

mon-law right, and could have sued in our courts as an alien friend, without the slightest regard to the matter of treaty or convention.¹ B. having established his claim, the next step is to issue to him a letter of registry. That will be to have two outstanding titles to the same property at once. Yes, until a court shall have enjoined one from the use of the symbol, or the wrong-doer shall have voluntarily relinquished all claim to it. The Commissioner has no power to cancel a certificate of registration already issued; for that is a matter for judicial cognizance upon a suit to be brought by the government, either in its own name or the name of the Attorney-General; or by some form of proceeding which can give official assurance of the sanction of the proper authority.² But the Commissioner may, in an interference issue, if he find that another was the prior adopter, give him also a certificate of registry; and thus place both parties on the same footing before the courts and the public. His authority for so doing is found in the proviso to the third section of the trade-mark law of March 3, 1881.³

§ 625. *Preliminary Interference.* -- Before the declaration of an interference proper, a preliminary interference will be declared. In that, each party will be required to file a statement under oath, giving a detailed history of the circumstances of his adoption of the mark; the extent and manner of application to merchandise; and the particular description of goods to which it was by him affixed; and giving, so far as

¹ An alien suing for violation of his trade-mark need not even allege the existence of a treaty. *Fils v. Sarrazin*, 15 Fed. R. 489.

² *Mowry v. Whitney*, 14 Wall. 620; 5 Fish. 513; 1 Off. Gaz. 499.

³ In the United States, the first adopter, or one deducing title from him, is alone entitled to registry. (Act of 1881, sect. 3.) In England, it was held that, inasmuch as each of the parties had used a certain mark independently and *bona fide* for several years, the mark should be registered in both names. (Re Powell, Re Pratt, 1 Trade Marks, 237; Sebastian's Dig., No. 357; Cox's Man., case 589.) With respect to those technically termed "old marks," the court permitted identical marks to be registered to three different parties at the same time (Re Jolley, Son, & Jones, 1 Trade Marks, 346); but if the mark be used by more than three parties, it cannot be registered at all, as, by being used by more than three, it lacks the element of distinctiveness. Re The Walkden Aerated Waters Co., 1 Trade Marks, 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.*¹ shows the importance of a circumstantial detail of facts, and especially the necessity for setting forth the exact date of placing the symbol upon goods offered for sale.

§ 627. The statute requires that the length of time during which the trade-mark has been used shall be stated in the application; and the statement is generally conclusive against the affirmant in any subsequent proceeding; for it would not be just to allow him to fix a date under oath, and afterwards, when another claimed a prior title, to come in and alter the date so as to anticipate his opponent's title. In one case,² the Commissioner held that such preliminary statement should always be regarded as conclusive against the party making it, restricting him to the date, and substantially to the history therein set forth, while, by a well-known rule of law, it can never be used as evidence against the adverse party in interference; and in another case, it was said that if testimony, taken upon an interference, tends to set up an earlier date than was claimed in the preliminary statement of the same party, it must at least be viewed with grave suspicion.³ The stringency of this rule is sometimes relaxed, upon overwhelming evidence of unintentional error, and of perfect good faith; although, of course, the presumption is always against him who would attempt to vary a statement made under the solem-

¹ *Infra*, § 661.

² *Kenyon v. Wesson*, Com. Dec. 1871, p. 91.

³ *Tegmeyer v. Kerns*, *Ibid.* 285.

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

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

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

¹ Schenck v. Rider, Com. Dec. 1870, p. 135.

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

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

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

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

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

¹ *Jenkins et al. v. Putnam*, Com. Dec. 1870, p. 156.

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

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

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

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

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

¹ *Eames & Sealey v. McDougal*, Com. Dec. 1871, p. 206.

² *Hawkins v. Lambert*, Ibid. 273.

³ *Jackson v. Nichols*, Ibid. 278.

⁴ *Eames & Sealey v. McDougal*, *supra*.

⁵ Rule of Practice 102, as to interferences.

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

§ 638. *Grounds of Interference.* — Marks do not conflict unless they are identical in form, or have such a near resemblance to each other that the public may confound them. Although there may be points of resemblance, they will not warrant the declaration of an interference, unless confusion be likely to ensue. Take the following case as an illustration. One person obtained a certificate of registry¹ 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 certificate² for a trade-mark, for substantially the same class of merchandise. The mark of the latter was described as consisting essentially of the word "Centennial." The prior adopter said that he was prepared to discard all the other elements of his mark, and confine his claim to the one word. The Examiner held that the specifications on file were the criteria of action; and that, as they did not disclose any conflict of claims, inasmuch as the two things were so dissimilar that they were not calculated to deceive, it was not a proper case for an interference.³ If the prior applicant limited himself to the use of the word in combination with other things, it was his misfortune. Thus the junior applicants were left with a broad claim to the word "Centennial," which they might use, in combination or not, at pleasure. For the pur-

¹ Leopold Sternberger. No. 709, dated March 10, 1872.

² Thalbot & Co. v. Sternberger, No. 809, dated May 7, 1872.

³ In *Thalbot & Co. v. Sternberger* (138), it was held that a star and crescent for so many years previously registered by another of the figure of a swan was held to conflict with "Black Swan." (Re

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

§ 639. *Compulsory Testimony.* — Previous to the passage of the act of Congress of March 2, 1861, it was within the option of witnesses to give their testimony or not, so that there were frequent failures of justice. That act provides, "That the clerk of any court of the United States for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue a subpoena for any witness residing or being within said district or territory, commanding him to appear and testify before any officer in said district or territory authorized to take depositions or affidavits, at any time and place in the subpoena stated; and if any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or, after appearing, shall refuse to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases."² The act further provides that the witnesses shall be allowed the same fees as are allowed to witnesses attending the courts of the United States; and they are not compelled to attend at any place more than forty miles from the place where the subpoena is served, unless the fees are paid or tendered in advance.

§ 640. *Parties have Access to Testimony* on file prior to the hearing, in presence of the officer in charge, and copies may be obtained by them at the usual rates.³

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

² Re-enacted as Section 44 of the Patent Act of July 8, 1870; Rev. Stats., sect. 4906.

³ Rule 209.

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

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

§ 643. A motion to open an interference for a rehearing, after a decision *sub silentio*, will be refused where there has been gross negligence in preparing for it. There is a case² where, four months after the decision had been made, and after frequent allowances of additional time, a party had the cool assurance to ask for a still further opportunity. His motion was denied. Up to that time he had taken no proof, offered no affidavit except his own affidavits to show what proof he desired to offer, or that any evidence existed ; and his affidavits gave no details, but were most general in statements. The Office regarded his persistent waste of time as intended simply for delay, although he made affidavit to the contrary. This is an extreme case ; for it is seldom that repeated postponements would be countenanced, unless by the consent of the adverse party.

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

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

¹ Rule 157.

² *Covel v. Maxim et al.*, Com. Dec. 1869, p. 78.

³ See 125th Rule of Practice in the Patent Office.

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

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

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

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

¹ See Act of March 3, 1881, sect. 3.

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

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

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

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

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

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

² *Whitely v. Swain*, 4 Fisher, 123.

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

the right to the exclusive use of a trade-mark. We shall thus not only see the formal part of the proceedings which characterize such a matter, but also have a curious exhibition of the 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.¹

§ 654. Armistead responded by a sworn statement of his version of the origin, etc. of the mark, partly from his own knowledge, and partly on information and belief, deducing his title through one Wesley A. Wright, and taking it back to 1860.² Blackwell also filed his statement, setting forth that, in 1865, one J. R. Green, from whom he claimed title, was engaged in manufacturing tobacco in North Carolina at the time of the approach of the armies of the United States under command of General W. T. Sherman, and the retrograde movements of the army of General Joseph E. Johnston, of the so-called Confederate States, and in the vicinity of the town of Durham. That when the armistice antecedent to the surrender of the army of General Johnston was promulgated, the two armies occupied positions adjacent to said town of Durham, and the town and vicinity became common ground to each army; that said Green sold large quantities of smoking-tobacco to the soldiers; and from the circumstance of the surrender at that place, he believed that the name "Durham"

¹ See Trade-Mark Rule 13, ed. of 1885.

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

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

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

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

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

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

¹ Blackwell v. Armistead, 5 Am. L. T. 85; 3 Hughes, 163.

Tobacco," for such words in common use cannot be appropriated.¹ Nor can the words "manufactured by W. T. Blackwell," for they are in the nature of a mere advertisement. If any word contains the essential attributes of the symbol known to commerce as a trade-mark, that word is "Durham." The respondent's first point denies that by any possibility it can be a trade-mark, and cites cases. If the word "Durham" is used for the purpose of indicating that the merchandise to which it is affixed is manufactured and sold at a place called Durham, it cannot be a trade-mark.² Did the applicant use it for that purpose? If the word is used in its geographical sense, it means but one place, — a village in North Carolina. That is conceded and proved. The applicant or his assignor there began business in 1850, or 1860. The respondent now carries on business there. Is there such a place as Durham in North Carolina? Some witnesses speak of "Durham"; some, of "Durham's"; others, of "Durham's Station." The official list of post-offices spells it "Durham's," the apostrophe probably signifying "Durham's Station." It is officially so certified by the Acting First Assistant Postmaster-General. That settles the question. The word as used by both parties is not meant to indicate locality. The evidence shows that it is used to denote the excellence of the tobacco.³ It is not pretended that the tobacco is raised at Durham's Station; or, if it were, that the soil of that locality possesses any peculiar properties to make tobacco grown therein better than in any other. The witnesses swear that the flavor imparted by the tonka bean and other ingredients makes it superior, as manufactured in a peculiar manner. Blackwell did not mean it in a geographical sense, when he began to use the word. His sworn statement shows that. This does not concede, as law, that a geographical name cannot be a trade-mark. It generally cannot be, for the reason given in the "Lackawanna" case.⁴ But this rule has exceptions. The leading authority

¹ See *ante*, § 134, "Generic Names."

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

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

⁴ See *ante*, § 189.

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

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

¹ See *ante*, § 184.

² See *ante*, § 237.

³ See *infra*, Chapter XV., on "Abandonment."

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

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

¹ See *ante*, § 188.

² See *ante*, § 183.

³ See *ante*, § 43, "Unfair Competition in Business."

⁴ Reported in full, 1 Off. Gaz. 603.

⁵ *Blackwell v. Armistead*, *supra*.

able flavor. It is proved that the whole merit of this smoking-tobacco, and its celebrity, were due to the flavoring. He was confessedly the first to begin its manufacture at Durham's Station. There was nothing in the locality that could reasonably have been counted on to commend his manufacture to the public. Take his own statement, and what was his brand? "Best Spanish Flavored Durham Smoking Tobacco." What, in view of the pleadings and the evidence, is the characteristic — the vital element — of this trade-mark? Manifestly, "Best Spanish Flavored." This is the only conspicuous and discriminating element of the trade-mark.¹ "Durham," if indeed a part of it, is subordinate and insignificant. There is nothing to restrain succeeding manufacturers from engrafting it on their brand, so long as they laid no claim to, nor made use of, his words "Best Spanish Flavored" compound, which he indeed appropriated² by the first and original use of this only conspicuous term in his stencil-plate in 1860-61. It must be remembered that Wright was only in the infancy of this manufacture at Durham; and that others followed and developed it, till the complainants instituted their brand in 1865-66. What motive could have existed with Wright, all whose reliance was on the merits of his flavoring compound, to invoke the name of a small, thriftless station on a railroad, settled by but two or three families, with a store and this factory, to invoke its name to give celebrity to the preparation to which he solely looked for his reward?³ It is abundantly proved that his product was known, called, and distinguished in the market as "Durham" smoking-tobacco. The plaintiffs secured their label by copyright.⁴ Argument and ridicule are relied on to show the inapplicability of a copyright for such a print. The language of the statute is certainly comprehensive enough to embrace a label of this kind. The object of such copyright is to secure to "the

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

² He could not possibly do so, for they are common language.

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

⁴ A grave error. See *ante*, §§ 109, 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-symbol¹ 'Bouquet.' To increase the pictorial effect of this mark, 'Bouquet' may be associated with a branch or wreath of flowers, or other appropriate ornaments, but they are not a part of the mark. It is for cured meats. The alleged trade-mark of Beresford & Co., the respondents, consists of a bouquet, thus described. Two sprigs of leaves, having their stems at the bottom of the lithograph, and fastened together by a ribbon, are bent around the bouquet, so that their ends nearly touch, and so as to form an oval. Within this oval is the bouquet, composed of various colored flowers, ears of grain, and several varieties of leaves. It is for hams and breakfast bacon. One mark consists of the word-symbol 'Bouquet,' and the other of the representation or picture of a bouquet. The question that arises is *sui generis*. It is believed that the precise point here suggested has not been decided by any tribunal.² The name of an object is brought into conflict with a picture of the object. The former addresses itself more particularly to the ear; the latter, to the eye. No countenance can be given by the Office to what may possibly be turned into an instrument of wrong, or even of annoyance in trade. Let us take a hypothetical case. A customer inquires thus: 'Have you the Bouquet brand of

¹ See *ante*, § 89 a, as to this term.

² See *ante*, § 33, "Colorable Variation"; also, as to alternate forms, *ante*, § 606.

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

¹ See *ante*, § 89, for discussion of this point.

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

³ See *ante*, §§ 66 *et seq.*

⁴ See "Abstract Symbol," in the Index.

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

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

§ 662. A multiplicity of legal questions upon the trial of an interference arises before the Patent Office. The following case² involves a number of nice points worthy of notice. Any matter affecting the title to the thing in controversy may be shown, subject, of course, to the established rules of evidence. After reciting certain facts not necessary now to be considered, the decision of the Examiner proceeds substantially thus.

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

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

¹ This was a fatal concession. See "Abstract Symbol," in Index.

² Walch, Brooks, & Kellogg v. M. J. Cole & Co., in 1872.

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

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

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

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

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

¹ See case of *Filley v. Fassett*, 44 Mo. 173; 8 Am. L. Reg. (N. S.) 402; R. Cox, 530.

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

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

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

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

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

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

¹ See *ante*, § 71, "A Lack of Truth debars," etc.

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

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

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

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

¹ *Kidd v. Johnson*, 100 U. S. 617. It was held, in 1884, that a trade-mark will pass under a general conveyance of all the assets and effects of a firm, though not specifically designated. *Morgan et al. v. Rogers*, 19 Fed. R. 596.

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

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

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

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

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

CHAPTER XV.

ABANDONMENT.

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

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

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

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

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

¹ 2 Bl. Com. 9.

² *Adams & Hammond v. Edwards et al.*, 1 Fish. 1.

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

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

¹ See "Abstract Symbol," in the Index.

² See *ante*, §§ 178-181.

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

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

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

¹ See *ante*, §§ 220 and 252, for other examples.

² *American Hide & Leather, &c. Co. v. American Tool, &c. Co.*, 4 Fish. 284.

³ See *ante*, §§ 346, 347.

⁴ See *ante*, §§ 52, 382-384.

Why? Because the title to the invention passed to the public, the instant that the only person who had a right to a patent dedicated his invention to the common stock of property. But in the case of discontinuance of the use of a trade-mark the public gain nothing thereby, except the negative benefit of precluding an individual from profiting by the exclusive use of it as a sign. Thus in a case¹ in the Court of Paris, in 1870, when the plaintiff's claim to the exclusive use of the representation of a golden bee, as a trade-mark for hats, was rejected, what did the public gain by the decision that the emblem was not a private mark? The court said, among other things, that, whether as an emblem or as an ornament, the bee is common property. Any person might therefore use it as an ornament for a hatter's label, or in any other mode; but the plaintiff had no exclusive right to "a bee in his bonnet." There is no advantage to the public in the liberty of adorning furniture or hats with golden bees; but there is always presumed to be benefit in the use of an invention, of which benefit use is the strongest kind of evidence. And as to the denomination of an article of commerce, as evidences of our right to call a thing by its true name, we might cite authorities by the score. The name may originally have been the coinage of a manufacturer to designate his peculiar product; but it may have instantly become the only true and proper denomination of the article, wherefore all might use it.²

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

¹ Héroid v. Gerbeau, 16 Annales, 76.

² See *ante*, § 220, "The Necessary Name of a Product."

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

¹ *Mouson & Co. v. Boehm*, 26 Ch. D. 398.

² *Browne v. Freeman*, 12 W. R. 305; 4 N. R. 476.

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

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

¹ *Atlantic Milling Co. v. Robinson et al.*, 20 Fed. R. 217.

² *Holt et al. v. Menendez et al.* (Not yet reported.)

³ *Armstrong v. Kleinhaus*, 19 Rep. 528.

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

⁵ *Taylor v. Carpenter*, 2 Wood. & M. 1.

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

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

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

³ *Sprague v. Adriance*, 14 Off. Gaz. 308.

⁴ *Hovey v. Henry*, 3 West. L. J. 153.

⁵ *Williams v. Boston & Albany R. R.*, 17 Blatch. 21.

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

⁷ *Kendall v. Windsor*, 21 How. 322.

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

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

¹⁰ *McMillan v. Barclay*, 5 Fish. 189.

¹¹ *Taylor v. Carpenter*, 3 Story, 458.

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

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

¹ *Gillott v. Esterbrook*, 48 N. Y. 374.

² *Wolfe v. Barnett*, 24 La. Ann. 97.

³ *Lazenby v. White*, 41 L. J. (N. S.) 354.

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

⁵ *Eydoux v. Morel*, 23 Annales, 252.

⁶ *Mouson & Co. v. Boehm*, *supra*.

⁷ *Leroy v. Calmel*, 10 Annales, 193.

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

¹ Dental Vulcanite Co. v. Wetherbee, 3 Fish. 87.

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

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

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

² *American Hide, &c. Co. v. American Tool, &c. Co.*, 4 Fish. 305.

³ *Ward v. Ward*, 7 Ex. 738.

⁴ *Lemoine v. Ganton*, 2 E. D. Smith, 343; R. Cox, 142.

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

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

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

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

¹ Rodgers & Sons v. Philp & Solomons, 1 Off. Gaz. 29.

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

¹ See authorities cited *ante*, in note to § 336.

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

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

¹ Taylor v. Carpenter, 3 Story, 458; R. Cox, 14.

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

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

¹ *Amoskeag Manuf. Co. v. Spear*, 2 Sandf. S. C. 599.

² *Gillott v. Esterbrook*, 47 Barb. 455.

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

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

¹ *Filley v. Fassett*, 44 Mo. 173.

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

³ *Spencer & Son v. Peigney*, 10 Annales, 197.

⁴ See Broom's Legal Maxims, 700.

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

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

¹ Menier *v.* Buisson *et al.*, 18 Annales, 24.

² Menier *v.* Rochebrun, *Ibid.* 29.

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

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

⁵ Mulhens *v.* Buchholz, 24 *Id.* 29.

the mark involved in the suit; but he had continued to affix to his products a notice that his label and mark were registered. That was evidence that he had not abandoned.¹ — In 1882, the Tribunal of Havre² said, that whereas property in a mark can be abandoned expressly or tacitly, tacit abandonment cannot be presumed, and simple acts of tolerance cannot be deemed renunciation; that non-user itself during the time, more or less long, permits nevertheless the claim to property in a mark, provided that during that time it did not fall into the public domain. — The late M. Pataille, certainly very high authority, gave as his opinion, that the default of suing for false imitation going back for more than three years cannot be regarded as abandonment, when coupled with the fact that the owner of the trade-mark had legally registered it, and had not ceded his right.³

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

¹ Carrière v. Durand *et al.*, 25 Annales, 166.

² Chapu v. Legrand *et al.*, 27 Id. 201.

³ Affaire Vrau v. Divers, 26 Id. 85.

⁴ "Medicina mortuorum sera est." Quintil.

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

§ 688. The case of *Stubs v. Astier et al.*,¹ in the Court of Paris, in 1864, on appeal from the Tribunal Civil of the Seine, involved the same principle. The Tribunal confiscated the spurious goods, consisting of cutlery, and imposed a fine. Hence the appeal. The appellate court said that the mark claimed by the complainant as his peculiar property had long been in France the index of a product of superior quality, and had ceased to be an indication of the origin of manufacture, but had become the very designation of the nature of the product of which it is the denomination. That a mark so long known to the public to cover products of a superior quality would operate to the exclusion of all others was manifest, and it would cause considerable damage to French industry to deprive it of the fruit of labor to enrich Peter Stubs; that such a result would, in effect, extinguish the just stipulations of reciprocity contained in the treaty of commerce of March 10, 1860.² It must also be considered that Peter Stubs can assure his rights, in the wise limits that the law has traced, by giving to the mark used by him in France a peculiarity of appearance that can suffice to prevent confusion between his products and those of other persons. He will then have obtained all the advantages that the said treaty intended for foreigners. — When we reflect upon this judgment and the one immediately preceding it, we come to the conclusion that the courts did not desire to countenance fraud in the slightest degree. The originally trustworthy marks

¹ 10 *Annales*, 212.

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

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

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

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

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

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

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

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

¹ Lawson *et al.* v. Dechaille, 19 Annales, 153.

² Affaire Armstrong, 23 Id. 216.

³ Jaubert-Bonnaire v. Wilford, Bulletin Officiel, January 8, 1885.

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

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

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

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

APPENDIX.

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

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

ARTICLE I.

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

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

ARTICLE II.

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

¹ See the note to Article II. of Convention with France, p. 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.

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

ARTICLE I.

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

ARTICLE II.

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

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

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

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

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

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

ARTICLE I.

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

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

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

ARTICLE II.

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

¹ This Article II. is not correctly translated. On March 21, 1877, the French Minister at Washington invited the attention of the Secretary of State to the fact of the omission of a material word, "*devront respectivement être 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.)

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

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

ARTICLE XVII.

With regard to the marks or labels¹ of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade,² the citizens of Germany shall enjoy in the United States of America, and American citizens³ shall enjoy in Germany, the same protection as native citizens.

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

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

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

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

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

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

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

² These five words mean trade-marks proper.

³ Observe the broad term, which is limited to citizens of the United States.

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

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

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

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

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

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

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

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

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

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

ARTICLE I.

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

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

TRADE-MARK LAWS OF VARIOUS COUNTRIES.

AUSTRIAN LAW OF DECEMBER 7, 1858.

I. *General Provisions.*

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

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

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

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

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

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

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

ART. 7. All that is stated in the present law in regard to 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.)

BELGIAN TRADE-MARK LAW OF APRIL 1, 1879.

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

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

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

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

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

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

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

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

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

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

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

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

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

ART. 16. A fraudulent registration may be annulled.

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

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

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

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

CANADA.

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

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

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

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

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

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

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

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

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

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

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

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

DENMARK.

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

I.

ART. 1. It is forbidden to all persons to affix to their merchandise intended to be put into general circulation, or on the packing thereof, the name of another person or firm, or the name of a place of manufacture of products of another person. It is equally forbidden to affix on such merchandise, or on its packing, a 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.)

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

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

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

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

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

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

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

It is cancelled officially, —

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

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

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

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

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

Other registrations and cancellings are gratis.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

ITALY.

LAW OF AUGUST 30, 1868.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

ART. 14. Applicants for registration of trade-marks must pay the following fees, provided that, in case their applications are rejected, the money will be refunded: 1. The sum of ten yen¹ must be paid for the registration of one trade-mark, and if the same mark is to be applied or transferred to articles of different classes, five yen must be added for each class. 2. Applications for transfer wholly or in part, or for alteration of trade-marks, or for the continuation of their use after the expiration of the registered term, will involve the payment of five yen for every mark. 3. One yen must be paid for obtaining a fresh certificate of registration.

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

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

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

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

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

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

¹ A yen is equal to our dollar.

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

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

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

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

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

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

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

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

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

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

The fee for registration and publication is ten florins.

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

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

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

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

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

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

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

ROUMANIA.

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

(Translation from the Russian.)

EXTRACT FROM THE STATUTE OF LAWS RELATING TO
MANUFACTURING INDUSTRY. (Code of Civil Laws, Vol. XI.,
Part 2, Edition of 1857.¹)

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

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

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

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

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

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

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

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

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

¹ Reports relative to Legislation in Foreign Countries on the subject of Trade-Marks (British Parliament, 1879), p. 96.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

TURKEY.

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

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

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

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

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

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

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

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

A TREATISE
ON THE
LAW OF TRADE-MARKS

AND ANALOGOUS SUBJECTS,

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

BY

WILLIAM HENRY BROWNE, LL.D.

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

S U P P L E M E N T

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PREFACE

OF THE SUPPLEMENT TO THE SECOND EDITION

OF

BROWNE ON TRADE-MARKS.

MORE than twelve years have passed since the publication of the above-mentioned work. Intervening time must be bridged by later authorities.

Although but few principles of the law appertaining to the subject have subsequently been evolved, still there are elucidations, judicial refinements, and modifications consequent on the legislation of various nations which require attention.

When the International Union for the Protection of Industrial Property was formed on May 20, 1883, by a Convention of representatives of several countries, it was believed that long-pending misunderstandings were soon to be harmonized, and that Commerce and Manufactures would be regulated by set rules of action, and that symbolic language of subjects in which all are interested might be regulated by intelligent general concurrence, so that the interpretation thereof might be as precisely reliable as the precious metals when coined. There was no difficulty in constructing a Bureau of the Union to act as a world-wide intermediary, and to place it in the Republic of Switzerland, isolated from the jealousy of rival and powerful kingdoms.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Sweden were first to enter the combination. Subsequently Great Britain, Tunis, the Dominican Republic, Norway, and Sweden signed the Convention and final Protocol. (The Republic of Salvador withdrew August 17, 1886.) The United States of America, with the advice and consent of the Senate, on March 27, 1887, adhered to the Convention and final Protocol of 1883. (Austria-Hungary joined the Union subject to parliamentary approbation.)

It is necessary to explain why our Nation never heartily co-operated in the general plan intended to unite all countries as one family in commercial relations. Our patent system was the stumbling-block. It was found that it was imperilled by too much concession, — the same difficulty which caused Great Britain to virtually withdraw. There was a general desire to disentangle trade-marks from the objects of the International Union.

Thereupon resulted the Arrangement of April 14, 1891, adopted by the Conference at Madrid, providing for International Registration of trade-marks. The system for central registration was a promising step. It was to take account of the differences existing between the laws of the several countries, especially of the necessary facts preliminary to registration in the places of origin; of the unequal terms of protection granted in different countries; and the publication of registered marks in all countries where protection was to be afforded. Although nominally a member of the Union, our country never became so in the fullest sense. The proclamation of our President reads thus: "And whereas the President of the United States of America,

by and with the advice and consent of the Senate thereof, did on the 29th day of March, 1887, declare that the United States adhere to the said Convention and final Protocol of the 20th of March, 1883," etc.

At first sight this statement is convincing. Eminent jurists and statesmen have accepted it as conclusive, and opinions have been rendered from the Federal Bench based thereon. On close examination, however, it is found to be fallacious.

The Attorney-General of the United States was called on to decide as to the effect of the mere senatorial confirmation; and on April 5, 1889, he rendered an opinion, of which the following is an extract (Opinions of the Attorney-General for 1889, p. 253): "This treaty is a reciprocal one. Every party covenants to grant to the subjects and citizens of the other parties certain special rights, in consideration of the like special rights to its subjects and citizens. It is a contract operative in the future infra-territorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws." He cites the decision of the Supreme Court of the United States, wherein Chief Justice Marshall rendered the opinion, declaring as follows (*Foster v. Neilson*, 2 Peters, 314): "A treaty is in its nature a contract between two nations, not a legislative act, . . . and the legislature must execute the contract before it can become a rule for the Court."

The question of registrability could best be practically tested by consulting Mr. Morel, Director of the International Office for the Protection of Industrial Property, at Berne, Switzerland. His answer, confirmatory of the long-held views of the author of this Treatise, is given in the following extract:—

“Les Etats Unis n’ont adhéré jusqu’ici qu’à la Convention générale du 20 mars 1883 pour la protection de la propriété industrielle. Ils n’ont pas encore accédé à l’Arrangement du 14 avril, 1891, qui constitue une Union restreinte pour l’enregistrement international des marques de fabrique ou de commerce. Notre Bureau n’est donc pas compétent pour recevoir des marques américaines en vue de leur assurer la protection légale dans les États ayant adhéré à l’Arrangement sur l’enregistrement international.”

Forasmuch, then, as the United States have not adhered to the limited Union constituted by the Arrangement of 1891, International Registration does not apply to them. As heretofore, independent treaties, or conventions, must be resorted to, unless our Congress shall have legislated in the matter.

These explanations were needed.

It is deemed advisable to include the general Index of the Second Edition in the general Index of this Supplement, as one will thereby be enabled to follow out subjects from their introduction.

W. H. B.

WASHINGTON, D. C.,
March, 1898.

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A.	Atlantic Reporter.
A. C.	Appeal Cases.
Abb. N. C.	Abbott's New Cases.
Alb.	Albany Law Journal.
Annales	Annales de la Propriété Industrielle, Artistique et Littéraire. (Paris)
App. Cas.	Appeal Cases.
App. Div.	N. Y. Appellate Division.
App. D. C.	District of Columbia Court of Appeals.
Barb.	Barbour's Supreme Court Reports. (New York.)
Cal.	California Supreme Court Reports.
Can. S. C. R.	Canada Supreme Court Reports.
C. C. A.	U. S. Circuit Court of Appeals.
Ch.	Chancery Division. (English.)
Ch. D.	Chancery Division. (English.)
Daly	Daly, New York Common Pleas.
F.	The Federal Reporter.
Ga.	Georgia Supreme Court.
Har. Law Rev.	Harvard Law Review.
H. L. E.	House of Lords of England.
How. Pr.	Howard's Practice Reports.
Hun	New York Supreme Court.
Ill.	Illinois Supreme Court.
Ill. App.	Illinois Appellate Court.
Ind.	Indiana Supreme Court.
Iowa	Iowa Supreme Court.
Jur. (N. S.)	Jurist, New Series. (English.)
La. Ann.	Louisiana Supreme Court Reports.
L. J. P. C.	Law Journal Reports.

L. J. Q. B. (N. S.)	Law Journal, Queen's Bench. (New Series.)
L. R. Ch. App.	Law Reports, Chancery Appeals.
L. T. Rep.	Law Times Reports.
L. T. Rep. (N. S.)	Law Times Reports. (New Series.)
Mass.	Massachusetts Supreme Judicial Court.
Minn.	Minnesota Supreme Court.
Misc. Rep.	New York Miscellaneous Reports.
Miss. Rep.	Mississippi Supreme Court.
Mo.	Missouri Appellate Court.
MS. Dec.	Manuscript Decisions of the Patent Office.
N. E.	Northeastern Reporter.
N. W.	Northwestern Reporter.
N. Y.	New York Court of Appeals.
N. Y. Crim. R.	New York Criminal Reports.
N. Y. Super. Ct.	New York Superior Court.
N. Y. Supp.	New York Supplement.
N. Y. S.	New York Supplement.
Off. Gaz.	Official Gazette of the United States Patent Office.
Ohio Dec.	Ohio Decisions.
Ohio N. P.	Ohio Nisi Prius Reports.
P.	Pacific Reporter.
Pa.	Pennsylvania Supreme Court Reports.
Pa. C. Ct.	Pennsylvania County Courts. (Common Pleas.)
Pa. Co. Ct. R.	Pennsylvania County Court Reports.
Pa. Dist. R.	Pennsylvania District Reports.
Q. B.	Queen's Bench.
Rep.	The Reporter.
R. I.	Rhode Island Supreme Court.
R. S.	Revised Statutes of the United States.
S.	Southern Reporter.
Sup. Ct. Rep.	United States Supreme Court Reports.
S. W.	Southwestern Reporter.
U. S.	Supreme Court Reporter.
U. S. App.	United States Court of Appeals.
Wis.	Wisconsin Supreme Court.
Wkly. Law Bull.	Weekly Law Bulletin.
W. N. C.	Weekly Notes of Cases.

SUPPLEMENT
TO
LAW OF TRADE-MARKS.

CHAPTER I.

VALID TRADE-MARKS.

- § 692. The office of a trade-mark
- § 693. What constitutes the symbol.
- § 694-696. Illustrations of valid trade-marks.
- § 697. Object of a trade-mark.
- § 698 *et seq.* French court decisions.

§ 692. *The office of a trade-mark* is to point out distinctively the origin, or the ownership, of the article of merchandise to which it is affixed; or, in other words, to give notice as to who is the producer. This may be done in many cases by a name, or mark, or a device well known, but not previously applied to the same article.¹ See the U. S. C. C. of Appeals in the case of *Improved Fig Syrup Co. v. California Fig Syrup Co.*²

§ 693. As to what may constitute the symbol of a valid trade-mark, depends on the reason that is wrapped up in it and the circumstances involved. Examples are almost infinite in number and variations. What is valid in one case, in another, having close resemblance thereto, may be worthless for the purpose. No rigid rules can be laid down for guidance. — The word “Celluloid,” being a new and arbitrary word coined by the plaintiff and applied to goods of

¹ For full treatment of this subject, see Chapter III., Browne on Trade-Marks.

² 54 F. 177; 4 C. C. A. 264; 7 U. S. App. 588.

its manufacture, is a valid trade-mark, and will be protected, although the word has become so generally known as to have been adopted by the public as the common appellation of the article to which it is applied.¹ — “Kaiser,” as applied to beer, which had become known in the United States as the product of a particular German brewer, is a valid trade-mark, though under the laws of Germany it could not be adopted as such.² — Royal is not descriptive of Baking Powder, but is only “a metaphor in a high degree fanciful and remote.” “It is, in fact, a sign of origin.”³ — “Bromo-Caffeine,” a term not in general use when plaintiff applied it, and not descriptive of the articles used to make the medicine designated by it, is valid.⁴ — The fact that flour marked with a certain brand acquired an extensive sale because the public discovered that it might be relied on as of a uniformly meritorious quality, demonstrates that the brand deserves protection, plaintiff having acquired the exclusive right to the words “La Favorita” for flour. It is no answer to say that there was no invasion of that right because the name accompanying the words on flour sold by the defendants varied from that used by the plaintiffs.⁵ — The word “Star,” and the symbol of a star, adopted and used during many years by manufacturers of shirts, waists, underwear, and furnishing-goods, to mark and designate the same, in combination with the words “Star Shirts,” and other words describing the articles, so that the goods became well known by such marks, and the designation “Star Goods,” constitute a valid trade-mark. Morrison & Hoyt began, in or about 1859, in the city of New York, marking goods with the word “Star,” and so marking the packages and boxes containing said goods as to make the star so prominent and conspicuous as to attract attention, and deceive purchasers into the belief that the goods made

¹ Celluloid Manuf'g Co. v. Read (C. C.), 47 F. 712.

² Kaiserbrauerei, Beck & Co. v. J. & P. Baltz Brewing Co., 71 F. 695 ; affirmed C. C. A. 74 F. 222. See Luyties v. Hollandeer, 30 F. 632.

³ Royal Baking Powder Co. v. Raymond, 70 F. 376.

⁴ Keaseby v. Brooklyn Chemical Works, 37 N. E. 476 ; 142 N. Y. 467 ; reversing 21 N. Y. S. 696.

⁵ Menendez v. Holt, 128 U. S. 514 (L. ed. 32, 226).

by defendant were the "Star Goods" of the complainants. Defendant denied infringement, as he had combined a crescent with the star. He also said that usually the complainants' star was red in color, and of six prongs, while defendant used a five-pointed star of another color. He was enjoined.¹

§ 694. The word "Saponifier" became a technical trade-mark for concentrated lye, especially after a public acquiescence for thirty-five years.²— Every one of the plaintiffs' cigarettes was enclosed in a paper wrapper across which were the words, in circular form, "Sweet Caporal." Within the circle, and lengthwise of the paper, was the word "Rice," below which were "Kinney Bros." in script, and below the word "Paper." On the wrapper of defendants' cigarettes were the words, in circular form, "Sweet Coronal." Within the circle, and lengthwise of the paper, was the word "Rice," below which was "Oscar Maller" in script, and below that the word "Paper." To the left was the figure of a crown. The form and style of the letters and characters used by defendant closely resembled those used by plaintiff, as did also the manner in which they were grouped. *Held*, that the use of this combination by defendant was an infringement of plaintiffs' trade-mark.³— Plaintiffs conceiving that they had discovered a salt from the plant "wintergreen," containing valuable antiseptic properties, sent a quantity of the same to a chemist, for analysis and designation by a suitable name. The chemist suggested the name "Asepsin," a word coined by him to indicate the antiseptic qualities of the salt. Plaintiffs adopted and caused that name to be registered as a trade-mark. *Held*, that plaintiffs were entitled to the exclusive use of that word as a trade-mark, and that the word being new it was not objectionable as

¹ Hutchinson *et al.* v. Blumberg, 51 F. 829.

² Pennsylvania Salt Manuf'g Co. v. Myers, 79 F. 87. This is made up of Latin words "sapo" (soap) and "facere" (to make), and therefore is not descriptive. In *Ex parte Wolf*, in July, 1897, *held*, as "Gyrator" for bolting-machine, being a common English word, is merely descriptive, and therefore cannot be registered. U. S. Com. of Patents, Butterworth; 80 O. G. 1271.

³ Kinney Tobacco Co. v. Maller, 6 N. Y. S. 389; 53 Hun, 340.

such because it suggested the qualities of the article sold.¹ — The plaintiff corporation manufactured matches under a trade-mark owned by it, affixed by a label on the match-box. On that was stamped, in red, “The Vulcan,” over a globe with representations of certain medals owned by the plaintiff, and the words “Damp Proof,” “Trade-Mark,” “Paraffin Matches.” Defendant imported matches in boxes of like size and general appearance, and bearing a label stamped in red, with the same words, except that “The Vulture” was substituted for “The Vulcan,” with a fac-simile of the same medals, and in addition the picture of a vulture. The words and characters on the bottom and one of the sides of every one of the boxes were widely dissimilar. *Held*, that the resemblance between the boxes was such as to tend to create confusion and deceive intending purchasers of plaintiff’s goods. Injunction.²

§ 695. The complainant and its predecessors had for many years manufactured and sold scythe-stones under the trade-marks “Lamoille,” “Green Mountain,” “Black Diamond,” “Indian Pond,” “Magic,” and “Willoughby Lake.” Defendants, having succeeded to a company which had contracted to purchase complainant’s scythe-stones for a series of years, refused to carry out the contract; and having procured quarries, were manufacturing and selling scythe-stones under the above names, except that they used in place of “Willoughby Lake” “Willoughby Ridge,” and in place of “Black Diamond” “Diamond Glen,” these names never having been used by complainant to designate stones taken from defendants’ quarries. *Held*, that a preliminary injunction applied to all the names, whatever the decision might be, were the question alone as to the terms “Willoughby Ridge” and “Diamond Glen.”³

¹ Lloyd v. Wm. S. Merrill Chemical Co. (Cin. Sup. Ct.), 25 Wkly. Law Bull. 319.

² Taendsticksfabricks Aktiebolaget Vulcan v. Myers, 34 N. E. 904; 139 N. Y. 364.

³ A. F. Pike Manuf’g Co. v. Cleveland Stone Company (four cases), U. S. C. C. of Mass. and N. H., Colt, J., 35 F. 896.

§ 696. For fifteen years prior to 1855, two companies used in common, and made and sold certain patterns of scythe-stones. In 1876, they formed a pool, and for nine years sold their manufactures under the same labels. In 1885, they united with others to form another pool, all the members of which sold like patterns under like labels. In 1886, the plaintiff company bought out one of the original companies, and it and the other original company only continued to make and sell until 1890, when plaintiff bought out the other original company. *Held*, that there had been no such indiscriminate use of the patterns as would deprive plaintiff of its exclusive use.¹— The word “Marvel” may be appropriated as a trade-mark to designate the output of a certain mill.²— The word “Ideal,” as a trade-mark for fountain pens, is valid.³— “Johnson’s Anodyne Liniment” had been sold for more than fifty years in bottles of a certain size and style, having a blue wrapper and a purplish label bearing a certain description, and a fac-simile of the name of A. Johnson. The defendant had a label differing but little from that of the genuine article, except a not very marked difference in color, and bore the fac-simile of defendant’s name, F. E. Johnson. There was evidence besides showing actual deception. Enjoined.⁴

§ 697. The object of the trade-mark is to indicate either by its own meaning, or by association, the origin or ownership of the article to which it is applied.⁵— The right to the exclusive use of a trade-mark does not depend on novelty or invention.⁶— A label bearing the head of an elk, with the word “Elk” in large letters, together with the words

¹ Cleveland Stone Co. *v.* Wallace *et al.*, 52 F. 431.

² Listman Mill Co. *v.* William Listman Milling Co., 60 N. W. 261; 88 Wis. 334.

³ Waterman *v.* Shipman (N. Y. App.), 29 N. E. 111; 130 N. Y. 301. (8 N. Y. S. 814, reversed.)

⁴ Jennings *v.* Johnson, 37 F. 304. (This comes very near being merely a trade-name.)

⁵ See Chapter IV., Browne on Trade-marks; Handy *v.* Commander (La.), 22 So. 230.

⁶ *Ibid.*

“Patented¹ by the Elk Cigar Factory, June 15, 1875,” sufficiently indicate origin and ownership to be a valid trade-mark.² — The fact that a trade-mark is put on different brands of the article is immaterial when the brands have distinguishing marks.³ — The fact that the owner of a trade-mark allows the packages to be labelled with the names of the dealers, is no deception.⁴ — The words “Anti-Washboard Soap” is valid as a trade-mark, the words so applied being suggestive rather than descriptive.⁵ — The words “Cough Cherries,” for a confection, are not descriptive of the quality of the article, but are sufficiently arbitrary and fanciful to be applied as a trade-mark.⁶ — The same rule applies to “Bromidia.”⁷ — Arbitrary numbers may be appropriated by a person to his exclusive use to designate the styles of goods which he makes, and they will be protected as trade-marks; though, of course, numbers already known to the trade, and in use by others, cannot be so appropriated.⁸ — The owner of certain natural springs, having for many years used the words “Blue Lick Water,” to designate water from his springs, will be protected in the use of such words as his trade-mark.⁹ — It is no defence that Spanish labels similar to a certain described trade-mark had been used by various manufacturers for many years, nor that imitations of the trade-mark were sold, or used, in the absence of evidence that it was with the consent or acquiescence of the owner.¹⁰ — The words “Nickel — In,” used to designate a brand of cigars, being original, arbitrary, and fanciful, and not descriptive of the articles, their grade, or quality, are entitled to protection.¹¹

¹ The wrong use of the word “Patented” is harmless.

² *Lichstein v. Goldsmith*, 37 F. 359. ³ *Ibid.* ⁴ *Ibid.*

⁵ *O'Rourke v. Central City Soap Co.*, 25 F. 576.

⁶ *Stoughton v. Woodard*, 39 F. 962.

⁷ *Battle & Co. v. Finlay et al.* (C. C. 1891); 50 F. 106 (*Battle & Co.*).

⁸ *American Solid Leather Button Co. v. Anthony*, 5 A. 625; 15 R. I. 338. (See *Humphrey's Homœopathic Med. Co. v. Hilton*, 60 F. 756, which decides that numerals used by a medicine company to identify descriptive terms will not be protected.)

⁹ *Northcutt v. Turney* (Ky.), 41 S. W. 21.

¹⁰ *Cuervo v. Jacob Henkell Co.* (C. C.), 50 F. 471.

¹¹ *Selchow v. Baker* (Sup.), 18 N. Y. S. 1; 63 Hun, 330.

§ 698. *Decisions in France.* — The Court of Cassation (the Supreme Court of France), in January, 1892, passed a decree enlarging the beneficent Article I. of the law of June 23, 1857.¹ It said that that Act punishes the usurpation of a trade-mark even if the usurper uses the mark on a prospectus only, and does not use it on the products which he delivers to the public. This decree definitely fixes a point of law up to that time vaguely defined. Inasmuch as the defendant had caused to be printed and distributed a prospectus bearing at its head the words “Salvo Petrolia et Cie,” ornamented with a vignette representing an American eagle with spread wings, these divers indications constituting one of the marks of the American concern, — the Oil Company, — as he well knew, he vainly asserted that the law of June 23, 1857, was not operative in his case, as he had not affixed these symbols to his products, but used them only on his prospectus. Article I. of said Act is couched in most general terms, and requires only a condition constituting a *tort* to make the defendant amenable to the law.²

§ 699. The words “Belle Jardinière” constitute not only a simple sign, but also a trade-mark (see decision, Court of Paris, 1894).³ — The Civil Tribunal of the Seine, in 1893, decided that the denominations “Grande Grille,” “Hôpital,” “Mesdames,” are valid trade-marks. It is unfair competition to present an artificial product (in this case “Vichy”) claimed as equal to the water of a spring belonging to a rival, and embracing the active principle of the natural springs, and producing an instantaneous result at a small price. This tends to establish a false analogy of therapeutic efficacy to the natural spring.³ It was claimed that confusion would thereby be created, and the public be misled to think that the merchandise is placed under the patronage and guaranty of the company; and it establishes between the products a comparison by the terms in which it is presented,

¹ See Browne on Trade-Marks (2d ed.), p. 686, Appendix.

² 39 *Annales*, 359.

³ *Bessaud & Richard v. Dubois*, 42 *Annales*, 90.

— a reprehensible disparagement. 2000 fr. damages, etc.¹ — In the Tribunal Civil of Lille, 1896, it was *held*: a bordering composed of a red thread, of a yellow thread, and of a white thread, constitutes a trade-mark for cloth, although the yellow thread had entered into the composition of a trade-mark that had previously become public property. A bordering composed of three such threads, with the interposition of another red thread, constitutes a fraudulent imitation, if there be a possible confusion of the mind of the consumer.²

§ 700. The Court of Lyons, in 1880, thus decided: The first adopter has the claim to exclusive use; but he cannot claim the mark of a lion, that is to say, consisting in the emblem of a lion, independent of every attitude, when it is established that having bought a place of business in which is employed a standing lion, he cannot object against his vendor substituting a lion lying down.³

§ 701. The Tribunal Civil of Lyons, in 1885, *held*: that words which constitute the necessary denomination of a product may, however, become the object of a private right, when they are disposed in a new manner, and are not the grammatical designation of the product. Especially the words “Liqueur de Quina,” being in the public domain the denomination “Quina liqueur,” becomes the property of him who first uses it.⁴

§ 702. The Tribunal Civil of the Seine, 1896, *held*: the denomination of the “Chat Noir” (black cat), registered in the year 1885, as a trade-mark with which to individualize an establishment composed of an eating-house and place of entertainment, was valid as a sign and trade-mark. The defendant — Ferny — used the title of “Chansons du Chat Noir” on the cover of his publication. The defendant vainly pleaded good faith, but he was forbidden to use the term “Chat Noir.”⁵

¹ *Compagnie fermière de Vichy v. Fédit & Co.*, 41 *Annales*, 296.

² *Wibaux-Florin v. Lalouette-Parent*, 42 *Annales*, 120.

³ *Flachat v. Bedel*, 32 *Annales*, 176.

⁴ *Goutard v. Brunier Brothers*, 33 *Annales*, 853.

⁵ *Solis v. Ferny et al.*, 43 *Annales*, 21.

§ 703. The Court of Rennes, in 1887, and the Court of Cassation, in 1889, had the following case before them: in *Saupiquet v. Dauché*. — In 1882, the complainant registered as his trade-mark for sardines a vignette representing a race-track, with the words “Sardines Jockey-Club” as the essential element. The defendant afterwards registered a vignette representing a regatta, with the inscription “Sardines Rowing-Club.” The Tribunal Civil of Nantes, while allowing the right to protection of the mongrel words of the complainant, decided that the form of the box was *not* entitled to protection. The complainant thereupon appealed, to secure his supposed right to the form of the box, which was purely geometrical, the color of which he asserted was original and having certain dispositions of placing. It went up on appeal until it reached the highest court, and was there decided in favor of the complainant, that the entire thing constituted a valid trade-mark; with additional damages and costs.¹

§ 704. The Court of Douai, in the case of *C . . . v. Veuve* (widow) *Humbert*, held, that a special denomination such as “Chicorée au Mouchoir,” with the enrolment of a handkerchief about the packet, and the name and the address of the fabricant, constitute, in the whole, a trade-mark protected by the law of 23 June, 1857. Said article enumerates some of the signs most ordinarily employed as a mark; but that enumeration is not limitative, for every sign, or symbol, from the instant that it is characteristic, special, and new, can constitute a mark. Inasmuch as the dame Annette Lervillé, — widow Humbert, — manufacturer at Lille, under the name of Lervillé, adopted as an arbitrary emblem the same sign, “Chicorée au Mouchoir” (with similar details), which emblem simulated a white pocket-handkerchief, in which was her name and address, her act was fraudulent, as there was a manifest intention to deceive the public and induce confusion.²

§ 705. The Court of Nîmes, in 1894 (*Legrès v. Iatowski*), had this case: The inventor of a powder, to be used for the

¹ 42 Annales, 126 [1896].

² 34 Annales, 34 [1889].

complexion, and called by him "Kabiline," had registered it as a trade-mark. The label represented a woman in Kabyle costume horizontal to the capital letter L, which initial letter was a prominent feature. The defendant had a mark for a similar product composed of the word "Bengaline," and representing a woman standing up, holding a piece of stiff material with the letter L in a slightly incorrect form thereon, but having the same general aspect, etc. etc. Defendant was restrained. 200 fr. damages.¹

¹ 42 Annales, 101 [1896].

CHAPTER II.

SYMBOLS NOT DEEMED VALID.

- § 706. Illustrations of marks not deemed valid.
- § 707. "Goodyear R. Co.," — "Cigar-Makers' Union," etc.
- § 708. Jaegar Sanitary Woolen System Co.
- § 709. Singer Manufacturing Co. v. June, etc.
- § 710. No valid trade-mark in materials.
- § 711. "Astral," "Kaiser."
- § 712. Treaty of 1871 with Germany, etc.
- § 713. Uncertainty of description, etc., bewildering to courts.
- § 714. "Green Mountain," for grapes.
- § 715. Original name that has become public property.
- § 716. "Old Sleuth Library."
- § 717. "Savon de Thridace."
- § 718. Mere geographical name cannot constitute trade-mark.

§ 706. "INSTANTANEOUS" is not a valid trade-mark for a preparation of tapioca adapted for immediate use without soaking.¹ — The term "Black Package Tea" is not such a distinctive appellation as will entitle the one first adopting it to its exclusive use in business, since it manifestly has reference either to the quality of the article, or the color of the package in which it is sold.² — An invented word cannot be registered as a trade-mark if it is intended to be descriptive.³ — The words "Yorkshire Relish," by themselves, having only been used on packing-cases containing bottles of sauce, and with nothing to indicate that the words were used as a trade-mark, or otherwise than as a description of the contents of the cases, *held*, that the words had not been used as a trade-

¹ Bennet v. McKinley, 65 F. 505 ; 13 C. C. A. 25.

² Fischer v. Blank, 33 N. E. 1040; 138 N. Y. 244.

³ In re Talbot's Trade-Mark, 8 Rep. 149. (Re Meyerstein's Trade-Mark, 43 Ch. D. 604, followed.)

mark.¹ — The plaintiff made corsets, which he called “Ball’s Health-preserving Corset.” Defendant called his corsets “Schilling’s Health-preserving Corset.” *Held*, no exclusive claim to the words “health-preserving.” Labels and boxes of parties differed.² — One is not entitled to a trade-mark for a certain class of goods, — used for *some only* of the articles in the class, although he may in fact manufacture and sell other articles of the same class unmarked.³ — “International Banking Company” is a term not capable of exclusive appropriation by a partnership as a firm name, or a trade-mark, for it is a generic term, descriptive of a class of business.⁴ — “Sarsaparilla and Iron” is not valid, being generic.⁵ — A valid trade-mark cannot be acquired for a word previously applied to same goods; for it does not indicate origin, manufacture, or ownership, but mere quality.⁶ — “Taffy Tolu,” for chewing-gum, is descriptive rather than indicative of its origin.⁷ — The word “Imperial” is so far designative of quality as to be incapable of adoption as a trade-mark for beer.⁸ — The words “Indurated Fibre,” as applied to wares made of wood-pulp, which has been condensed and subjected to baths in linseed oil and resin, and baked, designate wood fibre which has been subjected to a hardening process, and refer to ingredients, quality, and characteristics, and are not so arbitrary as to authorize a preliminary injunction to protect them as a trade-mark.⁹ — Acid Phosphate is a mere medical description.¹⁰ — When the article made was theretofore

¹ Powell v. Birmingham Vinegar Co. (No. 1), 6 Reports, 52 App.

² Ball v. Siegel, 166 Ill. 137.

³ Hargreave v. Freeman [1891], 3 Ch. 39. See also Rolander v. Peterson, 136 Ill. 215; 26 N. E. 603 (*infra*).

⁴ Affirming 48 Hun, 48; Kohler v. Sanders, 25 N. E. 235; 122 N. Y. 65.

⁵ Schmidt v. Brieg, 35 P. 623; 100 Cal. 672; Same v. McEwen, 35 P. 854; Same v. Steinke, Id. 855; Same v. Crystal Soda Water Co., Id.; Same v. Hake, Id.; Same v. Liberty Soda Works Co., Id. 1856.

⁶ 46 F. 16; Columbia Mill Co. v. Alcorn, 14 S. Ct. 151; 150 U. S. 460.

⁷ Colgan v. Danheiser, 35 F. 150.

⁸ (Showalter, C. J., dissenting.) Beadleston & Woerz v. Cooke Brewing Co., 20 C. C. A. 405.

⁹ Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co., 37 F. 695.

¹⁰ Rumford Chemical Works v. Muth, 35 F. 524.

unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all have a right to so designate it.¹ — The word “Tycoon,” for tea, is old, and therefore not valid.² — The letters “L. L.,” placed on sheetings, which only indicate grade, class, or quality, and not origin, ownership, or manufacture, are not a trade-mark.³ — The plaintiffs’ assignor obtained a patent for an improvement in sewing-machines, the frame being in the form of the letter “G,” and design-letters were also issued for the same form. *Held*: No trade-mark could be acquired for such form.⁴ — The words “Liver Medicine,” being merely descriptive, are not a trade-mark.⁵ — The words “Svenska Snusmaganiset,” meaning Swedish Snuff Store, are merely descriptive of business, and not a trade-mark, as against other Swedes engaged in the snuff business.⁶ — The word “Satinine” is a descriptive word referring to the character and quality of goods, such as starch, glue, perfumery, etc., to which it is applied, and is not an invented word registrable under the English Act of 1888, § 10.⁷

§ 707. The name of Goodyear Rubber Company is not capable of exclusive appropriation, it being a mere indication of a class of goods.⁸ — The words “Microbe Killer” do not constitute a trade-mark. They are common English words of fixed meaning.⁹ — Where a voluntary association of cigar-makers, which puts no goods on the market, adopts a name to distinguish cigars made by any of them, but has not applied the name to any commodity of which said association is the

¹ Leclanche Battery Co. v. Western Electric Co., 21 F. 538; 23 Id. 276.

² Corbin v. Gould, 10 S. Ct. 312; 133 U. S. 308.

³ Lawrence Manuf’g Co. v. Tennessee Manuf’g Co., 138 U. S. 537 (L. ed. 34, 997).

⁴ Wilcox & Gibbs Sewing-Machine Co. v. Kruse-Murphy Manuf’g Co., 14 Daly, 116; affirmed, 23 N. E. 1146; 118 N. Y. 677.

⁵ C. F. Simmons Co. v. Mansfield Drug Co. (Tenn.), 23 S. W. 165.

⁶ Bolander v. Peterson (Ill.), 26 N. E. 603; 136 Ill. 215.

⁷ In re Meyerstein’s Trade-Mark, 43 Ch. D. 604.

⁸ Goodyear’s India Rubber Glove Manuf’g Co. et al. v. The Goodyear Rubber Co., 128 U. S. 598 (L. ed. 32, 535).

⁹ Auff v. Radam (Tex.), 14 S. W. 164; 77 Tex. 530.

owner, or in which it trades, and which is in the market with the name attached, it acquires no trade-mark in the name.¹ — The Cigar-Makers' Union, having many thousand members, adopted a symbol, or device, to be used by any members on boxes of cigars made by them ; such device not indicating by what persons the cigars were made, but only that they are made by some member of said union, the right to the device belonging equally to any of the members, and continuing only while the person remains a member. *Held*, not a legal trade-mark.²

§ 708. The plaintiff claimed a trade-mark on certain words on garments made by him by reason of a concession made to him by the inventor of the articles. The inventor had never made such garments, nor had he been a vendor of such garments with such words attached. *Held*, that the inventor had no trade-mark.³

§ 709. The name which is given to a patented device to distinguish it as a patented article from others of the same nature, is not, during the life of the patent, properly speaking, a trade-mark. It designates nothing excepting that the structure has a definite character, which was patented, and indicates nothing in regard to the character of the workmanship, or of the person by whom it was manufactured. A trade-mark is something different from the article which the mark designates (*Fairbanks v. Jacobus*, 14 Blatch. 337).⁴ — One so using name which has become the generic name of patented article, on which the patent has expired, must adopt such precautions as will protect the property of others and prevent injury to the public interests, if by so doing no substantial restriction is imposed on the freedom of use ; and the addition of other matters will not absolve him from a charge of attempting to deceive the public in the sale of the patented article.⁵

¹ *Schneider v. Williams* (N. J.), 14 A. 812.

² *Cigar-Makers' Protective Union v. Conhaim* (Minn.), 41 N. W. 943 ; 40 Minn. 243.

³ *Jaegar's Sanitary Woolen System Co. v. Le Boutillier*, 47 Hun, 521.

⁴ *Per Curiam* in *Adee v. Peck Brothers & Co.*, 37 F. 209.

⁵ *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169 ; 41 L. ed. 118 ; 75 Off. Gaz. 1703 ; 16 Sup. Ct. Rep. 1002.

§ 710. Materials are not the subject of appropriation as a trade-mark.¹ — There is no valid trade-mark in a piece of tin as a tag for tobacco, regardless of its color, shape, or inscription, as this is one of the common metals in use by the public for a large variety of purposes.² — Nor is “Tin Tag” or “Wood Tag” a trade-mark.³ — There is no right to the use of material substances on which a word, figures, or emblems, may be impressed or engraved.⁴ — A patent monopoly cannot be extended under guise of trade-mark.⁵ — Nor can there be a trade-mark in a peculiar method of arranging soap.⁶ — Nor for chewing-gum for *form* of sticks, or the shape or decoration of boxes; nor for arrangement of gum in the same.⁷ — Nor in a method of bronzing horse-shoe nails.⁸

§ 711. Nor can there be a trade-mark in an oil-burning lamp called the “Astral,” such a lamp having long been used.⁹ — The word “Kaiser” is not a trade-mark, as others had previously acquired and exercised the right to use it for mere description. Long before complainant adopted the word, a number of springs of mineral waters bore the name as a prefix in different parts of Europe.¹⁰ — As a large tract of land in which there are many coal mines, owned and operated by different persons, was long known and recognized as “Sonman Survey,” it having a village post-office, telegraph office, and a railroad station, the name “Sonman” cannot be used as a trade-mark or trade-name for coal.¹¹ — The name “Rosendale Cement” cannot be a trade-mark, for all cement manufacturers in Rosendale may rightfully so call their product. There cannot be any trade-mark in the name of a place.¹² — The word “Hygienic,”

¹ Lorillard *v.* Pride, 28 F. 434.

² Ibid.

³ Ibid. ⁴ Ibid.

⁵ Ibid.

⁶ Davis *v.* Davis, 27 F. 490.

⁷ Adams *v.* Heisel, 31 F. 279.

⁸ Putnam Nail Co. *v.* Bennet *et al.*, 43 F. 800. See also 59 F. 909, and 8 C. C. A. 362.

⁹ Pratt's Mfg. Co. *v.* Astral Refining Co., etc., 27 F. 492.

¹⁰ Luyties *et al.* *v.* Hollendeer *et al.*, 30 F. 632. (See also Kaiserbrauerie, Beck & Co. *v.* J. & P. Baltz Brewing Co., 71 F. 695, and 20 C. C. A. 402.)

¹¹ Appeal of Laughman (Pa.), 18 A. 415; 24 W. N. C. 465.

¹² New York & R. Cement Co. *v.* Coplay Cement Co., 45 F. 212.

as applied to underwear, is not a trade-mark.¹ — In 1873, complainant used a name on a small shipment of flour, and in 1884, the defendants used the same name, continuing the use for seven years. The use by complainant was so inconsiderable that a registry of the same as a trade-mark could not confer a right on the complainant. The complainant's predecessors, flour dealers, in 1873, furnished two hundred and twenty barrels of flour for export to Venezuela, branding the barrels with the name "La Venezalano," and that seems to be the only occasion on which the trade-mark was used on behalf of complainant.² — The words "Iron Bitters," being an indication of the article so called, cannot be a trade-mark.³ — The *intention* to adopt a trade-mark, and the sale of a few dozen bottles of a medicinal preparation with written labels affixed bearing a name different from that previously used for such preparation, does not amount to use in such circumstances as to publicity, and such length of use as to show an intention to adopt the written words as a trade-mark.⁴ — Although registration of a trade-mark, under the Act of March 3, 1881, may not prevent the adoption of another device as a common-law trade-mark in domestic markets, such registration may be evidence in a suit to restrain an infringement of such common-law trade-mark to show what complainant really claimed.⁵

§ 712. Registration, under Act of 1881, is evidence of specific claim. The essential feature described a representation of a red anchor in an oval space. That was not proof of an intention to adopt a trade-mark consisting of the word "Anchor," and the symbol of an anchor, irrespective of color and surroundings. The treaty of 1871, between the United States and Germany (Article 17; 17 St. 931), which provides

¹ Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 60 F. 622; 65 F. 424. — Note: The word "Hygienique" as applied to suspenders. See Bailly v. Nashawanna Mfg. Co., 10 N. Y. S. 224.

² Brewer v. Boulton, 58 F. 888; (C. C. A.) 7 C. C. A. 567.

³ Brown Chem. Co. v. Stearns & Co., 37 F. 360. See Brown Chem. Co. v. Meyer *et al.*, 139 U. S. 540 (L. ed. 35, 247).

⁴ Kohler Mfg. Co. v. Beshore, 53 F. 262; 59 F. 572; 8 C. C. A. 215.

⁵ Richter v. Reynolds *et al.*, 17 U. S. App., affirming 52 F. 455.

that with regard to the marks of labels on goods, or of their packages, the citizens of Germany shall enjoy in the United States the same protection as native citizens, does not give to a citizen of Germany who has acquired the right to a trade-mark in that country a similar right to the trade-mark in the United States.¹

§ 713. Uncertainty of description, and misconception of the matters that are calculated to make up essentials of a valid trade-mark, are at times bewildering to courts. Coxe, J., truly said in one case: "The courts will have time for little else, if they undertake to meddle with . . . the color and size of the wrapping-paper and boxes in which a shop-keeper displays his wares. Trade should not be hampered by vexatious restrictions in matters apparently so trivial."²

§ 714. "Green Mountain" was rejected as a trade-mark for grapes, it being a mere geographical name.³

§ 715. On expiration of a patent under which was manufactured kitchen ware described as "Granite," the public has the right to use that name; and the manufacturer is not entitled to the exclusive use of it.⁴— When a medicinal preparation, not patented, has come to be known by the name of the original compounder, another person engaged in the manufacture cannot appropriate the name to his exclusive use.⁵— The purchaser of a firm name has no right to use the same in such a manner as would expose to liability an individual whose name is part of, or constitutes the firm name.⁶

§ 716. The publisher of a series of stories entitled "Old Sleuth Library," and purporting to relate the adventures of a detective called "Old Sleuth," is not entitled to exclusive use of the word "Sleuth" in the title of stories about detectives.⁷

¹ 8 C. C. A. *supra*.

² Philadelphia Novelty Co. v. Rouss, 40 F. 585. See also Same v. Blakeley Novelty Co., Id. 588. Bill dismissed on preceding case. (See also 39 F. 273.)

³ Hoyt *et al.* v. J. T. Lovett Co., 71 F. 173; 17 C. C. A. 652.

⁴ St. Louis Stamping Co. v. Piper (Sup.), 33 N. S. 443; 12 Misc. Rep. 270.

⁵ Watkins v. Lawdon (Minn.), 54 N. W. 193.

⁶ Chesterman v. Seeley (Com. Pl.), 18 Pa. Co. Ct. R. 631; 5 Pa. Dist. R. 757.

⁷ Munro v. Fousey, 29 N. E. 9; 129 N. Y. 38; Id. 10 N. E. 129; 13 N. Y. S. 79, 81, reversed.

§ 717. In the Court of Paris, 1885 (*Rheus & Co. v. Javal & Parquet*), plaintiffs were manufacturers and vendors of soap to which they had given the name of "Savon de Thridace." It was said in the Tribunal below that inasmuch as the word "Thridace" is not the appellation of a person nor a name of fancy, created without necessity, but is the name given in pharmacy to the juice of a certain pottage herb (*suc de laitue*), which product is in the Codex, which gives the formula of a preparation of a syrup of Thridace, the denomination cannot be deemed arbitrary, susceptible of a private right as applied to soap. Judgment was against the plaintiffs. On appeal, said judgment was affirmed.¹

§ 718. A mere geographical name cannot constitute a trade-mark. In 1810, one B. began the manufacture of mustard in Lexington, Kentucky, which became widely known as "Lexington Mustard." After some years plaintiff purchased the business, and, in 1877, removed it to Louisville. Prior to that time the label described the goods as "Burrowe's Mustard, Lexington, Ky.," which was changed to "Burrowe's Lexington Mustard," giving the address of the manufacturer as Louisville. Defendant began to make mustard in Lexington, in 1873, calling it "Metcalf's Improved Lexington Kentucky Mustard," and, in 1877, "Metcalf's Lexington Kentucky Mustard." *Held*, that where it is uncertain whether a geographical word is used as an address, or as the name of a manufactured article, and it is uncertain which, of two, first used it in the last-named way, neither party can appropriate the word to his exclusive use as a trade-mark.²

¹ 31 *Annales*, 74.

² *Metcalf v. Brand* (Ky.), 5 S. W. 773.

CHAPTER III.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS.

- § 719. Unfair competition in business explained and defined.
- § 720. "Royal," not infringed by "Coral," etc.
- § 721. Imitations of bottles, signs, cuts, etc., enjoined.
- § 722. Color of labels, etc., used to deceive.
- § 723. Misuse of trade-names.
- § 724. Unfair competition by misuse of trade-names.
- § 725. Trade-names protected.
- § 726. Name of orchestra not assignable.
- § 727. "Blue Lick Water" case.
- § 728. Misuse of one's own name.
- § 729. "Portland Stove" case.
- § 730. "Le Page Co." case. (Cement.)
- § 731. "Draper Oiler Co." case.
- § 732. "Higgins' Soap Co.," "Boston Rubber Co.," etc., etc.
- § 733. "Fish Bros. & Co.'s Wagons" case.
- § 734. "The Sun Life Assurance Co. of Canada" case.

§ 719. *Unfair Competition in Business.* This matter is explained and defined in Browne on Trade-Marks, § 43. Since the introduction of the term *Concurrence déloyale*, anglicized as above, it has generally been adopted by the courts. It includes multifarious cases that are not strictly trade-mark matters, and are beyond recognized technical rules, but which are deemed worthy of protection. The following decisions afford illustration of the doctrine of *Unfair Competition*.

§ 720. In the case of the *Royal Baking Powder Co. v. Davis*, the use of the phrase "Coral Baking Powder," in connection with the color of the label, and the general appearance of the cans bearing the label, are calculated to deceive the public, although in themselves they are no infringement of the trade-mark, nevertheless they were enjoined;¹ — and in the

¹ 26 F. 293. See also *C. F. Simmons Med. Co. et al. v. Simmons*, 81 F. 163.

Carlisle Soap Co. v. Thompson, the imitation of the packages, and the color, design, style, and lettering were enjoined;¹— and so in *Fleischman et al. v. Starkey*, although it was held that the color alone was not a trade-mark.²

§ 721. In *Cook & Barkheimer Co. v. Ross*, complainant sold a brand of whiskey bottled by it at the distillery in a bottle of peculiar shape devised by it, and thereby engaging favor in the market, which brand, through extensive advertising, came to be relied on as indicating complainant's bottling. Defendants, who for some time had bottled and sold the same whiskey, adopted a bottle precisely like complainant's. *Held*, that the use of such bottle was Unfair Competition, and should be restrained.³— The defendant, under the name of "Young," engaged in a business similar to that done by the plaintiff, under the corporate name of "De Youngs," established himself in the same street near the plaintiff, used similar business signs and advertising devices, and displayed the name "The Youngs," so that it differed from that of the plaintiff only in the prefix "The." *Held*, that such use of the name and devices should be enjoined.⁴— A device bearing the names of the proprietors of a patent medicine, the proprietors' place of business, the names of various diseases, etc., and consisting chiefly of a letter of the alphabet nine times repeated, arranged in three vertical columns, separated by lines or bars, so as to form three B's each, this letter being the initial of the three words forming the name of the medicine, generic words belonging to the science, the whole so printed on the wrapper that, when it is placed around the package of the goods, every one of the three sides were present to view, one of these combinations of B's is a *label* which the court will protect against infringement.⁵— Although the words "Kidney & Liver Bitters" are not the subject of a trade-mark, being merely descriptive, yet the name of the maker, and every

¹ 25 F. 625.

² 25 Id. 127.

³ 73 F. 203.

⁴ *De Young v. Jung*, 27 N. Y. S. 370; 7 Misc. Rep. 56.

⁵ *Foster v. Blood Balm Co. (Ga.)*, 3 S. E. 284.

device in the form and contexts of a label and wrapper, to denote that the goods are made by him, are proper subjects for protection.¹ — Although the plaintiff cannot acquire the exclusive right to use the word “American” as descriptive of beer, yet it is entitled to an injunction when an imitation of its sign, bearing that word conspicuously, so closely resembles the company’s in size and colored lettering as to deceive the public.² — The plaintiff, the name of which is known to the trade as the “Tuerk Water Motor Co.,” is entitled to enjoin defendants, the members of the firm of the “Tuerk Water Motor Co.,” from using such firm name, or cuts and printed matter in advertisements used by it prior to the formation of the defendants’ firm, or any substituted imitation thereof, the adoption whereof by the defendants having been not only with the purpose of representing to the public that the motors sold by the defendants were those of the plaintiff, but being calculated to have, and having that result with ordinary purchasers, in the exercise of ordinary care and caution.³ — In imitating distinguishing marks on stoves made by another, with the purpose and result of palming them off as the manufacture of such other, the imitator will be enjoined, irrespective of the question of trade-mark.⁴

§ 722. Plaintiff’s label on packages of the same size, shape, material, and position, printed in the same colors, with some alterations, — where, on the plaintiff’s label there was a progressive increase in the size of letters, there was the same on the defendant’s label; the sentences and picture on the latter were very similar to those on the former, and in some instances the same; that the word “Germ” used by defendant was similar in sound and appearance to the word “Germea” carried by the plaintiff; that the words “Trade-Mark Registered,” in similar colors, type, and position, though defendant had not registered any trade-mark at the time the action was brought, while plaintiff’s labels were registered

¹ *Spieker v. Lash* (Cal.), 36 P. 362.

² *American Brewing Co. v. St. Louis Brewing Co.*, 47 Mo. App. 14.

³ *Tuerk Hydraulic Power Co. v. Tuerk* (Sup.), 36 N. Y. S. 384; 92 Hun, 65.

⁴ *Amos H. Van Horn v. Crogan* (N. J. Ch.), 28 A. 788.

several years before the infringement began. It further appeared that the person who prepared defendant's package and labels had those of plaintiff before him; thus proving actual intent to deceive. *Held*, that injunction should issue.¹

§ 723. The trade-names "A. N. Hoxie's Mineral Soap" and "A. N. Hoxie's Pumice Soap" are assignable, and if the assignee uses them to denote soap made according to the formulas of A. N. Hoxie, and to denote that they are made by said Hoxie, he may maintain a bill in equity to restrain an infringement. Hoxie subsequently issued a circular virtually representing himself as successor to the business, the goodwill of which he had sold, and also asserted a right to the so-called trade-mark. This was in excess of what he could lawfully do.²—A bill was filed to enjoin defendant from manufacturing and selling certain medicines under the names of "Dr. Spencer's Queen of Pain," and "Spinal Paste or Salt Rheum Cure," from using the trade-names, and from libelling the plaintiff. The defendant had taken from administrator said medicines. The question was whether plaintiff had acquired, as against the defendant, the exclusive right to the trade-names formerly used by Dr. Spencer. In *Chadwick v. Covell*, it was decided that defendant had no such right. His only title from the representatives of Dr. Spencer accrued more than four years and a half after the doctor's death. He was not the purchaser of the business, which was wound up several years before he acquired title, and plaintiff did not buy the business.³

§ 724. Courts have frequently had occasion to investigate complaints of unfair competition, when the same arose from the wrongful use of trade-names, as contra-distinguished from trade-marks. The following citations afford illustrations under this head. *La République Française et al. v. Schultz* is a suit to enjoin the word "Vichy," in designating mineral waters. It

¹ *Sperry & Co. v. Percival Milling Co.* (Cal.), 22 P. 651; 81 Cal. 252.

² *Hoxie v. Chaney*, 143 Mass. 592.

³ *Covell v. Chadwick*, 153 Mass. 263. See authorities cited, including *Kiua v. Johnson*, 100 U. S. 617, 620.—No business or goodwill is shown, to carry property in a trade-mark.

also involves the question of right to use a geographical name in connection with mineral waters derived from springs in the same locality as that of Vichy, by persons owning such springs. Complainants claim that the word "Vichy" is not a trade-mark, but is a trade-name, and as such should be protected on principles analogous to those applied to trade-marks. Although defendant claims that the word is a trade-mark, much of his argument proceeds on the theory that it is not. This was a question of a right to redress. The court said that: "In the industrial property treaty of 1883, these three expressions are used, '*Marque de fabrique*' (trade-mark), '*Marque de Commerce*' (trade and commerce mark), and '*Nom Commercial*,' (trade and commercial name). The treaty provides that every trade-mark, or commerce-mark regularly deposited in the country of origin, shall be admitted to deposit, and so protected in all the other countries of the Union. (25 Stat., 1376, Art. 6.) And the first protocol, on page 1380, is as follows: Paragraph 1, of Article 6, is to be understood in the sense that no trade or commercial mark shall be excluded from protection in one of the States of the Union [international], by the mere fact that it may not satisfy, in respect to the signs composing it, the conditions of the laws of this State, provided that it does satisfy in that regard the laws of the country of origin, and that it has been in the latter country duly deposited," etc.¹*

§ 725. The principle that nobody has any right to represent his goods as the goods of somebody else has no limit as regards name, origin, honesty of manufacture, or sale. Thus a trader whose goods have acquired a reputation under a particular name can restrain the user of that name in any way whatever by a rival trader in connection with the latter's own goods; even though that reputation has been acquired by the exertions or enterprise of the rival trader, as an importer or vendor, etc.² — The words "Mechanics' Store," as a trade-

¹ *La République Française et al. v. Schultz*, 57 F. 37.

* This case erroneously assumes that the United States was an active member of said union. *Browne on Trade-Marks*, § 85, is cited by court with approbation.

² *Reddoway v. Benham* [1896], A. C. 199, 204.

name, may be protected.¹—The phrase “New York Dental Rooms” may become a trade-name to designate the business of a dentist doing business in St. Louis.²

§ 726. A trade-name given to an orchestra by its founder, is not assignable. It is personal, and rests on the reputation of the musician. It would be a fraud on the public to assign it.³

§ 727. The name “Blue Lick Water,” having reputably been used for more than a century to designate the water of certain springs in Nicholas County, and known by that name ever since their first discovery, is a good trade-name, in the hands of lessees of said springs, as against owners of an artesian well near Louisville.⁴ *

§ 728. A corporation assumed the name of an employé to get the trade of a rival of the same name.⁵—One entering into competition with another of the same name, who has an old and established business, is bound to distinguish his goods to prevent confusion. He is not entitled to use the same name, whether with his given name or his initials.⁶—The right of a person to use his own name in his own business does not authorize him to lend or give his name to a corporation for the purpose of engaging in a business which has been conducted by others, under precisely the same name.⁷—A person who so lends to a corporation the right to his name, does not thereby lose the right afterwards to use it in his own business.⁸

§ 729. The word “Portland,” having been used for a number of years by the plaintiff to distinguish stoves, etc., a rival

¹ *Weinstock, L. & Co. v. Marks*, 109 Cal. 529; 3 L. R. A. 182; 42 Pacific, 142; Natl. Corp. Rpt. 341.

² *Saunders v. Utt*, 16 Mo. App. 322; *Saunders v. Jacob*, 20 Mo. App. 96.

³ *Messer v. The Fadettes* (Mass.), 45 N. E. 407.

⁴ *Parkland Hill Blue Lick Water Co. v. Hawkins* (Ky.), 26 S. W. 389.

* The proprietary rights in names under which articles are named, as analogous to trade-marks, considered by Grafton Dulaney Cushing, 4 Har. Law Rev. 321.

⁵ *City of Carlsbad v. Schultz*, 78 F. 469.

⁶ *Walter Baker & Co. v. Saunders*, 80 F. 887.

⁷ *De Long v. De Long Hook & Eye Co.* (Sup.), 32 N. Y. S. 203; 10 Misc. Rep. 577.

⁸ *De Long v. De Long Hook & Eye Co.* (Sup.), 39 N. Y. S. 903; 7 App. Div. 33.

dealer was prohibited from advertising and selling his stoves under a similar name.¹

§ 730. The *LePage Co. v. Russia Cement Co.*, in the first circuit, *held*, as follows: The rights of original corporation are not affected by the fact that, after retiring therefrom, LePage obtained a patent on an alleged improvement over his original glue, and that the patent laws required notice to be stamped on each package of the patented article.² He assigned the patent to the LePage Co., plaintiff. That company claims that, as the owner of a patent, its privilege and duty is so to stamp its goods. Inasmuch as the patent was applied for, after the rights of the Russia Cement Co. accrued, it was estopped.³

(The Court of Appeal was composed of Gray, Cir.-Justice, and Colt and Putnam, Cir.-Judges. The last-named judge said, *inter alia*: "The method of stating that the article is patented was such as to aggravate the offence of the LePage Co. instead of excusing it. The face of William N. LePage, a fac-simile, and the words 'William N. LePage is the original inventor of preserved liquid fish glue,' etc.; and at the close follows: 'Improved process pat. Oct. 26, 1886.'") (This was an *action* for damages for the wrongful use of the name "LePage." Verdict of jury, \$8,000.) The record shows that, subsequently to the state of facts shown in *Cement Co. v. LePage*, a corporation was formed in January, 1887, being the defendant below, taking first the name of LePage Liquid Glue and Cement Company. The original corporators were William N. LePage, his wife, and his counsel.⁴ The court cited many cases to forcibly illustrate the underlying principle.—In *Seixo v. Provezende*, Lord Chancellor Cranworth said that "the actual physical resemblance of the two marks is not the sole question for consideration; but that the adoption by a rival trader of *any mark* which will cause his goods to bear the same name in the market is as much a

¹ *Amos H. Van Horn v. Crogan* (N. J. Ch.), 28 A. 788.

² R. S. § 4900.

³ 51 F. 291.

⁴ 147 Mass. 206; 17 N. E. Rep. 304.

violation as an actual copy.”¹ — The same doctrine is that of *Orr Ewing & Co. v. Johnston & Co.*² Lord Selborne, Lord Chancellor, said in the House of Lords that the mere appearance of the two tickets could not lead any one to mistake one for the other. It might easily happen that they might be taken by natives of Aden or India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. If many such persons took notice of the differences between the two labels it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. — The plaintiff in error claims that the letter from the attorney of the Russia Cement Co., that the use of the name is not likely to do them harm enough in the long run to make it worth while to bring another suit, *operates as an estoppel*; but the court said that in equity, coupled with evidence of *laches*, it might have some effect in accounting, but in a suit at law it has no effect whatever.³

§ 731. The case of *Noera v. H. A. Williams' Manufacturing Co.*, a bill to enjoin N. from using the word “Draper” as applied to oilers (other than those made by the complainant corporation). Draper & Co. had made hardware ever since 1833, and had put the name “Draper” on different articles of their make. About 1880, they began to make oilers and put their name on them to denote superior excellence. Before and since, inferior oilers resembling the genuine article, and called “Draper” oilers and “Star” oilers were in the market. From 1880 to 1884, one A. bought some cans from Draper & Co., manufactured cans resembling theirs, and marked them “Draper Oiler Co.” Up to 1887, Draper & Co. made all the oilers sold by Noera under the name “Draper Oiler Co.” N. began to have the less important parts made elsewhere, and the oilers were completed by D. & Co. In selling oilers N. packed them in boxes labelled “Draper Steel Oilers.” In

¹ L. R. 1 Ch. App. 192, 196; 14 L. T. (N. S.) 314; 12 Jur. (N. S.) 215.

² 13 Ch. D. 463.

³ 51 F. 491; 2 C. C. A. 555.

1890, N. sold out to the complainant and went into its employ. "Draper," having gained a certain commercial value, as applied to oilers, he then attempted to steal a part of its reputation. D. & Co. ceased to use "Draper Oiler Co.," at the demand of one Alden, — for the sake of peace, — perhaps unduly impressed by the suggestion that Alden had a copyright. The word "Draper" certainly did not become public property. Injunction denied as to Williams' Manufacturing Co. *et al.*; but Noera enjoined.¹

§ 732. One Higgins sold to the plaintiff, Charles H. Higgins Co., a soap business long established at Brooklyn, with the good-will, labels, and trade-marks, reserving the right to engage in the same business. The soap made by said company was extensively advertised at large expense, and was known to the trade as "Higgins' Soap," and plaintiff was known as its manufacturer, and was to some extent called the "Higgins' Soap Company." Among the labels sold were "Higgins" and "Higgins' Soap." Thereafter, Higgins with others, including members of his family, organized a company to manufacture soap at Brooklyn under the name "Higgins' Soap Company;" and within four months thereafter, that company received over twenty-eight business letters intended for the other corporation. *Held*, that though the new company took its name from the family name of its organizers, and adopted it in good faith, without design to acquire plaintiff's trade, it would be restrained from using it.² — In another case, a petition stated that the adoption and use by defendant of plaintiff's corporate name was with the fraudulent intent of appropriating plaintiff's trade, that the public was deceived, and plaintiff's trade diverted to defendant thereby. *Held*, a case for equitable relief.³ — The *Boston Rubber &c. Co. v. Boston Rubber Co.* involves the same principle. A certificate of incorporation was held to be conclusive that respondent's name was conferred by law; and because petitioner does not

¹ 158 Mass. 110.

² *Chas. S. Higgins' Co. v. Higgins' Soap Co.*, 39 N. E. 490; 144 N. Y. 402 (reversing 24 N. Y. S. 801).

³ *Plant Seed Co. v. Michel Plant & Seed Co.*, 23 Mo. App. 579.

show its right or interest it is not injured or put in jeopardy by the exercise of a franchise. The *younger* corporation cannot be restrained from using its corporate name.¹ — In *Converse v. Hood*, and the same against the Boston Rubber Co., it appeared that for thirty years the trade-name had been known, differing from its corporate name. A junior corporation of the same name was organized in 1878. It made the same goods, and in the same city. An objection was made to the use of the name by the junior company. *Held*, that corporate rights cannot be maintained by one individual stockholder against another. The second bill was brought by plaintiff as a stockholder in the Boston Rubber Co., and in behalf of all other stockholders who were not defendants, for the purpose of restraining acts injurious to stockholders. Bill shows no right to equitable relief, for that must be alleged by the corporation.²

§ 733. All the property, assets, and business of the firm of Fish Bros., Wagon Manufs., passed by successive changes to Fish Bros. & Co., thence into the hands of a receiver, and thence to the Fish Bros. Wagon Co. The Fish brothers remained in the business through all the successive changes, and became directors and officers of the new company, although the majority of stock was owned by others. During all this time the products were variously advertised under the trade-names "Fish Bros.," "Fish Wagons," "Fish Bros., Agents," "Fish Bros. & Company, Agents," and the picture of a fish with "Bros." or "Bros. & Co." on it. Several years after the organization of the company, the Fish brothers withdrew therefrom and set up on their own account, under the firm name of "Fish Bros. & Co." *Held*, in an action by the corporation against "Fish Bros. & Co.," that plaintiff owned the goodwill of the old business, including the right to use the fish symbols.³

§ 734. In June, 1893, the Sun Life Assurance Co. of Canada, which was duly incorporated in Canada, and had there carried on business for some years under that name, opened an

¹ 149 Mass. 436.

² 149 Mass. 471.

³ *Fish Bros. Wagon Co. v. La Belle Wagon Works* (Wis.), 52 N. W. 525.

office in the city of London. The Sun Life Assurance Co., which was established in England in 1810, its head office being in said city, asked for an injunction to restrain the Canadian company from carrying on in the United Kingdom of the business of life assurance, under the name of the Sun Life Assurance Company of Canada. *Held*, inasmuch as the mere user by the defendant company of its full name involved no mis-statement of fact, and was not a fraudulent user, the defendant was entitled to use its full corporate name, but the right did not extend to the use of "The Sun," or "The Sun Life," without the addition of the words "of Canada."¹

¹ 8 Reports, 125 ; Id. [1894], 1 Ch. 537.

CHAPTER IV.

ASSOCIATIONS, UNIONS, SUCCESSION, ETC.

- § 735. Statutes relative to use of trade-marks, names, etc.
- § 736. Protection by laws of Me., Mass., O., Ills., Wis., Ky., Neb.
- § 737. Protection to unincorporated associations.
- § 738. Label adopted by a union can be used by all its members.
- § 739. Punishment for forged imitations, or counterfeits.
- § 740. Label not libellous in case stated.
- § 741. Imitation of a trade-mark a misdemeanor in So. Dakota.
- § 742. Succession, priority, etc.
- § 743. One's own name, when assignable.
- § 744. Symbol "N & S" on cigars.

§ 735. ASSOCIATIONS, UNIONS, etc. — In many of the States there are statutes regarding the use of trade-marks, trade-names, and analogous matters by unincorporated companies and trades-unions; but it is not the province of this work to give more than examples of, and citations on these subjects.

§ 736. In Maine, the Rev. Stat. c. 39, §§ 37-43, in relation to the adoption and protection of the use of trade-marks, labels, etc., is extended to associations of working-men.¹ — In Massachusetts, the Pub. Stat. c. 203, §§ 63, 64, concerning the counterfeiting of prints, labels, stamps, and trade-marks, is amended so as to make the statute applicable to labor and trade associations.² — In Ohio, there is a provision for the protection of skilled labor, and for the registration of labels, etc.³ — In Illinois, there are general provisions for the adoption, and protection in the use of trade-marks, by persons, associations, and unions of working-men, and penalties for violations.⁴ — In Wisconsin, there are similar provisions by the Act of April

¹ Act Mch. 28, 1891. (Pub. Laws 1891, c. 114, p. 124.)

² Act of Mch. 19, 1890. (Acts 1890, c. 104, p. 65.)

³ Act of Apr. 2, 1890. (Laws 1890, p. 141.)

⁴ Act May 8, 1891. (Laws 1891, p. 202.)

16, 1891.¹ — In Kentucky, there is a provision authorizing the filing with the Secretary of State of copies of labels, marks, etc., adopted by unions or associations of working-men or women, and protecting the same.² — Nebraska has substantially the same provisions.³

§ 737. An unincorporated association of operatives who are employed by others in manufacturing a product, may adopt a device for designating the articles manufactured by themselves, and are entitled to equitable protection against fraudulent imitations, it appearing that goods marked with the label command a better price than others.⁴ The fact that one of the objects of such unincorporated association is to maintain fair wages for its members, and that it allows a device adopted to designate the products, is not presumed to be illegal.⁵ — A voluntary association of cigar-makers having issued to manufactories in which its members only are employed, or to a member who makes cigars on his own account, to indicate that the cigars bearing the labels are made solely by such member or members, and to distinguish them from other cigars, though such cigars are made in various manufactories by various workmen, and neither the workmen nor association have any proprietary interest in them, — yet such label is a trade-mark, within the meaning of Pen. Code N. Y. § 366, defining a trade-mark to be a mark to indicate the owner, maker, or seller, of an article of merchandise, and usually affixed to merchandise to denote that it was manufactured, etc., or otherwise prepared, and section 364, making it a misdemeanor to counterfeit a trade-mark, or to affix a counterfeited trade-mark to merchandise, etc.⁶

§ 738. A label adopted by the International Cigar-Makers' Union, to be pasted on boxes containing cigars made by members, is not a legal trade-mark, it not indicating by what per-

¹ Act Apr. 16, 1891. (Laws 1891, p. 353.)

² Act Apr. 16, 1890. (Pub. Acts 1889-1890), c. 823, p. 99.

³ Act Mch. 31, 1891. (Laws 1891, c. 15, p. 214.)

⁴ *Strasser v. Moonello*, 55 N. Y. Super. Ct. 197.

⁵ *Ibid.*

⁶ *People v. Fisher*, 3 N. Y. S. 786; 50 Hun, 552.

sons the cigars are made, but only that they are made by members of one of the local unions, the right to use it belonging equally to all members, and continuing only while they are members.¹ — The Cigar-Makers' International Union of America, a voluntary unincorporated association of workmen, organized "for promoting the mental, moral, and physical welfare of its members," but not engaged in the business of making or selling cigars, etc., is not a trader, and is not entitled to a trade-mark, either at common law or under Act U. S. July 8, 1870, which provides that a statement shall be recorded in the Patent Office, showing "the names of the parties applying for the registration, with their residences and places of business, and a description of the goods comprising the class" by which the trade-mark is to be appropriated.²

§ 739. Under the statute providing for the punishment of any person who shall vend goods, etc., on which, or in connection with which any forged imitation, or counterfeit label, trade-marks, etc., have been placed, affixed, or used, and intended to represent the said goods as the genuine goods or properties of any other person, it is not an indictable offence to use or counterfeit the label of a labor union, or organization not making or dealing in similar goods, indicating that the labor of members of such organization has entered into the manufacture of goods to which it is attached.³

§ 740. A statement on a label adopted by a cigar-makers' union that the cigars contained in the box are made by a member of such union which is opposed to "inferior, rat-shop, cooley, prison, or filthy tenement-house labor" does not deprive such label from protection against infringement on the ground that it is libellous.⁴ — Where a label, adopted in accordance with 80 Ohio Laws, 166, providing for the protection of labels adopted by labor unions, stated that the

¹ *Weemer v. Brayton* (Mass.), 25 N. E. 46 ; 152 Mass. 101.

² *McVey v. Brendel* (Pa. Sup.), 22 A. 912 ; 144 Pa. St. 235 ; 29 W. N. C. 1.

³ *State v. Berlinsheimer*, 62 Mo. App. 168.

⁴ *Perkins v. Heert*, 5 App. Div. 335 ; 39 N. Y. Supp. 223.

cigars on which it was placed, are the product of an organization opposed "to inferior, rat-shop, coolie, prison, and filthy tenement-house workmanship," it is not objectionable as against public policy.¹ — Said statute is constitutional.² — A complaint in an action brought by Louis Allen *et al.*, as "officers and members of Cigar-Makers' Protective Union, No. 98, of the State of Minnesota, a branch and member of the Cigar-Makers' International Union of America, composed of local Union Societies," etc., etc., shows a proprietary interest entitling them to maintain action.³ — In the Supreme Court of Michigan, May 28, 1897, was this case, *Supreme Lodge Knights of Pythias v. Improved Order Knights of Pythias et al.*, the sole question was whether defendants shall be enjoined from using the name "Improved Order Knights of Pythias." *Held*, members withdrawing from the "Knights of Pythias," and organizing an association on similar lines, may use the title K. of P. The court recited the history of schisms in other societies which have adopted, as a permanent part of their respective names, the name of the parent organization. No careful person could think that these two orders are identical, or that the similarity of names is calculated to mislead the ordinary run of mankind. A decree was entered dismissing complainants' bill.⁴

§ 741. The South Dakota Statute. Using a trade-mark of another with intention to deceive is a misdemeanor punishable by fine, or imprisonment, or both. The using of such trade-mark, after notification that it is a counterfeit, is similarly punishable.

§ 742. *Under the head of SUCCESSION*, there are many interesting cases. In the case of *P. Lorillard Co. v. Peper*, an assignment was traversed by defendant. The controverted fact of succession of complainant in business is not established by complainant. As to who is a "predecessor"

¹ Cigar-Makers' Protective Union, No. 4, *v. Lindner* (Com. Pl.), 2 Ohio N. P. 114; 3 Ohio Dec. 244.

² *Ibid.*

³ *Allen v. McCarthy* (Minn.), 34 N. W. 416. Act Mich. 7, 1890, Laws 1890, c. 153, 321.

⁴ 71 N. W. 470.

is a legal question. A "predecessor," in the common acceptation, is one who goes before or precedes another in a given state, position, or office, and does not necessarily express any relation of legal priority.¹—The firm of Probasco & Oakes manufactured and sold candles under the name of "Excel-sior Candles," but afterwards called their candles "Oakes' Candles." Oakes sold out to Probasco, including in the bill of sale the right to use this name. He then entered the employ of Probasco, and continued therein for several years, superintending the making of the candles, during which time Probasco devised and used a trade-mark consisting of two oak-trees with the words "Oakes' Candles" printed across them. Oakes subsequently quitted Probasco's service, and, several years later, Probasco sold the business, together with the right to use the trade-mark. *Held*, that as the trade-mark was used to denote candles made by the firm, and was not a guarantee that the candles were made by Oakes personally, the use thereof was not a fraud on the public, and the sale of the right thereto was valid. The bill of sale by Oakes to Probasco stipulated that the right to use the name "Oakes' Candles" should cease on a sale of the business to a stranger, and should then revert to Oakes; but the purchaser from Probasco was not aware of this condition. *Held*, that being a *bonâ-fide* purchaser he was not bound thereby.² As the *bonâ-fide* purchaser had good title to the trade-mark he could convey it to another, even though the latter had notice of the stipulation.³

§ 743. The fact that a trade-mark bears its owner's own name and portrait does not render it unassignable to another.⁴—Under a purchase from an assignee for the benefit of creditors, the purchaser acquired the right to use a lot of sacks and wrappers marked with the name of the assigning firm. *Held*, that this did not preclude a member from apply-

¹ Lorillard Co. v. Peper, 65 F. 597.

² Oakes v. Tonsmierre (C. C.), 49 F. 447.

³ Ibid.

⁴ Dr. S. A. Richmond Nervine Co. v. Richmond, 159 U. S. 293; 23 L. ed. 155; 16 Sup. Ct. Rep. 30.

ing its name to a corporation afterwards organized by him.¹ — An assignment of a business, with the debts and plant, includes trade-marks used in the business, and gives the assignee the exclusive right thereto.² — The right of one to use his name as a trade-mark, the words used in connection with his name, the words being words of common use, is a personal right, and does not pass to his assignee in bankruptcy.³ — The failure of an assignee of a trade-mark to show the assignment on his label will not prevent enforcement of his rights thereto, where the omission involved no fraud or false representation.⁴ One Magale, a wholesale dealer in “Monarch Whiskey,” stamped on the barrels above the brand of the manufacturers the brand Magale’s, so that when so stamped the brand was “Magale’s Monarch Whiskey.” The name of Magale gave the whiskey value, because of his general reputation for integrity. After his death, the successor to his business conducted it in Magale’s name. *Held*, that on such successor ceasing to do business, an assignment by him of such brand and trade-mark was against public policy and void.⁵

§ 744. *Frank v. Sleeper*⁶ was a case of infringement of a trade-mark by a symbol “N & S.” It is alleged that a cigar-dealer adopted the letters “N. S.,” to designate cigars of a certain style, and for a superior and uniform workmanship, and manufactured by him from a certain standard grade of tobacco; that he sold his business and with it assigned the trade-mark to plaintiff, who continued to sell the same cigars, which were also made exclusively for him by the same manufacturer; that labels on the cigar-boxes gave the location of the factory, and, after his purchase, the plaintiff’s name as successor to the business and trade-mark, with a notice that the “N. S.” brand, as originally manufactured, continued to be made by the same person for the plaintiff.

¹ Iowa Seed Co. v. Dorr, 70 Iowa, 481.

² Merry v. Hoopes (N. Y.), 18 N. E. 714.

³ Mattingly v. Stone (Ky.), 12 S. W. 467.

⁴ Royal Baking Powder Co. v. Raymond (C. C.), 70 F. 376.

⁵ Mayer v. Flanagan (Tex. Civ. App.), 34 S. W. 785.

⁶ 50 Mass. 583.

Defendant was enjoined, the decree reciting that the letters constituted a valid trade-mark to represent cigars of a certain and distinct kind, that it was assignable, and that the symbol did not indicate personal selection further than that it was the name of cigars of a certain size, quality, and shape.¹

¹ 150 Mass. 583.

CHAPTER V.

CONCURRENCE DÉLOYALE.

- § 745. "Crystal Champagne" case.
- § 746. Livery and color of coaches protected.
- § 747. Name of quarry stone protected.
- § 748. Name of "Roquefort" for cheese, distinctive.
- § 749. Wife's name borrowed, to continue business after partnership dissolved.
- § 750. Misuse of Numerals, to deceive.
- § 751. Ex-employé's rights protected, when honest.
- § 752. Ex-employé must preserve good faith.
- § 753. A vendor of good-will must act in good faith.
- § 754. Pommery wine case. One's name enjoined. Moët Name protected.
- § 755. Saint Quentin Cement.
- § 756. Conflicting Publications.
- § 757. Vichy water and that of Saint-Yorre.
- § 758. Owner of Mineral Springs may give to them genuine name of country of origin.
- § 759. "Modèles de Paris" case.
- § 760. Criminal prosecution to stop alleged unfair competition.
- § 761. Syndicate stops the selling of false medicines.
- § 762. False use of surname.
- § 763. When partner is considered legally in possession.
- § 764. Ex-wives cannot use, in business, names of former husbands.
- § 765. Unfair dealings in name of son.
- § 766. Professional syndicate suppresses fraud.
- § 767. Fraudulent breach of contract.

§ 745. THE Court of Cassation, in 1896, had the case of the *Société des eaux de St. Galmier v. Bertet*. The defendant, Bertet, a restaurateur, had delivered the water "Crystal-Champagne" to consumers who called for the water of St. Galmier. Considering that the water of the spring "Crystal Champagne" has, to a certain degree, the same hygienic properties of those of St. Galmier, and belong to the same neighborhood and make a part of the canton of that

name, *held*, that it is not unlawful competition in Bertet towards the *Société de St. Galmier*. B.'s labels on bottles and half bottles bore the words "Crystal Champagne Spring, Canton of St. Galmier;" and customers demanded the St. Galmier water, without designating one spring from another.¹

§ 746. The Court of Angers, in 1883, in *Compagnie des petites voitures v. Mabreux Bonget et al.*, *held*: a proprietor of carriages for hire has the right to interdict a rival from imitating the livery of his coachmen and the painting on his vehicles, which he has adopted to distinguish them and attract attention. It matters little that an attentive examination allows one to distinguish coaches of the two rivals, if confusion really exists, or is possible.²

§ 747. The Tribunal Civil of the Seine, in 1896, considered the case of *Standish v. Civet & Co.* The complainant was proprietor of certain quarries of stone for building purposes, in the territory of the commune of Morley (Meuse), at a place termed the "Forest of Morley," and set forth that the defendants were selling similar stone under the name adopted by complainant, the "Forest of Morley." He asked the Tribunal to enjoin his rivals from the use of that especial denomination. It was *held*, that inasmuch as bad faith is the necessary element of unfair competition, which in this case was not clearly established, yet there are circumstances which require the action asked for. There are certain characteristics of similarity in all the stone of the quarries of that region; not only in that portion of the woods reserved to Mr. Standish, but in all the surrounding woods under the common name of the commune. After a commercial usage generally adopted, one has the right to give to his products an indication of the origin of his stone in the special part of the commune where it is quarried; and others, although they have a right to use the name of the commune, may be prohibited from using the special designation adopted

¹ *Société des eaux de St. Galmier v. Bartet*, 42 *Annales*, 344.

² *Compagnie de petites voitures v. Mabreux, Bonget, Guibert & Lambourg*, 34 *Annales*, 14.

by him. It was ordered that Mr. Standish has the sole right to designate the stone extracted by him from quarries situate in the Forest of Morley by the words "Stone of the Forest of Morley." Defendants to pay 1000 fr. damages, and costs.^{1*}

§ 748. The Tribunal Civil of Millau, in 1896, had the case of "*Société des caves, etc., de Roquefort*" v. *Mercadier*. It is well known that the locality denominated Roquefort, situate in the old region of Millau, has acquired great distinction because of its products; it being generally acknowledged that the quality of the soil where the caves are sunken have certain characteristic conditions which create an unrivalled reputation for the cheeses produced from Roquefort. The defendant, a cheese-maker at Lestaing, inscribed at the head of his envelopes in his correspondence the words "Fromages de Roquefort," whereas he sold an inferior cheese produced from Lestaing. Enjoined, with costs.²

§ 749. In the Tribunal of Commerce of Aurillac, in 1895, the case of *Bois v. Lafon* was considered. The parties to the suit had been partners in business. In separating they had stipulated that each might re-establish himself, but should not take the title of successor to the old firm of Lafon & Bois. Bois took the name of Louis Lafon: Lafon took the firm name of Lafon-Bois (the maiden name of his wife was Bois). But, inasmuch as Lafon had not used her name in partnership, it was *held*, that such use would create confusion among customers, it being only a pretext for continuing the old firm name of Lafon & Bois. Lafon was forbidden the use of his wife's name on his cards, signs, and in his business generally.³

§ 750. In the Court of Riom, in 1889, was *Rousselon v. Lafort-Dumas*, which was a case of confusion by the intentional misuse of numerals. It was said that to appreciate the possibility of confusion between two marks,

¹ 42 Annales, 145.

* See *Newman v. Alvord*, 49 Barb. 588; 35 How. Pr. 108; *R. Fox*, 404. Also *Browne on Trade-Marks*, §§ 182 *et seq.*

² *Société des caves, etc., de Roquefort v. Mercadier*, 42 Annales, 165.

³ *Bois v. Lafon*, 43 Annales, 26.

they should be examined together, the constitutive elements of said marks considered, and every detail compared, which would in any way serve to mislead the public. Thus the mark *Véritable Dumas et Cie.*, 52, was held to be a fraudulent imitation of the mark *Véritable Dumas*, 32. (The case is an intricate one, and must be studied to be thoroughly understood.)¹

§ 751. The Court of Cassation, in 1891, had this case on appeal, — *Redfern & Sons v. Williamson et al.* Messrs. Williamson and Mulligan were employed by Redfern & Sons, ladies' tailors, but had quit their employers, and formed a similar enterprise of their own, also in Paris. The Tribunal of Commerce regarded it as an unfair competition in business, and forbade its continuance, under the penalty of 300 fr. for every disobedience of its order, and prohibited any future announcement on defendants' part, or the use on letterheads, or papers of commerce of any nature, of the fact of their being old employés of Redfern & Sons, and condemned them to 2,500 fr. damages. Their appeal found its way to the highest court. It appeared by the evidence that they had served for several years in the capacity mentioned, one as cutter, the other as book-keeper. They had been circumspect, and had done nothing to create confusion in the minds of the public. It is true that they had rendered homage to the standing of the house in the industry of shaping garments for the ladies, an enterprise which in itself is useful, and in the interests of commerce should be protected. They had not been guilty of falsehood, nor of any other illicit act. It also appeared that they had not been guilty of obtaining a list of the customers of the former house, nor of improperly soliciting their work. The case was reversed, and the plaintiffs, Messrs. Redfern & Sons, were ordered to pay the primary costs and those of appeal.²

§ 752. The Court of Cassation, in 1890, had the case on appeal of the *Compagnie française du Celluloid v. Schnerver et al.* Messrs. Jules and Charles Schnerver, brothers, and both

¹ Rousselon v. Lafont-Dumas, 36 Annales, 67.

² Redfern & Sons v. Williamson et al., 38 Annales, 13.

Americans, the one a chemist, and the other an engineer, were proprietors of English patents. They had entered the service of the plaintiffs, taking their patents, and giving their technical knowledge to the firm; and they engaged, by a contract of 1883, not in future to engage in this business with other parties, whether as partners, managers, engineers, employés of any kind, in France, or elsewhere in Europe, either as a corporation or under a collective name; or to occupy themselves in the making, or selling, of celluloid, or analogous products. At the end of six months the brothers Schnerver gave notice of quitting employment in the works of the company, and had entered the service of an American firm of the name of Hyde & Ward, afterward the Company Phibolithoid. The Schnerver brothers occupied themselves in the manufacture of celluloid and articles similar to it. The Compagnie française du Celluloid considered this action on the part of the brothers as a violation of their contract of 1883, and summoned them before the Tribunal of Rouen, demanding 10,000 fr. damages and an injunction, under penalty of 1000 fr. for every repetition of the offence. The brothers, not defending the case, judgment was awarded the Compagnie française. The brothers defendant demanded 10,000 fr. damages in further legal proceedings. Meanwhile, the judgment by default was reduced to 3000 fr. and the constraint to 500 fr. It seemed that the first protest of the brothers was in their letter of withdrawal; that the complaint among other things was that their salary was insufficient, etc., etc. *Held*, that they had violated their contract. They appealed to the Court of Rouen, which affirmed the judgment. They then appealed to the Court of Cassation. In its decree of 1890, it was *held*, among other matters, that the acceptance of the brothers' withdrawal by the Compagnie did not avoid the obligations of the contract. The decision of the lower courts was affirmed.¹

§ 753. In the Court of Nîmes, on appeal, in 1887, was considered *Gibelin v. Peyron*. The vendor of a place of business bound himself not to exercise an industry of a sim-

¹ *Compagnie française du Celluloid v. Schnerver*, 37 *Annales*, 68 [1891].

ilar nature — blacksmithing — within a determined perimeter; but he furnished to his brother the necessary funds to install an establishment of the same kind within said perimeter. Jean Peyron had bound himself against the business of blacksmithing within the canton of Verroux, except the territory of Silhac, yet secretly intended to substitute a third person in carrying on a similar business. A forge was established by Ferdinand Peyron, with the funds furnished by his brother, — Ferdinand having begun his work, awaited the expected more funds from Jean. *Held*, that Jean Peyron's contract with the plaintiff had been violated. He was fined 600 fr., unless Ferdinand's forge was discontinued within a month, with 400 fr. additional, and costs.¹

§ 754. The Tribunal Civil of Epernay, 1889, had the case of *Veuve Pommery, fils, et Cie. v. Alfred Pommery*. The defendant, a minor, had founded at Epernay, at the beginning of 1887, a house of commerce for champagne wines, under the name of Alfred Pommery, — this was formed of his own patronymic and one of his baptismal names. The plaintiffs, Société Veuve Pommery, fils, et Cie., had, on the other hand, carried on business for the sale of champagne wines at Rheims, for more than thirty years, and their wines had enjoyed an enviable renown, not only throughout France, but in foreign countries as well. The plaintiffs demanded the abandonment, by defendant, on his labels, letter-heads, stamps, signs, and from his corks and price lists, the name of Pommery; and that he should be condemned to pay 3000 fr. damages, and costs, and make due publication of such decision in the French papers. Plaintiffs argued that the wines of champagne are distinguished not by the names of vintages, but by those of fabricants; so that when two wines are sold under the same commercial name, even if the labels on each mention the date of foundation, the place of business, and differ in other material ways, yet confusion is sure to result. Plaintiffs showed that defendant had no cellars, nor workmen, nor a wholesale license, nor capital; but only retailed wines furnished all prepared by their

¹ Gibelin v. Peyron, 37 Annales, 50.

fabricant. Therefore defendant was not a veritable vendor, having the right to commercial usage of the name of merchant. The Tribunal found for defendant against plaintiffs, with damages and costs. The plaintiffs appealed to the Court of Paris, which reversed the decision below, notwithstanding that there had been proved no intentional guilt on the part of defendant, who had, indeed, offered to submit all his labels, signs, etc., to the plaintiffs before placing them on his goods, and which offer plaintiffs had refused.¹ — The Court of Paris, in 1890, had the case of *Chaudon et Cie. v. Henri Moët*, which had come up from the Tribunal Civil at Rheims. The house of Moët had been founded in 1743; the firm of Moët and Chaudon had succeeded to the business and were proprietors of certain trade-marks and labels and emblems of the old established house. The defendant, Moët, conducted a business of champagne wines under his own name, against which plaintiffs had brought suit. The decision was in favor of defendant as he had lawfully used his ancient patronymic. On appeal it was *held*: one has the incontestable right in commerce and in industry to inscribe his patronymic on signs, advertisements, prospectuses, etc., thus upholding the decision of the court below.²

§ 755. In the Court of Amiens, 1886 (*Tausin v. Soupfiel-Lebland*), were developed these facts: Inasmuch as the cement made at Saint-Quentin has long been classed by commerce in the category known under the denomination of "Roman Cement;" and there are other regions, notably in the Basin of Paris, in Bourgogne, Boulogne-sur-mer, where other cement of the nature of that of Saint-Quentin is produced, — the fact remains that the term "Roman Cement" is merely descriptive, and is employed by commerce to designate a material of a general quality, each region having its peculiar geographical designation. The words "*Ciment de Saint-Quentin*" indicate the origin of the cement made at Saint-Quentin, and not at another place. The name of a city belongs exclusively to the individual resident who first appropriated it to his product, and he has the right, while

¹ 37 Annales, 124 [1891].

² 37 Annales, 133.

strangers have not. It is unfair competition to introduce other cements, as from Belgium, and bring them into France under the name of "*Ciment de Saint-Quentin*." On appeal, the judgment was affirmed.¹

§ 756. In the Tribunal Civil of the Seine, 1885, was the case of *La Nouvelle Revue v. Veuve Dentu*. *La Nouvelle Revue* had published a series of studies under the titles of "*La Société de Berlin*," "*La Société de Vienne*," and "*La Société de Londres*." This last study had appeared in book form and been put on sale May 1, 1885, in Paris. Near the same date, March 14, 1885, had been announced in London the early appearance of a similar work under the title of "*Society in London*;" but it was not in the market until early in May. Madame Dentu purchased the right of reproduction of this book under the title of "*La Société de Londres*." The director of *La Nouvelle Revue*, fearing that the similitude of titles would tend to confusion between the two works, brought suit against Madame Dentu to restrain the sale of the volume edited by the latter, demanded modification of the title, the style of the work, and 3000 fr. damages. The defendant insisted that she had the right of anteriority of the title, for the English work had appeared before the publication made by *La Nouvelle Revue*, and stated that no confusion was possible, for the names of authors, the construction of the book, and the prices differed. *Held*, the originality of the title "*La Société de Londres*" could not be counterbalanced by the co-existence of an English book entitled "*Society in London*." Judgment, prohibition of sale of the book under penalty. She to pay the costs. *Veuve Dentu*, after appealing, consented to change the title to "*Le grand Monde de Londres*."²

§ 757. In the Tribunal Civil of the Seine, 1894, was considered *Compagnie fermière de Vichy, État et Union de propriétaires et concessionnaires des eaux Minérales v. (Divers persons)*. The City of Vichy is the centre of a hydrographic region known under the name — more or less exact in a scientific point of view — of the Basin of Vichy. The

¹ 32 Annales, 190.

² 36 Annales, 26.

widely diffused usage, in the learned and commercial world, is to borrow the name of this locality to designate all the mineral waters of the region; but the name cannot be the object of exclusive appropriation, for the waters which emerge within the administrative limits of the commerce of Vichy. It would be unjust to forbid those in the business of mineral waters at Saint-Yorre to employ in any manner the name of Vichy on their labels and capsules; but the tribunals may determine the conditions under which the name *should* figure on labels, etc., to avoid confusion of a nature to create belief that their springs belong to Vichy proper. In the case of one defendant, it was said that if he wishes to continue to use the name of Vichy, to give his waters a generic name, he should adjoin a notice informing the public of their exact source; for instance, "*eau Minérale Naturelle du Bassin de Vichy, Source Larbaud, Saint-Yorre, près Vichy;*" and the capsules should bear the name of "*Saint-Yorre près de Vichy.*" The principle of all the other cases is thus explained.¹

§ 758. In the Court of Rouen, 1893, was the case of *Piatier et préfet de la Corse v. Angeli et al.* Piatier was lessee of the mineral fountains of Orezza, which belonged to the department of the Corse. It is a principle that the names of places are in the public domain, and every one may truly indicate the origin of his products. Therefore, the proprietor of mineral springs may, without being amenable to criticism, give to the water the genuine name of the country whence it issues, provided he truly does so; and that the use of this denomination should be under the condition susceptible of not causing confusion in the mind of the public, with similar springs of the same region, exploited under the same name.²

§ 759. In the Tribunal of Commerce of the Seine, 1896 (*Beer, Raudnitz, Doucet et al. v. Lœu*), the plaintiffs were originators of certain models of fashion. Defendant had purchased the right to issue the patterns of the robes of the winter season, and to engrave them for his publica-

¹ 41 Annales, 5.

² 41 Annales, 25.

tion, which he edits under the title "*Modèles de Paris.*" The plaintiffs refused to allow him to put their names on the bottom of the designs reproduced by him, although he had bought and paid for them. He, nevertheless, printed their name without especial authority. It is not established that he had acted in bad faith, and with the object of unduly appropriating to himself the reputation of the plaintiffs, but he led many customers to look to him directly instead of going to the plaintiffs. *Held*, the patronymic name and the denomination of fancy adopted by a firm, constitute, in the commercial sense, a property of which the usage is expressly limited to those duly authorized. Defendant had no right to use the names complained of, and must discontinue them in the publication "*Modèles de Paris,*" and pay costs.¹

§ 760. In the Court of Cassation, 1897, was the remarkable case of *Veuve Leloutre v. Dubuisson*. The parties were in the same kind of business, — the making of bronze figures. The complainant thought that she could best check the defendant in an act which she deemed unfair competition by giving a criminal turn to affairs. The subjects of contest were: 1. Two torches of the style of Louis XIV., and the representation of two children embracing each other; 2. Statuettes termed "*Enfants terre et eau.*" Plaintiff caused the articles in possession of defendant to be judicially seized, insisting that she was the assignee of M. Graux-Morly, the fabricant. It was *held*, that the fabricant who purchases at a sale on execution pieces of bronze, destined for reproduction by castings from the models, has the sole right to such reproductions, and could not in any sense be regarded as a counterfeiter. Judgment in favor of defendant.²

§ 761. In the Court of Cassation, 1894 (*Brachat v. Syndicat des pharmaciens de Bordeaux*), a syndicate may intervene to claim damages against a pharmacien, even a member of the syndicate, who is complained of as selling falsified medicated substances.³

¹ 43 Annales, 98.

² 43 Annales, 155.

³ 41 Annales, 22.

§ 762. In the Court of Paris, 1888, was the case *Corube & Oriée v. Rouillon et al.* C. & O. for more than forty years were engaged in the dressing and preparation of skins, under the name of "Grison," as their duly registered trade-mark. This was the name of the founder of the house. Rouillon, and others in the same line of business, associated themselves with a young man named George Grison, and instituted the commercial house of Grison and Company. In this enterprise they had imitated the trade-mark of C. & O. The Tribunal of Commerce had found that young Grison was of little account. Of course he had the right to use his own name, but the addition of "and Company" was held to be a fraudulent attempt to encroach on the rights of plaintiffs. The amount of 5000 fr. was awarded plaintiffs. Defendant was also ordered to publish this sentence in fifteen French and other newspapers which plaintiffs might select. On appeal to the Court of Paris, the judgment was affirmed.¹

§ 763. In the Court of Cassation, 1891, was heard on appeal *Antoine v. Labadie & Agostini.* Held, when a firm of business has been dissolved, and the trade-mark belonging to it not having been expressly provided for, and one of the late partners having continued the use of said mark without opposition, the court has the power to conclude that such partner is legally in possession.²

§ 764. In the Tribunal of Nantua, 1891 (*Choffé v. Dame Ratel*), the divorced wife has not the right to call herself "*ex femme divorcée*" of such a one, for the name of her former husband no longer belongs to her.³ — In the Tribunal of Commerce of Marseille, 1881, it had been held in *Léon Espié v. Dame Espié*, as follows: When husband and wife have been separated *à mensa et thoro*, the woman cannot exercise a commerce similar to that of her husband, without adjoining her family name to that of her married name, as, for instance, the designation "*Irma Criquet, femme de Léon Espié*."⁴

¹ 38 Annales [1891], 141.

² 41 Annales, 125.

³ 38 Annales, 8.

⁴ 38 Annales, 9.

§ 765. In the Court of Paris, 1887 (*Jouot v. Société Générale de laiteries*), these facts appeared. A certain number of wholesale milk-dealers associated themselves for the sale of milk produced in Paris or in the provinces. Eugène Jouot had transferred to the association his interest in the business and good-will, and had accepted the appointment as inspector of the concern for 3000 fr. a year, but voluntarily quit his employment as inspector in 1881. All the members of the Société had bound themselves to the interests of the association. In February, 1882, Eugène Jouot actively occupied himself in the apparent interest of his son, in establishing a milk business under the name of Mathieu and Co. In February, 1883, they duly registered for the sale of their milk-produce, under a collective name with one Tempez and Albert Jouot, son of Eugène. At this time, Albert was in military service, and Eugène took direction and control of the business under the apparent name and authority of his son. It was a matter of public notoriety that Eugène himself directly admitted his personal interest, and circumstances concurred to show his individual connection. The firm of Albert Jouot and Tempez having been dissolved by the latter's death, the concern had been sold under a judgment of the Tribunal of the Seine of Feb. 7, 1884, and was re-established for the purpose of wholesale milk-dealing in the branches of the trade situate in Fleury (Oise) and Saint-Siméon (Seine-et-Marne); Eugène Jouot, representing himself as agent for his son, still absent as a soldier, was manager of these several establishments. The son had by notarial act qualified himself as a wholesale dealer in milk. The evidence showed that Eugène Jouot had directed the milk interests under the names of Matthieu & Co., Jouot & Matthieu, Jouot & Tempez, etc., in every case pretending to be the agent for his son, to whom he rendered no accounting. The court *held*, that Eugène Jouot was clearly guilty of unfair competition in business, and adjudged him to pay fines and costs.¹

§ 766. In the Court of Bourges, 1894 (*Montupet and the*

¹ 37 *Annales*, 54.

Union of Proprietors and Lessees of Mineral Springs v. Nattan et al.), the following case involved a matter of deceit, detrimental to the interests of owners, etc., of mineral waters. It was said that every deceit as to the nature of merchandise sold, every fraud, every illicit act to the injury of the consumer, causes also a double injury to legitimate vendors. A professional syndicate has therefore the right to demand the cessation of such false practice. *Held*, to be a case of unfair competition, with the usual penalty.¹

§ 767. In the Court of Paris, 1888 (*Omer Décagu et fils et al. v. Ferniot*), was this case of unfair competition. F. and his partners had ceded to the plaintiffs their interest in the commerce of fruits, vegetables, and flowers in one of the central halls of Paris. The contract contained a clause that F. should not directly, nor indirectly, engage in a similar business. The evidence showed that F. had worked to the detriment of the Décagu firm by lending to Bellau & Roux — of which his son-in-law was one of the partners — his active assistance in conducting their correspondence, and taking part in their commercial operations, which were of the same nature as those of plaintiffs. *Held*, to be an infraction of the contract to the great loss of the plaintiffs; and Ferniot was condemned to pay 3000 fr. damages, 500 fr. for each act of disobedience, and costs.²

¹ 41 *Annales*, 17. See also *Société générale des eaux Minérales de Gouzan v. Bertrand*, a similar case, 37 *Annales*, 164.

² 37 *Annales*, 53.

CHAPTER VI.

INJUNCTIONS.

- § 768. "Benedictine" and "Hostetter's Bitters" cases.
- § 769. Rights of Canadian citizens manufacturing in New York, etc.
- § 770. Corporation cannot use name of another for deceit, etc.
- § 771. "Lightning Hay Knives," "Akron Dental Rubber," etc.
- § 772. Imitation of "Mumm's Extra Dry" trade-mark; "Cuticura," etc.
- § 773. "Frazer's Axle Grease." N. K. Fairbank Co. case.
- § 774. When an injunction will not be refused.
- § 775. When a label may be enjoined on evidence of deceit of two persons.
- § 776. Infringement of "Sapolio" by "Pride of the Kitchen."
- § 777. "Washburn Flour Mills Co." case, "Clark Thread Co." case.
- § 778. "Club Soda" case.
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- § 780. Instances of protection to various manufacturers' trade-marks.
- § 781. "Star" tobacco case.
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- § 785. "Maizena infringed by Maizharine," "Fig Syrup" case.
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- § 786. Continued use of same name by father and son.
- § 787. No defence that infringer ceased use.
- § 788. "Home" for sewing-machine, infringed by "Home Delight."
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- § 791. "Howe's Grain Cleaner."
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- § 794. "Golden Crown" tobacco and tag.
- § 795. Deleterious substances. Disparagement.
- § 796. Ignorance no defence. Effects of indifference or negligence.
- § 797. Devices and methods intended to deceive, enjoined.
- § 798. Defendant's use of hotel trade-mark for cigars enjoined.
- § 799. An instance of unfair competition enjoined.
- § 800. Term American Syrup of Figs by English Co., misrepresentation.
- § 801. "Six Big Tailors" enjoined.
- § 802. "U. S." infringement on "United States."

- § 803. Rights of industrial to trade-mark for sewing-thread, etc.
- § 804. Injunction against copying a costume used as a sign of trade.
- § 805. Against use of similar names intended to deceive.
- § 806. "Insectine," "Baeder Flint-Paper Co." cases.
- § 807. Under what circumstances a Preliminary Injunction is granted.
- § 808. Preliminary Injunction in case of almost identical labels.

§ 768. *Injunction.* This term means a remedy in equity to restrain infringement, when the peril is imminent; and it is invoked when law does not afford an adequate redress. The following are cases and examples of late decisions:—

The fact that the complainant, the manufacturer of a cordial made according to a recipe obtained from the Benedictine monks, attached to the bottle-labels an advertisement bearing Latin and French phrases, which, translated, are, "Genuine Benedictine Liqueur of the Benedictine Monks of the Abbey of Fécamp," does not preclude relief against one who manufactures and places on the market an article in such form and guise as to clearly indicate that it is the identical article sold by the complainant,—such phrases not being representations that the Benedictine monks are still engaged in its manufacture at Fécamp, but that it originated with them, especially as one of the advertisements shows that the cordial is manufactured by complainant, a corporation.¹ The contention is based on the fact that the Latin words "*Liquor Monachorum Benedictinorum Abbatiae Fiscanensis*" appear on a label pasted round the neck of every one of the Société's bottles; that an advertisement printed in French is also wrapped up with every bottle with the leading words, "*Véritable Bénédictine Liqueur des moines Bénédictines de L'Abbaye de Fécamp*," and that the wax seal on the cork of every bottle has impressed thereon the figure of a monk, and that one of the labels on the body of the bottle bears the cabalistic letters "D. O. M." It also bears illustrations that dispel any suggestion of deceit. Defendant put on the market a cordial not made according to the genuine recipe. Thayer, J., enjoined, and ordered an accounting of profits.²—Complainant had sold for many

¹ Société Anonyme de la Distillerie v. Western Distilling Co., 43 F. 416.

² Ibid.

years an article known as "Hostetter's Bitters." Defendant manufactured an article resembling it in color and in other particulars under the name "Host's Style Bitters," and sold the same in large demijohns, without labels, and was shown in several instances to have given to the purchaser of his bitters an empty bottle bearing all complainant's labels. *Held*, that defendant — although the purchasers from him were not deceived — had furnished the means, and should be enjoined from selling "Host's Style Bitters," and at the same time, and in connection with the sale, giving the purchasers empty "Hostetter" bottles.¹ — Defence attempted to show that the beverage contains alcohol, and the evidence shows that some chemist found a teaspoonful of alcohol in a quart, and others much less, and that it was used to cut the flavoring oils, and mostly evaporated. The defendant claimed that injunction should be dissolved, because plaintiff is not a corporation in point of fact, and because there never was such a person as Lieutenant Moxie; that the product contains alcohol, and is not manufactured from a sugar-cane-like plant which grows near the equator and further south, and that the representations are false. Motion to dissolve injunction refused.²

§ 769. Citizens of Canada, engaged in the manufacture of trade-marked articles, and who have places of business in the State of New York, where they make and ship such articles, are within the international convention of March 20, 1883, for the protection of industrial property; and they may succeed in the United States courts for infringement to trade-marks by its citizens. (Defendant has produced a catching device to deceive trade and induce sales.)³ — The word "Valvoline," compounded and used on packages of lubricating oils by plaintiffs and registered as a trade-mark, may be used for that purpose, and the use thereof by defendant in the same manner will be enjoined, though defendant use his own name in connection with the word.⁴

¹ Hostetter Co. v. Becker, R. 297.

² Moxie Nerve Food Co. v. Baubach *et al.* (C. C.), E. D. Texas, 32 F. 205.

³ 60 F. 272.

⁴ Leonard v. White's Golden Lubricator Co., 38 F. 922.

§ 770. The United States Circuit Court of Appeal *held*, that a corporation which, by arrangement with one R. W. R., takes his name and stamps it on articles sold by it, with the purpose of inducing the public to think that in purchasing such articles they are purchasing the articles of another "R." of established reputation, will be restrained from using such stamp.¹ — A newly coined word is used in the manufacture and sale of various compounds of "pyroxoline," which it designates as "Celluloid," to distinguish it from similar compounds used by others. Defendant was incorporated by the name of the "Cellonite Manufacturing Co." *Held*, that the similarity was sufficient to mislead ordinary, unsuspecting purchasers. Enjoined by Bradley, Just.² *

§ 771. "Lightning Hay-Knives" is a trade-mark under which was advertised and sold thousands of the manufactured article bearing this name, and the word "Lightning" was registered. "Lightning Pattern Hay-Knives" was enjoined, it being *held*, that the word "Lightning" is not merely descriptive of the quality or characteristics of the knives.³ — A manufacturer of an article of dentistry printed on the boxes containing it, "Non-Secret Dental Vulcanite, made according to our analysis of the Akron Dental Rubber," the words "Akron Dental Rubber," being the trade-mark of a competitor, and being printed in red ink and large type. The preceding words were printed in large black type, and the formula for the preparation of the article followed in red ink in very small type. *Held*, that the label was likely to mislead, that it was an infringement, and that its use should be enjoined.⁴ — Defendants use a bottle which has a peculiar form, color, and round shoulders, and the short neck of complainants' bottle, with a label containing the words "Theller's Celebrated Stomach Bitters," a monogram of the letters "A. T."

¹ R. W. Rogers Co. *et al.* v. Rogers M'fg Co., 70 F. 1017 ; 17 C. C. A. 576.

² Celluloid M'fg Co. v. Cellonite M'fg Co., 32 F. 94. See Celluloid M'fg Co. v. Read, 47 F. 712.

* In 1873 complainant caused the word "Celluloid" to be registered in U. S. Patent Office as a trade-mark.

³ Hiram Holt Co. v. Wadsworth, 41 F. 34.

⁴ Keller v. B. F. Goodrich Co. (Ind.), 19 N. E. 196 ; 119 Ind. 556.

in place of the picture of St. George and the dragon, used by complainants, a black shield below the monogram greatly resembling complainants' shield, and below the shield an imitation of the lettering on the genuine label. *Held*, an imitation well and designedly calculated to deceive.¹ The fact that one of the defendants was, in 1870, engaged in manufacturing imitations of the goods, labels, and trade-marks now manufactured and owned by complainants, and was then successfully sued therefor, is immaterial.² — The labels on complainant's tobacco packages had a representation of a shield or banner and an ellipse within a circle, and the words "Smoke and Chew." The colors used were red and yellow. Defendant's labels had the same figures and colors, and the words "Smoke and Chew," and were so much like complainant's, that one might easily be mistaken for the other. One was called "Peach Blossom" and the other "Sweet Lotus." *Held*, that defendant's wrapper was a palpable imitation of complainant's, and that their use should be enjoined.³ — A firm in the United States engaged in bottling and selling whiskey under the name of "Canadian Rye Whiskey," in bottles and with labels, bands, and devices so nearly resembling those on bottles of a corporation engaged in Canada in manufacturing and selling whiskey under the name of "Canadian Club Whiskey," as to constitute unfair competition, and evidence and intent to deceive purchasers.⁴ — When complainant has established a trade in a cough mixture known as "Bull's Cough Syrup," and "Dr. Bull's Cough Syrup," and defendant has placed on the market, with a fraudulent purpose of causing it to be mistaken for complainant's article, with a similar name and wrapper (or any kind of wrapper calculated to deceive the public), he should be enjoined.⁵ — One who puts into the hands of retail dealers an article made by him, and so dressed up as to enable such dealers to deceive the ultimate purchasers into the belief that they are buying the goods of a third person, may be enjoined

¹ Myers v. Theller, F. 38, 607.

² Ibid.

³ Wellman & Dwire Tobacco Co. v. Ware Tobacco Works, 46 F. 289.

⁴ Hiram Walker & Sons v. Mikolas (C. C.), 79 F. 965.

⁵ Meyer v. Dr. B. L. Bull Vegetable Medicine Co. (C. C. A.), 58 F. 884.

by the latter.¹ When so dressed up, it is unnecessary to prove that any particular person has in fact been so deceived.² When the devices used by the plaintiff are imitated by the defendant, the testimony of witnesses as to the likeness is not necessarily required.³

§ 772. In 1866, the plaintiffs, at Rheims, France, originated a champagne wine, having a "dry" flavor, which has been very extensively sold in the United States as "G. H. Mumm & Co.'s Extra Dry." In the beginning, plaintiffs adopted a new and characteristic metal capsule, of a peculiar rose color never before used, on top of which is stamped, in blue, an imperial mantle, bearing a trade-mark, while running perpendicularly are the words "G. H. Mumm & Co." Just below the capsule is a small label on which the trade-mark is also printed. The principal label of the bottle also bears that trade-mark in the upper field. Defendants sell an assorted American wine in ordinary champagne bottles. On the upper part of the principal label they put the words "Extra Dry," and also a colorable imitation of the trade-mark and mantle, while the words "Extra Dry" are stamped perpendicularly thereon in the same place where plaintiff stamped "G. H. Mumm & Co." Defendants' wine has no "dry" quality; and the court found from the testimony that the words "Extra Dry" were used by them for the purpose of fraud, and that the bottles were dressed up so as to enable them to be put off as goods of plaintiffs. *Held*, that defendants should be enjoined (1) from using in a combination the marks, labels, and capsules described; (2) from using any colorable imitation of plaintiffs' trade-mark; (3) from placing the words "Extra Dry" on any bottles of their product, of the character described either in combination or otherwise; (4) from surrounding the neck and cork of any bottles of the form generally used for champagne, and containing their product, with a rose-colored metal capsule, whether stamped as before described or otherwise.⁴—

¹ Von Mumm *et al.* v. Frash *et al.*, 56 F. 830.

² *Ibid.*

³ Coats v. Thread Co., 13 Sup. Ct. 966 (149 U. S. followed).

⁴ Von Mumm *et al.* v. Frash, 56 F. 830. (As stated by the N. Y. Ct. of Appeals, in *Thrascher v. Blank*, 33 N. E. 104, "each case must, in a measure, be a law unto itself.")

“Cuticura,” a trade-mark for a toilet soap, is infringed by the word “Curative,” applied to a different soap; and the use may be enjoined, especially when imitative devices were used, and there was an actual attempt to mislead.¹ — Defendant’s boxes of medicine, as prepared for market, bore a close and intentional resemblance to plaintiff’s boxes externally, and the arrangement and words on the bottles of medicine, pamphlets, and labels were calculated to mislead the public. *Held*, that plaintiff is entitled to an injunction restraining defendant from infringing on the original peculiar method of preparing the wrapping, boxing, and packing the medicine.²

§ 773. The defendant Frazer, the patentee of an article known as “Frazer’s Axle Grease,” “Frazer’s Lubricator,” or “Frazer’s Grease,” sold his present and future interest therein to plaintiffs, authorized the use of his name in the manufacture and sale by it of such article, and agreed to refrain from the manufacture and sale thereof, or the use of his name in connection therewith. Thereafter, he obtained a patent for an alleged improved axle grease composed of essentially the same ingredients, though mixed in different proportions. This he sold in packages somewhat different from plaintiff’s, but marked “Frazer & Co.,” in good-sized letters. *Held*, a breach of the contract with plaintiffs, which was enjoined.³ — Where defendant’s packages resemble complainants’ in numerous particulars besides those of size, color, and form, an injunction should be granted against the sale of that particular form of package, or any other form which should, by reason of the collocation of size, shape, color, lettering, spacing, ornamentation, present a general appearance as closely resembling complainants’ package as the one complained of; but a clause should be added to the effect that the injunction should not be construed as preventing a sale of a package of the same size, weight, shape, or color, — provided it be so differentiated as not to be likely to deceive ordinary purchasers.⁴

¹ Potter Drug & Chem. Corp. v. Miller, 75 F. 656.

² Homœopathic Med. Co. v. Bell, 2 N. Y. S. 50.

³ Frazer v. Frazer Lubricator Co. (Ill.), 13 N. E. 639.

⁴ N. K. Fairbank Co. v. R. W. Bell M’fg Co. (C. C. A. affirming circuit), 77 F. 869.

§ 774. An injunction will not be refused because the complainant was not the original designer or owner of the trade-mark, but succeeded to the rights of a firm which used it; nor is it refused because defendant has made no sales, but would have done so but for the suit.¹ — An innocent misrepresentation is no ground for refusing relief.²

§ 775. A label bearing six different points of resemblance to a label used by another person in the same business, may be enjoined by evidence that two persons were deceived and that the defendant's sales were increased.³

§ 776. The complainant had a trade-mark, "Sapolio," used to designate a particular kind of soap. When a person called at defendant's store and asked for "Sapolio," the salesman would, without explanation, put out a soap called "Pride of the Kitchen," plainly so marked, and paid therefor the usual price. The wrapper was different, and the size and shape different from that of "Sapolio." *Held*, that although there was no use of the word "Sapolio" on defendant's soap, and no resemblance in his package, he should be enjoined. Costs reserved.⁴

§ 777. The use of a brand on flour differing from a brand used by an established manufacturer only in adding the initials to a name, slightly altering the design of the letters in a prominent word, and the arrangement of certain letters and words, is a colorable imitation, manifestly intended to mislead the public, and will be enjoined. Objection that the corporation complainant, formed and managed by members of a firm which originated the brand, is itself guilty of misrepresentation as to the real maker of the goods, if valid at all, is obviated by the placing on the goods the name of the corporation, with the word "successor."⁵ — Where a corporation has changed its name, and adopted a modified name, at the sug-

¹ *Cuervo v. Landauer*, 63 F. 1003.

² *C. F. Simmons Med. Co. v. Mansfield Drug Co.*, 23 S. W. 165.

³ *McCann v. Anthony*, 21 Mo. App. 83.

⁴ *Enoch Morgan's Sons Co. v. Wendover et al.* (C. C.), 43 F. 420.

⁵ *Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 F. 841; 12 C. C. A. 432.

gestion of the manager of another corporation, the latter corporation is estopped, afterwards, to object to the use by the former of the modified name. — Fraud, to disentitle complainant to relief, cannot be predicated of trivial inaccuracies or “trade-talk,” as to say that his thread is sold “everywhere,” or that the thread is the “latest and best.” No one is deceived.¹ — An injunction should be granted if the defendants adopt their brand for the purpose of selling their goods, or to enable others to do so, and complainant has been injured, or was likely to be injured thereby.² — It is no defence that no deception is in fact practised on others with whom they deal personally, or that retailers could thereby be enabled to deceive consumers.³

§ 778. One who has registered an English trade-mark, “Club Soda,” in Jamaica, is not disentitled to relief against an infringer because plaintiff has printed on his labels the words “Manufactured in Ireland by H. M. Royal Letters Patent,” where such words relate to patented machinery. They do not necessarily induce belief that the ingredients were patented.⁴

§ 779. Plaintiff marked an article called by him “German Sweet Chocolate.” *Held*, that, deceit of the public having been shown, an injunction should issue without reference to question of trade-mark.⁵ — Upon the facts, as to the use by defendant of labels resembling those of complainant, *held*, that defendant was attempting to palm off his goods as those of complainant, and should be enjoined.⁶ — If one person by superior energy, by more extensive advertising, by selling a better or more attractive article, or by greater frankness in disclosing the ingredients of his compound, outbids another in popular favor, he has a right to do so, provided he do not attempt

¹ Clark Thread Co. v. Armitage (C. C.), 67 F. 896 ; 21 C. C. A. 178 ; 74 F. 936. See Same v. Wm. Clark Co., 37 A. 599.

² Southern White Lead Co. v. Cary, 25 F. 125.

³ Ibid.

⁴ Cochrane v. Macnish (P. C.) [1896], A. C. 225 ; 65 L. J. P. C. N. s. 20 ; 74 Law T. Rep. 109.

⁵ Pierce v. Guittard, 68 Cal. 68.

⁶ Klotz v. Hecht (C. C.), 73 F. 822.

to palm off his goods as the product of another. He must not so far imitate as to enable a dishonest trader to sell. Where complainant was proprietor of a preparation known as "Brown's Iron Bitters," and defendant made another called "Iron Tonic Bitters," which is falsely stated to be made by "Brown & Co., New York," *held*, that such statement should be enjoined.¹—A maker of salt in Genesee Valley will not be enjoined from using "Genesee" in connection therewith, but will be restrained from using it in such a way as to imitate a combination previously used by another manufacturer.²—Where a proper name has become the chief means in commerce of distinguishing the article of merchandise, the use of the same by another for a similar article will be enjoined, where the name is fraudulently intended to deceive.³—Alexis Godillot adopted a trade-mark, "A. G." combined in a monogram, and used the same for many years on articles made by him in France and sold in the United States. In 1884, he sold the right to use the trade-mark in the United States to T. W. & Co., and such right afterward passed to their successor, the T. W. Co. In 1894, a receiver of the firm re-sold the right to Godillot. Afterward, the stock in trade of the T. W. Co. was sold to the American Grocery Co., which began business at the former stand of the T. W. Co., and affixed a mark consisting of the letters "A. G. Co." in a monogram similar to G.'s, which it applied to cigars and coffee, and claimed the right to use it without restriction in its business of dealing in groceries. *Held*, that the American Grocery Co. should be restrained from using such monogram.⁴—The use of imitative labels on inferior articles to enable retailers to sell as the product of others, enjoined.⁵—*Held*, that though defendant did not itself use plaintiffs' labels and bottles, still in advising its customers it was guilty of a wrong which equity will enjoin.⁶

¹ Brown Chemical Co. v. Frederick Stearns & Co. (C. C.), 37 F. 360.

² Genesee Salt Co. v. Burnap, 20 C. C. A. 27.

³ Chas. S. Higgins' Co. v. Amalga Soap Co., 30 N. Y. S. 1074; 10 Miss. Rep. 268.

⁴ Godillot v. American Grocery Co., 71 F. 873.

⁵ Garrett v. T. H. Garrett & Co., 78 F. 472.

⁶ Hostetter Co. v. Brueggeman-Reinert Distilling Co., 46 F. 188.

§ 780. A cigar manufacturer, to protect his trade-marks, may have an injunction restraining a box-maker from furnishing boxes with those trade-marks to other cigar manufacturers, and against all who knowingly combine for that purpose.¹ — A manufacturer of white lead, in Chicago, will be enjoined from the use of the words “White Lead, St. Louis.”² — A manufacturer will be protected in the use of a geographical name by which his goods are known to the public, as against another manufacturer who used the same name to designate a similar article, not for the purpose of describing the place where the goods are made, but for the fraudulent purpose of deceiving purchasers.³ — In a distinctive package and label, though technically not a trade-mark, it is immaterial that defendant did not intend to deceive the public, when, by the use complained of, he knowingly put it in the power of the retailer to do so.⁴ — Actual deceit is not required to be shown to warrant injunction.⁵

§ 781. After plaintiff's well-known “Star” tobacco, having a trade-mark of a five-pointed star with a hole in the centre, had been in the market, defendant adopted the words “Buzz-saw” for tobacco, to which is attached a tin symbol of the same size as that of plaintiff, with eight points slightly inclined to the right, with a hole in the centre and the word “Buzz” dimly impressed on the surface. It is attached to the plug in the same way as the star of the plaintiff. *Held*, that the “Buzz-saw” symbol was an infringement of the plaintiff's trade-mark, and that its use should be enjoined.⁶ — But one not the first to use the design of a star on plug tobacco, but who was the first to use a star made of *tin*, a little over a half an inch in diameter, with a hole in the centre, cannot prevent another from using a round *paper* label, over three-quarters of an inch

¹ *Cuervo v. Jacob Henkel Co.* (C. C.), 50 F. 471.

² *Southern White Lead Co. v. Colt*, 39 F. 492.

³ *Gebbie v. Still*, 31 N. Y. S. 102; 82 Hun, 93.

⁴ *New England Awl & Needle Co. v. Marlboro Awl & Needle Co.* (Mass.), 46 N. E. 386.

⁵ *Shaw v. Pilling*, 175 Pa. 78; 34 Alb. 446.

⁶ *Liggitt & Myer Tobacco Co. v. Sam. Reid Tobacco Co.* (Mo.), 15 S. W. 843.

in diameter, with a red star between words "trade" and "mark" in gilded letters on a red background, having beneath the star the word "Light," thus forming by the figure and the letters the word "Starlight," which is the name given to the tobacco, instead of "Star."¹—The resemblance need not be such as to deceive persons seeing the two trade-marks side by side, or such as to deceive experts.²

§ 782. That the plaintiff adopted the words "Maryland Club Whiskey" as an arbitrary designation, not to designate a particular kind, quality, or composition, but only applied to a certain grade manufactured by him, does not invalidate a right to protection.³ An objection to the geographical term held to be inapplicable.⁴ The words "pat. Aug. 13th, 1872," that being the date of the registration of the trade-mark, was not a false affirmation that goods were *patented*, to defeat right to protection.⁵ A representation on the trade-label that the article is "pure old rye whiskey" is not falsified by proof that the whiskey is diluted with water, and packages bear but one stamp, while high-proof whiskey bears two stamps, and does not deprive of right to protection if it appear that the whiskey does not possess commercial purity.⁶

§ 783. Where manufacturers at one place falsely mark or brand their goods as manufactured at another, for the purpose of inducing trade which would otherwise go to manufacturers at such other place, such false marking will be considered as fraudulent and a "resort to a palpable trick," and complainant being injured thereby, the infringing manufacturers should be enjoined from thus using the name of the place where the complainant carries on its business.⁷

§ 784. The complainant used on the bottles in which it sold liquid bluing, a bright metallic cap of tin, extending down over about half of the rim at the mouth of the bottle, the cap having six perforations, *held*, that defendant should

¹ Liggitt & Myer Tobacco Co. v. Finzar, 129 U. S. (L. ed.) 32, 395.

² Liggitt & Myer Tobacco Co. v. Hynes, 20 F. 883.

³ Cahn v. Gottschalk, 2 N. Y. S. 13.

⁴ Ibid.

⁵ Ibid.

⁶ Ibid.

⁷ Southern White Lead Co. v. Corry, *supra*.

be restrained from using for the sale of his bluing a similar cap on bottles of the same shape and appearance as those of complainant. Where both parties are manufacturers of liquid bluing, the defendant may be restrained from buying old bottles of the complainant having the latter's name on them (following *Evans v. Van Laer*, 32 F. 153).¹

§ 785. "Maizena" was a mark for corn-flour put up by complainant. The defendant put upon similar goods the word "Maizharine." Complainant had a second trade-mark, consisting of an allegorical picture representing the cultivation of the corn, and the preparation and cooking of the flour by the Indians. Defendant also had a registered mark, — a pictorial representation of a man carrying a quantity of maize in his arms. Enjoined.² — The use of the phrase "Improved Fig Syrup," on a preparation resembling a similar preparation manufactured and sold under the name of "Syrup of Figs," and calculated to deceive and mislead the public, was enjoined as an infringement of the complainant's trade-mark.³

§ 785½. The city of Carlsbad, Bohemia, having long made and sold salts of high medicinal qualities, in crystals and powders, made by evaporating water from the springs owned by that city, under the name of "Carlsbad Sprudel Salts," held, that it was an infringement to sell articles of salts, in no way derived from the Carlsbad waters, under the name of "Improved Effervescent Carlsbad Powder." The fact that the city of Carlsbad sells Carlsbad Sprudel Lozenges with labels stating "that they are manufactured under the direct administration of the city of Carlsbad," and which contain but 10 per cent of the ingredients formed in Carlsbad water, and 90 per cent of cane sugar, constitutes no fraud or misrepresentation such as would warrant a contention that the city of Carlsbad does not come into court with clean hands.⁴ *

¹ *Sawyer Crystal Blue Co. v. Hubbard*, 32 F. 388.

² *Glen Cove Mfg. Co. v. Ludeling*, 22 F. 823.

³ *Improved Fig Syrup Co. et al. v. California Fig Syrup Co.*, 54 F. 175; 4 C. C. A. 264.

⁴ *City of Carlsbad et al. v. Kutnort*, 71 F. 167; 18 C. C. A. 24.

* A decision of the High Court of Chancery in England, granting to the defendant, against the complainants' opposition, a right to register as a trade-mark the