

to pay all the costs. 1865, *V. C. Wood's Ct.*, *Harrison v. Taylor*, 11 *Jurist (N. S.)* 408; S. C., 12 *Law T. R. (N. S.)* 339.

§ 469. It does not signify, for the purpose of the plaintiff's right to relief, whether the defendant has acted with a fraudulent intention or not; it is enough if, even without any unfair intention, he has done that which is calculated to mislead the public. 1865, *V. C. Kindersley's Ct.*, *Glenny v. Smith*, 2 *Dr. & Sm.* 476; S. C., 11 *Jurist (N. S.)* 964; S. C., 13 *L. T. R. (N. S.)* 11; S. C., 6 *New R.* 363.

§ 470. The use of the trademark of another manufacturer, whether done *scienter* or not, is an interference with his business which the court of chancery will interpose to prevent, on the ground that the defendant is endeavoring to pass off the goods of his own, or somebody else's manufacture, as the manufacture of the plaintiff. 1866, *V. Ch. Wood*, *Ainsworth v. Walmsley*, *Law R. 1 Eq.* 518; S. C., 12 *Jurist (N. S.)* 205; S. C., 14 *Weekly R.* 363; S. C., 14 *Law Times R. (N. S.)* 220; S. C., 35 *Law J. R. (N. S.) Ch.* 352.

§ 471. It is not necessary to prove intentional fraud. If the imitation is calculated to mislead, the intention to deceive is to be inferred therefrom. 1869, *Supreme Ct. of Missouri*, *Filley v. Fassett*, 44 *Mo.* 168.

§ 472. W's manager, without the personal knowledge of W, affixed tickets with T's name printed thereon to certain goods of inferior quality to T's, and made by another manufacturer. On T's complaining of this W offered to give an undertaking that he would not use such tickets again, and to pay a certain sum, but declined to make a public

admission that he had used the tickets in order to defraud T. *Held*, that notwithstanding W's offer T was entitled to an injunction with costs, and also to an inquiry as to damages at his own risk. 1869, *Rolls Ct.*, *Tonge v. Ward*, 21 *Law Times (N. S.)* 480.

§ 473. An infringement of a trademark will be enjoined, although the intent of the infringer may have been entirely innocent. 1870, *Ct. of Com. Pleas, Phil., Pa.*, *Dixon Crucible Co. v. Guggenheim*, 2 *Brew.* 321; *S. C.*, 7 *Phil.* 408.

§ 474. Trademarks are property, and a person using such marks without the sanction and authority of the owner will be restrained by injunction, even where it does not appear there was any fraudulent intent in their use, and will be required to account for the profits derived from the sale of goods so marked. 1870, *Maryland Ct. of App.*, *Stonebreaker v. Stonebreaker*, 33 *Md.* 252.

§ 475. The ground on which courts of equity afford relief in cases of infringement upon the right of property in trademarks is the injury to the party aggrieved and the imposition upon the public. The existence of these consequences does not necessarily depend upon the question whether fraud or an evil intent does or does not exist. The *quo animo* therefore, *would seem* to be an immaterial inquiry. 1870, *Supreme Ct. of Errors, Conn.*, *Holmes v. Holmes, Booth & Atwood Manufacturing Co.*, 37 *Conn.* 278.

§ 476. Where the probable and ordinary consequences of a man's acts will be to benefit himself to the injury of another, his intention to produce such a result may be legitimately inferred. *Ibid.*

§ 477. These matters I should say do not depend on intention. A man may issue a label or trade-

mark like another with the most innocent intention possible ; yet the law is settled that if in truth the trademark is such that it is calculated to mislead, the user will be prohibited in a court of equity. Vice Ch. MALINS, 1870, *Wotherspoon v. Currie*, 22 *Law Times (N. S.)* 260 ; S. C., 18 *Weekly R.* 562.

§ 478. A permanent injunction will be issued against a defendant, who, in ignorance of the plaintiff's rights and claims, has used a trademark belonging to the plaintiff. And the plaintiff in such a case is entitled to costs, but not to damages. 1872, *N. Y. Supreme Ct. Circuit, Weed v. Peterson*, 12 *Abb. Pr. (N. S.)* 178.

§ 479. In order to constitute a ground for interference by a court of equity, to protect the manufacturer against the use, by another person, of the particular name of his manufactured article, it is not necessary that there should be a *mala mens* towards the first purchaser of the article thus imitatively designated. The fault of the imitator is, that the first purchaser may be enabled through this unwarranted designation to retail a simulated article at a lower price than would be demanded for the original article, and so the original manufacturer may be injured. Lord Ch. HATHERLY, *House of Lords*, 1872, *Wotherspoon v. Currie*, 27 *Law Times R. (N. S.)* 393 ; S. C., *L. R. 5 Eng. & Ir. Appeals*, 508 ; S. C., 42 *Law Journal R. (N. S.) Ch.* 130 ; reversing S. C., 23 *L. Times R. (N. S.)* 443 ; S. C., 18 *W. R.* 942 ; and affirming S. C., 22 *T. R. (N. S.)* 260, and S. C., 18 *W. R.* 562.

§ 480. Where a trademark is not actually copied, fraud is a necessary element in the consideration of every question of this description—that is, the party accused of piracy must be proved to have

done the act complained of with the fraudulent design of passing off his own goods as those of the party entitled to the exclusive use of the trademark. For the purpose of establishing a case of infringement, it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as, not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trademark belongs. Lord CHELMSFORD, *House of Lords*, *Ibid.*

§ 482. In suits to restrain the fraudulent use of of a trader's name, or of a trademark, it is not necessary to give proof of actual deception; it is enough if the acts of the defendant are calculated to deceive. Nor is it necessary to find that there is any intention on the part of the defendant to mislead; that is immaterial. 1872, *V. C. Malin's Ct.*, *Hookham v. Pottage*, 26 *L. T. R. (N. S.)* 755; *S. C.*, 20 *W. R.* 720; *S. C.*, *on appeal*, 21 *W. R.* 47; *S. C.*, *L. R. 8 Ch.* 91; *S. C.*, 27 *Law T. R. (N. S.)* 595.

§ 483. It would seem to be immaterial whether an infringing trademark is adopted by fraud or mistake, for the injury is the same. 1875, *Supreme Ct. of North Carolina*, *Blackwell v. Wright*, 73 *N. C.* 310.

§ 484. Intent is immaterial. 1876, *N. Y. Supreme Ct.*, *S. T.*, *The Amoskeag Manufacturing Company v. Garner*, 4 *Am. Law Times R. (N. S.)* 176.

See also §§ 290, 291, 292, 962.

JURISDICTION.

See §§ 201, 490, 633, 791 ; see INJUNCTION.

KNOWLEDGE.

See INTENT.

LABELS.

§ 490. Labels used on vials and bottles to designate certain medicines, and the diseases cured by their use, are not books within the meaning of the copyright act. They are of no value except as labels, for which they are designed. Their publication could, by no possibility, injure the writer or author of the labels. If falsely applied to medicine, with a view to impose upon the public, and injure the inventor of the medicine, chancery will enjoin. But the circuit court of the United States cannot inquire into such a case, when both parties live in the same State. 1848, *U. S. Cir. Ct., Ohio Dist.*, *Scoville v. Toland*, 6 *West. Law Jour.* 84.

§ 491. A manufacturer has no right to the exclusive use of a particular colored paper, or kind of paper, for covering or inclosing his goods in any particular form. 1867, *N. Y. Supreme Ct., S. T.*, *Faber v. Faber*, 49 *Barb.* 357 ; *S. C.*, 3 *Abb. Pr. (N. S.)* 115.

§ 492. In an action to recover damages for an

alleged invasion, by imitation, of the plaintiff's trademark for the sale of a certain washing powder which consisted of a highly colored picture, representing a wash room, with tubs, baskets, clothes lines, etc., also the following legend interblended with it: "Standard Soap Company, Erasive Washing Powder," followed by directions for the use of the "washing powder," and the place of manufacture; the alleged imitation by defendants consisted of a picture and label which were the same as in plaintiff's alleged trademark, only in the use of the words "washing powder," the directions for the use of the powder, and in the use of paper of the same color as that used by plaintiff. *Held*, that this did not constitute an infringement of plaintiff's trademark. 1868, *Supreme Ct. of Cal.*, Falkinburg v. Lucy, 35 *Cal.* 52.

§ 493. The plaintiff, for the purpose of distinguishing the spoons of his manufacture from all other Britannia spoons sold in market, and for the purpose of designating different classes of his own goods, adopted different labels of particular size, color and form, with his own name and some term descriptive of the spoons thereon, and certain figures arbitrarily chosen, each class of spoons being indicated by fixed numbers. Said labels constituted the only trademark under which he introduced his goods into market, and under said labels and numbers his goods had become generally known in the market and had obtained a good reputation, and a large demand had grown up for them, and they were generally known by their respective numbers and generally ordered, bought and sold, by the numbers on the labels. *Held*, that the labels thus arranged and used were entitled to protection. The defendant

made spoons similar in character to those made by plaintiff, though differing somewhat in style or pattern, and prepared labels resembling the plaintiff's, and adopted the same numbers for similar kinds of spoons, the labels being so similar that an unwary trader who did not read the name upon them might be deceived. The defendant adopted said labels with the particular numbers for the purpose of aiding the introduction of his spoons into the market. *Held*, that defendant's labels were a violation of the trademark of the plaintiff, although he put his own name on the labels in the place of that of the plaintiff; and it seems that the use of the figures with a cipher prefixed would not vary the result. 1868, *Connecticut Sup. Ct.*, Boardman v. Meriden Britannia Co., 35 *Conn.* 402.

§ 494. Where the plaintiff has the right to the exclusive use of a trademark, in a particular article of manufacture, any labels used by defendants which are calculated to deceive the public into the belief that the article they are selling is the article made and sold by the plaintiff, will be restrained by injunction and the plaintiff fully protected. 1868, *N. Y. Com. Pleas, G. T.*, Curtis v. Bryan, 2 *Daly*, 312; *S. C.*, 36 *How. Pr.* 33.

§ 495. A label at common law is not a trademark, but when a manufacturer or seller of goods adopts a label to distinguish his goods from those of another, he is entitled to be protected in its use, and others will be enjoined from using the same, or a colorable imitation thereof. 1873, *Supreme Ct. of Cal.*, Burke v. Cassin, 45 *Cal.* 467.

§ 496. An imitation of a label used on goods is a false representation that the goods to which it is attached were manufactured or sold by the person

whose label was copied or imitated, and purchasers are deceived and liable to be defrauded. Case of *Falkinburgh v. Lucy*, 35 *Cal.* 52, explained. *Ibid.*

§ 497. Where a person, by a combination of elements and symbols, has produced a wrapper to enclose and designate an article manufactured by him, under which it has gone into use, he cannot be interfered with or despoiled of his lawful business by the adoption of a label by another, similar in color, size, border, ornamentation, symbol, and colored ink, and so closely an imitation, that the careless or unobservant purchaser may be readily misled. Such practices are deceptive, and have their origin in and promote dishonorable competition. In order to justify the intervention of a court of equity, it is sufficient that the imitation is so close, that a crafty vendor may palm off on the buyer the article manufactured by the latter, as that of the former. It is no answer to an application for an injunction, that in certain particulars, the label of the defendant differs from that of the plaintiff, so long as the imitation in other respects is so close, that the general appearance is the same, and purchasers have been and are likely to be deceived. 1874, *N. Y. Superior Ct., S. T., Brown v. Mercer*, 37 *N. Y. Superior Ct.* 265.

§ 498. The plaintiff imported and sold an article known as "Julienne," composed of various vegetables for making julienne soup, which was prepared and put up expressly for him by the firm of *Hollier & Co.*, in Paris. There was evidence that a similar article designated "Julienne" was prepared and put up at other establishments in France and imported to this country. Plaintiff devised a trademark or label for the article sold by him; the

device consisted of the words "conserves alimentaires," under which was the coat of arms of the city of Paris, upon either side the monogram A. C. in a circle, and underneath the words "Paris" and "Julienne," with directions for preparing for use and using. Subsequently, the defendants sold a similar article with a device in all respects like the plaintiff's device, except that the monogram was F. G. In size, type, color and appearance, the two devices were entirely alike. *Held*, that plaintiff's label as a whole was entitled to protection, and that the defendants should be enjoined. That the combination of all the words and symbols which the plaintiff had put upon his label entitled him to be protected against the appropriation and use of such combination by the defendants. 1875, *N. Y. Superior Ct., S. T., Godillot v. Hazard*, 49 *How. Pr.* 5.

See also IMITATION.

LACHES.

§ 505. A plaintiff laid by for two years before filing his bill for an injunction, having seen labels of the defendant exhibited publicly, which he now complained of as being colorable imitations of his labels. *Held*, that such laches disentitled the plaintiff to relief. 1866, *Vice Ch. Wood's Ct., Beard v. Turner*, 13 *L. T. (N. S.)* 747.

§ 506. Plaintiff's article was known as "East-court's Hop Supplement." Plaintiff brought suit to restrain defendant from using the words "East-court's Hop Essence" for a similar article, but as

he delayed commencing suit from January, 1874, to August, 1874: *Held*, that he was precluded by delay from right to relief. 1875, *Ch. Ct. of Appeal*, *Eastcourt v. Estcourt Hop Essence Company (Limited)*, 44 *L. J. R. (N. S.) Ch.* 223; S. C., *L. R.* 10 *Ch.* 276; S. C., 32 *L. T. R. (N. S.)* 80; S. C., 23 *W. R.* 313; reversing S. C., 31 *L. T. R. (N. S.)* 567.

See also ACQUIESCENCE; ABANDONMENT; LIMITATIONS.

LETTERS.

§ 510. The plaintiffs had a patent for the manufacture of case-hardened ploughshares, which they were accustomed to mark with the words "Ransome's Patent," and with the letters H. H. to denote that the shares were case-hardened, and also with certain numbers, as No. 6, to denote their size. The defendant marked his ploughs "Ransome & Co., H. H. 6;" he admitted the use of the words "Ransome & Co.," but said it had been done under belief that the patent had expired; but he claimed the right of using the letters and figures H. H. 6. An injunction was granted restraining the defendant from using said words or letters on ploughshares. 1834, *Vice Ch. Ct.*, *Ransom v. Bental*, 3 *Law Journal R. (N. S.)* 161.

§ 511. The boxes of tin plates made at particular works at Carmarthen were for a long series of years branded with the mark "M. C." S, a lessee of those works, who had used that mark while tenant of the works, subsequently removed his

manufactory to other works, at a distance of forty miles, and there used the same mark. The owner of the property, as soon as the lease expired, remonstrated against Mr. S's continuing to use the said mark, which had always been used to designate the tin plates manufactured at the Carmarthen works. The Carmarthen works were, for some years, unoccupied; but afterwards D, and others as copartners, having taken a lease of them, carried them on, and branded their boxes with the mark "M. C.," and styled themselves "The M. C. Tin Plate Company." S then obtained an injunction to restrain D and his partners from using the mark "M. C.," or the designation of "The M. C. Tin Plate Company;" but upon appeal, it not appearing certain to the court that the plaintiffs had acquired a right to prevent other subsequent tenants of the works at Carmarthen from using said mark, which was originally derived from said works, the injunction was dissolved, with liberty to S to bring an action. 1837, before Ld. Ch. COTTENHAM, *Motley v. Downman*, 3 *Myl. & Cr.* 1; S. C., 6 *Law J. R. (N. S.) Ch.* 308.

§ 512. Where plaintiffs used the words "Amoskeag Manufacturing Company, Power Loom, Yds. —, A C A, Amoskeag Falls, N. H.," and defendant the words "Lowell Premium Ticking, Power Loom, Yds. —, A C A, Warranted Indigo Blue," the shape and color of the labels being the same, an injunction was granted, restraining the defendant from using his said labels. But that part of the injunction restraining the use of any labels with the letters A C A thereon was stricken out. 1849, *N. Y. Superior Ct., S. T., Amoskeag M'fg Co. v. Spear*, 2 *Sand. Sup. Ct.* 599.

§ 513. There can be no doubt that two letters may constitute a trademark. The letters "L. L." held a trademark. 1863, Lord Ch. BRADY, *Kinahan v. Bolton*, 15 *Irish Ch. R.* 75.

§ 514. A firm originated and adopted a method of preparing whiskey, whereby a peculiar flavor was imparted, and marked the whiskey so prepared with the letters "L. L.," being the initial letters of the words Lord Lieutenant, and sold it in bottles, jars and casks, having the letters "L. L." with a ducal coronet impressed on the corks of the casks, of the bottles and jars, and also having a label affixed on the outside of the casks, bottles and jars, having printed thereon a ducal coronet and "L. L. Whiskey." Evidence was given that in the trade the letters "L. L." were understood to mean a peculiar whiskey sold by the firm of Kinahan & Sons, and not any other whiskey of the same class. It appeared that the newspaper advertisements issued by the petitioners described the whiskey sold by them as "L. L. Whiskey" simply, although on the labels those letters were always preceded by the word "Kinahan's." The Lord Chancellor said that the word "Kinahan" did not seem to have been incorporated with the trademark, but to have been inserted to say that the whiskey was made or prepared by Kinahan, and could not be had elsewhere. The respondent was restrained by injunction from using the letters "L. L." for whiskey sold by him. *Ibid.*

See also IMITATION.

See also §§ 656, 674, 751, 757.

LICENSE.

§ 520. Elias Howe, Jr., in 1846 obtained a patent for a sewing machine, and gave a license to his brother, the plaintiff, to use his patented right or combination, in the manufacture of sewing machines. Before 1857 the plaintiff placed on the machines manufactured by him his own name, "A. B. Howe." In 1857 he substituted the name "Howe" for "A. B. Howe" and subsequently every machine manufactured by him had the word "Howe" on a conspicuous place on it; such word being used to denote the plaintiff as the manufacturer, and not to denote Elias Howe, Jr., as the inventor. *Held*, 1. That the fact that the plaintiff was the licensee of the inventor and could not have manufactured his machines, without using the patented combination of the inventor, and therefore could not have manufactured them without the inventor's license, did not and could not interfere with or impair his right to adopt and appropriate a trademark to mark or distinguish the machines manufactured by him from those manufactured by other licensees of the inventor. 2. That the circumstance that licensees did use and had to use the patented right or combination of the inventor as his licensees in manufacturing their machines, did not affect the question of the right of either of such licensees to adopt and appropriate a trademark, even as against Elias Howe, Jr., as a manufacturer of sewing machines. 1867, *N. Y. Supreme Ct., G. T., Howe v. Howe Machine Co.*, 50 *Barb.* 236.

§ 521. The use of the name of a steamship line while the shippers were agents for a steamship

company, is a mere license and gives no right to its use after the agency is terminated. 1872, *Ct. of Com. Pleas, Phil. Pa.*, Winsor v. Clyde; Stetson v. Winsor, 9 *Phil.* 513.

See also ACQUIESCENCE.

LIMITATION.

§ 525. An action to recover damages for the infringement of a trademark will lie, although at the time the article was sold by the defendant, the plaintiff employed another mark and had discontinued the use of the one imitated. The wrong and injury to the plaintiff consist in the sale of an article falsely purporting and declared to be of his manufacture, and it makes no difference whether the deceit be effected by counterfeiting his present trademark, or one that he formerly used. Hence, the fact that the plaintiff had discontinued the use of his trademark for three years and had adopted a new mark, 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. 1854, *N. Y. Com. Pleas, G. T.*, Lemoine v. Gauton, 2 *E. D. Smith*, 343.

§ 526. A person who does not assent to the use of his trademark by another, cannot be deprived of his rights by omitting to bring an action for a

period of nine years. 1871, *Ch. Ct. of Appeal*, *Lazenby v. White*, 41 *Law Jour. (N. S.) Ch.* 354.

See also ACQUIESCENCE.

MARKS.

See DEVICES.

MAGAZINES.

See PUBLICATIONS.

MISREPRESENTATION.

§ 530. The plaintiff had made a new sort of mixed tea, and sold it under the name of "Howqua's mixture;" but as he had made false statements to the public, as to the teas of which his mixture was composed, and as to the mode in which they were procured (by intimating in his labels and advertisements that the mixture was made by Howqua, in Canton, and imported into England by the plaintiff, in the packages in which it was sold; that the tea which gave it its peculiar flavor was very rare and high-priced, even in China, and was grown only in the province of Kyiang Nau; and that it could not be procured in England, at any price); the court refused to restrain the defendant from selling tea under the same name, until the plaintiff

had established his title at law—and the *ex parte* injunction was dissolved, with liberty to the plaintiff to bring such action as he might be advised. 1837, *High Ct. of Chancery*, Pidding v. How, 8 *Simons*, 477.

§ 531. If a plaintiff coming for an injunction in a trademark case appears to have been guilty of misrepresentations to the public, the court will not interfere in the first instance. Accordingly, where it appeared that a Mr. *Leathart* had invented a mixture for the hair, the recipe for making which he sold to the plaintiff, who gave to the composition the name of “Medicated Mexican Balm,” and sold it as “Perry’s Medicated Mexican Balm,” and used a printed show-card in which he represented that the article was an extract of vegetable balsamic productions of Mexico, and that said composition was “*made from an original recipe of the learned J. F. Von Blumenbach,*” and recently presented to the proprietor by a very near relation of that illustrious physiologist—and the defendant commenced selling a composition which he designated and sold as “Truefitt’s Medicated Mexican Balm,” in bottles and with labels closely resembling those used by the plaintiff—an injunction was denied, with liberty to the plaintiff to commence an action at law. 1842, *Rolls Ct.*, Perry v. Truefitt, 6 *Beavan*, 66.

§ 532. It is not the office of chancery to intervene by its summary process in controversies between the vendors of a quack medicine. A complainant, whose business is imposition, cannot invoke the aid of equity against the piracy of his trademarks. The only remedy in such a case is at law. Hence, protection to the words “Dr. Wistar’s

Balsam of Wild Cherry'' was refused. 1847, *U. S. Cir. Ct., Pa.*, *Fowle v. Spear*, 7 *Penn. L. J.* 176.

§ 533. If the label contain a misrepresentation by the use therein of the name of a former proprietor it will not alter the case that the complainant purchased the right to use that name. The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce. 1848, *N. Y. Ct. of Appeals*, *Partridge v. Menck*, 1 *How. App. Cas.* 547.

§ 534. The complainant's label contained the words "A. Golsh's Friction Matches," when, in truth, Golsh had no concern or interest in the business, and had left the country. *Held*, that the label contained a misrepresentation on its face, and would not be protected by injunction. That it is no sufficient answer that the complainant obtained from Golsh the secret of the manner in which his matches were prepared, or that he manufactured an article in all respects equal to that offered by Golsh, the former proprietor. Nor does it alter the case that the complainant purchased the right to use the name of A. Golsh. The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce; and at all events, if the maxim that he who asks equity must come with pure hands, is not altogether obsolete, the complainant has no right to invoke the aid of a court of chancery in favor of such a monopoly. *Ibid.*

§ 535. The wrappers and pamphlets of the plaintiff's article contained extravagant representations as to its universal curative effects, but as the labels and wrappers used by the defendant were similar in form to and copied from those used by the plaintiff, the defendant was restrained from the use of

the simulated labels and wrappers by injunction. 1850, *Rolls Ct.*, *Holloway v. Holloway*, 13 *Beav.* 209.

§ 536. The court refused to grant an injunction at the suit of Flavell, to restrain Harrison from making and selling a stove by the name of "Flavell's Patent Kitchener," on the ground, first, that Flavell had falsely assumed to describe the article as being patented; and, secondly, that he had known of the use of the name by Harrison four months before he had applied for an injunction. But the court, not deciding whether Flavell had or had not a legal remedy, retained the bill, giving him liberty to bring an action. 1853, *Vice Ch. Wood's Ct.*, *Flavell v. Harrison*, 10 *Hare*, 467; S. C., 19 *Eng. L. & Eq.* 15; S. C., 17 *Jurist*, 368.

§ 537. The plaintiffs, who had purchased the patent and the right to use the name of T. & Co., the patentees of solid-headed pins, and also the labels, &c., used by T. & Co. for said pins, continued, after the expiration of the patent, to use labels on their goods, printed from the original blocks formerly belonging to the patentees, on which label the goods were described as patented. The defendants adopted and issued labels closely resembling those of the plaintiffs. And under such circumstances, although the description of the plaintiff's goods on their labels, as being patented, had ceased to be strictly true, and although the labels announced that the pins were "exclusively manufactured by T. & Co.," when in fact they were not manufactured at all by T., who had long since retired, the court granted an injunction restraining the defendants from using labels bearing an inscription appearing to designate the goods

contained therein as being manufactured by the plaintiffs. 1853, *Vice Ch. Wood's Ct.*, *Edelston v. Vick*, 11 *Hare*, 78; S. C., 18 *Jurist*, 7; S. C., 23 *Eng. Law & Eq.* 51.

§ 538. Chancery will not interfere by injunctions in questions of trademarks between the venders of patent medicines, being quack medicines; such questions having too little merit on either side. Hence, protection to the word "Kathairon" was refused. 1855, *Heath v. Wright*, 3 *Wall. Jr. U. S. Cir. Ct., Pa.*

§ 539. It is no defense to an action brought to restrain the defendants' use of the plaintiff's trademark upon an article intrinsically valuable, that the trademark in question is false and fraudulent, used by the plaintiff with intent to deceive, and that the article which is accompanied by it is not what the trademark indicates it to be. Certain trademarks, owned by plaintiff, containing these words, respectively, one of them, "H & M's patent thread, Barnsley," and the other, "G & W's celebrated patent thread, Berwick;" *Held*, that the fact that the threads were not patented, and were not made by the persons whose names they bore, nor by their assignees or successors, nor at the places designated on the trademarks, but that the trademarks were false and fraudulent, constituted no defense, and, therefore, a motion to amend the answer by inserting allegations to that effect, was properly denied. 1856, *N. Y. Com. Pleas, S. T.*, *Stewart v. Smithson*, 1 *Hilt.* 119.

§ 540. A court of equity will not interfere to protect a party in the use of a trademark where the name claimed as such is intended and calculated to deceive the public. It may be true that the de-

defendants, if permitted to use, in their contemplated sales, a trademark apparently the same as the plaintiff's, would commit a fraud upon the plaintiffs and upon the public; but if the plaintiffs are themselves engaged in the execution of a systematic plan for deceiving the public, if they have been, and still are, endeavoring, constantly and daily, to multiply their sales and swell their profits by false representations of the composition, qualities and uses of the liquid compound which they invite the public to buy, they cannot be listened to when they complain that, by the fraudulent rivalry of others, their own fraudulent profits are diminished. An exclusive privilege for deceiving the public is assuredly not one that a court of equity can be required to aid or sanction. To do so would be to forfeit its name and character. 1857, *N. Y. Superior Ct., S. T., Fetridge v. Wells*, 4 *Abb. Pr.* 144; S. C., 13 *How. Pr.* 385; See *Fetridge v. Merchant*, 4 *Abb. Pr.* 156.

§ 541. Where it appears in an action to restrain an infringement of plaintiff's trademark, that defendant has deliberately and without any previous connection with the particular business, adopted the emblems and appellations employed by plaintiff, simply to break in upon the trade and profit of the latter, in such cases, notwithstanding that it may appear to the court that the trademark claimed by the plaintiff was intended and calculated to deceive the public, the question should be judged of solely as between the immediate parties, and the public should be left to its own guardianship. 1857, *N. Y. Superior Ct., S. T., Fetridge v. Merchant*, 4 *Abb. Pr.* 156. See *Fetridge v. Wells*, 4 *Abb. Pr.* 144; S. C., 13 *How. Pr.* 385.

§ 542. The legislature having passed an act to

punish and prevent fraud in the use of false stamps and labels, and it being the policy of the law to protect the rights of individuals in respect to their own inventions, labels and devices, it would seem to be implied, since the legislature and the courts are thus sedulous to protect the rights of individuals in respect to their own inventions, labels and devices, that such individuals should not themselves attempt or allow any imposition upon the public by the false and fraudulent use of such labels, devices, names or inventions, for the sale of spurious or simulated articles. Accordingly held, that it was an offense against the spirit of the law, equally injurious to trade and commerce, and equally an imposition upon the public, to palm off spurious goods under the cover of genuine labels and devices; and that contracts to do this were clearly against public policy, and should not be upheld and enforced by the courts. A contract for the sale and purchase of a quantity of empty papers or bags for seeds with the plaintiff's label thereon, to be filled with seeds of good quality by the purchaser, and the seeds thus put up to be offered for sale by the purchaser of such papers in a specified county, and not elsewhere, was therefore held to be void. 1857, *N. Y. Supreme Ct., G. T., Bloss v. Bloomer*, 23 *Barb.* 604.

§ 543. If the pills are an innocent humbug, the defendants have no right to deprive the plaintiffs of the reputation and customers which the plaintiffs' money has been the means of acquiring for the pills and themselves; especially in this case, where the expenditure was in a great measure induced by the defendant. It does not appear that the pills are positively injurious; but it is not for

the defendants to say that the plaintiffs are humbugging the public and are therefore not entitled to any relief against them, when the defendants have been, and still are engaged in the same work. As to the public: if the pills are an innocent humbug, it is doubtful whether it is the duty of the court, on the questions of the property, of right and wrong between the parties, to step outside of the case and abridge the innocent individual liberty, which all persons must be presumed to have in common, of suffering themselves to be humbugged. 1860, *N. Y. Supreme Ct., S. T., Comstock v. White*, 18 *How. Pr.* 421.

§ 544. The courts will not interfere by injunction, to protect a party in the use of trademarks, which are employed to mislead the public, and to deceive them by fraudulent representations contained in the labels and devices which are claimed to constitute wholly or in part such trademarks. The court does not refuse its aid in such a case from any regard to a defendant, who is using the same efforts and misrepresentations to deceive the public. Hence, where the plaintiff's label was calculated to induce the belief that the article in the box on which it was pasted was manufactured in London, and that the sole proprietors of it had their place of business in London, and that the plaintiff was their sole agent for the United States, when in fact the article was made in New York and the plaintiff was not the agent, but the manufacturer and proprietor, and injunction was denied. 1860, *N. Y. Superior Ct., S. T., Hobbs v. Francis*, 19 *How. Pr.* 567.

§ 545. While it is true that a court of equity will not interfere preliminarily by injunction and

protect a person in an exercise of his right to a trademark or label, manifestly devised and intended to cheat the public in the purchase of the article to which it may be attached, by representing the thing to be of a different substance from that of which it really consists, or by stating untruthfully its origin, properties or qualities; or when the articles to which they are affixed are of very doubtful character and quality; nevertheless, in a case where the plaintiff's title to the trademark has been legally established, and the label is manifestly one not intended to delude the public in the purchase of an article by making any representations or asserting anything in respect to its qualities or properties, which are untrue, and is not used with any fraudulent intent, and the public is not in fact deceived, the plaintiff will be entitled to protection by injunction against the use by defendant of similar labels, although the plaintiff's trademark bears a fictitious name as the name of the manufacturers of the article. Hence, Thomas Nelson Dale was protected by injunction in the exclusive use of the following label: "Courtria Flax; Thomas Nelson & Co. Warranted Fast Colors, et 16 oz." 1861, *N. Y. Com. Pleas, G. T., Dale v. Smithson*, 12 *Abb. Pr.* 237.

§ 546. A trademark describing the articles on which it is impressed as "patented" is a proper one, if the statement was true at the time the mark was adopted, though the patent has been allowed to drop before its expiration. 1863, *V. C. Wood's (L., Leather Cloth Company (Limited) v. Hirschfeld*, 1 *New R.* 551. But see *Leather Cloth Company (Limited) v. American Leather Cloth Company (Limited)*, *infra*, § 548.

§ 547. Where the plaintiffs advertised their perfume as the extract of the "Night Blooming Cereus, distilled from this rare and beautiful flower, from which it takes its name," and the perfume was an alcoholic compound, not an extract from the flower,—*Held*, that this was a deception, intended to impose upon the public by exciting curiosity to learn the nature of the perfume of the rare and beautiful flower, and that a court of equity would not aid him in carrying it on. 1864, *Phalon v. Wright*, 5 *Philadelphia*, 464 (*Penn.*).

§ 548. Misrepresentations in a trademark, amounting to a fraud upon the public, will disentitle the person making such misrepresentation to protection in a court of equity against a rival trader; and, as a general rule, a misstatement of any material fact calculated to impose upon the public, will be sufficient for the purpose; *e. g.*, a trademark representing an article as protected by a patent, when in fact it is not so protected, or a trademark falsely representing an article as the production of an artist of special skill, or of a place of special adaption. 1865, *House of Lords*, *Leather Cloth Company (Limited) v. American Leather Cloth Company (Limited)*, 35 *Law J. R. (N. S.) Ch.* 53; S. C., 11 *House of Lds. Cases*, 523; 12 *Law T. R. (N. S.)* 742; S. C., 6 *New R.* 209; S. C., 13 *Weekly R.* 873; S. C., 11 *Jurist (N. S.)* 513; affirming S. C., 33 *Law J. R. (N. S.) Ch.* 199; S. C., 12 *Weekly R.* 289; S. C., 9 *L. T. R. (N. S.)* 558; S. C., 10 *Jurist (N. S.)* 81; and reversing S. C., 1 *H. & M.* 271; S. C., 32 *Law J. R. (N. S.) Ch.* 721; S. C., 11 *Weekly R.* 931; S. C., 8 *Law Times R. (N. S.)* 829.

§ 549. The plaintiffs purchased from a firm established in the United States, knowledge of a

secret mode of making crucibles, which had acquired a reputation in America as "Patent Plumbago Crucibles," although the process had never been patented. *Held*, that the plaintiffs could not maintain a bill to restrain others from pirating this designation. That the use of the word "Patent" by the plaintiffs was calculated to mislead and defraud the public with whom they were dealing, and that therefore they would not be protected in its use. 1866, *V. C. Wood, Morgan v. M'Adam*, 36 *Law Jour. (N. S.) Ch.* 228.

§ 550. In such a state of things, the court, whatever may be the conduct of the defendant, does not ask whether or not it shall interfere to restrain a defendant, but it must see in the first instance, before it reaches the defendant's case, whether or not the plaintiff has made such a case as to entitle him to the court's assistance. All that the court has to determine is, has the plaintiff, who comes to seek relief, any ground whatever for asking the court to assist him in protection of that right which he sets up? If the court finds it to be a right founded upon fraud, the court says it cannot assist a person in carrying on a fraud; and when he comes and cannot establish to the satisfaction of the court that he has a case in which he is entitled to relief, he is told that when he has entitled himself by a proper description to protection in regard either to a trademark or any trade designation of that kind, he will be assisted; but until then, the court must disregard altogether any supposed wrong which he may suffer from other persons carrying on the same system of fraud that he carries on, imitating him in the false description of what

they sell, or in the title of the company under which they and he falsely profess to exist. *Ibid.*

§ 551. Defendant procured a label very closely resembling plaintiffs' and commenced to attach it to a perfume manufactured by him, adopting the same name and style of packages, with the intention of counterfeiting plaintiffs' trademark, as well as imitating the article and style of packages used, and with the design of appropriating to himself the market obtained for the plaintiffs' article. The plaintiffs in connection with their label put forth a puff in which it was stated that "The opoponax is a native flower from Mexico, of rare and very rich fragrance, *from which this extract is distilled,*" &c. Several perfumers on the part of the defendant made affidavit that plaintiffs' article was not distilled from the flower of opoponax, but was a compound of essential oils, combined with pure spirits, and that there was a resinous gum in the market, of a disagreeable odor, but no flowers of opoponax. Plaintiffs and their claimants swore the perfume was made from said flower. *Held*, that upon this contradictory state of the evidence, the defendant's defense that the plaintiffs are attempting to impose upon and defraud the public was not available and that defendant should be enjoined. 1867, *N. Y. Supreme Ct., G. T., Smith v. Woodruff*, 48 *Barb.* 438.

§ 552. The justice and morality of this defense is not very high, in the present instance; but this rule of law or equity has been recognized in several cases, and must be followed if the case is brought within its application. It is a defense that ought to be suggested by the court in some cases, and probably would be in all cases where the imposition is flag-

rant. For instance, where a quack compounds noxious and dangerous drugs, hurtful to the human constitution, and advertises them as a safe and sure remedy for disease; or when some charlatan avails himself of the prejudice, superstition, or ignorance of some portion of the public, to palm off a worthless article, even when not injurious, the case falls beneath the dignity of a court of justice to lend its aid for the redress of such a party, who has been interfered with by the imitations of another quack or charlatan. But the suggestion comes with a poor grace from one who has, by the imitation, been guilty of the same fraud or imposition upon the public, if such it happens to be. *Per* LEONARD, P. J. *Ibid.*

§ 553. A person who in and by his trademark makes representations which deceive the public, cannot appeal to the equitable interposition of a court of equity to restrain the use of such deceptive trademark by another. But a mere false or exaggerated statement in an advertisement of the manufactured article, and not contained in the trademark itself, tending to recommend its use to the public, will not deprive the owner of a right to be protected in the exclusive use of his trademark. Hence, where an advertisement of the plaintiff's article (called "Mrs. Winslow's Soothing Syrup") contained these words: "Mrs. Winslow, an experienced nurse and female physician, presents to the attention of mothers her Soothing Syrup," whereas the truth was, that Mrs. Winslow had been for many years dead, and the defendant denied that Mrs. Winslow had been an experienced nurse and female physician: *Held*, that the statements in said advertisement did not affect the plaintiff's

trademark one way or the other. 1868, *N. Y. Com. Pleas, G. T., Curtis v. Bryan*, 2 *Daly*, 312, and 36 *How. Pr.* 33.

§ 554. A person who has fraudulently imitated the trademark of another, and offered for sale his own goods as those of the owner of the trademark, can not be heard to raise the objection that the latter's goods are injurious to health. The acts of the party conclude him. *Ibid.*

§ 555. The ground on which the jurisdiction of equity in trademark is vested, is the promotion of honesty and fair dealing, because no one has a right to sell his own goods as the goods of another. There is no class of cases to which the maxim "He who comes into equity must come with clean hands" can more properly be applied. A party who attempts to deceive the public by the use of a trademark, which contains on its face a falsehood as to the place where his goods are manufactured, in order to have the benefit of the reputation which such goods have acquired in the market, is guilty of the same fraud of which he complains in defendants who imitate his mark. He can have no claim to the extraordinary interposition of a tribunal constituted to administer equity, for the purpose of securing to him the profits from his fraudulent act. It is not necessary that any one person has been actually deceived or defrauded; it is enough that it is a misrepresentation calculated to have that effect on the unwary and unsuspecting. A trademark on Spanish cigars made in New York, indicated that they were made in Havana. *Held*, that an injunction would not be granted to restrain a counterfeit of the trademark. 1869, *Supreme Ct. of Pa., Palmer v. Harris*, 60 *Pennsylvania*, 156.

§ 556. The use of the word "patent" as part of the description in a label or trademark of goods not protected by a patent, is not such a misrepresentation as to deprive the owner of his right to be protected against an infringement of his label where the goods have, from the usage of many years, acquired the designation, in the trade generally, of patent. 1869, *V. C. James' Court*, Marshall v. Ross, *Law R. 8 Eq.* 651; S. C., 21 *Law Times R. (N. S.)* 260; S. C., 17 *Weekly R.* 1086; S. C., 39 *Law J. R. (N. S.) Ch.* 225.

§ 557. The plaintiffs instituted a suit to restrain the defendant from using the name "The Pall Mall Guinea Coal Company" in Pall Mall. The defendant, amongst other grounds of defense, set up a case that the plaintiffs habitually served short weight upon their customers, and deceived their customers also in the character of the goods supplied. *Semble*, if these allegations had been supported by the evidence, which was held not to be the case, they would have disentitled the plaintiffs to come to the court of chancery. 1869, *Before Lord Justice Gifford on appeal*, Lee v. Haley, 18 *Weekly R.* 242; S. C., *L. R. 5 Ch.* 155; S. C., 22 *Law T. (N. S.)* 251; S. C., 39 *Law J. R. (N. S.) Ch.* 284. But see S. C., *Before V. C. Malins*, 18 *Weekly R.* 181, S. C., 21 *Law Times (N. S.)* 546.

§ 558. Although where suit is brought for the infringement of a trademark which is itself a falsehood and calculated to deceive and mislead the public as to the true character of the article sold under it, equity will not relieve; yet where there is no intention to deceive and no falsehood is used, an injunction will issue. Where the trademark discloses truly the place of manufacture and sale

of the goods, and substantially the true ownership of them, the fact that the name on the label is not the exact name of the manufacturers, owing to changes in the persons manufacturing after the manufacture was commenced, will not debar the plaintiffs of their injunction. *Held*, that the difference between Jos. Dixon & Co., as printed on the labels and the Jos. Dixon Crucible Company, the name of the manufacturer and vender of the goods, was not of such a character as to destroy the plaintiffs' right to equitable relief. 1870, *Ct. of Com. Pleas., Phil. Pa.*, Dixon Crucible Co. v. Guggenheim, 2 *Brewster*, 321, *Penn.*; S. C., 7 *Phila.* 408.

§ 559. A joint stock company took its name from the names of four of its principal stockholders. Subsequently an act of the legislature was passed requiring the names of corporations to begin with the word "The" and end with the word "Company;" but nothing in the act required a change in the names of existing corporations. The retention of a name without such words, thereby indicating a partnership instead of a corporation, after the passage of the act, held not to be such a misrepresentation as to render it inequitable for a court of equity to protect the corporation in the use of its name against infringement by a rival company. After a period of more than fifteen years, the persons whose names appeared in the corporate name of such joint stock company ceased their connection with the corporation. The retention of the name subsequently, held not to import a representation that the company still had the benefit of the skill and experience of the persons named. 1870, *Supreme Court of Errors of Conn.*, Holmes

v. Holmes, Booth & Atwood Manf. Co., 37 *Connecticut*, 278.

§ 560. Trademark cases will be adjudicated only upon the rights of parties before the court, and as between their conflicting claims, and not with a view to the guardianship of the public upon the merits or demerits of *nostrums*, except in cases where injury to the public health or morals enters into the ingredients of the allegations. 1871, *Supreme Ct. of Ga.*, *Ellis v. Zeilin*, 42 *Ga.* 91.

§ 561. The court of chancery will not interfere by injunction to restrain the imitation of a trademark, if there is false representation in the trademark, or if the trade itself is fraudulent. And, *semble*, such false representation or fraud would be a good defense to an action at law for imitation of the trademark, on the ground that *ex turpi causâ non oritur actio*. But a collateral misrepresentation by the owner of the trademark will not disentitle him to relief, either at law or in equity. 1872, *Ford v. Foster*, *Law R. 7 Ch. Ap. Cas.* 611; *S. C.*, 27 *L. T. R. (N. S.)* 219; *S. C.*, 41 *L. J. R. (N. S.) Ch.* 682; *S. C.*, 20 *W. R.* 318; reversing *S. C.*, (BACON, V. C.,) 20 *W. R.* 311.

§ 562. In a case where the plaintiff, whose trademark was "Ford's Eureka Shirt," had falsely represented in his invoices and in a few advertisements that he was a "patentee" of the shirt: *It is held*, that such false representation was not sufficient to prevent him from sustaining an action at law; and that, his right at law being clear, he was entitled to an injunction in chancery. *Ibid.*

§ 563. Where fraud and falsehood on the part of the plaintiff are relied on as a forfeiture of his title to relief in equity for a violation of a trade-

mark, it must result from direct proof, and not mere crimination or argument. 1872, *U. S. Circuit Ct. Va.*, Blackwell *v.* Armistead, 5 *Am. Law Times*, 85.

§ 564. Trademarks intended to deceive and practice a fraud upon the public, will not be protected by a court of equity. G. W. Laird instituted this action against J. B. Wilder & Co. to enjoin them from counterfeiting his trademark. Injunction refused. In this case the design of the bottle, and the label of "Laird's Bloom of Youth or Liquid Pearl," a compound prepared and sold by G. W. Laird, were unwarrantably adopted by J. B. Wilder & Co., to mislead the public by inducing the belief that the compound prepared and sold by them was identical with that of G. W. Laird, and the imitation was so nearly exact as to be well calculated to produce that effect. On the facts the court held, that the plaintiff in putting his compound on the market as he did, with his express as well as implied assurance to the public that it was "free from all mineral and poisonous substances," deliberately engaged in the perpetration of a fraud, which in a court of equity should be rebuked rather than upheld or protected. To a party thus presenting himself, a court of equity, adhering to the maxim that "*he who asks equity must come with pure hands*," will not lend its aid when the object to be effected is to secure to himself the exclusive privilege of deceiving the public in a particular way, although in doing so it might prevent another equally guilty from committing the same wrong. 1872, *Ct. of Appeals, Kentucky*, Laird *v.* Wilder, 9 *Bush*, 131.

§ 565. Equity will not protect a trademark which

deceives the public ; but that deception need not be of such a character as to work a positive injury to purchasers, nor, on the other hand, will the fact that some erroneous impression may be received by the public, be suffered to destroy the validity of the trademark. If the representation of the trademark does not in fact mislead the public, and may be understood in any reasonable sense as substantially true, the trademark will be entitled to protection. 1872, *Sup. Ct. of Errors*, Meriden Britannia Co. v. Parker, 39 Conn. 450.

§ 566. As it appeared that the Rogers brothers superintended the petitioners' spoon and fork manufactory, directed as to the style and quality of such goods, and had the general supervision of the manufacturing and sale thereof, it was held that the representation contained in the trademark on the goods manufactured by the Meriden Britannia Company, that the Rogers brothers were the manufacturers, was true in a certain sense, to wit : that the goods were the production of their skill, judgment and experience, and therefore the misrepresentation, if any, was not of such a character as to defeat the petitioners' claim to the exclusive use of the trademark. *Ibid.*

§ 567. *It seems*, that a business which is, to a certain extent, a fraud upon the public, such as the palming off of an alcoholic beverage in common use exclusively as a medicine and as a specific for certain diseases, under a name not generally understood by the community, is not entitled to the aid of a court of equity, and that the name will not be protected as a trademark. CHURCH, Ch. J., 1874, *N. Y. Court of Appeals*, Wolfe v. Burke, 56 N. Y. 115.

§ 569. Complainants used to distinguish jars, the

designations “*Mason’s Patent, Nov. 30th, 1858,*” “*Mason’s Improved,*” “*The Mason Jar of 1858.*” It appeared that the jars had been protected by a patent that had been adjudged to be invalid. *Held,* that the designations had a tendency to mislead the public, and could not therefore, be protected as trademarks. In respect of the designation “*The Mason Jar of 1872,*” the objection held not to be applicable. 1874, *U. S. Circuit Ct., Penn., Consolidated Fruit Jar Company v. Dorflinger,* 2 *Am. Law Times (N. S.)* 511

§ 570. S. C., deceased, and plaintiff, G. C., jointly took out letters patent for a filter, which they allowed to drop, but continued to affix to their filters, “*G. C.’s improved patent gold medal, self-cleansing, rapid water filter, Boston.*” Defendant commenced to sell filters of similar shape, inscribed “*S. C.’s patent prize medal, self-cleansing, rapid water filter, improved and manufactured by W. P. & Co.*” *Held,* that plaintiffs had acquired a right to protection of their inscription as a trademark, and that the use of “*patent*” therein did not avoid such right. 1876, *Ch. Div. Vice Ch. Bacon, Cheavin v. Walker,* 35 *Law Times (N. S.)* 757; S. C., 46 *Law J. R. (N. S.) Ch.* 265.

§ 571. The plaintiffs’ trademark or label was affixed to bottles containing quantities of brandy less than pints and quarts. Nothing appeared upon the bottles or the trademark to indicate that the bottles contained quarts and pints, and there was nothing in their appearance or form to deceive or impose upon any one. They were transparent, and any one looking at them could see the quantity they contained. It did not appear that the bottles in the trade were ever used as the measure of quan-

tity, or that they were ever sold or bought as actually containing quarts or pints. The plaintiffs were manufacturers and wholesale dealers in the brandy, and the bottles, when imported in this country, were entered at the custom house with a statement of the true quantity contained in them. There was no proof that any purchasers from the plaintiffs purchased upon the faith that the bottles actually contained quarts and pints, or that such purchaser did not understand perfectly their capacity. There was no proof that the plaintiffs ever represented to any one that the bottles contained quarts and pints, or that they ever deceived or imposed upon any one, or that any dealers ever sold the bottles as containing more than by measure they actually contained. It did not appear that the trademark was used or could be used by plaintiffs to impose upon or deceive any one, or that they carried on their business for a dishonest purpose, or in such way as to cheat or defraud any one. It was not questioned that the brandy was genuine and just what it purported to be, and *although in the complaint the bottles were described as quart and pint bottles*, they appeared to be of the ordinary size used in the liquor trade. *Held*, that it might be assumed that the brandy in the bottles was sold by the bottle and not by measure. That as plaintiffs shipped their brandy to different parts of the world the fact that a quart differs in size in various countries showed it to be impracticable to use bottles actually containing measure quarts and pints. That as the brandy was put up in bottles of convenient size, and sold by the bottle in this country, they might be called quart and pint bottles because they were nearest in size to those measures, and the

designation was sufficiently accurate for the purposes of trade, and that no one would be necessarily or actually deceived. That the case was therefore not one where it could be said that plaintiffs came into court with unclear hands and guilty consciences, and must therefore be denied equitable relief; that the case was not one where the trademark was used to deceive or impose upon the public, or where it was used upon a spurious, worthless or deleterious compound, or where the business in which it was used was carried on systematically in a dishonest and fraudulent way; in such cases courts will not lend their aid to protect trademarks. Judgment of court below denying injunction on ground of misrepresentation reversed, and a new trial ordered. 1877, *N. Y. Court of Appeals*, *Hennessey v. Wheeler*, not yet reported; reversing S. C., 51 *How. Pr.* 457.

§ 572. The plaintiffs claimed the exclusive right to the use of the word "Capcine" as used in their trademark "Benson's Capcine Plasters," and filed a bill to restrain the defendants from using the word "Capsicin" for a similar article. "Although the plaintiffs may have omitted the fraudulent and deceptive and untrue language from their circulars before this suit was commenced, yet if they have any property in their trademark which they claim title to, they acquired such property by the use, for a considerable time, of such language in the circulars which accompanied the articles they sold, and in respect to which the trademark is claimed. Such language was to the effect that 'a celebrated chemist had recently discovered a vegetable principle of great value, and, prior to making it generally known, had introduced it into hospitals, and had generously

extended its use to the most successful physicians ; that the flattering and astonishing results which characterized its action, at once stamped it as the most remarkable principle ever discovered ; that this powerful remedy was named Capcine, and that it was used in plasters prepared by the plaintiffs, and called Benson's Capcine Plasters'. A registered trademark is claimed in the word 'Capcine.' Courts of equity refuse to interfere in behalf of persons who claim property in a trademark acquired by advertising their wares under such representations as those above cited, if they are false. It is shown there is no such article as Capcine known in chemistry, or medicine, or otherwise. The authorities are clear that in a case of this description a plaintiff loses his right to claim the assistance of a court of equity. The motion for an injunction is denied." 1877, *U. S. Circuit Ct. N. Y.*, *Seabury v. Grosvenor*, unreported.

See also §§ 152, 225, 824.

NAME.

- I. In general, § 580, *et seq.*
- II. How far one may be restrained from the use of his own name in business, § 600, *et seq.*
- III. Corporate name, § 630, *et seq.*
- IV. Descriptive name and words, § 640, *et seq.* (and see WORDS, § 1010, *et seq.*).
- V. Fancy name, § 680, *et seq.*
- VI. Geographical name, § 705, *et seq.*
- VII. Patentee, name of, § 731, *et seq.*
- VIII. Partnership name, see PARTNERSHIP, § 780, *et seq.*
- IX. Names of buildings, see BUILDINGS, § 160, *et seq.*, SIGNS, § 940, *et seq.*
- X. Nom de plume, see § 886.

I. *In general.*

§ 580. The provisional directors of a joint stock company, having, without the authority of the plaintiff, published a prospectus, stating him to be a trustee of the company, were restrained by injunction. 1847, *Rolls Court*, Routh *v.* Webster, 10 *Beav.* 561.

§ 581. A court of equity will protect by injunction the name of an enterprise undertaken for the amusement of the public. The use of the name "Christy's Minstrels" protected. 1856, *New York Supreme Ct. S. T.*, Christy *v.* Murphy, 12 *How. Pr.* 77.

§ 582. It is to protect a party's right of selling his own, that the law of trademarks has been introduced. The right must include the privilege of selling to all, to the incautious, as well as to the cautious. Any false name that is assumed in imitation of a prior true name, is in violation of this right, and the use of it will be restrained by injunction. Hence the use of the word "company" in the mark "Brooklyn White Lead & Zinc Company," by the defendant, who had no such company, in imitation of the trademark of the plaintiff, an incorporated company, was restrained by injunction. 1857, *N. Y. Supreme Ct. G. T.*, Brooklyn White Lead Company *v.* Masury, 25 *Barb.* 416.

§ 583. Whether a manufacturer can acquire an absolute right in a name as a name merely, and whether the words or name "Aramingo Mills" can be protected as a trademark, doubted. 1860, *Ct. of Com. Pleas, Phil. Pa.*, Colladay *v.* Baird, 4 *Phil.* 139.

§ 584. It would be impossible to lay down any general rule as to when persons in business are entitled to use the names of others in the same business. The court has always purposely avoided doing so, that they might not thereby open a door to fraud. But the general principle is, that the court will always interfere where there has been a fraudulent use of the name. Before the court will interfere to prevent one trader from making fraudulent use of the name of another, it requires to be satisfied not only that the course taken by the defendant is calculated to deceive the public but that representation has been made to him by the plaintiff that it will have that effect. If after such representation the defendant persists in continuing the use of the name in the same manner, then on the plaintiff's bringing the case before the court, the court would be justified in saying that that which was not fraudulent at first became so by the defendant's persisting in the same course, and that therefore the plaintiff would be entitled to relief. 1865, *Vice Ch. Wood's Court, Williams v. Osborne*, 13 *L. T. (N. S.)* 498.

§ 585. The actual physical resemblance of the two marks is not the sole question for the court, for if the plaintiff's goods have, from his trademark, become known in the market by a particular name, the adoption by the defendant of a mark or name which will cause his goods to bear the same name in the market, is as much a violation of the plaintiff's rights as the actual copy of his mark. 1866, *Before Lord Chancellor CRANWORTH on appeal, Seixo v. Provezende*, *Law R.* 1 *Ch.* 192; *S. C.*, 12 *Jurist (N. S.)* 215; *S. C.*, 4 *Weekly R.* 357; *S. C.*, 14 *Law Times (N. S.)* 314.

§ 586. Although the defendant may have some title to the use of a mark or name, he will not be justified in adopting it, if the probable effect of his so doing is to lead the public to suppose, that in purchasing his goods they are purchasing those of the plaintiff. *Ibid.*

§ 587. A person may acquire a valid trademark in his own Christian name, as a designation of his place of business, which will be protected by injunction. *N. Y. Superior Ct., S. T., Staudinger v. Staudinger, 19 Leg. Int. 85.*

§ 588. The name of an inventor, or discoverer, or manufacturer, may be employed as a part of a trademark. It may give to other parts of the appellation a distinctive character, or rather, it may make words distinctive that without the name would not be. The words "Dr. J. M. Lindsey's Improved Blood Searcher" were held to be a legitimate trademark, and entitled to protection in a court of equity. 1867, *Sup. Ct., Penn., Fulton v. Sellers, 4 Brews. 42.*

§ 589. No right can be absolute in a name as a name merely. It is only when that name is printed or stamped upon a particular article and thus becomes identified with a particular style and quality of goods, that it becomes a trademark. Hence, therefore, the fact that the defendant had suggested the name of "Heroine," to the plaintiff for his jars, was held to be immaterial, when he had not used the name until after the plaintiff had used it and established for it a reputation and value—and the defendant was enjoined from the use of said name on his jars. 1868, *Phil. Com. Pleas, Pa., Rowley v. Houghton, 2 Brewster, 303; S. C., 7 Phila. 39.*

§ 590. The plaintiffs had carried on for some

years at No. 22 Pall Mall, under the style of "The Guinea Coal Company" a large business, which had a considerable reputation. They were also frequently spoken of as "The Pall Mall Guinea Coal Company." In March, 1869, the defendant, who had been their manager, set up a rival business in Beauford Buildings, Strand, under the name of "The Pall Mall Guinea Coal Company," and at the end of August removed it to No. 46 Pall Mall. On November 24, the plaintiffs finding that many persons had been misled into giving orders to the defendant in the belief that his concern was that of the plaintiffs, filed their bill to restrain him from trading under the above style, or any other colorable imitation of the plaintiffs' business style. The defendant, among other grounds of defense, alleged, that the plaintiffs had no exclusive right to the name "Guinea Coal Company," which was used by various other establishments about London. Vice Chancellor MALINS granted an injunction restraining the defendant from using the name "The Pall Mall Guinea Coal Company" in Pall Mall. On appeal by defendant: *Held*, that although the plaintiffs had no exclusive right to the name, the injunction had been properly granted, on the ground that the defendant had no right to use the name in such a way as to lead persons to believe that his business was that of the plaintiffs, and that therefore there was no objection to confining the injunction to the use of the name in a particular place, inasmuch as its tendency to deceive greatly depended on the place where it was used. 1869, *Before Lord Justice Gifford on appeal*, *Lee v. Haley*, 18 *Weekly R.* 242; S. C., *L. R.* 5 *Ch.* 155; S. C., 22 *Law Times R. (N. S.)* 251; S. C., 39

Law J. R. (N. S.) Ch. 284; affirming S. C., 18 *Weekly R.* 181; S. C., 21 *Law Times R. (N.S.)* 546.

§ 591. The name and address of the manufacturer combined, may constitute a trademark which will entitle him who adopts it to protection in its exclusive use, but neither the name nor the address singly will be sufficient for protection; both must be used. 1870, *Supreme Ct. of Illinois*, *Candee v. Deere*, 54 *Ill. R.* 439. See §§ 22, 740.

§ 592. A name has for certain purposes a commercial value. If the proprietor estimates that value, and sells it to another person, to the extent and for the purposes for which he sold it, he has no right to use it. 1871, *Ct. of Com. Pleas, Phil. Pa.*, *Gillis v. Hall*, *Ayer v. Hall*, 3 *Brews.* 509; S. C., 8 *Phila.* 231; S. C., 1 *Leg. Gaz.* 124.

§ 593. It is unlawful to put up imitation goods under the name of the real manufacturer, and the excuse that such an act was authorized by a person of the same name as that manufacturer, is absurd. 1872, *Supreme Ct. of Louisiana*, *Wolfe v. Barnett*, 24 *La. An.* 97.

§ 594. Title to property in the name "Keystone Line," acquired by many years' certain, exclusive appropriation and use of it by shippers of merchandise, who did not own the vessels employed by them, will be protected in equity. 1872, *Ct. of Com. Pleas, Phila. Pa.*, *Winsor v. Clyde*, *Stetson v. Winsor*, 9 *Phila.* 513.

See also, §§ 283, 878.

II. *How far one may be restrained from the use of his own name in business.*

§ 600. Where plaintiff marked his goods "Sykes' Patent," to show that they were his own

manufacture, and defendant copied the mark on his goods to show that they were plaintiff's manufacture, and sold the goods so marked as and for plaintiff's manufacture; *Held*, that case would lie for the injury, though plaintiff and the defendant were both named "Sykes," and neither of them had in fact a valid patent, and that a verdict for the plaintiff would be sustained where the evidence was, that the persons to whom the defendant sold the goods knew that they were not manufactured by the plaintiff, but that the defendant copied plaintiff's mark, and sold the goods so marked, in order that the purchasers might re-sell them as and for goods manufactured by plaintiff, and which they did. 1824, *King's Bench*, *Sykes v. Sykes*, 3 *Barn. & C.* 541; *S. C.*, 5 *Dowl. & Ryd.* 292.

§ 601. The right which any person may have to the protection of the court, does not depend upon any exclusive right which he may be supposed to have to a particular name, or to a particular form of words. His right is to be protected against fraud, and fraud may be practiced against him by means of a name, though the person practicing it may have a perfect right to use that name, provided he does not accompany the use of it with such other circumstances as to effect a fraud upon others. A blacking manufactory had long been carried on under the firm name of Day & Martin, at 97 High Holborn. The executors of the survivor continued the business under the same name. A person of the name of Day, having obtained the authority of one Martin to use his name, set up the same trade at 90½ Holborn Hill, and sold blacking as of the manufacture of Day & Martin, 90½ Holborn Hill, in bottles and labels having a general resemblance to

those of the original firm, and in a manner calculated to mislead the public. He was restrained by injunction. 1843, *Rolls Ct.*, *Croft v. Day*, 7 *Beav.* 84.

§ 601*a*. In a suit for an injunction against the use by defendants of a certain name and mark upon their goods, the defendants admitted the use of the name and mark, but said that it was their true name, and that they were entitled so to use it; the plaintiffs, without moving for an injunction, went into evidence in equity. At the hearing of the cause, the court, being of opinion that the evidence did not establish the plaintiff's right to the injunction, but that it showed the defendants to have used the name and mark in question on their goods, in a manner which might lead purchasers to understand falsely, that the goods were manufactured by the plaintiffs, gave the plaintiffs the option either of having the bill dismissed against them without costs, or having the right tried at law. The bill being retained for a year, with liberty to the plaintiffs to bring an action at law, the action was brought and the plaintiffs recovered a verdict. The court then granted the injunction and ordered the defendants to pay the costs at law and in equity, except the costs of the evidence in equity. 1847, *Vice Chancellor's Ct.*, *Rodgers v. Nowill*, 6 *Hare*, 325; and see S. C., 5 *Com. Bench.* (*M. G. & S.*) 109; S. C., 11 *Jurist*, 1037; S. C., 17 *L. J. R. N. S.* (*C. P.*) 52.

§ 602. The plaintiff, Thomas Holloway, sold a medicine as "Holloway's Pills." The defendant, Henry Holloway, commenced selling pills as "H. Holloway's pills," but in boxes, &c., similar to the plaintiff's, and with a view of passing off his pil's

as the plaintiff's. The pill boxes and pots were similar in form to, and the labels and wrappers were copied from, those used by the plaintiff. The defendant was restrained by injunction. 1850, *Roll's Court, Holloway v. Holloway*, 13 *Becc.* 209.

§ 603. Where a person is selling an article in his own name, fraud must be shown to constitute a case for restraining him from so doing on the ground that the name is one in which another has long been selling a similar article. Therefore, where a father had for many years exclusively sold an article under the title of "Burgess's Essence of Anchovies" the court would not restrain his son from selling a similar article under that name, no fraud being proved. 1853, *Burgess v. Burgess*, 3 *De G. M. & G.* 896; S. C., 17 *Jur.* 292; S. C., 22 *Law Journal R. (N. S.) Chanc.* 675; S. C., 17 *Eng. L. & Eq.* 257.

§ 604. Where the plaintiff and the defendant have nearly the same names and are engaged in the same business, each has the right to use his own name, and a party will not be restrained by injunction from using his own name, unless he so use it as to mislead. 1857, *N. Y. Supreme Ct., G. T., Clark v. Clark*, 25 *Barb.* 76.

§ 605. Where a firm name, as "J. & P. Coats" in connection with certain symbols, has acquired the properties of a trademark, it is not an infringement for two other individuals bearing the same name, to adopt the style of "J. & T. Coats" to designate goods of the like description, provided they do not use it in connection with the residue of the trademark of the former firm. *Coats v. Platt*, 17 *Leg. Int.* 213; S. C., 7 *Pitts. L. J.* 361.

§ 606. A defendant sold tobacco pipes packed in boxes or cases, upon which were labels or descriptions of a similar character to those of the plaintiff, using the plaintiff's name as being the real manufacturer, the defendant having a person in his employ of that name: *Held*, that such colorable imitation and use of the labels and descriptions could be restrained by injunction. 1865, before V. C. Wood, *Southorn v. Reynolds*, 12 *Law T. R. (N. S.)* 75.

§ 607. The court will not enjoin a defendant from using his own name in the prosecution of a manufacturing business, because it is similar to that of a rival manufacturer in the same business. Any injury which one manufacturer may suffer by competition of other persons of the same name, from the use of such name merely, is without a remedy. 1867, *N. Y. Supreme Ct., S. T.*, *Faber v. Faber*, 49 *Barb.* 357; *S. C.*, 3 *Abb. Pr. N. S.* 115.

§ 608. A manufacturer has a right to adopt and appropriate his surname as a trademark; and another manufacturer of the same article, though his surname is the same, has no right to use his own surname in such a way as to deceive the public and deprive the former of the benefit of the notoriety and market which his articles have gained. 1867, *N. Y. Supreme Ct., G. T.*, *Howe v. Howe Sewing Machine Co.*, 50 *Barb.* 236.

§ 609. The plaintiff's preparations were known to the trade and public generally as "Stonebreaker's medicines." One Dr. Stonebreaker, a brother of the plaintiff, engaged with the defendants in the sale and preparation of medicines known as "Dr. Stonebreaker's Medicines," using on their wrappers and labels the language of the plaintiff

on his wrappers and labels, and printing on the wrappers of some of their medicines the certificates given to the complainant in recommendation of his preparations. The evidence in the case showed that the whole agreement between all of the defendants was but a combination to deceive the public and to enable them to obtain for their medicines the benefit of the celebrity which the plaintiff's preparations and medicines had in the market, at the expense of the plaintiff and in fraud of his rights. *Held*, that although Dr. Stonebreaker had a right to enter into an agreement with anybody to manufacture and sell his own medicines, he had no right to lend or sell his name to perpetrate an injury upon his brother, and a fraud upon the public. The defendants were restrained by injunction from using the name Stonebreaker in titles of preparations and medicines the same as those used by the plaintiff. 1870, *Maryland Court of Appeals*, *Stonebreaker v. Stonebreaker*, 33 *Md.* 252.

§ 610. Plaintiff manufactured an article called "Lazenby's Harvey's Sauce." Defendant employed a person of the name of Charles Lazenby to assist in manufacturing a sauce which he called "Lazenby's Harvey Sauce," and put up with labels resembling the plaintiff's. It was assumed at the hearing that the word "Harvey's Sauce" was not itself a trademark, but a name open to the public. *Held*, that defendant might represent himself as the proprietor and maker of a Harvey Sauce, and to represent himself as the maker of a Harvey Sauce made according to a recipe purchased from a Mr. Charles Lazenby, or to represent that there was a connection by relationship between Charles Lazenby the vendor, and Elizabeth Lazenby, the original

proprietor of it ; but that the defendant was not entitled to use his present labels, or to represent his business as being carried on at No. 6 Edwards Street, or to represent that his sauce was the "original sauce" or the "original Lazenby's Sauce" or "Lazenby's Sauce, the original." 1871, *Ch. Ct. of App.*, Lazenby *v.* White, 41 *L. J. (N. S.) Ch.* 354.

§ 611. The defendant sold his right to use his own name on a preparation known as "Hall's Vegetable Sicilian Hair Renewer." A decree of the court enjoined the defendant from using the name of "Hall" or "R. P. Hall" upon any such preparation as aforesaid. The defendant commenced the manufacture and sale of an article, which he designated "R. P. Hall's Improved Preparation for the Hair," and added upon the label that the new article was not the original article. Upon a rule to show cause why an attachment should not issue against him for a contempt in disregarding the decree of the court: *Held*, that a name has for certain purposes a commercial value. If the proprietor estimates the value and sells it to another person, to the extent and for the purposes for which he sold it, he has no right to use it. That the use of the name "R. P. Hall" by the defendant was a palpable piracy of plaintiff's trademark, and a clear evasion of the decree. 1871, *Ct. of Common Pleas, Phila. Pa.*, Gillis *v.* Hall; Ayer *v.* Hall, 3 *Brews.* 509; S. C., 1 *Leg. Gaz. R.* 124; S. C., 8 *Phila.* 231.

§ 612. Any person who by fair means has gained the knowledge of a trade secret, may, after the death of the original inventor, make and sell the article under the name of the original inventor, pro-

vided such person does nothing to induce the public to believe that the article sold by him is made by the successor of the original inventor. A member of the family of R. J., the original inventor of a secret preparation, having by fair means become possessed of the original recipe, made and sold the article by the name given to it by the original inventor, under the signature of R. J., his own name being R. J. J. *Held*, that he was not entitled, as against the successor of the original inventor, to sell the article under the signature of R. J., simply, or to represent that his was the only genuine preparation. 1872, *James v. James*, *Law R.* 13 *Eq.* 421; S. C., 20 *W. R.* 434; S. C., 41 *Law J. R.* (N. S.) *Ch.* 353; S. C., 26 *L. T. R.* (N. S.) 568.

§ 613. H by agreement sold the use of his name to C, and C manufactured goods marked "H & C." On C's death, which terminated the agreement, C's son continued to manufacture goods with the same mark. H forbade him to use his name under said agreement or in any way, and C's son replied that he had made arrangements with another person named H, to use his name in connection with his own. *Held*, that the plaintiff, having no interest in the business, had no right in any trademark used in it, and could not therefore maintain a bill to restrain the use of the name of Hallett & Cumston as a trademark; nor to restrain the use of his name under the Gen. Sts. of Mass., c. 56, §§ 3, 4, in the absence of a distinct and sufficient allegation that the defendant used the name of H. with intent to represent it to be the name of the plaintiff, and thereby to defraud and injure him. 1872, *Supreme Jud'l Ct. of Mass.*, *Hallett v. Cumston*, 110 *Mass.* 29.

§ 614. Theodore J. and John H. McGowan were

manufacturers of pumps, and partners in business under the name of "McGowan Brothers." John H. sold out all his interest in the business and assets of the firm to Theodore J., including the old patterns, with the name "McGowan Brothers" on them, and Theodore J. was to assume the liabilities and succeed to the business of the firm, and associate with himself others if he chose. After the contract of sale was executed, there was inserted in the notice of dissolution a privilege to Theodore J. of using the old firm name, as to which there had been no previous negotiation. Theodore J., with others, procured a certificate of incorporation, under the name "The McGowan Brothers Pump and Machine Company," and transferred to the said corporation all his rights and interest as purchased from John H. *Held*, that John H., who set up a similar business by himself, was entitled to an injunction to restrain the corporation from the use of "McGowan Brothers" in its name; the use of the old firm name, granted to Theodore, being in the nature of a revocable license. That the old name is not a trade mark to be used by the corporation; and while it has a right to use the old patterns and sell the castings with the name "McGowan Brothers" on them, it cannot hold out by the corporate name, that *all* the articles made by it are in part the product of the skill and labor of John, or that the corporation is in fact the old firm. That a well-founded apprehension of injury is sufficient to warrant an injunction, where the act, if completed, must give a ground of action. 1872, *Superior Ct. of Cincinnati, O.*, McGowan Bros. Pump and Machine Co. v. McGowan, 2 *Cin.* 313.

§ 615. The petitioners' spoons and forks were

manufactured under the supervision of the Rogers brothers and were stamped "1847, Rogers Bros. A. 1." The respondent acquired the right from other persons, named Rogers, to stamp the name of Rogers on plated spoons and forks manufactured by respondent for himself and them. He stamped the goods so manufactured "C. Rogers Bros. A. 1." and "C. Rogers & Bros. A. 1." These stamps resembled the petitioners' trademark to such an extent that they were calculated to deceive, and did in fact deceive, unwary purchasers, and the respondent sold large quantities of his own goods thus stamped, upon the reputation of the petitioners' goods, stamped with their trademark. *Held*, that the respondent's trademarks were infringements of the petitioners' trademark, and that the petitioners were entitled to an injunction restraining their further use by the respondent. The court declined, however, to prohibit absolutely the use of the name "Rogers," inasmuch as that name might be used in such a manner as not to constitute an infringement of the petitioners' trademark. The court also declined to prohibit absolutely the sale by the respondent of goods bearing the stamp in question, which were on hand at the time the petition was served, and also goods at that time in process of manufacture and which had been stamped, as such goods might be sold to purchasers who would not be misled by the stamps, and some injustice might be done to the respondent by such absolute prohibition—leaving the petitioners to their remedy at law for any injury that might be actually done by the sale. 1872, *Sup. Ct. of Errors, Conn.*, Meriden Britannia Co. v. Parker, 39 *Conn.* 450.

§ 616. A man cannot make a trademark of his

name to the exclusion of a like use of it by another of the same name, the use of it by the latter being fair, and unaccompanied by contrivances to deceive. 1873, *N. Y. Supreme Ct., G. T., Wolfe v. Burke*, 7 *Lans.* 151; *S. Ct.*, reversed on another point, 56 *N. Y.* 115.

§ 617. "There was lately before me, and before the court of appeal, who affirmed my decision, the *Annatto* case, *Fullwood v. Fullwood*. In that case the uncle, the plaintiff, had got the original business. The nephew, the defendant, set up the same business, and used a label so like his uncle's that I had great difficulty in saying, even on the label itself, that there was not a case for interference. Upon the whole, I am inclined to think the court would not have interfered upon the label alone, as his name was *Fullwood*, and he did make annatto, as long as he remained at a distance. At all events, the uncle did not ask for the interference of the court on that ground; but nothing would do but that, like the defendant in the *Guinea Coal Company* case, he must remove from the place where he had been carrying on his business, into the same small street in which his uncle carried on his business. Then, there being a combination of the name, a similarity of the labels, and the same place of manufacture, I thought, and in that I was affirmed by the court of appeal, that it was a case for the interference of the court, because I was of opinion that he could not have removed into that street, of all streets in the world, except for the purpose of availing himself of the name and reputation of his uncle." *Malins, V. C., Fullwood v. Fullwood*, cited in *L. R.* 17 *Eq.* 40.

§ 618. Plaintiffs, who were two brothers, carried

on business at West Troy, Albany county, N. Y., as bell founders, under the firm name of "E. A. & G. R. Meneely." This business had been established by Andrew Meneely, the father of the plaintiffs, who had acquired an extended reputation of great value as a manufacturer of bells, and which had by his last will been given to plaintiffs. Defendants, one of whom was a brother of plaintiffs, after the father's death, began the manufacture of bells under the name of "Meneely & Kimberly" at Troy, Rensselaer county, N. Y. The defendants by the use of the name "Meneely" expected and intended to derive a profit and advantage from the good reputation and celebrity in bell founding given to that name by Andrew Meneely. In an action to restrain defendants from the use of the name of "Meneely" in the bell business, *held*, (1) that equity would not interfere to prevent defendant, Meneely, from the use of his own name in such business, no fraud or intention to injure plaintiffs or deceive the public being shown, even though he intended to derive advantage from such name; (2) that there was not such a resemblance in the names of the firms as would of itself tend to deceive the public or indicate a fraudulent purpose; (3) that the location of defendants' business was not of itself evidence of an attempt to deceive the public, or an interference with plaintiffs business. 1874, *N. Y. Supreme Ct., G. T., Meneely v. Meneely*, 1 *Hun*, 367; S. C., 3 *T. & C.* 540; S. C., affirmed, 62 *N. Y.* 427.

§ 619. Andrew Meneely, by his will, after making certain specific legacies, devised all the remainder of his estate, both real and personal, to the plaintiffs, charging them with the support and mainte-

nance of his children during the minority of the youngest of them, and with the payment of certain legacies, and he states that in so doing, he has taken into view "that I leave them conveniences for carrying on a successful business, and the good will and custom which it is believed is established and connected with it."

Held, (1) that there is a distinction between appropriating the good will of a business of a deceased father, carried on in a particular locality, and enjoying the benefit of his name and reputation as a man of skill and fair dealing; (2) that there was nothing in the language of the will, which conferred upon the plaintiffs the exclusive use of the name of Meneely in the business of bell founding. *Ibid.*

§ 620. If the defendants were using the name of Meneely with the intention of holding themselves out as the successors of Andrew Meneely, and as the proprietors and managers of the old-established foundry which was being conducted by the plaintiffs, and thus enticing away the plaintiffs' customers; and if with that intention they used the name in such a way as to make it appear to be that of the plaintiffs' firm, or resorted to any artifice to induce the belief that the establishment of the defendants was the same as that of the plaintiffs, and, perhaps, if without any fraudulent intent they had done acts calculated to mislead the public as to the identity of the establishments, and produce injury to the plaintiffs beyond that which resulted from the similarity of name, then the cases referred to sustain the proposition, not that a court of equity would absolutely restrain the defendant Meneely from the use of his own name in any way or form, but simply that the court would enjoin him from

using it in such a way as to deceive the public and injure the plaintiffs. The manner of using the name is all that would be enjoined, not the simple use of it, for every man has the absolute right to use his own name in his own business, even though he may thereby interfere with or injure the business of another person bearing the same name, provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead. Where the only confusion created is that which results from the similarity of the names the court will not interfere. A person cannot make a trademark of his own name and thus obtain a monopoly of it which will debar all other persons of the same name from using their own names in their own business. *N. Y. Ct. of Appeals, Ibid., 62 N. Y. 427.*

§ 621. Plaintiff sold a cosmetic known as "Gourard's Oriental Cream or Magical Beautifier," and claimed those words as his trademark, and that the defendants infringed his rights by using the words "Creme Orientale" and adding thereto "by Dr. T. F. Gourard's Sons." Plaintiff was known by the name of Dr. J. W. Trust for a number of years, and the defendants, his sons, were known by that name. Three years before the commencement of this action, plaintiff's name was changed to Trust Felix Gourard. The defendants were enjoined. 1875, *N. Y. Supreme Ct. Genl. T., Gourard v. Trust, 3 Hun, 627.*

§ 622. Plaintiffs for a long time had been engaged in business in New York City as manufacturers of pianos, under the firm name of Decker Brothers, and their pianos had acquired much celebrity.

Defendants since 1871, had been in the same business, in the same place, under the firm name of Decker & Barnes, and defendant Decker prior to that time had been engaged in the same business under the name of Decker & Co. The defendants caused to be registered and recorded as a trademark, in the patent office, the words: "*The Decker Piano.*" Plaintiffs sought to enjoin defendants from the use of said trademark, claiming it was obtained for the purpose of misleading the public, and that it was an artifice calculated and intended to induce purchasers to believe that defendants were solely entitled to use the name of Decker, and that the pianos manufactured by them were those of the plaintiffs. Defendants claimed that their pianos were known in the trade as Decker pianos, long before the plaintiffs acquired a reputation as the manufacturers of pianos. All the equities in the complaint and plaintiffs' affidavits were denied and rebutted by the answer and affidavits of defendants. Motion for injunction *pendente lite* denied. 1876, *N. Y. Supreme Ct., S. T., Decker v. Decker*, 52 *How. Pr.* 218.

§ 623. The plaintiffs' trademark consists of the words "Prince's Metallic Paint," used in a particular form. The defendants, for their trademark, use the words "Prince Bros. Iron Ore Paint," in an entirely different form. Prince is the name of the defendants; they are brothers, and they manufacture and sell a paint which they call "iron ore paint." The injunction restrains them from using the name "Prince," as applied to the paint manufactured by them, "or upon any label, card, bill-head, or any advertisement." The order is altogether too broad. The use of their own name in connection with their business, in any form that

does not infringe the plaintiffs' trademark, cannot be enjoined. But I think that defendants' trademark is no infringement of the plaintiffs'. There is no similitude between the trademarks except the word "Prince," and that is only used to indicate that Prince Bros. are the manufacturers of iron ore paint, and not, I think, to hold out to purchasers that theirs is a Prince' metallic paint made by plaintiffs. Motion denied and injunction order dissolved, with ten dollars costs of opposing. 1877, *N. Y. Supreme Ct., S. T., Prince Metallic Paint Company v. Carbon Metallic Paint Company*, unreported.

See also §§ 144, 689, 949.

III. *Corporate name.*

§ 630. The plaintiff, "The London and Provincial Law Assurance Society," was projected in the year 1845, and its deed of settlement was registered in November, 1846. Some time afterwards another insurance company, the defendant in the suit, called "The London and Provincial Joint Stock Life Insurance Company," was projected and completely registered on June 20, 1847. A motion was made by the plaintiff, to restrain the defendant from using the words: "London and Provincial." The Vice Chancellor refused to grant the injunction, on the grounds that it was a fair question whether the plaintiff was likely to suffer any injury, and whether there had been such a length of user by the plaintiff as to entitle it to complain, but gave the plaintiff leave to bring an action at law. 1847, *Vice Chancellor's Ct., London and Provincial Law Assurance Society v. London and Provincial Joint*

Stock Life Insurance Company, 11 *Jurist*, 938; S. C., 17 *Law J. R. (N. S.) Ch.* 37.

§ 631. The corporate name of a corporation is a trademark from the necessity of the thing, and upon every consideration of private justice and public policy, deserves the same consideration and protection from a court of equity. A corporate name is a necessary element of a corporation's existence, and any act which produces confusion or uncertainty concerning such name, is well calculated to injuriously affect the identity and business of the corporation. 1870, *U. S. Circuit Court, Newby v. Oregon Central R. R. Co.*, 1 *Deady*, 609.

§ 632. The right to a corporate name does not rest in parol, but is shown by the record and is triable by inspection thereof in any form of proceeding. Therefore, a court of equity will not refuse to enjoin the use of such name because the right to the same has not been established at law. *Ibid.*

§ 633. The jurisdiction to enjoin the use of a corporate name does not depend upon the insolvency of the defendant. *Ibid.*

§ 634. Where the name of a manufacturing corporation designates the origin and ownership of goods manufactured by it, it will be protected in the use of its name to the same extent and upon the same principle that individuals will be protected in the use of trademarks. Where a corporation, with the consent of its principal stockholders, has embodied the names of such stockholders in the corporate name, the right to use the name so adopted will continue during the existence of the corporation. Another corporation subsequently formed, and composed in part of the same persons, will have no right so to use the names of such per-

sons as to mislead those dealing with them into the belief that the two companies are the same. 1870, *Supreme Court of Errors of Connecticut, Holmes v. Holmes, Booth & Atwood Manf. Co.*, 37 *Conn.* 278

§ 635. In 1853 the plaintiff corporation was organized under the joint stock laws of Connecticut, taking the name "Holmes, Booth & Haydens"—being the names of its principal corporators or promoters. Two of them, Israel Holmes and J. C. Booth, whose names appear in the corporate title, by long experience had acquired considerable skill and reputation in the manufacture of brass, the business for which the corporation was organized. Thus organized, the corporation established and carried on a successful business, and their corporate name acquired a valuable reputation in the public markets of the country. Most of the respondent's corporators were officers, stockholders and employees of the plaintiff corporation. One after another resigned his office or position, and sold out his stock and secretly organized and put in operation a rival company (in 1869) which bought the entire property of a similar corporation in a neighboring town and located themselves permanently in the same town with the petitioners, established their depots for the sale of their goods in New York and Boston as near as practicable to the depots of the petitioners, and organized under the corporate title of "The Holmes, Booth & Atwood Manufacturing Company." The similarity of the names of the two companies resulted in confusion of their correspondence, mistakes in the delivery of orders, goods, &c., and the court below found that "by reason of this similarity, dealers in the market are likely to be confused and misled into the belief that the

companies are the same." *Held*, that the respondents should be restrained by injunction from the use of their said title. *Ibid.*

§ 636. Plaintiff, a manufacturing company, had long applied its corporate name, "The Amoskeag Manufacturing Company," to numerous kinds of cotton goods, but had never made prints. Sometimes its full name appeared upon the labels affixed to its goods, at other times the word "Amoskeag," and again "A. M. Co." or "A. M. C." Defendant used the word "Amoskeag" on prints: *Held*, that plaintiff was entitled to an injunction restraining the defendant from such use of its corporate name. 1876, *N. Y. Supreme Ct. Special Term*, *The Amoskeag Manufacturing Company v. Garner*, 4 *Am. Law Times R. (N. S.)* 176. See 56 *Barb.* 151, and 6 *Abb. Pr. (N. S.)* 265.

IV. *Descriptive name and words.*

§ 640. The plaintiff's father prepared and sold a medicine called "Dr. Johnson's Yellow Ointment," for which no patent had been obtained. The plaintiff, after his father's death, continued to sell the same. The defendant sold a medicine under the same name and mark, but no evidence was given of the defendant having sold it as if prepared by the plaintiff. *Held*, that no action could be maintained against him by the plaintiff. 1783, *King's Bench*, *Singleton v. Bolton*, 3 *Douglas*, 293.

§ 641. There is no exclusive right in the manufacture and sale of a medicine, and therefore the sale by another person of a medicine under the same title as the plaintiffs' will not be prevented—provided the defendant does not represent his art.

cle to be the same as the plaintiffs. 1813, *Before the Vice Chancellor, Canham v. Jones*, 2 V. & B. 218.

§ 642. The bill stated that Isaac Swanson was the owner of the recipe for preparing Velno's Vegetable Syrup, which he bequeathed to the plaintiff, who continued its manufacture and sale. The defendant, a former servant of Swanson, manufactured and sold a spurious composition under the name of Velno's Vegetable Syrup, and stated by him in advertisements and handbills, to be the same medicine in quality and composition as that made by Swanson and the plaintiff. General demurrer to the bill allowed. *Ibid.*

§ 643. Where certain medicines are designated by the name of the inventor, as a generic term, designating their general character, the inventor is not entitled to the exclusive right of compounding or vending them, unless he has a patent therefor; and if another person prepares such medicines of an inferior quality, and sells them, and by this means all medicines of that class are brought into disrepute, such inventor can maintain no action for any loss sustained by him in consequence thereof, unless he sold them, or placed them in the hands of others to sell, as and for the medicines made by the inventor, so that persons purchasing the same supposed and believed they were purchasing the medicines made and prepared by the inventor. Protection of the words "Thomsonian medicines" as a trademark refused. 1837, *Supreme Jud'l Ct. of Mass., Thomson v. Winchester*, 19 *Pick.* 214.

§ 644. There is no exclusive right in the use of marks, symbols or letters, which indicate the appropriate name, mode, or process of manufacture, or the peculiar or relative quality of the fabric manu-

factured, as distinguished from those marks which indicate the true origin or ownership. 1849, *N. Y. Superior Ct., S. T., The Amoskeag Mfg. Co. v. Spear*, 2 *Sandf. Sup'r Ct.* 599.

§ 645. No exclusive right to the use of words, marks, or devices, which do not denote the goods or property or particular place of business of a person, but only the nature, kind, or quality, of the articles in which he deals, can be acquired. There is obviously no good reason why one person should have any better right to use them than another. They may be used by many different persons at the same time, in their brands, marks, or labels on their respective goods, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article could be defrauded. Hence, the court refused to protect the use of the words "Cylinder," "Lake," "New York," and "Galen." 1853, *N. Y. Supreme Ct., S. T., Stokes v. Landgraff*, 17 *Barb.* 608; *affi'd at G. T., Sept. 1854.*

§ 646. A name may, in some cases, be rightfully used and protected as a trademark. But this is only true where the name is used as indicating the true origin or ownership of the article offered for sale; never where it is used to designate the article itself, and has become by adoption and use its proper appellation. 1857, *N. Y. Superior Ct., S. T., Fetridge v. Wells*, 4 *Abb. Pr.* 144; *S. C., 13 How. Pr.* 385. See *Fetridge v. Merchant*, 4 *Abb. Pr.* 156.

§ 647. When a new preparation or compound is offered for sale, a distinct and specific name must necessarily be given to it. The name thus given to it, no matter when or by whom imposed, becomes by use its proper appellation, and passes as such

into one common language. Hence, all who have an equal right to manufacture and sell the article, have an equal right to designate and sell it by its appropriate name, the name by which alone it is distinguished and known, provided each person is careful to sell the article as prepared and manufactured by himself and not by another. When this caution is used, there is no deception of which a rival manufacturer, not even the manufacturer by whom the distinctive name was first invented or adopted, can justly complain; and so far from there being any imposition upon the public, it is the use of the distinctive name that gives to purchasers the very information which they are entitled to have. In short, an exclusive right to use, on a label or other trademark, the appropriate name of a manufactured article, exists only in those who have an exclusive property in the article itself. This, however, is a species of property unknown to the law, and that can only be given to one by the infringement of the rights of all. *Held*, that the plaintiffs have no exclusive property in the words "Balm of Thousand Flowers." *Ibid.* But see *Petridge v. Merchant*, 4 *Abb. Pr.* 156.

§ 648. Where a person forms a new word to designate an article made by him, which has never been used before, he may obtain such a right to that name as to entitle him to the sole use of it as against others who attempt to use it for the sale of a similar article; but such an exclusive use can never be successfully claimed of words in common use previously, as applicable to similar articles. Words as used in any language cannot be appropriated by any one to his exclusive use to designate an article sold by him similar to that for which

they were previously used. That is, no person can acquire a right to the exclusive use of words, applied as the name of an article sold by him, if in their ordinary acceptation they designate the same or a similar article. *Held*, that as it was very doubtful whether plaintiff had any right to the exclusive use of the name "Schiedam Schnapps" for gin, and his right being denied by the defendant, that a preliminary injunction restraining the use of those words by defendant should be dissolved. 1859, *N. Y. Supreme Court, S. T.*, Wolfe v. Goulard, 18 *How. Pr.* 64. But see §§ 661, 664, 1029.

§ 649. No dealer in any commodity can be protected by injunction in the exclusive use simply of a name by which to designate it, which does not express the origin, ownership, or place of manufacture or sale of the article, but merely its quality, kind, texture, composition, utility, destined use or class of consumers, or some other attribute which it has in common with other similar commodities. Hence, the term "Club House," as a designation for gin, was not protected, it being established that such name had been long in use as designating a superior kind of gin used in such establishments. 1860, *N. Y. Superior Court, G. T.*, Corwin v. Daly, 7 *Bosw.* 222.

§ 650. The court will restrain the use by a third party of an arbitrary fancy name, which a plaintiff has invented and applied to a particular class of goods as sold by him and which has thus become identified with the plaintiff's goods. But where the plaintiff invents or discovers a product to which he gives a name, not as a fanciful but as a descriptive name, and it becomes identified with the plaintiff's goods, so that, by the use of the

name alone, his goods would be referred to, not because they are the plaintiff's, but because he alone as patentee can make and sell them, the defendant will not be enjoined from using the name fixed upon by the patentee, for similar goods, manufactured in such a way as not to infringe the patent. Hence, the use of the words "Paraffine Oil" was not enjoined. 1862, *Vice. Ch. Wood's Ct.*, *Young v. Macrae*, 9 *Jurist (N. S.)* 322.

§ 651. A word which is the *name* of the article, or indicates its quality, is not capable of an exclusive use as a trademark. Every one has the right to manufacture the same article and to call it by its name or descriptive character. In doing so, there is no violation of propriety or of truth, nothing which intrudes upon the distinctive province of others. Were it otherwise, monopolies might be created which would be destructive of the freedom of trade. Hence, any one has the right to make an extract from the flower known as "The Night Blooming Cereus," and to call it what it is, by the name of the flower, and his use of those words will not be enjoined. 1864, *Ct. of Com. Pleas, Phil. Pa.*, *Phalon v. Wright*, 5 *Phil.* 464.

§ 652. Words that do not denote the goods or property or particular place of business of the plaintiff, but only the nature, kind or quality of the article in which he deals, are never the subjects of trademarks. Hence, no title can be acquired to the words "Old London Dock Gin." But where the name of the manufacturer is appended to such title and a style of bottle and label used which have a general resemblance of form, symbols and accompaniments to those of the plaintiff, and are therefore calculated to deceive the public, the plain-

tiff will be protected by injunction. 1865, *N. Y. Com. Pleas, S. T.*, *Binninger v. Wattles*, 28 *How. Pr.* 206.

§ 653. A trademark, which is merely descriptive of the kind of articles or goods to which it is applied, is not a trademark in a legal sense, and is not entitled to protection as such. Hence, where the name of "Holbrook" and "Holbrooks," as applied to school apparatus, had become generic, and descriptive merely of the class of articles manufactured to elucidate astronomy, geography and geometry in schools, protection to said names was refused. 1866, *Superior Ct. of Chicago*, *Sherwood v. Andrews*, 5 *Am. Law Reg. (N. S.)* 588.

§ 654. In 1847, Baron Von Liebig discovered and published a process for making an extract of meat. The extract was made extensively at the Royal Pharmacy, Munich, and sold there, with the permission of the baron, as Liebig's extract of meat, from 1861 to 1864. It became generally known in Germany and other countries, and the term Liebig's extract of meat became used as a term of art in scientific treatises. In 1864, Baron Liebig gave the Fray Bentos Company the right of using his name in connection with the extract of beef manufactured by them. In 1864, the plaintiff's company bought the business and property of the Fray Bentos Company, and by a deed poll, dated April 12, 1866, the baron granted to the plaintiff's company the exclusive right and privilege to use his name in connection with the extract manufactured by them. The defendants, who had previously sold extract manufactured by the Fray Bentos Company, in 1866, began to sell as "Liebig's extract of meat" an extract manufactured by a Mr. Tooth, in Australia, after Liebig's process. On a suit being instituted

by the plaintiff's company to restrain the defendants from so using the name Liebig's extract of meat, the court *held*, that the term having been used as a term of art to designate a well known process before 1861, the defendants were fully justified in using it, and the bill was dismissed with costs. 1867, *Vice Ch. Wood's Ct.*, Liebig's Extract of Meat Company (limited) *v.* Hanbury, 17 *Law Times R. (N. S.)* 298.

§ 655. A manufacturer cannot acquire a special property in an ordinary term or expression, the use of which as an entirety is essential to the correct and truthful designation of a particular article or compound. Thus, a dealer in salt fish can not maintain an exclusive claim to the use of the term "dressed cod-fish" as a trademark. It is a sequence of the right of each party to dress cod-fish that he may sell the article thus produced, under the designation which is strictly appropriate to the altered or modified condition of the principal ingredient. A dealer may distinguish his "dressed cod-fish" as the "Bismarck" or the "Von Buest," or by the prefix of any other proper name or common word not previously applied in that connection, and not essential to the truthful designation of the article produced, and he will be protected in its exclusive use. But he can no more acquire a special property in the word "dressed," as applicable to an article which has undergone that process, than he can to the words "dried," "preserved" or "pickled," as applied to that which has, in fact, been thus treated. It appearing that no attempt had been made to deceive the public or to palm off the defendant's dressed cod-fish as that of the plaintiffs' manufacture, the temporary in-

junction was dissolved. 1868, *N. Y. Com. Pleas, S. T., Town v. Stetson*, 5 *Abb. Pr. (N. S.)* 218; S. C., affirmed, 3 *Daly*, 53.

§ 656. Although, by the long continued use of certain letters, figures, words, marks or symbols, which do not, of themselves, and were not designed to indicate the origin or ownership of the goods to which they are attached, but only to designate the nature, kind or quality of the different varieties of the article, and because so marked, the goods have become known as those of the manufacturer who first used them, such fact cannot alter the original meaning of the words or symbols, or the intent with which they were first used, as denoting the name of the thing, or its general or relative quality, or take from others the right to employ them in the same sense. So where a manufacturer of plows placed upon them, for the purpose of designating the size, shape, and quality of the different plows upon which they were respectively branded, the letters and figures in their combinations as follows: "A No. 1, A X No. 1, No. 1, X No. 1, No. 3, and B No. 1," it was *held*, he had no exclusive right to their use for such purpose, but they could be used by any other manufacturer of plows, in the same combinations, to indicate like varieties of the same article. 1870, *Supreme Ct. of Illinois, Candee v. Deere*, 54 *Ill.* 439.

§ 657. The defendants resisted an application for an injunction to restrain an alleged violation of a trademark on the ground (among others) that the plaintiff's trademark was composed of letters, words and characters denoting the quality of the article to which they were affixed. RAND, J.: "I find some authorities that hold there can be no

exclusive right to a trademark, which only denotes the quality of the article manufactured. I believe, however, the weight of authority is the other way. The later, and it seems to me, the better authorities, establish the proposition that a trademark may be composed in part, if not entirely, of words, letters and characters, that denote the quality of the article. If a trademark is once established, I hold, whatever its design, it will, to some extent, necessarily indicate to the public the quality of the article. But if I am mistaken in this, still I am of opinion that the plaintiff's trademark does designate much more than the simple quality, or quantity of the flour in the barrel, and therefore is entitled to protection from infringement." 1871, *Indianapolis Superior Ct. S. T.*, *Sohl v. Geisendorf*, 1 *Wilson*, 60 (*Ind.*).

§ 658. No one has a right to appropriate a sign or symbol which from the nature of the fact it is meant to signify, others may employ with equal truth for the same purpose. Names having a definite and established meaning in the language, and which do not indicate origin or ownership, or something equivalent, can not be appropriated by one so as to exclude a similar use by others. No property can be acquired in words or marks which do not denote the goods or property, or particular place of business of a person. No person by prior use can acquire an exclusive right to the words "Mammoth Wardrobe" as a sign or designation where a large amount of clothing is kept. 1871, *Michigan Circuit Ct.*, *Gray v. Koch*, 2 *Mich. N. P.* 119.

§ 659. The owner of a peculiar product of nature, like natural mineral water, who has applied to it a

conventional name, by which it has become generally known, and under which it has been extensively sold by him as a useful article, is entitled to be protected in the exclusive use of such name as his trademark in the sale of the article. 1871, *N. Y. Court of Appeals*, *Congress & Empire Spring Company v. High Rock Congress Spring Company*, 45 *N. Y.* 291; *S. C.*, 10 *Abb. Pr. (N. S.)* 348; reversing *S. C.*, 57 *Barb.* 526.

§ 660. A generic name or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, cannot be employed as a trademark. 1871, *U. S. Supreme Ct.*, *Delaware & Hudson Canal Company v. Clark*, 13 *Wall.* 311.

§ 661. A word, figure, &c., in common use, which indicates the name, nature, kind, quality, or character of the article, cannot be appropriated as a trademark. The word "Schnapps," which has long been in use to designate gin manufactured at Schiedam, cannot be appropriated as a trademark for gin, in the United States, even if its former use had been confined to Europe. 1873, *Supreme Ct. of Cal.*, *Burke v. Cassin*, 45 *Cal.* 467. See §§ 648, 664, 1029.

§ 622. The word "Schiedam" cannot be adopted as a trademark, because it has long been used to denote quality or kind. *Ibid.*

§ 663. The word "aromatic," when employed to express one of the qualities of liquor, cannot be protected as a trademark. *Ibid.*

§ 664. The employment in a trademark of a term, which is the true generic designation of the merchandise, cannot give any exclusive right to employ it. Hence the word "schnapps," intending abroad alcoholic drink in general, and in common use here,

Holland gin, may not be exclusively appropriated for trademark purposes. 1873, *N. Y. Supreme Ct. G. T.*, Wolfe *v.* Burke, 7 *Lans.* 151; S. C., reversed on another point, 56 *N. Y.* 115.

§ 665. Protection afforded to trademarks rests upon the principle of preventing a fraudulent appropriation of a name by which only the product or manufacture of another is designated, and of shielding the public against deception by such means. The appropriate and distinctive name given to a new commodity becomes, by use, its proper appellation, and passes as such into our language, and, excepting rights secured by patent, may be used in manufacturing and selling the article by any one. (Per GILBERT, J.) *Ibid.*

§ 666. A was the manufacturer of certain stout known as "Nourishing London Stout," and had adopted and registered a circular trademark or label with such words inscribed upon it. B carried on the trade or business of wine and ale merchants and had, subsequently to the registration of the plaintiff's label, adopted an oval trademark or label with the words "Nourishing Stout" inscribed upon it. *Held*, that an injunction could not be granted to restrain B from using the label with the inscription "Nourishing Stout," the word "nourishing" being merely descriptive of the quality of the manufacture. 1873, *Vice Ch. Malins*, Raggett *v.* Findlater, 43 *L. J. R. (N. S.) Ch.* 64; S. C., *L. R.* 17 *Eq.* 29; S. C., 29 *L. T. R. (N. S.)* 448; S. C., 22 *W. R.* 53.

§ 667. There is no principle more firmly settled in the law of trademarks, than that words and phrases which have been in common use, and which indicate the character, kind, quality, and composition of the

thing, may not be appropriated by any one to his exclusive use. In the exclusive use of them the law will not protect, nor does it matter that the form of words or phrases adopted also indicates the origin and maker of the article. The combination of words must express only the latter. It is the result of all the decisions, that known words and phrases indicative of quality and composition are the common property of all mankind. They may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him. Even when the sole purpose of the one who first uses them is to form of them a trademark for himself, expressive only of origin with himself, if they do in fact show forth the quality and composition of the article sold by him, he may not be protected in the exclusive use of them. Still less, then, when joined to the fact that they do thus show forth the quality and composition, there is a purpose that they should do so. 1874. *N. Y. Ct. of Appeals*, *Caswell v. Davis*, 58 *N. Y.* 223; overruling *S. C.*, 35 *How. Pr.* 76; 4 *Abb. Pr. (N. S.)* 6.

§ 668. It is a right which everyone has, and from the exercise of which he may not be debarred, to make an article of the same ingredients, of the same composition, and of as good quality as that made by another, when that other has no exclusive privilege of manufacture conferred by law. Having this right to make, he has also the right to indicate the ingredients, the composition and quality of that which he has made, by any words or phrases apt therefor. Hence, when he adopts usual phrases which do no more than this, he but takes from a

stock common to all mankind, and does not infringe upon any exclusive right of another, who has, before that, used the same or like words or phrases. Nor can the first user avoid this result by coupling with his purpose to indicate quality and characteristics, a purpose also to indicate origin. Though he have that purpose also, and the form of words used by him have also that effect, inasmuch as he cannot be given the exclusive use, without impairing the right of another, the exclusive use will be denied. The general rule is against appropriating mere words as a trademark. An exception is of those indicating origin or ownership, having no reference to quality or use. Words are but symbols. When they are used to signify a fact, or when, with what purpose soever used, they do signify a fact which others may, by the use of them, express with equal truth, others have an equal right to them for that purpose. *Ibid.*

§ 669. Nor is the question whether the name used as a trademark will convey an exact notion of how to compound an article, so that one reading it may be able to make a like article. If the necessary effect is to inform the reader or hearer of the general characteristics and composition of the thing, it is a name which may be used, with equal truth, by any one who has made and offers for sale a thing compounded of the same ingredients, and who desires to express to the public the same facts. Nor does the coupling together, in a new combination, of words, which before that had been used apart, and had entered into the common or scientific vocabulary, give a right to the exclusive use of such combination, where it is indicative, not of

origin, maker, use and ownership alone, but also of quality and other characteristics. *Ibid.*

§ 670. Plaintiffs prepared a medicine, the principal ingredients of which were iron, phosphorus and elixir of calisaya bark, to which they gave the name of "Ferro-Phosphorated Elixir of Calisaya Bark," and so labeled the bottles containing it. *Held*, that as it appeared from the testimony in the case, that the phrase claimed by the plaintiffs was formed of words in use before the adoption thereof by them; that they were then and are indicative, not of origin, use and ownership alone, but also of characteristics, quality and composition; that the said phrase could not be protected as a trademark, and that the defendant would not be enjoined from their use upon labels, devices, &c., which were calculated to deceive the public, and to induce the belief that the article which he sold was the same as that made and sold by the plaintiffs *Ibid.*

§ 672. The defendant used labels, devices, &c., calculated to deceive the public, and to induce a belief that the elixir which he sold was the same as that made and sold by the plaintiffs. The plaintiffs sought to have the defendant enjoined from using certain words on such labels which they claimed constituted their trademark. *Held*, that although the courts would be desirous of restraining and punishing the designed interference with the business of the plaintiffs, as the words did not constitute a trademark, the injunction should be denied. 1874, *N. Y. Court of Appeals, Caswell v. Davis*, 58 *N. Y.* 223.

§ 673. An exclusive right cannot be acquired to the use of the words "gold medal" as a trademark upon the wrappers of a manufactured article. The

words so used do not indicate ownership or origin, but quality, and that, in some competitive exhibition, a gold medal had been awarded to the article for its excellence, and so they cannot be appropriated as a trademark. 1874, *N. Y. Court of Appeals*, *Taylor v. Gillies*, 59 *N. Y.* 331; *affi'g S. C.*, 5 *Daly*, 285.

§ 674. The applicants, who were iron masters, had for some time prior to the passing of the Trademarks Registration Act, 1875 (38 & 39 *Vict.* c. 91, and 39 & 40 *Vict.* c. 33), been in the habit of using as trademarks the initials of their original firm, the name of their works, or an abbreviation of it, and combinations of them, and also these marks coupled with symbols or words denoting the particular quality of the iron. The registrar of trademarks was willing to register as trademarks the initials, and the name of the works and abbreviation and their combinations, but refused to register the marks which contained the symbols or words denoting quality. On motion before MALINS, V. C., that the registrar might be directed to register the whole of the marks claimed: *Held*, that the symbols and words denoting quality, though by themselves not trademarks, yet were trademarks in combination with the initials and the name of the works, and abbreviations and their combinations, and were entitled to registration. On appeal by the registrar of trademarks, the court of appeal were of opinion that the proper form of registration would be "B. B. H., used either alone or in combination with a crown, horse-shoe, or crown and horse-shoe, or with any other mark, device or word signifying the quality of the iron," and such order was made by agreement. 1877, *Ch. Ct. of Appeal*, *In re Barrow's Application*, 25 *W. R.* 564; *S. C.*,

below, 36 *L. T. R. (N. S.)* 291 ; S. C., 25 *W. R.* 407 ; S. C., 46 *L. J. R. (N. S.) Ch.* 450.

§ 675. The court at special term found that plaintiffs, in 1842, had originated a medicine for the cure of diseases of the throat, &c., for which they then devised and commenced to use as a trademark, to designate the origin, ownership and particular manufacture of the article, in connection with the name "Ayer," the words "Cherry Pectoral," which combination, "Cherry Pectoral," was original and not previously used. That the word "Pectoral," though known as an adjective, was then of rare and infrequent use as a substantive. That said words "Cherry" and "Pectoral," suggested, partially, the origin and use of the article. That the extract of wild cherry was one of the ingredients thereof. That said article became well-known to the public under its name and title of "Ayer's Cherry Pectoral," and "Cherry Pectoral;" was commonly known among dealers as "Cherry Pectoral;" and that, by association with the name of Ayer, and long-continued and uninterrupted use, the title "Cherry Pectoral" became established as plaintiffs' trademark. That it was generally understood by purchasers that the title "Cherry Pectoral," referred to and meant "Ayer's Cherry Pectoral," and none other. Said article was a liquid of a deep saffron color, put up in oblong, flat, clear glass bottles, containing about six ounces, upon which bottles were stamped the words, "Ayer's Cherry Pectoral." The bottles were enclosed in a paper wrapper of a deep orange color, bearing the printed words, "Ayer's Cherry Pectoral for the various affections of the lungs and throat, such as colds, . . . prepared and sold

by J. C. Ayer, Lowell, Massachusetts. Price One Dollar." In 1869, defendant commenced to make and sell a medicine for coughs, &c., which he called "Cherry Pectoral Troches;" said article was in the form of lozenges, put up in small paper boxes of a salmon color, with a figure of a red lion, holding a scroll in his mouth, with the words "Cherry Pectoral Troches" thereon, and also the words "Cherry Pectoral Troches for coughs . . . &c." Soon thereafter, defendant commenced to sell and manufacture a preparation of the same color, taste, smell and appearance as plaintiffs' article, and put up in oblong, flat, clear glass bottles, containing about five and a half ounces, of a somewhat smaller size, but of the same shape and having the same general appearance as plaintiffs' article, and having on the outer wrapper of white paper with red print, in large lettering, the words "Cherry Pectoral," and underneath the same in smaller lettering, the words, "Rushton's, F. V.," and on an inside wrapper the words "Cherry Pectoral," and, after some printed words of description and recommendation, the words, "For sale, wholesale and retail, by Rushton & Co., 11 Barclay Street, New York." Soon thereafter, defendant changed the color of his article to a lighter shade, and somewhat changed the taste and smell thereof. The articles made by defendant, as aforesaid, contained the extract of wild cherry. Defendant extensively advertised the words "Cherry Pectoral," for sale at 11 Barclay street, without the name of any person, and had conspicuously placed in front of his premises, a sign, "Depot of the Cherry Pectoral Company," and inside his premises a placard, "Ayer's Cherry Pectoral, One Dollar.

Rushton's Cherry Pectoral, Fifty Cents. Which will you have?" Defendant instructed his clerks to answer to purchasers who called for Ayer's Cherry Pectoral, that his Cherry Pectoral was not Ayer's, and that all persons inquiring for Cherry Pectoral, should be asked which they wanted—"Rushton's" or "Ayer's," and told that Rushton's was much better. The court also found that the said articles put up by defendant were well calculated to deceive and mislead purchasers, and to induce them to believe that they were the plaintiffs' article; and that defendant, well-knowing that said words and name, "Cherry Pectoral," were plaintiffs' trademark, and had by long use become known as designating plaintiffs' article, and known to the public as their trademark, with the wrongful intent to induce purchasers to believe that his article was the plaintiffs', and with the wrongful intention of securing to himself the benefit of plaintiffs' trademark, had imitated their trademark so closely as to mislead and deceive purchasers. Defendant was enjoined from using the words "Cherry Pectoral," and from imitating, &c. On appeal, the court at general term held that the said findings as to intent, &c., and as to imitation were not sustained by the findings describing defendant's acts and the respective articles. That defendant had been careful to distinguish his article from plaintiffs', and had taken precaution to prevent purchasers from being misled. That although he had taken advantage of the celebrity of plaintiff's name, and had hoped to gain advantage from the popularity plaintiff's article had acquired, by calling his medicine "Cherry Pectoral," and thus inducing persons to try his com-

pound, if they could be persuaded that one "Cherry Pectoral" was as good as another; and had proposed to build up a business upon and avail himself of the fame which years of sale and great expenditure of money had acquired for plaintiff's preparation; still there was clear proof that he did not intend to incur any penalty for imitation, or for attempts to impose his compound on the public as the plaintiff's article, and that he had kept within the letter of the law if he were at liberty to call his preparation "Cherry Pectoral." That the word "Cherry" described one of the ingredients of the compound, the word "Pectoral" described its use and application; that both words were common property, and that the two words made a descriptive term, to which no one could acquire an exclusive use. Judgment granting injunction reversed. 1877, *N. Y. Ct. of Com. Pleas, G. T., Ayer v. Rushton*, unreported.*

See also WORDS; and PARTNERSHIP, Name of.

V. *Fancy name.*

§ 680. A and B filed their bill, alleging a right to a trademark in the word "Ethiopian" upon black cotton stockings, acquired by A, and a former partner, deceased, praying an injunction and an account of profits. Defendants denied plaintiffs' right to the mark as a trademark, stating that other parties used the word prior to A and his partner, but admitted that they (defendants) had copied the mark from plaintiffs' stockings, and denied any fraudulent intent in so doing. The evidence as to plaintiffs' right to the mark as a trade-

* This case is now in the Court of Appeals for review.

mark was very unsatisfactory ; but held, that defendants, having made so complete a copy of plaintiffs' mark, the difference being only nominal, must be taken to have done so with an intent to gain an advantage to which they were not entitled—and that the motion to dissolve the injunction should be denied. 1846, *Vice Chancellor's Ct.*, *Hine v. Lart*, 10 *Jurist*, 106

§ 681. The plaintiff having first applied the name "Pain Killer" to a medical compound made and sold by himself, it was held that the application of the same name to a similar compound sold by defendant, bottled and labeled in a somewhat similar way, was an infringement of the plaintiff's trademark. 1850, *Supreme Ct. of Rhode Island*, *Davis v. Kendall*, 2 *R. I.* 566.

§ 682. The distinction between a "fancy" name and a descriptive name—considered. 1857, *N. Y. Superior Ct. S. T.*, *Fetridge v. Merchant*, 4 *Abb. Pr.* 156.

§ 683. Whether a mere name of an article or a designation of a place of manufacture, can or cannot become the subject of protection, as a trademark, or whether the words "Genuine" or "Yankee" can or cannot in any possible combination be used as a trademark, the court will restrain the use thereof in peculiar devices and labels in imitation of trademarks used by a manufacturer to distinguish his goods and when such use tends to deceive the public. 1857, *N. Y. Superior Ct., G. T.*, *Williams v. Johnson*, 2 *Bosw.* 1. See § 685.

§ 684. There is no legal restriction upon a manufacturer's choice of a name for his trademark, any more than of his choice of a symbol, so that his name be so far peculiar, as applied to manufacture.

goods, as to be capable of distinguishing, when known in the market, one manufacturer's goods of a certain description from those of another. "Roger Williams," though the name of a famous person, is, applied to cotton cloth, a fancy name, and the name "Roger Williams, Long Cloth," is capable of being appropriated by a manufacturer to cotton cloth of his manufacture, to distinguish it from cloth of the same general description manufactured by others; and if, to the knowledge of the public, it be so appropriated by the plaintiff, a person who stamps the name of "Roger Williams" on his cloth of similar description, with the design and effect of fraudulently passing it upon the market as and for cloth manufactured by the plaintiff, to the lessening of the gains and credit as a manufacturer of the latter, is liable to him for the injury caused thereby. 1860, *Supreme Ct. of R. I.*, *Barrows v. Knight*, 6 *R. I.* 434.

§ 685. Where the plaintiff has the right to the exclusive use of a trademark, in a particular article of manufacture, any labels, devices or handbills used by the defendants which are calculated to deceive the public into the belief that the article they are selling is the article made and sold by the plaintiff, will be restrained by injunction, and the plaintiff fully protected. *So held*, where it appeared that the appellation "Yankee Soap" was known to indicate the plaintiff's soap, and that the defendant's labels were in imitation of the plaintiff's, and calculated to deceive. 1863, *N. Y. Superior Ct., S. T.*, *Williams v. Spence*, 25 *How. Pr.* 366.

§ 686. Where A introduces into the market an article which, though previously known to exist,

is new as an article of commerce, and has acquired a reputation therefrom in the market by a name not merely descriptive of the article, B will not be permitted to sell a similar article under the same name; and this although the peculiarity of the name in question has long been in common use as applied to goods of a different kind. *Held*, that where the plaintiffs sold only one quality of soap, and that by the name of "The Excelsior White Soft Soap," the word "Excelsior" was not a mark of quality or description, and that said word is one in which an exclusive right of user as a trademark may be obtained. 1853, *Vice Ch. Wood's Cl.*, *Braham v. Bustard*, 9 *Law Times Rep. (N. S.)* 199; S. C., 1 *Hem. & M.* 447; S. C., 11 *W. R.* 1061; S. C., 2 *New R.* 572.

§ 687. The judge, before whom the action was tried, found as facts that the plaintiffs, in November, 1856, compounded from cocoanut oil and other ingredients, a mixture to be used as a hair wash, for which they devised as a trademark the name or word "Cocoaine;" that they published the same very extensively, with notice that they had adopted the said name or title as their trademark; and that the defendant, in November, 1868, commenced the preparation and sale of a similar compound, in bottles and with labels under the name and title of "Cocoïne;" and further, that the defendants, well knowing that the name, word or title of "Cocoaine" was, and for a considerable time had been, the trademark of the plaintiffs, with the wrongful intent of inducing the public to believe that the compound sold by themselves under the name, word or title of "Cocoïne," was that of the plaintiffs, and with the wrongful intention of securing to

themselves the benefit of the skill, labor and expense of the plaintiffs, have so closely imitated and used the aforesaid trademark of the plaintiffs as to deceive the public, and to injure and damage the plaintiffs; that the word, name, title or device "Cocoine" is a spurious and unlawful imitation by the defendants of the word, name, title or device "Cocoaine," the aforesaid trademark of the plaintiffs. *It was held* that the plaintiffs were entitled to a judgment enjoining the defendants from manufacturing, using, selling or in any manner disposing of a compound or preparation with the name, word or title of "Cocoine" printed or stamped upon the bottles, labels, wrappers, covers or packages thereof. 1867, *N. Y. Court of Appeals*, *Burnett v. Phalon*, 3 *Trans. App.* 167; S. C., 3 *Keyes*, 594; S. C., 5 *Abb. Pr. (N. S.)* 212; S. C., 1 *Abb. Ct. of App. Dec.* 267; *affi'g* S. C., 9 *Bos'n.* 193; *affi'g* S. C., 12 *Mo. Law R.* 220.

§ 688. The title and trademark of the plaintiff's article was "Perry Davis' Vegetable Pain Killer," and had been introduced in the market under that name as far back as 1842. About five years ago the defendant commenced to manufacture and sell an article similar to the plaintiff's, which he called "The Great Home Remedy, Kennedy's Pain Killer." Plaintiff filed a bill to restrain the use of the words "Pain Killer" by defendant. There was an obvious difference in the appearance of the labels and bottles when seen together. Defendant contended that his label was not an infringement of the plaintiff's, and that, as the words Pain Killer was descriptive of the article, that plaintiff had no exclusive right thereto. The evidence showed that the name Pa' Killer was first invented by Perry

Davis, that since 1841 it was understood by the public and the trade that Perry Davis was the inventor of "Pain Killer," that "Pain Killer" meant the medicine of the plaintiff, that whenever "Pain Killer" was asked for, the plaintiff's medicine was understood as meant, and supplied without further inquiry, that his medicine was asked for and supplied without further designation, that the defendant's article could not be sold in considerable quantities unless the name Pain Killer was conspicuously placed thereon, and that it was only since the defendant's article had been introduced that persons who asked for "Pain Killer" gave the name of the maker. There was proof that defendant's article was obscurely known in the trade, but that plaintiff's article had previously obtained a great reputation. *Held*, that the words "Pain Killer" fell within the class of trademarks usually called fancy names or trademarks, which are arbitrarily selected by an inventor or manufacturer to catch the eye or ear of the public, and to distinguish his article from others of the like nature. That it was true that the term Pain Killer was suggestive of the use of the medicine, but that it was not an adjective or used adjectively; that it was a quaint combination of words never probably used together before, forming a name by which the inventor desired his medicine to be known, and calculated, as he rightly judged, from its quaintness to fix itself in the memory of the general public. *Held*, further, that the words "Pain Killer" was the distinctive trademark of plaintiff, and that even taking the whole title "Perry Davis' Vegetable Pain Killer" to be the trademark, the use of the words "Pain Killer" upon the defendant's

label as aforesaid was an infringement of the plaintiff's trademark. Defendant was enjoined from the use of said words, ordered to account for the profits he had made, and to forthwith destroy all dies, labels, wrappers, and printed papers in his possession, power or control, upon which the plaintiff's said trademark was used. 1867, Sept. 3, *Vice Chancellor's Ct. held at Hamilton, Canada, May, 1867, Davis v. Kennedy*, unreported.

§ 689. In the year 1859, the plaintiff, Carl A. H. Schweitzer, who carried on the business of an analytical chemist, invented a preparation of cocoa to which he applied the fancy name of "cocoatina" and which he sold in packets labeled "Schweitzer's cocoatina, or anti-dyspeptic cocoa, registered." It had ever since been known under that name and had now attained an extensive sale. The defendant Atkins had been in the employ of the plaintiff, to whose wife he was related, and upon leaving the plaintiff's establishment, in February 1868, he had received money from the plaintiff for the purpose of enabling him (the defendant) to set up business on his own account. The defendant thereupon entered into partnership with a man named Otto Schweitzer and traded under the name of "Otto Schweitzer, Atkins & Co." Shortly afterwards, the defendant and his partner (who was now abroad) began selling another preparation of cocoa, which they called "cocoatine," and sold in packets labeled "Otto Schweitzer, Atkins & Co.'s cocoatine, registered." The packets and labels of the two firms had a general resemblance in color and form, though the defendants' packets, at the same price as the plaintiff's, were considerably larger in size. The defendants' label contained a description below the title, which the

plaintiff's had not, but in small print. The directions for use were quite different. *Held*, that there had been a fraudulent and colorable imitation on the part of the defendants, and an injunction was granted accordingly. 1868, *Before Malins, V. C.*, *Schweitzer v. Atkins*, 37 *Law Jour. R. (N. S.) Ch.* 847; *S. C.*, 19 *Law Times R. (N. S.)* 6.

§ 690. Any contrivance, design, device, name, symbol, or other thing, may be employed as a trademark, which is adopted to point out the true source and origin of the goods to which said mark is applied, or even to point out and designate a dealer's place of business, distinguishing it from the business locality of other dealers. The mark, however, must point out the source and origin of the goods, and not be merely descriptive of the style, quality, or character of the goods themselves. The plaintiff originated and applied to cooking stoves of his manufacture, the name "Charter Oak," which was so formed upon the patterns, as to produce the name upon the stoves in combination with a sprig of oak leaves. This name and device was employed to distinguish and designate the plaintiff's articles. *Held*, that said name and device were possessed of the requisite characteristics of a trademark, and that as said stoves were not generally known by the particular device which surrounded the name upon them, but by the name itself, the use of the name "Charter Oak," separated from other parts of the trademark, amounts to an infringement of the maker's rights. 1869, *Supreme Ct. of Missouri*, *Filley v. Fassett*, 44 *Missouri*, 168.


§ 691. The plaintiff, being a shirt-maker in London, invented a particular form of shirt, to which

he gave the name of "Eureka," and used, as a trademark, which he affixed to the shirts, the words "Ford's Eureka Shirt." After the plaintiff had used this trademark for several years, the defendants commenced to use the word "Eureka," affixing it to a shirt in exactly the same place as the plaintiff affixed his mark, also boxes containing small quantities of shirts, just as much as one purchaser would buy, with the mark "Foster, Porter & Company's Improved Eureka." The defendants were restrained by injunction from affixing or using any label or card, or other mark containing the word "Eureka," or from applying the word "Eureka," to or upon any shirts not of the plaintiff's manufacture. 1872, *Ch. Ct. of Appeal*, Ford v. Foster, *Law R. 7 Chancery Ap. Cas.* 611; S. C., 27 *L. T. R. (N. S.)* 219; S. C., 41 *L. J. R. (N. S.) Ch.* 682; S. C., 20 *W. R.* 318; reversing S. C., 20 *W. R.* 311.

§ 692. The exclusive right to the use of a fancy name as a trademark, is not lost by the inventor habitually using it in conjunction with his own name as maker of the article. *Ibid.*

§ 693. A fancy name which designates a particular kind of article, may be in general use in price lists which circulate between manufacturers and retail dealers, without prejudicing the right of the inventor to the exclusive use of a fancy name as a trademark in the sale of the article to the public. *Ibid.*

§ 694. For twenty years the plaintiffs used the trademark in question, by stamping or labeling it upon shirts, their packages and advertisements. In March, 1871, they registered their trademark in the patent office, under the act of Congress (16 *U. S. Stat. at L.* 210, &c. § 77, &c.). The trademark,

as appeared by the certificate of the commissioner of patents, consists of the words, "The Star Shirt;" also the words, "The Star Shirt," with the device of a six-pointed star therewith; also the device and words, "The  Shirt"—either one or all being used as convenience requires. "Though this device or mark is in part arbitrary and, to that extent, would have no natural or necessary significance in connection with the article manufactured, apart from its use in that connection, yet, by such use of the plaintiffs, in connection with their manufacture and sale of these articles, it has become well known to the trade, and has come to be taken by dealers as a peculiar designation by which the plaintiff's goods are distinguished in the market. It is, therefore, both in its character and use, when taken together, a lawful trademark. It has long been employed by the plaintiffs, and well understood by dealers and the public as designating such articles of their manufacture. The plaintiffs are entitled to protection. Their exclusive right to the use of this trademark is co-extensive with the limits of the United States." 1872, *U. S. Circuit Ct., Conn., Morrison v. Case*, 9 *Blatchf. C. C.* 548.

§ 695. A manufacturer who has produced an article of merchandise (*e. g.*, a new pattern of cloth), and applied to it a particular fancy name, and sold it with a particular mark, under which name and mark it has obtained currency in the market, acquires an exclusive right to the use of such name and mark, and is entitled to restrain all other persons from using such name and mark to denote articles similar in kind and appearance, although he may have no exclusive right of manufacturing the article. If the use of such name and mark by any

other person than the first inventor, has been adopted for the purpose of selling goods of an inferior quality, though of similar external appearance, so that purchasers may be misled into the belief that they are buying the goods of the first inventor, the injury to the first inventor is one for which he is entitled to compensation in damages and relief by injunction. 1872, *Vice Ch. Bacon's Ct.*, *Hirst v. Denham*, *L. R.* 14 *Eq.* 542; *S. C.*, 41 *Law Jour. R. (N. S.) Chanc.* 752; *S. C.*, 27 *Law Times R. (N. S.)* 56.

§ 696. The plaintiff, a woolen manufacturer, introduced into the market cloths of particular textures, made by him, under arbitrary names, as "Turin," "Sefton," "Leopold," and "Liverpool." The defendant copied the patterns, which were not registered, and sold the cloths under the same names. The defendants also used a ticket in sending their cloth to the wholesale dealers, closely resembling that of the plaintiff; but they explained that they purchased the ticket, which was of a simple description, and did not bear the manufacturers' name, from the stock of a stationer, without any intention to copy the plaintiff's. They claimed to be entitled to describe the cloths by the names given to them by the plaintiff. *Held*, that the plaintiff was solely entitled to the names as trademarks; and that the use of the tickets, even if innocent, was unjustifiable. *Ibid.*

§ 697. The device consisting of the word "Star" stamped upon lead pencils, held to be a valid trademark. 1875, *N. Y. Supreme Ct. G. T., First Dept. Dec. 30*, *Faber v. Hovey*, unreported.

§ 698. The plaintiff adopted as a trademark for his stove polish a device of an orb, with rays of

light rising over a body of water, in connection with the words, “*Rising Sun Stove Polish.*” The defendant subsequently used as his trademark for his stove polish a similar device of an orb rising over a body of water, in connection with the words “*Rising Moon Stove Polish.*” The plaintiff filed a bill, and the defendant by his answer admitted above facts, but denied any intentional imitation, or that there was a sufficient resemblance to cause deception. *Held*, by the court, that defendant’s trademark was a plain imitation of the plaintiff’s, and that the defendant should be restrained by injunction from the use of his said device; from using the name “*Rising Moon;*” also from using the device of an orb rising over a body of water. 1875, *Phila. Court of Com. Pleas*, *Morse v. Cornwell*, unreported.

See also §§ 44, 375, 379, 395, 431, 433, 871.

VI. *Geographical name.*

§ 705. Though no exclusive right of property can be acquired in the public and well known name of a geographical district, such a right may be acquired in the application of such a name to a particular article of manufacture, if the article has acquired a reputation in the market under such name as a trademark. 1864, *Before Lord Ch. Westbury on Appeal*, *M’Andrew v. Bassett*, 10 *Jurist (N. S.)* 550; S. C., 33 *Law J. R. (N. S.) Ch.* 561; S. C., 12 *Weekly R.* 777; S. C., 10 *Law T. R. (N. S.)* 442; affirming S. C., 10 *Jurist (N. S.)* 492; S. C., 10 *Law T. R. (N. S.)* 65.

§ 706. The plaintiffs were manufacturers of liquorice, and having made in England a new description

of goods from a mixture of juice extracted from roots obtained from Anatolia and Spain, they stamped upon the manufactured article the mark "Anatolia," and sold it to the public and acquired a reputation for it in the market. About six weeks afterwards some of the goods so marked were sent to the defendant with a request that he would make up liquorice in the same form and with the same stamp. Liquorice juice had long been imported from Anatolia, but no one before the plaintiff had used the word "Anatolia" as a mark. *Held*, by Vice Ch. WOOD, and affirmed on appeal, that the word "Anatolia" might be used as a trademark, and that the plaintiff had acquired sufficient property in it to entitle him to an injunction against the defendant. *Ibid.*

§ 707. Ever since the year 1848 the plaintiff, Baron Seixo, had caused his casks to be stamped with his coronet on the top, and with his coronet and the word "Seixo" at the bung; and the evidence showed that his wines had thus acquired in the market the name of "Crown Seixo Wine." When therefore the defendants, in the year 1862, adopted as their device a coronet with the words "Seixo de Cima" (meaning Upper Seixo), below it, the consequence was almost inevitable that persons with only the ordinary knowledge of the usages of wine trade from Oporto would suppose, that in purchasing a cask of wine so marked, they were purchasing what was generally known in the market as "Crown Seixo" wine. Against the use of such a trademark the plaintiff has a right to have an injunction. Even assuming the truth of what the defendants contend for, *i. e.*, that parts of their vineyards were known by the name of Seixo, that

does not justify them in adopting a device or brand, the probable effect of which is to lead the public, when purchasing their wine, to suppose that they are purchasing wine from the vineyards, not of the defendants, but of the plaintiff. The defendants were enjoined from using the crown or the word "Seixo" on their wine. (There was no evidence to show that the defendants ever offered their wine as "Crown Seixo," but it was proved that they had offered it as "Crown Seixo de Cima;" and a wine broker of eminence deposed that he believed it, when offered by that name, to be the plaintiff's wine.) 1866, *Before Lord Ch. Cranworth on Appeal, Seixo v. Provezende, L. R. 1 Ch. 192*; S. C., *12 Jurist (N. S.) 215*; S. C., *14 Weekly R. 357*; S. C., *14 Law T. R. (N. S.) 314*.

§ 708. Where plows in reference to which the words "Moline Plow" were used (being manufactured in the town of Moline, Ill.), said words were regarded as a generic term, and as indicating the place at which they were made, and it was *held* that no property could be acquired in words of that character, as constituting a trademark, to the exclusion of others in their use in connection with plows made by them at the same place. 1870, *Supreme Ct. of Illinois, Candee v. Deere, 54 Ill. 439*.

§ 709. One manufacturer of an article at a particular town, whose wares have gained celebrity, can not appropriate as his own, to the exclusion of other persons in the same place, the name of the place, and thus prevent them from designating their manufactures as of the place where they were actually made. So where a manufacturer of plows at the town of Moline, had been accustomed

to brand or stencil upon the beams of his plows, under his name, the words "Moline, Ill.," and subsequently another manufacturer of plows in the same place, branded plows which he manufactured there, under his own name, with the same words, "Moline, Ill.," it was held there was no violation of any right in the former, because he could not acquire any property in those words, which only indicated the place at which the plows were made. *Ibid.*

§ 710. Where a place has become noted by reason of the excellence of an article manufactured there, another person may choose such place for the manufacture of the same article, for the reason the name has become known in the markets, and with the intention of introducing that name as a part of the description of himself and his goods. *Ibid.*

§ 711. It is obvious that the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured, and which can be employed with truth, apply with equal force to the appropriation of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies. Could such phrases as "Pennsylvania wheat," "Kentucky hemp," "Virginia tobacco," or "Sea Island cotton," be protected as trademarks; could any one prevent all others from using them, or from selling articles produced in the

districts they describe under those appellations, it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common property of many. It can be permitted only when the reasons that lie at the foundation of the protection given to trademarks are entirely overlooked. 1871, *U. S. Supreme Ct.*, Delaware and Hudson Canal Company *v.* Clark, 13 *Wall.* 311.

§ 712. It must then be considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the appellation as to prevent others inhabiting the district or dealing in similar articles coming from the district from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trademark amounts to a false representation, express or implied, designed or incidental, that there is any title to relief against it. True it may be that the use, by a second producer, in describing truthfully his product, of a name or a combination of words already in use by another, may have the effect of causing the public to mistake as to the origin or ownership of the product, but if it is just as true in its application to his goods as it is to those of another who first applied it, and who therefore claims an exclusive right to use it, there is no legal or moral wrong done. Purchasers may be mistaken, but they are not deceived by false representations, and equity will not enjoin against telling the truth. *Ibid.*

§ 713. Where coal of one person who early and long mined coal in a valley of Pennsylvania known as the Lackawanna valley had been designated and become known as "Lackawanna coal," *Held*, that

miners who came in afterwards and mined in another part of the same valley, and persons who sold the coal so mined, could not be enjoined against calling their coal "Lackawanna coal," it being in fact and in its generic character properly so designated, although more properly described when specifically spoken of as "Scranton coal" or "Pittston coal," and when specifically spoken of usually so called. *Ibid.*

§ 714. A name may become a trade denomination and as such the property of a particular person who first gives it to a particular article of manufacture. The employment of the name by another person is an invasion of the right of the original manufacturer, who is entitled to protection by injunction. In 1847, W bought certain plant and stock in trade used in the manufacture of starch, with the right to use the name "Glenfield Patent Double Refined Powder Starch" from certain dyers in Glenfield, which was a small property two miles from Paisley. W since then continued to make the article (which acquired a great reputation under the title of "Glenfield Starch") at Paisley, to which place he removed the business, still using water, which was largely employed in the manufacture, from Glenfield. In 1868, C, who had lived at Glenfield for more than twenty years, began manufacturing starch in a shed or out-building of the works of W's assignor at Glenfield, and sold the starch in packets labeled C & Co. Starch and Corn Flour Manufacturers, Glenfield, his name and that of the place being in large capitals. In color, C's labels resembled those of W's, but it appeared that this color was used by most starch manufacturers. There was evidence that C's agent represented his

starch as "Glenfield Starch" and that he thereby got an increased sale for the article. It was proved, however, also, that as regards the first purchasers, the retail dealers, there was no deception; that they well knew that in buying C's starch, they were not buying that made by W, and that W's was the original "Glenfield Starch." *Held*, that W was entitled to an injunction to restrain C from using the word "Glenfield" on his labels and from representing his starch as "Glenfield Starch." *House of Lords*, 1872, *Wotherspoon v. Currie*, 27 *Law T. R. (N. S.)* 393; S. C., *Law R. 5 Eng. & Ir. Ap.* 508; S. C., 42 *Law J. (N. S.) Ch.* 130; reversing S. C., 23 *Law T. R. (N. S.)* 443; S. C., 18 *Weekly R.* 942; and affirming S. C., 22 *Law T. R. (N. S.)* 260, and S. C., 18 *Weekly R.* 562.

§ 715. Where the name of a place has by user by a particular maker of a particular article of manufacture, acquired a secondary signification in connection with that manufacture, and has obtained currency and value in the market as the trade denomination of that particular maker's goods, it becomes, in connection with that manufacture, the property of that maker as his trademark, or as part of his trademark. *Ibid.*

§ 716. The name of an article, if it has acquired a name, should not by an honest manufacturer be put upon his goods, if a previous manufacturer has, by applying it to his goods, acquired the sole use of that name. I mean the sole use in this sense; that his goods have acquired by that description a name in the market, so that whenever that designation is used, he is understood to be the maker, where people know who the maker is at all—or, if people have been pleased with an article, it

should be recognized at once by the designation of the article, although the customers may not know the name of the manufacturer. It may very well be that hundreds of people like *Glenfield Starch*, and order it because they think it is the very best starch that they ever used, without having heard the name of Mr. *Wotherspoon*, and without knowing him at all. They say, I want the thing that bears that name, made by the manufacturer who makes it in that way, and there being only one manufacturer who does make it in that way, I want the article made by that manufacturer. Lord Ch. HATHERLY, *House of Lords, Ibid.*

§ 717. An injunction will be granted on an interlocutory motion to restrain the use or imitation of the name of a place, used as a trademark, if the plaintiff proves, *prima facie*, that such name in the market has become to mean the plaintiff's article obtained from such place. 1872, *Before Wickens, V. C.*, *Radde v. Norman*, *Law R. 14 Eq.* 348; S. C., 41 *Law Jour. R. (N. S.) Ch.* 525; S. C., 26 *L. T. R. (N. S.)* 788; S. C., 20 *W. R.* 766.

§ 718. In April, 1870, the ducal government of Anhalt granted to Z. the exclusive right of exporting over the sea genuine kainit, out of the ducal mines at Leopoldshall. On the same day Z conferred such exclusive right upon the plaintiffs, who advertised and sold the kainit, as "Genuine Leopoldshall Kainit." The plaintiffs' article attained a high reputation, and became known in the trade as the product of the Leopoldshall mines, and was distinguished by the name of Leopoldshall from all other kinds of kainit. The defendants offered for sale, under the name of "Kainit (Leopoldsalt)," kainit, which had not come from the Leopoldshall

mines. On motion, *held* that the plaintiffs had made out a *prima facie* title to the exclusive use of the word "Leopoldshall" as a trademark, and that, on an interlocutory application, an injunction should be issued restraining the defendants from using the word "Leopoldsalt," or "Leopoldshall," or any colorable imitation of the "Leopoldshall" in connection with kainit brought into the market by them. *Quere*, whether the plaintiffs' title was sufficiently established as against a person who, in ignorance of any claim on the part of the plaintiff, had sold, or offered for sale, the raw Leopoldshall kainit, which he had lawfully got into his possession, with good reason to believe that it was so. *Ibid.*

§ 719. The plaintiffs were engaged in the business of manufacturing cement, or water lime, from quarries or beds lying near Akron, Erie county, N. Y., designated and sold as "Akron Cement," and "Akron Water Lime," the packages containing the same, when sold and offered for sale, having attached to each of them these words: "Newman's Akron Cement Co., manufactured at Akron, N. Y., The Hydraulic Cement known as the Akron Water Lime." Part of these words, viz.: Newman's Akron Cement Co., was printed in capitals, and part, viz.: Akron Water Lime, in large capitals. The defendants being engaged in manufacturing and selling a similar article from quarries or beds situated near Syracuse, Onondaga county, N. Y., and knowing that water lime cement was manufactured and sold by the plaintiffs, under the name of "Akron Water Lime," and "Akron Cement," called their own beds the "Onondaga Akron Cement and Water Lime," and after that, they

sold the water lime and cement, prepared by them, with a label on each package, having these words upon it: "Alvord's Onondaga Akron Cement or Water Lime, manufactured at Syracuse, New York," such water lime and cement being placed upon the market and sold in the same places where that manufactured by the plaintiffs was sold and used. *Held*, that the word "Akron," as used by the plaintiffs, was their trademark by which they designated the article manufactured and sold by them; and that they were entitled to be protected in such use of it, by an injunction restraining the defendants from making use of the word "Akron" as their trademark. 1872, *New York Commission of Appeals*, *Newman v. Alvord*, 51 *N. Y.* 189; affirming *S. C.*, 35 *How. Pr.* 108; *S. C.*, 49 *Barb.* 588.

§ 720. *Held also*, that the case was not one of such doubt as to require the plaintiffs' right to be first established at law. *Ibid.*

§ 721. *Held further*, that to defeat the plaintiffs' right to appropriate the term "Akron" on the ground that it had previously been in common use, such a use of it must be shown as would extend to and include the defendants. That until that was done, the use made of it by the plaintiffs might well be exclusive of the defendants, without being so as to the inhabitants of Akron. That assuming (although not so deciding) that other persons who owned quarries at or near Akron, had the right also to call their cement, Akron Cement, yet it was clear that the plaintiffs, upon the facts of the case, were entitled to protection against the defendants. *Ibid.*

§ 721a. I can perceive no reason why a trademark may not be the name of a place. EARL, *J.*, *Ibid.*

§ 722. As a general rule geographical names cannot be appropriated as trademarks, and their use by another will not be enjoined; but the rule has its exceptions, where the intention in the adoption of the descriptive word is not so much to indicate the place of manufacture, as to intrench upon the previous use and popularity of another's trademark. 1873, *N. Y. Supreme Ct., G. T., Lea v. Wolf*, 15 *Abb. Pr. (N. S.)* 1; S. C., 1 *Thomp. & C.* 626; S. C., 46 *How. Pr.* 157; modifying S. C., 13 *Abb. Pr. (N. S.)* 389.

§ 723. Plaintiff had manufactured at Worcester-shire for many years, an article known as "Worcestershire Sauce." Defendant commenced the manufacture at another place, of an article of similar character, which he named "Worcestershire Sauce." The labels, wrappers, &c., of plaintiff's article were closely imitated in size, color and appearance, and were irresistible proof of an intention of the defendants to deceive the public and to lead purchasers to suppose that the defendant's preparation was the original Worcestershire Sauce, so long manufactured by the plaintiffs. *Held*, that where such an intention exists, the defendants should not be protected in their fraudulent imitation by the pretense that in the words employed the name of a place and the word descriptive of the article only are used. That the defendants, doubtless, might, under proper circumstances, employ the name of a place where an article is manufactured, as well as the word descriptive of its character; but such words must be employed honestly and properly, and not with a design to imitate and deceive to the detriment of another. That plaintiff was entitled to an injunction prohibiting the use of

the words "Worcestershire Sauce" on defendant's bills, labels and wrappers. *Ibid.*

§ 724. As a general rule the name of a town or city cannot be exclusively appropriated as the trademark of any one. 1874, *Supreme Court of Pennsylvania*, Glendon Iron Co. v. Uhler, 75 *Penn. St.* 467.

§ 725. The plaintiffs adopted the trademark "Glendon" for the iron manufactured by them; the place where their furnaces were was afterwards made a borough by the name of Glendon. Another company afterwards built a furnace at Glendon, and used the mark "Glendon" on the iron of their manufacture. *Held*, that the latter company could lawfully use said mark of "Glendon." *Ibid.*

§ 726. The commission of a lawful act does not become actionable, although it proceed from a malicious motive. *Ibid.*

§ 727. The plaintiffs, under a grant from the owners, acquired the exclusive right of importing and selling in Great Britain, the mineral water produced by a natural spring, called "Apollinaris" at Arhweiler, in Prussia, which had for some years been known and sold in the English market under the name of "Apollinaris Water," and advertised and sold the same as "Apollinaris Water." Subsequently, the defendants made and sold an artificial mineral water, being the chemical equivalent of the natural water, under the name and description of "London Apollinaris Water, possessing all the properties of the natural water." *Held*, on motion, that the plaintiffs were entitled to an interim injunction to restrain the use of the words "London Apollinaris Water," or of any other name of which the word "Apollinaris" so formed part as to

be calculated to mislead the public. 1875, *Vice Ch. Bacon's Ci.*, Apollinaris Company (limited) *v.* Norrish, 33 *Law T. R. (N. S.)* 242.

§ 728. Plaintiff and defendant both manufactured tobacco at Durham, N. C. *Held*, that neither party could exclusively appropriate the word "Durham" as a trademark. 1875, *Supreme Ct. of North Carolina*, Blackwell *v.* Wright, 73 *N. C.* 310. But see § 390.

§ 729. Plaintiff's trademark for the cigarettes of his manufacture consisted of the words "St. James," the device of rays of the sun, and the numerals " $\frac{1}{2}$." Defendants imitated said trademark upon cigarettes manufactured by them and defended an action brought to restrain such imitation, claiming that plaintiff had no exclusive right to the words "St. James" as it was a geographical name, nor to the numerals " $\frac{1}{2}$," as they contended that such numerals represented that plaintiff's cigarettes were made one-half of Perique and one-half of Turkish tobacco. The court found that although the cigarettes might be so composed, said numerals did not indicate the fact; that they might as well relate to price, to size, to quality, to numbers, as to quality of tobacco. The court also found that defendants, by the use of the words "St. James," intended to defraud the public into the belief that when they bought cigarettes with those words upon the labels, they were buying cigarettes of the plaintiff's manufacture. Defendants were enjoined from the use of said words, device and numerals. 1877, *N. Y. Supreme Ct. S. T.*, Kinney *v.* Basch, unreported.

§ 730. "The interference of courts of equity, instead of being founded upon the theory of protec-

tion to the owners of trademarks, is now supported mainly to prevent frauds upon the public. If the use of any words, numerals or symbols, is adopted for the purpose of defrauding the public, the courts will interfere to protect the public from such fraudulent intent, even though the person asking the intervention of the court may not have the exclusive right to the use of those words, numerals or symbols. This doctrine is fully supported by the latest English cases of *Lee v. Haley*, 5 *Ch. App. Cases*, *Law R.* 155, and *Wotherspoon v. Currie*, *Law R.* 5 *Eng. & Ir. App. House of Lords*, 508, and also in the case of *Newman v. Alvord*, 51 *N. Y.* 189." VAN BRUNT, J. *Ibid.*

See also §§ 413, 590, 823.

VII. Patentee, name of.

§ 731. The purchaser of a patent and of the right to use the name of the patentee for the goods manufactured by him thereunder, has no exclusive right to use of such name after the expiration of the patent, and another manufacturer will not be precluded from using such name in representing that his goods are manufactured according to the patent, provided he does not do so in a manner liable to mislead. 1853, *Vice Ch. Wood's Ct.*, *Edelsten v. Vick*, 11 *Hare*, 78; S. C., 18 *Jurist*, 7; S. C., 23 *Eng. Law & Eq.* 51.

§ 732. Where articles of a particular kind have become generally known in commerce under the name of the original manufacturer (or patentee, as the case may be), any person has a right, after the expiration of the patent, to manufacture such articles and sell them under that name; but he

may not, by inscribing the name, as a proper name, on his shop front or otherwise, lead the public to believe that he is selling as the agent for the original manufacturer. The name "Wheeler & Wilson" machine held to have come to signify the thing manufactured according to the principle of Wheeler & Wilson's patent. 1869, *V. C. James' Ct.*, *Wheeler & Wilson Mfg. Co. v. Shakespear*, 39 *Law J. R. (N. S.) Ch.* 36.

§ 738. Since 1863 the pursuers had sold their machines as Singer sewing machines, and their machines were exclusively known and sold in the market under that name. It was proved that the name "The Singer Machine," or "The Singer Sewing Machine," meant, and in the trade was well understood as meaning, a machine manufactured by Mr. Singer, or by the Singer Manufacturing Company. It was not proved that the name indicated any special peculiarity in principle or construction. *Held*, that though there is no patent, and other parties are, therefore, entitled to manufacture identically the same article, they are not entitled to sell it under the same name, but that a maker's name so used and appropriated is just as good a trademark, and one as exclusively and effectually appropriated by him as if it were a trademark not consisting of a word at all, but of some particular device in drawing. Interdict granted against the defenders from selling machines not made by the Singer Manufacturing Company as "Singer's Singer Machines," or "Singer Sewing Machines." 1873, *Ct. of Session*, *Singer Manuf. Co. v. Kimball*, 10 *Scottish L. R.* 173; S. C., 45 *Scottish Jurist*, 201. But see *Singer Mfg. Co. v. Wilson*, 24 *W. R.* 1023; S. C., 45 *L. J. R. (N. S.) Ch.* 490; S. C., 34 *L. T. R. N. S.* 858.

§ 734. The words imprinted upon a patented article of manufacture are common property from the date of the expiration of the patent. 1875, *U. S. Circuit Ct., Ill.*, Tucker Manufacturing Co. v. Boyington, 9 *Off. Gaz. (U. S. Patent Office)* 455.

§ 735. *Held*, that the words "Tucker Spring Bed," as applied to a spring bed, were common property from the date of the expiration of the patent in such bed. That when a party other than the one who formerly owned the patent manufactured a spring bed, he had the right to designate it as the "Tucker Spring Bed," indicating that it was manufactured under the Tucker patent. *Ibid.*

See Cheavin v. Walker, 35 *L. T. R. (N. S.)* 757; Ransom v. Bentall, 3 *L. J. R. (N. S.) Ch.* 161; Howe v. Howe Machine Co., 50 *Barb.* 236.

NEWSPAPERS.

See PUBLICATIONS.

NOM DE PLUME.

See § 886.

NOSTRUMS.

See MISREPRESENTATION.

NUMERALS.

§ 740. The name of a manufacturer, or a system of numbers adopted and used by him in order to

designate goods of his make, may be the subject of the same protection in equity as an ordinary trademark. 1866, *Vice Ch. Wood's Ct.*, *Ainsworth v. Walmesley*, *Law R. 1 Eq.* 518; S. C., 12 *Jurist (N. S.)* 205; S. C., 14 *Weekly R.* 363; S. C., 14 *Law Times (N. S.)* 220; S. C., 35 *Law Journal (N. S.) Ch.* 352.

§ 741. The name and address of a manufacturer, used by him as a trademark, may have added to and connected with it some peculiar device, vignette, emblem, symbols, forms or figures adopted as auxiliary to the name and address in declaring the true origin and ownership of his merchandise and a wrongful violation of such a trademark may be accomplished, even though the name of the imitator be substituted for that of the original manufacturer, by such an imitation of the device, vignette, emblem, symbols, form, color or figure alone, as indicates a design to deceive, and is calculated to deceive the public as to the true origin and ownership of the goods. Where numbers are associated with the name of the manufacturer upon labels of of a certain form, color, and general arrangement, and in connection with such labels are used by him to indicate his own goods, they may, by virtue of that connection, form an important part of a trademark. 1868, *Supreme Ct. of Conn.*, *Boardman v. Meriden Britannia Co.*, 35 *Conn.* 402.

§ 742. A manufacturer has the right to distinguish the goods manufactured by him, by any peculiar mark or device, he may select and adopt, by which they may be known as his in the market, and he is entitled to the protection of a court of equity, in the exclusive use of the peculiar marks or symbols appropriated by him, designating or

indicating the true origin or ownership of the articles to which they are affixed. Plaintiff, a manufacturer of steel pens, had for many years manufactured a peculiar pattern on which was impressed the figures "303" and the words "Joseph Gillott, extra fine." The pens were put up in paper boxes, with a label on top containing the same name and numerals. The pens were known and ordered by dealers as "303" pens. Such figures did not express any quality or size of the pens, but were selected arbitrarily by plaintiff to distinguish the pattern or character of pen to which it was applied. Defendants began the manufacture and sale of a steel pen, closely resembling plaintiff's pen in every particular, on which was stamped "303" and "Esterbrook & Co., extra fine." The pens were put up in boxes of the same size and similar to those of plaintiff, with a label containing the same words and figures, except "Esterbrook & Co.," instead of "Joseph Gillott." In an action brought by plaintiff to restrain defendant from using the figures "303" upon these pens and boxes: *Held*, that plaintiff had acquired the right to the exclusive use of those figures as a trademark, and was entitled to the relief sought. 1872, *N. Y. Com. of Ap.*, *Gillott v. Esterbrook*, 48 *New York*, 374; affirming *S. C.*, 47 *Barb.* 455.

§ 743. Plaintiff's trademark for umbrellas consisted of the numerals "140" in a white oblong placed in the centre of a five-pointed star. Defendants used a mark for umbrellas, consisting of the number "142" in the centre of a sun-burst. The evidence showed that the use of numerals as trademarks among dealers in umbrellas was common—and that no one with ordinary intelligence

or attention could mistake the one device of "142," &c., for the other one of "140," &c. An injunction asked for by the plaintiff was refused. 1873, *N. Y. Ct. of Com. Pleas, S. T., Dawes v. Davies*, unreported.

§ 744. Since 1873, the plaintiff placed upon his packages of cigarettes, amongst other trademarks, an Eastern fez surrounded by rays of light; also, the numerical symbol $\frac{1}{2}$ printed in b. l. characters, in red color, with the bar between the two figures oblique and nearly upright; with the figure 1 elevated on the left; with the figure 2 depressed on the right; the symbol as a whole being of such size that the circumference of a circle having a radius of five-eighths of an inch, would just include all of its points. This character of $\frac{1}{2}$ was registered in the U. S. patent office as a trademark in May, 1875. The original idea of the complainant in using said character $\frac{1}{2}$ was to indicate that the cigarettes stamped with it were made up of two kinds of tobacco, in the proportion of half and half. Defendant, in April, 1875, began to put up cigarettes stamped with the same numerical character $\frac{1}{2}$ in broad, scarlet, red color, with the dividing bar oblique and nearly upright, and of size identical with the same character as used by complainant. The plaintiff filed a bill for a perpetual injunction forbidding the use of said trademark by defendant. *Held*, that said numerical character does not *express* the idea of the tobacco being half and half, but that it *indicated* such idea; that therefore, the case being one of nicety and doubt, an injunction against the use of said character *in any form*, upon goods similar to the plaintiff's would not be granted, but that the defendant

should be enjoined from the use of any imprint upon his goods of the character $\frac{1}{2}$ in the form, size, color and style, as used by plaintiff, and that plaintiff had the right to the exclusive use of said character in the form, color, size and style in which he had used it. *Held*, further, that if the use by the complainant of said character $\frac{1}{2}$ had been absolutely arbitrary, there could be no question of his exclusive right to use it stamped in any form upon his goods. 1877, *U. S. Circuit Ct., Virginia, Kinney v. Allen*, 4 *Am. Law Times R. (N. S.)* 258.

§ 745. Plaintiff used the numerals " $\frac{1}{2}$ " in connection with certain words and a device as a trademark for cigarettes manufactured and sold by him. Defendants imitated said trademark upon their cigarettes, and in an action brought by plaintiff to restrain such imitation claimed that the use of said numerals by the plaintiff was intended to represent that his cigarettes were made one half of Perique and one half Turkish tobacco. The court found that although plaintiff's cigarettes might be so composed, said numerals did not indicate the fact; that they might as well relate to price, to size, to quality, to numbers, as to the quality of the tobacco, and consequently could not be descriptive of any particular quality, except as they may have been so used in connection with the plaintiff's label. *Held*, therefore, that plaintiff was entitled to protection in the use of said numerals in connection with his cigarettes. 1877, *N. Y. Supreme Ct. S. T., Kinney v. Basch*, unreported.

See also §§ 510, 656, 674, 947.

ONE'S OWN NAME.

See NAME, § 600, *et seq.*

OPERATION OF LAW.

Acquisition of trademarks by operation of law.
See §§ 85, 97, 99, 121, 135, 142, 143, 149.

ORIGIN AND OWNERSHIP.

§ 750. The owner of an original trademark has an undoubted right to be protected in the exclusive use of all the marks, forms or symbols, that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed ; but he has no right to an exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their name or quality. He has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. Were such an appropriation to be sanctioned by an injunction the action of a court of equity would be as injurious to the public as it is now beneficial ; it would have the effect, in many instances, of creating a monopoly in the sale of particular goods, as exclusive as if secured by a patent, and freed from any limitation of time.

1849, *N. Y. Superior Ct. S. T.*, *The Amoskeag Mf'g Co. v. Spear*, 2 *Sandf. Sup. Ct.* 599.

§ 751. There was no evidence that the mark, which consisted of the initials of a firm surmounted by a crown, was ever current or accepted in the market as a representation of the persons who manufactured, or of the place of manufacture, or otherwise than as a brand of quality; there was nothing to show that the iron marked with the initials ever had a reputation in the market, because it was believed to be the actual manufacture of those who used the mark. *Held*, that said mark was a trademark properly so called, *i. e.*, a brand which has reputation and currency in the market as a well-known sign of quality, and would be protected by injunction. 1864, *Before Lord Ch. Westbury on appeal*, *Hall v. Barrows*, 10 *Jurist (N. S.)* 55; S. C., 12 *Weekly R.* 322; S. C., 9 *Law Times R. (N. S.)* 561; S. C., 33 *Law J. R. (N. S.) Ch.* 204; reversing S. C., 9 *Jurist (N. S.)* 483; S. C., 11 *Weekly R.* 525; S. C., 8 *Law Times (N. S.)* 227; S. C., 32 *Law Jour. R. (N. S.) Ch.* 548; S. C., 1 *N. R.* 543.

§ 752. By the common law, the manufacturer of goods, or the vender of goods for whom they have been manufactured, has a right to designate them by some peculiar name, symbol, figure, letter, form, or device, whereby they may be known in the market as his own, and be distinguished from other like goods manufactured or sold by other persons; and when original with him, the owner of such mark will be protected by the courts in its exclusive use, but only so far as it serves to indicate the origin and ownership of the goods to which it is attached, to the exclusion of such symbols, figures

and combination of words which may be interblended with it, indicating their name, kind or quality. *Held*, that where the alleged imitation by defendants consisted of a picture and label, which were the same as in plaintiffs' alleged trademark only in the use of the words "Washing Powder," the directions for the use of the powder, and in use of paper of the same color as that used by plaintiffs, there was no infringement of plaintiffs' trademark. 1868, *Supreme Ct. of Cal.*, Falkinburg v. Lucy, 35 *Cal.* 52.

§ 753. A trademark adopted by a manufacturer or merchant for his goods, to be clothed with the attributes of property entitling the appropriator to protection in its exclusive use must, by word, letter, figure or symbol, designate the true origin or ownership of the goods. When any mark, symbol or device is used merely to indicate the name, quality, style, or size of an article, it can not be protected as a trademark. 1868, *Supreme Ct. of Conn.*, Boardman v. Meriden Britannia Co., 35 *Conn.* 402.

§ 754. A name can only be protected as a trademark when it is used merely as indicating the true origin and ownership of the article offered for sale, but never when it is used to designate the article itself, and has become by adoption and use its proper appellation. 1869, *Philadelphia Ct. of Com. Pleas, Pa.*, Ferguson v. Davol Mills, 7 *Phila.* 253; *S. C.*, 2 *Brews.* 314.

§ 755. No property can be acquired in words, marks or devices which do not denote the goods or property or place of business of a person, but only the kind or quality of the article in which he deals. *Ibid.*

§ 756. It is requisite that the device or symbol should perform the office of a finger board and indicate the name and address of the manufacturer, to invest it with the attributes and entitle it to the protection of a trademark. *Ibid.*

§ 757. The bill charged that the complainants are the manufacturers of goods known as silesias or bleached and dyed cotton twillings; that many years ago, by great outlay of time and money, and by improved machinery, &c., they succeeded in producing the manufactured article in question; and that more than thirty years ago they devised and have ever since used a certain trademark and name for the said goods, which consists of a circular label with the letter "K" in the centre, which letter is surrounded by plain lines and ornamental tracings extending outward from the centre and having nothing written or printed upon it except, a little above the top of the letter "K," in an open space between two of the circular lines, the printed letters "No." and at the bottom of the same the letters "Yds." That one of said labels is placed on every piece of goods manufactured and forwarded to market by them, and by long use this mark has become identified with the said goods, and that the goods have come to be known in the markets of the world and to the trade everywhere by the said labels or trademarks, and are known and called by the name of the "K" silesias. That the defendants are engaged in the manufacture and sale of goods similar in appearance, but inferior in quality to theirs, put up in pieces and covered with wrappers similar to those of complainants, and that defendants affix upon one end of each piece an imitation copy and counterfeit of said label or

trademark, whereby defendants are defrauded out of their profits. The defendants denied the fraud charged, and asserted that the plaintiffs' device did not constitute a trademark such as the law will protect. *Injunction refused*, on the ground that the alleged trademark has no name, words, signs, or marks by which in any possible manner or degree the origin or ownership of complainants' goods are indicated, or the place of sale or manufacture pointed out to distinguish them as the complainants' goods. *Ibid.*

§ 758. A generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, cannot be employed as a trademark and the exclusive use of it be entitled to legal protection. As was said in the well considered case of *Amoskeag Manufacturing Company v. Spear*, "the owner of an original trademark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed, but he had no right to the exclusive use of any words, letters, figures, or symbols, which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or qualities. He has no right to appropriate a sign or a symbol, which from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose." 1871, *U. S. Supreme Ct.*, *Delaware & Hudson Canal Company v. Clark*, 13 *Wallace*, 311.

§ 759. The trademark must, either by itself or by association, point distinctively to the origin or

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

§ 760. The petitioners' trademark consisted of the words "1847, Rogers Bros. A. 1." The Rogers brothers superintended the petitioners' spoon and fork manufactory, directed as to the style and quality of such goods, upon which said trademark was placed, and had the general supervision of the manufacturing and sale thereof. The petitioners furnished all the capital, power and machinery, employed and paid laborers, and controlled the sale and disposition of the goods manufactured. The respondents contended that said trademark did not indicate the true origin of the goods. *Held*, that the representation that the Rogers brothers were

the manufacturers, was true in a certain sense, but that the petitioners were, in another sense, the manufacturers. "Like all other symbols and devices used as trademarks, its import was not at first perhaps fully understood. The effect, as well as the value of a trademark, is the work of time and experience. This probably was no exception to the rule. However this may be, it seems to have been well understood by the trade at the date of this petition, that goods bearing that stamp were manufactured by the petitioners." *Held*, that the trademark sufficiently indicated the origin and ownership of the goods. 1872, *Supreme Ct. of Errors, Conn.*, Meriden Britannia Company v. Parker, 39 *Conn.* 450.

PARTIES.

§ 765. The plaintiff and another person, who carried on distinct trades at different places of business, had derived from a common predecessor in their respective businesses, the right to use the name of Dent as a trademark. The defendants having infringed this right: *Held*, on demurrer, that the plaintiff, without averring special damage, might sue alone for an injunction and for the delivery up of the articles so marked to have the name erased. *Held*, also, that he might sue alone for an account of profits made by the defendant out of articles so marked, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to. 1861, *Before V. C. Wood*, Dent v. Turpin, Tucker v. Turpin, 2 *J. & H.* 139;

S. C., 30 *Law J. R. (N. S.) Ch.* 495; S. C., 7 *Jurist (N. S.)* 673; S. C., 4 *L. T. R. (N. S.)* 637.

§ 766. Two persons, sons of the one who had originated the manufacture of certain tobacco pipes and designated them as "Southorn's Brosely Pipes," on the death of their father, manufactured at Brosely, but at separate establishments and for their separate benefit, pipes of a like character. One of the brothers instituted a suit to restrain the use of this trademark, the other declining to join in such suit. *Held*, that the one brother might alone file a bill for an injunction and an account. 1865, *Before V. C. Wood*, *Southorn v. Reynolds*, 12 *Law T. R. (N. S.)* 75.

§ 767. It is unnecessary in a petition for an injunction brought by one who has the sole interest in the trademark, to join as a party a silent partner in the business whose existence is unknown to the public. 1865, *Supreme Ct. of Conn.*, *Bradley v. Norton*, 33 *Conn.* 157.

§ 768. When the manufacturer of goods wrongfully stamped with the trademark of the petitioner conducted the business through an agent, who, with his knowledge and consent, was held up by his principal to the public as the proprietor, and as far as the public could reasonably judge, was the proprietor: *Held*, that an injunction against the farther use of the trademark should be granted in an action to which the principal was not made a party. *Ibid.*

§ 769. In an action to enjoin the violation of a trademark, persons who are not the publishers or makers of the infringing article, and who are engaged as the vendors thereof, may be joined as defendants with the former. The acts of both parties

are to be regarded as kindred, and both wrong-doers may be joined in one action. It is enough to support an injunction against several persons, that particular acts of fraud, kindred in character, are charged against them. 1867, *N. Y. Com. Pleas, S. T., Matsell v. Flanagan*, 2 *Abb. Pr. (N. S.)* 459.

§ 770. In a suit to enjoin the use of a corporate name, the corporation whose name is alleged to be wrongfully used must be a party plaintiff or defendant, but if such corporation refuse to bring such suit upon request, its bondholder or creditor may do so and make such corporation a party defendant. 1870, *U. S. Circuit Ct. Newby v. Oregon Central R. R. Co.*, 1 *Deady*, 609.

See also §§ 809, 820.

PARTNERSHIP.

§ 780. Injunction to restrain surviving partners from using the name of a deceased partner in the firm of the trade refused. The Lord Chancellor said that the use of the testator's name could not subject his name to the trade debts, and that the fraud upon the public was no ground for the plaintiff's (the executor of the deceased) coming into the court of chancery. 1791, *Before the Lord Chancellor, Webster v. Webster*, 3 *Swanston*, 490.

§ 781. A and B carried on the business of pencil-makers, under the firm name of A & L. A died and B carried on the business under the firm of B & Co., successors to A & L. A's executor having commenced the same business, under the firm of A & L, an injunction was granted to restrain him from using that firm name until the right should

have been tried at law. 1835, *Vice Ch. Shadwell, Lewis v. Langdon*, 7 *Simon*, 421.

§ 782. Although the personal representatives of a deceased partner may have a right to participate in the property in a trademark owned by the firm, the surviving partner has a sufficient interest in the mark to entitle him to file a bill to enjoin its use by another. 1846, *Vice Chancellor's Ct., Hine v. Lart*, 10 *Jurist*, 106.

§ 783. If two parties are concerned in getting up a medicine, both contributing to the compound as a partnership action, neither can claim the exclusive use of the name or trademark used in connection therewith. 1851, *Coffeen v. Brunton*, 5 *McLean*, 256 (*U. S. Circuit Ct., Ind.*).

§ 784. A former copartner may be restrained from continuing the use of the signs containing the old firm name, without sufficient alterations or additions to give distinct notice of a change in the firm. And the absolute refusal of the defendant, before suit brought, to remove such signs, dispenses with any obligation on the part of the plaintiff to contribute to the expense of the removal, or from allowing reasonable time therefor. 1857, *N. Y. Supreme Ct. S. T., Peterson v. Humphrey*, 4 *Abb. Pr.* 394.

§ 785. A surviving partner is not entitled, without the consent of the representatives of the deceased partner, to use the firm name upon goods manufactured by himself. *It seems*, that a firm name, which the firm has rendered valuable, is, like other assets of the partnership, held in common after the death of one partner, by the survivor and the deceased's representatives. 1858, *N. Y. Superior Ct. S. T., Fenn v. Bolles*, 7 *Abb. Pr.* 202.

§ 786. Hobart Fenn had been in partnership with the defendant Bolles in the manufacture of faucets, under the firm name of Hobart Fenn & Co. In an action brought by the administratrix of the estate of Fenn, deceased, to settle the partnership affairs, on application of the plaintiff, the defendant was enjoined, until the hearing, from using the name of Hobart Fenn, or Hobart Fenn & Co., upon any faucets manufactured by the defendant. *Ibid.*

§ 787. A, B and C carried on the business of stuff merchants at X under the firm of A & Co. A sold to B and C his share in the business, and the good will thereof, and B and C (with A's assent) announced themselves to the world as "B & C, late A & Co." Some time afterwards A resumed the business of a stuff merchant at X with other persons, under the name of "A & Co." and under circumstances showing it to be his intention to represent to the public that his was the old firm. The court granted an interim injunction restraining A from carrying on the business of a stuff merchant at or in the immediate neighborhood of X under the firm of "A & Co." or from otherwise holding himself out as the successor of the old firm. 1859, *Vice Ch. Wood's Ct.*, *Churton v. Douglas*, 5 *Jurist (N. S.)* 887; S. C., 1 *H. V. Johns*. 174; S. C., 7 *W. R.* 365.

§ 788. The defendant was one of the proprietors and the editor of a weekly periodical called "Household Words." *Held*, on a dissolution of the partnership, that he was not justified in advertising that the publication would be discontinued; for that the right to use the name must be sold for the benefit of all the partners, it being part of the partnership assets. But *held* that he might advertise the discontinuance of the publication as regards

himself. 1859, *Rolls Ct.*, *Bradbury v. Dickens*, 27 *Beavan*, 53.

§ 789. On the dissolution of and winding up of a partnership, where a valuable part of the partnership consists in the good-will of the business carried on by the partners (publishing a newspaper) such value, as much as the furniture of the office or debts due to the firm, must be protected and disposed of for the benefit of the creditors of the firm, or of the partners jointly. Where there is a dissolution of partnership in the business of publishing a newspaper, and the whole title to the paper is owned by one of the partners or a purchaser under the firm, the court has no right, in the absence of any covenant or restriction on the subject, to restrain or interdict the establishment, by the partner, of another paper devoted to the same objects, provided the latter paper is sufficiently distinguished from the former to prevent the doctrine of piracy of trademarks from applying. 1859, *N. Y. Superior Ct. S. T.*, *Dayton v. Wilkes*, 17 *How. Pr.* 510.

§ 790. Where it appeared that the defendants, in having connected themselves with the plaintiffs in the business of manufacturing, advertising and selling pills by a particular name, or designation, and having induced the plaintiffs to expend large sums of money in advertising, &c., the pills so manufactured and then suddenly and without notice, in an unjustifiable manner, and apparently from improper motives, severed their connection with the plaintiffs and set up the same business for themselves: *Held*, that an injunction should be granted, restraining the defendants from using the name or designation ("Dr. Morse's Indian Root Pills") used by the plaintiffs, in designating, mark-

ing, labeling, advertising or selling the pills manufactured by the plaintiffs; and also restraining the defendants from using either of the labels or trademarks of the plaintiffs, or any other labels or trademarks made so similar to the plaintiffs' as would be calculated to deceive the public. 1860, *N. Y. Supreme Ct. S. T.*, *Comstock v. White*, 18 *How. Pr.* 421.

§ 791. The supreme judicial court of Massachusetts has no power to enjoin the use of a trademark which consists in part of the name of one with whom some of the defendants were formerly associated as partners, and which was invented, adopted and used by them during his lifetime, without objection on his part, and has been used by them ever since; but on the application of his executors, the court has power, under Gen. Sts. c. 56, § 4, to restrain the use of his name in their business and firm without having obtained his written consent in his lifetime, or that of his executors since his death, although such use has continued for more than six years. 1861, *Mass. Sup. Jud. Ct.*, *Bowman v. Floyd*, 3 *Allen (Mass.)* 76.

§ 792. A receipt given by executors for money due and paid to the estate of a deceased person from former partners, in which the latter are mentioned by the name of the former partnership, under which they continued to carry on business, will not be construed as a written consent to the continued use of the name of the deceased in the new business and firm. *Ibid.*

§ 793. Partnership property includes the good will of the business and the right to use the trademark; and on the purchase by a surviving partner from the executors of a deceased partner of the

partnership stock at a valuation, the value of the good will and the trademark must be taken into account. 1863, *Before Lord Ch. Westbury on appeal*, *Hall v. Barrows*, 33 *Law Jour. R. (N. S.) Ch.* 204; S. C., 9 *Law T. (N. S.)* 561; S. C., 12 *Weekly R.* 322; S. C., 10 *Jurist (N. S.)* 55; reversing S. C., 9 *Jurist (N. S.)* 483; S. C., 11 *Weekly R.* 525; S. C., 8 *Law Times (N. S.)* 227; S. C., 32 *Law J. R. (N. S.) Ch.* 548; S. C., 1 *N. R.* 543.

§ 794. By articles of copartnership it was provided, that if either of the partners should die before the expiration of the copartnership, the surviving partner should have the option of taking to himself all the stock belonging thereto on paying to the executors of the party dying, the value of his share. The firm were in the habit of using as a trademark the initial letters of the names of the original manufacturers of the articles sold; but the mark had ceased to be a representation that the articles on which it was impressed were the manufacture of the persons whose initials it bore, and had come to be a mere brand, denoting the quality of the articles. *Held*, reversing the decision of the Master of the Rolls, that the exclusive right to the trademark belonged to the partnership as part of its property, and must be included in the valuation. *Ibid.*

§ 795. Upon the formation of a partnership with a person entitled to the benefit of a trademark, in the absence of express provision in relation to it, it becomes an asset of the partnership. 1864, *Ch. Ct. of Appeal*, *Bury v. Bedford*, 10 *Jurist (N. S.)* 503; S. C., 33 *Law Jour. R. (N. S.) Ch.* 465; S. C., 12 *Weekly R.* 726; S. C., 10 *Law Times (N. S.)* 470; S. C., 4 *N. R.* 180; reversing S. C., 11 *Weekly R.*

973; S. C., 8 *Law Times* (N. S.) 847; S. C., 32 *Law Jour. R.* (N. S.) *Ch.* 741; S. C., 9 *Jurist* (N. S.) 956; S. C., 1 *N. R.* 5.

§ 796. Upon the decease of one partner, a decree was made for the sale of the business as a going concern, and it was proposed to sell to any purchaser "the right to hold himself out as the successor of the firm of Samuel Johnson & Sons." *Held*, that the particulars of the sale ought to explain that the surviving partner, William Johnson, had still a right to carry on the same business in the same town in his own name. On appeal, it was *held* that the words "with the exclusive right in the purchaser to hold himself out as the successor to the said firm of S. Johnson & Sons," should be stricken out, and these words added: "The sale will give to the purchaser both the premises in which the business has been carried on and the benefit to be derived from the habits of the customers resorting to such premises, but it will not prevent any of the persons heretofore interested in the business, or those who may represent them, from carrying on the like business." 1864, *Rolls Court*, *Johnson v. Hellely*, 34 *Beav.* 63; S. C., on appeal, 2 *De Gex, J. & S.* 446.

§ 797. On the dissolution of a partnership each partner is, in the absence of any special agreement, entitled to trade under the name or style of the old firm. 1865, *Rolls Court*, *Banks v. Gibson*, 34 *Beav.* 566; S. C., 13 *Weekly R.* 1012; S. C., 34 *Law J. R.* (N. S.) *Ch.* 592.

§ 798. The plaintiff's husband, B, and the defendant for many years carried on business under the style of B & Co. The plaintiff, on the death of her husband, continued the partnership in pursu-

ance of a proviso in the articles of partnership. The plaintiff and defendant afterwards dissolved partnership by mutual consent, and no stipulation was made with respect to the use of the name of the firm. The defendant continued to trade under the style of B & Co., while the plaintiff traded in her own name, B. There was evidence to show that customers of the plaintiff had been deceived by the use of the name of the old firm, and had sent to the defendant orders intended for the plaintiff; but there was no evidence of fraud on the part of the defendant. *Held*, that the plaintiff was not entitled to an injunction to restrain the defendant from trading as B & Co. *Ibid*.

§ 799. A partnership deed witnessed that the lands, mills, and machinery, which theretofore had belonged exclusively to M (one partner) should remain his sole property, subject during the partnership to be used for all partnership purposes; and provided that the retiring partners should, at the end of the partnership, be paid, by M's promissory notes, the value of their respective shares in the partnership stock and capital. No mention was made therein of the good will, name of the firm, or trademarks. After eight years the partnership was dissolved. The outgoing partners insisted that M should pay them for the name, good will, and trademarks, at a valuation. *Held*, that M was entitled to the name, &c., upon paying the outgoing partners pursuant to the deed; but without their being separately valued. The petition, praying an injunction to restrain M from using the name &c., was dismissed with costs. *Dickson v. M'Master*, (Affirmed with the court of C. A., with this variation, that in taking the account, the good will

should be valued separately.) *Gamble's Index*, 983; S. C., 11 *I. Jur. (N. S.)* 202.

§ 800. R. Scott and the plaintiff, W. Scott, carried on business at N. and G. in partnership, under the firm of R. and W. Scott. By an agreement for dissolution it was agreed that one of the partners should remain at N. but there was no stipulation by which either party bound himself not to continue the business, but only that they would not carry it on together. There was no disposition of the good will to the partner who remained at N. Neither party was to use the name of the firm except so far as might be necessary in winding up the partnership affairs. Shortly after the date of the agreement, W. Scott retired from the business and set up business for himself at T near N. The inscription used by the firm over the door of their place of business at G had been "R. and W. Scott, of N." R. Scott made over his business at N and G to the defendants, who, at their premises at G made use of the inscription "Scott and Nixon, late R. and W. Scott, of N." On the application of the plaintiff, the court granted an injunction restraining them from using such an inscription, inasmuch as it amounted to a representation that they had succeeded to the business of the late firm. *Held further*, that the plaintiff need not prove special damage. 1866, *Vice Ch. Wood's Ct.*, *Scott v. Scott*, 16 *L. T. R. (N. S.)* 143.

§ 801. Fay, J, R and T, as copartners, began the business of manufacturing machinery at Worcester, in 1852, under the firm name of F & Co.; and Fay, J, R and C, as copartners, began a similar business at Cincinnati in 1853, under the same firm name, using it as the style of the concern and

as a trademark. Fay died in 1854. Ever since his death, J, R and C, copartners, continued the business at Cincinnati with all the rights as to the use of the name of F and Co., which their firm had originally ; and J, R and T, copartners, continued the business at Worcester, under the name of F and Co., with the assent of F's representatives, until 1861, when their firm was dissolved, and its orders, correspondence and good will were sold to T, who thereafter engaged in the business of buying and selling, but not of manufacturing machinery. *Held*, that J, R and C, could not maintain a bill in equity to restrain T from using the name of F and Co. in his business, and attaching it to machinery which he sells made by other persons than himself. 1867, *Supreme Jud'l Ct. of Mass.*, *Rogers v. Taintor*, 97 *Mass.* 291.

§ 802. One tradesman has no right to use the trademarks or names previously adopted and used by another, so as to induce purchasers to believe, contrary to the fact, that they are buying the articles to which the marks were originally applied. Trademarks are property, and a person using such marks without the sanction and authority of the owner will be restrained by injunction, even where it does not appear there was any fraudulent intent in their use, and will be required to account for the profits derived from the sale of goods so marked. Accordingly, where the defendants S and H had become entitled by articles of dissolution of partnership to certain wrappers and labels belonging to the late firm, and had stipulated not to use them for any purpose except for re-wrapping medicines coming back in bad order, and said S and H sold said labels to the defendants C and P in order that

they might be used for medicines manufactured by C and P in imitation of the plaintiff's preparations: *Held*, that the defendants S, H, C and P, should be enjoined and that the plaintiff should be compensated by having an account taken. 1870, *Md. Ct. of Appeals*, Stonebreaker v. Stonebreaker, 33 *Md.* 252.

§ 803. Upon the dissolution of a firm composed of the plaintiff, Edgar H. Reeves, and the defendants, the former, by a written conveyance, sold and transferred to the latter, all his interest in the partnership property and effects. Such property and effects were not described. *Held*, that the defendants, by such conveyance, did not acquire the right to use the firm name of "E. H. Reeves & Co.," under which the business of the partnership had previously been conducted, as a label on their goods, or to advertise themselves as the successors of such firm. 1871, *N. Y. Superior Ct. S. T.*, Reeves v. Denicke, 12 *Abb. Pr. (N. S.)* 92; criticising and disapproving Peterson v. Humphrey.

§ 804. That there may be and is "property" in a name seems to be conceded, and the names of newspapers, hotels and places of amusement are instances of this species of property. Such names may be dealt with as property, and are the subject of sale and transfer, and are often of great value. Where the name under which a business of any nature is carried on, is that of the *proprietor*, it would require clear and express words of conveyance to secure a transfer to a purchaser of the right to continue the use of such name, for his convenience or profit. When, therefore, the name and style of a mercantile firm is that of the principal, and most responsible and influential member of the partnership, the mere transfer of the interests of

such member, in the partnership property, will not convey the partnership name to the purchaser, or give to him the right to continue its use against the consent of such person. *Ibid.*

§ 805. In the sense of a very common practice of persons who have acquired the property of an old and well established mercantile firm, of using the term "successors to" such firm, there may be an assumed right to so continue the use of such firm name. But such common practice does not give the right. It can be acquired only by a grant from the owner, and when such grant has not been made there is no succession to it. *Ibid.*

§ 806. It is a very common mistake to suppose that a purchaser of the property of a mercantile firm is the "successor" of the firm. He succeeds to the property, to all that is conveyed to him, but to nothing more; and he has no more right to describe himself as the successor of such firm because he has purchased its property, than he has to designate himself the successor of a manufacturing company from which he had casually purchased some goods. *Ibid.*

§ 807. One Daniel Simmons, who, from 1842, had been engaged in the business of making axes, took the plaintiffs into partnership with him in 1848, under the name of "D. Simmons & Co." which they used on their stamps and labels. The firm continued until Simmons's death in 1860, without any change in the trademark. In October, 1861, plaintiffs made an arrangement with Jonas Simmons, the legatee of Daniel Simmons, and with the executors of the latter, under which they continued the use of the name "D. Simmons & Co." as their trademark. *Held*, that the plaintiffs are entitled

to use the trademark "D. Simmons & Co.," and that Jonas Simmons did not have (at least after October, 1861) any right to use that name. 1872, *N. Y. Supreme Ct. Circuit, Weed v. Peterson*, 12 *Abb. Pr. (N. S.)* 178.

§ 808. On a dissolution of partnership between S and R, all the property of the partnership was bought by R, and paid for on a valuation, but he did not pay for good will, *nominatim*. S was living, and not a bankrupt. *Held*, that R was not entitled to continue to use the name of S, in the style of the firm. 1872, *V. Ch. Wood's Ct., Scott v. Rowland*, 26 *Law Times R. N. S.* 391; *S. C.*, 20 *Weekly R.* 508

§ 809. A entered into a copartnership with B, soon after dissolved it and formed with C a partnership under the name of A & Company. Two years afterwards A died, and his administrator conveyed to B the right to use A's name in his business. *Held*, that the administrator and B might join in a bill in equity under the Gen. Sts. c. 56, § 3, to restrain C from continuing to do business under the name of A & Company. 1872, *Mass. Sup. Judl Ct., Morse v. Hall*, 109 *Mass.* 409.

§ 810. A trader, who has been a manager or a partner in a firm of established reputation, has a right, on setting up an independent business, to make known to the public that he has been with that firm; but he must take care not to do so in a way calculated to lead the public to believe that he is carrying on the business of the old firm, or is in any way connected with it. 1872, *Ch. Ct. of Appeal, L. J. J., Hookham v. Pottage*, *L. R.* 8 *Ch.* 91; *S. C.*, 27 *L. T. R. (N. S.)* 595; *S. C.*, 21 *W. R.* 47; affirming *S. C.*, 26 *L. T. (N. S.)* 755, and *S. C.*, 26 *W. R.* 720.

§ 811. The plaintiff, an old established tailor, took the defendant, who had been his foreman, into partnership, and the business was carried on under the name of H & P. The partnership was afterwards dissolved by a decree of the court, in which it was provided that the business of the partnership should belong to the plaintiff. The plaintiff accordingly kept up the shop under the name of H & Co. Subsequently the defendant set up a shop only a few doors from the plaintiff's shop, and painted over the door the words "P, from H & P." *Held* (affirming the decree of *Malins, V. C.*), that having regard to the manner in which the names were painted up, the defendant had done that which was calculated to lead the public to suppose that he was still connected with the old firm, and that the plaintiff was entitled to an injunction. *Ibid.*

§ 812. William P. Winchester, was, in 1847, the surviving member of the firm of "E. A. and W. Winchester," which established a soap manufactory in C in 1821, and used the firm name as a trademark. In that year said Winchester formed a partnership with the defendant for the purpose, as the articles stated, "of continuing the business in the same name and style of the late firm." The articles provided that William P. Winchester might dissolve the partnership at any time (in which case the defendant should have no claim except for his share of accrued profits), and might by his will give the right to his relatives to become members of the firm, which should be continued under the same name. William P. Winchester died in 1850, and by his will directed that his trustees should allow the firm of "E. A. and W.

Winchester," if the defendant should be a member thereof, to continue in possession of the testator's land at a certain rent, and, if desired, to borrow \$100,000 from his personal estate, if not needed for payment of bequests, unless all his trustees (one of whom should always be a member of the firm) should deem it proper to withdraw such real and personal property; and he named the plaintiffs and the defendant executors and trustees. The defendant continued the business under the same name, first alone and then with partners, using the firm name as a trademark, until 1867, when the partnership was dissolved. In 1868, the executors and trustees sold the manufactory with the fixtures and utensils to L. *Held*, that the plaintiffs could not maintain a bill in equity to restrain the defendant from using the name "E. A. and W. Winchester," as a trademark, and to compel him to join in an agreement to transfer to L the right to use it. 1872, *Sup. Jud'l. Ct. Mass.*, *Sohier v. Johnson*, 111 *Mass.* 238.

§ 813. When a firm under a contract with the owner has the right to the exclusive use of a trademark, and during the partnership one of the firm enters into an agreement with the owner, whereby the previous contract is canceled and a new one made, giving to such member the exclusive use of the trademark for a certain number of years, on certain conditions, and at the end of that term, the conditions having been performed, the sole and exclusive right and title to the trademark: *Held*, that such partner took and held the contract, and all the rights and interests given thereby, as trustee for the firm. When one partner, during the partnership, negotiates respecting, and obtains the exclu-

sive use of a right in which the firm was interested, he will be declared to hold such use in trust for the firm. 1875, *N. Y. Superior Ct. G. T., Weston v. Ketcham*, 39 *N. Y. Superior Ct.* 54; and see S. C., 51 *How. Pr.* 455.

§ 814. In the trademark case last above put, the other partners, after knowledge of the contract made by their copartner, expressed their disapprobation, but did not immediately resort to their legal remedy, and notwithstanding the act of their copartner still continued the firm, and in its business used the trademark, and manufactured under it as before, and paid to the owners out of the firm's funds the sums stipulated to be paid; yet it appearing that the copartner who procured the contract for his own benefit alone knew the secret of the manufacture, *Held*, a forced acquiescence, which would not sustain a finding of ratification. If they had moved in the matter adversely, they would, in asserting their remedy, not have possessed the knowledge by the use of which the capital employed in the manufacture (all of which was contributed by them) might be made remunerative. *Ibid.*

§ 815. Although in the case last above put the defendant does not know the secret of the manufacture, and was selling under the trademark an article different from that represented by it, yet (whatever may be the effect of these elements in other cases) no cause of action arises therefrom against him in favor of one who has no more right to the trademark than he has. *Ibid.*

§ 816. Defendant, survivor of the firm of Phelan & Collender, on decease of his partner, purchased of his executors all the trademarks and the business of the old firm; he continued the business, describ-

ing himself as "H. W. Collender, successor to Phelan & Collender," and describing his billiard tables as "Phelan & Collender's Standard American Tables." Plaintiff, a son of said deceased, was engaged in the same business, and alleged that defendant by use of the words "successor to Phelan & Collender" and said description on billiard tables, was injuring his business by inducing customers of the late firm, who would otherwise have dealt with plaintiff, but who had been misled by the use of such name, to deal in billiard tables with defendant. *Held*, that plaintiff's right of action did not rest on his relationship to his deceased father, nor upon any right or interest in the concerns of the late firm, but solely on the ground that his name was Phelan, and that he was engaged in the business of manufacturing and selling billiard tables, and that his business was injured by the use of that name by defendant, in connection with his business; that any other Phelan, who happened to be in the same business, would have the same legal right to enjoin the use of the name by defendant, and could maintain an action for that purpose if plaintiff could do so; and that, as he did not allege that the defendant had used the name Phelan in such a way as to make it appear to be that of plaintiff himself, or had resorted to other artifice, to induce the belief that the establishment of defendant was the same as that of plaintiff, or to mislead customers to purchase of him under the belief that they were buying of plaintiff, or were buying articles of plaintiff's manufacture, he was not entitled to any injunction. 1875, *N. Y. Supreme Ct. G. T.*, *Phelan v. Collender*, 6 *Hun*, 244.

§ 817. A, C & Co. being the successors by purchase of Stillman & Co., woolen manufacturers,

continued to use "Stillman & Co." as a trademark on their ticket for goods. Latimer, Stillman, & Co. the lessees of a mill formerly used by Stillman & Co., known both as the "Stillman Mill," and as the "Seventh Day Mill," also used "Stillman & Co." as a trademark. On a petition for injunction, brought by A, C & Co., against Latimer, Stillman, & Co., to prevent their so using the words "Stillman & Co.," it appearing that no deception could be charged on either complainants or respondents, and that no person of the old firm of Stillman & Co., was a member of the firm of A, C & Co. *Held*, that the injunction could not be granted. *Held*, further, that a manufacturer has the right to label his goods with his own name or that of his mill, if no fraudulent purpose is intended. 1876, *Supreme Ct. of R. I.*, Carmichael v. Latimer, unreported.

§ 818. *Query*. If the English practice of retaining a firm name, when no original partner remains, is generally recognized in American law? *Ibid*.

See also §§ 614, 767, 870.

PARTNERSHIP NAME.

See PARTNERSHIP.

PATENT.

As to the use of the word "Patent," see MISREPRESENTATION.

As to the right to use the name of a patentee, see PATENTEE (NAME OF).

See also §§ 4, 32, 510.

PATENTEE—NAME OF.

See NAME.

PERIODICALS.

See PUBLICATIONS.

PLAYS.

See PUBLICATIONS.

PLEADING.

§ 820. D, the inventor of a medicine, employed P, a foreigner, residing abroad, to manufacture it for him there, and D sold it in England for his own sole profit. A label and seal denoting that the medicine was manufactured by P and sold by D, were affixed to each of the bottles in which it was sold. The defendants imitated the labels and seals, and D & P filed a bill for an injunction and an account. Demurrer allowed on the ground that it did not appear that P had any interest in the labels and seals—the parties asking joint relief, not being entitled to joint relief. 1828, *High Ct. of Chancery*, *Delondre v. Shaw*, 2 *Sim.* 237.

§ 821. The declaration, after stating that the plaintiffs prepared, vended and sold, for profit, a certain medicine called "Morrison's Universal Medicine," which they were accustomed to sell in boxes wrapped up in paper, which had those words printed thereon, alleged that the defendant, intending to injure the plaintiffs in the sale of their said medicines, deceitfully and fraudulently prepared medicines in imitation of the medicines so prepared by the plaintiffs, and wrapped up the same in paper, with the words "Morrison's Universal Medicine" printed thereon, in order to denote that such medicine was the genuine medicine prepared and sold by the plaintiffs; and that the defendant deceitfully and fraudulently vended and sold, for his own lucre and gain, the last mentioned boxes of the said articles, represented by him to be medicines by the name and description of "Morrison's Universal Medicine" which had been prepared and sold by the plaintiffs; whereas, in truth, the plaintiffs had not been the preparers, &c., thereof. *Held*, on a motion to arrest the judgment, that the declaration disclosed a sufficient cause of action. Verdict for plaintiff sustained. 1841, *Ct. of Com. Pleas*, *Morrison v. Salmon*, 2 *Man. & Gr.* 385.

§ 822. In actions on the case in trademark cases, it is enough,—at least after verdict—to allege generally, that, by means of the premises, the plaintiff was deprived of the sale of divers large quantities of goods, and lost the profits that would otherwise have accrued to him therefrom. 1847, *Rodgers v. Nowill*, 11 *Jurist*, 1037; S. C., 5 *C. B. (Man. Gr. & Sc.)* 109; S. C., 17 *L. J. R. (N. S.) C. P.* 52; S. C., 6 *Hare*, 325.

§ 823. A declaration stated that the plaintiff

had *established* a bank in London called "The Bank of London," and was the first person who had established a bank by or under that name, and had established the said bank at great expense, and caused the name to be published and affixed on the offices of the said bank so that the same might be seen and known by the public, and had caused prospectuses of the said bank to be printed and circulated with the said name and title of "The Bank of London" thereon, and the said bank was then commonly known by the name of, and was the only bank named or styled, "The Bank of London," whereby the plaintiff *had acquired and was acquiring great gains and profits*. It then proceeded to allege that the defendants, intending to *injure the plaintiff in his said bank and the said business of his said bank*, afterwards, and while his said bank was the only bank named or styled "The Bank of London," wrongfully and fraudulently established a certain other bank in London, under the name, style and title of "The Bank of London" *in imitation of, and as representing, the said Bank of London of the plaintiff*, and wrongfully and fraudulently transacted business at the said bank so established by the defendants under the said name, and under the false color and pretense, that the same was the bank established by the plaintiff; and that thereby the plaintiff had been prevented from carrying on his business at the said bank so established by him, so fully and extensively as he would otherwise have done, *and had been deprived of profits*, and that by means of the premises, divers persons were induced to believe and did believe that the bank so established by the defendants was the bank called "The Bank of

London'' established by the plaintiff. *Held*, that the declaration disclosed no cause o' action, it not being averred that the plaintiff had ever carried on the business of a banker. 1856, *Ct. of Com. Pleas*, *Lawson v. Bank of London*, 18 *Common Bench*, 84.

§ 824. Where the complaint set up that the plaintiffs and defendant entered into an agreement whereby the former agreed to sell and did sell to the latter twenty thousand empty papers or bags for seeds with the plaintiffs' label thereon, and two thousand bags of seeds with the plaintiffs' label thereon, for the sum of \$52.27; that the defendant agreed to pay said sum and to fill said empty bags with seeds of good quality and sell or dispose of them so filled and the bags of seed purchased of the plaintiffs, with their labels on the same, in Dutchess County, New York, and nowhere else; and that the plaintiff fulfilled their part of said agreement, but that the defendant, wrongfully intending to injure the plaintiffs in their business and reputation as seedsmen, filled said empty seed bags with seeds of a poor quality and sold or disposed of them, together with the said bags of seeds sold to him by the plaintiffs, at divers other places than in said Dutchess County, by reason of which premises the plaintiffs had suffered damages to the extent of \$200. *Held*, that the contract for sale of said empty bags with the plaintiffs' labels thereon, for the purposes aforesaid, was against public policy and void, and that—as the consideration is entire—a demurrer to said complaint was well taken. 1857, *N. Y. Supreme Ct., G. T.*, *Bloss v. Bloomer*, 23 *Barb.* 604.

§ 825. In an action on the case, where the

declaration alleged in substance that the defendant, well knowing the plaintiffs' trade mark "Roger Williams Long Cloth," and for the purpose and with the effect of deceitfully passing off his own goods for those of the plaintiffs, did stamp the words "Roger Williams" upon cotton cloth not manufactured by the plaintiff, and to his serious injury: *Held*, that under the rule that a partial imitation of a trademark, if calculated to deceive, will support an action, this is a sufficient allegation of an invasion of the plaintiffs' rights. 1860, *Supreme Ct. of R. I., Barrows v. Knight*, 6 *R. I.* 434.

§ 826. A declaration alleged that the plaintiff was employed by the defendant to make certain articles, and that the defendant fraudulently directed the plaintiff to place on each of the said articles a mark which was the trademark of one R; and that the defendant did so innocently, and was thereby subjected to a chancery suit at the suit of R, which he had to pay a large sum to compromise. *Held*, that as this suit could have been prosecuted by R successfully for an injunction and an account, the declaration showed a good cause of action. 1861, *Queen's Bench, Dixon v. Fawcus*, 7 *Jurist (N. S.)* 895; S. C., 30 *Law J. R. (Q. B.)* 137; S. C., 9 *Weekly R.* 414; S. C., 3 *Law Times R. (N. S.)* 693; S. C., 3 *EL. & EL.* 537.

§ 827. In an action brought to restrain the defendants from infringing plaintiffs' trademark and for damages, an answer alleging that the defendants had sold only a very small and specified quantity of merchandise bearing the label complained of, and that the same was sold to plaintiffs' agent at their request and that the use of the label was accidental,

without intent to defraud plaintiffs, or imitate their label and did not represent the article to be the plaintiffs', is not frivolous. 1852, *N. Y. Superior Ct. G. T.*, *Guilhon v. Lindo*, 9 *Bosw.* 605.

§ 828. Complainants alleged that they are entitled to the sole and exclusive right to manufacture and sell a certain preparation known as Dr. Simmons' Liver Regulator or Medicine, and have acquired right thereto by purchase; and that they have expended large sums of money in manufacturing and advertising it, by which it has become widely known and justly celebrated for the purposes it is intended to accomplish. And that they have adopted certain trademarks, in which their packages are put up; and that the plaintiff in error has commenced to sell a preparation which he calls by nearly a similar name, and is putting it up in packages of similar form and size, and that the general appearance and printed indorsements thereon, is intended to take advantage of the reputation acquired by the reputation of Zeilen & Co., which they allege is a fraud upon their rights, &c. To which bill a demurrer was filed, which was overruled by the court. *Held*, that as the demurrer admits that what was done, was done intentionally to take advantage of the reputation of the complainants' "Simmons' Liver Medicine," the court below did not err in retaining the bill for a hearing to let the whole matter be determined upon its merits. 1871, *Supreme Ct. of Ga.*, *Ellis v. Zeilen*, 42 *Ga.* 91.

§ 829. A sale of a mineral spring carries to the purchaser the right to use the trademark of the waters; and in an action by the purchaser to enjoin third persons from infringing, the complaint need

not allege any express assignment of the trademark. 1871, *N. Y. Ct. Appeals*, Congress & Empire Spring Company *v.* High Rock Congress Spring Company, 45 *N. Y.* 291; S. C., 10 *Abb. Pr. (N. S.)* 348; reversing S. C., 57 *Barb.* 526.

§ 830. In an action for damages for infringement of a trademark, an answer denying knowledge of plaintiff's ownership of the trademark, and any intention to do wrong, and averring a single sale of the simulated article, is not frivolous; these allegations being important on the question of damages. 1871, *N. Y. Supreme Ct. S. T.*, Faber *v.* D'Lassey, 11 *Abb. Pr. (N. S.)* 399.

§ 831. A bill was filed to restrain the defendants from issuing a prospectus calculated to mislead the public into the belief that the business carried on by the defendants was the plaintiffs' business. The bill stated that one of the defendants (C. J. Christie), had been adjudicated a bankrupt, and prior thereto had lost his situation as secretary of St. Marylebone Female Charity School, in consequence of having been charged with intent to defraud one S by false cheques; that he had been committed for trial and the money, in respect of which the charge had been made, subsequently paid by one of his relatives, and that S had then withdrawn from prosecution—that the defendants were persons of no means. Exceptions were taken only to those statements regarding the charge made against the defendant C. J. Christie as being scandalous and impertinent. *Held*, that it was relevant to the issue to state what were the antecedents of the defendants, who they were, from whence they came, and how they had been employed; that though the matter was scandalous, as it was

relevant to the issue it was not impertinent, and that the exceptions should be overruled. *Christie v. Christie*, *Vice Ch. Malins, Weekly Notes*, 1873, 7; S. C., reversed, *L. J. J. Ibid.* 70.

§ 832. In an action to restrain the violation of a trademark, a counter-claim on the part of defendant alleging that he is himself the owner of the name, that plaintiff has wrongfully used it, and asking that plaintiff be restrained from such use, and be required to pay damages for the infringement of the defendant's right thereto, is proper; and if the allegations are sustained, defendant is entitled to the relief sought. It is a cause of action connected with the subject of the action set forth in the complaint, and so falls within the definition of a counter-claim, as given by the Code of Procedure (§ 150). 1874, *N. Y. Com. of App.*, *Glen & Hall Mfg. Co. v. Hall*, 61 *N. Y.* 226; rev'g S. C., 6 *Lans.* 158.

PRACTICE.

§ 840. *It seems*, that on a motion to dissolve an injunction restraining the use of a trademark, granted on the complaint and affidavits, the plaintiffs are not at liberty to read new affidavits to support the allegations in the complaint. *Per WOODRUFF, J.* Whether in a case wherein the defense rest upon new matter set up in the answer, in avoidance of the facts charged in the complaint, but admitting the charges to be true, the answer may be regarded as itself an affidavit, so as to permit counter affidavits by the plaintiffs? *Quere.* 1855, *N. Y. Common Pleas, G. T.*, *Merrimack Mfg. Co. v. Garner*, 4 *E. D. Smith*, 387; S. C., 2 *Abb. Pr.* 318.

§ 841. Where a preliminary injunction is dissolved on the ground that the plaintiff's legal title to his trademark is doubtful, it is proper to impose, as a condition to such dissolution, that the defendants enter into an undertaking to keep an account of their sales and render the same when required by the order of a competent court. The plaintiff to establish in the action his legal title, if he can, as well as any other grounds of relief, upon the trial. The undertaking to be considered as security for keeping the account and rendering it. 1857, *N. Y. Superior Ct. S. T.*, Fetridge v. Merchant, 4 *Abb. Pr.* 156.

§ 842. If a party is examined as a witness, his refusal to answer a cross question, pertinent to the issue, is his own act. It must entail upon him the loss of his testimony in his own favor, or may subject him to the usual compulsory process to compel a witness to testify if his adversary require it. 1860, *N. Y. Superior Ct. G. T.*, Burnett v. Phalon, 11 *Abb. Pr.* 157; *S. C.*, 19 *How. Pr.* 530.

§ 843. Whether a referee appointed merely to compute and report the damages sustained by the plaintiffs by reason of the violation of their trademark, admitting he has the power to strike out the plaintiff's testimony in chief, for refusing to answer a pertinent question, on cross examination, has the power to issue a compulsory process to require the plaintiff to answer. *Quere? Ibid.*

§ 844. The better practice is for the referee to give a certificate setting forth the questions, with the objections in detail of the witness to answering them, and his decision upon them, that the *court* may pass upon the remedy. *Ibid.*

§ 845. Where, however, the referee in such case

struck out the plaintiff's testimony as to damages, for his refusal to answer a pertinent question on his cross examination, and then closed the case, and thereby shut out all testimony on that question, which might have formed a general exception to the report: *Held*, that an exception to this decision brought up the case to be regularly passed upon by the court. *Ibid*.

§ 846. In trademark cases, under the Code of Procedure, the judgment cannot direct the damages to be assessed by a sheriff's jury. The proofs must be taken by the court or referee. 1862, *N. Y. Superior Ct. G. T.*, *Guilhon v. Lindo*, 9 *Bosw.* 605.

§ 847. Where in an action brought to enjoin the use by defendant of plaintiff's trademark and for damages, judgment is ordered for frivolousness of defendant's pleadings, the judgment should be either in the form proper where nothing is left to be ascertained but the amount of damages, or it should simply adjudge the pleading frivolous and leave the plaintiff to apply to the court for the relief he seeks. *Ibid*.

§ 848. The plaintiff in an action is entitled to an injunction at the time of issuing the summons upon the complaint alone, if it makes a proper case and is verified in the manner stated in the one hundred and thirteenth section of the practice act (*Laws of California*), but if he asks for an injunction thereafter, he must do so upon affidavits. Where an injunction has been granted without notice to the defendant, he may move to dissolve, first upon the papers, whatever they may have been, upon which it was granted, or second, upon the papers upon which it was granted and affidavits on the part of the defendant, with or without the answer. If the

defendant rests his motion on the papers upon which the injunction was granted, the plaintiff can make no further showing, but must stand upon his complaint, or his complaint and affidavits, as the case may be; but if the defendant makes a counter showing, by affidavits, with or without the answer, the plaintiff may meet it with a further showing on his part. If the defendant moving to dissolve an injunction, uses his verified answer for that purpose, he makes it an affidavit in the sense of section 118 of the practice act for all the purposes of his motion; and, as in the case of his use of affidavits for that purpose without the answer, the plaintiff is equally entitled to reply by way of affidavits on his part. 1868, *Supreme Ct. of Cal.*, *Falkinburg v. Lucy*, 35 *Cal.* 52.

§ 849. An appeal from a decree granting an injunction to restrain the use of a trademark ordered to be advanced, on the ground that the injury done to the defendant by the continuance of the injunction, if wrongly granted, would be irreparable. 1870, *Before the Lords Justices*, *Lazenby v. White*, *Law R. 6 Ch. Ap.* 89; *S. C.*, 19 *W. R.* 291.

§ 850. In a suit in equity to restrain an alleged infringement of a trademark right in the title of a publication, where it did not appear whether or not the public was actually deceived, or in danger of being deceived, it was referred to a master, to ascertain and report whether such was the fact. 1872, *U. S. Circ. Ct. Maine*, *Osgood v. Allen*, 1 *Holmes*, 185; *S. C.*, 6 *Am. Law T. R.* 20.

PRIOR USE.

§ 856. In asserting a prior use of the trademark, the claim is not supported by proof that one term of

the same appeared incidentally in a longer phrase, whereof the conspicuous element was quite different; for instance, a trademark, in 1865, of "Genuine Durham Smoking Tobacco" is not invalidated by the defendant's use in 1860, of a brand of "Best Spanish Flavored Durham Smoking Tobacco," where the pleadings and proofs show that "Durham" was used incidentally and without significance; and the characteristic and descriptive phrase was "Best Spanish Flavored," having special reference to a flavoring compound, which was claimed as a discovery in the treatment of the article. 1872, *U. S. Circ. Ct. Va.*, *Blackwell v. Armistead*, 5 *Am. Law Times*, 85.

§ 857. Three brothers, William, Asa H. and Simeon S. Rogers, were engaged for many years in the business of manufacturing plated spoons and forks, sometimes as partners under the name of "Rogers Brothers," and sometimes as stockholders in joint stock corporations. The goods manufactured by such partnerships and corporations were stamped with various devices, each of which contained the name "Rogers." In 1862, all such partnerships and corporations, with one exception, had ceased to do business, and the three brothers entered into a contract with the plaintiffs, by which the latter agreed to manufacture such goods under their supervision. The goods so manufactured were stamped "1847, Rogers Bros., A 1," which stamp differed somewhat from any stamp previously used. The plaintiffs claimed protection, not in the words, "Rogers Brothers," but "Rogers Bros," with the figures "1847" prefixed and the letter and figure "A 1" annexed. The respondent contended that the name "Rogers Brothers" could not lawfully be used by

the plaintiffs as a trademark, for the reason that long before the plaintiffs commenced to stamp their goods with that name, it had been appropriated by other manufacturers for that purpose, and for the reason that it was then well known in the market as a brand for the goods of manufacturers other than the plaintiffs. *Held*, that the plaintiffs acquired a lawful right to the use of such name as a part of their trademark. That the mere fact that the name "Rogers Brothers" had been previously used by other persons and corporations, could not, of itself, operate to prevent the plaintiffs from acquiring a right to the use of the same name as a part of their trademark. That said partnerships and corporations, save one, having lost or surrendered the right to said name by ceasing to manufacture goods, the right to the use of their own name reverted to the Rogers brothers, who might under certain legal restrictions impart that right to the plaintiffs. That the respondent had no cause of complaint, or right to derive any advantage from the fact that the trademarks of the plaintiffs and said single corporation which used the name "Rogers & Brothers," resembled each other. 1872, *Supreme Ct. of Errors, Connecticut*, Meriden Britannia Co. v. Parker, 39 Conn. 450.

See § 262, ACQUISITION OF TRADEMARKS.

PUBLICATIONS.

- I. Publications—generally, § 865.
- II. Advertisements, circulars, &c., § 867.
- III. Books, plays, &c., § 877.
- IV. Newspapers, § 890.

I. *Publications—generally.*

§ 865. The court will not protect the owner of a mischievous or libelous publication by restraining the publication of it by other persons. 1802, *Lord Ch. Eldon, Walcot v. Walker*, 7 *Ves. Jr.* 1; 1817, *Lord Ch. Eldon, Southey v. Sherwood*, 2 *Mer.* 435.

§ 866. The court of chancery has jurisdiction to prevent the publication of any letter, advertisement, or other document, which, if permitted to go on, would have the effect of destroying the property of another person, whether that consists of tangible or intangible property, whether it consists of money or reputation. The publication of a notice stating that the plaintiff was a partner in a bankrupt firm, restrained. 1869, *Vice Ch. Malins, Dixon v. Holden*, *L. R.* 7 *Eq.*, 488. See 1 *H. L. C.* 363; 11 *Beav.* 112; *L. R.* 6 *Eq.* 551; *L. R.* 2 *Ch.* 307.

II. *Advertisements and Circulars.*

§ 867. The defendant, a chemist and druggist, had inserted advertisements in the public journals, so expressed as to induce the world at large to believe that certain pills sold by him, and intended for the cure of consumption, were pills prepared and sold by him, with the sanction of the plaintiff, who was a physician of great eminence, practising in the metropolis, and celebrated for his skill in cases of consumption. *Held*, on application for special injunction to restrain the publication of such advertisements, that the court had no jurisdiction to grant the same, the injury being that of defamation

rather than injury to property. 1848, *Rolls Ct.*, *Clark v. Freeman*, 17 *Law J. R. Ch. (N. S.)* 142; S. C., 12 *Jur.* 149; S. C., 11 *Beav.* 118.

§ 868. Plaintiffs, who were manufacturers, had moved for an injunction to restrain the defendants from selling any cotton sewing thread by the name of "Glacé," or "Patent Glacé Thread," or having labels or wrappers with the words "Glacé" or "Patent Glacé" thereon, those terms being claimed by the plaintiffs as their trademarks. The court directed the motion to stand over, with liberty to the plaintiffs to bring such action as they might be advised. The plaintiffs published in the newspapers, and circulated by means of handbills, a report of the proceedings on the motion, in which report it was, amongst other things, stated that it was "established in evidence that the plaintiffs were the first to use the word in question." The defendants moved to restrain publication of the report, on the ground that it was untrue, the fact being that evidence was not gone into on the motion; and that it would have the effect of obstructing justice, and prejudicing the defendants' case. The court considered that the publication, though unfair, was not a libel, and not such as would obstruct the course of justice, and refused the motion; the costs to be costs in the cause. 1860, *Vice Ch. Stuarts' Ct.*, *Brook v. Evans*, 2 *L. T. R. (N. S.)* 740; S. C., affirmed, 29 *L. J. R. (N. S.) Ch.* 616.

§ 869. The plaintiffs and defendants carried on business of a similar description. On the expiration of the term in a lease of certain works of the plaintiffs, where they had carried on their business, the defendants, fifteen months afterwards, had pro-

cured a lease of the same works, with the exception of certain mines of clay. The defendants issued a circular and card tending to lead the public to suppose that the defendants had succeeded to the business of the plaintiffs, and were working the same material as the plaintiffs had formerly used. *Held*, that, although the words of the circular and card might be literally true, yet, if they tended to mislead the public, the court would restrain them from further circulating or issuing such or any similar circular or card. 1861, *Vice Ch. Wood's Court*, *Harper v. Pearson*, 3 *Law Times R. (N. S.)* 547.

§ 870. The defendant Foster had carried on business as an insurance broker as a member of the firms of Foster, Lacy, & Co., and Bashall, Lacy, & Co. By indenture, it was agreed that said firms should be dissolved, and that the plaintiff Burrows should have the benefit and advantages of the business and connections of the said two firms, and should be at liberty to make such arrangements as he might think proper with said Lacy for forming a new copartnership, with a view to continue the business of the said two firms. After the said dissolutions and formation of the new firm, the defendant Foster sent circulars to the old correspondents and business connections of the late firms, announcing the dissolution of his firm of Foster, Lacy, & Co., stating that he should continue to act as an insurance broker as theretofore, and soliciting the favor of their esteemed orders. The defendant was enjoined from further sending said circulars, from representing his business to be in continuation of that of the firms dissolved, and from soliciting any of the customers of said dissolved firms. 1862, *Ch.*

Ct. of Appeal, L. J. J., Burrows v. Foster, 1 New R. 156.

§ 871. The court does not recognize property in unpatented articles, and will not interfere to restrain the sale of spurious articles, though described to be the same as those manufactured by another, unless such articles are held out by the imitator to be the manufacture of that other person. Where B invented and sold a secret medicine called chlorodyne, and F advertised a spurious imitation of it as “the original chlorodyne,” and in consequence of said advertisement B added the words “the original and only genuine” to the description under which he had previously advertised his medicine, and continued to advertise it in that manner, and the evidence showed that F’s article was not mistaken for B’s, but only that F was taken to be the first inventor. *Held*, that B was not entitled to an injunction to restrain F from issuing such advertisements. That although the court believed the statements of B, that he was the original inventor, it could not interfere with the defendant making a counter-statement, much as it disapproved of his conduct and disbelieved his statements. 1864, *Vice Ch. Wood’s Ct., Browne v. Freeman, 4 N. R. 476*; and see S. C., 12 *Weekly R. 305*.

§ 872. A circular was used by parties then recently in the employ of a firm of manufacturing engineers, which informed the trade and public that they had commenced business on their own account, and made precisely the same goods as their former employers, with great improvements in the same, and could sell them at a much reduced price as being satisfied with smaller profits. It appeared that several customers of the former firm

had been deceived by this circular, and removed their custom to the new firm. *Held*, that the facts in the circular not being such as there stated, the same was a deceit upon the trade and the public, and, as such, an injunction was granted to restrain the further issuing of the circular, &c. 1868, *Vice Ch. Gifford's Ct.*, *Stevens v. Paine*, 18 *Law T. R. (N. S.)* 600.

§ 873. Whether, apart from circumstances showing a fraudulent intention, a person has a right to advertise himself as "agent for the sale of" a particular article without authority from any definite principal? *Quere.* 1869, *Vice Ch. James' Ct.*, *Wheeler and Wilson Manufacturing Company v. Shakespear*, 39 *L. J. R. (N. S.) Ch.* 36.

See also §§ 341, 580.

III. *Almanacs, Books, Magazines, Songs, Plays, &c.*

§ 877. Where it appeared that the plaintiff was proprietor of a magazine published monthly and called "The Wonderful Magazine," and the defendant after leaving the plaintiff's employ commenced the publication of a similar magazine under the same title with a similar device on the cover, and that on inspection the defendant's magazine appeared to be a succeeding number of the plaintiff's publication, it taking up the same article in continuation which had been left unfinished in the middle of a sentence in plaintiff's number preceding defendant's publication, the defendant was enjoined from selling his said publication, or from publishing any other work as being a continuation of the plaintiff's work, but he was not enjoined from the

publication of an original work of the same nature and under a similar title. 1803, *Lord Ch. Eldon, Hogg v. Kirby*, 8 *Vesey Jr.* 215.

§ 878. The defendant, a publisher, advertised for sale certain poems, which he falsely represented by advertisement to be the work of Lord Byron. He was restrained by injunction from publishing in the plaintiff's name, or as his work, the several poems mentioned in the advertisement or any parts thereof. 1816, *Lord Ch. Eldon, Lord Byron v. Johnston*, 2 *Mer.* 29.

§ 879. Unless the case is so clear, that there can be no reasonable doubt with regard to the legal right, the court should not exercise its equitable jurisdiction till the legal right is ascertained. Hence, where the plaintiff was the owner of a publication called "The Pictorial Almanack," and the defendant of one called "Old Moore's Family Pictorial Almanack," there being little or no resemblance with regard to the substance and internal portion of the two works, the covers of both being decorated with a pictorial representation of the observatory at Greenwich—the court finding that the similarity in the appearance of the covers was not likely to deceive any one: *Held*, that the case was not sufficiently clear to entitle the plaintiff to an injunction, and the defendant undertaking to keep an account the injunction granted by the Vice Chancellor was dissolved, with liberty to the plaintiff to bring an action. 1846, *Ct. of Chancery, Spottiswoode v. Clark*, 10 *Jurist*, 1043.

§ 880. Where a publisher published a song with a title page containing a picture of the singer who had brought the song into notice, and the words, "Minnie, sung by Madame *Anna Thillon* and Miss

Dolby at Julien's Concerts, written by George Linley," &c., and another music publisher subsequently published the same melody, with different words and upon the title page they placed a similar portrait of Madame Anna Thillon, with the words, "*Minnie Dale*, sung at *Julien's Concerts* (and always encored) by *Madame Anna Thillon*; the music composed by *H. S. Thompson*," &c., this song having never, in truth, been sung by Madame Anna Thillon at Julien's Concerts. *Held*, that this was a palpable attempt to induce the public to believe that the song so published was the same as that of the first publishers, and at their suit an injunction was granted on interlocutory application to restrain this or any similar infringement of their right to the name and description of their song. 1855, *Vice Ch. Wood's Ct.*, *Chappell v. Sheard*, 2 *Kay & J.* 117.

§ 881. The plaintiffs having published a song, on the title page of which was a portrait of Madame Anna Thillon and the words "Minnie, sung by Madame Anna Thillon and Miss Dolby at Julien's Concerts, written by George Linley," &c., and this song having become very popular, the defendant subsequently published another song, consisting of different words to the same air, with a title page on which there was a different portrait of Madame Anna Thillon, copied from an American publication, and the words, "Minnie, dear Minnie, Madame Thillon." *Held*, that this was an obvious attempt to palm off the defendant's publication for that of the plaintiffs, which had obtained the public favor, and this attempt was restrained by an interlocutory injunction without imposing upon the parties the necessity of trying the right at law.

1855, *Chappell v. Davidson*, 2 *Kay & J.* 123. On appeal, the court did not consider the fraud clearly made out and therefore: *Held*, that the injunction ought only to be continued on the terms of the plaintiff undertaking to bring an action and to be answerable in damages. 1856, *Ch. Ct. of Appeal*, *L. J. J.*, *Chappell v. Davidson*, 8 *De G. M. & G.* 1.

§ 882. H, in 1863, registered an intended new magazine, to be called "Belgravia." In 1866, such magazine not having appeared, M, in ignorance of what H had done, projected a magazine with the same name, and incurred considerable expense in preparing it, and extensively advertising it in August and September, as about to appear in October. H, knowing this, made hasty preparations for bringing out his own magazine before that of M could appear, and in the meantime accepted an order from M, for advertising M's magazine on the covers of his own publications, and the first day on which he informed M that he objected to his publishing a magazine under that name was the 25th of September, on which day the first number of H's magazine appeared. M's magazine appeared in October. *Held*, on bill filed by M (affirming the decision of STUART, V. C.), that M's advertisements and expenditure did not give him any exclusive right to the use of the name "Belgravia," and that he could not restrain H from publishing a magazine under the same name, the first number of which appeared before M had published his. That the mere intention, and the declaration of intention, to use a name will not create any property in that name, and that there can be no protection in the court of chancery for the intended name during the course of manufacture of the article which is to bear that name

Held, on bill filed by H, that H's registering the title of an intended publication could not give him a copyright in that name, and that, in the circumstances of the case, he had not acquired any right to restrain M from using the name as being H's trademark. That if M had not been interfered with, and had been allowed to publish a magazine, and to sell it for some time, he would have obtained, according to the doctrine of trademarks, a right to continue the exclusive use of that name, as indicating a monthly periodical. 1867, *Ch. Ct. of Appeal*, Maxwell v. Hogg; Hogg v. Maxwell, *Law R.* 2 *Ch.* 307; S. C., 36 *L. J. R. (N. S.) Ch.* 433.

§ 883. Words which in their ordinary and universal use denote the virtues, such as "Charity," "Faith," can not ordinarily be appropriated by any one as a title or designation for a book, play, &c., written, &c., by him, treating or enforcing, symbolizing, &c., a virtue, to the exclusion of any other person who may write, &c., a book, play, &c., treating upon, enforcing, symbolizing, &c., the same virtue. There may be cases where a title is made use of in bad faith, or to promote some imposition, or to inflict a wrong, when a court of justice should interfere to prevent its use or to compensate a party who has in consequence sustained an injury. 1874, *N. Y. Superior Ct., S. T.*, Isaacs v. Daly, 39 *N. Y. Superior Ct. (7 J. & S.)* 511.

§ 884. The plaintiff, in December, 1873, deposited in the copyright office at Washington the title of a play called "Charity," and copyrighted such dramatic composition. The defendant, in January, 1874, purchased manuscript copies of a different play, also called "Charity," prepared it for performance in February following, and advertised it

for public representation on March 3, 1874. Plaintiff's motion for an injunction was denied on the grounds stated in the preceding section. *Ibid.*

§ 885. Plaintiff for upwards of eight years had been engaged in selling pills under the name of "Magic Cure" for the treatment of malarial diseases. The subject of diseases in general, and of malarial diseases in particular, with a description of the effects expected to be secured by use of the "Magic Cure," was treated of in a small pamphlet with red cover, called "The Little Red Book. New Series, 1875." The pamphlet contained a large number of commendatory letters, and references were made to persons named. Defendant was at one time employed by plaintiff in said business. After that relation was terminated he commenced to sell pills called "Moore's Pilules" for malarial diseases. He also published a book called the "Red and White Book," with the figures "50, 50" at foot of first and top of last page of cover; the words "The" and "White" and the figures were printed with white letters, while the words "Red Book" were printed in red letters. The same subject was discussed in defendant's as in plaintiff's book, but in a different manner. His book had no commendatory letters, but a list of references was in it, containing most of the names in plaintiff's book. The points of difference were prominent and striking, although by the red cover, the title and the references, indicated a disposition on the part of the defendant to impose on plaintiff's customers. *Held*, that plaintiff was not entitled to an injunction *pendente lite*. Courts of equity will interfere to prevent one person from imposing upon or deceiving the customers of another by means of

simulated labels, marks, indicia or advertisements, but it must be shown that the devices adopted are such as would ordinarily lead persons dealing in the articles to suppose them to be the same. 1875, *N. Y. Supreme Ct. G. T., Tallcot v. Moore*, 13 *N. Y. Supreme Ct.* 106.

§ 886. The plaintiff had acquired a reputation for his literary productions under the *nom de plume* of "Mark Twain." The defendant obtained permission from the plaintiff to publish one of his essays in a pamphlet entitled "Fun, Fact and Fancy," containing advertisements, anecdotes, sketches, &c., and the plaintiff delivered to the defendant a volume of essays which had been published but not copyrighted, in order that one essay therefrom might be selected for said pamphlet. The defendant published in said pamphlet six essays purporting to have been written by "Mark Twain," and with the false statement upon the title page that said essays had been revised and selected by the author "Mark Twain" for said pamphlet. Five of said essays had been taken from the volume delivered by the plaintiff as aforesaid, and the remaining essay had not been written by the plaintiff. The defendant was enjoined *pendente lite* from using said *nom de plume* on the title page of said pamphlet or as the author or revisor of any pamphlet or book, or from publishing any matter alleged to have been written by the plaintiff under the *nom de plume* of "Mark Twain," except one essay from said volume delivered to the defendant as aforesaid; and defendant was permitted to state upon the title page of said pamphlet that the book contained among other things a sketch by "Mark Twain."

1873, June 12 and July 11, *N. Y. Supreme Ct. S. T. 1st Dist.*, Clemens *v.* Such, unreported.

See also §§ 139, 201, 203, 490.

IV. *Newspapers.*

§ 890. “Let an injunction be awarded to restrain the defendants B and H, their servants, workmen and agents, from printing and publishing, composing, and offering for sale the newspaper in the pleadings mentioned, called ‘The Real John Bull’ or ‘The Old Real John Bull,’ and from printing, or publishing, or exposing or offering for sale any newspapers or newspaper as and for a continuation of the plaintiff’s said newspaper called ‘The Real John Bull;’ until,” &c. *Edmonds v. Benbow*, February 20, 1821, *A.* 572; settled by the *V. Ch.*; *Seton on Decrees*, 3rd Edition, 905. See *Tonson v. Walker*, 3 *Swan.* 681.

§ 891. A person having sold a newspaper establishment, together with the name of the paper, has no right to publish another paper as that which he has sold. 1825, *Ch. Sandford, N. Y.*, *Snowden v. Noah*, *Hopkins Ch.* 347.

§ 892. Plaintiff acquired from defendant the right to publish at the city of New York “*The National Advocate.*” Defendant subsequently published at said city “*The New York National Advocate.*” *Held*, that there was such a difference as to warrant the court in refusing an injunction to restrain defendant. That where there is so great a difference as to afford room for reasonable doubt, a court of equity will not interfere by injunction, but will leave the parties to their remedy at law. *Ibid.*

§ 893. The name of a newspaper is the proper subject of property, and may be a trademark. *Ibid.*

§ 894. One who assumes the name of another's newspaper for the fraudulent purpose of imposing upon the public, and of supplanting him in the good will of his paper, may be restrained. 1840, *Ch. Walworth, N. Y., Bell v. Locke*, 8 *Paige*, 75.

§ 895. To entitle the complainant to the interposition of the court of chancery to restrain the use by defendant of the name of complainant's newspaper, the name of the complainant's paper must be used in such a manner as to be calculated to deceive or mislead the public, and to induce them to suppose that the paper printed by the defendant is the same as that which was previously being published by the complainant; and thus to injure the circulation thereof. *Ibid.*

§ 896. *Held*, that the name "New Era" was not sufficiently assimilated to the name "Democratic Republican New Era," the type and other incidents being dissimilar, to entitle plaintiff, the owner of the latter, to an injunction. *Ibid.*

§ 897. The plaintiff, C. G. P., became by purchase in February, 1856, the proprietor of a weekly newspaper called "The Britannia," which he subsequently incorporated with another newspaper called "The John Bull," and issued the publication under the title of "The John Bull and Britannia." The plaintiff had not registered his name at the stamp office, under the act for that purpose, as the proprietor for either newspaper. On April 12, a notice was inserted in "The Britannia" to the effect that the paper would be united with "The John Bull." On April 19, the defendant J. M., who had been the printer and publisher of "The

Britannia," issued a publication called the "True Britannia," in imitation and as a continuation of "The Britannia." The bill was filed against the defendant as the proprietor of the new newspaper to restrain him from publishing it. The defendant in his affidavit said that A B was the registered proprietor of the "True Britannia," and that he was the printer and publisher only. On motion for an injunction, the court ordered the defendant to be restrained from printing and publishing, &c., the "True Britannia," or any other newspaper as a continuation of "The Britannia." 1856, *Vice Ch. Stuart, Prowett v. Mortimer*, 2 *Jurist (N. S.)* 414.

§ 898. The registered proprietors of "Bell's Life in London and Sporting Chronicle," published weekly, at the price of five pence, filed a bill against the proprietors and publishers of a new newspaper called "The Penny Bell's Life and Sporting News," and which was published at the price of one penny. The evidence produced showed that from the similarity of the two names, mistakes had occurred, and were likely to occur, on the part of the public, and that inquiries had been made at the office of "Bell's Life in London" for "The Penny Bell's Life." On motion on behalf of the plaintiffs, the court granted an injunction to restrain the defendants from the use of the words "Bell's Life" in the title of their newspaper. 1859, *Vice Ch. Stuart, Clement v. Maddick*, 5 *Jurist (N. S.)* 592; S. C., 1 *Gif.* 98.

§ 899. In October, 1857, A being the proprietor of a weekly publication called "The London Journal," the price of which was one penny, assigned his copyright and interest therein to B for value, and en-

tered into a covenant with B not to publish, either alone or in partnership with any other person, any weekly periodical of a nature similar to "The London Journal." In May, 1859, A issued an advertisement, announcing the publication by him on June 1, following, of a daily newspaper, to be called "The Daily London Journal." The order for an injunction against A restraining his publication was affirmed on appeal, upon B undertaking to abide by any order the court might make as to damages and to bring an action against A within one week. 1859, *Ch. Ct. of Appeal, L. J. J., Ingram v. Stiff*, 5 *Jurist (N. S.)* 947.

§ 900. The law of trademarks is applicable to newspapers. 1867, *N. Y. Com. Pleas, S. T., Mattsell v. Flanagan*, 2 *Abb. Pr. (N. S.)* 459.

§ 901. The courts in exercising their power to restrain the use of another's trademark, do not confine their interference to names, symbols, marks, or designs originating with the person first using them. The enforcement of the doctrine that trademarks shall not be simulated does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle, that the public are entitled to protection from the use of previously appropriated names or symbols in such manner as to deceive them, by inducing or leading to the purchaser of one thing another. It is not necessary to the exercise of judicial powers that the plaintiffs should have any other property in the name used than that possessed by any other person. The employment of words or names in common use may be adopted by various persons in the same business, employment or manufacture, in competition of trade or business, and be encouraged by all the attributes

of courts and communities, but such use must be independent and free from the charge of deceitful simulation. Hence, where the plaintiffs had long published a newspaper entitled "The National Police Gazette" and the defendant thereafter published a paper entitled the "United States Police Gazette" and printed in a way actually to deceive purchasers and readers, the latter was enjoined. *Ibid.*

§ 902. The principles upon which equity enjoins a defendant from imitating the plaintiff's trademarks do not apply to the publication of newspapers, except so far as to protect the proprietor of a paper in the use of the name adopted by him for such paper. 1868, *N. Y. Superior Ct. S. T.*, *Stephens v. De Conto*, 4 *Abb. Pr. (N. S.)* 47; *S. C.*, 7 *Robertson*, 343.

§ 903. If, in an action brought to restrain the publication of defendant's newspaper, upon the ground that he is infringing trademarks adopted by the plaintiff in the publication of a newspaper previously established, it appears that the names of the two papers are so different, that, considering the dissimilarity of type and general appearance, one is not liable to be mistaken for the other, no injunction can be granted. *Ibid.*

§ 904. The right of property in what is commonly denominated the "good will" has never been protected, except where it had been made the subject of some express covenant between the parties. It may be sold by private agreement, and the stipulation of the parties in respect to it will be enforced; but in the absence of any covenant, and on a purchase at an involuntary sale, the vendee is not subrogated to all the rights of the original owner. Hence *it would seem* to follow that where a public

administrator sells at public auction the right, title and interest which a decedent had in his lifetime in a newspaper, including the good will thereof, the purchaser would not acquire such a right of property in the name or title of the newspaper, as would prevent the same name being assumed afterward by another person. *Ibid.*

§ 905. The proprietors of a long established weekly comic periodical called "Punch" moved to restrain the publication of "Punch and Judy," a rival periodical of like character, and of the same size as and somewhat similar in appearance to "Punch," but with a different illustration on the cover and sold at a less price. It was in evidence that another well known comic periodical was published weekly under the name of "Judy": *Held*, that the adoption of the whole title, Punch and Judy, was no infringement of the plaintiff's right to use and property in, the name Punch; and that the general public were not likely to be misled into purchasing the defendant's publication by mistake for that of the plaintiffs. And the motion for injunction was refused—without costs. 1869, *Vice Ch. Malins, Bradbury v. Beeton*, 39 *Law Jour. R. (N. S.) Ch.* 57; S. C., 21 *L. T. R. (N. S.)* 323; S. C., 18 *W. R.* 33.

§ 906. The class of persons to be considered in trademark cases are those of common intelligence and observation. The court will not interfere for the sake of heedless people who know not, or will not take the trouble to see, what they are purchasing. *Ibid.*

§ 907. A court of equity will protect a person in the use of a trademark, such as the name of a newspaper, although the name adopted is one that be-

longs to the language of the country, and may be employed in any way, or for any purpose, which will not defraud individuals or deceive the public. 1876, *N. Y. Supreme Ct. S. T.*, American Grocer Publishing Association *v.* Grocer Publishing Co., 51 *How. Pr.* 402.

§ 908. A newspaper establishment is a subject of property and of contract, and the right to it may be protected by a court of equity, and a person who sells such an establishment has no right to continue a publication as the same, but he may set up a different rival paper. If the question whether the rival paper is the same or different be doubtful, that doubt is a sufficient reason to refuse an injunction and to leave the parties to their remedies at law. *Ibid.*

§ 909. If it appears that the defendant's paper is an imitation or simulation of the plaintiffs' paper, and as such designed to mislead the public, an injunction will be granted. *Ibid.*

PUFFERY.

See MISREPRESENTATION.

PURCHASE.

See ASSIGNMENT.

QUACK MEDICINES.

See MISREPRESENTATION.

QUALITY.

§ 912. The owner of a trademark is entitled to recover damages for its violation notwithstanding that the goods upon which the simulated mark is placed are not inferior in quality. 1833, *King's Bench*, Blofield *v.* Payne, 1 *N. & M.* 353; S. C., 4 *B. & Ad.* 410; S. C., 3 *L. J. R. (N. S.)* 68.

§ 913. It is no answer to a suit for the violation of a trademark that the simulated article is equal in quality to the genuine. 1845, *Vice Ch. Sandford, N. Y.*, Coats *v.* Holbrook, 2 *Sandf. Ch.* 586; S. C., 3 *N. Y. Leg. Obs.* 404.

§ 914. It is wholly immaterial whether the simulated article manufactured by the defendant is or is not of equal goodness and value to the real article manufactured and put up for sale by the complainant. 1846, *N. Y. Ct. of Errors*, Taylor *v.* Carpenter, 11 *Paige*, 292; S. C., 2 *Sandf. Ch.* 603.

§ 915. It is of no importance that the manufacture of the defendants is of equal or even superior quality to that of the plaintiff's; they have nevertheless no right to use the latter's trademark, or to make and use any imitation of it to help or increase their trade in the article. 1872, *N. Y. Superior Ct. S. T.*, Cook *v.* Starkweather, 13 *Abb. Pr. N. S.* 392.

For words denoting quality see DESCRIPTIVE NAME, § 640, *et seq.*; and WORDS, § 1010, *et seq.*

 QUESTIONS OF FACT AND OF LAW.

§ 920. In an action on the case brought for imitating the plaintiff's trademark; *held*, that it was

properly left to the jury to say, first, whether there was, in fact, so close a resemblance in the marks used, as would deceive persons of ordinary skill; and, secondly, whether the defendants used the mark with the intention of supplanting the plaintiff, or whether it was done in the ordinary course of business in execution of orders. 1842, *Court of Com. Pleas*, *Crawshay v. Thompson*, 4 *M. & G.* 357; S. C., 11 *L. J. R. (C. P.)* 301; and see *Rodgers v. Nowill*, 17 *L. J. R. (N. S.) C. P.* 52.

§ 921. Where the plaintiff used the words "Roger Williams Long Cloth," upon cotton cloths as a trademark, and the defendant used the words "Roger Williams" upon cotton cloths: *Held*, that the court could not, as matter of law, decide that such partial use of the designation of his goods appropriated by the plaintiff was not designed, calculated and effectual to carry out the fraud charged, and must leave that to be settled upon the evidence by the jury. 1860, *Supreme Ct. of R. I.*, *Barrows v. Knight*, 6 *R. I.* 434.

§ 922. The first question which arises in trademark cases is one of fact, and is, whether the mark used by the defendant is a colorable imitation of a genuine trademark of the plaintiff? That is a question to be determined at law by a jury, and in equity by the judge. If it be found that the trademark used by the defendants is not a colorable imitation of the genuine mark, the whole thing is at an end; there is no imitation, and the person may go on using it. 1862, *Rolls Court*, *Cartier v. Carlisle*, 31 *Beav.* 292; S. C., 8 *Jurist (N. S.)* 183.

See also EVIDENCE.

REGISTRATION.

Registration of trademarks, see STATUTES (CONSTRUCTION OF), and § 295.

REGISTRATION OF PRINTS AND LABELS.

§ 923. The act of Congress of June 18, 1874, is to be regarded as an amendment of the copyright laws. To acquire a copyright in any print or label deposited in the patent office, it is essential that the title of the print or label be first deposited in pursuance of the provision of the U. S. Revised Statutes concerning copyrights. 1877, *U. S. Circuit Ct., Southern Dist. of New York, Marsh v. Warren*, 4 *Am. L. T. R. (N. S.)* 126.

REMEDIES.

§ 928. An action on the case for the violation of a trademark may be maintained without proof of special damage. 1837, *Sup. Jud'l Ct. of Mass., Thomson v. Winchester*, 19 *Pick.* 214.

§ 929. An action on the case may be maintained by a manufacturer against another manufacturer who marks his goods with the known and accustomed mark of the plaintiff, where the mark used by the defendant resembles the plaintiff's mark so closely as to be calculated to deceive, and as to induce persons to believe the defendant's goods to be of the plaintiff's manufacture—and the defendant uses such mark with intent to deceive—and sells the goods so marked,

as and for goods of the plaintiff's manufacture ; and proof of special damage is not necessary. 1847, *Rodgers v. Nowill*, 11 *Jurist*, 1037 ; S. C., 5 *C. B. (Man. Gr. & S.)* 109 ; S. C., 17 *L. J. R. (N. S.) C. P.* 52. And see S. C., 6 *Hare*, 325.

§ 930. The violation of a trademark will be enjoined and the party violating may be compelled to produce the articles to which the spurious brands are attached, to the end that such brands may be canceled or erased, at the cost and expense of the defendant. 1862, *N. Y. Ct. of Com. Pleas, S. T., Jurgensen v. Alexander*, 24 *How. Pr.* 269.

§ 931. An injunction was obtained to restrain the defendants, who were wharfingers, from parting with certain goods, on the ground that they had been imported with counterfeit trademarks. U, who was not a party to the suit, had *bona fide* advanced money before bill filed, on the security of the dock warrants. Upon motion by U, *pro interesse suo* : *Held*, that he had a priority, in respect to his advance, over the plaintiffs' costs of suit, he undertaking to destroy the counterfeit marks and paying the costs of the motion. That the wharfingers' charges and costs of suit were the first charges upon the goods ; U to pay these costs and add them to his advance, and the total to form the second charge ; the plaintiff's costs of suit to be the third charge. 1864, *Rolls Ct., Ponsardin v. Peto*, 33 *Beav.* 642 ; S. C., 10 *Jurist (N. S.)* 6 ; S. C., 12 *W. R.* 198 ; S. C., 33 *L. J. R. (N. S.) Ch.* 371.

§ 932. S, having engaged in the manufacture of various medicines and other preparations adopted and used thereon certain labels and trademarks, to

distinguish his medicines and preparations from all others. These labels and trademarks were generally known to the trade and consumers, so that by them the preparations were distinguished, recognized and bought. The manufacture and sale of these preparations had become the source of profit and emolument to S. Certain persons thereupon fraudulently engaged in the manufacture of medicines and other preparations and sold large quantities thereof, with labels and trademarks corresponding with those used by S, or with only a colorable difference, and designed to deceive the public, and to enable the vendors to obtain for their medicines the celebrity which the medicines and preparations of S had in the market. On application by S it was *Held*: that he was entitled to be protected by injunction and to be compensated by having an account taken. 1870, *Maryland Court of Appeals*, *Stonebreaker v. Stonebreaker*, 33 *Md.* 252.

See also CONTEMPT ; INJUNCTION ; STATUTES, CONSTRUCTION OF.

RESEMBLANCE.

See IMITATION.

SECRET.

See TRADE SECRET.

SCIENTER.

See INTENT.

SIGNS.

§ 940. A sign containing a firm name used over the doorway of a store may be the subject of a trademark. 1857, *N. Y. Supreme Ct. S. T.*, Peterson v. Humphrey, 4 *Abb. Pr.* 394.

§ 941. The plaintiff, a son and former partner of John Burgess, manufactured and sold for many years "Burgess's essence of anchovies" at No. 107 *Strand*; and carried on business there, after the death of his father, under the style of John Burgess & Son, which had been used previously to his father's death. The defendant, W. H. Burgess (a son of the plaintiff), who had been employed for many years by the plaintiff and had been permitted to reside on the premises No. 107 *Strand*, opened a house in King William street, and had letters and figures over his shop front, as follows; on one window "W. H. Burgess," on the other window "107 *Strand*," and in the intermediate space over the fanlight, "late of." The defendant was enjoined from the use of the words "107 *Strand*," "late of," and also from continuing a plate which he had on the sides of his shop door with the words "Burgess' Fish Sauce Warehouse, late of 107 *Strand*;" but was not enjoined from using the words "Burgess's essence of anchovies" on the article sold by him. 1853, *High Ct. of Chancery*, Burgess v. Burgess, 3 *De G. M. & G.* 896: S. C.,

17 *Jur.* 292; S. C., 22 *Law Jour. R. (N. S.) Ch.* 675; S. C., 17 *Eng. L. & Eq.* 257.

§ 942. Where Smith, a tradesman, who had been in the employ of a large firm, put his own name over his shop, but on the plates under the shop windows, and on the sun awning "from Thresher & Glenny," his former employers; the word "from" being much small than the words, "Thresher & Glenny," and it was proved that some persons had been misled into thinking that the shop was the shop of "Thresher & Glenny:" The court *Held*, that what Smith was doing, was calculated to mislead the incautious, unwary and heedless portion of the public; and on bill by Thresher & Glenny, granted an injunction restraining him from using the name of their firm about his shop in such a way as to mislead the public into the belief that his shop was the shop of Thresher & Glenny, or that their business was carried on there. 1865, *Vice Ch. Kindersley, Glenny v. Smith*, 11 *Jurist (N. S.)* 964; S. C., 13 *L. T. R. (N. S.)* 11; S. C., 2 *Dr. & Sm.* 476; S. C., 6 *New R.* 363.

§ 943. There is no question but that if a man, having been in the employment of a firm of reputation, sets up in business for himself, he has a right in any way in which he thinks fit (provided he does not use names, marks, letters or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are those of another person), to inform the public that he has been in such employment, and in that way to appropriate to himself some of the benefit arising from the reputation of his former employers. But in so doing he must take especial care that it is done in

such a way as not to mislead the public to the detriment of his former employers. *Ibid.*

§ 944. The use of a simulated card, advertisement, or sign, calculated to deceive the incautious or unwary, whereby a party may be deprived of his just gains and profits, will be restrained by injunction. Accordingly, where the plaintiff's sign was "Colton Dental Association," and the defendant, a former employee of the plaintiff, used cards and had a sign over his office in form following: Dr. F. R. Thomas, late operator at the Colton Dental Rooms, the words "late operator at" in small letters, the court held the cards and signs to be deceptive, and compelled their discontinuance, until changed. 1868, *Ct. of Com. Pleas, Phil. Pa., Colton v. Thomas, 2 Brews. 308.*

§ 945. The plaintiff was the proprietor of an oyster saloon, No. 214 Broadway, and had a sign over the door of "The Captain's Live and Let Live Oyster and Dining Saloon." Defendants carried on the same business next door and put up a sign with the words "G. W. Chadsey & Co's. Great Eastern Live and Let Live Dining Saloon." The defendants were enjoined from using the words "Live and Let Live." *Genin v. Chadsey*, a New York case, cited in *2 Brews. 330.*

§ 946. The parties to the suit were severally engaged in selling ready made clothing. They occupied adjoining rooms in the same block, fronting on the same street. The complainant caused to be put up on the wall of the building, over the entrance to his store, the words "Mammoth Wardrobe;" below it and over the door, his name in large gilt letters; on top of the building a sign in these words: "W. N. Gray's Great Wholesale and

Retail Clothing Emporium;" on the windows on either side of the entrance, other words indicative of his business, including his name; he also advertised his place of business and his trade in the local newspapers and the directory, as the "Mammoth Wardrobe," uniformly connecting with it his name and the number of his room. Subsequently to complainant's adoption of the words "Mammoth Wardrobe," defendant painted the same words on an awning erected over the entrance to his store, and below them his name and the number of his room; he also placed his name in large gilt letters over his door; and above the awning, and on the building, below the awning and near the entrance, a card displaying "The Mammoth Wardrobe," and defendant's name. Defendant advertised in the same newspapers and directory as complainant, but without mentioning the place of business as the "Mammoth Wardrobe." Complainant applied for a temporary injunction. *Held*, that without the suggestion of falsehood or suppression of truth in words or acts, there can be no fraud. That even if the words "Mammoth Wardrobe" were such that they might be appropriated as a trademark by having first been arbitrarily applied by complainant, they not being an appropriate term according to general usage to describe such a place, still great doubt might be entertained whether the defendant had not by the addition of his name, number and other marks, so distinguished the designation of his establishment from that of the complainant, that though each was called the "Mammoth Wardrobe," they were not identical or so nearly so as to require close inspection to detect the difference.

The court could not see how any person could fail to recognize the two establishments; that it was difficult to believe that any customers attracted by the advertisements, and guided by them and seeing the two stores, or only the defendant's, could make any mistake. Application denied. 1871, *Mich. Circ. Ct.*, *Gray v. Koch*, 2 *Mich. N. P.* 119.

§ 947. Joseph Hall had been engaged in the manufacture and sale of thrashing machines at No. 10 Water street, in the city of Rochester, and put up a sign with No. 10 upon it, and his shop was known by that number. On the death of said Hall, in the Spring of 1869, the premises and property of said Hall were sold by his executors to the defendant, who continued the business at the same place, and designated his place of business as "Old Joseph Hall's Agricultural Works, No. 10 South Water St." The plaintiff, prior to the Fall of 1869, carried on the business of manufacturing agricultural implements at Brighton, some two and a half miles from Rochester. In the Fall of 1869 they rented a small office on South Water street, near to defendant's shop; and, with intent to injure defendant, put on the store the words and figures "No. 10," thereby indicating their place of business as being "No. 10" South Water street. The number was put upon the implements manufactured by them. The plaintiff was restrained from using said number as its trademark, or keeping the same on its office or building in South Water street, or using it in any way in imitation of the defendant's trademark. 1874, *N. Y. Commission of Appeals*, *Glen and Hall Manufacturing Co. v. Hall*, 61 *N. Y.* 226; reversing *S. C.*, 6 *Lans.* 158.

§ 948. Where one has established a business at

a particular place, from which he has or may derive profit, and has attached to such business a name indicating to the public where it is carried on, he thereby acquires property in the name, which will be protected from invasion by a court of equity on principles analogous to those in case of the invasion of a trademark. *Ibid.*

§ 949. The plaintiffs composed the firm of Devlin & Co., engaged in the clothing business in Broadway, New York. The defendant, whose name was John S. Devlin, was engaged in the same business and in the same street, and had upon his place of business a sign with the words "Devlin & Co." thereon. The use of the words "& Co." by defendant was found by the court to be the use of a deliberate falsehood to attract the plaintiffs' custom, and he was enjoined from using the firm name "Devlin & Co." in any manner, and in the injunction it was further ordered "that the said John S. Devlin be, and he is hereby confined—whenever the word or words 'Devlin' appears or is used in his advertisements, signs, placards, slips, or other means and modes of making known his business or place of business, or offering for sale or selling his goods, wares and merchandise—to his own proper Christian, middle and surname, conjoined and without monograms, signs, or other devices which may tend to mislead or induce the public or any other person as aforesaid; and it is further ordered that the said John S. Devlin be confined to the use of his own name—John S. Devlin or J. S. Devlin—without the use of any monogram containing the initials J. S. or other device; but nothing herein is to be construed or interpreted as preventing the said defendant from using his own name in his advertisements, signs or

placards.” Subsequently to said injunction the defendant made use of a sign containing the number of his store and the words “J. S. Devlin’s Clothing” so arranged as to attract and fix the public eye on the words “Devlin’s Clothing.” The court adjudged the defendant in contempt for violating said injunction. 1875, *N. Y. Supreme Ct. G. T.*, *Devlin v. Devlin*, 4 *Hun*, 651; S. C., affirmed by *N. Y. Ct. of Appeals*, not yet reported.

See also BUILDINGS, and §§ 124, 125 and 1023; also PARTNERSHIP.

STATUTES—CONSTRUCTION OF.

§ 957. The statute of 1845, making it a penal offense to vend merchandise, having thereon forged or counterfeited trademarks, knowing them to be such, &c., without disclosing the fact to the purchaser, would prevent the vendor from recovering the price of the goods sold, if he knew that the marks were forged or counterfeited. But it must appear that the vendor had such knowledge or that there was a warranty of the genuineness of the goods, or some representation on his part, to prevent a recovery. 1849, *N. Y. Superior Ct., G. T.*, *Rudderow v. Huntington*, 3 *Sandf.* 252.

§ 958. In Massachusetts a bill in equity to restrain the fraudulent use of trademarks cannot be maintained under St. 1852, c. 197, without alleging and proving that such use was for the purpose of falsely representing the articles so marked to be manufactured by the plaintiff. 1854, *Sup. Jud’l Ct. of Mass.*, *Ames v. King*, 2 *Gray*, 379.

§ 959. The statute of 1863, of the State of Cali-

fornia, concerning trademarks, does not take away the common law remedy for the protection of the same, from those who do not register their trademark according to the provisions of the act. 1865, *Supreme Ct. of Cal.*, *Derringer v. Plate*, 29 *Cal.* 292.

§ 960. By the terms "peculiar name," letters, marks, devices, figures, or other trademark or name, as used in the statute concerning trademarks (Hittel's Laws, art. 7, 134 [Cal.]), is not meant the established and proper names by which the "articles" to which they are attached, and by which they are known in the market, nor something indicating their actual kind, character, or quality, but by them is meant, as the subjects of protection against infringement, something new, not before in use,—something of the manufacturer's own invention, or first put to use by him,—something peculiar to him, and not common to him and others,—something which is intrinsically foreign to the "articles" themselves, and only serves to designate them because it has been fancifully put to that use, in disregard of all natural relations. The statute does not vest in the manufacturer or vendor, as the case may be, any exclusive property in the "articles" manufactured or sold, nor in names or the words which most aptly apply and properly describe them; and even if such were the proper construction of the statute, it would be void for want of power in the legislature to enact it. If the statute goes beyond the common law and embraces within its protection matter which relates to kind, character, or quality of "articles," it is not perceived why it does not trench upon the law of copy and patent rights, and is therefore void. It is sug-

gested, but not decided, that the terms used in the statute, to wit: "to designate it as an article of peculiar kind, character, or quality," were inadvertently incorporated into it under a mistaken notion of the functions of a trademark, and that in respect to those terms the statute can have no intelligible operation. 1868, *Supreme Ct. of Cal.*, *Falkinburgh v. Lucy*, 35 *Cal.* 52.

§ 961. The statute of Missouri concerning trademarks, Gen. Stat. 1865, p. 912, was not designed to weaken or abridge any existing rights, or any future right to a trademark, which might be acquired by appropriation and use. A written claim to a disputed trademark, filed in the office of recorder of deeds in the county of St. Louis, under the act of March, 1866, Gen. Stat. 1865, p. 912, cannot avail the manufacturer of stoves in another State. 1869, *Supreme Ct. of Mo.*, *Filley v. Fassett*, 44 *Mo.* 168.

§ 962. Under the provisions of section 4 of chapter 306, Laws of 1862 (New York) entitled "an act to prevent and punish the use of false stamps, labels or trademarks," as amended by section 2 of chapter 209, Laws of 1863, to render a person liable to the penalty therein prescribed, the act complained of must have been done with intent to defraud some person or persons, or some body corporate. 1871, *N. Y. Court of Appeals*, *Low v. Hall*, 47 *N. Y.* 104.

§ 963. Section 77 of the act of July 8, 1870 (16 U. S. Stat. at Large, 210), provides, as a requirement for obtaining a trademark, the filing, in the patent office, of a declaration under oath, as to the right to the trademark. A certificate by the commissioner of patents, of the deposit, for registration,

of a trademark, of which a copy is thereto annexed, and of the filing of a statement, of which a copy is annexed to the certificate (but which statement does not contain any such declaration), and that the party depositing the trademark has otherwise complied with the act, and that the trademark has been registered and recorded, and will remain in force for a period named in the certificate, is not evidence of the filing of such declaration. 1872, *U. S. Circ. Ct. N. Y.*, *Smith v. Reynolds*, 10 *Blatchf.* 85.

§ 964. The firm of J & Co., in registering a trademark for paints in the patent office under sections 77, &c., of the act of July 8, 1870 (16 U. S. Stat. at Large, 210), filed as the names of the parties desiring the protection of the trademark, and their residences and places of business: "J & Co., of No. 276 Pearl street, in the city of New York, County and State of New York, and engaged in the manufacture and sale of paints at said New York," and nothing further: *Held*, that it was not necessary to record the name of each of the individual partners of the firm, and his place of residence, and that the residence and place of business of the firm, as the party desiring the protection, were sufficiently stated. *Ibid.* p. 100.

§ 965. The act requiring that the "the class of merchandise, and the particular description of goods comprised in such class, by which the trademark has been or is intended to be appropriated" shall be recorded, where a trademark is claimed for paints generally, any further statements than merely specifying paints as the class of merchandise, without specifying any description of paints, is unnecessary. *Ibid.* p. 100.

§ 966. The illustration of a crown was claimed by J & Co., as a trademark for paints generally, under said act, and it was alleged that R had infringed such right, and it appeared that a brand of a crown had been used by B, for white lead alone, of a particular quality and description, made by him continuously, from a period prior to the use and to the registration, of such brand as a trademark by J & Co., and until R purchased from B his paints, materials and labels, and the right to use them, including the labels embodying the device of a crown, and that R, from the time of his purchase, which was prior to such registration, had continuously used the device of a crown on some description of paints: *Held*, that, at the time of registering the trademark, J & Co. had no right to the use of it for paints generally, because R then had a right to use it for the class of paints for which B, as well as R, had previously used it. *Ibid.* p. 100.

§ 967. A registration under the act of Congress must stand or fall, as a whole, for that to which the registration declares it is intended to appropriate it, there being no provision to maintain a suit on it, where the grant is valid as to a part but not as to the whole. *Ibid.* 100.

§ 968. The protection given by the act of July 8, 1870 (16 U. S. Stat. at L. 210, 211), to the use of a trademark, is to the exclusive use of such trademark only so far as regards the particular description of goods set forth in the statement filed under said act as the particular description of goods to or by which the trademark has been, or is intended to be, appropriated; and the prohibition is only against the use, by another, of substantially the same

trademark on goods of substantially the same descriptive qualities as such particular description of goods set forth in such filed statement. 1873, *U. S. Circ. Ct. N. Y.*, *Osgood v. Rockwood*, 11 *Blatchf.* 310.

§ 969. A statement filed by O set forth that his trademark consisted of the word "Heliotype," "in connection with the production and publication of prints," and that "the particular article of trade" upon which he had used it was "the prints" which he designated as "Heliotype." Such prints were made by a process to which the name "Heliotype" was applied, and which was a process secured by letters patent of the United States, under which O was the sole licensee. The defendant used the word "Heliotype" on prints published by him, which were not made by such patented process. *Held*, that the right of O to the recorded trademark was limited to its use on prints made by such patented process. *Ibid.*

§ 970. The act of Congress of July 8, 1870,—providing for the registration of trademarks,—does not (at least in a State court) furnish any further or greater protection than the court might have previously given. 1873, *N. Y. Superior Ct. S. T.*, *Popham v. Wilcox*, 14 *Abb. Pr. (N. S.)* 206; *S. C. on appeal*, 38 *N. Y. Super. Ct.* 274.

§ 971. The act to protect merchants, &c., against counterfeit trademarks, approved February 22, 1870 (Adj. Sess. Acts 1870), was designed to protect foreign as well as domestic trademarks, and may be invoked by citizens of other States and countries. 1874, *Supreme Ct. of Missouri*, *State of Missouri v. Gibbs*, 56 *Mo.* 133.

§ 972. *Query*,—whether, when a trademark,

registered under the act of Congress consists of a combination of words, letters, monograms and pictures, it is infringed when the whole combination is not used. 1875, *U. S. Circuit Ct. Ill.*, *Tucker Mfg. Co. v. Boyington*, 9 *Off. Gaz. (U. S. Patent Office)* 455.

§ 973. A person who had been using for upwards of a year a trademark bearing the word "registered," it having been registered under the copyright act 1862 (25 & 26 Vic. c. 68), applied for its registration under the trademark registration act 1875, but the registrar, acting on the instructions of the commissioners of patents, one of whom is the lord chancellor, who is empowered by the act to make general rules as to registration, declined either to register the trademark with the word "registered," or to allow the advertisements required by the act before registration to be issued bearing the word "registered" as part of the trademark. An application under section 5 of the act, for an order directing the registrar to take the necessary steps for the registration of the trademark in its entirety was refused. *Semble*, the copyright act of 1862 (25 & 26 Vic. c. 68), is not applicable to trademarks. 1875, *V. C. Hall's Ct., In re Meikle's Trademark*, 24 *W. R.* 1067; S. C., 46 *L. J. R. (N. S.) Ch.* 17.

§ 974. The trademarks registration act of 1875 (38 & 39 Vic. c. 91), and the trademarks registration amendment act of 1876 (39 & 40 Vic. c. 33), construed. 1877, *V. C. Malins, In re Barrow's Application*, 46 *Law J. R. (N. S.) Ch.* 450; S. C., 25 *W. R.* 407, 564; S. C., 36 *L. T. R. (N. S.)* 291.

See also § 284.

SYMBOLS.

See DEVICES.

TRADEMARKS.

§ 979. I.—By whom property in trademarks may be possessed.

See GENERAL PRINCIPLES AND DEFINITIONS; ALIENS; PARTNERSHIP; ASSIGNMENT, &c.

II.—The manner in which property in trademarks may be acquired and transferred.

See GENERAL PRINCIPLES AND DEFINITIONS; ACQUISITION; ASSIGNMENT; ACQUIESCENCE; ABANDONMENT; LICENSE; LACHES; PRIOR USE; EXCLUSIVE RIGHT; PARTNERSHIP; REGISTRATION; OPERATION OF LAW.

III.—Of the requisite components of trademarks to entitle him who owns them to protection in their exclusive use as property.

See ORIGIN AND OWNERSHIP; NAME; WORDS; DEVICES; LETTERS; NUMERALS; MISREPRESENTATION; QUALITY.

IV.—To what a trademark may be applied.

See VEHICLES; PUBLICATIONS; SIGNS; GENERAL PRINCIPLES AND DEFINITIONS.

V. Of the violation and infringement of the right of property in trademarks.

See IMITATION ; PUBLICATIONS ; LABELS ; NAME ; LETTERS ; NUMERALS ; WORDS ; DEVICES ; MISREPRESENTATION ; QUALITY ; INTENT ; CAUSE OF ACTION ; DEFENSES.

VI.—Remedies.

See REMEDIES ; CONTEMPT ; INJUNCTION ; DAMAGES ; CRIMES ; STATUTES (CONSTRUCTION OF).

TRADEMARKS IN GENERAL.

§ 980. An injunction will not be made to include the manner of boxing an article, the phraseology of cautions, and other incidents which are to be considered open to the public. 1867, *N. Y. Supreme Ct., G. T., Gillott v. Esterbrook*, 47 *Barb.* 455.

§ 981. If an article is an artificial compound of worth, of such fame as to be in demand, and its ingredients and the proportion of their admixture the result of the study, information and skill of the owner, and known only to him, an imitation of any proper symbol by which he guaranteed to the purchaser the verity and origin of the compound, would be a violation of the rights of both. And why? For that the purchaser has a right to have the very thing which he seeks, and the owner has the right that the very thing sought shall be sold at his profit. It does not alter this right that the compound held for sale and sought for, is made by nature and not by art. The owner of its sole place of production is the exclusive owner of it in the last case, as in the first. And in the last case, as in

the first, the buyer seeks that very thing. And both have the right that the truthful symbol or device which tells of the genuineness of its origin shall not be imitated with intent or effect to deceive. It is the peculiarity of the article, its merit which is individual and exclusive, which attracts the buyer. It is the sole power, from having sole control of the place of origin, to furnish this peculiarity, which is the advantage of the owner and is his property of value. The trademark adopted is the indication to the first of where he may feed his desire, and the protection to the last that he shall keep the profit of being the one who does feed it. 1871, *N. Y. Court of Appeals*, *The Congress and Empire Spring Company v. The High Rock Congress Spring Company*, 45 *N. Y.* 291; *S. C.*, 10 *Abb. Pr. (N. S.)* 348; reversing *S. C.*, 57 *Barb.* 526.

§ 982. When the spring first known as and named "Congress Spring" produces natural water of peculiar medical and curative properties, possessed by no other spring, the words "Congress Water," and "Congress Spring Water" appropriately indicate the origin and ownership of the water flowing from Congress Spring, and the word "Congress" used in connection with the bottling and sale of such water, is a proper and legitimate trademark. *Ibid.*

§ 983. A barrel of peculiar form and dimensions, irrespective of any marks or brands impressed upon, or connected with it, cannot become a lawful trademark, or a substantive part of a lawful trademark, so as to invest the claimant with an exclusive right to use it. 1871, *U. S. Circ. Ct. of Cal.*, *Moorman v. Hoge*, 2 *Sawyer*, 78.

§ 984. The defendants were restrained from sell-

ing "any preparation or compound under the name and style of "J. B. Wilder & Co.'s Stomach Bitters" printed, stamped or engraved upon the bottles, labels, wrappers, covers, boxes or packages thereof, also from using the bottle herein exhibited marked 'B 2,' and from imitating or causing to be imitated in any manner, either the bottle or label of the plaintiff herein marked respectively, 'A, and B.'" *Wilder v. Wilder, Ct. of Chan. Ky.*, cited in *Moorman v. Hoge, 2 Sawyer, 89.*

§ 985. Although the name adopted by dealers for their article be not one to the exclusive use of which they are entitled, yet the peculiar style of the package in which they put up the article, and the combination constituting the label may be protected. Where a peculiar device is applied to a box or barrel especially prepared to display it, the special preparation of the box or barrel constitutes a part of the trademark, and may participate in its protection. This principle applied, to protect plaintiffs in the use of a barrel with a red rim and a glazed surface on the head, with the letters A A A and a Maltese cross, and to enjoin defendants from using a similarly prepared head with the letters XXX and a crown. 1872, *N. Y. Superior Ct. S. T., Cook v. Starkweather, 13 Abb. Pr. (N. S.) 392.*

§ 986. The plaintiffs since 1855 had rolled their carpets upon a hollow stick, which stick, when put into the centre of their rolls of carpet, they claimed to be their trademark. The stick consisted of two pieces, ground on the inside, so that when the two pieces were put together they formed a shell with a rectangular opening and with the corners of the outside rounded off so that the ends of the stick or shell formed an octagonal ring. This ring was

both visible and tangible in each end of each roll of carpet. The stick or shell was made the length of the rolls of carpet, so as to exhibit the rings. The shell was adopted in 1855 and used continuously ever since by plaintiffs as a trademark, and was registered as a trademark in the U. S. patent office in 1871. The defendants, in 1872, commenced to make and sell carpets rolled upon sticks resembling the sticks used by the plaintiffs. The plaintiffs filed a bill to enjoin the defendants from the use by them of such sticks for carpets. The evidence in the case showed that such sticks in rolls of carpet indicated to the public that the goods containing them were made by the plaintiffs; that any one seeing the shells in carpets would suppose them to be the plaintiffs' goods; and that the use by the defendants of said sticks would deceive the public. *Held*, that said stick as claimed by plaintiffs was a good and valid trademark, that they were entitled to its exclusive use; and that the defendants should be enjoined and pay to the plaintiffs the profits and gains received by them in consequence of their infringement, together with such damages as plaintiffs had suffered thereby. 1873, *U. S. Circuit Ct. Penn.*, *The Lowell Manufacturing Company v. Larned*, unreported.

§ 987. *It seems* doubtful whether in a collateral proceeding the court is empowered to restrain a party from the use of a trademark, awarded to him in the established course of procedure, by the commissioners of patents. 1876, *N. Y. Supreme Ct. S. T.*, *Decker v. Decker*, 52 *How. Pr.* 218.

TRADE SECRET.

§ 995. An injunction granted to restrain the use of a secret in the compounding of a medicine, not being the subject of a patent, and to restrain the sale of such medicine by a defendant, who acquired the knowledge of the secret in violation of the contract of the party by whom it was communicated, and in breach of trust and confidence. A plaintiff not having the privileges of a patentee, may have no title to be protected in the exclusive manufacture and sale of a medicine against the world; but he may notwithstanding have a good title to protection against the particular defendant. The injunction restrained the sale of medicine by the defendant under the name of the medicine prepared according to the secret preparation, not on the ground of the use of the name alone, but because it was by the use of the name that the defendant was availing himself of the breach of faith and contract. The defendant acquired the secret from T M, and such communication was a breach of faith on the part of T M towards the plaintiff. 1851, *Before the Vice Chancellor*, *Morison v. Moat*, 9 *Hare*, 241.

§ 996. *Semble*. It might have been different, if the defendant had been a purchaser for value of the secret without any notice of any obligation affecting it. *Ibid*.

See also §§ 144, 152, 242, 612.

TRANSFER.

See ASSIGNMENT.