same in all his advertisements, and prominently displayed it on his

[1] 2 Brewster, 308.

signs, doors, and windows. That the defendant, who had been in his employment, left him, and opened dental-rooms in the same street, and issued cards in form following: "Dr. F. R. Thomas, formerly operator at the COLTON DENTAL ROOMS. Teeth extracted without pain by nitrous-oxide gas;" and that he had a sign over his door of the same purport. It was alleged that the words "formerly operator at the" upon the cards and sign were in small letters, illegible except to one near by, while the words "Colton Dental Rooms" were in large, bold type and letters, so as to be seen at a great distance. The plaintiff's right to use the name was not denied; nor did the defendant set up any corresponding right in himself. His defence was, that he employed the words "Colton Dental Rooms" without any intention of defrauding the plaintiff; and that his sole object was to protect his reputation, and secure to himself the full advantage of it by advertising the fact that he had ceased to be the operator at the rooms of the plaintiff, which he claimed to be a perfectly fair and legitimate purpose. From the opinion of Allison, P. J., we learn that the signs which hung over the doors of the plaintiff's rooms, No. 737 Walnut Street, and over the defendant's at No. 1027 of the same street, were in size, shape, and general appearance very like to one another. The material portions of the lettering required a careful inspection to notice any difference between them. They both hung in the same manner, on the same side of the street, and might readily be mistaken the one for the other, especially by suffering patients impatient for relief. The same might, to some extent, be said of the cards. An injunction was granted against the use of the cards and sign, and the employment of any device by which the patients and patrons of the plaintiff, without the exercise of excessive care, would be induced to suppose that the defendant's place of business was the place of business of the Colton Dental Association.

§ 541. *The Dixon Crucible Co.* v. *Guggenheim*[1] is purely a

[1] 3 Am. Law Times R. (St.) 288, and 2 Brewster, 321.

label case, and it need hardly be referred to in this place, further than to invite attention to the fact that the protection claimed was embraced in a statute of the State of Pennsylvania, for the protection of private stamps, wrappers, or labels.[1] The defendant was enjoined against the use of the name of "Dixon," to which he had no right or title. It was not pretended that this was a case of a common-law trade-mark. — In *Blofield* v. *Payne*,[2] a law-case, the declaration stated that the defendants wrongfully, and without the consent of the plaintiff, caused a quantity of metallic hones to be made and wrapped in envelopes resembling those of the plaintiff, and containing the same words, thereby denoting that they were of his manufacture. On trial before Denman, C. J., it appeared that the defendants had obtained some of the plaintiff's wrappers, and used them as alleged. It was held by the court *in banc* that as the defendants had used the plaintiff's envelope, and pretended it was their own, the plaintiff was entitled to recover some damages. — In *Holloway* v. *Holloway*,[3] the defendant sold pills and ointment with labels and wrappers copied from those of the plaintiff. The Master of the Rolls pronounced the act to be as clear and as plainly-avowed a fraud as he ever knew, and granted protection accordingly. — In *Eddleston* v. *Vick*,[4] the defendant used labels in palpable imitation of the plaintiff's, and was restrained.

§ 542. A sauce was invented many years ago by *James Cocks*, of *Reading*, and named by him "*Reading* Sauce," under which name it acquired considerable reputation. The success of the manufacture induced others to make and sell what they called "*Reading* Sauce;" and in order to distinguish the article manufactured by *James Cocks* and his successor in business, he and they had for many years been in the habit of wrapping the bottles of sauce, the labels of which always had "The Original *Reading* Sauce." The plaintiff's label was imitated in part.

[1] Sec. 173, Act of March 31, 1860.
[2] 4 Barn. & Adol. 410.
[3] 13 Beav. 209.
[4] 18 Jur. 7.

But plaintiff admitted the only thing to which objection could be taken was the use of the words, "The Original," the labels being otherwise distinguishable.

§ 543. The defendant by answer alleged that the sauce manufactured by him was made from an original recipe to which the plaintiff had no title, and submitted that his sauce deserved the title of original as much as that of the plaintiff; and he further alleged that the plaintiff's was known to the trade as Cock's "Reading Sauce," and not as the "Original Reading Sauce." Evidence in support of the last mentioned allegation was given in his behalf; while, on behalf of the plaintiff, two of the partners in the firm of Crosse & Blackwell, pickle-manufacturers in London, deposed that the use of the word "Original" as part of the title or description of a sauce such as *Reading* Sauce, would lead those in the trade, and the public, to conclude that the sauce so described was the manufacture of James Cocks or his successor. There was no evidence that any one had been misled by the words on defendant's wrappers. Lord Romilly, M. R., said, among other matter: The question, then, is this. There being abundant evidence to show that there are a great number of persons who make *Reading* Sauce, whether the person who is the owner of the original recipe which gave the name, and from which the article called "*Reading* Sauce" acquired its character, is not entitled to say, "I hold under the original inventor, and the word *original* means that and nothing else." He said that the use of the word by the defendant was calculated to deceive. The defendant was accordingly enjoined.[1]

§ 544. Labels and cautions composed of words in common use in our language cannot be exclusively appropriated as trade-marks. But those labels and cautions, although not protected by any virtue of their own, become powerful auxiliaries, bringing punishment upon the wrong-doer. Take the case of *Gillott* v. *Esterbrook*.[2] The selection of boxes, sizes, colors,

[1] Cocks *v.* Chandler, Law Rep. 11 Eq. 446–451.

[2] 47 Barb. 455.

labels, cautions, and style of lettering, however innocent it may have been under ordinary circumstances, became the most conclusive evidence of the intent to mislead the public, and to commit a fraud upon the plaintiff in relation to his trade-mark; yet merely because all those things can be brought forward as witnesses to complete a chain of testimony of guilt, the mere label does not rise to the dignity of a trade-mark proper.

§ 545. When a man has learned a trade-secret from his employer, and practised it after his employer's death, selling the article under the old name, he will not acquire such a right to the exclusive use of the name as a trade-mark as will be protected in a court of equity.[1]

§ 546. **The original** inventor of a new manufacture, and persons claiming under him, are alone entitled to designate such manufacture as "the original;" and if he or they have been in the habit of so designating their manufacture, an injunction will be granted to restrain another manufacturer from applying the designation "original" to his goods. This was the ruling of the Master of the Rolls, in *Cocks* v. *Chandler*.[2] This case must be classed with cases of unfair competition in business rather than with those of trade-marks proper.

§ 547. **Title of a Book.** — There are cases in which the use of a particular title or title-page to a book, or the use of an author's name, has been restrained by injunction. The title of a book or of a newspaper may possess all the characteristics of a trade-mark, when the same is a newly-coined term, or an arbitrary symbol; but that is generally not so.

§ 548. In *Hogg* v. *Kirby*,[3] the plaintiff was proprietor of a monthly magazine published by the defendant, and sold at his shop upon commission. The publication continued during five months; but at the end of that time disputes arose between the parties. It was agreed to discontinue the joint publication, and a final settlement of accounts was had. The plaintiff then

[1] Hovenden *v.* Lloyd, 18 Weekly Reporter (Eng.), 1132.
[2] 11 L. R. Eq. 446. [3] 8 Ves. 215.

circulated advertisements, stating that the publication under its old title would be continued by him, and that a sixth number of the magazine would be, as it accordingly was, soon afterwards published by him. The defendant at once advertised and published the first number of a periodical work under a title similar to the plaintiff's, but described as a "New Series, Improved." An injunction was applied for, to restrain him from selling any copies of his publication, and from printing or publishing any future or other number, either under the same or any similar appellation, and from borrowing and using the appellation, or copying the ornaments, or any part of the plaintiff's original publication. Several circumstances were alleged by the bill to show that the defendant's work was intended to mislead the public to the conclusion that it was a continuation of the plaintiff's, — such as the general resemblance, though not an exact similarity of its title-page or wrapper; the continuation in the new magazine of an article left unfinished by the old; and the publication of an index to the first five numbers of the old work, under the name of an index to the first part. This intention was, however, denied by the answer, which attempted to give a sufficient reason for the steps taken in composing the form and substance of the new magazine, to show that it was not intended to represent it to the public as a continuation of the old work; and the defendant submitted that he had a right to publish a work under a similar title. The court held, that, upon the facts stated, there appeared to be an intention on the part of the defendant to put his work before the world as a continuation of the old magazine. Lord Eldon, in that case, did not rest his decision so much on the ground of copyright, or of contract, as upon that of fraud. He stated the question to be, not whether the work was the same as the original, but whether the defendant had not represented it to be the same, and whether the injury to the complainant was not as great, and the loss accruing to be regarded upon the same principles

between them, as if it were, in fact, the same work. What we may gather from this decision amounts to this: that, by a certain resemblance of form and matter, a publisher may not with impunity put forth to the public a literary work to be taken for another work of an established reputation, and thus fraudulently reap the advantage enjoyed by the original work; and that this advantage in the market corresponds in some measure with the property created by the Copyright Act, and is protected on analogous grounds.

§ 549. A case of a similar character is that of *Spottiswoode* v. *Clarke*.[1] There the plaintiff was the owner of a publication called "The Pictorial Almanack, for 1847;" and the defendant of one called "Old Moore's Family Pictorial Almanack." The plaintiff alleged that the defendant's work was a piracy on his publication, and filed a bill for an injunction. With regard to the substance and internal portion of the two works, there was little or no resemblance; but the covers were, to a certain extent, similar, both being decorated with a pictorial representation of the Observatory at Greenwich, and in the title, as printed on the cover, making use of nearly the same expressions. The bill alleged that this imitation was intentional, and done with a view to deceive the public, to the injury of the plaintiff. The Lord Chancellor said, among other things: "In the course of argument, cases of trade-marks were referred to; but trade-marks have nothing to do with this case. Take a piece of steel: the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article. So it is of blacking, or any other article of manufacture, the particular quality of which is not discernible by the eye. In the present case, if anybody is deceived it is not by the eye; for any thing more different than the two articles in question can hardly be conceived. . . . Both covers represent a portion of Greenwich Observatory, and profess the work to be for all sorts of persons. It is diffi-

[1] 10 Jur. 1043, and 2 Ph. 154.

cult to believe that all this is accidental; but if it is a fraud, it is the most clumsy fraud that I ever saw, for it could deceive no one." He accordingly dissolved the injunction granted below, the defendant undertaking to keep an account, with liberty to the plaintiff to bring an action. The whole gist of the matter lies in this: If no one could be deceived, the plaintiff suffered no injury; but if a casual observer would probably be misled, then the principle laid down in trade-mark cases would be applicable, and the use of a particular name, title, or wrapper, would be restrained. This case has been cited and followed." [1]

§ 550. In *Snowden* v. *Noah*,[2] the complainant had purchased from the defendant the right to publish at the city of New York a newspaper called "The National Advocate." The defendant subsequently published at said city "The New York National Advocate." Sandford, Ch., held that there was such a difference as to warrant the court in refusing an injunction to restrain the defendant. — So, in *Bell* v. *Locke*,[3] Walworth, Ch., denied an injunction to restrain the defendant from publishing or circulating a newspaper called the "New Era," which was alleged to be an infringement of the rights of the plaintiff, who published the "Democratic Republican New Era." Besides the difference in titles, the defendant's paper, upon its face, purported to be a revival of an old paper, in which he was formerly interested with the complainant, which paper had been voluntarily discontinued by both for more than eighteen months. — In *Matsell* v. *Flanagan*, the complaint alleged that the plaintiffs were, and long had been, the publishers and proprietors of the "National Police Gazette," which was commonly known to the public as the "Police Gazette;" and it appeared that it was the only "Police Gazette," *eo nomine*, published in the United States, at the time of the publication of this paper. It further appeared that the

[1] Purser *v.* Brain, 17 L. J. Ch. 141. See also Chappell *v.* Davidson, 1 K. & J. 123.

[2] Hopkins, Ch. R. 347.

[3] 8 Paige, 75.

defendants were engaged in publishing and selling a paper called "The United States Police Gazette." which, from its general character and appearance, was a fraudulent simulation of the plaintiffs' paper. The words "Police Gazette," forming a part of the title, were printed in type similar in character to that employed by the plaintiffs for their print, and a similar imitation characterized the general form, style, type, and device of the paper complained of. It was shown that the public were actually misled into purchasing the defendants' paper for that of the plaintiffs; and the more easily as when "The United States Police Gazette" was folded, and lying upon the newspaper stands, as is usual and customary, the words "United States," which made the difference between the titles of the two papers, would be concealed. The manifest fraud in this case distinguishes it in principle from *Snowden* v. *Noah* and *Bell* v. *Locke* (*supra*). The injunction was continued. — In *Stephens* v. *De Cuto*,[1] the main question was, whether the name of a newspaper in the Spanish language, called "El Cronista," published by the defendant, was an infringement upon the name "La Cronica." Monell, J., held that there was so manifest a dissimilarity in the general appearance of the two titles, both as respects the formation of the words and the character of the type employed in printing, that no Spaniard could be mistaken. But the case was relieved of all difficulty, as it appeared that the publication of "La Cronica" had ceased. The injunction was dissolved, and the complaint dismissed. — In *Dayton* v. *Wilkes*,[2] the good-will of a newspaper — that is, the celebrity which it had acquired under the name of "Porter's Spirit of the Times" — was fully recognized a valuable property. — And in *Clement* v. *Maddick*,[3] where an injunction was granted to restrain the defendant from using the name "Bell's Life" for his newspaper, the court characterized the suit as "an application to support a right to property."

[1] 4 Abb. Pr. R. (N.S.) 47, and 7 Robertson, 343.
[2] 17 How. Pr. R. 510.
[3] 5 Jur. (N.S.) 592.

§ 551. In the Court of Paris, in 1858 (case of *Estibal* v. *Petit-Demenge*[1]), an appeal from a judgment forbidding the defendant from using the name of a journal — the "Charivari" — on card-covers for the same, to be used in coffee-houses, lecture-rooms, &c., it was held that such use did not constitute a case of illicit competition or infringement. The appellate court said that the gilt advertising-cards of the defendant were but covers for the "Charivari," which could not create confusion in the public mind with the paper itself; and although, in enclosing the "Charivari" in the covers the defendant addressed the readers of the journal, that fact in itself did not make him responsible in damages. The defendant offered to alter his cards so that they should read, "'Cover for the 'Charivari,'" which the court thereupon directed should be done.

§ 552. In the Tribunal of the Seine, in 1855 (*Castille* v. *Dennery*[2]), it appeared that the plaintiff had published, in 1847, a romance, entitled "Les Oiseaux de Proie" (The Birds of Prey). The defendant brought out a drama under the same title, which was thought by Mr. Castille to be an infringement upon the name he had selected. *Held:* Considering that for a long time the words *Oiseaux de Proie* have been metaphorically employed to designate certain men; that those men offer types so varied that they are the objects of observations, of studies, and diverse paintings, to each of which the said words are as applicable as to a romance by Castille; and that there is no invention in the title, — the demand of the plaintiff must be refused.

§ 553. An author or a publisher has, either in the title of his work, or in the application of his name to that work, or in the particular external marks which distinguish it, just such a species of property as a trader has in his trade-mark. He may, therefore, equally claim the protection of a court of equity against such a use, or such an imitation of that name or mark as is likely, in the opinion of the court, to

[1] Annales de la Prop., tome iv. p. 334.

[2] Id., tome ii. p. 27.

be a cause of damage to him in respect of that property.[1] Upon this principle rests the case of *Thuuot-Duvotenay* v. *Degorce-Cadot*, in the Court of Paris, in 1869. Madame Michaud, widow of the historian of the crusades, had married M. Thuuot-Duvotenay, and conjointly with him and others in interest had brought suit to prevent the further publication of a "History of the Crusades," which had been brought out by the defendant. The defendant had, in 1868, by means of circulars and notices, profusely scattered about, announced for sale the "HISTOIRE POPULAIRE ET NATIONALE DES CROISADES," by Michaud. Four numbers of this book were published. Having been duly warned by process to cease the publication, he had recourse to subterfuge to give to the complainants a seeming satisfaction. In the fifth number, he ceased to edit the text of the "History of the Crusades," by Michaud, and substituted therefor the "Jerusalem Delivered," of Tasso. The substitution deceived a portion of the public, who believed that the "Jerusalem Delivered" was a legend of the "History of the Crusades," which latter title continued to figure at the head of each page. These combinations and manœuvres constituted a manifest fraud. The Tribunal of Commerce of the Seine, which had original cognizance of the case, held that it had jurisdiction of the matter as a commercial act, the parties appearing in the character of merchants. Judgment for complainants. Upon appeal, the defendant invoked his good faith to repel the presumption of tort. He fared no better than in the forum below. The court said, *inter alia:* Considering that Michaud is a contemporary author; that his "History of the Crusades" has a merit and renown that the defendant was among the first to recognize; that the defendant is a bookseller and editor in Paris, where divers editions of this book have been published; that under these circumstances he cannot pretend ignorance of the fact that the name has not become public property, but belongs to the heir and assignees, or, if he had a doubt thereon, the most

[1] Lloyd on Trade-marks, 2d ed. p. 42.

simple effort would have dissipated the doubt; that he cannot pretend that he prepared and commenced the publication in good faith, but has manifested his bad faith by his acts; therefore he is guilty of counterfeiting, and the judgment must be affirmed, with costs.

§ 554. In the remarkable case of *Lord Byron* v. *Johnstone*,[1] the defendant, a publisher, advertised for sale certain poems, which he represented by the advertisement to be the work of Lord Byron, on whose behalf a bill was (during his lordship's absence abroad) filed to restrain the publication under the title described in the advertisement. There appears to have been some doubt at the time of the original publication whether or not the poems were Lord Byron's; but when the defendant, at the hearing, declined to swear as to his belief that the poems in question were actually the work of Lord Byron, the court granted the motion for an injunction until answer or further order. This seems like recognizing a proprietary right in a mere name. At least, it goes so far as to grant relief against damage arising from the use of a particular name in conjunction with a particular article offered for sale; it being impossible for the purchaser to ascertain, on mere inspection, the truth or falsehood of the representation on the faith of which he buys the article.

§ 555. It is difficult to reconcile the principle of the decision in this case with that of the decision in *Clark* v. *Freeman*,[2] where the eminent physician, Sir James Clark, applied for an 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. The only distinction between the principles of the two cases seems to be this: that in the former the author must be held to have a species of property in his name, consisting in

[1] 2 Mer. 29.

[2] 11 Beav. 112; s. c. 17 Law J. Rep. (N.S.) Chanc. 142.

the recommendation to the public which the use of that name gives to the sale of a literary work, while it did not appear that Sir James Clark was in the habit of selling medicines, or of deriving a profit from the sale of medicines, and therefore it could not be argued that he had suffered injury in trade; and the court could not recognize an injury done to his reputation, which it treated as an illusory damage. It must, therefore, have held in the former case that the author has a species of interest in his name quite similar to that of a trader in his mark affixed to the articles manufactured by him.

§ 556. Yet there does seem to be natural justice in protecting one's name from contempt or unpleasant notoriety, which may amount to infamy. Could not the eminent physician have been seriously damaged in his practice by the usurpation of his name by a quack? and was he not in all probability injured in his professional reputation by the conduct complained of? If this decision is sound, may not any man's name be blasted by the brazen villany of another who chooses to borrow his name! In France, a different doctrine is maintained, as is evident by the judgment of the Tribunal Civ. of the Seine, in 1869 (*Charles de Bussy* v. *Charles Marchal*[1]). The defendant, well-known in the literary world under the pseudonym of Charles de Bussy, is the author of numerous publications which have appeared under the assumed name. Among them is a *brochure* entitled "Les Impurs de Figaro," and another entitled "Le Cas de M. Rochefort." The plaintiff, an engineer of Paris, who aspired neither to immodest notoriety nor the imputation of embroiling himself in political affairs, obtained an injunction against the further misuse of his name, with 50 francs damages, and costs.

§ 557. **The Name of a Song.** — Certain music-publishers having adapted original words to an old American air, which was rearranged for them, gave to the song so composed the name of "MINNIE," and procured it to be sung by Madame Anna

[1] Annales de la Prop., tome xv. p. 143.

Thillon, a popular singer, at M. Julien's concerts in London: and when it had by that means become a favorite song, they published it with a title-page containing a picture of the singer who had brought the song into notice, the name "Minnie," &c. *Held*, that the publishers had by these means obtained a right of property in that name and description of their song, which a court of equity would restrain any person from infringing.[1] Another party infringed upon the same by using the words "MINNIE, DEAR MINNIE," and was restrained by an interlocutory injunction, without imposing upon the parties the necessity of trying the right at law.[2]

§ 558. **Printed Publications** have sometimes their titles registered as trade-marks, and they may legitimately be so, provided they have such a distinctive individuality as shall preclude the probability of confusion with the titles of other publications. "OUR SOCIETY,"[3] and "INSURANCE MONITOR"[4] seem to be free from any such objection, as applied to periodicals.

§ 559. **The Right to Exclusive Use must be Definite**, to entitle the claimant to relief. In England, it has been held that a newspaper is not within the Copyright Act, 5 & 6 Vict. c. 45, and therefore requires no registration under that Act: but the proprietor of a newspaper has, without registration, such a property in all its contents as will entitle him to sue in respect of a piracy.[5] But there must be something definite and certain in the thing sought to be protected. When the proprietor of a newspaper sought to restrain the piracy of a "List of hounds," the court was of opinion, that although the piracy might be established, the list was liable to such frequent changes, and a correct list was so easily obtained, that it was not a case for an interlocutory injunction.[6]

[1] Chappell *v.* Sheard, 2 Kay & J. 117; 1 Jur. (N.S.) 996.
[2] Chappell *v.* Davidson, 2 Kay & J. 123.
[3] F. C. Barksdale, No. 424. [4] Charles C. Hine, No. 903.
[5] Cox *v.* Land and Water Journal Co., 9 Law R. Eq 324; 39 L. J. Chanc. 152 (V.-C. Malin's Court.)
[6] Ibid.

§ 560. **Names on Coaches.** — A court of equity will restrain a defendant from fraudulently using the same words and devices on an omnibus that the complainant may have previously appropriated to designate his. In *Knott* v. *Morgan*,[1] in 1836, in the Rolls Court of England, the defendant was restrained from using upon an omnibus the names "London Conveyance," and "London Conveyance Company," or either of such names, or any colorable imitation of them, or either of them, painted, stamped, printed, or written thereon, or in any manner affixed thereto. — *Stone* v. *Carlan*,[2] in 1850, is a similar case, the defendants having been restrained from improperly using the names "Irving Hotel," "Irving House," or "Irving," upon coaches, and upon certain badges worn by the defendants upon their arms and hats.

§ 561. An action of trespass on the case may be maintained under similar circumstances. Thus, in *Marsh* v. *Billings*,[3] where the plaintiffs claimed and established the exclusive right to use the name of a hotel, "Revere House," upon coaches, to indicate the fact that they had the countenance of the lessee of that house for the purpose of transporting passengers to and from that house from the railroads. For this privilege they paid an equivalent in the obligations into which they entered. The ground of action against the defendants was not that they carried passengers to the Revere House, or that they had the words "Revere House" on the coaches and on the caps of the drivers merely, but that they falsely and fraudulently held themselves out as being in the employment, or as having the patronage and confidence of the lessee of the Revere House, in violation of the rights of the plaintiffs. The Supreme Court of Massachusetts held, on appeal in this case, that the plaintiffs would be entitled to such damages as the jury, upon the whole evidence, should be satisfied they had sustained; and that the damage should not be confined to the loss of such passengers

[1] 2 Keen, 213. [2] 13 Mo. L. R. 360.

[3] 7 Cush. 322.

as the plaintiffs could prove had actually been diverted from their coaches to those of the defendants, but that the jury would be justified in making such inferences as to the loss of passengers and injury sustained by the plaintiffs as they might think were warranted by the whole evidence in the case.

§ 562. **Secret Process. Breach of Faith.** — There are also cases involving a breach of trust, in disclosing a secret process, a knowledge of which has been gained through confidential relations of the parties. The earliest of these cases, *Newbury* v. *James*,[1] shows the difficulties that have been felt in dealing with questions of this sort. The plaintiff there claimed to be entitled, under the provisions of certain agreements entered into by the ancestors of himself and the defendants, respectively, to the exclusive right of selling certain powders and pills, well known as "James' Powders," and "Analeptic Pills," as agent to the defendants, and prayed a decree for specific performance of agreements. The pills and powders were made up by the defendants from an alleged secret recipe; and it was sought to restrain them from communicating this recipe to any other person without the plaintiff's permission. The court does not seem to have looked upon this secret recipe in the light of property, — the subject of certain agreements as to the manner of enjoyment, and as clearly liable to injury from divulgation. Had this been done, there probably would not have been serious difficulty in framing an injunction in restraint of such a contemplated injury, even though the court might not have been able to decree the specific performance of the agreement. On this head, the Lord Chancellor said that either it was a secret, or not. If a secret, what means did the court possess for enforcing its own orders? If not a secret, there was no ground for interfering. If the art and method of preparing the Analeptic Pills, for which no patent had been procured, were a secret, what signified an injunction, the court possessing no means of determining on any occasion whether it had or had

[1] 2 Mer. 416.

not been violated? The only way in which a specific performance could be effected would be by a perpetual injunction: but this would be of no avail unless a disclosure were made to enable the court to ascertain whether it was or was not infringed; and in complaining of a breach of an injunction, it would be necessary first to show that the injunction had been violated. The injunction was therefore dissolved. — In *Williams* v. *Williams*,[1] it was said that the court would not struggle to protect secrets in medicine of that sort; but that it was different in the case of a patent, because there the patentee was a purchaser from the public, and bound to communicate his secret at the expiration of the patent. — This point has been settled with tolerable distinctness in *Dietrichsen* v. *Cabburn*.[2] Lord Cottenham virtually decided that, where there is such an infirmity in an agreement that it cannot be performed in all its parts, the court will not by injunction compel a defendant to perform the one part, it being at the same time unable to compel the plaintiff to perform reciprocally the other, namely, that which was positive in the agreement, if its aid should be appealed to by the defendant in order to procure for him the benefit of the contract or agreement. — We find, however, that in *Yovatt* v. *Winyard*,[3] the defendant, who had been employed as the plaintiff's assistant under an agreement by which he was to have a salary, and be instructed in the general knowledge of the business, but not in the secret of manufacturing the medicines sold, was restrained from divulging those recipes to which he had surreptitiously gained access; and from making up and selling the medicines compounded from the recipes, with certain printed instructions, almost literally copied from the plaintiff's. In this case, the decree proceeded on the ground of trust. — So, also, in *Green* v. *Folgham*,[4] where the defendant was held to be the trustee of the secret of compounding "The Golden Ointment," under the trusts of a certain settlement, and was ordered

[1] 3 Mer. 157.
[2] 2 Ph. 52.
[3] 1 J. & W. 394.
[4] 1 S. & S. 398.

to account for certain mesne-profits made by him in the sale of the ointment; the court even going so far as to direct the valuation of the secret to be made for the purpose of administering the trust property. — In *Tipping* v. *Clarke*,[1] a case arising out of a dispute between two merchants, in the course of which the defendant, in a letter to the plaintiff, stated that he had acquired a knowledge of his books and accounts, and that he intended to make a public exhibition of them, we have a recognition of the same doctrines. — In *Morison* v. *Moat*,[2] it appeared that the plaintiff and the defendant had for some years carried on in partnership the business of making and selling "Morison's Universal Medicine." On the dissolution of the partnership, the defendant, who had retired, set up for himself, and made and sold the original medicine under its former name as prepared by him. It appears that the plaintiff, in praying for an injunction, did not omit to put forward the ground of fraud or misuse of his labels and trade-marks by the defendant; but he relied on this only in aid of the principal head, — that of breach of faith and contract; and it is on this ground that the decision rests. In France, the law recognizes the secrets of manufacturers as property, and article 418 of the Penal Code severely punishes clerks or workmen who divulge the secrets of manufacture of their employers.

§ 563. On the other hand, where no charge of breach of trust is involved, courts will not protect the proprietors of secret medicines or other compounds not patented; and any one possessing himself of another's secret by fair means, may make and vend the same, provided he sell it as his own manufacture, and not that of a party complaining. Thus, in *Davis* v. *Kendall*,[3] where the plaintiff had no patent, and therefore no exclusive property in a medical compound invented and sold by him, and known as the "Pain Killer," the court said that all were entitled to make and vend the compou[illegible]. — The same

[1] 2 Hare, 383. [2] 9 Hare, 241.
[3] 2 R. I. 566. See Annales de la Prop., tome xiv. p. 229.

doctrine was recognized in *Comstock* v. *White*.[1] The defendants in that case, after dissolving their connection with the plaintiffs as partners, commenced using the name or designation of "Dr. Morse's Indian Root Pills," to which neither party had any exclusive right without a patent from the government. The court held that while an injunction should not be granted against an innocent defendant, yet where it appeared that the defendants, in having connected themselves with the plaintiff in selling the medicine by a particular name or designation, and having induced the plaintiffs to expend large sums of money in advertising, &c., the medicine manufactured, and then suddenly and without notice, in an unjustifiable manner and apparently from improper motives, severed their connection with the plaintiff and set up the same business for themselves, an injunction should be granted.

§ 564. As an instance of reparation for a wrong done, we will take a case tried in the Court of Paris, in 1861, — *Galy* v. *Mauchien & Co.*[2] Galy was the inventor of certain pharmaceutical products, which he sold under the denominations of *Sirop iodhydrique*, *iodhydrate de fer*, of *bonbons iodhydriques*, and of *pâte pectorale de réglisse iodhydrique*. He made the defendants the exclusive agents for the sale of his said products, upon the condition that they should use upon flasks, boxes, and prospectuses the above-mentioned names, and also the name of Galy, as inventor. They omitted his name, wherefore he sued. The court took into consideration the publicity which the defendants had given to the spurious labels, and said that, as the defendants had committed the wrong by means of announcements made by the *Société hygiophile*, in the journals *le Siècle*, *la Presse*, *les Débats*, *la Patrie*, *le Constitutionnel*, *le Pays*, and in the journal called *La France médicale et pharmaceutique*, it was just that the order of the court should receive the same publicity at the expense of the defendants. In addition to costs, &c., the publication was ordered to be made showing the judgment for the plaintiff.

[1] 18 How. Pr. R. 421. [2] Annales de la Prop., tome viii. p. 374.

CHAPTER XIII.

PRACTICE IN PATENT OFFICE.

Preliminaries. — Selection of Counsel. — Necessity for Forms. — System of Examination. — Special Pleading. — Drawing and filing of Application. — Amendments. — Confidence the Design of Oath. — *Prima Facie* Right to Mark. — Indefiniteness. — Description of Colors. — Breadth of Claim. — Degree of Specificness. — Examples of False Models. — Rejection because of False Suggestion. — Litigation not encouraged. — Surrender and Reissue. — Money paid as Fees, when returnable.

§ 565. **Preliminaries to Application for Registration.** — When the proprietor of the right to exclusive use of a trade-mark wishes to avail himself of the advantages of registration, he should reflect how his object can best be accomplished. He prepares his case with carefulness and thought. This he may do himself, and generally with an assurance of safety, provided he possess that rare quality known as "common sense." The forms to be found in the Appendix to this treatise serve as a guide, the necessary modifications being made to suit the peculiarities of each case. But he may not always feel perfectly safe in drawing up a few simple statements of fact, for if he be a person really possessed of the rare quality mentioned, in the majority of instances he will mistrust his own powers, remembering that experience is the mother of science. No man is wise at all times. The very simplicity of the procedure is puzzling to him. Many men deem it to be a simple matter to string a few sentences together in the form of a will and testament. We know that the memory of the man who drew his own will is always venerated as the lawyer's best friend. Words are sometimes used in a wrong or loose sense even by

astute jurists and writers; what, then, may be expected when a layman — however expert he may be with ledgers and invoices — hastily pens an application for the registration of his mark? That mark may be worth a fortune to him, although a mere "abracadabra" when disconnected from a particular species of goods. The meaningless, arbitrary symbol becomes a talisman. How, then, shall it best be protected?[1]

§ 566. The rules of practice of the Patent Office (131–135) furnish good advice upon this subject. The remarks made in regard to a patent are quite applicable to a trade-mark. The value of either depends largely upon the careful preparation of specifications and claims, and "the assistance of competent counsel will, in most cases, be of advantage to the applicant, but the value of their services will be proportioned to their skill and honesty." But how shall a selection of counsel be made from the multitudes of aspirants for forensic honors? Rule 131 says that "the Office cannot assume responsibility for the acts of attorneys (a broad term, including counsellors and solicitors, all being attorneys-in-fact when practising in the Office), nor can it assist applicants in making a selection. It will, however, be a safe rule to distrust those who boast of the possession of special and peculiar facilities in the Office for procuring patents in a shorter time, or with more extended claims, than others." Making the necessary changes in words, we may apply this caution to trade-mark matters.

§ 567. It is not every experienced counsel in patent cases who is qualified to conduct, or advise upon, a question of law applicable to trade-marks. It has frequently been made manifest that one who has devoted himself exclusively to patent practice is at a disadvantage when dealing with rights in a symbol of trade and commerce. His thoughts — habituated to

[1] "La marque employée honorablement peut et doit être maintenant une source de fortune, puisqu'on est sûr désormais qu'une protection efficace empêchera qui que ce soit d'usurper le signe caractéristique dont on a fait le pavillon de sa marchandise pour soi et ses successeurs." — "Marques de Fabrique," by M. Emile Barrault.

run in a groove — confound one thing with another of quite a dissimilar nature. The mischief of mistaking a certificate of registration for a patent, or any thing in the nature thereof, has been demonstrated in several places in this book. Yet mere patent lawyers (!) make this mistake every day, and will continue to do the same, in accordance with the proverb, "A wise man changes his mind, a fool never." It would therefore be judicious for the applicant to select as his legal adviser one who is not a *mere* patent lawyer, to deal with this question, involving so much commercial law. Forewarned, forearmed. The language of the papers may be the foundation to all right to protection.

§ 568. **Necessity for Forms.** — It has been well said that well-constructed *forms* are the consummate excellence in every department of legal practice. As conveyancing is nothing without forms, so is pleading nothing without them. Forms are the only contrivances to secure precision, certainty, and facility.[1] *Form* is of incalculable advantage to the practitioner who draws the papers, for a case never fully reveals itself until put into a definite form; it is an eminent auxiliary in the analysis of the application in the Patent Office; and is almost indispensable in the distraction and flurry of the trial of a cause in court? Perhaps your case may never get into court? That is more probable than otherwise, if your case is believed to be impregnable, free from ambiguities, title clear. Why come to the Office for registration of a trade-mark, but with the view of arming for the conflict! You thereby apply the maxim, that the surest way to avoid war is to be always prepared for it. You do not come to the Patent Office for a trade-mark, for, as has repeatedly been said in this treatise, no power resides in this branch of the Government to grant one; but you do come to record the fact of your adoption of a mark, and bear away with you the evidence of your assertion of title to the sole use of a peculiar symbol. You shall have an adjudication upon the question,

[1] Tyler's Rules of Pleading, p. 50.

whether your supposed trade-mark is valid or not; and that adjudication may be the means of closing the door to all strife. Your purpose is best subserved by adherence to form.

§ 569. The Office does not stickle for mere *technical form*, *i.e.*, form independent of the merits. It looks rather to substance; and a high degree of artificiality is not desired. But we must remember that there is in legal contemplation no such thing as *form* without substance, or *substance* without form. We know, by experience, that the precedents enable us to embody all necessary allegations with ease and perspicuity. Thus are evolved upon the record the questions of law and of fact, so that they may all be exactly and intelligently met.

§ 570. The system of examination is this: The papers are inspected, to ascertain whether they are written in the English language, in a fair and legible hand, with all interlineations and erasures clearly marked in a marginal-note on the same sheet, and all other matters of form are looked into; and, finally, all indispensable requisites of oath and allegations. The scrutiny may disclose some fault susceptible of amendment. If so, it is pointed out, and the paper perfected.

§ 571. The case is then taken up on its merits. Sometimes a course of special pleading is pursued, until the essential questions are met. The application-papers serve as a declaration, in lack of a defence to which the claim is passed for issue. Although the forms are few and simple, and the Office affords every reasonable facility for the curing of defects, a considerable degree of accuracy is quite necessary. He who has made himself familiar with the science of special pleading at common law, — little studied now-a-days for practical use, — as an aid to mental discipline, and as a system of logical devolution of the issues of a strictly legal controversy, will have an advantage over him who is slovenly in thought.

§ 572. The Office may plead in abatement, as for want of some material allegation. That having been cured by amendment, the case proceeds upon the law of the case. Admitting

all the facts alleged by the *primâ facie* case, the Examiner takes exception to the legal right of the claimant; for it may be that — 1. His record discloses the fact that the applicant is not one of the persons, natural or artificial, included within the provisions of section 77 of the Act of Congress of July 8, 1870; 2. Or, that the proposed trade-mark is not sufficient in law, being merely indicative of quality, or consists of words common to the language, to which no one can claim an exclusive right of use, because not indicating origin or ownership; 3. Or, that the same symbol has already been appropriated by another person for the same class of goods, as is shown by records, or otherwise is known; 4. Or, that the right to claim protection by virtue of the act has expired by limitation, in the case provided for in section 78; 5. Or, that the proposed mark is calculated to deceive the public; 6. Or, that it is intended for use in an unlawful business; 7. Or, that the registration would be contrary to public policy, &c., all of which matters may be necessarily inferable from the language of the applicant. While it is not probable that he would set a trap to catch himself, he may, by telling all the truth, blunder into difficulties from which he cannot be extricated. He is estopped by his recitals. He has admitted too much, as will appear in suppositive cases hereafter.

§ 573. As the application-papers have the same purpose as a declaration in an action, the Office must *demur* or *plead* thereto. In not one of the cases given can it plead either by way of *traverse*, or of *confession and avoidance*; for there is nothing to take issue upon. The Examiner then demurs for insufficiency in *substance* and in *form*. The cases commented upon are *essentially insufficient*. They are also stated in an inartificial manner. The insufficiency may be excepted to in general terms, without showing specifically more than one insuperable objection. A single bullet may be as efficacious as a shower of missiles. But when the refusal to register amounts to nothing more than a plea in abatement, the Examiner aids the appli-

cant by specifying the grounds of objection, and gives as many hints and facilities for amending as can reasonably be expected. But as the peculiar province of this officer is at times misunderstood, it must be stated in this place, that he is not called upon to furnish gratuitous advice to any applicant who shall have paid the sum of twenty-five dollars into the public treasury.

§ 574. No. 129 of the Rules of Practice of the Patent Office is as applicable to a trade-mark as to a patent case. It is there provided that the Office cannot respond to inquiries as to novelty, in advance of an application, nor to inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether the same claim has been passed upon, and if so, in whose favor; nor can it act as an expounder of the law, nor as counsellor for individuals, except as to questions arising within the Office. These questions arising within the Office are those which legitimately spring from a case actually under consideration. The functions of the Examiner of Trade-marks are judicial in their nature. He is not an advocate or counsel.

§ 575. The applicant may join issue with the Office, and argue the law question raised, and produce judicial decisions as to the law; or he may introduce new evidence to sustain his title, and show that the decision was based upon a mistake of fact. For example, if his claim be rejected on the ground that he belongs to a country that does not allow similar privileges to citizens of the United States, he may suggest that there is a treaty or convention between his country and this, and the Office will take cognizance of any such fact that by accident might not have come to light; or he may take issue on the question of novelty; or admit that another person once had title, but that he had lost it by abandonment; or that the mark already registered is for a different class of goods; or that the foreign protection has not expired, as provided for in section 78 aforesaid; or he may, as best he can, meet any other objection. Of course, it would be entirely impossible to suggest the multiplicity of points that

may arise in the prosecution of a claim to the recognition of an exclusive right in a mark. Man is not a mere machine, but is a being of mind. He may be pumped full of law, but it will remain undigested, to slop over upon the least provocation, unless he bring to his aid the noble faculties of the soul, and think! He must have faith in what he does, for uncertainty destroys law.

§ 576. **Drawing and filing of Application.** — It is to be presumed that the applicant has a valid claim to the exclusive use of a symbol as his trade-mark, before he comes to the Patent Office. He consults the rules as to the employment of descriptive or generic terms, and satisfies himself that he has a right to a certain definite emblem, by priority of adoption in his particular business. If he follow the dictates of common sense, his case may be clear enough. He takes the approved forms, and modifies them, telling a plain, unvarnished tale, in as concise language as may express his meaning. Having separately signed each paper, with two witnesses to the specification and the drawing, and sworn to the declaration, the case is ready to be presented. If the specification be accompanied by an original drawing, — on a sheet ten by fifteen inches, having a light and simple single-line border one inch from the edge, leaving the "sight" exactly eight by thirteen inches, — there need not be fac-similes; for copies will be made therefrom by the photo-lithographic process, without charge, the same as in patent cases. But if the representation of the trade-mark be a print, it must be mounted and signed, so as to be convenient for placing in a portfolio; and *ten fac-similes* must be filed with it. (As to the particular manner of making the drawing, the reader is referred to the printed Rules of Practice of the Patent Office.)

§ 577. **Amendments.** — The power to amend application-papers is limited. If this were not so, all the material facts and allegations might be so varied from the original statement as to entirely change its character. After a first rejection, the

applicant generally has a right to amend; but this is not always so; for the sworn papers may bear upon their face the most conclusive evidence of fraud, and a party be estopped from contradicting his own allegations. A rejection under circumstances which display a lack of good faith may be regarded as final. Suppose, as frequently happens, the applicant show that he is endeavoring to usurp the credit that belongs to a rival trader, by a servile imitation of his mark, he cannot well complain if he is refused a second hearing. Yet, if there be any reasonable doubt of guilty intent, and if there be ground for supposing the imitation to be the result of an innocent coincidence, he would be permitted to explain, and to amend.

§ 578. No amendment is permitted to enlarge the scope of the claim, unless upon supplemental oath. Solicitors of experience have, in many instances, so far disregarded the spirit and reason of this rule as to completely transform the original case. The papers are found to be deficient in essential averments. Citizenship, domicile, residence, place of business, description of the mark, the length of time it has been used, manner of applying it to goods, &c., have not been properly set forth. The solicitor mechanically draws an amendment, striking out this and inserting that, with the greatest recklessness of consequences. He sometimes attempts to amend the sworn declaration, usually termed the *oath*, by substituting words, or adding new allegations. He does not stop to think that he is thereby perverting the evidence, and that he might as well interpolate new statements in a deposition after execution, or words in a deed after delivery. Nor does he pause to reflect that such irregularities completely vitiate a case, and virtually destroy all the value of registration, and leave it without efficacy. A court is bound to adjudge a certificate to be void, when the record shows it to have been granted upon falsehood, or disregard of the sanctity of an oath. Even if the new matter in an affidavit be in fact true, it is in effect false,

unless properly sworn to. But suppose that no such glaring irregularity has been committed, and that so far as form is concerned the party has sworn to his amendment, even then he *may* be refused a favorable consideration; for he is not entitled upon the payment of a single fee to the judgment of the Office upon two different cases.[1] If he discover that his claim to the exclusive use of one symbol has been anticipated by some other person, he cannot be allowed to amend by substituting another symbol as his mark. That would be authority for ringing all the changes, and confining the attention of the Office to a single case.

§ 579. All amendments must be made on separate sheets of paper from the original, and must be filed with the chief clerk of the Patent Office, who will cause them to be duly marked with the stamp, showing the date of reception. It is irregular to file an amendment with the Examiner, or to change the original record by erasures, interlineations, or marginal-notes. A looseness of practice in this respect once put the Office to serious trouble, and enabled a roguish solicitor to perpetrate great wrongs; while a strictness of practice in another respect brought condign punishment upon the head of the culprit, and excluded him from the Office. It must appear by the file *when*, *how*, and *by whom* an amendment has been made.

§ 580. **Design of Oath.**— To secure faithfulness, and elicit truthful testimony, is not the only design of the oath. It is also intended to produce *confidence* in regard to the thing sworn to. It is designed to produce an effect, not only upon the person sworn, but also upon them to whom the oath is made. *Confidence* amongst the members of society is indispensable to social comfort. Suspicion and doubt and distrust are the bane of social peace.[2] The statute intends that this oath for *confirmation* shall be an end of all strife. So it would be, if implicit faith could be reposed in it. As it is, it

[1] Case of J. C. Cooke, Commissioner's Decisions, 1871, p. 312.

[2] See that admirable book, Junkin on the Oath.

can be only presumptive. What becomes of confidence, when an examination of the original file in the Patent Office discloses the fact that the sworn declaration has been tampered with; that after the oath has been administered interpolations have been made, and erasures and interlineations have materially changed the meaning of important allegations! The pen which traces these words has just spread upon paper as follows: "The applicant, by his attorney, proposes to amend the application-papers by adding to the affidavit certain facts which were not sworn to, *i.e.*, to make a person appear to have sworn to matters which he did *not* swear to. The proposition cannot be acceded to." The attorney referred to is a highly reputable member of his profession. If he could so glibly pass over such a contempt of the sacredness of an oath, what might not be expected from one who has no fear of the justice of the God of truth! The same attempt to pervert the oath is daily made in the Patent Office. How, oftentimes with success, need not be told. Suffice it to say that if the paper bearing the record stultifies itself, the registration is a nullity. The worshipper at the shrine of Mammon, who thinks gold more valuable than the invisible things of a man, — peace, probity, and purity, — may administer or take an oath with the indifference of an auctioneer selling goods; but he should take care that his record is plainly written, for the acute counsel in a trial in court will take it to pieces as one might a watch or other machine.

§ 581. **Prima Facie Right to Mark.** — The Office will not always question the right of the applicant to the use of a certain mark, although there may be circumstances of a dubious nature. Cases there are in which statements not strictly true may readily be corrected. Thus, in the following case, the oath of a party was deemed of sufficient weight to remove all doubt of the right to use the name, &c., of a foreign house. The mark, which is for brandy-bottle caps, is described as consisting of a circular colored border surrounding a white or metallic ground

containing a coiled belt or band consisting of two circles, with a vertical bar with buckle or fastening device, surmounted by a crown, and inclosing the letters "O. D.," the "O" being on the left of the bar and the "D" on the right. Within the border, and forming a semicircle above the crown, are the words "Otard, Dupuy, & Co.," and at the bottom of the white ground beneath the circles is the word "Cognac." In the space between the words "Otard, Dupuy, & Co." and "Cognac" are two stars. There was a momentary hesitation on the part of the Examiner. He asked himself, Have the applicants a right to use the name of the French firm? May not this mark, without some qualification to show its origin in this country, be apt to mislead the public? May this mark not prove to be an exact fac-simile of that of the foreign house? How can a license to use it be presumed? Is this proposed mark to be affixed to the genuine imported brandy? The records of the Office show that, some months earlier than the date of the pending application, the same applicants had obtained registration of a mark for liquors exported or sold by Otard, Dupuy, & Co., of Cognac, France, in which matter the applicants are described as agents for said house. The registered mark (No. 739) and that which was then pending are, in legal effect, nearly identical. *Conclusion:* The foreign house has a large trade with this country, and therefore may be presumed to jealously guard against encroachments upon rights which are allied to those of their customers. They may easily protect themselves in the courts. Besides, the applicants are in a line of business in which they have many vigilant competitors. If, by any possibility, there be error, it can readily be rectified. A *primâ facie* case has been made out. Registration allowed.[1]

§ 582. The Examiner sees enough to put him on inquiry. A single word, perhaps, is submitted as the essence of the mark. A single word, — but how much may that single word contain! A word may be a wonderfully-involved bud, which, when

[1] Cazade & Crooks, No. 993.

breathed upon, unfolds and develops a complexity of ideas. It may be as simple in appearance as an acorn, and yet enclose interests as wide-spreading as the roots and branches of an oak, with ramifications touching the business-matters of a myriad of persons. Take as an example the word "Chartreux" (signifying a Carthusian friar), which for many years, in a multiplicity of suits, has figured before the courts of France. One of the infringers had taken the feminine form of the word. Of that, the Court of Cassation said, in 1872:[1] The word "Chartreuse," applied as a denomination to the *liqueur* manufactured by the religious community of which the Père Garnier is the representative, is but an abbreviation and the equivalent of a designation more complete: for it at once indicates *the name of the fabricants* (the Chartreux); *the name or commercial firm of manufacture*, which is no other than the community of these same Chartreux; and, finally, *the place of manufacture*, that is to say, the monastery of "la grande Chartreuse." — That single word contains a long history of strife. It has repeatedly been held to be a perfect trade-mark, for the reasons just cited. The spoken word, "Chartreuse," is the symbol of the mental conception: the written word is the symbol of that symbol. The arbitrary sound of the voice is intimately combined with the conceptions of the mind, and the arbitrary vocal symbol is cemented with another symbol still more arbitrary, addressed to the sight. The symbol excites in other minds the invisible and intangible thoughts that it was meant to call up, by the association of ideas.

§ 583. **Indefiniteness.** — A so-called description of a trade-mark may be so indefinite as really not to convey the least idea of the intention of the applicant; as when, in an elastic-suspender case, the mark which was said to consist of a man's face printed or stamped on the front side or surface of the suspender, near the front end, — had been generally applied, as read the specification, "with some sort of ornamented design,

[1] Le Père Louis Garnier *v.* Paul Garnier, Ann. de la Prop., tome xvii. p. 257.

printed above and below the figure, with the name of the person represented by the picture under it, as shown. But the ornamented design, on the top or bottom, or at both places, may be omitted, or some other design substituted for that shown, and the *name* of the person whose likeness is printed on the suspender may be omitted, without materially changing the character of my trade-mark; the essential feature of which is, the picture of a person printed upon the face of the web or fabric." The applicant claimed that these two peculiarities were gained, viz.: 1. A picture — on the front of the suspender — of some personage of national or historic reputation of notoriety; 2. Having a face on the web, which is generally more or less elastic, the expression of which may be varied by stretching the material. The applicant also stated that he proposed "to change the likeness given in the picture, as expediency may require." To this the Examiner, after pointing out the contradictory recitals of the specification, ended his decision thus, — "COMMENT: This case presents none of the characteristics of the fixed, invariable, unmistakable, definite symbol termed a trade-mark."

§ 584. The reader can for himself analyze this specification. What was claimed? A man's face, *any* man's face, and that face to be changed at pleasure. But even the lineaments of that face were not to be permitted to remain in placidity; for being printed upon elastic suspenders, the features would be contorted by each strain upon the webbing. But then, there was an ornamental design above and below the face, and the name of the person whose face was represented! True, but the ornament and name were both dispensed with at the will of the manufacturer. In a suit for infringement of a trade-mark evidenced by such a specification, how could conviction of imitation possibly follow? If such a broad claim were inadvertantly allowed to escape the scrutiny of the Office upon an *ex parte* showing, it could not possibly form the basis of any judicial demand. And yet this very specification had been

drawn by an experienced patent lawyer, who had not become imbued with the subtle refinements of the law of trade-marks. He for a while refused to be comforted, and appealed; but, upon maturer consideration, he amended his specification and obtained a certificate of registry.[1]

§ 585. We cannot always be guided by the verbal description of the colors which may be essential elements of a trade-mark, or may be the ground of the label bearing it. Endless confusion would result unless we were permitted to lay the conflicting marks or labels side-by-side, and inspect for ourselves. What court or jury would rely upon witnesses in such a matter? for they may honestly disagree in attempting to impart to the mind of another an intelligible idea of colors and shades. A writer[2] on this subject says: "What idea is conveyed to the mind by the mere mention of a red, or a blue color? A scarlet coat is called red; and the term 'red' is applied to a rose, a brick, port-wine, mulberries, cherries, and other things of very different hues: the sky, a violet, a slate, and a steel helmet, are called blue; and the Arabs, who apply 'green' to a mouse-colored horse as well as to a copper-colored Abyssinian, call jet-black '*blue*;' and their 'blue horse' may mean one of jet-black, or iron-gray color. In like manner the Welsh *glas*, 'blue,' or 'green,' is applied to black (provided it has no brown tinge); and gray is also called 'blue' (*glas*), — hence *glastum*, a name of woad." When we come to tints, the mind is lost in a maze. The Roman artists say that more than 30,000 tints are used in mosaic. A slight variation in the colors employed in a mark for goods may change its whole aspect, just as a deepening of the natural shade of eyebrows, or the addition of a few bits of court-plaster, may so change the facial expression of a fair lady as to make us doubt her identity. In a trade-mark there must be no doubt. To judge of an alleged similarity between two trade-marks, we must place them together. If

[1] James Twamley, No. 860.

[2] Sir J. Gardner Wilkinson, "On Color," &c. London, 1858.

calculated to create confusion, one is an infringement upon the other; but if the public can readily distinguish between them upon a casual inspection, there is no confusion. Let us take a case.[1] The applicants say that the design shown in the drawing is a true copy of their trade-mark for base-balls. We see the representation of a red ball, with an imitation of its seams, and we read the words "Dead Red Ball," the name of the firm of the applicants, and a description of the weight and circumference of the real ball. What is the essential feature of the mark? We are not told in the specification. Any one who has a right to make the article (a base-ball), may lawfully make a picture of it; and there is no pretence that the applicants have a monopoly. What guides the purchaser in his selection? It is the *red* color of the ball, more than the words. Then the red ball is the trade-mark, if any thing in the whole design comes up to the requirements of the law. That being the case, no one else has a right to the same mark for the class of goods to which this is applied. But any person is at liberty to use a blue ball, or a green ball, or indeed one of any color or shade that could not be mistaken for that described. The shape is not a mark in this case. Nor was it in the case of *Ricque et als.* v. *Forge et al.*,[2] in the Court of Paris, in 1861, where the plaintiffs' mark consisted of four *rose*-colored threads as a border for their drillings, and the defendants adopted a bordering of two *red* threads, wherefore they were adjudged to be counterfeiters. Now, in either of these cases, witnesses might well disagree in naming the peculiar color used. What is *red* and what is *rose-color?* The necessity of ocular examination is obvious.

§ 586. **Breadth of Claim.** — This matter is entitled to more consideration than it usually receives from applicants. Things material are so united with things immaterial as to detract greatly from the value of a mark. Sometimes so great ingenuity

[1] Peck & Snyder, No. 46.

[2] Annales de la Prop., tome viii. p. 25.

seems to have been exercised to narrow down a claim, that one cannot but wonder at the folly. When a broad claim can be maintained for a word, for example, why encumber it with a collection of other words? Look at the consequences in case of encroachment upon the mark. The word is so hedged about by unimportant things, devices, or words, that it is almost impossible to convict of counterfeiting. The name of a firm, or of the place of manufacture, the term "warranted," and other words not really any part of the mark sought to be protected, detract from its strength; and the pirate finds a sure refuge behind the veil of uncertainty.

§ 587. Suppose, for the sake of argument, that the essence of the trade-mark is the word "Anchor." By the time that a superior description of goods may have obtained a solid reputation in the market, and the word "Anchor" as an arbitrary symbol is the only thing that the purchaser looks at to assure himself of the genuineness of manufacture, an imitator appears. He is sued for infringement. He defends himself upon the plea that the mark described by the plaintiff is so indefinite that he could not make it mean any thing in particular; and that as he took but a single word out of many words used in the mark of his rival, he cannot be deemed guilty of encroachment upon his rights. Upon inspection of the mark of the plaintiff, as registered, it is found that the word "Anchor," although it was that only that he desired to protect, is preceded and followed by the name of the party, his place of business, and the announcement that his wares are the justly-celebrated, world-renowned, best-class goods. He is taught a lesson. He learns that in this instance simplicity is strength. His complaint is dismissed. Nor is that always the worst result. He finds that while he has nothing but an elaborate mark, which is entirely worthless, his triumphant adversary has established a right to the exclusive use of the simple, yet valuable word "Anchor." The evil could have been avoided by the simple averment in his specification that the essential element of his

mark consisted of that one word. A lack of precision of phraseology may destroy trade, the soul of which often depends upon the recognition of a symbol. "A word fitly spoken is like apples of gold in pictures of silver." The declaration in an action on the case requires no greater discrimination in the use of the exact word than does a specification.

§ 588. The claimant of protection for an alleged trade-mark may, by too great breadth, dissipate all his pretensions, and thwart his own object. By attempting to grasp too much at once, he puts himself in the position of the greedy boy with the apples, and is left empty-handed. The representation of an object, a word, or emblem does not become a trade-mark until actually associated with a particular description of goods. How can a man hope to make a claim broad enough to cover all the merchandise in creation? Or how can he even think that a device can be set forth to cover a hundred forms of the same thing, — as "an eagle in any form or position;"[1] or "a crown of any desired form, style, or kind, whether of the shape usually known as a royal crown, or as a ducal crown, or otherwise?"[2] The representations of eagles and of crowns are almost infinite in number. In the latter case, the applicants averred that they had already registered one form of a crown for the same class of goods; and that now, by way of precaution, and in order to avoid any question as to the meaning and scope of their former description, they desired to include all other crowns. The answer was, that the claim was too indefinite, and in fact was anticipated by the former case of the same parties. The opinion was also volunteered, that the applicants were protected against the use by wrong-doers of any device substantially the same as that already registered, or so nearly resembling it as to be calculated to deceive. This *dictum* correctly states the law.

§ 589. A case like this could not be recognized as entitled to

[1] H. M. Rowe & Co., *ex parte*.

[2] Thompson, Langdon, & Co., *ex parte*.

registration, or as sufficient foundation for any redress under the law peculiar to trade-marks: "The mark consists of a tattooed initial letter, which may be any letter of the alphabet, stamped upon the upper-crust of the pie; as, for instance, the letter A will stand for apple; B for blackberry; C for currant, &c. Below this single initial we stamp the letters 'C. P. B.,' standing for Connecticut Pie Bakery."[1]

§ 590. One of the most remarkable applications ever filed was as follows: The claimant[2] represented that he was doing business under the name and style of the "New Era Company," in the city of New York, and was engaged in the publication and distribution of books, papers, and tracts; and also in the manufacture and sale of various articles of use, consisting *in part* of tacks, nails, locks, bolts, butts, saws, files, axes, hammers, bits, augers, planes and plane-irons, shears, scissors, pocket and table cutlery, spoons, lemon-squeezers, pins, needles, slates, hay and manure forks, hoes, spades, shovels, rakes, scythes, plows, carpet-stretchers, tack-claws, apple-parers, cherry-pitters, stove-polish, silver and plated ware, gold and silver watches and jewelry, and general cast and wrought hardware. He desired, therefore, to register as his trade-mark for said goods a star, with the words "New Age" in the centre, &c. The decision of the Special Examiner reads thus: Such an *omnium gatherum* was never contemplated as a subject of a trade-mark. Not more than one class of merchandise can be included in a single application, while this case may embrace forty thousand most incongruous things. It is not understood how one person can constitute, by himself, the "New Era Company." This requires explanation. . . . Case suspended for reconstruction.

§ 591. **Degree of Specificness.** — This no rule can designate, except in a general way. It is a rule, that *the declaration must state every thing that is of the essence of the cause of action; and that is of the essence of the cause of action, without which judgment cannot be given.* The dropping of a word

[1] Case & Martin, *ex parte*.

[2] W. M. Evans, *ex parte*.

may be the drawing of a rivet upon which depends the whole case. Omit any of the conditions precedent, and the Office has no jurisdiction. For example, *domicile* of a person or firm in the United States is in some cases required by section 77 of the Act; * and therefore is a necessary averment. In case of a corporate applicant, the exact name thereof, and the authority giving it existence, should be averred. So, also, of residence and place of business, and of many other facts. But surplusage is to be avoided. When the applicant is a resident of or located in a foreign country, it is not necessary to allege the existence of a treaty or convention of reciprocity; for official notice will be taken of all such matters.

§ 592. It will not be a waste of time to analyze the following hypothetical application-papers. Every fault indicated has been committed by one applicant or another, while sometimes a single case is found to be marvellously replete with errors. This is not the curious workmanship of a precisian, but a truthful exemplification of every-day practice. Bear in mind that these are FALSE MODELS, *not to be followed.*

PETITION FOR REGISTRATION.

To the Commissioner of Patents:

The petition of Antonio Gomez respectfully represents, that he is the senior member [1] of the firm of Gomez & Romero, engaged in the manufacture and sale of brandy and other li, rs at the city and county of New Orleans,[2] Louisiana.

That he alone and with others and the said firm [3] have used [4] trade-marks [5]

* July 8, 1870.

[1] Irrelevant. The application is made on his individual behalf, and not as a member of a firm.

[2] No such county. It should be, "Parish of Orleans."

[3] Such phraseology would be incredible, if the real application from which it is copied were not before the writer. A symbol cannot serve as a trade-mark, unless the right to its use be *exclusive*.

[4] When? — for how long a time? (See subsection fourth of sec. 77 of the Act of July 8, 1870.)

[5] Not more than one trade-mark can be embraced by a single application. This error is of frequent occurrence.

for said articles,[6] which trade-marks consist of the printed labels[7] herewith filed,[8] or substantial copies[9] thereof. No. 1, containing the words, "OTARD, DUPUY, & CO., COGNAC," surmounted by a ducal crown and the letters "OD" inside of a circular representation of a strap or belt, is to be applied to our manufacture[10] of brandy.[11] This is an excellent imitation of the imported article, is chemically pure, and medicinal,[12] and is generally pronounced by good judges to be superior to that brought from Europe.[13] The names "Otard, Dupuy, & Co." are only used as a fanciful emblem, and have no intention to mislead as to origin;[14] and indeed our label differs in several particulars from any label used by any such concern.[15] Nos. 2, 3, 4, and 5, containing the names of different kinds of liquors,[16] are intended to be applied as indicated.

He further represents that no other person, firm, or corporation has a right to the use of said trade-marks, or of any substantially the same,[17] or so nearly resembling them as to deceive the public.[18]

[6] The words "said articles" include brandy and other liquors; but to what number, and of what kinds, we are not informed by the papers in the case. Nor need we care to know. Subsection second of said section 77 calls for a statement of "the class of merchandise and the particular description of goods comprised in such class." *One class*, and no more, is contemplated by the statute.

[7] Labels are not trade-marks, but, as we have before seen, are merely vehicles for trade-marks.

[8] A full verbal description is in all cases required; so that the specification, when it shall have been printed, may sufficiently identify the trade-mark claimed, without compelling recourse to drawings, or other extraneous matters, which may become detached.

[9] "Substantial copies!" Such words throw the mind into a state of still deeper uncertainty. A copy must be a fac-simile, an exact counterpart.

[10] This is an admission of atrocious piracy. The intent to deceive the public, for the sake of dishonest gain, is too manifest to admit of doubt.

[11] It is not even brandy, but an imitation of brandy for a fraudulent purpose.

[12] Surplusage, even if true. *Falsus in uno, falsus in omnibus*, — false in one particular, false in all.

[13] It is not allowable to deceive the public, even for their own benefit.

[14] False upon its face! Why take the name of a reputable house, but for a vile purpose? Thucydides declared that a fraud cloaked with a specious pretence reflects infinitely greater dishonor than open violence; because the latter is the effect of the power which fortune has conferred, and the former is founded wholly in perfidy, which is the pest of society.

[15] An admission of an attempt at evasion.

[16] Even if more than one kind of liquor could regularly be embraced by the same application, this mention of "liquors" would be too indefinite.

[17] The language of subsection seventh of the statute must be more fully followed.

[18] The law says, "as might be calculated to deceive."

He therefore prays that the said lawful trade-marks [19] may be granted [20] to him, as by law provided. ANTONIO GOMEZ.

AFFIDAVIT.

State of Louisiana,
Parish of Orleans,
City of New Orleans. } ss.

Antonio Gomez, being sworn, says that the foregoing statement by him subscribed is true in substance and in fact, as he verily believes; and that he and his partner reside at Havana, in the Island of Cuba, and are subjects of the king of Spain.[21]

NAPOLEON JONES, *Notary Public*.[22]

§ 593. We have thus penned a simple-looking set of application-papers, in which almost every rule of law and of practice has been violated. The petition and the specification have been jumbled into one; doubt has been created from the start as to whether the applicant claimed for himself or for his firm; and the description of the mark, or marks, has been left so undecided as to leave no ground for action. Such faults could have been cured by amendment, *i.e.*, by a reconstruction of the case. But there are manifestations of fraud, which instantly shut the door to all further consideration, and estop the applicant from retractation or amendment. The want of domicile is sufficient for the purpose of rejection. The case dies without a hope of revival. Unhappily for justice, no punishment can be inflicted upon the flagitious wrong-doer beyond the loss of the fee paid in. We will next examine the application of a firm, or a corporation (we are at a loss to say which).

[19] A misnomer, as is evident from the circumstances.

[20] The Patent Office has no power to *grant* trade-marks. It receives and records them, and issues a certificate of registry. It has no creative power.

[21] It gives some degree of satisfaction to learn from the applicant that he has no legal standing before this tribunal. Neither he nor his firm is domiciled in the United States, nor is there any treaty or convention between Spain and this country which gives the application a right to be entertained.

[22] The notary has omitted to affix his official seal, which is indispensable under the Act of Congress of Sept. 16, 1850. No State regulation can affect this positive requirement. *A verbis legis non est recedendum.* (See Patent Office rule 10.)

Petition for Registration.

To the Commissioner of Patents:

Your petitioners[1] respectfully represent, that the Union Land Company,[2] composed of A. Bell, Ch. Dolan, Ed. Foy, G. Ham, and I. K. Lane,[3] is engaged in the manufacture[4] of pamphlets and circulars to advertise their business[5] as a land-improvement concern,[6] at Baltimore County,[7] Maryland, and are entitled[8] to the exclusive use upon the said articles manufactured by them of the trade-mark described in the specification and accompanying labels,[9] said trade-mark having been duly assigned to them,[10] for a valid consideration paid by said company to the original designer and inventor thereof.[11]

[1] One glance of the eye shows that there is but a single petitioner.

[2] The meaning of this word as here used is not apparent. It may be intended to indicate a corporation, or a firm. If the former, the application should be made by the corporation through its proper officers; and it should appear whether the incorporation was by authority of the United States, or of any State or Territory thereof, &c., as directed by sec. 77 of the Act of July 8, 1870. If a corporation, the names of the corporators should not be alleged.

[3] When names of persons are used, the same should be stated in full, mere initials not being names in law. (See Patent Office rule 17.)

[4] "*Engaged in the manufacture.*" This recital is not sufficiently comprehensive. The manufacture may be gratuitous, and indeed turns out to be, in this instance. If it be intended to imply mercantile operations, the words "*and sale*" would make the purpose clear. A symbol cannot possibly be a trade-mark unless in some mode attached to merchandise.

[5] "*Pamphlets and circulars to advertise their business.*" All idea of the emblem of trade is at once dispelled.

[6] A land-improvement concern can hardly be supposed to vend goods, wares, and merchandise.

[7] Unhappily worded, to say the least.

[8] In what capacity?—as individuals, firm, or corporation?

[9] "*Labels*" should be struck out, and "*fac-similes*" substituted.

[10] Where a party claims by *assignment or alienation*, the nature of the conveyance and alienation should be stated (Stephen on Pleading, 304, 311, 436). Either a certified copy of the assignment should be attached to the application-papers; or, if the same shall have been filed in the Office, a suitable reference should be made to it. Especially is it necessary to be introduced as an exhibit in this case, to show whether the transfer was made to *it*, the company, or to *them*, the individuals. If assigned to *them*, it seems that the *company* paid the consideration. Misty enough!

[11] An inventor has not any property in a design, unless it is patented as an adjunct of a manufacture. Actual use is the criterion of adoption of a symbol as a trade-mark. Intellectual conception has nothing to do with a mark, as an emblem of commerce. No title could therefore be deduced from "the original designer and inventor."

They therefore pray that the said company may be permitted to obtain protection [12] for said trade-mark, and letters-patent, or a copyright therefor,[13] under the law in such case made and provided: And they [14] do hereby appoint Simon Shallow, of said Baltimore, or his substitute,[15] their true and lawful attorney, to make all necessary alterations and amendments [16] in and to said trade-mark to receive the protection,[17] and to transact all business in the Patent Office connected therewith.

18

A. BELL, *President*.[19]

§ 594. Specification describing a trade-mark for pamphlets and circulars used by the "Union Land Improvement Company," [20] of Baltimore, Md.

Our trade-mark consists of the design [21] as fully represented and described in the annexed cut or drawing,[22] composed in part of the words "Union Land Company" with our initials [23] on a shield; but the said shield and initials may be omitted, or any other design be substituted therefor, or *vice-versa*.[24]

[12] If *it*, the company in its aggregate capacity, *i.e.*, as a corporation, is to obtain protection, it must be only upon the application of its proper officers.

[13] Neither letters-patent nor a copyright can apply to a trade-mark case.

[14] *They* do not appoint, for the paper is signed by but one, who styles himself "President."

[15] At all events, the *substitute* could not be appointed except by Simon Shallow.

[16] No alterations or amendments can be made in a trade-mark without destroying its identity. If altered, it becomes something else.

[17] Meaning the certificate of registry.

[18] The necessary internal-revenue stamp, required in case of the appointment of an attorney-in-fact, not having been attached, Mr. Shallow cannot be recognized as such. (The stamp is not necessary in cases filed on the 1st of October, 1872, and thereafter.)

[19] If this really is meant for an appointment by an incorporated company, the conclusion should be somewhat thus: "Witness the seal of said corporation, and the signature of its president, at Such-a-place, in the county of Baltimore, and State of Maryland, this 8th day of October, A.D. 1871." (See form 47, Rules of Practice of the Patent Office.)

[20] The true name should be given. There is a repugnance to the title previously stated.

[21] A trade-mark cannot correctly be said to consist of a design.

[22] Which is it? — a cut or a drawing? Inspection shows that it is neither, but a stencilling.

[23] Whose initials?

[24] We nearly despair of a solution of this enigma.

The most[25] essential features of this trade-mark are the words mentioned, and the shield when used,[26] together with the advertisement[27] of the company, and notices of the valuation of building-sites, &c.; but these or any of them may be varied or omitted according to circumstances.[28]

This trade-mark, consisting of the parts described, we have used in our business of publishing for some time past, and with good effect.[29] The particular class of goods upon which said company has used,[30] and still continues to use said trade-mark, consists of pamphlets and circulars,[31] in addition to our signs and cards.[32] We have been accustomed[33] to brand it with a stencil-plate and black ink on packages of circulars and pamphlets sent to our various agents, or print it on the faces of the same[34] with the usual printing-ink.

A. BELL, *President.*

Witness: I. K. LANE.[35]

AFFIDAVIT.

Commonwealth of Maryland,[36]
City & County of Baltimore.[37] } ss.

Personally appeared before me, a justice of the peace in and for said city and county, the said A. Bell,[38] who, being duly sworn, doth depose and say that he is an officer of said company within mentioned;[39] that they[40] have

[25] The word "most" must be eliminated.

[26] How can it be essential at all, if it may be dispensed with?

[27] An advertisement cannot enter into a trade-mark.

[28] Sheer nonsense.

[29] Surplusage.

[30] For how long a time? (Subsection fourth of sec. 77 of the Act aforementioned.)

[31] We have already seen that these pamphlets and circulars are used as mere advertisements.

[32] "*Signs and cards.*" Are these merchandise?

[33] How *now* applied and used?

[34] It would be hypercritical to say that the last antecedent is the word "agents."

[35] Two witnesses are required. *Query,* — Is not this witness the person named in the petition as a party?

[36] Should be "State of Maryland." (See Constitution of same.)

[37] The city and the county of Baltimore are different jurisdictions, the city not being in the county proper, but being itself a borough with county powers. This oath could not have been taken in both city and county. This error has been committed a number of times in trade-mark applications, being generally attributable to recklessness on the part of agents, or self-appointed solicitors. The oath must be discarded.

[38] Full name required.

[39] He fails still to state that it is a corporation.

[40] This implies a lack of incorporation.

the right to the use of the trade-mark described, and that no other person, firm, or corporation has a right to the same[41] or any part thereof;[42] that the description and fac-simile presented for record are true copies[43] of our trade-mark; and he further says that he is domiciled in and is a citizen of the said State.[44]

ADAM YOUNG,[45] *J. P.*[46]

§ 595. Examples equally vicious may be drawn in an almost infinite variety from cases actually filed in the Patent Office. Brief and comprehensive as are the approved forms, and intelligible as they must seem to be to any one possessing a modicum of sense, they are constantly made the sport of a spirit of misunderstanding. Instead of a terse style of allegation, involving a strict retrenchment of unnecessary words, — which is the aim of the best practitioners in pleading,* — we behold extraneous matter, recklessness of allegation, inconsistencies, ingenuity of falsehood. All of the errors of the preceding cases have not been pointed out; but sufficient have been displayed to convince us of the necessity of thought and caution in drafting a simple set of papers.

§ 596. In view of the fact that all action in the Patent Office is taken only to pave the road for possible ulterior proceedings in law or in equity, too much caution cannot be observed in declaring the title. The metes and bounds of a field must all be carefully defined, before a person can be charged with encroachment thereon. Therefore, any thing which does not possess all the essential characteristics of a trade-mark, under

[41] This should read, — "a right to the *use* of the same."

[42] This is too sweeping an assertion.

[43] A *description* cannot well be termed a *copy*.

[44] It is sometimes the fact that a person is a citizen of a State while not of the United States. The regulation made by the Commissioner of Patents on the 29th of February, 1872, reads: "The form of oath for application for registration of a trade-mark will hereafter contain a statement of what country the applicant is a citizen, the same as in patent cases."

[45] No date to the jurat, not fatal, but an irregularity.

[46] This officer, who improperly abbreviates his title to "J. P.," leaves us in the dark as to the question of his jurisdiction. He cannot be a justice of the peace for both Baltimore city and Baltimore county.

* Stephen on Pleading, 424.

the universally-accepted rules of commerce, cannot receive recognition. A thing must exist before it can be acknowledged. If the proposed mark be merely indicative of quality, it must fall to the ground. Yet this truth is slow in obtaining credit. It was thought that the legal advisors who, in 1859, contended that the term "Schiedam Schnapps" [1] constituted a valid trade-mark would long since have abandoned that fallacious idea; but the position taken at the trial of a very recent cause [2] implies the contrary. In the Supreme Court of New York, October 14, 1872, at special term, the matter was again decided. It appears that, at about a year before that day, the plaintiffs commenced the sale of an article of gin manufactured by them under the name of "HUDSON G. WOLFE'S BELL SCHNAPPS." The defendant, a corporation succeeding to the rights of the late Udolpho Wolfe claimed this name to be an infringement of its trade-mark, viz.: "UDOLPHO WOLFE'S AROMATIC SCHIEDAM SCHNAPPS." The defendant, by its agents, threatened the plaintiffs with prosecution, and sent circulars with a similar threat to their customers throughout the country. The latter were in many instances intimidated thereby. The plaintiffs thereupon brought suit against "The Udolpho Wolfe Company," and asked an injunction to restrain the defendant from thus interfering with their business. A preliminary injunction was granted by Gilbert, J. The question upon the hearing was this: Did the plaintiffs by their use of the words before-mentioned violate any right of the defendant? Pratt, J., who heard the cause, said, *inter alia*: "The evidence taken convinces me that, prior to 1848, the word 'Schnapps' had become a portion of our common language, and was used to denote either gin or a class of articles of which gin is one. The question of law arising on these facts is a narrow one, and has been several times decided. . . . The reason of the rule is obvious, — the language

[1] Wolfe *v.* Goulard, 18 How. Pr. R. 64.

[2] Hudson G. Wolfe, *et als. v.* Udolpho Wolfe Co., Off. Gaz., vol. ii. p. 441.

might otherwise be impoverished, and the community be exposed to inconvenience without any corresponding benefit. It follows from these views that the plaintiffs must have judgment in their favor." This decision maintains two points. 1st. That the defendant had no valid mark in the collocation of words mentioned. 2d. That the plaintiffs have a valid mark in theirs. It was not necessary for the purposes of the suit that the learned judge should go further, or he might have truly said that the word "Bell" is the essential part of the mark. In the former suit, it was admitted in argument that the word "Schiedam," being the name of a town in Holland, could not be appropriated by the plaintiff, and that the word "Schnapps" was a word adopted from the German language, meaning a dram.

§ 597. Just as worthless for the purpose of constituting trade-marks are such words as "Old London Dock Gin;"[1] or "Prize Medal, 1862;"[2] or "Yankee Soap"[3] (which a judge in 1863, through mistaking the scope of the decision in another case,[4] declared to be a trade-mark to which the plaintiff had an exclusive right). So in the "Moline Plow" case, in the Supreme Court of Illinois, in 1870, where the manufacturers branded upon their plows, for the purpose of designating the size, shape, and quality of the different grades, respectively, certain letters and figures in combinations as follows: "A No. 1," "AX No. 1," "No. 1," "AX No. 11," "B No. 1," &c., it was held that no exclusive right to their use existed; but that they could be used by any other manufacturer of the same articles.[5] And so in the case of *Stokes* v. *Landgraff*,[6] where certain words and figures were employed to designate the size and quality of glass. The "English's Broom" matter is also in the same category,[7] and so are also many other cases

[1] Binninger *v.* Wattles, 28 How. Pr. R. 206.
[2] Batty *v.* Hill, 84 T. R. (N.S.) 791.
[3] Williams *v.* Spence, 25 How. Pr. R. 366.
[4] Williams *v.* Johnson, 2 Bos. 1.
[5] Candee, Swan, & Co. *v.* Deere & Co., 54 Ill. 439.
[6] §§ 157–160, *ante*. [7] §§ 162, 163, *ante*.

to be found in close proximity to it in this book, and all designating the mere quality of the merchandise to which they were affixed, or being necessary names and common phrases which all persons have a right to use.

§ 598. In the Court of Lyons, in 1866 (*Chabrier* v. *Peillon*[1]), came up a suit involving a question similar to that which arose in the subsequent "Akron"[2] and "Lackawanna"[3] cases in this country. On the banks of the Rhone, in the environs of Seyssel, exists a natural repository of asphaltum. To distinguish it from many mineral deposits of the same kind situated in other parts of France, the usage has been to attach the denomination of "ASPHALTE DE SEYSSEL." The court *held*: Considering that this is a denomination of region adopted in the language of mineralogists and in the usages of industry, said denomination cannot become the subject of an exclusive right of property for asphaltum extracted from a particular place of deposit. That names of locality, simple geographical expressions, are common property, and can be employed with equal right by all interested in using the designation is well-established as law. The claim of the plaintiff was accordingly rejected. This is the principle that governed the Office in the "Geyser Spring"[4] case. The "Congress Spring"[5] was not brought within the reason of the rule, because all persons had not the same right as the plaintiffs, who possessed the entire title to the land where such spring had its outlet.

§ 599. In the Court of Bordeaux, in 1853 (*Salignac & Co.* v. *Levanier & Co.*[6]), it appeared that the plaintiffs had adopted as a designation of commerce for their brandy the words "Salignac et compagnie," and beneath the same the words "PROPRIÉTAIRES DE VIGNOBLES RÉUNIS." The defendants, for the same purpose, adopted the words "J. Levanier et compagnie," and beneath the same the words "COMPAGNIE DES PROPRIÉ-

[1] Annales de la Prop., tome xvi. p. 73.
[2] § 182, *ante*. [3] § 189, *ante*.
[4] § 276, *ante*. [5] § 191, *ante*.
[6] Journal du Palais, 1854, p. 129.

.TAIRES DE VIGNOBLES." PER CUR.: The words "Propriétaires de Vignobles" (Vineyard Proprietors) is a generic qualification belonging to an indefinite number of proprietors, and cannot indicate to commerce the origin of the article to which they are affixed. Dismissed.[1]

§ 600. An application was made for the registration of the words "Great Lightening Ink Eraser." These words, being descriptive of the article to which they were intended to be affixed, could not be favorably entertained. The Examiner made a suggestion that the interpolation of a single letter had quite changed the meaning of the essential word. Any ink eraser would lighten the ink marks, and therefore might truly be called a lightening ink eraser. The diminution of weight was not the exact point. The verb could be taken in but one sense. It could not possibly be meant to imply that the applicants' eraser burst or darted forth with an instantaneous illumination. That would be nonsense. The second vowel made the trouble. The word should have been written "LIGHTNING." The use of the metaphor would then have imported that, with the quickness of the electric flash, the stains of ink would be caused to disappear. That improper spelling would, in ninety-nine cases in a hundred, defeat the cause of the person who claimed the word. The rule of *idem sonans* could not save it. A man is supposed to have meant what he said, especially when suing for a penalty.

§ 601. An inventor may give the products of his genius, or skill, or good fortune, a distinctive appellation of infinitely great value to him than a patent for the machine or discovery. This is a matter that is worthy of the consideration of applicants for registration. The object is to select, or rather invent, a designation peculiarly applicable to the thing of which a monopoly

[1] The report of this case states that, during the progress of this suit in France, Salignac in the name of his company had obtained from the Lord Chancellor of England an injunction, and sequestration of certain goods so marked found in the London Docks. If so, it doubtless was on the ground of unfair competition; for there is nothing of the nature of a trade-mark in the whole case.

is desired. Now for an illustration of this idea. In or about the year 1814, John B. Logier obtained from the British Government a patent for fourteen years, for an instrument for guiding the hands of learners on the piano-forte. He compounded two Greek words, signifying "to form the hand," and named his machine the "Chiroplast." He acquired great reputation and a considerable pecuniary profit from the favorable reception of the instrument. If it had occurred to him that this new word was a valid trade-mark, it would have mattered little that his patent expired in fourteen years; for the mark would have virtually given him a monopoly so long as the public called for the "Chiroplast." As it was, the word is now generic. — In *Bardin* v. *Gobert et al.*,[1] the plaintiff had obtained a patent for a species of ornamental feathers produced by his invention of detaching the epidermis of all kinds of natural feathers, and dyeing them of all colors, as ornaments of various sorts for head-dresses, finery, flowers, embroideries, lace-work, and tissues. This constituted a new product of commerce. It needed a name. He composed one, — "FAILLANTINE." This meant his patented article, and nothing else. It was a perfect trade-mark.

§ 602. **Propriety** must be the standard in the selection of something intended to serve as a symbol of commerce.[2] Commerce extends throughout the world; therefore a mark should be valid in all lands or it is valid in none. The moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes. There is no necessity for so doing, for the objects suitable for use as trade-marks are as infinite in number as the sands of the seashore. A violation of this rule is not only in bad taste, but is also an outrage. The spirit of commerce is conciliatory. We must not blindly follow the loose, random sayings of judges, that any emblem may be lawfully employed for this purpose.

[1] Annales de la Prop., tome xii. p. 380.

[2] See case §§ 342–344; also cases in § 370, *ante*.

To be a "lawful trade-mark" the emblem must not transgress the rules of morality or public policy. The law will not aid any person to blasphemously bring obloquy upon objects and symbols consecrated to religion. But what is religion, in its relation to commerce? It is the recognition of God, as an object of worship, love, and obedience. All peoples worship God under some form or other, or at least think that they do. Their religious prejudices must not be trampled upon. We tolerate all religions, true or false. A reader of these lines may be a Chinaman. His *joss* must not be caricatured. If a scoffer should endeavor to curry favor with an infidel class by the profane use of an Agnus Dei, or of any symbol of the Alpha and Omega, or the Ineffable Name, or even of angels, apostles, saints, and martyrs, or of a thousand objects depicted by ancient art, and hallowed by associations, would any court of justice sustain a claim to a trade-mark so composed? No! This is a rule of universal application. The Office hesitated to permit a representation of the Evil One himself to be registered as a trade-mark. The device is set forth in the specification as "a smiling, half-drunken demon or devil in a sitting posture, with the left leg raised at an angle of about forty-five degrees, while the right one is folded under it, and his tail passes over his right ankle. The demon wears a broad-brim hat with conical top and feathers, and in his arms and hands he carries six bottles." Enough! the frightful thing might possibly convey a moral lesson by an association of ideas. The *bottles* turned the scale. It had been recognized in Germany; and was registered.[1] Suppose, for the sake of further illustration of this topic, that the fiend had borne the likeness of a human being venerated by a large class of followers. It would have been in law an atrocious libel, and must have been rejected on that account.

§ 603. We have seen that a colored bordering of a woven fabric may be as valid a trade-mark as any other device, espe-

[1] Walter & Shaeffer, No. 434.

cially when announced as such, and recognized by the trade, and consequently will be protected like any other symbol of commerce.[1] But a mark must be well defined, and its nature be calculated to effect its object. As to what would be deemed an encroachment upon such a delineation, we have a decision of the Court of Cassation of France, made in May, 1872 (*Duqué & Co.* v. *Bobot-Descoutures*[2]). Both parties manufactured drillings. The complainants in their act of deposit — corresponding to our filing for registration — described their mark as composed of eight threads, arranged thus: two of violet, four of white, and then two of violet. The court said that it thence follows that the distinctive element of this mark is the number of threads, their disposition, and the alternation, as described. The defendants used four deep lilac threads, disposed so as to intertwine like a chain; whence it follows that the number of threads are not the same in both marks. The color is not the same, the complainants having two colors, while the defendant has but one color, — deep lilac. The disposition of threads is different: the violet and white of the complainants alternating, as stated, while in the defendants' the color is a unit. To disregard the number and disposition of threads in the complainants' mark, were to suppress one distinctive element, and to take it without the basis they have adopted to characterize the peculiar products of their manufacture. If their fabric be examined, in piece or in roll, there can be no hesitation in discovering the lack of resemblance between the two marks. In a word, from any point of view, no imitation can be discerned upon which to found a claim to damages, whether under the statute of 1857, or at common law (arts. 1382 and 1383 of the Civil Code). Both marks were recognized as valid.

§ 604. When a large number of persons are interested in a trade-mark, either as members of a joint-stock unincorporated company, or as the personal representatives of a deceased person, or as guardians of infants, any of the number may be

[1] See § 268, *ante*.

[2] Annales de la Prop., tome xvii. p. 305.

selected to make the application for registration, for their joint benefit. In one case, the papers were executed by one such person, in his own behalf and "as the representative of, and for the joint and equal use of the heirs at law," &c.; and yet he asked that the registration should be made in his name, *he* having adopted a trade-mark for the benefit of all the others. He afterwards filed an unauthenticated certificate purporting to be signed by seven others as "the only heirs at law and legal representatives of Alpha Richardson, deceased," in which he, the applicant, was recognized as "the representative of the heirs at law." Papers so inartificially prepared could not receive a very favorable consideration. The complication might easily have been avoided in this way: If all the parties had adopted a trade-mark for their united interest, or had inherited such mark, they were tenants-in-common thereof, and one might have been appointed attorney-in-fact by and for the others; or, regarded as a copartnership, a single member of the concern might quite as well have done the business of obtaining registration. In either case, the petition should have been assimilated to the form prescribed for a firm. All the parties would then have acted through one, and the certificate of registry might have issued in the names of all, or to them as a firm.

§ 605. The following case is a curious instance of the ideas that are sometimes entertained in regard to the constitution of a trade-mark. It came up in the Court of Paris, in 1865 (*Prudon* v. *Brousse et al.*[1]). The plaintiffs made up cigarette-paper in the form of a roll or endless-band, with sections indicated, being kept rolled by means of a caoutchouc band, which they patented. They then made a deposit of what they assumed to be their trade-mark, *i.e.*, the cylindrical form of their product. The Tribunal of Commerce of the Seine having rejected their suit, they appealed. The appellate court affirmed the judgment, saying that although that peculiar form of the

[1] Journal du Palais for 1865, p. 1125.

complainants' product had been used by them exclusively for a number of years, it could not constitute the commercial property known as a trade-mark.

§ 606. Here is another singular case, filed by a firm of solicitors largely engaged in patent practice. The symbol was described as the picture of a tiger, or the word "Tiger," but the essential element was stated to be "the *idea* of a tiger." The Examiner was perplexed. Fac-similes must be furnished by all applicants. A fac-simile is that which is made exactly like the mark impressed upon the vendible commodity; an exact copy of the writing, engraving, stamp, or brand. How to get a fac-simile of an idea was the embarrassing question. It was not understood how a mental conception, a thought, a sensation, or whatever it might be termed, could be impressed upon, or otherwise affixed to goods; but out of a feeling of respect the matter was fully considered. The Examiner suggested that a trade-mark must necessarily consist of a visible and invariable form. The solicitors did not accept the hint. Thus the matter stands. If they had been content with the excellent delineation of a tiger filed by them, or with the word "Tiger," or both together, the case would have been of easy solution. This shakes our faith in the maxim, *Utile per inutile non vitiatur*; for here is something serviceable which is completely neutralized by a useless adjunct.

§ 607. **Rejection because of False Suggestion.** — The application-papers may be perfect in form, and, so far as verbal language goes, quite impregnable, and yet be open to assault. The sworn statement is not always conclusive. The case as presented is liable to dissection, and hideous deformities to be exposed to view. The allegations may be true in letter, and false in spirit. The Office will penetrate the surface, and endeavor to reveal any latent fraud. The circumstances are compelled to testify, and keen examination, like the spear of Ithuriel, forces the truth from unwilling witnesses. The declarations of good faith may be overturned. Spurgeon says

that no one is more like an honest man than a thorough rogue. There seems to be no end to the devices of unworthy traders, to trick their rivals and the public; nor can there well be until bounds shall have been set to human ingenuity. Yet, to warrant a refusal to register, there must be sufficient evidence of unfairness to overcome the natural presumption of honesty and fair dealing. For that reason, many suspicious cases are allowed to pass muster, and to go into the field of active strife armed with the certificate of the Patent Office, with the chance that justice may eventually overtake them. The Office is not bound to hunt for motives not made apparent by the papers; yet if the *ex parte* case cannot look one fairly in the face, the blandest words shall not save it from condemnation. It has been vehemently said that the Office is not the conservator of the morals of the community, nor does it aspire to be. But it has a duty to perform, and that duty is to carefully scan each proposed case, and, if necessary, to probe it through and through. A self-styled trade-mark may upon examination be found to be a brazen-faced counterfeit. Any objection to validity which might be made in subsequent judicial proceedings may be anticipated in an application for registration;[1] and fraud is certainly the most formidable foe that can appear.

§ 608. The fraud which would justify a refusal to register a proposed trade-mark may be, 1. Actual or positive fraud; 2. Constructive fraud. That is, it may be the intentional employment of any cunning, deception, or artifice, to circumvent, cheat, and deceive purchasers;[2] or it may consist in such acts which, — though not originating in evil design and contrivance to perpetrate a positive fraud or injury, yet by their necessary tendency to deceive and mislead, or to violate public

[1] "The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark." Sec. 79, Act of July 8, 1870.

[2] Dolum malum esse omnam calliditatem, fallacium, machinationem ad circumveniendum, fallendum, decipiendum alterum adhibitam. Dig. 4, 3, 1, 2; Poth. Obl. n. 28.

or private confidence, — are deemed equally reprehensible with positive fraud, and therefore are prohibited by law, as acts done *malo animo*.[1] The public must be protected, at least to the extent of declining to recognize a mark as the valid symbol of honest traffic, when bad faith is apparent. Fraud is not to be judged of by the event only, but also by the design.[2] Even the appearance of evil is a sufficient justification for rejecting an application. Without making invidious distinctions between the various classes of cases presented for registration, we may use the following by way of illustration.

§ 609. The words "Hamburger Tropfen" (Hamburg Drops) were proposed for registration, as a trade-mark for a certain kind of medicine.[3] The Office replied that it is difficult to conceive upon what principle such words could be upheld as a lawful trade-mark. They are printed upon a label which is entirely in the German language, and which, beyond a doubt, is addressed to German-speaking people. To them the said words are plain "Hamburg Drops," and nothing more. The words are therefore descriptive, that is, if the medicine truly consists of drops coming from or made in Hamburg. Any person in Hamburg has a right to manufacture "drops," and as much right to give those drops the geographical name of "Hamburg." But there is another objection. The label upon which the said words are printed has upon it the representation of an ornamented mortar-and-pestle, beneath which are the words "*Handels Marke*," besides a caution, and a fac-simile of the signature, "Dr. August Koenig." These words clearly indicate the previous appropriation of the said representation, as a trade-mark, and that by some one other than the applicants. By reference to the application-papers, it will be perceived that the medicine of the applicants, upon which article it is proposed to use the words "Hamburger Tropfen," is man-

[1] 1 Story Eq. Jur. § 258–440.

[2] Fraudis interpretatio semper in Jure Civile non ex eventu duntaxat sed ex consilio quoque consideratur. Dig. 50, 17, 79.

[3] A. Vogeler & Co., *ex parte*, 1872.

ufactured by them at Baltimore, Maryland. Such a label is calculated to mislead the public. For both reasons, the application was rejected.

§ 610. The words "American Sardines,"[1] as applied to certain fish prepared for food, were refused registration, for a similar reason. The objections were, the descriptive nature of the words on one hand, and their tendency to mislead on the other. The written argument of the applicant's counsel admits that the fish to which these words are applied are not really sardines, but are "*menhaden*," or "*moss-bunkers*," which, cooked in any ordinary way, are not eatable, owing to their numerous fine bones, and were therefore used only for making oil until treated by the applicant's patent process. The words "American Sardines" cannot, in view of this fact, be held to be descriptive. But a more formidable objection remains for consideration, said the Office, — the tendency to mislead the public. The counsel attempt to meet this objection by insisting that no one who has ever seen a sardine could mistake the so-called American Sardines for the genuine Mediterranean fish; for, say they, the applicant's fish are "at least six times as large, though supposed to be of the same (herring) family." The Office replied, as follows: The truth is this, the inferior fish, the moss-bunkers, are put up by the applicant in tin boxes similar in size and general appearance to those containing the genuine delicate fish, brought from the vicinity of Sardinia. It is not possible for any unadvised purchaser to draw comparisons between the appearance or sizes of the applicant's preparation of fish and the genuine, until the box is opened; and the box is not opened until after purchase. By that time the mischief will have been done. It may be that the wholesale dealer would not in the least degree be misled by the misuse of the word "Sardines," or by the appearance of the box with its French words on a brass label; and retail dealers might be cautious enough to look at the English words on said label,

[1] Case of "The American Sardine Company," 1872.

and draw the correct inference; but they are not the only classes who are to be shielded from deception. The careless, the ignorant, the inexperienced, must be protected; for they buy on the faith of a single glance of the eye at the outside of the box bearing the attractive appearance of a genuine package of sardines. It is denied that there is any *intention* on the part of the applicant to mislead. That is not material in our present investigation. The real question is this: Is the use of the name, "American Sardines," as applied to a box resembling the genuine sardine-box, calculated to mislead the public in the purchase of an article of merchandise? It is not necessary for the determination of this question that any purchaser shall actually have been deceived. Would the public be likely to be misled? They would be. Then, the proposed trade-mark cannot have the sanction of registration. As to the *bona fides* of the applicant in adopting said words: Why apply the words "sardines?" As moss-bunkers, perhaps the article would not sell. It is said that the words "American Sardines" are not given to the fish themselves, but to the fish as prepared under a peculiar process. The public would buy the prepared fish as genuine sardines, which they are not. Even if the American prepared fish are superior in taste and nutritious qualities to the Mediterranean fish, there is no reason why a purchaser should not have exactly what he calls for. Application finally rejected.

§ 611. An application was made for the registration of the words "Richardson's Patent Leather Splitting Machine." These words being purely descriptive of the article upon which they were placed, the case was rejected upon that technical ground. Upon a close inspection of the papers, it was observed that the applicant set forth that he had adopted a trade-mark consisting of those words, while in another place in the same documents he alleged that the mark had been in use for upwards of twenty years. The statements are objectionable for repugnance. That is not all that may be said. To use a mild

expression, the mode of relating the facts is very suggestive. Under this gentle aspect, what motive lies concealed? The phraseology — "for a term of upwards of twenty years" — is simple and indefinite enough, and may reasonably be inferred to mean at least twenty-one years. A patent granted prior to March 2, 1861, expired in fourteen years, unless extended, in which case its duration would have been prolonged for seven years. In either event, the monopoly must have ceased. What would have been the practical effect of a recognition of this assemblage of words as a trade-mark? For all time, the idea must thereby have been conveyed that a patent upon the machine was still in force, and the monopoly, which Government had limited, might by an ingenious manœuvre have been perpetuated.

§ 612. We need be at no loss to find precedents on this point of false suggestion. Where one person had adopted as his trade-mark the word "$\frac{\text{Hero}}{\text{ine,}}$" he was an infringer who used the words "The Heroine" for the same class of merchandise.[1] So, when one person distinguished his black cotton stockings from those made by others, by six plain lines one above another, and about the eighth of an inch apart, going round each stocking near the top of the leg, and the word "ETHIOPIAN" printed in Egyptian characters below said lines in a segment of a circle, and another person stamped lines and characters somewhat similar on his stockings.[2] So, also, in the "Chemical Paint" case, the "Cocoaine" case, the "Eau de la Floride" case, and many other instances that may be found in this book. The intent is to deceive.

§ 613. **Litigation not unduly encouraged.** — Applications for registration are frequently made with the idea of obtaining thereby a *primâ facie* title, as the basis of judicial proceedings. It may be well worth the while of a capitalist to be enabled, by the production of a certificate of registry, to throw the burden of

[1] Rowley *v.* Houghton, 2 Brewster, 303.

[2] Hine *v.* Lart, 10 Jur. 106.

proof upon an adverse party; and by obtaining a preliminary injunction founded thereon fetter, if not destroy, the business of another. We will suppose that some article has a transient popularity. The moment of demand must be seized. The delay of a few months may be fatal to success; for fortunes sometimes depend upon instantaneous action. The article is known by a certain mark, and that mark is a name. That name is the talisman that works prosperity. Whoever has the sole right to stamp that magic symbol on his goods, wares, merchandise, has the monopoly. An injunction is applied for. The proof of registration affords strong presumptive evidence of title. The provisional injunction is granted. Weeks, months, perhaps years, must elapse before the controversy can be determined upon its merits. In the mean time, the enjoined party suffers irreparable injury. It matters little who shall eventually win the battle. Craft, insolence, and abundant pecuniary means, will by that time have reaped the golden harvest. This is not a fancy sketch. It has been exemplified in more than one instance; and the Office has been cautioned thereby. The moral responsibility of a want of due caution rests upon the public officer. He is to guard against error, intentional or innocent. He who is persuaded that he has a right may be guilty of a mistake, and not of deceit.[1] Whatever may be the cause of a misstatement of facts, the legal result is the same: the thing proposed cannot become a lawful trade-mark. Thus, where it was alleged that the trade-mark consisted essentially of the words "Rip Van Winkle," and a triangle enclosing the applicant's initials, and it was found that another house had the words "Rip Van Winkle" as a mark for the same class of merchandise, the application was rejected.[2] The imitation was only in part, but was sufficient to cause confusion, and likely to provoke litigation.

[1] Nemo videtur dolo exequi, qui ignorat causam cur non debeat petere. Dig. 56, 17, 177.

[2] Case of Fechheimer & Workum, *ex parte*, 1872.

§ 614. **Surrender and Reissue** cannot, in strict parlance, be said to be applicable to a trade-mark case. But it sometimes happens that errors creep into certificates, or application-papers. If the error is on the part of the Office, the party cannot be prejudiced thereby;[1] and the correction will be made without cost to the applicant.[2] If, after a party obtain registration of a trade-mark, he discover that the certificate of registry is inoperative, or invalid by reason of a defective or insufficient statement or specification, or by reason of too great a breadth of claim, which error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, he may be permitted to surrender his certificate, and obtain another. In one case of the kind the mark consisted of an elaborate design, consisting of a cross, crown, wreath, vines and bunches of grapes, and a number of words. In the centre were the words "Sazerac de Forge & Sons." The two latter words should have been in French,—"*et Fils.*" This was a mere clerical error. The holders of the certificate filed a new application, paid the full fee, and asked for a new certificate. The Office suggested that the original certificate should be surrendered. That being done, the amended case was registered.[3]

§ 615. **Money paid as Fee, when returnable.** — It is provided by statute, "That the Treasurer of the United States is authorized to pay back any sums of money to any person who shall have paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasurer, as for fees accruing at the Patent Office, through mistake, certificate thereof being made to said Treasurer by the Commissioner of Patents;"[4] but a mere change of purpose, after the pay-

[1] Phelps *v.* Brown, 1 Fisher, 479.

[2] Case of James Cochrane, Commissioner's Decisions, 1869, p. 60, and case of Havemeyer *et als.*, ibid., 1870, p. 5.

[3] Ives, Beecher, & Co., No. 547.

[4] Sec. 71 of An Act to revise, &c., the statutes relating to patents and copyrights, of July 8, 1870.

ment of money, will not entitle a party to demand such a return.[1]

§ 616. The money must actually have been paid through *mistake*, to authorize a return. In any case, where the Office had no jurisdiction of the subject-matter filed, such return will be made; as, for example, where a non-trading corporation filed an application for the registration of a mark, which was therefore not a trade-mark, in contemplation of law, the money was returned. So, in a case where an applicant transmitted a fee which he desired to be applied for copyrighting a picture, which matter is solely within the cognizance of the Librarian of Congress. But when the Office has undoubted jurisdiction of the class to which the case belongs, the fee will have been earned the moment of the first action by an officer. The Government does not undertake to warrant a valid title, or any title at all. The party is presumed to know the true state of facts, as well as the law, before he applies for registration. If his application is rejected for any cause, the money paid will be retained, by way of costs.

[1] No. 111, Rules of Practice of Patent Office.

CHAPTER XIV.

INTERFERENCES IN PATENT OFFICE.

Skill demanded. — Definition. — In what Cases declared. — Preliminary. — Declaration and Dissolution. — Notice. — Grounds for declaring. — Compulsory Testimony. — Access to Testimony filed. — Printed Copies of Testimony. — Postponement. — Information in pending Cases. — Sources of Evidence. — Rules for taking and transmitting Testimony. — Case closed. — Hearing. — Appeal. — Practice exemplified. — "Durham" Case. — Decision of Examiner. — Of Commissioner. — Of Court. — "Bouquet" Case. — Multiplicity of Legal Questions. — "Paul Jones" Case.

§ 617. **Interferences** frequently demand the most skilful management, and bring into requisition all the acumen and learning of the ablest lawyers, so far, at least, as regards the taking of testimony, and the application of the rules of evidence. This presupposes an intimate acquaintance with the law of the case in hand.

§ 618. The matter must be as carefully conducted as though it were pending in a court of equity; indeed, the practice is moulded upon that of such a tribunal. As in controversies in courts, substantial rights may be frittered away by an inartificial mode of procedure; by a failure to evoke evidence of material facts, owing to a slovenly mode of examining witnesses; or by such irregularities in practice as are beyond toleration when the interests of another party are at stake.

§ 619. True it is that the Office earnestly strains after the furtherance of justice; but to this — as to all worthy endeavors elsewhere — there is practically a limit; and litigants must generally be left to rest as best they may upon the beds made

by themselves. An issue is joined, testimony is taken, objections and points are made, arguments are heard, and the Office decides upon the whole matter as presented. Leading and other improper questions and the answers to them are ruled out, and, may-be, whole depositions are eliminated for want of proper care having been given; for manifest lack of good-faith; or for some other fault, although it may be the result of sheer ignorance or carelessness. In case of surprise, relief will be given to an innocent party. Thus, upon a motion to reopen an interference in order to receive testimony which had been delayed until after the day of hearing by the fault of the officer before whom it had been taken, the decision of the Examiner was suspended, and the case set for immediate hearing upon the testimony and arguments by that time in.[1] But after one party had filed his preliminary statement and taken his testimony, the Commissioner refused to open the case and allow the other party to file a preliminary statement and take testimony, where, although not originally a party, it appeared that he had had knowledge of the pendency of the interference, and the proceedings under it.[2]

§ 620. It may here be remarked, that seeming mere irregularities are sometimes the manifestations of subtlety and craft of tricky practitioners. Their object is to discover the weakness of the adversary, and then by feigned surprise, or plausible excuse, obtain permission to take additional testimony. Such persons can usually find witnesses to supply all deficiencies in the evidence. When such a motive becomes apparent, the Office is sometimes called upon to exercise some ingenuity to circumvent villany, for rogues like them care little for frowns of indignation.

§ 621. **An Interference is defined** to be an interlocutory proceeding for the purpose of determining which of two or more persons, each or either of whom claims to be the first adoptor

[1] Hayden *v.* Phillips, Commissioner's Decisions of 1870, p. 171.
[2] Aldrich *et al.* *v.* Bingham, id. p. 90.

of a trade-mark, really did first adopt it. It may also be resorted to for the purpose of procuring evidence of an alleged abandonment of the mark in controversy.

§ 622. It will be declared in the following cases: *First.* When the parties have pending applications before the Office at the same time, both or all of the parties claiming priority of title to the same mark, — or one substantially the same, — used to indicate the same class of merchandise. *Second.* When an applicant — having been rejected upon a previously-registered trade-mark — claims an older subsisting title.

§ 623. Under the rule as to an older subsisting title, this case may arise, and may as well as not be anticipated in this place. A. may have in good-faith registered his mark, supposing that no one else in the world had appropriated it for the same purpose; and as a fact it may be that no other person had any right to ask for registration, when A. made his application. He then stood alone before the Office, with a *primâ facie* case, at least. If any other person had a better right to the thing, that right was not made manifest. Accordingly, his claim is admitted, and a certificate of registry duly issued. We concede that A. was the only person who had a legal right to registry. By virtue of a treaty subsequently made with some foreign country, B. comes in and demands that his trade-mark be registered in pursuance of the treaty stipulations. His proof is clear that he had adopted the mark long before A. What is to be done? A. acted in ignorance of B.'s right, and in perfect honesty. To deprive him of the exclusive right to the use of his symbol of trade may do him irreparable injury. He was diligent; he was truthful. At the time of registration, he was the only person in the world who had any standing before the Office.

§ 624. The solution of the question is easy to him who has studied the principles upon which rest the laws of a right to a trade-mark. The question thus far presented is one of registration. We must pass that by, and come to the real ques-

tion, — Who had the prior right to the use of the mark? If it were a claim to letters-patent for an invention, or to a copyright, the junior applicant might well be refused relief; for patents and copyrights are the creatures of arbitrary law, and, the courts say, have no foundation in nature. But not so in a matter of property in the conventional symbol that is the substitute for a man's name. That is founded upon immutable law, as we have before seen. Such being the case, B.'s priority of right must prevail; and for this reason: It was not his *right* but his *remedy* which was in abeyance. The treaty which demolished the partition-walls admitted him to all the privileges of the most-favored persons. But then he ousted another from a vested right? No: it was only an apparent right; for if the Patent Office had had any knowledge that any one else in any country had an older title, the application for registration would have been refused. B. had all the time a perfect common-law right, and could have sued in our courts as an alien friend, without the slightest regard to the matter of treaty or convention. — We could readily imagine other cases just as curious, and yet within the limits of probability. A. might, for instance, set up that, even if B. had once had a title to exclusive use, he had abandoned all right to the same; and that thereupon he, A., was the first to appropriate it to his sole use. B. having established his claim, the next step is to issue to him a letter of registry. That will be to have two outstanding titles to the same property at once. Yes, until a court shall have enjoined one from the use of the symbol; or the wrong-doer shall have voluntarily relinquished all claim to it. The Commissioner has no power to cancel a certificate of registration already issued; for that is a matter for judicial cognizance upon a suit to be brought by the Government, either in its own name or the name of the Attorney-General; or by some form of proceeding which can give official assurance of the sanction of the proper authority.[1] But the Commissioner may, if he find

[1] Mowry *v.* Whitney, Sup. Ct. U. S., April, 1872: Official Gazette of Patent Office, May, 1872.

that another was the prior adoptor, give him also a certificate of registry; and thus place both parties on the same footing before the courts and the public. His authority for so doing is found in the proviso to the 79th section of the trade-mark law of July 8, 1870.

§ 625. **Preliminary Interference.** — Before the declaration of an interference proper, a preliminary interference will be declared. In that, each party will be required to file a statement under oath, giving a detailed history of the circumstances of his adoption of the mark; the extent and manner of application to merchandise; and the particular description of goods to which it was by him affixed; and giving, so far as practicable, the exact date of each step in the act of appropriation. This statement must be sealed up *before* filing (to be opened by the Trade-mark Examiner only); and the name of the party filing it, and the subject-matter of the case, must be indicated on the envelope.

§ 626. As just intimated, the real point sought to be evolved is the exact time of adoption; and, as circumstances, the manner of application, place of adoption, and the class and species of vendible articles to which it was applied. It should also appear who made the original appropriation, whether the claimant or some one from whom he derived title; and if done through an agent, that fact should be stated. The case of *Schrauder* v. *Beresford & Co.*, hereinafter given, shows the importance of a circumstantial detail of facts, and especially the necessity for setting forth the exact date of placing the symbol upon goods offered for sale.

§ 627. The statute requires that the length of time, if any, during which the trade-mark has been used shall be stated in the application; and the statement is generally conclusive against the affirmant in any subsequent proceeding; for it would not be just to allow him to fix a date under oath, and afterwards, when another claimed a prior title, to come in and alter the date so as to anticipate his opponent's title. In one

case,[1] the Commissioner held that such preliminary statement should always be regarded as conclusive against the party making it, restricting him to the date, and substantially to the history therein set forth, while, by a well-known rule of law, it can never be used as evidence against the adverse party in interference; and in another case, it was said that if testimony, taken upon an interference, tends to set up an earlier date than was claimed in the preliminary statement of the same party, it must, at least, be viewed with grave suspicion.[2] The stringency of this rule is sometimes relaxed, upon overwhelming evidence of unintentional error, and of perfect good faith; although, of course, the presumption is always against him who would attempt to vary a statement made under the solemnity of an oath. In a patent case,[3] the Commissioner said: "The object of the preliminary statement is to serve as a pleading, in which each party, in ignorance of his opponent's case, sets forth the history and date of his own invention. This he must know better than any one else, and he will be held to make a full and accurate disclosure, without evasion or reservation. He must distinctly state the date which he proposes to prove as that of invention, and he must set forth the substantive *act* of invention, upon which he proposes to rely. . . . It is proposed to put an end to the practice which, it is to be feared, has prevailed to too great an extent, of striving on each side to learn an opponent's date of invention, only to manufacture such proof as may be necessary to fix an earlier date." Yet cases do sometimes arise when this rule cannot, in accordance with justice, be enforced to its fullest extent; as, for example, where, in one instance not reported in print, the evidence was clear that by unavoidable mistake the date was incorrectly stated, one numeral having been mistaken for another in transcribing. Even in such a case, the evidence of good-faith must be beyond reasonable doubt.

[1] Kenyon *v.* Wesson, Commissioner's Decisions, 1871, p. 91.
[2] Tegmeyer *v.* Kerns, id. p. 285.
[3] Schenck *v.* Rider, id. p. 135.

§ 628. The oath should be made by the party himself, unless, as may occur, he be not the most cognizant of the facts. One may be able to state that he adopted a mark for his merchandise, without being able to fix the exact date of the consummation of his intention, — that is, the actual stamping or otherwise marking of his goods; for he may possibly have acted through an agent at a distance from him. By virtue of the maxim, *Qui facit per alium, facit per se*, the physical act of his agent would enure to his (the principal's) benefit, though the one were at the moment in Boston, and the other in San Francisco. In making the oath to the preliminary statement, as in any other case of litigation, of course the best available evidence should be advanced.

§ 629. The preliminary statements are not open to the inspection of the opposing parties until both shall have been filed, or until the time for filing both shall have expired; nor then, until they shall have been inspected by the Examiner of Trade-marks, and are found to be sufficiently definite as regards the declaration of dates.

§ 630. If the party upon whom rests the burden of proof fail to file a preliminary statement, or if his statement fail to overcome the *primâ facie* case made by the respective dates of application, or if it show that he has abandoned his alleged trade-mark, the other party will be entitled to an immediate adjudication of the case upon the record; unless a presumption arise that his claim of right to registration is affected by a dedication of his mark to the public, in which case the interference may be proceeded with. Although the statement of one party may admit his lack of title to exclusive use of the mark in dispute, he may be prepared to prove the same lack of title in his opponent.

§ 631. If the earlier applicant fail to file a preliminary statement, no testimony will subsequently be received from him tending to prove that he adopted the mark at a time prior to that fixed in his application. The preliminary statement

can in no case be used as evidence on behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination by the other party.

§ 632. If either party require a postponement of the time for filing the preliminary statement, he must present to the Examiner his reasons therefor, in the form of an affidavit, and prior to the day previously set.

§ 633. **Declaration and Dissolution.** — An interference will not be declared until the subject-matter involved is decided to be registerable; and, when once declared, it will not be dissolved without judgment of priority, unless it be found that neither party is entitled to a certificate of registry, or that no interference in fact exists. And at whatever stage it is ascertained that there is no conflict between the claims of the parties, it will be dissolved, whether before the Examiner or the Commissioner; for to continue it would be a waste of time, and would avail nothing.[1] Thus it will be dissolved, *ipso facto*, by the withdrawal of one of the parties;[2] or it will be dissolved upon one of the parties striking out from his specification the only element of conflict;[3] or it be found that the registration of one will be no bar to the other.[4]

§ 634. **Judgment based upon Concession of Priority** will not be given unless such concession be evidenced by a writing, under the signature of the party himself. If there have been an assignment of the trade-mark, the assignee must join in the concession, although not a nominal party. The withdrawal of one party does not entitle the other to a decision in his favor on the question of *priority*;[5] for it may be that his withdrawal is by way of nonsuit, with an intention to renew the contest when better prepared; or it may be by collusion, when neither party has any right.

[1] Jenkins *et al.* v. Putnam, Commissioner's Decisions, 1870, p. 156.
[2] Eames & Sealey *v.* McDougal, id. 1871, p. 206.
[3] Hawkins *v.* Lambert, id. 273. [4] Jackson *v.* Nichols, id. 278.
[5] Eames & Sealey *v.* McDougal, *supra*.

§ 635. **Notice to Parties.** — When an interference is declared, notice will be given to both parties, or to their attorneys. When one of the parties has received a certificate of registry, duplicate notices will be sent to him and to his attorney of record. Where one of the parties resides abroad, and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in a newspaper of general circulation in Washington, D. C., once in a week for three successive weeks.

§ 636. If there be more than two parties, the times for taking testimony shall be so arranged, if practicable, that each shall have an opportunity for so doing in his turn, each being held to go forward and prove his case against those who shall have filed their applications before him.

§ 637. As the parties are to prove the facts by the adduction of evidence before the Examiner, and have, consequently, to provide themselves with the proper documentary or other testimony, it is essential that they should each be apprised of the specific nature of the question to be tried, for the guidance of the parties in preparing their proof. The notice of interference sent by the Office to the parties states the point in issue. For example, in a complex mark there may be one prominent element, as in the "Paul Jones" case, hereinafter given, where that name of a naval hero was really the whole case, although it was displayed upon a flag flying on a ship under full sail. The parties entered into the contest with the knowledge of that name being the only material point of inquiry.

§ 638. **Grounds of Interference.** — Marks do not conflict unless they are identical in form, or have such a near resemblance to each other that the public may confound them, and thus purchase the goods of one man when intending to obtain those of the other. Although there may be *some* points of resemblance, that will not warrant the declaration of an interference, unless confusion be likely to ensue. Take the following case as an illustration. One person obtained a certificate of registry

(No. 709, March 19, 1872) for a trade-mark for shirts, drawers, &c., which mark was described as consisting of "a balance, a shield, and the word 'CENTENNIAL' arranged as shown, numbers designating the size and quality of the goods being, if desired, marked upon the shield." Other persons, composing a partnership, subsequently obtained a certificate (No. 809, May 7, 1872) for a trade-mark, for substantially the same class of merchandise. The mark of the latter was described as consisting of the word "CENTENNIAL," which word was alleged to be generally arranged as shown in the label filed, the central or middle part being covered by a pictorial representation of the Declaration of Independence, within a wreath, which wreath is held and crowned by the American eagle, below which is a character symbolical of the word "CENTENNIAL." The word "CENTENNIAL" alone constitutes the mark, all the remainder being dispensed with at pleasure. Counsel for the earlier party, on becoming apprised of the second case, made this point: That the record showed sufficient grounds for the declaration of an interference, and that the later adoptors had no right to appropriate a word which was one of the essential elements of the trade-mark of the other claimant; and it was suggested that the latter, who was the prior adoptor, was prepared to discard all the other elements of his mark, and confine his claim to the one word. The Examiner held that the specifications on file were the *criteria* of action; and that as they did not disclose any conflict of claims, inasmuch as the two things were so dissimilar that they were not calculated to deceive, it was not a proper case for an interference. If the prior applicant limited himself to the use of the word in combination with other things, it was his misfortune. Thus the junior applicants were left with a broad claim to the word "CENTENNIAL," which they might use in combination or not, at pleasure. Thereupon, for the purpose of obtaining an adjudication on the question of priority of adoption, the senior registrant filed a new application, in which he claimed the word

"Centennial" as the essence of his trade-mark. That proceeding raised a simple question of fact, to be decided upon an interference trial.[1]

§ 639. **Compulsory Testimony.** — Previously to the passage of the Act of Congress of March 2, 1861, it was within the option of witnesses to give their testimony or not, so that there were frequent failures of justice. That Act provides, "That the Clerk of any court of the United States for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue a subpœna for any witness residing or being within said district or Territory, commanding him to appear and testify before any officer in said district or Territory authorized to take depositions or affidavits, at any time and place in the subpœna stated; and if any witness, after being duly served with such subpœna, shall neglect or refuse to appear, or, after appearing, shall refuse to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases."[2] The Act further provides that the witnesses shall be allowed the same fees as are allowed to witnesses attending the courts of the United States; and they are not compelled to attend at any place more than forty miles from the place where the subpœna is served, unless the fees are paid or tendered in advance. As parties in interest are competent witnesses in the Patent Office, as in the Federal Courts, they may testify upon deposition on their own behalf; but whether they are intended to be included within the provisions of the section above quoted is a disputed point. As a fact, however, it may be stated that in practice in interference cases, a party has been compelled to appear and testify against his own interest; and it is equally true that parties generally do not contest the matter, but prefer to testify.

[1] Sternberger *v.* Thalheimer & Hirsch, Nov. 1872.

[2] Re-enacted as sec. 44 of the Patent Act of July 8, 1870.

§ 640. **Parties have Access to Testimony** on file prior to the hearing, in presence of the officer in charge; and copies may be obtained by them at the usual rates.[1]

§ 641. **Printed Copies** of the testimony greatly facilitate the examination of cases; and they are required in all cases when the testimony is written otherwise than in a fair and legible hand.[2]

§ 642. **Postponements.** — If it become necessary for either party to have the time for taking his testimony, or for the hearing, postponed, he must make application to the Trade-mark Examiner for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his motion.

§ 643. A motion to open an interference for a rehearing, after a decision *sub silentio*, will be refused where there has been gross negligence in preparing for it. There is a case[3] where, *four* months after the decision had been made, and after frequent allowances of additional time, the party had the cool assurance to ask for a still further opportunity. His motion was denied. Up to that time he had taken no proof, offered no affidavit except his own to show what proof he desired to offer, or that any evidence did exist; and his own affidavits gave no details, but were most general in their statements. The Office regarded his persistent waste of time as intended simply for delay, although he made affidavit to the contrary. This is an extreme case; for it is seldom that repeated postponements would be countenanced, unless by the consent of the adverse party.

§ 644. **Information in Relation to Pending Cases** is given so far as it becomes necessary in conducting the business of the Office, but no further. Thus, where an interference is declared be-

[1] Rule 118. [2] Ibid.

[3] Covel *v.* Maxim *et al.*, Commissioner's Decisions, 1869, p. 78.

tween two pending applications, each of the contestants is entitled to a knowledge of so much of his opponent's case as to enable him to conduct his own understandingly.[1]

§ 645. **Sources of Evidence.** — As in equity cases, these are principally four. *First*. The intelligence of the tribunal, or the notice which it judicially takes of certain things, and the things which it presumes; *secondly*. The admissions of the parties, contained in their specifications and statements, which serve as pleadings; *thirdly*. Documents; and, *fourthly*. The testimony of witnesses.

§ 646. As a rule, the parties may by written consent make almost any thing evidence, unless the effect would be injurious to the public; as, for example, the admission that one of the parties has a good title when the contrary is clear. No such admission of an adversary would be deemed sufficient to warrant the issue of a certificate of registration where the Office had judicial cognizance of the untruth of the admission; for not only is the case to be decided upon the issue joined by the parties, but the interests of the community at large are to be looked after.[2] The law of evidence as settled by the courts is used in the matter of interferences, so far as applicable. Official papers; the precise state of our relations with a foreign government; the dates of public events, such as proclamations of war and peace, which may affect the forensic privileges of parties; treaties, and conventions with foreign powers, — will all be judicially recognized. The principal source of evidence is the testimony of witnesses taken upon deposition. The rules of practice of the Patent Office prescribes the regulations for taking and transmitting testimony in an interference case, viz.: —

> Before the deposition of a witness or witnesses is taken by either party, due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where such deposition or depositions will be taken, with the names and residences of the witness or witnesses then and there to be examined, so that the opposite party, either in person or by attorney, shall have full opportunity to cross-examine the witness or wit-

[1] Rule 128.

[2] See sec. 79, Act of July 8, 1870.

nesses: *Provided*, That if the opposite party, or his counsel, be actually present at the taking of testimony, witnesses not named in the notice may be examined, but not otherwise; and that neither party shall take testimony in more than one place at the same time, nor so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

The notice for taking testimony must be served by delivering a copy to the adverse party, or his agent or attorney of record or counsel, as provided in Rule 77,[1] or by leaving a copy at the party's usual place of residence with some member of the family who has arrived at the years of discretion; and such notice shall, *with proof of service of the same, and a certificate, duly sworn to, giving the manner and time of making the service*,[2] be attached to the deposition or depositions, whether the party cross-examine or not.

The magistrate before whom the deposition is taken must append thereto his certificate, stating the time and place at which it was taken, the name of the witness, the administration of the oath, at whose request the testimony was taken, the occasion upon which it is intended to be used, the names of the adverse party (if any), and whether they were present; and *immediately upon the close of the examination* he shall securely seal up all the evidence, &c., and forward the same *forthwith* to the Commissioner of Patents, making upon the envelope a certificate, giving the title of the case and the date of sealing and addressing the package.

If either party shall be unable, for good and sufficient reasons, to procure the testimony of a witness or witnesses within the stipulated time, it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied by statements *under oath of the cause of such inability, and of the names of such witnesses, and of the facts expected to be proved by them, and of the steps which have been taken to procure said testimony, and of the time or times when efforts have been made to procure it*; which notice to the Commissioner shall be received by him previous to the day of hearing aforesaid. Copies of the papers, and notice of any motion based upon them, must also be served upon the opposite party, as provided in rule 50. [This provides that reasonable notice of all motions, and copies of the motion papers and affidavits, must be served upon the opposite party or his attorney. Proof of such service must be made before the motion will be entertained by the Office; and motions will not be heard in the absence of either party, except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken to the Commissioner in person.]

[1] Rule 77 provides that if there be no attorney of record, the service of notice may be made upon any attorney or agent who takes part in the service of notice, or in the examination of witnesses of either party.

[2] Notwithstanding this phraseology, an admission of service by the adverse party or his agent, attorney, or counsel, duly appointed, will be deemed equivalent to the sworn certificate. See form of proof of service in the Appendix.

The official *records* of the Office, and other books and documents contained in the library, may be used at the hearing; but notice of any special matter contained therein, upon which a party relies, should be given to the opposite party previous to the day set for closing testimony.

The folios of each deposition must be numbered consecutively, and the name of the witness be plainly and conspicuously written at the top of each folio. It is deemed desirable that the testimony be taken upon legal-cap paper, with a wide margin on the left-hand side of the page, and that only one side of the sheet be written upon.

The testimony may be taken in narrative form; but, if either party desires it, it must be taken in answer to interrogatories, having the questions and answers committed to writing in their regular order by the magistrate, or, unless by consent, by some person not interested in the case, either as a party thereto or as attorney. The deposition, when complete, must be signed by the witness.

No evidence touching the matter at issue will be *considered* upon the day of hearing which shall not have been taken and filed in compliance with these rules; but no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it: and in such case it should be made to appear that, as soon as the party became aware of the objection, he immediately gave notice thereof to the Office, and also to the opposite party, informing him at the same time that, unless corrected, he shall urge his objection at the hearing.

§ 647. **Case closed.** — When no testimony shall have been taken by the party upon whom rests the burden of proof, or when testimony shall have been taken by such applicant, but not by the other party during the time assigned to him, the case will be considered to be closed; and, upon motion duly made before the Examiner at the expiration of the time assigned to the parties respectively, it may be set for hearing at any time not less than ten days thereafter.

§ 648. **Hearings.** — All interference cases pending before the Commissioner on appeal, or before the Examiner of Trade-marks, will stand for argument at one o'clock on the day of hearing, unless some other hour be specially designated. If either party then appear, he will be heard; but a contested case will not be taken up for oral argument after the day of hearing, except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new

assignment will be made, or the case will be continued from day to day until heard. Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel.[1]

§ 649. **Appeals.** — In cases of interference, appeals *pro formâ* may be taken to the Commissioner in person, and without the payment of an appeal-fee. The appeal must be accompanied by a brief statement of the reason therefor; and both parties will be required to file briefs of their argument at least five days before the hearing. Printed briefs are in all cases preferred, the practice of courts being followed in the citation of cases and making of points.

§ 650. It is not unusual in such appeals for the parties to file voluminous abstracts of testimony, sometimes running to the extent of thousands of pages. At least enough of the case should be shown to meet the exact points in controversy, and enable an intelligent understanding to be had of the facts. The more caution should be observed, as in this class of cases the decision of the Commissioner is final. In patent cases, a dissatisfied party may appeal to the Supreme Court of the District of Columbia sitting *in banc*, but an interference is expressly excepted by the law.[2]

§ 651. The remarks of the court in a certain patent case,[3] in regard to granting reissues, are also as applicable in matters of interference: "The Commissioner is supposed to have all the qualifications necessary to an intelligent decision of that question, and there are strong reasons why his action should be regarded as final. Such I understand to be the doctrine of the Supreme Court of the United States, as announced in numerous reported cases." [4]

§ 652. The practice in an interference case can best be ex-

[1] This is in substance the provisions of rule 49 in patent cases, and is now adapted to trade-mark interferences.

[2] Sec. 48, Patent-Law Act of July 8, 1870.

[3] Whitely *v.* Swain, 4 Fisher, 123.

[4] 4 How. 404; 15 id. 52; 17 id. 84; Law's Dig. 617.

plained by taking the record of an actual controversy as to the right to the exclusive use of a trade-mark. We will thus see not only the formal part of the proceedings which characterize such a matter, but will also have a curious exhibition of the contrarieties of the human mind, as shown in the ideas of counsel and the opinions of judicial officers. It will, in addition, furnish a commentary upon the "glorious uncertainty" of trade-mark law, when its settled principles are not rigidly adhered to. It is, besides, offered in evidence of the necessity which up to this time has existed, for some person who has made it a special study to write a treatise on the subject.

§ 653. We will take, for example, the case of *Louis L. Armistead* v. *William T. Blackwell*. The applicant stands in the position of plaintiff, as he attacks the title of Blackwell, who had previously registered as a trade-mark the words "DURHAM SMOKING TOBACCO." The Office having informed Armistead, through his solicitor, that another party claimed priority of title, both parties were required to file preliminary statements by a certain day.

§ 654. Armistead answered by a sworn statement of his version of the origin, &c., of the mark, partly from his own knowledge, and partly upon information and belief, deducing his title through one Wesley A. Wright, and taking it back to 1860. Blackwell also filed his statement, setting forth that, in 1865, one J. R. Green, from whom he claimed title, was engaged in manufacturing tobacco in North Carolina at the time of the approach of the armies of the United States under command of General W. T. Sherman, and the retrograde movements of the army of General Joseph E. Johnston, of the so-called Confederate States, and in the vicinity of the town of Durham. That when the armistice antecedent to the surrender of the army of General Johnston was promulgated, the two armies occupied positions adjacent to said town of Durham, and the town and vicinity became common ground to each army; that said Green sold large quantities of smoking-tobacco to the soldiers; and

from the fact of the circumstances of the surrender at that place, he believed that the name "DURHAM" would be popular. He said that the word "Durham" was first applied to smoking-tobacco in 1865.

§ 655. The preliminary statements conflicted as to the date of the adoption of the word "Durham" as a mark for tobacco, and as to the ownership of the right to its exclusive use. The controversy could not be determined without further action. The statements furnished insufficient data for final judgment. The preliminary interference was at an end.

§ 656. An interference proper was then declared, and due notice served upon the parties, by mail. The notice was in the form of an official letter from the Commissioner of Patents, informing the parties that their claims to the exclusive use of the mark were adjudged to interfere with each other, and that a hearing would be granted them upon a certain day; that the testimony of the applicant must be closed at a day fixed, and that of the respondent at a later day; and that, at a still later day, rebutting testimony, but no other, might be taken after the closing of the testimony-in-chief. Ample time was given by the Office, regard being had to the location of witnesses and parties.

§ 657. The next step in the litigation was the taking of testimony in behalf of the applicant, for he was obliged to prove his case before his adversary could be called on to respond. Due notice having been given, Armistead proceeded to take depositions, the respondent appearing by counsel and cross-examining. A similar course was then pursued by the other side; just as if the cause were pending in a Circuit Court of the United States. Then came the hearing, after which this decision: —

In the U. S. Patent Office.

LOUIS L. ARMISTEAD, OF VIRGINIA *v.* WILLIAM T. BLACKWELL, OF NORTH CAROLINA.

Interference — Trade-mark.

BROWNE, *Special Examiner:*

This matter was brought on for argument before me, the undersigned, on Monday, April 15, 1872, when it was elaborately argued by A. H. & R. K. Evans for the applicant, and by Cox & Cox for the respondent.

Voluminous testimony was filed and commented upon, it consisting principally of the record of a suit in the Circuit Court of the United States for the Western District of Virginia, between the same parties, and involving substantially the same main issue.

Before attempting to sift the testimony and apply the law, it is necessary to have a clear conception of the exact point in controversy.

Wherein consists the trade-mark in dispute?

There are two theories on this subject. The applicant insists that the essence is comprised in a single word, "Durham," used in conjunction with the words "Smoking Tobacco." By referring to the specification of applicant, filed December 6, 1871, we find that those are the words claimed by him. In the specification of the respondent, filed April 14, 1871, and registered October 3, 1871, we find that he describes his trade-mark as consisting of the words "Durham Smoking Tobacco, manufactured by W. T. Blackwell." The bill in equity in the suit above-mentioned, among other things, prays that the applicant be restrained from using any trade-mark containing the word "Durham."

What is the essential part of the mark?

It cannot be the words "Smoking Tobacco." for such names

in common use cannot be appropriated. The rule upon the subject of *generic* words, or words denoting quality, is so universally settled and acquiesced in, that authorities need not be cited in support thereof. Nor can the words "Manufactured by W. T. Blackwell," for such language is in the nature of a mere advertisement, and cannot, by any possibility, be deemed to constitute any part of the symbol known to commerce as a trade-mark. (See *Falkenburg* v. *Lucy*, in the Supreme Court of California, 35 Cal. 521; and also the *Leather Cloth Co.* v. *The American Leather Cloth Co.*, in the House of Lords, 11 Jur. (N.S.) 513.) Therefore the proposition that the applicant has simulated the trade-mark of the respondent by a *part*-imitation cannot be entertained. The whole, if any part, of the lawful mark has been pirated. If any word in Blackwell's registered mark possesses the essential attributes of the symbol known to commerce as a trade-mark, that word is "Durham."

But the respondent's counsel, in their first point, deny that by any possibility this word can be a trade-mark, and say it is liable to almost every objection that can be suggested. In support of this idea, they cite the recent case of *The Delaware and Hudson Canal Co.* v. *Clark*, in the Supreme Court of the United States. (Official Gazette, 1872, p. 279.)

Let us pause and consider the position of the respondent. "Durham" being the only word that can possibly be deemed essential in this case, how stands Blackwell if it cannot be supported as such? His objection is a two-edged sword. If one fails upon that point, so must the other.

What did the case cited by respondent's counsel decide? It simply reaffirmed the doctrine of the *Brooklyn White Lead Co.* v. *Masury* (25 Barb. 416). When two or more persons manufactured white lead in the city of Brooklyn, each had the right to describe his product as Brooklyn white lead. The exact point which turned that case against the defendant was this: he had fraudulently assumed the word "Company" or "Co." for the purpose of diverting the plaintiff's trade. It was purely

an instance of unfair competition in business. Careful analysis will demonstrate that it was not a trade-mark case, notwithstanding the fact that it is ofttimes referred to as such. In the case against Clark, above cited, known as the Lackawanna coal case, the court held that the name of a region of country cannot be appropriated to the exclusion of others who produce or who sell a similar article coming from the same region; therefore, as the complainants are not the sole owners of the coal-mining district of the Lackawanna, they have no exclusive right to the use of the words "Lackawanna Coal."

The same counsel also cited *Newman* v. *Alvord* (49 Barb. 588). In that case the court substantially concedes that the plaintiffs, by their prior appropriation of the name of the town of Akron, in connection with the words *cement* and *lime*, acquired no exclusive right to its use as against any one who could use it with equal truth. A careful examination of that case will disclose the fact that it was not strictly a case which involved a technical trade-mark; for to be a trade-mark, the right to its use must be *exclusive*. A laborious perusal of published authorities has failed to produce an instance of any court of any country admitting the possibility of the existence of a "neighborhood trade-mark." For our present purpose it is sufficient to refer to sec. 77 of the Act of Congress of July 8, 1870, in regard to trade-marks, which promises protection only to the person entitled to the *exclusive* use of any lawful trade-mark.

Therefore it is perfectly clear that if the word "Durham" is used for the purpose of indicating to the public that the merchandise to which it is affixed is manufactured or sold at a place called Durham, it is not what the law recognizes as a trade-mark; but it comes within the principle of *Falkenbury* v. *Lucy*, and the Leather Company case, above cited, and is a mere advertisement. Now comes an important question:

Did the applicant use the said word "Durham" as the name of a locality?

In an ordinary case of litigation, it would be sufficient to reply that the party making an objection is estopped by his admissions upon the record. If the objection were tenable, then this interference should be dissolved, for neither party would have any standing before this tribunal. But it is necessary to proceed further, for this reason: By section 79 of the Trade-mark Act of 1870, the Commissioner of Patents is prohibited from recording any proposed trade-mark which is not and cannot become a *lawful* trade-mark. This section confers judicial functions, at least to the extent of inquiring into the legality of every proposed trade-mark offered for registration, *ex parte* or otherwise.

This matter cannot be decided upon any thing in the nature of pleadings, or upon concessions. Consent cannot give jurisdiction. The applicant must not only have as good a right as any one else, but his right must be perfect. He must succeed, if at all, by his own strength, and not by the weakness of his adversary. If the Office erred in granting registration to Blackwell, that is no reason why it should repeat the error for the purpose of placing the parties upon the same footing before the courts, as one of the counsel suggested. Even if the Office should refuse registration, the rejected party might still fall back upon the common law, as a party litigant. This brings us back to the consideration of the question as to the meaning of the word "Durham," as used.

If the word is used in its geographical sense, it means but one place, a village in North Carolina. That is expressly conceded by both parties, and is warranted by the evidence. It was at a place bearing that name, or one nearly like it, that the applicant or his assignor commenced business as a manufacturer of smoking-tobacco, so long ago as 1859 or 1860. It is there that the respondent alleges that he now carries on the same kind of business. It is there that a number of witnesses reside and manufacture tobacco. We have not the slightest suggestion that any other place named "Durham" is meant.

It is true that several towns in the United States have that name; but they are excluded from consideration in this case, as the name means a place in North Carolina, if any thing.

Is there such a place as *Durham* in North Carolina? We would be left in some doubt upon this point if we depended entirely upon the language of the witnesses. Some of them speak of "Durham;" some of "Durham's;" some of "Durhams," and some of "Durham's Station." Which is correct? We turn to the official list of post-offices, and find that it is spelled *Durham's;* the apostrophe probably signifying, elliptically, Durham's Station. We finally hesitate to take judicial notice of the fact, and ask for the official certificate of the Acting First Assistant Postmaster-General, on file as an exhibit in this case. This is dated March 25, 1872. It says: "On examining the records of the Department it is ascertained that there is a post-office in Orange county, North Carolina, by the name of *Durham's*, and that Presly J. Mangum is the present postmaster," &c. That settles the question. The name is "Durham's."

The word "Durham," as used by both parties, is not so used to indicate any locality. We may reasonably so infer. The Office has virtually so ruled in granting registration to Blackwell. The evidence on file abundantly proves it. On the part of Blackwell and his predecessors, a representation of a Durham-bull was, and still is, used in connection with the word "Durham." What is it used for? The evidence overwhelmingly shows, that it is used to indicate to the public that the tobacco having that name had a peculiar excellence. That indication may be true, or it may not. The purchaser asks for the "Durham" brand, because it is his choice. Witnesses swear that it has a *peculiar* flavor, and say that ever since 1860 it has been known and used as a superior kind of manufacture. It would be idle to doubt that the article has agreeable properties, from the manner in which the tobacco is flavored with certain aromatic herbs, or other ingredients.

It is not pretended by any one that the tobacco is raised at Durham's Station; or that, if it were, that the soil of that locality possesses any peculiar properties to make tobacco grown thereon better than any other. The witnesses swear that it is the peculiar flavoring imparted by the tonqua-bean and other ingredients. What ground is there for rational doubt? The article manufactured in a particular manner is the thing meant.

If that were not so, then all the tobacco-manufacturers at Durham's had a right to use the same name. But Blackwell could not have so meant when he commenced to use the word "Durham;" for in his *sworn* statement, filed April 14, 1871, in applying for registration, he positively sets forth "that no other person, firm, or corporation has a right to use said trade-mark, or any one substantially the same, or one wherein or whereon the word 'Durham' is used in connection with the words 'smoking-tobacco,' upon any tobacco or package containing the same." This is irrefragable evidence to show that he did not then consider the word "Durham" as the mere name of a place; for at Durham's Station, at that very time, there were a number of other independent manufacturers, all equally entitled to use the name of their village as a geographical designation.

This does not concede, as law, that a geographical name cannot be the subject-matter of a trade-mark. It generally cannot be, for the reason given in the Lackawanna case. Mr. Justice Strong, in delivering the opinion of the court in that case, said: "Could such phrases as 'Pennsylvania wheat,' 'Kentucky hemp,' 'Virginia tobacco,' or 'Sea-Island cotton,' be protected as trade-marks?" All have an equal right to use those names when they truthfully indicate the goods to which they are applied. But this rule has some exceptions. A word which in one sense may be coincident with the proper designation of a region of country or a town, may be put to another office. The leading authority on this point is the celebrated

"Anatolia" case, *McAndrew* v. *Bassett* (10 Jur. (N.S.) 550). The Lord Chancellor therein said: "I am told that this word 'Anatolia,' being a general expression, — being in point of fact the geographical designation of a whole country, — is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist, but property in that word as applied by way of stamp upon the liquorice does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances that render the article so stamped acceptable to the public." *The Congress and Empire Spring Co.* v. *The High Rock Congress Spring Co.* (57 Barb. 525, and 4 Am. Law Times R. (St.) 168) affirm the same doctrine, "Congress Spring" being there held, under its peculiar circumstances, to be a perfectly good trade-mark.

In France the same ruling has been made in the Tribunal Civil of the Seine (*Faivre* v. *Duguaire*, Annales de la Propriété, etc., tome viii. p. 238), where it was held that the words "Mount Carmel," although a geographical name, was, as a fancy designation, a good trade-mark. These rulings are all consistent with reason, and harmonious with the current of decisions.

We now come to the question of priority of adoption.

The testimony in the two hundred and twenty-nine pages of the record has been sifted.

Blackwell's witnesses furnish a considerable amount of negative testimony as to the time of the first use of the word by any one as a trade-mark. They do not go further back than the year 1865, when the predecessor of Blackwell commenced to use it. If uncontradicted, their statements would be convincing, notwithstanding the fact which some of them disclose

that they are also manufacturers of smoking-tobacco, and are interested in defeating Armistead. But the applicant brings forward a large number of witnesses, whose statements overwhelmingly establish the fact, beyond doubt, that the word was used some years before 1865. Wright, the predecessor of Armistead, swears that he used the word in 1860, and continued to use it after he had removed his factory from Durham's, and until he entered the army (Rec., pp. 236, 237). If faith should be placed in the oaths of apparently entirely credible witnesses, then, beyond the shadow of a doubt, the word was used in 1860, and ever since, to designate a *peculiar* kind of tobacco.

What tobacco was that? It was a peculiarly-flavored smoking-tobacco, which acquired its reputation so far back as 1860. It was the smoking-tobacco that Wright made; substantially that for which he subsequently obtained letters-patent. This is not a mere inferential conclusion. It is fully corroborated by the evidence.

The applicant, Armistead, deduces any title he may have to the trade-mark from Wesley A. Wright, who at one time certainly did possess a certain trade-mark. That trade-mark was affixed to a certain label containing a number of other words, as "Morris & Wright's Best Spanish Flavored Durham Smoking Tobacco," or whatever the words may be. The counsel for Blackwell argues that Armistead must take the whole brand used by his predecessor or assignor, and that he cannot change or vary it in the least.

That would be true if the whole brand or label were a trade-mark, but the brand or label was but the vehicle of the mark of commerce, that symbol which becomes associated with a particular article of merchandise. We have seen that the only essential element of the trade-mark is the word "Durham." When an exclusive title to that was once acquired, its owner might use it as an isolated emblem, or he might combine it as he pleased. The courts of all nations concur in this doctrine.

It has also been suggested by the counsel that the word "Durham" is insufficient as a mark, because it does not indicate origin or ownership. That question is definitively set at rest by the decision of the New York Court of Appeals in *Burnett* v. *Phalon* (3 Keyes, 594), which held that the single word "Cocoaine" possessed all the essential elements of a common-law trade-mark.

CONCLUSION.

As facts I find —

First. That the firm of Wesley A. Wright, the assignor to Louis L. Armistead, the applicant, was the first to adopt and use a trade-mark, the essential element of which was the word "Durham," for smoking-tobacco.

Second. That the word "Durham" was not originally adopted as the distinctive name of a locality, or to denote that the tobacco to which it was affixed by him was manufactured or sold at any place named Durham; but that it was purely a fancy designation, adopted as an arbitrary symbol to denote his peculiar product.

Third. That the said symbol has by long use become associated with the particular manufacture of smoking-tobacco described in Wright's *patent*.

Fourth. That the said symbol was never abandoned or dedicated to the public by said Wright.

Fifth. That whatever property said Wright had in the said word "Durham" was transferred by him to said Armistead.

As a conclusion of law, I find that the said Wright had a legal title to the said word "Durham" as a trade-mark for smoking-tobacco, and that the applicant acquired title from him.

Priority is therefore awarded to the said Louis L. Armistead, and his claim of right to registration of said trade-mark is admitted.

§ 658. The foregoing opinion having been filed and entered of record, the Office notified the parties of the result, and

allowed thirty days for appeal, as is usual (although where circumstances render it expedient the period may be lengthened or shortened). The only appeal was, of course, to the Commissioner in person, and not to the Board of Appeal (the Examiners-in-chief), as in patent cases, for section 10 of the Act of July 8, 1870, does not apply to trade-mark cases.

§ 659. This appeal to the Commissioner is in the nature of a rehearing, for there is no statutory provision in regard to a revision of the decision of the Examiner of Trade-marks; his decision being in theory the act of the Commissioner. This explanation is useful as general information, and also to account for one circumstance at the hearing of the appeal, to wit, the introduction of new evidence, not presented to nor considered by the Examiner, as to the geographical import of the word "Durham."[1] The two decisions are thus reconciled, as to the question of fact. The law of the case is concurred in. We will now read the opinion of —

LEGGETT, *Commissioner:*

Blackwell obtained, October 3, 1871, the registry of the following as a trade-mark: "Durham Smoking Tobacco, manufactured by W. T. Blackwell, Durham, North Carolina."

[1] "AN ACT to incorporate the Town of Durham, in the County of Orange.

"*Be it enacted by the General Assembly of the State of North Carolina, and it is hereby enacted by the authority of the same,* That the town of Durham, in the county of Orange, be, and the same is hereby, incorporated by the name and style of the town of Durham, and shall be subject to all the provisions contained in the 111th chapter of the revised code.

"*Be it further enacted,* That the corporate limits of said town shall extend one half-mile in all directions from the warehouse of the North Carolina railroad in said town.

"*Be it further enacted,* That this act shall be in force from and after its ratification.

"In General Assembly read three times, and ratified this 22d day of December, A.D. 1866.

"R. Y. MCADEN, *Speaker House of Com.*

"M. C. MANLY, *Speaker of Senate.*"

The *date* of this act should be noted by the reader, as it has a bearing on the question of Durham being a geographical term or not.

December 6, 1871, Armistead applied for the registry of the following as a trade-mark: "Durham Smoking Tobacco;" and as he claimed the exclusive right to the use of these words, his application was placed in interference with the registered trade-mark of Blackwell for the purpose of determining who first adopted and used on packages of smoking-tobacco the words "Durham Smoking Tobacco."

Blackwell manufactures his tobacco at Durham, North Carolina; Armistead, at Lynchburg, Virginia. Armistead claims the right to use the label-mark under an assignment from one Wesley A. Wright, who formerly manufactured smoking-tobacco at Durham, North Carolina. The evidence shows that Wright invented a flavoring-compound for smoking-tobacco as early as 1860, for which he has since obtained a patent, and in company with one T. B. Morris, under the firm-name of Morris & Wright, manufactured smoking-tobacco at Durham, and that the tobacco obtained some reputation under the name "Best Spanish Flavored Durham Smoking Tobacco." It is by no means clear, however, whether this name was first given use by the manufacturers, or by the merchants who retailed it, or by the consumers who bought and used it. This tobacco, on account of its flavor, has become a favorite, and the distinctive words in the name adopted must have been "Best Spanish Flavored," and not "Durham." In 1861 Morris & Wright seem to have dissolved partnership, and Wright moved about two miles from Durham, where he continued to manufacture smoking-tobacco for a few months, and then gave up his business and went into the rebel army. There is no pretence that he resumed this business before 1869, when he again commenced the manufacture of smoking-tobacco at Liberty, Virginia, using the following brand: "Original Durham, W. A. Wright, Originator," the label also embracing the representation of a bull's head looking to the left. In 1870, said Wright, in company with J. R. Stewart, manufactured smoking-tobacco at Stewartville, Virginia, and branded it "Durham

Smoking Tobacco." After this he assigned the right to manufacture under his patent, and also the right to use the brand "Durham Smoking Tobacco," to Armistead, the applicant. If Wright had an exclusive right to this brand, then Armistead is entitled to have it registered; otherwise, not.

Armistead attempts to fix the origin of this label back as far as 1860, when it was used in connection with the words "Best Spanish Flavored;" but in doing so he shows that it was first used by Morris & Wright, and by proving this he proves that Wright did not have the exclusive title to the label. If this is the origin of the mark claimed, then, to make Armistead's title to the same good, he should be able to show that he holds under Morris as well as under Wright. Wright could not convey to Armistead the exclusive right to use what belonged to Morris & Wright.[1] But there is nothing of record to show that Armistead holds or claims to hold any thing, directly or indirectly, from Morris. An exclusive right to use is necessary, under the statute, to secure registration.

Wright used the word "Durham" upon a small portion of the smoking-tobacco he manufactured during the year 1861 near Durham, North Carolina. This is the utmost that can be claimed, from the testimony, as to any use of the word by him alone before 1869. That such use of the name of a town where he did business should give him the right to carry such name into another State, and to use it to the exclusion of all other people in the United States, even the citizens of the town of Durham, is too preposterous to require more than a simple statement for its refutation.[2]

Blackwell claims under an assignment from one J. R. Green, and proves that Green first used the word "Durham" upon smoking-tobacco in 1865. That Wright used this word to mark packages of smoking-tobacco before Green did the tes-

[1] As partnership assets in hands of the survivor?

[2] If it was, as he claims, an arbitrary symbol, and not the mere designation of a place, why could he not use it exclusively all the world over?

timony does not leave a shadow of doubt; and if the case was a proper one for a judgment of priority I should unhesitatingly give it to Armistead as assignee of Wright. But it is not such a case. The words "Durham Smoking Tobacco" cannot constitute a legal trade-mark, and therefore cannot be registered. Neither would adding the name and place of business of the manufacturer help the matter. There is nothing registerable in either Blackwell's or Armistead's labels, and the Office blundered when it gave a certificate of registration to Blackwell. It should not repeat that blunder by giving a like certificate to Armistead.

The Examiner, it seems, refused to register for Blackwell the words "Durham Smoking Tobacco;" but, when the words "Manufactured by W. T. Blackwell, Durham, N. C.," were added by amendment, registry was admitted. There is nothing in this label except the name "W. T. Blackwell" to which Blackwell had any exclusive right, and this name cannot be regarded as any part of the trade-mark. The parties have evidently been misled as to their rights by misreading some court decisions. Courts of equity have often granted injunctions against the fraudulent use of words which the same courts would not for a moment sustain as trade-marks. An example of this is found in what is known as "the Akron Cement Case," or *Newman* v. *Alvord* (Cox, 417). Newman lived at Akron, and manufactured from the quarries of that neighborhood water-cement, which he put up in barrels and labelled "Akron Water Lime," and added his own name as manufacturer. Many of his neighbors were engaged in the same business, all using the words "Akron Water Lime," or "Akron Cement," but each attaching his own name. This lime, under the brand "Akron Cement," became popular, and one Alvord, living and doing business in Cleveland, commenced branding his water-lime "Akron Cement," adding his name and proper place of manufacture. Newman, one of the manufacturers at Akron, applied for and obtained an injunction enjoining Alvord against

using the word "Akron" as any portion of his label. The court granted the injunction solely on the ground that Alvord used the word "Akron" for the purpose of making the public believe that it was the genuine Akron cement, and thereby obtaining by fraud trade that rightfully belonged to Newman and others in Akron. The learned judge was very careful to say, however, that Newman had no *exclusive* right to the use of the words "Akron Cement," but that the same might be used by any citizen of Akron, thereby holding that while "Akron Cement" was not a legal trade-mark, yet it was within the province of a court of equity to grant an injunction against its fraudulent use.

The same doctrine was held in the case of *The Brooklyn White Lead Co.* v. *Masury*. In this case Masury adopted as a label for his paint "Brooklyn White Lead and Zinc Company." As both did their manufacturing in Brooklyn, the court held that the respondent had a right to use the words "Brooklyn White Lead;" but as the word "Company" was added for the purposes of fraud, a decree was entered enjoining Masury from using the word "Company." No one, however, would hold from this that the word "Company," as attached to a firm or corporation name, could be regarded as a trade-mark. The court enjoined against *fraud*, but with no intention of defining a trade-mark. Many other cases to the same effect might be referred to, but these are enough.

The words "Durham Smoking Tobacco" may be used with impunity by any persons engaged in manufacturing smoking-tobacco at Durham, and for that reason no one person has any exclusive right to their use. By the statute an exclusive right to use the proposed trade-mark must be established before registry can be allowed.

By application of the doctrine held in the "Akron Cement" case any person living at Durham, and engaged in manufacturing smoking-tobacco, might enjoin any person not living there who should fraudulently use the word "Durham" on tobacco-

labels for the purpose of obtaining trade that otherwise would go to Durham. This may be true, and yet the words "Durham Smoking Tobacco" not be a legal trade-mark. These parties have already had adjudicated between them a question involving nearly all of the points here discussed. In the case of *Blackwell* v. *Armistead*, lately decided in the United States District Court for the Western District of Virginia, Justice Rives very fully and ably discusses this whole matter on substantially the same testimony submitted in this case. The trade-marks, as discussed by him, differed from the marks under consideration here in this: One of them had, in addition to the words "Durham Smoking Tobacco," the representation of a bull's head, and the other of the full-size view of a bull. So far as the questions are the same, I believe the holdings in this are substantially the same as held by the learned judge in that case.[1]

As neither party is entitled to registration, the interference must be dissolved, and registration refused to Armistead. If I had power to cancel the certificate granted to Blackwell, I should certainly do so.

§ 660. Let us now peruse the opinion of his Honor, Judge Rives, who based his opinion upon the identical testimony which was transcribed from the records of his court for the use of the Special Examiner in the Patent Office. The decision will stand upon its own merits, so that the annotations cannot add to nor detract from its wisdom. With the most profound deference for the learning of the Judge, it is with hesitation that any errors of judgment shall be pointed out, — errors as to the law; for with facts we need not trouble our heads. The whole case is a study, from beginning to end, and simply as a study is it so fully set forth.

[1] That is, as to the question of fact of "Durham" being a mere name of a place.

U. S. Circuit Court for the Western District of Virginia, March Term, 1872,

W. T. BLACKWELL, AND J. S. CARR, PARTNERS UNDER THE STYLE OF WM. T. BLACKWELL,
v.
L. L. ARMISTEAD. } In Chancery.

Bill to enjoin Violation of Trade-mark.

OPINION.

RIVES, J. — The preliminary injunction in this case was founded on the statements of the bill. In pursuance of the notice required by statute, the defendant appeared and contested its emanation upon *ex parte* affidavits assailing the title of the plaintiffs. But in that incipient state of the proceedings it would not have been proper, if at all practicable, to pass upon the merits of this defence; and the only question then was, whether the case, as presented by the bill and affected by this adverse testimony, was still such as to require this *stay* till the merits of the controversy could be developed by further pleading and testimony. The propriety of this interposition by the court will scarcely be now questioned, as these further proceedings have shown the case to be one of perplexity and doubt.

The pleadings have now been perfected. The defendant's answer was duly filed, issue taken upon it, and the cause set down for final hearing. A vast volume of testimony has also been taken, some of it contradictory, and a vast deal of it irrelevant and impertinent. It is to be regretted that the zeal of counsel or the anxiety of parties should have so augmented the bulk of this testimony as to make a needlessly expensive record of it, and to devolve upon all engaged in its examination a wearisome amount of unprofitable reading. Still it is a subject of congratulation that the cause is now fully developed in all its aspects and bearings, and has been argued with a dis-

crim nating force and fulness of research alike masterly and instructive, and calculated to produce settled convictions one way or the other.

Our first task is to acquire accurate and precise ideas of the issues made by the pleadings. If this be done, and then the law be properly applied, it seems to me we can reach a safe conclusion almost without resorting to the voluminous testimony. The plaintiffs [1] claim a trade-mark, designed in 1865 or 1866, and continuously used ever since. It is *exemplified* and made a part of their bill. The descriptive terms are, "Genuine Durham Smoking Tobacco," and the symbol or device is the side view of a *Durham* bull.[2] They assert that this trade-mark has been violated by the defendant in using, under date of January, 1871, this term: "The Durham Smoking Tobacco," and the symbol or device of "a bull's head," [3] with a note of the sale to the defendant of Wright's patent for the manufacture of "Genuine *Durham* Smoking Tobacco." This latter trade-mark of the defendant is also *exemplified* in the bill and placed in juxtaposition and contrast with plaintiffs' trade-mark.[4]

The answer, while calling for full proof of the allegations of the bill, does not directly deny this statement, but rests the defence upon three chief grounds: 1. The prior use of this trade-mark by Wright (under whom the defendant claims), as far back as 1860; 2. That the defendant's trade-mark is not an infringement of the plaintiffs', but is wholly dissimilar; and, 3. That the plaintiffs, by fraudulent representations in the premises, have deprived themselves of all equitable assistance.

[1] This being an equity suit, the term "complainant" should be used. A *lapsus calami*.

[2] This symbol is really the trade-mark. "The descriptive terms" cannot possibly be a mark of commerce. By what magic process is the animal represented shown to be a "Durham bull!" One witness swears that it is a cow.

[3] Is it possible as a matter of fact that a *bull's head* could be mistaken for the side-view of the animal! If not, how could there be infringement?

[4] This recognizes the existence of two distinct marks. If there is piracy, it thence follows that there is but *one* mark.

The main contest is considered by all parties and the counsel in this case to rest upon the *priority* in the use of this disputed trade-mark. The defendant does not pretend that Wright, under whom he claims, ever used the identical trade-mark set up by the plaintiffs. On the contrary, he takes especial pains to show that he placed no particular value on the term "*Durham*," *which he now asserts belonged in common to his and plaintiffs' brands.* The discovery which he had made, and for which he seeks protection, was his preparation for or mode of treating smoking-tobacco, so as to mitigate its noxious qualities and impart to it an agreeable flavor. This is the merit he claims; this the process he has patented. The testimony and the answer concur in proving that the whole merit of this smoking-tobacco, and its celebrity, were due to the use of the *flavoring* he gave his tobacco. He was confessedly the first to commence its manufacture at Durham's Station.[1] There was nothing in the locality he could have reasonably counted upon to commend his manufacture to the public.[2] But, if we are to accredit the defendant's answer and his testimony in this cause, it was his discovery of the flavoring compound on which he plumed himself. Accordingly it was this which he emblazoned on his stencil-plate. Take his own statement for the present, and what was his brand? "*Best Spanish Flavored* Durham Smoking Tobacco." What, in view of the pleadings and evidence in this cause, is the characteristic — the vital element — of this trade-mark?[3] Manifestly, "*Best Spanish Flavored.*" That was the only con-

[1] Observe, that the name of the place was "Durham's Station." It did not become "Durham" until the tobacco business had built it up, about six years thereafter.

[2] That is the very reason why it was a trade-mark. If the locality had power to draw public favor, then the name could not be a fancy designation.

[3] This is an instance of the inadvertent use of the term "trade-mark." The words "Best Spanish Flavored" cannot by any possibility constitute essential elements of what the law recognizes as a trade-mark. This is the test: Could any manufacturer acquire the *exclusive* right to use words so common to our language? No!

spicuous and discriminating element of this trade-mark. "Durham," if indeed a part of it, was, upon the defendant's own showing, subordinate and insignificant. Now, the plaintiffs concede in the fullest manner Wright's superior title to the use and brand of his flavoring compound, and disclaim in their process any infringement of it: nor does it appear there has been any, nor indeed any formal complaint of it.[1]

The pretension of the defendant, then, amounts to this: that because, in 1860, he branded his smoking-tobacco "*Best Spanish Flavored Durham*," wholly because of the mode in which he flavored it, no subsequent manufacturer of the article at Durham, without the use of his process, shall brand his as "*Genuine Durham Smoking Tobacco*" with a symbol which he never used. My reply is that, under the circumstances of his use of the name "Durham," there was nothing in it so descriptive as to restrain succeeding manufacturers at the same place from engrafting it on their brand, so long as they laid no claim to nor made any use of his "*Best Flavored Spanish*" compound, which he indeed appropriated by this first and original use of this only conspicuous term on his stencil-plate in 1860–61.[2] It must be remembered that Wright was only in the infancy of this manufacture at Durham; and that others followed and developed it till the plaintiffs instituted their brand in 1865 and 1866.[3]

[1] Compare this case with that of the Carthusian monks, § 582, where it was held that *Chartreuse* had become a symbol to denote their particular manufacture, possessing all the essential characteristics of a trade-mark.

[2] This is conceding that words in ordinary use in our language — as is this purely-descriptive phrase — may be appropriated by the first person who makes the combination. All the authorities are quite the other way.

[3] Let us suppose that — as was the fact in this suit — the coiner of a new word or symbol, as "Cocoaine" (which we will borrow for the sake of illustration), were to establish a manufactory, around which a large village sprung up, the village of Cocoaine, would he cease to be the owner of the symbol as his trade-mark? Would the name become a *mere* geographical designation which all might use? Certainly not. If the owner of the mark removed to another State, could it be pretended that all who had settled at Cocoaine could use the name, as the denomination of the originator's class of goods? And if the word "Durham" was merely a geographical term, why was it necessary to adopt the representation of

Conceding, then, all the defendant claims by virtue of his purchase from Wright, he fails, in my opinion, to rebut the plaintiffs' title by proving a brand as used by Wright previously, wherein "*Best Flavored Spanish*" was the distinguishing attribute, and "Durham," under the circumstances at that time, a mere unmeaning *incident*.[1] Thus stands this point in the light of the pleadings alone, the allegations of the plaintiffs on the one hand, and the denials and defences of the defendant on the other.

The testimony as to the fact whether the term "*Durham*" was ever upon the stencil-plate of Morris & Wright is contradictory. But in my mind it preponderates against the existence of that name in that brand. Counsel have adroitly insisted that the testimony against it is *negative*, and cannot from its nature, however commanding, overcome clear *affirmative* proofs. The proposition of law involved in the statement is correct; but the whole inquiry is into a fact, namely, What was the stencil used by Morris & Wright? Some, on the one hand, who had used it, declare with emphasis it was "Morris & Wright's *Best Spanish Flavored Smoking Tobacco*;" others, but mainly Wright and his two sons — the latter at the time but boys — stated it as "*Morris & Wright's Best Spanish Flavored* DURHAM *Smoking Tobacco*." The proofs, therefore, on both sides, are equally *affirmative*. If, then, it be left in doubt, we must look to the probabilities of the case to turn the scales. What motive could have existed with Wright, all whose reliance was upon the merits of his flavoring compound, to invoke the name of a small, thriftless station on a railroad, settled by only two or three families, with a store and this factory, — to invoke its name to give celebrity to the *preparation* to which he solely

a side-view of a bull! If it is geographical, so then must be its great original the ox and "Durham" on the label for mustard. (See case of *Harrison* v. *Taylor*, 11 Jur. (N.S.) 408.)

[1] Because it *was* a mere unmeaning incident, a mere arbitrary symbol, having no reference to the place of manufacture, it could be a valid trade-mark.

looked for his reward ?[1] It seems to me extremely improbable, upon ordinary grounds of reason and human action, to suppose that he used "*Durham*" on his stencil at all. On comparing and weighing the testimony on both sides, I am constrained to adopt the conclusion that he did not. Neither he nor his vendee, therefore, have any claim to contest, under this state of the evidence, the validity of the plaintiffs' trade-mark and his original and paramount title thereto.

It cannot be denied that it is abundantly proven in this cause, that the manufacture of Morris & Wright, and of those who succeeded them at Durham, was known, called, and distinguished in the market as "*Durham*" smoking-tobacco. It is on this notorious fact in the cause that the able and ingenious argument has been raised that the public, by its voice, may appropriate and consecrate to an individual property in a designation by which he may choose to denote any product of his industry. But I can find no warrant for such proposition in the law on this subject. On the contrary, it is distinctly laid down by the authorities, that it is only *the actual use* of the mark, device, or symbol by the dealer which entitles him to it, and gives him the right to be protected in the enjoyment of it.[2]

The doctrine on this subject has grown with commerce, and has assumed the form and title of a distinct body of law under the moulding hand of able judges, who have sought in their decisions to establish its guiding principles, and of acute commentators and essayists, who have exerted the powers of a superior analysis and discrimination to extricate from doubt the true maxims of this beneficent code of business ethics.

So much of it as is necessary or material for our present inquiry is comprehended in a single proposition. It is the *semi-*

[1] A manufacturer relies upon the reputation of his product. The trade-mark is the index that points to it. It was the patented article, the peculiarly-flavored compound, that was the object of value. The public cared not a rush where it was made.

[2] It was known and distinguished by the name of "Durham." Then the name must have been attached to it.

nal principle of the whole doctrine. The simple statement of it is, that the dealer has *property* in his trade-mark. This is allowed him because of the right which every man has to the rewards of his industry and the fruits of his discovery, and because of the wrong of permitting one man to use as his own that which belongs to another. In regard to the latter, it may be well said, that any imitation of a trade-mark, calculated to deceive the unwary customer, differs from an absolute forgery, not in the nature, but rather in the extent of the injury. The dissimilarity to the expert wholesale dealer may be such as to save him from the imposition, but too slight, and that perhaps by design, to diminish sales to the incautious purchaser. But upon the success of fraud depends, ultimately, the extent of the injury. Let the spurious fabrication meet with the same sale, among private and individual consumers, as the genuine article, and the wholesale dealer loses all motive for the exercise of his skill in detection when he, perhaps, can reap better profits from the spurious, and therefore cheaper, than from the genuine article. In this way a simulated trade-mark may work the same mischief, and to the same extent, as a forgery, defying detection at the hands of the *expert*.

With this brief view of the law, I proceed to examine the *second* ground of defence: that the defendant has not infringed the trade-mark of the plaintiffs. This is scarcely the subject of argument. It must be referred to ocular examination and decision. Place the respective trade-marks side by side, contrast the labels, the words, and the devices, and each one's vision must determine for himself whether the imitation is such as to deceive the unpractised and unwary customer. It matters not that now, in the critical inspection of them, and aided by ingenious counsel, we can clearly discern differences between the two. The true question is, whether, taking the "*tout ensemble*," Armistead's trade-mark might not pass with the unwary for that of Wm. L. Blackwell & Co.; and, if that be so, the wrong is done, and the title of the latter to be protected by

this court is consummated. For my part I do not see how trade-marks so similar could escape being confounded in the market. One reads, "*Genuine Durham Smoking Tobacco*;" the other, "*The Durham Smoking Tobacco.*" This use of the definite article makes these phrases equivalent. To remove all doubt, and aid the deception, in the note of sale of the patent to Armistead, it reads, for "*Genuine Durham Smoking Tobacco.*"[1] Thus the language, to this extent, of the labels is identical. Now, as to the symbols or devices, one is the side view of the Durham bull; the other, that of his head, on a medallion. The one symbolizes, by a part, the name "*Durham*" as effectually as the other does by the whole. The color of the paper is also the same. Whether this *simulation* be the product of accident or design does not matter.[2] It is the province of this court to suppress it in either case. It is a little curious, however, to note that Wright's first label, at Liberty or in Bedford, was wholly different, and that, after his son had seen plaintiffs' trade-mark in Kentucky, and after his return to his father, the present trade-mark, as transferred to the defendant, was adopted by Wright.

The third and last ground of defence is that the plaintiffs have forfeited their right to relief in this court by reason of their false and fraudulent pretensions. This is upon the ancient and familiar principle that those who do iniquity must not ask nor expect equity. It is worthy of all acceptation. It is a hoary maxim, hallowed by its age, and, unlike some other equally sacred antiquities, it is as yet unassailed by the spirit of change or reckless progress. I adhere to it. But the charges are serious and demand investigation.

[1] The judge having already ruled out the word "Durham" as "subordinate and insignificant," we may discard it. The so-styled trade-mark, then, consists of "The Smoking Tobacco;" and the alleged piracy reads, "Genuine Smoking Tobacco." This is not an error, for the recorded opinion shows it.

[2] Read this again. The representation of the *side-view* of a bovine quadruped is the simulation of another representation of the mere head of a bull! Could one possibly be mistaken for the other? If not, the coexistence of the two pictures could not amount to infringement. This being a question of fact, we will let it go. We are in pursuit of law.

The first is, that the plaintiffs sent out business-envelopes and business-cards, giving the year 1860 as the date of the establishment of their enterprise. In the absence of explanation, this might well impugn the *bona fides* of the plaintiffs, as in their bill they fix it no earlier than 1865. But was this statement by mistake or design? Have the plaintiffs failed to account for it? A junior member of the firm was examined, and showed how it all occurred *innocently*, and without intent to deceive. He ordered the printing and gave the date; soon after the packages were received and opened in the presence of Dr. Blackwell, the latter saw the error of date and corrected it; and the witness stated that he proceeded to correct the misdate by writing the figure (5) over the cipher in 1860, so as to make the date 1865, as corrected by Dr. Blackwell, but that some might have gone out before the correction. The exhibits made by the defendant of these envelopes and cards corroborate, rather than conflict with, the witness. *That* should not be taken for *fraud* which is proved by an unimpeached witness to have been a *mistake* on his part. Besides, there was no reasonable motive for such misrepresentation; the plaintiffs had nothing to gain by it, but much to lose, on the hypothesis of the counsel for the defendant.

The next is a charge of falsehood in representing that the label was secured by copyright. There is not a particle of proof to that effect. Argument and ridicule alone are relied on to show the inapplicability and absurdity of a copyright for such a print. The language of the statute is certainly comprehensive enough to embrace a label of this kind.[1] (Act of July 8, 1870, § 86, U. S. Stats. at Large, vol. xvi. p. 212). The object of such copyright is to secure to "the author, inventor, or designer" of any such "*print*" the sole liberty of printing

[1] This is a misconception of the extent and office of the copyright law. It was never intended to permit a mere label to be copyrighted. See reasonings upon this point in previous sections. The Librarian of Congress has felt himself obliged to issue a circular, to warn applicants for copyrights against this error, and to inform them that trade-marks are not subjects of copyright.

and vending the same. It forbids the surreptitious use and the illegal sale of his labels. This is a perfectly legitimate resort to copyright in such a case and for such a purpose. It would, indeed, be absurd and ridiculous if the object were, as sarcastically portrayed by counsel, to protect the designer against the unlawful multiplication of such *ycleped* works of art. The dealer seeks merely by his copyright to keep the printing and vending of his labels in his own hands and under his control. It has been resorted to in other cases, as for instance in the case of Wolfe *v.* Goulard (Cox's Am. Trade-mark Cases, p. 227), for the label of "*Schiedam Schnapps.*"[1] There is nothing unreasonable or incredible in this claim of the plaintiffs to a *copyright* for their label; nor is there any thing in the testimony or the law to lead us to discredit it and brand it as a falsehood.

It seems to me, therefore, that both these charges are unfounded. They spring from the heat of forensic contests. They pertain to the polemics of the bar. Their effect is to provoke recrimination. Hence, the plaintiffs' counsel retaliate by imputing *falsehood* to the defendant in dating his purchase of Wright 1st of January, when he had stated in his answer he would not buy till he had ascertained his title by certificates; and those very certificates bore the subsequent date of the 6th of that month. The imputation seems plausible; but the transaction is susceptible of a more charitable construction, which I deem it my duty to put upon it. Dates are commonly immaterial, and often misapplied in business transactions. The main fact is doubtless correctly stated by the defendant, though he is made himself to confront it by a *mistaken* date.

I am glad, therefore, to have it in my power to state that there is nothing in this cause to affect the fair fame of the parties, plaintiff or defendant. They are, doubtless, respectable

[1] An unhappy citation. See the case as commented on, and the late case (*ubi supra*) decided by Pratt, J., involving the validity of Wolfe's miscalled trade-mark.

men, and enterprising manufacturers of tobacco in their respective communities. They are engaged, as I believe, in the honest pursuit of their rights as they respectively understand them. The defendant has acted on the information of another, under whom he claims. He has obeyed the order of this court. The only thing I have to regret is, that the same deference was not paid by another manufacturer, who, though no party to this suit, could not have been ignorant of it from his near relation to the defendant. But the plaintiffs have not chosen to bring him before this court, save by proving his acts in the use of the simulated mark, notwithstanding the injunction upon his brother.

I am sure the plaintiffs and the defendant, as enterprising dealers, will find their ultimate interests subserved by the doctrine I have sought to expound and maintain as to their trade-marks. Whoever may now be the loser by it may soon have occasion to invoke it for his own protection; and they, whose rights are now sustained, must learn thereby to respect those of other competitors in their business, at the same time that they take encouragement to themselves from their present success. All intelligent men, engaged in manufactures or other enterprises, must sooner or later become reconciled to losses, in whatever favored quarter they may fall, that may be fairly viewed as penalties for the infraction, however unintentional, of laws, well settled, designed, and calculated to vindicate the honor, advance the morals, and promote the interests of trade.

For these reasons I decree the perpetuation of the injunction, and order an account to be taken by a master, of the profits made by the defendant from his sales under the simulated trade-mark aforesaid.[1]

§ 661. The following decision will give another example of the treatment of a trade-mark interference, and also furnish

[1] This controversy ended in smoke. The parties came together, and spoiled the lawyers' hopes of a determination by the Supreme Court. Moral: much remains to be learned.

points of practice and law which may serve a useful purpose. Attention is particularly invited to the points of counsel, and the concession made by one side, which was sufficient in itself to warrant judgment for the other side without the necessity of recourse to the testimony.

In the U. S. Patent Office.

GEORGE SCHRAUDER, APPLICANT *v.* RICHARD BERESFORD & CO., RESPONDENTS.

Interference — Trade-mark.

BROWNE, *Special Examiner:*

The hearing was had on the 27th day of June, 1872. Knight, Brothers, for the applicant, and Fisher & Duncan, for the respondents. Schrauder's alleged trade-mark, as set out in his specification, consists simply of the word "BOUQUET," which word is printed upon suitable labels, and then applied to barrels, tierces, boxes, wrappers, or other packages or receptacles for containing cured meats. For the purpose of increasing the pictorial effect of the trade-mark, said word "BOUQUET" may be associated with a branch or wreath of flowers, or with other appropriate ornaments; but such flowers or ornaments are not to be considered as forming any part of the mark. — It is for cured meats.

Beresford & Co.'s alleged trade-mark is stated in their specification as consisting of a bouquet, which is thus described: "Two sprigs of leaves, having their stems at the bottom of the lithograph,[1] and fastened together by a ribbon, are bent around the bouquet, so that their ends nearly touch, and so as to form an oval. Within this oval is the bouquet, composed of various-colored flowers, ears of grain, and several varieties of leaves.

[1] The picture is not a *lithograph*, but is an impression from an engraving on type-metal. Accuracy upon all points is desirable.

"The bouquet is supported by an urn-shaped holder. Above the bouquet, and near the top of the oval, upon a colored background, are the words 'Richard Beresford & Co.:' just below this firm title are the words, 'Extra Sugar Cured:' while across the face of the bouquet is the word 'BOUQUET.' Beneath the word 'BOUQUET,' and across the middle of the bouquet-holder, is the word 'Hams.' Under the latter, and across the foot of the bouquet-holder, are the words 'Cincinnati, O.'

"The enclosing sprigs may be dispensed with; also the words above mentioned be changed; also the holder of the bouquet be dropped; also the coloring of the bouquet, &c., be varied, or dispensed with, without materially altering the character of our trade-mark, the essential feature of which is the bouquet."

This mark is for hams and breakfast-bacon.

It must be observed that the mark claimed in one case consists of *nothing* but the single word "*Bouquet*;" and in the other consists of the representation or picture of a bouquet.

The question that arises in this instance is *sui generis*. It is believed that the precise point here suggested has not been decided by any tribunal. The *name* of an object is brought into conflict with a *picture* of the object. The former addresses itself more particularly to the ear, the latter to the eye. Schrauder entirely dispenses with the pictorial illustration, and still retains a word which, as an arbitrary symbol, is susceptible of constituting a valid trade-mark; but to Beresford & Co. the picture is indispensable. It is necessary to decide, at the very entrance of the discussion, whether the two things can be brought into antagonistic relations.

Section 79 of the Act of Congress of July 8, 1870, in regard to trade-marks, prohibits the registration of any proposed trade-mark which is not, and cannot become, a lawful trade-mark; and, like the common law, its spirit is to deny protection to any mark which is calculated to deceive the public, and to lead to the purchase of one man's product for that of another. Although there is not the slightest ground for imputing bad faith

to either of the parties hereto, still the probable effect upon the minds of purchasers must be anticipated and guarded against. The Office must withhold that which may possibly be turned into an instrument of wrong, or even of annoyance in trade.

As an aid to solution, let us take a hypothetical case. A customer inquires thus: "Have you the 'Bouquet' brand of hams?" "We have." He is satisfied with the bare assertion, and gives his order. He does not particularize the bouquet as a picture, or the article marked with the word "bouquet." Confusion arises, to the injury of some one. Now, it is one of the characteristics of a trade-mark that it possess a distinctive individuality, so that it may not be confounded with any other, whether by means of vision or of sound. The very possibility of such a mistake is sufficient. That decides the question. The two things conflict, — the word "Bouquet" and the bunch of flowers, called a bouquet. This is the doctrine of the case of *Seixo* v. *Provezende*, 12 Jur. (N.S.) pt. i. p. 215.

Another preliminary question arises. Do both parties apply their marks to the same class of merchandise, and the same particular description of goods? If not, then the claims do not conflict. Schrauder's is for "cured meats;" Beresford & Co.'s for "hams and breakfast-bacon." The evidence settles that question in the affirmative. Both parties mean the same kind of merchandise, although employing different modes of expression.

In applying the evidence, the parties have proceeded upon two widely-different theories as to the law of the case. The applicant, Schrauder, has regarded the symbol only in its concrete relation, *i.e.*, as an emblem affixed to merchandise; while the respondents, Beresford & Co., have wandered into the domain of authorship and invention, and claim the proprietorship of the design as an abstraction. This is best shown by the points presented for consideration, as follows: —

For Schrauder.

1.

Under the common law of trade-marks, the mark itself is nothing — has no intrinsic value at all — its value is only after some protracted [1] connection with a particular article of manufacture or merchandise, as an index or badge of genuineness. It had no legal force or intrinsic value, until its use with a given article of merchandise had given it such, and then not of itself separately, but only as and when attached to such an article.

2.

In this respect it differs radically from even a design-patent, which is presumed to possess some artistic quality or merit. Not so a trade-mark, which may be a word, a line, — any mark not expressing quality.

3.

Another expressive evidence of its radical difference from even a design-patent is that, whereas in such patent the recipient must be either the designer, or hold by assignment from him, ownership in a trade-mark is created by simple adoption and use, — and in fact in the present case neither party claims to have taken any part in getting up the design.

4.

(This is principally a commentary on the evidence, and need not be quoted.)

5.

As far as appears, the adoption of the mark by each party was spontaneous. We know that Schrauder's was, and impute no other origin to Beresford & Co.'s, although it is impossible to overlook the singular delay in uttering Beresford & Co.'s., — Beresford & Co.'s being a cheap, poor concern in type-metal. If Schrauder's was not used in getting it up, at least they had

[1] Not strictly correct. The title may vest *eo instanti*, by affixing the mark. See §§ 52, 129.

good opportunity to so use it; but, as before said, this point we regard as not in the controversy; and we also regard it as not a material point.

6.

The great and material point for Schrauder, we consider, is the *use* of the bouquet brand on heavy shipments of his choice sugar-cured meats, far in advance of use by any one else, and by which *alone* the mere form of words acquired any value or significance whatever.

7.

(Comments upon testimony.)

8.

Schrauder was the first to take steps to protect his mark by registration, and would have been the first on record in the Office, had he employed a solicitor; but, as before intimated, our strong, only, and sufficient point is, that Schrauder was, by many months, the first to *use* the mark as a brand on goods.

9.

It is understood that the Office is guided in adjudicating such interferences as the present by modes of procedure, and rules of action, established in interferences between applications for patents, so far as the same are applicable. The radically-different nature and ground of claim for trade-marks have an important bearing on this; for whereas, in applications for patents, the invention or design *per se* is presumed to be new and valuable in itself, no such presumption accompanies a claim for a trade-mark. It does not need to be new or meritorious in itself, — that question is of no import in the slightest degree, and does not arise. James, who claims to have gotten up or suggested the mark for his employers (Beresford & Co.), admits that he *took* the idea *from* a perfume-bottle of X Bazin, so marked.

10.

Schrauder has gone to great outlay, and has fully identified his goods with the mark, and would be a serious sufferer to be now deprived of its use, after being the one to give it force and value in the only way in which it could be given, namely, by attaching it to goods. There is no evidence that Beresford & Co. would suffer any serious loss from any cause. [1]

For BERESFORD & CO.:

1.

Theodore H. James, agent of your applicants, *conceived*[2] of this trade-mark, and studied out its details, before George Schrauder, or his lithographer, or any other person had thought of it. James not only conceived of the trade-mark first, but in May, full a month before Schrauder, he very fully and completely described his bouquet-brand to William Porter: said that the flowers should be in the form of a bouquet in a holder: stipulated that the bouquet should be of various colors; specified that the word "bouquet" should be placed on the trade-mark: inquired about the probable cost of getting up a lithograph of the trade-mark; stated clearly that this trade-mark of a bouquet of flowers was to be applied to hams; and finally ordered Porter to get up such a lithograph. This transaction took place in the month of May, 1871, and from four to six weeks earlier than the first conception of the application of flowers to a brand for hams, &c., for Schrauder. . . . While it may be true that Schrauder's lithographer, so far as appears from the testimony, first reduced the design of a bunch of flowers for a ham-brand to a sketch, and pasted it as his trade-mark on hams, yet the present case is one of those cases in which the question who first reduced the trade-mark to a sketch does not enter.

[1] This point is rather inartificial in construction. The question is purely one of right, independent of all consequences to the interest of the parties.

[2] The idea of conception or invention cannot enter into a trade-mark case.

2.

Because first James, in May, described his trade-mark [1] fully. He had thoroughly conceived it, and he so described it to Porter that any man of common sense could understand and use his design. 1. He mentioned then to Porter a bunch of flowers; 2. He described their shape: they were to *form* a bouquet; 3. He mentioned their support; 4. They were to be put in a holder, and the flowers were to be of a variety of colors; 5. The word "BOUQUET" was to be added to the trade-mark: 6. The article to which the trade-mark was to be applied was mentioned: that article was hams; 7. The name of the parties for whom the trade-mark was intended — *i.e.*, Richard Beresford & Co. — was added. Thus it will be seen that all the main features of the trade-mark, with the details, were stated by James to Porter, when he ordered the latter, in May, 1871, to get up the lithograph for the trade-mark he, James, had described.

3.

Here was the trade-mark *invented* [2] and described by James in May, 1871, in such clear and accurate language, and in such full details, that any man of ordinary intelligence and sense could understand and use his trade-mark.

4.

The rule is, that where the substance of an invention [3] consists in the application of a device, &c., for a specific purpose, the person suggesting the device and its application is the inventor, though some one else puts the invention into practice. (See *Thomas* v. *Weeks*, 2 Paine, C. C. 92.) No negligence can be imputed to your applicants. They are "winter-curers," and proved this by their own and their opponents' witnesses,

[1] It never was James' *trade-mark*, as he had never reduced it to possession by adoption. The proper word is *design*.

[2] See above note on this point, and title "Invention."

[3] This is a natural mistake of patent solicitors. They fall into the error of confounding an attribute of commerce with the subject of invention.

that, having *invented*, through James, their trade-mark in May, 1871, they, being "winter-curers," and not curing their hams until the succeeding fall and winter, would not need their trade-mark labels until that time.[1] Your applicants, then, submit that said James was the first and original inventor of the trade-mark now in controversy; and that, as the assignees[2] of said James, they are entitled to the exclusive use of said trade-mark for ham and breakfast-bacon, &c.

It is obvious at a glance that the respondents, Beresford & Co., have not only mistaken the real issue, but have also based their case upon an inapplicable theory.

By reference to the specifications, — which serve the same purpose in this interference as do pleadings in courts, — it must be seen that Schrauder claims nothing but the word "Bouquet," although for pictorial effect he chooses to associate that word with a nosegay, bouquet, or bunch of flowers, call it by what name one may. The essential part of the respondents' mark is the bouquet itself. Inquiry and comment should therefore have been directed by them, not only to the date of adoption of the bunch of flowers, but also to the adoption of the word which is its proper designation. It is because either the eye or the ear might mislead a would-be purchaser that the claims of the parties have come into collision. But the evidence, as to facts, is so clear that the error of counsel, in points and argument, cannot prejudice the rights of a party.

The law of the case has been mistaken. They have treated the mark, the emblem, the symbol of commerce, as an invention, and have attempted to apply principles which are utterly inconsistent with the idea of a trade-mark. If the bouquet in controversy be regarded as a design, the subject of a patent, then it would be proper to treat of the conception of the thing, and of the *perfecting* of the *invention*; but it is only the wildest

[1] This admits their adversary's case. See, also, point 1, conceding that Schrauder first pasted the mark on hams.

[2] The application was not filed by Beresford & Co., as *assignees*. If assignees, they would have had to deduce their title from James.

flight of fancy that could possibly conceive of a trade-mark as a patentable design. It is true, that the copy of something patented as a design may possibly be adopted as a trade-mark, as may the representation of an infinite number of objects in nature and art; but the ideas of æsthetics and trafficking have not ever been associated in the manner supposed by the counsel.

It is hardly necessary for the present purpose to assert the truth that a design, as contemplated by the patent laws, means an artistic or useful conformation or delineation, which is intended to be incorporated with an article of manufacture, and is inseparable from it. In no legal sense could the emblematic picture of the respondents be deemed a design. And if it were a design, as understood by the law in relation to patents for inventions, it could not possibly have any bearing upon a case of trade-mark law.

We must utterly repudiate the idea of a right of property in the symbols constituting a trade-mark, apart from the use or application of them to a vendible commodity. (*Leather Cloth Co.* v. *American Leather Cloth Co.*, House of Lords, 1865, 11 Jur. (N.S.) 513; *Perry* v. *Truefitt*, 6 Beav. 66; *Congress & Empire Spring Co.* v. *High Rock Congress Spring Co.*, 57 Barb. 526; and all the authorities.)

For the purposes of this discussion, it is not of the slightest avail to inquire who first sketched, drew, or invented the design now claimed as a trade-mark. Other irrelevant matters must also be ruled out; the only important question is this: Who first applied the symbol to the vendible commodities dealt in by the parties hereto? Upon the determination of that single question of fact rests the whole of the case. Let us resort to the testimony.

The witness Moers is positive that he saw Schrander 'abels affixed to packages of cured meats three or four weeks prior to September 8, 1871, and the witness Milholland says that shipments of meats bearing said labels were made by Schrander

a few days after the 10th day of August, 1871. The labels are clearly identified, and all bear the trade-mark described by Schrauder in his specification. All the evidence corroborates the statements of these witnesses. It is undoubtedly true that Schrauder had appropriated the mark in August, 1871, and that he from that time continued to affix it to his merchandise. It is proven that he was doing a large business in the sale of cured meats. The lithographer Strobridge, who furnished the lithographed labels, testifies that he supplied Schrauder with 500 labels for tierces of his meats; with 10,000 labels of another size; and with 500 labels for boxes. The said labels all bore the trade-mark described and claimed by Schrauder; and all were used in his place of business until the supply was exhausted, and more were required. He, then, had the ownership of the mark claimed by him, unless some other person or persons had adopted it before he had.

When did Beresford & Co. adopt the bouquet? Their printer testifies that he delivered their labels to them either in September or October, 1871, the charge for them having been made on the 7th day of November following. Their clerk, James, testifies that the first time he saw the bouquet-brand used was in January, 1872, when he saw it affixed to a ham bought from Schrauder. There is no pretence on the part of Beresford & Co. that they affixed the mark to their merchandise before that time; and indeed they account for their delay in its use by the fact that they were "winter-packers," while their adversary Schrauder was a "summer-packer:" *i.e.*, the latter worked in the warm season, while they could only work during the cool season. They relied upon the adoption of the abstract symbol, and did not make it a trade-mark. Schrauder's earlier business compelled him to use it in August; and by his act, in affixing it to the goods sold by him, — to wit, cured meats, consisting of hams, &c., — he did all that the law requires to reduce the emblem to possession, and thus he made it a trade-mark.

There seems to have been a confusion of ideas in the minds of Beresford & Co. as to the real nature of their device, the representation of a bouquet. By the testimony of James, their clerk, it appears that in September or October, 1871, they, through him, applied to the Librarian of Congress for a copyright of the picture, — although the thing had not the slightest claim to be a literary or artistic production, and was not intended to be sold as such, — and that a copyright was issued, bearing date the 26th or the 29th of October.

Whatever may have been their intention as to securing to themselves any possible property in the picture, it is manifest that the thing could no more be copyrighted than it could be patented: for the designer of the picture was neither an author nor an inventor, within the meaning of subsection 8 of section 8 of article 1 of the Constitution. Says Lord Cranworth, in the "Leather Co." case before cited: "The word 'property,' when used with respect to an author's right to the production of his brain, is used in a sense very different from what is meant by it when applied to a house or a watch. It means no more than that the author has the sole right of printing or otherwise multiplying copies of his work. The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where, or by whom, or at what manufactory, the article to which it is affixed was manufactured."

So, in the Supreme Court of the United States, in the case of *The President, &c., of the Del. & Hud. Canal Co.* v. *Clark* (Official Gazette, March 26, 1872), the court said that "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." This is the received doctrine of all the courts. Inventive or literary genius has nothing to do with the index of proprietorship termed a trade-mark.

Even if the respondents, Beresford & Co., had "originated the trade-mark for which they . . . seek protection," as stated in their sworn application, they did not perfect it by actual use

— *Ignorantia legis neminem excusat.* But it seems that on the naked question of moral right, they were not the designers of it; but either James, or the engraver, or Schrauder's lithographer, was the first designer of it. But this is outside of the law of the case, and is touched upon only for the reason that counsel of experience and acknowledged ability in patent law have misconceived the theory of trade-mark law, and made it necessary that some notice be taken of it.

Schrauder's counsel made a point that their client was the first to take steps to protect the mark by registration. The fact is, as appears by the records, both parties filed their applications on the same day, February 26, 1872; but Schrauder's papers were incomplete, and had not been prepared with as much care as had those of Beresford & Co., and therefore the case of the latter was first examined. But the fact of priority of filing cannot affect the title, its advantage consisting but in the circumstance of throwing the *onus probandi* on the junior applicant, *i.e.*, he who had been the latest to complete his papers.

The evidence being clear that George Schrauder, the applicant, was the first adoptor of the trade-mark in controversy, judgment of priority is accordingly awarded to him.

§ 662. A multiplicity of legal questions arise upon the trial of an interference before the Patent Office. The following case of *Walch, Brooks, & Kellogg* v. *M. J. Cole & Co.*, involves a number of nice points worthy of notice. Any matter affecting the title to the thing in controversy may be shown, subject, of course, to the established rules of evidence. — After reciting certain facts not necessary now to be considered, the decision of BROWNE, *Special Examiner*, proceeds: —

§ 663. **Motion to allow a New Party to come in.** — After the declaration of interference, a motion was made for the substitution of one John H. Farwell as a party in place of M. J. Cole & Co. It is in evidence that the latter had upon their

own petition been declared bankrupt, and one Henry D. Hyde had been appointed assignee. Farwell filed an instrument purporting to be an assignment and transfer of the trade-mark in controversy. There is no evidence of the authenticity of said instrument; and, indeed, it is not perceived what legal right the assignee in bankruptcy of the individual and partnership estates of M. J. Cole & Co. had to make the transfer; for the trade-mark had not been included in the schedule of assets. (See case of *Bradley* v. *Norton*, 33 Conn. 157.) If there had been the formality of including it among the assets, the evidence warrants the conclusion that, in contemplation of law, the bankrupts had really no trade-mark property to convey. As Farwell took nothing by his so-called assignment, his motion to be permitted to come in as a party litigant was necessarily denied.

§ 664. **The Essential Part of the Mark.** — It was assumed, for the purposes of this interference, that the name "Paul Jones," the conspicuous element in the mark, was that by which the whiskey would be bought and sold, and known in the market. The evidence shows that it was the prominent, essential, and vital feature of their mark, as it is also of that of their opponents. (See *Filley* v. *Fassett*, 44 Mo. 173.) The inquiry was therefore directed to those words, without which, as a component part of the mark, neither party would have desired to make a contest.

§ 665. **As to Title to Trade-mark.** — The first question to be settled is this: Did M. J. Cole & Co. have any property in those words, as a portion of a trade-mark to be affixed to whiskey? The testimony of Cole, of Gilmore the clerk, and of Hunt, the partner, established as a fact beyond any reasonable doubt that Cole & Co. devised the symbol for their own benefit, although one of their present opponents assisted therein. The mark was to be used in connection with whiskey, which M. Murphy & Co., the predecessors of Walch, Brooks, & Kellogg, were to manufacture in Cincinnati, Ohio, and of which

M. J. Cole & Co. were to have the exclusive sale in Boston, Mass. The title was clearly understood to be in M. J. Cole & Co., notwithstanding the fact that, for the sake of convenience, the branding-tool was made in Cincinnati, at the expense of M. Murphy & Co.

§ 666. **Good Faith.** — The *bona fides* of the latter firm and their successors may well be doubted, in connection with the possession of the branding-tool. It was used upon whiskey sold to other persons in the West and South; and, contrary to the contract, expressed or implied, made with M. J. Cole & Co. To the latter-named firm, if to anybody, belonged the mark. But there is one material fact disclosed by the evidence which determines all their title. The words "Paul Jones" were used as a portion of a brand, the other part of which was "Paris, Kentucky, Bourbon." Cole says (155, 158 X ans.), "If anybody bought the whiskey supposing that it was made in Paris, Kentucky, he would have been deceived." He says that it was thought that that brand would take better with the trade. (173 X ans.)

§ 667. **Imposition upon the Public.** — But one conclusion can be deduced from the evidence in regard to the *bona fides* of M. J. Cole & Co. in adopting that which they allege to be their trade-mark. Their intent was manifestly to impose upon the credulity of the whiskey-drinking public, by inducing them to purchase as genuine "Kentucky Bourbon Co. Whiskey" an article manufactured at Cincinnati, Ohio. The device had its inception in fraud, and therefore was worthless for the legitimate purposes of a trade-mark, even if the Cincinnati whiskey were proven to be as valuable as that made in Kentucky. Numerous judicial decisions support this view of the law. The public have a right to the genuine thing. M. J. Cole & Co., therefore, never had any legal property in the words composing the alleged trade-mark.

§ 668. **No Title in Assignee.** — As they had no trade-mark to assign when going into bankruptcy, it follows that their assignee took no such property with the assets.

§ 669. **Could an Abstract Symbol be assigned?** — It is not necessary to discuss the question of the possibility of such an incorporeal interest being conveyed, unless as an incident to the transfer of the good-will of the business; for there is no evidence to act upon, in relation to the transfer of the good-will.

§ 670. **Good Faith of Respondents.** — How does the case stand, as regards Walch, Brooks, & Kellogg? They claim as a trade-mark the words "Paul Jones, Paris, Kentucky, Bourbon," &c. The said mark is intended to be applied to whiskey manufactured by them at Cincinnati, Ohio. Their own testimony is conclusive upon that point. Indeed, they do not make the slightest pretence that the whiskey manufactured by them is distilled in the State of Kentucky.

§ 671. **Want of Equity.** — There is no more equity on their side than on the other. The argument of their counsel at the hearing, That the words constitute a mere arbitrary symbol, and that no deception was intended by them, does not require long consideration. The only meaning that general purchasers would be likely to attach to the words would be that the whiskey was distilled at Paris, Bourbon County, Kentucky.

§ 672. **Conclusion.** — Walch, Brooks, & Kellogg have not presented a lawful trade-mark for registration.

§ 673. **Judgment.** — The interference is therefore dissolved, and both applications rejected.

CHAPTER XV.

ABANDONMENT.

How Question may arise. — Error in arguing from Supposed Analogies. — When Symbol is discarded by one Person, any other may adopt it. — If Symbol becomes Free to the Public, its Technical Trade-mark Existence is extinguished. — Distinction between Abandonment of Trade-mark and that of other kinds of Property. — What amounts to Abandonment. — Difficulty of laying down Rule. — Intention is a Necessary Element. — Evidence thereof must be Clear. — Forbearance to prosecute is not Fatal. — Abandonment in one Country is Abandonment in all Countries. — Conclusion.

§ 674. **Abandonment** sometimes is alleged as an affirmative defence, while it may incidentally be drawn into question in *ex parte* proceedings upon application for registration. It is advisable, therefore, to ascertain the import of the term, as applied to a trade-mark case, and to consider the facts that may constitute it. But, at the very threshold of the investigation, we must be on our guard not to fall into error in attempting to reason from wrong premises or false analogies.

§ 675. A common mistake is this: in confusing notions of other kinds of rights with that right which consists in property in a certain emblem or device, with which a manufacturer or merchant stamps his wares and merchandise. A trade-mark differs essentially from all other matters of property. For that reason, we cannot hope to arrive at an intelligent understanding of the subject, unless we sedulously keep several points in view. Those are distinctions between the dedication or dereliction of tangible property, deliberately yielded into the common stock of the community or of the world, and the forsaking of a claim to the exclusive use of a mere shadow of incorporeal property, as is the emblem or device which is to become a

trade-mark. We have a clear idea of the utter forsaking of lands, and of the casting of a jewel or coin into the sea, or upon the highway; and we can clearly conceive the idea of an abandonment of the right to a patent for an invention, or an exclusive claim to the product of a person's literary labor; but the subject of cession, actual or tacit, of the right to prohibit all other persons from marking goods in a certain mode, or with a peculiar symbol, is a matter that is somewhat more difficult of comprehension. Let us inspect the lines of demarcation.

§ 676. Property belongs to him who first makes declaration of an intention to appropriate it to his own use; and the title remains in him, by the principle of universal law, till he does some other act which shows an intention to abandon it; for then it becomes, naturally speaking, *publici juris* once more, and is liable to be again appropriated by the next occupant.[1] Thus a valuable thing deliberately cast away is an express abandonment of private claim to its possession, and the finder becomes its owner. So a conveyance of land by deed, or a long-suffered adverse possession, is conclusive evidence that the former owner intended to divest himself of title, in favor of the party who shall have succeeded to the possession. So, also, if an inventor from a motive of patriotism, generosity, despair, or any other cause, acquiesce in the public use of his invention for two years, he is debarred from subsequently obtaining a patent therefor;[2] or he may abandon his claim to a monopoly at any instant, and the right to the invention passes at once into the public stock. In all such cases, whether of tangible property or of incorporeal rights emanating therefrom, there is something to affect the senses, and the land, or jewel, or invention embodied in a machine or composition of matter, can be seen and felt; and property in the object or thing may truly be said to exist. Not so with the symbol that a trader has made the peculiar mark of his goods. We have seen heretofore that

[1] 2 Blackst. Com. 9.

[2] Adams & Hammond *v.* Edwards *et al.*, 1 Fish. 1.

there cannot be property in an abstract symbol, whether that be an original design, or word, or emblem; for it is only an index to a certain article of merchandise. That undeniable truth being conceded, how can we draw a parallel between the relinquishment of a hold upon something which in itself is property, and another thing which until actually affixed to a vendible commodity is purely ideal! The land and jewel continue to be property under all circumstances; but a trade-mark ceases to be property the moment that its exclusive use ceases, and it resumes its ideal state. Its conjunction with a corporeal thing is like the union of soul and body.

§ 677. The thing abandoned may be instantly and simultaneously seized by a large number of persons, and that either in fact or by operation of law, as in case of a right of common, or a right to use an invention; and when the original owner's grasp is once released, the exclusive right is gone from him for ever. He cannot regain it, as in the case of a coin tossed by him into the public street, and which he may be the first to again pick up. A trade-mark may be discarded and be resumed, unless in the mean time it be taken possession of by another individual, or by a number of persons with united interests, or by the community in general. In the latter case, the thing may truly be said to be extinguished, for when all may use there is lacking the essential element of an exclusive right. We are supposing that the mark is one that is not personal in its nature, but one which is associated rather with an object of commerce than with a certain person. Yet we read of instances in which courts have held that a man's name may lose all idea of personality, and become merely a generic designation.[1] But we will not stop to discuss exceptional cases.

§ 678. Now, as to the extinguishment of a trade-mark. Suppose, for the sake of illustration, that a word that has been coined by a manufacturer to indicate a peculiar product be intentionally disused by said manufacturer, and that all other

[1] See §§ 178–181, *ante*.

persons in the same line of business by common consent adopt the word as the most suitable name for the thing, — as was the case as to the word "Lucilene," a name given to purified petroleum,[1] — then that name falls into the domain of commerce, and is not susceptible of reappropriation by him who first used it, as a fanciful denomination for his article of manufacture. But suppose, again, that, after having deliberately abandoned the mark, the late owner change his intention, while the title is still in abeyance, he may repossess himself of it, just as he might upon reflection recover the jewel flung into the sea or upon the highway. The case of the inventor is quite different. He has no right to his invention at common law. The right which he derives is a creature of the statute and of grant, and is subject to certain conditions incorporated in the statutes and the grant. He does not get his right to a patent on the ground of any inherent natural right which he has.[2]

§ 679. Hereby we see the impropriety of arguing upon decisions made under allegations of abandonment of an invention; for as the idea of invention does not enter into the contemplation of the law applicable to trade-mark property,[3] we must dismiss the false analogy from mind. To complete and perpetuate the act of abandonment, there must be a tender, an acceptance, and an adoption. The only mode by which a trade-mark can be adopted is by user in the actual affixing of the mark to merchandise.[4] How is it with an invention? If the first inventor choose to abandon the result of his genius, after perfecting it so as to be applicable to a practical useful purpose, and another and later inventor obtain a patent therefor, he fails to obtain any benefit, not being the first inventor of the particular thing. Why? Because the title to the invention passed to the public, the instant that the only person who had a right

[1] See § 252, *ante*.

[2] American Hide and Leather, &c., Co. *v.* American Tool, &c., Co., 4 Fish. 284.

[3] §§ 346, 347, *ante*.

[4] §§ 52, 382–384.

to a patent dedicated his invention to the common stock of property. But in the case of discontinuance of the use of a trade-mark the public gain nothing thereby, except the negative benefit of precluding an individual from profiting by the exclusive use of it as a sign. Thus in a case[1] in the Court of Paris, in 1870, when the plaintiff's claim to the exclusive use of the representation of a golden bee, as a trade-mark for hats, was rejected, what did the public gain by the decision that the emblem was *not a private mark*? *The court said, among other* things, that, whether as an emblem, or as an ornament, the bee is common property. Any person might therefore use it as an ornament for a hatter's label or in any other mode; but the plaintiff had no exclusive right to "a bee in his bonnet." There is no advantage to the public in the liberty of adorning their furniture or hats with golden bees; but there is always presumed to be benefit in the use of an invention, of which benefit the use is the strongest kind of evidence. If the right of everybody to use an emblem, name, or word, were to exempt him from the annoyance of litigation, that might be deemed a positive benefit, but that such is not the truth must be evident to all. We have seen many proofs to the contrary in the foregoing chapters of this book. As evidences of our right to call a thing by its true name, we might cite authorities by the score. The name may originally have been the coinage of a manufacturer to designate his peculiar product; but it may have instantly become the only true and proper denomination of the article, wherefore all might use it.

§ 680. **What amounts to Abandonment** of a trade-mark? It is more difficult to lay down a rule in this matter than in the case of corporeal property. The latter we may see and handle. The product of invention affects the perceptive faculties. We cannot see a trade-mark unless it is in full vigor. We may see a perfect *representation* of a signature or of an emblem of commerce, but the trade-mark itself is visible only as an affix of

[1] Hérold *v.* Gerbeau, Annales de la Prop., tome xvi. p. 76.

some corporeal vendible object. Hence one difficulty in determining the exact moment when one must be held to have abandoned a trade-mark. A manufacturer or merchant may discontinue the stamping or branding of his products for many years before he discontinues the sale of the goods marked by him, and may destroy his dies, brands, or stencil-plates; for he may have laid up a large stock of his wares or products, or he may have launched them upon the ocean of commerce. Our Government employs a fac-simile of the very peculiar autograph of Mr. Treasurer Spinner, as a proprietary mark for national securities, to be sold or exchanged for gold or other valuables. The printing of bonds and notes bearing that trade-mark may for ever cease, but the paper evidences of debt remain afloat, and the mark continues to be constructively, if not actually, in use. The nation will not have abandoned the mark by discontinuing the printing of it. By a parity of reasoning, a private owner of a trade-mark does not necessarily abandon it by ceasing to stamp it on goods as his sign-manual or peculiar emblem.

§ 681. The criterion manifestly is this: Was there an *intention* to abandon? Without such intention there could not be abandonment, although it is equally true that the intention may be inferred from circumstances of neglect as well as of positive dereliction, and the party would be concluded thereby. A person may temporarily lay aside his mark, and resume it, without having in the mean time lost his property in the right of user. Abandonment, being in the nature of a forfeiture, must be strictly proven. For example, if the proprietor of the word-symbol "Cocoaine" should be met in a suit with the allegation that he had lost all exclusive right to the use of that trade-mark, it would be incumbent on the party making that defence to show that he had, by clear and unmistakable signs, relinquished his claim to it as a trade-mark, so that other manufacturers or vendors of preparations of cocoa-nut oil had actually employed it as a generic term. If that point were

established, it would be manifest that the trade-mark had expired. That is what is meant in French-speaking countries by the expression, "to let fall into the public domain" (*laisser tomber dans le domaine public*). We must examine the surroundings of each case of imputed surrender, to be enabled to settle such question of deliberate yielding up.

§ 682. Would it constitute abandonment for the proprietor of a trade-mark to calmly look on while another files a claim in the Patent Office for the identical mark? No. Wherefore? For the reason that assertion of title and the recording thereof do not create any thing beyond a rebuttable presumption of property. So said the Court of Cassation of France, in 1864, in affirming a decision of the Court of Paris.[1] PER CUR.: The deposit does not constitute an exclusive property in the mark. That is necessary only for the purpose of enabling the owner to obtain redress for infringement. It is necessary to inquire always if the right existed previous to the deposit, and if the depositor has not renounced it. — This ruling is simply an enunciation of a doctrine that is universally maintained. It is the law of common sense. No one can obtain a title to lands by placing a forged paper upon record; for, although having all the external appearance of truth, it may have been forged, or never delivered, and therefore not be a deed in law. So of a symbol previously appropriated by another as his trade-mark. The registrant takes nothing by his stealthy motion, and the true owner is not despoiled thereby; although the attempt at fraud may furnish grist for the judicial mill. In an analogous case,[2] Clifford, J., held that actual abandonment must be proven, and that it is not possible to hold that the use of an invention without the consent of the inventor, while his application was pending in the Patent Office, could defeat the operation of the letters-patent afterwards duly granted. It may be that the owner of the trade-mark was under a disability to register, as

[1] Leroy *v.* Calmel, Annales de la Prop., tome x. p. 193.
[2] Dental Vulcanite Co. *v.* Wetherbee, 3 Fish. 87.

in the case of a resident of France previously to the making of the late convention of 1869. Yet his title was perfectly valid at common law. Section 82 of the statute of July 8, 1870, clearly recognizes this truth, for it makes it penal for any person to "procure the registry of any trade-mark or of himself as the owner thereof . . . by making any false or fraudulent representations or declarations, verbally (*i.e.* orally) or in writing, or by any fraudulent means," &c. Now, it is obvious that if one, by mere registration, could divest another of a common-law right, said section could never have been written. Section 83 of the same statute carefully preserves all common-law remedies for a wrongful use of even unregistered trade-marks. We see, therefore, that it is not abandonment for an honest trader, through inability or indisposition, to lie on his oars while another person attempts to commit an act of piracy. The wrong-doer is "hoist by his own petard." It must, however, be conceded that a long-continued neglect to attack a trespasser may be a circumstance tending to prove an intention to abandon. In one case,[1] after the commencement of a suit based upon infringement, the real defendants (although concealed behind others) made an attempt to appropriate the infringed trade-mark, by going through the form of registering it as theirs, under the Missouri statute of March, 1866. The court, by Currier, J., scouted the idea that the law could be made available for such a *nefarious purpose*, and said, as to that statute: "It was not designed to weaken or abridge any existing rights, or any future right to a trade-mark which might be acquired in the usual way, or to legalize, in any form or measure, piracy in trade-marks." Shepley, J., instructed the jury in a patent case[2] that "abandonment means a general abandonment to the public, and must be shown affirmatively and positively, as affecting the interest of the party; . . . it is dedication to the public; a giving up of the claim to the

[1] Filley *v.* Fassett, 44 Mo. 173.
[2] Am. Hide, &c., Co. *v.* Am. Tool, &c., Co., 4 Fish. 305.

monopoly in the invention." In the case of an easement,[1] the court said "the presumption of abandonment cannot be made from the mere fact of non-user. There must be other circumstances in the case to raise that presumption. The right is acquired by adverse enjoyment. The non-user, therefore, must be the consequence of something which is adverse to the user." This point of non-user calls up a case that requires comment.

§ 683. In the New York Common Pleas Court, in 1854,[2] Ingraham, First J., charged the jury that the defendant was liable for the sale of leather stamped with a *former* trade-mark of the plaintiff's, although at the time of said sale the plaintiff employed exclusively a mark of a different device; and that his property in the original trade-mark was not divested by discontinuing its use. It may possibly be that the reporter of the case, although a respectable member of the legal profession, may have misunderstood the language of the judge. On appeal to the court, *in banc*, Daly, J., in delivering the opinion of the court, said, more correctly: "The fact that the plaintiff had discontinued the use of this trade-mark for three years would not deprive him of a right of action against the defendant, for selling leather which was not manufactured by the plaintiff, but stamped in the same manner in which the plaintiff had formerly designated the leather manufactured by him, thus purporting to be of his manufacture, and declared by the defendant at the time of sale to be the genuine Lemoine calfskins." If we were to stop here, it might be with the erroneous impression that the learned judge meant that the mark had not been abandoned by a non-user for three years. He continued: "The wrong and injury to the plaintiff consisted in the sale of calfskins falsely purporting and declared to be of his manufacture; and it makes no difference whether that object was effected by counterfeiting the trade-mark which he uses at present, or one that he formerly used. An injury results to him in either

[1] Ward *v.* Ward, 7 Exch. 738.

[2] Lemoine *v.* Ganton, 2 E. D. Smith, 343.

case." This, then, was not an action for infringement of a trade-mark; but was an action for fraudulent competition and deceit, by means of a certain device that had formerly been a trade-mark. Lemoine had abandoned that device, and it had ceased to be a trade-mark. The act of abandonment was completed the instant that he intentionally discontinued its use — three years before.

§ 684. **Laches.** — What may be considered such remissness, carelessness, or neglect, as shall work a forfeiture of right to a trade-mark? It has sometimes been contended that a forbearance to prosecute infringers amounted to abandonment. But this view has not received the sanction of our courts. To be sure, we find in the "Official Gazette" of the Patent Office of January 10, 1872, an opinion of Wylie, J., of the Supreme Court of the District of Columbia, which, taken just as it appears in print, affirms that such forbearance does amount to abandonment. It would be a piece of gross injustice to the judge to omit to state that he receded from the position first assumed by him, and made all the amends in his power by granting a decree in direct opposition to his published opinion.[1] From the published report, it seems that the complainants are an incorporated company at Sheffield, England, engaged in the manufacture of fine cutlery, and are the successors of Joseph Rodgers & Sons, by whom the business was first established more than a hundred years ago. They alleged that their name and mark — a star and a Maltese cross — had been infringed. The defendants are respectable booksellers and stationers in Washington, D. C., and are dealers in fine penknives, scissors, and other cutlery. An injunction was asked for. The judge said, *inter alia*: "I am of opinion that this suit cannot be maintained by these complainants. . . . These goods have been manufactured in Germany, and sold extensively in this country under this spurious trade-mark, for nearly if not quite a quarter of a century. These facts must have been known to the complainants

[1] Rodgers & Sons *v.* Philp & Solomons, Off. Gaz. vol. i. p. 29.

almost from the beginning. One of the affiants states that he himself gave verbal notice of them to a clerk of the complainants, at Sheffield, in 1865, and was informed that his employers were perfectly aware of all that had been done. And yet, in all this period, the complainants have taken no measures, either in this country or in Germany, to vindicate the exclusiveness of their title to the trade-mark in question. They have seen, looked on, and permitted these German manufacturers to employ a similitude of their own trade-mark, and under it to make extensive sales to the people of this country. This long acquiescence might not possibly debar the complainants from remedy for their injury as against the German manufacturers. . . . It tended to encourage, and did encourage, our own people to part with their money in exchange for these goods. It was in violation of no law or contract, nor was it a wrong done to Rodgers & Sons, of Sheffield, when the goods in question were bought by the defendants in the city of New York. The neglect of these English manufacturers to arrest within a reasonable period, by legal measures, the violation of their rights in their own trade-mark by the Germans, amounted in law to a license to the world to buy the goods from the latter under the imitation trade-mark. All that can be expected of them is to take care that they are not cheated themselves, and that they defraud no one in their turn. It could not be tolerated that manufacturers, like patentees, should have the right as long as they should have a trade-mark — it might be for a hundred years, as in the case of these complainants — to send agents all over the country, and interfere with the business of every man who happened to have bought goods manufactured by other companies, and sold under an imitation trade-mark." Excellent! a title to roguery by prescription. Plea of a pirate that he and his ancestors had been so long engaged in the business of plundering foreign craft, that his right in the premises had become perfect, and a prayer that the indictment be quashed! We might regard this opinion of the judge as a

gleam of judicial pleasantry, were it not for the solemn style of the document as a whole. By consulting a previous part of this same opinion, we find that the defendants say in their answer that the goods were purchased with the knowledge that they were manufactured in Germany; "that goods of this manufacture, and stamped with this trade-mark, have been well-known to persons engaged in the business for nearly if not quite twenty-five years, as being different from those made by the English house of Joseph Rodgers & Sons; that they are of equally good quality with those produced by the English firm, and can be sold for thirty-three *per cent* less than these." We are all well aware by this time that it is no defence that the spurious wares are as good as the genuine.[1] If that could be received as a defence to a prosecution for infringement, farewell to protection! Nor is it a valid answer that the trespass is of long-continuance. There is, therefore, no just defence to the bill filed in the case under discussion. So, upon reflection, thought Judge Wylie. Out of a feeling of tenderness for the reputation of a judge, as well as to demolish a false authority, let us now place in print the sequel, which by some fatality has never found its way into the "Official Gazette," or (it is believed) any other legal periodical or book of reports. On the 5th day of February, 1872, the cause came on to be heard before the same judge. He decreed a perpetual injunction against the defendants, their servants, agents, or employés, restraining them from passing, putting up, selling, or offering for sale, penknives, pocket-knives, or other articles of cutlery other than those manufactured by the complainants, having imprinted, stamped, or in any wise marked thereon a star and Maltese cross, or any device substantially similar to, or in any manner imitating, said device of a star and a Maltese cross adopted and used by the complainants, Joseph Rodgers & Sons, as their trade-mark, &c., &c. In consideration of the honorable conduct of the defendants, in accepting the situation with good

[1] See authorities cited in note to § 336, *ante*.

grace, while not throwing any obstacles in the way of a righteous result, the complainants remitted the costs. Let us now learn what other judges have said upon the matter of abandonment of trade-marks.

§ 685. Story, J., once spoke thus:[1] "Again it has been said that other persons have imitated the same spools and labels of the plaintiffs, and sold the manufacture. But this rather aggravates than excuses the misconduct, unless done with the consent or acquiescence of the plaintiffs, which there is not the slightest evidence to establish; or that the plaintiffs ever intended to surrender their rights to the public at large, or to the invaders thereof in particular." The circumstances of this case are very similar to those in the Rodgers & Sons suit; and the defence therein made set forth infringements by others upon the plaintiffs, an English house. — And now comes another witness upon the same side of the question. As to the pretence of right in plundering foreigners, Woodbury, J., said:[2] "I am not aware of any principle by which a usage in this or a foreign country is competent evidence in defence of a wrong. . . . The defendant now argues that this evidence was competent to show an acquiescence by the plaintiff in the use of his marks, or to show a dedication of them to the public, as he knew that marks of theirs as well as of others were used in this way, and without redress, in this country as well as abroad. . . . But I am not aware that a neglect to prosecute, because one believed he had no rights, or from mere procrastination, is any defence at law, whatever it may be in equity (1 Story, 282), except under the statute of limitations pleaded and relied on, or under some positive statute, like that as to patents, which avoids the right if the inventor permits the public to use the patent some time before taking out letters. . . . There is something very abhorrent in allowing such a defence to a wrong, which consists in counterfeiting others' marks or stamps, defrauding

[1] Taylor *v.* Carpenter, 3 Story, 458.
[2] Taylor *v.* Carpenter, 2 Wood. & M. 1.

others of what had been gained by their industry and skill, and robbing them of the fruits of their 'good name,' merely because they have shown forbearance and kindness. . . . It is rather an aggravation to the plaintiffs that many others have injured them." — Lest the false doctrine be not sufficiently exploded, we may cite further authorities, powerful enough to pulverize the absurdity. When discussing the idea of acquiescence operating as an absolute surrender of an exclusive right, Duer, J., said:[1] "The consent of a manufacturer to the use or imitation of his trade-mark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent, whether expressed or implied, when purely gratuitous, may certainly be withdrawn; and, when implied, it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license." Potter, J., eighteen years later used substantially the same language,[2] and held that it is no defence that the fraud has been multiplied, and further held that acquiescence cannot be inferred, and is revocable if it could be. Upon appeal to the general term, two of the judges held that it was no acquiescence in the plaintiff, where it did not appear that he had discovered any individual whom he could attack as an offender, although the plaintiff knew that persons were trespassing upon him. The third judge thought that the knowledge of the fact of such infringement for more than twenty years would be treated as an acquiescence by him. But not one of the members of the court hinted that such acquiescence could amount to entire abandonment. Currier, J., in speaking for the whole court,[3] took the same position that had been before maintained, and said that the infringement of the plaintiff's mark by others in no way aided the defence. Said he: "The depredations of others on plaintiff's rights furnish no excuse to the defendants for similar acts on their part.

[1] Amoskeag Manuf. Co. *v.* Spear, 2 Sand. S. C. 599.
[2] Gillott *v.* Esterbrook, 47 Barb. 455.
[3] Filley *v.* Fassett, 44 Mo. 173.

It is rather an aggravation to the plaintiff that others have also injured him. And courts have not shown any disposition to encourage that line of defence." We hardly need to pursue the theme, for the weight of judicial authorities all tend the same way, in vindication of the venerable maxim,— *Jus et fraus nunquam cohabitant.*

§ 686. Yet a sense of truth compels us to cite two French cases which *seem* to assert that right and fraud may not only inhabit the same house, but may dwell together in harmony. The first is a judgment of the Court of Cassation.[1] It has such an air of moral obliquity about it as almost justifies the animadversions of the eminent jurists who have criticised and condemned it. If we carefully scan all the facts, we may possibly come to the conclusion that the judgment is reconcilable with the maxim above quoted, and also with that cited and relied upon by the demandants' counsel,— *Contra non valentem agere non currit præscriptio.* It was admitted by the tribunal of first instance, that, for more than half a century, the files made and sold by the house of Spencer & Stubs, now Spencer & Sons, of Sheffield, England, had enjoyed an incontestable industrial renown ; and that for many years — thanks to the immunities given on the Continent to the counterfeiting of foreign products — the manufactures of the demanders had been imitated in innumerable quantities, with the mark and name of the genuine house, all of which was done without the acquiescence of the demanders. By long usage, continued the mouth-piece of the tribunal, the name and mark had come to be the characteristic indication of a product; and therefore the owners had lost all right to the exclusive use by the effect of a sort of prescription of fact, *longi temporis*, for the name and mark had ceased to indicate origin or ownership. The advocate-general Bédarrides asks, on appeal, "Of what prescription do they speak? The tolerance of usurpation, can that serve to found a right?" The Court of Paris, on appeal, dis-

[1] Spencer & Son *v.* Peigney, Annales de la Prop., tome x. p. 197.

coursed thus: Considering that, for more than fifty years, the mark composed of a crescent, a Z reversed. and the name of Spencer has been adopted by French industry in the fabrication of a species of files; that this mark does not designate the origin, nor even the nature, of the fabric; that the French fabricants have rendered it common in France, and have given to it a just celebrity: considering that Spencer & Son, in availing themselves of article 12 of the treaty of commerce between France and England of the 10th of March, 1860, had not the power to take a mark which had become the property of French industry; that for the purpose of distinguishing their products they could only take a mark peculiarly their own, and that what they really did deposit with the clerk of the Tribunal of Commerce of the Seine is a mark composed of a crescent, a Z reversed, the name of Spencer, and the name of their place of manufacture,—*Sheffield:* considering that it is only to the last mark that Spencer & Son have an exclusive right; that Peigney has respected their property on this point, and in placing on the files made by him the mark which for long years had become proper to French commerce, he has committed no tort; and adopting in full the reasons of the judges below, let the appeal go for naught, and order that the judgment appealed from have full and entire effect, and condemn Spencer & Son to the costs of appeal.

§ 687. We must constantly bear in mind that this decision of law is based upon the question of fact determined in the tribunal below. The mark had lost its pristine integrity. Its individuality was annihilated. It might be likened to a ship decoyed by false lights and dashed into fragments on the rocks, to become a common prey. The mischief had been done beyond redress. The mark had lost all power to distinguish the manufacture of any particular person or company. It had become, through an unfortunate concurrence of circumstances, the mere sign of a class of goods. We perceive, therefore, that this cannot be deemed, even in theory, to be a case of abandonment.

The law will protect a man's life, but it cannot restore vitality. A dead man must remain dead.[1] The tribunal of last resort, the Court of Cassation, was bound by the fact established below. It said, *inter alia:* Inasmuch as Spencer & Son have deposited in France *another* mark, differenced from the preceding by the addition of the name of their place of manufacture,—Sheffield,—they have an incontestable exclusive right of property in that; but as this latter mark has not been usurped, the judgment must be affirmed.—Our wrath subsides, when thus reaching the inevitable conclusion, that the demanders were virtually conquerors. The Supreme Court had not the power to overturn a *fact* found. It did the best it could by intimating in clear language that the trivial addition of the name of a place made a new mark.—As the house of Spencer & Son never *intended* to abandon their trade-mark, it had not been abandoned.

§ 688. The case of *Stubs* v. *Astier et als.*,[2] in the Court of Paris, in 1864, on appeal from the Tribunal Civ. of the Seine, involved the same principle. The Tribunal condemned the defendants, confiscated the spurious goods, consisting of cutlery, and imposed a fine. Hence the appeal. The appellate court said that the mark claimed by the complainant as his peculiar property had long been in France the index of a product of superior quality, and had ceased to be an indication of the origin of manufacture, but had become the very designation of the nature of the product of which it is the denomination. That a mark so long known to the public to cover products of a superior quality would operate to the exclusion of all others was manifest, and it would cause considerable damage to French industry to deprive it of the fruit of labor, to enrich Peter Stubs; that such a result would, in effect, extinguish the just stipulations of reciprocity, contained in the treaty of commerce made March 10, 1860. It must also be

[1] *Medicina mortuorum sera est.* (Quintil.)

[2] Annales de la Prop., tome x. p. 212.

considered that Peter Stubs can assure his rights, in the wise limits that the law has traced, by giving to the mark used by him in France a peculiarity of appearance that can suffice to prevent confusion between his products and those of other persons. He will then have obtained all the advantages that the said treaty intended for foreigners. — When we reflect upon this judgment and that one immediately preceding it, we come to the conclusion that the courts did not desire to countenance fraud in the slightest degree. The originally trustworthy marks had, through misfortune, — brought on indeed by piracy, — lost all power to indicate origin or ownership. By a slight modification of the device, a perfectly-valid trade-mark could be established. The public would know whose products they were purchasing, and the foreign manufacturers would reap the advantages legitimately belonging to them. We reach another conclusion: these two cases do not militate against the generally-accepted rules in abandonment cases.

§ 689. **Abandonment in one Country is Abandonment in all Countries.** — Commerce is not bounded by territorial limits. The whole of the habitable Globe is hers. It is true that the owner of a counterfeit mark may not have the means of pursuing pirates in foreign lands, but his rights remain undiminished. It is only the *remedy* that is lacking. Reprisals upon trade must continue in most countries until reciprocity of protection is guaranteed by treaties or conventions; but certainly it cannot be pretended that there is an abandonment when one has no possible opportunity of attack or defence. Our Government does not forfeit its exclusive right to certain proprietary marks, because they are counterfeited in Europe. It is a well-known fact that when an American merchant visits certain Belgian, German, and Swiss manufactories, he is asked what English maker's trade-mark he desires to have stamped upon his purchases. Doors, similar to those used by vendors of paper-hangings, are swung open, and all the trade-marks of British manufacturers are displayed by the shameless depredators.

The victims are well aware of this practice; but their hands are tied. They are strangers and foreigners, and have no standing in court, until enfranchised by treaty stipulations. Do they forfeit their rights by reason of mere lapse of time? No. There not being any intention to abandon their marks, it follows that their marks are not abandoned. Abandonment must be as broad as the domain of commerce. The converse of this proposition is that if one retain his right to a trade-mark in one country he retains it in all. If the trader were compelled to repel every assault upon his property, under pain of forfeiture of title to it, what would be the consequence? He would have to constantly be in a belligerent attitude, and to be ubiquitous. He would soon fall into the "Slough of Despond." Might would inevitably usurp the place of Right. Is he, then, not compellable to assert his right? Certainly he is, but only within reasonable limits. The law does not demand the performance of impossibilities. The wisdom of all nations attests the correctness of this idea.

§ 690. **Conclusion deduced from the Foregoing.** — The phrase "abandonment of a trade-mark" means an *intentional* discontinuance of it. The original proprietor may readopt it, unless in the mean time another person shall have lawfully possessed himself thereof; or unless the device shall have become a mere designation of quality or kind of product. In the latter case, the trade-mark is extinguished. If readopted, it has all its original force and vigor. If a trade-mark be purely personal in its nature, it cannot be appropriated by another by virtue of abandonment; for otherwise a false credit might be gained thereby.

§ 691. It may now be said of the subject of Abandonment, as of other matters preceding it in this book, — the natural resting-place has been reached. But the writer does not intend to abandon the study of this interesting branch of jurisprudence, — the Law of Trade-marks. The same inquiring spirit which has impelled his pen will watch the gradual completion of a

system that is yet in its infancy, the foundation of which is laid in the doctrines collected in these pages. At every step he has been cheered by additional light. Even Japan, by the lips and pen of one of her representatives, has furnished valuable information upon cognate subjects, although not in a shape available for our present purpose. From clear indications, we are justified in the belief that all civilized nations will soon unite in a harmonious code for the protection of the trade-mark, as the surest guaranty of universal commercial faith. In the mean time, beneath the touch of able jurists throughout the domain of Commerce, rough stones shall become as polished corners of the Temple, and present theories be permanently established in the intellectual superstructure.

APPENDIX.

TREATIES AND CONVENTIONS.

CONVENTION *between the United States and the Austro-Hungarian Empire. Proclaimed June* 1, 1872.

ARTICLE I.

Every reproduction of trade-marks which, in the countries or territories of the one of the contracting parties, are affixed to certain merchandise to prove its origin and quality, is forbidden in the countries or territories of the other of the contracting parties, and shall give to the injured party ground for such action or proceedings to prevent such reproduction, and to recover damages for the same, as may be authorized by the laws of the country in which the counterfeit is proven, just as if the plaintiff were a citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in the Austro-Hungarian Empire, or of citizens of the Austro-Hungarian Monarchy in the territory of the United States, cannot exist for a longer period than that fixed by the law of the country for its own citizens. If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the countries or territories of the other of the two contracting parties.

ARTICLE II.

If the owners of trade-marks, residing in the countries or territories of the one of the contracting parties, wish to secure their rights in the countries or territories of the other of the contracting parties, they must deposit duplicate copies of those marks in the Patent Office at Washington, and in the Chambers of Commerce and Trade in Vienna and Pesth.[1]

[1] See the note to Article II. of Convention with France.

ADDITIONAL ARTICLE *to the Treaty of Commerce and Navigation between the United States and Belgium, of July* 17, 1858. *Proclaimed July* 30, 1869.

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens of one of the two countries may wish to secure the right of property in the other, must be lodged, to wit: the marks of citizens of the United States at Brussels, in the office of the clerk of the Tribunal of Commerce; and the marks of Belgian citizens at the Patent Office in Washington.

CONVENTION *between the United States of America and France concerning Trade-marks. Proclaimed April* 16, 1869.

ARTICLE I.

Every reproduction in one of the two countries of trade-marks affixed in the other to certain merchandise to prove its origin and quality, is forbidden, and shall give ground for an action for damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven, just as if the plaintiff were a subject or citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in France, or of French subjects in the territory of the United States, cannot exist for a longer period than that fixed by the law of the country for its own citizens.

If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the other country.

ARTICLE II.

If the owners of trade-marks, residing in either of the two countries, wish to secure their rights in the other country, they must deposit duplicate copies of those marks in the Patent Office

at Washington,[1] and in the clerk's office of the Tribunal of Commerce of the Seine, at Paris.

CONVENTION *between the United States and the German Empire. Proclaimed June* 1, 1872.

ARTICLE XVII.

With regard to the marks or labels[2] of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade,[3] the citizens of Germany shall enjoy in the United States of America, and American citizens[4] shall enjoy in Germany, the same protection as native citizens.

ADDITIONAL ARTICLE *to the Treaty of Navigation and Commerce between the United States of America and the Emperor of Russia, of the* 18*th of December*, 1832. *Concluded and signed at Washington, January* 27, 1868.

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the

[1] Many errors have been committed in consequence of a misconception of the scope and meaning of the language of this article. The Commissioner of Patents, on the 6th of December, 1872, made a decision thereon of which the following is an extract: "That clearly means that a resident of this country wishing to secure protection for his trade-mark in France must give constructive notice to the people of that country, by depositing duplicate copies in the clerk's office of the Tribunal of Commerce of the Seine; and so of a resident of France, who is required to deposit his mark in this Office. So far as the tribunals of this country are concerned, the mere deposit of copies of a mark in this Office, by residents of this country, does not amount to registration. The Act of Congress of July 8, 1870, is the governing rule in the latter case" (Matter of Lanman & Kemp).

Before the passage of the Act of 1870, many residents of the United States deposited copies of their marks in the Patent Office. That was done without authority of law, and consequently no certificate of such deposit can be received in evidence. This is an important point.

[2] The use of this word must not be permitted to mislead into the idea that *labels* are technical trade-marks; for, as has been shown in the foregoing treatise, they are only mere vehicles for trade-marks.

[3] These five words mean trade-marks proper.

[4] Observe the broad term, which must be limited to citizens of the United States.

two countries of the trade-marks affixed in the other on merchandise to show its origin and quality, shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other, must be lodged exclusively, to wit: the marks of citizens of the United States in the Department of Manufactures and Inland Commerce at St. Petersburg, and the marks of Russian subjects at the Patent Office in Washington.

LAWS OF VARIOUS COUNTRIES.

AUSTRIAN LAW OF DECEMBER 7, 1858.

I. *General Provisions.*

ART. 1. — Under the name of trade-marks are understood, in the present law, the particular signs serving to distinguish in commerce the products and the merchandise of one manufacturer from the products and merchandise of another (emblems, ciphers, vignettes, &c., constituting such signs).

ART. 2. — When a manufacturer desires to secure the exclusive use of a trade-mark, he must register it, conformably to the provisions of the following chapter.

ART. 3. — A person cannot obtain an exclusive right to marks consisting of signs in general use in commerce for particular merchandise, nor to marks which consist only of letters, words, or numerals, nor of the arms of the State or of its provinces.

ART. 4. — The exclusive right to a trade-mark only prohibits other manufacturers from the right to use the same mark on the species of merchandise belonging to the production or objects of commerce and industry to which the protected mark has been appropriated.

ART. 5. — The right to an exclusive mark is inherent in the industrial enterprise to which the mark is attached. This right is extinguished with the enterprise. A change of the enterprise changes also the proprietorship. In this case, however, the new

proprietor is obliged to have within three months the mark transcribed in his name under penalty of forfeiture, except always in a case where the manufacture shall be continued by the widow or a minor heir of a manufacturer, or on account of an estate in succession or in bankruptcy.

ART. 6. — No person shall arbitrarily take the name, the firm-title, nor the escutcheon or denomination of another manufacturer or native, to designate merchandise or products.

ART. 7. — All that is stated in the present law in regard to trade-marks shall apply equally to marks borne on packages, boxes, vases, envelopes, &c.

ART. 8. — The present law does not change any of the provisions in regard to particular marks ordained for certain classes of merchandise, especially the provisions as to stamping.

II. *Registration of Marks.*

ART. 9. — The mark of which a manufacturer desires to secure the exclusive right (art. 2) must be deposited in duplicate at the Chamber of Commerce and Industry of the district in which his manufactory is situate and carried on. One of the copies shall remain on deposit at the Chamber of Commerce and Industry, and be attached to the register of inscription; the other is returned to the depositor furnished with the statements designated in the following article.

ART. 10. — On each of the two copies the employé or functionary appointed for the purpose by the Chamber of Commerce and Industry shall write: — *a*, the number of the order of registry; *b*, the day and hour of presentation; *c*, the name of him for whom the mark has been registered; *d*, the designation of the commercial enterprise to which the work is appropriated; — to which he shall affix his signature and seal of office.

ART. 11. — The registration is subject to a tax of 10 florins, which shall be paid into the fund of the Chamber of Commerce and Industry.

ART. 12. — From the day and the hour of the presentation of the mark at the Chamber of Commerce and Industry commences the right of the depositor to the exclusive use of the mark, and it is as of this period that his right of priority shall be judged, in case the same mark shall be deposited by another person in the same Chamber or in other Chambers of Commerce and Industry.

ART. 13. — To obtain the transcription of the right to a mark, in the sense of article 5, the applicant must present the proof of

acquisition of title to the industrial enterprise in question. The transcript is subject to the same tax as the first registration.

ART. 14.—The Chamber of Commerce and Industry shall always keep the register of marks open to the inspection of the public.

III. *Usurpations, Contraventions, and Penalties.*

ART. 15.—Every usurpation of right to a mark, whether by reason of unlawful appropriation or the counterfeiting of a mark for the sale of merchandise bearing the spurious mark, shall give the right to the injured party to demand the final cessation of unlawful use of said mark, and its suppression on merchandise invested therewith and intended for sale. The injured party may also demand the destruction of instruments and appliances used exclusively or principally to counterfeit said mark. The right of the injured party to recover damages for the harm suffered in consequence of the usurpation of his right to the mark shall be adjudged according to the provisions of the civil code.

ART. 16.—It is counterfeiting when the marks in question cannot be distinguished one from the other without requiring an inspection more keen than ordinary.

ART. 17.—The provisions contained in article 15 are also applicable against those—*a*, who illegally appropriate the name, the firm-title, the escutcheon, or particular denomination of the commercial establishment of an industrial centre or producer, to designate merchandise intended for sale; and those— *b*, who expose for sale products or merchandise marked with an interdicted sign of this nature.

ART. 18.—If the usurpation (arts. 15 and 17) has been knowingly committed, the wrong-doer is amenable to damages in from 25 to 500 florins, independently of the penalties which may have been pronounced against him, according to the provisions of the general penal code.

ART. 19.—In case of repetition of the offence, the penalty shall be doubled. In case of further repetition, the wrong-doer shall be amenable, independently of damages, to an imprisonment of from one week to three months.

ART. 20.—If the fine should be such as might too sensibly affect the pecuniary means of the condemned, or exhaust the resources needed by him for the subsistence of himself and family, or hinder him from satisfying the judgment for damages, the fine shall be converted into an imprisonment of one day for each sum of 5 florins.

ART. 21. — The judge of the misdemeanor may also order the judgment to be made public.

ART. 22. — The amount of fines shall go into the funds of the poor of the place where the wrongful act shall have been committed.

IV. *On Authorities and Mode of Procedure;* and V. *On Transitory Provisions,* are not of general interest.

BAVARIA.

In Bavaria, a law of March 5, 1840, regulates property in trade-marks, labels, &c. From the time of the passage of that law the mark has not been obligatory, but may consist of the name of the fabricant, accompanied by the indication of his place of manufacture; or in any emblem whatever.

To secure the exclusive property in the mark chosen by him, the manufacturer must make before the police authorities of his district a declaration of the mark adopted by him, and deposit a representation and one copy of it. This declaration is to be inscribed in a special register, and a certificate delivered to the declarant. This register is public, so that all may take notice of it.

The punishment for counterfeiting is a fine of from 10 to 50 florins, doubled for a second offence, besides temporary or final suspension from the manufacturing or other industry of the counterfeiter, according to circumstances. This is in addition to damages to the party injured.

This law is applicable to foreign trade-marks and firm-names, always upon the condition that the owners affix to their products their names and places of domicile, or make the declaration or deposit with the police authorities in one of the districts of the Kingdom of Bavaria, — *Provided* the same protection shall be accorded and assured to Bavarians in the country of the foreign manufacturer.

BELGIUM.

The French legislative rules still govern in the matter of trade-marks. Thus there are still in vigor the decrees of 1801 relative to hardware and cutlery; the law of 1803 relative to manufactures, fabrics, and workshops; the imperial decree of 1810 containing provisions for the suppression of the counterfeiting of trade-marks on hardware and cutlery; and the imperial decree of 1809 relating to the *conseils de prud'hommes.*

To the said laws are added the royal decree of 1818 relative to marks of makers of pipes, and that of 1820 concerning manufacture of cloths. The pipes, their labels, boxes, &c., are to bear the print of the arms of the city or commune where made. All kinds of cloths composed wholly or in part of wool are to bear labels announcing their national origin. The counterfeiting of the said marks is to be punished as stated in the laws.

Property in labels, signs, and names of merchants is not protected in Belgium by any special law; the principles of the common law being alone applicable to the repression of usurpation of this kind of property.

CANADA.

"An Act to amend the law relating to the Fraudulent Marking of Merchandise," which took effect on the first day of September, 1872, is very similar to the British Act of 1862.

Under the Act respecting Trade-marks, &c., of 1868, it is provided that "all marks, names, brands, labels, packages, or other business devices, which may be adopted for use by any person in his trade, business, occupation, or calling, for the purpose of distinguishing any manufacture, product, or article of any description by him manufactured, produced, compounded, packed, or offered for sale, no matter how applied," &c., &c., may be registered; and timber and lumber upon which labor has been expended are deemed manufactures.

The owner of the mark may petition for the cancellation thereof. The mark may be assigned. In case of interference of an application with a mark already registered, the Minister of Agriculture shall examine witnesses for the purpose of establishing the ownership, and may order entry or cancellation, or both.

The proprietor of a mark may have the same registered by depositing with the Minister of Agriculture a drawing and description in duplicate of such mark, together with a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof. It shall then be examined, and if not identical with or closely resembling any registered mark, it shall be registered, and a certified copy of the drawing and description be returned to the proprietor. The certificate of the Minister or of his Deputy shall state the day, month, and year of the entry in the "Trade-mark Register;" and such certificates shall be evidence of the facts therein alleged.

DENMARK.

The counterfeiting of trade-marks or of stamps is punishable by the ordinance of 1840, with imprisonment not exceeding four years, or in minor cases with fines.

ENGLISH "MERCHANDISE MARKS ACT" OF 1862.[1]

Construction of Words.

1. In the construction of this act the word "person" shall include any person, whether a subject of Her Majesty or not, and any body corporate or body of the like nature, whether constituted according to the law of this country or of any of Her Majesty's colonies or dominions, or according to the law of any foreign country, and also any company, association, or society of persons, whether the members thereof be subjects of Her Majesty or not, or some of such persons subjects of Her Majesty and some of them not, and whether such body corporate, body of the like nature, company, association, or society be established or carry on business within Her Majesty's dominions or elsewhere, or partly within Her Majesty's dominions and partly elsewhere; the word "mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other of any other description; and the expression "trade-mark" shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or any other mark as aforesaid lawfully used by any person to denote any chattel, or (in Scotland) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark, or sign which, in pursuance of any statute or statutes for the time being in force relating to registered designs, is to be put or

[1] This Act embraces not only technical "trade-marks," but also all other kinds of "marks" for goods. It contains no provision for registration. Mr. Roebuck, the chairman of the committee of the House of Commons having the matter in charge, moved "That a system of registration of trade-marks be adopted in this bill." The motion was put and lost. The Cutler's Company of Sheffield register trade-marks for cutlery made in a small district. Many manufacturers enter their marks at Stationers' Hall, under a supposed authority of the copyright law. It is difficult to conceive what legal benefit can be derived from such entry, beyond fixing a date of claim.

placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes or any of them; the word "misdemeanor" shall include crime and offence in Scotland; and the word "court" shall include any sheriff or sheriff-substitute in Scotland.

Forging a Trade-mark or falsely applying any Trade-mark with intent to defraud, a Misdemeanor.

2. Every person (&c. &c.) so committing a misdemeanor shall also forfeit to Her Majesty every chattel and article belonging to such person to which he shall have so unlawfully applied, or caused or procured to be applied, any such trade-mark or forged or counterfeited trade-mark as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade-mark, or forged or counterfeited trade-mark as aforesaid, shall have been so applied, and every instrument in the possession or power of such person for applying any such trade-mark or forged or counterfeit trade-mark as aforesaid, shall be forfeited to Her Majesty; and the court before which any such misdemeanor shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such court shall think fit.

Applying a forged Trade-mark to any Vessel, Case, Wrapper, &c., in or with which any Article is sold or intended to be sold, a Misdemeanor.

3. (This title sufficiently expresses the subject.)

Selling Articles with forged or false Trade-marks after 31*st December*, 1863, *Penalty equal to alue of Article sold, and a sum not exceeding* 5*l. nor less than* 10*s.*

4. (For the present purpose this is sufficiently expressed in the title.)

Additions to and Alterations of Trade-marks made with intent to defraud to be deemed Forgeries.

5. (Every addition, alteration, or imitation, with intent to defraud, included.)

Any Person who, after 31*st December*, 1863, *shall have sold an Article having a false Trade-mark to be bound to give Information where he procured it. Power to Justices to Summon Parties refusing to give Information. Penalty for Refusal*, 5*l.*

6. (For the present purpose this is sufficiently expressed in the title.)

Marking any false Indication of Quantity, &c., upon an Article with intent to defraud, Penalty, a sum equal to the value of the Article and the further sum not exceeding 5*l.*, *and not less than* 10*s.*

7. (The same may be said of this.)

Selling or exposing for Sale after the 31*st December*, 1863, *Articles with false Statement of Quantities, &c., Penalty not more than* 5*l. or less than* 5*s.*

8. (Sufficient for present purposes.)

Proviso that it shall not be an Offence to apply Names or Words known to be used for indicating particular Classes of Manufactures.

9. (Sufficient for present purposes.)

Description of Trade-marks and forged Trade-marks in Indictments, &c.

10. In every indictment, pleading, proceeding, and document whatsoever in which any trade-mark shall be intended to be mentioned, it shall be sufficient to mention or state the same to be a trade-mark without further or otherwise describing such trade-mark, or setting forth any copy or fac-simile thereof; and in every indictment, pleading, proceeding, and document whatsoever in which it shall be intended to mention any forged or counterfeit trade-mark, it shall be sufficient to mention or state the same to be a forged or counterfeit trade-mark without further or otherwise describing such forged or counterfeit trade-mark, or setting forth any copy or fac-simile thereof.

Conviction not to affect any Right or Civil Remedy.

11. The provisions in this act contained of or concerning any act, or any proceeding, judgment, or conviction for any act hereby declared to be a misdemeanor or offence, shall not, nor shall any of them take away, diminish, or prejudicially affect any suit, process, proceeding, right, or remedy which any person aggrieved by such act may be entitled to at law, in equity, or otherwise, and shall not, nor shall any of them exempt or excuse any person from answering or making discovery upon examination as a witness or upon interrogatories, or otherwise, in any suit or other civil proceeding: Provided always, that no evidence, statement, or discovery

which any person shall be compelled to give or make shall be admissible in evidence against such person in support of any indictment for a misdemeanor at common law or otherwise, or of any proceeding under the provisions of this Act.

Intent to defraud, &c., any particular Person need not be alleged in an Indictment, &c., or proved.

12. (Sufficient for present purpose.)

Persons who aid in the Commission of a Misdemeanor to be also guilty.

13. (Sufficiently expressed.)

Punishment for Misdemeanor under this Act.

14. Imprisonment for not more than two years, with or without hard labor, or by fine, or both by imprisonment with or without hard labor and fine, and also by imprisonment until the fine (if any) shall have been paid and satisfied.

Recovery of Penalties.

15. (This provides for summary proceedings, &c.)

Summary Proceedings before Justices to be within 11 *and* 12 *Vict. c.* 43.

16. (Sufficient for present purpose.)

In Actions Penalties to be accounted for in like Manner as other Moneys payable to the Crown, and Plaintiff's to recover full Costs of Suit.

17. (Sufficient for present purpose.)

Limitations of Actions, &c.

18. Three years next after the committing of the offence, or one year next after the first discovery thereof by the person proceeding.

After 31*st December*, 1863, *Vendor of an Article with a Trade-mark to be deemed to contract that the Mark is genuine.*

19. (Sufficient for present purpose.)

After the 31*st December*, 1863, *Vendor of an Article with Description upon it of its Quantity to be deemed to contract that the Description was true.*

20. (Sufficient for present purpose.)

In Suits at Law or in Equity against Persons for using forged Trade-marks, Court may order Article to be destroyed, and may award Injunction, &c.

21. (Sufficient for present purpose.)

Persons aggrieved by Forgeries may recover Damages against the guilty Parties.

22. (Sufficient for present purpose.)

Defendant obtaining a Verdict to have full Indemnity for Costs.

23. (. . . "Unless the court or a judge thereof shall direct that costs of the ordinary amount only shall be allowed.")

A Plaintiff suing for a Penalty may be compelled to give Security for Costs.

24. (Sufficient for present purpose.)

Act not to affect the Corporation of Cutlers of Hallamshire nor to repeal 59 *G.* 3, *c.* 7.

25. (Sufficient for present purpose.)

Short Title.

26. The expression "The Merchandise Marks Act, 1862," shall be a sufficient description of this act.

FRENCH LAW OF JUNE 23, 1857.

Title I. — *Of the Right of Property in Marks.*

Art. 1. — The mark of manufacture and commerce is optional. Decrees rendered in the form of regulations of public administration can always, except in certain cases, declare marks to be obligatory for the products that they specify. As marks of manufacture and of commerce, shall be considered names under a distinctive form, denominations, emblems, imprints, stamps, stamped tickets, vignettes, reliefs, letters, ciphers, envelopes, and all other signs serving to distinguish the products of a manufacturer and the objects of a commerce.

Art. 2. — No one can claim the exclusive property of a mark, unless he shall have deposited two fac-similes thereof with the clerk of the Tribunal of Commerce of his domicile.

Art. 3. — The deposit has effect but for fifteen years. The property in a mark may always be protected for a new term of fifteen years by means of a new deposit.

ART. 4.—Besides the charge for stamp and of registration, there is a legal charge fixed at one franc for the drawing-up of the entry of each mark and for the cost of proceeding.

TITLE II.—*Dispositions Relative to Foreigners.*

ART. 5.—Foreigners who possess in France establishments of manufacture and commerce, enjoy for the products of their establishments the benefit of the present law upon fulfilling the formalities that it prescribes.

ART. 6.—Foreigners and the French whose establishments are situated outside of France, shall equally enjoy the benefit of the present law for the products of their establishments, if, in the countries where they are situated diplomatic conventions have established reciprocity for French marks. In this case, the deposit of foreign marks shall take place with the clerk of the Tribunal of Commerce of the department of the Seine.

TITLE III.—*Penalties.*

ART. 7.—The punishment shall be a fine of from 50 to 3000 francs, and with imprisonment of from three months to three years, or of one of these penalties only:—

1st. For such as shall have counterfeited a mark or made use of a counterfeit mark;

2d. For such as shall fraudulently affix to their products or the objects of their commerce a mark belonging to another;

3d. For such as shall have knowingly sold or exposed for sale one product or more than one product invested with a false mark fraudulently imitative or bearing indications tending to deceive the purchaser as to the nature of the product.

ART. 9.—They shall be punished with a fine of from 50 to 1000 francs, and with imprisonment of from fifteen days to six months, or with one or the other of such penalties:—

1st. Who shall not have affixed to their products a mark declared to be obligatory;

2d. Who shall have sold or exposed for sale one product or more than one product not bearing the obligatory mark for that species of product;

3d. Who shall have contravened the provisions rendered in execution of article 1st of the present law.

ART. 10.—The penalties established by the present law are not cumulative.

The heavier penalties are only to be pronounced for acts done anterior to the first act of pursuit.

ART. 11. — The penalties prescribed by articles 7, 8, and 9 may be increased to double in case of repetition of the offence. It is such repetition when within the five years anterior a condemnation shall have been pronounced against the prisoner for one of the misdemeanors provided for in the present law.

ART. 12. — Article 453 of the penal code shall apply to the misdemeanors under the present law.

ART. 13. — Besides, offenders may be deprived of the right of participating in election of Tribunals and of Chambers of Commerce, of Consulting Chambers of Arts and Manufactures, and of Councils of Selectmen, for a term not exceeding ten years.

The Tribunal may order the posting-up of the judgment in places to be determined, and its insertion in full in newspapers to be designated by it; the whole at the cost of the condemned.

ART. 14. — The confiscation of products recognized as contrary to the provisions of articles 7 and 8, even in cases of acquittal, may be pronounced by the Tribunal, besides the apparatus which especially served for the commission of the wrong.

The Tribunal may order that confiscated products shall be delivered to the owner of the mark counterfeited, or fraudulently affixed, or imitated, independent of, and in addition to ample damages that may have been given.

It shall prescribe, in all cases, the marks adjudged to be counterfeited contrary to the provision of articles 7 and 8.

ART. 15. — In the cases premised in the first two paragraphs of article 9, the Tribunal shall prescribe always that the marks declared to be obligatory shall be affixed to the products subject thereto.

The Tribunal may pronounce the confiscation of products, if the prisoner shall have undergone during the five last preceding years a condemnation for one of the misdemeanors provided in the first two paragraphs of article 9.

TITLE IV.

ART. 16. — Civil actions relative to marks are brought before the civil tribunals and judged as summary matters. (The remainder of this title relates to the mode of procedure. Title V., which contains the remaining part of the Act, relates to general and transitory matters, as, for example, the seizure and condemnation of foreign merchandise falsely bearing either the mark or the name of a resident of France; and other subjects of but local interest.)

HOLLAND.

There is no especial law on the subject of protection of trade-marks and stamps; but the infringement or counterfeiting thereof is punished by the ordinary penal code.

PRUSSIA.

Legislative enactments protect trade-marks and manufacturers' names. Whoever shall put a mark upon merchandise or the envelopes thereof bearing the name, firm-title, or domicile of another manufacturer, or who knowingly shall commit to commerce merchandise bearing false marks, is punished by a fine of from 50 to 1000 dollars, and, in addition thereto, with imprisonment of one year or more, according to circumstances. These penalties are equally applicable when a Prussian shall counterfeit the mark of a foreigner, but only when international treaties or the laws of such foreigner's country shall guaranty reciprocity to Prussian subjects.

ROME.

There exist in what were lately the Pontifical Dominions two kinds of marks: 1st, the mark affixed to objects made by the Government; 2d, the private mark placed by each manufacturer upon his products. This latter mark is not obligatory, and fabrics bearing such private mark need not the official stamp to indicate the origin of the goods. However, some kinds of fabrics bear the Government stamp.

Woollen and cotton cloths have attached to the weft a leaden seal; and certain tissues and skins, presented at the Custom-house, accompanied by a certificate of the commercial authority, are furnished by the Government officials with a leaden stamp, as a guaranty of nationality.

RUSSIA.

Trade-marks are not obligatory; but stamped products enjoy very notable advantages. Thus, these products are not confiscated when found united to foreign merchandise not provided with a customs-stamp; and when these products are reimported into Russia, they enter free of custom-house duty.

The originator of a new product must, if he wish to stamp such product, make a declaration at the Department of Manufactures, and deposit a copy of his mark, indicating his full name and his

place of manufacture. If the proprietor transfer his place of business, he should instruct the said Department, which may direct the stamp to be changed.

The fraudulent application upon Russian products of marks belonging to other makers is punished as counterfeiting, and the merchandise falsely marked is delivered over to the one whose mark has been simulated. If Russian marks are affixed to foreign goods, the said goods are confiscated, and the wrong-doer fined. The consequences are the same if Russian products are invested with false seals imitating those of the Customs, with the fraudulent intent that the same shall be accepted as products of foreign origin.

SARDINIA.

The trade-mark has been obligatory ever since the year 1725. By a royal edict of 1733 each manufacturer and dyer of woollen stuffs was obliged to affix to his fabrics a mark, a representation of which was to be deposited with the secretary of his district. For any violation of the right of mark, a fine was to be imposed and the merchandise marked with the false mark confiscated. More recent legislation has imposed new obligations on manufactures of tissues.

SAXONY.

Trade-marks are not obligatory. The manufacturer whose mark has been counterfeited may obtain legal redress. But although the mark is not obligatory, yet where Saxon products are to be exported to certain countries, especially America, they must be accompanied with a certificate of origin.

SPAIN.

The mark is obligatory upon cloths only: such is the regulation of 1832. Thereby the manufacturers were obliged to mark their cloths according to the degrees of quality, first, second, or third.

WIRTEMBERG.

By the general regulation of 1836, each manufacturer is obliged to affix to his products a mark of his name and device. An impression of this mark must be deposited with a Government official. Simulation of marks is punished as counterfeiting.

PATENT OFFICE FORMS.

APPLICATION FOR REGISTRATION.

PETITION.

1. By a Sole Applicant.

To the Commissioner of Patents:

Your petitioner respectfully represents that he is domiciled[1] in the United States, and is engaged in the manufacture and sale of [melodeons] at [the city of New York, N. Y.], and that he is entitled to the exclusive use upon said class of merchandise of the trade-mark described in the specification hereto annexed, and shown in the fac-similes to be herewith filed.

He therefore prays that said trade-mark may be registered and recorded in the Patent Office, in accordance with law.

[Henry H. Bradley.]

2. By a Partnership.

To the Commissioner of Patents:

Your petitioners respectfully represent that they constitute the firm of [Scott, Newman, & Co.], domiciled in [the United States], and engaged in the manufacture and sale of [cotton-sheetings] at [Fall River, Massachusetts]; and that, as said firm, they are entitled to the exclusive use, upon said class of merchandise, of the trade-mark described in the specification hereto annexed, and shown in the fac-similes to be herewith filed.

They therefore pray that said trade-mark may be registered and recorded in the Patent Office, in accordance with law.

[Scott, Newman, & Co.,
By Martin Scott, *a member of the firm.*]

[1] The statute reads: "any person or firm *domiciled* in the United States." Domicile, in certain cases, being an essential prerequisite to registration, should be averred.

3. By a Corporation.

To the Commissioner of Patents:

Your petitioner, a corporation created by authority of [section 4 of chapter 80 of the Acts of Congress of 1870 [1]], respectfully represents, that it is engaged in the manufacture and sale of [boots and shoes] at [Washington, District of Columbia]; and that it is entitled to the exclusive use, upon said class of merchandise, of the trade-mark described in the specification hereto annexed, and shown in the fac-similes to be herewith filed.

It is therefore prayed that said trade-mark may be registered and recorded in the Patent Office, in accordance with law.

[Washington City Boot and Shoe
[L. S.] Manufacturing Company,
By Robert Ball, *President.*[2]]

Petition with Power of Attorney.

To the Commissioner of Patents:

Your Petitioner [*&c., as in the foregoing forms, to the end of the prayer, and then continue*]; and he hereby appoints Solomon Sharp, of the city New York, N. Y., as his attorney in the presentation and prosecution of this application, to make the necessary amendments thereto, and to receive the certificate of registration.[3]

[*Name.*]

Specification.

Specification of a trade-mark used by [Scott, Newman, & Co.], of Fall River, Massachusetts, for cotton-sheetings.

[Our] trade-mark consists of a [crescent-shaped symbol and the word "Excelsior." These have been and are generally arranged, as shown in the accompanying drawing, above and below the fig-

[1] Or of any other authority of the United States, or of any State or Territory thereof, as the case may be. Or if the corporation be located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States (sec. 77, Act of 1870), the form may be thus: "a corporation located in the city of Paris, in the Republic of France," &c.

[2] Or any other officer of the corporation (sec. 77, Act of 1870).

[3] The signature of the applicant is sufficient to authenticate this instrument, without its being acknowledged before a public officer.

ure of a man represented as ascending the side of a mountain and carrying a banner, upon which is inscribed the word "Excelsior;" and the whole inclosed within an ornamental border, substantially like that shown in the drawing. But the figure of the man with the banner may be omitted, or some other device substituted for it, and the border may be changed at pleasure, or omitted altogether, without materially changing the character of our trade-mark, the two essential features of which are the crescent-shaped symbol and the word "Excelsior"].

This trade-mark we have used in our business for [ten years last past. The particular goods upon which we have used, and still use it, are made of cotton, and known as "sheetings;" and we are accustomed to print it, in blue ink, upon the outside of each piece of the manufactured goods. We have also printed it upon labels, which have afterward been pasted upon the separate pieces of sheetings, and also placed upon the outside of the cases in which the goods have been packed.

SCOTT, NEWMAN, & CO.,
By MARTIN SCOTT, *a member of the firm.*]

Witnesses:

Benjamin F. Lloyd,
Merwin Hallibow.

AFFIDAVIT UPON APPLICATION FOR REGISTRATION OF A TRADE-MARK.

[Commonwealth of Massachusetts,[1]
County of Franklin. } ss.]

Personally appeared before me, a [justice of the peace],[2] the above-named [Martin Scott], who, being duly sworn, deposes and says that [he is a member of the firm of Scott, Newman, & Co., above named]; that [said firm] has the right to the use of the trade-mark described in the foregoing specification, and 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; and that the description and the

[1] Or State of New York, or Territory of Idaho, or Kingdom of Spain, as the case may be.

[2] As to the various officers before whom an oath may be taken for this purpose, see § 321. See, also, as to the proper official seal of a notary public.

fac-similes presented for record truly represent the trade-mark sought to be protected; that the statements in the petition and specification are true; that he resides in [Boston], and all the other members of the firm reside at [Fall River, in said Commonwealth]; and that they are all domiciled [1] in [the United States and are citizens [2] thereof].

[MARTIN SCOTT.]

Sworn to and subscribed before me this [15th day of July, 1870].

[JOHN JURAT,
Justice of the Peace.]

AMENDMENT.

To the Commissioner of Patents:

In the matter of my application for registration of a trade-mark for melodeons, filed on the 18th day of September, 1872, I hereby amend my specification by striking out all between the tenth and thirteenth lines, inclusive, on page 1; by inserting after line nineteen on page 2 the words, "This trade-mark I have used in my business for seventeen years last past;" and by substituting the word "gilded" for "branded" in the last paragraph.[3]

HENRY H. BRADLEY.

APPEAL OF APPLICANT.[4]

To the Commissioner of Patents:

SIR, — I hereby appeal to you in person from the decision of the Examiner of Trade-marks, dated November 15, 1872, in the matter of my application for the registration of a trade-mark for cigars. The following are assigned as reasons of appeal: —

[1] Domicile need not be stated when the applicant is a non-resident of the United States. (See § 287–296, as to the commercial character imparted to one engaged in commerce abroad.) In such case, the place of residence in a foreign country must be stated.

[2] Or is a citizen of the republic of Mexico, or a subject of the Queen of Great Britain, &c., &c.

[3] This amendment involves the necessity of a new affidavit; for the specification is materially changed by the allegation of an additional fact, as to the length of time the mark has been used.

[4] This form may readily be adapted to the case of a partnership, or of a corporation. The appellant may set forth as many reasons as suggest themselves to his mind. This appeal being in the nature of a rehearing, no fee is required therefor.

1st. The Examiner erred, in holding that my residence in the island of Cuba at the time of application debarred me from the benefits of the Act of Congress approved July 8, 1870, in relation to the registration of trade-marks, inasmuch as, by his own admission and by the evidence filed by me, it is clearly shown that I was then a citizen of the United States.[1]

2d. He erred, in holding that the words "Improved and Excellent" do not constitute a lawful trade-mark.[2]

3d. He erred, in holding that a statement of the length of time the said trade-mark had been used by me is an essential requisite.[3]

4th. He erred, in (&c. &c.).

[LEMUEL STONE.]

TRANSFER OF A TRADE-MARK.[4]

We, Jotham Mills and Abner Clark, of Keokuk, Iowa, partners under the firm name of Mills & Clark, in consideration of five hundred dollars to us paid by Jarvis Case, of the same place, do hereby sell, assign, and transfer to the said Jarvis Case and his assigns the exclusive right to use in the manufacture and sale of stoves a certain trade-mark for stoves the description and fac-similes of which trade-mark were duly deposited by us in the United States Patent Office, and recorded therein; the same to be held, enjoyed, and used by the said Jarvis Case as fully and entirely as the same would have been held and enjoyed by us if this transfer had not been made.

Witness our hands this 20th day of December, 1872.

[JOTHAM MILLS,
ABNER CLARK.]

NOTICE OF PRELIMINARY INTERFERENCE.

DEPARTMENT OF THE INTERIOR,
U. S. PATENT OFFICE,
Washington, D. C., , 187 .

W. T. P. & C. McC., doing business as firm of P. & McC., Baltimore, Md.

Please find below a copy of a communication from the Trade-

[1] See §§ 290, 291, 295, *ante*. [2] See § 276, *ante*. [3] See § 316, *ante*.

[4] The assignment of an abstract symbol as a trade-mark is not within the range of legal possibility (see § 361). Therefore, unless the purported assignors had actually reduced the thing to possession, by affixing it as their trade-mark to the stoves sold by them, they had no title to convey, and this so called transfer is a nullity in law.

mark Examiner, concerning your application for registration of a trade-mark for whiskey, filed on the day of , 187 .

Very respectfully,

[M. D. LEGGETT, *Commissioner.*]

Room No. 10.

In the matter of the alleged trade-mark above referred to, notice is hereby given that in the particulars hereinafter named, another party claims to be the first and original adoptor, and that the question of priority will be determined in conformity with the rules and regulations for the conduct of interferences, a copy of which will be found inclosed.[1]

The preliminary statement (analogous to that called for by rule 53) must be filed on or before the day of , 187 . This statement must be sealed up before filing (to be opened only by the Trade-mark Examiner), and the name of the party filing it, and the subject, be indicated on the envelope.

In case the party who was first to make application for registration *alone file a statement, no testimony will be required,* but priority of adoption will be awarded to him. In default of such filing by the earlier applicant, and the other applicant do file the required statement, no testimony will be received from the former going to prove the date of his adoption prior to the earliest date of adoption alleged in his application for registration. In the event of neither party filing a statement, a decision will be rendered in favor of the party who was *first to file application.*

The subject-matter involved is the symbol of a crescent in combination with the word "Crescent," as a trade-mark for whiskey.[2]

[1] It is not necessary to recite these in full in this place. See the chapter on Interferences, *ante.*

[2] A copy of this notice is sent by the Office to each party. — Unless it be intended to let the case go by default, or to rely entirely upon the record made by the respective applications, the next step in order is to follow the foregoing instructions.

Great particularity should be observed in wording the statement, as the result may depend upon its expressions. The facts should be tersely narrated; care being taken, however, while avoiding the Scylla of prolixity not to perish by the Charybdis of a lack of perspicuity. Bear this in mind: while the preliminary statement can never be used as evidence on behalf of the party making it, it may be used as evidence against him.

The examples following may be taken as fair precedents. Truth is more necessary than form.

Preliminary Statement.[1]

To the Commissioner of Patents:

In compliance with the requirement of official notice of October 2, 1872, and in furtherance of our claim of right to registration of our trade-mark, we make this preliminary statement.

We commenced business in the city of Baltimore, Md., on the first day of October, 1867, as wholesale and retail dealers in liquors, and as rectifiers and compounders of the same. In the course of a few weeks thereafter we found that it would be beneficial to our interests to adopt some mark or brand to apply to a particular quality of rye-whiskey of our manufacture. It was important for us to adopt such a mark as should distinguish our article of manufacture from that of others in the market, as a protection from encroachment, and to secure to us the benefits of reputation in the profits arising therefrom. We tried to devise a mark which should not be like nor resemble any other in use for the same class of merchandise, and finally, on or about the first day of January, 1868, adopted that for which we now claim the right of registration.

We were induced to adopt the device of the word "Crescent" and the symbol of a crescent from these facts: the distillery where our whiskey was manufactured is located at Canton, in the extreme eastern and a growing section of the city; and the whiskey itself was increasing in favor and general use. These facts suggested to us the symbol of the East — the crescent — which signifies, to increase. We adopted it in conjunction with its name. We conceived the idea that these two things would be a suitable designation for our commodity; so, after making diligent and thorough inquiry in this and other cities, and in every possible way, to learn whether it was like any other brand in the market, or bore a near resemblance thereto, and finding that it did not, we concluded to adopt it. This we accordingly did on or about the first day of January, 1868, and having had a stencil-plate cut (the same stencil-plate which we are now using, and which was employed in making the fac-similes filed with our application for registration), we commenced at once to affix the same to our goods. This we did by stencilling the heads of the barrels containing our whiskey.

[1] Form is not of so much consequence as substance. Let circumstances be stated, so that from the detail of simple facts deductions may be made by the Office. Great care should be taken to state all matters bearing upon the issue. Too much conciseness must lead to obscurity; and obscurity may possibly be attributed to a lack of honesty.

We were the first to use the said mark to designate said class of merchandise, and we have never abandoned it, nor permitted any other manufacturer or vendor to make use of it, all which we are fully prepared to prove.

[*Signatures.*]

State of Maryland, }
City of Baltimore. } ss.

On this 7th day of October, 1872, before me, the undersigned, a justice of the peace [*or other officer, as the case may be*], personally appeared the above-named William T. P—— and Charles McC——, and made oath in due form of law to the truth of the foregoing statement by them subscribed.

[*Signature of officer and title of office.*[1]]

(*Another precedent of a Preliminary Statement in the same case.*)

To the Commissioner of Patents:

In regard to the application filed by us, for registration of a trade-mark, we state as follows:—

At about the time we commenced building our distillery, we requested Emmart & Quartley, of the city of Baltimore, to execute some design for us that would answer for a name for our place, and also for our trade-mark. During the early part of March, 1872, a sketch was made, which, meeting with our approval, was placed in the hands of an artist, to be colored. May 1st, it was given to the engraver, who at once prepared the plates, and upon their completion, and the printing of the copies, we applied for registration. By the testimony of A. D. Emmart and A. Quartley we can prove that the design is original[2] with us, and was chosen by us on account of the situation of our property, we not knowing at the time that any one had ever thought of it. The name "Crescent" and its symbol is the designation of our distillery. We propose[3]

[1] If a notary public, or clerk of a court, he should affix his official seal.

[2] The question is not, Who originated the design? but, Who first affixed it as a mark to merchandise? It is referred to here as a circumstance to support the parties' statement. See the case of Schrauder *v.* Beresford & Co., in the chapter on Interferences, as to origin of design.

[3] This is a fatal admission. Although the persons making this statement were actually the senior applicants for registration, they show conclusively that they did not consummate their purpose, *i.e.*, did not make the device a trade-mark by affixing it to merchandise. Their adversaries show that they did stencil the mark upon their barrels containing the product of their manufacture.

to use the mark on all rye-whiskey made by us. For the exact dates of the conception and execution of the different stages of the work, we can produce the testimony of the persons engaged by us for that object, as before stated. [*Finish substantially as in the foregoing precedent.*]

Notice of Interference.

Department of the Interior,
U. S. patent office.
Washington, D. C., , 187 .

[*Name of party to whom addressed.*]

Please find below a copy of a communication from the Trade-mark Examiner, concerning your application for registration of a trade-mark for whiskey, filed on the day of , 187 .

Very respectfully,
[M. D. Leggett, *Commissioner.*]

Room No. 10.

The parties hereinafter named are hereby notified that their claims to exclusive use of a trade-mark specified in Office letter of the [27th of June, 1872], are adjudged to interfere with each other, and that a hearing will be granted them on the [21st] day of [October, 1872].

The testimony of the respective parties must be closed previous to the dates hereinafter designated.

Rebutting testimony, but no other, may be taken after the closing of the testimony-in-chief, but the same must be closed previous to the [7th day of October, 1872].

All testimony must be taken in accordance with the printed rules previously transmitted.

[George T. Smith, of Cincinnati, Ohio, filed his application May 20, 1827. His direct testimony must be closed before the 26th day of August, 1872.[1] — Augustus F. Jones, Cincinnati, Ohio, attorney of record.

Benjamin Barter of Philadelphia, Penn., filed his application February 20, 1872, and a certificate of registration was issued to

[1] The junior applicant stands in the place of plaintiff, as he attacks the claim of right of the senior party or parties, — for there may be several persons standing on the defensive as respondents. Each party is obliged to go forward and make out his case against those who filed their applications before him.

him April 9, 1872. His direct testimony must be closed before the 23d day of September, 1872.—Dodson & Fogg, Camden, N. J., attorneys of record.]

——— ———,

Trade-mark Examiner.

NOTICE OF THE TAKING OF TESTIMONY.

Before the Commissioner of Patents, in the matter of the Interference declared between the application of George T. Smith, for registration of trade-mark for whiskey, and the certificate of registry of Benjamin Barter, dated April 9, 1872.

——— ———

SIRS,—You are hereby notified that on Monday, August 12, 1872, at the office of Hamilton Roberts, Esq., No. 140 Central Avenue, Columbus, Ohio, at nine o'clock in the forenoon, I shall proceed to take the testimony of A. B., C. D., and E. F., all of Columbus, Ohio, as witnesses on my behalf.

The examination will continue from day to day, until completed. You are invited to attend and cross-examine.

[GEORGE T. SMITH,
By AUG. F. JONES, *his Attorney.*]

Cincinnati, O., August 5, 1872.

To Messrs. DODSON & FOGG, Attorneys for Respondent.

We hereby admit[1] due service of notice of which the foregoing is a copy, this 6th day of August, 1872.

[DODSON & FOGG,
Attorneys for Respondent.]

State of ,
County of . } ss.

Personally appeared before me, a justice of the peace in and for said county, Samuel Johnson, who, being duly sworn, says that he served the foregoing notice upon Dodson & Fogg, attorneys for Benjamin Barter aforesaid, at one o'clock, P.M., of the 6th day of August, 1872, by leaving a copy thereof at their office in Camden, N. J., in charge of their clerk.

SAMUEL JOHNSON.

Sworn to before me this 7th day of August, 1872.

——— ———,

Justice of the Peace.

[1] Unless service be admitted, there must be proof of service either by affidavit or by certificate of marshal or sheriff.

Deposition.

Before the Commissioner of Patents, in the matter of Interference between the application of George T. Smith, for registration of trade-mark for whiskey, and the certificate of registry of Benjamin Barter, dated April 9, 1872.

Depositions of witnesses examined in behalf of George T. Smith, pursuant to the annexed notice, at the office of Hamilton Roberts, Esq., No. 140 Central Avenue, Columbus, Ohio, on Monday, August 12, 1872, and following days.

A. B., being duly sworn [*or* affirmed], doth depose and say, in answer to interrogatories proposed to him by James G. Fant, Esq., counsel for the said George T. Smith, as follows, to wit:—

Question 1. What is your name, age, residence, and occupation?

Answer 1. My name is A. B. I am twenty-seven years old. My residence is in Columbus, Ohio. I am a wholesale dealer in groceries.

Quest. 2. &c.

And in answer to cross-interrogatories proposed to him by Charles Cavil, Esq., counsel for Benjamin Barter, he saith:—

Cross-question 1. How long have you known the trade-mark in question?

Ans. 1. &c.

A. .

Certificate of Officer.

[*To follow depositions.*]

State of , }
County of . } ss.

At , in said county, on the 12th day of August, 1872, and subsequent days, before me personally appeared the above-named [*give full names of all the witnesses*], and made oath that the foregoing depositions by them respectively subscribed contain the truth, the whole truth, and nothing but the truth. The said depositions were taken at the request of —— ——, to be used upon the hearing of an interference between the claim of the said —— —— and that of —— ——, to the exclusive use of a trade-mark, before the Commissioner of Patents, on the [21st day of October, 1872].

The said —— —— was duly notified, as appears by the proof

attached to the original notice, hereto annexed, and he attended by —— ——, Esq., his counsel.

WILLIAM BLACKSTONE,
Justice of the Peace.[1]

APPEAL IN INTERFERENCE CASE.

LEOPOLD WIRTS
v.
WILSON & DUNN. } Trade-mark Interference.

To the Commissioner of Patents:

SIR, — I hereby appeal to you in person from the decision of the Examiner of Trade-marks, in the matter of interference between my application for registration of a trade-mark for spool-cotton and the certificate of registry issued to the respondents, in which priority of adoption was awarded to them, the said Wilson & Dunn. The following are assigned as reasons for appeal: —

1st. The Examiner erred, in holding that to constitute adoption of a symbol as a trade-mark there must be an actual affixing to merchandise.

2d. He erred, in holding that the copyrighting of the said symbol was not, in legal effect, an actual adoption.

3d. He erred, in ruling out the deposition of James Johnson, because of alleged informalities.

4th. [*Any other objections, in regular order.*]

[1] Or U. S. Commissioner, or Judge, or Notary Public, or other officer having authority to administer oaths for general purposes.

The officer, having appended to the depositions the notice under which they were taken, shall then seal up the testimony, and direct it to the Commissioner of Patents; and shall also place upon the package a certificate of the taking, sealing up, and addressing, and the date of sending, &c.

FORMS OF PLEADINGS, &c.

No. 1. — Beginnings of Declaration in Federal Courts.[1]

Circuit Court of the United States.

For the [*Southern*] *District of* [*New York*].

A. B. }
C. *v.* D. }

Of the day of , 187 . As yet of term, in the year of our Lord one thousand eight hundred and seventy .

District of New York, ss.

A. B., who is a citizen of the State of [Ohio], plaintiff in this suit, by Merwin Hallibow, Esq., his attorney, complains of C. D., who is a citizen of the State of [New York], defendant in this suit, of a plea of trespass on the case: For that whereas the said plaintiff, before and at the time of the committing of the grievances by the

[1] Particular attention is invited to the following extracts from "An Act to further the Administration of Justice," approved June 1, 1872: —

Sec. 4 provides, among other matters, that "all process issued from the courts of the United States shall bear teste from the day of such issue."

"Sec. 5. That the practice, pleadings, and forms and modes of proceeding, in other than equity and admiralty causes in the Circuit and District Courts of the United States, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the Courts of Record of the State within which such Circuit or District Courts are held, any rule of court to the contrary notwithstanding: *Provided, however*, That nothing herein contained shall alter the rules of evidence under the laws of the United States and as practised in the courts thereof."

"Sec. 6. That in common-law causes in the Circuit and District Courts of the United States the plaintiff shall be entitled to similar remedies, by attachment or other process against the property of the defendant, which are now provided for by the laws of the State in which such court is held, applicable to the courts of such State; and such Circuit or District Courts may, from time to time by general rules, adopt such State laws as may be in force in the State in relation to attachments and other process; and the party recovering judgment in such cause shall be entitled to similar remedies upon the same, by execution or otherwise, as are now provided by the laws of the State within which said Circuit or District Courts shall be held in like causes, or which shall be adopted by rules as aforesaid: *Provided*, That similar preliminary affidavits or proofs, and similar security, as required by such laws, shall be first furnished by the party seeking such attachment or other remedy."

said C. D., as hereinafter mentioned, did manufacture, vend, and sell [*here state the cause of action in accordance with the suggestions contained in form No. 2*].

BY AN ALIEN AGAINST A CITIZEN OF THE UNITED STATES.

P. Q., who is a subject of the Emperor [*or* citizen of the Republic] of , and an alien, plaintiff, &c., complains of R. S., who is a citizen of the State of , &c.

BY A CITIZEN OF THE UNITED STATES AGAINST AN ALIEN.

R. S., who is a citizen of the State of , plaintiff, &c., complains of P. Q., who is a subject of the King of , &c.

BY A CORPORATE BODY.

The [*giving the full corporate name*] Company, citizens of the State of , incorporated by the name aforesaid, by the said State, and having their principal place of business therein, plaintiffs, &c.

No. 2.—DECLARATION FOR INFRINGEMENT OF A REGISTERED TRADE-MARK.

UNITED STATES CIRCUIT COURT.

—— *District of* ——.

E. F.
v.
G. H.

Of the day of , 187 . As yet of term, in the year of our Lord one thousand eight hundred and seventy .

E. F., being a citizen of the United States of America, and resident in the city of ,[1] plaintiff in this suit, by Merwin Hallibow,

[1] Probably this averment is not necessary when the action is brought in a Federal court under the trade-mark Act of July 8, 1870. *Citizenship*, under that Act, is less a matter of importance than *domicile*, *i.e.*, the commercial character, rather than the political status, is the point. But, to avoid all question as to jurisdiction, it is best to make the allegation so that it may appear whether the plaintiff sues as a citizen or as an alien. Where the subject-matter confers jurisdiction (as in a suit for infringement of a duly-registered trade-mark), an allegation of citizenship of a particular State is not required. However, abundant caution cannot harm.

his attorney, complains of G. H., defendant, of the said District, of a plea of trespass on the case: For that whereas he, the said plaintiff, for divers years before, and at the time of the committing of the grievances hereafter next mentioned, did manufacture, vend, and sell, and continue to manufacture, vend, and sell, and still does continue to manufacture, vend, and sell for profit, divers large numbers of a certain reaping-machine called the "Harvest Victor," which said machine the said plaintiff was then, and still is, used and accustomed to sell, each machine bearing a representation of "Time," with a scythe, and the words "Harvest Victor" in raised characters, as his trade-mark therefor.[1] And the said plaintiff being then domiciled within the United States, did cause to be recorded, in the Patent Office of the United States, a statement of his name, residence, and place of business; the class of merchandise and the particular description of goods comprised in such class, by which the aforementioned trade-mark had been appropriated as aforesaid; a description of the said trade-mark itself, with fac-similes thereof, and the mode in which it has been applied and used; and the length of time during which the said trade-mark had been used; and having made a payment of a fee of twenty-five dollars, and complied with the regulations prescribed in such case by the Commissioner of Patents; and having filed a declaration under the oath of this plaintiff, to the effect that he then had a right to the use of the said trade-mark, and that no other person, firm, or corporation, had the right to such use, either in the identical form or having such near resemblance thereto as might be calculated to deceive, and that the description and fac-similes presented by him for record truly represented the trade-mark sought to be protected, therefore he obtained a certificate of registry of said trade-mark under the seal of the said Patent Office, certified by the Commissioner of Patents, bearing date the day of , 187 , in due form of law, as by reference to said certificate and a schedule thereto annexed will fully appear.

And the said plaintiff further says that before and at the time of committing the grievances hereinafter next mentioned, he had gained and acquired great fame and reputation with the public on account of the excellent properties of the said reaping-machine, so

[1] Whether a full compliance with all the requirements of the statute in regard to registration need to be alleged has not been decided by any court. Perhaps it would be sufficient to simply allege the fact of due registration, evidenced by the certificate of the Patent Office, as regularity would be presumed. At any rate, the exemplification of the record would demonstrate the matter.

by him manufactured, vended, and sold, whereby the said plaintiff daily acquired and obtained great gain and profit. Yet the said defendant, well knowing the premises, but contriving to injure the said plaintiff in his said sale of said reaping-machine, and to deprive him of the great gains and profits which he the said plaintiff would otherwise have acquired by manufacturing, vending, and selling the said machine, did, on the day of , eighteen hundred and seventy , and at divers other times before and afterwards, and before the commencement of this suit, unlawfully and wrongfully, injuriously, deceitfully, and fraudulently, against the will and without the license or consent of the said plaintiff, manufacture and make, and cause to be manufactured and made, divers, to wit, 100 reaping-machines, marked in imitation of, and bearing an almost exact copy of the said plaintiff's trade-mark, to wit, the said representation of "Time," with a scythe, and the words "Harvest Victor" in raised characters, as hereinbefore set forth, in order to denote that the reaping-machine of the said defendant was the genuine reaping-machine manufactured, vended, and sold by the said plaintiff; and did knowingly, wrongfully, injuriously, deceitfully, and fraudulently vend and sell for his own lucre and gain the said last-mentioned reaping-machines; by reason of which said premises the said plaintiff has been greatly injured and deprived of great profit and advantage, in being hindered and prevented by the said defendant from selling, vending, and disposing of divers large numbers, to wit, 100 of the said reaping-machines, which the said plaintiff would otherwise have sold, vended, and disposed of, and has thereby sustained actual damage to the amount of two thousand dollars.

Yet the said defendant, though requested, hath never paid the same, or any part thereof, to the said plaintiff, but hath refused, and yet refuses so to do, and therefore the plaintiff brings this suit.

MERWIN HALLIBOW,
Attorney, and of Counsel for Plaintiff.

[*Title of the suit.*]

The defendant will please to take notice that the within is a copy of a declaration filed with the clerk of the United States Circuit Court for the District of at and that the defendant must plead thereto within twenty days after service hereof on him, or judgment will go by default.

Dated 187 .

MERWIN HALLIBOW,
Plaintiff's Attorney.

To G. H., the above-named Defendant.

(*Or this.*)

[*Title of the suit.*]

The defendant will please to take notice that a rule has been entered in this suit with the clerk of this court, at his office, in the city of , requiring the defendant to plead to the declaration filed in this action, with a copy whereof he is hereby served, within twenty days after service of a copy thereof and notice of said rule, or judgment.

Dated , 187 .

Yours, &c.,

MERWIN HALLIBOW,
Attorney for Plaintiff.

To G. H., Defendant.

AFFIDAVIT OF SERVICE OF THE DECLARATION.

L. M., being duly sworn, says, that on the day of , 187 , he personally served on the defendant G. H. within named, a copy of the within declaration and notice of rule to plead as herein indorsed (*or*, hereto annexed).

L. M.

Sworn to before me, this day of , 187 .

No. 3. — GENERAL DEMURRER TO DECLARATION.

[*Title of the cause, as in Form No.* 1.]

And the said defendant, by G. G., his attorney, comes and defends the wrong or injury, when, &c., and says that the said declaration and the matters therein contained, in manner and form as the same are above stated and set forth, are not sufficient in law for the said plaintiff to have or maintain his aforesaid action thereof against the defendant, and that he the said defendant is not bound by law to answer the same.

And this he is ready to verify; wherefore, by reason of the insufficiency of the said declaration in this behalf, the said defendant prays judgment, and that the said plaintiff may be barred from having or maintaining his aforesaid action thereof against him, &c.[1]

G. G., *Attorney for Defendant.*

[1] There may be several objections to the declaration, as, for example, that it shows no trade-mark in the legal sense, or does not set forth facts of any kind sufficient to constitute a cause of action. In Barrows *v.* Knight (6 R. I. 434), the defendant took the ground that the plaintiff had no right to appropriate the name of a famous deceased person; and that, even if he had, it was not plainly set forth that the defendant had infringed thereon.

Plea in Abatement to the Jurisdiction.

[*Title of the cause, as in Form No.* 1.]

And the said defendant C. D., by G. G. his attorney [*or in his own proper person*], comes and defends the wrong and injury when [&c.], and says that the court here ought not to take cognizance of, or sustain the action aforesaid, because he says that the cause of action aforesaid, if any accrued to the said plaintiff, accrued to him at Jersey City, within the jurisdiction of the United States Circuit for the District of New Jersey, and not within the jurisdiction of this court, and this he is ready to verify: wherefore he prays judgment, if the court here will take further cognizance of, or sustain the action aforesaid, &c.[1]

G. G., *Attorney for Defendant.*
[*Or*, C. D., *Defendant.*]

Affidavit.

—— *District of* ——.

C. D., the above-named defendant, being duly sworn, says, that the above plea is true in substance, and matter of fact.

C. D.

Sworn to before me this day of , 187 .

Replication to the Foregoing Plea.

[*Title of the cause, as in Form No.* 1.]

And the said plaintiff says that the court here ought to take further cognizance of, and sustain his action aforesaid against the said defendant, because the said plaintiff says that the cause of action aforesaid did arise within the jurisdiction of this court now here, to wit: at [*name the place*], as he hath above in declaring alleged; and this he prays may be inquired of by the country, and the said defendant doth the like, &c.

M. H., *Attorney for Plaintiff.*

[1] When both parties are citizens of the same State, and the action is brought for vindication of a common-law right to the use of a trade-mark, this plea is available. But if the action is brought under the provisions of the Trade-mark Act of July 8, 1870, the subject-matter gives jurisdiction, as in a patent or copyright case.

NOTICE OF MOTION FOR LEAVE TO AMEND.

[*Title of the cause, as in Form No.* 1.]

Sir,—Please to take notice that on the affidavit, with a copy whereof you are herewith served, a motion will be made before the Circuit Court of the United States for the District of , before one of the judges of the said court, on the day of , 187 , at o'clock in the noon, or as soon thereafter as counsel can be heard, that the plaintiff [*or defendant*] in this cause have leave to amend the declaration [*or other pleading*] filed herein, by inserting [*or striking out, or substituting, as the case may be, specifying the amendment proposed*], on such terms as the said court may direct.

Dated , 187 .

Yours, &c.,

M. H., *Attorney for*, &c.

To N. O. P., Esq., Attorney for, &c.

No. 4.—COMPLAINT AT COMMON LAW IN STATE COURTS.

By and against Partners.

A. B. and C. D., *Plaintiffs*,
against
E. F. and G. H., *Defendants*.

The plaintiffs, A. B. and C. D., partners, doing business under the firm-name of A. B. & Co., complain of E. F. and G. H., doing business under the firm-name of F. & H., and allege:—

That the said plaintiffs, before and at the time of the committing of the grievances by the said E. F. and G. H., as partners aforesaid, as hereinafter mentioned, did manufacture, vend, and sell, and continue to manufacture, vend, and sell, divers large quantities of lead-pencils for the use of artists and others, which said lead-pencils were each stamped in gold with a device representing a spread eagle with a star over its head, and the letters "A. B." underneath the said eagle, which said device when so applied constituted the exclusive trade-mark of the said plaintiffs, to indicate to purchasers and the public that the said lead-pencils were the product and merchandise of the said plaintiffs, and the said lead-pencils when offered for sale in large quantities were done up in packages of dozens from one dozen up to

twelve dozen in each package, and each package thereof was wrapped in paper having thereon a label with a deep-blue ground upon which was stamped in gold the trade-mark before described, and the said label also contained a printed notice reading as follows: "Genuine STAR AND EAGLE lead-pencils, manufactured and sold by A. B. & Co., GRAPHITE BLOCK, JERSEY CITY, N. J. *None Genuine without our Trade-mark.*" And the said plaintiffs do further allege that, before and at the time mentioned, they had gained and acquired great fame and reputation with the public, on account of the excellent quality of the said lead-pencils so manufactured and sold by them; yet the said defendants, well knowing the premises, but wickedly and wrongfully, subtly and unjustly, intending to injure and defraud the said plaintiffs in the sale of the lead-pencils so manufactured by them, and to deprive them of the just gains and profits which they the said plaintiffs would otherwise have made in vending and selling the said lead-pencils, on the day of , and at divers other days and times between that day and the day of the commencement of this suit, at the city of New York, and divers other places, did wrongfully, knowingly, injuriously, deceitfully, and fraudulently, against the will and without the license or consent of the said plaintiffs, manufacture, and cause to be manufactured, divers, to wit, one thousand dozen of lead-pencils, in imitation of the lead-pencils manufactured and sold, or offered for sale by the said plaintiffs as aforesaid, and did stamp, or cause to be stamped, each one of the said lead-pencils manufactured by the said defendants with a mark similar in appearance to that before described as used by the plaintiffs, and to which they then had and still have an exclusive right of use, and did pack or caused the same to be packed in the same manner, and to be wrapped in paper bearing a label of the same color as that of the said plaintiffs, upon which was stamped, in silver, a device very similar to that used by the plaintiffs as their exclusive trade-mark as aforesaid, which said label contained a notice having the same general effect as that of the plaintiffs, and reading thus: "The Best STAR and EAGLE lead-pencils, made expressly for F. & H. at GRANITE BLOCK, Jersey City, N. J. — None Genuine without our House-mark," in order to denote that said spurious lead-pencils were the genuine manufacture of the plaintiffs; and the said defendants did knowingly, wrongfully, injuriously, deceitfully, and fraudulently vend and sell, for their own lucre and gain, the said last-mentioned lead-pencils, as and for lead-pencils manufactured and sold by the said plaintiffs, whereas in truth and in fact the said

plaintiffs had never been the manufacturers or vendors thereof, or any part thereof; by reason of which said premises the said plaintiffs have been fraudulently injured and deprived of great advantage which they would otherwise have derived from the sale of lead-pencils so manufactured and marked by them, and have sustained actual damage to the amount of one thousand dollars, and have been otherwise greatly injured in the selling and vending of the said lead-pencils to the further amount of five thousand dollars and therefore the plaintiffs bring this suit.

MERWIN HALLIBOW,
Attorney for Plaintiffs.

No. 5.—BILL IN EQUITY.

CIRCUIT COURT OF THE UNITED STATES, }
For the District of . }

To the Judges of the Circuit Court of the United States for the District of in the Circuit, sitting as a Court of Equity.

A. B. & C. D., of , and citizens of the State of , bring this their bill against E. F., of , and a citizen of the State of . And thereupon your orators, humbly complaining, show unto your honors that they are the assignees and successors in business of & , a firm which was composed of , , and your orators, and which firm was formerly engaged in the manufactory and sale of sewing-machines in ; and for the period of more than five years your orators and their predecessors had been engaged in the manufacture and sale of sewing-machines at the same place; and that during the whole period of time of such manufacture and sale by them they had exclusively used and your orators are now so using, and had, and still have the right so to use, a certain trade-mark for said sewing-machines, which trade-mark was printed on paper of an ultramarine ground on which is represented a view of the Princess Penelope weaving, and the name "Penelope," which is the essential part of said mark, printed thereon; and that no person, firm, or corporation except the said and your orators have had at any time heretofore, and none except your orators now have any right to the use of the said trade-mark or of any trade-mark substantially the same.

They further show to your honors that on the said day of , 18 , being entitled as aforesaid to the exclusive use of said

trade-mark, and desiring to secure to themselves full and lawful protection for the same by due registration thereof in the United States Patent Office, according to law, your orators did deposit in said Patent Office of the United States for registration their trade-mark aforesaid for sewing-machines; and having fully complied with all the requirements of the Act of Congress in such cases made and provided, the trade-mark aforesaid was on the day of , 18 , duly and lawfully registered and recorded in said United States Patent Office, with protection to remain in force for thirty years from said date, all of which, with an accurate copy and description of said trade-mark and the declaration of a member of the firm, on which it was registered, will more fully and at large appear from copies from the Patent Office, duly certified by , Commissioner of Patents, under his seal of office, and herewith filed as part of this bill marked ; and thereupon protection in the exclusive use of the trade-mark aforesaid previously held and enjoyed by your orators was secured to them for the period of thirty years from said day of , 18 .

Your orators, further complaining, respectfully show unto your honors, that since your orators have had the exclusive right to use the said trade-mark, to wit, from the day of to the present time, the said , of , in the State of , has been manufacturing sewing-machines in said city of , and has been unlawfully and without your orators' consent using, in the sale thereof, a trade-mark substantially like, and indeed almost identical with, that of your orators.

To the end, therefore, that your orators may obtain relief in the premises in this honorable court, where alone adequate relief can be afforded, they pray: —

1st. That the said E. F. may be made a defendant to this bill, and compelled to answer each and every allegation thereof, on oath, as fully and to the same extent as if he were directly interrogated as to each allegation.

2d. That he may be compelled to render before a commissioner of this court a full, true, and perfect account of all profits of every description which he has made, or might have made, by the use of the simulated trade-mark aforesaid, or by the use of any other trade-mark for sewing-machines having thereon as a constituent part thereof the word "Penelope," or a representation of the Princess Penelope weaving, or any trade-mark having such near resemblance to that of your orators, as aforesaid, as might be calculated to deceive; and that he, the said E. F., be decreed to pay over to them all such profits.

3d. That the said commissioner be required to ascertain and report to this court, also, what loss and damage has been inflicted upon your orators by reason of the infringement of their rights, and the interference aforesaid with the right of exclusive use of the trade-mark first-mentioned; and that the said E. F. be also decreed to pay to them such damages.

4th. And may it please your honors, the premises considered, to grant unto your orators a restraining order against the said defendant enjoining and restraining him, his clerks, attorneys, agents, and servants from using the simulated trade-mark aforesaid, or any other trade-mark containing the word "Penelope," or being substantially the same with that of your orators.

5th. And that your orators may obtain the injunction and relief prayed for, and all such other and further relief as the nature of their case may require, may it please your honors to award against the said E. F. a writ of subpœna, &c.

C. D. [*for the firm.*]

KELLER & WATSON,
Counsel for Complainants.

United States of America, }
District of . } ss.

At the city of , in the county of , and district aforesaid, this 3d day of , 187 , personally appeared before me, ——, U. S. Commissioner for said district, the above-named C. D., and made oath that the facts set forth in the foregoing bill, so far as they purport to be stated as of his own knowledge, are true; and so far as they purport to be stated on information and belief, he believes to be true.

Given under my hand this day of , 187 .

——,

[L. S.] *U. S. Commissioner for District of .*

No. 6. — ORDER TO SHOW CAUSE WHY INJUNCTION SHOULD NOT ISSUE.

In the Circuit Court of the United States for the District of at .

At Chambers in Vacation. and , citizens and inhabitants of the State of , and partners under the firm and style of & *versus* , a citizen and inhabitant of the city of in the State of .

This day came the complainants by and their counsel, and presented to me, , Judge of the Circuit Court of the United States for the District of , at my chambers, in vacation, their bill of complaint against the defendant ; and the same, with the affidavit of thereto annexed and the exhibits filed, being read and duly considered, on motion of said complainants by their counsel aforesaid, it is ordered, that the defendant do, on the of the special term of the Circuit Court of the United States for the District of at , to be held on the day of , appear before said court and show cause, if any he have to show, why an injunction should not issue against him, and accounts be ordered, according to the prayer of said bill; such course to be shown on said bill on affidavit, provided copies thereof be served on said defendant, with a copy of this order, on or before , the day of .

—— ——,
Judge, &c.

No. 7. — Answer to the Foregoing Bill.

[*Title of court and caption.*]

The answer of E. F., defendant, to the bill of complaint of A. B. and C. D., complainants.

This defendant, now and at all times hereafter saving and reserving unto himself all benefit and advantage of exception which can or may be had or taken to the many errors, uncertainties, and other imperfections in the said complainants' said bill of complaint contained, for answer thereto, or to so much and such parts thereof as this defendant is advised is or are material or necessary for him to make answer to, this defendant answering saith: — (1.) That he has been informed and admits it to be true that, upon application by the complainants, registration was granted by the Patent Office of the United States on the day of , 18 , as in said bill alleged, of an alleged trade-mark as described in the said bill of complaint; and this defendant says that he does not know and is not informed, save by said bill of complaint, whether or not the said complainants did properly make application for said registration of trade-mark, and did comply with all the requirements of law, and did have the said certificate of registration issued to them in due form of law. He leaves the complainants to make such proof thereof as they shall be advised is material. (2.) And this defendant, on information and belief, de-

nies that by virtue of any such registration of the said trade-mark in said bill mentioned, or otherwise, the said complainants became, or ever were, or either of them ever was, possessed of any exclusive right to use the said alleged trade-mark in the said certificate of registration and bill of complaint described, if indeed the trade-mark and label used by this defendant is in any wise to be regarded as the same, either in substance or effect with the said trade-mark claimed by the complainants.

[&c. &c. &c.]

No. 8. — Decree for Injunction.[1]

[*Title of cause, &c.*]

[*Then follows the usual recital of all essential preliminary matters, as in ordinary cases of injunction.*]

It is ordered, adjudged, and decreed, and this court, by virtue of the power therein vested, doth order, adjudge, and decree, that the defendants, Calvin Flint Spear and George B. Ripley, and each of them, and their, and each of their attorneys, servants, and agents be, and they are hereby perpetually enjoined and restrained from making, devising, or causing to be made or devised, purchasing or procuring, any marks, stamps, labels, or tickets, described in the complaint in this action, as in use by the defendants, upon tickings possessed and sold by them, and that they be in like manner enjoined and restrained from using the said marks, stamps, labels, or tickets upon any tickings whatever in their possession, or under their control, or offered or kept for sale by them, or on their account, or for their benefit. And that they be in like manner enjoined and restrained from selling, keeping, or offering for sale any tickings bearing thereon any such stamp, mark, label, or ticket. And that they be in like manner enjoined and restrained from making, devising, or causing to be made or devised, purchasing or procuring, or in any way or manner using for or upon any tickings whatever any stamp, mark, label, or ticket similar to the said stamp, mark, label, or ticket of the plaintiffs, or having thereon the letters A C A, or being in any manner an imitation, whether in whole or in part, of the said stamp, mark, label, or ticket of the plaintiffs. And that they be in like manner enjoined and restrained from selling, keeping, or offering for sale any tickings as the real

[1] This is taken from the decree of Duer, J., in case of Amoskeag Manuf. Co. *v.* Spear, 2 Sand. S. C. 599 ("A C A" is the essence of the mark).

A C A tickings, which are not so, and for that purpose, from resorting to any device, deceit, fraud, or misrepresentation whatever, by the use of any stamp, mark, label, or ticket, or otherwise. And that they be in like manner enjoined and restrained from in any manner using the letters A C A on goods, or on the wrappers or covering thereof.

[The foregoing forms of pleadings, &c., are not intended to furnish models for all the machinery of legal and equitable procedure. It must be obvious to even the specialist in trade-mark litigation that these forms merely supplement ordinary books of practice. He must have recourse to the latter in the majority of cases.]

TABLE OF CASES

REGISTERED AS TRADE-MARKS,

UNDER THE ACT OF CONGRESS OF JULY 8, 1870.

THESE matters should not be implicitly relied on as precedents; for while it is true that the greater number of the cases are valid in law, having all the essential characteristics of lawful trade-marks, as laid down in § 143 of this book, many of the remainder are fatally-defective, while not a few are extremely dubious.

It would be invidious to annotate each case, and thus possibly injure the claimant thereof by indicating its indefensible features. Each reader must scrutinize for himself. It cannot fail to be observed, that the majority of worthless, self-styled trade-marks were registered within the first few months after the passage of the statute. It took time, study, toil, on the part of the Office, to learn and apply the principles of the law appertaining to this rather novel branch of jurisprudence, each day bringing fresh verifications of the truth that there is no royal road to knowledge. Courts have erred, as well as have practitioners. For some time the Office, in the discharge of ministerial functions, was satisfied with the statement sworn to by the applicant, and registered on the faith thereof; but by-and-by the fact dawned upon the mind that an examination of a judicial nature was required by the Act. Thenceforth all applications were rejected which did not at least make out a *primâ facie* exclusive right to the symbol claimed, and which would not probably endure the test of litigation. It must be apparent to any one who will run an eye down the following list, that some words or devices filed cannot possibly be recognized as symbols of manufacture or commerce. Several heads have already fallen into the basket at the hands of

the executioner of the law. Many other defective marks may be recast, and put into legal form by a proceeding in the nature of re-issue. Mere registration does not create a trade-mark. The law will not recognize nor protect any but legitimate offspring. The spurious children must be cast out.

For full descriptions, inquirers are referred to the specifications and fac-similes, copies of which may be obtained from the Patent Office by any person upon payment of twenty-five cents each. The descriptions in this table must necessarily be very brief. The object has been to give only the essential word or other symbol. When a reader looks at the *class* column, he can then, by looking at the description, learn whether it is worth his while to send to the Patent Office for a printed specification and a copy of the mark.

In many of the earlier cases, the specifications referred to drawings thereto annexed, but did not describe the marks. In such cases, it is sometimes difficult to determine what is the essential symbol.

This list is brought down to the latest day of registration before going to press. (*See* ADDENDUM.)

Registrants.	Brief Description.	Class.	No.
Abendroth Bros. . . .	"Cotton Plant," &c.	Ranges & stoves	306
do. do.[1] . .	"Sunny South," &c.	do. do.	307
Adams, Blake, & Taylor	"G.O.Blake's Bourbon Co., Ky.," &c.	Whiskey . . .	703
do. do. do.	Apple-tree, and words "Apple-Tree"	Gin	712
Adams & Fay[2] . . .	"Young America," &c.	Writing-ink . .	912
do. do.	"J. Dessauer's Inks," and shield .	do. . .	921
do. do.	"Black Swan," &c.	do. . .	922
Adams, G. S. . . .	Headless bull, ox-yoke, &c. . . .	Mustard & spices	790
Adams, John W. . .	Boot upside-down, with horn-blower, and words "Mammoth Shoe" .	Boots and shoes	600
Adams & Taylor . .	Device, "Honeysuckle, Schiedam," &c.	Gin . . .	658
do. do. . . .	"Daniel Boone, Paris, Ky.," &c. .	Whiskey . . .	659
do. do. . . .	Phœnix, and letters "A. T.," &c. .	Gin	691
do. do.[3] . . .	"Kentucky Pioneer," and picture .	Whiskey . . .	692
do. do. . . .	Within two rings, "Mayflower," &c.	Gin	693
Adams & Young . . .	"Lee's Liniment"	Liniment . . .	446
Adriance, Platt, & Co. .	Word "Buckeye"	Mowing mach'y	1075
Aikin, Lambert, & Co.	A lozenge, with the initials "A. L. & Co.," between two *fleurs-de-lis*	Watches and jewelry . .	472
Allen, Shapleigh, & Co.	"Crown Teas," with figure of crown	Teas	527
Althof, Bergmann, & Co.	Trotting-horse, harnessed in a hoop, &c.	Toys . . .	799
Altwell, Jr., James . .	Letters "C K C"	Knitting cotton	660
do. do. do. . .	Female sitting in chair knitting stocking, surmounted by words "Cabinet Knitting Cotton" . .	do. do. .	661

[1] See § 273, *ante*.

[2] See § 218, *ante*.

[3] See § 193, *ante*.

Registrants.	Brief Description.	Class.	No.
Altwell, Jr., James . .	"Improved Cabinet C. W. C." . .	Welting-cord .	662
American Club Fish Co.	"The American Club," with hieroglyph of fish	Preserved fish .	285
American Graphite Co.	Elaborate design, figure of globe, ship, locomotive, &c.	Plumbago or graphite lubricant .	737
do. do.	Circle, within which "Plumbago Railway-Grease"	Plumbago grease	197
Amer. Standard Tool Co.	"A. S. T. Co. — Hero"	Pistols	318
American Sterling Co.	"American Sterling"	Am. sterl'g metal	694
American Tube Works	Eagle, shield, &c.	Seamless metal tubes . . .	17
Amoskeag Manuf. Co.[1]	Letters "A C A"	Tickings & cottons	713
Anderson & Co., S. H.	"Premium Loaf," with designs of barrel, &c.	Flour	290
Appleby & Helme[2] . .	Landscape, train of cars, &c. . .	Snuff	61
Armistead, Louis Lee .	Bull's head, with words "The Durham Smoking Tobacco" . . .	Tobacco . . .	231
do. do.[3]	"Deer Tongue," and deer . . .	Smoking-tobacco	512
Ashcroft, John . . .	Coffee-pot, and words "The Mocha Steam Coffee-Pot"	Coffee-pot . .	608
do. do. . . .	Chain, star, anchor, &c. . . .	Coffee	553
Atchison & Bro. . .	"Atchison's Sure Cure for Cholera," &c.	Cholera medicine	447
Atlantic White Lead Co.	"Atlantic," and a circle formed of words.	White lead .	71
do. do. do.	Letters "A. W. L. Co.," &c. . . .	Refined boiled linseed-oil .	72
Atmore & Son . . .	"Atmore's Mince-Meat"	Mince-meat . .	436
Averill Chem. Paint Co.	A rock, with the word "Chemistry" upon it, &c.; eagle, bearing ribbon, with words "Economical, Beautiful, Durable," &c. .	Liquid paint . .	1
do. do. do.	Mixed device, with words "Mixed, ready for use"	Paint	128
do. do. do.	Ornamental design, and "Liquid Chemical Paint"	Liq. chem. paint	129
do. do. do.[4]	"Chemical Paint"	Chemical paint .	130
do. do. do.	"Chemically-prepared Paint" . .	Paint	384
do. do. do.	"Averill Chemical Paint" . . .	Chemical paint .	143
do. do. do.	Eagle on a rock, holding in its beak a paint-pot and brush, city, lettering, &c.	Paint	224
Ayers, Francis H. . .	Arms of Louisiana, and words "Dr. F. H. Ayers' Celebrated Vinegar Bitters"	Medicine . . .	901
Babcock & Co., J. P. .	Word "Irish"	Soap	667
Backman & Wilson . .	Border within which copy of Landseer's painting called "Monarch of the Glen," firm-name, individual names, name of brand, "Challenge Brand," &c. . . .	Sugar-cur'd hams	1066

[1] See §§ 153–156, *ante*.
[2] Not described in specification.
[3] See § 273, *ante*.
[4] See § 251, *ante*.

Registrants.	Brief Description.	Class.	No.
Backus & Co., F. M.[1] .	"Water White Oil"	Refined petroleum	640
Backus, Frederick M. .	"Fire Engine Oil"	Lubricating-oil .	266
Badger, Benjamin F. .	"Souvenir"	Razor-strops . .	96
Badger, Benj. F. . .	Oval figure, containing the word "Badger"	Razor-strop . .	944
Baeder, Adamson, & Co.	Diamond, containing descriptive words.	Glue . . .	175
do. do. do.	A figure of a crescent	Emery . . .	890
Baker & Bro., H. J.[2] .	"Crystal"	Castor-oil . . .	373
do. do. do. . .	"A. A."	do. . .	374
Baker & Bullock . .	Two horns, with quadrangular block	Soap	473
Baker, Carr, & Co. . .	"The Concord Hame, B. C. & Co."	Hames . . .	811
Baker, Francis . . .	Bee, and word "Mills"	Salt	372
Baker, Seth W. . . .	Horse covered with blanket, and the words "Baker's Patent Evaporating Horse-Blankets"	Horse-blankets .	791
Balch & Co., A. W.[3] .	"Rip Van Winkle Copper Distilled Whiskey"	Whiskey . . .	601
do. do. do. . .	Words "Antiquity Whiskey" . .	do. . . .	602
do. do. do. . .	Shield, containing a crescent . .	Wines & liquors	852
do. do. do. . .	Hexagon, with letters "A. W. B. & Co.," and words "Crystal Glen."	Whiskey . .	586
do. do. do. . .	"A. W. B. & Co.," and word "Pyramid."	do. . .	587
do. do. do. . .	"Thirty-three Stars," and cuts of stars.	Gin . . .	588
do. do. do. . .	"Santa Claus Schiedam," and picture.	do. . . .	589
do. do. do. . .	Outline of a bell	Wine	590
Baldwin, Oran S. . .	"Baldwin, the Clothier"	Clothing . . .	351
Baldwin, Prentice, & Waller	Wings, & words "The Winged Hat"	Hats	182
Baldy & Co., J. B. . .	Four designs: locomotive, female, cage, and coach, &c.	Mustard . . .	2
Barclay, George C. . .	"Tricopherous"	Preparation for the hair . .	267
Barkhouse Bros. & Co.[4]	"Barkhouse Brothers & Company," and cut of horse, and words "Gold Dust," &c.	Whiskey . . .	626
Barksdale, Ford S. . .	"Our Society"	Newspaper . .	424
Barnes, Demas . . .	"Hagan's Magnolia Balm," and magnolia blossom	Balm	232
do. do. . . .	"Mexican Mustang Liniment," &c.	Liniment . . .	233
do. do. . . .	"Lyon's Magnetic Powder," &c. .	Insect-powder .	234
do. do. . . .	"Lyon's Kathairon for the Hair".	Preparation for the hair . .	235
Barnes, Wallace . .	Figure of patent level-tempered clock-spring	Clock-springs .	474
Bartlett & Butman . .	"Common Sense"	Trusses . . .	933
Bartlett & Co., H. A. .	"Crumbs of Comfort"	Stove blacking .	18
Bartlett, Robbins, & Co.	"Baltimore Kitchener," & two stars	Kitchen-ranges .	513
Batcheller Manuf. Co. .	Maltese cross, & words "Gold Cross."	Agricult.-forks .	131
Bates, Benjamin . . .	Ring, stripe, or band, with signature	Beer	176

[1] See § 274, *ante*.
[2] See § 274, *ante*.
[3] See § 218, *ante*.
[4] See § 273, *ante*.

Registrants.	Brief Description.	Class.	No.
Bates, Benjamin	Ring, stripe, or band, of diverse colors.	Beer	268
do. do.	"*National*"	Tonic beer	1010
Baxter, James P.	Three yellow tablets, &c.—elaborate	Sugar corn	375
Bayles, James A.	"Bayles' Improved Tree Digger"	Nursery trees, &c.	869
Bay State Iron Co.[1]	Photograph of pig-iron, with words "Port Henry"	Pig-iron	874
do. do.	"Bay State," and photographs of rolled plates	Plate metal	875
Beardsley Scythe Co.	"Harvest Victor"	Scythes	843
Benson, Charles W.	"Catalina"	Wine tonic	945
Beresford & Co., R.	*Cancelled*		765
do. do.	Word "Peerless" on device	Sugar-cured hams, &c.	1082
do. do.	Figure of woman, eagle flying, &c.	do. do.	1083
Bergen & Bainbridge[2]	"Dolly Varden," with designs	Card-stock, wedding & visiting papers, &c.	833
Bernecker, John L.	Spread eagle, with letters "L" and "B" and "&"	Whiskey	207
Bickford, E. F.	"Bickford Reinforced Overshoe," &c.	Overshoes	844
Biddle Hardware Co.[3]	"Wisconsin Wood-Chopper"	Axes	923
Bidwell, John C.	"*J. C. Bidwell, Pittsburg Plow-Works,*" &c.	Plows, &c.	155
Billings, Henry M.	Ring and bar, with words "Tarrant's Seltzer Aperient"	Medicine	387
Bishop & Co., R. M.	"Royal Olive Soap"	Soap	977
Bishop, George Riker	"Yuh-heh"	Mineral water	495
Bishop, William A.	Monogram, with letters "W. A. B."	Medicine	545
Bissell & Moore Manufacturing Co.	"The Electric"	Saws	341
Black Diam. Cement Co.	Picture of black diamond, and words "Black Diamond Cement Co."	Cement	861
Blackwell, W. T.	Durham bull, and "Genuine Durham Smoking Tobacco"	Smoking-tobacco	122
Blackwell, William T.[4]	"Durham Smoking Tobacco"	do.	454
Blanchard's Sons, Porter[5]	"The Blanchard Churn"	Churns	254
Blatchley, Charles G.	"B," enclosed within a circle	Pumps	198
Bliss, Keene, & Co.	Bird with serpent in beak.	Cundurango	514
do. do. do.	Bird holding serpent in beak, and words "Bliss, Keene, & Co., Cundurango"	do.	515
Block & Co., H.	Dove with olive-branch in mouth, &c.	Whiskey	112
Blume & Co.	Eagle, between the letters "B" and "C"	Chicory	177
Bock, Genin, & Co.	"Paragon Wax Match"	Matches	352
Boetticher, Kellogg, & Co.[6]	"I X L"	Chopping-axe	83
Borgner, H. C.	"I S, Everybody's Favorite, Indigo-Soap"	Indigo-soap	776

[1] See § 193, *ante*.
[2] See § 218, *ante*.
[3] See § 193, *ante*.
[4] See "Durham" case, chapter on Interferences.
[5] See §§ 377–379, *ante*.
[6] See §§ 68–70, 450, *ante*.

Registrants.	Brief Description.	Class.	No.
Boston Lead Co. . . .	"Boston Lead Company," and star and seal	Lead for painters' use	714
Bostwick & Tilford[1] .	"Daylight, B. & T."	Illuminating oils	376
do. do.[1] .	"Gaslight, B. & T."	do. do.	377
Bourke & Co., F. G. .	"The New York Copper or Metallic Paint"	Metallic paint .	255
Bourne, George . . .	Diamond, containing the letter "A," &c.	Fertilizer . . .	169
Bouton, Whitehead, & Co.	"Western Star," with 5-pointed star	Pitch-forks . .	591
do. do. do.	Jones' Plow, with star between words	Plows	627
Bowen, Hunt, & Winslow	Representation of American eagle, with spread wings	Black alpaca dress-goods .	66
Boyce & McKenzie . .	Picture of a tree, with words "Dr. Pettis' Australian Blood-Purifier"	Medicine . . .	1048
Boynton, E. M. . . .	Patent lightning saw, &c., and words "*Il tempo passa*"	Saws	636
Brady & Co., D. C. .	Figure of mortar & pestle, with words "Brady's Kentucky Whisky," and "Pharmaceutic"	Whiskey . . .	704
Brainerd, Armstrong, & Co.	Man holding a spool of silk, and words "Best in the World" .	Sewing silk and machine twist	1000
Branson, Ellis . . .	An oval, with word "Kohinoor" .	Retail coal . .	3
Brayley, James . . .	A belt, with buffalo's head, &c. . .	Thrash. machines	216
do. do. . . .	"The Buffalo Pitts Thresher" . .	do. do.	308
Bridgeford & Co. . .	Name "American," and letter "A"	Cooking and other stoves . . .	592
Briggs & Bro. . . .	Octagonal figure, with words "Put up by Briggs & Bro., Rochester, N. Y."	Seeds	442
do. do. . . .	"Choice Collection, Briggs & Bro., seedsmen and florists, Rochester, N. Y."	do.	443
Bristol Brass & Clock Co.	"Crystal"	Lamp-burners .	1001
Brodhurst, Kelita[2] . .	"Daniel"	Bridle-bits and stirrups . .	946
Brooklyn White Lead Co.	View of Company's factory, with words "Baltic," "White Lead," "Ground in Refined Oil," "Pure," &c.	White-lead . .	53
do. do. do.	View, enclosed in a semicircle, of Co.'s factory, with words, "Refined," "White Lead," &c. . .	do. . .	54
do. do. do.	View, with words "Manufactured from pure metallic lead, ground in pure linseed-oil," &c. . . .	do. . .	55

[1] See § 274, *ante*.

[2] See § 349, *ante*.

Registrants.	Brief Description.	Class.	No.
Brown Chem. Co., C. F.	Words "Young American" . . .	Liniment . . .	800
Brown & Co., B. F. .	"Army and Navy Blacking," and two stars	Blacking & leather dressing . .	403
do. do. . .	"Cirage Français," &c.	do. do. .	404
do. do. . .	"Brown's Satin Polish," &c. . .	do. do. .	405
Brown & Co., D. A. .	"Concord, N. H., Use"	Wagon-axles .	97
Brown & Co., S. N. .	"The Trade Wagon"	Wagons . . .	528
Brown, Frederick . .	Fac-simile of signature, and word "Genuine"	Essence of Jamaica ginger . . .	715
Brown & Sons, John I.	"Brown's Bronchial Troches" . .	Bronchial troches	475
Brown, W. A. & F. R.	"Log-Cabin," and design of cottage	Tobacco . . .	467
Buchan & Co., James[1]	"Diamond Soap"	Soap	924
Bucher, Gibbs, & Co. .	"Gibbs' Imperial Trade-Mark" .	Plows	217
Buffalo Magic Polish. Co.	Representation of a lady in the act of polishing a vase	Polishing preparation . . .	18
Bullucke, John . . .	"Warranted all pure Linen and grass bleach," decorations, &c.	Linen goods and fabrics . .	327
Bullymore, Richard .	Picture of fat hog, letter "B," and words "Full Weight" . . .	Lard	876
Butcher & Butcher . .	Name "W. Goodlad," and device of an anchor	Files	777
do. do. . .	Letter "B" enclosed in a ring, with arrow and Maltese cross . . .	Files, edge-tools, &c.	778
Butcher & Co., William	"W. Butcher," with cut of anchor	Cast-steel and castings . .	573
Butler, Earhart, & Co.	Can labelled "Butler, Earhart, & Co.'s Genuine"	Essence of coffee	425
do. do. do.	"Buckeye Mills" and "Sprig" .	Coffees, spices, &c.	455
Butler & Haynes . .	"Improved Cement Oil, 1870," in a circle	Composition oil	148
Cable Flax Mills . .	Words "Cable Flax Mills," encircled with a cable	Twines, yarns, &c.	792
Cahn, Belt, & Co. . .	Arms of Baltimore, casks, and monogram "C. B. & Co."	Whiskey . . .	947
do. do. . .	Seal, with clover-leaf, and term "Maryland Club"	do. . . .	948
Calhoun, Robbins, & Co.	"Japan Machine Twist," with vignette	Sewing-silk and twist . . .	738
Callaghan & Brother .	"Farmers and Mechanics" . . .	Cassimeres . .	222
Cameron & Co., R. W.	"Cameron's Triumph"	Twist-tobacco .	291
do. do. do.	"Diamond," with picture of a diamond	Kerosene . . .	292
Canfield, William M. .	Arms of N. Y. State, in circle; words "Empire Packing," &c. . . .	Steam & hydraulic packing . .	360

[1] See § 273, *ante*.

Registrants.	Brief Description.	Class.	No
Cape Ann Isinglass and Glue Co.	Eagle's wings, and name	Isinglass	1076
Capel & Roebuck	"Bone's Old Bourbon"	Whiskey	370
do. do.	"Boyd's Old Kentucky Bourbon"	do.	371
Carew, Andrew T.	"The American Club," and fish	Fish	476
Carroll, John W.[1]	Bust of Prince of Prussia, "Our Fritz," &c.	Smoking-tobacco	156
do. do.[1]	Horse, with words "The Celebrated Brown Dick"	do.	157
do. do.	Bust of a man, and "The Celebrated Lone Jack"	do.	158
Carson & Le A. & W.	"Lemon's Superior Sparkling," &c.	Ginger-ale, &c.	159
Carter Brothers & Co.	"Carter's Mucilage"	Mucilage	546
do. do. do.	"Carter's Ink"	Ink	388
Cassidy, John E.	"Pure Old Neptune Whiskey"	Whiskey	1002
Castle Brothers	Turreted castle, with shield-shaped border	Teas	812
Cazade & Crooks	"Otard, Dupuy, & Co., Cognac," &c.	Liquors	739
do. do.	Belt and crown, and words "Otard, Dupuy, & Co."	Brandy-bot. caps	993
Chamberlain, W. D.	Anchor, arrow, crosier, &c., in double circle	Medicine	913
Charleston (S. C.) Mining and Manuf. Co.	"Goodrich Bone-Phosphate"	Fertilizer	293
Chase & Co.	American buffalo, with inscription, "1.4. lb. nett, Chase & Co.'s Pure Ground Pepper"	Coffee, spices, &c.	891
Chaurant & Co., H.	Star, crescent, &c.	Confectionery	1077
Cherrington, Robert E.	Monogram, "P. S. P.," and word "Graphite"	Stove-polish	227
Chevalier & Co., F.	"Castle," &c.	Whiskey	1049
Chicago Attrition Pulverizing Co.	"Attrition Flour," and representation of a shield	Attrition flour	884
Chicago Manuf. Co.	Word "Tubular"	Lanterns	722
Chiles, Edward	"Chiles' Tonic Elixir"	Medicine	574
Chipman, George W.	"Anti-Moth Carpet-Linings"	Carpet-linings	294
Clark, George	"Rubigo Whiskey"	Whiskey	1034
Clark, Giles O.	Picture of foot and ankle, with a hand rubbing, star, letters "G. O. C.," &c.	Liniment	950
Clark, James L.	A star, to indicate star matches	Friction matches	1003
Clark, Orion	The constellation Orion, with figure armed with a club, &c.	Hair and face dressings	456
Clark Thread Co.	"O. N. T." "Clark's O. N. T. Spool-Cotton"	Spool-thread	949
do. do.	"O. N. T." arranged within a border	do.	969
Clarke & Schultz	"C. S. United States of North America, Trade-Mark"	Liquors & wines	723

[1] See § 218, *ante*.

Registrants.	Brief Description.	Class.	No.
Claubers, Wilhelm . .	Figure of a soldier on foot . . .	Cutlery & surgical instruments	1004
Clement, Colburn, & Co.	Likeness of Washington, with the name beneath	Men's boots . .	695
do. do. do.	"H. Clay," and likeness of H. Clay	Gentlemen's boots	516
Clemons, Welcome G..	Monogram, "T. G.," and words "The Taylor Gin"	Cotton-gins . .	1076
Cleveland, Orestes . .	"American Grap' ite Polygrade Pencils," and "Dixon"	Lead-pencils . .	956
do. do. . .	Representation of a crucible . . .	do. . .	957
do. do. . .	The word "Crucible"	do. . .	958
do. do. . .	Letter "S."	do. . .	959
do. do. . .	"S. S."	do. . .	960
do. do. . .	"M."	do. . .	961
do. do. . .	"S. M."	do. . .	962
do. do. . .	"V. H."	do. . .	963
do. do. . .	"V. S."	do. . .	964
do. do. . .	"V. V. H."	do. . .	965
do. do. . .	"American Graphite"	do. . .	966
Clifton, Charles H. . .	Pen, and "C. H. Clifton's Double Pointed Nickel Pen"	Writing-pens .	353
Cloud, Aikin, & Co. .	Design, and "Hungarian Condn. Powders"	Medicine . . .	554
do. do. . .	Letter "R," with serpent coiled upon it	Liniment . . .	779
Coats, J. & P. . . .	Combined arms of Great Britain and United States, with words, "Best six-cord spool thread," &c.	Spool-cotton . .	724
Cochran, McLean, & Co.	Three figures of articles for ladies' wear	Fancy goods for ladies' wear .	1053
Coes & Co., Aury G. .	"The Genuine Coes Screw Wrench"	Screw-wrenches	361
Coffin & Altemus . .	Word "Washington," with or without figure	Calico prints . .	663
do. do. . .	"Ballardvale"	Bleach'd long-cl'th	681
do. do. . .	"Rochdale"	do. do.	682
do. do. . .	"Avondale"	do. do.	705
Cohn & Co., M. . . .	"Novelty Ribbed Front Corset," "Perfect Fitting," "O K size, White"	Corsets . . .	529
Coit, Tracy	"Shadines"	Fish	4
Colburn, Charles H. .	"Colburn Top"	Removable tops for boots . .	766
Cole & Co., H. C. . .	"F. F. F. G."	Flour	256
Coleman, Dudley H. .	"Maid of the South"	Corn and wheat mills . . .	892
Coleman, James S. . .	"Coleman's Compound Extract of Eucalyptus," figure of mariner's compass, &c.	Medicine . . .	1040
Coleman, Walker, & Co.	"C. & W.'s," 3000, 3500, 99, with illustrations	Saddlery h'ware	978

Registrants.	Brief Description.	Class.	No.
Coleman & Co., Lewis	Elaborate design, "shield, lions, crown, eagle," &c.	Spool-cotton	183
Coles & Co., I. U.	Picture of car-truck in a border	Tallow packing for car journals	668
Colgate & Co.[1]	"Cashmere Bouquet"	Soap, toilet preparations, &c.	914
do. do.	Shield, garlands of leaves, and letters "C. & Co."	do. do.	915
Collender, Hugh W.	"Eureka Billiard-Cushion"	Billiard cushions	236
Collins Co.	"Collins & Co., Hartford Cast Cast-Steel"	Plows	523
do. do.	"Cast Cast-Steel"	Edge-tools, &c.	849
do. do.	Letters "C. C. S."	Edge-tools & agricultural ins'ts	850
Colwell, William I.	"Champion"	Muley-saw h'gings	740
Colwells, Shaw, & Willard Manuf. Co.	Representation of the cross-section of a tin-lined lead pipe, with projecting ribs, &c.	Tin-lin'd lead pipe	867
Comstock, Castle, & Co.	"Economy"	Stoves	295
Congress and Empire Spring Co.	"C."	Mineral water	398
Conklin, P. & F. G.	Deer, with head erect and front foot raised, &c.	Gloves	934
Conway & Son, John R.	Sheaf of wheat, &c., words "Upland Distillery," and monogram "J. R. C. & S."	Whiskey	935
Cook & Co., M. R.	Maltese Cross, with star, and letters "G. A. F. C."	do.	741
do. do.	Monogram of "M. R. & Co., within letter C.," &c.	do.	742
do. do.	Monogram, with words "Manhattan Club Whiskey"	do.	743
Cooper, John	"Cooper's Engine & Mill Works"	Machinery	269
Cowpe & Co., W.	"Excelsior," and letters "W. C. & Co."	Lace leather	951
Crichton, Malcolm[2]	"Monticello"	Whiskey	877
do. do.[2]	"Marieland"	do.	925
Crockett, David B.	A boat, with name, and letters "C. C. C."	Compos. coating	160
Crow, William	"Centaur Liniment"	Liniment	926
Crump, Samuel	Star, with words "Bull's Eye"	Labels and cards	457
do. do.	Head of bull, &c., and words "Full Weight"	Labels and show-cards	637
do. do.	"Crump's Label Press," &c.	Labels and show-cards for manufacturers	1011
Culter & Proctor	"Woman's Rights," in either raised or sunk letters	Stoves and stove trimmings	1068

[1] See § 273, *ante*.

[2] See § 193, *ante*.

Registrants.	Brief Description.	Class.	No.
Cummings, T. J. T.	"Model Baker," and figure of the apparatus	Baking & roasting apparatus	793
Cutter, Tower, & Co.	Figure of a dove, and word "Dove"	Lead-pencils	1005
Dale, Ross, & Co.	Picture of a stag erect	Dry goods	12
Danforth, George M.	Open hand over a flame, and letter "D."	Burning-fluid	113
Danforth, R. F.	Portrait of proprietor, &c., monogram "R. F. D.," &c.	Non-explosive burning-fluid	67
Davis, Curtis	"Peerless"	Soaps	669
do. do.	Word "Domestic"	do.	670
Davis & Co., S. H.	"Salt-Sea"	Oysters, fish, &c.	725
Davis, Jr., & Co., S.	Diamond-shaped figure, containing "S. Davis, Jr.," &c.	Hams, shoulders, tongues, &c.	902
Davis & Son, James	A displayed banner, with the word "Banner"	Leather	801
Davis & Son, Perry[1]	"Pain-Killer"	Medicine	416
do. do.	"Bearine"	Pomatum	970
Dawes, Fisk, & Fanning	A star, with other forms, letters, &c.	Umbrellas and parasols	84
Dawes & Fanning[2]	"140"	Alpaca-finished umbrellas	644
Dearborn, N. L.	Word "Zincoline"	Paint	632
De Cordova, G.	"Wine of the Allspice"	Wine of allspice	984
Delaney, Virgil	A caduceus or Mercury's rod, and words "Delaney's Vegetable Pain Exterminator"	Medicine	1054
Demarest, James	"Hesperidina"	Stomach bitters	257
Deniker & Melville	A crown, with monogram of firm-name	Toilet-soap	85
do. do.	"Alpina"	Perfumes,s'ps,&c.	609
Denison, George M.	Axle-box, with volume of smoke	Lubricating comp.	506
Des Auges, Robert	Two oranges, eagle, name, and signature	Honolulu orange bitters	114
Devlin & Co.	Letter "D" upon a shield, with hand grasping branch	Clothing,shirts,&c.	780
Diamond, Jacob	Six-pointed star, with letter "D"	Spectacles	507
Dick, Dundas	"The Dundas Dick Soft Capsules"	Medicine	362
Dill, Joseph	"Dill's Excelsior Marquetry"	Marquetry	802
Dobbins, Robert	"Dobbins' Healing-Salve," and cut of honey-bee	Salve	184
Dolan, Thomas	"Broadway," &c.	Shawls	1035
Domestic Sewing Machine Co.	"Domestic"	Sewing-machines	414
do. do. do.[3]	"Domestic"	Sewing-machine attachments	530

[1] See § 273, *ante*. [2] See title "Numerals." [3] *Abundans cautela non nocet.*

Registrants.	Brief Description.	Class.	No.
Dorn, Julius	Name, and circle enclosing woodcock	Whiskey . . .	389
Douglas Axe Manuf. Co.	"D. Sharp," &c.	Axes	302
do. do. do.	"W. Hunt," &c.	do.	303
do. do. do.	"A. Cutter," &c.	do.	304
Douglass & Co., Wm. B.	"Lake Superior Vis," and outline of lake	Medicine . . .	893
Doxsee, James H.[1] . .	Fishes crossed to resemble let. "X"	Preserved-fish .	853
Dreydoppel, William .	"Economy"	Soap	555
Dreyfus, Joseph . . .	Star, crescent, branch of oak, & clouds	Stomach bitters	940
Droege & Co., Ignatius	"Excellent"	Stoves	161
Dugdale & Girvin . .	"Magnum Bonum," and "Soluble Phosphate"	Fertilizer . . .	115
do. do. . .	"Excellenza," and "Soluble Ammoniated Superphosphate" . .	do. . . .	116
Dunlap & Co.	Maltese cross, with stag's head on its face	Hats, caps, and straw goods	170
Dunn & Co.[2]	"Everlasting"	Medicine . . .	448
Dunn Edge-tool Co. .	"D. E. T. Co.'s Clipper" . . .	Edge-tools . .	477
do. do. . .	"Fine Cutlery Steel," and firm-name	Scythes . . .	562
do. do. . .	"Damascus Blade," and firm-name	do. . . .	563
Durkee & Co., E. R. .	Representation of a helmet . . .	Spices, groceries, and drugs .	603
do. do. . .	Representation of a tiger's head .	do. do. .	604
do. do. . .	Monogram of "E. R. D. & Co.," within shield	do. do. .	605
do. do. . .	Representation of a gauntlet . . .	do. do. .	606
Dutcher Temple Co. .	The letter "D" and lozenge . . .	Loom-temples .	496
Dyott, M. B.	Repres. of the world and sun, with words "Carbon Gas-Light," &c.	Carbon gas-light oil & burners	706
Eagle Tanning Works	"Eagle Tanning Works," with eagle	Leather . . .	449
Earle, James M. . . .	Bust of American Indian, and words "Massasoit Mills" . .	Coffees, spices, &c.	1055
Edgerly, Hosea B.[3] . .	"Edgerline"	Boots and shoes	610
Elias & Bro., W. W. .	Elliptically-formed lady's locket, with chain	Jewelry . . .	237
Ellis & Co., W. L. . .	Five-pointed star, name, &c. . . .	Oyster packing	5
Elwell, Fiske, & Worth	Man holding umbrella, pump, &c. .	Umbrellas and parasols . .	406
do. do. do.	Diamond, with letters and figures .	do. do. .	407
Empire Mill Co. . . .	Sheaf of wheat, and words "Empire Mill Co.'s"	Flour	1006
English, Lizzie F. . .	A watch-key, & monogram "B.C.E."	Watch-keys . .	1062
English, Richard W.[4] .	Distinguishing feature is "X" . .	Brooms . . .	86
do. do.[4] .	"XXX"	XXX brooms .	87
do. do.[4] .	"XX"	XX do. .	88
Estey & Co., J. . . .	"The Vox Jubilante"	Reed-organs .	486
do. do. . . .	Word "Delecante"	Stop & reed-organs	638

[1] See § 250, *ante*.
[2] See § 273, *ante*.
[3] See § 217, *ante*.
[4] See §§ 162, 163, *ante*.

Registrants.	Brief Description.	Class.	No.
Evans, Clow, Dalzell, & Co.	Crescent, and monogram of letters "T." and "W."	Wrought-iron pipe	6
Evans, Lippincott, & Cunningham	"Banner Hams," and American shield with stars, &c.	Hams	894
Evans, Thomas R.	"Evans' American Gaiter"	Gaiters	426
Excelsior Needle Co.	"Excelsior"	Sewing-machine needles	1056
Faber, Eberhard[1]	"Star Pencils," in fancy frame	Lead-pencils	19
do. do.	"A. W. Faber"	do.	117
Faber, John	"*Quis quis fortuna sua Faber*," &c.	Drugs & medicines	971
Falk & Bro., G.	"Curls"	Cigars	952
Falls City Cement Co.	Anchor, with words "Falls City Cement Co."	Cement	862
Farber, McPike, & Co.	A crown, name and address of firm, and brand	Flour	895
Farr, Asa	"Southerner"	Pistols	1036
Farrington, Campbell, & Co.	"Detroit Mills Gold-Dust Mustard"	Mustard	936
Fechheimer & Workum	"Beech Grove Distillery," a triangle enclosing the letters "F. & W."	Whiskey	1012
Fegan, Peter	"Arlington," pictorial design, &c.	Rye whiskey	1057
Fenno & Co., Isaac	Monogram of "F. C. M. Co.," and drawing of machine	Cloth cut'g mach's	995
Filley, Giles F.[2]	"Charter Oak"	Cooking-stoves	328
Fink, H. G. G.	"Fink's Magic Oil," with cut of bottle	Medicine	611
Finkle & Lyon Manuf. Co.	Female clad in mail, with shield, on which are the words "Victor Sewing-Machine"	Sewing-machines	631
Fish & Son, G. H.	"Saratoga Aperient"	Med. preparation	1013
Fisk, Clark, & Flagg	"The Belfort Brace"	Gents' furn'g g'ds	270
do. do. do.	"Cheviot Shirts"	do. do.	271
do. do. do.	Lion passant, and words "*Cura et industria*"	Furnishing goods	118
do. do. do.	"Cheviot Shirtings"	Cheviot shirtings	249
do. do. do.	"The Argyll Brace"	Gents' furn'g g'ds	296
do. do. do.	"The Hampton Brace"	do. do.	297
do. do. do.[3]	"The Samson Brace"	Suspenders	744
Fitch & Son, S. S.	"The Queen's Toilet," and monogram of "M. I."	Toilet preparation	726
Fleischmann & Co.	Sheaf of grain, & generally firm-name	Yeast	821
Fleming, Cochran	Fac-simile of signatures "Fleming Bros." and "C. McLane"	Medicine	756
do. do.	Raised seal & "McLane's Liver Pill"	do.	757
do. do.	Fac-simile of signatures "C. McLane" and "Fleming Bros."	do.	758
Flint & Co.	Figure of a Quaker, &c., and "Jacob Warren"	Root & herb bitters	98

[1] Not described in specification.

[2] Filley v. Fassett, 44 Mo. 173.

[3] See § 273, *ante*.

Registrants.	Brief Description.	Class.	No.
Flint & Co., H. S. . .	"Dr. H. S. Flint's Shaker Bitters," with figures	Bitters	845
do. do. . .	"Dr. H. S. Flint & Co.'s Celebrated Quaker Choice Root and Herb Bitters," and figure of Quaker	do.	846
Foote, Arthur W. . .	Figure of a man astride the globe, and words "Uncle Sam" . .	Tobacco . . .	20
Forest-City Varnish, Oil, and Naphtha Co. .	Figure of a crown, & word "Crown"	Varnish, oil, and naphtha . .	727
Forest-River Lead Co. .	Barrel, on which are fig's "1840," &c.	Lead	847
Forster, Joseph . . .	"London Cordial Gin," signature and pictorial illustration . . .	Cordial gin . .	444
Foster, Wm. & Henry .	Triangles, enclosing "R. D. W. &" and "H. F."	Lastings & serges	427
Francis & Mallon . .	"Beaverine"	Boots and shoes	565
Frank & Co., Charles .	"Olive Bitters," with portrait of Dr. Aldo Wise	Bitters . . .	1028
French, E. D. & W. A.	Shield with three eagles' heads . .	Painters', &c., supplies . .	1084
Frieberg & Workum[1] .	Triangle, "O K," "Cabinet Bourbon," &c.	Whiskey . . .	89
do. do. .	Letters "F and W," female head, and "40"	do. . . .	696
Friedman Bros. . . .	"May flowers"	Boots and shoes	878
do. do. . . .	"De Soto"	do. do.	879
do. do. . . .	"Mississippi Valley"	do. do.	880
Fuller, Irad	Maltese Cross, name, grain & grapes	Wines, liquors, &c.	517
Furber, George C. . .	Open Bible, and verse therefrom .	Medical compound	99
Fusiyama Tea Imp. Co.	Monogram, "F. T. I. Co.," with figure, &c.	Tea	286
Gaff & Co., T. & J. W.	Open diamond, with figure or letter in centre	Rye and Bourbon whiskey . .	781
Gaines & Co., W. A. .	"Old Crow Distillery Copper Distilled Whiskey," &c.	Whiskey . . .	101
do. do. do. .	do. (substantially same) . . .	do. . . .	102
do. do. do. .	do. (add. "Franklin Co., Ky.")	do. . . .	103
do. do. do. .	"Hermitage Distillery Copper Distilled Pure Rye Whiskey," &c.	do.	104
Galena Oil Works . .	Words "Galena Oil," and star . .	Lubricating-oil .	772
Galt, William M. . .	"Golden Hill"	Flour	458
Gantz, George F. . .	Elaborate device, crown, stand of flags, &c., with words "Awarded to G. F. Gantz & Co.," &c. . .	Baking-powder .	813
Garbutt & Co., E. H. .	"E. H. G. & Co.," and words "All Right"	Coffee, spices, &c.	803
Gardiner & Co., L. Y. .	Figure of a star, with figure, mark, or letter	Brooms & brushes	100

[1] Not described in specification.

Registrants.	Brief Description.	Class.	No.
Garlick, Charles . . .	Quadrangle, figure, and signatures "Simpson & Co." and "Alex. Simpson"	Condition-powd'rs	459
Garrett & Sons, W. E.	Dragon rampant, with letters "G. S. S." &c.	Snuff	7
Gaullieur & André[1] .	Map of South Florida and Cuba, and words "La Flor del Tropico" .	Cigars . . .	927
Gay, Calvin B.[2] . . .	"Globe Boot and Shoe Store" . .	Boots and shoes	782
Georger, Charles E. .	Fem. bust, with word "Carbolicon"	Preparation for the hair . .	162
Gerber & Co., C. . .	Star of five points, with the words "Star Ax"	Axes	593
Gibbs, Ross, Field, & Field	Two bears, &c., and cock and trumpet, &c.	Woollen goods .	199
Gillender & Co., A. . .	"Solace"	Fine-cut chewing-tobacco . .	767
Gililand, Samuel . . .	"Pain-Banisher"	Medicine . . .	728
Gill & Looty[3] . . .	Figure of the Apollo Belvidere, and words "Apollo Gin, Schiedam"	Gin	521
Gillett, Allen H. . . .	Circular brand, proprietor's name, and "Woodcock Rye" . . .	Whiskey . . .	321
Giron, Frères	Two ladies on horseback, &c. . .	Velvet ribbons	1069
Globe Collar Co. . . .	Representation of a globe, and the letter "N"	Corsets . . .	953
Goodall, J. M. . . .	"Baskerville Vellum Wove," &c. .	Writing-paper .	804
Goodwin & Co. . . .	"Welcome Tobacco"	Tobacco . . .	607
Gordon, Gerald . . .	"Nutritious Condiment for Horses and Cattle," and figure of a horse, with letter "A" and figure "1" on his body	Cattle food . .	794
Goss, W. H.	"Tamarind Beer," with figure of a tamarind-tree	Tamarind-beer .	848
Graves, Chester H. . .	"Atwood's Pure Alcohol," &c. . .	Alcohol . . .	575
Great N. Y. Tea Co. .	Letters "G. N. Y. T. Co.," and Japanese emblem	Tea and coffee .	524
Green, Richard . . .	Shield, monogram, "Sea Foam" .	Preparations for the hair . .	21
Greenwoods Scythe Co.[4]	Words "Red Racer"	Mowing, reaping, and harvesting tools . . .	749
do. do.[4]	"Tip-Top"	do. do. .	750
do. do.[4]	"Queen of the Meadow"	do. do. .	751
do. do.[4]	"Star of the West"	do. do. .	752
do. do.[4]	"King of the Field"	do. do. .	753
do. do.[4]	"Western Dutchman"	do. do. .	754
do. do.	"Our Best," in connection with firm-name	do. do. .	773
do. do.	Word "Harvester"	Corn-knife . .	774

[1] See § 273, *ante*.
[2] "Globe" is the essential part.
[3] See § 218, *ante*.
[4] See § 275, *ante*.

Registrants.	Brief Description.	Class.	No.
Greenwoods Scythe Co.[1]	Letters "I X L"	Mowing, &c., tools	788
Grover & Baker Sewing Machine Co. . . .	Monogram of the letters "G" and "B," & name of Co., with devices	Sewing-machines	1019
Grubb & Co., John . .	An orange, and word "Orange" .	Sugar-cur'd hams	1078
Hacker & Richardson .	Pair of boots, one worn and one good	Boot-heels . .	188
Haines, John P. . . .	"Magic Disk Oil Cans"	Oil-cans . . .	566
Haley, John J. . . .	Representation of an elephant, produced by grouping of female figures	Medicines . .	532
Halford Sauce Co. . .	Crown and star, with letters "H. S. Co.," &c.	Table-sauce . .	822
Hall & Alger	"Dr. Henry Humphrey's Celebrated Liniment and Pain-Reliever," with portrait of a man	Medicine . . .	745
Hall, Isaac	"Sanseam"	Bk.-seam'd boots	1070
Hall, John L. S. . . .	"Columbo Bitters," letters & figures	Medicine . . .	408
Hall & Speer	"Hall & Speer," and monogram "P. G. W."	Agricult. impl'ts	123
Hallett & Co., G. W. .	A star, with the words "Tool Co."	Metal tools, &c.	729
Hamilton, T. F. . . .	A cross, and the word "Seamless"	Corsets . . .	1029
Hamilton, W. G. . .	Words "Steeled Wheels," moulded on the wheels	Car-wheels . .	8
Hamilton Woollen Co.	"Tycoon Reps"	Cotton, wool'n, &c.	716
do. do. .	"Red Riding Hood," figure of girl and wolf, &c.	Cotton & woollen fabrics . .	916
do. do. .	"Niobe Alpaca," cut of Niobe and child	do. do. .	917
Hammond, J. N. . . .	"Soda Beer"	Small-beer . .	823
Hand, Thomas J. . .	Skeleton bullock's head, with horns, resting on heart, plowman, &c.	Fertilizers . .	478
Hardee, Philip M. . .	"Superfine Merino," and letter "T"	Knit goods and fabrics . .	497
Harding, William W. .	Oblong figure, with rounded base and top	Photog. albums	683
do. do. .	Pointed elliptical figure, with circle, &c.	do. do.	684
do. do. .	Raised indented frame, &c. . . .	do. do.	685
do. do. .	Rectangular frame, &c.	do. do.	686
do. do. .	Rectangular frame, with central oval, &c.	do. do.	687
Harkness, Charles . .	"Patent Wax," and a honey-bee .	Candles . . .	390
Harmon, Merrick, & Co.	"Prime Engine Oil," with eagle, &c.	Engine-oil . .	439
Hart, Jr., & Bro., Wm. H.	Figure of a heart	Shields for neckties . . .	460
Harris, Beebe, & Co. .	"Flounders"	Chewing-tobacco	979
do. do. .	"Firm Brand"	Plug chew.-tobac.	928
do. do. .	"Pocahontas"	do. do.	929
do. do. .	"Mule Ear," with figure of the mule	do. do.	930

[1] See §§ 68–70, 450, *ante*.

Registrants.	Brief Description.	Class.	No.
Harris & Co., J. N. . .	"Lung Balsam"	Medicine . . .	417
Harris Manuf. Co. . .	"Buck's Head"	Cotton goods .	225
do. do. . .	"Little Champion"	Harvesters . .	428
do. do. . .	Cotton-plant, and words "Gem of the Spindle"	Fine cot. shirtings	479
Harris, Richmond, & Shafer	Complete anchor, with cable, &c. .	Clothiers & tailors' trimmings .	329
do. do. . . .	Coronet, shield with Greek cross, &c.	do. do. .	330
do. do. . . .	Map of North America, with spread eagle, &c.	do. do. .	331
Hartman & Co., S. B. .	"Hope," with picture of an anchor	Bitters . . .	218
Hartwell, Harrison J. .	"The Compound Oxygen Treatment"	Medicine . . .	346
Hauthaway & Sons, C. L.	Figure of a diamond or lozenge . .	Leather-dressing	78
Hawley, Alfred A. . .	"Repellent" — peculiar device . .	Water-proof mat'l	672
Haworth & Williams .	Word "Diamond," with letter "H" above and below the word, inclosed in a rhomboid	Cigars	1037
Hay, Henry H.[1] . . .	"L. F.," red letters on yellow ground, &c.	Medicine . . .	208
Hedges, William N. .	Five-pointed star, and monogram "H. C. B. P."	Baking powder .	309
Heller & Brightly . .	Transit instrument, and firm-name	Math. instruments	140
Henarie, Daniel V. B.[1]	Star on shield, &c.	Whiskey . . .	209
Hennessy & Co., J. . .	"Jas. Hennessy, Cognac," with arm and hand in mail	Brandy . . .	854
do. do. . .	"Jas. Hennessy & Co., Cognac," pictorial illustration	do. . . .	855
Hernsheim, Simon[1] . .	"Black," and representation of a horse, in stencil	Leaf-tobacco . .	272
Hill & Co., James R. .	"The Concord Harness"	Harness . . .	567
Hillebrand & Wolf . .	Star and suspended key	Locks & hardware	178
Hine, Charles C. . .	"The Insurance Monitor" . . .	Periodical . .	903
Hinrichs, C. F. A. . .	"Fire-Proof Chimney," and picture of phœnix	Lamp chimneys	628
Hirsch & Co., D.[1] . .	Oval, inclosing words "Big Thing," &c.	Cigars	22
do. do.[2] . .	Elaborate picture of Falstaff . .	do.	23
do. do.[1] . . .	Elaborate picture of Gulliver . .	do.	24
do. do.[1] . . .	Star in oval, words "Lone Star," &c.	do.	25
do. do.[1] . . .	Lion and serpent in oval, and words "The Lion"	do.	26
do. do.[1] . . .	Picture of Mephistopheles, and word "Mephisto"	do.	27
do. do.[1] . . .	Arms of State of Missouri, &c. . .	do.	28
do. do.[1] . . .	Picture of Jupiter, &c.	do.	29
do. do.[1] . . .	"Defiance," and picture in oval .	do.	30
do. do.[1] . . .	"Success," &c., in oval	do.	31

[1] Not described in specification.

[2] Ditto; see § 218, *ante*.

Registrants.	Brief Description.	Class.	No.
Hirsch & Co., D.[1] . .	"The Power of Fashion," and picture	do.	32
do. do.[1] . . .	Crowned eagle, &c.	do.	33
do. do.[1] . . .	"Legal Tender," &c., in oval . .	do.	34
do. do.[1] . . .	"The Pelican," and picture . . .	do.	35
Hirsch & Oppenheimer[1]	"H. & O. Perret, Geneva," in script, star	Watches . . .	36
Hodgson & Co., Thos. S.	Keystone, with Maltese cross and "T. S. H. & Co."	Medicine . . .	238
Hoffheimer Bros. . .	Initials "H. B.," "Fairfax Old Bourbon"	Whiskey . . .	79
Hogg, John K. . . .	Star, and word "Star"	Soap	9
Holbrook & Merrill . .	Ornamental woman's head, and words "The Empress" . . .	Cosmetics, pomades, &c. .	135
Holden, Tascott, & Co.	"Chicago Enamel Paint-Works," &c.	Paint	469
do. do. do.	"Tascott's Enamel-Paint" . . .	do.	470
do. do. do.	"Chicago Enamel Paint Works" .	do.	471
Holloway & Co. . . .	A serpent, and the words "Holloway's Pills"	Medicine . . .	598
do. do. . . .	Serpent, and the words "Holloway's Ointment"	do.	599
Hollwede, Charles F. .	"Isola Bella," and proprietor's name	Varnish . . .	863
Holman, Andrew J. .	Open book, and words "Let there be light"	Bibles	612
Holmes, Henry J.[1] . .	Device, "H. J. H.," and cotton-plant	Cotton-seed . .	37
Holmes, Thomas J. . .	"Holmes' Boston Perfumer" . .	Atomizers for perfuming, &c. .	480
Home Woollen Co. . .	Word "Home," with figures . .	Shawls, cloakings	568
Hooper, Quincy A. . .	"Rivera's Pine-Apple Beer," in border and device	Pine-apple beer .	533
Hopkins, Andrew J. .	Cut of horse, sulky, and driver, and "Go"	Medicine . . .	534
Horner, Jr., Joshua . .	"Maryland Super-Phosphate," and plow	Fertilizers . .	535
do. do. . .	"Maryland Superphosphate and Tobacco-Sustain," &c. . . .	do. . . .	594
Horton & Son, Eli[2] . .	"The Horton Lathe-Chuck" . .	Lathe chucks .	518
Hostetter & Smith . .	Trade-name, and picture of St. George and Dragon	Medicine . . .	223
Houghton, Edwin F.[1] .	Globe, and "Cosmoline" across it .	Cosmoline, a product of petroleum	56
Hudson & Co., H. C. .	"Hudson's Golden California Mustard," fac-simile of signature "H. C. Hudson," &c. . . .	Mustard . . .	1050
Hudson, Thomas S. .	"Sphynx," with pictorial representation	Stationers' hardw.	219
Hughes, D. W. . . .	Figure of a man, &c., and "Hughes' Missouri Corn Planter" . . .	Corn planters .	38
Hughes, John M. . .	"Hughes' Carbolic Insect-Powder"	Insect-powder .	332

[1] *Not described in specification.*

[2] *See §§ 377–379, ante.*

Registrants.	Brief Description.	Class.	No.
Hurlbut & Shanty . .	Anchor, or resemblance thereto . .	N'ck-ties, bows, &c.	673
Husson, Edmond . .	Collar & cuff, and monogram "E. H."	Ladies' collars, cuffs, &c. . .	481
Hutchinson, Jr., S. . .	Figure of apparatus, and words "Wicked Oiler"	Oiling apparatus	824
Hutchinson & Thomas	"The Coat-Fitting Shirt," with illustration	Shirts	273
Hydraulic Cement Co.	Circle, enclosing directions for use, address, and words "Akron Hydraulic Cement," &c.	Hydraulic cement	347
Ingraham & Co., E. . .	"Grecian"	Clocks	576
do. do. . .	"Venetian"	do.	577
do. do. . .	"Ionic"	do.	578
do. do. . .	"Doric"	do.	579
Ives, Beecher, & Co. .	"Very Old Brandy," grapes & leaves	Brandy . . .	429
do. do. . .	Elaborate design: wreath, crown, &c.	do.	547
do. do. . .	do. do. oval label . . .	do.	548
do. do. . .	do. do. do. . . .	do.	549
Jackson & Co., J. A.[1] .	Picture of Persens & Andromeda, &c.	Stomach bitters	39
Jackson Co.	Head and upper part of the body of an Indian, words "Indian Head Mills"	Cotton sheetings	538
Jackson & Wiley . .	"J. & W.," composition bearings .	Car, &c., bearings	378
Jenkins, Nathaniel[2] .	"Annihilator"	Medicine . . .	746
Jenkins, Thomas E. .	Picture of plant *Cinchona Calisaya*, with flowers, birds, and leaves .	do. . . .	310
Jennings, Abraham G.	Bobbin & carriage of a lace machine	Lace goods . .	163
do. do.[3] .	"200"	Nets and lace .	311
do. do.[3] .	"190"	do. do. .	312
do. do.[3] .	"150"	do. do. .	313
do. do.[3] .	"180"	Nets & lace goods	391
do. do.[3] .	"300"	do. do.	392
do. do. .	"Stella"	do. do.	393
do. do. .	"La Duchesse"	do. do.	394
do. do. .	"Diamond"	do. do.	395
do. do.[3] .	"750"	Hair-nets . . .	717
do. do. .	"775"	do. . . .	718
Jervey, William E. .	"Puroline"	Illumin. oils, &c.	164
Johnson, Charles E. .	Griffin holding balls, eagle, &c. . .	Printers' ink. .	228
Johnson & Co., I. S. .	"Sheridan's Cavalry Condition Powders"	Medicine . . .	918
Johnson & Co., Oliver .	"Villa Paints"	Paint	379
Johnson, Frank G.[1] .	"Indestructible School Chart" .	School charts .	40
Jones, Edward F. . .	"The Binghamton Scale Works," and bee-hive	Weighing scales	200
do. do. . .	Picture of shoe, with words "Ankle Counter"	Shoes, brogans, and boots .	149
Joslin, Palmer, & Williams	"Real," and letters "S. A. H." .	Jewelry . . .	730

[1] Not described in specification. [2] See § 273, *ante*. [3] See title "Numerals."

Registrants.	Brief Description.	Class.	No.
Joslin, William E. . .	"A. B. C. D. E. F.," representing patterns	Shirtings . .	498
Kavanagh & Decker .	"The Nonpareil"	Billiard-tables .	536
Keeler, Ezra W. . . .	"Clarence," and figure of a cross .	Twine, warp, yarn, &c.	230
Keep, William J. . .	Words "Side Burner"	Stoves	624
do. do. . .	"Side Burning"	do.	625
Kellogg, John Q. . .	"Jurubeba"	Medicine . . .	306
Kennedy & Co., S. H. .	Device of tree, &c.	Hemlock linim'nt	1080
Kennedy, Simon H. .	Monogram "K. C. E. P."	do. . . .	380
Kimball & Co., W. S. .	"Peerless," with cut of rising sun	Tobacco . . .	274
King, S. A.	Letter "T," with figure of a Chinese carrying chests of tea . .	Tea	825
King, William . . .	Proprietor's portrait, surmounted by British arms, above which the words "King's Sauce Royal," &c.	Table-sauce . .	57
Kingsford & Son, T. .	"Silver Gloss Starch"	Starch	768
Knight, B. B. & R. . .	"100⁸ Fruit of the Loom 100⁸," with fruit	Cotton goods .	220
do. do. . . .	"Fruit of the Loom"	Cotton shirtings	418
Knight, Samuel F. . .	Figure of a turtle, and inscription .	Shell-goods . .	1030
Knoepfel, W. H.[1] . .	"J. G. B. Siegert's Angostura Bitters"	Bitters . . .	580
Knox, Jr., James . .	Duck, encircled by wreath of thistle leaves, with words "Moveo et Profigior"	Linen thread .	482
Kohler, John F. . . .	"A. R."	Bread	537
do. do. . . .	"Cream Bread," and letters "A. R."	do.	653
Kuhlman, Henry . .	"Cape-Hood Water-Proof" . . .	Water-proof garments . . .	654
Kupfer, John B. . . .	Letters "K. K. C."	Biscuits & crack'rs	856
do. do. . . .	"K. C." (for Kenosha crackers) .	do. do.	941
Kwong On Cheong[2] .	"U. S." in a diamond	Tea	409
Lacroix, A. L. . . .	Device of pine-apple shape, and words "Pine-Apple Strengthening Cordial Bitters," &c. . . .	Strengthening cordial bitters .	996
Laflin & Rand Powder Co.	Various devices, and "Laflin & Rand Powder Co., N. Y.," &c. .	Gunpowder . .	885
Landenberger & Co. .	Shield, with double-headed eagle, and firm-initials	Woven & knitted goods . . .	834
do. do. .	do. do. do.	do. do. .	835
Landsberg, Silvius . .	"Genuine Virgin Gold Plate," and eagle	Jewelry and watches . .	419
Landsberger & Co.[3] .	Picture of three four-winged bees, for the letter "L."	Wild-blackberry bitters . .	814
Langdon Manuf. Co. .	Letters "G. B."	Shirtings, &c. .	719

[1] See § 194, *ante*. [2] Chinese firm domiciled in the United States. [3] See § 273, *ante*.

Registrants.	Brief Description.	Class.	No.
Lamman & Kemp[1] . .	Words "Florida Water"	Toilet-perfume	1094
Laroche Frères du Martinet	"Laroche Frères du Martinet," with monogram of "V. E. Mauger"	Writing-paper and envelopes .	994
Larrabee & Sons, E. .	Engraving of the "Battle Monument" of Baltimore, and words "Monumental Factory" . . .	Leather . . .	1071
Lawrence, B. & P. . .	Shield, with *fleur-de-lis*, &c., "warranted pure linen"	Writing-paper .	937
Lawrence & Sons, D. .	"Medford Rum," &c.	Medford rum .	165
Lear, Peter	"Lear's Lung and Spine Protector"	Apparel for protecting lungs	569
Leberman & Co. . .	"Primrose Soap"	Soap	189
do. do. . .	"Philada. Soap Co., Phil.," with monogram of "P. S. C." . .	do.	185
Le Clercq, Arthur . .	Pictures of "Copying Press, Earth, and Mercury"	Copying presses	731
Lee & Bro.	"A. R. L."	Medicine . . .	333
Lesley, Alex. M.[2] . .	"Zero"	Refrigerators and water-coolers	664
Lester, Felix E. . . .	"Green Mountain Beer"	Beer	483
Levi, Lewis	Lozenge, and "Manhattan Fine Shirts"	Shirts	179
Lewenthal & Co., R. .	"R. Lewenthal & Co.," with monogram of "H. & M."	White lead . .	769
Lewis & Co., A. K. . .	Kettle suspended over fire, &c. . .	Whiskey & bitters	275
Lincoln & Co., Geo. S.[3]	"Molasses-Gate," in raised letters	Molasses-gate .	146
Lippiatt Silver Plate and Engraving Co.[3] . .	Mythological device, double-headed bird, &c.	Silver & plated ware	41
Littlefield, Alvah . .	Device, reversed Q, &c.	Quinine tonic bitters. . . .	1091
Loring, John P. . . .	Shield, antique letters "J. P. L.," monogram	Hosiery, trim'ngs	363
Lovett, Jane	Rings, containing "Mrs. Jane Lovett's Nipple-Salve"	Nipple-salve . .	508
Low & Co., C. A. . .	Letter "L," inclosed in diamond-shaped lines	Tea	240
Lowell Manuf. Co. . .	Picture of machinery, and of a carpet rolled	Carpets . . .	132
Luckemeyer & Co., K.	"Eugenie"	Gloves . . .	864
Luscombe & Co., T. T.	"Silver Polish Bath Brick," &c. .	Polishing-brick .	805
Lynch & Buckingham .	"Huntoon Governor"	Governors for steam-engines	334
Lynch & Co., J. A. . .	Propeller-wheel, bearing the words "The Huntoon Governor" . .	Huntoon steam-governors .	68
Mallory & Co., J. F. .	Shield-shaped symbol	Canned goods .	1093

[1] Registered in consequence of decision referred to on p. 559.

[2] See § 273, *ante*.

[3] Not described in specification.

Registrants.	Brief Description.	Class.	No.
Mayer Brothers & Co. .	Representation of a fish, and letters "H. K."	Cherry-juice . .	1038
McBeth, Bentel, & Margadant	"The Universal Wood Worker" .	Wood working .	381
McBride & Co., S. W. .	"White Lilly"	Soap	1058
McComb, James J. . .	"Arrow-Tie"	Cotton-bale ties	314
do. do. . .	"McComb," with drawing of an arrow	Cotton-bale bands and ties . .	171
McComber, Joel . . .	"The McComber Last," with figure	Boot & shoe lasts	250
McConnell, Porter, & Co.[1]	"Scioto"	Fire-br'k, tiles, &c.	510
McCutcheon, Gordon, & Co.	"Red Sea," and "McCutcheon, Gordon, & Co."	Flour	747
McDermott, Reddington, Hostetter, & Co.	"Yerba Santa," lettering, devices, &c.	Medicine . . .	69
McKee, John	"McKee's Corn Salve," and figures	Corn-salve . .	451
McKennon, J. W. . .	Monogram, composed of the letters "B. C. T. D.," &c.	Chemical test and detector for bank-checks	836
do. do. . . .	"Commercial Safety Paper," &c. .	Bank-checks, &c.	981
McKeon, Thomas . .	"Iron Crown Paint," and two sailors	Paint	484
McKinnon, John A. .	Words "McKinnon's Colic Cure," printed on a horse	Medical compound	42
McLean & Co., Samuel[2]	"Railroad Brand," locomotive, wild animals, &c.	Worsted goods .	136
Maddox, William . .	Elaborate device, two obelisks, one having on it the words "Maddox Japanese," the other "Cough Balsam"	Cough balsam .	62
Magan, M. H. M. . .	Frog drawing a box, on which is "Cleansing Powder"	Cleansing powder	865
Maguire, I. & C. . . .	Pass in the Andes Mountains, two natives leading llamas, cundarango plant, &c.	Medicine . . .	896
Maillard, Henry . . .	American eagle, &c., serpents, anchor, &c.	Confectionery and chocolate . .	870
Mallory & Co., D. D. .	Diamond-shaped figure, and firm-name.	Canned oysters and fruit . .	985
Manhattan Cloth and Paper Co.	Circle with firm-name, figure of Indian with bow and arrows .	Cloth and paper	688
Mansfield, G. H. . . .	Picture of a fish	Fish-lines . . .	509
Marcelin, Warren, & Co.	Word "Sulphurine"	Disinfectants, &c.	629
Marley & Cook . . .	Monogram of names, &c., "The Acme Shirt"	Shirts	897

[1] See § 193, *ante*.

[2] Not described in specification.

Registrants.	*Brief Description.*	Class.	No.
Martin & Co.[1]	Fancy shield with device	Whiskey . . .	210
Martin, J. L.	Female head, with word "Ozoami"	Preparation for the hair .	58
Marx & Rawolle . . .	Monogram, "R. T. G. C.," &c. . .	Glycerine soap .	364
Maryland Fertilizing & Manufacturing Co. .	Words "Tobacco Food"	Fertilizers . .	645
do. do. do.	Representation of palmetto-tree, and "Cotton Food"	do. . .	646
do. do. do.	*Cancelled*	do. . .	647
Massonneau, Charles F.	"Arnica and Iodine," portrait of manufacturer, and "Trade-mark"	Strengthening plasters . .	450
Mason Manuf. Co. . .	"Mason's Improved"	Fruit-jars . .	276
Mathews, David P. . .	Monogram "D. P. M."	Medical compound for cattle . .	499
Mauger, Victor E. . .	"Wharfedale"	Printing-presses	826
do. do. . .	"Goodall Playing Cards"	Playing-cards .	556
do. do. . .	"Hughes & Kimber Litho machines," and arrow	Printing machinery & materials	886
do. do. . .	"Bichromatic"	Playing-cards .	980
Maw, Son, & Thompson, S.	Monogram, "S. C. M. M. T.," elaborate	Surgeons' ins'ts	430
Maxwell & Clarke . .	"Game Cock"	Paints	1007
Mayo, Israel C. . . .	"Piscatine"	Preserved fish .	633
Mayo, Urial K.[2] . . .	"Mayoline"	Artificial teeth .	904
Meneely, E. A. & G. R.	"The Meneely Bell-Foundry" . .	Bells	935
Mercantile Loan and Warehouse Co. . .	Words "Safe Sure," so arranged that same S answers for both words	Stationery, and mem. books .	851
Merrill, R. S., W. B., and J. A[3]. . . .	"Mineral Sperm Oil"	Hydrocarbon oil	557
Messinger, Charles R. .	"F. G."	Smoking-tobacco	558
do. do. . .	"C. S."	do.	559
do. do. . .	"Granger"	Chewing-tobacco	570
do. do . .	"One A Better"	Smoking-tobacco	1041
Meyer, Julius W. . .	Label, with crown, and monogram of dealer, &c.	Axes	43
Miami Powder Co. . .	Mounted cannon, and "Miami Powder Co.," &c.	Gunpowder . .	909
Michigan Stove Co. .	Arms of Michigan, and words "E Pluribus Unum," &c.	Stoves, &c. . .	982
Middlesex Co. . . .	"Middlesex Yacht Cloth" . . .	Woollen cloth .	655
Milhau's Sons, J. . .	Words "Lanoix Vaccine" . . .	Vaccine . . .	837
Millard, E. R.	Monogram of letters "D.C." in star	Dressing comp'nd	190
Miller, Albert W. W. .	"Men's Furnisher"	Gentlemen's furnishing goods	258

[1] Not described in specification.

[2] See § 217, *ante*.

[3] See § 273, *ante*.

Registrants.	Brief Description.	Class.	No.
Miller & Bro.	Eagle Shirt Factory, and picture of an eagle	Shirts	613
Mills, Johnson, & Co. .	"R. Bond, Bourbon Co., Ky.," and two arrow-heads	Whiskey . . .	191
do. do. do. .	"T. O. P., 1858, Paris, Ky.," and two triangles	do. . . .	192
do. do. do. .	"I. Seawright, Bourbon Co., Ky.," eight-pointed star	do. . . .	193
do. do. do. .	"T. Williams, Bourbon Co., Ky." with anchor	do. . . .	194
do. do. do. .	"S. N. Pike's Whiskey, Cinn, Ohio," with "XXX" . . .	do. . . .	215
do. do. do. .	"John Frazer, Paris, Ky., Bourbon"	do. . . .	201
do. do. do. .	"S. N. Pike's Magnolia Whiskey," diamond, &c.	do. . . .	241
do. do. do. .	"Dave Jones' Paris, Ky., Bourbon"	do. . . .	461
do. do. do. .	"Bourbon," and two spear-heads .	do. . . .	462
do. do. do. .	"A Wickliffe," arranged in semi-circle	do. . . .	463
Mitchell, Samuel J. .	"Franklin Lightning Rod Factory"	Lightning-rods .	354
Molesworth, William .	"Wm. Molesworth, M.D., Vaginal Injecting and Vacuum or Suction Syringe," with figure . .	Vaginal injecting syringe . .	838
Moline Plow Company [1]	Monogram, &c.	Plows & cultiv'rs	251
Moller & Sons, William	Pyramidal figure, with fac-simile .	Sugar, syrup, and molasses . .	150
do. do. do.	A parallelogram, and word "Sirup"	Syrup	195
do. do. do.	"Diamond Syrup"	Syrup & molasses	348
do. do. do.	"Wm. Moller & Sons' Block Sugar"	Sugar	349
Monies & Pughe . . .	Peculiar five-pointed star	Crackers . . .	382
Monks & Sons, J. A. .	Stag or elk's head, and words "Douglass Elkhorn"	Whiskey . . .	355
do. do. do. .	"J. A. M." and various words . .	do. . . .	410
do. do. do. .	"J. A. M." and "Licking Valley Bourbon," &c.	do. . . .	411
Moore & Co., Jesse . .	Stag's antlers, above firm-marks .	do. . . .	322
Moore, Thomas E. . .	"Pure Hand-Mash Copper Whiskey," and figure of a man stirring a mash-tub	do. . . .	412
do. do. . .	"Pure Sour-Mash Copper Whisky," with figure of man	do. . . .	656
do. do. . .	"Pure Sweet-Mash Bourbon Whisky," with cut of tub	do. . . .	657
do. do. . .	Sheaf of rye, and words "Pure Old Rye Whiskies"	do. . . .	711
Moore & Co., J. C. . .	"Argus Oil Co.," eye and arrows .	Oils, wax, & tallow	827
Moorman, C. P. . . .	"C. P. Moorman — Old Bourbon," with crown and cross	Whiskey . . .	63

[1] Not described in specification.

Registrants.	Brief Description.	Class.	No.
Moorman & Hardy [1] .	Picture of an English crown, and fac-simile of a barrel of very peculiar construction	Whiskey . . .	64
do. do. . .	"J. H. Cutter, Old Bourbon," "Pure Old Rye," &c. . . .	do. . . .	90
Morehouse, Charles L.	"Arctic Machinery Oil"	Machinery oil .	151
do. do.	"Crystal Head Light Oil" . . .	Illuminating oil	152
do. do.	"Amberline Machinery Oil" . .	Lubricating oil .	153
do. do.	"Zepher Wool and Factory Oil" .	Factory oils . .	154
Morgan's Sons, Enoch .	"Sapolio"	Polishing comp'd	323
do. do. do.	Human face reflected in a pan . .	do. do.	324
Morison, Son, & Hutchinson [2]	"The Star Shirt," with six-pointed star	Shirts	202
Morrison & Co., James	Dial and Magnetic Needle, &c. . .	Sugar-cured hams	697
Morse Brothers . . .	Word "Sun," with or without pictorial design	Prepared plumbago . . .	1042
Murdock, Jr., E. . . .	"Sunshine Polish Oil"	Substitute for linseed-oil . .	614
Myer, Daniel W. . .	"D. W. M." and figures "1840" in a triangle	Ague and fever mixtures . .	1014
Myers & Co., E. [3] . .	Winged shoe, monogram, and "Shoe Fly"	Prize candy . .	44
Myers & Co.	A star, with title of product . . .	Wool-detergent and bleaching compound .	986
Myers & Co., Lawrence	"M" in heraldic garter, in oval form.	Gin	365
do. do. do.	Cluster of grapes, "Royal Sherry," &c.	Sherry wine .	366
Myers & Drummond .	"Golden Slug," &c.	Pressed chewing-tobacco . .	1020
do. do. .	"Pancake"	do. do. .	1021
Nason, James H. . .	Palette with pencil and brushes, and name, &c.	Pigment . . .	229
National Rubber Co. .	Word "Anchor," picture of anchor.	Rubber goods .	783
National Yeast Co. . .	Eagles, with words "National Dry-Hop Yeast"	Yeast	127

[1] The certificate in this case has been considered by the U. S. Circuit Court, Cal. Dist., and annihilated (Moorman *v.* Hoge, Am. Law Review, vol. vi. p. 365, reported in full in California journals) The mark is described in the specification as consisting of a barrel of peculiar construction, "of extraordinary length, being thirty-eight inches, made with sixteen wooden and four massive iron hoops; staves one and one-fourth inch thick, and has a capacity of fifty gallons," &c. It is also set forth that the brands and devices were bought by the applicants for the sum of ten thousand dollars. The Office erred in admitting the application to registration.

[2] This mark has been sustained in the U. S. Circuit Court (Morison *et als. v.* Case, 9 Blatchford, 548, and Official Gazette, vol. ii. p. 544), and a perpetual injunction granted. But lest the language of the specification might mislead, it would be well not to follow the description as a precedent. — It runs thus: "The name of the 'Star Shirt,' both in this form, 'The Star Shirt,' and with the device of a six-pointed star in place of the word 'Star,' . . . and also the said device of the six-pointed star used in connection with the said words 'The Star Shirt.'" The Office is now more particular. A trade-mark must be *invariable*, as well as definite and certain.

[3] Not described in the specification.

Registrants.	Brief Description.	Class.	No.
National Wood-Manufacturing Co. . . .	"Wood Carpeting," and two stars.	Wood-carp'g. &c.	519
Navassa Phosphate Co.	"Azotin," in diamond-shaped border	Concentrated ammoniate . .	665
Nellis, Aaron J. . . .	Monogram "A. J. N.," with hay-forks, &c.	Hay-elevators, &c.	124
New England Felt-Roofing Company . . .	Figure of a bee-hive with bee . .	Felt roofings . .	721
Nichols & Co., J. R. .	"Cincho-Quinine"	Medicine . . .	707
Niederlander & Co., J.	Figure of a Chinaman	Bitters	898
Nones & Co., A. . . .	"Fleur de Lys," with cut of lily-flower, and "Brandywine.—:xxx:—A. Nones & Co." . .	Flour	784
North-Western Horse-Nail Co.	"Western Horse-Nail"	Horse-nails . .	277
North-Western Fire-Extinguisher Co. .	"The Babcock Fire-Extinguisher"	Fire-extinguisher	856
Norwalk Iron Works .	Star, and words "Steam Pump" .	Steam-pumps .	1015
Oakley, Jesse	Words "Maltese Soap"	Soap	648
do. do.	Figure of a Maltese cross	do.	770
O'Donnell, J. M. . .	"J. M. O'D." as a monogram, with various other devices and symbols	Whiskey . . .	649
do. do. . .	Monogram "J. M. O'D.," and "Jas. M. O'Donnell & Bros." .	do. . . .	850
do. do. . .	"J. M O'D.—O. K. No. ONE—Jas. M. O'Donnell"	do. . . .	651
Ohio Valley Piano Co.[1]	Words "Valley Gem"	Pianos	795
Oldberg, Oscar . . .	Word "Borobalsamine"	Aqueous solution of balsamic gums	630
Olzendam, A. P.[2] . .	Crown in a wreath, "A. P. O." .	Woollen hose .	10
Oppelt, Edmund J. . .	"Standard"	Tobacco . . .	203
Orth, Adam[2]	Monogram in diamond	Bitters	211
Ottenheimer, Rothschild, & Co.	Letter "G"	Corsets . . .	1008
do. do. do.	Letters "D | d." &c.	do.	759
do. do. do.	Word "Comet"	do.	760
do. do. do.	"W. F.," with ornamental border .	do.	761
do. do. do.	"G. S." do. do. do. .	do.	762
do. do. do.	"X. L." with or without anchor .	do.	1043
do. do. do.	"B."	do.	1044
do. do. do.	"D."	do.	1045
Page, G. F. and C. T. .	"Patna Cow," with words "Page's Patent, May 8, 1866"	Leather . . .	105
do. do. do.	"Page's Patent Tanned Leather," &c.	do. . . .	441
Palmer, Elihu B. . .	"Palmer's Spanish Dressing" . .	Dres'g for leather	615
Palmer, Kennedy . .	Diamond, with monogram "P. H. & G. 1871"	Advertising medium . . .	500
Palmer, Lorin[3] . . .	Crown, wreath, and words "Golden Crown"	Cigars, snuff, and tobacco . . .	106

[1] See § 273, *ante*.

[2] Not described in specification.

[3] Palmer *v.* Harris, 60 Penn. 156.

Registrants.	Brief Description.	Class.	No.
Palmer, O. M.	Shield with a mortar, &c.	Salve	212
Parodi, Enrique	"Superior de J. Mª Vichot," &c.	Cigars	815
Partridge & Co., J. C.	Eagles and young, and rock, &c.	Cigars, tobacco, and snuff.	65
Patent Elastic Felt Co.	"Patent Elastic Felt," and anchor.	Prepared cotton	464
Patent Metal Co.	Monogram, "C. L. S."	Metal	73
Paton & Co.	Word "Huguenot"	Cotton sheetings and flannels.	839
Paullin, Mary A.[1]	Cross-enclosed words "Mrs. Marple's Salve"	Salve	857
Pavenstedt & Co., E.	Representation of a spread fan	Tea	720
Peake, William I.	An otter on a rock, & word "Otter"	Alpaca	259
do. do.	A beaver, and words "Improved Silk Finish"	Mohair	260
do. do.	A marten sable, and words "Turkish Mohair Brilliantine"	do.	261
do. do.	Star, shield, &c.	Dress-trimmings	1079
Pearl, Adolph	"Green Seal"	Tobacco	350
Pease, Francis S.	An eagle, and the words "German Lead"	White lead, &c.	881
Peck & Snyder[2]	Red ball, & words "Dead-red Ball"	Base balls	46
Pecker & Co., Seth E.	View of Boston Custom-house, & words "Custom-House Gin"	Gin	616
Pemberton, John S.	"Compound Syrup of Globe-Flower," and cut of flower	Cough-syrup	816
Pemberton, Taylor, & Co.	Hercules and the Gorgon, with words	Medical comp'nd	166
Penn, William H.	Monogram "W.H.P.," and "Grape Wine Bitters"	Bitters	938
Perrin, Marie Eulalie	Monogram, "J A," "Cyano, Pancreatin"	Medicine	367
Perry & Co.	"New American"	Cooking-stoves	278
Pettit & Barker	"Pettit's American Eye-Salve," &c., with picture of human eye	Medicines	817
Phalon & Son	"I love you," and picture of eye, &c.	Perfume	325
Phelan & Collender	"The Standard American Billiard-Table," &c.	Billiard-tables	242
Phillips, Charles H.	Monogram containing letters "P. H. I. L. L. I. P. S."	Essential oils and other chemicals	1072
Phillips & Co., E. R.	"E. R. Phillips' Scotch Liniment," in border	Medicine	357
Phosphor-Bronze Co.	Initials "P. B. C."	Bronze alloys	698
do. do.	"Sligo"	Bronze alloys, &c.	699
Pierce, Henry L.	A star, with "German Sweet Chocolate"	Chocolate	882
Pike, Amasa H.	Woman applying garter, & "Magic Garter"	Garter	298
Pilkington, Edwin T.	"The Fruits and Flowers," illust'd.	Smoking & chewing tobacco	279

[1] See § 246, *ante*.

[2] Not described in specification.

Registrants.	Brief Description.	Class.	No.
Pitt & McCann, W. T. & C.	Figure of a crescent, and word "Crescent"	Rye whiskey .	1031
Place & Co., William H.	"Colorine"	Dyeing & coloring compounds	252
Plumb & Burdict . .	Diamond-shaped figure, "Bolt M. F. R. S." and monogram . . .	Carriage bolts .	967
Pohalski & Co., Pincus	"Monte Christo," elaborate design, figures, ship, and military equipments	Cigars	581
Pomeroy's Sons, L. .	"West Point Cadet," in rustic letters	Gray cloth . .	196
Pommer, Frank L. .	"Malt Extract Lozenges," &c. . .	Lozenges . . .	905
Pope & Baldwin . . .	Picture of corn-planter, firm-title, &c.	Corn-planter . .	91
Popham, William H. .	Figure of a pig or hog	Hog's lard . .	987
Pratt, Charles . . .	"Astral Oil"	Oils	107
Prescott, James L.[1] . .	Monogram on scroll	Stove-polish . .	109
Procter & Gamble . .	Circle, enclosing the moon, stars, human profile	Soaps, candles, oils, &c.	887
Purley & Co., John . .	Egyptian landscape, camels, Bedouins, &c., and words "The Water of Life"	Medicine . . .	906
Putnam, Silas S. . .	"The Putnam Curtain Fixture" .	Curtain fixtures	422
Rall & Co., J. M. . .	"Oil of Soap," and two barrels .	Oil of soap . .	617
Ralph, Alexander . .	Perched eagle, and letters "R. S. S."	Snuff	748
Rand, Jr., W. J. . . .	Venus, and words "Sea-Moss Cough-Candy, Troches, & Syrup" . .	Sea-moss cough-candy, troches, and syrup . .	125
Randolph, R. R. . . .	Portrait of King William, &c. . .	Tobacco . . .	110
Ransom, Lewis E. . .	Large letter "R" and "Trade Mark"	Annatto . . .	1073
Rappleye & Knight . .	"The Dollar Reward Soap," &c. .	Soaps	431
Rasin, R. W. L. . . .	Picture of an island in the Caribbean Sea, and words "Soluble Sea-Island Guano"	Soluble Sea-Island guano . . .	45
Rawson & Philbrick .	Picture of palm-tree, lettering, and signature	Cigars	92
Redington & Co. . .	"Cabinet Pipe Organ"	Cabinet organs .	336
Redway & Burton . .	"Century"	Stoves	520
Reed, William H. . .	Lamp, with word "Sunlight" . .	Burning-fluid .	708
Remington Empire Sewing-Machine Co. . .	"Remington Empire"	Sewing-machines	552
Renauld, François, & Co.	Medallion having printed thereon "H. Piper & Co., successors to Heidsieck à Rheims, Marne," and words "Renauld & François, sole Importers in the U. S."	Champ'ne-wine	1051
do. do. do.	Crest, and words "Old Brandy; trade-mark on capsules and cases; J. & F. Martell, Cognac," &c. .	Brandy . . .	1052

[1] Not described in specification.

Registrants.	Brief Description.	Class.	No.
Renne & Sons, W. . .	"Renne's Pain-Killing Magic Oil"	Medicine . . .	806
Reno, Griffen	"Dr. Reno's Catarrh Specific," and "Eureka"	do. . . .	280
Reud, William R. . .	"Oxyzone"	Medicines . .	1032
Reynolds, Benjamin K.	Figure of a horseshoe, "B. K. Reynolds, Pure Bourbon, Harrison Co., Ky."	Whiskey . . .	221
Rice, Mathias Joslyn .	Triangles, with letters "M. J. Rice," &c.	Picture frames,&c.	413
Rich & Burlingham .	Foliage and fruit of the cucumber-tree, &c.	Wood pumps .	243
Rich & Co., Isaac . .	Letter "I," in combination with two fishes	Spiced salmon .	618
Richards & Sons, I. D.	Thistle, &c.	Gin	560
do. do. do.	A single lily, with words "White Lily," &c.	Gin	137
do. do. do.	A shell, and the word "Shell" . .	do.	485
Richards, Robert G. .	Rising sun, with the letter "R." .	Burning-fluid .	204
Richardson, Boynton, & Co.	"Baltimore, Richardson, Boynton, & Co."	Fire-place heaters	501
Richardson, Frank L. .	"Dr. Kingford's Celebrated Pills"	Medicine . . .	486
Richmond, C. C. . .	Word "Crosby's," with picture or without	Axle-oil . . .	771
Ridenour, Coblentz, & Co.	Picture of a Hindoo doctor, and words "Hindoo Pain-Conqueror," blown in the glass . . .	Liniment . . .	93
do. do. do.	"Arabian Horse-Powders," with heads of seven animals . . .	Medicine . . .	186
Roberts & Co., J. E. .	"Longines"	Watches . . .	997
Roberts, Robert J. . .	"Diamond Edge"	Cutlery . . .	108
do. do. . .	"A Luxury.—R. J. Roberts' Razor-Steel Scissors," &c.	Scissors . . .	262
do. do. . .	"To the ladies. The proprietors of the Patent Parabola Needles," &c.	Needles . . .	358
do. do. . .	"R. J. Roberts' Diamond-Edge Razor"	Razors . . .	299
do. do. . .	"An Exquisite pleasure to shave with," "Diamond-Edge Razor"	do. . . .	300
do. do. . .	"R. J. Roberts' Razor Steel" . .	Razor steel . .	368
Robbins, Horace T. .	"The Storm King Improved" . .	Umbrellas . .	315
Robur Distillery Co. .	Word "ROBUR"	Spirits	1097
Rock River Paper Co.[1]	"Building Paper"	Paper	281
do. do. do.[1]	"Prepared Plastering-Board, or Paper"	Prepared plastering paper . .	634
Rockwood Photo-Engraving Co.	Device of rising sun, and words "Photo-Chromo Lith." . . .	Photo-engravings	337
do. do. do. .	Device of rising sun, and words "Photo-Engraving"	do.	338

[1] Applicant claims origin of article.

Registrants.	Brief Description.	Class.	No
Rogers & Burchfield .	Monogram of letters "R" and "B," and words "Siberian Iron" . .	Sheet-iron . .	595
Rogers & Bro. . . .	Hand holding thunder-bolts . . .	Silver-ware . .	796
Rogers, J. & J. . . .	Circle, with the letter "R" therein	Wrought-iron goods . . .	619
Roose, William S. . .	View of Stockton Hotel at Cape May, &c.	Cigars	80
do. do. . .	A print, with the name "La Manola"	do.	81
Rose, Buckley A. . .	"Rose Burning-Fluid," with picture of a rose	Burning-fluid .	282
Rose, Joseph[1] . . .	"Rosebaume"	Perfume . . .	807
Ross & Co., C. H. . .	"Monumental," &c.	Liquors . . .	119
do. do. . .	"Thompson," and "Pure Rye Whiskey"	Whiskey . . .	339
do. do. . .	"J. Jackson," "Old Rye Whiskey, 5 years old"	do. . . .	340
do. do. . .	"Patapsco"	do. . . .	550
do. do. . .	"Monongahela," "Mountain Dew," and "Old Rye Whiskey" . .	do. . . .	652
Rowe, Graves, & Co. .	Map of the State of Ohio, &c. . .	Vinegar and cider	283
Rowland, Raphael, & Co.	"Star Monogram Whiskey," star and monogram	Whiskey . . .	954
Rubber Paint Co. . . .	"Rubber Paint," with picture of tree, &c.	Rubber paint .	582
Russell & Seabold . .	Statuary design of Hercules and Lichta, &c.	Medicine . . .	808
Russell, Thomas . . .	"Little Belt," with ornamental devices	Cigars	1016
Ryan, William[2] . . .	Star, wreath, &c.	Hams	11
San Francisco Pioneer Woollen Factory .	Medal, with words "San Francisco Pioneer Woollen Factory," &c.	Woollen fabrics	420
Saratoga Seltzer-Spring Co.	Anchor, with "Saratoga Seltzer-Spring Co., 1870"	Mineral-water .	213
Schember, John . . .	"Dr. Hoffman's Celebrated German Liniment"	Liniment . . .	263
Schenck, C. S. . . .	Two lions erect, and label with words "Schenck's Water-Proof Tags and Labels"	Tags and labels	1046
Schmidlapp, Bros. . .	Cave, with sea-nymphs, and word "Iola"	Cigars . . .	316
Schmidt & Curtius . .	"Musical Note-Paper," with a stave of music	Letter-paper . .	968
Schoeffel, Adam . . .	Picture of crowing rooster, and word "Excelsior"	Sugar-cur'd hams	1059
Schrauder, George[3] .	"Bouquet"	Cured meats .	955
Schriber, James . . .	"A. A."	Smoking-tobacco	988
Schroeder, Herman . .	Bust of woman, & words "Schroeder's Imperial Balm"	Cosmetic . . .	317

[1] See § 217, *ante*.
[2] Not described in specification.
[3] See § 661, *ante*.

Registrants.	Brief Description.	Class.	No.
Schuchardt, Frederick	"Meder Swan Gin," and figure o swan	Gin	502
do. do.	"Swan Gin"	do.	503
Scott, Jane	Shield supporting dog, and words "The University Medicines," &c.	Medicine	452
Scranton Stove & Manufacturing Co.	Name of company, and words "Merry Christmas"	Stoves	287
do. do.	"The Excelsior Range"	Ranges	342
Seaman, Robert F.	"Wetterstedt's Patent Metallic Composition"	Paints	437
Seely, Samuel S.	"Seely's Liquid Cough and Heave Cure"	Medical compound	120
Seibert, Jacob H.	Two figures, representing condensers, &c.	Condensed lye	785
Selby & Co., James	Shield, with words "Union Planter"	Corn-planters	144
Seligman, Jacob	Words "Little Jake," &c.	Men's clothing,&c.	828
Seltzer & Miller	"Silver Brook Whiskey"	Whiskey	301
Shannon, Albert F.	"Ferdinand Summerfield's Oriental Balm"	Medicine	465
Sharp & Craig	"Non-Explosive," with figure of oil-can	Lamp-oil	736
Sharp, Edward S.	"T. M. Sharp's Celebrated Dyspepsia Pills"	Medicine	423
Sharp, Joel	Picture of machinery, with figure of engineer, &c.	Steam-engine	133
Shepard & Seaman, H. W. & R.	"The Iron Clad Can Co."	Sheet-metal wares, &c.	343
Sherriff, John L.	"Sherriff Palm"	Palm-leaf brushes	344
Shinnick, Woodside, & Gibbons	"Sensation"	Cooking-stoves	989
Shumway, F. P.	"The Partridge Fork"	Agricultural forks	786
Sibley, Solomon	Three lines, and words "Sibley's Trade-Mark," "Cut by this line," "For a perfect fit"	Shirt-bosoms	1063
Silbermann, Heinemann, & Co.	Letters "S. H. Co.," interlaced	Fringes, rib'ns,&c.	134
do. do.	"Honest Measure"	Cords, fringes, ribbons	172
Silicate Slate Co.	Open book, with words "Silicate Book-Slate Co."	Slates, &c.	205
Simes, I. F.	"Egg Soda"	Soda-water	829
Simpson & Co., E.	Spread-eagle, holding star, &c.	Wines and liquors	620
Singer, Nimick, & Co.	"Star Cast-Steel"	Cast-steel	487
Sleeper, Wells, & Aldrich	"Triumph"	Canned vegetables, &c.	700
do. do. do.	Shield, or shield-like border, with name, &c.	do. do.	701
Smith, Crosby, & Co.[1]	Portrait of Gen. Phil. Sheridan, and the words "Phil. Sheridan"	Cigars	244

[1] See § 218, *ante*.

Registrants.	Brief Description.	Class.	No.
Smith, Elisha T.	"E. T. S.," in double oval, &c.	Yeast	561
Smith, Iliram[1]	"Star of the West Pump," and star	Pump	432
Smith, Irving C.	"Goodenough"	Oil-cans	888
Smith, James T.	A standing guanaco, and word "Guanaco"	Umbrellas and parasols	94
Smith, Jesse S.	"Dr. J. S. Smith's Detergent Powder," portrait, signature, &c.	Detergent powder	70
Smith, Nathaniel	"Magnetic Balm"	Medicine	797
Smith, Samuel	"Excelsior Frying-Pan"	Frying-pan	284
Smith, Thos. L.	"Strawberry"	Gin	551
Smith, W. P.	Half-circle symbol, and words "Centrifugal Earth Drill"	Driven-well points and drills	990
Smith & Co., F. E.	"F. E. Smith & Co.'s Crushed White Wheat"	Crushed white wheat	858
Smith & Co., H. D.	Letter "S," in circle	Carriage hardware	521
Smith & Co., J. Lee	Illustration of a crown	Paints	173
Smith & Harris	A curve, formed of 2 semicircles, &c.	Fertilizers	245
Smith & Son, John C.	"Live Indian," with illustration	Cigars	230
Solms, Sidney J.	"Pekin Mills," and "Hoosier Doe-Skins"	Woven fabrics	522
Sorrento Wood-Carving Co.	Words "Sorrento-Wood Carving"	Wood-carvings	689
Soule, Kretsinger, & Co.	"Gold Medal," and monogram "S. K. & Co."	Agricultural implements	1017
Southern Fertilizing Co.	An anchor, and letters "S. F. Co.," &c.	Fertilizers	866
Spang, Jacob D.	Barrel, with proprietor's name, lamps, &c.	Illuminating-oil	138
Spencer, Albert H.	"Reliance"	Clothes wringer	826
Spencer Manuf. Co.	Diamond-shaped symbol on frame, to signify "Diamond Spectacles," &c.	Spectacles and eye-glasses	1023
do. do.	Crescent-shaped symbol on frame, to signify "Crescent Spectacles," &c.	do. do.	1024
Spies, Francis[2]	Bell, and words "Bell Brand Oils," &c.	Kerosene and spirits of turpentine	139
Springfield Iron Works	"The Joe George Plow"	Plows	1009
Staab, Charles P.	"Semper Paratus," on an escutcheon, which bears the upper part of lion, &c.	Artists' materials	621
Stanley, David A.	"Club-House Favorite"	Whiskey	488
Starkey, George R.	"Oxygenaqua"	Compound oxygen-water	1064

[1] See § 274, *ante*.

[2] Not described in specification.

Registrants.	Brief Description.	Class	No.
Starrett, Helen E.[1] . .	"Starrett Patent Overshoe," &c. .	Overshoes . .	871
Steel & Co., E. T. . .	Combination of the letters "H. W. and H."	Cloth or men's-wear . . .	147
Steele & Price . . .	Word "Cream," &c.	Baking-powder .	1085
Steffan & Co., F. . .	Shield & crown, lions & monogram	Shawls . . .	397
Stern & Co.	"Champion Shirts"	Shirts	991
Sternberger, Leopold .	Balance, shield, and word "Centennial"	Shirts, shirt-fronts, &c.	709
Sternberger, L. & S. .	Circle, crescent, &c., and word "Eclipse"	Shirts, draw'rs, &c.	253
Stevens, Alfred T. . .	"Stevens' Combination for Staining, Tinting, or Coloring," with the monogram "A. T. S." . .	Colors and paints	907
Stevens, Thomas W. .	"V. G. & S." in monogram, and "Bazaar Shirt"	Shirts	908
Stewart & Co., A. T. .	Arms of U.S., Gt. Britain, Germany, and France, &c., very elaborate .	Dry goods . .	763
Stickney & Poor . . .	Globe, with latitudinal and longitudinal lines	Spices	674
do. do. . . .	Pot, ornamented with flowers and leaves	do.	675
do. do. . . .	Figure of a bull	do.	676
do. do. . . .	Cup and saucer, flowers, &c. . . .	Coffee	677
Stowell & Co. . . .	"Samuel Kidder & Co.'s Asthmatic Pastilles"	Pastilles . . .	622
Strain, John G. . . .	"J. G. Strain's Grecian-Post Split-Bottom Chairs, Delaware, Ohio," and cut of chair	Split-bott'm chairs	504
Straiton, Schmitt, & Storm	Three owls, words "Owl Segars," &c.	Cigars	126
Strasburger & Pfeiffer .	Escutcheon, and letter "G" . . .	Harmonicas . .	1065
Strasburger, Fritz, & Pfeiffer	Inverted truncated cone, with smaller cone	Toys & fancy g'ds	246
Stuart, Peterson, & Co.	"Sunnyside"	Heaters & stoves	710
Suire & Co., F. E. . .	Mortar and pestle	Chemicals . .	383
Swain, Earle, & Co. .	"Golden Mustard," and figure of a cruet-stand	Mustard . . .	919
Swalley, Jos. W. . .	"Sea-Foam Soap," and proprietor's name	Soap	1060
Swank, M. J.	"Centennial"	Cigars	942
Sweet, Barnes, & Co. .	Lozenge figure, with letters "S. B. & Co."	Cutters for harvesters . .	571
Swett & Crouch . . .	Firm-name, and words "Willow-Spring Ice," &c.	Ice	798
Tamin, J. M. O. . . .	"Phosphorine"	Alimentary & medical preparat'ns	943

[1] An existing patent.

Registrants.	Brief Description.	Class.	No.
Taplin, Horace . . .	A star, harp, trefoil, & clasped hands	Badges, medals, studs . . .	732
do. do. . . .	American flag and staff, and clasped hands	do. do. .	733
Taylor, A. S.	"Taylor's Champagne Nectar" .	A beverage . .	872
Taylor, De Witt C. & George F.	Word "Perfection"	Refrigerating apparatus . .	787
Taylor, Jr., E. H. . .	"O. F. C.," &c.	Whiskey . . .	1022
Tenney & Sons, W. H.	"Harper's Ferry Flour from White Wheat"	Flour	572
Teter & Hite[1] . . .	One star overlapping another, in cloud	All-healing liniment and morning-star lamp-oil . .	47
Thalheimer & Hirsch .	Word "Centennial," and pictorial designs	Shirts, draw'rs, &c.	809
The Tanite Company .	"Tanite," &c.	Emery-w'h'ls, &c.	1047
Thomas & Co., J. J. .	"Thomas' Smoothing Harrow and Broad-cast Weeder"	Harrows . . .	635
Thomas & Co., J. L. .	"Alexandra"	Refined petrol'm	999
Thompson, C. L. . .	Five-pointed star	Tonic or cr'm beer	789
Thompson & Steele . .	"Dr. Price's Cream"	Baking-powder .	95
Thompson, Steele, & Price Manufacturing Co.	"Dr. Price's Blood Enricher," &c.	Medicines . .	453
Thomson & Co., A. . .	"Crescent City," "Sugar Refinery," "A. Thomson & Co.," "Orleans Molasses," stars, crescent, &c. .	Molasses . . .	972
do. do. . .	"Crescent City," "Bouquet Syrup," stars, &c.	Syrup	973
do. do. . .	"Crescent City," "Louisiana Molasses," &c.	Molasses . . .	974
do. do. . .	"Pelican," "Molasses," & crescent-shaped symbol	do. . . .	931
do. do. . .	"Chalmette," "Molasses," and crescent	do. . . .	983
do. do. . .	Crescent-shaped symbol	Sugars, syrups, &c.	998
Thomson, Langdon, & Co.	Picture of a crown	Corsets, skirts, &c.	539
do. do. do.[2]	"Thomson's Royal Batswing" . .	Skirts	540
do. do. do.	"Thomson's Glove-Fitting Corsets," &c.	Corsets . . .	541
do. do. do.	Picture of corset, with zone-like section	do. . . .	542
do. do. do.	"Thomson's Glove-Fitting," with cuts	Skirts and corsets	543
do. do. do.	A cross, a crown, and words "The Crown Perfumery Company" .	Perfumery, &c. .	1025
do. do. do.	Picture of a crown, and words "The Crown Perfumery Company" .	do. .	1026
Thurber & Co., H. K. .	Autograph, &c.	Yeast powder .	14
do. do. do. .	Sheaf of wheat, with words "Century White Wheat Bourbon" .	Whiskey . . .	15

[1] Not described in specification.

[2] See § 273, *ante*.

Registrants.	Brief Description.	Class.	No.
Thurber & Co., H. K. .	"Century Whiskey," and monogram "H. T. & Co."	Whiskey . . .	889
Thurston, George B. .	"Mrs. Thurston's Celebrated Worm-Syrup"	Medic.-preparat'n	247
Tiemann & Co., D. F. .	Representation of a globe, paint-brush, paint-can, and the hand .	Paints, colors, and painting-materials . .	1039
Tilden & Co.	"Bromo Chloralum, Tilden & Co."	Medicine . . .	421
Tileston, William M. .	"Ginger, Tonic, Bitters, Wine, Spice," "W. M. T."	Ginger tonic bit'rs	899
Tilton & Co., J. E. . .	"Autographium"	Blank-books . .	734
Tinkham, F. J. . . .	Words "Lightning Polish" . . .	Polish for metals	859
Toppan & Winn, C. & M. F.	"Aquapelle"	Water-proof goods	111
Townsend, Elmer . .	Phrase "Cable Screw Wire," with or without picture	Boots and shoes	140
Townsend, Henry Elmer	"Cable Wire," with picture of piece of wire	do.	do. 264
do. do.	"Screw Wire," &c.	do.	do. 265
Trentman, Monning, & Son	"White Fawn Baking Powder," and figure of a white deer or fawn .	Baking powder .	1018
Trischet & Bondy, S. & J.	Figure of seated woman, holding shield and sword, eagle, words "Fast edges, trade-mark, full width," &c.	Velvet ribbons .	939
Truex, E. H.	"Cod-Liver Oil Jelly"	Cod-liver oil . .	764
Tucker, J. Augustus .	"Bay State Bone Superphosphate," &c	Fertilizer . . .	248
Tufts, James W.[1] . .	"The Arctic Soda Apparatus" . .	Soda water apparatus . .	678
Tully & Davenport . .	Female crowned head	Emery	641
Turner & Co., J. J. . .	Word "Excelsior"	Fertilizing comp'd	16
Turner, John P. . . .	"Victoria Jet"	Jewelry . . .	415
Tuttle, G. R.[2] . . .	"Sterling Cannel Coal"	Coal	818
Twamley, James[3] . .	Man's face, printed or stamped . .	Elastic webbing	860
Tyler, John T. . . .	Monogram, word "Deerustator," &c.	Deerustating compound for steam-boilers .	1087
Tyzick, James . . .	Diamond or lozenge shaped symbol, and words "Trade-Mark, Black Diamond," &c.	Emery wheels or blocks . . .	1061
Underhill Edge Tool Co.	"Crown Axe," with or without picture of an axe	Axes	840
Underwood & Co., Wm.	"Deviled Extremets," &c. . . .	Deviled extremets	82
Union Akron Cement Co.	"Akron Cement," &c., with picture of star	Akron cement .	141

[1] See § 273, *ante*.

[2] Not a mere geographical term, because registrant is sole owner of place.

[3] See § 584, *ante*.

Registrants.	Brief Description.	Class.	No.
Union Manuf. Co. . .	"Minnehaha Mills," figure of man, fall of water, &c.	Paper	187
University Publish'g Co.	Name, with banner and monogram thereon	School-books, maps, &c. .	868
U. S. Proprietary Medicine Co.[1]	Representation of corporate-seal .	Medical comp'ds	74
Utica Cement Co. . .	"Utica Cement Co.," stars, &c. .	Hydraulic cement	433
Van Wart, Son, & Co.	Stars and stripes, with the star and part of the collar of the order of St. Michael and St. George . .	Saddlers' h'dware	992
Ventilating Water-proof Shoe Co.	"Ventilating Water-Proof Shoe Co. Works," and picture of 3 boys .	Boots and shoes	583
do. do.	"Ventilating Water-Proof Shoe Co.," "Lic. Stamp"	do. do.	584
Victor Scale Co. . .	Word "Victor"	Scales	49
Vidvard & Sheehan . .	"Meehan's Malt Potteen," and Irish harp	Whiskey . . .	180
do. do. . .	Medal, with stars, and words "Gold Medal Kentucky Malt Bourbon"	do. . . .	226
Viele, Platt B. . . .	"Viele's Golden Laundry-Bluing"	Laundry-bluing	438
Vincent, Hathaway, & Co.	Lozenge-shaped border, lettering, and monogram of letters "V. H. & Co."	Ginger-ale . .	883
Walker, Joseph H. . .	"Walker" and "Boot," and star .	Boots and shoes	288
do. do. . .	Combination of words "Saddle," "Seam," and "Boot" . . .	Boots	932
Walker, Oakley, & Co.	"Walker Tannery," with device of tiger, wreath, &c.	Leather . . .	289
Walsh, Brooks, & Kellogg	Monogram "C. S.," and words "Old Cave Spring"	Whiskey . . .	489
do. do. do.	"Old Woodburn," and three links .	do. . . .	490
do. do. do.	Monogram "B. C.," "Old Buck Creek Whiskey," &c.	do. . . .	491
do. do. do.	Monogram "C. G.," "Old Cedar Grove Whiskey," &c.. . . .	do. . . .	492
do. do. do.[2]	"Paul Jones," and letters "W. B. & K." in lozenge	do. . . .	702
Walter & Fielding . .	"* Richmond * Metallic Paint" .	Paints	493
do. do.[3] . .	"Vieille Montagne Green" . . .	do.	494
Walter & Shaeffer . .	Demon holding six bottles of bitters	Pipifax bitters .	434
Walters, Edwin . . .	Crescent or new moon, and word "Orient"	Whiskey . . .	830
do. do. . . .	Crescent, & words "Spring Valley"	do. . . .	873
Walton, Whann, & Co.	"The Great Fertilizer — Whann's Rawbone Superphosphate" . .	Fertilizer . . .	75
do. do. do.	"Virginia Tobacco Guano" . . .	do. . . .	319
do. do. do.	"Carolina Peanut Guano" . . .	Commercial fertilizers . .	642

[1] Not described in specification.

[2] See § 218, *ante*.

[3] See § 193, *ante*.

Registrants.	Brief Description.	Class.	No.
Ward & Co.	Letters and figure in combination, "B 4 + A. N. Y."	Cutlery . . .	755
Ware, Marshall, & Co.	The word "Gavotte"	Gloves	596
Ware, Jr., Preston . .	Monogram of letters "W. A. R. E."	Boots & shoes .	1033
Warfield, Alex. . . .	Letter "S," within which are the words "Warfield's Cold-Water Soap. Best in the World" . .	Soap	59
Warfield & Co. . . .	"Mecca," with firm initials . . .	Lubricating oil .	145
Warren, Edwin A. . .	"Warren's Not Poisonous Hair-Restorer"	Hair-restorer .	445
Waters, C. & W. A. .	"Magnolia Gin," and flowers . .	Gin	514
Waterston & Son, George	Picture of a bee, "The First Wax-Maker"	Sealing-wax . .	1027
Watson, R. H. . . .	Shield and border, with cut of a ship	Druggists' sundries . . .	831
Wattles, Joseph W. .	Bust of an Indian chief, with coronet of feathers, and necklace of talons, &c.	Suspenders and elastic webbing	50
Wattson & Clark[1] . .	"W × C" in a parallelogram . .	Superphosphate	60
Wayne, Edward S. . .	"Wayne's Diuretic Elixir of Buchu, Juniper," &c.	Medicines . .	345
Weaver, James E. . .	Pearl wheat, letters "J. E. W.," and two ears of wheat	Wheat	623
Webber & Co., J. T. .	Cut of mortar, having the words "Webber's Strengthening Bitters"	Strength'g bitters	841
Weber, Bernhard . .	Three cherubs coloring a chair . .	Colors	597
Webster & Co., H. . .	Horse-shoe, and words "Kentucky Favorite," &c.	Whiskey . . .	142
Weed Sewing-Machine Co.	Letters "F. F.," for "Family Favorite"	Sewing-machines	51
Weed & Co., W. A. .	Angles, with letters "S. N. W. E.," &c.	Perfumery, drugs, &c.	775
Weil & Woodleaf . .	Lion's head enclosed in a triangle .	Fancy goods . .	975
Weisenberger, Philip .	Mixed design of stones, flame, and words "Key-stone Non-Explosive," &c.	Burning-fluid .	121
Weeks & Dupee . . .	Word "Aurantine"	Chemicals for dyeing	525
Wells & Stell, W. S. and J. J. . . .	Figure of a conoid A, "Medikones," &c.	Medical preparations . . .	167
do. do. do.	Elongated conoid B, "Medikones," &c.	do. do.	168
Wells, William N.[1] . .	Pythagorean theorem, and dove .	Medicines . . .	76
Wendt & Rammelsberg	"Bismarck Cement," &c.	Cement . . .	585

[1] Not described in specification.

Registrants.	Brief Description.	Class.	No.
Werk & Sons, M. . .	Eagle, with words "Golden" and "Eagle," &c.	Wine	206
West Virginia Oil and Oil Land Co. . . .	Representation of the western hemisphere, with the word "Globe" across the same	Lubricating oils	48
Wheeler, A.	"Siccohast," & *monogram* "A. W."	Paint-drier . .	832
Wheeler, Madden, & Clemson	"Improved Conqueror Saw," with or without pictorial designs . .	Saws	1074
Wheeler & Wilson Manufacturing Co. . .	Shield, stars, & monogram "W. & W."	Sewing-machines	181
White & Alexander[1] .	Game-cock	Whiskey . . .	77
Whitelaw, Francis M. .	"Gold Ring Candy"	Candy	320
Whiting, George A. .	*Monogram "W. & Co." with motto "Memor et fidelis" on a shield* .	Ladies' under-garments, ruffles, &c.	359
Whitney, James H. .	Name, with locket enclosing portrait, &c.	Sewing-machine	399
Whittaker & Sons, F. .	Five-pointed star, letter "W," and firm motto	Sugar-cured hams	920
Whorley, T. & L. . .	Negro's head, &c., and "Celebrated Tar-Heel"	Tobacco . . .	810
Wiard & Hough . . .	Character consisting of five circles	Plows, cultivators, &c.	819
Wilder, James Davis .	"Wilder's Liquid Slating," elaborate device	Liquid slating, &c.	511
Willetts, Charles E. .	"Quaker"	Soap	305
Williams, Blanchard, & Co.	Japan dragon, with drawing, &c. .	Tea	214
Williams (Thomas C.) & Thomas (James, Jr.)	Monogram, "T. W. C.," globe, and tobacco plants	Tobacco . . .	400
Williamson, Edward J.[2]	"Melaroma," and beehive & plants	Beverages . .	401
Willoughby, Hill, & Co.	"Square-Dealing Clothing" . . .	Clothing . . .	735
Wilson Sewing-Machine Co.	"Excelsior Wilson," eagle, &c. . .	Sewing-machines	679
Wilson, Sorg, & Co. .	Border enclosing firm-name and "Beauty Navy Tobacco" . .	Tobacco . . .	910
Winfree & Loyd[3] . .	"Uncle Bob Lee," and face . . .	do. . . .	402
do. do. . . .	Figures of two Indians, word "Hiawatha"	Smoking-tobacco	689
do. do. . . .	Words "Pride of Virginia," figures of men, &c.	do.	690
Winslow & Rogers . .	"Alexina"	Boots or shoes .	643
Witherspoon, Witherspoon, & Wern . .	"Magic Polish," and figures . . .	Metal polish . .	466
Wood & Co., Alan . .	"Best Charcoal Bloom," &c., "XXX"	Sheet or plate iron	505
do. do. do. . .	Monogram "A W"	Sheet-iron, &c. .	564

[1] *Not described in specification.* [2] See § 273, *ante* [3] See § 218, *ante.*

Registrants.	Brief Description.	Class.	No.
Woodbury, Booth, & Co.	"Endurance"	Working-barrels for petroleum-wells . . .	435
Woodbury, Edward W.	Figure "A" of a cigar, with label attached, words "Industria Del Tobacco," &c.	Cigars	900
Worcester Co. Free Institute of Industrial Science	Monogram of "W. and S.," artist's palette, a trefoil on a circular disk, &c.	Mechanical tools, &c.	911
Worth, Judson G. . .	Woman carrying a tray with cup and glass	Teas, coffees, & spices . . .	842
Wostenholm & Son, G.[1]	"I X L"	Cutlery . . .	666
Yates, Wharton, & Co.	Shield (quartered), hats, "Excelsior".	Hats	369
York & Co., George H.	Scroll, and monogram "G. H. Y. & Co."	Medicine . . .	174
Young & Co., George T.	Name, and "Liquid Enamel Paint"	Paint	385
do. do. do.	Name, and "Always Ready for Use"	do.	386
Young & Co., Charles H.	"Metropolitan — Dressing" . . .	Blackings . .	526
do. do. do.	"Paris Dressing"	Shoe-blackings .	680
Young, John B. . . .	"Crown Braud Leather Stuffing".	Compound for stuffing leather	820
Zeilin & Co., J. H.[2] . .	Autographs, monogram, &c. . . .	Medicine . . .	52
Zoller & Little . . .	Rising sun, and words "Rising Sun".	Roasted coffees .	1088

[1] See §§ 68–70, 450, *ante*.

[2] Many errors are connected with this case. The specification speaks of "a wrapper or label as a trade-mark for said medicine, of which the design shown in the annexed drawing is a true copy," &c. No *drawing* is or has been annexed. A copy of the printed label or wrapper was filed. By some fatality, that was not signed by the applicants. Singular enough, one person signed it as witness! Yet on the label there is a perfectly-valid trade-mark. All errors can yet be cured. See §§ 418, 419. *ante*.

ADDENDUM.

Registrants.	Brief Description.	Class.	No.
Ames & Co., Henry . .	"Henry Ames & Co., Standard," figure of hog on a banner, and monogram "H. A. & Co." . .	Sugar-cured hams, &c.	976
Beckwith, Philo D. . .	Words "Round Oak"	Stoves	1089
Brown & Co., J. . . .	Word "Liberty"	Chewing-tobacco	1090
Carey & Co.	Device of a dragon	Oils	1092
De Bary & Co., F. . .	Elaborate device	Champ'ne-wine	1099
Florence Sewing Ma. Co.	Word "Bureau"	Sew'g-machines	1081
Fort Plain Spring Axle Co.	"Green Jacket"	Springs and axles	1095
George, Rogers . . .	"B. C.," a hyphen, and fig. "70" .	Liquor packages	671
Hanau, Julius . . .	E. front Capitol at Washington . .	Leather . . .	1096
Jenks, Charles W. . .	Words "Sanspareil," &c.	Shirts	1100
Jewett, Sherman, & Co.	Words "White Lily"	Baking-powders	1098
Jowitt & Son, Thomas	Steam-engine, &c.	Files	1101

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A.

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Cambridge: Press of John Wilson & Son.