

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

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

¹ *Annales de la Prop.*, tome vii. p. 95.

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

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

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

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

¹ See sec. 79, Act of Congress, July 8, 1870.

² 47 Barb. 455.

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

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

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

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

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

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

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

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

² 35 Conn. 402.

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

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

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

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

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

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

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

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

¹ 2 Brewster, 314, and Leg. Int., Jan. 1, 1869.

² Dutcher Temple Co., Comm’rs’ Decisions, 1871, p. 248.

³ H. D. Smith & Co., No. 521.

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

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

¹ 2 Sand. (S. C.) 599.

² *Amoskeag Manuf. Co.*, No. 713.

³ *Annales de la Prop.*, tome x. p. 340.

⁴ *Ibid.*, tome xi. p. 284.

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

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

¹ Annales de la Prop., tome xiv. p. 105.

² Ibid., tome v. p. 250.

³ Ibid., tome iv. p. 157.

⁴ 3 Keyes, 594. Same case below in 9 Bos. 192 and 5 Abb. Pr. R. (N.S.) 212.

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

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

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

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

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

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

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

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

of New York, was, like the preceding, on a motion to dissolve a preliminary injunction granted by Mr. Justice Hoffman.¹ The latter differed materially with his associate judge. He said: "It is constantly insisted, and the position is sanctioned by some judges, that when the article in question is innocuous, or in some degree useful, no absurd panegyric or extravagant price is a reason for denying the interference. In short, as counsel once said before me, if a man should compound tallow with some high scent and beautiful coloring matter, and term it 'The Ointment of Immortality,' he has a right to appropriate so much of public credulity as he can in this designation. On the other side, it is well settled that when the deception consists in palming upon the public articles of the party's own manufacture or composition for those of another who has obtained celebrity or notoriety, the court will remain inactive."

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

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

¹ *Fetridge v. Merchant*, 4 Abb. Pr. R. 156.

² 6 Beav. 66.

³ 4 McLean, 516.

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

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

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

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

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

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

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

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

¹ Mary A. Paullin, No. 857.

² See Cong. & Empire Spring Co. case, 57 Barb. 526.

³ Swett & Crouch, No. 798.

⁴ Charles S. Ross & Co., No. 339.

⁵ Dunn Edge Tool Co., No. 563.

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

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

¹ J. H. Doxsee, No. 853.

² V. E. Mauger, No. 886.

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

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

¹ Averill Chemical Paint Co., No. 130.

² *Annales de la Prop.*, tome x. p. 105.

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

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

¹ *Annales de la Prop.*, tome xii. p. 430.

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

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

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

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

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

¹ 35 Cal. 52.

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

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

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

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

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

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

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

¹ 10 Jur. 1043.

² Journal du Palais, 1855, p. 244.

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

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

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

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

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

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

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

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

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

¹ Spooner's Dictionary of the Fine Arts.

² Boutell's English Heraldry, p. 13.

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

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

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

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

¹ Wilkinson on Color and Taste. London, 1858.

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

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

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

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

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

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

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

§ 271. The applicant for registration of a supposed trade-mark for indelible ink thus described his mark: "My trade-mark consists of a bright, yellow-covered wrapper enveloping the metallic case holding the bottle of indelible ink, and forming the ground upon which is pasted or glued a bright red label upon which is inscribed the words, 'Payson's Indelible Ink, for marking Linen, Silk, and Cotton with a Common Pen without a Preparation. Price 37½ cts.'" Below this label, and upon the wrapper-paper, is a caution against spurious and worthless imitations, with the fac-simile of the signature, J. Payson Williston, the original inventor and only manufacturer of the ink. The applicant set forth that the foregoing had been used to distinguish the said article for *thirty-five years*. The specification further recited that "the indelible ink in a bottle is held within the metallic case covered by the wrapper, which, with the label, presents a combination of the two bright colors, yellow and red, so that the package or roll would look nearly the same were the label and the ground upon which it was pasted red; or were the red label left off entirely, the color of the roll, together with its size, would still be enough to indicate its character to any who would recognize it by this general characteristic at a distance too great to read the printed matter."

§ 272. The Office replied that there was but a single element of a trade-mark in the case, and that that was the fac-simile of the signature. The applicant insisted upon a right to the colors of the two labels or wrappers, or a single color, as mentioned. Such a case probably never before came up. It was a matter such as is usually noted in books of reports as *Curia advisare vult*. The case was taken before the Commissioner of Patents in person, and consultation had. The applicant, by counsel, strenuously insisted upon the colors, regardless of form. *Result*: Examiner's decision fully concurred in. A contrary opinion would virtually have conceded the right of any man to select a certain color by which his

merchandise should be designated, a peculiarly-colored paper in which his goods should be wrapped, and his exclusive right to that color. The effect would have been, if such a wild theory were maintained, to gradually throttle trade. No one would dare to send out his wares in red or in yellow papers, lest the vengeance of a prior adoptor should light upon him. This case has its lesson.

§ 273. As Exemplars of Words as Trade-Marks of Fancy, we will consider some that have passed the Patent Office. "LA FLOR DEL TROPICO," for cigars, really manufactured from the flower of the tropics, was held not to be objectionable.¹ "CASHMERE BOUQUET," for toilet-soap, do not convey any false suggestion of origin or quality.² Nor does "DIAMOND," coupled with soap.³ "SAMSON BRACE," for suspenders, cannot imply any thing more than strength of material and make.⁴ "DEER TONGUE," for tobacco, is clear enough.⁵ So is "ROYAL BATSWING," for ladies' corsets.⁶ "MELAROMA," for a beverage, might possibly intimate to a scholar that the article was compounded of honey and some other ingredient, fragrant and delicious; but whether true or not in a literal sense, it would not be likely to do the public much harm.⁷ The words, "WILD BLACK BERRY BITTERS," should not for an instant be thought of as a lawful trade-mark for the article they designate; but when, instead of the initial letters, B, we see three golden *bees*, the ingenious device commands our admiration.⁸ We are not deceived into thinking that there is any "GOLD DUST" in the whiskey that bears that name;⁹ or that an illuminating-oil is verily "MINERAL SPERM OIL;"¹⁰ or that pills are really "EVER-LASTING."¹¹ Nothing but a sheer lack of charity would literally construe "ANNIHILATOR," as applied to a medicine;¹² and when

¹ Gaullieur & André, No. 927.

³ J. Buchan & Co., No. 924.

⁵ L. L. Armistead, No. 512.

⁷ E. J. Williamson, No. 401.

⁹ Barkhouse Brothers & Co., No. 626.

¹¹ Dunn & Co., No. 448.

² Colgate & Co., No. 914.

⁴ Fisk, Clark, & Flagg, No. 744.

⁶ Thomson, Langdon, & Co., No. 540.

⁸ Landsberger & Co., No. 814.

¹⁰ R. S. Merrill & Co., No. 557.

¹² N. Jenkins, No. 746.

considering the case of *Davis v. Kendall*,¹ we would deem the question as to its right of existence to be judicially-settled, and pass as good the words, "PAIN KILLER."² In this case, it appears by the specification that Perry Davis, the founder of the firm, and father of Edmund Davis and Sarah D. Dennis, co-partners under the firm name of Perry Davis & Son, in or about the year 1839 originated and introduced the article of medicine to which he at that time applied the distinctive and suggestive name of "Pain Killer." There is also a recital of the fact that the said name has at various times been pirated by different persons, who have been promptly sued for their piracies; and that in all cases the said name as a trade-mark has been fully maintained by the decisions of the courts. — For a while there was doubt as to the propriety of admitting to registration the word "ZERO," as a mark for a water-cooler. The term seems to imply a low degree of temperature, and to be in the nature of a guaranty of great frigidity; but upon consideration it was allowed to pass.³ "THE ARCTIC," for soda-apparatus, was also held to be valid.⁴ "VALLEY GEM," for piano-fortes, was held not to be necessarily descriptive, while well adapted to its purpose.⁵ "SUNNY SOUTH" is not a term so common as to prevent its use as a mark for stoves.⁶

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

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

¹ 2 R. I. 566.

³ A. M. Lesley, No. 664.

⁵ Ohio Valley Piano Co., No. 795.

⁷ Bostwick & Tilford, No. 376.

⁹ Bostwick & Tilford, No. 377.

¹¹ H. J. Baker & Brother, No. 373.

² Perry Davis & Son, No. 416.

⁴ James W. Tufts, No. 678.

⁶ Abendroth Brothers, No. 307.

⁸ W. H. Reed, No. 708.

¹⁰ F. M. Backus, No. 649.

¹² H. Smith, No. 432.

designations of "RED RACER,"¹ "TIP TOP,"² "QUEEN OF THE MEADOW,"³ "STAR OF THE WEST,"⁴ "KING OF THE FIELD,"⁵ "WESTERN DUTCHMAN,"⁶ and "HARVEST VICTOR;"⁷ and many other names which are understood to be purely arbitrary, to identify certain articles as the manufacture of certain persons.

§ 276. *Rejected, as indicative of Quality.* — The following are instances of applications rejected, because the proposed trademarks consisted of words denoting the quality or nature of the articles to which it was intended to apply them. The words "Parchment Deed," to be affixed to a peculiar kind of writing-paper.⁸ *Held*, to be either purely descriptive, or else calculated to deceive. Affirmed on Appeal. "Geyser Spring," for Saratoga mineral water.⁹ The Examiner said in his decision that the term "geyser" has a signification well-known to the public in connection with certain springs. It is therefore generic and descriptive. The applicant asked for some evidence of the correctness of the decision. He replied that the word "geyser" is a familiar geological term, as is shown by the standard dictionaries, books on geology, and many other printed authorities; that it is an English word, from the Icelandic verb *gélysa*, to rage, boil, spout: meaning, in its restricted sense, a fountain common in Iceland which spouts forth boiling waters; and that by the natural growth of our language it has become common property to indicate any spring like the geyser-springs of Iceland. The geysers of the Yellow-Stone Valley and of California, in our own country, might also have been mentioned. "Beeswax Oil" were in effect held by the Commissioner to be simply descriptive of quality.¹⁰ The word "Razor" being purely descriptive, and "steel" a generic term, the compound word "Razor-steel" was refused registration.¹¹ The

¹ Greenwoods Scythe Co., No. 749.

² *Id.*, No. 750.

³ *Id.*, No. 751.

⁴ *Id.*, No. 752.

⁵ *Id.*, No. 753.

⁶ *Id.*, No. 754.

⁷ Samuel B. Forbes, No. 843.

⁸ Crane & Co., *ex parte*.

⁹ George S. Batcheller *et als.*, *ex parte*.

¹⁰ C. L. Hawthaway & Sons, Comm'rs' Dec., 1871, p. 97.

¹¹ K. J. Roberts, *Ibid.*, p. 113.

word "Invisible," applied to pearl-powder for beautifying the complexion, when used to indicate the character of the thing to which it is attached, becomes descriptive. The intention of the applicant was to intimate that the powder, when applied to the skin, is imperceptible or invisible.¹ The words "Calendar Watch,"² for watches having calendars, were rejected, and the rejection sustained on appeal. The applicant asked for a rehearing upon the case as amended by the addition of "Hall's." The petition was denied, for the reason that such addition could not strengthen a deficient symbol. "Cundurango Ointment, C. O.," is not a legitimate trade-mark. "Ointment" is a generic term, and "Cundurango" the name of a plant extensively known, and the initials, "C. O." are immaterial, and not likely to be noticed.³ "Lunch Milk Biscuit," to be applied to milk biscuit, for lunch or not, cannot be regarded as a trade-mark.⁴

§ 277. The words, "The Woven Wire Mattress," to be affixed to the very article designated, were claimed to be worthy of favorable consideration. The counsel for the applicant — a corporation formed under the laws of the State of Connecticut⁵ — argued on its behalf: 1. That the said words, at the time of their adoption by the applicant as its trade-mark, had not been used in our language, that is, connected together to represent any known article or thing; and by themselves conveyed no meaning. 2. That they could not be considered to be descriptive, for the reason that the wires of the said mattress are coiled and interlacing together, rather than united in the manner ordinarily and technically known as "weaving." 3. That the applicant had the sole right to manufacture goods with the above-mentioned name, and had that right at the time of the adoption of the words as a trade-mark, under a patent owned by it, — in which patent first occurred the word "weav-

¹ Solon Palmer, Comm'rs' Dec., 1871, p. 289.

² Daniel G. Hall, *ex parte*.

³ Blakeslee & Co., Comm'rs' Dec., 1871, p. 284.

⁴ C. D. Ross & Son, *ex parte*.

⁵ The Woven Wire Mattress Co., *ex parte*.

ing" in connection with the peculiar form and manner of interlacing coils of wire therein described, the same having been before then unknown in our language. The ingenuity of the argument did not save the case; for it could not be conceived what words more clearly descriptive could have been selected. The words were not newly-coined, and are common property, notwithstanding the applicant first used them in that exact form.

CHAPTER VI.

ACT OF CONGRESS OF JULY 8, 1870.

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

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

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

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

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

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

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

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

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

§ 283. **Any Person.** — Do these words literally mean that any man, woman, or child; any citizen or alien; any resident, or non-resident, may obtain the protection of this law? Do they in effect include *any person* in the broadest sense of those words? This position has been strenuously insisted on before the Patent Office, by solicitors who had not the time nor the desire to think for their clients. We know that in law persons are divided into natural and artificial persons. Men, women, and children are called natural persons, and a corporation is an artificial person; but in another sense, by person is meant the part which a man plays in society.¹ In law, man and person are not exactly synonymous terms. Any human being is a man, whether a member of society or not. A slave, though a man, is in general considered not as a man, but as a thing — a chattel. Toullier² gives the derivation of the word

¹ Bouvier's Institutes, vol. i. p. 57.

² Droit Civ. Français, liv. i. n. 168.

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

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

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

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

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

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

¹ See Parsons on Contracts, title Married Women.

² Webster's Un. Dic. and Worcester's Dic. : Firm.

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

§ 287. **Domiciled.** — In certain cases domicile is an essential prerequisite to registration; and, being essential, it should be set out in the application-papers. When not averred distinctly, it will be inferred from circumstances. It is because the term “domicile” has not been understood, and has so often been confounded with a mere abiding-place, that the Office has been led to demand an oath, showing of what country the applicant is a citizen, the same as in applications for patents.¹ The Office will then assume that a certain place or country is the party’s domicile. What is the meaning of the word “domicile”? The definition of the term is not without difficulty; for although so many powerful minds have been applied to this question, there is no universally-agreed definition of the word, nor an agreed enumeration of the ingredients which constitute domicile.

¹ Patent Office Regulation, Feb. 29, 1872.

Two things must concur to constitute it : *first*, residence ; and, *secondly*, the intention of making a place the home of a person. There must be the fact and the intent. However, in many cases, actual residence is not indispensable to retain a domicile ; but it is retained *animo solo* by the mere intention not to change it, or adopt another. Thus, if a person should go on a voyage to sea, or to a foreign country, for health, or for pleasure, or for business of a temporary nature, with an intention to return, such a transitory residence would not constitute a new domicile, nor amount to an abandonment of the old one ; for it is not the mere fact of inhabitancy in a place which makes it the domicile, but it is the fact, coupled with the intention of remaining there, *animo manendi*.¹

§ 288. There is sometimes no small difficulty in deciding upon the place of domicile, in a strict and legal sense. Residence is oftentimes of a very equivocal nature, and an intention to return to a former residence is still more obscure. Both are sometimes to be gathered from slight circumstances of mere presumption, and from equivocal and conflicting acts.² Thus, at the federal seat of government there are many office-holders in the civil service who claim domicile in States from which they have been absent many years, and in which they hold but the shadow of a nominal residence ; and yet they assert and frequently exercise the right to vote in their respective States, just as our ministers to foreign courts, and soldiers and sailors may do, when they return to homes from which they have long been absent. To complicate the question as to their fixed, true, and permanent residence, these office-holders sometimes vote at the municipal elections in the District of Columbia ; and their right to do so has been maintained by high legal authority. Yet an inhabitant of one State does not acquire a domicile in another by merely coming to the latter to seek employment, with the intention of residing there only if he should find it.³ In *Abing-*

¹ Story, Conflict of Laws, § 44.

² Ibid., § 45.

³ *Ross v. Ross*, 103 Mass. 575.

ton v. North Bridgewater,¹ the learned Chief Justice Shaw said truly that "every one has a domicile of origin, which he retains until he acquires another, and the one thus acquired is in like manner retained. The supposition that a man can have two domiciles would lead to the absurdest consequences. If he had two domiciles within the limits of distant sovereign States, in case of war, what would be an act of imperative duty to one would make him a traitor to the other." He might thus, during a period of hostilities, become an enemy to himself, or be bound to do personal service in two military districts of the same State at the same time; or in two countries be compellable to serve on juries at the same moment; or, as in our late civil war, be held to duty as a conscript in one district when the quota of troops had actually been filled by him in another.

§ 289. Every person must have a domicile somewhere. *First*, the place of birth of a person is considered to be his domicile, if at the time of his birth it was the domicile of his parents. If his parents are then on a visit, or on a journey (*in itinere*), the home of his parents (at least, if it be in the same country) will be deemed the domicile of birth or nativity. Persons born out of the limits and jurisdiction of the United States, whose fathers were at the time of their birth citizens of the United States, are citizens of the United States; but the rights of citizenship shall not descend to persons whose fathers never resided in the United States,² for their domicile would be abroad. An illegitimate child follows the condition of his mother. A child born on the high seas has his domicile in the country of his parents. The domicile of birth of minors continues until a new one is obtained. Minors are generally deemed incapable, *proprio Marte*, of changing domicile, and retain the domicile of their parents; and if the father die, his last domicile is that of the minor children. A married woman follows the domicile of her husband; but

¹ 23 Pick. 170, 177.

² Act of Congress, Feb. 10, 1855.

sometimes she may obtain one different from his, and institute proceedings for divorce.¹ A widow retains the domicile of her deceased husband until she obtain another domicile. *Primâ facie*, the place where a person lives is taken to be his domicile until other facts establish the contrary. When one removes to another place, with an intention to make it his permanent residence, it instantaneously becomes his place of domicile; and that although he may entertain a floating intention to return at some future period to his old home. It has so been considered in relation to the Chinese immigrants in the States of the Pacific, who nearly all hope to return to China during life, or to have their remains removed thither after death. The place of residence of a man's family is generally to be deemed his domicile, unless it be only a place of temporary establishment for his family. Residence, to produce a change of domicile, must be voluntary. If, therefore, it be by constraint, or banishment, arrest, imprisonment, the antecedent domicile remains; as in the case of the many thousand French soldiers who retreated into Switzerland, during the late war between their nation and North Germany, and also that of Don Carlos, who more recently retreated with some of his soldiers into France from Spain. The removal was not a matter of choice. Still, probably, any of those persons could obtain a domicile by intending to always remain in the land of exile.²

§ 290. There is a *forensic* domicile (*forum domicilii*), or place where one can sue and be sued. It may happen, and it often does, that the political, civil, and the forensic domicile are the same; but this is a matter not so much of general principle as of positive legislation in different countries. A person who resides in a foreign country, for purposes of trade, is deemed an inhabitant of that country by foreign nations; and his character changes with that of his country. In peace

¹ *Cheever v. Wilson*, 9 Wallace, 109. See authorities cited in Story, Conflict of Laws, note to § 46. See also Dr. Lieber's article, "Domicile," in Encyclop. Am.

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

he is deemed a neutral, in war an enemy; and his property is dealt with accordingly in prize courts.¹ It is doubtless in this sense that the word "domiciled" is used in the act of July 8, 1870, as will be apparent upon a careful reading; for it was passed in the interest of commerce generally, and not with reference to the citizenship of applicants. The main point is this: Does the claimant, by engaging in manufacturing and commercial pursuits in our country, add to its prosperity and wealth? If so, this statute shall give him additional protection and privileges. The policy of the law is to enhance our national prosperity. He whose actions have not that tendency cannot reasonably claim an advantage over any one else. As an example of the practical working of this theory, we will take a case recently submitted for advice. A native of the State of Rhode Island, a natural-born citizen of the United States, and still such citizen, continued to reside in this country for many years after attaining his majority. For about eighteen years he has been established in China, as a tea-merchant, and exports largely to this country. He desired to register his trade-mark for teas, but entertained doubts of the feasibility of his wish, on the ground of want of domicile. He was informed through his counsel that so far as this statute is concerned, he must be regarded as a Chinese subject; and as such foreign country does not by treaty afford similar privileges to citizens of the United States, he could not avail himself of the provisions of this act. His able counsel fully acquiesced in this view, and so the matter ended.

§ 291. Citizenship is not an element to entitle or debar from registration under this statute. The question of fealty or allegiance does not arise. The citizen of the United States, resident and in commerce in a foreign country, — and if not in commerce why have a trade-mark! — is adding to the wealth and prosperity of that foreign country. He has there thrown in his lot. Commercially, he is a citizen of that country. To

¹ *The Venus*, 8 Cranch R. 278.

be sure, he can resume his prior status. If he do not choose so to do, let him use his influence to secure to all of his fellow-citizens of the United States the privileges he now seeks here. One may for half a century have been a trader in the city of New York, and not be included within the meaning of this act; or he may not have yet been in the United States for more than an hour, and be included. What was his intention, as to permanency?

§ 292. Let us consider a hypothetical case, to illustrate the idea of the necessity of a strict compliance with the statute, and the rules of practice. The late Mr. Nicholas Bodisco, who died in 1872, while connected with the Russian legation at the Brazilian court, was born in Georgetown, D. C., in 1844, his mother being a natural-born citizen of the United States. Suppose that that gentleman had embarked in mercantile business in the city of Washington, and had applied for the registration of a trade-mark. Would it have been sufficient for him to merely allege his residence in Georgetown, and his place of business in Washington? No! He should also have averred his place of domicile, for such is a material fact, and therefore should always be alleged. Why? Because our government, and the public at large, have a right to know the exact status of every one to whom protection is conditionally promised by this legislative enactment. If he had then alleged his domicile, the fact would have transpired that his domicile was in Russia. Why so? Because, at the time of his birth, his father was Envoy Extraordinary, &c., of the Emperor of Russia, and in legal contemplation his domicile was that of his father, and not having renounced his allegiance to his own country, but actually continued in the diplomatic service, he had not acquired a domicile here. But what matter would that have been, since the residents of all foreign countries affording privileges of protection to trade-marks to our people are provided for in this act? Not at all. The object of registration is protection in our courts; and the right to that pro-

tection might at any time be suspended by the supervention of a state of war between the countries. He would take the certificate, if at all, under an existing treaty, and subject to all legal conditions and contingencies.

§ 293. One effect of the law of national domicile may be this: it may affect the validity of the transfer of a trade-mark by assignment, as provided for in section 81. If by the law of the place where a person has his domicile he is of legal age at the age of twenty, and has the faculty of disposing of his property there situate, the same faculty will extend to his property situate in another country, where he would not be capable of alienating until he had reached the age of twenty-five years.¹ For example: the modern Civil Code of France expressly declares that the laws concerning the condition and capacity of persons govern Frenchmen, even if residing in a foreign country. Thus French minors, incapable of binding themselves by engagements of commerce, unless they are emancipated or authorized, cannot bind themselves in commercial transactions in a foreign country, even when the law of that country does not require the like conditions. So does the personal incapacity of French married women follow them everywhere, so far as the French tribunals are concerned.² Any man obtaining an assignment of a trade-mark would prefer to be assured that he might assert his title the world over.

§ 294. Whether a member of an Indian tribe resident within the territory of his nation, and subject to its laws, would be regarded as included within the provisions of this statute of 1870, is a question that may arise, but has not been officially passed upon. The language of subdivision 3, section 8, article 1, of the Constitution, seems to imply that a treaty would be necessary for the regulation of commerce with such tribes; and this law relates to commerce.

¹ Story, Conflict of Laws, § 54.

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

§ 295. The national character which a man gains by residence may be thrown off at pleasure, by a return to his native country, or even by turning his back on the country in which he had resided, on his way to another. It is an adventitious character gained by residence, and which ceases by mere residence.¹ It is manifest that the fact of mere citizenship is not conclusive on the question of domicile. An Englishman came to this country, and became naturalized, and two years afterward returned to England, where he continued to reside for sixteen years, with the exception of a few months spent in visiting this country. *Held*, that he must be regarded as having again become a British subject.² The same doctrine was held in the Supreme Court of the United States in 1814,³ where a naturalized citizen, in time of peace, returned to his native country for the purpose of trade, but with the intention of returning to his adopted country. He remained in his native country for a year after the commencement of the war between the two countries; but only for the purpose of winding up his business. *Held*, that he had gained a domicile in his native country. In still another case, a residence of thirteen years in an enemy's country was held sufficient to invest the party with the character of an enemy.⁴ In the civil war in the United States, property was condemned on the ground of domicile only. It was decided, *first*, that if a place was in the firm possession and under the control of the rebel enemies, it was, for the time, and in the technical sense of the prize-law, enemy's territory; *second*, that the property of a person domiciled in that place at the time of capture was liable to condemnation as enemy's property, in the sense of the prize-courts; and *lastly*, that although the owner was a citizen of the United States, and had always resided in that place, which was held to be of right a part of the United States, and of right a proper place of residence to constitute citizenship of the United States,

¹ *The Venus*, 8 Cranch, 253 (1814).

² 2 Paine, 601.

³ *The Frances*, 8 Cranch, 335.

⁴ *Rogers v. The Amado*, 1 Newb. 400.

yet the property of such a person was to be condemned without inquiring whether he was or was not, in his intentions or acts, loyal or disloyal. The same rule was applied to the property of foreigners domiciled in such places.¹

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

§ 297. "Any Corporation." — What do these words mean? Do they embrace literally any and every corporation, sole and aggregate, ecclesiastical, municipal, manufacturing, and commercial? corporations formed for scientific, educational, and a score of other purposes? Counsel have asserted that all kinds of corporations, however unconnected with commerce, are included. If not in *trade*, why have a *trade*-mark? If a non-trading corporation cannot have a trade-mark at common law, how can it possibly have one by virtue of this act of Congress. This statute does not create trade-marks, for no power to do so exists under the Constitution; and it would be an absurdity to attempt to create a symbol of commerce, which, being the emblem of its owner, each man must adopt for himself.

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

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

The right to use a certain mark for goods does not depend upon statutory enactments, but has its foundation in the immutable law of nature. Congress had only authority to regulate commerce, and it did not attempt to transcend its powers. It could not change the natures of things. We are referred to the common law for the rules which govern those natures; and it has repeatedly been declared that statutes which alter common-law remedies, or effect common-law rights, must be strictly complied with. Witness the maxim: *Nihil quod est contra rationem est licitum*, for reason is the life of the law. And such statutes are to be construed sensibly, and with a view to the object aimed at by the legislature. An ancient and settled system ought not to be overturned, except by clear, unambiguous, and peremptory language.¹

§ 298. This statute does not make valid any act on the part of a corporation which would not be valid without it, and does not in the slightest degree add breadth to the provisions of its charter; therefore, it is a corollary that an ecclesiastical, educational, eleemosynary, or other non-mercantile corporation, is not contemplated by this act. In one case, the applicant set forth that it was engaged in the "manufacture and distribution of pamphlets, circulars, and other publications," and that the proposed trade-mark was to be printed thereon, "and upon the notices which advertise the same and the business of the company to the public." It did not appear, nor could it be inferred, that the articles upon which the mark was intended to be applied were to be sold. Therefore they were not merchandise within the meaning of the statute. The application was rejected.² In another case, where a picture of a safe and a watch-dog was filed for registration by an insurance company, it met a similar fate. This picture was not intended to be sold as a work of art, — for then it might have come under the copyright law, and been entered in the office of the Librarian of

¹ Sedg., Stat. and Const. Law, p. 318.

² The Mercantile Loan and Warehouse Co. App. 683.

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

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

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

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

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

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

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

¹ Legal and Political Hermeneutics, p. 100.

² Angell & Ames on Corporations, § 161.

§ 301. **Treaty, or Convention.** — This phraseology was conceived in a liberal spirit, looking to the encouragement of reciprocity. The Office has given to these words a very liberal construction ; and, in all cases when the full scope and intent of a treaty of commerce is somewhat dubious, it presumes in favor of the applicant. Thus where a British subject, resident in his own country, applied for registration, it was held that the English act of Parliament, entitled “The Merchandise Marks Act of 1862,” was equivalent to a convention. Indeed, the right of an alien friend to protection in the English courts did not depend upon the passage of that statute, for in many instances previous thereto, the said courts had recognized and enforced the doctrine.¹ In *Pisano v. Lawson*,² it was shown that at law as well as in equity, an alien friend, not at any time a resident in England, might maintain a personal action for an injury done within the realm. It was held by Woodbury, J., in the United States Circuit Court for the District of Massachusetts, in 1846,³ that British subjects had the same privileges in our judicial tribunals as our own citizens. The third article of our treaty of 1794, with England, gives the people of both powers the authority “freely to carry on trade and commerce with each other.” “So,” said that learned judge, “we are under treaty obligations to Great Britain and most other European powers, to admit their merchandise on favorable terms, and to allow their merchants to trade here as those of favored nations. But it would be a mockery of such provisions and engagements, if we prevented them from selling their goods after arriving here (Ch. J. Marshall, in *Brown v. State of Maryland*, 12 Wheat. 447), unless noxious to health or morals; or if we made onerous discriminations against them, or prevented their receiving the proceeds of their goods, or abstained from yielding protection against injuries to them, or to their

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

² 6 Bing. N. C. 90.

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

marks." This doctrine had previously been asserted by Story, J., in the same court.¹ Mr. Justice Woodbury, in the case above cited, said that an alien is not now regarded as "the outside barbarian" he is considered in China, and the struggle in all commercial countries for some centuries has been to enlarge his privileges and powers as to all matters of property and trade. So, too, heavy taxation of alien merchants was guarded against in Magna Charta, allowing them "to go and come, and buy and sell, without any evil tolls." It is hence, undoubtedly, that Montesquieu observed, that "the English have made the protection of foreign merchants an article of their national liberty;" and Thompson on Charters, p. 232, says, that once they enjoyed it even in war, "in common with the clergy and husbandmen, in order that those who prayed, ploughed, and trafficked, might be at peace." Lord Ch. J. Hale said, so long ago as his time, that "the law of England rather contracts than extends the disability of aliens, because the shutting out of aliens tends to the loss of people, who, when laboriously employed, are the true riches of any country." Therefore, when we consider the spirit and reason of this law, which are the promotion of reciprocity, it would be manifestly illiberal, if not positively unjust, to refuse registration of the mark of a resident of England. We need not hesitate, because the subjects of marks of commerce are not mentioned *eo nomine* in any treaty with England, nor in any convention; but, upon the principle of international comity, the presumption should be in favor of the residents of that country. It should be observed that the word "citizen" or "subject" of a foreign country is not used: the language is, "any person, firm, or corporation resident of or located in." A citizen of the United States *resident* in such foreign country would, therefore, for the purposes of this act, be deemed a foreigner.

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

¹ Taylor v. Carpenter, 3 Story, 458.

known as trade-marks; for such recognition operates as a safeguard against fraud on their own communities. Hence the many treaties and conventions upon this subject, and the liberal views entertained by the judicial courts of nearly all of the enlightened countries. By the term "convention" we mean all kinds of contracts less formal than a treaty, and all pacts, understandings, or agreements,¹ the leading idea being the interchange of amicable relations and dealings. All nations are not alike liberal in respect to this matter, and require something more than a tacit understanding. Although a Frenchman in England had his rights as carefully protected in the courts of that country as if he were a British subject, independently of any treaty or compact, the French nation did not display a similar spirit of justice to Englishmen. Rowland & Son, of England, sued in France for an infringement of their trade-mark. The court refused them redress because they were undomiciled foreigners. The cases of Stubs and of Spencer were decided against Englishmen on the same ground. The same ruling seems to have been uniformly made in the cases of all other foreigners under the same circumstances. In March, 1856, the Tribunal of Commerce of the Seine,² in an infringement case, held, that, inasmuch as the complainant, Jean Marie Farina, of Cologne-water fame, was a foreigner, not admitted to establish his domicile in France, conformably to art. 13 of the Code Napoléon; and as he had not proved that the civil rights he demanded were accorded by his nation to Frenchmen, his case must be dismissed. This course was taken, although the court admitted that his proprietary mark for his flasks of *eau-de-Cologne* had been recognized by numerous judgments and injunctions, and the defendant intended to continue the piratical use of it and the name of the complainant. Our countrymen met with a reception quite as unfavorable. In the Court of Paris, in 1867,³ the complainant, Kemp,

¹ Bouvier's Law Dic.; Webst. Dic., title Convention.

² Farina *et al. v.* Camus, *Annales de la Prop.*, tome ii. p. 159.

³ Kemp *v.* Herman, *Annales de la Prop.*, tome xiii. p. 298.

an American, proprietor of "Florida Water" (*Eau de la Floride*), sold as "Agua Florida," had obtained in the court below a judgment for infringement of his trade-mark. It was held by the appellate court that, by arts. 11 and 13 of the Code Napoléon, the foreigner not permitted by authorization of the emperor to establish his domicile in France could enjoy only those rights accorded to Frenchmen by treaty with the nation to which such foreigner belongs.

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

§ 304. The term "corporation" has been taken by some applicants for registration to mean any voluntary association or aggregation of individuals, although they do not possess the general characteristics of a corporation. Thus, in one case, the claimants set forth that they were engaged in business under the name of the "Sorrento Wood-carving Company," and asked that a certificate should be issued to and in the name of such company.¹ *Held*, the company has no legal existence by that name, not being incorporated, and is in reality a "firm." The grant should properly be made in the

¹ Hill & Hall's case, Cert. No. 639.

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

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

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

¹ See chap. ii., *ante*.

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

¹ See Judiciary Act of 1789.

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

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

REQUIREMENTS, ANTECEDENT TO REGISTRY.

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

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

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

¹ Sedgwick on Stat. and Con. t. Law, p. 438.

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

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

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

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

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

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

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

§ 311. It seems scarcely necessary to remark that this statute is applicable to *merchandise* alone, — something to be sold, and not to be given away. The plaintiff claiming protection must prove that he has an exclusive right to use a particular mark or symbol in connection with some manufacture or vendible commodity; and, secondly, that this mark or symbol has been adopted or is used by the defendant, so as to prejudice the plaintiff's custom, and injure him in his trade or business.¹ There is not any exclusive ownership of the symbols which constitute a trade-mark apart from the use or application of them to a vendible commodity.² This is the settled doctrine of all the courts. Any other view of the matter would be wildly absurd. A symbol does not become a trade-mark until actually stamped upon or otherwise affixed

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

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

to goods to be sold. It would not therefore be correct for one to say that his trade-mark is stamped upon his business-cards, or other mere advertisements; for the impression of the symbol would be nothing more than a fac-simile or copy of his trade-mark. The public do not purchase signs, or circulars, or cards of business; but they buy the article of merchandise bearing upon it a certain known mark of genuineness. Yet, for all this, the dictates of common sense are set at defiance by muddle-headed solicitors, who will not think, — How can a thing be a trade-mark if not used in trade? How can one's property be protected if he have no property?

§ 312. Lest the proposition enunciated above should not be considered authoritatively given, let us consult the Bench. Ludlow, J., in 1860,¹ said as follows: "It may be remarked in general, that while an imitation or fac-simile, or a mere colorable artifice, will bring the offending party clearly within the rule, no decision has ever yet declared the right of a manufacturer to be absolute in a *name* as a *name* merely; it is only when that name is printed in a particular manner upon a particular label, and thus becomes identified with a particular style of goods, or when a name is used by a defendant in connection with his place of business (and not his manufactured goods), under such circumstances as to deceive the public and rob another of his individuality, and thus destroy his fame and injure his profits, . . . that it becomes a *trade-mark*, or in the nature of a trade-mark, and as such entitles its possessor or proprietor to the protection of courts of justice." These remarks are so consonant with the rules of common sense, that it would be unpardonable in a writer to produce additional authorities, were it not for the fact that the Office has been pestered with the declamatory nonsense of persons who contended to the contrary. To continue: Vice-Chancellor Wood, of England, in 1865,² said: "The law on this point, as

¹ *Colladay v. Baird*, 4 Phil. 139.

² *Ainsworth v. Walmesley*, 44 L. J. R. 252.

laid down in the cases before Lord Westbury,¹ I understand to be as follows, and I do not think that any one would be disposed to dissent from it. This court has taken on itself to protect a man in the use of a trade-mark as applied to a particular description of article. He has no property in that mark *per se*, any more than a person has in any fanciful denomination which he may assume for his own particular use without reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and when he has caused his goods to circulate with that mark, when that mark has become the known *indicium* of their being his, the court has said that nobody shall defraud him by using that mark, and passing off the goods of another's manufacture as being the goods of the owner of the mark." And the Lord Chancellor in the same year said: "It is correct to say that there is no exclusive ownership of the symbols which constitute a trade-mark apart from the use or application of them; but the word "trade-mark" is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such use or application is rightly called 'property.'" ² This rule is as rigid and unalterable as the laws of the Medes and the Persians.

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

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

¹ Millington *v.* Fox, 3 Myl. & Cr. 338; Hall *v.* Barrows, 10 Jur. (N.S.) 55.

² Leather Cloth Co. case, 11 Jur. (N.S.) 513.

certificate of registry, and does not appear in the specification, of which several hundred copies are printed for possible use. By a recent regulation, the representation of the trade-mark may be printed as a portion of the specification. In that case, it is not "annexed," but incorporated. An allegation that "the mark consists of a schooner-yacht under full sail, in connection with the words 'Middlesex Yacht-cloth,' as is more fully shown in the fac-simile hereto annexed," would be unobjectionable.¹ Sometimes the representation filed consists of fanciful groupings of figures, or of ships and railway trains, and bridges, and a number of words, while the essential mark lies in a single word. The verbal description is, therefore, the only true guide.

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

§ 315. **Mode of Application or Use of mark.** — This may be set forth thus: "by marking each article with blue ink by means of a stencil-plate;" "by printing the mark upon tags to be fixed to the cloth;" "by branding the top of each box containing the goods with a hot iron;" "by painting or stencilling the mark upon each article;" or in any other language which will clearly show the mode of affixing the same. Sometimes the articles intended to be protected are too minute to bear the mark, as needles, when the box will perform that office; or pins, when the paper in which they are fastened will serve the purpose; and so of a myriad of those articles to which the emblem cannot be affixed, except by means of envelopes, wrappers, boxes, and other enclosures.

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

¹ Middlesex Co., No. 655.

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

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

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

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

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

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

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

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

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

§ 320. Seventh. The filing of a declaration, under the oath of the person, or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and that no other person, firm, or corporation has the right to such use, either in the identical form or having such near resemblance thereto as might be calculated to deceive, and that the description and facsimiles presented for record are true copies of the trade-mark sought to be protected.

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

¹ Att'y-Gen's' Opinions, vol. ix. p. 64.

² Pat. Office Rule 111.

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

⁴ *Arnold v. Bishop*, MSS. (Appeal cases), Cranch, Ch. J., D. C. 1841; also *O'Hara v. Hawes*, MSS. (Appeal cases), Morsell, J., D. C., 1859.

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

§ 321. The manner of administering the oath, or affirmation, must of course be left to national or local peculiarities and customs, as in the case of heathen idol-worshippers. The oath may be made in the United States before any officer authorized to administer oaths for general purposes, as justices of the peace, notaries-public, commissioners of deeds of cities, or of judicial courts, and clerks and judges of the same; or, in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent holding a commission under the government of the United States, or before a notary-public of the foreign country in which the applicant may be. The signature of a notary-public must in all cases be attested by his proper official seal. Sometimes the official seal is dispensed with by State laws; but under federal laws it cannot be.² Of course the oath prescribed in this act cannot be taken by any one who has been convicted of perjury, or who for any other reason is not a competent witness in a court of justice in the State or Territory where the party proposes to take it; and if, upon interference or other trial it appeared that a person legally incompetent had sworn to the declaration, the case would stand exactly as if no oath had been made. Lapse of time could not cure a defect so radical.

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

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

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

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

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

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

§ 325. **Where there is no Oath on File,** the fact that a blank form of oath not executed is found among the papers cannot overcome the direct recital of the letters-patent that the oath was taken, or the presumption that the requirements of the law were complied with in issuing the patent.⁴ And suppose the oath had not been taken at all, would the patent be void on that account? Story, J., in one case held otherwise.⁵ The taking of the oath, it seems, though to be done prior to the granting of the patent, is not a *condition precedent*, failing which the patent must fail.⁶ Notwithstanding the tenor of the foregoing decisions, no prudent applicant would neglect any of the formalities required, nor lay the flattering unction to his soul that he can eventually succeed if he do so. We have an opinion in the Crompton case, above cited, that even the requirement for the payment of fees is *directory*, and that the non-payment thereof would not invalidate a patent inadvertently granted. (*Obiter dictum.*)

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

¹ *Whitely v. Swayne*, 4 Fish. 117.

² *French v. Rogers*, 1 Fish. 133.

³ *Goodyear v. Hullihen*, 3 Fish. 251.

⁴ *Crompton v. Belknap Mills*, 3 Fish. 536.

⁵ *Whittaker v. Cutter*, 1 Gall. 429.

⁶ *Clifford and Clark, JJ., Crompton v. Belknap Mills, supra.*

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

§ 327. *Calculated to deceive.* — However strong may be the asseveration of the applicant upon this point, the declaration will not be conclusive, where the statement is obviously false. Motives will be keenly scrutinized. The Office will for itself determine when a proposed mark is calculated to deceive. Nor will motives be the sole test; for it is not essential to reprobation that a use shall have been with fraudulent intent. In *Fetridge v. Wells*,¹ the “Balm of Thousand Flowers” case, Duer, J., said: “Without rejecting the evidence of my senses, I cannot doubt that the label or trade-mark which the defendants admit that they propose to use, from its general resemblance to that of the plaintiff and his firm, is well-calculated to mislead the public, by inducing the belief that the articles to which it is affixed are in reality prepared or manufactured by the plaintiffs’ firm. Nor can I doubt that the label was framed with this design, since the imitation is so close, minute, and exact, as, in my opinion, to exclude the supposition of any other motive. It is true that the name of R. H. Rice, as proprietor, is printed on the label, but it is so printed as not to attract, but almost certainly to elude, observation. A variation must be regarded as immaterial which requires a close inspection to detect, and which can scarcely be said to diminish the effect of the fac-simile which the simulated label in all other respects is found to exhibit.” The question of general resemblance, with variations in nearly all the *minutiae*, was fully considered by the Office in an application for registration of a proposed trade-mark for paint, rejected upon registered case No. 1 of the “Averill Chemical Paint Company.” The verbal description of the Averill Co. reads as follows, viz: “In the foreground,

¹ 4 Abb. Pr. R. 144.

on a rock, with the word 'Chemistry' upon it, is an eagle holding in his mouth a paint-pot or canister, with a brush, and a ribbon or streamer, on which are the words, 'Economical, Beautiful, Durable.' Below the feet of the bird is represented water, upon which are a steamer and other vessels. In the background is a bridge or viaduct, with a train of railroad cars upon it. Further in the background are seen buildings and manufactories." The applicant's specification presented the same general effect. "Omit the word 'Chemistry,' said the Special Examiner, add the figure '&' to the ribbon, and substitute a globe for the rough rock, and the written description of Bradley is the same as that of the Averill Company. At a casual glance, one design might easily be mistaken for the other, an indistinct impression of which may have been left upon the memory; for each contains all the essential features of the other. Both devices are circular in form, are intended to be applied in the same mode, in the same color, and to the same class of goods. It is not to be supposed that opportunities for critical examination would commonly offer, nor even be sought; for the resemblance of the infringing to the genuine mark would lull suspicion; so that not only the general public but even acute observers in the business of dealing in paints might easily be misled."¹ If the affidavit filed in this case had been conclusive the case could not have been rejected; for that affidavit states positively "that no other person, firm, or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive." This is by no means an uncommon kind of case. The moral of it is, that the Patent Office will examine, weigh, scrutinize, and decide, in accordance with the rules of common sense.

§ 328. The statute, by defining the conditions under which the power it confers shall be exercised, necessarily excludes it in all others, except, perhaps, the correction of clerical errors.

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

When a statute defines the extent of power to one who acts ministerially (as the Commissioner does under this section), the courts cannot extend it, nor validate acts done without or beyond its authority. The Commissioner cannot pardon a false suggestion, or excuse on the ground of innocent ignorance. If, for example, an alien, either through ignorance or intention, falsely represent himself to be a citizen, in order to obtain a patent, the patent so obtained is inoperative and invalid to vest title. Where the taking of the oath is a condition precedent, the want of it may be pleaded in defence.¹

§ 329. In another case it was held that the Commissioner has clearly no power to dispense with what the statute declares to be the necessary prerequisites to the grant. And if it appears from the records and papers of the Office in evidence that the statutory requirements have not been complied with, it is within the power of a court, and its plain duty, to hold a patent to be void. It would be straining the doctrine of presumption in favor of the legality of the acts of a public officer to an unreasonable extent, to hold that a patent is legal and valid where the records and papers of the Office show conclusively that essential statutory provisions have been disregarded.²

¹ *Child v. Adams et als.*, 1 Fish. 189.

² *Whitely v. Swayne*, 4 Fish. 117.

CHAPTER VII.

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

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

DURATION OF TIME OF PROTECTION UNDER THIS ACT.

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

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

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

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

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

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

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

PENALTIES FOR INFRINGEMENT, AND SAFEGUARD AGAINST FALSE MARKS.

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

§ 335. This statute does not create the right to judicial remedies generally; for that right has always existed, and occasionally has been enforced in one form or another during past ages. The penal portion of this section must be strictly construed. The law gives satisfaction for infringement whether

¹ Sec. 25, Patent Laws, July 8, 1870.

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

§ 336. The remedy given by this section is cumulative. The party wronged has undoubtedly a right to resort to the common law for damages sustained, independently of this statute. The common-law remedy is not taken away by this affirmative statute, without a negative, express or implied.³ The primary right to a satisfaction for injuries is given by the law of nature, and the suit is only the means of ascertaining and recovering that satisfaction. The injured party has unquestionably a vague and indeterminate right to some damages or other the instant he receives the injury; and the verdict of the jurors, and the judgment of the court thereupon, do not, in this case, so properly vest a new title in him as fix and ascertain the old one. They do not give, but they define the right.⁴ The wrong implied by this section is deceit. From the very terms of the definition of deceit, there must be *fraud* or the intention to deceive, for this is the very essence of the injury. If the party making the representation himself made a mistake, no degree

¹ Sedgwick on the Measure of Damages.

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

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

⁴ Bl. Com. book ii. chap. 29.

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

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

¹ *Pasley v. Freeman*, 3 T. R. 51.

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

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

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

⁵ 2 Ld. Raymond, 953; Willes, 597.

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

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

§ 339. **Caution to be observed.** — Before rushing into litigation under the assumed sanction of this act, the aggrieved proprietor of a trade-mark should be cautious. His rights must be based upon a strict compliance with all the requirements of

¹ Lord Mansfield, in *Bird v. Randall*, 3 Burr. 1353.

² See title, Remedies.

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

¹ Curtis on Patents: Infringement.

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

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

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

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

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

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

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

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

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

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

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

§ 344. After the foregoing had been printed, the following decision on appeal was made. The novel question is therein treated in a masterly manner. THACHER, *Acting Commissioner*: "Applicant is a manufacturer and vendor of flour in the city of St. Louis, Mo. He has two establishments upon different streets, and he seeks to register as trade-marks to be used upon the barrels containing his flour, the words 'Cherry St. Mills' in one case, and 'Market St. Mills' in the other, combined respectively with a well-known masonic emblem, the square-and-compass. These combinations of words and symbols, it is strenuously maintained, embrace all the requisites, and come within none of the negative exceptions or limitations, of the law defining a legal trade-mark. Applying the comprehensive test laid down by the Commissioner in *Ex parte Dawes & Fanning*, Official Gazette, vol. i. p. 27, it is said that neither of the combinations claimed is the name of a person, firm, or corporation, or is calculated to deceive the public as to the true origin or character of the article to which it is applied, or is generic or descriptive of quality; and, finally, it is asserted that each, when applied to the commodities for which it is adopted as a trade-mark, will distinguish them from others of the same class. The essence of these alleged trade-marks is the masonic symbol, the square-and-compass. It has already been determined that the words alone do not possess the characteristics of a legal trade-mark, and, in order to make it appear that the addition of the square-and-compass do confer these characteristics, it is also insisted that this masonic symbol is not used with its ordinary signifi-

¹ 6 Beav. 69.

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

the public mind, in portions of the old world, as would affect common affairs, and could not properly be disregarded under whatever circumstances they should appear. If they were now held in the same estimation in this country, who imagines that they could be divested of their general significance so that they could successfully be adopted to constitute trade-marks, or parts of trade-marks, and be displayed before the public in that capacity? The case of these masonic symbols is in some respects different, to be sure, yet it is in important particulars similar, and the same objections lie to their use in the manner proposed. I am clearly of opinion, therefore, that the proposed combinations cannot properly subserve the ends of a trade-mark. Among masons with whom this token has a moral significance, its use in that capacity would undoubtedly be regarded as a base prostitution of it to mercenary purposes, while with others its mystic force would often dissipate its virtues as a trade-mark, and perhaps in some instances place the article it appeared upon under a ban. Thus, if these trade-marks could be sanctioned, they would tend to defeat the fundamental object of the trade-mark law, which is an offshoot of the ancient 'law-merchant,' and like that designed to advance trade and manufactures. Decision of the Examiner affirmed." Oct. 3, 1872.

§ 345. Now opportunely presents itself a still fresher matter to reinforce our position. It is an appeal from the Examiner. *TEACHER, Acting Commissioner*: "This appeal covers two applications. The first is for the registration of the words and letters 'Parson's Purgative Pills, P. P. P.,' as a trade-mark. The decision in *Blakeslee & Co., C. D., 1871, p. 284*, indicates the action that should be taken in this case. In that case, the Commissioner held, that the addition of the initials 'C. O.' to 'Cundurango Ointment' was not sufficient to entitle applicants to registration. I am unable to make any distinction between these two cases: they appear to be perfectly analogous. In both instances, the letters themselves would probably be

regarded as a legal trade-mark; but when used in connection with words of which they are the initials they lose the characteristics of an arbitrary device; their precise meaning becomes evident from the words which they accompany, and they are as much descriptive as the words themselves. Hence initial letters can add nothing to a phrase which is not a lawful trade-mark without them. The second application asks for the registration of the words, 'Johnson's American Anodyne Liniment, established A.D. 1810.' It is claimed that the phrase, 'Established A.D. 1810,' is an arbitrary distinguishing mark, and that by the addition thereof the whole is constituted a legal trade-mark. This view of the case does not seem to be correct. The additional phrase indicates the date of the discovery of the liniment, or the commencement of its manufacture, and to this extent is descriptive in nature. Any other person who made a similar liniment the same year would have as much right to use these particular words as the applicants in this case. It would be unjust to give one person or firm the monopoly of words used in a descriptive way, to which others might have the same right, as descriptive matter. The decision of the Examiner is affirmed in both applications. (Sept. 12, 1872.)¹

§ 346. The effect of the foregoing, and similar judgments, is to correct an error prevalent in the minds of solicitors who have devoted themselves wholly to the practice of patent-law. That error is the improper application of the theory of *combinations*. In reasoning from a supposed analogy, they deduce a wrong conclusion. A technical combination in machinery may be defined, not as a new machine, but as a new union of elemental parts not before brought together in that kind of machine. The machine itself may have existed before; and the separate elements of the new combination may have existed before; but if those elements have not been before united so as to produce a method of operation differing from what had

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

been done before in that kind of machine, what is called a new combination is created.¹ Therefore they think that the combination of verbal elements, inefficacious when single, may constitute a new, and on that account a valid, symbol of trade. We can find applications on file, where line has been piled upon line and precept upon precept, in the vague idea that, because the combinations are new, they must perforce be deemed true symbols of commerce. As has been said in a previous chapter, the idea of *invention* does not enter into the contemplation of a trade-mark.

§ 347. An applicant² claimed as his mark the words "Chestnut Hill Bourbon," to be branded upon casks or packages containing whiskey. The Examiner questioned the right of the claimant to the exclusive use of the words, and asked, Where is said "Chestnut Hill"? What is the meaning of "Bourbon"? Is not the use of the word "Bourbon" calculated to create a wrong idea of origin? In reply to the official letter of inquiry, were filed a written argument of counsel and a number of affidavits. The affiants came up boldly to the task of proving a conclusion of law, and swore that the combination of words constitute a lawful trade-mark. The argument of the counsel affords a clew to the remarkable statements of the party and his witnesses. We find that he treats the case as if it were an application for a patent for an aggregation of useful elements in a machine, or the bringing together of various chemicals in a new composition of matter. A single extract will suffice to show the counsel's position. He says: "As in case of patenting a new machine, it is sufficient if this *combination* of old and well-known words embrace sufficient novelty and distinctiveness from all others, as to be readily and easily distinguishable therefrom, so that none are wronged or misled. This, I believe, the testimony fully establishes." It is manifest that the counsel intended to

¹ Curtis on Patents, § 111 (3d ed.).

² John E. Cassidy, *ex parte*, Sept. 24, 1872.

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

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

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

¹ 1 Greenl. Ev., ch. xv.

² Winslow & Rogers, No. 643.

period of twenty-one years, as a trade-mark for bridle-bits and stirrups, the word "DANIEL," as a fanciful name, it was admitted to registry.¹ If this word "Daniel" were the name of the applicant, it would not be valid for the purpose; but being a pure designation of fancy, — meaning, mayhap, him who was thrown into the den of lions, — there is no objection to it. Even if another person, whose real name is Daniel, were to set up in a similar business, he would not be permitted to stamp his goods with the simple name adopted as above stated: but would be compelled by a court of equity, if he used it at all, to use with it some distinguishing mark, or his initials, to avoid the possibility of confusion.

§ 350. What is *merely* the name? Answer: The name used in the ordinary manner, having nothing in its arrangement to attract attention, and lead the public to inquiry, and having no feature indicative of an intention to make it a distinguishing emblem. John Jones cannot claim the right to an exclusive use of his mere name to mark his merchandise, consisting of boots and shoes; for any other person of the same name, dealing in the same class of merchandise, has as good a right to so mark his goods. But if one form his name into an anagram, or form a cross or crescent, or any other fancy figure of his name, then by the singularity of formation it acquires an individuality, and ceases to be merely his name, and becomes a lawful mark. The imitation of such a device would hardly be deemed the result of accident. One's autograph may be his commercial mark, if it possess striking peculiarities, so that it can be, and really is, recognized as his, and his only; but it is not every scrawl that would be deemed such. That involves a question of fact, whether such mark is sufficient to distinguish it from the same name when used by other persons.

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

¹ Kelita Brodhurst, No. 946.

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

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

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

§ 353. There are two recently-published opinions that, upon a superficial reading, seem to affirm that the mere name of a corporation may constitute a lawful trade-mark, when used by the corporation itself, as a mark or sign upon merchandise. These opinions are worthy of examination at this moment, and especially so is the earlier one, as that has been cited in the Patent Office as an authority. It is the case of *Newby v. The Oregon Central Railway Co. et als.*, in the Circuit Court of the United States for the District of Oregon, in 1869.¹ The facts are briefly as follows: The corporation defendant was organized in 1867, under a general law of the State of Oregon (Code, 658-659), for the purpose of constructing and operating a railway. Prior thereto, however, another company had been incorporated by the same name, and by authority of the law of the same State. It was alleged by

¹ Deady's Rep. (1859-69), p. 609.

the bill that the bonds and obligations of the senior corporation (of which the complainant was a stockholder) had become valuable and marketable as commercial paper, so that it was enabled by the sale of them to meet its liabilities; and it was charged that the individual members of the second corporation had confederated and conspired together to defraud and injure the senior corporation, by assuming the same corporate title; whereby they succeeded in putting their paper into market, to the injury of the credit of the original corporation. In short, the true and legal designation of an incorporated company had been fraudulently usurped. An injunction was asked for. The language of the judge in granting the prayer is in part this: "The corporate name of a corporation is a trade-mark, and from the necessity of the thing, and every consideration of private justice and public policy, deserves the same consideration and protection from a court of equity. Under the law, the corporate name is a necessary element of the corporation's existence. Without it, a corporation cannot exist. Any act which produces confusion or uncertainty concerning the name is calculated to injuriously affect the identity and business of a corporation." He found that the defendants were in the wrong, and administered the remedy applied for. What did the judgment decide? That the mere naked name of a corporation is a trade-mark at common law? If it did so decide, then the name of a corporation used *for* itself, and *by* itself, is not included within the prohibition of this section, provided the same was so used prior to the time of the passage of this Act. Did the court decide that the name of a corporation is a technical trade-mark? Yes! exclaims the tyro; No! as emphatically says the lawyer. Let us carefully examine the language of Judge Deady, and theorize, if necessary. "The corporate name of a corporation is a trade-mark," said he, and "deserves *the same* consideration and protection." The *same* as what? The *same* as if it were really a technical trade-mark. That is undoubtedly what he

meant to say, and by his decision virtually did say. Was the case before the court an alleged infringement of a trade-mark? No. How can that be demonstrated? By a very simple process. There was no charge that the mark of the original and genuine company had been violated. If the bill had so averred, and claimed relief on that ground, the defendants would have demurred thereto, and a dismissal of the bill would necessarily have followed. There would have been a defect in the party complainant. In case of infringement, the party injured by the wrongful conduct of the defendants would have been the corporation itself, and not an individual stockholder. There was no pretence that the defendants, or any one of their number, had imposed a false mark upon Newby. His ostensible reason for bringing the suit was to prevent a further depreciation of his stock, by any wrongful act of the defendants. How came he to sue, instead of the corporation? The motive may readily be inferred. He was a citizen of the State of California; the defendants all citizens of Oregon. He could bring a suit in the Circuit Court of the United States, and the corporation could not; because in the latter case both parties would have belonged to the same State, and the court could not have had jurisdiction under the Act of 1789; for it must be remembered that this suit was instituted before the time of the passage of the Act of 1870, which permits both parties to belong to the same State, as in a patent or a copyright case. The senior corporation found that it was necessary to its own salvation that the pseudo-corporation should be destroyed; and the expunging of its name was annihilation. A suit might well have been brought in a court of the State of Oregon; but for some reason, not apparent on the face of the record, it was desirable to submit the cause to another jurisdiction. A non-resident was found; so the necessity for a direct attack in a State tribunal was averted, and a skilful flank movement was planned and executed. We have no right to quarrel with Judge

Deady, except on one point, and that point is the careless misuse of a technical term, — “trade-mark;” and when we look back at the frequent instances of the same slip of the tongue, or the pen, as shown in Chapter III. (on the definition and nature of the trade-mark), we find him to be in illustrious company. The case of *Newby v. The Oregon Central Railway Co. et als.* does not judicially decide that the mere name of a corporation is a trade-mark.

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

¹ 37 Conn. 278.

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

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

Evidence.—The record operates as *prima facie* evidence of title, as in the case of letters-patent.¹ Before the time of the passage of this act, it was sometimes next to impossible to establish the date of adoption, and the exact description of a trade-mark, depending as those matters did upon the recollection of witnesses, who, when produced at perhaps a great expense, would disagree upon both points. It cannot, however, be contended that the evidence furnished by virtue of this section would be conclusive. Take an analogous case: A patent does not conclude anybody. It is, at most, a statement of what has appeared to the Commissioner to be a new and useful invention by the party. That may, and often does, prove not to be the fact. The Commissioner makes a certificate of the *prima facie* right of the patentee to the exclusive use of what he alleges to be his own originally, and to which the patent gives exclusiveness of use in so far only as the property really existed in the first instance, and before the right was protected. The Government does not warrant the act of the Commissioner.² The certificate is a convenient species of evidence of the claim, and the length of time that the right has been asserted. When employed to show the date of filing claim, and other facts which do not usually appear in the certificate, as issued in course, an exemplification of the whole record should be demanded. Whenever convenient, the de-

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

² Att’y-Gen’s Op., vol. viii. p. 277.

fendant should for the greater caution examine the original file, with every paper in it. The papers contained in the file (excepting assignments, which may be found recorded in their appropriate books) constitute the sole record. This is a perpetual, intrinsic, and exclusively admissible testimony of all the transactions in the case. The slightest error of the transcript may materially affect important rights.

§ 356. It was held in the Court of Metz, in France, in 1861, in the case of *Somborn v. Menser et al.*,¹ that the deposit of a trade-mark under the law of 1857 (which our act resembles in many features) creates a presumption in favor of the depositor, and nothing more than a presumption, which may be rebutted by proof that other manufacturers previously used the same mark for the same class of merchandise. Curry-combs, bearing the mark of a horse, had been seized. The evidence showed that the said mark had been used in Germany for nearly a century, and had long before the date of the suit fallen into the public domain, even in France, and was notoriously employed by the manufacturers of Paris to designate certain articles of hardware. The proof of foreign user, therefore, destroys the presumption created by registration.

§ 357. "TRADE-MARK PATENT" is a false term, frequently used to indicate the certificate given under the provisions of this section. The phrase is illogical and mischievous. A patent is an official document conferring a right or privilege on some person; especially a writing securing in a person for a term of years the exclusive right to an invention or discovery. A patent is a grant, — a new creation. It makes a right that did not previously exist, and one that must expire with it. A trade-mark is not granted by the Government. Even if the certificate of registry should prove to be informal and worthless, that fact would not affect the vitality of the trade-mark at common law, but would simply deprive the person using it of convenient evidence. But if a patent should

¹ *Annales de la Prop.*, tome viii. p. 78.

be found to lack any material allegation, or to be informal, the patentee is left without property in his invention. The patent is a modern contrivance; but the trade-mark is venerable for its antiquity, its origin being coeval with that of property itself. All the Patent Office does with the latter is to recognize and record it. The erroneous use of the word "patent," when applied to a certificate of registry, is apt to be the source of injury, for in such use we lose sight of a principle. We thereby admit what is not true, *i.e.*, that Government has conferred a right of user, and that that right may expire at the will of the Government; whereas the symbol of commerce exists *ex proprio vigore*, by virtue of an immutable law. Words are the guardians of thought, language the amber in which are embedded and preserved precise and subtile ideas. Words, as living powers, have a relationship to the things they designate, and must not be taken at random. That would be to pull the bow at a venture. Again, there may be imposture in the use of the word "patent," when the correct term is "certificate of registry;" as when a man who has registered a trade-mark for some common article of merchandise stamps his goods with the mark, and adds the words "patented" on such a date. The error may arise from ignorance, or, quite as likely, it is the result of a studied effort to cheat the purchaser. If ignorantly done, the legal consequence may be to deprive the proprietor of the mark of any redress for a violation of what is truly his mark; but if intentionally done, it makes the person amenable to the penalty prescribed for false marking.¹ The following is an example of perfect good-faith in the misapplication of the word "patented," as is evident by the candid admissions of the person as a party in an interference.² The dispute being as

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

² Sternberger v. Thalheimer & Hirsch, still pending.

to the priority of adoption of the word "CENTENNIAL" as a mark for shirts, &c., the sworn preliminary statement says: "We first commenced using the word 'Centennial' on the 10th day of March, 1872. Our shirts were then exhibited in boxes on which were affixed our labels, represented in our patent dated May 7th, 1872. We did not, however, label the shirts until we received official notice that our patent was allowed. From the date of the patent, May 7, 1872, we have stamped our shirts thus: 'CENTENNIAL, PAT. MAY 7TH, 1872.'"

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

ASSIGNMENTS AND OTHER TRANSFERS.

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

This section relates to form rather than substance. At common law, the transfer of such a right was usually an incident of the assignment of the good-will of a business, or the stock in trade of a manufacturer or merchant. It was sometimes a matter of doubt whether the successor of a trading firm by the general transfer of the good-will and stock (whether the same were made voluntarily, or by operation of law) carried with it also the right to the use of an established

trade-mark. To remove all such doubt, it was desirable that the assignee of the mark might place his evidence of title upon record, and the most convenient place of record is the Patent Office.

§ 360. Particular attention is invited to the phraseology of this section, especially the words "forms," "rights to the use," and "trade-marks." Forms may be made for the transmission of legal, tangible rights; but before the transfer can be made the right must exist. How does such right exist? This question can best be answered by citing the opinions of learned judges and chancellors, who have had occasion to judicially consider the subject. The Court of Appeals of the State of New York, in the case of *The Congress and Empire Spring Company v. The High Rock Congress Spring Company*,¹ in 1871, passed upon this very point, and said: A property in a trade-mark may be obtained by transfer from him who has made the primary acquisition, though it is essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade-mark has been attached. — In the same case,² in the Supreme Court, it was held that property in trade-marks is not property in the words, letters, marks, or symbols as things, or as signs of thought, or as productions of the mind, like that of patent or copyright; but simply and solely property as a means of designating things, — the things thus designated being the production of human skill or industry, whether of the mind or the hands, or a combination of both; and this property has no existence apart from the thing designated, or separable from its actual use in accomplishing the present and immediate purpose of its being. In *The Dixon Crucible Co. v. Guggenheim*,³ in 1870, the court cited authorities, and said, the true rule to be deduced from these cases would appear to be this: that the property or right to a trade-mark may pass by an assignment,

¹ 57 Barb. 526, and 4 Am. Law Times R. (St.) 168.

² Ibid.

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

or by operation of law, to any one who takes at the same time the right to manufacture or sell the particular merchandise to which said trade-mark has been attached. As a mere abstract right, having no reference to any particular person or property, it is conceded that it cannot exist, and so cannot pass by an assignment, or descend to a man's legal representatives. To the same effect is also the opinion of Daly, Ch. J., in *Lockwood v. Bostwick*,¹ in 1869. In the Supreme Court of California, in *Derringer v. Plate*,² in 1865, it was held that a person's right to a trade-mark accrues to him from its adoption and use for the purpose of designating the particular goods he manufactures or sells, and has no value except when so employed, and indeed has no separate abstract existence, but is appurtenant to the goods designated. In *Walton v. Crowley*,³ in the United States Circuit Court, N. Y. Dist., in 1856, the plaintiff was the assignee of the trade-mark and of the good-will of the trade. There are other American decisions all tending the same way; and it is believed that not one can be found which positively affirms a contrary notion. As to English decisions: In the *Leather Cloth Co.*⁴ case, in the House of Lords, in 1865, Lord Cranworth said that the right to a trade-mark may in general, treating it as property, or as an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser; and in that opinion the remainder of the court concurred. Vice-Chancellor Wood, in *Ainsworth v. Walmesley*,⁵ in 1865, said: "Inasmuch as the court protects the owner of the mark, he is entitled to authorize another, when he hands over his business to him, to place that mark on his goods. Thus the mark is a thing bought and sold, a right recognized and protected in a court of equity, which can be disposed of for money. It is, therefore, in that sense of the

¹ 2 Daly, 521.² 29 Cal. 292.³ 3 Blatch. C. C. 440.⁴ 11 Jur. (n.s.) 513.⁵ 44 L. J. R. 252.

word, property.” In the Rolls Court, in *Hall v. Barrows*,¹ in 1863, it was held that a trade-mark could properly be sold with certain iron-works; and that it constituted a part of the partnership assets, and should be so treated. In all these cases — and they lay down the settled law — the transfer of the trade-mark was concurrent with the transfer of the business or goods. If by any possibility they be deemed not sufficiently conclusive, the reader for himself may examine other authorities — if such he can find.

§ 361. **Reasons why an Abstract Symbol cannot be transferred as a Trade-mark.** — If the mere representation of a symbol adopted as a trade-mark could be changed from the possession of one person to that of another, in the same manner as is a patent for a design, or a copyright in a book or print, such a transfer would be productive of fraud upon the public. It is a matter of no consequence to the purchaser of an article protected by a design-patent as to who made it, nor to the purchaser of a book as to who published it; for the value of the thing could be tested by its intrinsic excellence. But a trade-mark is an index pointing to an article as the product of a certain person or place. The law would not permit it to be used as an instrument of falsehood. Take the case of *Samuel v. Berger*,² as an illustration of judicial treatment of such a use of a mark. The plaintiffs said that one Brindle, a watchmaker, had acquired a reputation as such, and that all watches made by him were stamped with his name; that Sylvester J. Samuel purchased from Brindle the right to stamp Brindle’s name on watches made by Samuel; and that Samuel assigned to the plaintiffs the right to stamp Brindle’s name on watches made by them. The court held that the plaintiffs had no case of which a court should take cognizance. In the case of the *Leather Cos.*,³ Lord Kingsdown said that if an artist or an arti-

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

² 24 Barb. 163; 13 How. Pr. R. 342; and 4 Abb. Pr. R. 88. ³ *Ubi supra*.

san has acquired, by his personal skill and ability, a reputation which gives to his works in the market a higher value than those of other artists or artisans, he cannot give to any other person the right to affix his name or mark to their goods; because he cannot give them the right to practise a fraud upon the public. In the same case, the Lord Chancellor regarded such an act as an imposition on the public. He put this hypothetical case: Suppose an individual, or a firm, to have gained credit for a particular manufacture, and that the goods are marked or stamped in such a way as to denote that they are made by such person or firm, and that the stamp has gained currency and credit in the market and become of great value (there being no secret process or invention), could such person or firm, on ceasing to carry on business, sell and assign the right to use such name and mark to another firm carrying on the same business in a different place? Suppose a firm of A. B. & Co. to have been clothiers in Wiltshire, for fifty years, and that broadcloth marked thus, "A. B. & Co., Wilts," has obtained a great reputation in the market, and that A. B. & Co., on discontinuing business, sell and transfer the right to use their name and mark to a firm of C. D. & Co., who are clothiers in Yorkshire, would the latter be protected by a court of equity in their claim to the exclusive right to use the name and mark of A. B. & Co.? "I am of opinion that no such protection could be given," said he.

§ 362. Upon the formation of a partnership with a person entitled to the benefit of a trade-mark, the trade-mark, in the absence of express provisions in relation to it, becomes an asset of the partnership — the trade-mark being but one element of the trade. It may also pass to trustees under a creditor's deed.¹

§ 363. **The Commissioner to prescribe Forms for the transfer of the right to use such trade-marks.** This section probably does not contemplate any but registered trade-marks, as is evi-

¹ Bury v. Bedford, 10 Jur. (n.s.) part i. p. 503.

denced by the word "*such*." Assignments of common-law marks are sometimes recorded, it being the practice of the Office to record any instrument of the kind without looking into the chain of title; just as a recorder of deeds will without hesitation record any conveyance, provided the fees be paid. Yet no one could pretend that the mere fact of transcribing into official records could breathe life into dry bones. *Lex non cogit ad impossibilia*. Reference is made to the requirements of law respecting the transfer and transmission of copyrights. We turn to the only provision of law upon the subject,¹ and find that an assignment must be recorded within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice. By the same section, copyrights are made "assignable in law, by *any* instrument in writing." This broad provision has not been in any wise modified by any rule or regulation of the Patent Office respecting trade-marks.²

§ 364. It has repeatedly been held that an agreement which operates as an assignment of a patent is good against the patentee, and those who purchase without notice, though not recorded.³

§ 365. An assignment of a patent, by one of two or more administrators, is good, and passes the entire interest.⁴ This is applicable to the case of property in a trade-mark.

§ 366. **Personal trade-mark.** If this is in any respect less assignable than one referring to locality only, or a mere device, the distinction must be limited to mere cases where the mark is so clearly personal as to import that the goods bearing it are manufactured by a particular person.⁵

¹ Sec. 80, Act of Congress of July 8, 1870, in relation to patents and copyrights.

² Rule 88, Patent Office; Form 44, Office-Rules Appendix.

³ 4 Fisher, 428.

⁴ 1 Fisher, 239.

⁵ *Bury v. Bedford*, 10 Jur. (n.s.) 503; 33 L. J. Chan., 465.

DAMAGES FOR FRAUDULENTLY PROCURING REGISTRY, ETC.

§ 367. (Sec. 82.) *And be it further enacted,* That any person who shall procure the *the* registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark in the Patent Office under this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case before any court of competent jurisdiction within the United States.

This section creates a right of action. At common law, the wrong-doer would not have been liable unless he had actually used the trade-mark in palming off goods as the manufacture or merchandise of another; although equity would have enjoined against the contingency of use. This is an action upon the case for deceit, fraud being of the essence of the injury. Two main points must be proved: the fraudulent nature of the wrong committed by the defendant, and the nature of the injury suffered by the plaintiff. The nature of the wrong to be proved in a case of actual piracy is well-defined by Wilde, C. J., in *Rodgers v. Nowill*.¹ He says: "Has more ever been necessary to be proved in actions of this description than that the plaintiff, being a manufacturer, has been accustomed to use a certain mark to denote that the goods so marked were of his manufacture; that such mark was well-known and understood in the particular trade, and that the defendant had adopted the mark, and sold goods bearing it, as and for the plaintiff's goods, with intent to deceive?" On these grounds, the action was held not to be maintainable in *Singleton v. Bolton*,² for there no sale was proved to have been made by the defendant of a medicament (yellow ointment) of his own under the name or mark of the plaintiff, but both the plaintiff and the defendant used the name of the original inventor (Dr. Johnson), and no evidence was given of the defendant having sold his ointment as if it had been prepared by the plaintiff.³ Probably, by virtue of this section, the real

¹ 5 C. B. 109; 5 Man., Gr. & S. C. 109.

² 3 Doug. 293.

³ Lloyd on Trade-marks: Remedies against Piracy.

owner of a mark would be entitled to nominal damages, sufficient to establish his title, the same as in ejectment, without proof of actual injury, for injury might well be inferred from the fact of false or fraudulent representations. The true owner's loss of time in procuring registry, the expense attending the interference made necessary by the fact of a plurality of claimants, and many other circumstances, — as, for example, the loss of reputation in the market, — might be urged as proper grounds upon which to base a demand for damages.

§ 368. *Any Court of Competent Jurisdiction.* — The full scope of this provision in regard to the forum is dubious. Does this section creating a new right of action give the courts of States jurisdiction of suits brought therefor? or does it apply only to federal tribunals?

§ 369. (Sec. 83.) *And be it further enacted,* That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity, which any party aggrieved by any wrongful use of any trade-mark might have had if this act had not been passed.

The effect of this section — if it is not sheer surplusage — is, to say the least, problematical. Possibly, it means that any continuing wrong, for which a party had a remedy at common law, or in equity, shall not abate by reason of registration of a mark, infringed upon before July 8, 1870. It may be that it is intended to permit the joinder of causes of action arising before and since the registration.

§ 370. (Sec. 84.) *And be it further enacted,* That no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

To entitle the plaintiff to recover damages for infringement of his mark, it is essential that it be his mark of commerce, and that the business carried on by him be *lawful* in its nature. It is a broad principle of law that all contracts in violation of

morality, and founded upon conditions *contra bonos mores*, are void. All duties enjoined by the divine law are not enforced, indeed, by the common or by the statute law, not only because the forms or modes of proceeding do not enable human tribunals to adjust nice questions of morals, but because strict rules as to ethical questions would tend to destroy freedom of opinion, and to afford opportunities for persecution. But no agreements to do acts forbidden by the law of God, or which are manifestly in furtherance of immorality, and tend to contaminate the public mind, are tolerated, or can be enforced. Thus if it be shown that the plaintiff's trade-mark is used by him to stamp obscene publications, or articles used only in the commission of acts of vice, and the defendant has pirated the trade-mark to palm off similar publications or articles, the plaintiff could not recover damages. Two general maxims would be enforced against his demand. *Ex turpi contractu non oritur actio*, and *In pari delicto, potior est conuictio defendentis*. Any business which violates the rules of public policy is unlawful; yet, as Mr. Justice Story says,¹ public policy is in its nature so uncertain and fluctuating, varying with the habits and fashions of the day, that it is difficult to determine its limits with any degree of exactness. It has never been defined by the courts, but has been left loose and free of definition, in the same manner as fraud. This rule may, however, be safely laid down, that any business which conflicts with the morals of the time, and contravenes any established interest of society, is void, as being against public policy. A business originally lawful in itself may by peculiar circumstances be made unlawful. Thus trading with an enemy without a license from one's own government, is unlawful, for it is the policy of war for each party to injure the other party to its utmost ability, even though such injury be continually recoiling. All commercial partnerships existing between citizens of two countries at war with each other, are dissolved

¹ See Story on Contracts: Void on Account of Immorality.

by war, so that no new contract can arise between them, pending such war. Nor can an ally engage in trade with a common enemy, without rendering himself liable to the penalty of seizure and forfeiture of property so engaged. A business carried on in violation of a statute is unlawful, whether that statute *expressly* prohibit or enjoin an act, or *impliedly* prohibit or enjoin it, by affixing a penalty to the performance or omission thereof. Any business the object of which is the violation of the laws of another nation should, upon principle, be treated as unlawful, and as tainted with immorality, for no nation should connive at the infraction of the just laws of another. Honesty is the true policy of nations as well as of individuals, even if the higher obligations of morality were to be disregarded by the brotherhood of nations, every day the more closely drawn together by a community of interests. This being a commercial statute, it is not improbable that Congress meant to give to the term "unlawful" a comprehensive scope. At all events, courts should require the enforcement of the strict rules of morality in the application of this penal provision. In two recent cases in the Patent Office, the applicants set forth that they manufactured boots for the Southern trade. The places of business were in the State of Massachusetts, and the merchandise to which the proposed trade-marks were to be affixed, was expressly intended for sale in the States lately in rebellion against the United States. No doubts would have arisen of the entire lawfulness of the business of the applicants, but for certain *indicia* of bad faith. On the fronts of the legs of the boots of one party was stamped as a trade-mark the likeness of Robert E. Lee and a copy of his signature, accompanied with six stars. The Office refused registration on two grounds: 1st. That the use of said likeness and the stars, signifying the States that led off in the rebellion, tended to foster prejudice and keep alive a sectional feeling; 2d. That the concealment of the true origin of the manufacture was an attempt at imposition

upon the people of the South. The other case was rejected upon substantially the same grounds. Under the peculiar circumstances, the business might well be held to be unlawful within the meaning of the statute. If Southern manufacturers had been the applicants, the Office would have made allowances for the admiration entertained for the memory of gallant officers, however mistaken the cause in which they had been engaged, and probably would have granted the registry.

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

§ 372. **Fraudulently obtained.**— Fraudulent means of any kind would vitiate any certificate of registry granted in consequence thereof; and that whether the false declarations had been made in the statement presented originally, by amendment, by testimony furnished, orally or in writing, or indeed in any manner. The registry is a contract between the United States and the grantees of the certificate; and fraud destroys any contract into which it enters. Any false entry prejudicial to the rights of another is also actionable; as, for example, a pretended or fraudulent assignment placed upon record. As to the assignee claiming title under such an assignment the trade-mark would not be “lawful,” any more than the title of

the holder of a promissory note with a forged indorsement, or one given for a consideration void at law. As to the meaning of this phraseology, *fraudulently obtained*, take the case of *Petridge v. Wells*,¹ in which Duer, J., said that in the mode of acquiring his title the plaintiff was guilty of a deliberate attempt to deceive the public. The written agreement between him and the person whose recipe he purchased stated that the consideration of the transfer was the sum of \$7,500, to be paid in cash, and that of \$2,500, in promissory notes falling due at different periods. This statement, though not wholly false, was a very great exaggeration. Of the \$7,500 to be paid in cash not one dollar was paid or meant to be paid. The \$2,500 in notes was the whole consideration of the transfer. The advertisement to the public that the plaintiff had paid \$10,000 for the recipe was intended to create a false impression of the real value of the purchase. The agreement was framed to silence the doubts of those who might inquire, and to be used as conclusive proof that the advertisement was true. "I will not say," said the judge, "that the title thus acquired is not valid in law, but I cannot believe that it deserves to be aided by an injunction from a court of equity." It must be observed that this section uses the word "action," which must be taken in its technical sense as employed throughout this statute, meaning the legal remedy only, the "action on the case" mentioned in section 79. It could not be said that the title had been *fraudulently obtained*, for the plaintiff certainly took all the interest that his assignor had had, and he was the sole proprietor of the trade-mark. Nor was that mark obnoxious to the objection that it had "been *formed* and *used* with the design of deceiving the public;" for, if it was a trade-mark at all, its inception was free from any such imputation. There is no doubt, therefore, that on the law side of the court such objections under similar circumstances would be untenable.

§ 373. It may safely be assumed that this section (84) is

¹ 4 Abb. Pr. R. 144; 13 How. Pr. R. 385.

but a reaffirmance of the doctrines of the common law. In that, it is well-settled that a claim founded upon a transaction which is either *malum prohibitum* or *malum in se* cannot be enforced in an action of any kind.¹ It has been held that an agreement on which an action was brought was invalid, as "contrary to public policy, and to open, upright, and fair dealing." A contract to do an illegal and immoral act is invalid, and will not be enforced in courts of justice, either of law or equity.² Fraud avoids a contract *ab initio*, both at law and in equity, whether the object be to deceive the public, or third persons, or one party endeavors thereby to cheat the other: for the law will not sanction dishonest views and practices, by enabling one to acquire, through the medium of deception, any right or interest. It is a question whether the title of the plaintiff can be inquired into by the defendant upon a plea of the general issue; or, indeed, whether he can examine a title not claimed under himself. Of course, if the plaintiff do not make out a *prima facie* title to the trade-mark alleged in the declaration, he must fail in any event. The difficulty of treating this question may be overcome, in this particular instance, by the answer that this section contemplates only a case where a trade-mark has been registered by means of fraudulent representations. This, however, is but a cutting of the Gordian knot; for a trade-mark cannot be *fraudulently obtained* from the Patent Office of the United States, inasmuch as no power resides in the Office, nor in the United States, to grant a trade-mark. All that is done by the authority of the Act of Congress is to issue a certificate of registration. The act regulates: it does not create. These remarks are intended to provoke investigation into the purpose and intent of this legislative provision, rather than to attempt to ascertain and define.

§ 374. **Deceiving the Public**, as by acting a lie by means of a

¹ Eberman v. Reitzell, 1 Watts & Serg. 181. See also 18 Pick. 472.

² Forsythe v. State, 6 Ham. 21; Chitty on Contracts, 678, and cases there cited.

false indication of origin, that the vendor may obtain the benefit of the reputation that certain goods may have, as when the signs on cigars made in New York indicated that they were made in Havana ;¹ or when a quack medicine is held forth as a panacea for an incongruous group of diseases ;² or when a man by the use of his own name attempts to impose upon the public his goods as those of another ;³ or when he falsely represents an article to be protected by a patent ;⁴ or in many other cases that might be cited to illustrate this principle of the common law. And it will be no answer to the charge of deceiving the public that the deceit was really for the benefit of the public.⁵ Truth is the standard required. The court said, in *Matsell v. Flanagan*,⁶ that the enforcement of the doctrine that trade-marks shall not be simulated does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle that the public are entitled to protection from the use of previously-appropriated names of symbols, in such a manner as may deceive them, by inducing to the purchase of one thing for another. In another case it was held that a mere false or exaggerated statement in a public advertisement, tending to recommend the manufactured article to the public, will not deprive the owner of a right to be protected in the exclusive use of his trade-mark ; and the court further held, that the fraudulent imitator of the mark could not be heard to raise the objection.⁷ It has also been held, that the fact that a trade-mark bears a fictitious name as the name of the manufacturer of the article, does not affect the owner's right to protection, when not used with a fraudulent intention to deceive the public.⁸ Hoffman, J., said : " It is

¹ *Palmer v. Harris*, 60 Penn. 156.

² *Fowle v. Spear*, 7 Penn. L. J. 176.

³ *Croft v. Day*, 7 Beav. 84.

⁴ *The Leather Cloth Co. case*, 11 Jur. (n.s.) 513.

⁵ *Partridge v. Menck*, 1 How. App. Cases, 558.

⁶ 2 Abb. Pr. R. (n.s.) 459.

⁷ *Curtis v. Bryan*, 2 Daly, 212 ; 36 How. Pr. R. 33.

⁸ *Dale v. Smithson*, 12 Abb. Pr. R. 237. .

constantly insisted, and the position is sanctioned by some judges, that when the article in question is innocuous, or in some degree useful, no absurd panegyric, or extravagant price, is a reason for denying the interference. In short, as counsel once said before me, if a man should compound tallow with some high scent and beautiful coloring-matter, and term it 'The Ointment of Immortality,' he has a right to appropriate so much of the public credulity as he can to this designation."¹ These remarks do not inculcate as high a standard of morals as might be expected from so learned and upright a jurist; and in justice it must be said that they do not represent the sentiments generally entertained by judges. It was said by E. Darwin Smith, J., that individuals should not themselves attempt, or allow, any imposition upon the public by the false and fraudulent use of their genuine labels, devices, or names, for the sale of spurious or simulated articles. So when the plaintiffs sold to the defendant about twenty thousand empty seed-bags with the label of the plaintiffs upon them, and two thousand papers or bags of seeds bearing the same label, and so enabled the defendant to impose upon the public, which he did by violating his promise to fill the empty bags with seeds of good quality, the plaintiffs in effect deceived the public, and were left without remedy.² When the defendant filled the empty seed-bags with seeds of a poor quality, the purchasers were defrauded, and through the fault of the plaintiffs.

§ 375. To guard as much as possible against the danger of deceiving the public, the Office avails itself of the implied judicial power granted to it by section 79, and endeavors to fathom the motives of applicants for registration. It is immaterial whether the intention of fraud actually exist in the mind of the applicant, if there is a reasonable probability that the public may be misled. Therefore, when an application was made

¹ *Fetridge v. Merchant*, 4 Abb. Pr. R. 156.

² *Bloss v. Bloomer*, 23 Barb. 604.

for the registry of the words "American Sardines," as a trade-mark, to be placed upon boxes ordinarily used for the sardines of commerce, the case was rejected; and that, even although it was alleged that the native fish — which is *not* a sardine — is equal in nutritious qualities and delicacy of taste to the imported article. The appearance of the package and the name were calculated to induce the public to buy one thing instead of another. In another case the proposed trade-mark consisted of the words "American Sterling," intended to be stamped on goods made from a peculiar metallic alloy closely resembling real silver, both in color and weight. The Special Examiner declined to recognize the words as a valid trade-mark, for the reason that they were calculated to mislead. An appeal, *pro forma*, was taken to the Commissioner in person. He held thus: The mark may or may not mislead. That is a matter to be determined in the future, according to circumstances which may arise. A case of *primâ facie* right to registry has been made out.

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

some one had not appropriated it as his mark of manufacture ! The whole language might thus by degrees be fettered, so that a merchant would not dare to call his wares by their right names. The correct doctrine is now better understood.

§ 377. The decision in “The Blanchard Churn”¹ case gave an impetus to this way of thinking. The Examiner refused the application for registration of these words, to be stencilled on the side or lid of churns manufactured by persons of the name of Blanchard ; and he insisted that the *words* should be accompanied by some *sign* or *mark* to distinguish the same from the mere words alone, to the use of which letters other possible parties of the same name in the like business might have an equal right. On appeal to the Commissioner, he said that the question, What constitutes a lawful trade-mark ? is left by the statute just where the common law leaves it, with a simple limitation, that it shall not be the mere name of a person, firm, or corporation only, unaccompanied by a *mark* sufficient to distinguish it from the same name when used by other persons. The only thing ambiguous about this limitation, said he, is the meaning of the word *mark*. The Examiner seemed to understand by this word some device, figure, or emblem, something other than mere words, from which he, the Commissioner, dissented. He was clearly of the opinion that the expression, “The Blanchard Churn,” is not the mere name of a person only, but that the name is accompanied by the marks “The” and “Churn,” and hence is not excluded by the limiting clause of the statute. *Held*, the combination of the three words, “The Blanchard Churn,” seems to possess the necessary characteristics of a trade-mark, and is not excluded by the limitations. The decision of the Examiner is therefore reversed.

§ 378. The foregoing decision opened the door to many proposed trade-marks of an exceedingly doubtful nature. Finally, after the registration of combinations formed upon the model

¹ Commissioner's Decisions, 1871, 97.

thus furnished, the question came up again before the same Commissioner. In this instance, the proposed mark consisted of the words "The Hall Calendar Watch," intended to be affixed to a watch sold by the applicant, named Hall.¹ The counsel for the appellant cited the Blanchard case, and relied upon it to sustain his position. Certainly, if one were valid, so must the other be. One of the points on appeal was this: "If a person adopts the words 'The Hall Calendar Watch' as a trade-mark, and is the first to do so, and registers such in the Patent Office, thereby notifying the public of such, he is the first to comply with the requisition of the law, and consequently should be protected. If another person by the name of Hall wishes a trade-mark for watches, he must adopt another symbol." The decision of the Examiner, rejecting the application on the ground that those words could not constitute a valid trade-mark, was affirmed by the Commissioner.

§ 379. In other cases, in his oral review of the statements made by him in the Blanchard matter, the Commissioner entirely receded from the position there taken by him. Thus the question may, so far at least as the Patent Office is concerned, be considered to have been definitely set at rest. This virtually decides, if a decision upon so obvious a point seem necessary, that the mere fact of placing on record the evidence of claim cannot operate to *create* a title to the exclusive use of a symbol which could not be a trade-mark *without registration*.

§ 380. In another appeal case,² the Commissioner said that, at common law, the trade-mark to become legal, and to vest an exclusive right in the person adopting it, must have been so long in use as to be known and recognized in the market. That is, a person could not adopt a trade-mark to-day and successfully sue for infringement of it to-morrow; and he was of opinion that one object of the registry law was to settle this very question. *Registry*, said he, is notice to the world, and supplies the place of *long use* at common law.

¹ Commissioner's MS. Decisions, 1872.

² Dutcher Temple Co., Commissioner's Decisions, 1871, p. 248.

§ 381. If the Commissioner meant to intimate, as he probably did, that the reason why one could not recover at common law upon a new mark is because he would lack evidence of its recognition in trade, and that one object of the statute was to furnish a convenient mode of proving adoption, then his decision is unquestionably sound. He is prohibited from receiving and recording any marks but those which would be valid at common law.¹

§ 382. Having easily become persuaded that Congress did not think of *creating* a trade-mark (as is evident from the whole of the legislation upon the subject, and especially by the language of the seventh subdivision of section 77, which prescribes that the applicant shall make oath that he "*has a right to the use of the same*"), we are led to the consideration of another point. It having been made tolerably clear to the shallowest apprehension that the act of recording is merely an act of recognition of a symbol affixed, or to be affixed, to merchandise with the intent that the purchaser shall associate it with a certain product, or a particular vendor, we ask, When is that symbol to be deemed to be affixed? Must there be actual taction, *i.e.*, a union of the symbol and the vendible article, or is the act of filing in the Patent Office *in law* an affixing? That is, does a man who *intends* to adopt a mark, and who complies with certain conditions and regulations, acquire a right to the exclusive use thereof as a mark for goods, *before* he shall have stamped, branded, or painted the same upon his merchandise? It has been contended by respectable counsel that he does. It is well worth our while to discuss and settle this point, as upon it must frequently depend the question of priority of adoption.

§ 383. What does the claimant register? His mark, or what he intends shall be his mark. But it is not a mark until actually *marked* upon something, and that something an article of commerce. He does not in any case file his mark,

¹ Sec. 79, Act of July 8, 1870.

but he does file "a description of the trade-mark itself, with fac-similes thereof," and he makes oath "that the description and fac-similes presented for record are true *copies* of the trade-mark sought to be protected."¹ We see that he does not file his mark, for that he could not do unless he could at the same instant sell to the United States the article bearing the mark; but he does file the *representation* of his mark. Does that fact vest title? Is he excused from actual use? May he lay his certificate in a bureau-drawer, as he would a patent, and for days, months, or years neglect to exhibit it to purchasers of the goods that he has specified, and at any time claim the right to exclusive use? If he may in one instance thus obtain title, he may adopt a thousand emblems, and remain in a quiescent state until one or more of the number shall have acquired celebrity in connection with the merchandise of others, and then assert his paper-title. the issuance of a certificate a symbolical delivery of property, as in the case of a deed of lands? For the sake of argument, we assume that the giving of a certificate is obligatory in all cases of registration. It is true that that is the practice; but as a legal truth, the registry is complete, even if no certificate ever be issued of that fact. The certificate is only evidence. We are not now indulging a speculative fancy, but considering a matter that has been argued again and again. The answer is this: The certificate has no analogy to a deed, for in a deed there must be a grantor as well as a grantee, and a thing to be granted. The Government does not pretend to hold title in the symbol employed as a trade-mark, and therefore it is not a grantor. It merely makes a compact with the proprietor of the mark, and guaranties protection for a consideration paid. If the certificate given upon registration were an investiture of title, a livery of seisin, what would be the logical effect? If a grant in one case, so must it be in another. If a man admit that he obtained a right to exclusive use by

¹ Sec. 77, third and seventh subdivisions.

registering his mark, he also concedes that the mark that he has used for half a century had no legal existence, and he thereby makes himself the junior of any imitator who has used it for a less time, and destroys the antiquity of his mark. Being driven to the wall, the counsel say that the intention to adopt, the filing, and the recognition by the Patent Office, is an adoption. Rutherford, in his *Institutes*, p. 25, tells us that "a man's bare intention of acquiring a thing is not enough to make it his own, till that intention is known; for without the consent of mankind no property could be gained justly, and there could be no ground for presuming that they consent to what they know nothing of. Now the act of occupancy is the outward mark by which his intention is made public. And this act is, therefore, understood to give him property." The act of occupancy of a symbol is that act which commerce throughout all ages, and in all countries, has imperatively required,—the physical application of the same to merchandise. This view of the law was entertained by the Office in the well-contested case of *Schrauder v. Beresford & Co.*,¹ and was silently acquiesced in by the counsel for the losing party, one of which counsel had been Commissioner of Patents, and the other Acting Commissioner; and more recently it has been reaffirmed in the case of *Sternberger v. Thalheimer & Hirsch*.²

§ 384. But this matter of adoption involves a refinement that we have not yet touched upon. Suppose A. to make a device, which he intends at a convenient time to stamp upon his goods as his distinctive symbol; and suppose that he has gone to great expense in procuring engravings, dies, or brands, for the purpose of affixing his symbol, but before his labels shall have been delivered by the printer, or his dies, or brands be put into actual use, B., learning A.'s intention, adopts that very symbol as his. B. is the first to actually use the mark; but is not his act of adoption tainted with fraud? A moral wrong has been committed by B. His conduct has, perhaps,

¹ In chapter on Interferences.

² Interference, Sept. 1872.

been a breach of confidence. We agree that a title to property cannot be obtained by fraud. But the answer to this suggestion of fraud is that A. must have had property before he could be despoiled of it. This unscrupulous act of B. is a wrong that must be adjudicated *in foro conscientie*, for no human tribunal can give redress. It is a clear instance of *damnum absque injuriâ*. We do not lack analogies to confirm this conclusion. It is a familiar fact that, by the fiction of the English patent-law, he is deemed to be the first inventor who first brings an invention into the realm, and that, although he is not the inventor in any sense. He has, in legal contemplation, been the first to find or discover the thing (a pleasant euphemism applied to theft). Hills, an American inventor of a machine for making brushes, embarked for England for the purpose of obtaining a patent. He had had confidential relations with one Sheldon in this country, and the latter conceived the idea of obtaining a patent for himself for the thing that Hills had invented, and actually reached England and secured a patent before Hills arrived there. Steps were immediately taken by the true inventor to enjoin the swift-footed sharper. *Held*, by the Lord Chancellor, to be a case of wrong without a remedy. (This case was cited by a legal gentleman in a trade-mark discussion. It is believed not to have been reported in print, the point having been decided in other instances.) In a hearing before the Attorney-General (Sir R. P. Collier), Nov. 26, 1870,¹ the counsel for the patentee in such a case argued: (1.) The law does not require the communicator to be the inventor. (2.) The non-resident inventor has no legal rights of invention. (3.) The person to whom the invention is communicated is the legal inventor. The adverse counsel, who represented the real inventor (one Overend, of San Francisco, Cal.), said that he could not controvert the argument. The Attorney-General dismissed the opposition, with costs against Overend. — We

¹ Dunn's application, No. 2427, Int. Pat. Off. circ., Jan. 1871.

may suppose a case wherein the actors are nations. It is ascertained by one nation that another nation is fitting out a fleet at great expense, with the intent of taking possession of a savage or an uninhabited country; and the nation first mentioned, without a moment's delay, pounces upon and holds the prey, and annexes the new territory. Who becomes the sovereign, — he who *intended* to seize, or he who actually did occupy the new country? Spain obtained her title to a large portion of the Western Hemisphere by the planting of her flag; but what if, while Columbus, or Vespuccius, was drifting over the ocean, a more swiftly-sailing flotilla had darted upon the coveted prize? Spain would have come to grief. The fact of first starting in the race would not avail. First come, first served. When a thing has no lawful owner, the first actual occupant obtains the exclusive right to it. This rule is as applicable to trade-marks as to any other property.

CHAPTER VIII.

INFRINGEMENTS.

Colorable Infringements. — At Law, and in Equity. — Whole Trade-mark need not be imitated to constitute Piracy. — As a General Rule, one may affix his Name to Product. — Exceptions. — One's own Name may be used as an Accessory to Fraud. — When Trader debarred from using a Trade-mark originated by Himself. — Use of Name of Old Commercial House. — Per-version of Mark.

§ 385. **What deemed Infringement.** — To entitle a trader to relief against the illegal use of his trade-mark, it is not necessary that the imitation thereof should be so close as to deceive persons seeing the two marks side by side; but the degree of resemblance must be such, that ordinary purchasers, proceeding with ordinary caution, are likely to be misled. Lord Cranworth, Chancellor, held:¹ The actual physical resemblance of the two marks is not the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of the rival as the actual copy of his device.

§ 386. In many cases, it may be difficult to determine whether the complainant's trade-mark has been actually pirated in such a manner as to be likely to deceive and impose upon his customers or the patrons of his manufactures or business, and in cases of doubt the court should not grant

¹ *Seixo v. Provezende*, 12 Jur. (n.s.) part i. p. 215; 14 W. R. 357.

or retain an injunction until the cause shall have been heard upon the pleadings and proofs, or until the complainant shall have established his right by an action at law. But if the court sees that the complainant's trade-mark is simulated in such a manner as probably to deceive his customers, or the patrons of his trade or business, the piracy should be checked at once by injunction.¹

§ 387. Now, although a court will hold any imitation colorable which requires a careful inspection to distinguish its marks and appearance from those of the manufacture imitated, it is certainly not bound to interfere when ordinary attention may enable a purchaser to discriminate. It does not suffice to show that persons incapable of reading the labels bearing the mark might be deceived by the resemblance. It must appear that the mass of ordinary purchasers paying that attention that such persons usually do in buying the article would probably be deceived.²

§ 388. In *Clark v. Clark*,³ in the Supreme Court of New York, at a general term, in 1857, the facts were these: The plaintiffs were manufacturers, at Mile-End, Glasgow, of spool cotton. In 1843, they used their trade-mark, consisting of four concentric circles; the inner one in gold, and the next in silver; the whole bounded by two concentric black lines. In the inner circle is the number of the cotton; in the next, "J. Clark, Jr., & Co., Mile-End, Glasgow," at the bottom. In the next circle are the words, "Six Cord Cable Thread, warr'd 200 yards." In the outer circle are the words, "Sole Agent, Wm. Whitewright, New York." J. & J. Clark & Co. were also manufacturers of the same class of goods at Seed Hill, Paisley, and the defendant was their agent. They both sold largely in the United States. The defendant, some years after the plaintiff's trade-mark was well-known, adopted one for his

¹ Chancellor, in *Partridge v. Menck*, 2 Barb. Ch. R. 101; 1 How. App. Cases, 558.

² *Partridge v. Menck*, 2 Sand. Ch. R. 622.

³ 25 Barb. 76.

cotton to be sold in the United States, consisting of concentric spaces of precisely the same dimensions as those of the plaintiffs', of the same colors, in the same order, with the letters in black, or in gold, as the plaintiffs'. There is the same number for the inner circle, with the same kind of stamp. In the next circle are the words, "Clark & Co., Seed Hill, Paisley," "Clark & Co." being at the top, as in the plaintiffs', and the same words, so far as they go, as in the plaintiffs', and the other words below and in the reverse order, as are also the plaintiffs'; though these last words are entirely different from the plaintiffs'. Then, in the next circle, "Six Cord Cabled Thread, warr'd 200 yards," precisely as in the plaintiffs', in black ground and gold letters; and in the outer circle the words, "Sole Agent, George Clark, New York," the words "Sole Agent, New York," being the same as in the plaintiffs', even as to their position; the place of their beginning and ending, and the stamp for the letters, being exactly alike, also, in both.

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

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

§ 391. The foregoing suggestion of Mr. Justice Mitchell, in delivering the opinion of the court, must be taken *cum grano salis*. The court was not called upon to devise a label, or a mark, for the defendants. We must separate the judgment from the mere *obiter dictum*, or we may be sadly misled as to wherein consists the plaintiffs' trade-mark. The four concentric circles, the inner one in gold, and the next in silver, the whole bounded by two concentric black lines, *they* constitute the essential elements of the technical trade-mark. That being the case, the defendants would not have any right to use them for the same class of merchandise, even by changing the order of the colors, and the style of the lettering.

§ 392. **At Law**, the remedy for piracy of a trade-mark is by an action on the case in the nature of a writ of deceit. This remedy is founded upon fraud; and it seems that originally an action was given not only to the trader whose mark had been pirated, but also to the buyer in the market, if he had been induced by fraud to buy goods of an inferior quality.

§ 393. "In **Equity**, the right to give relief to the trader whose

trade had been injured by the piracy appears to have been originally assumed by reason of the inadequacy of the remedy at law, and the necessity of protecting property of this description by injunction. But although the jurisdiction is now well settled, there is still current in several recent cases language which seems to give an inaccurate statement of the true ground upon which it rests." Such is the language of the Lord Chancellor of England in 1865.¹ He then takes up *Croft v. Day*,² and *Perry v. Truefitt*,³ where the late Lord Langdale is reported to have used words which place the jurisdiction of courts of equity to grant relief in cases of piracy of a trade-mark entirely upon the ground of the fraud that is committed when one man sells his own goods as the goods of another. He also quotes the language attributed to Vice-Chancellor Wood:⁴ "All these cases of trade-mark, therefore, turn not upon a question of property, but upon this, whether the act of the defendant is such as to hold out his goods as the goods of the plaintiff." This statement the Lord Chancellor pronounces to be inaccurate. For "first the goods of one man may be sold as the goods of another without giving to that other person a right to complain, unless he sustains, or is likely to sustain from the wrongful act some pecuniary loss or damage. Thus in the case of *Clark v. Freeman*, 11 Beav. 112; s. c. 17 Law J. Rep. (n. s.) Chan. 142, the eminent physician, Sir James Clark, applied for an injunction to restrain a chemist from publishing and selling a quack medicine under the name of 'Sir James Clark's Consumption Pills;' but the court refused to interfere, because it did not appear that Sir James Clark had sustained any pecuniary injury. Secondly, it is not requisite for the exercise of the jurisdiction that there should be fraud or imposition practised by the defendant at all. The court will grant relief although the defendant has no intention of selling his own goods as the goods of the plaintiff, or of

¹ 11 Jur. (n.s.) 513.

² 7 Beav. 84.

³ 6 ibid. 56.

⁴ 1 Hem. & M. 287; 32 L. J. R. (n.s.) Chan. 721.

practising any fraud either on the plaintiff or the public. If the defendant adopt a mark, in ignorance of the plaintiff's exclusive right to it, and without knowing that the symbols or words so adopted and used are current as a trade-mark in the market, his act, though innocently done, will be a sufficient ground for the interference of the court, as is plain from the decision of Lord Cottenham, in the case of *Millington v. Fox*, to which I entirely assent, and from the learned Vice-Chancellor's own opinion, in the case of *Welch v. Knott*, 4 Kay & J. 747, 751. Imposition upon the public, occasioned by one man selling his goods as the goods of another, cannot be the ground of private action or suit. . . . The true principle, therefore, seems to be that the jurisdiction of the court in the protection given to trade-marks rests upon property; and that the court interferes by injunction because that is the only mode by which such property can be effectually protected. The same things are necessary to constitute a title to relief in equity in the case of the infringement of the right to a trade-mark, as in the case of the violation of any other right of property. First, the plaintiff must prove that he has an exclusive right to use some particular mark or symbol in connection with some manufacture or vendible commodity; and, secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff's custom and injure him in his trade or business."

§ 394. Lord Cranworth, in the same case, fully concurred in the principle just enunciated; and intimated that to hold otherwise would be to make the Court of Chancery auxiliary to the protection of fraud; for the principle is founded on honesty and good sense, and rests on authority. Lord Kingsdown, in the same case, also placed the right of a plaintiff in a suit for infringement upon the ground of property in the mark; and said that the fundamental rule is, that one man has no right to put off his goods for sale as the goods of a rival trader, by using his name, mark, or other *indicia* of origin or manufacture.

§ 395. The Supreme Court of Connecticut, in *Boardman v. The Meriden Britannia Co.*,¹ in 1868, said that the object or purpose of the law, in protecting trade-marks, is twofold: first, to secure to him who has been instrumental in bringing into market a superior article of merchandise, the fruit of his industry and skill; second, to protect the community from imposition, and furnish some guaranty that an article purchased as the manufacture of one who has appropriated to his own use a certain name, symbol, or device as a trade-mark, is genuine. Consequently, the violation of property in trade-marks works a twofold injury; the appropriator suffers, in failing to receive that remuneration for his labors to which he is justly entitled, and the public in being deceived, and induced to purchase articles manufactured by one man, under the belief that they are the production of another. Robertson, J., in *Corwin v. Daly*,² said that the origin of the favor shown to trade-marks was the protection of the public, and not merely the individual dealer. The first case containing this doctrine reported, on which all the others seemed to depend, is found in a note of Doddridge, J., to the case of *Southern v. How*,³ and referred to by Lord Hardwicke, in *Blanchard v. Hill*,⁴ and then the action was brought by a purchaser. In *Blanchard v. Hill*, Lord Hardwicke makes the right of action grow out of the fraudulent design both of putting off an inferior article *and* drawing away customers. He possibly may have meant that either was sufficient, and that both were not necessary. The doctrine was recognized as law by Lord Mansfield, in *Singleton v. Bolton*,⁵ and enforced in *Sykes v. Sykes*,⁶ and thoroughly sifted and defined in the elaborate and important case of *Crawshay v. Thompson*.⁷ In this last case, a bold attempt was made to make the defendant liable for the use of trade-marks, without reference to his intention, but it was thoroughly canvassed and rejected by the entire bench; so that, at common

¹ 35 Conn. 402.

³ Popham, 143, and Cro. Jac. 471.

⁵ 3 Doug. 393.

² 7 Bos. 222.

⁴ 2 Atk. 484.

⁶ 3 Barn. & C. 541.

⁷ 4 Man. & Gr. 357.

law, an action will not lie without proof of an intent to deceive, and it is by no means clearly settled that courts of equity will interfere without some evidence of fraud. They operate by their remedial powers to prevent the continuance of a wrong, and reach the past action of the offender by converting him into a trustee for the injured party; so that now, even though the article sold with the simulated mark be equally good with the genuine, the owner of the latter is entitled to preventive relief, although the public may not have been the sufferer. It seems impossible now to discover the first assumption of this jurisdiction, or its reasons.¹

§ 396. In the case of *The Dixon Crucible Co. v. Guggenheim*,² the judge said substantially: The stove-polish of the plaintiffs is put up in small cubical blocks, — say two inches by an inch and a quarter, — and covered with a blue printed wrapper, containing in printed letters upon one side of the cube the words, “Dixon’s Prepared Carburet of Iron, for polishing stoves, grates, ranges, and every kind of cast and sheet iron work.” The next side of the cube contains a statement of the superior character of the article. The third has the printed announcement that it is “prepared from pure Carburet of Iron only by Joseph Dixon & Co., black-lead crucible manufacturers and practical chemists, Jersey City, N. J.,” while the fourth side of the cube contains the directions for the use of the article. The ends of said cube have a yellow label with the following words and figures thereon, viz.: “STOVE POLISH. DIXON’S PREPARED Carburet of Iron. Price 10 cents.” So much for the plaintiffs’ article. That of the defendant is also put up in cubes of about the same size as that of the plaintiffs’, — with a blue wrapper and yellow ends. Slight differences exist when the two are placed side by side, but to one not thoroughly familiar with both, the one could easily be mistaken for the other, so far as the shape and

¹ *Corwin v. Daly*, 7 Bos. 222.

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

general appearance are concerned. On one side of the cube are the printed words: "J. C. Dixon's Prepared Carburet of Iron, for polishing ranges, stoves," &c. On the next side, the virtues or merits of the article are set out; on the third are the words: "Prepared from pure Carburet of Iron by J. C. Dixon;" and on the fourth side are the directions. The ends have a yellow label, on which are the words: "J. C. DIXON'S STOVE POLISH. Carburet of Iron. Price 10 cents." There are differences in the types and the lettering, and the virtues of the respective articles, and the directions for their use are not stated in precisely the same terms, but the general effect is very similar. The defendant has varied his label somewhat, and in some instances the words "pure plumbago" are substituted for the words "carburet of iron;" but the general appearance and effect are substantially the same. A number of affidavits were read, on both sides, as to the closeness of the alleged imitation. Those of the plaintiffs say that the defendant's article is purchased and used to a very large amount by persons who supposed that they were buying the plaintiffs' polish; while the defendant's affidavits allege that both the Joseph Dixon and the J. C. Dixon polish are known to the trade, and that the defendant never sells the one for the other. Further, that any one of common understanding can distinguish between them, and that persons are not likely to be misled. But upon this point the testimony of the defendant is merely negative. That of the plaintiffs is positive and strong. The public have been misled. It is true that the wholesale dealers may generally understand the difference between the two articles, and may not sell the J. C. Dixon for the Joseph Dixon; but the small retail dealers, scattered all over the world, do not so understand this distinction, and if they did, might not regard it. Much less would their customers — many of whom are ignorant people, sometimes domestics sent to the store by their employers — recognize any difference between them, or know whether they were buying

the Dixon stove-polish which has been celebrated for so many years, or the article manufactured and sold by the defendant. In this case, I have the articles before me, and can judge by inspection as to the resemblance. The result of such a test has left no doubt upon my mind that defendant's article is put up in a shape and with wrappers and labels to closely resemble those of the plaintiffs. And, when to all this we add the fact that defendant has taken the name "Dixon," by which plaintiffs' article is known, the resemblance is complete. True it is that they are not exactly alike. But the whole trade-mark need not be counterfeited. And the court will examine to see if the very differences are not colorable. . . . The mere probabilities of deception justify the remedy by injunction. . . . The defendant's article, in my opinion, is, as I have before stated, a close and palpable imitation of that of the plaintiffs'. The defendant has no person of the name of Dixon in his firm. He does not pretend to have any authority from any one to use that name. He gives us no account of the "J. C. Dixon" whose name he uses. If there is no value in the name, and the defendant does not mean to deceive, why does he use a name to which it is clear he has no right, and at the same time imitate so closely the wrappers and stamps of the plaintiffs? That he does so for the sole purpose of enjoying the benefit of the name and reputation of the plaintiffs' article, there can hardly be a reasonable doubt. . . . It is proper to add that Joseph Dixon & Co. have established their right to the use of this trade-mark in the courts of several States. . . . I am clear that the injunction should go out.

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

§ 397. In *Lockwood v. Bostwick*,¹ the court said, *inter alia*: An inspection of the two labels shows that the one used by the defendants, and the use of which the plaintiffs seek to restrain by injunction, is, in respect to form, color, words, and symbols, so like the former as to make it manifest that the design of the defendants in using it was to deceive, the resemblance being such as would be likely to impose upon ordinary purchasers. It was alike in the form and size of the label; in the color of the paper, — a peculiar, delicate, gray tint; the machine or apparatus represented was one that had no existence in fact, but resembling the real machine sufficiently for the difference to escape observation unless upon attentive examination; and the word “BOVINA” was substituted for “BOVILENE,” printed in the same type, and in exactly the same place as the other at the head of the label. The design evidently was to depart from the other sufficiently to constitute a difference when the two were compared, and yet to do it so skilfully that the difference would not be detected by an ordinary purchaser unless his attention were particularly called to it, and he had a very perfect recollection of the other label. The design was to deceive, and to obtain, in the manufacture and sale of the article, any benefit or advantage that might be gained by its being purchased for another article of the same description, which was known and distinguished by a particular trade-mark. There could be no other motive; and it was done with the shallow expectation that the law would not see through the motive, but pronounce that the two labels were not the same, by simply distinguishing the points of difference between them. So far as the object sought could be attained, it would operate to the plaintiffs’ detriment by diminishing the sale of their articles in the market, and they are entitled to be protected by a court of equity from this attempt on the part of rivals to deprive them of the fruits of their industry or enterprise, in making their own fabric known

¹ 2 Daly, 521.

and recognizable by its distinctive trade-mark. In *Burnett v. Phalon*¹ it was found as a fact, that the defendants well knew that the plaintiffs used the word "COCOINE" as their trade-mark; yet the defendants took the word "COCOÏNE" as their mark, to designate the same kind of merchandise, to wit, a preparation of cocoa-nut oil. The court, by Bosworth, C. J., said, in substance, that the defendants had been frequently experimenting with cocoa-nut oil, and selling it since 1840 (and the trial was in 1859), and vending it as a preparation of hair-oil. It was a simple matter to get up a label, and impress on it, and on the bottles containing their compound, the word "Cocoïne," omitting one letter only of the plaintiffs' word. But no plausible or rational explanation, except an intent to defraud, could be given of a transaction so bold as to take the word "Cocoaine." It was, undoubtedly, deemed wiser to instruct the chemist to compose a name somewhat indicative of the substantial ingredients of the compound, without informing him of the fact that Burnett was manufacturing and selling largely a similar article, which was known as "Cocoaine." In this case similarity between the labels of the parties could hardly be said to exist; and yet the piracy was manifest. A very similar case was decided in the Court of Paris, in 1862, — *Guislain & Co. v. Labrugnère*.² The plaintiffs made and sold a hair-dye, to which they had given the name "EAU DE LA FLORIDE" (Florida Water). The defendant, for a product of the same nature made or sold by him, took the name of "EAU DE LA FLUORIDE" (the last word signifying a compound of fluorine with a metallic or combustible base). By this ingenious interpolation of a single letter, the defendant thought to escape the legitimate consequences of his roguery, while he deceived the public for his own profit. Having been defeated in the court below, he appealed. The appellant's counsel argued that there was really no conflict between the two trade-

¹ 9 Bos. 192; 5 Abb. Pr. R. (N.S.) 212; and 3 Weyes, 594.

² *Annales de la Prop.*, tome ix. p. 40.

marks; for the plaintiffs represented their product as a natural water imported from Florida, whence its name; while the appellant offered his article only as a chemical composition, — a combination of fluorine with nitrate of lead or of silver, whence its name of *Fluoride*; and that this term of chemistry designates the combination of fluorine with bodies less electro-magnetic. Moreover, the appellant claimed to have always maintained a dissimilarity of flasks, labels, bills, advertisements, notices, &c. This pretence did not avail. The appellate court not only sustained the judgment, but, finding that it possessed the elements necessary for making a new and more just appreciation, it increased the damages given by the court below.

§ 398. In the Tribunal of Commerce of the Seine, in 1866 (*Bardou et al. v. Sabatou et als.*¹), came up this interesting case. Bardou, senior, was the first manufacturer of cigarette-paper in France, in or about the year 1841. This paper was sold in little packets covered with glazed paper, having a brown ground, on which was printed, in gold, the letters J. B. separated by a lozenge. In consequence of an error on the part of the public, this lozenge was taken for the letter O, for which reason the paper became known only under the name of “JOB PAPER.” The maker J. Bardou, *père*, accepted this designation, and adopted the name “JOB” in the registration of his trade-mark. Many decisions of courts had confirmed his title to this word as his commercial emblem or mark. A lithographer of Toulouse made and sold similar packets of paper, having the same color, but bearing different ornaments, and over which he had inscribed in large characters this notice: “GUERRE À JOB PAPIER TRÈS SUPÉRIEUR. Paris, 80, Rue de Rivoli, 80. TAKE NOTICE. — LET NO PERSON BE SURPRISED. I AM NOT THE SAME MARK *of the cover which bears the title JOB.* But I guaranty that I enclose a paper superior to JOB by the addition of hygienic substances.” The sale of this paper was

¹ Annales de la Prop., tome xiv. p. 140.

announced as well in Paris as in Toulouse, the prospectus affixed reading thus: "I possess the sole general use of the cigarette-paper GUERRE λ JOB, incontestably the best paper that exists, the superiority of which is recognized not only by all consumers, but also by the Messrs. Bardou & Pauilhac, proprietors of the JOB paper. The last observe silence to the defiance given to them to dare say that the paper GUERRE λ JOB is not superior to theirs," &c., &c. The defendants voluntarily withdrew from their notice the names of the plaintiffs. The design of the defendants in using the name of the article and the names of the true owners of the mark was too manifest. The court therefore enjoined them from using the name JOB, saying, among other things, as follows:— *As to the suppression of the name of JOB*: Whereas, Sabatou, a fabricant of cigarette-paper, sells his products under the same form as those of the plaintiffs, and employs a paper wrapper of the same color, bearing the inscription "GUERRE λ JOB" (&c., as above stated); whereas, the lawful competition which should exist between merchants, cannot be extended to include a right to take the distinctive denomination of a rival even for advertisements and circulars, with the design of diverting his custom; whereas, it is manifest that Sabatou, in the use of the name of JOB, and in indicating the superiority of his paper, had no other object than to destroy the reputation enjoyed for the paper sold under the title of JOB, and to cause confusion by holding forth the said name; therefore, it is ordered that Sabatou cease for the future to use the name of JOB on his covers and prospectuses. *As to damages*: Inasmuch as, by the conduct of Sabatou, the plaintiffs have shown that they are entitled to reparation for injury received, and this tribunal possesses the elements for the appreciation of the same, let Sabatou be held to pay them the sum of 5,000 francs, with costs. On appeal to the Court of Paris, which heard the matter in 1869, the judgment was affirmed, although the damages were reduced to 3,000 francs.¹

¹ Annales de la Prop., tome xv. p. 115.

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

§ 400. The Court of Cassation (the supreme court of France), in 1867, — *Lagarde v. Piper*,¹ — *Held*: It is a fraudulent imitation of a mark, falling within the provisions of art. 8 of the Law of 23 June, 1857, to servilely copy the label of another merchant, although a name or pseudonym be interpolated other than that of the true owner. The offence is committed in France, and not in a foreign country, even although the label bearing the mark, which has been in part fraudulently imitated, is not intended for use in France, but is intended to be sold in foreign countries, for the purpose of there being affixed by others. The piracy consisted in the imitation in part, with the design of profiting by the reputation belonging to another.

§ 401. In *Gillott v. Esterbrook*,² the defendants took only a portion of the plaintiff's mark, viz., the numerals 303 (which by themselves probably could not be a lawful trade-mark),³ and yet were found guilty of infringement. The defendants manufactured a pen in shape, color, size, and pattern, so closely resembling the pen of the plaintiff that it required an

¹ *Annales de la Prop.*, tome xiii. p. 293.

² 47 Barb. 455.

³ See §§ 225-233, *ante*; and also *Glen & Hall Man'g Co. v. Hall*, *Albany Law Jour.* vol. v. p. 109 (1872).

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

mentation as fancy or interest may dictate; he may imitate any pattern or quality of pen, even if known to be made by any other manufacturer; he may, if he can, make a superior article in material, pattern, or quality, and if he can do so, he has the right to select a device or symbol, as a trade-mark, to designate his manufacture from others: and, if such device or symbol relates to the origin or ownership of the goods to which it is affixed, his legal right to protection is undoubted. Such protection is no restraint upon the freest exercise of talent, enterprise, and competition in trade, but rather a proper stimulant to encourage competition. His superior skill and enterprise give him the right to its profits and advantages, and this is giving no encouragement to monopolies so destructive to the freedom of trade. It may be that in this case the defendant's pen is equal in merit, or even superior to the plaintiff's. This was not an issue in the case. . . . It is no hardship upon the defendants to have them stand upon the merits of their own pen, unaided by the reputation of the plaintiff as a manufacturer, or by the merits of his pen. . . . The design to defraud may be as apparent, and is generally more injurious, in the partial than in the entire imitation. When the trade-mark is a conspicuous device, connected with the name of the true proprietor, of course the imitator would desire to avoid the offence of forgery, and would omit on his own article the name of the true proprietor, and substitute his own.

§ 402. In *Walton v. Crowley*,¹ Betts, J., said: On ordinary observation, the labels used by the two parties in this case would not be apt to be distinguished the one from the other, — the size, shape, vignette, coloring, and marking being so nearly identical as to make them easily pass for the same; and the only difference discernible, on considerable scrutiny, being in the name of the warrantor, stamped upon them in letters so small as not readily to attract notice. It is this apparent similitude or counterfeiting which is the grievance complained of

¹ 3 Blatch. C. C. 440.

A tradesman, to bring his privilege of using a particular mark under the protection of equity, is not bound to prove that it has been copied in every particular. It is enough for him to show that the representations employed bear such a resemblance to his as to be calculated to mislead the public generally who are purchasers of the article, and to make it pass with them for the one sold by him. If the *indicia* or signs used tend to that result, the party aggrieved will be allowed an injunction staying the aggression until the merits of the case can be ascertained and determined.

§ 403. In one case,¹ the plaintiffs, rectifiers of whiskey, had as a brand for their goods the representation of two anchors placed near together in an upright position, the upper parts inclining outward, with a rope attached. Over the device, in a circular form, were the initials "S. Mc." The device and letters were stencilled upon the heads of barrels containing a particular kind of whiskey known in the trade as "double anchor," or "double-anchor whiskey." They brought suit to enjoin the defendant from using in his whiskey trade an alleged counterfeit in imitation of their trade-mark. The supposed imitation consisted in the representation of two picks placed near together in an upright position, with the handles inclining inward. Between the handles was suspended a pair of balances or scales. The defendant's name was placed over the picks, and the words "Old Bourbon" underneath; the whole inscription reading, "J. H. Garnhart's Old Bourbon." The defendant stencilled this brand upon the heads of the whiskey-barrels. He used the whiskey thus put up and branded for his mountain trade, and called it "pick brand."

§ 404. The picks were alleged to be an imitation of the anchors on the plaintiffs' head. That was the only point of resemblance insisted on. In all other particulars the court said that the marks were wholly dissimilar. Currier, J., in delivering the opinion of the Supreme Court of Missouri, said

¹ *McCartney v. Garnhart*, 45 Missouri (IV. Post's R.), 593.

that "the defendant's 'picks' resemble the plaintiffs' 'anchors' substantially, as a real pick resembles a real anchor of reduced dimensions. One who would mistake a miner's pick for a diminutive anchor might confound the defendant's brand with that of the plaintiffs', and hardly otherwise. The pick in the defendant's brand is quite as good an imitation of the article intended to be represented as is the anchor in the brand of the plaintiffs of the nautical instrument there sought to be represented. The resemblance between the two brands is too slight to be likely to mislead; and there is nothing in the testimony which shows that the defendant sought to dispose of his whiskey as that of the plaintiffs', or of the plaintiffs' rectification." We see here evolved the sole point: Was the pick made so nearly like the anchor-mark as to be likely to deceive the public? No. Therefore, the injunction was properly refused.

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

§ 406. A long and elaborate attempt was made to show that the defendants held a right to the use of the trade-mark which they had adopted. They held, either as owners or lessees, a vineyard adjoining that of the plaintiff, and several small vineyards on the opposite side of the river. "Seixo" means "pebbly" or "stony." *Vino de Seixo*, therefore, is only the same thing as *Vin de Grave*, in French, or *Stein Wein*, in German. . . . "Even

¹ *Seixo v. Provezende*, 12 Jur. (N.S.) part i. p. 215.

assuming the truth of what is contended for the defendants, *i.e.*, that parts of their vineyards are known by the name of Seixo, that does not justify them in adopting a device or brand, the probable effect of which is to mislead the public when purchasing their wine, to suppose that they are purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff. Cases may be imagined, though very unlikely to arise, in which a person bringing into the market for the first time the produce of a newly-established manufacture, to come into competition with one already established, may really be embarrassed as to the mode in which he should describe it, so as not to interfere with the description adopted by a manufacturer who has been before him. If such a case should arise, it must be dealt with on its own merits." Appeal dismissed with costs.

§ 407. A judgment of the Tribunal of Commerce having, so long ago as 1852, decided in principle that the father Garnier, in his own name, and in a representative capacity as *procureur* of the Carthusian monks, was the sole possessor of the title to the *liqueur de Chartreuse*, he frequently afterwards found himself involved in litigation in protecting his right. In the Tribunal Correctional of Grenoble, in 1857, came up one of the cases, — *Garnier v. Berthe*.¹ The defendant had made liquors which he sold under the title, *liqueur de Grande Chartreuse*. His label — which he had duly deposited — was on the same colored paper as that of the prosecutor; of the same form, dimensions, dispositions of characters and letters, with mottoes and phrases adopted by the monastery, and certain light clouds which disappeared at a little distance. This could not but cause confusion and error. Worse still, he had printed on his marks the very arms of the Chartreux, *i.e.*, a globe surmounted by a cross. To escape the just consequences of his fraudulent imitation, the defendant set up: 1st. That his liquors were the same as those of the Chartreux, whose secret

¹ *Annales de la Prop.*, tome iv. p. 119.

he had penetrated by the aid of magnetism (!), wherefore he called his liquors and elixirs *liqueurs et elixirs de la Chartreuse*; for, said he, to give them another name would be to deprive them of their special character. 2d. That he could not write his prospectuses in any way not conforming to those of the Chartreux, because his elixirs were similarly composed to theirs, and possessing the same virtues. 3d. That his marks, labels, &c., differed essentially from those of the monastery, because they did not bear *liqueur de la Chartreuse*, or *de la Grande Chartreuse*, but *liqueur fabriqué à Saint-Pierre-de-Chartreuse*, where he had established his place of business; and that he had on his labels his Exposition medal of 1855, his name, &c. The court was not beguiled with his oily blandishments, but ordered the confiscation of all his liquors and elixirs, and the destruction of his false labels and marks, with a fine of 500 francs, six months' imprisonment, and the publication of his villainy in eight public journals at Paris and other cities.

§ 408. In the Tribunal Corr. of the Seine, in 1868 (*Louis Garnier v. Paul Garnier*¹), the same name as a symbol of trade was brought into controversy. On certain liquors, seized at the defendant's place at the demand of the plaintiff, was found this title, somewhat changed. The labels of the bottles bore marks of the same form, dimension, and color as those of the monastery of the Chartreux, but with a framing or border a little different, and the inscription, "*Liqueur Hygiénique de la Chartreuse*," followed by the signature of *P. Garnier*. *Held*, an infringement. The fraudulent design of the defendant was manifest from the circumstances. It did not matter that both parties bore the same surname, and that the signatures placed upon the bottles were distinguished by the initials of the baptismal names, and with entirely different flourishes.

§ 409. Upon reference to the case first referred to, — that

¹ *Annales de la Prop.*, tome xiv. p. 252.

in the court of Grenoble, in 1852: *Garnier et al. Carthusians v. Rivoire*,¹— we find that the question from the beginning was in this, Whether the name of *chartreuse*, given by the Chartreux to the peculiar liquor manufactured by them, had not become a generic denomination that any one could lawfully employ to designate liquors of the same kind. The court decided that the plaintiffs had not the monopoly of the article of manufacture; wherefore the defendant had a right to make and vend a similar article, if he possessed the secret of manufacture, and in default of a name to give it one, even suggested by the resemblance, leaving the public to judge, but that the name of *chartreuse* must not be employed on labels, unless as a simple term of comparison, as, for example, *imitation de chartreuse*, the whole in the same kind of characters; or if another denomination were used, the sense should not be equivocal, to draw to the defendant. His custom must depend upon his own merit, without diverting the trade of the plaintiffs, the *Chartreux*. The reputation of the delicate fluids seems to have kept the venerable brotherhood in constant litigation. One decision made in their favor affected all the manufacturers of similar articles in the department of Isere and the Rhone; and they combined to prove the name *chartreuse* to be but generic. They signally failed, on appeal. The court said that the term *chartreuse*, which is but an abbreviation of the label of the Chartreux, is not a generic name, as would be a name derived from the nature of the liquor, or the substances of which it is composed; and the liquor would not have been so named, but that it had been invented at the monastery of the Grande Chartreuse, and made by the Carthusians; so that the name at once designated the *inventor*, the *maker*, and the *place of manufacture*, and constituted, in each of these particulars, a distinctive mark, a *specification which could not with verity be applied* to a similar or analogous product of Grenoble, by others. The same doctrine was affirmed

¹ *Annales de la Prop.*, tome iv. p. 115.

in 1868, in *Garnier v. Lindière et als.*¹ M. Pataille, the counsel for the Chartreux, argued that the composition of the article made by them is a secret, and even if chemistry could detect the presence of vegetable essences in a liquor, it is powerless to specify, in a complete manner, all the medicinal or aromatic plants entering into the composition, and still less determine the proportions, and the process of manufacture. As a sequence, if one had the right to make liquors more or less approaching in kind those of the Chartreux, no one could say that he made the identical liquor. He contended that therefore no one had the right to copy the idea embraced in the mark. The article not being the same, what right had any one to mislead by a label which implied that the liquor was identical? Then, the difference of price was injurious to the owners of the mark and makers of the genuine article; for the spurious was sold at one-half or one-third the price. The lowness of the price might not deceive merchants, who could not fail to know the cost of the genuine article; but, as to the public, that lowness is only the means of augmenting the sale of the false article. The depreciation of the reputation of the plaintiffs' article should be taken into consideration in adjusting damages.

§ 410. The case of *Louis Garnier v. Paul Garnier* came up in the Court of Paris, on appeal, in 1870,² and the judgment of the tribunal was affirmed. The court *held*, that property in a denomination or a mark is acquired by the first user thereof, independent of all deposit (equivalent to our registration), wherefore the special denomination of *chartreuse* employed by the Carthusians to designate the *liqueurs* manufactured by them at their monastery, is, as a trade-mark, their exclusive property. Consequently, they have a right to demand that other manufacturers or dealers be forbidden to use the word "CHARTREUX," or "CHARTREUSE," upon the class of merchandise that they, the plaintiffs, manufacture.

¹ *Annales de la Prop.*, tome xiv. p. 225.

² *Ibid.*, tome xvii. p. 241.

Not to let the matter drop without exhausting all means of defence, the defendant carried his case to the court of last resort. In April, 1872, it was decided in the Court of Cassation,¹ where the claim of the Carthusian monks to the right of exclusive use of the word so much harped-on was fully sustained. Therefore, we may regard the single word "CHARTREUSE" as possessing all the essential characteristics of a trade-mark;² and we may rest assured that any one is an infringer who varies that word, as did the defendant, in the futile hope that he might evade the penalty of the law.

§ 411. In *Edelsten v. Edelsten*,³ Court of Appeals in Chancery, 1863, the facts of the case were that the plaintiff, a wire manufacturer, with a view of distinguishing his wire from that of other manufacturers, in the year 1852 adopted as a trade-mark an anchor on the metal labels, called "tallies," which were attached to each bundle of wire sent into the market by the plaintiff's firm. For this reason the plaintiff's wire acquired the name of the "anchor-brand wire," by which it has since been generally known to the trade. Plaintiff complained of the defendant's use of a crown and an anchor as being a colorable simulation of his trade-mark. Judgment with costs, and an account of profits. Affirmed on appeal, with costs.

§ 412. In *Woolam v. Rateliff*,⁴ the plaintiff and the defendant were both large silk throwsters. The plaintiff was in the habit of making up his bundles of silk in a particular form, with forty-eight heads of silk in each bundle, tied with five strings in different places, with the silk protected from the knots of the strings by pieces of foolscap paper of a particular form, the heads of silk being themselves tied with silken strings of different colors to mark the quality of silk, and containing the following particular mark: "St. A * * * * *,"

¹ Annales de la Prop., tome xvii. p. 257.

² § 143, *ante*.

³ 1 De G., J. & S. 185.

⁴ 1 Hemming & Miller, p. 259.

which represented *St. Alban's*, the place where the plaintiff's manufactory was, and which was well known in the trade as the plaintiff's trade-mark.

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

§ 414. In the Court of Caen, in 1872 (*Carpentier v. Canivet*²), it appeared that the plaintiffs, the Brothers Carpentier, manufacturers of chocolate in Paris, have been in the practice of enclosing their products in envelopes bearing the fac-simile of a bill of exchange. The better to imitate a bill of exchange, the label, which has a double bordering of arabesques, represents engine-turned paper of a gray tint, with a band a little

¹ *Knott v. Morgan*, 2 Keen, 213.

² *Annales de la Prop.*, tome xvii. p. 233.

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

the position of one and the other on the tablets are identical: and to him who has not under his direct gaze the mark of the Carpentier Brothers, the deceit is inevitable. . . . The judgment below is reversed, with costs, &c.

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

¹ *Annales de la Prop.*, tome xv. p. 5.

that it took for principal title the denomination of “*Moniteur universel* ;” but this title was so taken with a knowledge of the fact that that name, as applied to journals, had become public property, wherefore care was taken to adjoin the distinctive qualification of *universel* ; and that under the general name of “*Moniteur*” more than one hundred and fifty journals had been published. Thus, said the defence, there is the “*Moniteur de l’armée*,” the “*Moniteur de la flotte*,” the “*Moniteur de l’industrie*,” &c. The defendant claimed that in law, as in fact, he had the greatest degree of interest in avoiding confusion between the two journals ; and that he had established a difference between them in taking the title of “*Moniteur officiel*.” It was held, *inter alia*, by THE TRIBUNAL: The title of a journal is property. It incontestably appears that the “*Moniteur universel*,” whether as a daily political and literary sheet, or as an historical collection, has always been known under the simple title of “*Moniteur* ;” and as in ordinary language, so in parliamentary, and even in official phrasology, this single denomination serves almost invariably to designate this journal, even for the periods when it was not the organ of the Government, and was not charged with the publication of official acts ; and this fact, which appears by all the documents, is also attested by the “*Bibliographie historique et pratique de la presse française*,” p. 125, in an article devoted to said sheet, of which the editor, Charles Joseph Panckoucke, was the founder ; and the plaintiffs, or those through whom they derived title, have not since 1789 discontinued to publish the journal under the denomination which was and is their property. If the word “*Moniteur*” is within the public domain as a generic expression, it nevertheless constitutes, for those persons who have adopted it to denominate their publication, a right of exclusive application. If the word has figured in the titles of certain journals which have ceased to appear, and figures still in those of a great number of others which have made themselves the organs of special professional or local

interests, it has never been applied to any of the great local political journals of Paris other than the "MONITEUR UNIVERSEL." If it were now to be employed in carrying on a literary and political journal other than that of the plaintiffs, an inevitable confusion between the two papers would result, whatever else might be the qualification adjoined thereto. This confusion is superabundantly demonstrated by the usage adopted, not only by the public but by the agency also of the defendant, of naming as the "MONITEUR" the journal that the defendant proposes to publish under the title of "LE MONITEUR OFFICIEL DE L'EMPIRE FRANÇAIS." After some further reasoning upon the subject, the Tribunal gave judgment, as follows: For these reasons, forbid Wittersheim to take the title of managing-printer of "*Le Moniteur officiel de l'Empire français*," or to make use for the publication and carrying on of the journal under his charge of the title of the "*Moniteur*," either singly or with the qualification *officiel*, unless he acquire the right. Order the insertion of this judgment in three newspapers at the choice of the plaintiffs and expense of the defendant. Condemn the defendant to costs. The defendant appealed; but the Minister of State, Rouher, recognizing the soundness of the foregoing judgment of the Tribunal of Commerce of the Seine, and in the name of the Emperor, revoked the authority that had been given to the defendant, and changed the name of the official paper to "JOURNAL OFFICIEL DE L'EMPIRE FRANÇAIS."

§ 416. In the Tribunal Civ. of the Seine, in 1869, came up a case similar in principle to the foregoing.¹ The plaintiff, manager of the journal "LA PRESSE," founded in 1836, brought suit to suppress the title of "LA PRESSE LIBRE," which the defendant had given to a new political paper. The defence contended that the word "press" is a generic name which all persons might lawfully use; and that the qualification of "*free*" (*libre*) adjoined to the word "*press*" constituted a

¹ Halbronn v. Malespine, *Annales de la Prop.*, tome xv. p. 142.

different title; and that therefore confusion between the two sheets was impossible, especially as the said journals followed two different political parties, and addressed themselves to different classes of readers. Yet judgment was rendered in favor of the plaintiff, with 300 francs damages and costs.

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

¹ *Annales de la Prop.*, tome xvii. p. 101.

francs damages and costs. In the Tribunal of Commerce of Amiens, in 1871 (*Millaud v. Caron*¹), the plaintiff in the last suit found himself engaged. In this instance, the defendant took the title of "PETIT JOURNAL" for his paper, but, as a sub-title in the second line, and printed in smaller characters, added the words "*de la Somme.*" The judgment says that the title of a journal is the exclusive property of its founder, and to give to a new journal the title already belonging to another sheet is a usurpation of property, and consequently an act of unlawful competition. Judgment for plaintiff, with 100 francs damages and costs, and an injunction forbidding the further use by defendant of the words "Petit Journal." Again, in 1871, before the Tribunal of Commerce of Douai (*Millaud v. Le Petit Journal du Nord*²), we find substantially the same question of part-infringement. The addition of the sub-title "*du Nord*" did not avail the defendants. They were forbidden to use the name "Petit Journal" with or without a sub-title, under penalty of 50 francs damages for each number that should be issued after that day, 300 francs damages and costs.

§ 418. The following case cannot properly be classified with technical trade-marks, as the matter in dispute is the phraseology of a label; still it will serve some useful purpose as an illustration. It is *Ellis v. Zeilin & Company*,³ in the Supreme Court of Georgia, in 1871. The plaintiffs below (defendants in error) in their bill allege that they are entitled to the sole and exclusive manufacture and sale of certain medicinal preparations, known as "DR. SIMMONS' LIVER REGULATOR or MEDICINE," having acquired the right thereto by purchase from the son of Dr. A. Q. Simmons, the inventor. They allege that they have expended large sums of money in extending the reputation thereof, and that they "have adopted certain trade-marks in which their packages are put up, which have been

¹ Annales de la Prop., tome xvii. p. 104.

² Ibid.

³ 42 Georgia, 91.

entered, under the copyright-law, in the District Court of the United States at Savannah.”¹ They further allege that Ellis, the plaintiff in error, has commenced to sell a preparation which he calls “SIMMONS’ GENUINE LIVER MEDICINE,” and is putting it up in similar form and size of packages, and that the general appearance and pirated indorsements thereon are intended to convey a wrong impression, and to take advantage of the reputation which Zeilin & Co.’s preparation has acquired, and which they allege to be a fraud on their rights; wherefore they ask for an injunction, and such other relief as they may be entitled to under the circumstances. To the bill, the defendant below (Ellis) demurred, but the court overruled his demurrer. Error was assigned and the case carried up.

§ 419. The question which we are discussing is one of alleged infringement. For argument sake, we will concede that the combination of words used by Zeilin & Co. constitute a lawful trade-mark. Was that mark infringed by the imitation in part by Ellis? From the report of the case, we find that he used a large symbol which the others did not use. That symbol was probably sufficient to be in itself a trade-mark; and it doubtless created such a difference between the two labels that one could not well be mistaken for the other. LOCHRANE, C. J., said, *inter alia*: “We do not think there was equity in this bill, on the mere question of similarity of trade-marks. But as the demurrer admits that what was done was done intentionally to take advantage of the reputation of the ‘Simmons’ Liver Medicine,’ we cannot hold the judge below erred in retaining the bill for a hearing, to let the whole matter be determined upon the merits.” If, therefore, the words set forth in the bill as a

¹ This passage is worthy of attention and re-perusal, if only as a curiosity of literature and of pleading. Admitting the remote possibility of a mere necessary description of an article being transformed into an arbitrary symbol of trade, by what magical process could packages be put up in, i.e., *wrapped in*, trade-marks? And if that were actually done, by what construction of the Constitution of the United States, or statutes passed by authority thereof, could a label for medicine be deemed the work of an author?

trade-mark were so in reality, the use of some of those words by Ellis, as shown, did not amount to infringement; but as Ellis had admitted his guilt in unlawfully diverting the trade of Zeilin & Co., he was properly held to accountability therefor, although he did not trespass upon trade-mark property.

§ 420. **A Manufacturer has a Right to affix his own Name to an article of his product; and any injury which another manufacturer of the same surname may suffer thereby is *damnum absque injuriâ*. This is a general rule; and yet it has its limits and qualifications. We may truthfully say that a man may enjoy his property in a manner to please himself; and so he may, unless in the enjoyment of his rights he cause a legal injury to another's rights. *Sic utere tuo, ut alienum non ledas*. is the maxim which governs this right to the use of what is one's own. It must be so used as not to injure another, in a legal sense. The rule shall be made clear by the cases which follow.**

§ 421. In *Faber v. Faber*,¹ at a special term of the Supreme Court of New York, in 1867, this question came up on a motion to continue an injunction. The action was brought by John Lothar Faber, the manufacturer of the article known as the "A. W. Faber" lead-pencil, against John H. Faber, and his agent in this country, J. S. Frankenthal, for an injunction, and damages for violation of the trade-mark claimed by the plaintiff. The plaintiff then resided and carried on the manufacture of pencils at Stein, and the defendant, J. H. Faber, at Schweinaw, both of which places are near Nuremberg, Germany. At and near Nuremberg were many other manufacturers of lead-pencils. For the defence, it was contended that the plaintiff had no trade-mark in the name "Faber;" and that the method and style in which the pencils were manufactured and put up, the kind of wrappers, labels, &c., used were not peculiar to the plaintiff, but were such as were generally employed by the manufacturers at Nuremberg.

¹ 49 Barb. 357, and 3 Abb. Pr. R. (n.s.) 115.

Sutherland, J., said that it was unfortunate for the plaintiff that he and the defendant, J. H. Faber, were both manufacturers of lead-pencils at or near the same place in Germany, and that both had the same name, Faber, for it was easy to see that this circumstance may have been an injury to the plaintiff; but the defendant Faber had a right to put or stamp his own name in gold, gilt, or other letters, on his pencils, and on the bands, wrappers, or covers in which they are put up, as described in the complaint; and any injury which the plaintiff had suffered, or might suffer, by such use of the defendant Faber's name merely, must be viewed as an injury without a remedy. That the plaintiff certainly could not claim the exclusive right to manufacture lead-pencils for the American market, or the exclusive right to make them round, or to cover or polish them with black varnish, or to stamp gilt or gold numerals upon them, to designate certain qualities. That it was plain to him that the plaintiff had no right to complain of the form or finish of the defendant J. H. Faber's pencils, or of any mark or stamp upon them, viewed singly, and out of their market-bands or inclosures. There was nothing but the name of the maker stamped upon the pencils, viewed singly, calculated to deceive the purchaser of a single pencil, or of any number less than a dozen. Nor could the plaintiff complain of the manner in which the defendant's pencils were put up for the wholesale market. The plaintiff certainly had no right to the exclusive use of a particular colored paper, or kind of paper, for covering or inclosing his pencils by the gross in a book-form, or any other particular form; and the judge could not see how any wholesale purchaser, knowing that the plaintiff Faber and the defendant Faber both manufactured pencils, would be likely to be deceived by the gross envelopes or wrappers, and purchase the defendant's pencils by the gross for the plaintiff's; especially as it appeared that all the manufacturers of lead-pencils at Nuremberg, to the number of twenty or more, put up their

pencils by the dozen, and by the gross, in substantially the same manner, using substantially the same color and kind of paper for the bands and for the outside gross envelopes or wrappers, with substantially the same devices, numerals, and words, with the exception of the maker's name stamped upon them. As to the bands or wrappers of black glazed paper, in which the dozen and the ten dozen, were inclosed or wrapped before the gross are put up in book-form, considering the explanations of the answer, &c., as to the universal use by pencil manufacturers of the words "Crayons Polygrades" and "Pour Dessiri, Architecture Bureau," &c., no complaint could be made of their use by the defendant Faber. Besides, these words, and the gilt parallelogram and ornamental work, device, or design surrounding them, and the maker's name, could not deceive or mislead any purchaser by the dozen packages or bundles. The motion to continue the injunction was accordingly dismissed.

§ 422. The following case of *Howe v. The Howe Machine Co.*,¹ at a general term of the Supreme Court of New York, in 1867, illustrates the same doctrine. The facts sufficiently appear in the extract from the opinion of Sutherland, J., that Elias Howe, Jr., in 1846, obtained a patent for a certain combination of mechanism called a sewing-machine; that his brother, the plaintiff, commenced manufacturing sewing-machines as early as 1854, and continued to manufacture them at least up to the time of the arrangement between him and Elias Howe, Jr., in 1862; and that the plaintiff in their manufacture used the combination of mechanism patented by Elias Howe, Jr., as his licensee, are undisputed facts. Elias Howe, Jr., did not license the plaintiff to make sewing-machines, but he licensed him to use his patented right or combination in the manufacture of sewing-machines. There is nothing in the case to show that the plaintiff manufactured the machines as agent for Elias Howe, Jr. The fact that he

¹ 50 Barb. 236.

was his licensee, and that he could not have manufactured the machines without his license, does not tend to show the agency. . . . The uncontradicted history of the claimed trade-mark is, that before 1857 the plaintiff placed on the machines letters and word "A. B. Howe;" that in 1857, Taylor, the plaintiff's mechanic, suggested the substitution of "Howe" for "A. B. Howe," which suggestion was adopted by the plaintiff, and subsequently every machine manufactured by the plaintiff had the word "Howe" in a conspicuous place on it. . . . The conclusion from the pleadings and affidavits is irresistible, that the word "Howe" was thus used to denote the plaintiff as the manufacturer, and not to denote Elias Howe, Jr., as the inventor. It is obvious that the fact that the plaintiff was the licensee of Elias Howe, Jr., and that the plaintiff could not have manufactured his machines without using the patented combination of his brother, and therefore could not have manufactured them without his brother's license, did not, and could not interfere with or impair his right to adopt and appropriate a trade-mark, to mark or distinguish the machines manufactured by him from those manufactured by other licensees of his brother. . . . It is equally clear that the plaintiff could adopt and appropriate the word "Howe" as a trade-mark as against Elias Howe, Jr. . . . The plaintiff had a right to adopt and appropriate his surname as a trade-mark, and it cannot be said that Elias Howe, Jr., though his surname was the same, had a right to use his own surname in such a way as to deceive the public, and deprive the plaintiff of the benefit of the notoriety and market which his machines had gained.—This enunciation of the law the judge based upon the cases of *Sykes v. Sykes*, and *Croft v. Day*, especially the conclusion of the opinion of the Master of the Rolls in the latter case. He further said, that the words, "The Howe Machine," are descriptive of the trade-mark "Howe," or "Howe, N. Y.," used on the plaintiff's machines.

§ 423. *Commentary.* — This case is apt to mislead the superficial observer; and even for a moment staggers the preconceived notions of one used to critical examination. It has been cited more than once in support of this absurd proposition, to wit: When two men in the same trade have the same surname, one may employ that surname as a trade-mark to the exclusion of any such right by the other. That is, when the two brothers Howe made and sold sewing-machines, the one who first stamped his surname upon a machine was the sole possessor of the right to stamp his workmanship with his true name. This conclusion has no warrant from any authoritative source. In fact, when we again scan the opinion of Mr. Justice Sutherland, we doubt his intention to convey any such fallacious idea as his language seems to import. The question before the court did not require any expression of opinion as to the abstract right of the plaintiff to the name, in the absence of fraud on the part of the defendants; and the good faith of the defendants is manifest from the unanimous decision of the court, denying the demand for an injunction. Leonard, P. J., said: "There is no fraud upon the plaintiff in use, by the defendants, of the name of 'Howe,' in designating a machine manufactured by them, which Elias Howe, Jr., had invented, and from whom the defendants derive their right to use the name." We might abandon further investigation into the occult utterance of the judge first quoted, if it were not for the impression made by his citation of the two English cases, in support of his proposition that "the plaintiff had a right to adopt and appropriate his surname as a trade-mark," &c. Let us turn to *Sykes v. Sykes*. What were the circumstances of that case? Two men of the same name and trade, one, the plaintiff, with an established business reputation and a patent; the other, the defendant, stamping his shot-belts and powder-flasks with the words "Sykes' Patent," and so falsely representing his goods as manufactured by the plaintiff. We see that there is no analogy between the Sykes case and that of

Howe. Now read *Croft v. Day*. A blacking manufactory had long been carried on under the firm of Day & Martin, at No. 97 High Holborn, London. The executors of the survivor continued the business under the same name. A person of the name of Day, having obtained the authority of one Martin to use his name, set up the same trade at No. 90½ Holborn Hill, and sold their blacking as of the manufacture of Day & Martin, 90½ Holborn Hill, in bottles and with labels having a general resemblance to those of the original firm. An injunction was granted to restrain the continuance of so palpable a fraud. The Master of the Rolls, an able judge (Lord Langdale), said that “in such cases there must be a great variety of circumstances; and the court must deal with each case according to the nature of its peculiar circumstances. The accusation which is made against this defendant is this: that he is selling goods, under forms and symbols of such a nature and character as will induce the public to believe that he is selling the goods which are manufactured at the manufactory which belonged to the testator in this case. . . . My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the name of Day & Martin, but upon the fact of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day’s estate, a benefit for himself, to which he is not, in fair and honest dealing, entitled. Such being my opinion, I must grant the injunction restraining the defendant from carrying on that deception. He has a right to carry on the business of a blacking manufacturer honestly and fairly; he has a right to the use of his own name: I will not do any thing to debar him from the use of that, or any other name calculated to benefit himself in an honest way; but I must prevent him from using it in such a way as to deceive and defraud the public, and obtain for himself, at the expense of the plaintiffs, an undue and improper advantage.” The Howe case lacked

the ingredient of fraud, or false suggestion. Howe, the inventor of the mechanical combination, had given it a name: it was "The Howe Sewing Machine;" and no other designation would have been so appropriate. Whoever had a right to make and vend the article had an equal right to call it by its proper appellation. That being conceded, it necessarily follows that that portion of the syllabus of the case which reads thus: "That the plaintiff had a right to adopt and appropriate the word 'Howe,' as a trade-mark, as against Elias Howe, Jr.," is erroneous in the superlative degree. The *mere* name of the manufacturer cannot in any case become a technical trade-mark, notwithstanding numerous *dicta* to the contrary. The error on the part of the judge was to use the term "trade-mark" in a vague, indefinite sense. We set out with the idea of demonstrating that *Howe v. The Howe Machine Co.* is not a trade-mark case, and at its worst phase nothing more than a possible case of unfair competition. This has been done.

§ 424. The case of *Derringer v. Plate*,¹ in the Supreme Court of California, in 1865, seems at the first glance to hold that a man's name may at common law be used by him as a trade-mark. Let us see if the court did so decide. This was an appeal from a District Court. The plaintiff averred that he was a resident of Philadelphia, and upwards of thirty years ago invented a pistol, known as "Derringer's pistol," and adopted as a trade-mark for the same the words "DERRINGER, PHILADEL.," which was and ever since had been his trade-mark, and which he had caused to be stamped on the breech of all pistols manufactured and sold by him, and that the defendant, since 1858, had been engaged in the manufacture of pistols, at San Francisco, similar to the plaintiff's, on the breech of which he had stamped plaintiff's trade-mark, &c. Defendant had judgment on demurrer, and plaintiff appealed. The question raised by the respondent in support of the demurrer to the complaint was: That the statute of California in relation to trade-marks

¹ 29 Cal. 292.

had, in effect, repealed the common law; and that the appellant, in order to maintain his action, must show affirmatively that he had complied with the requirements of the act passed April 3, 1853. The answer was, That the statute does not take away the remedy at common law; that it is an affirmative statute, and that an action might be maintained both at common law and under the statute. The substance of the rule as laid down in the cases is, that where a party has a remedy at common law for a wrong, and a statute shall have been passed giving a further remedy without a negative of the common-law remedy, expressed or implied, he may, notwithstanding the statute, have his remedy at common law.¹ The Supreme Court, by Rhodes, J., said, *inter alia*: The only question presented on the appeal is, whether the statute of 1863, concerning trade-marks, repealed or abrogated the remedies afforded by the common law in trade-mark cases. The plaintiff does not allege a compliance with the provisions of the statute. He contends that the remedies given by the statute are cumulative to those which a party was entitled to at common law; and the defendant insists that the statute forms a "complete scheme" in respect to trade-marks, and thereby repeals the common-law rules relating to the same subject-matter. — When we read the case for ourselves, we indeed find that the judge was strictly correct in stating that question to be the only one on appeal. The court was not called upon to pass upon the validity of a name of a manufacturer as a common-law trade-mark; nor indeed was the mere name presented, for it was coupled with the word "PHILADEL.;" and even if nothing more than the name of Derringer had been relied on as a mark or emblem, that name may possibly have been stamped on in peculiar characters, as a copy of his autograph, which would have given it a distinctive individuality, and have imparted to it the

¹ *Wheaton v. Hubbard*, 20 Johns. 192; 13 id. 322; *Almy v. Harris*, 5 id. 175; *Clark v. Brown*, 18 Wend.

essential characteristics of the symbol of commerce. We here have the words of the court in awarding judgment: "We do not fully agree with counsel for either party in his construction of the Act, in respect to its relation to and effect upon the common-law remedies. The remedies provided by the Act (at least those applicable to registered trade-marks) are not cumulative to those possessed at common law, but in that respect provision is made by the Act for a new case: nor do we think the Act forms a 'complete scheme' of itself, in the sense that counsel regards it, as requiring all trade-marks to be registered under the Act to entitle them to protection; though it may be regarded as a 'complete scheme' in the respect that it grants certain remedies in cases of registered trade-marks, and expressly reserves to the owners in other cases the usual remedies enjoyed at common law. Judgment reversed, and the cause remanded, with directions to the court below to overrule the demurrer." We must look further, if we think it possible that any court has solemnly decided otherwise. We rest, therefore, on the proposition that one cannot use his *mere* name as a trade-mark.

§ 425. The remarks of Paxson, J., in the case of *Gillis v. Hall*,¹ seem to countenance the notion that a man may turn his surname into a trade-mark; but if we scrutinize the whole record we will come to an opposite conclusion. It was there alleged, and not denied, that the defendant Hall had commenced the manufacture and sale of an article which he designated as "R. P. Hall's Improved Preparation for the Hair," and that upon the wrapper of his bottles were printed these words: "R. P. Hall's Improved Preparation for Restoring the Hair. This preparation is entirely different from Hall's Vegetable Sicilian Hair Renewer, but is compounded by the same inventor, R. P. Hall." If we refer to another case by the same title,² we find that the plaintiff and the defendant had been

¹ Believed not to be reported except in Cox's American Trade-mark Cases, p. 596.

² 2 Brewster, 342.

partners in business, in making and selling a certain preparation called "Hall's Vegetable Sicilian Hair Renewer." On the 15th of June, 1865, in consideration of the sum of \$30,000, the defendant Hall sold to the plaintiff all his, said Hall's, interest in the firm, in the secret of said preparation, the right to make and vend the same, and the exclusive right to use his name therefor in the future sales thereof. This agreement contained covenants as follows: 1. That he will not use, or allow his name to be used, in the preparation of any similar articles; 2. That he will not engage in the manufacture thereof; 3. That he will not impart to any one the secret or recipe for the manufacture thereof; 4. That he will not engage in the manufacture of any article similar to this; 5. That he will allow the plaintiff the free, uninterrupted, and exclusive use of his name in the manufacture and sale of said preparation, — and a stipulation to forfeit the said sum of \$30,000, if he violated any of said covenants. Upon a violation of the said covenants, Gillis applied for an injunction. Hall denied the right of the plaintiff to equitable relief, for the reasons that those covenants were in restraint of trade, and therefore void. The objection, so far as it applied to a general restraint of trade, was held to be well-taken, as against the policy of the law. Said Paxson, J.: "He may manufacture and sell as many articles as he may desire for the preservation of the hair; but he may not manufacture, or sell, any of such articles as and for "Hall's Vegetable Sicilian Hair Renewer." The right to make and vend an article with that particular name and trade-mark he has parted with. He has bartered away his name, so far as the right to apply it to this preparation is concerned." Thus we observe what question was before the court. The defendant had broken his agreement, and had gone into unlawful competition with his former partner. Now, upon a rule to show cause why he should not be punished for contempt, in disregarding the order and decree of the court in the above-mentioned case of injunction, the judge said: "The said defendant has certainly mis-

apprehended the scope of that decree, as well as the meaning of the term 'trade-mark.' He may lawfully make any article known to commerce, which is unpatented, but he may not apply the trade-mark of the plaintiff to any such article. It is also to be observed that there is a wide distinction between covenants not to engage in trade and covenants to restrain the use of a trade-mark. The former may be void as being against the policy of the law, while the latter, not being obnoxious to any such objection, will be enforced. In this case, the defendant Hall has taken from the plaintiff's trade-mark that which gives it its chief value, viz., the name of 'Hall,' and placed it upon his own. The plaintiff's article is known as 'Hall's Vegetable Sicilian Hair Renewer.' Strike the name of 'Hall' therefrom, and its distinctive characteristic as a trade-mark is gone." The general conclusions of the judge are indisputably correct; and the only error therein consisted in the improper use of the term "trade-mark." In the definition of the term, we find that the manufacturer's own name is not an essential part of the mark, although frequently combined with the symbol that constitutes its essence. What was the real trade-mark? Certainly not the words in common use to designate the name of the article, the words "vegetable hair renewer." The word "Sicilian" is the only word that can stand the test as a fancy appellation, an arbitrary symbol; and it would be worthless for the purpose of the law if it were called into requisition to imply that the article of hair-preparation was really Sicilian, *i.e.*, made in Sicily. The case is simply thus: The defendant indirectly violated the plaintiff's trade-mark by using the symbol "Sicilian" in a covert manner, calculated to deceive the public and divert custom from his rival in trade; and all the language of his advertisement upon the bottles was calculated to create the impression that he sold the well-known article, or one superior to it. Doubtless substantial justice was done in every respect, except the incautious use of technical phrasology.

§ 426. *Curtis v. Bryan*¹ is a case where the defendant simulated the label of the plaintiffs, adopted a stamp similar to the plaintiffs', and fraudulently sold the article under the name of the original inventor, as Mrs. Winslow's Soothing Syrup. The plaintiffs' preparation had been in public use for nearly twenty-five years, and had an established and very valuable reputation. The name of Mrs. Winslow may be said to have lost its primary signification, and to have become a mere emblem, as in the case of the use of the historic name of "Roger Williams."² The equity was clearly with the plaintiffs, and the defendant had, by unfair and dishonorable practices, sought to avail himself of, and turn to his own account, the labor and the expense which the plaintiffs had borne for years to bring their article into favorable notice and general use. He would have the public believe that the article he was selling was the plaintiffs'. It mattered not, so far as the principles of justice were concerned, whether the name did constitute a fancy denomination or not; for the general statute of the State embraced all cases of the kind, — the imitation of labels, stamps, &c., — and the controversy before the court did not need any nice distinction in terms. We will continue the search.

§ 427. In *Jurgensen v. Alexander*³ it appeared that for twenty years previously to the suit the plaintiff was a manufacturer and vendor of watches in Switzerland and Copenhagen. It was found by the courts that the trade-mark used by the plaintiff for the purpose of distinguishing and designating the watches manufactured by him was "JULES JURGENSEN, COPENHAGEN," and that said trade-mark was so used and employed by him on all such watches so manufactured, or sold, by him, being inscribed on the cap or inside back of each watch; and that in the faith and credit of the said mark, the watches were bought, sold, and dealt in, and had acquired a wide-spread reputation and extensive sale. It was also found that the defendant, a dealer

¹ 2 Daly, 212, and 36 How. Pr. R. 33.

² *Barrows v. Knight*, 6 R. I. 434.

³ 24 How. Pr. R. 269.

in watches and other merchandise, had exposed for sale four watches purporting to be manufactured by the plaintiff, and bearing the mark "Jules Jurgensen, Copenhagen," which mark thereon was false, simulated, and spurious. We are not told whether the said words were inscribed in any peculiar manner, or in any uncommon characters. It was a clear case of fraud, whether those words constituted a common-law trade-mark or not. That case therefore does not assist in the elucidation of the point under consideration. Nor does that of *Byass v. Sullivan*,¹ where the plaintiff averred that the defendants unlawfully copied and used his trade-mark or label on bottled porter, viz.: "Best Stout Porter, from R. B. Byass, London," with a *fac-simile* of his signature underwritten; for that copy of a signature itself was a good trade-mark. In *Clark v. Clark*,² it was held that a party will not be restrained by injunction from using his own name, unless the use by him be accompanied by circumstances indicating an intention to mislead the public. In *Ames v. King*,³ the answer denied that the plaintiffs had the sole right to use the word "Ames" upon shovels, and denied that the defendants ever stamped or marked any shovels with the name "Ames" with intent to imitate the plaintiffs' shovels or their mark, or to represent the same to be the manufacture of the plaintiffs, or to injure, defraud, or deceive the public or the plaintiffs; but admitted that he had stamped two hundred dozen shovels for a dealer whose name was Edward B. Ames, and at his request had stamped the same "Ames," but not "O. Ames," and solely to denote that they were sold, or kept for sale, by Edward B. Ames. This alleged infringement was brought before the court under the Massachusetts statute of 1852, entitled "An Act further to protect trade-marks." That statute conferred upon the court the power to restrain by injunction the fraudulent use of trade-marks, and *other similar devices*, employed

¹ 21 How. Pr. R. 50.

² 25 Barb. 76.

³ 2 Gray, 379.

“for the purpose of falsely representing any article to be manufactured by” a person or firm who did not in fact make it. In the case at bar, the bill stated a case clearly within the statute above cited. But the essential averments in the bill, of a fraudulent use of the plaintiffs’ name by the defendant, for the purpose of falsely representing articles to have been made by them which were in fact manufactured by the defendant, are particularly and fully traversed by the answer. Bill dismissed. This not being a case falling within the principles of the common law, but resting upon a local statute, cannot avail us in our present investigation.

§ 428. *Rodgers v. Nowill*¹ is frequently misquoted. The facts of that case are short and simple. The defendants, manufacturers of cutlery at Sheffield, received an order from the Messrs. Lord & Son for a quantity of pen-knives and pocket-knives, to be stamped or marked with the letters V. R., with a crown between them, and the words “J. Rodgers & Sons, Sheffield,” underneath. They accordingly made and marked the knives as ordered. The knives, when made, were, it is said, received by the defendants, accompanied by a bill of parcels describing them as purchased from John Rodgers & Sons. The plaintiffs brought their action; and, having proved the order for knives so marked as to resemble and pass for their manufacture, and its execution by the defendants in the manner stated, the case went to the jury. It was found that the defendants had adopted the plaintiffs’ mark. We perceive that the infringement covered the whole of the mark, and not alone the names of the plaintiffs.

§ 429. The case of *Morison v. Salmon*,² in the Court of Common Pleas, in England, in 1841, appears at the first glance to throw light upon this question, but, in reality, it does not. The declaration, after stating that the plaintiffs prepared, and sold, for profit, a certain medicine called “*Morison’s Universal Medi-*

¹ 5 Man., Gr. & Sc. 109; 11 Jur. 1039; 17 L. J., C. P. 52.

² 2 Scott, N. R. 449; 2 Man. & G. 385.

cine," which they were accustomed to sell in boxes wrapped up in paper, which had those words printed thereon, alleged that the defendant, intending to injure the plaintiffs in the sale of their said medicines, deceitfully and fraudulently prepared medicines in imitation of the medicines so prepared by the plaintiffs, and wrapped up the same in paper, with the words "*Morison's Universal Medicine*" printed thereon, in order to denote that such medicine was the genuine medicine prepared and sold by the plaintiffs, &c. *Held*, on a motion to arrest the judgment, that the declaration disclosed a sufficient cause of action. Looking at this as a trade-mark case, where do we locate the essence of the commercial symbol? It does not reside in the generic term "medicine," for that is common property, free to all who use the language; nor is it in the name of the plaintiffs, for any one else bearing the same surname had the same right to stamp it upon the same unpatented articles of merchandise. How could we hesitate to fix upon the word "universal" as the talisman! That word is used here as an arbitrary symbol, or fancy denomination. It does not pretend to intimate that the medicine to which it is affixed is *universal*; for then it would be obnoxious to the charge of quackery, and even though it might not deceive the most credulous, it would meet the fate of the marks in *Heath v. Wright*¹ and *Fowle v. Spear*.²

§ 430. In *Holloway v. Holloway*,³ in the Rolls Court in England, in 1850, the plaintiff, Thomas Holloway, complained that his brother, the defendant, Henry Holloway, had commenced selling pills and ointment at 210 Strand, under the description of "H. Holloway's Pills and Ointment." The pill-boxes and pots were similar in form to, and the labels and wrappers were copied from those used by the plaintiff, whose place of business was at 244 Strand. The plaintiff prayed an injunction to restrain the defendant from selling any pills or ointment

¹ 3 Wall. Jr. 141.

² 7 Penn. L. J. 176.

³ 13 Beav. 209.

described as, or purporting to be, "Holloway's Ointment," or "H. Holloway's Pills," or "H. Holloway's Ointment," in boxes or pots having labels so contrived or expressed, as by colorable imitation or otherwise to represent the pills or ointment sold by the defendant to be the same pills or ointment as were sold by the plaintiff.

§ 431. THE MASTER OF THE ROLLS (without hearing a reply). "This case, upon the evidence before me, is perfectly clear. The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment; and I do not intend to say any thing tending to abridge any such right. But he has no right to do so with such additions to his own name as to deceive the public, and make them believe that he is selling the plaintiff's pills and ointment."

§ 432. In *Burgess v. Burgess*,¹ in the English High Court of Chancery, in 1853, it appeared that, for upward of forty years prior to 1800, John Burgess, the father of William R. Burgess, the plaintiff, carried on business on his own account as an Italian warehouseman at No. 107 Strand, London. In 1800, the plaintiff was taken into partnership by his father, and from that time until 1820, when the father died, they continued the partnership business under the style or firm of "*John Burgess & Son*." The son, as sole executor and residuary-legatee, succeeded to the business, and continued it on his own account, but under the same style of "*John Burgess & Son*," and on the same premises at No. 107 Strand. Amongst the articles in which the firm originally, and afterward the plaintiff, had been in the habit of dealing, was a fish-sauce called "Essence of Anchovies," which had been originally manufactured by John Burgess, the father of the plaintiff, about forty years prior to 1800, and ever since sold by the firm under the name of "*Burgess' Essence of Anchovies*." The defendant, William Harding Burgess, the son of the plaintiff, after being for many years employed, at a salary, by his father

¹ 17 Jur. 292; 22 L. J. Chanc. 675.

in his business at the said place, upon the occasion of a disagreement left his father's service, and commenced trading on his own account, at No. 36 King William Street, same city. He caused to be placed over his shop-front the words, "W. H. BURGESS, *late of 107 Strand*," and on each side of the door of his shop fixed a metal-plate, with the words, "*Burgess' Fish-Sauce Warehouse, late of 107 Strand*." The bill complained also that the defendant was selling a fish-sauce purporting to be "*Burgess' Essence of Anchovies*," but at a lower price than that of the article sold by the plaintiff under the same description or title, and that such sauce was offered for sale by the defendant in bottles similar in size and shape to the bottles used by the plaintiff, accompanied with labels, wrappers, and catalogues bearing a general resemblance to those used by the plaintiff in the sale of his essence of anchovies; and in particular, that upon such labels, wrappers, and catalogues he used the title "*Burgess' Essence of Anchovies*," under which the article sold by the plaintiff was well known, and had long enjoyed a great celebrity in the market. It was alleged also that the said words had been used by the defendant with the fraudulent object of deceiving the public, and leading purchasers to believe that they were purchasing the plaintiff's article. Vice-Chancellor Kindersley ordered an injunction restraining the defendant from using the words "late of 107 Strand," and "Burgess' Fish-Sauce Warehouse, late of 107 Strand," but refused to restrain him from using the words "Burgess' Essence of Anchovies." The decision of the Vice-Chancellor was affirmed on appeal.

§ 433. This is so manifestly an instance of unfair competition in trade, and not a trade-mark case, that remark were supererogatory, unless to cite it as an additional illustration of the doctrine that a man's name cannot be transmuted into a technical trade-mark.

§ 434. In the Court of Paris, in 1863 (*Massez v. Joly*¹),

¹ *Annales de la Prop.*, tome x. p. 318; 11 *Beav.* 112; 11 *Jur. (n.s.)* 513.

the plaintiff, a shoemaker, had for a mark the name of "JOLY," surrounded by an oval. The defendant, Joly, used his own name in the same manner and with the same object. The court ordered that the defendant should modify his mark, either by joining his Christian name, or by omitting the oval form, so as to prevent a confusion in the mind of the public. The oval constituted the essence of the symbol. In the *Leather Co.* case, in the House of Lords, in 1865, both parties made conspicuous use of the surname "Crockett," being that of the inventors of a certain process, and yet the court did not entertain the notion that that name could be an essential part of a trade-mark. Nor does the following case sustain any such idea, although sometimes cited in support thereof.

§ 435. The complainant, Samuel Stonebraker,¹ being engaged in the manufacture of certain medicines and other preparations, adopted and used certain labels to distinguish his preparations from all others. These labels became generally known to the trade and consumers, so that by them the preparations were recognized, distinguished, and bought. The manufacture and sale became a source of profit and emolument to the complainant. Certain persons thereupon fraudulently engaged in the manufacture and sale of medicine and preparations, which they sold, bearing a similar label with only a colorable difference. Two of the defendants had employed in business another, a brother of the complainant, for no other reason than that his name was Stonebraker, and because they believed that by employing a person of that name they could with impunity consummate their intended frauds against the complainant and the public. Pinkney, J., who heard the case, said, that the evidence showed beyond all doubt that the agreement between the parties was but a combination to deceive the public, and to enable the parties to it to obtain for their medicines the benefit of the celebrity which those of the complainant had in the market, at the expense of the com-

¹ *Stonebraker v. Stonebraker*, 33 Maryland, 252.

plainant, and in fraud of his rights. The defendant who had thus loaned his name was himself a medical man, and had a right to compound and vend medicines. His offence was in selling his medicines as those of his brother. The defendants copied the names given by the complainant to his medicines; and on their wrappers and labels the language that he had on his; and, as if to leave no doubt of their fraudulent intent, printed on the wrappers of some of their medicines and preparations the certificates given to the complainant, in recommendation of his medicines, &c., &c. This design became a perfect success, so that experienced druggists were deceived.

§ 436. The Circuit Court passed a decree perpetually enjoining and restraining defendant Stonebraker and his partners, their agents, and all persons claiming under them, from manufacturing or imitating any of the medicines, &c., which had been known as "Stonebraker's Medicines or Preparations," and from counterfeiting the labels, marks, &c. The Court of Appeals of Maryland affirmed the decree.

§ 437. A trader is sometimes debarred from using a trade-mark originated by himself; for by his own direct act, or by operation of law, the title to its use may have been alienated from him. In substance, there is no distinction between the sale of a business and good-will by a trader himself, and a sale by his assignees in bankruptcy. Therefore, on a sale by such assignees, the trader has no right, upon setting up a fresh business, after his discharge, to use the trade-mark of his old business, or in any other way to represent himself as carrying on the identical business which was sold; although he has a right to set up again in business of the same kind next door to his old place of business.¹ The principle of this ruling of Vice-Chancellor James is plain. A trade-mark is frequently an indication of place, and purchasers look rather to the locality than the person. If certain goods are associated with the shop bearing the sign of the Crescent, or the Elephant, or any other

¹ *Hudson v. Osborne*, 39 L. J., Chanc. 79.