

fanciful emblem, and go forth to the public bearing the stamp of the Crescent, &c., then it is clearly an infringement for any one else in the same line to use the mark. But if the mark be so personal in its character that it is identified with the person, and import that the goods bearing it are manufactured by him, then the rule would be different; for the law will not lend itself to the perpetration of a fraud.¹

§ 438. The employment by a firm of a name identical with that of an old commercial house is not illicit in itself, and the suppression of the name will not be decreed. But when to the use of this name are added abusive manœuvres, having for an object to deceive consumers, then it becomes necessary to order that modifications be made in marks and tickets, with the first name of the junior party, and sometimes the date of the formation of the new house. In the case of *Louis Rœderer & Co. v. Théophile Rœderer*,² in the Court of Paris, in 1865, the plaintiffs, the well-known vintners of Rheims, complained of the defendant's use of the surname of the head of their house to their prejudice. The plaintiffs had adopted a mark called *Carte Blanche* for their finest champagne-wines. The Tribunal of Commerce of Rheims found for the plaintiffs, and directed that on the labels, corks, brands, tickets, &c., to be used by the defendant's firm, the word *Théophile* should be placed in letters of the same size, shape, &c., as the name *Rœderer*. The plaintiffs, thinking the remedy insufficient, appealed, and produced before the appellate court prospectuses which, both before and after the judgment of the court of first instance, had been circulated not only in France, but also in Belgium and in England. The following shows the contents of said prospectuses: "*Grand vin de Champagne mousseux. T. RŒDERER & CO., OF RHEIMS, CARTE BLANCHE, qualité unique, francs: 5.* Merchants and consumers are requested not to confound this wine with that of a similar house at Rheims, and to sus-

¹ See *Bury v. Bedford*, 10 Jur. (n.s.) 503.

² *Annales de la Prop.*, tome xi. p. 58.

pect fraudulent imitations. Corresponding depository in Belgium: A. Vernaelde, wine merchant, 29 Ommeganech Street, Antwerp.”

“LONDON, October 13, 1861.

“GENTLEMEN, — *In remitting herein enclosed the circular of the Messrs. TH. RŒDERER & COMPANY, of Rheims, who give us the title of sole agents for the sale of their CELEBRATED CHAMPAGNE-WINE, we request you to forward to us your orders.*

“The mark ‘Carte Blanche’ of Th. R. & Co. is so well known that there is no need for us to recommend it to you,” &c.

PER CUR.: As to the principal demand tending to the prohibition of the use by the defendants in their firm name, their marks and labels, of the name of *Rœderer*: — Considering that Théophile Rœderer, having formed with the brothers Bousigue (called Bley) an association under a collective name for the sale of sparkling champagne-wines, had a right to dispose of his name for the profit of the partnership, they consequently had a right to use it, as well in the firm title as in their marks, labels, and advertisements, beyond the reach of power to suppress the same, especially as against Rœderer himself, if he has created the house on his own account. As touching the subsidiary conclusions, directing that the name of Théophile Rœderer take precedence in the firm or title, marks, and labels: — Considering that an association under a collective title may borrow from among themselves that name of any one most suitable for their title, marks, and labels, they are not, however, at liberty to take a sign tending to divert to their own profit the good-will of an old house bearing the same name, one already made popular in the same trade; that this good-will should be the result of a free and legitimate competition and not of illicit actions, and that it is an illicit action to cause a coincidence of mercantile names to deceive the consumer: — Considering that the judges of the first instance have found as a fact that Théophile Rœderer’s firm has established and organized for the purpose of appropriating, by means of the

name it bears, the favor enjoyed by the house of Louis Rœderer: that, in fact, the antecedents of Théophile Rœderer — a stranger in the city of Rheims, and to the commerce of champagne-wines — justify the conclusion that the part he plays in the partnership is solely to lend his name to imitate the labels and vignettes of Louis Rœderer, the borrowing of the special designation of “Carte Blanche,” the resemblance of the sealing-wax for the bottles, the similarity of marks upon the corks, and the announcements, scattered even through Belgium and England, in which the agents of the new concern felicitate themselves upon having received the agency for the celebrated champagne-wine, recommending not to confound it with another house of the same name, and retaining but the initial of the name Théophile to make more conspicuous the name of Rœderer: all reveal and characterize an unlawful competition: — Considering that to remedy this abuse the judges below should not have limited themselves simply to direct that the marks, labels, and announcements of this new house should for the future bear the prenomen of Théophile written in full, and in characters of the same dimension as those of the surname Rœderer; that that would be an incomplete and inefficacious remedy against confounding in commerce the name of the new house with that of the old, but that the same can be accomplished by diversifying them by exterior signs, without the necessity of modifying the firm title, — Théophile Rœderer & Co.; that it will suffice for the future to direct that the defendants shall be bound to insert in their marks, labels, announcements, circulars, and bills, the mention following: “House founded in 1864,” and to inscribe it thereon in characters of the same size, and of the same form as those of the name and prenomen of Théophile Rœderer: For these reasons, the judgment appealed from is modified, in that it orders only that the marks, labels, announcements, and bills of the house of Théophile Rœderer & Company shall bear for the future the prenomen Théophile in form and dimension the same as

those of the surname. . . . Ordered, that the defendants shall in future insert in their advertisements, bills, and prospectuses, as well as on their marks, labels, and corks, 1st, the prenomens of Théophile; 2d, the mention following: "House founded in 1864;" — Ordered, that said mention shall appear in characters of the same dimension and form as those of the surname Rœderer; — Ordered, that the present judgment shall be inserted by extract containing the names and qualities of the parties, the reasons and disposition made, in the newspapers of the department of the Marne, in three newspapers of Paris, and in four foreign newspapers selected by the plaintiffs and at the expense of the defendants, &c.

§ 439. An Englishman established in Paris the sale of a certain manufacture from farina for food, to which he gave the name "ERVALENTA-WARTON," compounded from a word of fancy and his surname. Whatever may have been the intrinsic merit of this farina, through dint of advertising it had obtained in France as well as in England a grand success. Influenced by the renown gained by Warton for his product, another Englishman, named Klug, commenced the sale of a somewhat similar article of food, which he decorated with the name of "REVALENTA ARABICA." For a long time the competitors in business carried on business side-by-side without a legal contest; but eventually Warton died, and his widow succeeding to his affairs brought an action against Klug for usurpation of the denomination which had been adopted by her husband as a trade-mark. The Court of Paris affirmed the judgment of the court below, which had found the defendant guilty of infringement, in using the thinly-veiled expedient of slightly modifying the name of the thing.¹

§ 440. It is a counterfeiting of a trade-mark to affix the symbol to a box or envelope, although the goods themselves, enclosed therein, do not bear the same mark as the genuine. Thus, where a manufacturer of gilt-headed nails had a star for his

¹ Warton v. Klug, *Annales de la Prop.*, tome i. p. 40.

mark, which mark he impressed upon the boxes containing his products and his invoices, as well as on the goods; and another person placed the same mark on the outside of his boxes, but not upon the goods, it was held to be infringement. Such was the decision of the Court of Paris in 1872, in *Carmoy v. Samson*,¹ on appeal from a judgment of the Tribunal Civil of the Seine. The lower court had held that a five-pointed star, such as the plaintiff had adopted and the defendant had imitated, is a sign commonly employed in other branches of industry, and when isolated from all other distinctive characters is not susceptible of private appropriation. The defendant, therefore, had not encroached upon an exclusive right, especially as he had not actually stamped the merchandise itself. Judgment was rendered for the defendant, with costs. The appellate court not only regarded the star sufficient as a trade-mark, but found the defendant guilty of counterfeiting, by the external use thereof. His object was to deceive the purchaser, and he did it as effectually as if the star had been impressed upon each nail.

§ 441. As to who is the actual counterfeiter of a trade-mark, the Court of Cassation of Belgium, in 1865 (*Gilbert & Co. v. Benedictus*²), said: Inasmuch as the prohibition to counterfeit trade-marks has for its object the preservation from outrage of industrial property, it follows therefrom, 1. That the counterfeiter is not the agent who materially executes the simulated work, but he who causes it to be done with an intent to fraudulently traffic in counterfeited objects; 2. That the wrong is consummated at the place where the counterfeiter carries on the illicit traffic, although the act may have had its inception in a foreign country.

§ 442. As to the question of infringement by the use of numerals, we have a decision made at a general term of the Supreme Court of New York, in 1872.³ It was there *held*:

¹ *Annales de la Prop.*, tome xvii. p. 231.

² *Ibid.*, tome xii. p. 427.

³ *Glen and Hall Manuf. Co. v. Hall*, *Albany Law Jour.*, vol. v. p. 109.

That the use of a street number, or of a building in a street, for part of a person's trade-mark, where other persons have the same right to manufacture the same article in the same street, or at the same number or building, cannot be made exclusive, or the use by another be restrained by injunction. But where a person has the exclusive use of a street number or building, he may very properly use it as a part of his trade-mark.

§ 443. *Perversion of Mark.* — A genuine mark may virtually become a counterfeit by misapplication or transfer. Thus if a trader sell goods with his mark thereto attached as an evidence of genuineness, and the purchaser adulterate the goods, or use the same envelope for the purpose of selling a false article, he is a counterfeiter. So when one having a right to use a genuine mark upon paper bags for seeds, placed therein seeds of an inferior quality, he was guilty in the eye of the law of fraud, just as much as if he transferred a genuine signature from one paper to another.¹ This point may be considered as settled.

§ 444. This question was discussed in the *Corps Législatif* of France, when the bill that crystallized into the trade-mark law of 1857 was under consideration. One honorable member (M. Legrand) said that certain products exist on which by reason of their nature the trade-mark could not be immediately applied. These products are placed in an envelope on which is put the mark of the manufacturer; and the products find a sale more or less easy, according to the degree of credit that particular mark has in the market. He mentioned frauds of frequent occurrence, where certain vendors had made themselves the intermediaries between the manufacturer and the consumer. They address their attentions to the manufacturers the most renowned. In the beginning, to establish confidence, they render to their principals such as they have received; but soon afterwards, when the valuable products have become associated with certain marks, they open the packets and substitute an inferior kind of goods.²

¹ *Bloss v. Bloomer*, 23 Barb. 604.

² *Moniteur*, May 14, 1857.

§ 445. M. Levavasseur, in the same debate, said that in nearly all the cities where textile fabrics are made, and notably so in Rouen, there exist commission-merchants who buy to sell, generally under a form different from that the manufacturer has given; thus, they divide the stuffs in pieces, to make them assume new guises suited to the convenience of those to whom the merchandise is sent. These textile fabrics receive at the dressers an entirely new form, and the commission-merchant, to assure the sale thereon, places his mark, known only to his principals. It is in this manner that are dressed, exported, and sold the greater part of the stuffs of Rouen sold in America.

§ 446. In *Gillott v. Kettle*,¹ at a general term of the Superior Court of the city of New York, the fraud complained of consisted in selling an inferior article of the plaintiff's manufacture as being one of a superior quality. The case came up on appeal from an order enjoining the defendant, as hereinafter stated. The papers on which the injunction was granted showed that the plaintiff had for a long time been extensively engaged in the manufacture of steel-pens, at Birmingham, in England; that the pens made by him were well-known as such in the market, and were extensively sold, as well in the United States as in England; that large quantities of them were sold in boxes containing one gross each; that each box was labelled in a manner and with a label having devices upon it, which indicated that the plaintiff was the manufacturer of the pens, and in consequence of which they were bought and sold in the market, as pens made by him; and that the labels had numbers or marks² impressed on them which indicated, and which were recognized by dealers as indicating, an actual difference in the quality of the pens. The pens in boxes numbered 303 were bought and sold as being extra fine-pointed, and were in fact so. The pens in

¹ 3 Duer, 624.

² As to the numbers being trade-marks, see *Gillott v. Esterbrook*, 47 Barb. 455.

boxes numbered 753 were of an inferior quality, and were bought and sold as such, the number being understood by dealers to denote their inferior quality. The former were sold by the plaintiff at about seventy-five cents, and the latter at about eighteen cents a gross. From the boxes containing the plaintiff's label or trade-marks, and bearing the number 753, the defendant was in the habit of removing the plaintiff's label, and putting on in place thereof labels which he made or caused to be made closely imitating the genuine labels of the plaintiff, which bear the number 303. This act was productive of great injury to the plaintiff, by destroying public confidence in his honesty, and bringing the pens made by him into discredit, by reason of his inferior pens being disposed of as being his best pens.

§ 447. This case differs from those in which a manufacturer seeks to restrain others from placing upon articles made by themselves his trade-mark, by which goods of his own manufacture are known to be his, and are recognized as such in the market. Here the defendant has not attempted to sell an article made by himself, by fraudulently creating the impression that it was made by the plaintiff; but he has attempted to sell an inferior article — made by the plaintiff to be sold as an inferior one of his own manufacture — by using a label indicating a superior article. The fraud, so far as successful, is twofold. The public is defrauded, by being induced to buy the inferior for the superior article. The plaintiff is defrauded, by an unjust destruction of confidence that his pens are put up for sale and assorted with reference to the quality, indicated by the labels. Unless the fraud were checked by the intervention of a court of equity, the damage to the owner of the mark might be irreparable. The remedy by injunction is invariably granted when the nature of the injury is such that a preventive remedy is indispensable and should be permanent. Order affirmed, with costs.

§ 448. The following curious case was submitted to the

writer, for his opinion as counsel. C. J. M., a wine and liquor merchant in the city of New York, was threatened with a prosecution for imitating the trade-mark of Bass & Co., of England, upon ale and porter. "Then you do not sell a genuine article?" "Oh yes, we sell the very ale and porter that we purchased from the manufacturers themselves." "Then the labels are imitated by you; that is, false labels are used upon genuine goods?" "Not at all, for the labels also are genuine. The whole story is this: we bought the ales and porter at wholesale for the understood purpose of retailing in England; and also obtained from the agent of the firm of Bass & Co. a supply of their labels containing their trade-marks. Instead of selling in England, we chose to bring the ale and porter to this country, and by retailing here we reap the profits that the manufacturers expected to enure to themselves. *Query*: Have we made ourselves liable in an action for damages, or can we be enjoined?" The reply was that in the absence of any agreement, it could not be perceived how either an action at law or suit in equity could be maintained. It seemed like a naked question of morality and mercantile faith. It was nothing but a trick in trade. A bill in equity could not well be sustained under such a state of facts. The foreign firm may protect itself in the future by selling only to known confidential retailers. Legal remedy there is none.

§ 449. From an examination of the foregoing illustrations, we cannot have failed to gain a general idea of the correct theory of infringements. We observe that encroachments upon trade-mark rights have usually less of the characteristics of downright robbery than of mean, dissembling knavery. The craft of the fox is evinced more frequently than the boldness of the lion. The highwayman becomes respectable and dignified, in comparison with the trader who, by evasion or circumvention, would despoil a competitor of his just reputation. The colorable infringer is more apt to be visited with rigorous justice than is the trespasser who shows himself in the light of

day. The attempt to cover and conceal his tracks is evidence of intentional wrong. Two traders may take the same symbol, each in ignorance that the other uses it, or with an honest doubt as to which has the legal right therein. The conflict of claims may be the result of a difference of opinion as to the alleged imitation. At the first glance, it is not always easy to say what amounts to imitation. In the chapter on Interferences, hereafter, may be seen a remarkable instance of two things entirely unlike in appearance being adjudged to be alike in effect.¹ In that case, it was conceded by the able counsel on both sides, and found by the Patent Office, that the picture of a bouquet with elaborate ornamentation, and the simple word "Bouquet," interfered with each other, when used upon the same class of goods. If vision were the sole guide, the lack of physical resemblance would have decided that no interference existed. One delineation could not possibly be mistaken for the other. Here is the test: Would the use by different houses of the two things cause confusion? The ear is the medium to mislead a purchaser. He might ask this question, — "Have you the Bouquet ham?" and either of the traders could truthfully reply in the affirmative. The picture and the word could not lawfully coëxist as marks for rivals dealing in the same class of merchandise. The matter then resolves itself into a question of priority of adoption. We see how one may press closely upon the rights of another without the least thought of fraud; and yet be adjudged to be a wrongdoer.

§ 450. Again, the same symbol may be used by two persons having no interests in common, and still furnish no ground for legal conflict. We have heretofore seen that there is no property in an abstract symbol. It must be a mark upon a vendible commodity to entitle it to judicial attention. It does not signify if the emblem used by the different parties be exactly alike, — in fact, be printed from the same plate or impressed by

¹ *Schrauder v. Beresford & Co.*

the same brand, — unless it also be affixed to similar goods. Now arises a point of considerable difficulty. How shall we define the term *class*? A class is an order or division of objects, grouped together on account of their common characteristics. We must narrow the limitation, when applying the word to our present purpose. This point has already been discussed in this treatise, and some examples given of the construction of the word *class*. Cutting instruments may be classified generally as cutlery; and yet a chopping-axe, a pocket-knife, and a scythe be said to belong to three distinct classes. Wine, brandy, whiskey, gin, are all alcoholic liquors; but we see that the Patent Office has held that they do not come in the same class.¹ We read the decision in the case of the *Amoskeag Manufacturing Co. v. Garner*,² and learn, if we did not know it before, that *plain* cotton cloths and *printed* cotton cloths belong to different classes. Some latitude must be allowed in determining to what class an article should be assigned. If a manufacturer adopt a mark for a razor, and use it upon nothing else, can he subsequently claim that he had obtained the exclusive right to its use upon all sharp instruments of steel? Or if he adopt a mark for alcohol, does he thereby exclude every other manufacturer or trader from the use of the same symbol for whiskey or gin? Certainly not. The classification of commerce must be consulted. The *experimentum crucis* is this: What does a buyer ask for? An experienced tippler may say that he is at times unable to distinguish old whiskey from brandy, so much are they alike in taste, and that that circumstance is a good reason why the halo of a trade-mark for one article should be considered broad enough to embrace the other. That is a question of evidence rather than one of classifying. If the purchaser asks for brandy, he does not wish for whiskey. What does he believe he is getting? If he is misdirected by a symbol, the proprietor whose mark has been pirated loses a customer; and for the

¹ §§ 66-76, *ante*.

² 59 Barb. 151.

wrong so done him is entitled to legal satisfaction. The class of merchandise of the defendant may not be exactly that of the plaintiff, and yet the deceit be complete. We must apply the doctrine of analogous use. If a defendant show that the class of goods to which he has affixed the mark of the plaintiff, is not in all particulars the same as his, shall he thereby be screened from punishment? If there be two distinct classes of goods bearing the same emblem, are they so nearly alike that the public may naturally be misled? If one apply a symbol to corn-starch, can another evade it by applying it to a somewhat similar article of farinaceous food? In *Burnett v. Phalon*,¹ the essential element of each party's product was cocoa-nut oil, although in certain particulars the articles were not alike; but when a buyer saw the word "Cocoïne" he thought that he was obtaining the genuine "Cocoaine." So, also, when one asked for the plaintiff's "Eau de la Floride," represented to be a natural water from Florida, he thought his wish was gratified when the defendant delivered a chemical compound marked "Eau de la Fluoride."² The object in each case was to deceive the public by the usurpation of the reputation of another person. It is eminently a question of fact for the practical experience of a jury, whether, in a particular case, a resemblance is likely to deceive the community.³ In the "I X L" matter,⁴ Wostenholm & Son had no right to complain of the application by others of the composition of letters first used by their house; for as those others did not manufacture the same kind of cutting instruments that they, the originators, did, no competition arose, and no custom was lost. The goods are of different classes.

¹ 9 Bos. 192; 5 Abb. Pr. R. (n.s.) 212, and 3 Keyes, 594.

² *Guislain & Co. v. Labrugnière*, *ante*.

³ Per Robertson, C. J., in *Swift v. Dey*, 4 Robertson, 611.

⁴ §§ 68-70, *ante*.

CHAPTER IX.

REMEDIES — LAW AND EQUITY.

Usually by Action on the Case, or Injunction. — State Legislation. — Indictment, when. — Court of Equity will not interfere unless Legal Title Clear. — Defendant Liable, although acting without Guilty Knowledge. — Discovery. — Costs.

§ 451. The Remedies against Piracy are usually by an action on the case for an injury done to a trader in respect to his trade-mark, being a personal injury to be compensated by damages; or else by injunction. The law remedy is sometimes sought under the common law, and sometimes under statutes. Many of the States of the Union have legislated more or less upon the subject, and some of them have passed stringent penal laws in regard thereto. The first Federal legislation in the matter is to be found in the trade-mark sections of the patent and copyright enactment of July 8, 1870; and the remedies therein prescribed are purely of a civil nature, being, indeed, a reaffirmance of the provisions of the pre-existing rules of common law and equity, and novel only in allowing an action for injuries resulting from false or fraudulent representations in the registry of a trade-mark.

§ 452. Sometimes a remedy may be found by criminal indictment, either at common law or by the statutes of States. There are two heads of crime under which it might be expected that the fraudulent imitation of a trade-mark would be indictable, — as a forgery, or as the obtaining of money under false pretences. The former of these methods was adopted in the

case of *Reg. v. J. Smith*, in England.¹ The imitation in this case consisted of a printed label, which was an exact imitation of the labels attached by the prosecutor, George Borwick, to packets of his powder, called "Borwick's Baking Powder," with this exception, that the signature, "George Borwick," was omitted in the counterfeit. It was contended, on the part of the prosecution, that the term *forgery* might be defined as the alteration or making of a false document with intent to defraud; and cases were cited in which the fraudulent imitation of a printed document, such as a diploma of the College of Surgeons, the good-conduct certificate of the master of a ship, and of a clergyman, as to the character of a schoolmaster, had been held to be forgeries. It was, however, unanimously held by the bench that the conviction was not sustainable; that the issuing of the wrapper or label, without the powder which it enclosed, would be no offence; and that, in the printing of the wrappers, there was no forgery committed by the printer. Bramwell, B., there said: "Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so efficacious for all purposes as the other," that, in the case before him, "one of the documents is as good as the other, — the one asserts what the other does, — the one is as true as the other; but one gets improperly used." Mr. Lloyd, in his work on trade-marks, says that he has not been able to find any case in the Reports, in which an indictment for obtaining money under false pretences has been sustained in the case of a fraudulent use of a trade-mark, although he had been referred to the cases of *Reg. v. Gray & Gosling*, in which the prisoners were sentenced to twelve months' hard labor for the fraudulent use of the Messrs. Allsop's labels; and to another case of *Reg. v. S. Jones*, where a sentence of three years' penal servitude was inflicted. He says that it is clear, however, that the principle is applicable; and, in the

¹ Dearsley & Bell, 566; 8 Cox, Crim. Cases, 32.

case first cited, Willes, J., says: "In cases like the present the remedy is well known: the prosecutor may, if he pleases, file a bill in equity to restrain the defendant from using the wrapper; or he may bring an action at law for damages: or he may indict him for obtaining money for false pretences." This opinion of Mr. Justice Willes was assented to, with more or less positiveness, by the other judges; and it seems strange, says Mr. Lloyd, that this form of indictment should not have come into use by manufacturers for the purpose of protecting their trade-marks. It may, however, be accounted for on the ground that an action at law for damages, if successful, gives a more ample compensation for the violation of their rights.

§ 453. Forgery at common law is defined to be "the fraudulent making or alteration of a writing to the prejudice of another man's right," or as a false making, a making *malo animo*, of any written instrument for the purpose of fraud or deceit. In the case of *Reg. v. J. Smith*, above cited, Pollock, C. B., in giving judgment, said, speaking of the labels: "They are merely wrappers, and, in their present shape, I doubt whether they are any thing like a document or instrument which is the subject of forgery at common law. To say that they belong to that class of instruments, seems to me to be confounding things together as alike which are essentially different. It might as well be said, that if one tradesman used brown paper for his wrappers, and another tradesman had his brown paper wrappers made in the same way, he could be accused of forging the brown paper." So in *Reg. v. Closs*,¹ it was decided that the painting an artist's name in the corner of a picture, in order to pass it off as an original picture by that artist, is not a forgery. Cockburn, C. J., in giving judgment, said: "We are all of opinion that there was no forgery. A forgery must be of some document or writing; and this was merely in the nature of a mark put upon the painting with a view of identifying it, and was no more than if the painter put any

¹ 7 Cox, Crim. Cases, 494.

other arbitrary mark as a recognition of the picture being his." In the course of the argument of this case it was stated by the counsel that "no case had gone the length of holding that to stamp the name of *Manton* on a gun would be forgery;" upon which Crompton, J., said: "That would be forgery of a trade-mark, and not of a name;" and Cockburn, C. J., said: "Stamping a name on a gun would not be a writing; it would be the imitation of a mark, not of a signature." Whether the common law embraced such cases or not, the subject, in England, is made clear; and the following offences are made misdemeanors by section 2 of the Merchandise Marks Act of 1862: 1. The forging or counterfeiting any trade-mark with intent to defraud. 2. The applying a *genuine*, or a forged trade-mark, with intent to defraud, to any thing not being the manufacture, &c., of any person denoted or intended to be denoted by such trade-mark, or not being the manufacture, &c., of the person whose trade-mark shall be forged. 3. The applying any *genuine* or forged trade-mark, with intent to defraud, to any thing not being the particular or peculiar description of manufacture, &c., denoted or intended to be denoted by such trade-mark; for instance, if a man has two trade-marks, one for a particular description of goods of a superior quality, and another for a different description of goods of an inferior quality, the applying the trade-mark for the goods of superior quality to the goods of inferior quality, will be a misdemeanor, if done "with intent to defraud," such intent being an essential ingredient in all such offences.

§ 454. Some of the States of this Union have passed statutes, declaring it to be a misdemeanor punishable by fine and imprisonment to forge or counterfeit, or cause to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label affixed by any mechanic or manufacturer to his goods, wares, or merchandise, or in the sale thereof, with intent to deceive or

defraud the purchaser or manufacturer of any goods, wares, or merchandise whatever. For our present purpose, it is hardly worth while to discuss these comprehensive enactments, which are not confined to technical trade-marks, but embrace wrappers, stamps, and labels. It may, however, be well worth while to have recourse to local statutes when other means are inapplicable, as when, although the technical symbol is not imitated, mischief is done by the ingenious simulation of a label or a wrapper, in color, size, shape, &c. In such cases, of course, a Federal court is not the proper forum; for such court possesses no power except such as both the Constitution and the Acts of Congress *concur* in conferring upon them.¹

§ 455. The criminal law of some of the countries of Europe, especially France, is severe upon fraudulent imitators of trade-marks. In the Tribunal Corr. of Rheims, in 1863 (*Clicquot v. Roudeau et als.*²), these facts appeared: In 1863, the London journals contained an advertisement of wines of the house of *la veuve Clicquot*, of Rheims, at advantageous prices, at the Victoria Dock. Suspicions were aroused. The boxes and the casks were found to bear counterfeit marks. The Court of Queen's Bench ordered the seizure of the wines. It transpired that an association, composed of Cazin, a wine merchant, of Roudeau, his principal agent, and three Englishmen, were operating together, and selling wines under the counterfeited marks of Moët, d'Epernay, and Veuve Clicquot. All were deemed guilty in France (although the acts were consummated in England), and severely punished. So, also, in the Court of Paris, in 1867 (*Heidsieck v. Souris, Dresel, et als.*³), Souris, a commission-merchant, and Dresel, of Rheims, in September, 1866, formed a conspiracy with Theodore and George Bayaud, merchants at New York, to imitate and usurp the trade-mark of Charles Heidsieck, manu-

¹ U. S. v. Hudson & Goodwin, 7 Cranch, 32.

² Annales de la Prop., tome x. p. 101.

³ Ibid., tome xiv. p. 95.

facturer of champagne-wine at Rheims, and to export the wine in large quantities to America. In pursuance of their plan, Souris caused to be engraved a mark like that of Charles Heidsieck, and to be reproduced on the cork of each bottle, with the sole substitution of the name of Herman for that of Charles, in the same characters, and the accessory ornament representing a comet. Souris then proposed to export wine in baskets, whose covers bore the four red bars, and all the external appearances of those of the house of Charles Heidsieck. Upon their arrival in America, labels were to be affixed, to complete the deception. It was shown that one Herman Heidsieck, residing at St. Louis, Mo., and not in the champagne-wine business, had loaned his name to guaranty success. The court said that the nefarious conspiracy had been organized on a vast scale. 10,000 francs damages, costs, &c., were allowed.

§ 456. In the Court of Paris, 1868 (*Martell & Co. v. Badoureau & Patte*¹). The plaintiffs in this case were of Cognac, the products of which place are known in all the markets of Europe and America, and having been victims of numerous counterfeits, had seized in Badoureau's lithographic establishment in Paris 12,000 labels bearing their name, and entirely similar to those employed by them in their trade. Badoureau set up that he had made the false labels at the order of Patte. *Held*, that the counterfeiting was complete by making, it not being necessary that use should be shown. The lithographer who reproduces the mark or label by order of a third person, without assurance that he is either the proprietor, or the agent of the proprietor of the mark, cannot set up his good faith. Damages against both. The court further ordered that the labels and stone from which they were printed should be destroyed; and that the judgment should be published in public journals to be selected by the plaintiffs.

§ 457. It has been seen, that the form of action adopted in

¹ *Annales de la Prop.*, tome xiv. p. 126.

vindication of the right to use a trade-mark, is that of an action on the case for deceit; that is, so far as the common-law forms have escaped the renovating inroads of the new school of pleaders; and that action still survives under some other name, or no name, under the simplified forms of pleadings of the codes of procedure. Under the United States statutes, the action remains purely the old action on the case.¹

§ 458. In this action, fraud is of the essence of the injury. There are, therefore, two main points to be proved, — the fraudulent nature of the wrong committed by the defendant, and the nature of the injury suffered by the plaintiff. The nature of the wrong to be proved is well-defined by Wilde, C. J., in *Rodgers v. Nowill*,² where he says: “Has more ever been held necessary to be proved, in actions of this description, than that the plaintiff, being a manufacturer, has been accustomed to use a certain mark to denote that the goods so marked were of his manufacture; that such mark was well-known and understood in the particular trade; and that the defendants had adopted the mark, and sold goods bearing it, as and for the plaintiff’s goods, with intent to deceive?” On these grounds, the action was held not to be maintainable in *Singleton v. Bolton*;³ for there no sale was proved to have been made by the defendant of a medicament of his own under the mark of the plaintiff, but both the plaintiff and the defendant used the name of the original inventor (Dr. Johnson), and no evidence was given of the defendant having sold his ointment as if it had been prepared by the plaintiff. So, also, in *Crawshay v. Thompson*,⁴ it was held that the mark used by the defendants was not used with the intention of supplanting

¹ The Commissioners appointed by virtue of the Act of Congress (14 Stat. at L. 74) to revise, simplify, arrange, and consolidate all statutes of the United States, have printed their report, to be presented at the coming session of Congress; and in that report they amend the language of the law by making an infringer of a trade-mark “liable to an action in the nature of an action of trespass on the case.”

² 5 Com. B. 109.

³ 3 Dougl. 298.

⁴ 4 Man. & Gr. 357.

the plaintiffs, but that it was applied to certain goods in the ordinary course of business, and in execution of orders. This decision is grounded on the evidence in the case, and turns on the question of what constituted such a fraudulent use. There was no proof of an intention on the part of the defendants to sell their manufacture as and for that of the plaintiffs; but it was contended that their motive in using the mark was immaterial, if the resemblance in fact existed, and they were aware of it. In *Blanchard v. Hill*,¹ Lord Hardwicke said: "It is not the single act of making use of the mark that was sufficient to maintain the action, but the doing it with a fraudulent design to put off bad cloths by this means, and to draw away customers from the other clothier." McLean, J., said, in *Coffeen v. Brunton*,² that from the cases theretofore decided it would seem that an intentional fraud is not necessary to entitle the plaintiff to protection, for the injury will be neither greater nor less by the knowledge of the party. "If he has adopted the same mark which will cause his article to be taken for another in the market, which is known and approved of, it is an injury which the law will redress. In commercial dealings, the utmost good faith should be observed, and no one is permitted to go into the market with a deception of this character, so as to profit by the good faith or established reputation of another." In *Dale v. Smithson*,³ Hilton, J., held that the right of the plaintiffs to maintain the action did not in any degree depend upon the inquiry as to whether the defendants intended to appropriate to their use a trade-mark or label, known by them to have been devised and employed by the plaintiffs in their business; but that it was enough if it was made to appear that the defendants did the act complained of; and so, although they may have used the mark in ignorance of its being the exclusive property of any one. It must be observed that this case, although nominally an *action* under the code of procedure of the State of New York,

¹ 2 Atk. 484.

² 4 McLean, 516.

³ 12 Abb. Pr. R. 237.

is not the technical *action on the case*, but was really a suit in equity to restrain an infringement; and equity will restrain independent of motive. This principle has been so uniformly maintained by the courts, that it is almost supererogatory to cite further illustrations; but, to place the question still more clearly before the reader, we will look at other cases. In *Blofield v. Payne*,¹ the declaration stated that the plaintiff, being the inventor and manufacturer of metallic hones, used certain envelopes for the same, denoting them to be his, and that the defendant wrongfully made other hones, wrapped them in envelopes resembling the plaintiff's, and sold them as his own, whereby the plaintiff was prevented from selling many of his hones, and they were depreciated in value and reputation, those of the defendant being inferior. The court held that the plaintiff was entitled to some damages for the invasion of his right by the fraud of the defendant, though he did not prove that the defendant's hones were inferior, or that he had sustained any specific damage. Where a right is invaded by a fraudulent act, though no specific injury be proved, some damages, at law, must be given; as when a publisher of a magazine or newspaper assumes the name of one previously published, or represents the new publication as a continuation of the former, when it is not so.² In *Marsh v. Billings*,³ which was an action on the case, sounding in tort, and governed by the same principle which has been repeatedly recognized and acted on by courts, in reference to the fraudulent use of trade-marks, it was held that the use of the words "Revere House" on coaches was a fraud on the plaintiffs, and a violation of their rights, for which an action would lie, without proof of actual or specific damages. The same rule was observed in *Blofield v. Payne*,⁴ where it was held that by the defendant's act the plaintiff was entitled to some damages, inasmuch as his right had been fraudulently invaded. So, also, in *Rodgers v. Nowill*.⁵

¹ 4 Barn. & Ad. 410.

² *Hogg v. Kirby*, 8 Ves. 213.

³ 7 Cush. 322.

⁴ 4 Barn. & Adol. 410.

⁵ 5 Com. B. 109.

§ 459. *To entitle him to recover*, it is necessary for the plaintiff to show that an actual damage has been suffered. But sometimes the law will presume damages, as where the defendant made and sold medicines, calling them "Thomsonian Medicines," as and for the medicines made and prepared by the plaintiff, so that persons purchasing the same supposed and believed that they were purchasing the medicines made and prepared by the plaintiff; for that was a fraud upon the plaintiff for which the law will presume some damage. Such a case, therefore, being proved, the plaintiff will be entitled to recover nominal damages, at least, and something more, if he can make it appear to the satisfaction of a jury that he has sustained more than nominal damage.¹

§ 460. The nature of the wrong suffered by the trader whose mark is fraudulently used is twofold. It consists in the injury to his reputation where an article of inferior value is palmed off upon the purchaser; or else in the injury done to his trade by general diversion of custom. In *Coffeen v. Brunton*,² the court said, that if the defendant made representations that his liniment contained the same ingredients as that of the complainant, while in fact it was not only different from the "Chinese Liniment," but greatly inferior to it, the effect must be to destroy in the market the value of the complainant's liniment; and that would be ground for the equitable interposition of a court of equity. That is an injury for which a court of law cannot give adequate compensation. However valuable the complainant's invention may be, yet if it be discredited by a worthless article, it would be impossible, in any reasonable time, to restore the public confidence in the genuine article. In this consists the injury; and the fraud arises from the false representations that the composition is the same.

§ 461. Nor need the representations be *immediate* in order to give a ground of action, as is shown by the case of *Sykes v.*

¹ *Thomson v. Winchester*, 19 Pick. 214.

² 4 McLean, 516; and same case in 5 McLean, 156.

Sylkes.¹ The defence there proved that the sale of the spurious article was made to retail dealers, who were aware of the fraud; but nevertheless it was held that the sale to them for the purpose of a resale to the public, who would be deceived by the printed stamp, was substantially the same thing as a direct fraud by the original vendor.

§ 462. **Remedy in Equity.** — As a general proposition, it is only when the legal title is clear that a court of equity will interfere by injunction to restrain the use, or the colorable infringement of a trade-mark. In cases of doubt the court should not grant or retain an injunction until the cause shall have been heard upon the pleadings and proofs, or until the complainant shall have established his right by an action at law. Such was the decision of the New York Court of Appeals, in 1848.² So the Lord Chancellor, in *Spottiswoode v. Clark*,³ who said that, unless the case be very clear, it is the duty of the court to see that the legal right is ascertained before it exercises its equitable jurisdiction. And he said that for this there are good reasons: the title to relief depends on a legal right, and the court only exercises its jurisdiction on the ground that that legal right is established. The objection to granting an injunction in the first instance is, that it promotes after-litigation. The order either grants an injunction and compels the complainant to bring his action, or suspends the injunction, with liberty to the complainant to bring an action. If you compel him to go to a court of law, you promote litigation, and this course is forced upon parties at a time when their feelings are deeply engaged in prosecuting their imaginary rights. There is also, said he, another objection, which is, that the court expresses a strong opinion, and it ought to be a strong opinion, and then sends the right to be tried. It is better that the court should abstain from express-

¹ 3 Barn. & Cr. 541.

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

³ 10 Jur. 1043.

ing such an opinion. But, after all, the chief objection is, that the court runs the risk of doing the greatest possible injustice, in case its opinion upon the legal right should turn out to be erroneous. If the plaintiff prove his title by a successful action at law, he is indemnified by the defendant in the account which the court has directed the latter to keep. On the other hand, if the plaintiff fail in his proof at law, there are no means in his power for compensating the defendant for the loss he will have sustained by the suspension of his trade during the operation of the injunction. This is a sufficient reason for withholding that remedy, unless there be a very clear preponderance of proof in favor of the complainant in the first instance, or some conduct be shown on the part of the defendant which renders it unadvisable to permit him to continue his trade upon the footing of an account to be taken.¹ Mr. Justice McLean, in *Coffeen v. Brunton*,² said that the right of the party who claims protection must be clear; for, if it be controverted, chancery will leave the party to his remedy at law; or, at least, to such a proceeding as shall present the whole merits of the controversy, and enable the court to decide it. Mr. Justice Duer, in the case of the *Amoskeag Manufacturing Company v. Spear*,³ said that the rule is fully settled, and is recognized in nearly all the cases, that, in suits for infringements of trade-marks, an injunction is never to be granted in the first instance, if the exclusive title of the plaintiff is denied, unless the grounds upon which it is denied are mainly frivolous. When the title is disputed, the course is to let the motion for an injunction stand over until the plaintiff has established his legal right in an action at law; and Mr. Justice Duer cited with approval the ruling of Lord Cottenham, in *Motley v. Downman*,⁴ who used the strong expression that "he cannot conceive a case in which the court will interfere at once by an injunction so as to prevent the defendant from disputing the plaintiff's legal title."

¹ Lloyd on Trade-marks, p. 17.

³ 2 Sand. S. C. 599.

² 5 McLean, 256.

⁴ 3 Mylne & C. 14.

Daly, J., in *The Merrimack Manufacturing Company v. Garner*,¹ said that courts of equity have not interfered in cases of this kind, except in aid of a legal right; and if the fact of the plaintiff's property in the trade-mark, or if the defendant's interference with it has appeared at all doubtful, the plaintiff has been left to establish his case first by an action at law. Where the title of the plaintiff to appropriate a certain mark or name to himself was not made out, or considerable doubt existed respecting it, the court discharged an injunction order, upon the defendant's entering into an undertaking in a penalty to keep an account of their sales, and render the same when required by a competent court.²

§ 463. The same principle has been applied by courts in the exercise of their jurisdiction in patent and copyright cases, and on the same grounds. In *Stevens v. Keating*,³ the learned judge said that "if the injunction, having been once granted, turns out to be unfounded, you are doing an irreparable injury to the parties restrained, whereas, by withholding it, you may be permitting some injustice, but certainly not an injustice at all equal to that which you are doing by improperly granting it." In this case, the court went so far as to fix the time within which the plaintiff was to bring his action; and on his failing to proceed to the trial of that action, upon grounds which by the court were considered to be insufficient to justify his delay, and upon a subsequent motion on the part of the defendant, the injunction which had been granted on the merits of the case was dissolved, and the defendant was directed to keep an account of his profits.

§ 464. The rendition of a verdict in a case in favor of plaintiff is *not* conclusive upon the right of such party to an injunction (where it is manifest that error has been done⁴); but the considerations which would justify a judge in renewing the dis-

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

² *Fetridge v. Merchant*, 4 Abb. Pr. R. 156; also *Spottiswoode v. Clark*, *supra*.

³ 2 Ph. 338.

⁴ *Many v. Sizer*, 1 Fish. 31.

cussion of a patentee's title, after solemn hearing and judgment at law, should be such as, if presented to his view after a trial at law, would have induced him to set aside the verdict.¹ No interlocutory injunction should issue unless complainant's title be clear, or admitted, for the court is not bound to decide doubtful and difficult questions of law, or disputed questions of fact, nor to exercise this high and (if exerted rashly) dangerous power before the alleged offender has had an opportunity for a full and fair hearing. The chief object is to prevent irreparable mischief, not to give complainant means of coercing a compromise on his own terms.²

§ 465. If the defendant shows a belief that he has a just defence, and is not a wilful pirate, then the case should be one of evident mistake of law or fact, or both, in the defence which he sets up, which will justify the *festinum remedium*.³

§ 466. The constitutional right of a trial by jury applies only to actions at common law. In suits in equity, an inquiry by the jury depends upon the discretion of the court,⁴ it not being conclusive, but only an aid to the conscience.

§ 467. Upon motions for preliminary injunction, if, after a careful and impartial examination of the case, the court be of opinion that the complainant is entitled by law to the writ, it is their duty to grant it without evasion.⁵

§ 468. In equity, if the defendant, without fraud, use the trade-mark of the complainant, he is still liable. If the right be violated, it matters not whether it be by fraud or by mistake. The whole question in such case is whether the defendant's label or mark is calculated to deceive the public, and to lead them to suppose that they are purchasing an article manufactured by the complainant instead of by the defendant.⁶ To

¹ Parker v. Brant, 1 Fish. 58.

² Parker v. Sears, 1 Fish. 33; Goodyear v. Dunbar, *ibid.* 472.

³ *Ibid.*

⁴ Ely v. Monson, 4 Fish. 64.

⁵ Blanchard v. Reeves, 1 Fish. 103.

⁶ Millington v. Fox, 3 Myl. & C. 339; Davis v. Kendall, 2 R. I. 566.

entitle a complainant to protection against a false representation, it is not essential that the article should be inferior in quality, or that the individual should fraudulently represent it, so as to impose upon the public; but if, by representation, it be so assimilated as to be taken in the market for an established manufacture, or compound of another, the injured person is entitled to an injunction. The injury is not the less, though the false representations be made without a knowledge of such interference.¹

§ 469. **Discovery, Account, Costs.** — Although it is not within the scope of this treatise to discuss matters which can be found more fully and more ably treated in books devoted to equity jurisprudence, and in books of practice, still this subject is worthy of observation, in its relation to trade-marks. In many cases, the aggrieved party might be at a great disadvantage, unless he had some means of access to his opponent's books and papers. To enable him to fix the amount of injury done by the wrongful conduct of the other, he must look to discovery. How shall he, in the majority of cases, ascertain the amount of sales, unless in this mode? But how shall he proceed?

§ 470. We find a statutory provision² by which all courts of the United States have power in the trial of actions at law, on motion and due notice thereof being given, to require the parties to produce books or writings in their possession or power, which contain evidence pertinent to the issue, in cases and under circumstances where they might be compelled to produce the same by the ordinary rules of proceeding in chancery. But this may really afford no remedy. On failure, judgment may be given against the defendant by default, and the plaintiff be left to grope in the dark. He must, then, resort to a court of equity. There the familiar canons of chancery jurisprudence stand in his way, if he seeks discovery

¹ Coffeen v. Brunton, 5 McLean, 256.

² Judiciary Act of Sept. 24, 1789.

to enable him to enforce a forfeiture ; for equity does not favor forfeitures. But if he relinquish all claim to a penalty or forfeiture, he may entitle himself to a discovery in aid of an action at law for the recovery of damages.¹

§ 471. Parties innocently bought and sold as genuine an article which was in fact spurious. They were restrained from selling it with the plaintiff's trade-mark ; but were not ordered to account for profits, nor compelled to pay the plaintiff's costs. The Master of the Rolls said, substantially, that the right to an injunction usually carries with it the right to costs ; but if a plaintiff asks for costs, and for something more than he is entitled to, he will lose the costs he might otherwise have received.²

§ 472. A common carrier, entirely innocent of fraudulent intent, but having certain falsely-marked goods in his possession for the purpose of transportation, may be enjoined ; but the fact of good faith is ground for refusing costs. This was the ruling in *Upmann v. Elkan*,³ in 1871, by Lord Chancellor Hatherly, affirming a decree of the Master of the Rolls. A firm of forwarding agents in London received from correspondents abroad a number of boxes of cigars, being counterfeit brands, to be delivered to several persons in England. On application by the makers whose brand had been imitated, the agents gave information against the consignors, and offered to either send back the cigars, or to remove the brand. The Lord Chancellor said : " It has been urged that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods which, though fraudulently marked, were not for their own use, nor to be sold for them for their own benefit, but were merely received for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine

¹ See authorities cited in 2 Abb. U. S. Cts. Practice, p. 92.

² *Moet v. Couston*, 10 L. T. R. (N.S.) 395.

³ L. R. 7 Chanc. Appeals, 130 ; also, Amer. ed. of Eng. Reports (Moaks), 1872, p. 474.

more dangerous or mischievous, or more fatal to the authority of the court with respect to trade-marks. If that argument prevailed, persons being abroad, as was the case in this instance, and inclined to commit frauds upon an English trade-mark, could easily do so by sending their different consignments together to the possession of the defendants (who appear to be reputable agents and warehousemen), thereby committing an injury in a manner most convenient to themselves, and very mischievous to the person entitled to the benefit of the trade-mark.”

§ 473. In such a case, the agent may be compelled by a court of equity to disclose the names of places to which goods bearing false marks had been transmitted by him, and all other information that is within his knowledge or may be gathered from his books tending to redress the grievance of the plaintiff, *except* the names of customers and the prices of the goods.¹

¹ *Carver v. Pinto Leite*, L. R. 7 Chanc. 90.

CHAPTER X.

DEFENCES.

The Complainant must come with "Clean Hands." — Want of Truth. — Quack Medicines not protected. — What Courts regard as Falsehoods. — Mere Exaggeration in Advertisement does not disentitle to Relief. — Nor Fictitious Name of Manufacturer, in Absence of Fraud. — No Defence that Spurious Article is Equal to Genuine. — Laches of Complainant. — What not deemed Laches.

§ 474. THE most important of the grounds of defence to a bill for infringement is the well-established rule of equity, that the protection of the court will not be extended to a person whose case is not founded in truth. That appears to have been first made use of as a ground of defence to a bill for an injunction to restrain the alleged violation of a right to use a trade-mark in *Hogg v. Kirby*.¹ The objection there taken was that the complainant, claiming the protection of the court for the title-page of his magazine, which professed to be "by William Granger, Esq.," was in fact guilty of an imposition on the public, it being shown that the name of the alleged author was fictitious. The excuse offered was that it was a custom of the trade; but Lord Eldon states in his judgment that he felt considerable difficulty on the question, and that this custom, though it might be very usual, appeared to him very much like a fraud on the public. His lordship, however, deciding the cause upon other grounds, left this question as an ingredient in an action for damages. In *Partridge v. Menck*,² the complainant claimed the exclusive right to impose upon the public

¹ 8 Ves. 215.

² 1 How. App. Cases, 158.

matches made by himself as those manufactured by one Golsh ; and although the court decided the cause upon the ground of dissimilarity of the labels, a strong opinion was expressed against his right to recover, on the ground of his attempted deception. So, also, in *Samuel v. Berger*,¹ where the plaintiffs asked the court to aid them in passing off upon the public watches made by them, as those made by another person, from whom they had purchased authority to use his name.

§ 475. The manufacturer of a quack medicine is not entitled to invoke the intervention of a court of equity ; for it is not the office of chancery to intervene, by its summary process, in controversies connected with the title to such a matter : “ *non nostrum tantus componere ;* ”² and an injunction will be refused against the vendor of a patent medicine at the suit of his brother quack, who complained that his label and envelope of certificates had been imitated, for the special action of chancery cannot be involved in a controversy which has so little merit to commend it on either side.

§ 476. The court said, in *Smith v. Woodruff*,³ that the justice and morality of this defence were not very high in that instance, yet the rule must be followed if the case were brought within its application : that it is a defence that ought to be suggested by the court in some cases, and probably would be in all cases where the imposition is flagrant. For instance, where a quack compounds noxious and dangerous drugs, hurtful to the human constitution, and advertises them as a safe and sure remedy for disease ; or where some charlatan avails himself of the prejudice, superstition, or ignorance of some portion of the public, to palm off a worthless article, even when not injurious, the case falls beneath the dignity of a court of justice to lend its aid for the redress of such a party, who has been interfered with by the imitations of another quack or charlatan.

¹ 13 How. Pr. R. 342, and 4 Abb. Pr. R. 88.

² *Fowle v. Spear*, 7 Penn. L. J. 176 ; *Heath v. Wright*, 3 Wall. Jr. 141.

³ 48 Barb. 438.

§ 477. The case of *The Leather Co. v. The American Leather Co.*,¹ in the House of Lords, in 1865, furnishes instruction upon more than one point, and it is well worthy of the expenditure of time in its perusal in regard to the question of truth in representations.

§ 478. The appellants and the respondents were rival joint-stock companies, engaged in the manufacture of leather cloth. The plaintiffs are an English company, formed in 1857, with limited liability, for the purpose of making and selling an article called leather cloth. They bought the business of an American company, which was formed for the purpose of carrying on this manufacture in New Jersey in the United States, and at West Ham, in the county of Essex, in England. The name of the company was "The Crockett International Leather Cloth Company." The original inventors and manufacturers of this article, called leather cloth, were a firm of "Crockett & Co." in the United States, who, upon the formation of the International Company, ceased to carry on a separate business, and became shareholders in that company, but have resumed business, and are manufacturers of leather cloth in the United States. The International Company by its agents obtained, in the month of January, 1856, an English patent for tanning the leather cloth, and having done so, they devised an elaborate label, to be attached to the goods manufactured by them, which, being in a circular form, had its circumference formed by the words "Crockett International Leather Cloth Company, Newark," with the initials "N. J., U. S. A.," meaning New Jersey, United States of America, and also the words "West Ham, Essex, England." These words and letters formed the periphery or outer rim of the label. Within the circle, at the top, is the word "Excelsior," below which is an eagle with expanded wings, and beneath the eagle are printed these words, — "Crockett & Co.'s Tanned Leather Cloth, Patented Jan. 24, 1856, J. R. & C. P.

¹ 11 Jur. (N.S.) 513.

Crockett, manufacturers." The International Leather Cloth Company carried on business as leather cloth manufacturers, both in the United States and in England, until May, 1857. They used the stamp or label which has been described, as a trade-mark, affixing it to the goods which they manufactured. In May, 1857, the plaintiff's company was incorporated; and the International Company sold and assigned to the plaintiffs the business carried on by them at West Ham, together with the English letters-patent, with full power and authority to use all and singular the trade-marks that had been used by the International Company in their business in England. From the time of this sale, the plaintiffs have carried on, at West Ham, the manufacture of leather cloth, according to the process originally introduced by Crockett & Co.; and they have constantly used the trade-mark which has been described, stamping it on their goods of the first quality. In August, 1861, the defendants were incorporated for the purpose of carrying on the manufacture and sale of leather cloth; and they have used as a trade-mark, on goods made by them of the first quality, a stamp or label which certainly appears to have been formed upon the model of the plaintiffs' trade-mark. They do not, however, make use of the word "patented," nor do they call their leather cloth "tanned." All these facts appear in the opinion of the Lord Chancellor on appeal to him from Vice-Chancellor Sir W. P. Wood. The Lord Chancellor said: "To continue the old style of a firm is a very different thing from making false representations with respect to a vendible commodity, in order to give it greater value, and to create a greater demand for it in the market. The plaintiffs impose upon the public by selling goods which are, in reality, manufactured by themselves at West Ham, as being the goods of the Crockett International Leather Cloth Company, and as having been manufactured by Messrs. Crockett, who were the original inventors and manufacturers; and further, they described their untanned goods as being tanned and protected

by the patent, which was not yet expired. Their request is to be protected, and therefore justified, in continuing to make these untrue statements to the public, in order to secure a monopoly for their commodity. There is a homely phrase, long current in this court, that a plaintiff must come into equity with clean hands: that is not so with the present plaintiffs, whose case is condemned by the principles to which they appeal." He thereupon, without hesitation, reversed the decision of the Vice-Chancellor, and dismissed the bill: but, in disapprobation of the conduct of the defendants, he did so without costs.

§ 479. In *Perry v. Truefitt*,¹ the plaintiff filed his bill, alleging that the name or designation of "*Medicated Mexican Balm*" had become of great value to him as a trade-mark; and prayed an injunction and account. According to his own statement, the plaintiff used a printed show-card, in which he represented the article in question in the following terms: "Medicated Mexican Balm, for restoring, nourishing, strengthening, and beautifying the hair. Perry, 12 and 13 Burlington Arcade, London. It is a highly concentrated extract, from vegetable balsamic productions, of that interesting but little-known country, Mexico, and possesses mild astringent properties, which give tone to weak and impoverished hair, and impart a glossy appearance to the naturally dull and harsh. Where there is a tendency to fall off, the Mexican Balm exerts its astringent qualities, and gradually, but infallibly, braces the pores of the cuticle, and arrests the deterioration of the most beautiful ornament of the human frame, — a fine head of hair. This admirable composition is made from an original recipe of the learned J. F. Von Blumenbach, and recently presented to the proprietor by a very near relation of that illustrious physiologist." The fact appeared that one Leathart had invented the preparation, and sold the recipe for making it to the plaintiff. The Master of the Rolls did not think it a favor-

¹ 6 Beav. 66.

able case for the interposition of the court, there not being the least evidence that the composition was formed of vegetable balsamic productions from Mexico. Yet, as it was a case of some doubt, he let the matter stand over, with liberty to the plaintiff to bring an action.

§ 480. The circumstances in *Pidding v. How*¹ were less dubious. The plaintiff, in his labels and advertisements, intimated that the tea sold by him as "*Howqua's Mixture*," was made by Howqua, in Canton, and was purchased from him and imported into England by the plaintiff, in the packages in which it was sold; that the tea which gave it its peculiar flavor was very rare and high-priced, even in China, and was grown in but one province of that country, viz., Kyang Nan; and that it could not be procured in England at any price. On behalf of the defendants, affidavits were made by persons, some of whom had been acquainted with Howqua. They stated that the mixed tea sold by the plaintiff was neither made nor used by Howqua; that it was composed of scented orange pekoe (which gave it its peculiar flavor), and of other black teas of the ordinary kinds; that orange pekoe was not considered, in China, to be one of the best teas; and that that sort of tea had been imported and sold in England for several years, and was generally imported and sold by persons in the tea-trade; that no black tea was produced in the province aforesaid; and that the plaintiff purchased and mixed his teas in England. The Vice-Chancellor said, that on the part of the plaintiff there had been such a degree of representation which he took to be false, that, in his opinion, a court ought not to interfere to protect him, until he had established his title at law. As between the plaintiff and the defendant, the course pursued by the latter had not been a proper one (he having imitated the plaintiff's marks); but that it is a clear rule, laid down by courts of equity, not to extend protection to persons whose case is not founded on truth. "And,"

¹ 8 Sim. 477.

said the Vice-Chancellor, "as the plaintiff in this case has thought fit to mix up that which may be true with that which is false, in introducing his tea to the public, my opinion is, that unless he establish his title at law, the court cannot interfere on his behalf." He accordingly dissolved the injunction, with liberty to the plaintiff to bring an action, reserving the question of costs. In *Dixon Crucible Co. v. Guggenheim*,¹ the defendant made a point that the wrapper of the plaintiffs averred a falsehood in stating that the article sold by them is prepared from *pure carburet of iron*. The court replied that no intention to mislead appeared: that, at best, it is a question of science; that plumbago is undoubtedly the proper name of the article, though it was long known to science as carburet of iron; and that it was entirely too nice a question to be decided upon a motion for a special injunction. Another point was made, that the label states that the plaintiffs' article is prepared by Joseph Dixon & Co., whereas the bill avers that it is prepared and sold by a corporation, viz., The Joseph Dixon Crucible Co. The court said that that difference is not of such a character as to destroy the plaintiffs' right to equitable relief, there being nothing to indicate any attempt at deception or imposition, the corporation being the successor of the individuals.

§ 481. In *Palmer v. Harris*,² in the Supreme Court of Pennsylvania, in 1869, where an injunction had been refused below by reason of the plaintiff's false representation, the plaintiff claimed immunity from the strictness of the rule, because the falsehoods were in a foreign language, presumed not to be understood. The bill alleged that the plaintiff was a tobacco-merchant in New York, and made superior cigars, known as the "*Golden Crown*," which he sold in large quantities; that in 1858 he devised a trade-mark, to wit, a golden crown, and had labels with that mark lithographed and printed, which, for

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

² 60 l'enn. 156.

his protection, he entered on the 18th of December, 1858, in the office of the District Court of the Southern District of New York, in conformity with the Act of Congress respecting copyrights;¹ and that from that time this trade-mark had been used by him, and became identified with the golden crown cigars. The labels were used by placing a larger one inside of the cover of the cigar-box, and a smaller one over the edge of the box where the cover is opened. The defendant, who is a printer, made a great number of counterfeit labels of the plaintiff's trade-mark for persons unknown to the plaintiff, for the purpose of inducing purchasers to believe that they marked the "golden crown" cigars. Upon being notified, the defendant refused to discontinue the printing and sale of the counterfeit labels. The answer of the defendant admitted most of the allegations of the bill, but averred as follows: "It is true, as matter of fact, and I aver it to be so, that complainant's cigars are manufactured and sold in the city of New York, and not at Havana, and that, therefore, the announcement upon complainant's label, Exhibit A, in the words following: 'Fabrica de Tabacos de las Majores Vegas, de la Vuelta Abajo, Calle del Agua, No. 75, Habana,' is wholly untrue, and both calculated and intended to deceive, and being so calculated and intended, is not entitled to the aid of a court of equity for its protection."

§ 482. The genuine labels in this case were parallelograms, nearly square; on the smaller was inscribed "*Golden Crown*," below which was "*L. P.*," and below that "*Habana*." The larger was enclosed in an ornamental border. On it were "*Golden Crown*," below that the figure of a golden crown; then the Spanish words above quoted; and below all, and outside of the border, in very small letters, "*Ent. according to Act of Congress, A.D. 1858, by Lorin Palmer, in the Clk's Office in D't'c't of the S. D't of N. Y.*" There was also a government revenue stamp on the box. The counterfeit was

¹ This act of entering as a copyright was a nullity in law.

of the larger label, and was very similar to it, but wanting the certificate of the entry of the copyright. The appellant—the plaintiff below—made a point that the taking out of the copyright, and declaring that fact on the label, neutralized the words in Spanish; also, that the internal revenue stamp stated the kind, quantity, and district where manufactured; and that the assertions were innocent in their effect on the public, and that the court should not canvass the motive.

§ 483. The court, by Sharswood, J., said, among other things: “The party who attempts to deceive the public by the use of a trade-mark, which contains on its face a falsehood as to the place where his goods are manufactured, in order to have the benefit of the reputation which such goods have acquired in the market, is guilty of the same fraud of which he complains in the defendant. He certainly can have no claim to the extraordinary interposition of a tribunal constituted to administer equity, for the purpose of securing to him the profits arising from his fraudulent act.” As to the notice of the entry as a copyright, the court said: “Apart from the fact that this is in such very small type, and so abbreviated that it would probably escape the observation of every one whose attention was not specially directed to it, a circumstance which rather strengthens the evidence of an intention to mislead the public, what is there in the fact that the design or engraving had been copyrighted in the United States, inconsistent with the declaration that the cigars contained in the box were manufactured in Havana, of Cuban tobacco? But, again, it is said that the United States internal revenue stamp would at once undeceive the purchaser, there being a difference between the stamp used for articles imported and for those of domestic manufacture. Few persons would stop to notice this difference, and, besides, as it is alleged, the trade-mark is pasted on the inside of the lid, and when the box is open, for the purpose of retailing, the trade-mark is brought directly in the view of persons wishing to purchase, and the revenue-stamp is not seen unless the lid is turned

down, and the box examined on the outside. It is contended further, that the falsehood is in a foreign language, of which it is to be presumed that the plaintiff's customers are ignorant. Yet there is certainly enough to convey to every one who can read that the cigars are from 'Havana.' . . . It is not necessary that any one person has been actually deceived or defrauded: it is enough that it is a misrepresentation calculated to have that effect on the unwary and unsuspecting." The decree refusing an injunction was affirmed, and the appeal dismissed at the costs of the appellant.

§ 484. In *Phalon v. Wright*,¹ the plaintiff claimed to have compounded a new perfume, and to have invented a name for it, to wit, "Extract of Night Blooming Cereus." He did not claim any exclusive right in the perfume itself. He had thus chosen the name of a rare, though well-known flower, and claimed in the name alone an exclusive right, as his trademark. He admitted that name to be a deception, so far as used to indicate the real character of the compound; and that the perfume was not an extract from the flower, the mark being in that respect a pure invention. As an exhibit, the plaintiff produced an advertising card, used to give publicity to his preparation, upon which card he declared that the new perfume is the extract of the "Night Blooming Cereus, distilled from this rare and beautiful flower, from which it takes its name." Thompson, J., said that "this is a deception, intended to impose upon the public by exciting curiosity to learn the nature of the rare and beautiful flower. It may be that the deception is harmless. The manufactured perfume may be better than the genuine extract would be; but still it is a deception, and the plaintiff has no right to expect a court of equity to aid him in carrying it on. . . . Thus the case stands upon the plaintiff's own showing. The defendants, by their affidavits, deny fully that the name upon their labels was used to imitate the plaintiff's labels; and they show, by the affidavit of the lithog-

¹ 5 Philadelphia, 464.

rapher by whom the label was drawn and prepared, that he did not know of the existence of the plaintiff's label when he designed and drew that of the defendants. The labels are so little alike, and the name of the defendants so distinctly printed upon theirs, that, as has already been said, no one purchasing Wright's Night Blooming Cereus could suppose he was buying Phalon's. It is very manifest that the defendants did not sell their preparation as that of Phalon's; and they clearly marked it as their own production." The motion for an injunction was dismissed.

§ 485. In *Hobbs v. Francais*,¹ the plaintiff moved for an injunction to restrain the defendant from violating his trade-mark. It appeared that he and another, under the firm name of Fabian & Co., in 1846, commenced the manufacture and sale in the city of New York of a certain powder "for beautifying the complexion and skin;" that they had adopted as the name of the said article the words "Meen Fun," and devised a label bearing that name, with certain devices upon it, to put upon the boxes and packages containing said article; and that they had sold said article by the name of "Meen Fun," until 1848, when his partner, Fabian, transferred to the plaintiff his interest in business, and the right to use the firm name, label, devices, and marks. Further, that after the said article had acquired a reputation, and the sales had become large and profitable, the defendant had made and sold an article of skin-powder, put up in boxes like those of the plaintiff, and had placed on them labels closely imitating the plaintiff's, with the words "Meen Fun" thereon.

§ 486. The plaintiff's label read as follows: "Patronized by Her Majesty, the Queen. 'MEEN FUN,' the Celebrated Chinese Skin Powder for Restoring, Beautifying, and Preserving the Skin and Complexion, Preventing Cutaneous Eruptions, Chapping, and Obviating too Copious Perspiration. ADAPTED FOR ALL CLIMATES. Fabian & Co., Sole Proprietors, 24 Mark Lane, London," &c.

¹ 19 How. Pr. R. 567.

§ 487. PER CUR., Bosworth, C. J. : “ The plaintiff’s label is calculated to induce the belief, and probably was designed to induce the belief, that the article in the box on which it is pasted is manufactured in London ; that the sole proprietors of it have their place of business at 24 Mark Lane, London ; that it is intrinsically so excellent as to secure the patronage of her majesty, the Queen ; and that the labels have paid the stamp-duty required by some English statute. The truth is, that it is made in New York, and that her majesty, the Queen, is probably ignorant of its virtues, or even of its existence. In this respect, there is a manifest intention to deceive and mislead the public. . . . The plaintiff’s label, instead of indicating that he is the manufacturer of the article covered by it, represents him to be the sole agent in the United States of the proprietors of it, and that their place of business is in London. It appears by the defendant’s affidavit, that it is the prevailing belief in this country that ladies’ toilet articles of English or French manufacture are superior to those made in this country, and that the demand for the former is much better than for the latter. The plaintiff’s labels, therefore, contain representations believed to be useful, and which must be known to be false ; and to secure to the plaintiff by injunction an exclusive use of such a label, and the exclusive privilege of thereby deceiving the public, is an object to which a court of equity will not lend its aid. The court does not refuse its aid in such a case from any regard to the defendant, who is using the same efforts and misrepresentations to deceive the public, but on the principle that it will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and devices which are claimed to constitute wholly, or in part, such trade-marks. On this ground, the motion for injunction must be denied.”

§ 488. Mr. Justice Duer applied this rule in *Petridge v.*

Wells,¹ — the “Balm of Thousand Flowers” case, — that they who come into a court of equity seeking equity, must come with pure hands and a pure conscience. If they claim relief against the fraud of others, they must be free themselves from the imputation. The learned judge said, *inter alia*: “The position so strenuously insisted on, that the plaintiff’s firm have an exclusive property in the words ‘Balm of Thousand Flowers,’ or, which is the same thing, an exclusive right to use those words as a trade-mark, I wholly reject. . . . It may be true that the defendants, if permitted to use in their contemplated sales a trade-mark apparently the same as that of Fetridge & Co., would commit a fraud upon the plaintiff and upon the public; but if the plaintiff and his firm are themselves engaged in the execution of a systematic plan for deceiving the public; if they have been, and are, endeavoring, constantly and daily, to multiply their sales, and swell their profits by false representations of the composition, qualities, and uses of the liquid compound which they invite the public to buy, it is strenuously insisted that a court of equity would violate its principles, and abuse its powers, by consenting to aid them, by an injunction or otherwise, in accomplishing their design; and to this proposition I yield my fullest assent. . . . An exclusive privilege for deceiving the public is assuredly not one that a court of equity can be required to aid or sanction. To do so, would be to forfeit its name and character.” The injunction previously granted was therefore dissolved, but without costs, since, although the plaintiff might justly be required to pay costs, the defendants had certainly no title to receive them, being equally guilty of wrong.

§ 489. In *Partridge v. Menck*,² in the Court of Appeals of New York, in 1848, this question received a full consideration. This case came before the Vice-Chancellor of the first circuit on a motion founded on the bill and answer, to dissolve the preliminary injunction granted by an injunction-master, on

¹ 13 How. Pr. R. 385.

² 1 How. App. Cases, 558.

filing the bill. It appeared by the bill that one Golsh, who formerly resided in the city of New York, commenced the manufacture of a certain kind of friction-matches, usually known as "loco-foco matches," for which he acquired a great patronage. His matches were put up in small paper boxes, usually of brown paper, made with a cap or cover, which, when placed on the box, covered about a third of its length; and his trade-mark was a cut representing a straw bee-hive surrounded by flowers and foliage, with the words "A. GOLSH'S FRICTION MATCHES" above the hive. The cut and the words were printed on a label, which was pasted upon the front of each box. The complainant succeeded Golsh in his business, and continued to manufacture and sell the same kind of matches, using the same mark, the label being sometimes varied. His business had extended so that large quantities of his matches were exported to the West Indies, Mexico, and South America. The bill charged that the defendants, Menck & Backes, had been and were engaged in manufacturing friction-matches, purporting to be the Golsh matches. It set forth two labels as being used by the defendants upon the brown-paper boxes in which they put up their matches. One contained the bee-hive and foliage, over which were printed the words "MENCK & BACKES' FRICTION MATCHES, late chemist to A. GOLSH," the words "late chemist" being in letters smaller than the rest; and under the bee-hive were printed in two panels the number and street in which their manufactory was situated, &c. The other label was pretty-much the same, the words "A. Golsh" being much larger and more prominent than those above them. It was charged that this was a piratical and fraudulent invasion of the complainant's trade-mark. The Vice-Chancellor said that, taking the whole label together as it appeared on a single box of matches when offered for sale, the resemblance of the bee-hive was qualified by the distinct terms, "late chemist for A. Golsh," so that the article did not purport to emanate from either Golsh or from his successor. He

accordingly dissolved the injunction, placing his decision on the ground of dissimilarity in the labels of the respective parties. The complainant appealed to the Chancellor. He affirmed the decision, and upon the same grounds, not questioning the legal right of the complainant to use the mark set forth in his bill. The complainant thereupon appealed to the court of last resort. The Court of Appeals took a different view of the case, although the result was the same.

§ 490. *PER CUR.*, Gardiner, J.: If the statements of the bill are analyzed, it will be found that the complainant claims the exclusive right to impose upon the public matches made by himself as those manufactured by A. Golsh. He alleges that "the label heretofore spoken of, which was used by said Golsh, had an imprint of a bee-hive, and the words 'A. Golsh, Friction Matches, 124 Twelfth Street, between 5th and 6th Avenues, New York,' which label has been and now is used by your orator without variation." In every essential particular, as it respected the complainant, the statement of the label was false. "The matches were not Golsh's matches, in the sense in which it was intended that purchasers should understand those terms. He was in Europe, and had no interest or agency in their manufacture. Verbal declarations to a purchaser of the same kind, with a view to a sale of this article, it was conceded, would have been fraudulent. That they were made to assume a more permanent form, and one better calculated to impose upon those who relied upon the reputation, personal skill, and integrity of Golsh, can make no difference in the character of the transaction. It is no sufficient answer to this view of the subject that the complainant obtained from Golsh the secret of the manner in which his matches were prepared, or that he manufactured an article in all respects equal to that offered by the former proprietor. So, also, did the defendants, if we may trust their answer. Nor does it alter the case that the complainant purchased the right to use the name of A. Golsh. The privilege of deceiving the public, even for their own benefit, is not

a legitimate subject of commerce; and at all events, if the maxim, that he who asks equity must come with pure hands, is not altogether obsolete, the complainant has no right to invoke the extraordinary jurisdiction of a court of chancery in favor of such a monopoly. The bill is therefore defective for want of equity; and for this reason, as well as for those assigned by the Vice-Chancellor and Chancellor, I think the order of the latter should be affirmed." Wright, J., said: "The label of the appellant is calculated to deceive the purchasers of matches, inducing all unacquainted with the agreement between him and Golsh to believe that they are purchasing an article manufactured and sold by Golsh himself, when, in truth, Golsh has no concern in the manufacture, nor interest in the business, and has left the country." The order was affirmed unanimously.

§ 491. A court of equity will not interfere to protect the trade-mark of a quack medicine. In *Fowle v. Spear*,¹ in the United States Circuit Court, E. D. of Pennsylvania, in 1847, the complainant applied for an injunction to restrain the defendant from using wrappers, labels, and bottles resembling those used by the complainant in his business of selling "Wistar's Balsam of Wild Cherry." Kane, J., refused the relief asked for. From his opinion, it appears that on one of the complainant's wrappers, which was made a part of the bill, the balsam was described as "a valuable family medicine for consumption of the lungs, coughs, colds, asthmas, bronchitis, croup, whooping-cough, difficulty of breathing, pains in the side or breast, liver complaints, &c.," to which another paper, also among the exhibits, adds "influenza, hoarseness, pains or soreness of the chest, &c." The judge said that "It is not the office of chancery to intervene, by its summary process, in controversies like this; '*non nostrum tantas componere.*'" Looking at the incongruous group of diseases for which the balsam prescribes itself to public credulity, I must

¹ 7 Penn. L. J. 176.

apply the principle of the Vice-Chancellor's decision in *Pidding v. How*, 8 Sim. 477, that a complainant whose business is imposition cannot invoke the aid of equity against a piracy of his trade-mark. The only remedy in such a case is at law." In 1855, the same judge made a similar ruling in the case of *Heath v. Wright*,¹ where the complainant sought to restrain the defendant from using the word "KATHAIRON," of assumed prodigious efficacy in many diseases.

§ 492. A mere False or Exaggerated Statement in a public advertisement will not deprive the owner of his right to protection. In *Curtis v. Bryan*,² the defendant interposed the objection that the plaintiff's medicine was not what by the advertisement it purported to be; and that it was not perfectly safe or harmless, but that, on the other hand, it contained ingredients which are injurious and baneful to children. The court said that "It is difficult to conceive upon what principle of equity this defendant should be heard to raise this objection. His own conduct in regard to the subject-matter is an unequivocal concession to the goodness and value of the plaintiff's article. He interposes this objection to avoid an injunction which restrains him from imitating the plaintiff's article. After the plaintiff's preparation had been in use for nearly twenty-five years, its sale having steadily increased during all that time, the defendant appears, and places upon the market an article which, by the practices and arts to which he has had recourse, he would have the public purchase as the plaintiff's article. If the article was not a good one, why should the defendant imitate it? If it was injurious to health, it is not reasonable to suppose that a prudent man would venture to introduce a similar article under the same name, and hope to succeed. . . . Experience is an excellent teacher, and the fair trial of an article will furnish unerring evidence of its worthlessness or value. It is obviously true that if a

¹ 3 Wallace, Jr. 141.

² 2 Daly, 212; 36 How. Pr. R. 33.

medicine can stand the test of twenty years of experimental use, and grow steadily and constantly in favor, its properties cannot be injurious. But, as before observed, the good faith of this defendant, in raising the objection, may reasonably be questioned, and I am satisfied that it does not lie in his mouth to make it. If a man's acts are any indication of his belief, on any subject, the conduct and admissions of the defendant constitute a complete refutation to this objection. A man's faith is shown by his works." The defendant was accordingly restrained, with costs.

§ 493. In *Smith v. Woodruff*¹ the doctrine of estoppel was also applied. Admitting, for the sake of argument, that the plaintiffs' preparation was a fraud upon the public, the court said that that suggestion comes with a poor grace from one who has, by the imitation, been guilty of the same fraud upon the public, if such it happens to be. This case was an appeal from an order dissolving an injunction restraining the defendant from manufacturing and selling a perfume called "SWEET OPOPANAX OF MEXICO;" from selling any perfumery with that name; from using the name in connection with any perfumery; from using the plaintiffs' label, or any imitation or counterfeit thereof; and from using the label then employed by the defendant, as set out in the complaint. From the opinion of the court, in reversing the order above-mentioned, we learn that the plaintiffs, in connection with their label, put forth a puff, stating that "the opopanax is a native flower from Mexico, of rare and very rich fragrance, from which this extract is distilled," &c. On the part of the defendant, several perfumers made affidavit that they had examined the perfume of the plaintiffs; that they could tell, approximately, its ingredients; that it was not distilled from the flower of opopanax, but was a compound of several well-known tinctures or essential oils, combined with pure spirits. Others stated that there was a resinous *gum* in the market, of a disagreeable odor, but no

¹ 48 Barb. 438.

flowers of opopanax. The plaintiffs, and their chemists, swore that the said opopanax was used in the preparation, distillation, and manufacture of said perfume, and that the perfume was made from it. Several perfumers also made affidavits that it was not possible for any perfumer to tell the ingredients of the plaintiffs' perfume. Under this contradictory state of evidence, the rule was not available to the defendant. The injunction was restored with costs from defendant.

§ 494. **Fictitious Name of Manufacturer.**—The fact that a trade-mark bears a fictitious name as the name of the manufacturer does not affect the owner's right to protection, where it is shown that it is not used with any fraudulent intent, and does not in fact deceive the public. This point is illustrated by the case of *Dale v. Smithson*,¹ where Thomas Nelson Dale was adjudged to have a lawful right to the exclusive use of the following: "Courtria Flax, Thomas Nelson & Co. Warranted, Fast Colors and 16 oz." The defendants, who had closely imitated the plaintiffs' label (which strictly speaking is not a trade-mark), contended that the plaintiffs could not acquire an exclusive right to the use of said label, because it did not indicate the true origin or ownership of the thread to which it was affixed, — the name of Thomas Nelson & Co. being that of a fictitious firm; and that as the plaintiffs were thus practising a deception upon the public, by passing off the thread as being manufactured by persons who had no real existence, a court of equity should not interfere to protect them in their fraud.

§ 495. The court, by Hilton, J., said in reply, that "the label is manifestly one not intended to delude the public, by making any representations or asserting any thing in respect to its qualities or properties, which are untrue; therefore, it cannot be said that, in protecting the plaintiffs in its use, we are assisting in the perpetration of a fraud. It is not contended that the thread to which this label is affixed is an article without merit;

¹ 12 Abb. Pr. R. 237.

while, on the contrary, the testimony at the trial fully established the fact that by its excellence it had acquired a valuable celebrity among dealers, and, besides, has become well-known as the thread of the plaintiffs. . . . The use of the name was not with any fraudulent intent, but, as is stated by Mr. Dale, it arose from the fact that his Christian name is Thomas Nelson, and it is quite obvious that it was used for purposes of identification, and with about the same object as if, instead, he had adopted some familiar emblem, figure, or picture, by which the thread might be designated, and become generally known in the market. The public is not in fact deceived, as it is shown that no such firm exists as Thomas Nelson & Co., who are known to be manufacturers of thread; and the label does not pretend to hold out that any particular manner of manufacturing the thread is followed by which this pretended firm are enabled to furnish a better quality than any one else. Apart from the use of this fictitious firm name, it is not claimed that the label is false in any other respect; and, under the circumstances shown in this case, I think it would be a gross injustice to deny the plaintiffs protection in the use of a trademark¹ to which their title has been so clearly established.” This is the doctrine held by the court in *Stewart v. Smithson*,² in the New York Common Pleas Court, *in banc*. After issue joined, the defendants move to amend their answer by adding the following allegations: “And the defendants, on information and belief, state that the mark claimed by the plaintiffs, and set out in the third section of the complaint, viz., ‘Hall & Moody’s patent thread, Barnsley,’ was and is a false and fraudulent mark, used by the plaintiffs to deceive and defraud, and that the thread containing said mark, sold or kept for sale by the plaintiffs, was not and is not patent, and that no patent for said thread has ever existed; nor was said thread manufactured by Hall & Moody, nor by any person or persons their as-

¹ This term is improperly used here. See definition of “trade-mark

² 1 Hilt. 119.

signees or successors, nor was said thread manufactured at, or brought from, Barnsley, — all which the plaintiffs well knew.” There was also another proposed amendment, involving the same point. The motion was denied, upon the ground that the proposed amendments contained no defence. The defendants appealed. The court, by Brady, J., said that “The mere fact that names used on a trade-mark are fictitious would not authorize the use of it by strangers. The question to be determined in these cases is, whether the mark used by the party claiming the protection of the court is owned by him, without regard to its form, which such party has a right to design according to his judgment or his fancy. If the defendants had alleged that the firm names used on the marks never existed, that would, for the reason stated, furnish no justification for their use of it, and it would not have presented a defence in this action. They have not done so, however, nor have they alleged that firms whose names do appear on the mark did exist, and that the use of their names by the plaintiffs was wholly unauthorized. If they had alleged this, then, in the application of the maxim, *potior est conditio defendentis*, the courts might relieve them from any disturbance by the plaintiffs.”

§ 496. **No Defence that Spurious Article is equal to Genuine.** — It is no defence to a suit for assuming a trade-mark, that the simulated article is equal in quality to the genuine.¹ Upon this point the following distinctions are made: If a druggist prepare a certain kind of medicine, and designate it by the name of a superior medicine, invented, prepared, and sold by the plaintiff, and sells it *as and for* the medicine prepared by the plaintiff, the plaintiff may maintain an action against him, without proof of special damage. But where certain medicines are designated by the name of the inventor, as a *generic term*, descriptive of a kind or class, the inventor is not entitled to the exclusive right of compounding or vending them, unless he have

¹ *Coats v. Holbrook*, 2 Sandf. Ch. 586; *Partridge v. Menck*, *ibid.* 622; *Taylor v. Carpenter*, 11 Paige, 292.

obtained a patent therefor; and if another person prepare such medicines of an inferior quality, and by this means all medicines of this class be brought into disrepute, such inventor can maintain no action for any loss sustained by him in consequence thereof, unless they are sold as and for medicines prepared by him.¹ Moreover, it is no defence that the marks of the spurious goods, or the jobber who sells them to the retailers, inform those who purchase that the article is spurious or an imitation.²

§. 497. *Laches*. — So if a plaintiff lie by for a long time before filing his bill for an injunction, the while being aware of the encroachment, that exhibition of laches will be deemed equivalent to a want of good faith. The case of *Beard v. Turner*,³ before Vice-Chancellor Wood, in 1866, affords such an instance. There, it seems, the plaintiff for two years before filing his bill saw done the identical thing of which he complained. The court said: “But suppose you wish to profit by the act of which you say you have a right to complain, and shall at some future period complain of, then I apprehend this court will say, You must come here at once, for this reason, that you ask in your bill for an account of the profits made by this gentleman upon the sale of these goods. The plaintiff may say: ‘It may answer my purpose to let the defendant go on selling four or five years, and then at the end of that time to say he is my salesman, and I come for an account of profits.’ I know of no instance in which the court has given relief with reference to a trade-mark except on a prompt application. By not complaining at the time when you might complain (I do not say that it is your intention: we must judge of the intention by the necessary result), you are lying by, the man continuing to use your property, with the hope (and such is the prayer in your bill filed two or three years afterward) of obtaining those profits which you stood by allowing him to make under this

¹ *Thomson v. Winchester*, 19 Pick. 214.

² *Coats v. Holbrook*, *supra*.

³ 13 L. T. R. (N.S.) 747.

designation, without apprising him of your intention to make any such use of it. On that ground it falls within the principle enunciated, . . . in which it is stated that it is a fraud to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief. You will assume, when he allows another wrongfully to use that which, in the plaintiff's judgment, would facilitate a rival in trade, that being so, unless you come quickly, you must make a rival in trade your agent, for the purpose of carrying on that business, and for the purpose of getting an account at the end of four years. . . . It appears to me, therefore, that if I had come to a different conclusion, it might have affected the question of costs, although it would not have affected the question of relief. I could not give a person an opportunity of lying by, and then asking for an account of the profits made by an injury committed." — In *Harrison v. Taylor*,¹ in 1865, the Vice-Chancellor refused an account of profits, on the ground of the plaintiff's delay before commencing suit, although the defendant had persevered in the use of the mark after having been cautioned. — In *The Amoskeag Manufacturing Co. v. Garner*,² before Barnard, J., at special term, in 1869, a delay of nine years in applying for an injunction to restrain the violation of a trade-mark, was held good cause for refusing relief. The plaintiff alleged that the defendants wrongfully used a trade-mark belonging to the plaintiff and used to stamp cotton cloths. The judge said that the plaintiff had by silence consented to, if it did not encourage, the defendants in the use of the mark in question upon their labels, introducing these prints to the trade generally throughout the country. That, under these circumstances, to deprive the defendants of the use of these labels would work to them great and irreparable injury, wrong, and hardship, and at the same time give to the plaintiff a dishonest and unconscientious advantage as the fruits of the plaintiff's own wrong and negligence. The rule is that the

¹ 11 Jur. (N.S.) 408.

² 55 Barb. 151.

plaintiff must not be guilty of any improper delay in applying for relief. He said, further, that the design and object of the plaintiff in enjoining the defendants, at that particular time, from using the said labels, was to produce financial embarrassment by destroying their profitable trade, immediately after the payment by the leading member of the defendants' firm, in pursuance of the terms of his father's will, of the sum of \$3,225,000; that to uphold the injunction upon the papers before him would be grossly inequitable and unjust to the defendants; would enable the plaintiff to profit largely by its own wrong and negligence, and thus turn the court into an engine to oppress and destroy, when its true office is to relieve a party from hardship and oppression, and to protect him in the enjoyment of his rights, when they are illegally and wrongfully invaded, or threatened with injury. Injunction dissolved, with costs.

§ 498. **What not deemed Laches.** — When a trader believes that he has good ground for complaining of a colorable imitation of the style of his business, he is justified in waiting until he can collect a sufficient number of cases to show that the alleged attempt has succeeded, before he file his bill; inasmuch as it would not be safe for him to come into court until he could establish actual cases of deception.¹ (This the case of the *Guinea Coal Co.*, in 1869.)

¹ *Lee v. Haley*, L. T. Rep. 22 (n.s.) 251.

CHAPTER XI.

DAMAGES.

When Recoverable. — Presumed in some Cases. — No Fixed and Certain Rule for measuring. — Compensatory. — How measured. — Election of Remedies. — Intent. — Special. — Plaintiff's Negligence. — Exemplary.

§ 499. **When Damages are Recoverable.** — There must be loss legitimately resulting from the unlawful usurpation of a trade-mark, or the plaintiff cannot recover; for if there be no loss, the injury must go unredressed. It is not sufficient that an act unauthorized by law has been committed; because for *Injuria sine damno* there is no compensation. Substantial loss to the plaintiff must have ensued by the mal-appropriation of the mark, the right to the exclusive use of which was in the plaintiff, to entitle him to substantial relief. *De minimis non curat lex.*

§ 500. Thus, it would not be sufficient for the plaintiff to prove that the defendant had threatened to adopt his mark, or that he had actually — through an error as to the scope of the copyright law — filed it with the Librarian of Congress; or, through another blunder, had applied for a patent for the design, — for these acts could not have worked to the legal injury of the plaintiff. There being no property in the mere representation of the symbol constituting a trade-mark, as has been before stated and proved, no legal harm could have resulted from a mere imitation of the symbol. The wrong consists in affixing the mark to merchandise which the public purchase, thereby erroneously supposing that it is the product of the

plaintiff. That is the whole basis of a right to damages in such case.¹

§ 501. Damages will be presumed in some cases; as where one intentionally uses or closely imitates another's trade-mark on merchandise or manufactures, the law presumes it to have been done for the fraudulent purpose of inducing the public, or those dealing in the article, to believe that the goods were those made or sold by the latter, and of supplanting him in the good-will of his trade.² In such a case at law, nominal damages will be given, although no specific injury shall have been proven.

§ 502. No Fixed and Certain Rule for damages can be established, applicable to all cases,³—no inflexible or unyielding guide,—but the rule generally recognized as the true one is to give as damages the amount of profits the defendant shall have made by his infringement.⁴ As in trials at law the jury are the proper judges of damages where there is no certain measure of damages, the court ordinarily will not disturb their verdict, unless on grounds of prejudice, passion, or corruption in the jury.⁵ In all actions on the case, the question is, What is the amount of damages sustained?⁶ and that is within the especial province of the jury to answer, after weighing all the testimony; but, as a general principle, a party is entitled to damages corresponding with the amount of injury suffered, however small.

§ 503. Compensatory damages should be given. The criterion is indemnity;⁷ and in estimating the actual damage, the

¹ *Southern v. How*, 2 Poph. 144; *Blanchard v. Hill*, 2 Atk. 484; *Singleton v. Bolton*, 3 Doug. 293; *Blofield v. Payne*, 4 Barn. & Adol. 410.

² *Taylor v. Carpenter*, 11 Paige, 292, and 2 Sand. Ch. R. 603; *Blofield v. Payne*, *supra*; *Rogers v. Nowil'*, 5 Man., Gr. & Sc. 109; *Coffeen v. Brunton*, 4 McLean, 516; *Marsh v. Billings*, 7 Cush. 322.

³ *Ransom v. The Mayor*, 1 Fisher, 252.

⁴ *Bell v. Daniels*, *ibid.* 372.

⁵ 2 Greenl. on Ev. § 255.

⁶ *West v. Rice*, 9 Met. 564.

⁷ *Parker v. Helme*, 1 Fisher, 44.

rule is to give the value of the use of the thing during the illegal user, or, in other words, the amount of profits,¹ as was said in analogous cases of patented machines. The proper measure of damages, in case of violation of a trade-mark, is generally the profit realized upon the sales of goods to which the spurious marks were attached. The actual damages for the infringement would seem, as a general rule, to be all that could be reasonably claimed. There may be exceptions. Cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement.² Each case must necessarily depend upon its own circumstances. Thus, where in an action on the case for imitating and using the trade-mark of the plaintiffs', on thread made by the defendant, and selling the same as and for the plaintiffs' thread, a verdict was found for the plaintiffs for eight hundred dollars;³ and on a motion for a new trial, the court refused to disturb the verdict. Woodbury, J. (who had not tried the case), said that he had little doubt that there was material enough in the case from which to estimate actual damages, such as the probable extent of sales by the defendant under the marks, and the loss of sales and profits thereon to the plaintiffs; and that the jury would, in a case like that, of a known and deliberate intention, often renewed, and very prejudicial to the plaintiffs, not be very nice in their data and inferences, but be sure to give enough to cover all losses, and ample indemnity, — not “smart-money,” or “vindictive damages,” but full atonement for the wrong done. He said, further, that in a case like that, if in any, no reason exists for giving greater damages than have actually been sustained, or what have been called compensatory;⁴ and that there was nothing peculiarly atrocious in the

¹ *Wintermute v. Redington*, *ibid.* 277; *Page v. Ferry*, *ibid.* 298; *Taylor v. Carpenter*, 2 Wood. & M. 1.

² *Nelson, J.*, in *Guyon v. Sewell*, 1 Blatch. 244. See also *Foote v. Silsbee*, *ibid.* 445; and *Seymour v. McCormick*, 16 How. 480.

³ *Taylor v. Carpenter*, *supra*.

⁴ Citing *Tracy v. Swartwout*, 10 Pet. 81.

conduct of the defendant to be punished by damages, and in no other way, as a public example. It seems that Judge Sprague, who tried the case, in his charge to the jury, used the term "exemplary damages;" but that language was construed by the superior judge to mean a full indemnity for the individual wrong, in every equitable view, that by example might operate the more effectually in a preventive manner against a repetition of such injuries. He further expressed his opinion that the jury did not give more than was sufficient to make the plaintiffs whole, but rather less than the amount.

§ 504. *How measured.*—Every trespass on property gives a right, at least, to nominal damages.¹ All damages must be *the result* of the injury complained of, to wit, the simulation of the trade-mark of the plaintiff, those which *necessarily* result, termed general damages, being shown under the *ad damnum*; for the defendant must be presumed to be aware of the necessary consequences of his conduct, and therefore cannot be taken by surprise in the proof of them. Where the damages, though the *natural* consequences of the act complained of, are not the necessary result of it, they are termed *special damages*, and are not implied by the law. Therefore, in order to prevent a surprise upon the defendant, they must be particularly specified in the declaration, or the plaintiff will not be permitted to give evidence of them. But where the special damage is properly alleged, and is the natural consequence of the wrongful act, the jury may infer it from the principal fact.²

§ 505. But the damages must be proved from the evidence, not from mere conjecture, independent of the evidence.³ A mere *possible* injury furnishes no ground of damages. In a recent English case,⁴ where a bill in equity had been filed to restrain the infringement of a trade-mark, the court offered a decree for an account of profits; but the plaintiffs elected an

¹ Hilliard on Remedies for Torts, p. 404.

² 2 Greenl. Ev. § 254.

³ Carter v. Baker, 4 Fisher, 404.

⁴ Leather, &c. v. Hirschfield, Law Rep. Eq. 1867, pp. 298-301.

inquiry as to damages. It was held that the law would not presume that the plaintiffs would have sold the amount of goods sold by the defendant; but the burden of proof was on the plaintiffs to show special damage by loss of custom, or otherwise. The remarks of the court have an important bearing on the subject of remote or contingent damages. "How can the court assume that the persons who bought what the plaintiffs aver were inferior articles, at an inferior price, would necessarily, if they had not done so, have bought the superior articles at the higher prices." In a case¹ where there was evidence that persons were, by false statements of the defendants' agent, induced to leave the plaintiffs' coach, and to go in that of the defendants', that was held to be a fraud on the plaintiffs, and a violation of their rights, for which an action would lie, without proof of actual or specific damages; and that the damages should not be confined to the loss of such passengers as the plaintiffs could prove had actually been diverted from their coaches to those of the defendants; but that the jury would be justified in making such inquiries as to the loss of passengers and injury sustained by the plaintiffs as they might think were warranted by the whole evidence in the case. When it was stated in the declaration, and proven on trial, that the defendants had obtained some of the plaintiff's wrappers, and used them to palm off inferior articles — metallic hones for sharpening razors, &c. — as the manufacture of the plaintiff, Denman, C. J., stated to the jury that even if the defendants' hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by the fraudulent acts of the defendants. The jury, having found for the plaintiff, with one farthing damages, stating that they thought the defendants' hones were not inferior to the plaintiff's, it was held, *in banc*, that the act of the defendants being a fraud upon the plaintiff, even if it occasioned him no specific damage, it was still, to a certain extent, an injury to

¹ Marsh v. Billings, 7 Cush. 322.

his right. This case makes it clear and conclusive that a plaintiff may recover without proof of special damage.¹

§ 506. **Election of Remedies.** — He whose rights are infringed has his election of remedies. He may proceed in equity for the profits the defendant has made, or he may sue at law for the loss he has suffered.

§ 507. In the first case, if the defendant has realized no profit, there can be no recovery; in the second, he may recover the damage he has sustained, whether the defendant has made any profit or not. He may treat the infringer who illegally appropriates an invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. In such case, the plaintiff may recover those profits, be they more or less; and he can recover no more, however great the damages may be which the alleged interferer has occasioned. If, on an accounting, it should appear that the defendant used the invention so unskillfully that he realized no profit, there could be no recovery. On the other hand, the patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not.²

§ 508. **Intent.** — A wrongful or malicious intent, express or implied, is an essential and prominent element in determining the amount of damages to be awarded. The general rule is that it is of no consequence whether the defendant intended the injury or not. In civil actions, the law does not so much regard the intent of the actor as the loss or damage of the party suffering.³ Yet in actions for the invasion of patent-rights, the intent is generally considered, as in a case where the maker of a machine appears in truth to be ignorant of the existence of the patent and does not intend any infringement;

¹ *Blofield v. Payne, supra.* See also *Rogers v. Nowill, supra.*

² *Woodruff, J., in Cowing v. Rumsey et al., 4 Fisher, 275.*

³ *Johnson, J., in Auburn, &c. v. Douglass, 12 Barb. 557.*

and though this will not altogether exonerate him, it will tend to mitigate the damages.¹

§ 509. **Special Damages.**—The right to recover special damages, *i.e.*, damages additional to the amount of direct and immediate injury, often depends upon the allegations in the writ. Such damages must be specially alleged, solely for the purpose of giving the defendant notice of the plaintiff's demand with regard to them; while, as before said, he is held to take notice of such damage as is the necessary consequence of his act, without any special allegation, and without any statement of the particular circumstance of aggravation. It is rarely in actions for the violations of trade-marks that the right to such damages can be fairly established.

§ 510. **Plaintiff's Negligence.**—In assessing damages, the direct and immediate consequences of the injurious act are to be regarded, and not remote, speculative, and contingent consequences, which the party injured might easily have avoided by his own act. Suppose a man should enter his neighbor's field unlawfully, and leave the gate open; if, before the owner know it, cattle enter and destroy the crop, the trespasser is responsible. But if the owner see the gate open and pass it frequently, and wilfully or obstinately, or through gross negligence, leave it open all summer, and cattle get in, it is due to his own folly. So, if one throw a stone and break a window, the cost of repairing the window is the ordinary measure of damages. But if the owner suffer the window to remain unrepaired a great length of time after notice of the fact, and his furniture or pictures, or other valuable articles, sustain damage, or the rain beat in and rot the windows, the damage would be too remote.²

§ 511. We may apply the doctrine thus laid down by the eminent jurist to the case of one who stands by, and calmly

¹ *Bryce v. Dorr*, 3 McLean, 583; *Whittemore v. Cutter*, 1 Gallison, 429; *Jones v. Pearce*, Webster's Pat. Cases, 125; *Hogg v. Emerson*, 11 How. 587-607. See also *Lowell v. Lewis*, 1 Mason C. C. 182.

² *Shaw, C. J.*, in *Laker v. Damon*, 17 Pick. 284.

sees another pirate his mark. He may sustain many injuries that by prompt action he might have avoided. Legal relief, at best, is but part indemnity. The law in fact aims not so much at satisfaction as at a division of the loss.

§ 512. After a review of the few cases bearing directly upon the question under discussion, — that is, the true principle for the measuring of damages in trade-mark infringements, — we relapse into uncertainty, and despair of finding any nicely-adjusted scheme to solve the problem. The infringement of a mark at one time may be destructive of the trade of the true proprietor; and at another time, and under similar circumstances, it may be comparatively harmless. An article of trade may have an ephemeral popularity which is an immediate fortune to its producer, or it may be a thing of limited sale, yet of continuing demand. All the surrounding facts must therefore be weighed by the jury, or referee, as the case may be, and although of as little account singly as the dust in the balance, yet in the aggregate they may cause the scale to kick the beam. Look at such a case as *Gillott v. Esterbrook*,¹ and the power of the grouping of seemingly insignificant minutiae, to make a convincing proof of fraudulent intent, will be plainly perceptible.

§ 513. In many classes of cases of injury to property, the estimate of damage can easily be made, either by the value of an article destroyed or wrongfully converted, or by a previous liquidation. Thus for the infringement of a copyright, the legislature has laid down certain rules to meet all cases; but when we turn to infringements of patent-rights, and attempt to reason from analogy, we find great difficulty. In *Conover v. Rapp*,² Ingersoll, J., said that the plaintiff is entitled to such actual damages as he has sustained; and that the actual damages are the profits which the defendant has made. This was a case of infringement of a patent for a machine for splitting wood; and evidence having been given that the defendant used

¹ 47 Barb. 455.

² 4 Fisher, 57.

the machine, and also of the amount of wood split by him during each day, the plaintiff calculated from that what the actual damages were. The court instructed the jury that a plaintiff is not able, with the utmost accuracy, in cases of that kind, to give the exact amount of damages that he has sustained. It is beyond his power. He does the best he can. If he is wrong in his calculation, the defendant can put him right. The defendant knows the profit he has made. Therefore, said he, the jury must take the evidence as it is, and come to the best conclusion they can as to what are the actual damages. The jury having found a verdict for the plaintiff, the defendant moved for a new trial before Mr. Justice Nelson. He delivered the opinion that there was no error in the charge of the judge, and denied the motion. Sawyer, J., said, in *Carter v. Baker*,¹ that the profits made by the defendants are proper to be given as a part of the damages; and that the jury might take into consideration other losses caused by the infringement, beyond those profits actually received by the defendants. In a late patent case (*Cowing v. Rumsey et al.*)² Woodruff, J., laid down the rule somewhat more specifically, the true rule being what the plaintiff has lost, and not what the defendant has gained. He said that, "in such an action, it is precisely what is lost to the plaintiff, and not what the defendant has gained, which is the legal measure of the damages to be awarded. Under this rule it may often be entirely proper to prove the profits of the ordinary use of the invention, and the demand existing in the market, evidenced by sales made, and so, as an element of consideration, show the profits realized by the defendant, in order to furnish to the jury all proper materials for determining how much the plaintiff has lost. But I apprehend that they are to answer the precise question, How much loss has the plaintiff sustained by reason of the defendant's infringement? . . . There may be cases so peculiar that there are no means of proving the plaintiff's loss without proving the defend-

¹ 4 Fisher, 404.

² Ibid. 275.

ant's profits, and such proof becomes clearly admissible ; but, even then, the recovery is what the jury shall find to be the plaintiff's loss, not because the defendant realized profits, but because, under all the circumstances, the jury infer, as a fact, but for the interference, the plaintiff would have realized those profits. It may be said, with some plausibility, that the plaintiff's damages may sometimes be greater than the profits which the defendants have made, but ought never to be considered less ; and that the defendants having illegally infringed, should always be held to the presumption that the plaintiff would have made as much as they have realized, and should not be permitted to retain any of the fruits of their illegal conduct, by showing that the plaintiff could not have manufactured or used the invention so profitably." This reasoning is lucid and satisfactory, so far as applicable to a patent case, but should not be strictly applied to a trade-mark infringement.

§ 514. A patentee is presumed to have employed genius, or talent, at least, and to have expended time and money upon his invention ; and in consideration thereof he is allowed, for a limited time, a monopoly of the thing invented. No one else in the country which grants the patent has a right to vend or use the article. All profits from its sale or use belong to the patentee or his assigns. The trade in it is absolutely his during the lifetime of the patent. Not so the traffic in merchandise to which a trade-mark may be attached ; for a thousand persons may have a perfect right to manufacture and sell the same class of goods, and of the same quality and value, and yet but one person have a right to impress those goods with a certain peculiar symbol. It may be that the infringer has facilities for selling a hundred times as much as he whose mark is imitated. Would the small dealer be entitled to receive as damages a hundred times as much profit as he could possibly have made ? Reason forbids it. Courts would regard such a rule in a trade-mark case as extravagant and mischievous.

§ 515. Trade-mark and patent cases, therefore, cannot be

controlled by the same inflexible rule of measurement of damages for infringement. We are unembarrassed in a patent case where the patentee has adopted a patent-fee as one mode of remuneration, and in the fee has fixed his own measure of the value of the use of the machine for the entire term, or until that particular machine is worn out, and the computation is readily made ;¹ for if the patentee has an established price in the market for his patent-right, or what is called a patent-fee, that sum with the interest constitutes the measure of damages.² In one case, the plaintiff insisted that he was entitled to recover for the infringement the full amount which he would himself have made on the articles sold, had he manufactured and sold them himself, upon his own established terms. He gave evidence showing the price at which he sold, and the profits realized upon sales at those prices ; and the court adopted those profits as the measure of damages, and gave him the benefit of the rule, so far as the damages could be ascertained from the testimony.³ But notwithstanding this will not be applicable to all cases of trade-mark infringements, we can understand perfectly well how the analogy may be of assistance. Let us take an example : —

§ 516. The plaintiff has the exclusive right to vend by a fanciful designation a certain article, the secret of the manufacture of which he possesses. It is well-settled as matter of law, that he has no exclusive right of property in the compound itself, it not being patented ; consequently, if any one by fair means discover the secret of manufacture, he may go into competition with the inventor himself, in obtaining the patronage of the public in the sales of the very article.⁴ But we set out with the fact that the plaintiff has the exclusive title in the name of the article, the said name being an arbi-

¹ *Spaulding v. Page*, 4 Fisher, 641.

² *Sickles v. Borden*, 3 Blatch. 536.

³ *Spaulding v. Tucker*, 4 Fish. 633, as cited by the court in *Spaulding v. Page*, *supra*.

⁴ *Davis v. Kendall*, 2 R. I. 566.

trary symbol, and possessing all the essentials of a lawful trade-mark. The public know the article by that name, and would not buy it under any other. If the defendant sell the identical compound, a knowledge of the ingredients of which he may have obtained by chemical analysis, he may do so without hindrance, provided he do not sell it under the name given to it by the plaintiff; but if he do so sell it, he is guilty of infringement of the mark. The number of articles sold by the defendant being ascertained, we have a means of measuring the damages, by applying the rule in patent cases. The presumption must be that the plaintiff would have made all the sales, had it not been for the alleged conduct of the defendant.

§ 517. The courts of equity seem to indicate a rule for measuring damages, by their practice of ordering the defendant to keep an account of sales of merchandise bearing the simulated mark, to the end that they may be paid as indemnity to the complainant. But that this is an exceedingly fallacious guide in actions at law must be manifest, for many circumstances may conspire to cause injury from the improper use of the mark, and many of such circumstances must be taken into consideration, in assessing damages. Unfair competition may cause a loss of reputation and good-will, and depreciation of the class of goods sold by the parties. Sawyer, J., in *Carter v. Baker*,¹ told the jury that they might take into consideration that fact that the plaintiffs, by the infringement, may have sold their articles at a higher price than the defendants had received; and yet, he said, that only those damages which directly and immediately flow from the wrongful act can be considered, and that remote consequential damages must be discarded.

§ 518. No wrong-doer can be allowed to apportion or qualify his own wrong. As a loss has actually happened whilst his wrongful act was in operation and force, and which is attribu-

¹ 4 Fisher, 404.

table to his wrongful act, he cannot set up as an answer to the action the bare possibility of a loss, if his wrongful act had not been done.¹ The disposition of the courts, in such case, is to make the wrong-doer liable for injurious consequences flowing from the illegal acts, although they be very remote.

§ 519. **Exemplary Damages.** — In the case of *Day v. Woodworth*, in the Supreme Court of the United States,² Mr. Justice Grier, in delivering the opinion of the court, said: “It is a well-established principle of the common law that in actions of trespass, and all actions in the case for torts, a jury may inflict what are called exemplary, punitory, or vindictive damages upon a defendant, having in view the enormity of his offence, rather than the measure of compensation to the plaintiff. . . . By the common, as well as by statute law, men are often punished for aggravated conduct or lawless acts by means of a civil action, and the damages inflicted by way of penalty or punishment given to the party injured. . . . And the damages assessed in the circumstances, showing the degree of moral turpitude or atrocity of defendant’s conduct, may properly be termed exemplary or vindictive, rather than compensatory.”

§ 520. Thus, one who shall counterfeit — a term implying deliberation and intent, as contradistinguished from a casual imitation — will be held to a more grave responsibility than another who unwittingly may have copied a rival’s mark.

¹ Tindal, C. J., *Davis v. Garrett*, 6 Bing. Rep. 716 (13 Eng. C. L. R. 212).

² 13 How. 303.

CHAPTER XII.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS.

Classification. — Good-will of Trade. — Name of Firm, Business, &c. — Signs. — Firm-name on Dissolution of Partnership. — Representations on Shop-fronts. — Use of Word "Original," or Equivalent Expression. — Use of Firm-name after Dissolution of Partnership. — Labels and Wrappers. — Author or Publisher's Right to Name of Publication. — Names on Omnibus-coach. — Secret Process. — Breach of Faith.

§ 521. THERE are two species of property which are protected by courts, on principles analogous to those on which rest the decisions in cases of trade-marks proper. These are, the good-will of a trade, so far as it is contained in the style or title of a partnership, or the name of a trader, or the description of his place of business, or peculiar manufacture or product, and labels and wrappers of goods; and property in a name or distinguishing style, as connected with a literary publication, or a work of art. There is another class of cases, too, which must not be entirely omitted from consideration, — those in which the interference of a court has been grounded on the general doctrine of the prevention of damage arising from a breach of trust, or confidence. By this method of classification, many cases may be considered under one general head.

§ 522. **Good-will.** — The authorities in general describe the good-will of a trade as "a probability that the old customers will resort to the old place."¹ Judge Story² says that it may be described to be the advantage or benefit which is acquired by

¹ *Howe v. Searing*, 10 Abb. Pr. R. 264; 6 Bos. 354, and 19 How. Pr. R. 14.

² *Partnership*, § 99.

an establishment, beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position, or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices. Thus, a nursery of trees and shrubs, a favorite fashionable stand, or a newspaper establishment, may and often does enjoy a reputation and command a price beyond the intrinsic value of the property invested therein from the custom which it has obtained and secured for a long time; and this is commonly called the good-will of an establishment.

§ 523. The extent to which a good-will is protected is fully illustrated in *Crutwell v. Lye*,¹ as is also its nature. In that case, the good-will consisted in certain premises in Bath and in Bristol, which were sold by the assignees in bankruptcy of one of the defendants, Edward Lye, who had, for some years, together with his father, George Lye, carried on the business of a carrier from Bristol through Bath to London; the same parties having also a carrying business from Bristol through Salisbury and Warminster to London. At the sale, the whole of the premises of the Messrs. Lye, and their business as carriers from Bristol through Bath to London, and the good-will of that business, was sold in one lot to the plaintiffs; the carrying business from Bristol through Warminster and Salisbury being put up for sale separately, and eventually bought by friends of E. Lye, the defendant, who then set him up in that business. The question was, whether the defendant, according to the facts stated, was really carrying on his own trade, and not that of the plaintiff. A person having sold a house and stock in trade is, in the absence of any special covenant, at liberty to set up a similar business the very next door to his former shop or warehouse. That is merely a fair case of competition in

¹ 17 Ves. 335.

trade ; but he must not, under color of chalking out a different course of trading, really carry on, for his own benefit, the trade of others. Lord Eldon considered that the facts in that case were not sufficient to prove a fraudulent design on the part of the defendant. He said that they amount to no more than that the defendant asserts a right to set up this trade (the carrying business), *and has set it up as the like, but not the same trade with that sold*, taking only those means that he had a right to take to improve it.

§ 524. In *Peterson v. Humphrey*,¹ it was held that an injunction will lie, at the suit of one against his former copartner, restraining the continuance of the use of the signs containing the old firm name, without sufficient alterations or additions to give distinct notice of a change in the firm. The parties were in business on Broadway, in the city of New York, and failed. Some arrangements were made with their creditors, by which they were enabled to enter into a new business, which each did on his own account, — Humphrey at the former store in Broadway, and Peterson in Canal Street. Before the failure, there was a broad sign above the second story of the store on Broadway, in the name of the firm, “Peterson & Humphrey,” and another over the entrance-door. Peterson requested Humphrey to remove those signs, and receiving a refusal, obtained an injunction to prevent the use of them. Before that, the sign on the door had above it the name of the old firm, and the word “formerly,” so as to read “Humphrey & Co., formerly Peterson & Humphrey.” The court said that this last sign was true, and nobody could be deceived by the last words ; but the sign above the door might mislead, and the injunction against it should be sustained. — In *Howe v. Searing*,² the plaintiff, a baker by trade, sought to restrain the defendant from designating the bakery establishment kept by him at No. 432 Broadway, in the city of New York, as

¹ 4 Abb. Pr. R. 394.

² 10 Abb. Pr. R. 264 ; 6 Bos. 354, and 19 How. Pr. R. 14.

“Howe’s Bakery,” and from otherwise using the name of “Howe” in the business, so as to induce the public to believe that the business carried on at 432 Broadway was conducted by the plaintiff. Upon the trial at special term, it was proved that, eight years before, the plaintiff carried on a large and lucrative business at 432 Broadway, and during all the time he carried on the business the premises had been known as “Howe’s Bakery,” and had gained great celebrity by that name. Howe then sold out his lease of the premises, and all the stock, wagons, and fixtures used by him in the business, together with the “good-will” of the concern. After the sale of the business-stand and good-will, Howe, by agreement with his vendee, obtained the privilege of resuming the business at another stand, covenanting not in any manner to interfere with the business carried on at the former stand, known as “Howe’s Bakery.” *Held*, that this was no recognition of the vendee’s claim to use the name of “Howe.” On appeal from the judgment in plaintiff’s favor, the decision was affirmed by a majority of the court. Hoffman, J., said that the case was decided upon all the authorities found bearing upon it. But it is to be noticed that, under a statute of the State of New York, passed April 29, 1833, “to prevent persons from transacting business under fictitious names,” no person has power to transact business in the name of a person not interested in his firm; and that act would have been sufficient to warrant the decision made. By a statute passed April 17, 1854, a copartnership name may be continued by some or any of the copartners, their assignees or appointees, upon filing and publishing a certificate; but that provision applies only to firms having business relations with foreign countries. The court, independent of any regard to the statute, recognized the principle, as one of public policy, that business must be transacted under the name of the real parties doing it, and not under other names.

§ 525. This decision fully accords with the law of France in relation to commercial partnerships. By the 21st article of

the Code of Commerce, the name of the associates can alone constitute the firm name (*la raison sociale*). This is intended to forbid persons who succeed to the business of a deceased merchant from continuing it under his name. "Credit," said Hoffman, J., in commenting upon said article, "is altogether personal. It does not transmit itself by cession or inheritance. It is won by actions and capacity. It is not right, then, that a successor should avail himself of a fallacious credit in appropriating a firm's name extinguished by the death of one of those who gave it the value."¹

§ 526. It has been a question whether the right to use the firm name is a part of the good-will belonging to the partnership, or whether, in case of the dissolution thereof by the death of the partner, it belongs to the survivors. That the right to use the name of a known and celebrated firm in the case of manufactures is often a very valuable possession, is unquestionable; and, therefore, courts of equity will often interpose to protect the right against the abuse of third persons, in using it for their own advantage.² But it has been thought that this right does not fall within the true character and nature of good-will; but that it belongs to the surviving partner. The case of *Lewis v. Langdon*³ illustrates the notion of property in a partnership-name, as a species of good-will attached, not to the place of business, but to the name of a firm, or of a trader. In this case, Vice-Chancellor Shadwell held that a surviving partner had, on the death of his copartner, a right to carry on the business under the designation of the original firm; for that the good-will arising from the use of a particular designation was, during the partnership, the joint property of the firm, and became on the death of one of the partners the sole

¹ See the case of *Compere v. Bajou et als.*, §§ 209-211, *ante*.

² Story on Partnership, § 100; Story on Eq. Jur. vol. ii. § 951; Eden on Inj. ch. 14; *Motley v. Downman*, 3 Mylne & Craig, 1, 14, 15; *Millington v. Fox*, *ibid.* 338; *Knott v. Morgan*, 2 Keen, 213, 219; *Webster v. Webster*, 3 Swanst. 490, n.

³ 7 Sim. 421.

property of the survivor. He, however, while granting the injunction, directed the plaintiff to bring his action at law. — But this opinion does not seem to have been generally acquiesced in. Hoffman, J., in rendering the decision of the court in *Howe v. Searing*,¹ intimates that it is a well-settled rule that the good-will of a partnership business does not survive to a continuing partner; and that it belongs to the firm as much as the ordinary stock in trade. He said that the case of *Lewis v. Langdon*, which seems to assert a different rule, is not the law of the court on this point. He referred to the decision in *Hammond v. Douglass*,² which explicitly asserts a different doctrine, speaking of the good-will generally; and decides that a sale of it cannot be compelled by the representatives of the deceased partner; and that it is not partnership stock of which the executor may compel a division, but belongs of right to the survivor. But in the case of *Dougherty v. Van Nostrand*,³ before him as assistant Vice-Chancellor, he had thought that case could not be supported; and the opinion in the last-mentioned case had been acted on and approved in other cases.⁴ — Perhaps, says Lloyd,⁵ *Churton v. Douglass*⁶ approaches more nearly than any other of the numerous cases on good-will to the case of a trade-mark. There, the defendant had, in 1857, received a considerable sum from the plaintiff, upon a dissolution of partnership, for the purchase of “all his known rights and interests in the partnership business and the good-will thereof.” The plaintiffs carried on the old business under the name of their new firm, “late John Douglass & Company.” Four months afterwards, the defendant again set up his old business, in partnership with other persons, under the firm of “John Douglass & Company.” The whole question, as in *Crutwell v. Lye*, before referred to, was whether, upon all the circumstances, this was an attempt to set up, not a business

¹ See *ante*.

² 5 Ves. 539.

³ 1 Hoffm. Ch. R. 68.

⁴ *Williams v. Wilson*, 4 Sand. Ch. R. 379.

⁵ *Trade-marks*, 35.

⁶ *Johnson*, 174, 7 W. R. 365.

similar to the old one, but the identical business : and the court coming to the conclusion that such was the defendant's intention, granted an injunction, although the defendant's name was John, and the style was genuine. — In *Howe v. Searing*, Moncrieff, J., took the ground, in his dissenting opinion, that the words “Howe's Bakery” were nothing but a trade-mark, and as such passed by the assignment and transfer of the good-will, and, if not the thing itself, it was an integral part of it. He was unquestionably in error in the use of the term *trade-mark*, and in his conclusion of law he is without the support of authorities.

§ 527. In the Tribunal of Commerce of Paris, in 1857 (*Bautain v. Mercklein*¹), it appeared that Bautain and wife had sold to Mercklein and wife their establishment as opticians. Among other conditions, it had been stipulated that the defendants, as successors, might avail themselves of the name of Bautain as found convenient ; but the Bautains reserved the right to continue to carry on another place of business which they had established in another street from that of their former place. The defendants used as a commercial designation the formula, — *Maison Bautain, Bautain Opticien*, without the addition of the words *Mercklein, successeur*, whereupon the plaintiffs brought suit for damages for violation of contract in making a false representation. It was held, in the first instance, that the defendants had obtained the right to use the name of Bautain on their signs, cards, &c., and the case was dismissed, plaintiffs to pay the costs. The plaintiffs appealed. The judgment below was reversed, on the ground that it was only in the quality of successors in business that the respondents had the right to use the name of Bautain ; but as no appreciable injury had resulted to the appellants, no damages were allowed. To suppress the evil for the future, the court forbid the respondents Mercklein to inscribe the name of Bautain on their invoices, addresses, and signs, otherwise than as successors of the said Bautain and

¹ *Annales de la Prop.*, tome iii. p. 207.

wife, that quality to be expressly mentioned in conjunction with the name of Mercklein. The respondents were adjudged to pay the costs of the trial and the appeal. — In the Tribunal of Commerce of Marseilles, in 1861 (*Laurens v. Laurens*¹), it appeared that the plaintiff, Gustave Laurens, had, ever since 1836, carried on the pharmacy founded by his uncle, Joseph Laurens, in 1814, with this sign: "PHARMACIE LAURENS." The plaintiff signed his name as "G. Laurens." and so was generally known. His cousin, the defendant, Paul Gustave Laurens, established a pharmacy in the vicinity of that of the plaintiff, and had for his sign "G. Laurens." The court ordered that the defendant should qualify his designation, suppressing the name of "Gustave." — In the Court of Bourdeaux, in 1865 (*Caminade & Co. v. Caminade*²), it was held, that although in case of similarity in the names of two merchants, in the same line of business, the later comer is not obliged to suppress the name of his firm on his marks and labels, nevertheless he can be adjudged as an instance of good-faith to add his distinctive designation. The defendant had announced in circulars that he had founded at Cognac a mercantile house, under the name of Ad. Caminade, for the purchase and sale of Cognac brandies. It was shown by him that, in his correspondence with his agents, he had notified them not to confound his house, just commenced, and the ancient house of Caminade, with which he had no connection, of either kinship or interest. Good-faith was shown. The court held that every person has a perfect right to use his patronymic, in commerce as in any thing else, subject, however, to the condition of being distinguished as much as possible from any other in the same trade. It was *ordered*, that the defendant's full name appear, thus: Adrien Caminade. This was affirmed on appeal, the defendant spontaneously agreeing to add to his labels, &c., the words "*Maison fondée en 1864*," so as to prevent any possible confusion. — So, also, in the Tribunal of Commerce of the Seine, in 1857 (case of *Pinaud & Amour*

¹ Annales de la Prop., tome viii. p. 221.

² Ibid., tome xiii. p. 268.

v. *Pineau*¹), where the names, although differently spelled, were *idem sonans*. It appeared that the plaintiffs had carried on a hat-store, founded twenty-five years before at No. 87 Richelieu Street, in Paris, by Juste Pinaud; and that the defendant quit-
 ted another street formerly occupied by him, and established a hat-store at No. 91 Richelieu Street. It was charged that he did this to profit by the similitude of name to draw away the custom of the plaintiffs. The defendant contended that he had a perfect right to remove into the street mentioned, and that the difference in the spelling of the two names was quite sufficient to avoid confusion; and, as a subsidiary precaution, he offered to prefix his baptismal name of *René*. PER CUR.: Whereas Pinaud & Amour are proprietors of a hat establishment in Paris, in Richelieu Street, 87, and known for twenty-five years under the name of "MAISON PINAUD;" and whereas Pineau, a hatter previously of the street Fossés-Montmartre, has recently established himself at No. 91 of the aforesaid street, and, with the intention of profiting by the similarity of names, he has placed over his store "MAISON PINEAU;" and whereas he employs for the lining of his hats an escutcheon which is a servile imitation of that adopted by Pinaud & Amour, all of which has been done to divert to himself the custom of the old house of Pinaud; now, although he has an incontestable right to establish himself under his true name, and to place that name upon his place of business, yet he must be interdicted from unlawful competition; and measures must be taken to prevent confusion in the mind of the public between the two houses. *Ordered*, that the defendant suppress the word *Maison*, which in the usages of commerce indicate an establishment of ancient date and reputation; also, that he change the escutcheons chosen by him and placed on the lining of his hats; and, finally, that the name of Pineau shall be preceded by the prenomén *René*, and that these two names shall be placed over both fronts of his store, and on his invoices and

¹ Annales de la Prop., tome iv. p. 86.

letters of commerce, on the same line, and in the same characters. This judgment was to be inserted in two newspapers selected by the plaintiffs, the defendant to pay costs of advertisement and suit. The defendant accepted the condemnation, but he executed it in a tardy manner, and in a way indicative of bad faith. He placed his name, René Pineau, on his principal sign; but on the glass of his entrance-door he left the sole name of Pineau. Besides that, his shop having two fronts, the one on Richelieu Street and the other on Saint-Marc Street, he had placed his surname on one street, and his baptismal name on the other, so that passengers on Richelieu Street, who were more numerous than those on Saint-Marc Street, would see but the name of Pineau. He was again brought into court. For his reprehensible subterfuge in attempting to continue his unfair competition to the damage of the plaintiffs, he was condemned to pay them 2,000 francs, and the costs. — In the same court, in 1858 (case of *Bonnet et als. v. Henry Delisle*¹), it appeared that the sign of the *Maison Delisle* belonged for a long time to a house of commerce, to which name the founders and their successors the plaintiffs attached a very great importance. The defendant, whose place of business was *not* in the same street with that of the plaintiffs, used the same designation of “Maison Delisle,” without any thing to distinguish his establishment from that of the plaintiffs. *Ordered*, that for the future the defendant cease to designate his place of business under the simple denomination of “Maison Delisle;” and that he pay the costs. — And in the same court, in 1857 (case of *Chevet v. Lemasson*²), it was held that when members of the same family, or merchants bearing the same name, have created rival establishments, the proprietor of the most ancient has the right to preserve the qualification of *Maison*, or *Ancienne Maison*, and in case of possible confusion, the junior should be compelled to add his quality of successor on his signs and prospectuses. — In the Court of Paris, in 1858 (case of *Ter-*

¹ *Annales de la Prop.*, tome iv. p. 301.

² *Ibid.*, tome iv. p. 330.

*noux v. Bournhonet*¹), it was held that the successor, however far removed, of a house of commerce, has a right to put on his bills and signs the name under which his house was founded.

§ 528. Courts of equity will protect a party in the use of a sign of an inn, hotel, or other place of business, where the sign or the name is simulated so as to deceive, or be calculated to deceive customers. The adjudged cases proceed solely on the ground of a valuable interest acquired in the good-will of the trade or business. At the foundation of the principle is the idea of falsehood. If a man create a reputation for his business, it is as the keeper of some particular house at a known location, and it is piracy to draw off the custom of his friends or customers who have identified him with the name of his house. It is a personal right. By giving a particular name to a building, as a sign of the hotel business, a tenant does not thereby make the name a fixture to the building, and the property of the landlord upon the expiration of the lease, as was decided by the Supreme Court of California, in *Woodward v. Lazar*.² One may consent to the employment of his name to designate a place of refreshment; but if such consent be purely gratuitous, or unless there is some valid agreement binding upon the party who gives his consent, he may withdraw it at pleasure, and its further use will be enjoined, as in *McCardel v. Peck*.³ And a court of equity will protect by injunction the name of an enterprise undertaken for the amusement of the public, as in *Christy v. Murphy*.⁴ — Even although one's place be designated by two names indiscriminately, a colorable imitation of the title will be enjoined.⁵

§ 529. In France this protection is frequently granted. In the Tribunal of Commerce of the Seine, in 1857 (case of *Dorvault v. Hureauux*⁶), the plaintiffs had for about twenty-five

¹ *Annales de la Prop.*, tome iv. p. 331.

² 21 Cal. 448.

³ 28 How. Pr. R. 120.

⁴ 12 How. Pr. R. 77.

⁵ *Howard v. Henriques*, 3 Sand. S. C. 525.

⁶ *Annales de la Prop.*, tome iv. p. 125.

years used as a sign, and upon their labels, circulars, and prospectuses, the words "PHARMACIE CENTRALE DE FRANCE." The defendants had as their sign the words "PHARMACIE RATIONNELLE," but added thereto the words "CENTRALE DE FRANCE." This fact was recognized by the court as an attempt to create confusion between the two establishments, and the defendants were prohibited from the further use of the latter-mentioned words, as was also done in a case between the same plaintiff and *Teissier & Co.*,¹ the year following. — In the same court, in 1858, came up the case of *Schorthose v. Hogg*,² two Englishmen, cousins-german and pharmacists, and former fellow-students in the office of one Robert. The plaintiff, as successor in business of Mr. Robert, claimed the designation of "LONDON DISPENSARY," under which his pharmacy was known, and also the title of "PHARMACIE DE L'AMBASSADE D'ANGLETERRE." The defendant pretended to have certain rights in Robert's pharmacy, and accordingly used similar names and titles at his store in another street from that in which the plaintiff's was situated. When summoned before the court, for encroachment upon the plaintiff's rights in that respect, the defendant disclaimed all right to the said name and title; but subsequently he took the designations of "LONDON DISPENSARY," and of "ENGLISH EMBASSY CHEMIST." This was held to be an infringement, and defendant was forbidden to further use those titles to designate his place of business, and condemned to pay 500 francs damages, and the costs. — In the same court, in 1859 (case of *Lemercier v. Millin* ³), it was shown that Claude Bully had given his name to an aromatic toilet-vinegar, of which he had transmitted the recipe to Jean-Vincent Bully. The plaintiffs had purchased from the latter his business and the sign of the inventor. The defendant made and sold a toilet-vinegar under the name of "Bully," with the sign "AU TEMPLE DE FLORE." Judgment for plaintiffs. — In the court of Paris, in 1862 (case of *Muller v. Compagnie immobilière* ⁴),

¹ *Annales de la Prop.*, tome iv. p. 298.

³ *Ibid.*, tome v. p. 360.

² *Ibid.*, p. 255.

⁴ *Ibid.*, tome viii. p. 265.

it appeared that the plaintiff had for more than fifteen years carried on a hotel known as the "HÔTEL DE LA PAIX," situate at the angle of the street *de la Paix* and the boulevard of the Capucines. The defendants built a hotel on the same boulevard, and gave it the same name as the plaintiff's. The court below — the Tribunal of Commerce of the Seine — had declined to completely suppress the name thus assumed by the defendants, but accepted their offer to adjoin the word "Grand," and ordered that their sign be altered within the period of two months, so that — in letters all of the same size — it should read "GRAND HÔTEL DE LA PAIX." On appeal, it was held that the words "HÔTEL DE LA PAIX" were indicative and characteristic of the hotel owned by Muller, and that those words could not be employed by others in the same business without violating his rights. A few weeks later, the same parties were again before the court. Muller complained that, notwithstanding the judgment in his favor, the defendants continued to announce in the newspapers their hotel under the interdicted name; and that the napkins and towels for table and toilet, the bills of fare, &c., of the new hotel were thus marked; and the letters "H. P." — an abridgement of the sign — were engraved upon the glass-ware, the bottles, and the plate. The defendants replied that the initials "H. P.," and even the words "Hôtel de la Paix" on the linen, all used in the interior of the establishment, could not prejudice the plaintiff, especially the use of the letters "H. P.," which had no precise sense. They also alleged that the interior arrangements had all been ordered and executed long before the first suit, and argued that the order of the court would not admit of such stringent interpretation as to prevent even the temporary use of the articles mentioned. *Held*, that the letters "H. P." on the porcelain, glass, vessels, silver, cutlery, and divers utensils placed at the disposition of guests, for a purely internal purpose, did not in contemplation of law prejudice the plaintiff. But, although the defendants acted without a fraudulent intent, the use of

the words "Hôtel de la Paix" was a damage to the plaintiff. They were accordingly forbidden to let those words appear on objects either on the exterior or in the interior of their new hotel. But in consideration of all the circumstances, and the hardship that would result from instant suppression, the court granted a delay of six months for the removal of the words "*de la Paix*" from the linen and furnishing-articles; and allowed the plaintiff his costs.

§ 530. *Partnership dissolved.*— Upon a dissolution of partnership, each of the partners has a right, in the absence of a stipulation to the contrary, to use the name and style of a partnership firm.¹ The principles of this case are very plain and simple, and are well-settled by authority. The name or style of the firm "Banks & Co." was an asset of the partnership; and if the whole concern, and the whole good-will had been sold, this was a trade-mark or asset which might have been sold with it. But if the partners chose to divide the partnership assets, each is at liberty to use the trade-mark just as much as before. *Held*, that both are entitled to use the style or firm of "Banks & Co."

§ 531. *Representations contained on the blinds and brasses of a shop-front, calculated to induce the public to believe that the owner is connected with a business with a firm of established reputation, will be considered upon the same principles as govern rights in trade-marks.* In *Glenny v. Smith*,² it appeared that the defendant had been employed by the plaintiffs for three years in their shop, up to April, 1865, and that in May of that year he set up in a like business for himself. The defendant's name, Frank P. Smith, was posted immediately over his shop-window, in black letters upon a white ground, while upon the sun-blind and brass-plate under the window were the words "From Thresher & Glenny," the word "from" being printed diagonally to, and in smaller letters than, the rest. On the part

¹ *Banks v. Gibson*, 11 Jur. (n.s.) 680.

² 11 Jur. (n.s.) 964; 2 Drew & Sm. 476.

of the plaintiffs, the sun-blind and brass-plate were produced in court, and photographs of the shop-front, from which it appeared that when the sun-blind was drawn down the defendant's name was not visible, except to persons passing immediately under the window. They also proved four cases in which persons had actually been misled; and to show that the defendant had some misgivings as to the propriety of his conduct, a conversation between him and one of the plaintiff's assistants was given in evidence. The evidence of the defendant consisted of opinions of persons who had inspected his shop, to the effect that the public were not likely to be misled, and of his directions that nothing should be said to purchasers to induce them to think that Messrs. Thresher & Glenny were connected with his business.

§ 532. *Held*, by Kindersley, V. C.: The same rule that applies in the case of manufacturers applies also to tradesmen by retail. A man having been in the employment of a firm of reputation, has a right, in setting up in business for himself, in any way in which he thinks fit (subject to the restrictions of the rule laid down in the *Leather Cloth Co.* case, and in *Perry v. Truefitt*), to inform the public that he has been in such employment; and in that way he does appropriate to himself some of the benefit arising from the reputation of his former employers. This makes it the more necessary that he should not act in such a way as to mislead the public to the detriment of his former employers. For the purposes of the plaintiff's right to relief, the intention of the defendant is of no consequence: it is enough if, without any unfair intention, he has done that which is calculated to mislead.

§ 533. After commenting upon the nature of the evidence on each side, his Honor continued: That it was in vain for witnesses to say on defendant's part, that, in their opinion, persons could not be misled. When a person goes to try the effect of his own inspection, he knows what he will find, and is prepared to look for the word "from;" but the general public are off

their guard when they pass the shop. But further than this, it is not the question whether the public generally, or even a majority of them, are likely to be misled, but whether the unwary, the heedless, the incautious portion of the public would be likely to be misled. The injunction prayed for was accordingly granted.

§ 534. In the Tribunal of Commerce of the Seine, in 1867 (*Mondin & Co. v. Sari & als.*¹), it appeared that the plaintiffs had adopted as a sign to indicate the nature of their business the words "AGENCE DES THÉÂTRES." It was held that another in the same line of business, who had adopted as his sign the words "OFFICE DES THÉÂTRES," did not infringe upon any right, the words being generic and common. It was no answer that the words might lead to confusion.

§ 535. It is unfair competition to indicate by one's sign an industrial product under a name very similar to that of another product, in such manner as to create confusion. In the case of *Berthelon v. Vergé*,² in the Tribunal Civ. of Lyons, in 1865, it appeared that the plaintiff was the patentee of an invention to which he had given the name of "CONFORMATEUR DU TAILLEUR." From the name, we may infer that the invention was embodied in an instrument for the shaping of garments to the person. Under this denomination, the machine was indicated in the sign, and in the prospectuses of the plaintiff. The defendant, also a patentee, with the evident intention of causing confusion between his machine and that of the plaintiff, placed upon his sign the words "CONFORMATEUR POUR HOMMES ET DAMES," in characters corresponding with those upon his rival's sign. *Per Tribunal*: This act on the part of Vergé does not constitute a counterfeiting or a usurpation of the trade-mark of the plaintiff, but it is an unlawful competition, and therefore the word "CONFORMATEUR" upon the business-sign of the defendant must be suppressed, as also upon his circulars and prospectuses.

¹ *Annales de la Prop.*, tome xiv. 352. ² *Ibid.*, tome xi. p. 349.

§ 536. As another example of the judicial suppression of a fancy name upon a shop-sign, we have *Chaize v. Fromentelle*,¹ in the Tribunal of Commerce of the Seine, in 1865. The parties were tobacconists, carrying on business in the same neighborhood. The plaintiff's sign read, "LA CIVETTE" (civet-cat). He had previously been compelled in defence of his rights to attack a certain dame Pousse, who had erected a sign reading, "*A la CIVETTE de la rue de Rivoli*," and had discomfited her by a judgment of suppression, with 200 francs damages and costs. This time it was the dame Fromentelle who thought to avail herself of the reputation of the plaintiff's wares, by putting up a sign reading, "*A la NOUVELLE CIVETTE*." As it was plain that her motive was to profit by the justly-gained popularity of the establishment of Chaize, a judgment was rendered similar to that in the other case.

§ 537. Labels and Wrappers. — We will now consider another class of cases, which seem to form a connecting link between those where the good-will of a trade has been protected, and those which may be characterized as relating to trade-marks proper. This is where the advantage in the market (or good-will) is due either to the name of the trader or trading-firm, or to his or their place of business, or to both these causes combined, but not being, as a good-will, allowed to rest merely *in nubibus*, is embodied in a label or wrapper, and affixed to the article sold. This name becomes then a *quasi* trade-mark.²

§ 538. *Croft v. Day*³ is a very important case under this head. The *quasi* trade-mark there consisted in the name of Day & Martin, and their address, 97 High Holborn, with other devices on a printed label attached to the bottles of blacking made by the plaintiffs, the executors of the former firm of Day & Martin, and then carrying on the same business. This was so closely imitated by the defendant as to afford the fair presumption that he intended the public to be deceived into

¹ Annales de la Prop., tome xi. p. 350.

² Lloyd, p. 36.

³ 7 Beav. 84.

buying his blacking as and for that of the original firm. The Master of the Rolls, in his judgment, observes that the act complained of was equivalent to a sale by the defendant of his goods as those of the plaintiffs, and that two things were requisite for the accomplishment of this fraud. First, a general resemblance of the forms, words, symbols, and accompaniments, such as to mislead the public; secondly, a sufficient distinctive individuality was to be preserved, so as to procure for the person himself the benefit of that deception which the general resemblance was calculated to produce. — In *Coffeen v. Brunton*,¹ the defendant, in combination with others, fraudulently issued to others a preparation called “Ohio Liniment,” having upon the bottles containing it labels with directions exactly similar to that used by the complainant for his “Chinese Liniment;” and he made representations to induce the public to believe that the composition sold by him contained the same ingredients as the “Chinese Liniment.” McLean, J., said that from the body of the label and of the directions for the use of the medicine, it was clear that the language of the defendant was so assimilated to that of the plaintiff as to appear to be the same medicine, the alteration being only colorable, and was intended to avail himself of the favorable reputation acquired by the “Chinese Liniment.” An injunction was granted to enjoin the defendant from using the labels or directions accompanying the liniment sold by him, or other labels or directions or advertisements or hand-bills tending to produce a false impression in the public mind that the liniment sold by him contained the same ingredients as the “Chinese Liniment.” (It should be noted that this case is frequently referred to as one of trade-marks, but improperly so. The word “Chinese” was the only symbol capable of exclusive appropriation, and that was not pirated.) — *The Merrimack Manuf. Co. v. Garner*² case belongs to the label class. In that, the plaintiff’s label was “Merrimack Prints, Fast Colors,

¹ 4 McLean, 516.

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

* Lowell, Mass. ;” and that of the defendant, “English Free Trade, Merrimack Style, warranted fast colors.” The court, *in banc*, dissolved an injunction which had been granted at special term, and left the parties to try the issue of an actual imitation involving the question of fraudulent intent and actual injury. — So, also, does the case of *Dale v. Smithson*¹ belong to the label class. The plaintiff affixed to each package of thread sold by him a label, reading as follows: “Courtria Flax. Thomas Nelson & Co. Warranted. *Fast Colors & 16 Oz.*” What word or symbol is here to constitute an exclusive emblem? “Courtria” might possibly, if it were a fancy denomination, and not descriptive. The defendants adopted and used in a similar manner upon their thread a label so closely imitating that of the plaintiff as to leave not the slightest doubt of the intention of fraud. The judgment of the judge at special term granting an injunction was, therefore, affirmed at general term. — *Newman v. Alford*² is nothing more than a label case. Both parties used the word “Akron,” the name of the place where the plaintiff had a manufactory, and the defendants had not. The name “Akron” being a mere geographical designation, could not be exclusively appropriated, for the reason that all inhabitants of the place had a perfect right to affix it to their goods. But as there was no room for doubt, in the mind of the court, that the said name was used by the defendants to enable them to avail themselves of the patronage justly belonging to others, an injunction granted at special term was sustained. — *Falkinburg v. Lucy*³ is a label case, although frequently miscalled a trademark case. Sawyer, C. J., said: “Can there be any doubt that the verbatim copy of the entire label of plaintiff, except the heading, the name of the maker, and place of manufacture, and adopting it as the label of the defendants, was done for the purpose of inducing the public to believe that the defendants’ was precisely the same thing as, and pos-

¹ 12 Abb. Pr. R. 237.² 49 Barb. 588.³ 35 Cal. 52.

sessed the identical properties of the compound manufactured and sold by the plaintiff, and for the purpose of availing themselves of the reputation established by the plaintiff?" It was sought to protect an elaborate label under a statute of the State of California, including "any peculiar name, letters, marks, figures, or other trade-mark or name, cut, stamped, cast, or engraved upon, or in any manner attached to or connected with any article, or with the covering or wrapping thereof," &c. Comprehensive as is the language of the statute, and palpable as was the imitation of the plaintiff's label, yet the Supreme Court of California held that the label contained no peculiar names, marks, &c., in the sense of the statute which the defendants had copied: nor was the plaintiff entitled to any protection of the words in common use in our language which composed the profusely-worded label. The injunction granted below was accordingly dissolved. — The case of *Boardman v. The Meriden Britannia Co.*,¹ in the Supreme Court of Connecticut, in 1868, is a fair illustration of the protection which courts award to a mere label, which has been fraudulently imitated for the purpose of diverting custom from its legitimate channel. The labels used by the respondents were of the same size and color as the labels of the petitioners, and the same numerals were used for the same class of goods. The petitioners' label read thus: "1-2 Gross L. Boardman's No. 2340 Wire Strengthened, French Tipped Teaspoons;" and that of the respondents read: "1-2 Gross Meriden Brita. Co.'s No. 2340 Wire Strength'd, French Tipped, Oval Thread Teaspoons." Both parties seem to have regarded the use of the numerals 2340 as giving rise to the most important and most material question in the cause; but Carpenter, J., in delivering the opinion of the court, said that whether in any case numbers alone may be legitimately appropriated as trade-marks, was a question not necessarily involved in that case. It is apparent, at a glance, that neither of the

¹ 35 Conn. 402.

labels contained a single essential element of a technical trade-mark, although the court loosely used that convenient term. From the finding of facts, we can judge for ourselves of the class to which the case belongs. It was found that the respondents manufactured "spoons similar in character to those made by the petitioners, though differing somewhat in style and pattern, and prepared labels resembling those of the petitioners, and adopted the same numbers as had been adopted by the petitioners, adapting said numbers to similar kinds of spoons." We can classify the case as one of unfair competition in trade by means of a simulated label. A remedy was due, and the court awarded it. The court said: "Have the petitioners suffered damage? On this point, there is no room for doubt. The finding of the committee is explicit, that said respondents have sold large quantities of their spoons so put up, in place of spoons manufactured by the petitioners, as alleged in the petition." It is also apparent, from what has already been said, that the petitioners are in danger of still further loss, unless protected by an injunction. The circumstance that the respondents now prefix a cipher to the numbers would hardly vary the result. Their motive is apparent. They may succeed in reaping some advantage from the numbers as thus used, but it is manifest that it will be at the expense of the petitioners." All the judges concurred in giving judgment for the petitioners.

§ 539. As to the right of property in the name of another, we have a case in the Court of Besançon, in 1861. — *Lorimier & Bovet v. Dubois*.¹ The house of Bovet, of Fleurier, a village of the canton of Neuchâtel, in Switzerland, manufacturers of watches for exportation, especially to England and China, authorized M. Lorimier, a watchmaker at Besançon, in France, to use the name of "Bovet" as a trade-mark. Lorimier duly deposited the said name as his trade-mark. By authority of his right to use the same, he seized certain watches, then at the custom-

¹ *Annales de la Prop.*, tome viii. p. 297.

house, *in transitu* for China. The Tribunal of Pontarlier rejected the demand for condemnation. Lorimier appealed. The appellate court said: For more than thirty years Lorimier has manufactured watches for the Bovet firm; from the beginning of his relation with that firm, he has been authorized to engrave upon the watches made by him the name of "Bovet;" and, for more than thirty years, he has constantly sold in China watches bearing the mark of "Bovet," the same being in Chinese characters. Said mark, considering the relation of the two houses, is as much the property of Lorimier as it is of the Bovet house. The defendant has usurped, by his products of an inferior quality, the confidence and the credit attaching to the merchandise of the plaintiffs. If tolerated, there would be no security for commerce. Two owners may use the same mark when their interests are united. The right to the use of the mark of "Bovet" in the Chinese is in both plaintiffs. Injunction. Damages, 1,000 francs, and costs. — Although this is a matter somewhat in the nature of a trade-mark proper, it should be classed with mere labels, and treated as such. Being the simple name of a manufacturer, it of course could not be treated in any part of the commercial-world as the peculiar arbitrary symbol that commerce requires. It serves our purpose as an illustration of the fact that a man may have a qualified right to the use of another's name as a mere sign.

§ 540. *Colton v. Thomas*¹ is to the same effect as the foregoing. The complaint charged an improper and fraudulent use of a name or designation of business, placed by the defendant upon cards and in advertisements, and also upon a sign hung out upon the street in front of his dental-rooms. The bill alleged that the plaintiff had purchased from Dr. Gardiner Q. Colton the right to use the name of the "*Colton Dental Association*" in connection with the use of nitrous-oxide gas to alleviate pain in extracting teeth; and that he used the same in all his advertisements, and prominently displayed it on his

¹ 2 Brewster, 308.

signs, doors, and windows. That the defendant, who had been in his employment, left him, and opened dental-rooms in the same street, and issued cards in form following: "Dr. F. R. THOMAS, formerly operator at the COLTON DENTAL ROOMS. Teeth extracted without pain by nitrous-oxide gas;" and that he had a sign over his door of the same purport. It was alleged that the words "formerly operator at the" upon the cards and sign were in small letters, illegible except to one near by, while the words "Colton Dental Rooms" were in large, bold type and letters, so as to be seen at a great distance. The plaintiff's right to use the name was not denied; nor did the defendant set up any corresponding right in himself. His defence was, that he employed the words "Colton Dental Rooms" without any intention of defrauding the plaintiff; and that his sole object was to protect his reputation, and secure to himself the full advantage of it by advertising the fact that he had ceased to be the operator at the rooms of the plaintiff, which he claimed to be a perfectly fair and legitimate purpose. From the opinion of Allison, P. J., we learn that the signs which hung over the doors of the plaintiff's rooms, No. 737 Walnut Street, and over the defendant's at No. 1027 of the same street, were in size, shape, and general appearance very like to one another. The material portions of the lettering required a careful inspection to notice any difference between them. They both hung in the same manner, on the same side of the street, and might readily be mistaken the one for the other, especially by suffering patients impatient for relief. The same might, to some extent, be said of the cards. An injunction was granted against the use of the cards and sign, and the employment of any device by which the patients and patrons of the plaintiff, without the exercise of excessive care, would be induced to suppose that the defendant's place of business was the place of business of the Colton Dental Association.

§ 541. *The Dixon Crucible Co. v. Guggenheim*¹ is purely a

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

label case, and it need hardly be referred to in this place, further than to invite attention to the fact that the protection claimed was embraced in a statute of the State of Pennsylvania, for the protection of private stamps, wrappers, or labels.¹ The defendant was enjoined against the use of the name of "Dixon," to which he had no right or title. It was not pretended that this was a case of a common-law trade-mark. — In *Blotfield v. Payne*,² a law-case, the declaration stated that the defendants wrongfully, and without the consent of the plaintiff, caused a quantity of metallic hones to be made and wrapped in envelopes resembling those of the plaintiff, and containing the same words, thereby denoting that they were of his manufacture. On trial before Denman, C. J., it appeared that the defendants had obtained some of the plaintiff's wrappers, and used them as alleged. It was held by the court *in banc* that as the defendants had used the plaintiff's envelope, and pretended it was their own, the plaintiff was entitled to recover some damages. — In *Holloway v. Holloway*,³ the defendant sold pills and ointment with labels and wrappers copied from those of the plaintiff. The Master of the Rolls pronounced the act to be as clear and as plainly-avowed a fraud as he ever knew, and granted protection accordingly. — In *Eddleston v. Vick*,⁴ the defendant used labels in palpable imitation of the plaintiff's, and was restrained.

§ 542. A sauce was invented many years ago by *James Cocks*, of *Reading*, and named by him "*Reading Sauce*," under which name it acquired considerable reputation. The success of the manufacture induced others to make and sell what they called "*Reading Sauce*;" and in order to distinguish the article manufactured by *James Cocks* and his successor in business, he and they had for many years been in the habit of wrapping the bottles of sauce, the labels of which always had "*The Original Reading Sauce*." The plaintiff's label was imitated in part.

¹ Sec. 173, Act of March 31, 1860.

³ 13 Beav. 209.

² 4 Barn. & Adol. 410.

⁴ 18 Jur. 7.

But plaintiff admitted the only thing to which objection could be taken was the use of the words, "The Original," the labels being otherwise distinguishable.

§ 543. The defendant by answer alleged that the sauce manufactured by him was made from an original recipe to which the plaintiff had no title, and submitted that his sauce deserved the title of original as much as that of the plaintiff; and he further alleged that the plaintiff's was known to the trade as Cocks's "Reading Sauce," and not as the "Original Reading Sauce." Evidence in support of the last mentioned allegation was given in his behalf; while, on behalf of the plaintiff, two of the partners in the firm of Crosse & Blackwell, pickle-manufacturers in London, deposed that the use of the word "Original" as part of the title or description of a sauce such as *Reading Sauce*, would lead those in the trade, and the public, to conclude that the sauce so described was the manufacture of James Cocks or his successor. There was no evidence that any one had been misled by the words on defendant's wrappers. Lord Romilly, M. R., said, among other matter: The question, then, is this. There being abundant evidence to show that there are a great number of persons who make *Reading Sauce*, whether the person who is the owner of the original recipe which gave the name, and from which the article called "*Reading Sauce*" acquired its character, is not entitled to say, "I hold under the original inventor, and the word *original* means that and nothing else." He said that the use of the word by the defendant was calculated to deceive. The defendant was accordingly enjoined.¹

§ 544. Labels and cautions composed of words in common use in our language cannot be exclusively appropriated as trade-marks. But those labels and cautions, although not protected by any virtue of their own, become powerful auxiliaries, bringing punishment upon the wrong-doer. Take the case of *Gillott v. Esterbrook*.² The selection of boxes, sizes, colors,

¹ *Cocks v. Chandler*, Law Rep. 11 Eq. 446-451.

² 47 Barb. 455.

labels, cautions, and style of lettering, however innocent it may have been under ordinary circumstances, became the most conclusive evidence of the intent to mislead the public, and to commit a fraud upon the plaintiff in relation to his trade-mark; yet merely because all those things can be brought forward as witnesses to complete a chain of testimony of guilt, the mere label does not rise to the dignity of a trade-mark proper.

§ 545. When a man has learned a trade-secret from his employer, and practised it after his employer's death, selling the article under the old name, he will not acquire such a right to the exclusive use of the name as a trade-mark as will be protected in a court of equity.¹

§ 546. The original inventor of a new manufacture, and persons claiming under him, are alone entitled to designate such manufacture as "the original;" and if he or they have been in the habit of so designating their manufacture, an injunction will be granted to restrain another manufacturer from applying the designation "original" to his goods. This was the ruling of the Master of the Rolls, in *Cocks v. Chandler*.² This case must be classed with cases of unfair competition in business rather than with those of trade-marks proper.

§ 547. **Title of a Book.** — There are cases in which the use of a particular title or title-page to a book, or the use of an author's name, has been restrained by injunction. The title of a book or of a newspaper may possess all the characteristics of a trade-mark, when the same is a newly-coined term, or an arbitrary symbol; but that is generally not so.

§ 548. In *Hogg v. Kirby*,³ the plaintiff was proprietor of a monthly magazine published by the defendant, and sold at his shop upon commission. The publication continued during five months; but at the end of that time disputes arose between the parties. It was agreed to discontinue the joint publication, and a final settlement of accounts was had. The plaintiff then

¹ *Hovenden v. Lloyd*, 18 Weekly Reporter (Eng.), 1132.

² 11 L. R. Eq. 446.

³ 8 Ves. 215.

circulated advertisements, stating that the publication under its old title would be continued by him, and that a sixth number of the magazine would be, as it accordingly was, soon afterwards published by him. The defendant at once advertised and published the first number of a periodical work under a title similar to the plaintiff's, but described as a "New Series, Improved." An injunction was applied for, to restrain him from selling any copies of his publication, and from printing or publishing any future or other number, either under the same or any similar appellation, and from borrowing and using the appellation, or copying the ornaments, or any part of the plaintiff's original publication. Several circumstances were alleged by the bill to show that the defendant's work was intended to mislead the public to the conclusion that it was a continuation of the plaintiff's, — such as the general resemblance, though not an exact similarity of its title-page or wrapper; the continuation in the new magazine of an article left unfinished by the old; and the publication of an index to the first five numbers of the old work, under the name of an index to the first part. This intention was, however, denied by the answer, which attempted to give a sufficient reason for the steps taken in composing the form and substance of the new magazine, to show that it was not intended to represent it to the public as a continuation of the old work; and the defendant submitted that he had a right to publish a work under a similar title. The court held, that, upon the facts stated, there appeared to be an intention on the part of the defendant to put his work before the world as a continuation of the old magazine. Lord Eldon, in that case, did not rest his decision so much on the ground of copyright, or of contract, as upon that of fraud. He stated the question to be, not whether the work was the same as the original, but whether the defendant had not represented it to be the same, and whether the injury to the complainant was not as great, and the loss accruing to be regarded upon the same principles

between them, as if it were, in fact, the same work. What we may gather from this decision amounts to this: that, by a certain resemblance of form and matter, a publisher may not with impunity put forth to the public a literary work to be taken for another work of an established reputation, and thus fraudulently reap the advantage enjoyed by the original work; and that this advantage in the market corresponds in some measure with the property created by the Copyright Act, and is protected on analogous grounds.

§ 549. A case of a similar character is that of *Spottiswoode v. Clarke*.¹ There the plaintiff was the owner of a publication called "The Pictorial Almanack, for 1847;" and the defendant of one called "Old Moore's Family Pictorial Almanack." The plaintiff alleged that the defendant's work was a piracy on his publication, and filed a bill for an injunction. With regard to the substance and internal portion of the two works, there was little or no resemblance; but the covers were, to a certain extent, similar, both being decorated with a pictorial representation of the Observatory at Greenwich, and in the title, as printed on the cover, making use of nearly the same expressions. The bill alleged that this imitation was intentional, and done with a view to deceive the public, to the injury of the plaintiff. The Lord Chancellor said, among other things: "In the course of argument, cases of trade-marks were referred to; but trade-marks have nothing to do with this case. Take a piece of steel: the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article. So it is of blacking, or any other article of manufacture, the particular quality of which is not discernible by the eye. In the present case, if anybody is deceived it is not by the eye; for any thing more different than the two articles in question can hardly be conceived. . . . Both covers represent a portion of Greenwich Observatory, and profess the work to be for all sorts of persons. It is diffi-

¹ 10 Jur. 1043, and 2 Ph. 154.

cult to believe that all this is accidental ; but if it is a fraud, it is the most clumsy fraud that I ever saw, for it could deceive no one." He accordingly dissolved the injunction granted below, the defendant undertaking to keep an account, with liberty to the plaintiff to bring an action. The whole gist of the matter lies in this : If no one could be deceived, the plaintiff suffered no injury ; but if a casual observer would probably be misled, then the principle laid down in trade-mark cases would be applicable, and the use of a particular name, title, or wrapper, would be restrained. This case has been cited and followed." ¹

§ 550. In *Snowden v. Noah*,² the complainant had purchased from the defendant the right to publish at the city of New York a newspaper called "The National Advocate." The defendant subsequently published at said city "The New York National Advocate." Sandford, Ch., held that there was such a difference as to warrant the court in refusing an injunction to restrain the defendant. — So, in *Bell v. Locke*,³ Walworth, Ch., denied an injunction to restrain the defendant from publishing or circulating a newspaper called the "New Era," which was alleged to be an infringement of the rights of the plaintiff, who published the "Democratic Republican New Era." Besides the difference in titles, the defendant's paper, upon its face, purported to be a revival of an old paper, in which he was formerly interested with the complainant, which paper had been voluntarily discontinued by both for more than eighteen months. — In *Matsell v. Flanagan*, the complaint alleged that the plaintiffs were, and long had been, the publishers and proprietors of the "National Police Gazette," which was commonly known to the public as the "Police Gazette ;" and it appeared that it was the only "Police Gazette," *eo nomine*, published in the United States, at the time of the publication of this paper. It further appeared that the

¹ *Purser v. Brain*, 17 L. J. Ch. 141. See also *Chappell v. Davidson*, 1 K. & J. 123.

² *Hopkins*, Ch. R. 347.

³ 8 Paige, 75.

defendants were engaged in publishing and selling a paper called "The United States Police Gazette." which, from its general character and appearance, was a fraudulent simulation of the plaintiffs' paper. The words "Police Gazette," forming a part of the title, were printed in type similar in character to that employed by the plaintiffs for their print, and a similar imitation characterized the general form, style, type, and device of the paper complained of. It was shown that the public were actually misled into purchasing the defendants' paper for that of the plaintiffs; and the more easily as when "The United States Police Gazette" was folded, and lying upon the newspaper stands, as is usual and customary, the words "United States," which made the difference between the titles of the two papers, would be concealed. The manifest fraud in this case distinguishes it in principle from *Snowden v. Noah* and *Bell v. Locke* (*supra*). The injunction was continued. — In *Stephens v. De C'nto*,¹ the main question was, whether the name of a newspaper in the Spanish language, called "El Cronista," published by the defendant, was an infringement upon the name "La Cronica." Monell, J., held that there was so manifest a dissimilarity in the general appearance of the two titles, both as respects the formation of the words and the character of the type employed in printing, that no Spaniard could be mistaken. But the case was relieved of all difficulty, as it appeared that the publication of "La Cronica" had ceased. The injunction was dissolved, and the complaint dismissed. — In *Dayton v. Wilkes*,² the good-will of a newspaper — that is, the celebrity which it had acquired under the name of "Porter's Spirit of the Times" — was fully recognized a valuable property. — And in *Clement v. Madlick*,³ where an injunction was granted to restrain the defendant from using the name "Bell's Life" for his newspaper, the court characterized the suit as "an application to support a right to property."

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

² 17 How. Pr. R. 510.

³ 5 Jur. (N.S.) 592.

§ 551. In the Court of Paris, in 1858 (case of *Estibal v. Petit-Demenge*¹), an appeal from a judgment forbidding the defendant from using the name of a journal — the “Charivari” — on card-covers for the same, to be used in coffee-houses, lecture-rooms, &c., it was held that such use did not constitute a case of illicit competition or infringement. The appellate court said that the gilt advertising-cards of the defendant were but covers for the “Charivari,” which could not create confusion in the public mind with the paper itself; and although, in enclosing the “Charivari” in the covers the defendant addressed the readers of the journal, that fact in itself did not make him responsible in damages. The defendant offered to alter his cards so that they should read, “Cover for the Charivari,” which the court thereupon directed should be done.

§ 552. In the Tribunal of the Seine, in 1855 (*Castille v. Dennery*²), it appeared that the plaintiff had published, in 1847, a romance, entitled “LES OISEAUX DE PROIE” (The Birds of Prey). The defendant brought out a drama under the same title, which was thought by Mr. Castille to be an infringement upon the name he had selected. *Held*: Considering that for a long time the words *Oiseaux de Proie* have been metaphorically employed to designate certain men; that those men offer types so varied that they are the objects of observations, of studies, and diverse paintings, to each of which the said words are as applicable as to a romance by Castille; and that there is no invention in the title, — the demand of the plaintiff must be refused.

§ 553. An author or a publisher has, either in the title of his work, or in the application of his name to that work, or in the particular external marks which distinguish it, just such a species of property as a trader has in his trade-mark. He may, therefore, equally claim the protection of a court of equity against such a use, or such an imitation of that name or mark as is likely, in the opinion of the court, to

¹ Annales de la Prop., tome iv. p. 334.

² Id., tome ii. p. 27.

be a cause of damage to him in respect of that property.¹ Upon this principle rests the case of *Thunot-Duvotenay v. Degorce-Cadot*, in the Court of Paris, in 1869. Madame Michaud, widow of the historian of the crusades, had married M. Thunot-Duvotenay, and conjointly with him and others in interest had brought suit to prevent the further publication of a "History of the Crusades," which had been brought out by the defendant. The defendant had, in 1868, by means of circulars and notices, profusely scattered about, announced for sale the "HISTOIRE POPULAIRE ET NATIONALE DES CROISADES," by Michaud. Four numbers of this book were published. Having been duly warned by process to cease the publication, he had recourse to subterfuge to give to the complainants a seeming satisfaction. In the fifth number, he ceased to edit the text of the "History of the Crusades," by Michaud, and substituted therefor the "Jerusalem Delivered," of Tasso. The substitution deceived a portion of the public, who believed that the "Jerusalem Delivered" was a legend of the "History of the Crusades," which latter title continued to figure at the head of each page. These combinations and manœuvres constituted a manifest fraud. The Tribunal of Commerce of the Seine, which had original cognizance of the case, held that it had jurisdiction of the matter as a commercial act, the parties appearing in the character of merchants. Judgment for complainants. Upon appeal, the defendant invoked his good faith to repel the presumption of tort. He fared no better than in the forum below. The court said, *inter alia*: Considering that Michaud is a contemporary author; that his "History of the Crusades" has a merit and renown that the defendant was among the first to recognize; that the defendant is a bookseller and editor in Paris, where divers editions of this book have been published; that under these circumstances he cannot pretend ignorance of the fact that the name has not become public property, but belongs to the heir and assignees, or, if he had a doubt thereon, the most

¹ Lloyd on Trade-marks, 2d ed. p. 42.

simple effort would have dissipated the doubt; that he cannot pretend that he prepared and commenced the publication in good faith, but has manifested his bad faith by his acts; therefore he is guilty of counterfeiting, and the judgment must be affirmed, with costs.

§ 554. In the remarkable case of *Lord Byron v. Johnstone*,¹ the defendant, a publisher, advertised for sale certain poems, which he represented by the advertisement to be the work of Lord Byron, on whose behalf a bill was (during his lordship's absence abroad) filed to restrain the publication under the title described in the advertisement. There appears to have been some doubt at the time of the original publication whether or not the poems were Lord Byron's; but when the defendant, at the hearing, declined to swear as to his belief that the poems in question were actually the work of Lord Byron, the court granted the motion for an injunction until answer or further order. This seems like recognizing a proprietary right in a mere name. At least, it goes so far as to grant relief against damage arising from the use of a particular name in conjunction with a particular article offered for sale; it being impossible for the purchaser to ascertain, on mere inspection, the truth or falsehood of the representation on the faith of which he buys the article.

§ 555. It is difficult to reconcile the principle of the decision in this case with that of the decision in *Clark v. Freeman*,² where the eminent physician, Sir James Clark, applied for an injunction to restrain a chemist from publishing and selling a quack medicine under the name of "Sir James Clark's Consumption Pills;" but the court refused to interfere, because it did not appear that Sir James Clark had sustained any pecuniary injury. The only distinction between the principles of the two cases seems to be this: that in the former the author must be held to have a species of property in his name, consisting in

¹ 2 Mer. 29.

² 11 Beav. 112; s. c. 17 Law J. Rep. (n.s.) Chanc. 142.

the recommendation to the public which the use of that name gives to the sale of a literary work, while it did not appear that Sir James Clark was in the habit of selling medicines, or of deriving a profit from the sale of medicines, and therefore it could not be argued that he had suffered injury in trade: and the court could not recognize an injury done to his reputation, which it treated as an illusory damage. It must, therefore, have held in the former case that the author has a species of interest in his name quite similar to that of a trader in his mark affixed to the articles manufactured by him.

§ 556. Yet there does seem to be natural justice in protecting one's name from contempt or unpleasant notoriety, which may amount to infamy. Could not the eminent physician have been seriously damaged in his practice by the usurpation of his name by a quack? and was he not in all probability injured in his professional reputation by the conduct complained of? If this decision is sound, may not any man's name be blasted by the brazen villany of another who chooses to borrow his name! In France, a different doctrine is maintained, as is evident by the judgment of the Tribunal Civ. of the Seine, in 1869 (*Charles de Bussy v. Charles Marchal*¹). The defendant, well-known in the literary world under the pseudonym of Charles de Bussy, is the author of numerous publications which have appeared under the assumed name. Among them is a *brochure* entitled "Les Impurs de Figaro," and another entitled "Le Cas de M. Rochefort." The plaintiff, an engineer of Paris, who aspired neither to immodest notoriety nor the imputation of embroiling himself in political affairs, obtained an injunction against the further misuse of his name, with 50 francs damages, and costs.

§ 557. **The Name of a Song.** — Certain music-publishers having adapted original words to an old American air, which was rearranged for them, gave to the song so composed the name of "MINNIE," and procured it to be sung by Madame Anna

¹ *Annales de la Prop.*, tome xv. p. 143.

Thillon, a popular singer, at M. Julien's concerts in London : and when it had by that means become a favorite song, they published it with a title-page containing a picture of the singer who had brought the song into notice, the name "Minnie," &c. *Held*, that the publishers had by these means obtained a right of property in that name and description of their song, which a court of equity would restrain any person from infringing.¹ Another party infringed upon the same by using the words "MINNIE, DEAR MINNIE," and was restrained by an interlocutory injunction, without imposing upon the parties the necessity of trying the right at law.²

§ 558. **Printed Publications** have sometimes their titles registered as trade-marks, and they may legitimately be so, provided they have such a distinctive individuality as shall preclude the probability of confusion with the titles of other publications. "OUR SOCIETY,"³ and "INSURANCE MONITOR"⁴ seem to be free from any such objection, as applied to periodicals.

§ 559. **The Right to Exclusive Use must be Definite**, to entitle the claimant to relief. In England, it has been held that a newspaper is not within the Copyright Act, 5 & 6 Vict. c. 45, and therefore requires no registration under that Act : but the proprietor of a newspaper has, without registration, such a property in all its contents as will entitle him to sue in respect of a piracy.⁵ But there must be something definite and certain in the thing sought to be protected. When the proprietor of a newspaper sought to restrain the piracy of a "List of hounds," the court was of opinion, that although the piracy might be established, the list was liable to such frequent changes, and a correct list was so easily obtained, that it was not a case for an interlocutory injunction.⁶

¹ *Chappell v. Sheard*, 2 Kay & J. 117; 1 Jur. (n.s.) 996.

² *Chappell v. Davidson*, 2 Kay & J. 123.

³ *F. C. Barksdale*, No. 424.

⁴ *Charles C. Hine*, No. 903.

⁵ *Cox v. Land and Water Journal Co.*, 9 Law R. Eq. 324; 39 L. J. Chan. 152 (V.-C. Malin's Court.)

⁶ *Ibid.*

§ 560. **Names on Coaches.** — A court of equity will restrain a defendant from fraudulently using the same words and devices on an omnibus that the complainant may have previously appropriated to designate his. In *Knott v. Morgan*,¹ in 1836, in the Rolls Court of England, the defendant was restrained from using upon an omnibus the names “London Conveyance,” and “London Conveyance Company,” or either of such names, or any colorable imitation of them, or either of them, painted, stamped, printed, or written thereon, or in any manner affixed thereto. — *Stone v. Carlan*,² in 1850, is a similar case, the defendants having been restrained from improperly using the names “Irving Hotel,” “Irving House,” or “Irving,” upon coaches, and upon certain badges worn by the defendants upon their arms and hats.

§ 561. An action of trespass on the case may be maintained under similar circumstances. Thus, in *Marsh v. Billings*,³ where the plaintiffs claimed and established the exclusive right to use the name of a hotel, “Revere House,” upon coaches, to indicate the fact that they had the countenance of the lessee of that house for the purpose of transporting passengers to and from that house from the railroads. For this privilege they paid an equivalent in the obligations into which they entered. The ground of action against the defendants was not that they carried passengers to the Revere House, or that they had the words “Revere House” on the coaches and on the caps of the drivers merely, but that they falsely and fraudulently held themselves out as being in the employment, or as having the patronage and confidence of the lessee of the Revere House, in violation of the rights of the plaintiffs. The Supreme Court of Massachusetts held, on appeal in this case, that the plaintiffs would be entitled to such damages as the jury, upon the whole evidence, should be satisfied they had sustained; and that the damage should not be confined to the loss of such passengers

¹ 2 Keen, 213.

² 13 Mo. L. R. 360.

³ 7 Cush. 322.

as the plaintiffs could prove had actually been diverted from their coaches to those of the defendants, but that the jury would be justified in making such inferences as to the loss of passengers and injury sustained by the plaintiffs as they might think were warranted by the whole evidence in the case.

§ 562. **Secret Process. Breach of Faith.**—There are also cases involving a breach of trust, in disclosing a secret process, a knowledge of which has been gained through confidential relations of the parties. The earliest of these cases, *Newbury v. James*,¹ shows the difficulties that have been felt in dealing with questions of this sort. The plaintiff there claimed to be entitled, under the provisions of certain agreements entered into by the ancestors of himself and the defendants, respectively, to the exclusive right of selling certain powders and pills, well known as “James’ Powders,” and “Analeptic Pills,” as agent to the defendants, and prayed a decree for specific performance of agreements. The pills and powders were made up by the defendants from an alleged secret recipe; and it was sought to restrain them from communicating this recipe to any other person without the plaintiff’s permission. The court does not seem to have looked upon this secret recipe in the light of property,—the subject of certain agreements as to the manner of enjoyment, and as clearly liable to injury from divulcation. Had this been done, there probably would not have been serious difficulty in framing an injunction in restraint of such a contemplated injury, even though the court might not have been able to decree the specific performance of the agreement. On this head, the Lord Chancellor said that either it was a secret, or not. If a secret, what means did the court possess for enforcing its own orders? If not a secret, there was no ground for interfering. If the art and method of preparing the Analeptic Pills, for which no patent had been procured, were a secret, what signified an injunction, the court possessing no means of determining on any occasion whether it had or had

¹ 2 Mer. 416.

not been violated? The only way in which a specific performance could be effected would be by a perpetual injunction; but this would be of no avail unless a disclosure were made to enable the court to ascertain whether it was or was not infringed; and in complaining of a breach of an injunction, it would be necessary first to show that the injunction had been violated. The injunction was therefore dissolved. — In *Williams v. Williams*,¹ it was said that the court would not struggle to protect secrets in medicine of that sort; but that it was different in the case of a patent, because there the patentee was a purchaser from the public, and bound to communicate his secret at the expiration of the patent. — This point has been settled with tolerable distinctness in *Dietrichsen v. Cabburn*.² Lord Cottenham virtually decided that, where there is such an infirmity in an agreement that it cannot be performed in all its parts, the court will not by injunction compel a defendant to perform the one part, it being at the same time unable to compel the plaintiff to perform reciprocally the other, namely, that which was positive in the agreement, if its aid should be appealed to by the defendant in order to procure for him the benefit of the contract or agreement. — We find, however, that in *Youatt v. Winyard*,³ the defendant, who had been employed as the plaintiff's assistant under an agreement by which he was to have a salary, and be instructed in the general knowledge of the business, but not in the secret of manufacturing the medicines sold, was restrained from divulging those recipes to which he had surreptitiously gained access; and from making up and selling the medicines compounded from the recipes, with certain printed instructions, almost literally copied from the plaintiff's. In this case, the decree proceeded on the ground of trust. — So, also, in *Green v. Holgham*,⁴ where the defendant was held to be the trustee of the secret of compounding "The Golden Ointment," under the trusts of a certain settlement, and was ordered

¹ 3 Mer. 157.

³ 1 J. & W. 394.

² 2 Ph. 52.

⁴ 1 S. & S. 398.

to account for certain mesne-profits made by him in the sale of the ointment; the court even going so far as to direct the valuation of the secret to be made for the purpose of administering the trust property. — In *Tipping v. Clarke*,¹ a case arising out of a dispute between two merchants, in the course of which the defendant, in a letter to the plaintiff, stated that he had acquired a knowledge of his books and accounts, and that he intended to make a public exhibition of them, we have a recognition of the same doctrines. — In *Morison v. Mout*,² it appeared that the plaintiff and the defendant had for some years carried on in partnership the business of making and selling “Morison’s Universal Medicine.” On the dissolution of the partnership, the defendant, who had retired, set up for himself, and made and sold the original medicine under its former name as prepared by him. It appears that the plaintiff, in praying for an injunction, did not omit to put forward the ground of fraud or misuse of his labels and trade-marks by the defendant; but he relied on this only in aid of the principal head, — that of breach of faith and contract; and it is on this ground that the decision rests. In France, the law recognizes the secrets of manufacturers as property, and article 418 of the Penal Code severely punishes clerks or workmen who divulge the secrets of manufacture of their employers.

§ 563. On the other hand, where no charge of breach of trust is involved, courts will not protect the proprietors of secret medicines or other compounds not patented; and any one possessing himself of another’s secret by fair means, may make and vend the same, provided he sell it as his own manufacture, and not that of a party complaining. Thus, in *Davis v. Kendall*,³ where the plaintiff had no patent, and therefore no exclusive property in a medical compound invented and sold by him, and known as the “Pain Killer,” the court said that all were entitled to make and vend the compound. — The same

¹ 2 Hare, 383.

² 9 Hare, 241.

³ 2 R. I. 566. See *Annales de la Prop.*, tome xiv. p. 229.

doctrine was recognized in *Comstock v. White*.¹ The defendants in that case, after dissolving their connection with the plaintiffs as partners, commenced using the name or designation of "Dr. Morse's Indian Root Pills," to which neither party had any exclusive right without a patent from the government. The court held that while an injunction should not be granted against an innocent defendant, yet where it appeared that the defendants, in having connected themselves with the plaintiff in selling the medicine by a particular name or designation, and having induced the plaintiffs to expend large sums of money in advertising, &c., the medicine manufactured, and then suddenly and without notice, in an unjustifiable manner and apparently from improper motives, severed their connection with the plaintiff and set up the same business for themselves, an injunction should be granted.

§ 564. As an instance of reparation for a wrong done, we will take a case tried in the Court of Paris, in 1861, — *Galy v. Mauchien & Co.*² Galy was the inventor of certain pharmaceutical products, which he sold under the denominations of *Sirap iodhydrique*, *iodhydrate de fer*, of *bonbons iodhydriques*, and of *pâte pectorale de réglisse iodhydrique*. He made the defendants the exclusive agents for the sale of his said products, upon the condition that they should use upon flasks, boxes, and prospectuses the above-mentioned names, and also the name of Galy, as inventor. They omitted his name, wherefore he sued. The court took into consideration the publicity which the defendants had given to the spurious labels, and said that, as the defendants had committed the wrong by means of announcements made by the *Société hygiophile*, in the journals *le Siècle*, *la Presse*, *les Débats*, *la Patrie*, *le Constitutionnel*, *le Pays*, and in the journal called *La France médicale et pharmaceutique*, it was just that the order of the court should receive the same publicity at the expense of the defendants. In addition to costs, &c., the publication was ordered to be made showing the judgment for the plaintiff.

¹ 18 How. Pr. R. 421.

² *Annales de la Prop.*, tome viii. p. 374.

CHAPTER XIII.

PRACTICE IN PATENT OFFICE.

Preliminaries. — Selection of Counsel. — Necessity for Forms. — System of Examination. — Special Pleading. — Drawing and filing of Application. — Amendments. — Confidence the Design of Oath. — *Prima Facie* Right to Mark. — Indefiniteness. — Description of Colors. — Breadth of Claim. — Degree of Specificness. — Examples of False Models. — Rejection because of False Suggestion. — Litigation not encouraged. — Surrender and Re-issue. — Money paid as Fees, when returnable.

§ 565. **Preliminaries to Application for Registration.** — When the proprietor of the right to exclusive use of a trade-mark wishes to avail himself of the advantages of registration, he should reflect how his object can best be accomplished. He prepares his case with carefulness and thought. This he may do himself, and generally with an assurance of safety, provided he possess that rare quality known as “common sense.” The forms to be found in the Appendix to this treatise serve as a guide, the necessary modifications being made to suit the peculiarities of each case. But he may not always feel perfectly safe in drawing up a few simple statements of fact, for if he be a person really possessed of the rare quality mentioned, in the majority of instances he will mistrust his own powers, remembering that experience is the mother of science. No man is wise at all times. The very simplicity of the procedure is puzzling to him. Many men deem it to be a simple matter to string a few sentences together in the form of a will and testament. We know that the memory of the man who drew his own will is always venerated as the lawyer’s best friend. Words are sometimes used in a wrong or loose sense even by

astute jurists and writers; what, then, may be expected when a layman — however expert he may be with ledgers and invoices — hastily pens an application for the registration of his mark? That mark may be worth a fortune to him, although a mere “*abracadabra*” when disconnected from a particular species of goods. The meaningless, arbitrary symbol becomes a talisman. How, then, shall it best be protected? ¹

§ 566. The rules of practice of the Patent Office (131–135) furnish good advice upon this subject. The remarks made in regard to a patent are quite applicable to a trade-mark. The value of either depends largely upon the careful preparation of specifications and claims, and “the assistance of competent counsel will, in most cases, be of advantage to the applicant, but the value of their services will be proportioned to their skill and honesty.” But how shall a selection of counsel be made from the multitudes of aspirants for forensic honors? Rule 131 says that “the Office cannot assume responsibility for the acts of attorneys (a broad term, including counsellors and solicitors, all being attorneys-in-fact when practising in the Office), nor can it assist applicants in making a selection. It will, however, be a safe rule to distrust those who boast of the possession of special and peculiar facilities in the Office for procuring patents in a shorter time, or with more extended claims, than others.” Making the necessary changes in words, we may apply this caution to trade-mark matters.

§ 567. It is not every experienced counsel in patent cases who is qualified to conduct, or advise upon, a question of law applicable to trade-marks. It has frequently been made manifest that one who has devoted himself exclusively to patent practice is at a disadvantage when dealing with rights in a symbol of trade and commerce. His thoughts — habituated to

¹ “La marque employée honorablement peut et doit être maintenant une source de fortune, puisqu’on est sûr désormais qu’une protection efficace empêchera qui que ce soit d’usurper le signe caractéristique dont on a fait le pavillon de sa marchandise pour soi et ses successeurs.” — “*Marques de Fabrique*,” by M. EMILE BARRAULT.

run in a groove — confound one thing with another of quite a dissimilar nature. The mischief of mistaking a certificate of registration for a patent, or any thing in the nature thereof, has been demonstrated in several places in this book. Yet mere patent lawyers (!) make this mistake every day, and will continue to do the same, in accordance with the proverb, “A wise man changes his mind, a fool never.” It would therefore be judicious for the applicant to select as his legal adviser one who is not a *mere* patent lawyer, to deal with this question, involving so much commercial law. Forewarned, forearmed. The language of the papers may be the foundation to all right to protection.

§ 568. **Necessity for Forms.** — It has been well said that well-constructed *forms* are the consummate excellence in every department of legal practice. As conveyancing is nothing without forms, so is pleading nothing without them. Forms are the only contrivances to secure precision, certainty, and facility.¹ *Form* is of incalculable advantage to the practitioner who draws the papers, for a case never fully reveals itself until put into a definite form; it is an eminent auxiliary in the analysis of the application in the Patent Office; and is almost indispensable in the distraction and flurry of the trial of a cause in court? Perhaps your case may never get into court? That is more probable than otherwise, if your case is believed to be impregnable, free from ambiguities, title clear. Why come to the Office for registration of a trade-mark, but with the view of arming for the conflict! You thereby apply the maxim, that the surest way to avoid war is to be always prepared for it. You do not come to the Patent Office for a trade-mark, for, as has repeatedly been said in this treatise, no power resides in this branch of the Government to grant one; but you do come to record the fact of your adoption of a mark, and bear away with you the evidence of your assertion of title to the sole use of a peculiar symbol. You shall have an adjudication upon the question,

¹ Tyler's Rules of Pleading, p. 50.

whether your supposed trade-mark is valid or not ; and that adjudication may be the means of closing the door to all strife. Your purpose is best subserved by adherence to form.

§ 569. The Office does not stickle for mere *technical form*, *i.e.*, form independent of the merits. It looks rather to substance ; and a high degree of artificiality is not desired. But we must remember that there is in legal contemplation no such thing as *form* without substance, or *substance* without form. We know, by experience, that the precedents enable us to embody all necessary allegations with ease and perspicuity. Thus are evolved upon the record the questions of law and of fact, so that they may all be exactly and intelligently met.

§ 570. The system of examination is this : The papers are inspected, to ascertain whether they are written in the English language, in a fair and legible hand, with all interlineations and erasures clearly marked in a marginal-note on the same sheet, and all other matters of form are looked into ; and, finally, all indispensable requisites of oath and allegations. The scrutiny may disclose some fault susceptible of amendment. If so, it is pointed out, and the paper perfected.

§ 571. The case is then taken up on its merits. Sometimes a course of special pleading is pursued, until the essential questions are met. The application-papers serve as a declaration, in lack of a defence to which the claim is passed for issue. Although the forms are few and simple, and the Office affords every reasonable facility for the curing of defects, a considerable degree of accuracy is quite necessary. He who has made himself familiar with the science of special pleading at common law, — little studied now-a-days for practical use, — as an aid to mental discipline, and as a system of logical devolution of the issues of a strictly legal controversy, will have an advantage over him who is slovenly in thought.

§ 572. The Office may plead in abatement, as for want of some material allegation. That having been cured by amendment, the case proceeds upon the law of the case. Admitting

all the facts alleged by the *prima facie* case, the Examiner takes exception to the legal right of the claimant; for it may be that — 1. His record discloses the fact that the applicant is not one of the persons, natural or artificial, included within the provisions of section 77 of the Act of Congress of July 8, 1870; 2. Or, that the proposed trade-mark is not sufficient in law, being merely indicative of quality, or consists of words common to the language, to which no one can claim an exclusive right of use, because not indicating origin or ownership; 3. Or, that the same symbol has already been appropriated by another person for the same class of goods, as is shown by records, or otherwise is known; 4. Or, that the right to claim protection by virtue of the act has expired by limitation, in the case provided for in section 78; 5. Or, that the proposed mark is calculated to deceive the public; 6. Or, that it is intended for use in an unlawful business; 7. Or, that the registration would be contrary to public policy, &c., all of which matters may be necessarily inferable from the language of the applicant. While it is not probable that he would set a trap to catch himself, he may, by telling all the truth, blunder into difficulties from which he cannot be extricated. He is estopped by his recitals. He has admitted too much, as will appear in suppositive cases hereafter.

§ 573. As the application-papers have the same purpose as a declaration in an action, the Office must *demur* or *plead* thereto. In not one of the cases given can it plead either by way of *traverse*, or of *confession and avoidance*; for there is nothing to take issue upon. The Examiner then demurs for insufficiency in *substance* and in *form*. The cases commented upon are *essentially insufficient*. They are also stated in an inartificial manner. The insufficiency may be excepted to in general terms, without showing specifically more than one insuperable objection. A single bullet may be as efficacious as a shower of missiles. But when the refusal to register amounts to nothing more than a plea in abatement, the Examiner aids the appli-

cant by specifying the grounds of objection, and gives as many hints and facilities for amending as can reasonably be expected. But as the peculiar province of this officer is at times misunderstood, it must be stated in this place, that he is not called upon to furnish gratuitous advice to any applicant who shall have paid the sum of twenty-five dollars into the public treasury.

§ 574. No. 129 of the Rules of Practice of the Patent Office is as applicable to a trade-mark as to a patent case. It is there provided that the Office cannot respond to inquiries as to novelty, in advance of an application, nor to inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether the same claim has been passed upon, and if so, in whose favor; nor can it act as an expounder of the law, nor as counsellor for individuals, except as to questions arising within the Office. These questions arising within the Office are those which legitimately spring from a case actually under consideration. The functions of the Examiner of Trade-marks are judicial in their nature. He is not an advocate or counsel.

§ 575. The applicant may join issue with the Office, and argue the law question raised, and produce judicial decisions as to the law; or he may introduce new evidence to sustain his title, and show that the decision was based upon a mistake of fact. For example, if his claim be rejected on the ground that he belongs to a country that does not allow similar privileges to citizens of the United States, he may suggest that there is a treaty or convention between his country and this, and the Office will take cognizance of any such fact that by accident might not have come to light; or he may take issue on the question of novelty; or admit that another person once had title, but that he had lost it by abandonment; or that the mark already registered is for a different class of goods; or that the foreign protection has not expired, as provided for in section 78 aforesaid; or he may, as best he can, meet any other objection. Of course, it would be entirely impossible to suggest the multiplicity of points that

may arise in the prosecution of a claim to the recognition of an exclusive right in a mark. Man is not a mere machine, but is a being of mind. He may be pumped full of law, but it will remain undigested, to slop over upon the least provocation, unless he bring to his aid the noble faculties of the soul, and think! He must have faith in what he does, for uncertainty destroys law.

§ 576. **Drawing and filing of Application.**—It is to be presumed that the applicant has a valid claim to the exclusive use of a symbol as his trade-mark, before he comes to the Patent Office. He consults the rules as to the employment of descriptive or generic terms, and satisfies himself that he has a right to a certain definite emblem, by priority of adoption in his particular business. If he follow the dictates of common sense, his case may be clear enough. He takes the approved forms, and modifies them, telling a plain, unvarnished tale, in as concise language as may express his meaning. Having separately signed each paper, with two witnesses to the specification and the drawing, and sworn to the declaration, the case is ready to be presented. If the specification be accompanied by an original drawing,—on a sheet ten by fifteen inches, having a light and simple single-line border one inch from the edge, leaving the “sight” exactly eight by thirteen inches,—there need not be fac-similes; for copies will be made therefrom by the photo-lithographic process, without charge, the same as in patent cases. But if the representation of the trade-mark be a print, it must be mounted and signed, so as to be convenient for placing in a portfolio; and *ten fac-similes* must be filed with it. (As to the particular manner of making the drawing, the reader is referred to the printed Rules of Practice of the Patent Office.)

§ 577. **Amendments.**—The power to amend application-papers is limited. If this were not so, all the material facts and allegations might be so varied from the original statement as to entirely change its character. After a first rejection, the

applicant generally has a right to amend; but this is not always so; for the sworn papers may bear upon their face the most conclusive evidence of fraud, and a party be estopped from contradicting his own allegations. A rejection under circumstances which display a lack of good faith may be regarded as final. Suppose, as frequently happens, the applicant show that he is endeavoring to usurp the credit that belongs to a rival trader, by a servile imitation of his mark, he cannot well complain if he is refused a second hearing. Yet, if there be any reasonable doubt of guilty intent, and if there be ground for supposing the imitation to be the result of an innocent coincidence, he would be permitted to explain, and to amend.

§ 578. No amendment is permitted to enlarge the scope of the claim, unless upon supplemental oath. Solicitors of experience have, in many instances, so far disregarded the spirit and reason of this rule as to completely transform the original case. The papers are found to be deficient in essential averments. Citizenship, domicile, residence, place of business, description of the mark, the length of time it has been used, manner of applying it to goods, &c., have not been properly set forth. The solicitor mechanically draws an amendment, striking out this and inserting that, with the greatest recklessness of consequences. He sometimes attempts to amend the sworn declaration, usually termed the *oath*, by substituting words, or adding new allegations. He does not stop to think that he is thereby perverting the evidence, and that he might as well interpolate new statements in a deposition after execution, or words in a deed after delivery. Nor does he pause to reflect that such irregularities completely vitiate a case, and virtually destroy all the value of registration, and leave it without efficacy. A court is bound to adjudge a certificate to be void, when the record shows it to have been granted upon falsehood, or disregard of the sanctity of an oath. Even if the new matter in an affidavit be in fact true, it is in effect false,

unless properly sworn to. But suppose that no such glaring irregularity has been committed, and that so far as form is concerned the party has sworn to his amendment, even then he *may* be refused a favorable consideration; for he is not entitled upon the payment of a single fee to the judgment of the Office upon two different cases.¹ If he discover that his claim to the exclusive use of one symbol has been anticipated by some other person, he cannot be allowed to amend by substituting another symbol as his mark. That would be authority for ringing all the changes, and confining the attention of the Office to a single case.

§ 579. All amendments must be made on separate sheets of paper from the original, and must be filed with the chief clerk of the Patent Office, who will cause them to be duly marked with the stamp, showing the date of reception. It is irregular to file an amendment with the Examiner, or to change the original record by erasures, interlineations, or marginal-notes. A looseness of practice in this respect once put the Office to serious trouble, and enabled a roguish solicitor to perpetrate great wrongs; while a strictness of practice in another respect brought condign punishment upon the head of the culprit, and excluded him from the Office. It must appear by the file *when, how, and by whom* an amendment has been made.

§ 580. **Design of Oath.**—To secure faithfulness, and elicit truthful testimony, is not the only design of the oath. It is also intended to produce *confidence* in regard to the thing sworn to. It is designed to produce an effect, not only upon the person sworn, but also upon them to whom the oath is made. *Confidence* amongst the members of society is indispensable to social comfort. Suspicion and doubt and distrust are the bane of social peace.² The statute intends that this oath for *confirmation* shall be an end of all strife. So it would be, if implicit faith could be reposed in it. As it is, it

¹ Case of J. C. Cooke, Commissioner's Decisions, 1871, p. 312.

² See that admirable book, Junkin on the Oath.

can be only presumptive. What becomes of confidence, when an examination of the original file in the Patent Office discloses the fact that the sworn declaration has been tampered with; that after the oath has been administered interpolations have been made, and erasures and interlineations have materially changed the meaning of important allegations! The pen which traces these words has just spread upon paper as follows: "The applicant, by his attorney, proposes to amend the application-papers by adding to the affidavit certain facts which were not sworn to, *i.e.*, to make a person appear to have sworn to matters which he did *not* swear to. The proposition cannot be acceded to." The attorney referred to is a highly reputable member of his profession. If he could so glibly pass over such a contempt of the sacredness of an oath, what might not be expected from one who has no fear of the justice of the God of truth! The same attempt to pervert the oath is daily made in the Patent Office. How, oftentimes with success, need not be told. Suffice it to say that if the paper bearing the record stultifies itself, the registration is a nullity. The worshipper at the shrine of Mammon, who thinks gold more valuable than the invisible things of a man, — peace, probity, and purity, — may administer or take an oath with the indifference of an auctioneer selling goods; but he should take care that his record is plainly written, for the acute counsel in a trial in court will take it to pieces as one might a watch or other machine.

§ 581. **Prima Facie Right to Mark.** — The Office will not always question the right of the applicant to the use of a certain mark, although there may be circumstances of a dubious nature. Cases there are in which statements not strictly true may readily be corrected. Thus, in the following case, the oath of a party was deemed of sufficient weight to remove all doubt of the right to use the name, &c., of a foreign house. The mark, which is for brandy-bottle caps, is described as consisting of a circular colored border surrounding a white or metallic ground

containing a coiled belt or band consisting of two circles, with a vertical bar with buckle or fastening device, surmounted by a crown, and inclosing the letters "O. D.," the "O" being on the left of the bar and the "D" on the right. Within the border, and forming a semicircle above the crown, are the words "Otard, Dupuy, & Co.," and at the bottom of the white ground beneath the circles is the word "Cognac." In the space between the words "Otard, Dupuy, & Co." and "Cognac" are two stars. There was a momentary hesitation on the part of the Examiner. He asked himself, Have the applicants a right to use the name of the French firm? May not this mark, without some qualification to show its origin in this country, be apt to mislead the public? May this mark not prove to be an exact fac-simile of that of the foreign house? How can a license to use it be presumed? Is this proposed mark to be affixed to the genuine imported brandy? The records of the Office show that, some months earlier than the date of the pending application, the same applicants had obtained registration of a mark for liquors exported or sold by Otard, Dupuy, & Co., of Cognac, France, in which matter the applicants are described as agents for said house. The registered mark (No. 739) and that which was then pending are, in legal effect, nearly identical. *Conclusion*: The foreign house has a large trade with this country, and therefore may be presumed to jealously guard against encroachments upon rights which are allied to those of their customers. They may easily protect themselves in the courts. Besides, the applicants are in a line of business in which they have many vigilant competitors. If, by any possibility, there be error, it can readily be rectified. A *primâ facie* case has been made out. Registration allowed.¹

§ 582. The Examiner sees enough to put him on inquiry. A single word, perhaps, is submitted as the essence of the mark. A single word,—but how much may that single word contain! A word may be a wonderfully-involved bud, which, when

¹ Cazade & Crooks, No. 993.

breathed upon, unfolds and develops a complexity of ideas. It may be as simple in appearance as an acorn, and yet enclose interests as wide-spreading as the roots and branches of an oak, with ramifications touching the business-matters of a myriad of persons. Take as an example the word "Chartreux" (signifying a Carthusian friar), which for many years, in a multiplicity of suits, has figured before the courts of France. One of the infringers had taken the feminine form of the word. Of that, the Court of Cassation said, in 1872:¹ The word "Chartreuse," applied as a denomination to the *liqueur* manufactured by the religious community of which the Père Garnier is the representative, is but an abbreviation and the equivalent of a designation more complete: for it at once indicates *the name of the fabricants* (the Chartreux); *the name or commercial firm of manufacture*, which is no other than the community of these same Chartreux; and, finally, *the place of manufacture*, that is to say, the monastery of "la grande Chartreuse." — That single word contains a long history of strife. It has repeatedly been held to be a perfect trade-mark, for the reasons just cited. The spoken word, "Chartreuse," is the symbol of the mental conception: the written word is the symbol of that symbol. The arbitrary sound of the voice is intimately combined with the conceptions of the mind, and the arbitrary vocal symbol is cemented with another symbol still more arbitrary, addressed to the sight. The symbol excites in other minds the invisible and intangible thoughts that it was meant to call up, by the association of ideas.

§ 583. *Indefiniteness.* — A so-called description of a trade-mark may be so indefinite as really not to convey the least idea of the intention of the applicant; as when, in an elastic-suspender case, the mark which was said to consist of a man's face printed or stamped on the front side or surface of the suspender, near the front end, — had been generally applied, as read the specification, "with some sort of ornamented design,

¹ *Le Père Louis Garnier v. Paul Garnier*, Ann. de la Prop., tome xvii. p. 257.

printed above and below the figure, with the name of the person represented by the picture under it, as shown. But the ornamented design, on the top or bottom, or at both places, may be omitted, or some other design substituted for that shown, and the *name* of the person whose likeness is printed on the suspender may be omitted, without materially changing the character of my trade-mark; the essential feature of which is, the picture of a person printed upon the face of the web or fabric." The applicant claimed that these two peculiarities were gained, viz.: 1. A picture — on the front of the suspender — of some personage of national or historic reputation of notoriety; 2. Having a face on the web, which is generally more or less elastic, the expression of which may be varied by stretching the material. The applicant also stated that he proposed "to change the likeness given in the picture, as expediency may require." To this the Examiner, after pointing out the contradictory recitals of the specification, ended his decision thus, — "COMMENT: This case presents none of the characteristics of the fixed, invariable, unmistakable, definite symbol termed a trade-mark."

§ 584. The reader can for himself analyze this specification. What was claimed? A man's face, *any* man's face, and that face to be changed at pleasure. But even the lineaments of that face were not to be permitted to remain in placidity; for being printed upon elastic suspenders, the features would be contorted by each strain upon the webbing. But then, there was an ornamental design above and below the face, and the name of the person whose face was represented! True, but the ornament and name were both dispensed with at the will of the manufacturer. In a suit for infringement of a trade-mark evidenced by such a specification, how could conviction of imitation possibly follow? If such a broad claim were inadvertently allowed to escape the scrutiny of the Office upon an *ex parte* showing, it could not possibly form the basis of any judicial demand. And yet this very specification had been

drawn by an experienced patent lawyer, who had not become imbued with the subtle refinements of the law of trade-marks. He for a while refused to be comforted, and appealed; but, upon maturer consideration, he amended his specification and obtained a certificate of registry.¹

§ 585. We cannot always be guided by the verbal description of the colors which may be essential elements of a trade-mark, or may be the ground of the label bearing it. Endless confusion would result unless we were permitted to lay the conflicting marks or labels side-by-side, and inspect for ourselves. What court or jury would rely upon witnesses in such a matter? for they may honestly disagree in attempting to impart to the mind of another an intelligible idea of colors and shades. A writer² on this subject says: "What idea is conveyed to the mind by the mere mention of a red, or a blue color? A scarlet coat is called red; and the term 'red' is applied to a rose, a brick, port-wine, mulberries, cherries, and other things of very different hues: the sky, a violet, a slate, and a steel helmet, are called blue; and the Arabs, who apply 'green' to a mouse-colored horse as well as to a copper-colored Abyssinian, call jet-black '*blue*;' and their 'blue horse' may mean one of jet-black, or iron-gray color. In like manner the Welsh *glas*, 'blue,' or 'green,' is applied to black (provided it has no brown tinge); and gray is also called 'blue' (*glas*), — hence *glastum*, a name of woad." When we come to tints, the mind is lost in a maze. The Roman artists say that more than 30,000 tints are used in mosaic. A slight variation in the colors employed in a mark for goods may change its whole aspect, just as a deepening of the natural shade of eyebrows, or the addition of a few bits of court-plaster, may so change the facial expression of a fair lady as to make us doubt her identity. In a trade-mark there must be no doubt. To judge of an alleged similarity between two trade-marks, we must place them together. If

¹ James Twamley, No. 860.

² Sir J. Gardner Wilkinson, "On Color," &c. London, 1858.

calculated to create confusion, one is an infringement upon the other; but if the public can readily distinguish between them upon a casual inspection, there is no confusion. Let us take a case.¹ The applicants say that the design shown in the drawing is a true copy of their trade-mark for base-balls. We see the representation of a red ball, with an imitation of its seams, and we read the words "Dead Red Ball," the name of the firm of the applicants, and a description of the weight and circumference of the real ball. What is the essential feature of the mark? We are not told in the specification. Any one who has a right to make the article (a base-ball), may lawfully make a picture of it; and there is no pretence that the applicants have a monopoly. What guides the purchaser in his selection? It is the *red* color of the ball, more than the words. Then the red ball is the trade-mark, if any thing in the whole design comes up to the requirements of the law. That being the case, no one else has a right to the same mark for the class of goods to which this is applied. But any person is at liberty to use a blue ball, or a green ball, or indeed one of any color or shade that could not be mistaken for that described. The shape is not a mark in this case. Nor was it in the case of *Ricque et als. v. Forge et al.*,² in the Court of Paris, in 1861, where the plaintiffs' mark consisted of four *rose*-colored threads as a border for their drillings, and the defendants adopted a bordering of two *red* threads, wherefore they were adjudged to be counterfeiters. Now, in either of these cases, witnesses might well disagree in naming the peculiar color used. What is *red* and what is *rose-color*? The necessity of ocular examination is obvious.

§ 586. **Breadth of Claim.** — This matter is entitled to more consideration than it usually receives from applicants. Things material are so united with things immaterial as to detract greatly from the value of a mark. Sometimes so great ingenuity

¹ Peck & Snyder, No. 46.

² *Annales de la Prop.*, tome viii. p. 25.

seems to have been exercised to narrow down a claim, that one cannot but wonder at the folly. When a broad claim can be maintained for a word, for example, why encumber it with a collection of other words? Look at the consequences in case of encroachment upon the mark. The word is so hedged about by unimportant things, devices, or words, that it is almost impossible to convict of counterfeiting. The name of a firm, or of the place of manufacture, the term "warranted," and other words not really any part of the mark sought to be protected, detract from its strength; and the pirate finds a sure refuge behind the veil of uncertainty.

§ 587. Suppose, for the sake of argument, that the essence of the trade-mark is the word "Anchor." By the time that a superior description of goods may have obtained a solid reputation in the market, and the word "Anchor" as an arbitrary symbol is the only thing that the purchaser looks at to assure himself of the genuineness of manufacture, an imitator appears. He is sued for infringement. He defends himself upon the plea that the mark described by the plaintiff is so indefinite that he could not make it mean any thing in particular; and that as he took but a single word out of many words used in the mark of his rival, he cannot be deemed guilty of encroachment upon his rights. Upon inspection of the mark of the plaintiff, as registered, it is found that the word "Anchor," although it was that only that he desired to protect, is preceded and followed by the name of the party, his place of business, and the announcement that his wares are the justly-celebrated, world-renowned, best-class goods. He is taught a lesson. He learns that in this instance simplicity is strength. His complaint is dismissed. Nor is that always the worst result. He finds that while he has nothing but an elaborate mark, which is entirely worthless, his triumphant adversary has established a right to the exclusive use of the simple, yet valuable word "Anchor." The evil could have been avoided by the simple averment in his specification that the essential element of his

mark consisted of that one word. A lack of precision of phraseology may destroy trade, the soul of which often depends upon the recognition of a symbol. "A word fitly spoken is like apples of gold in pictures of silver." The declaration in an action on the case requires no greater discrimination in the use of the exact word than does a specification.

§ 588. The claimant of protection for an alleged trade-mark may, by too great breadth, dissipate all his pretensions, and thwart his own object. By attempting to grasp too much at once, he puts himself in the position of the greedy boy with the apples, and is left empty-handed. The representation of an object, a word, or emblem does not become a trade-mark until actually associated with a particular description of goods. How can a man hope to make a claim broad enough to cover all the merchandise in creation? Or how can he even think that a device can be set forth to cover a hundred forms of the same thing, — as "an eagle in any form or position;"¹ or "a crown of any desired form, style, or kind, whether of the shape usually known as a royal crown, or as a ducal crown, or otherwise?"² The representations of eagles and of crowns are almost infinite in number. In the latter case, the applicants averred that they had already registered one form of a crown for the same class of goods; and that now, by way of precaution, and in order to avoid any question as to the meaning and scope of their former description, they desired to include all other crowns. The answer was, that the claim was too indefinite, and in fact was anticipated by the former case of the same parties. The opinion was also volunteered, that the applicants were protected against the use by wrong-doers of any device substantially the same as that already registered, or so nearly resembling it as to be calculated to deceive. This *dictum* correctly states the law.

§ 589. A case like this could not be recognized as entitled to

¹ H. M. Rowe & Co., *ex parte*.

² Thompson, Langdon, & Co., *ex parte*.

registration, or as sufficient foundation for any redress under the law peculiar to trade-marks: "The mark consists of a tattooed initial letter, which may be any letter of the alphabet, stamped upon the upper-crust of the pie; as, for instance, the letter A will stand for apple; B for blackberry; C for currant, &c. Below this single initial we stamp the letters 'C. P. B.,' standing for Connecticut Pie Bakery."¹

§ 590. One of the most remarkable applications ever filed was as follows: The claimant² represented that he was doing business under the name and style of the "New Era Company," in the city of New York, and was engaged in the publication and distribution of books, papers, and tracts; and also in the manufacture and sale of various articles of use, consisting *in part* of tacks, nails, locks, bolts, butts, saws, files, axes, hammers, bits, augers, planes and plane-irons, shears, scissors, pocket and table cutlery, spoons, lemon-squeezers, pins, needles, slates, hay and manure forks, hoes, spades, shovels, rakes, scythes, plows, carpet-stretchers, tack-claws, apple-parers, cherry-pitters, stove-polish, silver and plated ware, gold and silver watches and jewelry, and general cast and wrought hardware. He desired, therefore, to register as his trade-mark for said goods a star, with the words "New Age" in the centre, &c. The decision of the Special Examiner reads thus: Such an *omnium gatherum* was never contemplated as a subject of a trade-mark. Not more than one class of merchandise can be included in a single application, while this case may embrace forty thousand most incongruous things. It is not understood how one person can constitute, by himself, the "New Era Company." This requires explanation. . . . Case suspended for reconstruction.

§ 591. Degree of Specificness. — This no rule can designate, except in a general way. It is a rule, that *the declaration must state every thing that is of the essence of the cause of action; and that is of the essence of the cause of action, without which judgment cannot be given.* The dropping of a word

¹ Case & Martin, *ex parte*.

² W. M. Evans, *ex parte*.

may be the drawing of a rivet upon which depends the whole case. Omit any of the conditions precedent, and the Office has no jurisdiction. For example, *domicile* of a person or firm in the United States is in some cases required by section 77 of the Act;* and therefore is a necessary averment. In case of a corporate applicant, the exact name thereof, and the authority giving it existence, should be averred. So, also, of residence and place of business, and of many other facts. But surplusage is to be avoided. When the applicant is a resident of or located in a foreign country, it is not necessary to allege the existence of a treaty or convention of reciprocity; for official notice will be taken of all such matters.

§ 592. It will not be a waste of time to analyze the following hypothetical application-papers. Every fault indicated has been committed by one applicant or another, while sometimes a single case is found to be marvellously replete with errors. This is not the curious workmanship of a precisian, but a truthful exemplification of every-day practice. Bear in mind that these are FALSE MODELS, *not to be followed*.

PETITION FOR REGISTRATION.

To the Commissioner of Patents:

The petition of Antonio Gomez respectfully represents, that he is the senior member¹ of the firm of Gomez & Romero, engaged in the manufacture and sale of brandy and other liquors at the city and county of New Orleans,² Louisiana.

That he alone and with others and the said firm³ have used⁴ trade-marks⁵

* July 8, 1870.

¹ Irrelevant. The application is made on his individual behalf, and not as a member of a firm.

² No such county. * It should be, "Parish of Orleans."

³ Such phraseology would be incredible, if the real application from which it is copied were not before the writer. A symbol cannot serve as a trade-mark, unless the right to its use be *exclusive*.

⁴ When?—for how long a time? (See subsection fourth of sec. 77 of the Act of July 8, 1870.)

⁵ Not more than one trade-mark can be embraced by a single application. This error is of frequent occurrence.

for said articles,⁶ which trade-marks consist of the printed labels⁷ herewith filed,⁸ or substantial copies⁹ thereof. No. 1, containing the words, "OTARD, DUPUY, & Co., COGNAC," surmounted by a ducal crown and the letters "OD" inside of a circular representation of a strap or belt, is to be applied to our manufacture¹⁰ of brandy.¹¹ This is an excellent imitation of the imported article, is chemically pure, and medicinal,¹² and is generally pronounced by good judges to be superior to that brought from Europe.¹³ The names "Otard, Dupuy, & Co." are only used as a fanciful emblem, and have no intention to mislead as to origin;¹⁴ and indeed our label differs in several particulars from any label used by any such concern.¹⁵ Nos. 2, 3, 4, and 5, containing the names of different kinds of liquors,¹⁶ are intended to be applied as indicated.

He further represents that no other person, firm, or corporation has a right to the use of said trade-marks, or of any substantially the same,¹⁷ or so nearly resembling them as to deceive the public.¹⁸

⁶ The words "said articles" include brandy and other liquors; but to what number, and of what kinds, we are not informed by the papers in the case. Nor need we care to know. Subsection second of said section 77 calls for a statement of "the class of merchandise and the particular description of goods comprised in such class." *One class*, and no more, is contemplated by the statute.

⁷ Labels are not trade-marks, but, as we have before seen, are merely vehicles for trade-marks.

⁸ A full verbal description is in all cases required; so that the specification, when it shall have been printed, may sufficiently identify the trade-mark claimed, without compelling recourse to drawings, or other extraneous matters, which may become detached.

⁹ "Substantial copies!" Such words throw the mind into a state of still deeper uncertainty. A copy must be a fac-simile, an exact counterpart.

¹⁰ This is an admission of atrocious piracy. The intent to deceive the public, for the sake of dishonest gain, is too manifest to admit of doubt.

¹¹ It is not even brandy, but an imitation of brandy for a fraudulent purpose.

¹² Surplusage, even if true. *Falsus in uno, falsus in omnibus*,—false in one particular, false in all.

¹³ It is not allowable to deceive the public, even for their own benefit.

¹⁴ False upon its face! Why take the name of a reputable house, but for a vile purpose? Thucydides declared that a fraud cloaked with a specious pretence reflects infinitely greater dishonor than open violence; because the latter is the effect of the power which fortune has conferred, and the former is founded wholly in perfidy, which is the pest of society.

¹⁵ An admission of an attempt at evasion.

¹⁶ Even if more than one kind of liquor could regularly be embraced by the same application, this mention of "liquors" would be too indefinite.

¹⁷ The language of subsection seventh of the statute must be more fully followed.

¹⁸ The law says, "as might be calculated to deceive."

He therefore prays that the said lawful trade-marks ¹⁹ may be granted ²⁰ to him, as by law provided.

ANTONIO GOMEZ.

AFFIDAVIT.

State of Louisiana, }
 Parish of Orleans, } ss.
 City of New Orleans. }

Antonio Gomez, being sworn, says that the foregoing statement by him subscribed is true in substance and in fact, as he verily believes; and that he and his partner reside at Havana, in the Island of Cuba, and are subjects of the king of Spain.²¹

NAPOLEON JONES, *Notary Public.*²

§ 593. We have thus penned a simple-looking set of application-papers, in which almost every rule of law and of practice has been violated. The petition and the specification have been jumbled into one; doubt has been created from the start as to whether the applicant claimed for himself or for his firm; and the description of the mark, or marks, has been left so undecided as to leave no ground for action. Such faults could have been cured by amendment, *i.e.*, by a reconstruction of the case. But there are manifestations of fraud, which instantly shut the door to all further consideration, and estop the applicant from retractation or amendment. The want of domicile is sufficient for the purpose of rejection. The case dies without a hope of revival. Unhappily for justice, no punishment can be inflicted upon the flagitious wrong-doer beyond the loss of the fee paid in. We will next examine the application of a firm, or a corporation (we are at a loss to say which).

¹⁹ A misnomer, as is evident from the circumstances.

²⁰ The Patent Office has no power to *grant* trade-marks. It receives and records them, and issues a certificate of registry. It has no creative power.

²¹ It gives some degree of satisfaction to learn from the applicant that he has no legal standing before this tribunal. Neither he nor his firm is domiciled in the United States, nor is there any treaty or convention between Spain and this country which gives the application a right to be entertained.

²² The notary has omitted to affix his official seal, which is indispensable under the Act of Congress of Sept. 16, 1850. No State regulation can affect this positive requirement. *A verbis legis non est recedendum.* (See Patent Office rule 10.)

PETITION FOR REGISTRATION.

To the Commissioner of Patents :

Your petitioners¹ respectfully represent, that the Union Land Company,² composed of A. Bell, Ch. Dolan, Ed. Foy, G. Ham, and I. K. Lane,³ is engaged in the manufacture⁴ of pamphlets and circulars to advertise their business⁵ as a land-improvement concern,⁶ at Baltimore County,⁷ Maryland, and are entitled⁸ to the exclusive use upon the said articles manufactured by them of the trade-mark described in the specification and accompanying labels,⁹ said trade-mark having been duly assigned to them,¹⁰ for a valid consideration paid by said company to the original designer and inventor thereof.¹¹

¹ One glance of the eye shows that there is but a single petitioner.

² The meaning of this word as here used is not apparent. It may be intended to indicate a corporation, or a firm. If the former, the application should be made by the corporation through its proper officers; and it should appear whether the incorporation was by authority of the United States, or of any State or Territory thereof, &c., as directed by sec. 77 of the Act of July 8, 1870. If a corporation, the names of the corporators should not be alleged.

³ When names of persons are used, the same should be stated in full, mere initials not being names in law. (See Patent Office rule 17.)

⁴ "*Engaged in the manufacture.*" This recital is not sufficiently comprehensive. The manufacture may be gratuitous, and indeed turns out to be, in this instance. If it be intended to imply mercantile operations, the words "*and sale*" would make the purpose clear. A symbol cannot possibly be a trade-mark unless in some mode attached to merchandise.

⁵ "*Pamphlets and circulars to advertise their business.*" All idea of the emblem of trade is at once dispelled.

⁶ A land-improvement concern can hardly be supposed to vend goods, wares, and merchandise.

⁷ Unhappily worded, to say the least.

⁸ In what capacity?—as individuals, firm, or corporation?

⁹ "*Labels*" should be struck out, and "*fac-similes*" substituted.

¹⁰ Where a party claims by *assignment or alienation*, the nature of the conveyance and alienation should be stated (Stephen on Pleading, 304, 311, 436). Either a certified copy of the assignment should be attached to the application-papers; or, if the same shall have been filed in the Office, a suitable reference should be made to it. Especially is it necessary to be introduced as an exhibit in this case, to show whether the transfer was made to *it*, the company, or to *them*, the individuals. If assigned to *them*, it seems that the *company* paid the consideration. Misty enough!

¹¹ An inventor has not any property in a design, unless it is patented as an adjunct of a manufacture. Actual use is the criterion of adoption of a symbol as a trade-mark. Intellectual conception has nothing to do with a mark, as an emblem of commerce. No title could therefore be deduced from "the original designer and inventor."

They therefore pray that the said company may be permitted to obtain protection¹² for said trade-mark, and letters-patent, or a copyright therefor,¹³ under the law in such case made and provided: And they¹⁴ do hereby appoint Simon Shallow, of said Baltimore, or his substitute,¹⁵ their true and lawful attorney, to make all necessary alterations and amendments¹⁶ in and to said trade-mark to receive the protection,¹⁷ and to transact all business in the Patent Office connected therewith.

18

A. BELL, *President*.¹⁹

§ 594. Specification describing a trade-mark for pamphlets and circulars used by the "Union Land Improvement Company,"²⁰ of Baltimore, Md.

Our trade-mark consists of the design²¹ as fully represented and described in the annexed cut or drawing,²² composed in part of the words "Union Land Company" with our initials²³ on a shield; but the said shield and initials may be omitted, or any other design be substituted therefor, or *vice-versa*.²⁴

¹² If *it*, the company in its aggregate capacity, *i.e.*, as a corporation, is to obtain protection, it must be only upon the application of its proper officers.

¹³ Neither letters-patent nor a copyright can apply to a trade-mark case.

¹⁴ *They* do not appoint, for the paper is signed by but one, who styles himself "President."

¹⁵ At all events, the *substitute* could not be appointed except by Simon Shallow.

¹⁶ No alterations or amendments can be made in a trade-mark without destroying its identity. If altered, it becomes something else.

¹⁷ Meaning the certificate of registry.

¹⁸ The necessary internal-revenue stamp, required in case of the appointment of an attorney-in-fact, not having been attached, Mr. Shallow cannot be recognized as such. (The stamp is not necessary in cases filed on the 1st of October, 1872, and thereafter.)

¹⁹ If this really is meant for an appointment by an incorporated company, the conclusion should be somewhat thus: "Witness the seal of said corporation, and the signature of its president, at Such-a-place, in the county of Baltimore, and State of Maryland, this 8th day of October, A.D. 1871." (See form 47, Rules of Practice of the Patent Office.)

²⁰ The true name should be given. There is a repugnance to the title previously stated.

²¹ A trade-mark cannot correctly be said to consist of a design.

²² Which is it? — a cut or a drawing? Inspection shows that it is neither, but a stencilling.

²³ Whose initials?

²⁴ We nearly despair of a solution of this enigma.

The most²⁵ essential features of this trade-mark are the words mentioned, and the shield when used,²⁶ together with the advertisement²⁷ of the company, and notices of the valuation of building-sites, &c.; but these or any of them may be varied or omitted according to circumstances.²⁸

This trade-mark, consisting of the parts described, we have used in our business of publishing for some time past, and with good effect.²⁹ The particular class of goods upon which said company has used,³⁰ and still continues to use said trade-mark, consists of pamphlets and circulars,³¹ in addition to our signs and cards.³² We have been accustomed³³ to brand it with a stencil-plate and black ink on packages of circulars and pamphlets sent to our various agents, or print it on the faces of the same³⁴ with the usual printing-ink.

A. BELL, *President.*

Witness: I. K. LANE.³⁵

AFFIDAVIT.

Commonwealth of Maryland,³⁶ }
City & County of Baltimore.³⁷ } ss.

Personally appeared before me, a justice of the peace in and for said city and county, the said A. Bell,³⁸ who, being duly sworn, doth depose and say that he is an officer of said company within mentioned;³⁹ that they⁴⁰ have

²⁵ The word "most" must be eliminated.

²⁶ How can it be essential at all, if it may be dispensed with?

²⁷ An advertisement cannot enter into a trade-mark.

²⁸ Sheer nonsense.

²⁹ Surplusage.

³⁰ For how long a time? (Subsection fourth of sec. 77 of the Act aforementioned.)

³¹ We have already seen that these pamphlets and circulars are used as mere advertisements.

³² "Signs and cards." Are these merchandise?

³³ How now applied and used?

³⁴ It would be hypercritical to say that the last antecedent is the word "agents."

³⁵ Two witnesses are required. *Query*, — Is not this witness the person named in the petition as a party?

³⁶ Should be "State of Maryland." (See Constitution of same.)

³⁷ The city and the county of Baltimore are different jurisdictions, the city not being in the county proper, but being itself a borough with county powers. This oath could not have been taken in both city and county. This error has been committed a number of times in trade-mark applications, being generally attributable to recklessness on the part of agents, or self-appointed solicitors. The oath must be discarded.

³⁸ Full name required.

³⁹ He fails still to state that it is a corporation.

⁴⁰ This implies a lack of incorporation.

the right to the use of the trade-mark described, and that no other person, firm, or corporation has a right to the same⁴¹ or any part thereof;⁴² that the description and fac-simile presented for record are true copies⁴³ of our trade-mark; and he further says that he is domiciled in and is a citizen of the said State.⁴⁴

ADAM YOUNG,⁴⁵ *J. P.*⁴⁶

§ 595. Examples equally vicious may be drawn in an almost infinite variety from cases actually filed in the Patent Office. Brief and comprehensive as are the approved forms, and intelligible as they must seem to be to any one possessing a modicum of sense, they are constantly made the sport of a spirit of misunderstanding. Instead of a terse style of allegation, involving a strict retrenchment of unnecessary words, — which is the aim of the best practitioners in pleading,* — we behold extraneous matter, recklessness of allegation, inconsistencies, ingenuity of falsehood. All of the errors of the preceding cases have not been pointed out; but sufficient have been displayed to convince us of the necessity of thought and caution in drafting a simple set of papers.

§ 596. In view of the fact that all action in the Patent Office is taken only to pave the road for possible ulterior proceedings in law or in equity, too much caution cannot be observed in declaring the title. The metes and bounds of a field must all be carefully defined, before a person can be charged with encroachment thereon. Therefore, any thing which does not possess all the essential characteristics of a trade-mark, under

⁴¹ This should read, — “a right to the *use* of the same.”

⁴² This is too sweeping an assertion.

⁴³ A *description* cannot well be termed a *copy*.

⁴⁴ It is sometimes the fact that a person is a citizen of a State while not of the United States. The regulation made by the Commissioner of Patents on the 29th of February, 1872, reads: “The form of oath for application for registration of a trade-mark will hereafter contain a statement of what country the applicant is a citizen, the same as in patent cases.”

⁴⁵ No date to the jurat, not fatal, but an irregularity.

⁴⁶ This officer, who improperly abbreviates his title to “*J. P.*,” leaves us in the dark as to the question of his jurisdiction. He cannot be a justice of the peace for both Baltimore city and Baltimore county.

* Stephen on Pleading, 424.

the universally-accepted rules of commerce, cannot receive recognition. A thing must exist before it can be acknowledged. If the proposed mark be merely indicative of quality, it must fall to the ground. Yet this truth is slow in obtaining credit. It was thought that the legal advisors who, in 1859, contended that the term "Schiedam Schnapps" ¹ constituted a valid trade-mark would long since have abandoned that fallacious idea; but the position taken at the trial of a very recent cause ² implies the contrary. In the Supreme Court of New York, October 14, 1872, at special term, the matter was again decided. It appears that, at about a year before that day, the plaintiffs commenced the sale of an article of gin manufactured by them under the name of "HUDSON G. WOLFE'S BELL SCHNAPPS." The defendant, a corporation succeeding to the rights of the late Udolpho Wolfe claimed this name to be an infringement of its trade-mark, viz.: "UDOLPHO WOLFE'S AROMATIC SCHIEDAM SCHNAPPS." The defendant, by its agents, threatened the plaintiffs with prosecution, and sent circulars with a similar threat to their customers throughout the country. The latter were in many instances intimidated thereby. The plaintiffs thereupon brought suit against "The Udolpho Wolfe Company," and asked an injunction to restrain the defendant from thus interfering with their business. A preliminary injunction was granted by Gilbert, J. The question upon the hearing was this: Did the plaintiffs by their use of the words before-mentioned violate any right of the defendant? Pratt, J., who heard the cause, said, *inter alia*: "The evidence taken convinces me that, prior to 1848, the word 'Schnapps' had become a portion of our common language, and was used to denote either gin or a class of articles of which gin is one. The question of law arising on these facts is a narrow one, and has been several times decided. . . . The reason of the rule is obvious, — the language

¹ Wolfe v. Goulard, 18 H. v. Pr. R. 64.

² Hudson G. Wolfe, et als. v. Udolpho Wolfe Co., Off. Gaz., vol. ii. p. 441.

might otherwise be impoverished, and the community be exposed to inconvenience without any corresponding benefit. It follows from these views that the plaintiffs must have judgment in their favor." This decision maintains two points. 1st. That the defendant had no valid mark in the collocation of words mentioned. 2d. That the plaintiffs have a valid mark in theirs. It was not necessary for the purposes of the suit that the learned judge should go further, or he might have truly said that the word "Bell" is the essential part of the mark. In the former suit, it was admitted in argument that the word "Schiedam," being the name of a town in Holland, could not be appropriated by the plaintiff, and that the word "Schnapps" was a word adopted from the German language, meaning a dram.

§ 597. Just as worthless for the purpose of constituting trade-marks are such words as "Old London Dock Gin;"¹ or "Prize Medal, 1862;"² or "Yankee Soap"³ (which a judge in 1863, through mistaking the scope of the decision in another case,⁴ declared to be a trade-mark to which the plaintiff had an exclusive right). So in the "Moline Plow" case, in the Supreme Court of Illinois, in 1870, where the manufacturers branded upon their plows, for the purpose of designating the size, shape, and quality of the different grades, respectively, certain letters and figures in combinations as follows: "A No. 1," "AX No. 1," "No. 1," "AX No. 11," "B No. 1," &c., it was held that no exclusive right to their use existed; but that they could be used by any other manufacturer of the same articles.⁵ And so in the case of *Stokes v. Landgraff*,⁶ where certain words and figures were employed to designate the size and quality of glass. The "English's Broom" matter is also in the same category,⁷ and so are also many other cases

¹ *Binninger v. Wattles*, 28 How. Pr. R. 206.

² *Batty v. Hill*, 84 T. R. (N.S.) 791.

³ *Williams v. Spence*, 25 How. Pr. R. 366.

⁴ *Williams v. Johnson*, 2 Bos. 1.

⁵ *Candee, Swan, & Co. v. Deere & Co.*, 54 Ill. 439.

⁶ §§ 157-160, *ante*.

⁷ §§ 162, 163, *ante*.

to be found in close proximity to it in this book, and all designating the mere quality of the merchandise to which they were affixed, or being necessary names and common phrases which all persons have a right to use.

§ 598. In the Court of Lyons, in 1866 (*Chabrier v. Peillon*¹), came up a suit involving a question similar to that which arose in the subsequent "Akron"² and "Lackawanna"³ cases in this country. On the banks of the Rhone, in the environs of Seyssel, exists a natural repository of asphaltum. To distinguish it from many mineral deposits of the same kind situated in other parts of France, the usage has been to attach the denomination of "ASPHALTE DE SEYSSEL." The court *held*: Considering that this is a denomination of region adopted in the language of mineralogists and in the usages of industry, said denomination cannot become the subject of an exclusive right of property for asphaltum extracted from a particular place of deposit. That names of locality, simple geographical expressions, are common property, and can be employed with equal right by all interested in using the designation is well-established as law. The claim of the plaintiff was accordingly rejected. This is the principle that governed the Office in the "Geyser Spring"⁴ case. The "Congress Spring"⁵ was not brought within the reason of the rule, because all persons had not the same right as the plaintiffs, who possessed the entire title to the land where such spring had its outlet.

§ 599. In the Court of Bordeaux, in 1853 (*Salignac & Co. v. Levanier & Co.*⁶), it appeared that the plaintiffs had adopted as a designation of commerce for their brandy the words "Salignac et compagnie," and beneath the same the words "PROPRIÉTAIRES DE VIGNOBLES RÉUNIS." The defendants, for the same purpose, adopted the words "J. Levanier et compagnie," and beneath the same the words "COMPAGNIE DES PROPRIÉ-

¹ Annales de la Prop., tome xvi. p. 73.

² § 182, *ante*.

³ § 189, *ante*.

⁴ § 276, *ante*.

⁵ § 191, *ante*.

⁶ Journal du Palais, 1854, p. 129.

TAIRES DE VIGNOBLES.” PER CUR.: The words “Propriétaires de Vignobles” (Vineyard Proprietors) is a generic qualification belonging to an indefinite number of proprietors, and cannot indicate to commerce the origin of the article to which they are affixed. Dismissed.¹

§ 600. An application was made for the registration of the words “Great Lightning Ink Eraser.” These words, being descriptive of the article to which they were intended to be affixed, could not be favorably entertained. The Examiner made a suggestion that the interpolation of a single letter had quite changed the meaning of the essential word. Any ink eraser would lighten the ink marks, and therefore might truly be called a lightening ink eraser. The diminution of weight was not the exact point. The verb could be taken in but one sense. It could not possibly be meant to imply that the applicants’ eraser burst or darted forth with an instantaneous illumination. That would be nonsense. The second vowel made the trouble. The word should have been written “LIGHTNING.” The use of the metaphor would then have imported that, with the quickness of the electric flash, the stains of ink would be caused to disappear. That improper spelling would, in ninety-nine cases in a hundred, defeat the cause of the person who claimed the word. The rule of *idem sonans* could not save it. A man is supposed to have meant what he said, especially when suing for a penalty.

§ 601. An inventor may give the products of his genius, or skill, or good fortune, a distinctive appellation of infinitely great value to him than a patent for the machine or discovery. This is a matter that is worthy of the consideration of applicants for registration. The object is to select, or rather invent, a designation peculiarly applicable to the thing of which a monopoly

¹ The report of this case states that, during the progress of this suit in France, Salignac in the name of his company had obtained from the Lord Chancellor of England an injunction, and sequestration of certain goods so marked found in the London Docks. If so, it doubtless was on the ground of unfair competition; for there is nothing of the nature of a trade-mark in the whole case.

is desired. Now for an illustration of this idea. In or about the year 1814, John B. Logier obtained from the British Government a patent for fourteen years, for an instrument for guiding the hands of learners on the piano-forte. He compounded two Greek words, signifying "to form the hand," and named his machine the "Chiroplast." He acquired great reputation and a considerable pecuniary profit from the favorable reception of the instrument. If it had occurred to him that this new word was a valid trade-mark, it would have mattered little that his patent expired in fourteen years; for the mark would have virtually given him a monopoly so long as the public called for the "Chiroplast." As it was, the word is now generic. — In *Bardin v. Gobert et al.*,¹ the plaintiff had obtained a patent for a species of ornamental feathers produced by his invention of detaching the epidermis of all kinds of natural feathers, and dyeing them of all colors, as ornaments of various sorts for head-dresses, finery, flowers, embroideries, lace-work, and tissues. This constituted a new product of commerce. It needed a name. He composed one, — "FAILLANTINE." This meant his patented article, and nothing else. It was a perfect trade-mark.

§ 602. Propriety must be the standard in the selection of something intended to serve as a symbol of commerce.² Commerce extends throughout the world; therefore a mark should be valid in all lands or it is valid in none. The moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes. There is no necessity for so doing, for the objects suitable for use as trade-marks are as infinite in number as the sands of the seashore. A violation of this rule is not only in bad taste, but is also an outrage. The spirit of commerce is conciliatory. We must not blindly follow the loose, random sayings of judges, that any emblem may be lawfully employed for this purpose.

¹ *Annales de la Prop.*, tome xii. p. 380.

² See case §§ 342-344; also cases in § 370, *ante*.

To be a "lawful trade-mark" the emblem must not transgress the rules of morality or public policy. The law will not aid any person to blasphemously bring obloquy upon objects and symbols consecrated to religion. But what is religion, in its relation to commerce? It is the recognition of God, as an object of worship, love, and obedience. All peoples worship God under some form or other, or at least think that they do. Their religious prejudices must not be trampled upon. We tolerate all religions, true or false. A reader of these lines may be a Chinaman. His *joss* must not be caricatured. If a scoffer should endeavor to curry favor with an infidel class by the profane use of an *Agnus Dei*, or of any symbol of the Alpha and Omega, or the Ineffable Name, or even of angels, apostles, saints, and martyrs, or of a thousand objects depicted by ancient art, and hallowed by associations, would any court of justice sustain a claim to a trade-mark so composed? No! This is a rule of universal application. The Office hesitated to permit a representation of the Evil One himself to be registered as a trade-mark. The device is set forth in the specification as "a smiling, half-drunken demon or devil in a sitting posture, with the left leg raised at an angle of about forty-five degrees, while the right one is folded under it, and his tail passes over his right ankle. The demon wears a broad-brim hat with conical top and feathers, and in his arms and hands he carries six bottles." Enough! the frightful thing might possibly convey a moral lesson by an association of ideas. The *bottles* turned the scale. It had been recognized in Germany; and was registered.¹ Suppose, for the sake of further illustration of this topic, that the fiend had borne the likeness of a human being venerated by a large class of followers. It would have been in law an atrocious libel, and must have been rejected on that account.

§ 603. We have seen that a colored bordering of a woven fabric may be as valid a trade-mark as any other device, espe-

¹ Walter & Shaeffer, No. 434.

cially when announced as such, and recognized by the trade, and consequently will be protected like any other symbol of commerce.¹ But a mark must be well defined, and its nature be calculated to effect its object. As to what would be deemed an encroachment upon such a delineation, we have a decision of the Court of Cassation of France, made in May, 1872 (*Dugué & Co. v. Bobot-Descoutures*²). Both parties manufactured drillings. The complainants in their act of deposit — corresponding to our filing for registration — described their mark as composed of eight threads, arranged thus: two of violet, four of white, and then two of violet. The court said that it thence follows that the distinctive element of this mark is the number of threads, their disposition, and the alternation, as described. The defendants used four deep lilac threads, disposed so as to intertwine like a chain; whence it follows that the number of threads are not the same in both marks. The color is not the same, the complainants having two colors, while the defendant has but one color, — deep lilac. The disposition of threads is different: the violet and white of the complainants alternating, as stated, while in the defendants' the color is a unit. To disregard the number and disposition of threads in the complainants' mark, were to suppress one distinctive element, and to take it without the basis they have adopted to characterize the peculiar products of their manufacture. If their fabric be examined, in piece or in roll, there can be no hesitation in discovering the lack of resemblance between the two marks. In a word, from any point of view, no imitation can be discerned upon which to found a claim to damages, whether under the statute of 1857, or at common law (arts. 1382 and 1383 of the Civil Code). Both marks were recognized as valid.

§ 604. When a large number of persons are interested in a trade-mark, either as members of a joint-stock unincorporated company, or as the personal representatives of a deceased person, or as guardians of infants, any of the number may be

¹ See § 268, *ante*.

² *Annales de la Prop.*, tome xvii. p. 305.

selected to make the application for registration, for their joint benefit. In one case, the papers were executed by one such person, in his own behalf and "as the representative of, and for the joint and equal use of the heirs at law," &c.; and yet he asked that the registration should be made in his name, *he* having adopted a trade-mark for the benefit of all the others. He afterwards filed an unauthenticated certificate purporting to be signed by seven others as "the only heirs at law and legal representatives of Alpha Richardson, deceased," in which he, the applicant, was recognized as "the representative of the heirs at law." Papers so inartificially prepared could not receive a very favorable consideration. The complication might easily have been avoided in this way: If all the parties had adopted a trade-mark for their united interest, or had inherited such mark, they were tenants-in-common thereof, and one might have been appointed attorney-in-fact by and for the others; or, regarded as a copartnership, a single member of the concern might quite as well have done the business of obtaining registration. In either case, the petition should have been assimilated to the form prescribed for a firm. All the parties would then have acted through one, and the certificate of registry might have issued in the names of all, or to them as a firm.

§ 605. The following case is a curious instance of the ideas that are sometimes entertained in regard to the constitution of a trade-mark. It came up in the Court of Paris, in 1865 (*Prudon v. Brousse et al.*¹). The plaintiffs made up cigarette-paper in the form of a roll or endless-band, with sections indicated, being kept rolled by means of a caoutchouc band, which they patented. They then made a deposit of what they assumed to be their trade-mark, *i.e.*, the cylindrical form of their product. The Tribunal of Commerce of the Seine having rejected their suit, they appealed. The appellate court affirmed the judgment, saying that although that peculiar form of the

¹ Journal du Palais for 1865, p. 1125.

complainants' product had been used by them exclusively for a number of years, it could not constitute the commercial property known as a trade-mark.

§ 606. Here is another singular case, filed by a firm of solicitors largely engaged in patent practice. The symbol was described as the picture of a tiger, or the word "Tiger," but the essential element was stated to be "the *idea* of a tiger." The Examiner was perplexed. Fac-similes must be furnished by all applicants. A fac-simile is that which is made exactly like the mark impressed upon the vendible commodity; an exact copy of the writing, engraving, stamp, or brand. How to get a fac-simile of an idea was the embarrassing question. It was not understood how a mental conception, a thought, a sensation, or whatever it might be termed, could be impressed upon, or otherwise affixed to goods; but out of a feeling of respect the matter was fully considered. The Examiner suggested that a trade-mark must necessarily consist of a visible and invariable form. The solicitors did not accept the hint. Thus the matter stands. If they had been content with the excellent delineation of a tiger filed by them, or with the word "Tiger," or both together, the case would have been of easy solution. This shakes our faith in the maxim, *Utile per inutile non vitiatur*; for here is something serviceable which is completely neutralized by a useless adjunct.

§ 607. Rejection because of False Suggestion. — The application-papers may be perfect in form, and, so far as verbal language goes, quite impregnable, and yet be open to assault. The sworn statement is not always conclusive. The case as presented is liable to dissection, and hideous deformities to be exposed to view. The allegations may be true in letter, and false in spirit. The Office will penetrate the surface, and endeavor to reveal any latent fraud. The circumstances are compelled to testify, and keen examination, like the spear of Ithuriel, forces the truth from unwilling witnesses. The declarations of good faith may be overturned. Spurgeon says

that no one is more like an honest man than a thorough rogue. There seems to be no end to the devices of unworthy traders, to trick their rivals and the public; nor can there well be until bounds shall have been set to human ingenuity. Yet, to warrant a refusal to register, there must be sufficient evidence of unfairness to overcome the natural presumption of honesty and fair dealing. For that reason, many suspicious cases are allowed to pass muster, and to go into the field of active strife armed with the certificate of the Patent Office, with the chance that justice may eventually overtake them. The Office is not bound to hunt for motives not made apparent by the papers; yet if the *ex parte* case cannot look one fairly in the face, the blindest words shall not save it from condemnation. It has been vehemently said that the Office is not the conservator of the morals of the community, nor does it aspire to be. But it has a duty to perform, and that duty is to carefully scan each proposed case, and, if necessary, to probe it through and through. A self-styled trade-mark may upon examination be found to be a brazen-faced counterfeit. Any objection to validity which might be made in subsequent judicial proceedings may be anticipated in an application for registration;¹ and fraud is certainly the most formidable foe that can appear.

§ 608. The fraud which would justify a refusal to register a proposed trade-mark may be, 1. Actual or positive fraud; 2. Constructive fraud. That is, it may be the intentional employment of any cunning, deception, or artifice, to circumvent, cheat, and deceive purchasers;² or it may consist in such acts which, — though not originating in evil design and contrivance to perpetrate a positive fraud or injury, yet by their necessary tendency to deceive and mislead, or to violate public

¹ "The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark." Sec. 79, Act of July 8, 1870.

² *Dolum malum esse omniam calliditatem, fallacium, machinationem ad circumveniendum, fallendum, decipiendum alterum adhibitam.* Dig. 4, 3, 1, 2; Poth. Obl. n. 28.

or private confidence, — are deemed equally reprehensible with positive fraud, and therefore are prohibited by law, as acts done *malo animo*.¹ The public must be protected, at least to the extent of declining to recognize a mark as the valid symbol of honest traffic, when bad faith is apparent. Fraud is not to be judged of by the event only, but also by the design.² Even the appearance of evil is a sufficient justification for rejecting an application. Without making invidious distinctions between the various classes of cases presented for registration, we may use the following by way of illustration.

§ 609. The words “Hamburger Tropfen” (Hamburg Drops) were proposed for registration, as a trade-mark for a certain kind of medicine.³ The Office replied that it is difficult to conceive upon what principle such words could be upheld as a lawful trade-mark. They are printed upon a label which is entirely in the German language, and which, beyond a doubt, is addressed to German-speaking people. To them the said words are plain “Hamburg Drops,” and nothing more. The words are therefore descriptive, that is, if the medicine truly consists of drops coming from or made in Hamburg. Any person in Hamburg has a right to manufacture “drops,” and as much right to give those drops the geographical name of “Hamburg.” But there is another objection. The label upon which the said words are printed has upon it the representation of an ornamented mortar-and-pestle, beneath which are the words “*Handels Marke*,” besides a caution, and a fac-simile of the signature, “Dr. August Koenig.” These words clearly indicate the previous appropriation of the said representation, as a trade-mark, and that by some one other than the applicants. By reference to the application-papers, it will be perceived that the medicine of the applicants, upon which article it is proposed to use the words “Hamburger Tropfen,” is man-

¹ 1 Story Eq. Jur. § 258-440.

² *Fraudis interpretatio semper in Jure Civile non ex eventu duntaxat sed ex consilio quoque consideratur.* Dig. 50, 17, 79.

³ A. Vogeler & Co., *ex parte*, 1872.

ufactured by them at Baltimore, Maryland. Such a label is calculated to mislead the public. For both reasons, the application was rejected.

§ 610. The words "American Sardines,"¹ as applied to certain fish prepared for food, were refused registration, for a similar reason. The objections were, the descriptive nature of the words on one hand, and their tendency to mislead on the other. The written argument of the applicant's counsel admits that the fish to which these words are applied are not really sardines, but are "*menhaden*," or "*moss-bunkers*," which, cooked in any ordinary way, are not eatable, owing to their numerous fine bones, and were therefore used only for making oil until treated by the applicant's patent process. The words "American Sardines" cannot, in view of this fact, be held to be descriptive. But a more formidable objection remains for consideration, said the Office, — the tendency to mislead the public. The counsel attempt to meet this objection by insisting that no one who has ever seen a sardine could mistake the so-called American Sardines for the genuine Mediterranean fish; for, say they, the applicant's fish are "at least six times as large, though supposed to be of the same (herring) family." The Office replied, as follows: The truth is this, the inferior fish, the moss-bunkers, are put up by the applicant in tin boxes similar in size and general appearance to those containing the genuine delicate fish, brought from the vicinity of Sardinia. It is not possible for any unadvised purchaser to draw comparisons between the appearance or sizes of the applicant's preparation of fish and the genuine, until the box is opened; and the box is not opened until after purchase. By that time the mischief will have been done. It may be that the wholesale dealer would not in the least degree be misled by the misuse of the word "Sardines," or by the appearance of the box with its French words on a brass label; and retail dealers might be cautious enough to look at the English words on said label,

¹ Case of "The American Sardine Company," 1872.

and draw the correct inference ; but they are not the only classes who are to be shielded from deception. The careless, the ignorant, the inexperienced, must be protected ; for they buy on the faith of a single glance of the eye at the outside of the box bearing the attractive appearance of a genuine package of sardines. It is denied that there is any *intention* on the part of the applicant to mislead. That is not material in our present investigation. The real question is this : Is the use of the name, " American Sardines," as applied to a box resembling the genuine sardine-box, calculated to mislead the public in the purchase of an article of merchandise ? It is not necessary for the determination of this question that any purchaser shall actually have been deceived. Would the public be likely to be misled ? They would be. Then, the proposed trade-mark cannot have the sanction of registration. As to the *bona fides* of the applicant in adopting said words : Why apply the words " sardines ? " As moss-bunkers, perhaps the article would not sell. It is said that the words " American Sardines " are not given to the fish themselves, but to the fish as prepared under a peculiar process. The public would buy the prepared fish as genuine sardines, which they are not. Even if the American prepared fish are superior in taste and nutritious qualities to the Mediterranean fish, there is no reason why a purchaser should not have exactly what he calls for. Application finally rejected.

§ 611. An application was made for the registration of the words " Richardson's Patent Leather Splitting Machine." These words being purely descriptive of the article upon which they were placed, the case was rejected upon that technical ground. Upon a close inspection of the papers, it was observed that the applicant set forth that he had adopted a trade-mark consisting of those words, while in another place in the same documents he alleged that the mark had been in use for upwards of twenty years. The statements are objectionable for repugnance. That is not all that may be said. To use a mild

expression, the mode of relating the facts is very suggestive. Under this gentle aspect, what motive lies concealed? The phraseology — “for a term of upwards of twenty years” — is simple and indefinite enough, and may reasonably be inferred to mean at least twenty-one years. A patent granted prior to March 2, 1861, expired in fourteen years, unless extended, in which case its duration would have been prolonged for seven years. In either event, the monopoly must have ceased. What would have been the practical effect of a recognition of this assemblage of words as a trade-mark? For all time, the idea must thereby have been conveyed that a patent upon the machine was still in force, and the monopoly, which Government had limited, might by an ingenious manœuvre have been perpetuated.

§ 612. We need be at no loss to find precedents on this point of false suggestion. Where one person had adopted as his trade-mark the word “ $\frac{\text{Hero}}{\text{ine}}$ ” he was an infringer who used the words “The Heroine” for the same class of merchandise.¹ So, when one person distinguished his black cotton stockings from those made by others, by six plain lines one above another, and about the eighth of an inch apart, going round each stocking near the top of the leg, and the word “ETHIOPIAN” printed in Egyptian characters below said lines in a segment of a circle, and another person stamped lines and characters somewhat similar on his stockings.² So, also, in the “Chemical Paint” case, the “Cocaine” case, the “Eau de la Floride” case, and many other instances that may be found in this book. The intent is to deceive.

§ 613. Litigation not unduly encouraged. — Applications for registration are frequently made with the idea of obtaining thereby a *prima facie* title, as the basis of judicial proceedings. It may be well worth the while of a capitalist to be enabled, by the production of a certificate of registry, to throw the burden of

¹ Rowley v. Houghton, 2 Brewster, 303.

² Hine v. Lart, 10 Jur. 106.

proof upon an adverse party ; and by obtaining a preliminary injunction founded thereon fetter, if not destroy, the business of another. We will suppose that some article has a transient popularity. The moment of demand must be seized. The delay of a few months may be fatal to success ; for fortunes sometimes depend upon instantaneous action. The article is known by a certain mark, and that mark is a name. That name is the talisman that works prosperity. Whoever has the sole right to stamp that magic symbol on his goods, wares, merchandise, has the monopoly. An injunction is applied for. The proof of registration affords strong presumptive evidence of title. The provisional injunction is granted. Weeks, months, perhaps years, must elapse before the controversy can be determined upon its merits. In the mean time, the enjoined party suffers irreparable injury. It matters little who shall eventually win the battle. Craft, insolence, and abundant pecuniary means, will by that time have reaped the golden harvest. This is not a fancy sketch. It has been exemplified in more than one instance ; and the Office has been cautioned thereby. The moral responsibility of a want of due caution rests upon the public officer. He is to guard against error, intentional or innocent. He who is persuaded that he has a right may be guilty of a mistake, and not of deceit.¹ Whatever may be the cause of a misstatement of facts, the legal result is the same : the thing proposed cannot become a lawful trade-mark. Thus, where it was alleged that the trade-mark consisted essentially of the words " Rip Van Winkle," and a triangle enclosing the applicant's initials, and it was found that another house had the words " Rip Van Winkle " as a mark for the same class of merchandise, the application was rejected.² The imitation was only in part, but was sufficient to cause confusion, and likely to provoke litigation.

¹ *Nemo videtur dolo exequi, qui ignorat causam cur non debeat petere.* Dig. 56, 17, 177.

² *Case of Fechheimer & Workum, ex parte, 1872.*

§ 614. **Surrender and Reissue** cannot, in strict parlance, be said to be applicable to a trade-mark case. But it sometimes happens that errors creep into certificates, or application-papers. If the error is on the part of the Office, the party cannot be prejudiced thereby;¹ and the correction will be made without cost to the applicant.² If, after a party obtain registration of a trade-mark, he discover that the certificate of registry is inoperative, or invalid by reason of a defective or insufficient statement or specification, or by reason of too great a breadth of claim, which error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, he may be permitted to surrender his certificate, and obtain another. In one case of the kind the mark consisted of an elaborate design, consisting of a cross, crown, wreath, vines and bunches of grapes, and a number of words. In the centre were the words "Sazerac de Forge & Sons." The two latter words should have been in French, — "*et Fils.*" This was a mere clerical error. The holders of the certificate filed a new application, paid the full fee, and asked for a new certificate. The Office suggested that the original certificate should be surrendered. That being done, the amended case was registered.³

§ 615. **Money paid as Fee, when returnable.** — It is provided by statute, "That the Treasurer of the United States is authorized to pay back any sums of money to any person who shall have paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasurer, as for fees accruing at the Patent Office, through mistake, certificate thereof being made to said Treasurer by the Commissioner of Patents;"⁴ but a mere change of purpose, after the pay-

¹ *Phelps v. Brown*, 1 Fisher, 479.

² Case of *James Cochrane*, Commissioner's Decisions, 1869, p. 60, and case of *Havemeyer et als.*, *ibid.*, 1870, p. 5.

³ *Ives, Beecher, & Co.*, No. 547.

⁴ Sec. 71 of An Act to revise, &c., the statutes relating to patents and copyrights, of July 8, 1870.

ment of money, will not entitle a party to demand such a return.¹

§ 616. The money must actually have been paid through *mistake*, to authorize a return. In any case, where the Office had no jurisdiction of the subject-matter filed, such return will be made; as, for example, where a non-trading corporation filed an application for the registration of a mark, which was therefore not a trade-mark, in contemplation of law, the money was returned. So, in a case where an applicant transmitted a fee which he desired to be applied for copyrighting a picture, which matter is solely within the cognizance of the Librarian of Congress. But when the Office has undoubted jurisdiction of the class to which the case belongs, the fee will have been earned the moment of the first action by an officer. The Government does not undertake to warrant a valid title, or any title at all. The party is presumed to know the true state of facts, as well as the law, before he applies for registration. If his application is rejected for any cause, the money paid will be retained, by way of costs.

¹ No. 111, Rules of Practice of Patent Office.

CHAPTER XIV.

INTERFERENCES IN PATENT OFFICE.

Skill demanded. — Definition. — In what Cases declared. — Preliminary. — Declaration and Dissolution. — Notice. — Grounds for declaring. — Compulsory Testimony. — Access to Testimony filed. — Printed Copies of Testimony. — Postponement. — Information in pending Cases. — Sources of Evidence. — Rules for taking and transmitting Testimony. — Case closed. — Hearing. — Appeal. — Practice exemplified. — “Durham” Case. — Decision of Examiner. — Of Commissioner. — Of Court. — “Bouquet” Case. — Multiplicity of Legal Questions. — “Paul Jones” Case.

§ 617. Interferences frequently demand the most skilful management, and bring into requisition all the acumen and learning of the ablest lawyers, so far, at least, as regards the taking of testimony, and the application of the rules of evidence. This presupposes an intimate acquaintance with the law of the case in hand.

§ 618. The matter must be as carefully conducted as though it were pending in a court of equity; indeed, the practice is moulded upon that of such a tribunal. As in controversies in courts, substantial rights may be frittered away by an inartificial mode of procedure; by a failure to evoke evidence of material facts, owing to a slovenly mode of examining witnesses; or by such irregularities in practice as are beyond toleration when the interests of another party are at stake.

§ 619. True it is that the Office earnestly strains after the furtherance of justice; but to this — as to all worthy endeavors elsewhere — there is practically a limit; and litigants must generally be left to rest as best they may upon the beds made

by themselves. An issue is joined, testimony is taken, objections and points are made, arguments are heard, and the Office decides upon the whole matter as presented. Leading and other improper questions and the answers to them are ruled out, and, may-be, whole depositions are eliminated for want of proper care having been given; for manifest lack of good-faith; or for some other fault, although it may be the result of sheer ignorance or carelessness. In case of surprise, relief will be given to an innocent party. Thus, upon a motion to reopen an interference in order to receive testimony which had been delayed until after the day of hearing by the fault of the officer before whom it had been taken, the decision of the Examiner was suspended, and the case set for immediate hearing upon the testimony and arguments by that time in.¹ But after one party had filed his preliminary statement and taken his testimony, the Commissioner refused to open the case and allow the other party to file a preliminary statement and take testimony, where, although not originally a party, it appeared that he had had knowledge of the pendency of the interference, and the proceedings under it.²

§ 620. It may here be remarked, that seeming mere irregularities are sometimes the manifestations of subtlety and craft of tricky practitioners. Their object is to discover the weakness of the adversary, and then by feigned surprise, or plausible excuse, obtain permission to take additional testimony. Such persons can usually find witnesses to supply all deficiencies in the evidence. When such a motive becomes apparent, the Office is sometimes called upon to exercise some ingenuity to circumvent villany, for rogues like them care little for frowns of indignation.

§ 621. An Interference is defined to be an interlocutory proceeding for the purpose of determining which of two or more persons, each or either of whom claims to be the first adoptor

¹ *Hayden v. Phillips*, Commissioner's Decisions of 1870, p. 171.

² *Aldrich et al. v. Bingham*, id. p. 90.

of a trade-mark, really did first adopt it. It may also be resorted to for the purpose of procuring evidence of an alleged abandonment of the mark in controversy.

§ 622. It will be declared in the following cases: *First*. When the parties have pending applications before the Office at the same time, both or all of the parties claiming priority of title to the same mark, — or one substantially the same, — used to indicate the same class of merchandise. *Second*. When an applicant — having been rejected upon a previously-registered trade-mark — claims an older subsisting title.

§ 623. Under the rule as to an older subsisting title, this case may arise, and may as well as not be anticipated in this place. A. may have in good-faith registered his mark, supposing that no one else in the world had appropriated it for the same purpose; and as a fact it may be that no other person had any right to ask for registration, when A. made his application. He then stood alone before the Office, with a *prima facie* case, at least. If any other person had a better right to the thing, that right was not made manifest. Accordingly, his claim is admitted, and a certificate of registry duly issued. We concede that A. was the only person who had a legal right to registry. By virtue of a treaty subsequently made with some foreign country, B. comes in and demands that his trade-mark be registered in pursuance of the treaty stipulations. His proof is clear that he had adopted the mark long before A. What is to be done? A. acted in ignorance of B.'s right, and in perfect honesty. To deprive him of the exclusive right to the use of his symbol of trade may do him irreparable injury. He was diligent; he was truthful. At the time of registration, he was the only person in the world who had any standing before the Office.

§ 624. The solution of the question is easy to him who has studied the principles upon which rest the laws of a right to a trade-mark. The question thus far presented is one of registration. We must pass that by, and come to the real ques-

tion, — Who had the prior right to the use of the mark? If it were a claim to letters-patent for an invention, or to a copyright, the junior applicant might well be refused relief; for patents and copyrights are the creatures of arbitrary law, and, the courts say, have no foundation in nature. But not so in a matter of property in the conventional symbol that is the substitute for a man's name. That is founded upon immutable law, as we have before seen. Such being the case, B.'s priority of right must prevail; and for this reason: It was not his *right* but his *remedy* which was in abeyance. The treaty which demolished the partition-walls admitted him to all the privileges of the most-favored persons. But then he ousted another from a vested right? No: it was only an apparent right; for if the Patent Office had had any knowledge that any one else in any country had an older title, the application for registration would have been refused. B. had all the time a perfect common-law right, and could have sued in our courts as an alien friend, without the slightest regard to the matter of treaty or convention. — We could readily imagine other cases just as curious, and yet within the limits of probability. A. might, for instance, set up that, even if B. had once had a title to exclusive use, he had abandoned all right to the same; and that thereupon he, A., was the first to appropriate it to his sole use. B. having established his claim, the next step is to issue to him a letter of registry. That will be to have two outstanding titles to the same property at once. Yes, until a court shall have enjoined one from the use of the symbol; or the wrongdoer shall have voluntarily relinquished all claim to it. The Commissioner has no power to cancel a certificate of registration already issued; for that is a matter for judicial cognizance upon a suit to be brought by the Government, either in its own name or the name of the Attorney-General; or by some form of proceeding which can give official assurance of the sanction of the proper authority.¹ But the Commissioner may, if he find

¹ *Mowry v. Whitney*, Sup. Ct. U. S., April, 1872: Official Gazette of Patent Office, May, 1872.

that another was the prior adoptor, give him also a certificate of registry; and thus place both parties on the same footing before the courts and the public. His authority for so doing is found in the proviso to the 79th section of the trade-mark law of July 8, 1870.

§ 625. **Preliminary Interference.**— Before the declaration of an interference proper, a preliminary interference will be declared. In that, each party will be required to file a statement under oath, giving a detailed history of the circumstances of his adoption of the mark; the extent and manner of application to merchandise; and the particular description of goods to which it was by him affixed; and giving, so far as practicable, the exact date of each step in the act of appropriation. This statement must be sealed up before filing (to be opened by the Trade-mark Examiner only); and the name of the party filing it, and the subject-matter of the case, must be indicated on the envelope.

§ 626. As just intimated, the real point sought to be evolved is the exact time of adoption; and, as circumstances, the manner of application, place of adoption, and the class and species of vendible articles to which it was applied. It should also appear who made the original appropriation, whether the claimant or some one from whom he derived title; and if done through an agent, that fact should be stated. The case of *Schrauder v. Beresford & Co.*, hereinafter given, shows the importance of a circumstantial detail of facts, and especially the necessity for setting forth the exact date of placing the symbol upon goods offered for sale.

§ 627. The statute requires that the length of time, if any, during which the trade-mark has been used shall be stated in the application; and the statement is generally conclusive against the affirmant in any subsequent proceeding; for it would not be just to allow him to fix a date under oath, and afterwards, when another claimed a prior title, to come in and alter the date so as to anticipate his opponent's title. In one

case,¹ the Commissioner held that such preliminary statement should always be regarded as conclusive against the party making it, restricting him to the date, and substantially to the history therein set forth, while, by a well-known rule of law, it can never be used as evidence against the adverse party in interference; and in another case, it was said that if testimony, taken upon an interference, tends to set up an earlier date than was claimed in the preliminary statement of the same party, it must, at least, be viewed with grave suspicion.² The stringency of this rule is sometimes relaxed, upon overwhelming evidence of unintentional error, and of perfect good faith; although, of course, the presumption is always against him who would attempt to vary a statement made under the solemnity of an oath. In a patent case,³ the Commissioner said: "The object of the preliminary statement is to serve as a pleading, in which each party, in ignorance of his opponent's case, sets forth the history and date of his own invention. This he must know better than any one else, and he will be held to make a full and accurate disclosure, without evasion or reservation. He must distinctly state the date which he proposes to prove as that of invention, and he must set forth the substantive *act* of invention, upon which he proposes to rely. . . . It is proposed to put an end to the practice which, it is to be feared, has prevailed to too great an extent, of striving on each side to learn an opponent's date of invention, only to manufacture such proof as may be necessary to fix an earlier date." Yet cases do sometimes arise when this rule cannot, in accordance with justice, be enforced to its fullest extent; as, for example, where, in one instance not reported in print, the evidence was clear that by unavoidable mistake the date was incorrectly stated, one numeral having been mistaken for another in transcribing. Even in such a case, the evidence of good-faith must be beyond reasonable doubt.

¹ *Kenyon v. Wesson*, Commissioner's Decisions, 1871, p. 91.

² *Tegmeyer v. Kerns*, id. p. 285.

³ *Schenck v. Rider*, id. p. 135.

§ 628. The oath should be made by the party himself, unless, as may occur, he be not the most cognizant of the facts. One may be able to state that he adopted a mark for his merchandise, without being able to fix the exact date of the consummation of his intention, — that is, the actual stamping or otherwise marking of his goods; for he may possibly have acted through an agent at a distance from him. By virtue of the maxim, *Qui facit per alium, facit per se*, the physical act of his agent would enure to his (the principal's) benefit, though the one were at the moment in Boston, and the other in San Francisco. In making the oath to the preliminary statement, as in any other case of litigation, of course the best available evidence should be advanced.

§ 629. The preliminary statements are not open to the inspection of the opposing parties until both shall have been filed, or until the time for filing both shall have expired; nor then, until they shall have been inspected by the Examiner of Trade-marks, and are found to be sufficiently definite as regards the declaration of dates.

§ 630. If the party upon whom rests the burden of proof fail to file a preliminary statement, or if his statement fail to overcome the *primâ facie* case made by the respective dates of application, or if it show that he has abandoned his alleged trade-mark, the other party will be entitled to an immediate adjudication of the case upon the record; unless a presumption arise that his claim of right to registration is affected by a dedication of his mark to the public, in which case the interference may be proceeded with. Although the statement of one party may admit his lack of title to exclusive use of the mark in dispute, he may be prepared to prove the same lack of title in his opponent.

§ 631. If the earlier applicant fail to file a preliminary statement, no testimony will subsequently be received from him tending to prove that he adopted the mark at a time prior to that fixed in his application. The preliminary statement

can in no case be used as evidence on behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination by the other party.

§ 632. If either party require a postponement of the time for filing the preliminary statement, he must present to the Examiner his reasons therefor, in the form of an affidavit, and prior to the day previously set.

§ 633. **Declaration and Dissolution.** — An interference will not be declared until the subject-matter involved is decided to be registerable; and, when once declared, it will not be dissolved without judgment of priority, unless it be found that neither party is entitled to a certificate of registry, or that no interference in fact exists. And at whatever stage it is ascertained that there is no conflict between the claims of the parties, it will be dissolved, whether before the Examiner or the Commissioner; for to continue it would be a waste of time, and would avail nothing.¹ Thus it will be dissolved, *ipso facto*, by the withdrawal of one of the parties;² or it will be dissolved upon one of the parties striking out from his specification the only element of conflict;³ or it be found that the registration of one will be no bar to the other.⁴

§ 634. **Judgment based upon Concession of Priority** will not be given unless such concession be evidenced by a writing, under the signature of the party himself. If there have been an assignment of the trade-mark, the assignee must join in the concession, although not a nominal party. The withdrawal of one party does not entitle the other to a decision in his favor on the question of priority;⁵ for it may be that his withdrawal is by way of nonsuit, with an intention to renew the contest when better prepared; or it may be by collusion, when neither party has any right.

¹ Jenkins *et al.* v. Putnam, Commissioner's Decisions, 1870, p. 156.

² Eames & Sealey v. McDougal, *id.* 1871, p. 206.

³ Hawkins v. Lambert, *id.* 273. ⁴ Jackson v. Nichols, *id.* 278.

⁵ Eames & Sealey v. McDougal, *supra.*

§ 635. **Notice to Parties.** — When an interference is declared, notice will be given to both parties, or to their attorneys. When one of the parties has received a certificate of registry, duplicate notices will be sent to him and to his attorney of record. Where one of the parties resides abroad, and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in a newspaper of general circulation in Washington, D. C., once in a week for three successive weeks.

§ 636. If there be more than two parties, the times for taking testimony shall be so arranged, if practicable, that each shall have an opportunity for so doing in his turn, each being held to go forward and prove his case against those who shall have filed their applications before him.

§ 637. As the parties are to prove the facts by the adduction of evidence before the Examiner, and have, consequently, to provide themselves with the proper documentary or other testimony, it is essential that they should each be apprised of the specific nature of the question to be tried, for the guidance of the parties in preparing their proof. The notice of interference sent by the Office to the parties states the point in issue. For example, in a complex mark there may be one prominent element, as in the "Paul Jones" case, hereinafter given, where that name of a naval hero was really the whole case, although it was displayed upon a flag flying on a ship under full sail. The parties entered into the contest with the knowledge of that name being the only material point of inquiry.

§ 638. **Grounds of Interference.** — Marks do not conflict unless they are identical in form, or have such a near resemblance to each other that the public may confound them, and thus purchase the goods of one man when intending to obtain those of the other. Although there may be *some* points of resemblance, that will not warrant the declaration of an interference, unless confusion be likely to ensue. Take the following case as an illustration. One person obtained a certificate of registry

(No. 709, March 19, 1872) for a trade-mark for shirts, drawers, &c., which mark was described as consisting of “a balance, a shield, and the word ‘CENTENNIAL’ arranged as shown, numbers designating the size and quality of the goods being, if desired, marked upon the shield.” Other persons, composing a partnership, subsequently obtained a certificate (No. 809, May 7, 1872) for a trade-mark, for substantially the same class of merchandise. The mark of the latter was described as consisting of the word “CENTENNIAL,” which word was alleged to be generally arranged as shown in the label filed, the central or middle part being covered by a pictorial representation of the Declaration of Independence, within a wreath, which wreath is held and crowned by the American eagle, below which is a character symbolical of the word “CENTENNIAL.” The word “CENTENNIAL” alone constitutes the mark, all the remainder being dispensed with at pleasure. Counsel for the earlier party, on becoming apprised of the second case, made this point: That the record showed sufficient grounds for the declaration of an interference, and that the later adoptors had no right to appropriate a word which was one of the essential elements of the trade-mark of the other claimant; and it was suggested that the latter, who was the prior adoptor, was prepared to discard all the other elements of his mark, and confine his claim to the one word. The Examiner held that the specifications on file were the *criteria* of action; and that as they did not disclose any conflict of claims, inasmuch as the two things were so dissimilar that they were not calculated to deceive, it was not a proper case for an interference. If the prior applicant limited himself to the use of the word in combination with other things, it was his misfortune. Thus the junior applicants were left with a broad claim to the word “CENTENNIAL,” which they might use in combination or not, at pleasure. Thereupon, for the purpose of obtaining an adjudication on the question of priority of adoption, the senior registrant filed a new application, in which he claimed the word

“Centennial” as the essence of his trade-mark. That proceeding raised a simple question of fact, to be decided upon an interference trial.¹

§ 639. **Compulsory Testimony.** — Previously to the passage of the Act of Congress of March 2, 1861, it was within the option of witnesses to give their testimony or not, so that there were frequent failures of justice. That Act provides, “That the Clerk of any court of the United States for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue a subpoena for any witness residing or being within said district or Territory, commanding him to appear and testify before any officer in said district or Territory authorized to take depositions or affidavits, at any time and place in the subpoena stated; and if any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or, after appearing, shall refuse to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases.”² The Act further provides that the witnesses shall be allowed the same fees as are allowed to witnesses attending the courts of the United States; and they are not compelled to attend at any place more than forty miles from the place where the subpoena is served, unless the fees are paid or tendered in advance. As parties in interest are competent witnesses in the Patent Office, as in the Federal Courts, they may testify upon deposition on their own behalf; but whether they are intended to be included within the provisions of the section above quoted is a disputed point. As a fact, however, it may be stated that in practice in interference cases, a party has been compelled to appear and testify against his own interest; and it is equally true that parties generally do not contest the matter, but prefer to testify.

¹ *Sternberger v. Thalheimer & Hirsch*, Nov. 1872.

² Re-enacted as sec. 44 of the Patent Act of July 8, 1870.

§ 640. Parties have Access to Testimony on file prior to the hearing, in presence of the officer in charge; and copies may be obtained by them at the usual rates.¹

§ 641. Printed Copies of the testimony greatly facilitate the examination of cases; and they are required in all cases when the testimony is written otherwise than in a fair and legible hand.²

§ 642. Postponements.—If it become necessary for either party to have the time for taking his testimony, or for the hearing, postponed, he must make application to the Trade-mark Examiner for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his motion.

§ 643. A motion to open an interference for a rehearing, after a decision *sub silentio*, will be refused where there has been gross negligence in preparing for it. There is a case³ where, *four* months after the decision had been made, and after frequent allowances of additional time, the party had the cool assurance to ask for a still further opportunity. His motion was denied. Up to that time he had taken no proof, offered no affidavit except his own to show what proof he desired to offer, or that any evidence did exist; and his own affidavits gave no details, but were most general in their statements. The Office regarded his persistent waste of time as intended simply for delay, although he made affidavit to the contrary. This is an extreme case; for it is seldom that repeated postponements would be countenanced, unless by the consent of the adverse party.

§ 644. Information in Relation to Pending Cases is given so far as it becomes necessary in conducting the business of the Office, but no further. Thus, where an interference is declared be-

¹ Rule 118.

² *Ibid.*

³ *Covel v. Maxim et al.*, Commissioner's Decisions, 1869, p. 78.

tween two pending applications, each of the contestants is entitled to a knowledge of so much of his opponent's case as to enable him to conduct his own understandingly.¹

§ 645. **Sources of Evidence.**—As in equity cases, these are principally four. *First.* The intelligence of the tribunal, or the notice which it judicially takes of certain things, and the things which it presumes; *secondly.* The admissions of the parties, contained in their specifications and statements, which serve as pleadings; *thirdly.* Documents; and, *fourthly.* The testimony of witnesses.

§ 646. As a rule, the parties may by written consent make almost any thing evidence, unless the effect would be injurious to the public; as, for example, the admission that one of the parties has a good title when the contrary is clear. No such admission of an adversary would be deemed sufficient to warrant the issue of a certificate of registration where the Office had judicial cognizance of the untruth of the admission; for not only is the case to be decided upon the issue joined by the parties, but the interests of the community at large are to be looked after.² The law of evidence as settled by the courts is used in the matter of interferences, so far as applicable. Official papers; the precise state of our relations with a foreign government; the dates of public events, such as proclamations of war and peace, which may affect the forensic privileges of parties; treaties, and conventions with foreign powers, — will all be judicially recognized. The principal source of evidence is the testimony of witnesses taken upon deposition. The rules of practice of the Patent Office prescribes the regulations for taking and transmitting testimony in an interference case, viz. : —

Before the deposition of a witness or witnesses is taken by either party, due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where such deposition or depositions will be taken, with the names and residences of the witness or witnesses then and there to be examined, so that the opposite party, either in person or by attorney, shall have full opportunity to cross-examine the witness or wit-

¹ Rule 128.

² See sec. 79, Act of July 8, 1870.

nesses: *Provided*, That if the opposite party, or his counsel, be actually present at the taking of testimony, witnesses not named in the notice may be examined, but not otherwise; and that neither party shall take testimony in more than one place at the same time, nor so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

The notice for taking testimony must be served by delivering a copy to the adverse party, or his agent or attorney of record or counsel, as provided in Rule 77,¹ or by leaving a copy at the party's usual place of residence with some member of the family who has arrived at the years of discretion; and such notice shall, *with proof of service of the same, and a certificate, duly sworn to, giving the manner and time of making the service,*² be attached to the deposition or depositions, whether the party cross-examine or not.

The magistrate before whom the deposition is taken must append thereto his certificate, stating the time and place at which it was taken, the name of the witness, the administration of the oath, at whose request the testimony was taken, the occasion upon which it is intended to be used, the names of the adverse party (if any), and whether they were present; and *immediately upon the close of the examination* he shall securely seal up all the evidence, &c., and forward the same *forthwith* to the Commissioner of Patents, making upon the envelope a certificate, giving the title of the case and the date of sealing and addressing the package.

If either party shall be unable, for good and sufficient reasons, to procure the testimony of a witness or witnesses within the stipulated time, it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied by statements *under oath of the cause of such inability, and of the names of such witnesses, and of the facts expected to be proved by them, and of the steps which have been taken to procure said testimony, and of the time or times when efforts have been made to procure it*; which notice to the Commissioner shall be received by him previous to the day of hearing aforesaid. Copies of the papers, and notice of any motion based upon them, must also be served upon the opposite party, as provided in rule 50. [This provides that reasonable notice of all motions, and copies of the motion papers and affidavits, must be served upon the opposite party or his attorney. Proof of such service must be made before the motion will be entertained by the Office; and motions will not be heard in the absence of either party, except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken to the Commissioner in person.]

¹ Rule 77 provides that if there be no attorney of record, the service of notice may be made upon any attorney or agent who takes part in the service of notice, or in the examination of witnesses of either party.

² Notwithstanding this phraseology, an admission of service by the adverse party or his agent, attorney, or counsel, duly appointed, will be deemed equivalent to the sworn certificate. See form of proof of service in the Appendix.

The official *records* of the Office, and other books and documents contained in the library, may be used at the hearing; but notice of any special matter contained therein, upon which a party relies, should be given to the opposite party previous to the day set for closing testimony.

The folios of each deposition must be numbered consecutively, and the name of the witness be plainly and conspicuously written at the top of each folio. It is deemed desirable that the testimony be taken upon legal-cap paper, with a wide margin on the left-hand side of the page, and that only one side of the sheet be written upon.

The testimony may be taken in narrative form; but, if either party desires it, it must be taken in answer to interrogatories, having the questions and answers committed to writing in their regular order by the magistrate, or, unless by consent, by some person not interested in the case, either as a party thereto or as attorney. The deposition, when complete, must be signed by the witness.

No evidence touching the matter at issue will be *considered* upon the day of hearing which shall not have been taken and filed in compliance with these rules; but no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it: and in such case it should be made to appear that, as soon as the party became aware of the objection, he immediately gave notice thereof to the Office, and also to the opposite party, informing him at the same time that, unless corrected, he shall urge his objection at the hearing.

§ 647. **Case closed.** — When no testimony shall have been taken by the party upon whom rests the burden of proof, or when testimony shall have been taken by such applicant, but not by the other party during the time assigned to him, the case will be considered to be closed; and, upon motion duly made before the Examiner at the expiration of the time assigned to the parties respectively, it may be set for hearing at any time not less than ten days thereafter.

§ 648. **Hearings.** — All interference cases pending before the Commissioner on appeal, or before the Examiner of Trade-marks, will stand for argument at one o'clock on the day of hearing, unless some other hour be specially designated. If either party then appear, he will be heard; but a contested case will not be taken up for oral argument after the day of hearing, except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new

assignment will be made, or the case will be continued from day to day until heard. Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel.¹

§ 649. *Appeals.* — In cases of interference, appeals *pro formâ* may be taken to the Commissioner in person, and without the payment of an appeal-fee. The appeal must be accompanied by a brief statement of the reason therefor; and both parties will be required to file briefs of their argument at least five days before the hearing. Printed briefs are in all cases preferred, the practice of courts being followed in the citation of cases and making of points.

§ 650. It is not unusual in such appeals for the parties to file voluminous abstracts of testimony, sometimes running to the extent of thousands of pages. At least enough of the case should be shown to meet the exact points in controversy, and enable an intelligent understanding to be had of the facts. The more caution should be observed, as in this class of cases the decision of the Commissioner is final. In patent cases, a dissatisfied party may appeal to the Supreme Court of the District of Columbia sitting *in banc*, but an interference is expressly excepted by the law.²

§ 651. The remarks of the court in a certain patent case,³ in regard to granting reissues, are also as applicable in matters of interference: "The Commissioner is supposed to have all the qualifications necessary to an intelligent decision of that question, and there are strong reasons why his action should be regarded as final. Such I understand to be the doctrine of the Supreme Court of the United States, as announced in numerous reported cases."⁴

§ 652. The practice in an interference case can best be ex-

¹ This is in substance the provisions of rule 49 in patent cases, and is now adapted to trade-mark interferences.

² Sec. 48, Patent-Law Act of July 8, 1870.

³ *Whitely v. Swain*, 4 Fisher, 123.

⁴ 4 How. 404; 15 id. 52; 17 id. 84; Law's Dig. 617.

plained by taking the record of an actual controversy as to the right to the exclusive use of a trade-mark. We will thus see not only the formal part of the proceedings which characterize such a matter, but will also have a curious exhibition of the contrarieties of the human mind, as shown in the ideas of counsel and the opinions of judicial officers. It will, in addition, furnish a commentary upon the "glorious uncertainty" of trade-mark law, when its settled principles are not rigidly adhered to. It is, besides, offered in evidence of the necessity which up to this time has existed, for some person who has made it a special study to write a treatise on the subject.

§ 653. We will take, for example, the case of *Louis L. Armistead v. William T. Blackwell*. The applicant stands in the position of plaintiff, as he attacks the title of Blackwell, who had previously registered as a trade-mark the words "DURHAM SMOKING TOBACCO." The Office having informed Armistead, through his solicitor, that another party claimed priority of title, both parties were required to file preliminary statements by a certain day.

§ 654. Armistead answered by a sworn statement of his version of the origin, &c., of the mark, partly from his own knowledge, and partly upon information and belief, deducing his title through one Wesley A. Wright, and taking it back to 1860. Blackwell also filed his statement, setting forth that, in 1865, one J. R. Green, from whom he claimed title, was engaged in manufacturing tobacco in North Carolina at the time of the approach of the armies of the United States under command of General W. T. Sherman, and the retrograde movements of the army of General Joseph E. Johnston, of the so-called Confederate States, and in the vicinity of the town of Durham. That when the armistice antecedent to the surrender of the army of General Johnston was promulgated, the two armies occupied positions adjacent to said town of Durham, and the town and vicinity became common ground to each army; that said Green sold large quantities of smoking-tobacco to the soldiers; and

from the fact of the circumstances of the surrender at that place, he believed that the name "DURHAM" would be popular. He said that the word "Durham" was first applied to smoking-tobacco in 1865.

§ 655. The preliminary statements conflicted as to the date of the adoption of the word "Durham" as a mark for tobacco, and as to the ownership of the right to its exclusive use. The controversy could not be determined without further action. The statements furnished insufficient data for final judgment. The preliminary interference was at an end.

§ 656. An interference proper was then declared, and due notice served upon the parties, by mail. The notice was in the form of an official letter from the Commissioner of Patents, informing the parties that their claims to the exclusive use of the mark were adjudged to interfere with each other, and that a hearing would be granted them upon a certain day; that the testimony of the applicant must be closed at a day fixed, and that of the respondent at a later day; and that, at a still later day, rebutting testimony, but no other, might be taken after the closing of the testimony-in-chief. Ample time was given by the Office, regard being had to the location of witnesses and parties.

§ 657. The next step in the litigation was the taking of testimony in behalf of the applicant, for he was obliged to prove his case before his adversary could be called on to respond. Due notice having been given, Armistead proceeded to take depositions, the respondent appearing by counsel and cross-examining. A similar course was then pursued by the other side; just as if the cause were pending in a Circuit Court of the United States. Then came the hearing, after which this decision:—

In the U. S. Patent Office.

LOUIS L. ARMISTEAD, OF VIRGINIA *v.* WILLIAM T. BLACKWELL,
OF NORTH CAROLINA.

Interference — Trade-mark.

BROWNE, *Special Examiner*:

This matter was brought on for argument before me, the undersigned, on Monday, April 15, 1872, when it was elaborately argued by A. H. & R. K. Evans for the applicant, and by Cox & Cox for the respondent.

Voluminous testimony was filed and commented upon, it consisting principally of the record of a suit in the Circuit Court of the United States for the Western District of Virginia, between the same parties, and involving substantially the same main issue.

Before attempting to sift the testimony and apply the law, it is necessary to have a clear conception of the exact point in controversy.

Wherein consists the trade-mark in dispute?

There are two theories on this subject. The applicant insists that the essence is comprised in a single word, "Durham," used in conjunction with the words "Smoking Tobacco." By referring to the specification of applicant, filed December 6, 1871, we find that those are the words claimed by him. In the specification of the respondent, filed April 14, 1871, and registered October 3, 1871, we find that he describes his trade-mark as consisting of the words "Durham Smoking Tobacco, manufactured by W. T. Blackwell." The bill in equity in the suit above-mentioned, among other things, prays that the applicant be restrained from using any trade-mark containing the word "Durham."

What is the essential part of the mark?

It cannot be the words "Smoking Tobacco," for such names

in common use cannot be appropriated. The rule upon the subject of *generic* words, or words denoting quality, is so universally settled and acquiesced in, that authorities need not be cited in support thereof. Nor can the words "Manufactured by W. T. Blackwell," for such language is in the nature of a mere advertisement, and cannot, by any possibility, be deemed to constitute any part of the symbol known to commerce as a trade-mark. (See *Falkenburg v. Lucy*, in the Supreme Court of California, 35 Cal. 521; and also the *Leather Cloth Co. v. The American Leather Cloth Co.*, in the House of Lords, 11 Jur. (N.S.) 513.) Therefore the proposition that the applicant has simulated the trade-mark of the respondent by a *part-imitation* cannot be entertained. The whole, if any part, of the lawful mark has been pirated. If any word in Blackwell's registered mark possesses the essential attributes of the symbol known to commerce as a trade-mark, that word is "Durham."

But the respondent's counsel, in their first point, deny that by any possibility this word can be a trade-mark, and say it is liable to almost every objection that can be suggested. In support of this idea, they cite the recent case of *The Delaware and Hudson Canal Co. v. Clark*, in the Supreme Court of the United States. (Official Gazette, 1872, p. 279.)

Let us pause and consider the position of the respondent. "Durham" being the only word that can possibly be deemed essential in this case, how stands Blackwell if it cannot be supported as such? His objection is a two-edged sword. If one fails upon that point, so must the other.

What did the case cited by respondent's counsel decide? It simply reaffirmed the doctrine of the *Brooklyn White Lead Co. v. Masury* (25 Barb. 416). When two or more persons manufactured white lead in the city of Brooklyn, each had the right to describe his product as Brooklyn white lead. The exact point which turned that case against the defendant was this: he had fraudulently assumed the word "Company" or "Co." for the purpose of diverting the plaintiff's trade. It was purely

an instance of unfair competition in business. Careful analysis will demonstrate that it was not a trade-mark case, notwithstanding the fact that it is oftentimes referred to as such. In the case against Clark, above cited, known as the Lackawanna coal case, the court held that the name of a region of country cannot be appropriated to the exclusion of others who produce or who sell a similar article coming from the same region; therefore, as the complainants are not the sole owners of the coal-mining district of the Lackawanna, they have no exclusive right to the use of the words "Lackawanna Coal."

The same counsel also cited *Newman v. Alvord* (49 Barb. 588). In that case the court substantially concedes that the plaintiffs, by their prior appropriation of the name of the town of Akron, in connection with the words *cement* and *lime*, acquired no exclusive right to its use as against any one who could use it with equal truth. A careful examination of that case will disclose the fact that it was not strictly a case which involved a technical trade-mark; for to be a trade-mark, the right to its use must be *exclusive*. A laborious perusal of published authorities has failed to produce an instance of any court of any country admitting the possibility of the existence of a "neighborhood trade-mark." For our present purpose it is sufficient to refer to sec. 77 of the Act of Congress of July 8, 1870, in regard to trade-marks, which promises protection only to the person entitled to the *exclusive* use of any lawful trade-mark.

Therefore it is perfectly clear that if the word "Durham" is used for the purpose of indicating to the public that the merchandise to which it is affixed is manufactured or sold at a place called Durham, it is not what the law recognizes as a trade-mark; but it comes within the principle of *Falkenburg v. Lucy*, and the Leather Company case, above cited, and is a mere advertisement. Now comes an important question:

Did the applicant use the said word "Durham" as the name of a locality?

In an ordinary case of litigation, it would be sufficient to reply that the party making an objection is estopped by his admissions upon the record. If the objection were tenable, then this interference should be dissolved, for neither party would have any standing before this tribunal. But it is necessary to proceed further, for this reason: By section 79 of the Trade-mark Act of 1870, the Commissioner of Patents is prohibited from recording any proposed trade-mark which is not and cannot become a *lawful* trade-mark. This section confers judicial functions, at least to the extent of inquiring into the legality of every proposed trade-mark offered for registration, *ex parte* or otherwise.

This matter cannot be decided upon any thing in the nature of pleadings, or upon concessions. Consent cannot give jurisdiction. The applicant must not only have as good a right as any one else, but his right must be perfect. He must succeed, if at all, by his own strength, and not by the weakness of his adversary. If the Office erred in granting registration to Blackwell, that is no reason why it should repeat the error for the purpose of placing the parties upon the same footing before the courts, as one of the counsel suggested. Even if the Office should refuse registration, the rejected party might still fall back upon the common law, as a party litigant. This brings us back to the consideration of the question as to the meaning of the word "Durham," as used.

If the word is used in its geographical sense, it means but one place, a village in North Carolina. That is expressly conceded by both parties, and is warranted by the evidence. It was at a place bearing that name, or one nearly like it, that the applicant or his assignor commenced business as a manufacturer of smoking-tobacco, so long ago as 1859 or 1860. It is there that the respondent alleges that he now carries on the same kind of business. It is there that a number of witnesses reside and manufacture tobacco. We have not the slightest suggestion that any other place named "Durham" is meant.

It is true that several towns in the United States have that name; but they are excluded from consideration in this case, as the name means a place in North Carolina, if any thing.

Is there such a place as *Durham* in North Carolina? We would be left in some doubt upon this point if we depended entirely upon the language of the witnesses. Some of them speak of "Durham;" some of "Durham's;" some of "Durhams," and some of "Durham's Station." Which is correct? We turn to the official list of post-offices, and find that it is spelled *Durham's*; the apostrophe probably signifying, elliptically, Durham's Station. We finally hesitate to take judicial notice of the fact, and ask for the official certificate of the Acting First Assistant Postmaster-General, on file as an exhibit in this case. This is dated March 25, 1872. It says: "On examining the records of the Department it is ascertained that there is a post-office in Orange county, North Carolina, by the name of *Durham's*, and that Presly J. Mangum is the present postmaster," &c. That settles the question. The name is "Durham's."

The word "Durham," as used by both parties, is not so used to indicate any locality. We may reasonably so infer. The Office has virtually so ruled in granting registration to Blackwell. The evidence on file abundantly proves it. On the part of Blackwell and his predecessors, a representation of a Durham-bull was, and still is, used in connection with the word "Durham." What is it used for? The evidence overwhelmingly shows, that it is used to indicate to the public that the tobacco having that name had a peculiar excellence. That indication may be true, or it may not. The purchaser asks for the "Durham" brand, because it is his choice. Witnesses swear that it has a *peculiar* flavor, and say that ever since 1860 it has been known and used as a superior kind of manufacture. It would be idle to doubt that the article has agreeable properties, from the manner in which the tobacco is flavored with certain aromatic herbs, or other ingredients.

It is not pretended by any one that the tobacco is raised at Durham's Station ; or that, if it were, that the soil of that locality possesses any peculiar properties to make tobacco grown thereon better than any other. The witnesses swear that it is the peculiar flavoring imparted by the tonqua-bean and other ingredients. What ground is there for rational doubt? The article manufactured in a particular manner is the thing meant.

If that were not so, then all the tobacco-manufacturers at Durham's had a right to use the same name. But Blackwell could not have so meant when he commenced to use the word "Durham;" for in his *sworn* statement, filed April 14, 1871, in applying for registration, he positively sets forth "that no other person, firm, or corporation has a right to use said trade-mark, or any one substantially the same, or one wherein or whereon the word 'Durham' is used in connection with the words 'smoking-tobacco,' upon any tobacco or package containing the same." This is irrefragable evidence to show that he did not then consider the word "Durham" as the mere name of a place; for at Durham's Station, at that very time, there were a number of other independent manufacturers, all equally entitled to use the name of their village as a geographical designation.

This does not concede, as law, that a geographical name cannot be the subject-matter of a trade-mark. It generally cannot be, for the reason given in the Lackawanna case. Mr. Justice Strong, in delivering the opinion of the court in that case, said: "Could such phrases as 'Pennsylvania wheat,' 'Kentucky hemp,' 'Virginia tobacco,' or 'Sea-Island cotton,' be protected as trade-marks?" All have an equal right to use those names when they truthfully indicate the goods to which they are applied. But this rule has some exceptions. A word which in one sense may be coincident with the proper designation of a region of country or a town, may be put to another office. The leading authority on this point is the celebrated

“Anatolia” case, *McAndrew v. Bassett* (10 Jur. (N.S.) 550). The Lord Chancellor therein said: “I am told that this word ‘Anatolia,’ being a general expression, — being in point of fact the geographical designation of a whole country, — is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist, but property in that word as applied by way of stamp upon the liquorice does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances that render the article so stamped acceptable to the public.” *The Congress and Empire Spring Co. v. The High Rock Congress Spring Co.* (57 Barb. 525, and 4 Am. Law Times R. (St.) 168) affirm the same doctrine, “Congress Spring” being there held, under its peculiar circumstances, to be a perfectly good trade-mark.

In France the same ruling has been made in the Tribunal Civil of the Seine (*Faivre v. Duguairre*, *Annales de la Propriété*, etc., tome viii. p. 238), where it was held that the words “Mount Carmel,” although a geographical name, was, as a fancy designation, a good trade-mark. These rulings are all consistent with reason, and harmonious with the current of decisions.

We now come to the question of priority of adoption.

The testimony in the two hundred and twenty-nine pages of the record has been sifted.

Blackwell’s witnesses furnish a considerable amount of negative testimony as to the time of the first use of the word by any one as a trade-mark. They do not go further back than the year 1865, when the predecessor of Blackwell commenced to use it. If uncontradicted, their statements would be convincing, notwithstanding the fact which some of them disclose

that they are also manufacturers of smoking-tobacco, and are interested in defeating Armistead. But the applicant brings forward a large number of witnesses, whose statements overwhelmingly establish the fact, beyond doubt, that the word was used some years before 1865. Wright, the predecessor of Armistead, swears that he used the word in 1860, and continued to use it after he had removed his factory from Durham's, and until he entered the army (Rec., pp. 236, 237). If faith should be placed in the oaths of apparently entirely credible witnesses, then, beyond the shadow of a doubt, the word was used in 1860, and ever since, to designate a *peculiar* kind of tobacco.

What tobacco was that? It was a peculiarly-flavored smoking-tobacco, which acquired its reputation so far back as 1860. It was the smoking-tobacco that Wright made; substantially that for which he subsequently obtained letters-patent. This is not a mere inferential conclusion. It is fully corroborated by the evidence.

The applicant, Armistead, deduces any title he may have to the trade-mark from Wesley A. Wright, who at one time certainly did possess a certain trade-mark. That trade-mark was affixed to a certain label containing a number of other words, as "Morris & Wright's Best Spanish Flavored Durham Smoking Tobacco," or whatever the words may be. The counsel for Blackwell argues that Armistead must take the whole brand used by his predecessor or assignor, and that he cannot change or vary it in the least.

That would be true if the whole brand or label were a trade-mark, but the brand or label was but the vehicle of the mark of commerce, that symbol which becomes associated with a particular article of merchandise. We have seen that the only essential element of the trade-mark is the word "Durham." When an exclusive title to that was once acquired, its owner might use it as an isolated emblem, or he might combine it as he pleased. The courts of all nations concur in this doctrine.