

by the photo-lithographic process, without charge, the same as in patent cases. But if the representation of the trade-mark be a print, tag, or medal,<sup>1</sup> 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.<sup>2</sup>

§ 577. *Amendments.*— The power to amend application papers is limited.<sup>3</sup> If this were not so, all the material facts and allegations might be so varied from the original statement as entirely to change its character. After a first rejection, the applicant generally has a right to amend; but this is not always so; for the sworn papers may bear upon their face the most conclusive evidence of fraud, and a party be estopped from contradicting his own allegations. A rejection under circumstances which display a lack of good faith may be regarded as final. Suppose, as frequently happens, the applicant shows that he is endeavoring to usurp the credit that belongs to a rival trader, by a servile imitation of his mark, he cannot well complain if he is refused a second hearing. He may, however, appeal to the Commissioner.

§ 578. No amendment is permitted to enlarge the scope of the claim, unless upon supplemental oath or its equivalent.<sup>4</sup> Solicitors of experience have, in many instances, so far disregarded the spirit and reason of this rule as completely to transform the original case. The papers are found to be deficient in essential averments. The solicitor, perhaps mechanically, draws an amendment, striking out this, and inserting that, with great recklessness of consequences. He sometimes attempts to amend the sworn declaration, usually termed the *oath*, by substituting words, or adding new allegations.<sup>5</sup> He does not stop to think that he is thereby perverting evidence, and that he might as well interpolate new statements in a deposition after execution, or words in a deed after delivery.

<sup>1</sup> See *ante*, § 89, for examples of peculiar emblems: colored threads, a band of gilt paper, medals, miniature metallic bell, etc.

<sup>2</sup> Trade-Mark Rule 9.

<sup>3</sup> It must be warranted by something in the statement or fac-simile as originally filed. Trade-Mark Rule 12. See also General Rule 71.

<sup>4</sup> See *ante*, §§ 311, 312, 313, as to verification.

<sup>5</sup> See requirements of Trade-Mark Rule 12.

Nor does he pause to reflect that such irregularities completely vitiate a case, and virtually destroy all value of registration, and leave it without efficacy. A court is bound to adjudge a certificate to be void, when the record shows it to have been granted upon falsehood, or disregard of the sanctity of an oath. Even if new matter in a declaration be in fact true, it is in effect false, unless properly sworn to. But suppose that no such glaring irregularity has been committed, and that so far as form is concerned the party has sworn to his amendment, even then he *may* be refused a favorable consideration; for he is not entitled for a single fee to the judgment of the Office upon two different cases.<sup>1</sup> He cannot be allowed to amend by substituting another symbol as his mark.

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

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

<sup>1</sup> Re J. C. Cooke, Com. Dec. 1871, p. 312.

<sup>2</sup> See that admirable book, Junkin on the Oath.

only presumptive. What becomes of confidence, when an examination of the original file in the Patent Office discloses the fact that the sworn declaration has been tampered with, — that after the oath was administered interpolations have been made, and erasures and interlineations have materially changed the meaning of important allegations? Attempts to pervert the oath are daily made in the Patent Office, — how oftentimes with success, need not be told. Suffice it to say, that, if the paper bearing the record stultifies itself, the registration is a nullity.

§ 581. *Prima Facie Right to Mark.* — The Office will not always question the right of the applicant to the use of a certain mark, although there may be circumstances of a dubious nature. Cases there are in which statements not strictly true may readily be corrected. Thus, in the following case, the oath of a party was deemed of sufficient weight to remove all doubt of the right to use the name, etc. of a foreign house. The mark, which is for brandy-bottle caps, is described as consisting of a circular colored border surrounding a white or metallic ground containing a coiled belt or band consisting of two circles, with a vertical bar with buckle or fastening device, surmounted by a crown, and enclosing the letters "O. D.," the "O." being on the left of the bar and the "D." on the right. Within the border, and forming a semicircle above the crown, are the words "Otard, Dupuy, & Co.," and at the bottom of the white ground below the circles is the word "Cognac." In the space between the words "Otard, Dupuy, & Co." and "Cognac" are two stars. There was a momentary hesitation on the part of the Examiner. He asked himself, Have the applicants a right to use the name of the French firm? May not this mark, without some qualification, be apt to mislead the public? May this mark not prove to be an exact fac-simile of that of a foreign house? How can even a license to use it be presumed? Is this proposed mark to be affixed to genuine imported brandy? The records of the Office show that, some months earlier than the date of the pending application, the same applicants had obtained registration of a mark for liquors exported or sold by Otard,

Dupuy, & Co., of Cognac, France, in which matter the applicants are described as agents for said house. The registered mark (No. 739) and that which was then pending are, in legal effect, nearly identical. *Conclusion*: "The foreign house has a large trade with this country, and therefore may be presumed to jealously guard against encroachments upon rights which are allied to those of their customers. They may easily protect themselves in the courts. Besides, the applicants are in a line of business in which they have many vigilant competitors. If, by possibility, there be error, it can readily be rectified. A *prima facie* case has been made out. Registration allowed."<sup>1</sup>

§ 582. The Examiner sees enough to put him on inquiry. A single word, perhaps, is submitted as the essence of the mark. A single word, — but how much may that single word contain! A word may be a wonderfully involved bud, which, when breathed upon, unfolds and develops a complexity of ideas. It may be as simple in appearance as an acorn, and yet enclose interests as wide-spreading as the roots and branches of an oak, with ramifications touching business matters of a myriad of persons. Take as an example the word "Chartreux," (signifying a Carthusian friar,) which for many years, in a multiplicity of suits, has figured before the courts of France. One of the infringers had taken the feminine form of the word. Of that, the Court of Cassation said, in 1872:<sup>2</sup> "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,

<sup>1</sup> Re Cazade & Crooks, No. 993.

<sup>2</sup> Le Père Louis Garnier v. Paul Garnier, 17 Annales, 257.

“Chartreuse,” is the enunciation of the mental conception: the written word is the symbol of that enunciation. The arbitrary sound of the voice is intimately combined with the conceptions of the mind, and the arbitrary vocal sound is connected with a symbol still more arbitrary, addressed to the sight. The symbol excites in other minds the thoughts that it was meant to call up, by the association of ideas.<sup>1</sup>

§ 583. *Indefiniteness.*<sup>2</sup> — A so-called description of a trade-mark may be so indefinite as really not to convey the least idea of the intention of the applicant; as when, in an elastic-suspender case, the mark — which was said to consist of a man’s face printed or stamped on the front side or surface of the suspender, near the front end — had been generally applied, as read the specification, “with some sort of ornamented design, printed above and below the figure, with the name of the person represented by the picture under it, as shown. But the ornamented design, on the top or bottom, or at both places, may be omitted, or some other design substituted for that shown, and the *name* of the person whose likeness is printed on the suspender may be omitted, without materially changing the character of my trade-mark; the essential feature of which is, the picture of a person printed upon the face of the web or fabric.” The applicant claimed two peculiarities, viz.: “1. A picture — on the front of the suspender — of some personage of national or historic reputation of notoriety; 2. Having a face on the web, which is generally more or less elastic, the expression of which may be varied by stretching the material.” The applicant also stated that he proposed “to change the likeness given in the picture, as expediency may require.” To this the Examiner, after pointing out contradictory recitals in the specification, ended his decision thus: “This case presents none of the characteristics of the fixed, invariable, unmistakable, definite symbol termed a trade-mark.”

§ 584. The reader can for himself analyze this specification. What was claimed? A man’s face, *any* man’s face, and that

<sup>1</sup> See *ante*, Chapter IV., “Indication of Origin or Ownership.”

<sup>2</sup> See *ante*, § 89, on this point.

face to be changed at pleasure. But even the lineaments of that face were not to be permitted to remain in placidity; for, being printed upon elastic suspenders, the features would be contorted by each strain upon the webbing. But then there was an ornamental design above and below the face, and the name of the person whose face was represented! True, but the ornament and the name were both dispensed with at the will of the manufacturer. In a suit for infringement of a trade-mark evidenced by such a specification, how could conviction of imitation possibly follow? If such a broad claim were inadvertently allowed to escape the scrutiny of the Office upon an *ex parte* showing, it could not possibly form the basis of any judicial demand. And yet this very specification had been drawn by an experienced patent attorney, who had not become imbued with the subtle refinements of the law of trade-marks. He for a while refused to be comforted, and appealed; but, upon maturer consideration, he amended and limited his specification, and obtained a certificate of registry.<sup>1</sup>

§ 585. We cannot always be guided by the verbal description of colors which may be essential elements of a trade-mark, or may be the ground of the label bearing it. Endless confusion would result unless we were permitted to lay the conflicting marks or labels side by side, and inspect for ourselves. What court or jury would rely upon witnesses in such a matter? for witnesses may honestly disagree in attempting to impart an intelligible idea of colors and shades. A writer<sup>2</sup> 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

<sup>1</sup> Re James Twamley, No. 860.

<sup>2</sup> Sir J. Gardiner Wilkinson, "On Color," etc. London, 1858.

brown tinge); and gray is also called 'blue' (*glas*), — hence *glastum*, a name of woad." When we come to tints, the mind is lost in a maze. The Roman artists say that more than 30,000 tints are used in mosaic. A slight variation in the colors employed in a mark for goods may change its whole aspect, just as a deepening of the natural shade of eyebrows or the addition of a few bits of court-plaster may so change the facial expression of a fair lady as to make us doubt her identity. In a trade-mark there must be no doubt.<sup>1</sup> To judge of an alleged similarity between two trade-marks, we must place them together. If calculated to create confusion, one is an infringement on the other; but if the public can readily distinguish between them upon a casual inspection, there is no confusion. Let us take a case.<sup>2</sup> The applicants say that the design shown in the drawing is a true copy of their trade-mark for base-balls. We see the representation of a red ball, with an imitation of its seams, and we read the words "Dead Red Ball," the name of the firm of the applicants, and a description of the weight and circumference of the real ball. What is the essential feature of the mark? We are not told in the specification. One who has a right to make the article (a base-ball) may lawfully make a picture of it; and there is no pretence that the applicants have a monopoly. What guides the purchaser in his selection? It is the *red* color of the ball, more than the words. Then the red ball is the trade-mark, if anything in the whole device comes up to the requirements of the law. That being the case, no one else has a right to the same mark for the class of goods to which this is applied. But any person is at liberty to use a blue ball, or a green ball, or indeed one of any color or shade that could not be mistaken for that described. The shape is not a mark in this case. Nor was it in the case of *Ricque et al. v. Forge et al.*,<sup>3</sup> 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

<sup>1</sup> See *ante*, §§ 263 *et seq.*, on Color as an essential element of a Trade-Mark.

<sup>2</sup> *Re Peck & Snyder*, No. 46.

<sup>3</sup> 8 *Annales*, 25.

bordering of two *red* threads, wherefore they were adjudged to be counterfeiters. Now, in either of these cases, witnesses might well disagree in naming the peculiar color used. What is *red*, and what is *rose-color*? The necessity of ocular examination is obvious.

§ 586. *Breadth of Claim.* — This matter is entitled to more consideration than it usually receives from applicants. Things material are so united with things immaterial as to detract greatly from the value of a mark. Sometimes so great ingenuity seems to have been exercised to narrow down a claim, that one cannot but wonder at the folly. When a broad claim can be maintained for a word, for example, why encumber it with a collection of other words? Look at the consequences in case of encroachment upon the mark. The word is so hedged about by unimportant things, devices, or words, that it is almost impossible to convict of counterfeiting. The name of a firm, or of the place of manufacture, the term “warranted,” and other words not really any part of the mark sought to be protected, detract from its strength; and the pirate finds a sure refuge behind the veil of uncertainty. — The highest court in France, in 1884,<sup>1</sup> held that the matter registered is an indivisible unit, and must be taken as a whole. The plaintiff had, in his registry, described his trade-mark as consisting, essentially, of the words, “Papier hygienique, vrai Papier Goudron de Norwege, extra, fabricants Joseph Bardou et fils, Perpignan”; and although the defendant had usurped the only valuable part of it, “Papier Goudron,” it was held that the plaintiffs had no remedy.

§ 587. Suppose, for the sake of argument, that the essence of the trade-mark is the word “Anchor.” By the time that a superior description of goods may have obtained a solid reputation in the market, and the word “Anchor” as an arbitrary symbol is the only thing that the purchaser looks at to assure himself of the genuineness of manufacture, an imitator appears. He is sued for infringement. He defends himself on the plea that the mark described by the plaintiff is so indefinite that he could not make it mean anything in

<sup>1</sup> *Bardou v. Lacroix*, 29 *Annales*, 226.



particular; and that, as he took but one word out of many words used in the mark of his rival, he cannot be liable. On inspection of the mark of the plaintiff, as registered, it is found that the word "Anchor," although it was that only which he desired to protect, is preceded and followed by the name of the party, his place of business, and the announcement that his wares are the justly-celebrated, world-renowned, best-class goods. He is taught a lesson. He learns that in this instance simplicity is strength. His case is dismissed. Nor is that always the worst result. He may find that, while he has nothing but an elaborate mark, which is entirely worthless, his triumphant adversary has established apparent right to the exclusive use of the simple, yet valuable, word-symbol "Anchor." The evil could have been avoided by a simple averment in his specification that the essential element of his mark consisted of that word-symbol. A lack of precision of phraseology may destroy trade, the soul of which often depends upon the recognition of a symbol. "A word fitly spoken is like apples of gold in pictures of silver." The declaration in an action on the case requires no greater discrimination in the use of the exact word than does a specification.

§ 588. The claimant of an alleged trade-mark may, by too great breadth, dissipate all his pretensions, and thwart his own object. By attempting to grasp too much at once, he puts himself in the position of the greedy boy with the apples, and is left empty-handed. The representation of an object, a word, or emblem, does not become a trade-mark until actually associated with a particular description of goods. How can a man hope to make a claim broad enough to cover all kinds of merchandise? Or how can he even think that a device can be set forth to cover a hundred forms of the same thing,—as "an eagle in any form or position"?<sup>1</sup> 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"?<sup>2</sup> The representations of eagles and of crowns are almost infinite in number. In the latter case, the appli-

<sup>1</sup> Ex parte H. M. Rowe & Co.

<sup>2</sup> Ex parte Thompson, Langdon, & Co.

cants averred that they had already registered one form of a crown for the same class of goods; and that now, by way of precaution, and in order to avoid any question as to the meaning and scope of their former description, they desired to include all other crowns. The answer was, that the claim was too indefinite, and in fact was anticipated by the former case of the same parties. The opinion was also volunteered, that the applicants were protected against the use by wrong-doers of any device substantially the same as that already registered, or so nearly resembling it as to be calculated to deceive. This *dictum* correctly states the law.<sup>1</sup>

§ 589. A case like the following could not be recognized as entitled to registration, or as sufficient foundation for any redress under the law peculiar to trade-marks: "The mark consists of a tattooed initial letter, which may be any letter of the alphabet, stamped upon the upper-crust of the pie; as, for instance, the letter A will stand for apple; B, for blackberry; C, for currant, etc. Below this single initial we stamp the letters 'C. P. B.,' standing for Connecticut Pie Bakery."<sup>2</sup>

§ 590. One of the most remarkable applications ever filed was as follows. The claimant<sup>3</sup> represented that he was doing business under the name and style of the "New Era Company," in the city of New York, and was engaged in the publication and distribution of books, papers, and tracts; and also in the manufacture and sale of various articles of use, consisting *in part* of tacks, nails, locks, bolts, butts, saws, files, axes, hammers, bits, augers, planes and plane-irons, shears, scissors, pocket and table cutlery, spoons, lemon-squeezers, pins, needles, slates, hay and manure forks, hoes, spades, shovels, rakes, scythes, ploughs, carpet-stretchers, tack-claws, apple-parers, cherry-pitters, stove-polish, silver and plated ware, gold and silver watches and jewelry, and general cast and wrought hardware. He desired, therefore, to register as his trade-mark for said goods a star, with the words "New

<sup>1</sup> See *ante*, § 89 *d*, "A General Type of Objects," etc.

<sup>2</sup> *Ex parte* Case & Martin.

<sup>3</sup> *Ex parte* W. M. Evans.

Era" in the centre, etc. The decision of the Examiner reads thus: "Such an *omnium gatherum* was never contemplated as a subject of a trade-mark. Not more than one class of merchandise can be included in a single application, while this case may embrace forty thousand most incongruous things. It is not understood how one person can constitute, by himself, the 'New Era Company.' This requires explanation. . . . Case suspended for reconstruction."<sup>1</sup>

§ 591. *Degree of Specificness.*— This no rule can designate except in a general way. It is a rule, that *the declaration must state everything that is of the essence of the cause of action*; and that is of the essence of the cause of action, *without which judgment cannot be given.* The dropping of a word may be the drawing of a rivet upon which depends the whole case. Omit any of the conditions precedent, and the Office has no jurisdiction. For example, *domicile* of a person or firm in the United States is in some cases required by section 1 of the act of 1881, and therefore is a necessary averment. In case of a corporate applicant, the exact name thereof, and the authority giving it existence, should be averred. So, also, of residence and place of business, and of many other facts. But surplusage is to be avoided. When the applicant is a resident of or located in a foreign country, it is not necessary to allege the existence of a treaty or convention of reciprocity; for official notice will be taken of all such matters.

§ 592. It will not be a waste of time to analyze the following hypothetical application papers. Every fault indicated has been committed by one applicant or another, while sometimes a single case is found to be marvellously replete with errors.

<sup>1</sup> At that time there was a State law against such a fiction. So also the New York laws of 1883, sect. 1, ch. 281, provide that, where the designation "Company" or "Co." is used, it shall represent an actual partner or partners. But it was held by the Court of Appeals, in 1884 (*Gay v. Siebold*, 31 Alb. L. J. 273), of this law, that "it does not compel partners to disclose their true names in the partnership designation. They may still do business under any style, not untruly containing the name of any person, which they choose to assume, such as the 'Union Towing Company,' the 'Eureka Company,' or other fanciful names. (*Crawford v. Collins*, 45 Barb. 269; *Wright v. Hooker*, 10 N. Y. 51.) . . . Even an individual may transact his business under such a name without violating the statute."

This is not the curious workmanship of a precisian, but a truthful exemplification of every-day practice. Bear in mind that these are FALSE MODELS, *not to be followed*.

#### PETITION FOR REGISTRATION.

“ *To the Commissioner of Patents : —*

“The petition of Antonio Gomez respectfully represents, that he is the senior member<sup>1</sup> 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,<sup>2</sup> Louisiana.

“That he alone and with others and the said firm<sup>3</sup> have used<sup>4</sup> trade-marks<sup>5</sup> for said articles,<sup>6</sup> which trade-marks consist of the printed labels<sup>7</sup> herewith filed,<sup>8</sup> or substantial copies<sup>9</sup> thereof. No. 1, containing the words, ‘Otard, Dupuy, & Co., Cognac,’ surmounted by a ducal crown and the letters ‘OD’ inside of a circular representation of a strap or belt, is to be applied to our manufacture<sup>10</sup> of brandy.<sup>11</sup> This is an excellent imitation of the imported arti-

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

<sup>2</sup> No such county. It should be, “Parish of Orleans.”

<sup>3</sup> 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*.

<sup>4</sup> When? — for how long a time? (See subsect. 1 of sect. 1 of the act of March 3, 1881.)

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

<sup>6</sup> The words “said articles” include brandy and other liquors; but to what number, and of what kinds, we are not informed by the papers in the case. Nor need we care to know. Said section 1 calls for a statement of “the class of merchandise and the particular description of goods comprised in such class.” *One class*, and no more, is contemplated by the statute.

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

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

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

<sup>10</sup> 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.

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

cle, is chemically pure, and medicinal,<sup>1</sup> and is generally pronounced by good judges to be superior to that brought from Europe.<sup>2</sup> The names ‘Otard, Dupuy, & Co.’ are only used as a fanciful emblem, and have no intention to mislead as to origin;<sup>3</sup> and indeed our label differs in several particulars from any label used by any such concern.<sup>4</sup> Nos. 2, 3, 4, and 5, containing the names of different kinds of liquors,<sup>5</sup> 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,<sup>6</sup> or so nearly resembling them as to deceive the public.<sup>7</sup>

“He therefore prays that the said lawful trade-marks<sup>8</sup> may be granted<sup>9</sup> to him, as by law provided.

“ANTONIO GOMEZ.”

AFFIDAVIT.

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

“Antonio Gomez, being sworn, says that the foregoing statement by him subscribed is true in substance and in fact, as he verily believes; and that he and his partner reside at Havana, in the island of Cuba, and are subjects of the king of Spain.<sup>10</sup>

“NAPOLEON JONES, *Notary Public.*”<sup>11</sup>

<sup>1</sup> Surplusage, even if true. *Falsus in uno, falsus in omnibus*, — False in one particular, false in all.

<sup>2</sup> It is not allowable to deceive the public, even for their own benefit.

<sup>3</sup> 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.

<sup>4</sup> An admission of an attempt at evasion.

<sup>5</sup> Even if more than one kind of liquor could regularly be embraced by the same application, this mention of “liquors” would be too indefinite.

<sup>6</sup> The language of section 2 of the statute must be more fully followed.

<sup>7</sup> The law says, “to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.” (Sect. 3.)

<sup>8</sup> A misnomer, as is evident from the circumstances.

<sup>9</sup> The Patent Office has no power to *grant* a trade-mark. It receives and records it, and issues a certificate of registry. It has no creative power.

<sup>10</sup> It gives some degree of satisfaction to learn from the applicant that he had no legal standing before this tribunal. Neither he nor his firm was domiciled in the United States. (There is now a treaty between Spain and this country which gives an application a right to be entertained: April 19, 1883.)

<sup>11</sup> The notary has omitted to affix his official seal, which is indispensable

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

#### PETITION FOR REGISTRATION.

“*To the Commissioner of Patents: —*

“Your petitioners<sup>1</sup> respectfully represent, that the Union Land Company,<sup>2</sup> composed of A. Bell, Ch. Dolan, Ed. Foy, G. Ham, and I. K. Lane,<sup>3</sup> is engaged in the manufacture<sup>4</sup> of pamphlets and cir-

under the act of Congress of Sept. 16, 1850. Rev. Stats., sect. 1778. No State regulation can affect this positive requirement. *A verbis legis non est recedendum.* (See Patent Office Rule 46.)

<sup>1</sup> One glance of the eye shows that there is but a single petitioner.

<sup>2</sup> 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, etc., as directed by Trade-Mark Rule 6. If a corporation, the names of corporators should not be alleged.

<sup>3</sup> When names of persons are used, the same should be stated in full, mere initials not being names in law. (See said Rule 6.)

<sup>4</sup> “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.

culars to advertise their business<sup>1</sup> as a land-improvement concern,<sup>2</sup> at Baltimore County,<sup>3</sup> Maryland, and are entitled<sup>4</sup> to the exclusive use upon the said articles manufactured by them of the trade-mark described in the specification and accompanying labels,<sup>5</sup> said trade-mark having been duly assigned to them,<sup>6</sup> for a valid consideration paid by said company to the original designer and inventor thereof.<sup>7</sup>

“They therefore pray that the said company may be permitted to obtain protection<sup>8</sup> for said trade-mark, and letters patent, or a copyright therefor,<sup>9</sup> under the law in such case made and provided: And they<sup>10</sup> do hereby appoint Simon Shallow, of said Baltimore, or his substitute,<sup>11</sup> their true and lawful attorney, to make all necessary alterations and amendments<sup>12</sup> in and to said trade-mark to receive the protection,<sup>13</sup> and to transact all business in the Patent Office connected therewith.

“A. BELL, *President.*”<sup>14</sup>

<sup>1</sup> “Pamphlets and circulars to advertise their business.” All idea of an emblem of trade is at once dispelled.

<sup>2</sup> A land improvement concern can hardly be supposed to vend goods, wares, and merchandise.

<sup>3</sup> Unhappily worded, to say the least.

<sup>4</sup> In what capacity, — as individuals, firm, or corporation?

<sup>5</sup> “Labels” should be struck out, and “fac-similes” substituted.

<sup>6</sup> Where a party claims by *assignment* or *alienation*, the nature of the conveyance and alienation should be stated (Stephen on Pleading, 304, 311, 436). Either a certified copy of the assignment should be attached to the application papers, or, if the same shall have been filed in the Office, a reference should be made to it. Especially is it necessary to be introduced as an exhibit in this case, to show whether the transfer was made to *it*, the company, or to *them*, the individuals. If assigned to *them*, it seems that the *company* paid the consideration. Misty enough!

<sup>7</sup> An inventor has no property in a design, unless it is patented as an adjunct of a manufacture. Actual use is the criterion of adoption of a symbol as a trade-mark. Intellectual conception has nothing to do with a mark, as an emblem of commerce. No title could therefore be deduced from “the original designer and inventor.”

<sup>8</sup> 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.

<sup>9</sup> Neither letters patent nor a copyright can apply to a trade-mark case.

<sup>10</sup> *They* do not appoint, for the paper is signed by but one, who styles himself “President.”

<sup>11</sup> At all events, the *substitute* could not be appointed except by Simon Shallow.

<sup>12</sup> No alterations or amendments can be made in a trade-mark without destroying its identity. If altered, it becomes something else.

<sup>13</sup> Meaning the certificate of registry.

<sup>14</sup> If this really is meant for an appointment by an incorporated com-

§ 594. *Specification* describing a trade-mark for pamphlets and circulars used by the "Union Land Improvement Company,"<sup>1</sup> of Baltimore, Maryland.

"Our trade-mark consists of the design<sup>2</sup> as fully represented and described in the annexed cut or drawing,<sup>3</sup> composed in part of the words 'Union Land Company' with our initials<sup>4</sup> on a shield; but the said shield and initials may be omitted, or any other design be substituted therefor, or *vice versa*.<sup>5</sup>

"The most<sup>6</sup> essential features of this trade-mark are the words mentioned, and the shield when used,<sup>7</sup> together with the advertisement<sup>8</sup> of the company, and notices of the valuation of building-sites, etc.; but these or any of them may be varied or omitted according to circumstances.<sup>9</sup>

"This trade-mark, consisting of the parts described, we have used in our business of publishing for some time past, and with good effect.<sup>10</sup> The particular class of goods upon which said company has used,<sup>11</sup> and still continues to use said trade-mark, consists of pamphlets and circulars,<sup>12</sup> in addition to our signs and cards.<sup>13</sup> We have been accustomed<sup>14</sup> to brand it with a stencil-plate and black ink on packages of circulars and pamphlets sent to our various

pany, the conclusion should be somewhat thus: "Witness the seal of said corporation, and the signature of its president, at Such-a-place, in the county of Baltimore and State of Maryland, this 8th day of October, A. D. 1885."

<sup>1</sup> The true name should be given. There is a repugnance to the title previously stated.

<sup>2</sup> A trade-mark cannot correctly be said to consist of a design.

<sup>3</sup> Which is it, — a cut or a drawing? Inspection shows that it is neither, but a stencilling.

<sup>4</sup> Whose initials?

<sup>5</sup> The word "design" is out of place. We nearly despair of a solution of this enigma.

<sup>6</sup> The word "most" must be eliminated.

<sup>7</sup> How can it be essential at all, if it may be dispensed with?

<sup>8</sup> An advertisement cannot enter into a trade-mark.

<sup>9</sup> Sheer nonsense.

<sup>10</sup> Surplusage.

<sup>11</sup> For how long a time? (Sect. 1 of the Act of 1881.)

<sup>12</sup> We have already seen that these pamphlets and circulars are used as mere advertisements.

<sup>13</sup> "Signs and cards." Are these merchandise?

<sup>14</sup> How *now* applied and used?



agents, or print it on the faces of the same<sup>1</sup> with the usual printing-ink.

“A. BELL, *President*.

“*Witness*: I. K. LANE.”<sup>2</sup>

AFFIDAVIT.

“Commonwealth of Maryland,<sup>3</sup> }  
City & County of Baltimore,<sup>4</sup> } ss.

“Personally appeared before me, a justice of the peace in and for said city and county, the said A. Bell,<sup>5</sup> who, being duly sworn, doth depose and say that he is an officer of said company within mentioned;<sup>6</sup> that they<sup>7</sup> have the right to the use of the trade-mark described, and that no other person, firm, or corporation has a right to the same,<sup>8</sup> or any part thereof;<sup>9</sup> that the description and fac-simile presented for record are true copies<sup>10</sup> of our trade-mark; and he further says that he is domiciled in and is a citizen of the said State.<sup>11</sup>

“ADAM YOUNG,<sup>12</sup> *J. P.*”<sup>13</sup>

<sup>1</sup> It would be hypercritical to say that the last antecedent is the word “agents.”

<sup>2</sup> Two witnesses are required. *Query*, — Is not this witness the person named in the petition as a party?

<sup>3</sup> Should be “State of Maryland.” (See Constitution of same.)

<sup>4</sup> 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.

<sup>5</sup> Full name required.

<sup>6</sup> He fails still to state that it is a corporation.

<sup>7</sup> This implies a lack of incorporation.

<sup>8</sup> This should read, “a right to *the use of* the same.”

<sup>9</sup> This is too sweeping an assertion.

<sup>10</sup> A *description* cannot well be termed a *copy*.

<sup>11</sup> It is sometimes the fact that a person is a citizen of a State, but not of the United States. The regulation made by the Commissioner of Patents on the 29th of February, 1872, reads: “The form of oath for application for registration of a trade-mark will hereafter contain a statement of what country the applicant is a citizen, the same as in patent cases.” (Sect. 1 of the Act of March 3, 1881.)

<sup>12</sup> No date to the jurat, not fatal, but an irregularity.

<sup>13</sup> This officer, who improperly abbreviates his title to “J. P.,” leaves us in the dark as to the question of his jurisdiction. He cannot be a justice of the peace for both Baltimore City and Baltimore County.

§ 595. Examples equally vicious may be drawn in an almost infinite variety from cases actually filed in the Patent Office. Brief and comprehensive as are the approved forms, and intelligible as they are, they are constantly made the sport of a spirit of misunderstanding. Instead of a terse style of allegation, involving a strict retrenchment of unnecessary words, — which is the aim of the best practitioners in pleading,<sup>1</sup> — we behold extraneous matter, recklessness of allegation, inconsistencies, ingenuity of falsehood. All the errors of the preceding cases have not been pointed out; but sufficient have been displayed to convince us of the necessity of thought and caution in drafting a simple set of papers.

§ 596. In view of the fact that action in the Patent Office is taken only to pave the road for possible ulterior proceedings in law or in equity, too much caution cannot be observed in declaring title. The metes and bounds of a field must all be carefully defined, before a person can be charged with encroachment thereon. Therefore, anything which does not possess all the essential characteristics of a trade-mark, under the generally accepted rules of commerce, cannot receive recognition. A thing must exist before it can be acknowledged. If the proposed mark be merely indicative of quality, it must fall to the ground.<sup>2</sup> Yet this truth is slow in obtaining credit. It was thought that the legal advisers who, in 1859, contended that the term “Schiedam Schnapps”<sup>3</sup> constituted a valid trade-mark, would long since have abandoned that fallacious idea; but the position taken at the trial of a certain cause<sup>4</sup> implies the contrary. In the Supreme Court of New York, October 14, 1872, at special term, the matter was again decided. It appears that, at about a year before that day, the plaintiffs began the sale of an article of gin manufactured by them under the name of “Hudson G. Wolfe’s Bell Schnapps.” The defendant, a corporation succeeding to the rights of the late Udolpho Wolfe, claimed this name to be

<sup>1</sup> Stephen on Pleading, 424.

<sup>2</sup> See *ante*, § 134, “Generic Names.”

<sup>3</sup> *Wolfe v. Goulard*, 18 How. Pr. 64; R. Cox, 226.

<sup>4</sup> *Hudson G. Wolfe et al. v. Udolpho Wolfe Co.*, 2 Off. Gaz. 441.

an infringement of its trade-mark, viz.: “Udolpho Wolfe’s Aromatic Schiedam Schnapps.” The defendant, by its agents, threatened the plaintiffs with prosecution, and sent circulars with a similar threat to their customers throughout the country. The latter were in many instances intimidated thereby. The plaintiffs thereupon brought suit against “The Udolpho Wolfe Company,” and asked an injunction to restrain the defendant from thus interfering with their business. A preliminary injunction was granted by Gilbert, J. The question upon the hearing was this: Did the plaintiffs by their use of the words before mentioned violate any right of the defendant? Pratt, J., who heard the cause, said, *inter alia*: “The evidence taken convinces me that, prior to 1848, the word ‘Schnapps’ had become a portion of our common language, and was used to denote either gin or a class of articles of which gin is one. The question of law arising on these facts is a narrow one, and has been several times decided. . . . The reason of the rule is obvious, — the language might otherwise be impoverished, and the community be exposed to inconvenience without any corresponding benefit. It follows from these views that the plaintiffs must have judgment in their favor.” This decision maintains two points. 1st. That the defendant had no valid mark in the collocation of words mentioned. 2d. That the plaintiffs had a valid mark in theirs. It was not necessary for the purposes of the suit that the learned judge should go farther, or he might have truly said that the word “Bell” is the essential part of the mark. In the former suit, it was admitted in argument that the word “Schiedam,” being the name of a town in Holland, could not be appropriated by the plaintiff, and that the word “Schnapps” was a word adopted from the German language, meaning a dram.

§ 597. Just as worthless for the purpose of constituting trade-marks are such words as “Old London Dock Gin”;<sup>1</sup> or “Prize Medal, 1862”;<sup>2</sup> or “Nourishing Stout.”<sup>3</sup> So in the

<sup>1</sup> *Binniger v. Wattles*, 28 How. Pr. 206.

<sup>2</sup> *Batty v. Hill*, 84 T. R. (n. s.) 791.

<sup>3</sup> *Raggett v. Findlater*, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 20 L. T. (n. s.) 448; 22 W. R. 53.

“Moline Plough” case, in the Supreme Court of Illinois, in 1870, where the manufacturers branded upon their ploughs, for the purpose of designating the size, shape, and quality of the different grades, respectively, certain letters and figures in combinations, as “A No. 1,” “AX No. 1,” “No. 1,” “AX No. 11,” “B No. 1,” etc., it was held that no exclusive right to their use existed; but that they could be used by any other manufacturer of the same articles.<sup>1</sup> And so in the case of *Stolces v. Landgraff*,<sup>2</sup> 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,<sup>3</sup> and so also are many other cases to be found in close proximity to it in this book, and all designating the mere quality of the merchandise to which they were affixed, or being necessary names and common phrases which all persons have a right to use. — The following are samples of rejected cases. The words “New York Cutlery Co.,” because the mere name of the applicant;<sup>4</sup> “D. D. & Co. — Tasteless,” for drugs and medicines, because they are either descriptive or deceptive;<sup>5</sup> the figure of a fish, for fishing-lines, as merely descriptive;<sup>6</sup> the words “Crack-proof,” for India-rubber goods, for the same reason;<sup>7</sup> and also “Iron Stone,” enclosed in an oval border, for water-pipes.<sup>8</sup> Minor non-essential elements of a composite symbol were refused registration;<sup>9</sup> as was also a combination of two symbols, each of which had been registered in other cases.<sup>10</sup>

§ 598. In the Court of Lyons, in 1866, (*Chabrier v. Peillon*,<sup>11</sup>) came up a suit involving a question similar to that

<sup>1</sup> *Candee, Swan, & Co. v. Deere & Co.*, 54 Ill. 439.

<sup>2</sup> *Ante*, §§ 157-160.

<sup>3</sup> *Ante*, §§ 162, 163. Yet, March 24, 1885, the triple letters “xXx,” for bottled lager-beer, was registered by the Anthony & Kuhn Brewing Co. (No 12,033); and on the same day, “XX” or “double X” for sad-irons, by John Sabold, Jr. (No. 12,051).

<sup>4</sup> *Re Rowe & Post*, 3 Off. Gaz. 496.

<sup>5</sup> *Re Dick & Co.*, 9 Id. 538.

<sup>6</sup> *Re Pratt & Farmer*, 10 Id. 866.

<sup>7</sup> *Re The Goodyear Rubber Co.*, 11 Id. 1062.

<sup>8</sup> *Re Rader & Co.*, 13 Id. 596.

<sup>9</sup> *Re Coats*, 16 Id. 544.

<sup>10</sup> *Re Smith*, 16 Id. 679.

<sup>11</sup> 16 *Annales*, 73.

which arose in the subsequent "Akron"<sup>1</sup> and "Lackawanna"<sup>2</sup> 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"<sup>3</sup> case. The "Congress Spring"<sup>4</sup> 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. Levancier & Co.*,<sup>5</sup>) 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. Levancier et Compagnie," and beneath the same the words "Compagnie des Propriétaires de Vignobles." *Per Curiam*: The words "Propriétaires de Vignobles" (Vineyard Proprietors) is a generic term belonging to an indefinite number of proprietors, and cannot indicate to commerce the origin of the article to which they are affixed. Dismissed.<sup>6</sup>

<sup>1</sup> *Ante*, § 182.

<sup>2</sup> *Ante*, § 189.

<sup>3</sup> *Ante*, § 276.

<sup>4</sup> *Ante*, § 191.

<sup>5</sup> *Journal du Palais*, 1854, p. 120.

<sup>6</sup> The report of this case states that, during the progress of this suit in France, Salignac, in the name of his company, had obtained from the Lord Chancellor of England an injunction and sequestration of certain goods so marked, found in the London Docks. If so, it doubtless was on the ground of unfair competition; for there is nothing of the nature of a trade-mark in the whole case.

§ 600. An application was made, in 1872, for the registration of the words "Great Lightening Ink Eraser." These words, being descriptive of the article to which they were intended to be affixed, could not be favorably entertained. The Examiner made a suggestion that the interpolation of a single letter had quite changed the meaning of the essential word. Any ink eraser would lighten the ink marks, and therefore might truly be called a lightening ink eraser. The diminution of weight was not the exact point. The participle could be taken in but one sense. It could not possibly be meant to imply that the applicants' eraser burst or darted forth with an instantaneous illumination. That would be nonsense. The second vowel made the trouble. The word might better have been written "Lightning." The use of the metaphor would then have imported that, with the quickness of the electric flash, the stains of ink would be caused to disappear. Nor need that word be regarded as necessarily descriptive. That improper spelling would, in ninety-nine cases in a hundred, defeat the cause of the person who claimed the word. The rule of *idem sonans* could not save it. But this, however, is a fine point.—In the Court of Lyons, in 1884, an analogous case was decided. The registered mark consisted of the words "Insecticide foudroyant." It was held that the adjective *foudroyant* (striking with a thunderbolt), applied to an insect-killing powder, is but an expression drawn from common language, although pretentious, to intimate, in a single word, the efficaciousness of the powder offered for sale, and cannot be deemed to be a technical term under the French law of 1857.<sup>1</sup>

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

<sup>1</sup> Galzy v. Courcy, 80 Annales, 84. The learned editors, with a considerable show of reason, in a note, dissent from the finding, and cite authorities the other way.

which a monopoly is desired. Now for an illustration of this idea. In or about the year 1814, John B. Logier obtained from the British government a patent for fourteen years, for an instrument for guiding the hands of learners on the piano-forte. He compounded two Greek words, signifying "to form the hand," and named his machine the "Chiroplast." He acquired great reputation and a considerable pecuniary profit from the favorable reception of the instrument. If it had occurred to him that this new word was a valid trade-mark, it would have mattered little that his patent expired in fourteen years; for the mark would have virtually given him a monopoly so long as the public called for the "Chiroplast." As it was, the word is now generic.<sup>1</sup> — In *Bardin v. Gobert et al.*,<sup>2</sup> the plaintiff had obtained a patent for a species of ornamental feather produced by his invention of detaching the epidermis of all kinds of natural feathers, and dyeing them of all colors, as ornaments of various sorts for head-dresses, finery, flowers, embroideries, lace-work, and tissues. This constituted a new product of commerce. It needed a name. He composed one, — "Faillantine." This meant his patented article, and nothing else. It was a perfect trade-mark. — In late dictionaries of the English language, the word "harvester" is defined as one who gathers the harvest. The name came to be applied to the machine; and now a whole class of machines in the Patent Office are termed "harvesters." The term "vibrator" was applied to a kind of agricultural machine; now there is a class of "vibrators." So the term "revolvers" includes many kinds of revolving pistol.

§ 602. *Propriety* must be the standard in the selection of something intended to serve as a symbol of commerce.<sup>3</sup> Commerce extends throughout the world; therefore a mark should be valid throughout the world to be valid in any country. This is a general rule, that may possibly have exceptions. Care must be observed to avoid copying established hall-marks, or emblems common to specific manufactures. For example: in articles of manufactured gold in Great Britain

<sup>1</sup> See *ante*, § 221, "The Name of a Machine," etc.

<sup>2</sup> 12 *Annales*, 380.

<sup>3</sup> See case, *ante*, §§ 342-344; also cases in § 370.

and Ireland, an anchor shows that the gold wares were made at Birmingham ; a dagger and three wheat-sheaves, at Chester ; “Hibernia,” at Dublin ; a castle and a lion, at Edinburgh ; a castle with two wings, at Exeter ; a tree and a salmon with a ring in its mouth, at Glasgow ; a leopard’s head, at London ; three castles, at Newcastle-on-Tyne ; a crown, at Sheffield ; and five lions’ heads and a cross, at York. The moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes. There is no necessity for so doing, for the objects suitable for use as trade-marks are as infinite in number as the sands of the sea-shore. A violation of this rule is not only in bad taste, but is also an outrage. The spirit of commerce is conciliatory. We must not blindly follow the loose, random sayings of judges, that any emblem may be lawfully employed for this purpose. To be a “lawful trade-mark,” the emblem must avoid transgressing the rules of morality or public policy. The law will not aid any person to bring obloquy upon objects and symbols consecrated to religion. But what is religion, in its relation to commerce ? It is the recognition of God as an object of worship, love, and obedience. All peoples worship God under one form or another, or at least think that they do. Their religious prejudices should not be trampled upon. We tolerate all religions, true or false. A reader of these lines may be a Chinaman. His *joss* must not be caricatured. If a scoffer should endeavor to curry favor with infidels by the profane use of an *Agnus Dei*, or of any symbol of the Alpha and Omega, or the Ineffable Name, or even of angels, apostles, saints, and martyrs,<sup>1</sup> or of a thousand

<sup>1</sup> The laws of many nations forbid the registry of sacred emblems. Very recently, the Department of Customs of Russia issued an order on this subject, which has been copied in the *Bulletin Officiel* (Paris, Feb. 12, 1885). It says that lately there have been importations of foreign merchandise bearing trade-marks composed, in part, of the image of the Virgin Mary (“*la Mère de Dieu*”), of St. George the Conqueror (patron saint), and other saints ; and it continues, that “the right of property that a foreigner possesses in a mark in his own country does not authorize the entry into Russia of manufactured products invested with sacred images, and consequently no goods so marked shall be permitted to enter the custom-house.” — Our Patent Office acts on this rule of propriety.



objects depicted by ancient art, and hallowed by associations, would any court of justice sustain a claim to a trade-mark so composed? No. This is a rule of general application. Indeed, the Office hesitated to permit a representation of the evil one himself to be registered as a trade-mark. The device is set forth in the specification as "a smiling, half-drunken demon or devil, in a sitting posture, with the left leg raised at an angle of about forty-five degrees, while the right one is folded under it, and his tail passes over his right ankle. The demon wears a broad-brim hat with conical top and feathers, and in his arms and hands he carries six bottles." The frightful thing might possibly convey a moral lesson by an association of ideas. The *bottles* turned the scale. It had been recognized in Germany; and was registered.<sup>1</sup> Suppose, for the sake of further illustration of this topic, that the fiend had borne the likeness of a human being venerated by a large class of followers. It would have been in law an atrocious libel, and must have been rejected on that account.

§ 603. We have seen that a colored bordering of a woven fabric may be as valid a trade-mark as any other device, especially when announced as such, and recognized by the trade, and consequently will be protected like any other symbol of commerce.<sup>2</sup> 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*<sup>3</sup>). Both parties manufactured drillings. The complainants in their registration described their mark as composed of eight threads, arranged thus: two of violet, four of white, and then two of violet. The court said that it thence follows that the distinctive element of this mark is the number of threads, their disposition, and the alternation, as described. The defendants used four deep lilac threads, disposed so as to intertwine like a chain; whence it follows that the number of threads are not the same in both marks. The color is not the same, the

<sup>1</sup> Re Walter & Shaeffer, No. 434.

<sup>2</sup> See *ante*, §§ 89 and 268, for similar cases.

<sup>3</sup> 17 *Annales*, 305.

complainants having two colors, while the defendant has but one color, — deep lilac. The disposition of threads is different: the violet and white of the complainants' alternating, as stated, while in the defendants' the color is a unit. To disregard the number and disposition of threads in the complainants' mark were to suppress one distinctive element, and to take it without the basis they have adopted to characterize the peculiar products of their manufacture. If their fabric be examined, in piece or in roll, there can be no hesitation in discovering the lack of resemblance between the two marks. In a word, from any point of view, no imitation can be discerned upon which to found a claim to damages. Both marks were recognized as valid.

§ 604. When a large number of persons are interested in a trade-mark, either as members of a joint-stock unincorporated company, or as the personal representatives of a deceased person, or as guardians of infants, any of the number may be selected to make the application for registration, for their joint benefit. In one case, the papers were executed by one such person, in his own behalf and "as the representative of, and for the joint and equal use of, the heirs at law," etc.; and yet he asked that the registration should be made in his name, he having adopted a trade-mark for the benefit of all the others. He afterwards filed an unauthenticated certificate purporting to be signed by seven others as "the only heirs at law and legal representatives of Alpha Richardson, deceased," in which he, the applicant, was recognized as "the representative of the heirs at law."<sup>1</sup> 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

<sup>1</sup> See same case, *ante*, § 221, and *infra*, § 611.

the parties would then have acted through one, and the certificate of registry might have issued in the names of all, or to them as a firm.<sup>1</sup>

§ 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.*<sup>2</sup>). The plaintiffs made up cigarette paper in the form of a roll or endless band, with sections indicated, being kept rolled by means of a caoutchouc band, which they patented. They then made a deposit of what they assumed to be their trade-mark, i. e. the cylindrical form of their product. The Tribunal of Commerce of the Seine having rejected their suit, they appealed. The appellate court affirmed the judgment, saying that, although that peculiar form of the complainants' product had been used by them exclusively for a number of years, it could not constitute the commercial property known as a trade-mark.

§ 606. *The Doctrine of Alternate Forms* has sometimes come up in practice. It is based on the decision of the United States Circuit Court for the District of Connecticut, in *Morrison v. Case*,<sup>3</sup> in which it was held that the words "The Star Shirt," the words "The Star Shirt" with the figure of a star, and the words and device "The \* Shirt" constituted a single mark. On that authority, the Commissioner Duell reversed the decision of the Examiner, in *Re Weaver, ex parte*,<sup>4</sup> and directed the registration of a trade-mark consisting of the word-symbol "Lion," or the pictorial representation of a lion, or both. Ever since then, it has been the settled practice to register alternate forms, when they constituted true alternatives. The reason given is that a trade-mark appeals in many cases to the ear as well as to the eye. The goods bearing the symbol of a star will be known to commerce as the star goods, and so, also, if they bear the word "Star." "But," said Examiner

<sup>1</sup> Many manufacturers may unite to use a mark in common, and all thus be co-proprietors, as, for example, a union of hardwaremen, and as joint owners they may assign to successors or admit new members on an equal footing with themselves. *Arnoult et al. v. Franck*, 27 *Annales*, 352.

<sup>2</sup> *Journal du Palais* for 1865, p. 1125.

<sup>3</sup> 9 *Blatchf.* 548; 2 *Off. Gaz.* 544.

<sup>4</sup> 10 *Off. Gaz.* 1.

Seely, in a case in 1885, "this doctrine has some limitations. The question whether a word and a symbol presented for registration, whether by the same party or by different parties, are alternative forms of the same trade-mark, is one that calls for the judgment of the Office, and it is not left to the determination of the applicant. They must be exact alternatives, such that, on sight of the symbol, the word naturally occurs to the mind; such that, to express the symbol in language, no other word will occur; such that the written or spoken word unfailingly suggests to the mind the visible symbol." He cited an instance where a trade-mark for gloves consisted of a picture of a kid with its dam;<sup>1</sup> yet no one would venture to assert that the word "Kid," as an alternative form, could be a trade-mark for gloves. Similar to this case is another,<sup>2</sup> where a pair of kids in harness is the essential feature for gloves. Nor can this doctrine be stretched to cover cases in which the symbol is fanciful, while the name expressive of it is descriptive of quality or the price of the goods to which it is attached. In the case of 1885 referred to, the alleged trade-mark consisted of a United States cent in coin, affixed to a piece of tobacco, and the word "penny" was claimed as an alternative form thereof. "Cent" and "penny" are not convertible terms. Therefore it was held by the Examiner that the word "penny" cannot by itself constitute a valid trade-mark for plug tobacco, nor is it an alternative form of the word "cent," or of the coin of that name. An appeal having been taken, no opinion on this exact point of alternative forms was expressed by the Commissioner, he holding that the word "penny" could not be a trade-mark, being merely descriptive and common to trade.<sup>3</sup>

§ 607. *Rejection because of False Suggestion.* — The application papers may be perfect in form, and, so far as verbal language goes, quite impregnable, and yet be open to assault. The sworn statement is not always conclusive. The case as presented is liable to dissection, and hideous deformities may be exposed to view. The allegations may be true in letter,

<sup>1</sup> Registration No. 9,851.

<sup>2</sup> Registration No. 11,984.

<sup>3</sup> Perkins & Ernst, 28 Com. Dec., 93.

and false in spirit. The Office will penetrate the surface, and endeavor to reveal any latent fraud. The declarations of good faith may be overturned. Spurgeon says that no one is more like an honest man than a thorough rogue. There seems to be no end to the devices of unworthy traders, to trick their rivals and the public; nor can there well be until bounds shall have been set to human ingenuity. Yet, to warrant a refusal to register, there must be sufficient evidence of unfairness to overcome the natural presumption of honesty and fair dealing. For that reason, many suspicious cases are allowed to pass muster, and to go into the field of active strife armed with the certificate of the Patent Office, with the chance that justice may eventually overtake them.<sup>1</sup> 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 cannot save it from condemnation. It has been vehemently said that the Office is not the conservator of the morals of the community, nor does it aspire to be. But it has a duty to perform, and that duty is carefully to scan each proposed case, and, if necessary, to probe it thoroughly. A self-styled trade-mark may upon examination be found to be a brazen-faced counterfeit. Any objection to validity which might be made in subsequent judicial proceedings may be anticipated in an application for registration, and fraud is certainly the most formidable foe that can appear.

§ 608. The fraud which would justify a refusal to register a proposed trade-mark may be, — 1. Actual or positive fraud; 2. Constructive fraud. That is, it may be the intentional employment of any cunning, deception, or artifice, to circumvent, cheat, and deceive purchasers;<sup>2</sup> or it may consist in

<sup>1</sup> See *C. A. Yale Cigar Manufacturing Co. v. C. A. Yale*, 30 Off. Gaz. 1183. The respondent was one of the partners and superintendent of the company which owned the mark. He secretly and covertly obtained registration of the mark "Grand Master," for cigars, he never having individually adopted it. The decision was in favor of the company. — In the Court of Lyons, in 1880, (*Seigle v. Mondon, Gonon, & Carre*, 29 *Annales*, 177,) a similar case was decided, with the same result.

<sup>2</sup> "Dolum malum esse omnem calliditatem, fallacium, machinationem ad circumveniendum, fallendum, decipiendum alterum adhibitam." Dig. 4. 3. 1, 2; Poth. Obl. n. 28.

acts which, though not originating in evil design and contrivance to perpetrate a positive fraud or injury, yet by their necessary tendency to deceive and mislead, or to violate public or private confidence, are deemed equally reprehensible with positive fraud, and therefore are prohibited by law, as acts done *malo animo*.<sup>1</sup> 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.<sup>2</sup> 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.<sup>3</sup> The Office answered that it is difficult to conceive upon what principle such words could be upheld as a lawful trade-mark. They are printed upon a label entirely in the German language, and, beyond doubt, addressed to German-speaking people. To them the said words are plain "Hamburg Drops," and nothing more. The words are therefore descriptive; that is, if the medicine truly consists of drops coming from or made in Hamburg. Any person in Hamburg has a right to manufacture "drops," and as much right to give those drops the geographical name of "Hamburg." But there is another objection. The label upon which the said words are printed has upon it the representation of an ornamented mortar and pestle, beneath which are the words "Handels Marke," besides a caution, and a fac-simile of the signature, "Dr. August Koenig." These words clearly indicate the previous appropriation of the said representation as a trade-mark, and that by some one other than the applicants. By reference to the application papers, it will be perceived that the medicine of the applicants, upon which article it is

<sup>1</sup> 1 Story Eq. Jur. § 258-440.

<sup>2</sup> "Fraudis interpretatio semper in Jure Civile non ex eventu duntaxat sed ex consilio quoque consideratur." Dig. 50. 17. 79.

<sup>3</sup> Ex parte A. Vogeler & Co., 1872.

proposed to use the words "Hamburger Tropfen," is manufactured by them at Baltimore, Maryland. Such a label seemed calculated to mislead the public. For both reasons, the application was rejected.

§ 610. The words "American Sardines," as applied to certain fish prepared for food, were refused registration, in 1872, for a similar reason. The objections were, the descriptive nature of the words on the one hand, and their tendency to mislead on the other. The written argument of the applicant's counsel admits that the fish to which these words are applied are not really sardines, but are "menhaden" or "moss-bunkers," which, cooked in any ordinary way, are not eatable, owing to their numerous fine bones, and were therefore used only for making oil until treated by the applicant's patent process. The words "American Sardines" cannot, in view of this fact, be held to be descriptive. But a more formidable objection remains for consideration, said the Examiner, — the tendency to mislead the public. The counsel attempt to meet this objection by insisting that no one who had ever seen a sardine could mistake the so-called American sardines for the genuine Mediterranean fish; for the applicant's fish are "at least six times as large, though supposed to be of the same (herring) family." The answer was as follows: "The truth is this: the inferior fish, the moss-bunkers, are put up by the applicant in tin boxes similar in size and general appearance to those containing the genuine delicate fish, brought from the vicinity of Sardinia. It is not possible for any unadvised purchaser to draw comparisons between the appearance or size of the applicant's preparation of fish and the genuine, until the box is opened; and the box is not opened until after purchase. By that time the mischief will have been done. It may be that the 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, and draw the correct inference; but they are not the only classes who are to be shielded from deception. The careless, the ignorant, the inexperienced,

must be protected; for they buy on the faith of a single glance of the eye at the outside of the box bearing the attractive appearance of a genuine package of sardines. It is denied that there is any *intention* on the part of the applicant to mislead. That is not material in our present investigation. The real question is this: Is the use of the name 'American Sardines,' as applied to a box resembling the genuine sardine-box, calculated to mislead the public in the purchase of an article of merchandise? It is not necessary for the determination of this question that any purchaser shall actually have been deceived. Would the public be likely to be misled? They would be. Then, the proposed trade-mark cannot have the sanction of registration. As to the *bona fides* of the applicant in adopting said words: Why apply the word 'sardines'? As moss-bunkers, perhaps the article would not sell. It is said that the words 'American Sardines' are not given to the fish themselves, but to the fish as prepared under a peculiar process. The public would buy the prepared fish as genuine sardines, which they are not. Even if the American prepared fish are superior in taste and nutritious qualities to the Mediterranean fish, there is no reason why a purchaser should not have exactly what he calls for." On appeal, the decision was affirmed, on the same reasoning.<sup>1</sup>

§ 611. An application was made for the registration of the words "Richardson's Patent Leather Splitting Machine."<sup>2</sup> These words being purely descriptive of the article upon which they were placed, the case was rejected upon that technical ground. Upon a close inspection of the papers, it was observed that the applicant set forth that he had adopted a trade-mark consisting of those words, while in another place in the same documents he alleged that the mark had been in use for upwards of twenty years. The statements are objectionable for repugnance. That is not all that may be said. To use a mild expression, the mode of relating the facts is very suggestive. Under this gentle aspect, what motive lies concealed? The phraseology — "for a term of upwards of twenty years" — is simple and indefinite enough, and may reasonably be in-

<sup>1</sup> Re American Sardine Co., 3 Off. Gaz. 495.    <sup>2</sup> Re Richardson, Ibid. 120.



ferred to mean at least twenty-one years. A patent granted prior to March 2, 1861, expired in fourteen years, unless extended, in which case its duration would have been prolonged for seven years. In either event, the monopoly must have ceased. What would have been the practical effect of a recognition of this assemblage of words as a trade-mark? For all time, the idea must thereby have been conveyed that a patent upon the machine was still in force, and the monopoly, which government had limited, might by an ingenious manœuvre have been perpetuated.<sup>1</sup>

§ 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 “<sup>Hero</sup><sub>ine</sub>” he was an infringer who used the words “The Heroine” for the same class of merchandise.<sup>2</sup> 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.<sup>3</sup> 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 hope of obtaining thereby a *prima facie* title,<sup>4</sup> as the basis of judicial proceedings. It may be well worth the while of a capitalist to be enabled, by the production of a certificate of registry, to throw the burden of proof upon an adverse party; and by obtaining a preliminary injunction founded thereon fetter, if not destroy, the business of another. We will suppose that some article has a transient popularity. The moment of demand must be seized. The delay of a few months may be

<sup>1</sup> See *ante*, § 71, “A Lack of Truth debars from Protection,” and § 72, “An Untrue Use of the word ‘Patented.’”

<sup>2</sup> *Rowley v. Houghton*, 2 Brewster, 303; 7 Phila. 39; *R. Cox*, 486.

<sup>3</sup> *Hine v. Lart*, 10 Jur. 106; 7 L. T. 41.

<sup>4</sup> Act of March 3, 1881, sect. 7.

fatal to success; for fortunes sometimes depend upon instantaneous action. The article is known by a certain mark, and that mark is a name. That name is the talisman that works prosperity. Whoever has the sole right to stamp that magic symbol on his goods, wares, merchandise, has the monopoly. An injunction is applied for. The proof of registration affords strong presumptive evidence of title. The provisional injunction is granted. Weeks, months, perhaps years, must elapse before the controversy can be determined upon its merits. In the mean time, the enjoined party suffers irreparable injury. It matters little who shall eventually win the battle. Craft, insolence, and abundant pecuniary means, will by that time have reaped the golden harvest. This is not a fancy sketch. Whatever may be the cause of a misstatement of facts, the legal result is the same: the thing proposed cannot become a lawful trade-mark. Thus, where it was alleged that the trade-mark consisted essentially of the words "Rip Van Winkle," and a triangle enclosing the applicant's initials, and it was found that another house had the words "Rip Van Winkle," as a mark for the same class of merchandise, the application was rejected.<sup>1</sup> The imitation was only in part, but was sufficient to cause confusion, and likely to provoke litigation. The word "Star," for oil, was rejected because another person had already registered a device for oil, consisting of a star containing the letter G;<sup>2</sup> and "Centennial," combined with a firm name and place of business, for sparkling wines, because a previous applicant had registered "Centennial" for alcoholic spirits.<sup>3</sup>

§ 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;<sup>4</sup> and the correction will be made without cost to the applicant.<sup>5</sup> If, after a party obtain

<sup>1</sup> Ex parte Fechheimer & Workum, 1872.

<sup>2</sup> Re The American Lubricating Oil Co., 9 Off. Gaz. 687.

<sup>3</sup> Re Busch & Co., 10 Id. 164.

<sup>4</sup> Phelps v. Brown, 1 Fisher, 479.

<sup>5</sup> Re James Cochrane, Com. Dec., 1869, p. 60, and Re Havemeyer et al., Id. 1870, p. 5.

registration of a trade-mark, he discover that the certificate of registry is inoperative, or invalid by reason of a defective or insufficient statement or specification, or by reason of too great a breadth of claim, which error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, he may be permitted to surrender his certificate, and obtain another.<sup>1</sup>

§ 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”;<sup>2</sup> but a mere change of purpose, after the payment of money, will not entitle a party to demand such a return.

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

<sup>1</sup> Re Ives, Beecher, & Co., No. 547.

<sup>2</sup> Rev. Stats., sect. 4936. Patent Office Rule 215.

## CHAPTER XIV.

## INTERFERENCES IN THE PATENT OFFICE.

- § 617, 618. Practice moulded on that of courts of equity
- § 619, 620. Manner of conducting interference.
- § 621. Interference an interlocutory proceeding.
- § 622. In what cases declared.
- § 623. Matters to be considered.
- § 624. Priority of right.
- § 625. Preliminary interference.
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- § 669. Good faith as regards Walsh, Brooks, & Kellogg.
- § 670. Want of equity on their side.
- § 671. Conclusion and dissolution of interference.
- § 672. "Magnolia" and "Dave Jones" trade-marks.
- § 673. Learning and skill required in interference cases.

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

§ 618. The matter must be as carefully conducted as though it were pending in a court of equity; indeed, the practice is moulded upon that of such a tribunal.<sup>1</sup> As in controversies in courts, substantial rights may be frittered away by an in-artificial mode of procedure; by a failure to evoke evidence of material facts, owing to a slovenly mode of examining witnesses; or by such irregularities in practice as are beyond toleration when the interests of another party are at stake.

§ 619. True it is that the Office earnestly strains after the furtherance of justice; but to this — as to all worthy endeavors elsewhere — there is practically a limit; and litigants must generally be left to rest as best they may upon the beds made by themselves. An issue is joined, testimony is taken, objections and points are made, arguments are heard, and the Office decides upon the whole matter as presented. Leading and other improper questions and answers to them are ruled out, and, it may be, whole depositions are eliminated for a manifest lack of good faith, or for some other fault, although it may be only the result of sheer ignorance or carelessness. In case of surprise, relief will be given to an innocent party.

<sup>1</sup> Sect. 3 of the Trade-Mark Act of March 3, 1881, prescribes that the Office shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

Thus, upon a motion, in the nature of an appeal, to reopen an interference, in order to receive testimony which had been delayed until after the day of hearing by the fault of the officer before whom it had been taken, the decision of the Examiner was suspended, and the case on appeal set for immediate hearing upon the testimony and arguments by that time in.<sup>1</sup> But after a party had filed his preliminary statement and taken his testimony, the Commissioner refused to open the case and allow the other party to file a preliminary statement and take testimony, where, although not originally a party, it appeared that he had had knowledge of the pendency of the interference, and the proceedings under it.<sup>2</sup>

§ 620. It may here be remarked, that seeming mere irregularities are sometimes manifestations of subtlety and craft. The object is to discover the weakness of the adversary, and then, by feigned surprise, or plausible excuse, to obtain leave to take additional testimony. Witnesses can usually be found to supply all deficiencies in evidence. When such a motive becomes apparent, the Office is sometimes called upon to exercise ingenuity to circumvent villany.

§ 621. *An Interference is defined* to be an interlocutory proceeding for the purpose of determining which of two or more persons, claiming to be the first to adopt a trade-mark, really did first adopt it.<sup>3</sup> It may also be resorted to for the purpose of procuring evidence of an alleged abandonment of the mark in controversy.<sup>4</sup>

§ 622. It will be declared in the following cases: 1. When the parties have pending applications before the Office at the same time, both or all the parties claiming priority of title to the same mark, — or one substantially the same, — used to indicate the same class of merchandise. 2. When an appli-

<sup>1</sup> *Hayden v. Phillips*, Com. Dec. 1871, p. 170.

<sup>2</sup> *Aldrich et al. v. Bingham*, Ibid. 90.

<sup>3</sup> The Commissioner had authority, under the old law, to declare an interference in a trade-mark case. *Lautz Bros. & Co. v. Schultz & Co.*, 9 Off. Gaz. 791. So held by U. S. Circuit Court, N. J. Dist., *Hanford v. Westcott*, 16 Id. 1181. The subsequent act of March 3, 1881, sect. 3, gives ample power in the same respect.

<sup>4</sup> See *infra*, Chapter XV., on "Abandonment."

cant — having been rejected upon a previously registered trade-mark — claims an older subsisting title.

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

§ 624. The solution of the question is easy to him who has studied the principles upon which rest the laws of a right to a trade-mark. The question thus far presented is one of registration. We must pass that by, and come to the real question, — Who had the prior right to the use of the mark? The right to a trade-mark is founded on immutable law, as we have before seen. Such being the case, B.'s priority of right must prevail; and for this reason: it was not his *right*, but his *remedy*, which was in abeyance. The treaty which demolished the partition walls admitted him to all the privileges of the most favored persons. But then he ousted another from a vested right? No; it was only an apparent right; for if the Patent Office had had any knowledge that any one else in any country had an older title, the application for registration would have been refused. B. had all the time a perfect com-

mon-law right, and could have sued in our courts as an alien friend, without the slightest regard to the matter of treaty or convention.<sup>1</sup> B. having established his claim, the next step is to issue to him a letter of registry. That will be to have two outstanding titles to the same property at once. Yes, until a court shall have enjoined one from the use of the symbol, or the wrong-doer shall have voluntarily relinquished all claim to it. The Commissioner has no power to cancel a certificate of registration already issued; for that is a matter for judicial cognizance upon a suit to be brought by the government, either in its own name or the name of the Attorney-General; or by some form of proceeding which can give official assurance of the sanction of the proper authority.<sup>2</sup> But the Commissioner may, in an interference issue, if he find that another was the prior adopter, give him also a certificate of registry; and thus place both parties on the same footing before the courts and the public. His authority for so doing is found in the proviso to the third section of the trade-mark law of March 3, 1881.<sup>3</sup>

§ 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

<sup>1</sup> An alien suing for violation of his trade-mark need not even allege the existence of a treaty. *Fils v. Sarrazin*, 15 Fed. R. 480.

<sup>2</sup> *Mowry v. Whitney*, 14 Wall. 620; 5 Fish. 513; 1 Off. Gaz. 409.

<sup>3</sup> In the United States, the first adopter, or one deducing title from him, is alone entitled to registry. (Act of 1881, sect. 3.) In England, it was held that, inasmuch as each of the parties had used a certain mark independently and *bona fide* for several years, the mark should be registered in both names. (Re Powell, Re Pratt, 1 Trade Marks, 237; Sebastian's Dig., No. 357; Cox's Man., case 589.) With respect to those technically termed "old marks," the court permitted identical marks to be registered to three different parties at the same time (Re Jolley, Son, & Jones, 1 Trade Marks, 346); but if the mark be used by more than three parties, it cannot be registered at all, as, by being used by more than three, it lacks the element of distinctiveness. Re The Walkden Aerated Waters Co., 1 Trade Marks, 39; Re Hyde & Co., 7 Ch. D. 724; 28 L. T. (N. S.) 777; 26 W. R. 625; 1 Trade Marks, 245.



practicable, the exact date of each step in the act of appropriation. This statement must be sealed up before filing; and the name of the party filing it, and the subject matter of the case, must be indicated on the envelope.

§ 626. As just intimated, the real point sought to be evolved is the exact time of adoption; and, as circumstances, the manner of application, place of adoption, and the class and species of vendible articles to which it has been applied. It should also appear who made the original appropriation, whether the claimant or some one from whom he derived title; and if done through an agent that fact should be stated. The case of *Schrauder v. Beresford & Co.*<sup>1</sup> shows the importance of a circumstantial detail of facts, and especially the necessity for setting forth the exact date of placing the symbol upon goods offered for sale.

§ 627. The statute requires that the length of time during which the trade-mark has been used shall be stated in the application; and the statement is generally conclusive against the affirmant in any subsequent proceeding; for it would not be just to allow him to fix a date under oath, and afterwards, when another claimed a prior title, to come in and alter the date so as to anticipate his opponent's title. In one case,<sup>2</sup> 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.<sup>3</sup> The stringency of this rule is sometimes relaxed, upon overwhelming evidence of unintentional error, and of perfect good faith; although, of course, the presumption is always against him who would attempt to vary a statement made under the solem-

<sup>1</sup> *Infra*, § 631.

<sup>2</sup> *Kenyon v. Wesson*, Com. Dec. 1871, p. 91.

<sup>3</sup> *Tegmeyer v. Kerns*, *Ibid.* 285.

nity of an oath. In a patent case,<sup>1</sup> the Commissioner said: "The object of the preliminary statement is to serve as a pleading, in which each party, in ignorance of his opponent's case, sets forth the history and date of his own invention. This he must know better than any one else, and he will be held to make a full and accurate disclosure, without evasion or reservation. He must distinctly state the date which he proposes to prove as that of invention, and he must set forth the character of the substantive *act* of invention, upon which he proposes to rely. . . . It is proposed to put an end to the practice which, it is to be feared, has prevailed to too great an extent, of striving on each side to learn an opponent's date of invention, only to manufacture such proof as may be necessary to fix an earlier date." Yet cases do sometimes arise when this rule cannot, in accordance with justice, be enforced to its fullest extent; as, for example, where, in one instance not reported in print, the evidence was clear that by unavoidable mistake the date was incorrectly stated, one numeral having been mistaken for another in transcribing. Even in such a case, the evidence of good faith must be beyond reasonable doubt.

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

§ 629. The preliminary statements are not open to the inspection of opposing parties until both, or all, shall have been filed, or until the time for filing shall have expired; nor then,

<sup>1</sup> *Schenck v. Rider*, Com. Dec. 1870, p. 135.

until they shall have been inspected by the Examiner, and found to be sufficiently definite as regards the declaration of dates.

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

§ 631. If the earlier applicant fail to file a preliminary statement, no testimony will subsequently be received from him tending to prove that he adopted the mark at a time prior to that fixed in his application. The preliminary statement can in no case be used as evidence on behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination.

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

§ 633. *Declaration and Dissolution.* — An interference will not be declared until the subject matter involved is decided to be registrable; and, when once declared, it will not be dissolved without judgment of priority, unless it be found that neither party is entitled to a certificate of registry, or that no interference in fact exists. And at whatever stage it is ascertained that there is no conflict between the claims of the parties, it will be dissolved, whether before the Examiner of Interferences, or the Commissioner; for to continue it would be a waste of time, and would avail nothing.<sup>1</sup> Thus it will be dissolved, *ipso facto*, by the withdrawal of one of

<sup>1</sup> Jenkins *et al.* v. Putnam, Com. Dec. 1870, p. 156.

the parties ;<sup>1</sup> or it will be dissolved upon one of the parties striking out from his specification the only element of conflict ;<sup>2</sup> or it may be found that the registration of one will be no bar to the other.<sup>3</sup>

§ 634. *Judgment based on Concession of Priority* will not be given unless such concession be evidenced by a writing, under the signature of the party himself. If there have been an assignment of the trade-mark, the assignee must join in the concession, although not a nominal party. The withdrawal of one party does not entitle the other to a decision in his favor on the question of priority ;<sup>4</sup> for it may be that his withdrawal is by way of nonsuit, with an intention to renew the contest when better prepared ; or it may be by collusion, when neither party has any right.

§ 635. *Notice to Parties.*—When an interference is declared, notice will be given to the parties, or to their attorneys. When one of the parties has received a certificate of registry, duplicate notices will be sent to him and to his attorney of record. Where one of the parties resides abroad, and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in the Official Gazette for such time as the Commissioner may direct.<sup>5</sup>

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

§ 637. As the parties are to prove facts by the adduction of evidence before the Examiner, and have, consequently, to provide themselves with proper documentary or other testimony, it is essential that they should be apprised of the specific nature of the question to be tried, for guidance in preparing proof. The notice of interference sent by the

<sup>1</sup> *Eames & Sealey v. McDougal*, Com. Dec. 1871, p. 206.

<sup>2</sup> *Hawkins v. Lambert*, Ibid. 278.

<sup>3</sup> *Jackson v. Nichols*, Ibid. 278.

<sup>4</sup> *Eames & Sealey v. McDougal*, *supra*.

<sup>5</sup> Rule of Practice 102, as to interferences.

Office states the point in issue. For example, in a complex mark there may be one prominent element, as in the "Paul Jones" case, hereinafter given, where that name of a naval hero was really the whole case, although that name was displayed upon a flag flying on a ship under full sail. The parties entered into the contest with the knowledge of the name being the only material point of inquiry.

§ 638. *Grounds of Interference.* — Marks do not conflict unless they are identical in form, or have such a near resemblance to each other that the public may confound them. Although there may be points of resemblance, they will not warrant the declaration of an interference, unless confusion be likely to ensue. Take the following case as an illustration. One person obtained a certificate of registry<sup>1</sup> for a trade-mark for shirts, drawers, etc., which mark was described as consisting of "a balance, a shield, and the word 'Centennial,' arranged as shown, numbers designating the size and quality of the goods being, if desired, marked upon the shield." Other persons, composing a partnership, subsequently obtained a certificate<sup>2</sup> for a trade-mark, for substantially the same class of merchandise. The mark of the latter was described as consisting essentially of the word "Centennial." The prior adopter said that he was prepared to discard all the other elements of his mark, and confine his claim to the one word. The Examiner held that the specifications on file were the criteria of action; and that, as they did not disclose any conflict of claims, inasmuch as the two things were so dissimilar that they were not calculated to deceive, it was not a proper case for an interference.<sup>3</sup> If the prior applicant limited himself to the use of the word in combination with other things, it was his misfortune. Thus the junior applicants were left with a broad claim to the word "Centennial," which they might use, in combination or not, at pleasure. For the pur-

<sup>1</sup> Leopold Sternberger, No. 709, dated March 19, 1872.

<sup>2</sup> Thalheimer & Hirsch, No. 809, dated May 7, 1872.

<sup>3</sup> In *Re Cornwall* (12 Off. Gaz. 138), it was held that a star and crescent for soap did not interfere with a previous registration by another of the figure of a star for soap. But "Swan" was held to conflict with "Black Swan." (*Re Jules E. Caire*, 15 Id. 248.)

pose of obtaining an adjudication on the question of priority of adoption, the senior registrant filed a new application, in which he claimed the word "Centennial" as the essence of his trade-mark. That proceeding raised a simple question of fact. On an interference trial, Sternberger proved priority as to the actual affixing of the mark, and the Examiner decided in his favor. On appeal, the decision was affirmed.<sup>1</sup>

§ 639. *Compulsory Testimony.*— Previous to the passage of the act of Congress of March 2, 1861, it was within the option of witnesses to give their testimony or not, so that there were frequent failures of justice. That act provides, "That the clerk of any court of the United States for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue a 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."<sup>2</sup> 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.

§ 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.<sup>3</sup>

<sup>1</sup> Sternberger v. Thalheimer & Hirsch, Com. Dec. 1873, p 24, 3 Off. Gaz. 120.

<sup>2</sup> Re-enacted as Section 44 of the Patent Act of July 8, 1870; Rev. Stats., sect. 4006.

<sup>3</sup> Rule 209.

§ 641. *Printed Copies* of testimony greatly facilitate the examination of cases; and such copies are required in all cases when the testimony is written otherwise than in a fair and legible hand.<sup>1</sup>

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

§ 643. A motion to open an interference for a rehearing, after a decision *sub silentio*, will be refused where there has been gross negligence in preparing for it. There is a case<sup>2</sup> where, four months after the decision had been made, and after frequent allowances of additional time, a party had the cool assurance to ask for a still further opportunity. His motion was denied. Up to that time he had taken no proof, offered no affidavit except his own affidavits to show what proof he desired to offer, or that any evidence existed; and his affidavits gave no details, but were most general in statements. The Office regarded his persistent waste of time as intended simply for delay, although he made affidavit to the contrary. This is an extreme case; for it is seldom that repeated postponements would be countenanced, unless by the consent of the adverse party.

§ 644. *Information in Relation to Pending Cases* is given so far as it becomes necessary in conducting the business of the Office, but no farther. Thus, where an interference is declared between pending applications, each contestant is entitled to a knowledge of so much of his opponent's case as would enable him to conduct his own understandingly.<sup>3</sup>

§ 645. *Sources of Evidence*.— As in equity cases, these are principally four: 1st. The intelligence of the tribunal, or the

<sup>1</sup> Rule 157.

<sup>2</sup> *Covel v. Maxim et al.*, Com. Dec. 1869, p. 78.

<sup>3</sup> See 125th Rule of Practice in the Patent Office.

notice which it judicially takes of certain things, and the things which it presumes; 2d. The admissions of the parties, contained in their specifications and statements, which serve as pleadings; 3d. Documents; and, 4th. The testimony of witnesses.

§ 646. As a rule, parties may by written consent make almost anything evidence, unless the effect would be injurious to the public; as, for example, the admission that one of the parties has a good title, when the contrary is clear. No such admission of an adversary would be deemed sufficient to warrant the issue of a certificate of registration where the Office had judicial cognizance of the untruth of the admission; for not only is the case to be decided upon the issue joined by the parties, but the interests of the community at large are to be looked after.<sup>1</sup> The law of evidence as settled by the courts is used in the matter of interferences, so far as applicable. Official papers; the precise state of our relations with a foreign government; the dates of public events, such as proclamations of war and peace, which may affect the forensic privileges of parties; treaties, and conventions with foreign powers, — will all be judicially recognized. The principal source of evidence is the testimony of witnesses taken upon deposition. The practice of the Patent Office, for taking and transmitting testimony in an interference case, may be found in the Rules thereof, Nos. 150–158.

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

§ 648. *Hearings.* — All interference cases pending before the Commissioner on appeal, or before the Examiner of Interferences, will stand for argument at one o'clock on the day of hearing, unless some other hour be specially designated. If

<sup>1</sup> See Act of March 3, 1881, sect. 3.



either party then appears, he will be heard; but a contested case will not be taken up for oral argument after the day of hearing, except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard. Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel.<sup>1</sup>

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

§ 650. It is not unusual in such appeals for the parties to file voluminous abstracts of testimony, sometimes running to the extent of thousands of pages. At least enough of the case should be shown to meet the exact points in controversy, and enable an intelligent understanding to be had of the facts. The more caution should be observed, as in this class of cases the decision of the Commissioner is final.

§ 651. The remarks of the court in a certain patent case,<sup>2</sup> in regard to granting reissues, are also applicable in matters of interference: "The Commissioner is supposed to have all the qualifications necessary to an intelligent decision of that question, and there are strong reasons why his action should be regarded as final. Such I understand to be the doctrine of the Supreme Court of the United States, as announced in numerous reported cases."<sup>3</sup>

§ 652. The practice in an interference case can best be explained by taking the record of an actual controversy as to

<sup>1</sup> This is the substance of the provisions of Rule 146 in patent cases, now adapted to trade-mark interferences.

<sup>2</sup> *Whitely v. Swain*, 4 Fisher, 123.

<sup>3</sup> 4 How. 404; 15 Id. 52; 17 Id. 84; Law's Dig. 617.

the right to the exclusive use of a trade-mark. We shall thus not only see the formal part of the proceedings which characterize such a matter, but also have a curious exhibition of the contrarities of the human mind, as shown in opinions of counsel and judicial officers. It will, in addition, furnish a commentary upon the "glorious uncertainty" of the administration of trade-mark law, when its settled principles are not rigidly adhered to.

§ 653. We will take, for example, the case of *Armistead v. Blackwell*. The applicant stands in the position of plaintiff, as he attacks the title of Blackwell, who had previously registered as a trade-mark the words "Durham Smoking Tobacco." The Office having informed Armistead, through his solicitor, that another party claimed priority of title, both parties were required to file preliminary statements by a certain day.<sup>1</sup>

§ 654. Armistead responded by a sworn statement of his version of the origin, etc. of the mark, partly from his own knowledge, and partly on information and belief, deducing his title through one Wesley A. Wright, and taking it back to 1860.<sup>2</sup> Blackwell also filed his statement, setting forth that, in 1865, one J. R. Green, from whom he claimed title, was engaged in manufacturing tobacco in North Carolina at the time of the approach of the armies of the United States under command of General W. T. Sherman, and the retrograde movements of the army of General Joseph E. Johnston, of the so-called Confederate States, and in the vicinity of the town of Durham. That when the armistice antecedent to the surrender of the army of General Johnston was promulgated, the two armies occupied positions adjacent to said town of Durham, and the town and vicinity became common ground to each army; that said Green sold large quantities of smoking-tobacco to the soldiers; and from the circumstance of the surrender at that place, he believed that the name "Durham"

<sup>1</sup> See Trade-Mark Rule 13, ed. of 1885.

<sup>2</sup> See *Blackwell v. Dibrell*, U. S. Cir. Ct., E. D. of Va., 1878, 14 Off. Gaz. 633, in which this point was involved. See also *Blackwell v. Wright*, Sup. Ct. of North Carolina in 1875, 73 N. C. 310.

would be popular. He said that the word "Durham" was first applied to smoking-tobacco in 1865.

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

§ 656 An interference proper was then declared, and due notice served. The parties were informed that their claims were adjudged to interfere with each other, and that a hearing would be granted them on a certain day; that the testimony of the applicant must be closed at a day fixed, and that of the respondent at a later day; and that, at a still later day, rebutting testimony, but no other, might be taken after the closing of the testimony in chief. Ample time was given, regard being had to the residences of witnesses and parties.

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

§ 658. *By the Examiner:* It is necessary to have a clear conception of the exact point in controversy. Wherein consists the trade-mark? There are two theories. The applicant, Armistead, insists that the essence of it is in a single word, "Durham," used in connection with the words "Smoking Tobacco." The respondent, Blackwell, claims all these words in conjunction with the words "manufactured by W. T. Blackwell." The bill in equity in the suit,<sup>1</sup> the testimony in which is here adduced, claims the word "Durham." What is the essential part of the mark? Not the words "Smoking

<sup>1</sup> Blackwell v. Armistead, 5 Am. L. T. 85; 3 Hughes, 103.

Tobacco," for such words in common use cannot be appropriated.<sup>1</sup> Nor can the words "manufactured by W. T. Blackwell," for they are in the nature of a mere advertisement. If any word contains the essential attributes of the symbol known to commerce as a trade-mark, that word is "Durham." The respondent's first point denies that by any possibility it can be a trade-mark, and cites cases. If the word "Durham" is used for the purpose of indicating that the merchandise to which it is affixed is manufactured and sold at a place called Durham, it cannot be a trade-mark.<sup>2</sup> Did the applicant use it for that purpose? If the word is used in its geographical sense, it means but one place, — a village in North Carolina. That is conceded and proved. The applicant or his assignor there began business in 1859, or 1860. The respondent now carries on business there. Is there such a place as Durham in North Carolina? Some witnesses speak of "Durham"; some, of "Durham's"; others, of "Durham's Station." The official list of post-offices spells it "Durham's," the apostrophe probably signifying "Durham's Station." It is officially so certified by the Acting First Assistant Postmaster-General. That settles the question. The word as used by both parties is not meant to indicate locality. The evidence shows that it is used to denote the excellence of the tobacco.<sup>3</sup> It is not pretended that the tobacco is raised at Durham's Station; or, if it were, that the soil of that locality possesses any peculiar properties to make tobacco grown therein better than in any other. The witnesses swear that the flavor imparted by the tonka bean and other ingredients makes it superior, as manufactured in a peculiar manner. Blackwell did not mean it in a geographical sense, when he began to use the word. His sworn statement shows that. This does not concede, as law, that a geographical name cannot be a trade-mark. It generally cannot be, for the reason given in the "Lackawanna" case.<sup>4</sup> But this rule has exceptions. The leading authority

<sup>1</sup> See *ante*, § 134, "Generic Names."

<sup>2</sup> See *ante*, § 182, "Geographical Names," and §§ 191, 192, on same subject.

<sup>3</sup> See *ante*, § 135, "A Trade-Mark may be valid although descriptive of Quality."

<sup>4</sup> See *ante*, § 189.

is the "Anatolia" case.<sup>1</sup> Other cases affirm the same doctrine. In France, the same ruling was made. These rulings are all consonant with reason, — harmonious with the current of decisions. As to priority of adoption, Blackwell's evidence goes no farther back than 1865; Armistead's goes back to 1860, when his predecessor began to use it, and he continued to use it after he removed his factory from Durham's. Beyond the shadow of a doubt, — if faith is to be placed in the oaths of apparently credible witnesses, — the word was used in 1860, and ever since, to distinguish a peculiar kind of tobacco. This is the smoking tobacco that Armistead's assignor, Wright, made; substantially that for which he subsequently obtained a patent. The evidence proves that. The only essential element of the mark is the word "Durham." When an exclusive title to that was once acquired, its owner might use it as an isolated emblem, or he might combine it as he pleased. It has been suggested that the word "Durham" is insufficient as a mark, because it does not indicate origin or ownership. The New York Court of Appeals set that question at rest when it held that the single word "Cocaine"<sup>2</sup> possessed all the essentials of a common-law trade-mark. As a conclusion of fact, Wright, the assignor to Armistead, was the first to adopt it. The word was not originally adopted as a distinctive name of a place, but as a fancy designation, an arbitrary symbol. By long use, it has become associated with Wright's patent. The symbol was never abandoned by Wright;<sup>3</sup> and his property in its use was transferred by him to Armistead. As a conclusion of law, the title is in Armistead. Registration is therefore allowed. Thirty days' time was allowed for appeal to the head authority of the Office. The following is condensed from his opinion.

§ 659. *By the Commissioner, on appeal:* In October, 1871, Blackwell registered; in December following Armistead applied for registry. Blackwell manufactured at Durham, North Carolina; Armistead, at Lynchburg, Virginia, under an assignment from Wright. The evidence shows that Wright

<sup>1</sup> See *ante*, § 184.

<sup>2</sup> See *ante*, § 237.

<sup>3</sup> See *infra*, Chapter XV., on "Abandonment."

invented a flavoring compound for smoking-tobacco, which he patented; and his tobacco obtained some reputation under the name. On account of its flavor, it became a favorite. Wright removed about two miles from Durham, where he continued to manufacture for a few months, and then gave up business and went into the rebel army. He resumed business in 1869. That was at Liberty, Virginia, where he used the brand, "Original Durham, W. A. Wright, Originator." In 1870, in company with another person, he manufactured tobacco at Stewartville, Virginia, and marked their product "Durham Smoking Tobacco." After that, he assigned to Armistead. There is nothing registrable in the labels of either party. The parties have evidently misread some decisions. Courts of equity have often granted injunctions against the fraudulent use of words which the same court would not for a moment sustain as trade-marks. The "Akron Cement"<sup>1</sup> case is in point. So is the "Brooklyn White Lead"<sup>2</sup> case. In these, the courts enjoined against fraud,<sup>3</sup> but with no intention of defining a trade-mark. Conclusion: neither party is entitled to registration.<sup>4</sup> In the United States Circuit Court,<sup>5</sup> the following is, in substance, the opinion hereinbefore referred to. With a profound deference to the general learning of the judge, the errors of law are with hesitation pointed out. The case is a study from beginning to end, and simply as a study is it commented on.

§ 660. Rives, J.: The main question rests on priority in the use of this disputed trade-mark. The defendant does not pretend that Wright, under whom he claims, ever used the identical trade-mark set up by the plaintiffs. On the contrary, he takes especial pains to show that he placed no particular value on the term "Durham." The discovery which he had made, and for which he seeks protection, was his preparation for, or his mode of treating, smoking-tobacco, so as to mitigate its noxious qualities, and impart to it an agree-

<sup>1</sup> See *ante*, § 188.

<sup>2</sup> See *ante*, § 183.

<sup>3</sup> See *ante*, § 43, "Unfair Competition in Business."

<sup>4</sup> Reported in full, 1 Off. Gaz. 603.

<sup>5</sup> *Blackwell v. Armistead*, *supra*.

able flavor. It is proved that the whole merit of this smoking-tobacco, and its celebrity, were due to the flavoring. He was confessedly the first to begin its manufacture at Durham's Station. There was nothing in the locality that could reasonably have been counted on to commend his manufacture to the public. Take his own statement, and what was his brand? "Best Spanish Flavored Durham Smoking Tobacco." What, in view of the pleadings and the evidence, is the characteristic — the vital element — of this trade-mark? Manifestly, "Best Spanish Flavored." This is the only conspicuous and discriminating element of the trade-mark.<sup>1</sup> "Durham," if indeed a part of it, is subordinate and insignificant. There is nothing to restrain succeeding manufacturers from engrafting it on their brand, so long as they laid no claim to, nor made use of, his words "Best Spanish Flavored" compound, which he indeed appropriated<sup>2</sup> by the first and original use of this only conspicuous term in his stencil-plate in 1860-61. It must be remembered that Wright was only in the infancy of this manufacture at Durham; and that others followed and developed it, till the complainants instituted their brand in 1865-66. What motive could have existed with Wright, all whose reliance was on the merits of his flavoring compound, to invoke the name of a small, thriftless station on a railroad, settled by but two or three families, with a store and this factory, to invoke its name to give celebrity to the preparation to which he solely looked for his reward?<sup>3</sup> It is abundantly proved that his product was known, called, and distinguished in the market as "Durham" smoking-tobacco. The plaintiffs secured their label by copyright.<sup>4</sup> Argument and ridicule are relied on to show the inapplicability of a copyright for such a print. The language of the statute is certainly comprehensive enough to embrace a label of this kind. The object of such copyright is to secure to "the

<sup>1</sup> Misuse of term. See *ante*, Chapter III., "Definition and Nature of a Trade-Mark."

<sup>2</sup> He could not possibly do so, for they are common language.

<sup>3</sup> Such was the very soul of the "Glenfield" case, — *Wotherspoon v. Currie*. See *ante*, §§ 184, 185.

<sup>4</sup> A grave error. See *ante*, §§ 100, 380.

author, inventor, or designer" of any such "print" the sole liberty of printing and vending the same. This is a perfectly legitimate resort to copyright in such a case, and for such a purpose. Perpetual injunction and account of profits decreed.

§ 661. The following decision will give another example of the treatment of a trade-mark interference, and also furnish points of practice and law which may serve a useful purpose. Attention is particularly invited to the points of counsel, and the concession made by one side, which was sufficient in itself to warrant judgment for the other side, without the necessity of recourse to the testimony. By the Examiner, in 1872: "The alleged trade-mark of Schrauder, the applicant, consists simply of the word-symbol<sup>1</sup> 'Bouquet.' To increase the pictorial effect of this mark, 'Bouquet' may be associated with a branch or wreath of flowers, or other appropriate ornaments, but they are not a part of the mark. It is for cured meats. The alleged trade-mark of Beresford & Co., the respondents, consists of a bouquet, thus described. Two sprigs of leaves, having their stems at the bottom of the lithograph, and fastened together by a ribbon, are bent around the bouquet, so that their ends nearly touch, and so as to form an oval. Within this oval is the bouquet, composed of various colored flowers, ears of grain, and several varieties of leaves. It is for hams and breakfast bacon. One mark consists of the word-symbol 'Bouquet,' and the other of the representation or picture of a bouquet. The question that arises is *sui generis*. It is believed that the precise point here suggested has not been decided by any tribunal.<sup>2</sup> The name of an object is brought into conflict with a picture of the object. The former addresses itself more particularly to the ear; the latter, to the eye. No countenance can be given by the Office to what may possibly be turned into an instrument of wrong, or even of annoyance in trade. Let us take a hypothetical case. A customer inquires thus: 'Have you the Bouquet brand of

<sup>1</sup> See *ante*, § 89 *a*, as to this term.

<sup>2</sup> See *ante*, § 88, "Colorable Variation"; also, as to alternate forms, *ante*, § 606.



hams?' 'We have.' He is satisfied with the bare assertion, and gives an order. He does not particularize the bouquet as a picture, nor as the article marked with the word 'Bouquet.' It is characteristic of a trade-mark that it possesses a distinctive individuality, so that it may be confounded with no other, whether by means of vision or of sound.<sup>1</sup> That decides the question. The two things conflict, the word 'Bouquet' and the bunch of flowers called a bouquet. This is the doctrine of *Seixo v. Provezende*.<sup>2</sup> Another preliminary question arises. Do both parties apply their marks to the same class of merchandise, and the same species of goods?<sup>3</sup> If not, then the claims do not conflict. Schrauder's is for cured meats, while Beresford & Co.'s is for hams and breakfast bacon. Both parties mean the same kind of merchandise, although employing different modes of expression. They have, however, proceeded on two widely different theories as to the law of the case. Schrauder has regarded the symbol in its concrete relation only, i. e. as an emblem which he had affixed to merchandise; but Beresford & Co. have wandered into the domains of authorship and invention; and claim the design as an abstraction,<sup>4</sup> and base their claim on the fact that their agent, James, conceived the device. They went so far as to order a lithograph of the bouquet, with the intention of using it as a trade-mark on hams, with special instruction as to details. They say that their agent's invention thereby became complete, as any man of ordinary intelligence could understand and use the mark. They claimed as assignees of James's trade-mark.<sup>5</sup> They concede that Schrau-

<sup>1</sup> See *ante*, § 89, for discussion of this point.

<sup>2</sup> Cranworth, L. C., therein said: "If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market may be as much a violation of the rights of that rival as the actual copy of his device." L. R. 1 Ch. 192; 12 Jur. (n. s.) 215; 14 L. T. (n. s.) 314; 14 W. R. 357.

<sup>3</sup> See *ante*, §§ 66 *et seq.*

<sup>4</sup> See "Abstract Symbol," in the Index.

<sup>5</sup> The later interference cases of *Swift v. Peters* (11 Off. Gaz. 1110), and *C. A. Yale Manufacturing Co. v. C. A. Yale* (30 Id. 1183), discussed these points, and reaffirmed their doctrines.

der was the first to affix the symbol to goods.<sup>1</sup> That was the test of property." Priority was therefore awarded to him.

§ 662. A multiplicity of legal questions upon the trial of an interference arises before the Patent Office. The following case<sup>2</sup> involves a number of nice points worthy of notice. Any matter affecting the title to the thing in controversy may be shown, subject, of course, to the established rules of evidence. After reciting certain facts not necessary now to be considered, the decision of the Examiner proceeds substantially thus.

§ 663. *Motion to allow a New Party to come in.* — After the declaration of interference, a motion was made for the substitution of one John H. Farwell as a party in place of M. J. Cole & Co. It is in evidence that the latter had on their own petition been declared bankrupt, and one Henry D. Hyde had been appointed assignee. Farwell filed an instrument purporting to be an assignment and transfer of the trade-mark in controversy. There is no evidence of the authenticity of said instrument; and, indeed, it is not perceived what legal right the assignee in bankruptcy of the individual and partnership estates of M. J. Cole & Co. had to make the transfer; for the trade-mark had not been included in the schedule of assets.<sup>3</sup> If there had been the formality of including it among the assets, facts in evidence warrant the conclusion that, in contemplation of law, the bankrupts had really no trade-mark property to convey. As Farwell took nothing by his so-called assignment, his motion to be permitted to come in as a party litigant was necessarily denied.

§ 664. *The Essential Part of the Mark.* — It was assumed, for the purposes of this interference, that the name "Paul Jones," the conspicuous element in the mark, was that by which the whiskey would be bought and sold, and known in the market. The evidence shows that it was the prominent, essential, and vital feature of their mark, as it is also of that

<sup>1</sup> This was a fatal concession. See "Abstract Symbol," in Index.

<sup>2</sup> Walch, Brooks, & Kellogg v. M. J. Cole & Co., in 1872.

<sup>3</sup> See case of Bradley v. Norton, 33 Conn. 157; R. Cox, 331.

of their opponents.<sup>1</sup> The inquiry was therefore directed to that name, without which, as a component part of the complex mark, neither party would have desired to make a contest.

§ 665. *As to Title to the Trade-Mark.* — The first question to be settled is this: Did M. J. Cole & Co. have any property in that name, as a portion of a trade-mark to be affixed to whiskey? The testimony of Cole, of Gilmore, the clerk, and of Hunt, the partner, established as a fact beyond any reasonable doubt that M. J. Cole & Co. devised the symbol for their own benefit, although one of their present opponents assisted therein. The mark was to be used in connection with whiskey, which M. Murphy & Co., the predecessors of Walch, Brooks, & Kellogg, were to manufacture in Cincinnati, Ohio, and of which M. J. Cole & Co. were to have the exclusive sale in Boston, Mass. The title was clearly understood to be in M. J. Cole & Co., notwithstanding the fact that, for the sake of convenience, the branding-tool was made in Cincinnati, and at the expense of M. Murphy & Co.

§ 666. *Good Faith.* — The *bona fides* of the latter firm and their successors may well be doubted, in connection with the possession of the branding-tool. It was used by them for whiskey sold to other persons in the West and South; and, contrary to the contract, express or implied, made with M. J. Cole & Co. To the latter-named firm, if to any, it would seem the mark belonged. But there is one material fact disclosed by the evidence which determines all their claim. The name "Paul Jones" was used as a portion of a brand, the other part of which was "Paris, Kentucky, Bourbon." Cole testifies, "If anybody bought the whiskey supposing that it was made in Paris, Kentucky, he would have been deceived." He says that it was thought that that brand would take better with the trade.

§ 667. *Imposition on the Public.* — But one conclusion can be deduced from the evidence in regard to the *bona fides* of M. J. Cole & Co. in adopting that which they allege to be

<sup>1</sup> See case of *Filley v. Fassett*, 44 Mo. 173; 8 Am. L. Reg. (n. s.) 402; R. Cox, 530.

their trade-mark. Their intent was manifestly to impose on the credulity of the whiskey-drinking public, by inducing them to purchase as genuine Kentucky Bourbon County Whiskey an article manufactured at Cincinnati, Ohio. The device had its inception in fraud, and therefore was worthless for the legitimate purposes of a trade-mark, even if the Cincinnati whiskey were proved to be as valuable as that made in Kentucky.<sup>1</sup> Numerous judicial decisions support this view of the law. The public have a right to the genuine thing. M. J. Cole & Co., therefore, never had any legal property in the words composing the alleged trade-mark.

§ 668. *No Title in Assignee.* — As they had no trade-mark to assign when going into bankruptcy, it follows that their assignee took no such property with the assets.

§ 669. *Good Faith of the other Party.* — How does the case stand, as regards Walch, Brooks, & Kellogg? They claim as a trade-mark the words, "Paul Jones, Paris, Kentucky, Bourbon," etc. The said mark is intended to be applied to whiskey manufactured by them at Cincinnati, Ohio. Their own testimony is conclusive on this point. Indeed, they do not make the slightest pretence that the whiskey manufactured by them is distilled in the State of Kentucky.

§ 670. *Want of Equity.* — There is no more equity on their side than on the other. The argument of their counsel at the hearing, that the words constitute a mere arbitrary symbol, and that no deception was intended by them, does not require long consideration. The only meaning that general purchasers would be likely to attach to the words would be, that the whiskey was distilled at Paris, Bourbon County, Kentucky.

§ 671. *Conclusion.* — Walch, Brooks, & Kellogg have not presented a lawful trade-mark for registration. The interference is therefore dissolved, and both applications rejected.

§ 672. *Another Case.*<sup>2</sup> — The firm of S. N. & H. Pike adopted the words "Magnolia" and "Dave Jones" as trade-marks for whiskey, manufactured by the firm before 1854. In

<sup>1</sup> See *ante*, § 71, "A Lack of Truth debars," etc.

<sup>2</sup> *Kidd & Co. v. Mills, Johnson, & Co.*, Com. Dec. 1874, p. 28; 5 Off. Gaz. 337.

that year, H. Pike withdrew from the business, and S. N. Pike continued therein alone for about four years, when Lawrence Myers joined him, and continued in the firm of S. N. Pike & Co. until 1862. Myers then withdrew, and S. N. Pike went on alone until 1864. Then was formed a new firm, consisting of S. N. Pike, Joseph Tilney, and George W. Kidd. The firm did business in the cities of New York and Cincinnati. Tilney withdrew in 1867, and the other two continued as S. N. Pike & Co. In 1868, Pike, in his individual capacity, sold the realty, appurtenances, fixtures, machinery, and apparatus used by the firm in Cincinnati, but owned by him, and gave them this memorandum signed by him: "Having sold to Messrs. Mills, Johnson, & Co. my premises, No. 18 and 20 Sycamore Street, I hereby extend to them and their successors the use of all my brands formerly used by me in my Cincinnati house."<sup>1</sup> The firm of Messrs. Mills, Johnson, & Co., the purchasers, continued the business in Cincinnati; and S. N. Pike & Co. entirely removed to New York. With the addition of a new member, Isaac Bristow, they continued without change of firm name. In 1872, Pike died, and the surviving partners continued under the style of Geo. W. Kidd & Co. They claimed title in the said trade-marks, and applied for registration. Mills, Johnson, & Co. had already registered them. Hence the declaration of an interference. Held by Examiner: The trade-marks belonged to S. N. Pike individually, his firm having had only a license therein determinable at pleasure, and the title to them passed to Mills, Johnson, & Co. On appeal, the Commissioner reversed the decision. He held that, the title having been in S. N. Pike by virtue of abandonment by his former partners, he brought the same into the successive firms which he formed, and that it belonged to those firms, and could not be divested by his individual act. In the Circuit Court of the United States for the District of Louisiana, suit was brought by Johnson *et al.*, as the successors in business of Mills, Johnson, & Co., against Kidd, as the survivor of S. N. Pike & Co., in regard to the "Magnolia" mark. The court held that the complainants had the exclu-

<sup>1</sup> See *ante*, § 57, "Title to a Trade-Mark by Assignment."

sive right under the sale of Pike to their predecessors. An appeal was taken to the Supreme Court, and the decree below was affirmed.<sup>1</sup> The court, by Mr. Justice Field, said of Pike: "He did not place his interest in the trade-mark in the concern as a part of its capital stock. He allowed the use of it on packages containing the whiskey manufactured by them; but it no more became the partnership property from that fact than did the realty itself, which he also owned, and on which their business was constructed." As the case appeared in the courts, a new element had to be considered. It was not only the trade-mark proper, but all the words, "S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio," enclosed in a circle, that Johnson continued to use. He had a perfect right to "Magnolia," but had he a right to the whole brand? Was not the use by him obnoxious to the charge of misrepresentation?<sup>2</sup> No, said the court. "Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character as those to which the mark was attached by its original designer."<sup>3</sup> No suggestion was made that such use amounted to deception.<sup>4</sup>

<sup>1</sup> *Kidd v. Johnson*, 100 U. S. 617. It was held, in 1884, that a trade-mark will pass under a general conveyance of all the assets and effects of a firm, though not specifically designated. *Morgan et al. v. Rogers*, 10 Fed. R. 596.

<sup>2</sup> See *ante*, § 71, "A lack of truth debars a trade-mark from protection."

<sup>3</sup> Citing *Leather Cloth Co. v. American Leather Cloth Co.*, 11 Jur. (N. S.) 513; *Ainsworth v. Walmesley*, 44 L. J. 355; and *Hall v. Barrows*, 10 Jur. (N. S.) 55.

<sup>4</sup> In *Stachelberg et al. v. Ponce* (23 Fed. R. 430), in the United States Circuit Court, Maine Dist., in 1885, Colt, J., held that an assignee or purchaser of a trade-mark from the original proprietor must, in the use thereof, indicate that he is assignee or purchaser, or he will not be entitled to protection in the use of the mark assigned to him. The complainants claimed the trade-mark "La Normandi," or "Normandi," as applied to cigars, and charged the defendant with infringement by using the words "E. P. Normanda," or "Normanda," or "Normandie," for cigars made and sold by him. The complainant, Stachelberg, had obtained the exclusive right to use the mark, by assignment from one Asher Bijur of New York, and he subsequently transferred the right to his firm. It appears that Bijur, the originator of the mark, had used it for years, and built up an extensive sale for this brand of cigars by reason of their good quality. The original trade-mark bore the name of the maker, "A. Bijur," and also the initials, "A. B." For them, the assignee substituted his own name

§ 673. From the foregoing examples, it is inferable that an interference case in the Patent Office may involve innumerable matters in law and equity. A complication of apparently heterogeneous questions sometimes may demand as great professional skill as judicial examinations in any court. In a still-continuing controversy for the ownership of a word-symbol as a trade-mark for tobacco, the following matters have necessarily been considered. The circumstances of adoption, laches, abandonment, suspension of right in consequence of a state of war, partnership (including survivorship), administration of an intestate's estate, and various minor points. The rules of evidence have been strained to their utmost tension to countervail new circumstances that constantly obtrude themselves. It must therefore be concluded that this branch of practice demands great learning and skill.

"M. Stachelberg," and his initials, "M. S." The learned judge seems to have found as a fact, that the complainants were guilty of misleading the public, by false representations, into the purchase of their cigars as those made by A. Bijur, the original owner. Otherwise, the citation of *Manhattan Medicine Co. v. Wood*, 108 U. S., could not have been apposite.

## CHAPTER XV.

## ABANDONMENT.

- § 674. Abandonment sometimes an affirmative defence.
- § 675. Confused notions of abandonment.
- § 676. Property belongs to the first occupant.
- § 677. Effect of abandoning a right.
- § 678. Extinguishment of a trade-mark.
- § 679. Arguing from false analogy.
- § 680. What amounts to abandonment?
- § 681. Intention to abandon. — Illustrations.
- § 682. Actual abandonment must be proved.
- § 683. Abandonment operates from discontinuance of use.
- § 684, 685. Laches, what amounts to.
- § 686, 687. Abandonment not readily to be presumed.
- § 688. Misfortune sometimes works abandonment.
- § 689. Abandonment in one country is abandonment everywhere.
- § 690. Abandonment means intentional discontinuance.
- § 691. Indications of progress in trade-mark law.

§ 674. ABANDONMENT is sometimes alleged as an affirmative defence, while it may incidentally be drawn into question in *ex parte* proceedings upon application for registration. It is advisable, therefore, to ascertain the import of the term, as applied to a trade-mark case, and to consider the facts that may constitute it. But, at the very threshold of the investigation, we must be on our guard not to fall into error in attempting to reason from wrong premises or false analogies.

§ 675. A common mistake is this: in confusing notions of other kinds of rights with that right which consists in property in the use of a certain emblem or device, with which a manufacturer or merchant stamps his wares and merchandise. A trade-mark differs essentially from all other matters of property. For that reason, we cannot hope to arrive at an intelligent understanding of the subject, unless we sedulously keep several points in view. These are distinctions between the dedication or dereliction of tangible property, deliberately



yielded into the common stock of the community or of the world, and the forsaking of a claim to the exclusive use of a mere shadow of incorporeal property, as is such emblem or device which is to become a trade-mark. We have a clear idea of the utter forsaking of lands, and of the casting of a jewel or coin into the sea, or upon the highway; and we can clearly conceive an abandonment of the right to a patent for an invention, or an exclusive claim to the product of a person's literary labor; but the subject of cession, actual or tacit, of the right to prohibit all other persons from marking goods in a certain mode, or with a peculiar symbol, is a matter that is somewhat more difficult of comprehension. Let us inspect the lines of demarcation.

§ 676. Property belongs to him who first makes declaration of an intention to appropriate it to his own use, followed by actual appropriation by him; and the title remains in him, by a principle of general law, till he does some other act which shows an intention to abandon it; for then it becomes, naturally speaking, *publici juris* once more, and is liable to be again appropriated by the next occupant.<sup>1</sup> Thus a deliberate casting away of a valuable thing is an express abandonment of private claim to its possession, and the finder becomes its owner. So a conveyance of land by deed, or a long-suffered adverse possession, is conclusive evidence that the former owner intended to divest himself of title, in favor of the party who shall have succeeded to the possession. So, also, if an inventor from a motive of patriotism, generosity, despair, or any other cause, acquiesce in the public use of his invention for two years, he is debarred from subsequently obtaining a patent therefor;<sup>2</sup> or he may abandon his claim to a monopoly at any instant, and the right to the invention passes at once into the public stock, and ceases to be susceptible of private appropriation. In all such cases, whether of tangible property or of incorporeal rights emanating therefrom, there is something to affect the senses, and the land, or jewel, or invention embodied in a machine or composition of matter, can

<sup>1</sup> 2 Bl. Com. 9.

<sup>2</sup> *Adams & Hammond v. Edwards et al.*, 1 Fish. 1.

be seen and felt; and property in the object or thing may truly be said to exist. Not so with the symbol that a trader has made the peculiar mark of his goods. We have seen heretofore that there cannot be property in an abstract symbol, whether that be an original design, or word, or emblem; for it is only an index to a certain article of merchandise.<sup>1</sup> This undeniable truth being conceded, how can we draw a parallel between the relinquishment of a hold upon something which in itself is property, and another thing which until actually affixed to a vendible commodity is purely ideal? The land and jewel continue to be property under all circumstances; but a trade-mark ceases to be property the moment that its exclusive use ceases, and it resumes its ideal state. Its conjunction with a corporeal thing is like the union of soul and body.

§ 677. The thing abandoned may be instantly and simultaneously seized by a large number of persons, and that either in fact or by operation of law, as in case of a right of common, or a right to use an invention; and when in such case the original owner's grasp is once released, the exclusive right is gone from him forever. He cannot regain it, as in the case of a coin tossed by him into the public street, and which he may be the first again to pick up. A trade-mark, however, may be discarded and be resumed, unless in the mean time it be taken possession of by another, or by a number of persons with united interests, or by the community in general. In the latter case, the arbitrary emblem may truly be said to be extinguished; for when all may use, there is lacking an essential element, to wit, exclusive right. We are supposing that the mark is one that is not personal in its nature, but one which is associated rather with an object of commerce than with a certain person. Yet we read of instances in which courts have held that a man's name may lose all idea of personality, and become merely a generic designation.<sup>2</sup> But we will not stop to discuss exceptional cases.<sup>3</sup>

<sup>1</sup> See "Abstract Symbol," in the Index.

<sup>2</sup> See *ante*, §§ 178-181.

<sup>3</sup> This section and that immediately preceding were cited with approbation by the court, in *Gray et al. v. Taper-Sleeve Pulley Works*, 16 Fed. R. 436.

§ 678. Now, as to the extinguishment of a trade-mark. Suppose, for the sake of illustration, that a word that has been coined by a manufacturer to indicate a peculiar product be intentionally disused by said manufacturer, and that all other persons in the same line of business by common consent adopt the word as the most suitable name for the thing, — as was the case as to the word “Lucilene,” a name given to purified petroleum,<sup>1</sup> — then that name falls into the domain of commerce, and is not susceptible of reappropriation by him who first used it as a fanciful denomination for his article of manufacture. But suppose, again, that, after having deliberately abandoned the mark, the late owner change his intention, while the title is still in abeyance, he may repossess himself of it, just as he might upon reflection recover the jewel flung into the sea or on the highway. The case of the inventor is quite different. He has no right to his invention at common law. The right which he derives is a creature of the statute and of grant, and is subject to certain conditions incorporated in the statutes and the grant. He does not get his right to a patent on the ground of any inherent natural right.<sup>2</sup>

§ 679. Herein we see the impropriety of arguing from decisions made under allegations of abandonment of an invention; for as the idea of invention does not enter into the contemplation of the law applicable to trade-mark property,<sup>3</sup> we must dismiss the false analogy from mind. To complete and perpetuate the act of abandonment, there must be a tender, an acceptance, and an adoption. The only mode by which a trade-mark can be adopted is by user in the actual affixing of the mark to merchandise.<sup>4</sup> How is it with an invention? If the first inventor choose to abandon the result of his genius, after perfecting it so as to be applicable to a practical useful purpose, and another and later inventor obtain a patent therefor, the latter fails to obtain any lawful benefit, not being the first inventor of the particular thing.

<sup>1</sup> See *ante*, §§ 220 and 252, for other examples.

<sup>2</sup> *American Hide & Leather, &c. Co. v. American Tool, &c. Co.*, 4 Fish. 284.

<sup>3</sup> See *ante*, §§ 346, 347.

<sup>4</sup> See *ante*, §§ 52, 382-384.

Why? Because the title to the invention passed to the public, the instant that the only person who had a right to a patent dedicated his invention to the common stock of property. But in the case of discontinuance of the use of a trade-mark the public gain nothing thereby, except the negative benefit of precluding an individual from profiting by the exclusive use of it as a sign. Thus in a case<sup>1</sup> in the Court of Paris, in 1870, when the plaintiff's claim to the exclusive use of the representation of a golden bee, as a trade-mark for hats, was rejected, what did the public gain by the decision that the emblem was not a private mark? The court said, among other things, that, whether as an emblem or as an ornament, the bee is common property. Any person might therefore use it as an ornament for a hatter's label, or in any other mode; but the plaintiff had no exclusive right to "a bee in his bonnet." There is no advantage to the public in the liberty of adorning furniture or hats with golden bees; but there is always presumed to be benefit in the use of an invention, of which benefit use is the strongest kind of evidence. And as to the denomination of an article of commerce, as evidences of our right to call a thing by its true name, we might cite authorities by the score. The name may originally have been the coinage of a manufacturer to designate his peculiar product; but it may have instantly become the only true and proper denomination of the article, wherefore all might use it.<sup>2</sup>

§ 680. *What amounts to Abandonment of a Trade-Mark?*— It is more difficult to lay down a rule in this matter than in the case of corporeal property. The latter we may see and handle. The product of invention affects the perceptive faculties. We cannot see a trade-mark unless it be in full vigor. We may see a perfect *representation* of a signature, or of an emblem of commerce, but the trade-mark itself is visible only as an affix to some corporeal vendible object. Hence one difficulty in determining the exact moment when one must be held to have abandoned a trade-mark. A manu-

<sup>1</sup> Hérold v. Gerbeau, 16 Annales, 76.

<sup>2</sup> See *ante*, § 220, "The Necessary Name of a Product."

facturer or merchant may discontinue the stamping or branding of his products for many years before discontinuing the sale of the goods marked by him, and may destroy his dies, brands, or stencil-plates; for he may have laid up a large stock of his wares or products, or he may have launched them upon the ocean of commerce. Our government has employed a fac-simile of the very peculiar autograph of Mr. Treasurer Spinner as a proprietary mark for national securities, to be sold or exchanged for gold or other valuables. The printing of bonds and notes bearing that trade-mark may forever cease, but the paper evidences of debt remain afloat, and the mark continues to be constructively, if not actually, in use. The nation will not have abandoned the mark by discontinuing the printing of it. By a parity of reasoning, a private owner of a trade-mark does not necessarily abandon it by ceasing to stamp it on goods as his sign-manual or peculiar emblem, if merchandise bearing his trade-mark is still in the markets of commerce. Thus, it was held by Chitty, J., in 1884, that the mere non-user by an owner of a mark between the years 1876 and 1882, though coupled with non-registration, did not amount to abandonment, having regard to the fact that he had not ceased to carry on his business, and had not broken up the mould for his soap, and that a number indicating soap bearing that mark was retained in his price-list.<sup>1</sup> — Yet, although one continued the active use of a mark or fancy name originated by him, protection was refused, on the ground that he had abandoned all claim to an exclusive right in it, by dismissing a suit begun by him to restrain the use of it.<sup>2</sup> — In the same year, in the Circuit Court of the United States for the Southern District of New York, Wallace, J., said of a trade-mark: "It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment rather than of the propri-

<sup>1</sup> *Mouson & Co. v. Boehm*, 26 Ch. D. 898.

<sup>2</sup> *Browne v. Freeman*, 12 W. R. 805; 4 N. R. 476.

etor.”<sup>1</sup> — In the same court, and in the same year, Coxe, J., held that, where a certain brand for flour had been discontinued and abandoned, another firm might legally adopt it for the same kind of goods.<sup>2</sup> — The Court of Appeals of Kentucky, in 1884,<sup>3</sup> held that, where a trader had removed from a building to which he had affixed a fancy name, “Tower Palace,” he, by the act of removal, had abandoned all right to said name, and a rival trader who followed him as tenant had a right to the use of that name.

§ 681. *Intention to abandon.* — The criterion manifestly is this: the evidence of such an intention. Without such intention there could not be abandonment, although it is equally true that the intention may be inferred from circumstances of neglect as well as of positive dereliction, and the party should be concluded thereby. A person may temporarily lay aside his mark, and resume it, without having in the mean time lost his property in the right of user. Abandonment, being in the nature of a forfeiture, must be strictly proved. For example, if the proprietor of the word-symbol “Cocaine” should be met in a suit with the allegation that he had lost all exclusive right to the use of that trade-mark, it would be incumbent on the party making that defence to show that he had, by clear and unmistakable signs, relinquished his claim to it as a trade-mark, so that other manufacturers or vendors of preparations of cocoanut oil had actually employed it as a generic term. If that point were established, it would be manifest that the trade-mark had expired. This is what is meant in French-speaking countries by the expression, “to let fall into the public domain” (*laisser tomber dans le domaine public*). We must examine the surroundings of each case of imputed surrender, to be enabled to settle such question of deliberate yielding up.<sup>4</sup> A defence of abandonment is abhorrent, even in an action at law;<sup>5</sup> and the assertion of

<sup>1</sup> Atlantic Milling Co. v. Robinson *et al.*, 20 Fed. R. 217.

<sup>2</sup> Holt *et al.* v. Menendez *et al.* (Not yet reported.)

<sup>3</sup> Armstrong v. Kleinhaus, 19 Rep. 528.

<sup>4</sup> The original section, ending here, was cited with approbation by the Supreme Court of Indiana, in Julian v. The Hoosier Drill Co. *et al.*, 78 Ind. 408.

<sup>5</sup> Taylor v. Carpenter, 2 Wood. & M. 1.

title, on the ground of abandonment by the prior owner, must be established by the strongest proof.<sup>1</sup> Mere lapse of time does not *per se* warrant the conclusion of abandonment. The circumstances of the case, other than mere lapse of time, almost always give complexion to the delay, and either excuse or give it a conclusive effect.<sup>2</sup> Abandonment itself is a fact, and not a conclusion of positive law, statutory or common, arising from any prescribed state of facts.<sup>3</sup> The presumption is against it.<sup>4</sup> It must be set up in pleading to be availed of;<sup>5</sup> and upon him who thus sets it up rests the burden of clearly establishing by affirmative evidence a positive and actual abandonment, or such laches as clearly indicate an intent to abandon.<sup>6</sup> Abandonment may arise by express declaration, or by conduct equally significant, as by acquiescence.<sup>7</sup> But a declaration of an intention to abandon does not always bind, for one is entitled to the *locus penitentiae*. There must be something more than mere words. The intention must be manifested by acts,<sup>8</sup> and when so manifested it cannot be recalled.<sup>9</sup> But mere non-user of a trade-mark is not conclusive, where the owner was passive because he was powerless to prevent infringements, and he is not estopped from asserting his right when he is in a condition to enforce it.<sup>10</sup> As to the lapse of time that could justify an inference of abandonment, it has been judicially said, that no statute of limitations bars one from protection of his trade-mark.<sup>11</sup> On this point are many decisions, alike in principle, although varied with cir-

<sup>1</sup> *Sohl v. Geisendorf*, 1 Wilson (Ind.) 60. See also *Bump, Laws of Patents, Trade-Marks, etc.*, 246, which cites many cases to the same effect.

<sup>2</sup> *Ibid.* 247; *Russel & Erwin Manuf. Co. v. Mallory*, 10 Blatch. 140.

<sup>3</sup> *Sprague v. Adriance*, 14 Off. Gaz. 308.

<sup>4</sup> *Hovey v. Henry*, 3 West. L. J. 153.

<sup>5</sup> *Williams v. Boston & Albany R. R.*, 17 Blatch. 21.

<sup>6</sup> *United States Rifle & Cartridge Co. v. Whitney Arms Co.*, 14 Blatch. 94.

<sup>7</sup> *Kendall v. Windsor*, 21 How. 322.

<sup>8</sup> See *Bump*, 248, and authorities there cited; and also *Mouson & Co. v. Boehm, supra*.

<sup>9</sup> *American Hide, &c. Co. v. American Tool, &c. Co.*, 1 Holmes, 503; *Ransom v. Mayor of New York*, 1 Fish. 252; *Bell v. Daniels*, 1 Bond, 212; *Mellus v. Silsbee*, 4 Mason, 108.

<sup>10</sup> *McMillan v. Barclay*, 5 Fish. 180.

<sup>11</sup> *Taylor v. Carpenter*, 8 Story, 458.

cumstances. In one case, a lapse of twenty years was held to be no bar;<sup>1</sup> in another case, ten years;<sup>2</sup> in another case, nine years.<sup>3</sup> Yet, in another case, it was held that a non-user of a trade-mark for the period of eight years, notwithstanding the fact that the owner was absent a considerable portion of the time on military service in a time of war, was conclusive evidence against him, and that it could not be resumed as against one who had exclusively used it in the mean time.<sup>4</sup> In the Court of Aix, in France, in 1876,<sup>5</sup> one reason for dismissing the plaintiff's claim was that he had knowingly, and without dispute, allowed the defendant for more than ten years to use the trade-mark in controversy. — From these examples, it is seen how impracticable it is to make any inflexible rule on the subject. Circumstances must always control a decision. The language of Chitty, J., in 1884, is worthy of quotation:<sup>6</sup> “Now it is said that user is the life of a trade-mark, and non-user the death of it. These of course are metaphorical expressions, which must be received with caution. . . . A man who has a trade-mark may properly have regard to the state of the market, and the demand for his goods: it would be absurd to suppose he lost his trade-mark by not putting more goods on the market when it was glutted.” This matter of intention demands further consideration in the light of other authorities.

§ 682. Would it constitute abandonment for the proprietor of a trade-mark calmly to look on while another files a claim for the identical mark? No. Wherefore? For the reason that assertion of title and the recording thereof do not create anything beyond a rebuttable presumption of property. So said the Court of Cassation of France, in 1864, in affirming a decision of the Court of Paris.<sup>7</sup> *Per Curiam*: “The deposit

<sup>1</sup> *Gillott v. Esterbrook*, 48 N. Y. 374.

<sup>2</sup> *Wolfe v. Barnett*, 24 La. Ann. 97.

<sup>3</sup> *Lazenby v. White*, 41 L. J. (N. S.) 354.

<sup>4</sup> *Blackwell v. Dibrell*, 14 Off. Gaz. 633; 3 Hughes, 163. The court cited this chapter as authority.

<sup>5</sup> *Eydoux v. Morel*, 23 Annales, 252.

<sup>6</sup> *Mouson & Co. v. Boehm*, *supra*.

<sup>7</sup> *Leroy v. Calmel*, 10 Annales, 193.



does not constitute an exclusive property in the mark. That is necessary only for the purpose of enabling the owner to obtain redress for infringement. It is necessary to inquire always if the right existed previous to the deposit, and if the depositor has not renounced it." — This ruling is simply an enunciation of a doctrine that is without exception maintained. It is the law of common sense. No one can obtain a title to lands by placing a non-valid paper on record; for, although having all the external appearance of truth, it may have been forged, or never been delivered, and therefore not be a deed in law. So of an emblem previously appropriated by another as his trade-mark. The unjust registrant takes nothing by his stealthy motion, and the true owner is not despoiled thereby, although the attempt at fraud may furnish grist for the judicial mill. In an analogous case,<sup>1</sup> Clifford, J., held that actual abandonment must be proved, and that it is not possible to hold that the use of an invention without the consent of the inventor, while his application was pending in the Patent Office, could defeat the operation of the letters patent afterwards duly granted. It may be that the owner of the trade-mark was under a disability to register, as in the case of a resident of France previous to the making of the convention of 1869. Yet his title was perfectly valid at common law. Section 9 of the statute of March 3, 1881, clearly recognizes this truth, for it makes it actionable for any person to "procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means," etc. Now, it is obvious that, if one by mere registration could divest another of a common-law right, said section should never have been written. Section 10 of the same statute carefully preserves all common-law remedies for a wrongful use of even unregistered trade-marks. We see, therefore, that it is not abandonment for an honest trader, through inability or indisposition, to lie on his oars while another person attempts to commit an act of piracy. The

<sup>1</sup> Dental Vulcanite Co. v. Wetherbee, 3 Fish. 87.

wrong-doer is "hoist by his own petard." It must, however, be conceded that a long-continued neglect to attack a trespasser may be a circumstance tending to prove an intention to abandon. In one case,<sup>1</sup> after the beginning of a suit based on infringement, the real defendants (although concealed behind others) made an attempt to appropriate the infringed trade-mark, by going through the form of registering it as theirs, under the Missouri statute of March, 1866. The court, by Currier, J., scouted the idea that the law could be made available for such a nefarious purpose, and said, as to that statute, "It was not designed to weaken or abridge any existing rights, or any future right to a trade-mark which might be acquired in the usual way, or to legalize, in any form or measure, piracy in trade-marks." Shepley, J., instructed the jury in a patent case,<sup>2</sup> that "abandonment means a general abandonment to the public, and must be shown affirmatively and positively, as affecting the interest of the party; . . . it is dedication to the public; a giving up of the claim to the monopoly in the invention." In the case of an easement,<sup>3</sup> the court said: "The presumption of abandonment cannot be made from the mere fact of non-user. There must be other circumstances in the case to raise that presumption. The right is acquired by adverse enjoyment. The non-user, therefore, must be the consequence of something which is adverse to the user." This point of non-user calls up a case that requires comment.

§ 683. In the New York Common Pleas Court, in 1854,<sup>4</sup> Ingraham, First J., charged the jury that the defendant was liable for the sale of leather stamped with a *former* trade-mark of the plaintiff, although at the time of said sale the plaintiff employed exclusively a mark of a different device; and that 's property in the original trade-mark was not divested 's discontinuing its use. It may possibly be that the reporter of the case, although a highly intelligent member of

<sup>1</sup> *Filley v. Fassett*, 44 Mo. 173; 8 Am. L. Reg. (n. s.) 402; R. Cox, 530.

<sup>2</sup> *American Hide, &c. Co. v. American Tool, &c. Co.*, 4 Fish. 305.

<sup>3</sup> *Ward v. Ward*, 7 Ex. 738.

<sup>4</sup> *Lemoine v. Ganton*, 2 E. D. Smith, 348; R. Cox, 142.

the legal profession, may have misunderstood the language of the judge. On appeal to the court, *in banc*, Daly, J., in delivering the opinion of the court, said, more correctly: "The fact that the plaintiff had discontinued the use of this trade-mark for three years would not deprive him of a right of action against the defendant, for selling leather which was not manufactured by the plaintiff, but stamped in the same manner in which the plaintiff had formerly designated the leather manufactured by him, thus purporting to be of his manufacture, and declared by the defendant at the time of sale to be the genuine Lemoine calfskins." If we were to stop here, it might be with the erroneous impression that the learned judge meant that the mark had not been abandoned by a non-user for three years. He continued: "The wrong and injury to the plaintiff consisted in the sale of calfskins falsely purporting and declared to be of his manufacture; and it makes no difference whether that object was effected by counterfeiting the trade-mark which he uses at present, or one that he formerly used. An injury results to him in either case." This, then, was not an action for infringement of a trade-mark; but was an action for fraudulent competition and deceit, by means of a certain device that had formerly been a trade-mark.<sup>1</sup> Lemoine had abandoned that device, and it had ceased to be a trade-mark. The act of abandonment was completed the instant that he intentionally discontinued its use, — three years before.

§ 684. *Laches*. — What may be considered such remissness, carelessness, or neglect, as shall work a forfeiture of right to a trade-mark? It has sometimes been contended that a forbearance to prosecute infringers amounted to abandonment. But this view has not received the sanction of our courts. To be sure, we find an opinion of Wylie, J., of the Supreme Court of the District of Columbia, which, taken just as it appears in print, affirms that such forbearance does amount to abandonment. It would be a piece of gross injustice to the judge to omit to state that he receded from the position first

<sup>1</sup> See *ante*, § 34, "Principles on which Infringement is prohibited," and § 43, "Unfair Competition in Business."

assumed by him, and made all the amends in his power by granting a decree in direct opposition to his published opinion.<sup>1</sup> From the published report, it seems that the complainants are an incorporated company at Sheffield, England, engaged in the manufacture of fine cutlery, and are the successors of Joseph Rodgers & Sons, by whom the business was first established more than a hundred years ago. They alleged that their name and mark — a star and a Maltese cross — had been infringed. The defendants were respectable booksellers and stationers in Washington, D. C., and dealers in fine penknives, scissors, and other cutlery. A preliminary injunction was asked for. The judge said, *inter alia*: “ I am of opinion that this suit cannot be maintained by these complainants. . . . These goods have been manufactured in Germany, and sold extensively in this country under this spurious trade-mark, for nearly, if not quite, a quarter of a century. These facts must have been known to the complainants almost from the beginning. One of the affiants states that he himself gave verbal notice of them to a clerk of the complainants, at Sheffield, in 1865, and was informed that his employers were perfectly aware of all that had been done. And yet, in all this period, the complainants have taken no measures, either in this country or in Germany, to vindicate the exclusiveness of their title to the trade-mark in question. They have seen, looked on, and permitted these German manufacturers to employ a similitude of their own trade-mark, and under it to make extensive sales to the people of this country. This long acquiescence might not possibly debar the complainants from remedy for their injury as against the German manufacturers. . . . It tended to encourage, and did encourage, our own people to part with their money in exchange for these goods. It was in violation of no law or contract, nor was it a wrong done to Rodgers & Sons, of Sheffield, when the goods in question were bought by the defendants in the city of New York. The neglect of these English manufacturers to arrest within a reasonable period, by legal measures, the violation of their rights in their own

<sup>1</sup> Rodgers & Sons v. Philp & Solomons, 1 Off. Gaz. 29.

trade-mark by the Germans, amounted in law to a license to the world to buy the goods from the latter under the imitation trade-mark. All that can be expected of them is to take care that they are not cheated themselves, and that they defraud no one in their turn. It could not be tolerated that manufacturers, like patentees, should have the right as long as they should have a trade-mark — it might be for a hundred years, as in the case of these complainants — to send agents all over the country, and interfere with the business of every man who happened to have bought goods manufactured by other companies, and sold under an imitation trade-mark.” Excellent! a title to roguery by prescription! Plea of a pirate that he and his ancestors had been so long engaged in the business of plundering foreign craft, that his right in the premises had become perfect, and a prayer that the indictment be quashed! We might regard this opinion of the judge as a gleam of judicial pleasantry, were it not for the solemn style of the document as a whole. By consulting a previous part of this same opinion, we find that the defendants say in their answer that the goods were purchased with the knowledge that they were manufactured in Germany; “that goods of this manufacture, and stamped with this trade-mark, have been well known to persons engaged in the business for nearly, if not quite, twenty-five years, as being different from those made by the English house of Joseph Rodgers & Sons; that they are of equally good quality with those produced by the English firm, and can be sold for thirty-three per cent less than these.” We are all well aware by this time that it is no defence that the spurious wares are as good as the genuine.<sup>1</sup> If that could be received as a defence to a prosecution for infringement, farewell to protection! Nor is it a valid answer that the trespass is of long continuance. There would be, therefore, no just defence to the bill filed in the case under discussion. So, upon reflection, thought Judge Wylie. Out of a feeling of tenderness for the reputation of a judge, as well as to demolish a false authority, let us now place in print the sequel, which by some fatality has never found its way

<sup>1</sup> See authorities cited *ante*, in note to § 336.

into the "Official Gazette," or (it is believed) any other legal periodical or book of reports. On the 5th day of February, 1872, the cause came on to be heard before the same judge. He decreed a perpetual injunction against the defendants, their servants, agents, or employees, restraining them from passing, putting up, selling, or offering for sale, penknives, pocket-knives, or other articles of cutlery other than those manufactured by the complainants, having imprinted, stamped, or in any wise marked thereon a star and Maltese cross, or any device substantially similar to, or in any manner imitating, said device of a star and a Maltese cross adopted and used by the complainants, Joseph Rodgers & Sons, as their trade-mark, etc. In consideration of the honorable conduct of the defendants, in accepting the situation with good grace, while not throwing any obstacles in the way of a righteous result, the complainants remitted the costs. Let us now learn what other judges have said upon the matter of abandonment of trade-marks.

§ 685. Story J., once spoke thus:<sup>1</sup> "Again it has been said, that other persons have imitated the same spools and labels of the plaintiffs, and sold the manufacture. But this rather aggravates than excuses the misconduct, unless done with the consent or acquiescence of the plaintiffs, which there is not the slightest evidence to establish; or that the plaintiffs ever intended to surrender their rights to the public at large, or to the invaders thereof in particular." The circumstances of this case are very similar to those in the Rodgers & Sons suit; and the defence therein made set forth infringements by others upon the plaintiffs, an English house. — And now comes another witness upon the same side of the question. As to the pretence of right in plundering foreigners, Woodbury, J., said:<sup>2</sup> "I am not aware of any principle by which a usage in this or a foreign country is competent evidence in defence of a wrong. . . . The defendant now argues that this evidence was competent to show an acquiescence by the plaintiff in the use of his marks, or to show a dedication of them

<sup>1</sup> Taylor v. Carpenter, 3 Story, 458; R. Cox, 14.

<sup>2</sup> Taylor v. Carpenter, 2 Wood. & M. 1; 9 L. T. 514; R. Cox, 32.

to the public, as he knew that marks of theirs as well as of others were used in this way, and without redress, in this country as well as abroad. . . . But I am not aware that a neglect to prosecute, because one believed he had no rights, or from mere procrastination, is any defence at law, whatever it may be in equity (1 Story, 282), except under the statute of limitations pleaded and relied on, or under some positive statute, like that as to patents, which avoids the right if the inventor permits the public to use the patent some time before taking out letters. . . . There is something very abhorrent in allowing such a defence to a wrong, which consists in counterfeiting others' marks or stamps, defrauding others of what had been gained by their industry and skill, and robbing them of the fruits of their 'good name,' merely because they have shown forbearance and kindness. . . . It is rather an aggravation to the plaintiffs that many others have injured them." — Lest the false doctrine be not sufficiently exploded, we may cite further authorities, powerful enough to pulverize the absurdity. When discussing the idea of acquiescence operating as an absolute surrender of an exclusive right, Duer, J., said:<sup>1</sup> "The consent of a manufacturer to the use or imitation of his trade-mark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent, whether expressed or implied, when purely gratuitous, may certainly be withdrawn; and, when implied, it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license." Potter, J., eighteen years later, used substantially the same language,<sup>2</sup> and held that it is no defence that the fraud has been multiplied, and further held that acquiescence cannot be inferred, and is revocable if it could be. Upon appeal to the general term, two of the judges held that it was no acquiescence in the plaintiff, where it did not appear that he had discovered any individual whom he could attack as an offender, although the plaintiff knew that persons were trespassing upon him. The third judge thought, that the knowledge of the fact of such infringement

<sup>1</sup> *Amoskeag Manuf. Co. v. Spear*, 2 Sandf. S. C. 599.

<sup>2</sup> *Gillott v. Esterbrook*, 47 Barb. 455.

for more than twenty years would be treated as an acquiescence by him. But not one of the members of the court hinted that such acquiescence could amount to entire abandonment. Currier, J., in speaking for the whole court,<sup>1</sup> took the same position that had before been maintained, and said that the infringement of the plaintiff's mark by others in no way aided the defence. Said he: "The depredations of others on plaintiff's rights furnish no excuse to the defendants for similar acts on their part. It is rather an aggravation to the plaintiff that others have also injured him. And courts have not shown any disposition to encourage that line of defence." We hardly need to pursue the theme, for the weight of judicial authorities all tends the same way, in vindication of the venerable maxim, "*Jus et fraus nunquam cohabitant.*"<sup>2</sup>

§ 686. Yet truth compels the citation of two French cases which *seem* to assert that right and fraud may not only inhabit the same house, but may dwell together in harmony. The first is a judgment of the Court of Cassation.<sup>3</sup> It has such an air of moral obliquity about it as almost justifies the animadversions of the eminent jurists who have criticised and condemned it. If we carefully scan all the facts, we may possibly come to the conclusion that the judgment is reconcilable with the maxim above quoted, and also with that cited and relied upon by the demandants' counsel, — "*Contra non valentem agere non currit præscriptio.*"<sup>4</sup> It was admitted by the tribunal of first instance, that, for more than half a century, the files made and sold by the house of Spencer & Stubs, now Spencer & Son, of Sheffield, England, had enjoyed an incontestable industrial renown; and that for many years — thanks to immunities given on the Continent to the

<sup>1</sup> *Filley v. Fassett*, 44 Mo. 173.

<sup>2</sup> *Blodgett, J. (Williams v. Adams, 8 Biss. 452)*, held that abandonment of a trade-mark is not made out by showing numerous infringements in which the owner of the trade-mark has not acquiesced. The same doctrine was maintained in *Sohl v. Geisendorf*, 1 Wilson (Ind.), 60; and by the Supreme Court of Louisiana, in *Funke v. Dreyfus*, 34 La. Ann. 80; 44 Am. R. 413.

<sup>3</sup> *Spencer & Son v. Peigney*, 10 Annales, 197.

<sup>4</sup> See *Broom's Legal Maxims*, 700.



counterfeiting of foreign products — the manufactures of the demanders had been imitated in innumerable quantities, with the mark and name of the genuine house, all which was done without the acquiescence of the demanders. By long usage, continued the mouth-piece of the tribunal, the name and mark had come to be the characteristic indication of a product; and therefore the owners had lost all right to the exclusive use by the effect of a sort of prescription of fact, *longi temporis*, for the name and mark had ceased to indicate origin or ownership. The Advocate-General Bédarrides asks, on appeal, “Of what prescription do they speak? The tolerance of usurpation, can that serve to found a right?” The Court of Paris, on appeal, discoursed thus: “Considering that, for more than fifty years, the mark composed of a crescent, a Z reversed, and the name of Spencer has been adopted by French industry in the fabrication of a species of file; that this mark does not designate the origin, nor even the nature, of the fabric; that the French fabricants have rendered it common in France, and have given to it a just celebrity: considering that Spencer & Son, in availing themselves of Article 12 of the treaty of commerce between France and England of the 10th of March, 1860, had not the power to take a mark which had become the property of French industry; that for the purpose of distinguishing their products they could take only a mark peculiarly their own, and that what they really did deposit with the clerk of the Tribunal of Commerce of the Seine is a mark composed of a crescent, a Z reversed, the name of Spencer, and the name of their place of manufacture, Sheffield: considering that it is only to the last mark that Spencer & Son have an exclusive right; that Peigney has respected their property on this point, and in placing on the files made by him the mark which for long years had become proper to French commerce, he has committed no tort; and adopting in full the reasons of the judges below, let the appeal go for naught, and order that the judgment appealed from have full and entire effect, and condemn Spencer & Son to the costs of appeal.”—It is worth while to glance at later French and German authorities. The Tri-

bunal Civil of Lyons, in 1872,<sup>1</sup> held that abandonment of a registered trade-mark is not presumed, and cannot be presumed, from the fact of refraining from suing infringers during a time of more or less duration; and yet the defence had established the fact, that prior to 1845 the plaintiff had in his prospectuses admitted that his mark had been counterfeited.— In the month after that decision was made, the Court of Aix held that abandonment will not be presumed from the fact that the manufacturer and owner of the mark, to discourage competition, sold inferior products without affixing his mark thereto.<sup>2</sup>— In the Court of Paris, in 1874, it was held that abandonment is not to be presumed even when the inventor had published the name for the use of a particular business concern, and others could be interdicted for using the particular designation.<sup>3</sup>— So also in the Court of Cassation, in 1875, it was held that the fact that a certain number of industrials had made use of the inventor's name to designate a product obtained by the aid of his formulæ would not suffice to make that name *publici juris*, nor to turn it into a necessary name of the product.<sup>4</sup>— In the year after that, in Germany, the Court of Appeal of Cologne held that a trade-mark should not be considered as abandoned to the public from the mere fact that it had been used by a few members of a certain class of merchants, when it had not been used generally by that class.<sup>5</sup>— So the Court of Paris, in 1877, said that the proprietor of a regularly deposited trade-mark could not be deprived of his claim to exclusive user, unless he should have consented to its cession without reserve, or should have abandoned it in an absolute manner, that is to say, with an unequivocal will to let it fall into the public domain. The facts in that case were these. The plaintiff had published a list in which—among a great number of other and common marks, to be selected at pleasure by his retail customers, and to which they could join their own names—he had included

<sup>1</sup> *Menier v. Buisson et al.*, 18 *Annales*, 24.

<sup>2</sup> *Menier v. Rochebrun*, *Ibid.* 29.

<sup>3</sup> *Liebig and Liebig's Extract of Meat Co. v. Collemann et al.*, 19 *Id.* 83.

<sup>4</sup> *Demot, Dubrac, & Benités v. Société des Héritiers Liebig*, 20 *Id.* 115.

<sup>5</sup> *Mulhens v. Buchholz*, 24 *Id.* 29.

the mark involved in the suit; but he had continued to affix to his products a notice that his label and mark were registered. That was evidence that he had not abandoned.<sup>1</sup> — In 1882, the Tribunal of Havre<sup>2</sup> said, that whereas property in a mark can be abandoned expressly or tacitly, tacit abandonment cannot be presumed, and simple acts of tolerance cannot be deemed renunciation; that non-user itself during the time, more or less long, permits nevertheless the claim to property in a mark, provided that during that time it did not fall into the public domain. — The late M. Pataille, certainly very high authority, gave as his opinion, that the default of suing for false imitation going back for more than three years cannot be regarded as abandonment, when coupled with the fact that the owner of the trade-mark had legally registered it, and had not ceded his right.<sup>3</sup>

§ 687. We must constantly bear in mind that the decision of law in the case of Spencer & Son is based on the question of fact determined in the tribunal below. The mark had lost its pristine integrity. Its individuality was annihilated. It might be likened to a ship decoyed by false lights, and dashed into fragments on the rocks, to become a common prey. The mischief had been done beyond redress. The mark had lost all power to distinguish the manufacture of any particular person or company. It had become, through an unfortunate concurrence of circumstances, the mere sign of a class of goods. We perceive, therefore, that this cannot be deemed, even in theory, to be a case of abandonment. The law will protect a man's life, but it cannot restore vitality. A dead man must remain dead.<sup>4</sup> The tribunal of last resort, the Court of Cassation, was bound by the fact established below. It said, *inter alia*: Inasmuch as Spencer & Son have deposited in France another mark, differenced from the preceding by the addition of the name of their place of manufacture, Sheffield, they have an incontestable exclusive right of property in that; but as

<sup>1</sup> *Carrière v. Durand et al.*, 25 *Annales*, 106.

<sup>2</sup> *Chapu v. Legrand et al.*, 27 *Id.* 201.

<sup>3</sup> *Affaire Vrau v. Divers*, 26 *Id.* 85.

<sup>4</sup> "Medicina mortuorum sera est." Quintil.

this latter mark has not been usurped, the judgment must be affirmed. — Our wrath subsides when thus reaching the inevitable conclusion, that the demanders were virtually conquerors. The supreme court had not the power to overturn a *fact* found. It did the best it could by intimating in clear language that the trivial addition of the name of a place made a new mark. — As the house of Spencer & Son never *intended* to abandon the trade-mark, it had not been abandoned.

§ 688. The case of *Stubs v. Astier et al.*,<sup>1</sup> in the Court of Paris, in 1864, on appeal from the Tribunal Civil of the Seine, involved the same principle. The Tribunal confiscated the spurious goods, consisting of cutlery, and imposed a fine. Hence the appeal. The appellate court said that the mark claimed by the complainant as his peculiar property had long been in France the index of a product of superior quality, and had ceased to be an indication of the origin of manufacture, but had become the very designation of the nature of the product of which it is the denomination. That a mark so long known to the public to cover products of a superior quality would operate to the exclusion of all others was manifest, and it would cause considerable damage to French industry to deprive it of the fruit of labor to enrich Peter Stubs; that such a result would, in effect, extinguish the just stipulations of reciprocity contained in the treaty of commerce of March 10, 1860.<sup>2</sup> It must also be considered that Peter Stubs can assure his rights, in the wise limits that the law has traced, by giving to the mark used by him in France a peculiarity of appearance that can suffice to prevent confusion between his products and those of other persons. He will then have obtained all the advantages that the said treaty intended for foreigners. — When we reflect upon this judgment and the one immediately preceding it, we come to the conclusion that the courts did not desire to countenance fraud in the slightest degree. The originally trustworthy marks

<sup>1</sup> 10 *Annales*, 212.

<sup>2</sup> Such was also the reasoning of the Court of Rouen, in a case of citizens of the United States, in 1883. *Lanman & Kemp v. Bognard et al.*, 29 *Annales*, 200.

had, through misfortune, — brought on indeed by piracy, — lost all power to indicate origin or ownership. By a slight modification of the device, a perfectly valid trade-mark could be established. The public would know whose products they were purchasing, and the foreign manufacturers would reap the advantages legitimately belonging to them.<sup>1</sup> We reach another conclusion: these two cases do not militate against the generally accepted rules in abandonment cases.

§ 689. *Abandonment in one Country is Abandonment in all Countries.*—Commerce is not bounded by territorial limits. The whole of the habitable globe is hers. It is true that the owner of a counterfeited mark may not have the means of pursuing pirates in foreign lands, but his rights remain undiminished. It is only the *remedy* that is lacking. Reprisals upon trade must continue in most countries until reciprocity of protection be guaranteed by treaties or conventions; but certainly it cannot be pretended that there is an abandonment when one has no possible opportunity of attack or defence. Our government does not forfeit its exclusive right to certain proprietary marks, because they are counterfeited in Europe. It is a well-known fact, that when an American merchant visits certain Belgian, German, and Swiss manufactories, he is asked what English maker's trade-mark he desires to have stamped upon his purchases. Doors, similar to those used by vendors of paper-hangings, are swung open, and all the trade-marks of British manufacturers are displayed by the shameless depredators. The victims are well aware of this practice; but their hands are tied. They are strangers and foreigners, and have no standing in court until enfranchised by treaty stipulations.<sup>2</sup> Do they forfeit their rights by reason of mere

<sup>1</sup> Mellish, L. J. (in *Ford v. Foster*, L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (n. s.) 219; 20 W. R. 818), said: "What is the test by which a decision is to be arrived at whether a word which was originally a trade-mark has become *publici juris*? I think the test must be whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods."

<sup>2</sup> Since the first publication of this section, nearly all European nations have, by treaties, or stipulations in the nature thereof, allowed foreigners to

lapse of time? No. There being no intention to abandon their marks, it follows that their marks are not abandoned. Abandonment must be as broad as the domain of commerce. The converse of this proposition is, that if one retain his right to a trade-mark in one country, he retains it in all. If the trader were obliged to repel every assault upon his property, under pain of forfeiture of title to it, what would be the consequence? He would constantly have to be in a belligerent attitude, and to be ubiquitous. He would soon fall into the "Slough of Despond." Might would inevitably usurp the place of Right. Is he, then, not compellable to assert his right? Certainly he is, but only within reasonable limits. The law does not demand the performance of impossibilities. The wisdom of all nations attests the correctness of this idea. Nevertheless, it must be remembered that a symbol that is *publici juris* in one country is so in all others. The Court of Cassation of France, in 1874,<sup>1</sup> held that, even when treaties confer reciprocity in trade-mark rights in France and England, the vulgarization of a mark in England is an obstacle to the claim of that mark in France.—So also in an appeal to the Saxon Court Royal of Leipzig, in 1878, it was held that foreign trade-marks that have ceased to be legally such in the country of origin are equally invalid in other countries.<sup>2</sup>—And so, in the Court of Appeal of Brussels, in 1884,<sup>3</sup> the same rule was applied.

§ 690. *Conclusion deduced from the foregoing Authorities.*—The phrase "abandonment of a trade-mark" means an *intentional* discontinuance of it. The original proprietor may

register, and consequently to sue. But registration has not a retroactive effect. The Tribunal of Commerce of Brussels, in 1883, held that a registration of a trade-mark in Belgium by a foreigner, anterior to a treaty with his country, is a nullity. 1 Bulletin Officiel, 178.—In the same year, the Court of Cassation of France held that the registrant of a trade-mark has no redress for counterfeiting before registration. Ibid. 198.—It is not vainglorious again to call attention to the truth, that in the United States a more liberal spirit has always prevailed, and that, without regard to nationality or formalities of registration, foreigners have stood on an equality with our own citizens.

<sup>1</sup> Lawson *et al.* v. Dechaille, 19 Annales, 153.

<sup>2</sup> Affaire Armstrong, 23 Id. 216.

<sup>3</sup> Jaubert-Bonnaire v. Wilford, Bulletin Officiel, January 8, 1885.

readopt it, unless in the mean time some other person or persons shall have lawfully become possessed thereof; or unless the device shall have become a mere designation of quality or kind of product. In the latter case, the trade-mark is extinguished. If readopted, it has all its original force and vigor. If a trade-mark be purely personal in its nature, it cannot be appropriated by another by virtue of abandonment; for otherwise a false credit might be gained thereby.

§ 691. It may now be said of the subject of Abandonment, as of other matters preceding it in this book, that the natural resting-place has been reached. But the writer does not intend to abandon the study of this interesting branch of jurisprudence, — the Law of Trade-Marks. The same inquiring spirit which has impelled his pen will watch the gradual completion of a system now emerging from infancy, the foundation of which is laid in the doctrines collected in these pages. At every step he has been cheered by additional light. Even Japan, by the lips and pen of one of her representatives, has furnished valuable information upon cognate subjects, although not in a shape available for the present purpose. From clear indications, the belief is justified that all civilized nations will soon unite in an harmonious code for the protection of the trade-mark, as the surest guaranty of universal commercial faith.<sup>1</sup> In the mean time, beneath the touch of able jurists throughout the domain of Commerce, rough stones shall become as polished corners of the Temple, and present theories be permanently established in the intellectual superstructure.<sup>2</sup>

<sup>1</sup> See *ante*, § 26, and the Laws of Various Countries, in the Appendix. Has not this prophecy of more than a dozen years ago been almost completely fulfilled? Has not even Japan proved her right to be classed with the most enlightened nations in respect to the subject of this treatise? Truly, a common bond of interest has drawn all civilized countries into a close communion.

<sup>2</sup> What is demonstrated, on comparison of this revised edition with the first? That crude speculations have crystallized into established principles; and that conflicting opinions have, by the attrition of mind on mind, been reconciled, adjusted, and reduced to harmonious order.

## APPENDIX.

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### TREATIES, CONVENTIONS, ETC., IN RELATION TO TRADE-MARKS.

CONVENTION *between the United States and the Austro-Hungarian Empire, November 25, 1871. Proclaimed June 1, 1872. (17 Statutes at Large, 917.)*

#### ARTICLE I.

Every reproduction of trade-marks which, in the countries or territories of the one of the contracting parties, are affixed to certain merchandise to prove its origin and quality, is forbidden in the countries or territories of the other of the contracting parties, and shall give to the injured party ground for such action or proceedings to prevent such reproduction, and to recover damages for the same, as may be authorized by the laws of the country in which the counterfeit is proven, just as if the plaintiff were a citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in the Austro-Hungarian Empire, or of citizens of the Austro-Hungarian Monarchy in the territory of the United States, cannot exist for a longer period than that fixed by the law of the country for its own citizens. If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the countries or territories of the other of the two contracting parties.

#### ARTICLE II.

If the owners of trade-marks, residing in the countries or territories of the one of the contracting parties, wish to secure their rights in the countries or territories of the other of the contracting parties, they must deposit duplicate copies of those marks in the Patent Office at Washington, and in the Chambers of Commerce and Trade in Vienna and Pesth.<sup>1</sup>

<sup>1</sup> See the note to Article II. of Convention with France, p. 675.



**ADDITIONAL ARTICLE** *to the Treaty of Commerce and Navigation between the United States and Belgium, of July 17, 1858. Proclaimed July 30, 1869. (16 Statutes at Large, 765.) Renewed June 11, and proclaimed June 29, 1875.*

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens of one of the two countries may wish to secure the right of property in the other must be lodged to wit: the marks of citizens of the United States at Brussels in the office of the clerk of the Tribunal of Commerce, and the marks of Belgian citizens at the Patent Office in Washington.

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**CONVENTION** *between the United States and Belgium, of April 7, 1884. Proclaimed July 9, 1884. (Statutes for 1883-84, List of Treaties, etc., 56.)*

**ARTICLE I.**

Citizens of the United States in Belgium, and Belgian citizens in the United States of America shall enjoy, as regards trade-marks and trade-labels, the same protection as native citizens, without prejudice to any privilege or advantage that is or may hereafter be granted to the citizens of the most favored nations.

**ARTICLE II.**

In order to secure their marks the protection provided for by the foregoing article, the citizens of each one of the contracting parties shall be required to fulfil the laws and regulations of the other.

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**AGREEMENT** *between the United States and Brazil, September 24, 1878. Proclaimed June 17, 1879. (21 Statutes at Large, 659.)*

The citizens or subjects of the two high contracting parties shall have, in the dominions and possessions of the other, the same rights

as belong to native citizens or subjects in everything relating to property in marks of manufacture and trade.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

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CONVENTION *between the United States of America and France concerning Trade-Marks, of April 16, 1869. Proclaimed July 6, 1869. (16 Statutes at Large, 771.)*

#### ARTICLE I.

Every reproduction in one of the two countries of trade-marks affixed in the other to certain merchandise to prove its origin and quality is forbidden, and shall give ground for an action for damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven, just as if the plaintiff were a subject or citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in France, or of French subjects in the territory of the United States, cannot exist for a longer period than that fixed by the law of the country for its own citizens.

If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the other country.

#### ARTICLE II.

If the owners of trade-marks, residing in either of the two countries, wish to secure their rights in the other country, they must [respectively <sup>1</sup>] deposit duplicate copies of those marks in the Patent Office at Washington,<sup>2</sup> and in the clerk's office of the Tribunal of Commerce of the Seine, at Paris.

<sup>1</sup> This Article II. is not correctly translated. On March 21, 1877, the French Minister at Washington invited the attention of the Secretary of State to the fact of the omission of a material word, "*devront respectivement être déposées en double exemplaire,*" etc. On April 25, 1877, the Secretary answered, that our government interpreted the article in the same sense as it has in the French text. (Coudert, *Marques de Fabrique*, p. 45.)

<sup>2</sup> Many errors have been committed in consequence of a misconception of the scope and meaning of the language of this article. The Commissioner of Patents, on December 6, 1872, made a decision thereon, of which the following is an extract: "That clearly means that a resident of this country wishing to secure protection for his trade-mark in France must give constructive notice to the people of that country, by depositing duplicate copies in the clerk's office of the Tribunal of Commerce of the Seine; and so of a resident of France, who is required to deposit his mark in this Office. So far as the tribunals of this country

CONVENTION *between the United States and the German Empire, of December 11, 1871. Proclaimed June 1, 1872. (17 Statutes at Large, 921.)*

ARTICLE XVII.

With regard to the marks or labels<sup>1</sup> of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade,<sup>2</sup> the citizens of Germany shall enjoy in the United States of America, and American citizens<sup>3</sup> shall enjoy in Germany, the same protection as native citizens.

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DECLARATION *between the United States and Great Britain, October 24, 1877. Proclaimed July 17, 1878. (20 Statutes at Large, 703.)*

The subjects or citizens of each of the contracting parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted, or may hereafter be granted, to the subjects and citizens of the most favored nation, in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries.

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DECLARATION *between the United States and Italy, June 1, 1882. Proclaimed March 19, 1884. (Statutes for 1883-84, List of Treaties, 16.)*

The citizens of each of the high contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as are concerned, the mere deposit of copies of a mark in this Office, by residents of this country, does not amount to registration. The Act of Congress of July 8, 1870, is the governing rule in the latter case." (*Matter of Lanman & Kemp.*) This is the rule under the Act of 1881.

Before the passage of the Act of 1870, many residents of the United States deposited copies of their marks in the Patent Office. That was done without authority of law, and consequently no certificate of such deposit can be received in evidence. This is an important point.

<sup>1</sup> The use of this word must not be permitted to mislead into the idea that *labels* are technical trade-marks; for, as has been shown in the foregoing treatise, they are only mere vehicles for trade-marks.

<sup>2</sup> These five words mean trade-marks proper.

<sup>3</sup> Observe the broad term, which is limited to citizens of the United States.

belong to native citizens, or as are now granted, or may hereafter be granted, to the subjects or citizens of the most favored nation, in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective nations.

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*ADDITIONAL ARTICLE to the Treaty of Navigation and Commerce between the United States of America and the Emperor of Russia, of the 18th of December, 1832. Concluded and signed at Washington, January 27, 1868. Proclaimed October 15, 1868. (16 Statutes at Large, 725.)*

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other, must be lodged exclusively to wit: the marks of citizens of the United States in the Department of Manufactures and Inland Commerce at St. Petersburg; and the marks of Russian subjects at the Patent Office in Washington.

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*TREATY between the United States and Serbia, for facilitating and developing Commercial Relations, October 2 and 14, 1881. Proclaimed December, 1882. (22 Statutes at Large, 966.)*

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trade-mark affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured parties, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-mark in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other,

must be registered exclusively to wit: the marks of citizens of the United States in the Tribunal of Commerce at Belgrade, and the marks of Serbian subjects in the Patent Office at Washington, subject to the conditions and restrictions prescribed by the laws and regulations of the country in which the trade-marks are registered.

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CONVENTION *between the United States and Spain, June 19, 1882.*  
*Proclaimed April 19, 1883. (22 Statutes at Large, 979.)*

ARTICLE I.

The citizens and subjects of each of the contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as the natives of the country in everything relating to the ownership of trade-marks, industrial designs or models, or manufactures of any kind.

Persons desiring to secure the aforesaid protection shall be obliged to comply with the formalities required by the laws of the respective countries.

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TRADE-MARK LAWS OF VARIOUS COUNTRIES.

AUSTRIAN LAW OF DECEMBER 7, 1858.

I. *General Provisions.*

ART. 1. Under the name of "trade-marks" are understood, in the present law, the particular signs serving to distinguish in commerce the products and the merchandise of one manufacturer from the products and merchandise of another (emblems, ciphers, vignettes, &c., constituting such signs).

ART. 2. When a manufacturer desires to secure the exclusive use of a trade-mark, he must register it, conformably to the provisions of the following chapter.

ART. 3. A person cannot obtain an exclusive right to marks consisting of signs in general use in commerce for particular merchandise, or to marks which consist only of letters, words, or numerals, or of the arms of the State or of its provinces.

ART. 4. The exclusive right to a trade-mark only prohibits other manufacturers from the right to use the same mark on the

species of merchandise belonging to the production or objects of commerce and industry to which the protected mark has been appropriated.

ART. 5. The right to an exclusive mark is inherent in the industrial enterprise to which the mark is attached. This right is extinguished with the enterprise. A change of the enterprise changes also the proprietorship. In this case, however, the new proprietor is obliged to have, within three months, the mark transcribed in his name under penalty of forfeiture, except always in a case where the manufacture shall be continued by the widow or a minor heir of a manufacturer, or on account of an estate in succession or in bankruptcy.

ART. 6. No person shall arbitrarily take the name, the firm-title, nor the escutcheon or denomination of another manufacturer or native, to designate merchandise or products.

ART. 7. All that is stated in the present law in regard to trademarks shall apply equally to marks borne on packages, boxes, vases, envelopes, &c.

ART. 8. The present law does not change any of the provisions in regard to particular marks ordained for certain classes of merchandise, especially the provisions as to stamping.

## II. *Registration of Marks.*

ART. 9. The mark of which a manufacturer desires to secure the exclusive right (art. 2) must be deposited in duplicate at the Chamber of Commerce and Industry of the district in which his manufactory is situate and carried on. One of the copies shall remain on deposit at the Chamber of Commerce and Industry, and be attached to the register of inscription; the other is returned to the depositor furnished with the statements designated in the following article.

ART. 10. On each of the two copies the employee or functionary appointed for the purpose by the Chamber of Commerce and Industry shall write: *a*, the number of the order of registry; *b*, the day and hour of presentation; *c*, the name of him for whom the mark has been registered; *d*, the designation of the commercial enterprise to which the work is appropriated, — to which he shall affix his signature and seal of office.

ART. 11. The registration is subject to a tax of 10 florins, which shall be paid into the fund of the Chamber of Commerce and Industry.

ART. 12. From the day and the hour of the presentation of the mark at the Chamber of Commerce and Industry commences the right of the depositor to the exclusive use of the mark, and it is as

of this period that his right of priority shall be judged, in case the same mark shall be deposited by another person in the same Chamber or in other Chambers of Commerce and Industry.

ART. 13. To obtain the transcription of the right to a mark, in the sense of article 5, the applicant must present the proof of acquisition of title to the industrial enterprise in question. The transcript is subject to the same tax as the first requisition.

ART. 14. The Chamber of Commerce and Industry shall always keep the register of marks open to the inspection of the public.

ARTS. 15-22. (These give a right to suppress a spurious mark, and to destroy instruments and appliances for counterfeiting; and also give an action for damages.)

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#### BELGIAN TRADE-MARK LAW OF APRIL 1, 1879.

ART. 1. Every sign serving to distinguish the products of an industry, or the objects of a commerce, is considered as a mark of manufacture or of commerce. The name of a person, as well as that of a commercial or industrial house, may serve as a mark in the distinctive form given to it by the owner.

ART. 2. No one can claim the exclusive use of a mark if he has not deposited the fac-simile in triplicate, with the stereotype of his mark, at the office of the clerk of the Tribunal of Commerce in the place where his establishment is situated.

ART. 3. Whoever has first made use of a mark may alone make the deposit.

ART. 4. The instrument of deposit is inscribed on a special register and signed both by the depositor, or his attorney, and the clerk; the power of attorney remains annexed to the instrument. It states the day and hour of the deposit. It indicates the kind of industry or of commerce for which the depositor intends to employ the mark. A copy of the instrument of deposit is given to the depositor. Another copy is sent, within the week, with one of the deposited fac-similes and the stereotype of the mark, to the central office, by which the announcement of the deposit, the description, and the design of the mark shall be published in a special publication, six months at the farthest after the reception of the packet.

ART. 5. For each mark deposited a tax of ten francs is paid. The deposit is received only on the production of a receipt proving the payment of the tax.

ART. 6. Foreigners who conduct in Belgium industrial or commercial establishments enjoy, for the products of these establishments, the benefits of the present law on fulfilling the formalities

which it prescribes. The same applies to foreigners or Belgians who conduct their industry or commerce out of Belgium, if in the countries where their establishments are situated international conventions have stipulated reciprocity for Belgian marks. In the latter case the deposit of the marks takes place at the office of the clerk of the Tribunal of Commerce of Brussels.

ART. 7. A mark cannot be conveyed except with the establishment of which it serves to distinguish the objects of manufacture or of commerce. Every conveyance of a mark between the living shall be registered at the fixed charge of ten francs. The conveyance is of no effect as to third persons, until after a deposit of an extract of the conveyance in the forms prescribed for the deposit of the mark.

ART. 8. Are punished by an imprisonment of from eight days to six months, and a fine of twenty-six francs to two thousand francs, or of one of these penalties alone: —

(a.) Those who have counterfeited a mark, and those who have fraudulently made use of a mark.

(b.) Those who have fraudulently affixed, or made to appear by additions, retrenchment, or by alteration, on the products of their industry or the objects of their commerce, a mark belonging to another.

(c.) Those who have knowingly sold, or placed on sale or in circulation, products invested with a counterfeit mark, or mark fraudulently affixed.

ARTS. 9–15. (These provide penalties of fine and imprisonment for counterfeiting, or selling spuriously marked goods. The goods may be ordered to be destroyed.)

ART. 16. A fraudulent registration may be annulled.

ART. 17. All pre-existing laws on the subject are repealed.

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BRAZILIAN LAW OF TRADE-MARKS. (Imperial Decree No. 2682, of October 23, 1875.)

Article 1 defines a trade-mark as the name of a manufacturer or merchant or firm, in some distinctive form; or any other denotation, emblem, stamp, seal, signet-stamped mark, relief, or wrapping of any kind, which may distinguish manufactured goods or articles of trade. Registration is a condition precedent to protection.

Marks composed exclusively of numerals or of letters, or of representations of objects that may give rise to scandal, are prohibited from registration. The law is applicable to foreigners on terms of reciprocity.



## CANADA.

## CONDENSED EXTRACT OF THE TRADE-MARK LAW OF MAY 15, 1879.

1. A register of trade-marks shall be kept in the office of the Minister of Agriculture, in which any proprietor of a trade-mark may have the same registered by complying with the provisions of the Act.

2. The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make rules and adopt forms.

3. The Minister of Agriculture may cause a seal to be made, and therewith seal trade-marks, copies, &c.

4. No person shall be entitled to institute any proceeding to prevent infringement of a trade-mark unless the same be duly registered.

5. The Minister of Agriculture may object to register any trade-mark in the following cases: *First*. If the said trade-mark is identical with or resembles a trade-mark already registered. *Second*. If it appears that the said trade-mark is calculated to deceive or mislead the public. *Third*. If the said trade-mark contains any immorality or scandalous figure. *Fourth*. If the so-called trade-mark does not contain the essentials necessary to constitute a trade-mark properly speaking.

6, 7. (Mode of presenting the case, by forwarding to said Minister a drawing and description in duplicate, with a declaration of novelty, and the fee. On registration, one of the copies of drawing and description, signed by the Minister or his Deputy, duly sealed and certified, shall be returned to the applicant. The certificate is made *prima facie* evidence in all courts of law or of equity in Canada of the facts therein alleged.)

8. For the purposes of this Act are included all marks, names, brands, labels, packages, or other business devices, which may be adopted for use by any person in his trade, business, occupation, or calling, for the purpose of distinguishing any manufacture, product, or article by him manufactured, produced, compounded, packed, or offered for sale, no matter how affixed, whether to the article itself or to its case or other receptacle. Timber or lumber on which labor has been expended by any person in his trade, business, occupation, or calling shall be deemed a manufacture, product, or article.

9-11. A trade-mark may be general or specific, the latter being intended for merchandise of a particular description. A general mark shall endure without limitation. A specific mark endures

for twenty-five years, renewable for similar periods. The applicant for registration must state whether his mark is general or specific.

12. Fees, payable in advance: For general trade-mark, \$30.00. For specific trade-mark, \$25.00. Renewal of the latter, \$20 00. If the application be refused, the fee, less five dollars, will be returned.

13-19. (These provide for cancellation at the request of the owner, for assignment, and for hearing disputes as to title. Infringement is made a misdemeanor, punishable by fine, to be paid to the owner. A private suit may be maintained for damages. The public registry shall be open to inspection. The Minister may correct clerical errors of his office.)

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## DENMARK.

### LAW OF JULY 2, 1880, FOR THE PROTECTION OF MARKS OF TRADE AND COMMERCE.

#### I.

ART. 1. It is forbidden to all persons to affix to their merchandise intended to be put into general circulation, or on the packing thereof, the name of another person or firm, or the name of a place of manufacture of products of another person. It is equally forbidden to affix on such merchandise, or on its packing, a trade-mark to which another person has the exclusive right, in the terms of the following provisions.

#### II.

ART. 2. Whoever engages in Denmark in the manufacture or sale of merchandise intended in a general manner to be put into circulation, may acquire in Denmark the exclusive right to the mark or marks of fabric which he affixes to his merchandise, or packing thereof, to distinguish the same from merchandise made or sold by others, on the condition of declaring his mark, by insertion in the register for that purpose, conformably to the rules of the present law.

ART. 3. The register of trade-marks is held for all the kingdom at Copenhagen, by a conservator named by the Minister of the Interior, and after the rules of disposition, of form, and of conduct, determined by the said minister.

**ART. 4.** The declaration called for in article 2 should be made in writing and presented or sent without expense to the conservator. It should contain : —

1. The full name of the declarant, his domicile, or the name of the firm and place of business.

2. A clear description of such mark, indicating at the same time, if need be, the mode of employing said mark (for example, if it should be affixed to the merchandise itself or on its packing, pasted, branded, or stamped, &c.). This description should be accompanied by a fac-simile of the mark, of four inches in height by six inches in length or more, on strong paper. The deposit of this fac-simile should be in three copies. It should be followed by the deposit of a duplicate of the stereotype, which will not be returned.

The declaration should be signed by the declarant and accompanied with fees to the amount prescribed for declarations and publications.

**ART. 5.** So soon as possible after the reception of the declaration and the payment of the duties, the conservator shall receipt therefor in writing, with a statement of the day of reception. From the time of the declaration, it being seen that all the provisions above prescribed have been observed, if otherwise no obstacle to registration exists (Art. 6), it shall be proceeded with, and publication thereof shall be made (Art. 8).

**ART. 6.** Registration of the declaration shall be refused : —

1. If the mark consists only of numerals, or words, or letters.

2. If it contains names of a person or a firm different from the proper name or firm-style of declarant, or the name of a place which shall not be the seat of production of the merchandise manufactured by the declarant, unless the declarant establishes before the conservator that he has acquired the right of user, as a trade-mark, of the name or firm-style in question.

3. If the mark declared on contains public arms or public marks.

4. If it contains objects calculated to provoke public scandal.

5. If the same mark has previously been regularly declared on by another person.

In case of refusal of registration, the conservator shall give notice thereof to the declarant, with a statement of reasons for refusal. The declarant can, if he believe his rights to be damaged by such decision, refer the matter to the Minister of the Interior, who will decide.

**ART. 7.** (This relates to entering in register, &c., or refusal for valid reasons to enter on record.)

**ART. 8.** (As to publication of register.)

ART. 9. (The registration of a mark is subject to a duty of thirty kroner.)

ART. 10. (Giving any person the right to examine register, personally, or by obtaining extracts therefrom.)

ART. 11. (Accounts of the conservator.)

### III.

ART. 12. Whoever shall have made the declaration prescribed by articles 2 and 4, and obtained registration, thereby acquires an exclusive right to invest his merchandise, or his packings, with the declared mark, and to place in commerce the merchandise thus marked. When several persons declare the same mark, the exclusive right belongs to the first in date. The right acquired in the user of a mark passes after the death of the grantee to his successor or to his heirs without a new declaration, but only for the term of one year from his decease.

ART. 13. (Obsolete by limitation.)

ART. 14. The declaration for a mark containing letters or words shall not prevent other persons from the use of the name or firm-style to designate that merchandise.

No one can acquire by declaration the right to marks which shall to that time have been in general use by all trades, or by certain classes of traders.

ART. 15. The measure of protection ordained by the present law against the unlawful use of a mark, of a name, or firm-style, shall extend also to the case where said mark, name, or style shall be represented with differences likely to escape the attention of the ordinary mind.

(ARTS. 16, 17, and 18 relate to remedies for infringements.)

### IV.

ART. 19. The benefit of the present law may be extended by royal ordinances to traders who have their places of business in foreign nations, on condition of reciprocity, on the following terms :

1. The declarant shall indicate some attorney domiciled in Denmark to act for him.

2. He shall establish the fact of having complied with the conditions prescribed in the country of his residence for the protection of trade-marks.

3. He shall enjoy the right accorded by the present law only for the period of protection in his own country.

## FRENCH LAW OF JUNE 23, 1857.

TITLE I. — *Of the Right of Property in Marks.*

ART. 1. The mark of manufacture and commerce is optional. Decrees rendered in the form of regulations of public administration can always, except in certain cases, declare marks to be obligatory for the products that they specify. As marks of manufacture and of commerce shall be considered names under a distinctive form, denominations, emblems, imprints, stamps, stamped tickets, vignettes, reliefs, letters, ciphers, envelopes, and all other signs serving to distinguish the products of a manufacturer and the objects of a commerce.

ART. 2. No one can claim the exclusive property of a mark, unless he shall have deposited two fac-similes thereof with the clerk of the Tribunal of Commerce of his domicile.

ART. 3. The deposit has effect but for fifteen years. The property in a mark may always be protected for a new term of fifteen years by means of a new deposit.

ART. 4. Besides the charge for stamp and of registration, there is a legal charge fixed at one franc for the drawing-up of the entry of each mark and for the cost of proceeding.

TITLE II. — *Dispositions Relative to Foreigners.*

ART. 5. Foreigners who possess in France establishments of manufacture and commerce enjoy for the products of their establishments the benefit of the present law upon fulfilling the formalities that it prescribes.

ART. 6. Foreigners and the French whose establishments are situated outside of France shall equally enjoy the benefit of the present law for the products of their establishments, if in the countries where they are situated diplomatic conventions have established reciprocity for French marks. In this case the deposit of foreign marks shall take place with the clerk of the Tribunal of Commerce of the Department of the Seine.

TITLE III. — *Penalties.*

ART. 7. The punishment shall be a fine of from 50 to 3,000 francs, and with imprisonment of from three months to three years, or of one of these penalties only:—

1st. For such as shall have counterfeited a mark or made use of a counterfeit mark.

2d. For such as shall fraudulently affix to their products or the objects of their commerce a mark belonging to another.

3d. For such as shall have knowingly sold or exposed for sale one product or more than one product invested with a false mark fraudulently imitative, or bearing indications tending to deceive the purchaser as to the nature of the product.

ART. 9. They shall be punished with a fine of from 50 to 1,000 francs, and with imprisonment of from fifteen days to six months, or with one or the other of such penalties: —

1st. Who shall not have affixed to their products a mark declared to be obligatory.

2d. Who shall have sold or exposed for sale one product or more than one product not bearing the obligatory mark for that species of product.

3d. Who shall have contravened the provisions rendered in execution of article 1 of the present law.

ART. 10. The penalties established by the present law are not cumulative.

The heavier penalties are only to be pronounced for acts done anterior to the first act of pursuit.

ART. 11. The penalties prescribed by articles 7, 8, and 9 may be increased to double in case of repetition of the offence. It is such repetition when within the five years anterior a condemnation shall have been pronounced against the prisoner for one of the misdemeanors provided for in the present law.

ART. 12. Article 453 of the Penal Code shall apply to the misdemeanors under the present law.

ART. 13. Besides, offenders may be deprived of the right of participating in election of tribunals and of chambers of commerce, of consulting chambers of arts and manufactures, and of councils of selectmen, for a term not exceeding ten years.

The Tribunal may order the posting-up of the judgment in places to be determined, and its insertion in full in newspapers to be designated by it; the whole at the cost of the condemned.

ART. 14. The confiscation of products recognized as contrary to the provisions of articles 7 and 8, even in cases of acquittal, may be pronounced by the Tribunal, besides the apparatus which especially served for the commission of the wrong.

The Tribunal may order that confiscated products shall be delivered to the owner of the mark counterfeited, or fraudulently affixed, or imitated, independent of and in addition to ample damages that may have been given.

It shall prescribe, in all cases, the marks adjudged to be counterfeited contrary to the provision of articles 7 and 8.

ART. 15. In the cases premised in the first two paragraphs of article 9 the Tribunal shall prescribe always that the marks de-

clared to be obligatory shall be affixed to the products subject thereto.

The Tribunal may pronounce the confiscation of products, if the prisoner shall have undergone during the last five preceding years a condemnation for one of the misdemeanors provided in the first two paragraphs of article 9.

#### TITLE IV.

ART. 16. Civil actions relative to marks are brought before the civil tribunals and judged as summary matters. (The remainder of this title relates to the mode of procedure. Title V., which contains the remaining part of the Act, relates to general and transitory matters, as, for example, the seizure and condemnation of foreign merchandise falsely bearing either the mark or the name of a resident of France; and other subjects of but local interest.)

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### LAW OF THE GERMAN EMPIRE RESPECTING TRADE-MARKS, IN FORCE EVER SINCE MAY 1, 1875.

§ 1. Traders whose firm is entered in the commercial register can apply to the proper court for the entry, in the commercial register of the district in which the principal firm has its domicile, of marks which are to be used on the goods themselves, or on the packing, to distinguish their goods from those of other traders.

§ 2. The application must contain a clear drawing of the trade-mark, together with a description of the class of goods for which the mark is destined.

§ 3. The registration of trade-marks, the use of which by the applicant is protected by the law of the State, and also of such marks which, up to the beginning of the year 1875, have been universally received in commerce as the recognized marks of a certain trading firm, may not be refused.

For the rest, the registration is forbidden if the mark consists exclusively of numerals, letters, public words, armorial bearings, or scandalous designs.

§ 4. The registration is made in the name of the firm of the applicant. The time of the application is then to be noted. If a trade-mark already registered has to be registered again, owing to the transfer of the head domicile, the time of the first application is then to be noted.

§ 5. On the petition of the partners of the firm the registered trade-mark will be cancelled.

It is cancelled officially, —

1. If the firm is removed from the commercial register.
2. If an alteration in the firm is applied for without a simultaneous application for the maintenance of the mark.
3. If ten years have elapsed since the register of the mark without an application for its further maintenance, or since such application without its having been renewed.
4. If the mark, according to § 3, ought not to have been registered.

§ 6. The first registration and the cancelling of a mark shall be notified in the “*Deutscher Reichs-Anzeiger*.”

The costs of the notification of the registration are to be borne by the proprietor of the firm.

§ 7. For the first registration of a mark, which is not protected by the law of the land, a fee of fifty marks is to be paid.

The State's government can excuse the payment of a fee for the registration of such marks as, up to the commencement of 1875, have been accepted generally in trade as the known marks of certain tradesmen.

Other registrations and cancellings are gratis.

§ 8. The right to affix on goods or their packing a mark applied for in respect of such goods, at the commercial register, or to traffic in such goods, belongs exclusively to the proprietor of that firm to which the application was first granted.

§ 9. With respect to trade-marks, which are protected by the law of the State, likewise with respect to such marks as up to the commencement of the year 1875 have been accepted generally in trade as the known marks of a certain trader, no one except the proprietors protected by law, or universally acknowledged in trade, can acquire a right to such by an application for registration, provided that the proprietors shall have made the application before October 1, 1875.

§ 10. By the application for a trade-mark, which contains letters or words, no one will be prevented from using his name or his firm, even in making use of abbreviations for the verification of his goods.

No one can acquire a right by application to trade-marks which have hitherto been freely used by all, or by certain classes of traders, or the registration of which is not permissible.

§ 11. The proprietor of a firm for which a trade-mark is registered must have it cancelled on the demand of the party who has a right to exclude him from the use of the mark, or, as far as the trade-mark belongs to those mentioned in the second paragraph of § 10, on the demand of a participator.



§ 12. The right obtained through application for a trade-mark is cancelled, —

1. By the withdrawal of the application, or by a request to cancel it on the part of the proprietor of the firm to which it belongs.

2. When one of the cases in §§ 1–3 occurs.

§ 13. Every home manufacturer or trader can bring a civil action against any one who unlawfully marks goods with the name or the firm of the former, or who marks them with a trade-mark to the use of which the former is exclusively entitled, praying that the latter may be precluded from the right to use such mark, and be forbidden to use it any longer.

Similarly, the injured manufacturer or trader can bring a civil action against any one who unlawfully traffics in, or exposes for sale, marked goods, praying that the latter may be forbidden to deal in such goods.

§ 14. Whoever unlawfully marks goods or the packing thereof with a trade-mark, intended to be protected by the present law, or with the name or the firm of a home manufacturer or trader, doing so knowingly, or who knowingly traffics in such unlawfully marked goods, or exposes them for sale, shall be punished by a fine of from 150 to 3,000 marks, or by imprisonment not exceeding six months, and must give compensation to the injured party.

The prosecution only takes place on petition of the injured party.

§ 15. Instead of the fine provided for by this law, compensation to the amount of 5,000 marks can, on the demand of the injured party, be awarded to him.

For this compensation the condemned parties are liable as joint debtors.

When a fine is imposed, it excludes any further money compensation.

§ 16. The court will determine, if any, and what, damages are to be assessed, and it does this according to the evidence, fixing the amount it thinks proper.

§ 17. If the accused is found guilty, then, with respect to the goods found in his possession, the marks on the packing or the goods are to be destroyed, or if the removal of the goods is not possible, the packing or the goods themselves are to be destroyed, on the petition of the injured party.

If the accused is condemned, the injured party shall be authorized to publish the sentence at the cost of the condemned party. The manner of publication, as well as the period thereof, is to be declared in the sentence.

§ 18. The protection afforded by the provision of the present law to the proprietor of a trade-mark, a name, or a firm, will not be lost when the trade-mark, name, or firm is reproduced with changes, which can only be recognized after being the object of particular scrutiny.

§ 19. Civil suits brought by virtue of this law are taken as commercial suits, according to the spirit of the Imperial and States' laws.

§ 20. The provisions of the present law apply to the trade-marks of tradesmen who have no registered firm in the Empire, as well as to the names or firms of foreign manufacturers or tradespeople, if, in the State where the latter have their domicile, German trade-marks, names, and firms enjoy protection through a notification in the "Reichs Gesetzblatt"; the following special rules will, however, be enforced as regards the trade-marks (§ 1):—

1. An application to register a trade-mark must be made to the Commercial Court, at Leipsic, with a declaration that the applicant submits to the jurisdiction of the said court in all complaints brought by virtue of this law.

2. With such application, proof must be given that in the foreign country all requirements have been fulfilled to afford the applicant protection to trade-marks there.

3. The application entitles to a right to such trade-marks only so far and so long as the applicant is protected in its use in the foreign country.

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#### ACT OF GREAT BRITAIN FOR THE REGISTRATION OF TRADE-MARKS, 1883.

62. (1.) The comptroller may, on application by, or on behalf of, any person claiming to be the proprietor of a trade-mark, register the trade-mark.

(2.) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office, in the prescribed manner.

(3.) The application must be accompanied by the prescribed number of representations of the trade-mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade-mark to be registered.

(4.) The comptroller may, if he thinks fit, refuse to register a trade-mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the

comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the court; and in that event the court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

63. Where registration of a trade-mark has not been, or shall not be, completed within twelve months from the date of the application, by reason of default on the part of the applicant, the application shall be deemed to be abandoned.

64. (1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:

(a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(b.) A written signature, or copy of a written signature, of the individual or firm applying for registration thereof as a trade-mark; or

(c.) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

(2.) There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act.

65. A trade-mark must be registered for particular goods or classes of goods.

66. Where a person claiming to be the proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of the statement of the goods for which they are respectively used or proposed to be used, or statements of numbers, or statements of price, or statements of quality, or statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately.

67. A trade-mark may be registered in any color, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other color.

68. Every application for registration of a trade-mark under this part of this Act shall, as soon as may be after its receipt, be advertised by the comptroller.

69. (1.) Any person may, within two months of the first advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade-mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within two months after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) If the applicant sends such counter-statement, the comptroller shall furnish a copy to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the court.

70. A trade-mark, when registered, shall be assigned and transmitted only in connection with the good-will of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that good-will.

71. Where each of several persons claims to be registered as proprietor of the same trade-mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the court.

72. (1.) Except where the court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the comptroller shall not register in respect of the same goods or description of goods a trade-mark identical with one already on the register with respect to such goods or description of goods.

(2.) The comptroller shall not register with respect to the same goods or description of goods a trade-mark so nearly resembling a trade-mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

73. It shall not be lawful to register as part of or in combination with a trade-mark, any words, the exclusive use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark, —

(a.) In the case of an application for registration of a trade-mark used before the thirteenth day of August, one thousand eight hundred and seventy-five, —

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, figures, though the same is common to the trade in the goods with respect to which the application is made.

(b.) In the case of an application for registration of a trade-mark not used before the thirteenth day of August, one thousand eight hundred and seventy-five, —

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made.

(2.) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August, one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or similar description of goods, shall, for the purpose of this section, be deemed common to the trade in such goods.

75. Registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark.

76. The registration of a person as proprietor of a trade-mark shall be *prima facie* evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade-mark unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act, or

of an enactment repealed by this Act, or, in the case of any other trade-mark in use before the thirteenth of August, one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

78. There shall be kept at the Patent Office a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

79. (1.) At a time not being less than two months, nor more than three months, before the expiration of fourteen years from the date of the registration of a trade-mark, the comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years, the comptroller may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If, before the expiration of the said three months, the registered proprietor pays the said fee, together with the additional prescribed fee, the comptroller may, without removing such trade-mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where, after the said three months, a trade-mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade-mark to the register on payment of the prescribed additional fee.

(5.) Where a trade-mark has been removed from the register for the non-payment of the fee or otherwise, such trade-mark shall, nevertheless, for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade-mark which is already registered.

80. There shall be paid, in respect of applications and registration, and other matters under this part of this Act, such fees as

may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

The Act contains general provisions, a few of which may be briefly noted as follows: —

The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade-marks, who shall act under the superintendence and direction of the Board of Trade.

The comptroller may refuse to register a trade-mark of which the use would, in his opinion, be contrary to law and morality.

The name of an assignee, &c., of a trade-mark may, on proof of title, be entered on the register; and any person appearing in the register as proprietor may absolutely assign, or otherwise deal with the trade-mark.

Every register shall be open to the public, and certified copies thereof be given, on payment of the prescribed fee. Copies, or extracts from the register, certified by the comptroller, and sealed with the seal of the Patent Office, shall be evidence in all courts, and in all proceedings. The court may, on the application of any person aggrieved by an omission, without sufficient cause, from any register, or by an entry, without sufficient cause, in any register, order the varying or expunging of the entry.

The court may decide any question as to the rectification of a register, and may direct an issue of fact to be tried, and award damages.

The comptroller has power, on request, to correct any clerical error, or cancel an entry.

The registered proprietor of any registered trade-mark may apply to the court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the court may refuse or grant leave on such terms as it may think fit.

If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Where discretionary power is given to the comptroller, he shall not exercise that power adversely to the applicant for registration of a trade-mark, without (if so required within the prescribed time

by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

It is a misdemeanor to falsely represent a trade-mark to have been registered, with a fine not exceeding five pounds.

“Person” includes a body corporate. “The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) the High Court of Justice in England. “Comptroller” means the Comptroller General of Patents, Designs, and Trade-Marks.

The Trade-Mark Registration Act of 1875, as amended in 1876, 1877, is repealed.

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## ITALY.

### LAW OF AUGUST 30, 1868.

This is very much like that of France, of June 23, 1857, which see.

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## TRADE-MARK LAW OF JAPAN OF JUNE 7, 1884.

ART. 1. When trade-marks are registered at the agricultural and commercial departments in a book specially provided for the purpose, the owners of such marks may enjoy the exclusive privilege of employing them for a term of fifteen years from the date of registration.

ART. 2. Persons who are desirous of obtaining a right to the exclusive use of trade-marks must apply for registration by forwarding specimens and a detailed account of the marks. This account will explain the nature of the marks and the manner of using them, and will give the name and classification of the articles to which they are to be attached. When registration is permitted a certificate will be granted.

ART. 3. Applications for the registration of trade-marks will be retained by the authorities for two months from the date of their receipt, after which time they will receive sanction, should no conflicting applications have been received in the interim. When two or more persons happen to apply for registration of the same marks, or of marks which closely resemble each other, with the intention of affixing them to articles of the same classification, the application or applications of later date will be rejected; and when they are under the same date all will be rejected.



**ART. 4.** Suitable measures will be taken by the Minister of Agriculture and Commerce to exhibit the registered trade-marks to the public.

**ART. 5.** Registration of the following marks must not be applied for: 1. Marks which are exactly the same as, or are likely to be mistaken for, marks already registered, and which are designed to be affixed to articles of the same classification. 2. Marks which represent the name of a place, a person, a shop, or a company, and those representing the general name of articles, or national arms, either foreign or domestic. 3. Marks which are universally employed by a particular class of merchants, or which are used in accordance with the common customs of the commercial community. 4. New marks which are exactly the same as, or likely to be mistaken for, marks adopted prior to the promulgation of the present regulations, and actually used up to the present time, and all marks of a similar character intended to be attached to articles of the same class or description.

**ART. 6.** When persons who have registered their marks change their residences, the local jurisdiction, or their personal names, or abandon their trade, or suspend it for a year or upwards during the term for which the marks are registered, they must give notice of the said change, abandonment, or suspension to the authorities within three months.

**ART. 7.** When heirs succeed to the business of their predecessors during the term of the exclusive use of the latter's trade-marks, they must report the fact to the authorities within three months after their succession.

**ART. 8.** When persons who have obtained registration of marks desire to assign, wholly or in part, the right of using such marks to other persons, they must apply for fresh registration. In such cases the period of the exclusive use of the marks will be reckoned from the date of original registration.

**ART. 9.** When it is desired to apply or transfer the same marks to articles of other classifications, or to introduce some alterations into them, application must be made for fresh registration. In such cases applications will be dealt with in accordance with article 3 of these regulations.

**ART. 10.** When persons who have obtained registration desire to continue the exclusive use of trade-marks after the expiration of the registered term, they must apply for fresh registration within three months before the expiration of such term.

**ART. 11.** In the event of certificates of registration being lost or damaged, application must be made for fresh certificates.

**ART. 12.** When, after the registration of trade-marks, frauds are

detected in the original application for their registration, or in the specimens or detailed accounts furnished in accordance with these regulations, or when it is found that the original applications were carried out in violation of article 5, the registration will lose its validity, and the certificates will be cancelled by the authorities.

ART. 13. When the owners of registered trade-marks relinquish their business entirely, they will lose their right to the exclusive use of the marks from the date of such relinquishment. This provision also holds good in the case of the suspension of a trade for three years.

ART. 14. Applicants for registration of trade-marks must pay the following fees, provided that, in case their applications are rejected, the money will be refunded: 1. The sum of ten yen<sup>1</sup> must be paid for the registration of one trade-mark, and if the same mark is to be applied or transferred to articles of different classes, five yen must be added for each class. 2. Applications for transfer wholly or in part, or for alteration of trade-marks, or for the continuation of their use after the expiration of the registered term, will involve the payment of five yen for every mark. 3. One yen must be paid for obtaining a fresh certificate of registration.

ART. 15. The owners of registered trade-marks may claim damages from, or lay information against, any person who encroaches upon their privileges.

ART. 16. Persons who counterfeit registered trade-marks and employ them will be punished by imprisonment with hard labor, for a term not less than one month and not more than one year, in addition to a fine of from four to forty yen. Persons who use trade-marks clandestinely will be liable to a punishment mitigated by one degree from the above.

ART. 17. Those who make and use marks which are likely to be mistaken for registered marks will be liable to imprisonment with hard labor for a period of not less than fifteen days and not more than six months, and to a fine of from two to twenty yen.

ART. 18. Persons who, with full knowledge of the fact, undertake the sale of commodities bearing trade-marks of the nature interdicted by articles 16 and 17, will be liable to a fine of from four to forty yen.

ART. 19. In the cases set forth in the three preceding articles, 16, 17, and 18, the trade-marks will be confiscated, and when the marks are inseparable from the commodities, the commodities themselves will be destroyed.

ART. 20. Those who fraudulently effect the registration of trade-marks, or falsely assert that they have obtained registration, will

<sup>1</sup> A yen is equal to our dollar.

be punished by imprisonment with hard labor for a term of from fifteen days to six months, together with a fine of from two to twenty yen.

ART. 21. Persons who neglect to make a due report within a prescribed period, in accordance with articles 6 and 7, will be liable to a fine of from one yen to 1.95 yen.

ART. 22. Persons infringing these regulations will not be dealt with in accordance with those provisions of the penal code which refer to the occurrence of several offences.

ART. 23. Offences enumerated in articles 16 to 18, inclusive, will be taken cognizance of only after information is laid by the owners of the registered trade-marks.

ART. 24. When such information is laid against offenders by the owners of marks, the judges may suspend the sale of all commodities bearing the marks in question, pending investigation.

There are also By-Laws and Classification of Articles, which may be found in full in No. 44 of the United States Consular Reports. August, 1884.

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CONDENSED EXTRACTS FROM THE NETHERLANDS  
TRADE-MARK LAW OF MAY 25, 1880. (23 Off. Gaz. 1334,  
in full.)

ART. 1. Any person desiring to secure the right to the exclusive use of a mark to be placed upon his goods, or upon the wrappers thereof, for the purpose of distinguishing such goods from those of others, shall send two copies, bearing his signature, of a distinct representation or drawing of such mark, and a minute description thereof (stating in said description the kind of goods for which the mark is to be used), to the clerk of the District Court of his place of residence.

If he have no place of residence within the kingdom in Europe, the transmission shall be made to the clerk of the District Court of Amsterdam, and he shall select a place of residence within the kingdom in Europe. The transmission may also be made by a person authorized for this purpose, in writing.

The mark shall contain no words or designs offensive to public order or good morals. It shall not consist exclusively of ordinary letters, figures, or words. Nor shall it consist (even though a slight alteration be made) of the arms of the kingdom, or of those of a province, commune, or other legally constituted public corporation.

The fee for registration and publication is ten florins.

ART. 2. The clerk shall enter the application in the public register, and give the depositor a certificate, and within three days report the case to the Department of Justice, which shall cause it to be published in the official paper.

ART. 3. If the mark offered for registration is identified with, or does not differ sufficiently from, a mark for the same kind of goods which is owned by another person, or for the ownership of which another person has made application, such person may, within six months after the publication, apply to the court, to the end that the registration be forbidden. After a notice of fourteen days, a hearing is had. From the decision of the judge there is no appeal; but within a month application may be made to have the decision set aside.

ART. 4. If the court forbid that a mark be registered, the Department of Justice shall be duly notified thereof, and a note of the fact shall be made in the register.

ART. 5. If within six months from the date of the announcement of the application for registration no application be made, the registration shall be made. The fact shall be announced in the "Nederlansche Staatscourant" on the 15th of the month.

The same law provides that the registration may be renewed in fifteen years; and punishes the counterfeiting of a trade-mark by fine and imprisonment.

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LAW OF NORWAY OF MAY 26, 1884, THAT WENT INTO  
OPERATION JANUARY 1, 1885. (30 Annales, 169.)

The provisions of this law are very similar to those of Sweden, which see. The registration bureau is established at Christiania.

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ROUMANIA.

The law for the protection of trade-marks went into operation June 27, 1879. Its provisions are much like those of the French law of June 23, 1857.

*(Translation from the Russian.)*

**EXTRACT FROM THE STATUTE OF LAWS RELATING TO  
MANUFACTURING INDUSTRY. (Code of Civil Laws, Vol. XI.,  
Part 2, Edition of 1857.<sup>1</sup>)**

**RELATIVE TO THE IMPOSITION OF MARKS ON PRODUCTS OF RUSSIAN  
MILLS AND MANUFACTORIES.**

§ 74. The right of stamping or marking Russian manufactured produce of various descriptions shall be enjoyed by every manufacturer. No official investigations shall be made at works or factories as to whether the products of the same are marked or not.

§ 75. Free exportation out of the Empire shall be allowed of both marked and unmarked Russian manufactured goods, subject, however, to the proviso that this permission shall apply only to such goods as are allowed to be exported under the existing tariffs.

§ 76. Goods of Russian origin bearing trade-marks shall enjoy the following privileges: —

(a.) When foreign goods not bearing the stamp of the custom-house shall be discovered, together with Russian merchandise bearing genuine Russian trade-marks, the latter goods shall be recognized as of Russian origin, and shall not be liable to confiscation; they may only in such cases serve as security for penalties, as any other goods, according to the customs regulations. If, however, there shall be found among the smuggled goods merchandise alleged to be Russian, but which shall bear no trade-mark proving their origin, they shall in such cases be confiscated without any investigation as to their origin.

(b.) Russian goods bearing trade-marks, when reimported from abroad, shall be allowed to re-enter the country free of duty. Such goods, however, as shall bear no trade-marks shall be treated as foreign, in accordance with the customs regulations.

§ 77. In order to introduce a uniform system of trade-marks, the following rules are established: —

(a.) The mark shall bear on it the Christian name and surname of the manufacturer, or these may be indicated by initials; the seat of the manufactory must also be shown.

The mark must be solidly and legibly imposed, and the letters must be in the Russian character; other letters may also be

<sup>1</sup> Reports relative to Legislation in Foreign Countries on the subject of Trade-Marks (British Parliament, 1879), p. 98.

used, on condition that a Russian mark shall, in addition, be employed.

(*b.*) On the establishment of a new manufactory, the owner, who may be desirous of using a trade-mark, shall inform the department of Commerce and Industry of such wish, and also state where the manufactory is situated, and the nature of the industry which will be pursued in it; a specimen and written description of the trade-mark which it is contemplated to use must be forwarded at the same time.

(*c.*) Whenever a manufactory shall be sold or closed, the manufacturer shall inform the Department of Commerce and Industry of the same.

(*d.*) Should a manufacturer deem it necessary to make some alterations in his trade-marks, he shall signify such intention to the Department of Trade and Manufactures, stating from what period the new trade-marks will be imposed on the goods.

(*e.*) Should the Department of Commerce and Industry disapprove of the proposed trade-mark on the ground of its being either contrary to regulations, or that a similar mark has already been registered, from which the proposed mark does not differ sufficiently, an alteration in the submitted mark shall be demanded by the Department.

(This law also punishes counterfeiting, and gives a right to damages. Goods of Russian origin are protected, though not bearing trade-marks.)

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CONDENSED EXTRACTS FROM THE SWEDISH TRADE-MARK LAW OF JULY 5, 1884, THAT WENT INTO OPERATION JANUARY 1, 1885. (30 Annales, 161.)

1. Every person having the right to the use of a trade-mark, whether personal or attached to his place of business, whether he be manufacturer, agriculturist, miner, merchant, or other trader, may by registration secure the exclusive privilege of using his special trade-mark to distinguish in commerce his products from all others; whether said mark be affixed directly to his merchandise, or applied to the envelope or wrapper.

2. The trade-mark bureau for the whole country is established at Stockholm.

3. An application must be post-paid. It must contain a complete description of the mark, state the name of the owner, his business location, and the class of goods to which the mark is

attached. With it must be three copies of the mark on strong paper not more than ten centimetres high by fifteen wide; and the fee of forty crowns.

4. Registration is prohibited to so-called marks consisting: 1, only of numerals, letters, or words not in peculiar form; 2, of a concealment of the true name of the applicant; 3, public arms or seals; 4, objects of an offensive nature; 5, of an exact resemblance to another registered or announced mark, or such a near resemblance as to be calculated to deceive or mislead.

(Registration lasts ten years, and may be renewed. It is provided that a foreigner may register, provided his country affords similar privileges to Swedes. Registration expires with registration in the foreign country. A foreign applicant must show that he has complied with the formalities required by the registration law of his own country.)

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CONDENSED EXTRACTS FROM THE SWISS TRADE-MARK  
LAW OF DECEMBER 19, 1879. (23 Off. Gaz. 2237, in full.)

ART. 1. The Swiss Confederation recognizes and protects marks of manufacture and trade in conformity with the provisions of the present law.

ART. 2. The following are considered as marks of manufacture or trade: Firm-names, as well as symbols placed adjacent to, or in lieu of them, that appear upon manufactured articles or merchandise, industrial or agricultural, or upon their coverings or envelopes, in order to distinguish them and establish their origin.

ART. 4. The initials of a firm are not sufficient to constitute a mark. Similarly, symbols placed adjacent to or in place of names of firms cannot be protected if they consist exclusively of ciphers, letters, or words, or are contrary to good morals. Public heraldic devices appearing upon the marks of individuals are not placed under the protection of the law.

ART. 5. The use of a mark in so far as concerns firms cannot be claimed in court unless the mark has been regularly deposited, and the registry published in the official trade bulletin or some other official federal bulletin designated for that purpose. In absence of proof to the contrary the presumption will be that the first depositor of a mark is also the equitable possessor.

ART. 6. The mark must be distinguished by essential characteristics from those already registered, unless it is applied to a different class of products or merchandise.

ART. 7. The following are authorized to register marks:—  
 1. Manufacturers having the seat of their manufacture or production in Switzerland, and merchants having a commercial house regularly established within the same. 2. Manufacturers or merchants established in States that allow citizens of Switzerland reciprocity of treatment, provided these manufacturers or merchants furnish proof in addition, that their marks or firm-names are sufficiently protected in the place of their establishment.

ART. 8. The duration of rights established by registering a mark is fixed at fifteen years, renewable indefinitely for the same period. Fee for each registry or renewal twenty francs.

ART. 9. The mark can only be transferred with the enterprise, the product, or merchandise of which it serves to distinguish. The transfer is of no effect in regard to third parties till after the registration and publication of the act confirming the same. (The fee for a transfer is fixed by article 16 at twenty francs.)

The same law prescribes the mode of making deposit for registry. To the application duplicate copies of the mark and a stereotype plate are appended, and other formalities are set forth. It also contains provisions for damages for counterfeiting or usurping marks, besides penalties of fine and imprisonment.

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## TURKEY.

A special regulation as to trade-marks, first promulgated in 1870, seems to be still in force. Registration is a condition precedent to suit for infringement.

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## LAWS OF THE UNITED STATES RELATING TO THE PROTECTION OF TRADE-MARKS.

*AN ACT to punish the counterfeiting of Trade-Mark Goods and the sale or dealing in of counterfeit Trade-Mark Goods. Approved August 14, 1876. (1 Supp. to Rev. Stats. 241.)*

This may be found in condensed form, *ante*, § 371. It is published in full in the edition of April, 1885, of the official publication of "Patent Laws and Laws relating to the Registration of Trade-Marks and Labels," p. 27.



**AN ACT** *to authorize the Registration of Trade-Marks and protect the same. Approved March 3, 1881. (21 Stat. 502; edition of April, 1885, of the official publication above mentioned, p. 29.)*

See also *ante*, §§ 283, 309, 325, 330, 333, 334, 337, 348, 355, 357, 358, 361, and 365, with a commentary thereon.

For **AN AMENDMENT** to said Act, approved August 5, 1882, see said official publication, p. 32.

**PROHIBITION** *upon the Importation of Simulated Watches, &c., sec. 2496, Rev. Stats., as amended by Act approved March 3, 1883. (22 Stat. 490; and ante, § 368.)*

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