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THE LAW

OF

TRADE-MARKS

INCLUDING

TRADE-NAMES

AND

UNFAIR COMPETITION

BY

AMASA C. PAUL

OF THE MINNEAPOLIS BAR.

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PREFACE.

The effort of the author has been to produce a practical work for the practitioner of trade-mark law. The state and federal decisions on the subject have been exhaustively collated. The trade-mark statutes of the several states compiled and brought down to date will be found in the appendix. No attention has been paid to the trade-mark laws of foreign countries.

The writer desires to acknowledge his obligation to Honorable Charles B. Elliott, Judge of the District Court of this District, for material assistance and many valuable suggestions.

AMASA C. PAUL.

Minneapolis, Minn., April 25, 1903.

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THE LAW OF TRADE-MARKS.

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§ 1. Definition of trade-mark.

A trade-mark is a sign, symbol, mark, figure, picture, device, numeral, letter, word, name, or combination of any or all of these, used by a manufacturer, producer, or vendor of a commercial article, and indicating primarily, either by its own meaning or by association, the origin, ownership, or place of manufacture, production, or sale of the article to which it is applied.[1] It is a notice indicating origin. It cannot exist—that is, be the subject of ownership—apart

[1] Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311-325; McLean v. Fleming (1877) 96 U. S. 245; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Menendez v. Holt (1888) 128 U. S. 514; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Hostetter v. Fries (1883) 17 Fed. 620; Atlantic Milling Co. v. Robinson (1884) 20 Fed. 217; Adams v. Heisel (1887) 31 Fed. 279; Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 603; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Derringer v. Plate (1865) 29 Cal. 292; Falkinburg v. Lucy (1868) 35 Cal. 52; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Filley v. Fassett (1869) 44 Mo. 168; Candee v. Deere (1870) 54 Ill. 439; Congress & Empire Spring Co. v. High Rock Congress Spring Co., (1871) 10 Abb. Pr. (N. S.; N. Y.) 348; Gillott v. Esterbrook (1872) 48 N. Y. 374; Wolfe v. Barnett (1872) 24 La. Ann. 97; Burke v. Cassin (1873) 45 Cal. 467; Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5; Dunbar v. Glenn (1877) 42 Wis. 118; Gilman v. Hunnewell (1877) 122 Mass. 139; Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453; Shaver v. Shaver (1880) 54 Iowa, 208; Hier v. Abrahams (1880) 82 N. Y. 519; Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946; Avery v. Meikle (1883) 81 Ky. 73; Selchow v. Baker (1883) 93 N. Y. 59; Smith v. Walker (1885) 57 Mich. 456; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Cady v. Schultz (1895) 19 R. I. 193; Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutillier (1888) 47 Hun (N. Y.) 521; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 137 Ill. 231; Hoyt v. Hoyt (1891) 143 Pa. 623; Metcalfe v. Brand (1887) 86 Ky. 331; Weener

from a business, or the goodwill thereof.[2] It must be so clear and well defined as to give notice to others of the origin

v. Brayton (1890) 152 Mass. 101, 8 L. R. A. 640; Cigar-Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125.

The following are some of the definitions of a trade-mark, to be found in the decisions of the courts:

In Shaw Stocking Co. v. Mack (1882) 12 Fed. 707, 710, Coxe, J.: "A trade-mark is a mark by which the wares of the owner are known in trade."

In Adams v. Heisel (1887) 31 Fed. 279, 280, Welker, J.: "What is a trade-mark? A 'mark' means to make a visible sign upon something; to affix a significant mark to; to draw, cut, fasten, brand; a token upon, indicating or intimating something; to affix an indication to; to attach one's name or initials to. Webst. Dict. A trade-mark, therefore, consists of the use in trade of such a mark, placed upon goods manufactured by a particular person, and placed in market, with such marks, for sale and trade."

In Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314, 317, Allison, P. J.: "A trade-mark * * * is * * * a name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from the goods of another."

In Candee v. Deere (1870) 54 Ill. 439, 456, Breese, J.: "A trade-mark is the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry, or enterprise."

In Burke v. Cassin (1873) 45 Cal. 467, 478, Rhodes, J.: "A trade-mark is a word, symbol, figure, form, or device, or a combination thereof, adopted or devised and used by a manufacturer or vendor of goods to designate the origin or ownership of his goods, and is used by him to distinguish his goods from those which are manufactured or sold by others."

In Cady v. Schultz (1895) 19 R. I. 193, 195, Douglas, J.: "A trade-mark is a symbol arbitrarily selected by a manufacturer or

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[2] Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376; Cigar-Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125.

or ownership of the article to which it is applied, and it cannot be materially changed or deviated from.[3] It is a right

dealer, and attached to his wares to indicate that they are his wares. * * * When it has become generally known in the trade that this symbol or word has been taken by one dealer or manufacturer to indicate his goods, he acquires a title to it for that purpose, and no one else can use it, even innocently."

In Avery v. Meikle (1883) 81 Ky. 73, 84, Hargis, C. J.: "A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral, or combination or arrangement of any or all of these, which would serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth."

In Dr. Jeager's Sanitary Woolen System Co. v. Le Boutillier (1888) 47 Hun (N. Y.) 521, 523, Van Brunt, P. J.: "A trade-mark * * * is a mark or device attached by the manufacturer and seller of goods to the merchandise produced by him, in order to distinguish it from a like class of merchandise produced by others; and the right to the exclusive use of such mark accrues, not because he was the originator of the same, but because he has applied it to goods of his manufacture, and they have acquired a reputation in connection with such mark."

In Shaver v. Shaver (1880) 54 Iowa, 208, 210, Beck, J.: "A trade-mark is a name, sign, symbol, mark, brand, or device of any kind used to designate the goods manufactured or sold, or the place of business of the manufacturer or dealer in such goods. The exclusive right in a trade-mark is acquired by its use, which the law does not require shall be continued for any prescribed time."

In Wecner v. Brayton (1890) 152 Mass. 101, 102, 8 L. R. A. 640, 642. Devens, J.: "A trade-mark is a peculiar name or device, by which a person dealing in an article designates it as of a peculiar kind, character, or quality, or as manufactured by or for him, or dealt in by him, and of which he is entitled to the exclusive use."

In Leidersdorf v. Flint (1878) 8 Biss. 327, 330, Fed. Cas. No. 8,219, Dyer, J.: "A trade-mark has been very well defined as one's commercial signature to his goods. It may consist of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer

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[3] Candee v. Deere (1870) 54 Ill. 439; Metcalfe v. Brand (1887) 86 Ky. 331.

which can only be tested by its violation.[4] It acknowledges no territorial boundaries, and is not limited in time. It is a right that must be exclusive in the proprietor, either individually or jointly with others.[5] It has been well defined as one's commercial signature.[6]

or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, so that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity."

In Leather Cloth Co. v. American Leather Cloth Co. (1865) 35 Law J. Ch. 53, 61, Lord Cranworth: "The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where, or by whom, or at what manufactory, the article to which it is affixed was manufactured."

In Larrabee v. Lewis (1881) 67 Ga. 561, 563, Crawford, J.: "A trade-mark is defined to be the name, symbol, figure, letter, form, or device used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and to secure such profits as result from a reputation for superior skill, industry, or enterprise."

In Humphreys' Specific Homeopathic Medicine Co. v. Wenz (1882) 14 Fed. 250, 252, Nixon, Dist. J.: "A trade-mark is any proper mark by which goods and wares of the owner or manufacturer are known in the trade."

In Hostetter v. Fries (1883) 17 Fed. 620, 622, Wallace, J.: "A trade-mark consists of a word, mark, or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article."

In Davis v. Davis (1886) 27 Fed. 490, 491, Carpenter, J.: "A trade-mark is some arbitrary or representative device attached to or sold with merchandise, and serving to designate the origin or manufacture of that merchandise."

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[4] Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Collins v. Cowen (1857) 3 Kay & J. 428; Farina v. Silverlock (1856) 6 De Gex, M. & G. 214; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291.

[5] Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Siegert v. Abbott (1893) 72 Hun (N. Y.) 243.

[6] Leidersdorf v. Flint (1878) 8 Biss. 327, Fed. Cas. No. 8,219.

§ 2. Office of trade-mark.

The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed or applied. Unless it does this, neither can he who first adopted the trade-mark be injured by any appropriation or imitation of it by others, nor can the public be deceived. "The first appropriator of a name or device pointing to his ownership, or which, by being associated with his articles of trade, has acquired an understood reference to him as the originator or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is in effect representing falsely that the productions of the latter are those of the former. Thus, the custom and advantages to which the enterprise and skill of the first appropriator had given him a just right are abstracted for another's use, and this is done by deceiving the public, by inducing the public to purchase the goods and manufactures of one person, supposing them to be those of another. The trade-mark must, therefore, be distinctive in its original signification, pointing to the origin of the article, or it must have become so by association."[7]

[7] Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Kidd v. Johnson (1879) 100 U. S. 617; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Larrabee v. Lewis (1881) 67 Ga. 561; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651; Cigar-Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125; Marshall v. Pinkham (1881) 52 Wis. 572; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Symonds v. Jones (1890) 82 Me. 302; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 Sup. Ct. 151; Laughman's Appeal (1889) 128 Pa. 1; Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117; Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391; Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331; Handy v. Commander (1897) 49 La. Ann. 1119.

In Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51, 54, Field, J.: "The object of the trade-mark is to indicate, either by its own

§ 3. Indication of origin or ownership may be direct, or by association of the mark with the article.

While the trade-mark must indicate the "true origin or ownership" of the article to which it is applied, it need not

meaning or by association, the origin or ownership of the article to which it is applied. If it did not, it would serve no useful purpose either to the manufacturer or to the public. It would afford no protection to either against the sale of a spurious in place of the genuine article."

In Kidd v. Johnson (1879) 100 U. S. 617, 620, Field, J.: "It is true, the primary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is affixed."

In Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 463, Jackson, J.: "To acquire the right to the exclusive use of a name, device, or symbol as a trade-mark, it must appear that it was adopted for the purpose of identifying the origin or ownership of the article to which it is attached, or that such trade-mark must point distinctively, either by itself or by association, to the origin, manufacture, or ownership of the article on which it is stamped. It must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity, and to distinguish it from like articles manufactured by others."

In Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331, 334, Rapallo, J.: "The right to use a word or name as a trade-mark is the right which a person has to use a certain mark or name for articles which he has manufactured, so that he may prevent another person from using it, because the mark or name denotes that articles so marked or named were manufactured by a certain person, and no one can have the right to put the same name or mark upon his goods, and thus represent them to have been manufactured by the person whose mark it is."

In Waterman v. Shipman (1891) 130 N. Y. 301, 311, Vann, J.: "The function of a trade-mark is to point out the maker of the article to which it is attached. It individualizes the particular make of one who adopted the name for that purpose and with that effect. The defendants claim that the use by them of the name in question did not point out the maker, but the inventor, but we think it indicated both. 'Waterman's Fountain Pen,' with the date of the patent following, pointed out the inventor, while the insertion of the word 'Ideal,' together with the use made of it, pointed out the maker. * * * As the name was also used to indicate

give such indication directly or by its own meaning. It is sufficient if it indicate the ownership or origin by association of the particular mark with the particular article. For instance, if an arbitrary or fanciful mark or device is applied as a trade-mark to an article, there need be nothing more than this mark or device on the article. The manufacturer's or dealer's name and address may be wholly want-

the patented article, it performed the double function of identifying, not only fountain pens as made by Mr. Waterman, but also as patented by him. Can this fact take anything from his rights, or add anything to those of the defendants? Cannot a patentee adopt the same name to designate his workmanship, as well as his invention? Assuming that, upon the expiration of the patent, any one may use the name, until that time arrives, why should the inventor be deprived of a right which, without question, would be his if he had not taken out a patent for his invention?"

In Cigar-Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 245, Gilfillan, C. J.: "It is essential that the symbol or device shall be adopted to distinguish the productions of the manufacturer or vendor from those of others, and it must so distinguish them."

In Symonds v. Jones (1890) 82 Me. 302, 310, Emery, J.: "Such words and marks, however, as by their own meaning, or by association in the public mind, indicate not the quality of an article, but its origin or ownership,—the person by whom or the factory in which it was produced,—become appropriated in their use exclusively to the originator or owner of such articles. No other person can lawfully use them to designate other similar articles of different origin or ownership."

In Laughman's Appeal (1889) 128 Pa. 1, 19, Clark, J.: "The object of a trade-mark is that the article to which it is attached or belongs may be distinguished from articles of a similar kind, and thus be known and identified in the market. Its purpose is to indicate the personal origin of the article to which it is applied, or the source from which it comes."

In Marshall v. Pinkham (1881) 52 Wis. 572, 578, Cassoday, J.: "It seems to be the office of a trade-mark to point out the true source, origin, or ownership of the goods to which the mark is applied, or to point out and designate a dealer's place of business, distinguishing it from the business locality of other dealers."

ing, and the indication of origin or ownership may be the consequence of such continued and uniform use of marks, devices, or, in some instances, of words, by a manufacturer or dealer, as to create, in the mind of the public, an association between the marks, devices, or words and the article to which they are attached, on the one hand, and the manufacturer or dealer, or place of manufacture, on the other; so that mere marks, devices, or words which, upon their face, impart no reference to or connection with the manufacturer of, or dealer in, the article to which they are constantly affixed, nor any index to its origin, may, because of such customary use upon such article, come to indicate clearly its origin or ownership. The trade-mark will then indicate origin or ownership wholly by association.[8]

In the case of Ferguson v. Davol Mills,[9] the court held that the letter "K," surrounded by a circle, did not constitute a trade-mark, as it did not indicate the name and address of the manufacturer, and, in deciding the case, Allison, P. J., said: "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 attribute, and entitle it to the protection, of a trade-mark."

In the later case of White v. Schleet,[10] Judge Allison ad-

[8] Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Kidd v. Johnson (1879) 100 U. S. 617; Powell v. Birmingham Vinegar Brewery Co. (1896) 65 Law J. Ch. Div. 563; Scott v. Standard Oil Co. (1894) 106 Ala. 475; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651; Pearrung v. Compton (1892) 6 Ohio Cir. Ct. R. 483; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376.

[9] (1869) 7 Phila. (Pa.) 253; (1868) 2 Brewst. (Pa.) 314.

[10] (1880) 14 Phila. (Pa.) 88.

hered to the rule laid down by him in Ferguson v. Davol Mills. This position, however, is not sound. It loses sight of the rule that a trade-mark may indicate origin or ownership by association, as well as by its own meaning. Judge Allison's decision has not been followed in later cases.[11]

In Sheppard v. Stuart,[12] Judge Finletter discusses the case of Ferguson v. Davol Mills, and, after pointing out that the cases cited by the learned judge in that case do not support his position, says: "How is a mark or device to indicate 'true origin or ownership,' or to indicate the name and address of the manufacturer? In and by itself alone, this is impossible. It is only by use as the device of him who distinguishes his goods by it in order that they may be known as his that it can ever indicate 'true origin or ownership.' * * * In other words, the evidence must show the first appropriation of the device by the claimant, its application by him to his goods or business, and that the trade or public recognize the article or business by that device, as made or sold by him, or belonging to him. In no other way can a mark or device indicate 'true origin or ownership.'"

§ 4. Association may be acquired only after long use.

The association of the trade-mark with the origin of the goods may be acquired only after long use. The effect as well as the value of the trade-mark is the work of time and experience. It is sufficient for all purposes if, at the time when the question of the validity of the trade-mark is raised,

[11] Godillott v. Harris (1880) 81 N. Y. 263; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338 (see note to this case in 26 Am. Law Reg. [N. S.] 176); Meriden Britannia Co. v. Parker (1872) 39 Conn. 450; Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[12] (1879) 13 Phila. (Pa.) 117.

it is well understood by the trade that articles bearing the mark are made or sold by a particular manufacturer or vendor.[13] The original use of the trade-mark may have been begun and continued for any length of time without any thought or intention on the part of the proprietor of the device of its being or becoming a trade-mark. As stated by the supreme court of the United States: "The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident, rather than design."[14] It is for this reason that a descriptive or geographical term may sometimes become a valid trade-mark. When first employed, such term may have been used only in its primary descriptive sense, but, after long use, it may acquire a new or secondary meaning, and may come, when thus used, to designate to the mind of the purchasing public the particular article as made or sold by a particular manufacturer or vendor, instead of indicating that the article possesses certain qualities, or is to be obtained from a particular locality.[15]

§ 5. The trade-mark brings seller and buyer together.

It has been said that the province of a trade-mark is to bring seller and buyer together, that the one may sell his merchandise, and the other obtain the particular goods the reputation of which has won his confidence, and that, when this is done, the office and object of the trade-mark is accom-

[13] Meriden Britannia Co. v. Parker (1872) 39 Conn. 450.

[14] Trade-Mark Cases (1879) 100 U. S. 82.

[15] American Waltham Watch Co. v. United States Watch Co. (1889) 173 Mass. 85; American Waltham Watch Co. v. Sandman (1899) 96 Fed. 330; Wotherspoon v. Currie (1872) 42 Law J. Ch. 130, L. R. 5 H. L. 508.

plished.[16] By this is meant that, when the trade-mark has guided the article from the purchaser to the consumer, it has done its work. It has brought to the consumer the article that he wishes to purchase. It has guarantied to him the genuineness of that article. If the case or package bearing such trade-mark is now used for a totally different purpose, or if the trade-mark is removed or obliterated, no one is deceived or misled, and no injury is done either to the seller or buyer.

§ 6. Object of the law in protecting trade-marks.

The object or purpose of the law in protecting trade-marks is two-fold: First, it secures to him who has been instrumental in bringing into the market a superior article of merchandise the fruit of his industry and skill; second, it protects the community from imposition, and furnishes a guaranty that an article, purchased as the manufacture or selection of one who has appropriated to his own use a certain trade-mark, is genuine. The law thus prevents fraud upon the manufacturer, and imposition upon the public.[17] As said by the supreme court of the United States in a leading case, any one has an unquestionable right to affix to articles manufactured by him a mark or device not previously appropriated to distinguish his from articles of the same general character manufactured or sold by others. He may

[16] Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

[17] Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Newman v. Alvord (1867) 49 Barb. (N. Y.) 588; Wolfe v. Burke (1873) 7 Lans. (N. Y.) 151; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Skinner v. Oakes (1881) 10 Mo. App. 45; Avery v. Meikle (1883) 81 Ky. 73; De Long v. De Long Hook & Eye Co. (1894) 10 Misc. Rep. (N. Y.) 577.

thus notify the public of the origin of the article, and secure to himself the benefit of any particular excellence it may possess from the manner or materials of its manufacture. His trade-mark is both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture. It thus often becomes of great value to him, and, in its exclusive use, the court will protect him against attempts of others to pass off their products upon the public as his. This protection is afforded, not only as a matter of justice to him, but to prevent imposition upon the public.[18]

§ 7. Origin of trade-mark law.

The trade-mark law grew out of the philosophy of the general rule that every man should so use his own property and rights as not to injure the property and rights of another, unless some priority of right or emergency exists to justify a necessarily different manner of use. The intermediate instrument of prevention which the law protects in its office is called a "trade-mark," which an owner of goods may adopt and use to indicate their origin or ownership, and to distinguish them from goods of a similar nature produced by somebody else.[19]

§ 8. Principle upon which all cases unite.

The principle upon which all the cases on the subject of trade-marks unite is that one man will not be permitted, by imitating the distinctive name or mark already in use by another person to designate the articles of the latter's manufacture, to impose articles of his own manufacture upon the public as the articles of the latter. The cases so holding

[18] Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51.
[19] Avery v. Meikle (1883) 81 Ky. 73.

rest upon the considerations already stated: First, that it would be a fraud upon the rights of the first user thus to permit his trade-mark to be imitated; second, that it would be a fraud on the public.[20]

§ 9. Leading principle that proprietor shall be protected.

It is the leading principle of the law of trade-marks that the manufacturer or merchant who has produced or brought into market an article of use or consumption that has found favor with the public, and who, by affixing to it some name, device, or symbol which serves to distinguish it from all others, has furnished his individual guaranty of its value, shall receive the reward of his skill, and shall not be deprived thereof by infringement or imitation.[21]

§ 10. Enforcement of doctrine does not depend entirely on individual rights.

The enforcement of the doctrine that trade-marks shall

[20] McLean v. Fleming (1877) 96 U. S. 245, 251; Gilman v. Hunnewell (1877) 122 Mass. 139; Colman v. Crump (1877) 70 N. Y. 573; Fairbanks v. Jacobus (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608; Devlin v. Devlin (1875) 67 Barb. (N. Y.) 290; Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297; Curtis v. Bryan (1868) 2 Daly (N. Y.) 312, (1867) 36 How. Pr. (N. Y.) 33; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Howe v. Howe Machine Co. (1867) 50 Barb. (N. Y.) 236; Sykes v. Sykes (1824) 3 Barn. & C. 541; Burgess v. Burgess (1853) 3 De Gex, M. & G. 896, 904; Burke v. Cassin (1873) 45 Cal. 467; Ellis v. Zeilin (1871) 42 Ga. 91; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523, 538; Perry v. Truefitt (1842) 6 Beav. 66; Walton v. Crowley (1856) 3 Blatchf. 440, 448, Fed. Cas. No. 17,133; Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322.

[21] Wolfe v. Barnett (1872) 24 La. Ann. 97; Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322; Marshall v. Pinkham (1881) 52 Wis. 572; Clark v. Clark (1857) 25 Barb. (N. Y.) 76.

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 and symbols, in such manner as may deceive them by inducing or leading to the purchase of one thing for another. It is not necessary, therefore, to the exercise of judicial powers, that the plaintiff should have any other property in the name or mark used, as a mere name or mark, than that possessed by any other person.[22] Thus, no one can claim that he has any property in any word or mark, as such. Every person has an equal right to the mere use of words or marks. But it is the right to use words or marks in a specific manner, or for a specific purpose, that may be exclusively claimed, and, under proper conditions, enforced.

§ 11. Adoption of trade-mark gives no exclusive right to production of article.

The adoption of a trade-mark to indicate the manufacture or origin of a certain article does not give any right to the exclusive production of the article so marked. An article of manufacture, unless it be protected by a patent, may be made or sold by any person. Any person who possesses the requisite skill may copy or imitate any unpatented article. There is no such thing as an exclusive right to any particular branch of industry. The only restriction is that each party shall stand upon his own merits, and none shall be permitted, by the use of marks or symbols, to pretend that the goods offered by him are the products of another.[23]

[22] Matsell v. Flanagan (1867) 2 Abb. Pr. (N. S.; N. Y.) 459; Reviewed Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 374.

[23] Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5, affirmed (1879) 44 N. Y. Super. Ct. 427; Powell v. Birmingham Vinegar Brewery Co. (1896) 65 Law J.

§ 12. Proprietor has valuable interest in goodwill of his trade or business.

In trade-mark cases, the question is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he now puts his trade-mark, nor whether the article made and sold under his trade-mark by the defendant is equal to his own in quality or value. But the court proceeds on the ground that the complainant has a valuable interest in the goodwill of his trade or business, and, having appropriated to himself a particular trade-mark, indicating to his customers that the article is made or sold by him or by his authority, he is entitled to protection against one who attempts to pirate upon the goodwill of his friends or customers, or the patrons of his trade or business, by using such trade-mark without his consent or authority.[24] It is to protect this right of one's selling his own that the law of trade-marks has been introduced. The right must include the privilege of selling to all,—to the incautious as well as to the cautious.[25]

§ 13. Protection of trade-marks promotes honesty and fair dealing.

The protection of trade-marks is therefore among the highest incentives to ingenuity, exertion, and fidelity, and one of the greatest securities to the public against imposition,[26] and the ground upon which equity proceeds is the promotion of honesty and fair dealing. No one has a right to sell his own goods as the goods of another.[27]

Ch. Div. 563; Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutillier (1893) 24 N. Y. Supp. 890, 5 Misc. Rep. 78.

[24] Partridge v. Menck (1847) 2 Sandf. Ch. (N. Y.) 622, 2 Barb. Ch. (N. Y.) 101.

[25] Brooklyn White Lead Co. v. Masury (1857) 25 Barb. (N. Y.) 416.

[26] Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 603.

[27] Palmer v. Harris (1869) 60 Pa. 156.

§ 14. Earliest trade-mark case.

The earliest trade-mark case of which there is any record appears to have been decided during the reign of Queen Elizabeth (1590), and, while there is no report of the case, it was cited by Doderidge, Justice, in the case of Southern v. How.[28] In one report of this case the reference is as follows: "Doderidge cited a case to be adjudged (33 Eliz.) in the common pleas: A clothier of Gloucestershire sold very good cloth, so that, in London, if they saw any cloth of his mark, they would buy it without searching thereof, and another, who made ill cloth, put his mark upon it without his privity, and an action upon the case was brought by him who bought the cloth for this deceit, and adjudged maintainable." In another report of Southern v. How,[29] the reference to this case is as follows: "Doderidge said that (22 Eliz.) an action upon the case was brought in the common pleas by a clothier; that, whereas he had gained great reputation for his making of his cloth, by reason whereof he had great utterance to his great benefit and profit, and that he used to set his mark to his cloth, whereby it should be known to be his cloth, and another clothier, perceiving it, used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie." According to the first report of this case, the action was brought by the defrauded purchaser, and the action was, therefore, an ordinary action of deceit. According to the other report, the action was brought by the owner of the mark, and, if this is correct, this was undoubtedly the first action for the infringement of a trade-mark.[30]

[28] Cro. Jac. 471.

[29] Popham, 144.

[30] Kerly, Trade-Marks, p. 2.
The following appears in a note to Crawshay v. Thompson (1842)

§ 15. Development of English trade-mark law.

The English trade-mark law is a development of the nineteenth century, and has been said to afford 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.[31] Reference to a few of the earlier cases will be of interest:

In Blanchard v. Hill,[32] a motion was made on behalf of the plaintiff for an injunction to restrain the defendant from making use of the Great Mogul as a stamp upon his cards, to the prejudice of the plaintiff, upon the suggestion that the plaintiff had the sole right to this stamp, having appropriated it to himself, conformable to the charter granted to the Card-Makers' Company by King Charles I. Lord Chancellor Hardwicke denied the injunction. A part of the decision is as follows: "In the first place, the motion is to restrain the defendant from making cards with the same mark which the plaintiff has appropriated to himself, and, in this respect,

4 Man. & G. 386: "In Popham, this decision is said to have taken place in 22 Eliz., and in Cro. Jac. in 33 Eliz., but it is clearly the same case. In Com. Dig., 'Action on the Case for Deceit' (A9), the case is thus referred to: '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 from Cro. Jac. only, it may be inferred that he considered the case as establishing the right of action in the purchaser, which it certainly would, supposing that report to be accurate. The report in Popham would appear more likely to be a true version of Doderidge's statement, since the case, as represented by Croke, would not have been very apposite to that of Southern v. How, in which it was cited by the learned judge. Lord Rolle, however, expressly states that Doderidge did not say whether the former action was brought by the clothier or by the vendee, but adds, 'Semble que gist pur le vendee.' 2 Rolle, Rep. 28."

31 Browne, Trade-Marks, p. 19.

32 (1742) 2 Atk. 484.

there is no foundation for this court to grant such an injunction. Every particular trader has some particular mark or stamp; but I do not know 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. Mr. Attorney General has mentioned a case where an action at law was brought by a cloth worker against another of the same trade for using the same mark, and a judgment was given that the action would lie. Popham, 151. But it was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away customers from the other clothier. And there is no difference between a tradesman's putting up the same sign and making use of the same mark with another of the same trade. * * * An objection has been made that the defendant, in using this mark, prejudices the plaintiff by taking away his customers; but there is no more weight in this than there would be in an objection to one innkeeper setting up the same sign with another. * * * Upon the whole, there are no grounds in this case to grant an injunction against the defendant till the hearing of the cause."

In Singleton v. Bolton,[33] Lord Mansfield, discharging a rule for a new trial in a case in which the plaintiff was nonsuited, 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."

In Hogg v. Kirby,[34] Lord Chancellor Eldon granted an injunction to restrain publishing a magazine, as a continuance of the plaintiff's magazine, in numbers. The injunc-

[33] (1783) 3 Doug. 293.

[34] (1803) 8 Ves. 215.

tion did not prevent the publication of an original work of the same nature and under a similar title. The injunction was granted to restrain the defendant from publishing a work under a fraudulent representation that such work was that of the plaintiff, and was really to restrain what, at the present time, would be designated as unfair competition. This clearly appears from the following statement in the opinion: "In this case, protesting against the argument that a man is not at liberty to do anything which can affect the sale of another work of this kind, and that, because the sale is affected, therefore there is an injury (for, if there is a fair competition by another original work, really new, be the loss what it may, there is no damage or injury), I shall state the question to be, not whether this work is the same, but, in a question between these parties, whether the defendant has not represented it to be the same, and whether the injury to the plaintiff is not as great, and the loss accruing ought not to be regarded in equity upon the same principles between them, as if it was in fact the same work."

In 1813, a demurrer to a bill in equity was allowed by Vice-Chancellor Plumer with the following statement: "The violation of right with which the defendant is charged does not fall within the cases in which the court has restrained a fraudulent attempt by one man to invade another's property; to appropriate the benefit of a valuable interest, in the nature of goodwill, consisting in the character of his trade or production, established by individual merit, the other representing himself to be the same person, and his trade or production the same, as in Hogg v. Kirby, combining imposition on the public with injury to the individual."[35]

In 1816, an injunction was granted to restrain a manufacturer from using, upon blacking, labels in imitation of

[35] Canham v. Jones (1813) 2 Ves. & B. 218.

those employed by the plaintiff.[36] This has been said to be the earliest reported case in which the infringement of a trade-mark was restrained. The first reported case for the infringement of trade-marks in the common-law courts is Sykes v. Sykes,[37] in 1824. In this case, the declaration stated that the plaintiff was a manufacturer of shot belts and powder flasks, which he was accustomed to mark with the words "Sykes' Patent," and that the defendants made shot belts and powder flasks which they also marked "Sykes' Patent," in imitation of the marks used by the plaintiff, and sold the articles so made and marked as and for shot belts and powder flasks of the manufacture of the plaintiff. At the trial, before Mr. Justice Bayley, it appeared that the plaintiff's father obtained a patent for the manufacture of the articles in question, which patent, however, had been held to be invalid, in consequence of a defect in the specification, but that the patentee, and afterwards the plaintiff, continued to mark the articles with the words "Sykes' Patent." It appeared, also, that the mark used by the defendant resembled, as nearly as possible, that adopted by the plaintiff. Mr. Justice Bayley held that the defendant had no right so to mark his goods, as and for goods manufactured by the plaintiff, and he left it to the jury to say whether the defendants adopted the mark in question for the purpose of inducing the public to suppose that the articles were manufactured, not by them, but by the plaintiff. The jury found a verdict for the plaintiff. Upon motion for a new trial, Abbott, C. J., delivered the judgment of the court, and said: "I think that the substance of the declaration was proved. It was established most clearly that the defendants marked

[36] Day v. Day (1816) Eden, Inj. (1st Am. Ed.) 226; Cod. Dig. 138.

[37] (1824) 3 Barn. & C. 541, 3 Law J. K. B. (O. S.) 46.

the goods manufactured by them with the words 'Sykes' Patent' in order to denote that they were of the genuine manufacture of the plaintiff; and although they did not themselves sell them as goods of the plaintiff's manufacture, yet they sold them to retail dealers for the express purpose of being resold as goods of the plaintiff's manufacture. I think that is substantially the same thing, and that we ought not to disturb the verdict."

In Blofeld v. Payne[38] it was held, in a case in the court of king's bench, that it was unnecessary for a plaintiff, in an action for damages at common law, to prove that the goods sold by the infringer were inferior to those manufactured and sold by the plaintiff to which the mark in controversy was applied, or to prove any special damage resulting from the defendant's acts.

In 1838 came the important case of Millington v. Fox,[39] in which it was held by Lord Cottenham that a court of equity will grant a perpetual injunction against the use, by one tradesman, of the trade-mark of another, although such marks have been so used in ignorance of their being any person's property, and under the belief that they were merely technical terms. It has been said that this was the first case in which an English court held that the owner of a trade-mark was entitled to injunction against the use of a mark by those who used it without fraudulent intent,—in other words, recognized the right to the exclusive use of a trade-mark as a property right.[40] The growth of commerce and increase in the facilities of communication and transportation had widened the markets of all manufacturers, and it became necessary for the courts to protect the manufacturers

[38] (1833) 4 Barn. & Adol. 410, 2 Law J. K. B. 68.

[39] (1838) 3 Mylne & C. 338.

[40] Greeley, Report to Revise Patent and Trade-Mark Laws (1900).

and dealers in the use of their marks, and also to protect the purchasing public from imposition and fraud. The rule that a trade-mark is property was not, however, finally established by the case of Millington v. Fox, and, as late as 1857, Vice-Chancellor Sir W. Page Wood said: "It is now settled law that there is no property whatever in a trade-mark, but that a person may acquire a right of using a particular trade-mark for articles which he has manufactured, so that he may be able to prevent any other person from using it, because the mark denotes that articles so marked were manufactured by a certain person."[41] The jurisdiction of the courts to grant relief in trade-mark cases is now held not to rest alone on fraud, but upon property in the trade-mark, and upon the fact that an injunction is the only mode of protecting it. The earlier cases, to the effect that there is no property in a trade-mark, must be deemed in that respect overruled.[42]

§ 16. Development of American trade-mark law.

The earliest reported case in the United States relating to the subject of trade-marks is that of Thomson v. Winchester,[43] in the supreme court of Massachusetts, in which the opinion is by Chief Justice Shaw. In this case it was held that, if the defendant made and prepared medicines, calling them "Thomsonian Medicines," and sold them, or placed them in the hands of others to sell, 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, it was a fraud upon the plaintiff, and an injury to his rights, for

[41] Collins Co. v. Brown (1857) 3 Kay & J. 426.

[42] Perry v. Truefitt (1842) 6 Beav. 66; Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222.

[43] (1837) 19 Pick. (Mass.) 214.

which the law will presume some damages. It was further held, however, "that, without obtaining a patent, 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 plaintiff to make and vend these medicines, or to call them 'Thomsonian,' if this term had acquired a generic meaning descriptive of a general kind, quality, and class of medicines, as, for instance, James' powders or Turlington's balsam, and if they were not sold to consumers, or consigned or sold to others, to be sold to consumers, as and for medicines made and prepared by the plaintiff."

The earliest case to come before a federal court was that of Taylor v. Carpenter,[44] which was decided by Justice Story in 1844. In this case it appeared that the plaintiffs were manufacturers in England of "Taylor's Persian Thread," and the defendant, in America, imitated their names, trademarks, envelopes, and labels, and placed them on thread of a different manufacture. It was held that it was a fraudulent infringement by the defendant of the rights of the plaintiffs, for which equity would grant relief, and that it was immaterial whether other persons had or had not done the same. The learned justice said: "I have not the slightest doubt, in the present case, that a perpetual injunction ought to be granted. The case presented is one of unmitigated and designed infringement of the rights of the plaintiffs, for the purpose of defrauding the public, and taking from the plaintiffs the fair earnings of their skill, labor and enterprise."

In 1857, the case of Clark v. Clark[45] was decided by the

[44] (1844) 3 Story, 458, Fed. Cas. No. 13,784. See, also, Taylor v. Carpenter (1844) 11 Paige (N. Y.) 292.

[45] (1857) 25 Barb. (N. Y.) 76.

supreme court of New York. The trade-mark involved was used upon spool cotton, and an injunction was granted, although defendants were not prohibited from using their own name, the court saying: "Both parties deal in spool cotton, and, as both are of the same name, each is entitled to have his called by the name of 'Clark's Spool Cotton.'" The court further said: "The law of trade-marks is of recent origin, and may be comprehended in the proposition that a dealer 'has a property in his trade-mark.' The ownership is allowed to him that he may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public as his that which is not his. An imitation of his mark, with partial differences, such as the public would not observe, does him the same harm as an entire counterfeit. If the wholesale buyer, who is most conversant with the marks, is not misled, but the small retailer or consumer is, the injury is the same in law, and differs only in degree. The right of action must exist for the last as well as the first. If all consumers do not discriminate in the end, it would be indifferent, even to the wholesale buyers, from which of the two they bought, and thus the extent, also, of the injury would be as great as if they also were deceived. It would follow that the defendants in this case should be enjoined from using the mark which they now use, and from any imitation of it with only colorable differences; but the injunction should not be as broad as it was originally granted. It should be so expressed that the defendants might distinctly understand what is prohibited. 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."

These cases, at the present day, would all be considered as cases of unfair competition, as no one of them involved any technical trade-mark. The term "Taylor's Persian Thread" might, possibly, be considered a technical trade-mark, but as the defendant had imitated not only the name, but the envelopes and labels as well, the question as to whether these words constituted a technical trade-mark did not arise.

In Phalon v. Wright,[46] decided by the court of common pleas of Philadelphia in 1864, a very clear statement of the main principles of trade-mark law is found. The court said: "It is somewhat strange that, in the state of Pennsylvania, whose people are so largely engaged in manufactures, the subject of 'trade-marks' should not have been more frequently presented to our courts for decision. The case of Colladay v. Baird, reported in 4 Phila. (Pa.) 139, decided in this court, in which my Brother Ludlow delivered an elaborate and well-considered opinion, seems to be the only reported decision in this state upon the subject. In New York the subject of trade-marks has been frequently presented for judicial consideration, and in the decisions of the courts of that state and of the English tribunals, with one or two from other states, we find the sources of the information required for the investigation of the case before us. It is well settled that a court of equity will exercise its powers for the protection of the owner of a trade-mark in the exclusive enjoyment of that device or symbol chosen by him to designate his goods or manufactures, and to distinguish them from those of others. Every man has a right to the products of his own labor, and is entitled so to distinguish them that persons dealing in or purchasing his commodities may be readily able to recognize them as his. The maker may therefore, either

[46] (1864) 5 Phila. (Pa.) 464.

with or without the use of his name, adopt a word, title, symbol, or figure to designate the ownership or manufacture of the goods. In the use of such 'trade-mark' he is to be protected from the efforts of others who would take advantage of his enterprise or skill, and, by imitation, endeavor to impose upon the public, and to deprive him of the just reward of his industry. The adoption of a trade-mark or device to indicate the manufacture or origin of a certain article does not give any right to the exclusive production of the article so marked. Any article of manufacture, unless it be protected by a patent, may be made and sold by any person. There is no such thing as an exclusive right to any particular branch of industry. The only restriction is that each party shall stand upon his own merits, and none shall be permitted, by the use of marks or symbols, to pretend that the goods offered by him are the products of another. Perry v. Truefitt, 6 Beav. 72; Coffeen v. Brunton, 4 McLean, 516 [Fed. Cas. No. 2,946]. This rule has even been applied to cases where there was no intentional deception; as where the manufacturer of steel was prohibited from stamping upon his manufacture certain words which he supposed were descriptive of a particular quality of steel, but which were, in fact, the name of the original manufacturer, and indicated his ownership. Millington v. Fox, 3 Mylne & C. 338. The 'trade-mark,' to be capable of an exclusive use, must be such as will identify the article to which it is affixed as that of the person naming it, and distinguish it from others. A word which is the name of the article, or indicates its quality, cannot be so appropriated. Every one has the right to manufacture the same article, and to call it by its name or descriptive character. In doing so there is no violation of propriety or of truth,—nothing which intrudes upon the distinctive province of others. Singleton v. Bolton, 3 Doug.

293; Canham v. Jones, 2 Ves. & B. 218; Amoskeag Mfg. Co. v. Spear, 2 Sandf. (N. Y.) 599; Stokes v. Landgraff, 17 Barb. (N. Y.) 608. Were it otherwise, monopolies might be created which would be destructive of the freedom of trade, and restrictive of the free exercise of talent."

In Joseph Dixon Crucible Co. v. Guggenheim,[47] decided in 1869, Judge Paxson, referring to the growth of the trade-mark law, said: "There is no doubt but that property in trade-marks has been recognized for a long time by the profession and by the court, but it has only been within a comparatively short time that its importance has come to be fully understood. In a rude age, when manufactures were few, and those of only useful and indispensable articles, trade-marks were but little known, and seldom, if ever, violated. It was when wealth and luxury increased, and manufactures multiplied accordingly, that the use and value of a trade-mark became distinctly recognized. In the present age, with the vast extension of the manufacturing interest, the law upon this subject is, of necessity, frequently invoked, and it is settling down into a consistent theory."

§ 17. Right to use a trade-mark is property.

Upon whatever idea the courts proceeded, as soon as their decisions established in a particular individual a right, exclusive as against the world, to use a particular label or mark whereby trade was attracted to him, that right at once became a thing of value, and hence property, in a sense more strict than that in which many other incorporeal rights, such as the elective franchise or the right of presentation to a vacant benefice, have been regarded as property. Moreover, the courts of chancery were appealed to, successfully, to enjoin the infringement of trade-marks in cases where no

[47] (1869) 2 Brewst. (Pa.) 326.

fraud was intended, and where the relief could hence be granted only on the idea of property in the user of the mark. Accordingly, it has become a settled doctrine of the English and American courts that trade-marks are protected, not exclusively on the ground of fraud, but also on the ground of property. It is hence settled law that the right to use a trade-mark is not a mere personal privilege, but that, within certain limits, it is property, capable of being bought and sold, and for the invasion of which an action for damages will lie, and the exclusive use of which will be protected, when necessary, by injunction.[48]

§ 18. No abstract property right in a trade-mark.

While the exclusive right to use a trade-mark is property,

[48] Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5; Avery v. Meikle (1883) 81 Ky. 73; Skinner v. Oakes (1881) 10 Mo. App. 45; Cigar-Makers' Prctective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125; Liggett & Myers Tobacce Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Peltz v. Eichele (1876) 62 Mo. 171; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Filley v. Fassett (1869) 44 Mo. 168, 177; Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226; Gilman v. Hunnewell (1877) 122 Mass. 139; Maxwell v. Hogg (1867) 2 Ch. App. 307, 314; Hall v. Barrows (1863) 4 De Gex, J. & S. 150, 158; Bury v. Bedford (1864) 33 Law J. Ch. 465, 4 De Gex, J. & S. 352; Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Trade-Mark Cases (1879) 100 U. S. 82; Kidd v. Johnson (1879) 100 U. S. 617; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169; Mrs. G. B. Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; Bradley v. Norton (1865) 33 Conn. 157; Stonebraker v. Stonebraker (1870) 33 Md. 252; Clark v. Clark (1857) 25 Barb. (N. Y.) 76; Schneider v. Williams (1888) 44 N. J. Eq. 391; Leather Cloth Co. v. American Leather Cloth Co. (1863) 4 De Gex, J. & S. 137, 141; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Handy v. Commander (1897) 49 La. Ann. 1119; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1890) 20 N. Y. Supp. 462; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1892) 135 N. Y. 24; Electro Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369; Laughman's Appeal (1889) 128 Pa. 1.

there is no abstract property right in a trade-mark. It is property only when appropriated and used to indicate the origin or ownership of a commercial article.[49] The trade-mark has no separate, abstract existence, but is appurtenant to the goods designated.[50] It does not partake of the character or nature of a patent or copyright.[51] The owner's right of property in the use of the trade-mark is as complete as that which he possesses in the goods to which he attaches it, and the law protects him in the enjoyment of the one as fully as of the other.[52] The real value of the trade-mark consists in the confidence and patronage of the public, secured through its instrumentality in acquainting them with the origin of an article, which thus gains reputation for its superior qualities. Of this reputation its owner cannot be deprived, without his consent, either by use of forbidden means, or the illegal employment of things otherwise lawful.[53] The property really consists in the exclusive right of a manufacturer or vendor to sell his products or goods as his own, and in being protected in the exercise of that right by the exclusion of all others from its enjoyment, either by selling theirs for his, or causing others to do so.[54] The credit and reputation a person acquires by his care or skill

[49] Cigar Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125; Avery v. Meikle (1883) 81 Ky. 73; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291; Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; McVeagh v. Valencia Cigar Factory (1885) 32 Official Gazette, 1124; Price & S. Am. Trade-Mark Cas. 970; Chadwick v. Covell (1890) 151 Mass. 190.

[50] Derringer v. Plate (1865) 29 Cal. 292.

[51] Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 603; Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376.

[52] Derringer v. Plate (1865) 29 Cal. 292.

[53] Avery v. Meikle (1883) 81 Ky. 73.

[54] Avery v. Meikle (1883) 81 Ky. 73.

in the manufacture of a particular article is a species of property which the law recognizes and protects; and when an article, not of his manufacture, is sold with the mark or symbol affixed which he has devised to designate his own goods, an injury results to him in the effect upon the reputation of his goods, provided the article so sold is inferior thereto, and in the diminution of the demand for his goods, in case such article is equal or superior in quality.[55]

§ 19. Principle upon which courts of equity proceed.

Courts of equity proceed on the principle of protecting property and the promotion of honesty and fair dealing. The protection of the public alone is not sufficient for the jurisdiction. However, it is an element that enters, and ought to enter, into every case.[56] Where a manufacturer has, by skill, care, and fidelity, manufactured a good article, it becomes of the utmost importance to him that its origin and ownership should be known, and the law points out to him what means he may adopt, and how he may appropriate them, to indicate this important fact; and when he adopts and uses them, and his reputation is thereby built up, it is to him the most valuable of property rights. Sound policy, which dictates the protection of the public from imposition, the security of the fruits of labor to the laborer, the encouragement of skillful industry, and, above everything, the inculcation of truth and honor in the conduct of trade and commerce, and the requirement that all the contractual relations of life, natural, abstract, and relative, shall be honestly observed, demands that such a reputation so gained be accorded the safest and best remedy for redress known to the courts of equity.[57]

[55] Lemoine v. Gauton (1854) 2 E. D. Smith (N. Y.) 343.

[56] Avery v. Meikle (1883) 81 Ky. 73; Weener v. Brayton (1890) 152 Mass. 101, 8 L. R. A. 640.

[57] Avery v. Meikle (1883) 81 Ky. 73.

Where the trade-mark itself, in whole or in part, has been appropriated, it is not necessary to a recovery in equity to prove fraud or an inferior quality of the article of the defendant. This principle is based on the ground that a trade-mark, when in use, is property itself.[58] It was the deficiency in the remedy at law that caused the courts of equity to take jurisdiction of this class of cases, and extend protection to this great right of property, in whose exercise the public are deeply interested, and in whose maintenance the commercial honor and trade integrity of the state are profoundly concerned.[59] It is apparent that the right to a trade-mark is one which can be tested only by its violation. So long as no one imitates the trade-mark, the proprietor has no means of testing its validity. It is only when a supposed piracy occurs that the questions of the validity of the trade-mark and the proprietor's exclusive right thereto can be determined. The right to a trade-mark is one which any person designating his wares and commodities by it has to prevent others from selling wares which are not his, but are marked with his mark.[60]

§ 20. Trade-mark of common-law origin.

The right of property in a trade-mark, being recognized by the common law, does not in any manner depend for its inceptive existence or support upon statutory law, although its exercise may be limited or controlled by statute. The right to adopt or use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been

[58] Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185; Avery v. Meikle (1883) 81 Ky. 73; Miller Tobacco Manufactory v. Commerce (1883) 45 N. J. Law 18.

[59] Avery v. Meikle (1883) 81 Ky. 72.

[60] Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314.

long recognized by the common-law and the chancery courts of England and of this country, and by the statutes of some of the states. It is a property right, for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not conferred by act of congress, and does not now depend upon statutes for its enforcement. The whole system of trade-mark property, and the civil remedies for its protection, existed long prior to any legislation by congress, and have remained in full force since such legislation.[61] Being a common-law right, it is limited only by the period of its use.[62] The right of property in a trade-mark is not limited in its enjoyment by territorial bounds, but may be asserted and maintained wherever the common law affords remedies for wrongs, subject only to such statutory regulations as may properly be made concerning the use and enjoyment of other property.[63] By the common law, every manufacturer, and every merchant for whom goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the markets for which he intends them, that he may thus secure the profits their superior repute as his may be the means of gaining.[64]

[61] Derringer v. Plate (1865) 29 Cal. 292; Trade-Mark Cases (1879) 100 U. S. 82; Reeder v. Brodt (1897) 6 Ohio Com. Pl. & Super. Dec. 248; Chadwick v. Covell (1890) 151 Mass. 190.

[62] Leidersdorf v. Flint (1878) 8 Biss. 327, Fed. Cas. No. 8,219.

[63] Derringer v. Plate (1865) 29 Cal. 292; Leidersdorf v. Flint (1878) 8 Biss. 327, Fed. Cas. No. 8,219; Bush v. Hanson (1888) 2 Can. Exch. 557; Kidd v. Johnson (1879) 100 U. S. 617.

[64] Smith v. Walker (1885) 57 Mich. 156.

§ 21. Statutory registration may limit common-law trade-mark.

While the trade-mark does not owe its origin to statutes, and exists entirely independent thereof, and infringements thereof may be redressed as a common-law right, it has been held, in a suit to restrain infringement of a common-law trade-mark, that the registry of the trade-mark under the act of congress of March 3, 1881, may be evidence to show what the complainant really claimed as his trade-mark,[65] and the time when use began,[66] and whether the trade-mark was personal, and hence whether it passed by insolvency proceedings.[67]

§ 22. Distinction between cases involving trade-marks, trade-names, and unfair competition.

It will be seen from the foregoing sections defining trade-marks, and pointing out their office and characteristics, that there are many things that have been loosely called "trade-marks" by the courts that are not properly so designated, and in many instances the courts have properly granted injunctions where no technical trade-marks were involved. A manufacturer or vendor may have no trade-mark, and yet may be entitled to restrain another from imitating the form, color, or general appearance of his labels, packages, or articles, the manner of arranging the directions, or other *indicia* thereon, or from in any way dressing up goods so as to cause them to be mistaken for his, or from resorting to any trick or artifice whereby another's goods are palmed off on

[65] Richter v. Reynolds (1893) 59 Fed. 577. See, also, Kohler Mfg. Co. v. Beeshore (1892) 53 Fed. 262.

[66] Kohler Mfg. Co. v. Beeshore (1893) 8 C. C. A. 215, 59 Fed. 572; Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444.

[67] Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 35 C. C. A. 496, 93 Fed. 624.

the public as his. Cases of this kind are not strictly trade-mark cases, and do not involve strict trade-mark rights.[68] They are cases of unfair competition in trade, and, being analogous to trade-mark cases, are treated under a separate chapter of this work.[69] Other analogous cases involve the names of places of business, or the names of individuals, firms, or corporations, not applied to commercial articles. These also are not strictly trade-mark cases, and they are treated under the chapter on trade-names. No sharp or distinct line can be drawn between these three classes of cases, and the facts and circumstances belonging to all may be found mingled in a single cause of action. The following may, however, be laid down as characteristics of a technical trade-mark: First, it must point distinctively, either by its own meaning or by association, to the origin or ownership of the article to which it is affixed; second, it must be affixed or applied to a commercial article; third, it must be of such nature that it can be rightfully appropriated by one person, to the exclusion of all others.[70] In many instances, the courts have restrained the use of words, marks, or devices not falling under these heads. In those instances, however, the complainant did not have a technical trade-mark, but the injunction issued for the purpose of restraining unfair or fraudulent competition, and such competition must have been shown in order to entitle the complainant to the injunction. Relief in such cases is granted only where the defendant, by his marks, signs, labels, or in other ways, rep-

[68] Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598; McLean v. Fleming (1877) 96 U. S. 245; Sawyer v. Horn (1880) 4 Hughes, 239, 1 Fed. 24; Perry v. Truefitt (1842) 6 Beav. 66; Croft v. Day (1843) 7 Beav. 84; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169.

[69] See chapter 10.

[70] Weener v. Brayton (1890) 152 Mass. 101; Schneider v. Williams (1888) 44 N. J. Eq. 391.

resents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacture, to the injury of the plaintiff.[71] But where a technical trade-mark right is involved, it is unnecessary to show fraud on the part of the defendant, or that he even knew of the complainant's trade-mark.[72]

§ 23. Underlying principle of cases involving trade-marks and unfair competition the same.

The underlying principle of cases of technical trade-marks and unfair competition is the same, namely, the prevention of that which, in its operation and results, and usually in intention, is a fraud upon the public, and an injury to the rival trader.[73] In Delaware & H. Canal Co. v. Clark, the United States supreme court said: "This will be manifest when it is considered that, in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief. This is the doctrine of all the authorities."[74] Fraud which lies at the foundation of the law of

[71] Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598.

[72] McLean v. Fleming (1877) 96 U. S. 245; Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369; Cady v. Schultz (1895) 19 R. I. 193; Miller Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; State v. Berlinsheimer (1895) 62 Mo. App. 168; Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185; Avery v. Meikle (1883) 81 Ky. 73; Messerole v. Tymberg (1868) 4 Abb. Pr. (N. S.; N. Y.) 410; Reviewed Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 374.

[73] Church v. Russ (1900) 99 Fed. 276.

[74] (1871) 13 Wall. (U. S.) 311-322.

trade-marks, as well as the law of unfair competition, may rest in actual intent, shown by the evidence, or may be inferred from the circumstances, or may be conclusively presumed from the act itself. In cases of unfair competition, the fraudulent intent must be shown by the evidence, or be inferable from the circumstances, while, in trade-mark cases, fraud will be presumed. If one person use another's trade-mark in connection with similar goods, and persists therein after being requested to desist, the fraud and imposition which constitute the essence of the injury will be presumed to exist, and relief will be granted without further proof. In strict trade-mark cases, a fraudulent intent to injure the complainant, or an actual misleading of the public, need not be proved, as it will be presumed. As said by the supreme court in a leading case: "The jurisdiction to restrain the use of a trade-mark rests upon the ground of the plaintiff's property in it, and of the defendant's unlawful use thereof. If the absolute right belonged to the plaintiff, then, if an infringement were clearly shown, the fraudulent intent would be inferred, and, if allowed to be rebutted in exemption of damages, the further violation of the right of property would nevertheless be restrained."[75]

§ 24. Comparison between cases of trade-marks and unfair competition.

In the case of C. F. Simmons Medicine Co. v. Mansfield Drug Co.[76] the supreme court of Tennessee has discussed these two classes of cases as follows: "It is only within recent years that a distinction has been taken in the authorities between this class of controversies (unfair com-

[75] Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537-548.

[76] (1893) 93 Tenn. 84, 23 S. W. 165.

petition) and technical trade-mark cases. In the earlier reported decisions, infringements of trade-marks and simulations of labels and packages are all intermingled under the general designation of 'trade-marks,' or treated as in substance the same thing, if not the same in exact definition. Latterly, however, especially in this country, the tendency has been to a narrowing of the use of the term 'trade-mark' to its proper signification, as an arbitrary symbol affixed by a manufacturer or merchant to a vendible commodity, and to exclude from use as such symbol words merely descriptive or generic, or merely expressive of quality, and also to exclude from designation as such labels, advertisements, signs, and the form, size, and general appearance of packages of merchandise. The new classification, while useful, seems to lack something of logical accuracy, inasmuch as the imitation of another's trade-mark, if intentional, and done with the purpose of pirating his trade thereby, is as truly an instance of unfair competition in business as any other fraudulent device adopted for that purpose, so that the effect is, in the main, only the attainment of a more correct and accurate use of the term 'trade-mark,' while the cases falling under the new classification are subject to most of the principles that govern technical trade-marks, but not to all. Moreover, the principles that are common to trade-mark law as thus narrowed, and to the subject of unfair competition in business, are also applicable to competition in other kinds of business besides the sale of articles of merchandise, leaving, however, a residuum of peculiar rules applicable only to technical trade-marks. The correspondences between the two classes of cases are more numerous than their differences. As in cases of trade-mark, so in cases of unfair competition in business, imposition upon the public is a necessary constituent of the plaintiff's title to sue, but only in the fact that

it is the test of the invasion of the plaintiff's rights by the defendant. As in one, so in the other, the object and purpose of the law is, 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, and, secondly, to protect the community from imposition. As in one, so in the other, the underlying principle is that one man is not to sell his own goods under pretense that they are the goods of another; and, as in one, so in the other, the violator of another's rights pirates upon the goodwill of that other's friends and customers, or the patrons of his trade and business, by sailing under his flag without his authority or consent. There is this difference, however: the law of trade-marks is designed to protect primarily a property right, and, as incidental thereto, gives redress for the injuries resulting from invasions of that right, a distinct, technical trade-mark being in itself evidence, when wrongfully used, of an illegal act, while the jurisdiction exercised over cases of unfair competition in business is grounded in the prevention of fraud. Fraudulent intention is not a necessary ingredient of a pure trade-mark case, as an invasion of another's trade-mark may be the result of accident or of a misunderstanding, although it may be and probably is true that in the majority of cases fraud is an element of trade-mark cases in awarding damages and costs."

CHAPTER II.

WHAT CAN BE APPROPRIATED.

§ 25. General Rule.
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27. Purpose for Which Mark Adopted may Determine Whether Valid Trade-Mark.
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49. Newly-Coined Words as Trade-Marks.
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51. Fanciful Names and Phrases as Trade-Marks.
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58. Names of Newspapers and Periodicals as Trade-Marks.
59. Descriptive or Geographical Words that have Acquired Secondary Meanings.

§ 25. General rule.

A common-law trade-mark may consist, with certain limitations, of any mark, symbol, device, or word, or any combination thereof, that is affixed to a commercial article, and used to indicate, primarily, the origin or ownership of such article.[1] The essential requisite of a trade-mark is that it shall indicate the origin or ownership of the article to which it is applied. Anything that is distinctive and will do this, and which others may not use with equal truth, may be appropriated. With the proviso, therefore, that the mark must indicate origin or ownership, either by its own meaning or by association with the article to which it is applied, and that the mark is not one that others may use with equal truth, there are few limitations as to what may be adopted as a trade-mark.[2]

[1] See chapter 1, § 1; Newman v. Alvord (1867) 49 Barb. (N. Y.) 588; Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Derringer v. Plate (1865) 29 Cal. 293; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Filley v. Fassett (1869) 44 Mo. 168; Gillott v. Esterbrook (1872) 48 N. Y. 374; Wolfe v. Barnett (1872) 24 La. Ann. 97; Godillott v. Hazard (1875) 49 How. Pr. (N. Y.) 5; Dunbar v. Glenn (1877) 42 Wis. 118; Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453; Gilman v. Hunnewell (1877) 122 Mass. 139.

[2] Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Potter v. McPherson (1880) 21 Hun (N. Y.) 559; Hier v. Abrahams (1880) 82

§ 26. Devices held to be trade-marks.

Thus it has been held that an octagonal, hollow, wooden stick, upon which carpets were rolled, so that the stick pre-

N. Y. 519; Morgan's Sons Co. v. Troxell (1881) 23 Hun (N. Y.) 632; Thornton v. Crowley (1881) 47 N. Y. Super. Ct. 527; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Avery v. Meikle (1883) 81 Ky. 73; Smith v. Walker (1885) 57 Mich. 456; Leidersdorf v. Flint (1878) 8 Biss. 327, Fed. Cas. No. 8,219; McLean v. Fleming (1877) 96 U. S. 245; Kidd v. Johnson (1879) 100 U. S. 617; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523; Hall v. Barrows (1863) 33 Law J. Ch. 204, 4 De Gex, J. & S. 150; Ainsworth v. Walmsley (1866) L. R. 1 Eq. 518; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Russia Cement Co. v. Le Page (1888) 147 Mass. 206; Clinton Metalic Paint Co. v. New York Metalic Paint Co. (1898) 23 Misc. Rep. 66; The Solis Cigar Co. v. Pozo (1891) 16 Colo. 388; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502, 26 S. W. 389; Munro v. Smith (1890) 55 Hun (N. Y.) 419; Lafean v. Weeks (1896) 177 Pa. 412; Dr. Jaeger's Co. v. Le Boutillier (1893) 5 Misc. Rep. 78, 24 N. Y. Supp. 890; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Metcalfe v. Brand (1887) 86 Ky. 331; Stokes v. Allen (1890) 56 Hun (N. Y.) 526.

"The 'trade-mark,' to be capable of an exclusive use, must be such as will identify the article to which it is affixed as that of the person naming it, and distinguish it from others." Phalon v. Wright (1864) 5 Phila. (Pa.) 464.

"Any name, symbol, letter, figure, or device adopted by the persons manufacturing or selling goods, and used and put upon such goods to distinguish them from those manufactured or sold by others, and employed so often and for such length of time as to raise the presumption that the public would know that it was used to indicate ownership of the goods in the person manufacturing or selling them, constitutes his trade-mark." Derringer v. Plate (1865) 29 Cal. 292.

A trade-mark may consist of words, but they must be specific and distinctive, and must point to the articles, and to nothing else. Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42.

"In all cases where names, signs, marks, labels, words, or devices of any kind can be advantageously used to designate the goods or property or particular place of business of a manufacturer or

sented, at the ends of the roll of carpet, the appearance of two octagonal wooden rings, constituted a valid trade-mark.[3] It has also been held by the English court of appeal that

a person engaged in trade, he may adopt and use such as he pleases, which are adapted to that end, and have not been before appropriated." Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314.

"Any contrivance, design, device, name, symbol, or other thing may be employed as a trade-mark, which is adapted to point out the true source and origin of the goods to which said mark is applied, or even to point out and designate a dealer's place of business, distinguishing it from the business locality of other dealers; but the mark must point out the source and origin of the goods, and not be merely descriptive of the style, quality, or character of the goods themselves; and the fact that the name of a trade-mark, with the combined device, are neither descriptions nor suggestive of the style, character, or qualities of the article manufactured, is one of their virtues as a trade-mark." Filley v. Fassett (1869) 44 Mo. 168.

"A manufacturer has the right to distinguish the goods manufactured by him by any peculiar mark or device he may select or adopt, by which they may be known as his in the market, and thereby secure to himself the profits arising from the fact that they are his manufacture, and he is entitled to the protection of a court of equity in the exclusive use of the peculiar marks or symbols appropriated by him, designating or indicating the true origin or ownership of the article to which they are affixed, against the adoption or imitation thereof by another so as to mislead the public as to such origin or ownership, and thus effect the sale of his goods as those of the party whose trade-mark is so adopted or imitated." Gilliott v. Esterbrook (1872) 48 N. Y. 374.

"A trade-mark may consist of a name, or a device, or a peculiar arrangement of words, lines, or figures in the form of a label, which has been adopted and used by a person in his business to designate goods of a particular kind manufactured by him, and which no other person has an equal right to use. The right in a trade-mark, so applied, is recognized as property, which a court of chancery will protect by injunction." Gilman v. Hunnewell (1877) 122 Mass. 139.

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[3] Lowell Mfg. Co. v. Larned (1873) Cox, Man. Trade-Mark Cas. No. 428, 15 Fed. Cas. No. 8,570.

a white selvage on each side of a piece of worsted goods, having a red and white mottled thread interwoven the full length of the selvage between the edge of the piece and the

"A trade-mark may consist of anything—marks, forms, symbols—which designate the true origin or ownership of the article. It cannot consist of anything which merely denotes the name or quality. There can be no right to the use of mere generic words." Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5.

"The law in relation to trade-marks has frequently been the subject of discussion in the courts; and it seems to be well settled that the owner of any original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that he may appropriate as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to appropriate a sign or mark which indicates the name or quality of the goods, and which others may employ with equal truth for the same purpose." Dunbar v. Glenn (1877) 42 Wis. 118.

"A trade-mark must, * * * as the terms import, be one consisting of a word, an expression, a device, or a mark, invented or adopted by the owner, which designates and distinguishes his production from the general manufacture of the same article, and it cannot be the appropriation of words belonging to the general public which describes truly a known product." Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. N. Y. 453.

"The law * * * will protect the party whose wares, commodities, or publications have become identified in the market under any appropriate symbol, words, phrases, or devices from the appropriation and use of them by other and competing dealers, in the same description of property." Potter v. McPherson (1880) 21 Hun (N. Y.) 559.

"Trade-marks are of two kinds. They may consist of pictures or symbols of a peculiar form and fashion of label, or simply of a word or words which, in whatever form printed or represented, continue to be the distinguishing mark of the manufacturer who has appropriated it or them, and the name by which his products are known and dealt in. This distinction is recognized in the statutes for the protection of trade-marks, as well as in the cases." Hier v. Abrahams (1880) 82 N. Y. 519.

"A trade-mark is not necessarily limited to a device or name, but may consist of any marks, forms, or symbols which serve to

edge of the selvage, constituted a valid trade-mark.[4] Similar devices have also been held by the French courts to con-

designate the true origin or ownership of the article." Morgan's Sons Co. v. Troxell (1881) 23 Hun (N. Y.) 632.

"The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used. Why not numerals united?" Shaw Stocking Co. v. Mack (1882) 12 Fed. 707.

"Fancy names, whether invented or arbitrary, the names of places, words, where applied to a new process by the inventor, the name of an article which alone designates its origin or ownership, letters and numerals combined in unusual and peculiar forms, or with other parts composing trade-marks, have been held, under the particular circumstances of the various cases, where their exclusive appropriation and use are in question, to be trade-marks or component elements thereof." Avery v. Meikle (1883) 81 Ky. 73.

In general, a man may adopt for a trade-mark whatever he chooses; but when he asserts and seeks to enforce exclusive right therein, it becomes necessary to ascertain whether it is just to others that this be permitted. If the name, device, or description is purely arbitrary or fanciful, and has been first brought into use by him, his right to the exclusive use of it is unquestionable. Smith v. Walker (1885) 57 Mich. 456.

"A person has the right to affix to his goods any device, symbol, or name which he may invent, to distinguish such goods from those made by other people. When the symbol becomes known, in connection with his name, it serves as a sign and pledge of the origin of his goods. People do not often stop to read all that may be printed on a label; nor do they always know the changes that are made in firms or business names. Hence it is that the right of a familiar symbol, inducing one to purchase goods to which the symbol does not properly belong, to the injury of him who devised it to mark his own goods, is the gravamen of the law of trade-marks." American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338.

A trade-mark may consist of a name, or a device, or a peculiar arrangement of words, lines, or figures, or, indeed, any peculiar mark or symbol, not theretofore in use, adopted and used by a manufacturer, or a merchant for whom goods may be manufactured,

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[4] Mitchell v. Henry (1880) 15 Ch. Div. 181.

stitute trade-marks.[5] In the case of Cook v. Starkweather,[6] it was said by the New York supreme court: "The package, case, or vessel in which the commodity is put, if prepared in a peculiar or novel manner, although in itself, perhaps, not a trade-mark, may very properly be a very important part of it; and where a peculiar device is applied to a box or barrel which has been especially prepared to receive and give prominence to the design, such specially prepared box or barrel constitutes a part of the trade-mark, and may participate in the protection which will be given to the trade-mark itself."

to designate them as those which he manufactures or sells. It may be put either upon the article itself, or its case, covering, or wrapper. Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51.

"A trade-mark has been defined to be a symbol, emblem, or mark which the tradesman puts upon or wraps or attaches in some way to the articles he manufactures, or causes to be manufactured, for the purpose of distinguishing them from the productions of other manufacturers." Munro v. Smith (1890) 55 Hun (N. Y.) 419.

"Any contrivance, design, device, name, or symbol may be used as a trade-mark for the purpose of pointing out the true source and origin of the goods to which it is affixed. Under some circumstances, the name of a place may be used as a trade-mark." Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53.

"A trade-mark may be a name adopted and used by a merchant or dealer in order to designate the goods that he sells, and distinguish them from those sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from the celebrity of his wares, or a reputation for superior skill, industry, or enterprise in handling the article put on the market. Any name may be so used that he may deem appropriate in designating the true origin or ownership of the article to which it is affixed, though he may not appropriate a name indicative of the quality of his goods which others may employ with equal truth for the same purpose." Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502, 26 S. W. 389.

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[5] Browne, Trade-Marks, § 268.

[6] (1872) 13 Abb. Pr. (N. S.; N. Y.) 392.

§ 27. Purpose for which mark adopted may determine whether valid trade-mark.

The purpose for which the mark is adopted may determine whether it is a valid trade-mark or not. The primary object in using a trade-mark must be to indicate origin or ownership. If the primary object in using the mark is to express grade, quality, or the kind or class to which the article belongs, it does not become a good trade-mark. A word or mark which, if used merely to designate one of several grades of a manufactured article, would not be subject to appropriation as a trade-mark because it then expressed grade or quality only, would be subject to such appropriation if used primarily to designate the origin or ownership of the article, instead of its grade or quality, because then it would be an arbitrary designation for the sake of distinction, and express origin primarily.[7]

§ 28. Test of trade-mark.

Hence, the same mark, if applied to one article, may be a valid trade-mark, and, if applied to another, even by the same manufacturer or producer, may be invalid. No exact statement of what a trade-mark may consist of can therefore made. The true test is, was the mark adopted, or has it come by use, to indicate primarily the origin or ownership of the article to which it is applied? Can others, with equal truth, use it for the same or a like article? If the first of these questions must be answered in the affirmative, and the second in the negative, and the mark is distinctive in its character, it is a valid trade-mark, no matter of what it may consist. While some confusion exists upon this point in the decided cases, and a few may be found that do not respond to

[7] Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331. See, also, Raymond v. Royal Baking Powder Co., 85 Fed. 236.

the test here laid down, it will be found that, in the majority of cases, the courts have sought to determine the question in accordance with the principles above stated. There are many cases, however, where injunctions have been granted, and the courts have applied the term "trade-mark" to some word involved which did not constitute a trade-mark, and where the injunction was, in fact, granted on grounds applicable solely to cases of unfair competition. A notable instance of this is the case of Newman v. Alvord,[8] in which the defendant was restrained from using the word "Akron" as applied to cement, and the court referred to this name, designating locality of origin, as a trade-mark, which it clearly was not. The decision of the court in the case was correct, but should have been based upon the ground of unfair competition on the part of the defendant in fraudulently using the term "Akron" for cement not produced at that place, and not on the ground that the plaintiff had a trade-mark right in the name "Akron."

§ 29. Trade-mark may secondarily denote grade or quality.

While a trade-mark must primarily indicate origin or ownership, it is no objection that the mark had originally, or has come to have, a secondary significance, denoting grade or quality.[9] The word "quality" is used in different senses in the cases. It is employed in some to denote the grade, ingredients, or properties of an article, and in others to indicate, generally, the merit or excellence of an article as associated with or coming from a certain source. While there

[8] (1867) 49 Barb. (N. Y.) 588. See Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Pillsbury-Washburn Flour Mills Co. v. Eagle (1897) 82 Fed. 816, reversed (1898) 30 C. C. A. 386, 86 Fed. 608.

[9] Burton v. Stratton (1882) 12 Fed. 696.

can be no valid trade-mark as denoting quality when used merely in the former sense, there may be a valid trade-mark as indicating quality when used in the latter sense.[10] A manufacturer or producer may use a certain trade-mark upon goods of the highest quality, and these goods may acquire a great reputation in the market. The trade-mark then not only indicates the origin or ownership of the goods, but it becomes, also, as said by the United States supreme court in Manhattan Medicine Co. v. Wood,[11] "both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture." A proprietor of trade-marks may also manufacture or sell several different grades or qualities of the same general kind of goods, and may adopt a separate mark for each quality or grade. If the primary function of each mark is to denote origin or ownership of the article with the proprietor, each mark will constitute a valid trade-mark, even though, as a secondary function, each mark distinguishes goods of the proprietor to which it is applied from other of his goods marked with other marks, or not marked at all.[12]

§ 30. Trade-mark may operate as assurance of quality.

It frequently happens that words used for the purposes of a trade-mark, and which, either in themselves as originally used, denote only origin or ownership, or which, by use, come, in the public mind, to indicate origin or ownership, though intrinsically denoting nothing of the kind, acquire finally a sort of adjective or descriptive significance in re-

[10] Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[11] (1883) 108 U. S. 218; Cahn v. Gottschalk (1888) 14 Daly (N. Y.) 542.

[12] American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Scott v. Standard Oil Co. (1894) 106 Ala. 475.

spect to the wares upon which they appear, and become an assurance that the commodity possesses certain virtues and qualities. But this is not because the words themselves are descriptive of the thing, but because they point to an origin or ownership known by experience to be the source of goods of certain qualities. The words do not describe the thing, but they indicate who made it. This knowledge of the maker involves an assurance of the quality, through the reputation which articles manufactured by him and put on the market under his mark have acquired. This reflex descriptive quality in words, which, dissociated from their use in connection with the article, are not descriptive of it at all, constitutes the chief value of trade-marks composed of them, both to the manufacturer or dealer and the public. Such words are not strictly descriptive, and that they, in this indirect way, show quality, is no objection to their employment in trade-marks, since their exclusive use by one would not deprive another of the full vocabulary of primarily descriptive words, to which the public are entitled, and to which these do not belong.[13]

§ 31. Classes of trade-marks.

Trade-marks were classified by Lord Romilly into personal and local.[14] Mr. Tudor suggests[15] as additional classes,—third, symbolical, as figures of animals, etc.; fourth, where a fancy name is used; and, fifth, where the claim is to a trade-mark compounded more or less of the others.[16] The proper division of trade-marks seems to be into (1) personal and (2) impersonal. Personal trade-marks are those which

[13] Scott v. Standard Oil Co. (1894) 106 Ala. 475.

[14] Hall v. Barrows (1863) 11 Wkly. Rep. 525.

[15] 2 Tudor, Lead. Cas. (2d Ed.) p. 573.

[16] Carmichel v. Latimer (1876) 11 R. I. 395.

indicate to the public that some particular person has given his special skill to the production or selection of the articles to which they are applied.[17] Impersonal trade-marks, even when they consist, in whole or in part, of the name of the manufacturer, do not indicate that the goods are the product of his personal skill, but rather point to him as the owner or proprietor of the manufactory or business in which they are produced, or through which they are put on the market. A trade-mark that is originally personal, and indicates that the article to which it is applied is the product of a particular person, may, by usage, come to indicate simply that the article is the product of a manufactory with which the person whose name appears in the mark was originally connected.[18] Many trade-marks which are personal in form have been held by the courts to be merely impersonal marks, transferable with a business, and usable in their original form by a successor in business. Examples of these are found in "Dr. C. McLane's Liver Pills";[19] "S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio";[20] "Dr. J. Blackman's Genuine Healing Balsam";[21] "Oakes' Candies";[22] "A. N. Hoxie's Pumice Soap"; "A. N. Hoxie's Mineral Soap";[23] "Collins & Co."[24]

[17] Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523-544; Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369; Hill v. Lockwood (1887) 32 Fed. 389-393; Davis v. Kendall (1850) 2 R. I. 566.

[18] Oakes v. Tonsmierre (1883) 4 Woods, 547; Atlantic Milling Co. v. Robinson (1884) 20 Fed. 217.

[19] McLean v. Fleming (1877) 96 U. S. 245.

[20] Kidd v. Johnson (1879) 100 U. S. 617.

[21] Filkins v. Blackman (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786.

[22] Oakes v. Tonsmierre (1883) 49 Fed. 447.

[23] Chaney v. Hoxie (1887) 143 Mass. 592.

[24] Collins Co. v. Oliver Ames & Sons Corp. (1882) 18 Fed. 561.

§ 32. Characteristics of local trade-marks.

Some impersonal trade-marks are originally strictly local, or become so by usage, and indicate origin at a certain place of production, or manufactory, without reference to the owner or proprietor thereof. Such trade-marks, as already pointed out, pass, whether specifically mentioned or not, with a transfer of the manufactory or place of production. They are inseparable from the manufactory or place of production. Instances of such purely local trade-marks are found in the names "Congress Water" and "Bethesda Water," applied to the waters from certain springs;[25] "Old Oscar Pepper Distillery," applied to the whiskey produced at a certain distillery;[26] "M. C.," applied to tin plates produced at a certain manufactory;[27] "Stillman Mill," applied to woolens manufactured at a certain mill.[28] In these cases, a person acquiring the original manufactory or place of production is entitled to the trade-mark, although he has no derivative title from the original proprietor, and has not succeeded to the business in which the trade-mark originated and acquired its value. A trade-mark of this kind becomes so identified with the place or establishment where the article to which it is applied is produced as to designate or characterize the article as the production of that place or establishment, rather than of the proprietor. A trade-mark of this description is of no value to the original proprietor after he parts with his ownership of the original manufactory or place of production, because he could not use it without deception, and therefore would not be protected in its exclusive

[25] Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 10 Abb. Pr. (N. S.; N. Y.) 348; Dunbar v. Glenn (1877) 42 Wis. 118.

[26] Pepper v. Labrot (1881) 8 Fed. 29.

[27] Motley v. Downman (1837) 3 Mylne & C. 1.

[28] Carmichel v. Latimer (1876) 11 R. I. 395.

enjoyment. Such a trade-mark is an incident to the business of the place or establishment to which it owes its origin, and without which it can have no independent existence.[29]

§ 33. Majority of trade-marks impersonal.

The great majority of trade-marks are impersonal, but not local. They indicate origin or ownership of the articles to which they are applied with a certain business establishment, and, whether personal or impersonal in form, they constitute a part of the goodwill and assets of the business, and pass as an incident of the business to any successor to the original proprietor.

§ 34. Words in common use as trade-marks.

In Delaware & H. Canal Co. v. Clark,[30] Mr. Justice Strong, in stating what may be appropriated as a trade-mark, says: "Words in common use, with some exceptions, may be adopted, if, at the time of their adoption, they were not employed to designate the same or like articles of production;" and in McLean v. Fleming,[31] Mr. Justice Clifford states the rule as follows: "Phrases or even words in common use may be adopted for the purpose, if, at the time of their adoption, they were not employed by another to designate the same or similar articles of production or sale." The exceptions to the adoption of words in common use as trade-marks are also stated by Justice Strong in the case of Delaware & H. Canal Co. v. Clark. His language upon this point is as follows: "But though it is not necessary that the word adopted as a trade-mark should be a new creation, never before

[29] See, also, Glenn & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226; Atlantic Milling Co. v. Robinson (1884) 20 Fed. 217, 218; In re Swezey (1881) 62 How. Pr. (N. Y.) 215-219.

[30] (1871) 13 Wall. (U. S.) 311.

[31] (1878) 96 U. S. 245.

known or used, there are some limits to the right of selection. This will be manifest when it is considered that in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief." These rules have been repeated by the supreme court of the United States in a number of later decisions, notably Columbia Mill Co. v. Alcorn,[32] and they have been applied in many instances by the lower federal and the state courts of this country.[33]

§ 35. General rule as to common words.

From these decisions we are able to deduce a general rule as to the appropriation of words in common use, as follows: Words in common use may be appropriated as trade-marks if they are adopted originally, or by usage have come, to indicate primarily the origin or ownership of a commercial article to which they are applied, and if they are not geographical, in the sense of being the names of localities of production, or not the generic name of the article, or merely descriptive of it, or of its qualities, ingredients, or character-

[32] (1893) 150 U. S. 460; McLean v. Fleming (1877) 96 U. S. 245; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598; Corbin v. Gould (1890) 133 U. S. 308; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540.

[33] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Koehler v. Sanders (1890) 122 N. Y. 65; Burton v. Stratton (1882) 12 Fed. 696; Roberts v. Sheldon (1879) 8 Biss. 398, Fed. Cas. No. 11,916; Le Clanche Battery Co. v. Western Electric Co. (1885) 23 Fed. 276; Alleghany Fertilizer Co. v. Woodside (1871) 1 Hughes. 115, Fed. Cas. No. 206.

istics. Another well-recognized rule is that a trade-mark must not be deceptive. Hence, common words, when employed as trade-marks, must not give a false impression as to the qualities, ingredients, or characteristics of the article. In numerous instances, claimants of trade-marks, consisting of words in common use, when met with the objection that the words were descriptive, have attempted to show that the articles did not contain the ingredients or possess the qualities attributed to them by the words employed, and have had their marks held invalid by the courts on the ground that they were deceptive. Subject to the limitations pointed out, words in common use may be appropriated as trade-marks, and the exclusive right to their use, for the specific articles to which they are applied, may be maintained.

§ 36. Instances of common words as trade-marks.

The following are instances of common words that have been held valid trade-marks under applications of the rules above stated: The word "Eureka," for fertilizers,[34] and also for a steam packing;[35] "Congress," for water from a certain spring;[36] "Mottled German," in connection with a circle having a moon and several stars within it, for soap;[37] "Warren Hose Supporter," in connection with a cut of a hose supporter engaged with a stocking, for a hose supporter;[38] "Excelsior," for ranges;[39] "Bismarck," for paper col-

[34] Alleghany Fertilizer Co. v. Woodside (1871) 1 Hughes, 115. Fed. Cas. No. 206.

[35] Symonds v. Greene (1886) 28 Fed. 834.

[36] Spring Co. v. Spring Co. (1871) 4 Brewst. (Pa.) 398.

[37] Proctor v. McBride (1875) Cox, Man. Trade-Mark Cas. No. 657, Fed. Cas. No. 11,441.

[38] Frost v. Rindskopf (1890) 42 Fed. 408.

[39] Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

lars;[40] "Pain-Killer," for a medical compound;[41] "Sunlight," for soap;[42] "Kaiser," for beer;[43] "Anti-Washboard," for soap;[44] "Twin Brothers," for yeast;[45] "Parabola," for needles;[46] "Grenade Syrup," for syrup made from pomegranates;[47] "National System of Penmanship," for copy books;[48] "Pride," for cigars;[49] "Magnetic Balm," for a medical compound;[50] "Hoosier," for grain drills;[51] "Sliced Animals," "Sliced Birds," and "Sliced Objects," for games or puzzles;[52] "Cough Cherries," for a confection;[53] "Lightning," for hay knives;[54] "Cream," for baking powder;[55] "Home," for sewing machines;[56] "Star," and a symbol of a star, for shirts, waists, underwear, and furnishing goods;[57] "Fibre Chamois," for a dress-lining fabric;[58] "Royal," for baking powder;[59]

[40] Merserole v. Tynberg (1868) 36 How. Pr. (N. Y.) 14.

[41] Davis v. Kendall (1850) 2 R. I. 566.

[42] Lever Bros. v. Pasfield (1898) 88 Fed. 484.

[43] J. & P. Baltz Brewing Co. v. Kaiserbrauerie, Beck & Co. (1896) [illegible] A. 402, 74 Fed. 222.

[44] O'Rourke v. Central City Soap Co. (1885) 26 Fed. 576.

[45] Burton v. Stratton (1882) 12 Fed. 696.

[46] Roberts v. Sheldon (1879) 8 Biss. 398, Fed. Cas. No. 11,916.

[47] Rillett v. Carlier (1870) 11 Abb. Pr. (N. S.; N. Y.) 136.

[48] Potter v. McPherson (1880) 21 Hun (N. Y.) 559.

[49] Hier v. Abrahams (1880) 82 N. Y. 519.

[50] Smith v. Sixbury (1881) 25 Hun (N. Y.) 232.

[51] Julian v. Hoosier Drill Co. (1881) 78 Ind. 408.

[52] Selchow v. Baker (1882) 64 How. Pr. (N. Y.) 212.

[53] Stoughton v. Woodard (1889) 39 Fed. 902.

[54] Hiram Holt Co. v. Wadsworth (1889) 41 Fed. 34.

[55] Price Baking Powder Co. v. Fyfe (1891) 45 Fed. 799.

[56] New Home Sewing Machine Co. v. Bloomingdale (1893) 59 Fed. 284.

[57] Hutchinson v. Blumberg (1892) 51 Fed. 829.

[58] American Fibre Chamois Co. v. De Lee (1895) 67 Fed. 329.

[59] Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376; Raymond v. Royal Baking Powder Co. (1898) 29 C. C. A. 245, 85 Fed. 231.

"Swan Down," for a complexion powder;[60] "Ideal," for fountain pens;[61] "Maryland Club," for whiskey;[62] "Sleuth" or "Old Sleuth," for publications;[63] "The Akron Dental Rubber," for dental articles;[64] "Champion," for flour;[65] "Genuine Yankee" and "Yankee," for soap;[66] "Marvel," for flour;[67] "Established 1780," for drugs;[68] "Old Crow," for whiskey.[69]

§ 37. Application of word to article must be arbitrary or fanciful.

In all of these cases, the application of the word to the article has been held to be arbitrary or fanciful, and not descriptive. It is to be noted that a word may be a valid trade-mark, even though it be suggestive of the qualities or characteristics of the article, or of the advantages supposed to arise from its use. In Roberts v. Sheldon,[70] Judge Blodgett says: "It is frequently the case that, by close analysis and ingenuity, you can find in almost any trade-mark a designation of some quality connected with the goods." In O'Rourke v. Central City Soap Co.,[71] Judge Brown says: "There is, however, a class of words which, though not de-

[60] Tetlow v. Tappan (1898) 85 Fed. 774.

[61] Waterman v. Shipman (1891) 130 N. Y. 301.

[62] Cahn v. Gottschalk (1888) 14 Daly (N. Y.) 542.

[63] Munro v. Beadle (1899) 55 Hun (N. Y.) 312; Munro v. Tousey (1891) 129 N. Y. 38.

[64] Keller v. B. F. Goodrich Co. (1888) 117 Ind. 556.

[65] Atlantic Milling Co. v. Robinson (1884) 20 Fed. 217.

[66] Williams v. Johnson (1857) 2 Bosw. (N. Y.) 1; Williams v. Spence (1863) 25 How. Pr. (N. Y.) 366; Williams v. Adams (1879) 8 Biss. 452, Fed. Cas. No. 17,711.

[67] Listman Mill Co. v. Listman Milling Co. (1894) 88 Wis. 334.

[68] Hazard v. Caswell (1878) 57 How. Pr. (N. Y.) 1.

[69] Gaines v. Leslie (1898) 25 Misc. Rep. (N. Y.) 20.

[70] (1879) 8 Biss. 398, Fed. Cas. No. 11,916.

[71] (1885) 26 Fed. 576.

scriptive of the article, are suggestive of some supposed advantage to be derived from using it, or some effect produced by its use. These have been ordinarily, though not always, upheld as valid trade-marks."

§ 38. Word may be valid trade-mark, although article has acquired wide sale, and mark becomes indicative of quality.

Nor is a word to be held invalid as a trade-mark because the article to which it is applied has attained such widespread sale that the mark has also become indicative of quality. If the primary object of the trade-mark be to indicate ownership, the mark does not become the common property of the trade, nor is the owner debarred from protection merely because the sale of the article under the mark has been so great and so widespread that the mark has also become indicative of quality.

§ 39. Word may be valid trade-mark, although it has become ordinary appellation of article.

Nor is a word invalid as a trade-mark because it has become so generally known in connection with the article that it has been adopted as the ordinary appellation of the article. In Selchow v. Baker,[72] Judge Rapallo, in pronouncing the decision of the New York court of appeals, says: "It cannot be true, as a general proposition, as contended on the part of the defendants, that, when a manufacturer has given to his products a new name invented by himself for the purpose of distinguishing them as his, and the article becomes generally known to the trade and to the public by that name, the name becomes public property, and every one has a right to use it. That proposition can be sustained only in respect

[72] (1883) 93 N. Y. 59.

to names which are descriptive of the article, and incapable of being appropriated as trade-marks. The value of a trade-mark consists in its becoming known to the trade as the mark of the manufacturer who has invented or adopted it, and in being known to the public as the name of an article which has met with popular favor. It cannot be that the very circumstances which give it value operate at the same time to destroy it." In Celluloid Mfg. Co. v. Cellonite Mfg. Co.,[73] Mr. Justice Bradley quotes with approval from Selchow v. Baker, and says: "When the word ["celluloid"] was coined and adopted, it was clearly a good trade-mark. The question is whether the subsequent use of it by the public as a common appellative of the substance manufactured can take away the complainant's right. It seems to me that it cannot." The last case cited involved a newly-coined word, but the rule must be the same as to a word in common use. If the word was a good trade-mark when adopted, it remains a good trade-mark, no matter how extensively used, and even if it has acquired, by such extensive use, a secondary descriptive meaning, unless the owner, by his conduct, has lost his exclusive right thereto. If the word was merely descriptive when adopted, subsequent use cannot make it a valid trade-mark unless, by such use, it has acquired a predominating secondary meaning, in connection with the particular article on which it is used, that causes it to indicate origin or ownership, rather than the qualities or characteristics of the article.[74]

§ 40. Trade-mark may consist of common words, combined with other features.

A combination of common words, not in themselves the

[73] (1887) 32 Fed. 94.
[74] Schendel v. Silver (1892) 63 Hun (N. Y.) 330.

subject of appropriation as a trade-mark, with other distinctive features or devices, may be adopted as a trade-mark, and the proprietor thereof will be entitled to protection against such an imitation as will deceive the public, and cause it to purchase goods bearing the simulated mark, in the belief that they are the goods of the original proprietor. It is immaterial that no one feature of the trade-mark is in itself distinctive or capable of appropriation. In such instance it is the combination or arrangement of words or devices, or words and devices, that constitutes the trade-mark.[75]

[75] "The words which compose a trade-mark need not each be new. If the combination thereof be new and be descriptive of the origin of the goods and their ownership by the manufacturer who devises the mark, it will be unlawful for any other person to filch the combination, or any important part thereof." Wolfe v. Barnett (1872) 24 La. Ann. 97.

"A combination of words and figures or symbols may constitute a trade-mark, although some or each of the parts, standing alone, would not do so, and could be used without infringement; and in such a case it is the entire combination and setting which makes the trade-mark." Clinton Metalic Paint Co. v. New York Metalic Paint Co. (1898) 23 Misc. Rep. (N. Y.) 66.

"A trade-mark may consist of a name, a device, or a peculiar arrangement of words, or of words with some device of greater or less novelty. Words and devices of common use in a particular trade, as 'Fabrica Tabacos' in the tobacco trade, are not of themselves the subject of a trade-mark, but, used in connection with other words or devices, the whole may constitute a valid trade-mark, which will be entitled to legal protection as property." Solis Cigar Co. v. Pozo (1891) 16 Colo. 388.

"Where words and names are in common use, no one person can claim a special appropriation of them to his peculiar use; but where words and the allocation of words have, by long use, become known as designating the article of a particular manufacturer, he acquires a right to them, as a trade-mark, which competing dealers cannot fraudulently invade. The essence of the wrong is the false representation and deceit. When the improper design is apparent, an injunction should be issued. In such cases, injunctions have been sustained, though the name of the place, or of a celebrated person,

§ 41. Personal names as trade-marks.

There is considerable conflict in the decisions of the courts upon the question whether a personal name may be used as a trade-mark. Some of the courts have held that it can; others that it cannot. A personal name does not respond to the tests for a technical trade-mark, for the reason that no one can have the exclusive right to such a name against another person having the same name, and using it in good faith; but there would seem to be no reason against appropriating a trade-mark consisting of a personal name used in some peculiar or distinctive design or form. In this instance, any one would have a right to use the name, in good faith, in any form except that already appropriated.

In Ainsworth v. Walmsley,[76] Vice-Chancellor Wood said: "Is not a man's name as strong an instance of trade-mark as can be suggested? subject only to this inconvenience: that, if a Mr. Jones or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name."

were within the trade-mark protected by the injunction." Lea v. Wolff (1873) 1 Thomp. & C. (N. Y.) 626, 15 Abb. Pr. (N. S.; N. Y.) 1, 46 How. Pr. (N. Y.) 157.

When a commercial name, not the subject of appropriation as a trade-mark, is combined with other distinctive features, including the manufacturer's name, the whole may be adopted by him as a trade-mark, and he will be entitled to protection against such a fraudulent imitation of his wrappers and labels, bearing such trade-mark, as will enable the defendants to deceive the public and injure his business. Hence, when plaintiff adopted a trade-mark consisting, as a whole, of printed copies of the medals awarded him by the United States Centennial Commission, in 1876, and the French Republic at the Exposition Universelle Nationale, held at Paris in 1878, with the words "Dreydoppel's Borax Soap" printed underneath, and used it upon his wrappers and labels, he is entitled to the exclusive use of such trade-mark, and to protection against infringement of it. Dreydoppel v. Young (1880) 14 Phila. (Pa.) 226.

[76] (1866) L. R. 1 Eq. 518.

In Dunnachie v. Young,[77] Lord Craighill said: "The name of a person may be a trade-mark; but there may be other manufacturers of goods of the same description, and the latter are not precluded from placing their own names on their own goods by reason of the fact that this name has already become the trade-mark of another manufacturer. The only condition they must fulfill is that the name as used by them shall be accompanied by something which shall be a distinction, if the bare name would lead to the deception of the public, and the injury of the trader on whose goods the name first appeared as a trade-mark."

In El Modello Cigar Mfg. Co. v. Gato,[78] Mitchell, J., said: "It is now well established that a man may acquire the right of a trade-mark in his own name, or in the name of any person, but a man cannot acquire the right of a trade-mark in the use of his own name, to the exclusion of the right of another person by the same name, and whose place of business is in the same place."

In Hegeman v. Hegeman,[79] it is said: "It [a trade-mark] may exist where the name of the article and of the proprietor are so blended together that the right to the use of the name is indispensable to the use of the trade-mark, or may consist of the name alone of the manufacturer or proprietor."

In McLean v. Fleming,[80] Justice Clifford said: "It is doubtless correct to say that a person may have a right in his own name as a trade-mark as against a trader or dealer of a

[77] (1883) 10 Scot. Ct. Sess. Cas. (4th Ser.) 874.

[78] (1890) 25 Fla. 886, 6 L. R. A. 823.

[79] (1880) 8 Daly (N. Y.) 1.

[80] (1877) 96 U. S. 245. See, also, Burke v. Cassin (1873) 45 Cal. 467; Meneely v. Meneely (1875) 62 N. Y. 427; Wedgwood v. Smith (1848) Cox, Man. Trade-Mark Cas. No. 96.

In 26 Am. & Eng. Enc. Law (1st Ed.) 260, it is said: "The name of an inventor or maker is the best guaranty of the genuineness of the goods which bear the name, and will, as a general rule, be

different name; but the better opinion is that such a party is not, in general, entitled to the exclusive use of a name, merely as such, without more."

While these authorities would seem sufficient to establish the rule that a personal name may be a trade-mark as against

protected as an exclusive trade-mark if used in a way which is free from misrepresentation or fraud."

In Williams v. Farrand (1891) 88 Mich. 473, it was held that a surname may become impersonal when it is attached to an article of manufacture, and becomes the name by which such article is known in the market, and the right to use the name may, in consequence, follow a grant of the right to manufacture that article, or a sale of the business of manufacturing such article; and where the right to manufacture is exclusive, the right to the use of the name as applied to that article becomes likewise exclusive.

The following excerpts from judicial decisions are in point:

"A surname may become impersonal when it is attached to an article of manufacture, and becomes the name by which such article is known in the market." Vonderbank v. Schmidt (1892) 44 La. Ann. 264.

"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." Carmichel v. Latimer (1877) 11 R. I. 395.

"But the right of a corporation to the use of its name can be no greater or different in principle than that of an individual, and, although an individual may acquire the right to use his name as a trade-mark, he may be enjoined from doing so if some other person, having the same name, has previously acquired the right to use it as a trade-mark upon his goods." Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 137 Ill. 231.

"A trade-mark may, and often does, consist in the name of a person or partnership firm, and the exclusive use of such trade-mark is upheld, with this limitation: that another person of the same name is not to be prevented from using his name in the same way, provided there are no special circumstances which make it inequitable for him to do so." Skinner v. Oakes (1881) 10 Mo. App. 45.

"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 fingerboard,—should indicate the

any person of a different name, it will be found, upon examination, that each case would, under the later authorities, be regarded as a case of unfair competition, rather than one involving a technical trade-mark, and the correct rule seems to be that a personal name alone cannot constitute a technical trade-mark, though it may serve as the basis of an action to prevent unfair competition.

§ 42. A person cannot made a trade-mark of his own name, and debar another, having the same name, from using it.

Whether a person may make a trade-mark of his own name or not, as against a person having a different name, it is clear that he cannot, as against another person of the same name, so as to prevent him from using it in his business, if he does so honestly, and without any intention to appropriate wrongfully the goodwill of a business already established by others of the name. Every one has the absolute right to use his own name honestly in his own business for the purpose of advertising it, even though he may thereby incidentally interfere with and injure the business of another having the same name and address of the manufacturer,—to invest it with the attributes, and entitle it to the protection, of a trade-mark." Ferguson v. Davol Mills (1868) 2 Brewst (Pa.) 314.

"The name of the manufacturer or seller of goods may be used as a trade-mark, and the adoption of the same name as a trade-mark for goods of the same kind, by a person of a different name, is 'piracy of a trade-mark.'" Burke v. Cassin (1873) 45 Cal. 467.

"The name of a manufacturer, or a system of numbers adopted and used by him in order to designate goods of his make, may be the subject of the same protection in equity as an ordinary trade-mark." Ainsworth v. Walmsley (1866) L. R. 1 Eq. 518.

A person cannot have a right to his own name as a trade-mark, "as against another person of the same name, unless the defendant uses a form of stamp or label so like that used by the plaintiff as to represent that the defendant's goods are of the plaintiff's manufacture." Gilman v. Hunnewell (1877) 122 Mass. 139.

name. In such case, the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But although a person may thus use his name, he cannot resort to any artifice or do any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name.[81]

[81] Russia Cement Co. v. Le Page (1888) 147 Mass. 206, 17 N. E. 304; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540-542; Meneely v. Meneely (1875) 62 N. Y. 427; Holloway v. Holloway (1850) 13 Beav. 209; Gilman v. Hunnewell (1877) 122 Mass. 139; Rogers v. Rogers (1885) 53 Conn. 121; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 137 Ill. 231; Turton v. Turton (1888) 42 Ch. Div. 128; Robinson v. Storm (1899) 103 Tenn. 40; William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co. (1882) 11 Fed. 495; Faber v. Faber (1867) 49 Barb. (N. Y.) 357; Carmichel v. Latimer (1877) 11 R. I. 395; William Rogers Mfg. Co. v. Simpson (1887) 54 Conn. 527; Cutter v. Gudebrod Bros. Co. (1899) 36 App. Div. (N. Y.) 362; Elgin Butter Co. v. Elgin Creamery Co. (1895) 155 Ill. 127-137; Rock Springs Distillery Co. v. Monarch (1893) 15 Ky. Law Rep. 866, 22 S. W. 1028; Monarch v. Rosenfeld (1897) 19 Ky. Law Rep. 14, 39 S. W. 236; De Long v. De Long Hook & Eye Co. (1895) 89 Hun (N. Y.) 399; N. K. Fairbank Co. v. Swift & Co. (1896) 64 Ill. App. 477; De Youngs v. Jung (1893) 25 N. Y. Supp. 479; Decker v. Decker (1876) 52 How. Pr. (N. Y.) 218.

"A man may use his own name, because he cannot truthfully do business under any other, and the law protects that right ordinarily, even when such use is injurious to another who has established a prior business of the same kind, and gained a reputation which goes with the name. Even then the courts require that the name shall be honestly used [by him], and will permit no deceit calculated to mislead the public into purchasing his goods under the belief that they are the manufacture of another." De Long v. De Long Hook & Eye Co. (1895) 89 Hun (N. Y.) 399.

"No person is bound to accept his patronymic as a surname, and he may engage in business under whatever name he sees fit, provided, however, that the assumption of any particular name for such purposes is unaccompanied by design to perpetrate a fraud upon others. If so, the use of the assumed name should be restrained.

§ 43. Second user may be restrained when fraud appears.

Where two persons have the same name, and use it to distinguish an article or commodity produced by them of like

* * * The use of a person's patronymic or other properly acquired name under circumstances which are calculated to deceive the public, and to convey the impression that the business products of the one sought to be restrained are those of another of the same name, who, by the use of such name in connection with particular devices which have been appropriated by the former, has acquired a trade-mark therein, may be restrained." De Youngs v. Jung (1893) 25 N. Y. Supp. 479.

"A defendant will not be restrained by injunction from the use of his own name, which he has caused to be registered and recorded as a trade-mark in the patent office, on motion of a plaintiff by the same name, and engaged in the same business, unless it plainly appears that it was obtained for the purpose of deception, or with a view to mislead the public or injure the plaintiff." Decker v. Decker (1876) 52 How. Pr. (N. Y.) 218.

"It would seem that the same rule should apply to corporations in this regard that obtains in respect to natural persons, and, in the absence of any fraudulent or wrongful intention or act, or any contract to prohibit it, every natural person has the absolute right to use his own name in his own business." Elgin Butter Co. v. Elgin Creamery Co. (1895) 155 Ill. 127.

"A man may not use his own name for the purpose of deception, and such fraudulent use will be enjoined. Fair competition in business is legitimate, and promotes the public good, but an unfair appropriation of another's business by using his name or trademark, or an imitation thereof, calculated to deceive the public, is not permissible, and will be enjoined by a court of equity." N. K. Fairbank Co. v. Swift & Co. (1896) 64 Ill. App. 477.

"An examination of the * * * cases wherein the use of a person's name has been regulated will show that, in most instances, conscious, intentional fraudulent misrepresentation on the part of the defendant has been resorted to. In others, there was such a combined use of the name with other marks, characters, figures, or form and arrangement of circulars, advertisements, etc., as to amount to a false representation, and the combination only was enjoined. No instance can be found where the use of the name only in good faith has been stopped." Rogers v. Rogers (1885) 53 Conn. 121.

"Upon the other hand, there has been, from the first to the pres-

character, and it is clearly shown that the later user does so for the purpose of imposing his own article upon purchasers for the prior user's article, which has become known and well established, it is, on the part of the later user, alike an imposition upon the public and an attempt to secure to himself, by this dishonest means, what rightfully belongs to another, and he will be restrained from so using his own name.[82]

ent time, a general consensus of judicial opinion that the use of a personal name in a fair, honest, and ordinary business manner could not be prevented even if damage resulted therefrom." Rogers v. Rogers (1885) 53 Conn. 121.

"A manufacturer has the right to use his own name as a mark upon his goods, although it be the same name with that of another manufacturer of the same goods, who makes the name a part of his own trade-mark, where there is no false representation in such use." Rogers v. Rogers (1885) 53 Conn. 121.

[82] England v. New York Pub. Co. (1878) 8 Daly (N. Y.) 375; William Rogers Mfg. Co. v. R. W. Rogers Co. (1895) 66 Fed. 56; Arnheim v. Arnheim (1899) 28 Misc. Rep. (N. Y.) 399; Allegretti v. Allegretti Chocolate Cream Co. (1898) 177 Ill. 129; Young Women's Christian Ass'n v. International Committee, Y. W. C. A. (1900) 86 Ill. App. 607; Penberthy Injector Co. v. Lee (1899) 120 Mich. 174, 78 N. W. 1074.

"A man, and no less a corporation, may not be entirely prohibited from using his or its proper name in any lawful business or occupation, but he [or it] may properly be restrained from so using it [such name] in such a manner as to perpetrate a fraud upon the public, and an injury to another of the same name." Young Women's Christian Ass'n v. International Committee, Y. W. C. A. (1900) 86 Ill. App. 607.

Where two parties have the same name, and use it as a trademark to distinguish an article or commodity produced by them of like character, and it is clearly shown from the facts that the later user does so for the purpose of imposing his own articles upon purchasers for the prior user's article, which has become known and well established, it is, on the part of the later user, alike an imposition upon the public, and an attempt to secure to himself, by this dishonest means, what rightfully belongs to another, and he will be restrained thereafter from so using his own name. England v. New York Pub. Co. (1878) 8 Daly (N. Y.) 375.

"A person may legally name himself, or change his name, or ac-

§ 44. Rule does not apply to corporations.

"Although the use of a personal name as a trade-mark will not be protected against its use in good faith by a defendant who has the same name, the reason of the rule ceases, and the rule no longer applies, where the defendant, as in case of a corporation, selects its own name, especially where it appears that such name is selected with an intention to mislead."[83]

§ 45. Personal name protected only when it truthfully indicates origin or ownership.

In order that a manufacturer or vendor may be protected in the use of a personal name, used on a commercial article, whether it be considered a technical trade-mark or not, it is necessary that such name indicate origin or ownership of such article, and this must be truthfully done.[84]

§ 46. Court of equity will direct and control the use of a personal name.

A court of equity will direct and control the use of a man's

quire a name by reputation, general usage, and habit." England v. New York Pub. Co. (1878) 8 Daly (N. Y.) 375.

"No person can, merely by adoption or use, acquire an exclusive right to the use of the name of another. 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." Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 40 Ill. App. 430.

[83] William Rogers Mfg. Co. v. R. W. Rogers Co. (1895) 66 Fed. 56.

[84] "But the primary function of a trade-mark is to indicate ownership and origin, and, unless this is truthfully done, it becomes a means of fraud upon the public, and will not be protected; and if a trade-mark is a personal one, designating a particular person, and his reputation and skill, it cannot truthfully be used by any other person, and consequently cannot be assigned." Mayer v. Flanagan (1896) 12 Tex. Civ. App. 405, 34 S. W. 785.

name, either by himself or by himself associated with others, in his or their business, so it shall not be used to work an injury to the business of another person having the same name, or to perpetrate an imposition or a fraud upon the public.[85]

§ 47. Instances of personal names as parts of trade-marks.

The following are a few instances of trade-marks involving personal names that have been recognized as valid by the courts: "Roger Williams' Long Cloth";[86] "Dr. J. M. Lindsey's Improved Blood Searcher";[87] "Oakes' Candies";[88] "Dr. McLane's Liver Pills";[89] "Taylor's Persian Thread";[90] "Ainsworth's Thread";[91] "Storm's Liver Regulator";[92] the name and portrait of Dr. Richmond.[93]

§ 48. Names of places of business as trade-marks.

The name of a place of business may constitute a valid trade-mark if it is applied or affixed to a commercial article for the purpose of indicating the origin or ownership of such article. It is not a trade-mark unless it is thus applied or affixed to a commercial article for the purpose stated. It

[85] Allegretti Chocolate Cream Co. v. Rubel (1900) 86 Ill. App. 600; Rubel v. Allegretti Chocolate Cream Co. (1898) 76 Ill. App. 581; Allegretti v. Allegretti Chocolate Cream Co. (1898) 177 Ill. App. 129; Allegretti Chocolate Cream Co. v. Keller (1898) 85 Fed. 643; Walter Baker & Co. v. Sanders (1897) 80 Fed. 889.

[86] Barrows v. Knight (1860) 6 R. I. 434.

[87] Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42.

[88] Probasco v. Bouyon (1876) 1 Mo. App. 241.

[89] McLean v. Fleming (1877) 96 U. S. 245.

[90] Taylor v. Taylor (1854) 23 Eng. Law & Eq. 281.

[91] Ainsworth v. Walmsley (1866) L. R. 1 Eq. 518.

[92] Robinson v. Storm (1899) 103 Tenn. 40.

[93] Dr. S. A. Richmond Nervine Co. v. Richmond (1895) 159 U. S. 293.

may, however, if not applied or affixed to such article, be entitled to protection as a trade or commercial name.[94]

§ 49. Newly-coined words as trade-marks.

A newly-coined word constitutes one of the strongest trade-marks. The reason for this is obvious. Such a word, being usually meaningless, cannot be either descriptive or deceptive. All question as to the arbitrary character of the mark is therefore removed, and to entitle the originator thereof to hold such word as a valid trade-mark it is only necessary to show that it has been affixed or applied to a commercial article or vendible commodity for the purpose of indicating the origin or ownership thereof. It is no objection to a newly-coined word as a trade-mark that it is suggestive of the quality of the article to which it is applied, or of the purposes for which it is employed, or the mode of use thereof.[95]

§ 50. Instances of coined words as trade-marks.

The following instances of coined words that have been held valid trade-marks illustrate the rule above stated: "Cocaine," as a trade-mark for a hair wash;[96] "Sapolio," as a trade-mark for a cleaning compound;[97] "Electro-Silicon," as a trade-mark for a polishing powder;[98] "Chatterbox," as a trade-mark for a publication;[99] "Celluloid," as a trade-mark

[94] Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226.

[95] Leonard v. White's Golden Lubricator Co. (1889) 38 Fed. 922; N. K. Fairbank Co. v. Central Lard Co. (1894) 64 Fed. 133; American Grocery Co. v. Sloan (1895) 68 Fed. 539; Wolfe v. Goulard (1859) 18 How. Pr. (N. Y.) 64.

[96] Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192, affirmed (1867) 1 Abb. Dec. (N. Y.) 267.

[97] Morgan v. Schwachhofer (1878) 55 How. Pr. (N. Y.) 37.

[98] Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369.

[99] Estes v. Worthington (1887) 31 Fed. 154.

for compounds of pyroxyline;[100] "Bromidia," as a trade-mark for a medicinal compound;[101] "Momaja," as a trade-mark for a blend of coffee;[102] "Saponifier," as a trade-mark for concentrated lye;[103] "Valvoline," as a trade-mark for lubricating oils;[104] "Cottolene," as a trade-mark for a substitute for lard;[105] "Cuticura," as a trade-mark for a toilet soap;[106] "Vitae-Ore," as a trade-mark for a medicinal preparation;[107] "No-To-Bac," as a trade-mark for a medicine designed to cure the tobacco habit;[108] "Asepsin," as a trade-mark for an antiseptic compound;[109] "Bromo-Caffeine," as a trade-mark for a medicinal preparation;[110] "Uneeda," as a trade-mark for biscuit;[111] "Filo-Floss," as a trade-mark for a fabric;[112] "Hygieniques," as a trade-mark for suspenders;[113] "Roach Sault," as a trade-mark for an insecticide;[114] "Maizena," as a trade-mark for corn flour.[115]

§ 51. Fanciful names and phrases as trade-marks.

There is another class of words and phrases that may often

[100] Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94; Celluloid Mfg. Co. v. Read (1891) 47 Fed. 712.

[101] Battle v. Finlay (1891) 45 Fed. 796.

[102] American Grocery Co. v. Sloan (1895) 68 Fed. 539.

[103] Pennsylvania Salt Mfg. Co. v. Myers (1897) 79 Fed. 87.

[104] Leonard v. White's Golden Lubricator Co. (1889) 38 Fed. 922.

[105] N. K. Fairbank Co. v. Central Lard Co. (1894) 64 Fed. 133.

[106] Potter Drug & Chemical Corp. v. Miller (1896) 75 Fed. 656.

[107] Noel v. Ellis (1896) 89 Fed. 978.

[108] Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 80 Fed. 105.

[109] Lloyd v. William S. Merrill Chemical Co., 25 Ohio Law J. 319.

[110] Keasbey v. Brooklyn Chemical Works (1894) 142 N. Y. 467.

[111] National Biscuit Co. v. Baker (1899) 95 Fed. 135.

[112] Rawlinson v. Brainard & Armstrong Co. (1899) 28 Misc. Rep. (N. Y.) 287.

[113] Bailly v. Nashawannuck Mfg. Co. (1890) 10 N. Y. Supp. 224.

[114] Stern v. Barrett Chemical Co. (1899) 29 Misc. Rep. (N. Y.) 609.

[115] Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823.

be exclusively appropriated as trade-marks. These are words and phrases that are hardly to be considered as words in common use, and yet do not come under the class of newly-coined words. Instances of these are found in the phrase "Coal Oil Johnnie's Petroleum Soap";[116] in "La Favorita," as a brand for flour;[117] "Sorosis," for ladies' shoes;[118] "Nickel-In" and "El Destino" for cigars;[119] "Pharaoh's Serpents," for fireworks;[120] "Lone Jack" and "El Cabio," for tobacco;[121] "Sappota Tolu," for chewing gum.[122] Such purely fanciful words or phrases may be exclusively appropriated as trade-marks.

§ 52. Letters as trade-marks.

Letters, or even a single letter, when adopted and used primarily to indicate origin or ownership of a commercial article, may constitute a valid trade-mark. It is essential, however, in such case, that the primary object in using such letter or letters be to indicate origin or ownership, and not the grade or quality of the article. If the primary object is to indicate origin or ownership, then the letter or letters may constitute a valid trade-mark, even though they may secondarily indicate quality; but if the letter or letters indicate quality or size primarily, and indicate origin or ownership only secondarily, then such letter or letters do not constitute a valid trade-mark. There are instances in which marks

[116] Petrolia Mfg. Co. v. Bell & Bogart Soap Co. (1899) 97 Fed. 781.

[117] Menendez v. Holt (1888) 128 U. S. 514.

[118] Little v. Kellam (1900) 100 Fed. 353.

[119] Schendel v. Silver (1892) 63 Hun (N. Y.) 330; Pinto v. Badman (1891) 8 R. P. C. 181.

[120] Barnett v. Leuchars (1865) 13 Law T. (N. S.) 495, 14 Wkly. Rep. 166.

[121] Carroll v. Ertheiler (1880) Cox, Man. Trade-Mark Cas. No. 669; Solls Cigar Co. v. Pozo (1891) 16 Colo. 388.

[122] Adams v. Heisel (1887) 31 Fed. 279.

consisting of letters alone or combined with other features have been sustained by the courts, and there are other instances in which such letters have been held to be invalid as trade-marks. It will be found, on an examination of these cases, that, where the marks have been sustained, the primary purpose in using them was to indicate origin or ownership, and, where they have been held invalid, the primary object in using them was to denote size, grade, or quality.[123]

§ 53. Instances of letters as trade-marks.

In the following cases, marks composed in whole or in part of letters have been sustained:

In Godillot v. Harris,[124] a monogram formed of the letters "A G," in connection with other devices, was held to be a valid trade-mark, and relief was granted to the plaintiff against a defendant who used a similar package, having thereon a monogram formed of the letters "F G."

In Foster v. Blood Balm Co.,[125] the principal feature of the plaintiff's device consisted of the letter "B," nine times repeated, the repetitions being arranged in three vertical columns, separated by lines or bars so as to form three groups of three B's ("B, B, B"), and, when applied to the goods, each of three sides of the package presented to the eye one of these triple combinations of B in conspicuous type. The court refused a preliminary injunction, holding that the case should await the result of a trial upon the merits, expressed some doubt as to whether the design was sufficiently fanciful

[123] Godillot v. Harris (1880) 81 N. Y. 263; Foster v. Blood Balm Co. (1887) 77 Ga. 216; Frank v. Sleeper (1890) 150 Mass. 583; Giron v. Gartner (1891) 47 Fed. 467; George T. Stagg Co. v. Taylor (1894) 95 Ky. 651, 27 S. W. 247; Godillot v. American Grocery Co. (1896) 71 Fed. 873; Lafean v. Weeks (1896) 177 Pa. 412; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[124] (1880) 81 N. Y. 263.

[125] (1887) 77 Ga. 216.

and arbitrary to constitute a technical trade-mark, and stated that, whether the design would suffice or not for a technical trade-mark, there could be no reasonable doubt but that it was sufficient for a label.

In Frank v. Sleeper,[126] the supreme court of Massachusetts held that the letters "N S" constituted a valid trade-mark for cigars, and that the trade-mark was infringed by the use of the letters "N & S."

In George T. Stagg Co. v. Taylor,[127] the court of appeals of Kentucky held that the letters "O. F. C." constituted a trade-mark for whiskey.

In Godillot v. American Grocery Co.,[128] a monogram composed of the letters "A" and "G" was held to be a trade-mark, and the defendant was enjoined from using a similar monogram, although composed of letters forming the initials of the two principal words of defendant's name.

In Giron v. Gartner,[129] the complainant's trade-mark consisted of the letters "G F," and was held to be infringed by the mark "G & F," in the form in which it was used by the defendant, unless the ampersand was made of equal prominence with the initials.

§ 54. Numerals as trade-marks.

An arbitrarily selected numeral or combination of numerals used primarily for the purpose of indicating origin or ownership may constitute a valid trade-mark. It is essential, however, as in the case of other trade-marks, that the primary object in using the mark be to indicate origin or ownership, and not grade or quality. Such numerals may be used either by themselves or in conjunction with other

[126] (1890) 150 Mass. 583.
[127] (1894) 95 Ky. 651, 27 S. W. 247.
[128] (1896) 71 Fed. 873.
[129] (1891) 47 Fed. 467.

devices, or with words. In such case it must appear that the primary object in using the mark is to indicate origin or ownership. If the mark has acquired a secondary or subordinate signification, indicating grade or quality, it will not interfere with its validity as a trade-mark. If, however, the primary object in using the trade-mark is to indicate grade or quality, it will not constitute a valid trade-mark, even though it has acquired a secondary signification, indicating origin or ownership. The test in each case is, what is the primary object in using the mark? If this object is to point to a particular person as the maker of the goods, the numeral or combination of numerals, either with or without other devices, will constitute a valid trade-mark. If the primary object is to indicate grade or quality, or to distinguish one grade or quality from another, then the mark will not constitute a valid trade-mark. Again, if the numerals adopted have acquired, prior to such adoption, a well-understood meaning in the trade, indicative of grade or quality, they cannot be appropriated as trade-marks.[130]

§ 55. Instances of numerals held to be valid trade-marks.

In Gillott v. Esterbrook[131] it appeared that the plaintiff, a

[130] Gillott v. Esterbrook (1867) 47 Barb. (N. Y.) 455; Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Gillott v. Esterbrook (1872) 48 N. Y. 374; India Rubber Co. v. Rubber Comb & Jewelry Co. (1879) 45 N. Y. Super. Ct. 258; Kinney v. Allen (1877) 1 Hughes, 106, Fed. Cas. No. 7,826; Collins v. Reynolds Card Mfg. Co. (1879) 7 Abb. N. C. (N. Y.) 17; Lawrence Mfg. Co. v. Lowell Hosiery Mills (1880) 129 Mass. 325; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Humphreys' Specific Homeopathic Medicine Co. v. Wenz (1882) 14 Fed. 250; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Smith & Davis Mfg. Co. v. Smith (1898) 89 Fed. 486. See Humphreys' Homeopathic Medicine Co. v. Hilton (1894) 60 Fed. 756.

[131] (1867) 47 Barb. (N. Y.) 455, affirmed (1872) 48 N. Y. 374.

manufacturer of steel pens, had for many years manufactured a peculiar pattern, on which was impressed the figures "303," and the words "Joseph Gillott, Extra Fine." The pens were put up in paper boxes, with a label on top, containing the same name and numeral. The pens were known and ordered by dealers as "303" pens. Such figures did not express any quality or size of the pen, but were selected arbitrarily by plaintiff to distinguish the pattern or character of pens to which they were applied. Defendants began the manufacture and sale of a steel pen closely resembling plaintiff's pen in every particular, on which were stamped "303" and "Esterbrook & Co." and "Extra Fine." The pens were put up in boxes of the same size and similar to those of plaintiff, with a label containing the same words and figures, except "Esterbrook & Co.," instead of "Joseph Gillott." In an action brought by plaintiff to restrain the defendants from using the number "303," it was held by the New York supreme court that plaintiff had acquired the right to the exclusive use of those figures as a trade-mark, and was entitled to the relief sought. The judgment of the supreme court was affirmed on appeal, and in the opinion affirming the court below it is said: "The preceding statement of facts clearly shows that the said number was selected and used by the plaintiff as his trade-mark to indicate, in connection with his name, the origin and ownership of the said pens so manufactured by him, and not to designate their quality merely, and that the defendants, by the adoption thereof, have done it in fraud of his rights, and the plaintiff, upon all the facts found by the judge, was entitled to the injunction granted to him."

In Boardman v. Meriden Britannia Co.,[132] a trade-mark consisting of numbers associated with the name of the peti-

[132] (1868) 35 Conn. 402.

tioner, and certain words indicating the manner of manufacture of the teaspoons, upon the boxes of which the trade-mark was applied, was involved. The defendant used the same numbers and words indicating manner of manufacture upon a similar label, but substituted his own name for the name of the petitioner. Judgment was granted for the petitioner, and in its opinion the Connecticut supreme court said: "Both parties seem to regard the use of numbers as giving rise to the most important and most material question in the cause. The petitioners rely upon them as the most prominent, valuable, and distinctive feature in their trade-marks. The respondents claim 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. If this be so, or if the numbers were used solely to indicate the different patterns, styles, or sizes, it is clear, from the view we have taken of the law, that the respondents ought not to be restrained from their use. Whether, in any case, numbers alone may be legitimately appropriated as trade-marks, is a question not necessarily involved in the case. It may be difficult to give to bare numbers the effect of indicating origin or ownership, and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, 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."

In India Rubber Co. v. Rubber Comb & Jewelry Co.,[133] the defendant was enjoined from using the numbers "2,"

[133] (1879) 45 N. Y. Super. Ct. 258.

"101," and "32" upon gutta-percha combs. Referring to these numbers, the court, by Judge Sedgwick, said: "I am not able to see that the principles of Gillott v. Esterbrook [48 N. Y. 375] should not be applied. In that case and in this, the numbers were used to distinguish one pattern or character of goods from other patterns. In this case, the defendant's labels prove that the numbers were useful in the market to designate these patterns. The numbers were selected arbitrarily, and of themselves expressed no size or quality."

In Collins v. Reynolds Card Mfg. Co.,[134] it appeared that plaintiffs manufactured most of the cards used for photographic mounts in this country. Their cards of various sizes and kinds were boxed, each kind by itself, in a paper box, with a label on one end of the box. The cards themselves were perfectly plain in appearance, and the boxes and labels were not marked with the manufacturer's name, or with any peculiar device, except that, upon the labels, numbers running from 1 to upward of 50 were printed, a different number being employed for each kind of cards. The numbers were purely arbitrary, and were used by the plaintiffs for the double purpose of distinguishing the different kinds of their cards as among themselves, and also of designating to the trade cards of their manufacture, and of distinguishing them from cards of all other manufacturers. The numbers were first selected by the plaintiffs, and had been exclusively used by them for this purpose, and with this effect in the photographic card trade, until certain of them were adopted by the defendant. The plaintiffs' cards were generally ordered, in the trade, simply by numbers. The court stated that the case could not be distinguished in principle from that of Gillott v. Esterbrook, and said: "In the case at bar, the labels do not contain the name of the plaintiffs as makers, but the evi-

[134] (1879) 7 Abb. N. C. (N. Y.) 17.

dence satisfies me, beyond doubt, that the figures '35' were known to and recognized by dealers when employed as designating *carte de visite* mounts, as referring to the particular kind of card which was manufactured by the plaintiffs. And under the authorities, I am of the opinion that the plaintiffs have a trade-mark in those figures, and are entitled to be protected from its infringement by a court of equity."

In Lawrence Mfg. Co. v. Lowell Hoisery Mills,[135] the trade-mark of the plaintiff consisted of the figure of an eagle, surmounting a wreath formed of the branches of the cotton plant. The wreath inclosed the words, "Lawrence Manufacturing Company," printed in a circle, having underneath it the word "Trade-Mark," and, below all, the figures "523," printed in large hollow block numerals. This device had been stamped for many years on hosiery of a certain grade, and was known and recognized as indicating that the goods so marked were of the plaintiff's manufacture. Before this, the plaintiff had used an eagle and scroll in combination with other numerals as a trade-mark, upon the same grade of hosiery, and the wreath and eagle of the present device, without the numerals "523," or any other numerals, had been previously used on other grades of goods. The stamp adopted by the defendant consisted of an eagle surmounting a double circle or garter, on which were printed the words, "Extra finish iron frame," and beneath which were the figures "523," printed in large hollow block numerals, of the size and description used by the plaintiff, and occupying the same position with reference to other parts of the device. This stamp the defendant had placed upon hosiery goods made by it, for the purpose of imitating the plaintiff's stamps, and in order that such goods might be supposed to be of the plaintiff's manufacture, and it was found by the court that the

[135] (1880) 129 Mass. 325.

plaintiff's customers had been misled and deceived thereby. The eagle and garter had been used by the defendant before the trade-mark of the plaintiff was adopted, and the plaintiff made no claim to the exclusive use of them when not combined with the numerals "523." It was held by the court that the plaintiff adopted and used the numerals "523" as part of its trade-mark; that these figures were selected arbitrarily; that they were of unusual and distinctive form; that they were added to the original device, consisting of the eagle, the wreath, and the plaintiff's name, at the time when the word "Trade-Mark" was also added; that the whole, so composed, had been used as one trade-mark ever since; that this mark was recognized and known as the plaintiff's mark, and goods so marked were described and called for as "523's." It was also held that the plaintiff was entitled to a decree.

In American Solid Leather Button Co. v. Anthony,[136] the complainant was the manufacturer of buttons and nails with solid leather heads. In order to distinguish the different styles which it manufactured, it had assigned certain numerals, arbitrarily chosen, *e. g.*, 30, 40, 60, 70, 111, etc., to designate each style of head, on its advertising cards and packing boxes. The several styles made by the complainant had become associated with and known by these numerals in the trade, and the numerals were commonly made use of in orders and other designations of a style desired to be referred to. In deciding the case in favor of the complainant, the court said: "Within limits, which are well defined, a combination of letters or figures, arranged for convenience or to attract attention, may serve the purpose of a trade-mark as well as a device invented or arbitrarily selected. So a person may have different symbols for different grades of goods, which, in the same way, will indicate both quality and or-

[136] (1887) 15 R. I. 338.

igin, with respect to the goods so marked. A manufacturer may adopt such symbols, not simply to mark 'a' style or quality, but 'his' style and 'his' quality, as well. He is entitled to have 'his' style and 'his' quality protected from misrepresentation, and to have the benefit of any favorable reputation they may have gained. * * * We think these numbers indicate origin as well as style. The fact that orders for goods refer to numbers, which have become associated with a particular style of nail only by the complainant's association of the number with the style, raises a natural inference that persons ordering by that number suppose they are ordering both goods and style of complainant's make. We therefore think that, in the use of these numbers, * * * the complainant is entitled to protection according to the prayer of the bill."

In Kinney v. Allen[137] it appeared that the complainant used, with other devices, on certain classes of the packages and boxes in which he put cigarettes manufactured by him upon the market, the numerical symbol "1/2," printed in bold characters, in red color, with the bar between the two figures oblique, and nearly upright, with the figure "1" elevated on the left, the figure "2" depressed on the right, the symbol, as a whole, being of such size that the circumference of a circle having a radius of five-eighths of an inch would just include all its points. In discussing this mark Judge Hughes said: "It would seem that the original idea of the complainant in using this character '1/2' on certain of his wares was to indicate that the cigarettes stamped with it were made up of two kinds of tobacco, in the proportion of half-and-half. The numerical character does not express such an idea. It is not the term which a person accustomed to the use of accurate language would employ for the pur-

[137] (1877) 1 Hughes, 106, Fed. Cas. No 7,826.

pose of expressing it, but yet it must be admitted that it does, in some sort, indicate the idea, and is not an absolutely arbitrary symbol. It is only because of the fact that the character does indicate the idea of half-and-half, but does not express it, that any confusion attends this case. If the use by the complainant of the numerical character '1/2' was absolutely arbitrary, there could be no question of his exclusive right to use it stamped in any form upon his goods. But where, on the other hand, a character or word is the one in general use for describing the quality or kind of goods on which it is placed, the books are full of authorities showing that such character or word ordinarily used cannot be appropriated by any one manufacturer, and that the most he can acquire by long usage, or by statutory registration, is the right of using the character or word printed or painted in some special form not in ordinary use." It was held that the use of the numeral character "1/2" by the complainant, being in a critical sense merely arbitrary, as only indicating, but not expressing, the idea of half-and-half, but not absolutely arbitrary in a popular sense, the complainant was not entitled to an injunction prohibiting the use by others of the character in any form on wares similar to his own, but that he was entitled to its exclusive use in the form, size, color, and style in which he had used it.

In Shaw Stocking Co. v. Mack,[138] the principal contention was as to whether the complainant had an exclusive right to the number "830" to designate and distinguish its hose of a particular variety. In holding that this combination of figures constituted a valid trade-mark, Judge Coxe said: "Broadly defined, a trade-mark is a mark by which the wares of the owner are known in trade. Its object is two-fold,—first, to protect the party using it from competi-

[138] (1882) 12 Fed. 707.

tion with inferior articles, and, second, to protect the public from imposition. There is hardly a limit to the devices that may be thus employed. The whole material universe is open to the enterprising merchant or manufacturer. Anything which can serve to distinguish one man's productions from those of another may be used. The trade-mark brands the goods as genuine, just as the signature to a letter stamps it as authentic. The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used. Why not numerals united? What consistency is there in allowing it in a combination of letters, but denying it in a combination of figures? A careful examination of the authorities cited by the learned counsel for the defendants leads to the conclusion that, where the courts have refused protection to alleged trade-marks composed of letters or numerals, it has been because, on the facts of each case, it was determined that the figures or letters were intended solely to indicate quality, etc., and not because figures and letters in arbitrary combination are incapable of being used as trade-marks. It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3, and 4, or the letters A, B, C, and D, to distinguish the first, second, third, and fourth quality of his goods, respectively. Why? Because the general signification and common use of these letters and figures are such that no man is permitted to assign a personal and private meaning to that which has, by long usage and universal acceptation, acquired a public and generic meaning. It is equally clear, however, that if, for a long period of time, he had used the same figures in combination, as '3214,' to distinguish his own goods from those of others, so that the public had come to know them by these numerals, he would be protected. The courts of last resort in Connecticut, in Massachusetts, and in New York have distinctly held that doctrine."

In Humphreys' Specific Homeopathic Medicine Co. v. Wenz [139] it was held that a series of numbers employed to designate homeopathic specifics constituted a valid trade-mark, and the defendant was enjoined from applying the same system of numbers to another set of specifics, although such numbers were used in connection with the words "Humphreys' Homeopathic Specifics" by the complainant, and in connection with the words "Reeves' Improved Homeopathic Specifics" by the defendant. In this instance the defendant had used the same numbers that had been previously used by the complainant for the same specific. In the later case of Humphreys' Homeopathic Medicine Co. v. Hilton [140] it appeared that the different numbers did not stand for the same remedies in the defendant's system as in the complainant's system. In dismissing the bill, Judge Wallace said: "It may be that numerals which are arbitrarily selected, without any purpose of identifying the article to which they are affixed from other articles of a similar class, may become the subject of a trade-mark; but the use of numerals as a short method of identifying the several members of a class, and distinguishing one of them from another, is as old as the use of written words. When so used, they are, in substance and effect, descriptive terms,—the number conveys to the reader details which otherwise would have to be amplified in words. Hence it is that the practice is so common, with manufacturers and dealers, of numbering the varieties so as to indicate, by reference to advertisements, photographs, or other descriptive mediums, the size, grade, or peculiar characteristics of each for their own convenience and that of their customers. No one can acquire an exclusive right to appropriate them for such a purpose. No one has the right to ap-

[139] (1882) 14 Fed. 250.
[140] (1894) 60 Fed. 756.

propriate to his exclusive use a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. It is because of this principle that a trade-mark cannot be acquired by the adoption of a word which is merely descriptive of the quality, ingredients, or characteristics of a commodity. * * * As used by the complainant and its predecessors, the numbers merely are not a valid trade-mark."

§ 56. Pictures as trade-marks.

Pictures, used alone or in combination with other devices, may constitute valid trade-marks. Such devices are not open to the objection of being either descriptive or deceptive. It is usually then only necessary for the plaintiff to show prior adoption and use of the picture in question for the class of goods upon which it is used in order to establish his exclusive right thereto.

§ 57. Instances of pictures or symbols as trade-marks.

In Colman v. Crump [141] it was held that the plaintiffs were entitled to the exclusive use of the picture of a bull's head as a trade-mark for mustard, although, prior to the adoption of such use by plaintiff, it had been used by others casually and occasionally, and as an ornament, rather than as a distinguishing mark of the mustard manufactured and sold; and the fact that the same device was used upon other articles of merchandise did not take from the plaintiffs their right to its exclusive use on this one article of their manufacture.

In Pratt's Appeal,[142] the supreme court of Pennsylvania

[141] (1877) 70 N. Y. 573.

[142] (1888) 117 Pa. 401.

held that a representation of a cornucopia printed upon cakes of butter constituted a valid trade-mark.

In Lichtenstein v. Goldsmith,[143] the principal feature of the trade-mark involved was a picture of the head of an elk, together with the word "Elk" printed in large letters, upon the face of labels used upon boxes of cigars.

In G. G. White Co. v. Miller,[144] the trade-mark consisted of the representation or picture of a chicken cock standing upright within a circle, surrounded by the words, "Old Bourbon Whiskey, Bourbon Co., Ky.," and within these encircling words, and below the representation or picture, were the words "From J. A. Miller, Paris." This trade-mark was used upon the barrels containing the whiskey, and this whiskey, for more than thirty years, had always been known in the trade as "Miller's Chicken Cock Whiskey," or "Chicken Cock Whiskey," and it had been noted for its high grade and uniform excellence, and this mark had been stamped upon every barrel or package of whiskey made or sold by Miller or his successor in business. The defendant used a mark that the court held to be in all essential characteristics almost identical with that of the plaintiff, and was enjoined, the court saying: "The main feature of the mark in each case is the representation of a cock standing upright."

In Kerry v. Toupin [145] it appeared that complainants manufactured a medicinal compound under the name of "Syrup of Red Spruce Gum," and for some twenty years or more that name was placed conspicuously on the packages in which the compound was sold, and in connection therewith appeared a cut of an Indian against the background of spruce

[143] (1889) 37 Fed. 359.

[144] (1892) 50 Fed. 277.

[145] (1894) 60 Fed. 272. See, also, Manitowoc Pea-Packing Co. v. William Numsen & Sons (1899) 93 Fed. 196; Ruhstrat v. People (1900) 185 Ill. 133.

trees and a waterfall. It was held that the adoption and continuous use of this distinctive name and device entitled the complainants to claim it as a trade-mark, and to be protected against its infringement by persons making similar goods. The court said: "The complainants' name, 'Syrup of Red Spruce Gum,' adopted and continued in the manner shown, is a trade-name, and the device embodying the name and the cut, as printed on the blue wrapper, has become a distinctive mark in the trade, as applied to their cough mixture, and, as such, is entitled to protection."

§ 58. Names of newspapers and periodicals as trade-marks.

Newspapers and periodicals are commercial articles. The names thereon or titles thereof indicate origin or ownership. Such names may therefore constitute valid trade-marks, under the rules and subject to the exceptions and restrictions hereinbefore stated. There are many instances in which the courts have granted injunctions prohibiting the use of names constituting the titles of newspapers or periodicals, without discussing the question whether such titles constituted trade-marks. In some instances, the cases have been considered as involving merely questions of goodwill. In several of the later cases, however, the courts have recognized that the titles of newspapers and periodicals are usually trade-marks.[146]

[146] Bradbury v. Dickens (1859) 28 Law J. Ch. 667; Clement v. Maddick (1859) 33 Law T. 117; Ingram v. Stiff (1859) 33 Law T. 195; Hogg v. Kirby (1803) 8 Ves. 215; Longman v. Winchester (1809) 16 Ves. 269; Edmonds v. Benbow, Seton (3d Ed.) 905; Id. (4th Ed.) 238; A. Constable & Co. v. Brewster (1824) 3 Scot. Ct. Sess. Cas. (1st Ser.) 215; Prowett v. Mortimer (1856) 27 Law T. 132; Chance v. Sheppard (1869) Cox, Man. Trade-Mark Cas. No. 317; Clowes v. Hogg (1871) Cox, Man. Trade-Mark Cas. No. 345; Mack v. Potter (1872) 41 Law J. Ch. 781; Corns v. Griffiths (1873) Cox, Man. Trade-Mark Cas. No. 420; Metzler v. Wood (1878) 38 Law T. (N. S.) 541.

§ 59. Descriptive or geographical words that have acquired secondary meanings.

While it is the general rule that neither descriptive words nor geographical terms may be appropriated as trade-marks, it has been held, in a number of cases, that such words or

8 Ch. Div. 606; Weldon v. Dicks (1879) 39 Law T. (N. S.) 467, (1878) 10 Ch. Div. 247; American Grocer Pub. Ass'n v. Grocer Pub. Co. (1881) 25 Hun (N. Y.) 398; Kelly v. Hutton (1868) 19 Law T. (N. S.) 228; Snowden v. Noah (1825) Hopk. Ch. (N. Y.) 396; Bell v. Locke (1840) 8 Paige (N. Y.) 75; Dayton v. Wilkes (1859) 17 How. Pr. (N. Y.) 510; Matsell v. Flanagan (1867) 2 Abb. Pr. (N. S.; N. Y.) 459. See, also, Stephens v. De Conto (1868) 4 Abb. Pr. (N. S.; N. Y.) 47; New York Polyclinic Medical School v. King (1899) 27 Misc. Rep. (N. Y.) 250; Osgood v. Allen (1872) Holmes, 185, Fed. Cas. No. 10,603, Cox, Man. Trade-Mark Cas. No. 410, note.

In Matsell v. Flanagan (1867) 2 Abb. Pr. (N. S.; N. Y.) 459, 462, Brady, J.: "A newspaper establishment is not excluded from the advantage of these rules. It is a species of property, and the rights which appertain to it, so far as they are private and exclusive, are entitled to the protection of the laws. Snowden v. Noah, Hopk. Ch. (N. Y.) 351; Bell v. Locke, 8 Paige (N. Y.) 75. The title of a newspaper may be a purely original one, and the proprietor, for that reason, entitled to its exclusive use. He may create a word, or combination of words, for the particular designation of his paper, and in that way acquire an exclusive right to the use of the name employed. He may combine, as the plaintiffs have, well-known English words, in common use, to designate his paper, and its contents may in many respects be multiplied by publications in other prints, but the paper will, nevertheless, be original in some, if not in many, respects. The individualities of editorial life are as rarely duplicated as those displayed in other pursuits, and the intellectual vigor distinguishing the character and value of different prints, though equal in power, will be essentially different in thought,—in the principles announced and advocated, and in the reasoning by which the same theories are advanced and sought to be established. A newspaper, in its commanding elements, is the result of mental labor, and should be protected to the same extent, at least in the use of symbols, names, and marks, as any other property."

In Stephens v. De Couto (1868) 7 Rob. (N. Y.) 343, 348, Monell, J.: "I do not understand that the protection which the law affords to 'trade-marks,' even assuming the name of a newspaper to be a

terms may acquire a secondary meaning in the trade from having been long used as the designation of a particular manufactured article, and thereby to have lost, so far as such ar-

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, except, perhaps, in the name or title of the paper, 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, Fed. Cas. No. 2,872.

"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 the rules of trade-mark would apply. Dayton v. Wilkes, 17 How. Pr. (N. Y.) 510. And I have no doubt that the names, so long appropriated and used, of the New York Herald, or the Sun, would be protected, as trade-marks, against the assumption of those names by another proprietor. But that I understand to be the extent of the rule, and that any mere assimilation of the name, unless it was very clearly calculated to deceive the public, would not be unlawful."

In Joseph Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321, 339, Paxson, J.: "The name of a newspaper is a trademark,—as much so as a label stamped upon a bale of muslin."

In American Grocer Pub. Ass'n v. Grocer Pub. Co., 25 Hun (N. Y.) 398, it was held by the New York supreme court (reversing 51 How. Pr. [N. Y.] 402) that where the plaintiff had for many years published in the state of New York a paper called the "American Grocer," and one Price, who had theretofore edited plaintiff's paper, started for the defendant a new paper called "The Grocer," even if the evidence failed to show an intention on the part of Price to encroach upon the plaintiff's business, yet the plaintiff was entitled to an injunction restraining the defendant from the publication of any paper called "The Grocer" or "The American Grocer," as plaintiff had acquired a proprietary right in that name.

In Clement v. Maddick, 5 Jur. (N. S.) 592, the proprietor of "Bell's

ticle is concerned, their primary descriptive or geographical significance. Thus it has been held that the name "Waltham" on watches, while originally used in a geographical sense, had, by continued use, acquired a secondary meaning as a designation of watches of a particular class, and that purchasers had come to understand that watches stamped with the name "Waltham" are watches made by the American Waltham Watch Company.[147] In the English case of Wotherspoon v. Currie[148] it was held by the house of lords that the word "Glenfield," as applied to starch, had acquired a secondary meaning, and denoted to the public starch made by the appellants, and an injunction was granted "restraining the respondent, his servants and agents, from using the word 'Glenfield' in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be 'Glenfield Starch,' and from selling or causing the same to be sold as 'Glenfield Starch,' and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is 'Glenfield Starch,' or starch manufactured by the appellants." It appeared, moreover, that, while the appellants' starch had originally been manufactured at Glenfield,

Life in London and Sporting Chronicle" obtained an injunction restraining the proprietors of "The Penny Bell's Life and Sporting News" from using any title which included "Bell's Life," by which name the plaintiff's paper was known familiarly.

In Ingram v. Stiff, 5 Jur. (N. S.) 947, the proprietor of a weekly publication called "The London Journal" obtained an injunction restraining the defendant from printing, publishing, or selling any newspaper or other periodical under the name of "The Daily London Journal," or any other name or style of which the words "London Journal" should form part.

[147] American Waltham Watch Co. v. United States Watch Co. (1899) 173 Mass. 85; American Waltham Watch Co. v. Sandman (1899) 96 Fed. 330.

[148] (1872) 42 Law J. Ch. 130, L. R. 5 H. L. 508.

their factory had been moved, prior to the time when suit was brought, to another place, and that the respondent had set up his manufactory at Glenfield, and was actually manufacturing starch at that place, and in part of the same building where the original manufacture of Glenfield starch had been carried on. Glenfield was not a parish, nor a hamlet, nor a district of any special character, but it was merely an estate of that name, upon which some people had erected some houses or manufactories, and upon which some sixty people were then living. There was, therefore, nothing whatever to give particular celebrity to the name of Glenfield, so connected with the starch manufactory, beyond the fact that the appellants had manufactured an article having a very large sale under that name. In stating his opinion in the house of lords, Lord Westbury said: "I take it to be clear, from the evidence, that, long antecedently to the operations of the respondent, the word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture,—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and, in connection with starch, had acquired that peculiar secondary signification to which I have referred. The word 'Glenfield,' therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch." In the case of Montgomery v. Thompson,[140] also decided by the house of lords, it appeared that the respondents had carried on business as brewers at Stone, a town of 6,000 or 7,000 inhabitants, for upwards of a century. The ales manufactured by them had gained a high reputation, and had become known to the market, and to the public, under the terms "Stone Ales," or "Stone Ale," the latter being exclusively ap-

[140] (1891) 60 Law J. Ch. Div. 757, [1891] App. Cas. 217.

plied to a particular quality of beer, and any one asking for "Stone Ale" or "Stone Ales" would desire to be supplied, and expect to be supplied, with the ale manufactured by the respondents. The appellant had recently established a brewery at Stone. The courts below came to the conclusion that he intended to use the terms "Stone Ale" and "Stone Ales" in connection with liquor of his own manufacture, with a view of leading to the belief that the ales he sold were those which had become known to the market and to the public, and thus obtaining advantage of the reputation which the respondents' ales had acquired. An injunction was accordingly granted on the application of the respondents, restraining the appellant from "carrying on the business of a brewer at Stone under the title 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling or causing to be sold any ale or beer, not of the plaintiffs' manufacture, under the term 'Stone Ales' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade-marks, or any of them." In the case of Reddaway v. Banham & Co.,[150] decided by the house of lords in 1896, it was found that the appellant Frank Reddaway had been for many years a manufacturer of machine belting. About the year 1879 he commenced calling the belting which he manufactured "Camel-Hair Belting," for the purpose of distinguishing it from belting of other manufacturers. A large proportion of his trade had been with India, the Colonies, and foreign countries. The belting consigned to these countries was stamped with a "Camel," or with the word "Camel" or "Camel Hair," and sometimes with both. The yarn of which the appellants'

[150] (1896) 65 Law J. Q. B. Div. 381.

belting consisted chiefly was, for the most part, made of camel hair, and while this yarn was commonly called "Camel-Hair," it was not generally known that it really consisted of the hair of a camel. The respondent Banham, who was formerly in the employ of the appellant, ceased to be so employed in the year 1889, and commenced manufacturing belting on his own account. He made belting from yarn of the same description as that used by the appellants, which he sold and advertised as Arabian belting. In 1891 the respondent company was formed, and commenced calling their belting "Camel-Hair Belting," these words, and these words only, being in most cases stamped on the belting. Suit having been brought, a special jury found that the term "Camel-Hair Belting" meant belting made by the plaintiffs, as distinguished from belting made by other manufacturers. Upon the findings of the jury, the court entered judgment for the plaintiffs. On appeal, this judgment was reversed, and judgment entered for the defendants. In the opinion of the court of appeal, inasmuch as the words "Camel-Hair Belting" were descriptive of the article sold, the words "Camel-Hair" indicating the material of which it was made, the defendants were entitled to use the same language with reference to the belting which they sold, and the plaintiffs could have no right to restrain them from doing so, even though, as the jury had found, the words "Camel-Hair Belting" would be understood to mean belting manufactured by the plaintiffs, and purchasers of the belting would be deceived into the belief that they were obtaining goods of the plaintiffs' manufacture. On appeal to the house of lords, the decision of the court of appeal was reversed. In stating his opinion in the house of lords, Lord Herschell, referring to the statement that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting, said: "I think the

fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification, differing from its primary one, and that, if it is used to persons in the trade who will understand it, and be known and intended to understand it, in its secondary sense, it will none the less be a falsehood that in its primary sense it may be true. A man who uses language which will convey to persons reading or hearing it a particular idea which is false, and who knows and intends this to be the case, is not surely to be absolved from a charge of falsehood because in another sense, which will not be conveyed, and is not intended to be conveyed, it is true. In the present case, the jury have found, and in my opinion there was ample evidence to justify it, that the words 'Camel Hair' had, in the trade, acquired a secondary signification in connection with belting; that they did not convey to persons dealing in belting the idea that it was made of camel's hair, but that it was belting manufactured by the plaintiffs. They have found that the effect of using the words in the manner in which they were used by the defendants would be to lead purchasers to believe that they were obtaining goods manufactured by the plaintiffs, and thus both to deceive them and to injure the plaintiff. On authority, as well as on principle, I think the plaintiffs are, on these facts, entitled to relief."

While in all of these cases elements of unfair competition were present, and while in none of them except the Glenfield starch case was it held that the plaintiff had a property right in the name or term in question, the same result was reached as if the plaintiff had acquired a technical trade-mark in the words or terms employed. The correct rule in reference to such terms has been stated by the court of appeals of Kentucky, in the case of Metcalfe v. Brand,[151] as follows: "While one who sells a product of a particular region of

[151] (1887) 86 Ky. 331.

country cannot appropriate the name of that region to indicate the article he sells, to the exclusion of others who produce or sell a similar product of the same region, yet a geographical name, as applied to a manufactured article, in connection with which the manufacturer was the first to use it, may acquire a secondary meaning, and thus become a valid trademark, but such a right will not be declared or protected unless clearly shown." The same rule should doubtless be applied in reference to descriptive words.[152]

[152] See, also, Gage-Downs Co. v. Featherbone Corset Co. (1897) 83 Fed. 213; Levy v. Waitt (1894) 10 C. C. A. 227, 61 Fed. 1008; Birmingham Vinegar Brewery Co. v. Powell (1897) 66 Law J. Ch. 763; Siegert v. Findlater (1878) 7 Ch. Div. 801, 47 Law J. Ch. 233; Seixo v. Provezende (1866) 1 Ch. App. 192; Newman v. Alvord (1867) 49 Barb. (N. Y.) 588, affirmed 51 N. Y. 189.

In Metcalfe v. Brand (1887) 86 Ky. 331, 345, Holt, J.: "If a geographical name be used as such, it cannot be protected as a trademark. Clearly, all persons living in a town or city may use its name as an address, and, of course, many persons may make the same article in the same town, and show that it is so manufactured, by having the name of the place stamped upon it, or printed upon the label or covering, as their address or place of business. * * * The general qualities of a natural product are indicated by the name of the region from whence it comes. All have a right to sell it, and, in doing so, to call it by the name of the section where it is produced, and from whence it originally came, as that, in effect, describes the article. Such a name indicates the quality, and not the producer or the ownership. All may use it with equal truth. * * * For these reasons, such phrases as 'Sea Island Cotton,' 'Hungarian Grass,' 'Kentucky Hemp,' or 'Virginia Tobacco' will not be protected as trade-marks. This is not so, however, of a manufactured article. The name of the place where it is made serves in no way to indicate its quality or composition; and where the manufacturer has given it a geographical name, which he was the first to use in connection with the article, it seems to us that it may, from long use in such connection, acquire a secondary meaning, and, instead of designating the place where the article is made, indicate its origin, or that it is the product of a particular manufacturer, or

made according to his method. When this is the case, it becomes, in our opinion, a valid trade-mark."

In Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502, 505, Hazelrigg, J.: "The Blue Licks, the upper and lower, have been known since the early settlement of the state,—indeed, years before the formation of the state. It was at the lower springs that, in 1782, the memorable and sanguinary battle occurred between the whites and the Indians, making the spot historically renowned. Buffalo and other wild animals had well beaten 'traces' to and from this spring, which they frequented to lick the deposits from the water; hence the first name was 'The Licks.' The commercial value of the water was early recognized, and years ago the predecessors of the appellees adopted the name 'Blue Lick Water' as their trade-mark. * * * There is no conceivable reason why the name of a place may not be selected as a trade-mark, or the natural product of a spring be the subject of the protection afforded by it. * * * In the case under consideration, the name adopted by the appellees and their predecessors for the water from the Blue Lick Springs indicated the origin and ownership or place of the product, and is one in the exclusive use of which the appellees should be protected."

In Hegeman & Co. v. Hegeman (1880) 8 Daly (N. Y.) 1-4, Daly, C. J.: "A person may acquire the right known as the 'goodwill' in a business from its being established in a particular place, from which he has derived, or may derive, profit, and where there is attached to the business a name indicating to the public where, or in what manner, it is carried on; and this is a right which will be protected in a court of equity, even where he removes the business to another place. Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 232; Harper v. Pearson, 3 Law T. (N. S.) 547; Howard v. Henriques, 3 Sandf. (N. Y.) 725; Christy v. Murphy, 12 How. Pr. (N. Y.) 77."

In El Modello Cigar Mfg. Co. v. Gato (1889) 25 Fla. 886, 909, Mitchell, J.: "A man may establish his right to a trade-mark in the name of a place, city, or town, and it is well established that, when a man manufactures his goods at a particular place, and uses the name of that place in combination with other words as a trade-mark to distinguish the origin or ownership of his goods, no other person will be permitted to use the name of the same place upon goods manufactured by him at another and different place. Delaware & H. Canal Co. v. Clark, 13 Wall. (U. S.) 325; Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291; Newman v. Alvord, 51 N. Y. 189; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 226; Sawyer v. Horn, 1 Fed. 24; Gilman v. Hunnewell, 122 Mass. 139; Robertson v. Berry, 33 Am. Rep. 337, note 1. Under these de-

clions, it will be seen that defendants [who manufactured at Jacksonville, and the complainants at Key West (page 889)] clearly had no right to use the name of the place,—Key West,—* * * either alone or in combination with the other words as alleged in the bill to have been used by them."

In City of Carlsbad v. Thackery (1891) 57 Fed. 18-20, Blodgett, Dist. J.: "Complainants charge that the city of Carlsbad, situated in Bohemia, in the empire of Austria, is the sole owner of the celebrated mineral springs of said city, and has for many years been engaged in the business of evaporating the waters of said springs, and thereby producing the essential salts contained in them, * * * and has put said salts upon the market under the names of 'Carlsbad Sprudel,' 'Carisbad Salts,' and 'Carlsbad Sprudel Salts.' * * * That defendant has engaged in the business of making artificial salts, and putting them upon the market, and offering them for sale, by the names and designations of 'Carlsbad Sprudel,' and 'Carlsbad Sprudel (Artificial).' * * * An injunction is prayed, restraining defendant from making and selling any artificial salts as 'Carlsbad Salts,' or as 'Carlsbad Sprudel,' and from using the word 'Carlsbad' as the designation of the defendant's salts. * * * The term 'Carlsbad Sprudel Salts' means more than a mere combination, in certain proportions, of certain chemical elements. They mean an article produced by the complainant from the Carlsbad waters. Nor does the addition of the word 'artificial' by the defendant to its label enable the defendant to escape from the charge of wrongfully availing itself of complainants' name and reputation. * * * An injunction will be ordered as prayed."

In City of Carlsbad v. Kutnow (1895) 68 Fed. 794-796, Wheeler, Dist. J.: "The Carlsbad Springs appear to be owned by, and wholly within the control of, the city of Carlsbad, in Bohemia, and the waters of them, for many years, to have been evaporated into salts of highly medicinal qualities, in crystals and powder, well known for their curative properties, everywhere, as 'Carlsbad Sprudel Salz.' This bill is brought to restrain the defendants, who are dealers in drugs and medicines in New York, from further using the words 'Improved Effervescent Carlsbad Powder' in selling other salts of similar appearance and properties. * * * As the case stands here, the defendants appear to be using the name 'Carlsbad' upon artificial salts having no connection with that name, and to be using it only because of its connection with the genuine Carlsbad Sprudel Salts. Carlsbad, with its springs, is far away. * * * Allusion has been made to this word being the name of the city, to which ordinarily an exclusive right cannot be acquired; but it is also the

name of these peculiar springs, and gives the name to their products. Decree for the plaintiffs for an injunction and account." Affirmed (1895) in 18 C. C. A. 24, 71 Fed. 167, Lacombe, C. J.

In Sanders v. Utt (1884) 16 Mo. App. 322-327, Lewis, P. J.: "The plaintiff is a dentist, practicing his profession in the city of St. Louis. His petition states that for about twelve years past he has kept over the entrance to his place of business a sign bearing the words 'New York Dental Rooms,' and adds other particulars of fact which are sufficient to vest in him a proprietary right to those words, as descriptive of the place where his business is carried on, if the words themselves are capable of being held in such a right. * * * The grounds of objection chiefly relied on seem to be that, the words 'New York' being a mere geographical designation, and the word 'Dental' only a generic term of description applying to a business or occupation, there can be no proprietary right in either, and no infringement in any use of them by a person other than the plaintiff. * * * To say that a geographical name can never be used in proprietary right as a trade-mark states the rule far too broadly. When such a name is employed in connection with the place of manufacture or production, no person manufacturing or producing at that place can monopolize it against other persons manufacturing or producing at the same place. * * * But in Newman v. Alvord, 49 Barb. (N. Y.) 588, the controversy was about the word 'Akron,' which was the name of the village in New York where the plaintiffs manufactured a cement. * * * It was held that the plaintiffs had an exclusive right to use the word 'Akron,' except as against any person manufacturing at the same place. The defendants were therefore restrained from using the word, although it was a geographical name, because they had no factory at Akron. There is another class of cases, in which proprietary rights may be acquired in a geographical name. This occurs where the name is used, not for the purpose of indicating a particular locality, as in any way connected with the business, but only as a fancy designation, adopted for the sole purpose of distinguishing the factory, or its business, or the particular persons engaged therein, from all other institutions or persons identified with the same pursuit. * * * We think, therefore, that the petition sufficiently shows a proprietary right in the plaintiff to the title 'New York,' as descriptive of his professional abode, and an unlawful infringement of his right by the defendant. To this extent, therefore, the demurrer should have been overruled."

In Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297, 301, Barrett, J.: "It is not disputed that, so far as the word 'Amos-

keag' has been applied by plaintiff to cotton goods actually manufactured and sold by it, the use of such word is its exclusive right. The claim is that, as to any description of cotton goods which the plaintiff has not yet produced, the word 'Amoskeag' is common property, and that therefore the defendants were at liberty to apply it as their trade-mark, even as against the plaintiff, to prints or calicoes. This claim rests upon the assumption that the word 'Amoskeag' is simply the plaintiff's trade-mark,—that is, a geographical name, in which the plaintiff can have no exclusive property except so far as it has been actually applied. It ignores the fact that the word stands for and is, in reality, the distinctive part of the plaintiff's corporate name. * * * The manufacturer of cement, for instance, might apply the word 'Amoskeag' to that article, because, when stamped upon cement, it would not stand for 'The Amoskeag Manufacturing Company.' In that connection, it would be a mere geographical designation, in which, per se, no one has an exclusive right until applied, and not, in effect, the plaintiff's name. Its use, consequently, would deceive no one, because it would not convey the idea, and therefore would not represent that the cement was the plaintiff's production."

In St. Louis Carbonating & Mfg. Co. v. Eclipse Carbonating Co. (1894) 58 Mo. App. 411, 416, Bond, J.: "The question arising for decision is whether or not there was such a prior use of the terms 'New Orleans Mead,' at the time of their adoption as a trade-mark by plaintiff's assignors, as to render them publicl juris, and therefore not subject to appropriation as a trade-mark. In considering this question, we shall concede that the fact that New Orleans is the name of a place is not an objection to its adoption as a trade-mark or trade label, when it is not employed in a geographical sense, but is only used as a term of fancy to designate the origin or ownership of an article. Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co., 104 Mo. 53; Sanders v. Utt, 16 Mo. App. 322."

In Dunbar v. Glenn (1877) 42 Wis. 118, 137, Cole, J.: "It will avail little to resort to the original meaning of the word 'Bethesda,' as defined by biblical writers. It is sufficient to say that the word, as used by the plaintiff, does not describe any quality of the water. It seems to have been adopted to indicate origin or ownership, and to have a name by which the water could be distinguished when bought and sold in the market. The plaintiff has a right to the exclusive use of the word, when employed as a trade-mark, for such purpose. The cases cited on the brief of defendants' counsel clearly recognize such a right. Where the trade-mark, in its original signification or association distinctively points to the origin or ownership

of the article to which it is applied, it will be protected; but where it is a generic or geographical name, designating a city or district of country, or is merely descriptive of the article manufactured, and can be employed with truth by other manufacturers, it is not entitled to legal protection as a trade-mark. Delaware & H. Canal Co. v. Clark, 13 Wall. (U. S.) 311; Brooklyn White Lead Co. v. Masury, 25 Barb. (N. Y.) 416; Wolfe v. Goulard, 18 How. Pr. (N. Y.) 64; Burke v. Cassin, 45 Cal. 468; Stokes v. Landgraff, 17 Barb. (N. Y.) 608; Corwin v. Daly, 7 Bosw. (N. Y.) 222; Caswell v. Davis, 58 N. Y. 223; Taylor v. Gillies, 59 N. Y. 331; Choynski v. Cohen, 39 Cal. 501; Perry v. Truefitt, 6 Beav. 66. But this case does not fall within any of the exceptions stated to the rule in the above cases. Here the plaintiff adopted and applied the name 'Bethesda' to her spring, to mark or distinguish the waters thereof in the market, and she has the right to its exclusive use. It is not intended to, nor does it, indicate the quality or constituents of the water, but rather its origin or ownership."

In Lea v. Wolf (1873) 15 Abb. Pr. (N. S.; N. Y.) 1, 5, Fancher, J.: "Where words or names are in common use, no one person can claim a special appropriation of them to his peculiar use; but where words, and the allocation of words, have, by long use, become known as designating the article of a particular manufacturer, he acquires a right to them as a trade-mark, which competing dealers cannot fraudulently invade. The essence of the wrong is the false representation and deceit. When the improper design is apparent, an injunction should be issued. In such cases, injunctions have been sustained, though the name of a place, or of a celebrated person, were within the trade-mark protected by the injunction. Messerole v. Tynberg, 4 Abb. Pr. (N. S.; N. Y.) 410; Matsell v. Flanagan, 2 Abb. Pr. (N. S.; N. Y.) 457; Amoskeag Mfg. Co. v. Spear, 2 Sandf. (N. Y.) 599; Caswell v. Davis, 4 Abb. Pr. (N. S.; N. Y.) 6; Newman v. Alvord, 49 Barb. (N. Y.) 588, affirmed 51 N. Y. 189; Wotherspoon v. Currie, 27 Law T. (N. S.) 393. * * * As a general rule, geographical names cannot be appropriated as trade-marks, but the rule has its exception where the intention in the adoption of the descriptive word is not so much to indicate the place of manufacture as to intrench upon the previous use and popularity of another's trademark. The order appealed from (13 Abb. Pr. [N. S.; N. Y.] 389) should be modified, and the injunction extended so as to prohibit the use of the words 'Worcestershire Sauce' on the bills, labels, and wrappers of defendants."

CHAPTER III.

WHAT CANNOT BE APPROPRIATED.

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79. Color, Form, Material, or Mode of Construction of Package, Article Manufactured. etc.

§ 60. General rules.

The general rules as to what cannot be appropriated as trade-marks have been stated by the supreme court of the United States in the leading case of Delaware & H. Canal Co. v. Clark, as follows: "No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could,

the public would be injured, rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection. As was said in the well-considered case of Amoskeag Mfg. Co. v. Spear, 2 Sandf. (N. Y.) 599: 'The owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed, but he has no right to the exclusive use of any words, letters, figures, or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. He has no right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.' And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and, could they be appropriated exclusively, the appropriation would result in mischievous monopolies. Could such phrases as 'Pennsylvania wheat,' 'Kentucky hemp,' 'Virginia tobacco,' or 'Sea Island cotton' be protected as trade-marks,—could any one prevent all others from using them, or from selling articles produced in the districts they describe under those appella-

tions,—it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common right of many. It can be permitted only when the reasons that lie at the foundation of the protection given to trade-marks are entirely overlooked. It cannot be said that there is any attempt to deceive the public when one sells as Kentucky hemp or as Lehigh coal that which in truth is such, or that there is any attempt to appropriate the enterprise or business reputation of another who may have previously sold his goods with the same description. It is not selling one man's goods as and for those of another. Nothing is more common than that a manufacturer sends his products to market, designating them by the name of the place where they were made; but we think no case can be found in which other producers of similar products in the same place have been restrained from the use of the same name in describing their goods."[1]

From the foregoing quotation it will be seen that two classes of words are here designated as incapable of appropriation as trade-marks. These are, first, descriptive words: second, geographical names designating districts of country. To these may be added, third, personal names, which cannot be generally appropriated against others bearing the same names, and using them in good faith, but which may be appropriated in any peculiar or fanciful form, even against others bearing the same names. It is thus apparent that nothing can be legally appropriated by any one as a trade-mark which, aside from superiority in excellence, popularity, or cheapness

[1] (1871) 13 Wall. (U. S.) 311. See, also, Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460; Caswell v. Davis (1874) 58 N. Y. 231; Thomson v. Winchester (1837) 19 Pick. (Mass.) 214; Raggett v. Findlater (1873) L. R. 17 Eq. 29; (1849) 2 Sandf. (N. Y.) 599.

of the article bearing it, would practically confer on him a monopoly in the production or sale of like articles.[2] The supreme court of Rhode Island has stated the rules which must be followed in selecting a trade-mark as follows: "A trade-mark is a symbol, arbitrarily selected by a manufacturer or dealer, and attached to his wares to indicate that they are his wares. In selecting such a device, he must avoid words merely descriptive of the article or its qualities, or such as have become so by use in connection with well-known articles of commerce. He must also avoid words, *e. g.*, geographical names, which are descriptive of the local origin of the goods, if other persons have the right to deal in goods of a similar origin."[3]

§ 61. Device not distinctive in character.

From the definition of a trade-mark heretofore given, it is apparent that, unless a mark or device is distinctive in character, pointing unmistakably, either by its own meaning or by association, to the origin or ownership of the article to which it is affixed, it cannot be a valid trade-mark. In Candee v. Deere,[4] it is said by the supreme court of Illinois: "All [courts] concur in saying that the mark must be so clear and well defined as to give notice to others, and must not be deviated from at the suggestion of whim or caprice." Where a series of books were published, on the first of which appeared, as a frontispiece, a representation of a figure in a particular dress, and, as a frontispiece to the subsequent books, other figures, each bearing some slight resemblance to each other and to the first figure, but in different attitudes, with

[2] Brown Chemical Co. v. Meyer (1891) 139 U. S. 540; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[3] Cady v. Schultz (1895) 19 R. I. 193.

[4] (1870) 54 Ill. 439-457.

different surroundings, and each conveying an entirely different impression, it was held that such pictures did not constitute a distinctive device, and could not be held as a trade-mark.[5] In Candee v. Deere, and also in Foster v. Blood Balm Co.,[6] it is questioned whether a person can appropriate two or more trade-marks for the same goods in the same commerce. In a late case decided by the circuit court for the eastern district of Wisconsin it appeared that a manufacturer of toilet paper used a large number of different brands for the same article, and in the bill filed the complainant sought to enjoin the use by the defendant of thirteen different trade-marks. The court found that the brands were used to designate in some cases the quality, and in other cases the size of the sheets. Upon the question whether these different brands could all constitute trade-marks for the same article, the court said: "The principal question which is suggested by the bill and the evidence is whether the manufacturer of a single article has the right to use, and to be protected in the use of, more than one trade-mark for that article. I find little authority upon the subject, and have given to the question much consideration. Upon principle, I think that he cannot. A trade-mark must denote origin. * * * How can that purpose be accomplished if a manufacturer dealing in a single article used a thousand different trade-marks to designate the article and its origin? Such use necessarily produces confusion, and fails of the single purpose of the trade-mark, —to designate with certainty the origin of the product."[7] It would seem, however, to be settled by competent authority, that the rule above stated does not prevent a manufacturer or

[5] Munro v. Smith (1890) 55 Hun (N. Y.) 419.

[6] (1887) 77 Ga. 216.

[7] Albany Perforated Wrapping-Paper Co. v. John Hoberg Co. (1900) 102 Fed. 157.

dealer from appropriating different trade-marks for different grades of goods of the same general kind, or different species of goods of the same genus.[8] Each case is to be tested by considering the primary function of the mark adopted. If the primary function is to denote origin or ownership, and the mark is distinctive, it is a valid trade-mark. If the primary function is to indicate grade or quality, the mark is invalid for the purposes of a trade-mark.

§ 62. Mark that does not primarily indicate origin or ownership.

To constitute a trade-mark, the mark or symbol used must be designed, as its primary purpose, to distinguish each of the articles to which it is affixed from like articles produced by others. If it is originally adopted for some other purpose, such as to designate the size, shape, and capacity of the article, so that any office it may perform as a designation of origin is merely incidental, no trade-mark right is acquired. There can be no valid trade-mark in a device or word which is placed upon an article, not for the purpose of indicating origin, manufacture, or ownership, but merely as designating quality, class, grade, or style.[9] Hence, where it appeared that letters and numerals claimed as a trade-

[8] Cahn v. Gottschalk (1888) 14 Daly (N. Y.) 542; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Scott v. Standard Oil Co. (1894) 105 Ala. 475.

[9] Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 33 C. C. A. 558, 91 Fed. 376; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460; New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co. (1900) 99 Fed. 85; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Humphreys Homeopathic Medicine Co. v. Hilton (1894) 60 Fed. 756; Smith & Davis Mfg. Co. v. Smith (1898) 89 Fed. 486; Beadleston v. Cook Brewing Co. (1896) 20 C. C. A. 405, 74 Fed. 229; Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 321.

mark were adopted to denote or indicate origin or ownership, as well as the shape, size, style, and quality of the complainant's goods, but it did not appear clearly whether such letters or figures were adopted primarily for the purpose of indicating this origin or ownership of the goods, and on the face of the bill and exhibits there was a serious question whether it did not appear that the letters and figures only secondarily pointed to origin or ownership, it was held that the bill could not be sustained.[10] Terms which are descriptive of products, and identify the manufactured article to which they are applied, rather than the manufacturer, cannot be appropriated as trade-marks.[11]

§ 63. Descriptive words.

The general proposition is therefore well established that words which are merely descriptive of the character, qualities, or composition of an article cannot be monopolized as trade-marks.[12] If, however, the primary object of the mark

[10] Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[11] Leclanche Battery Co. v. Western Electric Co. (1885) 23 Fed. 276; Proctor & Gamble Co. v. Globe Refining Co. (1899) 34 C. C. A. 405, 92 Fed. 357; Thomas G. Plant Co. v. May Co. (1900) 100 Fed. 72; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Marcus Ward & Co. v. Ward (1891) 61 Hun, 625, 15 N. Y. Supp. 913; Fetridge v. Wells (1857) 4 Abb. Pr. (N. Y.) 144; Wolfe v. Burke (1873) 7 Lans. (N. Y.) 151; Merriam v. Famous Shoe & Clothing Co. (1891) 47 Fed. 411; Wilcox & Gibbs Sewing Mach. Co. v. The Gibbens Frame (1883) 17 Fed. 623; Hostetter v. Fries (1883) 17 Fed. 620; Smith v. Walker (1885) 57 Mich. 456.

[12] Ayer v. Rushton (1877) 7 Daly (N. Y.) 9; Newman v. Alvord (1867) 49 Barb. (N. Y.) 588; Alden v. Gross (1887) 25 Mo. App. 123; Chadwick v. Covell (1890) 151 Mass. 190; Alff & Co. v. Radam (1890) 77 Tex. 530; Siegert v. Abbott (1893) 72 Hun (N. Y.) 243; Schmidt v. Brieg (1893) 100 Cal. 672; Nokes v. Mueller (1897) 72 Ill. App. 431; Clinton Metalic Paint Co. v. New York Metalic Paint Co. (1898) 23 Misc. Rep. (N. Y.) 66; Scott v. Standard Oil Co. (1894) 106 Ala. 475; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco

be to indicate origin or ownership, the mere fact that, after the adoption of the mark, the article has obtained such a wide sale that the mark has also become indicative of quality, is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. It is no objection to a word used as a trade-mark that it is suggestive of the qualities or grade of the article upon which it is used, if not actually descriptive thereof. Words of common use may be so employed as to acquire a limited additional significance by way of designating a particular article of manufacture or production, and in that sense may be entitled to the protection of the court against an infringement upon such use by others; but when the words signify a fact which others may, by the use of them, express with equal truth, such others

Co. (1890) 104 Mo. 53; Wolfe v. Goulard (1859) 18 How. Pr. (N. Y.) 64; Comstock v. Moore (1860) 18 How. Pr. (N. Y.) 421; Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222; Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192; Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Falkinburg v. Lucy (1868) 35 Cal. 52; Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Choynski v. Cohen (1870) 39 Cal. 501; Wolfe v. Burke (1873) 7 Lans. (N. Y.) 151; Burke v. Cassin (1873) 45 Cal. 467; Chase v. Mayo (1876) 121 Mass. 343; Carmichel v. Latimer (1876) 11 R. I. 395; Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453; Gilman v. Hunnewell (1877) 122 Mass. 139; Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Val Beil v. Prescott (1880) 82 N. Y. 630; Marshall v. Pinkham (1881) 52 Wis. 572; Larrabee v. Lewis (1881) 67 Ga. 561; Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331; Leclanche Battery Co. v. Western Electric Co. (1885) 23 Fed. 276; *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338; Metcalfe v. Brand (1887) 86 Ky. 331; In re Pratt's Appeal (1888) 117 Pa. 401; Putnam Nail Co. v. Dulaney (1891) 140 Pa. 205; Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1900) 99 Fed. 971; Thomas G. Plant Co. v. May Co. (1900) 100 Fed. 72; Koehler v. Sanders (1890) 122 N. Y. 65; Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391; Babbitt v. Brown (1893) 68 Hun (N. Y.) 515; Enoch Morgan's Sons Co. v. Troxell (1882) 89 N. Y. 292.

have an equal right to use them for that purpose.[13] The supreme court of Canada has stated the rule upon this point as follows: "Property can not be acquired in marks, etc., known to a particular trade as designating quality merely, and not, in themselves, indicating that the goods to which they are affixed are the manufacture of a particular person. Nor can property be acquired in an ordinary English word expressive of quality merely, though it might be in a foreign word or word of a dead language."[14]

§ 64. Instances of descriptive words held invalid as trade-marks.

There are numerous instances in the reported cases of descriptive words that have been held invalid as trade-marks. There are many other instances of words that have been held merely suggestive of the qualities of the article upon which they were used, and hence capable of appropriation as trade-marks. Thus, the word "Cream"[15] has been held capable of appropriation as a trade-mark for baking powder, which decision would seem to be sound, while the word "Snowflake"[16] has been held incapable of appropriation as a trade-mark for bread or crackers, on the ground of being "descriprive of whiteness, lightness, and purity." It would seem, however, that this word is suggestive of such qualities, rather than descriptive of them, and that it should have been held capable of appropriation. Other instances of descriptive words incapable of appropriation as trade-marks are as follows: "Iron Bitters,"[17] for a medicinal preparation; "Goodyear

[13] Stokes v. Allen (1890) 56 Hun (N. Y.) 526.

[14] Partlo v. Todd (1888) 17 Can. Sup. Ct. 196.

[15] Price Baking Powder Co. v. Fyfe (1891) 45 Fed. 799.

[16] Larrabee v. Lewis (1881) 67 Ga. 562.

[17] Brown Chemical Co. v. Meyer (1891) 139 U. S. 540.

Rubber,"[18] for rubber articles; "Dr. Johnson's Yellow Ointment";[19] "Velno's Vegetable Syrup,"[20] and "Perry's Medicated Mexican Balm,"[21] each used for a medicine; "Nourishing Stout,"[22] for beer; "Thomsonian Medicines";[23] "Dessicated Codfish";[24] "Julienne Soup";[25] "Paraffin Oil";[26] "Ferro-Phosphorated Elixir of Calisaya Bark";[27] "Microbe Killer";[28] "Sarsaparilla and Iron,"[29] for a medicinal compound or beverage, including sarsaparilla and iron as ingredients; "Compressed Yeast";[30] "Aluminum,"[31] applied to an article of manufacture composed in part of that metal; "Sweet Caporal,"[32] applied to cigarettes; "Fruit,"[33] applied to vinegar; "Fire-Proof Oil,"[34] for an illuminating oil; "Liver Medicine";[35] "Headache Wafers";[36] "Steel Clad,"[37] for

[18] Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598.

[19] Singleton v. Bolton (1783) 3 Dougl. 293.

[20] Canham v. Jones (1813) 2 Ves. & B. 218.

[21] Perry v. Truefitt (1842) 6 Beav. 66.

[22] Raggett v. Findlater (1873) L. R. 17 Eq. 29.

[23] Thomson v. Winchester (1837) 19 Pick. (Mass.) 214.

[24] Town v. Stetson (1868) 5 Abb. Pr. (N. S.; N. Y.) 218.

[25] Godillot v. Harris (1880) 81 N. Y. 263.

[26] Young v. Macrae (1862) 9 Jur. (N. S.) 322.

[27] Caswell v. Davis (1874) 58 N. Y. 223.

[28] Alff & Co. v. Radam (1890) 77 Tex. 530; Radam v. Capitol Microbe Destroyer Co., 81 Tex. 122.

[29] Schmidt v. Brieg (1893) 100 Cal. 672.

[30] Fleischmann v. Newman (1888) 16 N. Y. St. Rep. 794, 2 N. Y. Supp. 608.

[31] American Washboard Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

[32] Hornbostel v. Kinney (1885) 20 Jones & S. (N. Y.) 41.

[33] Alden v. Gross (1887) 25 Mo. App. 123.

[34] Scott v. Standard Oil Co. (1894) 106 Ala. 475.

[35] C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84.

[36] Gessler v. Grieb (1891) 80 Wis. 21.

[37] Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1900) 99 Fed. 976; affirmed (1901) 47 C. C. A. 532, 108 Fed. 624.

shoes; "Trademark—Best Soap";[38] "What is it?" for candy;[39] "Syrup of Figs" or "Fig Syrup," held descriptive in one case, and not descriptive in another (the first decision[40] was by the circuit court of appeals for the sixth circuit, and the other[41] by the circuit court of appeals for the ninth circuit); "Instantaneous,"[42] for a preparation of tapioca; "Taffy Tolu,"[43] applied to chewing gum; "Air Brush,"[44] for an instrument designed for the distribution of pigments by means of an air blast to produce pictures; "Acid Phosphate,"[45] applied to a medicinal preparation; "Straight Cut,"[46] as a trade-mark for cigarettes or smoking tobacco; "Cramp Cure,"[47] applied to a medicine; "Hygienic,"[48] applied to underwear; "Cresylic,"[49] for a compound made from cresylic acid; "Matzoon,"[50] for an article which has been made for centuries in Armenia from sterilized and fermented milk; "Crystallized Egg,"[51] for preserved egg meat; "Indurated Fibre,"[52] applied to wares made of wood pulp; "Patent Roof-

[38] Babbitt v. Brown (1893) 68 Hun (N. Y.) 515.

[39] Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391.

[40] California Fig Syrup Co. v. Frederick Stearns & Co. (1896) 20 C. C. A. 22, 73 Fed. 812.

[41] Worden v. California Fig Syrup Co. (1900) 42 C. C. A. 383, 102 Fed. 334.

[42] Bennett v. McKinley (1895) 13 C. C. A. 25, 65 Fed. 505.

[43] Colgan v. Dezheiser (1888) 35 Fed. 150.

[44] Air-Brush Mfg. Co. v. Thayer (1897) 84 Fed. 640.

[45] Rumford Chemical Works v. Muth (1888) 35 Fed. 524.

[46] Ginter v. Kinney Tobacco Co. (1882) 12 Fed. 782.

[47] L. H. Harris Drug Co. v. Stucky (1891) 46 Fed. 624.

[48] Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co. (1894) 65 Fed. 424.

[49] Carbolic Soap Co. v. Thompson (1885) 25 Fed. 625.

[50] Dadirrian v. Yacubian (1900) 37 C. C. A. 321, 98 Fed. 872.

[51] Lamont v. Leedy (1898) 88 Fed. 72.

[52] Indurated Fibre Co. v. Amoskeag Indurated Fibre Co. (1889) 37 Fed. 695.

ing";[53] "Health Preserving,"[54] for a corset; "Selected Shore Mackerel";[55] "Best Six Cord" and "200 yds.";[56] a sign placed over a man's place of business, with a row of beer barrels painted on it, the letters "P B" stamped or printed on the head of each barrel, the words "Depot of the Celebrated" placed above, and the words "Philadelphia Beer" placed below;[57] "Imperial,"[58] for beer; "Centennial,"[59] for medals: "One Night Cough Cure" and "One Night Corn Cure";[60] "Rye and Rock,"[61] for a mixture of rye whiskey and rock candy; "Borax Soap";[62] "Cherry Pectoral,"[63] for a medicine; "Gold Medal";[64] "Aromatic Schiedam Schnapps,"[65] for gin; "Club House,"[66] for gin; "Old London Dock Gin";[67] "Air-Cell" and "Fire Board";[68] "Clinton Hematite Red" and "Metallic Clinton Paint";[69] "Webster's Dictionary,"[70] for a publication; "Night-Blooming Cereus,"[71] for a perfume.

[53] Fay's Adm'rs v. Fay (1886) 4 Cent. Rep. 241.

[54] Ball v. Siegel (1886) 116 Ill. 137.

[55] Trask Fish Co. v. Wooster (1888) 28 Mo. App. 408.

[56] Coats v. Merrick Thread Co. (1893) 149 U. S. 562.

[57] Eggers v. Hink (1883) 63 Cal. 445.

[58] Beadleston v. Cook Brewing Co. (1896) 20 C. C. A. 405, 74 Fed. 229.

[59] Hartell v. Viney (1876) 2 Wkly. Notes Cas. 602, Fed. Cas. No. 6,158.

[60] Kohler Mfg. Co. v. Beeshore (1892) 53 Fed. 262.

[61] Van Beil v. Prescott (1880) 82 N. Y. 630.

[62] Dreydoppel v. Young (1880) 14 Phila. (Pa.) 226.

[63] Ayer v. Rushton (1877) 7 Daly (N. Y.) 9.

[64] Taylor v. Gillies (1874) 59 N. Y. 331.

[65] Burke v. Cassin (1873) 45 Cal. 467.

[66] Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222.

[67] Bininger v. Wattles (1865) 28 How. Pr. (N. Y.) 206.

[68] New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co. (1900) 99 Fed. 85.

[69] Clinton Metalic Paint Co. v. New York Metalic Paint Co. (1898) 23 Misc. Rep. (N. Y.) 66.

[70] Merriam v. Famous Shoe & Clothing Co. (1891) 47 Fed. 411; Merriam v. Texas Siftings Pub. Co. (1892) 49 Fed. 944.

§ 65. Descriptive words deceptively applied.

It has frequently occurred that a person claiming a descriptive word as a trade-mark has sought to avoid the claim that the word was merely descriptive of the character, qualities, or composition of the article upon which it is used, by showing that such word was not in fact descriptive of such character, qualities, or composition. This, however, brings such word under another and equally fatal rule,—that a court of equity will not lend its aid to sustain a trade-mark when misrepresentations as to the nature or origin of articles are made in, or in connection with, the trade-mark by the aid of which the articles seek a market.[72] "If the word or words are properly applicable to the article, and may be truly used with respect to it, they are descriptive. * * * If they may be read as stating something with respect to the article which is untrue, they are deceptive, * * * so that *quacunque via* the application must fail."[73] This rule is more fully discussed in a subsequent chapter.[74]

§ 66. Words or symbols previously used as marks for like goods.

A valid trade-mark cannot be acquired in a word which has been previously appropriated and used by other parties as a brand for like goods. Thus, where the word "Columbia" was shown to have been in use as a brand upon sacks or barrels of flour long before its appropriation by complainant, it

[71] Phalon v. Wright (1864) 5 Phila. (Pa.) 464.

[72] Church v. Proctor (1895) 13 C. C. A. 426, 66 Fed. 240; Manhattan Medicine Co. v. Wood (1882) 108 U. S. 218; Dadirrian v. Yacubian (1900) 39 C. C. A. 321, 98 Fed. 872, 876; California Fig Syrup Co. v. Putnam (1895) 16 C. C. A. 376, 69 Fed. 740; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523; Koehler v. Sanders (1890) 122 N. Y. 65.

[73] Seb. Trade-Marks (4th Ed.) 351.

[74] Chapter 11.

was held that complainant could have no exclusive right thereto.[75] Where an oil-burning lamp, called the "Astral-Lamp," had been long well known and in common use, the court was of opinion that the word "Astral" was without the range of lawful appropriation as a trade-mark for refined petroleum.[76] Where the word "Matzoon" had been in use in Armenia to designate an article of food made of fermented milk, it was held that such word could not be appropriated as a trade-mark by the manufacturer who first introduced both the name and the article into the United States.[77] Where plaintiffs had invented and prepared a medicine for chest diseases, to which they gave the name of "Cherry Pectoral," and which was extensively sold as "Ayer's Cherry Pectoral," and one of the ingredients was extract of wild cherry, and the word "Pectoral" had been, before the invention of plaintiffs' medicine, applied to medicines for chest diseases, it was held that plaintiffs could not claim the exclusive use of the words "Cherry Pectoral" as a trade-mark.[78] Where the word "Club House" was proven to have been long in use as designating a superior kind of gin used in such establishments, it was held that no one could appropriate such words as a trade-mark.[79] And it was doubted whether plaintiff could appropriate to his own use, as a trade-mark, the picture of an animal, from which not only his own, but the lard of all other dealers and manufacturers, is derived, particularly when the same symbol had been used indiscriminately by dealers in lard and other products of the slaughtered animal.[80] Where A. had adopted, in 1878, and registered in the patent office in 1883, the

[75] Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460.
[76] Pratt Mfg. Co. v. Astral Refining Co. (1886) 27 Fed. 492.
[77] Dadirrian v. Yacubian (1896) 72 Fed. 1010; (1898) 90 Fed. 812.
[78] Ayer v. Rushton (1877) 7 Daly (N. Y.) 9.
[79] Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222.
[80] Popham v. Cole (1876) 66 N. Y. 69.

name "Kaiser" as a trade-mark for natural mineral water, and used it in foreign commerce, selling the water in bottles labeled "Kaiser Natural Mineral Water," with the words "Kaiser Water, Schwalheim," blown in the glass, and it appeared that mineral water known as "Kaiserquelle" or "Kaiserbrunnen," which in English mean "Kaiser Spring," "Kaiser Fountain," had been sold in various places in Europe, with the addition of the name of the place where the spring from which the water was obtained was located, it was held that the word "Kaiser" was not a valid trade-mark, as other parties had acquired and exercised the right to use it.[81]

§ 67. Geographical names.

The rule laid down in Delaware & H. Canal Co. v. Clark [82] has been repeated in many later cases. In that case it was held that the word "Lackawanna," which is the name of a region of country in Pennsylvania, could not, in combination with the word "Coal," constitute a trade-mark, because every one who mines coal in the valley of Lackawanna had a right to represent his coal as Lackawanna coal. Speaking for the court, Mr. Justice Strong said: "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. At the time when they began to use it, it was a recognized description of the region, and of course of the earths and minerals in the region. * * * And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation

[81] Luyties v. Hollendeer (1887) 30 Fed. 632. See, also, Corbin v. Gould (1890) 133 U. S. 308; Hoyt v. Hoyt (1891) 143 Pa. 623.

[82] (1871) 13 Wall. (U. S.) 311-327.

of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and, could they be appropriated exclusively, the appropriation would result in mischievous monopolies. * * * It must be then considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation." And in Columbia Mill Co. v. Alcorn,[83] Mr. Justice Jackson, in delivering the opinion of the court, said: "The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade-mark than he would have been to the use of the word 'America,' or 'United States,' or 'Minnesota,' or 'Minneapolis.' These merely geographical names cannot be appropriated and made the subject of an exclusive property. They do not, in and of themselves, indicate anything in the nature of origin, manufacture, or ownership, and in the present case the word 'Columbia' gives no information on the subject of origin, production, or ownership." It has also been held that the words "East Indian," in connection with "Remedy," placed upon bottles of medicine, were not the subject of a trade-mark. Chief Justice Gray, delivering the opinion of the court in that case, said: "That it is at least doubtful whether words in common use as designating a vast region of country and its products can be appropriated by any one as his exclusive trade-mark, separately from his own or some other name, in which he has a peculiar right."[84] So, where a manufacturer of plows at Moline had

[83] (1893) 150 U. S. 460.

[84] Connell v. Reed (1880) 128 Mass. 477.

been accustomed to brand or stencil upon the beams of his plows, under his name, the words "Moline, Ill.," and subsequently another manufacturer of plows in the same place branded plows which he manufactured there under his own name with the same words, "Moline, Ill.," it was held there was no violation of any right in the former, because he could not acquire any property in those words which only indicated the place at which the plows were made.[85] So, also, where a limited partnership built a furnace called the "Glendon Iron Works," and the same year used the word "Glendon" for stamping their pigs of iron, and a successor corporation continued the business, and adopted and used the mark "Glendon," and finally became the "Glendon Iron Works," and, twenty-three years after the invention and adoption of the mark, the locality of and surrounding the works of said corporation was incorporated as a borough, named "Glendon," it was held by the supreme court of Pennsylvania that the incorporation of said borough by that name deprived the corporation of the exclusive right to the use of the mark "Glendon," and that another corporate manufacturer of iron within said borough could lawfully use said name as a mark for its product.[86] In Clinton Metalic Paint Co. v. New York Metalic Paint Co.[87] the supreme court of New York said that the name of a place or country cannot be exclusively appropriated as a trade-mark for a product or ware of such place or country, as against one offering for sale a similar product or ware of the same place or country, and is only good against one using it for a product or ware not of such place or country. If it be used arbitrarily or fancifully, it is only good against one using it in the same way, and not against one using it truthfully, namely, in its actual meaning. In a case

[85] Candee v. Deere (1870) 54 Ill. 439.
[86] Glendon Iron Co. v. Uhler (1874) 75 Pa. 467.
[87] (1898) 23 Misc. Rep. (N. Y.) 66.

of the kind here referred to, however, such a word should not be considered "good" as a technical trade-mark, even "against one using it for a product or ware not of the same place or country," but relief should be granted on the principle and for the purpose of preventing unfair competition.[88]

[88] See, also, the "Worcestershire Sauce" cases: Lea v. Wolf (1872) 13 Abb. Pr. (N. S.; N. Y.) 389, (1873) 15 Abb. Pr. (N. S.; N. Y.) 1; Lea v. Miller, Seton (4th Ed.) 242; Lea v. Deakin (1879) 11 Biss. 23, Fed. Cas. No. 8,154. See, also: Blackwell v. Wright (1875) 73 N. C. 310; Dunbar v. Glenn (1877) 42 Wis. 118; Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369; Evans v. Von Laer (1887) 32 Fed. 153; Metcalfe v. Brand (1887) 86 Ky. 331; Columbia Mill Co. v. Alcorn (1889) 40 Fed. 676; Langham's Appeal (1889) 28 Pa. 1; New York & Rosendale Cement Co. v. Coplay Cement Co. (1890) 44 Fed. 277; Hoyt v. J. T. Lovett Co. (1895) 17 C. C. A. 652, 71 Fed. 174; Genessee Salt Co. v. Burnap (1895) 67 Fed. 534; Elgin Butter Co. v. Elgin Creamery Co. (1893) 51 Ill. App. 231, (1895) 155 Ill. 127; Cady v. Schultz (1895) 19 R. I. 193; Gabriel v. Sicilian Asphalt Pav. Co. (1898) 23 Misc. Rep. (N. Y.) 534; Morgan Envelope Co. v. Walton (1897) 82 Fed. 469, (1898) 30 C. C. A. 383, 86 Fed. 605; Elgin Nat. Watch Co. v. Illinois Watch-Case Co. (1898) 89 Fed. 487; Illinois Watch-Case Co. v. Elgin Nat. Watch Co. (1899) 35 C. C. A. 237, 94 Fed. 667; Atwater v. Castner (1898) 32 C. C. A. 77, 88 Fed. 642; Coffman v. Castner (1898) 31 C. C. A. 55, 87 Fed. 457; Castner v. Coffman (1899) 178 U. S. 168.

In Lea v. Deakin (1879) 11 Biss. 23, 24, Fed. Cas. No. 8,154, Drummond, J.: "I think the proof establishes that there has long been known in the market a certain kind of sauce, used for the table on fish and meats of various kinds, as 'Worcestershire Sauce'; that it is a sort of generic term given to this kind of sauce from the fact that it was originally manufactured in Worcestershire, England. It seems to have been manufactured also in other places, and the term 'Worcestershire Sauce' seems to have been applied to that species of sauce. Under the circumstances, therefore, it can hardly be claimed that the plaintiffs, simply because they reside in Worcestershire, and manufacture a sauce which they call 'Worcestershire Sauce,' have the sole right to the application of the term to that species of sauce. I think that the proof also shows that the plaintiffs have been cognizant for many years of the fact that there was this kind of sauce manufactured to which the term was applied; that for many years they took no steps to prevent the parties

§ 68. Personal names.

A person cannot make a trade-mark of his own name, and thus obtain a monopoly of it, so as to debar any other person

from manufacturing the sauce; and that, therefore, there may be said to have been something in the nature of an acquiescence in the manufacture of the sauce."

In Genessee Salt Co. v. Burnap (1895) 67 Fed. 534, 535, Ricks, D. J.: "The facts in this case show that defendants are manufacturing their salt in the Genessee valley, and to prevent them from using the word 'Genessee' as descriptive of their salt would be to give the plaintiff a monopoly of that word, which the law does not intend to give. * * * Injunction denied beyond restraining defendants from combining the words 'Genessee,' 'Salt,' 'Co.,' and 'Factory Filled,' to resemble plaintiff's combination. Defendants are entitled to use the name 'Genessee,' representing the locality of the manufacture of the salt, but not to use it in any color, style, or form of letters or in combination, so as to imitate plaintiff's combination."

In Hoyt v. J. T. Lovett Co. (1895) 71 Fed. 173, 177, Wales, D. J.: "The words 'Green Mountain,' being used to denote the place of origin of the article to which they were affixed, and the fact that this article is a natural product, bring the present case within the rule laid down in Delaware & H. Canal Co. v. Clark [13 Wall. (U. S.) 311] and Columbia Mill Co. v. Alcorn [150 U. S. 460], already cited. * * * The name ['Green Mountain'] given to the vine and to the grape is geographical, designating a particular district or country, and cannot be employed by the complainants to the exclusion of others who deal in similar articles originating in the same locality."

In Siegert v. Abbott (1893) 72 Hun (N. Y.) 243, 245, Follett, J.: "To constitute a valid trade-mark, the designation or term applied to the article must be one which the claimant has the exclusive right to use. Delaware & H. Canal Co. v. Clark, 13 Wall. (U. S.) 311. It is apparent on principle, and it is well settled by authority, that no one can acquire the exclusive right to use a geographical name or a term which denotes the nature of the article to which it is applied. Caswell v. Davis, 58 N. Y. 223; Keasbey v. Brooklyn Chemical Works, 50 N. Y. St. Rep. 483, 21 N. Y. Supp. 696."

In Evans v. Von Laer (1887) 32 Fed. 153, 154, Colt, J.: "The complainants by their bill claim, as against the defendant, the exclusive use of the word 'Montserrat' as a designation for lime juice. Montserrat is the name of a small island in the West Indies, and

of the same name from using his own name in his business, even though both pursue the same kind of business; and no

the complainants, who reside in Liverpool, are the consignees of the Montserrat Company, Limited, a corporation having large plantations on the island. The defendant lives in Boston, and is a dealer in lemon and lime-fruit juice. * * * The evidence is that the defendant, or Von Laer & Co., bought lime juice on the island and had it shipped to this country. * * * In the absence of fraud, the complainants cannot enjoin the defendant from the use of a geographical name. This was settled in the case of Delaware & H. Canal Co. v. Clark, 13 Wall. (U. S.) 311, where the court refused to enjoin the defendant against calling their coal 'Lackawanna Coal,' and where it was held that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation."

In Laughman's Appeal (1889) 128 Pa. 1, 22, Clark, J.: "These lands, for many years prior to the time [1874] that the plaintiffs adopted their trade-name ['Sonman,' for their coal], were, as we have seen, known as the 'Sonman Survey.' Its boundaries were marked and defined upon the map of Cambria county. The village erected thereon was Sonman; the post office was Sonman; the railroad station was Sonman; the telegraph office was Sonman; the coal taken from the mines was shipped as Sonman coal, and, by this description, was known in the market. Can it be doubted that the term 'Sonman,' in the year 1874, was a name descriptive of a locality? If it was, the name, when applied to its own natural products, must be taken in its geographical sense. We do not say that a geographical name may not in some cases or under some circumstances, be applied as a trade-name, but we do say that, when the article to which it is applied is a product of the place named, the term cannot be used as a trade-name by one, to the exclusion of others, owners of like products of the same place. This is the doctrine of all the cases."

In Elgin Butter Co. v. Elgin Creamery Co. (1893) 51 Ill. App. 231, 232, Gary, J.: "In effect, the plaintiff claims an exclusive right to the name of Elgin in connection with the butter business, unless, at least, if used by another corporation, that corporation has its factory actually within the township [congressional township including the city of Elgin]. This is too broad a claim. Without inquiry whether the plaintiff might not be entitled to some kind of

priority, duration, or publicity of use, or combination thereof, in any such case, will create any claim or right to such monopoly.[89]

relief, having no aid of counsel in such inquiry, we hold that the demurrer to the bill was rightly sustained, upon the principle stated in Candee v. Deere, 54 Ill. 439, and Bolander v. Peterson, 136 Ill. 215, 35 Ill. App. 551, that the name of a place cannot be, by one

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[89] In Wolfe v. Burke (1873) 7 Lans. (N. Y.) 151, 156, Gilbert, J.: "A man cannot make a trade-mark of his name, to the exclusion of a like use of it by another, who bears the same name, if the use by the latter is fair, and unaccompanied by any contrivance to deceive."

In Meneely v. Meneely (1875) 62 N. Y. 427, 432, Rapallo, J.: "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."

In England v. New York Pub. Co. (1878) 8 Daly (N. Y.) 375, 377, Charles P. Daly, C. J.: "It is well settled, as a general proposition, that a person has the legal right to use his own name to designate an article produced and sold by him, although another person of the same name has previously manufactured and sold the like article with the same designation. Burgess v. Burgess, 17 Jur. 292, 22 L. J. Ch. 675, 17 Eng. Law & Eq. 257; Meneely v. Meneely, 1 Hun (N. Y.) 367; Wolfe v. Burke, 7 Lans. (N. Y.) 156; Faber v. Faber, 49 Barb. (N. Y.) 359; Browne, Trade-Marks, §§ 206, 423."

In Pratt's Appeal (1888) 117 Pa. 401, 411, Paxson, J.: "The mere name of a person or of a place cannot, as a general rule, be appropriated as a trade-mark; at least not in the sense of preventing another person having the same name, or residing in the same place, from using it."

In American Cereal Co. v. Eli Pettijohn Cereal Co. (1896) 72 Fed. 903, 907, Showalter, Cir. J.: "But William A. Pettijohn and his assigns could not, by extensively advertising the name 'Pettijohn,' prevent Eli Pettijohn, who has for nearly twenty years been making or selling the same product, from selling or manufacturing in any part of the United States under the name 'Eli Pettijohn.'" See, also, Faber v. Faber (1867) 49 Barb. (N. Y.) 357, 358; Helmbold v. Henry T. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453, 459; Marshall v. Pinkham (1881) 52 Wis. 572, 585; Williams v. Farrand (1891) 88 Mich. 473, 493-498; Bingham School v. Gray (1898) 122 N. C. 699, 707.

§ 69. Pseudonym or nom-de-plume.

An author cannot, by the adoption of a *nom-de-plume,* be allowed to defeat the well-settled rules of the common law

to the exclusion of others, appropriated as a trade-name." Affirmed (1895) 155 Ill. 127.

In Elgin Butter Co. v. Elgin Creamery Co. (1895) 155 Ill. 127, 135, Baker, J.: "The bill proceeds upon the theory that the name 'The Elgin Butter Company,' and the claimed addition thereto of the words 'Proprietor of the Elgin Creamery,' are the trade-name and trade-mark of complainant, and that it has the exclusive right and property in both said corporate name and said addition, and that no other person or corporation has a legal right to combine the word 'Elgin' with either the word 'butter' or the word 'creamery,' in conducting his or its business. * * * It cannot be admitted that complainant, by using upon its letter heads, price lists, and other stationery, in connection with its corporate name of 'The Elgin Butter Company,' the additional words 'Proprietor of the Elgin Creamery,' has acquired such a property in and monopoly of the words 'Elgin,' 'butter,' and 'creamery' as that no one else can lawfully use the first of said words in connection with either of the other two,—even when they can truthfully be so used. Nor can it be conceded that farmers in and around the city of Elgin cannot sell the butter that they make as 'Elgin butter,' nor are they precluded from truthfully designating the places where they severally make their butter as creameries at Elgin. And no more can such a concession be allowed as against the right of any other person or corporation engaged in the business of manufacturing, dealing in, or selling butter made at a creamery in Elgin, and out of milk and dairy supplies produced in Elgin. As was said by the supreme court of the United States in Delaware & H. Canal Co. v. Clark, 13 Wall. (U. S.) 311: 'It must, then, be considered as sound doctrine, that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from using the same designation.' Like doctrine has been announced by this court, and in equally emphatic language. Candee v. Deere, 54 Ill. 439; Bolander v. Peterson, 136 Ill. 215. And to the same effect are the cases of Glendon Iron Co. v. Uhler, 75 Pa. 467; Laughman's Appeal, 128 Pa. 1, and Brown Chemical Co. v. Meyer, 139 U. S. 540. * * * The judgment of the appellate court [51 Ill. App. 231] is affirmed."

In Brooklyn White Lead Co. v. Masury (1857) 25 Barb. (N. Y.)

in force in this country, that the publication of a literary work without 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.[90]

§ 70. Legislative incorporation of personal name.

In a comparatively recent case, the court of last resort of North Carolina declared: "The incorporation of the Bingham School at Asheville, N. C., has only the usual effect of a charter, *i. e.*, to confer the corporate rights of perpetual succession, suing and being sued, exemption from personal liability of stockholders, and the like. It did not have the effect of creating a trade-mark of the Bingham name, and of conferring the exclusive right to use it, in connection with school purposes, upon that corporation, nor is it a prohibition upon all others named Bingham, whether of that family or of any other of the same name, using it in connection with any school they might establish. Such an idea was foreign to the legislative mind, and it is beyond the scope of the powers of the state legislature to establish a monopoly in a family name, or to confer a patent right in its use."[91]

§ 71. Use of personal name as trade-mark for contract term.

In a recent case in the United States circuit court of ap-

416, Mitchell, P. J.: "As they [plaintiff and defendant] both dealt in the same article, and both manufactured it at Brooklyn, each had the same right to describe it as Brooklyn white lead, and it is shown that many other companies had used the same designation."

In Blackwell v. Wright (1875) 73 N. C. 310, 314, Bynum, J.: "Nor can the word 'Durham,' the name of the town where both parties are doing business, be exclusively appropriated as a trade-mark."

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[90] Clemens v. Belford (1883) 14 Fed. 728, 732.

[91] Bingham School v. Gray (1898) 122 N. C. 699, 709.

peals, second circuit, it appeared that one Hiram Duryea was for many years the president and a stockholder of a corporation which made and sold starch in packages having thereon the name "Duryea's Starch" in prominent letters, and also a picture of the manufacturing buildings, and the name of the company. After the starch had thus been sold for many years, and had become identified with the company, the latter sold its business, trade-marks, and goodwill to another corporation, which continued the use of the package containing the name and picture, with its own name as manufacturer, Duryea agreeing not to go into the starch business for five years. At the expiration of this time, Duryea furnished capital to his sons, who, with others, formed a partnership as "Duryea & Co.," and procured other starch to be made for them under their direction and superintendence as to manufacture and improvement thereof, and sold it as "Starch Prepared by Duryea & Co.," but used strikingly different labels and packages, and it was held that this was a proper use by Hiram Duryea and sons of their own name, and could not be enjoined.[92]

§ 72. Personal name may become generic.

A personal name may be so used in connection with an article of manufacture as to become generic, and hence incapable of exclusive use as to the designation of such article. An instance of this is found in a recent case in the United States circuit court for the northern district of Illinois, in which it appeared that one Baron Liebig, an eminent German chemist, had published in 1847 a formula by which an extract of meat was obtained free from gelatine and fat. This extract was manufactured by the Royal pharmacy in Munich, and was designated as "Liebig's Extract of Meat," with the per-

[92] National Starch Mfg. Co. v. Duryea (1900) 101 Fed. 117, 119.

mission of Baron Liebig. Later a corporation was organized to manufacture the extract in South America on a large scale, and it was succeeded by the complainant corporation. The court held that the name had become generic on account of its use by the Royal pharmacy with Baron Liebig's consent, and that the complainant, having entered the markets of the United States after the name had become generic, could not maintain any exclusive trade-mark right thereto.[93]

§ 73. Personal name descriptive of medical preparation.

It has been held that the words "Liver Medicine" are purely descriptive, and cannot be appropriated by the complainant to indicate its preparation alone, nor can the word "Simmons," in connection with the words "Liver Medicine," be appropriated by the complainants to its preparation alone; that name under the proof having become merely descriptive of medicine prepared under the formula of old Dr. Simmons, and used by many people in connection with medicines prepared under that formula.[94]

§ 74. Mere use of like personal name by competing owners.

Where two persons, of the same name or surname, are competitors in business, and either uses such personal name or surname as a trade-mark or trade-name in his business, any injury resulting to one from such mere use by the other is without legal remedy.[95]

[93] Liebig's Extract of Meat Co. v. Libby (1900) 103 Fed. 87-89.

[94] C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84, 119; citing, for support of the rule, Marshall v. Pinkham (1881) 52 Wis. 572, 587, 588.

[95] In Faber v. Faber (1867) 49 Barb. (N. Y.) 357, 358, Sutherland, J.: "But the defendant, Faber, has 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 [Faber] has

§ 75. Letters or numerals used for certain purposes.

Letters or numerals, one or more of each, or combined together, cannot be appropriated as a trade-mark for a vendible article to which attached, when used for the purpose merely of indicating the name[96] of such article; or its mode or process of manufacture;[97] or its nature;[98] or its kind;[99] or its quality;[100] or its grade;[101] or its size;[102] or its meas-

suffered, or may suffer, by such use of the defendant Faber's name merely, must be viewed as an injury without a remedy."

In Meneely v. Meneely (1875) 62 N. Y. 427, 431, Rapallo, J.: "The manner of using the name is all that would be enjoined, not the simple use of it, for 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. * * * Where the only confusion created is that which results from the similarity of the names, the courts will not interfere." See, also, Marshall v. Pinkham (1881) 52 Wis. 572, 585; Williams v. Farrand (1891) 88 Mich. 473, 494.

[96] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599, 600, 610-612. Citing in support of positions held: Singleton v. Bolton (1783) 3 Dougl. 293; Canham v. Jones (1813) 2 Ves. & B. 218; Perry v. Truefitt (1842) 6 Beav. 66; Lafean v. Weeks (1896) 177 Pa. 412.

[97] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599.

[98] Candee v. Deere (1870) 54 Ill. 439.

[99] Candee v. Deere (1870) 54 Ill. 439.

[100] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Candee v. Deere (1870) 54 Ill. 439; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331; Avery v. Meikle (1883) 81 Ky. 73; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 11 Sup. Ct. 396; Smith & Davis Mfg. Co. v. Smith (1898) 89 Fed. 486; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[101] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1887) 31 Fed. 776; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 11 Sup. Ct. 396; Smith & Davis Mfg. Co. v. Smith (1898) 89 Fed. 486.

[102] Candee v. Deere (1870) 54 Ill. 439; Magee Furnace Co. v. Le Barron (1879) 127 Mass. 115; Avery v. Meikle (1883) 81 Ky. 73; Marcus Ward & Co. v. Ward (1891) 15 N. Y. Supp. 913; Deering

urement;[103] or its dimensions;[104] or its place in a machine;[105] or its capacity or capability;[106] or its shape;[107] or its style;[108] or its class;[109] or its membership in a class.[110] And although, from long use for any one or more of the purposes aforesaid, such letters or figures, or combinations thereof, come to indicate the origin or ownership of the vendible article to which attached, such fact cannot entitle them to appropriation as a trade-mark, where they are primarily used for another purpose.[111] And if primarily adopted and designed to indicate origin or ownership, their subsequent use for any one or more of the purposes aforesaid will not deprive them of the characteristics of a trade-mark.[112]

Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651,—citing in support, Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537.

[103] Magee Furnace Co. v. Le Barron (1879) 127 Mass. 115.

[104] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Marcus Ward & Co. v. Ward (1891) 15 N. Y. Supp. 913.

[105] Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1897) 86 Fed. 764; Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376.

[106] Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376.

[107] Candee v. Deere (1870) 54 Ill. 439; Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[108] Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 11 Sup. Ct. 396; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[109] Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1887) 31 Fed. 776; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 11 Sup. Ct. 396.

[110] Humphreys Homeopathic Medicine Co. v. Hilton (1894) 60 Fed. 756; Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376.

[111] Avery v. Meikle (1883) 81 Ky. 73; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 11 Sup. Ct. 396; Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376.

[112] Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S.

§ 76. Mere color of advertisements, labels, and manufactured articles.

In a recent case, the supreme court of New York said: "The plaintiff has adopted green as the distinctive color of its advertisement and labels, and the liniment itself is green. * * * The defendants have put upon the market a soap which they term 'Omega Oil Medicated Soap,' and claim it to be useful for skin and scalp troubles. The soap is green in color, as are likewise the paper wrapper in which each cake is inclosed, and the box in which the cakes are packed. * * * If the words [Omega Oil] constituting plaintiff's trade-mark be omitted from the soap, the mere use of the green color in the soap or on the wrapper or box cannot be enjoined."[114]

§ 77. Material.

The rule in reference to the use of materials has been stated by the United States circuit court for the northern district of Illinois as follows: "But the claim of this bill is that no person other than complainants has a right to use upon plug tobacco a piece of tin, of any shape or color, or with any legend or mark or sign upon it, as a manufacturer's or deal-

537, 11 Sup. Ct. 396; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

In Avery v. Meikle (1883) 81 Ky. 73, Hargis, Ch. J.: "The alphabet, English vocabulary, and 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, in which all have an equal share and character of interest. From these fountains, whoever will may drink, but an exclusive right to do so cannot be acquired by any. And the appellants, having drawn from the common fountain the letters and numerals named, cannot claim an exclusive right to them or their use."

[114] Omega Oil Co. v. Weschler (1901) 35 Misc. Rep. (N. Y.) 441-443.

er's mark, or designation of the origin of the goods. * * * A person may appropriate any word, figure, or emblem as a trade-mark, but that does not give an exclusive right to the use of the well-known material substances upon which the word, figure, or emblem may be impressed or engraved."[115]

§ 78. Parts of mark designed to indicate facts other than origin or ownership.

A trade-mark is frequently designed to convey information as to several distinct and independent facts, and therefore contains separate words, marks, or signs applicable to each, thus indicating not only the origin or ownership of the article or fabric to which it is attached, but its appropriate name, the mode or process of its manufacture, and its peculiar or relative quality. It is certain, however, that the use by another manufacturer of the words or signs indicative of these circumstances may yet have the effect of misleading the public as to the true origin of the goods; but it would be unreasonable to suppose that he is therefore precluded from using them as an expression of the facts which they really signify, and which may be just as true in relation to his goods as to those of another. Purchasers may be deceived; they may buy the goods of one person as those of another, but they are not deceived by a false representation: they are deceived because certain words or signs suggest a meaning to their minds which they do not in reality bear, and were not designed to convey.[116]

§ 79. Color, form, material, or mode of construction of package, article manufactured, etc.

As incapable of appropriation as trade-marks have been

[115] Lorillard v. Pride (1886) 28 Fed. 434, 438-440.

[116] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599, 609, 610.

held the following: A particular colored paper, or kind of paper, for covering or inclosing lead pencils by the gross in a book form, or any particular form.[117] A package of peculiar form and dimensions, or a bottle, or vessel, or package, without having imprinted upon or connected with it some other symbol, word, letter, or form.[118] A label of given material, dimensions, and color. A label is not a trade-mark, as recognized at common law, though it may in fact contain no words, figures, etc., except those which constitute the trade-mark.[119] A tin pail with a bail or handle to it, the tin ornamented with a geometrical pattern, and used to contain paper collars for sale, and sold with the collars.[120] A longitudinal straight line, crossed at right angles by equidistant straight lines, upon plug tobacco, along and by which to cut the plug in equal parts.[121] A package with a blue band and gold lettering, the package being of a form appropriate and usual for putting up small cakes of soap.[122] "The

[117] Faber v. Faber (1867) 49 Barb. (N. Y.) 357.

[118] Moorman v. Hoge (1871) 2 Sawy. 78, 89, Fed. Cas. No. 9,783. In Clinton Metalic Paint Co. v. New York Metalic Paint Co. (1898) 23 Misc. Rep. (N. Y.) 66, 69, Gaynor, J.: "Actual barrels, boxes, and the like may not be appropriated for trade-marks, for their particular size, style, or shape, but this has reference only to the physical objects themselves, and not to pictures or devices of them for labels or brands. Moorman v. Hoge, 2 Sawy. 78, Fed. Cas. No. 9,783; Enoch Morgan's Sons Co. v. Troxell, 89 N. Y. 292; Fischer v. Blank, 138 N. Y. 244; Brown, Trade-Marks, § 138. The cases sometimes cited to the contrary are not so, in fact, covering, as they do, combinations of package, color, and label. Cox, Man. Trade-Mark Cas., Index, 'Packages.'"

[119] Burke v. Cassin (1873) 45 Cal. 467, 481; Falkenburg v. Lucy (1868) 35 Cal. 52.

[120] Harrington v. Libby (1877) 14 Blatchf. 128, Fed. Cas. No. 6,107.

[121] Dausman & Drummond Tobacco Co. v. Ruffner (1878) 15 Official Gazette, 559, Fed. Cas. No. 3,585.

[122] Enoch Morgan's Sons Co. v. Troxell (1882) 89 N. Y. 292, 297.

shape and construction of the plows, * * * further than their subjection to the use of the mark to indicate their origin and make, is necessary to render the trade-mark property."[123] The color of a label, apart from any name, figure, or device with which it may be connected; the form of a package.[124] Directions, advertisements, notices, etc.; the form, appearances, or finish of goods; the form or color of a package or box.[125] The merchandise itself; the arrangement of differently colored packages (of soap) in the box.[126] The form of the sticks of chewing gum manufactured; the peculiar form and decoration of the boxes therefor; the manner in which the gum might be placed in the box.[127] Packages of peculiar form and color, unaccompanied by any distinguishing symbol, letter, sign, or seal.[128] A particular color, unaccompanied by any mark or symbol.[129] The article manufactured, a bronzed horseshoe nail.[130] The name of the book published and sold, "Webster's Dictionary;" a certain form or size of the book published; the device of a book with the name thereof, "Webster's Dictionary," printed thereon, used on circulars, bill heads, etc.[131] The size or shape or mode of construction of

[123] Avery v. Meikle (1883) 81 Ky. 73, 87; Candee v. Deere (1870) 54 Ill. 439, 461.

[124] Fleischmann v. Starkey (1885) 25 Fed. 127, 128.

[125] Ball v. Siegel (1886) 116 Ill. 137, 143.

[126] Davis v. Davis (1886) 27 Fed. 490, 492.

[127] Adams v. Heisel (1887) 31 Fed. 279, 280.

[128] Philadelphia Novelty Mfg. Co. v. Rouss (1889) 40 Fed. 585, 587; Fairbanks v. Jacobus (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608; Wilcox & Gibbs Sewing Mach. Co. v. The Gibbens Frame (1883) 17 Fed. 623; Brown Chemical Co. v. Stearns (1889) 37 Fed. 360.

[129] Philadelphia Novelty Mfg. Co. v. Blakesley Novelty Co. (1889) 40 Fed. 588.

[130] Putnam Nail Co. v. Dulaney (1891) 140 Pa. 205, 212, 213.

[131] Merriam v. Famous Shoe & Clothing Co. (1891) 47 Fed. 411, 413; Merriam v. Texas Siftings Pub. Co. (1892) 49 Fed. 944, 947, 948.

a box, barrel, bottle, or package in which goods may be put.[132] Color alone; a red label on a yellow wrapper; a white label; a red box.[133] The form of package and fashion of label.[134] Package boxes of particular shape and of uniform size and general appearance; mathematical lines; styles of printing or colors.[135] A tobacco box of the ordinary form in common use in many localities.[136]

[132] Hoyt v. Hoyt (1891) 143 Pa. 623, 638, 639.

[133] Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16, 17; In re Hanson's Trade-Mark (1887) 37 Ch. Div. 112.

[134] Brown v. Doscher (1895) 147 N. Y. 647, 651.

[135] Lafean v. Weeks (1896) 177 Pa. 412, 422-432.

[136] Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 80 Fed. 105, 107.

CHAPTER IV.

APPROPRIATION AND APPLICATION OF TRADE-MARKS.

§ 80. By Whom Trade-Marks may be Acquired and Held.
81. Trade-Mark Acquired by Importer of Manufactured Article.
82. Trade-Mark Acquired by Selector of Commercial Article.
83. Trade-Mark Acquired by Manufacturer in Limited Sense.
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87. Priority of Adoption.
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90. How Trade-Mark may be Acquired and Held.
91. Use Necessary to Support Claim to Trade-Mark.
92. Use, not Invention, of Trade-Mark that Creates Right.
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94. Declaration of Claimant cannot Lay Foundation of Right.
95. Voice of Public cannot Appropriate Trade-Mark to Individual.
96. Use by One Claimant will not Prevent Adoption by Another for Different Article.
97. Trade-Marks Also Acquired by Transfer.
98. To What Trade-Marks may be Applied.
99. How Trade-Marks may be Applied.

§ 80. By whom trade-marks may be acquired and held.

A common-law trade-mark may be acquired by any person, firm, or corporation.[1] The same rights are accorded by the courts of this country, in this respect, to aliens and citizens.[2]

[1] Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946.
[2] Taylor v. Carpenter (1844) 3 Story, 458, Fed. Cas. No. 15,784;

A trade-mark may be acquired by the manufacturer, producer, or vendor of a commercial article.[3] Usually such trade-marks are appropriated and applied by the manufacturer, but a vendor who has established a particular trade-mark which he uses to distinguish an article sold by him is entitled to be protected in its use, although he does not manufacture the goods.[4]

Derringer v. Plate (1865) 29 Cal. 292, 296; Kerry v. Toupin (1894) 60 Fed. 272. See, also, Collins v. Brown (1857) 3 Kay & J. 423.

[3] Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 603, affirmed (1844) 11 Paige (N. Y.) 292 (1846) 2 Sandf. Ch. (N. Y.) 611.

[4] Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Walton v. Crowley (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277; Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946; Holt v. Menendez (1885) 23 Fed. 869; Menendez v. Holt (1888) 128 U. S. 514, 9 Sup. Ct. 143; Societe des Hulles d'Olive de Nice v. Rorke (1896) 5 App. Div. (N. Y.) 175; McLean v. Fleming (1877) 96 U. S. 245.

In McLean v. Fleming (1877) 96 U. S. 245-253, Clifford, J.: "Everywhere courts of justice proceed upon the ground that a party has a valuable interest in the goodwill of his trade, and in the labels or trade-mark which he adopts to enlarge and perpetuate it. Hence it is held that he, as proprietor, is entitled to protection as against one who attempts to deprive him of the benefits resulting from the same, by using his labels and trade-mark without his consent and authority. * * * Such a proprietor, if he owns or controls the goods which he exposes to sale, is entitled to the exclusive use of any trade-mark adopted and applied by him to the goods, to distinguish them as being of a particular manufacture and quality, even though he is not the manufacturer, and the name of the real manufacturer is part of the device. Walton v. Crowley, 3 Blatchf. 440, Fed. Cas. No. 17,133; Emerson v. Badger, 101 Mass. 82."

In Falkinburg v. Lucy (1868) 35 Cal. 52, 64, Sanderson, J.: "By the common law, the manufacturer of goods, or the vendor of goods for whom they have been manufactured, has a right to designate them by some peculiar name, symbol, figure, letter, form, or device, whereby they may be known in the market as his, and be distinguished from other like goods manufactured or sold by other persons. The owner of such peculiar marks, provided they are original with him, will be protected in their exclusive use by the courts.

§ 81. Trade-mark acquired by importer of manufactured article.

Thus, in the case of Godillot v. Harris,[5] where plaintiff had devised the ingredients of a vegetable compound, which was manufactured and put up in Paris for him, was imported

but only so far as such marks serve to designate the true origin or ownership of the goods to which they are attached. He will not be protected in the use of figures or symbols or combinations of words which serve merely to indicate the name, kind, or quality of the goods to which they are attached, notwithstanding they may be interblended with others which indicate origin and ownership. Fetridge v. Wells, 4 Abb. Pr. (N. Y.) 144; Amoskeag Mfg. Co. v. Spear, 2 Sandf. (N. Y.) 599; Stokes v. Landgraff, 17 Barb. (N. Y.) 608."

In Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946, 952, Fenner, J.: "A corporation is entitled to have its trade-mark, as well as a private individual, and may sue for its infringement. * * * The objection that the oil is not directly manufactured by plaintiff, but only manufactured by others under plaintiff's orders and directions, is of no force. The authorities are clear that, in such case, the seller is as much entitled to protection in his trade-mark as if he were the manufacturer."

In Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277, 283, Bakewell, J.: "The owner of goods which he exposes to sale in market in his own right is entitled to the exclusive use of any trade-mark devised and applied by him to distinguish them as being of a particular manufacture or quality, although he is not himself the manufacturer. Walton v. Crowley, 3 Blatchf. 440, Fed. Cas. No. 17,133."

In Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5-8, Monell, C. J.: "The right to protection is not exclusively in the manufacturer. The person for whom the goods are manufactured (Amoskeag Mfg. Co. v. Spear, 2 Sandf. [N. Y.] 599; Walton v. Crowley, 3 Blatchf. 440, Fed. Cas. No. 17,133), and the vendor who sells, and who may have no direct relation to the manufacturer, has such right (Partridge v. Menck, 2 Barb. Ch. [N. Y.] 103; Taylor v. Car-

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[5] Godillot v. Harris (1880) 81 N. Y. 263, 266, Danforth, J.: "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. It may represent to the purchaser the quality of the

by him, and sales were made in the names of third persons, but he was interested in the result, and, to designate the article, plaintiff had prepared and had engraved and printed

penter, 2 Sandf. Ch. [N. Y.] 614). * * * And Beardsley, J., says, in Taylor v. Carpenter (supra): 'It is immaterial that the complainants were not admitted to be the manufacturers of the article. It was conceded that they were the vendors, and engaged in the sale of it.' In Lee v. Haley (39 Law J. 284), the plaintiffs were dealers in coal, a natural product in the general reach of all dealers, yet the court protected the goodwill of a business represented by a particular style of address. It sufficiently appears from the evidence that the plaintiff is in a position to entitle him to adopt a trade-mark to designate the goods in question. They were manufactured exclusively for him, and, within the authorities I have cited, he, as the vendor, had a right to establish a reputation for the quality of the article he sold, and perpetuate it by a device which would denote its origin and ownership. If he had done so, he should be protected in its exclusive use."

In Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 137 Ill. 231, 233, Scholfield, C. J.: "A trade-mark is not a franchise. It is not a privilege emanating from the sovereign power of the state, owing its existence to a grant, but it is, on the contrary, the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, and distinguish them from those manufactured or sold by another. Upt. Trade-Marks, c. 1, p. 9; Candee v. Deere, 54 Ill. 439."

In Smith v. Walker (1885) 57 Mich. 456, 473, Sherwood, J.: "By the common law, 'every manufacturer, and every merchant for whom goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the markets for which he intends them, that he may thus secure the profits that their superior repute, as his, may be the means of gaining.'"

In Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599, 605, Duer, J.: "Every manufacturer, and every merchant for whom

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thing offered for sale, and in that case is of value to any person interested in putting the commodity to which it is applied upon the market. This was the plaintiff's position. He was not the actual manufacturer of the 'Julienne,' but the trial court found, and there is evidence to sustain the finding, 'that it was manufactured and put up in Paris expressly for him.' He devised the ingredients, and

a label containing words designating the origin of the article itself, which he attached to the packages as a trade-mark, and where defendant, after a market had been established for the article, prepared and offered for sale substantially the same kind of goods, placing upon the packages a label so nearly like that of plaintiff's that a buyer would be easily deceived, it was held that plaintiff had acquired the right to the use of the trade-mark by its prior use and application, although the goods were manufactured for and not by him.

§ 82. Trade-mark acquired by selector of commercial article.

In Menendez v. Holt,[6] Chief Justice Fuller, in delivering the opinion of the United States supreme court, said: "The fact that Holt & Co. were not the actual manufacturers of the flour upon which they had for years placed the brand in question does not deprive them of the right to be protected in the use of that brand as a trade-mark. They used the words 'La Favorita' to designate flour selected by them, in the exercise of their best judgment, as equal to a certain

goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the market for which he intends them, and that he may thus secure the profits that their superior repute, as his, may be the means of gaining."

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became the importer of the prepared article. To designate the substance, when so prepared for sale, he designed and had engraved and printed a label, which he attached to the packages containing it. He was interested in the result of sales, and, although these were made in the names of third persons, and not his own, his legal right to protection is the same."

[6] (1888) 128 U. S. 514. See, also, Mayer v. Flanagan (1896) 12 Tex. Civ. App. 405, 34 S. W. 785.

In Walton v. Crowley (1856) 3 Blatchf. 440, 448, Fed. Cas. No. 17,133, Betts, J.: "The person for whom goods are manufactured has the same legal right to affix and maintain a special trade-mark as the manufacturer himself. Amoskeag Mfg. Co. v. Spear, 2 Sandf. (N. Y.) 599; Taylor v. Carpenter, 2 Sandf. Ch. (N. Y.) 614."

standard. The brand did not indicate by whom the flour was manufactured, but it did indicate the origin of its selection and classification. It was equivalent to the signature of Holt & Co. to a certificate that the flour was the genuine article, which had been determined by them to possess a certain degree of excellence. It did not, of course, in itself indicate quality, for it was merely a fancy name, and in a foreign language, but it evidenced that the skill, knowledge, and judgment of Holt & Co. had been exercised in ascertaining that the particular flour so marked was possessed of a merit rendered definite by their examination, and of a uniformity rendered certain by their selection."

§ 83. Trade-mark acquired by manufacturer in limited sense.

A person who is a manufacturer only in a limited sense may acquire a trade-mark which thus indicates the origin of the goods with him. Thus, in Meriden Britannia Co. v. Parker[7] it appeared that three brothers, of the name of Rogers, were engaged for many years in the manufacture of plated spoons and forks, in which they had superior skill, sometimes as partners under the name of "Rogers Brothers," and sometimes as stockholders in joint-stock corporations. The goods manufactured by such partnerships and corporations were stamped with various devices, each of which contained the name "Rogers." In 1862, all such partnerships and corporations, with one exception, had ceased to do business, and the three brothers then entered into a contract with the petitioners, by which, and by subsequent contracts, the petitioners acquired the right to manufacture and sell plated spoons and forks with the name "Rogers" stamped thereon as a component part of a trade-mark, and also became en-

[7] (1872) 39 Conn. 450. See, also, William Rogers Mfg. Co. v. Simpson (1887) 54 Conn. 527.

titled to have, and did in fact have, the benefit of the skill and experience of the three brothers in that department of the business. The goods so manufactured were stamped "1847, Rogers Bros. A 1," which stamp differed somewhat from any stamp previously used. The petitioners furnished all capital, power, and machinery, employed and paid laborers, and controlled the sale and disposition of the goods manufactured, while the Rogers brothers superintended the manufacture, directed as to their style and quality, and had general supervision of the manufacture and sale thereof. It was held that the right to use the name "Rogers" previously existing in the partnerships and corporations that had ceased to do business thereupon reverted to the Rogers brothers; that the petitioners were in one sense the manufacturers; that such trade-mark had come, by the work of time and experience, to indicate the origin and ownership of such goods with the petitioners, and they were entitled to protection in the use of it.

§ 84. No trade-mark acquired by manufacturer who applies mark at request of purchaser.

But the manufacturer who makes goods for another, and applies a particular trade-mark thereto at the request of the purchaser, acquires no right to such trade-mark. In Levy v. Waitt[8] it was shown that there are two classes of labels recognized by cigar manufacturers—"factory brands" and "customers' brands," the latter originating with a customer, and used only on goods manufactured for him. A cigar merchant ordered a lot of cigars, of a certain size and quality, under the name of "Blackstone," which he originated. This

[8] (1893) 56 Fed. 1016. See, also, Gravel Roofers' Exchange v. Turnbull (1894) 8 Nat. Corp. Rep. 490; Miles Corson Co. v. Young (1891) 29 Wkly. Notes Cas. (Pa.) 256.

order the manufacturer filled, but the cigars were not taken by the merchant, and were sold to other parties, and it was held that the manufacturer acquired no right to the word as a trade-mark. So, also, in an action brought to restrain the defendant from selling imitations of the olive oil of the plaintiff, and from using a certain trade-mark, it appeared that the manufacturer of the oil in question had appointed Dwyer & Co. his agents to sell the oil for five years, agreeing that during this time he would not sell, give, or dispose of his oils for shipment to or for sale or use in the United States or Canada. Thereafter the plaintiff corporation was organized, and the manufacturer transferred his contract with Dwyer & Co. to it. At the same time Dwyer & Co. agreed that they would not sell any oils except those of the plaintiff, and under the brand of Dwyer & Co. After the plaintiff corporation was organized, the manufacturer sold oil to it, and plaintiff sold to Dwyer & Co. The label in question was invented by Dwyer & Co. while agents for the manufacturer, and was sent to the manufacturer, who used it on the bottles. Subsequently the manufacturer and the plaintiff caused these labels, which did not mention the name of either of them, to be made, and charged Dwyer & Co. for such of them as they used on bottles shipped to Dwyer & Co. It was not shown that plaintiff sold, or that Dwyer & Co. advertised, any oil under this label as being the plaintiff's own oil, or that it became known to the public as such. It was held that, on the termination of the contract between the plaintiff and Dwyer & Co., the label or trade-mark would belong to Dwyer & Co., and not to plaintiff, and consequently was not plaintiff's trade-mark.[9]

[9] Societe des Hulles d'Olive de Nice v. Rorke (1896) 5 App. Div. (N. Y.) 175.

§ 85. No trade-mark acquired by association whose members apply union labels.

Nor can an association or union of workingmen, which does not own, manufacture, or deal in goods, acquire a trade-mark in a label adopted by such body, and used only to designate goods made by its individual members.[10] But the in-

10 In Cigar Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 247, Gilfillan, J.: "In these particulars the device is wanting in the essential characteristics of a legal trade-mark: First. It is not adopted nor used to indicate by what person the articles were made, but merely to indicate membership of a certain association. Second. Its use is not enjoyed as an incident to any business, and the right to use it cannot be transferred, even with the transfer of the business in which it may have been employed; the right to use it can be acquired only by becoming a member of one of the unions, or employing those who are members, and lost only by ceasing to be a member or to employ members. Third. There is no exclusiveness in the use, or right to use, which is necessary to a legal trade-mark. Browne, Trade-Marks, §§ 143, 309, 324. Any one of many thousands of persons, no way connected in business, and perhaps unknown to each other, has an equal right to its use."

In Carson v. Ury (1889) 39 Fed. 777, 779, Thayer, J.: "It is no doubt true that the union label does not answer to the definition ordinarily given of a technical trade-mark, because it does not indicate with any degree of certainty by what particular person or firm the cigars to which it may be affixed were manufactured, or serve to distinguish the goods of one cigar manufacturer from the goods of another manufacturer, and because the complainant appears to have no vendible interest in the label, but merely a right to use it on cigars of his own make, so long, and only so long, as he remains a member of the union. In each of these respects the label lacks the characteristics of a valid trade-mark. The court cannot interfere in this instance, as in ordinary trade-mark cases."

In Weener v. Brayton (1890) 152 Mass. 101-107, Devens, J.: "For similar reasons, we are of opinion that the label alleged by the bill in the case at bar to have been counterfeited cannot be treated as a trade-mark. * * * It wants every essential element of such a mark. It does not indicate by what person articles were made, but only membership in a certain association. There is no exclusive use of it, but many persons, not connected in business, and unknown to each other, may use it. Its rightful use is not connected with

dividual member who, by the use of such label upon goods manufactured by himself, has built up a profitable trade, is entitled to protection in such use under circumstances

any business; it cannot be transferred with any business, but such use is dependent only on membership in the association. * * * Where an association such as the Cigar Makers' Union, embracing many members and many divisions as subordinate unions, has adopted a symbol or device to be used on boxes of cigars made by its members, such device or symbol not indicating by whom the cigars are made, but only that they are made by some of the members of the union, and where the right to use the device or symbol belongs equally to all the members, and continues only while they are members, a bill cannot be maintained by individual members or officers of such association to restrain others wrongfully and fraudulently using such device or symbol from so doing."

In McVey v. Brendel (1891) 144 Pa. 235-246, Williams, J.: "But we are not disposed to impale their case upon what may be thought to be a technical point. On the other hand, we will consider whether the International Cigar Makers' Union is a trader; whether the label in question is a trade-mark. * * * The first question is disposed of by the learned master upon the pleadings. The organization that devised, registered, and owns the label is neither a manufacturer nor dealer, and has no trade in which a trade-mark can be used. The second question would seem to go with the first. * * * Now, if the Cigar Makers' International Union was a business organization engaged in making cigars for sale, it could adopt and use a trade-mark in its business, and acquire property in it. But it is not a business organization. It neither makes nor sells cigars, but directs its attention to cigar makers, and seeks 'to promote the mental, moral, and physical welfare of its members.' These are worthy objects. * * * It is obvious, however, that they are personal and social objects, not commercial ones. They do not look towards the production or sale of any class or quality of cigars or tobacco, but towards the personal elevation and comfort of cigar makers. I conclude, therefore, that the Cigar Makers' International Union of America is neither a 'trader,' within the meaning of the common law, nor within the purview of the act of congress. Not being a trader in any sense, it can have no distinctive trade-mark. Registration, under such circumstances, is not authorized by the act of congress, and, if made, confers no title, and gives no standing ground in a court of law or equity."

In State v. Berlinsheimer (1895) 62 Mo. App. 168-174, Bond, J.:

showing unlawful competition.[11] Although holding such labels not to be technical common-law trade-marks, some

"The conclusion follows that the statutes, supra, only embrace trade-mark cases. * * * Hence it is necessary to inquire whether the label adopted by the Cigar Makers' Union was a trade-mark. In this inquiry it must be borne in mind that the recording of the label has no effect in giving it the quality of a trade-mark, if it was not such according to the law applicable to the subject. United States v. Braun, 39 Fed. 775. It is one of the indispensable prerequisites to a valid trade-mark that it should point out the true origin or ownership of a vendible commodity to which it is affixed. That the label in the present case does not have this property appears from the conceded facts, since these show that the 'association or union of workingmen' claiming it does not own or manufacture any goods to which it is attached. It is true the individual members of that order are engaged, either for themselves or others, in the manufacture of such goods, but this does not meet the requirement of the law that the owner of the trade-mark must affix it to his goods as a designation. As the 'association or union of workingmen' adopted the said label as a trade-mark, without owning or dealing in any goods to which it must be attached, no title to it as a trade-mark accrued. Schneider v. Williams, 44 N. J. Eq. 391; Cigar Makers' Protective Union v. Conhaim, 40 Minn. 243; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co., 104 Mo. 53. For this reason, the conviction of defendant for counterfeiting a recorded trade-mark cannot be sustained."

In State v. Bishop (1895) 128 Mo. 373-381, Burgess, J.: "The first contention is that the label of the Cigar Makers' International Union of America is not a trade-mark. * * * It may be conceded that the label is not what is generally understood by law writers to be a technical trade-mark, because it does not pretend or intimate that the cigars are owned, prepared, or manufactured by the union as an organization, or that, as such union, it has any interest or property therein, nor by what particular firm or person the cigars to which it may be attached were manufactured."

In Hetterman Bros. & Co. v. Powers (1897) 102 Ky. 133, 138, Hazelrigg, J.: "And, first, we may admit that the label [of the Cigar Makers' International Union] is not used as a 'trade-mark,' in the ordinary sense of that word. It is not a brand put on the goods of the owner to separate or distinguish them from the goods of others."

[11] In Carson v. Ury (1839) 39 Fed. 777, 781, Thayer, J.: "The

courts have protected them when not contrary to good morals or public opinion, and others have further recognized in them a property right, belonging to the individual member as an employe and skilled workman, which entitles him to protection against the unauthorized or fraudulent use of the label.[12]

case at bar differs from those cases [Cigar Makers' Protective Union v. Conhaim, 40 Minn. 243, and Schneider v. Williams, 44 N. J. Eq. 391], however, in the respect before mentioned, that complainant is himself a manufacturer of cigars, and, according to the averments of the bill, has built up a profitable trade by the use [to which he was entitled] of the union label, which trade has been damaged, and is liable to be further damaged, by the fraudulent acts of the defendants. I think he is entitled to relief on the facts stated in the amended bill, and accordingly overrule the demurrer."

In Weener v. Brayton (1890) 152 Mass. 101, 107, Devens, J.: "Whether, if the bill had contained allegations similar to those found in the case of Carson v. Ury (39 Fed. 777), it might have been maintained, we have no occasion now to consider. Bill dismissed."

In State v. Berlinsheimer (1895) 62 Mo. App. 168, 174, Bond, J.: "We by no means hold that the members of said union who are engaged in manufacturing cigars may not have a proprietary interest in said label, as identifying and giving value to their goods, which would entitle them to enjoin an appropriation of it by the defendant under circumstances showing unlawful competition. Carson v. Ury, 39 Fed. 777."

[12] In Strasser v. Moonelis (1888) 23 Jones & S. (N. Y.) 197-208, Dugro, J.: "The question to which I refer is that raised by the defendant in his contention that the plaintiffs are not owners or manufacturers of cigars, but merely laborers employed to convert the material provided into the article of trade. The defendant's counsel, on the argument and in his brief, lays great stress on the fact that the label [of the Cigar Makers' International Union] presented in this case does not come within the settled definition of a trade-mark, as he claims it to be. It is needless to discuss this phase of the case, for the right to the exclusive use of this label may be sustained, although it fail to be a trade-mark, in the precise definition of the term as heretofore used. For whether we call the property right, which I believe the plaintiffs have in the label, a trade-mark, or by another name, is a matter of slight import. It is a right entitled to the protection of a court of equity on the

Many of the states have already adopted, and others are yearly adopting, statutes providing for the creation and protection of such property right in such labels, along the line of the decisions last referred to, and which statutes tend to same principle as that upon which courts have based their right to protect trade-marks and goodwill. * * * It needs no deep study to perceive that the laborer has the same valuable interest in the goodwill of his labor as a manufacturer has in the goodwill of his trade. * * * The plaintiffs are entitled to be protected in the use and value of their property, and, as in this case it can be adequately protected only by an injunction, an injunction pendente lite will issue."

On appeal, Sedgwick, J.: "I am of opinion that the plaintiffs, being members of the Cigar Makers' International Union, had an interest in the proper use of the labels of the union which might, upon sufficient grounds, be protected by injunction against the inequitable use of those labels."

In Cohn v. People (1894) 149 Ill. 486, 494, Shope, J.: "We need not extend this discussion. We are of opinion that the label adopted by the Cigar Makers' International Union of America is neither immoral nor against public opinion, and might lawfully be adopted by that body."

In Perkins v. Heert (1896) 5 App. Div. (N. Y.) 335-341, Patterson, J.: "As this case is presented to us, it is not necessary to consider whether the label, the subject of this action, may be protected under the general rules of law applicable to trade-marks. * * * It is said that the statements in the label respecting the goods of the members of the international union, not being 'inferior rat-shop, coolie, prison, or filthy tenement-house workmanship,' are libelous, and that, therefore, the label should not be protected. It is before the court that, in the present form of the label, those words are not used, but they are not libelous anyway. * * * They libel nothing and nobody, but, not being in the amended label, the words are altogether immaterial now. * * * We think the judgment below [awarding a perpetual injunction] was right, and should be affirmed, with costs." Affirmed (1899) 158 N. Y. 306, all concurring.

In Hetterman Bros. & Co. v. Powers (1897) 102 Ky. 133-143, Hazelrigg, J.: "Moreover, it is urged that the plaintiffs do not come into court with clean hands; * * * that the label [of the Cigar Makers' International Union] itself cannot be approved, either in

"the growth and expansion, and perhaps the creation, of legal remedies unknown to ancient trade-mark law."[13]

§ 86. No trade-mark acquired by inventor of system.

In Jaeger's Sanitary Woolen System Co. v. Le Boutil-

law or morals, as it denounces cigars other than union-made ones as inferior and unwholesome, and the product of filthy tenement houses, or made by coolies and convicts. And, first, we may admit that the label is not used as a trade-mark, in the ordinary sense of that word. It is not a brand put on the goods of the owner to separate or distinguish them from the goods of others, but we cannot agree, on that account, that it does not represent a valuable right which may be the subject of legal protection. Why may not those engaged in skillful employment so designate the result of their labor as to entitle them to the fruits of their skill, where it is admittedly a source of pecuniary property to them? And this, though they may not own the property itself? They are not, it is true, 'in business' for themselves, in the ordinary sense, but they have property rights nevertheless. They may not select a label and be protected in its use apart from its connection with some commodity, but they not only select it in this instance, they apply to the property, and it does not at all matter that the tangible property is that of another. * * * The man who is employed for wages is as much a business man as his employer, in that larger sense in which the word 'business' has come to be used by statesmen and legislators. * * * The learned chancellor below, in an exhaustive opinion reviewing all the authorities, among other things said, and we can say it no more clearly, that * * * hence it is indisputable that the employe whose skilled labor, in the production of a particular commodity, creates a demand for the same, that secures for him higher remunerative wages, has as definite a property right to the exclusive use of a particular label, sign, symbol, brand, or device, adopted by him to distinguish and characterize said commodity as the product of his skilled labor, as the merchant or owner has to the exclusive use of his adopted trade-mark on his goods. * * * On the whole case, therefore, we are of opinion that the law may be justly invoked by organized labor to protect from piracy and intrusion the fruits of its skill and handiwork, and that brain and muscle may be the subject of trade-law rules, as well as tangible property."

[13] In Hetterman Bros. Co. v. Powers (1897) 102 Ky. 133, 139, Hazel-

lier,[14] it appeared that Professor Jaeger had conceded to the cómplainant the exclusive right to use the words "Normal" and "System Professor Jaeger." The New York supreme court held that, as Prof. Jaeger was not engaged in trade, he could not acquire any proprietary right in a trade-mark. In the opinion of the court it is stated: "In the case at bar, the plaintiff claims its right to the use of this so-called trade-mark because of a concession made by Prof. Jaeger in May, 1886. The difficulty, however, which the plaintiff necessarily encounters, is the fact that there is nothing to show that Prof. Jaeger had ever acquired a proprietary right in the words the use of which was sought to be enjoined as trade-marks. It does not appear that he had ever manufactured any of these goods; neither does it appear that he has been the vendor of such goods having attached thereto these words. But it seems to be assumed that, because he is the inventor of the system, he has, therefore, the right to make concessions of the use of the words which he has employed to designate his particular system. Such a condition of affairs in

rigg, J.: "In a number of the states, laws have been enacted giving protection to the men engaged in the business of working for wages, and their right of organizing and selecting appropriate symbols to designate the results of their handiwork is recognized and ordained to be the subject of lawful protection by the courts. Thus, in this state [Kentucky], in April, 1890, a law was enacted by the general assembly providing that 'every union or association of working men or women adopting a label, * * * etc.' This suit was filed before the adoption of this statute, but it indicates the policy of the law, the growth and expansion and perhaps the creation of legal remedies hardly known to ancient trade-mark law."

See chapter xvi. Also, Bloete v. Simon (1887) 19 Abb. N. C. (N. Y.) 88; Cohn v. People (1894) 149 Ill. 486; State v. Bishop (1895) 128 Mo. 373; Perkins v. Heert (1896) 5 App. Div. (N. Y.) 335; Id. (1899) 158 N. Y. 306.

[14] (1888) 47 Hun (N. Y.) 521; (1892) 5 Misc. Rep. 78, 24 N. Y. Supp. 890.

no way conferred upon Prof. Jaeger any proprietary right, as he has not been engaged in trade, and has, therefore, been unable to acquire any proprietary right in a trade-mark."

§ 87. Priority of adoption.

Where two or more persons claim the same trade-mark for the same commercial article, it must be awarded to him who shows the prior *bona fide* appropriation thereof, supplemented by a continuous use. A mere intention to adopt a trade-mark, or a declaration that one has adopted, or a mere casual use, will not be sufficient to confer title.[15] As trade-marks have increased in importance with increase of commerce, and as the markets of the world have been brought nearer together by the adoption of modern inventions and business methods, the possibility of different persons having the same trade-mark in different localities has lessened. Formerly one person might have a trade-mark in one market, and a second have the same trade-mark in another, and the two never come in conflict; and while this may still be possible to a limited extent, it is not probable with trade-marks that possess any considerable commercial value.

The test in all cases of conflict as to priority of adoption is, which claimant was first to so use the mark as to fix in the market a conviction that goods so marked had their origin with him? Thus it has been held that the first use of the trade-mark "Epicure" by a complainant as a brand for pack-

[15] Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 Sup. Ct. 151; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Maxwell v. Hogg (1867) 2 Ch. App. 307; Civil Service Supply Ass'n v. Dean (1879) 13 Ch. Div. 512; Candee v. Deere (1870) 54 Ill. 439; Munro v. Beadle (1890) 55 Hun (N. Y.) 312; Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444; Wagner v. Daly (1893) 67 Hun (N. Y.) 477; Whitfield v. Loveless (1893) 64 Off. Gaz. Pat. Off. 442; American Washboard Co. v. Saginaw Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

ed salmon, and the establishment of a business thereunder, entitled him to protection against the use of it by another for salmon, though that other had previously used it as a trade-mark for canned fruits and vegetables.[16] It has also been held that the fact that a defendant had used the word "Royal" in connection with a grade of mustard made by him gives no right to use it to designate a flavoring extract, after the complainant had first distinctly appropriated the word for such other production.[17]

§ 88. Mere fact that trade-mark not in use in particular locality gives no one right to appropriate it.

The mere fact, however, that an established trade-mark is not at the time in use in a particular locality, gives no one

[16] George v. Smith (1892) 52 Fed. 830.

[17] Royal Baking Powder Co. v. Sherrill (1880) 59 How. Pr. (N. Y.) 17. See, also, Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376.

In Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 463, Jackson, J.: "That the exclusive right to the use of the mark or device claimed as a trade-mark is founded on priority of appropriation; that is to say, the claimant of the trade-mark must have been the first to use or employ the same on like articles of production."

In Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608, T. R. Strong, J.: "The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks, or symbols of any kind to distinguish his manufactures, acquire a property therein as a trade-mark, for the invasion of which an action for damages will lie, and in the exclusive use of which he may have protection, when necessary, by injunction."

In Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 477, 36 Pac. 444, 445, Reed, J.: "A trade-mark becomes the exclusive property of one only where he has, prior to any one else, appropriated and used it to indicate the ownership, origin, and quality of an article to which it is attached. Stokes v. Landgraff, 17 Barb. (N. Y.) 608; Van Bell v. Prescott, 82 N. Y. 630; Morgan's Sons v. Troxell, 89 N. Y. 297; Taylor v. Carpenter, 11 Paige (N. Y.) 292; Ex parte Lyon, Price & S. Am. Trade-Mark Cas. 911."

the right to appropriate it. If a manufacturer or vendor could secure a claim to a trade-mark on the ground alone that it was not in use, prior to the time when he adopted it, in the special locality in which he proposed to use it, the law for the protection of trade-marks would be shorn of most of its strength, for, on the same principle, other persons would be at liberty to adopt it in any locality in which it happened at the time not to be in use.[18]

§ 89. Right of prior domestic user.

It has been held that a foreigner engaged in manufacturing and selling goods in his own country under a registered trade-mark has no common-law right to such trade-mark in the United States, such as will enable him to claim the same, on establishing a branch business here, as against a domestic firm which had an established business under a similar trade-mark adopted in good faith, before the foreign manufacturer had sold any goods in this country.[19]

§ 90. How trade-mark may be acquired and held.

A trade-mark may be originally acquired only by adoption and use,[20] and it can be held only so long as the use continues.[21]

[18] Burke v. Cassin (1873) 45 Cal. 467.

[19] Richter v. Anchor Remedy Co. (1892) 52 Fed. 455, affirmed in Richter v. Reynolds (1893) 8 C. C. A. 220, 59 Fed. 577.

In Richter v. Reynolds (1893) 8 C. C. A. 220, 222, 59 Fed. 577, 579, Dallas, Cir. J.: "The complainant * * * has not shown sales of his medicines in this country prior to defendants' use, nor any importations, except to a limited extent upon special orders, to supply particular customers. This is not enough. It does not amount to use 'in such circumstances, as to publicity and length of use, as to show an intention to adopt it as a trade-mark for a specific article.' It indicates no intention to acquire title, and therefore none was acquired."

[20] Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444;

§ 91. Use necessary to support claim to trade-mark.

While the law does not require that the use of the trade-mark shall have been long continued,[22] or that the article on which it is used should be widely known, or should have attained great reputation,[23] it does require that it shall be

Wagner v. Daly (1893) 67 Hun (N. Y.) 477; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 Sup. Ct. 151; Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192; Derringer v. Plate (1865) 29 Cal. 292; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Messerole v. Tynberg (1868) 4 Abb. Pr. (N. S.; N. Y.) 410, 36 How. Pr. (N. Y.) 14; Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Shaver v. Shaver (1880) 54 Iowa, 208; Selchow v. Baker (1883) 93 N. Y. 59; Seltzer v. Powell (1871) 8 Phila. (Pa.) 296; Handy v. Commander (1897) 49 La. Ann. 1119; American Wash-Board Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

[21] Trade-Mark Cases (1879) 100 U. S. 82; Caswell v. Hazard (1890) 121 N. Y. 484.

In Caswell v. Hazard (1890) 121 N. Y. 484, 494, Ruger, Ch. J.: "The right to a trade-mark is derived from its appropriation and continual user, and becomes the property of those who first employ it and give it a name and reputation. Devlin v. Devlin, 69 N. Y. 212; Colman v. Crump, 70 N. Y. 578."

In Messerole v. Tynberg (1868) 36 How. Pr. (N. Y.) 14, 18, Brady, J.: "All the essential requisites to the plaintiff's right to protection flow from the prior use of a term, symbol, or word which has created for his manufacture a celebrity or value; and the burden of showing that the claim of priority is unfounded, or the absence of any injury resulting from its imitation, rests upon the defendant."

[22] Shaver v. Shaver (1880) 54 Iowa, 208; Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kniepp Medicine Co. (1897) 27 C. C. A. 351, 82 Fed. 321.

[23] Kathreiner's Malzkaffee Fabriken, etc., v. Pastor Kniepp Medicine Co. (1897) 27 C. C. A. 351, 82 Fed. 321; American Wash-Board Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

In Smith v. Walker (1885) 57 Mich. 456, 474, Sherwood, J.: "It is well settled that a manufacturer or vendor may, by a priority of appropriation and adoption of names, marks, letters, or other proper and appropriate symbols, so distinguish his manufactures from others as to acquire a property therein as a trade-mark, but not, however, until he has given it out and published it to the community

for such length of time and under such circumstances as to publicity as to show an intention to adopt it as a trade-mark as his, and that he has adopted it as an original thing, or has in some way become the lawful owner thereof. Stokes v. Landgraff, 17 Barb. (N. Y.) 608; Williams v. Johnson, 2 Bosw. (N. Y.) 6; Amoskeag Mfg. Co. v. Spear, 2 Sandf. (N. Y.) 599."

In Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Medicine Co. (1897) 27 C. C. A. 351, 356, 82 Fed. 321, 326, Jenkins, Cir. J.: "It is enough, we think, if the article with the adopted brand upon it is actually a vendible article in the market, with intent by the proprietor to continue its production and sale. It is not essential that its use has been long continued, or that the article should be widely known, or should have attained great reputation. The wrong done by piracy of the trade-mark is the same in such case as in that of an article of high and general reputation, and of long-continued use. The difference is but one of degree, and in the quantum of injury. A proprietor is entitled to protection from the time of commencing the user of the trade-mark. McAndrew v. Bassett, 4 De Gex, J. & S. 380; Jackson v. Napper, 4 Rep. Pat. Cas. 45; Cope v. Evans, L. R. 18 Eq. 138; Hall v. Barrows, 32 Law J. Ch. 548."

In Kohler Mfg. Co. v. Beeshore (1893) 8 C. C. A. 215, 219, 59 Fed. 572, 576, Shiras, Cir. J.: "A merely casual use, interrupted, or for a brief period, would not support a claim to a trade-mark. Menendez v. Holt, 128 U. S. 514, 9 Sup. Ct. 143. Nor will a court of equity recognize by injunction a proprietary right in a phrase or name, unless it has been used in such circumstances, as to publicity and length of use, as to show an intention to adopt it as a trade-mark for a specific article."

In Levy v. Waitt (1894) 10 C. C. A. 227, 61 Fed. 1008, 1011, Putnam, Cir. J.: "The right to a trade-mark at common law must not be confused, as it too frequently is, with the prima facie right existing under registration statutes. It arises to such a limited extent, from the mere matter of selection or discovery of the name or symbol used, that this may be of trivial consequence. A singular illustration of this fact is found in Siegert v. Findlater, 7 Ch. Div. 801, where, as applied to Dr. Siegert's bitters, the word 'Angostura,' indicating the place of their origin, was not selected by him as his trade-mark, but, instead thereof, the words 'Aromatic Bitters,' to which he added a statement that the bitters were prepared by him at Angostura. The public, however, applied to them the words 'Angostura Bitters,' so that, by the act of the public, those words be-

for a specific article. A mere casual use, interrupted, or for a brief period, will not support a claim to a trade-mark. Importation by a foreign manufacturer of goods, to a limited extent, upon special orders to supply particular customers in this country, does not amount to such use as will support a claim to a trade-mark.[24] The application of a mark to an article by a manufacturer at the request of a customer does not amount to such use as will sustain a claim to the mark, even against a manufacturer who adopts the mark at a later date.[25]

§ 92. Use, not invention, of trade-mark that creates right.

It is the use of a trade-mark, and not its invention, that creates the right.[26] It has sometimes been assumed that the common-law right to a trade-mark comes more from selection or discovery than from actual use of the mark;[27] but this is not the law. The right to a trade-mark at common law must not be confused, as it too frequently is, with the *prima facie* right existing under registration statutes.[28] It arises to such a limited extent from mere matter of selection or discovery of the name or symbol used that this may be of trivial consequence. The ordinary trade-mark has no

came the usual designation of the article, which the court protected in the case referred to."

[24] Kohler Mfg. Co. v. Beeshore (1893) 8 C. C. A. 215, 59 Fed. 572; Richter v. Reynolds (1893) 8 C. C. A. 220, 59 Fed. 577, affirming 52 Fed. 455; Smith v. Walker (1885) 57 Mich. 456.

[25] Levy v. Waitt (1893) 56 Fed. 1016, affirmed (1894) 10 C. C. A. 227, 61 Fed. 1008.

[26] Rowley v. Houghton (1868) 7 Phila. (Pa.) 39; American Wash-Board Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281; Schneider v. Williams (1888) 44 N. J. Eq. 391; Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutillier (1888) 47 Hun (N. Y.) 521; George v. Smith (1892) 52 Fed. 830.

[27] Brown, Trade-Marks, § 52.

[28] Levy v. Waitt (1894) 10 C. C. A. 227, 61 Fed. 1008.

necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident, rather than design.[29] The simple question in these cases is, has the claimant, by the appropriation of a peculiar mark, fixed, in the market where his goods are sold, a conviction that the goods so marked are manufactured by him? and, if so, and if no one else has been in the habit of using that mark, another has not the right to use that mark, so as to commit the fraudulent act of palming off his goods as being the goods of the person who is known to have been in the habit of using it.[30]

[29] Trade-Mark Cases (1879) 100 U. S. 82-94; Rowley v. Houghton (1868) 7 Phila. (Pa.) 39.

[30] Collins Co. v. Brown (1857) 3 Kay & J. 423.

In Handy v. Commander (1897) 49 La. Ann. 1119-1129, Watkins, J.: "The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party *using it. At common law, the exclusive right to it grows out of* its use, and not its mere adoption. * * * But it does not depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination; no genius nor laborious thought. It is simply founded on priority of appropriation. [Trade-Mark Cases, 100 U. S. 82.] * * * Every one is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of same general nature manufactured or sold by others. * * * The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and are assurance that they are the genuine article of the original producer. * * * It becomes his trade-mark, and the courts will protect him in its exclusive use." Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51.

In Schneider v. Williams (1888) 44 N. J. Eq. 391-396, Van Fleet, V. C.: "How may property in a trade-mark, or a right to a trade-mark, be acquired? It would seem to be settled, beyond question, that there can be no such thing as a trade-mark distinct from and unconnected with a vendible commodity. As the words themselves import, to make the thing selected or adopted answer the purposes of a trade-mark, it must be so used as to mark or distinguish some-

§ 93. Use must be sufficient to point out origin of claimant's goods.

As the exclusive right to the use of a trade-mark rests, not on invention, but on such use as makes it point out the origin of the claimant's goods, it must begin early enough, and be separate enough for the purpose; but absolute priority of invention is not required. Use by another before, at the

thing which is the subject of traffic,—something which is bought and sold. * * * It would appear to be entirely clear that a person who desires to acquire a right to a trade-mark must do three things, each of which is indispensably requisite to the acquisition of the right: First, he must select or adopt some mark or sign not in use to distinguish goods of the same class or kind already on the market, belonging to another trader; second, he must apply his mark to some article of traffic; and, third, he must put his article, marked with his mark, on the market. Mere adoption of a mark or sign, and a public declaration, by advertisement or otherwise, that a person will, at a subsequent time, put a particular thing on the market, marked or distinguished in a certain way, create no right. Until the thing is actually on the market, marked by the particular mark of the person intending to acquire a title, no property right in the mark arises. Lawson v. Bank of London, 18 C. B. 84; Maxwell v. Hogg, 2 Ch. App. 307, 314."

In Rowley v. Houghton (1868) 7 Phila. (Pa.) 39, 40, Ludlow, J.: "The defendant is driven to the position that he is entitled to his peculiar trade-mark because he suggested the name to the complainant. The law as settled will, however, hardly sustain the claim of the defendant. It was demonstrated in Colladay v. Baird, and the cases there cited (see 4 Phila. [Pa.] 139), that no right can be absolute in a name as a name merely; it is only when the name is printed or stamped upon a particular label or jar, and thus becomes identified with a particular style and quality of goods, that it becomes a trade-mark. In this instance, the complainant has used the name, as such, has established for it a reputation and value, has doubtless expended large sums of money in introducing it to the trade. * * * If the defendant had not only suggested, but had also legally used, this trade-mark, he would doubtless have a concurrent right with the plaintiff, but, under the evidence before us, he has not, in any just and legal sense, done this, but simply proposes to do it."

same place, or near enough to start a similar right, would prevent the use from showing such origin. The other use might be so far away, or so small, as to have no effect upon the use in question, to prevent it becoming a representation of origin.[31] While there is nothing to prevent the same person from having two or more trade-marks for the same article, if he seeks to appropriate one to himself, he must do it by no uncertain use.[32]

§ 94. Declaration of claimant cannot lay foundation of right.

That the published declarations of a manufacturer that he has adopted a certain word as his trade-mark can lay the foundation, or even aid in laying the foundation, of a right of property in the word, cannot be reconciled with recognized principles, upon which such property can be acquired, or with the policy of the law in recognizing and protecting the acquisition. It is the actual use of the trade-mark affixed to the merchandise of the manufacturer, and this alone, which can impart to it the element of property. The mere declaration of a person, however long, and however extensively published, that he claims property in a word as his trade-mark, cannot even tend to make it his property. No title arises until the thing is actually on the market, marked with the particular mark.[33]

[31] Tetlow v. Tappan (1898) 85 Fed. 774; Menendez v. Holt (1888) 128 U. S. 514.

[32] Metcalfe v. Brand (1887) 86 Ky. 331.

[33] Candee v. Deere (1870) 54 Ill. 439; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1892) 142 Ill. 494; Schneider v. Williams (1888) 44 N. J. Eq. 391.

In Civil Service Supply Ass'n v. Dean (1879) 13 Ch. Div. 512, 516, Malins, V. C.: "Now, Mr. Rogers [of counsel for plaintiffs] argued that, although the association had no place where they sold boots and shoes when these words were put in the window, there was an intimation that they were going to do so. I drew his at-

§ 95. Voice of public cannot appropriate trade-mark to individual.

Nor can the public, by its voice, appropriate and consecrate to an individual property in a designation by which he may choose to denote any product of his industry, but which he does not actually apply to his goods.[34]

tention to the rule laid down in Maxwell v. Hogg (2 Ch. App. 307), that the intention to issue a publication confers no property. So, too, in this case, an intimation by the association that they intended to open a shop for a particular purpose can give them no right to restrain anything which any other person may think fit to do."

In Maxwell v. Hogg (1867) 2 Ch. App. 307, 315, Sir H. M. Cairns, L. J.: "I am prepared to hold, without any hesitation, that the mere intention, and the declaration of intention, to use a name, will not create any property in that name, and to hold also that there can be no protection in this court for the intended name during the course of manufacture of the article which is to bear that name."

[34] Blackwell v. Armistead (1872) 3 Hughes, 163, Fed. Cas. No. 1,474. See Goodyear Rubber Co. v. Goodyear's Rubber Mfg. Co. (1884) 21 Fed. 276. Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598; Geo. T. Stagg Co. v. Taylor (1894) 95 Ky. 651, 27 S. W. 247.

In Blackwell v. Armistead (1872) 3 Hughes, 163, 167, Fed. Cas. No. 1,474, Rives, J.: "It cannot be denied that it is abundantly proven in this cause that the manufacture of Morris & Wright, and of those who succeeded them at Durham [the defendant claiming under Wright], was known, called, and distinguished in the market as 'Durham' smoking tobacco. It is on this notorious fact in the cause that the able and ingenious argument has been raised that the public, by its voice, may appropriate and consecrate to an individual property in a designation by which he may choose to denote any product of his industry. But I can find no warrant for such proposition in the law on this subject. On the contrary, it is distinctly laid down by the authorities that it is only the actual use of the mark, device, or symbol by the dealer which entitles him to it, and gives him the right to be protected in the enjoyment of it."

In Goodyear Rubber Co. v. Goodyear's Rubber Mfg. Co. (1884) 21 Fed. 276, 278, Wallace, J.: "Concisely stated, the question would seem to be whether the defendant can appropriate to itself the vari-

§ 96. Use by one claimant will not prevent adoption by another for different article.

The use of a trade-mark by one manufacturer or vendor will not ordinarily prevent another from adopting the same trade-mark for a different article.[35] He cannot prevent its use when the use is entirely innocent, and represents nothing in regard to the plaintiff's connection with the goods, and does not impose on the public.[36] Where the word "Celluloid" was used in connection with starch to make an attractive name, and suggest that the starch produced the glossy appearance of celluloid, it was held that the distinctive portion of the complainant's corporate name had been used against its will by the defendant, and that its trade-mark had been likewise used, but that it did not affirmatively appear that said name and said trade-mark had been used in a way to induce the public to believe or create the impression that the starch which bore the name was connected with the complainant, or was the product, in part, of its manufacture. The prospect that the complainant would

ous misnomers applied to it by the carelessness or inaccuracy of a comparatively small number of its customers during a period of ten or eleven years, notwithstanding the zealous and active measures of its managers to repress the practice, and their success in preventing it from ripening into a general usage. It would hardly be contended that an individual could found a claim of possessory right to any species of property upon the unauthorized conduct of other persons, or maintain that he had adopted a name symbolizing his products, or identifying his personalty with his business, by protesting against its use, and of course a corporation does not occupy a different position. The proofs show that there was no general recognition of the defendant among its customers by any other than its corporate name, and no adoption by the defendant of a different name, and it must be held that the occasional or persistent use of the misnomer by a few of the defendant's customers gave no privilege to the defendant to a monopoly in the use of the name."

[35] Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

[36] Colman v. Crump (1877) 70 N. Y. 573.

in future want to manufacture starch, or some article which has the use of or simulates starch, was held to be too shadowy to base an injunction upon.[37] It was also held that a dealer in dry white oxide of zinc has no remedy against another who uses the same trade-mark to distinguish the oxide when ground in oil. In this case Judge Blatchford said: "The defendants have not sold the dry white oxide in that state. It is not shown that the plaintiffs have sold such oxide ground in oil. It is true that the oxide is intended to be ground with oil for a paint. So, flour is intended to be made into bread; but if a baker should falsely stamp his bread with the mark of a particular brand of flour, the maker of such brand, if having a trade-mark therefor, could not claim that the baker had violated his trade-mark. And so of any other raw material which enters as an ingredient into a compound or article of manufacture.[38] But where the trade-mark was of a personal character, and its use by a second manufacturer, on a different article belonging to the same general class of goods, was calculated to lead purchasers to believe that the goods made by the second manufacturer were in fact made by the first manufacturer, the use of the trade-mark by the second manufacturer was held to be an unlawful appropriation of it, and was enjoined.[39] And where the plaintiff had used its trade-mark upon baking soda and saleratus only, and not upon baking powder, the defendant was enjoined from using the same mark upon baking powder, the court holding that baking powder and baking soda are in the same class. The court said: "Goods are in the same class whenever the use of a given trade-mark or

[37] Celluloid Mfg. Co. v. Read (1891) 47 Fed. 712-715.

[38] La Societe Anonyme Des Mines v. Baxter (1877) 14 Blatchf. 261, Fed. Cas. No. 8,099. See, also, Osgood v. Rockwood (1873) 11 Blatchf. 310, Fed. Cas. No. 10,605.

[39] Collins Co. v. Oliver Ames & Sons Corp. (1882) 18 Fed. 561.

symbol on both would enable an unscrupulous dealer readily to palm off on the unsuspecting purchaser the goods of the infringer as the goods made by the owner of the trade-mark, or with his authority and consent. The fact that the complainant has not used its trade-mark upon packages of baking powder constitutes no ground of defense. It has the right to manufacture or sell baking powder, and to use its trade-mark in connection with such manufacture or sale. The right to use its own trade-mark upon baking powder manufactured or sold by it would be valueless if all others were at liberty to use the same trade-mark on baking powder manufactured or sold by them."[40]

The case of Amoskeag Mfg. Co. v. Garner[41] came before the supreme court of New York at special term in May, 1869, on a motion to dissolve an injunction *pendente lite* previously granted restraining the defendant from applying the word "Amoskeag" as a trade-mark to prints or calicoes. The court held that, as the plaintiffs had never applied the word "Amoskeag" as a trade-mark to prints or calicoes, but only to unprinted cotton cloth, it could not restrain the defendant from applying the same word to prints or calicoes. Seven years later, the same case came before the same court on final hearing, and the court,[42] while holding that the injunction *pendente lite* had been properly refused, granted a permanent injunction restraining the defendant from applying the word "Amoskeag" to prints or calicoes. In the course of its opinion, the court used the following illustration: "But now suppose the plaintiff had received from the legislature of New Hampshire the name of 'The Amos-

[40] Church v. Russ (1900) 99 Fed. 276-280; Godillot v. American Grocery Co. (1896) 71 Fed. 873; Carroll v. Ertheller (1880) 1 Fed. 688.

[41] (1869) 6 Abb. Pr. (N. S.; N. Y.) 265.

[42] Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297.

keag Baking Company,' and for forty years had been engaged in the humbler, though hardly less useful, avocation of 'manufacturing' 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, such as 'Amoskeag B. Co.,' or 'Am. Baking Co.,' or 'Am. B. Co.,' or 'Amoskeag.' Suppose, however, that the plaintiff had omitted or had not yet decided to make and vend the single variety known as 'crumpets,' and thereupon a rival baker attempted 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 is only in degree."

In a recent case in New York it appeared that the plaintiff manufactured and sold a liniment under the name "Omega Oil." The defendants put on the market an "Omega Oil Soap." In the opinion of the court granting an injunction it is said: "That the plaintiff has a valid trade-mark in the name 'Omega Oil' is beyond dispute, and it does not seem to be questioned by defendants, but it is claimed the exclusive use of this name is limited to an article of the same class as that to which it has been applied by plaintiff, *i. e.*, a liniment, and that a soap is of a different class, and that, therefore, plaintiff's trade-mark does not extend to the use of the words as adopted by defendants and applied to a soap. It was conceded, upon the argument hereof by defendants' counsel, that defendants had adopted the words 'Omega Oil' because they had become well known to the public. The equities of the

case are clearly with the plaintiff. I am satisfied from the proof here submitted that the articles, *i. e.*, liniment and soap, are not of such a different character as will permit the defendants the use of the name created and made valuable by plaintiff. The liniment may have a much broader application than the soap, but it also possesses to a certain extent the qualities of the soap, and is used for many of the same purposes."[43]

§ 97. Trade-marks also acquired by transfer.

Trade-marks may also be acquired by purchase or inheritance;[44] but as a trade-mark cannot exist by itself, it follows that it can be acquired, other than by original appropriation, only as appurtenant to an established business, or the goodwill thereof, and it can be held by the transferee, the same as by an original proprietor, only so long as its use is continued, upon or in connection with an article of the character or species to which it was originally attached.[45]

§ 98. To what trade-marks may be applied.

In the law of trade-marks there is no distinction between artificial or manufactured products and those which are natural and spontaneous. The rules laid down in respect to an artificial or manufactured article are said to apply to the proprietorship of any peculiar natural product which a party may have acquired with the avails of his industry, sagacity,

[43] Omega Oil Co. v. Weschler (1901) 35 Misc. Rep. (N. Y.) 441, 442.

In Colman v. Crump (1877) 70 N. Y. 573, 580, Allen, J.: "The fact that the same device is used upon other articles of merchandise does not take from the plaintiffs their right to its exclusive use on this one article of their manufacture."

[44] See chapter vi., "Transfer of Trade-Marks."

[45] Walton v. Crowley (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; Filkins v. Blackman (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786.

and enterprise; the owner or vendor of the one, equally with the owner or vendor of the other, having a right to the exclusive use of the mark employed in connection with the sale of the article. It is very obvious that this must be so if the reason for the interference of the court is founded upon the injury to the owner when his trade-mark is invaded, or the fraud upon the public; for whether the commercial article be natural or artificial, the purchaser has imposed upon him an article that he never meant to buy, and the owner "is robbed of the fruits of the reputation that he had successfully labored to earn." Hence a trade-mark may be applied to any commercial article, natural or artificial.[46] Thus it has been held that the words "Congress Water" and "Congress Spring Water" appropriately indicated the origin of the water flowing from the spring in question, and that the proprietors of the spring had an exclusive right to the use of the word "Congress" as a trade-mark in connection with such water.[47] A similar ruling has been made as to the word "Bethesda," applied to the water from a certain spring, and the defendant was enjoined from applying the same name to water from another spring, located only twelve hundred feet from the former, and alleged to have exactly the same composition and curative qualities.[48] In the case of Hoyt v. J. T. Lovett Co.[49] it was held that the protection of a trade-mark

[46] Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291; Dunbar v. Glenn (1877) 42 Wis. 118.

[47] Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291.

[48] Dunbar v. Glenn (1877) 42 Wis. 118; Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502.

[49] (1895) 71 Fed. 173.

In Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291-299, Folger, J.: "The questions involved in this appeal are two: First. Can the owner of a peculiar product of nature be protected in the exclusive use of a name belonging

cannot be obtained for an organic article, such as a species of grape vine, which, by the law of its nature, is reproductive, and derives its innate vital powers independent of the care or ingenuity of man.

to it alone, and employed by him as his trade-mark in his sale thereof? Second. 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 interferes to protect the plaintiff, who has an exclusive right to use any particular mark or symbol in connection with the sale of some commodity. It is because it is his property for the purpose of such application. For the benefit of the vendor, the application of the mark or symbol may be as well to a vendible commodity natural as to one artificial, and thus the vendor of the one, equally with the vendor of the other, have a right in his mark. In Amoskeag Mfg. Co. v. Spear [in 2 Sandf. (N. Y.) 599], it is said that 'every merchant for whom goods are manufactured has an unquestionable right to distinguish the goods he sells by a peculiar mark or device.' He has used his capital to buy the exclusive right to vend for his own profit the peculiar product of another's skill. He has devoted and is giving his time, energy, and sagacity to extending the sale of it, with the hope and expectation of that profit. No reason presents itself why he is entitled to protection in the exclusive use of the symbol which designates that product of another's skill, more than one who, with equal capital, energy, and sagacity, has purchased the sole place of origin of a peculiar product of nature, and is engaged in the sale of it for profit. Both are so entitled. * * * There is but one Congress spring, and but that one spring from which does flow Congress water, exclusively possessed of these peculiar curative medicinal qualities, and there can be no question but that these proprietary marks, adopted and used by the plaintiffs and their predecessors, do indicate the true origin and ownership of this water, and that they have been and are now appropriated as designating the true origin and ownership of the article to which they are affixed."

In Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502-505, Hazelrigg, J.: "It was said [in Dunbar v. Glenn, 42 Wis. 118] the law in relation to trade-mark applied, whether the vendible commodity be natural or artificial. * * * So, also, in Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291, it was held that the owner of a peculiar product of nature, such

§ 99. How trade-marks may be applied.

It is essential to the idea of a trade-mark that it be affixed in some way, as by stamping, printing, carving, or engraving, to the commercial article to which it is applied, or to the packages or receptacles containing and sold with such articles, and so as to be reasonably durable and visible.[50] The mere declaration of a person that he claims property in a word or symbol not actually used on the article, or the package or receptable inclosing it, does not make it his property.[51] It has been held in a French case that the trade-mark may be applied to that part of a cork stopper that is inserted in the bottle neck, when in use, so that the mark is hidden until the cork is removed.[52] It has also been held in a recent case before the patent office that the trade-mark may be printed or otherwise placed on a paper sheet or strip, and placed loosely in the receptable with the article for which it is a trade-mark.[53]

as mineral water, will be protected in the exclusive use of a name given to it and employed as a trade-mark. The word 'Congress' in the phrases 'Congress Water' and 'Congress Spring Water' was held to be a legitimate trade-mark."

[50] Candee v. Deere (1870) 54 Ill. 439; St. Louis Piano Mfg. Co. v. Merkel (1876) 1 Mo. App. 305; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1892) 142 Ill. 494; Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391; Rowley v. Houghton (1868) 2 Brewst. (Pa.) 303.

[51] Candee v. Deere (1870) 54 Ill. 439.

[52] Ministere Pub. v. Bernard, Journ. du Palais, 1845; Browne, Trade-Marks, § 89.

[53] Hay & Todd Mfg. Co. v. Querns (1899) 86 Official Gazette, 1323.

CHAPTER V.

LOSS OF TRADE-MARK RIGHTS.

§ 100. General Rule.
101. Abandonment.
102. Intent to Abandon must be Shown.
103. Registration as Affecting Question of Abandonment.
104. Circumstances of Each Case must be Considered.
105. Abandonment by Nonuser.
106. Laches.
107. Rule Where Use is Justified.
108. Rule Where Fraud Appears.
109. Other Cases Considered.
110. Dedication to Public by Expiration of Patent.
111. Dedication to Public by Expiration of Copyright.
112. Other Forms of Dedication to Public.
113. Acquiescence of Original User Necessary.
114. General Use of Name does not Dedicate It to Public.
115. Whether Name has Become Generic is Question of Fact.

§ 100. General rule.

Trade-mark rights, once acquired, are perpetual unless lost by some act or omission of the proprietor, or by operation of law. Such loss of trade-mark rights may be partial or total, and the right to individual appropriation, once lost, is gone forever. While such loss usually arises from some act or omission on the part of the proprietor, it may arise, without his consent and against his will, from operation of law upon a state of facts over which the proprietor has no control. When the exclusive right to use a trade-mark terminates, no corresponding benefits result to the public. Its value is gone when it ceases to be exclusive, and becomes the property of the public.[1]

[1] Leidersdorf v. Flint (1878) 8 Biss. 327, Fed. Cas. No. 8,219.

§ 101. Abandonment.

A trade-mark, whether it consists of a symbol or a name, may be abandoned, and, if it is, it may then be appropriated by any one, who, by so doing, adopts it as his own, or, after it is abandoned, it may be resumed by the original proprietor and readopted by him, if, in the meantime, it has not been taken possession of by another, or by the community in general, or become, as a name or device, by general user, a mere designation of the kind of article or product, when its quality as an exclusive trade-mark is gone; the criterion of test being, was there an intention to abandon? which will depend upon the circumstances of the particular case.[2]

§ 102. Intent to abandon must be shown.

In the case of Saxlehner v. Eisner & Mendelson Co.,[3] the supreme court of the United States, in considering the defense of abandonment of a trade-mark, said: "To establish the defense of abandonment, it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon. Acts which, unexplained, would be sufficient to establish an abandonment, may be answered by showing that there never was an intention to give up and relinquish the right claimed." In that case, the court held that the defense of abandonment was not made out where there was but very slight evidence on the part of the original proprietor or his successor in interest to abandon the use of the word in question, or to dedicate the same to the public, and none at all of an intent to abandon the peculiar bottles and labels in connection with which the proprietor sold his waters, and where, in fact, the original proprietor's whole

[2] Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; O'Rourke v. Central City Soap Co. (1885) 26 Fed. 576.

[3] (1900) 179 U. S. 19, 21 Sup. Ct. 7.

life was a constant protest against the use by others of the name involved. Upon this point the court said: "The evidence shows that these Hungarian bitter waters were largely known in this country as 'Hunyadi Waters,' and that, in a certain sense, 'Hunyadi' had become a generic word for them. Of course, if it became such with the assent and acquiescence of Saxlehner, he could not thereafter assert his right to its exclusive use; but as this appropriation was made against his constant protest, and as he apparently made every effort in his power to put a stop to the use of it, it ought not to be charged up against his claim that the word had become generic." In deciding this case in the circuit court, Judge Shipman found actual abandonment from the fact that the Apollinaris Company, after it had acquired the exclusive right to sell "Hunyadi Janos" water in this country, and after it had in fact, for several years, sold large quantities here, and after the owner of the wells failed to suppress in Europe "Hunyadi" as prefixed to the names of other competing waters, and partly in consequence thereof, certain suits instituted in this country for infringement were voluntarily dismissed, and the use of the name became common by competitors, published notices stating that "Hunyadi" had become a general name for bitter Hungarian waters, and that it would henceforth distinguish its "Janos" water by a red diamond on the label, which was done for several years, and until the termination of the contract.[4]

§ 103. Registration as affecting question of abandonment.

It was also held, in the case cited in the last preceding section, that the registration of the words "Hunyadi Janos" did not estop the proprietor from subsequently claiming a

[4] Saxlehner v. Eisner & Mendelson Co. (1898) 88 Fed. 61. See, also, (1899) 33 C. C. A. 291, 91 Fed. 536.

trade-mark in the word "Hunyadi" alone. In the case of Richter v. Anchor Remedy Co.[5] it was held that the registration in the United States patent office of "a red anchor in the oval space or field" was an abandonment of any broad claim in the exclusive use of the word "anchor" and its symbol. This case was affirmed by the circuit court of appeals for the third circuit,[6] and was followed by the circuit court for the eastern district of Missouri in the case of Pittsburgh Crushed-Steel Co. v. Diamond Steel Co.[7]

§ 104. Circumstances of each case must be considered.

The circumstances of each case must be considered in determining the question of abandonment. Acts that, under certain circumstances, will be held to constitute abandonment in other cases, will not have this effect. For example, it has been held that an admission in a complaint or evidence before the court of plaintiff's acquiescence in, while cognizant of, defendant's use of the trade-mark in question, would not establish abandonment by plaintiff of such trade-mark, but it would be sufficient answer to any claim for damages for such use.[8] The consent of a manufacturer to the use or imitation of his trade-mark by another may be inferred from his knowledge and silence; but such consent, whether expressed or implied, when purely gratuitous, may be withdrawn, and, when implied, it lasts no longer than the silence from which it springs. It amounts to no more than a revocable license. The existence of the fact may be a proper subject of inquiry in taking an account of profits, if such an account should be decreed, but even the admission of the

[5] (1892) 52 Fed. 455.

[6] (1893) 8 C. C. A. 215, 59 Fed. 572.

[7] (1898) 85 Fed. 637. See, also, Hennessy v. Braunschweiger (1898) 89 Fed. 664.

[8] Julian v. Hoosier Drill Co. (1881) 78 Ind. 408.

fact would furnish no reason for refusing an injunction.[9] The fact that different parties have wrongfully used, at various times, some word, letter, or character which composed plaintiff's entire mark, is not sufficient to establish an abandonment of the mark by plaintiff.[10] And where the long and successful use of a trade-mark is clearly established, the fact that the owner has recognized and permitted the limited use thereof by another, which does not appear to have misled anybody, is not sufficient to defeat the owner's right to prevent others from using it.[11] And it has been held that the fact that the plaintiff had issued a notice or "caution" to the public against the fraudulent use of his device, showing that he knew that others had used the same combination of numerals as his own, for the purpose of defrauding him, will not be deemed an acquiescence in the use by such others of the particular arrangement of numerals upon steel pens and packing boxes which the plaintiff had first adopted and used.[12] Where an infringer invoked prescription for one year, the supreme court of Louisiana held it not tenable, and concurred with counsel for plaintiff and the authorities cited by him that the infringer who illegally appropriates a trade-mark to his own use, making profit thereby, may be treated as the owner's trustee in respect of such profits, and may be compelled to account therefor in equity. In this case, the defendant also contended that, from long use by others, he was justified in imitating the trade-mark, and in supposing acquiescence on the part of the owner. Upon this point, the court quoted from the opinion of Woodbury, J., in the case of Taylor v. Carpenter, as follows: "There is some-

[9] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297.

[10] Sohl v. Geisendorf (1871) 1 Wils. (Ind.) 60.

[11] Tetlow v. Tappan (1898) 85 Fed. 774.

[12] Gillott v. Esterbrook (1867) 47 Barb. (N. Y.) 455.

thing very abhorrent in allowing such a defense 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."[13] It has also been held that permission to one who is merely a dealer to place his name on articles bearing the trade-mark of a manufacturer is no indication of an abandonment of the trade-mark by the manufacturer, especially if such permission was in accordance with the custom of the trade.[14] In Filley v. Child it appeared that the plaintiff, during the entire twenty-one years' duration of his patent, knew of and acquiesced in the manufacture and sale by the defendant, and those under whom he claimed, of cooking stoves containing the patented improvements with the name "Charter Oak" upon them, and, as the defendant had built up a business through such acquiescence in the manufacture and sale of such cooking stoves with such name, the plaintiff could not, after the expiration of the patent, and when the defendant had a right to make stoves containing said improvements, prevent him from calling them by the name "Charter Oak," so long as he did not represent them as made by the plaintiff, or induce others to believe that they were made by the plaintiff.[15] It was held by the supreme court of Michigan that a trade-mark, when adopted, may be lost by being suffered, without objection, to come into common use in the trade, and that rights under it may be

[13] Funke v. Dreyfus (1882) 34 La. Ann. 80; Taylor v. Carpenter (1846) 2 Woodb. & M. 1, Fed. Cas. No. 13,784.

[14] Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

[15] Filley v. Child (1879) 16 Blatchf. 376, Fed. Cas. No. 4,787.

waived as against those using it with the knowledge of the owners, and without objection, though such use has not become general.[16]

§ 105. Abandonment by nonuser.

A complete disuse of a trade-mark may result in an abandonment thereof, and render the same capable of appropriation by others. Such disuse must, however, be for such period of time, and be accompanied by such circumstances, as to show an intention to abandon. In the case of Blackwell v. Dibrell[17] it was held that, where a mark was disused for eight years, and the proprietor, during that time, stood by and allowed a peculiar commercial and local signification to attach to the mark, an abandonment was made out. It was further held that where, during the period of its disuse, another had devised an equivalent mark, and had thereafter used it, having no knowledge of the first mark, such second appropriator acquired a right of exclusive use in such mark, and could enjoin the original user from resuming it. Where plaintiff's predecessor in business, goodwill, and trade-marks used the words "La Venzolana" on five shipments of flour in 1873, on three in 1885, one in 1886, several in 1887, and several more before his death, in 1888, and where another predecessor appeared to have used them on similar shipments in 1889, and before his death, in 1890, and the plaintiff used them on similar shipments, and caused them to be registered as his trade-mark in 1891, and where the defendant had used the words much more continuously and extensively on flour in shipments since October, 1884, it was held that whatever rights had begun to accrue to plaintiff's predecessor in 1873 by that use were lost by abandonment of the use

[16] Smith v. Walker (1885) 57 Mich. 456.
[17] (1878) 3 Hughes, 151, Fed. Cas. No. 1,475.

long before the defendants began using them in 1884, and that after that date, if either acquired any right to the exclusive use of these words for that purpose, the defendants appear to have done so.[18] In Raymond v. Royal Baking Powder Co.[19] the United States circuit court of appeals for the seventh circuit held that one who, after using an alleged trade-mark for a short time, abandons it for nearly a quarter of a century, has no right to resume its use after it has been long employed by another, who has built up under it a large and successful business. On the other hand, it was said in the case of Glen & Hall Mfg. Co. v. Hall,[20] that: "The neglect to carry on the business for a number of years does not prevent a party from resuming his trade mark or sign of the goodwill, nor entitle another to use it." This, however, was not strictly a trade-mark case, but was an action to restrain the use of the designation of a place of business. In this instance, the name properly went with the place of business, and a successor to the original proprietor, who resumed business in the original building, had the right to resume the original designation for that place of business. In the English case of Mouson v. Boehm,[21] it was held that, in order to deprive a manufacturer of his right to a trade-mark, the use of which had been practically given up for a period of five years, mere discontinuance of user for lack of demand, though coupled with nonregistration and nonassertion of any right, was not enough. In this case the trade-mark was for a particular kind of soap, and while the manufacture and sale of the soap thus marked had fallen off for a number of years, until it had practically ceased, and the proprietor had forgotten the existence of this par-

[18] Brower v. Boulton (1892) 53 Fed. 389.
[19] (1898) 29 C. C. A. 245, 85 Fed. 231.
[20] (1874) 61 N. Y. 234.
[21] (1884) 26 Ch. Div. 398.

ticular mark, it appeared that the manufacturer had not ceased to carry on his business, had not broken up the mold in which the soap was made, and a number indicating the soap thus marked was retained on the price list. The court said: "Here it appears to me there was no absolute non-user for any sufficient time, taken in connection with all the circumstances, to show an intention to abandon. A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods. It would be absurd to suppose he lost his trade-mark by not putting more goods on the market when it was glutted. There was some user, and the result, therefore, is that Boehm had not abandoned his trade-mark." The court further said that "the question of abandonment is one of intention, to be inferred from the facts in the particular case." It has also been held that, while property in a trade-mark may be abandoned, and thereby lost, a complaint for infringement, which shows nonuser for a year, does not disclose an intention to abandon; that, without such intention, there is no abandonment by mere nonuser; that such nonuser might imply a gratuitous license to others to use the mark for the time being, and thereby preclude the recovery of damages, but that this license is revocable, and does not preclude the remedy by injunction for the future.[22]

§ 106. Laches.

A trade-mark may be lost completely by laches, or the proprietor may lose simply the right to an account of gains or profits. Where the person who infringes a trade-mark does so with a show of right and justification, inexcusable laches on the part of a proprietor will work a forfeiture of the trade-mark, and disentitle him to any relief whatever;

[22] Julian v. Hoosier Drill Co. (1881) 78 Ind. 408.

but where the infringer has appropriated the trade-mark without any show of justification, and in fraud of the proprietor's rights, laches on the part of the proprietor will usually disentitle him to an account of gains and profits, but will not defeat the remedy by injunction.

§ 107. Rule where use is justified.

In considering the defense of laches in the Hunyadi Case,[23] the United States supreme court said: "The defense of laches depends upon somewhat different considerations, and, so far as it applies to the use of the word 'Hunyadi,' we think it is established. It appears that, after the decision of the minister of agriculture in 1873, sustaining the claim of Markus to the trade-mark 'Hunyadi Matyas,' other springs were opened, whose waters were bottled under different trade-marks, in all of which the word 'Hunyadi' was a component, and as early as 1886 these waters found their way to the United States, and were put on sale here with the knowledge of the Apollinaris Company. There is no evidence that Saxlehner had personal knowledge of these infringements, and, while something may be said in his favor in view of his persistent efforts to establish his rights in Hungary, he was bound to know the law in this country, and to take steps within a reasonable time to vindicate his rights. The infringers were making use of their trade-marks under licenses from the Hungarian government, and we see no reason to doubt that they were proceeding in good faith to dispose of their waters under the trade-marks registered in Hungary. Under these circumstances, if Saxlehner had intended to assert his rights, under the laws of this country, to the exclusive use of the word 'Hunyadi,' he was bound to act with rea-

[23] Saxlehner v. Eisner & Mendelson Co. (1900) 179 U. S. 19, 21 Sup. Ct. 7.

sonable promptness. It is true that he may have supposed the Apollinaris Company would assert his rights in that particular for their own benefit; but if, as we have already held, he was not bound by their admissions, he is in no position to take advantage of their inaction, and, as against traders who were selling bitter waters under trade-marks legalized by the Hungarian government, he should not have waited until the name 'Hunyadi' had become generic in this country, and indicative of this whole class of medicinal waters." The court then considers the effect of the treaty between this country and the Austro-Hungarian empire upon the trade-mark in question, and then says: "If, upon the other hand, we assume that the case can be decided without reference to the law of Hungary, or the decisions of its officers and courts, the plaintiff is still at a disadvantage by reason of not instituting her suits more promptly. 'Saxlehner knew, as a matter of fact, that the minister of agriculture had overruled his protest, and that the word 'Hunyadi' had become public property in the kingdom of Hungary. He knew that a large number of dealers would appropriate the word, and that he was himself selling a large quantity of bitter water in the United States. He must also have known, or at least had good reason to know, that his competitors were doing the same thing. Under such circumstances, he should have instituted inquiries upon his own account, and, regardless of his contract with the Apollinaris Company, have seen to it that his own interests were protected. If the Apollinaris Company were not his agent for the protection of his rights in the United States, then it was incumbent upon him to assert such rights personally, or through some other recognized medium. In now invoking our laws, his successor is bound to show that she has complied with our requirements of diligence and promptness in instituting suit. She has

failed in this particular. By twenty years of inaction she has permitted the use of the word by numerous other importers, and it is now too late to resuscitate her original title." It is clear from this decision that, where an alleged infringer has proceeded in good faith and with a show or justification of right, laches on the part of the proprietor may result in a complete loss of trade-mark right.

§ 108. Rule where fraud appears.

When, however, the court came to consider in the Hunyadi Case[24] the question of the appropriation of the complainant's bottles and peculiar labels by the defendant, which it appeared had been appropriated in fraud of the complainant's rights, a different rule was applied. Upon this point the court said: "This argument, however, has but a limited application to the appropriation of the bottles and red and blue labels covering them, which appear to have been seized upon by the proprietors of the Matyas Spring, as well as by others, without a shadow of justification, and in fraud of plaintiff's rights. * * * Indeed, we find no authority whatever for the appropriation of this label by any of Saxlehner's competitors, and nothing to show that it was not a case of undisguised piracy. The only justification for its appropriation now insisted upon is the fact that, by general use in this country for the past ten years, it has come to be recognized as a kind of generic label applicable to all Hungarian bitter waters, and, if Saxlehner had originally an exclusive right to make use of it, that right has been lost by his acquiescence and that of the Apollinaris Company in its general use by other importers. But in cases of actual fraud, as we have repeatedly held, notably in the recent case of McIntire v. Pryor, 173 U. S. 38, the principle of laches

[24] Saxlehner v. Eisner & Mendelson Co. (1900) 179 U. S. 19, 21 Sup. Ct. 7.

has but an imperfect application, and delay even greater than that permitted by the statute of limitations is not fatal to plaintiff's claim. We have only to refer to the cases analyzed in that opinion for this distinguishing principle: that, where actual fraud is proven, the court will look with much indulgence upon the circumstances tending to excuse the plaintiff from a prompt assertion of his rights. Indeed, in a case of an active and continuing fraud like this, we should be satisfied with no evidence of laches that did not amount to proof of assent or acquiescence."

§ 109. Other cases considered.

In McLean v. Fleming[25] there had been apparently a delay of about thirty years in instituting proceedings, but the court, citing Rodgers v. Rodgers, 31 Law T. 285, and Blackwell v. Crabb, 36 Law J. Ch. 504, said: "Equity courts will not, in general, refuse an injunction on account of delay in seeking relief, where the proof of infringement is clear, even though the delay be such as to preclude the party from any right to an account for past profits."

In the case of Menendez v. Holt,[26] the rule laid down in McLean v. Fleming was adhered to, and, in the opinion by Chief Justice Fuller, this question is discussed as follows: "Counsel, in conclusion, earnestly contends that whatever rights appellees may have had were lost by laches; and the desire is intimated that we should reconsider McLean v. Fleming, 96 U. S. 245, so far as it was therein stated that, even though a complainant were guilty of such delay in seeking relief upon infringement as to preclude him from obtaining an account of gains and profits, yet, if he were otherwise so entitled, an injunction against future infringement

[25] (1877) 96 U. S. 245.
[26] (1888) 128 U. S. 514.

might properly be awarded. We see no reason to modify this general proposition, and we do not find in the facts as disclosed by the record before us anything to justify us in treating this case as an exception. The intentional use of another's trade-mark is a fraud, and, when the excuse is that the owner permitted such use, that excuse is disposed of by affirmative action to put a stop to it. Persistence, then, in the use, is not innocent, and the wrong is a continuing one, demanding restraint by judicial interposition when properly invoked. Mere delay or acquiescence cannot defeat the remedy by injunction in support of the legal right, unless it has been continued so long, and under such circumstances, as to defeat the right itself. Hence, upon an application to stay waste, relief will not be refused on the ground that, as the defendant has been allowed to cut down half of the trees upon the complainant's land, he had acquired by that negligence the right to cut down the remainder. Attorney General v. Eastlake.[27] Nor will the issue of an injunction against the infringement of a trade-mark be denied on the ground that mere procrastination in seeking redress for depredations had deprived the true proprietor of his legal right. Fullwood v. Fullwood.[28] Acquiescence, to avail, must be such as to create a new right in the defendant. Rodgers v. Nowill.[29] Where consent by the owner to the use of his trade-mark by another is to be inferred from his knowledge and silence merely, 'it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license.' Duer, J., Amoskeag Mfg. Co. v. Spear;[30] Julian v. Hoosier Drill Co.;[31] Taylor v. Carpenter.[32] So far as the act com-

[27] (1853) 11 Hare, 205.
[28] (1878) 9 Ch. Div. 176.
[29] (1853) 3 De Gex, M. & G. 614.
[30] (1849) 2 Sandf. (N. Y.) 599.
[31] (1881) 78 Ind. 408.
[32] (1846) 2 Woodb. & M. 1, Fed. Cas. No. 13,785.

plained of is completed, acquiescence may defeat the remedy on the principle applicable when action is taken on the strength of encouragement to do it; but so far as the act is in progress, and lies in the future, the right to the intervention of equity is not generally lost by previous delay, in respect to which the elements of an estoppel could rarely arise."

In Estes v. Worthington [33] it was held that, when the delay of the owner of a trade-mark to prosecute infringers has been of a tendency to mislead the public, or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing. It has also been held that one does not necessarily lose his right to a trade-mark by his forbearance for three years to sue one unlawfully using it.[34] Where a defendant claimed a delay of nine years to commence proceedings to enjoin an alleged infringement of a trade-mark, and the court found the proof on this head too vague and unconvincing to justify a court of equity in refusing any relief, the injunction was allowed, but without damages, account of profits, or costs, because of the degree of inactivity exhibited by the plaintiff, as shown by the whole evidence.[35] In Low v. Fels,[36] an injunction was granted, although for nearly four years prior to the date of the suit complainants had notice that their trade-mark was in common use by dealers in this country, and did nothing to prevent it until the time of filing the bill, and such use had been practiced by all the principal dealers in soap in this country for nearly twenty years prior to the date of suit, and complainants,

[33] (1885) 22 Fed. 822.

[34] Blackwell's Durham Tobacco Co. v. McElwee (1888) 100 N. C. 150.

[35] Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297.

[36] (1888) 35 Fed. 361.

dealing in the markets of this country, should be presumed to have had knowledge of this fact. It was held that, if complainants had no such knowledge, it was because of indifference to their interests or lack of vigilance, and that there was no evidence of fraud on the defendant's part, and he did not even know of complainants' existence, or of the existence of the rights which they set up. This action, if it had arisen subsequent to the decision of the Hunyadi Case[37] by the supreme court of the United States, would probably have been decided the other way. As there was no fraud on the part of defendant, and no willful infringement, there was a complete justification for his using the trade-mark. Under these circumstances, inexcusable laches on the part of the complainant under the rule laid down in the Hunyadi Case should have disentitled them to any relief whatever.

In O'Rourke v. Central City Soap Co.[38] it was held that a person cannot appropriate a trade-mark belonging to another without his consent, and afterwards acquire a good title by the abandonment thereof by the first proprietor. In this case the court said: "In the case under consideration, however, the question is presented whether a person may appropriate a trade-mark belonging to another, and subsequently acquire a good title thereto by the abandonment thereof by the first proprietor. The testimony shows, and it is not disputed, that when Winger began manufacturing soap at Sturgis, under the name of 'Winger's Anti-Washboard Soap,' the firm of Clark & Benefiel was manufacturing soap at Mattoon, Ill., under the same name, and continued so to do for nearly a year after Winger commenced business. During this time he was an admitted trespasser upon

[37] Saxlehner v. Eisner & Mendelson Co. (1900) 179 U. S. 19, 21 Sup. Ct. 7.

[38] (1885) 26 Fed. 576.

their rights. The fact that he supposed the Ohio firm had gone out of business is no defense if in fact they had an exclusive right to the trade-mark. * * * There is no evidence in this case that his competition interfered with the business of Clark & Benefiel, or Stephens, their successor, or that he was the cause of the subsequent abandonment of the business by them; but if it be once conceded that a person may acquire a good title to a trade-mark by appropriation, without the consent of the lawful owner, it would enable a manufacturer, by the use of large capital or superior energy, to drive competitors out of business, by seizing their trade-marks, and using them for that very purpose, provided the lawful owner is unable or unwilling to assert his rights by resort to the courts. We think that no court would hesitate to pronounce against a title so obtained. We find it difficult to distinguish such a case, in principle, from the one under consideration, as it might be impossible to prove that the lawful owner was compelled to discontinue by reason of such competition."

From an examination of the statement of facts accompanying the opinion in the case last cited, it appears that the plaintiff's only title to the trade-mark was derived through a naked assignment of the mark from Winger, the person who had appropriated it prior to its abandonment by the original proprietor, and the bill of complaint might have been dismissed on the ground that the plaintiff could acquire no title to the trade-mark through a mere naked assignment. It is hardly seen why an infringer of a trade-mark cannot, upon the abandonment of it by another, begin to acquire, from the date of such abandonment, the right to use the trade-mark. If, upon the abandonment of the trade-mark, any person has a right to appropriate it, it would seem that a trespasser upon the rights of the former proprietor might

equally with any one else have the right to appropriate such mark.

In the case of Gilka v. Mihalovitch,[39] which was brought to restrain the infringement of plaintiffs' mixture or cordial trade-mark, "Gilka-Kummel," and for an account of profits, defendants filed a plea alleging that they and their predecessors had used the trade-mark for twenty years, and that, during the entire twenty years, there were manufactured and sold in the open market, and in the business and trade of the defendants and of the complainants, bottles, labels, packages, and other signs and devices similar to those set forth and described in the bill, and that their use of such bottles and labels was without knowledge of any special or exclusive right to such labels and bottles, as then claimed by the complainants, and without any intention or design of infringing upon or injuring any special or exclusive right complainants had to the use of the same, and that, immediately on learning of such right, they had desisted from such use. It appearing that the only circumstance relied upon to charge the plaintiffs with constructive notice was that they were represented by agents located at the city of New York, nearly eight hundred miles distant from the defendants' place of business, it was held that the plea presented no sufficient defense, and must be overruled.

In the case of Tygert-Allen Fertilizer Co. v. J. E. Tygert Co.,[40] decided by the supreme court of Pennsylvania, it appeared that two competing firms had entered into a contract for the purpose of consolidating their business interests. The corporation formed was called "The Tygert-Allen Fertilizer Co.," and the only use made of the name "Tygert" was as a part of this compound corporate title. The seven-

[39] (1892) 50 Fed. 427.
[40] (1899) 191 Pa. 336.

teen different articles made and sold were all advertised and sold under the name "Allen"; this word being, in each instance, used as a part of the trade-mark or brand. The name "Tygert" was never used by the corporation to designate any article manufactured or sold by it, and no request was ever made for a transfer of the right to its use as provided for by the contract. The corporation defendant was organized July 2, 1891, and its business had since been conducted within sixty feet of the plaintiff's office. It had used the name "Tygert" in connection with the various brands under which its goods were advertised and sold, and had built up an extensive business. The bill was filed January 12, 1894. The court said: "Aside from all questions as to the right of the plaintiff to enforce a covenant not made with it, but between third persons not parties to the bill, we think that the delay of the plaintiff has been such that, under the circumstances, it is not entitled to the relief sought. The merchandise owned by the firms was to be inventoried and sold to the plaintiff at its market value. The 'goodwill, brands, trade-mark, including the exclusive use of their names, so far as they shall hereafter apply or become necessary to be used in the manufacture and sale or purchase of fertilizers,' etc., were to be transferred for a nominal consideration. No transfer was ever asked for, and no use of the name 'Tygert' was made to designate the plaintiff's goods. Whatever right, if any, it acquired to the exclusive use of the name, it apparently abandoned. No value was given to the name by it as the designation of an article of merchandise. Its use by the defendant does not mislead the public, and it injures the plaintiff only as any other open and fair competition would do so. The plaintiff stood by for two years and a half without objection of any kind, while the defendant expended large sums of money, and built up

a business, the life of which depends upon the use of this name. The covenant to transfer the use of the name was not an unconditional one, but only as it should 'apply or become necessary to be used.' By the option of the plaintiff, it never has applied or become necessary for its use. In July, 1891, when the defendant was incorporated, it might well have been inferred that the plaintiff made no claim to the use of the name 'Tygert,' as all its goods had been put upon the market under another name. If the plaintiff intended to assert its right to its exclusive use, that was the time to speak. Its silence for two years and a half was more than mere laches,—it was, under the circumstances, such evidence of acquiescence as to bar its remedy for equitable relief."

It was also held, in the case of Cahn v. Gottschalk,[41] that where the plaintiff, after having knowledge by his agent of the infringement of his trade-mark, delayed for five years to bring his action for an injunction and for an accounting of profits, he was barred by his laches from recovering profits, though not from his right to an injunction.

In Sanders v. Jacob,[42] the St. Louis court of appeals, in considering the defense of laches in an action to restrain the infringement of a trade-mark, said: "The question of laches would be a serious one if there were no element of fraud in the case on the part of the defendant; * * * but where the element of fraud supervenes, lapse of time does not purge the defendant's conduct of this taint. The wrong is a continuing one. The injury done to the plaintiff, and the deception practiced upon the public, both of which the law takes into consideration in these cases, accumulate. Then, if the defendant, at a recent period of time, aggravates the wrong, as he is shown to have done in this case, by moving

[41] (1888) 14 Daly (N. Y.) 542.
[42] (1885) 20 Mo. App. 96.

his place of business still nearer to that of the plaintiff, and by there erecting signs similar in appearance to those of the plaintiff, it makes, we think, a plain case for equitable interposition." This rule was followed in the same court in the case of Plant Seed Co. v. Michel Plant & Seed Co.,[43] and by the supreme court of Florida in the case of El Modello Cigar Mfg. Co. v. Gato.[44] In the last case the court said: "The rule in England, in trade-mark cases, is more stringent than in this country, and a lack of diligence there in suing deprives complainant in equity of the right to an injunction or on account. But our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights if he would hold a wrongdoer to account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant. * * * Nor will the acquiescence of any person in the wrongful use of his name estop him from asserting his rights in equity unless he has notice, during such acquiescence, of the facts rendering the use of his name wrongful. * * * And the laches of the complainant will not avail as a defense in a proceeding to restrain the use of a trade-name, when the defendant adopted the name with a fraudulent intent."

Where plaintiffs had acquired, by long use, sanctioned by decision of the courts, the right to use the words "Blue Lick" as a trade-mark for mineral water, it was held that the use and attempted appropriation of the same trade-mark by defendant in advertising and selling water from an artesian

[43] (1886) 23 Mo. App. 579.
[44] (1889) 25 Fla. 886.

well was illegal and fraudulent, and that no presumption of acquiescence in the wrongful appropriation of the trade-mark could arise so as to estop plaintiffs from exercising their right to restrain its use, and whatever money might have been spent by the defendant in the purchase of and in putting improvements on the well, with the purpose of using the trade-mark in the sale of water therefrom, was done at his own risk. In this case the defendant claimed that he and his predecessors had for a period of fifteen years used the words "Kentucky Blue Lick Water" in connection with sale of water from the artesian well, and this statement, for the purpose of trying the general demurrer to the answer, was taken by the court as true. The court said, however: "But he does not allege they had so used the words under a claim of right, or that they had either acquired or undertook to convey to him a title to the trade-mark. On the contrary, their appropriation and use of the trade-mark being unlawful and fraudulent, it must be presumed whatever right they acquired thereto, if any, was abandoned when they transferred the well to appellant [defendant]; and as it was not conveyed, or attempted to be conveyed, to him, his use and attempted appropriation must be treated as illegal and fraudulent, and a distinct cause of action which accrued against him in favor of appellant [appellees] in 1893, when he first commenced to so appropriate and use their trade-mark." It does not appear from the report when or how soon after 1893 this action was brought, but the case was decided by the court of appeals in May, 1897 [45]

In Sawyer v. Kellogg[46] it was contended that the complainant had lain by for several years while the defendant had been publicly using his own label, and had thus acquiesced

[45] Northcutt v. Turney (1897) 101 Ky. 314.
[46] (1881) 7 Fed. 720.

in its use. The court found, however, that the complainant had a patent for the article—bluing—which he had been prosecuting and endeavoring to substantiate, but in which he finally failed, and that his failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back upon his rightful trade-mark.

And where plaintiffs sued defendants for infringement of a trade-mark, and manufacturing and selling an article in imitation of one sold by plaintiffs, and for an injunction about two years after they discovered the imitation, and plaintiffs had before brought suit against other infringers, and defendants had changed their label on account of a decision therein, it was held that plaintiffs should not be denied damages because of delay in bringing suit.[47] It has also been held that the fact that defendant put his packages on the market a year before complainant filed his bill to restrain such competition did not deprive plaintiff of the right to an accounting.[48] And where the imitation by defendants was begun in November, 1878, but not completed until 1879, and action was commenced fourteen months after the beginning of the imitation, and five or six months after its completion, it was held that there was no such laches by the plaintiffs as to deprive them of the right of an accounting of profits, and that there would have been none had the simulation been complete in November, 1878.[49] And where it appeared that the defendant had used the imitation complained of in various shapes and forms for many years, and for part of the time without active objection on the part of the complainant, and, during the use, different changes in the shape and general appearance of the packages were introduced in the

[47] Schmidt v. Brieg (1893) 100 Cal. 672.
[48] Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84.
[49] Avery v. Meikle (1887) 85 Ky. 435.

course of attempts at an amicable adjustment between the parties, and, by reason of these matters, proper accounting was rendered difficult, the court denied the accounting prayed for by the plaintiff without prejudice of his right to proceed at law for damages.[50]

In Blackwell's Durham Tobacco Co. v. McElwee,[51] it was held that, as between adverse claimants of an invention and sole ownership of a trade-mark, no greater force is to be given to the fact that one of the parties used the trade-mark for several years without being molested therein by the other, than that of evidence tending to disprove the claim of the other. Such forbearance on the part of the true owner, beyond its weight in disproving his title, cannot have the effect of extinguishing his rights; but such an indulgence is an assent to the use of the trade-mark, and the owner will not be entitled to demand damages for its intermediate use.

In the case of Williams v. Adams,[52] the proof showed that the complainants entered upon the manufacture of a class of soap, and adopted the word "Yankee" as a mark of distinction of their goods, and that they had used it from the time of its adoption to the time of suit. It was claimed by the defendants that the complainants had abandoned the use of this word as their trade-mark; that they had allowed other manufacturers to infringe upon it by putting their soaps on the market under the designation of "Yankee," as, for instance, "Yankee Jim," "Yankee Sam," and other labels, in which the word "Yankee" was the controlling or leading term, whereby complainants' exclusive claim of right to the

[50] Drummond Tobacco Co. v. Tinsley Tobacco Co. (1892) 52 Mo. App. 10.

[51] (1888) 100 N. C. 150.

[52] (1879) 8 Biss. 452, Fed. Cas. No. 17,711.

use of the word "Yankee" had been infringed, and that complainants had so acquiesced in this infringement as to abandon their exclusive right to the use of the word "Yankee." Judge Blodgett, in deciding the case for the complainants, said: "I do not find this position sustained by the testimony. The complainants seem to have been diligent in prosecuting all persons who infringed upon their rights within a reasonable time after they became aware of such infringement. It is true that the proof shows that quite a large number of manufacturers are putting shaving soaps upon the market under the term or description of 'Yankee,' such as 'Yankee Sam Soap,' 'Yankee Jim Soap,' and the 'Yankee Soap,' which last is precisely like the complainants', and there are various other imitations of the complainants' goods, shown in the proofs. But I do not understand the rule to be that, if a party infringes upon another's trade-mark, there is any fixed time in which he must bring suit in order to save his rights. Certainly, there is no such neglect on the part of the complainants proved here as would show an intention to abandon their trade-mark."

In Prince's Metallic Paint Co. v. Prince Mfg. Co.[53] it was held by the circuit court of appeals for the third circuit that where the purchaser, on foreclosure, of a property and business which had long been conducted in connection with a trade-mark, uses the trade-mark under claim and color of title, with the full knowledge of the former owner, for eight years without objection, this amounts to an acquiescence which will estop the latter, and a subsequent purchaser of the trade-mark from him at sheriff's sale, from afterwards maintaining a suit to restrain such usage. The court stated the general rule to be that, where the plaintiff's title to a trade-mark is clear, mere delay, unaccompanied by anything

[53] (1893) 6 C. C. A. 647, 57 Fed. 933.

else, will not ordinarily bar a suit for injunction against a naked infringement, but it held that this rule was not applicable to the case before it, and affirmed the decree of dismissal entered by the court below.

In White v. Miller,[54] which was a suit involving a trademark for whiskey, and in which it appeared that the complainant's distillery was located in Kentucky, and the defendant was located in Boston, the court held that the complainant had not been guilty of laches, where complainant had no knowledge of the defendant's infringement prior to 1889, and the suit was brought in 1890. The court took into consideration the distance from Boston to the point where complainant's distillery was located, and the fact that none of the proprietors of the complainant company had any knowledge of the infringement prior to 1889.

In Rahtjen's American Composition Co. v. Holzappel's Composition Co.[55] it appeared that there had been a delay of eight years before commencing suit to enjoin infringement, and the defendant insisted that the complainant's laches should prevent any decree in its favor. Upon this point, the court said: "It is true that the defendant has sold its manufacture of 'Rahtjen's Composition' to a certain extent since 1890, but the sales have been comparatively small, and did not interfere with the complainant's business to any marked extent until the defendant obtained a contract with the naval department of the United States government, in answer to a call for offers of 'Rahtjen's Composition,' when suit was promptly commenced. The defendant's chief brand of paint is the 'International Composition,' and it has been their endeavor to sell that brand, if they could, 'and, failing that, "Rahtjen's Composition."' The defense

[54] (1892) 50 Fed. 277.
[55] (1900) 101 Fed. 257.

of laches is nominal, rather than real, for the defendant's interference with the property rights of the plaintiff was for many years inconsiderable, and under no decision merits a refusal of a decree of injunction. Under all the circumstances of the case, we are not inclined to direct a decree for an accounting."

In Old Times Distillery Co. v. Casey[56] it appeared that both parties claimed original adoption of the brand "Kentucky Comfort" as a trade-mark for whiskey, and there was, in fact, but a few days' difference between the dates of actual application of the words by the two claimants. Each party clearly acted in good faith in the selection or the words, and there was no intention on the part of either to wrongfully appropriate the invention or the property of the other. In considering the defense of laches the court said: "As a matter of fact, the parties for ten years have acted on the theory that their geographical position made it unimportant to put to the test the question who was technically entitled to this trade-mark. The appellees have stood still too many years with knowledge of the fact that appellant has been expending large sums of money in extending the use of, and demand for, this brand of whiskey, and ought not to be permitted now to reap the benefit of the appellant's industry and enterprise. This is not a case where one who is clearly the owner of a trade-mark is seeking to withdraw his permission for its further piratical use." And in E. T. Fairbanks & Co. v. Des Moines Scale & Mfg. Co.,[57] where it appeared that the complainant had knowledge of the alleged infringement of its rights by defendant for many years before suit was brought, and where the case made by the bill was fully met by the answer, and no showing of defendant's insolvency

[56] (1898) 104 Ky. 616, 42 L. R. A. 466.
[57] (1899) 96 Fed. 972.

was made, a preliminary injunction was refused. In La Republique Francaise v. Schultz[58] it appeared that the defendant had sold artificial mineral waters for thirty years under the same labels, which implied that the water was from a well-known natural spring, before the proprietors of such spring took any steps to secure an injunction. The court held that the proprietors were not entitled to an accounting for gains and profits made during the time prior to beginning of suit. It was also claimed in that case by the complainant that there could be no imputation of laches against the owner of the springs, the republic of France being a sovereign power. The court held, however, that the lessee of the springs was the actual party in interest who would profit by a decree for accounting; that, while the republic of France was the owner of the springs, and a party to the suit, the lessee was the one beneficially interested in the gains and profits which might result from a decree, and that the principle that laches are not imputable to the government of a nation was not applicable in this case.

§ 110. Dedication to public by expiration of patent.

Where a name is used in connection with a patented article, and the article is sold under that name during the life of the patent, upon the expiration of the patent the name becomes dedicated to the public, whether the name be an arbitrary one, or be the surname of the patentee or original manufacturer. The leading case upon this point is Singer Mfg. Co. v. June Mfg. Co.,[59] in which the opinion of the court was delivered by Mr. Justice White. The doctrine of

[58] (1900) 102 Fed. 153. See, also, O'Rourke v. Central City Soap Co. (1885) 26 Fed. 576; Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84; Bank of Tomah v. Warren (1896) 94 Wis. 151; Sanders v. Jacob (1885) 20 Mo. App. 96.

[59] (1896) 163 U. S. 169.

dedication of the name of the patented article by expiration of the patent is clearly set forth in the opinion of the court as follows: "It is self-evident that, on the expiration of a patent, the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that, on the termination of the patent, there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss, without further comment, the complaint as to the form in which the defendant made his machines. It equally follows from the cessation of the monopoly, and the falling of the patented device into the domain of things public, that, along with the public ownership of the device, there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly in consequence of the designation having been acquiesced in by the owner, either tacitly, by accepting the benefits of the monopoly, or expressly, by his having so connected the name with the machine as to lend countenance to the resulting dedication. To say otherwise would be to hold that, although the public had acquired the device covered by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name, which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly; in other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that, at its termination, the monopoly should cease, and yet, when the end was reached, disregard the public dedication, and practically perpetuate indefinitely an exclusive right. The public having the right, on the expiration of the patent,

to make the patented article, and to use its generic name, to restrict this use, either by preventing its being placed upon the articles when manufactured, or by using it in advertisements or circulars, would be to admit the right, and at the same time destroy it. It follows, then, that the right to use the name in every form passes to the public with the dedication resulting from the expiration of the patent. Nor is this right governed by different principles, where the name which has become generic, instead of being an arbitrary one, is the surname of the patentee or original manufacturer. It is elementary that there is a right of property in a name which the courts will protect; but this right, like the right to an arbitrary mark, or any other, may become public property by dedication or abandonment."

An examination of the numerous cases that have been decided in this and other countries, many of which are cited in the opinion of the court in the case of Singer Mfg. Co. v. June Mfg. Co., shows that it is immaterial whether the name given to the patented article, and which becomes dedicated to the public by the expiration of the patent, is one that is capable of appropriation as a technical trade-mark or not. In the earlier case of Coats v. Merrick Thread Co.,[60] the supreme court said: "Plaintiffs' right to the use of the embossed periphery expired with their patent, and the public had the same right to make use of it as if it had never been patented. Without deciding whether, if the embossed periphery had contained a word which was capable of being appropriated as a trade-mark, defendants could have appropriated the same upon the expiration of their patent, it is clear that no such monopoly could be claimed of mere numerals used descriptively, and therefore not capable of exclusive appropriation because they represent the number of the

[60] (1893) 149 U. S. 562.

thread, and are therefore of value as information to the public. * * * Clearly the plaintiffs cannot, as patentees, claim a monopoly of these numerals beyond the life of the patent, and it is equally clear that, where used for the purpose of imparting information, they are not susceptible of exclusive appropriation as a trade-mark, but are the common property of all mankind. The patent being not simply for the embossed number, but for embossing the same upon the periphery of the spool head, defendants were entitled, upon the expiration of such patent, to use them for a like purpose."

There are numerous other cases in which the word "Singer" was involved, and in each of which an effort was made to hold this word as a trade-mark, after the expiration of the Singer patents. In Singer Mfg. Co. v. Larsen,[61] Judge Drummond held that there could be no trade-mark in the name "Singer Sewing-Machine," and said: "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 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." Judge Treat, in Singer Mfg. Co. v. Stanage,[62] said: "The plaintiff and its predecessors had, in connection with others, through patents, a monopoly as to cer-

[61] (1878) 8 Biss. 151, Fed. Cas. No. 12,902.
[62] (1881) 6 Fed. 279.

tain sewing-machines, known as the 'Singer' machines. When these patents expired, every one had an equal right to make and vend such machines. If the patentees or their assignees could assert successfully an exclusive right to the name 'Singer' as a trade-mark, they would practically extend the patent 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 patent would still be known on the market by that designation, irrespective of the name of the special manufacturer. No one had an exclusive right to the use of the generic name. If one wished to acquire a trade-mark in connection therewith, he could do so distinctively. * * * 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."

In Singer Mfg. Co. v. Riley,[63] where suit was brought to restrain the defendant's use of the word "Singer" in connection with sewing-machines, a preliminary injunction was refused, following the decision of the Stanage Case.

In Brill v. Singer Mfg. Co.[64] it was held by the Ohio supreme court commission that, as Singer machines had been protected by patents, and during the existence of such patents had become known and identified in the trade by their shape, external appearance, or ornamentation, the patentee could not, after the expiration of the patent, prevent others from using the same mode of identification in machines of the same kind, manufactured and sold by them. It was also held that, where a patented machine becomes 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 such machines, and use such name, and no one, by incorporating such name in his trade-mark, could take away from the public the right of using it.

In Fairbanks v. Jacobus[65] it was sought to restrain the defendant from making or selling an imitation of Fairbanks' scales, and from casting the words "Fairbanks' Patent" upon scales so made, in imitation of scales of the manufacture of the complainant. The court held that, by reason of the expiration of the patent under which plaintiff manufactured his scale, there was not, in the acts complained of, any invasion of the plaintiff's rights.

In the English case of Wheeler & Wilson Mfg. Co. v. Shakespear[66] it was sought to restrain the defendants from using the words "Wheeler & Wilson" as descriptive of any sewing-machine manufactured by the plaintiffs. The court

[63] (1882) 11 Fed. 706.
[64] (1884) 41 Ohio St. 127.
[65] (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608.
[66] (1869) 39 Law J. Ch. 36.

held that the name "Wheeler & Wilson" on sewing-machines had come to signify the thing manufactured according to the principle of the plaintiffs' patent, and, that being so, it could not restrain anybody, after the expiration of the patent, from representing his article as being the article which was so patented. The court observed: "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.'"

In the English case of Linoleum Mfg. Co. v. Nairn,[67] the plaintiffs claimed the exclusive right to the use of the word "Linoleum" as a trade-mark for a substance which had been covered by patents which, prior to the time of the suit, had expired. The inventor of the new substance had given to it the name "Linoleum," and it had always been sold under that name during the life of the patent. The court said: "It appears that the defendants are now minded to make, as it is admitted they may make, that substance. I want to know what they are to call it. That is a question I have asked, but I have received no answer, and for this simple reason: that no answer could be given except that they must invent a new name. I do not take that to be the law. I think that, if 'Linoleum' means a substance which may be made by the defendants, the defendants may sell it by the name which that substance bears. * * * In my opinion, it would be extremely difficult for a person who has been, by right of some monopoly, the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone, after his competitors are at liberty to make the same article."

In the case of Powell v. Birmingham Vinegar Brewery Co.,[68] in the English court of appeal, Lindley, L. J., in dis-

[67] (1878) 7 Ch. Div. 834.

[68] [1896] 2 Ch. 54, 65 Law J. Ch. Div. 563.

cussing the question of dedication of names to the public, says: "Again, if a person makes or sells an article and calls it by a particular name, the use of that particular name by others for the same sort of goods is not necessarily an infringement of his rights, even if the name is not obviously descriptive. If the article is a patented article, sold by the patentee under the name in question, then, when the patent expires, any one is at liberty to make and sell the article, and to sell it under the name by which it has become known in the market, and, if nothing more is done, the patentee has no redress. This was decided in Cheavin v. Walker, [5 Ch. Div. 850] and Linoleum Mfg. Co. v. Nairn [7 Ch. Div. 834]."

The same rule was followed in the several Castoria Cases. An effort was made in one of these cases to distinguish it from the Singer Case, on the ground that, in the Singer Case, controversy arose immediately upon the expiration of the patent, while in the Castoria Case the plaintiff continued in the exclusive manufacture of Castoria for some ten years after the expiration of the patent, and hence it was insisted that, during the time when the right to manufacture and sell was common, the plaintiff had acquired a trade-mark in the name. The court held, however, that this matter of time made no difference; that the word had become known as the name of the thing, and as such it could not be appropriated as a trade-mark.[69]

In the case of Dover Stamping Co. v. Fellows,[70] decided by the supreme court of Massachusetts, it appeared that the plaintiff had for many years manufactured an egg beater

[69] Centaur Co. v. Heinsfurter (1898) 28 C. C. A. 581, 84 Fed. 955; Centaur Co. v. Neathery (1898) 34 C. C. A. 118, 91 Fed. 891; Centaur Co. v. Reinecke (1898) 34 C. C. A. 684, 91 Fed. 1001; Centaur Co. v. Marshall (1899) 92 Fed. 605.

[70] (1895) 163 Mass. 191.

under a patent granted to one Williams. These egg beaters were stamped with the words and figures "Dover Egg Beater, Pat'd May 31st, 1870." Suit was brought to restrain the defendants from using the word "Dover," as applied to egg beaters, after the expiration of the Williams patent. The plaintiff contended that the word "Dover," as applied to egg beaters, was a trade-mark, and that it was entitled to be protected in the exclusive use of that word. The court, without deciding whether the word "Dover" could, under any circumstances, be a trade-mark, held that the plaintiff could not hold it as a trade-mark under the particular circumstances of the case. In the opinion of the court, the following statement is made: "A word which might become a valid trade-mark when applied to an unpatented article may not be so when applied to an article which has the protection of letters patent. In the latter case, the letters patent indicate the ownership and origin of the article, and it is more readily to be inferred that the word is used as a name merely to identify the article. Usually the protection given by a patent is far greater, though of less duration in time, than that obtained by the use of a trade-mark, because, if an article is patented, nobody but the owner of the patent can, without his consent, make or sell anything embodying the same principles or elements, while a trade-mark only secures one in the use of the name or emblem adopted by him, and applied to the article. * * * One may choose to rely on the name alone, and, if so, he may establish or create a trade-mark which will be permanent, but if he seeks and obtains the protection afforded by a patent, he is bound to yield up his monopoly with all that belongs to it at the end of the term, and the right to the exclusive use of the name given to his goods, which might otherwise become a trade-mark, will ordinarily fall with the patent itself. * * * After

the expiration of a patent, the public is entitled to make and use the patented article, free from restrictions, and this right carries with it whatever is necessary for its full enjoyment."

In the case of Wilcox & Gibbs Sewing-Machine Co. v. Gibbens Frame,[71] and Wilcox & Gibbs Sewing-Machine Co. v. Kruse & Murphy Mfg. Co.,[72] it was held that, where frames for sewing-machines in the form of the letter "G" had been so extensively manufactured and sold during the time they were protected by patents that the machines containing this feature came to be known in the trade thereby, the patentee could not after the expiration of the patents, by claiming such form or shape as a trade-mark, prevent others from using such frames in sewing-machines manufactured and sold by them.

In Lorillard v. Pride[73] it appeared that the complainants had procured a patent upon a mode of marking or distinguishing their plug tobacco by imbedding into the surface a metal tag or label; and for several years complainants insisted upon the validity of this patent, and asserted their exclusive right, by virtue of this patent, to mark their tobacco with tin tags, and thereby indicate its origin. It also appeared that the use of the tin tag, and the designation of complainants' goods by the words "Tin Tag," originated from the attempt of complainants to enforce their exclusive right to the use of a metal tag under this patent, and not to the adoption of tin or the words "Tin Tag" as a trade-mark. The patent was declared void, and thereafter complainants registered in the office of the commissioner of patents a trade-mark consisting of a bright, metallic tag, preferably of circular form, and firmly affixed to one of the sides or faces of

[71] (1883) 17 Fed. 623.
[72] (1887) 14 Daly (N. Y.) 116.
[73] (1886) 28 Fed. 434.

plugs of tobacco. The court held that the owner could not perpetuate the monopoly which he had attempted to hold under the patent by falling back upon a popular name given the goods by the public in consequence of the use of the patent, and claiming such name as a trade-mark.

In the case of St. Louis Stamping Co. v. Piper,[74] it appeared that the plaintiff commenced the manufacture of gray mottled enameled ironware in 1874; that, in 1876, a patent was issued for the process of making this enamel. The plaintiff applied to these goods the name "Granite Ironware," and under that name they became known to the public throughout the country. The defendants, having purchased goods from another manufacturer, advertised them for sale as "Granite Ware," and thereupon this motion was made to enjoin the use of the name in connection with the ware, the plaintiff claiming a common-law trade-mark in the name. The motion was denied, and Beach, J., in denying the motion, observed: "The term 'granite' was, doubtless, susceptible of use by the plaintiffs as an appropriate common-law trade-mark for goods of their manufacture. The difficulty, however, in the way of granting the injunction prayed for *pendente lite,* arises from the fact of their having so designated the ware for many years of manufacture by them under the protection of letters patent, which expired in 1893. Then the designation of 'granite' became public property, as well as the ware covered by the patent. That they may have taken out other letters still unexpired, in my opinion, does not prolong the monopoly of the name, but only gives protection as to the specific parts of the manufactured article covered by them."

It has also been held that the name "Tucker Spring Bed,"[75]

[74] (1895) 12 Misc. Rep. (N. Y.) 270.

[75] Tucker Mfg. Co. v. Boyington (1875) 9 Official Gaz. 455, Fed. Cas. No. 14,229.

applied to a bed, the name "Goodyear,"[76] applied to rubber goods, the name "Universal,"[77] applied to a printing press, the name "Weymouth's Patent,"[78] applied to hay knives, each became public property upon the expiration of the patent upon the article to which the name was applied. Where, however, a trade-mark right was acquired in England two and one-half years before the issue of a patent in the United States for the same article, and the trade-mark was used upon the entire product both in England and the United States, including part of the product made under the patent, and the trade-mark, not the patent, gave value to the article, it was held that the trade-mark did not become dedicated to the public upon the expiration of the patent.[79] In a case[80] recently decided by the circuit court of appeals for the second circuit, it appeared that a composition paint for use on the hulls of vessels was originally made and sold in Germany, prior to 1865, by Rahtjen & Sons, and acquired a high reputation under the name of "Rahtjen's Composition." In 1869 it was introduced into this country, and since that time was sold here continuously by the authorized agents of the original manufacturers, or their English licensees, under the trade-name of "Rahtjen's Composition." In 1873, the paint was patented in England, and the patent lapsed in 1880 for nonpayment of dues. In 1883, defendant commenced the manufacture of the same paint in England, using the name of "Rahtjen's Composition," and since 1890 had sold its production in the United States, and it was held that the expiration of the English patent did not affect the rights of

[76] Goodyear Rubber Co. v. Day (1884) 22 Fed. 44.
[77] Gally v. Colt's Patent Fire-Arms Mfg. Co. (1887) 30 Fed. 118.
[78] Holt Co. v. Wadsworth (1889) 41 Fed. 34.
[79] Thomson v. Batcheller (1899) 35 C. C. A. 532, 93 Fed. 660.
[80] Rahtjen's American Composition Co. v. Holzapfel's Composition Co. (1900) 41 C. C. A. 329, 101 Fed. 257.

the original makers to protection in this country in the exclusive use of the name, which had, since its introduction here, constituted the trade-name of their product. The circuit court[81] had held that the name had become *publici juris* by the expiration of the English patent. The decision of the circuit court was reversed by the court of appeals, Judge Wallace, however, dissenting, and expressing the opinion that the alleged trade-mark had become public property, first, because the name was the generic description of the patented article, and passed to the public at the expiration of the patent, and, secondly, because the name had long ceased to denote the source of the manufacture of the article. The supreme court of the United States reversed the decision of the circuit court of appeals, and affirmed the decision of the circuit court.[82] The grounds of the decision are stated in the following quotation: "We are of the opinion that no valid trade-mark was proved on the part of the Rahtjens, in connection with the paint sent by them from Germany to their agents in the United States prior to 1873, when they procured a patent in England for their composition. It appears from the record that from 1870 to 1879, or late in 1878, the paint was manufactured in Germany by Rahtjen, and sent to the United States in casks or packages marked 'Rahtjen's Patent Composition Paint.' Prior to November, 1873, the article was not patented anywhere, and a description of it as a patented article had no basis in fact, and was a false statement, tending to deceive a purchaser of the article. No right to a trade-mark which includes the word 'patent,' and which describes the article as 'patented,' can arise when there is and has been no patent; nor is the claim a valid one for

[81] Rahtjen's American Composition Co. v. Holzapfel's Composition Co. (1899) 97 Fed. 949.

[82] Holzapfel's Composition Co. v. Rahtjen's American Composition Co. (1901) 183 U. S. 1, 22 Sup. Ct. 6.

the other words used, where it is based upon their use in connection with that word. A symbol or label claimed as a trade-mark, so constituted or worded as to make or contain a distinct assertion which is false, will not be recognized, nor can any right to its exclusive use be maintained. Manhattan Medicine Co. v. Wood, 108 U. S. 218, 225, 27 L. Ed. 706, 708, 2 Sup. Ct. 436; Allan B. Wrisley Co. v. Iowa Soap Co., 104 Fed. 548. In 1873, an English patent had been obtained, and from that time to 1878, when the Rahtjens assigned the exclusive right of sale in the United States to Suter, Hartmann & Co., the words 'Rahtjen's Patent Composition' were used on casks containing the paint sent by the Rahtjens to the United States, and must have referred to the English patent, as there was no other, and the right to use those words depended upon the existence of the patent, although, up to 1878, the article sent to the United States was manufactured in Germany. As the right to use the word depended upon the English patent, the right to so designate the composition fell with the expiration of that patent, and from that time (1880) until 1883, when the trademark was obtained by Suter, Hartmann & Co., there can be no claim made of an exclusive right to designate the composition as 'Rahtjen's Composition,' because, from 1880, that right became public as a description of the article, and not of the name of the manufacturer. During its whole existence, the name had been given to the article, and that was the only name by which it was possible to describe it."

§ 111. Dedication to public by expiration of copyright.

Attempts have been made, after the expiration of a copyright upon a book, to hold the title of the book as a trademark. It is very questionable whether the title of a book is ever a valid trade-mark. In this particular instance, however, the court did not find it necessary to pass upon that

question, but contented itself with holding that there was no valid trade-mark in the name of the book in the instance before the court. In Merriam v. Holloway Pub. Co.,[83] which involved the right of defendants to use the words "Webster's Dictionary" in connection with a reprint of the 1847 edition of that work, upon which the copyright had expired, Mr. Justice Miller, in the opinion delivered by him, said: "I want to say, however, with reference to the main issue in the case, that it occurs to me that this proceeding is an attempt to establish the doctrine that a party who has had the copyright of a book until it has expired may continue that monopoly indefinitely, under the pretense that it is protected by a trade-mark, or something of that sort. I do not believe in any such doctrine, nor do my associates. When a man takes out a copyright for any of his writings or works, he impliedly agrees that, at the expiration of that copyright, such writings or works shall go to the public, and become public property. I may be the first to announce that doctrine, but I announce it without any hesitation. If a man is entitled to an extension of his copyright, he may obtain it by the mode pointed out by law. The law provides a method of obtaining such extension. The copyright law gives an author or proprietor a monopoly of the sale of his writings for a definite period, but the grant of a monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterwards to the unrestricted use of the book." And the justice further observed: "The contention that complainants have any special property in 'Webster's Dictionary' is all nonsense, since the copyright has expired. What do they mean by the expression 'their book,' when they speak of Webster's Dictionary? It may be their book if they have bought it, as a copy of Webster's Dictionary is my book

[83] (1890) 43 Fed. 450.

if I have bought it; but in no other sense than that last indicated can the complainants say of Webster's Dictionary that it is their book." Although the right to use the words was thus adjudged, the duty not to deceive by the method of their employment was upheld and enforced, the court saying: "Now, taking all of these allegations together, there may be some evidence of a fraudulent intent on defendants' part to get the benefit of the reputation of the edition of Webster's Dictionary which the complainants are publishing, and it may possibly be that, in consequence of the facts averred, the public are deceived, and that the complainants are damaged to some extent. We think, therefore, that this is one of those cases where, as the facts are stated in the complaint, the interests of justice would be best subserved by requiring the defendants to answer, so that there may be a full and fair investigation of the law and facts upon a final hearing."

In Merriam v. Famous Shoe & Clothing Co.,[84] a ruling similar to that announced by Mr. Justice Miller was made; but although the right to use the words "Webster's Dictionary" was sustained, the obligation to so use as not to mislead was again stated. Judge Thayer said: "It is unnecessary at this time to determine what form of relief should be administered if the allegations of the bill are proven on final hearing. It may be that some change in the form of defendant's circulars and advertisements will be all the relief that the circumstances of the case fairly warrant; or it may be that the proof will warrant an order that the defendant place a notice in their book that it is a reprint of the edition of 1847 of Webster's Dictionary, with such additions as they may have made to it. This is a matter, however, to be considered on final hearing, when the exact nature of the injury and the causes that mislead the public are ascertained. It

[84] (1891) 47 Fed. 411.

is sufficient to say at present that, on the showing made, the complainants are entitled to relief, and the demurrer to the bill is accordingly overruled."

§ 112. Other forms of dedication to public.

A trade-mark right may be lost by any form of abandonment or dedication to the public. It has already been pointed out that, where the proprietor of a trade-mark is guilty of laches, he may, under certain circumstances, lose his trade-mark rights altogether, although in most instances he will lose only his right to damages and costs, but not the right to an injunction. Whenever a word becomes the generic name of an article, it becomes dedicated to the public to such an extent that it cannot thereafter be appropriated as a trade-mark, or, if it had been previously appropriated, it can no longer be held. The test for determining whether a word which was once a trade-mark has become *publici juris* is given by Mellish, L. J., in Ford v. Foster,[85] as follows: "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. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, and can be induced, from the use of it, to believe that he is buying the goods of the original trader, it appears to me, however hard, to some extent, it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone."

[85] (1872) 7 Ch. App. 611, 41 L. J. Ch. 682.

In Powell v. Birmingham Vinegar Brewery Co.,[86] in the English court of appeal, it was said by Lindley, L. J.: "Again, if a person makes an article not patented, and gives it a certain name, by which the article comes to be known in the market, any one who can make the same kind of article can call it by the name by which it is known, if he can in fact do so without passing off his goods for those of the original makers."

In the early English case of Singleton v. Bolton[87] it was shown that one Dr. Johnson had invented a medicine which he called "Dr. Johnson's Yellow Ointment." The medicine had by long use become known by this name alone. The court held that no action would lie to prevent the defendant from using the same name for the medicine. Lord Mansfield said that both the plaintiff and defendant used the name of the original inventor, and no evidence was given of the defendant having sold the medicine as if prepared by the plaintiff. It would seem that the name had become the proper name of the medicine, and that any one had a right to use it. So, in the case of Canham v. Jones,[88] a demurrer to a bill was allowed where the plaintiff sought to restrain the defendant from using the name "Velno's Vegetable Syrup" in connection with a medicine. Vice-Chancellor Plumer said: "The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him, but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this bill, therefore,—the exclu-

[86] [1896] 2 Ch. 54, 65 Law J. Ch. Div. 563.
[87] (1783) 3 Dougl. 293.
[88] (1813) 2 Ves. & B. 218, 13 Rev. Rep. 70.

sive right asserted by the plaintiff,—failing, all the consequential relief falls with it."

In the case of Thomson v. Winchester,[89] the declaration 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 substance, so compounded, he had given the name of "Thomsonian Medicines." Chief Justice Shaw, in delivering the opinion of the court, said: "The court are also of opinion that the rule laid down is correct; that without obtaining a patent, 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 plaintiff to make and vend these medicines, or to call them 'Thomsonian,' if this term had acquired a generic meaning, descriptive of a general kind, quality, and class of medicines, as, for instance, James' powders, or Turlington's balsam, and if they were not sold to consumers, or consigned or sold to others to be sold to consumers, as and for medicines made and prepared by the plaintiff. If the defendant made and sold medicines, calling them 'Thomsonian,' as a generic term designating their general character, but did not offer and sell them, nor consign them to others to sell, as and for medicines made and prepared by the plaintiff, and if he made and compounded such medicines of bad materials with inadequate skill, by means whereof the credit and character of all Thomsonian medicines were brought into disrepute, the plaintiff can recover no damage."

In Hostetter v. Fries[90] it was sought to enjoin defendants from using the name "Dr. J. Hostetter's Stomach Bitters." Judge Wallace, in denying the motion for preliminary in-

[89] (1837) 19 Pick. (Mass.) 214.
[90] (1883) 17 Fed. 620.

junction, said: "The complainants have neither the exclusive right to make bitters compounded after the formula of Dr. Hostetter, nor the exclusive right to sell bitters by the name of 'Hostetter's Bitters.' The preparation never had any name until it was offered to the public, and christened. When a new article is made, a name must be given to it, and this 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 the preparation made by another."

In Leclanche Battery Co. v. Western Electric Co. [91] it was held that the complainants could not maintain their claim to the exclusive right to use either the word "Disque" or "Pile-Leclanche" as a trade-mark when applied to the batteries manufactured and sold by them. Judge Wallace, in deciding this case, said: "As owners of the right to manufacture and sell the Leclanche batteries until the expiration of the patent granted to the assignee of Leclanche, they have been accustomed to use the word 'Disque' on the labels pasted on the glass jar which forms part of the battery, and the word 'Pile-Leclanche' blown in the glass. Neither of these words are arbitrary names, selected to denote the article as the production of a particular proprietor. They are appropriate, and are intended to indicate that the batteries are of a specified form, and are made according to the patent of Leclanche.

[91] (1885) 23 Fed. 276.

'Disque' describes the form of the battery, and is used to distinguish it from the prism and other forms of porous-cup batteries. 'Pile' is synonymous with battery, and 'Pile-Leclanche' is the designation in French of Leclanche's battery. When an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in, and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable. * * * As soon as Leclanche invented his battery in France, it was necessarily given the name 'Pile-Leclanche,' and that name could never again be appropriated exclusively as a trade-mark, even by the inventor himself. A name alone is not a trade-mark when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing which is being sold." And it was held by the court of New South Wales[92] that, where a word had been used by the inventor in connection with a particular class of goods, but had not been registered as a trade-mark, and it was made use of by another, not with any fraudulent intention of counterfeiting the goods of the inventor, but to denote the quality and character of the article sold, and the word had come to be so understood, it had become *publici juris*, and could not thereafter be registered as a trade-mark. And where an unpatented medicinal preparation had come to be popularly known by the name of a person, another person lawfully engaging in the manufacture of it has no right to appropriate that name to his own exclusive use as a proprietary trade-mark or trade-name.

§ 113. Acquiescence of original user necessary.

The later cases establish the rule that a word or mark

[92] National Starch Mfg. Co. v. Munn's Pat. Maizena & Starch Co. (1894) 6 Reports P. C. 462.

rightfully adopted as a trade-mark does not become the generic name of an article, and thus lost to the original user without his consent, except in case of expiration of a patent upon the article, or, possibly, under other exceptional circumstances.

In Powell v. Birmingham Vinegar Brewery Co.[93] it is said: "There is another way in which a name originally a good trade-name may lose its character and become *publici juris, i. e.,* where the first person using the name does not claim the right to prevent others from using it, and allows other persons to use it without complaint. The name then comes to denote the article, and nothing more. The name becomes *publici juris,* and any one who is at liberty to make the article can call it by the name by which it is usually known." The fact that a name adopted as a trade-mark to indicate the origin or ownership has become the general name of the article is not, under later decisions, any reason for holding that the name has become the generic name of the article, and has become dedicated to the public. This rule, while apparently in conflict with the earlier cases, is not so in fact. In the Johnson Ointment Case,[94] in the Velno Syrup Case,[95] and in the Ward Liniment Case,[96] it appeared that these terms had been permitted to become the usual and generic names of the articles, and it was appropriately held in each instance that a later user could not appropriate such generic name of the article to his exclusive use. If, however, the original manufacturer of Dr. Johnson's liniment or Velno's syrup or Ward's liniment had continued to manufacture such articles, claiming an exclusive right to the name thereon as a trade-mark, no matter how extensively the ar-

[93] [1896] 2 Ch. 54, 65 Law J. Ch. Div. 563.
[94] Singleton v. Bolton (1783) 3 Dougl. 293.
[95] Canham v. Jones (1813) 2 Ves. & B. 218, 13 Rev. Rep. 70.
[96] Watkins v. Landon (1893) 52 Minn. 389.

ticle was sold, even if it were in universal use, and were exclusively known by such name, such name would not become dedicated to the public, so that any one would have a right to use it without the consent of the original proprietor.

§ 114. General use of name does not dedicate it to public.

The mere fact that a name, lawfully adopted as a trade-mark, has been extensively or generally used as the name of the article, will not dedicate it to the public, and deprive the original proprietor of his exclusive rights. This doctrine is laid down clearly in a number of recent cases. Thus, in Burton v. Stratton[97] it is said: "If the primary object of the trade-mark be to indicate origin or ownership, the mere fact that the article has obtained such a widespread sale that the mark has also become indicative of quality is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his trade-mark just at the time when it had become most valuable to him, and stood most in need of protection. But if the name be suffered to come into general use without objection from the proprietor, it may become merely generic or indicative of quality." And in Celluloid Mfg. Co. v. Cellonite Mfg. Co.,[98] Mr. Justice Bradley said: "It is undoubtedly true, as a general rule, that a word merely descriptive of the article to which it is applied cannot be used as a trade-mark. Everybody has a right to use the common appellatives of the language, and to apply them to the things denoted by them. A dealer in flour cannot adopt the word 'flour' as his trade-mark, and prevent others from applying it to their packages of flour. I am satisfied from the evidence adduced before me that the

[97] (1882) 12 Fed. 696.
[98] (1887) 32 Fed. 94.

word 'celluloid' has become the most commonly-used name of the substance which both parties manufacture, and, if the rule referred to were of universal application, the position of the defendant would be unassailable. But the special case before me is this: The complainant's assignors, the Hyatts, coined and adopted the word when it was unknown, and made it their trade-mark, and the complainant is assignee of all the rights of the Hyatts. When the word was coined and adopted, it was clearly a good trade-mark. The question is whether the subsequent use of it by the public, as a common appellative of the substance manufactured, can take away the complainant's right. It seems to me that it cannot. As a common appellative, the public has the right to use the word for all purposes for designating the article or product except one,—it cannot use it as a trade-mark, or in the way that a trade-mark is used, by applying it to and stamping it upon the articles. The complainant alone can do this, and any other person doing it will infringe the complainant's right. Perhaps the defendant would have a right to advertise that it manufactures celluloid, but this use of the word is very different from using it as a trade-mark stamped upon its goods. It is the latter use which the complainant claims to have an exclusive right in, and, if it has such right (which it seems to me it has), then such a use by the defendant of the word 'celluloid' itself, or of any colorable imitation of it, would be an invasion of the complainant's rights."

In the case of Schendel v. Silver[99] it was held by the New York supreme court that where the manufacturer has invented a new name, consisting either of a new word or words in common use, applied for the first time to distinguish his manufactures, if the name be not generic or descriptive of

[99] (1892) 63 Hun (N. Y.) 330.

the article, and not used to denote grade or quality, but is arbitrary and fanciful, he is entitled to be protected in its use, even though it has become so generally known as to be adopted by the public as descriptive of the article.

In the well-considered case of Selchow v. Baker,[100] the court of appeals of the state of New York, in an opinion delivered by Judge Rapallo, in discussing this question, said: "It cannot be true, as a general proposition, as contended on the part of the defendants, that, when a manufacturer has given to his products a new name invented by himself for the purpose of distinguishing them as his, and the article becomes generally known to the trade and to the public by that name, the name becomes public property, and every one has a right to use it. That proposition can be sustained only in respect to names which are descriptive of the article, and incapable of being appropriated as trade-marks. The value of a trade-mark consists in its becoming known to the trade as the mark of the manufacturer who has invented or adopted it, and in being known to the public as the name of an article which has met with popular favor. It cannot be that the very circumstances which give it value operate at the same time to destroy it. * * * Our conclusion is that, where a manufacturer has invented a new name, consisting either of a new word, or a word or words in common use, which he has applied for the first time to his own 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 qualities, 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 that name, notwithstanding that it has become so generally known that it has

[100] (1883) 93 N. Y. 59.

been adopted by the public as the ordinary appellation of the article."

§ 115. Whether name has become generic is question of fact.

Whether a name that had once been a valid trade-mark has become the generic name of the article to which it is applied, and hence has become dedicated to the public, is, in every case, purely a question of fact to be determined by the court on the evidence before it.[101]

101 Noera v. Williams Mfg. Co. (1893) 158 Mass. 110.

CHAPTER VI.

TRANSFER OF TRADE-MARKS.

§ 116. Trade-Marks Generally Assignable with Business in Which Used.
117. As an Abstract Right, Trade-Mark not Assignable.
118. Assignee Acquires All Rights of Assignor.
119. Assignee Has no Better Title than Assignor.
120. One may Assign His Own Name so as to Deprive Himself of Its Further Use.
121. Trade-Mark Assignable with Letters Patent.
122. Partnership Generally Acquires Trade-Mark of Individual Partners.
123. Firm may Have License from Individual Partner, Which Will Revert to Owner on Dissolution of Partnership.
124. Firm or Corporation Succeeding to Business Acquires Trade-Mark.
125. Partners Remaining in Firm Entitled to Firm Trade-Marks.
126. All Partners Entitled to Use Trade-Mark on Dissolution of Firm: Hazard v. Caswell.
127. Same Rule: Huwer v. Dannenhoffer.
128. Cases of Hazard v. Caswell and Huwer v. Dannenhoffer Compared with Menendez v. Holt.
129. Successor may Acquire Right to Use Name from Others.
130. Successor to Original Proprietor may Appropriate Trade-Mark.
131. One Who Acquires Manufactory may Acquire Right to Use Trade-Mark.
132. Proprietor may Use Name of Mill.
133. No Exclusive Right to Trade-Mark Acquired by Mortgage of Lands and Mill.
134. Personal Name not Transferable.
135 Whether Trade-Mark Assignable Depends upon Effect Produced by Use Thereof.
136. Trade-Mark Inseparable from Thing Which Gives It Value.
137. Name of Man cannot be Segregated from the Man Himself, and from His Business.

138. Trade-Mark Consisting of Name of Individual no Guaranty that Articles made by Individual Personally.
139. Names Held not Personal.
140. Personal Trade-Mark Held Assignable Where Original Proprietors Supervise Manufacture.
141. Question of Assignability Depends upon Circumstances.
142. Purchasers of Trade-Marks should Indicate Change.
143. Trade-Mark not Assignable Where Its Use would Deceive Public.
144. Transfer of Trade-Mark Apart from Business Confers no Title on Transferee.
145. Leading English Case of Leather Cloth Co. v. American Leather Cloth Co.
146. Sale of Woodcuts does not Transfer Trade-Mark.
147. Assignment of Invalid Registered Mark Insufficient to Support Injunction.
148. Assignment in Bankruptcy Carries Trade-Mark.
149. Assignment to Trustee of All Assets Carries Trade-Mark.
150. Instance of General Assignment not Passing Trade-Mark.
151. No Distinction Between Sale by Proprietor and Sale by Assignee.
152. Right to Use Name and Knowledge cannot be Taken by Judicial Proceeding.
153. Administrator of Assignee has no Title to Trade-Mark.
154. Trade-Mark cannot be Levied upon by Execution.

§ 116. Trade-marks generally assignable with business in which used.

Where a trade-mark is applied to a commercial article to indicate its origin at a particular manufactory or place of production, or its origin or ownership with a particular manufacturer or dealer, and not to indicate that such article is produced by the peculiar skill of any particular individual, the trade-mark is transferable, and will pass with the manufactory or place of production, or with the business in which it is used, to a successor to the original proprietor.[1] Trade-

[1] Kidd v. Johnson (1879) 100 U. S. 617; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540; Richmond Nervine Co. v. Richmond (1895) 159 U. S. 293; Pepper v. Labrot (1881) 8 Fed. 29; Prince's Metallic Paint Co. v. Prince Mfg. Co. (1893) 6 C. C. A. 647, 57 Fed.

marks of this character constitute a part of the assets of an individual, firm, or corporation, and pass under a sale of the assets and goodwill of the business, whether specifically men-

938; Witthaus v. Mattfeldt (1876) 44 Md. 303; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 10 Abb. Pr. (N. S.; N. Y.) 348; Id., 45 N. Y. 291; Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Oakes v. Tonsmierre (1883) 49 Fed. 447; Walton v. Crowley (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; Le Page Co. v. Russia Cement Co. (1892) 2 C. C. A. 555, 51 Fed. 941; Cuervo v. Landauer (1894) 63 Fed. 1003; Chattanooga Medicine Co. v. Thedford (1894) 14 C. C. A. 101, 66 Fed. 544; Jennings v. Johnson (1888) 37 Fed. 364; Lockwood v. Bostwick (1869) 2 Daly (N. Y.) 521; Soinl v. Geisendorf (1871) 1 Wils. (Ind.) 60; Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226; Gillis v. Hall (1870) 7 Phila. (Pa.) 422; Burton v. Stratton (1882) 12 Fed. 696; Huwer v. Dannenhoffer (1880) 82 N. Y. 499; Fish Bros. Wagon Co. v. La Belle Wagon Works (1892) 82 Wis. 546; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 49 Ill. App. 430, (1892) 142 Ill. 494; Wilmer v. Thomas (1891) 74 Md. 485; Mattingly Co. v. Mattingly (1894) 96 Ky. 430; Weener v. Brayton (1890) 152 Mass. 101; Dant v. Head (1890) 90 Ky. 255; Metcalfe v. Brand (1887) 86 Ky. 331; Symonds v. Jones (1890) 82 Me. 302; Laughman's Appeal (1889) 128 Pa. 1; Kinney Tobacco Co. v. Maller (1889) 53 Hun (N. Y.) 340; Frank v. Sleeper (1890) 150 Mass. 583; Noera v. Williams Mfg. Co. (1893) 158 Mass. 110; Merry v. Hoopes (1888) 111 N. Y. 415; Hall v. Barrows (1863) 4 De Gex, J. & S. 150; Leather Cloth Co. v. American Leather Cloth Co. (1862) 4 De Gex, J. & S. 137; Edleston v. Vick (1853) 23 Eng. Law & Eq. 51, 18 Jur. 7; Warren v. Warren Thread Co. (1882) 134 Mass. 247.

In Kidd v. Johnson (1879) 100 U. S. 617, 620, Field, J.: "As to the right of Pike to dispose of his trade-mark in connection with the establishment where the liquor was manufactured, we do not think there can be any reasonable doubt. It is true, the primary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is affixed. As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it. Its subsequent use by the

tioned or not.[2] The transfer of the trade-mark may be by a separate instrument, extending to the vendee and his suc-

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. Such is the purport of the language of Lord Cranworth in the case of Leather Cloth Co. v. American Leather Cloth Co., reported in 11 Jur. 513. See, also, Ainsworth v. Walmesley, 35 L. J. Ch. 355, and Hall v. Barrows, 10 Jur. 55. The present case falls within this rule."

In Fish Bros. Wagon Co. v. Fish Bros Mfg. Co. (1899) 37 C. C. A. 146, 95 Fed. 457, 461, Sanborn, Cir. J.: "The appellant contends that this rule is inapplicable to the case at bar because the right of Titus G. Fish and Edwin B. Fish to the use of the words and devices in question * * * was not subject to sale as distinct property, separate from the articles manufactured and the business of manufacturing, so that, as it claims, the appellee acquired no right to their use under its assignment from the Fishes. But this position is untenable, because the evidence is clear, not only that the assignment of the right to use these words and devices contained a conveyance of the goodwill of the business of the Fishes in Wisconsin, but also that it was a part of a single transaction by which they transferred to the appellee, at Clinton, Iowa, all the machinery, patterns, business, goodwill, and the right to the use of the trade-names which they owned and used in the business of manufacturing wagons at South Superior, Wis., and of selling them throughout the country. The assignment was not invalid because it was not accompanied with a transfer of the business and machinery. * * * Restraints upon alienation are not favored by the law. The modern rule is that one may do what he will with his own, unless prohibited by a positive statute, or restrained by manifest public policy. The principal value of property inheres in the right to sell it, and

[2] Johnson v. Schenck (1877) 1 Cin. Law Bul. 374, Fed. Cas. No. 7,412; Morgan v. Rogers (1884) 19 Fed. 596; Shipwright v. Clements (1871) 19 Wkly. Rep. 599; Frese v. Bachof (1878) 14 Blatchf. 432, Fed. Cas. No. 5,110; Le Page Co. v. Russia Cement Co. (1892) 51 Fed. 941; Adams v. Adams (1879) 7 Abb. N. C. (N. Y.) 292; Hoxie v. Chaney (1887) 143 Mass. 592; Listman Mill Co. v. Listman Milling Co. (1894) 88 Wis. 334; Allegretti v. Allegretti Chocolate Cream Co. (1898) 177 Ill. 129; Rubel v. Allegretti Chocolate Cream Co. (1898) 76 Ill. App. 581.

cessors the use of all brands formerly used by the vendor in such manufactory, and the right to use such brands will be deemed coextensive with the whole country, and exclusive in such vendee and his successors.[3] There are a few cases in-

all property is presumed to be salable and assignable unless its sale or assignment is clearly forbidden. Barnes v. Poirier, 27 U. S. App. 500, 501, 12 C. C. A. 9, 10, 64 Fed. 14, 15."

In Dant v. Head (1890) 90 Ky. 255, 261, Lewis, C. J.: "The defense that the distiller's brand was not a subject of sale and transfer, and therefore formed no consideration for the alleged agreement, because the use thereof by another than F. M. Head & Co. was deceptive, is not valid, for it is well settled that a trade-mark affixed to articles manufactured at a particular place may be lawfully sold with the establishment."

In J. C. Mattingly Co. v. Mattingly (1895) 96 Ky. 430, 437, Lewis, J.: "And that a trade-mark or trade-name, such as the two described, affixed to an article manufactured at a particular place, may be lawfully sold and transferred with the establishment, is no longer an open question in this state. Dant v. Head, 90 Ky. 255."

In Symonds v. Jones (1890) 82 Me. 302, 312, Emery, J.: "What is known as the goodwill of the business is recognized by the law as a proper subject of sale or contract, in connection with a transfer of the business plant. An established business, with plants and products well known to the trade, has a money value often far above that of its mere plant, and this is often the controlling motive for the purchase. Labels, trade-marks, particular words and phrases devised or used to distinguish or identify the products of the plant, and associated with such products in the public mind, are in like manner usually transferred with the plant, and are regarded as valuable acquisitions for the purchasers. They are, equally with the goodwill, proper subjects of such sale and contract. The name or initials of the originator or owner of the business, when used on labels and as trade-marks in the business, may thereby have a value, and so may be included in a sale of the business, so far, at least, as to prevent the vendor afterwards using them in like manner, on other similar products, to the detriment of his vendee."

In Laughman's Appeal (1889) 128 Pa. 1, 18, Clark, J.: "Trademarks are the proper subject of assignment, to the extent, at least, that, unless reserved, they pass with an assignment of business (Se-

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[3] Kidd v. Johnson (1879) 100 U. S. 617.

dicating that the mere right to use a name is not assignable,[4] but none that it may not be assigned to an outgoing partner

bastian, Trade-Marks, 236); and the assignment by one partner of all his interest in a firm to his co-partners will carry with it the exclusive use of the trade-mark of the firm (Menendez v. Holt, 128 U. S. 514). 'As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale; but when the trade-mark is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred, either by contract or operation of law, to others, the right to the use of the trade-mark may be lawfully transferred with it.'"

In Morgan v. Rogers (1884) 19 Fed. 596, 597, Colt, J.: "There is no reason why a trade-mark cannot be conveyed with the property with which it is associated. As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public. In this respect it differs from a patent or a copyright; but in connection with the article produced, it may be bought and sold like other property. It constitutes a part of partnership assets, and is properly sold with the firm property."

In Skinner v. Oakes (1881) 10 Mo. App. 45, 55, Thompson, J.: "There are some quasi proprietary rights, such as the elective franchise, which are incapable of assignment; but it would be obviously unjust so to restrict the right to use a trade-mark. The advantages which accrue from the use of a particular trade-mark or advertising device are often the result of a lifetime of integrity, skill, perseverance, and business capacity. Ought it to be held that a right so valuable should die with the person who created it, it being incapable of assignment, when, by reason of age or other considerations, he might desire to cease using it? The custom of trade, which solves many questions in advance of the courts, has declared that this should not be; and the courts, in adopting the view that the right to use a trade-mark is assignable, did no more than declare a result which followed from the concession that it was property, for the jus disponendi is embodied in the very idea of property. It is hence settled law that the right to use a trade-mark is not a mere personal privilege, but that, within certain limits, it is capable

[4] Chadwick v. Covell (1890) 151 Mass. 190; Skinner v. Oakes (1881) 10 Mo. App. 45.

or to a successor in business, as an incident to its goodwill.[5] And even where the trade-mark was not designed until after

of being bought and sold as other property. 'A trade-mark,' says Strong, J., 'like the goodwill of a store or manufacturing establishment, is a subject of commerce, and it has been many times held entitled to protection at the suit of vendees.' Fulton v. Sellers, 4 Brewst. (Pa.) 42. See, also, Bury v. Bedford, 33 L. J. Ch. 465; Hall v. Barrows, 33 L. J. Ch. 204; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 226; Peltz v. Eichele, 62 Mo. 171." Continuing, Thompson, J., said: "But there are many cases where the courts uphold the use of a name as a trade-mark, trade-name, or advertising engaged in the trade, and although, in order to do so, it is necessary to enjoin the person whose name is so used from a similar use of the name. These cases, so far as I have been enabled to discover and classify them, are two-fold: First. Where the business is sold, together with the goodwill thereof, in which case, either by the usages of trade or the express contract of the parties, the name passes with the business to the assignee. In such cases, in view of the courts, no deception is, in fact, practiced upon the public, since, in conformity with the usages of trade, the names used in the style of a business firm are not understood by the public as necessarily implying that persons of that name are actually members of the firm. Such was the case of Churton v. Douglas, Johns. Eng. Ch. 174, where John Douglas, of the firm of John Douglas & Co., having sold out his interest in the property and goodwill of the firm, was enjoined from taking in other partners and setting up a similar business near the old place, under the same firm name of John Douglas & Co. Such, also, was Dixon Crucible Co. v. Guggenheim, 2 Brewst. (Pa.) 321; * * * and such was this case, as it stood between Probasco and Oakes, as will be seen by reference to Probasco v. Bouyon, 1 Mo. App. 241. Some courts, indeed, have gone so far as to assimulate a trademark to the species of property known as 'goodwill,' insomuch as to hold that it is not vendible except as a part of the establishment or business with which it was originally connected. Leather Cloth Co. v. American Leather Cloth Co., 11 H. L. Cas. 523, 534, 544; Witthaus v. Mattfeldt, 44 Md. 303, 306."

In Petrolia Mfg. Co. v. Bell & Bogart Soap Co. (1899) 97 Fed. 781, 783, Townsend, Dist. J.: "The bill alleges that Jenkins was the inventor of the trade-mark, and a producer of, and dealer in, said

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[5] Ainsworth v. Walmsley (1866) L. R. 1 Eq. 518; Richmond Nervine Co. v. Richmond (1895) 159 U. S. 293.

the transfer of the business, and there was no formal transfer of the trade-mark, the successor becomes the owner of the trade-mark where it appears that it was designed and adopted for use in the business previously transferred. And the

soap, or who had caused said soap to be manufactured or produced for him, and that he 'organized a corporation, under the laws of the state of New Jersey, named the "Coal Oil Johnny Soap Company," for the purpose of manufacturing and selling said soap,' and assigned said trade-mark to said company, subject to a certain condition subsequent. This is not a sale of a trade-mark, as distinct property separate from the article or the manufacturer, but a transfer by the producer of the right to use the trade-name in connection with the corporation and place of business which he has organized and established to manufacture and deal in the article."

In Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291, 302, Folger, J.: "A property in 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. Upton, Trade-Marks, 52. And it may also pass, by operation of law, to any one who, at the same time, takes that right. Dixon Crucible Co. v. Guggenheim, 2 Brewst. (Pa.) 335. And see Banks v. Gibson, 34 Beav. 566. The plaintiffs purchased of the former proprietors the spring. They took the whole property in it. They thus obtained that which was the prime value of it,—the exclusive right to preserve its water in bottles, as an article of merchandise, and the exclusive right to sell it when bottled. Thus, they acquired the business of their predecessors, for, the plaintiffs owning the spring, no one else could carry on the business; and, under the rules above stated, they acquired, by assignment or operation of law, the right to the trade-mark before that in use to designate the article upon which this business was carried on. See, also, Hall v. Burrows, 10 Jur. 55."

In Allegretti v. Allegretti Chocolate Cream Co. (1898) 177 Ill. 129, 132, Wilkin, J.: "The transfer of the property and effects of a business carries with it the exclusive right to use such trade-marks or trade-names as have been used in such business. Snyder Mfg. Co. v. Snyder, 54 Ohio St. 86; Williams v. Farrand, 88 Mich. 473; Fish Bros. Wagon Co. v. La Belle Wagon Works, 82 Wis. 546; Merry v. Hoopes, 111 N. Y. 415; Feder v. Benkert, 70 Fed. 613, 18 C. C. A. 549."

trade-mark is not rendered unassignable from the fact that it bears the designer's own name and portrait,[6] or that it consists simply of the name of the vendor, or of a surname which has become impersonal, by being attached to an article of manufacture, and becoming the name by which such article is known on the market.[7]

[6] Richmond Nervine Co. v. Richmond (1895) 159 U. S. 293.

[7] Dant v. Head (1890) 90 Ky. 255; Vonderbank v. Schmidt (1892) 44 La. Ann. 264; Fish Bros. Wagon Co. v. La Belle Wagon Works (1892) 82 Wis. 546.

In Rubel v. Allegretti Chocolate Cream Co. (1898) 76 Ill. App. 581-588, Horton, J.: "There is no testimony showing that Allegretti Bros. executed and delivered to appellee any formal assignment or transfer of the right claimed; but no such formal transfer is necessary * * * if such right existed in Allegretti Bros. In Snyder Mfg. Co. v. Snyder, 54 Ohio St. 86, 97, the supreme court, quoting from Horton Mfg. Co. v. Horton Mfg. Co., 18 Fed. 816, states the rule thus: 'If one has made of his own name a trade-mark, and then transfers to another his business, in which his name has been so used, the right to continue such use of the name will doubtless follow the business as often as it may be transferred.' In Williams v. Farrand, 88 Mich. 473, 480, it is held 'that an assignment of all the stock, property, and effects of a business * * * carries with it the exclusive right to use * * * such trade-marks and trade-names as have been in use in such business. These incidents attach to the business or right of manufacture, and pass with it. Courts have uniformly held that a trade-mark has no separate existence; that there is no property in words, as detached from the thing to which they are applied; and that a conveyance of the thing to which it is attached carries with it the name.' In the case of Fish Bros. Wagon Co. v. La Belle Wagon Works, 82 Wis. 546, the business of the firm of Fish Bros., wagon manufacturers at Racine, together with all the property and assets, passed to Fish Bros. & Co., agents; thence into the hands of a receiver; thence to the Fish Bros. Wagon Co., a corporation. The Fish brothers remained in the business through the successive changes. * * * Several years after the organization of the corporation, the Fish brothers withdrew therefrom, and formed a partnership to manufacture and deal in wagons in another place, under the name of Fish Bros. & Co. In an action against them by the corporation, it is held that the latter had acquired the goodwill of the original business, and the

§ 117. As an abstract right, trade-mark not assignable.

As a mere abstract right, having no reference to any particular person or property, a trade-mark cannot pass by assignment or descend to a man's legal representatives. The reason for this is that, as an abstract right, apart from the business in which it is used, a trade-mark has no existence. To permit a trade-mark to be transferred apart from the business in which it is used would be productive of fraud upon the public. Moreover, the trade-mark must be assigned for continued use upon the same article or class of articles upon which it was used by the assignor.[s]

right to use the said names ['Fish Bros.' etc.] and pictures [a fish on which were the words 'Bros.' etc.] as trade-marks, although the same were not specifically mentioned in any of the transfers of the business to the corporation. In the case of Merry v. Hoopes, 111 N. Y. 415, it is held that where, upon the dissolution of a firm, one of the partners purchases and succeeds to the business of the firm, the exclusive right to use trade-marks belonging to the firm passes to the purchaser, although no express mention is made of them in the deed of assignment. There was no express assignment in Feder v. Benkert, 18 C. C. A. 549, 70 Fed. 613, yet it was there held that the trade-mark passed to the several successors, although no one originally connected with the firm had any longer any interest therein."

In Wilmer v. Thomas (1891) 74 Md. 485, 488, Alvey, C. J.: "That the goodwill of an established business, as also the brands or trade-marks used to distinguish and specially denote the product of manufacture of the establishment, are property, and form the subjects of contract and sale, is a principle too well settled to need the citation of authorities for its support. * * * And so important a contribution to the value of the establishment are these elements or accessories of the business that, in the sale or assignment of such manufactory or business establishment, to be continued as formerly, the sale or transfer of such an establishment ordinarily carries with it, by reasonable intendment or implication, the right to such goodwill and trade-mark."

[s] Morgan v. Rogers (1884) 19 Fed. 596; Filkins v. Blackman (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786; Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; Witthaus v. Mattfeldt (1875) 44

§ 118. Assignee acquires all rights of assignor.

The assignee of the original proprietor of a trade-mark, and of the goodwill of the trade, stands in the same relation

Md. 303; Skinner v. Oakes (1881) 10 Mo. App. 45; Weston v. Ketcham (1876) 51 How. Pr. (N. Y.) 455; Weener v. Brayton (1890) 152 Mass. 101; Fair v. Jose Morales & Co. (1899) 82 Ill. App. 499; McVeagh v. Valencia Cigar Factory (1885) 32 Pat. Off. Gaz. 1124; Cotton v. Gillard (1874) 44 L. J. Ch. 90.

In Weener v. Brayton (1890) 152 Mass. 101, 103, Devens, J.: "The right to a trade-mark cannot exist as a mere abstract right, independent of and disconnected from a business. It is not property, as distinct from, but only as incident to, the business. It cannot be transferred except with the business, may be sold with it, and ordinarily passes with it. Cigar-Makers' Protective Union v. Conheim, 40 Minn. 243."

In Weston v. Ketcham (1876) 51 How. Pr. (N. Y.) 455, 456, Sedgwick, J.: "Mrs. Pepper did not succeed to any business of her husband's, which continuing, a trade-mark belonging to it might continue. Her husband left no such business, and there is no such thing as a trade-mark in 'gross,' to use that term by analogy. It must be 'appendant' of some particular business in which it is actually used upon or in regard to specific articles. And she is in no way disclosed by the evidence—and I do not see how any could possibly exist—become possessed of the right to transfer to any one the right to use her deceased husband's name."

In Witthaus v. Mattfeldt (1875) 44 Md. 303, 306, Robinson, J.: "The mere sale of a trade-mark apart from the article to which it is affixed confers no right of ownership, because no one can claim the right to sell his goods, as goods manufactured by another. To permit this to be done would be a fraud upon the public."

In Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321, 339, Paxson, J.: "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."

In The Fair v. Jose Morales & Co. (1899) 82 Ill. App. 499, 505, Sears, J.: "That trade-marks cannot be thus conveyed in gross by in-

to the trade-mark as his assignor would, and whatever privilege the law accorded to his assignee in the possession and

dependent transfer, without also conveying the business to which the trade-mark attaches, is established by many decisions of different jurisdictions, among which are Dixon Crucible Co. v. Guggenheim, 2 Brewst. (Pa.) 321, and Witthaus v. Mattfeldt, 44 Md. 303."

In Skinner v. Oakes (1881) 10 Mo. App. 45, 59, Thompson, J.: "So, in the case before us, if we could gather from the record that the plaintiffs are the successors in business of Probasco & Oakes; that they had become the assignees, not merely of the trade-marks and tokens, but also of the establishment and the business, so that they are really carrying on the same business and manufacturing and selling the same goods as Probasco & Oakes,—we should have no difficulty in holding that they are entitled to the relief which the court below awarded them. But, so far as we can gather from the record, they stand before us as the naked assignees of certain trade-marks and tokens which were used by the originators of them in the sale of candles, and they claim the general right to sell candles by means of these trade-marks and tokens. This claim can only be supported by alleging and proving that these marks and tokens were originally devised and used to designate goods of a certain quality or description, and that they are, in fact, using them to designate goods of substantially the same quality or description. Filkins v. Blackman, 13 Blatchf. 440, Fed. Cas. No. 4,786."

In Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222, 234, Robertson, J.: "But it is doubtful if the right of using a mere trade-mark, by itself, can be transferred like a copyright, so as to make wares, not yet in existence, the subject of them, and the injury to an assignee of it greater or less by the use of it by others. The imitation of a trade-mark is entirely a personal injury. It is merely passing off the wares of the imitator as being those of the party injured. I do not see how his borrowing or purchasing the supposed right to use a certain mark to designate his wares can make the offense greater or less. Still less do I see how the relinquishment by the assignor of his trade-mark, and the dealing in particular wares, although in favor of a certain person, can prevent the rest of the world from using that trade-mark to distinguish their wares. On the other hand, although a name has been used by any one as a trade-mark, and is susceptible of being used as such, its previous employment by him, when abandoned, does not prevent any one else from employing it to designate their wares. It is wholly immaterial how long or how much a word has been employed as a trade

use of the trade-mark passes to such assignee under the assignment.[p]

mark. The employer of it can neither give any special right to another, nor abandon it to the community, so as to forever take away the right of employing it to designate his wares. If he can, the first use of a trade-mark gives a common-law perpetual copyright in it. If that exist in this case, it must be in the tradesman in London and Dublin, who applied the term 'Club House' to superior articles, and particularly to those who applied it to gin, as testified to by the witnesses."

[p] Walton v. Crowley (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Cuervo v. Landauer (1894) 63 Fed. 1003; Sohl v. Geisendorf (1871) 1 Wils. (Ind.) 60; Solis Cigar Co. v. Pozo (1891) 16 Colo. 388.

In Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42, 48, Strong, J.: "Nor do we think the position tenable that the complainants are not entitled to relief because they are only assignees of the trade-mark, and use it without designating themselves as assignees. We do not perceive how their using the mark after they bought it, without giving notice that they are not the original owners of it, can be a fraud upon the public of which the defendant can avail himself. A trade-mark, like the goodwill of a store or manufacturing establishment, is a subject of commerce, and it has been many times held entitled to protection at the suit of vendees. Pirating the trade-mark of another is an infringement upon that other's right, and the use which he may make of that right cannot be in issue when a court is asked to stay the piracy."

In Solis Cigar Co. v. Pozo (1891) 16 Colo. 388, 395, Bissell, C.: "It was manifest that the original trade-mark had been adopted by R. Solis. He had devised and applied it to the El Cablo brand of cigars. The Solis Company, however, by transfer and succession, came into the right to use the brand. After the organization of the company, by the consent and procurement of the original owner, who was the largest individual stockholder of the concern, they continued the use of the mark. It is true that there was no formal transfer of the right, but the circumstances clearly manifest the intention of the parties, and the case becomes one of a continuing trade-mark in the possession of a corporation which succeeded to all the rights, goodwill and trade of the former owner. In such a case, the corporation would be treated as the equitable owner. At any rate, the respondent could not be heard to complain, and the plaintiff would not be denied relief on that ground."

§ 119. Assignee has no better title than assignor.

The assignee of a trade-mark can, of course, obtain no better title to the trade-mark than is held by his assignor. So it was held that, where the plaintiff's assignor had no exclusive right to adopt the words "New Orleans Mead" at the time he adopted them as a trade-mark, he acquired no rights by their subsequent use which the law will protect on that ground.[10]

§ 120. One may assign his own name so as to deprive himself of its further use.

A person may lawfully assign and sell, not only a trade-mark indicative of origin in himself, but even the right to use his own name in connection with a particular business, and the assignee will thereby become entitled to the exclusive use of the name, even as against the assignor. A person has the right to use his own name in conducting his business, either by himself or in connection with others, if done in a proper or legitimate way, and this right is a valuable one, especially when he is the discoverer of a valuable article of trade then being manufactured and sold on the market.

[10] St. Louis Carbonating & Mfg. Co. v. Eclipse Carbonating Co. (1894) 58 Mo. App. 411.

In Skinner v. Oakes (1881) 10 Mo. App. 45, 53, Thompson, J.: "A point is made, in behalf of the defendant, Annie Oakes, that, before the plaintiffs acquired the alleged right to use the name of Oakes in the manufacture of candies, she, by marrying with Oakes, had acquired a right to use his name in the same connection, of which the plaintiffs cannot lawfully deprive her. There is nothing in this point except novelty. Peter Oakes could not confer upon Annie McLaughlin, by marrying her, any higher rights in the use of his own name than he himself had. A son cannot acquire from his father the right to use his father's name as a trade-mark, if the father had parted with the right by contract (Filkins v. Blackman, 13 Blatchf. 440, Fed. Cas. No. 4,786), and we do not see how a wife could stand in a better position as to the name of her husband."

This right, like most other property rights, is the subject of sale and transfer; and a person who has carried on business under a trade-name, or manufactured and sold a particular article in such manner as, by use of his name as a distinguishing feature of his trade-name or trade-mark, to cause the business or article to become known and established in favor under such trade-name or trade-mark, can sell or assign such trade-name or trade-mark when he sells the business, and by such sale or assignment deprive himself of the further use thereof.[11]

[11] Burton v. Stratton (1882) 12 Fed. 696; Hoxie v. Chaney (1887) 143 Mass. 592; Listman Mill Co. v. Listman Milling Co. (1894) 88 Wis. 334; Spieker v. Lash (1894) 102 Cal. 38; Le Page Co. v. Russia Cement Co. (1892) 2 C. C. A. 555, 51 Fed. 941; Gillis v. Hall (1870) 7 Phila. (Pa.) 422; Frazer v. Frazer Lubricator Co. (1887) 121 Ill. 147, (1886) 18 Ill. App. 450; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1892) 142 Ill. 494; Kennedy Corporation v. Kennedy (1899) 36 App. Div. (N. Y.) 599; Russia Cement Co. v. Le Page (1888) 147 Mass. 206; Rubel v. Allegretti Chocolate Cream Co. (1898) 76 Ill. App. 581; Mattingly v. Mattingly (1894) 96 Ky. 430; Symonds v. Jones (1890) 82 Me. 302; Kramer v. Old (1896) 119 N. C. 1.

In Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1892) 142 Ill. 494, 507, Bailey, C. J.: "It is undoubtedly true, as was held in Frazer v. Frazer Lubricating Co., 121 Ill. 147, that where a party sells out an established business, and with it his own name, to be used in connection with such business, his vendee will acquire a right to the use of the name, and the vendor cannot afterwards assume it in carrying on the same business. * * * The right of a man to use his own name in connection with his own business is so fundamental that an intention to entirely divest himself of such right, and transfer it to another, will not readily be presumed, but must be clearly shown. Where it is so shown, the transaction will be upheld."

In Symonds v. Jones (1890) 82 Me. 302-313, Emery, J.: "The respondent further urges that the words 'John Winslow Jones' constitute his name, and that the letters 'J. W. J.' are the initials of his name, and were intended to represent his name and initials, and that no one else can acquire the right to use them, or to prevent

§ 121. Trade-mark assignable with letters patent.

It has been held that a trade-mark used to designate goods manufactured under letters patent is assignable with the letters patent.[12] In this case, Morris, C., said: "This assignment and transfer carried with it to the assignee the exclusive right to manufacture and sell the grain drill specified in the letters patent, and to carry on the business of making and selling the same. It was a transfer to appellant of the right to carry on the business in which Joseph Ingels had been engaged, and in connection with which he had used said trade-mark. As incident to the right thus transferred

his using them. * * * The name or initials of the originator or owner of the business, when used on labels and as trade-marks in the business, may thereby have a value, and so may be included in a sale of the business, so far, at least, as to prevent the vendor afterwards using them in like manner on other similar products, to the detriment of his vendee."

In Kramer v. Old (1896) 119 N. C. 1, 7, Avery, J.: "The modern doctrine is founded on the basic principle that one who, by his skill and industry, builds up a business, acquires a property at least in the goodwill of his patrons which is the product of his own efforts (Cowan v. Fairbrother, 118 N. C. 406), and has the fundamental right to dispose of the fruits of his own labor, subject only to such restrictions as are imposed for the protection of society either by express enactments of law or by public policy. Hughes v. Hodges, 102 N. C. 239; Bruce v. Strickland, 81 N. C. 267. But the property which one thus creates by skill or talent and industry is not marketable, unless the owner is at liberty to sell his right of competition to the full extent of the field from which he derives his profit, and for a reasonable length of time. Cowan v. Fairbrother, supra; 2 High, Inj. § 1174; Leather Cloth Co. v. Lorsont, 39 Law J. Ch. 86; Rousillon v. Rousillon, 14 Ch. Div. 351; Clark, Cont. p. 451. To the extent that the assignor of this species of property is left at liberty to come into competition with the assignee, the market value of what is sold must fall below that of the untrammeled right to freedom from competition in the whole field from which the former derived the support of his business."

[12] Julian v. Hoosier Drill Co. (1881) 78 Ind. 408.

to the appellant, Joseph Ingels might, as he is averred to have done, assign to her his right to and property in said trade-mark. The assignment and the right to make it did not in any way depend upon the time at which the appellant might engage in business. Nor was it necessary to the validity of the transfer of the trade-mark that the place of business or drills actually manufactured should be transferred. It was enough if the right to engage in the business was assigned. As incident to the assignment of this right, it was quite competent to assign the right to the trade-mark."

§ 122. Partnership generally acquires trade-mark of individual partners.

When a partnership is formed to manufacture the article to which a trade-mark is properly applied, the trade-mark of one partner, in the absence of special regulations, becomes part of the partnership property.[13] But where the owner of a business, and of the realty used in the business, took two of his clerks into partnership, but did not place the realty or the trade-mark in the concern as a part of its capital stock, it was held that the trade-mark did not become partnership property, even though used on packages containing goods manufactured by the firm.[14]

[13] Filkins v. Blackman (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786; Bury v. Bedford (1864) 10 Jur. 503; Hoxie v. Chaney (1887) 143 Mass. 192. See, also, Sohier v. Johnson (1872) 111 Mass. 238.

[14] Kidd v. Johnson (1879) 100 U. S. 617.

In Kidd v. Johnson (1879) 100 U. S. 617-619, Field, J.: "At this time, and subsequently until its sale in 1868, the real property in Cincinnati upon which the business was conducted, and the distillery, with its fixtures and appurtenances, belonged to Pike, individually. In 1868, the firm moved its entire business to New York City, and Pike sold the real property in Cincinnati, and the stills, tubs, engines, boilers, tubing, and all apparatus in his distillery, for the consideration of $125,000, to the firm of Mills, Johnson & Co., who were also engaged in the manufacture and sale of whiskey

§ 123. Firm may have license from individual partner, which will revert to owner on dissolution of partnership.

In Batcheller v. Thomson it appeared that a manufacturer of corsets in England adopted a trade-mark before its use in this country, and its application to the goods before their importation, and its distinct ownership, were known and acted upon by a firm in New York of which the manufac-

at that place. At the same time, Pike executed and delivered to the purchasers a separate instrument, stating that, having sold his premises to them, he extended to them and their successors the use of all his brands formerly used by him in his Cincinnati house. * * * The principal question for determination is whether the complainants, claiming under the sale of Pike to their predecessors, or the defendant Kidd, claiming as survivor of [said firm] S. N. Pike & Co., have the exclusive right to the trade-mark mentioned. The court below decided that the complainants possessed the exclusive right, and our judgment approves of the decision. It is admitted that Pike was the owner of the trade-mark when he took two of his clerks into partnership and formed the firm of S. N. Pike & Co. He did not place his interest in the trade-mark in the concern as a part of the capital stock. He allowed the use of it on packages containing the whiskey manufactured by them, but it no more became partnership property from that fact than did the realty itself, which he also owned, and on which their business was conducted. * * * They [S. N. P. & Co.] knew of his conveyance of its use to Mills, Johnson & Co., on the first of October, 1868, when they removed their own business to New York, and made no objection to the transfer. * * * That transfer was plainly designed to confer whatever right Pike possessed. It in terms extends the use of the trade-mark to Mills, Johnson & Co. and their successors. Such use, to be of value, must necessarily be exclusive. If others also could use it, the trade-mark would be of no service in distinguishing the whiskey of the manufacture in Cincinnati; and thus the company would lose all the benefit arising from the reputation the whiskey there manufactured had acquired in the market. The right to use the trade-mark is not limited to any place, city, or state, and therefore must be deemed to extend everywhere. Such is the uniform construction of licenses to use patented inventions. If the owner imposes no limitation of place or time, the right to use is deemed perpetual and coextensive with the whole country."

turer was a member. The goods so manufactured and stamped in England were sold to the New York firm, and the trade-mark was subsequently permitted by the owner to be used by the firm on corsets manufactured by it in the United States. It was held that this licensed use in the business of the firm of the trade-mark owned by one partner did not place the trade-mark in the firm, as a part of its assets, nor make it partnership property. It was further held that, on dissolution of the partnership, and the transfer by the owner of the trade-mark of his interest in the factory proper, such owner could continue in the purchaser the right to use the trade-mark which he had previously permitted the firm to use in their factory.[15]

§ 124. Firm or corporation succeeding to business acquires trade-mark.

Where a firm or corporation is organized to succeed to a business in which a trade-mark is used, and the business, with the assets and goodwill thereof, are transferred to such firm or corporation, the latter will also acquire the exclusive right to the trade-mark, in the absence of special regulations, unless the mark is of such a personal character that its use by the firm or corporation would constitute a fraud upon the public.[16]

[15] (1889) 35 C. C. A. 532, 93 Fed. 660, reversing 86 Fed. 630.

[16] Chattanooga Medicine Co. v. Thedford (1894) 66 Fed. 544; Oakes v. Tonsmierre (1883) 49 Fed. 447; Richmond Nervine Co. v. Richmond (1895) 159 U. S. 293; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540; Filkins v. Blackman (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786; Bury v. Bedford (1864) 10 Jur. (N. S.) pt. 1, p. 503, De Gex, J. & S. 352; Solis Cigar Co. v. Pozo (1891) 16 Colo. 388; Cutter v. Gudebrod Bros. Co. (1899) 44 App. Div. (N. Y.) 605; Allegretti v. Allegretti Chocolate Cream Co. (1898) 177 Ill. 129.

In Snyder Mfg. Co. v. Snyder (1896) 54 Ohio St. 86, 96, Williams, J.: "We are not reluctant, therefore, in holding that, upon the dissolution of a trading co-partnership, its assets, including the good-

§ 125. Partners remaining in firm entitled to firm trade-marks.

The general rule as to acquirement by the remaining partners of the trade-marks of a copartnership upon the retiring of one or more of the members of the firm is thus stated by the supreme court of the United States in Menendez v. Holt: "It may be that, where a firm is dissolved, and ceases to exist under the old name, each of the former partners would be allowed to obtain 'his share' in the goodwill, so far as that might consist in the use of trade-marks, by continuing such use in the absence of stipulation to the contrary; but when a partner retires from a firm, assenting to or acquiescing in the retention by the other partners of possession of the old place of business and the future conduct of the business by them under the old name, the goodwill remains with the latter as of course."[17]

will of the business, may be sold as a whole, either by the partners directly, or through a receiver under an order made by a court in a case to which they are parties; and that a purchaser thereof under either method of sale is entitled to continue the business as the successor of the firm, and make use of the firm name for that purpose. And, further, that where the purchaser transfers the property so acquired by him to a corporation of which he is a member, organized to succeed to the business, it may carry on the business in the same manner under a corporate name, including the name which had been used by the firm. Brass & Iron Works Co. v. Payne, 50 Ohio St. 115."

In Snyder Mfg. Co. v. Snyder (1896) 54 Ohio St. 86, 97, Williams, J.: "If it is desired to limit the right of the purchaser or his vendee in the use of the firm name, or exclude such right altogether, it should be done by stipulation in the contract, when the sale is made by the partners, or by a provision to that effect in the order, when the sale is made through the court."

[17] (1888) 128 U. S. 514. See, also, Batcheller v. Thomson (1898) 86 Fed. 630; Adams v. Adams (1879) 7 Abb. N. C. (N. Y.) 292; Cuervo v. Landauer (1894) 63 Fed. 1003; Merry v. Hoopes (1888)

§ 126. All partners entitled to use trade-mark on dissolution of firm: Hazard v. Caswell.

Where a firm, doing business in two cities, expired by limitation, and the plaintiffs rightfully continued to carry on business at the old place of business in one city, and, so far as the goodwill of the business attached thereto, must be deemed to have acquired all the benefit of it, it was held that, in the absence of an agreement, a trade-mark consisting of the word, letters, and figures, "Established A. D. 1780," used in the business at both places, would not accrue to the plain-

111 N. Y. 415; Rankin v. Newman (1896) 114 Cal. 635, 34 L. R. A. 265; De Grauw v. Schmid (1899) 38 App. Div. (N. Y.) 189.

In Hoxie v. Chaney, and Chaney v. Hoxie (1887) 143 Mass. 592, 594, C. Allen, J.: "Under these circumstances, the bill of sale was signed, with no agreement, either written or oral, to take Hoxie back as a member of the firm. By it Hoxie sold to Pegram 'the following goods and chattels, namely: All my right, title, and interest in and to all and singular the partnership property belonging to the firm of A. N. Hoxie & Co. (consisting of A. N. Hoxie and Frank R. Pegram), meaning hereby to sell and convey to said Pegram all my interest in the entire assets of said firm, wherever the same may be situated.' These terms are broad, and, although the trade-marks and the goodwill of the firm are not expressly mentioned, both are included within its meaning. Sohier v. Johnson, 111 Mass. 242, 243; 2 Lindley, Partn. (4th Ed.) 860, 861, 1046; Shipwright v. Clements, 19 Wkly. Rep. 599. Pegram therefore became the owner of the trade-marks, and his firm of Chaney & Pegram are now entitled to their exclusive use."

In Merry v. Hoopes (1888) 111 N. Y. 415, 420, Peckham, J.: "All the liabilities of the late firm [Hoopes & Merry] were assumed by the plaintiff [Merry], and he was to succeed it in the same business and at the same place. * * * The agreement of dissolution specified exactly what the defendant was to have from the firm, and the goodwill was not there included, nor any marks or brands, nor was defendant to succeed to the business, or any part thereof, and what the defendant did not take it was meant the plaintiff should have. * * * In this case we hold that, if these were trade-marks, then the plaintiff has proved such exclusive right, so far as the facts are now presented."

tiff, and that each party might use the devices which constituted the trade-mark, although neither, except by agreement, could use the name of the other.[18]

§ 127. Same rule: Huwer v. Dannenhoffer.

In Huwer v. Dannenhoffer [19] it appeared that the parties were formerly partners in the business of manufacturing glass chimneys for lamps, and adopted the word "Silex" as a trade-mark. The firm was dissolved, and defendants sold to plaintiff their interest in the real estate used for the business, and in certain specified property connected with it. Nothing was said at the time about the goodwill of the business, or the trade-mark, and there was no reference to it in the bill of sale. The plaintiff continued the business at the same place, using the same trade-mark. Defendants later commenced and thereafter carried on the same business in the same city, and also used the same trade-mark, and it was held, in an action to restrain the use of the trade-mark by defendants, that, assuming that the word "Silex" could be used as a trade-mark, and that the firm, while it existed, had the exclusive right so to use it, such exclusive right was not acquired by plaintiff; that, after the dissolution, either of the late partners could use it until in some way he had divested himself of that right; that, as the trade-mark was not in its nature local, it did not pass as an incident to what was sold, and that it was incumbent upon the plaintiff to show himself vested, by some agreement, with the exclusive right to use it, and that, in the absence of such showing, he could not prevail in the action.

[18] Hazard v. Caswell (1883) 93 N. Y. 259, reversing (1878) 57 How. Pr. (N. Y.) 1, (1880) 46 N. Y. Super. Ct. 559. See Caswell v. Hazard (1890) 121 N. Y. 484; Young v. Jones (1879) 3 Hughes, 274, Fed. Cas. No. 18,159; Taylor v. Bothin (1879) 5 Sawy. 584, Fed. Cas. No. 13,780; Robinson v. Finlay (1878) 9 Ch. Div. 487.

[19] (1880) 82 N. Y. 499.

§ 128. Cases of Hazard v. Caswell and Huwer v. Dannenhoffer compared with Menendez v. Holt.

The cases of Hazard v. Caswell and Huwer v. Dannenhoffer form no exception to the general rule stated by the supreme court of the United States in Menendez v. Holt. In Hazard v. Caswell, the copartnership had stores in two places, and used the trade-mark in question at both stores. The plaintiff acquired from his copartner the assets of the firm at one store only. Hence it was held that he did not acquire the exclusive right to the trade-mark which was used at the other store as well. In Huwer v. Dannenhoffer it does not appear that plaintiff acquired all of the assets of the old firm, or that he continued the business under the same name. In Merry v. Hoopes, the general rule stated in Menendez v. Holt is followed, and the decision in Merry v. Hoopes [20] is said by the court not to be in conflict with Hazard v. Caswell or Huwer v. Dannenhoffer.

§ 129. Successor may acquire right to use name from others.

Where H. sold the use of his name to C., and C. manufactured goods marked "H. & C.," and, on C.'s death, his son continued to manufacture goods with the same mark, and H. forbade him to use his name, and C.'s son replied that he had bought from another person, named H., the right to use his name, it was held that H. could not maintain a bill in equity against C.'s son, setting forth these facts as an infringement of a trade-mark, in the absence of a distinct allegation that the defendant used the name of H. with intent to represent it to be the name of the plaintiff, and thereby defraud and injure him.[21]

[20] (1888) 111 N. Y. 415. See, also, Adams v. Adams (1879) 7 Abb N. C. (N. Y.) 292.

[21] Hallett v. Cumston (1872) 110 Mass. 29.

§ 130. Successor to original proprietor may appropriate trade-mark.

It has been held in several cases, where a trade-mark or a name, or a trade-mark and name united, has been used and recognized as denoting that the article is made at a particular establishment, that those who succeed to the establishment, such as heirs, next of kin, or successors in interest, may, in carrying on the establishment thereafter, there being no statutory enactment to the contrary, continue to use the same name and trade-mark, without any reference to their derivative title, for nobody is thereby deceived, as they get the same article, and from the same place that they got it before.[22]

§ 131. One who acquires manufactory may acquire right to use trade-mark.

Where a trade-mark has been used to indicate the origin of a commercial article at a particular manufactory or place of production, it has been held that a person who acquires such manufactory or place of production may use such trade-mark, even though he has not acquired the business formerly carried on there, and even against the will of the original proprietor, and although the business formerly carried on at such manufactory or place of production is then carried on elsewhere.[23] Thus, in Motley v. Downman, it appeared that the Morgans had for many years manufactured tin plates at Carmarthen, and used "M. C.," meaning Morgan, Carmarthen, as a trade-mark, and dissolved about 1820. One of the plaintiffs, a partner in the old firm, formed a new firm, bought the stock and goodwill, took a lease of the works, to expire in 1827, and manufactured the plates with the same

[22] Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Robertson v. Berry (1879) 50 Md. 591; Pratt's Appeal (1888) 117 Pa. 401.

[23] Carmichel v. Latimer (1877) 11 R. I. 395.

mark. About 1825 they removed their business to Margam, about forty-four miles from Carmarthen, and, with several changes as to partners, continued their business and the use of the trade-mark. From 1825 to 1836 the old works were closed. In 1836 the defendants hired the old works, began business as the "M. C. Tin Plate Co.," and manufactured the tin plates with the "M. C." mark, with the word "Carmarthen," in large characters, under the letters "M. C." A bill was brought for injunction. Shadwell, V. C., granted one, and, on appeal, Cottenham, L. C., dissolved it. He said the real question was whether the former occupants of the works had acquired a right to prevent subsequent tenants from using a mark which it was clear was originally derived from those works. The injunction was dissolved, with liberty to sue at law.[24]

[24] (1837) 3 Mylne & C. 1.

In Prince's Metallic Paint Co. v. Prince Mfg. Co. (1893) 57 Fed. 938, 943, Acheson, Cir. J.: "But we strongly incline to the opinion that, in 1878-1879, the trade-mark 'Prince's Metallic Paint' had become so localized—so identified with the Prince mine and the place of manufacture—that it was inseparable therefrom. There is sanction for this conclusion in the adjudged cases. Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291, 302; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 226; Pepper v. Labrot, 8 Fed. 29; Kidd v. Johnson, 100 U. S. 617; Atlantic Milling Co. v. Robinson, 20 Fed. 217. It was the judgment of the general term of the supreme court of New York, in view of everything, that the trade-mark passed as an incident of the property to the Prince Manufacturing Company, with the possession of the works."

In Symonds v. Jones (1890) 82 Me. 302, 312, Emery, J.: "What is known as the 'goodwill' of the business is recognized by the law as a proper subject of sale or contract, in connection with a transfer of a business plant. An established business, with plants and products well known to the trade, has a money value often far above that of its mere plant, and this is often the controlling motive for the purchase. Labels, trade-marks, particular words and phrases devised or used to distinguish or identify the products of the plant, and associated with such products in the public mind, are in like

§ 132. Proprietor may use name of mill.

If a manufacturer has the right to label the products of his mill with his name, he has an equal right to label them with the name of the mill itself, provided the name is not unfairly assumed for the purpose, or fraudulently employed.[25] In Delaware & H. Canal Co. v. Clark, the supreme court of the United States said: "Equity will not enjoin against telling the truth."[26]

§ 133. No exclusive right to trade-mark acquired by mortgage of lands and mill.

Where a corporation acquired, through foreclosure of a mortgage, lands containing mines from which ore had been obtained, and a mill which had been used for making paint from such ore, and which paint had been sold under a certain trade-mark, the purchasing corporation acquired nothing but the property sold, and no exclusive right to use the trade-mark. The original corporation still retained its corporate existence, its capacity to do business, its goodwill, and the right to use its trade-mark upon paints, should it acquire other mines, erect a new mill, and resume manufacturing business.[27]

manner usually transferred with the plant, and are regarded as valuable acquisitions for the purchasers. They are, equally with the goodwill, proper subjects of such sale and contract."

[25] Newman v. Alvord (1867) 49 Barb. (N. Y.) 588; Glendon Iron Co. v. Uhler (1874) 75 Pa. 467; Brooklyn White Lead Co. v. Masury (1857) 25 Barb. (N. Y.) 416; Candee v. Deere (1870) 54 Ill. 439.

[26] (1871) 13 Wall. 311.

[27] Prince Mfg. Co. v. Prince's Metallic Paint Co. (1890) 20 N. Y. Supp. 462. This decision, which was rendered at special term, was reversed by the general term (15 N. Y. Supp. 249), and the decision of the general term was reversed by the court of appeals (135 N. Y. 32). In doing so, the court said: "The judgment dismissing the complaint rendered at special term was placed by the learned judge upon the failure of the plaintiff to establish any exclusive right to

§ 134. Personal name not transferable.

When the whole pecuniary value of a name in connection with an article of merchandise or a manufacture or a business is derived solely from the personal qualities of the one to whom the name belongs, such as his skill, special knowledge, and experience, or from the fact that the article is produced under his personal supervision, which imparts to it a special value, the right to the name is purely personal, and is not transferable.[28]

the use of the trade-mark or label on its goods. The order of the general term reversing the judgment of the special term proceeded upon the contrary view of the question of title, and the court held that the evidence established the title claimed by the plaintiff. We feel compelled to concur in the judgment of the special term dismissing the complaint, on the ground that, assuming that the plaintiff had the exclusive right to use the label 'Prince's Metallic Paint,' it has, by its own conduct in the misuse of the trade-mark or label, forfeited any right to apply to the court for protection against its wrongful appropriation by others."

[28] Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; In re Swezey (1881) 62 How. Pr. (N. Y.) 215; Cutter v. Gudebrod Bros. Co. (1899) 44 App. Div. (N. Y.) 605.

In Mayer v. Flanagan (1896) 12 Tex. Civ. App. 405, 407, 34 S. W. 785, 786, Garrett, C. J.: "The brand or trade-mark 'Magale's Monarch Whiskey' was personal to the firm of J. F. Magale, since it derived its value from the known skill, integrity, and honesty ot the firm of J. F. Magale in selecting good whiskey, and selling it without adulteration. By their use of the trade-mark, the plaintiffs in error deceived their customers with the representation that the whiskey upon which it was used was selected and sold by the firm of J. F. Magale, which was not the truth, and was not intended to be the truth by the contract of assignment. It would be against public policy to enforce such a contract. Again, since the defendant in error could not assign the trade-mark, the contract was without consideration, and could not be enforced on that account."

In Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1, 6, Daly, C. J.: "When, however, the whole pecuniary value of the name, in its connection with an article of merchandise, or a manufacture, or a business, is derived solely from the personal qualities of the one to

§ 135. Whether trade-mark assignable depends upon effect produced by use thereof.

Where the trade-mark consists of a name, the question whether it is assignable 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 be-

whom the name belongs, such as his skill, special knowledge, and experience, or from the fact that the article is produced under his personal supervision, which imparts to it an especial value, then the right to the name is not transmissible. It is then purely personal; and this is equally so with a trade-mark used and recognized, as denoting that the article or product is made by a particular person, whose skill, experience, or other personal quality, or whose personal experience in the fabricating, preparation, or production of it gives to it a peculiar value, which is distinguishable from a trade-mark used as a brand of quality, or of texture, fineness, or other characteristics, or to indicate that it is made in a particular establishment or manufactory, or where a name simply denotes an established business, with whatever advantages may accrue from its long establishment, the fact that it is generally or widely known, and the confidence it inspires from its duration. Hall v. Barrows, 10 Jur. 55, 4 De Gex. J. & S. 156-158; Berry v. Bedford, 33 Law J. Ch. 465; Carmichel v. Lattimer, 11 R. I. 395."

In re Swezey (1881) 62 How. Pr. (N. Y.) 215, 219, Van Hoesen, J.: "The question here is whether or not the trade-mark in question owes its value to the personal skill of Mr. Dart as a manufacturer. If it does, it does not pass by assignment, for the public must not be deceived into buying goods which, though bearing his trade-mark, are not the product of his peculiar skill. If, however, it is the machinery—the factory—which has produced superior goods, the trade-mark goes with the machinery. In other words, the trade-mark is inseparable from the particular thing which gives it value."

In Mattingly v. Stone (1889) 12 Ky. Law Rep. 72, 75, 12 S. W. 467, 469, Holt, J.: "It will be noticed that the words composing the brand, save the name of the appellee, are those of common use. and the right of using his name merely was a personal one to the appellee, and did not, therefore, pass to his assignee, any more than would the skill acquired by a merchant from experience in his business. Helmbold v. Helmbold Mfg. Co., 17 Am. Law Reg. (N. S.) 169."

lieve that the particular goods are in fact made by the person whose name is thus stamped upon them, or in whose name they are advertised, 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 public.[29]

§ 136. Trade-mark inseparable from thing which gives it value.

The question in all these cases is whether the trade-mark owes its value to the personal skill of the manufacturer. If it does, it does not pass by assignment, for the public must not be deceived into buying goods which, though bearing his trade-mark, are not the product of his peculiar skill. If, however, it is the machinery—the factory—which has produced superior goods, the trade-mark goes with the machinery. In other words, the trade-mark is inseparable from the particular thing which gives it value.[30]

§ 137. Name of man cannot be segregated from the man himself, and from his business.

The name of a man cannot be segregated from the man himself, and from the business in connection with which the man had used it, erected into an ideal and abstract species of property, be made a subject of traffic and sale in the market from man to man, to be used in any manner in which the purchaser may choose to use it. Where the assignee of the naked right to use a trade-name claimed the exclusive right to sell goods bearing that name, it was held that he must

[29] Skinner v. Oakes (1881) 10 Mo. App. 45; Samuel v. Berger (1856) 4 Abb. Pr. (N. Y.) 88; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523, 534, 544.

[30] In re Swezey (1881) 62 How. Pr. (N. Y.) 215; Mayer v. Flanagan (1896) 12 Tex. Civ. App. 405, 34 S. W. 785.

show that the name was originally used to designate goods of a certain quality or description, and was being used by him to designate substantially goods of the same quality or description, and that the use of the name did not operate to deceive the public into the belief that the goods were made by the man whose name they bore.[31]

§ 138. Trade-mark consisting of name of individual no guaranty that articles made by individual personally.

Where a trade-mark consisting of the name of an individual was used to denote articles made by a firm of which he had been a member, it was held that such name was not a guaranty that the goods were made by the individual personally, that the use thereof by an assignee was not a fraud on the public, and that the sale of the right thereto was valid.[32]

§ 139. Names held not personal.

In Hoxie v. Chaney it was held that the trade-marks, "A. N. Hoxie's Mineral Soap" and "A. N. Hoxie's Pumice Soap," were not personal to the party whose individual name they each contained, and therefore not assignable, but were assignable; and if the assignee used them to denote soaps made according to the formulas of A. N. Hoxie, and not to denote that they were made by said Hoxie, he could maintain a bill in equity to restrain an infringement of the trade-marks.[33] In a case in the United States circuit court for the district of Connecticut it was said: "The name [Dr. J. B. Blackman's Genuine Healing Balsam], as a whole, was his trade-mark, which he had the exclusive right to use, and the

[31] Skinner v. Oakes (1881) 10 Mo. App. 45.
[32] Oakes v. Tonsmierre (1883) 49 Fed. 447.
[33] (1887) 143 Mass. 592.

exclusive use of which would pass, by assignment, to any one who had lawfully obtained from the inventor the exclusive right, also, to manufacture and sell, and who did sell, that particular article compounded according to the original formula. * * * It is not, however, necessary that an article to which a trade-mark, personal in its inception, was originally affixed, should always be manufactured at the same place where it was originally made. This particular trade-mark, being the name of the inventor, was personal to Dr. Blackman, in its inception, but has been permitted by him to be applied and to be appropriated to the same article when manufactured by Filkins Bros. Under the circumstances in which the medicine has been manufactured and sold, the use of the trade-mark does not imply that the medicine was manufactured by Jonas Blackman, but that it is the same article which he originally invented and manufactured."[34]

§ 140. Personal trade-mark held assignable where original proprietors supervise manufacture.

In Meriden Britannia Co. v. Parker it appeared that three brothers, Rogers, had made plated spoons, etc., marked with their name, and, on giving up business, had agreed that the plaintiffs might use their names in manufacturing the same goods, the manufacture to be carried on under the supervision of the Rogers brothers. Three other persons of the name of Rogers, who had been making coffin trimmings, arranged with the defendants to make the same goods with their name, "Rogers," on them. The defendants objected that the marks used by the plaintiffs did not indicate the true origin of the goods. The court, while admitting the principle that it would not protect any mark which tended

[34] Filkins v. Blackman (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786; Bury v. Bedford (1864) 10 Jur. 503.

to deceive the public, held that the agreement on which the plaintiffs relied was good, on the ground of the supervision above referred to.[35]

§ 141. Question of assignability depends upon circumstances.

In Bury v. Bedford, a corporate trade-mark had been assigned. The question arose under the special acts governing the company, and also under the general law. Turner, L. J., in giving judgment, says: "But without going the length of saying that a mark may not, in some cases, be so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual, and that the assignability of such a mark may not be open to objection on that ground, although the objection would, as it seems to me, apply rather to the use of the mark when assigned than to the power of assigning it, I think that all cases of this description must depend upon their particular circumstances. Much must, I think, depend upon the nature of the mark, and the mode in which it has been used. It is evident that a mark, although it may in some respects indicate the person by whom the goods have been manufactured, may refer much more closely to the place of manufacture than to the person of the manufacturer; and it is not less evident that a mark, although personal in its inception, may, from the mode in which it has been used, have become appropriated to goods manufactured at particular works."[36]

§ 142. Purchasers of trade-marks should indicate change.

The purchasers of trade-marks should not use them without change, if they indicate that the article to which they

[35] (1872) 39 Conn. 450.
[36] (1864) 4 De Gex, J. & S. 352, 33 Law J. Ch. 465, 4 N. R. 180.

are applied is made by the original proprietor. In such a case, words must be added showing that the original proprietor has retired, and that the goods are made by his successor.[37]

§ 143. Trade-mark not assignable where its use would deceive public.

In the case of Partridge v. Menck, it appeared that one Golsh had acquired a reputation for making matches, and the complainant succeeded to his business, and continued to use his name. The vice-chancellor and the chancellor had refused an injunction, on the ground that the defendant's labels were sufficiently dissimilar from the plaintiff's, and that, on them, the defendant represented himself as "late chemist for A. Golsh." When it came before the court of appeals, the result was the same; but it was put, and by one of the judges chiefly, on the ground of the misrepresentation in the plaintiff's label. "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 these terms. * * * Verbal declarations to a purchaser of the same kind, with a view to a sale of this article, it was conceded, would have been fraudulent." "The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce."[38]

In Samuel v. Berger it appeared that the plaintiffs had purchased from Brindle the right to use his name on watches made by them. The defendant was selling watches actually made by Brindle. The court says: "The plaintiffs ask this

[37] Symonds v. Jones (1890) 82 Me. 302; Stachelberg v. Ponce (1888) 128 U. S. 686; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218. But see Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42.

[38] (1847) 2 Sandf. Ch. (N. Y.) 622, 2 Barb. Ch. (N. Y.) 101, 1 How. Ct. App. Cas. (N. Y.) 547; Cox, Man. Trade-Mark Cas. No. 91.

court to aid them in passing off on the public watches manufactured by them, and held out to the public as made by Brindle, when, in truth, the watches made by Brindle, and stamped by him with his name, are those which the defendants seek to sell." The injunction prayed for was refused.[39]

§ 144. Transfer of trade-mark apart from business confers no title on transferee.

The mere sale of a trade-mark apart from the article to which it is affixed confers no right of ownership, because no one can claim the right to sell his goods as goods manufactured by another. In Chadwick v. Covell, where a manufacturer of medicines according to secret formulas of his own, which he sold under various names and labels, died, and his administratrix transferred the formulas and trade-marks by way of gift to one who proceeded to make the medicines with her own plant and appliances, and to sell them under the same names and labels, and, subsequently, the administratrix *de bonis non* of the original manufacturer conveyed by deed the same formulas and trade-marks to another, who began to make and sell the medicines in the same way as the donee, it was held that the donee, even if the gift were valid, had no such exclusive right to make the medicines or to use the trade-marks as entitled him to prevent the grantee from making and using them.[40] And in Marshall v. Pinkham, where the plaintiff's father, having a recipe for a liniment not discovered or invented by himself, or protected by a patent, communicated the receipe to various members of his own family, and permitted each, for his own

[39] (1856) 24 Barb. (N. Y.) 163, 4 Abb. Pr. (N. Y.) 88.

[40] (1890) 151 Mass. 190. See, also, Weston v. Ketcham (1876) 51 How. Pr. (N. Y.) 455; Covell v. Chadwick (1891) 153 Mass. 263; Witthaus v. Mattfeldt (1875) 44 Md. 303.

benefit, to manufacture the article and sell it with a label furnished by the father, and bearing his name, but with the address of the particular member of the family manufacturing, and where, after the death of the father, the widow continued for some years to manufacture and sell the liniment under the same label, and then sold the material and paraphernalia of her business to plaintiff, it was held that plaintiff acquired no exclusive right to manufacture the liniment, or to use the label or the name.[41]

§ 145. Leading English case of Leather Cloth Co. v. American Leather Cloth Co.

In the case of Leather Cloth Co. v. American Leather Cloth Co.,[42] an English company had purchased the business of an American company, and applied for an injunction against persons using certain marks, representing their goods as being the article known as "Crockett's Leather Cloth," etc. Wood, V. C., had granted an injunction, and, on appeal, Westbury, L. C., reversed his decision, and this reversal was confirmed by the house of lords. Some of the remarks of the lord chancellor and of the lords illustrate the rules relating to the transfer of trade-marks. In his decision, the lord chancellor said: "But 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 name has gained currency and credit in the market (there being no secret process nor invention), could such person or firm, on ceasing to carry on business, sell and assign the right to use such name and mark to another firm, carrying on the

[41] (1881) 52 Wis. 572.

[42] (1863) 4 De Gex, J. & S. 137, 11 Wkly. Rep. 931, 1 Hem. & M. 271, (1865) 11 H. L. Cas. 523.

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. Makers, 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 an exclusive right to use the name and mark of A., B. & Co.? I am of opinion that no such protection ought to be given. 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; but where any symbol or label, claimed as a trade-mark, is so constructed or worded as to make or contain a distinct assertion which is false, I think no property can be claimed in it, or, in other words, the right to the exclusive use of it cannot be maintained. To sell an article stamped with a false statement is *pro tanto* an imposition on the public, and therefore, in the case supposed, the plaintiff and defendant would be both *in pari delicto.* This is consistent with many decided cases." And again, the complainant "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade-mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade-mark gives a false description of the article, he is violating the rule on which he seeks relief against the defendant."

Lord Cranworth said: "But I further think 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. Difficulties, however, may arise where the trade-mark consists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade-mark, and they would be protected against any infringement of the exclusive right to that mark. They would be so protected, because, according to the usages of trade, they would be understood as meaning no more by the use of their grandfather's or father's name than that they were carrying on the manufacture formerly carried on by him. Nor would the case be necessarily different if, instead of passing into other hands by devolution of law, the manufactory were sold and assigned to a purchaser. The question in every such case must be whether the purchaser, in continuing the use of the original trade-mark, would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade-mark. In such a case I see nothing to make it improper for the purchaser to use the old trade-marks, as the mark would, in such a case, indicate only that the goods so marked were made at the manufactory which he had purchased."[43]

Lord Kingsdown said: "Though a man may assign his business, and the use of his firm and of his trade-mark as belonging to it, that proceeds, in my opinion, upon the ground which I have stated,—that the use of the name of the firm is not understood in trade to signify that certain individuals, and no others, are engaged in the concern. Though a man may have a property in a trade-mark, in the sense of having a

[43] Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 534.

right to exclude any other trader from the use of it in selling the same description of goods, it does not follow that he can, in all cases, give another person a right to use it, or to use his name. 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 any other persons the right to affix his name or mark to their goods, because he cannot give to them the right to practice a fraud upon the public."[44]

§ 146. Sale of woodcuts does not transfer trade-mark.

The sale or transfer of the woodcuts of a trade-mark does not carry with it property in the trade-mark itself, unless under circumstances indicating that such was the intention, and this will not be inferred where they were transferred, to be used in printing labels to be placed upon an article which, by agreement, was to be manufactured under the supervision of the proprietor of the trade-mark.[45]

§ 147. Assignment of invalid registered mark insufficient to support injunction.

No title sufficient to support an injunction is conferred by the assignment of a registered trade-mark, where the registry has been declared void as based on unconstitutional legislation.[46]

§ 148. Assignment in bankruptcy carries trade-mark.

A trade-mark, and the name by which a business has become known, involving what is understood by the goodwill,

[44] Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 544.

[45] Lockwood v. Bostwick (1869) 2 Daly (N. Y.) 521.

[46] White v. Schlect (1888) 14 Phila. (Pa.) 88.

will pass under a voluntary assignment, transferring the insolvent's property of every nature and kind for the payment of his debts, unless the value of the name has arisen from, and depends solely upon, the personal qualities or personal supervision of the one to whom it belongs. Or it may be sold by order of the court, whether it be attached to a new business or one long existing.[47]

[47] Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226; Pepper v. Labrot (1881) 8 Fed. 29; Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 93 Fed. 624; Mattingly v. Stone (1889) 12 Ky. Law Rep. 72, 12 S. W. 467, (1890) 14 S. W. 47.

In Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 93 Fed. 624, 626, Pardee, Cir. J.: "The law of Louisiana requires a cession of all the property of the insolvent debtor, and, upon acceptance of the cession by the court, vests such property immediately in the creditors. Rev. St. La. § 1791. It seems to be now settled beyond dispute that both in the state and federal courts a cession does include all the property of the debtor, whether the same is mentioned in the schedule of his property, or whether the debtor intended to surrender it, or not. The cession offered and accepted by the court vests the property of the debtor in the creditors, in any and every event. Muse v. Yarborough, 11 La. 521; Dwight v. Simon, 4 La. Ann. 490; Bank of Tennessee v. Horn, 17 How. (U. S.) 157; Geilinger v. Philippi, 133 U. S. 246, 10 Sup. Ct. 266."

In Pepper v. Labrot (1881) 8 Fed. 29, 39, 45, Matthews, Cir. J.: "The complainant having, upon his own petition, been declared a bankrupt, filed the required schedule of his assets and liabilities, in which he described the tract of land inherited from his brother as including the 'Old Oscar Pepper Distillery,' and as such it was known at the time the title became vested in the defendants. The clear result of the whole evidence seems, in our opinion, to be that the complainant adopted the name of 'Old Oscar Pepper Distillery' as the name of his distillery, in order that the whiskey manufactured by him there might have the reputation and whatever other advantages were to result from that association. That distillery having now become the property of the defendants by purchase from the complainants [through sale by the assignee in bankruptcy, and by mesne conveyances], can they (defendants) be denied the right of using

§ 149. Assignment to trustee of all assets carries trade-mark.

Where an insolvent corporation assigned and conveyed to a trustee "all its estate and property of whatever kind and wherever situated," in trust for the benefit of its creditors, with power to sell either at public or private sale, it was held that the deed of assignment, by legal operation, passed the goodwill of the business, with the brand or trade-mark thereof, with the right and power in the trustee to sell the same with the manufacturing establishment, and that purchasers from the trustee, upon the ratification of the sale, would acquire the exclusive right to such goodwill and trade-mark of the business, as fully and in like manner as the same were used by the manufacturing company before the assignment.[48]

§ 150. Instance of general assignment not passing trade-mark.

But it has been held that a general assignment in insolvency is inoperative, in respect to passing a right to a trade-mark, if the right was not inventoried by the trustee or ap-

the name by which it was previously known in the prosecution of the business of operating it, and of describing the whiskey made by them as its product? Can the complainant be permitted to use the brand or mark formerly employed by him to represent whiskey made by him elsewhere as the actual product of this distillery? Both these questions, in our opinion, must be answered in the negative. * * * The words 'Old Oscar Pepper Distillery' never lost their primary signification, and never acquired any secondary meaning, and, as applied to whiskey made by the complainant, the words 'Old Oscar Pepper,' and their abbreviation, 'O. O. P.,' never came to mean more than whiskey that had been made at that particular distillery. They did not become a denomination of whiskey as the manufacture of the complainant or of any person, but characterized it only as entitled to public favor by reason of the reputation of the particular distillery at which it purported to have been made. For these reasons, we are of opinion that the equity of the case, both upon the original and cross bills, is with the defendants."

[48] Wilmer v. Thomas (1891) 74 Md. 485.

praisers, and never claimed by the trustee or creditors of the insolvent, nor in any manner disposed of under the assignment.[49]

§ 151. No distinction between sale by proprietor and sale by assignee.

There is no distinction between the sale by a man of his business goodwill and trade-mark and the sale of them by the assignee in bankruptcy of all the bankrupt's assets of every

[49] Bradley v. Norton (1865) 33 Conn. 157. See, also, Bellows v. Bellows (1898) 24 Misc. Rep. (N. Y.) 482; In re Adams (1898) 24 Misc. Rep. (N. Y.) 293.

In Re Adams (1898) 24 Misc. Rep. (N. Y.) 293, 295, Russell, J.: "The supposed trade-mark is substantially the name of the assignor Robert Adams, who did business under the name of R. & H. Adams. If his name is of value as a trade-mark, it was made so by the skill and energy with which he associated that name in his conduct of the business prior to the assignment. If it shall now forever be transferred to a stranger to be used, by an involuntary transfer so far as Robert Adams is concerned, and alone by force of an assignment of the name by the general assignee whose duty ends with the conversion of the property of the assignor into money for the payment of debts, then we have the case of a stranger using a name not associated with his own business solely by force of the assignment, while the assignor himself is debarred forever from using his own name in his future efforts to retrieve his fortunes by intelligence and energy in any way that would lead the public to believe that the same person was manufacturing and vending goods who formerly manufactured the same line under the name 'R. & H. Adams.' No authority has yet been cited by counsel to justify such result."

In Bellows v. Bellows (1898) 24 Misc. Rep. (N. Y.) 482, 484, Stover, J.: "But, without discussing these inconclusive and hazy rights, the main, if not the sole, contention of the plaintiff, that he acquired by assignment a right to use the name, is utterly without foundation. While it is true that a person may, by proper assignment, convey the right to use his name in any business, yet such assignment must be an unequivocal and direct conveyance of such right, and such right would not pass under the ordinary phraseology of a general assignment for the benefit of creditors."

kind, and the insolvent has no right afterwards to use the trade-marks which were the marks of that business, or to use the name or title of the firm as representing himself as continuing the business, all the rights of which passed to his assignee and to the purchaser under the judgment. He has no right to represent himself as continuing the identical business that was sold by his assignee to another, which does not, however, debar him from going into the same business again, and indicating the fact of his having been in the former one, or from alleging anything respecting the new business, unless it be done with a design to impair the right of the purchaser of the former business, or to mislead the public.[50]

§ 152. Right to use name and knowledge cannot be taken by judicial proceeding.

Although a person can, by voluntary sale and assignment, transfer the right to use his own knowledge and name, the right to use his own knowledge and name cannot be taken from him, through the order of a bankrupt court, or any other judicial proceeding whatever.[51]

§ 153. Administrator of assignee has no title to trade-mark.

The administrator of the deceased general assignee of a firm takes no title to the firm assets, and hence a former partner of the firm, who claims title to one of the trade-marks under a transfer made by the administrator without authority by the court, cannot maintain an action to restrain its use by his partner in a new firm, formed after the old firm had made a general assignment.[52]

[50] Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; Rorke v. Societe des Huiles D'Olive de Nice (1897) 14 App. Div. (N. Y.) 173.

[51] Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453.

[52] Hayne v. Sealy (1898) 22 Misc. Rep. (N. Y.) 243.

§ 154. Trade-mark cannot be levied upon by execution.

A trade-mark cannot be levied upon and sold under execution as a species of tangible property, unless under the authority of a local statute authorizing such a sale. A statute is not to be construed as authorizing any one to purchase a trade-mark and affix it to his own product, where such construction would permit of a fraud or deception being perpetrated upon the public.[53]

[53] Prince Mfg. Co. v. Prince's Metallic Paint Co. (1890) 20 N. Y. Supp. 462.

CHAPTER VII.

JOINT OWNERSHIP OF TRADE-MARKS.

§ 155. In General.
156. Arising by Agreement.
157. Arising by Transfer.
158. Arising by Succession to Business.
159. Arising by Dissolution of Partnership.

§ 155. In general.

While it has been said by Mr. Justice Clifford that "trade-marks are an entirety, and are incapable of exclusive use at different places by more than one independent proprietor,"[1] this does not preclude the joint ownership of a trade-mark under certain circumstances, and there are several different ways in which such joint ownership may arise. Where several different individuals, firms, or corporations jointly own a trade-mark, the co-owners are together entitled to the exclusive use thereof, and it has been said that perhaps each may be entitled to such exclusive use as to all other persons except his associates in ownership.[2]

§ 156. Arising by agreement.

It has been held by the court of appeals of Kentucky[3] that, where the mineral water from two springs located at some

[1] Manhattan Medicine Co. v. Wood, 4 Cliff. 461, Fed. Cas. No. 9,026, Cox, Manual Trade-Mark Cas. 359.

[2] New York & Rosendale Cement Co. v. Coplay Cement Co. (1891) 45 Fed. 212. See, also, Newman v. Alvord (1872) 51 N. Y. 189.

[3] Northcutt v. Turney (1897) 101 Ky. 314. See, Cleveland Stone Co. v. Wallace (1892) 52 Fed. 421.

distance apart, and belonging to distinct firms, seems to be composed of the same ingredients, and to have the same kind and combination of medicinal qualities, and the same trade-mark has been properly and legally adopted by each of the respective owners without objection by the other, they have a common interest in preventing a third person from illegally appropriating and using the trade-mark, and have a right to jointly maintain an action for that purpose. Where a trade-mark is thus adopted or continued by agreement between two or more manufacturers or vendors, they may be considered, not as "independent" proprietors, in the sense in which that term was used by Justice Clifford, but rather as dependent proprietors, each using the mark by agreement with the other. In this way there can be a joint adoption of a trade-mark by distinct manufacturers or vendors, and it would seem, upon principle, that it is only by some such agreement that there can be a joint adoption of a trade-mark. Even then it would seem necessary, in order that the trade-mark may perform its office of pointing distinctly to the manufacturer or vendor of the article, that each proprietor should so use the mark as to distinguish his goods from those of the other proprietor. This might be done by each proprietor using, with the mark, his own name and address.

This view is well illustrated in two decisions by the United States circuit court of appeals for the seventh circuit. In these cases it appeared that the complainant and defendant's predecessors, James H. and Charles G. Smith, had entered into a contract specifying the manner in which each should use the word "Hygeia" as a trade-mark for mineral water. The agreement recited that the complainant was engaged in the manufacture or preparation of distilled water, for which it had used, as the essential feature of its trade-mark, the word "Hygeia," and a figure of the goddess Hygeia; that the

Smiths owned a spring at Waukesha, called the "Hygeia Natural Mineral Spring," and had used as an essential feature of their trade-mark, in the sale of the waters, the words "Waukesha Hygeia Mineral Springs," together with another figure of the goddess Hygeia. The contract stated that it was made "to avoid conflict and infringement in the use of both of their respective trade-marks." The contract provided in substance that the first party, the complainant, should use the word "Hygeia" and its figure of the goddess in connection only with carbonated and artificial mineral water, etc.; that the second party should use the word "Hygeia" only in the combination "Waukesha Hygeia Mineral Springs," etc. The court held that this was not an attempt to transfer or license the use of the trade-mark, or any rights therein, or in any word thereof, but that the contract fixed and defined the existing trade-mark of each party, that confusion and infringement might be prevented; that the contract did not create the trade-mark, but that it was clear evidence of its purpose and elements. Where the defendant, after acquiring the spring owned by the second parties to the contract, succeeded to their business, ignored the contract, and used the word "Hygeia" alone for the Waukesha water, an injunction was granted by the circuit court, and the decree was affirmed by the court of appeals,[4] but it was held that the defendant could not be enjoined from making the word "Hygeia" more conspicuous than the rest of the trade-mark.[5]

§ 157. Arising by transfer.

A business in which trade-marks are used may be trans-

[4] Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co. (1894) 11 C. C. A. 277, 63 Fed. 438.

[5] Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co. (1894) 11 C. C. A. 282, 63 Fed. 443.

ferred so as to give the transferee a right to use the trade-mark in common with the transferrer, or so as to vest the right to use the trade-mark in two or more transferees. In Fish Bros. Wagon Co. v. La Belle Wagon Works,[6] it appeared that the business of a firm of wagon manufacturers, named Fish Bros., located at Racine, Wis., together with all the property and assets of the firm, passed to Fish Bros & Co., agents, thence into the hands of a receiver, and thence to a corporation under the name of Fish Bros. Wagon Co. Through the successive changes, the Fish brothers remained in the business and became officers of the corporation, although the majority of the stock was owned by others. During all this time the wagons were marked "Fish Bros.," "Fish Bros. & Co., Agents," or "Fish Wagons," or with the picture of a fish, on which were the words "Bros.," "Bros. & Co.," or "Wagon," and were advertised under those names and with said picture. Several years after the organization of the corporation, the Fish brothers withdrew therefrom, and formed a partnership to manufacture and deal in wagons in another place, under the name of Fish Bros. & Co. An ac-

[6] (1892) 82 Wis. 546. It is believed that this case is not entirely free from doubt, and there seems to be a good deal of force in the dissenting opinion, delivered by Judge Winslow, which reads as follows: "I agree that the words, 'Fish Bros. Wagon,' and the rebus of the fish, were trade names or labels appertaining to the business transacted at the Racine factory, and that the right to use such names or labels upon wagons was acquired by the plaintiff by its purchase of that business. Such a right is, in its very nature, exclusive, and, if the plaintiffs own it, the defendants manifestly do not own it. In my judgment, the defendants have no right to mark their wagons with either the words or the rebus. Probably they have the right to use the firm name 'Fish Bros. & Co.,' if they do not use it in such a way as to mislead the public, but this will not give them the right to use a trade name or label on their wagons which is the distinctive mark of the product of the Racine factory, and the right to use which has passed from the defendants, T. G. and E. B. Fish, to that concern."

tion was brought against them by the corporation, and it was held that, while the corporation had acquired the goodwill of the original business, and the right to use the said names and picture as a trade-mark, although the same were not specifically mentioned in any of the transfers of the business of the corporation, there having been no agreement giving the corporation the exclusive right to such names and picture as trade-marks, the new firm also had the right to use the same in advertising and upon their wagons, provided they did not use them in a way calculated to induce persons to buy their wagons as and for those manufactured by the corporation. In the later case of Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., it was held by the United States circuit court for the northern district of Iowa that neither party could be restrained from using such trade-mark or trade-name at the suit of the other, although it was not open to either to give out or claim that it manufactured the only genuine article of that name. Undoubtedly, in the Fish Bros. Case in the Wisconsin supreme court, the turning point in the decision is to be found in the personal character of the trade-marks involved. The court quoted from Brown Chemical Co. v. Meyer, 139 U. S. 540, the statement that "the owner of a trade-mark bearing his own name, which is affixed to articles manufactured at a particular establishment, may, in selling the latter, confer upon the purchaser exclusive authority to use the trade-mark," and held that, as in the case at bar there was no agreement giving such exclusive right to the plaintiff, the defendants were at liberty to apply the trade-marks to the wagons and other vehicles manufactured by them, provided they did it in a way not calculated to induce persons to buy the same as and for those manufactured by the plaintiff.[7]

[7] Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co. (1898) 87 Fed. 293.

In the case of McAllister v. Stumpp & Walter Co.[8] it was held by the New York supreme court, where the owner of a right to manufacture certain proprietary articles sold his right to the plaintiff's assignor, and afterwards transferred the same rights to a corporation, which subsequently became insolvent, and the receiver sold the same rights to the defendant, and plaintiff's assignor gave notice of his ownership to the receiver only, attended the sale, made there no claim of title, and subsequently sold his right to the plaintiff, that the knowledge of the original owner as to his own sale to plaintiff's assignor could not be imputed to the corporation; that, by the original owner's transfer, a right to manufacture the articles passed to the corporation, and by the receiver's sale to the defendant; that the plaintiff had also acquired a right to manufacture the articles; that neither party had a sole right to such manufacture; that both parties were entitled to vend the goods under the same general designations, and that an injunction should issue upon this ground to restrain the defendant from styling itself the 'Sole Proprietor" of the articles, whether or not the rights were properly to be viewed as rights of trade-mark. Such acts of defendant would amount to an unfair method of trade competition as against the plaintiff.

§ 158. Arising by succession to business.

Where a manufacturer, the owner of a trade-mark, dies intestate, and his business and trade-mark are not disposed of by himself by will or otherwise, nor by his administrator, his heirs at law, who are separate successors in his business, have equal rights to use such trade-mark, if in so doing they make no false representations.[9]

[8] (1898) 25 Misc. Rep. (N. Y.) 439.
[9] Emerson v. Badger (1869) 101 Mass. 82.

In the case of Pratt's Appeal,[10] which was an action to restrain the defendant from using plaintiff's trade-mark, it appeared that the plaintiffs were farmers, and engaged in the dairy business; that they made what was known in many portions of the country as the "Darlington Butter," which was an article of such superior quality as to command a ready sale and a high price; that the plaintiffs and their immediate ancestors had been engaged in making this butter for a period of about three-quarters of a century; that during all this period the butter had been stamped with a peculiar print, claimed as a trade-mark, the distinguishing features of which were a cornucopia and the name "Darlington"; that this trade-mark had been originally adopted by the grandfather, and, after his death, by the father of plaintiffs; that, after the death of the father, his sons, the plaintiffs, without evidence of administration and distribution of the father's estate, continued the same manufacture and the use of the same trade-mark. Subsequently they separated, and each engaged independently upon the same manufacture, by agreement severally using the same trade-mark, but specialized by their proper names printed thereunder. The court held that the plaintiffs had the exclusive right to such use as against a stranger who had never acquired the right to use it in any way. In the opinion of the court it is said: "It was urged, however, that, conceding this symbol to have been a valid trade-mark in the hands of Jesse Darlington, or even of Jared, that, upon the death of the latter, it ceased to be the property of any one, and that its use by several members of the family of the latter destroyed its distinctive features, and left it open to the public to appropriate it. We cannot assent to this proposition. * * * When Jared Darlington died, his children appropriated this device or symbol to

[10] (1888) 117 Pa. 401.

their own use. They did so before any one else appropriated or attempted to appropriate it. By an amicable arrangement between themselves, each one was allowed to use the cornucopia as a device, each pound of butter being stamped, in addition, with the name of its manufacturer. It was all Darlington butter. There was no fraud upon the public nor any one else in this. It was not sold as the butter of either Jesse or Jared Darlington. They were both deceased, and it is fair to presume their customers knew it. The business was continued by their descendants, bearing the name of Darlington, in the same place and with the same skill. There is no pretense that the butter now made by the present members of the family is not equal in every respect to the best made by their ancestors. Under such circumstances, their trade-mark cannot be interfered with by a stranger, who has never acquired a right in any way to use it."

In the Leather Cloth Case[11] it was said by Lord Cranworth: "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. Difficulties, however, may arise where the trade-mark consists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trade-mark, and they would be protected against any infringement of the exclusive right to that mark. They would be so protected because, according to the usages of trade, they would be understood as meaning no more by the use of their grandfather's or

[11] Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523.

father's name than that they were carrying on the manufacture formerly carried on by him."

It has also been held by the supreme court of the United States[12] that, when a trade-mark is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it. Under this rule, when such an establishment is transferred by operation of law to several persons, with equal interests to each, it would seem that each would have an equal right to the use of the trade-mark connected with the business, provided each could use it without misrepresentation. As said in the Pratt Case: "While the cases are not uniform upon the subject, there is ample and recent authority for saying that not only a business and its accompanying trade-mark may pass from a parent to his children without administration, but that the business may be divided among the children, and each will have the right to the trade-mark, to the exclusion of all the world except his co-heirs."

§ 159. Arising by dissolution of partnership.

Upon the dissolution of a partnership which has acquired proprietorship in the trade-mark, if it is not sold with the other firm assets, it remains the property of the individual members, and either partner may continue to use such trade-mark unless he has conferred upon the other an exclusive right to do so. This proposition is established by numerous decisions.[13]

[12] Kidd v. Johnson (1879) 100 U. S. 617.

[13] Hazard v. Caswell (1883) 93 N. Y. 259; Caswell v. Hazard (1890) 121 N. Y. 487; Baldwin v. Von Micheroux (1893) 5 Misc. Rep. (N. Y.) 386; Snyder Mfg. Co. v. Snyder (1896) 54 Ohio St. 56; Smith v. Walker (1885) 57 Mich. 456; Taylor v. Bothin (1879) 5 Sawy. 584, Fed. Cas. No. 13,780; Young v. Jones (1879) 3 Hughes, 274, Fed. Cas. No. 18,159.

CHAPTER VIII.

TRADE OR COMMERCIAL NAMES.

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§ 160. Definition.

A trade or commercial name is a name under which a business is carried on, or by which it is designated, or the name

of the place at which a business is located. In the former instance it may be the name or names of one or more individuals, or the name of a firm, an association, or a corporation. A trade-name should be considered and treated the same as a trade-mark. If the name is arbitrary or fanciful, the adopter and user may acquire an exclusive right thereto, and may prohibit others from using it, even though such use is innocent or accidental, and no element of fraud is present. A great many terms used as trade-names, however, are of such character that they cannot be exclusively appropriated, and, in seeking to protect such names, reliance must be placed on the doctrine of unfair competition. There is a great deal of confusion in the decided cases upon this branch of the subject, for the reason that courts have not always distinguished between cases involving trade-names that can be exclusively appropriated and those in which relief, if granted at all, must be granted on the grounds of unfair competition In other cases where injunctions have been refused it is probable that, if the cases had been presented as cases of unfair competition, relief would have been afforded. A trade or commercial name differs from a trade-mark in that it is not affixed or applied to a commercial article. In a strict sense, the term "trade-mark," as heretofore pointed out, is applicable only to a mark or device that is affixed or applied to a commercial article to indicate origin or ownership. A trade-name is not so applied, but the courts protect it on grounds analogous to those on which trade-marks are protected. Where the trade-name is one that is capable of exclusive appropriation, an injunction will be granted against an innocent or accidental use thereof by others; but where the name is merely a descriptive or geographical term, or one which others have an equal right to use, an injunction will be granted only for the purpose of preventing unfair competi-

tion in business. In many instances where a trade-mark consists of a word or symbol, the goods upon which it is used are spoken of in the trade by such name, or by a word representing the symbol used as the trade-mark. An illustration of this is found in the term "Rogers' Goods," the word "Rogers" being stamped upon the articles as a trade-mark. Another illustration may be found in the term "Anchor Brand," the representation of an anchor being the trade-mark. In some instances the courts have used the term "trade-name" for the purpose of designating these spoken trade-marks, and in other instances have used the terms "trade-name" and "trade-mark" as synonymous. In most cases, however, the term "trade-name" has been properly restricted to the names of business organizations, or places of business, and the term "trade-mark" to names or symbols that are affixed or applied to commercial articles.[1]

The name of a business organization, or of a place of business, may be at the same time both a trade-name and a trade-mark. It may be the name of the business organization, or may designate the place of business. This makes it a trade-name. It may be affixed or applied to the commercial articles produced by such business organization, or at such place of business, and it may then become a technical trade-mark. An instance of this is found in the term "The Saratoga," which had been used as the name of a saloon, and was also used as a trade-mark on the liquors, cigars, etc., sold therein. The court said: "It clearly appears from the proof, and the chancellor so found, that the appellees purchased of Knaer

[1] Koehler v. Sanders (1890) 122 N. Y. 65; Hoyt v. Hoyt (1891) 327; Bingham School v. Gray (1898) 122 N. C. 708. 527; Cady v. Schultz (1895) 19 R. I. 193; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (1900) 42 C. C. A. 376, 102 Fed. 143 Pa. 623; William Rogers Mfg. Co. v. Simpson (1887) 54 Conn.

the sole and exclusive right to the use of the word 'Saratoga' as a business name, title, trade-mark, and brand for goods sold under the name. The business was extensively advertised by labels on the bottles of the firm, and by circulars; and while this name did not indicate the make of the goods, it came to indicate with the trade a superior selection of fine goods by D. Mathey & Co.; proprietors. The value of the name as a trade-name and trade-mark—for it was both—is shown by satisfactory proof."[2]

[2] Dewitt v. Mathey (1896) 18 Ky. Law Rep. 257, 35 S. W. 1113.

In Hoyt v. Hoyt (1891) 143 Pa. 623, it is said: "A trade-name may, in a general way, be treated as a trade-mark, and protected in the same manner. When a business has been conducted by some person or firm under a particular trade-name until the public come to regard the name as affording an assurance of the good quality of the article bearing it, the name is a valuable part of the business assets of the person or firm whose skill and integrity have won confidence for it. A rival who should appropriate the trade-name to his own use without the consent of the owners, and put his goods on the market bearing it, as though they were made by the rightful owner of the trade-name, is guilty of a fraud on the public, and a fraudulent taking from the proprietors, which is, both in intent and effect, a larceny; but when such rival puts his goods on the market on their own merits, and under his trade-name, his neighbors have no just grounds of complaint, if he has imitated, adopted, or improved upon their unpatented methods and processes." See Putnam Nail Co. v. Dulaney (1891) 140 Pa. 205.

In N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (1900) 42 C. C. A. 376, 102 Fed. 327, the United States circuit court of appeals for the ninth circuit says: "The trade-name differs from the trade-mark in this: that one appeals to the ear more than to the eye."

In Cady v. Schultz (1895) 19 R. I. 195, it is said: "A trade-name is of a different character [from a trade-mark]. It is descriptive of the manufacturer or dealer himself as much as his own name is, and frequently, like the names of business corporations, includes the name of the place where the business is located. If attached to goods, it is designed to say plainly what a trade-mark only indicates by association and use. The employment of such a name is

In an action for infringement of a trade-name, where the palpable identity of the names is likely to lead to confusion and result in damage, the plaintiff need not show that any pecuniary damages have resulted. The injury necessary to sustain the action is implied in the act of the defendant in wrongfully appropriating the name of the plaintiff, nor is the motive of the defendant in assuming the name in such case material.[3]

subject to the same rules which apply to the use of one's own name of birth or baptism. Two persons may bear the same name, and each may use it in his business, but not so as to deceive the public, and induce customers to mistake one for the other. The use of one's own name is unlawful if exercised fraudulently to attract custom from another bearer of it. Trade-marks, properly so-called, may be violated by accident or ignorance. The law protects them, nevertheless, as property. Names which are not trade-marks, strictly speaking, may be protected likewise if they are taken with fraudulent intention, and if they are so used as to be likely to effect such intention."

In Bingham School v. Gray (1898) 122 N. C. 699, the supreme court of North Carolina said: "As a rule, a trade-mark cannot be taken in a surname, and any one named 'Bingham' could start a school called the 'Bingham School,' in the absence of proof of intent to injure or fraudulently attract the benefit of the good name and reputation acquired by a previously existing 'Bingham School,' * * * and certainly there could be no confusion between a Bingham School at Asheville and a school, even of the identically same name, at Mebane, N. C."

In Weinstock, Luben & Co. v. Marks (1895) 109 Cal. 529, it was said: "Although there can be no property right in a trade-name which is not the subject of a trade-mark, yet it is a fraud on a person who has established a trade and carried it on under a given name, that some other person should assume the same name, or the same name with a slight alteration, in such a way as to induce persons to deal with him in the belief that they are dealing with the one who has given a reputation to the name, and an injunction will issue to prevent such fraudulent infringement of the trade-name."

[3] Roy Watch Case Co. v. Camm-Roy Watch Case Co. (1899) 28 Misc. Rep. (N. Y.) 45. In this case, a corporation had for four-

§ 161. Individual names.

The simplest form of a trade-name is the name of an individual used as the designation of a business. It is not necessary that a person's trade-name and his name of birth or baptism should be the same.[4] A person may assume, for the purpose of trade, any name not prohibited by statute, and he will be protected in the use thereof to the same extent that he would be in the use of his own name; and where the name which he assumes or adopts as a trade-name is arbitrary or fanciful, he may acquire the exclusive right thereto against all other persons, while, if he uses his own name, he may not be able to prevent the similar use by another person bearing the same name.[5] Whether a person uses his own name or a selected name, it must appear in both instances that he is using the name in good faith, and he cannot exclude another person, having the same name, from using it honestly and in good faith as a trade-name, even though some confusion thereby arises, as every person has the right to use his own name in the prosecution of his business, and this right can be limited or controlled only when such name has become the trade-name or business sign of another, and the later user is using it in a manner to deceive the public, or defraud the person who made it valuable, or, in other words, is using it in unfair competition.[6] This rule is stated by a

teen years used in its trade the corporate title "Roy Watch Case Co." It was held entitled to enjoin, by action, a rival and lately constituted corporation from employing the name "Camm-Roy Watch Case Co."

4 Church v. Kresner (1898) 26 App. Div. (N. Y.) 349.

5 Higgins v. Higgins Soap Co. (1895) 144 N. Y. 462; Croft v. Day (1885) 7 Beav. 84; Holloway v. Holloway (1850) 13 Beav. 209; Russia Cement Co. v. Le Page (1888) 147 Mass. 206.

6 Devlin v. Devlin (1877) 69 N. Y. 212; Meneely v. Meneely (1875) 62 N. Y. 427; Caswell v. Hazard (1890) 121 N. Y. 493; Frazer v.

writer on the law of trade-marks as follows: "The impossibility of a single manufacturer being allowed to arrogate to himself the exclusive use of a name which he shares in common with many other persons is apparent, and from this circumstance the rule was deduced that while, as against persons bearing a different name, a manufacturer's right in his name trade-mark is absolute and exclusive as against persons bearing the same name, no such exclusive right can be set up."[7]

In Burgess v. Burgess[8] it was said: "Where a person is selling goods under a particular name, and another person, not having that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff."

In Meneely v. Meneely[9] the court says: "If the defend-

Frazer Lubricator Co. (1887) 121 Ill. 147; Rogers v. Rogers (1885) 53 Conn. 121; Bingham School v. Gray (1898) 122 N. C. 699; Turton v. Turton (1889) 42 Ch. Div. 128.

[7] Sebastian, Trade-Marks, p. 25.

[8] (1853) 3 De Gex, M. & G. 896.

[9] (1875) 62 N. Y. 427.

In Massam v. Thorley's Cattle Food Co. (1878) 14 Ch. Div. 748, Bramwell, L. J., makes the following statement in reference to the use of individual names: "I wish to make one observation about the use of the name 'Thorley's Food for Cattle.' It has been said that the defendants have a right to say they make Thorley's Food for Cattle if they do not deceive. I agree that, if they could use that expression without the risk of deceiving, they ought to have a right to do so, but it seems to me almost impossible that they can. It is urged that it is hard upon them to forbid their using it, for that every Thorley has a right to make food, and therefore to sell it in his own name, and consequently, I suppose, to call it 'Thorley's Food.' But not only has every Thorley a right to do

ants were using the name of 'Meneely' with the intention of holding themselves out as the successors of Andrew Meneely, and as the proprietors and managers of the old established foundry which was being conducted by the plaintiffs, and thus enticing away the plaintiff's customers, and if, with that intention, they used the name in such a way as to make it appear to be that of the plaintiffs' firm, or resorted to any artifice to induce the belief that the establishment of the defendants was the same as that of the plaintiffs, and perhaps if, without any fraudulent intent, they had done acts calculated to mislead the public as to the identity of the establishments, and produce injury to the plaintiffs beyond that which resulted from the similarity of name * * * [then the

that, but every John Doe has a right to do that because he may give himself the name of 'Thorley,' and carry on business under the name if he thinks fit. A surname is not a man's legal property, or conferred upon him by law in any particular way. It is gained by reputation, and, if he choose to adopt the name 'Thorley,' and other people call him by that name, he is 'Thorley' to all intents and purposes, although his name was originally 'John Doe.' Then it is said that it is hard, if a man has the name of 'Thorley,' that he cannot make food and sell it as 'Thorley's Food.' So he may; but if, unfortunately for him, some preceding Thorley has carried on the business of making cattle food in such a way that by the name 'Thorley's Cattle Food' is understood the manufacture of that man, then the second Thorley, or the man who assumes his name, must take care so to conduct his business as not to be mistaken for the original Thorley, and, if he carries on his business so as to be mistaken, he must be restrained from doing it. It is not a hardship upon him that he should be obliged to state in his advertisements that the article produced by him is the same as Joseph Thorley produced, and is the article which is called 'Thorley's Food for Cattle,' and that the public may buy it of him as well as of the representatives of the original Thorley. The defendants, in that sense, might use the words 'Thorley's Food for Cattle,' but, if they cannot use that expression without misleading people, they must not use it, because it tends to the detriment of the plaintiffs."

court would enjoin them, not from the use of the name, but from using it in such a way as would deceive the public]. * * * 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."

§ 162. Impersonal name used by individual.

As an individual is not required to use his own name in the business which he carries on, he may adopt and use a fictitious, fanciful, or arbitrarily selected name. Such name may be a valid trade-name, and may pass to the purchaser of or successor to the business carried on under such name. Thus, where a banking business had been conducted for many years under the name and style of "Bank of Tomah," and, upon the insolvency of the proprietor, an assignment for the benefit of the creditors was made, it was held that the good-will and business name passed to the assignee, and might be transferred by the assignee to third persons in connection with the real estate and other property formerly used by the assignor in carrying on such business.[10]

§ 163. Firm names.

The same rules apply to the names of firms as trade names as are applied to the names of individuals. Where a name has been adopted in good faith, the users thereof are entitled to the exclusive right thereto, unless the name is one incapable of exclusive appropriation, and is also one that others can use with equal truth. As a firm adopts its own

[10] Bank of Tomah v. Warren (1896) 94 Wis. 151.

name, its act in selecting a name similar to that of a firm already in existence will be very closely scrutinized. If the two names are likely to lead to confusion, that which is last adopted will usually be enjoined. This, however, is not always the case. An illustration of this fact is found in the case of Turton v. Turton,[10a] in which it appeared that a firm had for many years carried on the business of steel manufacturers under the name of "Thomas Turton & Sons," and another manufacturer, John Turton, had for many years carried on a similar business in the same town, at first as "John Turton," then as "John Turton & Co.," and later, upon taking his two sons into partnership, as "John Turton & Sons," and there was no evidence of imitation of trade marks or labels, or other attempt to deceive the public, and it was held, although there was a probability that the public would be occasionally misled by the similarity of the names, the plaintiffs were not entitled to an injunction restraining the defendants from the use of the name "John Turton & Sons." It will be apparent that John Turton had a perfect right to do business under his own name, and, having taken his sons into partnership with him, it was proper to announce that fact, and make it known to the public by making the name of the firm "John Turton & Sons." In the absence of any evidence of an attempt at unfair competition, it was properly held that the firm of John Turton & Sons had a right to continue to use that name. Where a number of persons had carried on business as a partnership under the name of the Kalamazoo Wagon Co., and where two of the partners sold their interest in the property, assets, money, goodwill, and all other property of every name and nature in and to the firm, to the others, and these two, with others, afterwards organized a corporation under the name of the Kalamazoo

[10a] (1889) 42 Ch. Div. 128.

Buggy Co., it was held that they should be restrained from using that name.[11]

11 Myers v. Kalamazoo Buggy Co. (1884) 54 Mich. 215. See, also, Churton v. Douglas (1859) John's Eng. Ch. 174; Fullwood v. Fullwood (1876) 9 Ch. Div. 176.

In Bowman v. Floyd (1867) 3 Allen (Mass.) 76, it was held that a receipt given by executors for money due and paid to the estate of a deceased person from former partners, in which the latter are mentioned by the name of the former partnership, under which they continued to carry on the business, will not be construed as a written consent to the continued use of the former partner's name in the new business and firm, if it was executed and delivered merely for the purpose of exhibiting the settlement of the claim.

In Rogers v. Taintor (1867) 97 Mass. 291, where it appeared that F., J., R., and T., copartners, began the business of manufacturing machinery at Worcester, Mass., in 1852, under the name of F. & Co.; and F., J., R., and C., copartners, began a like business at Cincinnati, Ohio, in 1853, under the same name, using it as a style of the firm and as a trade-mark, and F. died in 1854, and, ever since his death, J., R., and C., copartners, continued the business at Cincinnati with all the rights as to the use of the name of F. & Co. which the Cincinnati firm had originally, and J., R., and T., copartners, continued the business at Worcester under the name of F. & Co., with the assent of F.'s representatives, until 1861, when their firm was dissolved, and its orders, correspondence, and goodwill were sold to T., a member of the dissolved firm, who thereafter pursued the business of buying and selling, and not of manufacturing, machinery, it was held that J., R. & Co. could not maintain a bill of equity to enjoin T. in his business, and attaching it to machinery sold by him, but made by others than J., R. & Co.

In McGowan Bros. Pump & Machine Co. v. McGowan (1872) 2 Cin. R. (Ohio) 313, the facts were as follows: Theodore and John McGowan were manufacturers of pumps, under the name of "McGowan Brothers." John sold out all his interest in the business and assets of the firm to Theodore, including the old patterns, with the name "McGowan Brothers" on them, and Theodore was to assume the liabilities and succeed to the business of the firm, and associate with himself others if he chose. After the contract of sale was executed there was inserted in the notice of dissolution a privilege

§ 164. License to use individual name.

Where a person permits a firm to use his name as a part of the firm style and title, the partnership may acquire by such license an exclusive right to the use of the name, as long as the firm continues intact, but it cannot, upon its dissolution, confer the same privilege on its successor. When a re-

to Theodore of using the old firm name, as to which there had been no previous negotiation. Theodore, with others, procured a certificate of incorporation under the name "McGowan Brothers Pump & Machine Company," and transferred to the said corporation all his rights and interest as purchased from John. It was held that John, who set up a similar business by himself, was entitled to an injunction to restrain the corporation from the use of "McGowan Brothers" in its name, the use of the old firm name granted to Theodore being in the nature of a revocable license; that the old name was not a trade-mark, to be used by the corporation, and, while it had the right to use the patterns and sell the castings with the name "McGowan Brothers" on them, it could not hold out, by the corporate name, that all the articles made by it were in part the product of the skill and labor of John, or that the corporation was in fact the old firm.

In Schmid v. De Grauw (1899) 27 Misc. Rep. (N. Y.) 693, where it had been duly adjudicated in a former action between the present plaintiff, purchaser of the entire stock in trade of the business of an old firm, and one of the present defendants, who participated in such sale, that the plaintiff was alone entitled to use the firm name, the participating defendant, and persons whom he had associated with himself because of the identity of their names to those of the partners of the old firm, were restrained from using the name of the old firm.

In Williams v. Farrand (1891) 88 Mich. 473, where, upon the dissolution of a firm called Farrand, Williams & Co., which was composed of one partner named Farrand and another named Sheley, Farrand sold to Sheley his interest in the concern, and Sheley's firm adopted the name of Williams, Sheley & Banks, successors to Farrand, Williams & Co., and where Farrand afterwards founded the firm of Farrand, Williams & Clark, these being the names of the partners therein, it was held that the latter firm was authorized to conduct the business in that name. In this case the court stated that the following propositions must be regarded as established by

tiring partner. whose name is part of the firm name, makes a contract giving to the other partner the right to continue the use of the same firm name as long as the other partner carries on the business, such right to use the retiring partner's name cannot be assigned to a corporation formed to take over the business. While a person might be willing to forego the use of his own name in favor of an ordinary partnership, which, whether limited or not to a definite term

the clear weight of authority: "(1) Though a retiring partner may have assigned his interest in the partnership business, including the goodwill thereof, to his copartner, he may, in the absence of an express agreement to the contrary, engage in the same line of business in the same locality and in his own name. (2) He may, by newspaper advertisements, cards, and general circulars, invite the general public to trade with him, and, through the same mediums, advertise his long connection with the old business, and his retirement therefrom. (3) He will not be allowed, however, to use his own name, or to advertise his business, in such a way as to lead the public to suppose that he is continuing the old business; hence will not be allowed to advertise himself as his successor. (4) The puchaser will not, in the absence of an express agreement, be allowed to continue the business in the name of the old firm. (5) That no man has a right to sell or advertise his own business or goods as those of another, and so mislead the public, and injure such other person. * * * (6) That, when an express contract has been made to remain out of business, or for the use by a purchaser of a fictitious name, or a trade-name, or a trade-mark, the courts will enjoin the continued violation of such agreement. * * * (7) That an assignment of all the stock, property, and effects of a business, or the exclusive right to manufacture a given article, carries with it the exclusive right to use a fictitious name in which such business has been carried on, and such trade-marks and trade-names as have been in use in such business. * * * (8) A corporate name is regarded in the nature of a trade-mark, even though composed of individual names, and its simulation may be restrained. After adoption, it follows the corporation." In the report of this case the following propositions are stated to be summarized from the opinion of Mr. Justice McGrath: "(a) Goodwill may be said to be those intangible advantages or incidents which are impersonal, so far as the grantor is concerned, and attached to

of existence, is liable upon many contingencies to come to an end, there could not reasonably be inferred from such a grant an intention to authorize a transfer or assignment of the name to other companies or corporations, whereby the owner might be perpetually deprived of his own name. Acquiescence by any person in the wrongful use of his name will not estop him from asserting his rights in equity unless he has notice, during such acquiescence, of the facts rendering the use of his name wrongful.[12]

the thing conveyed. (b) Where it consists of the advantages of location, it follows an assignment of the lease of that location. Again, it may not depend at all upon location, as in the case of a newspaper, and it would follow an assignment of all interest in the plant, property, effects, and business. (c) A partnership name may become impersonal after the death of the partners, and it is then treated like a fictitious or corporate name. (d) A surname may become impersonal when it is attached to an article of manufacture, and becomes the name by which such article is known on the market, and the right to use the name may, in consequence, follow a grant of the right to manufacture that article, or a sale of the business of its manufacture, and, when the right to manufacture is exclusive, the right to the use of the name as applied to the article becomes likewise exclusive."

[12] Bagby & Rivers Co. v. Rivers (1898) 87 Md. 400; Horton Mfg. Co. v. Horton Mfg. Co. (1883) 18 Fed. 816. See, also, Lodge v. Weld (1885) 139 Mass. 499; Lawrence v. Hull (1897) 169 Mass. 250; Iowa Seed Co. v. Dorr (1886) 70 Iowa, 481. In Reeves v. Denicke (1871) 12 Abb. Pr. (N. S.; N. Y.) 92, the court says: "In this case, the firm name * * * was not sold or transferred to the defendants as constituting a part of the partnership property and effects. Nor did the sale, in terms or by necessary implication, include the goodwill of the business of the previous firm, and it is therefore unnecessary to determine whether the partnership name was a part of such goodwill. There was no restraint upon the retiring partner holding him from engaging in a similar business, and he violated no obligation to the defendants by forming a new firm under his own name, and transacting a business in all respects like that which he had released to them. It is quite clear, I think, that the defendants acquired no right to continue the use of the partnership

§ 165. Presumption as to individual name appearing in firm name.

A person whose name appears in the name of a firm or partnership, in the absence of anything raising a contrary presumption, will be presumed to have agreed that it should so continue during the existence of the partnership. If, before the partnership expires, he merely sells his interest in the concern to a stranger, he conveys to the purchaser a right to the use of his name during the remainder of the term. If, at the expiration of the term, he sells his interest with an agreement, express or implied, that the business shall thereafter be continued under the same name, the same rule applies. At the dissolution of the partnership, the partners revert back to their individual rights and responsibilities, and each partner, in the absence of any agreement to the contrary, has an absolute right to control the use of his own name.[13]

§ 166. Rule where firm name is impersonal.

Where, however, the name adopted and used by a firm is impersonal, it becomes a part of the assets of the firm, and may be sold with the business, either by the partners directly, or through a receiver, under an order made by a court, in a case to which they are parties, and such name may be transferred by the purchaser to a corporation organized to succeed to the business. This was held by the supreme court of Ohio in a case in which it used the following language: "We are not reluctant, therefore, in holding that, upon the dissolution

name of the old firm. If the good reputation of that firm was intended to pass into and become a part of the defendants' new firm, it should have been provided for in the conveyance. That it was not intended it should pass is evident from the omission to include it."

[13] Holmes v. Holmes, Booth & Atwood Mfg. Co. (1870) 37 Conn. 295.

of a trading copartnership, its assets, including the goodwill of the business, may be sold as a whole, either by the partners directly, or through a receiver, under an order made by a court in a case to which they are parties, and that a purchaser thereof under either method of sale is entitled to continue the business as the successor of the firm, and make use of the firm name for that purpose. And, further, that where the purchaser transfers the property so acquired by him to a corporation of which he is a member, organized to succeed to the business, it may carry on the business in the same manner under a corporate name including the name which had been used by the firm."[14]

§ 167. Corporate names.

In respect to corporate names, the same rules apply as to the names of firms or individuals; and an injunction lies to restrain the simulation and use by one corporation of the name of a prior corporation, which tends to create confusion, and to enable the later corporation to obtain, by reason of the similarity of names, the business of the prior one. The courts interfere in these cases, not on the ground that the state may not affix such corporate names as it may elect to the entities it creates, but to prevent fraud, actual or constructive. The names of corporations organized under general laws, and in most other cases, are chosen by the promoters, and it would be an easy way to escape from the obligations which are enforced as between individuals, if a corporation were granted immunity by reason of its corporate character. The principle upon which courts usually proceed in restraining the simulation of a name that has come to designate the business of a particular person or company was stated in the Guinea Coal Company Case by Giffard, L. J., as follows: "I quite

[14] Snyder Mfg. Co. v. Snyder (1896) 54 Ohio St. 86.

agree that they [plaintiffs] have no property in the name [Guinea Coal Company], but the principle upon which the cases on this subject proceed is, not that there is property in the word, but that it is a fraud on the person who has established a trade, and carries it on under a given name, that some other person should assume the same name, or the same name with a slight alteration, in such a way as to induce persons to deal with him in the belief that they are dealing with the person who has given a reputation to the name."[15] Whether the court will interfere in a particular case must depend upon circumstances,—the identity or similarity of the names; the identity of the business of the respective corporations; how far the name is a true description of the kind and quality of the article manufactured, or the business carried on; the extent of the confusion which may be created or apprehended; and other circumstances which might justly influence the judgment of the judge in granting or withholding the remedy. Where it appeared that the plaintiff's corporate name was lawfully given to it by legislative action more than forty years before suit was brought, the court held that there would seem to be no good reason why it should not receive as much protection against the unauthorized use of its name as a natural person. It has also been said that a corporate name is entitled to protection to the same extent as a trade-mark.[16]

[15] Lee v. Haley (1869) 5 Ch. App. 155; Chas. S. Higgins Co. v. Higgins Soap Co. (1895) 144 N. Y. 463; Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 300; Holmes v. Holmes, Booth & Atwood Mfg. Co. (1870) 37 Conn. 278; Newby v. Oregon Cent. Ry. Co. (1869) Deady, 609, Fed. Cas. No. 10,144.

[16] In William Rogers Mfg. Co. v. Simpson (1887) 54 Conn. 568, the following is quoted from Sebastian on Trade-Marks (page 226 et seq.): "It was formerly sometimes supposed, and was held by the late master of the rolls and the court of appeal in Singer Mfg. Co. v. Wilson, 2 Ch. Div. 434, that, for an action to restrain the use

§ 168. Conflicting corporate names.

Where a controversy is between two corporations, there are certain things to be observed: Each party owes its existence to the law. The law authorizes, sanctions, and protects every act done, and every step taken, in pursuance of law, whether in the process of organization or in the course of its

of a trade-name to be successful, fraud must be proved, on the ground that, when a trade-mark was once affixed to the goods, it passed with the goods from hand to hand, thus silently repeating to each successive purchaser the original misrepresentation of the original infringer, while the improper use of a name not affixed to the goods was not the necessary consequence of being in possession of marked goods, but was the individual act of each person who used it in respect of the goods; so that there might be held to be an infringement of a trade-mark when, in analogous circumstances, there would be no infringement of a trade-name. And when the case of Singer Machine Manufacturers v. Wilson, 3 App. Cas. 376, was remitted by the house of lords to the court of first instance, on the ground of insufficiency of evidence, some of the law peers seem to have thought that different principles of law might possibly be applicable to trade-marks and trade-names. But Lord Cairns, Chancellor, said: 'It may well be that, if an imitated trade-mark is attached to the article manufactured, there will, from that circumstance, be the certainty that it will pass into every hand into which the article passes, and be thus a continuing and ever-present representation with regard to it, but a representation, made by advertisements, that the articles sold at a particular shop are articles manufactured by A. B. (if that is the legitimate effect of the advertisements, which is a separate question), must, in my opinion, be as injurious in principle, and may possibly be quite as injurious in operation, as the same representation made upon the articles themselves; and in Singer Mfg. Co. v. Loog, 8 App. Cas. 15, Lord Blackburn took the view that the law of trade-marks and trade-names, when not affected by legislation, was the same. Whether there is or is not property in a trade-name, as Lord Blackburn suggested, it is a fraud on the part of one person to attract to himself the custom intended for another, by a false representation, direct or indirect, that the business carried on by himself is identical with that of the other person, by whose ability and exertions the name has acquired the reputation it possesses. The

business. It is true all the details are not prescribed in advance. Certain general powers are conferred, which are applicable alike to all corporations, such as the power to hold property, to sue and be sued, and the like. So, also, of certain requisites and forms, such as the par value of each share of stock, the publication notice, and recording the articles of association, etc. Other powers and privileges are left in

question is not whether the defendant's business is represented as being similar to the plaintiff's, but whether it is represented as being that very identical business. If such a false representation has been made, whatever may have been the motive of the persons making it, when proceedings are taken in consequence of it, all the court requires is to be satisfied that the names are so similar as to be calculated to produce confusion between the two,—so calculated to do it that, when it is drawn to the attention of those adopting the name complained of, that that would be the result, it is not honest for them to persevere in their intention, though originally the intention might not have been otherwise than honest.'"

In Newby v. Oregon Cent. Ry. Co. (1869) Deady, 616, Fed. Cas. No. 10,144, in the United States court for the district of Oregon, Judge Deady, in considering the name of a corporation, said: "By the execution and filing of these articles, the corporate name assumed thereby and specified therein becomes exclusively appropriated. If afterwards any person attempt to incorporate for any purpose by the same name, this would be an encroachment upon the rights of the first corporation, and therefore illegal. To prevent the continuance of such a wrong upon the rights of another, equity will interfere, at the suit of the injured party, by injunction. The case is analogous to, if not stronger than, that of a piracy upon an established trade-mark. Bell v. Locke, 8 Paige (N. Y.) 75; Taylor v. Carpenter, 11 Paige (N. Y.) 292; Partridge v. Menck, 2 Barb. Ch. (N. Y.) 102; Willard, Eq. 402, 403. The corporate name of a corporation is a trade-mark from the necessity of the thing, and, upon 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 this name is well calculated to injuriously affect the identity

a measure to the discretion of the parties interested. Among these are the amount of capital stock, the location, the business to be transacted, and the name. When the corporators have once exercised their power in respect to these matters, the law declares the capital stock, the location, the business,

and business of a corporation; and, as a matter of fact, in some degree at least, the natural and necessary consequence of the wrongful appropriation of a corporate name is to injure the business and rights of the corporation by destroying or confusing its identity. The motives of the persons attempting the wrongful appropriation are not material. They neither aggravate nor extenuate the injury caused by such appropriation. The act is an illegal one, and must, if necessary, be presumed to have been done with an intent to cause the results which naturally flow from it. Nor will a court of equity refuse to enjoin the wrongful appropriation of a corporate name until the right of the first corporation to the name has been established by the verdict of a jury in an action at law. Such right does not rest in parol, but is shown by the record, if at all, and is determined by the court in any form of proceeding. Neither, in such case, has the party injured an adequate and complete remedy at law. As in the case of patents for inventions and copyrights, the remedy at law can only give redress for the past injury, and that often inadequately; but to protect the injured corporation from the mischief arising from continued violation of its rights and perpetual litigation concerning them, resort must be had to the equitable remedy by injunction. Story, Eq. § 930. Nor do I deem it material in this case to the jurisdiction in equity that the defendant should be insolvent,—unable to respond to the complainant in damages. The jurisdiction in this class of cases—trade-marks, patents, and copyrights—depends upon the fact that the matter is intrinsically of equitable cognizance; that the legal rights of the party can only be protected in equity, and not upon the uncertain and irrelevant test of the insolvency of the defendant." With the exception that the court designated the corporate *name* of a corporation as a trade-*mark*, this is an accurate statement of the law. The court should have said: "The corporate name of a corporation is a trade-*name*, from the necessity of the thing, and, upon every consideration of private justice and public policy, deserves the same consideration and protection from a court of equity as a trade-*mark*."

and the name to be as thus determined, until changed in pursuance of law. In respect to these matters the corporation is as much the creature of, and subject to, and protected by, the law as in the former. The law having authorized the selection of a name, and having declared the name so selected to be the name of the corporation, there is no reason why the law should not protect the corporation in the use of that name, upon the same principle, and to the same extent, that individuals are protected in the use of trade-marks. Hence it necessarily follows that corporations, in the exercise of discretionary powers conferred by the statute, must so exercise them as not to infringe upon the established legal rights of others.[17] In a leading case in the United States circuit court, Mr. Justice Bradley said: "The fact that both are corporate names is of no consequence in this connection. They are the business names by which the parties are known, and are to be dealt with precisely as if they were the names of private firms or partnerships. The defendant's name was of its own choosing, and, if an unlawful imitation of the complainant's, is subject to the same rules of law as if it were the name of an unincorporated firm or company."[18] And where complainants adopted as their trade-name the designation "Taper-Sleeve Pulley Works," and on that name built up a large general trade in taper-sleeve pulleys and other articles throughout the United States, it was held that complainants were entitled to the exclusive use of said trade-name, even as against a later corporation organized in another state under the same name, and having the right to make and sell the device of the taper-sleeve pulley, and hav-

[17] Holmes v. Holmes, Booth & Atwood Mfg. Co. (1870) 27 Conn. 293.

[18] Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 97.

ing also the right to so designate the article, and to advertise itself as a manufacturer and vendor thereof.[19]

In the English case of National Folding Box & Paper Co. v. National Folding Box Co.[20] it appeared that the plaintiffs were an American company which manufactured folding boxes and other goods of the same kind in America, and that there was a considerable market for their goods on the Continent and in England, where an English company were their sole agents. The defendants had been doing business for some years as Parmenter & Co., and in June, 1894, they passed and registered a special resolution to change their name to the "National Folding Box Co., Limited." The plaintiffs moved for an injunction to restrain the defendants from using plaintiffs' name, or any colorable imitation thereof. The injunction was granted, the court using the following language: "It was said that the plaintiffs are an American company, and carry on business in America, and that there is, therefore, no question of the defendants interfering with them. But, as a matter of fact, the plaintiffs do carry on, through their agents, a large business in England, and are, accordingly, entitled to the benefit of such protection as the law of England gives to persons carrying on a legitimate business in this country. The defendants have interfered with this business; they have adopted a name which, in all reasonable probability, will lead to their goods being passed off as goods manufactured by the plaintiffs. They have no right to do this. I think the names so similar that the result which the plaintiffs fear was the probable result to be expected. How did the defendants come to adopt their name? They adopted it last June after carrying on business for seven years under a totally different name. I do not be-

[19] Gray v. Taper-Sleeve Pulley Works (1883) 16 Fed. 436.
[20] (1894) 13 Reports, 60.

lieve that the explanation of the reasons for the change of name were correct, and I have come to the conclusion that the defendants adopted the name on account of its resemblance to the plaintiffs' name, knowing that the plaintiffs had a large business in England."

§ 169. Corporation may acquire trade-name different from corporate name.

A corporation may acquire a right to the exclusive use of another name than its corporate name as a trade-name, but not as a corporate name. Hence, where a corporation, with a corporate name similar to a trade-name used by an older corporation, continued for ten years to exercise its franchise in a different line of the same business without mutual embarrassment, except that letters and packages intended for the latter sometimes miscarried, without, however, causing serious inconvenience, and the younger corporation then prepared to enter the same line of business, and to use its corporate name in competition with the older corporation, it was held that a petition for leave to file an information in the nature of a *quo warranto,* and to restrain the younger corporation from thus using its corporate name, must be dismissed. This decision, however, was based on the ground that the proceeding sought to restrain the younger corporation from exercising its franchise, and, if it had a right to use its corporate name at all, the petition must be denied, and that it could not be restrained in a proceeding of this character from using its name in one line of business, and not in another. The remedy of the older corporation in this instance should have been by an action to restrain the younger corporation from using its name in the particular line of business in which the older corporation was engaged, on the ground that such use of the name would tend to create con-

fusion, and to cause the younger corporation to be mistaken for the older.[21]

§ 170. Corporation may not be entitled to use abbreviated name.

A corporation may in some instances be entitled to use its entire corporate name, where it would not be entitled to use an abbreviation of such name, if such abbreviated name was so close a resemblance to the name of another corporation, or to the abbreviation used for the name of another corporation, as to cause confusion. Thus, where the Sun Life Assurance Company of Canada, which was duly incorporated in Canada, and had there carried on business for some years under that name, opened an office in the city of London, and where the Sun Life Assurance Company, which was established in 1810 in England, with its head office in the City of London, commenced proceedings against the Canadian company, and moved for an injunction to restrain the defendant company from carrying on in the United Kingdom the business of a life assurance company under the name of the "Sun Life Assurance Company of Canada," it was held that, inasmuch as the mere user by the defendant company of its full name involved no misstatement of fact, and was not a fraudulent user, the defendant company was entitled to use in the United Kingdom its full corporate name, but that this right did not extend to the use of the name of "The Sun" or "The Sun Life" without the addition of the words "of Canada."[22]

§ 171. Estoppel arising from assent to adoption of corporate name.

Where a corporation assumed the name of the "Lamb

21 Boston Rubber Shoe Co. v. Boston Rubber Co. (1889) 149 Mass. 436.

22 Saunders v. Sun Life Assur. Co. of Canada (1893) 8 Reports, 125.

Knit-Goods Co.," with the knowledge and consent of one of the defendants, who, acting as agent, transferred to the corporation the property, business, and goodwill of a prior company, known as the "Lamb Knitting Company," and where it appeared that complainant had no exclusive right to the use of the terms "Lamb Knit," "Lamb Goods," "Lamb Machine Goods," or "Lamb Knit Goods," it was held that complainant was entitled to an injunction restraining the defendant from continuing the use of its corporate name "Lamb Glove & Mitten Company," or any name in which the name "Lamb" appears in connection with other words indicating a business similar to that of complainant, it being shown that considerable confusion had arisen, and that dealers had been misled, and that, by the transfer to the complainant of the goodwill of the Lamb Knitting Company, it was the intention of the defendant Lamb to grant the right to use his name in connection with the complainant's business, and that in fact he assisted in organizing the corporation, and became a stockholder in it, and he was therefore estopped from asserting that the company did not take its name rightfully.[23] In Clark Thread Co. v. Armitage, where it appeared that the defendant was originally incorporated as the William Clark Thread Company, and that plaintiff, the Clark Thread Company, objected to this name, and, at the suggestion of its managing director and treasurer, defendant's name was changed to the William Clark Company, it was held that plaintiff was estopped from afterwards objecting to the use by defendant of the amended name.[24]

§ 172. Individual name used as principal part of corporate name.

The fact that one of the incorporators and stockholders of

[23] Lamb Knit-Goods Co. v. Lamb Glove & Mitten Co. (1899) 120 Mich. 159, 44 L. R. A. 841.

[24] (1895) 67 Fed. 896, (1896) 21 C. C. A. 178, 74 Fed. 936.

a corporation bears an individual name that becomes the principal part of the name of the corporation gives the corporation no immunity from the consequences which ordinarily flow from an attempt to deceive the public by the fraudulent use of another's name, since the promoters of the corporation could have given to it any other name that they liked, provided the designation was honestly made, and without injury to others.[25] Where the circumstances surrounding the creation of a corporation and the naming of it were such as to show that the selection of the name was not an honest one, but a part of the original scheme of the promoter to make such use of his own name as would enable him to profit by the name which the plaintiffs had given to their articles on the market, and which they had made valuable by much labor and a liberal expenditure of money, it was held that the corporation would not be permitted to make use of a name acquired in such a manner and for such a purpose.[26]

§ 173. Descriptive names cannot be exclusively appropriated.

Names which are merely descriptive of well-known classes of goods, or of well-known methods of transacting business, cannot be exclusively appropriated as trade-names. In the case of Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., the supreme court of the United States said: "But the name of 'Goodyear Rubber Co.' is not one capable of exclusive appropriation. 'Goodyear Rubber' are terms

[25] De Long v. De Long Hook & Eye Co. (1895) 89 Hun (N. Y.) 399; De Long v. De Long Hook & Eye Co. (1894) 10 Misc. Rep. (N. Y.) 577. See, also, De Long v. De Long Hook & Eye Co. (1896) 7 App. Div. (N. Y.) 33.

[26] S. Howes Co. v. Howes Grain Cleaner Co. (1897) 46 N. Y. Supp. 165, (1897) 19 App. Div. (N. Y.) 625; permanent injunction granted (1898) 24 Misc. Rep. (N. Y.) 83.

descriptive of well-known classes of goods produced by the process known as 'Goodyear's Invention.' Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word 'Company' only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them. Thus, parties united to produce or sell wine, or to raise cotton or grain, might style themselves 'Wine Company,' 'Cotton Company,' or 'Grain Company,' but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have the right to deal in such articles, and to publish the fact to the world. Names of such articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name."[27]

In Bolander v. Peterson[28] it was held that the words "Svenska Snusmagasinet," which means "The Swedish Snuff Store or Magazine," cannot be exclusively claimed as a trade-name by one engaged in the business which they describe. The court said: "The words 'Swedish Snuff Store' are descriptive of the business there carried on, and may mean that it is conducted by Swedes, or that Swedish snuffs are there sold, or that Swedes are expected to patronize the same, and nothing more. * * * A trade-mark must be such as will clearly identify the article to which it is affixed as that of the person adopting it, and distinguish it from that of all others. * * * A generic name, or one merely descriptive of the article made or sold, or its qualities,

[27] (1888) 128 U. S. 598.
[28] (1891) 136 Ill. 215.

ingredients, or characteristics, and which may be employed truthfully by other makers or dealers, is not entitled to protection as a trade-mark."

In Employers' Liability Assur. Corp. v. Employers' Liability Ins. Co.,[29] the supreme court of New York adopted the same rule, and said: "We are of the opinion that the court below was correct in refusing a general injunction against the defendant in this action, prohibiting it from the use of the term 'Employers' Liability,' upon the ground that this term is a descriptive term used generally to designate a certain well-known branch of the insurance business. But it is claimed that, wholly irrespective of any question of exclusive property in the name, the plaintiff was entitled to protection against any such appropriation as would interfere with its business by inducing the public to suppose that a new company trading under the same was the original plaintiff corporation; that it was not necessary that fraud or evil practice should be shown; if the fact is made to appear that the use of a trade-mark or corporate name lawfully possessed and enjoyed by a trading company is so used by a competitor as to deceive or mislead dealers to the prejudice of the corporation lawfully using the name, equity will protect by injunction. And our attention is called to certain cases, among which are McLean v. Fleming [96 U. S. 245] and Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. [128 U. S. 598]. But we think that an examination of those cases is fatal to this claim. The rule is there expressly recognized that exclusive right to use a term descriptive of a character of business cannot be acquired, and the evidence in this case shows that the term 'Employers' Liability' was in common use in respect to this class of insurance."

[29] (1891) 61 Hun (N. Y.) 552.

In Continental Ins. Co. v. Continental Fire Ass'n[30] it was held by the circuit court for the northwestern district of Texas that the word "Continental" was a generic term, the right to use which could not be exclusively appropriated by any individual or corporation, and an injunction was denied, in the absence of proof of any fraudulent intent or conduct on the part of the defendant, or that the public had been deceived by the similarity of the names. This decision was affirmed by the United States circuit court of appeals for the fifth circuit.

It has also been held that the term "International Banking Company" is incapable of exclusive appropriation.[31] But the long-continued exclusive use of a trade-name, although primarily intended to be descriptive of the quality of product, entitles the user to protection against its unnecessary adoption and use by another which is calculated to deceive purchasers, the use having been retained for that purpose. And where the simulation of a complainant's trade-name by another is manifestly liable to deceive, it is not necessary for complainant to show that purchasers have actually been deceived, to entitle him to relief.[32] This right to relief, however, rests on the doctrine of preventing unfair competition, rather than on any exclusive right in the user to a trade-name of this character.[33]

[30] (1899) 96 Fed. 846, (1900) 101 Fed. 255.

[31] Koehler v. Sanders (1890) 122 N. Y. 65.

[32] Fuller v. Huff (1900) 104 Fed. 141, reversing (1899) 99 Fed. 439.

"A name, although generic and geographical, is within the rule of protection in law if it does not indicate that the business carried on is to be patronized by the people of any particular locality, or that any specific product is therein to be sold, or any particular language is there to be spoken." Whitfield v. Loveless (1893) 64 Official Gaz. 442.

[33] See chapter 10.

§ 174. Injunctions refused.

Where a corporation chartered in Michigan was doing business in Chicago, and another company was incorporated in Illinois under the same name, and filed a bill to restrain the use of this name by the former corporation, alleging that the Michigan corporation no longer existed, it was held that this was not a sufficient ground therefor, as the defendants might nevertheless do a partnership business under any name not interfering with any earlier party's use thereof.[34] The use of any particular name by a corporation will not be enjoined unless it is made to appear from the evidence and by all the circumstances that the proposed use of the name will likely result in injury to the complainant corporation.[35] Where two corporations are incorporated with similar names under the laws of different states, but there is no such similarity between the goods manufactured by them, or between their circulars or advertisements, as to be likely to deceive the ordinary mass of purchasers, an injunction will not be granted to restrict the use by one corporation of the name by which it is known, and under which it is incorporated.[36]

[34] Ottoman Cahvey Co. v. Dane (1880) 95 Ill. 203.

[35] Drummond Tobacco v. Randle (1885) 114 Ill. 412.

[36] Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 40 Ill. App. 430, affirmed (1892) 142 Ill. 494.

In the case of German Hanoverian & Oldenberg Coach Horse Ass'n v. Oldenberg Coach Horse Ass'n, 46 Ill. App. 281, it was held by the Illinois first district appellate court that where two associations are incorporated under the laws of Illinois under similar names, the claim of the older corporation to the use of the name will be upheld, and nothing done by individuals, in the name assumed by the junior corporation, before it was incorporated, adds to the rights of the junior corporation, since the assumption and use of a corporate name, in the state of Illinois, at least, is in direct violation of law, and the courts of that state will refuse to enforce or give efficacy to rights claimed to have been acquired by means of such illegal acts.

Where a corporation was duly incorporated under the laws of the state of Nebraska, with its principal place of business in the city of Hastings, in said state, under the name of the "Nebraska Loan & Trust Company," and where this company had been in business for a number of years, loaning money, buying and selling real-estate mortgages, city, county, and other municipal evidences of debt, and had largely increased its capital and extended its sphere of operations until it transacted business in a number of counties in the state, and where the defendants were proposing to organize a loan and trust company in the city of Lincoln, in the same state, with the corporate name of the "Nebraska Loan & Trust Company," it was held, in an action in equity by the Hastings company to enjoin the members of the Lincoln company from taking the corporate name referred to, that the law governing trade-marks for manufactured goods did not apply, and plaintiff could take no property in the name of the state, to the exclusion of the defendants; that, the proof failing to show a conflict of interest, or that the business transacted by the defendants would materially interfere with the business of the plaintiff, the injunction would be refused.[37]

The terms "Investor" and "Investor Publishing Company" were held capable of appropriation as trade-names, on a demurrer to bill of complaint, by the United States circuit court for the southern district of California,[38] although, on final hearing, the bill of complaint was dismissed by the same judge on the ground that the papers were published in widely separated states, and that the names were used with distinguishing characters, which rendered injury to complainant therefrom improbable, and absence of proof

[37] Nebraska Loan & Trust Co. v. Nine (1889) 27 Neb. 507.

[38] Investor Pub. Co. v. Dobinson (1896) 72 Fed. 603.

that injury to the complainant therefrom had actually resulted.[39]

Where a son of Marcus Ward withdrew from the firm of Marcus Ward & Co., Limited, which was engaged in the manufacture of linen paper, and established the firm of William H. Ward & Co., engaged in the same business, an action was brought to enjoin the members of said firm from placing the name of "Marcus Ward's Son" on their goods, and the expression, "Late of the firm of Marcus Ward & Co.," on their letter heads. It was held, the fact being that the defendant was a son of Marcus Ward, and lately a member of the firm named, that plaintiff was not entitled to an injunction.[40]

§ 175. Where corporation is not of commercial or trading character.

A right to injunctive relief against the improper use of a corporate name which interferes with the business of a corporation is not limited to cases where the business is of a commercial or trading character. Thus, a corporation organized in 1892, pursuant to chapter 267 of the Laws of 1875, state of New York, under the name of "The Society of the War of 1812," for the purpose of commemorating that war, and other kindred purposes, is entitled to an injunction restraining a corporation organized for similar purposes in 1896 under the name of "The Society of the War of 1812," in the state of New York, from using the words, "The Society of the War of 1812," as part of its corporate title, where it appears that the similarity of the names tends to produce confusion, and to affect injuriously the conduct

[39] Investor Pub. Co. v. Dobinson (1897) 82 Fed. 56.

[40] Marcus Ward & Co. v. Ward (1891) 61 Hun, 625, 15 N. Y. Supp. 913.

of the business of the older corporation.[41] But it has also been held that the use of the title "Colonial Dames" will not be restricted to the corporation which first adopted it, where it appears that another corporation, and a nonincorporated society, which are also using it, are not conducting it for a pecuniary profit, and that all three societies are merely societies for patriotic and philanthropic ends.[42]

§ 176. Organization of corporation with name conflicting with name of prior corporation.

While the statutes of most of the states prohibit the formation of a corporation with a name similar to that of a prior corporation in the same state, there is nothing to prevent the organization of a corporation in one state with the same name as that of a corporation foreign to that state, and courts will not interfere to prevent the organization, under the statutes of a state, of a corporation bearing the same name as a foreign corporation. This question came before Judge Gresham in the United States district court for the northern district of Illinois in a case in which the Lehigh Valley Coal Co., a corporation organized in 1875 under the laws of the state of Pennsylvania, sought to prevent the defendants from taking certain steps in the creation of a new corporation, with the same name, under the laws of the state of Illinois. In dissolving the temporary injunction previously granted, and dismissing the bill, Judge Gresham said: "The complainant is a foreign corporation, and it is only by comity that it is doing business in Illinois at all.

[41] Society of War of 1812 v. Society of War of 1812 (1900) 46 App. Div. (N. Y.) 568.

[42] Colonial Dames of America v. Colonial Dames of New York (1899) 29 Misc. Rep. (N. Y.) 10.

The state can say to it any day, 'Go!' and it must go. That being so, I do not see that the complainant has a legal right to say a corporation shall not be created in Illinois bearing its (the complainant's) name. If the state of Illinois may create a corporation bearing the same name as the complainant,—and it certainly can,—this court has no right by injunction to prevent anything from being done under the state law which is necessary in the creation of such a corporation. The commissioners perform a function under the laws of the state in the formation of the corporation. If they are not officers of the state, they are instrumentalities employed by the state. If they can be enjoined from receiving stock subscriptions under the license issued to them by the secretary of state, I do not see why the latter might not be enjoined from issuing a license, or doing anything else under the state statute. The general law authorizing the secretary of state to issue a license to commissioners to receive stock subscriptions provides that no license shall be issued to two or more companies having the same name. Before bringing this suit, the complainant should have brought to the attention of the secretary of state the matters alleged in the bill. He might, on a proper application, have revoked the license to the defendants, unless they adopted another name for their company. I do not think this court can interfere by injunction, at the instance of a foreign corporation, and prevent any necessary step from being taken under the statute of this state in the creation of a corporation. I do not say what may be done if the defendants succeed in creating their corporation bearing the complainant's name, and a suit shall be brought by the complainant to prevent individuals claiming to be officers or managers of such corporation from interfering with the complainant's business,

as already stated. The temporary injunction heretofore granted is dissolved, and the bill is dismissed."[43]

So, also, where, under the statutes of the state of Michigan, it was provided that "corporations organized in this state shall not take any name in use by any other organization of this state, or so closely resembling such name as to mislead the public as to its identity," and the relator, the Home Life Insurance Company, a foreign corporation, filed a petition asking leave to file an information in the nature of a *quo warranto* against the respondent for violating this provision, it was held that the petition must be denied, the relator not coming within the term "corporation of this state," used in the statute.[44]

§ 177. Names of places of business.

The name of a place where a business is carried on, such as an hotel or store, usually constitutes a valid trade-name. It is immaterial whether the name is original with the adopter and user, or has been previously used in other places sufficiently remote so that no conflict occurs. Thus, there may be a "Washington Hotel" in every city, and the name will constitute a valid trade-name for every one. In many of the decided cases, controversies have arisen in respect to the use of such names in the same locality. Thus, where a proprietor of an hotel opened it under the name of "Irving House," and it very soon became generally known as the "Irving House" and "Irving Hotel," and was kept by him while thus designated, it was held that he had a right to the use of those names, to the exclusion of other persons in the same city or town, and, on their subsequently setting up in the same city an hotel called "Irving Hotel," they were re-

[43] Lehigh Valley Coal Co. v. Hamblen (1885) 23 Fed. 225.
[44] People v. Home Life Assur. Co. (1897) 111 Mich. 405.

strained from the use of that name by injunction.[45] The court said: "We think that the principle of the rule is the same, to whatever subject it may be applied, and that a party will be protected in the use of a name which he has appropriated, and by his skill made valuable, whether the same is upon articles of personal property which he may manufacture, or applied to an 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, providing 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 reason of 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 traveler, 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 goodwill which honestly belongs to him alone." Under the same rule, the words "Columbia,"[46] "What Cheer,"[47] "McCardel House,"[48] "Osborne House,"[49] "Von-

[45] Howard v. Henriques (1851) 3 Sandf. (N. Y.) 725; Cox, Man. Trade-Mark Cas. No. 103.

[46] Whitfield v. Loveless (1893) 64 Official Gaz. 442.

[47] Woodward v. Lazar (1863) 21 Cal. 449.

[48] McCardel v. Peck (1864) 28 How. Pr. (N. Y.) 120.

[49] Hudson v. Osborne (1869) 39 Law J. Ch. 79, 21 Law T. (N. S.) 386.

derbank Hotel,"[50] and "Wood's Hotel"[51] have been protected; the owners of carriages run for hotel guests have been restrained from using the names "Irving House,"[52] "Revere House,"[53] and "Prescott House,"[54] as indicating that such carriages were run in connection with the hotel named; the names "The Saratoga"[55] and "What Cheer"[56] have been sustained as trade-names for restaurants; the terms "New York Dental Rooms,"[57] "United States Dental Association,"[58] and "Colton Dental Rooms"[59] have likewise been sustained as trade-names. The terms "Carriage Bazaar,"[60] "Mechanics' Store,"[61] "The Grosvenor Library,"[62] "The Golden Lion,"[63] and "The Little Shop"[64] have also been protected. But the term "The Antiquarian Book Store"[65] was refused protection, as being merely descriptive, and, where plaintiff and defendant were dealers in ready-made clothing, and had adjoining stores, and plaintiff began to designate his store as "Mammoth Wardrobe," and put up such a sign, and defendant did the same, it was held that the

[50] Wood v. Sands (1875) Cox, Man. Trade-Mark Cas. No. 467.

[51] Vonderbank v. Schmidt (1892) 44 La. Ann. 264.

[52] Stone v. Carlan (1850) Cox, Man. Trade-Mark Cas. No. 104.

[53] Marsh v. Billings (1852) 7 Cush. (Mass.) 322.

[54] Deiz v. Lamb (1866) 6 Rob. (N. Y.) 537.

[55] Dewitt v. Mathey (1896) 18 Ky. Law Rep. 257, 35 S. W. 1113.

[56] Gamble v. Stephenson (1881) 10 Mo. App. 581.

[57] Sanders v. Utt (1884) 16 Mo. App. 322; Sanders v. Jacob (1885) 20 Mo. App. 96.

[58] Cady v. Schultz (1895) 19 R. I. 193.

[59] Colton v. Thomas (1868) 2 Brewst. (Pa.) 308.

[60] Bulnois v. Peake (1868) 13 Ch. Div. 513, note.

[61] Weinstock v. Marks (1895) 109 Cal. 529.

[62] Hoby v. Grosvenor Library Co. (1880) 28 Wkly. Rep. 386.

[63] Walker v. Alley (1867) 18 Grant Ch. 366.

[64] Crawford v. Laus (1899) 29 Misc. Rep. (N. Y.) 248.

[65] Choynski v. Cohen (1870) 39 Cal. 501.

words were only descriptive of the plaintiff's store, and an injunction was denied.[66]

§ 172. Miscellaneous trade-names.

Other instances of trade-names that have come before the courts, and in which injunctions have been granted, are the following: The original establishment and designation of "Christy's Minstrels," it was held, entitled the founder thereof to the protection and benefit of the appellation exclusively.[67] The use of the foreign word "Valet," as a designation for the business of collecting and renovating worn clothing, being shown to be new and peculiar, it was held that a person earliest entitled to use in a city the name "The Brooklyn Valet" may restrain a city competitor in the same business from using the words "My Valet" in his trade and on his signs.[68] The trade-name "Six Little Tailors" was sustained.[69] It was held by the Philadelphia court of common pleas that title to property in the name "Keystone Line," acquired by many years' certain exclusive appropriation and use of it by shippers of merchandise who did not own the vessels employed by them, will be protected in equity.[70]

[66] Gray v. Koch (1871) 2 Mich. N. P. 119.
[67] Christy v. Murphy (1856) 12 How. Pr. (N. Y.) 77.
[68] Cohn v. Reynolds (1898) 26 Misc. Rep. (N. Y.) 473.
[69] Mossler v. Jacobs (1896) 66 Ill. App. 571.
[70] Stetson v. Winsor (1872) 9 Phila. (Pa.) 513. In this case the court said: "Property in the terms, names, and devices of trade and business has become as well established as property in any other matter or thing. It is based upon and controlled by the same general principles to which all property is subjected, and has no laws special to itself. The litigation which springs from it is rather for the decision of facts than for the establishment of peculiar or unknown principles. In a word, it is personal property, and has all the incidents thereof. It is acquired by certain exclusive appropriation, continued use, descent, or purchase, and may be relinquished by gift, sale, or abandonment. Its fraudulent appropria-

§ 179. Trade-name usually follows the business.

A trade-name usually belongs to and follows the business with which it is used, so that a sale of the business carries with it the trade-name by which the business is designated. In a leading New York case it is said: "In other words, the name of the business could be severed from the place where it was transacted, and, while thus separated, could be treated as an object of property, so as to prevent third persons from attaching it to their business, and thus depriving the owners of a legitimate profit which they might reap elsewhere under the same name. It seems plain that, if a banking house had acquired a name, such as that of "Baring Brothers," though there were no partner of the name of Baring, it would, on general principles of law, and independent of a statute preventing the use of fictitions names, have a property in such name, without reference to the particular place where the business was carried on. Though the name might be inseparable from the business, it would be separable from the premises, so that the business might, for example, be carried on on the opposite side of the street."[71]

§ 180. Trade-name affixed to particular building or locality.

A trade-name may be so applied to a particular building or *situs* of a business as to become attached to it and pass with it. This would undoubtedly be true in respect to many hotels, especially where the names used are impersonal. The name refers to the building or *situs*, rather than to the manager or person using it. Thus, where the

tion, though no less reprehensible in morals than the felonious taking of other personal property, has not yet become the subject of investigation and punishment by courts having jurisdiction of crimes. It is this, perhaps, which has made equity eager to arrest the spoliator flagrante delicto by its swiftest and sternest authority."

[71] Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226.

plaintiff, Booth, built, and, for several years thereafter, managed, a theater, and obtained great reputation for it as "Booth's Theater," and executed to another Booth a lease of it, the description containing the words "known as Booth's Theater," and the lessee assigned his lease to the defendants, and where plaintiff also executed two mortgages on the theater as "Booth's Theater," and the title passed to one of the mortgagees by foreclosure as "Booth's Theater," and, pending the foreclosure proceedings, the defendants, by an agreement in writing by order of the court, were accepted as tenants of the property known as "Booth's Theater," and had ever since been carrying on the theatrical business of said theater, designating the same on their hand-bills and bill-boards as "Booth's Theater," and representing themselves as lessees and managers, and the plaintiff asked that defendants be restrained from using the name "Booth" in connection with the theater theretofore known as "Booth's Theater," of which the defendants were lessees, and for damages, it was held that one of the inducements of the lease made by the plaintiff was the public reputation which "Booth's Theater" had acquired as a place of public amusement, and that the defendants, as assignees of said lease, succeeded to all the rights granted thereby. It was held, also, that the plaintiff, by his acts, had fixed his name to the theater so that his vendees and successors had a right to call this theater "Booth's Theater," the name which he had given it.[72] So, also, where plaintiff transacted the clothing business from 1871 to 1877 at 150 West Market street, Louisville, Ky., as lessee of the building, which, during the time he occupied it, was known as "Tower Palace," these words being placed upon a large and conspicuous open sign, supported by a structure, upon the

[72] Booth v. Jarrett (1876) 52 How. Pr. (N. Y.) 169.

top of the building, called "The Tower," and in 1877 appellant removed to a house on Jefferson street, where he carried on the same business. Defendants afterwards became occupants of the building, and in advertising their business indicated the place where it was carried on as "Tower Palace, No. 150 West Market Street." Plaintiffs sought to compel defendants to remove from the building the sign "Tower Palace," and to enjoin defendants from appropriating or using this term by advertising or otherwise. The court held, however, that the name "Tower Palace" was adopted and used by plaintiff and understood and recognized by his customers as a particular and appropriate designation and description of the house, and not of the business that plaintiff carried on there. The court quoted the following from an opinion of Justice Matthews:[73] "When the trade-mark consists merely in the name of the establishment itself where the manufacture is carried on, and becomes attached to the manufactured article only as the product of that particular establishment, a sale of the establishment will carry with it to the purchaser the exclusive right to use the name it had previously acquired in connection with his own manufacture, at the same place, of a similar article, by operation of law." The court also said: "We do not assent to the proposition that a tenant has the right to apply a name to a building without the consent of the owner, nor that a name which is intended to be and is descriptive of the place, as distinguished from the name adopted as a trade-mark, and applied to the particular business carried on there, can, at the pleasure of the tenant, be made to change its original signification, and applied to another and distinct place."[74]

[73] Pepper v. Labrot (1881) 8 Fed. 29.

[74] Armstrong v. Kleinhans (1884) 82 Ky. 303.

In a case before the New York commission of appeals, the trade-name, "No. 10 South Water Street, Rochester, N. Y.," was involved. The justice, at the trial, found the following facts: "Joseph Hall established, more than thirty years before the trial, on South Water street, in the city of Rochester, a manufactory for the construction of threshing machines. The business was carried on extensively until his death, in 1865. His establishment was known for many years as 'Number 10 South Water Street.' The defendant, Charles S. Hall, purchased the establishment from the executors of Joseph Hall, together with 'the tools, patterns, and fixtures,' in May, 1868, and took possession of the same in February, 1869, since which time he has carried on the same business at the same place. In April he printed in his hand-bills, and adopted as his trade-mark, the words 'The Old Joseph Hall Agricultural Works, No. 10 South Water Street, Rochester, N. Y.,' and continued to use such trade-mark until restrained by the injunction granted in the action. In September or October, 1869, the plaintiff rented a small office on South Water street, a short distance from the defendant's place of business, and painted the number on it, and also printed the number on its bills and on its sign, in the following terms: 'The Glen & Hall Manufacturing Company, No. 10 South Water Street, Rochester, New York.' At this time the plaintiff was carrying on the same business as the defendant. Its shops were located in the town of Brighton, two miles and more from the shops of the defendant. It took the office in South Water street and adopted the number (10) with the intention of interfering with the defendant's business, and unfairly securing his customers." On these findings, the judge reached the conclusion of law that "Number 10," at the time of the purchase, in April, 1869, and since, was a material part of

the defendant's trade-mark; that he was entitled to compensation for damages occasioned by his being restrained from using it, as well as to those sustained by reason of the plaintiff's use, and also in a perpetual injunction restraining the plaintiff from using said number as its trade-mark, or keeping the same on its office or building in South Water street, or using it in any way in imitation of the defendant's trade-mark. A motion for a new trial was granted by the general term, but, on appeal, this order was reversed, and the decision of the special term affirmed. In the decision of the justice at the special term, the phrase "No. 10 South Water Street" was regarded as a trade-mark. On appeal, however, this term was not regarded as a technical trade-mark, but was protected on principles analogous to those which are applied to trade-marks. In the opinion of Dwight, C., after quoting the definition of "trade-mark," and the application of trade-marks to natural products, it is said: "In the case at bar there was no product of industry or of nature. The trade-mark, if it existed at all, was attached to the building or works in which the products of human labor were made. This fact does not affect the application of the principle set forth in the Congress Spring Case. It is still true that the purchaser of an article manufactured at 'No. 10 South Water Street' has a right to have the very thing which he seeks, and the owner of the goods there manufactured has the right that the very thing sought shall be sold for his profit. * * * It would follow, from these principles, that, if a person had established a business at a particular place, from which he has derived or may derive profit, and has attached to that business a name indicating to the public where or in what manner it is carried on, he has acquired a property in the name which will be protected from invasion by a court of

equity, on principles analogous to those which are applied in case of the invasion of a trade-mark."[75]

§ 181. Trade-name personal to an individual.

A trade-name that is strictly personal can be used only by the person whom it designates. This rule arises from the fact that courts will not protect the use of a trade-name that will in any way deceive the public as to the manufacturer of the goods, or as to the proprietor of the business. This is particularly true in those cases in which personal skill is required of the manufacturer of the goods, or of the proprietor or conductor of the business. In some instances the courts have gone to extremes in the application of this rule. Thus, in the case of Howe v. Searing,[76] where the plaintiff sold to the defendant's assignor his lease of the premises known by the

[75] Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226.

[76] (1860) 19 How. Pr. (N. Y.) 14. There was a very strong dissenting opinion by Justice Moncrief in this case, in which it is said: "The plaintiff adopted, appropriated, and used the words or name 'Howe's Bakery,' and by that name his establishment became known and was extensively patronized, and was a thing having specific value. The plaintiff so avers in his complaint. * * * 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. * * * The name 'Howe' had a living, physical existence to support it. It was not, therefore, fictitious. The name 'Howe' required nothing to sustain it. As a trade-mark, it is immaterial whether it is the name of animate or inanimate creation, or the purest effort of fancy on the part of its originator. Possibly the more original in its character, the better would be the protection afforded to it, the nearer it approaches to the right to be patented. The plaintiff cannot avail himself of the statute, even if it did apply. Having agreed to dispose and actually conveying the thing alleged to be prohibited, it does not lie with him to complain of his own violation of law, or a fraudulent representation to his vendee."

name of "Howe's Bakery," and stock in trade, with "the goodwill of the business of baking, now or heretofore carried on by me in the city of New York," and where defendant's assignor and defendant carried on the business at the same place under the name "Howe's Bakery," and where the plaintiff, Howe, afterwards returned to the business, and brought suit to restrain the defendant from designating the bakery establishment kept by him as "Howe's Bakery," and from otherwise using the name of "Howe" in the business, it was held that the plaintiff was entitled to an injunction, the court finding that the use of Howe's name by the defendant was calculated to mislead the public, and had induced persons to deal at the defendant's bakery under the supposition that they were dealing with Howe, who would otherwise have dealt at Howe's place. The court, however, rested its decision on a New York statute which provided that "no person shall hereafter transact business in the name of a partner [*quaere*, person] not interested in his firm," holding that the principle and object of this statute extended to the case before it. In another case it appeared that one Ethel Atwood organized and employed a band of musicians, called "The Fadette Ladies' Orchestra," and hired and paid the members of it, and afterwards sold to plaintiff all her right, title, and interest in and to the organization known as "The Fadette Ladies' Orchestra," together with all rights acquired in and to the establishment, name, and trade-mark in the words "The Fadette Ladies' Orchestra," and then ceased to have any connection with the company, the other members of the orchestra not being parties to the contract, and not agreeing to continue to play under the direction or management of the plaintiff. At the time of the sale, and for a short time thereafter, the orchestra was composed of substantially the same member-

ship as before the sale. Subsequently, a number of those composing the orchestra left it, and organized an association under the name of "The Fadettes," which association duly became a corporation, and thereafter gave musical concerts, and used in advertising such concerts, as well as in holding itself out for engagements, the name "The Fadette Ladies' Orchestra." The plaintiff filed a bill to enjoin the defendant organization from using the name "Fadette." At the time the bill was filed, no member of the original organization except the plaintiff remained. The court said: "The question is whether the plaintiff acquired a right in the trade-mark or trade-name which she can enforce by way of injunction against the defendant corporation, some of the members of which were members of the original corporation. It is very clear that this question must be answered in the negative. So far as Ethel Atwood had any right or ownership in the trade-name which designated the organization under her management, it was personal to herself, depending upon her personal reputation and skill, and it was not assignable. The other musicians employed by her could not, by her contract of sale, be put in the control of any other person, and there was nothing in her relation to them that she could convey. The case is not like those in which there is a sale of fixed property, and a local business to which the name belongs, and whose principal features remain unchanged after the sale. If the use by the plaintiff of the name 'Fadette Ladies' Orchestra' would have any influence beneficial to herself upon the public who wished to procure the services of such an organization, it would be only to mislead and defraud them by implying that she and such musicians as she employed were the same persons who had formerly gained a good reputation under this name. It is well settled that the courts will not

enforce a claim of this kind which contains a misrepresentation to the public."[77]

§ 182. Elements of unfair competition usually present in trade-name cases.

In nearly all trade-name cases, even more than in trade-mark cases, elements of unfair competition are present. Usually, when a person adopts a trade-name closely resembling a name already in use, it is done for the purpose of diverting a part of the first user's business or patronage. If this is so, it will usually be made apparent to the court, and the case then becomes one of unfair competition. It will then be immaterial whether the name used is capable of exclusive appropriation or not. In many of the cases cited in this chapter, elements of unfair competition have been present.

[77] Messer v. The Fadettes (1897) 168 Mass. 140. In this case there was also a very able dissenting opinion by Lathrop, J., in which it is said: "It [the majority opinion] proceeds upon the ground that the name adopted by Ethel Atwood for the orchestra organized by her was not assignable, for the reason that it was personal to herself, and depended on her personal reputation and skill. The court below has found that the success of the orchestra 'was due to the ability, skill, and personal supervision of said Atwood.' It follows then, if the decision of the majority of the court is correct, that, if a business is conducted under a trade-name, the more the ability, skill, and personal supervision of the owner of the business conduces to its success, the less is the trade-name assignable with the business. I think this is not in accordance with sound principles or with the authorities. * * * In the case at bar I see no reason why the plaintiff was not entitled to have the trade-name of the orchestra protected. Such a name is clearly, to my mind, assignable. It also seems to me that the defendants, being merely employes of the plaintiff and of her predecessor in title, could not, by leaving, acquire the right to use the name under which they had before performed, or any name so similar as to deceive the public. It is not a case concerning the right of the majority of an association to the name, for here the name was invented by Atwood, and the defendants were hired by her."

CHAPTER IX.

INFRINGEMENT.

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205. Instances of Infringement.
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§ 183. Classes of infringement.

In the light of the decisions upon the subject, infringement in trade may be defined as the aggression by one business party upon another's rights, in business, in one of three ways: First, the unauthorized use of such other's trade-mark or

trade-name; second, the unauthorized simulation of such other's trade-mark or trade-name; third, the unauthorized use or simulation of such other's business methods or business symbols, in which such other does not, or cannot legally, claim any exclusive right, as he can do in a trade-mark or trade-name. Either the first or the second infringement is legally complete without fraudulent intent upon the part of the infringer; and such intent is not a necessary element of proof in legally establishing the infringement, though fraud upon the part of the infringer may, and often does, exist in either case, particularly the second. The reason that fraud is not a necessary element in either of these two cases is because a trade-mark or a trade-name is a "property right," which may be invaded or encroached upon without any intention to do so, and even ignorantly or by accident. The third infringement "sounds in fraud,"—cannot exist without it,—and a fraudulent intent upon the part of the infringer must be directly proven, or be legally inferable from the evidence, to legally establish the infringement, which, when so established, is designated by the courts, "unfair competition."

§ 184. Infringements of the first class.

In cases of infringement of the first class, three questions must be determined against the alleged infringer to establish a right of action in the claimant: First, that the right to the exclusive use of the mark or name in question existed in the claimant at the time of the alleged infringement;[1] second, that the alleged infringer used such mark or name;[2] third, that such use was unauthorized. It is evident that the

[1] As to what constitutes a valid trade-mark or trade-name, see chapter 1.

[2] Taendsticksfabriks Akticbolagat Vulcan v. Myers (1893) 139 N. Y. 364, 368, citing Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51.

first question is the important one in this class, for the other two depend upon it, and in most cases are of easy proof, if not apparent from the pleadings. In this class, also, the alleged infringement, when not the result of ignorance or accident upon the part of the infringer, may be under claim of right by him, based upon the following grounds: First, that, at the time of the alleged infringement, such right of exclusive use in the plaintiff had ceased to exist from abandonment [3] or dedication,[4] or, second, that the plaintiff could not claim the protection of the court [5] because of his own fraudulent use of such right.[6] All these matters must be settled adversely to the alleged infringer before a permanent injunction will be allowed or damages adjudged against him.[7] In other parts of this work, many of these questions and the method of their determination are fully treated.

§ 185. Infringements of the second class.

In cases of infringements of the second class, three questions also must be determined against the alleged infringer before the right of action is established: First, that the right to the exclusive use of the mark or name in question existed in the claimant at the time of the alleged infringement;[8] second,

[3] As to abandonment of a trade-mark or trade-name, see chapter v.

[4] As to cessation of right of trade-mark or trade-name, see chapter v.

[5] As to effect of fraudulent use of trade-mark or trade-name, see chapter xiii.

[6] New York Consolidated Card Co. v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611, 612.

[7] Calladay v. Baird (1860) 4 Phila. (Pa.) 139; McCardel v. Peck (1864) 28 How. Pr. (N. Y.) 120.

[8] Taendsticksfabriks Aktiebolagat Vulcan v. Myers (1893) 139 N. Y. 364, 368, citing Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; New York Consolidated Card Co. v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611, 612.

that the alleged infringer simulated such mark or name;[9] third, that such simulation was unauthorized. But in this class it is evident that not the first, but the second, may be the important question, for the reason that the purpose of the simulation may be to obtain for the alleged infringer all possible benefits and advantages which would otherwise accrue to the claimant from such exclusive right, and the reputation of the trade-mark or trade-name as such. The greater and more extended this reputation, the greater will be the benefits and advantages thus wrongly obtained, and hence it is unlikely that, in any case, the alleged infringer will attack, or try in any way to lessen, that reputation, which will be the direct result of his attack upon such right of exclusive use in the party claiming the mark. The policy of the alleged infringer will usually be involved in this second question,—that of the simulation,—and his effort will usually be to make that as complete as possible without subjecting himself to the charge of infringement, and upon the success of this effort will depend the beneficial results or gains to himself. And if any grounds, such as are mentioned in section 184, in regard to the first class of infringement, exist for attack upon such right of exclusive use in the party claiming the mark, the alleged infringer will not be likely to "simulate," but will "use" the mark or name in question, and thus bring the case within the first class. Since most of the cases in this second class are tinctured with fraud, the third question—that of authority—may not arise, or may be settled by the determination of the question of fraudulent simulation; and in the few cases of this class wherein fraud does not enter, the question of authority may be settled by the pleadings, or, if at issue, will require but little proof for its determination. In this second class, as well,

[9] Calladay v. Baird (1860) 4 Phila. (Pa.) 139.

must the foregoing questions be fully determined adversely to the alleged infringer before the court will allow permanent injunction or judgment against him.

§ 186. Infringements of the third class, or unfair competition.

The whole matter of infringements of the third class, viz., unfair competition, is treated fully in the following chapter of this work, and therefore this chapter will be confined substantially to infringements of the first and of the second class.

§ 187. General rule as to infringement.

The general rule as to infringement of trade-marks and trade-names is that, as one person has no right to put off his goods for sale as those of another, he cannot be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods he is selling are the manufacture of another person.[10] Competition between manufacturers or vendors is favored by the courts, as being of benefit to the public, but competition must be fair. Rivals in trade must not resort to fraudulent or unfair means to sell their wares. They must not make use of the trade-marks or trade-names of others, or any simulation thereof, to mislead the purchasing public as to the true source and origin of such wares. Every suit for infringement of a trade-mark or trade-name is founded on the fact that the action, or the proposed action, of the defendant has deceived, or is calculated to deceive, purchasers, so that they have purchased, or will probably purchase, the goods of the defendant, under the mistaken belief that they are those of the complainant, to the damage of the latter. This deceit, or probable deceit, of the purchaser,

[10] Perry v. Truefitt (1842) 6 Beav. 66; McCann v. Anthony (1886) 21 Mo. App. 83; Reddaway v. Banham (1896) 65 Law J. Q. B. Div. 381.

to such an extent that he buys, or will probably buy, the goods of one manufacturer or vendor, in the belief that they are those of another, is the *sine qua non* of every action for infringement. A wrong done or threatened, and consequent injury or probable injury to the complainant, are indispensable elements of every such cause of action. The mere intention to injure another, if no injury is done, or none ever will be done, constitutes no ground of relief. This intention must be coupled with some act that results, or is likely to result, in injury to another.[11] On the other hand, as a person is supposed to intend the natural result of his actions, if he adopts another's trade-mark or trade-name, or enters upon a line of action, the natural or probable result of which will be to deceive intending purchasers as to the origin of wares manufactured or sold by him, it will be immaterial what his real intentions were.[12] The legal wrong in these cases is in supplanting the genuine article by a spurious one,[13] and the gist of the action is that the defendant sold, as and for the manufacture of the plaintiff, something that was not the plaintiff's manufacture, and that the spurious trade-mark was put on to facilitate the fraudulent sale.[14] The true doctrine in these cases has been said to be "that no one should be permitted to so dress his goods or wares as to enable him to induce purchasers to believe that they are the goods of another."[15] In all cases where rights to the exclusive use of a trade-mark are invaded, the essence of the wrong consists

[11] Kann v. Diamond Steel Co. (1898) 32 C. C. A. 324, 89 Fed. 706.

[12] El Modello Cigar Mfg. Co. v. Gato (1889) 25 Fla. 886; Saxlehner v. Apollinaris (1897) 66 Law J. Ch. Div. 533.

[13] Miller Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18.

[14] Bloete v. Simon (1887) 19 Abb. N. C. (N. Y.) 88.

[15] New York Cab Co. v. Mooney (1884) 15 Abb. N. C. (N. Y.) 152; Edelston v. Vick (1853) 23 Eng. Law & Eq. 51; Williams v. Spence

in the sale of goods of one manufacturer or vendor as those of another.[16] Positive proof of fraudulent intent is not required when the proof of infringement is clear, as the liability of the infringer arises from the fact that he is enabled to sell a simulated article as and for the one which is genuine.[17] Courts of equity have uniformly condemned the imitation of distinctive marks by which a manufacturer has chosen to distinguish his goods, when it is done for the purpose of deceiving the public, and advancing the business of one who would appropriate to himself the advantages secured through the successful enterprise and diligence of another.[18] A person will be restrained, by injunction, from using the same trade-mark which has been previously used by another, and from any imitation of it with only colorable differences. An imitation of the trade-mark of a dealer with partial differences, such as the public would not observe, does him the same harm as an entire counterfeit, and will be enjoined accordingly.[19] Where the trade-mark consists of a word, it may be used by the manufacturer who has appropriated it, in any style of print, or on any form of label, and its use by another in any form is unlawful. In such case, as the goods become known by the name or word by which they have

(1863) 25 How. Pr. (N. Y.) 366; Lea v. Wolf (1872) 13 Abb. Pr. (N. S.; N. Y.) 389; Kinney v. Basch (1877) 16 Am. Law Reg. (N. S.) 597; Abbott v. Bakers' & Confectioners' Tea Ass'n (1872) 7 Wkly. Notes Cas. 31.

[16] Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322.

[17] Le Page Co. v. Russia Cement Co. (1892) 2 C. C. A. 555, 51 Fed. 941.

[18] Fleischmann v. Schuckmann (1881) 62 How. Pr. (N. Y.) 92; Thornton v. Crowley (1881) 15 Jones & S. (N. Y.) 527; Avery v. Meikle (1883) 81 Ky. 73.

[19] Clark v. Clark (1857) 25 Barb. (N. Y.) 76; Williams v. Johnson (1857) 2 Bosw. (N. Y.) 1; Colton v. Thomas (1868) 2 Brewst. (Pa.) 308.

been designated, and not merely by the manner or fashion in which the word is written or printed, or the accessories surrounding it, the unlawful use of the word in any form may be restrained.[20] An action to recover damages for violating a trade-mark will lie, although, at the time the article was sold by the defendant, the plaintiff employed another mark, and had ceased to use the one imitated. The wrong and injury to the plaintiff consist in the sale of an article falsely purporting and declared to be of his manufacture, whether the deceit be counterfeiting his present trade-mark, or one formerly used by him.[21] When, in trade-mark cases, the power of the court is invoked, it is to restrain the defendant from making goods and selling them as and for goods manufactured or sold by the plaintiff, on the ground that such act works an injury to the plaintiff, and tends to mislead and deceive the public.[22]

[20] Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369, 375; Hier v. Abrahams (1880) 82 N. Y. 519.

[21] Lemoine v. Ganton (1854) 2 E. D. Smith (N. Y.) 343.

[22] Samuel v. Buger (1856) 13 How. Pr. (N. Y.) 342.

In Powell v. Birmingham Vinegar Brewing Co. (1896) 65 Law J. Ch. Div. 563-571, Kay, L. J.: "The law relating to this subject may be stated in a few propositions: First. It is unlawful for a trader to pass off his goods as the goods of another. Secondly, if this is done innocently, it will be restrained. Millington v. Fox, 3 Mylne & C. 338. Thirdly. *A fortiori* if done designedly, for that is a fraud. Fourthly. Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal. Sykes v. Sykes, 3 Law J. K. B. (O. S.) 46, 3 Barn. & C. 541. Fifthly. One apparent exception is that, where a man has been describing his goods by his own name, another man, having the same name, cannot be prevented from using it, though it may have the effect of deceiving purchasers. Burgess v. Burgess, 22 Law J. Ch. 675, 3 De Gex, M. & G. 896, and Turton v. Turton, 58 Law J. Ch. Div. 677, 42 Ch. Div. 128. Sixthly. But this exception does not go far. A man may so use his own name as to infringe the rule of law. 'It is a question of evi-

§ 188. Resemblance necessary to constitute infringement.

No fixed rule can be laid down as to the degree of resemblance necessary to constitute an infringement of a trade-mark or trade-name. In determining this question, regard must be had to all the circumstances of each case. The class of people who buy the goods, or deal with the parties, and the place where the goods are usually exposed for sale, must be considered. If the resemblance is sufficiently close to deceive a person buying in the usual way, and using ordinary caution, and cause him to purchase the goods of one manufacturer as and for the goods of another, there is an infringement.[23] The supreme court of the United States has said:

dence in such case whether there is false representation or not.' Per Lord Justice Turner, in Burgess v. Burgess, supra. So he may be restrained if he associates another man with him, so that, under their joint names, he may pass off goods as the goods of another firm. Croft v. Day, 7 Beav. 84; Clayton v. Day, 26 Sol. J. 43, and Melachrino v. Melachrino Egyptian Cigarette Co., 4 Pat. Rep. 215. Seventhly. Another apparent exception is where a man has, under a patent, had a monopoly for fourteen years, and has given the article a descriptive name, he cannot, when the patent has expired, prevent another selling it under that name. Young v. Macrae, 9 Jur. (N. S.) 322, and Linoleum Mfg. Co. v. Nairn, 47 Law J. Ch. 430; Id., 7 Ch. Div. 834. Eighthly. I am not sure if this would be so if the name so used were the name of the patentee, or even a purely fanciful name, not descriptive. Ninthly. Certainly, where there has not been a patent, and an article has been made and sold under a principal name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article, made by him. Braham v. Bustard, 1 Hen. & M. 447, and Cochrane v. McNish, 65 Law J. P. C. 20; Id. [1896] App. Cas. 225. In this last proposition there is again a limitation. If the first maker has slept upon his rights, and allowed the name to be used by others, until it has become publici juris, the court will not interfere."

[23] Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 63; Wotherspoon v. Currie (1872) L. R. 5 H. L. 519; Improved Fig Syrup Co. v. California Fig Syrup Co. (1893) 54 Fed. 175; Celluloid Mfg. Co.

"Two trade-marks are substantially the same in legal contemplation if the resemblance is such as to deceive an ordinary

v. Cellonite Mfg. Co. (1887) 32 Fed. 94; Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823; Rowley v. Houghton (1868) 2 Brewst. (Pa.) 303, 7 Phila. (Pa.) 39; Bradley v. Norton (1865) 33 Conn. 157; Swift v. Dey (1865) 4 Robt. (N. Y.) 611; Filley v. Fassett (1869) 44 Mo. 168; Hostetter v. Vowinkle (1871) 1 Dill. 329, Fed. Cas. No. 6,714; Burke v. Cassin (1873) 45 Cal. 467; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 80 Fed. 105; N. K. Fairbank Co. v. Swift & Co. (1896) 64 Ill. App. 477; Consolidated Fruit Jar Co. v. Thomas (1879) 2 N. J. Law J. 272, Fed. Cas. No. 3,131; Sperry v. Percival Milling Co. (1889) 81 Cal. 252; Shaver v. Shaver (1880) 54 Iowa, 208; Orr v. Johnston (1880) 13 Ch. Div. 434; Johnston v. Orr Ewing (1882) 7 App. Cas. 219; Thornton v. Crowley (1881) 47 N. Y. Super. Ct. 527; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Wirtz v. Eagle Bottling Co. (1892) 50 N. J. Eq. 164; Drummond Tobacco Co. v. Addison Tinsley Tobacco Co. (1892) 52 Mo. App. 10; Cuervo v. Landauer (1894) 63 Fed. 1003; Powell v. Birmingham Vinegar Brewing Co. (1896) 65 Law J. Ch. Div. 563; Liggett & Myers Tobacco Co. v. Hynes (1884) 20 Fed. 883; Sohl v. Geisendorf (1871) 1 Wils. (Ind.) 60; Mossler v. Jacobs (1896) 66 Ill. App. 571; Williams v. Johnson (1857) 2 Bosw. (N. Y.) 1.

In McLean v. Fleming (1877) 96 U. S. 245, Clifford, J.: "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers, buying with ordinary caution, are likely to be misled."

In Solis Cigar Co. v. Pozo (1891) 16 Colo. 388, Bissell, C.: "Exact similarity is not necessary. To insist on that would be to permit most wrongdoers to evade responsibility. Colorable imitations are as much the subject of legal redress as the more exact and perfect similitudes. What is necessary in all cases is a similarity which will operate to convey a false impression to the ordinary purchaser, and serve to deceive and mislead him. The rule is grounded as much on the notion that the public is to be protected as on the theory that the inventor may have the exclusive benefit of the reputation acquired by the thing which he has produced. For this reason, it is always essential to show that the invention is of a char-

purchaser, giving such attention to the same as such a purchaser usually gives, and to cause him to purchase the one,

acter to escape the ordinary caution used in the purchase of the articles protected."

In Potter v. McPherson (1880) 21 Hun (N. Y.) 559, 566, Daniels, J.: "In order to render it necessary that a publication or imitation of this nature should be restrained, it is sufficient that persons who may desire to purchase the plaintiff's publication might very well accept that of the defendants, supposing and believing it to be the same. That the difference might be readily detected by a comparison of one book with the other is not sufficient to allow the defendants to appropriate and use the plaintiff's title. If, in its use, persons under ordinary circumstances, desiring to purchase one, would receive the other in its place, believing they had obtained the work intended to be bought, that will not only justify but require the court to interfere, for the purpose of preventing the use of plaintiff's title."

In Rubel v. Allegretti Chocolate Cream Co. (1898) 76 Ill. App. 581, 589, Horton, J.: "In order to authorize the interference of chancery, it is not necessary that a trade-mark should be copied with the fullest accuracy. An imitation which varies from the original in some particular, may be restrained * * * if the imitation is calculated to deceive, and may be taken for the original."

In McCartney v. Garnhart (1870) 45 Mo. 593, 595, Currier, J.: "To justify an injunction [against a defendant from the use of a certain brand as an alleged counterfeit or imitation of that of plaintiff], * * * it should at least appear that the resemblance between the two brands was sufficiently close to raise the probability of mistake on the part of the public, or design and purpose to mislead and deceive on the part of the defendant."

In Swift v. Dey (1865) 4 Robt. (N. Y.) 611, 612, Robertson, Ch. J.: "The proper question should be, not differences, but points of resemblance; not the utmost vigilance of purchasers, but ordinary observation. The value of the goods to be sold, and the intelligence of the persons dealing in and consuming them, besides other circumstances, are also to be taken into account in determining the adaptability of a simulated trade-mark to deceive purchasers."

In McCann v. Anthony (1886) 21 Mo. App. 83-90, Thompson, J.: "It is not necessary that the trade-mark, trade-name, sign, label, or other device which is employed by one merchant for that purpose

supposing it to be other."[24] And also that, "where the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the shall be an exact imitation or counterfeit of the trade-mark, trade-name, sign, label, or other device employed by the other manufacturer. Nor is it required that the imitation be so close as to deceive cautious and prudent persons. It is sufficient that it be so close as to deceive the incautious and unwary, and thereby work substantial injury to the other manufacturer."

In Blackwell v. Wright (1875) 73 N. C. 310, 313, Bynum, J., said that one who asks, upon general principles of equity, independent of statutes, to have an infringement of his trade-mark enjoined, "must show not only that he has a clear legal right to the trade-mark, but that there has been a plain violation of it; and where a violation is alleged, the true inquiry is whether the mark of the defendant is so assimilated to that of the plaintiff as to deceive purchasers. And it will make no difference whether the party designed to mislead the public, or whether the symbol adopted was calculated to deceive. If it appear that the trade-mark alleged to be imitated, though resembling the complainant's in some respects, would not probably deceive the ordinary mass of purchasers, an injunction will not be granted. An imitation is colorable, and will be enjoined, which requires a careful inspection, to distinguish its mark and appearance from that of the manufacture imitated."

In Liggett & Myer Tobacco Co. v. Hynes (1884) 20 Fed. 883, 885, Parker, J.: "In looking at the trade-mark to see whether it is so far an imitation of another as to deceive ordinary customers exercising ordinary care when purchasing, we must not look at the device alone, but we must also examine the article upon which it is placed, and, if there is a resemblance in it to another article bearing the same trade-mark that is claimed to have been infringed, and if this resemblance, when blended with the appearance of the device, has a tendency to deceive the ordinary public into the belief that they are buying the other article, then the very nature of the article becomes potential evidence in the case to show a purpose to deceive."

In Johnson v. Bauer (1897) 27 C. C. A. 374, 376, 82 Fed. 662, 663, Jenkins, Cir. J.: "The imitation need only be slight, if it attaches

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[24] McLean v. Fleming (1877) 96 U. S. 256, citing Gorham v. White (1871) 14 Wall. (U. S.) 511.

ordinary purchaser, in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right to redress."[26] This court has also held that the resemblance need not be such as would deceive experts or persons who, because of their peculiar knowledge from their being wholesale or retail dealers, or in any other way, are especially conversant with the trade-mark simulated.[26] Hence, to constitute an infringement, exact similarity is not required. The resemblance need not be so close as to deceive persons seeing the two marks placed side by side. It is sufficient if it is apparent or manifest to the court that the infringing mark bears such a resemblance to the genuine as to be calculated to mislead the public generally.[27] If a purchaser, looking at

to what is most salient, for the usual inattention of a purchaser renders a goodwill precarious if exposed to imposition."

In Mossler v. Jacobs (1896) 66 Ill. App. 571, 575, Waterman, J.: "The court [of equity] is not bound to interfere where ordinary attention will enable a purchaser to discriminate between the trademarks used on goods manufactured by different parties; nevertheless, the character of the article, the use to which it is put, and the kind of people who are likely to ask for it, as well as the manner in which it is probable it will be ordered, must not be lost sight of."

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[25] McLean v. Fleming (1877) 96 U. S. 255.

[26] Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 64.

In Avery v. Meikle (1887) 85 Ky. 435-445, Pryor, C. J.: "This court said: 'By skillful 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 efficiency to distinguish appellants' plows from all others.' Avery v. Meikle & Co., 81 Ky. 113. * * * The trade-mark is his [appellant's] property, the manufacture the result of his skill; and where one undertakes, by coloring, painting, and so arranging his manufacture as enables him to virtually destroy the trade-mark of another, and to sell his own as the product of the skill of the real inventor, it is as much a violation of the right of property in the trade-mark as if the trade-mark itself had been used."

[27] Liggett & Myer Tobacco Co. v. Hynes (1884) 20 Fed. 883; Sohl v. Geisendorf (1871) 1 Wils. (Ind.) 60.

the article offered to him, would naturally be led, from the mark impressed on it, to suppose it to be the production of another, and would purchase it in that belief, it is an infringement. Nor is the actual physical resemblance of the two marks the only consideration. If the goods of one manufacturer have, from the mark or device he has used, become known on the market by a particular name, the adoption by another of any mark that will cause his goods to bear the same name in the market may be as much an infringement as an actual copy of the mark.[28] An injunction ought therefore to be granted whenever the design, apparent or proved, of a person who imitates a trade-mark, 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; and an injunction must be granted whenever the public is in fact misled, whether intentionally or otherwise, by the adoption of marks or symbols, which the party who first employed them had a right to appropriate, for the reason that, when a right of property has been thus acquired, it must be protected.[29] In order to constitute an infringement, however, there must be, between the genuine and fictitious marks, some general similarity or resemblance of form, color, symbols, designs, and such identity of words and their arrangement, as to have a direct tendency of misleading buyers who exercise the usual amount of prudence and caution, and there will usually be found, in all infringement cases, such a distinctive individuality in the mark employed by the counterfeiter as to procure for him the ben-

[28] Seixo v. Provezende (1865) 1 Ch. App. 192; Hier v. Abrahams (1880) 82 N. Y. 519.

[29] Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; New York Cab Co. v. Mooney (1884) 15 Abb. N. C. (N. Y.) 152; McCann v. Anthony (1886) 21 Mo. App. 83.

efit of the deception resulting from the general resemblance between the genuine and counterfeit trade-marks.[30]

§ 189. Cases holding similarity must amount to false representation.

In the early case of Partridge v. Menck,[31] decided in 1845 by Vice-Chancellor Sandford, it was said: "Now, although the court will hold any imitation colorable which requires a careful inspection to distinguish its marks and appearance from those of the manufacture imitated, it is certainly not bound to interfere, where ordinary attention will enable a purchaser to discriminate. It does not suffice to show that persons incapable of reading the labels might be deceived by the resemblance. It must appear that the ordinary mass of purchasers, paying that attention which such persons usually do in buying the article in question, would probably be deceived." This case and that of Merrimack Mfg. Co. v. Garner were criticised by Judge Allison, of the court of common pleas of Philadelphia, delivering the opinion of the court, in 1868, in the case of Colton v. Thomas,[32] in the following language: "I am aware that the general doctrine upon which courts of equity are asked to interpose in cases of this kind has been somewhat shaken by the case of Partridge v. Menck, 2 Sandf. Ch. (N. Y.) 622, and cases which have followed in its lead. The doctrine of Partridge v. Menck is that courts of equity will not interfere, by way of injunction, where ordinary attention will enable a purchaser to discriminate between the marks or symbols employed, but it is clear that the current of authority is very decidedly against the

[30] Calladay v. Baird (1860) 4 Phila. (Pa.) 139; Rowley v. Houghton (1868) 2 Brewst. (Pa.) 303.

[31] (1847) 2 Sandf. Ch. (N. Y.) 622.

[32] (1868) 2 Brewst. (Pa.) 308.

doctrine of Vice-Chancellor Sandford, because it holds out a premium and encouragement to the cunning and crafty to exercise their ingenuity to accomplish, by a cheat, skillfully executed, that which they would not be allowed to do by a direct and undisguised piracy. How much better does the doctrine harmonize with the principles of honesty and fair dealing, that wherever, upon the face of the label or symbol or sign or name, there is a plain and manifest design to make the counterfeit appear in the eye of the public to be that which it is not, the probable and natural result of which must be to appropriate, by this means, to the maker of the counterfeit, the benefit or profit which belongs to the true owner of a trade-mark, that in such case preventive justice will not be invoked in vain. It matters little to the rightful owner of property of this description whether the public is cautious or incautious, if, by a simulation, he is deprived of his just gains; and the error of Partridge v. Menck and Merrimack Mfg. Co. v. Garner[33] consists of an improper application of the rule of cautious examination as to the person against whom the injury is done. It might be well to reply, in an action for damages against the vendor of merchandise by a purchaser thus imposed on, 'Your eyes are your market; why do you not examine with carefulness, and you would not have been deceived?' But it is difficult to ascertain, upon principle, why another party, who is injured by such deception, who was not present to protect himself, should be without remedy because an imposition had, with skill, been practiced, to his loss, by an imitation or simulation of his trade-mark. We prefer rather to hold to the older and higher toned and better fortified doctrine of the law."

In the next year, in the same court, Judge Paxson, in

[33] (1855) 4 E. D. Smith (N. Y.) 387.

the case of Dixon Crucible Co. v. Guggenheim,[34] quoted the following with approval from Upton on Trade-Marks:[35] "That a similarity between two trade-marks, used by different manufacturers for their goods, although of such a character as to induce a belief in the mind of the public that they belong to and designate the goods of the same manufacturer or trader, is not of itself sufficient ground for a prohibition of the use of such trade-mark by him who did not first adopt it. That similarity, to entitle the originator to the protection of the law, must be such as to amount to a false representation, not alone that the two articles have the same origin, but that the goods to which the simulated mark is attached are the manufacture of him who first appropriated the trade-mark." This statement was adopted by the supreme court of Illinois in the case of Candee v. Deere,[36] also decided in 1870, and by the court of appeals of New York in 1876 in Popham v. Cole,[37] this court adding that the maxim, "*Vigilantibus non dormientibus leges subserviunt.*" is applied to such cases. It was also adopted by the court of appeals of New York in Hier v. Abrahams,[38] decided in 1880. It was quoted with approval by the supreme court of New York in Electro-Silicon Co. v. Hazard, in 1883.[39] More than twenty years after laying down this rule, Judge Paxson, sitting upon the supreme bench of the state of Pennsylvania, and delivering the opinion of the court in Heinz v. Lutz,[40] quoted this statement with the following words of approval: "Dixon Crucible Co. v. Guggenheim, 7 Phila.

[34] (1870) 7 Phila. (Pa.) 408.
[35] Upton. Trade-Marks, p. 136.
[36] (1870) 54 Ill. 439.
[37] (1876) 66 N. Y. 69.
[38] (1880) 82 N. Y. 519.
[39] (1883) 29 Hun (N. Y.) 369.
[40] (1892) 146 Pa. 592.

(Pa.) 408, decided by the writer when sitting in the common pleas of Philadelphia, has been so generally accepted as law that I may be excused for giving a brief extract from the opinion in that case." In Brown v. Seidel,[41] the supreme court of Pennsylvania followed the decision in Heinz v. Lutz.

In Gilman v. Hunnewell,[42] decided in 1877 by the supreme judicial court of Massachusetts, it is said: "All the authorities agree that the court will not restrain a defendant from the use of a label on the ground that it infringes the plaintiff's trade-mark, unless the form of the

41 (1893) 153 Pa. 60.

42 (1877) 122 Mass. 139.

See, also, Stokes v. Allen (1890) 56 Hun (N. Y.) 526.

In Heinz v. Lutz (1892) 146 Pa. 592-610, Paxson, C. J.: "A court of equity will not restrain a person from using a device, on the ground that it infringes plaintiffs' trade-mark, unless it is so similar in appearance that any person using such reasonable care and observation as the public generally are capable of using, and may be expected to exercise, would mistake the one for the other. Gilman v. Hunnewell, 122 Mass. 139; Desmond's Appeal, 103 Pa. 126. In trade-marks, in order to entitle the plaintiffs to relief by injunction, the resemblance must be such that ordinary purchasers, dealing with ordinary caution, are likely to be misled. McLean v. Fleming, 96 U. S. 245. The court is not bound to interfere where ordinary attention will enable the purchaser to discriminate. Tallcot v. Moore, 6 Hun (N. Y.) 106. And it was said by the court of errors and appeals of New York in Popham v. Cole, 66 N. Y. 69: 'The question in this as in every other similar case is whether there is such resemblance between the two as to deceive the purchaser using reasonable caution.' So, in the case of Merrimack Mfg. Co. v. Garner, 4 E. D. Smith (N. Y.) 387, the court says: 'The courts are not bound to interfere when ordinary attention will enable a person to discriminate. We must assume that dealers and consumers have ordinary intelligence, and adopt reasonable precautions against imposition and fraud.' * * * It is not enough that there may be a possibility of deception. The offending label must be such that it is likely to deceive persons of ordinary intelligence. It is not necessary to show that persons have been deceived."

printed words, the words themselves, and the figures, lines, and devices, are so similar that any person, with such reasonable care and observation as the public generally are capable of using, and may be expected to exercise, would mistake the one for the other."

§ 190. Caution required on part of purchasers.

While, as seen by the cases cited in the foregoing section and the notes thereto, there is considerable conflict in the language of the decisions as to the degree of caution required on the part of purchasers, the rule generally accepted at the present time is that a court will assume that the purchasing public is possessed of ordinary intelligence, and that, in purchasing articles, it will exercise ordinary care and caution.[43] This, however, is a very flexible rule, and one that may be made to cover almost any degree of care upon the part of purchasers. A person who has become accustomed to buying an article under a well-known trade-mark will not be expected to exercise any great degree of care in making his purchases. If some particular familiar feature strikes his eye, he may be excused from looking carefully at any of the accessories. He has no reason to suspect that the familiar feature is used upon any but the genuine article, and he has a right to disregard all minor features, or at least he will be excused if he pays no attention to them.

In ruling upon the question, in cases of infringement, as to the "caution required to be exercised on the part of the purchaser," courts have used the following language: In McLean v. Fleming:[44] "No trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers, buying with ordinary caution, are likely to be misled;" "the general appearance of the package * * * is

[43] See section 188, and cases there cited.

[44] (1878) 96 U. S. 245.

well calculated to mislead and deceive the unwary;" and "if the resemblance is such as to deceive an ordinary purchaser giving such attention to the same as such a purchaser usually gives." In Consolidated Fruit Jar Co. v. Thomas:[45] "Where the imitation is so close that * * * purchasers exercising ordinary caution are liable to be misled." In Gilman v. Hunnewell:[46] "Unless the form of the printed words, the words themselves, and the figures, lines, and devices, are so similar that any person, with such reasonable care and observation as the public generally are capable of using and may be expected to exercise, would mistake the one for the other." In Colman v. Crump:[47] "If the resemblance is such as to deceive a purchaser of ordinary caution, or if it is calculated to deceive the careless and unwary." In Hurricane Patent Lantern Co. v. Miller:[48] "So dissimilar that they cannot, in my opinion, be mistaken as intended to represent the same article by any but the most careless observer." In Dreydoppel v. Young:[49] "To increase the counterfeit resemblance, they [the defendants] have added devices which may be readily mistaken for the medals of the plaintiff by unlettered persons, or persons not making a careful and critical comparison between the two."

In Brooklyn White Lead Co. v. Masury[50] it was held that an injunction will be granted to restrain the use of a trademark which appears to have been adopted in imitation of the plaintiff's, and which would have the effect of making the defendant's goods pass for the plaintiff's with any but the most cautious. The court said that such use of a false

[45] (1879) 2 N. J. Law J. 272, Fed. Cas. No. 3,131.
[46] (1877) 122 Mass. 139.
[47] (1877) 70 N. Y. 573.
[48] (1878) 56 How. Pr. (N. Y.) 234.
[49] (1880) 14 Phila. (Pa.) 226.
[50] (1857) 25 Barb. (N. Y.) 416.

name is in violation of a party's right to sell his own, to the incautious as well as to the cautious.

In N. K. Fairbank Co. v. Swift & Co.[51] it was said: "While the court is not bound to interfere where ordinary attention will enable the purchasers to discriminate between the trade-marks used on the goods manufactured by different parties, nevertheless the character of the article, the use to which it is put, and the kind of people who are likely to ask for it, as well as the manner in which it is probable it will be ordered, must not be lost sight of."

In Battle v. Finlay,[52] Judge Pardee held that the true test in trade-mark cases is (1) whether the trade-mark is infringed, and (2) whether incautious purchasers may be deceived, and said: "Wherever it appears that an incautious or ordinarily unsuspecting purchaser is liable to be deceived by the wrongful use of the trade-mark, equity never fails to give a remedy."

In Glenny v. Smith,[53] the court said: "And it is not the question whether the public generally, or even a majority of the public, is likely to be misled, but whether the unwary, the heedless, the incautious portion of the public would be likely to be misled."

In Singer Mfg. Co. v. Wilson,[54] Sir George Jessel, M. R., said: "I am not, as I consider, to decide cases in favor of fools or idiots, but in favor of ordinary English people, who understand English when they see it, and are not deceived by any difference in type, but who have before them a very plain statement."

51 (1896) 64 Ill. App. 477.

52 (1891) 45 Fed. 756.

53 (1865) 2 Drew. & S. 476, 11 Jur. (N. S.) 964, 13 Law T. (N. S.) 11, 13 Wkly. Rep. 1032, 6 New Reports, 363.

54 (1876) 2 Ch. Div. 434, 45 Law J. Ch. Div. 491, 34 Law T. (N. S.) 858.

Where trade-marks on a certain class of merchandise contained in the same form of package (as flour) are very numerous and similar, the rule is that some care must be exercised to distinguish one trade-mark from another, and if, this care being exercised, the difference is easily distinguishable, the second trade-mark does not infringe.[55]

§ 191. Not necessary that anyone has actually been deceived.

It is not necessary, in order to establish a right to an injunction or a right to recover damages against an alleged infringer of a trade-mark, to show that any one has actually been deceived by the alleged infringing mark, and has purchased the defendant's goods in the belief that they were goods bearing the genuine mark. To constitute an infringement, as already stated, it will be sufficient to show that the imitation is such as would be likely to mislead one in the ordinary course of purchasing the goods, and lead him to suppose or believe that he was purchasing the genuine article.[56]

§ 192. Infringement may appear from accessories.

It frequently occurs that an imitator of a trade-mark, while using a word or mark that in itself is not a close simulation of the genuine, will accompany the mark with such accessories as to render the mark a colorable imitation. The

[55] Columbia Mill Co. v. Alcorn (1889) 40 Fed. 676.

[56] Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Filley v. Fassett (1869) 44 Mo. 168; Drummond Tobacco Co. v. Addison Tinsley Tobacco Co. (1892) 52 Mo. App. 10; Collinsplatt v. Finlayson (1898) 88 Fed. 693; Bank of Tomah v. Warren (1896) 94 Wis. 152; Shaw v. Pilling (1896) 175 Pa. 78; Listman Mill Co. v. William Listman Milling Co. (1894) 88 Wis. 334; Taendsticksfabriks Aktieholagat Vulcan v. Myers (1893) 139 N. Y. 364; Wirtz v. Eagle Bottling Co. (1892) 50 N. J. Eq. 164; India Rubber Co. v. Rubber Comb & Jewelry Co. (1879) 45 N. Y. Super. Ct. 258.

question whether the infringer has colorably imitated the genuine mark cannot always be solved by considering the resemblances between the marks themselves. If the infringer has dressed his mark in such accessories that it may be mistaken for the original, that circumstance is not to be overlooked. Where a word is used as a trade-mark, it is addressed to the eyes as well as to the ears of purchasers of the article to which it is affixed. It cannot be dissociated from its surroundings when the inquiry is whether, as used, it is a colorable imitation of another's trade-mark. Where a defendant had artfully garbed and draped a word used by him bearing a close resemblance to the complainant's word, the court said that its identity was rendered more indistinguishable from that of the complainant than it was intrinsically, and took this fact into consideration in holding that there was an infringement.[57]

§ 193. May be determined by inspection.

In determining whether a trade-mark has been infringed, the court may base its conclusions upon a comparison of the devices used by plaintiff and defendant, and does not necessarily require the testimony of witnesses as to the likeness.[58]

[57] Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823.

[58] Coats v. Merrick Thread Co. (1893) 149 U. S. 562; Liggett & Myers Tobacco Co. v. Finzer (1888) 128 U. S. 183; Von Mumm v. Frash (1893) 56 Fed. 830; Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322; India Rubber Co. v. Rubber Comb & Jewelry Co. (1879) 45 N. Y. Super. Ct. 258; Potter v. McPherson (1880) 21 Hun (N. Y.) 559; Liggett & Myer Tobacco Co. v. Hynes (1884) 20 Fed. 883; Metcalfe v. Brand (1887) 86 Ky. 331; Lever v. Goodwin (1887) 36 Ch. Div. 1; Keller v. B. F. Goodrich Co. (1888) 117 Ind. 556; Heinz v. Brueckmann (1890) 134 Pa. 495; Fischer v. Blank (1892) 64 Hun, 635, 19 N. Y. Supp. 65; Drummond Tobacco Co. v. Addison Tinsley Tobacco Co. (1892) 52 Mo. App. 10; Wirtz v. Eagle Bottling Co. (1892) 50 N. J. Eq. 164; Cuervo v. Landauer (1894) 63 Fed. 1003; Burt v. Smith (1895) 71 Fed. 161; Brown v

Whether one thing is a colorable imitation of another is answered most satisfactorily by judicial inspection and comparison of the two, and, if the court is convinced that the two things are near enough to deceive or mislead the ordinary purchaser, in the exercise of ordinary care and caution, no amount of expert evidence of substantial differences would justify the court in withholding the injunction.[59]

§ 194. Expert evidence may be admissible.

While the main test of the alleged resemblance in a trademark case is an inspection by the court of the original trademark, and of the alleged infringement, nevertheless, in determining whether an ordinary customer, having neither the opportunity for comparison nor the time for examination, would be likely to be deceived by the similarity, the opinion of witnesses familiar with the trade and the habits of customers is of weight, and, when aided by evidence of actual deception, should be controlling unless the dissimilarity between the two marks is such as to exclude any probability of deception.[60] In investigations as to the question of infringement, the court may be aided to some extent by experts.[61] For the purpose of proving that the alleged infringing packages with their labels so closely resemble those of the plaintiff's as to mislead an ordinary purchaser, wholesale dealers in the articles in question may testify as experts.[62]

Doscher (1895) 147 N. Y. 647; Hubinger v. Eddy (1896) 74 Fed. 551; Lalance & Grosjean Mfg. Co. v. National Enameling & Stamping Co. (1901) 109 Fed. 317; Collinsplatt v. Finlayson (1898) 88 Fed. 693; Sperry & Co. v. Percival Milling Co. (1889) 81 Cal. 252.

[59] Consolidated Fruit-Jar Co. v. Thomas (1879) 2 N. J. Law J. 272, Fed. Cas. No. 3,131.

[60] Drummond Tobacco Co. v. Addison Tinsley Tobacco Co. (1892) 52 Mo. App. 10.

[61] Morse v. Worrell (1874) 10 Phila. (Pa.) 168.

[62] Williams v. Brooks (1882) 50 Conn. 278.

In the case of McLean v. Fleming,[63] Justice Clifford, in delivering the opinion of the supreme court, said: "Argu-

[63] (1878) 96 U. S. 245.

"Expert Testimony. The question of what evidence is requisite to make out a case of infringement of a trade-mark is often a difficult one. This difficulty, however, arises in great measure from the fact that considerable confusion exists with reference to the fundamental basis of trade-mark law. If the idea of property in a trade-mark be admitted, and followed to its logical conclusion, no evidence in technical trade-mark cases should be required beyond proof of ownership of the particular trade-mark, and its use by the defendant. Generally this use can be seen by the court at a glance, and, if the trade-mark of the plaintiff is found upon defendant's goods, this wrongful use of the plaintiff's property should be enjoined without further inquiry. Many judges, however, have refused to act in this summary way, and have required proof, either of actual deception of plaintiff's customers, or the probability of deception. The latter inquiry, which is the usual one, opens the door to evidence of a most unsatisfactory character. It has been decided in some cases that experts might be called in, but the later, and possibly the better, rule, excludes such evidence, first, because all such evidence is the merest speculation and expression of opinion, and quite as many witnesses will be produced on one side as on the other; but the best reason for rejecting such evidence is given in a recent case, in which it was said that every one in such a case must give an opinion based upon the effect that the articles and marks of the contending parties may make upon their minds; and if the parties be of a standard of intelligence such as will justify them in speaking as experts, they are entirely unfit to testify with reference to the impressions the marks would make upon the minds of persons of ordinary and presumably less intelligence than themselves. This line of argument brings us, however, to the question of, 'How competent are the judges, who are presumed to be of more than ordinary intelligence, to pass upon these questions?' This only shows how utterly unsatisfactory this method of proof is, and how little reliance is to be placed upon it, or in fact upon the opinions of the judges, when based upon nothing more than their individual opinion of whether deception is likely or not.' 26 Am. & Eng. Enc. Law (1st Ed.) 494-496.

In Mitchell v. Henry, 15 Ch. Div. 181, Cotton, L. J.: "In the present case, however, the question seems to me to be essentially a question for experts, for, when the goods are placed side by side,

ment to show that the name of the pills, as given in the trade-mark of the respondent, was of a character to mislead and

there is great difficulty in arriving at a conclusion whether the triple thread used by the defendants and the selvage altogether is not calculated to deceive. * * * But there is a conflict of testimony between the expert witnesses, and there is, so far as I am concerned, a difficulty in arriving at a satisfactory conclusion, and I think the better course is to let the motion stand to the hearing, and then, after cross-examination of the witnesses, and after hearing the evidence in court, the court can decide whether the defendants' goods are so manufactured as to be calculated to be passed off as the goods of the plaintiffs."

In Radam v. Capital Microbe Destroyer Co., 81 Tex. 122, Collard, J.: "We doubt the propriety of taking the opinion of an expert in such a case. He was called on for his opinion as to whether persons of ordinary intelligence and care would be deceived by the trade-marks of the parties, or the packages and the trade-marks, into the belief that they were the same. We do not see how the evidence of an expert could aid the court in determining this question, or how there could be an expert in such a matter. What ordinary intelligence might think of facts before the eye, it seems to the writer, should be left to the judgment of ordinary intelligence, with at least as much confidence as to one calling himself an expert. Such evidence has, however, been admitted and approved. Williams v. Brooks, 50 Conn. 278, 47 Am. Rep. 642. * * * Identity of design might require an expert's testimony,—an expert in designs,—but that is not the question here. Expert testimony is resorted to for the purpose of informing the court or jury upon subjects not commonly understood; but where the nature of the inquiry appeals to the common understanding and ordinary intelligence of mankind, it would be improper to admit opinions of experts or other persons. Shelley v. City of Austin, 74 Tex. 612. This witness was not called as an expert, and his opinion was not admissible, nor would it have been, in our judgment, if he had been an expert. All the facts were before the court,—the trade-marks, the labels, the jugs, and the packages, as presented for sale in the market. It was his province to decide what impression would be made by them upon persons of ordinary intelligence and care. In such a case, an expert should not be allowed to decide for him. * * * All such testimony was inadmissible, and there was no error in rejecting it."

In Re Jelley, 51 Law J. Ch. 640, note, Jessel, M. R.: "You can

deceive, is scarcely necessary, as they are *idem sonans* in the usual pronunciation; nor can it be doubted that the form of the box containing the pills and the general appearance

always get as much evidence on one side as you can on the other. One set of experts say that the marks are alike, and the other set say they are not. One side say that they are practically indistinguishable in the stamping, and the other side say that, if the stamping is carefully and well done, they may be distinct; whereas, in practice, they are particularly well struck, and one must, therefore, have regard not merely to the theory on the subject."

In Cook v. Starkweather, 13 Abb. Pr. (N. S.; N. Y.) 392, Monell, J.: "Upon the trial, the devices of the respective parties were produced upon barrel heads branded and prepared as for sale. A considerable amount of testimony was taken as to the effect of the defendants' devices. Dealers in whiskey were examined who, upon inspection of the two devices, gave their opinions. The plaintiffs' witnesses stated their opinion to be that the public would, and the defendants that it would not, be misled or deceived by the defendants' devices, and that description of evidence may be said to have been fairly balanced. There is nothing much more difficult than to decide upon the kind of evidence which is proper in this class of cases. The best evidence, of course, would be instances of actual deception, but, if none such can be furnished, the opinions of witnesses, formed from a mere inspection of the genuine and the imitation, are of little weight. They may or may not be deceived, but they are wholly unable to do more than express an opinion as to the effect in the community, the force or correctness of which is not increased or strengthened by the peculiar business in which they are engaged. An expert can easily detect a counterfeit bank bill, but his opinion as to whether the public could detect it is not entitled to any more weight than the opinion of any other person."

In Lee v. Haley, 5 Ch. App. 155, Giffard, L. J.: "The first thing to be observed in cases of this description is that it would not be safe for any plaintiff to come into court until he could prove instances of persons having been actually deceived, for the court would have to try a hypothetical case, and a number of people would be brought forward by the defendant to say, and probably truly, that the thing done would never have deceived them, and, in their opinion, was not calculated to deceive. I think, therefore, that the plaintiffs were quite justified in waiting until they could collect a sufficient number of cases to prove to the court that the proceedings complained of actually do deceive the public."

of the wrapper which surrounded it, were calculated to have the same effect. Mention may also be made of the fact that the color of the label and the wax impression on the top of the box are well suited to divert the attention of the unsuspecting buyer from any critical examination of the prepared article. * * * Witnesses in great numbers were called by the complainant, who testified that the exhibits 'L' and 'K' of the respondent were calculated to deceive purchasers, and the reasons given by them in support of the conclusion are both persuasive and convincing." In this case, it appears that, while considerable weight was attached to the testimony of experts, yet the court was of opinion, from an inspection of the packages and comparison of the trade-marks themselves, that the defendant infringed the plaintiff's trade-mark.

§ 195. Other evidence may be required.

Where, in a trade-mark case, the defendant's goods, on the face of them, and explained by surrounding circumstances, are calculated to deceive, no evidence is required to prove the intention to deceive. The sound rule is that a man must be taken to have intended the reasonable and natural consequence of his acts, and no more is wanted. If, on the other hand, a mere comparison of the goods, explained by the surrounding circumstances, is not sufficient, then it is allowable to prove from other sources that what is or may be apparent innocence was really intended to deceive. There can be no better evidence of intention to deceive than that of the deceiver himself, and this evidence may be given with equal force by admission, oral or in writing, or by inference from conduct. If the intent to deceive be once established, it is but a short step, though it is a step, and not an inevitable one, to the conclusion that the intention has been fulfilled.

and that the goods are calculated to deceive.[64] Where the titles of two publications were sufficiently distinct to prevent the court declaring an infringement by mere inspection of the titles, it was held that such intention must be established, if at all, by extrinsic evidence.[65]

§ 196. Intent to infringe unnecessary.

When infringement of a technical trade-mark or trade-name is shown, the intention of the infringer is immaterial, for the reason that infringement in such case is a violation of a property right, and the essence of the wrong lies in the injury to such right. Hence it is unnecessary to show an intention to infringe on the part of the defendant, and the right of recovery will not be affected by a showing that the infringement was innocent or accidental. This rule was emphatically stated by Lord Cairns and Lord O'Hagan in the case of Singer Machine Manufacturers v. Wilson,[66] as follows: Lord Cairns said: "I wish to state, in the most distinct manner, that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark. * * * A man may take the trade-mark of another ignorantly, not knowing it was the trade-mark of the other; or he may take it in the belief, mistaken, but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it, knowing it is the trade-mark of his neighbor, and intending and desiring to injure his neighbor by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the plaintiff is just

[64] Saxlehner v. Apollinaris (1897) 66 Law J. Ch. Div. 538.

[65] Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 325.

[66] (1878) 3 App. Cas. 376, 47 Law J. Ch. 481, 38 Law T. (N. S.) 303, 26 Wkly. Rep. 664.

the same. The action of the court must depend upon the right of the plaintiff, and the injury done to that right." Lord O'Hagan said: "If a man has acquired legitimately a right to the property in an exclusive use of a name, it is of small account to him, should it be invaded, whether the invasion comes from a purpose to deceive, or from ignorance, or inadvertence, or an honest misconception of the relative rights of the parties, and the law ought not to permit, and will not permit, the continuance of the invasion, whatever may have been its origin."

In Amoskeag Mfg. Co. v. Spear[67] the court said: "Even where no fraud can be justly imputed, where the use of the name or style originated in mistake, and not in design, although the party may be exempted from damages and costs, the continuance of the use may be justly restrained, since it involves a violation of a right of property that, if persisted in with a knowledge of the fact, would be fraudulent." The right of the proprietor of a trade-mark to maintain an action for its violation does not depend, therefore, upon the infringer's intention to violate it. It is enough that an actual violation is shown. Such violation may have been innocent, or even accidental.

The circuit court of appeals for the second circuit has said: "Courts in such cases do not require proof of any peculiarly iniquitous, 'perfidious dealing.' If the representation as to what or whose the goods are is calculated to deceive the purchaser into buying them as the goods of the complain-

[67] (1849) 2 Sandf. (N. Y.) 599; Dale v. Smithson (1861) 12 Abb. Pr. (N. Y.) 237; McLean v. Fleming (1878) 96 U. S. 245; Davis v. Kendall (1850) 2 R. I. 566; Siegert v. Abbott (1893) 72 Hun (N. Y.) 243; Dreydoppel v. Young (1880) 14 Phila. (Pa.) 226; Shaver v. Shaver (1880) 54 Iowa, 208; Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117; Cuervo v. Landauer (1894) 63 Fed. 1003; Metcalfe v. Brand (1887) 86 Ky. 331; Electro-Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369; Colman v. Crump (1877) 70 N. Y. 573.

ant, equity will enjoin its continuance, although the 'deceitful representation' was placed upon them carelessly, or from lack of appreciation of the meaning it would convey to the purchaser, or from an honest mistake as to defendant's right to use it."[68]

§ 197. Immaterial that purchasing dealer not deceived.

The owner of a trade-mark will not be deprived of his remedy in equity, even if it be shown that all who bought goods bearing the mark from the defendant were well aware that the goods were not of the plaintiff's manufacture.[69] It frequently occurs that the dealer who purchases the goods from the manufacturer is aware of the fact that they bear an infringing or simulated trade-mark, and the dealer purchases the goods for the purpose of passing them off upon consumers as the genuine article. No man has a right to adopt and use a trade-mark, or an imitation thereof, such as will enable any dishonest trader into whose hands the goods may come to sell them as the goods manufactured by the proprietor of the original trade-mark.[70]

In Potter v. McPherson[71] it was said: "An injunction [restraining defendant from using plaintiffs' title of a publication] was properly issued if it appeared that persons desiring to purchase the plaintiffs' publication might well accept that of the defendant's, supposing and believing it to be the plaintiffs', even though persons engaged in the trade of buying the books with an intention to resell them might not be misled by the resemblance [in the titles], and though

[68] Tarrant v. Hoff (1896) 22 C. C. A. 644, 76 Fed. 959; Braham v. Beachim (1878) 7 Ch. Div. 848; Messerole v. Tynberg (1868) 4 Abb. Pr. (N. S.; N. Y.) 410; Robinson v. Storm (1899) 10 Tenn. 40.

[69] Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185.

[70] Johnston v. Orr Ewing (1882) 7 App. Cas. 219.

[71] (1880) 21 Hun (N. Y.) 559.

the difference could be readily detected by comparison of one book with the other."

In the English case of Orr Ewing v. Johnston[72] it was held that, where a trader has a right to a trade-mark on goods sold in a foreign market, an injunction will be granted to restrain the export of goods under another trade-mark, which may deceive the ultimate purchasers, although it would not deceive Englishmen, or the dealers in the foreign market.

It was said by the Kentucky court of appeals: "There need not be *mala mens* towards the first purchaser of the imitation article. The simulation may enable him to retail it as the genuine article, but at a lower price, and thus injure the manufacturer and delude the public."[73]

One who puts into the hands of retail dealers an article made by him, and so dressed up as to enable such dealer to deceive the ultimate purchaser into the belief that he is purchasing the goods of a third person, may be enjoined by the latter, although the retail dealer is not deceived.[74] While a simulated trade-mark may not deceive the first purchaser from the manufacturer, if it is sufficient to mislead the subsequent retail purchaser, and if the article is sold at a less price than the genuine article, it will eventually, if not enjoined, interfere with the sales of the genuine article.[75] The law is intended to reach, and many authorities say that it does reach, not only those who themselves deceive, but also those who enable others to deceive, the purchasing public.[76] Even where the defendant stated, in selling the goods, that the trade-mark was an imitation, an injunction was granted, as subsequent dealers might not be equally frank.[77] The

[72] (1880) 13 Ch. Div. 434.
[73] Metcalfe v. Brand (1887) 86 Ky. 331.
[74] Von Mumm v. Frash (1893) 56 Fed. 830.
[75] Collinsplatt v. Finlayson (1898) 88 Fed. 693.
[76] Saxlehner v. Apollinaris (1897) 66 Law J. Ch. Div. 533.
[77] Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321.

controlling question is whether the manufacturer or wholesale dealer has knowingly put into the hands of the retail dealer the means of deceiving the ultimate purchaser.[78]

§ 198. Infringement not excused by custom of trade.

No custom of other people, even in the same trade, can excuse one man for taking another's property without his consent. Thus, when the inventor and manufacturer of a new kind of atomizer put his own or his partner's name to it, it was held that the presumption was that he did so to indicate its origin and maker, and intended the name as a trade-mark. The excuse that defendant supposed the name was a merely descriptive one, which any one might use, and that there was a custom of the trade for dealers to borrow each other's cuts for advertising purposes, was of no avail. That defendants and some other dealers misunderstood the facts was not sufficient to excuse the violation of plaintiff's rights.[79]

§ 199. Infringement by manufacturer of labels or brands.

A manufacturer of infringing labels or brands will be restrained at the instance of one whose trade-mark or label is imitated, even though such manufacturer does not apply the labels or brands to any goods. It is an infringement of the right of the proprietor of a trade-mark for any person "to print or manufacture, or put on the market for sale, and sell for use upon articles of merchandise of the same kind as those upon which it is used by the proprietor, any device or symbol which, by its resemblance to the established trade-mark, will be liable to deceive the public, and lead to the purchase and use of that which is not the manufacture of

[78] N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (1900) 102 Fed. 327.

[79] Shaw v. Pilling (1896) 175 Pa. 85.

the proprietor, believing it to be his."[80] While the mere act of printing and selling labels in imitation of those of another may be innocent, and, without evidence of an illicit purpose, will not be a violation of such other's rights, it is otherwise where this is done with the obvious purpose of enabling others, by the use of the labels, to palm off their goods upon the public as the goods of the proprietor of the genuine trade-mark.[81] Where defendants procured cigar labels counterfeiting complainant's labels, and assembled these labels with cigar boxes, with the obvious purpose of enabling others, by the use of the labels, to palm off their goods upon the public as the goods of the complainant, it was held that complainant was clearly entitled to an injunction against all who knowingly combine together to accomplish that purpose.[82]

§ 200. Refilling packages bearing genuine mark.

The refilling of packages of any kind bearing a trade-mark or label with the intention of permitting them to be palmed off on customers as containing the genuine article, or even without any such intention, if thereby a dealer is given power to so palm off the goods, constitutes an infringement of the rights of the proprietor of the trade-mark or label that will be restrained by injunction.[83] Where defendants used bar-

[80] Colman v. Crump (1877) 70 N Y. 573.

[81] De Kuyper v. Witteman (1885) 23 Fed. 871.

[82] Cuervo v. Henkell (1892) 50 Fed. 471. See, also, Farina v. Silverlock (1855) 1 Kay & J. 509, (1856) 6 De Gex, M. & G. 214, (1858) Cox. Man. Trade-Mark Cas. No. 130; Moxie Nerve Food Co. v. Beach (1888) 33 Fed. 248; Von Mumm v. Wittemann (1898) 85 Fed. 966; Hennessy v. Herrmann (1898) 89 Fed. 669; Hildreth v. Sparks Mfg. Co. (1899) 99 Fed. 484; Guinness v. Ullmer (1847) 10 Law T. 127; Cuervo v. Landauer (1894) 63 Fed. 1003; Carson v. Ury (1889) 39 Fed. 777; Dixon v. Fawcus (1861) 30 Law J. Q. B. 137, 9 Wkly. Rep. 414.

[83] Rose v. Henley (1878) Cox, Man. Trade-Mark Cas. No. 551, cited 47 L. J. Ch. Div. 577, 38 Law T. (N. S.) 410; Rose v. Loftus

rels bearing complainant's label, which, after being sold by complainant, containing oil and emptied of their contents, were bought up by defendants, refilled with their oil, and sold, an injunction was granted. The court said: "This is a flagrantly fraudulent appropriation of the complainant's label and the goodwill attaching to it, to the manifest injury of the complainant and the public."[84]

In Eckhart v. Consolidated Milling Co.[85] it appeared that the appellants delivered to their customers flour manufactured by them in bags bearing the brands and trade-marks of the appellee. Appellants explained their use of appellee's bags by stating that their principal customers were bakers, and that sometimes, by agreement with the bakers, appellants made a price on large quantities of appellants' flour in bulk, the bakers to furnish bags for delivery of the flour, and that, among the bags furnished by the bakers in accordance with such agreement, and in which the flour furnished was delivered, were bags marked or branded with the marks or brands of the appellee; that appellants also purchased from bakers second-hand jute bags, among which were bags marked with the brand of the appellee, and that they used all such bags for the purpose of delivering to such bakers flour sold to them in bulk by appellants, the object of such use of the bags furnished by the bakers and the second-hand jute bags furnished by appellants being that appellants might be able to sell their flour at a less price than they would if

(1878) Cox, Man. Trade-Mark Cas. No. 608, 47 Law J. Ch. Div. 576, 38 Law T. (N. S.) 409; Barnett v. Leuchars (1865) 13 Law T. (N. S.) 495, 14 Wkly. Rep. 166; Hostetter v. Anderson (1870) 1 Vict. R. 7, 1 Australian Jur. 4. Cox, Man. Trade-Mark Cas. No. 652; Richards v. Williamson (1874) 30 Law T. (N. S.) 746, 22 Wkly. Rep. 765, Cox. Man. Trade-Mark Cas. No. 441; Evans v. Von Laer (1887) 32 Fed. 153.

[84] Scott v. Standard Oil Co. (1894) 106 Ala. 475.

[85] (1897) 72 Ill. App. 70.

they furnished new bags. Appellants, in their answer, denied that the bakers or the public were deceived, or that appellee was in any way injured by their use of the bags, or that appellants intended, by such use, to deceive any one. The Illinois appellate court affirmed the order granting an injunction, and in doing so said: "To entitle a complainant to relief by injunction in a case like the present, it is not necessary to show that the public are or have been actually deceived. The remedy by injunction is preventive, and it is sufficient to show facts from which the court can deduce the conclusion that the complainant has reasonable ground to fear that the public and the complainant's customers may be deceived, to the injury of the complainant; that the use made by the defendant of the complainant's marks is calculated to deceive, and probably will deceive, the public, to the injury of the complainant. It is obvious that, after appellants delivered flour to their customers, the bakers, in bags marked and branded as before stated, appellants could not, in all cases, follow the bags, nor could they control the bakers in the disposition of their flour, nor could they have personal knowledge as to how the bakers disposed of it, or as to whether or not they sold it, or any of it, or exposed it for sale, in the bags in which it was delivered to them; or represented to their, the bakers', customers, that bread sold by them was made of flour of the brands marked on the bags, showing the bags. By delivering to the bakers their flour in bags marked as stated, they put in the power of the bakers to dispose of the flour as that of appellee."

Where defendant manufactured an article of bitters closely resembling Hostetter's Bitters in appearance and flavor, and sold the same in bulk to its customers, advising them, at the time of such sales, to refill bottles that originally contained Hostetter's Bitters with the spurious article, and to

put the bottles thus refilled on the market as containing genuine Hostetter's Bitters, an injunction was granted. Judge Thayer said: "Customers of defendant, who have thus been advised and induced to use genuine bottles and labels in the manner above mentioned, are clearly guilty of a wrongful act which a court of equity will enjoin; and a person who counsels and advises another to perpetrate a fraud, and who also furnishes him the means of consummating the same, is himself a wrongdoer, and, as such, is liable for the injury inflicted. * * * The defendant cannot shield itself from an injunction by the plea that it has not itself sold a spurious article in a false dress. The fact that it has advised its customers to perpetrate a fraud of that description, and that it has furnished them the spurious article, and that some of its customers have probably acted on the same suggestion, is sufficient to render them liable to an injunction."[80]

§ 201. Sale of low-grade for high-grade goods of same manufacturer.

No person has a right to buy a low-grade article from a manufacturer or dealer, and sell it under a trade-mark or label used by that manufacturer for another or higher-grade article. To do this would be an infringement of the rights of the proprietor of the mark, as much as though the article had been manufactured by another. Thus, where a manufacturer used the mark "Le Page's Liquid Glue" for its highest quality glue, and "Le Page's Fish-Head Glue" for a lower grade or quality glue, it was held an infringement for a pur-

[80] Hostetter v. Brueggeman-Reinert Distilling Co. (1891) 46 Fed. 188. See, also, Hostetter v. Becker (1896) 73 Fed. 297; Hostetter v. Sommers (1897) 84 Fed. 333; Hostetter v. Comerford (1899) 97 Fed. 585; Hostetter v. Bower (1896) 74 Fed. 235; Myers v. Theller (1889) 38 Fed. 607. But see Welch v. Knott (1857) 4 Kay & J. 747, 4 Jur. (N. S.) 330; Hostetter v. Van Vorst (1894) 62 Fed. 600.

chaser of the "Fish-Head Glue" to sell it in bottles bearing the mark "Le Page's Liquid Glue."[87]

Where the plaintiff, a penmaker, sold his pens in boxes labeled, respectively, with the numbers "303" and "753," the former denoting the superior quality, and the defendant removed the "753" labels from the inferior pens, and substituted therefor labels imitated from the "303" labels, and with the number "303," an injunction was granted to restrain defendant from so doing.[88]

§ 202. Infringing use must be on same class of goods.

It has been said that one may stamp his cloth with the same mark or sign that another has acquired the exclusive right to use on his manufacture of iron.[89] In order to constitute an infringement, the use must be on the same class of goods, though it is not necessary that the proprietor of the trade-mark shall have used it on the same species of goods in the class.[90] Thus, where the firm of Collins & Co. had, from prior to 1834, made edge tools, and marked them "Collins & Co.," and from 1843 the successor of the firm, a cor-

[87] Russia Cement Co. v. Katzenstein (1901) 109 Fed. 314.

[88] Gillott v. Kettle (1854) 3 Duer (N. Y.) 624. See, also, Hennessy v. White, 6 Wyatt, W. & A'B. Eq. 216, Cox, Man. Trade-Mark Cas. No. 650; Hennessy v. Hogan, 6 Wyatt, W. & A'B. Eq. 225, Cox, Man. Trade-Mark Cas. No. 651; Krauss v. Peebles, 58 Fed. 585.

[89] Miller Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; Ainsworth v. Walmsley (1866) 35 Law J. Ch. 352, L. R. 1 Eq. 518.

[90] Wamsutta Mills v. Allen (1878) 12 Phila. (Pa.) 535; Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222; La Societe Anonyme des Mines v. Baxter (1877) 14 Blatchf. 261, 14 Fed. Cas. No. 8,099; Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117; Amoskeag Mfg. Co. v. Garner (1876) 4 Am. Law T. (N. S.) 176, 54 How. Pr. (N. Y.) 298; Osgood v. Rockwood (1873) 11 Blatchf. 310, Fed. Cas. No. 10,605; Smith v. Reynolds (1872) 10 Blatchf. 100, Fed. Cas. No. 13,098, (1876) 13 Blatchf. 458, Fed. Cas. No. 13,099; Hecht v. Porter (1882) 9 Pac. Coast Law J. 569; Celluloid Mfg. Co. v. Read (1891) 47 Fed. 712.

poration, had the right to make all articles of metal, and had gone on from that time extending its manufacture beyond edge tools, into digging tools, such as picks and hoes, and having always put the mark "Collins & Co." on its best quality of articles, it was held that the fact that it did not, before 1856, make a digging tool, such as shovels, on which, in 1856, Ames & Sons put the mark "Collins & Co.," did not warrant the conclusion that that mark was not, in 1856, the mark of the plaintiff company's trade in respect to shovels.[91]

In a case in the United States circuit court for the district of New Jersey, Judge Bradford held that pale ale and half and half must, as against an infringer of a trade-mark for the former, be treated as malt liquors substantially similar to each other, and belonging to the same class. The court said: "Courts should not be astute to recognize in favor of an [trade-mark] infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrongdoer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol."[92] It has also been held that a trade-mark for baking soda and saleratus is infringed by the use of the same mark on baking powder,[93] and that a trade-mark, "Lone Jack," for smoking tobacco, is infringed by the use of the same mark for cigarettes.[94]

§ 203. Infringement not avoided by use of infringer's name.

Where a trade-mark is imitated or wrongfully appropriated, infringement is not avoided by substituting for the name or name and address of the original proprietor the name or name and address of the infringer. This is espe-

[91] Collins v. Oliver Ames & Sons Corp. (1882) 18 Fed. 561.
[92] Bass v. Feigenspan (1899) 96 Fed. 206.
[93] Church v. Russ (1900) 99 Fed. 276.
[94] Carroll v. Ertheiler (1880) 1 Fed. 688.

cially true when the trade-mark consists of a word by which the genuine article has become known in the market.[95]

In a leading case decided by the United States supreme court it was said: "Holt & Co., then, having acquired the exclusive right to the words 'La Favorita' as applied to this particular vendible commodity, it is no answer to their action to say that there was no invasion of that right because the name of S. O. Ryder [a retired member of the firm] accompanied the brand upon flour sold by appellants' instead of the name of Holt & Co. That is an aggravation, and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the true proprietor."[96]

The supreme court of Pennsylvania has also said: "The use of the defendant's name on a spurious trade-mark is no defense to a bill for an injunction to prevent a piracy. * * * It is a circumstance, and nothing more, to be considered in connection with the whole appearance of the trademark to determine whether it is an imitation."[97]

In a case decided by Judge Blodgett, the use of an infringer's name in connection with a pirated trade-mark is thus discussed: "In regard to the last point made, that, by reason of the defendants using their own name upon the wrapper or envelope, the public are not deceived, it would perhaps be enough to say that, when goods acquire a specific name, the purchaser rarely looks to see who has manufac-

[95] Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Gillott v. Esterbrook (1867) 47 Barb. (N. Y.) 455; Coats v. Holbrook (1845) 2 Sandf. Ch. (N. Y.) 586; Carroll v. Ertheiler (1880) 1 Fed. 688; Hegeman & Co. v. O'Byrne (1880) 9 Daly (N. Y.) 264; Hier v. Abrahams (1880) 82 N. Y. 519; Lever v. Goodwin (1887) 36 Ch. Div. 1; Battle v. Finlay (1891) 45 Fed. 796; Dixon Crucible Co. v. Guggenheim (1870) 7 Phila. (Pa.) 416.

[96] Menendez v. Holt (1888) 128 U. S. 514.

[97] Pratt's Appeal (1888) 117 Pa. 401.

tured the goods by that name; as, for instance, if, as a matter of fact, these needles have acquired among the trade, and among customers or users, the designation of 'Parabola,' to such an extent that the purchaser would simply ask for 'Parabola needles,' he might be supplied with the Parabola needles manufactured by Clark & Sons, instead of those manufactured by the camplainant, to the direct injury of the complainant and the abridging of his trade."[98] It has also been held that it is no defense to a suit for infringement of the trade-mark "Cottolene" by the use of the word "Cottoleo" that defendant sold under his own name, and made no attempt, other than by the use of the word "Cottoleo," to sell his goods as if manufactured by plaintiff.[99]

§ 204. Infringement not avoided by change of accessories.

No one can avoid the charge of infringement of an established trade-mark by showing that he so changed the accessories of the mark as to make it unlikely that any one will be deceived by his use of the counterfeit mark. The rule applicable to these cases has been well stated by Judge Bradford, as follows: "No one who has counterfeited a legitimate trade-mark, and applied the spurious symbol in competition with the genuine, can avoid the charge of infringement by showing that the false mark has in practice been so accompanied, on labels, capsules, or otherwise, by trade-names, designations, descriptions, or other accessories, not forming part of it, as to render it unlikely that the public has been deceived. Such a showing, while it may affect the nature or measure of the relief to be granted, cannot defeat a suit for infringement. The lawful appropriator and en-

[98] Roberts v. Sheldon (1879) 8 Biss. 398, Fed. Cas. No. 11,916.

[99] N. K. Fairbank Co. v. Central Lard Co. (1894) 64 Fed. 133. See, also, Leonard v. White's Golden Lubricator Co. (1889) 38 Fed. 922.

ployer of a trade-mark has an exclusive right of use, and is entitled to be effectually secured in the full enjoyment of that right. If other persons are to be permitted to violate that exclusive right, on the plea that the counterfeit symbol, as applied in a given case, has such accessories as to render deception of purchasers improbable or even impossible, an element of uncertainty and confusion will be introduced which cannot fail to encourage fraud and promote litigation. A sound public policy requires that the spurious trade-mark be suppressed, whether it is or is not for the time being accompanied by such accessories, not constituting part of it, as to avoid deception or render it unlikely. He who applies the false mark has no just cause of complaint if he be prevented from further violating the exclusive right of the lawful employer of the genuine symbol, and he certainly should not be allowed, at the peril of the latter, fraudulently to experiment in the use of such false mark with accessories of varying character, with the double purpose of filching the custom of a business rival, and at the same time shielding himself from the consequences of infringement."[100] In Hier v. Abrahams the court said: "The goods become known by the name or word by which they have been distinguished, and not merely by the manner or fashion in which the word is written or printed, or the accessories surrounding it, and the unlawful use of the name or word in any form may be restrained."[101] Where the dominating characteristic of a trade-mark is a name by which the manufacturer's goods have become familiarly known to the public, another manufacturer has no right to designate his goods by that name, even though he accompanies it with a different device.[102] The fact that the defendant uses other words in connection

[100] Bass v. Feigenspan (1899) 96 Fed. 206.
[101] (1880) 82 N. Y. 519.
[102] Carroll v. Ertheiler (1880) 1 Fed. 688.

with plaintiff's trade-mark does not give the defendant the right to use such trade-mark.[103] Thus, where plaintiff and defendant were manufacturers of liquid glue, and the defendant, whose name was "Le Page," used the same name as that used by plaintiff to describe his glue, and by which to advertise it, except that defendant introduced therein the word "Improved," it was held that the introduction of this word into the name of the article did not justify its use if, in other respects, the plaintiff had just grounds to object to it.[104] As "Charter Oak" stoves were not conspicuously known by the particular device which surrounded the name upon them, but by the name itself, it was held that the use of the name "Charter Oak," separated from other parts of the trade-mark, amounted to an infringement of the maker's rights.[105]

§ 205. Instances of infringement.

In the following instances the courts have held that the trade-marks specified were infringed. In some cases, an imitation of the accessories has contributed to the decision against the infringer. It is necessary, therefore, to examine each case in order to determine the circumstances of the infringement. The word "Apollinaris," used with the representation of an anchor, was held infringed by the word "Apollinis," used with the representation of a bow and arrow or anchor.[106] "Bovilene" was held to be infringed by "Bovina," where the two labels were so alike in respect to form, color, words, and symbols as to make it manifest that the design of the defendants was to deceive, the resemblance

[103] Rillet v. Carlier (1870) 61 Barb. (N. Y.) 435.
[104] Russia Cement Co. v. Le Page (1888) 147 Mass. 206.
[105] Filley v. Fassett (1869) 44 Mo. 168.
[106] Apollinaris Brunnen v. Somborn (1878) 14 Blatchf. 380, Fed Cas. No. 496.

being such as would impose upon ordinary purchasers.[107] The word "Cocoaine" was held infringed by "Cocoine," although there was little similarity between the labels.[108] When the plaintiff used the representation of an anchor on the metal labels attached to each bundle of wire sent into market, so that the wire became known as "Anchor Brand Wire," a representation of a crown and anchor on the metal labels of defendant's wire was held an infringement.[109] The words "Black Diamond" were held infringed by "Diamond Gem," although the court said: "While, if this case stood alone, there might be some doubt about it, as a part of the scheme of these defendants to pirate the more valuable brands of the complainant, if an injunction is issued against the use of the other names, I think this should be included."[110] Where medicinal and surgical plasters had long been put up in packages bearing a red Greek cross, so that they had become known and asked for as "Red Cross Plasters," it was held that the use by another of a Greek cross, of somewhat different form, with a large red circle in the center, was an infringement, though bearing on its face letters and marks not on the other, and though there was little resemblance in the packages and other *indicia*.[111] The word "Shawknit," printed in script with flourish underneath, was held infringed by "Seamless," printed in same script, with same flourish, both words being used in same relative position.[112] The words "Warren Hose Supporter," in connection with a cut of a hose supporter engaged with a stocking, were held infringed by the words "Warranted Hose Sup-

[107] Lockwood v. Bostwick (1869) 2 Daly (N. Y.) 521.
[108] Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192.
[109] Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185.
[110] A. F. Pike Mfg. Co. v. Cleveland Stone Co. (1888) 35 Fed. 896.
[111] Johnson v. Bauer (1897) 27 C. C. A. 374, 82 Fed. 662.
[112] Shaw Stocking Co. v. Mack (1882) 12 Fed. 707.

porter," in connection with a similar cut.[113] The words "Carlsbad Sprudel Salts" used on the product of the Carlsbad Springs were held infringed by "Improved Effervescent Carlsbad Powder" on an artificial product.[114] The words "Sunlight Self-Washer" as a trade-mark for soap were held infringed by "Goodwin's Self-Washing," where there was a marked similarity in the paper and the printing thereon used for the packages containing the soap.[115] The words "Le Page's Glue" were held infringed by "Glue made by Le Page" or "Glue made by the Le Page Company."[116] The coined word "Momaja" was held infringed by "Mojava."[117] "Sunlight" as a trade-mark for soap was held infringed by "American Sunlight."[118] "Germea," as a trade-mark for a cereal food, was held infringed by "Germ."[119] The title, "The National Police Gazette," for a periodical, was held infringed by "The United States Police Gazette."[120] "Gold Dust," for a washing powder, was held infringed by "Gold Drop," although the court said the question was a close one.[121] "Maizena," applied to a preparation of corn for food, was held infringed by "Maizharina," applied to a similar article.[122] "Celluloid" was held infringed by "Cellonite."[123] Where the word "Star" and the symbol of a star had been used for many years as a trade-mark for shirts, waists, un-

[113] Frost v. Rindskopf (1890) 42 Fed. 408.

[114] City of Carlsbad v. Kutnow (1895) 18 C. C. A. 24, 71 Fed. 167.

[115] Lever v. Goodwin (1887) 36 Ch. Div. 1.

[116] Le Page Co. v. Russia Cement Co. (1892) 2 C C. A. 555, 51 Fed. 941.

[117] American Grocery Co. v. Sloan (1895) 68 Fed. 539.

[118] Lever Bros. v. Pasfield (1898) 88 Fed. 484.

[119] Sperry v. Percival Milling Co. (1889) 81 Cal. 252.

[120] Matsell v. Flanagan (1867) 2 Abb. Pr. (N. S.; N. Y.) 459.

[121] N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (1900) 41 C. C. A. 376, 102 Fed. 327.

[122] Glen Cove Mfg. Co. v. Ludelling (1885) 22 Fed. 823.

[123] Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94.

derwear, and furnishing goods, so that the articles had become known in the market as "Star" goods, it was held an infringement for another dealer to use a star and crescent, the star being made so prominent that such goods might also be designated as "Star" goods.[124] The words "Cashmere Boquet" as a trade-mark for soap were held infringed by the words "Violets of Cashmere," applied to another soap.[125] The words "Vitae-Ore," and the abbreviation "V-O," applied to a medicinal preparation, were held infringed by the words "Vitalizing Ore," also applied to a medicinal preparation.[126] The word "Chatterbox" upon a series of books was held infringed by "Chatter-Book" upon a similar series of books.[127] The word "Home" as a trade-mark for sewing-machines was held infringed by "Home Delight," applied in a similar way to another make of sewing-machines.[128] The word "Cuticura" as a trade-mark for a toilet soap was held infringed by the word "Curative," applied to another soap with lettering and arrangement producing a deceptive resemblance to the original mark.[129] The words "German Sweet Chocolate" were held infringed by "Germania Sweet Chocolate."[130] The word "Unceda," applied as a trade-mark to biscuit, was held infringed by "Iwanta," applied to a similar article, put up in a similar package.[131] The words "Electro-Silicon," applied to a polishing powder, were held infringed by "Electric Silicon," applied to a powder for the

[124] Hutchinson v. Blumberg (1892) 51 Fed. 829; Hutchinson v. Covert (1892) 51 Fed. 832.

[125] Colgate v. Adams (1898) 88 Fed. 899.

[126] Noel v. Ellis (1896) 89 Fed. 978.

[127] Estes v. Leslie (1886) 29 Fed. 91.

[128] New Home Sewing Machine Co. v. Bloomingdale (1893) 59 Fed. 284.

[129] Potter Drug & Chemical Corp. v. Miller (1896) 75 Fed. 656.

[130] Walter Baker & Co. v. Baker (1896) 77 Fed. 181.

[131] National Biscuit Co. v. Baker (1899) 95 Fed. 135.

same purpose, put up in similar packages.[132] Where plaintiff had for many years made tobacco, to each plug of which it attached six five-pointed stars, made of tin, with a hole in the center, and where, after plaintiff's tobacco had become known as the "Star" brand, defendant put on the market a "Buzz-Saw" tobacco, to which it attached a tin symbol of the same size as the plaintiff's, with eight points, slightly inclined to the right, a hole in the center, and the word "Buzz" dimly impressed thereon, it was held that the "Buzz-Saw" symbol was an infringement of plaintiff's trade-mark, and that its use should be enjoined.[133] The trade-mark "Moxie" in the combination "Moxie Nerve Food" was held infringed by a similar use of the word "Noxie."[134] The word "Sanitas," applied as a trade-mark to certain disinfectants, was held infringed by the phrase "Condi-Sanitas," and an injunction was granted against the use of the word "Sanitas" alone or in this combination.[135]

Where plaintiff and his predecessors had long used upon their whiskey barrels a trade-mark consisting of a chicken cock standing upright within a circle, surrounded by the words "Old Bourbon Whiskey, Bourbon, Ky.," and below the picture the words "From J. A. Miller, Paris," and this brand had, for over thirty years, been known to the trade as "Miller's Chicken Cock Whiskey," or "Chicken Cock Whiskey," and defendants, doing business in Boston, adopted a like picture, including the circle, their brand being called "Miller's Game Cock Rye," the words "The King of All Whiskies," "John Miller & Co., Sole Proprietors, Boston, Mass.," being upon the brand, it was held that defendants had infringed,

[132] Electro-Silicon Co. v. Trask (1880) 59 How. Pr. (N. Y.) 189.

[133] Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 56.

[134] Moxie Nerve Food Co. v. Beach (1888) 33 Fed. 248.

[135] Sanitas Co. v. Condy (1886) 56 Law T. (N. S.) 621.

and that it was immaterial that defendants used the device on barrels and bottles, while the plaintiff had theretofore used it only on bottles, and that it was further immaterial that defendants' whiskey is a blended whiskey, having but one stamp, while plaintiff's is a "straight" whiskey, having two stamps.[136] The use, to designate a medicinal preparation, of the phrase "Improved Fig Syrup" on bottles, wrappers, and devices resembling in general appearance a similar preparation manufactured and sold under the name of "Syrup of Figs," was held calculated to deceive and mislead the public, and an injunction was granted.[137] Where it appeared that the plaintiff, a manufacturer of matches, put up and sold its goods in boxes, each having a label attached thereto, which label had been adopted by plaintiff in 1883 as a trade-mark, and used continuously since that time, and where, upon the label, was printed or stamped in red colors "The Vulcan," under this the words "Damp Proof," and under these words a globe, on each side of which was the representation of medals that had been awarded to plaintiff, and where defendants sold matches put up in boxes identical in size and general appearance with those of plaintiff, each having a label printed or stamped in red, and with letters of the same size, and upon this label were the words "The Vulture," the picture of a vulture, and a fac-simile of the plaintiff's medals, it was held that there was an infringement, that defendants' label was an imitation of plaintiff's trade-mark sufficiently close to be liable to deceive, and that an injunction was properly awarded.[138] A label containing the words "Non-Secret Dental Vulcanite, made according to

[136] G. G. White Co. v. Miller (1892) 50 Fed. 277.

[137] Improved Fig Syrup Co. v. California Fig Syrup Co. (1893) 54 Fed. 175.

[138] Taendsticksfabriks Akticbolagta Vulcan v. Myers (1893) 139 N. Y. 364.

our analysis of the Akron Dental Rubber," the last three words being printed in a differently colored ink from the rest of the label, with large type, and conspicuously displayed, was held to be an infringement of a trade-mark containing the words "The Akron Dental Rubber." In this instance, on defendant's label the words "Akron Dental Rubber" were printed in red ink in large type, and the words were prominently displayed, so as to readily and quickly catch the eye.[139]

The following trade-names have been held infringed by the words stated, under the circumstances in which they were used: "New York Cab Co., Limited," by "New York Cab, Ltd.";[140] "Tuerk Water Motor Company" by "The Tuerk Water Meter Company";[141] "Mechanics' Store" by "Mechanical Store";[142] "United States Dental Association" by "U. S. Dental Rooms."[143]

§ 206. Instances of non-infringement.

The following are instances in which the courts have held that there was no infringement of the trade-mark made the basis of the action: The use of the word "Cotosuet" as a trade-mark was held not to be an infringement of the trade-mark "Cottolene."[144] While "No-To-Bac" is an arbitrary term, which may be appropriated as a trade-mark for a medicine designed to cure the tobacco habit, it has been held not to be infringed by "Baco-Curo," used with a similar medi-

[139] Keller v. B. F. Goodrich Co. (1888) 117 Ind. 556.

[140] New York Cab Co. v. Mooney (1884) 15 Abb. N. C. (N. Y.) 152.

[141] Tuerk Hydraulic Power Co. v. Tuerk (1895) 92 Hun (N. Y.) 65.

[142] Weinstock, Lubin & Co. v. Marks (1895) 109 Cal. 529.

[143] Cady v. Schultz (1895) 19 R. I. 193.

[144] N. K. Fairbank Co. v. Swift & Co. (1896) 64 Ill. App. 477.

cine.[145] A rhombus, or lozenge, or conventional diamond figure, used upon packages of goods, so as to become a trade-mark therefor, is not infringed by the representation of a radiant, rough diamond, presenting a striking dissimilarity to the conventional figure.[146] The phrases "Oriole Vermillion" and "Peerless Green" were held not infringed by the terms "O. Vermillion" and P. Green."[147] A small blue label for packages of laundry soap, bearing the words "Old Country," was held not infringed by the use of a label having on it the national colors of the United States, with the words "Our Country."[148] A trade-mark used on shoes, and consisting of the words "Steel Shod," in connection with a symbol, is not infringed by the words "Steel Clad" alone, stamped on shoes having the soles quilted with steel wires.[149] The term "Grape-Nuts," applied to a cooked cereal food product, was held not infringed by the term "Grain-Hearts," applied to a like preparation.[150] The terms "Tempest" and "Hurricane," applied to lanterns, are not so similar as to warrant the conclusion that the public is liable to be misled into believing that the lamps are of the same manufacture.[151] Where plaintiff recorded "IXL General Merchandise Auction Store" as a trade-mark, and used the same as a sign over his place of business, and defendant afterwards

[145] Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 80 Fed. 105.

[146] Pittsburgh Crushed Steel Co. v. Diamond Steel Co. (1898) 85 Fed. 637; Kann v. Diamond Steel Co. (1898) 89 Fed. 707.

[147] Lavanburg v. Pfeiffer (1898) 23 Misc. Rep. (N. Y.) 577.

[148] Allen B. Wrisley Co. v. Geo. E. Rouse Soap Co. (1898) 87 Fed. 589.

[149] Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1900) 99 Fed. 971.

[150] Postum Cereal Co. v. American Health Food Co. (1901) 109 Fed. 893.

[151] Hurricane Patent Lantern Co. v. Miller (1878) 56 How. Pr. (N. Y.) 234.

used "Great IXL Auction Company" as a sign over his store, it was held that the court would not suppose the latter an infringement of plaintiff's trade-mark.[152] The appropriation as a trade-mark of the word "Samaritan" in one combination of words does not prevent its being used in all other combinations.[153] The name "The New Northwest" for a weekly newspaper was held to be a trade-mark. Defendant used the name "The Northwest News" for a similar paper. The court said: "It is clear that the titles are sufficiently distinct to prevent the court declaring an infringement by mere inspection of the titles. It must be established, if at all, by extrinsic evidence. But the facts set out in the complaint and affidavits and exhibits do not show any loss of trade. Inconveniences and annoyances from mistakes in the names of the two papers constitute no ground for an injunction. There must be actual injury to the sale of plaintiff's paper."[154] A person cannot, by coining the word "Puddine," and registering it, prevent other makers of pudding from calling their goods by their well-known English name, "Pudding."[155] The name "Cuticura Soap" is not infringed by the name "Cuticle Soap."[156] The court in this case said: "The words are, to a considerable degree, unlike to the eye, unlike to the ear, unlike in spelling, unlike in meaning, and unlike in suggestion." Where plaintiff used the words "Adams Sappota Tolu" for chewing gum, and had registered these words as a trade-mark in the patent office, designating the word "Sappota" as the essential feature, it was held that

[152] Lichtenstein v. Mellis (1880) 8 Or. 464.

[153] Desmond's Appeal (1883) 103 Pa. 126, Am. Trade-Mark Cas. 794.

[154] Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322.

[155] Clotworthy v. Schepp (1890) 42 Fed. 62.

[156] Potter Drug & Chemical Corp. v. Pasfield Soap Co. (1900) 102 Fed. 490.

the term "Heisel's Elastic Tolu" was not an infringement.[157] Where complainant was the first to use a tin star upon plug tobacco, but not the first to use the design of a star generally, and complainant and defendant both used stars upon such tobacco, but the two stars were, as said by the United States supreme court, "so different in form and surroundings that it would not be possible for any person, not afflicted with color blindness, to mistake the one for the other," there was no infringement of complainant's trade-mark.[158] The title "The Good Things of Life," for a publication, was held not infringed by the title "The Spice of Life." for a publication of a somewhat similar character.[159] It has been held that the name "B. T. Butler's," preceding the words "Trade-Mark—Best Soap," upon cakes of soap and their wrappers, is not so similar to the name "B. T. Babbitt's," preceding the same words, as to call for the restraint of its use as an infringement of a trade-mark, in the absence of proof that any one had been deceived thereby, and where the form and size of the cakes of soap differ.[160] It has also been held that the phrase "One Night Cure," used as a trade-mark for a cough remedy and for a corn remedy, is not infringed by the use of the words "Beeshore's One Night Cough Cure."[161] The use by defendants of their own firm initials, "B. & S.," upon articles sold by them, was held not to be an infringement of a registered trade-mark consisting of the letters "S. B."[162] A label upon which appeared, on a white background, in red and white letters, an advertisement of "Elastic Starch," made by H. Co., with a large and prominent cut of a flatiron, used

[157] Adams v. Heisel (1887) 31 Fed. 279.
[158] Liggett & Myers Tobacco Co. v. Finzer (1888) 128 U. S. 182.
[159] Stokes v. Allen (1890) 56 Hun (N. Y.) 526.
[160] Babbitt v. Brown (1893) 68 Hun (N. Y.) 515.
[161] Kohler Mfg. Co. v. Beeshore (1893) 59 Fed. 572.
[162] Burt v. Smith (1895) 71 Fed. 161.

as a trade-mark for starch, was held not to be infringed by another label, used as a trade-mark for starch, bearing on a red background, in white, yellow, and black letters, an advertisement of "E.'s New Process Starch," with a picture of a colored woman holding up prominently a freshly ironed shirt, underneath which, on a table, appeared a flatiron.[163]

[163] J. C. Hubinger Bros. Co. v. Eddy (1896) 74 Fed. 551.

CHAPTER X.

UNFAIR COMPETITION IN TRADE.

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283. Old Coon Smoking Tobacco Case.
284. Simmons' Liver Medicine Case.
285. Awl Package Case.

§ 207. In General.

In earlier chapters, incidental reference was made to what has come to be known as the law of unfair competition. Within recent years the courts have worked out a set of rules by which persons who have no technical trade-marks are nevertheless protected in the use of personal and descriptive names, marks, labels, forms of packages and wrappers, and other such insignia which have become associated with their business or products. The right to free and unrestricted competition is freely admitted, but such competition, to be legal, must be honest, and the courts will not countenance fraud or dishonesty under the guise of business competition. The rules which have become established for the determination of such questions enforce a strict code of business morality, and are highly honorable

to the courts by which they have been developed. As said by a learned judge: "The gradual but progressive judicial development of the doctrine of unfair competition in trade has shed luster on that branch of our jurisprudence as an embodiment, to a marked degree, of the principles of high business morality, involving the nicest discrimination between those things which may and those which may not be done in the course of honorable rivalry in business."[1] This branch of the law is still growing, and the tendency is to restrict the scope of the law of technical trade-marks, and to extend that which covers unfair competition.[2] The course of the decisions marks a distinct tendency towards the protection of persons in legitimate business enterprises from the inroads of dishonest competitors, and it is now thoroughly settled that a court of equity will enjoin those who, through unfair competition, seek to deprive others of the legitimate results of their skill and enterprise, irrespective of any question of trade-mark. Hence, rival manufacturers may not, by initative devices, beguile the public into buying their goods under the impression that they are buying those of their rivals.[3]

§ 208. Distinguished from Technical Trade-Marks.

The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed. The essential elements of a technical trade-mark have already been considered, and need not be here restated.[4] If a party

[1] Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[2] See Church v. Russ (1900) 99 Fed. 276; Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608.

[3] California Fig-Syrup Co. v. Worden (1899) 95 Fed. 132; Croft v. Day (1843) 7 Beav. 84; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Samuels v. Spitzer (1900) 177 Mass. 26.

[4] Chapter 1.

has such a trade-mark, the law will protect him in its use; but even when no technical trade-mark exists, the user of a name, mark, label, or other device which is of value to him will be protected from attack by the piratical craft which infest the seas of modern business. In a recent case in New York the distinction between the infringement of a technical trade-mark and unfair competition was thus stated: "In a general way," said the court,[5] "the infringement of a trade-mark, so far as applicable to this case, may be said to be the improper use by the defendant of the emblems constituting the trade-mark of the plaintiff, whether upon packages of cachous of the same general appearance or not; while unfair competition in trade may be said to be the simulation by defendant of the packages of plaintiff,—putting up and selling packages of the same general appearance as those of the plaintiff. In this case the question as to unfair competition was whether the defendant was fraudulently attempting to pass off upon the public its cachous as the cachous of the plaintiff. Fraud was the essence of the claim. The simulation might be so great as that fraud would be implied; otherwise it had to be proved by evidence aliunde." In another case it was said: "While the law of trade-marks is but part of the law of unfair competition in trade, yet, when the two are viewed in contradistinction to each other, an essential difference is to be observed. The infringement of trade-marks is the violation by one person of an exclusive right of another person to the use of a word, mark, or symbol. Unfair competition in trade, as distinguished from infringement of trade-marks, does not involve the violation of any exclusive right to the use of a word,

[5] T. B. Dunn Co. v. Trix Mfg. Co. (1900) 50 App. Div. (N. Y.) 75. See Goodman v. Bohls (1893) 3 Tex. Civ. App. 183, 22 S. W. 11; Radam v. Capital Microbe Destroyer Co. (1891) 81 Tex. 122, 16 S. W. 990; Alff v. Radam (1890) 77 Tex. 530, 14 S. W. 164.

mark, or symbol. The word may be purely generic or descriptive, and the mark or symbol indicative only of style, size, shape, or quality, and as such open to public use, 'like the adjectives of the language,' yet there may be unfair competition in trade by an improper use of such word, mark, or symbol. *Two rivals in business, competing with each other* in the same line of goods, may have an equal right to use the same words, marks, or symbols on similar articles produced or sold by them respectively; yet if such words, marks, or symbols were used by one of them before the other, and by association have come to indicate to the public that the goods to which they are applied are of the production of the former, the latter will not be permitted, with intent to mislead the public, to use such words, marks, or symbols in such a manner, by trade dress or otherwise, as to deceive or be capable of deceiving the public as to the origin, manufacture, or ownership of the articles to which they are applied, and the latter may be required, when using such words, marks, or symbols, to place on articles of his own production, or the packages in which they are usually sold, something clearly denoting the origin, manufacture, or ownership of such articles, or negativing any idea that they were produced or sold by the former."[6] It is therefore not necessary, in order to obtain an injunction, to show that a technical trade-mark has been infringed. "Irrespective of the technical question of trade-mark, the defendants have no right to dress their goods up in such manner as to deceive an intending purchaser, and induce him to believe he is buying those of the plaintiffs. Rival manufacturers may lawfully compete for the patronage of the public in the quality and price of their goods, in the beauty and tastefulness of their inclosing packages, in

[6] Dennison Mfg. Co. v. Thomas Mfg. Co. (1893) 94 Fed. 651, and cases cited.

the extent of their advertising, and in the employment of agents; but they have no right, by imitative devices, to beguile the public into buying their wares under the impression they are buying those of their rivals."[7]

I. General Principles.

§ 209. Basis of the Rule.

The law of unfair competition rests upon the simple principle that no person has the right to sell his own goods as those of another.[8] In other words, the basic rule is that no one shall, by imitation or any unfair device, induce the public to believe that the goods he offers for sale are the goods of another, and thereby appropriate to himself the value of the reputation which the other has acquired for his own products or merchandise.[9]

§ 210. Fraudulent Intent.

The same general principle is at the base of all cases of technical trade-mark and unfair competition,—that is, the prevention of fraud upon the public and injury to a business rival. Every suit to restrain unfair competition is

[7] Coats v. Merrick Thread Co. (1893) 149 U. S. 562, 13 S. Ct. 966; Buck's Stove & Range Co. v. Kiechle (1896) 76 Fed. 758; Gilman v. Hunnewell (1877) 122 Mass. 139; Croft v. Day (1843) 7 Beav. 84; Wotherspoon v. Currie (1872) L. R. 5 H. L. 508; Thompson v. Montgomery (1889) 41 Ch. Div. 35; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277; Sawyer v. Horn (1880) 1 Fed. 24; Southern White Lead Co. v. Cary (1885) 25 Fed. 125. See chapter 1, §§ 22-24.

[8] Heller & Merz Co. v. Shaver (1900) 102 Fed. 882.

[9] Proctor & Gamble Co. v. Globe Refining Co. (1899) 34 C. C. A. 405, 92 Fed. 357; Scheuer v. Muller (1896) 20 C. C. A. 165, 74 Fed. 225, annotated; Lare v. Harper Bros. (1898) 30 C. C. A. 376, 86 Fed. 481; Kann v. Diamond Steel Co. (1898) 32 C. C. A. 324, 89 Fed. 706; Leclanche Battery Co. v. Western Electric Co. (1885) 23 Fed. 276; Van Horn v. Coogan (1894) 52 N. J. Eq. 380.

therefore based on fraud.[10] In technical trade-mark cases the fraud is presumed, while in cases of unfair competition the plaintiff must prove this intent, or show facts and circumstances from which it may reasonably be inferred.[11] "Every suit of this character," says Judge Sanborn, "is founded on the fact that the action, or the proposed action, of the defendant has deceived, or is calculated to deceive, ordinary purchasers buying with usual care, so that they have purchased, or will probably purchase, the goods of the defendant under the mistaken belief that they are those of the complainant, to the serious damage of the latter. The deceit, or probable deceit, of the ordinary purchaser, to such an extent that he buys, or will probably buy, the property of one manufacturer or vendor in the belief that they are those of another, is a *sine qua non* of the maintenance of such a suit, because every one has the undoubted right to sell his own goods, or goods of his own manufacture, as such, however much such sales may diminish or injure the business of his competitors."[12] In another case it was said: "This suit is based on fraud. Its foundation is unfair, fraudulent competition, and the intent to deceive is an indispensable element in the fraud which warrants the relief sought. This intent, and the fraud in which it inheres, may be, and generally must be, proved by circumstances, by facts, by sales, by a course of action; but the facts and circumstances which establish

[10] The intentional use of another's trade-mark is a fraud. Menendez v. Holt (1888) 128 U. S. 514.

[11] Coats v. Merrick Thread Co. (1893) 149 U. S. 562, 13 S. Ct. 966; Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co. (1899) 92 Fed. 774, (1900) 43 C. C. A. 511, 104 Fed. 243; Avery v. Meikle (1883) 81 Ky. 73; Mrs. G. B. Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; W. A. Gaines & Co. v. Leslie (1898) 25 Misc. Rep. (N. Y.) 20.

[12] Kann v. Diamond Steel Co. (1898) 32 C. C. A. 324, 89 Fed. 706.

it must be such that the fraud and the intent to deceive the public are fairly inferable from them."[13] So, in another case it was held that: an injunction to restrain unfair competition will not be granted where the proofs show that defendant has not been guilty of intentional or actual unfairness, and has not employed imitative devices to draw trade from the complainant, or acted with bad faith or wrongful purpose.[14] It is not, however, necessary in each case to prove an actual intent to deceive,[15] as it is sufficient if the defendant's goods, on their face, having regard to the surrounding circumstances, are calculated to deceive. Hence, evidence to prove an intent to deceive is sometimes unnecessary, as a man must be taken to have intended the reasonable and natural consequences of his own acts. If a mere comparison of the goods, having regard to the surrounding circumstances, is not sufficient, the plaintiff may prove by other evidence that what is apparently innocent was in fact intended to deceive.[16] It is equally true that a mere intention to deceive will not justify an injunction unless the means adopted are such as will probably result in misleading the public and

[13] Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co. (1900) 104 Fed. 243; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 11 S. Ct. 396; R. Heinisch's Sons Co. v. Boker (1898) 86 Fed. 765; Trask Fish Co. v. Wooster (1888) 28 Mo. App. 408; P. Lorillard Co. v. Peper (1898) 30 C. C. A. 496, 86 Fed. 956. See Hygeia Distilled Water Co. v. Hygeia Ice Co. (1900) 72 Conn. 646.

[14] Morgan Envelope Co. v. Walton (1898) 30 C. C. A. 383, 86 Fed. 605.

[15] Powell v. Birmingham Vinegar Brewery Co. (1896) 65 Law J. Ch. 563. An act, although not actually intended to be fraudulent, which amounts to a constructive legal fraud, will be enjoined by a court of equity. Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002; Singer Mfg. Co. v. Hippie (1901) 109 Fed. 152; Halstead v. Houston (1901) 111 Fed. 376.

[16] Saxlehner v. Apollinaris Co. (1897) 66 Law J. Ch. 533, citing Reddaway v. Banham (1896) 65 Law J. Q. B. 381, and other cases.

injuring the complainant. "The intention on the part of an alleged infringer to induce purchasers, through the use of a simulated trade-mark or dress, to buy his goods under the belief that they are another's, furnishes no ground for relief unless the similarity between the two trade-marks is of a character 'to convey a false impression to the public mind, * * * and to mislead and deceive the ordinary purchaser.'"[17]

In some of the English cases it is said that it is not necessary to prove fraud in order to obtain an injunction against unfair competition, but it is evident that this means little more than that the court will treat certain facts as constructively fraudulent. This tendency, especially in dealing with descriptive or geographical terms which have acquired secondary meanings, is towards applying to such terms the rules governing technical trade-marks.[17a]

The books abound in cases of relief granted by courts of equity against the improper use of labels, wrappers, bill heads, signs, and other things that are essentially *publici juris*, on the ground that thereby the goods of one person have been intentionally and fraudulently sold as the goods of an-

[17] Centaur Co. v. Marshall (1899) 38 C. C. A. 413, 97 Fed. 785, citing McLean v. Fleming (1877) 96 U. S. 254; N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 23 C. C. A. 554, 77 Fed. 869; Kann v. Diamond Steel Co. (1898) 32 C. C. A. 324, 89 Fed. 706.

[17a] Reddaway v. Banham [1896] App. Cas. 199; Cellular Clothing Co. v. Maxton [1899] App. Cas. 326. In the latter case Lord Halsbury said: "The only observation I wish to make upon that part of the argument is that it seemed to be assumed that a fraudulent intention is necessary on the part of the person who was using a name in selling his goods in such a way as to lead people to believe that they were the goods of another person. * * * It is not necessary to establish fraudulent intention in order to claim the intervention of the court." See chapter 2, § 59. See article on "Fraud in Unfair Competition," 16 Harv. Law Rev. (1893) p. 272.

other, to the damage of the latter.[18] A court of equity will enjoin the infringement of a technical trade-mark which has been occasioned by accident or misunderstanding, without actual fraud on the part of the infringer, but it will not enjoin the imitation of labels, bill heads, and commercial names of a rival trader unless such imitations are fraudulently designed, and have a tendency to occasion damage.[19] The relief granted in such cases is based upon the right of a trader to be protected from dishonest competition, and, where it is apparent that fraud is being practiced, the court will not particularly concern itself about the means by which it is being accomplished.[20]

§ 211. No Exclusive Right in Complainant.

Where the question is simply one of unfair competition in trade, it is not essential that there should be an exclusive or proprietary right in the words or labels used in order to enable the plaintiff to maintain an action, as, irrespective of any question of trade-marks, a manufacturer has no right by imitative devices to beguile the public into buying his wares under the impression that they are buying those of a rival.[21] In fact, the distinguishing feature of cases of

[18] See St. Louis Carbonating & Mfg. Co. v. Eclipse Carbonating Co. (1894) 58 Mo. App. 411.

[19] American Brewing Co. v. St. Louis Brewing Co. (1891) 47 Mo. App. 14; Plant Seed Co. v. Michel Plant & Seed Co. (1886) 23 Mo. App. 579; McLean v. Fleming (1877) 96 U. S. 245.

[20] Weinstock, Lubin & Co. v. Marks (1895) 109 Cal. 529.

[21] McLean v. Fleming (1877) 96 U. S. 245; New York Cab Co. v. Mooney (1884) 15 Abb. N. C. (N. Y.) 152; Trask Fish Co. v. Wooster (1888) 28 Mo. App. 409; City of Carlsbad v. Tibbets (1892) 51 Fed. 852; Van Horn v. Coogan (1894) 52 N. J. Eq. 380; Coats v. Merrick Thread Co. (1893) 149 U. S. 562; The Fair v. Morales (1899) 82 Ill. App. 499; Reckitt & Sons v. Kellogg (1898) 28 App. Div. (N. Y.) 111; Sawyer v. Horn (1880) 1 Fed. 24; Cleveland Stone Co. v. Wallace (1892) 52 Fed. 431; Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608; Leclanche Battery Co. v. Western Electric Co. (1885) 23 Fed. 276; Powell v. Birmingham

unfair competition is the protection of one who has no technical trade-mark, and hence no exclusive property right.[22] A court of equity will thus restrain the fraudulent imitation of a mark, package, or label by which the public may be misled, to the injury of the original user, by one who might rightfully use it under circumstances which relieve from the imputation of fraud.[23] Hence, where a person has established a business in the manufacture and sale of goods, and carries it on under a given name or mark, whether the words or devices adopted by him constitute a trade-mark or not, another person cannot assume the name or mark, or the same, with a slight alteration, in such a way as to induce others to deal with him in the belief that they are

Vinegar Brewery Co. (1896) 65 Law J. Ch. 563; Croft v. Day (1843) 7 Beav. 84. In Montgomery v. Thompson [1891] App. Cas. 217, Lord Herschell said: "The respondents are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so because the practical effect of such restraint may be much the same as if the persons seeking the injunction had a right of property in a particular name."

[22] Weinstock, Lubin & Co. v. Marks (1895) 109 Cal. 529; Clark Thread Co. v. Armitage (1895) 67 Fed. 896; Newman v. Alvord (1872) 51 N. Y. 189; William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co. (1882) 11 Fed. 495.

[23] Sawyer v. Horn (1880) 1 Fed. 24. Even where there is no exclusive right to the use of a word, such as "American," as a trademark, a person who uses signs and devices containing the word for the purpose of advertising the sale of his goods will be protected from the fraudulent imitation of such signs and devices by others for the purpose of representing their goods as those of his manufacture, and, when the fraudulent interference is apparent, the device adopted for this purpose is immaterial. American Brewing Co. v. St. Louis Brewing Co. (1891) 47 Mo. App. 14; McLean v. Fleming (1877) 96 U. S. 245; Plant Seed Co. v. Michel Plant & Seed Co. (1886) 23 Mo. App. 579; Pierce v. Guittard (1885) 68 Cal. 68. See Apollinaris Co. v. Brumler (1890) Cox, Manual Trademark Cas. 684, note.

dealing with the person who has given the reputation to the name or mark.[24] As said in one case: "Under the circumstances, but one conclusion is admissible, and that is that the defendant intended, by putting up its cordial in the manner described, to deceive the public, and to deprive the complainant of a portion of its patronage by representing its own goods to have been manufactured by the complainant. In the light of these facts it is not very material whether complainant has an exclusive property in the word 'Benedictine,' as applied to its cordial, or has or has not a technical trademark entitling it to protection under treaty stipulation, as, in any event, the law will not permit a person to disguise goods of his own production as those of some other manufacturer, for the purpose of purloining the latter's custom and deceiving the public, although he may make use of no words or symbols except such as, standing by themselves, and in an ordinary relation, are common property. * * * Yet this is precisely what the distilling company seems to have done, and still threatens to do. It could have had no possible motive for representing its goods to be of foreign manufacture, and for adopting the same dress, down to the minutest detail, that complainant's goods have long worn, unless it was to profit by the reputation of complainant's goods, and enable it to make a successful inroad upon complainant's trade."[25]

§ 212. Fraud of Complainant.

The equitable rule that the plaintiff cannot obtain relief

[24] Pierce v. Guittard (1885) 68 Cal. 68, citing, with approval, Lee v. Haley (1869) 5 Ch. App. 155, and McLean v. Fleming (1877) 96 U. S. 245.

[25] Societe Anonyme, etc., v. Western Distilling Co. (1890) 43 Fed. 416; McLean v. Fleming (1877) 96 U. S. 245; Avery v. Meikle (1883) 81 Ky. 73; Croft v. Day (1843) 7 Beav. 84; Newman v. Alvord (1872) 51 N. Y. 192; Wotherspoon v. Currie (1872) L. R. 5 H. L. 512; Sawyer v. Horn (1880) 1 Fed. 24; Carson v. Ury (1889) 39 Fed. 779.

from the fraudulent acts of another unless he comes into court with clean hands applies to cases of this character, as well as to cases of technical trade-mark, or trade-name,[26] and often prevents plaintiff from securing an injunction against a party who is in fact guilty of unfair competition. Thus, where it appeared that a manufacturer of cigars placed in each box thereof a printed statement that only the best grades of Havana tobacco were used in the cigars, which were guaranteed to be of choice Havana tobacco, while in fact the cigars contained a considerable portion of inferior tobacco, not Havana, and, in some instances, no Havana tobacco at all, it was held that the misrepresentation prevented the manufacturer from securing relief against an imitator of his labels and advertisements, who was clearly guilty of unfair competition.[27]

In a recent case it appeared that the plaintiff used the

[26] See chapter 13, §§ 314-320.

[27] Hilson v. Foster (1897) 80 Fed. 896; Connell v. Reed (1880) 128 Mass. 477. An article which has been sold for a number of years with increasing demand presumptively has a value which entitles the owner to protection against unfair competition. This was established in the various *Hostetter* cases. *In Hostetter Co. v. Martinoni* (1901) 110 Fed. 524, it was said: "But the court need only concern itself with inquiry as to the merits of the preparation to the extent of discovering whether it has sufficient merit to justify the court in protecting complainant's rights therein; whether complainant has come into court with clean hands, under the fundamental principle that he who seeks equity must do equity. The preparation is designed for the use of the public; the public has tested it for a great number of years, and has stamped it with its seal of approval, as evidenced by the increased demand for the preparation. This is certainly proof of its commercial value, and presumptively establishes the fact that it possesses merit." See, also, Hostetter Co. v. William Schneider Wholesale Wine & Liquor Co. (1900) 107 Fed. 705; Hostetter Co. v. Sommers (1897) 84 Fed. 333. As to the deceptive use of geographical names, see Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218, 2 S. Ct. 436; Siegert v. Abbott (1883) 61 Md. 276; Hoochens v. Hoochens (1902) 51 Atl. 822.

name "Old Country Soap" on soap manufactured in the United States, for the purpose of inducing persons who had come to this country from Europe to believe that the soap was made in the old country. The court said: "I have no doubt whatever that the purpose of plaintiff is to make the people in a German community believe that its soap is manufactured in Germany, or at least from a recipe coming from that country, and, in an English community, that it is a soap manufactured in England, or at least from a recipe coming from England, and so on in all other communities having a foreign population. One of plaintiff's advertisements used in the argument by consent of parties tends to show that such is plaintiff's purpose, and yet the fact is that plaintiff's soap is made in Chicago, Ill., and is manufactured by an Illinois corporation, as successor of Mr. Wrisley, an American citizen. The long and short of this matter is that complainant comes into court upon proof that tends to show that it is practicing a deception, and has been for years. * * * Plaintiff does not come into court with the right to maintain its action in thus practicing this deception."[28] But it is not every departure from the strict truth which will be fatal to the plaintiff's case, especially where no one can reasonably be misled thereby. Thus, the fact that the wrapper in which medicine is placed upon the market contains erroneous statements that the compound is purely vegetable, where the same wrapper truthfully gives the formula in accordance with which it is made, is not such fraud as will defeat the right of the manufacturer to relief from unfair competition.[29]

[28] Allan B. Wrisley Co. v. Iowa Soap Co. (1900) 104 Fed. 548. See the recent decision of the United States supreme court in Worden v. California Fig Syrup Co. (1903) 102 O. G. 623. See, also, Sterling Silk Mfg. Co. v. Sterling Silk Co. (1900) 59 N. J. Eq. 394.

[29] Centaur Co. v. Robinson (1899) 91 Fed. 889.

§ 213. Misrepresentation as to Articles not Involved in Suit.

The complainant's right to relief in equity cannot be defeated because he has been guilty of fraud in misrepresenting to the public the origin of an article manufactured by him, but which is not involved in the suit. Thus, in one case it was contended that the complainant was not entitled to the favorable consideration of the court because he was engaged in selling bluing of his own manufacture under the title of "Germania and Bavarian Blues;" that this was a fraud on the public, as the blues thus sold were not of foreign product, and therefore the complainant did not come into court with clean hands. It was not shown that the complainant advertised the articles sold under the names of Germania and Bavarian Blues as being in fact of foreign make any further than that such might be the inference from the use of the words "Germania" and "Bavarian." "But if that were true," said the court, "the complainant is not seeking protection for its business in selling Germania or Bavarian Blues. It asks the aid of the court to protect it against unfair competition in the business of selling the commodities known under the names of 'American Wash Blue' and 'American Ball Blue,' and it is not claimed that it has committed any fraud upon the public in connection with this business, and therefore it is not a case for the application of the rule invoked by defendants."[30]

§ 214. Laches of Complainant.

It is possible for a party to deprive himself of the right to proceed against a competitor who is guilty of unfair competition in trade by mere delay, so that even a wrongdoer may sometimes successfully defend on this ground.[31] It must,

[30] Heller & Merz Co. v. Shaver (1900) 102 Fed. 882.

[31] See ante, c. 5, §§ 105-109; post, c. 13, § 313.

however, be such delay as would lead a reasonable person to suppose that the owner had abandoned his device, or such as induced defendants to act under such circumstances as required the owner to assert his right. Each case must be decided upon its own facts, as there can be no fixed rule. Time is only a matter of evidence, to be considered in connection with other matters.[32] Thus, in one case the court said: "There is no evidence in this case that the defendants were encouraged or misled into their wrongful acts, or that the plaintiffs were silent when they were called upon to speak. The evidence shows that they moved with as much celerity as was consistent with a proper vindication of their right. The delay seems to have been no greater than was necessary for a prudent, careful preparation for the legal conflict."[33] Another case presented the question whether, after the defendant had used a certain name for nearly thirty years publicly and notoriously, with no interposition on the part of the complainants, the latter could be heard to assert the right to an injunction. "It is impossible," said the court, "that the owners of the natural waters should not have known that, wherever they were extensively sold, artificial waters were being made and sold extensively by the same name. If the artificial waters had been made and sold as purporting to be the natural waters, there would be less equity in the defense of laches and acquiescence; but they were not,—they were made and sold to supply a demand for artificial waters, having properties similar to those of the natural water. It is very late to ask the intervention of equity to suppress a course of business which originated innocently, and has been so generally adopted. Equity is indisposed to assist parties who have slept upon their rights and acquiesced in their appro-

[32] Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

[33] Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

priation by others for a great length of time. The unexampled delay and acquiescence in the present case, I think, should defeat the action."[34]

§ 215. Parties Misled.

The rule which protects against unfair competition is primarily for the protection of the party against whom such competition is directed, and only incidentally for the protection of the public. In some of the cases language is used which would suggest that the public is under the protection of the court, but in fact the liability of the article to mislead the public is only an element of proof in the plaintiff's case, the evidence showing that he has been or may be injured by the fraudulent acts of the defendant. The court, therefore, does not interfere for the purpose of preventing the public from being misled, except in so far as it is necessary to protect the owner of a business from its fraudulent invasion by others.[35] If what is done tends to mislead the public, it naturally diverts customers from the complainant, to the injury of his business.[36] The prohibition is upon so acting as to beguile the public, and thus mislead an intending purchaser into buying the goods of one person, under the belief that he is buying those of a rival.[37] But the mere possibility that an extremely ignorant or careless person may be deceived is not the test, and it need not be made to appear that some particular person has actually been deceived.[38] It is presumed

[34] La Republicque Francaise v. Schultz (1899) 94 Fed. 500, citing Woodmanse & Hewitt Mfg. Co. v. Williams (1895) 37 U. S. App. 109, 15 C. C. A. 520, 68 Fed. 489.

[35] Levy v. Walker (1878) 10 Ch. Div. 436, 448. See chapter 9, §§ 187-191.

[36] Holbrook v. Nesbitt (1895) 163 Mass. 120.

[37] Coats v. Merrick Thread Co. (1893) 149 U. S. 566, 13 S. Ct. 966.

[38] Bolen & Byrne Mfg. Co. v. Jonasch (1899) 29 Misc. Rep. (N. Y.)

that purchasers will be persons of ordinary intelligence[39] and caution, and that they will exercise ordinary care.

So, regard must be had to the class of persons who purchase the particular article for consumption, and the circumstances ordinarily attending such purchases.[40] Thus, the fact that articles under a similar wrapper or label are generally sold in a community where the people are mostly unable to read or write is properly taken into consideration.[41] The test is whether ordinary purchasers, as distinguished from the members of a particular trade, are liable to be misled.[42] In determining whether packages are so dressed as to be calculated to deceive persons, equity regards the consumer, as well as the middle man, for it is to him, more than to the jobber or wholesale purchaser, that the various *indicia* of origin appeal.[43] It is therefore not a defense to show that no deception is in fact practiced on those with whom the defendant deals personally, as an injunction will be granted if the ultimate consumers to whom the goods are intended to be resold are or may be deceived.[44] As held in one case: "Where imitation of packages, stamps, and letters is complained of,

99; Jay v. Ladler (1888) 40 Ch. Div. 649; Von Mumm v. Frash (1893) 56 Fed. 830.

[39] Hildreth v. D. S. McDonald Co. (1895) 164 Mass 16. Where the label or device used is manifestly and entirely dissimilar, so that a person of ordinary prudence and caution could not be deceived into buying one article for the other, an action will not lie. Alff v. Radam (1890) 77 Tex. 530.

[40] C. F. Simmons Medicine Co. v. Simmons (1897) 81 Fed. 163; N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 23 C. C. A. 554, 77 Fed. 869; Tallcot v. Moore (1875) 6 Hun (N. Y.) 106.

[41] C. F. Simmons Medicine Co. v. Simmons (1897) 81 Fed. 163.

[42] R. Heinisch's Sons Co. v. Boker (1898) 86 Fed. 765.

[43] C. F. Simmons Medicine Co. v. Simmons (1897) 81 Fed. 163; N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 23 C. C. A. 554, 77 Fed. 869; McLean v. Fleming (1877) 96 U. S. 245.

[44] Southern White Lead Co. v. Cary (1885) 25 Fed. 125.

the question is whether there is such similarity as is likely to impose on ordinary purchasers, exercising such care only as is commonly used in purchasing the article in question. When this question cannot be answered with certainty or safety, and there is no proof that any one has actually been misled, a preliminary injunction is properly denied."[45]

An intending purchaser of an article in the market is not bound to be careful or to compare labels under which similar articles are sold. Where a manufacturer has built up an extensive trade in his product, which has become known by a certain name, and a second manufacturer of a similar article places it on the market under the same name, and in packages so similar as to deceive the unwary and careless, such facts are evidence of intended imposition, which entitles the first manufacturer to an injunction, although he is not entitled to the exclusive use of the name as a trade-mark.[46] The court must in all cases use its judgment as to the similarity of packages and labels, and the fact that others may differ from it in opinion, or that a few isolated purchasers have been misled, does not necessarily bind it.[47] Hence, in determining whether a person of ordinary intelligence would be misled by the alleged facts, the court is not necessarily controlled by the fact that the evidence shows that certain witnesses were in fact misled in making purchases of the goods of the one party for those of another. In the Lorillard Case, Mr. Justice Brewer said: "We cannot surrender our own judgment in this matter because others may be of a different opinion, or because it happens, in isolated instances, that some purchaser was so careless as not to detect the differences. It

[45] Van Camp Packing Co. v. Cruikshanks Bros. Co. (1898) 33 C. C. A. 280, 90 Fed. 814.

[46] Centaur Co. v. Robinson (1899) 91 Fed. 889.

[47] P. Lorillard Co. v. Peper (1893) 30 C. C. A. 496, 86 Fed. 956. See chapter 9, §§ 190-193.

may well be that, where many sales were made, some individuals, not particularly attentive, may have purchased the defendant's, supposing they were purchasing the plaintiff's, package. Such things will happen in the ordinary course of business, no matter how great the differences; and the fact that they do happen, while it is not to be ignored, is not to outweigh the evidence which comes from a personal inspection of the packages and labels."[48]

II. Illustrations and Conditions under Which Relief is Granted.

§ 216. Use of Corporate Name.

The right to a corporate name is ordinarily protected by positive statute, and sometimes may be protected as a trade-name,[49] but, in the absence of such a statute, and when it cannot be considered a technical trade-name, it will be protected under the general principles which govern unfair competition. Thus, the outgoing stockholders of a corporation, the most distinguishing part of whose names the corporation bears, have no right to compete in business under a corporate name so nearly like the first as to mislead customers.[50] Equity will restrain the use of a name which has become, with other *indicia,* the chief means in commerce of distinguishing a proprietary article of merchandise from others of the same class, even where the infringer has acquired the

[48] P. Lorillard Co. v. Peper (1898) 30 C. C. A. 496, 86 Fed. 956.

[49] See chapter 8, §§ 167-176.

[50] Van Auken Co. v. Van Auken Steam Specialty Co. (1895) 57 Ill. App. 240; Hazleton Boiler Co. v. Hazleton Tripod Boiler Co. (1891) 137 Ill. 231; Merchants' Detective Ass'n v. Detective Mercantile Agency (1888) 25 Ill. App. 250; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co. (1870) 37 Conn. 278. As to use of personal name as a part of a corporate name, see infra, § 238. See, also, chapter 8, § 172.

name through the instrumentalities of the laws for the incorporation of business companies, if he has done so with the fraudulent intent of stealing the trade of another.[51]

§ 217. Disclosure of Trade Secrets.

Many articles of great value are manufactured under secret, but not patented, processes, which necessarily become known to the employes of the manufacturer. Unless the law protected the owners of these secret processes, each employe

[51] Charles S. Higgins Co. v. Amalga Soap Co. (1894) 10 Misc. Rep. (N. Y.) 268; Charles S. Higgins Co. v. Higgins Soap Co. (1895) 144 N. Y. 462, 39 N. E. 490; Cohn v. Gottschalk (1888) 16 N. Y. St. Rep. 818; Fischer v. Blank (1893) 138 N. Y. 244; Enoch Morgan's Sons' Co. v. Troxell (1881) 23 Hun (N. Y.) 632, 640; Newman v. Alvord (1872) 51 N. Y. 189; Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co. (1870) 37 Conn. 278; Hendriks v. Montagu (1881) 50 Law J. Ch. 456, 17 Ch. Div. 638; Merchants' Detective Ass'n v. Detective Mercantile Agency (1888) 25 Ill. App. 250; Le Page Co. v. Russia Cement Co. (1892) 2 C. C. A. 555, 51 Fed. 941; Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 664; McLean v. Fleming (1877) 96 U. S. 245. In Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94, Mr. Justice Bradley said: "As to the imitation of the complainant's name, the fact that both are corporate names is of no consequence in this connection. They are the business names by which the parties are known and are to be dealt with precisely as if they were the names of private firms or partnerships. The defendant's name was of its own choosing, and, if an unlawful imitation of the complainant's, is subject to the same rules of law as if it were the name of an unincorporated firm or company. It is not identical with the complainant's name. That would be too gross an invasion of the complainant's right. Similarity, not identity, is the usual recourse when one party seeks to benefit himself by the good name of another." Quoted in Peck Bros. & Co. v. Peck Bros. Co. (1902) 113 Fed. 291, which cites R. W. Rogers Co. v. Wm. Rogers Mfg. Co. (1895) 17 C. C. A. 576, 70 Fed. 1017; Investor Pub. Co. of Massachusetts v. Dobinson (1896) 72 Fed. 603; Charles S. Higgins Co. v. Higgins Soap Co. (1895) 144 N. Y. 462, 39 N. E. 490, 27 L. R. A. 42, 43 Am. St. Rep. 769; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co. (1870) 37 Conn. 278, 9 Am. Rep. 324.

could, as soon as he learned the secrets of his employer, set up an establishment of his own, and thus appropriate valuable processes which his employer may have spent much money and time in discovering and developing. To prevent this, the manufacturer of such articles generally requires his employes to agree not to disclose or use the trade secrets which must thus necessarily be imparted to them. Such contracts are not against public policy, as being in restraint of trade. As said in one case: "It is settled that a secret art is a legal subject of property, and that a bond for a conveyance of the exclusive right to it is not open to the objection of being in restraint of trade, but may be enforced by action at law, and requires the obligor not to divulge the secret to any other person."[52] And in another, "Here is a party which, by the expenditure of vast sums of money, and the exercise of much skill and ingenuity, has built up a large and prosperous business, the capital of which consists largely in certain inventions and discoveries made by its officers, servants, and agents. The world at large knows nothing of these inventions and discoveries, because they are locked within the brain of those who conceive them. The defendants, who have been largely instrumental in perfecting them, while under both an express and implied contract to give the plaintiff the benefit of their inventive genius, propose now to disregard their legal and moral obligations, by creating a new establishment, where these inventions and discoveries may be employed, to plaintiff's serious injury. This is not legitimate competition, which it is always the policy of the law to foster and encourage, but it is *contra bonos mores*, and constitutes a breach of trust which a court of law, and much more a court of equity, should not tolerate."[53] But there are limits to the ap-

[52] Peabody v. Norfolk (1868) 98 Mass 452, 96 Am. Dec. 664.

[53] Eastman Kodak Co. v. Reichenbach (1894) 79 Hun (N. Y.) 183.

plication of this rule. In one case it appeared that the trade-mark and proprietary right to White Cochin Cocoanut Oil Soap, known as "Coal Oil Johnny Soap," was in one Jenkins, and that any one could manufacture the soap for him, provided he knew how to do it, as no secret process was involved. One Grant, who had special skill in compounding the soap, agreed with the plaintiff's assignor to erect a soap plant for the manufacture of White Cochin Cocoanut Oil Soap,—"the same kind of soap now being supplied Maross Jenkins, and known as 'Coal Oil Johnny Soap';" also to surrender all his rights, and all processes and formulae, and that he would not sell any plants in the United States for that

See, also, O. & W. Thum Co. v. Tloczynski (1897) 114 Mich. 149, 38 L. R. A. 200, citing Peabody v. Norfolk (1868) 98 Mass. 452, 96 Am. Dec. 664; Vickery v. Welch (1837) 19 Pick. (Mass.) 523; Taylor v. Blanchard (1866) 13 Allen (Mass.) 373, 374, 90 Am. Dec. 203; Jarvis v. Peck (1843) 10 Paige (N. Y.) 118; Salomon v. Hertz (1885) 40 N. J. Eq. 400; Simmons Hardware Co. v. Weibel (1891) 1 S. D. 488, 11 L. R. A. 267; Eastman Kodak Co. v. Reichenbach (1894) 79 Hun (N. Y.) 183; Morison v. Moat (1852) 21 Law J. Ch. 248, 9 Hare, 241; High, Inj. (2d Ed.) p. 15; Hammer v. Barnes (1863) 26 How. Pr. (N. Y.) 174; Champlin v. Stoddart (1883) 30 Hun (N. Y.) 300; Tabor v. Hoffman (1889) 118 N. Y. 30; Bristol v. Equitable Life Assur. Soc. (1892) 132 N. Y. 264-267; 1 Story, Eq. Jur. § 323; 2 Story, Eq. Jur. § 952, and many cases there cited; 10 Am. & Eng. Enc. Law, 949; High, Inj. § 19; Davies v. Clough (1837) 8 Sim. 262; Williams v. Prince of Wales Life, etc., Co. (1852) 23 Beav. 338; Yovatt v. Winyard (1820) 1 Jac. & W. 394; Tipping v. Clarke (1843) 2 Hare, 393; Little v. Gallus (1896) 4 App. Div. (N. Y.) 569; Tuck v. Priester (1887) 19 Q. B. Div. 629; Pollard v. Photographic Co. (1888) 40 Ch. Div. 345. The court distinguished the following: Newbery v. James (1817) 2 Mer. 446; Williams v. Williams (1817) 3 Mer. 157; Kimberley v. Jennings (1836) 6 Sim. 340; Voorhies v. Frisbie (1873) 25 Mich. 482, 12 Am. Rep. 291; Blanchard v. Detroit, L. & L. M. R. Co. (1875) 31 Mich. 43, 18 Am. Rep. 142; Bumpus v. Bumpus (1884) 53 Mich. 346; C. F. Simmons Medicine Co. v. Simmons (1897) 81 Fed. 163, citing and quoting from Gibbs v. Consolidated Gas Co. of Baltimore (1889) 130 U. S. 396, 9 S. Ct. 553.

particular manufacture for the term of twenty years. The following year he erected for defendants' assignors a similar plant, ostensibly for green soaps, but which would make any soap manufactured by the "cold-water process," and the defendants manufactured a White Cochin Cocoanut Oil Soap, under the name of "Coal Oil Johnny Soap." It was held that Grant's contract did not prevent him from erecting a plant, as he had done, for the manufacture of soap in general, and that, in the absence of proof of knowledge in the defendants of the rights which Grant had sold to the assignors of the plaintiff, the mere fact that defendants had diverted the plant to the manufacture of "Coal Oil Johnny Soap" did not impose a liability upon them. Nor did the further fact that Grant had furnished to defendants' assignors an operator who, in a lawful way, had learned how to manufacture "Coal Oil Johnny Soap," give the plaintiff a right to an injunction against defendants, and his remedy, if any, was against Grant.[54]

§ 218. Ex-partner—Use of Information by.

Where a member of a partnership avails himself of information obtained by him in the transaction of the partnership business, or by reason of his connection with the firm, for any purpose of the partnership business, or for any purpose which would compete with the partnership business, he is liable to account to the firm for any profit he may obtain from the use of such information. If, however, he uses the information for purposes which are wholly without the scope of the partnership business, and not in competition with it, the firm is not entitled to an accounting of such benefit. Thus, where a member of a firm of ship brokers, styled

[54] Bell & Bogart Soap Co. v. Petrolia Mfg. Co. (1898) 25 Misc. Rep. (N. Y.) 66.

"H. & C. Co.," assisted in the formation of a general stock company for building ships, and in so doing availed himself of information obtained as a member of the firm, and occasionally used the name and office paper of the firm in his correspondence on that subject, and received a remuneration for his services in the formation of the company, and threatened to engage in the business of a ship owner under the name of "H. C. Co., Ship Owning," it was held, in an action by the partners to restrain him from using the name of the firm in a separate business, and asking for an account of his profits and salary in connection with the new company, that defendant would be restrained from using the name "H. C. Co.," but that, as the business of the new company was beyond the scope and did not compete with the partnership business, the defendant was not bound to account for the benefit obtained by him in connection with the new company. The use by the defendant of the name and paper of the "H. C. Co." in promoting the ship-building company was held not to be sufficient to show that, as between defendant and his partners, ship building was within the scope of the partnership business.[55]

§ 219. Advertising as "Late With"—"Successor to."

In the absence of a prohibitory contract, an employe who severs his connection with an establishment with which he is employed, and engages in business for himself in opposition to his late employer, may advertise the fact of his former employment, provided he does it in such a way as not to induce customers or the public to believe that he is carrying on the business for the establishment from which he has retired.[56] Merely advertising a person as "late with" a well-

[55] Aas v. Benham, (1891) 2 Ch. 244.

[56] Sanders v. Bond (1891) 47 Mo. App. 363.

known firm, with the evident purpose of thereby drawing a part of the custom of the old firm, is not in itself unfair competition, and hence a person who was formerly in the employ of a firm, and who engages in similar business, may display upon the sign under his name the words "late with" such firm, but he must not arrange the matter in such a manner as to deceive the public.[57] A party, who had been an employe as watchmaker and clerk for a jeweler, left his employer and opened a store a few doors from the place of business of his former employer, and put up a sign which read, "A. Herowitz, late with J. P. Van Wyck." It was held that he had a right to use this sign.[58]

One E. P. began, in 1844, in Paris, France, the business of manufacturing toilet preparations, which became well and favorably known in Europe and the United States in connection with the name of E. P. The business was continued by the firm of which E. P. was a member, under the name of "Parfumerie E. P.," and by the plaintiff, to whom the business and all the trade-marks were sold. In 1895 the defendant, who had been in plaintiff's employ, began the manufacture and sale of certain toilet preparations with the same names as plaintiff's, which were manufactured in the United States, but were marked with labels in the French language, so devised as to give the impression that the goods were French. Defendant also placed on his labels a statement that he was "formerly with" the Parfumerie E. P., and arranged the names in such a manner as to give the impression that the latter was the name of the manufacturer. He also placed

[57] Holbrook v. Nesbitt (1895) 163 Mass. 120, 39 N. E. 794. In Marcus Ward & Co. v. Ward (1891) 15 N. Y. Supp. 913, affirmed 61 Hun, 625, it was held that the defendant could not be enjoined from advertising as "Marcus Ward's Son."

[58] Van Wyck v. Horowitz (1886) 39 Hun (N. Y.) 237, reversing 16 Abb. N. C. 121.

on the labels a picture which closely resembled a picture used on the plaintiff's labels, and it was held that, as it appeared that the defendant was attempting to palm off his goods as those of the plaintiff, the use of such labels should be enjoined.[59]

The words used must be such as to convey the true nature of the former connection of the party with his employer. Hence, where the defendant had been the business manager of a corporation whose business was the preparation and sale of certain medicines, and who had nothing to do with the compounding and putting up of such medicines, he was restrained, at the suit of the successor of such corporation, from advertising himself in his subsequent business operations as "late manager" of the former company, because it conveyed the false impression that he had managed the compounding and putting up of the medicines.[60] A retail dealer cannot properly advertise himself as the "successor to" a wholesale business which was simply discontinued without a "successor."[61]

§ 220. Oral Statements.

Although it has been determined that another manufacturer has the right to use labels and packages containing a name similar to that used by the complainant, a dealer, in the goods of such manufacturer, will be enjoined from making oral representations which tend to confuse the goods of the two manufacturers in the minds of the purchasers. In a recent case in the United States circuit court for the Southern district of New York it was said: "In view of the decision

[59] Klotz v. Hecht (1896) 73 Fed. 822.

[60] Humphrey's Homeopathic Medicine Co. v. Bell (1888) 15 Daly (N. Y.) 6.

[61] Nolan Bros. Shoe Co. v. Nolan (1900) 131 Cal. 271, 53 L. R. A. 384.

of the case against Wilhelmina Weber in the Eastern district, complainant is not entitled to any relief which will interfere with the labels or manner of packing the goods complained of. The further representation, however, of the defendant, when selling, that such tea is 'Weber's Tea,' is an independent act, not considered in the former suit. He may sell the packages which Wilhelmina is allowed to put up, and which represent the goods as 'genuine imported Alpine herb tea, manufactured by F. G. Weber & Co.,' and may repeat that representation orally; but when he further represents the contents to be 'Weber's Tea,' his statements, as the affidavits show, tend to produce a confusion of goods, against which the public should be protected. The prayer for relief seems to be broad enough to warrant an injunction against selling any preparation not manufactured by complainant upon the representation that it is 'Weber's Tea'."[62] To that extent the complainant was held entitled to a temporary injunction.

§ 221. Monopoly of Material.

The fact that a person has obtained a monopoly of the material from which his goods are manufactured gives him no broader rights to protection in his trade-mark or trade-name, or against unfair competition on the part of his competitors. A bill alleged that the complainantwas the manufacturer of a washboard having its rubbing face made of aluminum, and on which it used the name "Aluminum" as a trade-mark or trade-name; that it was the only manufacturer of such boards in the country, having secured a monopoly of all sheet aluminum produced which was suitable for use in their manufacture. It was also alleged that defendant had placed on the market a washboard on which he had used the word "Aluminum," by

[62] Weber Medical Tea Co. v. Kirschstein (1900) 101 Fed. 580.

reason of which the public was deceived into buying it as a genuine aluminum washboard, although there was in fact none of that metal in its composition. It was held that the bill did not state facts which entitled complainant to relief, as it was not shown that purchasers bought defendant's boards in the belief that they were made by the complainant, and any direct injury resulting to complainant could only be by reason of its monopoly, which could not afford ground for equitable relief against a competitor. "We are not referred to any case," said the court, "nor can we think of any reason why one who has obtained a monopoly in the material of which his goods are made should have any broader rights in protecting his trade-name than another, who is engaged in competition in the same line of business."[63]

§ 222. Selling Inferior Goods under Similar Name.

A person who was not a manufacturer or a dealer, but a philanthropic scientist, originated and freely gave to the world a system of all-wool underwear. The firm who manufactured and sold such underwear in strict accordance with such system, under an arrangement with the scientist, used his name in connection therewith, but had no proprietary right to the use of such name. In an action by the assignee of such firm to enjoin defendant from selling such underwear, it appeared that defendant, in the use of such name to designate the kind and quality of his goods, sold as the same kind of underwear an inferior article, containing a substantial admixture of cotton. It was held that such use was a deceptive misrepresentation, and constituted unfair competition, against which plaintiff was entitled to relief, and that in such case the defendant would be enjoined from advertising or in any way

[63] American Washboard Co. v. Saginaw Mfg. Co. (1900) 46 C. C. A. 233, 103 Fed. 281.

representing that the underwear sold by him, containing an admixture of cotton, was the kind and quality of underwear designated by the use of such name, and from using the originator's name in connection with the word "genuine," or other words so used, and from advertising or representing his underwear by any designation containing such name alone, or in combination with other words.[64]

[64] Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutillier (1893) 5 Misc. Rep. 78, 24 N. Y. Supp. 890, citing Read v. Richardson (1881) 45 Law T. (N. S.) 54; Apollinaris Co. v. Scherer (1886) 27 Fed. 18; Cellulold Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94; Von Mumm v. Frash (1893) 56 Fed. 830; Anheuser-Busch Brewing Ass'n v. Piza (1886) 24 Fed. 149. See chapter 4, § 86. Sale of inferior goods under imitative label, see Garrett v. T. H. Garrett & Co. (1896) 24 C. C. A. 173, 78 Fed. 472. In Russia Cement Co. v. Katzenstein (1901) 109 Fed. 314, it appeared that for a number of years the complainant had manufactured and sold glue of different grades under the general name of "Le Page's Glue," with further designations to denote grade and quality. The highest grade was known as "Le Page's Liquid Glue," and the lowest as "Le Page's Fish-Head Glue." The defendants purchased a quantity of the latter from the complainants, and put it up in bottles with distinctive labels, stating correctly that it was manufactured by complainants, and bottled by defendants, but on them printed the name "Le Page's Liquid Glue." It was held that this use of an inferior grade in connection with a trade-mark which had become known in connection with the complainant's best grade constituted unfair competition. The court said: "The test in this case must be, was there an intent on the part of these defendants, by the unauthorized use of the trade-mark and words specifying a grade of complainant's commodity, to palm off the goods bought by them from the manufacturer for a better or different quality? The proofs clearly show that the defendants purchased a less expensive grade of glue than the liquid glue. No remedy lies to restrain these defendants from truthfully advising the trade that glue sold by them is manufactured by complainant. The defendants' commodity cannot be successfully assailed when it discloses truthfully the source of its manufacture. Gillott v. Kettle (1854) 3 Duer (N. Y.) 624; Hennessy v. Hogan (1869) 6 Wyatt. W. & A'B. Eq. 225; Condy v. Taylor (1887) 56 Law T. (N.

§ 223. Imitation of Signs.

All practices between business rivals which tend to engender unfair competition are odious, and will be suppressed by injunction; hence no man will be permitted to make use of signs or tokens which serve to confuse the identity of his business with that of another, or to mislead the public, and thus divert custom from his competitor to himself. Where it appeared that the defendant had intentionally used signs in imitation of those theretofore adopted by the plaintiff, and had done so for the purpose of advertising beer brewed by it as the product of plaintiff's brewery, and that the imitation was sufficiently close to deceive the public, it was held that the plaintiff was entitled to enjoin the further use of such signs by defendant.[65] The same principle was applied to protect an auctioneer in the use of an advertising flag. For several years a real-estate auctioneer had been selling suburban property on the installment plan, and had used in his business, and had printed with his extensive newspaper advertisements, a representation of a flag with stars studding the upper and lower borders in an effective and striking way. The de-

S.) 891. The deceit lies in the fact that the glue is placed on the market by the defendants as a liquid glue of different grade and quality than that bought by defendants in bulk from complainant." In Hostetter Co. v. Martinoni (1901) 110 Fed. 524, it appeared that plaintiffs had the exclusive right to the use of the name "Hostetter," as applied to bitters. The defendant, upon being inquired of for Hostetter's Bitters, and objection being made to the price, stated that he could sell Hostetter's Bitters in bulk at a less price, and thereupon furnished an empty Hostetter Bitters bottle, and filled it with bitters thus sold in bulk, charging a less price than that at which Hostetter's Bitters were sold. It was held that this was a fraud upon complainant's rights, regardless of the comparative quality of the preparations, and that he was entitled to an injunction.

[65] American Brewing Co. v. St. Louis Brewing Co. (1891) 47 Mo. App. 14.

fendant, who was also a real-estate auctioneer, dealing in similar property on the same plan, advertised his sales in newspapers with a representation of a flag not only calculated to, but which in fact in many cases did, deceive people, who believed that defendant's advertisements were those of the plaintiff. Defendant's flag imitated plaintiff's in the arrangement of the stars on the border, and it was held that, while defendant had as much right to use in his advertisements the picture of a flag as plaintiff, yet he had no right unfairly or fraudulently to imitate the peculiar fanciful arrangement of details which indicated to the public the plaintiff's special business sign, for the purpose of acquiring to himself the custom of the plaintiff.[66]

§ 224. Substitution of Goods.

Plaintiffs had a trade-mark in the word "Sapolio," which was used to designate a kind of soap. When persons called at the defendant's store and asked for Sapolio, their salesmen would, without explanation, deliver a soap called "Pride of the Kitchen," on which these words were plainly marked, and receive the customary price. The wrappers used on the two soaps were entirely different in size and shape, and the cakes were also different. It was held that, although the word "Sapolio" was not used on the soap, and there was no resemblance in the packages, the transaction amounted to an infringement of the plaintiff's rights, and would be enjoined. The court said: "That the act of the salesman in offering 'Pride of the Kitchen' in response to a demand for 'Sapolio' is, though done silently, a positively unlawful act, is clear. Its unlawfulness consists in an attempt to steal away the business of the complainant for the benefit of the manufacturers of 'Pride of the Kitchen.' It is clearly the object of the law

[66] Johnson v. Hitchcock (1888) 3 N. Y. Supp. 680.

of trade-marks to prevent this."[67] In a more recent case the proof disclosed a scheme by which, when a thirsty patron of certain dealers in the city of Louisville called for "Blue Lick Water," meaning the genuine Blue Lick, which was produced in Nicholas county, Kentucky, he was to be given water from the artesian well of another party. This was a fraud upon the public and upon the proprietors of the Blue Lick water, as a purchaser has a right to get what he asks for, and the owner was entitled to the profit from the sale of the article sought.[68]

§ 225. Methods of Advertising.

A manufacturer's distinctive advertisements cannot be imitated by devices which involve nothing original, and, although not identical at every point, are so similar as to be readily mistaken for the original by the ordinary purchaser.[69]

§ 226. Place of Advertisement as Affecting Fraud.

In determining the question of the effect of imitating a label or other device, it is apparent that the place where it is

[67] Enoch Morgan's Sons Co. v. Wendover (1890) 43 Fed. 420. While the language of this case refers to trade-marks, the principle upon which the court proceeded is that of unfair competition in trade. In the decision the learned court quotes the language of Mr. Justice Bradley in Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 97: "It is the object of the law relating to trade-marks to prevent one man from unfairly stealing away another's business and goodwill. Fair competition in business is legitimate, and promotes the public good; but an unfair appropriation of another's business by using his name or trade-mark, or an imitation thereof calculated to deceive the public, or in any other way, is justly punishable by damages, and will be enjoined by a court of equity."

[68] Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502, 26 S. W. 389.

[69] Hilson Co. v. Foster (1897) 80 Fed. 896.

used must be noted. Thus, the use of a name in localities not very remote from each other might justify the inference that the establishments are those of the same proprietor. In a recent Rhode Island case, where the question of locality was discussed, the court said: "The character of the name adopted by the complainant suggests a distribution of offices. It would be natural for a person reading the advertisement of the complainant in a Pawtucket paper, and seeing the signs of the defendant displayed there, to suppose that they indicated a branch office of the same concern, and this we have no doubt the defendant intended should happen. It is the only result which he could anticipate from his contrivances."[70] So, a person may use a sign or business name in one street, when he would not be permitted to do so in another. Thus, a boot maker having a shop in Bedford street, with a front entrance on the Strand, placed over his shop the words "Civil Service Boot Supply." The Civil Service Supply Association was, at the time, building a large store at the other end of Bedford street, in which, when finished, it opened a general shop. Afterwards it opened a boot and shoe shop near by, in Travistock street. It appeared that one of the customers of the association had gone to the boot maker's shop, mistaking it for the association. An action was brought to restrain the boot maker from using the words, but it was held that the evidence did not justify the inference that the boot maker intended to deceive, as no rational person could have been deceived.[71]

In commenting on another case, the vice-chancellor said: "The decision * * * did not depend upon the use of the words 'Guinea Coal Co.' * * * I said they were entitled to call themselves the Guinea Coal Company if they sold

[70] Cady v. Schultz (1895) 19 R. I. 193.
[71] Civil Service Supply Ass'n v. Dean (1879) 13 Ch. Div. 512.

coals at one guinea a ton, and that they might have called themselves so in any other place than Pall Mall; but the fraud consisted in setting up in Pall Mall, and deluding persons who went into Pall Mall to buy coals from the other company.[72]

§ 227. Expiration of Patent.

After the expiration of a patent, any one has the right to manufacture the article, and to designate it by the name by which it has become known to the public, although no one has the right to represent in any manner that his goods are actually manufactured by the original owner of the patent.[73] Courts of equity thus uphold the right of the original manufacturer of a patented article to be protected from a fraudulent imitation of the *indicia* by which such articles have been known to the trade, without regard to whether these devices had been adopted during the life of the patent, or after its expiration.[74]

§ 228. Expiration of Patent—Generic Name—Secondary Meaning of Word.

After the expiration of a patent, the public is entitled not only to manufacture the article, but also to use the name by which the article has become popularly known. The rule is well established that, where, during the life of the monopoly created by the patent, the name, whether it be arbitrary or that of the inventor, has become, by his consent, either ex-

[72] Lee v. Haley (1869) 5 Ch. App. 155, 22 Law T. (N. S.) 251.

[73] Frost v. Rindskopf (1890) 42 Fed. 408. See chapter 5, § 110.

[74] Centaur Co. v. Killenberger (1898) 87 Fed. 725; distinguishing Centaur Co. v. Heinsfurter (1898) 28 C. C. A. 581, 84 Fed. 955; Coats v. Merrick Thread Co. (1893) 149 U. S. 562, 13 S. Ct. 966; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002.

press or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created. Where another person avails himself of the public dedication to make the machine and use the generic designation, he can do so in any form with the fullest liberty, subject to the condition that the name must be so used as not to deceive the public, and deprive others of their rights. Hence, the name must be accompanied by such indications that the thing manufactured is the work of the one making it as will unmistakably inform the public of that fact.[75]

The right to manufacture Castoria according to Pitcher's patented process or formula, and the right to sell the manufactured article under the name of "Castoria," became free to all the world after the expiration of the patent; but it was held that a new manufacturer, in placing it on the market, must clearly identify his goods, and not engage in unfair competition, or do anything to deceive the public by inducing it to purchase his goods under the belief that they were those it had been accustomed to purchase under the same name.[76]

§ 229. Imitating Name of Newspaper.

A party will be restrained from assuming the name of a

[75] Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002. See chapter 5, § 110. After the expiration of a patent, another manufacturer has the right not only to make and sell the article in the same form, but also to mark it with the same or similar name, if, in connection with such name, he places thereon his own name as manufacturer in such a way as to clearly distinguish the article from those made by the original manufacturer. B. B. Hill Mfg. Co. v. Sawyer-Boss Mfg. Co. (1901) 112 Fed. 144; Rahtjen's American Composition Co. v. Holzappel's Composition Co. (1900) 41 C. C. A. 329, 101 Fed. 257; Holzappel's Composition Co. v. Rahtjen's American Composition Co. (1901) 97 O. G. 958, 183 U. S. 1, 22 Sup. Ct. 6.

[76] Centaur Co. v. Neathery (1898) 34 C. C. A. 118, 91 Fed. 891.

newspaper belonging to another person for the fraudulent purpose of imposing upon the public, and of depriving the owner of the goodwill of his paper. But to entitle complainant to the interposition of a court of chancery, the name of the paper must be used in such a manner as to be calculated to mislead or deceive the public, and thus induce them to suppose that the paper printed by defendant is the same as that which was previously being published by the complainant, and thus injure its circulation and patronage.[77]

§ 230. Fraudulent Imitation of Book Titles.

In an early case it was held that the goodwill and established trade of a publisher of books would be protected from injury by acts of deception or piracy.[78] In a recent case it appeared that the complainant had published a book entitled "Farthest North,—Nansen." It had been composed chiefly by Dr. Nansen in the Norwegian language, and translated into English. Afterwards defendants published a book under the name of "The Fram Expedition; Nansen in the Frozen World; Including Earlier Arctic Expeditions," which contained part of the same or of substantially the same literary matter as the complainant's book, and also a number of similar portraits or illustrations, together with an account of sundry earlier expeditions. It so differed from the complainant's book, however, in cover, outside title, and title page, that no one of ordinary intelligence could mistake one for the other. It was held that, in the absence of proof that defendants had practiced fraud or deception in the sale of the book, the

[77] Bell v. Locke (1840) 8 Paige (N. Y.) 75. In Barthwick v. Evening Post, 58 Law T. 252, 37 Ch. Div. 447, it was held that a person who started a paper known as the "Evening Post" was guilty of unfair competition with the proprietors of the "Morning Post."

[78] Snowden v. Noah (1825) Hopk. Ch. (N. Y.) 396.

complainant was not entitled to an injunction on the ground of unfair competition. The court said: "This is an appeal from the decree of the circuit court for the Eastern district of Pennsylvania, dismissing the bill of the appellant, complainant below. The bill charges unfair competition in trade and violation of certain alleged copyrights. The case was before this court several terms ago[79] on an appeal from an interlocutory decree awarding a preliminary injunction. On the evidence then submitted the court held that the complainant had failed to sustain its bill on either ground, and accordingly reversed the decree. The case is now before us on plenary proofs. The appellant has on the market for sale a book entitled, on its outside cover, 'Farthest North. Nansen,' which consists of an English translation of an account of the recent Norwegian polar expedition conducted by Dr. Fridtjof Nansen, composed by him in the Norwegian language, and of the report of Otto Sverdrup, relating to the drifting of the steamer Fram, composed by the latter in the Norwegian, and translated into the English, language. The appellees publish and sell a book entitled, on its outside cover, 'The Fram Expedition. Nansen in the Frozen World. Including Earlier Arctic Explorations,' containing part of the same or of substantially the same literary matter found in the appellant's book; also portraits and pictorial illustrations similar to those made use of by the appellant, and accounts of sundry Arctic explorations prior to Dr. Nansen's polar voyage. The book of the appellees so differs from that of the appellant in cover, outside title, and title page that no one of ordinary intelligence seeing both of them could confound the two. * * * If it were true that the appellees had practiced fraud or deception in palming off their book as the book of the appellant, an injunction undoubtedly would lie against such unfair and

[79] Lare v. Harper & Bros. (1898) 30 C. C. A. 373, 86 Fed. 481.

fraudulent conduct, but it would by no means follow that the injunction should be so broad as wholly to suppress the publication and sale of a book which the appellees would have a right to put on the market by fair and proper means. On the evidence, however, we are not satisfied that the appellees have practiced fraud or deception in the sale of their book."[80]

In a recent case in Pennsylvania it appeared that the plaintiffs, who were the owners of a copyright of E. P. Roe's novels, had published a cheap paper edition, which they sold to the trade at fifty cents, and a fine cloth-bound edition, which sold

[80] Harper & Bros. v. Lare (1900) 43 C. C. A. 182, 103 Fed. 203. In Munro v. Tousey (1891) 129 N. Y. 38, 14 L. R. A. 245, the court said: "That the plaintiff would be entitled to the protection of the law against the use by others of the words 'Old Sleuth Library,' as used to describe a series of publications, or against the use of the name, 'Old Sleuth, the Detective,' for a work of fiction, may be conceded. That is plainly right, and, in order to afford a protection more adequate than would be afforded by an action at law, the equity power of the courts might be successfully invoked to restrain a similar use by others of such names, and to prevent a species of literary piracy. This power is exerted upon the same principle upon which the court acts in trade-mark cases in restraining the unauthorized use of the label or sign constituting the trade-mark. The theory upon which a court of equity has long acted is that a resemblance in, or an imitation of, the names, signs, or marks, under which another conducts a business, is a deception practiced upon the public, and an injury to the proprietor in the loss of custom and patronage, to redress which an action at law for damages is not a sufficiently satisfactory remedy. That is the principle we may extract from the often-cited opinions of Lord Eldon in Hogg v. Kirby (1803) 8 Ves. 215, of Lord Langdale in Knott v. Morgan (1836) 2 Keen, 213, and of our own chancellors in the early cases of Snowden v. Noah (1825) Hopk. Ch. (N. Y.) 347, and of Bell v. Locke (1840) 8 Paige (N. Y.) 75. A publication is the subject of property, and there is no reason why, like every other kind of property, it should not be the subject of the law's protection. To put out a colorable imitation of it, by which the public may be easily misled into supposing that it is the literary article they had in mind to obtain and read, is an act of deception which injures the publisher."

for one dollar and fifty cents. The defendants bought a large consignment of the cheap paper edition, bound the books in cloth, in imitation of the plaintiff's cloth-bound edition, and sold them to the trade at forty cents per volume. After defendants had sold a large number of copies, the plaintiffs filed a bill in equity for an injunction restraining the sale of the cheap paper edition that was rebound in imitation of its cloth-bound edition, and for an accounting. A preliminary injunction was refused.[81] In another case the plaintiff had announced that he was engaged in the preparation of a life of William McKinley, and issued a circular in which he called attention to the fact that the work he was then preparing was not to be confounded with a previous campaign life of McKinley, which had been written by him. The publishers of the previous life issued a circular to the trade, in which the statements of the plaintiff's announcement were so arranged in connection with other matter as to be misleading, and it was held that the distribution of such circular would be enjoined.[82]

§ 231. Unpatented Medicinal Preparations.

The rule is settled that any person who lawfully acquires a knowledge of the composition of an unpatented medicinal preparation may legally manufacture and sell the same, unless he has obtained the knowledge under such circumstances as to constitute a breach of confidence or good faith. Having the right to manufacture the article, he may also publish the fact that his product is made in accordance with the original formula therefor.[83]

[81] Dodd v. Smith (1891) 144 Pa. 340.
[82] Halstead v. Houston (1901) 111 Fed. 376.
[83] Watkins v. Landon (1893) 52 Minn. 389, citing many cases.

§ 232. Acts Induced by Plaintiff.

Where the alleged fraudulent acts of misrepresentation on the part of the defendant were induced by plaintiff, they cannot be availed of in a suit for an injunction. Thus, where an agent of the complainant, who was a manufacturer, purchased an article of a saleswoman in the defendant's store, and, after being distinctly told that it was not of complainant's manufacture, by false statements to the clerk induced her, for the purpose of obliging him, to mark the sale bill, which was delivered to him, so as to indicate that the article was of the complainant's make, it was held that the complainant could not avail himself of such fact as evidence in support of a claim that defendant sold its goods as those of the complainant.[84]

III. Use of Personal Name.

§ 233. In General.

A man's right to the use of his own name in his business is subject to the proviso that he use it honestly. The law will not permit a person to use even his own name for the purpose of imposing upon the public, to the injury of the property rights and business of a rival.[84a] So long as he acts fairly and honestly, a man may use his own name in his business, although he thus incidentally interferes with and injures the business of another having the same name. In such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. Although a party may thus use his name, he cannot resort to any artifice or do any act calculated to mislead the public as to the identity of the business or of the articles produced, and thus cause injury

[84] Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co. (1899) 92 Fed. 774.

[84a] See ante, c. 2, §§ 41-47; ante, c. 8, §§ 161, 164, 172, 181.

to the other beyond that which results from a mere similarity in name.[85] "While it is true," said Judge Sage, "that every man has a right to use his own name in his own business, it is also true that he has no right to use it for the purpose of stealing the goodwill of his neighbor's business, nor of committing a fraud upon his neighbor, nor a trespass upon his neighbor's rights or property; and while it is true that every

[85] Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002; Russia Cement Co. v. Le Page (1888) 147 Mass. 206, 17 N. E. 304; Duryea v. National Starch Mfg. Co. (1897) 25 C. C. A. 139, 79 Fed. 651; Pillsbury v. Pillsbury-Washburn Flour Mills Co. (1894) 24 U. S. App. 395, 12 C. C. A. 432, 64 Fed. 841; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Brown Chemical Co. v. Myer (1887) 31 Fed. 453, (1891) 139 U. S. 540, 11 S. Ct. 625; Coats v. Merrick Thread Co. (1893) 149 U. S. 562; Charles S. Higgins Co. v. Higgins Soap Co. (1895) 144 N. Y. 462, 39 N. E. 490, 27 L. R. A. 42, 43 Am. St. Rep. 769; Gilman v. Hunnewell (1877) 122 Mass. 139; Meneely v. Meneely (1875) 62 N. Y. 427; England v. New York Pub. Co. (1878) 8 Daly (N. Y.) 375; Rock Springs Distillery Co. v. Monarch (1893) 15 Ky. Law Rep. 866, 22 S. W. 1028. A man may use his own name in connection with any business he honestly desires to carry on, but he will not be allowed to use his name so as to work an injury to another having the same name, nor to perpetrate a fraud on the public. To prevent such injury, equity will direct how he shall use his name to indicate his own individuality. Walter Baker & Co. v. Baker (1896) 77 Fed. 181. A person is entitled to sell his own product under his own name, either individually or in connection with a partner, but in so doing he must be careful not to do anything calculated to delude the public into the belief that his goods are those of another having the same name. Allegretti Chocolate Cream Co. v. Keller (1898) 85 Fed. 643. "Disguise defeats the very end and object of legitimate competition, which is the free choice of the public. One may not legally use means, whether marks or other indicia, or even his own name, with the purpose and to the end of selling his goods as the goods of another. If such means tend to attract to himself the trade that would have flowed to the person previously accustomed to use them, their use will be restrained by the law." Pillsbury v. Pillsbury-Washburn Flour Mills Co. (1894) 24 U. S. App. 395, 12 C. C. A. 432, 64 Fed. 841.

man has a right to use white paper, it is also true that he has no right to use it for making counterfeit money, or committing a forgery. * * * It has been held, with reference to trade-marks, that a man has not the right to use even his own name so as to deceive the public, and make them believe that he is selling the goods of another of the same name."[86] In another case the rule was thus stated: "While

[86] Wilson v. T. H. Garrett & Co. (1896) 47 U. S. App. 250, 24 C. C. A. 173, 78 Fed. 472. In Peck Bros. & Co. v. Peck Bros. Co. (1902) 51 C. C. A. 251, 113 Fed. 291, it appeared that Peck Bros. & Co., as a corporation, had been engaged in the manufacture of brass and plumbers' goods for thirty years. It became embarrassed, and passed into the hands of receivers, who continued the business until, under an order of court, the entire property, goodwill, trade-mark, etc., was sold to a committee, who represented the stockholders, for the purpose of reorganization under the name of Peck Bros. & Co. Prior to the receivership the corporation had maintained a branch office at Chicago, which was in charge of three stockholders, one of whom was named Peck. While the receivership was pending in Connecticut, with an ancillary receiver of the Chicago property, the Chicago parties procured a charter in that state for the incorporation in that state of a corporation under the name of the Peck Bros. Co. In this corporation the ancillary receiver became a stockholder, while still acting as receiver. The new company purchased the Chicago stock, but did not acquire the goodwill of the business. The companies continued to do business in the same territory, with resulting confusion of goods, owing to the similarity of names. Upon these facts it was held that the new company was guilty of unfair competition, and that the old company was entitled to an injunction. Judge Jenkins said: "Upon the evidence in this case we think we are warranted in saying of this defendant, as we had occasion to say of another corporation under circumstances not dissimilar, that 'it was conceived in sin, and brought forth in iniquity; that wrong attended at its birth, and that fraud stood sponsor at its christening, imposing upon the corporate child a name to which it was not entitled, and which it had no right to bear.' Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Medicine Co. (1897) 27 C. C. A. 351, 82 Fed. 321. * * * It is now so well settled, both by the decisions of the supreme court and of this court, that the wrongful use of

the right can be denied to no one to employ his name in connection with his business, or in connection with articles of his own production, so as to show the business or product to be his, yet he should not be allowed to designate his article by his own name in such way as to cause it to be mistaken for the manufacture or goods of another already on the market under the same or a similar name. Whether it be his name or some other possession, every one, by the familiar maxim, must so use his own as not to injure the possession or right of another."[87]

The cases in which a person has been enjoined from using his own name in connection with labels and brands on his own goods proceed upon the general ground of deceit and unfair one's own name, to the injury of another, which results in the palming off upon the public his goods as the goods of that other, will be restrained, that it is not needful to review the authorities. We need only refer to a few. Elgin National Watch Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665, 21 S. Ct. 270; Pillsbury v. Pillsbury-Washburn Flour Mills Co. (1894) 12 C. C. A. 432, 64 Fed. 841. While one may have the right to use his own name honestly in his own business for the purpose of advertising, he cannot resort to any artifice or do any act calculated to mislead the public as to the identity of the business, firm, or establishment, or the article produced, and thus work injury beyond that which results from mere similarity of names. Brown Chemical Co. v. Meyer (1891) 139 U. S. 540. Here the artifice consisted not in using one's own name, but in assuming falsely the name 'Peck Bros.,' there being no brothers of that name in the corporation. The name manifestly was thus assumed for the purpose of obtaining the goodwill of the established business of the Connecticut corporation."

[87] Meyer v. Dr. B. L. Bull Vegetable Medicine Co. (1893) 18 U. S. App. 372. See, also, Nolan Bros. Shoe Co. v. Nolan (1900) 131 Cal. 271, 53 L. R. A. 384; Le Page Co. v. Russia Cement Co. (1892) 2 C. C. A. 555, 51 Fed. 941, 17 L. R. A. 354; Russia Cement Co. v. Le Page (1888) 147 Mass. 206, 17 N. E. 304; Knoedler v. Glaenzer (1893) 5 C. C. A. 305, 55 Fed. 895, 20 L. R. A. 733; Charles S. Higgins Co. v. Higgins Soap Co. (1895) 144 N. Y. 462, 27 L. R. A. 42; Bingham School v. Gray (1898) 122 N. C. 699, 41 L. R. A. 243; Harson v. Halkyard (1900) 46 Atl. 271.

competition. A person may thus be restrained from using his own name on his own goods because, under the circumstances, it will deceive the public into purchasing his goods under the belief that they are the goods of another.[88] But a manufacturer cannot, by extensively advertising his name in connection with goods made by him, acquire the right to prevent another person of the same name from selling similar goods under that surname, when such other person has for years been engaged in the manufacture of the same articles, and puts his full name on his labels. Thus, where it appeared that Eli Pettijohn had for many years been more or less successfully engaged in the manufacture of a breakfast food, the court said: "It can hardly be contended that he had not then the right to make or rather to continue making, rolled wheat, and to market the same in packages bearing his name, in any part of the United States. Neither complainant nor its assigns could, by advertising the name 'Pettijohn,' prevent Eli Pettijohn from doing this. It would seem to follow, also, that he might secure the co-operation of others willing to assist him financially in the business, and that he might, with such co-operation, form a corporation for the purpose of carrying on such business; provided, always, he should take reasonable precautions to distinguish the business thus carried on by him from that of a competitor rightfully using the name 'Pettijohn'."[89]

[88] Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608; Garrett v. T. H. Garrett & Co. (1896) 24 C. C. A. 173, 78 Fed. 472; Croft v. Day (1843) 7 Beav. 84; Holloway v. Holloway (1850) 13 Beav. 209; Wotherspoon v. Currie (1872) L. R. 5 H. L. 508; Thompson v. Montgomery (1889) 41 Ch. Div. 35; Howard v. Henriques (1851) 3 Sandf. (N. Y.) 725; Meneely v. Meneely (1875) 62 N. Y. 427; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540; Coats v. Merrick Thread Co. (1893) 149 U. S. 562. See, also, Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 46 U. S. App. 714.

[89] American Cereal Co. v. Eli Pettijohn Cereal Co. (1896) 72 Fed. 903.

§ 234. Limitations—Where Name Indicates Source of Manufacture.

We thus have the rule that a person who is entitled to sell his own products under his own name, either individually or in connection with a partner, must, in so doing, be careful not to do anything calculated to delude the public into the belief that his goods are those of another having the same name. If the latter has first acquired a reputation for a particular kind of goods, the former may be enjoined from selling like goods except in connection with a clear statement indicating that they are not the goods of the latter. Equity will thus direct how a man shall use his name for the purpose of indicating his own individuality.[90] Where a personal name has come to indicate the source of manufacture of a particular article or device, the use of such a name by another person of the same name, unaccompanied with any precaution or indication, in itself amounts to an artifice which is calculated to produce deception.[91]

[90] Allegretti Chocolate Cream Co. v. Keller (1898) 85 Fed. 643. The court said: "The court of appeals in this [second] circuit, following the English courts, has formulated a convenient rule applicable to cases of this kind." Walter Baker & Co. v. Sanders (1897) 26 C. C. A. 220, 80 Fed. 889; El Modello Cigar Mfg. Co. v. Gato (1890) 25 Fla. 886, 7 So. 23; Massam v. Thorley's Cattle Food Co. (1880) 14 Ch. Div. 748, 42 Law T. (N. S.) 851.

[91] Stuart v. F. G. Stewart Co. (1899) 33 C. C. A. 480, 91 Fed. 243; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002; Mossler v. Jacobs (1896) 66 Ill. App. 571. As to the right to the use of one's own name, see note to Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Medicine Co. (1897) 27 C. C. A. 357, 82 Fed. 321. Also, note to R. W. Rogers Co. v. Wm. Rogers Mfg. Co. (1895) 17 C. C. A. 579, 70 Fed. 1017. In Landreth v. Landreth (1884) 22 Fed. 41, the rule was thus stated: "Of course

§ 235. The Singer Case.

In the well-known Singer Sewing Machine Case[92] it appeared that the machines were covered by patents which gave to the manufacturers a substantial monopoly, and that, in consequence of the enjoyment of this monopoly by the makers, the name "Singer" came to indicate in its primary sense, to the public, the class and type of machines made by the Singer company or corporation, and that this name constituted their generic description. As this name applied to and described machines made alone by the Singer firm or corporation, the use also came to convey to the public mind the machines made by such particular firm or corporation. It also appeared that the word "Singer" was applied by the Singer firm or corporation as a designation of a general type of machines made by them, with the intention that such machines should be accepted by the public under that name. This course of business, and the purpose for which the name "Singer" was used, brought about results identical with those which spring from the existence of a monopoly, and that name became not only descriptive of the machine, but also, in a subordinate sense, an indication of the source of manufacture.

The scope of this decision is stated in a recent case.[93]

> a party cannot be debarred from the right to honestly use his own name in advertising his goods and putting them on the market; but where other persons, bearing the same surname, have previously used the name in connection with their goods in such manner and for such length of time as to make it a guaranty that the goods bearing the name emanate from them, they will be protected against the use of that name, even by a person bearing the same name, in such form as to constitute a false representation of the origin of the goods." See Hainque v. Cyclops Iron Works (1900) 136 Cal. 351; Nolan Bros. Shoe Co. v. Nolan (1900) 131 Cal. 271.

[92] Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002. See ante, § 110.

[93] Singer Mfg. Co. v. Hipple (1901) 109 Fed. 152.

It appeared that the defendant was engaged in selling sewing machines which she caused to be marked, "High-Armed Philadelphia Singer." The complainant claimed that this use of the word "Singer" violated its rights, as the word was adopted by one of its predecessors in the business about fifty years ago, and had since been continuously used by it, and those under which it claims, "to identify the machines manufactured by the complainant and its predecessors, and to distinguish them from machines of all other manufacturers." The defendant claimed that she was within the decision in Singer Mfg. Co. v. June Mfg. Co. The court said: "There a case of conflicting rights was presented, neither of which was ignored or disregarded. It was held, it is true, that the right to deal in a machine involves the right to designate it by the name by which it has become known to the public, even where that name, in a subordinate sense, is indicative of the source of manufacture. But from the opinion and judgment it also clearly appears that, although a manufacturer who has voluntarily applied the same word both to designate the machine made and himself as its maker cannot preclude others, who have the right to trade in it, from marking it with the name it has thus acquired, yet they must not do so 'without clearly and unmistakably specifying, in connection therewith,' that every such machine is the product of the actual manufacturer thereof, and therefore not the product of the manufacturer who otherwise would be indicated. In short, the principle of that decision is not that the first user of a mark indicative of origin forfeits his exclusive right thereto for that purpose by allowing it to be applied for the additional purpose of designating the thing itself, but that his monopoly for one purpose cannot be so enforced as to nullify the general right to apply it for the other. If, therefore, defendant's article were in fact a 'Singer' ma-

chine, she would be at liberty to so designate it, provided she also clearly and unmistakably specified that it was not the product of the Singer company; but the evidence, as I view it, is against her on the main point, and therefore her manner of marking need not be considered. The machine which she put on the market is not a 'Singer.' That word is not, as a name for it, either necessary or appropriate; nor can I accede to the contention that her machine is a developed or improved 'Singer,' for the proof is that it is of a distinct type, which is and long has been known as the 'Domestic.' Consequently, the defendant's employment of the word 'Singer' can have but one result, and that is, not to correctly identify the thing itself, but to mislead the public as to its source of origin, and, this being so, the decision in Singer Mfg. Co. v. June Mfg. Co. does not support, but subverts, her present position."

§ 236. Illustrations.

There are many cases which illustrate the rule that a court of equity will not permit a person to use his own name for the purpose of fraudulently interfering with the business of another. Thus, a preliminary injunction was awarded to restrain the sale of root beer under the name of "Hires," where it appeared that the defendant was a kinsman of the complainant, that he had the same name, and that he intended to sell root beer under the name of "Hires," and in packages and under labels similar in general appearance to those of the complainant, and manifestly intended to deceive the public and mislead purchasers.[94]

In another case the plaintiff's corporate name was "De Youngs," which it had long and successfully used in business. The defendant's real name was "Jung," but he assumed the business name of "The Youngs," and engaged in a

[94] Charles E. Hires Co. v. Hires (1897) 182 Pa. 346.

similar business to that of the plaintiffs, located his business in the same city and street, within one block of the plaintiffs (the two business places bearing nearly the same number), assumed a similitude of business signs and advertising devices displaying the name "Youngs" in script, with a heavy dash underneath, and only differing from plaintiff's signs and advertising devices in the prefix "The" substituted for "De." It was held that the defendant evidently designed to avail himself of the advantages accruing from the plaintiff's use of its corporate name of "De Youngs" as a trade-name in a business of established integrity and good repute by practicing an artifice on unwary persons who intended to present themselves as patrons of plaintiff's establishment, to the injury of the plaintiff. Plaintiff was granted an injunction *pendente lite* restraining the defendant from using the name "Young" or "Youngs" directly or indirectly in connection with the business of making or vending photographic art products in any manner calculated or intended to convey the impression that such business was identical with plaintiff's business of making photographic art products, carried on under the name of "De Youngs." In particular, the defendant was restrained from using the name "Young" or "Youngs" in script, with the prefix "The," or one with a like sound, with or without a dash underneath such name, on signs, circulars, letter heads, envelopes, cards, or other advertising medium in connection with such business, and from representing his business, and from suffering the same to be represented by his agents or employes, as identical with the business of "De Youngs."[95]

So, where a manufacturer gave his name to his goods, which became known to the trade and commerce as "Baker's Chocolate," "Baker's Cocoa," and "Baker's Breakfast Cocoa,"

[95] De Youngs v. Jung (1893) 25 N. Y. Supp. 479.

it was held that another person, bearing the name of "Baker," could not use, to designate his goods, the same combination of words, with or without the addition of other words or names, although he might use his own name in connection with other matter which was sufficient to distinguish his goods from those of the other manufacturer.[96]

Where complainant had for a number of years manufactured and sold a medicinal preparation under the name of "Stuart's Dyspepsia Tablets," and by extensive advertising built up a large trade, and, after the remedy had become widely known, one of the defendants, whose name was Stewart, organized a corporation which commenced the manufacture and sale of a preparation under the name of "Dr. Stewart's Dyspepsia Tablets," it was held that the question was one of fraud, actual or constructive, and that the facts showed a design on the part of the defendant to appropriate the complainant's goodwill, and to impose its manufactured articles upon the public as those of the plaintiff's.[97]

One Duryea and his brothers were the controlling members of the "Glen Cove Mfg. Co.," which for a number of years had made and sold starch in packages bearing in prominent letters "Duryea's Starch." A picture of the manufacturing buildings, together with the name of the corporation, also appeared on the packages, and the starch and the corporation became identified with each other. Thereafter the business was sold to another corporation, the "National Starch Mfg. Co.," of which Duryea became the president, and which continued the use of the words and pictures in connection with its own name. Duryea subsequently withdrew from the company, and furnished capital to two of his sons, who, together

[96] Walter Baker & Co. v. Baker (1898) 87 Fed. 209. See, for this case on appeal, 115 Fed. 297, and post, § 239.

[97] Stuart v. F. G. Stewart Co. (1899) 33 C. C. A. 480, 91 Fed. 243.

with two other persons of different names, formed the firm of "Duryea & Co.," without any imitation of labels or packages. It was held that this was a proper use by Duryea and his sons of their own names.[98]

In another case it appeared that the defendants had been the former agents of the firm of R. Heinish's Sons, who were the complainant's assignors. That firm enjoyed a high reputation as manufacturers of shears, when H. C. Heinish withdrew therefrom, conveying to it all his interest in the property, assets, and business. Defendants subsequently, in a contract with that firm, had admitted that it was "the sole owner of the H. trade-mark." Afterwards, the defendants entered into a contract with said H. C. H., by which they ostensibly acquired, among other things, the right to the use of his name upon all of their goods; and at once began to make and sell shears stamped with his name. They were packed in a manner similar to the complainant's goods, and were so labeled as to lead the ordinary purchaser to believe them to be the same. At the same time, defendants continued to use, at the doorway of their store, two signs having thereon "R. Heinish's Sons," and to use postal cards notifying dealers that they were "Sole Agents for R. Heinish's Sons' Shears." It appeared that nothing had been done under any clause of defendant's contract with said H. C. H. except that one purporting to convey the right to use his name. It was evident that the real object of the contract was to acquire the claim to that name under cover of the other clauses. It was held that the circumstances clearly indicated a fraudulent intent, and that the complainant was entitled

[98] Duryea v. National Starch Mfg. Co. (1897) 25 C. C. A. 139, 79 Fed. 651; Stuart v. F. G. Stewart Co. (1898) 85 Fed. 478.

to an injunction against the use of the name, and to an accounting.[99]

In another case it appeared that the plaintiff was the owner and manufacturer of a soap known to the public under the names of "Charles S. Higgins' German Laundry Soap," "Higgins' German Laundry Soap," and "Higgins' Laundry Soap." The defendant, D., subsequently organized a company, to which he procured one Walter A. Higgins to give his name, and thereafter manufactured, and permitted the Amalga Soap Company to manufacture, the soap under the name of "Walter Higgins' Turkish Laundry Soap," which was put up in packages similar in size and shape to those of the plaintiff, and bore similar devices, except as to the name, and the picture of a Turk smoking his pipe in place of that of a colored woman at the washtub. It was held that there was such imitation of the plaintiff's soap as was calculated and designed to deceive the public, and that an injunction to restrain the use of the wrappers similar to those of the plaintiff, and the use of the word "Higgins" in designating the soap made by defendants, was properly granted.[100]

[99] R. Heinisch's Sons Co. v. Baker (1898) 86 Fed. 765.

[100] Charles S. Higgins Co. v. Amalga Soap Co. (1894) 10 Misc. Rep. (N. Y.) 268; International Silver Co. v. Simeon L. & George H. Rogers Co. (1901) 110 Fed. 955, is one of the numerous cases in which the Rogers' trade-marks have been considered. The historical facts are too extensive to be here stated, but are fully set forth in R. W. Rogers Co. v. Wm. Rogers Mfg. Co. (1895) 17 C. C. A. 576, 70 Fed. 1017. Briefly, it appears that, about forty years ago, three brothers by the name of Rogers composed a firm in Connecticut under the style of "Rogers Bros." This firm acquired a high reputation for the quality of silver-plated ware, upon which the name of "Rogers Bros." was stamped. A corporation called the "William Rogers Mfg. Co." was the successor of the business established in 1865 by William Rogers, one of these brothers, and after 1872 it was engaged in manufacturing and selling silver-plated ware, and continued the trade-marks on such goods which its predecessors

§ 237. Family Name—Relationship to Original Manufacturer of Article.

No special right to the use of a family name which has become a trade-mark applied to a manufactured article accrues by virtue of the relation which the descendants bear to the original manufacturer of the same name; such descendants being entitled to no other than their natural rights to the use of their own names in the transaction of their own business. In a late case it appeared that the defendants were engaged as selling agents for typewriters, which were sold to the trade under the name of "Remington-Sholes," and manufactured by a corporation which was organized by the descendants of the original Remingtons. The right to the use of the name had been sold to the plaintiff. These descendants of the original

adopted in 1866. Two other corporations acquired from one or more of these brothers the right to use the name Rogers. In 1898 the International Silver Company acquired the entire capital stock and properties of fourteen silver-plating corporations, including the patents and ownership of all their trade-marks, so that it owned and controlled the business of all the original Rogers companies. After the organization of this consolidated company, a corporation was organized in Maine under the name of the "Rogers Bros. Mfg. Co.," and a small portion of its stock was held by parties by the name of Rogers, who were the sons of one of the three brothers, who composed the original firm of Rogers Bros. One of the parties had never been connected with the silver-plating business, and the other merely as a workman upon wages by the day or week. In its advertising matter, and on its labels and wrappers, this company displayed the names of S. L. and G. K. Rogers, with a statement that they were "the only real Rogers Bros.," and that the goods were the "real Rogers goods." It was held that this was clearly done for the purpose of conveying the impression to the public that it was the manufacturing successor of the original firm, and hence constituted unfair competition, against which the complainant, as the actual successor to such business, was entitled to an injunction. The corporation was allowed to use its corporate name, but was enjoined from marking the goods with any mark in which the name Rogers was prominent.

manufacturers became members of a corporation which made a typewriter under the names of the "Sholes," which was then changed to the "Remington-Sholes." As the ultimate purchaser of the typewriters might be led to think that the addition of the name "Sholes" was a new style of the old machine, coming from the same source, the use of the name "Remington" was held to be an attempt to deceive the public, and was therefore unwarranted. The court said: "Upon well-established principles, one has no right to push his wares as those of another. This would ordinarily be an actionable wrong at law, repetition of which, to save multiplicity of suits for repeated wrongs, would be restrainable in equity. That these Remingtons are descendants of one of the original Remingtons, and Sholes a descendant of an inventor of some part of the original typewriters, is set up and relied upon as establishing a right to the use made of the name 'Remington-Sholes' in this connection. No right descended, however, in these respects, from any of these ancestors to any of these persons, and this excuse has no legal foundation, but is entirely sentimental. They were situated as to this as any other persons of the same names would have been, with no standing but their own natural rights to the use of their own names in the transaction of their business. That all persons have respectively the right to use their own names in their own business is entirely clear, but this right is subject to the limitation common to all rights,—that it is to be so used as not to injure the rights of others. These Remingtons were not themselves manufacturers of typewriters, and did not start in as nor become such in their own names, nor have they had their own names put upon machines of their own make; but they gave their name to a large corporation as a distinct entity, which took the name into its typewriter business, and put it upon the machines of that corporation, whereby they under-

took to confer the right to the use of that name upon that entity for the benefit of others who had no right to use it at all. This was not a legitimate exercise of the natural right to use their own name in their own business, but was an attempt to exercise a fictitious right to use the name in, to a great part, other's business. This was going far beyond their own rights, and was an undertaking to give what they did not have, and their own natural right to the use of their own name in their own business became thereby so mingled with the unlawful use of it for the benefit of others that it is indistinguishable here. They lost their identity in that of the corporations. Connecting the name 'Sholes' with 'Remington' in the business and on the machines would not or might not adequately indicate to a purchaser who had known or heard of the Remington typewriters, and wanted one, that these were not original Remingtons, such as were wanted."[101]

§ 238. Personal Name as Part of Corporate Name.

Parties who organize a corporation for the manufacture and sale of a particular article are not entitled to use, as their corporate name in that business, the name of one of their number, when such name is intentionally selected for the purpose of competing with an established firm of the same name, and diverting the latter's trade to themselves by confusing the identity of their products, and thus leading purchasers to buy the goods of one for those of the other.[102]

So, where a corporation which was organized to manufac-

[101] Wyckoff v. Howe Scale Co. of 1886 (1901) 110 Fed. 520. See chapter 3, § 41.

[102] International Silver Co. v. Wm. G. Rogers Co. (1902) 113 Fed. 526; R. W. Rogers Co. v. Wm. Rogers Mfg. Co. (1895) 17 C. C. A. 576, 70 Fed. 1017. See chapter 8, § 172. See cases cited in next section. Medlar & Holmes Shoe Co. v. Delsarte Mfg. Co. (1900) 46 Atl. 1089.

ture and sell snuff, assumed the name of an employe who had a few shares of stock, for the evident purpose of appropriating the trade of others of the same name, who had established a business in the same article, it was held that such corporation would be enjoined from using the name of such employe as part of the corporate name or of the business.[103]

§ 239. Incorporation under Personal Name.

Prior to 1894, the concern of Walter Baker & Co. manufactured chocolates and cocoas which had become well known throughout the country. The word "Baker," when applied to these articles, had come to represent to purchasers, generally, the product of Walter Baker & Co., and had become a trade-name of such value in the commerce of those articles that various persons of the name of Baker were led to engage in the making and selling of them, in the expectation of marketing them as the products of the original concern. In 1894 the complainant, for this purpose, commenced the manufacture and sale of chocolates and cocoas at Winchester, Va., which he put on the market as those of W. H. Baker & Co. The packages simulated, in various respects, those of Walter Baker & Co. In 1897, in a suit brought against him by the successors of the original concern, he was enjoined from using in his business the name "Baker" or "Baker's" alone on the labels, wrappers, advertisements, etc., or the name "W. H. Baker & Co.," and was required to insert in lieu thereof the name "W. H. Baker, of Winchester, Va.," and also, in as prominent type, the statement, "W. H. Baker is distinct from the old chocolate manufacturer, Walter Baker & Co." In August, 1899, the defendant commenced the manufacture and sale of chocolates and cocoas at Syracuse, N. Y., be-

[103] Garrett v. T. H. Garrett & Co. (1896) 24 C. C. A. 173, 78 Fed. 472.

ing partly induced thereto, as complainant had been, by the expectation of profiting by the trade-name of "Baker," but also in part by the hope of diverting to himself some of the business of the complainant, as the articles were put on the market as those of William H. Baker. He employed, as his managing agent, a person who had been formerly in the employ of Walter Baker & Co., and who had subsequently been employed by the complainant. Through him he was able to approach the customers of complainant, and, to do so more effectually, he issued circulars simulating the circulars of the complainant, which were calculated to lead parties to believe that orders sent to him would be filled by complainant. On his circulars and labels appeared a notice that "William H. Baker is distinct from the old chocolate manufactory of Walter Baker & Co.," but in both circulars and labels the place of business was given as Syracuse. In 1899 the complainant filed a bill in equity against the defendant, alleging unfair competition in trade, and seeking an injunction. In this action a preliminary injunction was granted, restraining defendant from using on his circulars, or on his packages, or in his business in any form, the words "W. H. Baker," or "William H. Baker is distinct from the old chocolate manufactory of Walter Baker & Co.," but permitting it to use "William H. Baker," conjoined with "Syracuse." The action proceeded to an interlocutory decree, by which the preliminary injunction was made perpetual, and an accounting ordered. While this action was pending, defendant changed its business methods to conform to the requirements of the preliminary injunction, and also arranged his advertisements, packages, labels, etc., until they were approved by the successors of Walter Baker & Co., and then adopted as a trade-mark the words "Justice Brand," and a figure of Justice bearing the scales, and in all other respects differentiating the dress of his prod-

uct so as to minimize, as far as possible, the risk of confusion between them and those of the complainant. Before the final decree was entered, he transferred his business, which had become an extensive one, to a corporation which was organized under the laws of the state of New York, with the corporate name of "William H. Baker, Syracuse, N. Y." Thereafter the complainant filed a second bill in equity against the corporation, alleging unfair competition, and asking for an injunction and an accounting. The action on final hearing resulted in a decree dismissing the bill, and this was affirmed by the court of appeals. Wallace, Circuit Judge, said: "We are satisfied that substantial justice has been done by each of the two decrees. The complainant, notwithstanding he commenced business under false colors, and occupied a position which did not commend him to the very solicitous consideration of the court, was entitled to be protected in the circumscribed use of his own name, which had been accorded to him by a court of equity. He had no right to complain of the use by another of a rightful patronymic, and much less of the name of 'Baker' in selling the same class of products; but he has a right to complain if a competitor was endeavoring to palm off his own products as those of the complainant by the use of the same name, on misleading circulars or otherwise, and was entitled to be redressed. The evidence shows that the substantial grievance of the complainant is found in the conduct of William H. Baker at the inception and early in the history of his competition. This was remedied as to the future by the preliminary injunction in the first action. That injunction gave the full measure of relief to which the complainant, under the circumstances of the case, was entitled, except such a recovery for profits and damages as he might be found entitled to. * * * We have examined with care the evidence in the record of the second

action to ascertain whether the defendant in that action has, by its circulars, its advertisements, or the dress in which its goods have been presented, done anything of which the complainant can reasonably complain, and we have found nothing, unless he has cause to complain of the use of its corporate name. A part of that name is the place of business, and every person who deals with the defendant is thereby notified that its business domicile is not the domicile of the complainant. If the name had been selected unnecessarily, or for the purpose of illegitimate competition with the complainant, we should not hesitate to enjoin its use.[104] But it was selected without any element of bad faith or unfair use. It was not a new name, and it represented a widely-known concern, engaged in a large business, which had acquired a valuable goodwill. For reasons of convenience, the owner concluded to reorganize the concern as a corporation, and, desiring to preserve the goodwill, he chose the name with which the goodwill was identified. He intended to remain the owner of the concern, and has remained its owner, as before. As regards the complainant, it is wholly immaterial whether the business is conducted as that of a corporation or that of an individual by the same description."[105]

§ 240. Personal Name as Part of Label.

One of the leading cases upon the right of a person to the use of his own name is Pillsbury v. Pillsbury-Washburn Flour Mills Co.[106] In 1872 the firm of C. A. Pillsbury &

[104] Wm. Rogers Mfg. Co. v. R. W. Rogers Co. (1895) 66 Fed. 56; Rogers v. Wm. Rogers Mfg. Co. (1895) 17 C. C. A. 575, 70 Fed. 1019.

[105] Baker v. Baker (1902) 115 Fed. 297; Nolan Bros. Shoe Co. v. Nolan (1900) 131 Cal. 271.

[106] (1894) 24 U. S. App. 395, 12 C. C. A. 432, 64 Fed. 841.

Co., which for many years had been engaged in the business of manufacturing and selling flour in the city of Minneapolis, Minn., adopted a brand for identifying their high grade of wheat flour. It consisted of the words and letters, "Pillsbury's Best XXXX, Minneapolis, Minnesota," within a circle composed of two dotted lines, with the name "Pillsbury" appearing outside the circle on each side of the brand, and the words "Pillsbury's Best" repeated below the same. The flour put up under this brand had acquired a great reputation, and was sold and well known throughout Europe and America. In 1889 a corporation named "Pillsbury-Washburn Flour Mills Company, Limited," succeeded to the business of C. A. Pillsbury & Co., and acquired all its property, including trade-marks and brands. The members of the firm became largely interested in the corporation, and the business was continued successfully and on a large scale. The trade-marks and brands which had been used by C. A. Pillsbury & Co. were used, except that, a few years after the transfer to the corporation, it began to use on its sacks of flour the words "Pillsbury-Washburn Flour Mills, Ltd., Successors to," above the monogram "C. A. P. & Co." that had been used by the former firm upon its sacks. In 1893, L. F. Pillsbury, who resided in Illinois, and had never been engaged in the milling business, began to sell an inferior article of flour, which he purchased and put into sacks which bore the brand "L. F. Pillsbury's XXXX Best Patent Minnesota," surrounded by a circle composed of three dotted lines, with the name "Pillsbury" appearing outside of the circle on each side of the brand, and the words "Pillsbury's Best" repeated below the same in an arrangement similar to that used in the brand of the complainant, the only difference being the initials "L. F." in the simulated brand. The color of the

sacks used, and of the letters on the two brands, were the same, and the corresponding letters, and the circles of dotted lines, were printed in ink of the same color. The word "Best," in red ink, was prominently displayed, and was arranged substantially the same in the two brands. It was held that the Pillsbury-Washburn Flour Mills Co., Limited, on the principle that a court of equity will protect against fraud, was entitled to enjoin L. F. Pillsbury from using the brand or device, or any colorable imitation thereof. Judge Jenkins, after stating the rule as to the use of a personal name, said: "It is without doubt true that flour brands are numerous, and that the general shape and style are necessarily similar, because the packages which contain the flour are necessarily of like shape and character; but the question is not whether there is a general similarity of the brands in form necessitated by the general similarity in the shape of the packages which contain flour, but whether here is such marked simulation and such conduct upon the part of the appellants in the marketing and sale of their goods as lead to the conviction that they deliberately and fraudulently sought to impose upon the public, and to palm off their own goods as the manufactured product of the appellee. * * * There appears, we think, a studied attempt to simulate the brand of the appellee, and a studied design to incorporate in the brand of the appellants such differences only as should, upon close investigation, serve to distinguish it from the brand of the appellee, which differences would not be observed by the ordinary purchaser. * * * The question, however, is of resemblances, not differences. A test which applies only after the deviations have been pointed out favors the counterfeit. We think it clear beyond reasonable doubt that the simulation is such as to deceive the ordinary purchaser, desiring to buy the flour of

the appellee, into purchasing the flour thus put upon the market by the appellants. We must remember, in considering this and like cases, that the purchaser of goods, with respect to brands by which the goods are designated, is not bound to exercise a high degree of care. A specific article of approved excellence comes to be known by certain catch words, easily retained in memory, or by a certain picture, which the eye readily recognizes. The purchaser is required only to use that care which persons ordinarily exercise under like circumstances. He is not bound to study or reflect,—he acts upon the moment. He is without the opportunity of comparison. * * * We do not credit the assertion of the appellants that the flour they thus put upon the market was of equal quality to that manufactured by the appellee. If it were so, it could make no difference in the consideration of the question."

IV. Geographical Names.

§ 241. The General Rule.

A geographical name is not ordinarily the subject of a technical trade-mark, and a person cannot acquire an exclusive right to the use of such word. But where it has been adopted at first merely to indicate the place of manufacture, and afterwards has become known as a synonym for superior excellence, persons residing at other places, or even at the same place, will not thereafter be permitted to use it as a brand or label for similar goods, for the purpose of fraud and false representation, and thus to appropriate the goodwill of a business which long-continued industry, skill, and a large use of capital has built up.[107]

[107] Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608; Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co. (1898) 87 Fed. 864; Hoyt v. J. T. Lovett Co. (1895) 17

§ 242. Name of Place.

The rule stated in the preceding section is subject to the qualification that, where a geographical or descriptive word has acquired a secondary signification in connection with some manufacture or article of commerce, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public, and on those through whose employment of it a special meaning has become attached.[108] "In other words," said Chief Justice Fuller in the Elgin Watch case,[109] "the manufacturer of particular goods is entitled to the reputation they have acquired, and the public is entitled to the means of distinguishing between those, and other goods; and protection is accorded against unfair dealing, whether there be a technical trade-mark or not. The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another. If a plaintiff has the absolute right to the use of a particular word or words as a trade-mark, then, if an infringement is shown, the wrongful or fraudulent intent is presumed, and although allowed to be rebutted in exemption of damages, the further violation of the right of property

C. C. A. 653, 71 Fed. 173, annotated; Coffman v. Castner (1898) 31 C. C. A. 55, 87 Fed. 457; Delaware & Hudson Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 S. Ct. 151; Laughman's Appeal (1889) 128 Pa. 1, 18 Atl. 415; Glendon Iron Co. v. Uhler (1874) 75 Pa. 467; Connell v. Reed (1880) 128 Mass. 477; Candee v. Deere (1870) 54 Ill. 439; Evans v. Von Laer (1887) 32 Fed. 153; Genesee Salt Co. v. Burnap (1896) 20 C. C. A. 27, 73 Fed. 818. As to geographical names used in a merely fanciful sense, see Fleischmann v. Schuckmann (1881) 62 How. Pr. (N. Y.) 92 (Vienna Bread); Taylor v. Carpenter (1844) 3 Story, 458, Fed. Cas. No. 13,784 ("Persian" Thread).

[108] See chapter 2, § 59.

[109] Elgin National Watch Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665. See Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537, 549; Coats v. Merrick Thread Co. (1893) 149 U. S. 562.

will nevertheless be restrained. But where an alleged trade-mark is not in itself a good trade-mark, yet the use of the word has come to denote the particular manufacturer or vendor, relief against unfair competition or perfidious dealing will be awarded by requiring the use of the word by another to be confined to its primary sense by such limitations as will prevent misapprehension on the question of origin. In the latter class of cases such circumstances must be made out as will show wrongful intent in fact, or justify that inference from the inevitable consequences of the act complained of."

§ 243. Same—Illustrations.

The right to be protected in the use of a geographical name thus depends not upon a proprietary right in the name, or an exclusive right to its use. When another resorts to the use of such a name fraudulently as an artifice or contrivance to represent his goods or business as being that of a person previously using it, and induces the public so to believe, the court will afford relief to the party interested.[110] Thus, a manufacturer of salt in the Genesee Valley will not be enjoined from using the word "Genesee," but he will be restrained from using it in any color, style, or form of letters, or in connection with other words, to imitate a combination previously used by another dealer in the same article in the same locality.[111] In another case it appeared that the complainant, who was a brewer in St. Louis, Mo., made and exported to Panama and to South American ports beer in bottles with a label bearing the words, "St. Louis Lager Beer." Defendant, who was a shipper of beer from New

[110] Continental Ins. Co. v. Continental Fire Ass'n (1899) 96 Fed. 846; Gebbie v. Stitt (1894) 82 Hun (N. Y.) 93.

[111] Genesee Salt Co. v. Burnap (1896) 20 C. C. A. 27, 73 Fed. 818.

York City, and a competitor of complainants in the trade of Panama and South America, labeled his bottles "St. Louis Lager Beer." Although complainant had not an exclusive property right in the word "St. Louis," or the exclusive right to designate his beer by the name of "St. Louis Lager Beer," yet, as his beer had always been made at that city, the use of the designation on his labels was legitimate, and the defendant, whose beer was made in New York City, was enjoined from simulating his labels, or representing in any other way that his products were those of the complainant.[112]

[112] Anheuser-Busch Brewing Ass'n v. Piza (1885) 24 Fed. 149. The court said: "The case is similar in some of its facts to that of Newman v. Alvord (1872) 51 N. Y. 189. There the plaintiff used the word 'Akron' to designate a cement manufactured by him at the village of Akron, New York. The defendant, who was a manufacturer at another place in the same state, was enjoined from designating his cement as 'Akron Cement,' although he prefixed his own name, and added the real place of its manufacture. In the opinion delivered in that case by Earl, J., it was assumed that other persons at Akron nad the right, equally with the plaintiff, to call their cement 'Akron Cement,' but he added: 'Yet it is quite clear that the plaintiffs, upon the facts, are entitled to protection against the defendant. It is sometimes said in the cases to which our attention has been called that the claimant to a trade-mark must have the exclusive right to it. This form of expression, I apprehend, is not strictly accurate,—the right must be exclusive against the defendant. It is generally sufficient in such cases if the plaintiffs have the right, and the defendant has not the right, to use it. The principle upon which the relief is granted is that the defendant shall not be permitted, by the adoption of a trade-mark which is untrue and deceptive, to sell his own goods as the goods of the plaintiff, thus injuring the plaintiff and defrauding the public.' The following cases in which a party has been protected in the use of the name of a place to distinguish a particular business or product are apposite: 'Glenfield Starch,' in Wotherspoon v. Currie (1872) L. R. 5 H. L. 508, 513; 'Anatolia Liquorice,' in McAndrew v. Bassett (1864) 10 Jur. (N. S.) 492, 10 Law T. (N. S.) 65; 'Seixo Wine,' in Seixo v. Provezende (1866) 1 Ch. App. 192, 14 Law T. (N. S.) 314.

So, one who made corset waists at Chicago, and sold them as "Chicago Waists," so that this designation had come to denote, among purchasers, goods made by him, was granted an injunction against another who made similar waists in a different city, and sold them as "Chicago Waists," with the manifest intent of availing himself of the reputation acquired by the goods of the other.[113]

Certain millers in Minneapolis, Minn., and their predecessors in business, for thirty years had made flour by the roller patent process, and used as brands the words, "Minneapolis," "Minneapolis, Minn.," "Minneapolis, Minnesota," "Minnesota," and "Minnesota Patent." The words "Minnesota" or "Minnesota Patent" meant that the flour was made under the roller patent process somewhere in Minnesota. The words "Minneapolis," "Minneapolis, Minn.," and "Minneapolis, Minnesota," signified to the trade that the flour was made at a Minneapolis flouring mill. A Chicago dealer in flour obtained from the mills at Milwaukee an inferior grade of flour, which he labeled, "Best Minnesota Patent, Minneapolis, Minn." He advertised it as made at Minneapolis, Minn., with the result that the public was deceived into buying this flour under the belief that it was made at Minneapolis, Minn., and were thereby defrauded, and the business of the Minneapolis millers injured. It was held that a court of equity would grant re-

It is unnecessary, for present purposes, to consider whether the complainant has a valid trade-mark or can have a technical trade-mark in the name 'St. Louis.' It is sufficient that it was lawful for the complainant to use that name to designate its property; that, by doing so, it has acquired a trade which is valuable to it; and that the defendant's acts are fraudulent, and create a dishonest competition, detrimental to the complainant."

[113] Gage-Downs Co. v. Featherbone Corset Co. (1897) 83 Fed. 213.

lief by prohibiting the fraud, and thus prevent damage to the business of the Minneapolis millers.[114]

Plaintiff was the owner and operated all the collieries in the parish of R., in Somersetshire, and owned practically all the coal in that parish. She carried on the business of working the collieries and selling the coal in her own name, adding to it on her wagons and bill heads the words, "R. Collieries." The defendants, from 1868, carried on at R. the business of coal merchants as the "R. Coal Co.," having depots at various railway stations in the south and west of England, at which they sold different kinds of coal. They became, in 1876, the lessees of and worked a colliery outside of the parish of R., but in a district or basin in which the coal was similar to that raised within the parish. The coal produced in the district, but outside of the parish, was known as "R. Coal" in the market. In 1873 defendants began to sell coal at G., in Surrey, through a local agent, and in 1875 they bought the goodwill of a retail coal dealer, named C., at G., who had become bankrupt. They then advertised themselves in the Surrey newspapers, and otherwise in the neighborhood, as "The R. Colliery, Proprietors and Factors, Coal and Coke Merchants (Late C. & Co.)," and offered to supply coal of every description direct from the colliery. It was held that the defendants were not entitled to the use of the name "The R. Colliery, Proprietors," until they should acquire a colliery in the parish of R., or to use any style that implied that their coal came from the parish of R., until they should become authorized to sell coals raised from a colliery within that parish. It was also held that the acts of the defendants were calculated to induce purchasers to believe that the defendants were selling plaintiff's

[114] Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608, reversing (1897) 82 Fed. 816.

coal, and that plaintiff was not obliged to prove any instance of actual deception or any actual damage in order to obtain an injunction.[115]

Canning companies in California who put up and sell fruits grown in that state have a right to use thereon the name "California" as a trade designation, and, when their products become well and favorably known by such name, are entitled to protection by injunction against the fraudulent use on cans of the same kind of fruit grown and put up elsewhere of a label designating it as "California Fruit," falsely stating that it is put up in that state. "It is true," said the court,[116] "that no one single packer can acquire an exclusive right to use, as a private trade-mark, 'California Pears,' or 'California,' as a label on canned pears, but all the persons who put up California grown pears in California have a right to use it, and it has acquired, the bill alleges, an especial trade significance of value. With regard to articles of food, and particularly with regard to fruits, the place where they are grown creates often an essential distinction as to quality and flavor, and this distinction, when it has become known in trade by the geographical name of the place where grown, the growers of the fruit are entitled to the benefit of, and the consumers should not be deceived. The present is such a case, and presents, I think, indisputable ground for the application of the equitable jurisdiction which prevents unfair and fraudulent competition by simulated trade designations. All the objections which have been urged by the respondents upon the ground that a geographical name cannot be a trade-mark, that no one of the complainants can show the actual money damage it has suffered, and that equity has no jurisdiction, are, I think, fully

[115] Braham v. Beachim (1878) 7 Ch. Div. 848.
[116] California Fruit Growers' Ass'n v. Myer (1899) 104 Fed. 82.

answered in the learned opinion of Judge Bunn, and the cases cited by him in Pillsbury-Washburn Flour Mills Co. v. Eagle.[117]

In another case the proofs showed that the word "Vichy" was not a trade-mark or trade-name of the complainants, in the strict legal sense of the term, but was a geographical name applied by them, as well as various other owners of mineral springs at or near Vichy, in the department of Allier, France, to designate locality of origin, and to indicate the general characteristics of the waters. It was held that the bill could be maintained upon the theory of unfair competition by defendants and their testator in applying that name to the artificial mineral waters manufactured and sold by them in this country.[118]

[117] (1898) 30 C. C. A. 386, 86 Fed. 608.

[118] La Republique Francaise v. Schultz (1899) 94 Fed. 500. In the subsequent case of La Republique Francaise v. Saratoga Vichy Spring Co. (1900) 99 Fed. 733, Judge Coxe said: "It is thought that this cause is ruled by the decision in La Republique Francaise v. Schultz, 94 Fed. 500, recently affirmed. * * * The principles upon which the decision in the Schultz Case rests are invoked in the case at bar, and I see no way to avoid their application. * * * It would be inequitable to punish the defendant with an injunction and an accounting after exonerating the defendants in the former case. Indeed, the defense here is, in some respects, stronger than in the Schultz Case. The defendant's water has been known for twenty-six years as 'Saratoga Vichy,' and the record shows that there has never been an attempt to palm it off on innocent buyers as the imported article. The defendant has sold it upon its merits as a natural Saratoga water. The two are different in appearance, taste, and ingredients. The defendant's is a sparkling water, and for several years has been sold under a label on which the word 'Saratoga' is as prominently displayed as the word 'Vichy.' It is true that there is a small neck label attached to the bottle on which the name 'Vichy' is the more prominent, but, in view of the many other distinguishing characteristics, it seems inconceivable that any one of ordinary perception can be induced to buy the defendant's water supposing it to be the imported Vichy. An individual

Where the complainant sold goods under the name of "American Wash Blue" and "American Ball Blue," and sought to enjoin other parties from using these words, the court said: "The first contention of defendants is that complainant cannot maintain a right to a trade-mark in the designation 'American,' that being a geographical name, and intended merely to affirm that the articles sold under that description are of domestic, and not of foreign, origin. If the complainant's right to relief was based solely upon the claim of a trade-mark, or, in other words, if complainant could not sustain the suit except by claiming a strict right to a trade-mark in the brands 'American Wash Blue' and 'American Ball Blue,' the position of the defendants that the word 'American,' being a geographical name, cannot be appropriated by any one person as a trade-mark, would be sustained by the authorities. An injunction was granted.[119]

§ 244. Stone Ale Case.

In this well-known case[120] it appeared that the plaintiffs and their predecessors had for a hundred years carried on a brewery at Stone, in Staffordshire, England, and their ale had become known as "Stone Ale." They had registered several trade-marks which contained the name "Stone Ale" in combination with some device or name of the firm, and in 1888 they registered, as an additional trade-mark, the words "Stone Ale" alone. Defendant built a brewery at Stone village, over which he placed the words "Stone Brew-

stupid enough to be deceived in such circumstances is beyond the aid of a court of equity. In his case, a writ de lunatico is a more appropriate remedy than a writ of injunction."

[119] Heller & Merz Co. v. Shaver (1900) 102 Fed. 882.

[120] Thompson v. Montgomery (1889) 41 Ch. Div. 35, (1891) 64 Law T. (N. S.) 749. See Gebbie v. Stitt (1894) 82 Hun (N. Y.) 193, 31 N. Y. Supp. 102. See chapter 2, § 59.

ery," and, when that was objected to by the plaintiffs, he changed it to "Mrs. Stone Brewery," with a device containing the words "Stone Ale," and a monogram somewhat resembling the plaintiffs' trade-mark. Plaintiffs brought action for an injunction, and defendant moved under section 74 of the patent, designs, and trade-marks act of 1883, to enter a disclaimer on the part of the plaintiffs of the exclusive use of the word "Stone," and otherwise rectify the register. It was held that the word "Stone" was not a word common to the trade, and that consequently the case did not come within section 74, and the application for a disclaimer was refused. It was also held that, there being no evidence that the plaintiffs had used the expression "Stone Ale" by itself as a trade-mark before the 13th of August, 1875, plaintiffs could not register it as a trade-mark under section 64, subd. 5, of the same act. But the plaintiffs had acquired, by the user, a right to the words "Stone Ale," within the principles of Wotherspoon v. Currie,[121] and as the conduct of the defendant was calculated to deceive the public into supposing that his ales were brewed by the plaintiff, an injunction was issued.

§ 245. Glenfield Starch Case.

Where the word "Glenfield" had become associated with the starch manufactured by plaintiff, the defendant, although he established his manufactory at the town of Glenfield, was restrained from using the word in such a manner as to deceive intending purchasers.[122]

§ 246. The Yorkshire Relish Case.

From 1860 to 1893, plaintiff alone had sold a sauce called

[121] (1872) L. R. 5 H. L. 508. See next section.
[122] Wotherspoon v. Currie (1872) L. R. 5 H. L. 508.

"Yorkshire Relish." At a later date, defendants put on the market a sauce which was altogether different from that of the plaintiff, and sold it under the name "Yorkshire Relish." It was held that, though the general appearance of the defendants' wrappers and labels was different from that of the plaintiff, they had not taken sufficient precaution to prevent customers from being misled, and that, *ad interim*, an injunction must be granted.[123] On appeal it appeared that Powell had, for thirty-five years, been the sole maker of a sauce which he called "Yorkshire Relish," and which he had sold in round glass bottles, with labels attached to them containing the name "Yorkshire Relish" and his own name. The defendants made similar, but not identical, sauce, under the same name, and sold it at a less price, in similar glass bottles, with labels upon them also containing the name "Yorkshire Relish" in conjunction with their own name. The labels were not otherwise similar. Plaintiff's and defendants' sauces were sold by retail tradesmen at the same price, and there was proof that the ultimate purchaser

[123] Powell v. Birmingham Vinegar Brewery Co. (1894) 13 Reports, 153, citing Powell v. Birmingham Vinegar Brewery Co. (1893) 6 Reports, 52, [1894] App. Cas. 8, 63 Law J. Ch. 152, 70 Law T. (N. S.) 1; Singer Mfg. Co. v. Loog (1882) 8 App. Cas. 15, 32, 52 Law J. Ch. 481, 48 Law T. (N. S.) 3, 31 Wkly. Rep. 325, (1879) 11 Ch. Div. 656; Reddaway v. Bentham Hemp-Spinning Co. [1892] 2 Q. B. 639, 67 Law T. (N. S.) 301; Siegert v. Findlater (1878) 7 Ch. Div. 801, 47 Law J. Ch. 233, 38 Law T. (N. S.) 349, 26 Wkly. Rep. 459; Glenfield Starch Case (Wotherspoon v. Currie) (1872) L. R. 5 H. L. 508, 42 Law J. Ch. 130, 27 Law T. (N. S.) 393; Linoleum Mfg. Co. v. Nairn (1878) 7 Ch. Div. 834, 47 Law J. Ch. 430, 38 Law T. (N. S.) 448, 26 Wkly. Rep. 463; In re J. B. Palmer's Trade-Mark (1882) 24 Ch. Div. 504, (1883) 50 Law T. (N. S.) 30, (1884) 32 Wkly. Rep. 306; Seixo v. Provezende (1866) 14 Law T. (N. S.) 314, 14 Wkly. Rep. 357; Massam v. Thorley's Cattle Food Co. (1880) 14 Ch. Div. 748, 42 Law T. (N. S.) 851, 28 Wkly. Rep. 966; Montgomery v. Thompson [1891] App. Cas. 217, 60 Law J. Ch. 757, 64 Law T. (N. S.) 748.

had been in several instances misled into buying defendants' sauce for that of the plaintiff. It was held that the defendants were not entitled to the use of the name "Yorkshire Relish" in connection with any sauce other than plaintiff's without fairly distinguishing such sauce from the plaintiff's.[124] The court of appeals, in an elaborate and learned opinion, dismissed an appeal from the order granting an injunction. Lord Justice Lindley said: "Persons may be misled and may mistake one class of goods for another, although they do not know the names of the makers of either. A person whose name is not known, but whose mark is imitated, is just as much injured in his trade as if his name were known as well as his mark. His mark, as used by him, has given a reputation to his goods. His trade depends greatly on such reputation. His mark sells his goods. A rival who imitates his mark can hardly help deceiving buyers and injuring him; and for such injury, if proved, he can obtain redress.[125] * * * But it must never be forgotten that a trade-mark only confers on the person whose mark it is a right to say, 'Do not imitate my mark in connection with goods like mine, so that yours may be mistaken for mine.' There is no exclusive right to the mark except in connection with such goods and to prevent deception or mistake. Still less does a trade-mark confer any exclusive right to make or sell the kind of goods denoted by the mark. Unless a person has a patent for his goods, similar goods may be made and sold by any one; and they may be better or worse, dearer or cheaper, than those denoted by the mark. The mark is only a protection against mistakes in taking one person's goods for another's, and the right conferred by a trade-mark is only to

[124] Birmingham Vinegar Brewery Co. v. Powell (1896) 65 Law J. Ch. 563, [1896] 2 Ch. 54.

[125] Siegert v. Findlater (1878) 7 Ch. Div. 801.

prevent its use, if its use deceives or misleads, or is proved to be calculated so to do. The sense in which, and in which alone, a person entitled to a trade-mark has a property in it, was fully explained in Singer Mfg. Co. v. Loog[126] by Lord Selborne, Lord Blackburn, and Lord Watson. Precisely the same principles are applicable to the use of words as to the use of marks for the designation of particular goods. This is shown by such cases as the Angostura Bitters Case,[127] the Glenfield Starch Case,[128] the Stone Ale Case,[129] the Excelsior White Soft Soap Case,[130] and by Seixo v. Provezende.[131] But the exclusive right to the use of words is much more burdensome to other people than the exclusive right to the use of a mark. A person who designs or adopts a mark to denote his goods imposes no unreasonable burden on rivals in trade by forbidding them from using the same mark to denote similar goods if the public are thereby misled. But to monopolize the use of words imposes a much more serious burden. Consequently, limits have been put to the right to complain of the use of words, which have not been put to the right to complain of the use of marks. For example, if a man uses his own name to denote his own goods, it would be intolerable to confer upon him the right to prevent other people of the same name from honestly using their own name to denote their own goods, even although they might be of the same kind as his, and be undistinguishable from them.[132] Again, if a person uses words which simply describe the kind of goods he makes or

[126] (1882) 8 App. Cas. 15, (1882) 52 Law J. Ch. 481.

[127] Siegert v. Findlater (1878) 7 Ch. Div. 801.

[128] Wotherspoon v. Currie (1872) L. R. 5 H. L. 508.

[129] Montgomery v. Thompson (1891) 8 R. P. C. 361; [1891] App. Cas. 217.

[130] Braham v. Bustard (1863) 1 Hem. & M. 447.

[131] (1866) 14 Law T. (N. S.) 314, (1866) L. R. 1 Ch. 192.

[132] Burgess v. Burgess (1853) 3 DeGex, M. & G. 896; Turton v. Turton (1889) 42 Ch. Div. 128.

sells,—*e. g.*, leather boots,—it would be intolerable to confer upon him the right to prevent other persons from honestly using the same words to describe what they make or sell. Although, however, a person, by using his own name, or a merely descriptive word, to denote a particular article, cannot prevent other *bona fide* traders of the same name from using it, or prevent other *bona fide* traders making or selling the same sort of goods from using the same descriptive word, yet, even in such a case, if the descriptive name is proved to mean the goods of the plaintiff, and if deception is also proved, a person may be restrained from using such name or word without taking such steps as will render mistakes unlikely to occur.[133] The leading case on this point is Reddaway v. Banham,[133a] decided the other day in the house of lords."[133b] On appeal to the house of lords, this decision was affirmed.[133c]

§ 247. Old Country Soap Case.

The complainant and its predecessor in interest had for many years manufactured and sold soap under the name of "Old Country Soap," which was used as a trade-mark. The defendant commenced the manufacture and sale of soap under the name of "Our Country's Soap." The boxes in which defendant shipped its soap, and the wrappers around the boxes, were dissimilar from those of the complainant's

[133] Holloway v. Holloway (1850) 13 Beav. 209; Seixo v. Provezende (1866) 14 Law T. (N. S.) 314; Wotherspoon v. Currie (1872) L. R. 5 H. L. 508 (Glenfield Starch Case); Siegert v. Findlater (1878) L. R. 7 Ch. Div. 801 (Angostura Bitters); Thompson v. Montgomery (1889) 41 Ch. Div. 35, [1891] App. Cas. 217, (Stone Ale) 8 R. P. C. 361.

[133a] [1896] App. Cas. 199; (1896) L. J. Q. B. 381.

[133b] Powell v. Birmingham Vinegar Brewery Co. [1896] 2 Ch. 54; (1896) 65 Law J. Ch. 563.

[133c] Birmingham Vinegar Brewery Co. v. Powell (1897) 66 Law J. Ch. 763.

in the printed matter thereon, and in the coloring of the lettering, which, as well as the boxes themselves, contained defendant's name and address, which did not resemble complainant's. The boxes of each party, while similar in color and general appearance to those of the other, had stamped upon one side the name of the soap, and on the other the name of the makers. It was held that the mere similarity in name, in view of the other facts, was not sufficient to constitute unfair competition, it not appearing to be such as to deceive a buyer of ordinary intelligence and observation into buying the defendant's soap for that of the plaintiff. The court said: "Both parties shipped their soap, from their respective places of manufacture, to the trade, in pine boxes of about the same size. On complainant's boxes are the words, 'Allan B. Wrisley Old Country Soap. 479, 481, 483 Fifth Ave., Chicago,' which words are in large blue lettering. Defendant's boxes are marked on one side, in large black letters 'Our Country's Soap, Manufactured by Iowa Soap Co.' On the other side, in red letters, is a guaranty, and then 'Iowa Soap Co., Burlington, Iowa.' The bars of soap in each case are supposed to be one pound, and are of about the same size. Plaintiff's bar of soap is marked 'Allan B. Wrisley, Chicago,' in letters cut in the soap on a smooth surface on the bar. On the other side, 'Old Country Soap,' lettered in the same way. Defendant's soap is lettered on one side, 'Our Country Soap,' and on the other 'Iowa Soap Co., Burlington, Iowa.' The said lettering on both sides is in a panel cut out of the soap. Plaintiff's wrapper around each bar of soap has in large blue lettering as follows: 'Allan B. Wrisley's (Trade-Mark) Old Country Soap. Allan B. Wrisley.' His address or place of manufacture is not given on the wrapper. Defendant's wrapper, on one side, in large red letters on a blue field, in

part of an American eagle, is 'Our Country's Soap.' On the other side 'Iowa Soap Co., Manufacturers, Burlington, Iowa.' Also a lot of blue stars. * * * Plaintiff's soap is called 'Old Country Soap;' defendant's soap is called 'Our Country's Soap.' Plaintiff has been in the business of manufacturing and selling 'Old Country Soap' for a time long prior to the time defendant commenced to manufacture and sell its soap. So the question of fact is, would a person of ordinary intelligence be misled into buying defendant's soap when wanting the soap of plaintiff? * * * When speaking of the evidence that tended to show that some parties had made purchases of defendant's tobacco believing it plaintiff's, and that some witness had testified to such sales, Justice Brewer said: 'We cannot surrender our own judgment in this matter because others may be of a different opinion, or because it happens in isolated instances that some person was so careless as not to detect the difference. It may well be that, where many sales were made, some individuals, not particularly attentive, may have purchased the defendant's, supposing they were purchasing the plaintiff's, package. Such things will happen in the ordinary course of business, no matter how great the differences; and the fact that they have happened, while it is not to be ignored, is not to outweigh the evidence which comes from a personal inspection of the packages and labels.'"[134] The court continued: "I cannot understand how any one could be misled or deceived into buying defendant's soap believing he was getting that of plaintiff. A child who could not read would readily discern the difference, not only as to the box for shipment, but the wrappers around the soap, and the soap itself; and, if the child wanted the one soap, he

[134] P. Lorillard Co. v. Peper (1898) 57 U. S. App. 565, 30 C. C. A. 496, 86 Fed. 956.

could not be easily deceived into buying the other. In my opinion, there is no such resemblance either in box or in wrapper, or in the soap, or in name, as to deceive a child, to say nothing of a person of ordinary intelligence,—the test urged by Justice Brewer."[135]

§ 248. "Oxford," as Denoting Bibles.

In a recent case in one of the federal courts it was held that the name "Oxford" on Bibles had so long been used to designate Bibles prepared and published by the University of Oxford, England, as to become identified with such particular publications as denoting their origin, and that the use of the name by another publisher, having no connection with the place or name, could be for no other purpose than to deceive purchasers, and constitutes unfair competition. It appeared that the University of Oxford, England, is a body corporate, known by the name and style by which the suit was brought; that books had been printed by it as early as the fifteenth century; that letters patent for printing books of all kinds, including Bibles, were granted to it by King Charles in the seventeenth century; that it had printed Bibles of many kinds, prepared by its officers and scholars with great care, which were generally known as "Oxford Bibles;" that no other Bibles were published at Oxford, and that the complainant's Bibles were ordered, sold, and bought by the name "Oxford;" that, among the kinds published by complainant is the "Teachers'" Bible, first published in 1876, which contains, besides the text, a "Manual of Helps to the Study of the Bible," full of reliable information respecting the authors and books of the Bible and Palestine, a concordance, indices, tables, and maps; that this Bible, with new editions, has been published and sold by that name con-

[135] Allan B. Wrisley Co. v. Iowa Soap Co. (1900) 104 Fed. 548.

tinuously in this country and throughout the world. The defendant had printed and published a Bible specified on the title page as an "Oxford Bible. The S. S. Teachers' Edition," and on the back is "Holy Bible, Oxford, S. S. Teachers' Edition." In a suit brought to restrain the use of this name the court said: "It is insisted for the defendant that the name of a place of origin cannot become a valid trade-mark of goods and products, and that 'Oxford' here is merely the name of the city of the plaintiff. and could not be exclusively used to distinguish the plaintiff's Bibles. But this word is a part of the plaintiff's name, and as such has given name to the plaintiff's Bibles, and has come to be a means of showing their origin. The defendant has no connection with the place or name, and this use of the name by the defendant can be for no purpose but to represent the defendant's Bibles as coming from the plaintiff. The plaintiff has no copyright of this work, and any one would, of course, have a clear right to print and publish it, but no one would have a right in any false manner to represent such a product as the work of the plaintiff. The use of the name upon the defendant's Bibles had a tendency to so represent, and to confuse the plaintiff's use of its name in its business. That the plaintiff prints and publishes this work in America as well as at the university makes it none the less the plaintiff's product, and confers no right upon others to publish it in the name of the plaintiff, or to use the plaintiff's name in publishing it in America or elsewhere. * * * The case shows sufficient interference by the defendant to furnish ground for commencing the suit, and the ceasing of the interference by the defendant does not take away the right of the plaintiff to a decree, with costs. Sufficient perception of

profits does not, however, appear to warrant an accounting."[136]

V. Use of Descriptive Words.

§ 242. General Statement.

Words merely descriptive of the kind or quality of goods or articles are not, as pointed out in a previous chapter,[137] the subject of a technical trade-mark and cannot be exclusively appropriated. But where a party has for many years used a descriptive term, and built up a business thereunder, he will be protected from unfair competition by the use of such term.[138] Thus, a manufacturer of "Cashmere Boquet Soap," who has built up a large business, may, under certain circumstances, enjoin a rival manufacturer from using the words "Violets of Cashmere."[139]

Complainant's assignors contracted with Thomas A. Edison for the manufacture by him of a certain number of machines invented by Edison for projecting apparently living figures on a screen. To distinguish these machines

[136] Chancellor, etc., of Oxford University v. Wilmore-Andrews Pub. Co. (1900) 101 Fed. 443, citing Rahtjen's American Composition Co. v. Holzappel's Composition Co. (1900) 41 C. C. A. 329, 101 Fed. 257, reversing (1899) 97 Fed. 949.

[137] See chapter 3, § 63.

[138] Garrett v. T. H. Garrett & Co. (1896) 24 C. C. A. 173, 78 Fed. 472, citing California Fig Syrup Co. v. Frederick Stearns & Co. (1896) 26 C. C. A. 22, 73 Fed. 812; Genesee Salt Co. v. Burnap (1896) 20 C. C. A. 27, 73 Fed. 818. See Postum Cereal Co. v. American Health Food Co. (1901) 109 Fed. 898.

[139] Colgate v. Adams (1898) 88 Fed. 899. The court cited, as controlling this case, Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608, and said: "Whether the word 'Cashmere,' were this a case of technical trade-mark, would be held to be a geographical word, and therefore insusceptible of use under the doctrine of Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 S. Ct. 151, I need not decide." See Kyle v. Perfection Mattress Co. (1899) 127 Ala. 39.

from others, made for like purposes, the word "Vitascope" was coined, and it was agreed between the parties that complainant's assignors might call the machines "Vitascopes," or "Edison's Vitascopes." Complainants failed to take and pay for all of said machines according to the contract, and Edison sold those not taken to reimburse himself for their cost. It was held that the purchasers from Edison, in offering their machines for sale as "Edison Vitascopes," were not guilty of unfair competition with the complainants, as there was no misleading or deception of the public, who thus obtained the identical machines to which the name was intended to apply.[140]

§ 250. Nondescriptive Name—Confusion of Sources of Production.

Where a trader has long been the sole maker of a particular kind of an article, and has called it by a nondescriptive name, by which alone the article has become known in the market, a rival trader will not be permitted to make and sell a similar kind of an article under the same name without so distinguishing his goods as to prevent them from being mistaken for the goods of the original maker.[141] As said in one case: "It is well settled that, while a trade-mark of a descriptive character cannot be monopolized as such, yet there may be such circumstances that subsequent users are bound to distinguish their merchandise, and may be restrained unless they couple with the use of the generic name some caution suitable to guard the public from confusing the sources of production. In the case at bar it is alleged in the bill on this point that the respondents had put up their

[140] Vitascope Co. v. United States Phonograph Co. (1897) 83 Fed. 30.

[141] Birmingham Vinegar Brewery Co. v. Powell (1897) 66 Law J. Ch. 763.

product in pint bottles identically the same in shape and color as those used by the complainant, and had also used white labels, as does also the complainant. These are the only particulars as to which the bill describes simulation. The bottles of the complainant, however, are common pint bottles, in use everywhere, and the exhibits produced to the court do not show labels whose color would be mistaken by the ordinary public as that of the white ones in use by the complainant. The complainant has throughout used on his label a picture of Mount Ararat, being, for the eye of the purchaser, the most prominent feature which it contains. This was omitted by the respondents in their labels. Not only in this respect, but in others, theirs are distinguished in such marked manner from those of the complainant that, as we have already said, the public has a reasonable warning of the difference in the sources of production, although, as we have suggested, the article itself has been so long exclusively combined in the public mind with the complainant that little less than personal explanations would in many cases prevent the purchaser from deceiving himself. All that can be claimed of the respondents in this particular is that they conform to the rule of Singer Mfg. Co. v. June Mfg. Co.; and the complainant has not suggested to the court, and the court is unable to perceive from its own inspection of the exhibits, what the respondents could do, more than they have done, to perform their obligation in that respect.[142]

[142] Dadirrian v. Yacubian (1900) 39 C. C. A. 321, 98 Fed. 872. In this case the court said: "Aside from the question of an absolute right to a monopoly of the alleged trade-mark in issue, inasmuch as the complainant introduced into the market of the United States the foreign article which it represents, and had held that market exclusively for so many years that the article became known to the public as his article, the principle underlying the rule announced

§ 251. Words Descriptive of Origin—Use of Word "Vichy."

Where the city of Carlsbad attempted to enjoin a manufacturer of mineral waters from using the word "Vichy," and it appeared that, for more than fifty years, artificial waters, approximating more or less closely in ingredients and properties to natural Vichy water, had been prepared

in Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002, applies. So, also, cases like Reddaway v. Banham [1896] App. Cas. 199, where, to a certain extent, what is called a 'secondary use of a generic term' has been protected, are not to be overlooked. It may be well to add that the rule of Reddaway v. Banham is explained somewhat in Cellular Clothing Co. v. Maxton [1899] App. Cas. 326, 336, the latest case on the topic. Singer Mfg. Co. v. June Mfg. Co. and Reddaway v. Banham are, after all, essentially of the same class." Citing Centaur Co. v. Marshall (1899) 38 C. C. A. 413, 97 Fed. 785-789. In Sterling Remedy Co. v. Spermine Medical Co. (1901) 50 C. C. A. 657, 112 Fed. 1000, it was held that, where a certain article has been put on the market and become known to the public as "Cascarets," another manufacturer is not entitled to the use of the words "Candy Cathartic" in connection with the name "Cascarets" under such circumstances as will result in confusing and deceiving purchasers as to the origin of the remedy. With reference to the words "Candy Cathartic," the court said: "It is claimed that these words are merely descriptive, indicating the quality of the compound, and cannot be appropriated as a trademark. This may be, although a different conclusion was reached by Judge Wing in Sterling Remedy Co. v. Gorey (1901) 110 Fed. 372. We do not find it needful to determine that question, since the bill here does not proceed upon the ground of trade-mark alone, but upon the ground of unfair competition in trade. There can be no trade-mark in one's name, or in a geographical name, or in a name descriptive of quality; but neither can be used for the purpose of perpetrating a fraud which affects the public. * * * In a recent case in the supreme court (Elgin Nat. Watch Co. v. Illinois Watch Case Co. [1901] 179 U. S. 665, 21 S. Ct. 274), the court remarked that, 'where an alleged trade-mark is not in itself a good trade-mark, yet the use of the word has come to denote the particular manufacturer or vender, relief against unfair competition or perfidious dealing will be awarded by requiring the use of the word by another to be confined to its primary sense by such limitations as will prevent misapprehension on the question of origin.' "

and sold under the name "Vichy" by manufacturers in Europe and in this country; that natural waters lose their original virtues more or less when removed from their resources, while artificial waters, manufactured under pressure of carbonic acid gas, remain intact in all of their ingredients; and that Schultz, the testator of the defendants, began the manufacture of artificial water in New York City in 1862, and from that time until the bill was filed, a period of thirty years, continued to make and sell it in large quantities in this country, advertising it as "Schultz's Vichy Water," his earliest circular to the trade containing a statement that "Mineral waters will be made with the greatest care, and according to the best analyses known, so that they will not differ from the natural springs,"—the court said: "The case is devoid of any element of actual fraud. The defendant has acted in good faith throughout."[143] In a subsequent case, brought by another party, it was said: "His product acquired a high reputation for its purity, was prescribed extensively by physicians, and was considered by many to be preferable, for therapeutical purposes, to the natural waters. It became popular as a beverage, being kept by druggists generally, to be drawn from fountains or syphon bottles, and sold by the glass. The labels used by Schultz were widely dissimilar from those used with the natural water. It is apparent that he was solicitous to have the water identified with his name as its manufacturer, and that, so far from attempting to palm it off upon the public as the natural Vichy water, he sought to commend it as an artificial water having substantially the ingredients and properties of the natural water, but of greater excellence and purity than the water made by his competitors. If any part of the public bought or used his product supposing it

[143] City of Carlsbad v. Schultz (1897) 78 Fed. 469.

to be the natural Vichy water, they must have been very ignorant or very careless persons. Assuming that the use of the word "Vichy" in connection with the artificial water made by Schultz may have tended to divert to some extent sales of the water of the complainants, I do not think it tended appreciably to confuse the identity of the two articles."[144]

§ 252. Descriptive Words — Secondary Meaning — "Camel-Hair Belting."

In the leading English Case of Reddaway v. Banham,[145] it appeared that the plaintiffs had long made and sold "Camel-Hair Belting." The defendant also sold "Camel-Hair Belting." Both beltings were really made of camel hair; but it was proved that, in the trade, "Camel-Hair Belting" meant camel-hair belting of the plaintiffs' manufacture, and that the defendant's goods were, in fact, sold for the plaintiffs'. The court of appeals held that the plaintiffs were not entitled to an injunction, but the house of lords took a different view. Lord Herschel said: "What right, it was asked, can an individual have to restrain another from using a common English word because he has chosen to employ it as his trade-mark? I answer, he has no such right; but he has a right to insist that it shall not be used without explanation or qualification, if such a use would be an instrument of fraud. Who suffer injury by such a conclusion,

[144] La Republique Francaise v. Schultz (1899) 94 Fed. 500.

[145] (1896) 65 Law J. Q. B. 381. See chapter 2, § 59. See comment upon this case in Powell v. Birmingham Vinegar Brewery Co. (1894) 13 Reports, 153. In Cellular Clothing Co. v. Maxton (1899) L. J. P. C. 72, it was held by the house of lords that the term "cellular," as applied to cloth and other like materials, was descriptive of the character and texture of the goods, and had not acquired a secondary meaning in association with the goods of particular manufacturers.

or would be the worse if the defendant is thus restrained? It has been shown that the public have not needed the word 'Camel-Hair' to describe a particular kind of belting,—that the words have never been used in the trade in that sense. What Lord Justice James said in Thorley's Case[146] is applicable to the present. He observed: "Thorley's food for cattle had never become an article of commerce, as distinguished from the particular manufactory from which it had proceeded.' * * * The name of a person or words forming part of the common stock of language may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves, without explanation or qualification by another manufacturer, would deceive a purchaser into the belief that he was getting the goods of A., when he was really getting the goods of B. In a case of this description, the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving, further, that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this, I think he would, on well-established principles, be entitled to an injunction. In my opinion, the doctrine on which the judgment of the court of appeal was based—that, where a manufacturer has used as his trade-mark a descriptive word, he is never entitled to relief against a person who so uses it as to induce in purchasers the belief that they are getting the goods of the manufacturer who has theretofore employed it as his trade-mark—is not supported by authority, and cannot be defended on principle. I am unable to see why a man should be allowed in this way, more than

[146] Massam v. Thorley's Cattle Food Co. (1880) 14 Ch. Div. 748.

in any other, to deceive purchasers into the belief that they are getting what they are not, and thus to filch the business of a rival." Lord Macnaghten said: "The appellants concede—they cannot, indeed, any longer dispute—that every-body who makes belting of camel hair is entitled to describe his belting as 'Camel-Hair Belting,' provided he does so fairly. But they contend, and I think with reason, that neither Banham nor anybody else is entitled to steal Reddaway's trade under color of imparting accurate and possibly interesting information. Practically the only difference which the unexpected turn in the evidence has made is this: the case now comes under the second branch of the proposition laid down by Lord Justice James; if 'Camel-Hair Belting' had kept its place as a fanciful term, it would have fallen under the first. The learned counsel for the respondents maintained that the expression 'Camel-Hair Belting,' used by Banham, was 'the simple truth.' Their proposition was that, 'where a man is simply telling the truth as to the way in which his goods are made, or as to the materials of which they are composed, he cannot be held liable for mistakes which the public may make.' That seems to me to be rather begging the question. Can it be said that the description 'Camel-Hair Belting,' as used by Banham, is the simple truth? I will not call it an abuse of language to say so, but certainly it is not altogether a happy expression. The whole merit of that description—its one virtue for Banham's purposes—lies in its duplicity. It means two things. At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair. Abroad, to the German manufacturer, to the Bombay mill owner, to the up-country native, it must mean Reddaway's belting; it can mean nothing else. I venture to think that a statement which is literally true, but which is

intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."

VI. Imitation of Labels.

§ 253. In General.

A manufacturer may indicate his goods by a particular label or wrapper, and he will be protected in its use. Such labels are used for the purpose of distinguishing the goods to which they are attached from those manufactured by other parties, and, when another person uses the same label, or a colorable imitation thereof, the result is the same as in the case of the imitation of a trade-mark. It amounts to a false statement to the public that the goods to which it is attached were manufactured by the person whose label was copied or imitated, and purchasers are thus deceived and defrauded. It was early held that the goodwill of a business, as embodied in the labels and wrappers bearing the name of the concern, or their brands or marks, will be protected on principles analogous to those applied in cases of infringement of technical trade-marks.[147] Thus, in one case Mr. Justice McLean said: "In his bill the plaintiff represents that he was the inventor of a certain medicine, called the 'Chinese Liniment,' at great labor and expense; that the medicine was found to be efficacious in the cure of many diseases, and, on being made known to the public, was purchased extensively, so as to afford a great profit to the plaintiff. It was sold in small bottles, with a suitable label, and accompanied by another paper containing directions for taking and applying the medicine in various complaints. And the complainant represents that the defendant, in the

[147] Peltz v. Eichele (1876) 62 Mo. 171; Sawyer v. Kellogg (1881) 7 Fed. 720.

early part of the year 1848, in combination with one John Loree and others, fraudulently issued to the public a preparation called 'Ohio Liniment,' having, upon the bottles containing it, labels, with directions exactly similar to those used by the complainant for his 'Chinese Liniment,' and that the said Brunton pretends that Loree was the inventor of said liniment, and so represents by hand bills and advertisements, and that, by these representations, which are charged to be false, the defendant has induced the public to believe that the composition sold by him contains the same ingredients as the 'Chinese Liniment,' and that by such means it is extensively purchased and used, to the injury of the complainant, and the great benefit of the defendant. All which representations are alleged to be false, etc. The complainant has not obtained a patent for his alleged invention, and if, in this respect, the allegations of his bill be admitted in regard to the invention, yet this gives him no exclusive right of property in the medicine. Any other individual has a right to make and sell the same medicine. An exclusive right, as the inventor, can only be obtained under the patent law, by a compliance with its provisions. Nor has the complainant an exclusive right to the label, as it is not a book, within the provisions of the statute. On neither of these grounds can the complainant claim an injunction. But if there be found in the representations of the defendant that his liniment is the same as the 'Chinese Liniment,' which recommends it to the public, to the injury of the complainant, it may be ground for the equitable interposition of this court. Suppose the article sold by the defendant is 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 plaintiff's liniment. And this is an injury for which a court of law cannot give adequate compensation. However valuable

the plaintiff'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. * * * In the case under consideration, in his label, the plaintiff calls his medicine the 'Chinese Liniment;' the defendant calls his the 'Ohio Liniment;' but from the body of the label, and of the directions for the use of the medicine, it is clear that the language of the defendant is so assimilated to that of the plaintiff as to appear to be the same medicine, the alterations being only colorable. There would seem to be no doubt that the intention of Lorec, who prepared the liniment sold by the defendant, as his agent, was to avail himself of the favorable reputation acquired by the 'Chinese Liniment,' in the sale of his; and by most persons it would be received as the same medicine. From the hand bill published by Loree, the medicine sold by him is asserted to contain the qualities or ingredients of the 'Chinese Liniment,' and some other ingredient which renders it more efficacious. In his bill the plaintiff avers that this allegation is false; and especially in saying that the 'Ohio Liniment' contains the ingredients of which the 'Chinese Liniment' is composed. The case is considered as coming within the principles above cited, and an injunction is granted to enjoin the defendant from using the label or directions accompanying the liniment he sells, as aforesaid, or other labels or directions, or any advertisements or hand bills, respecting the same words and sentences which are used by the complainant in his label and directions, and which tend to produce an impression on the purchaser and the public that the liniment sold by the defendant contains the same ingredients as the 'Chinese Liniment,' and is, in effect, the same medicine. On the

filing of the answer, a motion will be heard to dissolve the injunction."[148]

A competing business firm is bound to deal fairly in placing its rival articles on the market. If, therefore, it clearly appears that a party has closely imitated another's label, to the obvious damage of the latter's business, a court will grant relief on the ground of fraud.[149] So a preliminary injunction will be granted when the court is satisfied that the labels are devised with an intent to deceive the purchasing consumer into the belief that he is buying the goods of another, where such label is in fact well calculated to deceive.[150] Thus, for illustration, a label on whiskey bottles, which in size, shape, and color is an evident imitation of the the label of a well-known brand of whiskey, and which differs from it merely in some details of the description on the label, although the name of the whiskey and the parties are not the same on both labels, is a fraud, the use of which will be enjoined.[151] So, where the labels on complainant's tobacco packages had a representation of a shield or banner, and an ellipse, with a circle of the words "smoke and chew"

[148] Coffeen v. Brunton (1849) 4 McLean, 516, Fed. Cas. No. 2,946, 7 West. Law J. 59, Cox, Amer. Trade-Mark Cas. 82, Cox, Manual Trade-Mark Cas. 52; Centaur Co. v. Link (1901) 62 N. J. Eq. 147.

[149] Schmidt v. Brieg (1893) 100 Cal. 672, 35 Pac. 623; Kinney Tobacco Co. v. Maller (1889) 53 Hun (N. Y.) 340; Colman v. Crump (1877) 70 N. Y. 573; Enoch Morgan's Sons Co. v. Troxell (1882) 89 N. Y. 292; Oppermann v. Waterman (1896) 94 Wis. 583, 69 N. W. 569; Cleveland Stone Co. v. Wallace (1892) 52 Fed. 431; Burke v. Cassin (1873) 45 Cal. 467,—citing Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Fetridge v. Wells (1857) 4 Abb. Pr. (N. Y.) 144; Coffeen v. Brunton (1849) 4 McLean, 516, Fed. Cas. No. 2,946; Williams v. Johnson (1857) 2 Bosw. (N. Y.) 1; Croft v. Day (1843) 7 Beav. 84.

[150] Scheuer v. Muller (1896) 20 C. C. A. 161, 74 Fed. 225.

[151] Hiram Walker & Sons v. Hockstaeder (1898) 85 Fed. 776; Pillsbury-Washburn Flour-Mills Co. v. Eagle (1897) 82 Fed. 816, followed in form of decree.

in red and yellow, and the defendant's labels had the same figures and colors and the words "smoke and chew," and were so much like the complainant's that one might easily be mistaken for the other, it was held that the wrappers were a palpable imitation, and that their use should be enjoined, although one was called "Peach Blossom," and the other "Sweet Lotus."[152] But the imitation must be of such a character as to have a tendency to deceive; hence, one who uses, in connection with pale ale, a plain red triangle stamped on the label, cannot enjoin, on the ground of unfair competition, one who uses, in connection with his lager beer, a similar red triangle having a large white "Z" thereon, the labels and posters being so utterly unlike that the ordinary purchaser would not be deceived.[153]

Where complainants had long used characteristic labels to distinguish a particular brand of champagne in bottles which had been long and favorably known, the defendants were restrained from using labels of the same kind and color sufficiently corresponding in general appearance to deceive the ordinary customer, and manifestly designed to enable unscrupulous persons to palm off a spurious article on the public.[154] So, one who uses a name or mark which is free to the public, in connection with a label purposely imitating the label of another, which he has the exclusive right to use, for the purpose of utilizing, by the use of a simulated label, the reputation of such other, will be enjoined from the further use of such label, and held to account for previous damages.[155]

[152] Wellman & Dwire Tobacco Co. v. Ware Tobacco-Works (1891) 46 Fed. 289.

[153] Bass, Ratcliff & Gretton v. Henry Zeltner Brewing Co. (1898) 87 Fed. 468.

[154] Von Mumm v. Wittemann (1898) 85 Fed. 966.

[155] Saxlehner v. Nielson (1898) 88 Fed. 71.

The appellant began the manufacture of mustard in Lexington, Ky., many years after the appellee and those through whom he claims. After the appellant had been in business several years, appellee moved his business to Louisville, Ky., and soon thereafter the appellant commenced to use a blue label on his can similar in size, form, and color to the label that had long been in use by the appellee upon cans of the same size and shape. The letters used on the two labels were of the same color, and strikingly alike in size. The directions for use were the same, and the words of caution, although unusual, were very much alike. In addition, the tops of the cans were fastened with a strip of cloth similar in color to that used by appellant for the same purpose. The appellee was enjoined from packing, labeling, or marking his mustard with any colorable imitation of appellee's blue label, and also from using the words of caution thereon.[156]

A statement on a label which is an imitation of the labels used by the complainant in connection with a preparation of chicory made by him in Germany, that the contents of defendant's package is "Chicorien Kaffee aus der Fabrik von E. B. Muller & Co., in Roulers (Belgien)," is misleading and unfair when the only thing done in Belgium is to harvest the chicory root.[157]

§ 254. Dissimilarity.

Dissimilarities appearing by comparison of wrappers and labels are not the test of unfair competition. It is the resemblances that should be looked to, rather than the differences, although both should be taken into consideration. It is a simple matter, upon the comparison of two trade wrappers, to observe dissimilarities, but the purchaser has not

[156] Metcalfe v. Brand (1887) 86 Ky. 331.
[157] Scheuer v. Muller (1896) 20 C. C. A. 161, 74 Fed. 225.

ordinarily the advantages of comparison.[158] An article may be advertised by a certain catch word, easily retained in the memory. An imitation of it may be sufficient to deceive purchasers exercising ordinary care, although the wrapper, in other respects, may be dissimilar.[159] Both resemblances and differences must be taken into consideration, and where the latter, though less conspicuous, so negative the former as to impose themselves upon a person who examines them with a view to ascertain who was the real manufacturer of the article, an unlawful imitation will not exist or be found by the court.[160] In order to justify the intervention of a court of equity, it is sufficient that the imitation is so close that a crafty vendor may palm off on the buyer the article manufactured by one as that of another. It is no answer to an application for an injunction, that in certain particulars, the label of the defendant differs from that of the plaintiff, so long as the imitation in other respects is so close that the general appearance is the same, and purchasers have been and are likely to be deceived.[161]

§ 255. Sale of Labels to Plaintiff's Competitors.

A court of equity will restrain a person from selling labels to parties who use them in unfair competition with the business of the plaintiff. It was so held where the defendant sold labels to be used as wrappers for molasses candy, although

[158] Pillsbury v. Pillsbury-Washburn Flour Mills Co. (1894) 24 U. S. App. 395, 12 C. C. A. 432, 64 Fed. 841; Sterling Remedy Co. v. Gorey (1901) 110 Fed. 372; Paris Medicine Co. v. W. H. Hill Co. (1900) 42 C. C. A. 227, 102 Fed. 148.

[159] Stuart v. F. G. Stewart Co. (1899) 33 C. C. A. 480, 91 Fed. 243.

[160] Proctor & Gamble Co. v. Globe Refining Co. (1899) 34 C. C. A. 405, 92 Fed. 357. See, also, Coats v. Merrick Thread Co. (1893) 149 U. S. 562, 13 S. Ct. 966; Corbin v. Gould (1890) 133 U. S. 308, 10 S. Ct. 312.

[161] Brown v. Mercer (1874) 37 N. Y. Super. Ct. 265.

the complainant did not allege that the wrappers were not susceptible of an innocent use, or that defendants took part in their improper use, or intended them for such use. "Although the bill does not allege an unlawful use in the sale of molasses candy, it does allege repeated interference with the plaintiff's business by unlawful imitation of the appearance of his goods, which could be done upon other goods of the same sort, not specifically molasses candy, as well as with that. The foundation of the right to proceed in equity in such cases is the repeated tort, for which repeated suits at law would be an inadequate remedy. In torts all participants are principals, and the plaintiff could doubtless maintain an action at law against the defendant for each of the diversions of his business produced, brought about or contributed to by the defendant, as alleged in the extracts quoted from the bill. The multiplicity having furnished equitable jurisdiction, the right to maintain the bill, upon the allegations quoted, and others of the same import, for full relief, follows."[162]

Another case in which the defendant attempted to escape responsibility by showing that he manufactured the labels on the order of another party well illustrates the searching powers of a court of equity. "The label complained of and admitted to be prepared and used by the defendant is of the same size, color, and type, and of the same general appearance, as that of the complainant, being divided into compartments corresponding with those in his label. The inscriptions, although not identical, appear very like. The general designation is in these words: 'Sawin's Soluble Blue and Pepper Box.' Placing the two labels side by side, it is easy to distinguish them. But ordinary persons, in the

[162] Hildreth v. Sparks Mfg. Co. (1899) 99 Fed. 484. See chapter 9, § 199.

habit of buying the complainant's bottles, would be very easily deceived into buying the defendant's for them, the general appearance being so similar in every respect. That the defendant's label is a designed imitation of the complainant's scarcely admits of a doubt. Such perfect similarity could hardly have been the result of chance. We do not mean to say that it would be a justification if it were accidental; but it is apparent that it was designed. Sawin is not the defendant's name. Why then, did he use Sawin's name, and not his own? It was evidently done for the purpose of making a closer imitation of Sawyer's label. The defendant, it is true, alleges that he does not put up the bluing for himself, but for a firm by the name of Barron & Co., who directed him to adopt the label in question. But this is no excuse for him unless Barron & Co. were entitled to use the label. The defendant attempts to show that they had such a title by having hired from Sawin the right to use his name. This pretext is too shallow. It is shown, indeed, that Sawin did manufacture bluing, and used a label of his own, but it was wholly unlike the label in question. The use of his name by Barron & Co. in the label complained of was evidently obtained for the purpose of making it more closely resemble Sawyer's. Sawin's bluing had no such reputation in the community as to make it an object to hire his name. As the label stands, it speaks a falsehood. The article covered by it is not 'Sawin's Soluble Blue,' and it is not 'prepared by W. E. Sawin, Jr.,' as stated at the foot of the label. It evidently speaks this falsehood for a purpose, and that purpose, we are satisfied, is to obtain a closer imitation of Sawyer's label. It is no excuse for the defendant that he does this work for other persons. He is just as guilty as if he did it for himself. All who are concerned in

the commission of a tort are alike amenable to the party injured."[163]

§ 256. Game of District Messenger Boy Case.

In an action brought to restrain the defendants from using an alleged trade-mark or trade-name and label of the plaintiffs, it appeared that the plaintiffs, the vendors of a game, prepared a colored label to be used on a box containing a game board, to which they gave the name of "Game of District Messenger Boy." They caused a book of instructions to be copyrighted, and thereafter continued to manufacture and sell the game in a box to which a colored label was affixed, and, as a result of advertising, it "obtained quite a reputation as one of the plaintiff's best games." Subsequently the defendants began to manufacture a game known as "The Messenger Boy," which they put up in a box to which similar labels were attached. The game was inferior to that of the plaintiffs, and its sale was calculated to injure the reputation of the plaintiffs' game, and, as a result, to diminish its sale. It was admitted that defendants' label was an intentional imitation of that of the plaintiffs, and on its face had a tendency to mislead persons, and to cause them to mistake it for the original label on plaintiffs' goods. It thus appearing that defendants' label was a palpable imitation of that of the plaintiffs, and the facts showing unfair competition, an injunction issued restraining its further use. The court said that it was not necessary that plaintiffs should show that persons were actually deceived by defendants' label.[164]

§ 257. Canadian Rye Whiskey Case.

In this case the court said: "I think that the use by the

[163] Sawyer v. Kellogg (1881) 7 Fed. 721.
[164] McLoughlin v. Singer (1898) 33 App. Div. (N. Y.) 185.

defendants of the words 'Canadian Rye Whiskey,' and of the crown and diamond upon the label in such way as to so nearly resemble complainant's trade-marks, constitutes an infringement of such trade-marks, and that all the labels, brands, capsules, devices, words, and lettering upon defendants' bottles so nearly simulate those upon complainant's bottles as to constitute unfair competition, intended to deceive purchasers, and appropriate the trade of complainant."[165]

§ 258. Royal Baking Powder Case.

The words "Coral Baking Powder," in connection with cans and labels of the same general appearance, are such an imitation of the words "Royal Baking Powder" that an injunction will be granted.[166]

§ 259. Saponifire Case.

The complainant had long sold concentrated lye in cylindrical packages, with labels having a white background with black lines around the margin, bearing in large black letters the word "Saponifire." The defendant adopted a similar package and similar label, with the same word in prominent black letters, placing his own trade-mark on the label, and otherwise differentiating the reading matter appearing in small type. He deliberately sought out the localities in which the complainant had created a demand for "Saponifire," with the purpose and result of enabling retailers to pass off his article for complainant's. It was held that this was unfair competition, and that the defendant should be enjoined.[167]

[165] Hiram Walker & Sons v. Mikolas (1897) 79 Fed. 955. citing N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 23 C. C. A. 554, 77 Fed. 869.

[166] Royal Baking Powder Co. v. Davis (1885) 26 Fed. 293.

[167] Pennsylvania Salt Mfg. Co. v. Myers (1897) 79 Fed. 87.

§ 260. P. Loriilard's Tuberose Case.

Plaintiff used as a label for tobacco packages the word, "P. Lorillard's Tuberose," peculiarly placed with reference to each other. The letters composing the name of the manufacturer decreased in size from left to right, and those composing the name of the brand increased in like manner. Defendant's label used the words, "Peper's True Smoke," the words and letters being arranged in the same way as upon plaintiff's label. Both packages were of the same size and shape, which characteristics were common to the trade, and both were made of blue and white striped cloth, although the stripes in defendant's packages were four times the width of those in plaintiff's. It was held that the resemblance was not sufficient to warrant the issuance of an injunction.[168]

§ 261. Morse's Syrup of Yellow Dock Case.

This case illustrates well what is meant by a colorable imitation of wrappers and labels. The complainants manufactured and sold a liquid medical preparation known to the public as "Morse's Syrup of Yellow Dock." It was put up in bottles of a form not peculiar to the complainants, but in use for other purposes. Each bottle had formed on its back, in the substance of the glass, the words "Dr. Morse's Celebrated Syrup," and was inclosed in a wrapper having a label thereon bearing descriptive words, among them the words "Morse's" and "Yellow Dock." The respondents used to a small extent, for a liquid medical preparation, bottles precisely similar in form and size to those used by the complainant. Each bottle had formed on its back, in the substance of the glass, "Dr. Morse's Celebrated Syrup," in precisely the same form as used by the complainants. Respondents' bottle, however, was not inclosed in a wrapper, and had a label pasted

[168] P. Lorillard Co. v. Peper (1898) 30 C. C. A. 496, 86 Fed. 956.

directly on the glass, and there was no similarity between respondents' labels and complainants' other than in the use of the significant words "Morse's" and "Yellow Dock," without any name of maker or seller. It was held that the respondents had infringed the rights of the complainants by using a bottle having the same form as that used by the complainants, and having the same words formed in the substance of the glass, and an injunction issued.[169]

§ 262. No-To-Bac Case.

Plaintiff's remedy for the tobacco habit was prepared in the form of tablets five-eighths of an inch in diameter, weighing twenty-eight to the ounce, of a light-gray color, odorless, and having the word "No-To-Bac" in raised letters on the surface. It was put up in tin boxes of a dark-red color, bearing the word "No-To-Bac," with the plaintiff's name and address conspicuously printed in black, with a description of its alleged qualities and effects, and directions for its use, of which the first was the instruction to discontinue the use of tobacco. The defendant manufactured a remedy for the same habit, to which it gave the name of "Baco-Curo," and which was also prepared in the form of tablets, but of less than one-half an inch in diameter, weighing forty-one to the ounce, of a dark-brown color, having a strong odor of liquorice, and with a smooth surface; it was put up in tin boxes, of a size and shape similar to plaintiff's, but nearly white in color, having the word "Baco-Curo" and the defendant's name and address conspicuously printed in green, with a description of its alleged qualities and effects similar to that of the plaintiff's remedy, and directions for use. The first instruction was not to discontinue the use of tobacco, and this was followed by a warning against remedies which required

[169] Alexander v. Morse (1883) 14 R. I. 153.

the user to discontinue such use of his own free will. Upon this showing it was held that the defendant's method of putting up and advertising his goods indicated no intention to deceive the public into buying his remedy, and therefore did not constitute unfair competition.[170]

§ 263. Clark's Thread Case.

Through a long course of successful dealings, plaintiff had established a high reputation and extensive market for thread manufactured and sold by it, which was known as "Clark's Thread," and was put up on spools each bearing a round label with the name "Clark's" in the upper part of the circle, and the words "Spool Cotton" in the lower part, and the letters "O. N. T.," separated by periods, horizontally across the middle. The defendant, immediately after its incorporation, began the manufacture of a thread which it put up on spools with a label in all respects like the plaintiff's, except that it bore the letters "N-E-W," separated by hyphens, in place of the letters on the plaintiff's label. It was held that this was calculated to create confusion and misunderstanding, and that the acts of the defendant were a fraudulent invasion of the goodwill of the complainant, and an unfair and inequitable competition. The circuit court[171] enjoined the defendant against the use, by labels, circulars, publication, or by word of mouth, of the designation "Clark's" as the name or part of the name of the thread manufactured by the William Clark Company, and from selling thread manufactured by said company under the name of "Clark's" or "Clark's Spool Cotton" or "Clark's Thread," but did not

[170] Sterling Remedy Co. v. Eureka Chemical Mfg. Co. (1895) 70 Fed. 704.

[171] Clark Thread Co. v. Armitage (1895) 67 Fed. 896.

restrain the use of the letters "N-E-W." Upon appeal, the decree of the circuit court was affirmed, but it was held that the defendant should also be restrained from using the letters "N-E-W."[172] The court of appeals found from the evidence and exhibits, including the advertising matter sent out by the defendants, that the purpose of the similarity was to deceive the public into the belief that the article was manufactured by the old and well-known manufacturer, and the "N-E-W" indicated a new kind of the old Clark's Spool Cotton.

§ 264. Hoff's Malt Extract Case.

The complainants acquired the right to the manufacture and sale in this country of Johann Hoff's Malt Extract under labels and trade-marks long used in Germany. This compound had been known for many years in this country indiscriminately as "Johann Hoff's Malt Extract," and as "Hoff's Malt Extract." Afterwards defendant acquired the right to import and sell Leopold Hoff's Malt Extract,—an article manufactured at Hamburg, but from alleged different formulae. It was held that the defendant had no right to sell this compound in bottles having a label bearing conspicuously the words, "Hoff's Malt Extract," although on a different part of the label, and on a separate label the fact was stated that it was made by Leopold Hoff, in Hamburg. The defendant was enjoined from using those words unless preceded by the word "Leopold," so as to read "Leopold Hoff's Malt Extract."[173]

§ 265. Sarsaparilla and Iron Case.

A palpable imitation of a label for a medicinal compound

[172] Clark Thread Co. v. Armitage (1896) 21 C. C. A. 178, 74 Fed. 936.

[173] Johann Hoff v. Tarrant & Co. (1896) 71 Fed. 163.

called "Sarsaparilla & Iron," both labels having the word "Sarsaparilla" at the top in large letters, and the word "Iron" in the border and lower half of the label, and both having parallel lines across the middle, with the names of the manufacturers between, and their monograms in the same position, both having the words "Great Blood Purifier," and "Cures All Skin Diseases," printed in the lower half of the label, while the only material difference in the design and appearance of the label is in the color, constitutes unfair competition, although there is no valid trade-mark in any of the words copied.[174]

VII. Imitation of Dress or Form of Package.

§ 266. In General.

A person may acquire an exclusive right to the use of a package of a fixed shape, style, and dimensions, with emblems, labels, and other devices thereon, and the name to represent its contents, notwithstanding the fact that each one of these distinguishing features might separately be used by another person.[175] The mere package, without sym-

[174] Schmidt v. Brieg (1893) 100 Cal. 672, 22 L. R. A. 790; Schmidt v. Welch (1893) 35 Pac. 626. The plaintiff had no exclusive right to the use of the words "Sarsaparilla & Iron," and therefore, where the only similitude is in the use of these words, no rights are infringed.

[175] Fischer v. Blank (1893) 138 N. Y. 244. A manufacturer who, for the purpose of presenting his goods to the public, adopts a certain combination of features, in part old and in part new, will be protected against imitation. Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16, 41 N. E. 56, and cases there cited. In Humphrey's Homoeopathic Medicine Co. v. Bell (1888) 15 Daly (N. Y.) 6, it was said that a proprietary right might exist in an original and peculiar method or form of preparing, wrapping, boxing, and packing articles. In Sterling Remedy Co. v. Spermine Medical Co. (1901) 50 C. C. A. 657, 112 Fed. 1000, Jenkins, J., said: "We have spoken so frequently to the subject of unfair competition in trade, and have de-

bols thereon, may not be sufficient to constitute a trade-mark; but where the defendant's package resembled the complainant's in numerous particulars besides those of size, color, and form, an injunction was granted restraining the sale of that particular form of package, or any other form which should, by reason of the collocation of size, shape, color, lettering, spacing, and ornamentation, present a general appearance closely resembling complainant's package. But a clause was added to the effect that the injunctional order should not be so construed as to prevent the sale of packages of the size, weight, shape, or color of the complainant's package, provided they were so differentiated in general appearance as not to be calculated to deceive the ordinary purchaser.[176]

Similar methods of advertising and dressing goods for the market, which, when considered alone, are immaterial and insignificant, may be important as tending to establish a design on the part of a dealer to palm his goods off as those of another.[177] "It must be admitted," said Mr. Justice Maynard, "that there is no single point of resemblance or imita-

clared the principles which, as we conceive, govern such cases, that the case before us calls for no special consideration of the facts. There was here manifest attempt to put upon the public the goods of the defendant as those of the complainant. The latter had provided a peculiar form for its tablets, and a box of peculiar shape. This form and shape had not before been used in connection with such medicine. It is clear that the defendant adopted the style and shape of the boxes, the color of the tablet, and the letter press upon the boxes and in advertising, to palm off his goods as those of the complainant. It is not a case of accidental imitation in some respect,—it is a case of deliberate and designed imitation in all respects. The facts bring the case under the ban of the law, and the complainant was entitled to relief."

[176] N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 23 C. C. A. 554, 77 Fed. 869.

[177] Joseph Dixon Crucible Co. v. Benham (1880) 4 Fed. 527 (involves trade-mark); Carbolic Soap Co. v. Thompson (1885) 25 Fed. 625.

tion which would of itself be regarded as adequate grounds for the grant of equitable relief. Form alone would not be sufficient; nor size, nor color, nor the general decoration of the panels, nor disks of the same size and color, arranged in the same way; nor a label of the same shape and color attached to the same part; nor the use of the same name to designate the kind or quality of tea. * * * But when all or a number of them are combined in a single package, and so arranged and exhibited that, when they strike the eye of the intending purchaser possessed of ordinary intelligence and judgment, the false impression is likely to be produced that the goods of the plaintiffs are offered, it is the province of equity to interfere for the protection of the purchasing public, as well as of the plaintiffs, and for the suppression of unfair and dishonest competition."[178] In determining the question of fraudulent intent in the imitation of packages, it is not sufficient merely to note points of difference and resemblances,—the packages and labels must be considered as a whole.[179]

Where the general appearance of the bottles and labels used in marketing a preparation known as "Castoria" was so nearly like that which had been used by another party for many years in the sale of his preparation under the same name as to deceive the ordinary purchaser, it was held that the right to an injunction was not defeated because changes had been made in the shape and color of the bottle, and in the tint of the labels, where the changes were so slight as not to attract attention, and the form and arrangement of the part which covered the front of the bottle remained, so as to deceive, and indicate an intention to defraud.[180]

[178] Fischer v. Blank (1893) 138 N. Y. 244, 33 N. E. 1040.

[179] P. Lorillard Co. v. Peper (1898) 30 C. C. A. 496, 86 Fed. 956.

[180] Centaur Co. v. Hughes Bros. Mfg. Co. (1898) 34 C. C. A. 127,

§ 267. Color of Wrappers.

The mere fact that there is a resemblance in the color of the wrappers used upon the packages is not sufficient to warrant the granting of an injunction. Thus, in one case it appeared that the parties both sold soap powder in four-pound packages, of similar shape, and wrapped in paper of a dark-yellow color. One panel on each package was occupied by a vignette, with the name of the powder, and the name and address of the maker printed in large black letters. The other panels were occupied by directions for use, and commendations of the different powders. The vignettes and the names of the makers of the powders were entirely different. It appeared that there was keen competition between the parties, but there was no evidence that defendant had attempted to palm off his goods as those of the plaintiff. It was held that, as the complainant had no exclusive right to the color of the wrapper of his package, defendant was not guilty of unfair competition.[181] But this case was subsequently reversed by the court of appeals. The evidence showed that the complainant, having commenced the manufacture of soap powder having new ingredients, giving it a yellow color, devised a new, distinctive, and attractive package of a yellow color, bearing the words "Gold Dust" and "Washing Powder," together with the maker's name, and with numerous *indicia* and directions upon the various panels. After it

91 Fed. 901; Centaur Co. v. Neathery (1898) 34 C. C. A. 118, 91 Fed. 891. See, also, Centaur Co. v, Reinecke (1898) 34 C. C. A. 684, 91 Fed. 1001.

[181] N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 71 Fed. 295. In Evans v. Von Laer, 32 Fed. 153, decided in 1887, it was held that, where the only resemblance between the defendants and complainant's packages was in the color of the labels and the use of the words "Montserrat Lime Fruit Juice," and the form of bottles, and it appeared that most of the lime-juice bottles were similar in size and design, an injunction would not be granted.

had sold soap powder in this form for two or three years, and expended large sums in advertising it, the defendant, which had been selling white soap powders, first in small red packages, and afterwards in packages shaped exactly like those of the complainant, but in other respects so different that any confusion of the two was impossible, began manufacturing yellow soap powder, which it styled "Buffalo Powder." It was put up in packages of the same size as the complainant's, with yellow wrappers of the same shade, and with numerous changes, all of which constituted an approach to those used by complainant, although avoiding exact similarity. It was held that, notwithstanding the word "Buffalo," together with defendant's name on the package, was distinctive, the changes were manifestly made with intent to simulate complainant's packages to enable retail dealers to pass them off as those of the complainant, and that an injunction should therefore issue.[182]

§ 268. Form of Bottle.

There are numerous cases in which the form of bottle in which the manufactured article is sold is an important fact, which tends to establish unfair competition. It generally arises in connection with a particular label, but the similarity in the bottles alone may be such as to in itself entitle plaintiff to an injunction. Thus, where the manufacturer of root beer adopted a new and peculiar form of bottle, by which principally its product became known and recognized by consumers, the intentional imitation of such form by a competing manufacturer, who commenced business subsequently, for the purpose of deception, in itself constitutes unfair competition, against which the original user is entitled to an injunction.[183]

[182] N. K. Fairbank Co. v. R. W. Bell Mfg. Co. (1896) 23 C. C. A. 554, 77 Fed. 869.

[183] Charles E. Hires Co. v. Consumers' Co. (1900) 100 Fed. 809. In

In another case it appeared that the plaintiff, under a contract with the distiller of a popular brand of whiskey, bottled such whiskey at the distillery, and sold it under labels stating that it was so bottled, bearing the distiller's guaranty of purity, which obtained favor for it on the market. The bottles used were of a peculiar shape, originally devised by the plaintiff, and which, through extensive advertising, had become to be generally relied upon by purchasers as a means of identifying the whiskey bottled by it. After the adoption by the plaintiff of such peculiar bottles, the defendants, who had dealt for some years in whiskey bottled by themselves, began the use of a bottle precisely similar in shape and appearance to that used by the plaintiff, although bearing labels which were in no sense imitations of the plaintiff's labels. Upon this showing it was held that the defendants

Van Hoboken v. Mohns & Kaltenbach (1901) 112 Fed. 528, it appeared that certain distillers had for years put up gin in a distinctive style of bottle, with the firm name and address and registered monogram and trade-mark blown in the bottle. One who refills these bottles with an inferior quality of gin, and sells it to the trade without notice that it is not the genuine, will be restrained, although the bottles do not have the distiller's monogram, paper label, and stamp on the cork, and it is sold at a less price than the genuine article. After considering the case as one of trade-mark, the court said: "If we consider the case as one of unfair competition, the same result must follow. As was said in the various Hostetter Cases (1897) 84 Fed. 333, (1900) 107 Fed. 705, and (1901) 110 Fed. 524, the doctrine of unfair competition rests upon the proposition that men must be honest in their business transactions, and rely upon the merits of their own goods, and not undertake to palm off inferior goods as and for goods of the genuine manufacturer. Even if the respondent in the case at bar was using the bottles of complainants as a mere convenience, without dishonest motives, the custom of refilling receptacles bearing distinctive trade names or marks with other manufactures is too dangerous, and allows too great an opportunity for fraud against the owners of valuable preparations, to be permitted." See chapter 3, § 79.

were engaged in unfair competition, and an injunction issued to restrain them from the use of the bottles.[184]

In an earlier case it appeared that Johnson's Anodyne Liniment had been sold for more than fifty years in bottles of a certain size and style, having a blue wrapper and a purplish label, bearing a certain description, and a *fac simile* of the name of A. Johnson, the original proprietor. Defendant's article was called "Johnson's Anodyne Liniment," and appeared in the same size bottles, with similar blue wrappers, and a label differing but little from that of the genuine article, except slightly in color, and bore a *fac simile* of the name of the defendant, F. E. Johnson. There was evidence of actual deception, and the defendant was restrained from the sale of his article in such form.[185]

So, where the defendants used a bottle for bitters which had the peculiar form and color, round shoulders and short neck of the complainant's bottle, with a label containing the words "Thellers Celebrated Stomach Bitters," and a monogram of the letters "A. T." in the place of the picture of St. George and the dragon, used by complainants, and a black shield below the monogram, which greatly resembled the complainants' shield, and, below the shield, an imitation of the lettering upon the genuine label, an injunction was issued.[186]

In an early case a defendant was enjoined from using a style of bottle and label which had a general resemblance in form, symbol, and accompaniments to those of the complainant, and which were calculated to deceive the public.[187]

Where plaintiff used, on a bottle in which he sold liquid

[184] Cook & Bernheimer Co. v. Ross (1896) 73 Fed. 203.
[185] Jennings v. Johnson (1888) 37 Fed. 364.
[186] Myers v. Theller (1889) 38 Fed. 607.
[187] Bininger v. Wattles (1865) 28 How. Pr. (N. Y.) 206.

bluing, a bright metallic cap of tin, that extended down over about one-half of the rim at the mouth of the bottle, the cap having six perforations, the defendant was restrained from using, for the sale of his bluing, a similar cap, and bottles of the same shape and appearance as those of the plaintiff.[188]

It was held that the label and method of preparation for market of "Hostetter's Celebrated Stomach Bitters" was infringed by that adopted for "Clayton & Russell's Celebrated Stomach Bitters," inasmuch as the latter was plainly copied from the former by design, and its general effect was such as to deceive the ordinary observer having no cause to use more than ordinary care. It was shown that there were no such persons as Clayton and Russell, and that defendant's label was prepared from plaintiffs' by intentionally imitating it in parts thereof. The court said: 'It is plain that it is a copy from the plaintiffs' by design. Variations are made of such a character as to be capable of discernment and description; but the general effect to the eye of an ordinary person, acquainted with the plaintiffs' bottle and label, and never having seen the defendant's label, and not expecting to see it, must be, on seeing the defendant's, to be misled into thinking it is what he has known as the plaintiffs'. The size, color, and shape of the bottle, the four lines of letters at the top of the label being, as to the three lower ones, identical, and, as to the upper one, differing only in the name, the general effect of the horse and his rider, the size and shape and color of the shield, the white letters in it, and their size and arrangement in lines contracting in length towards the lower point of the shield, the whole in black on a white ground, and the border, give an affirmative resemblance calculated to deceive an ordinary observer and purchaser, having no cause to

[188] Sawyer Crystal Blue Co. v. Hubbard (1887) 32 Fed. 388, citing Evans v. Von Laer (1887) 32 Fed. 153.

use more than ordinary caution, and make him believe he has before him the same thing which he has before seen on the plaintiffs' bottle, and expects to find on the bottle he is looking at. The differences which he would see on having his attention called to them are not of such a character as to overcome the resemblances to the eye of a person expecting to see only the plaintiffs' bottle and labels, and having no knowledge of another. * * * The plaintiffs have no exclusive right to make the bitters. Their trade-mark is not in the words, 'Celebrated Stomach Bitters,' nor have they any exclusive right to a bottle of the size, shape, and color of the one which they use. But the entire style of their bottle and label, of which those words form a part, is, in connection with the other particulars above mentioned, in which the defendant's bottle and label are like theirs, the mark of their trade."[180]

§ 269. Bottle Stamped with Complainant's Label or Name.

A manufacturer will be restrained from using, for the sale of his product, the old bottles of another dealer, used for a similar article, having such other dealer's name upon them.

Where it appeared that the defendant manufactured an article resembling Hostetter's Bitters manufactured by the complainant in color and in other particulars, and sold the same to retail dealers under the name "Host-Style Bitters," in large demijohns without labels, and it was shown that in several instances the defendant had given to a purchaser of his bitters an empty bottle which bore all the complainant's labels, it was held that although it appeared that the purchaser from the defendant was not deceived, the defendant had furnished the means of deceiving the public, and should be enjoined from selling Host-Style Bitters, and at the same

[180] Hostetter v. Adams (1882) 10 Fed. 838.

time, in connection, giving to the public empty Hostetter bottles.[190]

Both parties were dealers in lime juice, and the contention was that defendants had no right to sell lime juice in bottles bearing complainant's name. The court said: "I am aware that the name is on the bottom of the bottle, and that it is not very prominent; but while the defendant may buy in the market these bottles, and sell them again filled with anything but lime juice, I do not think he should be permitted to put his own lime juice into a bottle stamped with the complainants' name, and sell it. This may be said to be calculated to lead the public to believe they are buying the complainants' lime juice, when in point of fact they are buying some other person's."[191]

§ 270. Exclusive Right to Box.

The fact that the plaintiff was the first to put up a particular kind of merchandise in boxes does not give him an exclusive right to their use for that purpose, and he is therefore not entitled to a preliminary injunction against the use of a similar box by another manufacturer, unless it is clearly shown that the similarity is such as likely to mislead and impose upon ordinary purchasers exercising such care only as is commonly used in purchasing such articles. In a recent case in the federal court[192] it was said: "I substantially quote a portion of the court's opinion in Van Camp Packing Co. v. Cruikshanks Bros. Co.[193] when I say of the present case that the defendants' use of boxes similar to the

[190] Hostetter Co. v. Becker (1896) 73 Fed. 297. See chapter 4, § 200.

[191] Evans v. Von Laer (1887) 32 Fed. 153, citing Rose v. Loftus (1878) 38 Law T. (N. S.) 409; Richards v. Williamson (1874) 30 Law T. (N. S.) 746.

[192] Pfeiffer v. Wilde (1900) 102 Fed. 658. See chapter 3, § 79.

[193] (1898) 33 C. C. A. 280, 90 Fed. 814.

plaintiffs', without more, could not be complained of. It is a common way of packing various articles of merchandise, and, even if the plaintiffs were the first to apply it to packing 'Coffee Essence,' they have not thereby obtained a monopoly of its use for that purpose. The boxes and their markings are readily distinguishable from the plaintiffs' by intelligent persons, and, with care, ordinary purchasers would probably distinguish them. The question, however, is, did they bear such similarity as is likely to impose on ordinary purchasers, exercising such care only as is commonly used in purchasing such articles? This question cannot be answered with certainty or safety from the evidence before me. There is no proof that any one has been so misled. In this state of uncertainty, a preliminary injunction should not be awarded. To justify a preliminary injunction, the plaintiffs' case must be clear in all respects."[194]

§ 271. Every-Day Soap Case.

The soap manufactured by complainant was sold in packages with a yellow wrapper, on the side of which was printed in black letters the words "Every-Day Soap," together with the name and location of the maker. There was a small circular figure containing a representation of the moon and stars on a black ground. The defendant sold its soap in packages of a similar size and shape, with a yellow wrapper. On one face of it was a black ground, showing only the

[194] See, also, Lare v. Harper & Bros. (1898) 30 C. C. A. 373, 86 Fed. 481. In Centaur Co. v. Hughes Bros. Mfg. Co. (1898) 34 C. C. A. 127, 91 Fed. 901, the lower court refused a preliminary injunction and the judgment reversing this decree was that of a divided court. Franck v. Frank Chicory Co. (1899) 95 Fed. 818, was not decided upon a motion for a preliminary injunction, but on a final hearing, and it was manifest from the undisputed testimony that the defendants entered the field with an intention which was both calculated to and which did deceive purchasers.

words "Every-Day Soap," in letters formed by the yellow paper of the wrapper showing through the black field of the label. The other figures displayed on the sides and back of the label bore no resemblance to anything on complainant's, and the name and location of the maker were conspicuously shown on one side of the package. Upon this showing, an injunction was refused.[105]

§ 272. Baker's Breakfast Cocoa Case.

The complainant used for its powdered cocoa a tin case of peculiar shape and size, with the words "Walter Baker & Co.'s Breakfast Cocoa" stamped on the lid end of the can, * * * and on one side of the can a picture of "La Belle Chocolatiere," * * * and the defendant, for the same goods, used a tin can of the same shape and size as that of the complainant's, with the words "W. H. Baker & Co.'s Breakfast Cocoa" stamped on the lid end of the can. On one of its sides was a picture of the bust of a girl, and the words "Baker's Cocoa" in large capitals. Defendants were enjoined from using cans of the same shape as those of the complainant, and from using the words "Breakfast Cocoa" in connection with the word "Baker," and from using, on the side of the can where there appeared the bust of the girl, the words "Baker's Cocoa."[106]

§ 273. Moxie Case.

It appeared that the complainants, who were engaged in the sale of a certain beverage, used a trade-mark which consisted of the word "Moxie," with a label containing a picture and descriptive words. They also used a champagne

[105] Proctor & Gamble Co. v. Globe Refining Co. (1899) 34 C. C. A. 405, 92 Fed. 357.

[106] Walter Baker & Co. v. Baker (1896) 77 Fed. 131.

bottle, wrapped in a peculiar light-brown paper, with the words "Moxie Nerve Food" printed prominently thereon. After complainants had carried on business for some time, and acquired a large business, the defendants began the manufacture of a preparation similar in color, taste, and flavor to that of the complainants', and similarly put up in champagne bottles, with a label and wrapper sufficiently resembling that of the complainants to deceive the general public. It bore the words, "Standard Nerve Food," under which appeared the words "Genuine. Beach & Claridge," written across the label. The defendants were enjoined from putting on the market for sale any packages or bottles of the style of champagne bottles in use by the complainants, containing a liquid resembling that sold by the complainants as "Moxie Nerve Food" in taste, flavor, or appearance, and from using the words "Nerve Food," either alone or with other words, upon the outside or upon the wrapper of any package containing such fluid.[197]

§ 274. Mumm's Extra Dry Case.

As early as 1866, the plaintiffs, at Rheims, originated a champagne wine having a "dry" flavor, which was extensively sold in the United States as "G. H. Mumm & Co.'s Extra Dry," and was distinctively known by the words "Extra Dry." They adopted a new and characteristic metal capsule of a peculiar rose color, never before used, and on top of it was stamped in blue an imperial mantle, bearing the trade-mark. The words "G. H. Mumm & Co." ran perpendicularly below the capsule. Just below the capsule was a small label, on which the trade-mark was also imprinted. The principal label of the bottle also bore this trade-mark on its upper field. The defendants sold aerated American wine in

[197] Moxie Nerve Food Co. v. Baumbach (1887) 32 Fed. 205.

ordinary champagne bottles, and on the upper part of the principal label they put the words "Extra Dry," and also a colorable imitation of the Mumm trade-mark. Just below the capsule they placed a small label bearing a similar imitation of the trade-mark and mantle, and the words "Extra Dry." The metal capsule was of the peculiar color used by Mumm & Co., and on its top was stamped in blue an imitation of the trade-mark and mantle, while the words "Extra Dry" were stamped perpendicularly thereon in the same manner as on that of the plaintiffs. As a matter of fact, the defendants' wine had no "dry" quality, and the court found from the testimony that the words "Extra Dry" were used to mislead, and that their bottles were dressed up so as to enable them to be sold as the goods of the plaintiff. Upon this showing, the defendants were enjoined (1) from further dressing up their product in this manner, or from using any combination of marks, labels, or capsules described; (2) from using any colorable imitation of the plaintiff's trade-mark; (3) from placing the words "Extra Dry" on any bottle of their product of the character described, either in combination or otherwise; and (4) from surrounding any cork of any bottle of the form generally used for champagne, and containing their product, with a rose-colored metal capsule, whether stamped as stated or otherwise.[108] It was held that one who puts into the hands of retail dealers any article made by him, and so dressed up as to enable such dealers to deceive the ultimate purchaser into the belief that he is purchasing goods of a third person, may be enjoined by the latter. "No man is permitted to use any mark, sign or symbol, device, or other means whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false represen-

[108] Von Mumm v. Frash (1893) 56 Fed. 830.

tation to somebody else who is the ultimate purchaser.[199] * * * In this case it has been made plain that the defendants dress up their manufacture in a manner well calculated to deceive an intending purchaser not initiated, and induce him to believe that the article purchased is the wine of the complainants, known as 'G. H. Mumm & Co.'s Extra Dry." This dress the defendants adopt for the purpose of enabling such a fraud to be practiced. No other reason has been suggested, and none exists. The fact that an article such as the defendants make is dressed up by them as they dress it proves the existence of knaves willing to use the defendants' article for the purpose of deceit, and also the existence of persons not initiated capable of being deceived into buying the defendants' manufacture as 'G. H. Mumm & Co.'s Extra Dry.' If there were no such persons, the defendants never would have gone to the expense of dressing up their product as they do. But it is said that the defendants are guiltless, because they have never stated anything but the truth in regard to their manufacture. The earnestness with which this ground of defense has been pressed upon the court justifies some further comment upon the character of the act of the defendants in dressing up their article as they do. What the defendants do is this: They make and put in the hands of other persons the means of fraud, knowing that these means can be, and probably will be, employed for the purpose of fraud, and to the injury of the complainants. The defendants make and sell, knowingly, the tools for fraud; and they, and the knaves who buy the tools of them, intending to use them for the fraudulent purpose for which they were constructed, are co-conspirators, each guilty of the fraud perpetrated in pursuance of the intention with which the tools

[199] Singer Mfg. Co. v. Loog (1880) 18 Ch. Div. 395, 412. See section 235, supra.

were made, and this although the particular person intended to be defrauded is not agreed upon between them."

§ 275. Silicon Case.

The plaintiff had adopted and used the word "Silicon" on a round wooden box, with a yellow paper cover, with border and printing thereon for the top and sides of the box,—all three elements in combination. The defendant, although not using the same associate words, imitated plaintiff's combined use of these elements so as to inflict an injury upon plaintiff, and in a way well calculated to deceive purchasers. Although plaintiff was not entitled to the exclusive use of the word, it was held that defendant should be restrained from using it in such connection.[200]

§ 276. Sapolio Case.

The plaintiffs for many years had manufactured Sapolio, and the article had acquired an established reputation. The defendants, after ascertaining how the article was manufactured, began making an article similar in character, color, and appearance, which it called "Saphia." It was admitted that this was a fanciful name, of no particular derivation or signification. The cakes of Saphia were inclosed in wrappers which also closely resembled, in their external and internal appearance, as to color, size, and partially as to description and directions for use, those of the plaintiffs. The court being satisfied that the wrapper as used by defendant was calculated to deceive the general public, and that the ordinary purchaser was in fact deceived by the similar dress in which the soaps were put on the market, it was held that the plaintiffs were entitled to an injunction restraining him from selling Saphia in the blue packages in which it was sold. The

[200] Electro-Silicon Co. v. Levy (1880) 59 How. Pr. (N. Y.) 469.

defendant, however, was entitled to manufacture and sell the article under the name of "Saphia" so long as he abstained from dressing his goods in wrappers which so closely resembled plaintiffs' as to enable him to deceive the public, and thus perpetrate a fraud.[201]

In another case it appeared that for many years plaintiff had sold polishing soap put up in cakes wrapped in paper coated with tinfoil, and having around the edge of each cake a blue paper band, with gilt letters printed thereon. Each cake was stamped with the words, "Enoch Morgan's Sons' Sapolio." Thereafter defendants prepared and sold soap which they put up in cakes wrapped in tinfoil, having a blue paper band around them similar to that used by the plaintiff, upon which was stamped "Troxell's Pride of the Kitchen Soap." It appeared that the defendants sold and delivered soap to grocers with the intent that it should be, and the same was, as a matter of fact, sold as Sapolio. Upon this evidence, defendants were enjoined from so preparing and selling the said soap.[202]

§ 277. Hostetter's Bitters Case.

For many years plaintiff had sold Hostetter's Bitters in bottles of a peculiar form and size, and had established a large business therein. The defendant sold spurious bitters, which closely resembled the real article, in demijohns, labeled "Histetter's Bitters," with intent that they should be sold by the drink at bars as "Hostetter's Bitters." The court said: "Complainant is entitled to protection against the appropriation of its trade-mark by any and all unfair and dishonorable means, and a court of equity has power to grant such pro-

[201] Enoch Morgan's Sons' Co. v. Schwachhofer (1878) 55 How. Pr. (N. Y.) 37.

[202] Enoch Morgan's Sons' Co. v. Troxell (1881) 23 Hun (N. Y.) 632.

tection whenever it is satisfied that an attempt has been made, by ingenious subterfuges, to invade the rights of an owner of a trade-mark, either by a conspiracy with others to deprive him of such rights, or by misrepresentation in the sale of a spurious article so manufactured as to deceive the public."[203]

§ 278. Black Package Tea Case.

In this case it was held [203a] that there could be no exclusive right to a trade-mark which represents an idea, nor an exclusive appropriation of that which is descriptive of the articles to which they are attached, or which indicates their ingredients, mode of composition, characteristic qualities, properties, or nature, and that, in order to have the right of a trade-mark, it must be some arbitrary figure or term not suggestive of the nature of the article. This action was brought to restrain the defendant from an alleged infringement of plaintiffs' wrappers, labels, and packages used in the sale of tea, and of their alleged trade-name of "Black Package Tea." The referee found that plaintiffs' tea was put up in packages of a peculiar form with black wrappers, having thereon three scenes in white, a certain yellow, also a silver, circular label, and a white diamond-shaped one. This tea became known in the market as "Black Package Tea," and was known to Russians as "Russian Caravan Tea," which words appeared in Russian on the packages. After plaintiffs' tea became well known in the market, the defendant adopted and used, in the sale of tea not of the plaintiff's importation, wrappers similar in color, and with similar labels and devices, with the words "Genuine Russian Tea," in Russian. The tea was put up in packages of a shape similar to that used by the plaintiffs. An interlocutory judgment was entered, which provided that the plain-

[203] Hostetter Co. v. Sommers (1897) 84 Fed. 333.

[203a] Citing Koehler v. Sanders (1890) 122 N. Y. 65, 72.

tiffs were entitled, as against defendant, to the exclusive use of the style of wrappers adopted by them, the circular yellow and silver and the white diamond shaped labels, and the peculiar form of package, and the defendant was restrained from using any imitation thereof, and also from using the words "Black Package Tea" in connection with the sale of tea not of the plaintiffs' importation. On final hearing it was held that this judgment was too broad, and that plaintiffs had no separate proprietary right to the form of package, or the name "Black Package Tea," or the circular or diamond shaped label, or the Russian words; but that, while there was no single point of resemblance which of itself would authorize equitable relief, and each one of these distinguishing marks might be separately used by the defendant, it was not entitled to combine all or a part of them in a single package, so arranged as likely to deceive a purchaser of ordinary intelligence, and to produce a false impression that the tea offered for sale therein was the plaintiffs' tea. To this extent the plaintiffs were entitled to protection by injunction. That part of the interlocutory judgment which provided for the destruction of the defendant's labels was error, as they might be used for lawful purposes.[204]

[204] Fischer v. Blank (1893) 138 N. Y. 244. The court further said: "It must be admitted that there is no single point of resemblance or imitation which would of itself be regarded as adequate grounds for the grant of equitable relief. Form alone would not be sufficient; nor size; nor color; nor the general decoration of the panels; nor disks of the same size and color arranged in the same way; nor a label of the same shape and color attached to the same part; nor the use of the same name to designate the kind or quality of tea. Each one of these distinguishing features might be separately used, and no harm result; but when all or a number of them are combined in a single package, and so arranged and exhibited that, when they strike the eye of the intending purchaser, possessed of ordinary intelligence and judgment, the false impression is likely to be produced that the goods of the plaintiffs are offered, it is the province

§ 279. Cuticura Case.

Plaintiff was the proprietor of the word "Cuticura" as a trade-mark for toilet soap. The defendant put up for sale, and placed upon the market, a toilet soap under the name of "Cuticle" soap. The circulars which the defendant inclosed in the wrappers with each package of soap copied some of the reading matter from the circulars which plaintiff inclosed with its packages, and the style of letters used in printing the name "Cuticle" was also somewhat similar to those in which the name "Cuticura" was printed by the plaintiff. It was held that such facts did not establish unfair competition, where defendant's soap itself was of a different color from complainant's, and the wrappers inclosing each cake, and the box in which a number of cakes were inclosed, were so entirely dissimilar in color and general appearance that no purchaser of ordinary observation would be deceived thereby. "It is not obvious," said the court, "how any person of usual eyesight or observation could be misled or confused respecting these articles by the appearance of the articles, by the wrapping immediately about the same, by the exterior wrapping, or by the exterior surroundings. In other words, what a purchaser would ordinarily and necessarily see in selecting the article could in no instance lead him into error in making

of equity to interfere for the protection of the purchasing public, as well as of the plaintiffs, and for the suppression of unfair and dishonest competition. The true test, we think, is whether the resemblance is such that it is calculated to deceive, and does in fact deceive, the ordinary buyer making his purchases under the ordinary conditions which prevail in the conduct of the particular traffic to which the controversy relates. Franks v. Weaver (1847) 10 Beav. 297; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Colman v. Crump (1877) 70 N. Y. 573; McLean v. Fleming (1877) 96 U. S. 245; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537. No inflexible rule can be laid down,—each case must in a measure be a law unto itself."

his purchase. The contents of the inner circulars, however, show greater similarity, although there is absolute dissimilarity in appearance."[205]

§ 280. Liebig's Beef Extract Case.

For many years the Liebig Extract of Meat Co., Limited, had sold its product in the markets of the United States, and obtained a wide reputation. The defendant thereupon entered the market with a similar extract, distinctively dressed, but he subsequently sent out goods in a package so similar to that of the complainant in color and general appearance as to show that deception was intended, and so liable to result in the sale of the goods to the ultimate purchaser. He also used on the name of such packages, as the name of the manufacturer, the fictitious title of "Liebig's Fluid Beef Co." He was held guilty of unfair competition, the court saying:[206] "The manufacture of the beef extracts in question is open to all the world, and the manufacture in accordance with the Liebig formula is equally open to defendants, under that name, 'subject, however, to the condition that the name must be so used as not to deprive others of their rights, or to deceive the public, and therefore that the name must be accompanied with such indication that the thing manufactured is the work of the one making it, as will unmistakably inform the public of that fact.'[207] The complainant has possessed, in the United States, a trade in its products for more than thirty years, and for many years its trade has been of great extent, aided by large expenditures for advertising. The defendant entered the market with an extract which was

[205] Potter Drug & Chemical Corp. v. Pasfield Soap Co. (1900) 102 Fed. 490.

[206] Liebig's Extract of Meat Co. v. Libby (1900) 103 Fed. 87.

[207] Citing Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002.

well distinguished in the marking and the color of the package, but subsequently, in the Walker transaction at least, adopted a dress for the goods which clearly simulated that of the complainant, and was calculated to deceive. He assumed, as the name of the producer, the fictitious title of 'Liebig Fluid Beef Co.,' with the label stamped in blue, 'J. Walker,' and the color and general appearance of the package closely resembled that of complainant. It is true that 'Union Stock Yards, Chicago, U. S. A.,' appears on this label, but, taking all the circumstances, it is evident that deception was both intended and liable to arise in palming off the goods upon ultimate purchasers as those of complainant. The other exhibits, which bear the same color and fictitious title, taken with the shape and general appearance, although without blue signature, are deemed obnoxious and inexcusable under all the circumstances."[208]

§ 281. "Franck Chicory" Case.

For a half a century the firm of Heinrich Franck Soehne, of Germany, were extensive and well-known manufacturers from chicory of a substitute for coffee, having several factories in Europe. Their product was known and sent to all parts of the world as "Franck Kaffee," and afterwards as "Franck Chicory." For upwards of thirty-five years they had a large trade in this product in the United States, and in 1895 established at Flushing, Long Island, a branch firm under the name of "Heinrich Franck Soehne & Co.," who were the complainants in this action. In their business they had used the names "Franck Chicory" and "Genuine Franck," or "Echter Franck" (the German equivalent). The packages had been made, for upwards of twenty-five years,

[208] Citing Charles E. Hires Co. v. Consumers' Co. (1900) 41 C. C. A. 71, 100 Fed. 809.

in cylindrical form, inclosed in red paper, and were familiarly known as "Franck's Red Roll Chicory." Under the name of "Franck," and in such livery, their product obtained some degree of popularity among the Germans of Wisconsin, and especially at and in the vicinity of Milwaukee, including Cedarburg, where the defendants' business was established. In 1892, the Frank Chicory Company, deriving its name from one Frank, a chicory raiser and small stockholder, was organized at Cedarburg, and entered upon the manufacture of chicory under that name in packages which were clearly a colorable imitation of the complainant's production. Thereafter, when the question of infringement was raised, the defendants changed the label of a portion of their production to read "Cedarburg Chicory Co.," instead of "Frank Chicory Co.," but reserved the same general appearance, form, and color, and the earlier labels were not discontinued in actual use. "As it is manifest," said the court, "from the undisputed testimony, that the defendants entered the field with the imitation which was both calculated to and did deceive purchasers who were familiar with the complainants' goods, and thus captured the trade of the latter, and the substituted label is a continuation of that deception in its appearance as a whole, I am of opinion that the defendants must be enjoined from the use of either label, and from using on the label the name 'Franck' or 'Frank' to designate their goods, or to use a label which is so identical in color as to preserve the deception. * * * Under the circumstances shown, however, there can be no just relief from the unfair competition without a change in color as well."[209]

§ 282. "Velvet" Candy Wrapper Case.

A. manufactured molasses candy, which he wrapped in pa-

[209] Franck v. Frank Chicory Co. (1899) 95 Fed. 818.

per with twisted ends, with the word "Velvet" printed in red script letters upon the middle and ends of the wrappers. Others had sold molasses candy of the same size and shape, and wrapped the pieces in the same way, so that the combination was not original with A. The defendant company used the same combination and size and shape of candy, and the same kind and size of paper and manner of wrapping, all of which it had a right to do; but to this it added, printed in Roman letters instead of script, the word "McDonald" in red ink upon the middle of the wrapper, but not at the ends. It appeared that the public was in fact deceived into the belief that defendant's goods were plaintiff's goods, and that the resemblance was not accidental. Upon this showing, the court held that the plaintiff was entitled to an injunction restraining defendant " 'from printing or causing to be printed in red upon yellow wrappers, adapted to be used in putting up molasses candy, substantially in the size, shape, and manner in which said plaintiff * * * puts up and offers for sale the molasses candy made by him, the name McDonald, or any other name, word, mark or device whereby any candy sold or offered for sale by the defendant shall be caused to resemble, in its dress and appearance, said candy of the plaintiff, and also from putting up, offering for sale, or selling any molasses candy, or candy similar thereto, put up in yellow wrappers, with the red printing thereon substantially like the method employed by the plaintiff."[210]

§ 283. Old Coon Smoking Tobacco Case.

In 1883 plaintiffs began putting up their "Old Coon Smoking Tobacco" in cloth bags containing a label which they had previously used on paper bags, in which they had been accustomed to put up the same tobacco. Soon afterwards,

[210] Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16.

in the fall of 1883, the defendant began putting up his "Old Bachelor Smoking Tobacco" in cloth bags of the same size. At the same time he changed his label, which previously had borne no colorable resemblance to that of the plaintiffs, to a label of a form, size, and color substantially like that of the plaintiffs, with the exception of the words "Not Old Coon." The court said: "Leaving out of view the fact that the defendant began putting up his tobacco in cloth bags soon after the plaintiffs began putting up their tobacco in the same kind of packages, which the defendant explains by stating that smoking tobacco could no longer be sold in paper packages, we find that there are no less than six distinct points of resemblance between the two labels: (1) The general form; (2) the oval vignette; (3) the lettering on the white field on the left-hand side; (4) the lettering on the white field on the right-hand side; (5) the size; (6) the general color. In view of these points of resemblance, it is scarcely probable that, when the defendant designed this label, he did not have in his mind the distinct purpose of making as close an imitation of the plaintiffs' label as he felt it safe to do. Now, as he admits in his testimony that, since he adopted this label, his trade has increased, and does not state any facts which lead to the inference that this increase has been due to any other cause than his success in making this colorable imitation of the plaintiffs' label, we think it a fair conclusion that he had the purpose in view of banking, so to speak, on the plaintiffs' reputation, and that he has measurably succeeded in so doing. We do not think that the printing of the words, 'Not Old Coon,' upon the defendant's label, affords a sufficient reparation of the wrong."[211]

§ 284. Simmons' Liver Medicine Case.

Where it appeared that the defendant put on the market

[211] McCann v. Anthony (1886) 21 Mo. App. 83.

packages of medicine labeled "Dr. Simmons Liver Medicine," in packages so substantially similar to those in which the complainant's "Simmons Liver Medicine" had been previously sold as to deceive the public, and that this was done with the purpose of selling it in the place of the complainant's medicine, the latter was granted an injunction to restrain the use of such labels and packages by defendant.[212]

§ 285. Awl Package Case.

A manufacturer put up awls in a distinctive package, consisting of a bronze colored box, having a brown label on the top and one side with printed inscriptions, and tied with an orange string. Ten years after he began the use of this package, which use, although small at first, had increased largely during the last two years, another manufacturer of awls began the use of a package indistinguishable in every particular, even to the words of the inscription and the size and shape of the type, except that at the bottom, in letters and arrangement as nearly like the plaintiff's as possible, instead of "Manufactured and Warranted by the New England Awl & Needle Co.," in a certain town, the label read, "Manufactured for the United States Awl & Needle Co.," in a certain city. It was held that plaintiff was entitled to an injunction.[213]

[212] C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84, 23 S. W. 165.

[213] New England Awl & Needle Co. v. Marlborough Awl & Needle Co. (1897) 168 Mass. 154. The court said: "The principles upon which the rights of the parties are to be determined are similar to those which are well known to govern trade-marks, although the combination of elements is more complex than in devices which commonly go by that name. Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16; Chadwick v. Covell (1896) 151 Mass. 190, 194; Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598, 604; McLean v. Fleming (1877) 96 U. S. 245, 253, 254; Taend-

sticksfabriks Akticbolagat Vulcan v. Myers (1893) 139 N. Y. 364; Hall v. Barrows (1863) 4 De Gex, J. & S. 150, 159; Singer Machine Mfrs. v. Wilson (1877) 3 App. Cas. 376, 389; Turton v. Turton (1889) 42 Ch. Div. 128, 141; Kerly, Trade Marks, 13-15. The report states that it did not appear whether or not any purchaser of awls had learned to recognize the plaintiff's awls by the appearance of the packages. This cannot mean more than that there was no direct testimony to that effect. But the fact that the plaintiff had used the combination since 1885, and largely since 1893, is enough to raise a presumption in its favor. McAndrew v. Bassett (1864) 4 De Gex, J. & S. 380, 384, 385. * * * The plaintiff did not claim the exclusive right to brown labels for awls, but it claimed the exclusive use of the brown color in the combination which we have described. If the only other element besides the color had been a box of a certain size and a label of a certain shape, the case might be different (Enoch Morgan's Sons Co. v. Troxell [1882] 89 N. Y. 292), but when there is added an inscription which, both in its pictorial aspect of black marks, and in its meaning, was calculated to confuse, if not to deceive, the plaintiff's claim seems to us moderate (Frese v. Bachof [1878] 14 Blatchf. 432, Fed. Cas. No. 5,110; Sawyer v. Horn [1880] 4 Hughes, 239, 253, 1 Fed. 24; Carbolic Soap Co. v. Thompson [1885] 25 Fed. 625; Jennings v. Johnson [1889] 37 Fed. 364; Wellman & Dwire Tobacco Co. v. Ware Tobacco Works [1891] 46 Fed. 289; N. K. Fairbank Co. v. R. W. Bell Mfg. Co. [1896] 23 C. C. A. 554, 77 Fed. 867)."

CHAPTER XI.

COURTS AND PARTIES.

§ 286. Jurisdiction of United States Courts.
287. Jurisdiction of State Courts.
288. Parties Plaintiff.
289. Parties Defendant.

§ 286. Jurisdiction of United States Courts.

The United States courts have jurisdiction of suits brought for the infringement of trade-marks registered under the laws of the United States, irrespective of the amount in controversy, and irrespective of the citizenship of the parties, where the mark claimed to be an infringement is used by the defendant upon goods intended to be transported to a foreign country,[1] and suit is brought upon the trade-mark as a registered trade-mark. The proprietor of a registered trade-mark may ignore his registration, and sue upon his mark as a common-law trade-mark, in which case a United States court will not have jurisdiction unless the requisite diversity of citizenship exists. In all other cases involving trade-marks, in all cases involving trade-names, and in all cases to restrain unfair competition, the United States courts have jurisdiction concurrently with the courts of the several states, provided the amount in controversy exceeds $2,000 in value, and provided, also, the controversy is between citizens of different states, or between citizens of a state and foreign states, citizens, or subjects.[2] Unless the

[1] 21 Stat. 502 (March 3, 1881); Luyties v. Hollender (1884) 21 Fed. 281; Schumacher v. Schwencke (1886) 26 Fed. 818.

[2] 24 U. S. Stat. 552 (March 3, 1887); 25 U. S. Stat. 434 (Aug. 13,

complainant's trade-mark is used on goods intended to be transported to a foreign country, a United States 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 in this country 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.[a]

When complainant and defendant are citizens of the same state, a federal court can take jurisdiction only of the question whether the registered trade-mark declared upon is valid and has been infringed. If there is no valid trade-mark, or if there has been no infringement, the suit must be dismissed, notwithstanding the fact that the complaint may disclose a cause of action based upon unfair competition.[4] While it is the rule that, where a federal question is involved, a court is justified in adjudicating all questions growing out of the matter in controversy, if the trade-mark is invalid, or there is no infringement of a registered trade-mark, there is no federal question involved, even though the bill of complaint alleges infringement of a registered trade-mark. In determining the jurisdiction of the court, the amount in controversy is the value of the trade-mark to be protected, and not

1888); Battle v. Finlay (1892) 50 Fed. 106; Hennessy v. Braunschweiger & Co. (1898) 89 Fed. 664.

[3] Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823; Graveley v. Graveley (1890) 42 Fed. 265; Ryder v. Holt (1888) 128 U. S. 525; Elgin Nat. Watch Case Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665; Luyties v. Hollender (1884) 21 Fed. 281, (1887) 30 Fed. 632; Graveley v. Graveley (1890) 42 Fed. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co. (1892) 53 Fed. 493.

[4] Goldstein v. Whelan (1894) 62 Fed. 124; Burt v. Smith (1895) 71 Fed. 161.

the amount of damages that have been sustained, or the amount of profits to be recovered.[5]

Actions in the United States courts, when the jurisdiction is founded upon a registered trade-mark, can be brought only in the district of which the defendant is an inhabitant.[6] When the jurisdiction is founded on the fact that the parties are citizens of different states, the suit may be brought in the district of which either party is an inhabitant.[7] If suit is brought in the district of which the plaintiff is an inhabitant, proper service on the defendant must be had, unless the defendant, by entering a general appearance in a suit brought against him in a district of which he is not an inhabitant, waives the right to object that it is brought in the wrong district.[8] A suit against a corporation founded upon a trade-mark registered under the act of 1881 must be brought in the state in which the corporation is created.[9] A suit against a corporation, where the jurisdiction is founded upon diversity of citizenship, can be brought in a state other than that in which it is incorporated by a person who is a resident of the district in which the suit is brought,[10] but not by a person who is a nonresident of such district.

§ 287. Jurisdiction of State Courts.

The courts of the several states have jurisdiction in all

[5] Symonds v. Greene (1886) 28 Fed. 834; Hennessy v. Herrmann (1898) 89 Fed. 669.

[6] 24 U. S. Stat. 552 (March 3, 1887).

[7] 25 U. S. Stat. 434 (Aug. 13, 1888).

[8] 25 U. S. Stat. 434 (Aug. 13, 1888); Interior Construction & Improvement Co. v. Gibney (1895) 160 U. S. 217.

[9] In re Keasbey & Mattison Co. (1895) 160 U. S. 221.

[10] In re Keasbey & Mattison Co. (1895) 160 U. S. 221; McCormick Harvesting Mach. Co. v. Walthers (1890) 134 U. S. 41; Shaw v. Quincy Min. Co. (1892) 145 U. S. 444; Southern Pac. Co. v. Denton (1892) 146 U. S. 202.

cases involving trade-marks, trade-names, and unfair competition in business, except where a trade-mark registered under the United States laws is involved, and the suit is brought to enforce the rights secured by the United States statutes.[11]

§ 288. Parties Plaintiff.

As a trade-mark may be acquired and held by any person, firm, or corporation, it follows that any person, firm, or corporation may be the plaintiff in an action to restrain the further infringement of a trade-mark, or to recover damages for its past infringement. The same rule applies as to parties plaintiff in cases involving trade-names or unfair competition. Where suit is brought in a United States court upon a registered trade-mark as such, the residence of the plaintiff is immaterial. He may be a resident of the same state as the defendant, and he may be either an alien or a citizen. An alien who has sold his goods and used his trade-mark in the United States enjoys all of the rights of a citizen, both as to common-law rights and under the registration statutes.[12] As said by Judge Wallace, of the United States circuit court: "The fact that complainant is an alien does not affect his right of property in a trade-mark; but that fact, as it establishes the requisite diversity of citizenship between the parties to confer jurisdiction upon this court, is indispensable to the cause of action alleged."[13] A foreigner who has never introduced his goods or conducted

[11] Smail v. Sanders (1889) 118 Ind. 105.

[12] Davis v. Kennedy (1867) 13 Grant Ch. (Can.) 523; Taylor v. Carpenter (1846) 2 Woodb. & M. 1, Fed. Cas. No. 13,785; Taylor v. Carpenter (1844) 3 Story, 458, Fed. Cas. No. 13,784; Taylor v. Carpenter (1844) 11 Paige (N. Y.) 292, 42 Am. Dec. 114, (1846) 2 Sandf. Ch. 603; Collins Co. v. Reeves (1858) 28 Law J. Ch. 56, 4 Jur. (N. S.) 865; Collins Co. v. Brown (1857) 3 Kay & J. 423, 3 Jur. (N. S.) 929, 29 Law T. 245.

[13] La Croix v. May (1883) 15 Fed. 236.

trade in the United States or used his trade-mark rights in connection therewith, no matter how extensive his trade-mark rights or the extent of his trade abroad, has no trade-mark rights in the United States except so far as these rights may be secured by the international convention.[14]

In a case of unfair competition in business, where one person or corporation is entitled to relief, two or more persons or corporations, having a common interest in preventing the fraud, may unite to maintain a suit in equity.[15] An injunction will not be issued to restrain infringement of a trade-mark on a bill to which an exclusive licensee is not a party.[16] Where a distiller granted the sole and exclusive control of his bottled goods for a period of years, and agreed not to permit others to use his trade labels, a bill by the licensee to enjoin infringement of the trade-marks, which did not make the distiller a complainant, or state any reason for not doing so, was held defective.[17]

§ 289. Parties Defendant.

The manufacturer of an article bearing a spurious trade-mark, every one who sells the article, whether knowing of the infringement or not, and every one who contributes directly or indirectly to the infringement, as by printing the infringing labels, may be made a defendant in an action to restrain the infringement of a trade-mark.[18] "Ordinarily the infringer cannot escape responsibility by showing that he was acting for another. In torts of misfeasance, like the violation of a trade-mark, agents and servants are personally liable to the injured party. All persons procuring or assisting in the

[14] 26 Am. & Eng. Enc. Law (1st Ed.) 485.

[15] Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 86 Fed. 608.

[16] Wallach v. Wigmore (1898) 87 Fed. 469.

[17] Krauss v. Joseph R. Peebles' Sons Co. (1893) 58 Fed. 585.

[18] Low v. Hart (1882) 90 N. Y. 457; Coats v. Holbrook (1845) 2 Sandf. Ch. (N. Y.) 586.

commission of a trespass are principals in the transaction, and both the master who commands and the servant who does the act of trespass may be made responsible as principals, and may be sued jointly or severally for damages, as the injured party may elect. A joint action will lie against the principal and agent. If separate actions are brought against several joint trespassers, the plaintiff may proceed to judgment in all; and the judgment against one is not a bar to a trial and recovery against the others, although there can be but one satisfaction."[19] Persons who ignorantly sell articles bearing the spurious trade-mark will usually not be protected by that fact against injunction. If, however, an innocent vendor ceases infringement at once, upon being notified, he will not be subjected to costs or damages.[20] The same rules apply in cases involving trade-names. In cases of unfair competition, an action will not lie against an innocent or ignorant vendor, as fraud lies at the foundation of the action, and a person who is an innocent infringer cannot be guilty of fraud. If, however, he continues to sell the article complained of after notice he is no longer an innocent vendor, but is to be considered as guilty of participating in the deception of the public, and may be restrained and subjected to an accounting and to costs.[21]

[19] Estes v. Worthington (1887) 30 Fed. 465, citing Maltby v. Bobo (1876) 14 Blatchf. 53, Fed. Cas. No. 8,998; Steiger v. Heidelberger (1880) 4 Fed. 455; Bell v. Josselyn (1855) 3 Gray (Mass.) 309; Richardson v. Kimball (1849) 28 Me. 463; Mitchell v. Harmony (1851) 13 How. (U. S.) 115; Phelps v. Wait (1864) 30 N. Y. 78; Lightner v. Brooks (1864) 2 Cliff. 287, Fed. Cas. No. 8,344; Wright v. Wilcox (1838) 19 Wend. (N. Y.) 343; Livingston v. Bishop (1806) 1 Johns. (N. Y.) 289.

[20] Moet v. Couston (1864) 10 Law T. (N. S.) 395.

[21] Carson v. Ury (1889) 39 Fed. 777; De Kuyper v. Witteman (1885) 23 Fed. 871; People v. Molins (1888) 7 N. Y. Cr. R. 51, 10 N. Y. Supp. 130; Colman v. Crump (1877) 70 N. Y. 573; Farina v. Silverlock (1855) 1 Kay & J. 509, 3 Eq. Rep. 883, 24 Law J. Ch. 632, Cox, Man. Trademark Cas. 130.

CHAPTER XII.

PLEADING AND PRACTICE.

§ 290. Introductory.
291. Bill in Equity.
292. Answer in Equity.
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295. Declaration or Complaint at Law.
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306. Practice—Propriety of Approval by Court of New Label.
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§ 290. Introductory.

In cases involving trade-marks, trade-names, and unfair competition in business, the pleadings and practice are practically the same as in other cases of tort. The equitable action is usually resorted to. In the federal courts this action is still distinct in form, and the pleadings are governed by special rules. In nearly all of the states but a single form of action is now allowed, although the difference between actions that are equitable in their nature and those that are purely legal is recognized.[1] As an injunction is

[1] In Bonesteel v. Bonesteel (1871) 28 Wis. 245, 250, Lyon, J.: "There are certain essential and inherent distinctions between ac-

the most efficacious remedy for infringement of trade-mark rights, and as this can only be obtained in an equitable action, this character of action is generally employed where it is desired to prohibit the continuance of the infringement.

§ 291. Bill in Equity.

In the federal courts, the form of the bill in equity is prescribed by the equity rules.[2] The essential parts of the

tions at law and in equity, to abolish which is beyond the power of legislative enactment. The legislature may abolish the old forms of actions, and has done so, but the essential principles of equitable actions and equitable relief, as distinguished from legal actions and remedies, are as vital now, and as clearly marked and defined, as before the enactment of the Code. They are indestructible elements in our system of jurisprudence, and the courts are constantly required to recognize and apply them."

In Stevens v. City of New York (1881) 84 N. Y. 296, 304, Danforth, J.: "The names of actions no longer exist, but we retain in fact the action at law and the suit in equity. The pleader need not declare that his complaint is in either. It is only necessary that it should contain facts constituting a cause of action, and, if these facts are such as, at the common-law, his client would have been entitled to judgment, he will, under the Code, obtain it. If, on the other hand, they establish a title to some equitable interposition or aid from the court, it will be given by judgment in the same manner as it would formerly have been granted by decree."

In White v. Lyons (1871) 42 Cal. 279, 282, Crockett, J.: "Under the Code there is but one form of action in this state, and, if the complaint states facts which entitle the plaintiff to relief, either legal or equitable, it is not demurrable on the ground that it does not state facts sufficient to constitute a cause of action. If the facts stated are such as address themselves to the equity side of the court, the appropriate relief will be granted by the court, sitting as a court of equity. On the other hand, if the facts alleged are purely cognizable in a court of law, the proper relief will be administered in that form of proceeding. But a complaint which states a sufficient cause of action, either at law or in equity, is not demurrable as not stating facts sufficient to constitute a cause of action." See, also, Guernsey v. American Ins. Co. (1871) 17 Minn. 104 (Gil. 83); Erle Ry. Co. v. Ramsey (1871) 45 N. Y. 637.

[2] Equity Rules xx-xxv.

bill are: (1) The address; (2) the introduction; (3) the stating part; (4) the prayer for relief; (5) the prayer for process. Formerly it was customary to include the confederating part, the charging part, the jurisdictional clause, and the interrogatory part. The confederating part and the charging part are now seldom used. Their use is made optional in the federal courts.[3] The jurisdictional clause is unnecessary, for, if the case made is not of equitable jurisdiction, the bill will be dismissed, notwithstanding it contains an averment that the acts complained of are contrary to equity, and tend to the injury of the complainant, and that he has no adequate remedy at law.[4] The stating part of the bill is the most important. It must set forth all of the facts essential to the complainant's case. It should set forth nothing more. It must be carefully framed, so as to state fully and accurately every material fact.[5]

There are a few special requirements in cases involving trade-marks, trade-names, and unfair competition. The value of the trade-mark or right invaded must be stated to be not less than $2,000, if the action is brought upon a common-law trade-mark in a United States circuit court.[6] The amount in controversy is the value of the trade-mark, trade-name, or the right infringed, and not the amount of damage suffered by the complainant.[7] Where suit is brought to restrain the infringement of a registered trade-mark, if both parties reside in the same state, the bill must allege that the complainant uses the trade-mark in commerce with foreign nations or Indian tribes,[8] and that the defend-

[3] Equity Rule xvi.

[4] Equity Rule xxi; Story, Eq. Pl. (10th Ed.) § 34.

[5] Story, Eq. Pl. (10th Ed.) §§ 27, 28.

[6] 24 U. S. Stat. 552 (March 3, 1887).

[7] Symonds v. Greene (1886) 28 Fed. 834.

[8] Ryder v. Holt (1888) 128 U. S. 525.

ant has applied the trade-mark to goods intended for commerce with foreign nations or Indian tribes.[9] The complainant's trade-mark, wrapper, or label must be accurately described, and, whenever possible, a *fac simile* should be attached to the bill as an exhibit. In cases of unfair competition, the facts relied upon as constituting unfair competition should be fully set forth, and it should be averred that the acts complained of have been done fraudulently, and with intent to palm off upon the public the defendant's goods as and for those of the complainant.[10] It is not sufficient to allege in a bill for an injunction that irreparable injury or damage will result to the complainant by the acts or threats of the defendant, but such facts must be set forth as will enable the court to determine for itself from the facts whether that result will follow or is likely to follow.[11] A bill in equity to restrain the doing of certain acts, which does not allege that the defendant was continuing to do such acts when the bill was filed, shows no ground for an injunction.[12] And a bill for infringement of a trade-mark cannot be sustained as a bill to restrain unfair competition, when it does not allege that defendants have attempted or intend to practice any deceit for the purpose of selling defendant's goods as the goods of complainant.[13]

§ 292. Answer in Equity.

It is an elementary rule of equity pleading that he who submits to answer must answer fully. He must admit or deny all the facts stated in the bill, with all their material

[9] Graveley v. Graveley (1890) 42 Fed. 265.

[10] Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537.

[11] Chicago City Ry. Co. v. General Electric Co. (1898) 74 Ill. App. 465.

[12] Holbrook v. Nesbitt (1895) 163 Mass. 120.

[13] Lamont v. Leedy (1898) 88 Fed. 72.

circumstances, without any special interrogatory for that purpose.[14]

In the following chapter, the defenses that may be made to an action involving a trade-mark, trade-name, or unfair competition in business are discussed. Any of these defenses may be made in an answer to a bill in equity. If suit is brought on a trade-mark registered under the United States statute, defendant may plead that complainant is not using the mark in commerce with foreign nations or Indian tribes, or that defendant is not applying the mark to goods intended for use in such commerce.[15] These allegations are especially important when complainant and defendant are both citizens of the same state. For the purpose of avoiding costs, defendant may allege that, when notified of the infringement, he immediately ceased using the infringing mark. This defense will not usually avoid an injunction, but, if established by the proofs, it may compel the complainant to pay the costs of the suit, which may be an important consideration.[16] The defense of laches may also be insufficient to prevent an injunction, although it may avoid the necessity of an accounting, or the payment of costs by the defendant.[17] As, in an action to restrain unfair competition, it is not necessary for the complainant to show an exclusive right to the marks, labels, or dress of the packages alleged to have been imitated by the defendant, the essential allegations of the answer are denials of any acts constituting a palming off, or an attempted palming off, of defendant's goods as those of the complainant. Facts tending to show that defendant is selling his goods on his own reputation should be fully stated, due

[14] Story, Eq. Pl. (10th Ed.) § 852.

[15] Rev. St. U. S. § 4937.

[16] Bass, Ratcliff & Gretton v. Guggenheimer (1895) 69 Fed. 271.

[17] McLean v. Fleming (1877) 96 U. S. 245; Menendez v. Holt (1888) 128 U. S. 514.

regard being had to the rule that evidence need not be pleaded.

§ 293. Plea in Equity.

It being provided by the equity rules that "the defendant shall be entitled in all cases, by answer, to insist upon all matters of defense (not being matters of abatement, or to the character of the parties, or matters of form) in bar of or to the merits of the bill, of which he may be entitled to avail himself by a plea in bar,"[18] the plea in equity has generally fallen into disuse. It may still be used to set up "a defense which reduces the cause, or some part of it, to a single point."[19] Under the equity rules, no plea is allowed to be filed to any bill unless upon certificate of counsel that, in his opinion, it is well founded in point of law, supported by the affidavit of the defendant that it is not interposed for delay, and that it is true in point of fact.[20]

[18] Equity Rule xxxix.

[19] Beach, Eq. Pr. § 293.

[20] Equity Rule xxxi.

Hostetter Co. v. E. G. Lyons Co. (1900) 99 Fed. 734, Morrow, J.: "The office of a plea, in equity practice, is to present a single issue of fact as a defense, which operates as a bar to the complainant's right of recovery. A demurrer, on the other hand, raises a question of law, and is directed to the sufficiency of the complaint. It is manifest that these two defenses cannot be combined in one pleading, and this is the fatal objection to the present plea. It presents two separate and distinct defenses; the first being that the bill of complaint is inadequate and insufficient to entitle the complainant to relief, in that it does not appear from the bill that the complainant has the exclusive right to the trade-name of 'Hostetter's Bitters.' If this objection is well founded, it discloses a defect in complainant's case as stated in the bill, but this objection is one that cannot be raised by a plea. A defect upon the face of a bill is to be met, not by a plea, but by a demurrer. In Farley v. Kittson (1887) 120 U. S. 303, 314, 7 Sup. Ct. 534, 30 L. Ed. 684, the court said: 'But the proper office of a plea is not, like an answer, to meet

§ 294. Demurrer in Equity.

As a demurrer to a bill in equity admits all facts which are well pleaded in the bill to be true, it follows that such pleading can be used with safety by a defendant only in case the complainant alleges that the defendant has used or colorably imitated the complainant's trade-mark, without alleging fraud or any intention to deceive in the use of the mark.[21] If the bill alleges fraud or an intention to deceive in the use of the mark, a demurrer admitting such allegations will admit the essence of the complaint, and, where fraud and an intention to deceive are admitted, but slight imitation of the complainant's mark will be required to sustain the action.[22]

§ 295. Declaration or Complaint at Law.

If an action at law is brought in a federal court against

all the allegations of a bill, nor, like a demurrer admitting those allegations, to deny the equity of the bill; but it is to present some distinct fact which of itself creates a bar to the suit, or to the part to which the plea applies, and thus to avoid the necessity of making the discovery asked for, and the expense of going into the evidence at large. Mitford, Eq. Pl. (4th Ed.) 14, 219, 295; Story, Eq. Pl. pars. 649, 652.' It is very certain that a question of law as to the sufficiency of the bill cannot be raised by a plea, and that the first defense set up by respondent cannot be maintained as a plea in bar."

[21] Collins Chemical & Mfg. Co. v. Capitol City Mfg. Co. (1890) 42 Fed. 64; Desmond's Appeal (1883) 103 Pa. 126.

[22] Enoch Morgan's Sons Co. v. Hunkele (1879) 16 O. G. 1092, Fed. Cas. No. 4,493; Leidersdorf v. Flint (1880) 50 Wis. 401; Mrs. G. B. Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; Plant Seed Co. v. Michel Plant & Seed Co. (1886) 23 Mo. App. 579; El Modello Cigar Mfg. Co. v. Gato (1889) 25 Fla. 886; Merriam v. Holloway Pub. Co. (1890) 43 Fed. 450; Thedford Medicine Co. v. Curry (1895) 96 Ga. 89; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651; Block v. Standard Distilling & Distributing Co. (1899) 95 Fed. 978; La Croix v. May (1883) 15 Fed. 236; Ellis v. Zeilin (1871) 42 Ga. 91; Barrows v. Knight (1860) 6 R. I. 434; Putnam Nail Co. v. Bennett (1890) 43 Fed. 800.

an alleged infringer of a registered trade-mark, and the registration is relied upon to give the court jurisdiction, the form of action must be that prescribed by the act of congress of March 3, 1881,—trespass on the case.[23] If, however, the parties are citizens of different states, and the mark is claimed as a common-law trade-mark, and a suit at law is brought upon it as such, the practice and pleadings should conform, as near as may be, to the practice and pleadings existing at the time in like causes in the courts of record of the state within which the court is held.[24]

In a declaration upon a registered trade-mark, or a complaint upon a common-law trade-mark, as in a bill in equity, all the facts relied upon to give the court jurisdiction must be pleaded.[25] If the action is upon a registered trade-mark, it must be alleged in the declaration (if the parties are citizens of the same state) that both complainant and defendant use the mark upon goods, wares, or merchandise intended for commerce with foreign nations or the Indian tribes.[26] If the action is based upon a common-law trade-mark, and diversity of citizenship is relied upon to give the court jurisdiction, the complaint must allege the value of the trade-mark to be not less than $2,000.[27] Damages only can be recovered in an action at law, and hence a basis for such recovery must be laid in the declaration or complaint, by alleging an injury to plaintiff resulting from the infringement.[28]

[23] Act March 3, 1881 (21 Stat. 502, § 7).

[24] Rev. St. U. S. § 914.

[25] Symonds v. Greene (1886) 28 Fed. 834; Glotin v. Oswald (1894) 65 Fed. 151; Hennessy v. Herrmann (1898) 89 Fed. 669.

[26] Layties v. Hollender (1884) 22 Blatchf. 413, 21 Fed. 281; Schumacher v. Schwencke (1886) 26 Fed. 818; Ryder v. Holt (1888) 128 U. S. 525; Graveley v. Graveley (1890) 42 Fed. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co. (1892) 53 Fed. 493.

[27] Symonds v. Greene (1886) 28 Fed. 834.

[28] Singer Mfg. Co. v. Loog (1882) 8 App. Cas. 15.

It must also be alleged that the infringement was committed with a fraudulent intention.[29]

§ 296. Answer at Law.

The answer in an action at law in a federal court must state all the material facts necessary to constitute the defense to the action. The common-law form of answer in an action of trespass on the case should be employed when the action is based upon a registered trade-mark, and this form of action is resorted to by the plaintiff.[30] The form of answer employed in the pleadings in courts of record of the state in which the court is held should be used when the action is based upon a common-law trade-mark, and the complaint conforms to complaints used in like causes in the state courts.[31]

§ 297. Demurrer at Law.

As it is necessary, in an action at law, to aver that the infringement was committed willfully and with fraudulent intent on the part of the defendant, a demurrer in such an action, where the declaration or complaint is properly drawn, cannot safely be resorted to, as it admits the fraudulent intent upon the part of the defendant, and, with such an admission, a slight resemblance between the marks will be sufficient to entitle the plaintiff to judgment.[32]

[29] Blanchard v. Hill (1742) 2 Atk. 484, Cox, Man. Trademark Cas. 2; Singleton v. Bolton (1783) 3 Doug. 293, Cox, Man. Trademark Cas. 4; Crawshay v. Thompson (1842) 4 Man. & G. 357, 11 Law J. C. P. 301, Cox, Man. Trademark Cas. 72; Rodgers v. Nowill (1847) 17 Law J. C. P. 52, Cox, Man. Trademark Cas. 82; Edelsten v. Edelsten (1863) 7 Law T. (N. S.) 768, 1 De Gex, J. & S. 185, Cox, Man. Trademark Cas. 213.

[30] Act March 3, 1881 (21 Stat. 502, § 7).

[31] Rev. St. U. S. § 914.

[32] Thedford Medicine Co. v. Curry (1895) 96 Ga. 89; Mrs. G. B.

§ 298. Pleadings in the State Courts.

Many suits involving common-law trade-marks, trade names, or acts constituting unfair competition in business are prosecuted in the state courts. In such actions the pleadings are governed by the state statutes. A discussion of the pleadings in such actions is not within the scope of this work. An examination of the foregoing sections relating to pleadings in the federal courts will, however, assist the practitioner in framing the pleadings in actions in the state courts, the material allegations in pleadings in both courts being the same, except in actions involving registered trade-marks.

§ 299. Joinder of Causes of Actions.

A cause of action for infringement of a patent, and a cause of action for infringement of a trade-mark, may be joined in a single action, where the trade-mark and the patent were both infringed together.[33] Causes of action arising from infringement of a trade-mark and a trade-name may be joined,[34] or either or both of these may be joined with a cause of action arising from acts constituting unfair competition in business,[35] where the infringements arise from the same acts on the part of the defendant. Where a bill in equity is filed to enjoin the infringement of a technical trade-mark or trade-name, and also to enjoin unfair competition, if the complainant fails to establish his right to the trade-mark or trade-name, the bill may be maintained

Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18.

[33] Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co. (1894) 60 Fed. 622.

[34] Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94.

[35] Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

for the purpose of prohibiting the unfair competition.[36] It is therefore advisable to include, wherever possible, in the complaint in any trade-mark or trade-name action, allegations of unfair competition.

§ 300. Multifariousness.

To sustain the objection of multifariousness, the matters sought to be joined must be of such distinct natures, or the forms of proceeding in relation to such several matters must be so distinct, that it would be improper, or very inconvenient, to litigate the same in one suit.[37] A bill of complaint setting up a claim for damages under the anti-trust law of July 2, 1890, and also asking for an injunction restraining the defendant from using the complainant's trade-mark and trade-name, is multifarious, as joining two distinct causes of action, having no connection with each other, and the action for damages is triable at law, while the action for an injunction is of equitable cognizance.[38]

§ 301. Preliminary Injunctions—Granted.

It has been said that "the purpose of a preliminary injunction is to prevent irremediable injury to some of the parties to the suit during its pendency, and before their claims can be investigated and adjudicated. The burden is on the moving party to show that such an injury is threatened, and will probably be inflicted, before the case can be finally decided, unless the injunction issues. The granting or withholding such a temporary injunction rests largely in the sound judicial discretion of the court, and much latitude is,

[36] City of Carlsbad v. Tibbetts (1892) 51 Fed. 852.

[37] Newland v. Rogers (1848) 3 Barb. Ch. (N. Y.) 432; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

[38] Block v. Standard Distilling & Distributing Co. (1899) 95 Fed. 978.

and ought to be, allowed for the exercise of that discretion, in view of the fact that the personal acquaintance with and observation of the parties at the hearing which the trial court enjoys are of great assistance in reaching a just conclusion.[39] There are many considerations that may be conclusive without reference to the merits of the question at issue.[40] In an action upon a trade-mark or trade-name, the plaintiff must show, in order to entitle him to a preliminary injunction, that he is the owner of the trade-mark or trade-name, and is entitled to its exclusive use.[41] The right to the injunction must be clearly established by the evidence,[42] In a trade-mark or trade-name case the intention of the defendant is not material.[43] Even though the infringement be honest and innocent, equity will, in a clear case, restrain its continuance, unless there are special circumstances which take the case out of the general rule.[44] Nor is it necessary to show that actual damage or loss has accrued to the plaintiff.[45] Where the court sees that the plaintiff's trade-marks are simulated in such manner as to deceive his customers or

[39] Centaur Co. v. Marshall (1899) 38 C. C. A. 413, 97 Fed. 785. See, also, Gebbie v. Stitt (1894) 82 Hun (N. Y.) 93; Whitley Grocery Co. v. McCaw Mfg. Co. (1898) 105 Ga. 839.

[40] Garrett v. T. H. Garrett & Co. (1896) 24 C. C. A. 173, 78 Fed. 472.

[41] Rorke v. Societe des Huiles d'Olive de Nice (1897) 14 App. Div. (N. Y.) 173.

[42] Ball v. Siegel (1886) 116 Ill. 137; Coffeen v. Brunton (1851) 5 McLean, 256, Fed. Cas. No. 2,947; Ellis v. Zeilin (1871) 42 Ga. 91; McLoughlin v. Singer (1898) 33 App. Div. (N. Y.) 185; Hagen v. Beth (1897) 118 Cal. 330; Postal Tel. Cable Co. v. Netter (1900) 102 Fed. 691.

[43] Clinton Metalic Paint Co. v. New York Metalic Paint Co. (1898) 23 Misc. Rep. (N. Y.) 66.

[44] G. G. White Co. v. Miller (1892) 50 Fed. 277.

[45] Reeves v. Denlcke (1871) 12 Abb. Pr. (N. S.; N. Y.) 92.

the patrons of his trade or business, the piracy will be checked at once by injunction.[46]

Any evasion on the part of a defendant in responding to the charges of the bill, or any extreme improbability in the statement of the defendant, will be an inducement to the court to grant or retain an injunction.[47] Upon a motion for an injunction the court will hear affidavits of both parties, and consider the answer of the defendant an affidavit.[48] A preliminary injunction, when granted, is always until answer or until further order of the court.[49] It has been held that an injunctive order forbidding the use of certain words on a medicine bottle label equally forbids use of those words in a certificate attached to the bottle.[50]

Circumstances that strongly appeal to a court of equity in passing upon a motion for a preliminary injunction are found in those cases where the plaintiff has an established trade under the mark or name in question, and the defendant has recently begun the use of the mark or name, and can have acquired no established trade thereunder. As said by Cotton, L. J., in a leading English case:[51] "As to the question of convenience or inconvenience in granting the injunction, I

[46] Partridge v. Menck (1847) 2 Sandf. Ch. (N. Y.) 622. See, also, Price Baking Powder Co. v. Fyfe (1891) 45 Fed. 799; Symonds v. Greene (1886) 28 Fed. 834; Hill v. Lockwood (1885) 62 Wis. 507; Robertson v. Berry (1879) 50 Md. 591; Enoch Morgan's Sons' Co. v. Hunkele (1879) 16 Off. Gaz. 1092, Fed. Cas. No. 4,493, Price & S. Amer. Trade Mark Cas. No. 31; Frese v. Bachof (1876) 13 Blatchf. 234, Fed. Cas. No. 5,109; Lee v. Haley (1869) 5 Ch. App. 155.

[47] American Grocer Pub. Ass'n v. Grocer Pub. Co. (1876) 51 How. Pr. (N. Y.) 402.

[48] Gillis v. Hall (1870) 7 Phila. (Pa.) 422.

[49] White v. Schlect (1880) 14 Phila. (Pa.) 88; Walton v. Crowley (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133.

[50] Alexander v. Morse (1883) 14 R. I. 153.

[51] Read v. Richardson (1881) 45 Law T. (N. S.) 54.

have no hesitation in coming to the conclusion that, if there is a *prima facie* case made out by the plaintiffs, although it is not as fully made out as it possibly might have been, we ought to grant the injunction. The plaintiffs, in obtaining an injunction upon an interlocutory application, must give an undertaking as to damages. If there is no injunction granted, and they are in the right, the trade-name, which they say is valuable to them, and which they come to protect, will be absolutely gone before they can ascertain their rights. * * * Therefore, if the plaintiffs have made out a *prima facie* case, the strong balance of convenience and inconvenience is in favor of granting the injunction." And the same principle is recognized in a case decided in the United States circuit court for the Eastern district of Pennsylvania, in which Judge Butler said:[52] "He [defendant] knew it to be the recognized designation of the plaintiff's tobacco, which had become popular with consumers and the trade. Did he not expect the public to be influenced thereby, and his business increased? An affirmative answer cannot well be avoided. If he did not, however, the injunction will do him no harm, for he has not yet had time to establish a reputation of his own under this name."

While, in considering a motion for a preliminary injunction in a trade-mark or trade-name case, the intention of the defendant in using the infringing mark or name is not material, the intention of the defendant is material in considering a motion for such an injunction in a case of unfair competition. As "relief in such cases is granted only where the defendant, by his marks, signs, labels, or in other ways, represents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacture, to the in-

[52] Carroll v. Ertheiler (1880) 1 Fed. 688.

jury of the plaintiff,"[53] and as "the deceitful representation or perfidious dealing must be made out or be clearly inferable from the circumstances,"[54] it follows that the intention of the defendant in cases of unfair competition is of the very essence of the action, and of the right to a preliminary injunction. In such cases a fraudulent intention must be made out, or such facts must be shown as will compel the court to infer such intention. And it is sufficient to justify the interference by injunction by a court of equity to show that there is a fraudulent intention on the part of the defendant to palm off his goods as those of the plaintiff, and that such intention is being carried into execution.[55]

The purpose to be effected by an injunction is not primarily to protect the purchaser, but to secure to the manufacturer the profit to be derived from the sale of his goods to all who may desire and intend to purchase them.[56] Where it appears that the party infringing a trade-mark intends to continue the wrong, an injunction against such continuance is the sole adequate remedy.[57]

§ 302. Preliminary Injunction—Refused.

In cases involving trade-marks, trade-names, and unfair competition, it is by no means of course to grant preliminary injunctions.[58] Where it is doubtful whether the complaint

[53] Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 123 U. S. 598.

[54] Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537.

[55] Enoch Morgan's Sons' Co. v. Troxell (1881) 23 Hun (N. Y.) 632.

[56] Williams v. Brooks (1882) 50 Conn. 278.

[57] Bradley v. Norton (1865) 33 Conn. 157.

[58] Fairbanks v. Jacobus (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608.

shows a cause of action,[59] or whether what has been done by the defendant amounts to an unlawful representation, an injunction will be refused.[60] The practice is not to grant injunctions in actions of this kind except in very clear cases.[61] The purpose of an injunction is to protect the plaintiff in the exercise of a clear legal right, for the infringement of which the law does not afford an adequate remedy. If, therefore, the right of the plaintiff is doubtful, equity will withhold its aid.[62] Courts of equity have always recognized

[59] Selchow v. Baker (1883) 93 N. Y. 59; McHenry v. Jewett (1882) 90 N. Y. 58; Stirling Silk Mfg. Co. v. Sterling Silk Co. (1900) 59 N. J. Eq. 394.

[60] Green v. Rooke (1872) 7 Law J. Notes Cas. 54; Brown v. Doscher (1892) 66 Hun, 626, 20 N. Y. Supp. 900.

[61] McLoughlin v. Singer (1898) 33 App. Div. (N. Y.) 185; Fetridge v. Wells (1857) 4 Abb. Pr. (N. Y.) 144; Fetridge v. Merchant (1857) 4 Abb. Pr. (N. Y.) 156; Merrimack Mfg. Co. v. Garner (1855) 2 Abb. Pr. (N. Y.) 318, 4 E. D. Smith, 387; Samuel v. Berger (1856) 4 Abb. Pr. (N. Y.) 88, 24 Barb. 163, 13 How. Pr. 342; Partridge v. Menck (1847) 2 Barb. Ch. (N. Y.) 101, affirmed 3 Denio, 610; Seltzer v. Powell (1871) 8 Phila. (Pa.) 296; Hygeia Distilled Water Co. v. Hygeia Ice Co. (1898) 70 Conn. 516; W. J. Johnston Co. v. Electric Age Pub. Co. (1891) 60 Hun, 578, 14 N. Y. Supp. 803; Lies v. Daniel (1887) 82 Ga. 272; Foster v. Blood Balm Co. (1887) 77 Ga. 216; Hagen v. Beth (1897) 118 Cal. 330.

[62] McVey v. Brendel (1891) 144 Pa. 235; New York Asbestos Mfg. Co. v. New York Fire Proof Covering Co. (1899) 62 N. Y. Supp. 339; Vitascope Co. v. United States Phonograph Co. (1897) 83 Fed. 30; Van Camp Packing Co. v. Cruikshanks Bros. Co. (1898) 33 C. C. A. 280, 90 Fed. 814; Spottiswoode v. Clark (1846) 2 Sandf. Ch. (N. Y.) 628; Wolfe v. Goulard (1859) 18 How. Pr. (N. Y.) 64; Witthaus v. Braun (1875) 44 Md. 303; American Grocer Pub. Ass'n v. Grocer Pub. Co. (1876) 51 How. Pr. (N. Y.) 402; Decker v. Decker (1876) 52 How. Pr. (N. Y.) 218; Marshall v. Pinkham (1881) 52 Wis. 572; Leclancha Battery Co. v. Western Electric Co. (1884) 21 Fed. 538; Portuondo v. Monne (1886) 28 Fed. 16; French v. Alter (1896) 74 Fed. 788; Davis v. Davis (1886) 27 Fed. 490; Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94; Charles

the fact that the granting of a preliminary injunction is an exercise of a very far-reaching power, never to be exercised except in a case clearly demanding it.[63] As said by the United States circuit court of appeals for the Third circuit: "It is a wholesome doctrine that equity will restrain unfair competition in trade, but it should be applied with caution, lest, through possible misapplication, healthful and honorable competition be defeated."[64] And by the United States circuit court of appeals for the Seventh circuit: "An interlocutory injunction operates somewhat in the nature of judgment and execution before trial. Without question, it is at times an appropriate remedy in the prevention of great wrong, but to authorize its issuance there must exist a pressing necessity. The right to it must be clear, and the apprehended injury must be grievous, and, generally, where the injury may be measured in money, the alleged wrongdoer should be shown to be unable pecuniarily to respond."[65] Where defendants had abandoned the use of certain wrap-

E. Hires Co. v. Consumers' Co. (1900) 41 C. C. A. 71, 100 Fed. 809; Goldstein v. Whelan (1894) 62 Fed. 124.

In Keasbey v. Brooklyn Chemical Works (1891) 61 Hun, 627, 16 N. Y. Supp. 318, where the affidavits filed by plaintiff and defendant left in doubt the following questions, viz.: (1) Were the plaintiffs the originators of the manufactured article (a compound) to which the trade-mark was applied? (2) Was the trade-mark (two words) descriptive of the ingredients in the compound? (3) Was the dissimilarity between the bottles and labels of plaintiff and of defendant sufficient to prevent the public from buying the latter for the former,—it was held that a preliminary injunction was properly denied.

[63] New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co. (1900) 43 C. C. A. 46, 102 Fed. 890, affirming 99 Fed. 85.

[64] Lare v. Harper (1898) 30 C. C. A. 373, 86 Fed. 481.

[65] American Cereal Co. v. Eli Pettijohn Cereal Co. (1896) 22 C. C. A. 236, 76 Fed. 372. affirming 72 Fed. 903. See Foster v. Blood Balm Co. (1887) 77 Ga. 216.

pers before the hearing of a motion for a preliminary injunction, and, at the hearing, agreed in writing to cease using a certain advertisement, an injunction was refused,[66] and, upon appeal, this order was affirmed.[67] In an English case, where there was a conflict of testimony as to whether the defendants' goods were calculated to be mistaken for the plaintiff's, and the court was unable, from an inspection of the goods, to arrive at a satisfactory conclusion, it was held that the motion for a preliminary injunction should stand over to the hearing, the defendants being put on an undertaking to keep an account.[68]

Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, apparently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a lawsuit, and delayed legal proceeding until his patience was exhausted.[69] When delay of the owner of a trade-mark to prosecute infringers has been of a tendency to mislead the public, or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing.[70]

Where a temporary injunction was issued in favor of plaintiff, and afterwards dissolved as erroneously granted, it was held that the defendant, whose answer did not entitle him to

[66] Centaur Co. v. Marshall (1899) 92 Fed. 605.

[67] Centaur Co. v. Marshall (1899) 97 Fed. 785.

[68] Mitchell v. Henry (1880) 15 Ch. Div. 181. See Goodyear Rubber Co. v. Day (1884) 22 Fed. 44.

[69] Bovill v. Crate (1865) L. R. 1 Eq. 388; C. O. Burns Co. v. W. F. Burns Co. (1902) 118 Fed. 944.

[70] Estes v. Worthington (1885) 22 Fed. 822; White v. Schlect (1880) 14 Phila. (Pa.) 88.

affirmative relief, was entitled, as a matter of course, to the appointment of a referee to ascertain and report what damages he had sustained by reason of the issuing of the injunction.[71]

A complainant who had refused to acknowledge the rights of the original foreign proprietor of a trade-mark until he thought it would be more profitable to purchase his rights in this country, and thus obtain a monopoly, reserving the right to annul the contract at discretion, was refused a preliminary injunction against alleged infringers of the trade-mark, and was left to establish his rights at final hearing.[72]

§ 303. Permanent Injunctions.

In cases involving trade-marks, injunctions will be granted when plaintiff establishes at the trial his exclusive right to the trade-mark in question, and it is shown that the defendant is using upon the same class of goods the same mark, or one so closely imitating it as to deceive, or to be calculated to deceive, purchasers, and cause them to mistake one article for the other.[73]

A permanent injunction was granted in one case where it appeared that at the time suit was brought the defendant

[71] Glen & Hall Mfg. Co. v. Hall (1871) 6 Lans. (N. Y.) 158.

[72] Estes v. Worthington (1885) 22 Fed. 822.

[73] Millington v. Fox (1838) 3 Mylne & C. 338; Johnston v. Ewing (1882) 7 App. Cas. 219; Read v. Richardson (1881) 45 Law T. (N. S.) 54; Siegert v. Findlater (1878) 7 Ch. Div. 801; Apollinaris Co. v. Norrish (1875) 33 Law T. (N. S.) 242; Ford v. Foster (1872) 7 Ch. App. 611; Seixo v. Provezende (1866) 1 Ch. App. 192; McLean v. Fleming (1877) 96 U. S. 245; Menendez v. Holt (1888) 128 U. S. 514; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291; Rowley v. Houghton (1868) 7 Phila. (Pa.) 39; Small v. Sanders (1889) 118 Ind. 105; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 608; Cuervo v. Landauer (1894) 63 Fed. 1003; Manitowoc Pea-Packing Co. v. Numsen (1899) 35 C. C. A. 267, 93 Fed. 196.

was infringing the right of the complainant to the exclusive use of the trade-marks, although at the time of the final hearing such practices had ceased, and although the defendant had promised a perpetual cessation of the infringement.[74] That the infringer of a trade-mark, on being notified of his infringement, told his customers to erase the trade-marks from their goods, and had since gone out of business, are not grounds for denying an injunction to the owner of the trade-mark, where every step of the suit for an injunction and an accounting has been contested by the infringer, and he has put the complainants to the expense of proving every fact necessary to establish their right and his infringement.[75] In cases involving trade-names, permanent injunctions will be granted where plaintiff establishes his exclusive right to the trade-name, and it is shown that defendant is using the same name, or one closely resembling it, so as to cause confusion between the business or business establishment of plaintiff and the business or business establishment of defendant.[76] Where plaintiff has no technical trade-mark or trade-name, a permanent injunction will be granted where the dress of goods, the wrappers, labels, packages, bottles, seals, signatures, and other *indicia*, or the names, signs, titles, or business methods used by the plaintiff, are so imitated as to enable a dishonest defendant to sell his goods as and for those of the plaintiff, or so as to induce the public to do business

[74] Clark Thread Co. v. William Clark Co. (1897) 55 N. J. Eq. 658.

[75] Hutchinson v. Blumberg (1892) 51 Fed. 829.

[76] Knott v. Morgan (1836) 2 Keen, 219; Myers v. Kalamazoo Buggy Co. (1884) 54 Mich. 223; Hendriks v. Montagu (1881) 17 Ch. Div. 638; Lee v. Haley (1869) 5 Ch. App. 155; New York Cab Co. v. Mooney (1884) 15 Abb. N. C. (N. Y.) 152; Tuerk Hydraulic Power Co. v. Tuerk (1895) 92 Hun (N. Y.) 65; Weinstock, Lubin & Co. v. Marks (1895) 109 Cal. 529; Cady v. Schultz (1895) 19 R. I. 193. See chapter 8, and cases there cited.

with the defendant in the belief that they are doing business with the plaintiff.[77]

§ 304. Violation of Injunction.

Where an injunctional order served on a defendant is definite and peremptory, the defendant must obey it, or at once procure an alteration or dissolution of it. If he does neither, an attachment for contempt will issue against him.[78] An injunction forbidding the members of a partnership, charged with infringing a trade-mark, from preparing, putting up, selling, or offering for sale the article in question under the trade-mark in question, makes it a contempt for them to do these acts, not only in their own behalf, but as agents or servants of others, who attempt to carry on the infringing business.[79] An injunction forbidding the defendants and their "agents, servants," etc., from doing specified acts, binds the agents only while acting as such for the defendants, and not in their personal capacity after they have ceased to be defendants' agents or servants, or have become agents or servants of some one else.[80] Where an injunction prohibited defendants from affixing or applying certain words "to any plasters manufactured, sold, shipped, or supplied by them, or to the boxes in which the same are put up," it was held that defendants did not violate the injunction by using

[77] Sawyer v. Horn (1880) 4 Hughes, 239, 1 Fed. 24; Farina v. Silverlock (1855) 1 Kay & J. 509; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169; Vitascope Co. v. United States Phonograph Co. (1897) 83 Fed. 30. The following are a few of the instances in which permanent injunctions were refused: Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1900) 99 Fed. 971; Stetson v. Brennen (1897) 21 App. Div. (N. Y.) 552; New Haven Patent Rolling Spring Bed Co. v. Farren (1883) 51 Conn. 324.

[78] McCardel v. Peck (1864) 28 How. Pr. (N. Y.) 120.

[79] Dadirrian v. Gullian (1897) 79 Fed. 784.

[80] Dadirrian v. Gullian (1897) 79 Fed. 784.

the prohibited words in advertisements in newspapers, cards, circulars, catalogues,[81] etc.

For the purpose of sustaining a motion to punish for a contempt in violating an injunction as to trade-marks, it should appear clearly that the ordinary mass of customers, paying that attention which such persons usually do in purchasing, would be easily deceived by the mark used by defendant.[82]

§ 305. Parties—Who Entitled to Injunction.

Any one singly or two or more jointly of two or more persons or corporations having a common interest of the same quality or kind, though differing in degree, on proving fraud or irreparable injury, may maintain an action in equity to obtain the desired relief.[83]

The fraudulent use of marks or labels for the purpose of *deceiving the public will not be enjoined at the instance of* one who does not show that he is himself the manufacturer or owner or dealer in the articles which are fraudulently represented by counterfeited labels to be his; hence the fact that persons are officers or members of an association which has adopted the label to show that the articles bearing it are manufactured by its members does not of itself entitle them to maintain a bill to enjoin the fraudulent use of such label. In a case in Massachusetts, the court, after stating the general rule and citing well-known cases, said: "We have no occasion to question this principle, or the authorities by which it has been sustained. It will be found that where, under such circumstances, an injunction has been granted or an action maintained, it has been at the instance of one who

[81] Porous Plaster Co. of Village of Sing Sing v. Seabury (1888) 48 Hun, 620, 1 N. Y. Supp. 134.

[82] Swift v. Dey (1865) 4 Rob. (N. Y.) 611.

[83] Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 30 C. C. A. 386, 86 Fed. 608, and cases there cited.

was himself a manufacturer, dealer in, or owner of the articles which were fraudulently represented by the counterfeited labels, wrappers, or advertisements to be his. In such case the fraud complained of would have a natural and inevitable tendency to lessen the sales, affect the reputation of the articles manufactured or dealt in, and injure the business of the complainant, and would thus afford him a ground for relief by reason of the special and peculiar damage which he would sustain, or to which he might be exposed. The plaintiffs show by their bill that they have a right to use the label in question, and that it is a valuable privilege; but although they aver that they have suffered loss by the use of it by the defendant, they do not show that any business which they pursue has been affected, or that they can have sustained any definite loss, or any injury except that which must be extremely remote and purely speculative."[84]

In a recent case it was held that the only basis for a private suit for an injunction against unfair competition is injury to property rights of the complainant. The fact that the defendant deceives the public as to the goods by fraudulent means, while an important factor in such suit, does not give a right to an action unless it results in the sale of such goods as those of the complainant.[85]

[84] Weener v. Brayton (1890) 152 Mass. 101, 8 L. R. A. 640.

[85] American Washboard Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281. In this case the court said: "There are numerous cases in the reports upon the subject of unfair competition in trade. From the general principle running through them all, it may be said that when one has established a trade or business in which he has used a particular device, symbol, or name, so that it has become known in trade as a designation of such person's goods, equity will protect him in the use thereof. Such person has a right to complain when another adopts this symbol or manner of marking his goods so as to mislead the public into purchasing the same as and for the goods of complainant. Plain-

§ 306. Practice — Propriety of Approval by Court of New Label.

After a case has been tried, and it has been found that the defendant has been guilty of unfair competition by deliberately and designedly imitating packages and labels of the business of a competitor, it is improper for a court to give its approval in advance to a changed form proposed to be adopted by the defendant to avoid future liability. It should restrain the use of the infringing device, leaving to the defendant the responsibility of deciding for himself, at his own risk, what changes are necessary to avoid infringement. Where the lower court approved a proposed form, the court of appeals said: "The court below, upon holding that the changed label of the defendant infringed the complainant's right, caused to be submitted for its approval another form of label which it approved, and authorized the defendant to use upon bottles of the same form as those used by the complainant. We greatly doubt the propriety of such action. When an infringement has been found, it should be restrained. A court of equity does not sit as an arbiter to determine in advance upon other and changed labels which the infringer may adopt to avoid the condemnation of the court. Whether such changed forms do in fact infringe is matter of fact to be determined by the court in its usual course of procedure upon complaint lodged by the party damnified. The duty of the court below was to determine whether the labels complained of in the bill infringed the complainant's right. That duty was fully performed when the court had so determined. It is not called upon to decide whether a new label proposed for adoption would infringe.

tiff comes into a court of equity in such cases for the protection of his property rights. The private action is given, not for the benefit of the public, although that may be its incidental effect, but because of the invasion by defendant of that which is the exclusive property of complainant."

This is especially so here, where the infringement was deliberate and designed. In such case the court ought not to say how near the infringer may lawfully approximate the label of the complainant, but should cast the burden upon the guilty party of deciding for himself how near he may with safety drive to the edge of the precipice, and whether it be not better for him to keep as far from it as possible."[86]

[86] Charles E. Hires Co. v. Consumers' Co. (1900) 41 C. C. A. 71, 100 Fed. 809.

In Stirling Remedy Co. v. Spermine Medical Co. (1901) 50 C. C. A. 657, 112 Fed. 1000, Jenkins, J., said: "We have held in Charles E. Hires Co. v. Consumers' Co., 41 C. C. A. 71, 100 Fed. 809, and in Mitchell v. Williams, 45 C. C. A. 265, 106 Fed. 168, that it is not proper, where unfair competition has been found, for a court of equity to give its approval in advance to a changed form proposed to be adopted to avoid future liability, but should, in such cases, restrain the use of the infringing devices, leaving to the defendant the responsibility of deciding for himself, and at his own risk, what changes are necessary to avoid infringement."

In Weber Medical Tea Co. v. Weber (1900) 102 Fed. 156, the rights of the parties to the use of certain trade-names and labels had been adjudicated, and defendants thereafter submitted to counsel for complainants a proposed new form of label, which was by them approved as unobjectionable. It was held that thereafter another court would not grant a preliminary injunction against the use of such label by defendants on the application of the complainant. The court said: "Complainant's assignors, on August 29, 1899, obtained in the supreme court of the state of New York a judgment which, as to the rights determined therein, is an estoppel upon the defendants herein. After such judgment, the present defendants, with a view of complying therewith, submitted to the counsel for the present complainant the label which is the subject of the present controversy, and such counsel stated that he saw no objection to it, and the defendants thereupon adopted the label, and for such adoption they are accused by the complainant in the present action. It was the impression of the court, upon the hearing of the motion for a preliminary injunction, that a label which seemed unobjectionable when submitted to the skilled and advised counsel for the complainant should not be deemed a violation of the complainant's rights within the limits of examination

§ 307. Power of Court on Appeal.

The granting or refusing of a preliminary injunction is largely discretionary, but the provision of the act creating the United States circuit court of appeals, allowing appeals from such orders, is for the purpose of having such discretion reviewed, and errors in its exercise corrected. When the court below has found a defendant guilty of unfair competition practiced deliberately and designedly, and has granted an injunction for the protection of the complainant's rights as it found them, but fell short in its judgment as to the extent of such rights, its error will be corrected on appeal, and its injunction broadened to afford the full measure of relief to which complainant is entitled.[87]

observed upon applications of this nature. The impression is not diminished after an examination of the briefs, and, upon that ground alone, the motion for a preliminary injunction is denied. The position apparently taken by the defendants that their tea is now known as 'Weber's Tea' may enter into the ultimate decision, but for the purposes of a preliminary injunction the consent above discussed must have the greater influence."

In Bass, Ratcliff & Gretton v. Feigenspan (1899) 96 Fed. 206, it was said: "He who applies the false mark has no just cause of complaint if he be prevented from further violating the exclusive right of the lawful employer of the genuine symbol, and he certainly should not be allowed, at the peril of the latter, fraudulently to experiment in the use of such false mark, with accessories of varying character, with the double purpose of filching the custom of a business rival, and at the same time shielding himself from the consequences of infringement."

[87] Charles E. Hires Co. v. Consumers' Co. (1900) 41 C. C. A. 71, 100 Fed. 809. See Selchow v. Baker (1883) 93 N. Y. 59; O'Kane v. West End Dry Goods Store (1897) 72 Ill. App. 297.

CHAPTER XIII.

DEFENSES.

§ 308. In General.
309. No Exclusive Right in Claimant.
310. License.
311. Abandonment.
312. Use on Different Class of Goods.
313. Noninfringement.
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315. Deception Practiced by Claimant.
316. False Statements on Packages.
317. False Statements in Advertisements.
318. False Statements as to Person by Whom Article is Manufactured.
319. False Statements as to Place of Manufacture.
320. False Statements as to Materials Used.
321. False Statements as to Letters Patent.
322. Immaterial Misrepresentations.

§ 308. In General.

There are a number of defenses that may be made to an action for infringement of a technical trade-mark or trade-name, or to an action to restrain unfair competition in business, or to an action that contains both a claim of infringement of a technical trade-mark or trade-name and a claim of unfair competition in business. There are several defenses that are applicable only to cases involving technical trade-marks and trade-names, and a few that are applicable only to cases of unfair competition. The majority of defenses are, however, applicable both to trade-mark and trade-name cases, and to cases of unfair competition. The following defenses may be made to cases involving technical

trade-marks and trade-names: First, that complainant has no exclusive right to the trade-mark or trade-name in suit; second, that defendant has acquired a license to use such trade-mark or trade-name; third, that complainant has abandoned the trade-mark or trade-name; fourth, that the trade-mark is used by defendant on a class of goods different from that on which it is used by complainant; fifth, noninfringement; sixth, that complainant has been guilty of laches to such an extent as to disentitle him to relief; seventh, false and fraudulent representations on the part of complainant. The fifth, sixth, and seventh of the above-named defenses are equally applicable in actions to restrain unfair competition in business.

§ 309. No Exclusive Right in Claimant.

In an action to restrain the use of a technical trade-mark or trade-name, the defense that complainant has no exclusive right to the trade-mark or trade-name in question is, if sustained by the proofs, an absolute bar to the action. Thus it has been held by the United States supreme court that, as the designation "Goodyear Rubber Company" is not subject to exclusive appropriation, any use of terms of similar import, or any abbreviation of them, is free to all persons.[1] If a complainant has no exclusive right to an alleged trade-mark or trade-name, he cannot maintain an action for its infringement by others.

§ 310. License.

If a defendant, in an action to restrain the use of a trade-

[1] Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598; Manufacturing Co. v. Trainer (1879) 101 U. S. 51; Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1901) 108 Fed. 624; J. R. Watkins Medical Co. v. Sands (1901) 83 Minn. 326; Asbestos & Asbestic Co. v. William Sclater Co. (1901) 10 Rap. Jud. Que. B. R. 165.

mark or trade-name, proves a license from a person or persons having authority to give it, a defense to the action is made out. A license of this kind, to be effectual, however, must come from the actual owner of the trade-mark or trade-name, and, if of a revocable character, must be shown to be still in force.[2] It must also appear that the trade-mark or trade-name is of such character that a licensee can use it without fraud upon the public.[3]

§ 311. Abandonment.

That complainant has abandoned the trade-mark or trade-name alleged to have been infringed is necessarily a good defense. The subject of abandonment has been fully discussed in previous chapters of this work.[4]

§ 312. Use on Different Class of Goods.

That defendant uses the trade-mark on a different class of goods from that on which it is used by complainant is a defense to an action for infringement; but it is not a defense that defendant uses the trade-mark on a different species of goods from that on which it is used by complainant, where both species belong to the same general class.[5]

§ 313. Noninfringement.

The defense of noninfringement will usually be determined by the court by a comparison of the two trade-marks in a

[2] Stetson v. Winsor (1872) 9 Phila. (Pa.) 513, Cox, Man. Trademark Cas. 396; McCardel v. Peck (1864) 28 How. Pr. (N. Y.) 120, Cox, Man. Trademark Cas. 233; Deiz v. Lamb (1866) 6 Rob. (N. Y.) 537, Cox, Man. Trademark Cas. 266.

[3] Bloss v. Bloomer (1857) 23 Barb. (N. Y.) 604; Samuel v. Berger (1856) 24 Barb. (N. Y.) 163; Oldham v. James (1862) 13 Ir. Ch. 393, (1863) 14 Ir. Ch. 81.

[4] See chaper 5, §§ 101-105.

[5] See chapter 4, § 96; chapter 9, § 202.

case involving only a technical trade-mark, or by a comparison of the labels or wrappers in a case of unfair competition. The rules that govern in determining the question of infringement have been stated in previous chapters.[6]

§ 314. Laches.

Laches will not usually deprive a complainant, in a case involving a trade-mark, a trade-name, or unfair competition in business, of the remedy by injunction, but will frequently deprive him of an accounting and costs. This subject has been fully discussed in a preceding chapter.[7]

§ 315. Deception Practiced by Claimant.

One of the most effective defenses that can be made to an action in equity, where it is sought to restrain the infringement of a trade-mark or trade-name, or to restrain unfair competition in business, is that the complainant has been guilty of false and fraudulent representations in connection with the particular business in which the marks, names, labels, or packages are used. The basis of this defense is found in the old and settled rule of equity that "he who comes into a court of equity must come with clean hands and a pure conscience." If this defense is made and is substantiated, a court of equity will not inquire whether the complainant has a valid trade-mark or trade-name, or whether the defendant has been guilty of unfair competition, but the action will be dismissed, even though it be apparent that the defendant has been guilty of the most flagrant piracy. The following statement of the rule from the opinion of Chief Justice Duer in Fetridge v. Wells[8] was quoted with approval

[6] See chapters 9 and 10.
[7] See chapter 5, §§ 106-109.
[8] (1857) 4 Abb. Pr. (N. Y.) 144.

by Justice Field in delivering the opinion of the supreme court of the United States in the leading case of Manhattan Medicine Co. v. Wood:[9] "Those who come into a court of equity, seeking equity, must come with clean hands and a pure conscience. If they claim relief against the fraud of others, they must themselves be free from the imputation. If the sales made by the plaintiff and his firm are effected, or sought to be, by misrepresentation and falsehood, they cannot be listened to when they complain, that, by the fraudulent rivalry of others, their own fraudulent profits are diminished. 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." In the same case Justice Field also quoted the following with approval from the English case of Leather Cloth Co. v. American Leather Cloth Co.:[10] "When the

[9] (1883) 108 U. S. 218. See chapter 10, §§ 212-213.

[10] (1863) 4 De Gex, J. & S. 137, (1865) 11 H. L. Cas. 523. See, also, Pidding v. How (1837) 8 Sim. 477; Perry v. Truefitt (1842) 6 Beav. 66; Seabury v. Grosvenor (1877) 14 Blatchf. 262, Fed. Cas. No. 12,576; Hobbs v. Francais (1860) 19 How. Pr. (N. Y.) 567; Connell v. Reed (1880) 128 Mass. 477; Fowle v. Spear (1847) Cox, Man. Trademark Cas. 90, Fed. Cas. No. 4,996; Blackwell v. Armistead (1872) 3 Hughes, 163, Fed. Cas. No. 1,474; Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Swift v. Dey (1865) 4 Rob. (N. Y.) 611; Heath v. Wright (1855) 3 Wall. Jr. 141, Fed. Cas. No. 6,310; Smith v. Woodruff (1867) 48 Barb. (N. Y.) 438; Curtis v. Bryan (1867) 36 How. Pr. (N. Y.) 33; Palmer v. Harris (1869) 60 Pa. 156; Joseph Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; Laird v. Wilder (1872) 9 Bush (Ky.) 131; Wolfe v. Burke (1874) 56 N. Y. 115; McNair v. Cleave (1874) 10 Phila. (Pa.) 155; Hennessy v. Wheeler (1876) 51 How. Pr. (N. Y.) 457; Carmichel v. Latimer (1876) 11 R. I. 395; Helmbold v. Henry T. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1892) 135 N. Y. 24; Prince's Metallic Paint Co. v. Prince Mfg. Co. (1893) 57 Fed. 938; Krauss v. Joseph R. Peebles' Sons Co. (1893) 58 Fed. 585; Kohler Mfg. Co. v. Beeshore (1893) 59 Fed. 572; Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376; New York Consolidated Card Co.

owner of the trade-mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connection with the property he seeks to protect, he loses, and very justly, his right to claim the assistance of a court of equity;" and added: "The doctrine enunciated in all these cases is founded in honesty and good sense; it rebukes fraud, and encourages fair dealing with the public." It has been held, however, that "the maxim that one must come into equity with clean hands is confined to misconduct in regard to, or at all events connected with, the matter in litigation, so that it has in some measure affected the equitable relations subsisting between the two parties, and arising out of the transaction. It does not extend to any misconduct, however gross, which is unconnected with the matter in litigation, and with which the opposite party has no concern."[11]

There is considerable conflict in the decisions of the courts as to the character of representations that will disentitle a plaintiff to relief. It is not every exaggerated statement,

v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611; Metcalfe v. Brand (1887) 86 Ky. 331; Koehler v. Sanders (1890) 122 N. Y. 65; C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84; Millbrae Co. v. Taylor (1894) (Cal.) 37 Pac. 235; Siegert v. Abbott (1893) 72 Hun (N. Y.) 243; Siegert v. Abbott (1883) 61 Md. 276; Buckland v. Rice (1884) 40 Ohio St. 526; Kenny v. Gillet (1889) 70 Md. 574; Van Horn v. Coogan (1894) 52 N. J. Eq. 380; Joseph v. Macowsky (1892) 96 Cal. 518; Alden v. Gross (1887) 25 Mo. App. 123; Parlett v. Guggenheimer (1887) 67 Md. 542. But see Fetridge v. Merchant (1857) 4 Abb. Pr. (N. Y.) 156; Stewart v. Smithson (1856) 1 Hilt. (N. Y.) 119; Comstock v. White (1860) 18 How. Pr. (N. Y.) 421; Ellis v. Zeilin (1871) 42 Ga. 91.

[11] Mossler v. Jacobs (1896) 66 Ill. App. 571.

every puff of one's goods, that is to be regarded as a false representation. In some instances the courts have gone to an extreme in holding exaggerated statements to be evidence of deceit on the part of a plaintiff sufficient to disentitle him to relief. Thus, where a firm had adopted the name "Galaxy Publishing Company," it was held that this name falsely implied that plaintiffs were a corporation, and an injunction restraining an imitation of the name was refused.[12] In one case a trade-mark was refused protection because used upon bottles represented as being pint and quart bottles, and containing considerably less.[13] In another case, however, where complainant's preparation was advertised as "Sold only in quart bottles," while the bottles, though known among druggists as quart bottles, held substantially less than a quart, it was held that this fact was immaterial.[14] Moreover, it is not necessary, in order that this defense should prevail, that the plaintiff should have deliberately designed to deceive. If what is stated on the label is naturally calculated to deceive, and must and does inevitably deceive, the false statement has the same effect as if willfully made.[15]

§ 316. False Statements on Packages.

The false statements that ordinarily deprive the plaintiff, in an action in equity against an alleged infringer, of the right to relief, are generally found upon the package itself. Such statements usually relate to the person by whom the article is manufactured, to the place where it is manufactured, to the materials used, the results to be derived therefrom, or to the existence of a patent or copyright thereon.[16]

[12] McNair v. Cleave (1874) 10 Phila. (Pa.) 155.
[13] Hennessy v. Wheeler (1876) 51 How. Pr. (N. Y.) 457.
[14] Alexander v. Morse (1884) 14 R. I. 153.
[15] Kenny v. Gillet (1889) 70 Md. 574.
[16] Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218.

§ 317. False Statements in Advertisements.

False representations in advertisements are as fatal to the right of the proprietor of a trade-mark or trade-name to restrain its infringement, or to the right of a user of a label, or particular style of package, to restrain unfair competition, as similar statements are when made directly in the trade-mark or trade-name, or on the label itself.[17] Even where

[17] Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Leather Cloth Co. v. American Leather Cloth Co. (1863) 4 De Gex, J. & S. 137, (1865) 11 H. L. Cas. 523; Fetridge v. Wells (1857) 4 Abb. Pr. (N. Y.) 144; Pidding v. How (1837) 8 Sim. 477; Perry v. Truefitt (1842) 6 Beav. 66; Preservaline Mfg. Co. v. Heller Chemical Co. (1902) 118 Fed. 103; Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Siegert v. Abbott (1893) 72 Hun (N. Y.) 243. See, contra, Curtis v. Bryan (1867) 36 How. Pr. (N. Y.) 33.

Stirling Silk Mfg. Co. v. Sterling Silk Co. (1900) 59 N. J. Eq. 400, 401: "Another reason not pressed by counsel weighs with me against granting a preliminary injunction in this case, and should be called to counsel's attention now. Complainant, in October, 1899, advertised that its method of marking on the selvedge of silks was patented, and that its right to so mark was exclusive, and not only a legal, but a moral, right. It does not appear that the advertisement or claim has been withdrawn. No such patent right existed, nor, if my views above expressed be correct, can any patented right exist, and the representation that the marking of 'guarantied' was patented was therefore false. It was, moreover, a falsehood publicly made by advertisements for the apparent purpose of influencing dealers who were adopting the method of having their names woven on the goods by manufacturers to deal with complainant only, under penalty of infringement of patent, and it may possibly have had this effect. If this false statement that the mark 'guarantied' was patented had appeared in connection with the trade mark or name itself on the goods, there could be no question, I think, that the complainant could have had no relief, even on final hearing, for the protection by injunction is not given in favor of falsehood. Kerr, Inj. 412, and cases cited. The serious question is whether a false statement that the mark was 'patented,' made, not in the trade-mark itself, but by way of collateral misrepresentation, as by advertisements, etc., is a bar to relief. Upon this point judges differ. The leading case is Ford v. Foster, L. R. 7 Ch. App.

the trade-mark or trade-name would in itself be protected, or a clear case of unfair competition is made out, relief will be refused if material false statements have been resorted to

Cas. 611. In this case Vice-Chancellor Bacon held that the misrepresentation in invoices and advertisements that a shirt called 'Ford's Eureka Shirt' was patented, when it was not, deprived complainant of right to relief on final hearing. He says (at page 619) that he is not disposed to fritter away the wholesome doctrine of the court that, if a man invokes its aid for the protection of a legal right, he is bound to show that he dealt honestly with that right, and that there was no honesty in complainant's holding himself out as being patentee when he had no such right. On appeal, all of the justices admitted the correctness of the principle of the effect of misrepresentation in the trade-mark itself, but held that collateral misrepresentations that the article was patented were not fatal to protection on final hearing, if the misrepresentations would not have been a defense to an action at law for violating the trade-mark, or sufficient basis for enjoining a suit at law. These rules were made the test of whether a court of equity was bound to aid by injunction in the protection of the legal rights. Lord Justice Mellish, at pages 632, 633. This case was cited in a late case in the house of lords (Cochrane v. MacNish [1896] App. Cas. 225, 226. and the question stated, but it was not directly passed on. My present view is that there is much to be said in favor of the rule as stated by Vice-Chancellor Bacon, especially in view of the fact that in many cases our courts of equity have adopted a rule in relation to the protection of legal rights different from that laid down by the justices on appeal in Ford v. Foster. Our courts hold in many cases that complainant must come into a court of equity with a cause essentially equitable. Minzesheimer v. Doolittle (N. J. Err. & App.; March, 1900), 45 Atl. 611, and cases cited at page 612. This rule, if applicable to the present case, and in the absence of a satisfactory explanation of the representation or of its continuance, might prevent complainant obtaining a final decree. The doubt or question as to the legal effect of the misrepresentation upon the right to a decree at final hearing is therefore an additional ground for refusing to interfere by preliminary injunction, where the necessity for such interference is not absolutely imperative, in order to protect complainant, if ultimately successful." See, also, Preservaline Mfg. Co. v. Heller Chemical Co. (1902) 118 Fed. 103.

in placing an article, in connection with which the mark or name is used, on the market.[18]

§ 318. False Statements as to Person by Whom Article is Manufactured.

False statements as to the person by whom the article, upon which a trade-mark is used, is manufactured, will deprive the complainant in an action in equity of any relief, where it appears that this is a material circumstance in guiding the purchaser in making a selection of the article. In the majority of cases in which this rule has been applied, the articles have originally been manufactured by the assignor of the complainant, and the complainant has continued to manufacture and sell the article, after acquiring the business, under the original label, thus representing to the public that the article was still being manufactured by the original proprietor. The supreme court of the United States has said: "A court of equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article."[19] The reason for this, as stated by the court, is: "If one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess, in the estimation of purchasers." Hence, where a trade-mark is a mark of special qualities, due to the superior material, processes, skill, and care exercised by the originator thereof, an assignee of the business, who continues to use labels which contain the false statement

[18] Hennessy v. Wheeler (1876) 51 How. Pr. (N. Y.) 457.
[19] Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218.

that the goods are prepared by the originator, is not entitled to relief against an infringer.[20] An assignee or purchaser of a trade-mark from the original proprietor must, in the use of the mark, indicate that he is the assignee or purchaser, or he will not be entitled to protection in the use of the mark assigned.[21] Where a plaintiff in an action in equity sold a compound under the name and trade-mark of the original proprietor, and which such original proprietor, at that time, claimed to use under and through a corporation with which he was then connected, and the plaintiff also represented that the original proprietor superintended personally the manufacture of the compound, and by his own signature certified to the genuineness of each bottle, it was held that the plaintiff was entitled to no protection.[22] It must appear, however, that there is a material false representation in the use of the mark by the complainant; that he cannot honestly use it in the manner in which he is doing, and that, in order to protect the public, it is essential to show that the assignee, and not the original proprietor, is manufacturing the article and using the mark. If the complainant can fairly continue the original mark or label without deceiving the public, a court of equity will protect him in doing so.[23] Thus, where the business of manufacturing flour had

[20] *Alaska Packers' Ass'n v. Alaska Improvement Co.* (1894) 60 Fed. 103.

[21] Stachelberg v. Ponce (1885) 23 Fed. 430; Stachelberg v. Ponce (1888) 128 U. S. 686; Hoxie v. Chaney (1887) 143 Mass. 592; People v. Molins (1888) 7 N. Y. Cr. R. 51, 10 N. Y. Supp. 130; New York Consolidated Card Co. v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611; Hazard v. Caswell (1883) 93 N. Y. 259; Krauss v. Joseph R. Peebles' Sons Co. (1893) 58 Fed. 585; Siegert v. Abbott (1884) 61 Md. 276.

[22] Helmbold v. Henry T. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453.

[23] Feder v. Benkert (1895) 70 Fed. 613.

been conducted by a firm, and one of the partners had from the first controlled it, and under his management the product of the mills had acquired its high reputation, and where the business was afterwards incorporated with the same partner as managing director, the United States court of appeals for the Seventh circuit questioned whether continuing to sell the flour under the original brands could be fittingly characterized as misrepresentation and falsehood, preventing relief in equity, and said: "Under such circumstances, it may well be said that the trade-name continued to assert the truth in its spirit and essence, and gave truthful assurance to the public that the flour was the genuine product of the Minneapolis mills operated and controlled by Mr. Pillsbury, notwithstanding the legal and technical change in ownership wrought by the incorporation."[24] In another case, where it appeared that the complainant, twenty-one years before, succeeded to the business of a firm manufacturing baking powder, and that it had continued ever since to manufacture and sell the article under its own name, it was held that the failure to show on its labels the alleged assignment was immaterial. The court said: "This omission, under the circumstances here shown, involved no fraud or false representation. Complainant made the baking powder in its cans, and its label contained no representation to the contrary. When one person buys from another, for instance, a patent medicine business, abandons the old place of manufacture, and proceeds, himself, to make the medicine at another place, but represents on his labels that it is made at the old place, and by the original compounder, he fails in a court of chancery against an alleged infringer. Nothing at all parallel to this is found here. There was, so far as I can make out, no

[24] Pillsbury v. Pillsbury-Washburn Flour Mill Co. (1894) 64 Fed. 841.

false representation or imposition on the public in the labels of the complainant."[25]

§ 319. False Statements as to Place of Manufacture.

Misrepresentations as to the place of production of an article are equally fatal to the right to maintain an action in equity with similar statements as to the manufacturer, and for the same reason. The locality of production may be a material circumstance in aiding a purchaser to make a selection, and false statements in relation thereto will mislead and deceive him. A person making such statements is guilty of fraud, and can receive no aid from a court of equity.[26]

§ 320. False Statements as to Materials Used.

Courts of equity have always been very strict in refusing aid to a complainant who has made misstatements as to the ingredients of which his article is composed, and especially

[25] Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376, affirmed (1898) 85 Fed. 231. See, also, Witthaus v. Braun (1876) 44 Md. 303; Jennings v. Johnson (1888) 37 Fed. 364; Ransom v. Ball (1889) 7 N. Y. Supp. 238; Societe Anonyme v. Western Distilling Co. (1890) 43 Fed. 416; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1891) 60 Hun, 583, 15 N. Y. Supp. 249; Clark Thread Co. v. Armitage (1896) 74 Fed. 936; The Fair v. Jose Morales & Co. (1899) 82 Ill. App. 499; Petrolia Mfg. Co. v. Bell & Bogart Soap Co. (1899) 97 Fed. 781; Block v. Standard Distilling & Distributing Co. (1899) 95 Fed. 978.

[26] Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Raymond v. Royal Baking-Powder Co. (1898) 85 Fed. 231; Palmer v. Harris (1869) 60 Pa. 156; Coleman, Burden & Warthen Co. v. Dannenberg Co. (1898) 103 Ga. 784; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1892) 135 N. Y. 24; Connell v. Reed (1880) 128 Mass. 477; Millbrae Co. v. Taylor (1894) (Cal.) 37 Pac. 235; American Cereal Co. v. Eli Pettijohn Cereal Co. (1896) 72 Fed. 903; Hegeman & Co. v. Hegeman (1880) 8 Daly (N. Y.) 1; Siegert v. Abbott (1883) 61 Md. 276. But see Cleveland Stone Co. v. Wallace (1892) 52 Fed. 431; Fischer v. Blank (1892) 64 Hun, 635, 19 N. Y. Supp. 65.

where the article is one designed for human consumption. In an early case, decided by Judge Duer, it was said: "I am fully convinced that the name 'Balm of Thousand Flowers' was invented, and is now used, to convey to the minds of purchasers the assurance that the highly-scented liquid to which the name is given is, in truth, an extract or distillation from flowers, and therefore not merely an innocent, but a pleasant and salutary, preparation. Not only is this the meaning that the words used naturally suggest, but in my opinion it is that which they actually and plainly express, and were designed to convey. * * * Let it not be said that it is of little consequence whether this representation be true or false. No representation can be more material than that of the ingredients of a compound which is recommended and sold as a medicine. There is none that is so likely to induce confidence in the application and use of the compound, and none that, when false, will more probably be attended with injurious, and perhaps fatal, consequences."[27]

Where a complainant claimed a trade-mark in the word "Puddine," in connection with the words "Rose" and "Vanilla," the court said: "The complainant himself is engaged in deceiving the very public whom he claims to protect from the deception of others. He calls his preparation 'fruit' puddine. In nine different places on his package this word 'fruit' is repeated, as descriptive of the article, and a dish of fruit (pears, grapes, etc.) is most prominently depicted on one face of each package. His packages plainly suggest that fruit of some kind enters in some shape into his compound. A chemical analysis produced by defendant, the substantial accuracy of which is not disputed, discloses the fact that his 'Puddine' is composed exclusively of cornstarch, a small amount of saccharine matter, and a flavor-

[27] Fetridge v. Wells (1857) 13 How. Pr. (N. Y.) 385.

ing extract, with a little carmine added to give it color. It contains no fruit in any form. Under these circumstances, complainant's rights are not sufficiently clear to warrant the granting of a preliminary injunction."[28] In another case, where a trade-mark was claimed in the words "Fruit-Vinegar," the court said: "The vinegar thus branded was not manufactured out of 'fruit,' in the plain, ordinary, usual sense of that term, but out of low wines distilled from cereals, and fruit enters into its composition only to a very insignificant extent. * * * It would be a novel application of the rule governing the subject of trade-marks if one who manufactures vinegar out of cereals could appropriate for the article thus manufactured the word 'fruit,' and thereby exclude another from using the word as descriptive of an article which is, in point of fact, manufactured out of fruit. * * * But whether the word 'fruit,' in this connection, is purely indicative of the character or quality of the article or not, the plaintiffs' exclusive claim to it must fail on the further ground that the use of the word, in that connection, is clearly deceptive."[29] Where the word "Capcine" was claimed as a trade-mark, Judge Blatchford placed his refusal to sustain it on the following grounds: "Courts of equity refuse to interfere in behalf of persons who claim property in a trade-mark acquired by advertising their wares under such representations as those above cited, if they are false. It is shown that there is no such article as Capcine known in chemistry or medicine, or otherwise. The authorities are clear that, in a case of this description, a plaintiff loses his right to claim the assistance of a court of equity."[30] Where

[28] Clotworthy v. Schepp (1890) 42 Fed. 62.

[29] Alden v. Gross (1887) 25 Mo. App. 123.

[30] Seabury v. Grosvenor (1877) 14 Blatchf. 262, Fed. Cas. No. 12,576.

the subject of the claimed trade-mark was "Extract of Night-Blooming Cereus," and it was admitted that the name was a deception, that the perfume was not an extract from the flower, the trade-mark being in that respect a pure invention, the bill was dismissed.[31] Where a trade-mark was claimed in the words "Syrup of Figs," and the leading representation on the labels, packages, and in the advertisements was that the preparation was a laxative fruit syrup made from the juice of the California fig, the bill of complaint was dismissed by Judge Putnam in the United States circuit court for the district of Massachusetts. The court used the following language: "The popularity of this medicine arises from the belief in the mind of the ordinary purchaser that he is buying a laxative compound, the essential ingredient of which is the California fig, whereas, in fact, he is buying a medicine the active property of which is senna. The ethical principle on which the law of trade-marks is based will not permit of any such deception. It may be true, as a scientific fact known to physicians and pharmacists, that the syrup of figs has little or no laxative property; but this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig, which is false. This is not an immaterial representation, the effect of which is harmless, but it is a representation which goes to the very essence of the plaintiff's right to a trade-mark in these words."[32] This case was affirmed on appeal,[33] and has been followed in several other cases.[34]

[31] Phalon v. Wright (1864) 5 Phila. (Pa.) 464.

[32] California Fig-Syrup Co. v. Putnam (1895) 66 Fed. 750.

[33] California Fig-Syrup Co. v. Putnam (1895) 16 C. C. A. 376, 69 Fed. 740.

[34] California Fig-Syrup Co. v. Stearns (1895) 67 Fed. 1008; California Fig-Syrup Co. v. Frederick Stearns & Co. (1896) 20 C. C. A. 22,

§ 321. False Statements as to Letters Patent.

When the proprietor of a trade-mark used upon or in connection with a commercial article represents the article as protected by a patent, when in fact it is not, he loses his right to protection of such trade-mark, and the same rule applies whether there never was a patent on the article, or a patent granted therefor has been declared by the courts invalid, or has expired by limitation.[35] In some cases it

73 Fed. 812. But see California Fig-Syrup Co. v. Improved Fig-Syrup Co. (1892) 51 Fed. 296; Improved Fig-Syrup Co. v. California Fig-Syrup Co. (1893) 4 C. C. A. 264, 54 Fed. 175; California Fig-Syrup Co. v. Worden (1899) 95 Fed. 132.

[35] Leather Cloth Co. v. American Leather Cloth Co. (1863) 4 De Gex, J. & S. 137, (1865) 11 H. L. Cas. 523; Flavel v. Harrison (1853) 10 Hare, 467, 22 Law J. Ch. 866, Cox, Man. Trademark Cas. 116; Morgan v. McAdam (1866) 36 Law J. Ch. 228, Cox, Man. Trademark Cas. 267; Lamplough v. Balmer (1867) W. N. 1867, p. 293, Cox, Man. Trademark Cas. 288; Leather Cloth Co. v. Lorsont (1869) L. R. 9 Eq. 345, Cox, Man. Trademark Cas. 324; Consolidated Fruit-Jar Co. v. Dorflinger (1874) 2 Amer. Law T. Rep. (N. S.) 511, Fed. Cas. No. 3,129; Cheavin v. Walker (1877) 46 Law J. Ch. 686, 5 Ch. Div. 850, Cox, Man. Trademark Cas. 528; Morse v. Worrell (1874) 10 Phila. (Pa.) 168; Brown v. Doscher (1892) 66 Hun (N. Y.) 626. See, also, Fleischmann v. Schuckmann (1881) 62 How. Pr. (N. Y.) 92; Fleischmann v. Fleischmann (1896) 7 App. Div. (N. Y.) 280; Lauferty v. Wheeler (1882) 11 Daly (N. Y.) 194; C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84.

In New York Consolidated Card Co. v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611, Daniels, J.: "The point has been taken, in support of the appeal, that the use of the words 'patent' and 'patented,' in the manufacture and sale of the plaintiff's cards, was merely collateral to the device itself, which was made use of as the plaintiff's trade-mark, and, when used in that manner, even though it should be a misrepresentation, the fact would not deprive the plaintiff of an injunction restraining the use of a trade-mark by a competing dealer. That view of the law, but upon a different state of facts, was adopted and supported in Ford v. Foster (1872) 7 Ch. App. 611, and Millington v. Fox (1838) 3 Mylne & C. 338. But this was not a collateral misrepresentation, within the rule supported by these and other cases, for the fact misrepresented accompanied each

has been held that the proprietor of a trade-mark may lawfully mark his article "Patented," if he has registered a

sale of the article which was made. It was impressed upon one of the cards, and it was conspicuously placed and repeated upon each of the wrappers, so that it was impossible for a person to buy either a single pack or a dozen packs of the cards without being immediately confronted with the representation that the article was manufactured and sold as a patented article. This representation was immediately connected with the article itself which was sold, and did not, as it did in the cases to which reference has been made, consist of an advertisement or a mere accompanying invoice. It was held in Leather Cloth Co. v. American Leather Cloth Co. (1863) 1 Hem. & M. 271, 292, 293, that a representation of this description would not deprive the plaintiff of the right to an injunction, where a patent had been issued for the invention, which at the time had ceased to exist. The case was distinguished, by these circumstances, from one where no patent had ever been issued, and where the representation that the article was patented was held sufficient to deprive the plaintiff of the right to an injunction. Flavel v. Harrison (1853) 10 Hare, 467, 19 Eng. Law & Eq. 15. And a like distinction was drawn in another action in favor of the same plaintiff against Hirschfeld (1863) 1 Hem. & M. 295. And as liberal a ruling was made concerning the use of a fictitious name in Dale v. Smithson (1861) 12 Abb. Pr. (N. Y.) 237, and Stewart v. Smithson (1856) 1 Hilt. (N. Y.) 119. But this distinction was deemed to be unsound when the decision of the vice-chancellor in the case of the Leather Cloth Company was appealed to the chancellor, for he held that the prevlous existence of an expired patent would not sanction the representation, afterwards made, that the article was patented. Leather Cloth Co. v. American Leather Cloth Co. (1863) 33 Law J. Ch. 199, 4 De Gex, J. & S. 137. And this decision was afterwards affirmed on appeal to the house of lords. (1865) 11 H. L. Cas. 522. And the legal principle sustained by it was afterwards commended and approved in Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218. Upon the same subject, in Selchow v. Baker (1883) 93 N. Y. 59, 67, it was said by Judge Rapallo, in the opinion of the court, that 'the patentee relies for his protection upon his patent, and cannot, by calling the name of his patent a trade-mark, protect his monopoly after the patent has expired, or where it has no force.' And the same view of the law was taken and followed in Cheavin v. Walker (1876) 5 Ch. Div. 850."

trade-mark therefor;[36] *in another case the opposite has been held.*[37]

§ 322. Immaterial Misrepresentations.

In order to justify refusal of an injunction to restrain the infringement of a trade-mark, the misrepresentation must be of a material fact in respect of the property sought to be

[36] Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946; Cahn v. Gottschalk (1888) 14 Daly (N. Y.) 542. See, also, Morse v. Worrell (1874) 10 Phila. (Pa.) 168.

[37] New York Consolidated Card Co. v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611.

In Insurance Oil Tank Co v. Scott (1881) 33 La. Ann. 946, Fenner, J.: "Defendant urges that the use of the abbreviation 'Pat.,' meaning patented, in the trade-mark, is a fraud on the public, and a violation of law, which deprives plaintiff of the right to redress. It is undoubtedly true that the affixing of the word 'patent' to an unpatented article, 'for the purpose of deceiving the public,' is prohibited, under penalties, by the laws of the United States (Rev. St. U. S. § 4901), and that a representation in a trade-mark that an unpatented article is protected by a patent 'prima facie amounts to a misrepresentation of an important fact, which would disentitle the owner of the mark to relief in a court of equity, as against a pirate.' Browne, Trade-Marks, § 572; Coddington, Dig. Trade-Mark Cas. § 548; (1872) 39 Conn. 450. But, to have such effect, the use of the word 'patented' must be 'with the purpose of deceiving the public,' and, if such 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. High, Inj. § 674; Coddington, Dig. §§ 570, 571. The plaintiff avers that the use of the word 'patented' in its label or brand was intended to refer, not to the article, Insurance Oil, but to the word 'Trade-Mark,' placed on the top of the label. Had the words, 'Registered in 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 we are referred to an example where so learned a jurist as Judge Cooley uses the language: 'In the United States, trade-marks may be patented,' etc. Cooley, Torts, p. 361, note. Under such circumstances, we consider the explanation of plaintiff as sufficient to maintain its honesty of intention."

protected.[38] Statements, which are not strictly true, but are entirely immaterial, are not such false representations as will disentitle a manufacturer to an injunction against infringers.[39] Where a trade-mark disclosed truly the place of manufacture and sale of the goods and substantially the true ownership of them, the fact that the name on the label was not the exact name of the manufacturers, owing to changes after the manufacture was commenced, it was held, did not deprive the plaintiffs of their right of injunction.[40] The fact that in one year, eight years before bringing suit, and forty years after the business was established, complainant issued a circular misrepresenting the character of the article sold by him, did not prevent his obtaining relief against infringement of the trade-mark borne by such article.[41] A misrepresentation not made until after the commencement of an action does not affect the plaintiff's title to relief.[42] Dates being commonly immaterial and often misapplied in business transactions, an incorrect date, upon envelopes and cards used in business, fixing the establishment of an enterprise earlier than the true date, it has been held, will impugn the *bona fides* of the party so using it, but its prompt correction, so far as possible, will, in the absence of proof of original design, rebut any charge of fraud which might otherwise be justified by it.[43] Where a trade-mark contained the words "Pure Old Rye Whiskey," it was held that the falsity of such

[38] Lloyd v. William S. Merrill Chemical Co. (1891) (Super. Ct. Cin.) 25 Ohio Law J. (Weekly Law Bul.) 319. See chapter 10, § 212.

[39] Tarrant v. Hoff (1896) 76 Fed. 959.

[40] Joseph Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321.

[41] C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84.

[42] Siegert v. Findlater (1878) 7 Ch. Div. 801.

[43] Blackwell v. Armistead (1872) 3 Hughes, 163, Fed. Cas. No. 1,474.

statement was not proven by the facts that whiskey which was sold under such trade-mark was mixed or blended, and that it was diluted with water, it not appearing that commercially "pure" whiskey is understood to be whiskey of the strength indicated by the government test.[44]

The mere fact that a trade-mark bears a fictitious name as the name of the manufacturer of the article, it has been held, 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.*[45] Where the word "Magnetic" was used on wrappers in the name of a medicine, and it was not pretended that the liquid possessed any of the properties of "magnetism," in the scientific sense of the word, and the evidence did not show that the use of the word in the title was intended to deceive the public, it was held that these facts did not deprive the plaintiff of the right to the protection of the law.[46] Where the term "Coal Oil Johnny's Petroleum Soap" was used as a trade-mark for soap, and it was admitted by the demurrer that petroleum was one of the ingredients used in making soap, it was held that this term did not necessarily indicate that that was the largest ingredient in the soap, and that plaintiff was not guilty of such misrepresentations as would disentitle it to equity.[47]

[44] Cahn v. Gottschalk (1888) 14 Daly (N. Y.) 542.

[45] Dale v. Smithson (1861) 12 Abb. Pr. (N. Y.) 237.

[46] Ransom v. Ball (1889) 7 N. Y. Supp. 238.

[47] Petrolia Mfg. Co. v. Bell & Bogart Soap Co. (1899) 97 Fed. 781. See, also, City of Carlsbad v. Kutnow (1895) 71 Fed. 167; Cochrane v. McNish (1896) 65 Law J. P. C. 20; Clark Thread Co. v. Armitage (1895) 67 Fed. 896, affirmed (1896) 21 C. C. A. 178, 74 Fed. 936; Lichtenstein v. Goldsmith (1889) 37 Fed. 359; A. F. Pike Mfg. Co. v. Cleveland Stone Co. (1888) 35 Fed. 896; Funke v. Dreyfus (1882) 34 La. Ann. 80; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277; Meriden Britannia Co. v. Parker (1872) 39 Conn. 450.

In Solis Cigar Co. v. Pozo (1891) 16 Colo. 388, 395, Bissell, C.:

"The other branch of the question—deceit of the public—is not so free from difficulty. If it be conceded that the trade-mark tended to deceive the public in any material particular, the relief must be denied. Below the picture of the tobacco plant, it will be remembered, were the words, 'Habana,' 'Copyrighted.' They were words of definite meaning to the trade, and probably of equally certain significance to the public. They were not, however, as is clear from the evidence, of the same import to each class. The word 'Copyrighted' meant the same to everybody. It implied that the protection of the statute applicable to such matters had been secured. This was probably believed to be true, but was without foundation. The misrepresentation, however, was unimportant. It did not tend to deceive the public in respect to any of those matters with which the law concerns itself. The public might buy with the same reliance on all the representations as to the place of production and ownership, whether the marks were protected by the statute, or guarded only by the appropriation and user of its owner. This element would neither be considered nor depended on by the purchaser, whether he was in or out of the trade. With regard to the word 'Habana,' the case is not so easy of settlement. This was expressive of a quality, and an absolute representation of the material of which the cigars were made. Some sorts of deception may be practiced without loss of right to the legal protection usually given this species of property. It is possible for the proof to show that the public received an erroneous impression, which would not of itself be sufficient to destroy the validity of the trade-mark. Neither need the deception be of such a character as to work a positive injury to the purchasers to deprive the user of his exclusive privilege. In the first case it must not concern any of the essential particulars which the trade-mark protects, and in the latter it must not be absolutely false as to any of its leading elements."

CHAPTER XIV.

DAMAGES, PROFITS, COSTS.

§ 323. Redress at Law or in Equity.
324. Damages at Law.
325. Recovery in Equity—English Rule.
326. Recovery in Equity—United States Rule.
327. Costs.

§ 323. Redress at Law or in Equity.

In the United States and in England the plaintiff or complainant in actions for infringement of a trade-mark or trade-name may seek redress at law or in equity,[1] and upon his

[1] In Singer Mfg. Co. v. Wilson (1876) 2 Ch. Div. 434, 453, Mellish, L. J.: "Originally, I apprehend, the right to bring an action in respect of the improper use of a trade-mark arose out of the common-law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect: that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade-mark, the common-law courts noticed that the false representation which is made by putting another man's trade-mark, or the trade-name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade-mark is imitated, and therefore the common-law courts held that such a manufacturer had a right of action for the improper use of his trade-mark. Then the common-law courts extended that doctrine one step further,—first, if I recollect rightly, in the case of Sykes v. Sykes (1824) 3 Barn. & C. 541, 543. There it was held that, although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer

selection between these two methods will depend the character of the relief accorded him. In cases of unfair competition, the complainant must seek his remedy in a court of equity.

§ 324. Damages at Law.

If the method selected be at law, the plaintiff's recovery will be limited to the loss or damage incurred by him, and will not be measured by the gain or profit made by the de-

of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person, yet, if the trade-mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade-mark properly belonged, then that was equally a deception,—a selling of goods with a false representation,—which would give the original user of the trade-mark a right of action. That was the common-law right. Then, in Millington v. Fox (1838) 3 Mylne & C. 338, the court of chancery extended the right still further. To give a right of action at common law, the thing must have been done fraudulently; it must have been intended to deceive. But the courts of equity said: "If you have purchased goods with another man's trade-mark upon them, although you may have done it perfectly honestly, not knowing that it was another man's trade-mark, or if you have manufactured goods for somebody else, who has ordered you to manufacture them with a certain trade-mark upon them, and you have manufactured the goods with that trade-mark upon them, perfectly honestly, and not knowing that you were doing anything wrong in putting that trade-mark upon them, yet, nevertheless, you cannot be allowed to put the goods into the market with that trade-mark upon them, because the effect of it will be that the goods will pass from hand to hand as being goods manufactured by the person whose trade-mark it is, and therefore you shall be restrained from doing that. The courts of equity having taken that step, trade-marks began to be considered as property, and no doubt there is, in a certain sense, a property in a trade-mark, and equally in a trade-name, because a trade-name may be used, and is very commonly used, as a trade-mark, properly so called,—that is, a mark put upon the goods themselves."

fendant;[2] and the recovery may be nominal,[3] compensatory[4] (actual), or exemplary[5] (vindictive or punitive) damages, or both of the last two mentioned. A case may occur in which

[2] Seymour v. McCormick (1853) 16 How. (U. S.) 480; Peltz v. Eichele (1876) 62 Mo. 171, 180. In Addington v. Cullinane (1887) 28 Mo. App. 238, 241, 242, Lewis, P. J.: "In 3 Sutherland on Damages, pp. 630, 631, the law is explained with numerous citations of authorities, thus: 'The compensation to the owner of a trade-mark for the injury he suffers from a wrongful and unauthorized use of it by another is ascertained and computed on substantially the same principles as damages for infringements of patents and copyrights. * * * But at law only damages can be recovered, and they will be measured by the plaintiff's loss, and not by the defendant's gain. The profits are there held not to be the measure of damages, nor an element of them, where there is any other method of ascertaining and measuring them. * * * Nor will the proof of the defendant's profits warrant a legal presumption that the plaintiff's loss is a corresponding amount.' Another elementary writer says, in the same connection: 'But the damages must be proved from the evidence. A mere possible injury furnishes no ground of damages. * * * 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. In trade-mark cases the rule is much the same.' Browne, Trade-Marks, §§ 505, 507. In Leather Cloth Co. v. Hirschfield (1865) L. R. 1 Eq. 299, 302, it was held that the law would not presume that the plaintiffs would have sold the amount of goods sold by the defendant; but the burden of proof was on the plaintiffs to show special damage by loss of custom, or otherwise. Peltz v. Eichele (1876) 62 Mo. 171, 180, was a suit for the defendant's breach of his covenant that he would not engage in the manufacture of matches for a stipulated time. The principles which controlled the decision were closely analogous to those involved in the present case. Said the court: 'What the plaintiffs have lost by the defendant's breach of covenant, and not what the defendant has gained thereby, is the legal measure of damages in this case. It was there in proof that the plaintiffs' sales had been reduced about one-half after the defendant embarked in the business, in violation of his covenant."

[3] Sykes v. Sykes (1824) 3 Barn. & C. 541, 543; Blofeld v. Payne (1833) 4 Barn. & Adol. 410-412; Thomson v. Winchester (1837) 19 Pick. (Mass.) 214, 216; Morison v. Salmon (1841) 2 Man & G.

both nominal and exemplary damages are recoverable;[6] but usually the evidence warranting the recovery of exemplary will furnish grounds for compensatory damages. Proof of fraud or of fraudulent intent on the part of defendant,[7] and of an injury actually done,[8] is necessary to recovery at law.

385, 387, 389; Coffeen v. Brunton (1849) 4 McLean, 516, 520, Fed. Cas. No. 2,946; Marsh v. Billings (1851) 7 Cush. (Mass.) 322, 332; Lemoine v. Gauton (1854) 2 E. D. Smith (N. Y.) 343, 348; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277, 285; Addington v. Cullinane (1887) 28 Mo. App. 238, 243; El Modello Cigar Mfg. Co. v. Gato (1889) 25 Fla. 886, 915; Le Page Co. v. Russia Cement Co. (1892) 51 Fed. 941, 949.

[4] Marsh v. Billings (1851) 7 Cush. (Mass.) 322, 327, 332, 333, and cases, English and American, cited; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277, 280, 285; Alexander v. Henry (1895) 12 R. P. C. 360.

[5] The Amiable Nancy (1818) 3 Wheat. (U. S.) 546, 556; Day v. Woodworth (1851) 13 How. (U. S.) 363, 370, 371; Philadelphia, W. & B. R. Co. v. Quigley (1858) 21 How. (U. S.) 202, 213, 214; Emblen v. Myers (1860) 6 Hurl. & N. 54, 60, note; Bell v. Midland Ry. Co. (1861) 10 C. B. (N. S.) 287, 307, 308; Milwaukee & St. P. Ry. Co. v. Arms (1875) 91 U. S. 489, 492, 493; Voltz v. Blackmar (1876) 64 N. Y. 440, 444; Warner v. Roehr (1884) Fed. Cas. No. 17,189a; Missouri Pac. Ry. Co. v. Humes (1885) 115 U. S. 512, 521; Barry v. Edmunds (1886) 116 U. S. 550, 562-566; Denver & R. G. Ry. v. Harris (1887) 122 U. S. 597, 609, 610; Fotheringham v. Adams Express Co. (1888) 36 Fed. 252-254; Press Pub. Co. v. Monroe (1896) 73 Fed. 196, 201.

[6] Press Pub. Co. v. Monroe (1896) 73 Fed. 196, 201.

[7] Thomson v. Winchester (1837) 19 Pick. (Mass.) 214, 216; Crawshay v. Thompson (1842) 4 Man. & G. 357, 5 Scott N. R. 562; Rodgers v. Nowill (1847) 6 Hare, 325, 5 C. B. 109, 124; Marsh v. Billings (1851) 7 Cush. (Mass.) 322, 332; Lawson v. Bank of London (1856) 18 C. B. 84, 2 Jur. (N. S.) 716; Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185, 189; Hargreaves v. Smith (1870) Cox, Man. Trade-Mark Cas. 338; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277, 285; Warner v. Roehr (1884) Fed. Cas. No. 17,189a.

[8] Singer Mfg. Co. v. Loog (1882) 8 App. Cas. 15, 30. But see Embrey v. Owen (1851) 15 Jur. 633, 637; Marsh v. Billings (1851) 7 Cush. (Mass.) 322, 332; Conrad v. Joseph Uhrig Brewing Co. (1880) 8 Mo. App. 277, 285.

Upon the question of damages, plaintiff may show his loss of custom concurrently with the infringement[9] and defendant's fraudulent sales.[10] But defendant's profits from such sales are not recoverable at law;[11] and as such profits may, and often do, exceed the loss or damage, susceptible of proof, incurred by the plaintiff by reason of the infringement, the defendant may be encouraged to continue his wrongdoing, notwithstanding the action at law, and particularly so in those cases in which the evidence does not warrant the recovery of exemplary damages. These facts, taken in connection with the further fact that the proceeding in equity may be commenced with an order restraining the continuance of the wrongdoing on the part of the defendant, to obtain which order it is only necessary to show that the defendant threatens to do or continue, and will, if not prevented, do or continue, an injury,[12] account, in a measure, at least, for the more frequent resort in these causes to the action in equity, rather than to the action at law.

§ 325. Recovery in Equity—English Rule.

In England the complainant or plaintiff, when he succeeds in getting an injunction, or in establishing his right to relief, is entitled and required to elect between damages and profits,[13] and may refuse the offer by the court of a decree for

[9] Shaw v. Pilling (1896) 175 Pa. 78, 84.

[10] Le Page Co. v. Russia Cement Co. (1892) 51 Fed. 941, 949.

[11] Peltz v. Eichele (1876) 62 Mo. 171, 180; Addington v. Cullinane (1887) 28 Mo. App. 238. See quotations from this case ante, note 2.

[12] McLean v. Fleming (1877) 96 U. S. 245, 253, 254.

[13] In Leather Cloth Co. v. Hirschfield (1865) L. R. 1 Eq. 299, 301, Wood, V. C.: "The plaintiffs had their election to have taken an account of profits or of what damages had accrued, and preferred the latter alternative."

In Lever v. Goodwin (1887) 36 Ch. Div. 1, 7, Cotton, L. J.: "It is well known that, both in trade-mark cases and patent cases, the

an account of the latter[14] as his compensation for the wrong done by or because of the unfair competition or the infringement of his trade-mark or trade-name. If he elects the former, the chancery court will usually order an inquiry as to the damages by a special or common jury at law,[15] but it may be made by such jury before the chancery court itself,[16] or by such court without a jury,[17] or by the judge at chambers, or by a referee in chancery.[18] If he elects the latter, or should not make any election, the chancery court will award him an account of profits by a proceeding in chancery.[19]

§ 326. Recovery in Equity—United States Rule.

In the United States, an equity court, having once obtained full jurisdiction, both of the subject-matter and the parties, will administer full redress, including "damages and profits," technically so called, through a master in chancery, who will be instructed by the court, not only to take an account of all profits made by the defendant, but also to make an inquiry as to all damages incurred by the complainant from or be-

plaintiff is entitled, if he succeeds in getting an injunction, to take either of two forms of relief. He may either say, 'I claim from you the damage I have sustained from your wrongful act,' or 'I claim from you the profit which you have made by your wrongful act.'"

Fennessy v. Rabbits (1887) 56 Law T. (N. S.) 138; Fennessy v. Clark (1887) 37 Ch. Div. 184, 187; Saxlehner v. Apollinaris Co. (1897) 66 Law J. Ch. Div. 533, 540, 541.

[14] Leather Cloth Co. v. Hirschfield (1865) L. R. 1 Eq. 299.

[15] 21 & 22 Vict. (1858) c. 27, §§ 2, 6; 25 & 26 Vict. (1862) c. 42, § 3.

[16] 21 & 22 Vict. (1858) c. 27, §§ 2-4; Sayers v. Collyer (1884) 28 Ch. Div. 103, 107; Dreyfus v. Peruvian Guano Co. (1889) 42 Ch. Div. 66, 73.

[17] 21 & 22 Vict. (1858) c. 27, §§ 2, 5; 25 & 26 Vict. (1862) c. 42, § 3.

[18] 36 & 37 Vict. (1873) c. 66, § 56.

[19] Hills v. Evans (1862) 8 Jur. (N. S.) 525, 531; Cartier v. Carlile (1862) 31 Beav. 292, 298; Lever v. Goodwin (1887) 36 Ch. Div. 1, 3, 7, 8; Saxlehner v. Apollinaris Co. (1897) 66 Law J. Ch. Div. 533, 540, 541.

cause of the wrongdoing by defendant,[20] the law holding the latter to be a trustee for the benefit of the former to the ex-

[20] Taylor v. Carpenter (1844) 11 Paige (N. Y.) 292; Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192, 206; Gillott v. Esterbrook (1867) 47 Barb. (N. Y.) 455, 471, 480; Stonebraker v. Stonebraker (1870) 33 Md. 252, 264, 269, 270; Hostetter v. Vowinkle (1871) 1 Dill. 329, 331, Fed. Cas. No. 6,714.

In Graham v. Plate (1871) 40 Cal. 593, 598, Crockett, J.: "It is evident that the profit realized by the wrongdoer is not the only measure of damages. The spurious article may have injured the credit of the genuine one, and the profits of the owner of the trade-mark may have been greatly reduced, whilst the wrongdoer has made little or no profit. But whilst the profit made by the latter does not limit the recovery, the owner of the trade-mark is entitled to all the profit which was in fact realized. In sales made under a simulated trade-mark it is impossible to decide how much of the profit resulted from the intrinsic value of the commodity in the market, and how much from the credit given to it by the trade-mark. In the very nature of the case it would be impossible to ascertain to what extent he could have effected sales, and at what prices, except for the use of the trade-mark. No one will deny that, on every principle of reason and justice, the owner of the trade-mark is entitled to so much of the profit as resulted from the use of the trade-mark. The difficulty lies in ascertaining what proportion of the profit is due to the trade-mark, and what to the intrinsic value of the commodity; and, as this cannot be ascertained with any reasonable certainty, it is more consonant with reason and justice that the owner of the trade-mark should have the whole profit than that he should be deprived of any part of it by the fraudulent act of the defendant. It is the same principle which is applicable to a confusion of goods. If one wrongfully mixes his own goods with those of another, so that they cannot be distinguished and separated, he shall lose the whole, for the reason that the fault is his, and it is but just that he should suffer the loss, rather than an innocent party, who in no degree contributed to the wrong. I think, therefore, there was no error in awarding to the plaintiff the whole profit made by the defendant. This view of the law appears to be supported by the following authorities: Coats v. Holbrook (1845) 2 Sandf. Ch. (N. Y.) 611; Upton, Trade-Marks, 245; Spottiswood v. Clark (1846) 8 L. T. 230; Cox, Man. Trade-Mark Cas. 85. But if there were no authorities on the point, every consideration of reason, justice, and sound policy demands that one who fraudulently

tent of all such profits,[21] and, when the unlawful business is carried on in connection with the defendant's regular business 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 fact that it is impossible to apportion the profit renders it just that he should lose the whole."

In Sawyer v. Kellogg (1881) 9 Fed. 601, Nixon, D. J.: "This is a motion to strike from the decree entered in the above case the clauses which direct an accounting and the payment of costs. * * * As to the accounting. The counsel for the defendant rests his application to strike out on two grounds: First. Because the proofs show that the defendant is not the person liable to account to the complainant. The evidence is that the defendant was largely engaged in packing blues on his own account and for others in the trade; that all the blues covered by the infringing trade-mark were put up by him for the firm of James S. Barron & Co., dealers in wooden ware, rope, and cordage in New York, who placed the same upon the market; that he made no sales to any one of the articles thus packed, but received pay from his employers solely for the work and labor of packing. The bill of complaint prays for an injunction, and for profits and damages. Having been adjudged an infringer of the trade-mark of the complainant, an injunction has been issued against him. Under the above state of facts, should he be compelled to account for profits and damages? We have no doubt about the propriety of the reference, or of the liability of the defendant, if it can be shown on the accounting that profits were made by his work and labor, or that damages resulted to the complainant therefrom. If he did not sell, the profits on the sales are not chargeable to him; but if any profits came to him for preparing the article for those who did sell, they belong to the complainant, and the object of the accounting is to ascertain that fact, and, if the defendant has damaged the complainant by the unlawful use of his trade-mark, the nature and extent of the damage is a proper subject of inquiry."

In Collins Co. v. Oliver Ames & Sons Corp. (1832) 18 Fed. 561, 571, Blatchford, J.: "The plaintiff is entitled to a decree for a per-

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[21] Sawyer v. Kellogg (1881) 9 Fed. 601, 602; Avery v. Meikle (1887) 85 Ky. 435, 451.

ness, the same agencies being employed for both, no expenses will be deducted by the master in estimating such profits;[22]

petual injunction [against the use of plaintiff's trade-mark] as prayed in the bill, and for an accounting before a master as to profits and damages, and for the costs of the suit."

In Frazer v. Frazer Lubricator Co. (1886) 18 Ill. App. 450, 464, Moran, J.: "The court below had jurisdiction to enter a decree for the damages. In this class of [trade-mark] cases, where the main relief sought is to restrain defendants, and protect complainants in the rights granted by the contract, the ascertaining of the profits made by the wrongdoer, or the damage done to the complainants, is treated as incidental, and it is the practice to decree the profits or damages to the complainants. Hostetter v. Vowinkle (1871) 1 Dill. 329, Fed. Cas. No. 6,714; Atlantic Milling Co. v. Robinson (1884) 20 Fed. 217. Here the damages were ascertained by agreement, and it would have been idle to send them to the law side to enter the judgment. Equity, having jurisdiction for one purpose, will administer complete relief. Savage v. Berry (1840) 2 Scam. (Ill.) 545; Wade v. Bunn (1876) 84 Ill. 120." In this last-cited case, Walker, J.: "It is one of the oldest and most familiar rules in chancery practice that when a court of equity acquires jurisdiction for one purpose, and has all parties in interest before it, the chancellor will proceed to do complete justice to all parties." Estes v. Leslie (1886) 27 Fed. 22, 24; Atlantic Milling Co. v. Rowland (1886) 27 Fed. 24, 25.

In Avery v. Meikle (1887) 85 Ky. 435, 442, 444, Pryor, C. J.: "The appellants maintain, as this court had determined that the simulation was intentional, the wrongful appropriation of this property right of the appellants was consummated when their plows were sold by the appellees or their agents, and the profits realized constituted the criterion of damages in equity, when no special damage was alleged or claimed by the appellants; while, on the other hand, the appellees insist that it was a mere tort, and the inquiry [as to compensation to appellants] is limited to cases where the appellees have, in selling their plows, represented them in fact to be the plows of Avery. This is the real and only issue involved in the appeal. * * * While the profits made by the wrongdoer are not, in a technical legal sense, to be termed 'damages,' still many of the text books, as well as some of the reported cases, in fixing the measure of damages in a court of equity in a case like this, say that the plain-

[22] Societe Anonyme v. Western Distilling Co. (1891) 46 Fed. 921, 922.

and as, in any case, it cannot be ascertained with any reasonable certainty how much of the profit is due to the trade-mark, and how much to the intrinsic value of the commodity,

tiff is entitled to the profits; but not so at law,—he may there recover more or he may recover less than the profits realized. The fraud does not prevent a recovery of the profits in equity, as the plaintiff may not ask for more, or be satisfied with less.

In Benkert v. Feder (1888) 34 Fed. 534, 535, Sawyer, J.: "One who deliberately and knowingly uses another's trade-mark commits a palpable and unmitigated fraud, for which there is no possible excuse. He seeks to avail himself of the good reputation of another's goods, and puts his own goods—usually, if not always, of an inferior quality—upon the market, thereby not only fraudulently cutting off the market from the party who has, by years of labor, and at great expense, established a reputation for his wares, but, in addition to this injury, destroys or injures largely that reputation which is the foundation of the owner's business, by selling inferior goods under his trade-mark, thereby leading the world to believe that the inferior goods are his. To adopt as the measure of compensation for such injuries the difference between the price for which the spurious goods would sell without the trade-mark and for which they will sell with it imprinted thereon would be a mockery of justice. In my judgment the infringer should at least account for the entire profits made upon the goods wrongfully sold with the trade-mark impressed thereon. And this is the rule established, after mature consideration, in Graham v. Plate (1871) 40 Cal. 598; Sawyer v. Kellogg (1881) 9 Fed. 601. There may also be damages beyond the mere profits resulting to the owner of the trade-mark infringed, which he may recover. * * * The infringer fraudulently attaching another man's property to his own occasions only a confusion of property, with a view of taking advantage of that other's property. The trade-mark sells the whole article, however inferior or injurious in that particular, and prevents the sale of the owner's goods of equal amount. At least that is the fraudulent purpose, and the natural tendency, whether always accomplished or not; and the injured party should have at least the whole profit resulting from the wrongful act, and such I understand and hold the rule to be. The damage may be much more arising from destroying the reputation of the owner's goods."

In Clark Thread Co. v. William Clark Co. (1898) 56 N. J. Eq. 789, 790, Dixon, J.: "It appears in the case that the Clark Mile-End

the whole will be awarded to the plaintiff,[23] and profits recoverable in equity for unfair competition are governed by the same rule as in cases for infringement of trade-marks, and are not limited to such as accrue from sales in which it is shown that the customer is actually deceived, but include all made on the goods sold in the simulated dress or package,

Spool Cotton Company, as well as the complainant, had the right to call its product 'Clark's Thread,' and to use the word 'Clark' upon its labels, and that this right may have been violated by some of the acts of the defendant which infringed the complainant's right. In this condition of things it seems to us inequitable to hold the defendant responsible to the complainant for all the profits realized by the defendant from its wrongful conduct. Its responsibility to the complainant should be confined to such profits as were diverted from the complainant, and such damages as the complainant otherwise sustained, leaving the defendant answerable to the Mile-End company for the profits unlawfully diverted from it."

In Worden v. California Fig Syrup Co. (1900) 102 Fed. 334, 337, Gilbert, Cir. J.: "It is contended further that the portion of the decree which awards an accounting is erroneous, for the reason that, in a suit on a common-law trade-mark, the complainant is not entitled to recover the defendant's profits, but only his own damages, and for the further reason that in the present case the bill contains no allegation that the defendants realized any profits. The action of the court in so decreeing an accounting of the profits is not assigned as error, and we do not consider it such plain error as to require our consideration, in the absence of such assignment."

In Williams v. Mitchell (1901) 106 Fed. 168, 172, Per Curiam: "The complainants also assert error in that the decree denied them compensation for past unfair competition. In this respect, also, we think the court was in error. The decree declares that the defendants, by their imitation of the complainants' advertisements, had been guilty of deceiving purchasers and the public into believing that the game boards of their make were the game boards made by the complainants. It declares an invasion of the complainants' rights, and the complainants are entitled, upon proper proof, to compensation to the extent of the invasion."

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[23] Graham v. Plate (1871) 40 Cal. 593, 598.

and in violation of the rights of the original proprietor.[24] Where an article put up and sold in packages simulating those of another manufacturer was manufactured by a defendant in the course of its ordinary business, and, so far as appeared, without increasing the expenses of such business, it was held that the defendant was not entitled, in an accounting for profits wrongfully obtained from the unfair competition, to an allowance for the estimated cost of manufacture as a separate business.[25] The foregoing applies more particularly to the federal courts and the courts of the few states which have not yet adopted codes of practice providing but one form of action—a "civil action"—for all civil remedies. By this "civil action," however, in those states (the majority in the Union) which have adopted that practice, law and equity are administered in the same action, but separately, or distinctly,—the former with the aid of a jury, if required by either party, and the latter by the court alone, and the court in such causes will follow the rule in equity of the federal courts, and administer full redress, including damages and profits; but the duties of the "master in chancery" in the federal courts are usually performed in the state courts by a "referee" appointed by the court, and generally a special one for the particular cause at bar.[26] In both the federal and state courts, in such cases, the profits will be regarded as one

[24] N. K. Fairbank Co. v. Windsor (1902) 118 Fed. 96; Lever v. Goodwin (1887) 4 R. P. C. 507, 36 Ch. Div. 1.

[25] N. K. Fairbank Co. v. Windsor (1902) 118 Fed. 96; Lever v. Goodwin (1887) 4 R. P. C. 507, 36 Ch. Div. 1.

[26] De Witt v. Hays (1852) 2 Cal. 463; New York Cent. Ins. Co. v. National Protection Ins. Co. (1856) 14 N. Y. 85; Phillips v. Gorham (1858) 17 N. Y. 270; Cole v. Reynolds (1858) 18 N. Y. 74, 76; Wiggins v. McDonald (1861) 18 Cal. 126; New York Ice Co. v. Northwestern Ins. Co. of Oswego (1861) 23 N. Y. 357, 360; Barlow v. Scott (1861) 24 N. Y. 40, 45; Bowen v. Aubrey (1863) 22 Cal. 566, 569; Lattin v. McCarty (1869) 41 N. Y. 107; Troost v. Davis (1869) 31 Ind. 34.

element making up the final decree or (under the Code) judgment for damages.[27]

In equity, exemplary (vindictive or punitive) damages will never be awarded or decreed. This rule was stated by Circuit Judge Morrow in a recent case as follows: "There does not appear to be any example of a case in equity in which a master, upon an accounting, has acted as a jury in a case at law, and awarded punitive damages. The complainants in the case at bar might have chosen to prosecute their rights by an action at law; but they have decided to apply for relief to a court of equity. The functions of a master on an accounting do not include the imposing of exemplary damages by way of punishment. They are confined to the estimation of the profits realized by the infringer, on the one hand, and of such damage as has been suffered by complainants, on the other, for the purpose of giving him compensation therefor. Complainants are not entitled to an award of punitive damages."[28] In some cases, though the complainant may obtain an injunction, neither damages nor profits will be awarded him.[29]

[27] Hostetter v. Vowinkle (1871) 1 Dill. 329, 331, 332, Fed. Cas. No. 6,714; Avery v. Meikle (1887) 85 Ky. 435, 446; El Modello Cigar Mfg. Co. v. Gato (1889) 25 Fla. 886.

[28] Hennessy v. Wilmerding-Loewe Co. (1900) 103 Fed. 90, 95, 96.

[29] McLean v. Fleming (1877) 96 U. S. 245, 257; Harrison v. Taylor (1865) 11 Jur. (N. S.) 408; Moet v. Couston (1864) 33 Beav. 578; Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185; Millington v. Fox (1838) 3 Mylne & C. 338; Wyeth v. Stone (1840) 1 Story, 273, Fed. Cas. No. 18,107; Beard v. Turner (1866) 13 Law T. (N. S.) 747; Estcourt v. Estcourt Hop Essence Co. (1875) 10 Ch. App. 276, cited with approval in McLean v. Fleming, supra; Low v. Fels (1888) 35 Fed. 361; Menendez v. Holt (1888) 128 U. S. 514, 528; Drummond Tobacco Co. v. Addison Tinsley Tobacco Co. (1892) 52 Mo. App. 10, 31; Stagg v. Taylor (1894) 95 Ky. 651, 669; Buchanan v. Carpenter (1896) 19 R. I. 337, 338; S. Howes Co. v. Howes Grain Cleaner Co. (1898) 24 Misc. Rep. (N. Y.) 83, 85; Clark Thread Co. v. William

§ 327. Costs.

In litigation concerning unfair competition, or the infringement of a trade-mark or trade-name, the ordinary rule in regard to costs is the same as that in other litigation, viz., the party successful in the main object of the litigation will recover, and the one unsuccessful therein will lose, all the costs thereof;[30] and this general rule is alike in the United States and England.[31]

Clark Co. (1898) 56 N. J. Eq. 789, 790; La Republique Francaise v. Schultz (1900) 102 Fed. 153, 156; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (1901) 106 Fed. 498.

[30] Millington v. Fox (1838) 3 Mylne & C. 338; Volger v. Force (1901) 63 App. Div. (N. Y.) 122, 125; Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 611, 612; Pierce v. Franks (1846) 15 Law J. Ch. 122; Partridge v. Menck (1847) 2 Sandf. Ch. (N. Y.) 622, 627; Chappell v. Davidson (1855) 2 Kay & J. 123, Cox, Man. Trade-Mark Cas. 136; Burgess v. Hately (1858) 26 Beav. 249, 251; Burgess v. Hills (1858) 26 Beav. 244, 249; Collins Co. v. Walker (1859) 7 Wkly. Rep. 222, Cox, Man. Trade-Mark Cas. 171; Nicholls v. Kimpton (1887) 3 Times Law R. 674; Burnett v. Phalon (1861) 21 How. Pr. (N. Y.) 100, 103; Jurgensen v. Alexander (1862) 24 How. Pr. (N. Y.) 269, 271; Edelsten v. Edelsten (1863) 1 De Gex, J. & S. 185, 204.

In Coats v. Holbrook (1845) 2 Sandf. Ch. (N. Y.) 586, 598, Sandford, Asst. V. C.: "The question of costs remains to be disposed of. There was no occasion for the complainants to apply to the defendants before filing their bill. They found the latter participating in a gross violation of their rights, under circumstances where it was not supposable that the defendants were ignorant of the wrong. The same consideration shows that the litigation cannot be deemed to have been unnecessary. The costs subsequent to the bill and injunction stand upon a somewhat different footing from the others. The defendants had disclosed the manufacturer to the complainants' agent, and offered to give up their profits on the sale, to pay the costs up to that time, and to stipulate in writing not to sell any more of the spurious thread. If it had turned out that they were ignorant of the spuriousness of the thread which they sold, the case would have been within the opinion expressed by Lord Cottenham in Millington v. Fox [(1838) 3 Mylne & C. 338, 352], and I

[31] See citations under note 1, supra.

But it has many exceptions in both countries, which, in each case, and without regard to the success or failure of the main

think they would have been relieved from the subsequent costs. But the offer was not made until about the time the answer was due; in fact, it was on the day the answer was filed. It was not accompanied with a proffer of a perpetual injunction, to which the complainants were entitled, and for which the proposed stipulation was not a reasonable substitute, but it required the bill to be dismissed. And finally it turns out by the answer that the defendants were not guiltless of abetting McGregor's fraud. I cannot, under these circumstances, relieve them from any part of the costs."

In McAndrew v. Bassett (1864) 10 Jur. (N. S.) 492, 495, Wood, V. C.: "Then the only question that remains is the question of costs. Undoubtedly, I should not have given any costs at all if the defendants had simply said, in the first instance, coupled with the letter they wrote: 'You have filed this bill, and we will submit at once. We will put an end to the litigation, and pay the costs up to this time;' or, if they had told the whole history, as they did frankly in that letter, though it did not reach the plaintiffs for some time afterwards, as it happened, also, singularly enough, in Millington v. Fox, and had accompanied that letter either with an offer to pay the little trifling expenses which had then been incurred, or had said, 'We ask you to let this case now be argued before the court upon the question of costs, we giving you everything else you want,' although they could not have compelled the plaintiffs to accept that offer. I think the court would have stopped the costs from that time up to the hearing. But the case has been brought to a hearing, and I think the party who has taken the chance of the argument, and who loses, must pay the costs." Field v. Lewis (1867) Cox, Man. Trade-Mark Cas. 280, Seton (4th Ed.) 237; Tonge v. Ward (1869) 21 Law T. (N. S.) 480.

In Bass v. Dawber (1869) 19 Law T. (N. S.) 626, 627, Lord Romilly: "There was a certain degree of general resemblance which made me desirous of looking into the pleadings and evidence for the purpose of seeing whether the defendants had done what could be reasonably required of them to make the distinction compiete; because, if not, and if the court suspected their bona fides,—as if a man should imitate another person's label or trade-mark, and sail so near the wind as just to avoid an injunction, and do so intentionally, —though the court does not grant the injunction, it would not willingly give him any costs of the proceedings. At the same time it must be borne in mind that if a person has bona fide taken a label

object thereof, grow out of and depend upon—First, the conduct of the successful party, which may lose him a part or the

or trade-mark which does resemble the label of another person, and this is not done with the intention to deceive, the court will not require him to change it completely, because a change in a trade-mark is a serious thing. * * * Therefore I think the plaintiffs must pay the defendants their costs of the suit, and accordingly I dismiss the bill, with costs." Wheeler & Wilson Mfg. Co. v. Shakespear (1870) 39 Law J. Ch. 36, 41; Upmann v. Elkan (1871) 7 Ch. App. 130, 133, 134; Neilson v. Betts (1871) L. R. 5 H. L. 1, 27.

In Weed v. Peterson (1872) 12 Abb. Pr. (N. S.; N. Y.) 178, 180, Learned, J.: "I think, therefore, that the plaintiffs should have a permanent injunction, as prayed for, and that they should recover costs; but I do not think that they are entitled to any damages, and in that respect the prayer of the complaint is denied." Moet v. Pickering (1878) 8 Ch. Div. 372, 375.

In Sawyer v. Kellogg (1881) 9 Fed. 601, 602, Nixon, J.: "This is a motion to strike from the decree entered in the above case the clauses which direct an accounting and the payment of costs. * * * As to the matter of costs. We find nothing in this case to take it out of the ordinary rule that a decree for an infringement and an injunction carries costs. The only reason suggested by the counsel for the defendant was that no demand was made before suit that the defendant should cease to use the label. We have never understood that, in such cases, a demand was necessary, nor that an infringer, who stoutly contests the suit to the end, should be relieved from the payment of the costs which have been incurred in consequence of his wrongdoing and his litigation. The motion to strike out is overruled, but, under the circumstances, without costs, on the motion, to the complainants." Upmann v. Forester (1883) 24 Ch. Div. 231, 237; Collins Co. v. Oliver Ames & Sons Corp. (1882) 18 Fed. 561, 571; In re Kuhn & Co.'s Trade-Marks (1878) 53 Law J. Ch. 238; Fennessy v. Day (1886) 55 Law T. (N. S.) 161; Putnam Nail Co. v. Dulaney (1891) 140 Pa. 205, 213; Hennessey v. Budde (1897) 82 Fed. 541, 542.

In Woolf v. Woolf (1899) 68 Law J. Ch. Div. 82, 83, Kekewich, J.: "There is something, to my mind, inconsistent with strict law and common fairness in saying that you may pronounce a decree against an infant, but cannot follow it by ordering him to pay the costs. The question is whether I am prevented in law from doing that which I think common fairness dictates to be right. I have here a case of a man endeavoring to pass off goods as those of the plaintiff. There are cases which show that an infant has been ordered

whole of the costs;[32] second, the conduct of the unsuccessful party, which may save him a part or the whole of the costs;[33]

to pay costs." The court cites and discusses Chubb v. Griffiths (1865) 35 Beav. 127; Lempriere v. Lange (1879) 12 Ch. Div. 675; Cory v. Gertcken (1816) 2 Madd. 40; In re Jones (1881) 50 Law J. Ch. 673, 18 Ch. Div. 109.

In Hennessy v. Wilmerding-Loewe Co. (1900) 103 Fed. 90, 96, Morrow, Cir. J.: "Respondent contends that it ought not to be compelled to pay the costs of the accounting, upon the ground that its infringement was inadvertent, and that it discontinued such infringement directly it was notified by complainants. The alleged inadvertence of the infringement has been completely disposed of by the report of the master adversely to respondent's contention. * * * There has been no formal submission on the part of the respondent, accompanied by an offer to pay the accrued costs, and the facts do not warrant any departure from the ordinary rule that the losing party pays all costs. The report of the master will therefore be confirmed, and the costs on accounting will be taxed in favor of complainants."

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[32] Rodgers v. Nowill (1847) 6 Hare, 325, 338, 339; Burnett v. Phalon (1861) 12 Abb. Pr. (N. Y.) 186; Upmann v. Elkan (1871) 7 Ch. App. 130, 133, 134; Tallcot v. Moore (1875) 6 Hun (N. Y.) 106, 109; McLean v. Fleming (1877) 96 U. S. 245, 258; Hostetter Co. v. Van Vorst (1894) 62 Fed. 600; Saxlehner v. Apollinaris Co. (1897) 66 Law J. Ch. Div. 533, 539, 541.

In Millington v. Fox (1838) 3 Myln. & C. 338, 352, 354, Lord Cottenham: "In short, it does not appear to me that there was any fraudulent intention in the use [by defendants] of the marks. That circumstance, however, does not deprive the plaintiffs of their right to the exclusive use of those names; and therefore I stated that the case is so made out as to entitle the plaintiffs to have the injunction made perpetual. * * * The question remains, what is to be done as to the costs? Now, the question of costs in chancery is left to the discretion of the court. That discretion ought to be exercised, as far as possible, according to some principle; and I am very much disposed, as a general rule, to make the costs follow the result, because, however doubtful the title may be, or however proper it may be to dispute it, it is but fair that the party who really has the right should be reimbursed, as far as giving him the costs of the suit can reimburse him. But then there is another object which the court must keep in view, namely, to repress unnecessary litigation,

third, the conduct of both parties, which may divide, in some proportion, the costs between them, or prevent the allowance of costs to either."[34]

and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights. * * * The [defendants'] letter, therefore, was an entire abandonment of that which constituted the plaintiffs' demand; and it also states that, as to what had passed,—ignorantly as they say,—they were willing to make compensation for any injury which the plaintiffs might have sustained through the use of the marks in question by the defendants. It therefore gave the plaintiffs everything which they did or could ask for by the suit which they had instituted when the letter was received, but which they had not instituted when the letter was sent. * * * Now, I say that, having received that letter, it was not proper for the plaintiffs to apply ex parte for the injunction; or, if they had obtained an order for it, they should not have drawn up the order. That letter made it, as to costs, at least, incumbent upon the plaintiffs to put to the test whether the defendants were sincere in their offer, and not to go on with the suit unless they found that they were insincere. The injunction was obtained, and has not been displaced. No attempt has been made by the defendants to displace it. That is quite consistent with what is stated in their answer, and in the letter to which I have referred. For what purpose, then, was the suit prosecuted? Why, simply and only for the sake of the account, which is so small that the plaintiffs abandon it at the hearing. Here, then, has been a very expensive suit, with no possible object but the account, which, when the cause comes on for hearing, the plaintiffs' counsel very properly abandons. Now, under these circumstances, I think that a great deal of very useless litigation has been carried on, and that a great deal of very improper expense has been incurred. It strikes me, therefore, that this is exactly a case in which the court is repressing useless litigation by refusing the plaintiffs the costs of the cause. They waive the account. They must have a perpetual injunction against the use of the marks in question, but without the costs of the cause."

[34] Millington v. Fox (1838) 3 Mylne & C. 338; McAndrew v. Bassett (1864) 10 Jur. (N. S.) 492; Barnett v. Leuchars (1865) 13 Law T. (N. S.) 495, 496; Devlin v. Devlin (1877) 69 N. Y. 212, 215; Wharton v. Thurber (1879) Cox, Man. Trade-Mark Cas. 663; American Tobacco Co. v. Guest [1892] 1 Ch. 630, 633; Saxlehner v. Eisner (1898) 88 Fed. 61, 70.

In Lever Bros. v. Smith (1902) 112 Fed. 998, 1000, Townsend,

In adjudications with regard to costs, particularly in these exceptional cases, by the chancery courts of England, the

D. J.: "An order may be entered for an injunction restraining the defendant. * * * In view, however, of the fact that, prior to this suit, defendant had discontinued the use of the more objectionable labels, and, further, in view of the limited amount of the present infringement, no costs should be allowed against defendant."

[34] Heighington v. Grant (1839) 1 Beav. 228, 231.

In Fetridge v. Wells (1857) 4 Abb. Pr. (N. Y.) 144, 156, Duer, J.: "The motion for its [the injunction's] dissolution is, however, granted without costs, since, although the plaintiff might be justly required to pay costs, the defendants have certainly no title to receive them. They represent Rice, whose conduct and proceedings have been just as blamable as those of the plaintiff,—there is not a shade of difference between them."

Farina v. Silverlock (1858) 4 Kay & J. 650, 651; Moet v. Couston (1864) 33 Beav. 578, 581; Nunn v. D'Albuquerque (1865) 34 Beav. 595, 597; Hudson v. Bennett (1866) 12 Jur. (N. S.) 519, 520; De Vitre v. Betts (1873) L. R. 6 H. L. 319, 327; Estcourt v. Estcourt Hop Essence Co. (1875) 10 Ch. App. 276, 281; Compagnie Laferme v. Hendrickx (1876) Cox, Man. Trade-Mark Cas. 512; Loveridge v. Larned (1881) 7 Fed. 294; Newman v. Pinto (1887) 4 R. P. C. 508, 57 Law T. (N. S.) 31; American Box Mach. Co. v. Crosman (1893) 57 Fed. 1029, 1030.

In Bass, Ratcliff & Gretton v. Guggenheimer (1895) 69 Fed. 271, Morris, D. J.: "By this prompt acquiescence in the complainant's demands, and the offer at once to surrender the lithographic stone, and the promise to respect the complainant's rights, the complainant obtained all it was entitled to obtain by an injunction. The complainant, for reasons of its own, has preferred, notwithstanding, to file a bill and obtain an injunction, and to have the lithographic stone given up under order of the court. It is a sound rule, for the prevention of unnecessary litigation, and to encourage parties who have ignorantly, and without bad faith, infringed a trade-mark, to promptly desist, without suit, upon being notified, that where a complainant had already obtained, before entering suit, by the prompt acquiescence of the defendant, all that an injunction can give him, he should not recover costs. I think the present is a case proper for the application of this rule. The decree will provide that each party shall pay their own costs." Willis v. Terry (1899) 98 Fed. 8.

question of costs in chancery being left to their discretion,[35] more strictness is exercised than in the United States in the direction, and evidently for the purpose, of discouraging unnecessary litigation.[36]

In the United States, the courts have discretion as to costs in equity.[37]

Upon the question of nonallowance of costs in cases where the court decides adversely to its jurisdiction, the rule varies in different states, and in the federal courts, ordinarily, costs are not allowed; but exceptions are found even there.[38] As

[35] Millington v. Fox (1838) 3 Mylne & C. 338.

[36] Millington v. Fox (1838) 3 Mylne & C. 338; Burgess v. Hately (1858) 26 Beav. 249, 251; Burgess v. Hills (1858) 26 Beav. 244, 246, 248, 249; Saxlehner v. Apollinaris Co. (1897) 66 Law J. Ch. Div. 533, 539, 541.

[37] Du Bois v. Kirk (1895) 158 U. S. 58; Pennsylvania Co. for Ins. on Lives & Granting Annuities v. Jacksonville, T. & K. W. Ry. Co. (1895) 66 Fed. 421, 422; Supreme Council, L. H., v. Nidelet (1900) 85 Mo. App. 283, 284.

In Guernsey v. Phinizy (1901) 113 Ga. 898, 901, Simmons, C. J.: "In cases in equity it is the duty of the judge to determine which party shall pay the costs, or whether he shall divide them between the parties. Civ. Code, § 4850. It is a matter within his discretion." Roussel v. Mathews (1901) 62 App. Div. (N. Y.) 1, 7, 8; Pruitt v. Pruitt (1901) 59 S. C. 509, 38 S. E. 213, 216.

[38] Burnham v. Rangeley (1847) 2 Woodb. & M. 417, Fed. Cas. No. 2,177; Mansfield, C. & L. M. Ry. Co. v. Swan (1884) 111 U. S. 379; Peper v. Fordyce (1886) 119 U. S. 469; Blacklock v. Small (1888) 127 U. S. 97.

In Day v. Sun Ins. Office (1899) 40 App. Div. (N. Y.) 305, 307, Rumsey, J.: "Although the courts have no jurisdiction to entertain this action, yet they have the power, where the question of the jurisdiction of the subject-matter has been presented to them, to award costs, even when they decide that they have no jurisdiction of the action. Thiem v. Madden (1882) 27 Hun (N. Y.) 371. Where a party brings into court a case over which the court has no jurisdiction, and the suit is dismissed for lack of jurisdiction, costs may be awarded against him, for he, by bringing his action, has submitted himself to the jurisdiction of the court. Simmons v. Sim-

stated by Mr. Justice Matthews in delivering the decision of the supreme court in a leading case: "Ordinarily, by the long-established practice and universally recognized rule of the common law, in actions at law, the prevailing party is entitled to recover a judgment for costs, the exception being that, where there is no jurisdiction in the court to determine the litigation, the cause must be dismissed for that reason, and, as the court can render no judgment for or against either party, it cannot render a judgment even for costs."[39]

mons (1884) 32 Hun (N. Y.) 551. The affirmance, therefore, must be with costs against the plaintiff." Affirmed (1901) 167 N. Y. 543.

[39] Mansfield, C. & L. M. Ry. Co. v. Swan (1884) 111 U. S. 379, 387.

CHAPTER XV.

TRADE-MARK LEGISLATION.

§ 328. The Federal Act of 1870.
329. The Federal Act of 1876.
330. The Act of 1870 Unconstitutional.
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332. The Federal Act of 1881—The Present Law.
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§ 328. The Federal Act of 1870.

The first law relating to trade-marks passed by congress was the act of July 8, 1870, and was entitled, "An act to revise, consolidate, and amend the statutes relating to patents and copyrights."[1] This law provided that any person

[1] Act July 8, 1870 (16 Stat. 198); U. S. Rev. St. 4937-4947. See Appendix, I., p. 603.

or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any state or territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty afforded similar privileges to the citizens of the United States, and who were entitled to the exclusive use of any lawful trade-mark, or who intended to adopt and use any trade-mark for exclusive use within the United States, might obtain protection for such lawful trade-mark by complying with the requirements of the statute.

§ 329. The Federal Act of 1876.

Six years later congress passed the act of August 14, 1876,[2] punishing by fine and imprisonment the fraudulent use, sale, and counterfeiting of trade-marks registered in pursuance of the statutes of the United States,—that is, trade-marks registered in pursuance of the act of July 8, 1870.

§ 330. The Act of 1870 Unconstitutional.

The title of the act of 1870 shows that congress regarded its enactment as an exercise of the power found in the clause of the constitution authorizing congress "to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." The federal courts did not agree as to the validity of the statute. In one case the law was held constitutional, and was sustained.[3] In another the contrary was held.[4] In the Trade-Mark Cases[5]

[2] Act Aug. 14, 1876 (19 Stat. 141). See Appendix I., p. 607.

[3] Duwel v. Bohmer (1878) 14 Off. Gaz. 270, Cox, Manual Trademark Cas. 613, Fed. Cas. No. 4,213.

[4] Leidersdorf v. Flint (1878) 8 Biss. 327, Cox, Manual Trademark

the question came before the supreme court, and the statute was declared unconstitutional and void. The court said that "any attempt to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties." The court was unable to find any authority in this clause of the constitution authorizing congress to legislate upon the subject of trade-marks. The court further held that the statute could not be sustained under the clause of the constitution authorizing congress to regulate commerce, as the statute provided for the registration of trade-marks generally, without reference to the species of commerce in which they were used, while the constitutional provision was limited to "commerce with foreign nations, and among the several states and with the Indian tribes." The court expressed no opinion as to whether the act would have been valid if it had provided only for the registration of trade-marks, used only in such commerce as congress was empowered to regulate.

§ 331. Act of 1876 Fell with Act of 1870.

The criminal offenses described in the act of 1876 were by express terms limited to frauds, counterfeits, and the unlawful use of trade-marks which were registered under the provisions of the former statute. As that statute was unconstitutional, so that registration under it conferred no lawful right, it followed that the criminal statute intended to protect that right must necessarily fall with it, and it was so held by the supreme court. When the act of 1881

Cas. 629, Fed. Cas. No. 8,219; Day v. Walls (1878) 35 Leg. Int. 468, Fed. Cas. No. 3,692.

[5] United States v. Steffens ("The Trade-Mark Cases;" 1879) 100 U. S. 82.

was passed, the position was taken by some members of the bar that the act of 1876 was revived, and that its provisions would then apply to trade-marks registered under the new statute,[6] but this contention was finally laid to rest by a decision of Justice Brewer, sitting in the circuit court.[7] In the opinion filed in that case it is said: "When the act of 1881 was passed, if congress had intended that penalty should be imposed for a trespass upon the rights conferred by that statute, or if it had intended that the act of 1876 should be revivified and operate upon the act of 1881, it was very easy to say so. Its silence in this respect is cogent evidence that it did not understand or intend that the penal statute should be considered a part of present and valid law; and that assumption is strengthened by the fact that it had before it for consideration this passage from the opinion of the supreme court, in which it is broadly stated that the act of 1876 had fallen with the act of 1870. Whatever may be true as to the full meaning of that decision, or as to the general power of congress to impose penalties for trespasses upon rights having no existence, it had before it the general affirmance by the court that the law of 1876 had fallen; and it must be assumed that, if it meant that it should stand and be vivified, or that any penalties should be imposed for violations of the law of 1881, it would have so stated. These considerations convince me very strongly that the act of 1876 has, as the supreme court said, fallen with the act of 1870, and it is as much a dead letter as the act of 1870, and was not vivified or given operative force by the act of 1881."

[6] Browne, Trade-Marks, § 371.

[7] United States v. Koch (1889) 40 Fed. 250. See United States v. Braun and United States v. Sohn (1889) 39 Fed. 775; Elgin Nat. Watch Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665. See 26

§ 332. The Federal Act of 1881—The Present Law.

After the decision of the supreme court in the Trade-Mark Cases, congress passed the act of 1881, which permits registration by "owners of trade-marks used in commerce with foreign nations or with the Indian tribes."[8] This act has ever since been treated as valid.[9] In the Elgin Watch Case,[10] however, in the United States circuit court of appeals for the Seventh circuit, Judge Jenkins said: "There has been no ruling upon the constitutionality of this act, and it need only be said that its validity is fairly doubtful." It has also been said that "registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States courts."[11]

§ 333. Duty of Commissioner of Patents.

The statute does not make the patent office merely a registration office, and compel the commissioner to register a trade-mark presented for registry without permitting him to pass upon its lawfulness as a trade-mark,[12] but it is the duty of the commissioner, in considering an application for regis-

Am. & Eng. Enc. Law, 484, note 1, for an argument that the courts erred in holding that the act of 1876 fell with the act of 1870.

[8] Act March 3d, 1881 (21 Stat. 502). See Appendix I., p. 610.

[9] Hennessy v. Braunschweiger (1898) 89 Fed. 666; South Carolina v. Seymour (1894) 153 U. S. 353; Luyties v. Hollender (1884) 21 Fed. 281; Schumacher v. Schwencke (1886) 26 Fed. 818.

[10] Illinois Watch Case Co. v. Elgin Nat. Watch Co. (1899) 35 C. C. A. 237, 94 Fed. 667.

[11] Hennessy v. Braunschweiger (1898) 89 Fed. 668; Einstein v. Sawhill (1893) 2 App. D. C. 10, 65 Off. Gaz. 1918.

[12] Ex parte Buffalo Pitts Co. (1899) 89 Off. Gaz. 2069; United States ex rel. Buffalo Pitts Co. v. Duell (1900) 93 Off. Gaz. 1491; United States ex rel. Bronson Co. v. Duell (1900) 93 Off. Gaz. 1491; United States v. Seymour (1894) 66 Off. Gaz. 1167.

tration, to determine whether or not the mark presented is a lawful trade-mark, and the performance of this duty involves discretion.[13]

§ 334. Owners of Trade-Marks.

The registry of a trade-mark under the act of 1881 confers no property rights similar to those acquired under the patent or copyright laws, which are grants by the United States, but merely brings pre-existing rights, which the proprietor of a trade-mark may have at common law, within the cognizance of federal courts in cases wherein it is alleged in the pleadings that such trade-mark is used in connection with commerce with foreign nations or Indian tribes.[14] The act in terms gives the right of registration only to "owners of trade-marks." It adds nothing to the right of ownership therein, and it takes nothing from such ownership. As said by the court of appeals of the District of Columbia: "The owners of trade-marks who, by the first section [of the act of 1881], are permitted to obtain registration of the same, are those that, in the manner and under the conditions prescribed, shall have used such words and symbols only as at common law are susceptible of exclusive appropriation as trade-marks."[15] It is essential, therefore, that the applicant for registration possess the legal title to that for which registration is sought, and also that it be a "trade-mark."[16]

[13] United States v. Duell (1901) 95 Off. Gaz. 229.

[14] Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 93 Fed. 624; Schumacher v. Schwencke (1886) 26 Fed. 818; Graveley v. Graveley (1890) 42 Fed. 265.

[15] United States v. Duell (1901) 95 Off. Gaz. 229. See, also, Ex parte Buffalo Pitts Co. (1899) 89 Off. Gaz. 2069; United States ex rel. Buffalo Pitts Co. v. Duell (1900) 93 Off. Gaz. 1491; United States ex rel. Bronson Co. v. Duell (1900) 93 Off. Gaz. 1491.

[16] Ex parte Bronson Co. (1899) 87 Off. Gaz. 1782; Ex parte Buffalo Pitts Co. (1899) 89 Off. Gaz. 2069; Brower v. Boulton (1892) 53 Fed.

The statute does not define the term "trade-mark," or say of what it shall consist. The term is used as though its signification was already known to the law. It speaks of it as an already existing thing, and protects it as such.[17] As said by the supreme court in the Elgin Watch Case:[18] "Trade-marks are not defined by the act, which assumes their existence and ownership, and provides for a verified declaration by applicants for registration that they have the exclusive right to the particular trade-mark sought to be registered." Hence, where all the parties to a suit were residents of the same state, and the mark registered (the geographical word "Elgin") was not a lawful trade-mark, it was held that a United States circuit court did not have jurisdiction. The right to a trade-mark is a common-law right, and the patent office, under the act of 1881, is only given authority to register lawful trade-marks under the restrictions imposed by the statute.[19] An association or league of flour manufacturers, all members of which apply a certain mark to their product to indicate that the product is made by a member of the association, is not the owner of a trade-mark, and hence not entitled to register such mark.[20] In deciding this case the commissioner of patents said: "I can find no authority in the trade-mark act permitting

389; La Croix v. May (1883) 15 Fed. 236; United States v. Roche (1879) 1 McCrary, 385, Fed. Cas. No. 16,180; Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391; Hennessy v. Braunschweiger (1898) 89 Fed. 664.

[17] Moorman v. Hoge (1871) 2 Sawy. 78. Fed. Cas. No. 9,783. This case was decided under the act of 1870, but the language used in the decision is equally applicable to the act of 1881.

[18] Elgin Nat. Watch Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665, 21 Sup. Ct. 271. See chapter 1, § 1.

[19] Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co. (1898) 85 Off. Gaz. 1905.

[20] Ex parte Anti-Adulteration League (1899) 86 Off. Gaz. 1803.

this office to register a trade-mark, the right to use which is farmed out, and which is not actually used by the would-be registrant." A union of workingmen, such as the Cigar Makers' International Union, which neither makes nor sells goods, but which seeks to promote the mental, moral, and physical welfare of its members, cannot be the owner of a trade-mark. Registration of a union label, adopted by it and placed upon goods to indicate that they were made by members of the union, is not authorized by the act of congress of 1881, and, if such registration is granted, it confers no title and gives no standing ground in a court of equity.[21]

§ 335. Commerce with Foreign Nations and Indian Tribes.

The only trade-marks that can be registered under the act of 1881 are those used in two classes of commerce,—(1) commerce with foreign nations, and (2) commerce with the Indian tribes. There is no provision for registration of trade-marks used in state or inter-state commerce. A trade-mark that has been in undisputed use for years in domestic trade, and invested with all the characteristics of a trade-mark at common law, is, nevertheless, not a trade-mark in the sense of this statute, unless it has been lawfully used in commerce with foreign nations or the Indian tribes,[22] and the registration of a trade-mark in the patent office does not affect those not engaged in commerce with foreign nations or Indian tribes with notice thereof.[23]

[21] McVey v. Brendel (1891) 144 Pa. 235. See chapter 4, § 85.

[22] Ex parte State of South Carolina (1893) 64 Off. Gaz. 1395; Seymour v. United States (1894) 2 App. D. C. 240, 66 Off. Gaz. 1167; Ryder v. Holt (1888) 128 U. S. 525; Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 35 C. C. A. 496, 93 Fed. 624; Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823.

[23] Brennan v. Emery-Bird-Thayer Dry Goods Co. (1900) 99 Fed. 971.

§ 336. Domicile of Owner.

To be entitled to registration under the statute, the owner of the mark must either be domiciled in the United States or located in a foreign country or tribe, which by treaty, convention, or law affords similar privileges to citizens of the United States.[24]

§ 337. Name of Applicant.

The statute prohibits the registration of a mark "which is merely the name of the applicant." Under the later decisions of the patent office, this prohibition is construed to extend to a word which forms a part of the name of the applicant; thus, where Adriance, Platt & Co. sought to register as a trade-mark the word "Adriance," registration was refused, although the name was used together with a symbolic representation.[25] Where the F. H. Gilson Company sought to register the word "Gilson," registration was refused, the commissioner saying: "The trade-mark act under which registry is sought distinctly states that no trade-mark shall be registered which is merely the name of the applicant. This would seem to be controlling, for the trade-mark here sought to be registered is the essential feature of applicant's name. The fact that the word 'Gilson' is not the full name of the corporation, but only a portion of it, is to my mind immaterial."[26] Many other decisions of the commissioner of patents are to the same effect.[27]

[24] See Appendix, I., p. 610.

[25] Ex parte Adriance (1881) 20 Off. Gaz. 1820.

[26] Ex parte F. H. Gilson Co. (1898) 83 Off. Gaz. 1992.

[27] Ex parte Dalsimer (1898) 85 Off. Gaz. 149; Ex parte Gale Mfg. Co. (1898) 85 Off. Gaz. 1907; Ex parte A. Featherstone (1899) 86 Off. Gaz. 1497; Ex parte Guenther Milling Co. (1899) 86 Off. Gaz. 1986; Ex parte Buffalo Pitts Co. (1899) 89 Off. Gaz. 2069; Ex parte Tabor (1901) 96 Off. Gaz. 1036; Ex parte Edwin C. Burt Co. (1901) 96 Off. Gaz. 1450.

§ 338. Identity with Registered or Known Trade-Mark.

The statute also prohibits the registration of a trade-mark "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." It is made the duty of the commissioner to decide the presumptive lawfulness of claim to an alleged trade-mark. Under this section of the statute there has been little uniformity in the decisions of the patent office. The degree of resemblance permitted to a registered or known trade-mark has varied according to the views of the examiner and the commissioner. According to the later practice in a borderline case, the benefit of the doubt is given to the owner of the registered mark, and the later applicant is refused registration.[28]

§ 339. Application of Mark.

The statute requires the applicant for registration of a trade-mark to file "a statement of the mode in which the same is applied and affixed to goods." Under this provision of the statute it has been held by the commissioner of patents that it is not an essential and important prerequisite that a mark should be affixed or attached to the goods with which it is used to make it a valid trade-mark, and that it is sufficient if the mark is so associated with the goods as to distinguish them by the particular mark.[29] In his de-

[28] Ex parte Flint & Walling Mfg. Co. (1898) 85 Off. Gaz. 148; Ex parte Lefebvre (1901) 96 Off. Gaz. 841; Sherwood v. Horton (1898) 84 Off. Gaz. 2018. See Ex parte Meriwether (1898) 83 Off. Gaz. 1513; Ex parte Foley (1899) 87 Off. Gaz. 1957; Ex parte Corning (1893) 65 Off. Gaz. 751; Ex parte Wochrine (1901) 97 Off. Gaz. 1373.

[29] Hay & Todd Mfg. Co. v. Querns (1899) 86 Off. Gaz. 1323. See chapter 4, § 99.

cision the commissioner said: "A person acquires the right to a trade-mark by putting his merchandise upon the market marked or distinguished by his particular mark. Manifestly it is impossible to 'affix' a mark to many vendible commodities,—such, for example, as wines and liquors. It is inconvenient to affix the mark to many other articles, such as cigars and cigarettes, and the common practice is to attach the mark to the package containing the articles. In many cases, and this is one of them, it would be unjust to deprive the first to adopt and use a certain mark in connection with his merchandise of his rights thereto because he had not actually 'affixed' or 'attached' the mark to such merchandise." In this instance the mark was used in various kinds of advertisements, and representations of it were put in the boxes with the goods.

§ 340. Class of Merchandise.

While an applicant may not register a mark that is identical with or closely resembles a mark already registered by another for the same class of merchandise, there is no such prohibition as to marks used for different classes of merchandise. It becomes important, therefore, to determine what goods are to be considered as belonging to the same class. The same question also arises where it is desired to register a single mark used upon a number of articles. But little information is to be obtained upon either of these questions from the decisions of the patent office, owing to the fact that the different commissioners have held such divergent views thereon. It has been held, for instance, that the following articles are not in the same class: Cigars and cigarettes;[30] breakfast foods made from wheat, and flour;[31]

[30] Ex parte Egyptian Tobacco Co. (1898) 85 Off. Gaz. 1741.
[31] Ex parte Cream of Wheat Co., 62 MS. Dec. Pat. Off. 329.

steamed hominy and prepared flour;[32] bicycles and pneumatic tires for bicycles.[33] In other instances articles much more widely separated have been held to belong to the same class. Nor have the decisions of the courts been uniform where similar questions have arisen in connection with common-law trade-marks.[34] No uniform rule can therefore be drawn from the decided cases, and each instance that arises must be determined upon general principles. As said by Judge Bradford in a case involving a technical trade-mark: "Courts should not be astute to recognize in favor of an infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrongdoer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol."[35] The courts have held that the following articles belong to the same class: Pale ale and "half-and-half";[36] smoking tobacco and cigarettes;[37] prints and other kinds of cotton goods;[38] "straight" whiskey and "blended" whiskey;[39] but that the following articles belong to different classes: Prints of the kind known as "heliotypes," and prints of other descriptive properties;[40] paint composed of a white oxide of zinc ground in oil and white oxide of zinc.[41]

[32] Ex parte Western New York Preserving & Manufacturing Co. (1896) 59 MS. Dec. Pat. Off.

[33] Ex parte Consolidated Rubber Works (1897) 62 MS. Dec. Pat. Off. See Diamond Ink Co. v. Day (1896) 60 MS. Dec. Pat. Off.

[34] See chapter 4, § 96, and chapter 9, § 202.

[35] Bass, Ratcliff & Gretton v. Feigenspan (1899) 96 Fed. 206.

[36] Bass, Ratcliff & Gretton v. Feigenspan (1899) 96 Fed. 206.

[37] Carroll v. Ertheiler (1880) 1 Fed. 688.

[38] Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297.

[39] White v. Miller (1892) 50 Fed. 277.

[40] Osgood v. Rockwood (1873) 11 Blatchf. 310, Fed. Cas. No. 10,605.

[41] La Societe Anonyme des Mines v. Baxter (1877) 14 Blatchf. 261, Fed. Cas. No. 8,099. See ex parte Faxon (1903) 103 Off. Gaz. 891.

§ 341. Descriptive Words not Registrable.

On the ground that they cannot be lawful trade-marks at common law, descriptive words are refused registration by the patent office.[42] Words, however, that are merely suggestive of some quality or characteristic of the article to which they are applied may be common-law trade-marks, and are therefore entitled to registration.[43] Descriptive words not otherwise registrable do not become so by misspelling them and misplacing capitals;[44] or when produced in Hebrew characters;[45] or by being rearranged;[46] or by being combined with other nonregistrable words.[47]

§ 342. Geographical Words not Registrable.

It being the duty of the patent office to register only marks that are, at common law, lawful trade-marks, and, under the decisions of the courts, geographical words being incapable of appropriation as trade-marks, it follows that such words are not entitled to registration under the statute, even when

[42] Ex parte Spayd (Bromo Soda Mint; 1898) 86 Off. Gaz. 631; Ex parte G. F. Heublein (Apple and Honey; 1899) 87 Off. Gaz. 179; Ex parte Bronson Co. (Ever-Ready; 1899) 87 Off. Gaz. 1782; Ex parte Krusius (Barber's Model; 1898) 82 Off. Gaz. 1687; Ex parte Capital City Dairy Co. (Purity; 1898) 83 Off. Gaz. 295; Ex parte Ervin A. Rice Co. (Better Than Mother's; 1898) 83 Off. Gaz. 1207.

[43] Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co. (Koffio; 1898) 85 Off. Gaz. 1905; Ex parte Peek (Waukeasy; 1901) 96 Off. Gaz. 425.

[44] Ex parte Henderson (Kid-Nee-Kure; 1898) 85 Off. Gaz. 453; Ex parte Miller (Fitmeeasy; 1901) 95 Off. Gaz. 1452; Ex parte Seager (Kas-K-Rilla; 1901) 97 Off. Gaz. 749.

[45] Ex parte Stuhmer (Gold Label; 1898) 86 Off. Gaz. 181.

[46] Ex parte Hance (Chill Stop; 1899) 87 Off. Gaz. 698; Ex parte Evans (Pain-Ease; 1901) 96 Off. Gaz. 425; Ex parte Crescent Mfg. Co. (No-Rip; 1901) 97 Off. Gaz. 750.

[47] Ex parte Guenther Milling Co. (Guenther's Best; 1899) 86 Off. Gaz. 1896; Ex parte Pittsburgh Pump Co. (1898) 84 Off. Gaz. 309.

used in commerce with foreign nations and Indian tribes.[48] The rule, however, is not without some exceptions. Where, in its primary meaning, a word is not geographical, it is not rendered incapable of registration by the mere fact that it has been adopted as the name of a post office, a railway station, or even a town or village.[49] A word, however, that is used to designate a locality or section of country, whether or not that be the primary sense of the word, cannot be appropriated as a trade-mark, and should not be registered,[50] but a word symbol, to be refused registration because of its geographical character, must refer to some specific locality.[51] A geographical word, not in itself registrable, will not be made registrable by printing it in any particular form of letters, by separating the letters by hyphens, or by associating with it other words which are of a descriptive character.[52]

[48] Elgin Nat. Watch Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665.

[49] Ex parte Hendley (1895) 72 Off. Gaz. 1654; Ex parte Manogue-Pidgeon Iron Co. (1901) 97 Off. Gaz. 2084.

[50] Ex parte Little (1898) 85 Off. Gaz. 1221.

[51] Ex parte Tietgens (1899) 87 Off. Gaz. 2117.

[52] Ex parte Pittsburgh Pump Co. (1898) 84 Off. Gaz. 309. The following words have in recent years been refused registration on the ground of being geographical: "Yucatan," for leather and leather goods (Ex parte Weil [1898] 83 Off. Gaz. 1802); "Aurora," for boots and shoes (Ex parte Little [1898] 85 Off. Gaz. 1221); "Gibraltar," for lamp chimneys (Ex parte Nave & McCord Mercantile Co. [1899] 86 Off. Gaz. 1985); "The Roman," for knit underwear (Ex parte Rome Textile Co. [1900] 91 Off. Gaz. 820); "St. Johnsbury," for crackers (Ex parte Cross [1901] 96 Off. Gaz. 643); "Yale," for belt-supporters (Ex parte Peats [1901] 96 Off. Gaz. 1649); "Mobile," for playing cards (Ex parte United States Playing Card Co. [1901] 96 Off. Gaz. 1855). The following words, refused registration by the examiner on the ground that they were geographical, have been admitted to registration by the commissioner: "Hausa," for lard, etc. (Ex parte Tietgens [1899] 87 Off.

§ 343. Trade-Mark Used on Patented Article.

Since the decision of the supreme court in the Singer Case, the patent office has held that a trade-mark used upon a patented article cannot be registered, for the reason that the trade-mark would become public property upon expiration of the patent, and, as a patent has a shorter term than a trade-mark certificate, the registering of the mark for thirty years would be a fraud upon the public. In one case the commissioner said: "In view of the fact that, under the trade-mark act of 1881, a certificate of registry remains in force for thirty years from its date (with certain exceptions, unnecessary to be here considered), I do not think that this office should register trade-marks which, though lawful trade-marks at the date when registry is sought, will become public property before the expiration of the thirty years. By so doing, the patent office would be placed in the light of attempting to aid in prolonging a monopoly, which manifestly, under the decisions of the courts, is unwarranted."[53] And in another case it was said by the same commissioner: "I apprehend that, in order to bring the case within the authority of Singer Mfg. Co. v. June Mfg. Co., it is not necessary that the patents should be owned by the party putting out the article under the identifying or genuine name, but that it is sufficient if such name is given to the patented article with the consent, either express or tacit, of

Gaz. 2117); "Delta," for hardware (Ex parte Manogue-Pidgeon Iron Co. [1901] 97 Off. Gaz. 2084); "Dover," for egg beaters (Ex parte Dover Stamping Co. [1890] 51 Off. Gaz. 1784); "Vienna," for flour (Ex parte Jenkins [1890] 53 Off. Gaz. 759); "Florentine," for glass (Ex parte Mississippi Glass Co. [1893] 64 Off. Gaz. 713); "Waverley," for bicycles (Ex parte Indiana Bicycle Co. [1895] 72 Off. Gaz. 1654); "Menlo Park," for watch movements (Ex parte Hampden Watch Co. [1897] 81 Off. Gaz. 1282).

[53] Ex parte Velvril Co. (1898) 84 Off. Gaz. 807. See, also, Ex parte F. H. Gilson Co. (1898) 83 Off. Gaz. 1992.

the inventor."[54] It is to be doubted whether this position is sound. As the registration of a trade-mark is a mere act of record, and as, in the case of a trade-mark used to designate a patented article, the trade-mark is valid at least until the expiration of the patent, there would seem to be no good reason for refusing registration at any time before the expiration of the patent. The certificate of registration is not a grant for thirty years, or for any period, and the fact that the trade-mark will become dedicated to the public by expiration of the patent is not, it is believed, a valid ground for refusing registration.

§ 344. Construction of Application.

Where an application for registration of a trade-mark stated that the trade-mark consisted essentially of the illustration of a boy suffering from cramps, with the words "Cramp cure" arranged below the illustration, and forming part of the phrase, "Cramp cure for every ache or pain," and the application also stated that the descriptive matter might be altered or omitted at pleasure without affecting the character of the trade-mark, it was held that the trade-mark consisted in the design of the suffering boy, and that the words "Cramp cure" formed no part thereof.[55] And where the essential feature of a trade-mark was described as the representation of a red anchor in an oval space, it was held that the registration was not proof of an intention to adopt as a trade-mark the word "Anchor," and the symbol of an anchor, irrespective of color and surroundings.[56] A per-

[54] Ex parte Horlick's Food Co. (1898) 84 Off. Gaz. 1870.

[55] L. H. Harris Drug Co. v. Stucky (1891) 46 Fed. 624.

[56] Richter v. Anchor Remedy Co. (1892) 52 Fed. 455, affirmed Richter v. Reynolds (1893) 8 C. C. A. 220, 59 Fed. 577. See Kohler Mfg. Co. v. Beshore (1892) 53 Fed. 262; affirmed (1893) 8 C. C. A. 215, 59 Fed. 572. See, also, chapter 1, § 21.

son who, in his application to the United States patent office for registration of his trade-mark, alleged that he first used it on a certain date, cannot maintain an action for an injunction and damages against one who adopted and used the same mark prior to such date.[57]

§ 345. Infringing Use of Registered Trade-Mark.

The use of a registered trade-mark upon any goods except those intended for transportation to a foreign country or for commerce with the Indian tribes is not an infringement of the rights secured to the registrant by the statute.[58]

§ 346. Registration only Prima Facie Evidence of Ownership.

Under the act of 1881, the registration of a trade-mark is only *prima facie* evidence of ownership, and is not conclusive or binding on the courts as to the right of the registrant to its exclusive use.[59]

§ 347. Interferences.

The commissioner is authorized to decide the presumptive lawfulness of claim to a trade-mark, and, in case of dispute between an applicant and a previous registrant, or between registrants, he is directed to follow, as far as the same may be applicable, the practice of courts of equity of the United States in analogous cases. Under this section of the statute the commissioner is authorized to declare interferences

[57] Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444.

[58] Brennan v. Emery-Bird-Thayer Dry Goods Co. (1900) 99 Fed. 971; Luyties v. Hollender (1884) 21 Fed. 281; Schumacher v. Schwencke (1886) 26 Fed. 818; Graveley v. Graveley (1890) 42 Fed. 265; Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 93 Fed. 624.

[59] Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823; Hennessy v. Braunschweiger (1898) 89 Fed. 664. See United States v. Braun (1889) 39 Fed. 775.

between an applicant and a registrant, or between two or more applicants, claiming the same mark for the same class of goods.[60] The right to registration between two interfering applicants, or between an applicant and a registrant, belongs to the one who, if a party to a suit in equity, would be adjudged the owner of the trade-mark.[61]

There is no authority in the statute for the patent office to give consideration, in a trade-mark interference, to the claim that, by reason of false and fraudulent representations, an applicant is not entitled to register a trade-mark, because, while a court may refuse to grant relief to the owner of a mark on account of false representations, it would not on that account hold that an alleged trade-mark was unlawful.[62]

Where an interference is declared between a registrant and an applicant, the latter being the last to adopt and use the trade-mark in the United States, although having adopted and used it in a foreign country prior to the adoption and use by the registrant in the United States, priority of adoption and use must be awarded to the registrant, in the absence of any proof of fraud on his part.[63]

It was held in one case in the patent office that a party to an interference is bound by the statement in his application as to the date of adoption and use, and cannot prove adoption and use, prior to the date set up therein, either by himself or by others from whom he may have derived title;[64]

[60] See Appendix, I., p. 612.

[61] Manitowoc Mfg. Co. v. Dickerman (1891) 57 Off. Gaz. 1721.

[62] Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co. (1898) 85 Off. Gaz. 1905.

[63] Leprince v. Iler (1900) 92 Off. Gaz. 189; Farmers' Mfg. Co. v. Harrison (1901) 96 Off. Gaz. 2062.

[64] Empire Cycle Co. v. Monarch Cycle Mfg. Co. v. Meacham Arms Co. (1898) 82 Off. Gaz. 1689. See Stuart Medicine Co. v. Goldaine (1893) 64 Off. Gaz. 1005.

but in another and later case it was held that testimony adduced on behalf of a registrant, showing an earlier adoption and use of the trade-mark by their predecessors than that set forth in the original statement, may be considered and given such weight as may be proper under the circumstances of the case.[65]

§ 348. The Federal Act of 1882.

On August 5, 1882, congress passed an act amendatory of the act of 1881, and providing that nothing contained in the act of 1881 "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."[66] This statute does not seem to add anything to the act of 1881. All trade-marks registrable since the passage of this act were registrable before its passage.[67]

§ 349. The Print and Label Act of 1874.

In 1874 congress passed an act relating to copyrights, and the third section of the act provided for registration in the patent office of prints and labels designed to be used in connection with articles of manufacture.[68] This statute is a part of the copyright law, and the authority for its enactment is found in the clause of the constitution authorizing congress to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.[69] The word "print" as used in this act is defined by the patent

[65] Sherwood v. Horton (1898) 84 Off. Gaz. 2018. See Stewart v. Einstein v. Sawhill (1892) 61 Off. Gaz. 287.

[66] See Appendix, I., p. 614.

[67] Ex parte Gale Mfg. Co. (1898) 85 Off. Gaz. 1907.

[68] Act June 18, 1874 (18 Stat. 78). See Appendix, I., p. 616.

[69] See Appendix, I., p. 615.

office as "an artistic and intellectual production designed to be used for an article of manufacture, and in some fashion pertaining thereto, but not borne by it,—such, for instance, as an advertisement thereof."[70] The word "label" as used in this act is similarly defined as "an artistic and intellectual production impressed or stamped directly upon the article 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 article of manufacture."[71]

In the leading case upon this subject the supreme court considered this statute, and said: "The clause of the constitution under which congress is authorized to legislate for the protection of authors and inventors * * * has reference only to such writings and discoveries as are the result of intellectual labor. * * * 'While the word "writings" may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are original and are founded in the creative powers of the mind.' It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, and no possible influence upon science or the useful arts. A label on a box of fruit, giving its name as 'grapes,' even with the addition of adjectives characterizing their quality, as 'black,' or 'white,' or 'sweet,' or indicating the place of their growth, as 'Malaga,' or 'California,' does not come within the object of the clause. The use of such labels upon those articles has no connection with the progress of science and the useful arts. So, a label designating ink in a bottle as 'black,' 'blue,' or 'red,' or 'indelible' or 'insoluble,'

[70] Rule 30, Appendix, I., p. 641.
[71] Rule 31, Appendix, I., p. 641.

or as possessing any other quality, has nothing to do with such progress. It cannot, therefore, be held, by any reasonable argument, that the protection of mere labels is within the purpose of the clause in question. To be entitled to a copyright, the article must have, by itself, some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached."[72]

The supreme court also held, in the same case, that in order to maintain an action for infringement the registrant must give notice of the copyright by inscribing upon the print or label the word "copyright," with the year it was entered. It is also apparent that registration under this act must conform to the provisions of the general copyright law, and must take place before publication or use of the print or label. It has been held by the patent office that "a print," as the term is used in the act, "not being applied to an article of manufacture, is not in any sense a trade-mark, nor can it become a trade-mark. It cannot be an infringement of a trade-mark, even though it may bear a device which is a trade-mark in use by and owned by a person other than the owner of the print, or even though the print may be a mere representation of such trade-mark."[73] It has also been held that the words, "for any article of manufacture," in the statute, have reference to the subject-matter of the print itself, and that, if that subject-matter does not suggest or in some

[72] Higgins v. Keuffel (1891) 140 U. S. 428. See Marsh v. Warren (1877) 14 Blatchf. 263, Fed. Cas. No. 9,121; Werckmeister v. Pierce & Bushnell Mfg. Co. (1894) 63 Fed. 445; Ex parte Wickert (1899) 90 Off. Gaz. 1157; Ex parte New England Gas & Coke Co. (1899) 90 Off. Gaz. 1365; Ex parte Miller (1901) 96 Off. Gaz. 1855; Ex parte Bowles (1901) 97 Off. Gaz. 2308; Ex parte American Wire Weavers' Protective Ass'n (1901) 94 Off. Gaz. 586.

[73] Ex parte United States Playing Card Co. (1898) 82 Off. Gaz. 1209.

manner indicate some other article of manufacture, the print is not registrable in the patent office.[74]

The patent office formerly required, in case a label presented for registration under this act contained matter capable of sequestration as a trade-mark, that the trade-mark matter should first be registered as a trade-mark; but as a label must be registered, if at all, before use, and a trade-mark cannot be registered till after use, it was manifestly impossible to comply with both requirements. It was held, however, in 1898, that there was no authority of law for requiring the registration of the trade-mark matter contained in a label as a condition precedent to the registration of the label; that the label law was designed to give protection to the mark of a new creation possessing artistic merit, and that one cannot be deprived of this protection merely because it is possible that some device contained in it might be protected in a different manner, under a different law and different clause of the constitution.[75]

§ 350. State Statutes.

Many of the states of the Union have adopted laws for the protection of trade-marks. These laws vary in many particulars. Some of them provide for the registration of trade-marks, labels, or forms of advertisement by any person or association or union of workingmen, and for the punishment of infringers by fine and imprisonment; others provide only for such registration by associations or unions of workingmen. It is beyond the scope of this work to review the provisions of these statutes. The text of the statutes will be found in Appendix III.

[74] Ex parte Barnhart (1899) 87 Off. Gaz. 2118.

[75] Ex parte Mahn (1898) 82 Off. Gaz. 1210.

§ 351. Treaties and the International Convention.

Numerous treaties have been entered into between the United States and foreign countries for the protection of trade-marks, and in 1883 several countries joined in adopting an international convention, to which the United States afterwards acceded. The purpose of this convention was "to secure by mutual agreement complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guaranty for the rights of inventors, and for the loyalty of commercial transactions." The second article of the convention provides that the subjects or citizens of each of the contracting states shall enjoy, in all of the other states of the Union, for the protection of industrial property, so far as concerns trade or commercial marks and the commercial name, the advantages which the respective laws thereof at present accord, or shall afterwards accord, to subjects or citizens, and that they shall have the same protection and the same legal recourse against all infringements of their rights upon complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each state. A final protocol, ratified at the same time as the convention, provides that no trade or commercial mark shall be excluded from protection, in one of the states of the Union, by the mere fact that it may not satisfy in respect to the signs composing it, provided that it does not satisfy, in this regard, the laws of the country of origin, and that it has been in this latter country duly deposited.[76] Congress has passed no law for the

[76] For the text of international convention, and final protocol and summary of the treaties between the United States and other nations, see Appendix, IV., p. 826. For a discussion of the amendments of the United States trade-mark laws required to give full effect to the international convention, and for the text of the treaties between

execution of this treaty, and in an opinion rendered by the attorney general of the United States it is stated:[77] "Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects or citizens. It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws." While this may be true so far as the provisions of the convention and the patent laws of the United States are concerned, in which there are one or more discriminations in favor of the citizens of the United States, it does not seem to be applicable to trade-marks, as no distinction is made in the act of 1881 between citizens of the United States and citizens or subjects of others members of the industrial property union. The trade-mark laws of the United States are reciprocal and fulfill the requirements of the convention so far as they go. The United States circuit courts have in two instances recognized this convention as in force between the United States and the other contracting nations, and has given to citizens of other members of the union the advantages secured to them by the convention.[78]

the United States and other countries, see "Report of the commissioners appointed to revise the laws relating to patents, trade-marks and trade-names with reference to existing conventions and treaties," Government Printing Office, 1900. For a full discussion of foreign trade-mark laws, international conventions, and existing treaties, see Greeley, Foreign Patent & Trade-Mark Laws, p. 129 et seq., Washington, 1901.

[77] 19 Op. Attys. Gen. 278; Browne, Trade-Marks, Preface to Supplement, page v.

[78] In Kerry v. Toupin (1894) 60 Fed. 272, it was held that citizens of Canada engaged in the manufacture of trade-marked articles, and having a place of business in the state of New York, where they

make and ship articles for sale in the United States, are within the international convention of March 20, 1883, for the protection of industrial property. In La Republique Francaise v. Schultz (1893) 57 Fed. 37, it was held that the word "Vichy," used in connection with mineral waters, and derived from the locality in France where the waters are obtained, is a trade-name, or "nom commercial," within the meaning of the industrial property treaty with France of 1883, art. 6 (25 Stat. 1376), and as such is entitled to protection in the United States, though it has not been deposited as required by the treaty in the case of trade-marks; the treaty especially providing (article 8) that the "commercial name shall be protected in all the countries of the union, without obligation of deposit, whether it forms part or not of a trade or commercial mark."

In Richter v. Reynolds (1893) 59 Fed. 577, it was held that the treaty of 1871 between the United States and Germany (17 Stat. 931, art. 17), which provides that, with regard to the marks or labels of goods, or of their packages, the citizens of Germany shall enjoy in the United States the same protection as native citizens, does not give to a citizen of Germany, who has acquired the right to a trade-mark in that country, a similar right to the trade-mark in the United States.

APPENDIX I.

FEDERAL LEGISLATION.

THE LAW OF TRADE-MARKS.

ACT OF CONGRESS OF JULY 8, 1870.

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

First. By causing to be recorded in the patent office the names of the parties, and their residence and place of business, who desire the protection of the trade-mark.

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

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

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

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

Sixth. The compliance with such regulations as may be prescribed by the commissioner of patents.

Seventh. The filing of a declaration, under the oath of the person or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has the right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive, and that the description and *fac similes* presented for record are true copies of the trade-mark sought to be protected.

Section 78. And be it further enacted, that such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act, at the same time that it becomes of no effect elsewhere, and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods: provided that six months prior to the expiration of the said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the commissioner of patents, and the fee for such renewal shall be

the same as for the original registration; certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force for a further term of thirty years: and provided further, that nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

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

Section 80. And be it further enacted, that the time of the receipt of any trade-mark at the patent office for registration shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the patent office, certified by the commissioner, shall be evidence in any suit in which such trade-mark shall be brought into controversy.

Section 81. And be it further enacted, that the commissioner of patents is authorized to make rules and regulations and to prescribe forms for the transfer of the right to use such trade-marks, conforming as nearly as practicable to the requirements of the law respecting the transfer and transmission of copyrights.

Section 82. And be it further enacted, that any person who shall procure the registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark, in the patent office under this act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case in any court of competent jurisdiction within the United States.

Section 83. And be it further enacted, that nothing in this act shall prevent, lessen, impeach or avoid, any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if this act had not been passed.

Section 84. And be it further enacted, that no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been

formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

PENAL ACT OF AUGUST 14, 1876 (19 STATUTES AT LARGE, 141).

Be it enacted by the senate and house of representatives of the United States of America in congress assembled:

Section 1. 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 a fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

Section 2. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

Section 3. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation

thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

Section 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, 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, molds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving or mold of any private label, brand, stamp, wrapper, engraving on paper or other substances or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

Section 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully make, forge or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

Section 6. That any person who shall, with intent to injure or defraud the owner of any trade-mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated, without substantial injury to such box or other thing afore-

said, any trade-mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

Section 7. That if the owner of any trade-mark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal or other substance, or molds, of his said registered trade-mark, are in the possession of any person with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States, and the commissioners of the circuit courts, may, within their respective jurisdictions, proceed under the law relating to search warrants, and may issue a search warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and said empty boxes, envelopes, wrappers, cases, bottles or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance,

molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purpose of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

Section 8. That any person who shall, with intent to defraud any person or persons, knowingly and willfully aid or abet in the violation of any of the provisions of this act, shall, upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.

Act of March 3, 1881.

An act to authorize the registration of trade marks and protect the same.

Sec. 1. Be it enacted by the senate and house of representatives of the United States in congress assembled, that the 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, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration 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, location, and citizenship of the party applying; the class of merchandise, and the par-

ticular 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.

Sec. 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.

Sec. 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, 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.

Sec. 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 into controversy.

Sec. 5. That a certificate of registry shall remain in force for thirty years from its 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 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.

Sec. 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.

SEC. 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.

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

SEC. 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.

SEC. 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.

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

SEC. 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.

SEC. 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.

Approved March 3, 1881.

ACT OF AUGUST 5, 1882.

An act relating to the registration of trade marks.

Be it enacted by the senate and house of representatives of the United States of America in congress assembled, 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.

Approved August 5, 1882.

ACT JULY 24, 1897, (U. S. ST. AT LARGE, 1ST SESS., 55TH CONG., P. 207).

Section 11. That no article of imported merchandise which shall copy or simulate the name or trade mark of any domestic manufacture or manufacturer, or which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom-house of the United States. 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 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.

THE LAW OF PRINTS AND LABELS.

CONSTITUTION, 1787.

Art. I, sec. 8.—The congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

REVISED STATUTES.

Sec. 4952. The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition,

engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such persons shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors or their assigns shall have exclusive right to dramatize or translate any of their works, for which copyright shall have been obtained under the laws of the United States.

SEC. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

SEC. 4954. The author, inventor, or designer, if he be still living, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

STATUTE RELATING TO REGISTRATION OF PRINTS AND LABELS.

Sections 3, 4, and 5 of the act of congress relating to patents, trade-marks, and copyrights, approved June 18, 1874 (18 Stat. L. p. 78), are as follows:

Sec. 3. That in the construction of this act the words "engraving, cut and print," shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the commissioner of patents, to the party entering the same.

Sec. 4. That all laws and parts of laws inconsistent with the foregoing provisions be, and the same are hereby, repealed.

Sec. 5. That this act shall take effect on and after the first day of August, eighteen hundred and seventy-four.

APPENDIX II.

RULES OF THE UNITED STATES PATENT OFFICE FOR REGISTRATION OF TRADE-MARKS.

Correspondence.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the commissioner, and only returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by postal order, check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Complaints against the examiner of trade-marks, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to registered trade-marks should refer to the name of registrant, number and date of certificate, and the class of merchandise to which the trade-mark is applied.

6. The personal attendance of applicants at the patent office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, cannot generally be allowed.

9. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain trade-marks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express charges, freight, postage, and all other charges on matter sent to the patent office must be prepaid in full; otherwise it will not be received.

Attorneys.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office cannot aid in the selection of any attorney. An applicant may be represented by any person who is registered under the provisions of rule 17 of the rules of practice of the patent office to prosecute applications for patents.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the secretary of the interior.

Who may Register a Trade-Mark.

16. A trade-mark may be registered by any person, firm, or corporation domiciled in the United States or located in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States,[1] and

[1] For list of the countries having treaties with the United States at this time see Appendix IV. p. 826.

who is entitled to the exclusive use of any trade-mark and uses the same in commerce with foreign nations or with Indian tribes.

Also, by any citizen or resident of this country wishing the protection of his trade-mark in any foreign country the laws of which require registration in the United States as a condition precedent upon the payment of the fee required by law and other due proceedings had.

17. Owners of trade-marks for which protection has been sought by registering them in the patent office under the act of July 8, 1870 (declared unconstitutional by the supreme court of the United States,—100 U. S. 82), may register the same for the same goods, without fee. With each application of this character a specific reference to the date and number of the former certificate is required.

18. Applicants whose cases were filed under the act of 1870, either prior to or since the decision of the supreme court declaring it unconstitutional, which are now pending before the office, must prepare their applications in conformity with the present law and rules. On the receipt of such an application, referring to the date of the one formerly filed, all fees paid thereon will be duly applied. Those who have paid only $10 as a first fee are advised that the law does not provide for a division of the legal fee of $25, and that the remainder of the entire fee is required before the application can be examined.

19. No trade-mark will be registered unless it shall be made to appear that the same is used as such by the applicant in commerce between the United States and some foreign nation or Indian tribe, or is within the provisions of a treaty, convention, or declaration with a foreign power, or which is merely the name of the applicant, or which is identical with a known or registered trade-mark owned by another and ap-

propriated 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 in the mind of the public or to deceive purchasers, or which is merely descriptive in its nature, or which is primarily geographical.[2]

THE APPLICATION.

20. An application for the registration of a trade-mark must be made to the commissioner of patents and must be signed by the owner of the trade-mark.

21. A complete application comprises—

(a) A brief letter of advice requesting registration, signed by the applicant. (See form 1, on page 630.)

(b) A statement specifying name, domicile, 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, 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, and if the applicant be a corporation it must set forth under the laws of what state or nation incorporated.

(c) A declaration or oath complying with section 2 of the statute on page ——. (See forms 3, 5, and 7, on pages 631-634.)

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[2] "That if the device, mark, or symbol was adopted or placed upon the article for the purpose of identifying its class, grade, style, or quality, or for any purpose other than a reference to or indication of its ownership, it cannot be sustained as a valid trade-mark." Columbia Mill Company v. Alcorn et al., 65 O. G. 1916; C. D. 1893, 672.

(d) A *facsimile* or drawing of the mark. (See rules 27 and 28.)

(e) A fee of twenty-five dollars.

22. The letter of advice, the statement, and the declaration must be in the English language and written on one side of the paper only.

23. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a trade-mark by any person, or the subject-matter thereof, unless it shall, in the opinion of the commissioner, be necessary to the proper conduct of business before the office.

Declaration or Oath.

24. The declaration or oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *charge d'affaires,* consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be, who is authorized by the laws of said country to administer oaths, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

25. The declaration cannot be amended. If that filed with the application is faulty or defective, a substitute declaration must be filed.

Facsimile or Drawing.

26. If for any reason a drawing does not constitute a satisfactory *fac simile* of the trade-mark, two copies of the trade-mark as actually used must be deposited in addition to the required drawing, to be preserved in the office for reference.

27. (1) The drawing must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than 1¼ inches is to be left blank for the heading of title, name, number, and date.

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

(4) The name of the proprietor of the trade-mark signed by himself or his attorney of record must be placed at the lower right-hand corner of the sheet and the signatures of the witnesses at the lower left-hand corner, all within the marginal line, but in no instance should they encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side, and the heading will be placed at the right and the signatures at the left, occupying

the same space and position as in an upright view, and being horizontal when the sheet is held in an upright position.

(6) Drawings should be rolled for transmission to the office—not folded.

An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

28. The office, at the request of applicants, will furnish the drawings at cost.

Examination of Applications.

29. All applications for registration are considered in the first instance by the trade-mark examiner. Whenever, on examination of an application, registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application.

30. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

Amendments.

31. The statement may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination, but no amendments will be admitted unless warranted by something in the statement or *facsimile* as originally filed.

32. In every amendment the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. (See form 8, on page 634.) All such

amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant.

33. When an amendatory clause is amended, it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be rewritten.

34. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the commissioner.

Amendments not affecting the merits may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the commissioner without withdrawing the case from issue.

35. After the completion of the application the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms.

INTERFERENCES.

36. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have an opportunity to prove priority of use, and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents.

Appeals or Petitions.

37. From an adverse decision of the examiner of trade-marks upon an applicant's right to register a trade-mark, or upon any interlocutory matter, or from a decision of the examiner of interferences, the case will be reviewed by the commissioner, on petition or appeal, without fee.

Issue, Date, and Duration of Certificate.

38. When the requirements of the law and the rules have been complied with, and the office has adjudged a trade-mark lawfully registrable, a certificate will be issued by the commissioner, under seal of the interior department, to the effect that applicant has complied with the law, and that he is entitled to the protection of his trade-mark in such case made and provided. Attached to the certificate will be a *facsimile* of the trade-mark and a printed copy of the statement and declaration.

39. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

40. A certificate of registry shall remain in force for thirty years from its 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.

Assignments.

41. The right to the use of any trade-mark is assignable

by an instrument in writing, and provision is made for recording such instrument in the patent office. But no such instrument or conveyance will be recorded unless it is in the English language, and unless an application for the registration of a trade-mark shall have first been filed in the patent office, and such instrument must identify the application by date of filing, or, where the mark has been registered, by its certificate number and the date thereof. No particular form of instrument is prescribed.

Copies and Publications.

42. After a trade-mark has been registered, printed copies of the statement and declaration in each case, with a *facsimile* of the trade-mark, can be furnished by the office upon the payment of the fee.

43. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor; otherwise an extra charge will be made for the time consumed in making any search for such assignment.

44. The Official Gazette of the patent office will contain a list of all trade-marks registered, with the name and address of the registrant in each case, an illustration of the trade-mark, a brief description of the trade-mark itself, and the particular description of goods to which it is applied.

Fees.

45. On filing an application for registration of a trade-mark	$25.00
For manuscript copies, for every 100 words or fraction thereof	.10
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less....	1.00
For recording every assignment, agreement, power	

of attorney, or other paper of more than 300 words and less than 1,000 words	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words	3.00
For abstracts of title:	
For the certificate of search.....	1.00
For each brief from the digest of assignments.	.20
For assistance to attorneys and others in the examination of records, one hour or less.....	.50
Each additional hour or fraction thereof.....	.50
For single printed copy of statement, declaration, and *facsimile*	.05
If certified, for the grant, additional.....	.50
For the certificate.....	.25

46. Money required for office fees may be paid to the commissioner, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the secretary of the treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the patent office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders, drafts, and checks should be made payable to the "Commissioner of Patents."

47. All money sent by mail, either to or from the patent office, will be at the risk of the sender. All payments to the office must be made in specie, treasury notes, national-bank notes, certificates of deposit, money orders, or certified checks.

Repayment of Money.

48. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misin-

formation on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, will not entitle a party to demand such a return.

Forms for Registration of Trade-Marks.

The following forms illustrate the manner of preparing papers for applications for registration of trade-marks. Applicants will find their business facilitated by following them closely.

(1) *Letters of Advice.*

To the Commissioner of Patents: The undersigned presents herewith a *facsimile* of his lawful trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States patent office in accordance with the law in such cases made and provided.

Dated ———, 19—. A. B.

(2) *Statement by an Individual.*

To All Whom It may Concern: Be it known that I, A. B., a citizen [or subject, as the case may be] of the ——— ———, residing at ———, ———, and doing business at No.——, ——— street, in said city, have adopted for my use a trade-mark for molasses, of which the following is a description: As shown in the accompanying *facsimile*, my trade-mark consists of the representation of a flying dove, associated with the word "Dove." This trade-mark has been continuously used in my business since ——— —, 1——. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods

comprised in said class upon which I use the said trade-mark is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

A. B.

Witnesses:
C. D.
E. F.

(3) *Declaration for an Individual.*

State of ———, } ss.:
County of ———. }

A. B., being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that he has at this time a right to the use of the trade-mark therein described; 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 it is used by him in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [here name one or more foreign nations or Indian tribes, or both, as the case may be]; and that the description and *facsimiles* presented for record truly represent the trade-mark sought to be registered.

A. B.

Sworn and subscribed before me, a ———, this ——— day of ———, 19—.

[L. S.] G. H.

(4) *Statement by a Firm.*

To All Whom It may Concern: Be it known that we, C. D. & Co., a firm domiciled in ———, county of ———,

state of ———, and doing business at No. ——, ——— street, in said city, and composed of the following members, ———, ———, ———, citizens of [or, subjects, as the case may be]———, have adopted for our use a trade-mark for molasses, of which the following is a description:

As shown in the accompanying *facsimile*, our trade-mark consists of the representation of a flying dove associated with the word "Dove." This trade-mark has been continuously used in our business since ——— —, 1——. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which we use the said trade-mark is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

C. D. & Co.,
By C. D., a Member of the Firm.

Witnesses:
E. F.
G. H.

(5) *Declaration for a Firm.*

State of ———,
ss.:
County of ———.

C. D., being duly sworn, deposes and says that he is a member of the firm of C. D. & Co., the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said firm at this time has a right to the use of the trade-mark therein described; 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 the

trade-mark is used by the said firm in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [here name one or more foreign nations or Indian tribes, or both, as the case may be]; and that the description and *facsimiles* presented for record truly represent the trade-mark sought to be registered.

C. D.

Sworn and subscribed before me, a ———, this ——— day of ———, 19—.

[L. S.] E. F.

(6) *Statement by a Corporation.*

To All Whom It may Concern: Be it known that the E. & F. Company, a corporation duly organized under the laws of the state of ———, and located in the city of ———, county of ———, in said state, and doing business in said city of ———, has adopted for its use a trade-mark for molasses, of which the following is a description: As shown in the accompanying *facsimile,* the trade-mark consists of the representation of a flying dove associated with the word "Dove." This trade-mark has been continuously used in the business of the said corporation since ——— —, 1——. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which the said trade-mark is used is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

The E. & F. Company,
By G. H., Secretary.

Witnesses:
I. J.
K. L.

(7) *Declaration for a Corporation.*

State of ———, }
County of ———. } ss.:

G. H., being duly sworn, deposes and says that he is secretary [or other officer] of the corporation the E. & F. Company, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation at this time has a right to the use of the trade-mark therein described; 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 the trade-mark is used by the said corporation in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [here name one or more foreign nations or Indian tribes, or both, as the case may be], and that the description and *facsimiles* presented for record truly represent the trade-mark sought to be registered.

G. H., Secretary[3] [or other officer].

Sworn and subscribed before me, a ———, this ——— day of ———, 19—.

[L. S.] I. J.

(8) *Amendment.*

To the Commissioner of Patents: In the matter of my application for the registration of trade-mark for molasses, No. ———, filed ——— —, 19—, I hereby amend my statement as follows:

Page ———, line ———, cancel the words "The Dove

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[3] If the corporation have a seal, it may be used to authenticate the signature of the officer.

Brand," and insert in place thereof the following: "Dove" and the representation of a dove.

Same page, line ———, erase the words "about ten years," and insert since ——— —, 1——.

Dated ———, 19—. A. B.,
By J. K., His Attorney.

RULES OF THE UNITED STATES PATENT OFFICE FOR REGISTRATION OF PRINTS AND LABELS.

Correspondence.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the commissioner, and only returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by postal order, check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Complaints against the examiner, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relat-

ing to registered prints and labels should refer to the name of registrant and number and date of certificate.

6. The personal attendance of applicants at the patent office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, cannot generally be allowed.

9. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain prints and labels have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express charges, freight, postage, and all other charges on matter sent to the patent office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office cannot aid in the selection of any attorney. An applicant may be represented by any person who is registered under the provisions of rule 17 of the rules of practice of the patent office to prosecute applications for patents.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or co-

partnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the secretary of the interior.

Who may Register a Print or Label.

16. The author of any print or label, who is a citizen or resident of the United States, or who is a subject or citizen of any country to whose subjects or citizens the United States has extended the benefits of copyright, is privileged to obtain registration in the United States.

Any person to whom an author who has the privilege of copyright in the United States has transferred his copyright can apply for and obtain a copyright entry as a proprietor.

17. By the act of March 3, 1891, which went into effect on July 1 of the same year, the United States congress, by amendment of the then existing copyright law, removed the limitation of the privilege of copyright to citizens of the United States and made it possible for foreign authors to

obtain copyright in the United States upon the same terms as native authors. The last section of this statute limits its application as follows:

That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as (to) its own citizens, and when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the president of the United States by proclamation made from time to time as the purposes of this act may require.

Under the operation of this provision, the privileges of copyright in the United States have been extended by presidential proclamations to the authors of Belgium, Chile, Costa Rica, Denmark, France, Germany, Great Britain and her possessions (Australia, Canada, India, etc.), Italy, Mexico, Netherlands (Holland) and possessions, Portugal, Spain, and Switzerland.

The authors of the countries named, therefore, and their assigns, as copyright proprietors, can obtain copyright protection for their prints and labels in the United States upon the same conditions as American authors.

Under the authority of the opinions of the attorney general, dated December 2, 1898, and February 19, 1902, residents of Cuba, Hawaii, and Porto Rico are entitled to the benefits of the copyright laws relating to the registration of prints and labels.

The Application.

18. To entitle the author or proprietor of any such print or label to register the same in the patent office, the application for registration thereof must be made to the commis-

sioner of patents, and the said application should be signed by the author or proprietor, or for the author or proprietor by a duly authorized agent.

19. A complete application comprises—

(a) A statement addressed to the commissioner of patents, disclosing applicant's name, nationality, and place of doing business; whether author or proprietor, and, if proprietor, a disclosure of the nationality of the author; the title of the print or label, and the name of the article of manufacture for which the print or label is to be used.

(b) Ten copies of the print or label, one of which, when the print or label is registered, shall be certified under the seal of the commissioner of patents and returned to the author or proprietor.

(c) A statement of its nonpublication prior to date of filing.

(d) A fee of $6.

20. The title of the print or label must appear on the copies filed.

21. The deposit of the 10 copies required should be made before the publication of the print or label, the law providing that no person shall be entitled to a copyright unless he shall also, not later than the date of publication thereof, in this or any foreign country, deliver the required copies of the print or label in the office of registry.

22. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a print or label by any person, or the subject-matter thereof, unless it shall, in the opinion of the commissioner, be necessary to the proper conduct of business before the office.

Examination of Applications.

23. The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

24. All applications for registration are considered in the first instance by the examiner. Whenever on examination of an application registration is refused for any reason whatever the applicant will be notified thereof. The reasons for such rejection will be stated, and such information will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

25. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

Amendments.

26. The application may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination, and if the copies of the prints or labels furnished are for any reason not registrable under the copyright law, the applicant may substitute copies which conform to the requirements of said law.

27. In every amendment the exact word or words to be stricken out or inserted must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

28. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the commissioner.

Amendments may be made after the allowance of an application on the recommendation of the examiner, approved by the commissioner, without withdrawing the case from issue.

29. After the completion of the application, the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms. (See rule 42).

Subject-Matter of Application.

30. The word "print," as used in section 3 of the copyright act, so far as it relates to registration in the patent office, is defined as an artistic and intellectual production designed to be used for an article of manufacture, and in some fashion pertaining thereto but not borne by it; such, for instance, as an advertisement thereof.

31. The word "label," as used in this act, so far as it relates to registration in the patent office, is defined as an artistic and intellectual production impressed or stamped directly upon the article 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 article of manufacture.

32. No print or label can be registered unless it properly belongs to an article of manufacture, and is descriptive thereof, and is as above defined, and unless the application is filed before publication thereof.

Appeals.

33. An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the commissioner in person, on appeal, without fee.

Issue, Date, and Duration of Certificate.

34. When the requirements of the law and of the rules have been complied with, and the office has adjudged a print or label registrable, a certificate will be issued by the commissioner under his seal, to the effect that the applicant has complied with the law, and that he is entitled to the protection of his print or label in such case made and provided. Attached to the certificate will be a copy of the print or label.

35. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

36. A certificate of registry shall remain in force for twenty-eight years from its date.

37. The certificate may be continued for a further term of fourteen years upon filing a second application within six months before the expiration of the term of the original certificate and complying with all other regulations with regard to original applications. Within two months from the date of said renewal the applicant must cause a copy of the record thereof to be published for four weeks in one or more newspapers printed in the United States.

Assignments.

38. Prints and labels are assignable in law by an instrument in writing. This should state the names of the assignee and assignor, the title of the print or label assigned; the date of filing the application, or, if registered, the date and number of the certificate, a statement of a "valuable consideration," and should be dated and signed.

Every assignment must be recorded in the patent office within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.

Copies and Publications.

39. After a print or label has been registered, copies thereof can be furnished, when authorized by the commissioner, upon the payment of the fee.

40. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor; otherwise an extra charge will be made for the time consumed in making the search for such assignment.

41. The Official Gazette of the patent office will contain a list of all the prints and labels registered, with the name and address of the registrant in each case, the title of the print or label, and a statement of the particular goods to which it is to be applied, together with the date of filing the application.

Fees.

42. On filing an application for registration of a print or label	$6.00
For manuscript copies for every 100 words or fraction thereof	.10
For recording every assignment, agreement, power of attorney, or other paper of 300 words or less	1.60
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words	3.00
For abstracts of title:	
For the certificate of search	1.00
For each brief from the digests of assignments	.20
For assistance to attorneys and others in the examination of records, one hour or less	.50
Each additional hour or fraction thereof	.50

For single printed copy, when authorized by the commissioner ..... .05
If certified, for the grant..... .50
For the certificate ..... .25

43. The fee for registration of a print or label is to be paid to the commissioner of patents, or to the treasurer or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the secretary of the treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the patent office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders and checks should be made payable to the "Commissioner of Patents."

44. All money sent by mail, either to or from the patent office, will be at the risk of the sender. All payments to the office must be made in specie, treasury notes, national-bank notes, certified checks, or money orders.

Repayment of Money.

45. Upon refusal of the commissioner to register the print or label, and on application by the applicant, or his duly authorized agent, the fee may be returned.

Notice of Copyright.

46. It is necessary, in order to maintain an action for infringement of a copyright, that the claim of copyright be printed on each copy of the article protected. The wording of the notice is determined by the copyright statute, section 4962, and should be as follows: Copyright, 19—, by (inserting full name of author or proprietor).

FORMS OF APPLICATION FOR REGISTRATION OF PRINTS.

(1) For an Individual.

To the Commissioner of Patents: The undersigned, A. B., a citizen [or, subject, as the case may be] of the ———— ————, residing at ————, ————, and doing business at No. ——, ———— street, in said city, hereby applies as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated] for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ————, and it is used for advertising purposes for ————.

Dated this ———— day of ————, 190—.

A. B., Author or Proprietor.

(2) For a Firm.

To the Commissioner of Patents: The undersigned, C. D. & Co., a firm domiciled in the city of ————, county of ————, state of ————, and doing business at No. ——, ———— street, in said city, and composed of the following members ————, ————, citizens of [or, subjects, as the case may be] ———— ————, hereby apply as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated] for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ————, and it is used for advertising purposes for ————.

Dated this ———— day of ————, 190—.

C. D. & Co., Author or Proprietor,

By C. D., a Member of the Firm.

(3) For a Corporation.

To the Commissioner of Patents: The applicant, the E. & F. Company, a corporation duly created by authority of the laws of the state of ——— [or other authority, as the case may be], located in the city of ———, county of ———, in said state, and doing business at No. —, ——— street, in said city, hereby applies as proprietor [the nationality of the author from whom title is derived should be stated] for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ———, and it is used for advertising purposes for ———.

Dated this ——— day of ———, 190—.

The E. & F. Company,
By G. H., the President [or other officer].

FORMS OF APPLICATION FOR REGISTRATION OF LABELS.

(1) For an Individual.

To the Commissioner of Patents: The undersigned, A. B., a citizen [or, subject, as the case may be], of the ——— ———, residing at ———, ———, and doing business at No. —, ——— street, in said city, hereby applies as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated] for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

Dated this ——— day of ———, 190—.

A. B., Author or Proprietor.

(2) For a Firm.

To the Commissioner of Patents: The undersigned, C. D. & Co., a firm domiciled in the city of ———, county of

———, state of ———, and doing business at No. ——, ——— street, in said city, and composed of the following members, ———, ———, citizens of [or, subjects, as the case may be] ——— ———, hereby apply, as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated], for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

Dated this ——— day of ———, 190—.

C. D. & Co., Author or Proprietor,
By C. D., a Member of the Firm.

(3) For a Corporation.

To the Commissioner of Patents: The applicant, the E. & F. Company, a corporation duly created by authority of the laws of the state of ——— [or other authority, as the case may be], located in the city of ———, county of ———, in said state, and doing business at No. ——, ——— street, in said city, hereby applies as proprietor [the nationality of the author from whom title is derived should be stated] for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

Dated this ——— day of ———, 190—.

The E. & F. Company,
By G. H., the President [or other officer].

APPENDIX III.

STATE AND TERRITORIAL LEGISLATION.

ALABAMA.

Article 8, c. 196, Code 1896, affords protection to manufacturers, bottlers, and vendors of soda water and other beverages against the unauthorized use of or defacement of the names, marks, etc., upon their bottles, siphons, kegs, etc., by other parties.

No general trade-mark law.

An act approved March 1, 1901, provides for the protection of labels, adopted by labor unions, from counterfeits of such labels, and punishes the unlawful use of such labels.

ALASKA.

PAGE 18, CARTER'S ANNOTATED ALASKA CODES.

Sec. 84. Knowingly Using or Counterfeiting Trade-marks, etc. That if any person shall willfully and knowingly use or cause to be used any private brands, label, stamp, or trade-mark of another, either by counterfeiting the same or using any impression or copy thereof made or prepared by the proprietor thereof, or shall willfully and knowingly use or cause to be used any colorable imitation of such brand, label, stamp, or trade-mark, with intent to deceive any one, such person, upon conviction thereof, shall be punished by imprisonment in the county jail not less than one month nor more than six months, or by fine not less than twenty nor more than three hundred dollars. [Laws Oreg. Oct. 19, 1864; Hill's Ann. Laws, § 1804.]

ARIZONA.

SESS. LAWS 1899.

An act concerning the protection of trade marks and labels and providing a penalty for the imitation of the same.

Section 1. Whenever any corporation, association or union of workingmen have adopted or shall hereafter adopt for its or their protection any label, trade mark, or form of advertisement announcing that goods to which such label, trade mark, or form of advertisement shall be attached, were manufactured by it or by a member or members of such union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark or form of advertisement; every person violating this section shall, upon conviction, be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or by fine and imprisonment.

Sec. 2. Any person who shall use any counterfeit or imitation of any label, trade mark or form of advertisement of any such corporation, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a term of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or by both.

Sec. 3. Every such association, union or corporation that has heretofore adopted or shall hereafter adopt a label, trade mark or form of advertisement, as aforesaid, shall file the same in the office of the secretary of the territory, by leaving two copies, counterparts or fac similes thereof with the secretary of the territory; said secretary shall deliver to such corporation, association or union so filing the same, a duly attested certificate of the record of the same, for which he

shall receive a fee of three dollars; such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of said union, corporation or association, to adopt the same.

Sec. 4. Every person who shall use or display the genuine label, trade mark or form of advertisement of any such association, corporation or union in any manner not authorized by such association, corporation or union, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both.

Sec. 5. Any person or persons who shall in any way use the name or seal of any such association, corporation or union, or officer thereof, in and about the sale of goods, or otherwise not being authorized to use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both.

Sec. 6. It shall be the duty of the secretary of the territory to see that all associations, unions, or corporations enjoying the benefits of labels, trade marks, or forms of advertisements herein described shall comply with the foregoing provisions in all respects.

Sec. 7. This act shall take effect and be in force from and after its passage.

Approved March 6, 1899.

ARKANSAS.

SAND. & H. DIG. ST. 1894, CH. 150.

Section 7347. Any person or firm in this state, or any of the United States or territories thereof, and any corporation

created by the authority of this state, or the United States, or any of the states or territories thereof, and any person, firm or corporation resident, or located in any foreign country, which, by treaty or convention, affords similar privileges to citizens of the United States, and who may be entitled to the exclusive use of any lawful trade mark or device, or who may intend to adopt and use any trade mark or device for exclusive use in this state, may obtain protection for such lawful trade mark or device by complying with the following requisites and requirements.

First—By making out and filing in the office of the secretary of state of this state, to be there registered or recorded, a statement specifying the names of the parties and their residence and place of business who desire the protection of the trade mark, the class of merchandise, and particular description of goods comprised in such class, by which or to which the trade mark has been or is intended to be appropriated; a description of the trade mark itself or device, or combination of words, letters or figures or characters used or intended to be used as such, and the mode in which it has been or is intended to be applied and used, and the length of time, if any, during which the trade mark has been in use.

Second—By making payment to the secretary of state, for the use of the state, of a fee of not less than twenty-five nor more than one hundred dollars, to be determined by the secretary according to a schedule of fees arranged with reference to the number of words, figures, characters, etc., contained in such statement, which schedule it is made the duty of the secretary to make and keep posted up in his office.

Sec. 7348. The certificate prescribed in the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declara-

tion, verified by the person or by some member of the firm or officer of the corporation by whom it is filed, to the effect that the party claiming the protection for the trade mark has a right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, and that the fac similes presented for record are true copies of the trade mark sought to be protected.

Sec. 7349. The secretary shall not receive and record any proposed trade mark which is not and can not become a lawful trade mark, or 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, or which is identical with a trade mark appropriated to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade mark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trade mark rightfully in use on the first day of May, 1883.

Sec. 7350. The time of the receipt of any trade mark at the office of the secretary of state, for registration or record, shall be noted and recorded. Copies of the trade mark, and of the date of receipt thereof, and of the statement filed therewith, under the seal of the secretary of state shall be furnished by the secretary to any person who may apply therefor, and pay the fee therefor fixed by the secretary, not exceeding the fee required for the original registration thereof, and such copies shall be evidence in any suit or proceeding in which such trade mark shall be brought in controversy.

Sec. 7351. A trade mark registered as above prescribed shall remain in force for twenty-five years from the date of

such registration, except in case where such trade mark is claimed for, and applied to, articles not manufactured in this state, and in which it receives protection under the laws of some other state, territory or foreign country for a shorter period, in which case it shall cease to have any force in this state, by virtue of this act, at the same time that it becomes of no effect elsewhere.

Sec. 7352. Such trade mark, during the period it remains in force, shall entitle the person, firm or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath, as aforesaid, and no other party shall lawfully use the same trade mark, or substantially the same or so nearly resembling it as to be calculated to deceive, on substantially the same description of goods, or obtain, use or employ any article or thing whatever upon which such trade mark, or substantially the same, or one so nearly resembling it as to be calculated to deceive, has been printed, painted, stamped, woven, branded, or in any manner put or placed, for the purpose of putting up, shipping, selling, or otherwise disposing of substantially the same description of goods as those to which the same has been appropriated by the party rightfully entitled to the use of such trade mark; and any person or member of any firm, or agent, or officer of any corporation, not entitled so to do, who shall knowingly use such trade mark, or obtain, use or employ, as aforesaid, any such article or thing, or shall reproduce, counterfeit, copy or imitate any recorded trade mark, and affix the same to, or, for the purpose of having the same used or disposed of, to affix to goods of substantially the same descriptive properties and qualities as those referred to in the registration, or 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 registered in pursuance of this act, 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 article, or goods referred to in said registration, shall be deemed guilty of a high misdemeanor, and upon conviction thereof, shall be punished by a fine not exceeding one thousand dollars, or imprisonment not exceeding one year, or both such fine and imprisonment, and such person, and also the firm of which he is a member, or the corporation of which he is an agent or officer, and which may have countenanced or connived at his act, shall moreover be liable to an action for damages for such wrongful act, at the suit of the owner of such trade mark, and the party aggrieved shall also have his remedy according to the course of equity, to enjoin the wrongful use of his trade mark, and to recover compensation therefor in any court of competent jurisdiction, and in any such action or suit such owner or aggrieved party shall be entitled to recover a reasonable amount for attorney's fees, to be paid by the party or parties held liable therein.

Sec. 7353. No action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

Sec. 7354. Any person who shall procure the registry of any trade mark, or of himself as the owner of a trade mark, by making false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means,

shall be liable to pay any damages sustained in consequence thereof to the person injured thereby.

Sec. 7355. 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, if the provisions of this act had not been enacted, and nothing in this act contained shall be construed by any court as abridging, or in any manner affecting unfavorably, the claim of any person to any trade mark after the expiration of the term for which such trade mark was registered.

Act March 31, 1883.

Act 149 of the Acts of 1895 affords protection to manufacturers and dealers in mineral water and other beverages, also to manufacturers of medicines or other compounds, against the unauthorized use of, or injury to or defacement of marks upon, their bottles, boxes, casks, kegs, etc.

CALIFORNIA.

Pomeroy's Civil Code, 1901.

Sec. 655. There may be ownership of * * * the goodwill of a business, trade-marks and signs, and of rights created or granted by statute.

Sec. 991. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trade mark, any form, symbol or name, which has not been so appropriated by another, to designate the origin or ownership thereof, but he cannot exclusively appropriate any designation, or part of a designation, which relates only to the name, quality or the description of the thing or business, or the place where the thing is produced or the business is carried on.

Sec. 1772. One who sells or agrees to sell any article to

which there is affixed or attached a trade mark thereby warrants that mark to be genuine and lawfully used.

Sec. 1773. One who sells or agrees to sell any article to which there is affixed or attached a statement or mark to express the quantity or quality thereof, or the place where it was, in whole or in part, produced, manufactured, or prepared, thereby warrants the truth thereof.

Pomeroy's Penal Code, 1901.

Sec. 349a. Any person engaged in the production, manufacture, or sale of any article of merchandise made in whole or in part in this state, who, by any imprint, label, trade mark, tag, stamp, or other inscription or device, placed or impressed upon such article, or upon the cask, box, case, or package containing the same, misrepresents or falsely states the kind, character, or nature of the labor employed or used, or the extent of the labor employed or used, or the number or kind of persons exclusively employed or used, or that a particular or distinctive class or character of laborers was wholly and exclusively used or employed, when, in fact, another class or character or distinction of laborers was used or employed, either jointly or in any wise supplementary to such exclusive class, character, or distinction of laborers, in the production or manufacture of the article to which *such imprint, label, trade mark, tag, stamp, or other inscription* or device is affixed, or upon the cask, box, case, or package containing the same, is guilty of a misdemeanor, and punishable by a fine of not less than fifty nor more than five hundred dollars, or by imprisonment in the county jail for not less than twenty nor more than ninety days, or both.

Section 350. Every person who willfully reproduces, copies, imitates, forges, or counterfeits, or procures to be reproduced, copied, imitated, forged, or counterfeited, any trade mark usually affixed by any person to his goods, which has

been duly recorded in the office of the secretary of state, or with the commissioner of patents in the United States patent office, or any label or brand, composed in whole or in part of a reproduction of said trade mark, or who affixes the same to goods of essentially the same descriptive properties and qualities as those referred to in the registration of such trade mark, with intent to pass off, or to assist other persons to pass off, any goods to which such reproduced, copied, imitated, forged or counterfeited trade mark, or label or brand is affixed, or intended to be affixed, as the goods of the person, firm, company, or corporation owning the said trade mark, is guilty of a misdemeanor. [As amended March 27, 1897.]

Sec. 351. Every person who sells, or keeps for sale, or manufactures or prepares, for the purpose of sale, any goods upon or to which any reproduced, copied, imitated, forged, or counterfeited trade mark or label, or brand composed in whole or in part of such a reproduced, copied, imitated, forged, or counterfeited trade mark, has been affixed, after such trade mark has been recorded in the office of the secretary of state, or with the commissioner of patents in the United States patent office, intending to represent such goods as the genuine goods of the person, firm, company, or corporation owning the said trade mark, knowing the same to be reproduced, copied, imitated, forged, or counterfeited. is guilty of a misdemeanor. [As amended March 27, 1897.]

Sec. 352. The phrases "forged trade mark" and "counterfeited trade mark," or their equivalents, as used in this chapter, include every alteration or imitation of any trade mark so resembling the original as to be likely to deceive.

Sec. 353. The phrase "trade mark," as used in the three preceding sections, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper usually affixed by any mechanic, manufac-

turer, druggist, merchant, or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

Sec. 354. Every person who has in his possession, or who uses any cask, bottle, vessel, case, cover, label, brand, or other thing bearing, or having in any way connected with it, the trade mark of another, which has been duly recorded in the office of the secretary of state, or with the commissioner of patents in the United States patent office, or the trade name of another, for the purpose of disposing of any article other than that which such cask, bottle, vessel, case, cover, label, brand, or other thing originally contained, or is connected with by the owner of such trade mark or trade name, with intent to deceive or defraud, is guilty of a misdemeanor. [As amended March 27, 1897.]

Sec. 354a. Every person who willfully sells, or traffics in any cask, keg, bottle, vessel, siphon, can, case, or other package bearing the duly filed trade mark or name of another, printed, branded, stamped, engraved, etched, blown or otherwise attached or produced thereon, or refills any such cask, keg, bottle, vessel, siphon, can, case, or other package with intent to defraud the owner thereof, without the consent of the owner thereof, or unless the same shall have been purchased from the owner thereof, is guilty of a misdemeanor. [New section added March 14, 1899.]

Sec. 354b. Every person who shall willfully deface, erase, obliterate, cover up, or otherwise remove, destroy, or conceal the duly filed trade mark, or name of another, printed, branded, stamped, engraved, etched, blown, impressed, or otherwise attached to, or produced upon any cask, keg, bottle, vessel, siphon, can, case, or other package, for the purpose of selling, or trafficking in such cask, keg, bottle, ves-

sel, siphon, can, case, or other package, or refilling such cask, keg, bottle, vessel, siphon, can, case, or other package, with intent to defraud the owner thereof, without the consent of the owner, or unless the same shall have been purchased from the owner, is guilty of a misdemeanor. [New section added March 9, 1899.]

Sec. 1524-4 provides for search-warrant where a cask, keg, bottle, etc., bearing duly filed trade-name, etc., is in possession of any one except the owner thereof, with fraudulent intent.

Deering's Political Code, 1886.

Section 3196. The phrase "trade mark" as used in this chapter 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, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Sec. 3197. Any person may record any trade mark or name by filing with the secretary of state his claim to the same, and a copy or description of such trade mark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he (or the firm or corporation of which he is a member) is the exclusive owner, or agent of the owner, of such trade mark or name.

Sec. 3198. The secretary of state must keep for public examination a record of all trade marks or names filed in his office, with the date when filed and the name of claimant; and must at the time of filing collect from such claimant

a fee of three dollars in gold coin to be paid into the state library fund.

Sec. 3199. Any person who has first adopted and used a trade mark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain, by injunction, any use of trade marks or names in violation of this chapter.

By act of March 17, 1887, two sections (3200, 3201, Deering's Supplement 1889) were added which relate especially to the trade marks of labor unions and associations.

Chapter 154, p. 217, St. 1891, affords protection to manufacturers, bottlers, and vendors of soda water, mineral water, ale, porter, beer, and other beverages, in the use of their bottles, siphons, boxes, and kegs, and provides penalties for the unauthorized use of, or the defacement of, names, marks, etc., upon such bottles, boxes, siphons, and kegs, by other parties.

COLORADO.

Laws 1899, Ch. 154.

An act to confer exclusive rights to the use of labels, trade marks, terms, designs, devices or forms of advertisement, and provide for the recording of the same, to provide a remedy for the violation of such right, and the penalty for the unlawful use of labels, trade marks, terms, designs, devices and forms of advertising, and to repeal all acts and parts of acts inconsistent herewith.

Section 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods,

wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed shall be punished by a fine of not more than five hundred dollars ($500) or by imprisonment for not more than three months or by both such fine and imprisonment.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement as provided in section 1 of this act, may file the

same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right of such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association, any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association. But the said secretary shall file and record under this act any label, trade mark, term, design, device or form of advertisement, which may have been previously filed by any person, or any association

or union of workingmen, provided the person, association or union seeking to file and record under this act is the same person, association or union that previously filed or recorded the same label, trade mark, term, design, device or form of advertisement.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations, or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding five hundred dollars ($500) or by imprisonment not exceeding three months, or by both such fine and imprisonment.

Sec. 5. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit for damages to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunction to restrain such manufacture, use, display or sale and award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendant to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 6. Every person who shall use or display the gen-

nine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars ($500). In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than five hundred dollars ($500).

Sec. 8. In case the plaintiff is successful in maintaining his action either for damages or for permanent relief by injunction, or for nominal damages only, he shall be entitled to recover a reasonable attorney's fee, to be taxed by the court as a part of the costs, and merged in the judgment.

Sec. 9. All acts and parts of acts inconsistent herewith are hereby repealed; provided, that this act shall not be construed as impairing any rights heretofore accrued, nor as affecting the remedies therefor heretofore existing.

Approved April 10, 1899.

Sections 2985a-2985f, Mills' Ann. St. 1891-1896, covered largely the same ground as the above act. Sections 2985g-2985k, inclusive, protect manufacturers, bottlers, and vendors of mineral water and other beverages, medical and other preparations, against the unauthorized use of or injury to their barrels, kegs, casks, boxes, fountains, bottles, jugs, siphons, etc., by other parties.

CONNECTICUT.

GENERAL STATUTES OF CONNECTICUT—REVISION OF 1902.

§ 4899. Every person entitled to the exclusive use of any trade mark, or who intends to adopt and use any trade mark not previously adopted or used by another, may file for record in the office of the secretary of the state, a certificate, setting forth his name, residence, and place of business; the class of merchandise, and the particular description of goods comprised in such class, to which such trade mark has been or is to be appropriated: a description of such trade mark, and of the mode in which it is to be applied and used: the date when such trade mark was first used or adopted: that he has a right to the use of it; and that no other person has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive. A fac-simile of such trade mark shall be incorporated in or annexed to such certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record book, if practicable. Such certificate shall be signed by the person in whose behalf it is filed, or by his agent, and the person so signing it shall make oath or affirm that all the statements therein contained are true, to the best of his knowledge and belief.

§ 4900. Every person who shall willfully swear or affirm falsely, in any such affirmation or affidavit, as to any matter therein required to be set forth, shall be guilty of perjury, and shall pay treble damages to every party injured thereby.

§ 4901. If the secretary of the state has reason to apprehend, on the filing of any such certificate, that the statements therein contained, or any of them, are untrue, he may decline to record the same, unless the party filing it shall obtain a writ of mandamus to compel such recording. Such

writ may be granted, but without costs to the secretary, by any proper court, on due proof that all the statements in such certificate are true, but no final hearing on the application therefor shall be had until such notice thereof as the said court may order has been advertised in one or more newspapers published in the county where the party filing said certificate resides. And any persons who desire may appear and intervene as parties defendant and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

§ 4902. Every person having the lawful right to make and file such a certificate and affidavit, upon the recording of the same in said office, shall be entitled to the exclusive use of the trade mark therein described for so long as he or his assigns shall continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right shall be assignable in writing; but all assignments thereof shall be good only against the assignor and his personal representatives until lodged for record in said office.

§ 4903. The secretary shall retain all such certificates on file, and cause the same and all assignments of trade-mark rights to be recorded at length in his office. Copies of the record of any such certificate, attested by him under the seal of the state, shall be *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trade mark therein described for the periods limited in § 4902.

§ 4904. Every person who shall reproduce, copy, counterfeit, or imitate any such recorded trade mark, knowing the same to have been recorded, and affix such reproduction, copy, counterfeit, or imitation to goods resembling or designed to resemble those to which such trade mark is so appropriated, shall pay to the owner of such trade mark double

damages, and also such sum, not more than five hundred dollars, as the court before which the action is brought may order to be added to the damages found by the verdict or judgment.

§ 4905. The provisions of this chapter shall not abridge any rights to any trade marks, existing on the twenty-second day of April, 1880, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trade marks.

§ 4906. Every person who fraudulently and with intent to deceive, affixes any trade mark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle, or package similar in descriptive properties to those to which such trade mark is appropriated; or who fraudulently and with intent to deceive places in any receptacle or package to which is lawfully affixed a recorded trade mark, goods other than those which said trade mark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trade mark fraudulently affixed as above described in this section, or any goods contained in any package or receptacle having a lawful trade mark, which are not such goods as said trade mark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

Labels of Trade Unions.*

§ 4907. Whenever any person, association or union of workingmen has adopted for his or its protection any label, trade-mark, or form of advertisement, announcing that goods

*While the title of this act refers only to labels and trade-marks of trades unions, the body of the act covers also labels and trade-marks of "persons."

to which such label, trade-mark, or form of advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade-mark, or form of advertisement. Every person violating any provision of this section shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both.

§ 4908. Every person who shall use any counterfeit or imitation of any label, trade-mark, or form of advertisement of any such person, union or association, knowing the same to be a counterfeit or an imitation, shall be guilty of a misdemeanor, and shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both.

§ 4909. Every such person, association, or union that has heretofore adopted, or shall adopt a label, trade-mark, or form of advertisement as aforesaid, may file the same for record in the office of the secretary of state by leaving two copies, counterparts, or fac-similes thereof, with the secretary of the state. Said secretary shall deliver to such person, association, or union so filing the same a duly attested certificate of the record of the same. Such certificate of record shall in all suits and prosecutions under §§ 4907, 4908, 4910, 4911, and 4912 be sufficient proof of the adoption of such label, trade-mark, or form of advertisement, and of the right of said person, association, or union to adopt the same. No label shall be recorded that would probably be mistaken for a label already of record.

§ 4910. Every such person, association, or union adopting a label, trade-mark, or form of advertisement, as aforesaid, may enjoin the manufacture, use, display or sale of any counterfeit or imitation thereof; and all courts having jurisdiction thereof shall grant injunctions to restrain such

manufacture, use, display, or sale, and shall award the complainant in such suit, such damages, resulting from such wrongful manufacture, use, display or sale, as may, by said court, be deemed just and reasonable, and require the defendants to pay to such person, association, or union the profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court or to the complainant to be destroyed.

§ 4911. Every person who shall use or display the genuine label, trade-mark, or form of advertisement of any such person, association, or union, in any manner not authorized by such person, union, or association, knowing that such use or display is not so authorized, shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both. In all cases where such association or union is not incorporated, suits under §§ 4907, 4908, 4910, 4912, and this section may be commenced and prosecuted by any officer or member of such association or union, in behalf of and for the use of such association or union.

§ 4912. Every person who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, and knowing that such use is unauthorized, shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both.

Approved May 25, 1893.

Sections 4913-4918, inclusive, protect manufacturers of soda and mineral waters, porter, beer, etc., in use of bottles, boxes, or siphons having his name or other marks or devices branded, stamped, etc., thereon, upon certain conditions.

DELAWARE.

CODE 1893, PAGE 552.

An act to protect associations and unions of workingmen and persons in their labels, trade marks and forms of advertising.

Section 1. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection, any label, trade mark or form of advertisement announcing that goods to which such label, trade mark or form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark, or form of advertisement. Every person violating this section shall, upon conviction, be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars ($100) or both.

Sec. 2. Every person who shall use any counterfeit or imitation of any label, trade mark, or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more [than] one hundred dollars ($100) or both.

Sec. 3. Every person, association or union, that has heretofore adopted, or shall hereafter adopt, a label, trade mark or form of advertisement as aforesaid, may file the same in the office of the secretary of state, by leaving two copies, counterparts or fac similes thereof with the secretary of state; said secretary shall deliver to such person, association or union so filing the same a duly attested certificate, for which he shall receive one dollar. Such certificate of filing shall

in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of such person, association or union to adopt the same. No label shall be received and filed by the secretary of state that probably would [be] mistaken for a label already filed.

Sec. 4. Every such person, association or union adopting a label, trade mark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display, or sale, and shall award the complainant in such suit such damages, resulting from such wrongful manufacture, use, display or sale as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession, or under the control, of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. Every person who shall use or display the genuine label, trade mark, or form of advertisement of any such person, association, or union in any manner not authorized by such person, union, or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any member or officer of such association or union on behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use

the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars, or both.

Sec. 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complainant shall so elect, and in case of conviction before such justice of the peace the offender shall stand committed to the county jail until the fine and costs are fully paid.

Sec. 8. This shall be deemed and taken to be a public act.

Passed at Dover, March 29, 1893.

Chapter 92, vol. 16, Laws of Delaware (Code 1893, p. 551), affords protection to manufacturers and vendors of mineral water, porter, ale, or other beverages against the unauthorized use of or injury to their bottles by other persons.

Chapter 226, p. 435, of the Laws of Delaware of 1898-1899, provides for the protection of any labor organization, association, or society having headquarters in Delaware, whether an independent body or branch of a national or international one, in the adoption, use, and record of a label or seal.

FLORIDA.

Rev. St. 1892.

2481. Whoever, knowingly and wilfully, forges or counterfeits or causes or procures to be forged or counterfeited upon any goods, wares or merchandise, the private label, stamps or trade marks of any mechanic or manufacturer, knowing the same to be forged or counterfeited, without disclosing the fact to the purchaser, shall be punished by imprisonment not exceeding twelve months, or by fine not exceeding one hundred dollars.

2482. Whoever vends any goods, wares or merchandise,

having thereon a forged or counterfeit stamp, label, or trade mark of any mechanic or manufacturer, knowing the same to be forged or counterfeited, without disclosing the fact to the purchaser, shall be punished by imprisonment not exceeding six months, or by fine not exceeding fifty dollars.

Acts 1897, Ch. 4584 (No. 70).

An act to protect the owners of bottles, boxes, siphons, fountains, tins or kegs used in the sale of soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages, or medicines, medical preparations, perfumery, oils, compounds or mixtures.

Section 1. Any and all persons and corporations engaged in manufacturing bottling or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicines, medical preparations, perfumery, oils, compounds or mixtures, in bottles, siphons, fountains, tins or kegs, with his, her, its or their name or names, or other marks or devices branded, stamped, engraved, etched, blown, impressed or otherwise produced upon such bottles, siphons, fountains, tins or kegs, or the boxes used by him, her, it or them, may file in the office of the clerk of the county in which his, her, its or their principal place of business is situated, or if such person, persons, corporation or corporations shall manufacture or bottle out of this state then in any county in this state, and also in the office of the secretary of state, a description of the name or names, marks or devices so used by him, her, it or them, respectively, and cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed as aforesaid.

Sec. 2. It is hereby declared to be unlawful for any per-

son or persons, corporation or corporations, to fill with soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or with medicine, medical preparations, perfumery, oils, compounds or mixtures, any bottle, box, siphon, fountain, tin or keg, so marked or distinguished as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section 1 of this act, or to deface, erase, obliterate, cover up or otherwise remove or conceal any such name, mark or device thereon, or to sell, buy, give, take or otherwise dispose of, or wantonly destroy, or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or persons, corporation or corporations, whose mark or device shall be or shall have been in or upon the bottle, box, siphon, fountain, tin or keg so filled, trafficked in, used or handled as aforesaid. Any person or persons or corporation or corporations, offending against the provisions of this section shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment not less than ten days nor more than one year, or by a fine of fifty cents for each and every such bottle, box, siphon, fountain, tin or keg so filled, sold, used, disposed of, bought or wantonly destroyed, or trafficked in, or by both such fine and imprisonment, and for each subsequent offense by imprisonment not less than twenty days nor more than one year, or by a fine of not less than one dollar nor more than five dollars for each and every bottle, box, siphon, fountain, tin or keg so filled, sold, used, disposed of, bought or wantonly destroyed, or trafficked in, or by both such fine and imprisonment, in the discretion of the court before whom the offense shall be tried.

SEC. 3. The use by any other person than the person or persons, corporation or corporations, whose device, name or mark shall be or shall have been upon the same without such

written consent or purchase as aforesaid, of any such marked or distinguished bottle, box, siphon, fountain, tin or keg, a description of the name, mark or device, whereon shall have been filed and published, as herein provided, for the sale therein of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer, or other beverages, or any article of merchandise, medicines, medical preparations, perfumery, oils, compounds, mixtures or preparations, or for the furnishing of such or similar beverages to customer, or the buying, selling, using, disposing of or trafficking in any such bottles, boxes, siphons, fountains, tins or kegs by any person other than said persons or corporations having a name, mark or device thereon of such owner without such written consent, or the having by any junk dealer or dealers in second-hand articles possession of any such bottles, boxes, siphons, fountains, tins or kegs, a description of the marks, names or devices whereon shall have been so filed and published as aforesaid, without such written consent, shall, and is hereby declared to be presumptive evidence of the said unlawful use, purchase and traffic in of such bottles, boxes, siphons, fountains, tins or kegs.

Sec. 4. Whenever any person, persons or corporation mentioned in section 1 of this act, or his, her, its or their agent shall make oath before any justice of the peace in the district where the offense is committed that he, she, or it has reason to believe, and does believe, that any of his, her, its or their bottles, boxes, siphons, fountains, tins or kegs, a description of the names, marks or devices whereon has been so filed and published as aforesaid, are being unlawfully used or filled or had by any person or corporation manufacturing or selling soda, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicine, medical preparations, perfumery, oils, compounds or mixtures, or that any junk dealer or

dealer in second-hand articles, vendor of bottles, or other person or corporation has any such bottles, boxes, siphons, fountains, tins or kegs in his, her or its possession or secreted in any place, the said justice of the peace must thereupon issue a search warrant to discover and obtain the same, and shall also cause to be brought before him the person in whose possession such bottles, boxes, siphons, fountains, tins or kegs may be found, and shall then inquire into the circumstances of such possession, and if such justice of the peace, upon trial and conviction had, finds that such person has been guilty of a violation of section 2 of this act, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof; provided, that in any counties where criminal courts of record exist the said justice of the peace shall act only as a committing magistrate as in other cases in so far as trying the offender and imposing the said punishment are concerned.

Sec. 5. The requiring, taking or accepting of any deposit, for any purpose, upon any bottle, box, siphon, fountain, tin or keg shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this act.

Sec. 6. All laws and parts of laws inconsistent herewith are, for the purpose of this act, hereby repealed.

Sec. 7. This act shall take effect immediately upon its passage and approval by the governor.

Approved June 5, 1897.

Acts 1901, Ch. 4974 [No.] 90.

An act to authorize any person, association, or union of workingmen to adopt and use a label or trade-mark, to protect the same by law, to provide for its record, to prevent counterfeiting the same, or using the original or any package containing the same; and to prevent using

the name or seal thereof without authority, and fixing penalties for violations thereof.

Be it enacted by the legislature of the state of Florida:

Section 1. Whenever any person or any association of workingmen has heretofore adopted or used, or shall hereafter adopt or use, and has filed as hereinafter provided, any label, trade-mark, term, wording, design, device, color or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed, or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade-mark, term, wording, design, device, color or form of advertisement, or knowingly to use, sell, or offer for sale, or in any other way utter or circulate any counterfeit or imitation of any such label, trade-mark, term, wording, design, device, color or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade-mark, term, wording, design, device, color or form of advertisement, or knowingly sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trade-mark, term, wording, design, device, color or form of advertisement; or knowingly purchases and keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed: or knowingly purchases with intent to sell or dispose of any goods, wares, merchandise or other product of labor contained in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, stamped or impressed; or having knowingly purchased, keeps

or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than five hundred dollars, or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade-mark, term, wording, design, device, color or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade-mark, term, wording, design, device, color or form of advertisement shall be filed, the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trade-mark, term, wording, design, device, color or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union or corporation has the right to (such) use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of two dollars. Said secretary shall deliver to such person, association, or union so filing or causing to be filed any such label, trade-mark, term, wording, design, device, color or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which the secretary shall receive a fee of one dollar. Any such

certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade-mark, term, wording, design, device, color or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade-mark, term, wording, design, device, color or form of advertisement that would probably be mistaken for any label, trade-mark, term, wording, design, device, color or form of advertisement heretofore filed by or on behalf of any other person, union or association.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade-mark, term, wording, design, device, color or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars, or by imprisonment not exceeding three months.

Sec. 5. Every such person, association or union adopting or using a label, trade-mark, term, wording, design, device, color or form of advertisement or aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit damages resulting from any such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display or sale:

and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainants, to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trade-mark, term, wording, design, device, color or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. Any person using the trade-mark so adopted and used by any other person, or any imitation of such trade-mark or any counterfeit thereof; or who shall in any manner mutilate, deface, destroy or remove such trade-mark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second-hand package, which has contained the same or been used therefor, with the intention of using such empty or second-hand package, or of the same being used to contain goods, wares, merchandise, article or articles of the same general character as those for which they were first

used; and any person who shall use any such empty or second-hand package for the purpose aforesaid, without the consent in writing of the person whose trade-mark was first applied thereto or placed thereon, shall, upon conviction thereof, be fined in any sum not less than five hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles contained in such second-hand package or packages shall be forfeited to the original user of such package or packages whose trade-mark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular article or package shall be held to be a separate offense.

Sec. 9. The word "person" in this act shall be construed to include a person, copartnership, corporation, association or union of workingmen.

Sec. 10. This act shall take effect immediately upon its passage and approval by the governor.

Approved May 29, 1901.

GEORGIA.

Code 1895, Vol. 1.

Section 1736. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection, any label, trade mark, or form of advertisement announcing that goods to which such label, trade mark, and forms or advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark, or form of advertisement with intent to use the same for the purpose of deceiving the public in the sale of the goods.

Sec. 1737. Every person who shall use any counterfeit or imitation of any label, trade mark, or form of advertisement of any such person, union, or association, knowing the same

to be counterfeit or imitation, shall be guilty of a misdemeanor.

Sec. 1738. Every person, association, or union of workingmen that has adopted or shall hereafter adopt a label, trade mark, or form of advertisement, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with the secretary of state. Said secretary shall deliver to such person, association, or union, a duly attested certificate of the record of the same, for which he shall receive the fee of one dollar; such certificate of record shall, in all suits under this chapter, be sufficient proof of the adoption of such label, trade mark, or form of advertisement, and of the right of said person, association, or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

Sec. 1739. Every such person, association, or union adopting a label, trade mark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunction to restrain such manufacture, use, display or sale, and shall award the complainant in such suits such damages resulting from such wrongful manufacture, use, display, or sale as may by said courts be deemed just and reasonable, and shall require the defendant to pay such person, association, or union the profit derived from such wrongful manufacture, use, display, or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 1740. In all cases where such associations or unions are not incorporated, suits may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 1741. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, knowing that such use is unauthorized, with the intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor.

Code 1895, Vol. 2.

Section 4035. Any attempt to encroach upon the business of a trader, or other person, by the use of similar trade marks, names or devices, with the intention of deceiving and misleading the public, is a fraud for which equity grants relief.

Supplement to the Code of Georgia, 1901 (Vol. 4 of Code.)

§ 6676. Whenever any person, firm, corporation or association shall adopt and use in their business, for their protection, any label, trade mark, trade name or form of advertisement, it shall be unlawful for any person, firm, corporation or association to counterfeit or imitate such label, trade mark, trade name or form of advertisement, with intent to use the same for the purpose of deceiving the public in the sale of goods. Every person violating this section shall be guilty of a misdemeanor and punished therefor.

§ 6677. Every person, firm, corporation or association who shall use any counterfeit or imitation of any label, trade mark, trade name or form of advertisement of any person, firm, corporation or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor and punished therefor.

§ 6678. Every person, firm, corporation or association who shall use or display the genuine label, trade mark, trade name or form of advertisement of any person, firm, corporation or association, in any manner not authorized by law, such per-

son, firm, corporation or association, knowing that such use is not authorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and be punished therefor.

§ 6679. Any firm, person, corporation or association who shall use the name or seal of any other person, firm, corporation or association, in and about the sale of goods or otherwise, not being authorized to use the same, knowing that such use is unauthorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and punished therefor.

§ 6680. Any person, firm, corporation or association that shall be found guilty of violating the provisions of this act, or any of them as aforesaid, shall be punished as prescribed in section 1039 of the Penal Code.

By section 1039, vol. 3, Code 1895, the punishment for a misdemeanor is a fine not exceeding $1,000, or imprisonment not exceeding six months, or work in the chain gang not exceeding twelve months, either or all, at the discretion of the judge.

The provisions of sections 252 to 255 of volume 3 of the Code of 1895 appear to be substantially included in the sections and act above quoted, and are therefore not reproduced. Sections 2 and 4 of the act of 1898 are very similar to sections 1737 and 1741 of volume 1 of the Code of 1895, above quoted.

IDAHO.

Political Code of 1901.

Sec. 635. Whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement, for the purpose of designating, making known or distinguishing any goods, wares, merchandise, or other products of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, or association, or union of workingmen, or by a mem-

ber or members of such association, or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 636. Every such person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section 635, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or fac similes thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade mark, term,

design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association; and any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this subdivision, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction.

Sec. 637. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture and may award the complainant in any such damage resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such persons, association, or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed; and in all cases where such association or union is not incorporated, suits may be commenced and prosecuted by an officer or members of such association or union, on behalf of, and for the use of such association or union.

PENAL CODE OF 1901.

SEC. 4950. Whoever counterfeits or imitates any label, trade mark, term, design, device or form of advertisement, described in section 635 of the Political Code, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be guilty of a misdemeanor and be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

SEC. 4951. The phrases "forged trade mark" and "counterfeit trade marks," or their equivalents, as used in this chapter, includes every alteration or imitation of any trade mark so resembling the original as to be likely to deceive.

SEC. 4952. The phrase "trade mark," as used in section 4950, 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, to denote any goods to be goods im-

ported, manufactured, produced, compounded, or sold by him other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Section 4999. Any person who shall for himself or on behalf of any other person, association, or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state, by making any false or fraudulent representations or declarations, verbally, or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by, or on behalf of, the party injured thereby in any court having jurisdiction, and shall be guilty of a misdemeanor and be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months.

Section 5000. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union, in any manner not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months, or by fine of not more than one hundred dollars.

Section 5001. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sections 6862, 6863, Rev. St. 1887, make the counterfeiting or forgery of trade marks, or the sale of goods with counterfeit trade marks thereon, a misdemeanor. Sections 6864 and 6865 give definitions of the phrases "trade mark," "forged trade mark," and "counterfeited trade mark," as used in the chapter.

ILLINOIS.

STARR & C. ST. 1896, VOL. 3, PAGES 3955-3957.

An act to protect associations, unions of workingmen and persons in their labels, trade marks and forms of advertising.

Par. 6, § 1. Whenever any person or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Par. 7, § 2. Whoever counterfeits or imitates any such label, trade-mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters, or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement, or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells, or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or keeps or has in his possession with intent

that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not less than one hundred (100) dollars, nor more than two hundred (200) dollars, or by imprisonment for not less than three (3) months nor more than one (1) year, or by both such fine and imprisonment.

Par. 8, § 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section one (1) of this act, shall file the same for record in the office of the secretary of state, by leaving two (2) copies, counterparts or *fac similes* thereof with said secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trade mark, term, design, device or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writ-

ing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding two hundred (200) dollars or by imprisonment not exceeding one (1) year or both such fine and imprisonment. The secretary of state shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one (1) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

Par. 9, § 4. Every such person, association or union adopting a label, trade mark, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations; and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages, resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant to be destroyed.

Par. 10, § 5. Every person who shall use or display the genuine label, trade mark, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Par. 11, § 6. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both.

Jones & Addington's Supplement 1902 (Vol. 4, Starr & C. St.)

Paragraph 1, § 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complaining shall so elect, and in case of conviction before such justice of the peace the offender shall stand committed to the county jail until the fine and costs are fully paid, under the provisions of section 8, article IX, of an act to revise the law in regard to criminal jurisprudence, in force July 1, 1874, or otherwise. The first process under this section in all prosecutions for the recovery only of the fines, shall be a summons: provided, however, that a warrant for the arrest of the offender, as in other cases when justices of the peace have

original criminal jurisdiction, may issue upon the affidavit of any person that any of the provisions of this act have been violated, and that the person making the complaint has just and reasonable grounds to believe the party charged is guilty thereof. [Section as amended by act approved April 22, 1899. See vol. 3, p. 3957, paragraph 12.]

The act approved May 2, 1873 (paragraphs 1-5, inclusive, chapter 140, Starr & C. St. 1896), provides for the protection of manufacturers, bottlers, and sellers of ale, porter, beer, mineral water, and other beverages against the unauthorized use or willful destruction of their bottles, boxes, casks, kegs, etc., by other persons.

See, also, an act to prevent and punish the unlawful buying, selling, keeping for sale, using, filling or trafficking, in cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, cartons, tanks, fountains, vessels or containers; to provide for the registration of the names, brands, designs, trade-marks, devices, and other marks of ownership in connection with such articles, and to protect the owners thereof. Approved May 11, 1901. In force July 9, 1901. Laws 1901, p. 316; Jones & Addington's Supplement 1902 (vol. 4, Starr & C. St.), c. 140, pars. 2-7, pp. 1261-1264, inclusive.

INDIANA.

BURNS' ANNOTATED INDIANA STATUTES, REVISION OF 1901.

8681. That any firm, person, corporation or voluntary association that are citizens of the state of Indiana, except foreign corporations, and who are entitled to the exclusive use of any lawful trade mark, label, brand, stamp or wrapper, may obtain protection for such lawful trade mark, label, brand, stamp or wrapper by complying with the following requirements: First, by causing to be filed with the secretary of state a statement specifying the names of the parties, and the residences and places of business, who desire the protection of the trade mark, label, brand, stamp or wrapper, the class of merchandise and the particular description of goods comprised in such class, by which the trade mark, label, brand, stamp or wrapper has been, or is intended to be pro-

tected. A description of trade mark, label, brand, stamp or wrapper, with *fac simile* thereof, showing the mode in which it has been and is intended to be applied and used, and the length of time, if any, during which the trade mark, label, brand, stamp or wrapper has been in use. Second, by making a payment of a fee of two dollars to the secretary of state, whose duty it will be to file and record said statement in a book kept for the purpose to be procured by him as other books in his office of like nature are procured.

8682. Any certificate or statement prescribed in the preceding 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 some member of the firm or officer of the corporation or voluntary association by whom it is filed, to the effect that the party claiming the protection for the trade mark, label, brand, stamp or wrapper, has a right to the same and that no other person, firm, corporation or voluntary association has the right to such use either in the identical form or in any such near resemblance as might be calculated to deceive; and that the description and *fac simile* presented for record are true copies of the trade mark, label, brand, stamp or wrapper sought to be protected.

8683. The time of the receipt of any trade marks, label, brand, stamp or wrapper at the office of the secretary of state for registration shall be noted and recorded. Certified copies of the trade mark, label, brand, stamp or wrapper, and the date of the receipt thereof, and of the statement and affidavit filed therewith shall be *prima facie* evidence of the facts and statements and affidavit record in any suit in which such trade mark, label, brand, stamp or wrapper shall be brought into controversy.

8684. A trade mark, label, brand, stamp or wrapper shall remain in force so long as it is used continuously: after a disuse of six months, it shall be deemed out of existence. Such

trade mark, label, brand, stamp or wrapper may be sold or assigned, or pass to personal representatives by will, or become assets of an estate. In any case where ownership changes of such trade mark, label, brand, stamp or wrapper, before it can be used by the successor in title, a statement of such change of ownership shall be filed with the secretary of state, and he shall record the same in the book kept for the purpose of recording trade marks, labels, brands, stamps and wrappers, and such secretary shall receive two dollars for recording such statement; and it shall be unlawful to use such trade mark, label, brand, stamp or wrapper till such change of ownership has been filed as aforesaid.

8685. Such trade mark, label, brand, stamp or wrapper shall entitle the person, firm, corporation, or voluntary association registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person, firm, corporation or voluntary association can lawfully use the same trade mark, label, brand, stamp or wrapper, or substantially the same, or so nearly resembling it as to be calculated to deceive upon substantially the same description of goods.

8686. For a violation of any rights created by this act, the person, firm, corporation or voluntary association aggrieved, shall have all common law remedies and actions for damages, and shall be entitled to an injunction to prevent further use of any trade mark, label, brand, stamp or wrapper by this act secured to the injured person, firm, corporation, or voluntary association; and, if an injunction is made final and perpetual, the injured person, firm, corporation or voluntary association shall recover reasonable attorney's fees.

8687. Any owner of a trade mark, label, brand, stamp or wrapper, who has complied with the provisions of this act, shall have the right to grant to others the authority to use

such trade mark, label, brand, stamp or wrapper; but such authority to so use must be in writing, signed by the owner of such trade mark, label, brand, stamp or wrapper, with two witnesses to such signature, and no one but the owner shall have the right to use such trade mark, label, brand, stamp or wrapper, unless such written authority has been given.

S688. If it becomes necessary for any voluntary association to assert any right to any trade mark, label, brand, stamp or wrapper, it shall be sufficient to use the name of president or chief officer of such association either in action at law, suit in equity, or indictment for the violation of the provisions of this act.

S689. This act shall not be construed to lessen, impair or abridge any rights or remedies that have heretofore existed in favor of any one owning or rightfully claiming a trade mark, label, brand, stamp or wrapper.

S690. That any person or persons, who shall knowingly or willfully cast or 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 substances, molds or any false representations, likeness, copy or colorable imitation of any die, plate, brand or mold of any private trade mark, label, brand, stamp, wrapper, engraving on paper or other substance, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for not less than one year, or more than two years, or be fined in a sum not less than one thousand dollars, or more than two thousand dollars.

S691. That any person or persons [who shall] knowingly and willfully make, forge or counterfeit, or have in his, her or their possession, or buy, sell, offer for sale or deal in any representation, likeness, similitude, copy or colorable imitation of any private label, brand, stamp, wrapper, engrav-

ing, mold or trade mark, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for a period of years not more than two nor less than one, or be fined in any sum not less than one thousand dollars nor more than two thousand dollars.

8692. It shall be unlawful for any person, firm, corporation or voluntary association doing business in this state to have in his or its possession, or to sell, or offer for sale or trade, any goods, wares, merchandise or other article upon which he or it knows is placed or affixed a false, forged or spurious trade mark, label, brand, stamp, or wrapper in likeness or imitation of some trade mark, label, brand, stamp, or wrapper registered as provided for in this act; and any such person, firm, corporation or voluntary association so having in his or its possession or selling, or offering for sale or trade, any goods, wares or merchandise upon which he or it knows is placed or affixed a false, forged or spurious trade mark, label, brand, stamp or wrapper in likeness or imitation of some trade mark, label, brand, stamp or wrapper registered as aforesaid shall, upon conviction thereof, be punished by fine in a sum of not less than fifty dollars ($50.00) nor more than two hundred dollars ($200.00), or imprisoned in the county jail six months, or both.

Sections 8678-8680c, inclusive, are designed to protect manufacturers, bottlers, and sellers of mineral water, cider, ale, beer, ginger pop, soda water, distilled water, ginger ale, seltzer water, fermented liquors, and other beverages against the unauthorized use of or injury to their bottles or syphons by other parties.

Sections 8693-8703, inclusive, protect labor unions and associations in the use of their labels, names, stamps, etc.

IOWA.

Code 1897, Ch. 13, Tit. 24.

Section 5049. Every person or association or union of

working men or others that has adopted or shall adopt for their protection any label, trade mark or form of advertisement, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof with the secretary of state. Said secretary shall thereupon deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all actions and prosecutions under the following six sections be sufficient proof of the adoption of such label, trade mark or form of advertisement, and the right of said person, association or union to adopt the same.

Sec. 5050. Every person, association or union adopting a label, trade mark or form of advertisement, as specified in the preceding section, may proceed by action to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof; and all courts having jurisdiction of such actions shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant therein such damages resulting from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and shall require the defendant to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court to be destroyed. Such actions may be prosecuted for the benefit of any association or union by any officer or member thereof.

Sec. 5051. It shall be unlawful for any person or corporation to imitate any label, trade mark or form of advertisement adopted as provided in the second preceding section, or

to knowingly use any counterfeit or imitation thereof, or to use or display such genuine label. trade mark or form of advertisement, or the name or seal of such person, union or association, or of any officer thereof, unless authorized so to do, or in any manner not authorized by him or it. Any person violating any provision of this section shall be imprisoned in the county jail not more than thirty days, or be fined not less than twenty-five nor more than one hundred dollars.

Sec. 5052, Supplement (to Code) 1902, protects persons engaged in manufacturing, bottling, or selling soda water or other beverages against the unauthorized use of their bottles, barrels, kegs, etc.

KANSAS.

General Statutes 1901.

§ 7850. If any person or persons shall willfully change, alter, deface, destroy, counterfeit, cut out or dispose of any trade mark, brand, impression or device used by a person, company or corporation within this state, to designate a particular description of goods, wares, merchandise, cask, barrel, half-barrel, keg, bottle, package, or the contents thereof, he or they shall forfeit and pay to the owner or owners thereof, for each offense, not exceeding the sum of twenty-five dollars, to be recovered in any court proper to try the same, or before a justice of the peace having jurisdiction of the same.

§ 7851. If any person shall change, shift and place any brand, mark or device, used or intended to be used for the purpose aforesaid, to or upon any piece of goods, wares, merchandise, cask, barrel, half-barrel, keg, bottle or package, or shall intermix, take out, change or shift any article, liquid or commodity whatever, into a branded cask, barrel, half-barrel, keg, bottle or package, and thereby avail him or themselves of another person or persons' brand, mark, or device, he or

they shall forfeit for every such offense the sum of twenty-five dollars, to be recovered as aforesaid.

Sections 7852-7857, inclusive, protects labor unions in the use of their labels and trade marks.

KENTUCKY.

Chapter 130. Gen. St. 1899, protects labor unions and associations in the use of their labels, marks, brands, etc.

Sections 1279 and 1279a, Gen. St. 1899, protect manufacturers, bottlers, and sellers of soda water and other beverages, medicines, medical preparations, perfumery, oils, compounds, or mixtures in bottles, siphons, tins or kegs against the unauthorized use of or injury to their bottles, siphons, tins, kegs, etc., by other parties.

No general trade-mark law.

LOUISIANA.

Acts 1898, No. 49.

An act to protect labels, trade marks, terms, designs, devices or forms of advertisement, and to provide a penalty for violation thereof.

Section 1. Whenever any person, or any association or union of workmen, has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label,

trade mark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other products of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association,

union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement heretofore filed by or on behalf of any other person, union or association.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design, device or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damage sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

Sec. 5. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of

advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

SEC. 6. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

SEC. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

SEC. 8. This act shall take effect and be in force from and after its passage.

Approved July 8, 1898.

Act 120 of 1896 (Wolff's Rev. Laws, p. 204) affords protection to manufacturers, bottlers, and sellers of seltzer and mineral waters against the unauthorized use of or injury to their bottles and siphons by other parties.

MAINE.

Extract from Chapter 39, Rev. St. 1883.

Section 37. Any person entitled to the exclusive use of any trade mark, or who intends to adopt and use any trade mark not previously adopted or used by another, may file for record in the office of the secretary of state a certificate setting forth his name, residence and place of business; the class of merchandise and the particular description of goods comprised in such class to which such trade mark has been or is to be appropriated; a description thereof, and of the mode in which it is to be applied and used; the date when it was first used or adopted; that he has a right to the use of it; and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as is calculated to deceive. A *fac simile* of such trade mark shall be incorporated in or annexed to said certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record book, if practicable. Such certificate shall be signed and sworn to by such person, or his agent.

Sec. 38. Whoever willfully swears or affirms falsely to any such certificate, is guilty of perjury, and shall pay treble damages to every party injured thereby. If the secretary of state has reason to apprehend, on the filing of such certificate, that any statement therein contained is untrue, he may decline to record the same, unless the party filing it obtains a writ of mandamus to compel him. Such writ may be granted, but without costs to the secretary, by any proper court, on proof that all the statements in such certificate are true, but no

final hearing on the application therefor, shall be had until such notice thereof as said court orders has been advertised in one or more newspapers published in the county where the party filing said certificate resides; and any persons who desire may appear and intervene as parties defendant, and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

Sec. 39. Every party entitled to make and file such certificate and affidavit, upon recording the same in said office, becomes entitled to the exclusive use of the trade mark therein described, so long as he or his assigns continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right is assignable in writing; but all assignments thereof are good only against the assignor and his personal representatives, until lodged for record in said office.

Sec. 40. The secretary of state shall retain all such certificates on file, and cause the same and all assignments of trade mark rights to be recorded at length in his office, and is entitled to a fee of three dollars for each certificate, and one dollar for each assignment so filed and recorded. Copies of the record of any such certificate, attested by him under the seal of the state, are *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trade mark therein described for the periods limited in the preceding section.

Sec. 41. Whoever reproduces, copies, counterfeits, or imitates any such recorded trade mark, knowing the same to have been recorded, and affixes such reproduction, copy, counterfeit, or imitation to goods resembling or designed to resemble those to which such trade mark is so appropriated, shall pay to the owner of such trade mark double damages, besides such sum, not exceeding five hundred dollars, as the court before

which the action is brought orders to be added to the damages found by the verdict or judgment.

Sec. 42. Whoever fraudulently and with intent to deceive, affixes any trade mark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle or package similar in descriptive properties to those to which such trade mark is appropriated, or who fraudulently and with intent to deceive, places in any receptacle or package to which is lawfully affixed a recorded trade mark, goods other than those which said trade mark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trade mark fraudulently affixed as above described, or any goods contained in any package or receptacle having a lawful trade mark, but not being such goods as said trade mark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

Sec. 43. This chapter does not abridge rights to any existing trade marks, whether the same are hereafter recorded or not, nor any remedies or rights of action otherwise or heretofore existing in favor of owners of trade marks.

Laws 1893, Ch. 276.

An act to protect persons, associations and unions of workingmen and others in their labels, trade marks, devices and forms of advertising.

Section 1. Whenever any person, or any association, or union of workingmen has adopted and used, or shall hereafter adopt and use any label, trade mark, device, or form of advertisement to indicate that goods to which such label, trade mark, device or form of advertisement, shall be attached or affixed, or on which the same shall be printed, painted, stamped or impressed, were manufactured or produced, pack-

ed or put on sale by such person or by such association or union, or by a member or members thereof, which was not, before such adoption and use, lawfully adopted, owned and used by another as a label, trade mark, device or form of advertisement, from whom no right or authority to use and adopt the same had been acquired by such person, or by such association or union, or by such member or members thereof, nor a counterfeit, imitation or semblance thereof, it shall be unlawful to counterfeit or imitate such label, trade mark, device or form of advertisement, or use the same without the consent or authority of the person, association or union so having adopted and used it.

Sec. 2. Whoever knowingly, and with intent to mislead or deceive, counterfeits or imitates any such label, trade mark, device or form of advertisement, or knowingly uses or sells any such counterfeit or imitation of any such label, trade mark, device or form of advertisement, or knowingly sells or disposes of, or keeps, or has in his possession with intent that the same shall be sold, any goods to which any such counterfeit or imitation of such label, trade mark, device or form of advertisement is attached or affixed, or on which the same is printed, painted, stamped or impressed, shall, for the first offense be punished by fine not exceeding one hundred dollars, or by imprisonment for less than one year, and for the second and every subsequent offense, he shall be punished by fine not less than one hundred, nor more than five hundred dollars, or by imprisonment not less than sixty days, nor more than three years.

Sec. 3. Every such person, association or union that has heretofore adopted or shall hereafter adopt, a label, trade mark, device or form of advertisement as aforesaid shall file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state, together with a statement, in writing,

signed and sworn to by such person or by some person for and in behalf of such association or union, stating when and by whom so far as he knows and believes, said label, trade mark, device or form of advertisement was adopted or used, in what manner and for what purpose the same is to be used and by what right he claims the same, and such other particulars as shall serve to identify the same, said secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of two dollars. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, device, or form of advertisement. No label, trade mark, device or form of advertisement shall be recorded that so nearly resembles one already recorded as to be liable to be mistaken for such label, trade mark, device or form of advertisement and when in the judgment of the secretary of state, such resemblance exists he shall refuse to record such label, trade mark, device or form of advertisement.

Sec. 4. Every such person, association or union that has adopted and uses a label, trade mark, device or form of advertisement, as aforesaid, and which has been recorded in the office of the secretary of state as hereinbefore provided, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations, or of any goods to which such counterfeits or imitations shall be affixed or attached, or on which the same shall be printed, painted or impressed, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages resulting from such wrongful manufacture, use, display or sale as may by said court be deemed reasonable, and shall require the defendants to pay such person, association or union the profits derived from such wrongful manufacture,

use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case, be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. Every person who shall willfully use or display the genuine label, trade mark, device, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not more than six months, or by a fine not exceeding one hundred dollars, or both; and upon conviction for a second offense, shall be punished by imprisonment not less than thirty days nor more than one year, or by a fine not less than fifty nor more than three hundred dollars, or both.

Sec. 6. Any person or persons who shall in any way willfully use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not more than six months, or by a fine not exceeding one hundred dollars, or both; and upon conviction for a second offense shall be punished by imprisonment not less than thirty days nor more than one year, or by a fine not less than fifty nor more than three hundred dollars, or both.

Sec. 7. In all cases where the association or union mentioned in this act is not incorporated, suits and proceedings under this act may be commenced and prosecuted by an officer or member of such association or union, for and in behalf of and for the benefit of such association or union.

Approved March 28, 1893.

Sections 35-36, c. 39, Revised Statutes of 1883, as amended and another section added thereto by chapter 125, Gen. Laws 1891, afford protection to persons and corporations engaged in the man-

ufacture or sale of mineral water, soda water, ginger ale, and other similar beverages in the use of their bottles, and provide penalties for the unauthorized use of, or the defacement of names and marks upon, such bottles by other parties.

MARYLAND.

Acts 1892, Ch. 357.

An act to protect associations and unions of workingmen and persons in their labels, trade marks and forms of advertising and to punish offenders for a violation of the same.

Section 1. That whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection any label, trade mark or form of advertisement announcing and denoting that goods to which such label, trade mark or form of advertisement shall or may be attached, were manufactured by such person or by a member or members of such association or union, it shall not be lawful for any person or corporation to counterfeit or imitate such label, trade mark or form of advertisement. Every person violating this section shall be deemed guilty of a misdemeanor, and shall, upon conviction by any court having criminal jurisdiction, be punished by imprisonment in the city or county jail for not less than three months nor more than one year or by a fine of not less than one hundred dollars nor more than five hundred dollars, or both, in the discretion of the court.

Sec. 2. That every person, corporation or association who shall use any counterfeit or imitation of any label, trade mark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation shall be guilty of a misdemeanor and shall, on conviction by any court having criminal jurisdiction, be punished by imprisonment in the city or county jail for a term of not less

than one month nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both, in the discretion of the court, and the burden of proving that the defendant did not know the true character of the said label, trade mark or form of advertisement, and that he used the same in good faith shall be on the defendant.

Sec. 3. That every such person, association or union that has heretofore adopted, or shall hereafter adopt, a label, trade mark or form of advertisement as aforesaid, may file the same for record, in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state and said secretary shall deliver to such person, association or union so filing the same duly attested certificate of the record of the same for which he shall receive a fee of one dollar; such certificate of record shall be in all suits and prosecutions under this act sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of said person, association or union to adopt the same; no label shall be recorded that probably would be mistaken for a label already of record, of which question the said secretary shall be the judge.

Sec. 4. That every such person, association or union adopting a label, trade mark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeit, or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit such damage resulting from such wrongful manufacture, use, display or sale as may by said court be deemed just and reasonable, according to the evidence in the case, and shall require the defendants to pay such persons, associations, or unions the profits derived from such wrongful manufacture, use, display or sale, and in addi-

tion to court costs, such reasonable attorneys' fees as the court may allow, and said court shall also order that all such counterfeit or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. That every person who shall use or display the genuine label, trade mark or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall on conviction be punished by imprisonment in the city or county jail not less than one month nor more than one year, or by a fine of not less than fifty dollars or more than two hundred dollars, or both, in the discretion of the court.

Sec. 6. That any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable on conviction by imprisonment in the city or county jail for a term of not less than three months or more than one year, or by a fine of not less than fifty dollars nor more than three hundred dollars, or both, in the discretion of the court.

Sec. 7. That all the acts and parts of acts inconsistent with this act are hereby repealed.

Sec. 8. That this act shall take effect from the date of its passage.

Approved April 4, 1892.

Sections 201 to 206, inclusive, of article 27 of the Public General Laws, as amended by chapter 262 of the Acts of 1892, afford protection to manufacturers, bottlers, and dealers in mineral water and other beverages against the unauthorized use, refilling, or sale of their bottles, jugs, kegs, etc., by other persons.

MASSACHUSETTS.

REVISED LAWS (IN FORCE JANUARY 1, 1902), CHAPTER 72.

Definitions.

Section 1. The following words shall, in addition to their ordinary meaning, have the meaning herein given:

The word "name" or "names" in sections two, three, six, ten, twelve, fourteen, fifteen, sixteen, eighteen, nineteen and twenty-one of this chapter includes "letters," "marks," "devices" and "figures."

The word "person" or "persons" in sections two, seven, nine, fourteen to twenty, inclusive, and twenty-three, includes "firm," "association," "union" and "corporation."

The word "boots" in section four includes "half boots," "shoes," "pumps," "sandals," "slippers" and "overshoes."

The word "label" or "labels" in sections six to twelve, inclusive, includes "trade mark" "stamp" or "form of advertisement."

The word "beverage" or "beverages" in sections fifteen to eighteen, inclusive, includes also "milk," "cream," "soda water," "mineral" or "aerated waters," "ale," "beer," "ginger ale" or "similar beverages."

The word "vessel" or "vessels" in sections fifteen to eighteen, inclusive, includes "cans," "bottles," "siphons," "fountains" and "boxes."

The word "can" or "cans" in sections nineteen to twenty-three, inclusive, includes "jugs," "bottles" and "jars."

Labels and Trade Marks.

Section 2. When a person uses any peculiar name upon or connected with an article manufactured or sold by him to designate it as an article of a peculiar kind or quality, or as manufactured by him, no other person shall without his

consent use the same or any similar name for the purpose of falsely representing an article to have been manufactured by or to be of the same kind or quality as those manufactured or sold by the person rightfully using such name.

Section 3. Whoever violates the provisions of the preceding section, and whoever knowingly sells or exposes for sale an article having a name upon or connected with it in violation of the provisions of the preceding section, shall be liable in an action of tort to any party aggrieved thereby for all damages actually incurred.

Section 4. Every manufacturer of leather or boots shall have the exclusive right of stamping the articles manufactured by him with his name and the name of the place of manufacture; and such stamping shall be considered as a warranty that the article stamped is merchantable, made of good materials and well manufactured; and such article shall not be considered merchantable unless so stamped.

Section 5. A person who carries on business in this commonwealth shall not assume or continue to use in his business the name of a person formerly connected with him in partnership or the name of any other person, either alone or in connection with his own or with any other name or designation, without the consent in writing of such person or of his legal representatives.

Section 6. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the use of names or labels in violation of the provisions of this chapter.

Section 7. Any person may adopt a label, not previously owned or adopted by any other person, and file such label for record, by depositing two copies or *fac-similes* thereof in the office of the secretary of the commonwealth, one of which copies or *fac-similes* shall be attached by the secretary of the commonwealth to the certificate of record hereinafter referred to. The applicant shall file with the label a certificate spec-

ifying the name of the person so filing such label, his residence, situation or place of business, the kind of merchandise to which such label has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. If such label has not been and is not intended to be used in connection with merchandise, the particular purpose or use for which it has been or is intended shall be stated in the certificate. Such certificate shall be accompanied by a written declaration, verified under oath by the person, or by a member of the firm or by an officer of the association, union or corporation, by which it is filed, that the party so filing such label has a right to use the same, and that no other person has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the copies or *facsimiles* filed therewith are true. The secretary of the commonwealth shall issue to the person depositing such label a certificate of record, under the seal of the commonwealth, and the secretary shall cause the certificate to be recorded in his office. Such certificate of record or a certified copy of its record in the office of the secretary of the commonwealth, shall in all suits and prosecutions under the provisions of this section and of sections eight to fourteen, inclusive, be sufficient proof of the recording of such label and of the existence of the person named in the certificate. The fee for filing the certificate and declaration and issuing the certificate of record shall be two dollars. No label shall be recorded which could reasonably be mistaken for a label already on record.

Section 8. The secretary of the commonwealth is authorized to make regulations, and prescribe forms for the filing of labels, under the provisions of the preceding section.

Section 9. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the manufacture, use or sale of counterfeits or imitations of a label, recorded

as provided in section seven, shall award damages resulting from such wrongful manufacture, use or sale and shall require the defendant to pay the owner of such label the profits derived from such wrongful manufacture, use or sale; and may also order that all such counterfeits or imitations in his possession or control be delivered to an officer of the court, or to the complainant to be destroyed. If the complainant is not incorporated, suits under the provisions of sections seven, eight and ten to fourteen, inclusive, may be commenced and prosecuted by an officer thereof, on behalf of and for the use of the complainant. Every member of a complainant firm, association or union shall be liable for costs in any such proceeding.

Section 10. Whoever knowingly makes or uses any counterfeit or imitation of any lawful name or label or causes the same to be made or used, or sells, offers for sale, deals in or has in his possession with intent to use, sell, offer for sale or deal in the same, or affixes, impresses or uses such counterfeit or imitation upon any goods, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Section 11. Whoever, with intent to defraud, knowingly casts, engraves or manufactures, or has in his possession, or buys, sells, offers for sale, or deals in, a die, plate, brand, mould, or engraving on wood, stone, metal or other substance, of a label recorded pursuant to the statutes of this commonwealth, or a printing press, or types or other tools, machines or materials provided or prepared for making a counterfeit or imitation of such label, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Section 12. Whoever knowingly sells or exposes for sale goods upon which any lawful name or label or any counter-

feit or imitation thereof is unlawfully affixed, impressed, or used shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Section 13. Whoever, with intent to defraud, knowingly aids or abets in the violation of any of the provisions of the seven preceding sections shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than six months, or by both such fine and imprisonment.

Section 14. In any suit or prosecution under the provisions of the five preceding sections, the defendant may show that he was the owner of such name or label prior to its being filed under the provisions of section seven, and that it has been wrongfully filed by some other person.

Sections 1 (particularly clause "Fifth") to 8, inclusive, of chapter 217 of Revised Laws of Massachusetts (in force January 1, 1902), provide for a search warrant in regard to "counterfeits or imitations of a label, trade mark, stamp or form of advertisement recorded pursuant to the statutes of this commonwealth"; and for the results thereof, whether rightfully or wrongfully issued.

Sections 15 to 18, inclusive, taken in connection with section 1 of chapter 72 of Revised Laws of Massachusetts (in force January 1, 1902), afford protection to manufacturers, bottlers, and vendors of milk, cream, soda water, mineral water, ale, beer, and other beverages in the use of their cans, bottles, siphons, fountains, and boxes, and provides penalties for the unauthorized use of, or the defacement of names and marks upon, such cans, bottles, siphons, fountains, or boxes by other parties.

Sections 19 to 23, inclusive, taken in connection with section 1, of said chapter 72, afford protection to "persons engaged in buying, selling or dealing in milk or cream in cans" in the use of such cans, and provides penalties for the unauthorized use of, or the defacement of names and marks upon, or befouling, such cans.

MICHIGAN.

COMP. LAWS 1897, VOL. 3, PAGE 3473 (ACT 41 OF 1891, AS AMENDED BY ACT 206 OF 1895).

An act to provide for the protection of associations and unions

of workingmen and artisans, or other persons, in their labels, trade marks, and forms of advertisement, and to punish the counterfeiting and fraudulent uses of such labels, trade marks and forms of advertisement.

(11681) Section 1. That whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such labels, trade mark, term, design, device or form of advertisement.

(11682) Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent

that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association; or who shall in any way use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be deemed guilty of a misdemeanor, and shall be punished as hereinafter provided. In suits or proceedings for damage, or for equitable relief by or on behalf of any such person, association or union, on account of the violation of any provision of this act, it shall not be necessary to prove that such violation was knowingly or willfully committed.

(11683) Sec. 3. Any person, whether a member of a firm or corporation, or otherwise, who shall violate any of the provisions of section one of this act, or who shall knowingly or willfully violate any provision of section two of this act, shall be deemed to have committed a misdemeanor thereby, and on conviction thereof shall be punished by a fine of not less than ten nor more than one hundred dollars, or by imprisonment in the county jail for a period not exceeding ninety days, or by both such fine and imprisonment, in the discretion of the court.

(11684) Sec. 4. In actions at law or proceedings in equity brought on behalf of any such association or union which is not incorporated, the same may be brought in the name of any member of such association or union, who has been duly authorized so to do by such association or union, but for the use and benefit of all of the members of such association or union: provided, that before commencing such action or proceeding

the member so authorized shall file with the justice or clerk of such court a certificate of the president and secretary of such association or union, showing that such authority has been granted. Any criminal proceeding brought for a violation of any provision of this act, may be prosecuted by the authorized attorney of such association or union, in the court where originally commenced, but in such case the fees and compensation of such attorney shall be borne and paid exclusively by such association or union: provided, that nothing herein shall be deemed to prevent the prosecuting attorney from conducting any such prosecution, or the said authorized attorney of such association or union from deputizing a duly qualified attorney at law to appear in his stead.

(11685) Sec. 5. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section one of this act, shall file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with said secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any

label, trade mark, term, design, device or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months or by both such fine and imprisonment. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be *prima facie* proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association, any label, trade mark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

(11686) Sec. 6. In no case shall the certificate from the secretary of state, obtained in conformity with the fifth section of this act, be assignable by the party to whom the same is issued.

Sec. 7. All acts and parts of acts inconsistent with the provisions of this act are hereby repealed.

Sections (11677)-(11680), vol. 3, p. 3472, also provide punishment for the counterfeiting and fraudulent use of trade marks.

Sections (5676)-(5680), vol. 2, p. 1781, protect manufacturers, bottlers, and vendors of soda water, mineral water, ale, porter, beer, and

other beverages against the unauthorized use of, or the defacement of names and marks upon, their bottles, fountains, siphons, and kegs by other persons.

MINNESOTA.

GEN. LAWS 1893, CH. 24, AS AMENDED BY GEN. LAWS 1895, CH. 122.

Section 1. Whenever any person, or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person, or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in

his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; shall be punished by a fine of not more than one hundred (100) dollars or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used or shall hereafter adopt or use a label, trade mark, term, design, device, or form of advertisement, as provided in section one (1) of this act may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac simile* thereof with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated; stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in con-

sequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred (100) dollars, or by imprisonment not exceeding three (3) months. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one (1) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof to the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

Sec. 4. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union, all profits derived from such wrongful manufacture, use, display or sale, and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed.

Sec. 5. Every person who shall use or display the genuine

label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner not authorized by such person, union, or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not less than three (3) months, or by a fine of not more than one hundred (100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three (3) months, or for a fine of not more than one hundred (100) dollars.

Sec. 7. This act shall take effect and be in force from and after its passage.

Approved February 23, 1895.

While section 7 of the act of 1893 is not expressly amended or repealed by the act of 1895, its provisions appear to be embodied in section 4 of the above act.

Gen. St. 1894.

Section 6908. Any person or persons who shall knowingly and willfully forge or counterfeit, procure to be forged or counterfeited, any representation, likeness, similitude, copy or imitation of the private stamps, brands, wrapper, label or trade mark, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to and upon the goods, wares, merchandise or preparation of said mechanic, manufacturer, druggist, merchant or tradesman, with intent to pass off any work, goods, manufacture, compound or prepara-

tion, to which such forged or counterfeited representation, likeness, similitude, copy or imitation is affixed, or intended to be affixed, as the work, goods, manufacture, compound or preparation of such mechanic, manufacturer, druggist, merchant or tradesman, shall, upon conviction thereof, be deemed guilty of a misdemeanor, upon conviction thereof, and shall be punished by imprisonment in the county jail for a period [of] not less than six months, nor more than twelve months, or fined not more than five thousand dollars.

Sec. 6909. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, have in his or their possession any die or dies, plate or plates, brand or brands, engraving or engravings or printed labels, stamps, imprints, wrapper or trade marks, or any representation, likeness, similitude, copy or imitation of the private stamps, imprint, brand, wrapper, label or trade mark usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to or upon articles made, manufactured, prepared or compounded by him or them, for the purpose of making impressions, or selling the same when made, or using the same upon any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, manufactures, preparations or compounds of any other person or persons, body corporate or politic, or who shall wrongfully and fraudulently sell or use the genuine stamp, brand, imprint, wrapper, label or trade mark, with intent to pass off any goods, wares, merchandise, mixtures, compounds or other articles not the manufacture of the person or persons, body corporate or politic, to whom such stamp, brand, imprint, wrappers, label or trade mark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six months, nor more than twelve months, or be fined not more than five thousand dollars.

Sec. 6910. Any person who shall vend or keep for sale any goods, wares, merchandise, mixture or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels or trade marks shall be placed or affixed, and intended to represent the said goods, wares, merchandise, mixture or preparation as the genuine goods, wares, merchandise, mixture or preparation of any other person or persons, knowing the same to be counterfeit, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by a fine not exceeding five hundred dollars in each case so offending, and shall also be liable in a civil action to the person or persons whose goods, wares, merchandise, mixture or preparation is counterfeited or imitated, or whose stamps, brands, imprints, wrappers, labels, or trade marks are forged, counterfeited, placed or affixed, for all damages such person or persons may or shall sustain by reason of any of the acts in this section mentioned, and may be restrained or enjoined by any court of competent jurisdiction from doing or performing any of the acts above mentioned.

Sec. 6911. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, knowingly affix or cause to be affixed to or upon any bottle, case, box or package containing any goods, manufacture, mixture, preparation or compound, any stamp, brand, label, wrapper, imprint or trade mark, which shall designate such goods, manufacture, mixture, preparation or compound, either wholly or in part, the same to the eye, or in sound to the ear, as the word or words, or some of the words, used by any other person or persons for designating any goods, manufacture, mixture, preparation or compound manufactured or prepared by or for such other person or persons, or who shall knowingly sell or expose, or offer for sale, any such bottle, case, box or package, with any such stamp, brand, label, wrapper, imprint or mark affixed to or upon it, shall, provided such per-

son or persons so affixing or causing to be affixed any such stamp, brand, label, wrapper, imprint or mark, or so selling or exposing, or offering for sale, any such bottle, case, box or package, shall not have been the first to employ or use such words, to designate, wholly or in part, any goods, manufacture, mixture, preparations or compound, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six nor more than twelve months, or be fined not more than five thousand dollars, and shall also be liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

Sec. 6912. Any person or persons who, with intent to defraud, or to enable another to defraud, any person, shall manufacture or knowingly sell, or cause to be manufactured or sold, any article or articles, marked, stamped or branded, or incased or inclosed in any box, bottle or wrapper having thereon any engraving or engravings, or printed labels, stamps, imprints, marks, or trade marks, which article or articles are not the manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving or engravings, printed labels, stamps, imprints, marks or trade marks, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and for such offense shall forfeit and pay a fine of two hundred dollars, to be recovered, with costs, in a civil action to be prosecuted by the county attorney, of any county in the state, in the name of the county in which said action shall be commenced, and the one-half of such recovery shall be paid to the informer, and the residue shall be applied to the support of the poor in the county where such recovery is had.

Sec. 6913. A "trade mark" is a mark used to indicate the maker, owner or seller of any goods, wares, merchandise, mix-

ture, preparation or compound, and includes, among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label, or other mark lawfully adopted by him and usually affixed to any goods, merchandise, mixture, preparation or compound to denote the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him.

Sec. 6914. A trade mark is deemed to be affixed to any goods, wares, merchandise, mixture, preparation or compound when it is placed in any manner in or upon either—

(1) The article itself; or

(2) A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing, in, by, or with which the goods are packed, inclosed, or otherwise prepared for sale or disposition.

Sec. 6915. An imitation of a trade mark, stamp, brand, wrapper, or label is that which so far resembles the genuine trade mark, stamp, brand, wrapper or label as to be likely to induce the belief that it is genuine, either by the use of words or letters similar in appearance or in sound, or by any sign, device, or the names whatsoever.

Sec. 6916. No testimony or evidence given by any person in any civil action to which such person may be a party, or by any other witness in such action, or on any reference or proceeding which may be had in such action, nor any evidence or testimony derived from the books or papers of such party or witness, produced by him as a witness, or otherwise, in such action, or on any reference or other proceedings which may be had therein, can or shall be used in any criminal prosecution against such party or witness, under any of the provisions of this act; nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this act.

For the law protecting manufacturers, bottlers and vendors of soda water and other beverages, milk, cream, ice cream, and butter, in the use of their bottles, barrels, kegs, casks, etc., against the unauthorized use of, or the defacement of names and marks upon, such bottles, barrels, casks, kegs, etc., by other parties, see chapters 143 and 144, Laws 1895, and chapter 306, Laws 1899.

Sections 6917 to 6922, inclusive, Gen. St. 1894, relate to the labels, etc., of labor unions and associations.

Sections 6923 to 6929, inclusive, are substantially embodied in chapter 122, Laws 1895.

MISSISSIPPI.

ANN. CODE 1892.

Section 1306. Every person who shall knowingly and willfully forge or counterfeit, or cause or procure to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrappers, or labels usually affixed by any mechanic or manufacturer to, and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares, or merchandise whatsoever, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by a fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

Sec. 1307. Every person who shall have in his possession any die, plate, engraving, or printed label, stamp, or wrapper, or any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label usually affixed by any mechanic or manufacturer to, and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares or merchandise, with intent to use or sell the said die, plate or engraving, or printed stamp, label, or wrapper, for the purpose of aiding or assisting in any way whatever in vending any goods, wares, or merchandise in imitation of, or intended to resemble and be sold for the goods, wares, or merchandise of such mechanic or manufacturer, shall be

guilty of a misdemeanor, and, upon conviction, be punished by fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

Sec. 1308. Every person who shall vend any goods, wares, or merchandise having thereon any forged or counterfeit stamp or label, imitating, resembling, or purporting to be the stamp or label of any mechanic or manufacturer, knowing the same to be forged or counterfeited, and resembling or purporting to be imitations of the stamps or labels of such mechanic or manufacturer, without disclosing the fact to the purchaser thereof, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by imprisonment in the county jail not exceeding three months, or by a fine not less than fifty nor more than five hundred dollars, or both.

MISSOURI.

REV. ST. 1899, CH. 169.

Section 10365. If any mechanic, manufacturer, association or union of workingmen, or other person, shall wish to adopt any particular name, term, design or device as his or their trade mark, to designate, make known or distinguish any goods, wares or merchandise by him or them manufactured or prepared, he or they may write out a description of such name, term, design or device, describing the same accurately, and sign and acknowledge the same before some officer competent to take the acknowledgment of deeds, and file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state; said secretary shall deliver to such mechanic, manufacturer, association or union of workingmen, or other person, so filing the same, a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar; such certificate shall, in all suits and prosecu-

tions under this chapter, be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of such mechanic, manufacturer, association or union of workingmen, or other person, to adopt the same. No label, trade mark or form of advertisement shall be recorded that in any way resembles or would probably be mistaken for a label or trade mark already of record.

Sec. 10366. Any person or persons, association or union of workingmen, who shall knowingly and willfully make, forge or counterfeit any representation, likeness, similitude, copy or imitation of the private label, brand, stamp, wrapper, engraving, mould or trade mark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, person or body corporate, association or union of workingmen, or [body] politic, to, upon or used in connection with the goods, wares, merchandise, compound or preparation of such manufacturer, mechanic, merchant, tradesman, druggist, person, association or union of workingmen, or body corporate or politic, with intent to pass off any goods, wares, merchandise, compound or preparation, to which said forged [or] counterfeit representation, likeness, similitude, copy or imitation is affixed, or in connection with which the same may be used or intended to be so affixed or used, as the work, goods, wares, implements, merchandise, compound or preparation of such manufacturer, mechanic, merchant, druggist, tradesman, person, association, or union of workingmen, or body corporate or politic, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period of not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment.

Sec. 10367. Any person or persons, association or union of workingmen, who shall, with intent to defraud any person

or persons, or body corporate or politic, have in his, her or their possession any die or dies, plate or plates, brand or brands, engraving or engravings, printed labels, stamps, imprints, moulds, wrappers or trade marks, or any representation, likeness, similitude, copy or imitation of the private label, brand, stamp or wrapper, engraving, mould or trade mark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, association or union of workingmen, person or body corporate or politic, to, upon or used in connection with articles made, manufactured, prepared or compounded by him, her or them, for the purpose of making impressions, or selling the same when made, or using the same upon or in connection with any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, wares, implements, merchandise, compound or preparation of any other person or persons, association or union of workingmen, or body corporate or politic, or who shall in fact sell or use the same, or for the purpose of secreting the same from the rightful owner or owners, or who shall wrongfully or fraudulently use the genuine label, brand, stamp, wrapper, imprint, engraving, mould or trade mark, with intent to pass off any goods, wares, implements, merchandise, compound or preparation, or other article not the manufacture of the person, persons, association or union of workingmen, or body corporate or politic, to whom such label, brand, stamp, wrapper, engraving, imprint, mould or trade mark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment.

Sec. 10368. Any person, persons, association or union of

workingmen, or body corporate or politic, who shall vend or keep for sale any goods, wares, merchandise, compounds or preparations upon which or in connection with which any forged, imitation or counterfeit label, brand, stamp, wrapper, imprint, engraving, bottle or trade mark shall be placed, affixed or used, and intended to represent the said goods, wares, implements, merchandise, compounds or preparations as the genuine goods, wares, implements, merchandise, compound or preparation of any other person or persons, association or union of workingmen, or body corporate or politic, knowing the same to be imitation or counterfeit, shall be deemed guilty of a misdemeanor, and, upon conviction thereof, shall be punished by a fine of not less than one hundred dollars nor more than five thousand dollars, or by imprisonment in the county jail not less than one month nor more than twelve months, or both, and shall also be liable in a civil action to the person or persons, association or union of workingmen, or body corporate or politic, whose goods, wares, implements, merchandise, compounds or preparations is imitated or counterfeited, or whose label, stamp, wrapper, engraving, imprint, bottle, or trade mark is imitated, forged or counterfeited, placed, affixed or used, for all damages such person or persons, association or union of workingmen, or body corporate or politic, may or shall sustain, both by virtue of the loss of profits and the damage done to the reputation of the said genuine article, goods, wares, implements, merchandise, compound or preparation, by reason of any of the acts in any section of this chapter mentioned, and may be restrained or enjoined by any court of competent jurisdiction from doing or performing any of the acts herein mentioned.

Sec. 10369. Any person or persons who shall, with intent to defraud any person or persons, association or union of workingmen, or body corporate or politic, knowingly affix or cause to be affixed to or upon any case, box, web, package or

bottle containing any goods, wares, merchandise, compound or preparation, any label, brand, stamp, wrapper, engraving, imprint or mark which shall designate such goods, wares, merchandise, compound or preparation, either wholly or in part by a word or words, or by general design, which shall be wholly or in part the same to the eye, or in sound to the ear, as the word or words or the general design used by any person or persons, association or union of workingmen, or body corporate or politic, for designing any goods, wares, merchandise, compound or preparation, manufactured or prepared by or for some other person or persons, association or union of workingmen, or body corporate or politic, or who shall kno··ingly sell or expose or offer for sale any such case, box, web, ckage or bottle, with any such label, brand, stamp, wrapper, engraving, imprint, or mark affixed to or upon it, shall, provided such person or persons affixing or causing to be affixed any such label, brand, stamp, wrapper, engraving, imprint or mark, or so selling or offering for sale any such case, box, web, package or bottle, shall not have been the first to employ or use such word or words or general design to designate, wholly or in part, any goods, wares, merchandise, compound or preparation, and upon conviction thereof be deemed guilty of a misdemeanor, and shall be liable to the party aggrieved in the penal sum of five hundred dollars, and for a further sum equal to the amount which the aggrieved party might have received for the same amount of genuine goods, wares, merchandise, compounds or preparations, and shall be guilty of a misdemeanor, and on conviction may be punished by imprisonment in the county jail for a period of not less than one month nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment.

Sec. 10370. All courts of this state having jurisdiction of criminal cases shall have jurisdiction of proceeding [s] for

violation of this chapter. All suits brought under this chapter shall be brought by the person or persons injured or defrauded by such parties; and if brought by any association or union of workingmen, the suit may be brought in the name of the president and secretary, to the use and benefit of such association or corporation, and may thus sue and be sued.

Sec. 10371. It shall be the duty of any officer within the jurisdiction of the court having authority, to whom there shall be delivered any warrant for the arrest of any person alleged to have committed any offense created by this chapter to seize any and all goods, wares, merchandise, compounds, preparations, labels, brands, implements, stamps, wrappers, imprints, engravings, plates, bottles, dies or moulds, mentioned or referred to in the complaint, or affidavit or information, upon which said warrant issued, and upon final conviction of the offender, the court shall direct such of same as may be counterfeit to be destroyed, and they shall be so destroyed accordingly: provided, however, that if said property consists of wares and merchandise, which, in the judgment of the court, are independent of any trade mark, of genuine and intrinsic value, and capable of being applied to a useful and beneficial purpose, then and in such case all counterfeit words, marks, wrappers, labels, emblems, stamps, brands, bottles, imprints and signs used in connection therewith shall be first erased, obliterated and destroyed, and said property shall be sold within ten days next succeeding the decision of the court thereon, in such manner as the court shall direct, and the proceeds of said sale, less the expense thereof, be applied to the benefit of the school fund of the county in which said seizure was effected.

Sec. 10372. No testimony or evidence given by any person in any civil action to which said person may be a party, or by any other witness in such action, or in any reference or proceeding which may be had in such action, nor any tes-

timony or evidence derived from the books or papers of such party or witness, or otherwise, in such action, or in any reference or other proceeding which may be had therein, can or shall be asked in any criminal prosecution against such party or witness, under any of the provisions of this chapter, nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this chapter.

Sections 2270-2275, Rev. St. 1899, protect manufacturers of glass bottles, and persons who manufacture, bottle, or sell mineral waters and other beverages, against the unauthorized use of or injury to, or defacement of the names or marks upon, their bottles, siphons, jugs, etc., by other persons.

MONTANA.

CODES AND STATUTES OF 1895—POLITICAL CODE.

Section 3160. The phrase "trade mark," as used in this chapter, 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 to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description, or the designation or name for any mill, hotel, factory or other business.

Sec. 3161. Any person may record any trade mark or name, by filing with the secretary of state his claim to the same, and a copy or description of such trade mark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he or the firm or corporation of which he is a member, is the exclusive owner, or agent of the owner, of such trade mark or name. [As amended February 25, 1899.]

Sec. 3162. The secretary of state must keep for public ex-

amination a record of all trade marks or names filed in his office, with the date when filed and the name of the claimant, and must not record any two like trade marks or names. He must at the time of filing and recording a trade mark or name, collect from the claimant a fee of three dollars. [As amended February 25, 1899.]

Sec. 3163. Any person who has first adopted and used a trade mark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain by injunction any use of trade marks or names in violation of this chapter.

Sec. 3164. The penalty for forging, counterfeiting or unlawfully using trade marks is provided in section 636 of the Penal Code.

Civil Code.

Section 1071. There may be ownership of all inanimate things which are capable of appropriation or of manual delivery, of all domestic animals; of all obligations; of such products of labor or skill as the composition of an author; the good will of a business; trade marks and signs, and of rights created or granted by statute.

Section 1370. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trade mark, any form, symbol or name, which has not been so appropriated by another, to designate the origin or ownership thereof; but he cannot exclusively appropriate any designation or part of a designation, which relates only to the name, quality, or the description of the thing or business, or the place where the thing is produced, or the business is carried on.

Section 1371. The good will of a business is the expectation

of continued public patronage, but it does not include the right to use the name of any person from whom it was acquired.

Section 1372. The good will of a business is property, transferable like any other.

Sec. 2379. One who sells or agrees to sell any article to which there is affixed or attached a trade mark, thereby warrants that trade mark to be genuine and lawfully used.

Section 2380. One who sells or agrees to sell any article to which there is affixed or attached a statement or mark to express the quantity or quality thereof, or the place where it was, in whole or in part produced, manufactured or prepared, thereby warrants the truth thereof.

Section 2383. One who sells the good will of a business, thereby warrants that he will not endeavor to draw off any of the customers.

Penal Code.

Section 636. Every person who willfully forges or counterfeits, or procures to be forged or counterfeited, any trade mark usually affixed by any person to his goods, which has been recorded in the office of the secretary of state, with intent to pass off any goods to which such forged or counterfeited trade mark is affixed or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

Sec. 637. Every person who sells or keeps for sale, any goods upon or to which any counterfeited trade mark has been affixed, after such trade mark has been recorded in the office of the secretary of state, intending to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

Sec. 638. The phrases "forged trade mark" and "counterfeited trade mark" or their equivalents, as used in this chap-

ter, include every alteration or imitation of any trade mark so resembling the original as to be likely to deceive.

Sec. 639. The phrase "trade mark," as used in the three preceding sections, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

Sec. 640. Every person who has or uses any cask, bottle, siphon, vessel, case, box, cover, label, or other thing bearing or having in any way connected with it the duly filed trade mark or name of another, for the purpose of disposing, with intent to deceive or defraud, of any article other than that which such cask, vessel, bottle, case, cover, label, or other thing originally contained, or was connected with, by the owner of such trade mark or name, is guilty of a misdemeanor.

Sec. 641. Whenever any person, association or union of workingmen have adopted, or hereafter shall adopt for their protection, any label, trade mark or form of advertisement announcing the goods to which such label, trade mark or form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark or form of advertisement. Every person violating this section shall, upon conviction, be guilty of a misdemeanor.

Sec. 642. Every person who shall use any counterfeit or imitate any label, trade mark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor.

Sec. 643. Every such person, association or union that heretofore adopted, or shall hereafter adopt, a label, trade mark or form of advertisement as aforesaid, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state; said secretary shall deliver to such person, association or union filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of said person, association or union to adopt the same. No label shall be recorded that, probably, would be mistaken for a label already of record.

Sec. 644. Every such person, association or union adopting a label, trade mark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeit or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit such damages, resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, and shall require the defendants to pay such person, association or union the profits derived from such wrongful manufacture, use, display, or sale; and said court shall also order that all such counterfeits and imitations in the possession, or under the control, of any defendant in such case be delivered to any officer of the court, or to complainant, to be destroyed.

Sec. 645. Every person who shall use or display the genuine label, trade mark or form of advertisement of any such person, association or union in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor. In all cases where such association or

union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 646. Any person or persons who shall in any way use the name or seal of any person, association or union, or officer thereof, in and about the name of goods, or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor.

NEBRASKA.

COMPILED STATUTES 1901.

Section 6810. If any person shall falsely make, alter, forge, counterfeit, print, or photograph * * * any private stamp, brand, wrapper, label, or trade mark, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman to or upon the goods, wares, merchandise, preparation or mixture of such mechanic, manufacturer, druggist, merchant, or tradesman; * * * with intent to damage or defraud any person or persons, body politic or corporate, or any military body organized under the laws of this state; or shall utter or publish as true and genuine, or cause to be uttered and published as genuine and true, or shall have in his possession with intent to utter and publish as true and genuine, any of the above named false, altered, forged, counterfeited, falsely printed, or photographed matter above specified and described, knowing the same to be false, altered, forged, counterfeited, falsely printed, or photographed, with intent to prejudice, damage, or defraud any person or persons, body politic or corporate. Every person so offending shall be imprisoned in the penitentiary for any space of time not exceeding twenty years nor less than one year, and pay fine not exceeding five hundred dollars.

Section 6811. If any person shall have in his possession

any die, or dies, plate or plates, brand or brands, engraving, imprint, printed labels, wrappers, or any other instrument, thing or means whatever with intent therewith or thereby to falsely make, forge, or counterfeit any matter specified in the last preceding section, or to cause or enable the same to be done; or shall have in his possession any such falsely made, forged, or counterfeited matter whether the same be completed or only partly executed, for the purpose of bartering, selling, or disposing thereof, knowing the same to be falsely made, forged or counterfeited, with intent thereby to prejudice, damage, or defraud any person or persons, body politic or corporate, every person so offending shall be imprisoned in the penitentiary not less than six months nor more than ten years, and pay a fine not exceeding one thousand dollars.

Section 6814. Any person who shall vend or keep for sale any goods, merchandise, mixture, or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels, or trade marks be placed or affixed, and intended to represent the said goods, merchandise, mixture or preparation, as the true and genuine goods, merchandise, mixture or preparation of any person or persons, knowing the same to be counterfeit, shall be punished by a fine not exceeding one hundred dollars.

Sections 6922-6926, Comp. St. 1901, are designed to protect manufacturers, bottlers, and vendors of soda water, mineral water, and other beverages in the use of their casks, barrels, kegs, bottles, and boxes, and provide penalties for the unauthorized use of or injury to such casks, barrels, kegs, bottles, and boxes by other parties.

Sections 3549-3553 protect associations and unions of workingmen in their labels, trade marks, and forms of advertisement, and authorize such associations or unions to file the same with the secretary of state.

NEVADA.

COMPILED LAWS, ANN., 1861-1900.

An act concerning trade marks and names (approved March 8, 1865, 268).

5040. Section 1. When a person who has complied with the provisions of section two of this act uses any peculiar name, letters, marks, device, figures, or other trade mark or name, cut, stamped, cast, or engraved upon, or in any manner attached to or connected with, any article, or with the covering or wrapping thereof, manufactured or sold by him, to designate it as an article of a peculiar kind, character, or quality, or as an article manufactured or sold by him, or if such trade mark or name be so connected with any bottle, box, cask, or other thing used for holding such article, it shall be unlawful for any other person, without his consent, to use said trade mark or name, or any similar trade mark or name, for the purpose of representing any article to have been manufactured or sold by the person rightfully using such trade mark or name, or to be the same kind, character, or quality as that manufactured or sold by the person rightfully using such trade mark or name.

5041. Sec. 2. Any person wishing to secure the exclusive use of any such trade mark or name, under the provisions of this act, shal' file his claim to the same, and a copy or description of such trade mark or name, with the secretary of state.

5042. Sec. 3. The secretary of state shall keep a record of all trade marks or names filed in his office, with the date when filed, and name of claimant, for public examination. A fee of twenty dollars shall be paid to the secretary of state at the time of filing each copy and description of any trade mark or name, by the party claiming the use and benefit of the same. It is hereby made the duty of the secretary of

state to pay all fees accruing under this section into the state library fund.

5043. Sec. 4. Any person violating the provisions of the first section of this act shall be guilty of a misdemeanor, and on conviction thereof shall be punished by a fine of not less than twenty-five dollars, nor more than five hundred dollars, or by imprisonment in the county jail for not less than five days, nor more than thirty days, or by both such fine and imprisonment; and he shall be further liable to any party aggrieved by such violation for all damages actually incurred, to be recovered as a debt in any court of competent jurisdiction.

5044. Sec. 5. It shall be unlawful for any person to counterfeit any trade mark or name, or to have or use a counterfeit trade mark or name, or sell any article bearing or having in any way connected with it a counterfeit trade mark or name, which has been filed according to section two of this act, knowing it to be such, or having good and sufficient reason to know it to be such. Every alteration or imitation of any trade mark or name which has been filed according to section two of this act which shall be made, applied, or used, or which shall cause any trade mark or name, with such alterations or imitation, to resemble any genuine trade mark or name, so as to be calculated or likely to deceive, shall be deemed to be a counterfeit trade mark or name, within the meaning of this act and every act of making, applying, or otherwise using any such alteration or imitation, as aforesaid, done by any person, such person shall be deemed to be guilty of counterfeiting a trade mark or name, or knowingly using a counterfeit trade mark or name, within the meaning of this act. Every person violating the provisions of this section shall be guilty of a misdemeanor, and on conviction thereof shall be punished as provided in section four of this act.

5045. Sec. 6. Every person who shall have or use any cask, bottle, vessel, case, cover, label, or other thing, bearing or having in any way connected with it the trade mark or name of another, which has been filed according to section two of this act, for the purpose of disposing of any article with intent to deceive or defraud, other than that which said cask, bottle, vessel, case, cover, label, or other thing originally contained, or was connected with by the owner of said trade mark or name, shall be guilty of a misdemeanor, and on conviction thereof shall be punished as provided in section four of this act.

5046. Sec. 7. Every person who shall knowingly aid, or abet, or counsel in, or procure the commission of any offense which is by this act made a misdemeanor, shall be deemed and held to be guilty of a misdemeanor, and shall be subject to the penalties provided in section four of this act.

5047. Sec. 8. This act shall not be so construed as to permit any person to file, without authority from the owner, any trade mark or name owned, or previously used by another person, nor in any way to interfere with, hinder, prevent, or restrain the importation or sale, by any person, of genuine articles of merchandise having, or belonging thereto, genuine trade marks or names manufactured or sold in other states or countries.

5048. Sec. 9. Any person who has first adopted and used a trade mark or name, whether within or beyond the limits of this state, shall be considered its original owner, and the ownership may be transferred in the same manner as personal property, and shall be entitled to the same protection by suits at law as other personal property.

5049. Sec. 10. Every person filing with the secretary of state, as provided in section two of this act, his claim to any trade mark or name, shall have attached to the copy and description thereof his affidavit, duly certified to by any offi-

cer authorized by the laws of this state to take acknowledgments of conveyances, setting forth that he (or the firm or corporation of which he is a member) is the exclusive owner or agent of the accompanying trade mark or name.

5050. Sec. 11. Any court of competent jurisdiction may restrain, by injunction, any use of trade marks or names in violation of any section of this act.

5051. Sec. 12. No person otherwise competent as a witness, shall be disqualified or excused from testifying as a witness, either before a grand jury or a petit jury, or otherwise, concerning any offense mentioned in this act, on the ground that his testimony may criminate himself, but such testimony shall be reduced to writing, and no indictment or prosecution shall afterward be brought against him for said offenses, concerning which he has testified as a witness.

5052. Sec. 13. Any witness called to give testimony on behalf of the state, before any grand jury, or before any court of justice, shall be required to give such testimony, which shall be reduced to writing, and such witness shall not be liable to suffer any punishment or forfeiture for any offense against the provisions of this act, so disclosed.

Section 1938, Compiled Laws, Nevada, 1861 to 1900, reduces the fee for recording trade marks and names to five dollars.

NEW HAMPSHIRE.

Public Statutes and Session Laws 1901, Page 407 (Laws 1895, Ch. 42).

Protection of workingmen's trade marks, etc., and of rights in literary, dramatic and musical compositions and in works of art.

Section 1. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt, for their protection, any label, trade mark, or form of advertisement announcing that goods to which such label, trade mark, or

form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark or form of advertisement. And whenever any person, firm, association or corporation is the owner of any literary, dramatic or musical composition and the rights of the author pertaining thereto, and such composition has not been copyrighted, printed or published, or of any map, charter, engraving, cut, print, photograph or negative thereof, statue, statuary, model or design which has not been copyrighted or offered for sale, it shall be unlawful for any other person, firm, association or corporation to publish, produce, print or sell, or offer to sell the same without first obtaining the consent of the owner thereof.

Sec. 2. Every person who shall use any counterfeit or imitation of any label, trade mark, or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished as provided in section 7 of this act.

Sec. 3. Every such person, association or union that has heretofore adopted, or shall hereafter adopt, a label, trade mark, or form of advertisement, as aforesaid, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof with the secretary of state; and the secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall, in all suits and prosecutions under this act, be *prima facie* proof of the adoption of such label, trade mark, or form of advertisement, and of the right of said person, association or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

Sec. 4. Every such person, association or union adopting a label, trade mark, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display, or sale, and such person, association or union shall be entitled to such damages resulting from such wrongful manufacture, use, display, or sale, as may be deemed just and reasonable and the supreme court shall also order that all counterfeits or imitations in the possession or under the control of the defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. Every person who shall use or display the genuine label, trade mark, or form of advertisement of any such person, association, or union in any manner not authorized by such person, association, or union, shall be deemed guilty of a misdemeanor, and shall be punished as provided in section 7 of this act. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union in behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable as provided in the succeeding section.

Sec. 7. Any violations of any of the provisions of this act shall be punished by imprisonment in the county jail for a term of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both.

NEW JERSEY.

LAWS 1898, CH. 50.

An act to provide for the registration of labels, trade marks, terms and designs, and protect and secure the rights, property and interests therein of the persons, associations, organizations and corporations adopting and filing the same.

1. It shall be lawful for any person, association, organization or corporation to adopt for their protection and file for registry, or cause to be filed for registry, as herein provided, any label, trade mark, term or design that has been used or is intended to be used for the purpose of designating, making known or distinguishing any goods, wares, merchandise or products of labor that have been or may be wholly or partly made, manufactured, produced, prepared, packed or put on sale by any person, association, organization or corporation, or to or upon which any work or labor has been applied or expended by any person or by any member or members of any association, organization or corporation that has adopted and filed for registry, or that may adopt and file for registry, any such label, trade mark, term or design as aforesaid, or announcing or indicating that the same have been made in whole or in part by any such person, association, organization or corporation or by any member or members thereof.

2. Whenever any person, association, organization or corporation shall adopt and file for registry, or cause to be adopted and filed for registry, any label, trade mark, term or design pursuant to the provisions of this act, the property, privileges, rights, remedies and interests in and to any such label, trade mark, term or design, and in and to the use of the same, provided or given by this act to, or otherwise conferred upon or enjoyed by, the person, association, organization or corporation filing the same, or causing the same to

be filed, for registry, shall be fully and completely secured, preserved and protected as the property of those entitled to the same, before any such label, trade mark, term or design has been actually applied to any goods, wares, merchandise or product of labor and put upon the market for sale or otherwise, and before any use or appropriation of any such label, trade mark, term or design has been made in connection with any such goods, wares, merchandise or product of labor, as well as after the same has been used or applied to designate, make known or distinguish any such goods, wares, merchandise or product of labor and they have been put upon the market.

3. Any person, association, organization or corporation that has heretofore adopted and used, or shall hereafter adopt and use, any label, trade mark, term or design as herein provided, may file the same for registry in the office of the secretary of state by leaving two copies, *fac similes* or counterparts thereof, with the said secretary, and filing therewith a statement in the form of an affidavit, subscribed and sworn to by any such person, or by any officer, agent or attorney of any such association, organization or corporation, specifying the person, association, organization or corporation by whom, or on whose behalf, any such label, trade mark, term or design is filed, and the class or character of goods, wares, merchandise or product of labor to which the same has been, or is intended to be, appropriated or applied, and that the person, association, organization or corporation so filing the same, or on whose behalf the same is so filed, has the right to the use of the said label, trade mark, term or design, and that no other person, firm, association, organization or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, without the permission or authority of the person, association, organization or corporation filing the

same, or causing the same to be filed, and that the copies, *fac similes* or counterparts filed therewith are true and correct copies, *fac similes* or counterparts of the genuine label, trade mark, term or design of the person, association, organization or corporation filing the same or causing the same to be filed; and there shall be paid for such filing and registry a fee of one dollar to the secretary of state for the use of the state.

4. The secretary of state, upon the filing of any such label, trade mark, term, or design, that is not in conflict with the next section hereof, shall register the same, and shall deliver to the person, association, organization or corporation filing the same, or causing the same to be filed, as many certified copies thereof, with his certificate of such registry, as any such person, association, organization or corporation may request, and for every such copy and certificate there shall be paid to the secretary of state, for the use of the state, a fee of one dollar; and any such certified copy and certificate shall be admissible in evidence and competent and sufficient proof of the adoption, filing and registry of any such label, trade mark, term or design by any such person, association, organization or corporation, in any action or judicial proceeding in any of the courts of this state, and of due compliance with the provisions of this act; provided, however, that such certificate shall not be assignable or transferable by the person, association, organization or corporation to whom the same is issued by the secretary of state.

5. It shall not be lawful for the secretary of state to register, or permit to be registered, for any person, association, organization or corporation any label, trade mark, term or design that is in the identical form of any other label, trade mark, term or design theretofore filed by or on behalf of any other person, association, organization or corporation, or that bears any such near resemblance thereto as may be

calculated to deceive, or that would be liable to be mistaken therefor; and any person, association, organization or corporation who shall file or procure the filing and registry of any label, trade mark, term or design in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declarations, with fraudulent intent, shall be liable to pay any damages sustained in consequence of any such registry, to be recovered by or on behalf of the party injured thereby in any court of law of this state having jurisdiction in civil causes.

6. Whenever any person, association, organization or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trade mark, term or design, or cause the same to be done, as herein provided, and the same shall have been registered pursuant to this act, it shall be unlawful, and a violation of this act, for any other person, association, organization or corporation to manufacture, use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trade mark, term or design; or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or product of labor to which or on which any counterfeit or imitation of any such label, trade mark, term or design is attached, affixed, printed, painted, stamped, impressed or displayed; or to sell or dispose of, or offer to sell or dispose of, or have in possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed.

7. Whenever any person, association, organization or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any

label, trade mark, term or design as herein provided, it shall be unlawful, and a violation of this act, for any other person or persons, association, organization or corporation, to make any use, sale, offer for sale or display of the genuine label, trade mark, term or design of any such person, association, organization or corporation, filing the same; or to have any such genuine label, trade mark, term or design in possession with intent that the same shall be used, sold, offered for sale or displayed, or that the same shall be applied, attached or displayed in any manner whatever to or on any goods, wares or merchandise; or to sell, offer to sell, or dispose of, or have in possession with intent that the same shall be sold or disposed of, any goods, wares or merchandise in any box, case, can or package to or on which any such genuine label, trade mark, term or design of any such person, association, organization or corporation is attached, affixed or displayed; or to make any use whatever of any such genuine label, trade mark, term or design, without first obtaining, in every such case, the license, consent or authority of the person, association, organization or corporation adopting, filing and registering the same, or causing the same to be adopted, filed and registered; and any such license, consent or authority may be revoked and terminated at any time upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof.

8. It shall be lawful for any person, association, organization or corporation that has adopted and filed, or caused to be filed and recorded or registered in the office of the secretary of state, at any time before the passage of this act, any label, trade mark, term or design, to refile the same for registration by the secretary of state pursuant to the provisions of this act, upon payment of the fees herein pre-

vided for filing and registering any label, trade mark, term or design, and for copies and certificates thereof, and any person, association, organization or corporation so refiling any such label, trade mark, term or design shall have and be entitled to all the rights, remedies, privileges and protection given by this act to any person, association, organization or corporation originally filing any label, trade mark, term or design under the provisions of this act and subject to the same liabilities.

9. The court of chancery shall have jurisdiction in all cases arising or commenced therein under this act for the violation of any of the provisions thereof, and any person, association, organization or corporation filing, or causing to be filed, for registry, any label, trade mark, term or design pursuant to the provisions of this act, shall have the right to an action in the said court against any person or persons, association, organization or corporations, for the violation of any of the provisions of this act; and upon the filing of any bill of complaint therefor, the law and practice regulating proceedings in that court shall be applicable thereto; and the said court is hereby empowered and required to enjoin the manufacture, counterfeiting, imitation, display, use, sale, offer of sale, circulating or uttering of any counterfeit or imitation of any such label, trade mark, term or design of any such person, association, organization or corporation; and the sale or disposal of any goods, wares, merchandise or product of labor to which, or on which, any such counterfeit or imitation label, trade mark, term or design is attached, affixed, printed, painted, stamped, impressed or displayed; or any goods, wares, merchandise or product of labor contained in any box, case, can or package to or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed; and further to enjoin the manufacture, use, sale, offer of

sale, or display, of any genuine label, trade mark, term or design of any such person, association, organization or corporation filing the same as aforesaid; or having in possession any such genuine label, trade mark, term or design with intent that the same shall be used, sold, offered for sale or displayed, or the same applied, attached or displayed in any manner whatever to or on any goods, wares, merchandise or product of labor; or the selling or offer to sell or dispose of, or having in possession with intent that the same shall be sold, offered for sale or disposed of, any goods, wares or merchandise in any box, case, can or package to or on which any such genuine label, trade mark, term or design of any such person, association, organization or corporation is attached, affixed or displayed; and from making any other, or any, use whatever of any such genuine label, trade mark, term or design, without having first obtained, in any and every such case, the consent and authority of the person, association, organization or corporation adopting, filing and registering the same, or causing the same to be filed and registered, as herein provided; and the said court of chancery is hereby empowered to make such other orders and direct such other proceedings as the court may deem necessary and proper for the due protection of the rights of complainants, effecting the purposes of this act, the prevention of any violation of any of the provisions of the same, and secure and protect any and all persons, associations, organizations or corporations in all the rights, privileges, property and interests to which they or any of them are or may be entitled in any such label, trade mark, term or design under any of the provisions of this act or otherwise; and it shall be the duty of the said court of chancery to award to the complainant or complainants in any such action any and all damages resulting from any such wrongful use of any such label, trade mark, term or design by any defendant or de-

fendants, or for any violation of any of the provisions of this act; and to require any such defendant or defendants to pay to such complainants any and all such damages, together with all costs and expenses incurred by any such complainant in any such action or proceeding; and the said court shall also order and decree that the defendants pay to the complainant or complainants any and all profits obtained, received or derived from any such wrongful use or any violation of the provisions of this act; or both profits and any such damages, and that any and all such counterfeits or imitations of any such labels, trade marks, terms or designs in the possession or under the control of the defendant or defendants in any such action shall be delivered up to an officer of the court, or to the complainant, to be destroyed, and that any such genuine labels, trade marks, terms or designs in the possession or under the control of any such defendant or defendants shall be delivered up to the complainant.

10. That, in addition to any other rights, remedies or penalties provided by this act, and as concurrent therewith, any person or persons, association, organization or corporation that shall violate any of the provisions of this act shall be liable to a penalty of not less than two hundred and not more than five hundred dollars, to be recovered in an action of debt in any court of law of this state having jurisdiction in civil causes, by any such person, association, organization or corporation that has adopted and filed, or caused the same to be done as aforesaid, any such label, trade mark, term or design; which action may be commenced by summons as in ordinary cases, and shall be proceeded with therein as ordinary cases in said court; and in case any execution shall be issued upon any judgment obtained against the defendant or defendants in any such action and the same be returned unsatisfied, the court on application and two

days' notice to the defendant, may award an execution to take the body of the defendant or defendants as in other cases where a capias may issue out of the circuit or supreme courts of this state; and thereafter the rights, remedies and liabilities of the parties, and the proceedings in the case shall be the same, or as nearly as may be, as in other actions in said courts where an execution to take the body of the defendant or defendants has been issued; and it shall be the duty of the court in which any such action may be brought to make all proper and necessary orders to restrain and prevent any defendant or defendants from continuing the committing of any violation of any of the provisions of this act.

11. In any suit or proceeding in equity, or in any action at law, brought by or on behalf of any such association or organization that is not incorporated, for any violation of any of the provisions of this act, the same may be brought in the recognized name of any such association or organization, or in the proper name of the president or the secretary or the treasurer of any such association or organization who has been or may be given authority to bring any action or actions for or in behalf of any such association or organization, and if for any reason such authority is not given before the commencement of any such suit or action, the same may be given thereafter at any time before the trial of the same; and any such suit in equity or action at law may be brought as aforesaid in the recognized name of any branch or local or sub-association, affiliated or connected with any national or international association or organization, or in the name of the president or the secretary or the treasurer thereof; and such authority to bring the same may be given by any board of directors, executive board or executive committee, of any such association or organization, elected, chosen or appointed by any such association or organiza-

tion; and any such person or persons bringing any such action or proceeding in any court of law or equity in this state shall have the right to receive any and all moneys, property or other valuable thing recovered by or adjudged to the complainant or plaintiff in any such suit or action, for the use and benefit of the association or organization entitled to the same; and whenever any such suit or action shall be brought by or on behalf of any such branch or local or sub-association or organization as herein provided instead of by or on behalf of any such national or international association or organization, such branch or local or sub-association bringing the same shall be entitled to the same rights, privileges, remedies and advantages, in the prosecution of such suit or action, as any other party or parties authorized by this act to bring such suit or action would have been entitled to if any such suit or action had been brought by them, or in their behalf, as herein provided.

12. This act shall be construed by all courts at all times, in all suits, actions and proceedings, in the most liberal manner for effecting the objects and purposes thereof and protecting the claims, rights, interests, use and property of every person, association, organization or corporation in and to any label, trade mark, term or design, filed and registered pursuant to the provisions of this act.

13. All acts and parts of acts contrary to, or inconsistent with the provisions of this act, be and the same are hereby repealed.

14. This act shall be deemed and taken to be a public act and shall take effect immediately.

Passed March 15, 1898.

Earlier acts for the protection of labels, stamps, trade marks, etc., can be found in Gen. St. 1709-1895, vol. 3, pp. 3678-3680.

Section 186, p. 1082, tit. "Crimes," vol. I, Gen. St. 1709-1895, makes it a misdemeanor to forge or counterfeit private stamps or labels, or to

sell any goods having thereon forged or counterfeited stamps or labels, knowing the same to be forged or counterfeited, without disclosing the fact to the purchaser.

NEW MEXICO.

No statutes in this territory dealing with this subject.

NEW YORK.

CUMMING & GILBERT'S GENERAL LAWS AND OTHER GENERAL STATUTES, JANUARY 1, 1902, PAGE 1050.

§ 28. Trade Marks. Any person engaged in manufacturing, bottling, or selling any beverage, medicine, perfumery or mixture in this state, put up by him for sale in any vessel or receptacle, with his name or other private mark branded, stamped or marked thereupon, may file in the office of the secretary of state and in the office of the county clerk of the county where the same is manufactured, bottled, or put up for selling, a description of the name or other private mark so branded, stamped, or marked thereupon, and publish the same once a week, for at least three weeks successively, in a newspaper published in said county, except in New York and Kings, where such publication shall be for the same length of time daily in two newspapers therein, and he shall thereupon be deemed the proprietor of such name or mark and of every vessel or receptacle upon which it may be branded, stamped or placed. No person, other than such proprietor, shall fill for any purpose, any such vessel or receptacle so branded, stamped or marked or from which any such brand, stamp, mark, name or other device has been removed, defaced or obliterated, nor remove, deface or obliterate the same, or place other brands, stamps, marks, names or devices upon any such vessel or receptacle without the written permission of such proprietor, or unless there has been

a sale to such person of such vessel or receptacle, exclusive of the contents thereof, by such proprietor.

No person other than such proprietor, shall, without his permission, use, traffic in, purchase, sell, dispose of, convert, mutilate, destroy or willfully or unreasonably refuse to return or deliver to such proprietor on demand, any such vessel or receptacle so branded, stamped or marked belonging to such proprietor.

Any person violating any provision of this section shall forfeit to such proprietor one hundred dollars for each such violation.

Possession of any such vessel or receptacle without the consent of the proprietor of the trade mark thereupon shall be presumptive evidence of such violation. (Laws 1896, c. 376, § 28.)

PAGE 1082. TRADE MARKS.

§ 1. Any and all persons and corporations engaged in manufacturing, bottling or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages or medicines, medical preparations, perfumery, oils, compounds or mixtures, in bottles, siphons, tins or kegs, with his, her, its or their name or names, or other marks or devices branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, siphons, tins or kegs, or the boxes used by him, her, it or them, may file in the office of the clerk of the county in which his, her, its or their principal place of business is situated, or if such person, persons, corporation or corporations shall manufacture or bottle out of this state, then in any county in this state, and also in the office of the secretary of state, a description of the name or names, marks or devices so used by him, her, it or them, respectively, and cause such description to be

printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed as aforesaid, except that in the city and county of New York and the city of Brooklyn, in the county of Kings, such publication shall be made twice in each week, for three weeks successively, in two daily newspapers published in the cities of New York and Brooklyn, respectively. (Laws 1896, c. 933, § 1.)

§ 2. It is hereby declared to be unlawful for any person or persons, corporation or corporations to fill with soda water, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or with medicine, medical preparations, perfumery, oils, compounds or mixtures, any bottle, box, siphon, tin or keg so marked or distinguished as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section one of this act, or to deface, erase, obliterate, cover up or otherwise remove or conceal any such name, mark or device thereon, or to sell, buy, give, take or otherwise dispose of or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or persons, corporation or corporations, whose mark or device shall be or shall have been in or upon the bottle, box, siphon, tin or keg so filled, trafficked in, used or handled as aforesaid. Any person or persons, or corporation or corporations offending against the provisions of this section shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment for not less than ten days nor more than one year, or by a fine of fifty cents for each and every such bottle, box, siphon, tin or keg so filled, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, and for each subsequent offense by imprisonment for not less than twenty days nor more than

one year, or by a fine of not less than one dollar, nor more than five dollars, for each and every bottle, box, siphon, tin or keg so filled, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, in the discretion of the magistrate before whom the offense shall be tried. (Laws 1896, c. 933, § 2.)

§ 3. The use by any person, other than the person or persons, corporation or corporations, whose device, name or mark shall be or shall have been upon the same without such written consent or purchase as aforesaid, of any such marked or distinguished bottle, box, siphon, tin or keg, a description of the name, mark or device, whereon shall have been filed and published, as herein provided, for the sale therein of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or any article of merchandise, medicines, medicinal preparations, perfumery, oils, compounds, mixtures or preparations, or for the furnishing of such or similar beverages to customers, or the buying, selling, using, disposing of or trafficking in any such bottles, boxes, siphons, tins or kegs by any person other than said persons or corporations having a name, mark or device thereon of such owner without such written consent, or the having by any junk dealer or dealers in second-hand articles, possession of any such bottles, boxes, siphons, tins or kegs, a description of the marks, names or devices, whereon shall have been so filed and published as aforesaid, without such written consent, shall and is hereby declared to be presumptive evidence of the said unlawful use, purchase and traffic in of such bottles, boxes, siphons, tins or kegs. (Laws 1896, c. 933, § 3.)

§ 4. Whenever any person, persons or corporation mentioned in section one of this act, or his, her, its or their agent shall make oath before any magistrate that he, she or

it has reason to believe, and does believe, that any of his, her, its or their bottles, boxes, siphons, tins or kegs, a description of the names, marks or devices whereon has been so filed and published as aforesaid, are being unlawfully used or filled, or had, by any person or corporation manufacturing or selling soda, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicine, medical preparations, perfumery, oils, compounds or mixtures, or that any junk dealer or dealer in second-hand articles, vender of bottles, or any other person or corporation has any such bottles, boxes, siphons, tins or kegs in his, her or its possession, or secreted in any place, the said magistrate must thereupon issue a search warrant to discover and obtain the same, and may also cause to be brought before him the person in whose possession such bottles, boxes, siphons, tins or kegs may be found, and shall then inquire into the circumstances of such possession, and if such magistrate finds that such person has been guilty of a violation of section two of this act, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof. (Laws 1896, c. 933, § 4.)

§ 5. The requiring, taking or accepting of any deposit, for any purpose, upon any bottle, box, siphon, tin or keg shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this act. (Laws 1896, c. 933, § 5.)

§ 6. Any person or persons, corporation or corporations, that has or have heretofore filed in the offices mentioned in section one of this act a description of the name or names, mark or devices upon his, her, their or its property, therein mentioned, and has caused the same to be published according to the law existing at the time of such filing and publica-

tion shall not be required to again file and publish such description to be entitled to the benefits of this act. (Laws 1896, c. 933, § 6.)

§ 7. All acts and parts of acts inconsistent herewith are, for the purposes of this act, hereby repealed. (Laws 1896, c. 933, § 7.)

Sections 15 and 16, p. 2053, protect labor unions or associations in the adoption and use of their labels, marks, names, etc.

Parker's New York Penal Code 1901, Page 105.

§ 364. A person who, knowingly, in a case where provision for the punishment for the offense is not otherwise specially made by statute:

1. Falsely makes or counterfeits a trade mark; or,

2. Affixes to any article of merchandise, a false or counterfeit trade mark, knowing the same to be false and counterfeit, or the genuine trade mark, or an imitation of the trade mark of another, without the latter's consent; or,

3. Sells, or keeps, or offers for sale, an article of merchandise, to which is affixed a false or counterfeit trade mark, or the genuine trade mark, or an imitation of the trade mark of another, without the latter's consent; or,

4. Has in his possession a counterfeit trade mark, knowing it to be counterfeit, or a die, plate, brand, or other thing for the purpose of falsely making or counterfeiting a trade mark; or,

5. Makes or sells, or offers to sell or dispose of, or has in his possession with intent to sell or dispose of, an article of merchandise with such a trade mark as to appear to indicate the quantity, quality, character, place of manufacture or production, or persons manufacturing or producing the article, but not indicating it truly; or,

6. Who knowingly sells, offers or exposes for sale, any goods which are represented in any manner, by word or deed,

to be the manufacture or product of any person, firm or corporation, other than himself, unless such goods are contained in the original packages and under the labels, marks or names placed thereon by the manufacturer who is entitled to use such marks, names, brands or trade marks; or,

7. Who shall sell, or expose for sale, any goods in bulk, to which no label or trade mark shall be attached, and shall by representation, name or mark written or printed thereon, represent that such goods are the production or manufacture of a person who is not the manufacturer: is guilty of a misdemeanor. (Pen. Code, § 364.)

PAGE 149.

§ 365. The expression "article of merchandise," as used in this title, signifies any goods, wares, work of art, commodity, compound, mixture or other preparation or thing, which may be lawfully kept or offered for sale. (Pen. Code, § 365.)

§ 366. A "trade mark" is a mark used to indicate the maker, owner or seller of an article of merchandise, and includes among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label or other mark, lawfully adopted by him, and usually affixed to an article of merchandise to denote that the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him; and also a signature or mark used or commonly placed by a painter, sculptor or other artist, upon a painting, drawing, engraving, statue or other work of art, to indicate that the same was designed or executed by him. (Pen. Code, § 366.)

§ 367. A trade mark is deemed to be affixed to an article of merchandise when it is placed in any manner in, or upon, either

1. The article itself; or,

2. A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label or other thing, in, by or with which the goods are packed, enclosed or otherwise prepared for sale or disposition. (Pen. Code, § 367.)

§ 368. An "imitation of a trade mark" is that which so far resembles a genuine trade mark as to be likely to induce the belief that it is genuine, whether by the use of words or letters similar in appearance or in sound, or by any sign, device or other means whatsoever. (Pen. Code, § 368.)

Sections 369-371, pp. 150, 151, said Penal Code, authorizes any person engaged in making, bottling, etc., milk, ale, beer, cider, mineral water, or other beverage, to register a trade mark, protect him in its use, and provide penalties for invasion of his rights in connection therewith.

NORTH CAROLINA.

Code 1883, Vol. 1.

Section 1038. Every person who shall knowingly and willfully forge, or counterfeit, or cause or procure to be forged or counterfeited, the private marks, tokens, stamps or labels of any mechanic, manufacturer, or other person being a resident of this state or of the United States, with intent to deceive and defraud the purchasers, mechanics or manufacturers of any goods, wares, or merchandise whatsoever, upon conviction thereof shall be punished by a fine of not less than fifty dollars and not exceeding one thousand dollars, or by imprisonment of not less than thirty days or more than five years, or both fine and imprisonment, at the discretion of the court.

Sec. 1039. Every person who shall vend any goods, wares or merchandise having thereon any forged or counterfeited marks, tokens, stamps, or labels purporting to be the marks, tokens, stamps or labels of any person being a resident of

this state or of the United States, knowing the same at the time of the purchase thereof by him to be forged or counterfeited, shall be guilty of a misdemeanor, and punished by imprisonment in the county jail not exceeding six months, or by a fine not exceeding one hundred dollars, or by both fine and imprisonment, at the discretion of the court.

Sec. 1040. If any person shall knowingly use the mark or brand of any other person on any sack, or shall knowingly impress on any sack the mark or brand of another person, with intent to defraud or for the purpose of enhancing the value of his own property, the person so offending shall be guilty of a misdemeanor, and punished as if convicted of larceny.

NORTH DAKOTA.

REV. CODES 1899.

§ 3485. One who produces or deals in a particular thing or conducts a particular business, may appropriate to his exclusive use as a trade mark any form, symbol or name which has not been so appropriated by another to designate the origin or ownership thereof; but he cannot exclusively appropriate any designation or part of a designation which relates only to the name, quality, or the description of the thing or business, or the place where the thing is produced or the business is carried on.

§ 3486. The good will of a business is the expectation of continued public patronage, but it does not include a right to use the name of any person from whom it is acquired.

§ 3487. The good will of a business is property, transferable like any other.

§ 3979. One who sells or agrees to sell any article to which there is affixed or attached a trade mark, thereby warrants that mark to be genuine and lawfully used.

§ 3980. One who sells or agrees to sell any article to which

there is affixed or attached a statement or mark to express the quantity or quality thereof or the place where it was in whole or in part produced, manufactured or prepared thereby warrants the truth thereof.

§ 7256. Every person who willfully forges, counterfeits or procures to be forged or counterfeited any trade mark usually affixed by any person to any goods of such person, with intent to pass off any goods to which such forged or counterfeit trade mark is affixed or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

§ 7257. Every person who, with intent to defraud, has in his possession any die, plate or brand, or any imitation of the trade mark of any person, for the purpose of making any counterfeit or imitation of any description whatever of such trade mark, or of selling the same when made, or affixing the same to any goods, and selling or offering the same for sale or disposal as the original goods of any other person, and every person who so uses or sells the same, or who fraudulently uses the genuine trade mark of another with intent to sell or offer for sale or disposal, any goods not the goods of the person to whom such trade mark properly belongs, as genuine and original, is guilty of a misdemeanor.

§ 7258. Every person who either:

1. Uses or causes to be used any brand, mark, name, print, designation or description, the same as or similar to any recorded to any other person, or on the place recorded to another; or,

2. Uses or causes to be used any second hand sacks, box, barrel, can, package or other article on which has been placed any brand, mark, name, print, designation or description, the property of another, for the purposes of deception or profit, is guilty of a misdemeanor, and upon conviction thereof is punishable by fine of not less than one hundred and not exceeding one thousand dollars.

§ 7259. Every person who sells or keeps for sale any goods upon which any counterfeit trade mark has been affixed, and intended to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

§ 7260. Every person who, with intent to defraud, affixes or causes to be affixed to any goods, or to any bottle, case, box or other package containing any goods, any description of label, stamp, brand, imprint, printed wrapper, label or mark, which designates such goods by any word or token which is wholly or in part the same to the eye or to ear as the word or any of the words or tokens used by any other person as his trade mark, and every person who knowingly sells, or keeps, or offers for sale any such bottle, case, box, or other package with any such label, stamp, brand, imprint, printed wrapper, ticket or mark affixed to, or upon it, in case the person affixing or causing to be affixed such mark, or so selling or exposing or offering for sale such bottle. case, box, or other package, was not the first to employ or use such words as his trade mark, is guilty of a misdemeanor, and in addition to the punishment prescribed therefor is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

§ 7261. The words "trade mark," as used in the sections preceding, include 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 to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

§ 7262. The word "goods," as used in the sections pre-

ceding, includes every kind of goods, wares, merchandise, compound or preparation, which may be lawfully kept or offered for sale.

§ 7263. The offense of affixing a false trade mark to goods is equally complete within the meaning of sections 7256, 7259 and 7260, whether such mark is affixed to the goods themselves or to any box, bale, barrel, bottle, case, cask, wrapper or other package or vessel, or any cover or stopper thereof, in which such goods are put up.

Sections 7264-7266 protect manufacturers and bottlers of soda, mineral water, and other beverages in the use of their bottles, etc.

OHIO.

BATES' ANN. ST., 3d ED., 1787-1902.

Section 7069. Whoever vends, or keeps for sale, any goods, merchandise, mixture, or preparation upon which any forged or counterfeit stamp, brand, imprint, wrapper, label, or trade mark is placed or affixed, and intended to represent the said goods, merchandise, mixture or preparation, as the true and genuine goods, merchandise, mixture or preparation of any other person, knowing the same to be counterfeit, shall be fined not more than one hundred dollars.

Sec. 7096. Whoever willfully forges or counterfeits any representation, likeness, similitude, copy or imitation of the private brand, wrapper, label or trade mark usually affixed by any person to or upon the goods, wares, merchandise, preparation or mixture of such person, or by any maker of wine from grapes grown within this state, to the bottles or casks used by him to contain the same, with intent to pass off any work, goods, manufacture, wine, compound, preparation, or mixture, to which such forged or counterfeit representation, likeness, similitude, copy, or imitation is affixed, or intended to be affixed, as the work, goods, manufacture, wine, com-

pound, preparation or mixture of such person, shall be fined not more than five hundred dollars, or imprisoned not more than twelve months, or both.

Sec. 7098. Whoever has in his possession any die, plate, brand, engraving, printed label, stamp, imprint, wrapper, or trade mark, or any representation, likeness, similitude, copy, or imitation thereof, usually affixed by any person to or upon articles made, manufactured, prepared, or compounded by him, for the purpose of making impressions, or selling the same when made, or using the same upon any other articles made, manufactured, prepared, or compounded, and passing the same off upon the community as the original goods, manufacture, preparation, or compound of any other person, or so in fact sells or uses the same, [or] wrongfully and fraudulently uses the genuine stamp, brand, imprint, wrapper, label, or trade mark, with intent to pass off any goods, wares, merchandise, mixture, compound, or other article, not the manufacture of the person to whom such stamp, brand, imprint, wrapper, label, or trade mark properly belongs, as genuine and original, shall be fined not more than five hundred dollars, or imprisoned not more than twelve months, or both.

Sections 4364-42 to 4364-44, as amended pages 248-250, Laws of Ohio of 1902, relate to persons and corporations engaged in manufacturing, bottling, or selling ginger ale, seltzer water, soda water, mineral water, and other beverages, or other article of merchandise, medicine, compound, or preparation, and are designed to furnish protection for such persons and corporations against the unauthorized use of or injury to their bottles, boxes, casks, kegs, etc., by other parties.

Sections 4364-49 to 4364-53c, last section added, pp. 454, 455, Laws of Ohio of 1902, protect labor unions in the use of their labels, marks, names, etc.

Sections 4364-55 to 4364-61 provide that any person, firm, or corporation dealing in timber in any form shall be called and known as "timber dealers," and authorize them as such to adopt and record a trade mark, and protect them in its use on their timber, and their ownership of the timber marked therewith, and affix penalties for invasion of their rights in such trade mark and timber.

Sections 7069-1 and 7069-2 provide penalties for using a trade mark, etc., indicating sterling or sterling silver, or coin or coin silver, on any article, unless nine hundred one-thousandths part of the component parts of the metal of which the article is manufactured is pure silver.

OKLAHOMA.

Laws 1897, Ch. 40.

An act to provide a label law for the territory of Oklahoma.

Section 1. Whenever any person or any association or union of workinginen has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is

printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed or painted, stamped or impressed, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than a hundred dollars, or by imprisonment for not more than three months.

SEC. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section one of this act, may file the same for record in the office of the secretary of the territory of Oklahoma by leaving two copies, counterparts or *fac similes* thereof with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same: that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac similes* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar.

Said secretary shall deliver to such person, association or

union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of the territory shall not record for any person, mion or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement.

Sec. 4. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of the territory, under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not to exceed three months.

Sec. 5. Every such person, association or union adopting or using a label, trade mark, term, device, or form of advertisement as aforesaid may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit, damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reason-

able and shall require the defendants to pay to such person, associations or union all profits derived from such wrongful manufacture, use, display or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court or to the complainant, to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union, in any manner not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of, and for the use of, such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. This act shall take effect and be in force from and after its passage and approval.

Approved March 11, 1897.

Chapter 49, Sess. Laws 1895, protects manufacturers and dealers in carbonated goods, soda waters, and other beverages against the unauthorized use of or injury to their bottles, kegs, casks, boxes, siphons, etc., by other persons.

OREGON.

BELLINGER & COTTON'S ANN. CODES AND STATUTES, 1901.

§ 1840. If any person shall willfully and knowingly use or cause to be used any private brand, label, stamp or trade mark of another, either by counterfeiting the same or using any impression or copy thereof made or prepared by the proprietor thereof; or shall willfully and knowingly use or cause to be used any colorable imitation of such brand, label, stamp or trade mark with intent to deceive any one; or shall, with like intent, use or cause to be used any empty or second-hand package which has contained goods, wares, merchandise, article or articles of the same general character as those for which they were first used, upon conviction thereof, such person shall be punished by imprisonment in the county jail not less than one month nor more than six months, or be fined not less than twenty nor more than three hundred dollars. [As amended 1899.]

§ 4609. Any person, partnership, firm or private corporation desiring to secure within this state the exclusive use of any name, mark, brand, designation or description for any article of manufacture or trade, or for any mill, hotel, factory, machine shop or other place of business, shall deliver or cause to be delivered to the secretary of state a particular description or a *fac simile* of such mark, brand, name, designation or description as he may desire to use.

§ 4610. If there be not already a claim filed with the secretary of state for the same or a similar name, mark, brand, designation, or description, he shall immediately record the one furnished in a book to be specially provided and kept by him for such purpose, which book shall be kept at all times subject to public inspection and examination. If there be already filed the same or a similar brand, mark, designation or description, the secretary shall so inform the applicant, and shall not record the same.

§ 4611. Any person, partnership, firm or corporation that shall use or cause to be used any name, mark, brand, designation or description the same as or similar to one so secured or recorded, for the purpose of deception or profit, shall forfeit to the use of the owner of the name, mark, brand, designation or description so taken or imitated, one-half of the property, goods or articles of trade upon which the same may be used or placed, or the value thereof, to be recovered by the said owner in any court having jurisdiction of the subject-matter.

§ 4612. Any person, partnership, firm or private corporation that shall use any such mark, brand, name, designation or description a second or greater number of times shall forfeit the whole of the property or article upon which the same is placed or used, or the value thereof, to be recovered in the manner provided in the preceding section.

§ 4613. Any person, partnership, firm or private corporation that shall use or cause to be used any second-hand sack, box, barrel, can, package, or other article on which has been placed any name, mark, brand, designation or description, the property of another, for the purpose of deception, shall be liable to the same forfeiture of the property inclosed therein as is provided in sections 4611 and 4612.

§ 4614. If any goods, wares, merchandise, or other articles, shall be imported into this state on which shall be used, for the purpose of deception, the same or any similar mark, name, brand, designation or description, as may have been secured under the provisions of this chapter, said goods, wares, merchandise or other articles shall be forfeited to the use of the party injured as provided in sections 4611 and 4612.

§ 4615. A fee of two dollars and a half shall be paid to the secretary of state by the owner of said trade mark. as pay for recording.

§ 4616. Nothing in this act shall be construed so as to affect the power of courts of equity to perpetually restrain by injunction the improper use of any mark, brand, name, description, or designation which may have been secured by the provisions of this chapter.

Sections 1841 to 1848, inclusive, protect any person or any association or union of workingmen in the adoption and use of a label, trade-mark, term, design, device, or form of advertisement, for certain purposes.

PENNSYLVANIA.

PEPPER & LEWIS' DIG., 1700 to 1894, PAGE 1207.

279. If any person shall knowingly and willfully forge or counterfeit, or cause or procure to be forged or counterfeited, any representation, likeness, similitude, copy or imitation of the private stamps, wrappers or labels usually affixed by any mechanic or manufacturer to and used by such mechanic or manufacturer on or in the sale of any goods, wares or merchandise, with intent to deceive or defraud the purchaser or manufacturer of any goods, wares or merchandise whatsoever, such person shall be guilty of a misdemeanor and, on conviction thereof, be sentenced to pay a fine not exceeding one hundred dollars, and undergo an imprisonment not exceeding two years. (1860, March 31; P. L. 382, § 173.)

280. If any person shall have in his possession any die, plate, engraving or printed label, stamp or wrapper, or any representation, likeness, similitude, copy or imitation of the private stamp, wrapper or label usually affixed by any mechanic or manufacturer to and used by such manufacturer or mechanic on or in the sale of any goods, wares or merchandise, with intent to use or sell the said die, plate, engraving or printed stamp, label or wrapper, for the purpose of aiding or assisting, in any way whatever, in vending any goods,

wares or merchandise, in imitation of or intended to resemble and to be sold for the goods, wares or merchandise of such mechanic or manufacturer, such person shall be guilty of a misdemeanor, and, upon being thereof convicted, be sentenced to pay a fine not exceeding one hundred dollars, and to undergo an imprisonment not exceeding one year. (1860, March 31; P. L. 382, § 174.)

281. If any person shall vend any goods, wares or merchandise, having thereon any forged or counterfeited stamps or labels of any mechanic or manufacturer, knowing the same to be forged or counterfeited, and resembling or purporting to be imitations of the stamps or labels of such mechanic or manufacturer, without disclosing the fact to the purchaser thereof, such person shall, upon conviction, be deemed guilty of a misdemeanor, and be sentenced to pay a fine not exceeding five hundred dollars. (1860, March 31; P. L. 382, § 175.)

No. 286, Laws 1901.

An act to provide for the registration of labels, trade-marks, trade-names, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions, or forms of advertisement, and protect and secure the rights, property and interest therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violations of the act.

Section 1. Be it enacted, etc., that whenever any person or persons, copartnership or corporation, has heretofore adopted or used, or shall hereafter adopt or use, any label, trade-mark, trade-name, device, shopmark, designation or form or advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor, as having been manufactured, prepared, packed, bottled or placed on sale by such person or

persons, copartnership or corporation, he or they, if residents of or doing business in the United States, may file the same for record in the office of the secretary of state of the state of Pennsylvania, by leaving two copies, counterparts or *facsimiles* thereof with said secretary; and shall file therewith a certificate, specifying the names of the person or persons, copartnership or corporation, so filing such label, trade-mark, trade-name, device, brand, shopmark, designation or form of advertisement; his or its residence, location or place of business; the class of merchandise, and the particular description of goods comprised therein, the class to which it has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. Such certificate shall be accompanied by the written declaration verified under oath by the person or one of [the] persons, or some member of the copartnership or officer of the corporation, by whom it is filed, to the effect that the party so filing such label, trade-mark, trade-name, device, shopmark, designation, description, or form of advertisement, has the right to the use of the same, and that no other person or persons, copartnership or corporation, has a right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *facsimiles*, copies or counterparts filed therewith are true and correct. There shall be paid to such secretary, for such filing, a fee of one dollar. Said secretary shall deliver to such person or persons, copartnership or corporation, so filing the same, a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade-mark, trade-name, stamp, design, device, term, brand, shopmark, designation, description or form of advertisement. No label, trade-mark, trade-name, stamp, design, device,

term, brand, shopmark, designation, description, or form of advertisement shall be recorded that would reasonably be mistaken for the label, trade-mark, trade-name, stamp, design, device, term, brand, designation, shopmark, description, or form of advertisement, already filed of record.

Section 2. That the secretary of state is authorized to make rules and regulations, and prescribe forms, for the filing of labels, trade-marks, trade-names, stamps, designs, devices, terms, brands, designations, shopmark, descriptions, and forms of advertisement, under the provisions of this act.

Section 3. That whenever [any] person or persons, copartnership or corporation, has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, as herein provided, it shall be unlawful, and a violation of this act, for any other person, copartnership or corporation to make any use, sale, offer for sale, or display of the genuine label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof as shall be calculated or liable to deceive, of any such person or persons, copartnership or corporation, filing the same; or to sell, offer to sell or dispose of, any goods, wares or merchandise, in bulk or in any box, case, can, bottle or package, to or which any such genuine label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, filed for record as aforesaid, or any such likeness or imitation thereof is attached, affixed or displayed; or to make any wrongful use whatever of any such genuine label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof; or to, in any way, use the name or seal of any such person or persons, copartnership or corporation, or any such likeness or

imitation thereof, in and about the sale of goods or otherwise, without first obtaining in every such case the license, consent or authority of the person or persons, copartnership or corporation, adopting, filing and registering the same; and it shall be unlawful for any other person or persons, firm, copartnership or corporation to make any use of such label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, so filed, or any such likeness or imitation thereof, or utter or display the same orally or in any printed or written form in the conduct of his business or in any business transaction, attached to merchandise or products of labor, or detached from and independent of the same, on invoice, letter-heads, bills or advertisements, without express consent, license and authority of the person or persons, copartnership or corporation, so filing the same; and any such license, consent or authority may be revoked and terminated at any time, upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof. He [the secretary of state] shall refuse to file or register any label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, identical with, or so similar to as to be calculated or liable to deceive, any label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, filed or registered, unless it shall be proved to his satisfaction that the person or persons, copartnership or corporation, lastly applying for the registry of such label, trade-mark, trade-name, device, shopmark, designation, or form of advertisement, shall be entitled thereto, and the owner thereof by right of prior adoption; in which case the date of the adoption shall determine the ownership, and shall be proved by affidavits of persons conversant with such dates. In the case the secretary of state becomes satisfied, after hearing the said af-

fidavits, that the person or persons, copartnership or corporation, last applying for registry is entitled to priority of adoption to register such trade-mark, trade-name, device, shop-mark, designation, or form of advertisement, he shall revoke the first registry thereof, and re-register the same in the name of said applying person or persons, copartnership or corporation.

Section 4. That any person or persons who shall hereafter wrongfully perform, or permit to be performed, any act expressly prohibited or declared unlawful by section three of this act, shall be subject to a penalty of two hundred dollars, to be sued for in any court having jurisdiction for a fine or penalty, by any person or persons, copartnership or corporation, aggrieved in the matter; and the court having jurisdiction of the parties shall grant an injunction restraining the defendant from such unlawful acts, and in addition to the penalty provided for in this section shall award to the plaintiff such damages, resulting from such wrongful and unlawful acts, as may be proved, and shall require the defendant to pay to the plaintiff the profits derived from such unlawful acts.

Section 5. That all acts and parts of acts contrary to or inconsistent with the provisions of this act be and the same are hereby repealed: provided, that the provisions of this act shall not in any way affect, or interfere with the provisions of the act of Assembly, entitled "An act to provide for the adoption of trade-marks, labels, symbols, or private stamps by any incorporated or unincorporated association or union of workingmen, and to regulate the same," approved May twenty-one, Anno Domini one thousand eight hundred and ninety-five, or with the amendments thereto, approved May two, Anno Domini one thousand nine hundred and one.

Section 6. That this act shall take effect immediately.

Approved the 20th day of June, A. D. 1901.

The act of May 8, 1889 (Pepper & Lewis' Dig. p. 433), authorizes

the registering of bottles used by manufacturers or vendors of beverages or other articles of merchandise, and protects them against the unauthorized use of or injury to such bottles by other persons.

The act of April 4, 1865 (Pepper & Lewis' Dig. p. 439), is designed to furnish protection to brewers of malt liquors against the unauthorized use of refilling of their vessels by other parties.

The act, p. 613, Supplement, vol. 3, Pepper & Lewis' Dig. 1894 to 1897, as amended by Act No. 84, P. L. 1901, provides for adoption of trade-marks, labels, etc., by any incorporated or unincorporated association or union of workingmen, and for regulation of same, and is exempted from repeal by section 5 of Act No. 286, P. L. 1901, above quoted.

RHODE ISLAND.

Public Laws of 1900-1, Ch. 735.

An act for the protection of labels and seals of labor organizations, associations, and societies in the state of Rhode Island and Providence Plantations.

Section 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trade-mark, term, design, device, or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor as having been made, manufactured, produced, prepared, packed, or put on sale by such person, or association or union of workingmen, or by a member, or members, of such association or union, it shall be unlawful to counterfeit or imitate such label, trade-mark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trade-mark, term, design, device, or form of advertisement.

Sec. 2. Whoever knowingly counterfeits or imitates any such label, trade-mark, term, design, device, or form of advertisement which has been filed and recorded in the office of the secretary of state as hereinafter provided; or knowingly

sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trade-mark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowingly sells or disposes of any goods, wares, merchandise, or other product of labor contained in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed; or knowingly keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

Sec. 3. Every such person, association, or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade-mark, term, design, device or form of advertisement as provided in section 1 of this act, shall file the same for record in the office of the secretary of state by leaving two copies, counterparts, or *facsimiles* thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association, or union on whose behalf such label, trade-mark, term, design, device, or form of advertisement shall be filed; the class of merchandise, and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade-mark, term, design, device, or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm,

association, union, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *facsimile* or counterparts filed therewith are true and correct, before there shall be any liability to any suit or proceeding for any violation of this act. There shall be paid for such filing and recording a fee of one dollar. Said secretary of state shall cause a description of such label, trade-mark, term, design, device, or form of advertisement to be published once a week for three successive weeks, at the expense of the applicant, in some newspaper published in the city of Providence. After such publication said secretary shall deliver to such person, association, or union so filing or causing to be filed any such label, trade-mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association, or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in suits and prosecutions under this act be sufficient proof of the adoption of such label, trade-mark, term, design, device, or form of advertisement. Said secretary of state shall not record for any person, union, or association any label, trade-mark, term, design, device, or form of advertisement that would probably be mistaken for any label, trade-mark, term, design, device, or form of advertisement theretofore filed by or on behalf of any other person, union, or association.

Sec. 4. Any person who shall, for himself or on behalf of any other person, association, or union, procure the filing of any label, trade-mark, term, design, or form of advertisement in the office of the secretary of state under the provisions of this act by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sus-

tained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months. In any suit or prosecution under the provisions of this act, the defendant may show that he or it was the owner of such label, trade-mark, term, design, device, or form of advertisement prior to its being filed under the provisions of this act, and that it had been filed wrongfully or without right by some other person, association or union.

Sec. 5. Every such person, association, or union adopting or using a label, trade-mark, term, design, device, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction may grant injunctions to restrain such manufacture, use, display, or sale, and may award the complainant in any such suit damages resulting from such manufacture, use, sale, or display, as may be by the said court deemed just and reasonable, and may require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display, or sale; and such court may also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union, on behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods or otherwise,

not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by fine of not more than one hundred dollars.

Sec. 7. The provisions of this act shall not abridge any rights to any trade-marks existing at the time of the passage of this act, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trade-marks.

Sec. 8. The district courts of the several judicial districts shall have jurisdiction of all complaints for violation of this act.

Sec. 9. This act shall take effect and be in force from and after the first day of June, A. D. 1900, and all acts and parts of acts inconsistent herewith are hereby repealed.

Chapter 627, Pub. Laws 1898-1899, affords protection to manufacturers, bottlers, and vendors of soda water, mineral water, ale, beer, or other liquids that may be used as food or beverages, or medicines, perfumery, oils, compounds, etc., in the use of their bottles, barrels, kegs, casks, cans, etc., and prohibits the unauthorized use of or the defacement of names, marks, etc., upon such bottles, barrels, kegs, casks, cans, etc., by other parties.

SOUTH CAROLINA.

No. 601, Laws 1902, protects manufacturers, bottlers, and vendors of soda water, mineral waters, and other beverages against the unauthorized refilling or sale of, or defacement of names and marks upon, their bottles, siphons, casks, boxes, etc., by other persons.

SOUTH DAKOTA.

ANN. ST. 1901.

3588. There may be ownership of * * * the goodwill of a business, trade-marks and signs, and of rights created or granted by statute.

4387. One who produces or deals in a particular thing

or conducts a particular business, may appropriate to his exclusive use as a trade mark any form, symbol or name which has not been so appropriated by another to designate the origin or ownership thereof; but he cannot exclusively appropriate any designation or part of a designation which relates only to the name, quality, or the description of the thing or business, or the place where the thing is produced or the business is carried on.

4388. The goodwill of a business is the expectation of continued public patronage, but it does not include a right to use the name of any person from whom it is acquired.

4389. The goodwill of a business is property, transferable like any other.

4825. One who sells or agrees to sell any article to which there is affixed or attached a trade mark, thereby warrants that mark to be genuine and lawfully used.

4826. One who sells or agrees to sell any article to which there is affixed or attached a statement or mark to express the quantity or quality thereof, or the place where it was in whole or in part produced, manufactured or prepared, thereby warrants the truth thereof.

7875. Every person who willfully forges, counterfeits or procures to be forged or counterfeited any trade mark usually affixed by any person to any goods of such person, with intent to pass off any goods to which such forged or counterfeit trade mark is affixed or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

7876. Every person who, with intent to defraud, has in his possession any die, plate or brand, or any imitation of the trade mark of any person, for the purpose of making any counterfeit or imitation of any description whatever of such trade mark, or of selling the same when made, or affixing the same to any goods, and selling or offering the same for sale or disposal as the original goods of any other per-

son, and every person who so uses or sells the same, or who fraudulently uses the genuine trade mark of another, with intent to sell or offer for sale or disposal, any goods not the goods of the person to whom such trade mark properly belongs, as genuine and original, is guilty of a misdemeanor.

7877. Every person who sells or keeps for sale any goods upon which any counterfeited trade mark has been affixed, intended to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

7878. Every person who, with intent to defraud, affixes or causes to be affixed to any goods, or to any bottle, case, box or other package containing any goods, any description of label, stamp, brand, imprint, printed wrapper, label or mark, which designates such goods by any word or token which is wholly or in part the same to the eye or to ear as the word or any of the words or tokens used by any other person as his trade mark, and every person who knowingly sells, or keeps, or offers for sale any such bottle, case, box, or other package with any such label, stamp, brand, imprint, printed wrapper, ticket or mark affixed to, or upon it, in case the person affixing or causing to be affixed such mark, or so selling or exposing or offering for sale such bottle, case, box or other package, was not the first to employ or use such words as his trade mark, is guilty of a misdemeanor, and in addition to the punishment prescribed therefor is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

7879. The word "trade mark," as used in the sections preceding, 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 to denote any goods to be goods

imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

7880. The word "goods," as used in the sections preceding, includes every kind of goods, wares, merchandise, compound or preparation, which may be lawfully kept or offered for sale.

7881. The offense of affixing a false trade mark to goods is equally complete within the meaning of sections sixty-six hundred and twelve, sixty-six hundred and fourteen and sixty-six hundred and fifteen,* whether such mark is affixed to the goods themselves or to any box, bale, barrel, bottle, case, cask, wrapper or other package or vessel, or any cover or stopper thereof, in which such goods are put up.

Sections 3347 to 3351 and 7882 to 7884 protect manufacturers and bottlers of soda, mineral water, and other beverages in the use of their bottles, etc.

Sections 3352 to 3357, inclusive, protect labor unions and associations in the use of their labels, etc.

TENNESSEE.

Acts of 1897, Ch. 107.

An act to provide for the filing and recording by any person or association or union of workingmen, of a label, trade mark, term, design, device or form of advertisement for the purpose of designating or making known or distinguishing any goods, wares or other products of labor as having been made, manufactured, produced or put on sale by such person, association or union of workingmen or by a member of such union or association,

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*Sections 7875, 7877, and 7878 are the sections here intended to be referred to. In the Dakota Code of 1887 these sections were numbered 6612, 6614, and 6615. respectively; and in section 3351, section 3347 is referred to as 2443.

and to prohibit the counterfeiting or imitation or unauthorized use of such label, trade mark, term, design, device or form of advertisement, and to prescribe punishment for a violation of the provisions of this act.

Section 1. That whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement, for the purpose of designating, making known or distinguishing any goods, wares, merchandise, or other products of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, or association, or union of workingmen, or by a member or members of such association, or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trade mark, term, device or form of advertisement.

Sec. 2. That whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor

in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

SEC. 3. That every person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section 1 of this act, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dolllar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade mark, term, design, de-

vice or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

Sec. 4. That any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by, or on behalf of, the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months.

Sec. 5. That every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit, the court having jurisdiction, such damages resulting from such manufacture, use, sale or display as may be by the court or jury deemed just and reasonable; and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case, be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 6. That every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred ($100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. That any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. That this act shall take effect and be in force from and after its passage, the public welfare requiring it.

Approved February 6, 1897.

TEXAS.

General Laws 1895, Ch. 81.

An act to protect persons, associations, private corporations and unions of workingmen, incorporated or unincorporated, in their labels, trade marks, designs, devices, imprints, and forms of advertising and names; and to prescribe penalties for violation of same, and to repeal all laws or parts of laws in conflict with this act.

Section 1. That whenever any person, association, private corporations or union of workingmen, incorporated or unin-

corporated, have adopted or shall hereafter adopt for their protection any label, trade mark, design, device, imprint or form of advertisement, indicating that goods to which such label, trade mark, design, device, imprint or form of advertisement shall be attached, were manufactured by such person, association, private corporations or union, or by a member or members of such association or union, it shall be unlawful for any person, inclusive of officers, agents, receiver or receivers of corporations, to counterfeit or imitate such label, trade mark, design, device, imprint or form of advertisement or to use such counterfeit or imitation of such label, trade mark, design, device, imprint or form of advertisement, knowing the same to be counterfeit or imitation, or to aid, assist, countenance or knowingly permit such counterfeit or imitation or the use of such counterfeit or imitation for his own use or benefit, or for the use or benefit of any corporation of which he may then be an officer, agent or receiver. Every person, whether in his individual capacity or as an officer, agent or receiver of a corporation, violating this section, shall, upon conviction, be punished by a fine of not less than twenty-five nor more than one hundred dollars. Each day's violation of this section shall be considered a separate offense.

Sec. 2. Every person, whether in his individual capacity or as the officer, agent or receiver of a corporation, who shall willfully and knowingly use or display the genuine label, trade mark, design, device, imprint, or form of advertisement, or name of any such person, association or union, incorporated or unincorporated, not being authorized to use or display the same, or shall aid, assist, countenance or knowingly permit the use of same, not being authorized to use the same, shall, upon conviction, be punished by fine of not less than twenty-five nor more than one hundred dollars.

Sec. 3. Every person, association or union of workingmen, incorporated or unincorporated, having adopted a label, trade

mark, design, device, imprint or form of advertisement, as aforesaid, may proceed by suit to enjoin the wrongful manufacture, use, display or sale of any such label, trade mark, design, device, imprint or form of advertisement, and the manufacture, use, display or sale of any such counterfeit or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the plaintiff in such suit such damages resulting from such wrongful manufacture, use, display or sale as by him may have been sustained. Where such association or union is not incorporated suits under this act may be commenced and prosecuted by any officer or member of such association or union in his own name, for himself and for the use and benefit of such association or union.

Sec. 4. Every person, association or union of workingmen, incorporated or unincorporated, that has heretofore or shall hereafter adopt a label, trade mark, design, device, imprint or form of advertisement, shall file the same in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state, and said secretary shall deliver back to such person, association or union so filing the same one of said copies, counterparts or *fac similes,* along with and attached to a duly attested certificate of the filing of same, for which he shall receive a fee of one dollar from such person, association or union. Such certificate of filing shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, design, device, imprint or form of advertisement, and of the right of such person, association or union to adopt the same. No label, trade mark, design, device, imprint or form of advertisements shall be filed as aforesaid that would probably be mistaken for a label, trade mark, design, device, imprint or form of advertisement already of

record: provided, that no person or association shall be permitted to register as a label, trade mark, design, device, imprint or form of advertisement, any emblem, design or resemblance thereto that has been adopted or used by any charitable, benevolent or religious society or association without their consent: and provided, further, that all persons, institutions or associations now using a label, trade mark, design, device, imprint or form of advertisement shall have thirty days' time after this act takes effect in which to file such label, trade mark, design, device, imprint or form of advertisement under the provisions of this act, before the same can be registered by others.

Sec. 5. All laws and parts of laws in conflict with the provisions of this act be and the same are hereby repealed.

Sec. 6. It being important that the benefits of this act be realized at once, because the parties to be benefited by this act have no adequate protection under existing laws, creates an emergency and an imperative public necessity that the constitutional rule requiring bills to be read on three several days be suspended, and that this act take effect and be in force from and after its passage, and it is so enacted.

Approved April 29, 1895.

In Wilson's Tex. Crim. St. 1897, sections 1 and 2 of the above act appear as articles 918d and 918e, respectively, of the Penal Code, and sections 3 and 4 appear as articles 318c and 318d, respectively, at page 148 of Sayles' Civ. St. Tex. 1897.

Articles 318a, 318b, p. 148, Sayles' Civ. St. Tex. 1897, and articles 918a (as amended by chapter 110, p. 288, Gen. Laws 1901), 918b, 918c, Wilson's Crim. St. Tex. 1897, p. 390, Penal Code, protect manufacturers or dealers in mineral water and other beverages, and manufacturers of medicines or other compounds, against the unauthorized use or sale of or injury to their bottles, boxes, siphons, etc., by other persons.

UTAH.

Rev. St. 1898.

Section 2720. The phrase "trade mark" as used in this

title includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, tradesman, association, or union, whether incorporated or unincorporated, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, or by such association or union, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Sec. 2721. Any person, association or union, may record any trade mark or name, by filing with the secretary of state his or its claim to the same, and a copy or description of such trade mark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he, or the firm, corporation, association or union of which he is a member, is the exclusive owner, or agent of the owner, of such trade mark or name.

Sec. 2722. The secretary of state must keep for public examination a record of all trade marks or names filed in his office, with the date when filed and name of claimant; and must at the time of filing collect from each claimant the authorized fee.

Sec. 2723. Any person who has first adopted and used a trade mark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain by injunction, and award damages for, any use of trade marks or names in violation of this title.

Sec. 4482. Every person who willfully forges or counterfeits, or procures to be forged or counterfeited, any trade mark usually affixed by any person or by any association or

union of workingmen to his goods, which has been recorded in the office of the secretary of state, with intent to pass off any goods to which such forged or counterfeited trade mark is affixed, or intended to be affixed, as the goods of such person or such association or union of workingmen, is guilty of a misdemeanor.

Sec. 4483. Every person who sells, or keeps for sale, any goods upon or to which any counterfeited trade mark has been affixed, after such trade mark has been recorded in the office of the secretary of state, intending to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

Sec. 4484. The phrases "forged trade mark" and "counterfeited trade mark," or their equivalents, as used in this chapter, include every alteration or imitation of any trade mark so resembling the original as to be likely to deceive.

Sec. 4485. The phrase "trade mark," as used in the three preceding sections, 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, or by any association or union of workingmen, to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, or by such association or union of workingmen, other than any name, word or expression generally denoting any goods to be of some particular class or description.

Sec. 4486. Every person who has or uses any cask, bottle, vessel, case, cover, label, or other thing bearing or having in any way connected with it the duly filed trade mark or name of another, for the purpose of disposing with intent to deceive or defraud, or any article other than that which such cask, bottle, vessel, case, cover, label, or other thing originally contained or was connected with by the owner of such trade mark or name, is guilty of a misdemeanor.

Chap. 119, Laws Utah 1901, is "An act in relation to the brands

and property marks of bottles, kegs, etc., and tools, etc., and for the protection of owners thereof, and providing a penalty for the violation hereof."

VERMONT.

Laws of 1898.

Public Act No. 158.

An act to provide for the registration of trade marks.

Section 1. Any person, partnership or corporation may adopt as and for his or their trade mark or trade name any particular name, term, design, device, label, stamp or form of advertisement, not previously owned or adopted by any other person, partnership or corporation, to designate or distinguish any goods, wares or merchandise by him or them manufactured or prepared, and may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the said secretary; and shall also file therewith an accurate description of such name, term, design or device, label, stamp or form of advertisement, verified under oath by the person or some officer of the partnership or corporation by whom it is filed.

There shall be paid for such filing the fee of two dollars.

Said secretary shall deliver to such person, partnership or corporation so filing the same, a duly attested certificate of the record of the same, for which he shall receive the fee of two dollars. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such trade mark or trade name. No name, term, design, device, label, stamp or form of advertisement shall be recorded that in any way resembles or would be reasonably mistaken for a name, term, design, device, label, stamp or form of advertisement already on record.

Sec. 2. The secretary of state is authorized to make rules

and regulations and prescribe forms for the filing of names, terms, designs, devices, labels, stamps and forms of advertisement under the provisions of this act.

Sec. 3. Every person who, without authority from the owner of a trade mark or trade name adopted and recorded as aforesaid, shall knowingly and willfully make or sell any representation, likeness, similitude, copy, imitation or counterfeit of such trade mark or trade name, and every person who, without authority from such owner, shall affix, impress or use such trade mark or trade name upon any goods, wares or merchandise shall be punished by a fine not exceeding one thousand dollars or by imprisonment not exceeding one year, or by both said fine and imprisonment.

Sec. 4. Every person who shall knowingly and willfully sell or keep for sale any goods upon which or in connection with which shall be affixed any forgery, imitation or counterfeit of a trade mark or trade name adopted and recorded as aforesaid, and intended to represent the said goods as the genuine goods of any other person, shall be punished by a fine not exceeding one thousand dollars or by imprisonment not exceeding one year, or by both such fine and imprisonment.

Sec. 5. Every person who shall, with intent to defraud any other person, partnership or corporation, knowingly affix or cause to be affixed to or upon any package or bottle containing any goods, wares or merchandise any name, term, design, device, label, stamp or form of advertisement, which shall designate such goods, wares or merchandise, either wholly or in part by a word or words, or by general design, which shall be wholly or in part the same either in appearance to the eye, or in sound to the ear, as the word or words or the general design of any trade mark or trade name adopted and recorded, as provided in this act, or who shall knowingly sell, or expose for sale, any such package or bottle with any such imitating or

counterfeit name, term, design, device, label, stamp or form of advertisement, may also be punished by imprisonment not exceeding one year, or by a fine of not more than five hundred dollars, or by both such fine and imprisonment.

Sec. 6. The owner of any trade mark or trade name adopted and recorded as provided in section 1 of this act may proceed by suit to enjoin any and all other persons, partnerships or corporations from the manufacture, use or sale, without the authority of said owner, of all likenesses, similitudes, copies, imitations or counterfeits thereof, and also from selling or exposing for sale any and all goods, compounds, or preparations to or with which such unauthorized likenesses, similitudes, copies, imitations or counterfeits shall be affixed or connected. And all courts having jurisdiction in equity may grant injunctions to restrain and enjoin such manufacture, use, sale and exposure for sale, and may award to the complainant in such suit such a sum of money as shall be just and reasonable compensation for the damage to the reputation of the complainant's genuine goods, compounds or preparations by reason of such wrongful manufacture, use, sale or exposure for sale; and may also require the defendant to pay to the complainant in such suit a sum equal to the amount which the complainant would have received for the same quantity of genuine goods, compounds or preparations, and may also order that all such likenesses, similitudes, copies, imitations or counterfeits in the possession of or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Approved November 22, 1898.

VIRGINIA.

SECTION 1906d, PAGE 225, SUPPLEMENT (1898) TO CODE (ACTS 1897-98, CH. 33).

To protect labels, trade marks, terms, etc., of labor associations and organizations.

1. That whenever any person or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertising for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, and has filed and recorded the same as hereinafter provided, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device, or form of advertisement.

2. Whoever counterfeits or imitates any such label, trade mark, term, design, device, or form of advertisement, or knowingly and with intent to deceive, sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device, or form of advertisement, or knowingly and with intent to deceive, keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which, or on which, any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly and with intent to deceive, knowingly sells or disposes of any goods, wares, merchandise, or other product of labor contained in any box, case, can or package, to which, or

on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or knowingly and with intent to deceive, keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor in any box, case, can or package to which, or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement as provided in section one of this act, may file the same for record in the office of the secretary of the commonwealth by leaving two copies, counterparts or *fac similes* thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has a right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording to the commonwealth a tax of two dollars and fifty cents. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or

union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of the commonwealth shall not record for any person, union or association, any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design, or form of advertisement in the office of the secretary of the commonwealth under the provisions of this act, by making any false or fraudulent representations, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

5. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunction to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and shall require the defendant to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that any such counterfeits or imitations in the posses-

sion or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

6. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Section 906a, pp. 220-222, Supplement (1898) to Code, protects manufacturers, bottlers, and vendors of soda water and other beverages or medicines or other compounds against the unauthorized use or sale of, or defacement of marks upon, their bottles, kegs, siphons, etc., by other persons.

Section 1906c, pp. 223-225, Supplement (1898) to Code, authorizes "timber dealers" to adopt and record a trade-mark, and protects them in its use, and their timber marked with it, and provides penalties for invasion of their rights therein.

WASHINGTON.

BALLINGER'S ANN. CODES & STATUTES, 1897.

Of Trade Marks.

§ 3621. Whenever any person or any association or un-

ion of workingmen has heretofore adopted or used, or shall hereafter adopt or use and has filed as hereinafter provided any label, trade mark, term, design, device or form of advertisement, for the purpose of designating, making known or distinguishing any goods, wares, merchandise, or other products of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, or association, or union of workingmen, or by a member or members of such association, or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trade mark, term, device or form of advertisement. [Laws 1897, p. 65, § 1.]

§ 3622. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more more than one hundred dollars, or by imprisonment for not more than three months. [Laws 1897, p. 65, § 2.]

§ 3623. Every person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section one of this act, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of two dollars. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement

theretofore filed by or on behalf of any other person, union or association. [Laws 1897, p. 66, § 3.]

§ 3624. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by, or on behalf of, the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months. [Laws 1897, p. 67, § 4.]

§ 3625. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit, damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable; and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant, to be destroyed. [Laws 1897, p. 67, § 5.]

§ 3626. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner not being authorized so to do by such person, union or associa-

tion, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union. [Laws 1897, p. 67, § 6.]

§ 3627. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars. [Laws 1897, p. 68, § 7.]

§ 3628. Any person using the trade mark so adopted and filed by any other person, or any imitation of such trade mark, or any counterfeit thereof; or who shall, in any manner mutilate, deface, destroy or remove such trade mark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second hand package which has contained the same or been used therefor, with the intention of using such empty or second hand package, or of the same being used to contain goods, wares, merchandise, article or articles of the same general character as those for which they were first used; and any person who shall use any such empty or second hand package for the purpose aforesaid, without the consent in writing of the person whose trade mark was first applied thereto or placed thereon shall, upon conviction thereof, be fined in any sum not less than one hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles, contained in any such second hand package or packages shall be forfeited to the original user of

such package or packages whose trade mark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular article or package shall be held to be a separate offense. [Laws 1897, p. 68, § 8.]

§ 3629. The word "person," in this act, shall be construed to include a person, co-partnership, corporation, association or union of workingmen. [Laws 1897, p. 68, § 9.]

§ 3630. Sections 3125, 3126, 3127, 3128, 3129 and 3130 of volume 1, Hill's Annotated Statutes and Codes of Washington, and all acts amendatory thereof, be and the same are hereby repealed. [Laws 1897, p. 68.]

This act constitutes chapter 4, tit. 20, in Ballinger's Annotated Codes & Statutes of Washington 1897.

Chapter 38, Laws 1897 (chapter 5, tit. 20, Ballinger's Ann. Codes & Statutes 1897), protects manufacturers, bottlers, and vendors of ale, beer, and other beverages against the unauthorized use or sale or wanton destruction of their casks, barrels, kegs, bottles, or boxes by other persons.

WEST VIRGINIA.

ACTS OF 1901 (REG. SESS.), CH. 5.

An act providing for the protection of union labels and trade marks.

1. Whenever any person, firm or corporation, or any association or union of working men, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the use of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, firm, corporation or association or union of workingmen, or by a member or members of such association or union, and shall register the same as provided in section three of this act, it shall be unlawful to knowingly counterfeit or imitate such label, trade mark,

term, design, device or form of advertisement, or to knowingly use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

2. Whoever so knowingly counterfeits or imitates any such registered label, trade mark, term, design, device or form of advertisement; or knowingly sells, or offers for sale, or in any way utters or circulates any counterfeit or imitation of any such registered label, trade mark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, stamped or impressed, shall be punished by a fine of not more than five hundred dollars or by imprisonment for not more than three months, or by both such fine and imprisonment.

3. Every such person, firm, corporation, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement as provided in section one of this act, shall register the same by filing the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with said secretary and by filing therewith a sworn application specifying

the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement, shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to use the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac similes* or counterparts filed therewith are true and correct. There shall be for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association, or union, so filing or causing to be filed any such label, trade-mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, firm, corporation, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificates of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such labels, trade marks, terms, designs, devices or forms of advertisement. Said secretary of state shall not record for any person, union, or association, any label, trade mark, term, design, device or form of advertisement, that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, firm, corporation, union or association. But the said secretary shall file and record under this act any label, trade mark, term, design, device or form of advertisement, which may have been previously filed by any person, firm, corporation or any association or union of workingmen, provided the person, firm, corporation, association or union seeking

to file and record under this act is the same person, firm, corporation, association or union that previously filed or recorded the same label, trade mark, term, design, device or form of advertisement.

4. Any person who shall for himself, or on behalf of any other person, firm, corporation, association or union, procure the filing of any label, trade mark, term, design, or form of advertisement, in the office of the secretary of state under the provisions of this act, by making any known false or fraudulent representations, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars or by imprisonment not exceeding three months, or by both such fine and imprisonment.

5. Every such person, firm, corporation, association or union adopting or using any such registered label, trade mark, term, design, device or form of advertisement, as aforesaid, may proceed by suit for damages to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and award the complainant in any such suit damages resulting from such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union, all profits derived from such wrongful manufacture, use, sale or display; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

6. Every person, firm, corporation or union, who shall knowingly use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, firm, corporation, association or union when registered as aforesaid, in any manner, not being authorized so to do by such person, firm, corporation, association or union, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than three hundred dollars. In all cases where such association or union is not incorporated suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

7. Any person, firm, corporation, association, or union, who shall in any way knowingly use the name or seal of any such person, firm, corporation, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars.

8. Nothing contained in this act shall be construed as affecting or impairing any right or remedy at law or in equity now existing for the protection of any label, trade mark, term, design, device or form of advertisement, whether or not the same is registered under the provisions hereof.

Code of W. Va. (1899) pp. 1141, 1142 (chapter 15 of the Acts of 1897), is designed to protect persons and corporations engaged in manufacturing or selling mineral waters, malt liquors, and other beverages, against the unauthorized use of their bottles by other parties.

WISCONSIN.

GEN. ST. 1898.

Section 1747a. Any person, association or union of workingmen which has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person, association or union or by a member or members thereof may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof with said secretary and by filing therewith a sworn statement specifying the name of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement is to be filed, the class of merchandise and a separate description of the goods to which the same has been or is intended to be appropriated, that the party on whose behalf such label, trade mark, term, design, device or form of advertisement is to be filed has the right to the use of the same, and that no other person, firm, association, union or corporation has such right either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the copies, counterparts or *fac similes* filed therewith are correct. The papers so required to be filed shall be recorded in a book kept for that purpose, and there shall be paid the secretary of state for such recording and filing one dollar.

Sec. 1747b. Said secretary shall deliver to the person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the filing and recording of the same as may be desired and shall receive for each such certificate a fee of one dollar. Any such certificate

shall, in all suits and prosecutions arising out of or depending upon any rights claimed under such label, trade mark, term, design, device or form of advertisement, be sufficient proof of the adoption thereof. The secretary of state shall not record any label, trade mark, term, design, device or form of advertisement that may reasonably be mistaken for anything theretofore filed in his office under the provisions of this chapter.

Sec. 1747c. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trade mark, term, design, device or form of advertisement under the provisions of the preceding section by making any false or fraudulent representations or declarations, verbally or in writing, or by any other fraudulent means, shall be liable for any damages sustained in consequence thereof, to be recovered by or on behalf of the party injured thereby, and shall also be punished as provided by law.

Sec. 1747d. The secretary of state shall, on application by any person or firm domiciled in this state, or by any corporation created under the laws thereof and engaged in the manufacture or sale of ale, porter, lager beer, soda water, mineral water, or other beverages put up in packages, record in a book kept for that purpose a description of the names, brand or trade mark used by such person, firm or corporation for marking the casks, barrels, kegs, bottles, jugs, fountains, boxes or other packages containing such beverage. Before any such record shall be made there shall be paid said secretary a fee of five dollars for each and every such description of name, brand or trade mark which he is requested to have recorded. Nothing elsewhere in this chapter contained is intended to be contrary to or to control or modify the provisions of this section.

Sec. 1747dd. Every person, association or union adopting or using a label, trade mark, term, design, device or form

of advertisement as provided in section 1747a, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant damages resulting from such manufacture, use, sale or display as may be deemed just and reasonable by said court, including all profits derived from such wrongful manufacture, use, display or sale; such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant be delivered to any officer of the court to be destroyed. In case such association or union is not incorporated, such actions may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union. [Laws of 1901, c. 140.]

Sec. 4463. Any person who shall knowingly and willfully forge or counterfeit or cause or procure to be counterfeited upon any goods, wares or merchandise the private stamp or label of any mechanic or manufacturer, with intent to defraud the purchaser or manufacturer of any goods, wares or merchandise whatsoever, shall be punished by imprisonment in the county jail not more than six months or by fine not exceeding one hundred dollars.

Sec. 4463a. Every person who shall knowingly and willfully use or display the genuine label, name or seal, trademark, term, design, device or form of advertisement of any person, association or union in any manner, or in or about the sale of goods or merchandise not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars. [Laws of 1901, c. 201.]

Sec. 4464. Any person who shall counterfeit or imitate any

label, trade mark, term, design, device or form of advertisement adopted or used by any other person, or any association or union of workingmen for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person, association or union, or by a member or members of such association or union, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement, or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of, or keeps or has in his possession, with the intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which the same is printed, painted, stamped or impressed, or knowingly sells or disposes of, or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which, or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by imprisonment in the county jail not more than six months nor less than ten days, or by fine not exceeding one hundred dollars nor less than ten dollars, or by both such fine and imprisonment. Any person who shall, for himself or on behalf of another, or of any association or union, procure the filing and recording in the office of the secretary of state of any label, trade mark, term, design, device or form of advertisement by making any false or fraudulent representations or declarations, verbally or in writing, or by any other fraudulent means, shall be punished by imprisonment in the county jail not more than one year or by fine not exceeding two hundred dollars, or by both such fine and imprisonment.

Section 4442b provides punishment for wantonly obliterating or injuring names, marks, or brands upon casks, barrels, bottles, jugs, etc., used by persons or firms domiciled in the state, or by corporations created under the laws thereof, and engaged in the manufacture or sale of beverages.

Chapter 360, Laws 1901, "An act to provide for registration of trade marks and other marks of ownership and to prevent the unlawful use and disposal of articles marked therewith," seems to apply solely to such marks when used and for use on "cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, cartons, tanks, fountains, vessels or containers."

WYOMING.

Revised Statutes (Laws 1899, Ch. 5) 1899.

Sec. 2526. Any person, association or union may adopt a label, trade mark, stamp or form of advertisement not previously owned or adopted by any other person, association or union, and may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with said secretary; and shall file therewith a certificate specifying the name or names of the person, association or union so filing such label, trade mark, stamp or form of advertisement, his or its residence, location or place of business, the class of merchandise and the particular description of goods comprised in such class to which it has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. Such certificate shall be accompanied by a written declaration, verified under oath by the person or some officer of the association or union by whom it is filed, to the effect that the party so filing such label, trade mark, stamp or form of advertisement has a right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac similes*, copies or counterparts filed therewith are true and correct.

There shall be paid for such filing the fee of five dollars. Said secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive the fee of five dollars. Such certificate of record, shall in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, stamp, trade mark or form of advertisement. No label, trade mark, stamp or form of advertisement shall be recorded that would reasonably be mistaken for a label, trade mark, stamp or form of advertisement already on record.

Sec. 2527. The secretary of state is authorized to make rules and regulations, and prescribe forms for the filing of labels, trade marks and forms of advertisement under the provisions of this act.

Sec. 2528. The owner of any such label, trade mark, stamp or form of advertisement recorded as provided in section one of this act, may proceed by suit to enjoin the manufacture, use or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof to grant injunctions to restrain such manufacture, use or sale, and will award the complainant in such suit such damages resulting from such wrongful manufacture, use or sale as may by said court be deemed just and reasonable, and shall require the defendant to pay to such person, association or union the profits derived from such wrongful manufacture, use or sale; and such court may also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer of such association or union, on behalf of and for the use of such association or union, and every member of such association or union shall be liable for costs in any such proceedings.

Sec. 2529. Every person who, without authority from the owner of a label, trade mark, stamp or form of advertisement recorded as aforesaid, shall make or use any counterfeit or imitation of such label, trade mark, stamp or form of advertisement, knowing the same to be counterfeit or imitation, and every person who, without authority from such owner, shall affix, impress or use such label, trade mark, stamp or form of advertisement upon any goods shall be punished by a fine not exceeding two hundred dollars, or by imprisonment not exceeding one year, or by both such fine and imprisonment.

Sec. 2530. Every person who shall sell goods upon which such label, trade mark, stamp or form of advertisement recorded as aforesaid, or any counterfeit or imitation thereof, shall be unlawfully impressed, affixed or used, shall be punished by a fine not exceeding two hundred dollars, or by imprisonment not exceeding one year, or by both such fine and imprisonment, unless such person shall show that at the time such goods came into his possession he did not know that the impression, affixing or use of such label, trade mark, stamp or form of advertisement was unlawful.

Sec. 2531. In any suit or prosecution under the provisions of this act the defendant may show that he or it was the owner of such label, trade mark or form of advertisement, prior to its being filed under the provisions of this act, and that it has been filed wrongfully or without right by some other person, association or union.

Sec. 2532. This act shall not be construed as to apply to brands, marks or tags on live stock.

APPENDIX IV.

TREATIES, CONVENTIONS, AND DECLARATIONS BETWEEN THE UNITED STATES AND OTHER SINGLE POWERS.*

TREATIES WITH THE VARIOUS NATIONS.

Russia.

An article respecting trade-marks additional to the treaty of navigation and commerce of December 6-18, 1832, with Russia was concluded at Washington, January 27, 1868; proclaimed October 15, 1868. The additional article other than the preamble and provision for termination is as follows:

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.

A declaration regarding the above article was signed March 28, 1874, proclaimed November 24, 1874. It is as follows:

The government of the United States of America and the government of his majesty the emperor of all the Russias, having

*** From Report of Commissioners to Revise Statutes Relating to Patents, etc., Government Printing Office, 1900.**

recognized the necessity of defining and rendering more efficacious the stipulations contained in the additional article of the 15th-27th January, 1868, to the treaty of commerce and navigation concluded between the United States of America and Russia on the 6th-18th December, 1832, the undersigned, duly authorized to that effect, have agreed upon the following arrangements:

Article 1. With regard to marks of goods or of their packages, and also with regard to marks of manufacture and trade, the citizens of the United States of America shall enjoy in Russia, and Russian subjects shall enjoy in the United States, the same protection as native citizens.

Art. 2. The preceding article, which shall come immediately into operation, shall be considered as forming an integral part of the treaty of the 6th-18th December, 1832, and shall have the same force and duration as the said treaty.

The declaration is an addition only to the original article. It makes certain the fact that citizens of the United States shall enjoy the same protection as Russian subjects, but it does not change the obligation of either party to prohibit false marking, etc., as stated in the original article.

This treaty requires the enactment of some law by the congress of the United States in distinction from any state legislation for the prohibition and suppression of the counterfeiting of trade-marks of Russian subjects in the United States. It requires at least some national law, to which the subjects of Russia can resort, more far-reaching than the law of 1881.

This treaty requires the Russian subject to lodge his trade-mark in the patent office at Washington, but the commissioner of patents, as the trade-mark law is at present construed, does not consider that he has authority to register Russian trade-marks, unless they are such marks as could be registered by citizens of the United States.

It is of advantage to the citizens of the United States that a rule corresponding to the treaty should prevail. Our commerce has become so extensive abroad that our marks should have full protection everywhere in order to reap the full

advantage of such trade. For example, single names such as "Sapolio," "Listerine," and other advertised marks here are not trade-marks under the laws of many of the countries of Europe, and therefore these articles can not be exported there with the assurance of protection against infringement, and if export is desired some other trade-mark must be adopted. We can well receive and record the few Russian marks that will be offered, such as they are, and without making them conform to our rules.

BELGIUM.

In the same year that the agreement was concluded with Russia an additional article to the treaty of commerce and navigation of July 17, 1858, concerning trade-marks with Belgium, was concluded December 20, 1868; proclaimed July 30, 1869. The additional article is as follows:

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.

It is understood that if a trade-mark has become public property in the country of its origin it shall be equally free to all in the other country.

The treaty to which this was an additional article was abrogated, and a new "treaty of commerce, navigation, and trade-marks" with Belgium was concluded March 8, 1875, in which was inserted an article XV in substantially the same language as above. National, as distinguished from state,

trade-marks are clearly pointed out by the last paragraph of the article. It is necessary for the statute to decide what trade-marks have become public property in all the states of the United States; e. g., "Matsoon" has been held in New York state to be a good trade-mark, and the United States circuit court in Chicago, administering the common law of Illinois, has held it to be public property. This treaty seems to be still in force, yet a separate convention with Belgium concerning trade-marks only was concluded April 7, 1884; proclaimed July 9, 1884. It is as follows:

The president of the United States of America and his majesty the king of the Belgians being desirous of securing reciprocal protection for the trade-marks and trade-labels of their respective citizens or subjects within the dominions or territories of the other country, have resolved to conclude a convention for that purpose, and have appointed as their plenipotentiaries: * * *

Article 1. 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 nation.

Art. 2. In order to secure to their marks the protection provided for by the foregoing article, the citizens of each one of the contracting parties shall be required to fulfill the law and regulations of the other. (Appendix, chap. XVIII., sec. 2.)

If the treaty of 1875 is in force, the same observations must be made in regard to it as were made in regard to the treaty with Russia. They may also be applied, because the convention of 1884 contains the most-favored-nation clause.

In either case the treaty refers to the United States of America and its laws and not to local laws.

FRANCE.

In 1869 a separate convention concerning trade-marks was concluded with France April 16, 1869; proclaimed July 6, 1869. It is as follows:

The United States of America and his majesty the emperor of

the French, desiring to secure in their respective territories a guaranty of property in trade-marks, have resolved to conclude a special convention for this purpose, and have named as their plenipotentiaries: * * *

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, can not 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.

Art. II. If the owners of trade-marks residing in either of the two countries wish to secure their rights in the other country they must deposit duplicate copies of those marks in the patent office at Washington, and in the clerk's office of the tribunal of commerce of the Seine at Paris.

In this case the language of the prior treaties is not used, and the citizen of France is secured such rights only as if he were a citizen of the United States.

French citizens are to deposit duplicate copies of their marks in the patent office at Washington. Under the present law as at present construed they cannot deposit them unless they are such marks as would be registrable to citizens of the United States.

AUSTRIA-HUNGARY.

In 1871 a convention with Austria-Hungary, relative to trade-marks alone, was concluded November 25, 1871; ratifications exchanged at Vienna April 22, 1872; proclaimed June 1, 1872. It is as follows:

The United States of America and his majesty the emperor of Austria, king of Bohemia, etc., and apostolic king of Hungary, desiring to secure in their respective territories a guarantee of proper-

ty in trade-marks, have resolved to conclude a special convention for this purpose, and have named as their plenipotentiaries: * * *

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.

Art. 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 chamber of commerce and trade in Vienna and Pesth.

The language of this convention is very similar to that of the declaration with Russia, and the same observation may be made in regard to the same. It is also similar to that of the treaty with Belgium, 1875, in that the trade-mark is to become public property in both countries at the same time, and the remarks there made as to the necessity of national control, drawn from the language, apply here also.

GERMANY.

In 1871 a convention was entered into with the German empire. It is entitled in the collection of treaties and conventions published by the United States, "Convention Respecting Consuls and Trade-Marks." Concluded December 11, 1871: proclaimed June 1, 1872. The convention is

much broader than the title indicates, and has but one article in eighteen on trade-marks. It is:

Art. XVII. With regard to the marks or labels of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade, the citizens of Germany shall enjoy in the United States of America, and American citizens shall enjoy in Germany, the same protection as native citizens.

The present trade-mark statute seems to satisfy this treaty; but it seems hardly just that the Germans should be relegated to the protection offered in forty-five possible ways by forty-five different states, when the citizens of the United States need look at but one law, viz., that of the German empire. This remark is applicable to all the treaties granting reciprocal rights.

Great Britain.

In 1877 a declaration respecting trade-marks was concluded between Great Britain and the United States, October 24, 1877; ratification advised by senate May 22, 1878; ratified by president May 25, 1878; proclaimed July 17, 1878.

The government of the United States of America and the government of her majesty the queen of the United Kingdom of Great Britain and Ireland, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

The subjects or citizens of each of the contracting parties shall have, in the dominion 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 fulfill the formalities required by the laws of the respective countries.

This declaration, except so far as expanded by the most-favored-nation clause, is satisfied by the present trade-mark law of 1881. It is to be noted that the language would seem

to imply that citizens of the United States can register in Great Britain and subjects of the queen of Great Britain can register in the United States only what are recognized as good trade-marks in the country where registration is sought. It may happen, therefore, that a citizen of the United States may have a perfectly good trade-mark in the United States, registered under the law of 1881, and still not be able to register the same mark in Great Britain, if some other American or some subject of the queen applies first to register the United States registered mark in England, since the English law grants the registration to the first applicant. This would not be done in the United States. The first user in Great Britain would be given the registration over a subsequent adopter here.

The treaty seems to be more than satisfied by the act of 1881.

Does not fulfilling formalities mean the mere compliance with the forms for registration and not compliance with the definition of a trade-mark?

Brazil.

An agreement concerning trade-marks with Brazil was concluded September 24, 1878; proclaimed June 17, 1879.

The agreement recites:

The government of the United States of America and the government of his majesty the emperor of Brazil, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

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 fulfill the formalities required by the laws of the respective countries.

This agreement is satisfied by the present trade-mark law of 1881.

SERBIA.

A convention for facilitating and developing commercial relations with Serbia was concluded at Belgrade, October 14, 1881; proclaimed December 27, 1882, in which was included an article as follows:

Art. XII. 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 parties, 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 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.

This seems to be a copy of the agreement with Russia, 1868, except that the marks of the citizens of the United States are to be registered in "the tribunal of commerce at Belgrade," and the addition of the clause, "subject to the conditions and restrictions prescribed by the laws and regulations of the country in which the trade-marks are registered." The remarks made in regard to the Russian agreement apply here also, except so far as modified by the last clause of the last sentence. Whether we give more than we receive depends upon the meaning of the undefined words in the law of 1881, "a legal trade-mark." What Serbia protects is stated in Appendix to be:

Every mark serving to distinguish products of industry or articles of commerce from similar products or articles is considered a trade-mark.

No person can enjoy the exclusive right to a mark which is in general use in commerce, or which consists of a single letter, figure, or word. The reproduction of the national arms as a trade-mark

is as a rule interdicted. Marks which have an immoral character, or might be prejudicial to public order, cannot be admitted to registration.

ITALY.

A declaration for the reciprocal protection of marks of manufacture and trade with Italy was concluded June 1, 1882; proclaimed March 19, 1884. It is as follows:

The government of the United States of America and the government of his majesty the king of Italy, wishing to provide for the reciprocal protection of the marks of manufacture and trade, have agreed as follows:

The citizens of each of the high contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as 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 fulfill the formalities required by the laws of the respective countries.

This declaration is in substantially the same form as that with Great Britain, and the remarks made as to that declaration are also applicable here.

SPAIN.

A convention concerning trade-marks with Spain was concluded June 19, 1882; proclaimed April 19, 1883. It is as follows:

The president of the United States of America and his majesty the king of Spain, being desirous of securing reciprocal protection for the trade-marks and manufactured articles of their respective citizens or subjects within the dominions or territories of the other country, have resolved to conclude a convention for that purpose, and have appointed as their plenipotentiaries: * * *

Article I. The citizens and subjects of each of the two 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 of manufactures of any kind.

Art. IV. Persons desiring to secure the aforesaid protection shall be obliged to compiy with the formalities required by the laws of the respective countries.

The convention is given for the better understanding of the diplomatic history of our relations with foreign nations on the subjects being considered.

DENMARK.

A convention relating to trade-marks with Denmark was concluded June 15, 1892; proclaimed October 12, 1892. It is as follows:

With a view to secure for the manufacturers in the United States of America and those in Denmark the reciprocal protection of their trade-marks and trade-labels, the undersigned, duly authorized to that effect, have agreed on the following dispositions:

Article I. The subjects or citizens of each of the high contracting parties shall in the dominions and possessions of the other have the same rights as belong to native subjects or citizens, in everything relating to trade-marks and trade-labels of every kind.

Provided, always, that in the United States the subjects of Denmark, and in Denmark the citizens of the United States of America, cannot enjoy these rights to a greater extent or for a longer period of time than in their native country.

Art. II. Any person in either country desiring protection of his trade-mark in the dominions of the other must fulfill the formalities required by the law of the latter, but no person being a subject or citizen of one of the contracting states shall be entitled to claim protection in the other by virtue of the provisions of this convention, unless he shall have first secured protection in his own country in accordance with the laws thereof.

JAPAN.

A treaty of commerce and navigation between the United States of America and empire of Japan was concluded November 22, 1894; proclaimed March 21, 1895. This treaty contained an article on trade-marks, joined with patents and designs, as follows:

Art. XVI. The citizens or subjects of each of the high contracting parties shall enjoy in the territories of the other the same pro-

tection as native citizens or subjects in regard to patents, trade-marks, and designs, upon fulfillment of the formalities prescribed by law.

This article was by special convention concluded January 13, 1897; proclaimed March 9, 1897, and made immediately operative:

The president of the United States of America and his majesty the emperor of Japan, being desirous of securing immediate reciprocal protection for patents, trade-marks, and designs, have resolved to conclude a convention for that purpose, and have appointed as their plenipotentiaries: * * *

Article XVI. of the treaty of commerce and navigation between the United States of America and Japan, concluded at Washington on the twenty-fourth day, the eleventh month, the twenty-seventh year of Meiji, corresponding to the twenty-second day of November, eighteen hundred and ninety-four of the Christian era, shall have full force and effect from the date of the exchange of ratifications of this convention.

CONVENTION AND FINAL PROTOCOL BETWEEN THE UNITED STATES AND MANY OF THE NATIONS FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Concluded at Paris, March 20, 1883.
Exchange of Ratifications by Signatory Powers, June 6, 1884.
Adhesion to the Convention advised by the Senate, March 2, 1887.
Ratified by the President, March 29, 1887.
Accession of the United States to the Union announced by the Minister Resident and Consul General of the United States at Berne to the Federal Council of Switzerland, May 30, 1887.
Proclaimed June 11, 1887.

The following are articles especially relating to trade or commercial marks:

* * * * * * *

Article II. The subjects or citizens of each of the contracting states shall enjoy, in all the other states of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each state.

Article III. Are assimilated to the subjects or citizens of the contracting states, the subjects or citizens of states, not forming part of the Union, who are domiciled or have industrial or commercial establishments upon the territory of one of the states of the Union.

Article IV. Any one who shall have regularly deposited an application for a patent of invention, of an industrial

model or design, of a trade or commercial mark, in one of the contracting states, shall enjoy for the purpose of making the deposit in the other states, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined. In consequence, the deposit subsequently made in one of the other states of the Union before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working by a third party, by the sale of copies of the design or model, by the employment of the mark. The periods of priority above-mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the seas.

* * * * * * *

Article VI. Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union. Shall be considered as country of origin, the country where the depositor has his principal establishment. If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs. The deposit may be refused, if the object, for which it is asked, is considered contrary to morals and to public order.

Article VII. The nature of the production upon which the trade or commercial mark is to be affixed cannot in any case be an obstacle to the deposit of the mark.

Article VIII. The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not, of a trade or commercial mark.

Article IX. Every production bearing, unlawfully, a trade or commercial mark, or a commercial name, may be seized

upon importation into those of the states of the Union in which such mark or such commercial name has a right to legal protection. The seizure shall take place either at the instance of the public prosecutor or of the interested party, conformably to the domestic legislation of each state.

Article X. The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention. Is reputed interested party every manufacturer or trader engaged in the manufacture or sale of this production when established in the locality falsely indicated as the place of export.

Article XI. The high contracting parties engage between themselves to accord a temporary protection to patentable inventions, to industrial designs or models as well as to trade or commercial marks for the productions which may figure at official or officially recognized international exhibitions.

Article XII. Each one of the high contracting parties engages to establish a special service of industrial property, and a central depot, for giving information to the public, concerning patents of invention, industrial designs or models and trade or commercial marks.

Article XIII. An international office shall be organized under the title of "International Bureau of the Union for the Protection of Industrial Property." This bureau, the cost of which shall be supported by the governments of all the contracting states, shall be placed under the high authority of the Superior Administration of the Swiss Confederation, and shall work under its supervision. Its powers shall be determined by common accord between the state of the Union.

Final Protocol. * * *

4. Paragraph 1 of article 6 is to be understood in the sense that no trade or commercial mark shall be excluded from

protection, in one of the states of the Union, by the mere fact that it may not satisfy, in respect to the signs composing it, the conditions of the laws of this state, provided that it does satisfy, in this regard, the laws of the country of origin, and that it has been in this latter country duly deposited. Saving this exception which concerns only the form of the mark, and under reservation of the provisions of the other articles of the convention, the domestic legislation of each of the states shall receive its due application. In order to avoid all misinterpretation, it is understood that the use of public armorial bearings and decorations may be considered contrary to public order in the sense of the final paragraph of article 6.

THE INTERNATIONAL UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.*

Acts of Brussels of December 14, 1900.

We present below the text of the several amended articles of the convention as they now read, after the incorporation of the amendments passed in Brussels. These amendments have now been ratified by the following states, and upon the dates named: Belgium, Dec. 10, 1901; Denmark, Oct. 10, 1901; United States, May 3, 1901; France, May 23, 1902; Great Britain, Dec. 6, 1901; Italy, Dec. 12, 1901; Japan, April 21, 1902; Norway, June 5, 1902; Netherlands, June 10, 1902; Portugal, Nov. 5, 1901; Sweden, June 5, 1902; Switzerland, Aug. 5, 1901; and Tunis, May 23, 1902.

In several countries, Belgium, France, Italy, Netherlands, Portugal, Switzerland and Tunis, the conventional agreements are applicable from the very fact that the amendments enter into force and effect, no local legislation being required. In other countries it has been necessary to pass special acts

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in order to give legal effect to the amendments, and the following states have passed such laws to secure the application of the amendments, which, amongst other things, provide for a term of priority of twelve months for filing applications for patents: Denmark (Law of March 29, 1901); Great Britain (Law of August 17, 1901); Japan (Law of February 12, 1902); Norway (Law of March 29, 1902); and Sweden (Ordinance of May 9, 1902). We are advised by the Bureau of the International Union that Brazil, San Domingo, Spain, and Servia have not as yet filed their ratifications of these amendments. It should be noted, however, that the new Spanish patent law affords the same period of priority for filing applications for patents to citizens and subjects of all countries which afford a similar protection to Spanish subjects.

Articles of the Convention—Amended by the Acts of Brussels of December 14, 1900.

Art. 3. Are assimilated to the subjects or citizens of the contracting states, the subjects or citizens of states not forming part of the Union, that are domiciled or have effective and serious industrial or commercial establishments within the territory of one of the states of the Union.

Art. 4. Those who have regularly filed an application for a patent of invention, a design or industrial model, a trade or commercial mark, in one of the contracting states, shall enjoy, for effectuating the filing in the other states, and under reserve of the rights of third parties, a right of priority during the delay determined hereinbelow. In consequence, the subsequent filing in one of the other states of the Union, before the expiration of this delay, may not be invalidated by acts accomplished in the interval, as, notably, by another filing, by the publication of the invention or its exploitation, by putting on sale of examples of the design or model, by the use of the mark. The delay of priority mentioned above

shall be twelve months for patents of invention, and four months for designs or industrial models, also for trade or commercial marks.

Art. 4 *bis*. The patents demanded in the different contracting states by persons admitted to the benefits of the convention, under the terms of articles 2 and 3, shall be independent of patents obtained for the same invention in other states, whether adhering to the Union or not. This disposition will apply to patents existing at the moment of its going into effect. It will be the same in case of the accession of new states for patents existing on one side or the other at the moment of the accession.

* * * * * * *

Art. 9. All products bearing falsely a trade or commercial mark, or a commercial name, may be seized on importation into those of the states of the Union in which that mark or that commercial name has a right to legal protection. The seizure shall take place at the request either of the public prosecutor or of the interested party in accordance with the interior legislation of each state. In the states where the legislation does not admit of the seizure upon importation, this seizure may be replaced by prohibition of importation. The authorities shall not be required to effect the seizure in case of transit.

Art. 10. The provisions of the preceding article will be applicable to all products bearing falsely, as an indication of origin, the name of a determined locality, when that indication shall be joined to a commercial name, fictitious or assumed, with fraudulent intent. An interested party is deemed to be any producer, manufacturer or merchant, engaged in the production, the manufacture or trading in the product, and established either in the locality falsely indicated as the place of origin, or in the region where that locality is situated.

Art. 10 *bis*. Those within the jurisdiction of the conven-

tion (arts. 2 and 3) shall enjoy in all the states of the Union the protection accorded to natives against unfair competition.

Art. 11. The high contracting parties shall accord, in conformity with the legislation of each country, a temporary protection to patentable inventions, to designs or industrial models, also to trade and commercial marks, for products appearing in international exhibitions, official or officially recognized, organized upon the territory of one of them.

* * * * * * *

Art. 14. The present convention will be subject to periodical revisions in view of introducing ameliorations of a nature to improve the system of the Union. To this effect conferences will be held successively in one of the contracting states, between the delegates of the said states.

* * * * * * *

Art. 16. States which have not taken part in the present convention will be admitted to adherence upon their demand. This adhesion will be notified by diplomatic channels to the government of the Swiss Confederation, and by it to all the others. It shall entail complete accession to all the clauses, and admission to all the advantages stipulated by the present convention, and will be effective in one month after the sending of the notification by the Swiss government to the other states, unless a subsequent date shall have been indicated by the adhering state. Upon the signing of the convention concluded, the plenipotentiaries agreed as follows:

* * * * * * *

PROTOCOL OF CLOSING.

3 *bis*. The patents in each country shall not be declared void by reason of non-working, except after a minimum delay of three years, to date from the filing of the application in the country in which it is issued, and in cases where the patentee cannot justify the causes of his inaction.

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"Celluloid" (compound of pyroxyline), 50.
"Chatterbox" (name of publication), 50.
"Cocaine" (hair wash), 50.
"Cottolene" (substitute for lard), 50.
"Cuticura" (toilet soap), 50.
"Electro-Silicon" (washing compound), 50.
"Filo-Floss" (fabric), 50.
"Hygieniques" (suspenders), 50.
"Maizena" (corn flour), 50.
"Momaja" (blend of coffee), 50.
"No-to-bac" (tobacco habit cure), 50.
"Roach Sault" (insecticide), 50.
"Sapolio" (cleansing compound), 50.
"Saponifier" (concentrated lye), 50.
"Uneeda" (biscuit), 50.
"Valvoline" (lubricating oils), 50.
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