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A TREATISE

ON THE

LAW OF TRADE-MARKS

AND ANALOGOUS SUBJECTS,

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

BY

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OF THE BAR OF THE SUPREME COURT OF THE UNITED STATES.

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PREFACE

TO THE SECOND EDITION.

THE first edition of this book sprang from the author's desire to bring order out of chaos. There was need for a collation of authorities on the Law of Trade-Marks and kindred matters; and that need was felt, not only by owners of applied symbols of manufacture and commerce, but also by bench and bar alike. No comprehensive treatise on those matters could be found in any tongue. Judicial rulings of many countries had to be consulted, and general principles of world-wide interest to be deduced therefrom. Wonder not, therefore, that much of the matter was crude, and sometimes merely theoretical.

It is probable that no other branch of legal science has had a more rapid growth during the twelve years since the first edition appeared. For that reason, this book had, for the greater part, to be rewritten. Within that time, nearly all civilized nations have shown a due appreciation of the importance of the subject. Their interest has been manifested by scores of treaties and numerous acts of legislation. A single fact speaks a volume. In 1883, at Paris, more than twenty governments, including that of our own nation, were in conference to form a union for the protection of industrial property, including rights in trade-marks. The result

is a treaty in vigorous operation. The purpose thereof is practically to efface mere territorial limits, as effectually as does the Postal Union, or the work of the late International Prime-Meridian Conference. True, our Senate has thus far declined to confirm the treaty; but that is only because the subject of trade-marks had complicated with it that of patents for inventions, and it was thought too great concessions were demanded. For the present, our citizens rely on special treaties for protection in foreign countries. Interest in the matter is not abated, but rather increases with the progress of commerce. Because of that interest, the jurisprudence of the subject has necessarily become more settled, harmonious, and refined.

Our first national legislation in regard to trade-marks was in 1870. For lack of apt words, limiting the operation of the registration act to the commerce over which Congress has control, that act was a nullity. The Supreme Court having pointed out the error, Congress, in 1381, corrected it; and ever since registration and its beneficial consequences have run smoothly along.

A few words as to the literature of emblems of commerce, etc. In the United States, Mr. Upton published his work in 1860. As a pioneer, he did good service; but explorations had then only begun. In 1871 appeared a volume of nearly eight hundred pages, entitled "American Trade-Mark Cases," gathered by Mr. Rowland Cox. The collection is convenient and valuable, inasmuch as it contains in full the principal opinions of courts of the various States of our Union; and, in an Appendix, decisions of English courts. In 1881, Mr. Cox also published "A Manual of Trade-Mark Cases," comprising Sebastian's (English) digest of cases

down to 1879, besides some later ones. Several other digests were published in or before the former year, including that of Mr. Coddington. All are useful, if they do no more than point the direction to full and explicit enunciations of legal principles. — In England, in 1861, Mr. Lloyd put forth an excellent little treatise of about eighty pages duodecimo, and a second edition in 1865. Later followed Adams's, and other books and essays relating to trade-marks. The British legislation of 1875–76 gave an impetus to writers of books of local practice. As a consequence of the legislation of 1883, a number of books issued from the press, by Messrs. Aston, Lawson, Bousfield, Terrell, and others. They are mostly commentaries on the British statute of that year, with rules of practice in registration matters. They therefore do not immediately concern general readers or practitioners in this country, especially those who are in quest of general principles.

In France, in 1855, was published the "Code International de la Propriété Industrielle, Artistique et Littéraire," by MM. Pataille and Huguet, to which an "Appendice" was published in 1865 by the gentleman first named. 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, as a book of reference. In 1855, those gentlemen also began the issue of a periodical entitled "Annales de la Propriété Industrielle, Artistique et Littéraire," principally composed of opinions and decisions of the tribunals of commerce and courts of France, and sometimes of other European countries. This still goes on under the supervision of a corps of learned members of the French

bar, although the eminent writer M. Pataille died in 1881. This work, now in its thirtieth volume, contains a mine of wealth, not only in terse logical decisions of judicial courts, but also in able essays and careful annotations. In 1855 was published a good book, "Traité de la Contrefaçon," by Blanc. Space will not permit anything more than a mere reference to Pouillet, Clunet, and many other excellent authors. In 1884 was begun a publication entitled "Journal Officiel," which contains Trade-Mark decisions; but reference to cases is somewhat hindered, from the omission of names of parties litigant.

In other European countries there are publications on the same subject, especially in Belgium, Germany, and Austria, but they relate almost exclusively to matters of mere local interest.

The latest obtainable decisions of courts of various nations have been consulted and cited in the following pages.

With the hope that this volume — the result of careful revision of the first edition and analysis of judicial opinions since then evolved — may be serviceable to his brethren of the legal profession, and the public in general, this work is submitted by

W. H. B.

WASHINGTON, D. C., August, 1885.

CONTENTS.

[*The numerals refer to pages.*]

INDEX TO CASES CITED ix

TABLE OF ABBREVIATIONS xx

CHAPTER I.

INTRODUCTION 1

CHAPTER II.

PROTECTION OF TRADE-MARK PROPERTY 18

CHAPTER III.

DEFINITION AND NATURE OF A TRADE-MARK 94

CHAPTER IV.

INDICATION OF ORIGIN OR OWNERSHIP 163

CHAPTER V.

EXAMPLES OF TRADE-MARKS 210

CHAPTER VI.

FEDERAL TRADE-MARK LEGISLATION 286

CHAPTER VII.

FEDERAL LEGISLATION (*continued*) 330

CHAPTER VIII.

INFRINGEMENTS 383

CHAPTER IX.

REMEDIES, — LAW AND EQUITY 461

CHAPTER X.

DEFENCES 482

CHAPTER XI.

DAMAGES 507

CHAPTER XII.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS 524

CHAPTER XIII.

PRACTICE IN THE PATENT OFFICE 578

CHAPTER XIV.

INTERFERENCES IN THE PATENT OFFICE 620

CHAPTER XV.

ABANDONMENT 648

APPENDIX.

TREATIES, CONVENTIONS, ETC.

AUSTRO-HUNGARIAN EMPIRE, 673; BELGIUM, 674; BRAZIL, 674; FRANCE, 675; GERMAN EMPIRE, 676; GREAT BRITAIN, 676; ITALY, 676; RUSSIA, 677; SERBIA, 677; SPAIN, 678.

TRADE-MARK LAWS OF VARIOUS COUNTRIES.

AUSTRIA, 678; BELGIUM, 680; BRAZIL, 681; CANADA, 682; DENMARK, 688; FRANCE, 686; GERMANY, 688; GREAT BRITAIN, 691; ITALY, 697; JAPAN, 697; THE NETHERLANDS, 700; NORWAY, 701; ROUMANIA, 701; RUSSIA, 702; SWEDEN, 703; SWITZERLAND, 704; TURKEY, 705; THE UNITED STATES, 705.

INDEX 707

INDEX TO CASES CITED.

[*The references are to sections.*]

A.

Abadie & Co. *v.* Proudhon & Co. 224
Abendroth Brothers, Re 273
Abington *v.* North Bridgewater 202
Adams & Fay, Re 218
Adams & Hammond *v.* Edwards *et al.* 676
Adams & Taylor, Re 193
Adriance, Platt, & Co., Re 281
Affaire Armstrong 689
Affaire Vrau *v.* Divers 686
Ainsworth *v.* Walmesley 66, 199, 205, 302, 362, 471, 672
Aldrich *et al. v.* Bingham 619
Alleghany Fertilizer Co. *v.* Woodside 69, 219
Almy *v.* Harris 424
A. & M. Landon *v.* Pons 221
Am. Grocer Publishing Co. *v.* Grocer Pub. Co. 33, 547
Am. Hide, &c. Co. *v.* Am. Tool, &c. Co. 678, 681, 682
American Lubricating Oil Co., Re 68, 613
American Sardine Co., Re 134, 352, 610
American Saw Co. *v.* Emerson 504
Ames *v.* King 427
Amoskeag Manuf. Co., Re 235
v. Garner 67, 300, 386, 450, 497
v. Spear 28, 34, 36, 93, 153, 235, 462, 685
Ams, Re 89 *a*
Anglo-Swiss Condensed Milk Co. case 33
Ansell *v.* Gaubert 545
Anthony & Kuhn Brewing Co., Re 597
Apollinaris Co. *v.* Edwards 191
v. Moore 191
v. Norrish 191
Armistead *v.* Blackwell 192, 653
Armstrong *v.* Kleinhaus 680
Arnault *et cl. v.* Franck 604
Arnold *v.* Bishop 308
Arnoux *v.* Antippa *et al.* 25
Arthur Gillender & Co., Re 207
Atlantic Milling Co. *v.* Robinson *et al.* 150, 504, 680
Atlantic White Lead Co., *ex parte* 133
Aubertin *v.* Vix *et al.* 48
Auburn, &c. *v.* Douglass 508
Austen *v.* Boys 522
Averill Chemical Paint Co., Re 251
Avery & Sons *v.* Meikle 24, 30, 43, 91, 137, 220, 419
A. Vogeler & Co., *ex parte* 609
A. W. Balch & Co., Re 218
A . . . . . *v.* Z 135

B.

Backus, F. M., Re 274
Badoit *v.* André 170
Bain *v.* Munro 522
Banks *v.* Gibson 524
Banque du Commerce et de l'Industrie *v.* Banque Centrale du Commerce et de l'Industrie 530
Banque Populaire *v.* Banque Populaire d'Escompte 530
Barbier *v.* Simon 89 *c*
Bardin *v.* Gobert *et al.* 601
Bardou *v.* Berha *et al.* 33
v. Lassausée 212
Bardou *et al v.* Sabatou *et al.* 398
Bardou & Son *v.* Lacroix 71, 135, 586
Bardou, Pierre, & Pauilhac *v.* Bardou 420 *a*
Barkhouse Brothers & Co., Re 273
Barksdale, F. C., Re 115, 558
Barnard *v.* Pillow, Re 557
Barnett *v.* Kübler 166
v. Leuchars 166, 386, 496
Barrow's Application, Re 89 *d*
Barrows *v.* Knight 216, 420
Bass *v.* Dawber 471
Batcheller *et al.*, *ex parte* 270
Batty *v.* Hill 133, 597

[REFERENCES ARE TO SECTIONS.]

Bautain *v.* Mercklein 527
Bay State Iron Co., Re 198
Beard *v.* Turner 219, 260, 497
Bell *v.* Daniels 502, 681
v. Locke 105, 107, 550
Bergen & Bainbridge, Re 218
Bernard *v.* Emonds *et al.* 200
Berthelon *v.* Vergé 535
Biddle Hardware Co., Re 193
Bigelow Carpet Co. *v.* Dobson 504
Bininger *v.* Clark 524
Binninger *v.* Wattles 134, 597
Bird *v.* Randall 346
Bisson-Aragon *v.* Aragon 187
Blackwell *v.* Armistead 658, 659, 660
v. Dibrell 352, 654, 681
v. Wright 30, 33, 134, 380, 654
Blake Crusher Co. *v.* Ward 312
Blakeslee & Co., Re 134, 164, 270, 307
Blanchard *v.* Gutton 58
Blanchard & Co. *v.* Fancher 58
Blanchard *v.* Hill 20, 395, 458, 500
v. Reeves 407
Blanchard Churn case, The 375
Blofield *v.* Payne 35, 458, 500, 505, 541
Bloss *v.* Bloomer 351, 443
Boardman *v.* Meriden Britannia Co. 30, 144, 148, 229, 230, 395, 538
Bobœuf *v.* Bœuf 420 *a*
Boehm & Co., Re 66
Boetticher, Kellogg, & Co., Re 70
Boilley *v.* Jollivet 89 *c*
Bond *v.* Milbourn 523
Bonfils Frères *v.* Naquet 89 *d*
Bonnet *et al.* *v.* Delisle 527
Booth *v.* Jarrett 539
Bostwick & Tilford, Re 274
Boswell *v.* Mathie 531
Boudet *v.* Berdin *et al.* 528
Boulnois *v.* Peake 528
Bourmhonet & Basille *v.* Tisseron *et al.* 179
Bowman *v.* Floyd 91
Boyd *v.* Browne 344
Boyer *v.* Boyer 33, 420 *a*
Bradbury *v.* Beeton 547
v. Dickens 116, 524, 547
Bradley, Assignor to Young & Co. 328
v. Norton 663
Braham *v.* Bustard 150, 245
Brandreth, Re 134
Brook, Re 260
Brooklyn White Lead Co. *v.* Masury 91, 183, 650
Brousse, Perdonnet, & Co. 220
Brousse *v.* Pernolet & Co. 221
Brown, Fred., Re 207
v. Mercer 137
v. State of Maryland 287
Brown's Jamaica Ginger, Re 172
Browne *v.* Freeman 134, 220, 252, 680
Bru *v.* Larband 258
Brunswick *v.* Dunning 319
Bryce *v.* Dorr 508
Bryson *v.* Whitehead 545
Buck *et al.* *v.* Hermance 503
Buckland *et al.* *v.* Rice *et al.* 220 *b*
Bulloch, Lade, & Co. *v.* Gray 192
Burgess *v.* Burgess 420, 432
v. Hately 471
v. Hills 471
Burke *v.* Cassin 33, 134
Burnett *v.* Phalon 32, 33, 150, 237, 397, 450, 476, 658
Burrows *v.* Foster 523
Burton *v.* Stratton 91, 135, 136
Bury *v.* Bedford 57, 364, 437
Busch & Co., Re 613
Bush & Co., Re 68
Byass *v.* Sullivan 427
Byron, Lord, *v.* Johnstone 554

C.

Cagnaut *v.* Durand 546
Cahoon *v.* Ring 338
Caire, Jules E., Re 638
Caminade & Co. *v.* Caminade 527
Canal Co. *v.* Clark 29, 112, 134, 144, 182, 189, 192, 420, 521, 533
Candee, Swan, & Co. *v.* Deere & Co. 129, 134, 192, 597
C. & W. A. Waters, Re 68
C. A. Yale Manuf. Co. *v.* C. A. Yale 607, 661
Canham *v.* Jones 545
Carmichel *v.* Latimer 57, 420
Carmoy *v.* Samson 440
Carney, George J., Re 138
Carnrick *v.* Morson 33
Carpentier *v.* Canivet 414
Carrière *v.* Durand *et al.* 686
Carroll *v.* Ertheiler 66, 386
Carroll, J. W., Re 218
Carter *v.* Baker 505, 513, 517
Cartier *v.* Carlile 33, 386
v. May 471
Carver *v.* Bowker 229
v. Pinto Leite 472
Case & Martin, *ex parte* 589
Cassidy, John E., *ex parte* 368
Castille *v.* Dennery 552
Caswell *v.* Davis 29, 134, 136, 220
Cave *v.* Myers 72, 498, 531
Cawood Patent (94 U. S.) 504
Cazade & Crooks, Re 581
C. D. Ross & Son, *ex parte* 276
Chabrier *v.* Peillon 568
Chaize *v.* Fromentelle 534

[REFERENCES ARE TO SECTIONS.]

Champlin *et al.* v. Stodart 504
Chantier du Grande Ivry, Re 530
Chappell v. Davidson 71, 496, 549, 557
v. Sheard 71, 557
Chapu v. Legrand *et al.* 33, 686
Charles S. Ross & Co., Re 248
Charleson v. Campbell 528
Chase v. Mayo 565
Cheavin v. Walker 72, 221
Cheever v. Wilson 293
Chevet v. Lemasson 527
Chicot & Co. v. Vespierre & Rozé 89 *a*
Child v. Adams 329
Choynski v. Cohen 100, 101
Christofle & Co. v. Deleiderrier 22, 51
Christy v. Dande 261
v. Murphy 65, 528
Chubb v. Griffiths 471
Churton v. Douglass 98, 522, 524, 526
Civil Service Supply Assoc. v. Dean 528
Clark v. Brown 424
v. Clark 388, 420, 427
v. Freeman 393, 555
v German Mutual Fire Ins. Co. 71, 91
Clayton v. Stone 108
Clemens v. Belford 556
v. Such 548
Clement v. Maddick 33, 116, 386, 547, 550
Clertan *et al.* v. Carpentier 160, 230
Clicquot v. Roudeau *et al.* 455
Clowes v. Hogg 547
Coats, Re 597
Coats v. Holbrook 30, 344, 471, 496
Cochrane, James, Re 614
Cocks v. Chandler 252, 543
Coffeen v. Brunton 28, 34, 35, 109, 386, 458, 460, 462, 468, 501, 538
Cohen & Co. v. Maris & Widow Robert 252, 678
Colgate & Co., Re 273
Colladay v. Baird 180, 302
Collender v. Griffith 109
Collins Co. v. Brown 21, 287
v. Cohen 287, 362
v. Oliver Ames & Sons' Corporation 67, 427
v. Reeves 21
v. Walker 471
Colman v. Crump 58, 385, 386, 501
Colton v. Thomas 540
Compagnie Howe v. Grimm 387
Compagnie Laferme v. Hendrickx 471
Compère v. Bajou *et al.* 209, 525
Comstock v. White 38, 563
Congress & Empire Spring Co. v. High Rock Cong. Spring Co. 39, 57, 91, 146, 160, 191, 247, 362
Connell v. Reed 71
Conover v. Rapp 513
Conrad v. Joseph Uhrig Brewing Co. 71, 418, 473
Consolidated Fruit Jar Co., Re 221
v. Dorflinger 72
Constable & Co. v. Brewster 547
Cook v. Starkweather 137, 386
Cooke, J. C., Re 578
Cope v. Evans 386
Corns v. Griffiths 547
Cornwall & Co., Re 68, 191, 638
Correspondent Newspaper Co. v. Saunders 547
Corwin v. Daly 65, 134, 395
Cotton v. Gillard 352
Coudray v. Monpelas 219
Covel v. Maxim *et al.* 643
Cowing v. Rumsey *et al.* 504, 507, 513
Cox v. Land and Water Journal Co. 559
Crane & Byron, *ex parte* 133
Crane & Co., *ex parte* 276
Crawford v. Collins 590
Crawshay v. Collins 524
v. Thompson 395, 458
Crespel & Descamp v. Dayez filsainé & Co. 269
Crichton, Malcolm, Re 193
Croft v. Day 28, 34, 43, 201, 351, 385, 393, 422, 423, 538
Crompton v. Belknap Mills 315
Crutwell v. Lye 522, 523, 526
Cuillieron-Policard v. Gadobert 89
Cunin-Gridaine and other manufacturers of Sedan v. Crocius 182
Curtis v. Bryan 201, 351, 426, 492
Cusimberche v. Debard 89
C. & W. A. Waters, Re 68

D.

Dalbanne & Petit v. Colleuille & Co. 216
Dale v. Smithson 71, 351, 458, 494, 538
Dannachie v. Young 193, 533
Davey, Bickford, Watson, & Co. v. Nier 268
Davis v. Garrett 518
v. Kendall 33, 91, 273, 468, 516, 503
v. Kennedy 33
Dawes & Fanning, *ex parte* 367
Day v. Woodworth 519
Dayton v. Wilkes 106, 108, 550
De Bussy (Charles) v. Charles Marchal 556
Décressonière v. Celisse 33
Deiz v. Lamb 560

[REFERENCES ARE TO SECTIONS.]

Delaleu *v.* Grignon 192
Delaware & Hudson Canal Co. *v.* Clark. (See Canal Co. *v.* Clark.)
Demot, Dubrac, & Benitéz *v.* Soc. des Heritiers Liebig 686
Deneubourg-Ligier et Cliff *v.* Birkin frères 419
Denis & Mounier *v.* Vignier, Dodart, & Co. 253
Dental Vulcanite Co. *v.* Wetherbee 682
Derringer *v.* Plate 47, 362, 424, 502
Désiré Michel & Co. *v.* Achard & Co. 190
De Villemessant *v.* N. Estibal 33
Devlin *v.* Devlin 471
Dick & Co., Re 134, 597
Dietrichsen *v.* Cabburn 562
Dixon *v.* Jackson 33, 68
Dixon Crucible Co. *v.* Guggenheim 37, 114, 129, 172, 362, 396, 480, 541
Doe *v.* Yates 106
Dole Brothers, Re 134
Dorvault *v.* Hureaux 529
v. Teissier & Co. 529
Dougherty *v.* Van Nostrand 526
Dousman & D. T. Co. *v.* Ruffner 138
Doxsee, J. H., Re 250
Dr. Haterr Medicine Co., Re 381
Dubois *v.* Demoiselles Louise and Lucille 532
Dugué & Co. *v.* Bobot-Descoutures 603
Dunbar *v.* Glenn 33, 191
Dunèsme *v.* Anastay 473
Dunn & Co., Re 273
Dunn Edge Tool Co., Re 249
Dupont, A., *v.* Debreye 383
Dutcher Temple Co., Re 234, 377
Duwel *v.* Bohmer 280

E.

Eames & Sealey *v.* McDougal 633
Eberman *v.* Reitzell 351
Edelsten *v.* Edelsten 33, 35, 411, 471, 496, 504
v. Vick 72, 73, 541
Edgerley, H. B., Re 217
Edinburgh Correspondent Newspaper, Re 547
Edmonds *v.* Benbow 547
Eggers *v.* Hink 104
Electro-Silicon Co. *v.* Hazard 22, 71, 220
Elk *v.* Wilkins 289
Ellis *v.* Zeilen & Co. 418
Ely *v.* Monson 466
England *v.* Downs 522
v. New York Publishing Co. 106
English, R. W., Re 162
Enoch Morgan's Sons *v.* Troxell *et al.* 44, 137, 418
Entrepôt d'Ivry, Re 530
Erard *v.* Erard 420 *a*
Estcourt *v.* The Estcourt Hop Essence Co. 71, 471
Estes *et al.* *v.* Williams *et al.* 116
v. Worthington 497
Estibal *v.* Petit-Demenge 551
Evans *v.* Harlow 473
Evans, W. M., *ex parte* 590
Eydoux *v.* Morel 89 *d*, 681

F.

Faber *v.* Faber 421
v. Hovey 68, 504
Faivre *v.* Boulan 33
v. Duguaire *et al.* 184
Falkinburg *v.* Lucy 83, 148, 255, 538
Farcy *et al.* *v.* Epailly *et al.* 33
Farina, Re 260, 497
v. Camus 288
v. Cathery 33
v. Shaw 58
v. Silverlock 28, 30, 58
Farr *v.* Pearce 522
Farre, Charles Narcisse, Re 89, 304
Fay *v.* Durand 135
Featherstonhaugh *v.* Fenwick 524
Feehheimer & Workum, *ex parte* 613
Fenn *v.* Bolles 524
Ferguson *v.* Davol Mills 149, 254
Fetridge *v.* Merchant 38, 242, 244, 351, 462
v. Wells 71, 148, 241, 242, 244, 328, 353, 471, 488
Field *v.* Adreon 297
v. Lewis 471
Filkins *v.* Blackman 57, 539
Filley *v.* Child 221
v. Fassett 33, 148, 150, 386, 664, 682, 685
Fils *v.* Sarrazin 624
Fiolet *v.* Duval 89 *b*
Fisk, Clark, & Flagg, Re 133, 134, 273
Flavel *v.* Harrison 72
Fleischmann *v.* Schluckmann 136, 191
Fleming, Coehran, Re 207
Foote *v.* Silsbee 503
Forbes, Samuel B., Re 275
Ford *v.* Foster 68, 71, 72, 219, 688
Forsythe *v.* State 354
Foss, *ex parte*, and Re Baldwin 68
Fould *v.* Honegger 532
Fowle *v.* Spear 71, 351, 429, 475, 491

[REFERENCES ARE TO SECTIONS.]

Fox *v.* Meurgey *et al.* 89, 219, 221
F. Prot & Co. *v.* Cabrideus *et al.* 38
v. Carriès 443
v. Jules Avice *et al.* 135
v. Monganzi 387
Frances, The 299
French *v.* Rogers 314
Frese *v.* Bachof 137
Fullwood *v.* Fullwood 513
Fulton *v.* Sellers 20, 57, 135, 539
Fumouze *et al. v.* Grosse *et al.* 387
Funke *v.* Dreyfus 71, 135, 136, 685

G.

Galand *v* Galand 420 *a*
Gale, Daniel J., Re 138
Galy *v.* Mauchien & Co. 564
Galzy *v.* Courcy 600
Gamble *v.* Stevenson 528
Gardner *v.* Bailey 33
Garnier *v.* Berthe 407
v. Lindière *et al.* 409
v. Paul Garnier 408, 410, 582
v. Richard 33
Garnier *et al.* Carthusians *v.* Rivoire 409
Gaullieur & André, Re 273
Gay *v.* Siebold 590
Gènevoix *v.* Pauliac 387
Germain *v.* Sevène 504
Gibblett *v.* Read 68, 545
Gilbert & Co. *v.* Benedictus 441
Gill & Lootz, Re 218
Gillis *v.* Hall 425
Gillott *v.* Esterbrook 29, 226, 229, 401, 446, 512, 544, 681, 685
v. Kettle 36, 446
Gillout *v.* Richard 89 *c*
Gilman *v.* Hunnewell 33, 134
Ginter *v.* Kinney 134
Glen & Hall Manuf. Co. *v.* Hall 71, 401, 442
Glen Cove Manuf. Co. *v.* Ludeling 360, 400
Glendon Iron Co. *v.* Uhler 134, 136, 192
Glenny *v.* Smith 64, 386, 496, 531
Godillot *v.* Harris *et al.* 144
v. Hazard 261
Gogney *v.* Delanne 443
Goodyear *v.* Dunbar 464
v. Hullihen 312, 314
Goodyear Rubber Co., Re 134, 597
v. Day 220 *a*
Gourbeyre *v.* Bodevin 236
Gordon, Re 89 *b*, 138
Gout *v.* Aleploglu 222, 307
Graham, Re 134
Graham *v.* Plate 504, 507
Graham & Co. *v.* Kerr, Dodson, & Co. 386
Gravelet (*dit* "Blondin") *v.* Arnault 213
Graveley *v.* Winchester 523
Gray *et al. v.* Taper-Sleeve Pulley Works 91, 191, 677
Green, Re 191
v. Folgham 562
v. Rooke 134
Greenwoods Scythe Co., Re 70, 275
Grézier *v.* Caumontal 55
v. Chalvin 410
v. Cusenier 387
v. Detang 55
v. Gallifet 387
v. Girard 410
v. Jouhate 58
v. Lambert 387
v. Lieutand 410
v. Poullain 387
v. Rivoire 33
v. Rocca 387
v. Sage 410
Grillon *v.* Guénin 33
Grow *v.* Seligman 91, 214, 420
Guerineau *v.* Mignon 236
Guinness *v.* Ulmer 33, 58
Guislain & Co. *v.* Labrugnère 397, 450
Gullet Gin Manuf. Co., Re 323
Guyon *v.* Sewell 503

H.

Hagg *v.* Darley 545
Halbron *v.* Malespine 416
Hall *v.* Barrows 30, 66, 129, 302, 362, 672
v. Hall 524
Hall, Daniel G., *ex parte* 276
"Hall Calendar Watch" case, The 376
Halliday Bros., Re 138
Hamilton Disinfectant Works, Re 89 *d*
Hammelle *et al. v.* Doudiet 387
Hammerslaugh & Co., *ex parte* 133
Hammond *v.* Douglass 524, 526
Hanford *v.* Westcott 621
Hankinson, Re 565
Hargreaves *v.* Smith 260
Harrington *v.* Libby 89 *b*, 89 *d*, 137, 138, 270
Harris, Beebe, & Co., Re 167
Harrison *v.* Gardner 523
v. Taylor 407
Harter *v.* Souvazoglu 89
Hartford Carpet Co. *v.* Dobson 504

[REFERENCES ARE TO SECTIONS.]

Hauthaway & Sons, Re 164, 276
Havemeyer *et al.*, Re 614
Hawkins *v.* Lambert 633
Hayden *v.* Phillips 619
Hayem *v.* Brisac 58
H. D. Smith & Co., Re 234
Heath *v.* Wright 71, 429, 475, 491
Hecht *v.* Porter 66
Heidsieck *v.* Souris, Dresel, *et al.* 455
Helmbold *v.* The Henry T. Helmbold Manuf. Co. 57, 71, 134
Hennessy *v.* Hogan 443
v. Kennett 443
v. Wheeler 71, 475
v. White 443
Hennessy & Co., James, *ex parte* 133
Henry *v.* Price 137
Heritiers Bobœuf *v.* Bœuf 420 *a*
Hérold *v.* Gerbeau 679
Heydenfeldt *v.* Davey, &c. Mining Co. (U. S. Sup. Court) 282
Heyman, Re 135
Hill & Hall's case, Re 323
Hine, Charles C., Re 558
v. Lart 150, 612
Hirsch, David, Re 218
Hirst *v.* Denham 191
H. J. Baker & Brother, Re 274
H. M. Rowe & Co., *ex parte* 588
Hobbs *v.* Français 71, 485
Hogg *v.* Emerson 508
v. Kirby 20, 71, 108, 458, 474, 548
v. Maxwell 547
Holloway *v.* Holloway 71, 420, 430, 541
Holmes *et al. v.* Holmes *et al.* 34, 322
Holmes, Booth, & Haydens *v.* The Holmes, Booth, & Atwood Manuf. Co. 386, 420
Holt *et al. v.* Menendez *et al.* 680
Holtzer & Co. *v.* Tendenberg & Co. 50
Hookham *v.* Pottage 531
Hostetter *v.* Anderson 443
v. Fries *et al.* 220, 521
v. Vowinkle 33, 504, 516
Hovey *v.* Henry 681
Howard *v.* Henriques 83, 92, 95, 96, 528, 560
Howe *v.* Searing 83, 98, 210, 525, 526
v. The Howe Machine Co. 201, 422, 423
Howe Machine Co. *v.* Maquaire *et al.* 387
Hovenden *v.* Lloyd 545
Hudson *v.* Bennett 471
v. Osborne 57, 71, 437, 523
Humphrey's Spec. Hom. Med. Co. *v.* Wenz 89 *a*, 229
Hunt *v.* Maniere 472
Hunyadi-Janos, Re 191
Hyde & Co., Re 624

I.

Illinois, State of, *v.* Roehr 452
India Rubber Co. *v.* Rubber Comb Co. 229
Ingram *v.* Lawson 473
v. Stiff 33, 116, 547
Insurance Oil Tank Co. *v.* Scott 72, 340
Isaacs *v.* Daly 89 *a*
Ives, Beecher, & Co., Re 614

J.

Jackson *v.* Nichols 633
James Hennessy & Co., *ex parte* 133
James *v.* James 134, 420
Jansen *v.* Ostrander 319
Jaubert-Bonnaire *v.* Wilford 689
J. Buchan & Co., Re 273
Jenkins *et al. v.* Putnam 633
Jenkins, N., Re 273
J. Marsching & Co., Re 192
Johnson & Co., Re 134
Jolley, Son, & Jones, Re 624
Jollie *v.* Jaques 548
Jones *v.* Pearce 508
Joseph Dixon Crucible Co. *v.* Benham 137
J. S. Johnson & Co., *ex parte* 133, 367
Julian *v.* The Hoosier Drill Co. *et al.* 191, 681
Jurgensen *v.* Alexander 427, 471

K.

Kane & Co., Re 89 *b*
Kelly *v.* Byles 134
v. Hutton 116, 546
Kemp *v.* Herman 288
Kendall *v.* Stone 473
v. Winsor 681
Kennedy *v.* Lee 523
Kenyon *v.* Wesson 627
Kidd *v.* Johnson 57, 68, 364, 672
Kidd & Co. *v.* Mills, Johnson, & Co. 68, 672
King of Saxony, *ex parte* 144
Kinney *v.* Allen 137
v. Basch 30, 68, 229
Kipling, Re 89 *a*
Knoepfel, W. H., Re 194
Knott *v.* Morgan 91, 413, 526, 560

[REFERENCES ARE TO SECTIONS.]

L.

Labouchere *v.* Dawson 523
La Croix *v.* May *et al.* 568
La Fraternelle Parisienne *v.* La Parisienne 530
Lagarde *v.* Piper 400
Laird *v.* Wilder 71
Laker *v.* Damon 510
Lalande *et al. v.* Appel *et al.* 85, 141
Lamplough *v.* Balmer 72
La Nationale *v.* La Société Nationale 530
Landon *v.* Lamare 387
v. Leroux 221, 387
v. Pons 221
Landreth, Oliver, Re 89 *d*, 270
Landsberger & Co., Re 273
Lanferty *v.* Wheeler 71
Lanman & Kemp *v.* Bognard *et al.* 688
Larénaudière *v.* Perine-Guyot 220
Larrabee *v.* Lewis 89 *a*, 136, 174
Laurens *v.* Laurens 527
Lautz Bros. & Co. *v.* Schultz & Co. 621
Lavery & Co. *v.* Fajardo 91, 219
Lawrence & Co., Re 134
Lawrence Manuf. Co. *v.* Lowell Hosiery Mills 229
Lawson *et al. v.* Dechaille 689
Lazenby *v.* White 542, 681
Lea *v.* Haley 498
v. Millar 136, 192
v. Wolff 136, 192
et al. v. Deakin 136, 192
Leather, &c. *v.* Hirschfield 72, 505
Leather Cloth Co. *v.* Lorsont 72, 471
Leather Co. *v.* American Leather Co. 30, 32, 33, 41, 43, 64, 71, 72, 83, 91, 96, 126, 129, 301, 302, 351, 362, 363, 477, 672
Lebat *v.* Partongue 530
Leclanche Battery Co. *v.* Western Electric Co. 521
Ledger *v.* Ray 547
Lee *v.* Haley 71, 91, 498
Lee & Shepard, Re 113
Leech *v.* Doorgachurn Seal *et al.* 74
Le Figaro *v.* Le Petit Figaro 33
Legrand ainé *v.* Louit frères 137
Lehigh Valley Coal Co. *v.* Hamblen 533
Leidersdorf *v.* Flint 130, 280
Lelarge *v.* Brossom 89
Lemercier *v.* Millin 529
Lemoine *v.* Ganton 683
Leonard & Ellis's Trade-Mk., Re 135
Leonard & Ellis *v.* Wells 135
Leroy *v.* Calmel 49, 682
Lesley, A. M., Re 273
Levigoureux *et al. v.* Lecompte & Co. 187
Levy *v.* Bizet 236
v. Walker 36
Lewis *v.* Langdon 526
Lichstein *v.* Mellis 91, 528
Liebig & Liebig's Ext. of Meat Co. *v.* Collemann *et al.* 686
Liebig's Ext. of Meat Co. (limited) *v.* Hanbury 134
Linde *v.* Bensel 536
Lindon *v.* Graham 473
Linoleum Manufacturing Co. *v.* Nairn 220, 221
Lochgelly Iron & Coal Co. *v.* Lumphinnans Iron Co. 193, 533
Lockwood *v.* Bostwick 33, 362, 397
Longchamp *v.* Veuve Potin *et al.* 192
Lonquéty *v.* Fanchon & Co. 535
Loog *v.* Bean 473
Lord Byron *v.* Johnstone 554
Lorimier & Bovet *v.* Dubois 539
Louis Foucaud & Co. *v.* Lucien Foucauld & Co. 535
Louis Strasburger & Co., Re 133
Lowell *v.* Lewis 508
Lowell Manuf. Co. *v.* Larned 89, 304
Luyties *et al. v.* Hollender *et al.* 360

M.

Mack *v.* Petter 137, 547
Magee Furnace Co. *v.* Le Baron 533
Manhattan Medicine Co. *v.* Wood 71, 483, 545, 672
Manuf. Co. *v.* Trainer 71, 156
Many *v.* Sizer 464
Marsh *v.* Billings 91, 458, 501, 505, 561
et al. v. Warren *et al.* 381, 382
Marshall *et al. v.* Pinkham 324, 420
v. Ross 72
Martell & Co. *v.* Badoureau & Patte 456
v. Martell *et al.* 58
Massez *v.* Joly 434
Matsell *v.* Flanagan 30, 36, 107, 351, 550
Mauprivez *v.* Buchet *et al.* 165
Mayer *et al. v.* Herlick *et al.* 532
McAndrew *v.* Bassett 52, 66, 184, 471, 658
McCardel *v.* Peck 97, 528
McCartney *v.* Garnhart 403
McConnell, Porter, & Co., Re 193
McElwee *v.* Blackwell 306
McGowan Bros. Pump Mach. Co. *v.* McGowan 524
McLean *v.* Fleming 20, 33, 43, 137, 385, 386, 392. 420, 471, 497, 501, 504
McMillan *v.* Barclay 681

[REFERENCES ARE TO SECTIONS.]

McNair *v.* Cleave 495
Mellus *v.* Silsbee 681
Meneely *v.* Meneely 136, 206, 326, 420
Menier *v.* Buisson *et al.* 686
v. Loblanc-Winckler 419
v. Rochebrun 89 *c*, 686
Mercantile Loan and Warehouse Co., Re 318
Meriden Britannia Co. *v.* Parker 33, 71, 420
Merrimack Manufacturing Co. *v.* Garner 256, 462, 538
Messerole *v.* Tynberg 68, 216
Metzler *v.* Wood 33, 71, 471
Michaud *et al. v.* Lemenu *et al.* 58, 135, 191
Michel (Nestor) *v.* Stremier 236
Middlesex Co., Re 303
Millaud *v.* Caron 417
v. Le Petit Journal du Nord 417
v. Marian *et al.* 417
Millington *v.* Fox 302, 386, 393, 468, 471, 526
Mills, Johnson, & Co., Re 68
Milner *v.* Reed 326
Ministère Pub. *v.* Bernard 89
Ministère Pub. & F. Prot & Co. *v.* Carriès 443
Missouri *v.* Gibbs 136
Mitchell *v.* Henry 268, 418
Moet *v.* Couston 471
Mondin & Co. *v.* Sari *et al.* 534
Montagnac *v.* Halphen & Co. 535
Montagne *v.* Bizet 71
Montgomerie *v.* Donald & Co. 533
Moodie, *ex parte* 138
Moorman *v.* Hoge 89 *b*, 137, 138, 341
Morgan *v.* McAdam 71, 72
v. Rogers 362, 672
Morgan, C. C., Assignor to Union Paper Collar Co. 140
Morgan's Sons Co. *v.* Troxell 44, 137, 418
Morison *v.* Moat 545, 562
v. Salmon 429
Morrison *v.* Case 68, 606
Morse *v.* Worrell 33
Motley *v.* Downman 102, 462, 526
Mouson & Co. *v.* Boehm 680, 681
Mowry *v.* Whitney 624
Mulhens *v.* Buchholz 686
Muller *v.* Compagnie Immobilière 529
Müller *v.* Haymann 22

N.

Newberry *v.* James 545, 562
Newby *v.* Oregon Central R. R. Co. *et al.* 321
Newman *v.* Alvord 29, 182, 188, 191, 193, 538, 659
New York Cab Co. *v.* Mooney 560
Nixey *v.* Roffey 72
Notelle *v.* Dutoict, Marlin, & Co. and Paul Dutoict & Co. 137

O.

Oakes *v.* Tonsmierre 57, 539
O'Hara *v.* Hawes 308
Ohio Valley Piano Co., Re 273
Oliver, Re 192
Oliver Landreth, Re 89 *d*, 270
Orr Ewing & Co. *v.* Johnston & Co. 33, 418
Osgood *v.* Allen 33, 109, 116, 381, 547
v. Rockwood 66

P.

Page *v.* Ferry 503
Palmer *v.* Harris 71, 351, 481
J. B., Re 221
Solon, Re 164, 270
Panckoucke *v.* Wittersheim 415
Parent *v.* Chaumont 383
Parker *v.* Brant 464
v. Helme 503
v. Sears 464
Parsons *v.* Hayward 522
Partridge *v.* Menck 28, 32, 34, 35, 71, 256, 351, 462, 474, 489, 496
Pasley *v.* Freeman 344
Paullin, Mary A., Re 246
Peabody *v.* Norfolk 545
Peck & Snyder, Re 585
Peitz *v.* Eichele 537
Pellier *et al. v.* Trottier frères *et al.* 387, 535
Pennsylvania Coal Co. *v.* Douglas *et al.* 533
Pepper *v.* Labrot *et al.* 91, 191
Perkins & Ernst, *ex parte* 606
Perry Davis & Son, Re 273
Perry *v.* Truefitt 28, 34, 41, 43, 71, 385, 393, 479
Peterson *v.* Humphrey 525
Phalon *v.* Wright 71, 134, 484
Phelps *v.* Brown 614
Ph. Vrau & Co. *v.* Pouillier-Loughaye *et al.* 80, 268
Pidding *v.* How 71, 480, 491
Pie *v.* Poulet 443
Pierce *v.* Franks 471
Pierre Bardou & Pauilhac *v.* Joseph & Léon Bardou 420 *a*
Pinaud & Amour *v.* Pineau 527

[REFERENCES ARE TO SECTIONS.]

Pisano *v.* Lawson 287
Pitts *v* Hall 504
Ponsardin *v.* Peto 472
Popham *v.* Cole 385
v. Wilcox 38
Portallier *v.* Balay 58
Potter *v.* Holland 338
v. The Commissioners of Inland Revenue 522
Potter *et al. v.* McPherson *et al.* 33
Poupier *v.* Laurençon 89 *c*
Powell, Re 624
Pratt, Re 624
Pratt & Farmer, Re 597
Prize Cases (U. S. Sup. Court) 299
Probaeco *v.* Bouyon *et al.* 57
Procter & Gamble, Re 89
v. McBride *et al.* 33
Prot & Co., F., *v.* Cabrideus *et al.* 33
v. Carriès 443
v. Jules Avice *et al.* 135
v. Monganzi 387
Prowett *v.* Mortimer 547
Prudhon *v.* Villaret 89 *b*
Prudon *v.* Brousse *et al.* 605
Pyer *v.* Brain 549

R.

Radde *v.* Norman 191
Rader & Co., Re 597
Raggett *v.* Findlater 134, 597
Ralph *v.* Taylor 221
Ralph's Trade-Mark, Re 221
Ransom *v.* The Mayor, &c. 338, 502, 681
Ransome *v.* Graham 135
Raphauel, Re 135
Raymoudière, Veuve, *v.* Plesier *et al.* 387
Reed, W. H., Re 274
Regina *v.* Closs 453
v. Gray & Gosling 452
v. S. Jones 452
v. J. Smith 452, 453
Regnard *v.* Perrier 534
Reinhardt *v.* Spalding 135
Reynolds *v.* Bullock 524
Rian *v.* Bernheim 165
Richards *v.* Williamson 443
Richardson, Re 221, 611
Ricque *et al. v.* Forges 268, 585
Risewick *v.* Davis 297
Roach, Re 134
Robert *v.* Grandjean 89
Roberts, Re 134, 164, 276
v. Sheldon 33
Robertson *v.* Berry 191, 553
v. Quiddington 522, 524
Robineau *v.* Charbonnel 471
Rodgers *v.* Nowill 356, 428, 458, 471, 501, 505
v. Rodgers 471
Rodgers & Son *v.* Philp & Solomons 684
Rœderer & Co. *v.* Rœderer 438
Rogers *v.* The Amado 299
Rolt *v.* Bulmer 524
Rommetin *v.* Crotte 532
Rose *v.* Evans 135
v. Loftus 471, 508
Rose, J., Re 217
Rosing, Re 260
Ross *v.* Ross 292
Ross & Son, C. D., *ex parte* 276
Ross & Co., Chas. S., Re 248
Rotherham's Trade-Mark, Re 210
Rowe & Co., H. M., *ex parte* 588
Rowe & Post, Re 597
Rowland *v.* Breidenbach 134
Rowley *v.* Houghton 33, 612
R. S. Merrill & Co., Re 273
Rubber Co. *v.* Goodyear 504
Russell & Erwin Manuf. Co. *v.* Mallory 681

S.

Sabold, John, Jr., Re 597
Safeguard Fire Insurance Co., Re 318
Salignac & Co. *v.* Lavanier & Co. 599
Samuel *v.* Berger 363, 474
Sargent *v.* Romeu 50, 216
Saunion & Co., Re 71
Sawyer *v.* Horn 43, 187, 418
v. Kellogg 471
Say *v.* Duringer *et al.* 21, 43
Schenck, C. S., *ex parte* 133
v. Rider 627
Schmidt & Curtius, *ex parte* 133
Schorthose *v.* Hogg 529
Schrauder *v.* Beresford & Co. 380, 384, 449, 626, 661
Schweitzer *v.* Atkins 33
Scott *v.* Scott 531
Scoville *v.* Toland 109, 381
Seabury *v.* Grosvenor 71
v. Johnson 352
Seaton *v.* Senate 537
Seigle *v.* Mondon, Gonon, & Carre 607
Seixo *v.* Provezende 405, 661
Selchow *et al. v.* Baker 134, 160, 210
Seligman, Jacob, Re 214
Serrell *v.* Collins 338
Seymour *v.* McCormick 503
Shaver *v.* Shaver 136
Shepherd *v.* Boggs 524

[REFERENCES ARE TO SECTIONS.]

Shaw Stocking Co. *v.* Mack *et al.* 229
Shipwright *v.* Clements 57, 522
Shrimpton *v.* Laight 33
Sickles *v.* Borden 515
Siegert *et al. v.* Abbott 71, 483
v. Ehlers 194
v. Findlater 71, 134, 194, 546
Simpson & Sons, Re 881
Singer Manuf. Co. *v.* Brill 220 *a*
v. The Domestic Co. 473
v. Kimball & Morton 220 *a*
v. Larsen 220 *a*
v. Loog 91, 220 *a*, 521
v. Mestwerdt & Engel 387
v. Riley *et al.* 220 *a*
v. Stanage 220 *a*, 521
v. Wilson 386
Singleton *v.* Bolton 20, 134, 180, 356, 395, 458, 500
Skinner & Co. *v.* Oakes *et al.* 57, 420, 539
Smith, Re 89 *a*, 507
v. Everett 524
v. Reynolds 66, 329, 838
v. Sixbury 71
v. Woodruff 476, 493
H., Re 274
Smith & Co., C. D., Re 234
Smith, Crosby, & Co., Re 218
Snodgrass *v.* Wells 136
Snook, *ex parte* 196
Snowden *v.* Noah 36, 104, 107, 550
Société Anonyme des Mines et Fonderies de Zinc de la Vieille Montagne *v.* Baxter 66
Société de la Vieille Montagne *v.* Beglin 473
Sohl *v.* Geisendorf 135, 681, 685
Somborn *v.* Menser *et al.* 339
Southern *v.* How 20, 63, 395, 500
Southron *v.* Reynolds 17
Spaulding *v.* Page 515
v. Tucker 515
Spencer & Sons *v.* Peigney 178, 686
Spottiswoode *v.* Clarke 31, 257, 462, 549
Sprague *v.* Adriance 681
Stachelberg *v.* Ponce 672
Standish *v.* Whitwell 260
State of Illinois *v.* Frank Roehr 452
Steinthal *v.* Samson 260
Stephens *v.* De Conto 108, 111, 550
v. Peel 33
Sternberger, Leopold, Re 638
v. Thalheimer & Hirsch 68, 340, 380, 638
Stetson *v.* Wincor 560
Stevens *v.* Keating 463
Stewart *v.* Smithson 71, 72, 495
Stokes *v.* Landgraff 157, 160, 597
Stone *v.* Carlan 560
Stonebraker *v.* Stonebraker 435
Strasburger & Co., Louis, *ex parte* 133
Stubs *v.* Astier *et al.* 48, 178, 688
Swett & Crouch, Re 247
Swift *v.* Dey 36, 113, 450
v. Peters 661
Sykes *v.* Sykes 72, 201, 305, 422, 423, 461, 496

T.

Tallcott *v.* Moore 471
Taylor *v.* Carpenter (3 Story, 458) 21, 36, 287, 681, 685
v. Carpenter (2 Wood. & M. 1) 21, 35, 65, 287, 344, 496, 503, 681, 685
v. Carpenter (11 Paige, 292) 28, 34, 35, 42, 65, 496, 501
v. Gillies 133
v. Taylor 33
Tegmeyer *v.* Kerns 627
Ternaux *v.* Bournhonet 527
Testevuide *v.* Girault 535
Teter, Re 138
Tetlow *v.* Savournin 476
Thaddeus Davids & Co., Re 381
Thalheimer & Hirsch, Re 638
"The Blanchard Churn" case 375
The Dr. Harter Medicine Co., Re 381
"The Hall Calendar Watch" case 376
The Walkden Aerated Waters Co., Re 624
Thibierge *v.* Dupont *et al.* 165
Thomas, *ex parte* 522
Thompson *v.* Winchester 203, 459, 496
Thompson, Derby, & Co., Re 89 *a*
Thomson, Langdon, & Co., Re 273, 588
Thorley's Cattle Food Co. *v.* Massam 196, 420
Thunot-Duvotenay *v.* Degorce-Cadot 553
Tipping *v.* Clarke 562
Tolle, John F., *ex parte* 367
Tom Pouce *v.* Roqueplan 91
Tonge *v.* Ward 33
Torchin *v.* Cathrin 383
Torchon *v.* Pauliac 221
Tournachon *v.* Tournachon 213
Town *v.* Stetson 134
Tracy *v.* Swartwout 503
Trade-Mark Cases (U. S. Sup. Ct.) 278, 281, 381
Tribouillet *v.* Mounier 504
Tucker Manuf. Co. *v.* Boyington 221
Tufts, James W., Re 273
Twamley, James, Re 584

[REFERENCES ARE TO SECTIONS.]

U.

United States *v.* Hudson & Goodwin 464
v. Rider 89 *b*, 188
ex rel. Schumacher & Ettlinger *v.* Marble 881
ex rel. The Willcox & Gibbs Sewing-Machine Co. *v.* Marble 381
U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. 681
Upmann *v.* Elkan 472
Uzielli, *ex parte* 472

V.

Valve Jar Co., *ex parte* 133
Van Beil *v.* Prescott 134
Venus, The 294, 299
Vidoard *et al.*, Re 313
Violet frères *v.* Thomas 33
v. Vital, Liautaud & Co. 33
Vogeler, August, *et al. v.* Max Ernst 381
Vogeler & Co., A., *ex parte* 609
Voivet *v.* Scoppine 535
Volta Belt Co., Re 303
Vrau & Co, Ph., *v.* Pouillier-Loughaye *et al.* 89, 268

W.

Walch, Brooks, & Kellogg, Re 218
v. M. J. Cole & Co. 662
Walkden Aerated Waters Co., Re 624
Walter & Fielding, Re 193
Walter & Shaeffer, Re 602
Walton *v.* Crowley 33, 57, 362, 385, 402
Warburg & Co., Re 134
Ward *v.* Ward 682
Warfield *v.* Booth 522
Warner *v.* Roehr 443, 452, 520
Warren *v.* Warren Thread Co. 57
Warton *v.* Klug 439
Waters, C. & W. A., Re 68
Weaver, Re 606
Webster *v.* Webster 36, 526
Wedderburn *v.* Wedderburn 522
Wedgwood *et al. v.* Smith *et al.* 216
Weed *v.* Peterson 386, 471, 504, 508
Welch *v.* Knott 393
Weldon *v.* Dicks 497
Wendt & Rammelsberg, Re 68
West *v.* Rice 502
Weston *v.* Hemmons 545
v. Hunt 319
Wheaton *v.* Hubbard 424
Wheeler *v.* Johnston 103, 533
Wheeler & Wilson Manuf. Co. *v.* Shakespear 221, 521
White *v.* Schlecht 138
Whitely *v.* Swayne 813, 820, 651
Whittemore *v.* Cutter 315, 508
Whyte, Com. Dec., case of 111
Willcox *v.* Aubineau 89 *b*
Willcox & Gibbs Sewing Machine Co. *v.* The Gibbens Frame 89 *b*
Willett *v.* Blanford 524
Williams *v.* Adams 125, 130, 191, 681, 685
v. Boston & Albany R. R. 681
v. Johnson 119, 137
v. Williams 523, 545, 562
v. Wilson 526
Williamson, E. J., Re 273
Winans *v.* N. Y. & Erie R. R. Co. 338
Winfree & Lyon, Re 218
Winsor *v.* Clyde 560
Wintermute *v.* Redington 503
Witt *v.* Corcoran 523
Woodward *v.* Lazar 92, 528
Woolam *v.* Ratcliff 412
Wolfe *v.* Barnett 681
v. Burke 71, 475
v. Goulard 134, 596
v. Hart 134, 137
Wolfe *et al. v.* Udolpho Wolfe Co. 596
Worthington & Co.'s Trade-Mark, Re 266
Wostenholm & Son, Re 70
Wotherspoon *v.* Currie 130, 184, 185, 362, 600
Woven Wire Mattress Co., *ex parte* 277
Wright *v.* Hooker 590
Wylam *v.* Clarke 471

Y.

Yale, C. A., Cigar Manuf. Co. *v.* C. A. Yale 607, 661
Youatt *v.* Winyard 662
Young, *ex parte* (Re Lemon Hart & Son) 57
v. Jones Bros. & Co. 51
v. Macrae 134, 527

TABLE OF ABBREVIATIONS.

A. J.	Australian Jurist.
Abb. N. C.	Abbott's New Cases. (New York.)
Abb. Pr.	Abbott's Practice Reports. (New York.)
Ad. & E.	Adolphus & Ellis's Eng. King's Bench Reports.
Alb. L. J.	Albany Law Journal.
Am. L. Reg.	American Law Register.
Am. L. Rev.	American Law Review.
Am. L. T.	American Law Times.
Am. R.	American Reports.
Annales	Annales de la Propriété Industrielle, Artistique et Littéraire. (Paris.)
Atk.	Atkyns's Reports. (English Chancery.)
B. & Ad.	Barnewell & Adolphus, King's Bench Reports.
B. & Cr.	Barnewell & Cresswell, King's Bench Reports.
Bac. Abr.	Bacon's Abridgment.
Barb. Ch.	Barbour's Chancery Reports. (New York.)
Barb. S. C., or Barb. .	Barbour's Supreme Court Reports. (New York.)
Beav.	Beavan's Reports. (Rolls Court.)
Beng. L. R. App. . .	Bengal Law Reports, Appendix.
Bing. N. C.	Bingham's New Cases. (Eng. Common Pleas.)
Bing. N. R.	Bingham's New Reports. Do.
Biss.	Bissell. (U. S. Circuit Court.)
Blanc	Blanc sur la Contrefaçon.
Bl. Com.	Blackstone's Commentaries.
Blatch.	Blatchford's Reports. (U. S. Circuit Court.)
Bos.	Bosworth's Reports. (Superior Ct. N. Y. City.)
Brewst.	Brewster's Reports. (Pennsylvania.)
Burr.	Burrow. (English King's Bench.)
C. B.	Common Bench Reports.
C. C. C. Pap. . . .	Central Criminal Court Sessions Papers.
Cal.	California Reports.
Ch. D.	Law Reports, Chancery Division.
Codd. Dig.	Coddington's Digest.
Co. Litt.	Coke on Littleton.

Com. Dcc.	Commissioner's Decisions. (U. S. Patent Office.)
Conn.	Connecticut Reports.
Coop.	Cooper. (English Chancery Reports.)
Cox's Man.	A Manual of Trade-Marks, etc. (Rowland Cox.)
Cranch	Cranch's Reports. (U. S. Sup. Ct.)
Cro. Jac.	Croke's Reports. (King's Bench, *temp.* James I.)
Ct. of App.	Court of Appeal. (England.)
Ct. of Sess. Cas. . .	Court of Sessions Cases. (Scotch.)
Cush.	Cushing's Reports. (Massachusetts.)
D. & B.	Deersly & Bell's English Crown Cases.
D. & R.	Dowling & Ryland's English King's Bench Reports.
Daily Reg.	New York Daily Register.
Daly	Daly's Reports. (New York Common Pleas.)
Deady	Deady's Reports. (U. S. Circuit Court.)
De G., F. & J. . . .	De Gex, Fisher, & Jones's Eng. Chancery Reports.
De G. & J.	De Gex & Jones's Eng. Chancery Reports.
De G., J. & S. . . .	De Gex, Jones, & Smith's Eng. Chancery Reports.
De G., M. & G. . . .	De Gex, Macnaghten, & Gordon's Eng. Chan. Rep.
Dill.	Dillon's Reports. (U. S. Circuit Court.)
Doug.	Douglas's Reports. (English King's Bench.)
Drew. & S.	Drewry & Smale's Eng. Vice-Chancellor's Rep.
Eden on Inj.	Eden on Injunctions.
E. D. Smith	E. Delafield Smith's Reports. (N. Y. Common Pleas.)
Ex.	Exchequer Reports.
Fed. R.	The Federal Reporter.
Fish.	Fisher's U. S. Patent Cases.
Ga.	Georgia Reports.
Giff.	Giffard. (Eng. Vice-Chancellor's Reports.)
Gray	Gray's Massachusetts Reports.
Greenl. Ev.	Greenleaf on Evidence.
H. L. C.	House of Lords Cases.
H. & M.	Hemming & Miller. (Eng. Vice-Chancellor's Rep.)
H. & W.	Harrison & Wollaston. (Eng. King's Bench Rep.)
Hare	Hare's English Vice-Chancellor's Reports.
Hilt.	Hilton's Reports. (N. Y. Com. Pleas.)
Hoff. Ch.	Hoffman's Chancery Reports. (New York.)
Holmes	Holmes's Reports. (U. S. Circuit Court.)
Hopkins	Hopkins's Chancery Reports. (New York.)
How. App. Cas. . . .	Howard's Appeal Cases. (New York.)
How. Pr.	Howard's Practice Reports. (New York.)

Hughes	Hughes's Reports. (U. S. Circuit Court.)
Hun	Hun's New York Supreme Court Reports.
Ill.	Illinois Reports.
Ind.	Indiana Reports.
J. & W.	Jacob & Walker's English Chancery Reports.
Johns.	Johnson's Reports. (New York.)
Journ. du Palais . . .	Journal du Palais. (Paris.)
Jur..	The Jurist.
K. & J.	Kay & Johnson's English Vice-Chancellor's Reports.
Keen	Keen's English Rolls Court Reports.
Kent. L. R. and J. . .	Kentucky Law Reporter and Journal.
Keyes	Keyes's New York Reports.
La. Ann.	Louisiana Annual Reports.
Leg. Int.	Legal Intelligencer.
Leg. Obs.	Legal Observer.
L. J. Ch.	Law Journal, Chancery.
L. J. C. P.	Law Journal, Common Pleas.
L. J. Ex.	Law Journal, Exchequer.
L. J. K. B.	Law Journal, King's Bench.
L. J. M. C.	Law Journal, Magistrates' Cases.
L. J. Notes of Cas. .	Law Journal, Notes of Cases.
L. R. (Ireland) Ch. D.	Law Reports (Ireland), Chancery Division.
L. T. R.	Law Times Reports.
Lloyd	Lloyd on Trade Marks. (London.)
M. & C.	Mylne & Craig's English Chancery Reports.
Mackey	Mackey's Reports. (Supreme Court of D. C.)
Madd.	Maddock's English Chancery Reports.
Man. & Gr.	Manning & Granger's English Common Pleas Reports.
Man., Gr. & S. . . .	Manning, Granger, & Scott's do.
Mason	Mason's Reports. (U. S. Circuit Court.)
Mass.	Massachusetts Reports.
McLean	McLean's Reports. (U. S. Circuit Court.)
Md..	Maryland Reports.
Mer.	Merivale's English Chancery Reports.
Mich.	Michigan Reports.
Mo..	Missouri Reports.
Mo. App.	Missouri Appeals Reports.
Mod.	Modern Reports, English King's Bench.
Mont., D. & DeG. . .	Montagu, Deacon, & De Gex's Reports. (Lord Chancellor, etc.)
Monthly L. R. . . .	Monthly Law Reporter.

N. C.	North Carolina Reports.
N. & M.	Neville & Manning's English King's Bench Reports.
N. R.	The New Reports. (English.)
(N. S.)	New Series.
N. W. Reporter	Northwestern Reporter.
N. Y. Leg. Obs.	New York Legal Observer.
Of. Gaz.	Official Gazette of the United States Patent Office.
Ohio S.	Ohio State Reports.
Oreg.	Oregon Reports.
Pacific Coast L. J.	Pacific Coast Law Journal.
Pa. L. J.	Pennsylvania Law Journal.
Pemberton	Pemberton on Judgments.
Penn. L. J.	Pennsylvania Law Journal, Reports.
Penn. St.	Pennsylvania State Reports.
Pet.	Peters's Reports. (U. S. Supreme Court.)
Phil.	Phillips's English Chancery Reports.
Phila.	Philadelphia Reports.
Pick.	Pickering's Reports. (Massachusetts.)
Pop.	Popham's English King's Bench Reports.
Poth. des Ob.	Pothier on the Law of Obligations.
R. Cox	American Trade-Mark Cases. (Rowland Cox)
Rep.	The Reporter.
Rev. Stats.	Revised Statutes of the United States.
R. I.	Rhode Island Reports.
Robertson	Robertson's Reports. (New York Superior Court.)
Rose	Rose's Reports, English Bankruptcy.
S. & S.	Simons & Stuart's Reports, English Chancery.
Sandf. Ch.	Sandford's Chancery Reports. (New York.)
Sandf. S. C.	Sandford's Supreme Court Reports. (New York.)
Scot. L. Rep.	Scottish Law Reporter.
Seld.	Selden's Reports. (New York.)
Seton	Seton's Forms of Decrees in Equity.
Sim.	Simons's English Vice-Chancellor's Reports.
Supp. Rev. Stats.	Supplement to Revised Statutes of United States.
Swanst.	Swanston's English Chancery Reports.
T. R.	Term Reports.
Trade Marks	British and Foreign Journal of Commerce, Trade Marks, and International Exhibitions.
U. S.	Reports of the Supreme Court of the United States,
Upton	Upton's Trade-Marks.

V. & B.	Vesey & Beames's English Chancery Reports.
V. R. (W. W. & A'B.)	Wyatt, Webb, & A'Beckett's Victoria Reports. (Equity.)
Ves.	Vesey's English Chancery Reports.
Vict. L. R. Eq. . . .	Victoria Law Reports. (New Series.) Equity.
W. N.	Weekly Notes of Cases.
W. R.	Weekly Reporter, London.
Wall.	Wallace's Reports. (U. S. Supreme Court.)
Wall. Jr.	Wallace, Jr. (U. S. Circuit Court.)
Watts & Serg. . . .	Watts & Sergeant's Pennsylvania Reports.
Wend.	Wendell's Reports. (New York.)
West. Jur.	Western Jurist.
West. L. J.	Western Law Journal.
Wilson (Ind.) . . .	Wilson's Indiana Superior Court Reports.
Wis.	Wisconsin Reports.
Wood. & M.	Woodbury & Minot. (U. S. Circuit Court.)
Woods	Woods's Reports. (U. S. Circuit Court.)

LAW OF TRADE-MARKS.

CHAPTER I.

INTRODUCTION.

§ 1. Antiquity of the subject.
§ 2. Emblems of ownership coeval with birth of traffic.
§ 3. Origin, — in general ignorance.
§ 4. Seals, — most sacred proprietary marks.
§ 5. Trade-marks borrowed from heraldry.
§ 6. Sign-boards, as proprietary marks.
§ 7. Water-marks on paper.
§ 8. Stamps on ancient bricks, tiles, &c.
§ 9. Various kinds of circulating mediums.
§ 10. Stamping of precious metals.
§ 11. In all ages, symbolical expressions in favor.
§ 12. Hieroglyphics required by commerce.
§ 13. Chinese marks on fictile manufactures.
§ 14. Use of emblems on books.
§ 15. Proprietary marks of printers, painters, sculptors, &c.
§ 16. Swan-marks in England.
§ 17. Marks on clay pipes.
§ 18. Trade-marks are generally optional.
§ 19. Hall-marks, &c., in various countries.

§ 1. *Antiquity of the Subject.* — The main subject of this treatise — the symbolism of Commerce — may well be deemed to be as old as commerce itself. The most important part of that symbolism is comprehended in the brief conventional term "Trade-mark."[1] As the love of gain is inborn, it must

[1] In this age, when steam and electricity have nearly annihilated space, and brought all parts of the world together, it is surprising that the term

be assumed that in even the rudest ages of the world men obeyed the instinct of adding to gains, and therefore guarded against losses incident to keen and perhaps unscrupulous rivalry. By labor or traffic they had things to sell. He who sold and he who bought had alike to deal in faith. The faith had to rest on some mark on goods, some peculiar emblem that gave a quick but emphatic signal. All had to deal on trust, as all do now, and take as proof the representation of the affixed symbol, whether that symbol were the trade-mark of a nation on its coin, or the rude device of an unlettered artisan or trader. A glance of the eye sufficed. The first law of nature — self-preservation — was as potent in the protection of the means of livelihood as of life itself. History proves this.

§ 2. *Seals and other 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 im-

"trade-mark" is misunderstood. In the greater number of standard dictionaries of English there are definitions that do not define. Examine dictionaries.

Worcester, ed. of 1860: "A particular mark, sign, device, writing, or ticket put by a manufacturer upon his goods, to distinguish them from those of others." On the authority of Bouvier (*Law Dictionary*).

Webster, ed. of 1883, substantially the same, also limited to a *manufacturer*, on the authority of *Simmonds*.

Imperial Dictionary (by Ogilvie), 1883, also so limited.

Dictionary of Commerce and Manufactures, De Colange, 1881, substantially so limited.

Abbott's Law Dictionary properly defines.

Knight's American Mechanical Dictionary, vol. iii., 1876, contains the following, from the pen of the present writer: — "*Trade-Mark.* An arbitrary symbol affixed by a manufacturer or merchant to a vendible commodity. The principal purpose of a trade-mark is to guarantee the genuineness of a product. It is, in fact, the commercial substitute for one's autograph. In all ages it has been used to denote origin, and thus to protect the purchaser as well as the vendor. All countries protect the integrity of trade-marks, and nearly all civilized nations have treaties and conventions securing reciprocity of protection." As *tests*, it also recites the essential characteristics, substantially as in § 143, *infra*. This is a proper definition, in the light of authorities, as late as the year 1886.

pressed thousands of years ago. In truth, no organized system of trade could safely be conducted without the aid of symbols of *ownership*, or of *origin*;[1] 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 anything 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 — who, in the first age of the world, was "an instructor of every artificer in brass and iron" — was wont to impress upon 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

[1] As to the technical meaning of these words, as defined by the courts, see Chapter IV., "Indication of Origin or Ownership."

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 to inanimate property, 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 that the symbol of ownership might as well be applied to one kind of personal property as to 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.[1] 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";[2] and St. John tells of the mighty host who were sealed in their foreheads.[3] We speak of the seal of baptism, the seal of holy communion,

[1] See Gen. xxxviii. 18; Exod. xxviii. 11.
[2] 2 Tim. ii. 19. [3] Rev. vii. 3.

the seal of matrimony, and, most solemn of all, the seal of death.[1]

§ 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, on the field of which 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, inasmuch as it possesses a system, a classification, and a language, of its own, — which language speaks forth in many 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, signifying *to burn*) is a sign 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, seals are regarded as precious jewels 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 Aventinus "insigne paternum" upon his shield, — his hereditary device, derived by him from his father.[2] Badges are likewise proprietary marks: "Might I but know thee by thy household badge,"[3] says Shakespeare; and again he says,

[1] See "seal," 1 Kings xxi. 8; Nehem. ix. 38; and "sealed," Esther iii. 12. As to engraving, see Exod. xxviii. 2, "engraven in stone"; Job xix. 24, "graven with an iron pen and lead"; Jer. xvii. 1, "with a pen of iron, and with a point of a diamond: it is graven."

[2] Æneid, vii.

[3] Henry VI., Part II., Act 5.

"For sufferance is the badge of all our tribe."[1] The label, another heraldic term, is connected with trade-marks only as far as being a groundwork for figures or other devices.[2]

§ 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 less eager than their successors in the great bazaar 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. Among 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 driving 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 checkers. 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-emblem 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 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

[1] Merchant of Venice, Act 1.

[2] The signs belonging to tradesmen in the Middle Ages were heirlooms, but were gradually disused, until, from the development of international commerce, a "sign" on goods for sale became a necessity. Piracy on such marks became a trade with inferior tradesmen. The Globe Encyclopædia, *Trade-marks.*

acquirement with the commonalty; and consequently to write the trader's or owner's name would be of little avail. Those who 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 signboard the family crest of the lord of the estate whereon he lived! Luther was generally represented by the symbol of a swan; and hence "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? Who can tell?

§ 7. *Water-marks* on paper are used as proprietary signs. Temporary or accidental emblems have sometimes become permanent associations, as in the case of the kind of paper termed foolscap. In the reign of Charles I., all English paper bore in water-marks the royal arms. Cromwell's Parliament, to cast indignity upon the memory of the unhappy monarch, substituted the fool's cap and bells. Although in the course of events these symbols were discontinued, the name sticks. A notable instance of a sort of water-mark is that shown in obligations and other securities issued by the United States, in which threads of various-colored floss-silk are distributed through the paper in the process of manufacture. Such threads constitute a proprietary mark of the government; and it is a highly penal offence for any person to have such paper in his control or possession.[1] It may not seem irrelevant to allude to an interesting law case, which was decided by means of a water-mark on paper. There was produced a forged will, so cunningly executed that, although believed to be false, legal evidence of the fact of falsity was lacking. As the counsel of the rightful heir sat studying over the case at night, he chanced to hold the paper between his eyes and a candle.

[1] Revised Statutes of United States, sect. 5430.

He thus discovered in water-marks the figures of the year in which the paper was made. It was a period of years *after* the date of pretended execution.

§ 8. If one class of workmen might profitably employ peculiar marks to indicate origin, as well might any other class. The mechanics in the quarries, making ready the stones for the temple of Solomon, availed themselves of this mode of proving their claims to wages. Recent discoveries confirm tradition. The cinders of burnt Jerusalem have been cut through, and turned up to the light. While the seal of Haggai, in ancient Hebrew characters, has been picked up out of the siftings of the rich moulds deposited with the ruins of the treasures of Jewish pride, the first course of stones deposited by Phœnician builders has been reached. Quarry-marks put on in vermilion have been copied, — known to be quarry-marks by the trickled drops of the paint, still visible; only they are above the letters, showing that when they were affixed the stones lay with the under side uppermost.[1] The same practice continues to this very day, where many men are employed. The engineer and the architect know every mark, and thus can instantly fix the origin of the work. Our own artisans do not stop to think whether they are not pursuing the practice of forerunners of several thousand years ago. The tile-maker stamps his products with his private mark; and sometimes common building-brick is impressed with its maker's seal, rude though it be. The most ancient bricks, recovered from the ruins of temples of Nineveh and of Egypt, also bear many marks of origin. It was the rule of Nebuchadnezzar to have his name stamped on every brick that was used during his reign in erecting his colossal palaces. Sir Henry Rawlinson discovered on each brick in the walls of the modern city of Bagdad, on the borders of the Tigris, clear traces of that royal signature.[2] Fragments of pottery, having peculiar marks of workmen are everywhere found in the ancient cities of the East; pottery, as

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

[2] Müller's Science of Language. Also, Knight's Mechanical Dictionary, title "Brick."

Brongniart has remarked, affording the best records of the early ages of man, as bones do of the earth.[1]

§ 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. 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[2]) 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 having failed to receive full confidence, it was supplanted by actual coinage, which many authorities date from about seven centuries before the beginning of the Christian era.[3] 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

[1] See lecture by Prof. J. Forbes Boyle, F. R. S., on Arts and Manufactures of India; History of the Ceramic Art, from the French of Albert Jacquemart, London, 1873; and "Marks and Monograms on Pottery and Porcelain," &c., by William Chaffers, 4th ed., 1874, with 3,000 potters' marks and illustrations.

[2] Gillies's Ancient Greece, vol. i. p. 11.

[3] Snowden's Mint Manual of All Nations.

heroes. It was probably about the time that Daniel was cast into the lion's 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 engraved, 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 Maccabee. The first money coined in England was under the Romans at Colchester.

§ 10. There must have been an interval of over a 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 referred 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 have. 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

[1] Gen. xxiii. 14–16.

in the arts both of use and beauty. All these peoples 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 distinguishing 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. *Commerce required its hieroglyphics*, and commerce was world-wide. The situation of Babylon, at the head of the Persian Gulf, was admirably adapted for trading purposes; and, 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, — all sorts of serviceable commodities, — were floated on the Euphrates and the Tigris, or brought in caravans of camels to the grand central mart, every 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 claim to possess an exact chronology from the remotest antiquity to the present 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] Porcelain of China had sixteen hundred years' priority of invention over that of Europe; and 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, indicates the author of a vase, the place of manufacture, or the destination of the article, as for the use of the Emperor or other dignitary. On a piece of pure white china of great antiquity there was found stamped a factory-mark.

§ 14. The makers of books found it convenient to use arbitrary signs to authenticate their works. 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 half of all 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 Estienne, a bookseller and printer, whose firm for several generations continued to be the leading publishers and printers in Paris. The booksellers generally had wood-cuts of their signs for colophons of their books, so that their shops might become known by

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

[2] Histoire et Fabrication de la Porcelaine Chinoise. Translated from the Chinese, by Julian. Paris, 1856. — An interesting book is "The Old Derby China Factory," &c., by John Haslem. London, 1876. (Fac-similes of old marks.)

the inspection of the cuts. 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's 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 Aricia, 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

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

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 abregés," &c., of François Brulliot, published at Munich in 1832–34, and to be found in the Astor Library in the city of New York, and also 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 they were to be perfectly distinct from those used by other gentlemen. For instance, the company of the vintners had two nicks on the bills of their shows. 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.[1]

[1] Care must be taken not to confound mere proprietary marks and technical trade-marks. For examples of the former kind, see the act of the legislature of Canada, of May 12, 1870, (33 Victoria, c. 36,) respecting the marking of timber. It enacts that every person engaged in the business of lumbering or getting out timber, and floating or rafting the same on the inland waters of Canada within the provinces of Ontario and Quebec, shall, (under certain penalties for failure or neglect so to do,) within one month after he shall engage therein, select a mark, or marks, and, having caused the same to be registered as therein provided, shall put the same in a conspicuous place on each log or piece of timber so floated or rafted. These marks are *proprietary* and not *trade* marks. — The Indian Penal Code (Calcutta, 1861), Act No. XLV. of 1860, sect. 479, provides that a mark used for denoting that movable property belongs to a particular person shall be known as a *property-mark*, as contradistinguished from a trade-mark.

In various countries, and in our individual States, there are legislative provisions for marks or brands for cattle, or ear-marks for swine, or paint-marks for sheep. Such are simply means of identifying and proving property. Of course, all such marks may be made to serve a secondary purpose, by being adopted and known as symbols of commerce.

§ 17. The case of *Southron* v. *Reynolds*,[1] in England, in 1865, was in regard to a violation of a trade-mark used on clay pipes made at Broseley. "Broseley" is a household word with thousands who use the thing while wholly ignorant of its derivation, 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, no 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 ninety 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, France, and several other European countries, as well as in countries on our own continent; but there are exceptions in connection with various kinds of business. Thus, 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

[1] 12 L. T. R. (N. S.) 75.

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 then dealt in the precious and useful wares, as they do now.

§ 19. *Hall-marks* are among obligatory emblems. The first instance on record, in England, 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. In 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. In 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 century. In France there are standard and assay stamps required by the law of April 7, 1838. That country has also found it expedient to adopt a system of stamps analogous to the English Hall-marks, although they are not obligatory. A law of November 26, 1873, provides for a stamp or special sign to be affixed to marks of commerce or manufacture, as a guaranty thereof. Under its provisions

every proprietor of a mark duly registered conformably to the law of June 23, 1857,[1] shall be allowed, on his written request, to have affixed by the state, either on his paper labels, bands, or envelopes, or on his metallic labels, or stamps, a special stamp or punch to authenticate his mark. The duty to be paid therefor is from a centime to a franc. For affixing the punch directly to merchandise, the duty is from five centimes to five francs. A penalty is prescribed for counterfeiting or falsifying a special stamp or punch.[2] The government of Switzerland has recently recognized the necessity for obligatory marking of gold and silver watch-cases and jewelry. From the beginning of the year 1882, all watch-cases of gold of 18 carats, or 750 thousandths, and above, were required to be officially stamped with the designated figure of the head of a woman facing the left-hand side; and those of 14 carats, or 583 thousandths, must be stamped with the representation of a squirrel erect, facing the right-hand side. Silver cases of 875 thousandths, and above, must be stamped with the figure of a lion rampant, looking to the left-hand side; and if of 800 thousandths, with that of an arbitrary heraldic fowl running towards the right-hand side. The part to be stamped is also prescribed. The marking is obligatory, i. e. the article must bear the federal assay-mark. For other gold and silver ware, the marking is optional; but none such must bear any untrue indication of standard. For the infraction of that law, whether in manufacturing, selling, or offering for sale, severe civil and criminal penalties are prescribed.[3]

[1] See Law, in Appendix.

[2] See Journal Officiel, of Dec. 2, 1873; and 19 Annales, &c., 103.

[3] Horological Journal, London, 1882, vol. xxiv. p. 129. — See William Chaffer's interesting book (5th ed., London, 1874), entitled "Hall-Marks on Gold and Silver Plate," &c.

CHAPTER II.

PROTECTION OF TRADE-MARK PROPERTY.

§ 20. Right to Protection, — gradual recognition of.
§ 21. Alien friends, — protected the same as citizens.
§ 22. Comity of nations requires protection.
§ 23. Natural right of foreigners to protection.
§ 24. Mutual confidence a bond among nations.
§ 25. Progress of protection.
§ 26. Legislation of various nations, — detail of.
§ 27. Time come for equal protection.
§ 28. Constantly increasing importance of trade-marks.
§ 29. Limitation of right of protection to symbols.
§ 30. Mere imposition on public not ground of private suit.
§ 31. Equitable relief depends on legal right.
§ 32. A right of user is a species of property.
§ 33. Colorable variation, — examples of infringements.
§ 34. Principles on which infringement is prohibited.
§ 35. Comparative quality of goods, — not necessarily an element.
§ 36. The public should be protected. — Reason why.
§ 37. Pecuniary damages: foundation of suit.
§ 38. Question of fraud judged of as between immediate parties.
§ 39. Principle that underlies right to protection.
§ 40. Protection a powerful incitement to integrity in trade.
§ 41. Fundamental rule as to use of symbolism.
§ 42. Wherein consists the wrong in using another's mark.
§ 43. Unfair competition in business, — meaning of term.
§ 44. Seemingly exceptional case explained.
§ 45. Foundation of title to marks.
§ 46. Right in mark neither tangible nor visible.
§ 47. Statutory law not basis of right to protection.
§ 48. Registration of mark not essential to right in it.
§ 49. Right of property not always vindicable.
§ 50. Registration creates a presumption of proprietorship.
§ 51. A trade-mark not the creature of arbitrary law.
§ 52. What time required for perfection of title.
§ 53. Who may acquire property in trade-mark.
§ 54. Mere *selection* of representation is not adoption.
§ 55. Traders only can own trade-marks.
§ 56. Not all natural persons can own marks.
§ 57. Title by assignment.

§ 58. Who is an infringer.
§ 59. Confidence outraged by infringement.
§ 60. Protection should be secured by treaty.
§ 61. Fraud the basis of law's intervention.
§ 62. Whose rights are protected.
§ 63. Old books in doubt as to who is protected.
§ 64. The careless should be guarded against fraud.
§ 65. Doubts in minds of judges.
§ 66. *Class of Goods*, — definition of term.
§ 67. Class not so limited as to defeat justice.
§ 68. Same emblem in different classes.
§ 69. Importance of specific mention of class.
§ 70. A chopping-axe not in class of cutlery.
§ 71. A lack of truth debars mark from protection.
§ 72. Untrue use of word "patented," — illustrations.
§ 73. Inaccurate representation not fatal to suit.
§ 74. Simulations of foreign marks.
§ 75. Punishment of counterfeiters by Turks.
§ 76. Spurious coins and notes.
§ 77. Unfair competition not always punishable.
§ 78. Manufacture and Commerce twin sisters.
§ 79. How shall we judge a mark?

§ 20. *Right to Protection.* — The right of protection to trade-marks and their analogues, i. e. signs not technical marks, has come to be recognized throughout the domain of civilization. It was not always so, even after arbitrary symbols were recognized in commerce as exclusive property. As was said by a writer in 1874,[1] the law for the protection of this species of property is almost exclusively the growth of the last seventy or eighty years, and affords an interesting illustration of the process by which a few principles, at first doubtful and disputed, may be expanded into a complete system of jurisprudence. In 1742, Lord Hardwicke, C.,[2] used language that at the present day could not be countenanced in any tribunal of equity in the known world. He said: "Every particular trader has some particular mark or stamp; but I do not know of any instance of granting an injunction here to restrain one trader from using the same mark with another, and I think it would be of mischievous consequence to do it." He, accordingly, for want of precedent, refused an

[1] Adams on Trade-Marks, London.
[2] Blanchard *v.* Hill, 2 Atk. 484.

injunction to restrain the use of the Great Mogul stamp on cards, no suggestion being made as to the validity of that fanciful name as a trade-mark. His attention was called to an action on the case for deceit,[1] in which Doderidge, J., cited a decision of the same court in the reign of Queen Elizabeth, that an action on the case for deceit would lie against a clothier who had applied another's mark to his own inferior cloth. But that case is somewhat in the mist. Popham says, that the action was brought by the defrauded clothier, and Croke says, by the purchaser; but Rolle states that this was not specified, and conjectures that it was by the purchaser. — In 1783, Lord Mansfield, C. J., said plainly:[2] "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." — It seems that no courts of equity favored such proprietary rights until Lord Eldon, C., in 1803,[3] granted an injunction to restrain the wrongful use of the name of a publication, such name being of the nature of a trade-mark. — The right to protection in the Federal or State courts of the United States was never contingent on registration, or even publication. It might be thought otherwise, if the words of Mr. Justice Clifford in the Supreme Court of the United States were taken too literally.[4] He said: "Protection for lawful trade-marks may be obtained by individuals, firms, or corporations, entitled to the same, if they comply with the requirements prescribed by the act of Congress." Of course, he did not mean that there is no protection irrespective of a statute, for in his judicial practice he had had occasion to rule otherwise. Many of the States of this Union have enacted laws, both of a civil and penal nature, for the protection of marks of trade and commerce; but probably in no one of them would it be deemed that a compliance with registration acts is a condition precedent to a suit for vindication. We know that in Great Britain, France, and in other

[1] Southern *v.* How, temp. Jac. I, Common Pleas, Popham, 144; Cro. Jac. 471; 2 Rolle, 28; R. Cox, 633.

[2] Singleton *v.* Bolton, 3 Doug. 393.

[3] Hogg *v.* Kirby, 8 Ves. 215.

[4] McLean *v.* Fleming, 96 U. S. 248.

countries, it is absolutely necessary for the proprietor of a trade-mark to comply with registry laws before asking for judicial redress.[1] When the reader shall come to Chapters VI. and VII. of this treatise, he will see that registration is in aid of common law and equity, and is not subversive of pre-existing rights and remedies. The registration act of Congress, referred to by Mr. Justice Clifford, contained the words "may obtain protection"; but the act of March 3, 1881, which takes the place thereof, has studiously avoided the use of such misleading language. Certain and great advantages are given to him who registers thereunder; but if our courts can entertain jurisdiction on general grounds, a lack of registry will not defeat.[2]

§ 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. 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. . . . 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."[3] 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."[4] What is thus said is equally the rule of the individual States of this country. It is the law of England. In 1857 Vice-Chancellor Wood said, that any fraud may be redressed in the country in which it is committed, whatever may be the country of the person who is defrauded.[5] In the same year, the same learned jurist said as to the same attempted defence: "I apprehend

[1] See Statutes, in Appendix.

[2] Registration Act of March 3, 1881, sect. 10.

[3] Taylor *v.* Carpenter, Story and Sprague, JJ., 3 Story, 458. 1844.

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

[5] The Collins Co. *v.* Brown, 3 K. & J. 428; 3 Jur. (N. S.) 929; 29 L. T. 245; 3 L. T. 62.

that every subject of every country, not being an alien enemy, — and even to an alien enemy the court has extended relief in cases of fraud, — has a right to apply to this court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right, a right recognized, I imagine, everywhere in the world, or at least in every civilized community, of saying, 'We, being the manufacturers of certain goods, claim that another man shall not manufacture goods, and put upon them our trade-mark, and then pass them off as manufactured by us.'" — So, also, in 1858, Vice-Chancellor Stuart said of the plaintiffs: "Though they are aliens, they are entitled to sue in this court against any fraudulent invasion of their right, and that notwithstanding that the tools stamped with the marks, the fraudulent use of which is complained of, are not usually sold by them in this country."[1] And one is entitled to such protection, although at the time that the cause of complaint arose he was an alien enemy. In the German Imperial Court of Colmar, in 1873,[2] the defence in a case of piracy of a trade-mark was, that, by reason of the war between France and Germany, the treaties of commerce between the two countries had been suspended. In Germany, merchants in various wines imitated the trade-marks and labels of the French houses at Rheims, Epernay, and other places. They relied for impunity upon the fact that others had at the same time pirated on tobacco-marks. It was a mixed case. The counsel for the appellants (defendants below) spoke in German; the respondents' counsel spoke in French; the court, in German. But there was no confusion of tongues, nor of moral ideas. *Held*, that the state of war did not tolerate dishonesty.

§ 22. The comity of nations makes new concessions and demands in regard to the protection of commercial and industrial property, whatever may be the nationality of the suppliant for justice. The national sense of right, blunted by the long-prevailing feudal rule, that might makes right, is becom-

[1] The Collins Co. *v.* Reeves, 28 L. J. Ch. 56; 4 Jur. (N. S.) 865; 33 L. T. 101; 6 W. R. 717.

[2] Say *v.* Duringer *et al.*, 18 Annales, 148.

ing more acute. Countries that have heretofore been honest from policy are simultaneously rising to a high plane of morality. Laws like that of Luxembourg,[1] which denied to foreigners, not domiciliated, redress for usurpation of marks and names, and similar laws of other European countries, are gradually fading out. The prevailing spirit is that displayed in the Tribunal of Commerce of Geneva, in 1859.[2] It was there substantially held that the name of a manufacturer, and his mark, are his property under the law of nations. This doctrine has long been maintained by eminent jurists of England, France, and Germany; and as the nations find it to be as much to their interest as to their glory to throw down barriers, this doctrine is fast approaching world-wide acknowledgment. For proof, let us look at the treaty agreed upon in Paris, March 20, 1883, by the International Conference for the Protection of Industrial Property, at which twenty nations were represented.[3] It provides that subjects or citizens of each of the contracting states shall enjoy in all other states of the union, in that which relates to patents of inventions, industrial drawings or models, trade or business marks, and commercial titles, the advantages which the respective laws accord now or shall accord hereafter to their own citizens. Accordingly they shall have the same protection as such citizens, and the same legal remedy for every infringement of their rights, under the reserve of conformity with the formalities, and upon the conditions imposed upon citizens by the interior legislation of each state. (Art. 2.) The subjects of states not belonging to the union, who are residents of, or have industrial or commercial establishments within any of the states of the union, are assimilated to the subjects or citizens of the contracting states.

[1] Müller *v.* Haymann, 5 Annales, 62.

[2] Christofle & Co. *v.* Deleiderrier, 6 Annales, 29.

[3] Art. 1 reads: "Austria, Hungary, the Argentine Confederation, Belgium, Brazil, the United States of America, France, Great Britain and Ireland, Guatemala, Italy, Holland, Portugal, Russia, Sweden and Norway, Salvador, Switzerland, Turkey, Uruguay, and the United States of Venezuela, have entered into a union for the protection of industrial property." In 1883, our Senate postponed its consideration.

(Art. 3.) — But we are now considering only the distinctive emblem of one's individuality, i. e. his signature or mark upon his fabrics or merchandise, the existence of which depends solely on his own will. He created it: it is his property. Artificial rights, such as those pertaining to patents for inventions, have heretofore been the subjects of authorized plunder in even so enlightened a nation as the United Kingdom of Great Britain and Ireland; and to the present time, in our own country, the devouring of the children of the brain of foreign authors has perfect freedom. But the laws of commerce have always been governed by the maxim, *Debitum et contractus sunt nullius loci*, and a trade-mark belongs to commerce, and rules and maxims of debt and contract are applied to it; for the symbol has no vitality unless affixed in some physical way to something that is the subject of barter and sale. During all ages, in all parts of the commercial world, he who counterfeited or simulated, either by design or accident, that emblem of manufacture or traffic tersely designated a *trade-mark*, was deemed guilty of a tort. For such tort there should be ample redress by local laws. As was well said by Brady, J., in 1883,[1] in regard to protection, the ultimate object of the courts has been in all the cases of trade-mark adjudication, not only to protect and encourage honest competition, as a matter of public policy, but to condemn anything like dishonest traffic, or fraudulent or unjust attempts to invade existing rights.

§ 23. The natural right of foreigners to exclusive ownership of this arbitrary symbol for goods, while expressly or tacitly admitted by the jurisprudence of all civilized nations, has harshly been refused protection in default of specific treaty stipulations to that effect. Legislatures and judicial tribunals of even European states have so transgressed against conceded rights, and refused all remedies. 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.

[1] Electro-Silicon Co. *v.* Hazard, 29 Hun, 368.

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 they were aliens to France.[1] But such a state of affairs is rapidly obsolescent. The shortest way out of the difficulty has been taken, and treaties, conventions, and arrangements, scores in number, have been made to secure such rights of foreigners.

§ 24. Mutual confidence is the bond of union among nations and peoples. It follows, therefore, that whoever weakens such confidence by forgery, counterfeiting, or any other fraud, and begets distrust in mercantile dealings, is an enemy to all mankind. He becomes a pirate; and whether preying directly upon commerce on the high seas, or practising knavery and trickery on 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. Chief Justice Hargis, of the Kentucky Court of Appeals, in 1883, truly said:[2] "The trade-mark and the trade-reputation pirate always undertakes the difficult task of sailing between the Charybdis and Scylla of the law, but he should never be allowed a successful voyage. If, on the one hand, he escapes the rock by not infringing through the instrumentality of the trade-mark itself, he will not, on the other, if courts of equity are true to the principles of their own existence, be allowed a safe passage by the use of any means of deceit or false representation known to the inventive brain of man." We know that a general declaration of war against such spoliators is about to be proclaimed. Mutual reliance must be the rule. Every act of trade, by which operations to an almost boundless extent are daily transacted, is essentially founded on confidence. By the simple delivery of bits of paper bearing certain signs, millions of dollars are hourly transferred; and contracts of the greatest magnitude are

[1] 1 Annales, 36. (The matter has since been cured by a treaty between Great Britain and France.)

[2] Avery & Sons *v.* Meikle & Co., Kent. L. Rep. and Journal, April, 1883, 23 Alb. L. J. 203.

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 weaker; 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 their 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 the heart of Jobard. France itself has made more than forty treaties and conventions on the subject 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

[1] Jobard, Organon de la Propriété Intellectuelle.

activity, and behold the breaking down of the barriers of suicidal proscription.[1]

§ 26. *Legislation of Various Nations.* — It may be profitable to glance at the course of legislation of various nations on this subject. Perhaps France may be considered as the pioneer in general provisions for protecting marks of manufacture and trade. M. Treitt, of the French government, in an official letter to Lord Lyons, British Minister, said: The origin of trade-marks is as old as commerce itself. From the Middle Ages we find laws and regulations concerning such marks. But all those provisions were heterogeneous, unequal, and sometimes contradictory.[2] Special manufactures were favored, and the laws intended to protect their marks were sometimes very severe. A French writer tells us that these early laws, much anterior to industrial emancipation, were characterized with the rigor and penal exaggerations which always mark the essays of legislators. He says that a trace of this is found in the statute of 1666, relating to the fabrication of cloth of Carcassonne. The penalty for counterfeiting a trade-mark was six hours in the *carcan*,[3] and that was not changed until 1745. There were a number of other subsequent French laws on the subject, for special protection. The law of July 18, 1824, for the protection of property in commercial names, is the one anterior to 1857 that most concerns us; for, as M. Treitt says, recent judicial decisions have held that commercial names of foreigners (coming within the conditions of international treaties) are as implicitly protected in his country as are the names of French houses, — absolutely as fully as trade-marks are. On the 23d of June, 1857, France enacted her present excellent trade-mark registration law; and, to a greater or less extent, it has been imitated by divers

[1] In the Tribunal of First Instance of Ismailia, Egypt, in 1876, it was *held:* In the absence of a special law in Egypt for the protection of industrial rights, &c., natural law and equity shall be invoked. Hippolyte Arnoux *v.* Spiridione Antippa and Georges Zanghaki. On appeal, this doctrine was affirmed. Reports of Legislation in Foreign Countries, &c., Part II. p. 20.

[2] Reports of Legislation in Foreign Countries, p. 31.

[3] An iron collar by which the condemned was fixed to a post. The punishment was entirely suppressed in 1832. See Littré's Dictionary; also Blanc, Traité de la Contrefaçon, 773.

other nations. The matter had so carefully been considered by statesmen and legislators that its original text remains unchanged. — In the edition of 1857 of the Code of Civil Laws of Russia is found the law relative to the imposition of marks on products of Russian mills and manufactures. Austria enacted her registration law in 1858. In 1862, the British Parliament passed "An Act to amend the law relating to the fraudulent marking of merchandise." This is a penal statute directed against the forgery or counterfeiting of trade-marks, or the false application to goods, or to a vessel, case, wrapper, &c., of a false mark; the selling of articles by such false mark; or the false indication by description or statement, or respecting number, quantity, measure, or weight, of a chattel or article, or the sale of articles bearing the same. This statute did not affect the pre-existing common law and equity rights of action or suit by the aggrieved owners of the mark infringed on. The Kingdom of Italy passed a registration act in 1868; Turkey, in 1872; France, in 1873 (special-guaranty stamps, etc.);[1] the German Empire, and Chili, in 1875; the Argentine Republic, in 1876; Belgium, Switzerland, Roumania, Dominion of Canada, in 1879; Denmark and the Netherlands, in 1880. — In this country, nothing was done by the national legislature until the registration act of July 8, 1870, was passed. The promoters of the bill had very little knowledge of the general common law of the matter, and not the slightest regard to the Constitution. Indeed, it was not perceived what part of the Constitution was applicable to it. By a very great blunder, it was classed with inventions and authorship, and sandwiched in between the patent law and the copyright law in the same chapter. The writer of this book was the first officer who had to construe and apply its provisions. He had been selected from a belief that he possessed some knowledge of the principles of the matter. Soon seeing its more gross faults, he drafted bills and presented them to Congress. Committees did not wish to act until the courts had expressed an opinion as to validity. In 1871, an act was passed to prevent the importa-

[1] *Ante*, § 19.

tion of watches, or parts of watches, bearing the counterfeit marks of manufacturers in this country.[1] In 1876 was passed "An Act to punish the counterfeiting of trade-mark goods, and the sale or dealing in counterfeit trade-mark goods."[2] This act is still in force and effect, although, it must be admitted, it has for years been in a semi-comatose condition. The cause of that condition is, that it has seldom been roused into action, owing to misunderstanding as to its validity. An explanation is demanded. Briefly, the facts are as follows. In three cases, persons had been indicted for counterfeiting trade-marks. It will be noticed that that penal act referred only to trade-marks registered "pursuant to the statutes of the United States." The prisoners demurred to the several indictments. That compelled an examination into the question of the validity of the registration act of July 8, 1870; for that was the fulcrum of the lever. On a division of opinion in the courts below, the Supreme Court of the United States had to decide the question. That act was declared to be unconstitutional. Why? Because there had been a blundering looseness of phraseology, in not confining the provisions of the act to the kind of commerce over which Congress has control; viz. that with foreign nations, among the several States, and with the Indian tribes. Said Mr. Justice Miller, in delivering the opinion of the court:[3] "If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it." That is to say, the penal act of 1876 was inoperative in the cases before the court. It was never intended to be declared unconstitutional *per se*. That act was virtually re-adopted by Congress in passing the Supplement to the Revised Statutes, on June 7, 1880. The court having authoritatively indicated the errors that had been committed for lack of artificial language, the writer prepared a new bill. After much mutilation, and some admixture of absurdities in the first and last sections, it became the regis-

[1] Revised Statutes, sect. 2496; amended in 1883 to include *any other* articles.
[2] Supplement to Revised Statutes, vol. i. ch. 274.
[3] Trade-Mark Cases, 100 U. S. 99.

tration act of March 3, 1881.[1] It was amended in a slight particular, August 5, 1882.[2] As intelligence develops, it will no doubt be amended and perfected. It does not require a very keen intellectual vision to perceive that the penal act of 1876 immediately thereupon started into full vigor, and is operative in conjunction with the civil registration law.[3] — In 1883, the Grand Duchy of Luxembourg passed a general registration act, and, in the same year, Great Britain amended the acts of 1875–76. — By Imperial decree, dated June 7, 1884, very excellent trade-mark regulations were promulgated in Japan, with elaborate by-laws for registration purposes. — From these citations, it is manifest that the sentiments of nearly all nations are in harmony.

§ 27. Said an able writer in France, in 1855:[4] "The movement has now come for each state to prescribe in its legislation, that the names and marks of manufactures 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 the annihilation of distances by the agencies of steam and electricity, a noble and enlightened competition has been established, and promises to exert a sway over the whole earth. Commerce and industry are constantly becoming less centralized, and the laws thereof are becoming assimilated. Verily, the trade-mark has become a symbol of importance. The mightiest monarchs respect it. The recognition of it is world-wide, for it spurns the thraldom of territorial limits. All peoples might adopt the ideas of Professor Leone Levi, 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

[1] See Chapters VI. and VII. of this book.

[2] Providing that nothing contained in the act of 1881 "shall prevent the registry of any lawful trade-mark rightfully used by the applicant at the time of the passage of said act."

[3] See Appendix.

[4] 1 Annales, 33

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, everywhere accredited, that the coin is of a specific weight and fineness. Why should it not be now as in former times, when the mark was not simply the signature of the merchant or the manufacturer, but also a certificate of quantity, given by public authority, touching the quality of the produce, its origin, weight, &c.? [1]

§ 28. With the constantly increasing importance of the trade-mark, so much greater is the eagerness to ascertain and apply the principle upon which its security depends. It has the good wishes of honest industry and commerce. It incurs the ill-will of nobody, for it has not the least taint of odious monopoly or of restriction of trade. Competition is left free to all. The counterfeiter pays it a tribute of respect by his wrongful imitations. The principle on which relief and protection depend has been enunciated in a long train of decisions of learned judges. It is, that a man is not to sell his own goods under the pretence that they are the goods of another man: he cannot be permitted to practice such a deception, nor to use the means which contribute to that end.[2] You may express the same principle in a different form, and say that no man has a right to dress himself in colors, or adopt and bear symbols, to which he has no peculiar or exclusive right, and thereby personate another person, for the purpose of inducing the public to suppose, either that he is that other person, or that he is connected with and selling the manufactures of such other person, while he is really sell-

[1] Journal Soc. Arts, vol. vii. p. 202.

[2] Perry *v.* Truefitt, 6 Beav. 66; 1 L. T. 384.

ing his own. It is perfectly manifest that to do these things is to commit a fraud, and a very gross fraud;[1] and the effect of false representations, thus held out, is to deprive the owners thereof of the profits of their skill and industry. One is only required to depend for success upon his own character and fame.[2] 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 trade-mark, indicating to those who wish to give him their patronage that the article is manufactured or sold by him, or by his authority, he is entitled to protection against a defendant who attempts to pirate upon the good-will of the complainant's friends or customers, or the patrons of his trade or business, by sailing under his flag without his authority or consent.[3] The manufacturer's trade-mark is an assurance to the public of the quality of the goods, and a pledge of his own integrity in their manufacture or 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 the individual, require that the necessary protection shall be given.[4] If an article by representation 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.[5] The owner of the mark has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking exactly like it, but that they shall not sell it in such a way as to steal (so to call it) his trade-mark, and make purchasers believe that it is the manufacture to which that trade-mark was originally applied.[6]

§ 29. But when we speak of protection to a symbol of any

[1] Croft *v.* Day, 7 Beav. 84.

[2] Taylor *v.* Carpenter, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45.

[3] Partridge *v.* Menck, 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72.

[4] The Amoskeag Manufacturing Co. *v.* Spear, 2 Sandf. S. C. 599; R. Cox, 87.

[5] Coffeen *v.* Brunton, 5 McLean, 256; R. Cox, 132.

[6] Farina *v.* Silverlock, 6 De G., M. & G. 217; 26 L. J. Ch. 11; 2 Jur. (N. S.) 1008; 27 L. T. 277; 4 W. R. 731.

kind claimed as a trade-mark, we must understand that there is a limitation to the right. The trade-mark which is entitled to protection must be such as will identify the article to which it is affixed as that of the person adopting it, and distinguish it from others.[1] For example: if a trade-mark consist of words, as it may, such words must be specific and distinctive in their meaning;[2] and words and names that may be claimed and used by all cannot be exclusively appropriated to advance the interest of any one person.[3] There is no principle more firmly settled in the law of trade-marks, than that words and phrases, which have been in common use, and which indicate the character, kind, quality, and composition of the thing, may not be appropriated by one to his exclusive use.[4] No one can claim protection for the exclusive use of a trade-mark which would practically give him a monopoly in the sale of any goods.[5] The foregoing remarks, which are mostly in the exact words of judges, are examples of the sayings of modern courts in an unbroken current of decisions. We see that — subject to necessary limitations against usurpation of the rights of the public at large — one may have in a mere emblem affixed to his goods something more valuable than artificial property, such as a patent for invention or a copyright, to neither of which has a trade-mark any relationship. Sometimes it is the sole means of protection, although its life is limited only with that of the business of which it is the index. 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,

[1] Gillott *v.* Esterbrook, 47 Barb. 455; R. Cox, 340; N. Y. Com. of App., 48 N. Y. 374; 8 Am. R. 553.

[2] Fulton *v.* Sellers, 4 Brewst. 42.

[3] Newman *v.* Alvord, 49 Barb. 588; 35 How. Pr. 108; R. Cox, 404; 51 N. Y. 189; 10 Am. R. 588.

[4] Caswell *v.* Davis, 58 N. Y. 223; 17 Am. R. 233.

[5] Delaware & Hudson Co. *v.* Clark, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 79.

and indeed was more efficacious than any patent could be, unless we consider that he did possess an indefeasible 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. A very recent case in England may serve as an illustration. It appeared that iron manufactured in Sweden by Baron de Geer had ever since 1643 been branded (in compliance with Swedish law) with a device consisting of a hoop and the letter L, which device was registered in Sweden as a trade-mark as far back as 1718, and he was protected against imitators.[1]

§ 30. *Mere Imposition on the Public*, by the fact of 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 consideration until sure that we comprehend the scope of this brief enunciation. The point is, not the case of the purchaser who has his action for deceit, but of the owner of a peculiar symbol used as a trade-mark which has been encroached on by a rival, or a pirate, and who has a right, in the words of Lord Cranworth, C., to prevent others from selling wares which are not his, marked with that trade-mark, in order to mislead the public, and so, incidentally, to injure the person who is the owner of the trade-mark.[2] Lord Westbury, C., said that "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property."[3] Substantially the same thing was said by the Lord Chancellor in another case.[4] But the object or purpose of the law in protecting trade-marks as property, says Carpenter, J., is twofold: first,

[1] Re Heaton's Trade-Mark, The Weekly Notes, July 5, 1884, p. 158.
[2] Farina *v.* Silverlock, 6 De G., M. & G. 217.
[3] Hall *v.* Barrows, 4 De G., J. & S. 150; 33 L. J. Ch. 204; 10 Jur. (N. S.) 55.
[4] The Leather Cloth Co. case, 4 De G., J. & S. 141.

to secure to him who has been instrumental in bringing into market a superior article of merchandise, the fruit of his industry and skill; and secondly, to protect the community from imposition, and furnish some guaranty that an article purchased as the manufacture of one who has appropriated to his own use a certain name, symbol, or device as a trade-mark, is genuine.[1] Bynum, J., said, in substance, that this rule is grounded upon a twofold reason: first, that the public may be protected from being imposed upon by a spurious or inferior article, as an imitation or counterfeit almost always is; and secondly, that the owner may have the exclusive benefit of his reputation.[2] Brady, J., 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 a manner as may deceive them, by inducing the purchase of one thing for another.[3] Van Brunt, J., said that it is the duty of the court to protect the public from fraud, even at the suit of a plaintiff who has not the exclusive right to the use of words, numerals, or symbols, used by him;[4] but Hargis, Ch. J., in 1883, dissented from this opinion, saying, more properly, that the protection of the public alone is not sufficient ground for the jurisdiction. "However," he said, "it is an element which enters, and ought to enter, into every case. . . . If the plaintiff cannot show that his rights or interests are injured, or taken from him, he can have no standing in court, for strictly he represents the public no more than any one else."[5] This is the doctrine that is sanctioned by the current of decisions.

§ 31. The Lord Chancellor, in *Spottiswoode* v. *Clark*,[6] in 1846, said: "These cases depend so much upon their own

[1] Boardman *v.* The Meriden Britannia Co., 35 Conn. 402; R. Cox, 490.
[2] Blackwell *v.* Wright, 73 N. C. 310.
[3] Matsell *v.* Flanagan, 2 Abb. Pr. R. (N. S.) 459; R. Cox, 367.
[4] Kinney *v.* Basch, 16 Am. L. Reg. (N. S.) 596.
[5] Avery *v.* Meikle, § 43, *infra*.
[6] 10 Jur. 1043; 8 L. T. 230–271; 2 Ph. 154; 1 Coop. 254.

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 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 he 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] Without unnecessarily multiplying examples, the subject may be comprehended in this one saying, — that every man has a right to the reward of his skill, his energy, and his honest enterprise; and when he has appropriated, as his trade-mark, even letters combined with a word before unknown, and has used that word and has published it to the world as his adopted trade-mark, he has acquired rights in it which the courts will protect;[2] and he may use as his trade-mark any symbol or emblem, however unmeaning in itself; and if such symbol or emblem come 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.[3]

§ 33. *Colorable Variation.* — It is frequently difficult to determine, as fact, what is infringement. Two marks that are supposed to conflict may resemble each other, and yet differ in striking particulars. This question then arises: Is the difference only colorable? But no general or fixed rule can be laid down as to what may or may not be 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.[4] To constitute an infringement of a trade-mark, exact similitude is not required, but an infringement is committed when ordinary purchasers, buying with ordinary caution, are likely to be misled;[5] it being enough to show that the representations bear such a resemblance to the plaintiff's mark as to be calculated to mislead the public generally, who are purchasers of the article bearing it.[6] That means persons of ordinary intelligence, who adopt ordinary precaution against imposition and fraud,[7] and use such reason-

[1] Partridge *v.* Menck, 1 How. App. Cas. 558.

[2] Burnett *v.* Phalon, 9 Bos. 193; R. Cox, 356. See the same case in the N. Y. Ct. of App., 3 Keyes, 594; R. Cox, 397.

[3] The Leather Cloth Co., *supra*, in the House of Lords, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. (N. S.) 513; 12 L. T. (N. S.) 742; 13 W. R. 873.

[4] Lord Cranworth, in Leather Cloth case, 11 H. L. C. 533; N. Y. Ct of App., Popham *v.* Wilcox, 66 N. Y. 69.

[5] Sup. Ct. of U. S., McLean *v.* Fleming, 96 U. S. 245.

[6] Walton *v.* Crowley, 3 Blatch. 440.

[7] Blackwell *v.* Wright, 78 N. C. 310.

able care and observation as the public generally are capable of using and may be expected to exercise.[1] It is sometimes the case that the names of articles are of a character to mislead and deceive, they being *idem sonans* in the usual pronunciation; or the form of the package, general appearance of the wrapper, color of label, wax impressions on the top of the box containing the goods, are well suited to divert the attention of the unsuspecting buyer from any critical examination,[2] and the courts do not require a critical examination. It was well said by Wood, V. C., in 1854, that in every case the court must ascertain whether the differences are made *bona fide* in order to distinguish the one article from the other, whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are merely colorable, and the resemblances are such as are obviously intended to deceive the purchaser of the one article into the belief of its being the manufacture of another person. Resemblance is a circumstance of primary importance for the court to consider, because if the court finds, as it almost invariably does find in such cases, that there is no reason for the resemblance except for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading.[3] Such is the reasoning of all the courts. Probably Vice-Chancellor Shadwell did not go too far, in 1847, when he said that, "If a thing contains twenty-five parts, and but one is taken, an imitation of that one will be sufficient to contribute to a deception, and the law will hold those responsible who have contributed to the fraud."[4] In this place it is convenient to give examples, the more fully to illustrate the foregoing doctrines. Thus, the name "Wedgwood" was held to have been infringed by "Wedgewood";[5] "Perry Davis' Pain Killer," by "Perry's Vegetable Pain-Killer,"[6] and "The Great Home Remedy, Kennedy's Pain-Killer," but with quite different labels;[7] "Shrimpton &

[1] Gilman *v.* Hunnewell, 122 Mass. 139.
[2] McLean *v.* Fleming, *supra*.
[3] Taylor *v.* Taylor, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271.
[4] Guinness *v.* Ullmer, 10 L. T. 127.
[5] Cox's Man., case 96.
[6] Davis *v.* Kendall, 2 R. I. 566.
[7] Davis *v.* Kennedy, Codd. Dig. 236.

Hooper," by "Shrimpton Turvey";[1] "Taylor's Persian Thread," by same name except that defendant had inserted "Sam" instead of "J. W." before the name;[2] "Bell's Life in London," by "The Penny Bell's Life and Sporting News";[3] "The London Journal," by "The London Daily Journal";[4] a cross and letters "C B," by a cross and letters "C S";[5] an anchor on a metal label (from which plaintiff's wire had acquired the name of "Anchor Brand Wire"), by an anchor and small crown (from which the defendant's wire was called the "Crown and Anchor Wire");[6] "Govan *" (from which plaintiff's goods had acquired the name of star-iron), by "Coats *";[7] "Stephens'," by "Steelpen's," for bottles of ink;[8] "Jülicks," by "Josephs";[9] "Cocoaine," by "Cocoïne";[10] "Schweitzer's Cocoatina," by "Otto Schweitzer, Atkins & Co.'s Cocoatine";[11] "The Hero," by "The Heroine";[12] "Charter Oak" and a sprig of oak-leaves, by the name, omitting the oak-leaves;[13] "Bovilene," by "Bovina";[14] "Tonge's," by "Tung's";[15] "Stark," by "Star";[16] "Hostetter & Smith," by "Holsteter & Smyte";[17] the figure of a milkmaid, by the figure of a milkman;[18] "1847, Rogers & Bros., A. 1," by "C. Rogers Bros., A. 1," and "C. Rogers & Bros., A. 1";[19] "Our Young Folks, an Illustrated Magazine for Boys and Girls," by "Our Young Folks' Illustrated Paper";[20] "Wolfe's

[1] Shrimpton *v.* Laight, 18 Beav. 164.
[2] Taylor *v.* Taylor, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271.
[3] Clement *v.* Maddick, 1 Giff. 98; 5 Jur. (N. S.) 592; 33 L. T. 117.
[4] Ingram *v.* Stiff, 5 Jur. (N. S.) 947; 33 L. T. 195.
[5] Cartier *v.* Carlile, 3 Beav. 292; 8 Jur. (N. S.) 183.
[6] Edelsten *v.* Edelsten, 9 Jur. (N. S.) 479; 7 L. T. (N. S.) 768; 11 W. R. 328.
[7] Dixon *v.* Jackson, 5 Ct. of Sess. Cas., 3d series, 326; 2 Scot. L. R. 188.
[8] Stephens *v.* Peel, 16 L. T. (N. S.) 145.
[9] Farina *v.* Cathery, L. J., Notes of Cases, 1867, p. 134.
[10] Burnett *v.* Phalon, 3 Keyes, 594.
[11] Schweitzer *v.* Atkins, 37 L. J. Ch. 847; 19 L. T. (N. S.) 6; 16 W. R. 1080.
[12] Rowley *v.* Houghton, 2 Brewst. 303; 7 Phil. 39; R. Cox, 486.
[13] Filley *v.* Fassett, 44 Mo. 173; R. Cox, 530.
[14] Lockwood *v.* Bostwick, 2 Daly, 521; R. Cox, 555.
[15] Tonge *v.* Ward, 21 L. T. (N. S.) 480.
[16] Gardner *v.* Bailey, Codd. Dig. 131.
[17] Hostetter *v.* Vowinkle, 1 Dill. 329.
[18] The Anglo-Swiss Condensed Milk Co. case, Weekly Notes, 1871, p. 163.
[19] The Meriden Britannia Co. *v.* Parker, 39 Conn. 450; 12 Am. R. 401.
[20] Osgood *v.* Allen, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124.

Aromatic Schiedam Schnapps," by "Von Wolf's" or "Van Wolf's Aromatic Schiedam Schnapps";[1] "Rising Sun Stove Polish," by "Rising Moon Stove Polish";[2] "Apollinaris Water," by "London Apollinaris Water" (an artificial compound, containing the same chemical constituents as the natural water, but in a different kind of bottles, and differently labelled);[3] "Bethesda Mineral Water," by "Glenn-Bethesda Mineral Water";[4] "Tamar Indien," by "American Tamar";[5] "Lacto-Peptine," by "Lacto-Pepsine";[6] "Hemy's Modern Royal Tutor for the Pianoforte," by "Hemy's New and Revised Edition of Jousse's Royal Standard Pianoforte Tutor" (the defendant having employed Hemy to prepare a new edition of an obsolete work, "Hemy's" being in large and conspicuous letters);[7] "Mottled German Soap," with a device of a circle containing a moon and thirteen stars, by "S. W. McBride's German Mottled Soap," in combination with a crescent, within which was a single star;[8] "Robert's Parabola Needles," by "William Clark & Sons' Parabola Needles";[9] "The American Grocer," by "The Grocer";[10] "National System of Penmanship," by "Independent National System of Penmanship."[11] — A case in England, in 1880, has some peculiarities. From one of the essential features of the plaintiffs' trade-mark ticket, their goods had become known as "two-elephant" yarn. The trade-mark was complex, — a golden crown, on each side of which was a golden elephant, with its head turned away from the crown, and suspended from the elephants was a golden banner, which nearly filled the space between the crown and the apex of the triangle (the shape of

[1] Burke *v.* Cassin, 45 Cal. 467; 13 Am. R. 204.

[2] Morse *v.* Worrell, 9 Am. L. Rev. 308; Codd. Dig. 242.

[3] 38 L. T. (N. S.) 242.

[4] Dunbar *v.* Glenn, 42 Wis. 118; 24 Am. R. 395.

[5] Grillon *v.* Guénin, Weekly Notes, 1877, p. 14.

[6] Carnrick *v.* Morson, L. J., Notes of Cases, 1877, p. 71; Chemist and Druggist, 1877, p. 161.

[7] Metzler *v.* Wood, 8 Ch. D. 208; 47 L. J. Ch. 625; 38 L. T. (N. S.) 541; 26 W. R. 577.

[8] Procter & Gamble *v.* McBride *et al.*, 18 Off. Gaz. 1278; 8 Biss. 398.

[9] Roberts *v.* Sheldon, 8 Biss. 398.

[10] Am. Grocer Publishing Co. *v.* Grocer Publishing Co., 25 Hun, 398.

[11] Potter *et al.* (respondents) *v.* McPherson *et al.* (appellants), 21 Hun, 159.

the green ticket used). On the defendants' yarn was a rectangular ticket of a red color and a sitting figure with an elephant's head. The ticket complained of was placed on the main wrapper. It was of a similar shape and color to the plaintiffs' two-elephant ticket (that having a shape and a color commonly used in the trade), and it had also two golden elephants and a golden banner upon it. But although it differed in several respects from that of the plaintiffs, it was held to be an infringement.[1] Courts of justice of continental countries of Europe have very frequently had this class of cases to consider. In the following citations, trade-marks have been held to be infringed by attempted evasions, viz.: the fanciful name "JOB," by "Guerre à Job,"[2] by "J. H. B.," by "JOC,"[3] and by "JOP";[4] "Liqueur du Mont Carmel," by "Carmeline";[5] "Eau de toilette de Lubin," by "Eau de toilette aux fruits et fleurs Lupin";[6] "Eau de mélisse des Carmes," by "Eau de mélisse des Carmes Saint-Jacques";[7] "Chartreuse," by "Chartreuse de Saint-Hugon";[8] "Figaro," by "Petit Figaro,"[9] and by "Nouveau Figaro";[10] "C P" followed by the words "à la Sirène," by the words "None genuine except stamped C. P. and labelled à la Sirène," and "E P" substituting "Sarazène" for "Sirène";[11] "Byrrh," by "Blyr,"[12] and "Byrrh Vital au Malvoisie";[13] "Abricotine," by "Abricotain" (and other circumstances);[14] "Tapioca des familles," by "Tapioca des familles brésiliennes";[15] "Savons des Princes brésiliens" by "Savon aux parfums brésiliens."[16]

[1] Orr Ewing & Co. *v.* Johnston & Co., 13 Ch. D. 463.

[2] See § 308, *infra*.

[3] Bardou *v.* Berlin *et al.*, 18 Annales, 65.

[4] 22 Annales, 139.

[5] Faivre *v.* Boulan *et al.*, 19 Annales, 378.

[6] F. Prot & Co. *v.* Cabrideus *et al.*, 20 Annales, 369.

[7] A. Boyer *v.* C. Boyer *et al.*, 21 Annales, 25.

[8] Grézier *v.* Rivoire, 23 Annales, 191. See also §§ 410, 582, *infra*.

[9] De Villemessant *v.* N. Estibal *et al.*, 23 Annales, 269.

[10] Le Figaro *v.* Le Petit Figaro, 25 Annales, 174. See also § 547 *et seq.*, for other cases of publications.

[11] Farcy *et al. v.* Epailly *et al.*, 24 Annales, 123.

[12] Violet Frères *v.* Thomas, 24 Annales, 125.

[13] Violet Frères *v.* Vital, Liautaud, & Co., 27 Annales, 307.

[14] Garnier *v.* Richard, 25 Annales, 353.

[15] Chapu *v.* Legrand *et al.*, 27 Annales, 201.

[16] Décressonière *v.* Celisse *et al.*, 27 Annales, 349.

§ 34. *Principles on which Infringement is prohibited.* — Lord Langdale, M. R., said, in 1842, that the principle on which both courts of law and equity proceed in granting relief and protection is well understood; viz. that a man is not to sell his own goods under the pretence that they are the goods of another man.[1] He subsequently expressed the same principle in a different form of words.[2] — In 1846, the court of last resort in New York said substantially, that, while one is at liberty to manufacture and vend the same kind of goods as his rival, he is required to depend for success upon his own character and fame, and is only required not to pirate upon the rights of others.[3] In 1848, Walworth, C., said, that the question in such cases is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he puts his trade-mark, nor whether the article made and sold by the defendant under the complainant's trade-mark is an article of the same quality and value, but whether he is entitled to protection against a defendant who attempts to pirate upon the good will of the complainant's friends or customers, or the patrons of his trade and business, by sailing under his flag without his authority or consent.[4] In 1849, in a leading case, Duer, J., said that an injunction ought to be granted wherever the design of a person who imitates a trade-mark, be his design apparent or proved, is to impose his own goods upon the public as those of the owner of the mark, and the imitation is such that the success of the design is a probable or even possible consequence;[6] and it is not essential that the article of the defendant be inferior in quality, or that he should fraudulently represent it so as to impose upon the public; but if it be so assimilated to the genuine mark as to be taken in the market for the merchandise of another, the original person is entitled to an

[1] Perry *v.* Truefitt, 6 Beav. 66; 1 L. T. 384.

[2] Croft *v.* Day, 7 Beav. 84.

[3] Taylor *v.* Carpenter, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45.

[4] Partridge *v.* Menck, 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72.

[5] The Amoskeag Manufacturing Co. *v.* Spear, 2 Sandf. S. C. 599; R. Cox, 87.

injunction.[1] The Supreme Court of Connecticut, in 1870, said that the ground on which courts of equity afford relief in that class of cases is the injury to the party aggrieved, and the imposition upon the public, by causing them to believe that the goods of one man or firm are the production of another.[2]

§ 35. *Quality of Goods, and Invention of Article or Mark.* — The question of comparative quality is not necessarily an element, either at law or in equity. Yet it is sometimes well to establish the fact that the infringer has not only usurped trade, but by attaching the mark to inferior goods he has also damaged the reputation of the goods of the owner of the mark. In 1833, in *Blofield* v. *Payne*, an action on the case, it was held by Lord Denman, C. J., that although no specific damage was proved, and the jury found the defendant's article to be not inferior to the plaintiff's, the plaintiff was still entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendant.[3] So it was also held in another action on the case, in 1846, in a United States Circuit Court.[4] No *law* case is found, where a doctrine to the contrary prevailed. Courts of *equity* have as uniformly so held.[5] As to original invention, Walworth, C., said, in *Partridge* v. *Menck*: "The question in such cases 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." Federal courts so rule. Nor is the origin of the mark borne by the merchandise of moment, provided the claimant shows title in himself. The Patent Office so holds. Indeed no authority appears to the contrary.

§ 36. *The Public should be protected.* — It is frequently necessary for courts of justice to consider the ground on

[1] Coffeen *v.* Brunton, 5 McLean, 256; R. Cox, 132.

[2] Holmes, Booth, & Haydens *v.* The Holmes, Booth, & Atwood Manufacturing Co., 37 Conn. 278; 9 Am. Rep. 324.

[3] 4 B. & Ad. 410; 1 N. & M. 353; 2 L. J. K. B. (N. S.) 68.

[4] Taylor *v.* Carpenter, 2 Wood. & M. 1; R. Cox, 32; 9 L. T. 514.

[5] Taylor *v.* Carpenter, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45; Partridge *v.* Menck, *supra*; Coffeen *v.* Brunton, *supra*; Edelsten *v.* Edelsten, 1 De G., J. & S. 185; 9 Jur. (N. S.) 479; 7 L. T. (N. S.) 768; 11 W. R. 828.

which a party bases his demand for redress. In 1791, Lord Chancellor Thurlow held, that a possible fraud on the public gave no claim for an injunction.[1] This ruling has been followed in numerous instances in England and in this country. It means, doubtless, that something more than a general wrong must be alleged and proved to warrant the stretching forth of the judicial arm. While few courts have gone so far as to discard the fact of injury to the public as an element of damage to the one whose mark of authenticity has been infringed, yet, even as late as 1879, a court, in discussing the principle of protection, has used expressions seemingly as limited as that of Lord Thurlow. Lord Justice James, in *Levy* v. *Walker*, in the Court of Appeal, said: "The court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything."[2] Mr. Justice Duer, in 1849, in his very able opinion in the case of the *Amoskeag Manuf. Co.* v. *Spear*,[3] 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 1867, in *Matsell* v. *Flanagan*,[4] 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

[1] Webster *v.* Webster, 3 Swanst. 490.
[2] 10 Ch. D. 436; 48 L. J. Ch. 273; 39 L. T. (N. S.) 656.
[3] The Amoskeag Manufacturing Co. case, *supra*.
[4] 2 Abb. Pr. R. (N. S.) 459.

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 1865, in *Swift* v. *Dey*,[1] — which was a controversy in regard to a trade-mark on match-boxes, — said, substantially, that it is eminently a question of fact, to be submitted to the practical experience of a jury, whether, in a particular case, a resemblance is 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 1854, in *Gillott* v. *Kettle*,[2] 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

[1] 4 Robertson, 611; R. Cox, 319.
[2] 3 Duer, 624; R. Cox, 148.

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 case. Fraud and damage resulting therefrom always entitle the injured party to relief; provided, of course, that he comes 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, to protect the trade-mark, and the interests of the public as well as of the individual purchasers require that it should 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 1845, in *Coats* v. *Holbrook*,[1] 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 1844, in *Taylor* v. *Carpenter*,[2] was no less emphatic; and Sandford, Ch., in 1825, in *Snowden* v. *Noah*,[3] 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.

[1] 2 Sandf. Ch. R. 586; 3 N. Y. Leg. Obs. 404; R. Cox, 20.
[2] 3 Story, 458; R. Cox, 14.
[3] Hopkins Ch. R. 347; R. Cox, 1.

§ 37. In the case of *Dixon Crucible Co.* v. *Guggenheim*,[1] Paxson, J., in 1870, 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."

§ 38. In *Comstock* v. *White*,[2] in 1860, 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*,[3] in 1857, 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.*,[4] 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 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.

[1] 7 Phila. 408; 2 Brewst. 321; 8 Am. T. 288; R. Cox, 559.

[2] 18 How. Pr. R. 421; R. Cox, 232.

[3] 4 Abb. Pr. R. 156; R. Cox, 194.

[4] 57 Barb. 526; 4 Am. L. T. R. 168; 45 N. Y. 291; 10 Abb. Pr. R. (N. S.) 348; 6 Am. Rep. 82; R. Cox, 624.

§ 40. An able French writer [1] 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 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,[2] 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

[1] 4 Annales, 19, 20.

[2] The Leather Cloth Co. *v.* The American Leather Cloth Co., 11 Jur. (N. S.) 513; 11 H. L. Cas. 528.

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 injustice that is in direct transgression of that command of the Decalogue: "Thou shalt not covet . . . anything that is thy neighbor's." The most detestable kind of fraud underlies the filching of another's good name in connection with trafficking. The injury is not merely to the individuals who are cheated in buying, nor to the owner of the mark, but to commerce in general. Public faith is shaken. The wrong can be checked only by systematic protection. Modern nations have acted wisely in studying the ways of China in this matter. 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. Everything 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 every one recognized its 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. — 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: "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."[1] He might have further said, that the wrong nearly always is a witness against its author.

§ 43. *Unfair Competition in Business.* — In examining cases classified in digests and books of reports as those of trade-marks, the reader is sometimes puzzled. In the absence of the slightest evidence that technical trade-marks have been infringed, courts of equity have granted full and complete redress for an improper use of labels, wrappers, bill-heads, signs, or other things that are essentially *publici juris.* The difficulty is, that wrong names are used. French-speaking nations have a standard name for this kind of wrong. The term used is *concurrence déloyale.* This term may fairly be Anglicized as a dishonest, treacherous, perfidious rivalry in trade. In the German Imperial Court of Colmar, in 1873,[2] the court said that current jurisprudence understands by *concurrence déloyale* all manœuvres that cause prejudice to the name of a property, to the renown of a merchandise, or in lessening the custom due to rivals in business. The euphemism employed as a head to this section will answer the present purpose. It implies a fraudulent intention, while on the contrary an enjoinable infringement of a technical trade-mark may be the result of accident, or misunderstanding, without actual fraud being an element.[3] At law, special damage, unless damage is necessarily presumed, deceit, or fraudulent intent, must be proved in all cases to warrant a recovery. This is not always so in equity;[4] but it is common both in law and equity where the infringement is perpetrated by other modes and means

[1] Taylor *v.* Carpenter, 11 Paige, 292; 2 Sandf. Ch. 603.
[2] Say *v.* Duringer, 18 Annales, 148.
[3] See Chapter XII., for examples.
[4] Leather Cloth Co. case, referred to in various sections.

than the use of any part of a trade-mark itself;[1] and whether a trade-mark is shown to have been imitated or not, if the goods of one have been intentionally and fraudulently sold as the goods of another, and the latter has sustained damage, or the former threatens to continue acts tending to that end, a court of equity will restrain the further commission of them. This subject belongs properly to the class of good-will cases; but, nevertheless, it is necessarily an ingredient in a great majority of trade-mark cases. As an illustration, take *Croft* v. *Day*,[2] in 1843, which is not a technical trade-mark case. In that, Lord Langdale, M. R., granted an injunction to restrain the defendant from using labels or show-cards calculated to mislead the public, saying that the right which any person may have to the protection of the court does not depend upon any exclusive right to a particular name of a man, or to a particular form of words. His right, said he, is to be protected against fraud, and fraud may be practised by means of a name, though the person using it have a perfect right to use that name, provided he do not accompany the use of it with other circumstances to effect fraud. — The Supreme Court of the United States has embodied what is now a well-established doctrine, in the following language:[3] "Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that the court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist." — The broad rule was laid down by Lord Langdale, M. R., in *Perry* v. *Truefitt*, in 1842,[4] when he said that one cannot be permitted to practise deception in the sale of his goods as those of another, "nor to use the means which contribute to that end." — The Court of Appeals of Kentucky, in 1883,[5] in a case that furnished an excellent illustration, main-

[1] B. F. Avery & Sons *v.* Thomas Meikle & Co., Kent L. Rep. and Journ., April, 1883, 17 Western Jurist, 292, wherein Ch. J. Hargis has ably discussed this point.

[2] 7 Beav. 84.

[3] McLean *v.* Fleming, 96 U. S. 245; 18 Off. Gaz. 913.

[4] 6 Beav. 66; 1 L. T. 384.

[5] Avery case, *supra*.

tained the doctrine, that all fraudulent misrepresentations, "whether oral, by signs, symbols, trade-marks, labels, words, or figures," should be prevented by a court of equity. Chief Justice Hargis, in delivering the opinion of the court, spoke as follows: "The fraud is most frequently accomplished by the illegal use of names, forms, words, and numerals, which ordinarily belong to the common stock, and are not the subject of exclusive appropriation. Instead of employing them in their proper sphere to designate number, size, elements, quality, description, or give direction or caution, they are selected because of the known innocent purposes they generally serve, and combined so as not to represent quality, or other particles within the scope of their lawfully prescribed functions, but to cause the goods or articles to which they are attached to be purchased by the public as the make or manufacture of another, thus violating that great generic rule which lies at the foundation of all law, that a man must so use his own property as not to injure the property of another. . . . The law says you may use anything which is the common property of all, or that cannot be exclusively appropriated, but you must use it to convey the ideas which it commonly expresses, and of which it is the accepted sign. You must use it to tell the truth, the whole truth, and nothing but the truth. You cannot, under pretence of exercising a common right of use, . . . by the seeming fairness which follows the selection of a legal or innocent instrument or means, escape the consequences of an illegal use thereof. This would be stealing the livery of heaven to serve the devil in. This would be perverting the privileges and uses of our language, under the pretence of describing one's own, to take another's from him. . . . The appellees selected the same letters, the same words, the same numerals, and put them in the same colors, and upon the same places on their ploughs, as was used by appellants on their ploughs. For what? To represent size and quality alone? Who could believe it? Why not take type from a different font? Why not take other numerals that would serve the same purpose better? Why adopt as a number '½,' '1,' '2,' '3,' '8'? Why 'AO,' 'BO,' 'CO,'

'PO'? No answer can be given, except that a man intends the natural consequences of his own act, and the consequences of this act are to take appellants' trade, built up on their reputation, and transfer it to appellees, by using that reputation to sell appellees' ploughs. The appellees have not used a single letter, figure, or word that belongs to appellants' trade-mark proper, yet by the exact simulation of the plough in every perceivable point exposed to an ordinary observer and purchaser, and the use of the same coloring and staining, the same relative position of the letters and figures as employed and used by the appellants, avoiding the literal appropriation of any part of their trade-mark, the appellees have obscured their own and appellants' trade-mark, but at the same time sought to avoid detection and responsibility in doing so. . . . Thus by skilful combination of legal particles, taken one at a time and in the aggregate, leaving the mere trade-mark untouched, they have so confused its force and effect as to destroy its office and real efficiency to distinguish the appellants' ploughs from others."— In *Sawyer* v. *Horn*, in 1880,[1] the court said: "What we decide is, that whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labelled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color, and label, no person has the right to use the complainant's form of package, color, or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant."— The foregoing cases illustrate the principle on which courts of equity generally act.

§ 44. A *seemingly* exceptional case is found in a decision of the New York Court of Appeals, in 1882; but a careful examination shows that it is not so.[2] That decision was one of *fact*, and not of *law*. It is true that the learned judge who delivered the opinion of the court used this extraordinary language: "Where there is a simulation of a trade-mark, and the intent

[1] 4 Hughes, 439 (U. S. Circuit Court, Dist. of Maryland).

[2] Enoch Morgan's Sons *v.* Troxell *et al.*, 89 N. Y. 292 (reversing 23 Hun, 632).

becomes a subject of inquiry, the form, color, and general appearance of the packages may be material; but to sustain an action[1] there must be an imitation of something that can legally be appropriated as a trade-mark." On looking into the record, it clearly appears that the matter was properly one of "unfair competition in business," and not a trade-mark case. In the court of last resort, the judges, as well as the counsel on each side, treated it as a trade-mark case. So does the syllabus. If it had really been such, then the language above quoted might demand criticism. But the opinion starts out with the postulate that there was no imitation of any trade-mark. It says that there was no fraudulent representation, and no device to palm off goods as those of appellees; and that there was too great a dissimilarity between the labels, etc. of the parties to sustain the judgment below. The decision properly ends there. The sentence that intimates that no action can be sustained unless a technical trade-mark shall have been infringed, has no force, and may be regarded as surplusage. In all probability, the judge could not have meant it to apply to any other than an alleged infringement of an arbitrary symbol. If possibly he were thinking of *unfair competition*, it does not apply thereto; for it had already been declared that no element of unfairness appeared.

§ 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 both. The subject matter is not the symbol, but the exclusive privilege of continually using the same to impress or other-

[1] It must be rememembered that, under the New York Code, the term "action" is as applicable to a suit in equity, as this case was, as to a common-law action on the case.

wise 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 mark one's name on a piece of personal property is a natural right; so, therefore, must be the right to use, as its substitute, any other emblem. This right is founded upon possession: and 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 controlled 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, i. e. his 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 in any other kind of personal property, may be admitted; but possibly foreign courts are shut to him as an alien, non-domiciliated. In this illiberal spirit, some

[1] 29 Cal. 292; R. Cox, 324.

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 benefits of the actions which it organizes. The same court, the next year, recognized the same doctrine, in *Stubs* v. *Astier et al.*; 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 only.[2]

§ 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 the purpose of enabling the proprietor to sue for damages for infringement; and that it was necessary to search whether the mark in controvesy did not exist at a period anterior to that of deposit.[4] 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*,[5] 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.*[6]), 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 pro-

[1] 11 Annales, 344.
[2] 10 Annales, 212.
[3] 10 Annales, 193.
[4] By the term "deposit," used in the French cases, is meant a filing for registration. A right may exist to a trade-mark, but in nearly all European countries this right cannot be enforced without previous registration; and a right to registration depends on treatics of reciprocity.
[5] 13 Annales, 21.
[6] 14 Annales, 107.

ducts 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 three hundred 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 permitted to conflict with one that had 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 proved 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. 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, he argued, Lendenberg & Co. had a right to invoke the protection of the French laws, the same as if they were French themselves; and that, by the law of 1857, 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*

[1] 6 Annales, 29.

[2] 1 Annales, 45.

v. *Bassett*,[1] the right of the plaintiff was disputed because of his recent appropriation of the symbol to stamp his licorice, 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 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 facts of such user, notoriety, and public reputation have been proved. 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

[1] 4 De G., J. & S. 380; 33 L. J. Ch. 566; 10 Jur. (N. S.) 550; 10 L. T. (N. S.) 442; 12 W. R. 777; 4 N. R. 123.

trade-mark, for the law inhibits him from engaging in secular pursuits of a mercantile nature. A corporation is an artificial person, and under the former 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.[1] 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. — This matter has recently been discussed in several European judicial tribunals, especially in suits brought by the Carthusians[2] for the protection of trade-mark rights. In the Tribunal Correctionnel of the Seine, in 1879,[3] the defendant raised the point that the prosecutor, being a religious corporation, could not own a trade-mark. *Held*, that the members of a religious community (although the same is not recognized by law, nor authorized) enjoy individually civil rights in France, and may maintain personal actions to repress trespassing on their rights. — In the Court of Brussels, in 1883,[4] it was held, that, in Belgium, religious corporations or orders are regarded as mere aggregations of individuals enjoying *ut singuli* all civil rights. Monastic vows are no bar to personally acquiring and possessing in their own proper names titles to trade-marks. They are presumed to act in their individual capacity. The Court of Appeal of Brussels affirmed the decision. It was there objected that Grézier

[1] The registration act now in operation — that of March 3, 1881 — recognizes the right of a corporation, the same as of any other *owner*.

[2] "A religious order instituted by St. Bruno in 1086, and named from La Chartreuse, near Grenoble, Vienne, whither the saint retired with six companions to spend a life of pious solitude and austere severity. . . . The C. have still two of the finest convents in the world, viz. *La Grande Chartreuse*, on the site of their original home in the desolate valley near Grenoble, and *Certosa*, near Pavia." — The Globe Encyclopædia.

[3] Grézier *v.* Detang *et al.*, 24 Annales, 313.

[4] Grézier *v.* Caumontal, 29 Annales, 183.

sued as agent of the convent of the *Grande Chartreuse*, but the court said that that title belonged to him hierarchically in the convent life, and that France and Belgium had placed all religious bodies under the protection of the common law.

§ 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. *Title to a Trade-Mark by Assignment.* — The right to the exclusive use of a symbol as a trade-mark being property, as property, it is susceptible of being assigned, with certain exceptions which hereinafter appear; and an assignee has the good-will of the trade, and stands in the same relation to a defendant as would the original appropriator of the symbol.[1] If the assignor imposes no limitation of place or time, the right to use is deemed co-extensive with the whole country.[2] As the Supreme Court of Pennsylvania said, in 1867, assignees are entitled to relief, even though in the use of a trade-mark they have not designated themselves as assignees, or that they were not the original owners of it. A trade-mark, like the good-will of a shop or manufacturing establishment, is a subject of commerce, and it has many times been held to be entitled to protection at a suit of the vendees;[3] and the title to it may pass under a creditors' deed to trustees for the creditors of the firm owning it.[4] The sale of a business is a sale of the good-will; but it is not necessary that the term "good-will" be specifically mentioned. In such sale, the title to trade-marks passes, whether they be specifically mentioned or not.[5] The Supreme Court of the United States said that, when the trade-mark is affixed to articles manufactured at a particular establishment, and acquires a specific reputation in

[1] Walton *v.* Crowley, 3 Blatch. 440; R. Cox, 160.

[2] Kidd *v.* Johnson, 100 U. S. 617. [3] Fulton *v.* Sellers, 4 Brewst. 42.

[4] Bury *v.* Bedford, 4 De G., J. & S. 352; 33 L. J. Ch. 405; 10 Jur. (N. S.) 503; 10 L. T. (N. S.) 470; 12 W. R. 720; 4 N. R. 180; Hudson *v.* Osborne, 39 L. J. Ch. 79; 21 L. T. (N. S.) 386; Helmbold *v.* The Henry T. Helmbold Manufacturing Co., 53 How. Pr. 453; Ex parte Young, and Re Lemon Hart & Son, Cox's Manual, case 537.

[5] Shipwright *v.* Clements, 19 W. R. 599.

connection with the place of manufacture, and that establishment is transferred to others, either by contract or operation of law, the right to the use of the trade-mark may be lawfully transferred with it.[1] The title may pass by an assignment in bankruptcy,[2] or to the assignee in insolvency of the owner.[3] It has been held to be settled law, that the right of user in a trade-mark is not a mere personal privilege, but within certain limits may be transferred as other property. But there are exceptions to the susceptibility of emblems used as trade-marks being transferred to others as such. The court said, as to a trade-mark consisting of a man's name, that it is a difficult question to decide how far it is capable of assignment. "We think the answer to this question depends upon the effect which the use of the name, in each particular instance, is shown to have upon the minds of the public. If it leads the public to believe the particular goods are in fact made by the person whose name is thus stamped upon them, whereas they are in fact made by another person, then such a use of the name will not be protected by the courts, for to do so would be to protect the perpetration of a fraud upon the people."[4] By reference to another case,[5] it is seen that the court said: "By the dissolution of the firm, and Oakes's sale to Probasco, the latter acquired the rights of the firm to the name. Oakes could so sell his name as to deprive himself of the right to use it for his own manufacture, and give the right to another." The matter was again judicially considered in a United States Circuit Court,[6] in which it was said by Bruce, J.: "If there was anything in the nature of the business of candy-making, any art or incommunicable secret known only to the man Oakes, it might be said that he [the assignee] did not carry on the same business, and manufacture the same goods, as did the firm of Probasco & Oakes." — In such supposed case, there could not have been a valid assignment. The right to manufacture or sell the

[1] Kidd *v.* Johnson, *supra.*

[2] Ex parte Young, *supra.*

[3] Warren *v.* Warren Thread Co., 134 Mass. 247.

[4] Skinner & Co. *v.* Oakes *et al.*, 10 Mo. App. 45.

[5] Probasco *v.* Bouyon *et al.*, 1 Mo. App. 241.

[6] Oakes *v.* Tonsmierre, 4 Woods, 555 (June term, 1883).

merchandise to which the trade-mark is attached is essential to property therein;[1] for the right cannot be so enjoyed by an assignee that he shall have the right to affix the mark to the goods different in character or species from the article to which it was originally attached.[2] In some of the cases, said the Supreme Court of Rhode Island, in 1876, the question has been between partners, or there has been a sale of a business, to be continued by a vendee, and more or less connected with a place and the good-will of the business, in many of which cases the sale of a trade-mark would be upheld. But where the reputation of the goods and of the name has grown out of excellence of manufacture depending on the honesty and skill of the maker, it is more difficult to hold that it can be sold to a stranger, or that it is generally assignable.[3] As to partners it has been held that the title to a trade-mark does not pass to any member of the firm by mere implication, but each member may use it in a manner not to deceive the public.[4]

§ 58. *Who is an Infringer?* — He who uses on merchandise the peculiar mark to which another has the right of exclusive use for substantially the same class of goods; or, under some circumstances, he who has falsely fabricated such mark, although he has not actually affixed it to goods. A false fabrication of the symbol, as an instrument of fraud, is constructively an infringement.[5] One may be an infringer, although he took no part in imitating or affixing the simulated mark. The

[1] The Congress and Empire Spring Co. case, 45 N. Y. 291; 10 Abb. Pr. (N. S.) 348; 6 Am. R. 82; 4 Am. L. T. 168; R. Cox, 624.

[2] Filkins *v.* Blackman, 13 Blatchf. 440.

[3] Carmichel *v.* Latimer, 11 R. I. 395; 23 Am. Rep. 481; 16 Alb. L. J. 73.

[4] Young *v.* Jones Bros. & Co., 3 Hughes, 274. (See §§ 522 *et seq.*, on Good-Will.)

[5] The act of Congress of August 14, 1876, punishes with fine and imprisonment any person or persons who shall, with intent to defraud, "knowingly and wilfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, or offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mould, of any private label, brand, stamp, wrapper, engraving on paper, or other substance, or trade-mark," etc. See Appendix.

fact of selling, or offering for sale, goods falsely marked, is sufficient to charge him, and any semblance is deemed an infringement if calculated to mislead ignorant or careless purchasers. The infringer may be either the pirate himself, or an innocent vendor of the falsely marked goods. It matters not how many hands they may have passed through. Courts will arrest the wrong at any stage of its journey. A counterfeit is not valid even in the possession of one quite ignorant of its vicious character, although he may plead his good faith. The New York Court of Appeals said,[1] where the defendant, who was a label-printer, sold labels bearing an imitation, that it was not necessary to establish a guilty knowledge or fraudulent intent on the part of the wrong-doer. It is sufficient that the proprietary right of the party and its actual infringement are shown. In England, in 1847, Shadwell, V. C., enjoined certain engravers from making or disposing of labels or plates in imitation of those from which the plaintiff's labels were printed;[2] and, in 1852, Parker, V. C., enjoined a printer, under similar circumstances, he giving up all the false labels and paying £50 costs.[3] Wood, V. C., held that the plaintiff was entitled to an injunction to restrain the defendant, a printer, from "scattering over the world the means of enabling parties to commit frauds upon the plaintiff."[4] — The courts of France have frequently had occasion to consider this point. The Court of Bordeaux, in 1871,[5] held a lithographer liable for imitating labels, as well as the owners' rival, who had given the order to do the work. The Tribunal Correctionnel of the Seine, in 1875,[6] held a printer to be guilty, who executed imitations at the command of a third person, when he might have ascertained who was the true

[1] Colman *v.* Crump, 70 N. Y. (25 Sickels) 573; 16 Alb. L. J. 352; Cox's Manual, case 570.

[2] Guinness *v.* Ullmer, 10 L. T. 127; Cox's Manual, case 89.

[3] Farina *v.* Shaw, cited 3 Eq. R. 886, 887; 1 K. & J. 514; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532.

[4] Farina *v.* Silverlock, 1 K. & J. 509; 3 Eq. R. 883; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532.

[5] Martell & Co. *v.* Martell *et al.*, 18 Annales, 263.

[6] Blancard *v.* Gutton *et al.*, 20 Annales, 86.

owner. The same court, in the same year,[1] convicted a lithographer under the following circumstances. At the order of others he had made two thousand labels bearing the words "Liqueur Grande Chartreuse," a well-known trade-mark. It was held that he could not plead ignorance of the fact that he was dealing with counterfeiters; and that he was guilty, although he had not delivered the false labels, for the non-delivery was owing to a circumstance foreign to himself.[2] — The Court of Paris, in 1878,[3] held that engravers or founders who execute, on order, moulds or matrices intended to reproduce the essential and characteristic parts of a trade-mark, cannot be permitted to plead good faith. In the Court of Lyons, in 1879,[4] a lithographer, having counterfeited on stones the plaintiff's trade-mark, the *plaintiff*, through an intermediary, ordered a number of the false labels printed therefrom. The Tribunal Civil of Lyons had dismissed the plaintiff's case on that ground. *Held*, on appeal, that no law or principle of law prohibits an owner from obtaining, by such means, proof of wrong-doing. The Court of Paris, in 1883,[5] held that such an imitator will in vain pretend that he does not deceive purchasers when he vends *not to the public directly*, but to merchants or agents, who buy at their own risk and peril. It suffices that he knows that the products that bear the false marks are destined for the public at large. In his mind, as in contemplation of law, they are the true recipients of the falsified marks. Nor can one shield himself from even a criminal prosecution by the plea that he is a mere agent or consignee. So the highest judicial tribunal in France — the Court of Cassation — held, in 1882.[6] The defendant was, at Paris, the sole agent of his princi-

[1] Grézier *v.* Jouhate, 20 Annales, 92.

[2] In this case, M. Pataille, for the prosecution, cited two cases in the Court of Paris, in 1866 and 1868, where it had been adjudged that the sole fact of fabrication, even in the absence of delivery, is sufficient evidence against a lithographer to warrant condemnation of spurious labels.

[3] Michaud *et al. v.* Lemenu *et al.*, 23 Annales, 59.

[4] Portallier *v.* Balay, 25 Annales, 384.

[5] Blancard & Co. *v.* Faucher, 38 Annales, 288.

[6] Hayem *v.* Brisac, 27 Annales, 114.

pals in Berlin. He solicited orders in Paris, and his principals sent to him goods with the simulated marks of the plaintiff upon them. It appeared in evidence that the plaintiff had a prosperous trade with foreign countries, especially Brazil. The attempt was to divert that trade by sending abroad falsely marked goods. He was therefore held to have been properly convicted.

§ 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 modern genius. 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 exclusively to 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, paints, 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 will 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 steal the fruits of intellectual skill. *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 those of 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 Comyns'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." Comyns does not say *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 be 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." 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,[3] — "Vigilantibus, non dormientibus leges subveniunt," — is not

[1] Cited by Upton, p. 10.

[2] Popham, 144; Cro. Jac. 471; 2 Rolle, 28; R. Cox, 633.

[3] 11 Jur. (N. S.) p. 513; 11 H. L. C. 523; 35 L. J. Ch. 53; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209.

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; and 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 desert? In trade-mark 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

[1] See opinion of Kindersley, V. C., in Glenny *v.* Smith, 11 Jur. (N. S.) 964; 13 L. T. (N. S.) 11; 13 W. R. 1032; 6 N. R. 363.

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 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

[1] Taylor *v.* Carpenter, 2 Wood. & M. 1.
[2] 7 Bos. 222.
[3] Taylor *v.* Carpenter, N. Y. Ct. of Errors, 11 Paige, 292.

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.[1]

§ 66. *Class of Goods.* — Protection will not be given unless in connection with the class of goods to which the mark has been appropriated. It is sometimes difficult to define the term *class*, as the mark may have been affixed to but a small portion of a class, in which case, as a general rule, only that small portion can be protected. But there are instances where courts stretch the rule to cover obvious infringements, and expand a species into a genus. Lord Chancellor Westbury said, in 1863:[2] "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract; thus, an iron-founder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed in cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity, and such exclusive right is property." Vice-Chancellor Wood, in 1866,[3] used the same ideas, saying that one has no property in the mark *per se*, any more than in any other fanciful denomination assumed for his private use, otherwise than with 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 caused his goods to circulate with this mark upon them, no one is at liberty to defraud that man by using that mark. — Lord Chancellor Westbury held that property in a word (*Anatolia*) cannot exist;[4] but when applied by way of stamp upon a

[1] Christy *v.* Murphy, 12 How. Pr. R. 77.

[2] Hall *v.* Barrows, 4 De G., J. & S. 150; 33 L. J. Ch. 204; 10 Jur. (N. S.) 55; 9 L. T. (N. S.) 561; 12 W. R. 822; 3 N. R. 259.

[3] Ainsworth *v.* Walmesley, L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. (N. S.) 205; 14 L. T. (N. S.) 220; 14 W. R. 363.

[4] McAndrew *v.* Bassett, 4 De G., J. & S. 380; 33 L. J. Ch. 566; 10 Jur. (N. S.) 550; 10 L. T. (N. S.) 442; 12 W. R. 777; 4 N. R. 123.

particular vendible article, as a stick of licorice, it does exist the moment the article goes into the market so stamped, and there obtains acceptance and reputation, whereby the stamps get currency from superior quality of goods or other circumstance. — Where registration is relied on to establish ownership of a trade-mark, care must be taken that the description of class be not too broad. It has been twice held that, while a registration for the class of *paints* might be sufficiently specific without further description of the particular goods, a prior use by the defendant of the device on *white-lead* defeated the registration, which, being bad in respect to part of the class that it purported to cover, was bad altogether.[1] — The Patent Office has permitted the term "alcoholic spirits" to include bourbon, wheat, and rye whiskeys, wines, brandies, and gins, but excluded the term "bitters," as not being properly included within the class.[2] — Federal Courts have made very nice distinctions in regard to the matter of class of goods. Thus, where the complainants, holding American patents of a class of prints known as "heliotypes," had registered the word "Heliotype," as a trade-mark affixed to them, and the defendant used the same word, or "Heilotype," on prints not produced by the patented process, it was held that the goods of the parties were not substantially the same.[3] So, where, the complainant being manufacturer of the dry white oxide of zinc, the defendant sold white oxide of zinc ground in oil, under the same symbol used as a trade-mark, it was held that the articles were different.[4] But a defendant vainly sought to make a distinction in his favor in the case of the arbitrary symbol "Lone Jack," under which a certain smoking-tobacco long since obtained a high reputation. That tobacco had been put up in bales of a pound each, or halves or quarters. The defendant had adopted a label for cigarettes, which label was entirely unlike that of the complainant, with the exception

[1] Smith *v.* Reynolds, 10 Blatch. 100; 3 Off. Gaz. 214; 13 Blatch. 458.

[2] Re Boehm & Co., 8 Off. Gaz. 319.

[3] Osgood *v.* Rockwood, 11 Blatch. 310.

[4] Société Anonyme des Mines et Fonderies de Zinc de la Vieille Montagne *v.* Baxter, 14 Off. Gaz. 679.

of that word-symbol, and he had registered in the Patent Office his *Lone Jack cigarette-label.* The examiner had assented to the proposition that smoking-tobacco, and cigarettes made of long-cut tobacco, were art'cles of different classes. That was the defence, on application for an injunction, supported by over fifty witnesses in the tobacco trade. The internal revenue classification was also invoked, to the same end. The case was elaborately and ingeniously argued by counsel for the defendant. The writer and other counsel for the complainant argued substantially thus. The complainant manufactures and sells "Lone Jack" smoking-tobacco. The bags containing the granulated article may be ripped, and some of the article poured out. It may be put into a meerschaum pipe, a common clay pipe, or a corn-cob pipe; or, for lack of any pipe, it may be poured into little pieces of thin paper, and rolled up, in the form known as cigarettes. The tobacco may have been granulated, or, as in the case of the defendant's goods, it may have been cut into long fibres. That does not affect the essential quality of the tobacco. What should a consumer of the complainant's article, in either shape, answer to the question, What are you smoking? He must truthfully say, "Lone Jack," meaning this particular kind of carefully selected and peculiarly cured tobacco that had acquired a world-wide reputation. Why had the defendant adopted that peculiar word-symbol? Was it not that he might thereby usurp the complainant's trade? Butler, J. (after consulting with his associate, McKennon, J.) dissolved the defence in smoke, thus: "While the revenue laws, for purposes of taxation, distinguish between smoking-tobacco and cigarettes, there is, we believe, no substantial difference. Cigarettes consist of smoking-tobacco similar in all material respects to that used in pipes. The circumstance that a longer 'cut' than that commonly used in pipes is most convenient for cigarettes is not important; nor that the tobacco is smoked in paper instead of pipes. It may all be used for either purpose, and is all embraced in the term smoking-tobacco." [1] But where the fancy term "Iron-clad" is affixed as a trade-mark to *India-rubber*

[1] Carroll *v.* Ertheiler, 1 Fed. R. 688.

boots, it is no infringement for another to use the same term as a trade-mark for *leather* boots, for the reason that they belong to distinct classes.[1]

§ 67. *The term "Class"* will not be so strictly limited as to defeat substantial justice. While it is true that the first adopter of a trade-mark acquires an exclusive right only in a specific class, protection may possibly be granted, although in fact his mark may not have been affixed to every article in that class. *Boni judicis est ampliare jurisdictionem*, is a maxim that is well illustrated by a case in 1882.[2] The facts are as follows, from the opinion. The complainant, a corporation, had the right to make all articles of metal. It was the successor of "Collins & Co.," and always stamped that name upon its productions as a trade-mark. In 1856, the firm of Oliver Ames & Sons began to put the stamp and label "Collins & Co." on shovels made by it and sent to Australia. The complainant had not up to that time made shovels, but it had a market in Australia for the articles it made, and stamped "Collins & Co." The object of Oliver Ames & Sons in putting that stamp on the shovels was to avail themselves of the credit and reputation and market which the complainant had established for itself for articles thus stamped. The complainant, at the time of bringing this suit, had not sent nor sold any shovels to Australia. The defendant, successor to Oliver Ames and Sons, continued to do what the latter so began in 1856. *Held*, by Blatchford, J., that the acts of Oliver Ames & Sons and of the defendant were always unlawful. The complainant having, from 1843, the right to make any article of iron, steel, or other metal, and having gone on from that time, both before and after 1856, extending its manufacture beyond edge-tools into digging-tools, such as picks and hoes, and having put the mark "Collins & Co." on its best quality of articles, the fact that it did not before 1856 make a digging-tool, such as the shovels on which Ames & Sons put the mark "Collins & Co.," does not warrant the conclusion that that mark was not in 1856 the mark of the complainant's

[1] Hecht *v.* Porter, 9 Pacific Coast L. J. 569.

[2] The Collins Company *v.* Oliver Ames & Sons' Corporation, 20 Blatch. 542.

trade in respect to such shovels. This decision of the learned judge must commend itself as an act of equitable justice. The only question to be raised is this: Is it, strictly speaking, a trade-mark case? Tested by the severe technical rules that a symbol cannot be a trade-mark unless actually affixed to a vendible article, it may be thought not. But whether so or not, it needs no defence. If not strictly a case of trade-mark infringement, the facts furnish all the essential ingredients of a case of unfair competition in business. — On the same point may be cited a case in a State court, in 1869.[1] The complainants, being *manufacturers* but not *printers* of cotton cloths, had placed the name "Amoskeag" on their cloths; and the defendants, who were printers but not manufacturers of cotton cloths, had placed the same name on their printed cloths. An injunction had been granted; but it was dissolved, on the ground that the trades of the parties were different, and therefore the goods not of the same class. In 1876, this decision was reversed,[2] the reasoning of Barrett, J., in delivering the opinion of the court, being the same in principle as that of the later case above cited. His hypothesis was this. Suppose that the complainant had received from the legislature the name of "The Amoskeag Baking Company," and had manufactured almost every variety of bread, roll, muffin, cracker, biscuit, cake, and pie, on which articles of food it had invariably stamped its corporate name, or some abbreviation thereof, but had omitted, or had not yet decided, to make and vend the single variety known as the "crumpet"; and thereupon a rival baker attempts to sell his crumpets as "Amoskeag crumpets," would not any customer, upon seeing the name thus applied, naturally say that the Amoskeag Baking Company had added crumpets to its other varieties of bread? And would not the rival bakery be restrained upon the plain principle of an unauthorized use of the company's name? The parallel is not precise, as the printing of calicoes may require some additional machinery. "But the difference,"

[1] The Amoskeag Co. *v.* Garner, 56 Barb. 151; 6 Abb. Pr. (N. S.) 265; R. Cox, 541.

[2] 4 Am. L. T. (N. S.) 176.

said he, "is only in degree." The remarks made in regard to the preceding case are quite applicable to this. Both are cases of unfair competition in business, and not strictly those of trade-marks.

§ 68. As the first adopter of a mark does not acquire an 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 emblem, or fancy name, to be placed on articles of different classes by different owners. Thus, the fanciful appellation "BISMARCK" may, in compliment to the statesman, be used for cement,[1] notwithstanding the fact that another had previously appropriated it for paper collars.[2] "STAR" may be used for iron,[3] shirts,[4] lead pencils,[5] oil,[6] or soap[7]; "EUREKA," for a fertilizer,[8] or shirts[9]; "CENTENNIAL," for clothing,[10] or alcoholic spirits[11]; "ST. JAMES," for a newspaper,[12] or cigarettes.[13] As has been shown, general classes may be divided; and the name "IRON-CLAD," used on India-rubber boots, is held not to preclude its use on leather boots;[14] and "MAGNOLIA" may properly serve to indicate a certain manufacture of gin for one proprietor,[15] and a certain brand of whiskey for another.[16]

§ 69. The importance of a specific mention of the class of merchandise to which a certain emblem is to be attached as

[1] Re Wendt & Rammelsberg, U. S. Registration, No. 585.

[2] Messerole *v.* Tynberg, 4 Abb. Pr. (N. S.) 410; 36 How. Pr. 14; R. Cox, 479.

[3] Dixon *v.* Jackson, 2 Scot. L. Rep. 188.

[4] Morrison *v.* Case, 9 Blatch. 548; 2 Off. Gaz. 544.

[5] Faber *v.* Hovey, Codd. Dig. 79, 249.

[6] Re The American Lubricating Oil Co., 9 Off. Gaz. 687.

[7] Re Cornwall, 12 Off. Gaz. 138.

[8] The Alleghany Fertilizer Co. *v.* Woodside, 1 Hughes, 115.

[9] Ford *v.* Foster, L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

[10] Sternberger *v.* Thalheimer, 3 Off. Gaz. 120.

[11] Re Bush & Co., 10 Off. Gaz. 164.

[12] Gibblett *v.* Read, 9 Mod. 459; Ex parte Foss, and Re Baldwin, 2 De G. & J. 230; 27 L. J. Bankruptcy, 17; 4 Jur. (N. S.) 522; 31 L. T. 30.

[13] Kinney *v.* Basch, 16 Am. L. Reg. (N. S.) 596.

[14] *Ante*, § 66.

[15] Re C. & W. A. Waters, U. S. Registration, No. 544.

[16] Re Mills, Johnson, & Co., U. S. Registration, No. 241; Kidd & Co. *v.* Mills, Johnson, & Co., 5 Off. Gaz. 387; Kidd *v.* Johnson, 100 U. S. 617.

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] 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.

§ 70. An American firm, doing business at Evansville, Indiana, 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 world-wide reputation through the English firm of Wostenholm. *Held*, that chopping-axes are not included in the particular class of goods in which the Wostenholms used the mark. Registration allowed.[2] 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.[3] In March, 1872, a manufacturing company in Hartford, Connecticut, filed an application for a mark, newly

[1] First section of registration act of 1881.
[2] Re Boetticher, Kellogg, & Co., U. S. Registration, No. 83.
[3] Re Wostenholm & Son, U. S. Registration, No. 666.

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 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.[2] But these general propositions must be carefully considered in the light of judicial reasoning, lest by misunderstanding we commit a wrong, in hastily concluding a trade-mark to be devoid of truth, and an instrument of fraud, when the reverse is the case. We will first examine cases that illustrate the affirmative of the propositions. Mellish, L. J., in *Ford* v. *Foster*,[3] said: "According to the rule, *Ex turpi causa non oritur actio*, if a trade-mark contain a false representation, a representation calculated to mislead the public, a man cannot, by using that which is itself a fraud, obtain an exclusive right, or indeed any right at all." Of the correctness of this doctrine there can be no doubt, involving as it does the matter of misleading by fraud on others. Purchasers have a right to the very thing paid for, no matter what may be its comparative value. Therefore, where a perfume is wrongfully named "Night-Blooming Cereus,"[4] the name is a misrepresentation that debars the claimant of a right to any protection; so, when one sells an unpatented article as "patent pins,"[5] or sells oysters under the title of "Anglo-Portugo,"[6] when they did not come from Portugal, although none the less good for that reason; and even where a complainant had, in his advertisements, made a

[1] Re Greenwoods Scythe Co., U. S. Registration, No. 788.

[2] See §§ 430–439, as to the fraudulent use of one's own name.

[3] L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

[4] Phalon v. Wright, 5 Phila. 464; R. Cox, 307.

[5] Morgan v. McAdam, 35 L. J. Ch. 228; 15 L. T. (N. S.) 348.

[6] Re Saunion & Co., Cox's Manual, case 625.

number of false representations to the public with respect to the origin, composition, and value of the tea bearing his trade-mark, an injunction was refused until he had established his right at law; Vice-Chancellor Shadwell saying, "It is a clear rule, laid down by courts of equity, not to extend their protection to persons whose case is not founded in truth."[1] The rule applies when one has made misrepresentations in show-cards;[2] or made false statements as to the qualities and properties of his merchandise, as in selling a medicine misnamed "Balsam of Wild Cherry,"[3] or a toilet compound, the labels of which contained untrue statements and exaggerations,[4] or a cosmetic called "The Balm of Thousand Flowers," though the compound was not derived from flowers,[5] or "Laird's Bloom of Youth or Liquid Pearl," when the so-called article contained carbonate of lead or other noxious ingredients, although the manufacturers described it as being free from all mineral and poisonous substances;[6] or improperly represented their "Schnapps" as not merely a spirit, but also a medicinal preparation;[7] or sold a so-called "Hop Essence" for the purpose of enabling brewers to supply to the public a liquid which they might represent as being made with pure hops, which was not the truth;[8] or made false representations of the origin and value of the plasters, the word "Capcine" being shown to be quite unknown, and not to imply any such qualities as were described by the plaintiffs;[9] or falsely represented the place of manufacture, as where the manufacturer of a skin-powder which he called "Meen Fun" falsely represented his American compound to have been made in England, and patronized by the Queen;[10] or

[1] Pidding *v.* How, 8 Sim. 477; 6 L. J. Ch. (N. S.) 345.
[2] Perry *v.* Truefitt, 6 Beav. 66; 1 L. T. 384.
[3] Fowle *v.* Spear, 7 Penn. L. J. 176; R. Cox, 67.
[4] Heath *v.* Wright, 3 Wall. Jr.; R. Cox, 154.
[5] Fetridge *v.* Wells, 4 Abb. Pr. 144; 13 How. Pr. 385; R. Cox, 188.
[6] Laird *v.* Wilder, 2 Bush (Ken.) 131; 15 Am. R. 707.
[7] Wolfe *v.* Burke, 7 N. Y. Sup. Ct. 151; 56 N. Y. 115; 2 Off. Gaz. 441.
[8] Estcourt *v.* The Estcourt Hop Essence Co., 31 L. T. (N. S.) 567; L. R. 10 Ch. 276; 44 L. J. Ch. 223; 32 L. T. (N. S.) 80; 23 W. R. 313.
[9] Seabury *v.* Grosvenor, 53 How. Pr. 192; 14 Off. Gaz. 679.
[10] Hobbs *v.* Français, 19 How. Pr. 567; R. Cox, 287.

misrepresented his cigars as having been made in Havana;[1] or falsely denoted or indicated to the public, in the title of his merchandise, that the formula for his medicine was prepared in the East Indies;[2] or untruly represented the place of origin as well as the manufacturer;[3] or continued the use of the name of a predecessor after he had ceased to be connected with the business.[4] But it must be remembered that, in all the above cases, fraud was a predicate. — *Where no actual or constructive fraud is shown*, and no intention to harmfully mislead purchasers, manifested by the use of instrumentalities that would naturally tend to that result, *the rule does not apply*. The Supreme Court of Connecticut said, in the case of *Meriden Britannia Company* v. *Parker*,[5] that the deception need not be of such a character as to work a positive injury to purchasers, nor, on the other hand, can every erroneous impression which the public or a portion of the public may receive, be sufficient to destroy the validity of a trade-mark. — There are abundant illustrations of this principle. Thus, it has been held that the facts in the following cases did not disentitle the complainant to an injunction: an incorrect statement that a work was "By William Granger, Esq.";[6] the assumption of the title of "Professor," and some exaggerated commendations of medicines,[7] a statement on the title-page of a song, "Written by George Linley," he having written the words, though he did not compose the music, though Linley was better known as a composer than as a poet;[8] a representation that it was the six hundredth edition of the complainant's work, it being proved to be a custom to style every issue of two hundred and fifty copies a new edition, or by a state-

[1] Palmer *v.* Harris, 60 Penn. 156; 8 Am. L. Reg. (N. S.) 137; R. Cox, 523.

[2] Connell *v.* Reed, 11 Mass. 477; 85 Am. R. 399.

[3] Manhattan Medicine Co. *v.* Wood, 108 U. S. 218; Siegert *et al. v.* Abbott, 61 Md. 276.

[4] Partridge *v.* Menck, 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72; Helmbold *v.* The Henry T. Helmbold Manufacturing Co., 53 How. Pr. 453.

[5] 39 Conn. 450; 12 Am. R. 401; 13 Am. L. Reg. (N. S.) 153.

[6] Hogg *v.* Kirby, 8 Ves. 215. [7] Holloway *v.* Holloway, 13 Beav. 209.

[8] Chappell *v.* Sheard, 2 K. & J. 117; 1 Jur. (N. S.) 996; 3 W. R. 646; Chappell *v.* Davidson, 2 K. & J. 123; 8 De G., M. & G. 1.

ment that the work was specially revised by the author, the words being properly interpreted to mean that it was a specially revised edition, but not to distinguish it from all previous ones in this respect;[1] a representation by defendant that the name placed on plaintiff's thread was fictitious;[2] misrepresentation in selling, as quart and pint bottles, bottles that contained less, the deficiency amounting to about $\frac{7}{30}$, there being no evidence that any one had been or was likely to be deceived;[3] untruly stating in circulars, advertisements, etc. that they were carrying on the business formerly carried on by the defendant, plaintiffs having in fact purchased the stock in trade, etc. of the business carried on by the defendant from his assignees in bankruptcy.[4] — A trade-mark will not be defeated by the unwarranted use of the word "imported" in connection with it, unless such use is intended to deceive the public.[5] Plaintiff, as a trade-mark for oleomargarine, used the word "Alderney," which he stamped on his merchandise. It was held to be merely arbitrary, and not calculated to deceive.[6] — In *Conrad* v. *Joseph Uhrig Brewing Company*, the defendant alleged fraud on the part of the plaintiff in his use of "Budweiser Lager-Bier," when in truth his beer was not made in Budweis, in Bohemia, but was made by the Budweiser process. The court did not heed such defence.[7] In *Clark* v. *German Mutual Fire Insurance Company*,[8] it was held that trading under the name of "National Slipper Company" does not necessarily imply a corporation, nor an association of powers, but it may be the trade-name of one man. — The use of the words "Number 10, South Water Street," as indicating the place of business of a manufacturer, has been protected by injunction,

[1] Metzler *v.* Wood, 8 Ch. D. 606; 47 L. J. Ch. 625; 38 L. T. (N. S.) 541; 26 W. R. 577.

[2] Stewart *v.* Smithson, 1 Hilt. 119; R. Cox, 175; Dale *v.* Smithson, 12 Abb. Pr. 237; R. Cox, 282.

[3] Hennessy *v.* Wheeler, 51 How. Pr. 457; 69 N. Y. 271; 15 Alb. L. J. 454; 25 Am. R. 188.

[4] Hudson *v.* Osborne, 39 L. J. Ch. 79; 21 L. T. (N. S.) 386.

[5] Funke *v.* Dreyfus, 44 Am. R. 413; 34 La. Ann. 80.

[6] Lanferty *v.* Wheeler, 11 Abb. N. C. 220.

[7] 8 Mo. App. 277.

[8] 7 Mo. App. 77.

the words being a mere arbitrary designation, and not corresponding with any real number.[1] — Selling coal under the name of "Wallsend," though all original collieries of that name had previously been worked out, was not considered a misrepresentation to the public, as purchasers do not attach a definite meaning to the word, but would understand by it any good coal from the Northern districts.[2] — It was not a harmful misrepresentation to sell a preparation of infusorial earth under the name of "Electro-Silicon," silicon not being susceptible of being an object of general commerce, for the reason that in nature it exists in such minute quantities.[3] It was held that the name "Alderney" was a valid trade-mark for oleomargarine; and yet we can understand that it might possibly have conveyed a wrongful impression.[4] In that same case, the plaintiff had placed the words "Patent Sept." upon his goods, and although the patent had been allowed, but had not actually issued, the statement did no harm. — In *Smith* v. *Sixbury*,[5] the name "Magnetic Balm" was held to be a valid trade-mark, on the expressed ground that the medicine contained neither magnetism nor electricity, and that it did not contain any fraudulent suggestion. — In the Court of Paris, in 1881,[6] the following illustration was given. The plaintiff, a tailor in Paris, had assigned to his step-son, Bizet, his place of business, with the right to take the title of "Successeur de Montagne." Bizet, whose mother had espoused the plaintiff, put up a sign, and printed on his papers, the denomination, "Maison L. Montagne et fils, Bizet, dit Montagne fils, successeur." In his defence, he insisted that in so doing he only continued a situation created by Montagne, who had always presented him to customers as his own son and partner; that if there had been between them only an apparent association, the business name of the place was nevertheless that of "Montagne et fils." This

[1] Glen & Hall Manufacturing Co. *v.* Hall, 61 N. Y. 226; 19 Am. R. 278.

[2] Lee *v.* Haley, 21 L. T. (N. S.) 546; 18 W. R. 181; L. R. 1 Ch. 155; 39 L. J. Ch. 284; 22 L. T. (N. S.) 251; 18 W. R. 242.

[3] Electro-Silicon Co. *v.* Hazard, 29 Hun, 369.

[4] Lanferty *v.* Wheeler, *supra*.

[5] 25 Hun, 232.

[6] Montagne *v.* Bizet, 27 Annales, 191.

claim to pass in business as the son of the plaintiff was denied by the latter, who prosecuted him for usurping the false quality of son of his predecessor. The tribunal below had held that, inasmuch, as long prior to the cession by Montagne of his house of commerce to Bizet, the house, although carried on alone by Montagne, bore the name of himself "et fils," the denomination had become the property of Bizet; and although there was a lack of strict truth, it was harmless, and not obnoxious to the charge of deceit. — The question of harmless untruth came up in the French Court of Cassation, in 1882, in *Bardou* v. *Lacroix*,[1] with the same result as in the foregoing case. The plaintiff and his son, makers of cigarette paper at Perpignan, had given to their product the fanciful name of *papier goudron*, which had acquired great popularity. In the tribunal of first instance, the defendant was victorious, as he was also in the Court of Paris, on appeal; one of the grounds of decision being that the plaintiff was disentitled to redress, by reason of false representation. The court of last resort reversed the action below, and said that the law does not prohibit denominations purely arbitrary and fanciful; and that the plaintiff was not to be defeated under the plea of untruth, it appearing that, while the article was called "tar-paper," not a particle of tar entered into its composition; and that, there being no intention to deceive as to the nature of the merchandise, it could not be regarded as a lying trade-mark. — At this point is needed a reference to a case decided by the Court of Appeals of Maryland, in 1884.[2] That case takes extreme views, seeming to go to the length of holding that a misrepresentation, although innocent of wrongful intention, and essentially harmless in consequences, vitiates all right to redress for infringement. The bill charged a simulation of a trade-mark and label. Among other things that label read, "Angostura Bitters, prepared by Dr. Siegert, at Angostura, now Port of Spain, Trinidad." The court said, *inter alia*: "It is conceded that Dr. Siegert died in 1870.

[1] 27 Annales, 214.

[2] Siegert *et al.* v. Abbott *et al.*, 61 Md. 276 (citing with approbation §§ 71 and 474 *et seq.* of the first edition of this treatise).

The bill so charges. He never lived at Port of Spain. The complainants, his sons and successors in business, removed to Port of Spain after his death. One of the complainants was associated with Dr. Siegert in the business as his partner, and alleges that, as survivor, he succeeded to the business, and subsequently he associated his brothers, the other complainants, with him as partners in the trade. . . . It is true a removal from 'Angostura or Ciudad Bolivar to Port of Spain' is noted on the label; but it is so noted as to leave the impression that Dr. Siegert, the inventor and original proprietor, had so removed, and was continuing his manufacture at Port of Spain; . . . no intimation is to be found in the label that he is dead. . . . It should be remarked that, in the note of warning against counterfeits, at the left hand of the label, it is stated that bottles bear the complainants' signature, which inspection shows to be not theirs, but the original inventor's. We are unable to distinguish this case from the Manhattan Medicine Company's case." The defendants relied on the case of *Siegert* v. *Findlater*,[1] wherein the same complainants, after the death of their father, were awarded an injunction, although the same point as to misrepresentation was made. The court relied on a particular case as a conclusive precedent.[2] Let us compare the two by the records. The complainant, a New York corporation, derived all its right, through various mesne assignments, from one Moses Atwood, of Georgetown, Mass. Its bottles bore, blown in the glass, the words, "Atwood's Genuine Physical Jaundice Bitters"; and the labels thereon stated the article to have been manufactured by Moses Atwood, Georgetown, Mass., and sold by his agents. The court said, *inter alia*: "It is admitted that whatever value the medicine possesses was given to it by its original manufacturer, Moses Atwood. He lived in Georgetown, Massachusetts. He manufactured the medicine there. He sold it with the designation that it was his preparation. . . . As the medicine was tried and proved to be useful, it was sought for under that designation, and that purchasers might not be misled,

[1] 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (N. S.) 349; 26 W. R. 459.

[2] Manhattan Medicine Co. v. Wood, 108 U. S. 218.

it was always accompanied with a label showing by whom, and in what place, it was prepared. These statements were deemed important in promoting the use of the article and its sale, . . . yet they could not be used with any honest purpose when both statements had ceased to be true. It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company, in the city of New York." The court, in fixing fraud upon the complainants, cited nine cases as illustrations.[1] All but the first were tainted with fraud. But wherein consisted the fraud in the Maryland case? If Dr. Siegert did not himself prepare the bitters, his sons and survivors, and one of them a former partner of his father, did, and there is not a suggestion that the article differed from their original manufacture, or that any one had been deceived, or was likely to be. The name of "Dr. Siegert" in his lifetime represented more than his individual self. The single name of a man in trade may come to mean many men, his successors in business, not one of them having his surname. The *ratio decidendi* differs in the two cases. The purchasers of Angostura bitters require a specific article. They care not which one of the original firm makes it, nor whether it is made at one place or at another. It was the manufacture of the same concern. Quite the contrary was the truth in the Manhattan case. *Quære*, What rank does the Maryland decision take as an authority?

§ 72. *An Untrue Use of the Word "Patented," or its Equivalent.* — If a trade-mark, or the label bearing it, untruly and fraudulently represents an article as protected by a patent, it is *prima facie* the misrepresentation of an important fact, and the owner of the mark is generally for that cause disentitled to equitable relief against a pirate.[2] That has been

[1] Manufacturing Co. *v.* Trainer, 101 U. S. 51; The Leather Cloth Co. case, 11 H. L. C. 523; Pidding *v.* How, *supra*; Perry *v.* Truefitt, *supra*; Fetridge *v.* Wells, *supra*; Seabury *v.* Grosvenor, *supra*; Hobbs *v.* Français, *supra*; Connell *v.* Reed, *supra*; and Palmer *v.* Harris, *supra*.

[2] The Leather Cloth Co. (Limited) *v.* The American Leather Cloth Co. (Limited), 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. (N. S.) 513; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209. Morgan *v.* McAdam, 36 L. J. Ch. 228; 15 L. T.

held to be positively so when the pretended patent never existed. Wood, V. C., in *Flavel* v. *Harrison*,[1] gives a reason therefor; viz. that the use of the word "patent" operates to prevent the public from testing the article bearing it, as they otherwise might; they are dissuaded from examining the article with a view to imitation; and prevented from making that free use of it which every purchaser has a right to make of an unpatented article. The knowledge that there was no patent would enable and encourage others in the trade to take it to pieces, and examine, and make copies and models of all the parts, for the purpose of imitation, if they thought it likely to be useful, which they would not think of doing with regard to a patented article. Mellish, L. J., said, in *Ford* v. *Foster*,[2] that the test must be whether the use of the term is still calculated to deceive the public, inducing them to buy goods not made by the original owner of the trade-mark, as if they were his goods. In *Lamplough* v. *Balmer*,[3] the plaintiff's labels contained the words "Royal Letters Patent," he not having taken out any patent, and Wood, V. C., refused an injunction notwithstanding an explanation by the plaintiff that he had used the term in consequence of his having long paid duty as for a patent medicine. In *Edelsten* v. *Vick*,[4] Wood, V. C., intimated a doubt whether the rule would be the same if there had originally been a patent, and the statement, being true at first, had been continued after it had ceased to be true; but in *Cheavin* v. *Walker*,[5] the Court of Appeal held that the plaintiff was disentitled, by reason of his reference to a lapsed patent being such as to induce the belief that it was still in force. In *Nixey* v. *Roffey*,[6] the plaintiff described himself on his labels as "Manufacturer and Patentee," though he had taken out no patent, which was held to be equivalent to describing his article as patented; and his bill was dis-

(N. S.) 348. The Leather Cloth Co. *v.* Lorsont, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. (N. S.) 661; 18 W. R. 572. Nixey *v.* Roffey, W. N. 1870, 227.

[1] 10 Hare, 467; 22 L. J. Ch. 866; 17 Jur. 368; 1 W. R. 213.

[2] L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

[3] W. N. 1867, 293.

[4] 11 Hare, 78; 1 Eq. R. 413; 8 Jur. 7.

[5] 5 Ch. D. 850; 46 L. J. Ch. 686; 35 L. T. (N. S.) 938.

[6] *Supra.*

missed, with costs. And when a patent had been held to be invalid, it was held by a United States Circuit Court that the complainants were disentitled to relief, by reason of the reference to the invalid patent as if it were valid.[1] In all the foregoing cases, a fraudulent intention, or a tendency to mislead, was the ground of decision. But the untrue use of the word "patent," or an equivalent expression, does not necessarily disentitle to relief. Intent, or a tendency to mislead, is, after all, a question of fact to be determined by the circumstances of each individual case. Thus, in the King's Bench, in 1824, in an action on the case,[2] the plaintiff having been in the habit of marking his shot-belts, powder-flasks, etc. with the words "Sykes Patent" (though the patent which had been taken out had been held to be invalid), and the defendants having copied this mark on their own goods, the plaintiff was allowed to prevail. Abbott, C. J., said that it was established most clearly that the defendants marked the goods manufactured by them with the words "Sykes Patent" in order to denote that they were of the genuine manufacture of the plaintiff. It has been held by Wood, V. C., that an injunction must be granted, and an inquiry as to damages directed, notwithstanding that the plaintiff's trade-mark label contained the words "tanned leather cloth *patented* June 24th, '56," and that the plaintiff's leather cloth was in fact no longer tanned or patented; since the statement was correct when it was first inserted in the trade-mark.[3] In 1856, in a case where the plaintiffs sold thread the labels of which described "patent thread," and the defendants copied the words, it was held that it could not constitute a defence to show that no patent therefor ever existed.[4] In *Ford* v. *Foster*,[5] the plaintiff had in his advertisements called himself "patentee," but the misrepresentation was held not to disentitle, being at most collateral. — Sometimes the word

[1] Consolidated Fruit Jar Co. *v.* Dorflinger, 2 Am. L. T. (N. S.) 511.

[2] Sykes *v.* Sykes, 3 B. & Cr. 541; 5 D. & R. 292; 3 L. J. K. B. 46.

[3] The Leather Cloth Co. (Limited) *v.* Hirschfeld, 1 N. R. 551; and see 1 H. & M. 295.

[4] Stewart *v.* Smithson, 1 Hilt. 119; R. Cox, 175.

[5] L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

"patent" is used through a misconception of its import, as in *Cave* v. *Myers*,[1] in 1868, before Gifford, V. C., where it appeared that the plaintiffs had registered a design, but had not a patent, yet had described themselves as patentees, and they prevailed, notwithstanding. In the Supreme Court of Louisiana,[2] it was held that the use of the word "patented" must be with the purpose of deceiving the public, to be a valid objection; and if a fraudulent intention does not exist, and the use of the word may be explained in any reasonable sense consistent with truth and honesty, the party will not be prejudiced. Had the words "Registered in the Patent Office" been used, no question could have arisen, but the use of the word "patented" as applied to a trade-mark so registered is so common that the court was referred to a case where so learned a jurist as Judge Cooley uses the language, "In the United States, trade-marks may be patented."[3]—In the case of *Marshall* v. *Ross*,[4] 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.

[1] Seton, 4th ed. 238.

[2] Insurance Oil Tank Co. *v.* Scott, 33 La. Ann. 946.

[3] Cooley on Torts, p. 361, *note*.

[4] L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. (N. S.) 260; 17 W. R. 1086.

§ 73. The case of *Edelsten* 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 particolored labels, in pink and green, in which the pins were described as "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 Edelsten, the plaintiff, who continued the business and the use of the labels. In 1853, Edelsten discovered that Vick, the defendant, was using labels like those of the plaintiff. *Held*, *first*, That Edelsten was entitled to restrain such palpable imitation. *Secondly*, That Edelsten 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 guard 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

[1] 18 Jur. 7.

the possession of either kind by a private individual is presumptive evidence of felony, as much as the possession of false 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 excite the cupidity of the fraudulent dealer; and therefore Heidsieck champagne, other wines and brandies, Piesse's 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 wines. No nation can

[1] Act of March 3, 1871.

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, nearly twoscore years ago, 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 Nîmes, 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, and 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, which is generally much short of its value as a legal tender, as, for example, the standard United States silver dollar of 412½ grains, the gold value of which in 1885 is 86.18 cents. 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 fab-

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

ricated for the purpose of imposing them upon the public as genuine, and gaining the difference of values. 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 piasters 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. Piasters 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 exists 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 Bordeaux 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 Bordeaux. Here was a case of competition in business by unfair means. Suppose

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

that the pious fathers of Bordeaux 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. Manufacture 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 to-morrow. We must apply a touch-stone to anything 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.

§ 80. Necessity for definition.
§ 81. Trade-mark distinguished from its analogues.
§ 82. A clear conception must exist.
§ 83. Label, advertisement, sign of inn, not trade-marks.
§ 84. Convenience of statutory definition.
§ 85. *Marque de Fabrique et de Commerce.*
§ 86. Right to mark founded in immutable law.
§ 87. Of what trade-mark may consist.
§ 88. Mark is emblem of owner.
§ 89. Mark to be valid must be well defined.
§ 89 *a*. Word-symbols as trade-marks.
§ 89 *b*. Mere form of commodity not mark.
§ 89 *c*. Seeming contrary decisions reconciled.
§ 89 *d*. General type of objects not appropriable.
§ 90. Trade-mark confounded with its analogues.
§ 91. Trade-name distinguished from trade-mark.
§ 92. "What-Cheer House" case.
§ 93, 94. "A C A" case.
§ 95. "Irving House" case.
§ 96. Name of hotel not a trade-mark.
§ 97. "McCardel House" case.
§ 98. "Howe's Bakery" case.
§ 99. Howe's name not a trade-mark.
§ 100. "Antiquarian Book Store" case.
§ 101. Name of hotel and trade-mark not convertible terms.
§ 102. British "Merchandise Marks Act,"—definitions.
§ 103. Is name of newspaper a trade-mark?
§ 104. "National Advocate" case.
§ 105. "New Era" case.
§ 106. "Porter's Spirit of the Times" case.
§ 107. "National Police Gazette" case.
§ 108. "La Cronica" case.
§ 109. Copyrights and trade-marks distinguished.
§ 110. Name of newspaper discussed.
§ 111. Meaning of design-patent.
§ 112. Trade-mark, copyright, and patent,—little analogy between.
§ 113. Patented design may be adopted as mark.
§ 114. Judicial opinion as to newspaper name.
§ 115. Name of newspaper a trade-mark.

§ 116. Trade-marks on books.
§ 117. Books regarded as merchandise.
§ 118. Title of book as a trade-mark.
§ 119–125. *"Yankee" soap case.*
§ 126–128. Leather Cloth case discussed.
§ 129. No abstract right in a symbol.
§ 130. A trade-mark one's commercial signature.
§ 131. Generic terms to be avoided.
§ 132. Why labels are evidence.
§ 133. Matters not sufficiently arbitrary.
§ 134. Generic names not valid marks.
§ 135. Valid trade-marks may suggest quality.
§ 136. Line of demarcation not easily drawn.
§ 137. Style or peculiarity of package not mark *per se.*
§ 138. Misconceptions as to nature of symbolism.
§ 139–142. What is merchandise?
§ 143. Essential characteristics of 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*, &c., we mention things which are analogues of one another, 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 exam-

[1] Logic, Lect. VIII.

ple, 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:[1] "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 contain pure gold, we find but withered leaves. In no unkind spirit, we scan words that should be fortresses of thought, and find a heap of chaff. No one has a 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

[1] Logic, Lect. X.

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 Watts, 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 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 anything, 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

[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.

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 lawsuit 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 statutory definition of a trade-mark, which should distinguish, as was done by the old French law, between the *marques de fabrique*, or trade-marks properly so called, consisting of a stamp affixed to or incorporated with a manufactured article, and the use of a name, label, 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,

[1] Bishop's First Book of the Law, §§ 261, 262. [2] 2d ed., p. 83.

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 general 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 commerce 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,[2] where the phrase "trade-marks affixed to merchandise" is rendered in the counterpart *des marques de fabrique apposées dans l'autre sur certaines marchandises;* and see, also, our conventions with Belgium[3] and France.[4] The German term *Fabrikzeichen* is translated into the same words in French.[5] We find a

[1] Lalande et Liot *v.* Appel *et al.*, 5 Annales, 248.
[2] Jan. 27, 1868. [3] Dec. 20, 1868. [4] April 16, 1869.
[5] Technologisches Wörterbuch, in three languages. Paris, 1855.

more comprehensive definition of the term mark of trade, in German.[1]

§ 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 that it 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 fully to 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 shall perceive that any arbitrary law — as a treaty, a convention, or a statute — cannot be a 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. *Of what a Trade-Mark may consist.* — The mark may consist in the name of the owner, whether manufacturer or vendor of the merchandise (provided it be written, printed, branded, or stamped in a mode peculiar to itself); in a seal, a letter, a 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.[2] It may be adhesive or non-adhesive. It

[1] "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.

[2] The British Trade-Marks Act of 1883, sect. 64, says: "A name of an individual or firm printed, impressed, or woven in some particular and distinctive

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.[1]

§ 88. We must not be misled by a sweeping definition.[2] 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. *To be a valid Trade-Mark a Symbol must be well defined and certain.* — We may readily understand why a nondescript vignette, 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

manner; or a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark."

[1] "A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use." Ibid. See also § 102, *infra*.

The Trade-Mark law of the German Empire, of Nov. 30, 1874, does not attempt an elaborate definition; but it expressly excludes from registration such marks as consist exclusively of figures, numerals, letters, or words, or which contain a public escutcheon or any device tending to cause scandal or offence.

The French law of June 23, 1857, says: "Sont considérés comme 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."

[2] Standard authorities sometimes make a slip. For example, Webster's Unabr. Dict., ed. of 1883, has the definition of "*Reproduction*. The act or process of reproducing; as, the *reproduction* of plants or animals from cuttings or slips." See also note to § 1.

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. There are, however, arbitrary symbols that require more than a single glance to have their true character understood. It may be that purchasers are required to be specially instructed as to intent and signification; but when once explained in connection with certain merchandise they become reliable exponents. Examples will appear in other parts of this work; but, for present illustrations, the following instances, which have all been approved as valid trade-marks, may be cited. — Exporters of cotton cloths to Turkey and the Levant affixed to their cloths a certain heading, consisting of different-colored threads in combination.[1] — A selvage and a single thread in a woven fabric. It was held that by their color, their disposition, and the places occupied, they became a distinctive sign, especially when their distinctive character resulted principally from contrast with the color of the product to which they were attached.[2] — So of a simple selvage or edging composed of one of several threads woven into the top or border of a stuff.[3] — A simple band of gilt paper rolled around the lower part of a wax candle.[4] — Inscriptions and emblems, notably medals, in relief in the glass of a flask, when the arrangement is original.[5] — A star, printed on a colored card by itself.[6] — A hidden mark on the part of a cork that is inserted in the bottle.[7] — The union of

[1] Harter *v.* Souvazoglu, W. N. 1875, p. 11; L. J. Notes of Cas., 1875, p. 20; W. N. 1875, p. 101.

[2] Ph. Vrau & Co. *v.* Pouillier-Loughaye *et al.*, 26 Annales, 92.

[3] Cuillieron-Policard *v.* Gadobert, 21 Id. 62.

[4] Cusimberche *v.* Debard *et al.*, 27 Id. 304.

[5] Robert *v.* Grandjean, 28 Id. 145.

[6] Lelarge *v.* Brossom, Journ. du Palais, 1840.

[7] Ministère Pub. *v.* Bernard, Id., 1845.

divers emblems that had previously become *publici juris*. The highest court in France, in 1875, held that, the instant the union became of a nature to indicate a product in a distinctive and characteristic manner, it became a valid trade-mark.[1] — A peculiarly formed stick, in two pieces fitted together, with the ends of an octagonal shape, upon which carpet was rolled.[2] — A perfectly formed metallic bell of the height of about an inch, with clapper, a miniature of the great bell at Moscow, and used to be hung by a ribbon to the neck of a bottle containing champagne wine entitled "Bell of Moscow," was rejected by the Trade-Mark Examiner. On appeal to the Commissioner, on authority of the carpet-stick case, registration was allowed.[3] Very recently, a novel style of symbolism has favorably been considered by the Patent Office, as possessing all the essential characteristics of a trade-mark. This species of symbolism is of an ancillary nature, being the groundwork upon which is laid another and distinct trade-mark, and the matter is printed on a wrapper for bars of soap. It was found to be necessary to protection, that the general aspect of the wrapper of a cake of soap should be strictly defined and guarded. One configuration for a wrapper is thus described: "Within a parallelogram, with a triple-ruled border, is a mosaic tessellation, the same being an aggregation of uniform squares, separated from one another by straight lines. Every one of said squares contains four separate triangular figures formed by continuous straight lines, bent so as to form two acute angles and one right angle, yet separate, so as to leave a space between them, thus forming a diagonal cross. Laid upon, and extending across, said parallelogram, is another and smaller parallelogram narrower in proportion."[4] — Another for a groundwork has a representation of clover leaves, the greater number of which are four-

[1] Fox *v.* Meurgey *et al.*, 20 Annales, 213.

[2] Lowell Manuf. Co. *v.* Larned, in 1873, Codd. Dig. 341; Cox's Man., Case 428. In a note to this case, Mr. Cox expresses his opinion that the said stick was a perfectly good trade-mark. Certainly the device is *sui generis*.

[3] Re Charles Narcisse Farre, cert. No. 8,939.

[4] Re Procter & Gamble, cert. No. 11,927, dated Feb. 10, 1885.

leafed.[1] Another has a complex groundwork, formed by a multiplication of fine curved lines spreading, from a point, in every one of a great number of connected somewhat irregular figures, forming a neutral tint. Interspersed are circular devices, all similar and bearing the representation of a half-moon.[2] — There are many others of the same owners that are just as peculiar. The designs are novel, and require an inspection of the fac-similes to understand the verbal description.

§ 89 *a*. *Word-Symbols*[3] *as Trade-Marks*. — A combination of words, or a single word, or a collocation of letters of the alphabet not recognized as a word, if non-descriptive of the vendible commodity to which the same is affixed, may be a trade-mark. When so used, words cease to be mere words, and become denominations of fancy. The arbitrary use of a word, a compound phrase, or letters in a certain juxtaposition or arrangement, indicates that the thing is a technical trade-mark. But there is sometimes a conflict of laws in regard to word-symbols; and strange coutradictions arise in respect to judicial protection for them. It is possible that a right may exist, and yet protection therefor be in abeyance. Thus, in Great Britain, under the trade-mark act of 1875, a word was not entitled to recognition as a trade-mark unless it had pre-

[1] Same firm, cert. No. 11,959, dated Feb. 17, 1885.

[2] Same firm, cert. No. 11,962, dated Feb. 17, 1885.

[3] The author of this treatise coined the expression "word-symbol," because some new definite term seemed to be necessary. The convenience of the term is recognized in the Patent Office and in practice. "*Word*" is equivocal; for a word may be merely a vocal sound or a combination of vocal sounds; or a talk, discourse, or language; or it may be a written or printed character. If written or printed, a word may be spelled in several ways. Thus *Anotto* may be spelled in five ways, *Carbineer* in four ways, *Gantlet* and *Palette* each in three ways. (See Webster's Unabr. Dict., ed. 1883, Orthography, pp. lxviii.–lxxi.) The assemblage of letters may be substantially the same, yet be varied to eye and ear. A symbol is a sign by which one knows or infers a thing. It is positive, invariable. A *word-symbol* is therefore understood to mean precisely this: a combination and arrangement of letters that remain in the same relative position, a definite character addressed to the eye. Why not employ the simple noun "word"? Because it has been deprived of its proper office; or, indeed, the emblem formed of letters may not be a recognized word at all, or it may be a word distorted out of all natural shape. See §§ 83, 68, 192, and Index, for examples.

viously been in use as such, so that there might be protection for one man's fancy name when another's would be refused, because he adopted it a day too late. Under the act that went into operation at the beginning of 1884, arbitrary words may be valid marks. — So in France, as well as in this country. But the legislation of some countries positively excludes them from protection. For example, the law of November 30, 1874, of the German Empire, refuses registration to such marks as consist exclusively of words. — An international convention for the formation of a Union for the Protection of Industrial Property was held on March 20, 1883. Many nations have already acceded to the terms of the convention. Article 6 thereof reads thus: "Every mark of manufacture or of commerce, regularly registered in the country of origin, shall be admitted to registration and protection in all the other countries of the Union." In his circular of August 26, 1884, M. Ch. Herisson, Minister of Commerce, properly says: "The legislation of divers nations does not admit as trade-marks certain signs, certain emblems. As to those concerning the states of the Union, the marks of French manufacture and commerce shall be admitted to registration, as they shall have been registered in France." [1] It is intended that all the principal countries shall accede to the terms of the convention, just as they have in regard to postal matters. This strange state of affairs may be possible. An Englishman or a Frenchman may be entitled to registration and protection of his word-symbol in a foreign country, when a citizen of that country would be excluded by local legislation. But, for the purposes of this discussion, arbitrary words shall be regarded as entitled to plenary protection.[2] In the adoption of a word, or of words, it is not for the adopter to determine its technical validity. That is a judicial question. Yet it is not difficult to reason from authorized rulings. The word "Swing" for a socket of a scythe-snath was

[1] 29 Annales, 289 *et seq.*

[2] The United States has thus far declined to join the Union, — although represented at the convention, — for the reason that trade-marks had become complicated with patents.

decided not to be sufficiently arbitrary.[1] So of "Masonic."[2] "Snowflake" was held not to be a valid trade-mark for bread or crackers, because, said the court, "In the common or ordinary sense it is understood to be descriptive of whiteness, lightness, and purity."[3] The words "Homœopathic Medicines" were held not to be arbitrary.[4] "Albany Beef," (slang term for sturgeon) was rejected.[5] So was "Crystalline" for artificial stones or brilliants.[6] "Nappes de Famille" (family table-cloths, &c.), applied to all cloths of a certain dimension, of whatever material, could not be exclusively appropriated.[7] Words in ordinary and common use, such as "Charity" or "Faith," are not susceptible of appropriation as a title or designation for a book, or a play, to treat or symbolize the virtues.[8]

§ 89 *b*. *The mere Form of a vendible Commodity not a Trade-Mark.*[9]—A demonstration of this doctrine should hardly be necessary; but it is not always remembered that the mark is merely the authenticating sign or emblem. The following are illustrations of misconceptions in this regard. In the year 1844, the Tribunal of Commerce of Morlaix emphasized this rule.[10] In that instance, the plaintiff claimed the form of the article of commerce — a pipe — as a trade-mark, but his claim was rejected. In 1865, the Court of Paris held that the cylindrical shape of a package of cigarette-paper was not a trade-mark.[11] In the last-named court, in 1870,[12] the plaintiff, as assignee of one Gibbs, of a mechanical patent and also an *alleged* trade-mark, claimed as a technical trade-mark

[1] Re Thompson, Derby, & Co., 16 Off. Gaz. 137.
[2] Re Smith, Ibid. 764.
[3] Larrabee *v.* Lewis, 67 Ga. 561; 44 Am. R. 735. (A questionable ruling.)
[4] Humphrey's Specific Homœopathic Medicine Co. *v.* Wenz, 14 Fed. R. 250.
[5] Re Ams, 24 Off. Gaz. 344. [6] Re Kipling, Ibid. 809.
[7] Chicot & Co. *v.* Vespierre & Rozé, 25 Annales, 162.
[8] Isaacs *v.* Daly, 39 N. Y. Superior Ct. 511.
[9] See § 137, *infra*: "The style or peculiarity of package is not *per se* a trade-mark."
[10] Fiolet *v.* Duval, Traité de la Contrefaçon, by Etienne Blanc, 763; Huard, Marques de Fabrique, 19.
[11] Prudhon *v.* Villaret, 11 Annales, 443.
[12] Willcox *v.* Aubineau *et al.*, 17 Annales 31.

the form "G," of his sewing-machine arm. In 1867, the plaintiff had registered in France two alleged trade-marks, one the form "G" of the machine and the other the letter "G" embodied therein, and affixed thereto. On appeal the court said: "To accept as a trade-mark the product itself in its particular form, without other sign borne by the product to distinguish it, would be to exceed the intention of the special law of the matter. Such a doctrine would not only recognize the privilege of the inventor, but also the privilege of the very form of the product, that, in effect, by means of the deposit of the product under pretext of its being a mark, the product would become the privilege of the manufacturer to the prejudice of the liberty of trade; and, as by the registration act of 1857 the privilege of the mark is indefinitely renewable, one might acquire thereby the perpetuity of an indefinite privileged property in the form of the product itself, contrary to the principles of patent law. Inasmuch as the mark claimed by Willcox, as a distinctive sign of his sewing-machines, is the design of the manufacture itself, and is not an emblem or detail affixed in any manner whatsoever to the complete machine, if the peculiar form were entitled to any protection it was only by virtue of the patent, and, on the expiration of that, the public had a right to make machines in the form of the *letter*." — The exact point has recently been passed on in a United States Circuit Court with the same result, and probably without any intimation of the foreign decision.[1] A design-patent for the form of the letter "G" had been granted, August 10, 1858, and its re-issue of June 10, 1867, had expired by limitation. The complainant had also, on June 14, 1881, registered the same device in the United States Patent Office, as a trade-mark, claiming title by user back to 1859.[2] Wheeler, J., said, *inter alia*, that, in the patent, the shape of the frame, the letter "G," was particularly described, and its advantages set forth thus: "Which not only stamps it with a peculiar character, but is also exceedingly use-

[1] Willcox & Gibbs Sewing-Machine Co. *v.* The Gibbens Frame, 17 Fed. R. 623; 24 Off. Gaz. 1272.

[2] U. S. registration certificate No. 8,356.

ful, as it affords the greatest possible space for the cloth or material to be sewed of being turned and twisted under the needle and upon the table"; and there was claimed as a part of the patented invention "combining with the vibrating needle-arm a frame shaped substantially like the Roman letter G, as herein shown and described, and for the purposes set forth." *Per Curiam*: "The frames in this form were a part of the manufacture to be identified as to source, and not an identifying mark, merely, of source, indifferent to the main feature. All right acquired under the patents expired with them. . . . All the effect which these frames have in representing machines to be those of the orator appears to be due to the monopoly enjoyed under the patents; and to give the orator the benefit of the effect by calling the frame a trade-mark continues the monopoly indefinitely, when under the law it should cease." — In a United States Circuit Court, in 1871, Sawyer, J., said: "I find no case where the use of a package of peculiar form and dimensions has been restrained, without having impressed upon or connected with it some other word, symbol, letter, or form, adopted as a trade-mark." [1] In that case the claim was for the peculiar form, construction, and capacity of a barrel for whiskey. — So, in 1877, in a United States Circuit Court it was held that the complainant could not legally enjoy the exclusive right to use a decorated tin pail as a box for paper collars, notwithstanding the fact that he was the first to employ it for that purpose, and had registered it as a trade-mark.[2] — It was correctly held by the Patent Office, in 1875, that "galvanized iron hoops placed on a barrel of a dark color," as a trade-mark in respect to spirituous liquors, could not be such, even if the applicants were the first to use them on barrels of spirits, as they convey no distinctive idea.[3] — In 1877, that Office had before it an application for the registration of a strip of leaf-tobacco, intended to be wrapped around the mouth-piece of a cigarette, and to vary with the size of the cigarette, as a trade-mark. The application for

[1] Moorman *v.* Hoge, 2 Sawyer, 78; 4 Am. L. T. 217; 6 Am. L. Rev. 365.
[2] Harrington *v.* Libby, 12 Off. Gaz. 188.
[3] Re Kane & Co., 9 Off. Gaz. 105.

registration was rejected, because it was in fact adopted to serve a mechanical purpose rather than to distinguish the applicant's goods from those of others.[1] — In an analogous case, in 1878, under an indictment for counterfeiting an alleged trade-mark, consisting merely in the color of oil used for illuminating purposes, United States District Judge Giles doubted the possibility of protecting such a matter as a trade-mark, although it had been registered; and the prisoner was acquitted.[2]

§ 89 *c*. There are decisions which, at the first glance, seem to hold that the *mere form* of the vendible article may constitute a technical trade-mark. Careful analyses cannot fail to induce the conclusion, that the principles of unfair competition, rather than those appertaining to trade-marks, were the bases of judgment. In the Tribunal of Commerce of the Seine, in 1856,[3] it appeared that the plaintiff sold chemical paper enclosed in a maroon-colored pasteboard roll. Injunction and damages. — In the Court of Paris, on appeal, in the same year,[4] a biscuit manufacturer had for his biscuits four packages of white glazed paper, with a label "At the Biscuits of the Crown" printed thereon in gold, with the representations of medals at each corner, the national arms in the centre, and at the two ends an escutcheon with the words "à la vanille." The defendant wrapped his biscuits in the same kind of paper, with a label printed in gold, and the representations of medals at each angle, with same national arms, and at the corners escutcheons with the words "Glaces à la vanille." No technical trade-mark had been violated; but the court held that the form and color of the package would be likely to cause confusion. — In the Court of Lyons, in 1857,[5] the plaintiffs were manufacturers of solid laundry-bluing in cakes in the form of sad-irons, having on one side raised figures of women in the act of ironing, and on the other side women washing or placing clothes on lines to dry. The defendant made bluing in same form of sad-

[1] Re Gordon, 12 Off. Gaz. 517.
[2] U. S. *v*. Rider, Dist. of Maryland (*reported in newspapers*).
[3] Poupier *v*. Laurençon, 2 Annales, 363.
[4] Gillout *v*. Richard, 3 Id. 123.
[5] Boilley *v*. Jollivet, 3 Id. 253.

irons, bearing on one side the figure of a woman in the act of washing or of ironing. The tribunal below had dismissed the case because the resemblance of form and figures was not sufficient to deceive, each package bearing the name of the respective manufacturer, and the boxes enclosing the articles being unlike in color and inscriptions, not being a servile imitation. The appellate court reversed the decision, holding that the marks and emblems of the plaintiff had been imitated, and that the change of manufacturers' names was immaterial. *It does not appear that a technical trade-mark* had been infringed. — In the Tribunal of Commerce of the Seine, in 1858,[1] it was *held* that, although the manufacture of "l'eau de Botot" had become public property, a manufacturer of that water had no right to use the same form of bottles and seals as did the successor in business of Botot, the originator, nor to sell the product as "veritable eau de Botot." The decision was affirmed on appeal. — In the Court of Aix, in 1872,[2] there was a decision that seems to go a great way in this direction. The plaintiff's peculiar symbolism consisted in the demi-cylindrical form of tablets for chocolate, having six divisions with incrustations of a letter of his surname on the flat face of every division. The court sustained the plaintiff's case; but it is not at all clear that the form of the product was held to be a technical trade-mark.

§ 89 *d*. *A General Type* of objects cannot be exclusively appropriated. — The arbitrary symbol can consist only in specific form; and the representations must be so precise, definite, and certain, as to exclude all reason for doubt of description. A case in the Patent Office, in 1884,[3] involved an elaborate discussion of this theme. When stripped of redundant verbiage, the claim was for a cross represented pictorially, or by the word "Cross." Trade-Mark Examiner Seely, in refusing to register the case as presented, reasoned substantially thus: Suppose the alleged trade-mark to consist of the

[1] Barbier *v.* Simon, 4 Annales, 191.

[2] Menier *v.* Roquebrun, 18 Id. 29.

[3] Re Hamilton Disinfectant Chemical Works, Case No. 18,678, filed July 31, 1884. Affirmed on appeal, 27 Com. Dec. 842.

representation of an eagle. The species should be shown, since, in the eye of an ordinary observer, all eagles are much alike. It should be shown as sitting, flying, or as the spread-eagle of American coins, or as the double-headed eagle of Austria, etc. — The different forms of crosses, Greek, Maltese, Latin, Egyptian, St. Andrew's, and others, are as distinct from one another as are reciprocally the letters of the alphabet. No one who has used one of the specific forms to distinguish his goods can, by his appropriation of the same, exclude all the rest of the world from a use of any of the other forms, any more than he could by the adoption of the letter A exclude others from using the remainder of the alphabet, from B to Z both inclusive.[1] An attempt to include so many undescribed forms would necessarily result in just what the applicant should avoid, — an annihilation of all distinctiveness in his chosen symbol. If he has adopted a Greek or other particular form of cross, and made it known to the public as a distinguishing mark for his goods, every departure from the clear, sharply outlined figure which he has already employed must destroy its identity, and he ceases to that extent to have a trade-mark. Purchasers accustomed to buy goods distinguished by a peculiar well-defined mark must distrust goods having a mark in some respects similar, but on the whole different. It is not the same. The advantage of the applicant is in adopting a specific form and not departing from it. If the application were admitted, the registration would go for naught. This is a common-sense enunciation of the rule that a broad claim to a common emblem cannot be allowed. — The Court of Appeals of New York, in 1876, had this case.[2] The plaintiff below was a manufacturer of refined lard, which he sold in vessels stamped with the figure of a fat hog, his name, and "Prime Leaf Lard": the defendants began to sell a similar article in vessels stamped with a globe, a small wild boar, their name, and "Prime Leaf Lard." Monell, J., in the Superior Court of the City of New York, thought that the defendants' mark was likely to attract

[1] He cited § 588, *infra*, which see.

[2] 66 N. Y. (21 Sickels) 60; 23 Am. R. 22.

to itself the same name as the plaintiff's, namely "the pig brand," and continued an injunction previously granted. The general term of that court dissolved the injunction, it being shown that the pig mark had been used by various other refiners. The court of final resort concurred in the decision in favor of the defendants, on the ground that there was not sufficient resemblance between the marks to be calculated to deceive; and because it was doubtful whether the figure of the animal from which the lard is derived was not descriptive, and therefore incapable of being appropriated. If the plaintiff had prevailed, he might have appropriated to his exclusive use all animals of that genus. — In the Court of Nîmes, in 1876, and the Court of Cassation, in 1877, a case of the same nature came up.[1] *Held*, that where it is established that, from time immemorial, merchants of truffles had employed on the common label, or letter-heads, a representation of a hog seeking truffles, the vendor who adopts and registers a label of this kind, intended to distinguish boxes of truffles put into the market, cannot claim, in a general and absolute manner, the mark of a hog, but only the distinctive configuration. It is, therefore, no infringement when another uses the representation of a hog, the peculiar design, arrangement, color, and bordering of which so completely differ as not to cause confusion in the mind of purchasers. — These two decisions held virtually that there might have been infringement of an arbitrary emblem, if the specific hog had been copied. — In the Patent Office, in 1884,[2] the gist of an application for registration was as follows: "The essential feature of my trade-mark is the red bag, and I therefore claim the use broadly of a red bag in which pea-seed is packed for the trade." Trade-Mark Examiner Seely, in rejecting the claim, observed that in a similar application, filed at the same time, a *blue* bag was claimed as a trade-mark for spinach-seed. In all other respects, the cases were identical, and a decision in one would conclude the Office upon the other, and upon an entire series

[1] Bonfils Frères *v.* Naquet et Fils, 26 Annales, 101.

[2] Re Oliver Landreth, Case No. 17,431. The Office cited §§ 271, 272, *infra*, which were approved by the U. S. Cir. Ct. (S. D. of N. Y.) in Harrington *v.* Libby, 12 Off. Gaz. 188.

that, in event of decision in his favor, would be presented by the same applicant, involving the right of use of bags of different colors to distinguish various kinds of seeds from those of other dealers. He said, further, that it was evident, from considering more than one case, that the purpose was to secure the exclusive use of a system of packing seeds, in which the kind of seed should be indicated, and its origin shown, by the color of the package only. He demonstrated the uselessness of such a registration if it were possible, inasmuch as it would be in any one's power, without infringing any so-called trade-mark, to employ a similar system, or any number of systems, within the limits of arithmetical permutation. Except as to the color of the receptacle, there was no limitation in respect to the matter claimed as essential. As to shape and material, they were limited to nothing, except that the receptacle must be of some material that could be made into a bag, — paper, silk, canvas, leather, India-rubber, mosquito-netting, flannel, or any other textile stuff capable of receiving color; and the bag might be of any shape or size, as, for example, a lady's reticule or a gunny sack. He argued further, that, as red-colored materials suitable for being made into bags are commonly on sale and in use, there can be no legal restriction on their use by any person, for any lawful purpose that suits his convenience. If the law were otherwise, other persons might appropriate other colors and shades *ad infinitum*. — Appealed to the Commissioner, who, for the reasons stated above, affirmed the decision. — In an appeal from the trade-mark officer in England, the court held that the symbol of a crown, or of a horse-shoe, being common to the iron trade, could not be private marks.[1] — In the Court of Aix, in 1876,[2] it appeared in evidence that in 1862 the plaintiff had adopted and deposited at the city of Marseilles, as a trade-mark for soap, a device enclosing the image of the Virgin Mary, her head crowned with an aureole and surrounded with stars, and her fingers emitting rays. It had no denomination. In 1866, the defendant, another soap-

[1] Re Barrow's Application, 5 Ch. D. 353; 46 L. J. (N. S.) Ch. 725; 25 W. R. 564.
[2] Eydoux *v.* Morel, 23 Annales, 252.

manufacturer in the same city, adopted as a trade-mark for soap a device also enclosing the image of the Virgin Mary with a crown on her head, and the infant Jesus on her left arm, a vine in her right hand, and with the inscription "La Bonne Mère" in the margin. In 1875, the plaintiff made a new deposit of his trade-mark of 1862, but he added thereto the words "La Vierge," and thereupon sued for infringement. The opinion of the court commends itself by good sense. *Held:* When one adopts as a trade-mark *a general type* susceptible of being represented under different figures and denominations distinct from one another, he has not a vested right of exclusive user, except as to the figure and denomination that he has specially chosen; and this right cannot be extended to the general type of which he has availed himself, and of all the modes of manifestation. Being only an owner of an exterior and visible sign, registered and placed under the eyes of the public, he will not be permitted to complain of the use by a rival in trade of a mark differing from his own in effigy and denomination, nor to allege the identity of type from which the two are borrowed, when no confusion between the two is possible to be seen, and they present to the vision quite different aspects. It is a matter of indifference that confusion may be awakened in the imagination. The property in a trade-mark has not for an object a pure abstraction. It is not permissible for a manufacturer who has taken such an image, to absorb into exclusive property all varieties of forms and appellations in which that image has been comprised and reproduced in the domain of arts, and by the piety of people who have appropriated it.

§ 90. It is not very strange that casual readers, or ordinary observers, should fall into the error of confounding the technical mark of manufactures or commerce with things of quite another nature, — by which is meant rights which are protected on principles analogous to those on 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. — With rare exceptions, this important distinction is observed. Mr. Lloyd, in his treatise on Trade-Marks, 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, 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.

§ 91. *Trade-Name, as contradistinguished from Trade-Mark.* — Care should be observed not to confound these two technical terms. Sometimes, in the discussion of principles, or in reasoning from analogy, learned courts fall into error in using these terms convertibly, when the rules applicable to them

respectively are in their natures mutually antagonistic. The distinction will be readily comprehended, when it is remembered that a trade-mark owes its existence to the fact that it is actually affixed to a vendible commodity.[1] A trade-name is more properly allied to the good-will of a business.[2] Trade-names may, for the convenience of the present discussion, be divided into distinct classes: 1. Of men, their business, or their pseudonyms; 2. Of places become famed for manufactures, commerce, health, or even luxury; and 3. Of coaches, and other vehicles for the transportation of passengers or merchandise. As illustrations of Class 1 may be taken the name of a firm, which may continue to be a trade-name long after the firm has been dissolved, as "John G. Loring & Co."; [3] or the name of a person long deceased, that may represent several persons, as "Perry Davis"; [4] or the title of a corporation, as "Brooklyn White-Lead Company"; [5] or the name of a mere firm, as "The Guinea Coal Company"; [6] or a mere sobriquet, as "Tom Pouce" (Tom Thumb); [7] or "Little Jake"; [8] or "Twin Brothers"; [9] or "National Slipper Company," [10] assumed by a single person. As illustrations of Class 2 may be taken names, as "Congress Spring"; [11] "Old Oscar Pepper Distillery"; [12] "Taper Sleeve Pulley Works"; [13] "Grande Chartreuse"; [14] or "La Bodega," [15] for a wine-shop. As illustrations of Class 3 may

[1] See §§ 52, 382, 384. [2] §§ 521–536.

[3] Bowman *v.* Floyd, 85 Mass. (3 Allen) 76.

[4] Davis *v.* Kendall, 2 R. I. 566; R. Cox, 112.

[5] Brooklyn White-Lead Co. *v.* Masury, 25 Barb. 416; R. Cox, 210.

[6] Lee *v.* Haley, L. R. 5 Ch. 155; 39 L. J. Ch. 284; 22 L. T. (N. S.) 251; 18 W. R. 242.

[7] Trib. of Commerce of the Seine, in 1845, Tom Pouce *v.* Roqueplan, Blanc on Counterfeiting, 732.

[8] Grow *v.* Seligman, 47 Mich. 607. [9] Burton *v.* Stratton, 12 Fed. R. 606.

[10] Clark *v.* German Mutual Fire Ins. Co., 7 Mo. App. 77.

[11] The Congress and Empire Spring Co. *v.* The High Rock Congress Spring Co., 45 N. Y. (6 Hand) 291; 10 Abb. Pr. (N. S.) 348; 6 Am. R. 82; 4 Am. L. T. 168; R. Cox, 624.

[12] Pepper *v.* Labrot *et al.*, 8 Fed. R. 29.

[13] Gray *et al. v.* Taper Sleeve Pulley Works, 16 Fed. R. 436.

[14] See *infra*, § 407 *et seq.*

[15] Trib. of Commerce of the Seine, in 1878, Lavery & Co. *v.* Fajardo, 24 Annales, 71.

be taken such names as "Conveyance Company," for an omnibus;[1] or "Revere House," for a passenger-coach.[2] These are only examples, for the books contain many cases of the various kinds. It is somewhat remarkable that nearly all are improperly spoken of as trade-marks, when, as presented to the courts, they were not trade-*mark* but trade-*name* cases. The distinction rests upon the manner of use; for, as was properly held by the Supreme Court of Massachusetts, in 1861,[3] a thing may be a trade-name for one person, as indicating his business, and a trade-mark for another, who has affixed it to his merchandise as such; and, as the House of Lords of England afterwards said, "It is true that a name or the style of a firm may by long usage become a mere trade-mark, and cease to convey any representation as to the fact of the person who makes, or the place of manufacture."[4] Lord Blackburn, in the House of Lords, in 1882, said that a name may be so appropriated by user as to come to mean the goods of the plaintiffs, though it is not and never was impressed on the goods, or on the packages in which they are contained.[5] But it must be protected as a trade-name, and not as a trade-mark, as it would be, of course, when the name is stamped on, or otherwise affixed to, goods for sale. But sometimes the error is committed of calling a mere sign of a building a trade-mark, as when a sign "IXL General Merchandise Auction Store" had been registered under a State law as a trade-mark, and the court seems to have treated it as such;[6] and, in 1883, in the course of a very able opinion, a high court cited "Revere House," "What-Cheer House," and "Irving Hotel" as trade-marks.[7]

§ 92. In the case of *Woodward* v. *Lazar*,[8] 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

[1] Knott *v.* Morgan, 2 Keen, 213.
[2] Marsh *v.* Billings, 7 Cush. 322.
[3] Bowman *v.* Floyd, *supra.*
[4] The Leather Cloth Co. case, 11 H. L. C. 523.
[5] Singer Manufacturing Co. *v.* Loog, 5 L. R. App. Cas. 8.
[6] Lichstein *v.* Mellis, 8 Oregon, 464; 34 Am. R. 592.
[7] Avery *v.* Meikle, Kent. L. R., April, 1883; 17 West. Jur. 202.
[8] 21 Cal. 448.

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 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 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

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

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 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 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 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 struck from the injunction. Nothing thereafter remained but words in ordinary use, common to all the manufacturing world. But, as 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 *prima facie* trade-mark, from its long user and general 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 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, secondly, 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,

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

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,

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

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 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"; and 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 any wise discussed as anything other than what it really

[1] 28 How. Pr. R. 120.
[2] 10 Abb. Pr. R. 264; 6 Bos. 854; and 19 How. Pr. R. 14.

was,—"the *good-will* of the business of baking." All the authorities commented upon by the learned Judge Hoffman, who delivered the opinion of the court, are good-will cases. He adopted the language of Vice-Chancellor Wood, in *Churton 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 expression. 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

[1] 28 L. J. Ch. 841; 5 Jur. (N. S.) 887; 33 L. T. 57.

trade-mark; for it would not indicate origin. The purchasers could not tell by the mere name which 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 accurately to 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 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 Scotland) any article of trade, manufacture, or merchandise,

[1] 39 Cal. 501; 2 Am. R. 476; R. Cox, 598.

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 *Motley* 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 by the courts. 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

[1] 3 M. & C. 1; L. J. Ch. (N. S.) 308.

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

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 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

[1] Hopkins Ch. R. 347; R. Cox, 1.

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 thought 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 the plaintiff, who published the "Democratic Republican New Era." The Chancellor said: "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 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, farther on in his opinion, that "there could be very little excuse for the editor of a new paper who should adopt the precise name

[1] 8 Paige, 75; R. Cox, 11.

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." 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*,[1] 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 farther.

§ 107. *Matsell* v. *Flanagan*,[2] 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 plaintiffs' 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 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

[1] 17 How. Pr. R. 510; R. Cox, 224.
[2] 2 Abb. Pr. R. (n. s.) 459; R. Cox, 367.

commenting on *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 anything that was the subject of a patent or a copyright, but is confined to appropriations of names designating some 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

[1] 4 Abb. Pr. R. (n. s.) 47; 30 N. Y. Superior (7 Robertson), 348.

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 anything 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 our American authorities on this point are exhausted. 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

[1] 2 Ves. 226.

[2] An Act to revise, consolidate, and amend the statutes relating to patents and copyrights, July 8, 1870. — Rev. Stat., sect. 4948–4971.

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[1] 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 says,[2] 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

[1] Art. I. sect. 8, sub-sect. 8.
[2] Story on the Constitution, vol. ii. § 1152.

a trade-mark acknowledges no boundaries. They are unlike in their natures.[1]

§ 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 anything 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 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, or photograph, 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? None. If considered as a work of art, what would be the measure of damages for infringement?[2] As a penal law, the statute must be strictly

[1] Scoville *v.* Toland, 6 West. L. J. 84, U. S. Cir. Ct., Dist. of Ohio, held that labels or marks of commerce could not be protected under the copyright law. So held also in Osgood *v.* Allen, U. S. Cir. Ct., Dist. of Maine, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124. In the latter case, the title of a publication was sustained as a trade-mark. To the same effect is Coffeen *v.* Brunton, U. S. Cir. Ct., Dist. of Ohio, 4 McLean, 516; and Collender *v.* Griffith, U. S. Cir. Ct., S. Dist. of New York, as to an engraving. Simonds on Design Patents, p. 51.

[2] See sect. 100 of copyright law of 1870. Rev. Stat., sect. 4964, 4965.

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,[1] a description of the book or 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,[2] 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 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.[3] 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

[1] Sect. 90 of copyright law of 1870; Rev. Stat., sect. 4956.
[2] Albany, N. Y., 1860, pp. 17, 18.
[3] See case of Whyte, Commissioner's Decisions, 1871, p. 374.

analogy to that which exists in copyrights, or in patents for inventions." [1]

§ 113. In *Swift* v. *Dey*,[2] 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." [3]

§ 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 anything can be. It would 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.[5]

§ 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

[1] Delaware & Hudson Canal Co. *v.* Clark, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279.

[2] 4 Robertson, 611; R. Cox, 319.

[3] In Re Lee & Shepard, 23 Off. Gaz. 1271, it was decided that a patented design cannot afterwards be registered as a trade-mark.

[4] 3 Am. L. T. 288; 2 Brewst. 321.

[5] F. C. Barksdale, "Our Society," No. 424.

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 eighteenth; 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,"[1] 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 then regarded as proper objects for the reception of trade-marks. So the courts now uniformly hold.[2]

§ 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. 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; for example, when, two centuries ago, in England, the five Presbyterian divines (Stephen Marshal, Edward Calamy, Thomas Young,

[1] 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.

[2] Kelly *v.* Hutton, L. R. 3 Ch. 703; 37 L. J. Ch. 917; 19 L. T. (N. S.) 228; 16 W. R. 1182. Bradbury *v.* Dickens, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54. Clement *v.* Maddick, 1 Giff. 98; 5 Jur. (N. S.) 592; 33 L. T. 117. Ingram *v.* Stiff, 5 Jur. (N. S.) 947; 33 L. T. 195. Osgood *v.* Allen, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124. Estes *et al. v.* Williams *et al.*, 21 Fed. R. 189.

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 which 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 had for a time but doubtful 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. The court contented itself with ascertaining the justice of the case, without caring about much nicety in terms. We shall 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 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

[1] 2 Bos. 1.

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 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 the 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 and Co. was fictitious, or used as a colorable imitation, as simulating the trademark of the plaintiffs, and deduced the title of the defendant to its use from a firm of that name, which 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 exact-

ness 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 sufficent 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. So far as trade-mark law is involved, the foregoing contains very little instruction. None of the words on the plaintiffs' labels were susceptible of being made a technical mark, except the word "Yankee." The court did not announce the precise nature of the case. It was not necessary to do so, although the matter, as presented, was one of *unfair competition*. The object was not definition, but equitable relief. But the time came when allegations were more

technical, and a court was called on to decide the exact question. In a Circuit Court of the United States, in 1879,[1] Blodgett, J., held, on clear evidence, that the name "Yankee" was a valid trade-mark for soap.

§ 126. In the endeavor to ascertain the true nature of a trade-mark, we will examine the case of *The Leather Cloth Co.* v. *The American Leather Cloth Co.*[2] 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 form 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 anything 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. 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

[1] Williams *v.* Adams, 8 Biss. 452.
[2] 11 Jur. (n. s.) 513.

this language: "The plaintiff's 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 anything 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 alle-

gations 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 consummate 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 it be the exact representation of the signature which he intends to apply to an instrument in writing.[1]

§ 130. A trade-mark is nothing more nor less than one's commercial signature to his goods;[2] and the mark and the

[1] "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract." Ld. Ch. Westbury, in Hall *v.* Barrows, 4 De G., J. & S. 150; 83 L. J. Ch. 204; 10 Jur. (N. S.) 55; 9 L. T. (N. S.) 561; 12 W. R. 322; 3 N. R. 259. By same, Leather Cloth Co. *v.* Am. Leather Cloth Co., 11 Jur. (N. S.) 518. See also The Dixon Crucible Co. *v.* Guggenheim, and Candee, Swan, & Co. *v.* Deere & Co., *ubi supra*. All courts agree in this doctrine.

[2] The court, in Leidersdorf *v.* Flint, 8 Biss. 327, borrowed this phrase.

goods bear the same relation to each other 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 everything 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.[1] 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.[2]

§ 132. This question may be asked: If labels, for instance, 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 be proved 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

[1] Since this section was first published, events have furnished many demonstrations of the necessity for strict definitions. Uncertainty in this respect may thwart all attempts to gain protection. Nearly all the principal nations now require registration as an indispensable prerequisite to judicial redress; and registration is applicable only to technical trade-marks. If, by inadvertence or error of judgment, matter that is insufficient in law be admitted to registration, courts will set the registration aside.

[2] See "Physiology of Contracts," In Anthon's Law Student.

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. 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 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. — The words "Johnson's American Anodyne Liniment" shared the fate of the preceding case, and upon the same grounds. [6] 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, or American liniment; and, in of-

[1] Ex parte Crane & Byron. Not reported.

[2] Ex parte Hammerslaugh & Co. The New York Ct. of App. in Taylor *v.* Gillies *et al.*, 59 N. Y. (14 Sickels,) 331, cited with approbation the rejection of the words "Gold Medal." See case of Batty *v.* Hill, 1 H. & M. 264; 8 L. T. (N. S.) 791; 11 W. R. 745; 2 N. R. 265. "Prize Medal, 1862," not a valid mark.

[3] Ex parte C. S. Schenck; and Ex parte Atlantic White Lead Co. Not reported.

[4] Ex parte Valve Jar Co. Not reported.

[5] Ex parte Schmidt & Curtius. Not reported.

[6] Ex parte J. S. Johnson & Co., 2 Off. Gaz. 315.

fering 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. — 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.[1] — And still more hesitation was experienced when were filed the words "James Hennessy, Cognac,"[2] 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. — If one claim titles of firms, or names of manufactures, to which he shows no vested right, he will not be 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 these four applications.[3] 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.

§ 134. *Generic Names*, or names merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, are not valid trade-marks.[4] This is a general doctrine, but it has

[1] Ex parte Two cases, Fisk, Clark, & Flagg. Not reported.
[2] Ex parte James Hennessy & Co. Not reported.
[3] Ex parte Louis Strasburger & Co. Not reported.
[4] Canal Co. *v.* Clark, 13 Wall. 311.

its exceptions that will be noticed. Under the general rule, courts will refuse protection to claims for exclusive right of user in names of vendible commodities, that others must use in necessary description. As illustrative of this rule, the following cases may properly be cited. The first dates back to 1783, in the King's Bench, where the plaintiff manufactured and sold, in succession to his father, a medical preparation under the name of "Dr. Johnson's Yellow Ointment," and the defendant did the same thing. Lord Mansfield, C. J., nonsuited the plaintiff, on the ground that the name was property common to all.[1] So, also, "Schiedam Schnapps," [2] or "Aromatic Schiedam Schnapps";[3] "Club-House Gin";[4] "Paraffin Oil";[5] "Night-Blooming Cereus";[6] "Old London Dock Gin";[7] "Liebig's Extract of Meat";[8] "Desiccated Codfish";[9] "Ferro-phosphorated Elixir of Calisaya Bark";[10] "Lackawanna Coal";[11] "Razor-Steel";[12] "Cundurango Ointment, C. O.";[13] "Macassar Oil";[14] "Lieutenant James' Horse Blister";[15] "Golden Ointment";[16] "Parson's Purgative Pills, P. P. P.," and "Johnson's American Anodyne Liniment";[17] "True-fit Shirts," and "Cable-stitched Gloves";[18] "New Manny Harvester";[19] "American Sardines";[20] "Chlo-

[1] Singleton *v.* Bolton, 3 Doug. 293.

[2] Wolfe *v.* Goulard, 18 How. Pr. 64.

[3] Burke *v.* Cassin, 45 Cal. 467; 13 Am. R. 204; Wolfe *v.* Hart, 4 Vict. L. R. Eq. 125, 134.

[4] Corwin *v.* Daly, 7 Bos. 222.

[5] Young *v.* Macrae, 9 Jur. (N. S.) 322.

[6] Phalon *v.* Wright, 5 Phila. 464.

[7] Binninger *v.* Wattles, 28 How. Pr. 206.

[8] The Liebig's Extract of Meat Co. (Limited) *v.* Hanbury, 17 L. T. (N. S.) 208.

[9] Town *v.* Stetson, 5 Abb. Pr. (N. S.) 218; 3 Daly, 53; R. Cox, 514.

[10] Caswell *v.* Davis, 58 N. Y. 223; 17 Am. R. 233.

[11] Canal Co. *v.* Clark, *supra.*

[12] Re Roberts, Com. Dec., 1871, p. 100.

[13] Re Blakeslee & Co., Com. Dec., 1871, p. 284.

[14] Rowland *v.* Breidenbach, 1 Trade Marks, 261.

[15] James *v.* James, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. (N. S.) 568; 20 W. R. 434.

[16] Green *v.* Rooke, W. N. 1872, p. 40; L. J. Notes of Cases, 1872, p. 54.

[17] Re Johnson & Co., 2 Off. Gaz. 315.

[18] Re Fisk, Clark, & Flagg. Not reported.

[19] Re Graham, 2 Off. Gaz. 618.

[20] Re The American Sardine Co., 3 Off. Gaz. 495.

rodyne";[1] "Nourishing Stout";[2] "Tasteless";[3] "Für Familien Gebrauch" (For Family Use), and "Lawrence Feiner Familien Flannel" (Lawrence Fine Family Flannel);[4] "Croup Tincture";[5] "Cough Remedy";[6] "Crack-Proof";[7] "Cachemire Milano," in connection with the picture of the Cathedral of Milan, etc.;[8] "Highly Concentrated Compound Fluid Extract of Buchu";[9] "Egg Macaroni";[10] "Angostura Bitters";[11] "Allcock's Porous Plasters";[12] "Post-Office Directory";[13] "Rye and Rock";[14] "Sliced Animals," "Sliced Birds," and "Sliced Objects";[15] and "Straight-Cut," as applied to cigarettes.[16] In all these instances, collections of words and letters were adjudged to be merely ordinary language for ordinary purposes. These are names of things necessarily or commonly descriptive of them. To the foregoing citations may be added, sometimes, descriptive geographical names of the same class as "Lackawanna" above cited; as "Moline,"[17] "Durham,"[18] and "Glendon."[19]

§ 135. *A Trade-Mark may be valid, although suggestive of Quality.* — Brown, J., in *Burton* v. *Stratton*, said,[20] that if the primary object of the trade-mark be to indicate the origin or

[1] Browne *v.* Freeman, W. N. 1873, p. 178.

[2] Raggett *v.* Findlater, L. R. 17 Eq. 20; 43 L. J. Ch. 64; 29 L. T. (N. S.) 448; 22 W. R. 53.

[3] Re Dick & Co., 9 Off. Gaz. 538.

[4] Re Lawrence & Co., 10 Off. Gaz. 163.

[5] Re Roach, 10 Off. Gaz. 883.

[6] Gilman *v.* Hunnewell, 122 Mass. 139.

[7] Re The Goodyear Rubber Co., 11 Off. Gaz. 1062.

[8] Re Warburg & Co., 13 Off. Gaz. 44.

[9] Helmbold *v.* Helmbold Manufacturing Co., 53 How. Pr. 453.

[10] Re Dole Brothers, 12 Off. Gaz. 939.

[11] Siegert *v.* Findlater, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (N. S.) 349; 26 W. R. 459. See also § 104, *infra*.

[12] Re Brandreth, 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 281.

[13] Kelly *v.* Byles, 40 L. T. 623.

[14] Van Beil *v.* Prescott *et al.*, 82 N. Y. 630.

[15] Selchow *et al. v.* Baker, 93 N. Y. 59.

[16] Ginter *v.* Kinney *et al.*, 12 Fed. R. 782.

[17] Candee, Swan, & Deere *v.* Deere & Co., 54 Ill. 439; 5 Am. R. 125; 4 Am. L. T. 266; 10 Am. L. Reg. (N. S.) 694.

[18] Blackwell *v.* Wright, 73 N. C. 310.

[19] The Glendon Iron Co. *v.* Uhler, 75 Pa. St. 467; 15 Am. R. 599; 13 Am. L. Reg. (N. S.) 543; 6 Off. Gaz. 154.

[20] 12 Fed. R. 696.

ownership, the mere fact that the article has attained such a wide sale that the mark has also become indicative of quality is not of itself sufficient to debar the owner of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive right of his trade-mark just at the time when it had become most valuable to him, and stood most in need of protection. Rand, J., in *Sohl* v. *Geisendorf*,[1] held that the fact that the mark, to some extent, indicated quality, did not disentitle the plaintiffs. Bacon, V. C., in *Ransome* v. *Graham*,[2] held that, where a manufacturer placed on his goods a series of combinations of letters as trade-marks, each of which served to indicate to purchasers, (1.) that the goods were made by the person using the mark, and (2.) the quality of the goods, as compared with the goods respectively bearing the other marks in the series, the marks being exclusively used by the manufacturer, such series of letters were valid trade-marks, and might be registered, notwithstanding that they were indicative of the quality of the goods to which they were applied. — Section 66 of the English Trade-Marks Act of 1883 adopts and amplifies this decision. The Earl of Selborne, L. C, in a recent case,[3] said: "I do not at all mean to say that it is impossible that a word which is used to describe an article may also, if the proper means are taken at the proper time, be used as a trade-mark; but when any such double use takes place, it is most important to remember the difference between the use of a name as a trade-mark, and the use of it as a descriptive term. If the article itself is *publici juris*, and anybody may make it, the people who make it are at liberty — providing they do so honestly — to describe it by the descriptive term by which it is properly known in the trade, and no right of monopoly to that descriptive term can be acquired otherwise than by using it as a trade-mark." — The Supreme Court of Pennsylvania, in 1867,[4] held that the words "Dr. J. M. Lindsey's Improved

[1] 1 Wilson (Ind.) 60. [2] 51 L. J. Ch. 897; 47 L. T. 218.

[3] Re Leonard & Ellis's Trade-Mark, and Leonard & Ellis *v.* Wells, 26 Ch. D. 288.

[4] Fulton *v.* Sellers, 4 Brewst. 42; Cox's Manual, case 279.

Blood Searcher" constitute a legitimate trade-mark, although clearly indicative of the medical preparation that their assignor, Lindsey, had originated. So, under similar circumstances, the Supreme Court of Louisiana held "Bocker's Stomach Bitters" to be a valid trade-mark.[1] The words "Family Salve" were held to be a distinctive leading within Section 10 of the English act of 1875;[2] but it was doubted whether the scientific name of a tree, "Limetta," was so sufficiently a distinctive word as to be capable of registration as an *old* mark in respect of lime-juice.[3] In France, as great liberty prevails in this respect of words that are not essentially necessary to a description of articles to which they are applied. Thus the Tribunal of the Seine, in 1875, held that the fancy denomination "Veloutine" affixed to a mixture of powder of rice and bismuth, for the toilet, constituted a valid trade-mark, notwithstanding its suggestion of a velvety appearance of cheeks, on which it might be used.[4] The Court of Paris, in 1878, considered the words "Savon de Paris" sufficiently arbitrary for the purpose, although used for soap made in Paris.[5] In the Court of Appeal of Paris,[6] it appeared that A. was patentee of a process of neutralization and refining of oils. To distinguish his products obtained through the process, he registered, as a trade-mark, the words "Huiles neutres raffinées." Notwithstanding the fact that each of the words, taken separately, belongs to the common language, the union of them forms a denomination which, before the deposit (for registration) had been made by the plaintiff, had never been used in commerce. It specifies in a distinct manner his products under Article 1 of the French law of June 23, 1857. This case goes to an extreme length, even surpassing that wherein, in 1843, the Tribunal of Commerce of Paris, in advance of the statute, held that the words "Siccatif brillant" (brilliant dryer), although indicative of quality, were never-

[1] Funke *v.* Dreyfus, 34 La. Ann. 80; 44 Am. R. 413.
[2] Reinhardt *v.* Spalding, 49 L. J. Ch. 57; 28 W. R. 800.
[3] Rose *v.* Evans, 48 L. J. Ch. 618.
[4] Fay *v.* Durand, 20 Annales, 245.
[5] Michaud *et al. v.* Lemenu *et al.*, 23 Annales, 59.
[6] A.... *v.* Z..., Bulletin Officiel for 1884, p. 278.

theless not a necessary title of the article to which they were affixed, and were therefore a valid trade-mark.[1] The Court of Orleans, in 1882, held that the words "Papier hygiénique" and "Papier Goudron de Norwege," for cigarette-paper, constituted valid trade-marks, although more apt words could not be chosen to indicate that one was health-preserving paper, and the other Norway-tar paper.[2] In 1879, the Court of Cassation held that, in the phrase "Eau de toilette de Lubin," the name of Lubin, the originator, was a valid trade-mark.[3] This decision of the supreme court of France seems to settle the law for that country. It is safe to conclude, in the language of our own Patent Office, that a trade-mark which is merely inferentially or remotely descriptive is valid.[4]

§ 136. *The Line of Demarcation is not always easily drawn.* — A considerable amount of close reasoning upon stated facts is at times demanded, before a court can determine whether or not a name is necessarily descriptive, and therefore not entitled to protection. One cannot wonder that on that point mistakes are made. Infallibility does not belong to this subject. Let us take as illustrations of a contrariety of opinions the case of "Worcestershire," as applied to sauce. The Supreme Court of New York held that the name, being that of the local city of manufacture, could not be protected as a trade-mark.[5] The Supreme Court of Missouri seemed to hold otherwise, in a criminal case.[6] Later yet, Jessel, M. R., held that, because the name had long been used by sauce manufacturers other than the plaintiffs, it was not a trade-mark.[7] Finally, a United States Circuit Court decided it to be a generic term, holding that the former decree in England, not appealed from, was a complete bar to a suit in this country.[8] There is not much doubt that it was

[1] Re Raphauel, Huard, Marques de Fabrique, p. 15.
[2] Bardou & Son *v.* Lacroix, 29 Annales, 226.
[3] F. Prot & Co. *v.* Jules Avice *et al.*, 24 Annales, 345.
[4] Re Heyman, 18 Off. Gaz. 922.
[5] Lea *v.* Wolff, 15 Abb. Pr. 1; 46 How. Pr. 157; 1 Am. L. T. (N. S.) 400.
[6] Missouri *v.* Gibbs, 56 Mo. 133.
[7] Lea *v.* Millar, Seton, 4th ed., 242.
[8] Lea *et al.* *v.* Deakin, 11 Biss. 23.

originally a valid trade-mark; but by tacit abandonment it had become common property to describe a particular kind of sauce. "Yankee" is another term about which lawyers did not at first agree, although a court in the city of New York, in 1857, granted an injunction against its use as an element of an elaborate label.[1] In 1879, a United States Circuit Court, by Blodgett, J., in an able opinion, put all questions at rest.[2] He said that it is not a geographical term, nor a proper name, but a designation applied by the dwellers in one locality to the dwellers in another; that it is not the name of any certain locality, and the complainants had a right to adopt it as their trade-mark. Further, if it had, since the date of its adoption, by a more general use and definite application, come to designate any certain locality, which was not conceded, such subsequent use cannot affect the complainants' rights. This reasoning seems to be more just than that of the Supreme Court of Pennsylvania, which apparently held that a lawful trade-mark might be extinguished by the fact of incorporation of a borough of the same name.[3] "Vienna" was upheld as a trade-mark for bread, in 1881, in New York;[4] and, in 1883, the St. Louis Court of Appeal said that, "Vienna bread" being a common article, no person can acquire by use an exclusive right to sell it.[5] That virtually decided that it was not a trade-mark. "Bocker's Stomach Bitters," although the true name of the medicine, was recently, by the Supreme Court of Louisiana, held to be a valid trade-mark;[6] yet, about the same time, the Supreme Court of Georgia held that the word "Snowflake" could not be a trade-mark for crackers, for the reason that it is a mere descriptive term of the quality of flour.[7] It is difficult to understand the philosophy of this decision; for

[1] *Ante*, § 119 *et seq.*

[2] Williams *v.* Adams, 8 Biss. 452.

[3] The Glendon Iron Co. *v.* Uhler, 75 Pa. St. 467; 15 Am. R. 599; 18 Am. L. Reg. (N. S.) 543; 6 Off. Gaz. 154.

[4] Fleischmann *v.* Schluckmann, 62 How. 92; 8 L. Bull. 91; 20 Daily Reg., No. 55.

[5] Snodgrass *v.* Welle, 11 Mo. App. 590.

[6] Funke *v.* Dreyfus, 34 La. Ann. 80.

[7] Larrabee *v.* Lewis, 67 Ga. 561; 44 Am. R. 735.

surely it seems, to the common mind, that that word is not necessarily descriptive, and, if not, it is capable of being used as an arbitrary symbol. It is a general rule that a man has an absolute right to affix his own name to his merchandise;[1] yet the Supreme Court of Iowa lately forbade a man to place his own name, the same as that of his rival, on his manufacture, and held "Shaver Wagon" to be a valid trade-mark for his competitor's wagons.[2] The rule is against the right of exclusive use of a geographical name;[3] yet a court held the name of a place to be a valid trade-mark for the party that originally manufactured there, but who had removed, and against a new-comer who manufactured there. That was the law of the case until a superior court reversed it; but it ceased to be law when the court of last resort, the House of Lords, reversed the decision of the intermediate court, and established "Glenfield" as a legal trade-mark.[4] So a new name of a medicine was held by one court of New York to be an arbitrary symbol, because not philologically correct;[5] but the Court of Appeals reversed the case, and said that it was a necessary designation, and therefore not a technical trade-mark.[6] By this time, the reader will agree with the Federal Judge Brown, who said, in 1882, "There are few classes of cases in the whole domain of the law so difficult to reconcile as those wherein the validity of a trade-mark is discussed."[7]

§ 137. *The Style, or Peculiarity of Package, is not per se a Trade-Mark.* — But the package, case, or vessel, in which the commodity is put, if prepared in a peculiar or novel manner, though in itself not a trade-mark, may very properly be a very important part or adjunct of it.[8] The following alleged

[1] Meneely *v.* Meneely, 62 N. Y. 467. (See §§ 201–203, 393, as to use of one's own name.)

[2] Shaver *v.* Shaver, 54 Iowa, 208; 37 Am. R. 194.

[3] See § 182 *et seq.*, *infra*.

[4] Wotherspoon *v.* Currie, Malins. V. C., 22 L. T. (N. S.) 200; 18 W. R. 562. James, L. J., 42 L. J. Ch. 130; 23 L. T. (N. S.) 443; 18 W. R. 492. House of Lords., L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. (N. S.) 393.

[5] Caswell *v.* Davis, 4 Abb. Pr. (N. S.) 6; 35 How. Pr. 75; R. Cox, 429.

[6] 58 N. Y. 223; 17 Am. R. 233.

[7] Burton *v.* Stratton, *ante*, § 135.

[8] Cook *v* Starkweather, 13 Abb. Pr. (N. S.) 392.

trade-marks were not sustained as such by courts: a whiskey barrel of peculiar dimensions;[1] a small pail of ornamented tin for paper collars;[2] a package of a certain size, shape, and color, when defendant's label contained his own name in distinct characters;[3] a silver-foil paper with a blue band, as a wrapper for soap, the band being carried around the cake lengthwise.[4] — Yet, in many instances courts have granted injunctions against the use of such things; but it will be found on examination that there generally existed circumstances of fraudulent intent to encroach on a technical trade-mark, without actually imitating it; or, at least, there was evidence of unfair competition. Thus, in England, in 1831, where the plaintiff, in succession to his father, prepared calcined magnesia, and sold it in bottles of a peculiar shape, labelled "Henry's Calcined Magnesia, Manchester," and the defendant began to prepare magnesia, and to sell it in similar bottles, similarly labelled, (although it does not appear that a technical trade-mark was copied,) an injunction was granted against such acts.[5] — So, also, where it appeared that there was sufficient doubt about the exclusive right of the plaintiff to use the words "Genuine Yankee" in connection with soap, the court granted an injunction, because, having adopted 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, so arranged as to indicate their manufacture, the defendant had copied the form, appearance, color, style, and substantial characteristics in all respects, which distinguished the plaintiff's goods.[6] — In 1872, Lord Romilly, M. R., not only restrained defendants from publishing a book with a title somewhat resembling that of the complainant, but also from imitating the arrangement, binding, &c. in such a way as to deceive.[7] — In the same year, where

[1] Moorman *v.* Hoge, 2 Sawyer, 78; 4 Am. L. T. 217; 6 Am. L. Rev. 365.

[2] Harrington *v.* Libby, 12 Off. Gaz. 188.

[3] Frese *v.* Bachof, 13 Blatch. 234.

[4] Enoch Morgan's Sons *v.* Troxell, 89 N. Y. 292; 11 Abb. N. C. 86.

[5] Henry *v.* Price, 1 Leg. Obs. 364.

[6] Williams *v.* Johnson, 2 Bos. 1.

[7] Mack *v.* Petter, L. R. 14 Eq. 431; 41 L. J. Ch. 781; 2 W. R. 964.

the plaintiff, being a manufacturer of a preparation for dressing leather, sold his preparation in bottles enclosed in wrappers peculiarly colored and arranged, and the defendant sold a similar preparation in similar bottles, and gradually assimilated his wrappers more and more to those of the plaintiff, an injunction was granted.[1] — A complainant had always used on cigarettes the symbol "½" in red, and registered that as his trade-mark, and the defendant sold other cigarettes under labels essentially different. *Held*, that a limited injunction should be granted, restraining the use of that symbol in the identical form, style, size, and color, in which the complainant had used and registered it, and that notwithstanding that the defendants had used it on a label which was in other respects quite unlike that of the complainant; and yet the court expressed a doubt as to the validity of the symbol as a technical trade-mark.[2] — The complainants, a firm of tea-merchants, sold "Hamburg Tea" in a peculiar form of package, the tea being enclosed in long, cylindrical parcels with pink wrappers, and with crimson papers of directions, and yellow ones of warning, tied in, and having a white label with the firm name within a circle pasted across the ends of the string, and another white label with the same and the words "Hamburg Hopfensack, 6" embossed thereon pasted on the package. The defendant at first put up his tea in a precisely similar way, with the firm name and address; but after the commencement of the suit discontinued the use of the firm name and address, and substituted his own. Injunction and account ordered.[3] — In the Supreme Court of the United States, in 1877, it was held that, where the defendant had placed his goods in boxes sealed similarly to those of the complainant, and enclosed in wrappers of similar color and appearance, under a name having the same sound as complainant's, it was not necessary to prove infringement of a specific trade-mark, if the defendant had acted with a fraudulent intention.[4] —

[1] Brown *v.* Mercer, 37 N. Y. Superior Ct. 265.
[2] Kinney *v.* Allen, 1 Hughes, 106; 4 Am. L. T. (N. S.) 258.
[3] Frese *v.* Bachof, 13 Off. Gaz. 635.
[4] McLean *v.* Fleming, 96 U. S. 245; 13 Off. Gaz. 913.

Although an alleged trade-mark, the name "Aromatic Schiedam Schnapps," was held to be descriptive and incapable of appropriation, an injunction was granted, as the bottles and wrappers used by the defendant were intended and calculated to deceive; and on appeal to the full court the decree was affirmed. Per Stawell, C. J.: "We are to consider whether the infringement of the plaintiff's rights has been proved, not by taking particular isolated points, but by looking at the general resemblance of the packages, labels, bottles, and other points."[1] — A complainant alleged that, to individualize and identify his bluing, he adopted a peculiar and original form and style of package, consisting of the blue cylinder having a red top, by which they were known. He also set forth that his method of packing, including the size, shape, and color of his large packages, was original with him, and had never been varied. All the leading incidents and characteristics thereof had been imitated by the defendant. It was one element of defence that there was not any technical trade-mark in the case. The court said: "What we decide is, that whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labelled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant, by reason of their peculiar shape, color, and label, no person has the right to use the complainant's form of package, color, or label, or any imitation thereof, in such manner as to mislead purchasers."[2] — In a case in the Court of Appeals of Kentucky, in 1883,[3] both parties were manufacturers of ploughs. The defendants dismantled ploughs of the complainants' manufacture, and with great accuracy copied every important and ordinarily noticeable part of them. They branded them substantially in the same manner and style. They copied letters, numerals, and words of caution borne by the genuine ploughs, and stencilled them on the same

[1] Wolfe *v.* Hart, 4 Vict. L. R. Eq. 125, 134.

[2] Sawyer *v.* Horn, 4 Hughes, 239. — Same principle applied in Joseph Dixon Crucible Co. *v.* Benham, 4 Fed. R. 527.

[3] B. F. Avery & Sons *v.* Thos. Meikle & Co., *supra*, § 43.

corresponding places. They even varnished their ploughs as the genuine ploughs were varnished. They had had a consultation before they attempted the imitations above described, and determined, in the language of one of the members of their firm, "come what may, to take the bull by the horns." About their intention there was no doubt.[1] Yet, in the face of all these facts, the court below decided against the complainants. They appealed. The appellate court conceded the fact that the trade-mark proper had not been imitated in the slightest degree. The purpose of all the crafty cunning was to neutralize and in effect destroy its efficiency. Injunction and account for resulting profits. — A case in the Tribunal Civil of Bordeaux, in 1875,[2] is to the same effect as that of the Avery case. It was held that, where distinctive complex signs consist in the denomination, the style of package, special form and color, and particular mode of corkage, it is a fraudulent act to imitate the general aspect and principal distinctive signs, although the infringer should use a completely different denomination, the details being such as would escape the attention of the illiterate. In that case, the defendant had carefully avoided an imitation of the trade-mark proper, the fanciful name "La Benedictine"; but the court said that, in creating the receptacle for his liquor, styled by him "Saint Emilion," the author of the wrong had evidently before his eyes the genuine package. He was accordingly condemned to pay fifteen thousand francs as damages, and costs. Frequently, since the last-cited case, the French and other Continental courts, have considered the principle therein involved, and, where unfair competition has been apparent, the decisions have been parallel. In the Tribunal Civil of Lille, France, in 1883,[3] the following state of facts appeared. The plaintiff, a corset-maker, had adopted and registered a label bearing his trade-mark, consisting of the initials "N. T." and a hive surrounded by bees, and also the fanciful denomination "à la Ruche." The firm of Paul Dutoict & Co., of Brussels, Belgium, had

[1] See quotation, *ante*, § 43.

[2] Legrand ainé *v.* Louit frères, 26 Annales, 75.

[3] Notelle *v.* Dutoict, Marlin, & Co., and Paul Dutoict & Co., 27 Annales, 344.

also registered a label bearing a beehive of a yellow color on an azure ground, with the inscription, "P. D. Bruxelles, Paris." The firm of Dutoict, Martin, & Co. had obtained from P. D. & Co. a license to use the trade-mark in France on similar goods, and they had deposited it in the proper office, in their own name. The plaintiff attacked both firms, demanding that the registrations be annulled, with damages. The point in dispute was as to the defendants' right to use the emblem of a beehive, although it was dissimilar to that of the plaintiff. The plaintiff had attached so little importance to the details of the hive, that, in later registrations, he had the figure, form, and colors completely different from the first, with diverse accompanying attributes; but, despite these notable differences, it was held that the dominant and essential element remained always the same,—the emblem of the hive and the bees. The court said, in substance: Inasmuch as in the escutcheon forming the centre of the vignette of the defendants is found a hive surrounded by bees, it imports little that their escutcheon is accompanied with numerous accessories, for that which forms the object of the emblazonry, of which the surrounding attributes are but the supports, is the beehive of Notelle. That is so much so, that the corsets invested therewith are offered and sold as "Corsets à la Ruche." As to applications external to the products themselves, D., M., & Co. have employed the emblem of the hive on their letter-paper and their envelopes, and such use by a rival merchant of an emblem, the use of which properly belongs to the plaintiff, is of a nature to lead to confusion, so that the latter has a right to redress for the injury resulting to him. Notelle is the exclusive proprietor of the trade-mark, the emblem of the hive, and the denomination "à la Ruche" *together*, and *separate*, and *independent* of all *form*, *color*, and *accessories*. The mark of the defendants is an imitation. They are therefore enjoined from further use of the emblem of a hive in any form or way on products similar to those of the plaintiff, or on prospectuses or papers of correspondence.[1]

[1] See *ante*, §.89 *b*, "The mere Form of a Vendible Commodity."

§ 138. *Misconceptions as to the Nature of arbitrary Symbolism.* — A few examples on this point cannot fail to be instructive. An application for registration described the thing as "a label to be used for supplementary dials, by application or transfer of the same on the crystal glasses of watches, clocks, or other timepieces." The article was a disk of thin paper having the usual gradations, and figures indicating hours, painted on it, as ordinarily in watch-dials, so that when pasted to the inside of a watch-crystal the figures could be read from the outside in their positions.[1] *Rejected*, because, 1. not a label;[2] 2. because matter that enters into the structure of an article, so as to have a mechanical function, is a part of the article itself, it being a common right to use any mechanical device, unless the use is restricted by patent;[3] 3. the identical thing claimed as a mere label was already covered by a mechanical patent to another.[4] The Examiner also referred to two applications[5] for registration of dials for calendar-clocks. *Moorman* v. *Hoge*, in 1871,[6] is a leading case on this point. The plaintiffs, whiskey manufacturers, sold their product in a barrel of peculiar dimensions and form, which barrel they claimed as a trade-mark, irrespective of the brands on it. Sawyer, J., said that he had found no case where the use of a package of peculiar form and dimensions had been restrained. In *Harrington* v. *Libby*, in 1877,[7] the complainant, a manufacturer of paper collars, sold his goods in small pails of ornamented tin. Held, that the form of the pail could not constitute a trade-mark. In *White* v. *Schlecht*, in 1880,[8] the device of a drum to contain paper collars was used, having on the outside a representation of a drum, as indicating in the market the "drum collar." The decision,

[1] Re George J. Carney, case No. 17,033, filed March 20, 1884.

[2] Ex parte Moodie, Com. Dec., Sept. 22, 1884, adopting Worcester's definition of "label."

[3] Re Gordon, Com. Dec., 1877, p. 108.

[4] Trenor's Pat., No. 262,513, of Aug. 8, 1882.

[5] Re Daniel J. Gale, Nos. 15,212 and 15,213, one finally rejected Dec. 8, 1882, and the other June 20, 1883, and neither appealed.

[6] U. S. Cir. Ct. of Cal., 2 Sawyer, 78; 4 Am. L. T. 217; 6 Am. L. Rev. 865.

[7] U. S. Cir. Ct., S. D. of N. Y., 12 Off. Gaz. 188.

[8] 14 Phila. R. 88.

refusing an injunction against its use, was necessarily vague, for the reason that the bill was very indefinite; but at any rate, it does not controvert the doctrine of this section. The Patent Office rejected an application[1] where a barrel, constructed of light and dark staves alternately placed, for packages of flour, constituted the alleged mark; and also where the supposed mark consisted merely of straight lines intersecting one another, as a guide in cutting off any desired quantity of the article.[2] Many other examples of the same kind of error are referred to in other parts of this book.[3] One of the wildest vagaries was manifested as to the supposed validity of a red color for illuminating-oil.[4] The Commissioner indicated a doubt as to its possessing the essential nature of an arbitrary symbol, but concluded to let it be registered for what it was worth, for the simple reason that there was no appeal from his decision. A person having been indicted for imitating it, the court expressed a strong opinion against its being a trade mark, and the person was acquitted.[5]

§ 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.[6] 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 collar, &c. He who bought that label thereby obtained a license to sell that particu-

[1] Re Halliday Bros., 16 Off. Gaz. 500.

[2] Dousman & D. T. Co. *v.* Ruffner, 15 Off. Gaz. 559.

[3] See §§ 87 *et seq.*

[4] Re Teter, 17 MS. Com. Dec., p. 120.

[5] U. S. *v.* Rider, before Giles, J., published in Baltimore American, Oct. 8, 1878.

[6] C. C. Morgan, assignor to Union Paper Collar Co. of New York.

lar kind of goods, and at the same time he was furnished with 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 commodity. 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 al.*,[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

[1] 5 Annales, 248.

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.

§ 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] Act of March 3, 1881, sect. 5.

CHAPTER IV.

INDICATION OF ORIGIN OR OWNERSHIP.

§ 144, 145. A phrase not always understood.
§ 146, 147. "Congress Water" a sufficient indication.
§ 148. "Charter Oak" and "Balm of Thousand Flowers."
§ 149–151. Davol Mills, letter "K" case.
§ 152. Mint-marks denoting origin.
§ 153–155. Letters of alphabet, — as indicative of quality.
§ 156. Final decision in "A C A" case, — U. S. Supreme Court.
§ 157–160. Stokes *v.* Landgraff discussed ("Galen," "Lake," etc.).
§ 161. Terms in common use to designate trade, etc.
§ 162, 163. "XXX" case discussed.
§ 164, 165. Instances of common or generic terms rejected.
§ 166. "Serpent of Pharaoh" case.
§ 167–169. "Cable-Twist Tobacco" case.
§ 170. Colored wax, as seals for bottles.
§ 171–174. "Cable-Twist" case further discussed.
§ 175–177. Decided to be invalid, because descriptive.
§ 178–181. Man's name may lose all personality.
§ 182. Geographical names as trade-marks.
§ 183. "Brooklyn White-Lead" case.
§ 184, 185. "Anatolia," "Mount Carmel," and "Glenfield" cases.
§ 186. "Aramingo Mills" case.
§ 187. "Vallée d'Aure" and "Massy" cases.
§ 188. "Akron" case.
§ 189. "Lackawanna" case.
§ 190. "La Valentine" case.
§ 191. Examples of geographical names sustained.
§ 192, 193. When is a name merely geographical?
§ 194. "Angostura Bitters" case.

§ 144. *Indication of "Origin or Ownership."* — This is a phrase that has been the source of much perplexity, simply because not understood in its legal acceptation. In 1871, in the first case ever decided by the Supreme Court of the United States,[1] Mr. Justice Strong, delivering the opinion of the

[1] The Delaware & Hudson Canal Co. *v.* Clark, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279.

court, said, *inter alia*: "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." [1] But that learned jurist did not mean to intimate that the name of the producer must necessarily be an element of the mark, or even accompany it; for he qualified his language by further saying, that "a trade-mark must, either by itself or by association, point distinctively to the origin or ownership. . . . The trade-mark must, therefore, be distinctive in its original signification, pointing to the origin of the article; or it must become such by association." The foregoing was intended as the enunciation of a settled rule. A purchaser feels assured that he is getting a genuine article, when it bears the same device, emblem, or fanciful denomination that has been borne by genuine articles of the same kiud previously bought by him. The language of the Supreme Court

[1] This language is too limited in scope. A trade-mark may not only denote *origin* and *ownership*, but also indicate the *time of manufacture*, as in the case of the marks on fine porcelains of Sèvres. In 1745, a company of eight partners — under the trade-name of Charles Adam — obtained the privilege of manufacturing the said porcelains during a period of thirty years. Their establishment was located in the official building of the commission of Vincennes. In 1752, a decree of Council revoked the privilege, and decided that the pieces of the porcelains should be marked with a double L introduced in the form of a cipher. In the following year, King Louis XV. shared a third of the expenses. To give the mark a chronological value, a letter of the alphabet was added to it, which was changed every year. Changes went on until the L's were supplanted by C's under Charles X.; a different series, including LP in the form of a monogram under Louis Philippe; under the Republic of 1848 the letters RF (*République française*); and under Napoleon III. an N surmounted by the imperial crown between the words *Décoré à Sèvres*. Thus authenticity and chronology were conveniently combined. (See "Chefs-d'Œuvres of Industrial Arts," edited by W. Chaffers, F. S. A., pp. 156 *et seq.*) Another example of a similar nature may be cited. About the year 1760, a modeller named Kandler executed the principal groups that made Saxony famous, and which are only equalled at Sèvres and Chelsea. To authenticate his productions, the manufacturer began with a monogram of the king, — *Augustus Rex*. A sort of caduceus is the mark of the first period; the crossed swords succeeded it in 1742; and when the swords are accompanied with a star or a dot, they signify extremely delicate and choice workmanship executed about the year 1780. (Ibid., pp. 153, 154.) See Ex parte the King of Saxony, before Hall, V. C., in 1878 (1 Trade-Marks, 245). This was a case involving a right to protection of said marks, another person having applied for registration of marks resembling them.

of Connecticut, in 1868,[1] throws some light upon this point: "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, and that they have had that effect, 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." This is an opinion that mere numerals may sometimes indicate origin or ownership of the merchandise bearing them. But it was not necessary for the court to positively decide the exact point; for the numerals were associated with the name of the plaintiffs, and the form, color, and general arrangement of the labels; and, by virtue of that connection, said the court, formed an important part of the trade-mark itself. The subject matter of this section will hereinafter be further discussed. It is sufficient for the present to quote the language of the Court of Appeals of New York in 1880, in *Godillot* v. *Harris et al.*:[2] "It is not essential to property in a trade-mark that it should indicate any particular person as the maker of the article to which it is attached."

§ 145. The difficulty is this: What does distinctively indicate such origin or ownership? This question can be intelligibly 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 clearly to convey the indication; again, any simple device may by association with a particular person or place convey all the information required. What impre ion 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 recognizes a symbol instantly, 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

[1] Boardman *v.* The Meriden Britannia Co., 35 Conn. 402; R. Cox, 490.
[2] 81 N. Y. 263.

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, and was 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 artificial compounds, or products, originated by the science, 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

[1] 57 Barb. 526; 4 Am. L. T. R. 108; R. Cox, 624.

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 it has 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 spe-

cific 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*, that 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 as 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 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,[2] 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,[3] 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 Bri-*

[1] 35 Cal. 52.
[2] 44 Mo. 173.
[3] 4 Abb. Pr. 144; 13 How. Pr. 385.

tannia Co., in the Supreme Court of Connecticut, in 1868,[1] 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.[2] The facts are briefly these. More than thirty years before, the complainants had devised, and ever since used for certain goods, known as silesias, or bleached and dyed cotton twillings, a certain mark, consisting 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 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, afford no protection to the public against imposition

[1] 85 Conn. 402.

[2] 2 Brewster, 314; and Leg. Int., Jan. 1, 1869.

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] and "Champion," for flour.[5]

§ 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 anything 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!

[1] Filley *v.* Fassett, 44 Mo. 173; 8 Am. L. Reg. (N. S.) 402.

[2] Braham *v.* Bustard, 1 H. & M. 447; 9 L. T. (N. S.) 199; 11 W. R. 1061; 2 N. R. 572.

[3] Hine *v.* Lart, 10 Jur. 106; 7 L. T. 41.

[4] Burnett *v.* Phalon, 3 Keyes, 594.

[5] Atlantic Milling Co. *v.* Robinson *et al.*, 20 Fed. R. 217.

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 initial "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, "A C," Amoskeag Company, and "A," first quality. These letters were affixed to

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

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

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 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 any 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 were used merely 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, letters, 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: "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 *prima 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 should pass upon the disputed question.

§ 156. This matter came to the Patent Office in 1872, and, a *prima facie* right having been made out, (necessarily on *ex parte* testimony,) registration was allowed.[1] It finally came up in the Supreme Court of the United States, in 1879.[2] The court said: "It is clear from the history of the adoption of the letters 'A C A,' as narrated by the complainant, and the device within which they are used, that they were only designed to represent the highest quality of ticking which is manufactured by the complainant, and not its origin." The court further said, that as they were used to denote only quality, and that fact was so understood, they could be used

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

[2] Manufacturing Co. *v.* Trainer, 101 U. S. 51.

by others for a similar purpose, equally with the words "superior," or "superfine," or other words or letters having a like signification.

§ 157. In *Stokes* v. *Landgraff*, at a special term of the Supreme Court of New York, in 1853,[1] Strong, J., clearly laid 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," and "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 word "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 manu-

[1] 17 Barb 608; R. Cox, 137

factured 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 divert 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 that was, in part, his object. Some others 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 begin 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 that of 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 word "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 the name of which 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 of exclusive right, he would have rights

[1] 57 Barb. 526, and 4 Am. L. T. R. 168.
[2] "Akron" case, 49 Barb. 588.

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. 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

[1] 39 Cal. 501.

[2] Com. Dec. for 1870, 142.

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 mere 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

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

letter X, under the circumstances presented, constitute a lawful trade-mark? If used merely to indicate quality, it clearly did not. This 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? This 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 wayside opinion, not binding in other cases.

§ 164. There must be some word, 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.[1] 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.[2] 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. "Cundurango Ointment, C. O.,"[3] 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

[1] Re Hauthaway & Sons, Com. Dec. 1871, p. 97.
[2] Re Roberts, Ibid. 113.
[3] Re Blakeslee & Co., Ibid. 284.

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."[1] In the Supreme Court of California, in 1883, the following case arose.[2] The plaintiff below was a saloon-keeper in San Francisco, particularly engaged in the sale of beer, known as Philadelphia Beer. His shop sign consisted of a row of beer barrels, painted upon the sign and printed upon the labels so as to show the top head and outline of each barrel, with the letters "P. B.," indicating and standing for Philadelphia Beer, stamped or painted upon the head of each barrel, together with the words "Depot of the Celebrated" over, and the words "Philadelphia Lager Beer" below the row of barrels. The act of the defendant complained of was the erection by him, over his place of business, of a sign similar to that of the plaintiff, the chief difference being the insertion of the letters "F. B.," indicating and standing for "Fredericksburger Beer," in lieu of the letters "P. B.," and the insertion of the word "Fredericksburger" where the word "Philadelphia" appears on the sign and labels of the plaintiff. *Per Curiam* (substantially): The sign indicated that he sold beer; the letters and words, that he sold Philadelphia Beer. Anybody has the same right to sell. The sign and label of the plaintiff relate only to the description of the beverage dealt in by him, and therefore cannot be protected as a trade-mark.[3]

[1] Re Solon Palmer, Com. Dec., 1871, p. 289.

[2] Eggers (appellant) *v.* Hink (respondent), 63 Cal. 445.

[3] Sect. 3196 of the Political Code (of California) defines a trade-mark: "Every description of word, letter, device, emblem, stamp, imprint, brand,

§ 165. The courts of France have made a number of decisions upon this point. In the Court of Colmar, in 1857 (*Rian* v. *Bernheim* [1]), it was held that 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 al.*[2]), for the same reason rejected the words *benzine parfumée.* The Tribunal Civil of the Seine, in 1861 (*Mauprivez* v. *Buchet et al.*[3]), 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 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.[4] *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. *Kübler*, in the Court of Paris, in 1866,[5] illustrates this doctrine. Everybody knows, at least by name, the scientific toy called the "Serpent of Pharaoh." It is sold under the form

printed ticket, label, or wrapper, other than any name, word, or expression denoting any goods to be of some particular class or description."

[1] 4 Annales, 216. [2] Ibid., p. 400. [3] 7 Id. 335.
[4] 10 Id. 320. [5] 12 Id. 144.

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 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 Pharaoh," 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*, that the term "serpent"

[1] Clertan *et al. v.* Charpentier, 10 Annales, 340.

does not constitute a trade-mark, it being natural and necessary to describe the article.[1] The use of the word "serpent" by the defendant is not piracy. As the case stood, it was not necessary for the court to decide that the words "Serpent of Pharaoh," being a fanciful term, constitute a valid trade-mark. The arbitrary word "Pharaoh" had not been copied.[2]

§ 167. Since the foregoing was decided, the following case has arisen. A claim was made to the exclusive use of the words "Cable-Twist Tobacco," as a trade-mark for plug chewing-tobacco. The applicants [3] set forth that they had used said words for that purpose for about two years last past, i. e. from 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 these 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.[4] 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

[1] In Selchow *et al. v.* Baker *et al.*, in 1883, 93 N. Y. 59, the Court of Appeals of New York cited this section from the first edition, and applied its principles.

[2] In Barnett *v.* Leuchars, 13 L. T. (N. S.) 495; 14 W. R. 166, in England, in 1865, the name "Pharaoh's Serpents" was protected as a trade-mark.

[3] Harris, Beebe, & Co.

[4] As to the *form* of a product not being a trade-mark, see *ante*, § 89 *b*.

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 recognized 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" and "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 combination 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 said, that the color of the drum and wax was a mere mark or symbol 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 bot-

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

tles 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 to resemble a cable, and color it, 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 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

[1] 3 Am. L. T. R. 288, and 2 Brewst. 321.

Jamaica ginger; and his claim was allowed.[1] 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.)

§ 174. The counsel then suggested that the words "Snow-Flake Starch" would be a valid trade-mark, although applied to starch manufactured to resemble snowflakes.[2] (*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 snowflakes; which is hardly a supposable case. If a person have 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 manu-

[1] Frederick Brown, Certificate No. 715.

[2] In Larrabee *v.* Lewis, 67 Ga. 561; 44 Am. R. 735, in 1881, the Supreme Court of Georgia *held* that "Snowflake" was not a valid trade-mark for bread or crackers, because descriptive of whiteness, lightness, and purity.

factured 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 allowable, that would not be so. They would to that exten' control the use of words in common use.

§ 176. The applicants by their counsel made a motion before the Examiner for a rehearing. 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 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 response 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 rehearing has been shown. Case dismissed.

§ 178. *The Name of a Man may lose all Personality*, and become a mere indication of quality. This point was decided by the Court of Cassation of France, in the case of *Stubs* v. *Astier et al.*, in 1865.[2] 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

[1] No. 85,613, to William and David Rinehart.

[2] 11 Annales, 81.

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 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 manufacture 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 mer-

[1] 10 Annales, 197.

[2] 15 Id. 90.

chants from using the name of his predecessor to designate 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 same purpose in any other. The rights

[1] 3 Doug. 293.

of their owners might be in abeyance, but they could not be lost.

§ 182. *Geographical Names.* — Instances are not rare where these have been sustained as technical trade-marks. But in every case of the adoption of the name of a country, nation, region, or place, such name has been used in an arbitrary sense, and not adjectively; except where the owner of the mark was also the sole possessor of the place of origin, or had the monopoly of the vendible product, as, for example, of a mineral spring, or an established place of manufacture. Under circumstances of an exclusive right of sale, such a name cannot be said to be merely geographical. To be such, all or many others than the claimant, should have a right equal to his own to apply the name. A *merely* geographical name cannot be a trade-mark. Yet decisions are sometimes relied on to support a contrary doctrine; but if carefully scrutinized, it will be perceived that they are trade-mark matters in name only, and in reality belong to the domain of good-will. The distinction is important. The following citations illustrate the difference between cases depending for protection on principles of trade-mark law, and others depending on those appertaining to good-will. One of the latter-mentioned kind is *Newman* v. *Alvord*.[1] The name "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, New York. The defendants were engaged in the same line of business at Syracuse, New York. 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

[1] 49 Barb. 588; 35 How. Pr. 108; R. Cox, 404.

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 plaintiff's 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 intrenched 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 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[1] 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 wrong-doer who had attempted by fraudulent means to divert custom from its legiti-

[1] Delaware and Hudson Canal Co. *v.* Clark, 13 Wall. 311.

mate 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 one hundred and fifty 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 market 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*, that 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. — In the court of last resort, — the Commission of Appeals, — in delivering the affirmance of the foregoing, Earl, Commissioner, said, *inter alia*:[1] "The question is not before us, and it is not necessary for us to determine, whether any other owners of a portion of the same quarries could not manufacture cement, and label it 'Akron Cement.' The whole question to be determined is, whether the plaintiffs, who were the only persons engaged in manufacturing and selling the real 'Akron Cement,' which is known and has a reputation in market as such, can be protected in the use of the word 'Akron' against the defendants, who used it to defraud the plaintiffs, and deceive the public." This decision does not show that "Akron" was a trade-mark; but rather

[1] 51 N. Y. (6 Sickels) 189; 10 Am. R. 588.

that the case was one of unfair competition in business.—As an illustration of the Akron principle we have a decision of the Court of Cassation, of 1880.[1] Sixteen pieces of cloth had, in 1879, been sent from Aix-la-Chapelle to the defendant, a commission merchant in Paris. The cloth of the German manufacturer had embroidered on its ends the indication "Drap de Sedan" on some of the pieces of cloth, the words "Drap de France" on others, — all marked so as to cause belief that they were made in France. All the goods were confiscated.

§ 183. In *The Brooklyn White-Lead Co.* v. *Masury*,[2] 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*, that 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] Cunin-Gridaine and other manufacturers of Sedan *v.* Crocius, 25 Annales, 179. These cases came under Art. 423 of the Penal Code, against affixing to a manufacture a name other than that of fabrication.

[2] 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 licorice, does exist the moment the licorice 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 circumstance, 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 adopter of the word had never heard of the country bearing the name of his chosen word. The licorice was stamped with the name "Anatolia" by way of contradistinction from other kinds of licorice. It was not intended as a mere representation that the article was Anatolia licorice. 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 Civil 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, manufactured powdered starch, principally from East India sago, called "Glenfield Patent Double-Refined Powder Starch," commonly known as "Glenfield

[1] 10 Jur. (N. S.) 550.
[2] 8 Annales, 238.
[3] 22 L. T. (N. S.) 200; 18 W. R. 562.

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 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

[1] 42 L. J. Ch. 130; 23 L. T. (N. S.) 443; 18 W. R. 942.

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; for 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. — But, on appeal to the House of Lords,[1] an injunction was granted to restrain the defendant from using the word "Glenfield" in connection with his starch, notwithstanding that his own name had also been placed on his packets.

§ 186. In *Colladay* v. *Baird*,[2] 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 sizes and colors, 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.

§ 187. In the Tribunal Civil of Havre, in 1859 (*Levigoureux et al.* v. *Léon Lecompte & Co.*[3]), this matter came up. Both

[1] L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. (N. S.) 393.
[2] 4 Phila. 139.
[3] 5 Annales, 279.

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"; and that of the defendants was "Vallée d'Aure," and the initials, "L. L. et 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*[1]), 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*[2] 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 Delaware 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

[1] 5 Annales, 216.
[2] 49 Barb. 588; 35 How. Pr. 108; R. Cox, 404.

"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 all lawfully 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 boundaries, embracing the works of both parties; for they both use the same quarry. The name "La Valentine Cement" corresponds to the designations 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.

[1] 9 Annales, 328.

§ 191. As to the use of a geographical name as a trade-mark, Earl, Commissioner, in the "Akron" case,[1] expressed a settled rule. He said: "I can perceive no reason why it may not be the name of a place. Suppose one owns the only coal mine situated in a town, or near a city, and he names his coal after the town or city, and it becomes known as such in the market, why may not such name become his trade-mark? The same name could not be truly applied to coal obtained from any other place." — This is the principle of the "Congress Spring" case.[2] In that it was shown that the plaintiff had the sole title of the source of the medical waters, to the receptacles of which the name as a trade-mark was affixed. — So also of the "Bethesda" case.[3] The court held that a natural product, such as mineral water, which has become private property, and is vended to the public, may be the subject of a trade-mark consisting of the name. And so, in the "Hunyadi-Janos" case, in the Court of Cassation of France, in 1883.[4] *Held*, that, inasmuch as F. sold, under the name of a natural mineral-water of Hunyadi-Janos, an artificial water contained in bottles, he was guilty of infringement of a trade-mark. — The same principle is applicable to a place of manufacture, the exclusive right to which belongs to one who uses it as his trade-mark; as, "The Oscar Pepper Distillery";[5] and the "Taper Pulley Sleeve Works."[6] Plaintiffs being, by agreement with the owners of the Apollinaris Spring, in Germany, the exclusive importers into England of "Apollinaris Water," the name was repeatedly sustained as a trade-mark.[7] — In *Radde* v. *Norman*,[8] the doctrine that the name of a place of origin may become a technical trade-mark was fully recognized. The plaintiff had the exclusive

[1] *Supra*, §§ 182, 188.

[2] *Supra*, §§ 146, 147.

[3] Dunbar *v.* Glenn, 42 Wis. 118.

[4] Bulletin Officiel, No. 2, p. 26. The name of the spring was borrowed from that of a Hungarian hero, born at Hunyad in Transylvania in 1387.

[5] Pepper *v.* Labrot *et al.*, 8 Fed. R. 29.

[6] Gray *et al. v.* Taper-Sleeve Pulley Works, 16 Fed. R. 436.

[7] The Apollinaris Co. (Limited) *v.* Norrish, 33 L. T. (N. S.) 242; also Same *v.* Edwards, Seton, 4th ed. 237; also Same *v.* Moore, Cox's Man., case 675.

[8] L. R. 14 Eq. Cas. 348.

right to import over seas the article found at Leopoldshall, in the Duchy of Anhalt. — Cases of the same class as those of Anatolia and Mount Carmel [1] may be cited. In *Hirst* v. *Denham*,[2] the plaintiff being a manufacturer of woollen cloths, who had invented and adopted certain new fancy patterns and named them respectively "Turin," "Sefton," "Leopold," "Liverpool," was protected in the geographical names. — The name "Dublin" was admitted to registration as a trade-mark for soap, on the ground that, the place of manufacture not being in Ireland, but in this country, the word was not used in its ordinary descriptive geographical sense, but as an arbitrary fancy designation.[3] — So the word "German" was registered as a trade-mark for syrup, on the ground that, not being descriptive of a German product, it was a purely arbitrary term.[4] — That was also the ground of decision in regard to the word "Vienna."[5] The plaintiff was the first who applied the word to baked bread and other articles. His business was in the city of New York. — An almanac had for many years been published at Hagerstown, in the State of Maryland; yet the Court of Appeals sustained the name "Hagerstown Almanac" as a valid mark.[6] — Soap was manufactured at Paris; and that was held to be no reason why the name "Savon de Paris" should not be protected.[7] — There are other names that are, in one sense, geographical, but which have been sustained as denominations of fancy. "Hoosier" is such a one. Webster's Unabridged Dictionary defines the word to mean "a citizen of the State of Indiana." Yet the Supreme Court of that State held it to be a valid trade-mark for an article manufactured therein.[8] "Yankee" is a word applied to citizens of several States, in a rather indefinite way; and in a foreign country it is sometimes used to designate all the

[1] *Ante*, § 184.
[2] L. R. 14 Eq. 542; 41 L. J. Ch. 752; 27 L. T. (N. S.) 56.
[3] Re Cornwall & Co. 12 Off. Gaz. 312. [4] Re Green, 8 Id. 720.
[5] Fleischmann *v.* Schuckmann, 62 How. 92; 3 L. Bull. 91; 20 Daily Reg. No. 55.
[6] Robertson *v.* Berry, 50 Md. 591; 33 Am. R. 328.
[7] Michaud *et al. v.* Lemenu *et al.*, 23 Annales, 59.
[8] Julian *v.* The Hoosier Drill Co. *et al.*, 78 Ind. 408.

people of this country.[1] It was properly decided to be a technical trade-mark. — All the cases in this section proceeded on the ground, that, when such names are used in a sense that is not *necessarily* geographical, they may, by adoption, publicity, and recognition, become arbitrary symbols.

§ 192. *When is a name merely Geographical?* — This question is sometimes of very considerable importance, and it is one that demands nice discrimination. A perusal of the case of *Armistead* v. *Blackwell*[2] (in the chapter on Interferences) will show how judicial officers disagreed as to the signification of the word "Durham." A name may be deemed merely geographical, or a denomination of fancy, according to circumstances. When used as a common or necessary name of a country, region, or place, not in the exclusive possession of the claimant of the name as an arbitrary symbol, there is no difficulty, and it must be decided to be used in a merely geographical sense. Such an instance is the "Lackawanna" case.[3] This is the name of a region of country from which others besides the plaintiffs drew their supplies of coal. "Worcestershire," as applied to sauce, is governed by the same principle;[4] and so is the "Moline" case;[5] for that word is only indicative of the place of manufacture, and all the inhabitants of the town there manufacturing ploughs had a right to use the name. A serious aspect of the subject is when a name that was originally valid and exclusive has, without the owner's fault, been perverted and destroyed as a technical trade-mark. It is a grave question whether one can be so despoiled of property. — The case of the *Glendon Iron Co.* v. *Uhler et al.*, in the Supreme Court of Pennsylvania, in 1874,[6] was as follows. The plaintiff had

[1] Williams *v.* Adams, 8 Biss. 452. [2] *Infra*, §§ 653–660.

[3] Delaware and Hudson Canal Co. *v.* Clark, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 270.

[4] Lea *v.* Wolff, 13 Abb. Pr. (N. S.) 389; 15 Id. 1; 46 How. Pr. 157; 1 Am. L. T. (N. S.) 400. Lea *et al. v.* Deakin, 11 Biss., and Lea *v.* Millar, Seton on Decrees, 4th ed. 242, held the term to be merely generic.

[5] Candee, Swan, & Co. *v.* Deere & Co., 54 Ill. 439; 5 Am. R. 125; 4 Am. L. T. 206; 10 Am. L. Reg. (N. S.) 694.

[6] 75 Pa. St. 467; 15 Am. R. 599; 13 Am. L. Reg. (N. S.) 543; 6 Off. Gaz. 154; 1 Am. L. T. 147.

long stamped the word "Glendon" on iron, manufactured before the incorporation of the borough of that name. The defendants set up in business at the same place, and began to stamp the name "Glendon" on their iron. *Held*, that the name of a town or borough cannot be used as a trade-mark by one of its residents to the exclusion of other residents of such town or borough, even if the name were adopted prior to the act of incorporation. The adoption of the name as a geographical designation gives it a public character, which makes it the common property of the public for all legitimate purposes. Mercur, J., in delivering the opinion of the court, said, *inter alia:* "The appellees put upon their pigs the initials of their firm and the name of the town. That name was Glendon to the whole world. It cannot be that the previous appropriation by the appellants of the word, which now is the name of the town, prevents any other manufacturer of pig-iron within its limits from using the same word. If it be so now, it may continue through all coming time. The boundaries of the town may be enlarged; the borough may grow into a city; the manufactories of pig-iron may be multiplied; yet the word most expressive to indicate their locations must be denied to all but one." — Let us pause to consider and analyze. Of the correctness of the general proposition of law, there can be no cavil or doubt. Is it not, however, more than possible, that, by indefinite generalization, the learned judge has let error creep in unawares? Are his words chosen with so exquisite a precision as to leave no loophole for a sophist to creep through, to wrest and pervert the meaning? The judge said, that, by the act of incorporation, "The rights thereby given to the public become common to all citizens dwelling therein." Granted. All have a legitimate right to sell manufactures bearing their names and places of business. But that is not the point. The fallacy lies in stopping short of a full enunciation of the doctrine of equity. The first adopters of the name acquired the exclusive right to stamp it on their iron *in a peculiar manner.* Rivals have not a right to impress the mark in a manner so nearly like

it as to deceive purchasers. In the "Anatolia" case,[1] any importer of licorice had a perfect right to label his goods "Anatolia Licorice"; but he had not a right to stamp the word "Anatolia" on a stick of licorice in imitation of the stamp that gained currency for McAndrew's article. Probably Judge Mercur meant to say as much. We may reasonably infer that, from the fact found by the court. The defendants showed that they used the mark thus: "U. F. Glendon," to indicate the names of the partners. Probably the court regarded the differentiation as sufficient to avoid confusion. The latter part of the opinion runs thus: "We are unable to discover satisfactory proof that the appellees adopted their trade-mark with the design of imitating the one used by the appellants." This is the key to the true sense of the opinion.—It is obvious that the name "Raleigh" cannot be a trade-mark for tobacco, when tobacco is one of the staple products of the region of country in which the city of Raleigh is situated.[2] But the same name probably might be a valid mark for petroleum, or writing-paper, or some other article, the production or manufacture of which is no more associated with the place than with Sir Walter Raleigh. "French" cannot be a technical emblem for bronze paints, because deceptive.[3] In the Tribunal of Commerce of the Seine, in 1883,[4] the plaintiff claimed, as a trade-mark for biscuits, the words "Véritables Biscuits de Montbozon, Haute Saône." *Held*, that the name of a locality cannot be a valid mark.—The French Court of Cassation, in 1840,[5] held that every manufacturer of lime, who drew his material from one of the cantons of Doué had a right to sell it under the name of "Doué" hydraulic lime. The first adopter of the designation had no exclusive right.—In 1875, there were cross suits by two rival firms of distillers at Glasgow. One firm called their establishment "The Loch Katrine Distillery," and the other named their product "Loch Katrine Whis-

[1] *Supra*, § 184.
[2] Re Oliver, 18 Off. Gaz. 923.
[3] Re J. Marsching & Co., 15 Id. 204.
[4] Longchamp *v.* Veuve Potin *et al.*, 29 Annales, 157.
[5] Delaleu *v.* Grignon, Blanc, 732.

key." *Held*, that any one who used Loch Katrine water in the manufacture of his whiskey was at liberty to use the name.[1] Probably the foregoing cases answer the question at the head of this section.

§ 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 any other symbol could be. Thus the word "Marieland," although intended for a mark for merchandise manufactured in Maryland, is free from objection.[2] The change in the spelling, and slight difference 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";[3] or that the term "Kentucky Pioneer"[4] necessarily meant that it was made in Kentucky by the pioneer Daniel Boone; or that "Bay State" meant to imply Massachusetts.[5] 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.[6] 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.[7] 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

[1] Bulloch, Lade, & Co. *v.* Gray, 19 Journal of Jurisprudence, 218.
[2] Malcolm Crichton, No. 925.
[3] Malcolm Crichton, No. 877.
[4] Adams & Taylor, No. 602.
[5] Bay State Iron Co., No. 875.
[6] Walter & Fielding, No. 494.
[7] Biddle Hardware Co., No. 923.

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.*[1] It is not understood upon what principle this decision in the Scioto case could possibly be sustained. It may be that it never will 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 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.*[2]

§ 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 officinal 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 "cocktail" 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 first been 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.[3] —

[1] McConnell, Porter, & Co., No. 510. *Vide* Newman *v.* Alvord, *ubi supra.*

[2] The following recent authorities recognize the Akron principle: Wheeler *v.* Johnston, 3 L. R. (Ireland) Ch. D. 284; Lochgelly Iron & Coal Co. *v.* Lumphinnans Iron Co., 6 Sess. Cas., 4th Ser. 482; Dunnachie *v.* Young & Sons, 10 Id. 874.

[3] Re W. H. Knoepfel, Cert. No. 580.

Thus stood the matter on *ex parte* testimony two years, until 1874, when it became involved in a controversy in the Supreme Court of Trinidad. That case, however, turned on the general appearance of the wrapper bearing the name.[1] — In 1878 the same matter came up in the Chancery Division in England.[2] *Held*, by Fry, J., that no one was entitled to the exclusive use of the words "Angostura Bitters," since they had become the name of an unpatented article, which any one who could discover the secret receipt might make and call by its name, although it had hitherto been made by one firm only, because they alone knew the secret. That plainly decided the name "Angostura" to be merely descriptive, and not arbitrary. Any manufacturer of bitters at Angostura could lawfully so inform the public, — *provided* he should do it in a lawful manner: just as in the Glendon case any manufacturer of iron could truthfully stamp his merchandise in a way and form that could not mislead. The manner is the indication of fair dealing. Notwithstanding Judge Fry decided the name not to be exclusive property, he granted an injunction against the use of the word "Angostura," or the words "Angostura Bitters," in such a way as to be calculated to deceive.

[1] Siegert *v.* Ehlers, cited 7 Ch. D. 803; 38 L. T. (N. S.) 357.

[2] Siegert *v.* Findlater, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (N. S.) 349; 26 W. R. 459.

CHAPTER V.

EXAMPLES OF TRADE-MARKS.

§ 195. One's own name, — to what extent protected.
§ 196. What is merely a name?
§ 197. One's own name not an essential element.
§ 198. Allusive devices standing for names.
§ 199. Own name combined with words.
§ 200. Own name used fraudulently.
§ 201, 202. Name borrowed for purpose of fraud.
§ 203. Derivative from one's name, — when not protected.
§ 204. One's autograph a good trade-mark.
§ 205. One's name, — when common.
§ 206. One's mere name not a trade-mark.
§ 207–211. Fac-similes of autograph.
§ 212. Designation composed of simple initials.
§ 213–215. Pseudonyms.
§ 216–218. Fancy names of men.
§ 219. New words.
§ 220. Necessary name of product.
§ 220 *a*. "Singer," as designation for sewing-machine.
§ 220 *b*. Name tending to mislead, — "Trommer" case.
§ 221. Name of machine or product, — patent expired.
§ 222, 223. Word of warranty in foreign language.
§ 224. Fancy name protected.
§ 225–231. Numerals as marks.
§ 232. Numerals disguised.
§ 233. Conclusion, — mere numerals not a mark.
§ 234. Letters as marks.
§ 235. "A C A" case.
§ 236. Fancy names.
§ 237–239. "Cocoaine" case.
§ 240. Discrimination as to fancy names.
§ 241–244. "Balm of Thousand Flowers" case.
§ 245. "The Excelsior White Soft Soap" case.
§ 246–248. Mere descriptive names not valid marks.
§ 249. Descriptive names, — distinguished.
§ 250. Suggestive marks may be valid.
§ 251. "Chemical Paint" case discussed.
§ 252. Fancy name may become generic.
§ 253. Name of object of merchandise.
§ 254. Accompanying mark insufficient.

§ 255–259. A picture as a trade-mark.
§ 260. Trade-marks frequently borrowed from heraldry.
§ 261. National arms may sometimes be element in mark.
§ 262. Monograms and ciphers, as authenticating marks.
§ 263. Is color ever essential element?
§ 264. Disadvantage of reliance on color.
§ 265, 266. Color may be essential.
§ 267. Color, — a circumstance in infringement.
§ 268. Colored threads as trade-marks.
§ 269, 270. Form is implied by the term *Mark*.
§ 271, 272. "Payson's Indelible Ink" case.
§ 273–275. Examples, — words as trade-marks.
§ 276, 277. *Rejected*, — as indicative of quality.

§ 195. *One's own Name.* — To what extent will a person's name be protected as a trade-mark for himself? This question has its difficulty. The act of Congress of July 8, 1870, sect. 79,[1] prohibited the registration of a proposed trade-mark "which is merely the name of a person, firm, or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons." That meant only the name of the person, &c., applying for registration. The act of Congress of March 3, 1881, sect. 3,[2] uses the words "merely the name of the applicant." But the former act provided that that should "not prevent the registry of any lawful trade-mark rightfully used" at the time of the passage thereof. The act of August 5, 1882, contains substantially the same provision. The proviso opens the door to evidence that such name had previously become a "lawful trade-mark." It all depends on the full import of the words "merely" and "rightfully." We must be guided by judicial decisions. One case might be sustained and another not. Circumstances control the result.

§ 196. What is merely a name? An investigation that can enable this question to be intelligently answered should not be thought pedantic or far-fetched. It has been well settled that a middle name or an initial letter is not part of a person's name. The law knows of but one Christian name.[3] The addition of "senior," or "junior," is a mere matter of

[1] Rev. Stat., sects. 4937–4947.
[2] Supplement to Rev. Stat., vol. i. chap. 138.
[3] Co. Littleton, 3 *a*; 1 Lord Raymond, 562; 5 Johns. 84; 2 Cow. 463.

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 to one so designated 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 synonym 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; or 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 sire-name, 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]

[1] 7 Johns. 549; 11 Wend. 522; 1 Hill, 102.

[2] See Matter of Snook, 2 Hilton, 566. — In 1878, in England *v.* The New York Publishing Co., 8 Daly, 375, the court reaffirmed the principle of the Snook case, "nothing in the law prohibiting a man to take another name if he desire to do so, ... no consequence growing out of it, except so far as it might lead to the confounding of his own identity." So held also in Doe *v.* Yates, 4 Barn. & Ald. 544, where one changed his name by his voluntary act, in order to take an estate devised to him on that condition. — "There is no law to prevent a man assuming any name he likes." James, L. J., in Thorley's Cattle-Food Co. *v.* Massam, 42 L. T. R. (N. S.) 851; 14 Ch. D. 748.

[3] Trench, Study of Words.

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 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; and in the seventeenth century the English poet, Payne Fisher, turned his into *Paganus Piscator*. 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 Devices standing for 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 real names, they are not on that account objectionable.

§ 199. Vice-Chancellor Wood, in *Ainsworth* v. *Walmesley*, in 1865,[1] 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 Civil 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 mer-

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

[2] 10 Annales, 375.

chandise. *Held*, that a trade-mark has no object but that of distinguishing the products of manufacture of him who has adopted it; that the object of the law of 1857 is to guarantee 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 guarantee 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, began 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 did not depend upon the fact that the words mentioned con-

[1] 2 Daly, 212, and 36 How. Pr. 83; R. Cox, 434.

stituted 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 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

[1] 50 Barb. 236; R. Cox, 421.

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"; and 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 one another, had, by license from the inventor, acquired the right to make and vend his 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.

[1] 3 Barn. & Cres. 541; 5 D. & R. 202; 3 L. J. K. B. 46.
[2] 7 Beav. 84.

§ 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*, that 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. It is the 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.[2] The same may 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 general rule; but it has its exceptions in all countries, and even the act of Congress before cited[3] provides for exceptional cases.

§ 205. In *Ainsworth* v. *Walmesley*,[4] in 1865, Vice-Chancellor Wood ably discussed this question. He said that if Mr. Jones,

[1] 19 Pick. 214.

[2] By the use of a *paraphe*, such as is in vogue in France, Spain, and many other countries, a signature might easily be made so peculiar and distinctive as to arrest attention.

[3] *Ante*, § 195.

[4] 44 L. J. R. 252; L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. (N. S.) 205; 14 L. T. (N. S.) 220; 14 W. R. 363.

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, *bona 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 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 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 mere 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. That would be absurd.[1]

§ 207. *Fac-simile of Autograph.* — This is just as valid for

[1] Cited and approved in Meneely *v.* Mencely, 1 Hun (N. Y. Sup. Ct.), 663.

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, as 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 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 article 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 regis-

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

tration, 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 *Compère* v. *Bajou et al.*,[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 to 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 deal only in gloves called "Grenoble manufacture," 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 was 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

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

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 twenty-first 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 shall 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

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

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, had been in the habit of marking his products with his initials, "J. B.," separated by a lozenge, so that the 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 Schwartzerd, not admiring an uncouth cognomen, signifying black earth, changed it into the melliflu-ous Greek; and it has come floating down to us through three centuries as Melanchthon. 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

[1] 3 Annales, 125.

[2] Junius.

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 as 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."[1] 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 of the fruit of his toils. It was held by the Court of Paris, in *Tournachon* v. *Tournachon*,[2] that this feigned name was a valid trade-mark; and 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*,[3] 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 Curiam:* Graveiet took, many years ago, 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 competi-

[1] Pen-names may be divided into three classes: First, *pseudonyms*, as "George Eliot" (Mrs. Cross), "Georges Sand" (Madame Dudevant), "Christopher Crowfield" (Harriet Beecher Stowe), "Fernan Caballero" (Doña Felicia Arrom, the Spanish novelist), "Arthur Dudley" (Countess of Bury), "Howard Glyndon" (Laura C. R. Searing), "Peter Parley" (Samuel G. Goodrich), "Peter Plymley" (Sydney Smith), "Mark Twain" (Samuel L. Clemens), "Acton Bell," "Currer Bell," and "Ellis Bell" (three Brontė sisters), "Hosea Biglow" (James R. Lowell, for his political satires), "Boz" (Charles Dickens), "Sam Slick" (Judge Haliburton), "Jack Downing" (Seba Smith), "U. Donough Outis" (Richard Grant White). There are *anagrammatic pseudonyms*, as "Alcofribus Nasier" (François Rabelais, the French satirist), "Barry Cornwall, poet" (good though imperfect anagrammatic pseudonym of Bryan Waller Procter), "Benauly" (the trio, Benjamin, Austin, and Lyman Abbott, who once wrote in a sort of literary partnership). Second, *anonyms*, as "By a Layman," "L. E. L." (Letitia Elizabeth Landon), "A L O E" (a lady of England, Miss Charlotte Tucker). Third, *acrostics*, as "Talvi" (Therese Albertina Louise von Jakob)," E. D. E. N." (Emma D. E. Nevitte, Mrs. Southworth).

It was in the days of Cosmo de' Medici that a goldsmith of Florence, named Tomaso Bigordo, accepted as his definite title the nickname of "Ghirlandajo," — maker of garlands, — to which nickname he owed his subsequent success.

[2] 4 Annales, 83.

[3] 13 Annales, 303.

tion, Arnault, director of the Hippodrome, announced a spectacle in which should appear an acrobat to whom he gave the name of Blondin, and announced him 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.[1] 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 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."[2] 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*,[3] in the Supreme Court of Rhode Island, before all the 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 name of Washington, Greene, Perry, or any other hero, 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

[1] Jacob Seligman, No. 828. See Grow *v.* Seligman, 47 Mich. 607.
[2] Marryat's Pottery and Porcelain. London, 1857.
[3] 6 R. I. 434; R. Cox, 238.

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 al.* v. *Smith et al.*, 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 the plaintiff to the words "Royal Victoria."

§ 217. The applicant, at times, by an addition to his patronymic, or a variation thereof, makes a convenient and peculiar mark. Thus the terms "Mayoline,"[5] "Edgerline,"[6] and "Rosebaume,"[7] 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 un-

[1] 4 Abb. Pr. (N. S.) 410; 36 How. Pr. 14.

[2] 7 Annales, 414.

[3] Jewitt's Life of Josiah Wedgwood, p. 385.

[4] 13 Annales, 21.

[5] U. K. Mayo, No. 904.

[6] H. B. Edgerley, No. 610.

[7] J. Rose, No. 807.

meaning symbol, — then it may be entitled to recognition as the veritable mark of commerce. When we see "Dolly Varden"[1] upon fancy paper, we do not think of the charming daughter of the London locksmith, Gabriel Varden by name, as portrayed by Charles Dickens, but we associate the name Dolly Varden 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. 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 adopter 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.[2] So has the traditional "Young America"[3] been placed upon writing-ink for the use of the scions symbolized by that appellation. "Apollo"[4] indicates a certain species of gin; "Rip Van Winkle,"[5] a brand of whiskey; "Falstaff,"[6] "Gulliver,"[7] "Uncle Bob Lee,"[8] "Our Fritz,"[9] "Brown Dick,"[10] "Lone Jack,"[11] and "Phil Sheridan"[12] authenticate particular manufactures 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 on sale by him, may obtain such a right to that name as to entitle him to the sole use of it, as against any others who attempt to use it for the sale of a similar article. The Court of Appeals of New York said:[13] "Our conclusion is, that where a man has invented a new name, consisting either of a new word or a word in common use, which he has applied for the first time to his own

[1] Bergen & Bainbridge, No. 833.
[2] Walsh, Brooks, & Kellogg, No. 702.
[3] Adams & Fay, No. 912.
[4] Gill & Lootz, No. 531.
[5] A. W. Balch & Co., No. 601.
[6] David Hirsch, No. 23.
[7] David Hirsch, No. 24.
[8] Winfree & Lyon, No. 402.
[9] J. W. Carroll, No. 156.
[10] J. W. Carroll, No. 157.
[11] J. W. Carroll, No. 158.
[12] Smith, Crosby, & Co., No. 244.
[13] Selchow *et al. v.* Baker *et al.*, 93 N. Y. 59.

manufacture, or to an article manufactured for him, to distinguish it from those manufactured and sold by others, and the name thus adopted is not generic or descriptive of the article, its quality, ingredients, or characteristics, but is arbitrary, or fanciful, and is not used merely to denote grade or quality, he is entitled to be protected in the use of the name, notwithstanding that it has become so generally known that it has been adopted by the public as the ordinary appellation of the article." Of course the court did not mean to limit the use to an article of *manufacture*. The introducer of a word, or words, into the 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. Thus, the Greek word "Eureka" has been judicially recognized as possessing all the essential characteristics of a trade-mark.[1] — "Tod," in Arabic characters, was held to be a valid mark in England.[2] — The Latin "Ne Plus Ultra"[3] was held not to be a trade-mark, solely because proved to be common to the trade; and the Latin word "Excelsior" was held to be arbitrary, and therefore valid.[4] — The highest court in France (Cassation), in 1873,[5] held that even the translation into a foreign language of a term already *publici juris* in France should be upheld as a valid trade-mark. It was contended for the infringer, that the Spanish words "Agua divina" could not be regarded as constituting an arbitrary symbol, for the reason that they were only a translation of the French words "Eau divine," long before fallen into the public domain, and commonly used in trade. The court said that it was an exception to the general rule, as the foreign words had not before been usually employed, and had not, in any respect, fallen into the public domain. — In the Court of Paris, in 1874,[6] the foreign word "Paragon" was sustained

[1] Ford *v.* Foster, L. R. 17 Ch. App. 611; English Reports (Moak's notes), vol. iii. p. 538; also The Alleghany Fertilizer Co. *v.* Woodside, 1 Hughes, 115.

[2] Re Rotherham's trade-mark, 14 Ch. D. 585.

[3] Beard *v.* Turner, 13 L. T. (N. S.) 746.

[4] *Infra*, § 245.

[5] Coudray *v.* Monpelas, 10 Annales, 31.

[6] Fox *v.* Meurgey *et al.*, Ibid. 327.

as a trade-mark. — The Tribunal of Commerce of the Seine, in 1878,[1] in the analogous case of a shop sign, sustained a foreign name, "Bodega," which is only the Spanish for *boutique*, shop. We need not strain a point to inquire as to 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?

§ 220. *The Necessary Name of a Product.* — Such a name is not the subject of exclusive appropriation. This may be regarded as the settled law of commerce, everywhere. It is necessarily so. While it is true that one may coin and adopt a word intending it to serve as a trade-mark, and a means of attesting the genuineness of manufacture, he must beware of making it the indispensable designation of the same. Among the many illustrative examples, a few may here be cited, viz.: "Chlordine";[2] "Charbon de Paris";[3] "Linoleum";[4] "Charter Oak";[5] "Lucilene."[6] All these were made necessary descriptive names. But in opposition to the *necessary* designation, the *arbitrary* designation is that which springs from neither the nature nor kind of object designated, so that a product or establishment might be as well recognized under another name.[7] One of the oldest examples in France is that of "l'Encre de la petite vertu," in the Royal Court of Paris, in 1835.[8] The word *encre* is a necessary description; for it must be used readily to express the object, ink, and all may freely use that name. But the accompanying words are an accessory of fancy, which none but the first appropriator may employ. — A leading American case is that of *Caswell* v. *Davis*, in the Court of Appeals of New York.[9] The alleged trade-mark consisted of the name affixed by the plaintiffs to the medi-

[1] Lavery & Co. *v.* Fajardo, 24 Annales, 71.
[2] Browne *v.* Freeman, W. N. 1873, p. 178.
[3] Brousse, Perdonnet, & Co., 20 Annales, 91.
[4] Linoleum Manufacturing Co. *v.* Nairn, 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. (N. S.) 448; 26 W. R. 403; 1 Trade Marks, 291.
[5] *Ubi supra.*
[6] See § 252.
[7] Blanc sur Contrefaçon, 70.
[8] Larénaudière *v.* Perine-Guyot, Ibid.
[9] 58 N. Y. 223; 17 Am. R. 233.

cine, which was first compounded by them in 1861, — "Ferro-phosphorated Elixir of Calisaya Bark." 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 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 the court below.[1] 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 relationship. The court decided that the plaintiffs were entitled to the exclusive use of the word "Ferro-phosphorated," whether alone or in combination with other words. But the Court of

[1] 4 Abb. Pr. (N. S.) 6; 35 How. Pr. 76; R. Cox, 420.

Appeals held that the word was descriptive of the composition of the medicine, and reversed the decision appealed from. — In a United States Circuit Court,[1] Wallace, J., correctly said: "When a new article is made, a name must be given to it, and that name becomes by common acceptation the appropriate descriptive term by which it is known, and therefore becomes public property. If this were not so, any person could acquire the exclusive right to a formula by giving a name to the compound produced, not only when the compound has not been patented, but when it might not be the subject of a patent. All who have the right to manufacture and sell the preparation have the right to designate and sell it by the name by which alone it is known, provided care is observed to sell the preparation as the manufacture of the seller, and not as the preparation made by another. The same rule applies in the case of a natural product to which one has given a name, which name becomes designatory of the natural product, and may be generally used; and even so during the continuance of a patent, if a new means of getting at the natural product is discovered, which does not infringe the patent." — It will readily be understood that by the term *necessary* is meant that which is the true and descriptive name. In a case where a preparation made from infusorial earth for commercial purposes was called "Electro-Silicon," those words were held to have been coined for the purpose of creating and establishing a trade-mark; that they were not descriptive of the article, although it contains some silicon; that silicon is not, and from its nature cannot be, a commercial article, because it exists in such minute quantities, and is an elementary body closely allied to carbon and existing as a dark brown powder or steel-gray mass, according to circumstances, and is never found in nature in an uncombined state, but only exists as a component part of compounds resembling it in no respect, from which it has been separated so as to exist by itself only in a small quantity, and to furnish only specimens to cabinets.[2]

[1] Hostetter *et al. v.* Fries *et al.*, 17 Fed. R. 620.

[2] Electro-Silicon Co. *v.* Hazard, 29 Hun, 369.

§ 220 *a*. "*Singer*," *as a Designation for Sewing-Machines.* —Is this name merely generic, as applied to a class of machines, the patents on which have expired? To enable one to give a satisfactory answer to this question, it is necessary to examine the course of litigation as to the use of this name as a mere adjective. This has ably been done in a recent case in the Supreme Court of Ohio.[1] Although this is not strictly a trade-mark case, but rather belongs to the domain of good-will, it illustrates a principle applicable to trade-marks. The Singer Manufacturing Company, a corporation organized under the laws of the State of New Jersey, in 1880, brought an action, in the Superior Court of Cincinnati, under the code of the State of Ohio, for an injunction and an account. Plaintiff alleged that it was engaged in the manufacture and sale of sewing-machines, which machines were known by the name or designation "Singer," and that the defendant had violated its rights by selling machines of similar appearance under the name of "English Singer Sewing-Machines." From the pleadings and proofs, it appears that in 1850 letters patent were granted to one Howe, the inventor, (who transferred his rights to Isaac M. Singer, to whose rights the corporation plaintiff had succeeded,) for an improvement in sewing-machines. The name "Singer" was then given to the machine, and the machine introduced to the public, and afterwards, and through all subsequent changes, it was termed, and known to the public as, the "Singer Sewing-Machine." It was in this way that the machine was distinguished from other patented sewing-machines, identified and known by the name of the respective inventors and makers, as "Wheeler & Wilson," "Grover & Baker," "Florence," "Wilson," "Davis," etc. The public thereby became informed that any such designations meant machines for which patents had been granted, machines constructed upon the principles, and in the mechanical modes, and operating in the ways, described in the respective patents. The plaintiff contended that the word "Singer" was and had been

[1] The Singer Manufacturing Co. *v.* Brill, 41 Ohio St. See decision of the Superior Court of Cincinnati in this case, Cox's Manual, No. 672.

understood in the trade to signify machines of the manufacture of the plaintiff, and no others. The plaintiff was the proprietor of, or was interested in, several patents for improvements upon the machines manufactured and sold by it, each improvement being distinguished from all others, and a distinctive name given to it. The "Singer Family Machine" was the one sold by the defendant. The patents thereon had expired a long time before the acts complained of were done. It appeared that the name "Singer" had, by means of a brass plate or label, been affixed to all machines sold by the plaintiff, and its predecessors, said I. M. Singer and a New York corporation; but the word "Singer" had not been affixed to any machines sold by the defendant, but in all his cards, circulars, and newspaper advertisements he represents them to be "English Singer Sewing-Machines, manufactured by the Williams Manufacturing Company, Montreal, Canada." The Superior Court — Foraker, J. — properly treated the matter as one of trade-*name* and not as a trade-*mark* case. The judge regarded the advertisements, etc. of the defendant as likely to mislead the public, and gave judgment for the corporation plaintiff. The case was taken to the District Court, in 1881, but was not heard there, but reserved to the Supreme Court of the State, where, on June 3, 1884, the decision below was reversed, for the reason that, where a patented machine became known to the public by a distinctive name during the existence of the patent, any one, at the expiration of the patent, may make and vend the machine, and use such name; and no one, by incorporating such name into his trade-mark, can take away from the public the right of so using it. — The foregoing is one of several suits brought by the same corporation for alleged wrongful use of the name "Singer," claimed as its exclusive property. The Court of Session, in Scotland, in 1873,[1] regarded the use of the name (although the defendants placed their own names on their machines) as an unfair assumption, and granted an interdict. —In 1877, in England, Jessel, Master of the Rolls, and the

[1] The Singer Manufacturing Co. *v.* Kimball and Morton, 11 Ct. of Sess. Cas., 3d series, 207; 10 Scot. L. R. 173.

Court of Appeal, upon the plaintiff's evidence alone, held, that although where a trade-mark proper is imitated on goods, it is not necessary, to constitute an infringement, for actual fraud to be proved; yet where a trade-name (Singer) is used in respect of an article, but is not placed upon it, actual fraud must be proved to establish infringement. No actual fraud having been shown, an injunction was refused.[1] The plaintiff's evidence only was before the courts. It showed that the defendant, who manufactured sewing-machines on the principles of a variety of expired patents, used among others the patents formerly owned by the plaintiff and its predecessors in business, and described such machines as "Our Singer Machines," and placed on them his trade-mark, consisting of a brass plate representing St. George and the Dragon within the words "Newton, Wilson, & Co., Manufacturers, 144 High Holborn," arranged in a circle; and he alleged that the name "Singer" was indicative of machines made on the principles of construction which he asserted to run through all the plaintiff's patents, though they varied in minor particulars, and not of an article made by the plaintiff. *Held*, by the House of Lords,[2] that, the plaintiff's evidence only being before their lordships, they were not in a position to decide finally whether the name "Singer" or "Singer's" was really indicative of the plaintiff's manufacture, or of a principle of construction, or whether the defendant had acted in a way to deceive, and that therefore the case should be remitted to the court below for decision upon the whole of the evidence. But that action was fated to be fruitless, for Wilson, the defendant, ceased to be in a condition to further contest the matter. The plaintiff company then brought suit against the London agent of a Berlin firm.[3] Vice-Ch. Bacon decided in favor of the plaintiff; but the Court of Appeal reversed his decision.[4] The House of Lords finally

[1] 2 Ch. D. 434; 45 L. J. Ch. 491; 34 L. T. (N. S.) 858; 24 W. R. 1023. — Ct. of Appeal: 2 Ch. D. 448; 45 L. J. Ch. 490; 34 L. T. (N. S.) 863; 24 W. R. 1026.

[2] 3 App. Cas. 376; 47 L. J. Ch. 481; 38 L. T. (N. S.) 303; 26 W. R. 664.

[3] The Singer Manufacturing Co. *v.* Loog, 11 Ch. D. 656; 48 L. T. (N. S.) 3; Boston L. Rep. 1883, p. 533.

[4] 18 Ch. D. 365.

settled the question, on the fifth anniversary of its former decision, in the language of the Lord Chancellor holding that the phrase "Singer system" of sewing-machines, whether scientific or not, whether exact or loose, is used commonly by the sewing-machine trade to describe a fact, and that, while other manufacturers have no right to invade the reputation of the company as manufacturers, so neither has the company, now that its patents have expired, any right to claim a monopoly of a particular pattern of machinery, or the reputation acquired by it. The result is, that one who chooses to adopt the manufacture of machines having the same principle of working, and the same internal arrangement of parts, as those described in the Singer patents, is at perfect liberty to say that he manufactures them on the Singer system.[1] — Several suits on the same subject matter have been brought in Circuit Courts of the United States, with substantially the same result. In the Northern District of Illinois, in 1878,[2] Drummond, J., said, *inter alia*: "On a machine called 'The Singer Sewing-Machine' there were various patents. These patents have all expired, and nothing can therefore be claimed under them. Other persons cannot be prevented from manufacturing a machine like the Singer sewing-machine, and which may be called, to distinguish it from other machines, 'Singer's Sewing-Machine.' If a sewing-machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine. . . . I do not think, under the circumstances of this case, there can be a trade-mark for the name 'Singer Sewing-Machine.'" — In the Eastern District of Missouri, in 1881,[3] Treat, J., said: "If the patentees, or their

[1] 48 L. T. (N. S.) 3.

[2] Singer Manufacturing Co. *v.* Larsen, Chicago Leg. News, Nov. 6, 1880; 8 Biss. 151.

[3] Singer Manufacturing Co. *v.* Stanage, 6 Fed. R. 279. The same judge in 1884, in Goodyear Rubber Co. *v.* Day *et al.*, 22 Fed. R. 44, reasserted this doctrine.

assignees, could assert successfully an exclusive right to the name 'Singer,' as a trade-mark, they would practically extend the patents indefinitely. The peculiar machine which had become known to the public under that name during the life of the patents, was so known as a specified article of manufacture, and at the expiration of the patents would still be known on the market by that designation, irrespective of the name of the special manufacturer. No one has an exclusive right to the generic name. If one wished to acquire a trade-mark in connection therewith, he could do so, distinctively. The plaintiff accordingly adopted specific devices, including its own name, whereby its products could be distinguished. The defendant adopted a different device, with the name of his manufacturer 'Stewart,' and advertised the sale sometimes of the 'Stewart' machines, and sometimes of the 'Stewart-Singer' machines, attaching his name as 'late General Manager of the Singer Manufacturing Co.' . . . A review of the many cases cited leads to the following conclusions: — First. That when a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every person, at the expiration of the patent, has a right to manufacture and vend the same under the designation thereof by which it was known to the public. Second. That the original patentee, or his assignees, have no right to the exclusive use of said designation as a trade-mark. Their rights were under the patent, and expired with it. Third. If a corporation or person wished to establish a trade-mark or name, indicative of its own special manufacture of such a machine or product, the right must grow up, just as all other rights of the kind are established, by use and acquiescence. Thus, as every one, at the expiration of the patent, had a clear right to manufacture and vend what was known as the 'Singer' sewing-machine, the plaintiff could acquire no exclusive right to the name 'Singer,' but could, by proper trade-mark, appropriate to itself names or devices indicating its own manufacture of such machines."— The judge went on to say that the parties to the suit had each adopted a distinctive trade-mark, with different devices

and names, so that there was no probability that the machine made by one would be mistaken for the manufacture of the other; and that, inasmuch as th word "Singer" indicates a machine of peculiar mechanism, and every one has a right to make such a machine, the word "Singer" attached to such a machine is common property. He continued, that it is important to remark that the plaintiff is seeking, after the expiration of patents, to perpetuate a monopoly, under the guise of a trade-mark. He further remarked, that the propositions involved have undergone much judicial investigation in Transatlantic and Cisatlantic courts, and all the cases would show, if properly analyzed, that the general rule is the same as above laid down. — In 1882, in the Circuit Court of the United States for the Western District of Tennessee,[1] the same matter was considered, and a preliminary injunction denied. Hammond, J., fully concurred in the conclusions of the Stanage case, and said: "It is a part of the history of our inventions, known to the courts as well as others, that the names of inventors are used to distinguish their inventions, and there have been 'Howe,' 'Singer,' 'Grover & Baker,' 'Wheeler & Wilson,' &c., to indicate the different kinds of patented sewing-machines."

§ 220 *b*. The propriety of using a man's name as a trade-mark, when it might tend to mislead, was considered in the Supreme Court Commission of the State of Ohio, in 1884.[2] The defendants in error had claimed the name "Trommer" as one of the essential elements of a trade-mark upon bottles of malt-extract. The facts, as they appeared in the bill of exceptions, were as follows. The article sold by the defendants in error was made by one Gessner, and in accordance with a formula prepared by him. Many years before that time, Dr. Felix von Niemeyer, a German physician of some note, published a "Text-Book of Practical Medicine," the third American edition of which was printed in 1870. The book was a standard work, and became authority with physicians and students of medicine. In that book Dr. Niemeyer

[1] Singer Manufacturing Co. *v.* Riley *et al.*, 11 Fed. R. 706.
[2] Buckland *et al. v.* Rice *et al.*, 40 Ohio St. 526.

stated that in late years he had obtained very good effects from an extract of malt prepared by Trommer. He also in general terms described Trommer's malt-extract. Ziemssen, in his "Cyclopædia of the Practice of Medicine," a standard medical authority, also speaks of a malt-extract prepared from Trommer's receipt. Gessner did not know Trommer's receipt, and it is not claimed that the defendants in error prepared this malt-extract sold by them in accordance with Trommer's method, or that their malt-extract was like that of Trommer. When they put their extract upon the market, they adopted the word "Trommer" to be used as a trade-mark. The court said, *inter alia*: "What was their object in doing this? Why was the name of Gessner, the real author of the extract, concealed, and 'Trommer' put forward as the catchword? There could have been but one motive, and that was that the public should be led to believe that the defendants in error were making an extract of malt like that made by Trommer and mentioned by Niemeyer and Ziemssen. This was a deception, and to the extent that the District Court, by its order, protected them in the use of the word Trommer, it erred. There are, however, other distinctive features of the trade-marks, labels, and circulars of the defendants in error, which are not subject to the objection urged herein to the use of the word Trommer, which the courts below were asked to and did protect by their decrees in this case. Some of these devices the plaintiffs in error wrongfully made use of, and in rendering the judgment which the District Court should have rendered, we make our decree the same as that of the court below, except wherein it protects the defendants in the use of the word Trommer."[1]

[1] The author, as one of the counsel for the defendants in error, contended that it was an infringement, on the part of the plaintiffs in error, to use the word-symbol "Trommer," either directly or by colorable variations, in the nominative case or in the possessive; that the disguise assumed by them was based on the coincidence of "Trommer" with the surname of a man who then, or once, lived in Germany; and that the evidence of their unlawful intention was found in the similarity of the labels, circulars, wrappers, advertisements, bottles, and packages, the priority of adoption by the defendants in error having been beyond dispute. In a circular, the plaintiffs in error had said: "We were among the pioneer manufacturers of this inestimable remedy, having

§ 221. *The Name of a Machine, or Product, the Patent for which has expired.* — Such a name, indicating peculiar mechanism, cannot be protected as a trade-mark. James, V. C., in 1869, held that no injunction could be granted to restrain the use of the name "Wheeler & Wilson," that being merely indicative of a machine manufactured on certain principles, whether by the plaintiffs or others. He said that a man cannot prolong his monopoly by saying, "I have got a trade-mark in the name of a thing which was the subject of the patent."[1] — In the Patent Office, in 1873, an application was made for the registration as a trade-mark of the words "A. Richardson's Patent Union Leather-Splitting Machine."[2] It was refused on the ground that, the patent having expired, the continued use of the word "patent" was deceptive; and as to the remainder, on the ground that the name, having been applied to a patented article during the existence of the patent, had become descriptive of the article, and open to the use of the public on the expiration of the patent. — In 1875, in a case in a United States Circuit Court, the complainant, manufacturing the "Tucker Spring-Bed" under an expired patent, had registered as a trade-mark a picture of the bed, the monogram "T. M. Co.," and the name "Tucker Spring-Bed."[3] The defendant manufactured a similar bed, and used a label containing a picture of it, and the identical name. Blodgett, J., refused an injunction, on the ground that the right to use the name and represent the bed had become common property on the expiration of the patent. — In the Court of Appeal in England, in 1877, it appeared that the

been connected with the Trommer Extract of Malt Co. of this city from its infancy." Under oath they had said that the only "Trommer's method" known to them was that which was originated and operated by the defendants in error. While all the plaintiffs and defendants in error were copartners, they had under oath registered the name "Trommer" as one of the essential features of their trade-mark; therefore, they were by their own act estopped. In short, it was argued that, whether a technical trade-mark or not, the fancy name "Trommer" as an affix to malt-extract was entitled to protection. The courts below concurred in this opinion.

[1] The Wheeler & Wilson Manufacturing Co. *v.* Shakespear, 39 L. J. Ch. 36.

[2] Re Richardson, 3 Off. Gaz. 120.

[3] The Tucker Manufacturing Co. *v.* Boyington, 9 Off. Gaz. 455.

plaintiff, G. Cheavin, manufactured. filters on a principle patented by his father, S. Cheavin, in 1862, (but the patent for which lapsed in 1865,) and placed on his filters a tablet with the words, "G. Cheavin's Improved Patent Gold Medal Self-Cleaning Rapid Water Filter, Boston, England," beneath a medallion with the royal arms and the words "By Her Majesty's Royal Letters Patent." The defendants manufactured filters on the principle of the same patent, and placed on them a tablet with the words "S. Cheavin's Patent Prize Medal Self-Cleaning Rapid Water Filter, Improved and Manufactured by Walker, Brightman, & Co., Boston, England." Held by the Court of Appeal, (1.) that the alleged trade-mark was a mere inscription, and not a trade-mark; and (2.) that the defendants had merely stated the principle on which the filter was manufactured by them. *Per Curiam*, James, L. J.: "It is impossible to allow a man to prolong his monopoly by trying to turn a description of the article into a trade-mark. Whatever is mere description is open to all the world."[1] In 1877, the assignees of certain patents for screw-neck bottles and jars, granted to J. L. Mason, applied for registration in the United States Patent Office, of the name "Mason" as an alleged trade-mark in use by them for many years. The application was refused, inasmuch as it was the name of the inventor, and although the applicants had the sole right to make the articles, and therefore to designate them by that name, on expiration of the patents all makers would be entitled to describe them by the appropriate descriptive name.[2] — In 1879, in *Filley* v. *Child*, the evidence satisfactorily showed that the complainant, Giles F. Filley, during the entire duration of his patent, — twenty-one years, including the term of extension, — knew of and acquiesced in the manufacture and sale by M. L. Filley, and those under whom he claimed, of cooking-stoves containing the patented improvements, with the name "Charter Oak" upon them. M. L. Filley made the stoves complained of in the suit. He had built up a business through the acquiescence of the complainant,

[1] Cheavin *v.* Walker, 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. (N. S.) 988.
[2] Re Consolidated Fruit Jar Co., 14 Off. Gaz. 269.

and, as the court said, had the right to make stoves containing such improvements, and therefore could not be prevented from calling them by their proper name, "Charter Oak," so long as he did not represent them as being made by G. F. Filley, or induce others to believe that they were made by him.[1] — In 1883, in England, the question was as to the vitality of the term "Home-washer" as a trade-mark on a machine, the patent for which had expired. Pearson, J., said, *inter alia*, that the "Home-washer" no doubt during the existence of the patent described the machine which was made under the patent. He cited with approbation the decision in the "Linoleum" case,[2] and concurred with Lord Justice Fry that it was impossible for the court so to construe the Trade-Mark Act as to do away with what has been the law of the land, from the time of King James downward, as to the expiration of the monopoly with the ending of the patent.[3] — In *Re J. B. Palmer's Trade-Mark*, in 1882, Chitty, J., said that he considered it plain that a man can have a patent for a new manufacture, and at the same time have a trade-mark in the name used to designate the goods, though they are made under the patent. Therefore he argued that the words "Braided Fixed Stars," for matches, were not merely descriptive, as in the "Linoleum" case, but might have been valid as a trade-mark before the Trade Marks Act of 1876 (which excludes mere words, subsequently adopted, from the category of technical trade-marks); but the plaintiff had not so used them, and therefore had lost his claim to them. It was held, on appeal, that the words were only properly descriptive of the patented article. Bagallay, L. J., said that he understood the words "Fixed Stars" to mean cigar-lights, and the word "Braided" to indicate their having been prepared in a particular way. They were manufactured under a patent which was for the purpose of braiding the stems of cigar-lights, i. e. passing round them by means of an ordinary braiding-machine a net-

[1] 16 Blatch. 376.

[2] Linoleum Manufacturing Co. *v.* Nairn, 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. (N. S.) 448; 26 W. R. 403.

[3] Re Ralph's Trade-Mark, and Ralph *v.* Taylor, 25 Ch. D. 194.

work of fine wire. It was therefore to be seen at once that the words were used to describe articles manufactured under the patent. Cotton, L. J., concurred with him. The words had been used during the existence of a patent, and fairly described the article patented. He said that they did not point to claimants, independently of its being a patented article. If used by others during the existence of the patent, it would have been a false representation. "In one sense, therefore, the name of the article might be called a trade-mark." Lindley, L. J., said that it was plain to demonstration, on the evidence, that the expression meant a patented article which was indeed made by the plaintiffs, but that it was not intended to denote them as distinct from other manufacturers; and the case was therefore brought within the authority of the "Linoleum" case. He said, further, that he did not mean that the manufacturer of a patented article cannot have a trade-mark not descriptive of the patented article, so as to be entitled to the exclusive use of the mark after the patent has expired; for instance, if he impressed a griffin, or some other device; but if his only mark be a word or set of words descriptive of the patented article, it appears to be impossible to make out that that mark denotes him as the maker, as distinguished from other makers.[1] — European Continental courts have made several interesting decisions. In the Tribunal of Commerce of the Seine, in 1872, the manufacturer of a sort of charcoal (called by him "Charbon Agglomerée") had patented the product, and the patent had expired; but it was held that, nevertheless, he retained as his trade-mark the exclusive right to the special denomination under which he had delivered it to commerce, for the reason that that name was not a necessary appellation, and had become in fact a veritable mark for his product.[2] Plaintiff's article from the beginning of the trade therein had been sold under the name of "Charbon de Paris." For that very reason, the Court of Cassation, in 1875, reversed the decision as follows: The fabricant who has given to the product of his ingenuity a new and fanciful denomination, as "Charbon de

[1] 24 Ch. D. 504.

[2] Brousse *v.* Pernolet & Co., 18 Annales, 248.

Paris," cannot claim exclusive right to it when he has thus let it fall into the public domain; and especially so when, by long usage, and without opposition on his part, it has become the general designation of that kind of product.[1] But the Court of Paris, in 1874, held that, even if the product to which the name of fancy had been applied should have originally been the object of a patent, if, independent of the patent, it was not the necessary designation of the product, it was a valid trade-mark.[2] — In the Court of Brussels, in 1876, it appeared in evidence that, in 1809, Claude Bully had patented preliminarily a vinegar that he called *aromatique et antiméphitique*, and in 1814 he obtained for his invention a complete patent. After his decease, his son and successor very largely extended the manufacture and sale of the product, to which he gave his proper name of *Jean Vincent Bully*. It obtained a great reputation, which was enjoyed by the plaintiffs, who acquired the establishment in 1833. On appeal, it was held that, when a patented product is known in commerce under the name of the inventor, the expiration of the patent which causes the article to become public property causes the name of the inventor also to fall into the public domain. It is as much so when, instead of indicating the prænomens of the original inventor, those of his son and successor may have been employed, if it be established that under the surname and first name of the latter the product is known to the public. This decision of the Belgian court seems to be quite correct in principle, and its philosophy does not conflict with a decision of the Court of Agen, of the previous year, in *A. and M. Landon* v. *Pons*.[3] The French court said that Claude Bully never manifested an intention to bind his name by an indissoluble tie to the product of his invention; that he did not cede to any person the right to attach it thereto; that, besides, it could not become the essential element of all aromatic and antimephitic vinegar, even if manufactured after the name had become common by expiration of the patent; and that the name had not been alienated by Claude, but

[1] 22 Annales, 91.

[2] Fox *v.* Meurgey *et al.*, 19 Annales, 327.

[3] 23 Annales, 234.

remained the exclusive property of his son and heir. The Court of Cassation affirmed this decision, but rested it on the terms of the law of July 28, 1824, wherein it is forbidden to affix on manufactured articles the name of a manufacturer other than that of him who was the first inventor; and that although the thing patented with the expiration of the patent fell into the public domain, it was not so with his patronymic. The learned reporters say, what is unquestionably so, that this is the settled law of France.[1] — But observe the following decision in the same court of last resort on the very next day. The Tribunal of the Seine, having decided in favor of the plaintiff, and the Court of Paris having reversed the decision, the case was appealed to the Court of Cassation, which spake thus: "Although in principle the patronymic name of an inventor remains his exclusive property until the expiration of his patent, and all other manufacturers are prohibited from using it until then, yet it is always quite otherwise in a case where, *by long usage or in consequence of consent*, whether express or tacit, of the inventor, his name has become the only designation usually applied to the product. . . . It is especially so of medicines fallen into the public domain of pharmacy, and every pharmacist has the right to announce and sell under its designation which has become usual, at the charge of taking necessary precautions not to lead the public into error as to the origin of the product."[2] The Court of Cassation reasserted the same doctrine, in 1881, in almost the same language, viz.: "The name with the patent only falls into the public domain when the name has become, either by long notoriety, or by consent of the inventor, the necessary designation of the product."[3]

§ 222. Many authors, judges, and lawyers have cited *Gout* v. *Aleploglu*,[4] 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

[1] 23 Annales, 235.
[2] Torchon *v.* Pauliac, Id. 243.
[3] Landon *v.* Leroux, 27 Annales, 183.
[4] 6 Beav. 69.

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 word "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.

§ 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 Gout" 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 Aleploglu 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 (*Abadie & 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 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 Curiam:* 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

[1] 7 Annales, 95.

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. But the registry act did not create trade-marks, nor did it pretend to. It protects only valid marks. If it has no legal force at common law, the alleged mark has not attained legality by the fact of registration. Even long user and notoriety cannot cure the inherent lack of stamina. "*Quod ab initio non valet in tractu temporis non convalescit.*"[1] Any person may lawfully stamp on his goods any numerals that shall express the truth. But he could not so use them if another person, in the same line of business, had such numerals as his mark for merchandise. Mere numerals cannot be turned into arbitrary symbols. There must be collateral matters to invest them with such characteristics. There may be some such striking peculiarity of form, ornamentation, coloring, or combination, as to make them distinctive, and so take them out of the category of mere numerals. Why was it thought by many, that numerals

[1] Broom's Legal Maxims, [*132].

alone might become technical trade-marks? By reason of a judicial decision not fully understood. Here it is.

§ 226. *Gillott* v. *Esterbrook*,[1] 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 trade-mark. The facts in that case were substantially as follows. The plaintiff had been 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. These 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 the plaintiff did, 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

[1] 47 Barb. 455; R. Cox, 340.

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 acquiescence, 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 act *that decided 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. In 1872 this case was heard by the Commission of Appeal.[1] The judgment was affirmed, and justly so. The point is, whether it was decided that the said numerals constituted, by themselves, a technical trade-mark. It was not necessary to decide that exact point. There had been unfair competition in business. In rendering the decision, Chief Commissioner Lott said that the facts showed that the numerals "303" had been selected and used by the plaintiff as his trade-mark, to indicate, in connection with his name, the origin and ownership of the pens manufactured by him, and not to designate their quality merely. The case did not demand a precise definition.

§ 229. Since the time of *Gillott* v. *Esterbrook*, several decisions have been made that have a tendency to limit the use of such a perplexing symbol, while sustaining numerals according to circumstances. The difficulty in regard to the recognition of numerals is that they generally indicate size or quality. For this reason, nations of Continental Europe have generally excluded numerals from the list of technical trade-marks. It will be found that, when sustained, it is because they are combined with other symbols that are essential, or

[1] 48 N. Y. 374; 8 Am. R. 553.

cases have been determined on principles appertaining to the protection of good-will. *Unfair competition* is suppressed by the courts, irrespective of questions of technical trade-marks. — *Kinney* v. *Basch*, in 1877, is an instance,[1] the numerals being but a portion of a compound mark. — So, also, in *Carver* v. *Bowker*, in England, in the same year, in which numerals were combined with certain specially-colored stripes, and the defendant, who carried on a similar business, used similar combinations.[2] — In *India-Rubber Co.* v. *Rubber Comb, &c. Co.*, in 1879,[3] the numerals 2, 101, and 32 were said to be trade-marks. — In *Lawrence Manufacturing Co.* v. *Lowell Hosiery Mills*, in the Supreme Court of Massachusetts, in 1880,[4] the plaintiffs used on a certain grade of hosiery a certain device with the figures 523 under it. These goods were known and called for as "523's." The defendants afterwards used as a trade-mark a device somewhat resembling that of the plaintiffs, and the figures 523 printed in the same kind of type, and placed on the other parts of the device in the same relative position as the plaintiffs'. The case came under the statute of the Commonwealth,[5] which protects peculiar names, letters, marks, devices, and *figures*, used to distinguish articles of manufacture. The court said of the plaintiffs: "Their claim is, that the purpose of using those figures in connection with the other parts of their trade-mark was to aid the buyer in distinguishing their goods from similar goods made and sold by others." It was not pretended that the numerals *alone* were a technical trade-mark. The court cited *Boardman* v. *The Meriden Britannia Co.* (commented on in the next section) as authority,[6] and said: "The numbers in that case, however, were held, by virtue of their connection, to form an important part of the trade-mark itself." — In *Shaw Stocking Co.* v. *Mack et al.*, in 1882,[7] Coxe, J., said that, when

[1] N. Y. Supreme Ct., 16 Am. L. Reg. (N. S.) 596.

[2] Lancaster, Chanc., Little, V.-C., 1 Trade Marks, 252; Cox's Manual, case 581.

[3] 13 N. Y. Superior, 258.

[4] 129 Mass. 325; Cox's Manual, case 673; 37 Am. R. 362.

[5] Gen. Stat., c. 56, § 1.

[6] 35 Conn. 402; R. Cox, 490.

[7] 16 West. Jur. 560; 12 Fed. R. 707; 21 Blatch. 1.

courts have refused protection to alleged trade-marks so composed, it has been because, on the facts of each case, it was determined that they were intended solely to indicate quality.— In that same year, in *Humphrey's Specific Homœopathic Medicine Co.* v. *Wenz*,[1] Nixon, J., held that the numbers constitute a lawful trade-mark when they indicate origin or proprietorship, and are used in combination with words and other numerals. — In the Supreme Court of Kentucky, in 1883,[2] the defendant had imitated certain non-essentials, but in doing so had been guilty of unfair competition, and that was distinctly avowed to be the ground of the decision against the imitators. The learned Chief Justice Hargis said, on behalf of the court, that "Arabic numerals are to man, in conveying his thoughts, feelings, and the truth, what air, light, and water are to him in the enjoyment of his physical being. Neither can be taken from him. They are the common property of mankind. . . . And the appellants, having drawn from the common fountain, . . . cannot claim an exclusive right to them or their use."

§ 230. In *Boardman* v. *The Meriden Britannia Company*,[3] 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 petitioner relied upon them as the most prominent, valuable, 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 respondent ought not to be restrained from their use. Whether in any case numbers alone may be legiti-

[1] 14 Fed. R. 250.
[2] Avery & Sons *v.* Meikle & Co., Kent. L. R. & Jour., April, 1883.
[3] 35 Conn. 402; R. Cox, 400.

mately 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 intended 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 petitioner, 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 function, — that is, as 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] Anybody may so 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.

§ 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*,[2] 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

[1] Marryat's Pottery and Porcelain. London, 1857.
[2] 2 Brewster, 814, and Leg. Int., Jan. 1, 1869.

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.[1] 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.[2]

§ 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 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*.[3] 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 *prima facie* right to its exclusive use having been made out, it was registered.[4]

§ 236. *Fancy Names.* — The Court of Cassation, in 1864, in *Clertan et al.* v. *Charpentier*,[5] held that the denomination

[1] Dutcher Temple Co., Com. Dec., 1871, p 248.
[2] H. D. Smith & Co., No. 521.
[3] 2 Sand. (S. C.) 599.
[4] Amoskeag Manuf. Co., No. 713.
[5] 10 Annales, 340.

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 mode 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 Correctionnel of the Seine, in 1865, in *Nestor Michel* v. *Stremier*,[1] held that a designation of fancy as "Trappestine," as applied to liquor, was valid. The community of religious Trappists of the *Abbey de la Grace-Dieu* made and sold a *liqueur* with the new name "Trappestine." The Tribunal of Commerce of Rouen, in 1867, in *Levy* v. *Bizet*,[2] 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*,[3] held the same of "Poudre Brésilienne" (Brazilian Powder). The Tribunal Correctionnel of the Seine, in 1858, in *Guerineau* v. *Mignon*,[4] held that the words "Café des Gourmets" was a good mark for packages of roasted coffee.

§ 237. *Burnett* v. *Phalon*,[5] in the Court of Appeals of New York, in 1867, is a leading case upon the subject of fancy names. In 1857, the plaintiffs began 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 began 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

[1] 11 Annales, 284.
[2] 14 Id. 105.
[3] 5 Id. 250.
[4] 4 Id. 157.
[5] 3 Keyes, 594. Same case below in 9 Bos. 192, and 5 Abb. Pr. (N. S.) 212.

a similar preparation of cocoa-nut oil. In 1858, the defendants began 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.

§ 238. Bosworth, C. 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, C. 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 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

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

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 not remain inactive."

§ 243. He very truthfully remarked, as a general principle, that the farther 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,

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

two judges of the same court, and both men of high integrity and of acknowledged ability as jurists, may differ in legal conclusions.

§ 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, but even in her hands

[1] Braham v. Bustard, 1 Hem. & M. 447; 11 W. R. 1031; 9 L. T. (N. S.) 199.

the Office declined to admit it to registration. When, by an 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 appear the name 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 fol-

[1] Mary A. Paullin, No. 857.
[2] See Congress & 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.

lowing 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 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

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

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

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 & la Veuve 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 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

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

[2] 10 Annales, 105.

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. — Wood, V. C., in 1864,[1] *held:* Although the word "Chlorodine" might originally have been protected as a fancy name, the complainant abandoned all claim to an exclusive right in it by dismissing the suit begun by him to restrain the use of it; and, in 1873, the Lords Justices[2] refused to restrain the defendant from using the words "True and Original Chlorodine," on the ground that they had become the name of the article.[3]

§ 253. *Name of Object of Merchandise.* — In *Denis & Mounier* v. *Vignier Dodart & Co.*,[4] which came before the Court of Bordeaux 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 device of a grape-leaf, in the middle of which was printed or stamped these words: "G. Denis. H. Mounier et Ce. Cognac, Eau-de-vie vieille," or "Eau-de-vie très-vieille," 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

[1] Browne *v.* Freeman, 12 W. R. 305; 4 N. R. 476.

[2] Same parties, W. N. 1873, 178.

[3] In 1871, Lord Romilly, M. R., granted an injunction against the use of the words "The Original Reading Sauce," saying that the word "original" meant that the article was made by the first inventor, the complainant. Cocks *v.* Chandler, L. R. 11 Eq. 446; 40 L. J. Ch. 575; 24 L. T. (N. S.) 379, 19 W. R. 593.

[4] 12 Annales, 430.

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 undoubtedly sound judgment was the result. *Per Curiam:* 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.[1] 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 eye, 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 is in its nature too indefinite and uncertain. One leaf may easily be mistaken for another, for the outlines of leaves of plants of a quite different species, or even genus,

[1] As to general type of objects, see *ante*, § 89 *d*.

bear some resemblance to one another. In addition, the leaf, if recognized as a grape-leaf, is 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 visor he could be 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 should recognize in it the *Planta genista*, which gave to the Plantagenets their name. 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 passing 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 *Folkinburg* 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 a four-legged stool, — some of the legs being yellow, some red, some

[1] 35 Cal. 52.

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 scalloped 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 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

[1] 2 Sand. Ch. R. 622; 2 Barb. Ch. R. 101; and 1 How. App. Cases, 558.
[2] 2 Abb. Pr. 318, and 4 E. D. Smith, 387.

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 decision 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 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 establish-

[1] 10 Jur. 1043.

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

ment belonging to the state, and one that before then had been used on scientific publications; and that it is allowable for any person to 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 one 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, and buildings 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 appropriat-

ing time-honored heraldic compositions, for each of these 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.[1]

§ 261. In the Tribunal Civil of the Seine, in 1870, in the case of *Christy* v. *Dande*,[2] 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. — In 1875, Monell, C. J., held that a copy of the arms of the city of Paris might be an essential element of a trade-mark.[3] But nearly all nations now refuse to include public arms as trade-marks. One of the latest instances is the regulation of the Empire of Japan, of June 7, 1884, which expressly forbids the use of national arms, either foreign or domestic, for such purpose.

§ 262. Monograms and ciphers have been used as proprietary or trade-marks for many centuries, especially by painters and engravers. Many great masters seldom or never signed

[1] *One's family crest may be an essential element of his trade-mark (Beard v. Turner, 13 L. T. (N. S.) 746; Hargreaves v. Smith, Cox's Man., case 338; Steinthal v. Samson, Id., case 546; Re Brook, 26 W. R. 791); except when it conflicts with another symbol previously adopted for the same purpose (Standish v. Whitwell, 14 W. R. 512; Hargreaves v. Smith, supra); and so may family arms on the same condition (Re Farina, 26 W. R. 261; Re Rosing, Ct. of App., 1 Trade Marks, 371).*

[2] Le Technologiste, No. 365, p. 286.

[3] Godillot v. Hazard, 49 How. Pr. 5.

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. 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, most 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, and purple.[2] When so used, one could not well be mistaken for the other; but this 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 that

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

a rival in trade has taken, there would not be much safety. The sign which was originally 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 of 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 adopter; but it is taken subject to some risks. If one select a red cross as his symbol, he is

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

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.[1]

§ 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,[2] 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 suit was brought. The court said that the *red* mark had an almost complete

[1] Sect. 67 of the British Trade Marks Act of 1883 contains a new and important provision in respect to *color*, no notice of which as an essential had been taken in the act of 1875–76. The defect therein was much discussed in Re Worthington & Co.'s Trade-Mark, 14 Ch. D. 8.

[2] Ricque *et al. v.* Forges, 8 Annales, 25.

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; and 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. — In the Court of Nîmes, in 1877, the plaintiffs had deposited as a trade-mark a thread dyed blue, in the centre of a miner's match manufactured by them.[1] The court said: "Color by itself may sometimes be insufficient to constitute a trade-mark, that is when the color, being isolated from all combination, may with difficulty serve as a distinctive sign. Thus it has been adjudged, that, as a natural tint given by the fabrication of a product cannot constitute a color-mark, and as an artificial color, extending throughout a product, constitutes less a distinctive color than a commercial quality of the merchandise, therefore under these conditions color cannot lead (except in case of a patent) to a right of user to the exclusion of other manufacturers. But the moment that a color, whether by adoption of special dispositions, or by the application of the color itself to certain parts of the product, whatever otherwise might be the simplicity of said combinations, succeeds in constituting a distinctive sign, susceptible of striking the purchaser's eye, it enters into the category of signs not enumerated by Article 1 of the law of June 23, 1857, that may serve as marks of manufacture."[2] — In the Court of Douai, in 1881,[3] the facts were as follows. Certain thread manufacturers had adopted various colors combined in certain ways, to indicate different kinds of thread. The

[1] Davey, Bickford, Watson, & Co. *v.* Nier, 26 Annales, 81.
[2] See French law, in Appendix.
[3] Ph. Vrau & Co. *v.* Pouillier-Loughaye *et al.*, 26 Annales, 92.

plaintiff's marks consisted of four endings (*liséré*s), to wit, Solferino-red, blue, black, and *écru* (a sort of straw-color). *Held*, on appeal, that every one of the borderings, by its disposition and apposition of colors, by the places that they occupy, by the aspect that they give to the complete combination, embraces all the elements of the mark protected by said Article 1 of the law of 1857. That if a color by itself, independent of all form, of all substance, and of all particular disposition, cannot suffice to constitute a mark, it is otherwise when this color, localized according to certain dispositions by intentional combination, and apposition to other colors environing, gives a design of color or a determinate form. It is vain to object, that thereby, colors being limited, is created a monopoly contrary to the liberty of commerce. Besides, nothing obliges manufacturers to use a bordering of color as a distinctive mark, nor, above all, of a bordering combined so as to lead to confusion between their products and those of rivals. — The same kind of a case came up in England, in 1880, in *Mitchell* v. *Henry*.[1] The trade-mark for worsted goods, upon which the argument turned, was described in the Trade Marks Journal of January 13, 1877, as follows: "A white selvage on each side of the piece having a red and white mottled thread interwoven the full length of the selvage between the edge of the piece and the edge of the selvage." Jessel, M. R., said that he had registered the trade-marks (seven in all) very unwillingly, and that, if the registration were good for anything, it was because the colors make the distinctive device. All the seven registered marks were alike with this distinction, that the interwoven thread varied in color. The first was a blue and white mottled thread, the second a red and white mottled thread (which is the one under consideration), the third a yellow and white mottled thread, the fourth a violet and white mottled thread, the fifth a brown and white mottled thread, the sixth a green and white mottled thread, and the seventh a black and white mottled thread. The defendant put in another device with three colors, to use the language of the court, "white, if it is

[1] 15 Ch. D. 181.

white, and red and yellow. The only difference between the seven is that you put yellow instead of red. If you add yellow to the red, there is a double variation. Instead of having two colors, you have three, and one of them is a different color, and so different that the applicants consider it makes a new mark, and they change yellow for red, or violet for blue, or whatever the color is." He confessed himself to be quite nonplussed in regard to distinguishing the colors; for the dye had affected the yellow and red very much in the case of both plaintiff and defendant, and said that he was asked to disbelieve the evidence of his own eyes. On appeal, Thesiger, L. J., said: "I cannot say by the evidence of my own eyes whether the threefold thread used by the defendant might not, even to the eyes of an expert, be a colorable imitation of the twofold thread used by the plaintiff. It appears to me that that must be a matter of evidence, and evidence of experts." It was, accordingly, directed to stand over until the conflict of evidence could be decided.

§ 269. *Form* is necessary to make *color* an essential feature of a trade-mark. In other words, color alone cannot legally be deemed to be an arbitrary symbol. That form may be a geometrical figure, or the representation of an object having a fixed, definite shape, and being susceptible of description: thus, a circle, a square, a triangle; or an arrow, or an anchor, or a monogram; or any of an infinite variety of objects in nature or art, which may be easily described, and readily apprehended. But nothing short of this requirement could be sufficient. Who could impart or receive a precise idea of a tree, a cloud, or even a human being? A trade-mark must be something that can impress its peculiarity of configuration upon the memory, as plainly as it is impressed on goods. We can describe and recognize a Maltese cross, a diamond within a circle, a five-pointed star, a flag of fixed proportions having a certain number of stripes and stars, or national emblems. Then color may well be a valid essential constituent; but it is hardly within the range of possibility to convey an adequate idea of a thing that has no fixed invariable limits. In the

Court of Douai, in 1881,[1] it appeared that the plaintiff had duly registered, as a trade-mark for sewing-thread, an envelope of a blue color (fancifully called by him a *capsule*, although not such in reality), combined with other matters. One of the points of defence was that the blue color could not be an essential element. *Held:* As to the blue color of the capsule, although it is true that a color in itself cannot, independently of all form, of all substance, and of all peculiar dispositions, suffice to constitute a trade-mark, it is otherwise when such color is, as in the envelope of Crespel & Descamps, applied to an object of a determinate form, put in apposition with other colors, placed in special lines and particular designs, and by the agency of different elements constituting a clearly characterized whole.

§ 270. This matter may seem like the veriest enunciation of truisms. Why waste ink and paper in such incontrovertible statements? Let censure be deferred. All sorts of visionary conceptions are uttered in this world of fancies. In 1884, notwithstanding the light that published opinions of courts had shed upon this very subject, it was insisted on that a bag for seeds, a bag of no particular shape, having no peculiarity or striking feature, might be a trade-mark, provided its color were red.[2] The following is an instance of a false conception as to the function of mere colors.[3]

§ 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

[1] Crespel & Descamps *v.* Dayez fils ainé & Co., 20 Annales, 335.

[2] See Case of Oliver Landreth, *ante*, § 89 *d*.

[3] In Harrington *v.* Libby, in 1877, in the U. S. Circuit Court, the court approvingly cited the two sections following this. 12 Off. Gaz. 188.

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

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

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

[1] Gaullieur & André, No. 927.

suggestion of origin or quality.[1] Nor does "Diamond," coupled with *soap*.[2] "Samson Brace," for suspenders, cannot imply anything more than strength of material and make.[3] "Deer Tongue," for tobacco, is clear enough.[4] So is "Royal Bats-wing," for ladies' corsets.[5] "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.[6] 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.[7] We are not deceived into thinking that there is any "Gold Dust" in the whiskey that bears that name;[8] or that an illuminating-oil is verily "Mineral Sperm Oil";[9] or that pills are really "Everlasting."[10] Nothing but a sheer lack of charity would literally construe "Annihilator," as applied to a medicine;[11] and when considering the case of *Davis* v. *Kendall*,[12] we would deem the question as to its right of existence to be judicially settled, and pass as good the words "Pain Killer."[13] In this case, it appears by the specification that Perry Davis, the founder of the firm, and father of Edmund Davis and Sarah D. Dennis, copartners under the firm name of Perry Davis and Son, in or about the year 1839 originated and introduced the article of medicine to which he at that time applied the distinctive and suggestive name of "Pain Killer." There is also a recital of the fact that the said name has at various times been pirated by different persons, who have been promptly sued for their piracies; and that in all cases the said name as a trade-mark has been fully maintained by the decisions of the courts. — For a while there was doubt as to

[1] Colgate & Co., No. 014.
[2] J. Buchan & Co., No. 024.
[3] Fisk, Clark, & Flagg, No. 744.
[4] L. L. Armistead, No. 512.
[5] Thomson, Langdon, & Co., No. 540.
[6] E. J. Williamson, No. 401.
[7] Landsberger & Co., No. 814.
[8] Barkhouse Brothers & Co., No. 626.
[9] R. S. Merrill & Co., No. 557.
[10] Dunn & Co., No. 448.
[11] N. Jenkins, No. 746.
[12] 2 R. I. 566.
[13] Perry Davis & Son, No. 416.

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

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

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

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

[1] A. M. Lesley, No. 664.
[2] James W. Tufts, No. 678.
[3] Ohio Valley Piano Co., No. 795.
[4] Abendroth Brothers, No. 307.
[5] Bostwick & Tilford, No. 376.
[6] W. H. Reed, No. 708.
[7] Bostwick & Tilford, No. 377.
[8] F. M. Backus, No. 640.
[9] H. J. Baker & Brother, No. 373.
[10] H. Smith, No. 432.
[11] Greenwoods Scythe Co., No. 749.
[12] Id., No. 750.
[13] Id., No. 751.
[14] Id., No. 752.
[15] Id., No. 753.
[16] Id., No. 754.
[17] Samuel B. Forbes, No. 843.
[18] Ex parte Crane & Co.
[19] Ex parte George S. Batcheller *et al.*

his decision that the term "geyser" has a signification well known to the public in connection with certain springs. It is therefore generic and descriptive. The applicant asked for some evidence of the correctness of the decision. The reply was that the word "geyser" is a familiar geological term, as is shown by the standard dictionaries, books on geology, and many other printed authorities; that it is an English word, from the Icelandic verb *géysa*, to rage, boil, spout; meaning, in its restricted sense, a fountain common in Iceland which spouts forth boiling waters; and that by the natural growth of our language it has become common property to indicate any spring like the geyser springs of Iceland. The geysers of the Yellowstone Valley and of California, in our own country, might also have been mentioned. "Beeswax Oil" was in effect held by the Commissioner to be simply descriptive of quality.[1] The word "Razor" being purely descriptive, and "steel" a generic term, the compound word "Razor-steel" was refused registration.[2] The word "Invisible," applied to pearl-powder for beautifying the complexion, when used to indicate the character of the thing to which it is attached, becomes descriptive. The intention of the applicant was to intimate that the powder, when applied to the skin, is imperceptible or invisible.[3] The words "Calendar Watch,"[4] 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.[5] "Lunch Milk Biscuit," to be applied to milk biscuit, for lunch or not, cannot be regarded as a trade-mark.[6]

[1] C. L. Hauthaway & Sons, Com. Dec., 1871, p. 97.
[2] R. J. Roberts, Ibid. 113.
[3] Solon Palmer, Ibid. 289.
[4] Ex parte Daniel G. Hall.
[5] Blakeslee & Co., Com. Dec., 1871, p. 284.
[6] Ex parte C. D. Ross & Son.

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

[1] Ex parte The Woven Wire Mattress Co.

[2] As to the necessary name of a product, see §§ 220 *et seq.*

CHAPTER VI.

FEDERAL TRADE-MARK LEGISLATION.

§ 278. Misconception as to power of Congress.
§ 279. Carelessness in examination of question.
§ 280. Act of 1870 discussed.
§ 281. Congress has authority to legislate on marks.
§ 282. Act of March 3, 1881, constitutional.
§ 283. By whom and how registration is obtained.
§ 284. "Owner," — meaning of term, as used in act.
§ 285. Why act limited to foreign and Indian commerce.
§ 286. "Treaty, convention, or law" defined.
§ 287, 288. Liberal spirit of our law.
§ 289. Status of member of Indian tribe.
§ 290. Name of applicant, — particularity required.
§ 291. Domicile, — when to be set forth.
§ 292–295. Domicile, — discussed.
§ 296. Location of business of applicant.
§ 297–299. Citizenship, — not essential to registration.
§ 300. Class of merchandise.
§ 301, 302. Trade-mark applicable to merchandise only.
§ 303. Description of trade-mark must be clear.
§ 304. "Fac-similes," — meaning of term in this law.
§ 305. Mode of applying and affixing mark.
§ 306. Statement of time of use.
§ 307. Government fee, — prepayment necessary.
§ 308. Regulations to be made by Commissioner.
§ 309. Application must be verified.
§ 310. Meaning of words "create any right."
§ 311. How verification is to be made.
§ 312. Manner of administering oath.
§ 313. Strictness of verification.
§ 314. Certificate of officer administering oath.
§ 315. Proof of oath, or equivalent, must be filed.
§ 316. "Firm," — meaning of term.
§ 317–320. Trading corporation alone can register.
§ 321, 322. Name of corporation not a trade-mark.
§ 323. Term "corporation" sometimes misunderstood.
§ 324. Exclusive right to use.
§ 325. Time of receipt, — lawful use.
§ 326. "Merely the name," — not a trade-mark.
§ 327. "Registered or known trade-mark."
§ 328. Calculated to deceive.
§ 329. Statutory requirements must be fulfilled.

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

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

[1] In the Trade-Mark Cases, 100 U. S. 82.

[2] See Sect. 77, Registration Act of July 8, 1870.

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

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

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

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

[1] See opinion of court, 100 U. S. 93.

[2] Duwel *v.* Bohmer, 14 Off. Gaz. 270; Cox's Manual, case 613.

[3] Leidersdorf *v.* Flint, 13 Am. L. Rev. 300; 8 Biss. 327; Cox's Manual, case 629.

[4] 19 Stat. 141; 1 Supp. R. S. 241.

[5] "One's commercial signature,"—a phrase used by the writer in § 130.

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

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

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

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

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

[1] Re Adriance, Platt, & Co., certificate No. 5480, dated January 8, 1878.

[2] "In what we have here said, we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of Congress to pass any laws necessary to carry any such treaties into effect." — Trade-Mark Cases, 100 U. S. 90.

[3] Heydenfeldt *v.* Davey, &c. Mining Co., 93 U. S. 634.

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

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

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

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

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

Country.	Date.	Reference.
Austro-Hungarian Empire	June 1, 1872	17 Stat. 917
Belgium	July 30, 1869	16 Stat. 765
Do.	July 9, 1884	20 O. G. 452
Brazil	Sept. 24, 1878	21 Stat. 650
France	April 16, 1869	16 Stat. 771
German Empire	June 1, 1872	17 Stat. 921
Great Britain	July 17, 1878	14 O. G. 233
Italy	March 19, 1884	27 O. G. 304
Russian Empire	June 27, 1868	16 Stat. 725
Servia	Dec. 27, 1882	22 Stat. 966
Spain	April 19, 1883	25 O. G. 98
Switzerland	May 16, 1883	23 O. G. 2237
The Netherlands	Feb. 16, 1883	23 O. G. 1334

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

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

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

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

[1] "Protection" is the misleading word in the act of 1870.

[2] See §§ 291 *et seq.*

"and among the several States."[1] To insist upon a restoration of these words at that time must have jeoparded the passage of the bill. The Senate would have corrected the error; but the slightest amendment must inevitably have defeated final action, as the term of Congress was near its expiration.

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

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

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

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

Parliament entitled, "The Merchandise Marks Act of 1862," was equivalent to a convention. Indeed, the right of an alien friend to protection in the English courts did not depend upon the passage of that statute, for in many instances previous thereto, the said courts had recognized and enforced the doctrine.[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 marks." This doctrine had previously been asserted by Story, J., in the same court.[4] 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,

[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.

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

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

§ 288. Among commercial nations, there is a growing tendency to a general recognition of the emblems of commerce known as trade-marks; for such recognition operates as a safeguard against fraud on their own communities. Hence the many treaties and conventions upon this subject, and the liberal views entertained by the judicial courts of nearly all the enlightened countries. By the term "convention" we mean all kinds of contracts less formal than a treaty, and all pacts, understandings, or agreements,[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

[1] Bouvier's Law Dict.; Webster's Dict., title Convention.

in the courts of that country as if he were a British subject, independently of any treaty or compact, the French nation did not display a similar spirit of justice to Englishmen. Rowland & Son, of England, sued in France for an infringement of their trade-mark. The court refused them redress because they were undomiciled foreigners. The cases of Stubs and of Spencer were decided against Englishmen on the same ground. The same ruling seems to have been uniformly made in the cases of all other foreigners under the same circumstances. In March, 1856, the Tribunal of Commerce of the Seine,[1] 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,[2] the complainant, Kemp, an American, proprietor of "Florida Water" (*Eau de la Floride*), sold as "Agua Florida," had obtained in the court below a judgment for infringement of his trade-mark. It was held by the appellate court that, by Arts. 11 and 13 of the Code Napoléon, the foreigner, not permitted by authorization of the Emperor to establish his domicile in France, could enjoy only those rights accorded to Frenchmen by treaty with the nation to which such foreigner belongs.

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

[1] Farina *et al. v.* Camus, 2 Annales, 159.
[2] Kemp *v.* Herman, 13 Annales, 208.

necessary for the regulation of commerce with such tribes; and this law relates to commerce.[1]

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

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

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

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

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

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

§ 292. There is sometimes no small difficulty in deciding upon the place of domicile, in a strict and legal sense. Residence is oftentimes of a very equivocal nature, and an intention to return to a former residence is still more obscure. Both are sometimes to be gathered from slight circumstances of mere presumption, and from equivocal and conflicting acts.[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 voted at the municipal elections in the District of Columbia; and their right to do so has been maintained by high legal authority. Yet an inhabitant of one State does not acquire a domicile in another by merely coming to the latter to seek employment, with the intention of residing there only if he should find it.[3] In *Abington* v. *North Bridgewater*,[4] 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

[1] Story, Conflict of Laws, § 44.
[2] Ibid., § 45.
[3] Ross *v.* Ross, 103 Mass. 575.
[4] 23 Pick. 170, 177.

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

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

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

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

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

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

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

[2] The Venus, 8 Cranch, 278.

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

§ 295. One effect of the law of national domicile may be this: it may affect the validity of the transfer of a trade-mark by assignment, as provided for in Section 12. If by the law of the place where a person has his domicile he is of legal age at the age of twenty, and has the faculty of disposing of his property there situate, the same faculty will extend to his property situate in another country, where he would not be capable of alienating until he had reached the age of twenty-five years.[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.

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

[1] Story, Conflict of Laws, § 54.
[2] Pardessus, De Droit Commercial, vol. v. art. 1482, p. 248.

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

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

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

[1] Field *v.* Adreon, 7 Md. 209; Risewick *v.* Davis, 19 Id. 82; Drake on Attachments, § 59 *a*.

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

§ 299. The national character which a man gains by residence may be thrown off at pleasure by a return to his native country, or even by turning his back on the country in which he has resided, on his way to another. It is an adventitious character gained by residence, and which ceases by mere residence.[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 beginning of the war between the two countries; but only for the purpose of winding up his business. *Held*, that he had gained a domicile in his native country. In still another case, a residence of thirteen years in an enemy's country was held sufficient to invest the party with the character of an enemy.[4] In the civil war

[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.

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

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

[1] The Prize Cases, 2 Black's Rep. 635; Amy Warwick, 2 Sprague's Decisions, 2, and 24 Law Reporter, 335, 494.

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

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

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

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

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

§ 302. Lest the proposition enunciated above should not be considered authoritatively given, let us consult the Bench. Ludlow, J., in 1860,[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." Vice-Chancellor Wood, of England, in 1865,[2] said substantially that the law on this point, as laid down in the cases before Lord Westbury,[3] is as follows, and that he did not think that any one would be disposed to dissent from it. This court has taken on itself to protect a man in the use of a trade-mark as applied to a particular description of article. He has no property in that mark *per se*, any more than a person has in any fanciful denomination which he may assume for his own particular use without reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and when he has caused his goods to circulate with that mark, when that mark has become the known *indicium*

[1] Colladay *v.* Baird, 4 Phil. 139.
[2] Ainsworth *v.* Walmesley, 44 L. J. 252.
[3] Millington *v.* Fox, 3 Myl. & Cr. 338; Hall *v.* Barrows, 10 Jur. (N. S.) 55.

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

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

[1] Leather Cloth Co. case, 11 Jur. (N. S.) 513.
[2] Re Middlesex Co., Registration No. 655.
[3] Re Volta Belt Co., 8 Off. Gaz. 144.

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

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

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

[1] Lowell Manufacturing Co. *v.* Larned, Cox's Manual, case 428; Codd. Dig. 341.

[2] Re Charles Narcisse Farre, Certificate No. 8,939.

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

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

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

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

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

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

[1] 9 Opinions of Attorneys-General, 64.

[2] Patent Office, Rule 215; Rev. Stat., sect. 4936.

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

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

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

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

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

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

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

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

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

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

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

[1] Whitely *v.* Swayne, 4 Fish. 117.

[2] Re Vidoard *et al.*, 8 Off. Gaz. 143.

[3] Goodyear *v.* Hullihen, 3 Fish. 251; 2 Hughes, 492.

[4] French *v.* Rogers, 1 Fish. 133.

[5] Crompton *v.* Belknap Mills, 3 Fish. 536; Preble's Patent Case Index, 522.

in one case held otherwise.[1] 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.[2] Notwithstanding the tenor of the foregoing decisions, no prudent applicant would neglect any of the formalities required, nor lay the flattering unction to his soul that he can eventually succeed if he do so. We have an opinion in the Crompton case, above cited, that even the requirement for the payment of fees is *directory*, and that the non-payment thereof would not invalidate a patent inadvertently granted. (*Obiter dictum.*)

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

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

[1] Whittemore *v.* Cutter, 1 Gall. 420; 1 Robb. 48; Preble's Patent Case Index, 523.

[2] Clifford and Clark, JJ., Crompton *v.* Belknap Mills, *supra.*

[3] Webster's Dictionary, *Firm;* Worcester's Do.

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

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

[1] Sedgwick, Stat. and Const. Law, 318.

[2] The Mercantile Loan and Warehouse Co., case 683.

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

§ 319. If the Office had permitted registration in such cases, what absurd consequences might have flowed therefrom! Other corporations of a similar or analogous nature would perhaps have demanded the certificate, which to them might have seemed like the wand of an enchanter. A corporation sole is recognized as existing in the United States. Such is a minister of a parish seized of a freehold, as *persona ecclesiæ*, the same as in England; and the right once established cannot be devested 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 individ-

[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.

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

§ 320. Common sense and good faith are the leading stars of all genuine interpretation. We do not take language literally, but look at the reason which underlies it. The command, "Thou shalt not kill," does not prohibit killing in a just war, or in defence of one's person. When the minister in the pulpit tells us to sing three verses of a certain hymn, we do not take him literally, for his words do not mean exactly what they say. A hymn is in poetical form, and in poetry each line is a verse. Therefore we at once perceive that the careless speaker means that we shall sing three stanzas, as otherwise the sense would be incomplete and be turned into sheer nonsense. Dr. Lieber has given an illustration of the necessity of consulting the rules of reason in applying language. He takes the word *horse*, which means many different things.[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.

§ 321. There are two published opinions, which, on a superficial reading, seem to affirm that the mere name of a corporation may constitute a lawful trade-mark, when used by the corporation itself, as a mark or sign upon merchandise. These opinions are worthy of examination at this moment, and especially so is the earlier one, as that has been cited in the Patent Office as an authority. It is the case of *Newby* v. *The Oregon Central Railway Co. et al.*, in the Circuit Court of the United States for the District of Oregon, in 1869.[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 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

[1] Deady's Rep. (1859–69) p. 609.

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

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

§ 322. The other corporation case which invites our attention is that of *Holmes et al.* v. *Holmes et al.*,[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 shown that it did), it will be protected. How? "*Upon the same principle*," not as *being* a trade-mark.

[1] 37 Conn. 278; 9 Am. R. 324.

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

§ 324. *Exclusive Right to Use.* — In his statement or specification, the applicant must set forth his title, whether by original adoption, by assignment, inheritance, survivorship, or by operation of law, as when one has acquired a right to carry on the business of a bankrupt. From the facts therein alleged will be deduced a conclusion as to the legality of the title claimed. The right to the use of the mark must be *exclusive* of all other persons.[3] 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.

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

[2] Re Gullet Gin Manufacturing Co., 1873, case 1478.

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

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

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

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

[2] Meneely *v.* Meneely. 62 N. Y. 427. See *ante*, §§ 105–202.

[3] Bryce on Trade-Marks, 90; Cox's Man., case 328.

whom it was originally applied, and though the facts which caused it to be applied to him no longer exist. A surgeon T., who resided in Oldfield Lane, and who had acquired great fame under the name of the "Oldfield Lane Doctor," took an assistant as partner. The latter continued the business after T.'s death, and passed by the name of "Oldfield Lane Doctor." He was subsequently turned out by T.'s representatives, who leased the surgery to another surgeon, who practised there. The latter was restrained from using the name. — In a case where an applicant had used for the period of twenty-one years, as a trade-mark for bridle-bits and stirrups, the word "Daniel," as a fanciful name, it was admitted to registry.[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. — What is *merely* the name? Answer: the name used in the ordinary manner, having nothing in its arrangement to attract attention, and lead the public to inquiry, and having no feature indicative of an intention to make it a distinguishing emblem. But if one form his name into an anagram, or form a cross or crescent, or any other fancy figure of his name, then by the singularity of formation it acquires an individuality, and ceases to be merely his name, and becomes a lawful mark. The imitation of such a device would hardly be deemed the result of accident. One's autograph may be his commercial mark, if it possess striking peculiarities, so that it can be, and really is, recognized as his, and his only; but it is not every scrawl that would be deemed such. That involves a question of fact, whether such mark is sufficient to distinguish it from the same name when used by other persons.

[1] Re Kelita Broadhurst, Certificate No. 946.

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

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

[1] See *ante*, § 281.

[2] 4 Abb. Pr. 144; 13 How. Pr. 385; R. Cox, 188.

No. 1 of the "Averill Chemical Paint Company." The verbal description has been given in § 259. The applicant's specification presented the same general effect. "Omit the word 'Chemistry,'" said the Examiner, "add the Figure '&' to the ribbon, and substitute a globe for the rough rock, and the written description of Bradley is the same as that of the Averill Company. At a casual glance, one design might easily be mistaken for the other, an indistinct impression of which may have been left upon the memory; for each contains all the essential features of the other. Both devices are circular in form, are intended to be applied in the same mode, in the same color, and to the same class of goods. It is not to be supposed that opportunities for critical examination would commonly offer, nor even be sought; for the resemblance of the infringing to the genuine mark would lull suspicion; so that not only the general public, but even acute observers in the business of dealing in paints, might easily be misled."[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.

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

[1] Case of Henry W. Bradley, assignor to Young & Co., 355.

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

[1] Child *v.* Adams, 1 Fish. 189; 3 Wall. Jr. 20.

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

CHAPTER VII.

FEDERAL LEGISLATION (*continued*).

§ 330. Certificates of registry, — issue and effect.
§ 331. Term "Certificates" explained.
§ 332. Seal, — why of the Interior Department.
§ 333. Duration of certificate as evidence.
§ 334. Credit for fees paid under act of 1870.
§ 335. Who shall be credited for former fees.
§ 336. "Same Trade-Mark," — meaning of phrase.
§ 337. Effect of registration, — remedies.
§ 338, 339. Registration *prima facie* evidence.
§ 340. "Trade-Mark Patent" a false term.
§ 341. "Reproduce" explained.
§ 342. "Colorably," — definition of.
§ 343, 344. What remedies created by this act.
§ 345. "Remedy" a figurative expression.
§ 346. Action on the case.
§ 347. Cautions to be observed before litigation.
§ 348. When trade-mark is debarred from protection.
§ 349. "Unlawful business," — term defined.
§ 350. Article injurious in itself.
§ 351. Deceiving public by false indications
§ 352. Examples of imposition.
§ 353. Fraudulently obtained certificates.
§ 354. Reaffirmance of common-law doctrines.
§ 355. Damages for false representations.
§ 356. New right of action.
§ 357. No rights lost by registration.
§ 358. Claim to mark continues. — Suits between citizens of same State.
§ 359. Common-law right survives registration.
§ 360. "Goods to be transported," — phrase discussed.
§ 361. Transfers of trade-marks, — rules for.
§ 362. What trade-marks the rule applied to.
§ 363. Why abstract symbol not transferable.
§ 364. Trade-mark, on formation of partnership.
§ 365. A section that has no meaning.
§ 366. Seemingly unnecessary act of 1882.
§ 367, 368. Meaning of word "lawful."
§ 369. Simulated marks on watches, etc.
§ 370, 371. Act of 1876, to punish counterfeiting.

§ 372. Penal act and civil, — in effect one.
§ 373. Advantages of Federal registration.
§ 374. Effect of registration.
§ 375. "The Blanchard Churn" case.
§ 376. "The Hall Calendar Watch" case.
§ 377. Registry is notice to the world.
§ 378. Only valid common-law marks registrable.
§ 379. Congress did not think of creating marks.
§ 380. Meaning of registration.
§ 381. Registry of prints or labels. — Act of 1874.
§ 382. Meaning of "Prints," "Labels," etc.
§ 383. Accidental use by others of same emblem.
§ 384. Bad faith in anticipating adoption.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

[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 Calhoon *v.* Ring, Ibid. 397.

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

§ 339. It was held in the Court of Metz, in France, in 1861, in the case of *Somborn* v. *Menser et al.*,[3] 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

[1] 8 Opinions of Attorneys-General, 277.

[2] See Smith *v.* Reynolds, 10 Blatch. 85, 100; 3 Off. Gaz. 213, 214; 13 Blatch. 458.

[3] 8 Annales, 78.

user, therefore, destroys the presumption created by registration.

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

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

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

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

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

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

[2] Sternberger *v.* Thalheimer & Hirsch, 3 Off. Gaz. 120.

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

past ages. The penal portion of this section must be strictly construed. The law gives satisfaction for infringement whether the act of imitation be intentional or not. Under either aspect, if one be damaged by another in the use of his trade-mark, he is entitled to indemnification by way of compensation, although in the absence of evidence of a fraudulent intent, he is entitled to no more than nominal damages.[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.

§ 344. The remedy given by this section is cumulative. The party wronged has undoubtedly a right to resort to the common law for damages sustained, independently of this statute. The common-law remedy is not taken away by this affirmative statute, without a negative, express or implied.[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,

[1] Sedgwick on the Measure of Damages.

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

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

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

no degree of blame can be attached to him; as, for instance, in the use of a symbol which he did not know had been appropriated by another as his trade-mark; and, in that case, the principal feature to entitle the plaintiff to anything more than mere nominal damages would be wanting. In general, the representation must be *malo animo;* but whether the party making it is himself to gain by it is wholly immaterial,[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.

§ 345. *Remedy* is a figurative expression, which signifies the means employed under the provisions of law to enforce a right, or to redress an injury. It is a maxim of the law that there is no wrong without a remedy,— *Ubi jus ibi remedium;*[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 in form and spirit. Indeed, had not the statute named the action, a trade-mark is such an incorporeal right,

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

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

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

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

§ 346. The first remedy prescribed is an "action on the case," sometimes called "trespass on the case," which is the same remedy that the common law affords.[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.

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

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

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

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

[1] Curtis on Patents, "Infringement."

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

§ 349. "*Unlawful Business.*"— To entitle one to favorable judicial interposition, in case of infringement, it is not only essential that the symbol claimed be his mark of manufacture or commerce; but the business in which it is used by him must be lawful. It is a broad principle of law that all transactions in violation of morality, and founded upon conditions *contra bonos mores*, are void. All duties enjoined by the divine law are not enforced, indeed, by the common or by the statute law, not only because the forms or modes of proceeding do not enable human tribunals to adjust nice questions of morals, but because strict rules as to ethical questions would tend to destroy freedom of opinion, and to afford opportunities for persecution. But no agreements to do acts forbidden by the law of God, or which are manifestly in furtherance of immorality and tend to contaminate the public mind, are tolerated, or can be enforced. Thus, if it be shown that the plaintiff's trade-mark is used by him to stamp obscene publications, or articles used only in the commission of acts of vice, and the defendant has pirated the trade-mark to palm off similar publications or articles, the plaintiff could not recover damages. Two general maxims would be enforced against his demand,—*Ex turpi contractu non oritur actio*, and *In pari delicto, potior est conditio defendentis*. Any business which violates the rules of public policy is unlawful; yet, as Mr. Justice Story says,[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, safely be laid down, that any business which conflicts with the morals of the time, and contravenes any established interest of society, is void, as being against public policy. A business originally lawful in itself may by peculiar circumstances be made unlawful. Thus trading with an enemy without a license from

[1] See Story on Contracts, "Void on Account of Immorality."

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

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

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

§ 351. *Deceiving the Public* in the purchase of merchandise, as by acting a lie by means of a false indication of origin, that the vendor may obtain the benefit of the reputation that certain goods may have, as when the signs on cigars made in New York indicated that they were made in Havana;[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

[1] Palmer *v.* Harris, 60 Penn. 156.
[2] Fowle *v.* Spear, 7 Penn. L. J. 176.
[3] Croft *v.* Day, 7 Beav. 84.

to be protected by a patent;[1] 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.[2] Truth is the standard required. The court said, in *Matsell* v. *Flanagan*,[3] 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.[4] 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.[5] Hoffman, J., said: "It is constantly insisted, and the position is sanctioned by some judges, that when the article in question is innocuous, or in some degree useful, no absurd panegyric, or extravagant price, is a reason for denying the interference. In short, as counsel once said before me, if a man should compound tallow with some high scent and beautiful coloring-matter, and term it 'The Ointment of Immortality,' he has a right to appropriate so much of the public credulity as he can to this designation."[6] These remarks do not inculcate as high a standard of morals as might be expected from so learned and upright a jurist; and in justice it must be said that they do not rep-

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

[2] Partridge *v.* Menck, 1 How. App. Cases, 558.

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

[4] Curtis *v.* Bryan, 2 Daly, 212; 36 How. Pr. 83.

[5] Dale *v.* Smithson, 12 Abb. Pr. 237.

[6] Fetridge *v.* Merchant, 4 Abb. Pr. 156.

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

§ 352. To guard as much as possible against the danger of deceiving the public, the Office avails itself of the implied judicial power granted to it by Section 3, and endeavors to fathom the motives of applicants for registration. It is immaterial whether the intention of fraud actually exists in the mind of the applicant, if there is a reasonable probability that the public may be misled. Therefore, when an application was made for the registry of the words "American Sardines," as a trade-mark to be placed upon boxes ordinarily used for the sardines of commerce, the case was rejected; and that, even although it was alleged that the native fish — which is *not* a sardine — is equal in nutritious qualities and delicacy of taste to the imported article.[2] 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

[1] Bloss *v.* Bloomer, 23 Barb. 604.
[2] Re The American Sardine Co., 3 Off. Gaz. 495.

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

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

[1] Seabury *v.* Johnson, 14 Blatch. 262.
[2] Cotton *v.* Gillard, 44 L. J. Ch. 90.
[3] Blackwell *v.* Dibrell, 14 Off. Gaz. 633; 3 Hughes, 151.
[4] Rev. Stat., sect. 4943.

to the one claiming title under such circumstances, 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."

§ 354. It may safely be assumed that this Section 8 is but a reaffirmance of the doctrines of the common law, in that it is well settled that a claim founded upon a transaction which is either *malum prohibitum* or *malum in se* cannot be enforced in an action of any kind.[2] 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.[3] 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;

[1] 4 Abb. Pr. 144; 13 How. Pr. 385.
[2] Eberman *v.* Reitzell, 1 Watts & Serg. 181. See also 18 Pick. 472.
[3] Forsythe *v.* State, 6 Ham. 21; Chitty on Contracts, 678, and cases there cited.

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

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

§ 356. *New Right of Action.* — At common law, the 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 manufacturer, has been accustomed to use a certain mark to denote that the goods so marked were of his manufacture, that such mark was well known and understood in the particular trade, and that the defendant had adopted the mark, and sold goods bearing it, as and for the

[1] 5 C. B. 109; 5 Man., Gr. & Sc. 109.

plaintiff's goods, with intent to deceive?" On these grounds, the action was held not to be maintainable in *Singleton* v. *Bolton*,[1] 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.[2] Probably, by virtue of this section, the real owner of a mark would be entitled to nominal damages, sufficient to establish his title, the same as in ejectment, without proof of actual injury, for injury might well be inferred from the fact of false or fraudulent representations. The true owner's loss of time in procuring registry, the expense attending the interference made necessary by the fact of a plurality of claimants, and many other circumstances, — as, for example, the loss of reputation in the market, — might be urged as proper grounds upon which to base a demand for damages.

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

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

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

[1] 3 Doug. 293.

[2] Lloyd on Trade Marks, "Remedies against Piracy."

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

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

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

[1] Luyties *et al. v.* Hollender *et al.*, 21 Fed. R. 281.

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

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

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

[1] Glen Cove Manuf. Co. *v.* Ludeling, 22 Fed. R. 823.

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

purchaser or mortgagee[1] for a valuable consideration, without notice." [2]

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

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

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

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

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

[1] 57 Barb. 526, and 4 Am. L. T. R. (St.) 168.
[2] 3 Am. L. T. R. (St.) 288, and 2 Brewster, 321.
[3] 2 Daly, 521. [4] 29 Cal. 292.

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

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

[1] 3 Blatch. 440.

[2] 11 Jur. (N. S.) 513.

[3] L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. (N. S.) 205; 14 L. T. (N. S.) 220; 14 W. R. 363.

[4] 10 Jur. (N. S.) 55. See also The Collins Co. *v.* Cohen, 3 K. & J. 428; Wotherspoon *v.* Currie, 23 L. T. R. (N. S.) 443; 18 W. R. 942.

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

[1] 24 Barb. 163; 13 How. Pr. 342; and 4 Abb. Pr. 88.

[2] *Ubi supra.*

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

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

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

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

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

[2] Kidd *v.* Johnson, 100 U. S. 617.

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

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

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

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

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

[1] See Chapter III., on "Definition and Nature of a Trade-Mark," especially §§ 87–89, 143.

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

[1] Ex parte John F. Tolle, two cases.

[2] See *ante*, § 89 *a*.

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

[4] 6 Beav. 69, n.; 5 Leg. Obs. 495.

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

[1] 1 Off. Gaz. 27.

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

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

[1] Com. Dec., 1871, p. 284.

[2] Ex parte J. S. Johnson & Co., 2 Off. Gaz. 315.

of elemental parts not before brought together in that kind of machine. The machine itself may have previously existed; and so may the separate elements of the new combination; but if those elements have not before been united so as to produce a method of operation differing from what had been done before in that kind of machine, what is called a new combination is created.[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. 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, a written argument of counsel and a number of affidavits were filed. The affiants came up boldly to the task of proving a conclusion of law, and swore that the combination of words constitute a lawful trade-mark. The argument of the counsel affords a clew to the remarkable statements of the party and his witnesses. We find that he treats the case as if it were an application for a patent for an aggregation of useful elements in a machine, or the bringing together of various chemicals in a new composition of matter. A single extract will suffice to show the counsel's position. He says: "As in case of patenting a new machine, it is sufficient if this *combination* of old and well-known words embrace sufficient novelty and distinctiveness from all others, as to be readily and easily distinguishable therefrom, so that none is wronged

[1] Curtis on Patents, § 1.1 (3d ed.).

[2] Ex parte John E. Cassidy, Sept. 24, 1872.

or misled. This, I believe, the testimony fully establishes." It is manifest that the counsel intended to relieve the Office of the task of interpreting the plain, ordinary, and popular language of the claim. This proposition is clearly patentable as an invention, so far as *novelty* is concerned, and would be unobjectionable if it had *utility*. But we find a well-settled rule of evidence, that the *testimony of experts* cannot be adduced to aid a court in reading an instrument, unless it be non-decipherable by ordinary eyes, or has a hidden or technical meaning explainable only by parol evidence.[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 outwork of the Boston city water-works, and from that place the name is adopted by him. From all the facts, a conclusion was drawn unfavorable to the application. Rejected.

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

[1] 1 Greenl. Ev., Chapter XV.

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

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

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

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

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

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

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

[1] The edition of Rules of Practice issued by the Patent Office in 1885 contains this act of 1870 among the statutes in force.

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

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

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

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

§ 375. The decision in "The Blanchard Churn"[1] case gave an impetus to this way of thinking. The Examiner

[1] Com. Dec., 1871, p. 97.

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

§ 376. The foregoing decision opened the door to many proposed trade-marks of an exceedingly doubtful nature. Finally, after the registration of combinations formed upon the model thus furnished, the question came up again before the same Commissioner. In this instance, the proposed mark consisted of the words "The Hall Calendar Watch," intended to be affixed to a watch sold by the applicant, named Hall.[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*

[1] Com. Dec., 1872, MS.

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

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

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

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

[1] Re Dutcher Temple Co., Com. Dec., 1871, p. 248.

[2] Act of March 3, 1881, sect. 3.

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

§ 380. What does the claimant register, — his mark, or what he intends shall be his mark? But it is not a mark until actually *marked* upon something, and that something an article of commerce. He does not in any case *file* his mark, but he does file "a description of the trade-mark itself, with fac-similes thereof," and he makes oath, or its equivalent, "that the description and fac-similes presented for registry truly represent the trade-mark sought to be registered."[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

[1] See Sects. 1 and 2 of Act of March 3, 1881.

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

required, — the physical application of the same to merchandise. This view of the law was entertained by the Office in the well-contested case of *Schrauder* v. *Beresford & Co.*,[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]

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

[1] In chapter on Interferences.

[2] Interference, September, 1872.

[3] 18 Stat. at Large, 78; 1 Supp. Rev. Stat. 40.

[4] Rev. Stat., sects. 4952, 4962.

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

[6] Trade-Mark Cases, 100 U. S. 82.

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

[1] See Trade-Mark Cases, *supra*.

[2] Constitution, Art. I., sect. 8, clause 3.

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

[1] August Vogeler *et al. v.* Max Ernst, equity No. 3320. Decree for complainants, Sept. 27, 1878.

[2] Label Registrations, Nos. 512 and 539.

[3] Marsh *et al. v.* Warren *et al.*, 14 Off. Gaz. 678.

[4] Re The Dr. Harter Medicine Co., July 20, 1879, MS.

[5] Re Simpson & Sons, 10 Off. Gaz. 333.

[6] Re Thaddeus Davids & Co., 16 Id. 91.

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

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

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

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

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

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

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

[1] Marsh *et al. v.* Warren, *ante*, § 380.

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

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

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

[2] A. Dupont *v.* Debreye, 23 Annales, 5.

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

[1] Parent *v.* Chaumont, 23 Annales, 164.
[2] Torchin *v.* Cathrin, Ibid. 249.

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

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

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

In a hearing before the Attorney-General (Sir R. P. Collier), in 1870,[1] counsel for the patentee successfully urged this rule against the real inventor (one Overend, of San Francisco, California), who not only lost his invention, but was also compelled to pay costs. — We may suppose a case wherein the actors are nations. It is ascertained by one nation that another nation is fitting out a fleet at great expense, with the intent of taking possession of a savage or an uninhabited country; and the nation first mentioned, without a moment's delay, pounces upon and holds the prey, and annexes the new territory. Who becomes the sovereign, — he who *intended* to seize, or he who actually occupied the new country? Spain obtained her title to a large portion of the Western Hemisphere by the planting of her flag; but what if, while Columbus, or 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.[2] This ends the discussion of "Federal Legislation," and the principal rules applicable thereto.

[1] Dunn's Application, No. 2427, Int. Pat. Off. Circ., January, 1871.

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

CHAPTER VIII.

INFRINGEMENTS.

§ 385. What constitutes infringement.
§ 386. Fraudulent intention not essential.
§ 387. Small words, as instruments of fraud.
§ 388–391. Imitation of minor details.
§ 392. Case of McLean *v.* Fleming.
§ 393, 394. In equity, — as auxiliary to law.
§ 395. Object of protection is twofold.
§ 396. "Dixon's Stove Polish" case.
§ 397. "Bovilene," "Cocoaine," and "Eau de la Floride" cases.
§ 398, 399. "Job" case.
§ 400. Infringement intended to operate abroad.
§ 401, 402. Infringement by part imitation.
§ 403, 404. The "Double-anchor Whiskey" case.
§ 405, 406. "Crown Seixo Wine" case.
§ 407–410. "Grande Chartreuse" cases.
§ 411. "Anchor-brand Wire" case.
§ 412, 413. "St. A * * * * *" case.
§ 414. Colorable infringement, — chocolate case.
§ 415. "Moniteur Universel" newspaper case.
§ 416. "La Presse" newspaper case.
§ 417. "Petit Journal" newspaper case.
§ 418, 419. Blending of trade-mark and other rights.
§ 420. Manufacturer's right to affix his own name.
§ 420 *a*. French illustrations of the doctrine.
§ 421. "Faber" lead-pencil case.
§ 422, 423. "Howe Sewing-Machine" case.
§ 424. "Derringer Pistol" case.
§ 425. "Hall's Vegetable Sicilian Hair Renewer" case.
§ 426. "Mrs. Winslow's Soothing Syrup" case.
§ 427–429. Use of the name of another.
§ 430–436. One's name.
§ 437. One sometimes debarred from using his original mark.
§ 438. Use of one's own name to deceive.
§ 439. "Ervalenta-Warton" case.
§ 440. Counterfeiting, to affix symbol to package merely.
§ 441. Actual counterfeiter is he who directs.
§ 442. Infringement by use of numerals.
§ 443–448. Perversion of mark. — Examples.
§ 449. Theory of infringements.
§ 450. Same emblem for different classes.

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

[1] 6 Beav. 66; 1 L. T. 384. [2] 7 Beav. 84.
[3] Walton *v.* Crowley, 3 Blatch. 440; R. Cox, 166.
[4] Popham *v.* Cole, 66 N. Y. 69; 23 Am. R. 22.

except by an expert, or upon a critical examination by one familiar with the genuine trademark.[1]

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

[1] Colman *v.* Crump, 70 N. Y. 573; 16 Alb. L. J. 352. McLean *v.* Fleming, 96 U. S. 245; 18 Off. Gaz. 913.

[2] 3 My. & Cr. 338.

[3] Coffeen *v.* Brunton, 4 McLean, 516; 5 Id. 256.

[4] Clement *v.* Maddick, 1 Giff. 98; 5 Jur. (N. S.) 502; 33 L. T. 117.

[5] Glenny *v.* Smith, 2 Drew. & S. 476; 11 Jur. (N. S.) 964; 13 L. T. (N. S.) 11; 13 W. R. 1032; 6 N. R. 368. Filley *v.* Fassett, 44 Mo. 173; 8 Am. L. Reg. (N. S.) 402. Graham & Co. *v.* Kerr, Dodson, & Co., 3 Beng. L. R. App. 4. Holmes, Booth, & Haydens *v.* The Holmes, Booth, & Atwood Manufacturing Co., 37 Conn. 278; 9 Am. R. 324. Blackwell *v.* Wright, 78 N. C. 310. The Singer Manufacturing Co. *v.* Wilson, 3 App. Cas. 376. Amoskeag Manufacturing Co. *v.* Garner, 4 Am. L. T. (N. S.) 176. Colman *v.* Crump, *supra*. McLean *v.* Fleming, *supra*. Carroll *v.* Ertheller, 1 Fed. R. 688.

[6] Cartier *v.* Carlile, 31 Beav. 292; 8 Jur. (N. S.) 183.

[7] Barnett *v.* Leuchars, 13 L. T. (N. S.) 495; 14 W. R. 166.

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

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

[1] Weed *v.* Peterson, 12 Abb. Pr. (N. S.) 178.
[2] Cook *v.* Starkweather, 13 Abb. Pr. (N. S.) 392.
[3] Coffeen *v.* Brunton, 5 McLean, 256; R. Cox, 132.
[4] Cope *v.* Evans, L. R. 18 Eq. 138; 30 L. T. (N. S.) 202; 22 W. R. 453.
[5] Cited by the late eminent authority, M. Pataille, 19 Annales, 209.
[6] Howe Machine Co. *v.* Maquaire *et al.*, 20 Id. 353.

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

[1] Génevoix *v.* Pauliac, 19 Annales, 209.
[2] F. Prot & Co. *v.* Monganzi, 20 Id. 365.
[3] Grézier *v.* Lambert, 23 Id. 145.
[4] Grézier *v.* Cusenier *et al.*, Ibid. 154. See "Chartreuse" cases, §§ 407 *et seq.*
[5] Compagnie Howe *v.* Grimm, 23 Annales, 160.
[6] Grézier *v.* Poullain, 24 Id. 327.
[7] Grézier *v.* Gallifet, Ibid. 330.
[8] Grézier *v.* Rocca *et al.*, Ibid. 339.

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

§ 388. We have considered the meaning of the term "colorable variation,"[8] and had many illustrations thereof; and

[1] Fumouze *et al. v.* Grosse *et al.*, 26 Annales, 170.
[2] Pellier *et al. v.* Trottier frères *et al.*, 27 Id. 357.
[3] Veuve Raymoudière *v.* Plesier *et al.*, 28 Id. 37.
[4] Landon *v.* Leroux, Ibid. 183.
[5] Hammelle *et al. v.* Doudiet, Ibid. 30.
[6] Landon *v.* Lamare, Blanc sur Contrefaçon, 732.
[7] Singer Manufacturing Co. *v.* Mestwerdt & Engel, 24 Annales, 116. This case arose under Art. 14 of the German law of Nov. 30, 1874.
[8] *Ante*, § 33.

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

[1] *Ante*, § 34.

[2] 25 Barb. 76; R. Cox, 206.

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

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

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

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

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

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

[1] 96 U. S. 245; 13 Off. Gaz. 913.

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

§ 393. "*In Equity*, the right to give relief to the trader whose trade had been injured by the piracy appears to have been originally assumed by reason of the inadequacy of the remedy at law, and the necessity of protecting property of this description by injunction. But although the jurisdiction is now well settled, there is still current in several recent cases language which seems to give an inaccurate statement of the true ground upon which it rests." Such is the language of the Lord Chancellor of England in 1865.[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; 17 Law J. Rep. (N. S.) Ch. 142, the eminent physician, Sir James Clark, applied for an

[1] 11 Jur. (N. S.) 513. [2] 7 Beav. 84. [3] 6 Id. 56.
[4] 1 Hem. & M. 287; 32 L. J. R. (N. S.) Ch. 721.

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

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

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

§ 395. The Supreme Court of Connecticut, in *Boardman* v. *The Meriden Britannia Co.*,[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; secondly, to protect the community from imposition, and furnish some guaranty that an article purchased as the manufacture of one who has appropriated to his own use a certain name, symbol, or device as a trade-mark, is genuine. Consequently, the violation of property in trade-marks works a twofold injury; the appropriator suffers, in failing to receive that remuneration for his labors to which he is justly entitled, and the public in being deceived, and induced to purchase articles manufactured by one man, under the belief that they are the production of another. Robertson, J., in *Corwin* v. *Daly*,[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. The first case reported containing this doctrine, on which all the others seem to depend, is found in a note of Doderidge, J., to the case of *Southern* v. *How*,[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

[1] 35 Conn. 402.
[2] 7 Bos. 222.
[3] Popham, 143, and Cro. Jac. 471.
[4] 2 Atk. 484.
[5] 3 Doug. 303.

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

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

[1] 3 Barn. & C. 541. [2] 4 Man. & Gr. 357.
[3] Corwin *v.* Daly, *supra*.
[4] 7 Phila. 408; 2 Brewst. 321; 3 Am. L. T. 288; R. Cox, 559.

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

§ 397. In *Lockwood* v. *Bostwick*,[2] 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

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

[2] 2 Daly, 521; R. Cox, 555.

a particular trade-mark. There could be no other motive; and it was done with the shallow expectation that the law would not see through the motive, but pronounce that the two labels were not the same, by simply distinguishing the points of difference between them. So far as the object sought could be attained, it would operate to the plaintiffs' detriment by diminishing the sale of their articles in the market, and they are entitled to be protected by a court of equity from this attempt on the part of rivals to deprive them of the fruits of their industry or enterprise in making their own fabric known and recognizable by its distinctive trade-mark. In *Burnett* v. *Phalon*,[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

[1] 9 Bos. 102; 5 Abb. Pr. (N. S.) 212; 3 Keyes, 594.

[2] 9 Annales, 40.

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

§ 398. In the Tribunal of Commerce of the Seine, in 1866 (*Bardou et al.* v. *Sabatou et al.*[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 were printed in gold the letters J. B. separated by a lozenge. In consequence of an error on the part of the public, this lozenge was taken for the letter O, for which reason the paper became known only under the name of "JOB Paper." The maker, J. Bardou *père*, accepted this designation, and adopted the name "JOB" in the registration of his trade-mark. Many decisions of courts had confirmed his title to this word as his commercial emblem or mark. A lithographer of Toulouse made and sold similar packets of paper, having the same color, but bearing different ornaments, and over which he had inscribed in large characters this notice: "Guerre à Job Papier très supérieur.

[1] 14 Annales, 140.

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

judgment was affirmed, although the damages were reduced to three thousand francs.[1]

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

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

§ 401. In *Gillott* v. *Esterbrook*,[4] 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),[5] 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

[1] 15 Annales, 115.
[2] 13 Id. 293.
[3] See Glen Cove Manuf. Co. v. Ludeling, *ante*, § 360.
[4] 47 Barb. 455; 48 N. Y. 374; 8 Am. R. 553.
[5] See *ante*, §§ 225–233; also Glen & Hall Manuf. Co. v. Hall, 5 Alb. L. J. 109; 6 N. Y. Sup. Ct. (6 Lans.) 158; Com. of App., 67 N. Y. 226; 10 Am. R. 278.

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

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

§ 402. In *Walton* v. *Crowley*,[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. 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,[2] 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

[1] 3 Blatch. 440; R. Cox, 166.

[2] McCartney *v.* Garnhart, 45 Missouri (4 Post's R.), 593.

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

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

§ 405. Ever since the year 1848, a plaintiff, Baron Seixo,[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 assuming the truth of what is contended for the defendants, i. e. that parts of their vineyards are known by the name of Seixo, that does not justify them in adopting a device or brand, the probable effect of which is to mislead the public when purchasing their wine to suppose that they are purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff. Cases may be imagined, though very unlikely to arise, in which a person bringing into the market for the first time the produce of a newly established manufacture, to come into competition with one already established, may really be embarrassed as to the mode in which he should describe it, so as not to interfere with the description adopted by a manufacturer who has been before him. If such a case should arise, it must be dealt with on its own merits." Appeal dismissed, with costs.

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

[1] Seixo *v.* Provezende, 12 Jur. (N. S.) 215; L. R. 1 Ch. 192; 14 L. T. (N. S.) 314; 14 W. R. 357.

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

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

[1] 4 Annales, 119.

[2] 14 Id. 252.

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

§ 409. Upon reference to the case first referred to, — that in the Court of Grenoble, in 1852, *Garnier et al. Carthusians* v. *Rivoire*,[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 *Chartreuse* must not be employed on labels, unless as a simple term of comparison, as, for example, *imitation de Chartreuse*, the whole in the same kind of characters; or if another denomination were used, the sense should not be equivocal, to draw to the defendant. His custom must depend upon his own merit, without diverting the trade of the plaintiffs, the Chartreux. The reputation of the delicate fluids seems to have kept the venerable brotherhood in constant litigation. One decision made in their favor affected all the manufacturers of similar articles in the department of Isère and the Rhone; and they combined to prove the name *Chartreuse* to be but generic. They signally failed, on appeal.

[1] 4 Annales, 155.

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

§ 410. The case of *Louis Garnier* v. *Paul Garnier* came up in the Court of Paris, on appeal, in 1870,[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

[1] 14 Annales, 225.

[2] 17 Id. 241.

user thereof, independent of all deposit (equivalent to our registration), wherefore the special denomination of *Chartreuse* employed by the Carthusians to designate the *liqueurs* manufactured by them at their monastery is, as a trade-mark, their exclusive property. Consequently, they have a right to demand that other manufacturers or dealers be forbidden to use the word "Chartreux," or "Chartreuse," upon the class of merchandise that they, the plaintiffs, manufacture. Not to let the matter drop without exhausting all means of defence, the defendant carried his case to the court of last resort. In April, 1872, it was decided in the Court of Cassation,[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.[3]

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

§ 412. In *Woolam* v. *Ratcliff*,[5] the plaintiff and the defendant were both large silk throwsters. The plaintiff was in the

[1] 17 Annales, 257.

[2] *Ante*, § 143.

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

[4] 1 De G., J. & S. 165; 9 Jur. (N. S.) 470; 7 L. T. (N. S.) 768; 11 W. R. 328; 1 N. R. 300.

[5] 1 Hemming & Miller, 259.

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

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

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

[1] Knott *v.* Morgan, 2 Keen, 213.

[2] 17 Annales, 233.

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

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

§ 415. In the Tribunal of Commerce of the Seine, in 1863 (*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 "Moniteur Universel." In the eighth year of the Republic, it became the administration organ, and so continued to be until 1815. In 1816, it resumed its official relation. In 1852, the price of the journal was reduced; and in consideration of the superior advantages to the public occasioned by the increased publicity, it received the exemption of stamp and postage duties. In 1864, the "Moniteur" made a contract with the Minister of State for four years, as the official organ. It was during this period of time that the same owners commenced the publication of an evening edition of their paper, under the title of the "Petit Moniteur," which became exceedingly profitable to its publishers. In 1866, the Minister of State, not being inclined longer to submit to the inconvenience occasioned by the duality of the journal, authorized the publication of a new official paper by the defendant, and which paper assumed the name of "Moniteur Officiel de l'Empire Français." This act of the defendant was deemed by the owners of the old-established journal to be a usurpation of title; so suit was brought. For a defence, it was urged that the plaintiffs carried the inception of their journal back no farther than 1789; while, in fact, from the year 1760, other periodical publications had appeared under the same name; and that therefore the plaintiffs could not invoke the law applicable to the first occupant. Further, that the publication had long gone under the principal title of "Gazette Nationale"; and that it was not until the year 1811 that it took for principal title the denomination of

[1] 15 Annales, 5.

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

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

§ 416. In the Tribunal Civil of the Seine, in 1869, came up a case similar in principle to the foregoing.[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 different title; and that therefore confusion between the two sheets was impossible, especially as the said journals followed two different political parties, and addressed themselves to different classes of readers. Yet judgment was rendered in favor of the plaintiff, with three hundred francs damages and costs.

[1] Halbronn *v.* Malespine, 15 Annales, 142.

§ 417. In the Tribunal of Commerce of Lyons, in 1871 (*Millaud* v. *Marian et al.*[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 francs damages and costs. In the Tribunal of Commerce of Amiens, in 1871 (*Millaud* v. *Caron*[2]), the plaintiff in the last suit found himself engaged. In this instance, the defendant took the title of "Petit Journal" for his paper, but, as a subtitle in the second line, and printed in smaller characters, added the words "de la Somme." The judgment says that the title of a journal is the exclusive property of its founder,

[1] 17 Annales, 101.

[2] Ibid. 104.

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

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

[1] 17 Annales, 104. [2] See *ante*, § 43. [3] 42 Ga. 91.

[4] This passage is worthy of attention and re-perusal, if only as a curiosity

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

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

[1] Trade Marks Journal, Jan. 13, 1877.
[2] Mitchell *v.* Henry, 15 Ch. D. 181.

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

[1] Sawyer *v.* Horn, 4 Hughes, 239.
[2] Conrad *v.* Joseph Uhrig Brewing Co., 8 Mo. App. 277.
[3] Orr, Ewing, & Co. *v.* Johnston & Co., 13 Ch. D. 463.

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

[1] 7 App. *Cases*, 210.

[2] Morgan's Sons Company *v.* Troxell, 23 Hun. 632.

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

[1] 89 N. Y. 202; 11 Abbott N. C. 86. It is worthy of note that the new trial never took place, for the reason that the defendant ceased to assert his claim to use his labels, and adopted new ones.

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

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

[1] Deneubourg-Ligier et Cliff *v.* Birkin frères, 23 Annales, 207.

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

[1] Menier *v.* Leblanc-Winckler, 28 Annales, 24.

[2] B. F. Avery & Sons *v.* Thos. Meikle & Co., Kent. L. R. and Journ., April, 1883; 23 Alb. L. J. 203.

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

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

[1] 62 N. Y. 427; 20 Am. R. 489; 2 Am. L. T. (N. S.) 482.

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

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

[1] Holloway *v.* Holloway, 18 Beav. 209.
[2] Marshall *et al. v.* Pinkham, 52 Wis. 572 (the court citing § 303 of this book).
[3] Canal Co. *v.* Clark, 13 Wall. 311; 1 Off. Gaz. 279; 5 Am. L. T. 135.
[4] Carmichel *v.* Latimer, 11 R. I. 395; 23 Am. R. 481; 16 Alb. L. J. 73.
[5] Meneely *v.* Meneely, *supra*. Clark *v.* Clark, 25 Barb. 76; R. Cox, 206.
[6] L. R. 13 Eq. 421; 41 L. J. Ch. 353; 2 L. T. (N. S.) 508; 20 W. R. 434.

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

[1] Skinner *v.* Oakes, 10 Mo. App. 45.

[2] Holmes, Booth, & Haydens *v.* The Holmes, Booth, & Atwood Manufacturing Co., 37 Conn. 278; 9 Am. R. 324.

[3] The Meriden Britannia Co. *v.* Parker, 30 Conn. 450; 12 Am. R. 401; 13 Am. L. Reg. (N. S.) 153.

[4] 42 L. T. R. (N. S.) 851; 14 Ch. D. 748.

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

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

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

[1] 47 Mich. 647.
[2] A. Boyer *v.* R. Boyer, 21 Annales, 20.
[3] For the registration law referred to, see Appendix.
[4] 20 Annales, 108.

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

[1] Pierre Bardou and Pauilhac *v.* Joseph and Léon Bardou, 23 Annales, 40.

[2] See *ante*, § 398.

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

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

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

[1] Héritiers Bobœuf *v.* Bœuf, 20 Annales, 138.
[2] Galand *v.* Galand, 27 Id. 128.
[3] Mme. Veuve Erard *v.* Nicolas Erard, 20 Id. 225.

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

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

[1] 25 Annales, 386.

[2] 49 Barb. 357; 8 Abb. Pr. (N. S.) 115.

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

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 following extract from the opinion of Sutherland, J. That Elias Howe, Jr., in 1846, obtained a patent for a certain combination of mechanisms called a sewing-machine; that his brother, the plaintiff, began 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 his manufacture used the combination of mechanisms patented by Elias Howe, Jr., as his licensee. Elias Howe, Jr. did not license the plaintiff to make sewing-machines, but 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 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 the 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

[1] 50 Barb. 236; R. Cox, 421.

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 stagger 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 the 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 cited, 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," etc. 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 cer-

tain 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 anything 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

[1] 29 Cal. 292; R. Cox, 324.

before had invented a pistol, known as "Derringer's pistol," and adopted as a trade-mark for the same the words "Derringer, Philadel.," which 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, etc. Defendant had judgment on demurrer, and plaintiff appealed. The contention made by the respondent in support of the demurrer to the complaint was, that the statute of California in relation to trade-marks 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 response 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 ques-

[1] Wheaton *v.* Hubbard, 20 Johns. 192; 13 Id. 322; Almy *v.* Harris, 5 Id. 175; Clark *v.* Brown, 18 Wend. 213.

tion to be the only one on appeal. The court was not required 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 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 farther, 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 opinion that a man may turn his surname into a trade-mark; but if we scrutinize the whole record we shall come to an opposite conclusion. It was there alleged, and not denied, that the defendant Hall had begun 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

[1] 8 Phila. 231; 3 Brewster, 509; R. Cox, 536.

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,[1] we find that the plaintiff and the defendant had been 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 com-

[1] 2 Brewster, 342; 7 Phila. 422; R. Cox, 580.

petition 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 misapprehended 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 consists 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

justice was done in every respect, except to language, by 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, etc., — 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 previous to the suit the plaintiff was a manufacturer and vendor of watches in Switzerland and Denmark. 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

[1] 2 Daly, 212; 36 How. Pr. 33; R. Cox, 434.
[2] Barrows v. Knight, 6 R. I. 434; R. Cox, 238.
[3] 24 How. Pr. 269; R. Cox, 298.

wide-spread reputation and extensive sale. It was also found that the defendant, a dealer 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 these words constituted a common-law trade-mark or not. This 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 "for the purpose of falsely representing any article to be manufactured by" a person or

[1] 21 How. Pr. 50; R. Cox, 278.
[2] 25 Barb. 70; R. Cox, 206.
[3] 2 Gray, 370.

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.[1] This not being a case falling within the principles of the common law, but resting upon a local statute, it cannot avail us in our present investigation.

§ 428. *Rodgers* v. *Nowill*[2] 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," below. 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 pareels 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*,[3] 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 Medicine," which they were in the habit of selling in boxes wrapped up in paper, which had these words printed thereon, alleged that the defendant, intending to injure the

[1] See *ante*, § 67, The Collins Co. *v.* Oliver Ames & Sons Corporation.
[2] 5 Man., Gr. & Sc. 109; 11 Jur. 1039; 17 L. J. C. P. 52.
[3] 2 Scott N. R. 449; 2 Man. & G. 385.

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, etc. *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 begun to sell 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 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.

[1] 3 Wall. Jr. 141; R. Cox, 154.

[2] 7 Penn. L. J. 176; R. Cox, 67.

[3] 13 Beav. 209.

§ 431. The Master of the Rolls (without hearing an answer) said: "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 anything 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. Among 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 in his business at the said place, upon the occasion of a disagreement left his father's service, and began to trade 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

[1] 17 Jur. 202; 22 L. J. Ch. 675; 3 De G., M. & G. 896; 21 L. T. 53.

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 for himself.

§ 434. In the Court of Paris, in 1863, (*Massez* v. *Joly*,[1]) the plaintiff, a shoemaker, had for a mark the name of "Joly," enclosed in 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 confusion in the mind of the public. The oval constituted the essence of the symbol. In the Leather Companies case, in the House of Lords, in 1865,[2] both par-

[1] 10 Annales, 318.

[2] 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. (N. S.) 513; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209.

ties 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. A 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 complainant, 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, etc. This

[1] Stonebraker *v.* Stonebraker, 33 Md. 252.

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, etc. which had been known as "Stonebraker's Medicines or Preparations," and from counterfeiting the labels, marks, etc. 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 to the person. If certain goods are associated with the shop bearing the sign of the Crescent, or the Elephant, or any other fanciful emblem, and go forth to the public bearing the stamp of the Crescent, etc., 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 imports 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.[2]

§ 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

[1] Hudson *v.* Osborne, 39 L. J. Ch. 79; 21 L. T. (N. S.) 386.

[2] See Bury *v.* Bedford, 10 Jur. (N. S.) 503; 4 De G., J. & S. 352; 33 L. J. Ch. 465; 10 L. T. (N. S.) 470; 12 W. R. 726; 4 N. R. 180.

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 Roederer & Co.* v. *Théophile Roederer*,[1] 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, etc., to be used by the defendant's firm, the name *Théophile* should be placed in letters of the same size, shape, etc. as the name *Roederer*. 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. Roederer & 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 suspect 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. Roederer & 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," etc.

Per Curiam: "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 *Roederer*, — considering that Théophile Roederer, having formed with the brothers

[1] 11 Annales, 58.

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 Roederer himself, if he has created the house on his own account. As touching the subsidiary conclusions, directing that the name of Théophile Roederer take precedence in the firm or title, marks, and labels, — considering that an association under a collective title may borrow from among themselves the 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 Roederer'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 directing 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 & Co. 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 Roederer. 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," etc.

§ 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, began the sale of a somewhat similar article of food, which he decorated with the name of "Revalenta Arabica." For a long time the competitors 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 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 *Carmoy* v. *Samson*,[2] 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, however, 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*

[1] Warton *v.* Klug, 1 Annales, 40.

[2] 17 Annales, 231.

& Co. v. *Benedictus*,[1]) 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 fraudulently to 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.[2] It was there held, that the use of a number of a street, or that 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 sells goods with his mark thereto attached as an evidence of genuineness, and the purchaser adulterates the goods, or uses the same envelope for the purpose of selling a false article, he is a counterfeiter. So where 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.[3] Or in a case like the following. A gunmaker, who manufactured rifles that had acquired a great reputation, placed his trade-mark thereon. Some of the old parts were sold as old stores. The defendants bought old parts bearing the plaintiff's mark, and fitted

[1] 12 Annales, 427.

[2] Glen & Hall Manuf. Co. *v.* Hall, 5 Alb. L. J. 109; 61 N. Y. (16 Sickels) 226; 19 Am. R. 278.

[3] Bloss *v.* Bloomer, 23 Barb. 604; R. Cox, 200.

them to rifle-barrels not of plaintiff's make. The fraud was enjoined.[1] Or where false representations are made, as in the following cases. The plaintiffs sold their brandy in casks, and also in botties, the latter being of the better quality, and placed on their bottles certain distinctive labels, etc. The defendants purchased a large quantity of the plaintiff's inferior or cask brandy, and sold it in bottles similar to those of the plaintiffs.[2] A defendant had bought a considerable number of bottles that had contained the plaintiff's bitters and which bore his marks, and sold them refilled with other bitters of his own make.[3] The French courts of justice have had opportunities to discuss this subject. In the Court of Amiens, in 1872, it was held that where receptacles, such as siphons, of gaseous waters bear the mark of a manufacturer, another in the same business has not a right to avail himself thereof for his products, although he founds his claim so to do on the constant practice of the trade, permitting the employment of siphons returned by consumers, in exchange for others sold to them.[4] In the Tribunal Civil of the Seine, in 1879, it appeared in evidence that the defendant had obtained portions of a genuine famous article, and, supplying the other portions made by himself, he marked the article thus completed with the symbol of the first inventor. He thus succeeded in foisting an inferior article on purchasers, and at the same time damaged the reputation of the owner of the mark. The court said that it was fraud to use the mark even on the genuine portion.[5] In the Tribunal Correctionnel of Toulouse, in 1881, there was a case of selling in genuine bottles invested with false labels and fluid. The defendant was held to responsibility, under Article 7 of the law of June 23, 1857, and Article 423 of the Penal Code.[6] In 1884, in the Circuit Court of the United States for the Northern District of Illi-

[1] Richards *v.* Williamson, 30 L. T. 746.

[2] Hennessy *v.* White, 6 W., W. & A'B. Eq. 221; Hennessy *v.* Hogan, Ibid. 225; and Hennessy *v.* Kennett, Cox's Man., case 556.

[3] Hostetter *v.* Anderson, 1 V. R. (1 W., W. & A'B.) Eq. 7; 1 Australian Jur. 4.

[4] Pie *v.* Poulet, 20 Annales, 46.

[5] Gogney *v.* Delanne, Ibid. 164.

[6] Ministère Public and F. Prot & Co. *v.* Carrière, 28 Id. 185.

nois, there was a similar case. The defendant had bought from old-junk deale genuine bottles that had contained "Warner's Safe Kidney and Liver Cure," and had filled them with some base concoction, and affixed counterfeits of the label. He was mulcted in damages and costs.[1] This matter will be further discussed in a subsequent section.[2]

§ 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 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.[3]

§ 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 which 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 the greater part of the stuffs of Rouen sold in America are dressed and exported.

[1] Warner *v.* Roehr, reported in Chicago newspapers of March 21, 1884.

[2] See *infra*, § 473, "Slander of Trade-Mark Property."

[3] Moniteur, May 14, 1857.

§ 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[2] or marks 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 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.

[1] 3 Duer, 624; R. Cox, 148.

[2] As to the numbers being trade-marks, see Gillott *v.* Esterbrook, 47 Barb. 455; R. Cox, 340. Com. of App. 48 N. Y. (3 Sickels) 374; 8 Am. R. 558.

§ 447. This case differs from those in which a manufacturer seeks to restrain others from placing his trade-mark upon articles made by themselves, 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. The order was 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?" "O, 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 answer was, that,

in the absence of any agreement, it could not be perceived how either an action at law or a 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. The foreign firm may protect itself in the future by selling only to known confidential retailers.

§ 449. From an examination of the foregoing illustrations, we cannot have failed to gain a general notion of the correct theory of infringements. We observe that encroachments on trade-mark rights usually have less of the characteristics of downright robbery than of mean, dissembling knavery. The craft of the fox is evinced more frequently than is the boldness of the lion. Yet 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 each side, 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 coexist 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 wrong-doer.

[1] Schrauder *v.* Beresford & Co., § 661.

§ 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 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 adopts a mark for a razor, and uses 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 adopts 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

[1] *Ante*, §§ 66–70

[2] 55 Barb. 151; 6 Abb. Pr. (n. s.) 265.

broad enough to embrace the other. This 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 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 applies 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 "Cocoïne," 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"[4] matter, 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. 102; 5 Abb. Pr. (N. S.) 212; 3 Keyes, 594.

[2] Guislain & Co. *v.* Labrugnère, *ante*, § 397. See also *ante*, § 33.

[3] Per Robertson, C. J., in Swift *v.* Dey, 4 Robertson, 611.

[4] *Ante*, §§ 68–70.

CHAPTER IX.

REMEDIES, — LAW AND EQUITY.

§ 451. Remedies of different sorts.
§ 452. Remedy at Law.
§ 453. Forgery at common law.
§ 454. Penal statutes of States.
§ 455, 456. Criminal law of Europe.
§ 457. Action on the case. — Federal statutes.
§ 458. Fraud is of essence of injury.
§ 459. Actual damage must be shown.
§ 460. Wrong to trader is twofold.
§ 461. Representations need not be immediate.
§ 462–466. Remedy in Equity. — Injunction cautiously granted.
§ 467. Preliminary injunction, — when to be granted.
§ 468. Fraud or mistake, both causes for relief.
§ 469. Discovery, Account, and Costs.
§ 470. Inadequacy of legal redress.
§ 471. Innocent vendor not required to pay costs.
§ 472. So of innocent common carrier or bailee.
§ 473. Slander of trade-mark property.

§ 451. *The Remedies against Piracy* (a term broad enough to embrace all infringements, whether atrocious or comparatively innocent) may be said to be threefold, and a single act may incur all three prosecutions. They are as follows: 1. A private action at law. 2. A suit in equity for an injunction and an account of profits. 3. A criminal action for a public wrong. A civil action, sounding in damages, may be brought by the owner of a mark, for injury done to his property therein, an unwarrantable use of the mark, or a colorable imitation thereof; or, as an indirect means of protecting the owner, an action in the nature of deceit may be brought by a purchaser who has been cheated. The remedy at law is sometimes sought under common law; but more frequently by virtue of statutes. Many of the individual States have legislated upon this subject, not only providing civil redress for infringements of trade-marks (used in a comprehensive sense), but

have also passed penal statutes for counterfeiting the same; some of which statutes prescribe severe punishments, in one case the maximum for counterfeiting being imprisonment for twenty years.[1] Chapters VI. and VII. treat of our national legislation on the subject. The civil remedies therein provided are a reaffirmance of pre-existing provisions of law and equity, and novel only in allowing an action on the case for false or fraudulent representations or declarations, whether oral or in writing, made in the Patent Office in regard to a trade-mark.

§ 452. *Remedy at Law.* — Sometimes a criminal prosecution and a civil action for the same wrongful act may proceed simultaneously.[2] An indictment for the piracy of a trade-mark registered under the act of Congress of March 3, 1881, must of course be found in a Federal court. But cases may arise where it would be preferable to indict under the law of the State where the crime shall have been committed. The reason is this: the act of Congress of August 14, 1876, which is made operative in conjunction with that above mentioned, protects only technical trade-marks; but divers of the indi-

[1] As to the penal statutes, see the following State laws: — California: Penal Code of July 14, 1872, sect. 13,350 to 13,354, Hittel's. Connecticut: Gen. Stats., Revision of 1875, p. 523. Illinois: Acts of May 2, 1873; and March 27, 1874, sects. 115, 116. Indiana: Act of March 16, 1875. Iowa: Code of 1873, sects. 4079, 4080. Kansas: Act (that took effect) May 31, 1866, sects. 1, 2. Kentucky: Gen. Stats., 1873. Maine: Rev. Stats., 1871. Massachusetts: Gen. Stats., ch. 101, sect. 55 (Act of 1850, ch. 90); also Act of June 11, 1870. Michigan: Act of Feb. 22, 1870. Nebraska: Gen. Stats. of 1873, p. 758; Nevada: Act of March 8, 1865. New Jersey: Rev. Stats. (1877), title "Crimes." New York: Act of April 17, 1862, amended 1863, ch. 209; Act of May 14, 1875, ch. 303; also Supplemental Act of June 8, 1878, ch. 401. Ohio: Act of May 5, 1877, ch. 11, sects. 23, 24. Oregon: Crim. Code of 1864, sect. 588. Pennsylvania: Act of March 31, 1860 (Brightley's Dig., 10th ed. 365); Act of 1865; Laws, p. 58; and subsequent local acts. — This list does not pretend to be complete, being here cited as illustrations of State legislation for the punishment of trespasses on trade-mark rights.

[2] As in Chicago, Ill., in 1884. The case of The People of the State of Illinois *v.* Frank Roehr, for counterfeiting the trade-marks of H. H. Warner, in a State criminal court, and that of Warner *v.* Roehr, an action on the case, in the United States Circuit Court for the Northern District of Illinois, went along *pari passu*. As the criminal offence was against both nation and State, there might also have been a third case, i. e. a criminal prosecution under the act of 1870, as the trade-mark had been registered.

vidual States have greatly expanded the local definition of the term *trade-mark*.[1] 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 *Regina* v. *J. Smith*, in England.[2] 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 genuiue 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

[1] As an example, see sect. 3196 of the Political Code of California. By it the term trade-mark includes "every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman," etc.

[2] Dearsley & Bell, 566; 8 Cox, Crim. Cases, 32; 27 L. J., M. C. 225; 4 Jur. (N. S.) 1003; 31 L. T. 135; 6 W. R. 495; 47 C. C. C. Sess. Pap. 260; 48 Id. 8.

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 *Regina* 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 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 *Regina* 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 anything 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 *Regina* v. *Closs*,[1] it was decided that painting an artist's name in the corner of a picture, in order to pass it off as an original pic-

[1] 7 Cox Crim. Cases, 494; D. & B. 460; 27 L. J., M. C. 54; 3 Jur. (N. S.) 309.

ture 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 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 anything not being the manufacture, etc. of any person denoted or intended to be denoted by such trade-mark, or not being the manufacture, etc. of the person whose trade-mark shall be forged. 3. The applying any *genuine* or forged trade-mark, with intent to defraud, to anything not being the particular or peculiar description of manufacture, etc. 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, etc. 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 Correctionnel of Rheims, in 1863, (*Clicquot* v. *Roudeau et al.*,[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, 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 al.*[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, manufacturer of champagne wine at Rheims, and to export the wine in large quantities to

[1] United States *v.* Hudson & Goodwin, 7 Cranch, 32.
[2] 10 Annales, 101. [3] 14 Id. 95.

America. In pursuance of their plan, Souris caused a mark to be engraved 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 guarantee success. The court said that the nefarious conspiracy had been organized on a vast scale. 10,000 francs damages, costs, etc. 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 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

[1] 14 Annales, 126.

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] 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 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*,[5] 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*,[6] 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

[1] See Act of March 3, 1881.
[2] *Ante*, § 356.
[3] 3 Doug. 293; R. Cox, 634.
[4] 4 Man. & Gr. 357; 5 Scott N. R. 562; 11 L. J., C. P. 301.
[5] 2 Atk. 484; R. Cox, 633.
[6] 4 McLean, 516; R. Cox, 82.

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*,[1] 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, 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*,[2] 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

[1] 12 Abb. Pr. 237; R. Cox, 282.

[2] 4 Barn. & Ad. 410; 1 N. & M. 353; 2 L. J., K. B. (N. S.) 68.

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.[1] In *Marsh* v. *Billings*,[2] 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*,[3] 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*.[3]

§ 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.[4]

§ 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*,[5] the court said, that if the defendant made repre-

[1] Hogg *v.* Kirby, 8 Ves. 215.
[2] 7 Cush. 322; 14 Monthly L. R. (4 N. S.) 604; R. Cox, 118.
[3] *Ubi supra.*
[4] Thomson *v.* Winchester, 19 Pick. 214; R. Cox, 7.
[5] 4 McLean, 516; and same case in 5 McLean, 156.

sentations 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. *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

[1] 3 Barn. & Cr. 541; 5 D. & R. 292; 3 L. J., K. B. 40.

[2] Partridge *v.* Menck, 2 Sand. Ch. 622; 2 Barb. Ch. 101; and 1 How. App. Cases, 558.

[3] 10 Jur. 1043; 2 Ph. 154; 1 Coop. 154; 8 L. T. 230–271.

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 expressing 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,

[1] Lloyd on Trade Marks, p. 17.
[2] 5 McLean, 256.
[3] 2 Sand. S. C. 599.

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*,[1] 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." Daly, J., in *The Merrimack Manufacturing Company* v. *Garner*,[2] 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 defendants' entering into an undertaking in a penalty to keep an account of their sales, and render the same when required by a competent court.[3]

§ 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*,[4] 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

[1] 3 Myl. & C. 14.
[2] 2 Abb. Pr. 318, and 4 E. D. Smith, 387.
[3] Fetridge *v.* Merchant. 4 Abb. Pr. 156; also Spottiswoode *v.* Clark, *supra*.
[4] 2 Ph. 338.

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 [1]); but the considerations which would justify a judge in renewing the discussion 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.[2] 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.[3]

§ 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*.[4]

§ 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,[5] it not being couclusive, 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 a duty to grant it without evasion.[6]

§ 468. In equity, if the defendant, without fraud, use the trade-mark of the complainant, he is still liable. If the right be

[1] Many *v.* Sizer, 1 Fish. 31.
[2] Parker *v.* Brant, 1 Fish. 58.
[3] Parker *v.* Sears, 1 Fish. 93; Goodyear *v.* Dunbar, Ibid. 472.
[4] Ibid.
[5] Ely *v.* Monson, 4 Fish. 64.
[6] Blanchard *v.* Reeves, 1 Fish. 103.

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.[1] To 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.[2]

§ 469. *Discovery, Account, and 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[3] 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,

[1] Millington *v.* Fox, 3 Myl. & C. 339; Davis *v.* Kendall, 2 R. I. 566.
[2] Coffeen *v.* Brunton, 5 McLean, 256; R. Cox, 132.
[3] Judiciary Act of Sept. 24, 1789; re-enacted, Rev. Stat., sect. 724.

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 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. As a general rule, the costs of litigation must be paid by the infringer,[2] even though he be an infant, who acted in ignorance, and who submitted at once.[3] But where defendants had innocently bought and sold, as genuine, an article which was in fact spurious, although they were restrained from infringing the complainant's trade-mark, they were not ordered to account for profits, nor compelled to pay the complainant'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 complainants ask for costs, and for something more than they are entitled to, they will lose the costs which otherwise they might have received; and if the defendants had offered to submit to the injunction and to pay the costs, and the complainants had afterwards brought the case to a hearing, he would have given the defendants costs subsequent to the offer.[4] Unfounded allegations in the bill are reasons for granting costs to a defendant, although the complainant otherwise prevailed;[5] and where a complainant has set up claims as to a copyright, and gone into the internal structure of the defendant's work, but failed on that point, the defendant pays but a half, instead of the whole, of the taxed costs.[6] So, also, although a perpetual injunction is granted,

[1] See authorities cited in 2 Abb. U. S. Cts. Practice, p. 92.

[2] Rodgers *v.* Nowill, Wigram, V. C., 6 Hare, 325. Common Pleas, 5 C. B. 109; 17 L. J., C. P. 52; 11 Jur. 1039; 10 L. T. 88. Jurgensen *v.* Alexander, 24 How. Pr. 269; R. Cox, 298. Edelsten *v.* Edelsten, 1 De G., J. & S. 185; 9 Jur. (N. S.) 479; 7 L. T. (N. S.) 768; 11 W. R. 328; 1 N. R. 300. McLean *v.* Fleming, 96 U. S. 245.

[3] Chubb *v.* Griffiths, 35 Beav. 127.

[4] Moet *v.* Couston, 33 Beav. 578; 10 L. T. (N. S.) 395; 4 N. R. 86.

[5] Pierce *v.* Franks, 15 L. J. Ch. 122; 10 Jur. 25. Rose *v.* Loftus, 47 L. J. Ch. 576; 38 L. T. (N. S.) 400. Compagnie Laferme *v.* Hendrickx, Cox's Man., case 512. McLean *v.* Fleming, *supra*.

[6] Metzler *v.* Wood, 8 Ch. D. 606.

no costs will be given, where the plaintiffs have refused the defendant's offer at their peril in respect of costs.[1] Where defendants offer to print their labels so that they could not be mistaken for the plaintiffs', both injunction and costs were refused, the defendants having acted in good faith.[2] But defendants were required to pay costs, although they had offered to submit, since they had not offered to pay costs up to the time of the offer.[3] Where a case is sufficiently open to doubt, although an injunction has been granted below, an appellate court will not give costs to either party.[4] Nor will costs be allowed to a successful but disingenuous defendant.[5] In one case,[6] although a motion was refused only because of the complainant's laches for fifteen months, the defendant was required to pay all costs of the application; and the prevailing complainant will be allowed costs, although notice was not given before filing the bill.[7]

§ 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*,[8] in 1871, by Lord Chancellor

[1] Hudson *v.* Bennett, 12 Jur. (N. S.) 519; 14 L. T. (N. S.) 698; 14 W. R. 911. Millington *v.* Fox, 3 Myl. & C. 338. Burgess *v.* Hills, 20 Beav. 244; 28 L. J. Ch. 356; 5 Jur. (N. S.) 233; 32 L. T. 328; 7 W. R. 158. Moet *v.* Couston, *supra*.

[2] Bass *v.* Dawber, 19 L. T. (N. S.) 626.

[3] McAndrew *v.* Bassett, 4 De G., J. & S. 380; 33 L. J. Ch. 566; 10 Jur. (N. S.) 550; 10 L. T. (N. S.) 442; 12 W. R. 777.

[4] Devlin *v.* Devlin, 69 N. Y. (24 Sickels) 212; 15 Alb. L. J. 290.

[5] Ainsworth *v.* Walmesley, L. R. 1 Eq. 518; 33 L. J. Ch. 352; 12 Jur. (N. S.) 205. The Leather Cloth Co. *v.* Lorsont, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. (N. S.) 661; 18 W. R. 572. Rodgers *v.* Rodgers, 31 L. T. (N. S.) 285. Estcourt *v.* The Estcourt Hop Essence Co., L. R. 10 Ch. 276; 44 L. J. Ch. 223; 32 L. T. (N. S.) 80; 23 W. R. 313. Tallcott *v.* Moore, 18 N. Y. Sup. Ct. (6 Hun) 106. Wylam *v.* Clarke, W. N. 1876, p. 68; Robineau *v.* Charbonnel, W. N. 1876, p. 160; L. J. Notes of Cas., 1876, p. 104. Fetridge *v.* Wells, 13 How. Pr. 385; 4 Abb. Pr. 144; R. Cox, 188.

[6] Cartier *v.* May, Lloyd on Trade Marks, 55, 57.

[7] Coats *v.* Holbrook, 2 Sand. Ch. 586; 3 N. Y. Leg. Obs. 404; R. Cox, 20. Pierce *v.* Franks, *supra*. Burgess *v.* Hately, 26 Beav. 249. Burgess *v.* Hills, *supra*. The Collins Co. *v.* Walker, 7 W. R. 222. Field *v.* Lewis, Seton, 4th ed., 237. Weed *v.* Peterson, 12 Abb. Pr. (N. S.) 178. Sawyer *v.* Kellogg, 9 Fed. R. 601.

[8] L. R. 7 Chanc. Appeals, 130; 41 L. J. Ch. 246; 25 L. T. (N. S.) 813; 20 W. R. 131.

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 either to 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 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." In such a case, the agent may be compelled by a court of equity to disclose the names of places to which goods having false marks have been transmitted by him, and all other information that is within his knowledge, or may be gathered from his books, *except* the names of customers, tending to redress the grievance of the complainant.[1] — An injunction having been granted to restrain a dock company from parting with wine spuriously marked with the plaintiff's mark, on motion by a third person, who had advanced money on the dock-warrants, in ignorance of the spuriousness of the marks, for the wine to be delivered to him, it was held that he was entitled to have it so delivered, on its being recorked, but that he must pay the costs

[1] Carver *v.* Pinto Leite, appeal, James and Mellish, L. JJ., L. R. 7 Ch. 90; 41 L. J. Ch. 92; 25 L. T. (N. S.) 722; 20 W. R. 134.

of the application. Romilly, M. R., said, "The dock company would have the first charge on the wine for their expenses; Mr. Uzielli the second, for his advances and his costs; and the plaintiffs the third, for their costs of suit."[1] Wharfingers, with whom spurious champagne bearing a counterfeit brand of "Veuve Clicquot, Ponsardin & Co." was warehoused, and who had notice of the injured party's intention to apply for an injunction, refused to deliver up the wine to the indorsee of the dock-warrants. *Held*, that they were justified in so acting.[2]

§ 473. *Slander of Trade-Mark Property.* — The exclusive right of user of an arbitrary symbol is property. On the faith of it, goods are sold. But if a trader's rival in business bring that symbol into doubt or disrepute, the goods bearing it are not sold. There is no just reason why the owner of the symbol, that has by adoption become a trade-mark, should not be protected. Section 9 of the act of Congress of March 3, 1881, recognizes the justice of redress, by allowing an action on the case for a false representation or declaration, oral or written, in respect to registering a trade-mark in the Patent Office. That is obviously for the reason that any statement in the nature of a libel or slander might cause doubt, confusion, and consequent loss of trade. But for such a wrongful act, there or elsewhere, redress must generally be sought in a law court. To warrant relief by injunction, it is essential that an infringement of some actual property right be shown.[3] A court of equity will not, therefore, restrain the utterance of false statements on the ground of protecting a trade-mark, inasmuch as that is not, strictly speaking, an infringement on a property right; and the rule is well established that equity will not enjoin a mere slander or libel, or the utterance of an untruth.[4] It has been said, that "words, written or oral, which falsely depreciate the

[1] Ponsardin *v.* Peto, and Ex parte Uzielli, 33 Beav. 642; 33 L. J. Ch. 371; 10 Jur. (N. S.) 6; 9 L. T. (N. S.) 567; 12 W. R. 198.

[2] Hunt *v.* Maniere, 34 L. J. Ch. 144; 11 Jur. (N. S.) 73; 11 L. T. (N. S.) 723; 13 W. R. 363; 5 N. R. 295.

[3] High on Injunctions, § 1098.

[4] Singer Manufacturing Co. *v.* The Domestic Co., 49 Ga. 70.

value of chattel property, may be made the subject of an action, provided that special damage ensue from them. The distinction between a libel or slander on a person in the way of his trade, which is actionable without proof of special damage, and words injuriously reflecting on the quality of his wares or merchandise, is sometimes rather fine."[1] But few cases are found in the books where written or oral remarks on property have been held actionable under the law of libel or slander;[2] and even then it has been held that special damage must be alleged and proved.[3] On the other hand, it has been held that a statement in a newspaper, that a ship of which the plaintiff was owner and master was not seaworthy, was a libel on the plaintiff in his trade and business, for which he might recover damages without proof of malice, or allegation of special damage.[4] And it has been held in a recent case, that the imitator of a label not amounting to a trade-mark was liable in an action in the nature of an action on the case; and that specific damage need not be alleged or proved as essential to sustain the action, but the jury might give general damages.[5] — As to *what is slander* in such cases, it may be said that every act of selling inferior goods, with an imitation of another's trade-mark thereon, is in effect a slander. The Court of Cassation of France, in 1880, held that a registered trade-mark is so far independent of the object to which it is attached that the owner thereof has a right of action against counterfeiters or imitators of that work, even when it shall be intended by the wrong-doers for, or is affixed to, a product the sale of which is forbidden by law (as, for example, a secret remedy).[6] It may readily be understood that such a use might bring a trade-mark into contempt, or make it infamous. And the slander or libel may be not the less grievous, although the imitator of a trade-mark does not affix it to goods for sale.

[1] Broom Com., 514, 764; 1 Hilliard on Torts, 342.
[2] See Lindon *v.* Graham, 1 Duer, 670.
[3] Evans *v.* Harlow, 5 Ad. & Ell. (N. S.) 624; Kendall *v.* Stone, 1 Seld. 14.
[4] Ingram *v.* Lawson, 6 Bing. N. R. 212.
[5] Conrad *v.* Uhrig Brewing Co., 8 Mo. App. 277.
[6] Dunèsme *v.* Anastay, 25 Annales, 245.

In the Tribunal Civil of Lille, in 1883,[1] this point was illustrated as follows. A judicial test had been ordered, for the purpose of ascertaining the quality of zincs employed by the defendant, a zinc manufacturer of Lille, in a certain construction. The establishment of the thickness of the zincs was an especial object of investigation, and for that purpose there was a classification of numbers on the tariffs of metallurgic companies. In the course of the testing, to support his pretensions as to the relative thickness of the zincs involved in the examination, the defendant produced a table of comparisons, and exhibited to the architect expert two coins of zinc bearing the stamp of the plaintiff company, "La Vieille Montagne," whose manufactories were in France. The court said: "Inasmuch as in the course of a contest as to the value of works executed by him, Béglim produced, as pieces of comparison with the materials used by him, pieces of zinc bearing an imprint similar to the mark of the plaintiff company, and the words 'Vieille Montagne — Paris,' the number indicating a thickness inferior to the real thickness, although it appeared that the defendant had acted without fraudulent intent, he was liable." The plaintiff was awarded three hundred francs damages and costs. The act of the defendant may be classified as slander.[2] — The Court of Appeal of England, in 1884,[3] held that an oral slander, prejudicial to one's business, may be enjoined. This is probably the first case of the kind.

[1] Société de la Vieille Montagne *v.* Béglim, 22 Annales, 62.
[2] See *ante*, § 443, "Perversion of Mark."
[3] Loog *v.* Bean, 20 Central Law Journal, 13.

CHAPTER X.

DEFENCES.

§ 474. A defence may be either affirmative or negative.
§ 475 Unlawful business, deceit, etc.
§ 476. Noxious drugs palmed off as medicine.
§ 477, 478. Complainant must come into equity with clean hands.
§ 479. "Medicated Mexican Balm" case.
§ 480. Courts will weigh the effects of misstatements.
§ 481–483. False statement as to place of manufacture.
§ 484. A bill may be dismissed for even harmless deception.
§ 485–488. False statement of intrinsic excellence.
§ 489, 490. Untrue statement as to origin.
§ 491. As to quack medicines.
§ 492. Harmless, false, or exaggerated statement not fatal.
§ 493. Imitator sometimes estopped from alleging complainant's fraud.
§ 494, 495. Fictitious name of manufacturer not necessarily fraud.
§ 496. No defence that spurious article is equal to the genuine.
§ 497. Laches may be a defence.
§ 498. What not deemed laches.

§ 474. *A Defence may be either Affirmative or Negative.*— It may be affirmative, i. e. aggressive in attacking the prior title of the suing party, or an inherent defect in the nature of the matter or thing claimed as a technical mark, or for bad faith, or for some irregularity, or for laches amounting to abandonment. It may be merely a negative defence in taking an intrenched position, asking only to be let alone. In such case, a defendant does not assert a title in himself to the trade-mark claimed by his adversary, but is content with denying the use by him of imitations of the genuine mark; or, if he has used copies of the peculiar symbol alleged to have been infringed, asserts that he did not affix it to the same class of goods, but to another class, as he lawfully might do; or it may be that, by way of mitigation, he pleads his own good faith in the act charged. 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 given to one whose case is not founded in truth.[1] That appears to have been first made use of in the case of *Hogg* v. *Kirby*, in 1803.[2] The objection taken was that the complainant, who claimed protection 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 such was in accordance with a custom of the trade. Lord Eldon, C., said that he felt a considerable difficulty as to the question, and that the custom, though it might be very usual, appeared to him very much like a fraud on the public. He nevertheless granted an injunction to restrain the defendant from publishing a magazine with a similar title, and said that the matter of misstatement should be left to form an ingredient in an action for damages.— In *Partridge* v. *Menck*,[3] in 1848, the complainant claimed an exclusive right to impose upon the public matches made by himself as those made by one Golsh; and, although the court decided the cause on the ground of dissimilarity of the labels, a strong opinion was expressed against his alleged right, on account of attempted deception. — So, also, in *Samuel* v. *Berger*,[4] where the plaintiffs asked the court to aid them in passing off watches made by them as those made by another watch-maker named Brindle, from whom they had bought authority to use his name, which had acquired a reputation. The defendants sold other watches made by Brindle before the sale to the plaintiff, and stamped with his name. The court refused an injunction, with costs, since to grant it would be to protect the sale of the spurious article, and restrain that of the genuine.

§ 475. When Congress — in the registration act of 1870,[5] and also in that of 1881[6] — declared that no action should be maintained under it, by any person claiming an exclusive right to any trade-mark used or claimed in an unlawful busi-

[1] See *ante*, § 71.
[2] 8 Ves. 215.
[3] 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 158; R. Cox, 72.
[4] 24 Barb. 163; 13 How. Pr. 342; R. Cox, 178.
[5] Rev. Stats., sect. 4943.
[6] 1 Supplement to Rev. Stats., chap. 130, sect. 8.

ness or upon any article injurious in itself, or formed and used with a design to deceive the public, it merely enunciated a well-established rule of law and equity. That had always been so; but possibly it was thought that the ill-disposed might presume on the fact of registry. In a Circuit Court of the United States, in 1847,[1] it was held that the manufacturer of a quack medicine was not entitled to the intervention of a court of equity; for it is not the office of chancery to intervene, by summary process, in controversies connected with such a matter. The refusal of an injunction was on the ground of misrepresentations by the complainant, as to the quality and properties of his medicine. In the same court, in 1855,[2] a similar ruling was made. — In 1858, the "Bloom of Youth, or Liquid Pearl," suit was brought to restrain the use of that fancy name. The defence showed that the complainant's preparation contained carbonate of lead, or other noxious ingredients, whereas he described it as being "free from all mineral and poisonous substances," and was therefore not entitled to relief. The court below refused an injunction, and dismissed the bill. The Court of Appeals of Kentucky, in 1873, affirmed the decree.[3] — The New York Court of Appeals, in 1874, in "Wolfe's Aromatic Schiedam Schnapps" case,[4] held that the plaintiffs were not entitled to the favorable consideration of a court of equity because (1.) they had endeavored to secure a part of the good-will of the defendants' business, while avoiding an infringement of their trade-mark; and (2.) that they, as well as the defendants, had improperly represented their article as not merely a spirit, but a medicinal preparation. — But an intention to deceive the public will not always be inferred from the mere fact of untrue statements.[5] — In *Hennessy* v. *Wheeler*, in 1877,[6] the New York Court of Common Pleas dismissed a complaint on the ground that the plaintiffs were themselves guilty of misrepresentation in selling, as quart and pint bottles, bottles that contained less, the defi-

[1] Fowle *v.* Spear, 7 Pa. L. J. 176; R. Cox, 67.
[2] Heath *v.* Wright, 3 Wall. Jr. 141; R. Cox, 154.
[3] 2 Bush, 131; 15 Am. R. 707.
[4] Wolfe *v.* Burke, 56 N. Y. (11 Sickels) 115.
[5] See *ante*, § 72.
[6] 51 How. Pr. 457.

ciency amounting to about seven thirtieths. The Court of Appeals, however, took a different view,[1] and *held* that, as the bottles were not sold by the plaintiffs or others as measures of capacity, but were of the ordinary sizes used in the trade, the capacity of which was generally understood; and there being no evidence that any one had been or was likely to be deceived, the plaintiffs were therefore not disentitled to relief. But the principle was conceded, although the facts did not demand its application.

§ 476. The court said, in *Smith* v. *Woodruff*,[2] speaking of the allegation that the article pirated on was itself a quack medicine, 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. But it has been held that, in a suit to restrain infringement, a defendant cannot, by alleging injurious qualities in the complainant's goods, compel him to disclose the ingredients of which they are composed.[3] In one case,[4] an inquiry on that point was allowed, but only because the complainant had opened the door thereto, in his own testimony.

§ 477. The case of *The Leather Cloth Co.* v. *The American Leather Cloth Co.*,[5] in the House of Lords, in 1865, furnishes

[1] 69 N. Y. (24 Sickels) 271; 15 Alb. L. J. 454; 25 Am. R. 188.

[2] 48 Barb. 438; R. Cox, 373.

[3] Tetlow *v.* Savournin, 15 Phila. 170; 38 Leg. Int. 478.

[4] Burnett *v.* Phalon, 21 How. Pr. 100.

[5] 11 Jur. (N. S.) 513; 11 H. L. C. 523; 35 L. J. Ch. 53; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209.

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, formed for the purpose of carrying on this manufacture 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 resumed business, and were manufacturers of leather cloth in the United States. The International Company obtained, in the month of January, 1856, an English patent for tanning the leather cloth, and devised an elaborate label, to be attached to the goods manufactured by them, which, being circular, 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, was the word "Excelsior," below which was an eagle with expanded wings, and below the eagle were printed these words: "Crockett & Co.'s Tanned Leather Cloth, Patented Jan. 24, 1856, J. R. & C. P. Crockett, manufacturers." The International Leather Cloth Company carried on business as leather cloth manufacturers, both in the United States and in England, until 1857. They used the stamp or label which has been described, as a trade-mark, affixing it to the goods which they manufactured. In 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 carried on, at West Ham, the manufacture of leather cloth, according to the process originally introduced by Crockett & Co.; and they constantly used the trade-mark described, stamping it on their goods of the first quality. In 1861, the defendants were incorporated for the purpose of the manufacture and sale of leather cloth; and they used as a trade-mark, on goods of the first quality made by them, a stamp or label which appears to have been formed upon the model of the plaintiffs' trade-mark. They did not, however, make use of the word "patented," nor did 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 as being protected by the patent, which had 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 alleged that the name or designation "Medicated Mexiçan 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 favorable 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*[2] 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.

[1] 6 Beav. 66; 1 L. T. 384.

[2] 8 Sim. 477; 6 L. J. Ch. (N. S.) 345.

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, substantially, that, 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," said he, "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 (graphite) 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 was not of such a character as to destroy

[1] 3 Am. L. T. R. (St.) 288, and 2 Brewster, 321; *ante*, § 396.

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*,[1] 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 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 conformity with the act of Congress respecting copyrights;[2] and that from that time this trade-mark had been used by him and become 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

[1] 60 Penn. 156; 8 Am. L. Reg. (N. S.) 127; R. Cox, 523.

[2] This act of entering as a copyright was a nullity in law. See *ante*, § 380.

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 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 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.[1] 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

[1] See Manhattan Co. *v.* Wood, 108 U. S. 218; Siegert *et al. v.* Abbott, 61 Md. 270; and *ante*, § 71, where this doctrine is discussed.

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 cost 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: "This is a deception,

[1] 5 Philadelphia, 464; R. Cox, 307.

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 lithographer 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; and they clearly marked it as their own production." The motion for an injunction was dismissed.

§ 485. In *Hobbs* v. *Français*,[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, began 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, labels, 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.

[1] 10 How. Pr. 567; R. Cox, 287.

§ 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," etc.

§ 487. *Per Curiam*, 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.

[1] 13 How. Pr. 385; 4 Abb. Pr. 144; R. Cox, 188.

[2] 1 How. App. Cases, 558; 2 Sandf. Ch. 622; R. Cox, 72.

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 filing the bill. It appeared by the bill that one Golsh, who formerly resided in the city of New York, began 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 color, 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 beehive 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 beehive and foliage, over which were printed the words "Menck & Backes' Friction Matches, late chemist for A. Golsh," the words "late chemist for" being in letters smaller than the rest; and under the beehive were printed in two panels the number and street in which their manufactory was situated, etc. 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 beehive was qualified by the distinct terms, "late chemist for A. Golsh," so that the article did not purport to emanate from either Golsh or his suc-

cessor. 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 Curiam*, substantially: 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 beehive, 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. Golsh was in Europe, and had no interest or agency in their manufacture. Oral 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. The order was affirmed unanimously.

§ 491. In *Fowle* v. *Spear*,[1] 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, asthma, 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: "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 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*,[2] 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.[3] In *Curtis* v. *Bryan*,[4] 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 per-

[1] *Ante*, § 475.

[2] 3 Wallace, Jr. 141; R. Cox, 154.

[3] See *ante*, § 71, on this subject.

[4] 2 Daly, 212; 36 How. Pr. 33; R. Cox, 434.

fectly safe or harmless, but that, on the other hand, it contained ingredients which are injurious and baneful to children. The court said: "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 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] also, the doctrine of estoppel was applied. Admitting, for the sake of argument, that the plaintiffs' preparation was a fraud on 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, if such it happen to be. This case was an appeal from an order dissolving an injunction restraining the defendant from

[1] 48 Barb. 438; R. Cox, 373.

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," etc. 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 *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

[1] 12 Abb. Pr. 237; R. Cox, 282.

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: "The label is manifestly one not intended to delude the public, by making any representations or asserting anything 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; 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 is 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

[1] This term is improperly used here. See definition of "trade-mark," §§ 89, *et seq.*

which their title has been so clearly established." This is the doctrine held by the court in *Stewart* v. *Smithson*,[1] in the New York Common Pleas Court, *in banc*. After issue joined, the defendants moved 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 assignees 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, on the ground that the proposed amendments contained no defence. The defendants appealed. The court, by Brady, J., said: "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." — In *McNair* v. *Cleave*,[2] it appeared that the plaintiffs were engaged in business without an act of incorporation of any kind, under the name or style of "Ga-

[1] 1 Hilt. 119; R. Cox, 175.

[2] Leg. Int., July 3, 1874.

laxy Publishing Company." The defendants took the same name. *Held*, that the plaintiffs were guilty of a fraud on the public in adopting a name calculated to mislead, and had no standing in a court of equity.

§ 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 prepares a certain kind of medicine, and designates 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 has 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.[2] Moreover, it is no defence that the marks of the spurious goods, or the words of the jobber who sells them to the retailers, inform those who purchase that the article is spurious or an imitation.[3] Such knowledge on the part of the immediate purchaser is no defence.[4]

§ 497. *Laches.* — So if a plaintiff lie by for a long time before filing his bill for an injunction, the while being aware

[1] Coats *v.* Holbrook, 2 Sandf. Ch. 586; Partridge *v.* Menck, Ibid. 622; Taylor *v.* Carpenter, 11 Paige, 292.

[2] Thomson *v.* Winchester, 19 Pick. 214; R. Cox, 7.

[3] Coats *v.* Holbrook, *supra*.

[4] Sykes *v.* Sykes, 3 Barn. & Cr. 541; 5 D. & R. 292; 3 L. J. K. B. 46. Taylor *v.* Carpenter, 2 Wood. & M. 1; 9 L. T. 514; R. Cox, 32. Taylor *v.* Carpenter, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45. Chappell *v.* Davidson, 2 K. & J. 123; 8 De G., M. & G. 1. Edelsten *v.* Edelsten, 1 De G., J. & S. 185; 9 Jur. (N. S.) 479; 7 L. T. (N. S.) 768; 11 W. R. 328; 1 N. R. 300. Glenny *v.* Smith, 2 Drew. & Sm. 476; 11 Jur. (N. S.) 964; 13 L. T. (N. S.) 11; 13 W. R. 1032. Barnett *v.* Leuchars, 13 L. T. (N. S.) 495; 14 W. R. 166.

of the encroachment, that exhibition of laches will be deemed equivalent to a want of good faith. The case of *Beard* v. *Turner*,[1] 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 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,

[1] 13 L. T. (N. S.) 747.

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 beginning 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 plaintiff must not be guilty of any improper delay in applying for relief.[3] 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

[1] 11 Jur. (N. S.) 408; 12 L. T. (N. S.) 339.

[2] 55 Barb. 151; 6 Abb. Pr. (N. S.) 265; R. Cox, 541.

[3] There can be acquiescence only where there is knowledge. Malins, V. C., in Weldon *v.* Dicks, 10 Ch. D. 247; 39 L. T. (N. S.) 467. So held, also, by Hall, V. C., in Re Farina, 27 W. R. 456.

illegally and wrongfully invaded, or threatened with injury. Injunction dissolved, with costs.[1] — Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction.[2]

§ 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 files his bill; inasmuch as it would not be safe for him to come into court until he could establish actual cases of deception.[3]

[1] This section was cited and approved by the court in McLean *v.* Fleming, 96 U. S. 258.

[2] Wallace, J., in 1885, in Estes *et al. v.* Worthington, 22 Fed. R. 822.

[3] Cave *v.* Myers, Seton, 4th ed. 238; Lee *v.* Haley, 22 L. T. (N. S.) 251; 5 Ch. 155; 30 L. J. Ch. 284; 18 W. R. 242. See *infra*, § 681, "Intention to abandon"; and also § 684 *et seq.*, "Laches."

CHAPTER XI.

DAMAGES.

§ 499, 500. When damages are recoverable.
§ 501. Damages presumed in some cases.
§ 502. No fixed and certain rule.
§ 503. Compensatory damages should be given.
§ 504. How measured.
§ 505. Must be proved from the evidence.
§ 506. Election of remedies.
§ 507. In equity, damages depend on defendant's profits.
§ 508. Intent an element in determining amount.
§ 509. Special damages must be alleged.
§ 510, 511. Plaintiff's negligence considered.
§ 512. Difficulty of determining damages.
§ 513, 514. Estimates, how made in some cases.
§ 515, 516. Rule in patent cases not applicable to trade-marks.
§ 517. Account of sales of merchandise.
§ 518. Wrong-doer not allowed to be the judge.
§ 519. Exemplary damages.
§ 520. Vindictive damages, when given.

§ 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.[1] 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.[2]

§ 501. Damages will be presumed, in some cases. Where one intentionally uses another's trade-mark on goods, — i. e. merchandise of substantially the same class as his, — the law presumes the using to have been done for the fraudulent purpose of inducing the public, or those dealing in such goods, to believe that those sold, or offered for sale, are the genuine goods of the owner of the mark. The act is deemed to be an attempt to supplant the latter in the good-will of his trade. In such a case, nominal damages will be given, although no specific injury shall have been proved, or even alleged.[3] It is not even necessary to show guilty knowledge or fraudulent intent to warrant damages.[4]

§ 502. *No Fixed and Certain Rule* for damages can be established, applicable to all cases,[5] — 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.[6] 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 cor-

[1] But see Act of March 3, 1881, sect. 9, as to an entry in the Patent Office, by means of a false or fraudulent representation, orally or in writing, *ante*, §§ 355 *et seq.*

[2] 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.

[3] Taylor *v.* Carpenter, 11 Paige, 292, and 2 Sandf. Ch. 603; Blofield *v.* Payne, *supra*; Rodgers *v.* Nowill, 5 Man., Gr. & Sc. 109; Colleen *v.* Brunton, 4 McLean, 516; Marsh *v.* Billings, 7 Cush. 322; McLean *v.* Fleming, 96 U. S. 245.

[4] Colman *v.* Crump, 70 N. Y. 573.

[5] Ransom *v.* The Mayor, 1 Fisher, 252.

[6] Bell *v.* Daniels, Ibid. 372; Derringer *v.* Plate, 29 Cal. 292.

ruption in the jury.[1] In all actions on the case, the question is, What is the amount of damages sustained?[2] 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;[3] and in estimating the actual damage, the rule is to give the value of the use of the thing during the illegal user, or, in other words, the amount of profits,[4] 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.[5] 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;[6] 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

[1] 2 Greenl. on Ev. § 255.

[2] West *v.* Rice, 9 Met. 564.

[3] Parker *v.* Helme, 1 Fisher, 44.

[4] Wintermute *v.* Redington, Ibid. 239; Page *v.* Ferry, Ibid. 298; Taylor *v.* Carpenter, 2 Wood. & M. 1. Buck *et al. v.* Hermance, 1 Blatch. 308.

[5] Nelson, J., in Guyon *v.* Sewell, 1 Blatch. 244. See also Foote *v.* Silsbee, Ibid. 445; and Seymour *v.* McCormick, 16 How. 480.

[6] Taylor *v.* Carpenter, *supra.*

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;[1] and that there was nothing peculiarly atrocious in the 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.[2] 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 damnum*; 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.[3] — The Court of Nancy, in France, in 1827,[4] held

[1] Citing Tracy *v.* Swartwout, 10 Pet. 81.
[2] Hilliard on Remedies for Torts, 404.
[3] 2 Greenl. on Ev. § 254.
[4] Germain *v.* Sevène, Huard, Marques de Fabrique, 47.

that damages should be calculated according to the loss of the plaintiff, and not according to the profits that the infringer had been enabled to make. — The Tribunal of Commerce of the Seine, in 1857,[1] held, that the infringers ought to restore to the complainants, whose property they have usurped, all the illegitimate benefits which they have realized by aid of their fraudulent practices; that they also ought to account for the profits of which they have deprived the complainants, and to repair the wrong which they have caused by the depression of the price of the merchandise manufactured, and the rise of the price of the raw material, usual and almost necessary consequences of an unlawful rivalry; they ought also largely to indemnify complainants for all they have suffered in their credit, sacrifices of all kinds to which they have been obliged to submit, and all the expenses which they have been obliged to sustain to protect their rights. On these conditions only can the great industries which honor the country, and which have too often to fight against the culpable manœuvres of infringers, maintain and defend themselves. — In the Supreme Court of California, in 1871,[2] was considered a case in which the court below had awarded as damages all profits made by the defendant, by the sale of the spuriously marked goods, and the appellate court held that the damages were not excessive. Crockett, J., in delivering the opinion, said: "Every consideration of reason, justice, and sound policy demands that one who fraudulently uses the trade-mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade-mark, on the plea that it is impossible to determine how much of the profit is due to the trade-mark, and how much to the intrinsic value of the commodity." — The Supreme Court of New York, in general term, in 1875,[3] held that there was no error in an assessment of damages by a referee, in which he found that the damages were equal to the profits which the plaintiff

[1] Tribouillet *v.* Monnier, Ibid. 48. (See also Blanc de la Contrefaçon, 682.)

[2] Graham *v.* Plate, 40 Cal. 593; 6 Am. R. 689; 4 Am. L. T. 75.

[3] Faber *v.* Hovey, Codd. Dig. 79, 249. Mr. Cox, in a note to Case 481 of his Manual, says that this case was affirmed in the Court of Appeals by a divided court.

would have made from the manufacture and sale of the same number of articles as the defendant had sold under the spurious mark. — In a Circuit Court of the United States, in 1871,[1] Dillon, J., said: "I am satisfied that the plaintiffs' sales have been lessened at least to the extent of the two hundred dozen bottles; and that their profits would have been on each case of one dozen bottles the sum of four dollars." The damages were so measured. — In another Circuit Court of the United States, in 1884,[2] Wallace, J., held that the damages should be measured by the extent to which the unlawful use of the trade-mark had interfered with sales. — Learned, J., in 1872,[3] held that damages are not recoverable against a defendant who is ignorant of the plaintiff's rights and claims. In that case the defendants had used stamps and labels of an old firm to which they succeeded, and supposed that the use was lawful. Yet a perpetual injunction was allowed. — So also, in equity, where a complainant has been guilty of laches in not enforcing his claim for a long time, he will not be entitled to damages, and may even be compelled to pay costs.[4] And where a defendant is ordered to account, he cannot be charged with bad debts as profits; and, on the other hand, he cannot charge the plaintiff with the cost of manufacturing the goods in respect of which the bad debts were incurred.[5] There are decisions in cases analogous to those of trade-marks, that lay down a rule on the point. In a Circuit Court of the United States, in 1880,[6] McKennon, J., held that the measure of damages for the unauthorized sale of a patented article is the difference between the cost price to the patentee, and the market price, where the sales were made.[7] The same judge, in 1882, in two cases where the patented designs for a carpet

[1] Hostetter *v.* Vowinkle, 1 Dill. 329.

[2] Atlantic Milling Co. *v.* Robinson *et al.*, 20 Fed. R. 217.

[3] Weed *v.* Peterson, 12 Abb. Pr. (N. S.) 178.

[4] McLean *v.* Fleming, 96 U. S. 245.

[5] Edelsten *v.* Edelsten, 10 L. T. (N. S.) 780.

[6] American Saw Co. *v.* Emerson, 8 Fed. R. 806.

[7] Affirming the master's report, which cited the controlling principle in Rubber Co. *v.* Goodyear, 9 Wall. 788; Cawood Patent, 94 U. S. 695; Pitts *v.* Hall, 2 Blatch. 229; Cowing *v.* Rumsey, 8 Blatch. 36; and Hostetter *v.* Vowinkle, 1 Dill. 329.

had been so closely imitated that they were exact copies,[1] held: "The damages are measured by the profits which would have accrued to the complainant upon the number of yards sold by the defendant. Such number of yards must, under the circumstances, be presumed to have displaced an equal number of yards of the complainant's carpets." In a case on appeal in New York, in 1884,[2] substantially the same rule was observed. A cosmetic made and sold through the defendant's agency being an infringement of the plaintiffs' rights, it was held: "The price realized from the defendant's sales, less what it would have cost plaintiffs to make and vend the quantity sold by the defendant, was a measure of damages to which defendant cannot object." But where an intention to infringe is clear beyond doubt, courts will not be over tender with a wrong-doer. In two cases in a Circuit Court of the United States, in 1882,[3] for infringing designs patented by the complainants, the copying being as exact as possible, McKennon, J., laid down a proper rule: "Under these circumstances, the respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor, founded upon the alleged inconclusiveness of the complainants' proof of loss. On the other hand, such proof ought to be considered and interpreted most liberally in favor of the complainants, within the limits of an approximately accurate ascertainment of their damages."

§ 505. But the damages must be proved from the evidence, not from mere conjecture, independent of the evidence.[4] A mere *possible* injury furnishes no ground of damages. In an English case,[5] 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 inquiry as to damages. It was held that the law would not presume

[1] Bigelow Carpet Co. *v.* Dobson, and Hartford Carpet Co. *v.* Same, 10 Fed. R. 385.

[2] Champlin *et al. v.* Stodart, Gen. Term of Supr. Ct., Fifth Depart., 20 N. Y. Weekly Digest, 223.

[3] Bigelow Carpet Co. *v.* Dobson, and Hartford Carpet Co. *v.* Same, *supra.*

[4] Carter *v.* Baker, 4 Fisher, 404.

[5] Leather, etc. *v.* Hirschfield, L. R. 1 Eq. 299; 13 L. T. (N. S.) 427; 14 W. R. 78.

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, it 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 proved 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, etc. — 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 his right. This case makes it clear and conclusive that a plaintiff may recover without proof of special damage.[2]

[1] Marsh *v.* Billings, 7 Cush. 322; 14 Monthly L. R. (4 N. S.) 664; R. Cox, 118.

[2] See Blofield *v.* Payne, *supra*. See also Rodgers *v.* Nowill, *supra*.

§ 506. *Election of Remedies.* — He whose rights are infringed has his election of remedies. He may proceed in equity for an accounting of the profits that the defendant has made, an injunction, etc., or he may sue at law for the loss that he has suffered.

§ 507. In the first case, if the defendant has realized no profit, there can be no recovery; but in the second, he may recover the damage he has sustained, whether the defendant has made any profit or not. In a patent case, 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.[1] In trade-mark cases, the rule is much the same; but in the latter, considerations are involved which do not enter into ordinary patent infringements, as, for example, loss of reputation, so that courts allow greater scope in ascertaining damages. In one case,[2] where it was impossible to apportion the profits of the defendant, he was required to lose the whole.

§ 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 actually 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,

[1] Woodruff, J., in Cowing *v.* Rumsey *et al.*, 4 Fisher, 275.
[2] Graham *v.* Plate, 40 Cal. 593; 6 Am. R. 630; 4 Am. L. T. 75.
[3] Johnson, J., in Auburn, etc. *v.* Douglass, 12 Barb. 557.

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; and though this will not altogether exonerate him, it will tend to mitigate the damages.[1] So it is in trade-mark cases.[2]

§ 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 fairly be 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 knows 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.[3]

[1] Bryce *v.* Dorr, 3 McLean, 583; Whittemore *v.* Cutter, 1 Gallison, 420; 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] Rose *v.* Loftus, 47 L. J. Ch. 576; 38 L. T. (N. S.) 409. Weed *v.* Peterson, 12 Abb. Pr. (N. S.) 178.

[3] Shaw, C. J., in Laker *v.* Damon, 17 Pick. 284.

§ 511. We may apply the doctrine thus laid down by the eminent jurist to the case of one who stands by and calmly 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, referee, or master, 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 the machine, and also of the amount of wood split

[1] 47 Barb. 455.

[2] 4 Fisher, 57.

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 that he can. If he is wrong in his calculation, the defendant can put him right. The defendant knows the profit that 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 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: "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 defendant'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

[1] 4 Fisher, 404.

[2] Ibid. 275.

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 shall be 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 arbitrary 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

[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; R. Cox, 112.

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.[1]

§ 517. 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 an entry in a defendant's book 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*,[2] told the jury that they might take into consideration the fact that the plaintiffs may have sold their articles at a higher price than the defendants had received; but yet 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 while his wrongful act was in operation and force, and which is attributable 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.[3] 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,[4] Mr Jus-

[1] Hostetter *v.* Vowinkle, 1 Dill. 329.
[2] 4 Fisher, 404.
[3] Tindal, C. J., Davis *v.* Garrett, 6 Bing. 716 (19 Eng. C. L. R. 212).
[4] 13 How. 363.

tice 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 on 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. In a Circuit Court of the United States, in 1884, in an action on the case, for counterfeiting trade-marks, Blodgett, J., instructed the jury that damages are the necessary result of the defendant's wrongful act: "the interference with the plaintiff's business, and injury to the public confidence in the genuineness of the article which the plaintiff deals in, by reason of the fact becoming known to the public that the fraudulent and simulated imitation of this medicine had been placed before the public. These are the elements of damage which you are to consider. . . . In cases of this character, where you are satisfied from the proof and from the admissions in the case, that the fraud — the intention to defraud — is at the bottom of the matter. . . . the jury are not confined to the exact monetary damages shown by the evidence, but may give what are known as vindictive or exemplary damages, for the purpose of deterring others from embarking in the same schemes of fraud or deception. . . . You are to take into consideration what has been told you in reference to the fact that his [plaintiff's] sales were diminished; that he has apparently lost something; that he was obliged to notify the public of the fact

that simulations or imitations of his goods are in the market, and notify them how to detect this simulation; you are to say what, under the circumstances, will compensate the plaintiff, and act as smart money to deter others from embarking in other similar transactions in the future." The actual damage proved amounted to only about a hundred and fifty dollars; but the verdict was for twenty-six hundred and fifty dollars. Of course costs were added.[1]

[1] Warner *v.* Roehr, reported in Chicago newspapers of March 21, 1884.

CHAPTER XII.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS.

§ 521. Several species of incorporeal property therein embraced.
§ 522, 523. Good-will, generally.
§ 524–527. On dissolution of partnership.
§ 528, 529. Name of inn, hotel, or other place of business.
§ 530. Name of companies, etc., in France.
§ 531. False representations on signs of shops.
§ 532. Prohibition against using names of former employers.
§ 533. Unfair competition in usurping names of commerce.
§ 534. French cases as to business signs.
§ 535, 536. Unfair use of names of products.
§ 537, 538. Labels and wrappers.
§ 539, 540. Property in the name of another.
§ 541. Label cases.
§ 542, 543. Improper use of the word "original."
§ 544. Words in common use.
§ 545. Trade secrets.
§ 546. Title of a book or other publication.
§ 547–553. Examples of titles protected.
§ 554–556. Misuse of another's name.
§ 557. Name of a song.
§ 558, 559. Printed publications as trade-marks.
§ 560, 561. Names and designations on coaches, etc.
§ 562–564. Secret process, breach of faith, etc.

§ 521. SEVERAL species of incorporeal rights are protected on principles similar to those on which rests the ownership of a trade-mark. Indeed, many cases embraced within the meaning of the title of this chapter have masqueraded as cases of veritable trade-marks, while essentially widely differing in nature. Such rights may consist in mere trade-names[1] of persons, places, or manufactures; or in mere labels, wrappers, styles of packages, or other means of representing goods. All such matters may, like technical marks, be intimately connected with the good-will of a business, and may be guarded

[1] See *ante*, § 91, "Trade-Name, as contradistinguished from Trade-Mark."

from invasion through the same general equitable principles.[1] Not infrequently, these various matters intermingle, as circumstances of the same case.[2] It may be necessary to apply strict definitions; and discomfiture and loss may be the result of inattention to them. Yet there are cases where claimants to a right of exclusive user of symbols have utterly failed in that regard, while the prayers for general relief have been so broad that courts of equity have been able to give ample protection against unlawful interference with business.[3] The decision of a Circuit Court of the United States, in 1885,[4] serves as an illustration of this point. Wallace, J., held that a complainant could not maintain a claim to a right of exclusive use of either the word "Disque" or "Pile-Leclanche" as a trade-mark applied to the batteries of which one or the other was the proper descriptive designation, and cited authorities for the decision that it could not be exclusively appropriated as a trade-mark therefor, even by the inventor himself.[5] He also cited authorities to show that a man's name alone is not a trade-mark, when it merely designates the kind or description of the thing being sold.[6] On that ground, the claimant failed; but the prayer of the bill was broad enough for the court to continue as follows: "The defendants have imitated the label of the complainant to the minutest details, except the signature at the bottom. The complainant is entitled to protection against the unlawful competition in trade thus engendered by the simulation of its label; and upon that ground, a decree is ordered in its favor." By the method of classification hereinafter followed, many cases are considered under one general head.

§ 522. *Good-will.* — In 1856, Romilly, M. R., said: "There is considerable difficulty in defining accurately what is included

[1] See *ante*, § 34, "Principles on which Infringement is prohibited."

[2] See *ante*, § 418, "Blending of Trade-Mark and other Rights."

[3] See *ante*, § 43, "Unfair Competition in Business."

[4] Leclanche Battery Co. *v.* Western Electric Co., 23 Fed. R. 276.

[5] Hostetter *v.* Fries, 17 Fed. R. 620; Singer Manuf. Co. *v.* Stanage, 6 Id. 270. See also *ante*, § 220, "The Necessary Name of a Product," § 220 *a*, and § 221.

[6] Singer Manuf. Co. *v.* Loog, 15 Reporter, 538; Wheeler & Wilson Manuf. Co. *v.* Shakespear, 39 L. J. Ch. 36; Young *v.* Macrae, 9 Jur. (N. S.) 322; Canal Co. *v.* Clark, 13 Wall. 311. See also *ante*, §§ 178 *et seq.*

under this term good-will. It seems to be that species of connection in trade which induces customers to deal with a particular firm";[1] "or," as Lord Eldon, C., said, in 1810,[2] "the probability that the old custom will resort to the old place"; or, as Lord Langdale said, in 1842, "It is the chance or probability that custom will be had at a certain place of business, in consequence of the way in which that business has been previously carried on."[3] — Judge Story says, quite comprehensively, that it may be described to be the advantage or benefit which is acquired by 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.[4] — Tindal, C. J., said, in 1837: "The good-will of a trade is a subject of value and price. It may be sold, bequeathed, or become assets in the hands of the personal representative of the trader."[5] — Pollock, C. B., said, in 1854: "Very frequently the good-will of a business or profession, without any interest in land connected with it, is made the subject of sale, though there is nothing tangible in it; it is merely the advantage of the recommendation of the vendor to his connections, and his agreeing to abstain from all competition with the vendee. Still, it is a valuable thing

[1] Wedderburn *v.* Wedderburn, 22 Beav. 84; 25 L. J. Ch. 710; 2 Jur. (N. S.) 674; 28 L. T. 4.

[2] Cruttwell *v.* Lye, 17 Ves. 335; 1 Rose, 123.

[3] England *v.* Downs, 6 Beav. 269; 12 L. J. Ch. 85; 6 Jur. 1075.

[4] Partnership, § 99.

[5] 6 Ad. & E. 438–454; 1 N. & P. 796–814; 2 H. & W. 464–471; 6 L. J. Ex. (N. S.) 266–269.

belonging to himself, and which he may sell to another for a pecuniary consideration";[1] and, as Wood, V. C., said, in 1859, "When you are parting with the good-will of a business, you mean to part with all that good disposition which customers entertain toward the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it."[2] — Said Romilly, M. R., in 1860: "The good-will is a valuable and tangible thing in many cases, but it is never a tangible thing unless it is connected with the business itself, from which it cannot be separated, and I never knew a case in which it has been so treated";[3] and at a later date he said, "There may be a particular species of value attached to a particular spot where a business has for a long time been carried on, and which may be an asset of the partnership of very high value."[4] — "The sale of a business is a sale of the good-will. It is not necessary that the word 'good-will' should be mentioned."[5] — But it is not every kind of good-will that may be sold; for, as was held, in 1841, the good-will of a bankrupt's trade, so far as it is personal, remains with the bankrupt, although so far as it is local it passes to the assignees in bankruptcy, and owing to peculiar circumstances such assignees may not acquire any interest in the good-will.[6] The reason of this exception may be readily understood, when it is considered that the whole value of a good-will may be inseparable from personal professional skill, as for example that of a surgeon, such being very different in nature from a commercial matter.[7] — Lord Chelmsford, C., in 1857, said: "It is very difficult to give any intelligent meaning to the term 'good-will' as applied to the professional

[1] Potter *v.* The Commissioners of Inland Revenue, 10 Ex. 147; 23 L. J. Ex. 345; 18 Jur. 778; 23 L. T. 269; 2 W. R. 561.

[2] Churton *v.* Douglas, Johnson, 174; 28 L. J. Ch. 841; 5 Jur. (N. S.) 887; 33 L. T. 57; 7 W. R. 365.

[3] Robertson *v.* Quiddington, 28 Beav. 529.

[4] Parsons *v.* Hayward, 31 Beav. 199; 31 L. J. Ch. 666; 8 Jur. (N. S.) 474; 6 L. T. (N. S.) 523; 10 W. R. 531.

[5] Shipwright *v.* Clements, 19 W. R. 599, Malins, V. C.

[6] Ex parte Thomas, Court of Review in Bankruptcy, 2 Mont., D. & DeG. 204; 10 L. J. Bankruptcy, 75; 5 Jur. 967.

[7] Farr *v.* Pearce, 3 Madd. 74.

practice of a solicitor in this abstract sense. Where a trade is established in a particular place, the 'good-will' of that trade means nothing more than the sum of money which any person would be willing to give, for the chance of being able to keep the trade connected with the place where it has been carried on. . . . But the term 'good-will' seems wholly inapplicable to the business of a solicitor, which has no local existence, but is entirely personal, depending upon the trust and confidence which persons may repose in his integrity and ability to conduct their legal affairs."[1] Said the Lord Ordinary, in the Court of Session of Scotland, in 1878: "There is truly no such thing as good-will in the case of a business carried on by a professional man, such as a physician, surgeon, or law-agent, whose success depends entirely upon his own personal skill. It is quite different in the case of a trade or manufacture, where the employer may have the possession of patents or trade secrets, or may by long exercise of his trade or manufacture in some particular locality have drawn together skilled artisans, and attracted the custom of a district to his establishment. In such a case, it is not the individual skill of the employer, but the reputation which his establishment has acquired, which creates that incorporeal, but frequently valuable, estate known as the 'good-will' of a trade. But there is no such thing in the case of a professional man. His business dies with him, and the man who comes after him in the district must depend for success upon his own exertions. It is quite true that such businesses are occasionally sold; but what is thus sold in the case of a living professional man retiring from business, is truly the personal recommendation which the seller gives to his former clients or patients in favor of his successor, coupled with the predecessor's retirement from business. But when the physician or law-agent is dead, nothing of the kind can take place." The Lord Justice Clerk concurred, and spoke of the distinction between a trade, where the individual skill of a trader has often less to do with the success of the undertaking than other circumstances connected with it, and a profession,

[1] Austen v. Boys, 2 De G. & J. 626; 27 L. J. Ch. 714; 4 Jur. (N. S.) 719; 31 L. T. 276; 6 W. R. 729.

which is only carried on with success by means of the brain and other personal qualifications of the person conducting it. Lord Ormidale said that he thought that it would be impossible to hold that a medical man's practice could be transmitted so as to be an asset of his estate. This was the decision of the court, although one of the judges dissented.[1] — Yet the Court of Appeals of Maryland, in 1870, held that the good-will of the practice of a physician could be assigned for a certain district.[2]

§ 523. The extent to which a good-will is protected is illustrated in *Crutwell* v. *Lye*,[3] 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, were 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.[4] That is merely a fair case of competition in 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.[5] Lord Eldon considered

[1] Bain *v.* Munro, 5 Ct. of Sess. Cas., 4th series, 416; 15 Scot L. Rep. 260.

[2] Warfield *v.* Booth, 33 Md. 63.

[3] In 1810, Lord Eldon, C., 17 Ves. 335; 1 Rose, 123.

[4] See also Bond *v.* Milbourn, 20 W. R. 197; Kennedy *v.* Lee, 3 Mer. 441.

[5] See also Harrison *v.* Gardner, 2 Madd. 198. Hudson *v.* Osborne, 39 L. J. Ch. 79; 21 L. T. (N. S.) 386. Witt *v.* Corcoran, 2 Ch. D. 69; 45 L. J. Ch. 603;

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. *Partnership dissolved.* — Upon a dissolution of partnership frequently comes the question, What shall be done with the good-will? As was said by Wigram, V. C., in 1842, "The whole or substantial part of a trade may consist in good-will, leading to renewals of contracts with old connections. In such a case, it is the identical source of profit which operates both before and after dissolution."[1] This term good-will has no meaning except in connection with a continuing business, and it may generally be said to be practically worthless except to the former partner desiring to continue the business.[2] In a case before Romilly, M. R., in 1865, it appeared that the complainant's husband and the defendant entered into a partnership for fifteen years, under the name of "Banks & Co." At the end of ten years B. died, and the complainant replaced him in the partnership for four years longer, when the partnership was dissolved, and the assets were divided, but no arrangement was come to with respect to the firm name. The complainant continued in the same town and in the same business, although not on the old premises, and the defendant continued the business on the old premises, each under the old name of "Banks & Co." The court refused an injunction to restrain the defendant from using the name, saying that the name or style of the old firm was an asset of the partnership, and if the whole concern and the good-will of a business had been sold, that name, as a trade-mark, would have been sold with it. If, by arrangement, one partner take the whole concern, there must be a valuation of the whole,

34 L. T. (N. S.) 550; 24 W. R. 501. Labouchere *v.* Dawson, L. R. 13 Eq. 322; 41 L. J. Ch. 427; 25 L. T. (N. S.) 804; 20 W. R. 309. Graveley *v.* Winchester, Seton, 4th ed. 257. Burrows *v.* Foster, 1 N. R. 156; 32 Beav. 18; Seton, *supra*. Williams *v.* Williams, 2 Swanst. 253; 1 Wils. 473.

[1] Willett *v.* Blanford, 1 Hare, 253; 11 L. J. Ch. 182; 6 Jur. 274.

[2] Robertson *v.* Quiddington, 28 Beav. 529.

including the name or style of the firm. But if the partners merely divide the other partnership assets, then each is at liberty to use the name, just as they did before.[1] The same judge had held in 1859, that partnership assets, including the title of a publication, must be sold for the benefit of the partners, if it were of any value.[2] The court said, in *Churton* v. *Douglas*: "The name of a firm is a very important part of the good-will of the business carried on by the firm. . . . The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from that firm; and it becomes the known firm to which applications are made, just as when a man enters a shop in a particular locality."[3] By the authority of that case, the purchaser of the good-will acquires the right, not only to represent himself as the successor of those who formerly carried on the concern, but also to prevent other persons from doing the like.[4] When a firm is dissolved, and there is no agreement to the contrary, the good-will must be sold for the benefit of the partners, if any of them insist on such sale;[5] and a court may order it to be sold or disposed of in such a manner as may be deemed most advantageous to the partners, and may permit a partner to retain it upon payment of the value thereof.[6] This is the modern doctrine, and the ruling of Lord Loughborough, C., in 1800,[7] that upon a partnership without articles the good-will survives, and that it is not an asset of partnership, is not followed; nor did Lord Eldon, C., in 1808, concur in his opinion.[8] In a case before Grant, M. R., in 1810, where there

[1] Banks *v.* Gibson, 34 Beav. 566; 34 L. J. Ch. 591; 11 Jur. (N. S.) 680; 13 W. R. 1012; 6 N. R. 373.

[2] Bradbury *v.* Dickens, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54.

[3] Wood, V. C., Johnson, 174; 28 L. J. Ch. 841; 5 Jur. (N. S.) 887; 33 L. T. 57; 7 W. R. 365.

[4] See Lindley on Partnership, 861.

[5] Bradbury *v.* Dickens, *supra;* Fenn *v.* Bolles, 7 Abb. Pr. 202; Smith *v.* Everett, 27 Beav. 446; 29 L. J. Ch. 236; 5 Jur. (N. S.) 1332; 34 L. T. 58; 7 W. R. 605; also Bininger *v.* Clark, 10 Abb. Pr. (N. S.) 264.

[6] Shepherd *v.* Boggs, 2 N. W. Reporter, (N. S.) 370; 9 Neb. 258.

[7] Hammond *v.* Douglas, 5 Ves. 539.

[8] Crawshay *v.* Collins, 15 Ves. 218.

were no articles prescribing the terms, it was held that some of the partners could not insist on taking the share of another partner at a valuation, nor retain the benefit of a clandestine renewal to them of the lease of the partnership premises, since that would be to give them the whole benefit of the good-will, but that such renewed lease must be included in the valuation of the partnership property.[1] But it was held, in 1855, that when articles of partnership provided that the surviving or continuing partner should have the option of taking over the share of the deceased or retiring partner in the partnership "property, credits, and effects," and it having been agreed that the partnership should be dissolved, and that the continuing partner should take over the partnership "stock in trade and effects" at a valuation, the good-will was not to be taken into account and valued as being included in the partnership "property, credits, and effects," or "stock in trade and effects";[2] but in 1878, under articles which provided for the valuation of the partnership "property and effects" on the dissolution, there being no negative stipulation in the articles, it was held by Hall, V. C., that the good-will must be taken into account and valued, as being included in the "property and effects";[3] and Jessel, M. R., in a similar case, at the same time held that good-will was included in the "effects and things."[4] It must be understood that when one partner sells to another a going business, every advantage arising from the fact of the sole ownership of the premises, stock, and establishment, including advantages acquired by the old firm in carrying on its business, whether connected with the old place or the old name, passes to the purchaser; but the vendor will not be prevented from carrying on a similar business, when, where, and with whom he pleases.[5]

§ 525. In *Peterson* v. *Humphrey*,[6] it was held that an injunction will lie, at the suit of one against his former copartner,

[1] Featherstonhaugh *v.* Fenwick, 17 Ves. 208.

[2] Hall *v.* Hall, 20 Beav. 139.

[3] Reynolds *v.* Bullock, 47 L. J. Ch. 773; 39 L. T. (N. S.) 443; 26 W. R. 678.

[4] Rolt *v.* Bulmer, W. N. 1878, p. 119.

[5] The McGowan Bros. Pump Machine Co. *v.* McGowan, 2 Cincinnati, 313.

[6] 4 Abb. Pr. 394; R. Cox, 212.

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 on 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*,[1] 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 "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

[1] 10 Abb. Pr. 204; 19 How. Pr. 14; 6 Bos. 354; R. Cox, 244.

"Howe's Bakery." *Held*, that this was no recognition of the vendee's claim to use the name "Howe." On appeal from the judgment in the 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. The court 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. — This decision fully accords with the law of France in relation to commercial partnerships. By the 21st article of the Code of Commerce, the names of associates only can constitute the firm name (*la raison sociale*). This is intended to prohibit persons who succeed to the business of a deceased merchant from continuing it under his name. "Credit," said Hoffman, J., in commenting upon that 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 theory 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

[1] See the case of Compère *v.* Bajou *et al.*, *ante*, §§ 209-211.

[2] Story on Partnership, § 100; 2 Story on Eq. Jur., § 951; Eden on Inj., ch. 14; Motley *v.* Downman, 3 Myl. & Cr. 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; 4 L. J. Ch. (N. S.) 258.

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 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. *Douglas*,[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. *Douglas*[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 Douglas & Co." Four months afterwards, the defendant again set up his old business, in partnership

[1] See *ante*, § 525.
[2] 5 Ves. 539.
[3] 1 Hoffm. Ch. R. 68.
[4] Williams *v.* Wilson, 4 Sandf. Ch. R. 379.
[5] Trade Marks, 35.
[6] Johnson, 174; 7 W. R. 305.

with other persons, under the firm of "John Douglas & Co." 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 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.

§ 527. In the Tribunal of Commerce of Paris, in 1857, (*Bautain* v. *Mercklein*,[1]) it appeared that Bautain and wife had sold to Mercklein 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 a different 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 *Mercklein, 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, etc., 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 forbade the respondents Mercklein to inscribe the name of Bautain on their invoices, addresses, and signs, otherwise than as successors of the said Bautain and 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*,[2]) it appeared that the plaintiff, Gustave Laurens, had, ever since

[1] 3 Annales, 207.

[2] 8 Id. 221.

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 Bordeaux, in 1865, (*Caminade & Co.* v. *Caminade*,[1]) 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 evidence 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 anything 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, etc. 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* v. *Pineau*,[2]) 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 Rue Richelieu, in Paris, by Juste Pinaud; and that the defendant quitted another street formerly occupied by him, and established a hat-store at No. 91 Rue Richelieu. It was charged that he did this to profit

[1] 13 Annales, 268.

[2] 4 Id. 86.

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 curiam:* "Whereas Pinaud & Amour are proprietors of a hat establishment in Paris, in Rue Richelieu, 87, and known for twenty-five years under the name of 'Maison Pinaud'; and whereas Pineau, a hatter previously of the Rue 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 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 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 the Rue Richelieu and the other on the Rue Saint-Marc, he had placed his surname on

one street, and his baptismal name on the other, so that passengers on the Rue Richelieu, who were more numerous than those on the Rue Saint-Marc, 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 al.* v. *Henry Delisle*,[1]) it appeared that the sign of "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 anything 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 *Ternaux* v. *Bournhonet*,[3]) 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 name of an inn, hotel, or other place of business, where the sign or the name is simulated so as to deceive, or is 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 suggestion of falsehood. If a man creates a reputation for his business, it is as the keeper of some particular house at a

[1] 4 Annales, 801. [2] Ibid. 330. [3] Ibid. 331.

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*.[1] 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*.[2] 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*.[3] Even although one's place be designated by two names indiscriminately, a colorable imitation of the title will be enjoined.[4] — The name "What Cheer," as a sign for a restaurant, was held to be infringed by that of another afterwards established near by, reading, "New and Original What Cheer Restaurant";[5] as was the sign "Carriage Bazaar," by the change of a rival's sign from "Carriage Repository" to "New Carriage Bazaar."[6] But the sign "IXL General Merchandise Auction Store" was held not to be infringed by the sign "Great IXL Auction Co.";[7] nor that of "Station Hotel" by one of "The Royal Station Hotel";[8] and no exclusive right can exist in a name alleged to be infringed by a sign of "Civil Service Boot Supply."[9]

§ 529. In France this protection is frequently granted. In the Tribunal of Commerce of the Seine, in 1857, (case of *Dorvault* v. *Hureaux*,[10]) the plaintiffs had for about twenty-five

[1] 21 Cal. 448. So also in France: Boudet *v.* Berdin *et al.*, 24 Annales, 67.
[2] 28 How. Pr. 120.
[3] 12 How. Pr. 77.
[4] Howard *v.* Henriques, 3 Sandf. S. C. 725.
[5] Gamble *v.* Stevenson, 10 Mo. App. 581.
[6] Boulnois *v.* Peake, W. N. 1868, 95; 13 Ch. D. 513 n.
[7] Lichstein *v.* Mellis, 8 Oreg. 464; 34 Am. 592.
[8] Charleson *v.* Campbell, 4 Sess. Cas., 4th series, 149; 14 Scot. L. Rep. 104.
[9] Civil Service Supply Association *v.* Dean, 13 Ch. D. 512.
[10] 4 Annales, 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. *Hogg*,[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. 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 further to 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]) 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 Rue de la Paix and the Boulevard des Capucines. The defendants built a hotel on the same boulevard, and gave it the same name as the plaintiff's. The

[1] 4 Annales, 223. [2] Ibid. 255. [3] 5 Id. 360. [4] 8 Id. 205.

court below — the Tribunal of Commerce of the Seine — had declined completely to 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, etc., of the new hotel were thus marked; and the letters "H. P." — an abridgment of the sign — were engraved upon the glass-ware, the bottles, and the plate. The defendants answered 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. There are other French cases that convey instruction on this point of conflicting signs. In the Tribunal of Commerce of the Seine, in 1880, came up a case of two fire-insurance companies, — *La Fraternelle Parisienne* v. *La Parisienne*.[1] "La Parisienne," founded in 1837, was united in 1858 with "La Fraternelle," and the two united companies took the title of "Fraternelle Parisienne." In 1880, "Le Globe," a company insuring against hail-storms, changed its name and took the denomination of "La Parisienne." The use of the same was enjoined, although the risks were different in character. The French sometimes carry their sentiments of good-will protection pretty far, as in a case in the same court, in 1881, *La Nationale* v. *La Société Nationale*.[2] The plaintiff was a life and fire insurance company, and the defendant a military insurance company against accidents. They both carried on business in the city of Paris, but their respective establishments were not near each other, and the natures of their transactions were not similar. The demand was that the sign bearing the defendant's name should be taken down, as likely to cause confusion. It was so adjudged.[3] — Variations in names do not always shield the borrower, if the courts can reasonably infer a liability to mislead. In the same court, in 1882, — *Banque du Commerce et de l'Industrie* v. *Banque Centrale du Commerce et de l'Industrie*,[4] — it was held that the simple addition of a word was not sufficient to avoid confusion. — In the same court, in the same year, — *Banque Populaire* v. *Banque Populaire d'Escompte*,[5] — the same rule was applied. — In the same court, in 1884,[6] the plaintiff's sign being "Entrepôt d'Ivry," the defendant in the same business took for the same purpose "Chantier du Grande Ivry." The court said that a merchant is not permitted so to designate his establishment, even with a qualification of his residence. To avoid confusion in the mind of the public, the defendant

[1] 20 Annales, 232.

[2] 24 Id. 190.

[3] The late M. Pataille, who was certainly eminent authority in such matters, as an editor dissented from the view taken by the court. 24 Annales, 191.

[4] 29 Annales, 231.

[5] Ibid. 234.

[6] Names of parties not given in the report. 1 Bulletin Officiel, 222.

was ordered to change the sign, the court saying that he could not lawfully make use in his business of invoices of the same color and dimension, nor even of postal cards bearing the same disposition of matter as those of his rival. Indeed, the Imperial Court of Paris, in 1853, — *Lebat* v. *Partongue*,[1] — held that the color of a sign and its general aspect are considered as sufficiently distinctive to be respected.

§ 531. *False Representations on Signs, etc. of Shops.* — These matters, if calculated to induce the public to believe that the owner is connected in business with a firm of established reputation, will be considered upon the same principles as govern rights in trade-marks. In *Glenny* v. *Smith*[2] it appeared that the defendant 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 the rest, and in smaller letters. On the part 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. An injunction was granted. The same rule was

[1] Blanc, 700.

[2] 11 Jur. (N. S.) 964; 2 Drew. & Sm. 476; 13 L. T. (N. S.) 11; 18 W. R. 1032; 6 N. R. 363.

applied in England in later cases.[1] In *Boswell* v. *Mathie*,[2] in Scotland, in 1884, it appeared that the defender, who had set up in the same business as her former employer, had placed her own name on the blinds of her shop, adding the words "from Boswell." She pulled up the blinds so as to exhibit no part of the inscription except the name "Boswell." On labels, bill-heads, etc., she styled herself "late manager to Boswell." She was interdicted on the ground that her actions were misleading as to the blinds, and untrue as to the labels, etc.

§ 532. In the Tribunal of Commerce of the Seine, in 1857,[3] the defendants, who had been employed by M. & P. at No. 3 Boulevard des Capucines, established themselves at No. 11 on the same street. On a sign, they announced themselves as "ex-artists of the house of M. & P., when they had the honor to paint the photographic portraits of their Majesties, the Emperor and the Empress," etc. After suit brought, they abandoned the words "ex-artists of the house of M. & P.," but retained the remainder. They contended that, as they had performed the work, they had a right to say so, as their artistic talent was their own, and they could assert authorship of the portraits, which they had painted in the work-shop of their old employers. Held, that they had no right to use the name of their old employers; and that no artist or employee of a business house could claim a right to preserve his individuality in work so done. The Court of Paris, in 1863,[4] decided that an apprentice or workman has no right to announce himself as a pupil of his former employer, on establishing a business for himself, except with the consent of his employer. In the same year, the Tribunal of Commerce of the Seine[5] held, that a purchaser of a business may maintain an action to restrain the former pupils and employees from naming themselves as such on signs or manufactures, even though after the sale the

[1] Scott *v.* Scott, 16 L. T. (N. S.) 143; Cave *v.* Myers, Seton, 4th ed. 238; Hookham *v.* Pottage, L. R. 8 Ch. 93 *n.*; 26 L. T. (N. S.) 755; 20 W. R. 720; L. R. 8 Ch. 91; 27 L. T. (N. S.) 595; 21 W. R. 47.

[2] 11 Sess. Cas., 4th series, 1072.

[3] Mayer *et al.* *v.* Herlick *et al.*, 3 Annales, 63.

[4] Rommetin *v.* Crotte, 9 Annales, 173.

[5] Dubois *v.* Demoiselles Louise and Lucille, 10 Id. 187.

former manufacturer authorized them so to do. The same court, in 1864, reasserted that principle.[1]

§ 533. Unfair competition in business is sometimes evidenced by usurping a name by which the commerce of a rival is known. If the "Lackawanna" case[2] could have been maintained, it would have been on the ground of unfair competition, for the name was not actually affixed to the coal. In a case in Scotland, in 1879,[3] the following state of facts appeared. Coal from the Lochgelly collieries had for many years been known as "Lochgelly Coal," and was the only coal so known in the market; although there was a seam known as the "Lochgelly Splint Seam," which was not confined to the Lochgelly collieries, but extended under other regions. An interdict was granted against the use of the name "Lochgelly" to designate coal wrought by the respondents, except from their part of the Lochgelly Splint Seam, and then only under the designation of "Lumphinnans Splint Coal, Lochgelly Seam." In principle, this is like the "Akron" case.[4] — In another Scotch case, in 1883,[5] the pursuer, Dannachie, had registered the name of his locality, "Glenboig," as his trade-mark for bricks. The respondents, who were located more than two miles from Glenboig, stamped their bricks "Young's Glenboig." They were interdicted. — In the same country, in 1884,[6] there was another case of the same class as the "Lackawanna." The pursuer and his predecessors, for more than ninety years, at Dalmore, manufactured stones and hones for sharpening edge-tools, and for polishing, under the so-called fancy name of "Water of Ayr Stone." This stone, under that designation, became famous all over the world. It had been registered as a trade-mark. The defenders sold, in the same markets, a similar product, by the same name. They pleaded that their place, like the pursuer's estate of

[1] Fould *v.* Honegger, 10 Annales, 328.

[2] Delaware & Hudson Canal Co. *v.* Clark, 13 Wall. 311.

[3] Lochgelly Iron & Coal Co. *v.* Lumphinnans Iron Co., 6 Sess. Cas., 4th series, 482.

[4] *Ante*, § 182.

[5] Dannachie *v.* Young & Sons, 10 Sess. Cas., 4th series, 874.

[6] Montgomerie *v.* Donald & Co., 11 Id. 506.

Dalmore, is bounded by the river Ayr, and only separated from Dalmore by the glebe land of the parish church. The so-called fancy name was held to be merely generic. — In a case in Ireland, in 1879,[1] it was shown, that at Belfast there are numerous springs of pure water, commonly known as "Cromac Springs," much used in the manufacture of aerated, waters. The plaintiffs, who had one of these springs on their premises, had adopted and registered the name "Cromac" as a trade-mark. Whether any right to a trade-mark therein existed or not, the defendant was enjoined against the use in his business of these words: "Please observe the address, The Erin Mineral Water Company, Cromac Springs, Belfast." The name "Cromac Springs" in the print was in larger type than the rest of the sentence, and therefore likely to deceive. — But it is not always that courts can remedy complaints on this score. In the United States Circuit Court for the Northern District of Illinois, in 1885,[2] the court was asked to prevent a corporation from unjustly being formed under the name of the complainants, a foreign corporation. Gresham, J., said: "The object of the defendants in causing an Illinois corporation to be created, bearing the same name as the complainant company, is obvious. They hope by this means to secure the benefit of part, at least, of the patronage which the complainant has acquired. Unwilling to engage in open, manly competition with the complainant and others carrying on the same business, the defendants resort to a trick or scheme, whereby they hope to deceive the public, and obtain an unfair advantage of the complainant. Such conduct might be fairly characterized more harshly; and it is with extreme reluctance that I deny the complainant the relief prayed for." Whether relief could be granted after the creation of the corporation, in fraud of the rights of the complainant, was not determined. Another case of the same kind met the same fate.[3] — The following sharply defined ruling, in 1879, was perhaps owing to the technical prayer of the bill. A manu-

[1] Wheeler *et al.* *v.* Johnston, 3 L. R. (Ireland) Ch. D. 284.
[2] Lehigh Valley Coal Co. *v.* Hamblen, 28 Fed. R. 225.
[3] Pennsylvania Coal Co. *v.* Douglas *et al.*, Ibid. 226.

facturer of stoves and ranges not patented placed upon each of these stoves and ranges a name and a number, and also placed upon such of the separate parts, respectively, as were liable to be worn out rapidly, the initial letter and the number of the stove or range to which it belonged. Every one of these parts was well known, had acquired a high reputation, and was sold under the name of the letters and numbers placed on it. The defendant procured some of these parts, made patterns from them, and cast from the patterns parts of the stoves and ranges, inferior in quality to those of the plaintiff, but having their peculiarities of ornamentation, lettering, and numbering; and advertised these parts for sale as manufactured by himself, describing the parts by the name used by the plaintiff to designate them. At first, the case looks like one in which relief should be granted on the ground of unfair competition. But the Supreme Court of Massachusetts, in 1879, held otherwise; and in refusing an injunction, reasoned thus: "It appears that the numbers were used by the plaintiff and the defendant as they were used by manufacturers generally, to indicate a size or measurement: they form no part of the trade-mark. The letters, in some instances a single letter, in other instances two letters, are in no case the trade-mark which the plaintiff described in the bill, and cannot be regarded as likely, when considered by themselves, to mislead a purchaser into supposing that they were the trade-marks described in the bill."[1] This was therefore decided on fact.

§ 534. In the Tribunal of Commerce of the Seine, in 1867, (*Mondin & Co.* v. *Sari et al.*,[2]) it appeared that the plaintiffs had adopted, as a sign to indicate the nature of their business, the words "Agence des Théâtres." It was held that another, in the same line of business, who had adopted as his sign the words "Office des Théâtres," did not infringe upon any right, the words being generic and common. It was no answer, that the words might lead to confusion. — As an example of the judicial suppression of a fancy name upon a shop sign, we

[1] Magee Furnace Co. *v.* Le Baron, 127 Mass. 115.

[2] 14 Annales, 352.

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, "À 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. — In *Regnard* v. *Perrier*,[2] in the Court of Paris, in 1879, the same sign seems to have been infringed. The defendant, a retailer of tobacco and liquors in the Avenue de l'Opera, (Bureau No. 226,) took for a sign "À la Civette." The plaintiff, proprietor of the tobacco bureau situated in front of the Théâtre Français and of the Palais Royal, summoned him before the Tribunal of Commerce of the Seine, for the purpose of having the obnoxious sign suppressed, and to obtain damages for the trespass on his rights. The plaintiff prevailed, and the sign was ordered to be removed within a week's time, with damages and costs. On appeal, the decision was affirmed.

§ 535. It is unfair competition to indicate an industrial product under a name very similar to that of another's product, in such manner as to create confusion. In a case[3] in the Tribunal Civil 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 garmen' 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 be-

[1] 11 Annales, 350.
[2] 26 Id. 110.
[3] Berthelon v. Vergé, 11 Id. 349.

tween 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. — In the Tribunal Civil of the Seine, in 1875,[1] it appeared that the defendants were proprietors of a ready-made-clothing house in Paris, called "Maison du Pont-Neuf." They placed on sale a certain over-garment called the "Montagnac," for nineteen francs. Among numerous catch-words inserted by them in the Figaro, of Paris, they announced that the bureaux of the Mont-de-Piété were filled by an avalanche of "Pardessus Montagnac," intimating that the garments were pawned for twenty-five francs each, and that measures had been taken to stop the continuation of the traffic. MM. de Montagnac, manufacturers of cloth at Sedan, thought that the use of their surname, honorably known in the fabrication of cloth, prejudiced them, in causing the belief that the common cloth worked up by the defendants issued from their manufactory; and demanded that the name of Montagnac be removed from the hand-bills, and from catch-words employed by the defendants. It was so adjudged, with damages, etc. — In the same court, in 1877, this case came up.[2] The plaintiff was proprietor of a house of the name "La Maison de l'Aluminium." He engraved the name on the inside cases of watches for sale, and also on all other articles of his manufacture, by way of a trade-mark. The defendant, a watch-maker, sold watches of aluminium quite like those of the plaintiff, and bearing on the inside case the same name. It was held that the words "La Maison de l'Aluminium," being the name of a house of commerce, did not constitute a trade-mark, but merely a sign, even though they were affixed to the goods; but that it was a clear case of unfair competition. — In the Court of Douai, on

[1] Montagnac *v.* Halphen & Co., 20 Annales, 95.
[2] Testevuide *v.* Girault, 23 Id. 45.

appeal, in 1876, there was a cause[1] of the same nature as the "Akron" case.[2] For more than twenty years, the plaintiff was a manufacturer of cement at Boulogne-sur-Mer, and his product was all the time known as "Ciments Portland de Boulogne-sur-Mer." In 1875, the defendant set up works at Desvres, eighteen kilometres from the plaintiff's place of manufacture. In his labels, prospectuses, and letter-heads, he used the denomination "Ciments de Boulogne-sur-Mer," the geographical name being printed in bold lettering, while the words "Usines de Desvres" were in minute letters. The qualification as to the place of the works, did not save him from a judgment of unfair competition, in both courts. — So also in the Tribunal of Commerce of Nantes, in 1880,[3] in a case in which the defendant sought to deceive the public into believing that sardines, put up by them at another place, were those put up at Nantes, where the plaintiff had his business. The boxes were similar to those of the plaintiff. The words "Fabriquées comme à Nantes" were intentionally printed in such small letters as to be almost imperceptible. — In the Tribunal of Commerce of the Seine, in 1881,[4] it appeared that the plaintiff at Menat manufactured a tripoli, from a product taken from ores (*minières*) of the locality, which he sold under the name of "Minière de Menat." The defendant sold his product under the name of "Tripoli Roses des Minières de Menat," although he did not manufacture the same from material taken from Menat. He was forbidden to use the name, or one like it, under a penalty of 1,000 francs for each infringement; and the plaintiff was awarded 1,000 francs damages and costs. — But to entitle one to claim protection in the use of the name of a place, he must there have his principal place of business. In the Court of Cassation of France, in 1884, on final appeal,[5] it appeared that the plaintiffs below had their principal place of business at Jarnac, fourteen kilometres from Cognac, and at the latter had merely a cheap, rented place;

[1] Lonquéty *v.* Fanchon & Co., 21 Annales, 317.
[2] *Ante*, § 182.
[3] Pellier *et al. v.* Trottier frères *et al.*, 27 Annales, 357.
[4] Voivet *v.* Scoppine, 28 Id. 47.
[5] Louis Foucaud & Co. *v.* Lucien Foucauld & Co., 30 Id. 18.

while the defendant was truly located there. Although the plaintiffs had incorporated the name "Cognac" into their signs, labels, etc. as long before as 1862, the continuous use did not serve them.

§ 536. The reflecting reader must perceive that many matters, cited and commented on in foregoing chapters, might properly have been embraced in this chapter; and they would have been so, but for the reason that courts discussed them as trade-marks. It is undeniable that the line of demarcation between technical symbols of merchandise and quasi marks, or mere business indications, is not always clearly distinguishable.[1] But, as is said by an English writer, "All such cases, whether of trade-mark or trade-name, or other unfair use of another's reputation, are concerned with an injurious attack upon the good-will of a rival business; customers are directed from one trader to another, and orders intended for one find their way to the other."[2]

§ 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,[3] and the good-will of a business embodied in labels and wrappers will be protected on principles applicable to trade-mark infringements.[4] Even advertisements containing verses used by another in his trade have been suppressed.[5]

§ 538. *Croft* v. *Day*[6] is a very important case under this head. The quasi trade-mark there consisted in the name of

[1] See *ante*, § 52 and notes; also Linde *v.* Bensel, 22 Hun, 60.
[2] Sebastian's Law of Trade Marks, p. 12.
[3] Lloyd on Trade Marks, p. 30.
[4] Peitz *v.* Eichele, 62 Mo. 171.
[5] Sedon *v.* Senate, cited 2 V. & B. 220.
[6] 7 Beav. 84.

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 buying his blacking as and for that of the original firm. The Master of the Rolls, in his decree, observed 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 and sold 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 the alteration, being only colorable, showed that the defendant intended to avail himself of the favorable reputation acquired by the "Chinese Liniment." An injunction was granted to enjoin him from using 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, * Lowell, Mass."; and that of the defendant, "English Free Trade, Merrimack Style,

[1] 4 McLean, 516.

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

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 at special term granting an injunction was, therefore, affirmed at general term. — *Newman* v. *Alvord*[2] is no better 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. — *Falkinburg* 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 possessed 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.[4]

[1] 12 Abb. Pr. 237.
[2] 49 Barb. 588.
[3] 35 Cal. 52.
[4] See *ante*, § 452, note 2.

Comprehensive as is the language of that statute, and palpable as was the imitation of the plaintiff's label, the Supreme Court of California held that the label contained no peculiar names, marks, etc., 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. Probably the fault lay in the narrowness of the prayer. — 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 that was a question not necessarily involved in the case. It is apparent, at a glance, that neither of the 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. The court said: "Have the petitioners suffered dam-

[1] 35 Conn. 402.

age? On this point, there is no room for doubt. . . . Their motive is apparent. They may succeed in reaping some advantage from the numbers [2340] 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 Neufchâtel, 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-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

[1] 8 Annales, 297.

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 or trade-name.[1]

§ 540. *Colton* v. *Thomas*[2] 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 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," on 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. 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 each other. The material portions of the lettering required a careful inspection for one to notice any difference between them. They hung in the same manner, on the same side of the street, and might readily be mistaken the one for the other, especially by sufferers, impatient for relief. The

[1] Oakes *v.* Tonsmierre, 4 Woods, 547; Skinner *v.* Oakes, 10 Mo. App. 45; Filkins *v.* Blackman, 13 Blatch. 440; Fulton *v.* Sellers. 4 Brewst. 42; Booth *v.* Jarrett, 52 How. Pr. 169.

[2] 2 Brewst. 308.

same might, to some extent, be said of the cards. An injunction was granted.

§ 541. *The Dixon Crucible Co.* v. *Guggenheim*[1] is purely a 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.[2] The defendant was enjoined against the use of the name "Dixon," to which he had no right or title. It was not pretended that this was a case of a common-law trademark. — In *Blofield* v. *Payne*,[3] 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 damages. — In *Holloway* v. *Holloway*,[4] 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 *Edelsten* v. *Vick*,[5] the defendant used labels in palpable imitation of the plaintiff's, and was restrained.

§ 542. The original producer, and persons claiming under him, are exclusively entitled to designate the same as "the original." This principle has been recognized in a number of cases. Thus a defendant was restrained from selling his sauce under the name of "The Original Lazenby's Harvey's Sauce."[6] — A sauce was invented many years ago by James Cocks, of Reading, and named by him "Reading Sauce,"

[1] 3 Am. L. T. R. (St.) 283; 2 Brewst. 321.
[2] Act of March 31, 1860, sect. 173.
[3] 4 Barn. & Adol. 410.
[4] 13 Beav. 209.
[5] 18 Jur. 7.
[6] Lazenby *v.* White, L. R. 6 Ch. 89; 19 W. R. 291.

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 with labels which always bore the words "The Original Reading Sauce." The plaintiff's label was imitated in part; but he admitted that the only thing to which objection could be taken was the use of the words, "The Original."

§ 543. The defendant alleged that the sauce manufactured by him was 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 Cocks'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]

[1] Cocks *v.* Chandler, L. R. 11 Eq. 446; 40 L. J. Ch. 575; 24 L. T. (N. S.) 370; 19 W. R. 593. See also, to the same effect, Fullwood *v.* Fullwood, 9 Ch. D. 176; 47 L. J. Ch. 459; 38 L. T. (N. S.) 380; 26 W. R. 435.

§ 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*.[1] The selection of boxes, sizes, colors, 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. *Trade Secrets.* — These are personal assets, as was held by Lord Hardwicke, C.[2] The improper use of a secret will be restrained. While an inventor has no exclusive right to his secret, as against the public, especially those who in good faith have acquired a knowledge of the secret, nevertheless he has a good property in it, which a court of equity will protect against one who, in violation of contract and in breach of confidence, tries to apply it to his own use, or to disclose it to others. This is a well-established point.[3] A trader may sell a secret of business, as, for example, a mode of dyeing, and restrain himself generally from using that secret;[4] and after the dissolution of a firm, a partner, who had become acquainted with a secret recipe, through a breach of confidence on the part of a third person, was restrained at the suit of the legatees of the secret;[5] and he may be restrained if, after lawfully obtaining the secret, and selling the good-will to his co-partners, he sets up in business for himself, and attempts to impart the secret to his workmen.[6] But under peculiar cir-

[1] 47 Barb. 455.

[2] Gibblett *v.* Read, 9 Mod. 459.

[3] Peabody *v.* Norfolk, 98 Mass. 452; 2 Story Eq. § 952. See *infra*, § 562.

[4] Bryson *v.* Whitehead, 1 S. & S. 74; 1 L. J. Ch. 42.

[5] Morison *v.* Moat, 21 L. J. Ch. 284; 16 Jur. 321. To the same effect, see Ansell *v.* Gaubert, Seton, 4th ed. 235; Weston *v.* Hemmons, 2 Vict. L. R. Eq. 121.

[6] Hagg *v.* Darley, 47 L. J. Ch. 567; 38 L. T. (N. S.) 312.

cumstances injunctions will be refused, as where the defendant had been in the service of the complainant, the proprietor of a secret medicine, and began to make and sell an imitation.[1] Lord Eldon, C., once said, "I do not think that the court ought to struggle to protect this sort of secrets in medicine";[2] and, at another time, he refused an injunction to restrain the defendant from violating an agreement not to divulge the secret of a medical preparation, on the ground that, if there were a real secret in question, the court could have no means of interfering to enforce its order.[3] It is well settled, that whoever can in good faith discover a secret recipe may make and vend the article.[4]

§ 546. *Title of a Book or other Publication.*— There are not a few cases in which the use of some particular title, not amounting to a technical trade-mark,[5] has been restrained by injunction. While the title of a book, newspaper, or other printed publication for sale, may possess all the essential characteristics of a technical mark, it is frequently otherwise; and yet to prevent an unwarranted or fraudulent interference with the publisher's good-will right, courts of equity will intervene. Sebastian very properly says,[6] that, although the term copyright has been inadvertently applied to the right in the title of a publication, — as, for example, by Lord Romilly, M. R., in *Mack* v. *Petter*,[7] in which he said, "The plaintiff is entitled to a copyright in the use of the title 'Birthday Text-Book,'" — there is no copyright therein. Wood, L. J., correctly said:[8] "It seems to us that there is nothing analogous to copyright in the name of a newspaper, but that the proprietor has a right to prevent any other person from adopting the

[1] Canham *v.* Jones, 2 V. & B. 218.

[2] Williams *v.* Williams, 2 Mer. 157.

[3] Newberry *v.* James, Ibid. 446.

[4] Hovenden *v.* Lloyd, 18 W. R. 1132; Siegert *v.* Findlater, 7 Ch. D. 801; 47 L. J. Ch. 238; 38 L. T. (N. S.) 349; 26 W. R. 459. Manhattan Co. *v.* Wood *et al.*, 14 Off. Gaz. 519; on appeal, 108 U. S. 218.

[5] See *ante*, §§ 14, 15, 116 *et seq.*

[6] Law of Trade Marks, p. 171.

[7] L. R. 14 Eq. 431; 41 L. J. Ch. 781; 20 W. R. 964.

[8] Kelly *v.* Huttor L. R. 3 Ch. 703; 37 L. J. Ch. 917; 19 L. T. (N. S.) 228; 16 W. R. 1182.

same for any other similar publication." This is now the doctrine of all courts. — The term *title* has its limitation, excluding that which is secondary and merely qualificative, as is illustrated by a case that came up in the Court of Caen, in France, on appeal, in 1878.[1] The court said: "Although the title or denomination of a journal is private property, by *title* or *denomination* of a journal must be understood the same title, etc. under which it is known or designated; that is to say, the words written in very large characters at the head of the first page, and not the qualifications which follow, and are printed in much smaller characters in the second or third line. The plaintiff's journal bears the words 'Le Granvillars,' in very large characters, at the head of the first page, and filling the first line, — that being the sole title under which it is known and designated, though, truly, in the second and third lines are printed in fine type the words, 'Courrier d'Avranches de Constance, et de la Côte,' yet they are no part of the title of the paper, but indicate the radius for which it is established and to which it reports the local news. The defendant, Durand, in entitling his journal 'Le Courrier d'Avranches,' has only availed himself of words that are *publici juris*." The following decisions throw further light on this subject.

§ 547. *Examples of Titles protected.* — "The Real John Bull," infringed by "The Old Real John Bull";[2] "The Edinburgh Correspondent";[3] "The Edinburgh Philosophical Journal";[4] "The American Grocer";[5] "Household Words";[6] "Bell's Life in London," infringed by "The Penny Bell's Life and Sporting News";[7] "The London Journal," infringed by "The London Daily Journal";[8] "London Society" magazine, infringed by another styled "English Society";[9] "The Birth-

[1] Cagnaut *v.* Durand, 23 Annales, 143. See *ante*, §§ 109, 110.

[2] Edmonds *v.* Benbow, Seton, 4th ed. 238.

[3] Re The Edinburgh Correspondent Newspaper, 1 Ct. of Sess. Cas., 1st ser., new ed. 407, n.

[4] Constable & Co. *v.* Breweter, 3 Ct. of Sess. Cas., 1st ser. 215 (new ed. 152).

[5] American Grocer Publishing Co. *v.* Grocer Publishing Co., 51 How. Pr. 402.

[6] Bradbury *v.* Dickens, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54.

[7] Clement *v.* Maddick, 1 Giff. 98; 5 Jur. (N. S.) 592; 33 L. T. 117.

[8] Ingram *v.* Stiff, 5 Jur. (N. S.) 947; 33 L. T. 195.

[9] Clowes *v.* Hogg, W. N. 1870, p. 268; L. J. Notes of Cases, 1870, p. 267. — W. N. 1871, p. 40.

day Scripture Text-Book," infringed by "The Children's Birthday Text-Book"; [1] "The Iron Trade Circular (Ryland's)," infringed by "The Iron Trade Circular (Edited by Samuel Griffiths)." [2] — The proprietor of "The Britannia" newspaper incorporated with it another paper, called "The John Bull," and issued the combined paper as "The John Bull and Britannia." The defendant, the former printer and publisher of "The Britannia," began to publish a new paper, under the name of "The True Britannia," [3] and he was enjoined therefrom. But to entitle one to an injunction, there must be such a similarity of designation on the part of the defendant as to be likely to mislead purchasers. Therefore, it was held that "Punch," published at 3*d*., was not infringed by "Punch and Judy," published at 1*d*.[4] It was not clear that the title, "Our Young Folks; an Illustrated Magazine for Boys and Girls," was infringed by the use of the title, "Our Young Folks' Illustrated Paper"; so, for that reason, the case was referred to a master to report whether the use thereof by the defendant was deceiving, or was calculated to deceive, the public.[5] — The Court of Appeal of England refused an injunction to the proprietors of a dramatic and sporting newspaper called "The Era," which had for many years published articles signed "Touchstone," to prevent the publication of a new paper on the same subjects, under the title of "Touchstone, or the New Era." [6] An injunction was refused, because the complainants were merely contemplating publishing while the defendant had actually published his first number.[7] So, also, in the "Belgravia" magazine case.[8]

§ 548. In *Hogg* v. *Kirby*,[9] the complainant was proprietor

[1] Mack *v.* Petter, *supra.*

[2] Corns *v.* Griffiths, W. N. 1873, p. 93; Pemberton, 2d ed. 308.

[3] Prowett *v.* Mortimer, 2 Jur. (N. S.) 414; 27 L. T. 132; 4 W. R. 519.

[4] Bradbury *v.* Beeton, 39 L. J. Ch. 57; 21 L. T. (N. S.) 323; 18 W. R. 33.

[5] Osgood *v.* Allen, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124.

[6] Ledger *v.* Ray, Cox's Man., case 550.

[7] The Correspondent Newspaper Co. *v.* Saunders, 11 Jur. (N. S.) 540; 13 W. R. 804.

[8] Hogg *v.* Maxwell, 12 Jur. (N. S.) 916; 15 L. T. (N. S.) 204; 15 W. R. 84. On appeal, L. R. 2 Ch. 316; 36 L J. Ch. 437; 16 L. T. (N. S.) 133; 15 W. R. 470.

[9] 8 Ves. 215.

of a monthly magazine published by the defendant, and sold at his shop on 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 complainant then 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, 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. 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 that 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.[1]

[1] See Clemens *v.* Such, Codd. Dig. 312; Cox's Man., case 429, restraining the use of the name "Mark Twain"; and see also Jollie *v.* Jaques, 1 Blatch. 618, refusing protection to the name "The Serious Family Polka."

§ 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 Almanac, for 1847"; and the defendant of one called "Old Moore's Family Pictorial Almanac." 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 anything 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 difficult 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.[2]

[1] 10 Jur. 1043; 2 Ph. 154; 8 L. T. 230.

[2] Purser *v.* Brain, 17 L. J. Ch. 141. See also Chappell *v.* Davidson, 1 K. & J. 123.

§ 550. In *Snowden* v. *Noah*,[1] 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*,[2] 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 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

[1] Hopkins, Ch. R. 347.

[2] 8 Paige, 75.

principle from *Snowden* v. *Noah* and *Bell* v. *Locke* (*supra*). The injunction was continued. — In *Stephens* v. *De Conto*,[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 mistake. 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 as 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."

§ 551. In the court of Paris, in 1858, (case of *Estibal* v. *Petit-Demenge*,[4]) 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, etc., 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 thereon directed to be done.

§ 552. In the Tribunal of the Seine, in 1855, (*Castille* v. *Dennery*,[5]) it appeared that the plaintiff had published, in

[1] 4 Abb. Pr. (N. S.) 47; 7 Robertson, 343.
[2] 17 How. Pr. 510.
[3] 5 Jur. (N. S.) 592.
[4] 4 Annales, 334.
[5] 2 Id. 27.

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 M. 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 be a cause of damage to him in respect of that property.[1] Upon this principle rests the case of *Thunot-Duvotenay* v. *Degorce-Cadot*, in the Court of Paris, in 1869. Madame Michaud, widow of the historian of the Crusades, had married M. Thunot-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

[1] Lloyd on Trade Marks, 2d ed., p. 42.

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 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."[1]

§ 554. In the remarkable case of *Lord Byron* v. *Johnstone*,[2] in 1816, 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

[1] This section was cited with approbation by the Maryland Court of Appeals in 1878, in Robertson *v.* Berry *et al.*, 50 Md. 591.

[2] 2 Mer. 29.

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*,[1] in which 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 principle 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 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 be 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 Civil of the Seine, in 1869 (*Charles de Bussy* v. *Charles Marchal*.[2]) The defendant, well known in the literary world

[1] 11 Beav. 112; 17 L. J. R. (N. S.) Ch. 142.

[2] 15 Annales, 143.

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. — But it is sometimes lawful to use one's name or pseudonym, without his consent and to his prejudice, without legal liability for the act. "Mark Twain" is a trade-mark for some publications, and is not entitled to any protection in others. In a United States Circuit Court, in 1883, Blodgett, J., said: "An author cannot, by the adoption of a *nom de plume*, be allowed to defeat the well-settled rules of the common law in force in this country, that the publication of a literary work, without a copyright, is a dedication to the public, after which any one may republish it. No pseudonym, however ingenious, novel, or quaint, can give an author any more rights than he would have under his own name."[1] Even the good-will was extinguished by such prior publication.

§ 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 Madam Anna 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," etc. *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.[2] Another party infringed upon the same by using the words "Minnie, dear Minnie," and was restrained by an interlocutory injunction, without imposing

[1] Clemens *v.* Belford, 11 Biss. 459.

[2] Chappell *v.* Sheard, 2 Kay & J. 117; 1 Jur. (N. S.) 996.

upon the parties the necessity of trying the right at law.[1]— But where, the plaintiff being a writer and composer of songs and music under the name of "Claribel," the defendants published and sold certain songs, of which the plaintiff had written the words but not composed the music, with the words "Song written by Claribel" on the title-page, an injunction was refused.[2]

§ 558. *The Titles of Printed Publications* are sometimes registered, as trade-marks, and they may legitimately be so registered, 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. The same may be said of most of those mentioned in § 547.

§ 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, it was not a case for an interlocutory injunction.[6]

§ 560. *Names and Designations on Coaches, etc.* — 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*

[1] Chappell *v.* Davidson, 2 Kay & J. 123.
[2] Re Barnard *v.* Pillow, W. N. 1868, p. 94.
[3] Re F. C. Barksdale, Cert. No. 424.
[4] Re Charles C. Hine, Cert. No. 903.
[5] Cox *v.* Land and Water Journal Co., 9 L. R. Eq. 324; 39 L. J. Ch. 152. (V. C. Malin's court.)
[6] Ibid.

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 name "Irving Hotel," "Irving House," or "Irving," upon coaches, and upon certain badges worn by the defendants upon their arms and hats. — *Deiz* v. *Lamb*,[3] in 1866, the "Prescott House" case, is another of the same kind. — The same principle was applied in *Winsor* v. *Clyde* and *Stetson* v. *Winsor*, in regard to the name "The Keystone Line," for steamships.[4] — In the late case of *The New York Cab Co.* v. *Mooney*, the defendant was perpetually enjoined from using cabs painted and lettered to create the impression that they belonged to the plaintiff.[5]

§ 561. An action of trespass on the case may be maintained under similar circumstances. Thus, in *Marsh* v. *Billings*,[6] 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 between that house and 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

[1] 2 Keen, 213.

[2] 13 Monthly L. R. 360; R. Cox, 115. See also same matter in Howard *v.* Henriques, 3 Sandf. S. C. 725; R. Cox, 120.

[3] 20 N. Y. Superior Court, (6 Robertson,) 537.

[4] 9 Philad. 513.

[5] Reported in New York Tribune, Sept. 25, 1884.

[6] 7 Cush. 322; 14 Monthly L. R. (4 s s.) 664; R. Cox, 118.

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 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, etc.* — 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, *Newberry* v. *James*,[1] in 1817, shows the difficulties that have been felt in dealing with questions of this sort. The complainant 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 of 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 it was 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

[1] 2 Mer. 447.

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 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 *Youatt* 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

[1] 3 Mer. 157.
[2] 2 Phillips, 52.
[3] 1 J. & W. 394.
[4] 1 S. & S. 398.

settlement, and was ordered 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. The complainant, in praying for an injunction, 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.[3] — 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 as that of a party complaining. Thus, in *Davis* v. *Kendall*,[4] 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 compound. — The

[1] 2 Hare, 383. [2] 9 Id. 241.

[3] As to authorities on this matter of secrets of trade, see 2 Story Eq. Jur. § 954; 3 Daniell's Chancery Pleading and Practice, 1755.

[4] 2 R. I. 566.

same doctrine was recognized in *Comstock* v. *White*.[1] The defendants, after dissolving their connection with the plaintiffs as partners, began to use the name or designation "Dr. Morse's Indian Root Pills," to which neither party had any exclusive right. 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, etc. 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, etc., the publication was ordered to be made showing the judgment for the plaintiff.

[1] 18 How. Pr. 421.

[2] 8 Annales, 374.

CHAPTER XIII.

PRACTICE IN THE PATENT OFFICE.

§ 565. Preliminaries to application for registration.
§ 566, 567. Selection of attorney and counsel.
§ 568, 569. Necessity for forms.
§ 570, 571. System of examination.
§ 572, 573. Course of pleading pursued.
§ 574. Inquiries not answered before application filed.
§ 575. Issue joined.
§ 576. Drawing and filing of application.
§ 577, 578. Amendments, — power limited.
§ 579. How amendments are made.
§ 580. Design of oath.
§ 581. *Prima facie* right to mark, — how established.
§ 582. Caution in making examination.
§ 583, 584. Indefiniteness in statement.
§ 585. Colors, — uncertainty in describing.
§ 586–589. Breadth of claim.
§ 590. Class, — too loosely defined.
§ 591. Degree of specificness.
§ 592–594. Analysis of hypothetical papers.
§ 595. Terse style of allegation required.
§ 596. Caution in declaring.
§ 597. Instances of invalid claims.
§ 598. Geographical names.
§ 599. Generic terms.
§ 600. "Great Lightening Ink Eraser" case.
§ 601. Name given to invention.
§ 602. Propriety in selecting an emblem.
§ 603. Colored threads a mark for woven fabric.
§ 604. Case of many joint claimants.
§ 605. Form of product not a mark.
§ 606. The doctrine of alternate forms.
§ 607. Rejection for false suggestion.
§ 608. Actual or constructive fraud.
§ 609. "Hamburger Tropfen" case.
§ 610. "American Sardines" case.
§ 611. "Richardson's Patent Leather Splitting Machine" case.
§ 612. Instances of false suggestions.
§ 613. Litigation not encouraged.

§ 614. "Surrender" and "Reissue" not applicable.
§ 615. Money paid as fees, when returnable.
§ 616. When Office has jurisdiction, fee not returned.

§ 565. *Preliminaries to Application for Registration.*— When the owner[1] 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." 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?[2]

[1] He must be "owner." One cannot own a trade-mark for carpets in his hands as a cleaner, for as to him they are not merchandise. (Re Hankinson, 8 Off. Gaz. 89.) A packer and vendor of fish, being also official inspector of fish, has no private property in the official brand. (Chase *v.* Mayo, 121 Mass. 343.) Indeed, the brand could not be a trade-mark for the public authorities, they not being traders. (See *ante*, §§ 139 *et seq.*, as to definition of "Merchandise," and § 284, as to meaning of the term "Owner.")

[2] "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. Émile Barrault.

§ 566. The Rules of Practice of the Patent Office (17-23) furnish good advice upon this subject. The remarks made in regard to a patent are also 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 proportionate to their skill and honesty, and too much care cannot be exercised in their selection." But how shall a selection of counsel be made from the multitudes of aspirants for forensic honors? Rule 17 says: "The Office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making selections. It will, however, be unsafe to trust those who pretend to the possession of any facilities except capacity and diligence for procuring patents in a shorter time or with broader 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 run in a groove — confound one thing with another of a very dissimilar nature. The mischief of mistaking a certificate of registration for a patent, or anything in the nature thereof, has been demonstrated in several places in this book. Yet miscalled patent lawyers make this mistake every day. It would therefore be judicious for the applicant to select one who is not a *mere* patent agent as his legal adviser in dealing with this question, involving so much commercial law. Forewarned, forearmed. The language of the papers may be the foundation of 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, with a 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 always to be 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 the government to grant one;[2] 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.[3] You can have an adjudication upon the question 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 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, on but one side of a sheet, with all interlineations and erasures clearly marked

[1] Tyler's Rules of Pleading, 50.
[2] See remarks of Wallace, J., in La Croix *v.* May *et al.*, 15 Fed. R. 236.
[3] See section 2 of the Registration Act of 1881.

in a marginal note on the same sheet, and also to see that they contain all indispensable allegations. The scrutiny may disclose some fault susceptible of amendment. If so, it is pointed out, so that the paper may be 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 nowadays 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 thereof. Admitting all the facts alleged by the *prima 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 the act of Congress of March 3, 1881; 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,[1] because not indicating origin or ownership;[2] 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 5 of the act; 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 regis-

[1] See *ante*, § 134, "Generic Names," etc.

[2] See *ante*, §§ 144 *et seq.*, "Indication of Origin or Ownership."

tration would be contrary to public policy, etc.; — all 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, in telling all the truth, blunder into difficulties from which he cannot be extricated. He is estopped by his recitals. He has, perhaps, 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 applicant 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 obliged to furnish advice to any applicant.

§ 574. No. 14 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 had been passed on, 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 neither advocate nor 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 on 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 may not have come to light; or he may take issue on the question of novelty; or admit that another person once had title, but aver 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 5 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 an emblem. Man is not a mere machine, but is a being of mind.

§ 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 law 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 approved forms, and modifies them, telling a plain, unvarnished tale, in as concise language as may express his meaning. Having signed each paper, with two witnesses to the specification and the drawing or mounted fac-simile, and verified 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 other 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, tag, or medal,[1] 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.[2]

§ 577. *Amendments.* — The power to amend application papers is limited.[3] If this were not so, all the material facts and allegations might be so varied from the original statement as entirely to 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 shows 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. He may, however, appeal to the Commissioner.

§ 578. No amendment is permitted to enlarge the scope of the claim, unless upon supplemental oath or its equivalent.[4] Solicitors of experience have, in many instances, so far disregarded the spirit and reason of this rule as completely to transform the original case. The papers are found to be deficient in essential averments. The solicitor, perhaps mechanically, draws an amendment, striking out this, and inserting that, with great recklessness of consequences. He sometimes attempts to amend the sworn declaration, usually termed the *oath*, by substituting words, or adding new allegations.[5] He does not stop to think that he is thereby perverting evidence, and that he might as well interpolate new statements in a deposition after execution, or words in a deed after delivery.

[1] See *ante*, § 89, for examples of peculiar emblems: colored threads, a band of gilt paper, medals, miniature metallic bell, etc.

[2] Trade-Mark Rule 9.

[3] It must be warranted by something in the statement or fac-simile as originally filed. Trade-Mark Rule 12. See also General Rule 71.

[4] See *ante*, §§ 311, 312, 313, as to verification.

[5] See requirements of Trade-Mark Rule 12.

Nor does he pause to reflect that such irregularities completely vitiate a case, and virtually destroy all 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 new matter in a declaration 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 for a single fee to the judgment of the Office upon two different cases.[1] He cannot be allowed to amend by substituting another symbol as his mark.

§ 579. All amendments must be made on sheets of paper separate from the original, and must be filed with the chief clerk of the Patent Office, who will cause them to be duly stamped, 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 more than once put the Office to serious trouble, and enabled roguish agents to perpetrate great wrongs; while a strictness of practice in another respect brought condign punishment upon culprits, and excluded them 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* among members of society is indispensable to social comfort. Suspicion, 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 can be

[1] Re J. C. Cooke, Com. Dec. 1871, p. 312.

[2] See that admirable book, Junkin on the Oath.

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 was administered interpolations have been made, and erasures and interlineations have materially changed the meaning of important allegations? Attempts to pervert the oath are 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.

§ 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, etc. 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 enclosing 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 below 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, be apt to mislead the public? May this mark not prove to be an exact fac-simile of that of a foreign house? How can even a license to use it be presumed? Is this proposed mark to be affixed to 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 possibility, there be error, it can readily be rectified. A *prima 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 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 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: [2] "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,

[1] Re Cazade & Crooks, No. 993.

[2] Le Père Louis Garnier *v.* Paul Garnier, 17 Annales, 257.

"Chartreuse," is the enunciation of the mental conception: the written word is the symbol of that enunciation. The arbitrary sound of the voice is intimately combined with the conceptions of the mind, and the arbitrary vocal sound is connected with a symbol still more arbitrary, addressed to the sight. The symbol excites in other minds the thoughts that it was meant to call up, by the association of ideas.[1]

§ 583. *Indefiniteness.*[2] — 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, 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 two peculiarities, 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 contradictory recitals in the specification, ended his decision thus: "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

[1] See *ante*, Chapter IV., "Indication of Origin or Ownership."

[2] See *ante*, § 89, on this point.

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 the 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 inadvertently 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 attorney, who had not become imbued with the subtile refinements of the law of trade-marks. He for a while refused to be comforted, and appealed; but, upon maturer consideration, he amended and limited his specification, and obtained a certificate of registry.[1]

§ 585. We cannot always be guided by the verbal description of 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 witnesses may honestly disagree in attempting to impart 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

[1] Re James Twamley, No. 860.

[2] Sir J. Gardiner Wilkinson, "On Color," etc. London, 1858.

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.[1] To judge of an alleged similarity between two trade-marks, we must place them together. If calculated to create confusion, one is an infringement on the other; but if the public can readily distinguish between them upon a casual inspection, there is no confusion. Let us take a case.[2] 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. 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 anything in the whole device 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 al.* v. *Forge et al.*,[3] 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

[1] See *ante*, §§ 203 *et seq.*, on Color as an essential element of a Trade-Mark.
[2] Re Peck & Snyder, No. 46.
[3] 8 Annales, 25.

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 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. — The highest court in France, in 1884,[1] held that the matter registered is an indivisible unit, and must be taken as a whole. The plaintiff had, in his registry, described his trade-mark as consisting, essentially, of the words, "Papier hygienique, vrai Papier Goudron de Norwege, extra, fabricants Joseph Bardou et fils, Perpignan"; and although the defendant had usurped the only valuable part of it, "Papier Goudron," it was held that the plaintiffs had no remedy.

§ 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 on the plea that the mark described by the plaintiff is so indefinite that he could not make it mean anything in

[1] Bardou *v.* Lacroix, 29 Annales, 226.

particular; and that, as he took but one word out of many words used in the mark of his rival, he cannot be liable. On inspection of the mark of the plaintiff, as registered, it is found that the word "Anchor," although it was that only which 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 case is dismissed. Nor is that always the worst result. He may find that, while he has nothing but an elaborate mark, which is entirely worthless, his triumphant adversary has established apparent right to the exclusive use of the simple, yet valuable, word-symbol "Anchor." The evil could have been avoided by a simple averment in his specification that the essential element of his mark consisted of that word-symbol. 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 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 kinds of merchandise? 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 appli-

[1] Ex parte H. M. Rowe & Co.
[2] Ex parte Thompson, Langdon, & Co.

cants 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.[1]

§ 589. A case like the following could not be recognized as entitled to 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, etc. Below this single initial we stamp the letters 'C. P. B.,' standing for Connecticut Pie Bakery."[2]

§ 590. One of the most remarkable applications ever filed was as follows. The claimant[3] 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, ploughs, 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

[1] See *ante*, § 89 *d*, "A General Type of Objects," etc.
[2] Ex parte Case & Martin.
[3] Ex parte W. M. Evans.

Era" in the centre, etc. The decision of the 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." [1]

§ 591. *Degree of Specificness.* — This no rule can designate except in a general way. It is a rule, that *the declaration must state everything 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 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 1 of the act of 1881, 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.

[1] At that time there was a State law against such a fiction. So also the New York laws of 1883, sect. 1, ch. 281, provide that, where the designation "Company" or "Co." is used, it shall represent an actual partner or partners. But it was held by the Court of Appeals, in 1884 (Gay *v.* Siebold, 31 Alb. L. J. 273), of this law, that "it does not compel partners to disclose their true names in the partnership designation. They may still do business under any style, not untruly containing the name of any person, which they choose to assume, such as the 'Union Towing Company,' the 'Eureka Company,' or other fanciful names. (Crawford *v.* Collins, 45 Barb. 269; Wright *v.* Hooker, 10 N. Y. 51.) . . . Even an individual may transact his business under such a name without violating the statute."

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 liquors 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] 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 arti-

[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 subsect. 1 of sect. 1 of the act of March 3, 1881.)

[5] Not more than one trade-mark can be embraced by a single application. This error is of frequent occurrence.

[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. Said section 1 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 possibly 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.

cle, is chemically pure, and medicinal,[1] and is generally pronounced by good judges to be superior to that brought from Europe.[2] The names 'Otard, Dupuy, & Co.' are only used as a fanciful emblem, and have no intention to mislead as to origin;[3] and indeed our label differs in several particulars from any label used by any such concern.[4] Nos. 2, 3, 4, and 5, containing the names of different kinds of liquors,[5] 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,[6] or so nearly resembling them as to deceive the public.[7]

"He therefore prays that the said lawful trade-marks[8] may be granted[9] 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.[10]

"NAPOLEON JONES, *Notary Public.*"[11]

[1] Surplusage, even if true. *Falsus in uno, falsus in omnibus,*—False in one particular, false in all.

[2] It is not allowable to deceive the public, even for their own benefit.

[3] 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.

[4] An admission of an attempt at evasion.

[5] Even if more than one kind of liquor could regularly be embraced by the same application, this mention of "liquors" would be too indefinite.

[6] The language of section 2 of the statute must be more fully followed.

[7] The law says, "to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers." (Sect. 3.)

[8] A misnomer, as is evident from the circumstances.

[9] The Patent Office has no power to *grant* a trade-mark. It receives and records it, and issues a certificate of registry. It has no creative power.

[10] It gives some degree of satisfaction to learn from the applicant that he had no legal standing before this tribunal. Neither he nor his firm was domiciled in the United States. (There is now a treaty between Spain and this country which gives an application a right to be entertained: April 10, 1883.)

[11] The notary has omitted to affix his official seal, which is indispensable

§ 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).

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, and has adopted and used the following trade-mark upon its publications, and upon the boxes containing the same, viz.: [*Here insert a fac-simile of the mark.*]

"That the said mark consists of [*Here insert a description of the mark.*]

"That the said mark has been used by your petitioners since [*Here insert the date when the mark was first used.*]

"That your petitioners do not know that the said mark has been used by any other person.

"Your petitioners therefore pray that the said mark may be registered in the Patent Office, according to the provisions of the act of Congress in such case made and provided.

"[*Here insert the name of the petitioner.*]

"[*Here insert the date.*]

"[*Here insert the name of the petitioner.*]

"[*Here insert the name of the petitioner.*]

"[*Here insert the name of the petitioner

culars to advertise their business[1] as a land-improvement concern,[2] at Baltimore County,[3] Maryland, and are entitled[4] to the exclusive use upon the said articles manufactured by them of the trade-mark described in the specification and accompanying labels,[5] said trade-mark having been duly assigned to them,[6] for a valid consideration paid by said company to the original designer and inventor thereof.[7]

"They therefore pray that the said company may be permitted to obtain protection[8] for said trade-mark, and letters patent, or a copyright therefor,[9] under the law in such case made and provided: And they[10] do hereby appoint Simon Shallow, of said Baltimore, or his substitute,[11] their true and lawful attorney, to make all necessary alterations and amendments[12] in and to said trade-mark to receive the protection,[13] and to transact all business in the Patent Office connected therewith.

"A. Bell, *President.*"[14]

[1] "Pamphlets and circulars to advertise their business." All idea of an emblem of trade is at once dispelled.

[2] A land improvement concern can hardly be supposed to vend goods, wares, and merchandise.

[3] Unhappily worded, to say the least.

[4] In what capacity, — as individuals, firm, or corporation?

[5] "Labels" should be struck out, and "fac-similes" substituted.

[6] 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 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!

[7] An inventor has no 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."

[8] 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.

[9] Neither letters patent nor a copyright can apply to a trade-mark case.

[10] *They* do not appoint, for the paper is signed by but one, who styles himself "President."

[11] At all events, the *substitute* could not be appointed except by Simon Shallow.

[12] No alterations or amendments can be made in a trade-mark without destroying its identity. If altered, it becomes something else.

[13] Meaning the certificate of registry.

[14] If this really is meant for an appointment by an incorporated com-

§ 594. *Specification* describing a trade-mark for pamphlets and circulars used by the "Union Land Improvement Company," [1] of Baltimore, Maryland.

"Our trade-mark consists of the design [2] as fully represented and described in the annexed cut or drawing,[3] composed in part of the words 'Union Land Company' with our initials [4] on a shield; but the said shield and initials may be omitted, or any other design be substituted therefor, or *vice versa*.[5]

"The most [6] essential features of this trade-mark are the words mentioned, and the shield when used,[7] together with the advertisement [8] of the company, and notices of the valuation of building-sites, etc.; but these or any of them may be varied or omitted according to circumstances.[9]

"This trade-mark, consisting of the parts described, we have used in our business of publishing for some time past, and with good effect.[10] The particular class of goods upon which said company has used,[11] and still continues to use said trade-mark, consists of pamphlets and circulars,[12] in addition to our signs and cards.[13] We have been accustomed [14] to brand it with a stencil-plate and black ink on packages of circulars and pamphlets sent to our various

pany, 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. 1885."

1 The true name should be given. There is a repugnance to the title previously stated.

2 A trade-mark cannot correctly be said to consist of a design.

3 Which is it,—a cut or a drawing? Inspection shows that it is neither, but a stencilling.

4 Whose initials?

5 The word "design" is out of place. We nearly despair of a solution of this enigma.

6 The word "most" must be eliminated.

7 How can it be essential at all, if it may be dispensed with?

8 An advertisement cannot enter into a trade-mark.

9 Sheer nonsense.

10 Surplusage.

11 For how long a time? (Sect. 1 of the Act of 1881.)

12 We have already seen that these pamphlets and circulars are used as mere advertisements.

13 "Signs and cards." Are these merchandise?

14 How *now* applied and used?

agents, or print it on the faces of the same[1] with the usual printing-ink.

"A. BELL, *President.*

"*Witness:* I. K. LANE."[2]

AFFIDAVIT.

"Commonwealth of Maryland,[3] }
City & County of Baltimore,[4] } ss.

"Personally appeared before me, a justice of the peace in and for said city and county, the said A. Bell,[5] who, being duly sworn, doth depose and say that he is an officer of said company within mentioned;[6] that they[7] have the right to the use of the trade-mark described, and that no other person, firm, or corporation has a right to the same,[8] or any part thereof;[9] that the description and fac-simile presented for record are true copies[10] of our trade-mark; and he further says that he is domiciled in and is a citizen of the said State.[11]

"ADAM YOUNG,[12] *J. P.*"[13]

[1] It would be hypercritical to say that the last antecedent is the word "agents."

[2] Two witnesses are required. *Query*, — Is not this witness the person named in the petition as a party?

[3] Should be "State of Maryland." (See Constitution of same.)

[4] 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.

[5] Full name required.

[6] He fails still to state that it is a corporation.

[7] This implies a lack of incorporation.

[8] This should read, "a right to *the use of* the same."

[9] This is too sweeping an assertion.

[10] A *description* cannot well be termed a *copy*.

[11] It is sometimes the fact that a person is a citizen of a State, but 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." (Sect. 1 of the Act of March 3, 1881.)

[12] No date to the jurat, not fatal, but an irregularity.

[13] 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.

§ 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 are, 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,[1] — we behold extraneous matter, recklessness of allegation, inconsistencies, ingenuity of falsehood. All 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 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 title. The metes and bounds of a field must all be carefully defined, before a person can be charged with encroachment thereon. Therefore, anything which does not possess all the essential characteristics of a trade-mark, under the generally 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.[2] Yet this truth is slow in obtaining credit. It was thought that the legal advisers who, in 1859, contended that the term "Schiedam Schnapps"[3] constituted a valid trade-mark, would long since have abandoned that fallacious idea; but the position taken at the trial of a certain cause[4] 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 began 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

[1] Stephen on Pleading, 424.
[2] See *ante*, § 134, "Generic Names."
[3] Wolfe *v.* Goulard, 18 How. Pr. 64; R. Cox, 226.
[4] Hudson G. Wolfe *et al. v.* Udolpho Wolfe Co., 2 Off. Gaz. 441.

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 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 had a valid mark in theirs. It was not necessary for the purposes of the suit that the learned judge should go farther, 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 "Nourishing Stout."[3] So in the

[1] Binninger *v.* Wattles, 28 How. Pr. 206.

[2] Batty *v.* Hill, 84 T. R. (N. S.) 791.

[3] Raggett *v.* Findlater, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. (N. S.) 448; 22 W. R. 53.

"Moline Plough" case, in the Supreme Court of Illinois, in 1870, where the manufacturers branded upon their ploughs, for the purpose of designating the size, shape, and quality of the different grades, respectively, certain letters and figures in combinations, as "A No. 1," "AX No. 1," "No. 1," "AX No. 11," "B No. 1," etc., 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.[1] And so in the case of *Stokes* v. *Landgraff*,[2] 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,[3] and so also are many other cases 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. — The following are samples of rejected cases. The words "New York Cutlery Co.," because the mere name of the applicant;[4] "D. D. & Co. — Tasteless," for drugs and medicines, because they are either descriptive or deceptive;[5] the figure of a fish, for fishing-lines, as merely descriptive;[6] the words "Crack-proof," for India-rubber goods, for the same reason;[7] and also "Iron Stone," enclosed in an oval border, for water-pipes.[8] Minor non-essential elements of a composite symbol were refused registration;[9] as was also a combination of two symbols, each of which had been registered in other cases.[10]

§ 598. In the Court of Lyons, in 1866, (*Chabrier* v. *Peillon*,[11]) came up a suit involving a question similar to that

[1] Candee, Swan, & Co. *v.* Deere & Co., 54 Ill. 439.

[2] *Ante*, §§ 157-160.

[3] *Ante*, §§ 162, 163. Yet, March 24, 1885, the triple letters "xXx," for bottled lager-beer, was registered by the Anthony & Kuhn Brewing Co. (No 12,033); and on the same day, "XX" or "double X" for sad-irons, by John Sabold, Jr. (No. 12,051).

[4] Re Rowe & Post, 3 Off. Gaz. 406.

[5] Re Dick & Co., 9 Id. 538.

[6] Re Pratt & Farmer, 10 Id. 866.

[7] Re The Goodyear Rubber Co., 11 Id. 1062.

[8] Re Rader & Co., 13 Id. 596.

[9] Re Coats, 16 Id. 544.

[10] Re Smith, 16 Id. 679.

[11] 16 Annales, 73.

which arose in the subsequent "Akron"[1] and "Lackawanna"[2] 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"[3] case. The "Congress Spring"[4] 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.*,[5]) 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 Propriétaires de Vignobles." *Per Curiam:* The words "Propriétaires de Vignobles" (Vineyard Proprietors) is a generic term belonging to an indefinite number of proprietors, and cannot indicate to commerce the origin of the article to which they are affixed. Dismissed.[6]

[1] *Ante*, § 182. [2] *Ante*, § 189. [3] *Ante*, § 270.
[4] *Ante*, § 191. [5] Journal du Palais, 1854, p. 120.

[6] 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.

§ 600. An application was made, in 1872, 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 participle 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 might better 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. Nor need that word be regarded as necessarily descriptive. 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. But this, however, is a fine point. — In the Court of Lyons, in 1884, an analogous case was decided. The registered mark consisted of the words "Insecticide foudroyant." It was held that the adjective *foudroyant* (striking with a thunderbolt), applied to an insect-killing powder, is but an expression drawn from common language, although pretentious, to intimate, in a single word, the efficaciousness of the powder offered for sale, and cannot be deemed to be a technical term under the French law of 1857.[1]

§ 601. An inventor may give the products of his genius, or skill, or good fortune, a distinctive appellation of infinitely greater value to him than a patent for the machine or discovery. This is a matter that is worthy the consideration of applicants for registration. The object is to select, or rather invent, a designation peculiarly applicable to the thing of

[1] Galzy *v.* Courcy, 80 Annales, 84. The learned editors, with a considerable show of reason, in a note, dissent from the finding, and cite authorities the other way.

which a monopoly 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.[1] — In *Bardin* v. *Gobert et al.*,[2] the plaintiff had obtained a patent for a species of ornamental feather 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. — In late dictionaries of the English language, the word "harvester" is defined as one who gathers the harvest. The name came to be applied to the machine; and now a whole class of machines in the Patent Office are termed "harvesters." The term "vibrator" was applied to a kind of agricultural machine; now there is a class of "vibrators." So the term "revolvers" includes many kinds of revolving pistol.

§ 602. *Propriety* must be the standard in the selection of something intended to serve as a symbol of commerce.[3] Commerce extends throughout the world; therefore a mark should be valid throughout the world to be valid in any country. This is a general rule, that may possibly have exceptions. Care must be observed to avoid copying established hall-marks, or emblems common to specific manufactures. For example: in articles of manufactured gold in Great Britain

[1] See *ante*, § 221, "The Name of a Machine," etc. [2] 12 Annales, 880.
[3] See case, *ante*, §§ 342-344; also cases in § 370.

and Ireland, an anchor shows that the gold wares were made at Birmingham; a dagger and three wheat-sheaves, at Chester; "Hibernia," at Dublin; a castle and a lion, at Edinburgh; a castle with two wings, at Exeter; a tree and a salmon with a ring in its mouth, at Glasgow; a leopard's head, at London; three castles, at Newcastle-on-Tyne; a crown, at Sheffield; and five lions' heads and a cross, at York. 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 sea-shore. 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. To be a "lawful trade-mark," the emblem must avoid transgressing the rules of morality or public policy. The law will not aid any person to 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 one form or another, or at least think that they do. Their religious prejudices should 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 infidels 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,[1] or of a thousand

[1] The laws of many nations forbid the registry of sacred emblems. Very recently, the Department of Customs of Russia issued an order on this subject, which has been copied in the Bulletin Officiel (Paris, Feb. 12, 1885). It says that lately there have been importations of foreign merchandise bearing trade-marks composed, in part, of the image of the Virgin Mary ("la Mère de Dieu"), of St. George the Conqueror (patron saint), and other saints; and it continues, that "the right of property that a foreigner possesses in a mark in his own country does not authorize the entry into Russia of manufactured products invested with sacred images, and consequently no goods so marked shall be permitted to enter the custom-house."—Our Patent Office acts on this rule of propriety.

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 general application. Indeed, 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." 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, especially when announced as such, and recognized by the trade, and consequently will be protected like any other symbol of commerce.[2] 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 (*Dugué & Co.* v. *Bobot-Descoutures*[3]). Both parties manufactured drillings. The complainants in their 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

[1] Re Walter & Shaeffer, No. 434.

[2] See *ante*, §§ 89 and 268, for similar cases.

[3] 17 Annales, 305.

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. 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 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," etc.; 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."[1] 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

[1] See same case, *ante*, § 221, and *infra*, § 611.

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.[1]

§ 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.*[2]). 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 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. *The Doctrine of Alternate Forms* has sometimes come up in practice. It is based on the decision of the United States Circuit Court for the District of Connecticut, in *Morrison* v. *Case*,[3] in which it was held that the words "The Star Shirt," the words "The Star Shirt" with the figure of a star, and the words and device "The * Shirt" constituted a single mark. On that authority, the Commissioner Duell reversed the decision of the Examiner, in *Re Weaver, ex parte*,[4] and directed the registration of a trade-mark consisting of the word-symbol "Lion," or the pictorial representation of a lion, or both. Ever since then, it has been the settled practice to register alternate forms, when they constituted true alternatives. The reason given is that a trade-mark appeals in many cases to the ear as well as to the eye. The goods bearing the symbol of a star will be known to commerce as the star goods, and so, also, if they bear the word "Star." "But," said Examiner

[1] Many manufacturers may unite to use a mark in common, and all thus be co-proprietors, as, for example, a union of hardwaremen, and as joint owners they may assign to successors or admit new members on an equal footing with themselves. Arnoult *et al. v.* Franck, 27 Annales, 352.

[2] Journal du Palais for 1865, p. 1125.

[3] 9 Blatchf. 548; 2 Off. Gaz. 544.

[4] 10 Off. Gaz. 1.

Seely, in a case in 1885, "this doctrine has some limitations. The question whether a word and a symbol presented for registration, whether by the same party or by different parties, are alternative forms of the same trade-mark, is one that calls for the judgment of the Office, and it is not left to the determination of the applicant. They must be exact alternatives, such that, on sight of the symbol, the word naturally occurs to the mind; such that, to express the symbol in language, no other word will occur; such that the written or spoken word unfailingly suggests to the mind the visible symbol." He cited an instance where a trade-mark for gloves consisted of a picture of a kid with its dam;[1] yet no one would venture to assert that the word "Kid," as an alternative form, could be a trade-mark for gloves. Similar to this case is another,[2] where a pair of kids in harness is the essential feature for gloves. Nor can this doctrine be stretched to cover cases in which the symbol is fanciful, while the name expressive of it is descriptive of quality or the price of the goods to which it is attached. In the case of 1885 referred to, the alleged trade-mark consisted of a United States cent in coin, affixed to a piece of tobacco, and the word "penny" was claimed as an alternative form thereof. "Cent" and "penny" are not convertible terms. Therefore it was held by the Examiner that the word "penny" cannot by itself constitute a valid trade-mark for plug tobacco, nor is it an alternative form of the word "cent," or of the coin of that name. An appeal having been taken, no opinion on this exact point of alternative forms was expressed by the Commissioner, he holding that the word "penny" could not be a trade-mark, being merely descriptive and common to trade.[3]

§ 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 may be exposed to view. The allegations may be true in letter,

[1] Registration No. 9,851.
[2] Registration No. 11,084.
[3] Perkins & Ernst, 28 Com. Dec., 93.

and false in spirit. The Office will penetrate the surface, and endeavor to reveal any latent fraud. 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.[1] 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 cannot 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 carefully to scan each proposed case, and, if necessary, to probe it thoroughly. 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, 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

[1] See C. A. Yale Cigar Manufacturing Co. *v.* C. A. Yale, 30 Off. Gaz. 1183. The respondent was one of the partners and superintendent of the company which owned the mark. He secretly and covertly obtained registration of the mark "Grand Master," for cigars, he never having individually adopted it. The decision was in favor of the company. — In the Court of Lyons, in 1880, (Seigle *v.* Mondon, Gonon, & Carre, 20 Annales, 177,) a similar case was decided, with the same result.

[2] "Dolum malum esse omnem calliditatem, fallacium, machinationem ad circumveniendum, fallendum, decipiendum alterum adhibitam." Dig. 4. 3. 1, 2; Poth. Obl. n. 28.

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 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 answered 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 entirely in the German language, and, beyond doubt, 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

[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] Ex parte A. Vogeler & Co., 1872.

proposed to use the words "Hamburger Tropfen," is manufactured by them at Baltimore, Maryland. Such a label seemed calculated to mislead the public. For both reasons, the application was rejected.

§ 610. The words "American Sardines," as applied to certain fish prepared for food, were refused registration, in 1872, for a similar reason. The objections were, the descriptive nature of the words on the 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 Examiner, — the tendency to mislead the public. The counsel attempt to meet this objection by insisting that no one who had ever seen a sardine could mistake the so-called American sardines for the genuine Mediterranean fish; for the applicant's fish are "at least six times as large, though supposed to be of the same (herring) family." The answer was 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 size 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 wholsale 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, 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 word '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." On appeal, the decision was affirmed, on the same reasoning.[1]

§ 611. An application was made for the registration of the words "Richardson's Patent Leather Splitting Machine."[2] 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 in-

[1] Re American Sardine Co., 3 Off. Gaz. 405. [2] Re Richardson, Ibid. 120.

ferred 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.[1]

§ 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 "$\frac{\text{Hero}}{\text{Inc,}}$" he was an infringer who used the words "The Heroine" for the same class of merchandise.[2] 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.[3] 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 hope of obtaining thereby a *prima facie* title,[4] 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 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

[1] See *ante*, § 71, "A Lack of Truth debars from Protection," and § 72, "An Untrue Use of the word 'Patented.'"

[2] Rowley *v.* Houghton, 2 Brewster, 303; 7 Phila. 39; R. Cox, 486.

[3] Hine *v.* Lart, 10 Jur. 106; 7 L. T. 41.

[4] Act of March 3, 1881, sect. 7.

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. 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.[1] The imitation was only in part, but was sufficient to cause confusion, and likely to provoke litigation. The word "Star," for oil, was rejected because another person had already registered a device for oil, consisting of a star containing the letter G;[2] and "Centennial," combined with a firm name and place of business, for sparkling wines, because a previous applicant had registered "Centennial" for alcoholic spirits.[3]

§ 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;[4] and the correction will be made without cost to the applicant.[5] If, after a party obtain

[1] Ex parte Fechheimer & Workum, 1872.

[2] Re The American Lubricating Oil Co., 9 Off. Gaz. 687.

[3] Re Busch & Co., 10 Id. 164. [4] Phelps *v.* Brown, 1 Fisher, 479.

[5] Re James Cochrane, Com. Dec., 1869, p. 60, and Re Havemeyer *et al.*, Id. 1870, p. 5.

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.[1]

§ 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";[2] but a mere change of purpose, after the payment of money, will not entitle a party to demand such a return.

§ 616. The money must actually have been paid through *mistake*, to authorize a return. In any case, where the Office has 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] Re Ives, Beecher, & Co., No. 547.

[2] Rev. Stats., sect. 4936. Patent Office Rule 215.

CHAPTER XIV.

INTERFERENCES IN THE PATENT OFFICE.

§ 617, 618. Practice moulded on that of courts of equity
§ 619, 620. Manner of conducting interference.
§ 621. Interference an interlocutory proceeding.
§ 622. In what cases declared.
§ 623. Matters to be considered.
§ 624. Priority of right.
§ 625. Preliminary interference.
§ 626, 627. Exact time of adoption required.
§ 628. Who shall make oath.
§ 629. Preliminary statements, — when to be open.
§ 630. When adjudicated by default.
§ 631. Failure to file preliminary statement, — effect of.
§ 632. When postponement is required.
§ 633. Declaration and dissolution of interference.
§ 634. Judgment based on concession of priority.
§ 635. Notice to parties.
§ 636. Arrangement of time for taking testimony.
§ 637. Notice states point in issue.
§ 638. Grounds of interference.
§ 639. Compulsory testimony.
§ 640. Access to testimony.
§ 641. Printed copies of testimony.
§ 642. Postponements, — on affidavit.
§ 643. Defaults not generally opened.
§ 644. Information in relation to pending cases.
§ 645. Sources of evidence.
§ 646. What matters evidence, — how obtained.
§ 647. Case closed, when.
§ 648. Hearings, when. — Duration of arguments.
§ 649. Appeals *pro forma* to Commissioner.
§ 650, 651. Commissioner's decision final.
§ 652. Practice exemplified.
§ 653–657. "Durham" tobacco case.
§ 658. Opinion of Examiner.
§ 659. Opinion of Commissioner.
§ 660. Opinion of Judge Rives. — Comments.
§ 661. "Bouquet" interference case.
§ 662. Multiplicity of legal questions.

§ 603. Motion to admit new party.
§ 604. "Paul Jones" case.
§ 605. As to title to the mark "Paul Jones."
§ 606. Good faith, question of.
§ 607. Imposition on the public.
§ 608. Why assignee had no title to mark.
§ 609. Good faith as regards Walsh, Brooks, & Kellogg.
§ 610. Want of equity on their side.
§ 611. Conclusion and dissolution of interference.
§ 612. "Magnolia" and "Dave Jones" trade-marks.
§ 613. Learning and skill required in interference cases.

§ 617. INTERFERENCES frequently demand a 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.[1] 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 answers to them are ruled out, and, it may be, whole depositions are eliminated for a manifest lack of good faith, or for some other fault, although it may be only the result of sheer ignorance or carelessness. In case of surprise, relief will be given to an innocent party.

[1] Sect. 3 of the Trade-Mark Act of March 3, 1881, prescribes that the Office shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

Thus, upon a motion, in the nature of an appeal, 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 on appeal set for immediate hearing upon the testimony and arguments by that time in.[1] But after a 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 manifestations of subtlety and craft. The object is to discover the weakness of the adversary, and then, by feigned surprise, or plausible excuse, to obtain leave to take additional testimony. Witnesses can usually be found to supply all deficiencies in evidence. When such a motive becomes apparent, the Office is sometimes called upon to exercise ingenuity to circumvent villany.

§ 621. *An Interference is defined* to be an interlocutory proceeding for the purpose of determining which of two or more persons, claiming to be the first to adopt a trade-mark, really did first adopt it.[3] It may also be resorted to for the purpose of procuring evidence of an alleged abandonment of the mark in controversy.[4]

§ 622. It will be declared in the following cases: 1. When the parties have pending applications before the Office at the same time, both or all the parties claiming priority of title to the same mark, — or one substantially the same, — used to indicate the same class of merchandise. 2. When an appli-

[1] Hayden *v.* Phillips, Com. Dec. 1871, p. 170.

[2] Aldrich *et al. v.* Bingham, Ibid. 90.

[3] The Commissioner had authority, under the old law, to declare an interference in a trade-mark case. Lautz Bros. & Co. *v.* Schultz & Co., 9 Off. Gaz. 791. So held by U. S. Circuit Court, N. J. Dist., Hanford *v.* Westcott, 16 Id. 1181. The subsequent act of March 3, 1881, sect. 3, gives ample power in the same respect.

[4] See *infra*, Chapter XV., on "Abandonment."

cant — 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 *prima 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. had. What is to be done? A. acted in ignorance of B.'s right, and in perfect honesty. To deprive him of the apparent 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 question, — Who had the prior right to the use of the mark? The right to a trade-mark is founded on 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 com-

mon-law right, and could have sued in our courts as an alien friend, without the slightest regard to the matter of treaty or convention.[1] 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.[2] But the Commissioner may, in an interference issue, if he find that another was the prior adopter, 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 third section of the trade-mark law of March 3, 1881.[3]

§ 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

[1] An alien suing for violation of his trade-mark need not even allege the existence of a treaty. Fils *v.* Sarrazin, 15 Fed. R. 480.

[2] Mowry *v.* Whitney, 14 Wall. 620; 5 Fish. 513; 1 Off. Gaz. 409.

[3] In the United States, the first adopter, or one deducing title from him, is alone entitled to registry. (Act of 1881, sect. 3.) In England, it was held that, inasmuch as each of the parties had used a certain mark independently and *bona fide* for several years, the mark should be registered in both names. (Re Powell, Re Pratt, 1 Trade Marks, 237; Sebastian's Dig., No. 357; Cox's Man., case 589.) With respect to those technically termed "old marks," the court permitted identical marks to be registered to three different parties at the same time (Re Jolley, Son, & Jones, 1 Trade Marks, 346); but if the mark be used by more than three parties, it cannot be registered at all, as, by being used by more than three, it lacks the element of distinctiveness. Re The Walkden Aerated Waters Co., 1 Trade Marks, 89; Re Hyde & Co., 7 Ch. D. 724; 28 L. T. (N. S.) 777; 26 W. R. 625; 1 Trade Marks, 245.

practicable, the exact date of each step in the act of appropriation. This statement must be sealed up before filing; 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 has been 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.*[1] 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 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,[2] 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.[3] 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 solem-

[1] *Infra*, § 631.
[2] Kenyon *v.* Wesson, Com. Dec. 1871, p. 91.
[3] Tegmeyer *v.* Kerns, Ibid. 285.

nity of an oath. In a patent case,[1] 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 character of 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.

§ 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 verifying 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 opposing parties until both, or all, shall have been filed, or until the time for filing shall have expired; nor then,

[1] Schenck *v.* Rider, Com. Dec. 1870, p. 135.

until they shall have been inspected by the Examiner, and found to be sufficiently definite as regards the declaration of dates.

§ 630. If the party on whom rests the burden of proof fail to file a preliminary statement, or if his statement fail to overcome the *prima 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 abandonment, 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.

§ 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 registrable; 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 of Interferences, 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

[1] Jenkins *et al. v.* Putnam, Com. Dec. 1870, p. 150.

the parties;[1] or it will be dissolved upon one of the parties striking out from his specification the only element of conflict;[2] or it may be found that the registration of one will be no bar to the other.[3]

§ 634. *Judgment based on 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;[4] 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.

§ 635. *Notice to Parties.* — When an interference is declared, notice will be given to the 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 the Official Gazette for such time as the Commissioner may direct.[5]

§ 636. If there be more than two parties, the times for taking testimony will 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 facts by the adduction of evidence before the Examiner, and have, consequently, to provide themselves with proper documentary or other testimony, it is essential that they should be apprised of the specific nature of the question to be tried, for guidance in preparing proof. The notice of interference sent by the

[1] Eames & Sealey *v.* McDougal, Com. Dec. 1871, p. 206.
[2] Hawkins *v.* Lambert, Ibid. 278.
[3] Jackson *v.* Nichols, Ibid. 278.
[4] Eames & Sealey *v.* McDougal, *supra*.
[5] Rule of Practice 102, as to interferences.

Office 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 that name was displayed upon a flag flying on a ship under full sail. The parties entered into the contest with the knowledge of the 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. Although there may be points of resemblance, they 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 [1] for a trade-mark for shirts, drawers, etc., 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 [2] for a trade-mark, for substantially the same class of merchandise. The mark of the latter was described as consisting essentially of the word "Centennial." The prior adopter said that he 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.[3] 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. For the pur-

[1] Leopold Sternberger, No. 709, dated March 19, 1872.

[2] Thalheimer & Hirsch, No. 800, dated May 7, 1872.

[3] In Re Cornwall (12 Off. Gaz. 138), it was held that a star and crescent for soap did not interfere with a previous registration by another of the figure of a star for soap. But "Swan" was held to conflict with "Black Swan." (Re Jules E. Cdire, 15 Id. 248.)

pose 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. On an interference trial, Sternberger proved priority as to the actual affixing of the mark, and the Examiner decided in his favor. On appeal, the decision was affirmed.[1]

§ 639. *Compulsory Testimony.* — Previous 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.

§ 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.[3]

[1] Sternberger *v.* Thalheimer & Hirsch, Com. Dec. 1873, p 24, 3 Off. Gaz. 120.

[2] Re-enacted as Section 44 of the Patent Act of July 8, 1870; Rev. Stats., sect. 4906.

[3] Rule 209.

§ 641. *Printed Copies* of testimony greatly facilitate the examination of cases; and such copies are required in all cases when the testimony is written otherwise than in a fair and legible hand.[1]

§ 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 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[2] where, four months after the decision had been made, and after frequent allowances of additional time, a 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 affidavits to show what proof he desired to offer, or that any evidence existed; and his affidavits gave no details, but were most general in 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 farther. Thus, where an interference is declared between pending applications, each contestant is entitled to a knowledge of so much of his opponent's case as would enable him to conduct his own understandingly.[3]

§ 645. *Sources of Evidence.* — As in equity cases, these are principally four: 1st. The intelligence of the tribunal, or the

[1] Rule 157.
[2] Covel *v.* Maxim *et al.*, Com. Dec. 1869, p. 78.
[3] See 125th Rule of Practice in the Patent Office.

notice which it judicially takes of certain things, and the things which it presumes; 2d. The admissions of the parties, contained in their specifications and statements, which serve as pleadings; 3d. Documents; and, 4th. The testimony of witnesses.

§ 646. As a rule, parties may by written consent make almost anything 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.[1] 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 practice of the Patent Office, for taking and transmitting testimony in an interference case, may be found in the Rules thereof, Nos. 150–158.

§ 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 Interferences, will stand for argument at one o'clock on the day of hearing, unless some other hour be specially designated. If

[1] See Act of March 3, 1881, sect. 3.

either party then appears, 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 forma* may be taken to the Commissioner in person, and without any 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.

§ 651. The remarks of the court in a certain patent case,[2] in regard to granting reissues, are also 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."[3]

§ 652. The practice in an interference case can best be explained by taking the record of an actual controversy as to

[1] This is the substance of the provisions of Rule 140 in patent cases, now adapted to trade-mark interferences.

[2] Whitely *v.* Swain, 4 Fisher, 123.

[3] 4 How. 404; 15 Id. 52; 17 Id. 84; Law's Dig. 617.

the right to the exclusive use of a trade-mark. We shall thus not only see the formal part of the proceedings which characterize such a matter, but also have a curious exhibition of the contrarieties of the human mind, as shown in opinions of counsel and judicial officers. It will, in addition, furnish a commentary upon the "glorious uncertainty" of the administration of trade-mark law, when its settled principles are not rigidly adhered to.

§ 653. We will take, for example, the case of *Armistead* v. *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.[1]

§ 654. Armistead responded by a sworn statement of his version of the origin, etc. of the mark, partly from his own knowledge, and partly on information and belief, deducing his title through one Wesley A. Wright, and taking it back to 1860.[2] 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 circumstance of the surrender at that place, he believed that the name "Durham"

[1] See Trade-Mark Rule 13, ed. of 1885.

[2] See Blackwell *v.* Dibrell, U. S. Cir. Ct., E. D. of Va., 1878, 14 Off. Gaz. 633, in which this point was involved. See also Blackwell *v.* Wright, Sup. Ct. of North Carolina in 1875, 73 N. C. 310.

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. The parties were informed that their claims were adjudged to interfere with each other, and that a hearing would be granted them on 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, regard being had to the residences 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 a decision, which is condensed as follows.

§ 658. *By the Examiner:* It is necessary to have a clear conception of the exact point in controversy. Wherein consists the trade-mark? There are two theories. The applicant, Armistead, insists that the essence of it is in a single word, "Durham," used in connection with the words "Smoking Tobacco." The respondent, Blackwell, claims all these words in conjunction with the words "manufactured by W. T. Blackwell." The bill in equity in the suit,[1] the testimony in which is here adduced, claims the word "Durham." What is the essential part of the mark? Not the words "Smoking

[1] Blackwell *v.* Armistead, 5 Am. L. T. 85; 3 Hughes, 103.

Tobacco," for such words in common use cannot be appropriated.[1] Nor can the words "manufactured by W. T. Blackwell," for they are in the nature of a mere advertisement. If any word contains the essential attributes of the symbol known to commerce as a trade-mark, that word is "Durham." The respondent's first point denies that by any possibility it can be a trade-mark, and cites cases. If the word "Durham" is used for the purpose of indicating that the merchandise to which it is affixed is manufactured and sold at a place called Durham, it cannot be a trade-mark.[2] Did the applicant use it for that purpose? If the word is used in its geographical sense, it means but one place, — a village in North Carolina. That is conceded and proved. The applicant or his assignor there began business in 1859, or 1860. The respondent now carries on business there. Is there such a place as Durham in North Carolina? Some witnesses speak of "Durham"; some, of "Durham's"; others, of "Durham's Station." The official list of post-offices spells it "Durham's," the apostrophe probably signifying "Durham's Station." It is officially so certified by the Acting First Assistant Postmaster-General. That settles the question. The word as used by both parties is not meant to indicate locality. The evidence shows that it is used to denote the excellence of the tobacco.[3] It is not pretended that the tobacco is raised at Durham's Station; or, if it were, that the soil of that locality possesses any peculiar properties to make tobacco grown therein better than in any other. The witnesses swear that the flavor imparted by the tonka bean and other ingredients makes it superior, as manufactured in a peculiar manner. Blackwell did not mean it in a geographical sense, when he began to use the word. His sworn statement shows that. This does not concede, as law, that a geographical name cannot be a trade-mark. It generally cannot be, for the reason given in the "Lackawanna" case.[4] But this rule has exceptions. The leading authority

[1] See *ante*, § 134, "Generic Names."

[2] See *ante*, § 182, "Geographical Names," and §§ 191, 192, on same subject.

[3] See *ante*, § 135, "A Trade-Mark may be valid although descriptive of Quality."

[4] See *ante*, § 189.

is the "Anatolia" case.[1] Other cases affirm the same doctrine. In France, the same ruling was made. These rulings are all consonant with reason, — harmonious with the current of decisions. As to priority of adoption, Blackwell's evidence goes no farther back than 1865; Armistead's goes back to 1860, when his predecessor began to use it, and he continued to use it after he removed his factory from Durham's. Beyond the shadow of a doubt, — if faith is to be placed in the oaths of apparently credible witnesses, — the word was used in 1860, and ever since, to distinguish a peculiar kind of tobacco. This is the smoking tobacco that Armistead's assignor, Wright, made; substantially that for which he subsequently obtained a patent. The evidence proves that. The only essential element of the 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. It has been suggested that the word "Durham" is insufficient as a mark, because it does not indicate origin or ownership. The New York Court of Appeals set that question at rest when it held that the single word "Cocoaine"[2] possessed all the essentials of a common-law trade-mark. As a conclusion of fact, Wright, the assignor to Armistead, was the first to adopt it. The word was not originally adopted as a distinctive name of a place, but as a fancy designation, an arbitrary symbol. By long use, it has become associated with Wright's patent. The symbol was never abandoned by Wright;[3] and his property in its use was transferred by him to Armistead. As a conclusion of law, the title is in Armistead. Registration is therefore allowed. Thirty days' time was allowed for appeal to the head authority of the Office. The following is condensed from his opinion.

§ 659. *By the Commissioner, on appeal:* In October, 1871, Blackwell registered; in December following Armistead applied for registry. Blackwell manufactured at Durham, North Carolina; Armistead, at Lynchburg, Virginia, under an assignment from Wright. The evidence shows that Wright

[1] See *ante*, § 184.
[2] See *ante*, § 237.
[3] See *infra*, Chapter XV., on "Abandonment."

invented a flavoring compound for smoking-tobacco, which he patented; and his tobacco obtained some reputation under the name. On account of its flavor, it became a favorite. Wright removed about two miles from Durham, where he continued to manufacture for a few months, and then gave up business and went into the rebel army. He resumed business in 1869. That was at Liberty, Virginia, where he used the brand, "Original Durham, W. A. Wright, Originator." In 1870, in company with another person, he manufactured tobacco at Stewartville, Virginia, and marked their product "Durham Smoking Tobacco." After that, he assigned to Armistead. There is nothing registrable in the labels of either party. The parties have evidently misread some decisions. Courts of equity have often granted injunctions against the fraudulent use of words which the same court would not for a moment sustain as trade-marks. The "Akron Cement"[1] case is in point. So is the "Brooklyn White Lead"[2] case. In these, the courts enjoined against fraud,[3] but with no intention of defining a trade-mark. Conclusion: neither party is entitled to registration.[4] In the United States Circuit Court,[5] the following is, in substance, the opinion hereinbefore referred to. With a profound deference to the general learning of the judge, the errors of law are with hesitation pointed out. The case is a study from beginning to end, and simply as a study is it commented on.

§ 660. Rives, J.: The main question rests on 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." The discovery which he had made, and for which he seeks protection, was his preparation for, or his mode of treating, smoking-tobacco, so as to mitigate its noxious qualities, and impart to it an agree-

[1] See *ante*, § 188. [2] See *ante*, § 183.
[3] See *ante*, § 43, "Unfair Competition in Business."
[4] Reported in full, 1 Off. Gaz. 603.
[5] Blackwell *v.* Armistead, *supra*.

able flavor. It is proved that the whole merit of this smoking-tobacco, and its celebrity, were due to the flavoring. He was confessedly the first to begin its manufacture at Durham's Station. There was nothing in the locality that could reasonably have been counted on to commend his manufacture to the public. Take his own statement, and what was his brand? "Best Spanish Flavored Durham Smoking Tobacco." What, in view of the pleadings and the evidence, is the characteristic — the vital element — of this trade-mark? Manifestly, "Best Spanish Flavored." This is the only conspicuous and discriminating element of the trade-mark.[1] "Durham," if indeed a part of it, is subordinate and insignificant. There is nothing to restrain succeeding manufacturers from engrafting it on their brand, so long as they laid no claim to, nor made use of, his words "Best Spanish Flavored" compound, which he indeed appropriated[2] by the first and original use of this only conspicuous term in his stencil-plate in 1860–61. 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 complainants instituted their brand in 1865–66. What motive could have existed with Wright, all whose reliance was on the merits of his flavoring compound, to invoke the name of a small, thriftless station on a railroad, settled by but two or three families, with a store and this factory, to invoke its name to give celebrity to the preparation to which he solely looked for his reward?[3] It is abundantly proved that his product was known, called, and distinguished in the market as "Durham" smoking-tobacco. The plaintiffs secured their label by copyright.[4] Argument and ridicule are relied on to show the inapplicability of a copyright for such a print. The language of the statute is certainly comprehensive enough to embrace a label of this kind. The object of such copyright is to secure to "the

[1] Misuse of term. See *ante*, Chapter III., "Definition and Nature of a Trade-Mark."

[2] He could not possibly do so, for they are common language.

[3] Such was the very soul of the "Glenfield" case, — Wotherspoon *v.* Currie. See *ante*, §§ 184, 185.

[4] A grave error. See *ante*, §§ 100, 380.

author, inventor, or designer" of any such "print" the sole liberty of printing and vending the same. This is a perfectly legitimate resort to copyright in such a case, and for such a purpose. Perpetual injunction and account of profits decreed.

§ 661. The following decision will give another example of the treatment of a trade-mark interference, and also furnish 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. By the Examiner, in 1872: "The alleged trade-mark of Schrauder, the applicant, consists simply of the word-symbol[1] 'Bouquet.' To increase the pictorial effect of this mark, 'Bouquet' may be associated with a branch or wreath of flowers, or other appropriate ornaments, but they are not a part of the mark. It is for cured meats. The alleged trade-mark of Beresford & Co., the respondents, consists of a bouquet, thus described. Two sprigs of leaves, having their stems at the bottom of the lithograph, 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. It is for hams and breakfast bacon. One mark consists of the word-symbol 'Bouquet,' and the other of the representation or picture of a bouquet. The question that arises is *sui generis*. It is believed that the precise point here suggested has not been decided by any tribunal.[2] 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. No countenance can be given by the Office to what may possibly be turned into an instrument of wrong, or even of annoyance in trade. Let us take a hypothetical case. A customer inquires thus: 'Have you the Bouquet brand of

[1] See *ante*, § 89 *a*, as to this term.

[2] See *ante*, § 88, "Colorable Variation"; also, as to alternate forms, *ante*, § 606.

hams?' 'We have.' He is satisfied with the bare assertion, and gives an order. He does not particularize the bouquet as a picture, nor as the article marked with the word 'Bouquet.' It is characteristic of a trade-mark that it possesses a distinctive individuality, so that it may be confounded with no other, whether by means of vision or of sound.[1] That decides the question. The two things conflict, the word 'Bouquet' and the bunch of flowers called a bouquet. This is the doctrine of *Seixo* v. *Provezende*.[2] Another preliminary question arises. Do both parties apply their marks to the same class of merchandise, and the same species of goods?[3] If not, then the claims do not conflict. Schrauder's is for cured meats, while Beresford & Co.'s is for hams and breakfast bacon. Both parties mean the same kind of merchandise, although employing different modes of expression. They have, however, proceeded on two widely different theories as to the law of the case. Schrauder has regarded the symbol in its concrete relation only, i. e. as an emblem which he had affixed to merchandise; but Beresford & Co. have wandered into the domains of authorship and invention; and claim the design as an abstraction,[4] and base their claim on the fact that their agent, James, conceived the device. They went so far as to order a lithograph of the bouquet, with the intention of using it as a trade-mark on hams, with special instruction as to details. They say that their agent's invention thereby became complete, as any man of ordinary intelligence could understand and use the mark. They claimed as assignees of James's trade-mark.[5] They concede that Schrau-

[1] See *ante*, § 89, for discussion of this point.

[2] Cranworth, L. C., therein said: "If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that 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 that rival as the actual copy of his device." L. R. 1 Ch. 192; 12 Jur. (N. S.) 215; 14 L. T. (N. S.) 314; 14 W. R. 357.

[3] See *ante*, §§ 66 *et seq.*

[4] See "Abstract Symbol," in the Index.

[5] The later interference cases of Swift *v.* Peters (11 Off. Gaz. 1110), and C. A. Yale Manufacturing Co. *v.* C. A. Yale (30 Id. 1183), discussed these points, and reaffirmed their doctrines.

der was the first to affix the symbol to goods.[1] That was the test of property." Priority was therefore awarded to him.

§ 662. A multiplicity of legal questions upon the trial of an interference arises before the Patent Office. The following case[2] 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 the Examiner proceeds substantially thus.

§ 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 on 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.[3] If there had been the formality of including it among the assets, facts in evidence warrant 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

[1] This was a fatal concession. See "Abstract Symbol," in Index.
[2] Walch, Brooks, & Kellogg *v.* M. J. Cole & Co., in 1872.
[3] See case of Bradley *v.* Norton, 33 Conn. 157; R. Cox, 331.

of their opponents.[1] The inquiry was therefore directed to that name, without which, as a component part of the complex mark, neither party would have desired to make a contest.

§ 665. *As to Title to the Trade-Mark.* — The first question to be settled is this: Did M. J. Cole & Co. have any property in that name, 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 M. J. 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, and 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 by them for whiskey sold to other persons in the West and South; and, contrary to the contract, express or implied, made with M. J. Cole & Co. To the latter-named firm, if to any, it would seem the mark belonged. But there is one material fact disclosed by the evidence which determines all their claim. The name "Paul Jones" was used as a portion of a brand, the other part of which was "Paris, Kentucky, Bourbon." Cole testifies, "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.

§ 667. *Imposition on 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

[1] See case of Filley *v.* Fassett, 44 Mo. 173; 8 Am. L. Reg. (N. S.) 402; R. Cox, 530.

their trade-mark. Their intent was manifestly to impose on the credulity of the whiskey-drinking public, by inducing them to purchase as genuine Kentucky Bourbon County 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 proved to be as valuable as that made in Kentucky.[1] 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. *Good Faith of the other Party.* — How does the case stand, as regards Walch, Brooks, & Kellogg? They claim as a trade-mark the words, "Paul Jones, Paris, Kentucky, Bourbon," etc. The said mark is intended to be applied to whiskey manufactured by them at Cincinnati, Ohio. Their own testimony is conclusive on this point. Indeed, they do not make the slightest pretence that the whiskey manufactured by them is distilled in the State of Kentucky.

§ 670. *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.

§ 671. *Conclusion.* — Walch, Brooks, & Kellogg have not presented a lawful trade-mark for registration. The interference is therefore dissolved, and both applications rejected.

§ 672. *Another Case.*[2] — The firm of S. N. & H. Pike adopted the words "Magnolia" and "Dave Jones" as trade-marks for whiskey, manufactured by the firm before 1854. In

[1] See *ante*, § 71, "A Lack of Truth debars," etc.

[2] Kidd & Co. *v.* Mills, Johnson, & Co., Com. Dec. 1874, p. 28; 5 Off. Gaz. 337.

that year, H. Pike withdrew from the business, and S. N. Pike continued therein alone for about four years, when Lawrence Myers joined him, and continued in the firm of S. N. Pike & Co. until 1862. Myers then withdrew, and S. N. Pike went on alone until 1864. Then was formed a new firm, consisting of S. N. Pike, Joseph Tilney, and George W. Kidd. The firm did business in the cities of New York and Cincinnati. Tilney withdrew in 1867, and the other two continued as S. N. Pike & Co. In 1868, Pike, in his individual capacity, sold the realty, appurtenances, fixtures, machinery, and apparatus used by the firm in Cincinnati, but owned by him, and gave them this memorandum signed by him: "Having sold to Messrs. Mills, Johnson, & Co. my premises, No. 18 and 20 Sycamore Street, I hereby extend to them and their successors the use of all my brands formerly used by me in my Cincinnati house."[1] The firm of Messrs. Mills, Johnson, & Co., the purchasers, continued the business in Cincinnati; and S. N. Pike & Co. entirely removed to New York. With the addition of a new member, Isaac Bristow, they continued without change of firm name. In 1872, Pike died, and the surviving partners continued under the style of Geo. W. Kidd & Co. They claimed title in the said trade-marks, and applied for registration. Mills, Johnson, & Co. had already registered them. Hence the declaration of an interference. Held by Examiner: The trade-marks belonged to S. N. Pike individually, his firm having had only a license therein determinable at pleasure, and the title to them passed to Mills, Johnson, & Co. On appeal, the Commissioner reversed the decision. He held that, the title having been in S. N. Pike by virtue of abandonment by his former partners, he brought the same into the successive firms which he formed, and that it belonged to those firms, and could not be devested by his individual act. In the Circuit Court of the United States for the Dist[illegible] of Louisiana, suit was brought by Johnson *et al.*, as the successors in business of Mills, Johnson, & Co., against Kidd, as the survivor of S. N. Pike & Co., in regard to the "Magnolia" mark. The court held that the complainants had the exclu-

[1] See *ante*, § 57, "Title to a Trade-Mark by Assignment."

sive right under the sale of Pike to their predecessors. An appeal was taken to the Supreme Court, and the decree below was affirmed.[1] The court, by Mr. Justice Field, said of Pike: "He did not place his interest in the trade-mark in the concern as a part of its capital stock. He allowed the use of it on packages containing the whiskey manufactured by them; but it no more became the partnership property from that fact than did the realty itself, which he also owned, and on which their business was constructed." As the case appeared in the courts, a new element had to be considered. It was not only the trade-mark proper, but all the words, "S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio," enclosed in a circle, that Johnson continued to use. He had a perfect right to "Magnolia," but had he a right to the whole brand? Was not the use by him obnoxious to the charge of misrepresentation?[2] No, said the court. "Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character as those to which the mark was attached by its original designer."[3] No suggestion was made that such use amounted to deception.[4]

[1] Kidd *v.* Johnson, 100 U. S. 617. It was held, in 1884, that a trade-mark will pass under a general conveyance of all the assets and effects of a firm, though not specifically designated. Morgan *et al. v.* Rogers, 19 Fed. R. 596.

[2] See *ante*, § 71, "*A lack of truth* debars a trade-mark from protection."

[3] Citing Leather Cloth Co. *v.* American Leather Cloth Co., 11 Jur. (N. S.) 513; Ainsworth *v.* Walmesley, 44 L. J. 355; and Hall *v.* Barrows, 10 Jur. (N. S.) 55.

[4] In Stachelberg *et al. v.* Ponce (23 Fed. R. 430), in the United States Circuit Court, Maine Dist., in 1885, Colt, J., held that an assignee or purchaser of a trade-mark from the original proprietor must, in the use thereof, indicate that he is assignee or purchaser, or he will not be entitled to protection in the use of the mark assigned to him. The complainants claimed the trade-mark "La Normandi," or "Normandi," as applied to cigars, and charged the defendant with infringement by using the words "E. P. Normanda," or "Normanda," or "Normandie," for cigars made and sold by him. The complainant, Stachelberg, had obtained the exclusive right to use the mark, by assignment from one Asher Bijur of New York, and he subsequently transferred the right to his firm. It appears that Bijur, the originator of the mark, had used it for years, and built up an extensive sale for this brand of cigars by reason of their good quality. The original trade-mark bore the name of the maker, "A. Bijur," and also the initials, "A. B." For them, the assignee substituted his own name

§ 673. From the foregoing examples, it is inferable that an interference case in the Patent Office may involve innumerable matters in law and equity. A complication of apparently heterogeneous questions sometimes may demand as great professional skill as judicial examinations in any court. In a still-continuing controversy for the ownership of a word-symbol as a trade-mark for tobacco, the following matters have necessarily been considered. The circumstances of adoption, laches, abandonment, suspension of right in consequence of a state of war, partnership (including survivorship), administration of an intestate's estate, and various minor points. The rules of evidence have been strained to their utmost tension to countervail new circumstances that constantly obtrude themselves. It must therefore be concluded that this branch of practice demands great learning and skill.

"M. Stachelberg," and his initials, "M. S." The learned judge seems to have found as a fact, that the complainants were guilty of misleading the public, by false representations, into the purchase of their cigars as those made by A. Bijur, the original owner. Otherwise, the citation of Manhattan Medicine Co. *v.* Wood, 108 U. S., could not have been apposite.

CHAPTER XV.

ABANDONMENT.

§ 674. Abandonment sometimes an affirmative defence.
§ 675. Confused notions of abandonment.
§ 676. Property belongs to the first occupant.
§ 677. Effect of abandoning a right.
§ 678. Extinguishment of a trade-mark.
§ 679. Arguing from false analogy.
§ 680. What amounts to abandonment?
§ 681. Intention to abandon. — Illustrations.
§ 682. Actual abandonment must be proved.
§ 683. Abandonment operates from discontinuance of use.
§ 684, 685. Laches, what amounts to.
§ 686, 687. Abandonment not readily to be presumed.
§ 688. Misfortune sometimes works abandonment.
§ 689. Abandonment in one country is abandonment everywhere.
§ 690. Abandonment means intentional discontinuance.
§ 691. Indications of progress in trade-mark law.

§ 674. ABANDONMENT is sometimes 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 the use of 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. These 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 such 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 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, followed by actual appropriation by him; and the title remains in him, by a principle of general 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 deliberate casting away of a valuable thing 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, and ceases to be susceptible of private appropriation. 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

[1] 2 Bl. Com. 9.

[2] Adams & Hammond *v.* Edwards *et al.*, 1 Fish. 1.

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 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.[1] This 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 in such case the original owner's grasp is once released, the exclusive right is gone from him forever. 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 again to pick up. A trade-mark, however, may be discarded and be resumed, unless in the mean time it be taken possession of by another, or by a number of persons with united interests, or by the community in general. In the latter case, the arbitrary emblem may truly be said to be extinguished; for when all may use, there is lacking an essential element, to wit, 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.[2] But we will not stop to discuss exceptional cases.[3]

[1] See "Abstract Symbol," in the Index. [2] See *ante*, §§ 178–181.

[3] This section and that immediately preceding were cited with approbation by the court, in Gray *et al. v.* Taper-Sleeve Pulley Works, 16 Fed. R. 436.

§ 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 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 on 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.[2]

§ 679. Herein we see the impropriety of arguing from 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, the latter fails to obtain any lawful benefit, not being the first inventor of the particular thing.

[1] See *ante*, §§ 220 and 252, for other examples.

[2] American Hide & Leather, &c. Co. *v.* American Tool, &c. Co., 4 Fish. 284.

[3] See *ante*, §§ 346, 347.

[4] See *ante*, §§ 52, 382-384.

Why? Because the title to the invention passed to the public, the instant that the only person who had a right 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 furniture or hats with golden bees; but there is always presumed to be benefit in the use of an invention, of which benefit use is the strongest kind of evidence. And as to the denomination of an article of commerce, 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.[2]

§ 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 be 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 to some corporeal vendible object. Hence one difficulty in determining the exact moment when one must be held to have abandoned a trade-mark. A manu-

[1] Hérold *v.* Gerbeau, 16 Annales, 76.

[2] See *ante*, § 220, "The Necessary Name of a Product."

facturer or merchant may discontinue the stamping or branding of his products for many years before discontinuing 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 has employed 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 forever 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, if merchandise bearing his trade-mark is still in the markets of commerce. Thus, it was held by Chitty, J., in 1884, that the mere non-user by an owner of a mark between the years 1876 and 1882, though coupled with non-registration, did not amount to abandonment, having regard to the fact that he had not ceased to carry on his business, and had not broken up the mould for his soap, and that a number indicating soap bearing that mark was retained in his price-list.[1] — Yet, although one continued the active use of a mark or fancy name originated by him, protection was refused, on the ground that he had abandoned all claim to an exclusive right in it, by dismissing a suit begun by him to restrain the use of it.[2] — In the same year, in the Circuit Court of the United States for the Southern District of New York, Wallace, J., said of a trade-mark: "It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment rather than of the propri-

[1] Mouson & Co. *v.* Boehm, 26 Ch. D. 398.
[2] Browne *v.* Freeman, 12 W. R. 805; 4 N. R. 476.

etor."[1] — In the same court, and in the same year, Coxe, J., held that, where a certain brand for flour had been discontinued and abandoned, another firm might legally adopt it for the same kind of goods.[2] — The Court of Appeals of Kentucky, in 1884,[3] held that, where a trader had removed from a building to which he had affixed a fancy name, "Tower Palace," he, by the act of removal, had abandoned all right to said name, and a rival trader who followed him as tenant had a right to the use of that name.

§ 681. *Intention to abandon.* — The criterion manifestly is this: the evidence of such an intention. 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 should 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 proved. 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 cocoanut oil had actually employed it as a generic term. If that point were established, it would be manifest that the trade-mark had expired. This 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.[4] A defence of abandonment is abhorrent, even in an action at law;[5] and the assertion of

[1] Atlantic Milling Co. *v.* Robinson *et al.*, 20 Fed. R. 217.

[2] Holt *et al. v.* Menendez *et al.* (Not yet reported.)

[3] Armstrong *v.* Kleinhaus, 19 Rep. 528.

[4] The original section, ending here, was cited with approbation by the Supreme Court of Indiana, in Julian *v.* The Hoosier Drill Co. *et al.*, 78 Ind. 408.

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

title, on the ground of abandonment by the prior owner, must be established by the strongest proof.[1] Mere lapse of time does not *per se* warrant the conclusion of abandonment. The circumstances of the case, other than mere lapse of time, almost always give complexion to the delay, and either excuse or give it a conclusive effect.[2] Abandonment itself is a fact, and not a conclusion of positive law, statutory or common, arising from any prescribed state of facts.[3] The presumption is against it.[4] It must be set up in pleading to be availed of;[5] and upon him who thus sets it up rests the burden of clearly establishing by affirmative evidence a positive and actual abandonment, or such laches as clearly indicate an intent to abandon.[6] Abandonment may arise by express declaration, or by conduct equally significant, as by acquiescence.[7] But a declaration of an intention to abandon does not always bind, for one is entitled to the *locus penitentiæ*. There must be something more than mere words. The intention must be manifested by acts,[8] and when so manifested it cannot be recalled.[9] But mere non-user of a trade-mark is not conclusive, where the owner was passive because he was powerless to prevent infringements, and he is not estopped from asserting his right when he is in a condition to enforce it.[10] As to the lapse of time that could justify an inference of abandonment, it has been judicially said, that no statute of limitations bars one from protection of his trade-mark.[11] On this point are many decisions, alike in principle, although varied with cir-

[1] Sohl *v.* Geisendorf, 1 Wilson (Ind.) 60. See also Bump, Laws of Patents, Trade-Marks, etc., 246, which cites many cases to the same effect.

[2] Ibid. 247; Russel & Erwin Manuf. Co. *v.* Mallory, 10 Blatch. 140.

[3] Sprague *v.* Adriance, 14 Off. Gaz. 308.

[4] Hovey *v.* Henry, 3 West. L. J. 153.

[5] Williams *v.* Boston & Albany R. R., 17 Blatch. 21.

[6] United States Rifle & Cartridge Co. *v.* Whitney Arms Co., 14 Blatch. 94.

[7] Kendall *v.* Windsor, 21 How. 322.

[8] See Bump, 248, and authorities there cited; and also Mouson & Co. *v.* Boehm, *supra*.

[9] American Hide, &c. Co. *v.* American Tool, &c. Co., 1 Holmes, 503; Ransom *v.* Mayor of New York, 1 Fish. 252; Bell *v.* Daniels, 1 Bond, 212; Mellus *v.* Silsbee, 4 Mason, 108.

[10] McMillan *v.* Barclay, 5 Fish. 180.

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

cumstances. In one case, a lapse of twenty years was held to be no bar;[1] in another case, ten years;[2] in another case, nine years.[3] Yet, in another case, it was held that a non-user of a trade-mark for the period of eight years, notwithstanding the fact that the owner was absent a considerable portion of the time on military service in a time of war, was conclusive evidence against him, and that it could not be resumed as against one who had exclusively used it in the mean time.[4] In the Court of Aix, in France, in 1876,[5] one reason for dismissing the plaintiff's claim was that he had knowingly, and without dispute, allowed the defendant for more than ten years to use the trade-mark in controversy. — From these examples, it is seen how impracticable it is to make any inflexible rule on the subject. Circumstances must always control a decision. The language of Chitty, J., in 1884, is worthy of quotation:[6] "Now it is said that user is the life of a trade-mark, and non-user the death of it. These of course are metaphorical expressions, which must be received with caution. . . . A man who has a trade-mark may properly have regard to the state of the market, and the demand for his goods: it would be absurd to suppose he lost his trade-mark by not putting more goods on the market when it was glutted." This matter of intention demands further consideration in the light of other authorities.

§ 682. Would it constitute abandonment for the proprietor of a trade-mark calmly to look on while another files a claim for the identical mark? No. Wherefore? For the reason that assertion of title and the recording thereof do not create anything 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.[7] *Per Curiam:* "The deposit

[1] Gillott *v.* Esterbrook, 48 N. Y. 374.
[2] Wolfe *v.* Barnett, 24 La. Ann. 97.
[3] Lazenby *v.* White, 41 L. J. (N. S.) 354.
[4] Blackwell *v.* Dibrell, 14 Off. Gaz. 633; 3 Hughes, 163. The court cited this chapter as authority.
[5] Eydoux *v.* Morel, 23 Annales, 252.
[6] Mouson & Co. *v.* Boehm, *supra*.
[7] Leroy *v.* Calmel, 10 Annales, 193.

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 without exception maintained. It is the law of common sense. No one can obtain a title to lands by placing a non-valid paper on record; for, although having all the external appearance of truth, it may have been forged, or never been delivered. and therefore not be a deed in law. So of an emblem previously appropriated by another as his trade-mark. The unjust 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,[1] Clifford, J., held that actual abandonment must be proved, 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 in the case of a resident of France previous to the making of the convention of 1869. Yet his title was perfectly valid at common law. Section 9 of the statute of March 3, 1881, clearly recognizes this truth, for it makes it actionable for any person to "procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means," etc. Now, it is obvious that, if one by mere registration could divest another of a common-law right, said section should never have been written. Section 10 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

[1] Dental Vulcanite Co. v. Wetherbee, 3 Fish. 87.

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 beginning of a suit based on 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 monopoly in the invention." In the case of an easement,[3] 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,[4] 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, although at the time of said sale the plaintiff employed exclusively a mark of a different device; and that ' s property in the original trade-mark was not divested ' discontinuing its use. It may possibly be that the repo er of the case, although a highly intelligent member of

[1] Filley *v.* Fassett, 44 Mo. 173; 8 Am. L. Reg. (N. S.) 402; R. Cox, 530.
[2] American Hide, &c. Co. *v.* American Tool, &c. Co., 4 Fish. 305.
[3] Ward *v.* Ward, 7 Ex. 738.
[4] Lemoine *v.* Ganton, 2 E. D. Smith, 343; R. Cox, 142.

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 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.[1] 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 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

[1] See *ante*, § 34, "Principles on which Infringement is prohibited," and § 43, "Unfair Competition in Business."

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 were respectable booksellers and stationers in Washington, D. C., and dealers in fine penknives, scissors, and other cutlery. A preliminary 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 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

[1] Rodgers & Sons *v.* Philp & Solomons, 1 Off. Gaz. 29.

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 would be, 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

[1] See authorities cited *ante*, in note to § 336.

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 employees, 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, etc. In consideration of the honorable conduct of the defendants, in accepting the situation with good 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

[1] Taylor *v.* Carpenter, 3 Story, 458; R. Cox, 14.
[2] Taylor *v.* Carpenter, 2 Wood. & M. 1; 9 L. T. 514; R. Cox, 32.

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 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

[1] Amoskeag Manuf. Co. *v.* Spear, 2 Sandf. S. C. 599.
[2] Gillott *v.* Esterbrook, 47 Barb. 455.

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,[1] took the same position that had before been 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. 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 tends the same way, in vindication of the venerable maxim, "Jus et fraus nunquam cohabitant."[2]

§ 686. Yet truth compels the citation of 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.[3] 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."[4] 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 & Son, of Sheffield, England, had enjoyed an incontestable industrial renown; and that for many years — thanks to immunities given on the Continent to the

[1] Filley *v.* Fassett, 44 Mo. 173.

[2] Blodgett, J. (Williams *v.* Adams, 8 Biss. 452), held that abandonment of a trade-mark is not made out by showing numerous infringements in which the owner of the trade-mark has not acquiesced. The same doctrine was maintained in Sohl *v.* Geisendorf, 1 Wilson (Ind.), 60; and by the Supreme Court of Louisiana, in Funke *v.* Dreyfus, 34 La. Ann. 80; 44 Am. R. 413.

[3] Spencer & Son *v.* Peigney, 10 Annales, 197.

[4] See Broom's Legal Maxims, 700.

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 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, discoursed 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 file; 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 take only 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."—It is worth while to glance at later French and German authorities. The Tri-

bunal Civil of Lyons, in 1872,[1] held that abandonment of a registered trade-mark is not presumed, and cannot be presumed, from the fact of refraining from suing infringers during a time of more or less duration; and yet the defence had established the fact, that prior to 1845 the plaintiff had in his prospectuses admitted that his mark had been counterfeited.— In the month after that decision was made, the Court of Aix held that abandonment will not be presumed from the fact that the manufacturer and owner of the mark, to discourage competition, sold inferior products without affixing his mark thereto.[2] — In the Court of Paris, in 1874, it was held that abandonment is not to be presumed even when the inventor had published the name for the use of a particular business concern, and others could be interdicted for using the particular designation.[3] — So also in the Court of Cassation, in 1875, it was held that the fact that a certain number of industrials had made use of the inventor's name to designate a product obtained by the aid of his formulæ would not suffice to make that name *publici juris*, nor to turn it into a necessary name of the product.[4] — In the year after that, in Germany, the Court of Appeal of Cologne held that a trade-mark should not be considered as abandoned to the public from the mere fact that it had been used by a few members of a certain class of merchants, when it had not been used generally by that class.[5] — So the Court of Paris, in 1877, said that the proprietor of a regularly deposited trade-mark could not be deprived of his claim to exclusive user, unless he should have consented to its cession without reserve, or should have abandoned it in an absolute manner, that is to say, with an unequivocal will to let it fall into the public domain. The facts in that case were these. The plaintiff had published a list in which — among a great number of other and common marks, to be selected at pleasure by his retail customers, and to which they could join their own names — he had included

[1] Menier *v.* Buisson *et al.*, 18 Annales, 24.
[2] Menier *v.* Rochebrun, Ibid. 29.
[3] Liebig and Liebig's Extract of Meat Co. *v.* Collemann *et al.*, 19 Id. 83.
[4] Demot, Dubrac, & Benités *v.* Société des Heritiers Liebig, 20 Id. 115.
[5] Mulhens *v.* Buchholz, 24 Id. 29.

the mark involved in the suit; but he had continued to affix to his products a notice that his label and mark were registered. That was evidence that he had not abandoned.[1] — In 1882, the Tribunal of Havre[2] said, that whereas property in a mark can be abandoned expressly or tacitly, tacit abandonment cannot be presumed, and simple acts of tolerance cannot be deemed renunciation; that non-user itself during the time, more or less long, permits nevertheless the claim to property in a mark, provided that during that time it did not fall into the public domain. — The late M. Pataille, certainly very high authority, gave as his opinion, that the default of suing for false imitation going back for more than three years cannot be regarded as abandonment, when coupled with the fact that the owner of the trade-mark had legally registered it, and had not ceded his right.[3]

§ 687. We must constantly bear in mind that the decision of law in the case of Spencer & Son is based on 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.[4] 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

[1] Carrière *v.* Durand *et al.*, 25 Annales, 166.
[2] Chapu *v.* Legrand *et al.*, 27 Id. 201.
[3] Affaire Vrau *v.* Divers, 26 Id. 85.
[4] "Medicina mortuorum sera est." Quintil.

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 the trade-mark, it had not been abandoned. .

§ 688. The case of *Stubs* v. *Astier et al.*,[1] in the Court of Paris, in 1864, on appeal from the Tribunal Civil of the Seine, involved the same principle. The Tribunal 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 of March 10, 1860.[2] It must also be 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 the 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

[1] 10 Annales, 212.

[2] Such was also the reasoning of the Court of Rouen, in a case of citizens of the United States, in 1883. Lanman & Kemp *v.* Bognard *et al.*, 29 Annales, 200.

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.[1] 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 counterfeited 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 be 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.[2] Do they forfeit their rights by reason of mere

[1] Mellish, L. J. (in Ford *v.* Foster, L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818), said: "What is the test by which a decision is to be arrived at whether a word which was originally a trade-mark has become *publici juris?* I think the test must be whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods."

[2] Since the first publication of this section, nearly all European nations have, by treaties, or stipulations in the nature thereof, allowed foreigners to

lapse of time? No. There being no 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 obliged to repel every assault upon his property, under pain of forfeiture of title to it, what would be the consequence? He would constantly have to 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. Nevertheless, it must be remembered that a symbol that is *publici juris* in one country is so in all others. The Court of Cassation of France, in 1874,[1] held that, even when treaties confer reciprocity in trade-mark rights in France and England, the vulgarization of a mark in England is an obstacle to the claim of that mark in France.—So also in an appeal to the Saxon Court Royal of Leipzig, in 1878, it was held that foreign trade-marks that have ceased to be legally such in the country of origin are equally invalid in other countries.[2]—And so, in the Court of Appeal of Brussels, in 1884,[3] the same rule was applied.

§ 690. *Conclusion deduced from the foregoing Authorities.*—The phrase "abandonment of a trade-mark" means an *intentional* discontinuance of it. The original proprietor may

register, and consequently to sue. But registration has not a retroactive effect. The Tribunal of Commerce of Brussels, in 1883, held that a registration of a trade-mark in Belgium by a foreigner, anterior to a treaty with his country, is a nullity. 1 Bulletin Officiel, 178.—In the same year, the Court of Cassation of France held that the registrant of a trade-mark has no redress for counterfeiting before registration. Ibid. 198.—It is not vainglorious again to call attention to the truth, that in the United States a more liberal spirit has always prevailed, and that, without regard to nationality or formalities of registration, foreigners have stood on an equality with our own citizens.

[1] Lawson *et al. v.* Dechaille, 19 Annales, 153.

[2] Affaire Armstrong, 23 Id. 216.

[3] Jaubert-Bonnaire *v.* Wilford, Bulletin Officiel, January 8, 1885.

readopt it, unless in the mean time some other person or persons shall have lawfully become possessed 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, that 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 now emerging from 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 the present purpose. From clear indications, the belief is justified that all civilized nations will soon unite in an harmonious code for the protection of the trade-mark, as the surest guaranty of universal commercial faith.[1] 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.[2]

[1] See *ante*, § 26, and the Laws of Various Countries, in the Appendix. Has not this prophecy of more than a dozen years ago been almost completely fulfilled? Has not even Japan proved her right to be classed with the most enlightened nations in respect to the subject of this treatise? Truly, a common bond of interest has drawn all civilized countries into a close communion.

[2] What is demonstrated, on comparison of this revised edition with the first? That crude speculations have crystallized into established principles; and that conflicting opinions have, by the attrition of mind on mind, been reconciled, adjusted, and reduced to harmonious order.

APPENDIX.

TREATIES, CONVENTIONS, ETC., IN RELATION TO TRADE-MARKS.

CONVENTION *between the United States and the Austro-Hungarian Empire, November* 25, 1871. *Proclaimed June* 1, 1872. (17 *Statutes at Large*, 917.)

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, p. 676.

ADDITIONAL ARTICLE *to the Treaty of Commerce and Navigation between the United States and Belgium, of July* 17, 1858. *Proclaimed July* 30, 1869. (16 *Statutes at Large,* 765.) *Renewed June* 11, *and proclaimed June* 29, 1875.

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 and Belgium, of April* 7, 1884. *Proclaimed July* 9, 1884. (*Statutes for* 1883–84, *List of Treaties, etc.,* 56.)

ARTICLE I.

Citizens of the United States in Belgium, and Belgian citizens in the United States of America shall enjoy, as regards trade-marks and trade-labels, the same protection as native citizens, without prejudice to any privilege or advantage that is or may hereafter be granted to the citizens of the most favored nations.

ARTICLE II.

In order to secure their marks the protection provided for by the foregoing article, the citizens of each one of the contracting parties shall be required to fulfil the laws and regulations of the other.

AGREEMENT *between the United States and Brazil, September* 24, 1878. *Proclaimed June* 17, 1879. (21 *Statutes at Large,* 659.)

The citizens or subjects of the two high contracting parties shall have, in the dominions and possessions of the other, the same rights

as belong to native citizens or subjects in everything relating to property in marks of manufacture and trade.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

CONVENTION *between the United States of America and France concerning Trade-Marks, of April* 16, 1869. *Proclaimed July* 6, 1869. (16 *Statutes at Large*, 771.)

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 [respectively [1]] deposit duplicate copies of those marks in the Patent Office at Washington,[2] and in the clerk's office of the Tribunal of Commerce of the Seine, at Paris.

[1] This Article II. is not correctly translated. On March 21, 1877, the French Minister at Washington invited the attention of the Secretary of State to the fact of the omission of a material word, "devront *respectivement* être deposées en double exemplaire," etc. On April 25, 1877, the Secretary answered, that our government interpreted the article in the same sense as it has in the French text. (Coudert, *Marques de Fabrique*, p. 45.)

[2] 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 December 6, 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

CONVENTION *between the United States and the German Empire, of December* 11, 1871. *Proclaimed June* 1, 1872. (17 *Statutes at Large*, 921.)

ARTICLE XVII.

With regard to the marks or labels[1] of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade,[2] the citizens of Germany shall enjoy in the United States of America, and American citizens[3] shall enjoy in Germany, the same protection as native citizens.

DECLARATION *between the United States and Great Britain, October* 24, 1877. *Proclaimed July* 17, 1878. (20 *Statutes at Large*, 703.)

The subjects or citizens of each of the contracting parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted, or may hereafter be granted, to the subjects and citizens of the most favored nation, in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

DECLARATION *between the United States and Italy, June* 1, 1882. *Proclaimed March* 19, 1884. (*Statutes for* 1883–84, *List of Treaties*, 16.)

The citizens of each of the high contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as

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.*) This is the rule under the Act of 1881.

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.

[1] 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.

[2] These five words mean trade-marks proper.

[3] Observe the broad term, which is limited to citizens of the United States.

belong to native citizens, or as are now granted, or may hereafter be granted, to the subjects or citizens of the most favored nation, in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective nations.

ADDITIONAL ARTICLE *to the Treaty of Navigation and Commerce between the United States of America and the Emperor of Russia, of the 18th of December*, 1832. *Concluded and signed at Washington, January* 27, 1868. *Proclaimed October* 15, 1868. (16 *Statutes at Large*, 725.)

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 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.

TREATY *between the United States and Serbia, for facilitating and developing Commercial Relations, October* 2 *and* 14, 1881. *Proclaimed December*, 1882. (22 *Statutes at Large*, 966.)

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 two countries of the trade-mark 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 parties, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-mark 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 registered exclusively to wit: the marks of citizens of the United States in the Tribunal of Commerce at Belgrade, and the marks of Serbian subjects in the Patent Office at Washington, subject to the conditions and restrictions prescribed by the laws and regulations of the country in which the trade-marks are registered.

CONVENTION *between the United States and Spain, June* 19, 1882. *Proclaimed April* 19, 1883. (22 *Statutes at Large*, 979.)

ARTICLE I.

The citizens and subjects of each of the contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as the natives of the country in everything relating to the ownership of trade-marks, industrial designs or models, or manufactures of any kind.

Persons desiring to secure the aforesaid protection shall be obliged to comply with the formalities required by the laws of the respective countries.

TRADE-MARK 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, or to marks which consist only of letters, words, or numerals, or 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 employee 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 requisition.

ART. 14. The Chamber of Commerce and Industry shall always keep the register of marks open to the inspection of the public.

ARTS. 15–22. (These give a right to suppress a spurious mark, and to destroy instruments and appliances for counterfeiting; and also give an action for damages.)

BELGIAN TRADE-MARK LAW OF APRIL 1, 1879.

ART. 1. Every sign serving to distinguish the products of an industry, or the objects of a commerce, is considered as a mark of manufacture or of commerce. The name of a person, as well as that of a commercial or industrial house, may serve as a mark in the distinctive form given to it by the owner.

ART. 2. No one can claim the exclusive use of a mark if he has not deposited the fac-simile in triplicate, with the stereotype of his mark, at the office of the clerk of the Tribunal of Commerce in the place where his establishment is situated.

ART. 3. Whoever has first made use of a mark may alone make the deposit.

ART. 4. The instrument of deposit is inscribed on a special register and signed both by the depositor, or his attorney, and the clerk; the power of attorney remains annexed to the instrument. It states the day and hour of the deposit. It indicates the kind of industry or of commerce for which the depositor intends to employ the mark. A copy of the instrument of deposit is given to the depositor. Another copy is sent, within the week, with one of the deposited fac-similes and the stereotype of the mark, to the central office, by which the announcement of the deposit, the description, and the design of the mark shall be published in a special publication, six months at the farthest after the reception of the packet.

ART. 5. For each mark deposited a tax of ten francs is paid. The deposit is received only on the production of a receipt proving the payment of the tax.

ART. 6. Foreigners who conduct in Belgium industrial or commercial establishments enjoy, for the products of these establishments, the benefits of the present law on fulfilling the formalities

which it prescribes. The same applies to foreigners or Belgians who conduct their industry or commerce out of Belgium, if in the countries where their establishments are situated international conventions have stipulated reciprocity for Belgian marks. In the latter case the deposit of the marks takes place at the office of the clerk of the Tribunal of Commerce of Brussels.

ART. 7. A mark cannot be conveyed except with the establishment of which it serves to distinguish the objects of manufacture or of commerce. Every conveyance of a mark between the living shall be registered at the fixed charge of ten francs. The conveyance is of no effect as to third persons, until after a deposit of an extract of the conveyance in the forms prescribed for the deposit of the mark.

ART. 8. Are punished by an imprisonment of from eight days to six months, and a fine of twenty-six francs to two thousand francs, or of one of these penalties alone: —

(*a.*) Those who have counterfeited a mark, and those who have fraudulently made use of a mark.

(*b.*) Those who have fraudulently affixed, or made to appear by additions, retrenchment, or by alteration, on the products of their industry or the objects of their commerce, a mark belonging to another.

(*c.*) Those who have knowingly sold, or placed on sale or in circulation, products invested with a counterfeit mark, or mark fraudulently affixed.

ARTS. 9–15. (These provide penalties of fine and imprisonment for counterfeiting, or selling spuriously marked goods. The goods may be ordered to be destroyed.)

ART. 16. A fraudulent registration may be annulled.

ART. 17. All pre-existing laws on the subject are repealed.

BRAZILIAN LAW OF TRADE-MARKS. (Imperial Decree No. 2682, of October 23, 1875.)

Article 1 defines a trade-mark as the name of a manufacturer or merchant or firm, in some distinctive form; or any other denotation, emblem, stamp, seal, signet-stamped mark, relief, or wrapping of any kind, which may distinguish manufactured goods or articles of trade. Registration is a condition precedent to protection.

Marks composed exclusively of numerals or of letters, or of representations of objects that may give rise to scandal, are prohibited from registration. The law is applicable to foreigners on terms of reciprocity.

CANADA.

CONDENSED EXTRACT OF THE TRADE-MARK LAW OF MAY 15, 1879.

1. A register of trade-marks shall be kept in the office of the Minister of Agriculture, in which any proprietor of a trade-mark may have the same registered by complying with the provisions of the Act.

2. The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make rules and adopt forms.

3. The Minister of Agriculture may cause a seal to be made, and therewith seal trade-marks, copies, &c.

4. No person shall be entitled to institute any proceeding to prevent infringement of a trade-mark unless the same be duly registered.

5. The Minister of Agriculture may object to register any trade-mark in the following cases: *First.* If the said trade-mark is identical with or resembles a trade-mark already registered. *Second.* If it appears that the said trade-mark is calculated to deceive or mislead the public. *Third.* If the said trade-mark contains any immorality or scandalous figure. *Fourth.* If the so-called trade-mark does not contain the essentials necessary to constitute a trade-mark properly speaking.

6, 7. (Mode of presenting the case, by forwarding to said Minister a drawing and description in duplicate, with a declaration of novelty, and the fee. On registration, one of the copies of drawing and description, signed by the Minister or his Deputy, duly sealed and certified, shall be returned to the applicant. The certificate is made *prima facie* evidence in all courts of law or of equity in Canada of the facts therein alleged.)

8. For the purposes of this Act are included 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 by him manufactured, produced, compounded, packed, or offered for sale, no matter how affixed, whether to the article itself or to its case or other receptacle. Timber or lumber on which labor has been expended by any person in his trade, business, occupation, or calling shall be deemed a manufacture, product, or article.

9–11. A trade-mark may be general or specific, the latter being intended for merchandise of a particular description. A general mark shall endure without limitation. A specific mark endures

for twenty-five years, renewable for similar periods. The applicant for registration must state whether his mark is general or specific.

12. Fees, payable in advance: For general trade-mark, $30.00. For specific trade-mark, $25.00. Renewal of the latter, $20 00. If the application be refused, the fee, less five dollars, will be returned.

13–19. (These provide for cancellation at the request of the owner, for assignment, and for hearing disputes as to title. Infringement is made a misdemeanor, punishable by fine, to be paid to the owner. A private suit may be maintained for damages. The public registry shall be open to inspection. The Minister may correct clerical errors of his office.)

DENMARK.

LAW OF JULY 2, 1880, FOR THE PROTECTION OF MARKS OF TRADE AND COMMERCE.

I.

ART. 1. It is forbidden to all persons to affix to their merchandise intended to be put into general circulation, or on the packing thereof, the name of another person or firm, or the name of a place of manufacture of products of another person. It is equally forbidden to affix on such merchandise, or on its packing, a trademark to which another person has the exclusive right, in the terms of the following provisions.

II.

ART. 2. Whoever engages in Denmark in the manufacture or sale of merchandise intended in a general manner to be put into circulation, may acquire in Denmark the exclusive right to the mark or marks of fabric which he affixes to his merchandise, or packing thereof, to distinguish the same from merchandise made or sold by others, on the condition of declaring his mark, by insertion in the register for that purpose, conformably to the rules of the present law.

ART. 3. The register of trade-marks is held for all the kingdom at Copenhagen, by a conservator named by the Minister of the Interior, and after the rules of disposition, of form, and of conduct, determined by the said minister.

ART. 4. The declaration called for in article 2 should be made in writing and presented or sent without expense to the conservator. It should contain: —

1. The full name of the declarant, his domicile, or the name of the firm and place of business.

2. A clear description of such mark, indicating at the same time, if need be, the mode of employing said mark (for example, if it should be affixed to the merchandise itself or on its packing, pasted, branded, or stamped, &c.). This description should be accompanied by a fac-simile of the mark, of four inches in height by six inches in length or more, on strong paper. The deposit of this fac-simile should be in three copies. It should be followed by the deposit of a duplicate of the stereotype, which will not be returned.

The declaration should be signed by the declarant and accompanied with fees to the amount prescribed for declarations and publications.

ART. 5. So soon as possible after the reception of the declaration and the payment of the duties, the conservator shall receipt therefor in writing, with a statement of the day of reception. From the time of the declaration, it being seen that all the provisions above prescribed have been observed, if otherwise no obstacle to registration exists (Art. 6), it shall be proceeded with, and publication thereof shall be made (Art. 8).

ART. 6. Registration of the declaration shall be refused: —

1. If the mark consists only of numerals, or words, or letters.

2. If it contains names of a person or a firm different from the proper name or firm-style of declarant, or the name of a place which shall not be the seat of production of the merchandise manufactured by the declarant, unless the declarant establishes before the conservator that he has acquired the right of user, as a trade-mark, of the name or firm-style in question.

3. If the mark declared on contains public arms or public marks.

4. If it contains objects calculated to provoke public scandal.

5. If the same mark has previously been regularly declared on by another person.

In case of refusal of registration, the conservator shall give notice thereof to the declarant, with a statement of reasons for refusal. The declarant can, if he believe his rights to be damaged by such decision, refer the matter to the Minister of the Interior, who will decide.

ART. 7. (This relates to entering in register, &c., or refusal for valid reasons to enter on record.)

ART. 8. (As to publication of register.)

ART. 9. (The registration of a mark is subject to a duty of thirty kroner.)

ART. 10. (Giving any person the right to examine register, personally, or by obtaining extracts therefrom.)

ART. 11. (Accounts of the conservator.)

III.

ART. 12. Whoever shall have made the declaration prescribed by articles 2 and 4, and obtained registration, thereby acquires an exclusive right to invest his merchandise, or his packings, with the declared mark, and to place in commerce the merchandise thus marked. When several persons declare the same mark, the exclusive right belongs to the first in date. The right acquired in the user of a mark passes after the death of the grantee to his successor or to his heirs without a new declaration, but only for the term of one year from his decease.

ART. 13. (Obsolete by limitation.)

ART. 14. The declaration for a mark containing letters or words shall not prevent other persons from the use of the name or firm-style to designate that merchandise.

No one can acquire by declaration the right to marks which shall to that time have been in general use by all trades, or by certain classes of traders.

ART. 15. The measure of protection ordained by the present law against the unlawful use of a mark, of a name, or firm-style, shall extend also to the case where said mark, name, or style shall be represented with differences likely to escape the attention of the ordinary mind.

(ARTS. 16, 17, and 18 relate to remedies for infringements.)

IV.

ART. 19. The benefit of the present law may be extended by royal ordinances to traders who have their places of business in foreign nations, on condition of reciprocity, on the following terms:

1. The declarant shall indicate some attorney domiciled in Denmark to act for him.

2. He shall establish the fact of having complied with the conditions prescribed in the country of his residence for the protection of trade-marks.

3. He shall enjoy the right accorded by the present law only for the period of protection in his own country.

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 3,000 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 1,000 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 1 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 de-

clared 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 last five 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.)

LAW OF THE GERMAN EMPIRE RESPECTING TRADE-MARKS, IN FORCE EVER SINCE MAY 1, 1875.

§ 1. Traders whose firm is entered in the commercial register can apply to the proper court for the entry, in the commercial register of the district in which the principal firm has its domicile, of marks which are to be used on the goods themselves, or on the packing, to distinguish their goods from those of other traders.

§ 2. The application must contain a clear drawing of the trade-mark, together with a description of the class of goods for which the mark is destined.

§ 3. The registration of trade-marks, the use of which by the applicant is protected by the law of the State, and also of such marks which, up to the beginning of the year 1875, have been universally received in commerce as the recognized marks of a certain trading firm, may not be refused.

For the rest, the registration is forbidden if the mark consists exclusively of numerals, letters, public words, armorial bearings, or scandalous designs.

§ 4. The registration is made in the name of the firm of the applicant. The time of the application is then to be noted. If a trade-mark already registered has to be registered again, owing to the transfer of the head domicile, the time of the first application is then to be noted.

§ 5. On the petition of the partners of the firm the registered trade-mark will be cancelled.

It is cancelled officially, —

1. If the firm is removed from the commercial register.

2. If an alteration in the firm is applied for without a simultaneous application for the maintenance of the mark.

3. If ten years have elapsed since the register of the mark without an application for its further maintenance, or since such application without its having been renewed.

4. If the mark, according to § 3, ought not to have been registered.

§ 6. The first registration and the cancelling of a mark shall be notified in the " Deutscher Reichs-Anzeiger."

The costs of the notification of the registration are to be borne by the proprietor of the firm.

§ 7. For the first registration of a mark, which is not protected by the law of the land, a fee of fifty marks is to be paid.

The State's government can excuse the payment of a fee for the registration of such marks as, up to the commencement of 1875, have been accepted generally in trade as the known marks of certain tradesmen.

Other registrations and cancellings are gratis.

§ 8. The right to affix on goods or their packing a mark applied for in respect of such goods, at the commercial register, or to traffic in such goods, belongs exclusively to the proprietor of that firm to which the application was first granted.

§ 9. With respect to trade-marks, which are protected by the law of the State, likewise with respect to such marks as up to the commencement of the year 1875 have been accepted generally in trade as the known marks of a certain trader, no one except the proprietors protected by law, or universally acknowledged in trade, can acquire a right to such by an application for registration, provided that the proprietors shall have made the application before October 1, 1875.

§ 10. By the application for a trade-mark, which contains letters or words, no one will be prevented from using his name or his firm, even in making use of abbreviations for the verification of his goods.

No one can acquire a right by application to trade-marks which have hitherto been freely used by all, or by certain classes of traders, or the registration of which is not permissible.

§ 11. The proprietor of a firm for which a trade-mark is registered must have it cancelled on the demand of the party who has a right to exclude him from the use of the mark, or, as far as the trade-mark belongs to those mentioned in the second paragraph of § 10, on the demand of a participator.

§ 12. The right obtained through application for a trade-mark is cancelled, —

1. By the withdrawal of the application, or by a request to cancel it on the part of the proprietor of the firm to which it belongs.

2. When one of the cases in §§ 1–3 occurs.

§ 13. Every home manufacturer or trader can bring a civil action against any one who unlawfully marks goods with the name or the firm of the former, or who marks them with a trade-mark to the use of which the former is exclusively entitled, praying that the latter may be precluded from the right to use such mark, and be forbidden to use it any longer.

Similarly, the injured manufacturer or trader can bring a civil action against any one who unlawfully traffics in, or exposes for sale, marked goods, praying that the latter may be forbidden to deal in such goods.

§ 14. Whoever unlawfully marks goods or the packing thereof with a trade-mark, intended to be protected by the present law, or with the name or the firm of a home manufacturer or trader, doing so knowingly, or who knowingly traffics in such unlawfully marked goods, or exposes them for sale, shall be punished by a fine of from 150 to 3,000 marks, or by imprisonment not exceeding six months, and must give compensation to the injured party.

The prosecution only takes place on petition of the injured party.

§ 15. Instead of the fine provided for by this law, compensation to the amount of 5,000 marks can, on the demand of the injured party, be awarded to him.

For this compensation the condemned parties are liable as joint debtors.

When a fine is imposed, it excludes any further money compensation.

§ 16. The court will determine, if any, and what, damages are to be assessed, and it does this according to the evidence, fixing the amount it thinks proper.

§ 17. If the accused is found guilty, then, with respect to the goods found in his possession, the marks on the packing or the goods are to be destroyed, or if the removal of the goods is not possible, the packing or the goods themselves are to be destroyed, on the petition of the injured party.

If the accused is condemned, the injured party shall be authorized to publish the sentence at the cost of the condemned party. The manner of publication, as well as the period thereof, is to be declared in the sentence.

§ 18. The protection afforded by the provision of the present law to the proprietor of a trade-mark, a name, or a firm, will not be lost when the trade-mark, name, or firm is reproduced with changes, which can only be recognized after being the object of particular scrutiny.

§ 19. Civil suits brought by virtue of this law are taken as commercial suits, according to the spirit of the Imperial and States' laws.

§ 20. The provisions of the present law apply to the trade-marks of tradesmen who have no registered firm in the Empire, as well as to the names or firms of foreign manufacturers or tradespeople, if, in the State where the latter have their domicile, German trade-marks, names, and firms enjoy protection through a notification in the "Reichs Gesetzblatt"; the following special rules will, however, be enforced as regards the trade-marks (§ 1):—

1. An application to register a trade-mark must be made to the Commercial Court, at Leipsic, with a declaration that the applicant submits to the jurisdiction of the said court in all plaints brought by virtue of this law.

2. With such application, proof must be given that in the foreign country all requirements have been fulfilled to afford the applicant protection to trade-marks there.

3. The application entitles to a right to such trade-marks only so far and so long as the applicant is protected in its use in the foreign country.

ACT OF GREAT BRITAIN FOR THE REGISTRATION OF TRADE-MARKS, 1883.

62. (1.) The comptroller may, on application by, or on behalf of, any person claiming to be the proprietor of a trade-mark, register the trade-mark.

(2.) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office, in the prescribed manner.

(3.) The application must be accompanied by the prescribed number of representations of the trade-mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade-mark to be registered.

(4.) The comptroller may, if he thinks fit, refuse to register a trade-mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the

comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the court; and in that event the court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

63. Where registration of a trade-mark has not been, or shall not be, completed within twelve months from the date of the application, by reason of default on the part of the applicant, the application shall be deemed to be abandoned.

64. (1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

(*a.*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(*b.*) A written signature, or copy of a written signature, of the individual or firm applying for registration thereof as a trade-mark; or

(*c.*) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

(2.) There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act.

65. A trade-mark must be registered for particular goods or classes of goods.

66. Where a person claiming to be the proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of the statement of the goods for which they are respectively used or proposed to be used, or statements of numbers, or statements of price, or statements of quality, or statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately.

67. A trade-mark may be registered in any color, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other color.

68. Every application for registration of a trade-mark under this part of this Act shall, as soon as may be after its receipt, be advertised by the comptroller.

69. (1.) Any person may, within two months of the first advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade-mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within two months after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) If the applicant sends such counter-statement, the comptroller shall furnish a copy to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the court.

70. A trade-mark, when registered, shall be assigned and transmitted only in connection with the good-will of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that good-will.

71. Where each of several persons claims to be registered as proprietor of the same trade-mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the court.

72. (1.) Except where the court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the comptroller shall not register in respect of the same goods or description of goods a trade-mark identical with one already on the register with respect to such goods or description of goods.

(2.) The comptroller shall not register with respect to the same goods or description of goods a trade-mark so nearly resembling a trade-mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

73. It shall not be lawful to register as part of or in combination with a trade-mark, any words, the exclusive use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark, —

(*a.*) In the case of an application for registration of a trade-mark used before the thirteenth day of August, one thousand eight hundred and seventy-five, —

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, figures, though the same is common to the trade in the goods with respect to which the application is made.

(*b.*) In the case of an application for registration of a trade-mark not used before the thirteenth day of August, one thousand eight hundred and seventy-five, —

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made.

(2.) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August, one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or similar description of goods, shall, for the purpose of this section, be deemed common to the trade in such goods.

75. Registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark.

76. The registration of a person as proprietor of a trade-mark shall be *prima facie* evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade-mark unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act, or

of an enactment repealed by this Act, or, in the case of any other trade-mark in use before the thirteenth of August, one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

78. There shall be kept at the Patent Office a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

79. (1.) At a time not being less than two months, nor more than three months, before the expiration of fourteen years from the date of the registration of a trade-mark, the comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years, the comptroller may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If, before the expiration of the said three months, the registered proprietor pays the said fee, together with the additional prescribed fee, the comptroller may, without removing such trade-mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where, after the said three months, a trade-mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade-mark to the register on payment of the prescribed additional fee.

(5.) Where a trade-mark has been removed from the register for the non-payment of the fee or otherwise, such trade-mark shall, nevertheless, for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade-mark which is already registered.

80. There shall be paid, in respect of applications and registration, and other matters under this part of this Act, such fees as

may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

The Act contains general provisions, a few of which may be briefly noted as follows: —

The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade-marks, who shall act under the superintendence and direction of the Board of Trade.

The comptroller may refuse to register a trade-mark of which the use would, in his opinion, be contrary to law and morality.

The name of an assignee, &c., of a trade-mark may, on proof of title, be entered on the register; and any person appearing in the register as proprietor may absolutely assign, or otherwise deal with the trade-mark.

Every register shall be open to the public, and certified copies thereof be given, on payment of the prescribed fee. Copies, or extracts from the register, certified by the comptroller, and sealed with the seal of the Patent Office, shall be evidence in all courts, and in all proceedings. The court may, on the application of any person aggrieved by an omission, without sufficient cause, from any register, or by an entry, without sufficient cause, in any register, order the varying or expunging of the entry.

The court may decide any question as to the rectification of a register, and may direct an issue of fact to be tried, and award damages.

The comptroller has power, on request, to correct any clerical error, or cancel an entry.

The registered proprietor of any registered trade-mark may apply to the court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the court may refuse or grant leave on such terms as it may think fit.

If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Where discretionary power is given to the comptroller, he shall not exercise that power adversely to the applicant for registration of a trade-mark, without (if so required within the prescribed time

by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

It is a misdemeanor to falsely represent a trade-mark to have been registered, with a fine not exceeding five pounds.

"Person" includes a body corporate. "The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) the High Court of Justice in England. "Comptroller" means the Comptroller General of Patents, Designs, and Trade-Marks.

The Trade-Mark Registration Act of 1875, as amended in 1876, 1877, is repealed.

ITALY.

Law of August 30, 1868.

This is very much like that of France, of June 23, 1857, which see.

TRADE-MARK LAW OF JAPAN OF JUNE 7, 1884.

Art. 1. When trade-marks are registered at the agricultural and commercial departments in a book specially provided for the purpose, the owners of such marks may enjoy the exclusive privilege of employing them for a term of fifteen years from the date of registration.

Art. 2. Persons who are desirous of obtaining a right to the exclusive use of trade-marks must apply for registration by forwarding specimens and a detailed account of the marks. This account will explain the nature of the marks and the manner of using them, and will give the name and classification of the articles to which they are to be attached. When registration is permitted a certificate will be granted.

Art. 3. Applications for the registration of trade-marks will be retained by the authorities for two months from the date of their receipt, after which time they will receive sanction, should no conflicting applications have been received in the interim. When two or more persons happen to apply for registration of the same marks, or of marks which closely resemble each other, with the intention of affixing them to articles of the same classification, the application or applications of later date will be rejected; and when they are under the same date all will be rejected.

ART. 4. Suitable measures will be taken by the Minister of Agriculture and Commerce to exhibit the registered trade-marks to the public.

ART. 5. Registration of the following marks must not be applied for: 1. Marks which are exactly the same as, or are likely to be mistaken for, marks already registered, and which are designed to be affixed to articles of the same classification. 2. Marks which represent the name of a place, a person, a shop, or a company, and those representing the general name of articles, or national arms, either foreign or domestic. 3. Marks which are universally employed by a particular class of merchants, or which are used in accordance with the common customs of the commercial community. 4. New marks which are exactly the same as, or likely to be mistaken for, marks adopted prior to the promulgation of the present regulations, and actually used up to the present time, and all marks of a similar character intended to be attached to articles of the same class or description.

ART. 6. When persons who have registered their marks change their residences, the local jurisdiction, or their personal names, or abandon their trade, or suspend it for a year or upwards during the term for which the marks are registered, they must give notice of the said change, abandonment, or suspension to the authorities within three months.

ART. 7. When heirs succeed to the business of their predecessors during the term of the exclusive use of the latter's trade-marks, they must report the fact to the authorities within three months after their succession.

ART. 8. When persons who have obtained registration of marks desire to assign, wholly or in part, the right of using such marks to other persons, they must apply for fresh registration. In such cases the period of the exclusive use of the marks will be reckoned from the date of original registration.

ART. 9. When it is desired to apply or transfer the same marks to articles of other classifications, or to introduce some alterations into them, application must be made for fresh registration. In such cases applications will be dealt with in accordance with article 3 of these regulations.

ART. 10. When persons who have obtained registration desire to continue the exclusive use of trade-marks after the expiration of the registered term, they must apply for fresh registration within three months before the expiration of such term.

ART. 11. In the event of certificates of registration being lost or damaged, application must be made for fresh certificates.

ART. 12. When, after the registration of trade-marks, frauds are

detected in the original application for their registration, or in the specimens or detailed accounts furnished in accordance with these regulations, or when it is found that the original applications were carried out in violation of article 5, the registration will lose its validity, and the certificates will be cancelled by the authorities.

ART. 13. When the owners of registered trade-marks relinquish their business entirely, they will lose their right to the exclusive use of the marks from the date of such relinquishment. This provision also holds good in the case of the suspension of a trade for three years.

ART. 14. Applicants for registration of trade-marks must pay the following fees, provided that, in case their applications are rejected, the money will be refunded: 1. The sum of ten yen[1] must be paid for the registration of one trade-mark, and if the same mark is to be applied or transferred to articles of different classes, five yen must be added for each class. 2. Applications for transfer wholly or in part, or for alteration of trade-marks, or for the continuation of their use after the expiration of the registered term, will involve the payment of five yen for every mark. 3. One yen must be paid for obtaining a fresh certificate of registration.

ART. 15. The owners of registered trade-marks may claim damages from, or lay information against, any person who encroaches upon their privileges.

ART. 16. Persons who counterfeit registered trade-marks and employ them will be punished by imprisonment with hard labor, for a term not less than one month and not more than one year, in addition to a fine of from four to forty yen. Persons who use trade-marks clandestinely will be liable to a punishment mitigated by one degree from the above.

ART. 17. Those who make and use marks which are likely to be mistaken for registered marks will be liable to imprisonment with hard labor for a period of not less than fifteen days and not more than six months, and to a fine of from two to twenty yen.

ART. 18. Persons who, with full knowledge of the fact, undertake the sale of commodities bearing trade-marks of the nature interdicted by articles 16 and 17, will be liable to a fine of from four to forty yen.

ART. 19. In the cases set forth in the three preceding articles, 16, 17, and 18, the trade-marks will be confiscated, and when the marks are inseparable from the commodities, the commodities themselves will be destroyed.

ART. 20. Those who fraudulently effect the registration of trade-marks, or falsely assert that they have obtained registration, will

[1] A yen is equal to our dollar.

be punished by imprisonment with hard labor for a term of from fifteen days to six months, together with a fine of from two to twenty yen.

ART. 21. Persons who neglect to make a due report within a prescribed period, in accordance with articles 6 and 7, will be liable to a fine of from one yen to 1.95 yen.

ART. 22. Persons infringing these regulations will not be dealt with in accordance with those provisions of the penal code which refer to the occurrence of several offences.

ART. 23. Offences enumerated in articles 16 to 18, inclusive, will be taken cognizance of only after information is laid by the owners of the registered trade-marks.

ART. 24. When such information is laid against offenders by the owners of marks, the judges may suspend the sale of all commodities bearing the marks in question, pending investigation.

There are also By-Laws and Classification of Articles, which may be found in full in No. 44 of the United States Consular Reports. August, 1884.

CONDENSED EXTRACTS FROM THE NETHERLANDS TRADE-MARK LAW OF MAY 25, 1880. (23 Off. Gaz. 1334, in full.)

ART. 1. Any person desiring to secure the right to the exclusive use of a mark to be placed upon his goods, or upon the wrappers thereof, for the purpose of distinguishing such goods from those of others, shall send two copies, bearing his signature, of a distinct representation or drawing of such mark, and a minute description thereof (stating in said description the kind of goods for which the mark is to be used), to the clerk of the District Court of his place of residence.

If he have no place of residence within the kingdom in Europe, the transmission shall be made to the clerk of the District Court of Amsterdam, and he shall select a place of residence within the kingdom in Europe. The transmission may also be made by a person authorized for this purpose, in writing.

The mark shall contain no words or designs offensive to public order or good morals. It shall not consist exclusively of ordinary letters, figures, or words. Nor shall it consist (even though a slight alteration be made) of the arms of the kingdom, or of those of a province, commune, or other legally constituted public corporation.

The fee for registration and publication is ten florins.

ART. 2. The clerk shall enter the application in the public register, and give the depositor a certificate, and within three days report the case to the Department of Justice, which shall cause it to be published in the official paper.

ART. 3. If the mark offered for registration is identified with, or does not differ sufficiently from, a mark for the same kind of goods which is owned by another person, or for the ownership of which another person has made application, such person may, within six months after the publication, apply to the court, to the end that the registration be forbidden. After a notice of fourteen days, a hearing is had. From the decision of the judge there is no appeal; but within a month application may be made to have the decision set aside.

ART. 4. If the court forbid that a mark be registered, the Department of Justice shall be duly notified thereof, and a note of the fact shall be made in the register.

ART. 5. If within six months from the date of the announcement of the application for registration no application be made, the registration shall be made. The fact shall be announced in the "Nederlansche Staatscourant" on the 15th of the month.

The same law provides that the registration may be renewed in fifteen years; and punishes the counterfeiting of a trade-mark by fine and imprisonment.

LAW OF NORWAY OF MAY 26, 1884, THAT WENT INTO OPERATION JANUARY 1, 1885. (30 Annales, 169.)

The provisions of this law are very similar to those of Sweden, which see. The registration bureau is established at Christiania.

ROUMANIA.

The law for the protection of trade-marks went into operation June 27, 1879. Its provisions are much like those of the French law of June 23, 1857.

(*Translation from the Russian.*)

EXTRACT FROM THE STATUTE OF LAWS RELATING TO MANUFACTURING INDUSTRY. (Code of Civil Laws, Vol. XI., Part 2, Edition of 1857.[1])

Relative to the Imposition of Marks on Products of Russian Mills and Manufactories.

§ 74. The right of stamping or marking Russian manufactured produce of various descriptions shall be enjoyed by every manufacturer. No official investigations shall be made at works or factories as to whether the products of the same are marked or not.

§ 75. Free exportation out of the Empire shall be allowed of both marked and unmarked Russian manufactured goods, subject, however, to the proviso that this permission shall apply only to such goods as are allowed to be exported under the existing tariffs.

§ 76. Goods of Russian origin bearing trade-marks shall enjoy the following privileges: —

(*a.*) When foreign goods not bearing the stamp of the custom-house shall be discovered, together with Russian merchandise bearing genuine Russian trade-marks, the latter goods shall be recognized as of Russian origin, and shall not be liable to confiscation; they may only in such cases serve as security for penalties, as any other goods, according to the customs regulations. If, however, there shall be found among the smuggled goods merchandise alleged to be Russian, but which shall bear no trade-mark proving their origin, they shall in such cases be confiscated without any investigation as to their origin.

(*b.*) Russian goods bearing trade-marks, when reimported from abroad, shall be allowed to re-enter the country free of duty. Such goods, however, as shall bear no trade-marks shall be treated as foreign, in accordance with the customs regulations.

§ 77. In order to introduce a uniform system of trade-marks. the following rules are established: —

(*a.*) The mark shall bear on it the Christian name and surname of the manufacturer, or these may be indicated by initials; the seat of the manufactory must also be shown.

The mark must be solidly and legibly imposed, and the letters must be in the Russian character; other letters may also be

[1] Reports relative to Legislation in Foreign Countries on the subject of Trade-Marks (British Parliament, 1879), p. 96.

used, on condition that a Russian mark shall, in addition, be employed.

(*b.*) On the establishment of a new manufactory, the owner, who may be desirous of using a trade-mark, shall inform the department of Commerce and Industry of such wish, and also state where the manufactory is situated, and the nature of the industry which will be pursued in it; a specimen and written description of the trade-mark which it is contemplated to use must be forwarded at the same time.

(*c.*) Whenever a manufactory shall be sold or closed, the manufacturer shall inform the Department of Commerce and Industry of the same.

(*d.*) Should a manufacturer deem it necessary to make some alterations in his trade-marks, he shall signify such intention to the Department of Trade and Manufactures, stating from what period the new trade-marks will be imposed on the goods.

(*e.*) Should the Department of Commerce and Industry disapprove of the proposed trade-mark on the ground of its being either contrary to regulations, or that a similar mark has already been registered, from which the proposed mark does not differ sufficiently, an alteration in the submitted mark shall be demanded by the Department.

(This law also punishes counterfeiting, and gives a right to damages. Goods of Russian origin are protected, though not bearing trade-marks.)

CONDENSED EXTRACTS FROM THE SWEDISH TRADE-MARK LAW OF JULY 5, 1884, THAT WENT INTO OPERATION JANUARY 1, 1885. (30 Annales, 161.)

1. Every person having the right to the use of a trade-mark, whether personal or attached to his place of business, whether he be manufacturer, agriculturist, miner, merchant, or other trader, may by registration secure the exclusive privilege of using his special trade-mark to distinguish in commerce his products from all others; whether said mark be affixed directly to his merchandise, or applied to the envelope or wrapper.

2. The trade-mark bureau for the whole country is established at Stockholm.

3. An application must be post-paid. It must contain a complete description of the mark, state the name of the owner, his business location, and the class of goods to which the mark is

attached. With it must be three copies of the mark on strong paper not more than ten centimetres high by fifteen wide; and the fee of forty crowns.

4. Registration is prohibited to so-called marks consisting: 1, only of numerals, letters, or words not in peculiar form; 2, of a concealment of the true name of the applicant; 3, public arms or seals; 4, objects of an offensive nature; 5, of an exact resemblance to another registered or announced mark, or such a near resemblance as to be calculated to deceive or mislead.

(Registration lasts ten years, and may be renewed. It is provided that a foreigner may register, provided his country affords similar privileges to Swedes. Registration expires with registration in the foreign country. A foreign applicant must show that he has complied with the formalities required by the registration law of his own country.)

CONDENSED EXTRACTS FROM THE SWISS TRADE-MARK LAW OF DECEMBER 19, 1879. (23 Off. Gaz. 2237, in full.)

ART. 1. The Swiss Confederation recognizes and protects marks of manufacture and trade in conformity with the provisions of the present law.

ART. 2. The following are considered as marks of manufacture or trade: Firm-names, as well as symbols placed adjacent to, or in lieu of them, that appear upon manufactured articles or merchandise, industrial or agricultural, or upon their coverings or envelopes, in order to distinguish them and establish their origin.

ART. 4. The initials of a firm are not sufficient to constitute a mark. Similarly, symbols placed adjacent to or in place of names of firms cannot be protected if they consist exclusively of ciphers, letters, or words, or are contrary to good morals. Public heraldic devices appearing upon the marks of individuals are not placed under the protection of the law.

ART. 5. The use of a mark in so far as concerns firms cannot be claimed in court unless the mark has been regularly deposited, and the registry published in the official trade bulletin or some other official federal bulletin designated for that purpose. In absence of proof to the contrary the presumption will be that the first depositor of a mark is also the equitable possessor.

ART. 6. The mark must be distinguished by essential characteristics from those already registered, unless it is applied to a different class of products or merchandise.

ART. 7. The following are authorized to register marks: — 1. Manufacturers having the seat of their manufacture or production in Switzerland, and merchants having a commercial house regularly established within the same. 2. Manufacturers or merchants established in States that allow citizens of Switzerland reciprocity of treatment, provided these manufacturers or merchants furnish proof in addition, that their marks or firm-names are sufficiently protected in the place of their establishment.

ART. 8. The duration of rights established by registering a mark is fixed at fifteen years, renewable indefinitely for the same period. Fee for each registry or renewal twenty francs.

ART. 9. The mark can only be transferred with the enterprise, the product, or merchandise of which it serves to distinguish. The transfer is of no effect in regard to third parties till after the registration and publication of the act confirming the same. (The fee for a transfer is fixed by article 16 at twenty francs.)

The same law prescribes the mode of making deposit for registry. To the application duplicate copies of the mark and a stereotype plate are appended, and other formalities are set forth. It also contains provisions for damages for counterfeiting or usurping marks, besides penalties of fine and imprisonment.

TURKEY.

A special regulation as to trade-marks, first promulgated in 1870, seems to be still in force. Registration is a condition precedent to suit for infringement.

LAWS OF THE UNITED STATES RELATING TO THE PROTECTION OF TRADE-MARKS.

AN ACT *to punish the counterfeiting of Trade-Mark Goods and the sale or dealing in of counterfeit Trade-Mark Goods. Approved August* 14, 1876. (1 *Supp. to Rev. Stats.* 241.)

This may be found in condensed form, *ante*, § 371. It is published in full in the edition of April, 1885, of the official publication of "Patent Laws and Laws relating to the Registration of Trade-Marks and Labels," p. 27.

AN ACT *to authorize the Registration of Trade-Marks and protect the same. Approved March* 3, 1881. (21 *Stat.* 502; *edition of April*, 1885, *of the official publication above mentioned, p.* 29.)

See also *ante*, §§ 283, 309, 325, 330, 333, 334, 337, 348, 355, 357, 358, 361, and 365, with a commentary thereon.

For AN AMENDMENT to said Act, approved August 5, 1882, see said official publication, p. 32.

PROHIBITION *upon the Importation of Simulated Watches, &c., sec.* 2496, *Rev. Stats., as amended by Act approved March* 3, 1883. (22 *Stat.* 490; and *ante*, § 368.)

INDEX.

[*References are to sections.*]

A.

ABANDONMENT, (see Chapter XV.)
sometimes an affirmative defence, 674.
error in arguing from supposed analogies, 675, 676, 679.
of mark differs from that of other property, 675.
discarded symbol may be adopted by others, 677.
resumed by original proprietor, 677, 690.
when extinguishment of trade-mark, 678.
permitting others to use is not, 681.
patent cases do not furnish precedents, 679.
what amounts to, 680, 681.
giving necessary name to a product is, 220, 252.
intention is the criterion of, 498, 681, 686, 690.
mere lapse of time is not conclusive of, 681.
is a fact, and not a conclusion of positive law, 681.
must be established by the strongest proof, 681.
may arise by express declaration, or by conduct, 681.
non-resistance to registration by another, not fatal, 682.
what neglect operates as forfeiture, 681.
forbearance to sue is not abandonment, 685.
distinguished from neutralization of symbol, 686–689.
in one country is in law *total* abandonment, 689.
ABRAHAM, dealt in money current with merchants, 10.
ABSTRACT SYMBOL,
there is no property in an, 46, 52, 61, 66, 129, 301, 302, 384, 450.
reasons why it cannot be transferred, 363, 379, 380.
"A. C. A." case (*Amoskeag Manuf. Co.* v. *Spear*), 93, 94, 153–156.
ACCIDENTAL USE by others of same emblem, 383.
ACCOUNT IN EQUITY,
an accounting of profits required, 506, 507, 517.
not ordered where complainant negligent, 497.
innocent vendor of spurious goods not to keep, 471.
ACQUIESCENCE IN USE OF MARK,
may not amount to abandonment, 681.
defeats right to call for account in equity, 497.

[REFERENCES ARE TO SECTIONS.]

ACQUISITION OF TITLE to mark, 53.
by assignment, 57, 361–364.
ACTION AT LAW, as remedy for infringement, by statute, 346.
at common law, 356.
on the case for false representations in the Patent Office, 385.
for slander of a trade-mark, 473.
ACTS OF CONGRESS in relation to trade-marks, (see Chaps. VI., VII.)
that of July 8, 1870, considered, 26, 280 *et seq.*
August 14, 1876, to punish counterfeiting of marks, 26, 371.
March 3, 1881, providing for registration, 26, 282.
August 5, 1882, amendatory thereof, 366.
ADOPTION OF SYMBOL AS A TRADE-MARK,
is foundation of title, 45 *et seq.*, 301, 324, 361–364.
by affixing to merchandise, 52, 54.
title of, instantly perfected, 52, 306.
avowal of intention to adopt is not adoption, 52.
registration is not adoption, 48–52, 379, 380.
must be in connection with a specific class of goods, 300 *et seq.*
propriety must be observed in, 602.
AFFIXING OF MARK TO MERCHANDISE,
what amounts to, 304, 305.
AGENT is civilly and criminally responsible, 58.
"AKRON" case (*Newman* v. *Alvord*),
principle of that case applied, 182, 533.
ALDUS MANUTIUS, his mark for books, Dolphin and Anchor, 14.
ALIENAGE, no bar to protection, 21, 287, 288, 689.
ALLEGATIONS in applications for registration, 576.
must be clear and distinct, 583 *et seq.*
not conclusive on Patent Office, 607.
ALLUSIVE DEVICES, standing for names, 198.
ALTERNATE FORMS, the doctrine of, 588, 606.
AMENDMENTS, of application papers, limited, 577, 578.
enlarging claim require supplemental oath, 578.
must not substitute other symbols, 578.
to be made on sheets separate from the original, 579.
AMERICAN CITIZEN, may commercially be a foreigner, 294, 297.
"AMERICAN SARDINES," not a valid trade-mark, 134, 610.
AMERICAN WATCHES, etc., piracy on, 26, 369.
ANALOGUES OF THE TECHNICAL TRADE-MARK,
discrimination necessary, 83, 90, 100, 521.
trade-names, 91, 521.
labels, wrappers, advertisements, signs, 537, 538.
names on conveyances, 560, 561.
titles of publications, 546.
"ANATOLIA" case (*McAndrew* v. *Bassett*), 184, 191.
"ANGOSTURA BITTERS" case, 194.
ANIMATE PROPERTY, with owners' marks, 16.

[REFERENCES ARE TO SECTIONS.]

ANTIQUITY of proprietary marks, 1, 2, 11.
APPEAL from Trade-Mark Examiner, 649.
to Supreme Court, without regard to amount involved, 337.
APPLICANT'S OWN NAME, merely, is not a trade-mark, 326.
use of, may be only a cover for fraud, 420, 420 *a*.
APPLICATION FOR REGISTRATION, (see Chapters VI., VII.)
preliminaries to, 565.
necessity for forms, 568.
substance more important than technical form, 569.
system of examination, 571.
Office may plead in abatement, 572.
papers serve purpose of declaration in an action, 573.
issue joined, and law questions argued, 575.
drawing and filing of application papers, 576.
limited power of amendment, 577, 578.
manner of making amendments, 579.
design of oath, 580.
prima facie title of applicant to his mark, 581.
essence of the mark to be presented, 582.
indefiniteness of description, 583–585.
breadth of claim, 586–590.
degree of specificness, 591, 596, 600.
hypothetical false models of application papers, 592–594.
mere descriptive terms not valid marks, 596, 600.
APPLICATION OF MARK TO MERCHANDISE,
is essential to title, 143, 304.
mode of making application, or affixing, 305.
"ARAMINGO MILLS" case (*Colloday* v. *Baird*), 186.
ARBITRARY SYMBOLISM, misconception as to nature of, 138.
ARMS, national, not valid trade-marks, 261.
of family may be essential features, 261.
ART, trade-mark not deemed a work of, 110.
ARTICLE, proper name of, not a trade-mark, 165–177.
injurious in itself, not protected, 350.
ARTIFICIAL PERSON may own trade-mark, 55, 317.
but not so unless a trader, 55.
"ASPHALTE DE SEYSSEL," being geographical, not a mark, 598.
ASSAY MARKS in England, France, and Switzerland, 19.
ASSESSMENT OF DAMAGES, (see Chapter XI.)
direct and immediate consequences to be regarded, 504 *et seq.*
one cannot avail himself of his own neglect, 504, 510.
actual damages to be recovered, 503.
plaintiff not held to exact statement, 504.
plaintiff's loss, not defendant's gain, the criterion, 504.
rule varies from that in patent cases, 515, 516.
accounting in equity for profits, 507, 517.
wrong-doer not allowed to be the judge, 504, 518.

[REFERENCES ARE TO SECTIONS.]

ASSIGNMENT, 57, 361–363.
AUSTRIAN registration law, 26, Appendix, p. 678.
AUSTRO-HUNGARIAN CONVENTION, Appendix, p. 673.
AUTOGRAPH, one's own may be a valid trade-mark, 87, 204.
and so also a fac-simile thereof, 87, 207.

B.

BADGE, as a proprietary mark, 5.
"BALM OF THOUSAND FLOWERS" case, 148, 241, 243.
BANKRUPTCY, trade-mark included in assets. (See Chapter XII.)
BASS & CO.'S case, 448.
the placing of genuine mark on genuine goods not piracy, 448.
BELGIUM, registration law of, Appendix, p. 680.
treaty and convention between the United States and, Appendix, p. 674.
"BISMARCK," a valid trade symbol, 68.
"BLANCHARD CHURN" case discussed, 377.
BLASPHEMOUS ALLUSIONS condemned, 602.
BLENDING of trade-mark and other rights, 418.
unfair competition involves, 43, 44, 418.
"BLONDIN" protected as a pseudonym, 213.
"BLÜCHER," a man's name to designate boots, 181.
BOOKS, trade-marks for, 14, 15.
protected as merchandise, not as literature, 116.
titles of, sometimes perfect trade-marks, 546 *et seq.*
"BORWICK'S BAKING POWDERS" case, criminal, 452.
"BOUQUET" case, picture of bouquet and word "Bouquet" held to conflict, 449, 661.
"BOVILENE" and "BOVINA" case, 397.
BRAND, as a mark of ownership, 5.
BRAZIL, agreement between the United States and, Appendix, p. 674.
registration law of, Appendix, p. 681.
BREACH OF FAITH, in disclosing secret process, 562.
BREADTH OF CLAIM,
most likely to be founded in simplicity, 586–588.
mistake, by claiming too much, 588, 590.
"BRICK POMEROY," a valid personal designation, 214.
BRITISH "MERCHANDISE MARKS ACT" of 1862, 85, 102.
"BROSELEY" PIPE case, 17.
"BROUGHAM," a man's name to designate a carriage, 181.
"BURGESS' ESSENCE OF ANCHOVY SAUCE," not valid, 432.
BUSINESS, names protected. (See Chapter XII.)
names and styles, in signs and labels, 521 *et seq.*
place of, must be stated in application for registration, 296.
use of mark for unlawful, defeats remedy, 348 *et seq.*
BUYERS OF GOODS, falsely marked, suit by, 63.

[REFERENCES ARE TO SECTIONS.]

C.

"CABLE-STITCHED KID GLOVES," merely descriptive, 134.
"CABLE-TWIST TOBACCO" case, discussed and rejected, 167–175.
CÆSAR, JULIUS, the first to stamp his image on coin, 9.
"CALCULATED TO DECEIVE," oath that mark is not, 309, 328.
"CALENDAR WATCH" rejected, as merely descriptive, 376.
CALIFORNIA, definition of trade-mark, in Political Code of, 164.
CANADA, trade-mark, law of, Appendix, p. 682.
timber-marks, 16, note.
"CARTE BLANCHE," champagne-wine case, 438.
CARTHUSIAN MONKS' trade-mark suits, 407–410, 582.
CASE, action on the. (See ACTION AT LAW.)
CAVEAT emptor, 11, 64, and *venditor*, 64.
"CENTENNIAL," trade-mark interference, 340, 638.
CERTIFICATE, of officer to affidavit, 314.
of Commissioner of Patents, to be evidence, 330.
of registration, is not a *patent*, 340.
CERTIFICATE OF REGISTRY, 330, 331.
CHARACTERISTICS, essential, of a trade-mark, 143.
"CHARIVARI," French journal case, 551.
"CHARTER OAK," a valid trade-mark for stoves, 148, 150.
"CHARTREUSE" has all essential elements of trade-mark, 410, 582.
CHATTEL, history of word, 3.
"CHEMICAL PAINT" case considered, 251, 259.
CHEMICAL PRODUCTS, name of, not a valid mark, 166.
CHINESE, antiquity of their trade-marks, 13, 215.
perfect system of marking goods, 42.
imitation of marks in England, 232.
citizen of the United States held to be commercially Chinese, 294.
"CHINESE LINIMENT" case (*Coffeen* v. *Brunton*), 460, 462, 538.
"CHIROPLAST," inventor of, lost a good trade-mark in name, 601.
"CHLORODYNE" held not to be a valid mark, 252.
CHRISTIAN NAME, law recognizes but one, 196.
CIPHER, as a distinctive sign or mark, 87, 262.
CIRCULATING MEDIUM, its origin, originally cattle, then coin, 9.
CITIZENSHIP, not necessary to entitle to registration, 297–299.
yet must be divulged in application, 283.
CITIZENS OF THE SAME STATE, suits between, under Act of 1881, 358.
CLAIMANT does not register mark, but a *copy* thereof, 382.
"CLASS OF GOODS," restricted meaning of phrase, 66–70, 300.
protection given only in connection with, 66–70, 300, 450, 590.
particular description of goods must be alleged, 300.
definition of "class" sometimes strained to do justice, 66, 67.

[REFERENCES ARE TO SECTIONS.]

"CLEAN HANDS," (see "DEFENCES," Chapter X.)
indispensable to complainant in equity, 71, 348–354, 474 *et seq.*
inconsistent with unlawful business, 475.
with laches in lying by, without suit, 497.
with deceit of the public, 475, 476, 478, 479.
as to manufacturer, 474.
as to place of manufacture, 71, 481–483.
as to intrinsic excellence, 485–488.
by misuse of another's name, 474.
as to quack medicines, 491.
as to origin, 488, 491.
a lack of, not necessarily indicated by harmless statement, 492.
by fictitious name of manufacturer, 490, 495.
"COCOAINE" case (*Burnett* v. *Phalon*), 237–239, 450, 612.
COINER of new word may use same as trade-mark, 219.
COINS, marks on, 9, 10, 27.
COLOR, as an essential element of a trade-mark, 263–267, 585, 603.
one color may neutralize another, 264, 585.
must be definite and certain, if essential, 266 *et seq.*, 585.
an important circumstance in infringement case, 267, 413.
as means of deceiving the public, 268.
independent of *form*, cannot be a trade-mark, 138, 269–272.
as national proprietary signs, 74.
uncertainty in describing, 585.
COLORABLE infringements, 385 *et seq.*
COLORABLE VARIATION exemplified, 33, 385 *et seq.*
no fixed rule as to, 33.
COLTON DENTAL ASSOCIATION, sign case, 540.
COMBINATION, improper application of patent theory, 368.
COMITY OF NATIONS, 21, 22, 286 *et seq.*
demands the protection of all commercial rights, 21, 22.
courtesy due to all friendly strangers, 21.
disregarded at times by France, 23.
COMMERCE and trade-marks of equal antiquity, 2.
required its hieroglyphics, 12.
COMMERCE AND MANUFACTURE, twin-sisters, 78.
COMMERCIAL CHARACTER,
imparted by residence in foreign country, 295, 297 *et seq.*
COMMERCIAL SIGNATURE, a trade-mark is one's, 130, 280.
and should be valid all over the world, 260, 689.
COMMISSIONER OF PATENTS,
to make regulation for registration of marks, 308.
not to receive or record marks not lawful, 325.
nor merely the name of the applicant, 325.
nor a mark improperly claimed, 325.
to issue certificate of registration, 330.
to prescribe regulations, and forms for transfer, 361.

[REFERENCES ARE TO SECTIONS.]

COMMISSIONER OF PATENTS, — *continued.*
strictly to follow statutes in ministerial acts, 329.
has not power to cancel certificates, 624.
may place two parties on same footing, 624.
COMMON-LAW REMEDIES FOR INFRINGEMENT, (see ACTION.)
not affected by Act of March 3, 1881, 357 *et seq.*
"COMPAGNIE DES PROPRIETAIRES DE VIGNOBLES," 599.
COMPULSORY testimony, 639.
CONCESSION of priority of adoption, how made, 634.
CONFEDERATE STATES' notes counterfeited, 76.
CONFIDENCE indispensable to social compact, 580.
is the object of applicant's oath, 580.
"CONFORMATEUR DU TAILLEUR," sign infringement, 535.
CONGRESS, provision to protect American watch-makers, 74, 369.
marks on foreign manufactures, 369.
act of, in relation to registration of trade-marks, 283–366.
does not pretend to create trade-marks, 317.
has authority to legislate on trade-marks, 281.
"CONGRESS WATER" trade-mark case, 146 *et seq.*, 598.
CONSTITUTION, power conferred on Congress by, 109, 281.
CONTEMPT of witness before Patent Office, how punished, 639.
CONVENTION, meaning of term as used, explained, 286.
"CONVEYANCE COMPANY" case (name of coach), 413.
COPIES, ten fac-similes of mark to be filed, 304.
of testimony, printed preferred, 641.
COPYRIGHT cannot protect a trade-mark, 109–112.
not analogous to trade-mark, 112.
protects book as work of intellect, not as mere merchandise, 117.
difference from a trade-mark or a patent, 109, 129.
CORPORATION, protected in use of lawful mark, 309, 317–323.
entitled to trade-mark only as a trader, 55, 317–320.
meaning of term "corporation" sometimes misunderstood, 323.
oath to be made by officer of, 309.
who is such officer, 323.
mere name of, not a trade-mark for itself, 321, 322.
COSTS in infringement cases, 469, 471, 472.
COUNSEL, selection of, before Patent Office, 566, 567.
COUNTERFEITING,
consists, generally, in actual affixing of false mark, 337, 343, 344.
may consist in applying mark to mere box or envelope, 440.
may sometimes be complete without actual use, 456.
workman not allowed to plead his own good faith, 456.
he is guilty who causes act to be done, 341, 441.
"CRAYONS POLYGRADES" case (*Faber* v. *Faber*), 421.
"CRÈME D'ARGENT," as applied to a chemical product, 236.
CRIMINAL LAW, Act of August 14, 1876, 371, 381.
and the Civil Act of March 3, 1881, in effect one, 372.
see list of penal statutes of States, 452 *note*.

[REFERENCES ARE TO SECTIONS.]

CRIMINAL PROSECUTION for simulating mark, 371, 452.
"CROWN SEIXO WINE" case, 405, 406.
"CUNDURANGO OINTMENT, C. O.," rejected, as descriptive, 276.

D.

DAMAGES, (see Chapter XI.)
statutory provision for, in case of infringement, 337
of fraudulent registration, 355 *et seq.*
depends upon substantial loss to plaintiff, 343 *et seq.*, 499, 504.
upon actual affixing of mark to goods, 337, 500.
sometimes given without proof of specific injury, 501.
no fixed and certain rule for measuring, 502.
compensatory, should be given, 503, 507.
special, are not presumed, 43, 504, 509.
must be proved, not based upon mere conjecture, 505.
intent is a prominent element in fixing, 508.
amount of, not dependent on defendant's profits, 507.
plaintiff's negligence may defeat claim to, 510.
difficulty in fixing amount in trade-mark case, 512–515.
patent and copyright cases no standard, 513, 516.
exemplary, when allowed, 519, 520.
wrong-doer not allowed to apportion his wrong, 518.
a threat to injure is not ground for, 500.
mere possible injury no ground for, 500.
DAMNUM absque injuria, 384, 420, 431, 499, 500.
DANGER in superficially reading Trade-Mark Law, 279 *et seq.*
"DAY & MARTIN'S BLACKING" case, 423.
"DEAD RED BALL" as a mark for a base-ball, 585.
DECEIT, protection of public from, 30, 36–39, 309, 328.
DECEIVE, "calculated to," mark must not be, 328.
Patent Office will judge for itself on this point, 329, 352, 580 *et seq.*
DECLARATION, under oath, of exclusive right to use of mark, 309 *et seq.*
to be made by person, or officer of corporation, 309.
strictness of verification of, 313.
of interference, in what cases, 622, 633, 638.
DEFENCES, (see Chapter X.)
that complainant has been guilty of deceit. (See CLEAN HANDS.)
of bad faith in lying by, 497.
of negligence, 510.
to bill for injunction in the "Durham Tobacco" case, 660.
no defence that spurious goods are equal to genuine, 344, 496, 505.
that plaintiff's advertisements are exaggerated, 492.
that manufacturer's name is fictitious, 494, 495.
that complainant delayed, when delay necessary, 498.
may be either affirmative or negative, 474.
false statement in foreign language no defence, 481.

[REFERENCES ARE TO SECTIONS.]

DEFINITION AND NATURE of a trade-mark. (See Chapter III.)
necessity for, 1, 80, 136.
English, French, German, etc. definitions, 85, 87, 102.
of the term "owner," Act of March 3, 1881, 284.
"interference," 621.
"*laisser tomber dans la domaine public*," 681.
DEMARCATION,
line of, between trade-marks and analogues, 136.
"DEMOCRATIC REPUBLICAN NEW ERA" case, 550.
DENMARK, registration law of, Appendix, p. 633.
DEPOSIT of mark, not necessary to acqurie and conserve title, 48 *et seq.*
DESCRIPTION of mark must be filed with application, 303.
of color in application, 585.
DESIGN, is not the question, but adoptiou is, 54, 661.
patent for, explained, 111.
if patented, cannot be registered as a trade-mark, 113.
DEVICE for trade-mark is a matter of fancy, 87, 102.
propriety must govern, 602.
DICTA not authorities, 82, 84, 99, 391.
DILIGENCE, "race of," not inquired into, in registration, 384, 661.
DISAGREEMENT of judicial minds, 149, 658–660.
DISCOVERY, usually an equitable remedy, 469 *et seq.*
under Judiciary Act of 1789, in actions at law, 470.
in aid of forfeiture, not favored in equity, 470.
DISSOLUTION OF PARTNERSHIP, in absence of stipulation, each
can use old firm-name, 524 *et seq.*
DOMICILE, (see Chapter VI.)
owner, in United States, may register mark, 283.
term commented on, and explained, 292–295.
an essential allegation, in certain applications, 291, 591.
forensic, 294.
national and commercial, may not be identical, 294 *et seq.*
and residence not convertible terms, 299.
DURATION of trade-mark, life unlimited, 109, 143, 333.
"DURHAM" may or may not be a geographical name, 192.
interference case, three opinions, 658–660.
opinion of Examiner, 658.
Commissioner, 659.
Judge Rives, 660.

E.

"EAU DE LA FLORIDE,"
infringed by "*Eau de la Fluoride*," 397, 450, 612.
"EDGERLINE" (from Edgerley, the owner), a valid mark, 217.
EGYPTIANS, ancient, sign-boards of, emblem, &c., 6.
ELECTION of remedies, 506.

[REFERENCES ARE TO SECTIONS.]

EMBLEMS OF OWNERSHIP, (see TRADE-MARKS.)
coeval with birth of traffic, 2.
had origin in general ignorance of reading language, 3.
as signs of ancient Egyptians, Greeks, Romans, 6.
used in all ages, among all races of men, 11.
of old-time booksellers and printers, 14, 15, 116.
pipe-makers in England, 17.
goldsmiths in England, 19.
variety of, 87.
nondescript vignettes, groups of flowers and fruits, not legal, 89.
comprehensiveness of British Act of 1862, 102.
"ENGLISH EMBASSY CHEMIST," shop-sign case, 529.
ENGLISH ROYAL ARMS, as water-marks upon paper, 7.
"ENGLISH'S BROOMS" case considered and criticised, 162, 163, 597.
EQUALITY in value of spurious with genuine goods, no defence, 344, 496, 505.
EQUITY, (see CLEAN HANDS; PROTECTION.)
acts only when legal title is clear, 31, 462.
ESSENTIAL CHARACTERISTICS of a trade-mark, 143.
ESTIMATING DAMAGES. (See Chapter XI.)
ESTOPPEL by reason of previous declarations, 627, 631.
"ETHIOPIAN" trade-mark case, 612.
EVIDENCE,
of false use of unessential elements may be important, 33, 132.
fraudulent intent deduced from slight circumstances, 268, 387 *et seq.*
sources of, before the Patent Office, 645.
certificate of registration to be, 330.
registry, *prima facie*, of title, 337 *et seq.*
EXAGGERATED STATEMENTS, in advertisements, not conclusive evidence of fraud, 492.
EXAMINATION of application for registration of mark. (See Chapter XIII.)
EXAMINER OF TRADE-MARKS, judicial functions of, 574.
EXAMPLES OF TRADE-MARKS, (see Chapter V.)
autograph may be a valid mark, 204.
or fac-simile of signature, 207, 211.
pseudonyms may be valid marks, 213, 214, 217, 218.
fancy names of men, 216.
names of products, 236 *et seq.*
words, 33, 273-275.
letters of the alphabet, 234 *et seq.*
devices, including name, 246-248.
from heraldry, 260.
in which color is essential, 263-270.
monograms, ciphers, etc., 262.
necessary name of one's exclusive product, 251.
picture of public building, 258.
national arms combined with other things, 261.

[REFERENCES ARE TO SECTIONS.]

EXCLUSIVE USE of symbol the foundation of title, 143, 309, 324.
cannot be claimed of a mere geographical name, 182–185.
of designations of trades or occupations, 161.
of necessary name of thing, 164.
of one's surname, 202, 423.
EXTINGUISHMENT of trade-mark. (See ABANDONMENT.)
"EXTRACT OF NIGHT-BLOOMING CEREUS," a deception, 484.

F.

FABRIKZEICHEN, the German equivalent of "trade-mark," 85.
FAC-SIMILES, ten to be filed except in case of drawings, 304.
must be attested by oath of applicant, 283.
of autographs are valid trade-marks, 87, 207.
definition of term "fac-simile," 304.
FALSEHOOD, in mark cuts off right to protection. (See CLEAN HANDS.)
FALSE models of application papers, 592–594.
FAMILY NAMES, considered, 196, 197.
FANCY NAMES, judicially approved. (See 33, 547 *et seq.*)
"AINSWORTH," thread, 199; "Alderney," oleomargarine, 71; "American Sterling," silver, 352; "Anatolia," licorice, 66, 191; "Annihilator," medicine, 273; "Apollinaris Water," mineral water, 191; "Arctic," soda-apparatus, 273.
"BELL OF MOSCOW," wine, 89; "Benedictine (La)," liqueur, 137; "Bethesda," mineral water, 191; "Bismarck," cement, paper collars, 68; "Blood Searcher," medicine, 135; "Bockar's Stomach Bitters," medicine, 135; "Bouquet," hams, 449, 661; "Brown Dick," tobacco, 218.
"CAFÉ DES GOURMETS," coffee, 236; "Carte Blanche," champagne wine, 438; "Cashmere Bouquet," toilet soap, 273; "Centennial," clothing, alcoholic spirits, 68, 340, 613, 638; "Champion," flour, 150; "Charbon Agglomerée," charcoal, 221; "Charter Oak," cooking-stoves, 148; "Chartreuse," liqueur, 408, 582; "Chinese," liniment, 243, 538; "Climax," stoves, 150; "Cocoaine," cocoanut oil, 150, 237, 397, 450; "Congress Water," natural product, 146; "Crème d'Argent," a chemical product, 236; "Crystal," castor-oil, 274.
"DAMASCUS BLADE," scythes, 249; "Daniel," bridle bits, etc., 326; "Daylight," oil, 274; "Deer Tongue," tobacco, 273; "Diamond," soap, 273; "Dolly Varden," fancy paper, 218; "Dublin," soap, 191; "Durham," smoking-tobacco, 658.
"EAU DE LA FLORIDE," toilet preparation, 397; "Eau de toilette de Lubin," toilet-water, 135; "Electro-Silicon," polishing compound, 71, 220; "Empire," stoves, 150; "Ethiopian," stockings, 150, 612; "Eureka," fertilizer, shirts, 68, 219; "Everlasting," pills, 273; "Excelsior," stoves, 150.
"FALSTAFF," cigars, 218.

[REFERENCES ARE TO SECTIONS.]

FANCY NAMES, judicially approved, — *continued.*
"GASLIGHT," illuminating oil, 274; "German," soap, 191; "Glenfield," starch, 136; "Gold Dust," whiskey, 273; "Grande Chartreuse," liqueur, 407; "Gulliver," cigars, 218.
"HARVEST VICTOR," harvesting-machine, 275; "Heliotype," prints, 66; "Hoosier," agricultural implement, 191; "Hunyadi-Janos," mineral water, 191.
"IRON-CLAD," boots, 66; "I X L," cutlery, axes, scythes, 69, 70.
"JOB," cigarette paper, 212, 398.
"KING OF THE FIELD," agricultural implements, 275.
"LA BENEDICTINE," liqueur, 137; "La Cronica," newspaper, 108; "La Flor del Tropico," cigars, 273; "Lamartine," an elixir, 216; "La Normandi," cigars, 672; "Leopold," woollen cloths, 191; "Liverpool," woollen cloths, 191; "Lone Jack," smoking-tobacco, 66, 218; "Lubin," toilet perfumes, 135.
"MAGNETIC BALM," medicine, 71; "Magnolia," gin, whiskey, 68, 672; "Marieland," whiskey, 193; "Medicated Mexican Balm," 243; "Meloroma," beverage, 273; "Mineral Sperm," illuminating oil, 273; "Moniteur," newspaper, 415; "Monticello," whiskey, 193; "Mount Carmel," liqueur, 184, 191.
"NEW ERA," newspaper, 105.
"OUR FRITZ," smoking-tobacco, 218.
"PAIN KILLER," medicine, 273; "Papier Goudron," cigarette paper, 71, 135; "Papier hygienique," cigarette paper, 135; "Paragon," umbrellas, 219; "Paul Jones," whiskey, 218, 664; "Perles d'Ether," ether pills, 166, 236, 383; "Phil Sheridan," tobacco, 218; "Poudre Brésilienne," toilet article, 236.
"QUEEN OF THE MEADOW," agricultural implement, 275.
"RED RACER," agricultural implement, 275; "Rip Van Winkle," whiskey, 218, 613; "Roger Williams," cotton cloth, 216; "Royal Bats-wing," corsets, 273.
"SAMSON BRACE," suspenders, 273; "Savon de Paris," soap, 135; "Serpent of Pharaoh," chemical toy, 166; "Siccatif brillant," paint dryer, 135; "Star of the West," pump, 274, agricultural implement, 275; "Star Shirt," shirts, 606; "St. James," cigarettes, 68; "Sunlight," illuminating oil, 273; "Sunny South," stoves, 273.
"TIP TOP," agricultural implement, 275; "Trappestine," liqueur, 236.
"UNCLE BOB LEE," tobacco, 218.
"VALLEY GEM," piano-fortes, 273; "Veloutine," toilet-powder, 135; "Vieille Montagne," paints, 193.
"WATER WHITE," refined petroleum, 274; "Western Dutchman," agricultural implement, 275; "Wisconsin Wood-Chopper," axes, 193.
"YANKEE," shaving-soap, 125, 136, 191; "Young America," writing ink, 218.
"Zero," water-cooler, 273.

[REFERENCES ARE TO SECTIONS.]

FANCY NAMES, judicially rejected, for being descriptive, deceptive, or other cause.

"ALBANY BEEF," (slang term for sturgeon,) 89 *a*; "Allcock's Porous Plasters," 134; "American Sardines," 134, 352, 610; "Anglo-Portugo," (oysters,) 71; "Angostura," (bitters,) 134, 194; "Antiquarian Book Store," 161; "A. Richardson's Patent Union Leather Splitting Machine," 221, 611.

"BALM OF THOUSAND FLOWERS," 242, 488; "Beeswax Oil," 164, 276; "Bloom of Youth, or Liquid Pearl," 71, 475; "Braided Fixed Stars," 221.

"CABLE-STITCHED KID GLOVES," 133; "Cable Twist Tobacco," 167; "Cachemere Milano" (etc.), 134; "Calendar Watch," 276; "Charbon de Paris," 220; "Charter Oak," 221; "Chlorodine," 134, 220, 252; "Club-House Gin," 134; "Cough Remedy," 134; "Crack-Proof," 134, 597; "Croup Tincture," 134; "Crystalline," 89 *a*; "Cundurango Ointment, C. O.," 104; "Cylinder," 157.

"DESICCATED CODFISH," 134; "Durham," 134, 659.

"EGG MACARONI," 134.

"FAILLANTINE," 601; "Ferro-phosphorated Elixir of Calisaya Bark," 220; "French," (paints,) 192.

"GALEN," 157; "Geyser Spring," 276; "Glendon," (iron,) 134, 192; "Golden Ointment," 134; "Gold Medal," 133.

"HAMBURGER TROPFEN," 609; "Highly Concentrated Compound Fluid Extract of Buchu," 134; "Homœopathic Medicines," 89 *a*; "Howqua's Mixture," 478.

"INVISIBLE," 164; "Iron Stone," 597.

"JOHNSON'S AMERICAN ANODYNE LINIMENT," 133, 367.

"KATHAIRON," 491.

"LACKAWANNA COAL," 134; "Lake," 157; "La Maison de l'Aluminium," 535; "Lawrence Fine Family Flannel," 134.

"LIEBIG'S EXTRACT OF MEAT," 134; "Lieutenant James' Horse Blister," 134; "Linoleum," 220, 221; "Loch Katrine Whiskey," 192; "Lucilene," 220, 252; "Lunch Milk Biscuits," 276.

"MACASSAR OIL," 134; "Masonic," 89 *a*; "Meen Fun," 485; "Moline," 134, 597; "Musical Note Paper," 133.

"NEW MANNY HARVESTER," 134; "New York," 157; "Night-Blooming Cereus," 71, 134, 484; "Nourishing Stout," 134, 597.

"OLD LONDON DOCK GIN," 134, 597.

"PARAFFIN OIL," 134; "Parchment Deed," 276; "Parson's Purgative Pills, P. P. P.," 134, 367; "Post-Office Directory," 134; "Prize Medal," 133; "Propriétaires de Vignobles," 599.

"RALEIGH," 192; "Razor Steel," 134; "Rye and Rock," 134.

"SCHIEDAM SCHNAPPS," 134, 137, 596; "Singer," 220 *a*; "Sliced Animals," 134; "Snowflake," 136, 174; "Straight-cut," 134; "Swing," 89 *a*.

[REFERENCES ARE TO SECTIONS.]

FANCY NAMES, judicially rejected, — *continued.*
"TASTELESS," 134; "Trommer," 220 *b*; "True-fit Shirts," 133; "Tucker Spring Bed," 221.
"VIENNA," 191; "Vineyard Proprietors," 599.
"WATER OF AYR STONE," 532; "Wayne," 157; "Wistar's Balsam of Wild Cherry," 491; "Wolfe's Aromatic Schiedam Schnapps," 475; "Worcestershire," 136, "Woven Wire Mattress," 277.
FEDERAL TRADE-MARK LEGISLATION, (see Chaps. VI., VII.)
misconception as to power of Congress in, 278.
act of registration of 1870 discussed, 280.
Congress has authority to legislate on trade-marks, 281, 282.
FEE, payable on application for registration, 283.
is not a pledge or deposit, but an unconditional payment, 307.
cannot be reclaimed, unless paid by mistake, 307, 615, 616.
credit for fee, or part of fee, heretofore paid, 334.
FEES of witnesses in interference cases, 639.
"FERRO-PHOSPHORATED ELIXIR OF CALISAYA BARK,"
as a new name, held not to be a valid trade-mark, 220.
FICTITIOUS NAME of manufacturer, innocent use of, 494.
FIRM, may register a trade-mark, 283, 316.
definition of the term "firm," 316.
FIRM NAME on signs protected in equity. (See Chapter XII.)
by whom used, on dissolution, 524–527.
FOREIGN COMMERCE, law of March 3, 1881, 283, 285, 360.
FOREIGN COUNTRY, resident of,
upon what conditions allowed to register here, 283, 285.
deemed a citizen of that country commercially, 287, 297.
before whom to verify application, 312.
FORENSIC DOMICILE, 294.
FORGERY at common law defined, (see Chapter IX.)
or counterfeiting of labels, etc., punished by local laws, 452.
of will, detected by means of water-mark, 7.
FORM, or peculiar disposition of letters, a valid personal sign, 87, 165.
of natural object, given by chemical means, 166.
is implied in the use of the term "mark," 269.
of a product cannot be a trade-mark, 89 *b*.
FOUNDATION of title to trade-mark, discussed generally, 45–57.
rests upon mere adoption and use, 46.
does not depend on statutory law, 47–51.
is in immutable law of nature, 1 *et seq.*, 86.
FRANCE, trade-marks optional in, as a rule, 18.
trade-mark law of, Appendix, p. 686.
convention between the United States and, Appendix, p. 675.
FRAUD, committed in the use of one's own true name, 200, 388–390.
of the word "patent," 72, 340.
in assigning use of one's name, 363.

[REFERENCES ARE TO SECTIONS.]

FRAUD, — *continued.*
committed in perversion of mark, 443–447.
not fraud for stranger to place genuine mark on genuine goods, 448.
to use another's symbol for different class, 450.
question of, judged of as between immediate parties, 38.
FRAUDULENT representations in Patent Office, action for, 355, 356.
intent precludes registration, 348 *et seq.*, 592, 607, 612.
FRENCH definition of term "trade-mark," 85.

G.

"GAUNTLETT PIPES," marks upon, 17.
"GAZETTE NATIONALE," or "Moniteur Universel," case, 415.
GENERAL TYPE of objects cannot be exclusively appropriated, 89 *d.*
GENERIC TERMS,
cannot be trade-marks, 89 *a*, 134, 164, 167–177, 253.
men's names may become, 178, 181, 203.
fancy names of things may become, 252.
examples of rejected cases, 276, 277, 367, 368, 596 *et seq.*
GEOGRAPHICAL NAME, when not merely such, may be valid trade-mark, 182, 184, 185, 191, 193.
when is a name merely such? 192.
GERMAN definition of term "trade-mark," 85.
GERMAN EMPIRE, registration law, Appendix, p. 688.
Convention between the United States and, Appendix, p. 676.
"GEYSER SPRING," not a trade-mark, 276, 598.
"GOLDEN CROWN CIGARS" case (*Palmer* v. *Harris*), 481, 483.
GOLDSMITHS' company mark, 18, 19.
hall mark, 19.
"GOLSH'S FRICTION MATCH" case (*Partridge* v. *Menck*), 35, 256, 489.
GOODS "to be transported," phrase discussed, 360.
GOOD-WILL, difficulty in defining accurately, 522.
may be sold, bequeathed, or become assets of an estate, 522.
sale of business is sale of, 522.
not applicable to professional business, 522.
not necessary to name in sale of business, 522.
on dissolution of partnership, 524.
name of firm important part of, 524–526.
when understood to be conveyed, 524.
as implied in the use of signs of houses, 525 *et seq.*
equity will protect name of inn, hotel, or other place of business, 528.
colorable imitation of name will be enjoined, 528 *et seq.*
false representations on signs, 531.
comprises attack on trade-mark, trade-name, etc. of rival, 536.

[REFERENCES ARE TO SECTIONS.]

GOOD-WILL, — *continued.*
labels, wrappers, and advertisements comprised in, 537, 538.
improper use of word "original" prohibited, 542, 543.
trade secrets protected, 545.
may be sold, 545.
GOVERNMENT FEE for registration, 307.
credit for fee, or part of fee, heretofore paid, 307.
"GRAND HÔTEL DE LA PAIX," case of unfair competition, 529.
"GRANDE CHARTREUSE," trade-mark cases, 407–410, 582.
GREAT BRITAIN, declaration between the United States and, Appendix, p. 676.
registration-law of 1883, Appendix, p. 691.
"GREAT LIGHT(E)NING INK ERASER" case, 600.
GREEKS, ancient, sign-boards of, 6.
had cattle for currency, 9.
GREEN BUSH, as vintner's sign, 6.
GREEN SEAL for bottles, held to be a valid trade-mark, 170.
GUILDS, in olden times maintained high character of goods, 74.
GUTENBERG, mark of himself and associates, 14.

H.

HAGGAI, seal of, found in exploration of Jerusalem, 8.
"HALL MARKS," on gold and silver products, 18, 19.
"HALL'S VEGETABLE SICILIAN HAIR RENEWER" case, 425.
HAMILTON, Sir William, cited as to definition, etc., 82.
"HARDWARE," too indefinite to describe a class of goods, 300.
HAREBOTTLE, a hare and a bottle as his rebus, 6.
HARMLESS UNTRUTH not regarded as fraudulent, 71.
"HARVESTERS," a class of agricultural machines, 601.
HAYTIAN COIN, counterfeited, 76.
HENNESSY, JAMES, name used fifty-five years in commerce, rejected, 134.
HERALDRY, a science with system, classification, language, 5.
trade-marks frequently borrowed from mediæval, 260.
caution to be observed in copying devices, 260.
colors of English, — blue, red, black, green, purple, 263.
HERCULANEUM, emblematic signs in, 6.
HEREDITARY DIGNITIES, seal importing, 5.
"HEROINE" trade-mark infringement case, 612.
HINDOOS, 1200 or 1300 years B. C., had merchandise marks, 11.
HISTORY of proprietary marks. (See Chapter I.)
"HOLLOWAY'S OINTMENT" case, similarity of names, 430.
HOMER mentions brass money as existing twelve centuries B. C., 9.
HOTEL, name of, not a trade-mark, 83, 90–92, 95–97.
protected in equity court, 528, 529.
"HÔTEL DE LA PAIX" case, unfair competition by signs, 529.

[REFERENCES ARE TO SECTIONS.]

"HOWE'S BAKERY," good-will case, sign of business, 98 *et seq.*, 525.
"HOWQUA'S MIXTURE" case, 480.
"HUDSON G. WOLFE'S BELL SCHNAPPS" case, 596.

I.

IDEM SONANS, 392, 527, 600, 661.
IGNORANT MISUSE of word "patent" not penal, 72, 340.
ILLOGICAL USE of term "trade-mark patent," 340.
IMITATION in part, may be a colorable infringement, 33, 58, 388.
IMPOSITION on public, not ground for private action, 36, 37.
incidentally considered by court, 30, 43.
cause for refusing registration, 348 *et seq.*
INCORPORATED COMPANY may register trade-mark, 317–320.
INCREASED IMPORTANCE of trade-marks, 28.
INDEFINITENESS of allegation may defeat application, 303, 583 *et seq.*
INDIAN TRIBE, commerce with, 283, 285.
whether member of, can register, 285, 289.
INDICATION of origin or ownership, (see Chapter IV.)
is the office of trade-mark, 144 *et seq.*
of mere trade or occupation not a trade-mark, 161.
INDICTMENT for simulating marks. (See Chapter IX.)
INDIVIDUALITY an essential characteristic of trade-mark, 143.
INFRINGEMENT, (see Chapter VIII.)
frequently difficult to determine, 33.
exact similitude not essential to, 33, 228, 385.
actual physical resemblance not the only question, 385.
criterion of, the probability of deceiving purchasers, 43, 300, 328.
sufficient if ordinary purchasers are misled, 33.
principle on which prohibited, 34, 395.
wherein consists the wrong of, 42.
comparative quality of goods not necessary question, 35, 344, 401, 496, 505.
by what is it constituted, 385, 440.
fraudulent intent not essential to, 386.
by deceiving eye or ear, 449.
by colorable variations, 33, 388.
by using small words as instruments of fraud, 387.
by affixing mark to receptacle of unmarked goods, 440.
by misuse of genuine labels, 443-446.
genuine bottles, bags, etc., 443.
genuine parts of manufactures, 443.
minor details, 33, 388–391.
numerals, 226-230, 401, 446.
sometimes to use mark originated by one's self, 437.
in causing another to imitate mark, 441.
in making false labels to be affixed in foreign country, 400.

[REFERENCES ARE TO SECTIONS.]

INFRINGEMENT, — *continued.*
but mere imitation of abstract symbol is not, 42.
discovery by analysis of unpatented secret is not, 562, 563.
nor using symbol on another class of goods, 66–70, 300, 450, 590.
INFRINGER, who is, 58.
may be the pirate himself, or innocent vendor, 58, 468.
agent, 472.
INITIAL LETTERS may by accident become valid mark, 212, 398.
not sufficient for legal signature, 290.
INJUNCTION, (see REMEDIES, Chapter IX.)
against use of another's name, 527, 531, 539–541, 554, 556.
an old firm title, 525–527.
title of publication, 546–553, 557.
name of place of amusement, business, etc., 528.
INJURIA SINE DAMNO, 499.
"INJURIOUS in itself," meaning of phrase in statute, 350.
INNOCENT VENDOR may be an infringer, 58.
not compelled to account, or pay costs, 471.
INSTANT PERFECTION of title to trade-mark, 52, 54.
INTENT, express or implied, an element in fixing damages, 508, 520.
INTENTION to adopt is not adoption, without use, 52–54, 384, 661.
INTERFERENCE, subject generally considered. (See Chapter XIV.)
when may be declared, 325, 622.
demands skilful management, 617–619.
practice in, modelled on equity practice, 617, 618.
defined to be an interlocutory proceeding, 621.
preliminary, first declared, 625.
object of, 626.
declaration and dissolution of, 633.
judgment based on written concession of priority, 634.
grounds of, 325, 638.
access to testimony, 640.
printed copy of testimony, when required, 641.
postponement of taking testimony, or of hearing, 642.
information of opponent's case, 644.
sources of evidence, 645, 646.
hearing, rule as to, 648.
appeal from Examiner, 649, 658, 659.
decision of Commissioner final, 650, 651.
examples of actual trials and opinions, 653 *et seq.*
INTERNATIONAL CONFERENCE for protection of industrial property, 22.
list of the nations taking part therein, 22, note.
INVARIABILITY is an essential attribute of a trade-mark, 143.
INVENTOR alone has right to apply word "original" to product, 542, 543.
IRREGULARITY in making oath, etc., fatal to protection, 313, 580.

[REFERENCES ARE TO SECTIONS.]

"IRVING HOUSE" case (see *Howard* v. *Henriques*), 95, 96.
ITALY, declaration between the United States and, Appendix, p. 676.
registration law of, Appendix, p. 697.
"I X L," instance of same symbol for different owners, 69, 70, 450.

J.

JACOB'S CATTLE distinguished by their marks, 3.
JAPAN, EMPIRE OF, registration law of 1883, Appendix, p. 697.
JAPANESE MARKS pirated in England, 74.
"JOB," originally formed of initials J. B. and lozenge, 398.
JODOCUS BADIUS, caution against pirate of book-mark, 14.
"JOHNSON'S AMERICAN ANODYNE LINIMENT" rejected, 133, 367.
JUDGMENT BY DEFAULT,
when defendant in action fails to make discovery, 470.
in interference case, 630.
based upon concession of priority, 634.
of commissioner in interference is final, 650, 651.
JUDICIAL OFFICERS,
sometimes confound technical terms, 43, 90 *et seq.*, 98, 108, 222.
disagreements of, in conclusions, 65, 140, 244.
JURAT, valid although not dated, 314.
"JUSTINUS ET FLORUS," of Bernard Hector, caution in, against piracy of trade-mark for book, 14.

K.

"K" within two concentric circles, decision examined, 149.
"KATHAIRON" case (*Heath* v. *Wright*), 491.
KNIGHTS TEMPLARS' renowned banner *Beauseant*, 263.

L.

LABELS,
not technical trade-marks, but mere vehicles for them, 83, 133, 155.
mere analogues of trade-mark, 81, 537.
and wrappers, connecting link between good-will and trade-mark property, 537.
made instruments of fraud, 538, 541–544.
cannot be copyrighted, 109.
LACHES, what not deemed, as when one is seeking evidence, 498.
bad faith in plaintiff to lie by for a long time, 497.
as applied to question of abandonment, 684, 685.
"LA CIVETTE" sign-infringement case, 534.
"LACKAWANNA COAL" case (*Canal Co.* v. *Clark*), 144, 189, 598.

[REFERENCES ARE TO SECTIONS.]

LACK OF TRUTH, debars from protection, 71. (See CLEAN HANDS.)
but that is where fraud is a predicate, 71.
intention to deceive not always inferred from untrue statements, 475.
"LA CRONICA" newspaper case, 550.
"LA FLOR DEL TROPICO," a valid trade-mark for cigars, 273.
"LAMARTINE," valid as fanciful denomination, 216.
LANGUAGE of trade-marks easily read, 3.
of heraldry speaks forth in many trade-marks, 5.
"LA PRESSE" infringed by "La Presse libre," 416.
LATIN merchants, distinctive signs of trade, 6.
language, in Middle Ages, effect of, on men's names, 197, 213.
"LA VALENTINE CEMENT" not a valid mark, 190.
"LAWFUL TRADE-MARK," as used in Act of March 3, 1881, 367, 368.
LAWS OF VARIOUS COUNTRIES. (See Appendix.)
LEGAL DEPOSIT of marks simply declarative, not attributive, 48-51, 379, 380.
LEGISLATION, on subject of trade-marks in various nations, 26.
of the United States, 26. (See Chapters VI. and VII.)
"LES OISEAUX DE PROIE," a publication case, 552.
LETTERS, initial, as marks for painters, designers, sculptors, etc., 15, 234.
for fabrics of gold and silver in England, 19.
sometimes designations of products, 87.
LIBELS cannot be valid marks, 602.
LIMITATION OF PROTECTION, under Act of March 3, 1881,
generally is fixed at thirty years, 333.
when goods manufactured abroad, may expire at any time, 333.
"LIST OF HOUNDS" not exclusive property, 559.
LIVY OF ALDUS, of 1518, piracy of trade-mark, 14.
"LOCATION" of business of owner must be alleged, 283.
defined under law of March 3, 1881, 296.
"LONDON CONVEYANCE COMPANY," name on coach, 560.
"LONDON DISPENSARY" case, shop-sign, 529.
"LONE JACK," a valid trade-mark of fancy, 66, 218.
infringement case, 66.
LUTHER represented by symbol of a swan, 6.
LYDIANS, inventors of gold and silver coin, 9.

M.

"MACASSAR OIL" case, in France, 23.
"MAGNOLIA" a valid trade mark for alcoholic liquors, 68, 672.
MANDAMUS, proceedings to enforce Label, etc. Act, 381.
MANUFACTURER,
has right generally to place his name on his products, 420.
may use his name as instrument of fraud, 420 *a*, *et seq.*
of quack medicines not entitled to invoke aid of equity, 475.

[REFERENCES ARE TO SECTIONS.]

MANUFACTURER, — *continued.*
unlawfully engaged, or deceiving public, etc., refused protection, 348 *et seq.*
MANUFACTURING AND TRADING CORPORATIONS, the only kind of corporations that can have trade-marks, 317–320.
"MARIELAND" held not to be merely geographical, 193.
MARKS, generally. (See TRADE-MARK.)
upon animate property, 3, 16.
registration of swan-marks in England, 16.
seals, the most sacred proprietary marks, 4.
of sovereign upon coin, a guaranty of genuineness, 76.
of trade, etc., property under law of nations, 22.
assuming increased importance, 28.
may resemble each other and essentially differ, 33.
of workmen in quarries of Solomon's temple, 8.
on ancient bricks, tiles, pottery, 8, 13.
"MARK TWAIN," as a trade-mark, 548, note.
MARQUE DE FABRIQUE ET DE COMMERCE of France, Belgium, etc., means same as "trade-mark" in English, 85.
MASONIC SYMBOLS,
not calculated by their nature to serve as trade-marks, 367.
impossible to divest them of ordinary signification, 367.
liable to misinterpretation, and to deceive public, 367.
MAXIMS cited:
Boni judicis est ampliare jurisdictionem, 67.
Caveat emptor, 11, 64. Caveat venditor, 64.
Contra non valentem agere non currit prescriptio, 686.
Debitum et contractus sunt nullius loci, 22.
De minimis non curat lex, 499.
Ex turpi causa non oritur actio, 71.
Ex turpi contractu non oritur actio, 349.
In pari delicto, potior est conditio defendentis, 349.
Jus et fraus nunquam cohabitant, 685.
Lex non cogit ad impossibilia, 362.
Lex semper dabit remedium, 345.
Non nostrum tantas compouere, 491.
Noscitur a sociis, 132, 332.
Potior est conditio defendentis, 495.
Qui facit per alium, facit per se, 628.
Quod ab initio non valet in tractu temporis non convalescit, 225.
Sic utere tuo ut alienum non lædas, 420.
Ubi jus, ibi remedium, 345.
Vigilantibus, non dormientibus leges subveniunt, 64.
"MAYOLINE," (from Mayo, the owner,) a valid mark, 217.
MEANING OF PHRASES AND TERMS,
"lawful trade-mark," 367, 368.
"merely the name of the applicant," 325, 326.
"origin or ownership," indication of, 144 *et seq.*

[REFERENCES ARE TO SECTIONS.]

MEANING OF PHRASES AND TERMS, — *continued.*
publici juris, 676.
registrant, 325, note.
" unfair competition in business," 43.
" word-symbol," 89 *a*.
MEASURE OF DAMAGES FOR INFRINGEMENT, (see Chap. XI.)
nominal damages, at least, always given, 501 *et seq.*
"MEDICATED MEXICAN BALM" case (*Perry* v. *Truefitt*), 243, 479.
"MEEN FUN" case (*Hobbs* v. *Français*), 485.
MELANCHTHON, change of surname into Greek, 213.
MERCHANDISE,
definition of term as used in Registration Acts, 139–142, 300.
books protected by trade-mark merely as, 116, 117.
natural products protected as such, 147.
symbol not a trade-mark unless affixed to, 143.
class must be specified, 300.
MICHAEL ANGELO signed paintings by monogram, 262.
"MINERAL SPERM" as fancy name for illuminating-oil, 273.
"MINNIE, DEAR MINNIE" case, name of song, 55.
MISCONCEPTION as to nature of arbitrary symbolism, 138.
as to power of Congress, 278 *et seq.*
MISREPRESENTATIONS. (See CLEAN HANDS; PROTECTION.)
MODE of affixing mark to be stated in application, 305.
MODELS of vicious application papers, 592–594.
"MOLINE PLOUGH" case, qualifying marks, 597.
MONEY paid as fee, when returnable, 615, 616.
"MONITEUR" of Paris, newspaper infringement, 415.
MONKS OF BORDEAUX marked wine as mineral water, 77.
MONKS OF LA GRANDE CHARTREUSE, suits for infringements of their trade-marks, 407–410, 582.
MONOGRAMS, used as marks for many centuries, 15, 262.
Dictionnaire des Monogrammes, Marques, etc., 15.
"MONTICELLO" not merely a geographical name, 193.
MORALITY must be inviolate in mark, 64, 348 *et seq.*, 602.
"MORISON'S UNIVERSAL MEDICINE" case, 429, 562.
"MORSE'S INDIAN ROOT PILLS," 563.
"MOUNT CARMEL" held not to be merely geographical, 184.
"MRS. MARPLE'S SALVE" case, 246.
"MUSICAL NOTE PAPER" not a trade-mark, 133.

N.

NAME, what is a, 196.
of person, firm, etc., not a trade-mark, 195, 202.
of fancy, of famous living or dead person, 216, 426.
a country may be a valid trade-mark, 184, 193.
product solely made or sold by inventor of name, 251.

[REFERENCES ARE TO SECTIONS.]

NAME, — *continued.*
of fancy, of books, 116, 547–549, 553.
a song, "Minnie," 557.
to be a valid mark must not be generic. (See Chapter III.)
of a man may lose all personality, 178, 181, 220 *a*, 496.
cannot be assigned as a mark for another, 57, 420 *a*, 435.
sometimes illegal for himself, in trade, 420, 420 *a*.
frequently changed in Middle Ages, 213.
of applicants to be written in full, 290.
may generally be attached to goods, *bona fide*, 420 *a*, 421, 427.
fraud may be inferred from usurping another's, 396.
one's name sometimes usurped without redress, 393, 556.
of old commercial house protected, 524 *et seq.* (See Chapter XII.)
of a trader or firm protected, 524 *et seq.*
of firm, on dissolution of partnership, 524 *et seq.*
of coach, or other conveyance, 560 *et seq.*
but if necessary cannot be protected, 166, 220.
of a machine or product, patent expired, 221.
NATIONAL bonds and bills, colored threads in paper, 7, 74.
arms, not susceptible of private use as marks, 261.
flags blended with other objects to catch eye, 265.
comity regarded by the courts, 287, 288.
NATIONALITY, commercial, may differ from political, 297.
"NATIONAL POLICE GAZETTE" case (*Matsell* v. *Flanagan*), 550.
NATURAL LAW, foundation of trade-mark rights, 1, 46–51.
NEGLIGENCE. (See LACHES.)
NEOLOGISM, coiner of, may have title thereto, 219 *et seq.*
NETHERLANDS, THE, trade-mark law of, Appendix, p. 700.
"NEW ERA" *omnium gatherum* case, 590.
NEWSPAPER NAME, as trade-mark, discussed, 103–115, 415–417.
"NIGHT-BLOOMING CEREUS," not a valid mark, 484.
NINEVEH, ancient, bricks with marks, 8.
NOMS DE PLUME, 213.
NONDESCRIPT picture, vignette, etc., not valid marks, 89.
NON-RESIDENT CITIZEN regarded as a foreigner, 294.
NORWAY, trade-mark law of, Appendix, p. 701.
NOTARY PUBLIC, may administer oath to applicant, 312.
must in all cases affix official seal, 312.
certificate of, to affidavit, how made, 314.
NUMERALS, merely, not legal trade-marks, 225–233.
use of, as an element, 442.

O.

OATH, or its equivalent, required of applicant for registration, 309 *et seq.*
design of, is confidence, 580.
perverted by applicant or solicitor, 580.

[REFERENCES ARE TO SECTIONS.]

OFFENCES, against morality or good faith, defeat remedy, 348 *et seq.*
against public policy in any wise, 349.
in fraudulently procuring registration, 353.
affixing "patent" or equivalent term, 72.
OFFICER OF CORPORATION, to make oath, 309.
mere director is not such officer, 323.
"OLD LONDON DOCK GIN" not a valid mark, 597.
"OLD MOORE FAMILY PICTORIAL ALMANAC" case, 257, 549.
OPINIONS, contrariety of, 136, 658–660.
"ORIGINAL," or equivalent term, may be enjoined, 542 *et seq.*
proprietor takes precedence independent of registration, 47, 50, 357.
ORIGIN OR OWNERSHIP, indication of, (see Chapter IV.)
a phrase not always understood, 2, 144, 145.
what may be deemed such indication, 145, 147.
particular maker need not be indicated, 144.
simple name of article may be, 146–148, 150–152.
essential characteristic of trade-mark, 143.
name originally geographical may suffice, 184 *et seq.*, 191, 193.
"OU, the old man who lives in solitude," old Chinese mark, 215.
"OWNER" of trade-mark may register, 283.
definition of term, 284, 565, note.
OWNERS, there may be many of a mark, 604.

P.

"PAIN KILLER" (Perry Davis') case, 273, 563.
"PAPIER CRÈME DE RIZ," held to be valid mark, 224.
PARTNERSHIP, (see Chapter XII.)
title to trade-marks on dissolution of, 57.
"PATENT," or "patented," untrue use of term, 72.
may sometimes be used when patent expired, 72, 73.
penalty of misuse of, 340, note.
cannot be applied to trade-mark, 340.
PATENT CASES,
do not furnish rule for trade-mark cases, 513–515, 676, 679.
PATENT OFFICE OF THE UNITED STATES,
place of deposit of foreign marks, 332, note.
registration, under Act of March 3, 1881, 283.
does not grant a "patent" for trade-mark, 340.
"PAUL JONES" may be a valid trade-mark, 218, 664.
"PAYSON'S INDELIBLE INK" case, curious, 271.
"PEARLS OF ETHER," a valid fanciful mark, 166, 236.
PECULIARITY OF PACKAGE not *per se* a trade-mark, 137.
PENAL STATUTES OF STATES, 451.
PENALTIES, for infringement of mark, Act of 1876, 58, note, 370, 371.
Act of March, 1881, 337 *et seq.*, 355 *et seq.*
for fraudulent representations, or registry, 355 *et seq.*

[REFERENCES ARE TO SECTIONS.]

PENALTIES, — *continued*.
by indictment at common or local law, 451 *et seq.*
under treaties and conventions. (See Appendix.)
laws of various countries. (See Appendix.)
PERSONALITY, a man's name may lose all. (See NAME.)
PERVERSION of mark by transference to spurious goods, 443–447.
misapplication may turn genuine to counterfeit, 443.
by adulterating goods, 443.
by filling casks, etc. with inferior articles, 443.
by uniting false to genuine parts, 443–447.
"PESSENDEDE" was *not* decided to be a trade-mark, 222 *et seq.*
"PETIT JOURNAL" newspaper case, 417.
"PHARAOH'S SERPENTS" case, 166, note.
"PHARMACIE DE L'AMBASSADE D'ANGLETERRE," sign, 529.
PHRASES explained. (See MEANING OF PHRASES AND TERMS.)
"PICTORIAL ALMANAC" case, 257.
PICTURE, as a trade-mark, 255–259.
PIRACY ON TRADE-MARKS, (see INFRINGEMENT; REMEDIES.)
may be committed by part-imitation, 33, 385 *et seq.*
is sometimes a trade, 5.
"POLICE GAZETTE" case, 550.
POMPEII, ancient, commercial signs in, 6.
PRACTICE IN THE PATENT OFFICE, (see Chapter XIII.)
interference cases exemplified, 652–671.
PRELIMINARY INTERFERENCE,
detailed sworn statement required, 625.
PRELIMINARY STATEMENT serves as a pleading, 627.
when open to inspection of adversary, 629.
adjudication upon preliminary statement, 630.
not evidence for party filing it, 631.
PRIMA FACIE right to mark by registry, 338, 339.
right of applicant, 581.
PRINTED COPIES of testimony, 641.
PRINTED PUBLICATIONS,
books protected by trade-marks, 14, 15.
as merchandise, not literature, 116.
by titles as trade-marks, 546 *et seq.*
newspaper headings may be valid trade-marks, 103–115, 558.
infringed by part-imitation, 415 *et seq.*
name of song may be protected, 557.
PRINTS OR LABELS, Act of June, 1874, discussed, 381.
no claim of Act to constitutionality, 381.
meaning of words "prints," "labels," etc., 382.
proceedings on mandamus under said Act, 381.
PRIORITY OF ADOPTION,
as ground of title, 45 *et seq.*, 301, 324, 361–364.
concession of, on interference, 634.

[REFERENCES ARE TO SECTIONS.]

PROCURING REGISTRY of mark by fraud, penalty for, 355.
PROPERTY IN A TRADE-MARK. (See TRADE-MARK.)
PROPRIETARY MARKS, (see EMBLEMS; MARKS; TRADE-MARKS.)
not to be confounded with technical trade-marks, 16, note.
PROTECTION OF TRADE-MARK PROPERTY, (see Chapter II.)
right to, 20, 60, 62, 63.
growth of law of, 20.
foreigners have the same right to, as citizens, 21.
general widening of moral sense, 22–24.
grounds of, 30, 36, 74, 392, 393.
mere imposition on public does not entitle to, 30, 31.
is ground for consideration, 30.
harmless untruth does not defeat right to, 71.

Q.

QUACK MEDICINES discountenanced, 475 *et seq.*
QUALITY, mere indication of, not a trade-mark, 29.
of spurious goods not necessarily an element in suit, 35, 344, 401, 496, 505.
may properly be suggested in a trade-mark, 135.
QUARRY-MARKS in ruins of Solomon's Temple, 8.
QUASI TRADE-MARKS. (See Chapter XII.)

R.

"RACE OF DILIGENCE," not applicable to registration, 384, 661.
RAPHELENGIUS, bookseller at Leyden, trade-mark, 15.
"RAZOR STEEL" not a valid trade-mark for cutlery, 164.
"READING SAUCE" label case, 542, 543.
REBUSES as symbols of men, 5.
RECIPROCITY in protection of trade-marks, 287, 288.
REGISTRANT, definition of term, 325, note.
REGISTRATION, does not create title to a trade-mark, 48–51, 379, 380.
by whom and how obtained, 283.
why limited to marks used in foreign commerce, 285.
depends on lawful use, 325.
refused when mark calculated to deceive, 328.
prima facie evidence of ownership, 338, 339.
when renewable, 333.
is not the grant of a patent, 340.
of fraudulent marks, 348 *et seq.*
common-law rights are not impaired by, 357–359.
in Department of the Treasury for certain purposes, 369.
advantages of federal, 373.
effect of, 374.
a prerequisite to judicial redress in most countries, 131, note.

[REFERENCES ARE TO SECTIONS.]

REGISTRATION, — *continued.*
of prints or labels for articles of manufacture, 381.
in Europe has not a retroactive effect, 689.
of prints or labels, Act of June 18, 1874, 381.
REGULATIONS, Commissioner of Patents to prescribe, 308.
REISSUE, after surrender, 614.
REMEDIES, — LAW AND EQUITY, (see Chapter IX.)
may be threefold, 451.
at law, 452–461.
by criminal prosecution, 452–455.
action on the case for deceit, 457–461.
in equity, 462–468.
discovery, account, and costs, 469–472.
injured party has his election of, 506.
REMEDY, a figurative expression, 345.
at common law, 346.
denied in unlawful business, etc., 348–352.
"REVALENTA ARABICA," infringement on "Ervalenta-Warton," 439.
"REVERE HOUSE" coach case, 458.
"RICHARDSON'S PATENT LEATHER SPLITTING MACHINE,"
not a trade-mark, 611.
RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS, (see Chapter XII.)
several species of incorporeal property, 521.
"RIP VAN WINKLE" a valid trade-mark, 218, 613.
RODGERS' CUTLERY spuriously imitated, 74, 428, 684.
"ROGER WILLIAMS" a valid trade-mark of fancy, 216, 426.
ROMANS, ancient, signs and trade-emblems, 6.
coined money 578 years B. C., 9.
"ROSEBAUME," (from Rose, the owner,) a valid mark, 217.
ROUMANIA, trade-mark law of, Appendix, p. 701.
"ROYAL VICTORIA" a valid trade-mark, 216.
RUSSIAN EMPIRE, treaty between the United States and, Appendix, p. 677.
trade-mark law of, Appendix, p. 702.

S.

"SCHENCK WATER-PROOF TAGS," etc., not a valid mark, 133.
"SCHIEDAM SCHNAPPS" case, 596.
SEALS of ownership coeval with traffic, 2.
most sacred of proprietary marks, 4, 5.
SECRET PROCESS, breach of faith in divulging, 562 *et seq.*
SERBIA, treaty between the United States and, Appendix, p. 677.
"SERPENT" not a trade-mark for artificial serpent, 166.
"SERPENT OF PHARAOH" case, 166.

[REFERENCES ARE TO SECTIONS.]

SIGNATURE, as authenticating mark, 1 *et seq.*
a trade-mark is one's commercial signature, 130.
itself as a trade-mark, 204–206.
fac-simile of, as a trade-mark, 207–211.
SIGN-BOARDS, ancient, 6.
are not trade-marks, 96–101, 535.
are protected by courts of equity. (See Chapter XII.)
"SIMMONS' GENUINE LIVER MEDICINE" case, 418.
SINCERITY, an essential requisite of mark, 71, 143, 242, 348 *et seq.*
"SINGER," not a trade-mark for sewing-machines, 220 *a.*
SIR JAMES CLARK'S name usurped with impunity, 393, 555, 556.
SLANDER OF TRADE-MARK PROPERTY, 473.
by selling inferior goods bearing genuine mark, 473.
or using mark for false illustration, 473.
or by making false oral statements, 473.
SMECTYMNU-US, initials of five men's names, 118.
"SNOW-FLAKE STARCH," not valid because descriptive, 174.
SONG, name of, protected as *quasi* mark, 557.
SPAIN, convention between the United States and, Appendix, p. 678.
SPECIAL DAMAGES,
not recoverable unless pleaded. (See Chapter XI.)
SPECIFICATION OF APPLICANT FOR REGISTRATION,
considerable degree of accuracy required, 565 *et seq.*
must be written in the English language, 570.
essence of mark must be evolved on papers, 587, 588.
indefiniteness defeats protection, 583–591.
breadth of claim, how best attained, 586–589.
simplicity and breadth go together, 587.
too great breadth defeats object, 586–589.
degree of specificness required, 591 *et seq.*
difficulty in describing colors, 585.
rules of propriety in selecting emblems, 602.
allegations true in letter false in spirit, 607.
but *one* class of merchandise in certificate, 66–70, 300, 450, 590.
hypothetical cases analyzed, 592–594.
amendment, how made, 577 *et seq.*
requiring supplemental oath, 578.
"SPIEGELMACHERS," assumed name of early printers, 14.
the speculum their symbol, 14.
"STONEBRAKER'S MEDICINES," etc. case, 435 *et seq.*
STYLE, or peculiarity of package, not *per se* a trade-mark, 137.
SUGGESTION OF QUALITY, a valid trade-mark may contain, 135.
SURNAME, subject considered, 196, 213.
dispensed with, or changed at pleasure, 196.
translated into foreign tongue, 196, 197.
SURRENDER and reissue, 614.
SWAN-MARKS, 16.

[REFERENCES ARE TO SECTIONS.]

SWEDEN, trade-mark law of, Appendix, p. 703.
"SWEET OPOPANAX OF MEXICO" case, 493.
SWITZERLAND, registration law of, Appendix, p. 704.
law of, for marking gold and silver manufactures, 19.
SYMBOLS of ownership. (See MARKS; TRADE-MARK.)

T.

TECHNICAL MARK, (see TRADE-MARK.)
must be distinguished from its analogues, 80 *et seq.*, 130–133.
TERMS EXPLAINED. (See MEANING OF PHRASES AND TERMS.)
"THOMPSONIAN MEDICINE" case, 459.
TICKETS OR LABELS to be sold are *merchandise*, not *marks*, 141, 142.
TIMBER-MARKS, 16, note.
TRADE-MARK, optional in this and some European countries, 18.
old as commerce itself, 20.
must identify and distinguish article to which affixed, 29.
foundation of title to, 45–47, 384.
registration does not give title to, 48–51, 340, 376.
time required for perfection of title, 52, 129.
who may acquire, 53–57.
may be acquired by assignment, 57.
not to be confounded with analogues, 83, 90, 93–100, 521 *et seq.*
of what it may consist, 87, 398.
must be well defined and certain, 89, 127.
word-symbol as, 89 *a*, 219.
on books, 116–118.
on printed publications (titles of), 547, 558.
a picture may be a, 258, 259.
may be valid although suggestive of quality, 135, 249–251.
line of demarcation difficult to draw, 136.
mere form of vendible commodity not a, 89 *b*, 137.
style or peculiarity of package is not *per se* a, 137.
general type of objects cannot be a, 89 *d*, 254.
label, notice, or advertisement cannot be a, 133.
color cannot be a, 138, 269.
may be an essential element, 263–267, 603.
indication of quality not a, 156–160.
designation of trade or occupation cannot be a, 161.
necessary name of product cannot be a, 166–171, 220.
essential characteristics of, 143.
fac-simile of signature may be a, 172.
pseudonym may be a, 213–215.
fancy name of man may be a, 216–218.
product may be a, 236–244.
family crest or arms may be essential element of a, 260.
monogram and cipher may be a, 262.

[REFERENCES ARE TO SECTIONS.]

TRADE-MARK, — *continued.*
colored threads in woven goods may be a, 268, 603.
one's own name merely cannot be a, 326.
fac-similes must be furnished for registration, 304.
title not defeated by accidental prior use of emblem, 383.
no power in Congress to grant a, 568.
right of user exclusive in its nature, 324.
blended with other rights, 418.
with unfair competition, 43, 44, 418, 473.
TRADE-NAME, as contradistinguished from trade-mark, 91.
is properly allied to good-will, 91.
may be of men, of places, of vehicles, 91.
TRANSFER OF A TRADE-MARK, (see ASSIGNMENT.)
Commissioner of Patents to make regulations for, 361.
at common law, 361, 362.
as affected by law of domicile, 295.
TREATIES, CONVENTIONS, etc., on trade-marks, 283, 286, 288.
list of nations with whom we have, 283, note.
definition of terms, 286–288.
TRICKS OF TRADE, not always guarded against, 448.
TURKEY, trade-mark law of, Appendix, p. 705.

U.

UNFAIR COMPETITION IN BUSINESS, 43, 89 *c.*
principles of, discussed, 43, 44.
examples of, 137, 223, 224, 392–396, 521.
by truthful signs of ex-employees, 532.
by untruthful suggestions on signs, 529, 531.
by usurping name of rival's commerce, 533.
shop-sign, 534.
industrial product, 535.
UNITED STATES, trade-mark laws of, Appendix, p. 705.
UNTRUTH, (see CLEAN HANDS.)
in use of word "patented," or its equivalent, 72.
as to place of manufacture, 483, 487.
name of manufacturer, 489.
fictitious name of manufacturer may be innocent, 494 *et seq.*
harmless, is not deemed fraudulent, 71.
USE OF PROPRIETARY MARKS, (see TRADE-MARK.)
by ancients, 1–13.
lawful business essential to. (See ABSTRACT SYMBOL.)

V.

"VALLÉE D'AURE," a mere geographical name, 187.
"VEGETABLE SICILIAN HAIR RENEWER" case, 425.

[REFERENCES ARE TO SECTIONS.]

VENDIBLE COMMODITY, only object of trade-mark, 54, 66–70, 120, 130, 300 *et seq.*, 680.
VENETIAN PRINTERS' MARKS, 14, 15.
"VIBRATORS," a class of agricultural machines, 601.
VINTNERS' SYMBOL, a green bush, 6.

W.

WATER-MARK on paper detects forgery, 7.
WECHELENSES' marks on publications, 15.
WEDGWOOD'S reliance on trade-marks, 29.
family name, as mark, for centuries, 216.
"WHAT CHEER HOUSE" case, 92.
"WILLOW SPRING ICE" merely descriptive, 247.
"WINSLOW'S (MRS.) SOOTHING SYRUP" case, 201, 426.
"WISTAR'S BALSAM OF WILD CHERRY" case, 491.
"WORD-SYMBOL" as trade-mark, 89 *a*.
term defined, 89 *a*, note.
examples of, 33, 219.
WORDS AS TRADE-MARKS,
must be specific and distinctive in meaning, 29.
indicating character, kind, or quality, not appropriable, 29.
WOSTENHOLM & SON'S "I X L" case, 69, 70, 450.
WRAPPERS as *quasi* trade-marks, 537 *et seq.*
WRONG-DOER cannot qualify his own wrong, 518.
restraint of. (See REMEDIES.)
WRONGFUL INTENT, inquiry into, in fixing damages, 508.

X.

"X" formed of two fishes crossed, as mark for fish, 250.
"X," "XX," "XXX," mere indications of degree, not trade-marks, 162, 163, 597.
"xXx," registered for bottled lager beer, 597, note.

Y.

"YANKEE SOAP" case, 119–125.
"YELLOW MOSS CHEWING-TOBACCO," not descriptive, 173.
"YOUNG AMERICAN," a valid trade-mark for ink, 218.

Z.

"ZERO," a valid mark for water-coolers, 273.

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