

A TREATISE

ON THE

LAW OF TRADE-MARKS.

A TREATISE
ON THE
LAW OF TRADE-MARKS

AND ANALOGOUS SUBJECTS,

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

BY

c WILLIAM HENRY BROWNE,
OF THE BAR OF THE SUPREME COURT OF THE UNITED STATES.

BOSTON:
LITTLE, BROWN, AND COMPANY.
1873.

S
US
345
BRO

17
B

Entered according to Act of Congress, in the year 1873, by

WILLIAM HENRY BROWNE,

In the Office of the Librarian of Congress, at Washington.

JAN 13 1908

CAMBRIDGE:

PRESS OF JOHN WILSON AND SON.

P R E F A C E.

A COMPREHENSIVE collation of authorities upon the Law of Trade-marks, with a clear enunciation of the settled principles which govern it, is not to be found in any language. A long-continued experience in the application of the Law of Trade-marks, has led the author to undertake to meet this want, so generally felt by the Bench and Bar. The attention of commercial nations is becoming more fully awakened to the great subject of protection to maker and consumer, that protection which guarantees the integrity of signs of trade. As evidence of this, witness the many commercial treaties and conventions between the principal governments, and the recent introduction of the term "Trade-mark" into diplomatic compacts; and witness the stringent remedial enactments of nearly all countries in regard to the symbol of trade.

Our first legislative recognition, as a nation, of the necessity for protection to Trade-marks, was the Act of Congress, July 8, 1870. It had a stimulating effect upon our own people; although the principal object that it had in view, it must be confessed, was the matter of reciprocity.

Producers are beginning, generally, to realize the truth that a Trade-mark is of value, far exceeding in worth a temporary and territorially-limited patent or copyright; and they open their understanding to the fact that the longevity of the symbol of trade is equal to that of trade itself; while it also has

a world-wide universality of operation. The natural *right* being conceded, the *remedy* for its violation must follow just so soon as the tribunals of justice shall have unbarred their portals to all alike. The members of the legal profession, including practitioners before the Patent Office, and all who have given the subject a thought, have a right to expect that some one will bring order out of Chaos, and reduce the theory and practice to well-defined rules, based upon adjudicated cases.

In 1860, Mr. Upton published his book on the Law of Trade-marks. Down to this time, that is the only American treatise upon the subject. That gentleman earned the gratitude of the profession for his extrication of the matter from the doubt and confusion in which it lay; for with us this portion of the law was then but poorly understood. Since Mr. Upton's book appeared, great progress has been made in the settlement of the rules and doctrines of Trade-marks and analogous subjects, as is attested by the fact that the greater number of adjudications thereon have since been made.

In England, Mr. Lloyd put forth an excellent little treatise on the Law of Trade-marks, &c., of about eighty pages duodecimo; the greater portion of which first appeared in the "Solicitor's Journal" during the year 1861, and the early part of 1862. A second edition was issued in 1865.

In France, in 1855, was published the *Code International de la Propriété Industrielle, Artistique et Littéraire*, by MM. Pataille and Huguet; and in 1865 appeared an *Appendice* to the same, by the former gentleman. This is a work of great merit, containing as it does much and various information in regard to treaties, commercial conventions, and other congruous matters; but to us it is limited in value, other than as a book for reference. In 1855, those gentlemen also commenced

the issue of a periodical entitled *Annales de la Propriété etc.*, principally composed of decisions of the tribunals of commerce and courts of France, and sometimes of Belgium, Switzerland, and other countries, in patent, copyright, and trade-mark cases. The publication still continues under the able editorship of M. Pataille, assisted by other jurists and writers of recognized ability. The seventeen volumes of this work contain a mine of wealth, not only in the terse, logical decisions of the courts, but also in the able contributions of essayists. It will be seen that many references thereto are made in the following treatise; for the principles involved in their deliberations are applicable to our own controversies.

In Belgium, in 1843, the zealous Jobard sent forth his *Création de la Propriété Intellectuale*, which, although mainly devoted to the discussion of patent and copyright matters, still incidentally furnishes food for reflection on the subject of our present investigation. The same may be said of more recent books by the same author.

Our libraries are not rich in the possession of German lore on this subject; and the few accessible books in the German language are mostly elementary, containing but little in the matter of judicial decisions. Klostermann's work, entitled *Die Patentgesetzgebung aller Länder, etc.* (Berlin, 1869), has enough upon the law of Trade-marks to satisfy any one that the principles thereof are understood and applied in all countries in the same way, and to the same extent.

In 1871 appeared a volume of nearly 800 pages, entitled "American Trade-mark Cases," gathered by Mr. Rowland Cox. This collection is convenient and valuable, inasmuch as it contains or embraces the principal published decisions of the courts of the various States of this Union; and in an Appendix the decisions of the English courts.

We have also Fisher's English Digest, and other Digests by able American editors. These all are useful, if they do no more than point the direction in which the inquirer shall seek more full and explicit authoritative enunciations of legal principles. It is, however, to be regretted that these collections of decisions are not carefully classified, so that a Trade-mark proper may at a glance be distinguished from analogous subjects. The titles are too general. This fault — for so it must be termed — is not attributable solely to the collectors of decisions, but in some measure to the judges and reporters, who do not properly label their wares before they send them forth to the world. These frequently bear false marks. In the hurry of practice, the counsel cites a case as authority, and to his chagrin finds that it will not bear the test of analysis. The supposed Trade-mark case turns out to be one of good-will of a hotel, a contest about the right to a sign over the door of a dry-goods shop, or something else quite valueless for the purpose required. Careless terminology is suspiciously like the outgrowth of a careless habit of thought.

The Law of Trade-marks must be gathered from the reports of judicial decisions of all civilized countries, not the least valuable of which are those of commercial tribunals of the Continent of Europe. In the discussion of ordinary legal topics, we must be content with the adjudications of courts under the sway of the common law of England; but in this matter, with Mansfield, we go below the surface, and seek the origin of the fundamental rules of our subject in the immutable law that Nature herself ordained. Local law could do no more than affect the remedy for a violation of a Trade-mark proper. Therefore, we go to the very foundation of right, to the law that has no place nor time.

This work would have been incomplete without a brief history of proprietary-marks of various kinds. It includes, also, a statement of the foundation of title to a Trade-mark; by whom, and how, the same may be acquired; the characteristics that entitle it to protection; what is deemed a violation of the right; the remedies, preventive, remunerative, vindicatory; and the practice and forms.

It also treats of analogous subjects, as mere labels, stamps, envelopes, advertisements, and other things frequently mistaken for and cited as the universal mark of commerce; and also of the names of establishments of trade, of inns, &c.; of names of firms; of names of literary publications, and other matters, all controlled, more or less, by the same principles, although variant in nature.

Perhaps not the least interesting matter will be the decisions of the Patent Office in the treatment of applications for registration, mostly never before printed. The rules and forms of practice in the Office must, it is believed, prove to be of some value to the practitioner.

Much valuable material may be found in the Appendix, including an alphabetical list of eleven hundred registered cases, with short descriptions, &c.

So far as possible, the latest decisions of the courts of England, France, and other European nations, as well as those of our own land, have been consulted and cited.

W. H. B.

WASHINGTON, D.C., January, 1873.

CONTENTS.

[*The figures refer to the sections.*]

INDEX TO CASES CITED	xv
--------------------------------	----

CHAPTER I.

INTRODUCTION	1
------------------------	---

CHAPTER II.

PROTECTION OF TRADE-MARK PROPERTY	20
---	----

CHAPTER III.

DEFINITION AND NATURE OF A TRADE-MARK	80
---	----

CHAPTER IV.

INDICATION OF ORIGIN OR OWNERSHIP	144
---	-----

CHAPTER V.

EXAMPLES OF TRADE-MARKS	195
-----------------------------------	-----

CHAPTER VI.

ACT OF CONGRESS OF 1870 EXPLAINED	278
---	-----

CHAPTER VII.

PROTECTION AND REMEDIES UNDER THE ACT	330
---	-----

CHAPTER VIII.

INFRINGEMENTS	385
-------------------------	-----

CHAPTER IX.

REMEDIES — LAW AND EQUITY 451

CHAPTER X.

DEFENCES 474

CHAPTER XI.

DAMAGES 499

CHAPTER XII.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS 521

CHAPTER XIII.

PRACTICE IN PATENT OFFICE GENERALLY 565

CHAPTER XIV.

INTERFERENCES IN PATENT OFFICE 617

CHAPTER XV.

ABANDONMENT OF TRADE-MARK 674

 APPENDIX.

[*The figures refer to pages.*]

TREATIES AND CONVENTIONS. — Austria, 557. — Belgium, 558. — France, 558. — German Empire, 559. — Russia, 559.

LAWS OF VARIOUS COUNTRIES. — Austria, 560. — Bavaria, 563. — Belgium, 563. — Canada, 564. — Denmark, 565. — England, 565. — France, 569. — Holland, 572. — Prussia, 572. — Rome, 572. — Russia, 572. — Sardinia, 573. — Saxony, 573. — Spain, 573. — Wirtemberg, 573.

PATENT OFFICE FORMS. — Application for Registration, 574. — Transfer of Trade-mark, 578. — Preliminary Interference, &c., 578. — Interference, &c., 582.

FORMS OF PLEADINGS, &c. — Declaration in Federal Courts, 586. — General Demurrer to Declaration, 590. — Plea in Abatement, 591. — Replication, 591. — Notice of Motion for leave to amend, 592. — Complaint at Common Law in State Courts, 592. — Bill in Equity, Federal Courts, 594. — Order to show cause why Injunction should not issue, 596. — Answer to Bill, 597. — Decree for Injunction, 598.

TABLE OF CASES REGISTERED AS TRADE-MARKS, 601.



INDEX. — 641.

INDEX TO CASES CITED.

A.

	SECTION
Abadie & Co. v. Proudhon & Co.	224
Abington v. North Bridgewater	288
Adams & Hammond v. Edwards <i>et al.</i>	676
Ainsworth v. Walmesley	66, 199, 205, 312, 360
Aldrich <i>et al.</i> v. Bingham	619
Almy v. Harris	424
American Hide, &c., Co. v. American Tool, &c., Co.	678, 682
Ames v. King	427
Amoskeag Manuf. Co. v. Garner	36, 310, 311, 450, 497
Amoskeag Manuf. Co. v. Spear	36, 93, 153, 235, 462, 685, p. 598
Armistead v. Blackwell	192, 653
Arnold v. Bishop	319
Aubertin v. Vix <i>et al.</i>	48
Auburn, &c. v. Douglass	508

B.

Badoit v. André	170
Banks v. Gibson	530
Bardin v. Gobert <i>et al.</i>	601
Bardou v. Lassausée	212
Bardou <i>et al.</i> v. Sabatou <i>et als.</i>	398
Barnett v. Kübler	166
Barrows v. Knight	216, 426, p. 590
Batty v. Hill	597
Bautain v. Mercklein	527
Beard v. Turner	497
Bell v. Daniels	502
Bell v. Locke	105, 107, 550
Bernard v. Emonds	200
Berthelon v. Vergé	535
Binninger v. Wattles	597
Bisson-Aragon v. Aragon	187
Blackwell v. Armistead	659, 660
Blanchard v. Hill	395, 458, 500

	SECTION
Blanchard <i>v.</i> Reeves	467
Blofield <i>v.</i> Payne	458, 500, 507, 541
Bloss <i>v.</i> Bloomer	374, 443
Boardman <i>v.</i> Meriden Britannia Co.	148, 230, 395, 538
Bonnet <i>et als.</i> <i>v.</i> Henry Delisle	527
Bournhonet & Basille <i>v.</i> Tisseron <i>et al.</i>	179
Boyd <i>v.</i> Browne	336
Bradley <i>v.</i> Norton	663
Braham <i>v.</i> Bustard	245
Brooklyn White Lead Co. <i>v.</i> Masury	183, 191, 657, 659
Brown <i>v.</i> State of Maryland	301
Bru <i>v.</i> Larband	258
Brunswick <i>v.</i> Dunning	299
Bryce <i>v.</i> Dorr	508
Burgess <i>v.</i> Burgess	432
Burnett <i>v.</i> Phalon	237, 397, 450, 657
Bury <i>v.</i> Bedford	362, 366, 437
Byass <i>v.</i> Sullivan	427

C.

Cahoon <i>v.</i> Ring	355
Caminade & Co. <i>v.</i> Caminade	527
Candee, Swan, & Co. <i>v.</i> Deere & Co.	597
Carey <i>v.</i> Collier	309
Carmoy <i>v.</i> Samson	440
Carpentier <i>v.</i> Canivet	414
Carter <i>v.</i> Baker	505, 513, 517
Carver <i>v.</i> Pinto Leite	473
Castille <i>v.</i> Dennery	552
Caswell <i>v.</i> Davis	220
Chabrier <i>v.</i> Peillon	598
Chaize <i>v.</i> Fromentelle	536
Chappell <i>v.</i> Davidson	549
Chappell <i>v.</i> Sheard	557
Cheever <i>v.</i> Wilson	289
Chevet <i>v.</i> Lemasson	527
Child <i>v.</i> Adams <i>et als.</i>	328
Choynski <i>v.</i> Cohen	100, 161
Christoffe & Co. <i>v.</i> Deleiderrier	22, 51
Christy <i>v.</i> Dande	261
Christy <i>v.</i> Murphy	65, 528
Churton <i>v.</i> Douglass	526
Clark <i>v.</i> Clark	388, 427
Clark <i>v.</i> Freeman	393, 555
Clayton <i>v.</i> Stone	108

	SECTION
Clement <i>v.</i> Maddick	550
Clertan <i>et al.</i> <i>v.</i> Carpentier	236
Clicquot <i>v.</i> Rondeau <i>et als.</i>	455
Clinton <i>et al.</i> <i>v.</i> Douglass	98
Coats <i>v.</i> Holbrook	36, 336, 496
Cocks <i>v.</i> Chandler	542, 546
Coffeen <i>v.</i> Brunton	458, 460, 462, 468, 501, 538
Cohen & Co. <i>v.</i> Maris and Widow Robert	252
Colladay <i>v.</i> Baird	186, 312
Collins Co. <i>v.</i> Brown	301
Collins Co. <i>v.</i> Cohen	301, 360
Colton <i>v.</i> Thomas	540
Compere <i>v.</i> Bajou <i>et als.</i>	209
Comstock <i>v.</i> White	38, 563
Congress & Empire Spring Co. <i>v.</i> High Rock Congress Spring Co.	39, 146, 191, 247, 360, 657, 661
Conover <i>v.</i> Rapp	513
Corwin <i>v.</i> Daly	65, 395
Covel <i>v.</i> Maxim	643
Cowing <i>v.</i> Rumsey <i>et al.</i>	507, 513
Cox <i>v.</i> Land and Water Journal Co.	559
Crawshay <i>v.</i> Thompson	395, 458
Croft <i>v.</i> Day	28, 201, 374, 393, 422, 423, 538
Crompton <i>v.</i> Belknap Mills	325
Crutwell <i>v.</i> Lye	523, 526
Curtis <i>v.</i> Bryan	201, 374, 426, 492

D.

Dalbanne & Petit <i>v.</i> Colleuille & Co.	216
Dale <i>v.</i> Smithson	374, 458, 494, 538
Davis <i>v.</i> Garrett	518
Davis <i>v.</i> Kendall	273, 468, 516, 563
Day <i>v.</i> Woodworth	519
Dayton <i>v.</i> Wilkes	106, 108, 550
De Bussy (Charles) <i>v.</i> Charles Marchal	556
Delaware & Hudson Canal Co. <i>v.</i> Clark	144, 189, 657, 661
Denis & Mounier <i>v.</i> Vignier, Dodart, & Co.	253
Dental Vulcanite Co. <i>v.</i> Wetherbee	689
Derringer <i>v.</i> Plate	47, 360, 424
Dietrichsen <i>v.</i> Cabburn	562
Dixon Crucible Co. <i>v.</i> Guggenheim	37, 114, 172, 360, 396, 420, 541
Dorvault <i>v.</i> Hureaux	529
Dorvault <i>v.</i> Teissier & Co.	529
Dougherty <i>v.</i> Van Nostrand	526
Dugué & Co. <i>v.</i> Bobot-Descoutures	603

E.		SECTION
Eames & Sealey <i>v.</i> McDougal		633
Eberman <i>v.</i> Reitzell		373
Eddleston * <i>v.</i> Vick	72, 73,	541
Edelston <i>v.</i> Edelston		411
Ellis <i>v.</i> Zeilen & Co.		418
Ely <i>v.</i> Monson		466
Estibal <i>v.</i> Petit-Demenge		551
F.		
Faber <i>v.</i> Faber		421
Faivre <i>v.</i> Duguaire <i>et al.</i>	184,	657
Falkinburg <i>v.</i> Lucy	83, 148, 255, 538,	657
Farina <i>et al. v.</i> Camus		302
Ferguson <i>v.</i> Davol Mills		149, 234
Fetridge <i>v.</i> Merchant	38, 244, 374,	462
Fetridge <i>v.</i> Wells	148, 241, 244, 327, 372,	488
Filley <i>v.</i> Fassett	148, 150, 664, 682,	685
Foote <i>v.</i> Silsbee		503
Forsythe <i>v.</i> State		373
Fowle <i>v.</i> Spear	374, 429, 475,	491
Frances (The) case		295
French <i>v.</i> Rogers		323
G.		
Galy <i>v.</i> Mauchien & Co.		564
Garnier <i>v.</i> Berthe		407
Garnier <i>et al.</i> Carthusians <i>v.</i> Rivoire		409
Garnier <i>v.</i> Paul Garnier	408, 410,	582
Garnier <i>v.</i> Lindière <i>et als.</i>		409
Gilbert & Co. <i>v.</i> Benedictus		441
Gillis <i>v.</i> Hall		425
Gillott <i>v.</i> Kettle		36, 446
Gillott <i>v.</i> Esterbrook	226, 401, 446, 512, 544,	685
Glen & Hall Manuf. Co. <i>v.</i> Hall		401, 442
Glenny <i>v.</i> Smith		531
Goodyear <i>v.</i> Dunbar		464
Goodyear <i>v.</i> Hullahen		324
Gourbeyre <i>v.</i> Bodevin		236
Gout <i>v.</i> Aleploglu	222,	343
Gravelet (<i>dit</i> "Blondin") <i>v.</i> Arnault		213

* In the reports this name is spelled two ways : this is probably correct.

	SECTION
Green v. Folgham	562
Guerineau v. Mignon	236
Guislain & Co. v. Labruguère	397, 450
Guyon v. Sewell	503

II.

Hall v. Barrows	312, 360
Halbron v. Malespine	416
Hammond v. Douglass	526
Harrison v. Taylor	497, 660
Hawkins v. Lambert	633
Hayden v. Phillips	619
Heath v. Wright	429, 475, 491
Heidsieck v. Souris, Dresel, <i>et als.</i>	455
Héroid v. Gerbeau	679
Hine v. Lart	150, 612
Hobbs v. Français	485
Hogg v. Emerson	508
Hogg v. Kirby	108, 458, 474, 548
Holloway v. Holloway	430, 541
Holmes <i>et als.</i> v. Holmes <i>et als.</i>	354
Holtzer & Co. v. Lendenberg & Co.	50
Hovenden v. Lloyd	543
Howard v. Henriques	83, 92, 95, 96, 523
Howe v. The Howe Machine Co.	201, 422, 423
Howe v. Searing	83, 98, 99, 210, 522, 524, 526
Hudson v. Osborne	437

J.

Jackson v. Nichols	633
Jansen v. Ostrander	299
Jenkins <i>et al.</i> v. Putnam	633
Jones v. Pearce	627
Jurgensen v. Alexander	427

K.

Kemp v. Herman	302
Kenyon v. Wesson	627
Knott v. Morgan	413, 560

L.

Lagarde v. Piper	400
Laker v. Damon	510

	SECTION
Lalande <i>et al.</i> v. Appel <i>et als.</i>	85, 141
Laurens v. Laurens	527
Leather Co. v. American Leather Co.	30, 41, 64, 83, 85, 87, 96, 126, 141, 360, 374, 477, 657, 661
Leather, &c. v. Hirschfield	505
Lee v. Haley	498
Leech v. Doorgachurn <i>et al.</i>	74
Lemercier v. Millin	529
Lemoine v. Ganton	683
Leroy v. Calmel	49, 682
Levigoureux <i>et al.</i> v. Lecompte & Co.	187
Levy v. Bizet	236
Lewis v. Langdon	526
Lockwood v. Bostwick	360, 397
Lord Byron v. Johnstone	554
Lorimier & Bovet v. Dubois	539
Lowell v. Lewis	508

M.

Marsh v. Billings	458, 501, 505, 561
Marshall v. Ross	72
Martell & Co. v. Badoureau & Patte	456
Massez v. Joly	434
Matsell v. Flanagan	36, 107, 374, 550
Mauprivez v. Buchet <i>et als.</i>	165
McAndrew v. Bassett	52, 184, 657
McCardel v. Peck	97, 528
McCartney v. Garnhart	403
Merrimack Manufacturing Co. v. Garner	256, 462, 538
Messerole v. Tynberg	67, 216
Michel (Désiré) & Co. v. Achard & Co.	190
Michel (Nestor) v. Stremier	236
Millaud v. Caron	417
Millaud v. Marian <i>et als.</i>	417
Millaud v. Le Petit Journal du Nord	417
Millington v. Fox	312, 393, 468
Ministère, &c. v. Compagnie de l'Est	71
Moet v. Couston	471
Mondin & Co. v. Sari <i>et als.</i>	534
Moorman v. Hoge	341, p. 625
Morison v. Moat	562
Morison v. Salmon	429
Mottley v. Downman	102, 462
Mowry v. Whitney	624
Muller v. Compagnie immobilière	529

N.

	SECTION
Newbury <i>v.</i> James	562
Newby <i>v.</i> Oregon Central R. R. Co. <i>et als.</i>	353
Newman <i>v.</i> Alvord	182, 188, 538, 657, 659

O.

O'Hara <i>v.</i> Hawes	319
----------------------------------	-----

P.

Page <i>v.</i> Ferry	503
Palmer <i>v.</i> Harris	374, 481
Panckoucke <i>v.</i> Wittersheim	415
Parker <i>v.</i> Brant	464
Parker <i>v.</i> Helme	503
Parker <i>v.</i> Sears	464
Partridge <i>v.</i> Menck	32, 35, 256, 374, 386-387, 462, 489, 496
Pasley <i>v.</i> Freeman	336
Perry <i>v.</i> Truefitt	41, 393, 479, 532, 661
Peterson <i>v.</i> Humphrey	524
Phalon <i>v.</i> Wright	166, 484
Phelps <i>v.</i> Brown	614
Pidding <i>v.</i> How	480, 491
Pinaud & Amour <i>v.</i> Pineau	527
Pisano <i>v.</i> Lawson	301
Potter <i>v.</i> Holland	355
Prudon <i>v.</i> Brousse <i>et al.</i>	605
Purser <i>v.</i> Brain	549

R.

Ransom <i>v.</i> the Mayor, &c.	355, 502
Reg. <i>v.</i> Closs	453
Reg. <i>v.</i> Gray & Gosling	452
Reg. <i>v.</i> S. Jones	452
Reg. <i>v.</i> J. Smith	452, 453
Rian <i>v.</i> Bernheim	165
Ricque <i>et als. v.</i> Forges <i>et al.</i>	268, 585
Rcdgers <i>v.</i> Nowill	367, 428, 458, 507
Rodgers & Son <i>v.</i> Philp & Solomons	684
Ræderer & Co. <i>v.</i> Ræderer	438
Rogers <i>v.</i> The Amado	295
Ross <i>v.</i> Ross	288
Rowley <i>v.</i> Houghton	612

	S.	SECTION
<i>Salignac & Co. v. Lavanier & Co.</i>		599
<i>Samuel v. Berger</i>		361, 474
<i>Sargent v. Romeu</i>		50, 216
<i>Schorthose v. Hogg</i>		529
<i>Schrauder v. Beresford & Co.</i>		383, 449, 626, 661
<i>Seixo v. Provezende</i>		385, 405, 661
<i>Serrell v. Collins</i>		355
<i>Seymour v. McCormick</i>		503
<i>Sickles v. Borden</i>		515
<i>Singleton v. Bolton</i>		180, 367, 395, 458, 500
<i>Smith v. Woodruff</i>		476, 493
<i>Snowden v. Noah</i>		36, 104, 107, 550
<i>Somborn v. Menser et al.</i>		356
<i>Southern v. How</i>		63, 395, 500
<i>Southron v. Reynolds</i>		17
<i>Spaulding v. Page</i>		515
<i>Spaulding v. Tucker</i>		515
<i>Spencer & Son v. Peigney</i>		178, 686
<i>Spottiswoode v. Clarke</i>		31, 257, 462, 549
<i>Stephens v. De Conto</i>		108, 111, 550
<i>Sternberger v. Thalheimer & Hirsch</i>		357, 383, 638
<i>Stevens v. Keating</i>		463
<i>Stewart v. Smithson</i>		495
<i>Stokes v. Landgraff</i>		157, 160, 597
<i>Stone v. Carlan</i>		560
<i>Stonebraker v. Stonebraker</i>		435
<i>Stubs v. Astier et als.</i>		48, 178, 688
<i>Swift v. Dey</i>		36, 113, 450
<i>Sykes v. Sykes</i>		201, 395, 422, 423, 461

T.

<i>Taylor v. Carpenter (3 Story, 458)</i>		21, 36, 685
<i>Taylor v. Carpenter (2 Wood. & M. 1).</i>		21, 65, 301, 336, 503, 685
<i>Taylor v. Carpenter (11 Paige, 292).</i>		65, 496, 501
<i>Tegmeyer v. Kerns</i>		627
<i>Ternaux v. Bournhonet</i>		527
<i>Thibierge v. Dupont et als.</i>		165
<i>Thomas v. Weeks</i>		661
<i>Thomson v. Winchester</i>		203
<i>Thunot-Davotenay v. Degorce-Cadot</i>		553
<i>Tipping v. Clarke</i>		562
<i>Tournachon v. Tournachon</i>		213
<i>Tracy v. Swartwout</i>		503

U.

	SECTION
Upmann <i>v.</i> Elkan	472
U. S. <i>v.</i> Hudson & Goodwin	450

V.

Venus (The) case	290, 295
----------------------------	----------

W.

Walch, Brooks, & Kellogg <i>v.</i> M. J. Cole & Co.	662
Walton <i>v.</i> Crowley	360, 402
Ward <i>v.</i> Ward	682
Warton <i>v.</i> Klug	439
Wedgwood <i>et als.</i> <i>v.</i> Smith <i>et als.</i>	216
Welch <i>v.</i> Knott	393
West <i>v.</i> Rice	502
Weston <i>v.</i> Hunt	299
Wheaton <i>v.</i> Hubbard	424
Whittaker <i>v.</i> Cutter	325
Whitely <i>v.</i> Swayne	322, 329, 651
Whittemore <i>v.</i> Cutter	508
Williams <i>v.</i> Johnson	119, 597
Williams <i>v.</i> Spence	597
Williams <i>v.</i> Williams	562
Winans <i>v.</i> N. Y. & Erie R. R. Co.	335
Wintermute <i>v.</i> Redington	503
Woodward <i>v.</i> Lazar	92, 528
Woolam <i>v.</i> Rateliff	412
Wolfe <i>v.</i> Goulard	596, 660
Wolfe <i>et als.</i> <i>v.</i> Udolpho Wolfe Co.	596
Wotherspoon <i>v.</i> Currie	184, 185

Y.

Youatt <i>v.</i> Winyard	652
------------------------------------	-----

LAW OF TRADE-MARKS.

CHAPTER I.

INTRODUCTION.

Antiquity of Proprietary Marks. — Some Ideas as to their Use by the Ancients. — Symbolical Language of Trade-marks. — Vouchers of Authenticity of Articles of Commerce. — Of what may Marks consist. — Seals, Coins, Emblems. — To be respected must be protected. — Use by Manufacturers, Traders, Booksellers, &c.

§ 1. **Antiquity of the Subject.** — The proprietary instinct is an implantation of nature. The claim to property is asserted by means of symbolism. A man may be permitted the free use of an estate; but his enjoyment of it must necessarily be imperfect unless his title be attested by the symbolical marks borne by the title-deed. Upon the genuineness of those marks, consisting of words, signatures, and seals, depends his faith. If any of those signs prove to be false, the absolute right to the property is illusory. Who would purchase even a toy for a child without feeling assured that he was being dealt with in good faith? He desires a particular article, the make of some especial manufacturer. He glances at a mark upon the thing offered. It is sufficient. It has a peculiar sign upon it. Faith guides him. The same faith has governed men in their commercial transactions through all past ages, and must continue to do so for all the future.

§ 2. Seals and emblems of ownership were coeval with the birth of traffic. The numerous relics of prehistoric antiquity,

which have floated down to us on the current of Time, fully authorize this conclusion. That such marks were always in use at less remote periods, we gather from the records of chroniclers, on whose lips the signet-royal of Death was impressed thousands of years ago. In truth, no organized system of trade could safely be conducted without the aid of symbols of ownership, or of origin; for the simplest mode of exchange of goods, to be trustworthy, must be subject to faith in the authenticity of emblems attesting the probity of the vendor. We may reasonably assume, therefore, that marks were found to serve an important purpose from the beginning of competition in manufactures and the incipency of commercial spirit. What more natural than to affix a mark of identity to any thing we make or possess! It is not done through a churlish or selfish motive, but merely to avoid confusion and dispute.

§ 3. Such emblems had their origin in a general ignorance of reading the combinations of cabalistic characters that we call writing. A written certificate of the genuineness of any article of merchandise could not be understood by the nomadic peoples who desired to barter natural products for something made by the hand of skilled artisans. A simple emblem, as a crescent, a sun, a star, an animal, or other object copied from nature or devised by fancy, when once associated with a particular class of goods, or the handicraft of a certain man, would readily be understood. Perhaps Tubal-cain — he who in the first ages of the world was “the instructor of every artificer in brass and iron” — was wont to impress on his utensils and weapons a peculiar emblem of authenticity. Faith, the very soul of commerce, thus gave mutual advantages. The maker was protected against unfair competition of inferior workmen, and the purchaser had a guaranty of excellence. The mark was as easily read as were the marks that distinguished the cattle of Jacob from those of Laban. It spoke an emphatic language: When you see me, know that I have come

from So-and-so. From the day that such signs were used by artisans to indicate the product of their skill, or by merchants to vouch for the honesty of commodities sold or traded by them, base imitators must have existed, for dishonesty is not the junior of art. He who could forge a piece of metal could also forge a symbol. Thence arose the necessity for restrictive laws and retributive penalties; for from the beginning of the world the protection of the helpless and innocent has been a supreme object of legislation. "The law was made for transgressors," and to the law the wronged, the weak, the simple, look for redress from the rapacity of wicked men, and for the conservation of their rights. We can readily conceive how easy was the transition from the process of marking animate property to inanimate, from the branding of flocks and herds to the branding or otherwise marking of manufactures. The history of the word *chattel* informs us that in the early ages beasts constituted the chief part of a man's property. The word signifying cattle came to mean all other kinds of movable property the subject of bargain and sale, so the symbol of ownership might as well be applied to one kind of personal property as another. The object of affixing a mark was gain, just as it is now. It is meant to insure an adequate reward for acceptable workmanship, or to be evidence of authenticity.

§ 4. Seals are the most sacred of proprietary marks; and from early antiquity they have been used. The seal has ever been a distinguishing mark of ownership; of security, as in the case of sealing the den of lions upon Daniel, and the door of the sepulchre wherein was laid the body of the Saviour; of affection, as in the language of the Church to her Lord in the Song of Solomon: "Set me as a seal upon thy heart, as a seal upon thine arm;" of honor, of secrecy, of attestation, of authenticity. The *sigillum* or signet of a monarch or man in authority has always been deemed an instrument of power. Many noble families have in use ancestral seals which have descended to them from distant generations, and which they

regard with reverent pride. The seal is a figure frequently mentioned in Scripture. We read of the inscription on one, "The Lord knoweth them that are his;"¹ and St. John tells of the mighty host who were sealed in their foreheads.² We speak of the seal of baptism, the seal of holy communion, the seal of matrimony, and, most solemn of all, the seal of death.

§ 5. Soon after the Norman conquest, in consequence of their presence being required to give validity to every species of legal documents, SEALS became instruments of the greatest moment; and heraldic insignia, with a representation of the knightly shield, upon whose field they were displayed, were exactly suited to fulfil all the requirements of the seal-engraver. By such means heraldry became interwoven as well with the peaceful concerns of every-day life as with the display or martial splendor and turmoil of war. Heraldry may be regarded as a science, insomuch as it possesses a system, a classification, and a language of its own, — which language speaks forth in many a hundred trade-marks. But in this work it is simply as a token of proprietorship and authenticity, and as a fertile source of business emblems, that we regard the seal. Whether as a sign, a word, a brand, — in all cases the legal significance is the same. A *brand* (from the Anglo-Saxon, *brand*, to burn) is a seal of ownership imprinted on casks or other wood-work with hot iron; derived from the custom of burning criminals with heated metal. Seal-marks of rank, profession, trade, are infinite in style, but each is sacred to its possessor or originator. No man has any more right to plunder his neighbor's emblem, whether private or professional, than he has to steal his gold or his wife. In hereditary dignities, the seal, regarded as a precious jewel, attached to the title, and the most rare and exquisite gems are often employed in their construction. Heraldic devices are frequently highly prized as commemorative of family honors. Virgil assigns to Aventius "insigne

¹ 2 Tim. ii. 19.

² Rev. vii. 3.

fraternum" upon his shield, — his hereditary device, derived by him from his father.¹ Badges are likewise proprietary marks: "Might I but know thee by thy household badge,"² says Shakespeare; and again he says, "For sufferance is the badge of all our tribe."³ The label, another heraldic term, is only connected with trade-marks so far as being a groundwork for figures or other devices.

§ 6. Sign-boards are yet another description of proprietary marks. The ancient Egyptians, Greeks, Romans, seized this idea of advertising, and displayed sign-boards with inscriptions denoting their trades, further embellished with the most striking emblems thereof. We have no reason to think that the shrewd Oriental and Latin merchants were in those ancient days a whit behind their successors in the great bazar of life in devices to influence trade. On the contrary, they seem to have been exceedingly fertile and ingenious in symbols and other adjuncts of popularity. Amongst the ruins of Herculaneum and Pompeii have been discovered signs crudely painted, or graven in stone, or modelled in *relievo* in terra-cotta and inserted in the pilasters at the side of the open shop-fronts. Thus there have been found a *goat*, the sign of a dairy; a *mule* drawing a mill, the sign of a baker; and, at the door of a school, the not very seductive sign of a *boy* undergoing a birching at the hand of the master. At the shop of a perfumer were represented various items of his traffic. There were also the signs of the anchor, the ship, a sort of chess, and chequers. In Herculaneum, at what was probably the door of a shoemaker, was a painted *Amorino*, or Cupid, carrying a pair of ladies' shoes, one on his head, the other in his hand. Complex or simple sign-boards seem to be indispensable to prudent trading, and the most illiterate rustic has sufficient tact to fashion a trade-mark peculiar to himself, and not to be infringed on by another. From the custom of setting up a green bush at the door of a vintner,

¹ Æneid, vii. ² Henry VI., Part 2, Act 5. ³ Merchant of Venice, Act 1.

arose the Italian proverb, "Al buon vino non bisogna frasca." From the Romans undoubtedly our forefathers adopted the sign-board. A thousand-or-so years ago reading was a rare acquirement with the commonalty; consequently to write the trader's or owner's name would be of little avail. Those that could, advertised their names by rebuses; thus, for instance, a hare and a bottle stood for Harebottle, and two cocks for Cox. Others, whose names no rebus could represent, adopted pictorial objects according as genius or imagination suggested. What more convenient than for an innkeeper to emblazon on his sign-board the family crest of the lord of the estate whereon he lived! Luther was generally represented by the symbol of a swan; thus, "The Bible and Swan" was the characteristic sign of an inn in honor of Luther. Did not Lord Mountgarrat derive his title from the fact that one of his ancestors was a man of letters, probably a briefless barrister who had his dwelling in an attic? Temporary or accidental emblems have oftentimes become permanent associations, as in the case of the style of paper termed foolscap. In the reign of Charles the First, all English paper bore in water-marks the royal arms. Cromwell's parliament, to cast indignity upon the memory of that unhappy monarch, substituted the fool's cap and bells. Although in the course of time those symbols were discontinued, the name sticks.

§ 7. It may not seem irrelevant here to allude to the interesting law-case which was decided by a water-mark on paper. On the demise of a wealthy person, a forged will was produced so cunningly executed, that, although by the parties concerned it was known to be false, the fact could not be legally proven. As the counsel of the rightful heir sat studying the case over one night in his office, he chanced to hold the document up before the candle, and there, to his deep satisfaction, he discovered in water-marks the figures of the year in which the paper was made. It was a period of several years *after* the date in which the false will was said to have been executed.

* The only paper found in the case was the one which was produced by the executor of the will. The court was divided on the point whether the paper was genuine or not. The judge in the end decided in favor of the executor, and the will was admitted to probate.

§ 8. If one kind of workman might profitably employ individual marks, so might any other. The mechanics in the quarries, making ready stones for the temple of Solomon, availed themselves of this mode of proving their claims to wages. Recent discoveries confirm the tradition. The cinders of burnt Jerusalem have been cut through, and turned up to the light. The seal of Haggai, in ancient Hebrew characters, has been picked up out of the siftings of the rich moulds deposited by the treasures of Jewish pride. The first courses of stones, deposited by Phenician builders, have been reached. Quarry-marks, put on in vermilion, have been copied,—known to be quarry-marks by the trickling drops of the paint, still visible; only they are above the letters, showing that when they were affixed the stones lay with the underside uppermost.¹ The same practice continues in vogue to this very day where many men are employed. The engineer and the architect know each mark, and thus can instantly fix the origin of every piece of work. The practices of antiquity are exhibited and copied by our own artisans, who stop not to think whether they are not pursuing the practices of other forerunners of several thousand years ago. We see the tile-maker stamp his products with his private mark; and sometimes the common building-brick is impressed with its author's seal, rude though it be. The most ancient bricks recovered from the ruins of the temples of Nineveh and Egypt have many kinds of marks of origin.

§ 9. The condition of man as an inhabitant of the earth, and the relations and intercourse of men as members of a community, involved the necessity of a circulating medium. A *tertium quid* — a third commodity of a certain value — became necessary as a medium of exchange. At different periods the medium of exchange has been represented by various commodities, which at this day would be the very objects of barter.

¹ See the First Statement of the Palestine Exploration Society, 1871.

The ancient Greeks, with a limited commercial intercourse, used as a currency the cattle that grazed upon their land. These had one advantage, that of being able to transport themselves, under charge of drivers. Homer (in his episode of Glaucus and Diomed, where the former is represented as having given his golden armor, worth a *hundred oxen*, for the brazen armor of the latter, worth but *nine*¹) chronicles the use of cattle as a medium of exchange. Yet at that time the Greeks had talents of gold, but they were too valuable to use as current specie. Then as the use of coin superseded the more cumbrous living standard of value, the term "oxen" or "cattle" was transferred to the representative coin. They used stamped bars, the rude mark serving the same end that the image and superscription did at a later period. That plan again failed to receive full confidence, so it was supplanted by actual coinage, which many authorities date from about seven centuries before the Christian era.² Hōmer, however, speaks of brass money as being in existence nearly twelve centuries B.C. To the Lydians is ascribed the invention of gold and silver coin. At Rome, under Servius Tullius, money was coined about 578 B.C. Julius Cæsar was the first person who obtained permission from the senate to stamp his image on the national coin; that honor having previously been reserved for the gods or defunct heroes. It was probably about the time that Daniel was cast into the lions' den that those famous pieces of gold called *Darics*, from Darius the Mede, were coined; their fineness and beauty causing them to be preferred to all other money throughout the whole East. Spanheim informs us that upon the coins of Tenedos and those of other cities a *field-mouse* is engraven; together with Apollo Smintheus, the driver away of field-mice, on account of his being supposed to have freed certain tracts of ground from those animals. Shekels that have Samaritan inscriptions were generally coined by Simon the

¹ Gillie's Ancient Greece, vol. i. p. 11.

² Snowden's Mint Manual of All Nations.

Maccabee. The first money coined in England was under the Romans at Colchester.

§ 10. There must have been an interval of over one thousand years during which the precious metals were known and used before the ingenuity of man was able to apply them to the purposes of coinage. 1860 years B.C., Abraham, for a burial-place for his wife Sarah, purchased the cave of Machpelah; "and," says inspired writ, "Abraham weighed to Ephron the silver which he had named in the audience of the sons of Heth, four hundred shekels of silver, *current money with the merchant.*"¹ We must conjecture that the money alluded to was the simple bullion, perhaps marked but not coined. A currency of authenticated coin has always been an essential element of civilization.

§ 11. It is an indisputable fact that in all ages of the world, and among all races of men, some form of symbolical expression has been in use and in favor. It was the badge of good faith. *Caveat emptor!* Let the purchaser beware! See that the seal is on the bale of goods, the marks on the fabrics! The people of the ancient nations had need of symbols as well as we. Until within the last few years the arts practised in India were nearly as numerous as those known in Europe and America. The Persians, Babylonians, Assyrians, and the still more ancient Egyptians, had their multifarious products of skilled labor. In Nineveh, the people made warlike arms, and worked in gold. They glazed earth, made beads, and wrought famous embroideries. The Etruscans were eminently skilled in the arts both of use and beauty. All those nations maintained commerce. Much of the prosperity of the cities of Asia Minor was due to the trade with India. We find that the Hindoos, a manufacturing and mercantile people, 1200 or 1300 years B.C., had their emblematic marks for merchandise. Those persons who were unable to write used the most distin-

¹ Gen. xxiii. 14-16.

guishing symbol of their craft. Thus, the cultivator used the plough; the carpenter, the gimlet; the iron-smith, a pair of pincers; the shopkeeper, a pair of scales; the musical instrument maker, a lyre, a pipe, or a trumpet. The learned used symbols that might be intelligible to the unlearned. In short, a monogram a letter, some device drawn on the article made, to denote the place of its manufacture, the artist employed, the date, was all that was requisite to constitute a proprietary mark.

§ 12. Fragments of pottery bearing peculiar marks of workmen are everywhere found in the ancient cities of the East; "pottery," as Brogniart has remarked, "affording the best records of the early ages of man, as bones do of the earth."¹ Commerce required its hieroglyphics, and commerce was universal. The situation of Babylon, at the head of the Persian Gulf, was admirably adapted for trading purposes; hence, from the time of its destruction, it was succeeded by other cities until the foundation of Bagdad. Thus spices, ivory, ebony, dyes, gums, pearls, leather, silk, and cotton-stuffs, — every sort of serviceable commodity, were floated on the Euphrates and the Tigris, or brought in caravans of camels to the grand central mart, each species of product bearing some unmistakable impress of the mercantile enterprise which exported it. We read of Babylonish carpets and tapestry, and the various other tissues and cloths so famed for brilliancy and richness of hues; and as early as the time of Joshua, mention is made among the spoils of Jericho of "a goodly Babylonish garment."

§ 13. Many relics of pottery found in different parts of the Assyrian empire exhibit upon their surfaces marks which prove that an engraved mould had been employed in their manufacture. The Chinese, the only people who profess to possess an exact chronology from the remotest antiquity to the present

¹ See Lecture by Prof. J. Forbes Boyle, F.R.S., on Arts and Manufactures of India.

time, are our preceptors in the style and mode of affixing marks to articles of fictile manufacture. We do as they did long before the Christian era. Their official annals record, as the inventor of pottery, the Emperor Hoang-ti, to whom they assign a date of 2698 years B.C. ; and they tell us that under his reign there was a superintendent of pottery named Ning-fong-tsee.¹ The Chinese had a priority of 1600 years over the invention of European porcelain ; yet we find proofs of their trade-marks. These are of two sorts.² One kind is composed of Chinese characters, which tell under what reign the article was made ; the other by designs in color, or engraved names of men, or of establishments, indicating the author of a vase, the place of manufacture, or the destination of the article, as for the use of the emperor or other dignity. On a piece of pure white china of great antiquity there was found stamped a factory-mark.

§ 14. When the pioneers in the art of printing were pondering their new invention, during the transition period from block-printing with detached letters, Gutenberg, in 1436, entered into an agreement with John Riffe, Anthony Heilman, and Andrew Dreizehn, in which affair the three associates were to furnish the necessary funds, while Gutenberg was to pay them one-half of any profits, the other half being for himself. After a time the association broke up, differences arose about the liquidation, and a lawsuit was the consequence. By the records of this suit, it appears that they kept their invention a secret, and called themselves "Spiegelmachers" (makers of looking-glasses). The speculum was their protecting symbol. Aldus Manutius, the famous Venetian printer, adopted the dolphin and anchor as his mark, borrowing the idea from a silver medal of the Emperor Titus, presented to him by Cardinal Bembo. In 1503, the olive-tree was the sign of Henry

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

² Histoire et Fabrication de la Porcelaine Chinoise. Translated from the Chinese by Julien. Paris, 1856.

Estienne, a bookseller and printer, whose firm for several generations continued to be the leading publishers and printers in Paris. The booksellers generally had a wood-cut of their signs for the colophon of their books, so that their shops might become known by the inspection of the cut. For that reason, Benedict Hector, one of the early Bolognese printers, gives this advice to buyers, in his "Justinus et Florus:" "Purchaser, beware, when you wish to purchase books from my printing-office. Look at my sign, which is represented on the title-page, and you can never mistake. For some evil-disposed printers have affixed my name to their incorrect and faulty works, in order to secure a better sale for them." Jodocus Badius, of Paris, gives a similar caution: "We beg the reader to notice the sign, for there are men who have adopted the same title, and the name of Badius, and so filch our labor." In the preface to the Livy of 1518, of Aldus, before mentioned, a similar fraud is exposed: "Lastly, I must draw the attention of the student to the fact that some Florentine printers, seeing that they could not equal our diligence in correcting and printing, have resorted to their usual artifices. To Aldus' *Institutiones Grammaticæ*, printed in this office, they have affixed our well-known sign of the dolphin wound round the anchor. But they have so managed, that any person who is in the least acquainted with the books of our production, cannot fail to observe that this is an impudent fraud; for the head of the dolphin is turned to the left, whereas that of ours is well known to be turned to the right."

§ 15. An acquaintance with booksellers' marks or signs, as expressed in the title-pages of their books, is of some use, because many books have no other designation of origin. We find an anchor, the mark of Raphelengius, at Leyden; the same, with a dolphin twisted around it, the mark of the Manutii, at Venice and Rome; the Arion, denoting a book published by Oporinus, at Basle; the Caduceus or the Pegasus, on the publications of the Wechelenses, at Paris and Frankfort;

the cranes of Cramoisey; the compass of Plantin of Antwerp; the sphere in a balance of Janson or Blaow, at Amsterdam; the lily of the juntas at Venice, Florence, Lyons, and Rome.¹ Many publishers also made use of monograms compounded of the initials or other letters of their names. These furnish a clew to the discovery of the printer, where they occur on books without the printers' names. He who desires to examine a treasure-house of lore upon this subject to assure himself how general was the adoption of proprietary marks by painters, designers, engravers, and sculptors, can consult the "Dictionnaire des Monogrammes, Marques figurées, Lettres initiales, Noms abrégés," &c., of François Brulliot, published at Munich in 1832-3-4, and to be found in the Astor Library in the city of New York, and in the Congressional Library.

§ 16. We can trace proprietary marks a long way back in the history of England. In the *Archæologia* for 1812, a roll of 219 swan-marks is given, together with the ordinances respecting swans in the river Witham, in Lincoln, the same belonging to various gentlemen. This paper bears the date of 1570. The marks consisted of nicks, the nicking being done by swan-herds, appointed by the king's license. A register of all the marks was kept. None but freeholders were to have marks, and those were to be perfectly distinct from those used by other gentlemen. For instance, the company of the vintners had two nicks on their bills. This mode of indicating exclusive proprietorship is still annually illustrated by the guilds of London, who are entitled to claim the cygnets found with their old birds.

§ 17. The case of *Southron v. Reynolds*,² in England, in 1865, was in regard to a violation of a trade-mark used on clay pipes made at Broseley. A "broseley" is a household word with thousands who use the thing while wholly ignorant of its deriva-

¹ *Encyclop. Britannica*, vol. v. p. 30.

² 12 L. T. R. (N.S.) 75.

tion, being unaware that they perpetuate the name of a quiet little village in Shropshire, on the banks of the Severn, whose chief reputation rests upon the excellence of the quality of the tobacco-pipes there made; although, singular to state, not made of the clay there found. Of the pipes collected near there two hundred have marks upon the spur, not two of which are alike. The manufactures at that place have been traced back to the year 1575, a time anterior to the introduction of tobacco into England, which suggests the inquiry as to what purpose said pipes could have been applied. One mark is of an open hand, with the initials S. D., probably Samuel Decon. Aubrey describes pipes made in his day by one Gauntlett, who marked the heels of them with a gauntlet, whence they were called Gauntlett pipes. It is not improbable, says the historian, that Decon might have learned the "whole art and mystery" of pipe-making from Gauntlett, and then have adopted his special mark with the addition of his own initials, as a coat of arms is differenced in heraldry. About eighty years ago, the pipe-makers there began to stamp their distinctive symbols upon the *stems* instead of the *spurs*.

§ 18. As a rule, trade-marks are optional in England and France, as well as in our own country; but there are exceptions in connection with various kinds of business. In England, an act of Parliament empowered the Goldsmiths' Company to call upon the manufacturers to bring all the articles made by them to their hall, for the purpose of being assayed and stamped with the hall-mark; but various exceptions from hall-stamping were sanctioned by law. In the same manner the Cutlers' Company, of Sheffield, were empowered to grant marks to persons carrying on any of the incorporated trades, with power of summary jurisdiction before two magistrates, to enforce such regulation. We perceive that extraordinary means have been required at all times to guard against the fraudulent use of marks of manufacture. The protection of innocent purchasers was the motive of legislation. Rogues dealt in the precious and useful wares then as now.

§ 19. The first instance on record of an attempt to reduce goldsmiths' work to a certain standard was in the reign of Henry III., A.D. 1238, when, in consequence of the frauds which had been practised by the gold and silver smiths, it became necessary to prescribe some regulation for their trade, because the mixing of too much alloy in the composition of their wares tended to encourage the melting down of the coin of the realm. A.D. 1300 (28 Edward I. c. 20), it was ordained that the precious metals be assayed; and further, that the articles be marked with the "leopard's head." By the goldsmiths' ordinance of the year 1336, three distinct marks are mentioned: 1. The goldsmith's mark, to wit, his initials; 2. The assay mark, probably a letter of the alphabet; and 3. The mark of the Goldsmiths' Hall, a leopard's head, crowned. A.D. 1379 (2 Richard II.), it was enacted by Parliament that every goldsmith should have his own proper mark upon his work, and the mark of the city or borough where it was assayed; and that, after the assay, the work should be stamped with another mark, to be appointed by the king. There were many subsequent statutes and ordinances upon the same subject, penal in their nature. Marks were obligatory as checks upon fraud. In 1739 (12 George II.) it was ordained that the manufacturers were to destroy their existing marks, which were the first two letters of their surnames, and to substitute the initials of their Christian names and surnames. The curious can find tables of all the marks recorded in Goldsmiths' Hall from the thirteenth to the nineteenth centuries; and also all the standard and assay stamps required by the French law of April 7th, 1838.¹

¹ See William Chaffer's book (London, 1872), entitled, "Hall-marks on Gold and Silver Plate," &c.

CHAPTER II.

Right to Protection. — Mutual Confidence the Bond of Union. — The Pirate an Enemy to Mankind in General. — Legislation on Subject vague until of late. — Increased Importance of Trade-marks. — Wrong of imitating Marks. — Foundation of Title. — Rests upon Natural Law. — Time required for perfecting Title to a Mark. — Who may acquire Title. — Qualification as to Traders. — Natural and Artificial Persons. — Protection. — Whose Rights are protected. — *Caveat emptor* and *caveat venditor*. — Basis of Protection of a Mark. — Judges differ in Opinion. — Deceit shall debar from Protection, as when word “patented” wrongfully used. — How to judge a Mark.

§ 20. Right to Protection. — The United States’ statutes promise “protection” to lawful trade-marks, upon certain conditions. In its ordinary acceptation, this word “protection” is sufficiently well understood. Its legal sense is not always so clear to the novice. Applicants for registration sometimes seem to think that a bit of ribbon and the official seal of the Patent Office possess a magical potency to ward off piracy, without requiring on their parts the slightest care or concern. In a recent case in the Patent Office, the proprietor of a registered trade-mark indignantly called attention to the fact that other persons were importing his class of goods, Havana cigars, and demanded the instant interposition of the government on his behalf. It was evident from his communications that he expected the Queen of the Antilles to be blockaded, and that an armed force should be maintained, on land and sea, to prevent any one from bringing in cigars like those to which he had affixed his mark. He said that he had paid his money for his certificate, and now he must be protected. He was in-

formed that the protection was not promised to be given in that way. Physical force was out of the question. He must look to the judicial branch of the government.

§ 21. *Alien Friends.*—In the courts of the United States, under the constitution and laws, foreigners are entitled, being alien friends, to the same protection of their rights as citizens.¹ And this does not depend upon reciprocity. “The cannibal of the Fejces may sue here in a penal action though having no courts at home for us to resort to.”² “But an alien is not now regarded the outside barbarian he is considered in China, and the struggle in all commercial countries for some centuries has been to enlarge his privileges and powers as to all matters of property and trade.” Says Woodbury, J.: “Comity and courtesy are due to all friendly strangers, rather than imposition and pillage. Taking their marks and using them, as, and for theirs, to their damage, is like preying on a visitor, or inhospitably plundering a wreck on shore.” It is a pity that the spirit of enlightened liberality does not exist in all civilized nations. In Luxembourg, foreigners not domiciliated have no action to recover damages for usurpation of marks and names.³ So in some other countries.

§ 22. The comity of nations demands that all kinds of commercial property be protected, no matter what may be the nationality of the suppliant for justice. The case of *Christofle & Co. v. Deleiderrier*,⁴ in the Tribunal of Commerce of Geneva, in 1859, shows that another nation may lay claim to enlightened liberality in this respect. It was substantially held that the name of a manufacturer, and his mark, are his property under the laws of nations. This doctrine has long been maintained by eminent jurists of France and Germany; and as the nations find it to be their best interests to throw down the barriers, it is fast approaching universal acknowledgment.

¹ Story and Sprague, JJ., 1844, *Taylor v. Carpenter*, 3 Story, 458. ² *Ibid.*

³ *Müller v. Haymann*: *Annales de la Propriété*, etc., tome v. p. 62.

⁴ *Annales de la Prop.*, tome vi. p. 29.

It is not governed by the same rules as analogous rights, like a copyright or a patent for an invention or discovery, for such property is held to be local in its character, as well as artificial, while a right to a distinctive emblem of one's individuality, as his signature or his mark, does not depend upon any thing beyond one's own will. He made it: it is his. So, it may be said, is a man's right to the children of his brain. True. But to them has never been applied the maxim, *Debitum et contractus sunt nullius loci*. They have not yet been brought into the domain of commerce. It is not regarded as piracy to steal such things from people of other nations, who are not protected by treaty. But whoever infringes a trade-mark in any part of the commercial world commits a tort, and the law should give redress.

§ 23. Although emphatically or tacitly admitting the justice of claimants' title as resting upon the law of nature, the legislatures and tribunals of some European States have stultified themselves by denying the right to protection. In 1841, the Tribunal of Commerce of the Seine, by two judgments, decided the principle that the commercial name of a merchant is a property that the laws of all countries should respect. Yet the plaintiffs, Messrs. Rowland & Son, of England, whose name as a mark for Macassar oil had been pirated, were eventually denied the aid of the court, because aliens.¹

§ 24. Mutual confidence is the bond of union between nations. It follows, therefore, that whoever weakens it is an enemy to all mankind. He becomes a pirate, and whether preying directly upon commerce on the high seas, or by knavery and trickery upon the land, he is regarded as a common foe, to be dealt with, when coming within the iron grasp of the law, with a just rigor. Mutual reliance must be the rule. Every act of trade by which operations to an almost boundless extent are daily transacted, is essentially founded upon confidence. By

¹ Annales de la Prop., tome i. p. 36.

the simple delivery of bits of paper bearing certain signs, millions of dollars are hourly transferred; and contracts of the greatest magnitude are made upon the description of a mark or name. Being a common enemy, the robber of his neighbor's honor or property is pursued by the accredited protectors of commerce. It has been well said that the degree of civilization to which a people has arrived follows exactly the degree of guaranty that the law of that people affords to property.¹ The eternal principles of justice have been recognized; but an armed neutrality has been maintained, at the risk of sapping the foundations of morality and self-respect. Harmony of action may soon come. Jobard, in 1851, enthusiastically entered upon the contemplation of this subject, as he welcomed the humanitarian palingenesis then preparing itself. Whilst deploring the state of things then existing, he indulged in a sad tone; but there is no doubt that the animadversions of such men as he greatly assisted in bringing about the desired change.

§ 25. Monsieur Jobard said that the age of shepherds succeeded the age of hunters, the age of cultivators that of shepherds, and we have entered upon the industrial age; but we enter thereon as foragers. We have free course, because the domain is still without hedges, without ditches, without enclosures; each encroaches on his neighbor, and hunts and kills him if he be the stronger; all means are good: trickery and theft, ambuscade and violence. It is a conquered country without laws, without rules, without magistrates, where capers the dishevelled anarchy that certain sophists decorate with the title of free competition, as certain others call robbery a just and courageous reclamation of the goods of his ancestors. After the lapse of twenty years, we see the bright dawn of a more hopeful day. Nearly all the states of Europe have combined to effectuate the desire of his heart. France itself has made more than thirty treaties and conventions on the subject

¹ Jobard, *Organon de la Propriété Intellectuelle*.

of the protection of the fruits of intellectual labor, and the enterprise of the manufacturer or merchant. Philosophers, moralists, jurisconsults, statesmen, political economists, — all have paid their tribute to this and kindred subjects, and now they see a clear horizon in the sphere of human activity, and behold the breaking down of the barriers of suicidal proscription.

§ 26. Legislation on this subject has until of late been vague, uncertain, incomplete. Jurisprudence, however, has resolved innumerable questions by the light of natural justice, the law written in men's consciences, that immutable code inscribed by the Great Legislator on the soul. France by her law of June 23d, 1857, England by the "Merchandise Marks Act" of 1862, and the United States by the law of July 8th, 1870, in relation to trade-marks, have concurred in recognizing the necessity for more adequate protection than that afforded by pre-existing statutes or the common law. The Austrian law of December 7th, 1858, that of Sardinia of March 12th, 1855, and the many treaties for the like purpose, all display the same spirit. Said an able writer¹ in France, in 1855: "The moment has now come for each state to prescribe in its legislation that the names and marks of manufacturers of its own nation or of foreigners shall be inviolable, and shall find equal protection before the tribunals." His dream has come true. Thanks to steam and electricity, which are annihilating distances, a noble and enlightened competition has been established. We are no longer in a time when each kind of commerce and of industry is centralized in one spot, in a city, or in a region. The new ideas of civilization now open to us the empire of Japan, and even the Flowery Kingdom has begun to smile upon outside barbarians. Verily, a trade-mark has become a thing of moment, for it spurns the thralldom of territorial limits.

§ 27. We may adopt the ideas of Professor Leone Levi,

¹ *Annales de la Prop.*, etc., tome i. p. 33.

F.S.A., &c., in speaking of the lofty position gained by British manufacturers. He spoke some years before legislation had assumed definite proportions in this regard. He said substantially that the British manufacturers are well alive to the demands upon their skill and energies, and we see them everywhere striving to rival all competitors, and to maintain untarnished the reputation they have gained. Their aim is to produce articles which for their price may be unequalled and unexcelled in this or any other country; and whenever they stamp such articles with their names, ciphers, or labels, they enter into solemn guaranties that the goods so marked shall invariably be of the quality represented. Their endeavor is to establish such an intimate relationship between the manufacturer and the manufacture, that in whatever market such goods may be exposed for sale, the same may be received with the most implicit faith and reliance. A mark on a manufacture is like the impress of the sovereign's coin, — a sufficient evidence, universally accredited, that the coin is of a specific rate and fineness. Why should it not be now as in former times, when the mark was not simply the signature of the merchant or manufacturer, but also a certificate of quantity, given by public authority, touching the quality of the produce, its origin, weight, &c. ? ¹

§ 28. Trade-marks are assuming increased importance from the fact that in Europe there is a growing tendency to abolish or greatly restrict the granting of patents for inventions and discoveries. This question of political economy has so far prevailed that in the empire of Germany, in Belgium, and in other countries, official inquiries are being made as to the working of the patent laws and their effect upon the general welfare, many statesmen and jurists believing that the system of monopolies, as they miscall it, has not met the expectations of the law-makers. In Holland, we

¹ Journal Soc. Arts, vol. vii. p. 262.

are informed, both legislative chambers have abolished the system entirely, the votes lacking but two voices of unanimity. Although such retrogression cannot be expected to occur in this developing country, with its myriads of ingenious artisans and earnest explorers of the inmost recesses of nature, minds intent upon releasing the human frame from the thralldom of drudgery, it is well to know what other nations think and do. It may be that in those countries labor is so cheap that human muscle and life rate with those of the beasts that perish. Be that as it may in regard to artificial property like patents, the rights of manufacturers and merchants rest on exterior signs, which have for an object to make known their industries and the products thereof. Lawful competition is open to all. All that is demanded is that encroachments upon the business-mark of another be prohibited. The Master of the Rolls, in *Croft v. Day*,¹ said: "The principle in these cases is this, that no one has a right to sell his own goods as the goods of another."

§ 29. The world-renowned Wedgwood produced many fine pieces of work, which only his master-hand could afterwards improve. He did not patent his inventions, but with a consciousness of his own superiority — which he ever maintained — he permitted all other potters to follow as nearly as they could in his footsteps. His trade-mark was ample protection, and indeed was more efficacious than any patent could be, unless we consider that he did possess an unencroachable patent, — that bestowed by excellence itself. By means of his symbol he secured a full reward for his industry, his toil, his genius. With the largest manufactory of china and queen's-ware in the known world, he could safely rely on this trade-mark to point out to the people of all countries the goods in which he so successfully combined the useful, the ornamental, and the ingenious.

¹ 7 Beav. 84.

§ 30. Imposition upon the Public, occasioned by one man selling his goods as the goods of another, cannot be the ground of private action or suit. This is a definitively-settled rule. We must not, however, dismiss this rule from further consideration until we are sure that we comprehend the scope of this brief enunciation. To speak more plainly, the mere fact of fraud upon the public will not induce a chancellor to interfere unless the plaintiff has sustained, or there is good reason to believe that he will sustain, pecuniary damages. Imposition on the public becomes the test of the property in a trade-mark having been invaded and injured, but it is not the ground on which the court rests its jurisdiction.¹

§ 31. The Lord Chancellor, in *Spottiswoode v. Clark*,² in 1846, said that "These cases depend so much upon their own circumstances, that all that the court can do is to lay down principles under which such cases may fall. I have before this had occasion to express an opinion, that, unless the case be very clear, it is the duty of the court to see that the legal right is ascertained before it exercises its equitable jurisdiction. For this there are good reasons. The title to relief depends upon a legal right, and the court only exercises its jurisdiction on the ground that that legal right is established. Our objection to granting an injunction, in the first instance, is, that it promotes after-litigation. The order either grants an injunction, and compels the plaintiff to bring his action, or suspends the injunction, with liberty to the plaintiff to bring his action. If you compel him to go to a court of law, you promote litigation; and this course is forced upon parties when their feelings are deeply engaged in prosecuting their imaginary rights. There is also another objection, which is, that the court expresses a strong opinion, and it ought to be a strong opinion, and then sends the right to be tried. I think it better that the court should abstain from expressing such an opinion. But, after

¹ Lord Chancellor, in *Leather Cloth case*, 11 Jur. (N.S.) 513.

² 10 Jur. 1043.

all, the chief objection is, that the court runs the risk of doing the greatest possible injustice.”

§ 32. When a person has adopted and used a particular mark, to indicate to those who deal with him that an article is manufactured or sold by him, or by his authority, others have no right, without his assent, with the view of deriving advantage from the same, to use such mark without change, or even with such colorable difference as is calculated to deceive the proprietor's customers, or the patrons of his trade or business. Such mark, when it has become known, is a species of property; and its owner will be protected against the attempt of others to appropriate to themselves, by its use, the benefit which such is entitled exclusively to enjoy. But there can be no harm done to the owner of which he has the right to complain, unless his trade-mark be appropriated without change, or unless it is simulated in such a manner as probably to mislead his customers, or the patrons of his trade or business, inducing them to suppose that in purchasing the article marked, they are purchasing that manufactured or sold by such owner.¹

§ 33. It is frequently a difficult matter to determine what is an infringement. The two marks, which are supposed by the plaintiff in a case to conflict, may resemble each other, and yet be different. The question then arises, Is the difference only colorable? No general rule can be laid down as to what is or what is not a mere colorable variation. All that can be done is to ascertain, in every case as it occurs, whether there is such a resemblance as to deceive a purchaser, using ordinary caution.² In the case of the Leather Companies, in the House of Lords, in which remarks as follows were made, it was further said by Lord Cranworth for the court that in that case the difference was so palpable that no one could be deceived. “In the first place, the shape is different. The plaintiffs' trade-mark, if trade-mark it is to be called, is contained in a circle. The design of the defendants is a

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

² Lord Cranworth, 11 Jur. (N.S.) 513.

semicircle mounted on a parallelogram. It is said that the defendants' goods may be so rolled as to expose only the semicircle, and so lead to the belief that the device, in its integrity, is a circle. There might, however, be some force in the observation if the upper half were the same as, or even if it closely resembled, the upper half of the plaintiffs' device. But this is not so. The name of the company is different. The word 'Crockett' is prominently exhibited twice in the plaintiffs' upper half, not once in the defendants'. No one taking the trouble to read the two can say that he would be deceived."

§ 34. The ownership is allowed, that one may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public, as his, that which is not his. An imitation of his mark, with part differences, such as the public would not observe, does him the same harm as an entire counterfeit. If the wholesale buyer, who is most conversant with the mark, is not misled, but the small retailer or consumer is, the injury is the same in law, and differs only in degree. The right of action must exist for the last, as well as the first. If all consumers do not discriminate in the end, it would be indifferent, even to the wholesale buyers, from which of two they bought, and thus the extent of the injury would be as great as if they also were deceived.

§ 35. The question is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he now puts his trade-mark, or whether the article made and sold by the defendant under the complainant's trade-mark is an article of the same quality or value. But the court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade or business; and that having appropriated to himself a particular sign or mark, indicating to those who wish to give him their patronage that the article is manufactured and sold by him, or by his authority, or that he carries on business at a particular place,

he is entitled to protection against a defendant who attempts to pirate upon the good-will of the complainants' friends or customers, or the patrons of his trade or business, by sailing under his flag, without his authority or consent.¹

§ 36. **The Public should be protected.** — Mr. Justice Duer, in his very able opinion in the case of the *Amoskeag Manuf. Co. v. Spear*,² enunciated as one ground for protection the benefit to the public at large. The plaintiff's trade-mark is an assurance to the public of the quality of the goods, and the pledge of his own integrity in their manufacture and sale. To protect him, therefore, in the exclusive use of the mark that he appropriates, is not only the evident duty of a court, as an act of justice, but the interests of the public, as well as of individuals, require that the necessary protection should be given. Brady, J., in *Matsell v. Flanagan*,³ said that the enforcement of the doctrine that trade-marks shall not be simulated, does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle that the public are entitled to protection from the use of previously-appropriated names or symbols, in such manner as may deceive them, by inducing to the purchase of one thing for another. He took the extreme ground that it is not necessary to the exercise of judicial powers that the plaintiff should have any other property in the name used than that possessed by other persons. He said that there is neither honesty nor honorable competition in adopting, for a similar purpose, a name used by another, if it be employed in such a manner that the public may be imposed upon; and such a result must follow if the simulation be so successful that one article or creation is purchased or accepted for another. He regarded those principles as established by the adjudged cases of both England and this country. Robertson, C. J., in *Swift v. Dey*,⁴ — which was a controversy in

¹ Chancellor Walworth, *Partridge v. Menck*, *supra*.

² 2 Sand. S. C. 599.

³ 2 Abb. Pr. R. (N.S.) 459.

⁴ 4 Robertson, 611.

regard to a trade-mark on match-boxes, — said that is eminently a question of fact, to be submitted to the practical experience of a jury, whether in a particular case a resemblance was likely to deceive the community. There is no article of more general consumption, less value, or more frequently bought by ignorant or careless purchasers, than friction-matches; none, perhaps, where their degrees of excellence are more widely apart. In such a case, the general appearance of whatever is adopted as a trade-mark must control; because it is the unwary, and not the wary, who are to be protected, as most likely to be taken in by its counterfeits. Bosworth, J., in *Gillott v. Kettle*,¹ said that the fraud complained of consists in selling an inferior article of the plaintiff's manufacture as being one of a superior quality. The fraud, to the extent that it may be successful, is twofold: the public is defrauded by being induced to buy the inferior for the superior article; the plaintiff is defrauded by an unjust destruction of confidence that his pens are put up for sale, and assorted, with reference to the quality, indicated to dealers by the labels on the boxes which contain them. By such a practice the defendant *endeavors* by a false representation to effect a dishonest purpose: he commits a fraud upon the public and upon the manufacturer. The purchaser has imposed upon him an article that he never meant to buy, and the manufacturer is robbed of the fruits of the reputation that he had successfully labored to earn. In such a case, there is a fraud coupled with damage; and a court of equity, in refusing to restrain the wrong-doer by injunction, would violate the principles upon which a large portion of its jurisdiction is founded, and abjure the exercise of its most important functions, — the suppression of fraud and the prevention of a mischief that otherwise may prove to be irreparable. This language — which has the ring of the true metal — is substantially that of Duer, J., of the same court, in the *Amoskeag*

¹ 3 Duer, 624.

case.¹ Fraud and damage resulting therefrom always entitle the injured party to relief; provided, of course, that he come into court with clean hands. The public, as an innocent party, — for a party it must be considered, although not directly on the record, — should be sedulously guarded by the action of the tribunal which holds the culprit within its grasp. Duer, J., in the *Amoskeag* case, said, that it is the evident duty of a court as an act of justice, and the interests of the public as well as of the individual purchasers require, that the trade-mark be protected. This does not operate as an injurious restraint upon the freedom of trade. Its direct tendency is to produce and encourage a competition, by which the interests of the public are sure to be promoted, — a competition that stimulates effort, and leads to excellence, from the certainty of an adequate reward. Vice-Chancellor Sandford, in *Coats v. Holbrook*,² laid considerable stress upon the duty of protecting the public as well as the complainant from the consequence of barefaced roguery; and Story, J., in *Taylor & Carpenter*,³ was no less emphatic; and Sandford, Ch., in *Snowden v. Noah*,⁴ said that the injury for which redress is given in such cases results from the imposture practised upon the customers of an existing establishment, or upon the public. But we need not multiply instances to prove that courts will habitually regard the interests of the public at large, in acting upon particular cases, or applying the rules of justice to an individual wrong-doer.

§ 37. In the *Dixon Crucible Co. v. Guggenheim*⁵ case, Paxson, J., remarked that “the jurisdiction of chancery in trade-mark cases attaches because of the injury to the one whose goods are simulated, by interference with his profits, not because of the deception upon the public. The fraud upon the public will not induce a chancellor to interfere, unless the plaintiff has sustained, or there is good reason to believe he will sustain, pecuniary damages.”

¹ 2 Sand. S. C. 606.

² 2 Sand. Ch. R. 586.

³ 3 Story, 458.

⁴ Hopkins, Ch. R. 347.

⁵ 2 Brewster, 321.

§ 38. In *Comstock v. White*,¹ Sutherland, J., said, on the other hand, on a motion to dissolve an injunction: "As to the public, if these pills are an innocent humbug, by which both parties are trying to make money, I doubt whether it is my duty, on those questions of 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." It did not appear that the pills were positively injurious. Hoffman, J., in *Fetridge v. Merchant*,² said the question of fraud by means of a false mark should be judged of solely as between the immediate parties, and that the public should be left to its own guardianship.

§ 39. James, J., in the case of the *Congress and Empire Spring Co. v. High Rock Congress Spring Co.*,³ said that the doctrine of protection to trade-marks is now well established. The principle which underlies the doctrine is, that he who by his skill, industry, or enterprise has produced or brought into market or service some commodity or article of use, convenience, utility, or accommodation, and affixed to it a name, mark, device, or symbol, *which serves to designate it as his*, is entitled to be protected in that designation from encroachment, so that he may have the benefit of his skill, industry, or enterprise, and the public be protected from the fraud of imitators.

§ 40. An able French writer⁴ remarks that it is clear that the fabricant who by the superiority of his products, or by the cleverness of his manufactures, has acquired a merited renown, has a great object in investing with his mark articles of his make, to the end that such mark, which certifies them to the preference of the public, may thus secure an assurance and facility of sale. It is clear that he who sees his mark sought for by the public, finds, in his own interest, strong reasons to

¹ 18 How. Pr. R. 421.

² 4 Abb. Pr. R. 156.

³ 57 Barb. 526; 4 Am. Law Times R. (St.) 168.

⁴ Annales de la Prop., tome iv. pp. 19, 20.

make incessant efforts of intelligence, and of obedience to law, to conserve to himself the preference accorded to him. It is manifest, also, that the example of marks honored, eagerly looked for in commerce, and becoming for their possessors a source of fortune, is for others a powerful incitement to walk in the same path. But on what condition shall industry really find such signal advantages? On the condition that such marks shall be truly and efficaciously protected by the law; that the manufacturer shall find entire security in the use which he shall make of his mark; and finally, that he shall receive from the law sufficient guaranties for reclamation against the counterfeiter.

§ 41. In the House of Lords,¹ in 1865, Lord Kingsdown said: "The fundamental rule is, that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot, therefore, in the language of Lord Langdale in the case of *Perry v. Truefitt*, 'be allowed to use names, marks, letters, or other *indicia*, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.' A man may mark his own manufacture, either by his name, or by using for the purpose any symbol or emblem, however unmeaning in itself; and if such symbol or emblem comes by use to be recognized in trade as the mark of the goods of a particular person, no other trader has a right to stamp it upon his goods of a similar description. That is what I apprehend is usually meant by a trade-mark, just as the broad arrow has been adopted to mark government stores; a mark having no meaning in itself, but adopted by and appropriated to the government."

§ 42. **Wherein consists the Wrong in using the Trade-mark of Another.** — It is not in imitating a symbol, device, or fancy name, for in such act may not be involved the slightest turpitude. The wrong consists in unfair means to obtain from a person the fruits of his own ingenuity or industry, an injus-

¹ *The Leather Cloth Co. v. The Amer. Leather Cloth Co.*, 11 Jur. (N.S.) 513.

tice that is in direct transgression of that command of the Decalogue: "Thou shalt not covet . . . any thing that is thy neighbor's." The most detestable kind of fraud underlies the filching of another's good name in connection with trafficking.

§ 43. A perfect system of trade-marks is ascribed by Jobard to the Chinese. They excel in this institution of commercial guaranty; for nearly all the goods exported from China are enclosed in boxes hermetically fastened by paper bands, and have upon them the mark of the makers. Every thing is stamped and indorsed with the firm and title of the furnisher, who is responsible for the quality of the contents of the packages bearing his name. A cargo of tea arrived one day from Canton at London, when it was found that the boxes were filled with nothing but rice-straw. The vessel and cargo were immediately sent back to China; the Hongs were speedily assembled, and recognized each their own marks. It was ascertained on examination that the adroit thieves, who had been employed to convey the tea from the warehouses to the ship, had slipped off with the chests to an island, and had there opened them, and for their precious contents had substituted packages of rice-straw. To preserve their commercial reputation, the Chinese merchants gladly made good the loss.

§ 44. In connection with patents and some other kinds of property, resemblance may be the result of accident, or of an honest difference of opinion; but in conflicts arising out of the invasion of proprietary marks, resemblance may generally be traced to meanness and cupidity. Truly did Senator Lott say in one case: ¹ "A disguise is not generally assumed for an honest object. It is a mark more characteristic of deception and fraud. It defeats the very end and object contemplated by legitimate competitors, — the choice to the public to select between the articles for sale, — and operates as a deception and imposition on the dealer." He might have

¹ 11 Paige, 292.

further said that nearly always it is a witness against him who uses it.

§ 45. **Foundation of Title.**— Having satisfied our mind that the conventional sign of trade has a history, and an acknowledged right to protection, we next inquire upon what laws does the claim to property in it rest. How does the owner of a trade-mark obtain his exclusive right to its use in a particular manner, *i.e.*, in connection with certain articles of merchandise? Is it by act of law, vesting in him the sole right of user, or is it by mere volition? Let us attempt to answer.

§ 46. The right to a trade-mark is neither tangible nor visible, though the thing produced from the right is perfectly so. The subject-matter is not the symbol, but the exclusive privilege of continually using the same to impress or otherwise mark articles of merchandise, so that purchasers may instantly know the origin of such articles. Just as a person may by his autograph indicate his workmanship, or his ownership, so may he by any other sign as a substitute therefor do the same. The right to write one's name on a piece of personal property is a natural right; so, therefore, must be the right to use its substitute, any other emblem. This right is founded upon possession: and his possession rests upon the mere act of adoption and use; for, in contemplation of law, without use there is no adoption. That this is the true doctrine we may easily convince ourselves by reference to judicial decisions.

§ 47. Rhodes, J., in delivering the opinion of the Supreme Court of California in *Derringer v. Plate*,¹ in 1865, said: "The right of property does not in any manner depend for its inceptive existence or support upon statutory law, although its enjoyment may be better secured and guarded, and infringements upon the rights of the proprietor may be more effectually prevented or redressed by the aid of the statute than at common law. Its exercise may be limited or con-

¹ 29 Cal. 292.

trolled by statute, as in case of other property; but, like the title to the good-will of a trade, which it in some respects resembles, the right of property in a trade-mark accrues without the aid of the statute." The learned judge was discussing a local statute of his State, but the principle is quite as broad as he stated it. He further said that "the proprietor may assert and maintain his property-right wherever the common law affords remedies for wrongs." He might have put it more strongly, and have said that the right to the exclusive use of a man's commercial signature, or its analogue, the trade-mark, exists throughout the world. It is true that a remedy is not always promptly accorded, owing to the narrow jealousies of various nations in affording undue protection to their own manufactures and commerce; but the *right* is recognized. A foreigner's property in a promissory note, or any other kind of personal property, may be admitted; but the courts are shut to him as an alien, non-domiciliated. In this illiberal spirit some European nations have striven to extort reciprocity and privileges for their own citizens or subjects. Nevertheless, their conduct cannot affect the natural right.

§ 48. In the Court of Paris, in 1863 (*Aubertin v. Vix et al.*¹), the court held the same doctrine, and said: The deposit of a mark of commerce is not necessary to acquire, and even conserve, the property of the mark; although the deposit is indispensable to enable one under the law of the 27th of June, 1857, to obtain the special guaranties which it institutes, and of the actions which it organizes. The same court, the next year, recognized the same doctrine, in *Stubs v. Astier et als.*;² and the Court of Cassation, by its final judgment on appeal, effectually shut the door in the face of confessedly just claims, for the reason of alienage alone.

§ 49. The Court of Cassation, in 1864 (*Leroy v. Calmel*³), held that the deposit does not constitute the exclusive right to the property of the mark; that deposit is necessary only for

¹ *Annales de la Prop.*, etc., tome xi. p. 344.

² *Ibid.*, tome x. p. 212.

³ *Ibid.*, tome x. p. 193.

the purpose of enabling the proprietor to sue for damages for infringement; and that it was necessary to search whether the mark in controversy did not exist at a period anterior to that of deposit. Nothing can be plainer than this enunciation of the supreme court of France. The right to a thing may be perfect; but the right to claim reparation for an encroachment upon that right may not have any foundation!

§ 50. The Court of Paris, in 1867, in *Sargent v. Romeu*,¹ said that in ancient legislation as well as in the new, the legal deposit of marks was simply declarative, and not attributive; consequently, a deposit merely creates a presumption of proprietorship. In the same court, in 1868 (*Holtzer & Co. v. Lendenberg & Co.*²), it appeared that the plaintiffs, proprietors of certain steel-works in France, had ever since the year 1834 been using as a trade-mark the figure of a bell, and their products became known under the name *aciers à la cloche* (bell-steel), and acquired a reputation for superiority. After the treaty of 1862, between France and the Zollverein, the Prussian manufacturers, Lendenberg & Co., established a warehouse in Paris, near that of Holtzer & Co., and their wares were also marked with a bell. Holtzer & Co. sued them for infringement of their trade-mark. The Prussian house thereupon established the fact that ever since 1817 they had marked their products with the same device, and invoked on their behalf the benefit of the treaty aforementioned. They did not rest their claim to the exclusive right of user upon aught but possession. It was held that by virtue of the said treaty they had a right to prove their priority; and the court awarded them 300 francs as damages, and condemned the defendants to pay all the costs. The case was thereupon appealed. The appellants' counsel argued, *inter alia*, that the respondents' firm had not enjoyed any reputation in France until very recently; that it was not shown that their firm was established in France until after the date of the treaty; that therefore their title should not be per-

¹ *Annales de la Prop.*, etc., tome xiii. p. 21.

² *Ibid.*, tome xiv. p. 167.

mitted to conflict with one that had a recognized popularity ever since 1834; and that, in fact, their manufactures were inferior in quality to those of the appellants, as was shown at the Great Exposition, where they got nothing, while Holtzer & Co. received a gold medal. The respondents' counsel argued that they were the seniors in their line of business; that the possession of their mark had constantly been maintained in Germany, and was proven by all the documents that could possibly be procured in a country where property in emblematic marks was not regulated by law; that their possession was established as far back as 1817; and that their long user was conclusive, the act of deposit not being declarative of property, and not attributive of a new right. He further claimed judgment, irrespective of the said treaty, by the French law of 1857 (the sixth article of which provides that a foreigner whose establishment is outside of France, is admitted to enjoy the benefit of the law of deposit, if in the country where his establishment is situate diplomatic conventions had arranged reciprocity for Frenchmen). Concerning trade-marks the treaty says that "the subjects of each of the contracting states shall respectively enjoy in the other the same protection as the natives thereof." Therefore, Lendenberg & Co. had a right to invoke the protection of the French laws, the same as if they were French themselves; that by the law of 1857 the deposit of a trade-mark is not attributive, but simply declarative of property in that mark; that, in other words, the ownership of a trade-mark did not depend upon deposit, but that property existed independent of any species of deposit, although by not depositing one ran the risk of a use by others. Finally, Lendenberg & Co. had a pre-existing right: the treaty gave a remedy. The court concurred in these views as matters of law.

§ 51. The question thus raised was assuredly one of a most delicate and difficult nature, involving the effect of a treaty, affecting the rights of citizens of another country to

a mark long used, and to which up to the time of the treaty they had the sole right of protection. But for our present purpose, it is necessary only to cite it as authority for saying that a trade-mark is not the creature of arbitrary law. That point has been affirmed in other French cases, and may be said to be definitively settled. And this is the recognized law of all civilized nations. The Tribunal of Commerce of Geneva, in 1859 (*Christofle & Co. v. Deleiderrier*¹), held that a manufacturer's mark is property under the law of nations; and other nations by their judicial decisions have repeatedly affirmed the same doctrine, one founded upon sound reason. Thus, in 1855,² the tribunal of Brussels held that a Frenchman, domiciled in Paris, might in a Belgian court pursue an infringer of his mark, although the plaintiff had no treaty to stand upon, and based his claim to his mark upon the law of natural justice.

§ 52. **What Time is required for the Perfection of Title.**— That is, how long does it take to adopt it? The answer is obviously this: The moment one who has selected a symbol to indicate his merchandise applies the mark to his goods, the act is complete. The avowal of his intention to adopt, his registration of the mark, and notice to the whole world, do not constitute adoption; but apply the mark to the articles for sale, and, *eo instanti*, the act is complete. In *McAndrew v. Bassett*,³ the right of the plaintiff was disputed because of his recent appropriation of the symbol to stamp his liquorice, just as a claim based upon mere prescription might be challenged. The Lord Chancellor said that he had been much pressed by the defendants' counsel to declare that there was not sufficient time between the termination of the month of July and the 13th of September following for the plaintiffs to acquire a right of property in the particular trade-mark. The substance of the argument of defendants is this: that, supposing the court interfere upon the ground of property in a trade-mark, that

¹ *Annales de la Prop.*, etc., tome vi. p. 29.

² *Ibid.*, tome i. p. 45.

³ 10 *Jur.* (N.S.) 550.

property must be regarded as the offspring of such an antecedent user as will be sufficient to have acquired for the article stamped general notoriety and reputation in the market, and that the property cannot be held to exist until the fact of the general user, that notoriety and that public reputation have been proved to exist. The plaintiffs won.

§ 53. **Who may acquire Property in a Trade-mark.** — As a general proposition, any person who, in law, is capable of acquiring and holding any species of property, may hold a title to a trade-mark.

§ 54. Yet this sweeping assertion must be subjected to some qualification ; for unless the person be a trader, that is, unless he or she be engaged in mercantile business of some kind, such a title could not be acquired, as we shall hereafter more clearly see. The reason of such a condition is this: the object selected as a trade-mark does not become such by the mere act of selection. Something more is requisite to perfect an act of adoption. What is that something ? It is the union of the abstract representation of the object with a vendible commodity. Instantly the inchoate right becomes perfect, and title rests in the appropriator.

§ 55. But we shall see that certain persons cannot become traders, and consequently cannot place themselves in a position to obtain such a title. Take as an extreme hypothesis the case of the person holding the office of Archbishop of Canterbury. He could not become possessed of a title to a trade-mark, for the law inhibits him from engaging in secular pursuits of a mercantile nature. A corporation is an artificial person, and under an act of Congress of July 8, 1870, the right of a corporation to a trade-mark is distinctly recognized. But, when we come to consider the provisions of that act, we shall be easily convinced that it is not every corporation that can avail itself of the protection promised thereby. Why ? Because the corporation may not be a trading corporation. For instance, a rector of a parish in Massachusetts, New York,

Maryland, and other States where the Church of England once held legal sway, is a corporation sole. Yet no sane person would dream of such a corporation, or any other of a purely ecclesiastical nature, manufacturing or selling goods.

§ 56. Nor can every natural person hold title in a trade-mark; for some persons are under interdict, — are felons under sentence of death, or are not of sound mind. This phase we shall also more fully investigate hereafter.

§ 57. The conditions upon which a right can be enjoyed and guaranteed are few and simple. Be he citizen or alien, the owner has protection provided he is engaged in lawful business, conducted with sincerity.

§ 58. **Who is an Infringer.** — He who imitates in whole or in part the peculiar emblem or mark to which another has the right of exclusive use. *provided* he use it to indicate the same class of goods. The imitator may be the pirate himself, or he may be an innocent vendor of the article bearing the mark. Both are in intendment of law infringers, although the one may be guilty of gross roguery and the other be free from the imputation of turpitude. The law will correct the illegal act of either, but will deal more leniently with the unintentional trespasser.

§ 59. So similar in external appearance are different articles of merchandise, that, without peculiar indication of some kind, one would be in uncertainty. Some pledge of integrity is demanded. We see a curious mark: it is enough — it conveys to the mind full assurance of excellence, or what we are happy in believing to be such. Some such guaranty is required in these days when traffic moves swiftly, in harmony with agencies of steam and electricity. A glance! It is enough. Down goes the cash, and the change is effected. But what if the signal with its blazon of truth be false! Confidence is outraged, — and that is a thousand-fold worse than the immediate loss of money, for a scar of suspicion is left. Severe measures must be enforced to restrain the commission of crime which

has no small resemblance to that of wretches who display false signal-lights. Avarice and treachery! Piracy must be restrained by the iron grasp of justice, that laudable industry may flourish, and competition, the life of trade, be stimulated to ever-fresh efforts for excellence. An adequate security and protection may be found in the extension of the powers of courts of justice in the endeavor to uphold a high mercantile morality. In this there is no restraint of the freedom of trade, no fostering of monopolies. Each man stands upon his own merits, just as a knight at a tourney has his own color to identify him with valor and high emprise. Infamy would await the base dastard who took the pennon not belonging to him. So should it be in the mammoth contest for the well-earned meed of honorable and laborious enterprise.

§ 60. **Protection.** — What avails a mere naked title to any thing, unless the law protect it! Any man may copy an emblem or a mere representation of an object, — no matter whether it be of the rudest character or whether it be delineated with all the grace and beauty of accomplished art, — unless the exclusive property in it be secured by local law in another person. We say *local*, for a right to exclusively make and sell a representation of an object, or a fanciful picture, or other mark of taste, rests upon nothing more extensive than the laws of the country which has invested it with the ægis of defence. One nation does not respect the defensive law of another in respect to such work of art, unless bound to do so by a treaty or compact. The people of one country, then, may with impunity prey upon the people of any other in respect to works of genius, unless, upon the condition of reciprocity, mutual forbearance shall have been stipulated. This reflection begets an idea!

§ 61. It is not the act of *imitating* that is unlawful in regard to a trade-sign or mark. Then what is the wrongful act? It is this: the placing of that mark upon vendible goods, for the purpose of fraud. For *fraud*, actual or constructive. Of this

species of cheating, furtive and mean, the honest, the confiding, are the victims. But then the law protects the innocent against fraud? Yes! Now we perceive that fraud is the basis of the law's intervention: that kind of fraud which a person practises when he writes or paints or stamps or brands a certain sign upon articles for sale, with the design that the public shall take them to be the manufacture of some person else, or to have emanated from some place which is not the true one. This is a matter of property. A trader's business fails because another trader has illicitly copied his mark of honest dealing. He loses what should come to him as just profits, and the purchaser is deceived into paying for a false article. A double wrong is done. Unless the law intervene to preserve the credit of the mark, all faith in its integrity shall soon be destroyed. Commerce is wounded. Real tangible rights are struck at: money is lost. That in the eye of the law, as administered, is a greater wrong than to kidnap and sell the children of another's brain. *Property* has been despoiled, and that by the simple act of causing a certain symbol to utter a falsehood. Property must be protected.

§ 62. **Whose Rights are protected?** — Those of the manufacturer or merchant who has lost his just profits, or of him who has been cajoled out of his money? or both? We must examine into the theory of protection; for upon a right understanding of it frequently depends the possibility of redress.

§ 63. When we look at the case in *Cro. Jac.*,¹ we find that, for an imitation of a mark placed upon cloth, an action upon the case was brought *by him who bought the cloth*, for deceit, which action was adjudged to be maintainable. In *Southern v. How*,² which is believed to be the same case, a different version is given. In Comyn's Digest, "Action on the case for deceit," A. g., the case is thus cited: "So" (*i.e.*, an action will lie) "if a clothier sell bad cloths upon which he put *the mark* of another who made good cloths." Comyn does not say

¹ Cited by Upton, p. 10.

² 2 Popham, 144.

by whom the action may be maintained; but as he cites Cro. Jac. only, it may be inferred that he considered the case as establishing the right in the *purchaser*, which it certainly would, if that report is correct. In *Southern v. How* the case is certainly cited as a distinct affirmance of the right of a manufacturer to maintain an action for an unauthorized use of his trade-mark. Lord Rolle, however, expressly states that “Doderidge did not *say* whether the action was brought by the clothier or by the vendee;” but he adds, “semble que gist pur le vendee” (2 Roll. 28). Therefore, if we depend upon the old books, we are left in doubt as to who is the protected party. But, fortunately, the question may be said to be settled in these days; although in the minds of some chancellors there is a lingering doubt whether the public have any right to protection in such a case.

§ 64. We may safely assume that it is the moral, if not the legal, duty of a court to protect the public against fraud, perpetrated by means of false tokens. The maxim quoted by Lord Cranworth in the case of the Leather Companies¹ — “Vigilantibus non dormientibus leges subveniunt” — is not always approved doctrine; for not only the watchful but the careless should be guarded against wily craft and cunning. The morals of a nation are like those of an individual: they must be guarded by the supervising power, whatever that may be. In this matter it is the court of justice trying the question of infringement upon a mark of trade. The law of gravitation seems to operate in morals as in physics; there is an increased momentum at every stage of descent. Of this we have had melancholy proof in recent developments in some portions of our country, where corruption soiled even the ermine of the judge. When we read of excessive stickling for legality, we are apt to suspect that moral obligations have not due weight. When a rogue stands convicted of his offence, why not punish him to the extent of his merits? In trade-mark

¹ 11 Jur. (n.s.) p. 513.

cases there is a great laxity ; as if the community at large had no interest in the upholding of mercantile honor. Spasmodic pretences to severity do not help the matter. Let punishment be sure, like the bodily pain which follows every excess as a manifestation of Divine will, and fraud must decrease. Whether by corporal pain or pecuniary mulct, the effect would be beneficent. The law should protect the weak and the simple.¹ Is the child or the illiterate clown to be plundered at the will of any charlatan or knave? Is the law to lend its aid only to the vigilant, who require it not? It must be that the exponents of justice have sometimes, by mistaking the intent of the law, become false oracles. If the reasoning sometimes used is good in one case, then why not in another? If the confiding purchaser of wares may be cheated with impunity, why not also suffer the pickpocket to ply his craft unmolested against the youthful, the thoughtless, the unsuspecting? Would it be a good defence for a vendor of brass watches bearing the mark of the American, the Elgin, or any other reputable watch company, to plead that prudent examination would have detected the fraud? Verily not. Does one prudent person in a thousand keenly scrutinize each article he buys? What percentage of ordinarily cautious persons closely examine the printed national currency, to see that it bears all its legitimate marks? We come to the conclusion that the rule of *caveat emptor* should be changed into *caveat venditor*, demanding sincerity in the seller, rather than extreme caution in the purchaser.

§ 65. There seems to be a contrariety of opinion among judges, both in law and equity, as to the real principle upon which is founded the duty of judicial intervention. Some judges, remarkable for probity in private life, appear to permit the ermine to stifle sentiments of the nobler morality, and to deal with the rigid letter of the law, rather than with its equitable spirit. They base their action entirely upon the legal

¹ See opinion of Kindersley, V. C., in *Glenny v. Smith*, 11 Jur. (N.S.) 964.

right of the party complainant, and treat as a matter of little or no consequence the fact that the public at large have some right to protection. Conceding that a court cannot go outside of the immediate case presented, is it not true that the rights of the public may be guarded and vindicated by holding the simulator of trade-marks to a rigid responsibility? Woodbury, J., in one case,¹ uttered the true doctrine: "To elevate our own character as a nation, and the purity of our judicial tribunals, it seems to me we ought to go as far in the redress and punishment of these deceptions as can be vindicated on any sound principle." Robertson, J., in the case of *Corwin v. Daly*,² said that "the origin of the favor shown to trade-marks was the protection of the public, and not merely of the individual dealer;" and in speaking of the scope or design of a bill in chancery, invoking protection for honest trade, Lott, Senator, said: "Its object is to prevent the commission of a fraud not only on them and to the prejudice of their rights, but on the public, by the sale of an article with an imitation of their trade-mark thereon in such a manner as to deceive purchasers, and through the false representations thus held out, to deprive the owners thereof of the profits of their skill and enterprise. Honest competition relies only on the intrinsic merit of the article brought into the market, and does not require a resort to a false or fraudulent device or token."³ "It is undoubtedly the duty of courts to regard with disfavor every establishment having any tendency to corrupt the public morals, to create idle or dissipated habits, to encourage a craving for undue excitement, or to impair the taste for domestic attachments and domestic society," said another judge.⁴

§ 66. **Class of Goods.** — Protection will not be given unless in connection with the *class of goods* to which the mark has been applied. Vice-Chancellor Wood,⁵ in 1865, remarked that

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

² 7 Bos. 222.

³ *Taylor v. Carpenter*, N. Y. Ct. of Errors, 11 Paige, 292.

⁴ *Christy v. Murphy*, 12 How. Pr. R. 77.

⁵ *Ainsworth v. Walmesley*, 44 L. J. R. 252.

the court had taken on itself to protect a man in the use of a trade-mark as applied to a particular description of article. "He has no property in that mark, *per se*, any more than a person has in any fanciful denomination which he may assume for his own particular use, without reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and when he has caused his goods to circulate with that mark, when that mark has become the known *indicium* of their being his, the court has said that nobody shall defraud him by using that mark and passing off the goods of another's manufacture as being the goods of the owner of the mark."

§ 67. As the first adopter of a mark does not acquire any exclusive right to its use, except in connection with the specific class to which he has applied it, it is not uncommon for the same mark to be placed upon different classes by different owners. The word "MAGNOLIA" may properly serve to indicate a certain manufacture of *gin* for one proprietor,¹ and a certain brand of *whiskey* for another;² for although both contain a large proportion of alcohol, the fluids cannot be said to belong to the same class; and the fanciful appellation of "BISMARCK" may in compliment to the statesman be used for *cement*,³ notwithstanding the fact that another had previously appropriated it for *paper collars*.⁴

§ 68. The importance of a specific mention of the class of merchandise to which a certain emblem is to be attached as a trade-mark, may be illustrated by the letters "I X L" (*I excel*). To guard against looseness in practice, the statute requires that the class, "and the particular description of goods comprised in such class," shall be set forth in the application.

¹ C. & W. A. Waters, No. 544.

² Mills, Johnson, & Co., No. 241.

³ Wendt & Rammelsberg, No. 585.

⁴ *Messerole v. Tynberg*, 4 Abb. Pr. R. (n.s.) 410, and 36 How. Pr. R. 14.

Time out of mind, the manufacturing establishment of Wostenholm, in England, has used the letters I X L upon cutlery. The exclusive right to the use of that symbol had at common law become vested in that firm, — so far as it was actually stamped upon certain articles. It could properly have been appropriated for marking all kinds of cutlery, fine and common, large and small. The mark was known all over the world, and by it was understood that the house of Wostenholm had manufactured the steel fabrics thus stamped. The Examiner was well aware of the existence of that mark, and recognized its import. It was his duty to refuse registration to any one else who claimed property in that mark, as applied to the particular class of goods made and so marked by the English house. It did not matter that no official notice of the use of the mark in a foreign country had been filed. It was enough that a claimant must have been the prior adopter of it.

§ 69. An American firm, doing business at Evansville, Ind., applied for registration of that mark for a *chopping-axe*. They did not pretend to have adopted the symbol before the year 1870, many years after it had acquired a universal reputation through the English firm of Wostenholm. *Held*, chopping-axes are not included in the particular class of goods in which the Wostenholms used the mark. Registration allowed.¹

§ 70. In January, 1872, Wostenholm & Son, of England, filed an application for the registration of the said symbol, "I X L," as a trade-mark for *cutlery*. They set forth the long term of years during which their firm had used it for the same purpose. The certificate of registry was duly issued.² In March, 1872, a manufacturing company in Hartford, Conn., filed an application for a mark, newly adopted, of which the said symbol is the essential part. It was to be applied to scythes. The case was suspended until evidence was furnished that the English firm of Wostenholm did not make scythes. The adoption by the Hartford company was

¹ Boetticher, Kellogg, & Co., No. 83. ² Wostenholm & Son, No. 666.

therefore lawful, and the mark was registered for the third time.¹

§ 71. **A Lack of Truth** debars a trade-mark from protection. The tale told by the symbol must be sincere. The instant it ceases to be truthful, in spirit as well as in letter, it becomes an instrument of fraud, and is not lawful. A qualification, true in itself, may become fraudulent by the manner in which it is used. In a case before the Tribunal of Correction of Thionville,² in 1865, it was *held*, where a French gunmaker establishes himself and his manufactory in a foreign country, and places his name on his products as “of Paris,” although really a Parisian, it is bad faith in him. His intention was evidently to cause purchasers to believe that he was the person of that name, who carried on business in that city. When his merchandise was brought into France to compete with honest goods, his deception was sufficient authority for confiscating it.

§ 72. **An Untrue Use of the word “Patented,”** or its equivalent. If a trade-mark represents an article as protected by a patent, when in fact it is not patented, such a statement *primâ facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the mark to relief in a court of equity against a pirate.³ That is clearly so when the pretended patent had never existed.⁴ In the case of *Edelston v. Vick*,⁵ Vice-Chancellor Wood intimated a doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade-mark being true when first introduced, had been continued after it had ceased to be true. Lord Kingsdown, in the *Leather Cloth* case, declined to assent to that distinction. He thought that if the word “patent” be not so used as to indicate the existing protection of a

¹ Greenwoods Scythe Co., No. 788.

² Ministère Public et Bernard *v.* Compagnie de l'Est, Ann. de la Prop. tome xi. p. 202.

³ *Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 Jur. (N.S.) 513.

⁴ *Flavel v. Harrison*, 19 Eng. L. & Eq. 15. ⁵ 18 Jur. 7.

patent, but merely as part of the designation of an article known in the market by that term, then he quite agreed in that view. He said that a patent may have expired fifty years ago, and yet the name of "patent" may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represents the article as protected by patent, when in fact it is not so protected, it can make no difference whether the protection never existed or has ceased to exist. In the more recent case of *Marshall v. Ross*,¹ in 1869, it was held that the use of the word "patent" as part of the description in a label or trade-mark 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*. Sir W. M. James, V. C., said that he could grant the plaintiff the relief which justice requires without interfering with the decision of the House of Lords in the Leather Cloth Company's case above cited; for the word "patent" may be used in such a way as not to deceive the public. For instance, he said, the term "patent-leather boots" is in constant use; but no one supposes that it is thereby intended to convey the impression that the leather is protected by any patent. In this case, it was shown that the term "patent thread" had been used in the trade for many years past, and was the name by which thread of a certain class is known by manufacturers, and in the trade. It had in fact, he said, become a word of art.

§ 73. The case of *Edelston v. Vick*, in the High Court of Chancery, in 1853, is as follows: T. took out letters-patent, which expired in 1844, for the manufacture of solid-headed pins, and carried on the business under the firm of T. & Co., till 1838. In such business T. used parti-colored labels, in pink and green, in which the pins were described as

¹ L. T. Rep. 21 (n.s.) 260; Law Rep. (Eq.) 8, 651.

“Patent Pins, exclusively manufactured by T. & Co.,” and had engraved plates and blocks for striking off said labels. In 1838, T. assigned to S. the letters-patent, together with his business and good-will, and the right to use the plates, labels, &c., and the name of “T. & Co.” In 1839, S. became bankrupt. His assignees carried on the trade till 1841, when they assigned the business, patent, plates, labels, &c., with the right to use the name of “T. & Co.,” to Edelston, the plaintiff, who continued the business and the use of the labels. In 1853, Edelston discovered that Vick, the defendant, was using labels like those of the plaintiff. *Held, first*, That Edelston was entitled to restrain such palpable imitation. *Secondly*, That Edelston was not disentitled to sue by reason of the representation on his label being no longer accurate, although the pins were not still protected by patent, nor manufactured strictly according to the patent, nor exclusively or at all by T., who had long since retired. *Thirdly*, That Vick was not to be precluded altogether from representing that his pins were manufactured according to T.’s (expired) patent, but he was not to do so in a manner liable to mislead.¹

§ 74. Argument is not necessary to persuade any thinking person of the necessity that exists for the protecting instrumentalities of the law. In olden times in England, the trade-guilds and corporate bodies looked especially to the maintenance of a high character of workmanship on broad-cloths, cutlery, hardwares, and other principal manufactures. The penal law of that country is severe upon the reprobates who turn the lawful weapon of defence into the weapon of the robber, by simulating the marks that commerce uses as a safeguard. The crown has its distinguishing broad-arrow for some kinds of property, and its yellow thread in cordage; and the possession of either kind by a private individual is presumptive evidence of felony, as much as the possession of false

¹ 18 Jur. 7.

dies or tools for counterfeiting the currency. Our own government finds it necessary by similar stringent measures to protect its own peculiar marks, as, for example, in the matter of the various-colored threads scattered through the fibre of the paper on which the national securities are printed. Nearly all nations have observed the absolute necessity of severe penal laws to the same end ; while not a few have adopted the same rules as ours in regard to the fraudulent invasion of private rights. The more flourishing becomes commerce, the more general are piracies of this kind. While we may reasonably infer from circumstances that no ancient nation was exempt from such roguery, we have indubitable evidence that all nations of our own times are wonderfully enterprising in this respect. Almost all articles of merchandise possessing a high reputation in Europe are extensively imported into the United States. Their excellences and ready sale excites the cupidity of the fraudulent dealer ; and therefore Heidseick champagne, other wines and brandies, Piesse and Lubin's extracts, and all the various descriptions of toilet articles, Rodgers's cutlery, Worcestershire sauce, Burton ales, Irish linen, French silks, Scotch shawls, in short the innumerable other articles of luxury or of necessity, are imitated, falsely marked, and sold. These frauds are committed under the very eyes of the honest manufacturer, and carried out with so much satanic skill as to elude any but the most vigilant search. Our country has probably been the greatest victim. Even fabrics in which our workshops excel have been brought from Belgium, France, Switzerland, and put into competition with the genuine goods. The reputation of American watches has brought an avalanche of miserable imitations from Geneva, till Congress has been compelled to pass a statute expressly for the purpose of interposing a barrier against them.¹ The Germans imitate the Irish marks on linen ; the French, the English marks on ales, cutlery, &c. ; the English, the French marks on

¹ Act of March 3, 1871.

wines. No nation can claim precedence of any other in such illicit competition, so far as means allow. In the Supreme Court of Calcutta, in 1854,¹ the native defendant was shown to have pirated the English trade-marks on gray shirtings of an inferior quality. That case developed the fact that such imitations had been carried to a considerable extent. We are told that it was the custom at Worcester, England, to copy a great variety of Chinese and Japanese patterns on porcelain, and with such good effect that the copies were frequently mistaken for originals. The marks were simulated exactly.²

§ 75. M. Jobard, more than a score of years since, expressed his sorrow that the revolution in France in 1793 had broken down the law of obligatory marks, that honorable source of confidence and of commercial prosperity, which lost to France all the openings of the Orient. The Levantines, habituated for centuries to the sincerity of the marks guaranteed by the arms of the city of Nimes, Avignon, Lyons, &c., with horror observed the inroads of counterfeiters. The Turkish merchants, no longer confiding in the honor of the French, themselves repaired to Marseilles, Beaucaire, Lyons. But they were cheated as easily near by as afar off; several of the principal ones having paid at Lyons for golden fabrics (*by order of the Grand Seigneur*) unwittingly delivered brass to him. He beheaded them. Thus much for implicit faith in trade-marks.³

§ 76. We may instance the injury done to national confidence by false coinage, the simulation of the mark of the sovereign. Private coinage is not allowed. Coin is intrinsically worth nothing, or next to nothing, beyond its weight of gold or silver, in mass. The public faith is a sufficient guaranty of the genuineness of a coin. Counterfeit coins are almost always of inferior composition and value, and are fabricated for the purpose of imposing them upon the public as

¹ *Leech v. Doorgachurn Seal et al.*, Journal So. Arts, vol. vii. p. 271.

² Binn's Century of Potting in Worcester (London, 1865), p. 93.

³ Organon, etc.

genuine, and gaining the difference. And yet it is possible that the public may be deceived and at the same time not injured. This may be illustrated by a case which occurred in Tunis in 1828. A coinage of new piastres was effected under the direction of the Bey, and on account of his government, the sovereign reaping the enormous profit of more than forty per cent. Piastres of a similar impression, weight, and value, were fabricated in Europe, and found their way to Tunis, where they entered into the circulation, and procured for their makers a division of the spoils. Still the piracy was no less in law, even had the counterfeiters furnished a superior coin; the rule being that the public may not be deceived, even for its own benefit. Not many years ago, the base silver money of Hayti was imitated by artisans in this country, upon similar speculative ideas.¹ It may also be remembered that, during our late civil war of the rebellion, the worthless notes of the Confederate States were imitated by lithographers and printers in the North, and, being more artistically executed than were the genuine, were all the more greedily sought for. Yet the man who sold a cow for a pretty-looking counterfeit note, was declared in law to be cheated, even although the genuine note was doomed never to be redeemed; for his contract was for a genuine promise to pay. The cases fairly illustrate the principle of trade-marks, so far as the obligation to deliver to the purchaser the thing bargained for, whatever its intrinsic value.

§ 77. None of the actors in the following case would have had any standing in court, as applicants for protection. Years ago, the wine-growers of Mont Rachet and of Chablis heard that monks in Bourdeaux were exporting white wine to Turkey, under the name of mineral water. So thrifty an example was not to be despised; so white wine from Burgundy was sent to the Turks under the same disguise, and was declared by the consignees as well as by the exporters to be as good mineral water as that of Bourdeaux. Here was a case of competition

¹ Eckfeldt and Du Bois, Manual of Coins and Bullion.

in business by unfair means. Suppose that the pious fathers of Bourdeaux had prosecuted their rivals in trade for the imitation of their mark, to wit, the meaningless, arbitrary symbol, "Mineral Water," could a suit have been maintained? No! But nobody was deceived? True; but the business was immoral. Immoral to sell wine? No! but immoral to sell to Turks, because their religion forbids them to drink it.

§ 78. Manufactures and commerce are, it is plain to perceive, twin sisters. As they began life together, so in the race do they keep side by side. The plastic hand of the cunning workman moulds and fashions and shapes; while the merchant, scattering his products afar in all directions, by barter receives from afar the products of other countries. All the world should be enabled to test the genuineness of goods by the mark placed upon them. When the distinguishing symbol is once published, it should be susceptible of being read as easily as the child or the dog, by intuition or by instinct, reads the marks that nature has legibly written on the countenance of man. The first glance of the eye decides. This is a rule in connection with trade-marks.

§ 79. How shall we judge a Mark? — We must learn something of its peculiar nature; for it is not every heterogeneous assemblage of objects that comes within the category of trade-marks; nor every Protean representation, that may be one thing to-day, another thing to-morrow. We must apply a touchstone to any thing claiming to be the symbol of trade. We must learn to discern the true from the false, — *i.e.*, the one having the true essence from that which has but a faint semblance of reality. We need not err. There are certain tests. But this leads us to another chapter, which treats of the nature of the thing.

CHAPTER III.

DEFINITION AND NATURE OF A TRADE-MARK.

Necessity for Definition.—Difficulty of Defining.—All Nations use substantially the same Definition.—The 'Technical Mark not to be confounded with its Analogues.—Statutory Definitions.—Trade-marks as applied to Newspapers, Books, &c.—Mere Names of Hotels, Shops, &c., not Trade-marks.—So, also, of mere Labels, Advertisements, Notices.—No Abstract Right to Symbol of Manufactures or Commerce.—Merchandise: what?—*Résumé*—Essential Characteristics of a Trade-mark.

§ 80. A DEFINITION of the term trade-mark is requisite, in order that we may know exactly what we are discussing. This definition is not without difficulty. To arrive at certainty therein, we must examine the laws and the judicial decisions of various countries, whose jurisprudence on this subject is harmonious with that of our own tribunals. Indeed, this species of property cannot advantageously be considered simply in its relationship to a locality; but it must be viewed in connection with affinitive subjects embraced by the all-pervading spirit of commerce. Names sometimes deceive. The difficulty of defining this thing called a trade-mark has been recognized by the ablest minds.

§ 81. We must seek the differential quality by which a trade-mark is discriminated from its analogues, or we shall find our ideas tripped up by the improper use of names. Nomenclature does not consist in the mere naming of tools, but is the expression of distinctions which convey in a single word the nature of the thing meant. When we use the terms trade-mark, label, sign, envelope, design, etc., we mention

things which are analogues of each other, and are not similar in their natures.

§ 82. The exposition of the comprehension of a notion is called its definition, says Sir William Hamilton.¹ For example, the concepts *man*, *horse*, *dog*, &c., are contained under the general concept *animal*; and the concepts *triangle*, *square*, *circle*, *rhombus*, *rhomboid*, &c., are contained under the general concept *figure* (*concept* and *notion* being convertible terms). The same clear thinker says that conception, the act of which concept is the result, expresses the act of comprehending or grasping up into unity the various qualities by which an object is characterized. It has been for lack of a clear conception of the natures of the things which they had occasion to discuss or comment upon, that at times judges, essayists, and reporters have misused terms, and named one thing when they meant another. The uninitiated are misled by the wrongful use of terms; and find to their sorrow, in court, that what they supposed were veritable trade-marks, are mere labels or advertisements, not within the pale of the law's protection. The opinions abounding with fallacious *obiter dicta* remind one of the illustration used by Sir William Hamilton:² "In countries where bank-notes have not superseded the use of the precious metals, large payments are made in bags of money, purporting to contain a certain number of a certain denomination of coin, or at least a certain amount in value. Now these bags are often sealed up, and passed from one person to another, without the tedious process, at each transference, of counting out their contents, and this upon the faith that, if examined, they will be found actually to contain the number of pieces for which they are marked, and for which they pass current." Still the door is open to error and fraud. In the same way, we too frequently accept the loose sayings of a judge for law, because they bear the judicial impress; but when, from abundant caution, we open and examine the bag purporting to

¹ Logic, lect. viii.

² Logic, lect. x.

contain pure gold, we find but withered leaves. In no unkind spirit, we scan the words that should be the fortresses of thought, and find a heap of chaff. No one has the right to complain of our attempt to separate the chaff from the wheat. Locke tells us, in speaking "Of the Abuse of Words," that some take so little care to lay by words which in their primary notation have scarce any clear and distinct ideas which they are annexed to, that by an unpardonable negligence they familiarly use words which the propriety of language has fixed to very important ideas, without any distinct meaning at all. . . . Men having been accustomed from their cradles to learn words which are easily got and retained, before they knew or had framed the complex ideas to which they were annexed, or which were to be found in the things they were thought to stand for, they usually continue to do so all their lives; and, without taking the pains necessary to settle in their minds determined ideas, they use their words for such unsteady and confused notions as they have, contenting themselves with the same words other people use, as if their very sound necessarily carried with it constantly the same meaning.

§ 83. Thus, a careless speaker applies the term trademark to a mere label, although such mere label is not protected by law, unless by some local statute;¹ or to a mere advertisement;² or to the good-will of a shop;³ or to the sign of an inn or hotel.⁴ It is true that we may read and analyze for ourselves; and it is quite as true that we accept the phraseology of a judge on trust. The universality of a term, says Watt, in his book on logic, is many times restrained by the particular time, place, circumstance, &c., or the design of the speaker; as when it is said in the Gospel that "all men did marvel," it reaches to only those men who heard of the miracles of our Saviour. By a careful perusal of a case, we may

¹ *Falkinburg v. Lucy*, 35 Cal. 52.

² *Leather Co. case*, 11 Jur. (n.s.) 513.

³ *Howe v. Searing*, 10 Abb. Pr. R. 264; 6 Bos. 354; and 19 How. Pr. R. 19.

⁴ *Howard v. Henriques*, 3 Sand. S. C. 725.

generally ascertain the import of the language of a judge while he is attempting to expound the law ; but, unfortunately, we find that he is sometimes completely in the mist. "The one exclusive sign," says Aristotle, "that a man is thoroughly cognizant of any thing, is that he is able to teach it." We may, therefore, conclude that if a judge cannot convey to the mind of another person an intelligent idea of his meaning, he must himself be deficient in the understanding of his subject. We require a definition, and that definition the analysis of a complex concept into its component parts or attributes.

§ 84. A definition is a brief enunciation of the law governing a particular subject, or branch of a subject, known by a particular name. Thus, the law of contracts is, in outline, stated in the definition of the word *contract*. Out of an accurate definition can be drawn a vast amount of law. But, in the nature of legal things, a definition can never be established by adjudication. The absolute truth of this proposition appears when we consider that the object of every law-suit is, so far as the law of the case is concerned, to determine the rights of the parties as growing out of certain facts admitted or proved. But facts, as shown in courts of justice, are just as variant in nature from a definition as is a triangle from an emanation of the mind. There is no concord or harmony between the one and the other. Yet, although a court cannot adjudge a definition to be so and so, it may, in assigning reasons for its judgment, take into the account the idea of the true principle of a definition. In other words, the judge, in giving the opinion of himself and his associates upon the law as applied to the facts, may state what he and they deem the true definition to be. But this statement is a mere *dictum* : it creates no law ; it is of no higher authority than are similar statements made by text-writers ; and indeed it is not so likely to be found correct as is theirs.¹ In his treatise on trade-marks, Lloyd² states his opinion that there would be much convenience in having a

¹ Bishop's First Book of the Law, §§ 261, 262.

² Second ed., p. 33.

statutory definition of a trade-mark, which should distinguish, as was done by the old French law, between the *marques de fabriques*, or trade-marks properly so called, consisting of a stamp affixed to or incorporated with a manufactured article, and the use of a name, or label, or a sign-board, or placard, and all those less permanent marks of distinction which are used in trade; and again separating from them all cases which involve literary or industrial property.

§ 85. The French have probably given this subject as keen and thoughtful a scrutiny as any jurists in the world; and yet, in the report of the commission to examine the project which crystallized into their legislative act of the 23d of June, 1857, it is said: "In what do marks consist? The plan of the law, avoiding the peril of a definition, and leaving to doctrine and to jurisprudence the task of defining, has remained mute in this respect." The Council of State concurred in this idea of the impolicy of attempting an exact enunciation of the elements which constitute this thing, and said: "The mark is any sign serving to distinguish the products of a manufacturer, or the objects of commerce, and the law cannot enumerate the signs." The Court of Paris, in 1859, calls it the characteristic sign by means of which commerce distinguishes the products of one's manufacture, or the objects of his commerce.¹ By resorting to what was until lately the universal language of diplomacy, — the French, — and which is a safe guide to the meaning of all leading nations when speaking upon this subject, we find that the *trade-mark* of English-speaking countries is the same thing as the *marque de fabrique et de commerce* of continental Europe. This is placed beyond all question by the "Code International de la Propriété Industrielle," &c., by MM. Pataille and Huguet (Paris, 1855), and the Appendix thereto (1865), by the former eminent jurist. Our term is so translated, and so its synonym in the English "Merchandise Marks Act," of 1862. All treaties and conventions of com-

¹ Lalande et Liot *v. Appel et als.*, Ann. de la Prop., etc., tome v. p. 248.

merce agree in this respect. The uniformity of expression proves that the same thing is understood by all alike; and that in the minds of statesmen and jurists there is no doubt as to what is meant by the general comprehensive term *trade-mark*. As corroborating instances of this prevalent understanding, see our treaty with Russia,¹ where the phrase "trade-marks affixed to merchandise" is rendered in the counterpart *des marques de fabriques apposées dans l'autre sur certaines marchandises*; and see, also, our conventions with Belgium² and France.³ The German term *Fabrikzeichen* is translated into the same words in French.⁴ We find a more comprehensive definition of the term mark of trade, in German.⁵

§ 86. This perfect agreement leads to the inevitable conclusion that a trade-mark is not a new kind of creature; and that its meaning, purpose, and value are well known to all manufacturing and commercial peoples, and requires no definition in a treaty, every word of which is subjected before ratification to the most rigid scrutiny. The manifest object of the many national compacts was reciprocity of protection, and not to give vitality to the thing. When we come to fully consider the subject, it will be amply demonstrated that, as much as any other species of property, a right to a distinctive mark of authenticity has its foundation in immutable law; and we will perceive that any arbitrary law — as a treaty, a convention, or a statute — cannot be the parent of this ideographic sign. The *right* pre-existed: a compact only recognizes that right, and opens the door to a *remedy* for encroachment thereon.

§ 87. The mark may consist in the name of the manufacturer or the merchant (provided it be written, printed, branded, or stamped in a mode peculiar to itself); in a seal, a letter, a

¹ Jan. 27, 1868.

² Dec. 20, 1868.

³ April 16, 1869.

⁴ Technologisches Wörterbuch, in three languages. Paris, 1855.

⁵ "Unter den Waarenbezeichnungen (Fabrikzeichen, Marken) werden diejenigen Zeichen verstanden, welche dazu bestimmt sind, die in den Handel gebrachten Erzeugnisse als von einem bestimmten Urheber oder Zwischenhändler herrührend zu bezeichnen." Klostermann on Trade-marks, &c. Berlin, 1869.

cipher, a monogram, or any other sign or symbol that can serve to distinguish the products of one man from those of another. It may be any symbol or emblem, however unmeaning in itself, as a cross, a bird, a quadruped, a castle, a star, a comet, a sun; or it may, and frequently does, consist of a combination of various objects, copied from nature, art, or fancy; and if such symbol or emblem comes by use to be recognized in trade as the mark of the goods of a particular person, no other trader has a right to affix it to goods of a similar description.¹ It may be adhesive or non-adhesive. It may be put inside of the article, or on the outside. It may be written, printed, stamped, painted, stencilled, branded, or otherwise, and either on the article itself, or on its case, covering, envelope, or wrapper.²

§ 88. We must not be misled by a sweeping definition. We must judiciously compare, reason, generalize. Mere words may deceive. The physiology of the thing called a trade-mark must be examined and carefully analyzed. It has an individuality of nature. Meaningless in itself, when placed in a certain juxtaposition, it involves an idea, as the digit 9 does not represent the word *nine*, but the idea itself of the number. It is the legitimate hieroglyph. It is the emblem of a man; and it virtually says that the vendible object to which it is attached is the workmanship, or the selected article, of the owner of the mark. It is intended to strike the eye by its clearly defined character, and sometimes the ear by its sound when spoken of, and thus excite inquiry; and for this reason it must be peculiar in form, although possibly not susceptible of utterance in sound.

§ 89. We may readily understand why a nondescript vignette,

¹ *Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 Jur. (N.S.) 513.

² The French law of June 23, 1857, says: "Sont considérés comme marques de fabrique et de commerce les noms sous une forme distinctive, les dénominations, emblèmes, empreintes, timbres, cachets, vignettes, reliefs, lettres, chiffres, enveloppes, et tous autres signes servant à distinguer les produits d'une fabrique ou les objets d'un commerce."

a grouping of flowers and fruits, an elaborate landscape having no striking features, or a mere advertisement, or common print of a man's name, should not be regarded as the distinctive mark that the law of commerce requires. It should possess such salient features as might at once arrest attention and put the intended purchaser on the alert. If such an undefined object could possibly be regarded as a valid trade-mark, what would be the consequences? There would be neither protection for the owner nor guaranty for the buyer; for any other combination of flowers and fruits, of houses and trees, having the same pictorial effect, might be mistaken for it.

§ 90. It is not very remarkable that casual readers should fall into the error of confounding the technical trade-mark of commerce with rights protected upon principles analogous to those upon which trade-mark decisions rest,—such as the good-will of an establishment of trade and literary rights,—especially when we find at times a judge, a commentator, or a reporter, falling into the same error. The importance of observing the distinction will be more manifest as we proceed in this investigation. It should be borne in mind that a trade-mark carries the idea of a man's personality, like his ordinary autograph, and therefore preserves its essential characteristics wherever it may go. This is not so with a *quasi* trade-mark, as the name of a hotel or shop of trade, or the title of a stage-coach, or mere literary property, or a patent for an invention or a discovery; for such things have no inherent extra-territorial force, and for recognition depend upon compact, or the tacit acknowledgment of nations other than those where such rights originated.

§ 91. With rare exceptions, this important distinction is observed. Mr. Lloyd, in his treatise on trade-marks,¹ preserves the line between the good-will of a trade so far as it is contained in the title and style of a partnership, or the name of a trader, or the description of his place of business,

¹ London, 1865.

and property in a name or distinguishing style, as connected with a literary publication or a work of art. So do also the continental writers and jurists; for although in their tribunals a single action may, it seems, embrace a claim for damages for infringement of a patent, a demand based on a trespass on the good-will property by false representations, the piracy of a label and violation of a mark, and may unite a demand for both civil and criminal penalties, — *i.e.*, when all the alleged wrongs shall have arisen from one transaction, — yet we find that the different classes of injuries are separately considered in arriving at a conclusion, although constituting the warp and woof of the same web; and in adjusting remedies each species has its own peculiar redress. This mode of procedure, so different from that of countries under the domination of the common law of England, springs from the flexibility of the *Code Napoléon*. Yet this complexity need cause no confusion of ideas, except in the minds of superficial readers and unreflecting dabblers in law.

§ 92. In the case of *Woodward v. Lazar*,¹ in the Supreme Court of California, in 1863, before all the justices, the name of a hotel was treated as a trade-mark. It was an appeal from an order refusing to dissolve an injunction by which the defendants were restrained from using the name of “What-Cheer House,” as the title or name of a hotel in the city of San Francisco. Norton, J., in delivering the opinion of the court, said: “It has been decided, and with good reason, that the name established for a hotel is a trade-mark, in which the proprietor has a valuable interest, which a court of chancery will protect against infringement. *Howard v. Henriques*, 3 Sand. S. C. 725. The point of dispute in the case is as to whom the name ‘What-Cheer House,’ as a business-sign, belongs. The plaintiff claims that it belongs to him, as the keeper of the hotel, which he continued to conduct under that name after he surrendered the leased premises; while the

¹ 21 Cal. 448.

defendants claim that it is the designation of the building in which the business under that name was first conducted, and became theirs when they became owners of the building." Now let us examine the case cited by the judge, and decide for ourselves whether or not there was not a mistake made in the name of the thing, — a mistake quite as wide of the truth as would be the confusion of the terms freehold, mortgage, lease, all relating to landed property, yet distinct in their natures. Names are sometimes things.

§ 93. In *Amoskeag Manufacturing Co. v. Spear*,¹ in 1849, a distinguished jurist, Mr. Justice Duer, inadvertently misused terms. The defendant had pirated plaintiffs' label, making it correspond in size, color, fancy border, position, general arrangement and size of the letters, including the alleged trade-mark, the capital letters "A C A." These letters were decided not to be a trade-mark, being merely indicative of quality. What, then, was the trade-mark? Nothing. Compare the language of the two labels. That of the plaintiffs read thus: "AMOSKEAG MANUFACTURING COMPANY. POWER LOOM. *Yds.* —. A C A. AMOSKEAG FALLS, N. H." That of the defendant read thus: "LOWELL PREMIUM TICKING. POWER LOOM. *Yds.* —. A C A. WARRANTED INDIGO BLUE." The judge had a clear conception of all the principles involved, and his decision was unquestionably correct. The extraordinary powers of a court of equity had been invoked to prevent the continuance of fraud. In what did that fraud consist? In a "designed, studied, elaborate imitation" of the label of the plaintiffs, said his Honor. The defendant endeavored by a false representation to effect an unlawful purpose. To quote the judge's own words: "In this case there is a fraud coupled with a damage; and a court of equity, in refusing to restrain the wrong-doer by an injunction, would violate the principles upon which a large portion of its jurisdiction is founded, and abjure the exercise of its most important functions, — the suppression of

¹ 2 Sand. S. C. 599.

fraud, and the prevention of a mischief that otherwise may prove to be unbearable." The remedy could not be denied. The error of the judge manifestly consisted but in the loose use of one word for another, those words being in no sense convertible terms. The words were uttered more than twenty years before the first case of the kind had been reached in the highest court in the land, and were uttered in a case which required no definition of species. If there had been any need of a nice discrimination of technical terms, the acute mind of the judge would have seized upon it, and, by using the exact word, would have prevented the possibility of misunderstanding. The objectionable phraseology was this: "When I compare the original trade-mark of the plaintiffs," &c. The correct word was *label*, not *trade-mark*. It must be obvious at a glance to any one, who has acquainted himself with the law and principles of trade-marks, that the single element that could possibly be a trade-mark was the "A C A" symbol. The three letters were found not to constitute a lawful trade-mark, and were stricken from the injunction. Nothing, thereafter, remained but words in ordinary use, common to all the manufacturing world. But, if this was not a trade-mark case, what was it? Answer: it was a case of unlawful competition in trade, by means of a simulated label.

§ 94. In another place it will be seen that the Patent Office took action upon this question, and decided the three letters "A C A" to be at least a *prima facie* trade-mark, from its long user and universal recognition.

§ 95. The case of *Howard v. Henriques*,¹ in 1851, was decided by five out of six judges of the Superior Court of the city of New York, when that court was composed of as able minds as any in the land. The plaintiff was proprietor of a hotel known as the "IRVING HOUSE," or "IRVING HOTEL," and which was opened and named by him "IRVING HOUSE," in 1848. The defendants opened another hotel in the same city, which

¹ 3 Sand. S. C. 725.

they named the "IRVING HOTEL." An injunction was granted, by one of the justices of the court, restraining the defendants from using the name thus taken by them. A motion was made to dissolve this injunction. Observe, the plaintiff's house, although originally designated by him as the Irving *House*, very soon became generally known also as the Irving *Hotel*, and was designated by both names indiscriminately for more than a year before the defendants opened their hotel. All these facts appear in the opinion of the court, delivered by Mr. Justice Campbell. It was urged by the defendants' counsel, *first*, that the plaintiff had not appropriated the name, because no such name appeared on the external walls of his house; and, *second*, even if it did so appear, the name was not the subject of appropriation, as applied to a hotel; that the principle upon which trade-marks and other similar rights had been protected, was applicable alone to personal property, to manufactured articles, to such things as were necessarily movable, and in reference to which frauds could be practised without being easily detected, or, at all events, frauds could be practised operating injuriously upon the party claiming the trade-mark, and also upon the public. The answer of the court was that there would be no more necessity for the plaintiff to place in large letters upon the front of his building, "This is the Irving House," in order to designate it and secure an appropriation of the name, than there would be to write on the public edifices of the city, "This is the City Hall," and "This is Trinity Church." As to the second objection of the defendants the court spoke thus: "We think that the principle of the rule is the same, to whatever subject it may be applied, and that a party will be protected in the use of a name which he has appropriated, and by his skill rendered valuable, whether the same is upon articles of personal property which he may manufacture, or applied to a hotel where he has built up a prosperous business. We are not disposed to interfere with the lawful pursuits of any one. Every man may, and

ought to be permitted to pursue a lawful calling in his own way, provided he does not encroach upon the rights of his neighbor or the public good. But he must not by any deceitful or other practice impose upon the public; and he must not, by dressing himself in another man's garments, and by assuming another man's name, endeavor to deprive that man of his own individuality, and thus despoil him of the gains to which by his industry and skill he is fairly entitled. To make the application: If one man has, by close attention to the comfort of his guests, and by superior energy, made his hotel desirable for the traveller, and caused its name to become popular throughout the land, another man ought not to be permitted to assume the same name in the same town, and thus deprive him who first appropriated the name, of some portion of the fruits of that good-will which honestly belongs to him alone."

§ 96. The perusal of this case of *Howard v. Henriques* relieves the mind from all doubt or embarrassment as to the meaning of the court. The counsel had been reasoning from analogy; and the court pursued the train of ideas thereby evolved. No one in that case assumed that the mere name of a hotel could be a trade-mark, but argued upon principle. How could any one so assume? Did the proprietor of the name affix it to any vendible article? No. But, it may be replied, he did use it upon all the bills rendered to his guests, on cards, and in numerous advertisements circulating throughout the country. True; but advertisements are not trade-marks.¹ Nothing short of the sheerest sophistry could twist the title of a hotel into a mark of commerce, a visible mark affixed to a thing sold, or for sale. We cannot detect the essential elements of the thing technically so known. Then, if not a case of trade-mark, what was it? It was exactly what the Superior Court, by the lips of Mr. Justice Campbell, called it, the "good-will" of the establishment. The case did not call for a definition. All that was required was substantial

¹ Lord Chancellor, in *Leather Co. v. Am. Leather Co.*, 11 Jur. (n.s.) 513.

justice, upon the allegation of an invasion of an equitable right.

§ 97. *McCardel v. Peck*,¹ before the Supreme Court of New York, *in banc*, in 1864, is a case that is sometimes cited to prove that the name of a place of business is a trade-mark. The misconception is the fault of the syllabus of the reporter. The matter in dispute was the right to use the name of a restaurant known as the "MCCARDEL HOUSE," in the city of Albany. The court certainly did not treat the case as any other than a question of the right to the good-will. The language of Miller, J., who delivered the opinion, misled the reporter. "He said: "The use of names and trade-marks in business, when made valuable, has always been protected by the courts, and any improper appropriation of them without the authority of the owner will be restrained by injunction." He said in another place, "the use of a name or trade-mark." This is all that was said of trade-marks: "Names *and* trade-marks;" and "a name *or* trade-mark." It needs no great power of discrimination to perceive that the employment of the conjunctions implied a distinction between *name* and *mark*.

§ 98. *Howe v. Searing*, 1860,² is another case that is quoted in support of the theorem that the name of a place of business is essentially a trade-mark. But a careful examination of that case will show that the majority of the court placed it in its proper category. The plaintiff, a baker by trade, brought an action to restrain the defendant from designating the bakery-establishment kept by him, in the city of New York, as "Howe's Bakery," and from otherwise using the name of Howe, so as to induce the public to believe that the business carried on at his place was conducted by the plaintiff. It was not in anywise discussed as any thing other than what it really was, — "the *good-will* of the business of baking." All the authorities commented upon by the learned Judge Hoffmann, who delivered the opinion of the court, are good-will cases.

¹ 28 How. Pr. R. 120. ² 10 Abb. Pr. R. 264; 6 Bos. 354; and 19 How. Pr. R. 14.

He adopted the language of Vice-Chancellor Wood, in *Clinton et al. v. Douglass*:¹ "The name of a firm is a very important part of the good-will of the business carried on by the firm. A person says, I have always bought articles at such a place of business; I know it by that name, and I send to the house of business identified by that name for that purpose." Moncrieff, J., *dissenting*, said: "The name or words 'Howe's Bakery' was nothing but a trade-mark, and, as such, is now sought to be protected by the plaintiff. The name or trade-mark passed by the assignment and transfer of the '*good-will*;' and, if it was not the thing itself, it was an integral part of it."

§ 99. What warrant had the dissenting judge to use the technical term trade-mark? We look in vain for any authority to sustain his remark. Consider the circumstances. The plaintiff, who had been doing a lucrative business as a baker at No. 432 Broadway, sold the lease of the premises, with all the stock, wagons, and fixtures, and the good-will of the concern, to one Baker. Baker subsequently sold back to Howe the right to resume business at another place, No. 850 Broadway, in the same city; and still later sold the lease to Searing, the defendant, subject, however, to Howe's right to conduct business in his own name. Searing continued the old sign-name, to the prejudice of the plaintiff's rights, and in a way calculated to mislead the public. Howe had a clear title to his own name; and so, indeed, had any other Howe the same right, and if he chose could put up a sign informing the public of the location of his place of business. Searing, the defendant, had no right to use Howe's name. Hence the suit. The mere name of Howe could not be a valid trade-mark, for it was not the exclusive property of the plaintiff. It was not a trade-mark unless intended to be stamped upon, or otherwise affixed to the articles sold. It was at best a mere advertising sign. Even if stamped upon the bread, it would not be a trade-mark; for it would not indicate origin. The purchasers

¹ 1 H. R. N. Johns. 176.

could not tell by the mere name what one of many persons of the same name had baked the bread. Conclusion: the remarks of Mr. Justice Moncrieff were not a judicial decision, and must be classed with unauthoritative *obiter dicta*.

§ 100. We must not infer from the foregoing decisions that the name of a place of business cannot become a valid trade-mark. If it possess the true characteristics of such a mark; if it be not generic, merely descriptive, or one that any other person in the same trade may truthfully use; and if it be affixed to a vendible article, then it may be made a trade-mark as well as any other symbol. The case of *Chojnski v. Cohen*,¹ in the Supreme Court of California, in 1870, before all the justices, is in point. The plaintiff claimed the exclusive right to the name, "ANTIQUARIAN BOOK STORE," which name was placed upon his sign, *stamped upon all articles sold by him*, and used in his correspondence. *Held*, to be a mere designation of trade.

§ 101. It was of little or no moment in the cases cited what term a judge may have used to express an idea. Substantial justice did not depend upon preciseness of terminology. It is, however, of moment in our present purpose to accurately define, lest by looseness of language we fall into looseness of application of principles, and so end in egregious error. In judicial matters, a rose by any other name may not smell as sweet. A name is sometimes of the very essence. We could not arrive at any result other than this: the name of a hotel and a trade-mark are not convertible terms.

§ 102. The British "Merchandise Marks Act," of 1862, says that "the word 'mark' shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description; and the expression 'trade-mark' shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid lawfully used by any person to denote any chattel, or (in

¹ 39 Cal. 501.

Scotland) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, or production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person; and shall also include any name, signature, word, letter, number, figure, mark, or sign which in pursuance of any statute or statutes for the time being in force relating to registered designs is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of such statutes or any of them." This language savors more of enumeration than definition, and may possibly mislead by its breadth of expression, embracing as it does things incongruous in their several natures, as registered designs and copyright matters. Being a statute applicable only to British courts, its form of expression cannot be taken as an infallible guide for our present purpose. Many of the terms used cannot be understood unless taken with their judicial definitions, as name, word, label, &c. It should, however, be observed that the expression "trade-mark" not only includes every mark lawfully used by a person to denote any chattel to be an article of the manufacture, workmanship, or production of such person, but also to be an article of the *merchandise* of such person, or to be an article of any peculiar or particular description made or sold by such person. This will include such cases as *Mottley v. Downman*,¹ where it was contended that the right to use the trade-mark was attached to a particular place and works, and to cases where the articles are distinguished by the name of a person who did not manufacture them, and to similar cases.²

§ 103. Is the NAME OF A NEWSPAPER a trade-mark? This question has been thoroughly discussed *pro* and *con.* in the Patent Office, but has probably not been definitively decided

¹ 3 M. & C. 1.

² See notes of H. B. Poland, Esq., to the English Act of 1862.

by any court. Upon an application for registration, all the authorities bearing upon this point were examined. If a technical trade-mark, the application would be favorably acted on; if not, it would be rejected. The matter being *ex parte*, the pleasing task of collating judicial decisions devolved upon the Office. We will let the cases cited again pass in review.

§ 104. *Snowden v. Noah*, in the Court of Chancery of New York, before Sandford, Chancellor, in 1825,¹ was treated by counsel and by the court as a *good-will* case. The chancellor said: "The defendant Noah was the editor, but not the proprietor, of the newspaper establishment called the 'National Advocate;' and immediately after the sale of that establishment by its former proprietor to the complainant, Noah established another newspaper, under the title of the 'New York National Advocate.' This new gazette thus established is sent to the subscribers of the former 'National Advocate,' and Noah has solicited and continues to solicit the support of the patrons of the former paper and of the public to his newspaper. This is briefly and in substance the case upon which an injunction is now asked." After some other remarks, he continued: "The subject in respect to which an injunction is asked, is what is called the good-will of the establishment, or the custom and support which the 'National Advocate' had before received from its subscribers and patrons, or from the public. The effort of Noah is to obtain for his newspaper the support of the public in general, and especially the custom and good-will of the friends of the 'National Advocate.' This object is distinctly avowed; and an open appeal is made to the friends of the 'National Advocate' and to the public to give their support to the new paper. The question is, whether the acts of Noah are an invasion of the private rights of Snowden, as the proprietor of the 'National Advocate,' or merely an exercise of the common right to print and publish a new journal, and to obtain for it patronage. . . . The only circumstance in this

¹ Hopkins's Ch. R. 347.

case which has any appearance of an undue encroachment upon the rights of Snowden is, that Noah's new paper is published under a name nearly the same with that of Snowden; but the name of the new paper is sufficiently distinct from the name of Snowden's paper to apprise all persons that these are really different papers. . . . I do not perceive that any person can be misled in this respect. . . . The good-will of an established trade, the custom of an inn, and the right of a publisher of books, may be injured by acts of deception and piracy; but the injury for which redress is given in such cases results from the imposture practised upon the customers of an existing establishment, or upon the public." It is evident that the chancellor did not contemplate the case as a mere infringement of a trade-mark right, or he would not have mingled the matters of an injury to trade, to the custom of an inn, and the right of a publisher of books. If he had regarded the name "National Advocate" as a trade-mark, then he must necessarily have passed upon the question, whether the name that the defendant had adopted was not an infringement of that trade-mark. Yet he chose to discuss the question in controversy under the comprehensive idea of an injury to the good-will. Therefore that case does not solve our inquiry.

§ 105. *Bell v. Locke*,¹ in the same court, before Walworth, Chancellor, in 1840, was a similar case. This case came before the court upon an order for the defendant to show cause why an injunction should not issue, restraining him from printing, publishing, or circulating a newspaper under the name of the "New Era," it being contended that such name was an infringement of the rights of plaintiff, who published the "Democratic Republican New Era." THE CHANCELLOR: "The allegation in the complainant's bill is, that the defendant has assumed the name of the complainant's newspaper for the fraudulent purpose of imposing upon the public, and supplanting him in the good-will of his established paper, by simulating the name

¹ 8 Paige, 75.

and dress thereof, with the intent to cause it to be understood and believed by the community that the defendant's newspaper was the same as the complainant's, and thereby to injure the circulation of the latter. If this were in fact so, I should have no difficulty in making this order absolute." He observed, further on in his opinion, that "there could be very little excuse for the editor of a new paper who should adopt the precise name and dress of an old-established paper, which would be likely to interfere with the good-will of the latter by actually deceiving its patrons."¹ This case comes closer to our notions of one involving the mark of trade or commerce; and although the chancellor used the term good-will and did not mention the term trade-mark, we conclude that the latter term was strictly applicable.

§ 106. In *Dayton v. Wilkes*,² at a special term of the Superior Court of the City of New York, in 1859, Hoffman, J., in regard to the right to use the name of "Porter's Spirit of the Times," said: "It has been very correctly argued, by the counsel for the plaintiff, that the analogy of the rules as to trade-marks should apply to this case." It is manifest that the court did not regard the thing in controversy as a mere trade-mark; nor was it necessary for the solution of the matter. We must look further.

§ 107. *Matsell v. Flanagan*,³ at a special term of the Court of Common Pleas, in 1867, is of assistance in elucidating the mooted question. The plaintiffs were, and had long been the publishers and proprietors of the "National Police Gazette," which was commonly known to the public as the "Police Gazette." The defendants prepared and published a newspaper, in imitation of the plaintiff's newspaper, with nearly the same title and device, which misled and deceived purchasers. So the complaint alleged, and so the court found. The language of Brady, J., relieves us from any doubt as to the

¹ 8 Paige, 75.

² 17 How. Pr. R. 510.

³ 2 Abb. Pr. R. (N.S.) 459.

class of wrongs to which he assigned a case of the kind. After reciting the power of the court in trade-mark cases, he continued: "The enforcement of the doctrine that trade-marks shall not be simulated does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle that the public are entitled to protection from the use of previously appropriated names or symbols, in such manner as may deceive them, by inducing or leading to the purchase of one thing for another." This case was treated as purely an infringement of a trade-mark; and the court, in commenting upon *Snowden v. Noah* and *Bell v. Locke*, treated it as a parallel case.

§ 108. *Stephens v. De Conto*,¹ at a special term of the Superior Court of the City of New York, in 1868, has a somewhat different complexion. The plaintiffs owned and published a newspaper called "La Cronica." The single question in controversy was as to restraining the publication by the defendant of the paper called "El Cronista." Monell, J., discussed some of the general principles of "good-will," and assumed the case to be of that nature, if indeed any right at all existed; and, in delivering his opinion, he wandered off into fields foreign to the real nature of the case presented. He said: "If this case was to be determined solely upon whether the similarity, if it could be established there was any, of the names 'La Cronica' and 'El Cronista' could mislead the public into the belief that they were the same, I should have no difficulty in reaching the conclusion, upon the evidence, that no such effect could or would result. . . . I do not understand that the protection which the law affords to 'trade-marks,' even assuming the name of a newspaper to be a trade-mark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over any thing that was the subject of a patent or a copyright, but is confined to appropriations of names designating some

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

particular manufacture or business. There can be no such property in a newspaper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and when given to the public all literary proprietorship in them is lost. And the law of trade-marks, like the law of copyright, cannot be applied to a work of so fluctuating and fugitive a character. *Clayton v. Stone*, 2 Paine, 392. I do not mean to say that a newspaper proprietor cannot appropriate, and, by long use, acquire a property in a name, which the courts will protect against piracy. In this respect the analogy of trade-marks would apply. *Dayton v. Wilkes*, 17 How. Pr. R. 510. And I have no doubt that the names, so long appropriated and used, of 'The New York Herald,' or 'The Sun,' would be protected as trade-marks, against the assumption of those names by another proprietor. But that I understand to be the extent of the rule, and that any mere assimilation of the name — unless it was clearly to deceive the public — would not be unlawful." The injunction was accordingly dissolved, and the complaint dismissed with costs. This opinion has been quoted a number of times on each side of the question, which is evidence that it has misled. Let us hastily analyze it. What was the point? It was this: Was the use of the name "El Cronista" an infringement upon the exclusive right in the name of another newspaper, "La Cronica"? The general contents of the respective papers had nothing to do with the contest. The judge said the protection given to trade-marks had not been extended over any thing that was the subject of a *patent* or a *copyright*. Nothing more true. But the name of a newspaper is not the subject of a patent or of a copyright, as we shall see hereafter in this treatise. But the judge expressly conceded that the long-used names of certain papers would be protected as trade-marks. That is our case, so far as this decision goes. With it is exhausted our American authorities on this point. We look in vain for an English case

that exactly touches the present question. *Hogg v. Kirby*¹ was cited in each of the foregoing discussions ; but it does not help us in reaching a determination. In no instance have we the opinion of more than one chancellor or judge. Let us think whether the true principle cannot be deduced therefrom.

§ 109. The question recurs, Is the name of a newspaper a trade-mark ? If not, upon what principle is it protected ? The question arose in the Patent Office upon an application to register the name of a paper. It was suggested that, as the name had been copyrighted, protection must be sought under section 86 of the law in relation to copyrights.² It is there provided, that any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, &c., may, upon complying with certain specified conditions, have the sole liberty of printing, publishing, and vending the same, &c. The heading of said paper consisted of an ornamental *engraving* on wood, commonly known as a *wood-cut*. It was also a *print*. Did those literal facts determine the right ? We will examine for ourselves. The librarian of Congress, not being a judicial officer in any sense, was not required to pass upon the legality of copyrighting the thing presented to him for that purpose. The fee was paid : the act was done. But does a mere newspaper-heading come within the spirit and meaning of the law ? The Constitution³ gives power to Congress “ to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries.” We can nowhere else find the power to legislate upon copyrights. The rights of inventors and authors, as long settled in Great Britain, were familiar to the framers of the Constitution ; and, as Mr. Justice Story

¹ 2 Ves. 226.

² An Act to revise, consolidate, and amend the statutes relating to patents and copyrights, July 8, 1870.

³ Art. I. sec. 8, sub-sec. 8.

says,¹ it is doubtless to this knowledge of the common-law and statutable rights of authors and inventors that we are to attribute this constitutional provision, being beneficial to all parties. It was beneficial to authors and inventors, because it maintained their rights to the product of their intellectual labor; and beneficial to the public, as it would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint. In short, the only boon which could be offered to inventors to disclose the secrets of their discoveries would be the exclusive right and profit of them, as a monopoly, for a limited period. A copyright is limited by time: a trade-mark is not. A copyright is limited territorially, but a trade-mark acknowledges no boundaries. They are unlike in their natures.

§ 110. Literature, invention, and the fine arts needed a fostering hand, and found it. The consideration paid by them for a monopoly was a surrender to the public after a limited time. The consideration was the coin of their brains. Authors! What claim has the adopter of a trade-mark to be considered an author? He may adopt any symbol, the sign of any thing in heaven above or in the earth beneath; it may be a representation of a real object, or it may be entirely fabulous. It does not require any genius for one to call a newspaper by the name of sun, moon, or star. The name of a newspaper is a sign to arrest attention, as it catches the eye. It points to something else. The heading is not offered for sale. Its office is simply to inform the public that the paper on which it is printed is the Herald, the Sun, or the Globe, as the case may be. The public care not a straw whether the heading be ornamental or plain; for the advantage in buying it is the intelligence, the editorials, the advertisements. The purchaser does not glance at the heading, the title, the name, except to be assured that he is getting the newspaper of his

¹ Story on the Constitution, vol. ii. § 1152.

choice. He takes no delight in gazing upon the name or heading as a work of art. But the copyrighted article is the thing that is sold. The book, the map, the dramatic composition, the engraving, cut, photograph, &c., is the thing bought. The name of a newspaper is but the guide to the thing. In the case of the heading of a newspaper, if its owner should elect to abandon it after a certain period, what value would he render to the public? Nothing. If considered as a work of art, what would be the measure of damages for infringement?¹ As a penal law, the statute must be strictly construed. Again, it would be absurd to suppose that Congress intended to include such a thing, from the requirement of deposit in the mail before publication,² a description of the article, and within ten days after publication the transmission of two copies to enrich the library of the nation. The heading of the "Herald" as a work of art! We cannot conceive a mere newspaper heading to be a subject for copyright.

§ 111. In *Stephens v. De Conto*, the judge mentioned "the subject of a patent," — meaning, doubtless, a design-patent. Is such a heading the subject of a patent? Examine: Mr. Upton, in his work on Trade-marks,³ has taken the correct position in the construction of the Act of 1842, for patents for designs. The language, "any new and useful *pattern*, or print, or *picture*, to be either worked into or worked on, or printed or painted or cast, or otherwise fixed on any article of manufacture," &c., has been relied on as conferring a right to an exclusive privilege that may be made to serve the purpose of designating articles of merchandise. He says: "It is quite obvious that such was not the purpose of the law; but, on the contrary, it was manifestly intended that the *design* for which such protection was provided, should constitute a portion of the manufactured article, either as an ornamental adjunct, or as controlling its figure or proportions, by no means as a mere

¹ See sec. 100 of Copyright Law of 1870.

² Sec. 90 same act.

³ Albany, N. Y., 1860, pp. 17, 18.

name or designation by which to identify or distinguish the article." He maintains that the right thus acquired is in no sense a trade-mark property.¹ We must agree with him that the construction sometimes given to that act was quite unwarrantable. The design that is patentable is æsthetic. The mark of manufactures or of commerce is not essentially a thing of taste. The abstract symbol has no intrinsic value. The value is in the article to which it is affixed.

§ 112. The Supreme Court of the United States in its first trade-mark case, in 1872, said: "Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions."²

§ 113. In *Swift v. Dey*,³ Robertson, Ch. J., said: "A patented design may be adopted as a trade-mark, by consent of the patentee, and thereby its use by others for the same purpose prevented. There is no rule, however, which makes the test of the infringement of such rights the same in both cases. The defendants may be liable in both the Federal and State courts: in the former, for imitating the design; in the latter, for passing off, by means of such design, spurious wares as being the plaintiff's: and the cause of action would clearly not be the same."

§ 114. Paxson, J., in *The Dixon Crucible Co. v. Guggenheim*,⁴ expressed an opinion that "the name of a newspaper is a trade-mark, as much so as a label stamped upon a bale of muslin," although it is true that that was not the exact question before the court.

§ 115. From the foregoing train of reasoning, we deduce this conclusion: A newspaper, being a vendible article, is as much a matter of merchandise as any thing can be. It would

¹ See case of Whyte, Comr's Dec., 1871, p. 374.

² President, Managers, &c., of Del. & Hudson Canal Co. v. Clark, Patent Office Official Gazette, March 26, 1872.

³ 4 Robertson, 611.

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

not be bought unless it contained or bore an authenticating sign. That sign is its name. Each issue may be ephemeral, and be at once consumed; but the name, its emblem, is permanent and invariable, and is the stamp of genuineness. We see, therefore, that the Office was unquestionably right in admitting the name of a newspaper to registration as a trade-mark.¹

§ 116. **Trade-marks on Books.**— Can printed books be protected by trade-marks? Yes, as mere merchandise; no, as literary productions. They are articles of manufacture, and may bear a particular mark to designate their author, or the merchant who sells them. Sometimes they are impressed with a peculiar symbol, to indicate the place of sale: but not so much so as in preceding ages, especially the sixteenth and seventeenth centuries, and the earlier portion of the last; for then every shop had its emblematic sign, as a dolphin, a lion, the king, &c., and a representation of that sign indicated the place of sale quite as well as could the name of the merchant or publisher. The mark of the dolphin, for example, would satisfy the purchaser, for he would reflect that he had always obtained correct editions of books at that place—the Dolphin. In Savary's "Dictionnaire Universel de Commerce,"² we find that in France, and probably in other European countries, the legalized mark of a bookseller was an image placed by him under the title of a book, or on the first page thereof. This establishes the fact that books were regarded as proper objects for the reception of trade-marks.

§ 117. But it must be borne in mind that it is as merchandise merely, and not as intellectual creations, that books are protected by the mark of commerce. Why so? Because a book, as such, has its protection under the copyright law. If printed, ample remedy is afforded by the copyright law of July 8, 1870.

¹ F. C. Barksdale, No. 424 ("Our Society").

² Copenhagen, 1761, title *Marque*. (Under this head may be found much interesting information in regard to the compulsory use of trade-marks in the various branches of manufactures.)

That is the security which the Constitution and the statute provide for infringement upon works of literary genius, even though the pirate change the title of the book, and, as it were, hoist a false flag. It is the contents of the book that would be copied, and not its emblem, title, or mark.

§ 118. There seems to be no sufficient reason why the title of a book may not be deemed a valid trade-mark; *e. g.*, when, two centuries ago, in England, the five Presbyterian divines (Stephen Marshal, Edward Calamy, Thomas Young, Matthew Newcomen, and William Spurstow) combined the initials of their names, which made the word SMECTYMNU-US, and adopted it as their joint signature, they had a valid trade-mark if they had chosen to use it as such. It was good for the publication bearing that name, and would be entitled to protection as a trade-mark for any books the owners of the newly coined word might offer for sale.

§ 119. Here is a case which is usually classified with trade-mark cases; but, if we keenly scrutinize and analyze for ourselves, we may conclude that, although of the nature of a trade-mark, the thing in controversy has but little claim to the name. We examine *Williams v. Johnson*,¹ before the general term of the Superior Court of the City of New York, in 1857. Under the principle that a rose by any other name may smell as sweet, the court contented itself with rendering substantial justice, without caring about too much nicety in terms. We will soon be able to answer this pertinent question: Is not this an instance of unfair competition in trade, by means of false labels? A wrong was done. Let us try to name it.

§ 120. The plaintiff alleged that, in or about the year 1845, he and his brothers were manufacturers of soap at Manchester, Conn., and made a particular kind of soap, to which, in order to identify it as their manufacture, they gave the name of "GENUINE YANKEE SOAP." It was made in cakes of about two inches square, each cake covered with tin-foil; upon one side

¹ 2 Bos. 1.

of each cake was attached an octagonal pink label, with the words printed thereon: "GENUINE YANKEE SOAP, *manufactured at Manchester, Conn., by Williams & Brothers, Chemists and Apothecaries. To prevent counterfeits, their signature will be upon each cake.*" Upon the other side of each cake was attached another octagonal pink label, with the words printed thereon: "THE GENUINE YANKEE SOAP *is warranted superior to any foreign compound for shaving and the toilet, affording a copious and heavy lather, which does not dry on the face, leaving the skin soft and smooth.*" And at one end of each cake was attached another pink label with the words in writing, or in resemblance to writing: "*Williams & Bros.*" The said soap was put up in pasteboard boxes, containing one dozen cakes each, and each box was covered with a brown paper wrapper, with the words thereon: "One dozen Genuine Yankee Soap, warranted superior to any foreign compound for shaving and the toilet. Manufactured at Manchester, Conn., by Williams & Brothers, Chemists and Apothecaries. To prevent counterfeits, their signature will be upon each cake."

§ 121. It was alleged that the defendant manufactured soap of an inferior quality, put up in a style and manner precisely similar to the plaintiffs'; that it was cut up into cakes of the same size as those of the plaintiffs', each cake encased in tin-foil; and upon each cake were three labels of the same form as the plaintiffs'. Upon one were printed the words: "GENUINE YANKEE SOAP, *manufactured at New York, by L. Williams & Co. To prevent counterfeits, their signature will be upon each cake.*" Upon another were printed the words: "THE GENUINE YANKEE SOAP *is warranted superior to any foreign compound for shaving and the toilet, affording a copious and heavy lather, which does not dry on the face, leaving the skin soft and smooth.*" And upon the third were the words, in writing, or in a resemblance to writing: "L. WILLIAMS & Co." Each box was covered with a brown paper wrapper, with the words thereon: "*One Dozen Genuine Yankee Soap, warranted superior to any foreign*

compound for shaving and the toilet. Manufactured by L. Williams & Co., New York. To prevent counterfeits, their signature will be upon each label." Upon these several labels the arrangement of the lines, the form of the letters, and style of printing were, in almost every particular, an exact copy of the labels used by the plaintiffs. It was further alleged that the name of L. Williams & Co. was fictitious, and used to deceive.

§ 122. The defendant's answer denied that the plaintiffs had any exclusive right to use the designation "*Genuine Yankee Soap*," averring that that term described a particular style and quality of soap, and did not identify the person or persons by whom, or the place where, it was manufactured; and that the article known in the market by that name had been for years manufactured by different manufacturers of soap in different parts of the United States, and sold by that name, and could not be appropriated by the plaintiffs. It further denied that the name L. Williams & Co. was fictitious, or used as a colorable imitation, assimilating the trade-mark of the plaintiffs, and deduced the title of the defendant to its use from a firm of that name, who had assigned the business and name to the defendant.

§ 123. An injunction was granted at special term, restraining the defendant from "selling, or in any way disposing of any soap in boxes or otherwise, with labels or wrappers containing the words 'Genuine Yankee Soap' printed or written thereon; and from advertising, selling, or offering to sell, any soap whatever (unless the same has been manufactured by or procured from the plaintiffs), as and for the 'Genuine Yankee Soap,'" &c. From the order so made, the defendant appealed.

§ 124. In delivering the opinion of the court *in banc*, Woodruff, J., said: "The defendant is engaged in a gross and palpable endeavor, by imitating the marks and labels used by the plaintiffs, to deceive the public, and obtain patronage which would in all probability be attracted to the plaintiffs. This the defendant is doing, not only by closely imitating the plaintiffs'

marks and labels, but by falsely representing his soap as a Yankee manufacture, and made by persons named Williams, when, in truth, it is made in the city of New York by the defendant, William Johnson." After characterizing the acts of the defendant as a fraud upon the plaintiffs, the learned judge said of the latter: "They have adopted, in reference to *their* manufacture (of an article which any and every one may manufacture and sell, if he please), a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior handbill upon the box, and have so arranged the whole as to suggest to any one desiring to purchase their soap, upon an inspection, that the article is theirs, and made by them, like that heretofore made, sold, and known as their manufacture. All this the defendant has copied, with an exactness which is calculated to deceive even the wary, much more to entrap those who are not in the exercise of a rigid scrutiny. It is true that the defendant has put upon his labels New York as the place of manufacture, and L. Williams & Co., instead of Williams & Brothers, as manufacturers. But the latter designation imports a falsehood, and tends rather to create than destroy the impression that the soap is made by the plaintiffs; and the use of the word New York, in its obscure printing, if it be read, falls far short of suggesting to the public that it is not the soap manufactured by the plaintiffs. Whether upon taking the proofs in the cause it will appear that the particular words, 'Genuine Yankee Soap,' are to be deemed descriptive of the kind of soap which any one may make and sell by its proper name, or are terms properly designating the plaintiffs' manufacture, and so to be descriptive of their peculiar skill in making an article already in known and common use by its proper and only generic name — soap — is perhaps not free from doubt. It is quite clear that so far as it indicates the place of manufacture, it is a fraud on the part of the defendant to use it. . . . Without deciding whether the defendant may or may not use

either of the words 'Genuine' or 'Yankee' in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or handbills which he is using, nor any other like labels, devices, or handbills used by the plaintiffs, as set forth in the bill of complaint, or any other similar labels, devices, or handbills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap."

§ 125. A nutshell could contain this case, so far as trade-mark law is concerned. None of the words on the plaintiffs' labels are susceptible of being turned into trade-marks, except "Genuine" and "Yankee." The court did not decide their nature. It was not necessary so to do. We are warranted in going one step farther. Neither of those words can be made a trade-mark, nor are they such when combined.

§ 126. In the endeavor to ascertain the true nature of a trade-mark, we will examine *The Leather Cloth Co. v. The American Leather Cloth Co.*¹ The plaintiffs' alleged trade-mark reads as follows: "CROCKETT INTERNATIONAL LEATHER CLOTH COMPANY. NEWARK, N. J., U. S. A. WEST HAM, ESSEX, ENGLAND," which words formed a circle. Within and near the top of that circle is the representation of an American eagle, with outstretched wings, and, over the eagle, the word "Excelsior." Below the eagle are the words: "CROCKETT & Co. TANNED LEATHER CLOTH. PATENTED JAN. 24, 56. J. R. & C. P. CROCKETT, MANUFACTURERS. + 12 YDS. +." Besides that, within the circle are two other similar crosses, and this character from the printer's font: — † —

§ 127. To enable a party to obtain the intervention of a court for an infringement of a trade-mark, he must first establish the fact of his having a trade-mark. He cannot apply that name to any thing that he chooses, despite its utter lack of suitability for the purpose. The law will examine and apply the proper term of the thing presented.

¹ 11 Jur. (N.S.) 513.

Now, what is the essential constituent element of this stamp? Is it the eagle, the words, or both? We must not be misled by the application of the term trade-mark to the whole stamp, or label, even by a court. In the House of Lords, on appeal from the Lord Chancellor, Lord Cranworth said: "The plaintiffs' trade-mark, if trade-mark it is to be called, is contained in a circle. . . . Each of the trade-marks, it is true, as well that of the plaintiffs as that of the defendants, contains within its periphery an eagle, but not at all resembling each other. The rest of the device, if it is to be called device, consists merely of words intended to indicate the nature or quality of the article, the place of its manufacture, and the names of the manufacturers." Lord Kingsdown, in the same case, uses this language: "The plaintiffs' trade-mark, or what they call such," &c. It is undeniable that he used the term trade-mark to indicate the subject before the court; but it was not necessary to define that particular subject. The term was a convenient one by which to express the collocation of words and the eagle. The real question under consideration was, whether the defendants had been guilty of a fraud upon the public, in selling their goods as the plaintiffs'. The Lord Chancellor, whose decision was in process of affirmation, then rose to speak. His language, as to the matter of defining, relieves us from embarrassment. He saw the necessity of giving the alleged trade-mark its true name. He said: "I am satisfied that I assigned for my decision in the court below a ground narrower than I might have taken as the basis of that judgment. There were circumstances which induced me to think that it was necessary to consider the case from the particular point of view which I adopted, and having found that the ground was sufficient for the judgment which I gave, I did not enter into the consideration of the wider view of the subject, which has been so forcibly urged by my noble and learned friends. But, in truth, my lords, not only do I concur with them, but I am satisfied that I ought to have regarded this affix to the plaintiffs'

goods, which is here denominated a 'trade-mark,' as something which, according to the anterior usage and application of the word 'trade-mark' by no means resembles or comes within the description of any thing that has hitherto been properly designated by that name. What is here called by the appellants a 'trade-mark' is, in reality, an advertisement of the character and quality of their goods; and, dropping for a moment all reference to the incorrect and untrue statements contained in that advertisement, I will take only what is called the 'trade-mark' of the plaintiffs and the rival or antagonistic trade-mark of the defendants, and compare them together, taking them as if they were simply — what in reality they are — two advertisements, each affixed, by way of label, to the articles manufactured by the parties respectively. . . . The advertisement is the sole foundation of the plaintiffs' case, and their allegations must be reduced in substance to this: that having advertised and described their goods in a particular manner, the defendants have borrowed their advertisements and described their goods in substantially the same manner."

§ 128. What language could more clearly convey the idea that, independent of the two eagles, there was not one ingredient of a real trade-mark in either of the labels presented? The distinction between a mere advertisement and the technical commercial emblem is important.

§ 129. An abstract right in a symbol has no existence. The subject must be considered in its concrete relation. Herein a trade-mark differs from a patent or a copyright. The former exists the instant it is issued; and the latter as soon as entered. The patentee, or the author, may not choose to immediately avail himself of the benefits of the grant; and still the right exists in full vigor, unless, of course, the invention or the book be dedicated to public use by abandonment. But the registry of a trade-mark does not *ipso facto* make the mark, but merely operates as evidence of adoption, and the right to it is inchoate, and does not become a perfect right until the owner con-

summate his intention and stamp the symbol upon an article of merchandise which he desires to sell. When that is done, he will have entered into possession of the exclusive right to affix that particular symbol to the class of goods to which it has been appropriated. The symbol and the article for sale are complements of each other; and it would be as illogical to term such symbol a trade-mark before affixing it to goods in trade as to term one's loose autograph his signature, although the exact representation of the signature which he intends to apply to an instrument in writing.

§ 130. A trade-mark is nothing more nor less than one's commercial signature to his goods; and the mark and the goods bear the same relation to one another as do the positive and the negative forces of electricity to each other; and in their apposition they mutually uphold and sustain. We must be cautious to discern between things whose natures differ, and assign to each its peculiar and appropriate sign, by words which fit close to the thoughts, or the mind will be confused by a jumble of marks of commerce, of patented designs, of copyrights, of labels, of advertisements, and other matters of incongruous natures. A definition should instantly convey the true idea of the thing, and indicate the precise species of a genus. A trade-mark is in its nature separate and distinct from every thing else in the world; and yet we frequently hear of writers, lawyers, judges, by the most heedless use of the term, leading others into error. Things must be called by their right names. A homicide may mean a murderer amenable to criminal law; or he may be one whose action was justifiable as necessary to the preservation of his own life; or a sheriff reluctantly carrying into execution the sentence of a court; or a soldier in the performance of imperious duty. *Astrology*, in its etymological signification, is the science of the stars, and among the ancients it was synonymous with *astronomy*; yet no thoughtful person would confound the two terms at the present day. Before the nice distinctions connected with

the law of trade-marks were well understood, learned jurists, who adorned the bench, might have been pardoned for ambiguity of expression, in confounding labels and marks; but the time for palliating such carelessness is past, and the particular symbol of commerce must be carefully distinguished from its analogues.

§ 131. The sciolist asks, Why need we seek the technical name? Cannot justice be applied under one name as well as under another? Rights are rights, says he, whatever name they bear; and the tendency of this utilitarian age is towards simplification, so that one comprehensive term may signify many things. Now, what necessity is there for the loose, indefinite application of a scientific designation, so that it may signify many things, perhaps of natures very unlike? It may be, indeed, that in some cases the paucity of terms of art or science compels a plurality of uses for one word; but as regards our present subject, no such necessity exists. We must be exact in specifying the name of any kind of legal right, in order to obtain the remedy that the law prescribes for a given case. Generic terms must be avoided. For example, in a statute to punish horse-stealing, we would not use "horse" and "animal" as convertible terms, for the word "animal" might mean a cow, a sheep, a hog, or a dog. To prevent confusion, we must say exactly what we mean. We would not charge a person with the commission of a crime; but would specify the exact offence imputed to him. We must seek to ascertain the peculiar physiology of the thing; then its proper designation is the key that unlocks many of the secret places of the law connected with it.¹

§ 132. This question may be asked: If labels, *e. g.*, are not technical trade-marks, why permit evidence of their contents to be introduced, as is done in many cases? For this reason: although labels are not constituent elements of trade-marks, and are but vehicles for the same, all the details may

¹ See Physiology of Contracts: Anthon's Law Student.

be proven as surrounding facts, — *circum stantia*, — and should be brought forward as witnesses of a fraudulent intention. It must be conceded that any one may lawfully copy another's signature, or emblem of personality, and may publish it to the world; but if, in addition to the act of imitating, he use it in a peculiar manner to obtain a false credit, as by applying it to merchandise intended for sale, then his intent may be inferred from all the minor facts. The maxim, *noscitur a sociis*, is applicable. It is known by its companions: it is discoverable by what precedes and follows.

§ 133. We know that mere labels, notices, advertisements, and business-cards possess none of the essential characteristics of the common-law symbol of trade, and therefore are not entitled to registration. For that reason, a label reading, "For Sale at Record Office, Topeka;"¹ or one with "Gold Medal Clothing," for a legend to be affixed to wearing apparel;² or "Schenck's Water-proof Tags and Labels;"³ or the name of manufacturer, place of business, and description of goods, stencilled or painted, or labelled on said goods, would be rejected by the Patent Office as not being technical marks of manufactures or commerce.

§ 134. In one case, the applicant, a corporation created by authority of the State of Pennsylvania,⁴ for the purpose of manufacturing and selling "fruit-jars, bottles, and other vessels which are automatically and hermetically sealed when full," claimed the simple name of "Valve Jar," which was the true name of the thing made and sold by them. Those words on a label could not have the magical effect of transmuting the label into a thing of another nature. The application was rejected. So, also, where the proposed mark consisted of the words "Musical Note Paper," and the name and residence of the manufacturers of a certain kind of note-paper.⁵ A few

¹ Crane & Byron, *ex parte*.

² Hammerslaugh & Co., *ex parte*.

³ C. S. Schenck, *ex parte*; Atlantic White Lead Co., *ex parte*.

⁴ Valve Jar Co., *ex parte*.

⁵ Schmidt & Curtius, *ex parte*.

bars of music were printed upon the first page of each sheet, as a fanciful heading. The counsel ingeniously argued that there was nothing descriptive in this designation, as the paper could not truly be termed *musical*, and that the words were not a mere label, but in verity were an arbitrary symbol,—a good trade-mark. Rejected.

§ 135. The words “Johnson’s American Anodyne Liniment” shared the fate of the preceding case, and upon the same grounds.¹ The answer to the application was that any person by the name of Johnson has a perfect right to make and vend liniment, anodyne liniment, American liniment; and, in offering it for sale, to call it by its proper name. The right to the use of the combination of words not being exclusive, said words could not be a trade-mark, being merely a label or advertisement, and nothing more.

§ 136. A slight degree of hesitation was felt in rejecting the words “True-fit Shirts,” and “Cable-stitched Kid Gloves;” but upon reflection it was decided that these combinations of words expressed the correct names of the articles to which they were affixed, and were but the use of ordinary language, free to all who sell true-fitting shirts and gloves made with the cable-stitch.²

§ 137. And still more hesitation was experienced when were filed the words “James Hennessy, Cognac,”³ as a mark used upon brandy by the applicants or their predecessors in business for fifty-five years. This seemed to be a matter of hardship. Yet for more than half a century the firm had mistaken a mere label for the time-honored, dignified trade-mark. Remedy for its violation must be sought under local laws, or under the general powers of a court of equity for unfair competition in trade.

§ 138. If one claim titles of firms, or names of manufactures, to which he shows no vested right, he will not be

¹ I. S. Johnson, *ex parte*.

² Two cases, Fisk, Clark, & Flagg, *ex parte*.

³ James Hennessy & Co., *ex parte*.

deemed to possess even a label. As an instance of persons seeking their own discomfiture, while swelling the revenue of the Patent Office by one hundred dollars, read this: Four applications.¹ Claims,—the words “Bristol Watch Co., Bristol, Mass. ;” “G. M. Wilson, Chicago, Ill. ;” “New England Watch Co., Providence, R. I. ;” and “Chicago Watch Co., Chicago, Ill.” These names, said the applicants, are used upon watches and watch-movements; and this same petition states that no other person, firm, or corporation has a right to the use of said trade-marks, or of marks substantially the same. Not even substantially the same! Rejected.

§ 139. **What is Merchandise?**—This seems at the first glance to be a puerile question; and yet it is one that has sometimes puzzled experienced men of business. We all know that it means the objects of commerce: whatever is usually bought or sold in trade, or market, or by merchants; wares, goods, commodities. Yet a case may easily be supposed where the question cannot be answered without hesitation, when considered in its relation to a trade-mark.

§ 140. This question came up in the Patent Office, in 1872, in an application for a design-patent for a label with a coupon attached.² The whole value of the label depended upon the peculiar configuration, and was intended to be sold to manufacturers of a certain kind of paper collars, &c. He who bought that label thereby obtained a license to sell that particular kind of goods, and at the same time he had furnished to him a certificate of good workmanship. Now, what was intended to be sold? It was the label. But the label would have been incomplete without a peculiar mark. Then that peculiar mark could not be considered to be a trade-mark, strictly speaking; for a trade-mark is merely the index to something that is offered for sale. In this case, it was actually incorporated into, and became an essential component part of the com-

¹ Louis Strasburger & Co., *ex parte*.

² C. C. Morgan, assignor to Union Paper Collar Co. of New York.

modity. That answers the requirement of the law in relation to designs. The label was a design, — a matter of configuration of a new and useful article of manufacture; and without the peculiar mark it would have no more served its destined purpose than would a college diploma without signature. After deliberation, the matter was decided to be a design.

§ 141. In the Court of Paris, in 1859, *Lalande et al. v. Appel et als.*,¹ it was decided that tickets or labels, composed and sold by a lithographic printer, could not be considered as trade-marks. The plaintiffs, lithographers, complained that the defendants had counterfeited the designs upon tickets or labels destined to be sold to vendors of liquors and cosmetics, to be placed by them upon flasks or bottles. The defendants, as a point of law, contended that the plaintiffs had no right to recover, for the reason that the designs upon the tickets were neither designs of manufactures, nor marks for the same in the sense of the law of 1793. The reasoning of the court is perfectly convincing. Among other matters, it was *held*, “That the plaintiffs’ claim was ill-founded, because the tickets in question were the special objects of their commerce, and therefore could not be regarded as trade-marks; that the trade-mark, regulated by the law of the 25th of June, 1857, is the characteristic sign by means of which commerce distinguishes the products of fabric or objects of commerce; that the mark itself cannot be an object of commerce; that, by the use which a merchant makes of a ticket, in applying it to a vase containing the product of his manufacture, it is possible that the ticket may become for him a trade-mark, — subject to the fulfilment of all legal formalities, — for it may be then, as to him, a sign or distinctive seal of his products, without being the very object of his commerce: but, as to the plaintiffs, the tickets can be nothing but the special object of their industry. Judgment for defendants. On appeal, the decision was affirmed.

¹ *Annales de la Prop., etc.*, tome 5, p. 248.

§ 142. The same question was considered in a case in the Patent Office, where a lithographer¹ applied for a trade-mark to be affixed to labels manufactured and sold by him to merchants and others. It appeared, however, that he intended the mark to be stamped or printed upon the label, not as a constituent element, but as a sign of authenticity. Under that view of the matter, a certificate of registry was allowed.

§ 143. **Essential Characteristics.** — There are certain infallible indicia of the nature of the symbol known to commerce and jurisprudence as a trade-mark. These are: 1. *Invariability*, *i.e.*, fixed, positive, unmistakable; 2. *Individuality*, such a difference from other symbols as to indicate origin and ownership; 3. *Universality* of a right to its use, *i.e.*, good as a representative of, or substitute for, the owner's signature all the world over; 4. *Exclusiveness* of the right to use; 5. *Application to merchandise*; 6. *Use in lawful business*; 7. *Truth and good faith*; 8. *Duration unlimited* but by the trade itself. (*Protection, however, may sooner cease.*)²

¹ Samuel Crump, Cert. No. 637.

² Sec. 78, Act of July 8, 1870.

CHAPTER IV.

INDICATION OF ORIGIN OR OWNERSHIP.

Meaning of Phrase. — Disagreement of Judges. — Name or Address of Manufacturer or Trader not necessary Ingredient of Mark. — Use of word "Quality." — Designation of Occupation or Trade cannot be exclusively appropriated. — Chemical Products, Names of. — A Man's Name may lose Idea of Personality. — Instances: Names of Medicines, Boots, Carriages, Guns. — Geographical Names as Trade-marks.

§ 144. **Indication of Origin or Ownership.** — This is a phrase that of late years has been the source of much perplexity, simply because not understood in its legal acceptation. The Supreme Court of the United States, in *The President, &c., of the Del. & Hudson Canal Co. v. Clark*,¹ repeated a proposition that as a rule has been frequently enunciated, and settled beyond question, viz.: The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer.

§ 145. The difficulty is this: What does distinctively indicate such origin or ownership? That question can be intelligently answered only after the examination and collation of many adjudications. Each case necessarily depends to a great extent upon its own peculiar surroundings. What might indicate origin in one matter might not in another. Sometimes the name of a proprietor or of a place is required to clearly convey the indication; again, any simple device may

¹ Patent-Office Official Gazette, March 26, 1872.

by association with a particular person or place convey all the information required. What impression does the mark of commerce leave upon the vision of the beholder? What associations are called up by the sound of a word? A purchaser usually instantly recognizes a symbol, and buys on its faith, just as one might purchase bonds of the United States upon the most superficial glance. He asks for a 10-40, a 5-20, or a 7-30, and does not think of keenly scrutinizing its various indicia of genuineness. Its origin is clearly indicated. He has not the slightest suspicion that the thing a broker sells to him has been simulated. One buys a barrel of flour or a fancy toilet article with the same apparent carelessness. The true test is confidence. The brand, or the mere name of the article, satisfies him. Good faith is the bond of commerce; and without it doubt and hesitation will fetter enterprise and restrain trade.

§ 146. The words "Congress Water" were held by the New York Court of Appeals, in *Congress and Empire Spring Co. v. High Rock Congress Spring Co.*,¹ to appropriately indicate both the origin and the ownership of the water flowing from Congress Spring, to which place the plaintiffs had the sole title. The defendants' counsel argued that the words, as applied to a natural element, were an inexplicit name, expressing no idea of property or origin, and that the said mark lacked the essential elements, being used to designate the article itself by its proper appellation, therefore not the subject of exclusive appropriation; that, in fact, it expressed no more than the name of the spring, like "Avon Springs," "Lebanon Springs," "Sharon Springs," and "Cheltenham Springs," being names of particular fountains, indicative only of the place whence they issue. It was also insisted that the doctrine of trademarks has never been applied, and is not applicable, in letter or in spirit, to the sale of spontaneous natural products of substantially the same nature, being appropriate only to arti-

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

ficial compounds, or products, originated by the science, or skill, or diligence of man; and that this water, not being the creation of man's skill or industry, but being the gift of nature to all, no one could bottle and name the elements, and claim exclusively the new appellation by which they have become known in the market. It was said by counsel that one might as well bottle the pure air of the mountain, and prevent another from selling the same air by the same name. A preliminary injunction having been dissolved at special term by Rosekranz, J., the plaintiff appealed to the general term, which affirmed the action of dissolution. James, J., in rendering the opinion of the court *in banc*, said that he was not aware that the question of the application of the law of trade-marks to names given to spontaneous or natural products had, prior to that time, ever come before the courts for adjudication; and that, in all the cases, the principle of the law is stated and restated, as applicable to protect the skill, industry, and enterprise of mechanics, manufacturers, and inventors, and hence only applicable to artificial products. He seems to have excluded from consideration the idea of commerce, which may deal in commodities with which the skilled industrial classes have nothing to do; and which, although natural products, as coal, marble, or animal deposits, like guano, have distinctive marks entitled to protection. The case went to the highest court. The true principle involved had by that time become clearly apparent.

§ 147. The Court of Appeals considered these two questions: 1. Can the owner of a peculiar product of nature be protected in the exclusive use of a name belonging to it alone, and employed by him as his trade-mark in the sale thereof? 2. Does the name or trade-mark used in the case before us by the plaintiffs indicate the origin, ownership, or place of that product, and is it one in the exclusive use of which the plaintiffs should be protected? The court, by Folger, J., said, *inter alia*, that here is a particular article of which the owners

of this spring possess the only source, and which can be had only from them. The violation and the wrong are the same whether the commodity is one which the hand has made, or which Nature has put into the hand of man. Certainly so, if into the hand of but one man has it been put. It is a matter of property, and the profitable use of property. If one use the name of another for the purpose of securing to himself, in the disposition of property, advantages which belong to that other, the fraud is complete, and the remedy ought to be complete. By the application of capital, business sagacity, and enterprise, this spring and its products have become extensively known, and favorably received. When one wishes for the medicinal water which he has used before, he inquires for it by its specific name. And it is this name, the trade-mark of the plaintiffs, which is the short phrase between buyer and seller which indicates the wish to buy and the power to sell water from that origin, that place, of that ownership. This phrase, this device, is the trade-mark of the plaintiffs, and is of value to them, as thus designating the verity of its origin. They have the right to be protected in its exclusive use, for none other can use it with equal truth, and none other has equal right to employ it for the same purpose. *Held*, the words "Congress Water" are, under the circumstances set forth, a valid trade-mark indicating origin, and also ownership. The judgment below was reversed, with costs, and a new trial ordered.

§ 148. In *Falkinburg v. Lucy*, before all the justices of the Supreme Court of California, in 1868,¹ the court said that the owner of a mark would be protected in its exclusive use, but only so far as it serves to indicate the origin, or ownership, of the goods to which it is affixed, to the *exclusion* of such symbols, figures, and combinations of words which may be interblended with it indicating the name, kind, or quality of the article. In this case, the plaintiffs claimed the entire label as their

¹ 35 Cal. 52.

trade-mark, and asked to be protected in the use of it as a whole. The court said: "Only so much of their label as serves to indicate that they are the manufacturers or vendors of the washing-powder can be considered as constituting the legitimate characteristics of a common-law trade-mark." The symbol must tell its own story. It does not serve its intended and true purpose until associated with a certain person or article. In *Filley v. Fassett*, before the Supreme Court of Missouri, *in banc*, in 1869,¹ it was held that the words "Charter Oak," cast on cooking-stoves, were sufficient to point out the true source and origin of the stoves, and were therefore possessed of the requisite characteristics of a trade-mark. In *Fetridge v. Wells*, in 1857,² Duer, J., held that the words — "The Balm of Thousand Flowers" — might suffice for this purpose, unless, of course, they were descriptive or fraudulent. *Boardman v. The Meriden Britannia Co.*, in the Supreme Court of Connecticut, in 1868,³ fully recognizes and enunciates this doctrine.

§ 149. As an instance of the disagreement of judicial minds as to what in contemplation of law constitutes indication of origin, we will cite *Ferguson v. The Davol Mills*, in the Common Pleas of Philadelphia, in 1868.⁴ The facts are briefly these: More than thirty years before, the complainants devised, and ever since used for certain goods, known as silesias or bleached and dyed cotton twillings, a certain mark, 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 on it except the printed letters "No." at the top, and at the bottom of the same space the letters "Yds." By long use this mark had become identified with the said goods, and the goods came to be known in the markets of the world, and to the trade everywhere, by the said mark, and are

¹ 44 Mo. 173.

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

³ 35 Conn. 402.

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

known and called by the name of the "K" silesias. The defendants manufactured and offered for sale goods similar in appearance, but greatly inferior in quality to the complainants' "K" silesias, put up in wrappers similar to theirs, and a counterfeit of their label and mark. The defendants asserted that the use of the letter "K" and accompanying device, as printed by the complainants and pasted on their goods, did not constitute a trade-mark such as the law will protect. Allison, P. J., said: "The device and letter 'K,' which constitute the alleged trade-mark, have no name, words, signs, marks, by which in any possible manner or degree the origin or ownership of the silesias manufactured by the complainants are indicated, or the place of sale or manufacture pointed out, to distinguish them as the goods manufactured or sold by the complainants. And, failing in this, it follows that this application for an injunction cannot be granted. And this will justify itself when it is remembered that these circular lines and spaces, and intervening ornamental tracings and letter 'K' in the centre, with elliptical cross lines upon its face, affords no protection to the public against imposition by the complainants from the sale of a spurious or inferior article of silesia. They could flood the market with such inferior article, stamped with what they call their trade-mark, and the public would be wholly unable to ascertain who had manufactured and sold the goods. Protection is given only in consideration of the guaranty of the integrity of the manufacturer or merchant, certified by his trade-mark. When the device fails to accomplish this end, it is no trade-mark, and all claims founded thereon must be rejected. The simplest case of a trade-mark is the name and address of the claimant; and it is absolutely requisite that a device or symbol should perform the office of a finger-board: should indicate the name and address of the manufacturer, to invest it with the attributes, and entitle it to the protection, of a trade-mark. The device of the complainants does not contain, within itself, a

declaration to the public that Ferguson Brothers are the manufacturers of the silesias stamped with their device: it points to any other person as clearly as to them, and therefore it is obvious that the Davol Mills, or Fales, Wharton, & Co., in imitating this device and placing it on an article of silesias of their own manufacture and sale, have committed no legal wrong of which Ferguson Brothers have any right to complain. The morality of the use by them of the simulated label is another question; for simulated it is, beyond all doubt, — so much like the original as to be scarcely distinguishable from it.” Injunction refused.

§ 150. This decision is *sui generis*. The course of reasoning of the learned judge does not commend itself to any calm, thoughtful intellect. With all due deference to the opinion of Judge Allison, criticism is imperatively demanded; for it is the emanation of a respectable tribunal, and cannot be silently acquiesced in without positive injury to the cause of justice. It has been quoted in more than one case by counsel driven to desperate shifts, and has been strenuously urged as an authority. He has said that the device of concentric circles enclosing the letter “K” does not in any possible manner or degree indicate origin or ownership. Why not? Because, said he, the place of sale or manufacture is not pointed out; and he intimated that the device, to be a valid trade-mark, should contain the name and address of the claimant. If so, how could a great number of symbols reported in adjudicated cases have been recognized as perfectly valid, when those symbols were no more expressive than that under discussion? As instances, consider the distinctive names and designations “Excelsior,” “Climax,” “Empire,” “Charter Oak,” which were deemed perfectly good trade-marks for stoves;¹ the word “Excelsior,” for soap;² “Ethiopian,” for stockings;³ “Cocaine,” for hair-oil;⁴ “A C A,”⁵ which the court virtually held might be a valid trade-mark.

¹ 44 Mo. 173.

² 9 L. T. R. (N.S.) 199.

³ 10 Jur. 106.

⁴ 3 Keyes, 594.

⁵ 2 Sand. S. C. 599.

§ 151. Not one of these cases indicated the name, or even the address, of the manufacturer, or of the merchant. Yet they fully answered the legitimate purposes of a trade-mark. The judge said that the symbol in the Davol Mills case was no protection to the public against imposition by the complainants from the sale of a spurious article; for they could flood the market with an inferior article, and the public would be wholly unable to ascertain who had manufactured the goods. Now, a trade-mark to be worth any thing must be recognized by the public, and must be associated with a particular person or firm, so that the purchaser instantly says in his own mind, That is the article I wish: I know it is genuine, because it bears the well-known mark of So-and-so. What is the logical deduction of the judge? The mark is not associated in the mind with anybody or any place. It has not the slightest intimation of origin. By looking at it, the public cannot possibly guess who made the goods, or where they were made, or who offered them for sale. It promises nothing. No faith is given to it; for it is absolutely meaningless. It is virtually a blank. Well! the public not recognizing the symbol as any man's manufacturing or commercial signature, and perceiving in it no guaranty of the integrity of the manufacturer or merchant, yet bestow upon it the most implicit confidence! Through their infatuation the market is flooded! We answer, if the public buy on the credit of the mark, that is the highest evidence of its validity. Knowing the currency of their mark, its owners strain every nerve to sustain its reputation. To send out spurious goods with its impress upon them, would be to kill the goose that lays the golden egg. We must conclude that his Honor erred. If its thirty-year-old reputation had not made the symbol valuable, it would not have been counterfeited. Yet it was simulated by the defendants, so that their false token was not distinguishable from the genuine. What essential ingredients of a lawful trade-mark did it lack? None!

§ 152. When there are several mints for coining money in one country, some distinctive letter or mark usually indicates at which one a piece was coined. In the United States the three branch mints at Charlotte, Dahlonega, and New Orleans have used the initials "C.," "D.," or "O.," respectively. The principal mint at Philadelphia had no such mark. Yet the single letter, when found upon a coin of precious metal, was a sufficient indication of its precise origin. In South America, some of the mints have used monograms, or involutions of letters, — one complex character indicating Lima, and another Potosi.¹ The metal in one coin may be finer than that in another of the same nominal value. Preference can be awarded by means of the mark. It is just the same with any other commodity. Two articles may be of the same outward appearance, the same color, weight, size. The purchaser has no guide to assist his judgment, except the reputation of a certain manufacturer. He discovers his mark of authenticity and guaranty. It is enough: he buys.

§ 153. The *Amoskeag Manufacturing Co. v. Spear*,² before Duer, J., in the Superior Court of the City of New York, in 1849, and already discussed, is a leading case. The plaintiff averred that the letters "A C A," relied upon as a valid trade-mark, were intended to denote as follows: "A C," Amoskeag Company, and "A," first quality. These letters were affixed to a kind of cloth called "tickings," which by much care and skill, and at great expense, the plaintiff had brought to such a state of perfection, that the best quality had obtained a high reputation throughout the country. The defendants denied the allegation of the meaning of the said letters, and averred that they referred altogether to the quality of the tickings; and they denied that the plaintiff's goods were known as the "A C A tickings," without the addition of the name or place of manufacture, but that they were known as the "Amoskeag

¹ Eckfeldt and Du Bois, Manual of Coins and Bullion, p. 17.

² 2 Sand. S. C. 599.

A C A tickings," in like manner as the defendants' goods were known as the "Lowell Premium A C A tickings." The answer also averred that all manufacturers of tickings used letters to denote the different qualities, and that, in every case, the name of the maker or place of manufacture was added, to enable the public to distinguish between articles of similar quality made by different manufacturers. The answer further denied that the defendants had used these letters to enable them to sell their tickings as those manufactured by the plaintiff, or that their use had produced that result; and admitting that they had sold their goods as the genuine "A C A tickings," it was always with the designation that they were "Lowell," and not "Amoskeag," tickings. The defendants, for five years before the action was brought, had used a label corresponding with that of the plaintiff in size, color, fancy border, position, general arrangement, and size of the letters; and also containing, in large capitals, the letters "A C A." A preliminary injunction was granted, restraining the defendants, according to the prayer of the complaint, from using on their tickings any label such as that which they had used, or any label similar to the plaintiff's, or an imitation of it, or having thereon the letters "A C A." This was a motion to dissolve or modify the injunction, which had been granted *ex parte*, on giving security.

§ 154. The legal title of the plaintiff in the present case to the exclusive use of these significant letters, "A C A," was denied. They were said to be but an indication of the quality of goods, and that they were used as all manufacturers use letters to denote the different qualities. If so, it is clear to any comprehension that they did not constitute a trade-mark. The question to be decided was whether they did merely denote quality, or whether they did not constitute the peculiar symbol that indicated origin. If the said letters, as used by the plaintiff, were merely an indication of the relative quality of its tickings, they must be expunged. As the plaintiff

could not have acquired, by prior occupation, an exclusive right in the use of the words "First Quality," or "Superfine," it could not have acquired by similar means a right to an exclusive use of any letters, marks, or other signs, which are merely a substitute for the words, and intended to convey the same meaning. It is immaterial, said the judge, whether words, or letters, or figures, or any other signs are used, if the single fact which they are used to indicate or declare is a truth that other manufacturers or dealers have an equal right to express and communicate. The judge found, as a fact, that its letters "A C A" were employed by the plaintiff to indicate quality, and for no other purpose. He said that "It is doubtless true, as is stated in the complaint, and sworn in many of its affidavits, that the tickings of the plaintiff to which its A C A is attached, have for many years been known in the market as the 'A C A tickings;' but this fact neither alters the meaning of the letters, nor takes from others the right to employ them. If the letters designate only the quality of the goods, and not their origin or ownership, the tickings of the defendants, if the best quality of those which they sell, are as truly 'A C A tickings' as those of the plaintiff. The words 'Power Loom' are found upon the label of the plaintiff, yet it is not contended that I could restrain the defendants from using the same words as they have done upon their own. If there exists a distinction, I am unable to perceive it. The claim of an exclusive right rests in both cases upon the same grounds: it is valid in both, or in neither." The learned judge held that the conclusion was irresistible, that the three letters were used to designate the best quality of tickings, and for no other purpose. He therefore struck from the injunction the words "or having thereon the letters 'A C A,'" but retained the rest.

§ 155. What conclusions are deduced from this Amoskeag case? Let us again glance at the facts. A preliminary injunction had been granted upon the *ex parte* application of

the plaintiff. It had made out a *prima facie* right. Upon the coming in of the answer, which denied the plaintiff's allegation of an exclusive right to the letters "A C A," it was moved to dissolve or modify the injunction. As to the imitation of the label in all its features, there could be no gainsaying. It was apparent. Testimony could not counter-vail the evidence of ocular demonstration. But the label was not a technical trade-mark. Perhaps the three letters were. It was so asserted on one side, and denied on the other. It was an equipoise. In such a case, an equitable remedy would, by the rules of equity, be withheld. Take the language of the judge in rendering his decision: "I can give to the defendants, however, the benefit of the general rule, by so modifying the injunction as not to restrain them from using the letters A C A, until the legal right of the plaintiff shall have been established by the verdict of a jury in this suit, and I am satisfied that it is this course I should be bound to follow even were my opinion as to their legal right widely different from that which I have expressed." The court did not decide that the three letters could not be a lawful trade-mark. It decided that the case as presented did not establish the plaintiff's right. A jury must pass upon the disputed right.

§ 156. This matter had a sequel in the Patent Office, in 1872. The Amoskeag Manufacturing Company filed an application for registration of a trade-mark, consisting of the said three letters, A C A. The label on which the letters are printed is substantially that before described, — the same that has been used for thirty-six years. After a careful examination of authorities, the letters were recognized as containing in themselves the essential characteristics of the manufacturer's and merchant's symbol called a trade-mark; and the certificate of registration was duly issued.¹

§ 157. In *Stokes v. Landgraff*, at a special term of the Supreme Court of New York, in 1853,² Strong, J., clearly laid

¹ No. 713, dated March 26, 1872.

² 17 Barb. 603.

down the doctrine of the Amoskeag case. In respect to 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, no property 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. The plaintiff was a manufacturer of glass, at the village of Clyde, in the town of Galen, in the county of Wayne, State of New York. His complaint alleged that he was entitled to the exclusive use of the words GALEN, LAKE, CYLINDER, WAYNE, NEW YORK, which had long been used by his predecessors and himself to denote the qualities of glass made at his establishment, and to distinguish the same from that made by others. A temporary injunction was granted, which the defendants applied to have vacated. The question to be determined was whether the words so used by the plaintiff were embraced by the law of trade-marks. Did they indicate origin or ownership, or merely denote quality?

§ 158. In his complaint, the plaintiff alleged that the word "Galen" was used to denote the first quality; the word "Lake" to denote the second quality; the word "Cylinder" to denote the third quality; the word "Wayne" to denote the fourth quality; and the words "New York" to denote the fifth quality of glass manufactured at his works; and that the said marks or brands had ever been and still were used to denote and distinguish the respective qualities above mentioned. It was also alleged that the defendants "have manufactured for sale large quantities of window-glass, greatly inferior in quality and value to that manufactured by the plaintiff, and caused it to be put up in boxes or packages, and fraudulently caused the said boxes or packages to be branded or marked

with the words" mentioned, "in imitation of the several brands or marks used by the plaintiff, and with intent to cause it to be believed by the purchasers, builders, and the public, that such glass was manufactured at the glass-works belonging to the plaintiff, and to enable the defendants to sell the said glass as the manufacture of the plaintiff." The answer denied that the said words were used by the plaintiff to distinguish the glass manufactured by him from that manufactured by other persons, or at other manufactories; and insisted that they were used by both parties to distinguish the several qualities of their glass. They also denied any design to divest the plaintiff's trade, and that they made an inferior article.

§ 159. The court held, that in regard to the words "Cylinder," "Lake," and "New York," there was no propriety, or even plausibility, in the claim that they were used by the plaintiff, in part, to distinguish his glass, or glass of his manufacture: that they were not adapted to that end. Besides, the practice of manufacturers of glass, as above stated, and the appearance of the plaintiff's marks or brands in connection with it, showed that they were used to denote quality; and the plaintiff admitted that was, in part, his object. Some other of the words had not been used by the defendants. Injunction dissolved. This case was appealed to the general term, in 1854, and the decision was affirmed.

§ 160. Let us take another look at *Stokes v. Landgraff*. What principles governed the decision? Here are facts that will assist in the elucidation. The plaintiff's complaint was rather inartificial, to commence with. It admitted too much. The word "quality" was used in a loose sense. Did it mean merely to denote the different grades of a common article of manufacture? Was it not meant to be said that the words were employed only "to distinguish the glass manufactured by the plaintiff from that manufactured by other persons, or at other manufactories"? To say the least, the language was unhappy. Annexed to the answer are transcripts of the several

marks or brands both of the plaintiff and defendants, from which it appears that in each of the plaintiff's marks or brands, in addition to one of the words above named, are his name, and the village where his manufactory is situated, with a representation of the size and number of feet of glass, as "Stokes — Clyde — Galen, 8 × 12 — 50 feet;" or "Stokes — Clyde — Cylinder, 8 × 12 — 50 feet," &c.; and that each of the defendants' marks or brands, having either the words "Galen," "Lake," or "Cylinder," has, in addition, the name "Landgraff," with a representation of the size and quantity of glass, as "Landgraff's Galen, 8 × 12 — 50 feet;" or "Landgraff's Cylinder, 8 × 12 — 50 feet," &c. The brand of the defendants having the name "New York," is in this form: "Cleveland, New York," with a representation of size and quality as above given. Each party used the name of the place of manufacture, — Clyde, and Cleveland. The names in dispute were not so affixed as to be the salient points that would strike the purchaser's eye, arrest attention, and operate as a guaranty. No one would pin his faith to any one of the words by itself. The names had no blandishments to allure and captivate. They meant no more than would the numerals 1, 2, 3, &c.; indications of comparative quality. But the strongest objection is this: most of the words claimed are names of localities. No one can usurp geographical names which all in common have a right to use. But the rule as to the exclusive use of a name of a locality must be taken with its limitations and qualifications. If the plaintiff had owned the whole village or spot whose name was borrowed, he might have a right to the name, as in the Congress Spring case;¹ or if he had used a name which others in the same village had a right to use to denote a peculiar natural product, — one not found in any other place,² — although that would not be, strictly speaking, a trade-mark, for it would lack the essential element

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

² "Akron" case, 49 Barb. 588.

of exclusive right, he would have rights which a court of equity would protect. The plaintiff's case did not make out his claim to any remedy. The words were not used as trade-marks. It was therefore unnecessary to consider the question of priority.

§ 161. **Terms in Common Use** to designate a Trade or Occupation, in connection with other words indicating that a particular class of merchandise of the same general description is specially dealt in, cannot be exclusively appropriated by any one as a trade-mark. In *Choynski v. Cohen*,¹ Supreme Court of California, 1870, the plaintiff claimed the words "Antiquarian Book Store" as his peculiar symbol. The court said that the case depended upon the effect of the word "Antiquarian," as used in connection with the words "Book Store." As applied to a book-store, it can have no other meaning or effect than to indicate to the public that the proprietor deals in a certain class of books; to wit, ancient books, or books pertaining to antiquity. Any one reading the sign, "Antiquarian Book Store," over the door, would naturally expect to find there for sale either ancient books, or books treating on subjects connected with antiquity. . . . It could not, by even a forced construction, be made to signify that the plaintiff's business had been long established, and was of ancient origin; for the complaint informs us that the business was established in 1863, and that it had the name of the "Antiquarian Book Store" from the beginning. It was used precisely in the same sense that the words "Law Book Store," or "Medical Book Store," or "Divinity Book Store," would indicate that law, medical, or religious books were for sale. In all such cases, the words employed are but advertisements that certain goods are there sold.

§ 162. The case of R. W. English, appeal from the Examiner, November 2, 1870, to the Commissioner of Patents,² has been the source of error to all who cited it as an authority. The applicant offered for registration three so-called trade-marks.

¹ 39 Cal. 501.

² Commissioner's Decisions for 1870, p. 142.

The first reads thus: "R. W. English's X Brooms. Buffalo, N. Y. Order English's X Brooms." The two others are precisely the same, except that in one the character X X and in the other X X X are substituted for the X in the first. "X" was alleged to be the distinguishing feature. The applicant set forth as follows: "Heretofore I have been in the habit of using 'X' to distinguish my brooms, using 'X' for one quality, 'X X' for another quality, and 'X X X' for still another quality, by printing, stamping, or affixing the same to the brooms in any convenient manner." The Examiner rejected the applications. He said: "The label filed has no new or peculiar characteristic to make it a lawful trade-mark. The letters used in printing it are of the ordinary kind, set up in a common way, and the letter X, used to express quality, is commonly used for this purpose by all liquor dealers, particularly for marking the qualities of ale." A late commissioner, in his decision overruling the officer below, said: "The question, with reference to trade-marks, is not whether the particular mark is new in its application to goods of all kinds, but whether it is new in the special application proposed for it. In the case of this species of property a double use is permissible. The fact that a mark has been used for a bottle is no bar to its use by another for a broom, or by another for dry-goods, or by another for an agricultural implement, or for hardware. One man may choose to call his knives 'X L' knives, and another his baskets 'X L' baskets. The use of this mark in no way implies that the baskets were made by the manufacturer of the knives, or *vice versa*." He therefore held that the letter X, when employed to denote a particular article of manufacture, being in no way descriptive, but a new arbitrary character, which may, when adopted and used, indicate the origin and ownership of the goods to which it is applied, may well constitute a proper trade-mark. He further held that X X and X X X are as distinguishable from X as the latter is from Y or Z, or any other character. He also said that the

use of the letter X is not an ordinary mode of indicating quality. The three cases were thereupon registered.¹

§ 163. The general legal proposition, that two men may adopt the same symbol, if to be used upon different classes of goods, requires no comment. The question is this: Did the letter X, under the circumstances presented, constitute a lawful trade-mark? If used merely to indicate quality, it clearly did not. That point is too well settled to be disputed. What idea is conveyed by the use of the letter X? Has it not from its long association come to be well recognized as a mere indication of quality, as much as the numerals 1, 2, 3? That is a pure question of fact. It was a bare assumption to hold the contrary in the absence of the slightest evidence. How could any tribunal take judicial note of the fact that it was otherwise? The case before the Office was one where the applicant positively alleged that he used the letter, single, doubled, or trebled, as an indication of the respective qualities of his brooms. The allegation of the specification was conclusive. The fact was there enunciated. The Commissioner travelled out of the record. His opinion, then, as to the doctrine that the letter X does not generally indicate quality, is but an *obiter dictum*, — a way-side opinion, not binding in other cases.

§ 164. There must be some word, or sign, or device, other than the generic name, and words descriptive of quality. Under this rule, the proposed trade-mark "Beeswax Oil" was refused registration.² The name "oil" is generic. The word "beeswax" is doubtless intended to be more or less descriptive of the quality or nature of the oil. The words "Razor Steel," as applied to the blades of knives, shears, and other cutlery, were rejected.³ The word "razor" is purely descriptive, and the word "steel" a generic name, and being limited to neither person nor place, so as to indicate either origin or ownership, they cannot be regarded as constituting a legal trade-mark.

¹ Nos. 86, 87, and 88, Dec. 6, 1870.

² Commissioner's Decisions, 1871, p. 97.

³ *Ibid.*, p. 113.

“Cundurango Ointment, C. O.,”¹ is not a legitimate trade-mark; “ointment” being a generic term, and “Cundurango” the name of a plant extensively known, and the initials “C. O.” immaterial, and not likely to be noticed. The applicant in another case sought to register the word “Invisible,” to be applied to packages of powder intended for beautifying the complexion. Mr. Commissioner Leggett said: “That the word ‘invisible’ might be used as a lawful trade-mark, I have no doubt. But when used to indicate the character of the thing to which it is attached, it becomes descriptive, and cannot be monopolized. Such, without doubt, is the application of the word ‘invisible’ in this case. The intention of the applicant in the use of the word evidently is to indicate that the powder, when applied to the skin, is imperceptible or invisible; hence the word is used with its ordinary signification, as in the description of shades of colors, and when so used is, by the rulings of the courts, excluded from the list of devices that may become legitimate trade-marks.”²

§ 165. The courts of France have made a number of decisions upon this point. In the Court of Colmar, in 1857 (*Rian v. Bernheim*³), it was *held*, the denomination *toile ménage* is not a special denomination which can become the exclusive property of a manufacturer. The term had by long use become common to commerce. The Tribunal of Commerce of the Seine, in 1858 (*Thibierge v. Dupont et als.*⁴), for the same reason rejected the words *benzine parfumée*. The Tribunal Civ. of the Seine, in 1861 (*Mauprivez v. Buchet et als.*⁵), had this case: The plaintiff’s mint-drops were marked in relief, “Peppermint, London.” The defendant, who had imitated the mark upon the same class of goods, for defence argued that the words were but an indication of the nature of the preparation, and therefore could not become private property. But

¹ Commissioner’s Decisions, 1871, p. 284.

² *Ibid.*, p. 289.

³ *Annales de la Prop.*, tome iv. p. 216.

⁴ *Ibid.*, p. 400.

⁵ *Ibid.*, tome vii. p. 335.

the court held that the union of the two words, placed in relief, and with characteristics determined and distinct, were a particular sign to indicate to the public that they belonged to the inventor thereof. This in effect decided that, by the manner of use, these words had acquired an individuality sufficient for the destined purpose. The same parties appeared before the Court of Paris, in 1864, on appeal.¹ *Held*: "peppermint" is but the English appellation, but by long use in France it has become common to commerce. The simple indication of this product, in one language or the other, cannot be protected. The court plainly intimated that a particular form or disposition of letters might make it valid as a personal sign. This would virtually make it a distinctive sign of origin.

§ 166. When a chemical product takes naturally, in certain given conditions, the form of a known object, its denomination cannot become private property. The case of *Barnett v. Kübler*, in the Court of Paris, in 1866,² illustrates this doctrine. Everybody knows, at least by name, the scientific toy called the "Serpent of Pharaoh." It is sold under the form of a little cone covered with tin-foil. When set on fire, it acquires an extraordinary development, and, with the movements, takes the form, length, and color of a real serpent. The demandant described its mode of manufacture. He employed the *sulphocyanide of mercury*, obtained by the action of nitrate of mercury on the *sulphocyanide of potassium*. The containing box had upon it a notice of "Poison." The demandant had patented the toy, but the patent had been invalidated, as being for a worthless invention. As inventor, he had given to it the name of "Serpent of Pharaoh." It was sometimes called the "Artificial Serpent" and the "Eggs of Pharaoh." The defendant sold a similar article under the name of "Magic Serpent." An action was brought for infringement of the alleged trade-mark. Among other things, the defence set up that the toy was

¹ *Annales de la Prop.*, tome x. p. 320.

² *Ibid.*, tome xii. p. 144.

poisonous, and consequently contrary to law, and to the public security; but on that point the court ruled, that as the attention of the Council of Health had several times been called to the article, and nothing had been done to prohibit the sale of it, the conclusion was warranted that it presented no serious danger, and therefore was not unlawful. The next question was this: Do the words "Serpent of Pharoah," as used, constitute a trade-mark? If yea, is the use by the defendant of the term "Magic Serpent" for a similar article an infringement upon that mark, as a colorable imitation? In support of the claim, the counsel, M. Pataille, eminent for learning in the law of the subject, argued thus: The words "eggs" and "serpent," employed to designate the thing which was neither eggs nor a serpent, but which, upon combustion, gave a resemblance more or less removed, are clearly fancy names, belonging to him who first makes use of them. In support of that theory, he cited the decisions of the Court of Paris and the Court of Cassation in the instance of "Pearls of Ether," a title given to ether-pills, which, as pharmaceutical products, belong to the public in general, and by their form and silvery envelope resemble pearls, and which words notwithstanding were held to be a trade-mark.¹ *Held*, the term "serpent" does not constitute a trade-mark, it being natural and necessary to describe the article. The use of the word "serpent" by the defendant is not piracy. So the words "Night Blooming Cereus" were held to be invalid as a mark, being the proper descriptive appellation of an article.² The same rule defeated the adoptor of the words "Desiccated Cod-fish."³

§ 167. Since the foregoing got into type, the following case arose. A claim was made to the exclusive use of the words, "CABLE-TWIST TOBACCO," as a trade-mark for plug chewing-tobacco. The applicants⁴ set forth that they had used said words for that purpose for about two years last past, *i.e.*, from

¹ Annales de la Prop., tome x. p. 340.

² Phalon v. Wright, 5 Philadelphia, 464. ³ 5 Abb. Pr. R. (n.s.) 218.

⁴ Harris, Beebe, & Co.

about the year 1870. The Examiner rejected the application, on the ground that the words "Cable Twist" are purely descriptive of the goods to which they are attached. An interlocutory appeal was thereupon taken to the Commissioner, in person, the main question being this: Are those words the proper denomination of the article of manufacture?

§ 168. Upon the argument, the counsel for the applicants produced a piece of the manufactured tobacco, and a drawing filed in the Office in an application for a patent for their mechanical process of coiling the tobacco into the exact representation of an ocean-telegraph cable, which thing, said the counsel, had first suggested the name. The new article of manufacture consists of a strand or rope of tobacco coiled spirally about a "filler" or core, and then pressed flat, or into any other desired form. The object of the invention is alleged by the specification to be to provide a plug-tobacco in such shape, and of such arrangement, that the portion of it desired for use may be severed from it without uncoiling the remainder of the plug. After the coil is wound round the core, the bunch is placed in a mould, and reduced by hydraulic, or other, pressure to the shape of a flat plug. After this operation, a number of the plugs are placed in a tobacco-caddy and pressed; the process of filling and pressing being repeated until the caddy is full.

§ 169. It was conceded by the counsel that any article's appropriate name, which has become a part of our common language, cannot be registered or recognised as a valid trademark; but it was strenuously denied that the words "Cable-Twist," as here used, could be brought within the rule. It was admitted that the words "Cable," "Twist," and "Tobacco," are the common property of the public, and the words "Cable-Twist," when combined, are also in general use, designating as they do a kind or class of tobacco; but the counsel denied that such is the case in respect to the combination of the three words. "Cable-Twist Tobacco," it was contended, is a com-

bination quite unknown to the public, except as the mark or symbol of a particular firm, — the kind or class being *twist*, and the word *cable* being purely fanciful. The objection that the word *cable* is descriptive seemed to the counsel to be untenable. The case was instanced of the famous smoking-tobacco put up in green drums, and sealed with green wax, and having applied to it as a trade-mark the words “Green Seal Tobacco.”

§ 170. The Examiner replied that the color of the drum and wax were mere marks or symbols of the merchandise; and as green paint or green wax cannot enter into the composition of tobacco, the color in such case cannot be deemed to be descriptive, any more than the color of wax on bottles, as illustrated in the French case of *Badoit v. André*, in the Court of Appeal of Lyons, in 1851.¹ (In that case, the parties both sold the water of Saint Galmier, though each drew from a different spring. They had adopted very dissimilar exterior signs to distinguish their bottles. Badoit used a *green seal*, bearing the inscription “Mineral Water of Saint Galmier, Badoit Spring,” &c. André, who had quite another kind of designation, in 1850, without abandoning his peculiar mode of indication, all at once adopted the *green wax*. The court held that the color of the wax, as thus employed to seal bottles of mineral-water, constituted a trade-mark, and a sign of goodwill worthy of protection as the exclusive property of the plaintiff; and the defendant was accordingly enjoined from using for that purpose wax of the same color as that used by the plaintiff.)

§ 171. The counsel farther said, *inter alia*, that one might make candy, and color it to resemble a cable, and mould it into an exact representation of the applicants’ tobacco, and use the words “Cable-Twist Candy,” and enjoy the exclusive right of the employment thereof for that purpose. The words would necessarily be descriptive. The public would come to

¹ Le Technologiste, tome xiii. p. 213.

know the candy as "Cable-Twist Candy." The words might in time become the appropriate name of the article; and still the sole right to use the designation would remain in him who first applied it to candy. That is, that any person might apply the term *cable-twist* to any goods, as a fancy name, and hold the same as a valid trade-mark, although the words might possibly be to some extent descriptive.

§ 172. The case of "Brown's Jamaica Ginger" was cited as an illustration of the idea; and the remarks of Paxson, J., in the suit of *The Dixon Crucible Co. v. Guggenheim*,¹ were relied on as confirming the same. We turn to that case, and ascertain that what the judge said was this: "Our late fellow-townsmen, Frederick Brown, for many years before his death, prepared and sold a valuable article of Jamaica ginger. It was known as his article, and protected by his trade-mark. His son continues its manufacture. No one doubts his right to do so, or that equity would restrain an unlawful interference with his rights." The article would be "protected by his trade-mark," says the judge. He did not say what that trade-mark was. Was it the mere appellation of "Brown's Jamaica Ginger," as the counsel contended? It assuredly was not. The Patent Office has answered that question. Upon the application of the very gentleman mentioned, as successor in business, the point was passed upon. Mr. Brown applied for the registration of a *fac-simile* of the signature of his father and predecessor, as his lawful trade-mark for Jamaica ginger; and his claim was allowed.² The name of the commodity does not constitute any essential part of that mark.

§ 173. The counsel then said, that a fine-cut chewing-tobacco of a bright-yellow color, might be properly marked "Yellow Moss Chewing-Tobacco." (*Conceded*, and for this reason: the first term is purely fanciful. Yellow moss does not enter into the composition of chewing-tobacco.)

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

² Frederick Brown, No. 715.

§ 174. The counsel then suggested that the words "Snow-Flake Starch" would be a valid trade-mark, although applied to starch manufactured to resemble snow-flakes. (*Denied*, unless the claimant of a right to the exclusive use of the words have also the exclusive right, by virtue of a patent, to make starch of the appearance of snow-flakes; which is hardly a supposable case. If a person has a patent to make an article of any peculiar conformation, he may undoubtedly give it its proper descriptive name, and he would be protected therein, unless that name be generic, or broad enough to describe articles which others have an equal right to make and vend.) "Cable-Twist Tobacco," the counsel contended, "although used as a brand, is not yet properly a name, and cannot become a name until the diligence of the applicants make it such. It may doubtless pass into common use, and in time come to be a *quasi* generic term; but at present has nothing more than a fanciful significance. Perhaps every valuable (*word*) trade-mark in existence is more or less generic; and each may in the course of time take its appropriate place as a common noun, and be entered as such in the lexicons of future generations."

§ 175. The Commissioner of Patents affirmed the decision of the Examiner; and held that the words "Cable-Twist Tobacco" are descriptive, notwithstanding the transformation of the ropes or cables into rectangular blocks. He said that the words clearly indicate an article of chewing-tobacco manufactured in a peculiar manner, by twisting and coiling the plant into the form of a cable, just as hemp and other vegetables are manipulated. A cable continues to be a cable even if pressed out of shape. The idea is conveyed that the article offered for sale is tobacco, manufactured by the twisting or coiling process. No one would attach any other meaning to the term *cable-twist*, as used in connection with tobacco. It describes an article of merchandise that all manufacturers of tobacco have a right to make and sell. The applicants cannot

have the monopoly of all tobacco manufactured in the form of a cable, although they have made an application for a patent for a peculiar kind of cable-shaped tobacco pressed flat. They may have the sole right to make it in one way, and somebody else may have quite as good a right to make it in another way. If others have, or may acquire, a right to manufacture any other kind of cable-twist tobacco, they have the legal right to call the thing by its right name. But if the claim of these applicants were allowed that would not be so. They would to that extent control the use of words in common use.

§ 176. The applicants by their counsel made a motion before the Examiner for a re-hearing. Since the judgment of affirmance by the Commissioner, they had obtained the grant of a patent for seventeen years for their peculiar mode of manufacturing tobacco, as hereinbefore described; and it was argued that that fact put a new phase upon the matter, inasmuch as thereby they now had the sole right to make and vend chewing-tobacco made first in the form of a cable, and then pressed into flat plugs. The counsel urged the necessity of the recognition of the name as a trade-mark, as the applicants (stated to be the most extensive tobacco-manufacturers in the world) made a profit of twenty thousand dollars a year by the sale of *cable-twist tobacco*, and required the sole use of the name as a protection to their legal rights. Admitting that there is propriety in drawing a line of demarcation with nice discrimination in a case of mere description, it was said by the counsel that such an objection was obviated by the grant of a patent.

§ 177. The Examiner, in reply, referred to a patent¹ more than three years old, for another kind of improvement in the manufacture of chewing-tobacco. In that case, as is seen by the specification, the tobacco is spun or twisted together into one continuous "brake" or rope, and then coiled or pressed down into the keg, box, or other package, in which it is to be

¹ No. 85,613, to William & David Rineheart.

packed for market. The benefits claimed by the earlier patentees are the same as now set forth, — the convenience afforded to the consumer in breaking off only so much of the weed as he may need at the moment. The article manufactured under that patent is one kind of *cable-twist* tobacco. The public have a right to apply to it that descriptive name. The counsel insisted that the term was not understood by the trade to be descriptive; and asked leave to present evidence to that effect. The reply of the Examiner was, that the obvious and legitimate meaning of words in common use cannot be explained away by any possible amount of testimony. The Office must judge for itself. No cause for a re-hearing has been shown. Case dismissed.

§ 178. *The name of a man may lose the idea of personality, and become a mere indication of quality.* This point was decided by the Court of Cassation, the supreme judicial tribunal of France, in the case of *Stubs v. Astier et als.*, in 1865.¹ The plaintiff, a manufacturer in England, brought suit to restrain the use of his name upon articles of merchandise made and sold in France. Under the treaty made in 1860 between the two countries, he had a standing in court. His claim having been refused in the court below, on the ground that the name had attained a generic significance before the treaty of reciprocity had taken effect, the case was appealed to this, the court of last resort. It was contended on one side that the name of Stubs had lost its primary use, which was to indicate certain articles of hardware and cutlery as being his manufacture, and that by long user it had acquired a new attribute, and that to hold otherwise would be to take away rights that had become vested in the French people. On the other side, it was strenuously contended that a man's name is his distinct property, and remains a property sanctioned by the law of nations; and although the mark attached to it had fallen into the public domain from any cause, the name did

¹ *Annales de la Prop.*, tome xi. p. 81.

not cease to be the exclusive property of him who bore it. The court said that, for more than sixty years, the French manufacturers had made a certain kind of saws and files, on which they placed the mark "Stubs," with the initials "P. S." inverted; that said mark had become, in France, the indication of a product of superior quality; that it was not the indication of the origin of the manufacture, but was rather the designation of the nature and the quality of a product, of which it was the denomination, so that a purchaser could not be deceived into the belief that to him was presented an English product of the manufactory of Peter Stubs; that the files seized at Astier & Lechevallier's place bear, independent of this mark, "Stubs, P. S.," inverted, the initials "G. S.," indicating the real maker; that the files and saws seized at Reinaud's were wrapped in labels which made known the real place of manufacture; and that those divers circumstances manifested good faith and the absence of wilful injury. The same court, in 1864, in *Spencer & Sons v. Peigney*,¹ held the same doctrine. In that case the English manufacturer's name had for fifty years been employed in France to indicate *not the origin*, but the nature of certain products. As foreigners, the parties in both cases had no privileges in the courts of France until the treaty of 1860, and that although the English courts were open to alien and subject alike. By the time they could be heard in the assertion of natural rights, their names had been turned to another than the original purpose, so far, at least, as the territory of France was concerned. The soundness of these decisions is questioned by distinguished jurists, among them M. Pataille.

§ 179. In the case of *Bournhonet & Basille* (successors of *la maison Ternaux*) v. *Tisseron et al.*, in the Court of Cassation, in 1869,² we have an instance in point. It was *held* that the successor of a merchant cannot prevent other merchants from using the name of his predecessor to designate

¹ *Annales de la Prop.*, tome x. p. 197.

² *Ibid.*, tome xv. p. 90.

the products of their fabrication, when the name has long been used as the designation of a certain kind of products manufactured by the generality of the trade, and which has thus become public property as a qualifying term,—a mere adjective. It is especially so in the employment of the name of *Ternaux*, to designate a certain kind of *broché* shawls.

§ 180. The case of *Singleton v. Bolton*,¹ before Lord Mansfield, in 1783, is an illustration of the doctrine that a man's name may become a mere qualifying word. The plaintiff's father sold a medicine called "Dr. Johnson's Yellow Ointment." The plaintiff, after his father's death, continued to sell the medicine, marked in the same way. The defendant also sold the medicine, with the same mark; and for that alleged injury an action was brought. The plaintiff was nonsuited. A rule having been obtained for a new trial, Lord Mansfield said that if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud, for which an action would lie. But here, both the plaintiff and defendant use the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff. The only other ground on which the action could be maintained was that of property in the plaintiff, which was not pretended, there being no patent.

§ 181. We have familiar instances of a person's name becoming a mere indication of a certain article or class of goods. Wellington, Brougham, Stanhope, Blücher, and Manton are personal names that have given us the wellington boots, the brougham or the stanhope carriage, the blücher boots, and the manton fowling-piece. But it is not understood upon what principle a person's mercantile name can be wrested from him by the mere lapse of time. In the *Stubs* and *Spencer* cases, the fact was apparent that in England those names were regarded as marks of origin and warranty. If good for that purpose in one country, they were equally efficacious for the

¹ 3 Doug. 193.

same purpose in any other. The rights of their owners might be in abeyance, but they could not be lost.

§ 182. **Geographical Name.**— There are decisions which are supposed to justify the adoption of a mere geographical name as a trade-mark. One of these is *Newman v. Alvord*.¹ The word “Akron” was the subject of the controversy. The plaintiffs were manufacturers of cement or water-lime, at the village of Akron, in the county of Erie, N. Y. The defendants were engaged in the same line of business at Syracuse, N. Y. The court, on appeal, held that this name, although geographical, designated the origin of the article made and dealt in by the plaintiffs, as well as the place of manufacture, and was appropriately used in these respects; for the material used by the plaintiffs was obtained and manufactured into water-lime cement at the village having that name. The doctrine that the name of a locality may be exclusively appropriated was distinctly enunciated; but it was also held that what may be claimed or used alike by all in the said place cannot be exclusively appropriated to advance the interests of one. Daniels, J., delivered the opinion of the general term. After reviewing various authorities bearing upon the question at issue, he said: “In the present case, the term selected to identify and distinguish the plaintiffs’ manufacture from those of a similar character placed upon the market by others, had never been previously used for any such purpose. The use of it imposed a new attribute or office upon the word, which specially adapted it to indicate and distinguish the origin and place of the plaintiffs’ manufacture; and it in no way entrenched upon the previous use or purpose to which the term had been in any way devoted by others. The term was made to bear and perform an entirely new duty or office, which could result in no embarrassment, prejudice, or injury to any other person whatsoever. And from the continued use made of it in that respect, it has become an important and valuable element in

¹ 49 Barb. 588.

promoting and securing the prosperity of the plaintiffs' business, and as such the defendants should be restrained from making a similar use of it." While, for the purposes of that controversy, the court upheld the doctrine that the name of a place does indicate origin, we must not be misled by the broad language of the court. The plaintiffs came into court with clean hands, asking redress for an attempted fraud by the misuse of the word "Akron." What did that case decide? It virtually decided that that word did not, as presented, possess all the ingredients of a lawful trade-mark, for it lacked exclusiveness of the right of user. Mr. Justice Strong, of the Supreme Court of the United States, in the case in that court, before cited, said that the decision in the Akron case substantially concedes that the plaintiffs by their prior appropriation of the name of the town in connection with the words "cement" and "lime," acquired no exclusive right to its use as against any one who could use it with truth. All the inhabitants of the village of Akron had the same right to brand or label their goods with the name as had the plaintiffs; therefore it was not purely a trade-mark in its broadest sense. As against a wrongdoer who had attempted by fraudulent means to divert custom from its legitimate channel, it was good. The important word is the name of the place where the cement is made. The article manufactured is taken from the earth. It is a bed or quarry of lime. There is no special art or skill in making it into cement. The cement taken from different beds differs greatly in value, as in quality. The reputation of the plaintiffs' cement arises from the reputation of the bed or quarry from which it is made, — the Akron bed. They speak the truth in using the name. They tell the public by their bills — This is Akron lime. It is made from the Akron beds or quarries. The public have used it for years, and appreciate its qualities. The defendants, at a distance of 150 miles, change the name of their quarry, and incorporate the most significant word used by the plaintiffs for many years, and then prepare bills with

this word prominent in them, and bring their article into markets in competition with the plaintiffs'. It was not necessary for the purposes of the particular case under discussion for the court to decide in so many words that the word "Akron" was a technical trade-mark. The concluding sentence of the decision is sufficient to determine what was really decided. *Held*, the plaintiffs' right to restrain the defendants from making use of the word "Akron" as their trade-mark is reasonably plain, and the judgment awarding the injunction should therefore be affirmed.

§ 183. *The Brooklyn White Lead Co. v. Masury*,¹ before the general term of the Supreme Court of New York, in 1857, said that it is to protect a man's right of selling his own that the law of trade-marks has been introduced. It must include the right to sell 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 should be restrained by injunction. The plaintiffs had been engaged for more than twenty years in the manufacture of white lead, and had habitually marked their kegs with their name; adding the words, "premium lead, warranted pure." Both parties manufactured in the city of Brooklyn. As they both dealt in the same article, they had the same right to describe it as Brooklyn White Lead; and it was shown that many other companies had used the same designation. The defendant changed his mark, and assumed one to which he had no title, in imitation of the plaintiffs', with only a colorable difference, that of "Brooklyn White Lead and Zinc Company." He had no such company; and that part of his new title seems to have been adopted to imitate the plaintiffs', and to make his paint pass as theirs. This was a fraud. *Held*, the defendant should be enjoined from the use of the word "Company," or "Co." He may continue to use the title, "Brooklyn White Lead and Zinc," only omitting the word "Company."

¹ 25 Barb. 416.

§ 184. In *McAndrew v. Bassett*,¹ in 1863, the Lord Chancellor said: "I am told that this word 'Anatolia,' being a general expression, — being in point of fact the geographical designation of a whole country, — is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist; but property in that word, as applied by way of stamp upon a stick of liquorice, does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances, that render the article so stamped acceptable to the public." This is a recognition of the doctrine that a geographical name may cease to be merely such, and acquire a new function, as an arbitrary symbol. If it were not so, any word that might be found to be composed of the same letters in the same order, as the name of any country in the world, might be rejected as a trade-mark; and that although the adoptor of the word had never heard of the country bearing the name of his chosen word. The liquorice was stamped with the name "Anatolia" by way of contradistinction from other kinds of liquorice. It was not intended as a mere representation that the article was Anatolia liquorice. It acquired reputation. The defendant knew that, or he would not have simulated it. It was upon the same principle that, in 1862, the Tribunal Civ. of the Seine (*Faire v. Duyvaire et al.*) held that "Mount Carmel," although geographical, was good as a fancy name.² The case of *Wotherspoon v. Currie*,³ in V.-C. Malin's court in England, in 1870, is sometimes cited as an authority upon the same point. It appeared on a motion for an injunction that, for several years before 1847, Messrs. Fulton & Co., of Glenfield, near Paisley,

¹ 10 Jur. (n.s.) 550.

² *Annales de la Prop.*, tome viii. p. 238.

³ 23 L. T. R.

manufactured powdered starch, principally from East India sago, called "*Glenfield Patent Double Refined Powder Starch*," commonly known as "*Glenfield Starch*." In January, 1847, the plaintiff, William Wotherspoon, purchased of Messrs. Fulton & Co. their business and works at Glenfield, and the exclusive right of manufacturing starch and selling it under the name of "*Glenfield Patent Starch*." The plaintiff afterward removed his manufactory to Maxwellton, near Paisley, where he made and sold his starch. The defendant, Currie, rented from Messrs. Fulton & Co. a small building attached to their dyeing-works at Glenfield, and manufactured starch, which was sold in packets of a size and appearance similar to the plaintiff's, and labelled "*The Royal Double-refined Patent Powder Starch, manufactured by Currie & Co., Glenfield*." The plaintiff's case was that the defendant had taken the small building at Glenfield for the express purpose of inducing people to believe that his starch was the article made by the plaintiff. For the defendant, it was urged that, as he was an actual resident at Glenfield, and his manufactory was there, he had as much right to put his address upon the labels of the starch as had the plaintiff, who did not actually reside at Glenfield. An injunction was granted, the Vice-Chancellor remarking that he had never known a case in which a defendant had been guilty of more reprehensible conduct.

§ 185. This case came up on appeal before Lord Justice James, on a motion by the defendant to dissolve the injunction.¹ Lord Justice James said: "I am of opinion that the injunction in this case cannot be sustained. The word 'Glenfield' is not a fancy name, like the 'Victoria' or the 'Albert' or the 'Excelsior,' and various names of that kind, which were fancy names, actually constituting a trade-mark in themselves; but Glenfield, although it is not a place as big as London, Glasgow, or Paisley, and is not even a post-town, or a market-town, or village, is a place which has an actual existence as the site of

¹ 12 Jur. (n.s.) pt. 1; 23 L. T. (n. s.) 443.

some manufactory, is yet a place containing some few houses, and is a place at which the plaintiff's starch was manufactured. The defendant, no doubt moved by the great reputation which the plaintiff's 'Glenfield Starch' had acquired, was minded to establish works at Glenfield. That was what any one might do. Although the works of the plaintiff had been removed from Glenfield, Glenfield was not, as it seems to me, tabooed to all the world as a place or site for the manufacture of starch." The act of the defendant was legitimate. There are two classes of buyers, said the court. One is the class who can read, and the other is the class who cannot read. They who can read cannot be misled, if the language differs. To the persons who cannot read, the packets are dissimilar, and could not deceive.

§ 186. In *Colladay v. Baird*,¹ 1860, the complainant alleged that he was the manufacturer of a certain style of goods known in the market as "ARAMINGO CHECK." That, in 1854, he had devised a certain trade-mark, or name, to wit, the words "Aramingo Mills," which mark became identified with the goods manufactured by him, although his name did not appear upon the label as manufacturer; and that the defendant, intending to deprive him of the exclusive use and benefit of his trade-mark, cunningly devised a label upon which the words "Aramingo Mills" appeared; and thus by a colorable artifice succeeded in defrauding him of a portion of his well-earned reputation and profit. It appeared that both parties manufactured their checks at the same establishment, the defendant being in fact the lessor of the complainant. The defendant asserted his perfect right to use the words. The labels were of different size and color, so that the most ignorant could not fail to detect the differences in their general appearance; and the court said that there was not a colorable imitation, device, or artifice. The court refused a special injunction, leaving the complainant to maintain his title as best he could in an action at law.

¹ 4 Philadelphia, 139.

§ 187. In the Tribunal Civ. of Havre, in 1859 (*Levigoureux et al. v. Léon Lecompte & Co.*¹), came up this matter: Both parties imported the same kind of merchandise. The plaintiffs' mark was "Vallée d'Aure," in a semicircle, and underneath in a straight line the words "Levigoureux et Postel;" that of the defendants' was "Vallée d'Aure," and the initials, "L. L. & Co.," of their firm. It was shown that Vallée d'Aure was the name of a place in South America. The defendants truthfully employed it to indicate the origin of their products. *Held*, no infringement. In the Court of Paris, in 1859 (*Bisson-Aragon v. Aragon*²), the plaintiffs' mark was "Massy," their place of manufacture. *Held*, that defendant had a perfect right to use the words "près Massy," his manufactory being really near Massy, and that although others had previously adopted the word "Massy" as a distinctive symbol.

§ 188. *Newman v. Alvord*³ resembles the last case. There it appeared that the complainants had been manufacturers of cement or water-lime at Akron for about thirteen years, and that they had always designated and sold their products as "Akron Cement," and "Akron Water-lime." The defendants commenced a similar business twelve years later, at a place far distant from Akron, and called their product "Onondaga Akron Cement or Water-lime." It was a fraud upon the complainants and upon the public. Consequently, an injunction was granted. The court substantially conceded that the complainants had not acquired an exclusive right to the name as against one who could use it with truth; and that, as no one had the exclusive right to the name, it was not a trade-mark.

§ 189. The question of the appropriation of the name of a region to the exclusion of others who produce, or who sell, a similar product of the same region, may be considered as definitively settled. The case of *The President (&c.) of the Dela-*

¹ Annales de la Prop., tome v. p. 279.

² Ibid, p. 216.

³ 49 Barb. 588.

ware and Hudson Canal Co. v. Clark, already referred to, was well presented and argued in the Supreme Court of the United States, in 1872. The leading question was whether the complainants had an exclusive right to the use of the words "Lackawanna Coal" as a distinctive name or trade-mark for the coal mined and sold by them. The word "Lackawanna" was not devised by the complainants. They found it a settled and known appellative of the district in which their coal deposits, and those of others, were situated. The defendant invaded no right in employing the name, for he made no false representation. All the coal taken from that region is known in trade, and rated in public statistics, as "Lackawanna coal."

§ 190. The case of *Désiré Michel & Co. v. Achard & Co.*,¹ in the Court of Cassation (the supreme court of France), in 1863, bears a striking family-likeness to the Lackawanna case. Many years before, in the commune of Peypin, the plaintiffs had established a manufactory of cement, to which they gave the name "La Valentine." Their works were situated near a brook bearing this name, which it takes from the hamlet La Valentine, situated in the commune of Saint-Savournin, contiguous to that of Peypin. The defendants had recently constructed cement-works in the commune of Saint-Savournin, not far from the hamlet of La Valentine. Both parties took their limestone from the same quarry. The defendants advertised their product under the name of cement of "La haute Valentine." Was "La Valentine" a lawful trade-mark? If yea, did the defendants infringe it by the use of the words "La haute Valentine"? The court said that jurisprudence sanctions the doctrine that natural products, or even manufactures in the same place, may lawfully all be designated by the name of the locality where produced, unless encroaching on the name of a manufacturer, or his trade-mark. The name of "La Valentine Cement" is actually known to commerce as the proper designation of an article produced within certain boun-

¹ *Annales de la Prop.*, tome ix. p. 328.

daries, embracing the works of both parties ; for they both use the same quarry. The name, "La Valentine Cement," corresponds to the designation of Vassy, Roquefort, la Nerthe, &c., cement ; therefore the plaintiffs cannot pretend that the name is restricted to themselves. The designation of a locality cannot serve as the foundation of an exclusive right.

§ 191. The Congress Spring case¹ is not an exception to the general rule ; for in that it was shown that the plaintiff had the sole title to the place which was the source of the medicinal waters to which the name or mark was affixed. The same name could not be used with truth by other dealers in mineral waters. The Brooklyn White Lead case² is in point. There it was decided that all manufacturers in Brooklyn could properly use the name. The defendant was enjoined against the use of the word "Company" or "Co.," which was a fraudulent part-imitation of the plaintiff's label ; but was permitted to use the name of his place of manufacture.

§ 192. **When is a Name merely Geographical?** — When we glance at the case of *Armistead v. Blackwell* (in the chapter on Interferences), and see how judicial officers disagreed as to the meaning of the word "Durham," we hesitate before making answer. A word may be considered to be geographical or not, according to the circumstances of the case. If *merely* geographical, we know that it cannot be a lawful trade-mark. It behooves us, therefore, to scan closely.

§ 193. This question frequently comes up in the Patent Office ; and the rule for answering it is well-settled. If the word is not intended to be geographical, and is not taken to be such by the public, it is not such. It will have become, as an arbitrary symbol, as good an index as could be any other symbol. Thus the word "MARIELAND," although intended for a mark for merchandise manufactured in Maryland, is free from objection.³ The change in the spelling, and slight differ-

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

² 25 Barb. 416.

³ Malcolm Crichton, No. 925.

ence of sound, are sufficient to distinguish it from the usual and proper designation of the original *Terra Marie*, named for Henriette Marie, the queen of Charles I. of England. And no reasonable person would think that the use of the name "MONTICELLO," for whiskey, was intended to intimate that the article was distilled or sold at the home of the venerated "Sage of Monticello;"¹ or that the term "KENTUCKY PIONEER"² necessarily meant that it was made in Kentucky by the pioneer Daniel Boone; or that "BAY STATE" meant to imply Massachusetts.³ At first it was thought that the words "VIELLE MONTAGNE" were open to the objection of being a mere geographical designation, just as "Old Mountain" might be if the French were translated; but, upon reflection, it was concluded that the words could not, without straining their meaning, be taken to import that the green paint to which it was intended they should be affixed was manufactured at a place of that name.⁴ So "WISCONSIN WOOD CHOPPER" could not mislead any reflecting mind into supposing that the axe bearing that mark was peculiar to, or made in any particular State.⁵ The word "SCIOTO" is the name of the county, as Sciotoville is the name of the town, where the applicants make fire-brick, tiles, &c.; wherefore the Examiner rejected the application, as a geographical term, which any one in the county had a right to use. The Commissioner took another view of the matter, regarding it as an arbitrary symbol which no one else would be likely to impress on brick. Passed.⁶ It is not understood upon what principle this decision in the Scioto case could possibly be sustained. It may be that it never shall be brought in controversy in a judicial proceeding. If others have an equal right to use the name upon the same kind of wares, then it cannot be a trade-mark, for the essential element of exclusive right is lacking. We can understand how, if one

¹ Malcolm Crichton, No. 877.

² Adams & Taylor, No. 692.

³ Bay State Iron Co., No. 875.

⁴ Walter & Fielding, No. 494.

⁵ Biddle Hardware Co., No. 923.

⁶ McConnell, Porter, & Co., No. 510; *Vide Newman v. Alvord, ubi supra.*

not in a place of that name should fraudulently usurp the word as a mark, a court of equity would be called on to enjoin the wrong-doer, as in the Akron case, as an ordinary case of fraud, — not for violation of a trade-mark.

§ 194. As an illustrative case we will take the application for the word “ANGOSTURA” to be used in combination with bitters. The Examiner answered the claim, thus: The article called “Angostura Bitters” is well known as such, to the commercial public at least. A tincture of Angostura Bitters is officinal in the Pharmacopœia of some European countries. Ure’s Dictionary of Arts, &c., mentions the article among other bitter substances used in art and medicine, as quassia, wormwood, orange, gentian, tansy, coffee, &c. He also stated that he was credibly informed by experts, that a favorite drink called a “cock-tail” is composed in part of said bitters. The principal point was whether the word “Angostura” was not a geographical name; and it was held not to be, for the reason that the word “Angostura” had been first used by Dr. Siegert, under whom the applicant claimed. It had become a fancy name; and as the claimant proved his claim to the exclusive use of it, as the denomination of an article of which he was sole vendor, it was admitted to registration.¹

¹ W. H. Knoepfel, No. 580.

CHAPTER V.

EXAMPLES OF TRADE-MARKS.

One's Own Name. — Autograph. — Fac-simile of Autograph. — Initials. — Pseudonym. — Derivative from Surname. — Fancy Names of Men. — Name of Man may become Generic. — Natural Product. — Pictures. — Heraldry. — Monograms and Ciphers. — Color as an Element. — Form Essential. — Exemplars of Registered Trade-marks. — Cases rejected as merely indicating Quality.

§ 195. **One's Own Name.** — To what extent will a person's name be protected as a trade-mark? This question has its difficulty. The Act of Congress of July 8, 1870, sec. 79, prohibits the registration of a proposed trade-mark "which is merely the name of a person, firm, or corporation;" but the same section provides that that "shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act." The proviso opens the door to evidence that such name had previously become a "lawful trade-mark rightfully used." As an abstract proposition, such a name would not be protected, if another might truthfully use it. We must take the judicial decisions on this point, with all their circumstances. One case might be sustained; another not.

§ 196. **What is a name?** This question, which will also arise under section 79 of the law, is not an idle one, nor ought an investigation into its legal meaning to be thought pedantic or far-fetching. It has been well settled that a middle name or initial is not part of a person's name. The law knows of but one Christian name.¹ The addition of "senior" or "junior" is

¹ Co. Littleton, 3 a; 1 Lord Raymond, 562; 5 Johns. 84; 2 Cow. 463.

a mere matter of description, — *descriptio personæ*, — and forms no part of one's name, it being a casual and temporary designation.¹ If J. Smith is no name, then a deed or other instrument conveys no title or right to protection. One baptismal or given name out of half a score would satisfy the demand of the law in this respect; but that one name must be given in full, not in an initial letter, which means nothing or many things, and therefore, on account of its uncertainty, is worthless for the purpose of identification. Probably the surname might legally be dispensed with, or changed at pleasure.² A man's name is an emblem or symbol of himself, — a mark by which he may be known and identified. Here is a curious case: About the year 1825, at the Hereford assizes, in England, a Welsh witness, John Jones, was examined. He said that he had always gone by that name, while admitting, on cross-examination, that in Wales he had gone by the name of Evan Evans. The discrepancy was explained by showing that Evan is the Welsh synonyme of John, and Evans that of Jones. So he was John Jones in England, but at home he was Evan Evans, just by the rule which turns François Blanc, the Gaul, into Francis White, the American citizen; or Wilhelm Schwarz, the Teuton, into William Black, American: the name of a grandee of the Flowery Kingdom into a sonorous English cognomen. The surname, as distinguished from the Christian name, is the name over and above, — not the sirename, or name received from the father, but sur'name (*super-nomen*). There never was a time when every baptized man had not a Christian name, inasmuch as his personality before God was recognized.³ Upon good authority, it is stated that but few of the miners of Staffordshire, in England, choose to retain the names of their fathers; and we look in vain for a law to restrain them from the confusion that must frequently arise from severing this clew to

¹ 7 Johns. 549; 11 Wend. 522; 1 Hill, 102.

² See matter of Snook, 2 Hilton, 566.

³ Trench, Study of Words.

their identity. A single name, generally, sufficed for the early Hebrews, for each name bore significance; as, for example, Adam, *i.e.*, "man in the image of God;" Seth, "substituted by;" Enos, "frail man." Our ancestors were as easily satisfied with personal names, until, amid the increasing multitudes, it became necessary to more clearly designate persons. The year 1000 is the proximate date for the assumption of family names. The practice commenced in Normandy, and gradually obtained in England, Ireland, and Scotland, although at an earlier period surnames were occasionally hereditary in Great Britain. After the Conquest, the down-trodden nations began to copy the customs of their oppressors, and soon, from the haughty noble down through the various grades of society, all asserted the right to a distinctive *nom de famille*. A patronymic, in its true and original sense, is a modification of the father's name borne by the child, as Tydides, the son of Tydeus. The ancients formed their patronymics by an addition to the father's name, and modern nations have sometimes done the same, as, for example, John-son, Paulo-witz, Peter-kins; or by a prefix, as O'Brien, MacIntosh, Fitz-Herbert, Ap-John. In discussing this subject, Camden says, "Neither have they seene (I fear) any deed or donation before the Conquest, but sub-signed with crosses, and single names, without surnames, in this manner, in England: ' + *Ego Eadredus confirmavi*;' and ' + *Ego Edmundus corroboraui*;' in Scotland."

§ 197. It is the opinion of the ablest jurists that a person's name cannot be an essential element of his trade-mark; and such is the settled doctrine of the Patent Office. That means his proper appellation, — the name by which he passes in everyday life, the baptismal name joined to that of his father; and he may have a fancy surname, or no surname at all, as in the case of an Indian, or one who was born in slavery with paternity unknown. Or, as has been mentioned in another place, the name may have been translated. The use of the Latin language in the Middle Ages led to the frequent translation of

names. The French was also changed into English equivalents, having at times similar sounds, with the slightest reference to the original signification. Who, for instance, now associates the well-known Mortimer with the forgotten exploit of an ancestor in the Crusades; a "*De Mortuo Mari*" with the *Dead Sea*?

§ 198. **Allusive Names** may be, and sometimes are, used for marks. In the time of Henry III., G. de Lucy had for his arms *three lucies*, — fish now known as pike; Robert Quincy had a *quintefeuil*, — a flower of five leaves; Thomas Corbett had two *corbeaux*, — ravens; Sir O. Heron had three *herons*; Falconer, a *falcon*; Butler, *cups*; Forester, *bugle-horns*; Shelley, *shells*. If sufficient for arms, the same fanciful designations may well serve as trade-marks; and although suggestive of the real names, they are not on that account objectionable.

§ 199. Vice-Chancellor Wood, in *Ainsworth v. Walmesley*, in 1865,¹ considered this question, and held that a man's own name is his trade-mark, when united with other words which in themselves might not be such. He therefore upheld the designation of "Ainsworth's Thread," the plaintiff being an extensive manufacturer of thread, and his goods being well known in market by that name. But inasmuch as the defendant was not shown to have misrepresented the goods sold as being those of the plaintiff, the bill was dismissed.

§ 200. Here is a case which shows how a man may, by the use of his true name, attempt to conceal a fraudulent conception. In the Tribunal Civ. of the Seine, in 1863,² Eugène Bernard sued the Emonds, father and son. The plaintiff, a French armorer, established at Liège, in Belgium, had registered his trade-mark in France, under a treaty made in 1861. The mark was, "*E. Bernard, Canonnier de Paris*," with his initials, "E. B.," which he stamped upon the arms. The defendants had imitated that mark on the same class of merchandise. *Held*, that a trade-mark has no object but

¹ 44 L. J. R. 252.

² *Annales de la Prop.*, tome x. p. 375.

that of distinguishing the products of manufacture of him who has adopted it; that the object of the law of 1857 is to guaranty against unfair competition, by one vending his products as emanating from another; that E. Bernard is not a cannonier of Paris, where he has no establishment, but is only a manufacturer in Belgium; that the mark taken by him has evidently for an object not to guaranty the identity of his products, but to deceive the public in France, by causing them to confound the cannon coming from Belgium with the important house of Bernard in Paris, who make similar products; and that the law was not made to protect such marks and such frauds.

§ 201. In *Curtis v. Bryan*,¹ before the general term of the Court of Common Pleas of the city of New York, in 1868, the following facts appeared: Previous to the year 1844, Mrs. Charlotte N. Winslow prepared a composition for children teething, which she used with success. In 1844, she gave the recipe to her son-in-law, Jeremiah Curtis, one of the plaintiffs, who continued to manufacture and sell it under the name of "*Mrs. Winslow's Soothing Syrup*;" and, with the approval of Mrs. Winslow, he made that his trade-mark. The defendant, in 1867, commenced the manufacture of a preparation, in color and appearance resembling that of the plaintiffs, under the name of "*Mrs. H. M. Winslow's Soothing Syrup*," and with a label of the same size, color, and style as that of the plaintiffs. The imitation was close in other respects, and was evidently intended to mislead the public. To justify the use by him of the name of "Winslow," the defendant claimed that a variety of soothing syrups had been made and sold by John M. Winslow, a certain druggist; that he had purchased the formula of his remedy from said Winslow, who had invented it as early as 1842. The court held the claim of the defendant to be fraudulent, and the injunction granted was sustained with costs. We must remember that this was a case of fraud, in a court of equity. The right of the plaintiffs to this remedy

¹ 2 Daly, 212, and 36 How. Pr. R. 33.

did not depend upon the fact that the words mentioned constituted a valid trade-mark. Anybody named Winslow had a right to make and vend soothing syrup, and to combine his name with the generic term, if the sale thereof were not attended by circumstances of fraud or deceit. In accordance with rules elsewhere laid down, we must conclude that the words, "Mrs. Winslow's Soothing Syrup," are not *per se* a "lawful trade-mark." In *Howe v. The Howe Machine Company*,¹ before a general term of the Supreme Court of New York, in 1867, Sutherland, J., said that it was clear that the plaintiff could adopt and appropriate the word "Howe" as a trade-mark as against Elias Howe, Jr. "The plaintiff had a right to adopt and appropriate his surname as a trade-mark, and it cannot be said that Elias Howe, Jr., though his surname was the same, had a right to use his own surname in such a way as to deceive the public, and deprive the plaintiff of the benefit of the notoriety and market which his machines had gained." Elias Howe, Jr., in 1846, obtained a patent for a certain combination of mechanism called a sewing-machine. His brother, the plaintiff, commenced manufacturing sewing-machines as early as 1854, using the said combination, as the licensee of the patentee. These are undisputed facts. The uncontradicted history of the claimed trade-mark is, that before 1857, the plaintiff placed on the machines the letters and word "A. B. Howe;" that, in 1857, the plaintiff adopted "Howe" as the substitute therefor, and subsequently every machine manufactured by the plaintiff had the word "Howe" on it, in a conspicuous place. The judge said that "the conclusion from the pleadings and affidavits is irresistible that the word 'Howe' was thus used to denote the plaintiff, as the manufacturer, and not to denote Elias Howe, Jr., as the inventor. . . . Elias Howe, Jr., granted to the plaintiff, to Singer & Co., to Grover & Baker, to Wheeler & Wilson, &c., the right to use his patented right or combination, in the manufacture of

¹ 50 Barb. 236.

sewing-machines. It is obvious that the circumstance that these licensees did use, and had to use, his patented right or combination, as his licensees, in manufacturing their machines, cannot have the remotest bearing on the question of the right of either of these licensees to adopt and appropriate a trade-mark, even as against Elias Howe, Jr., as a manufacturer of sewing-machines." The judge cited *Sykes v. Sykes*,¹ where the manufacture simulated was shot-belts and powder-flasks, stamped "Sykes' Patent;" also *Croft v. Day*,² which is as follows: A blacking manufactory had long been carried on under the firm 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 the blacking as of the manufacture of Day & Martin, 90½ Holborn Hill, in bottles and with labels having a general resemblance to those of the original firm. He was restrained.

§ 202. Can we regard these two English cases as furnishing apt illustrations of the doctrine of Judge Sutherland? The cases differ in this: in the Sykes and the Day suits, the fact of fraudulent intent was too manifest to admit of doubt; but in the Howe case the defendant had in good faith used the name of the inventor, the president of the company. Leonard, P. J., said: "There is no fraud upon the plaintiff in the use by the defendants of the name of 'Howe,' as designating a machine manufactured by them, which Elias Howe, Jr., had invented, and from which the defendants derive their right to use the name." The injunction was accordingly refused. Therefore, notwithstanding the language of Judge Sutherland, as stated, it was virtually decided that the name "Howe" was not a trade-mark. How could it be under the admitted facts? Several firms, wholly independent of each other, had, by license from the inventor, acquired the right to make and vend his

¹ 3 Barn. & Cres. 541.

² 7 Beav. 84.

machine. A lawful trade-mark is exclusive property. All had the right to use the name "Howe." Therefore that name was not a trade-mark. Yet, although not technically such, under circumstances of fraudulent usurpation, the infringement of it would be restrained, as would any other act of unlawful competition.

§ 203. In *Thomson v. Winchester*,¹ before the Supreme Judicial Court of Massachusetts, in 1837, it was alleged that the plaintiff had discovered valuable medicinal properties in various vegetable substances, and the best manner of compounding the same for medical purposes, to which substances so compounded he had given the name of "Thomsonian Medicines;" and that the defendant made an inferior article, to which he improperly applied the same name. *Held*, the plaintiff had no exclusive right or privilege to compound or vend the medicines called "Thomsonian," although he was the original inventor; and that he had no more right than the defendant to make and vend these medicines, or call them "Thomsonian," if his term had acquired a generic meaning, descriptive of a general kind, quality, and class of medicines; as, for instance, James's Powders, or Turlington's Balsam.

§ 204. **One's Autograph** is good for this purpose. The Act of Congress prohibits the Commissioner of Patents from receiving and recording any proposed trade-mark which is merely the name of a person, firm, or corporation, unless accompanied by a *mark* sufficient to distinguish it from the same name when used by others.² One's autograph is his emblem or symbol of himself. It is not merely his name. If another of the same name have the same signature for the same purpose, the coincidence may be embarrassing, and raise a question of fact for a jury to weigh and settle. The similarity may be fortuitous and without fraudulent intent. Unless a man can invent a peculiar flourish or other characteristic sign-manual, he had better adopt something else with it. The same may

¹ 19 Pick. 214.

² Sec. 79, Act of July 8, 1870.

be said of the name of a firm, or of a corporation. "Doe & Roe," or "The Smith Manufacturing Company," might possibly lead to a confusion of persons; for the public cannot be assumed to know which firm or corporation shall have affixed its name to merchandise. This is a universal rule; but it has its exceptions in all countries, and even the Act of Congress above cited provides for exceptional cases in saying "that this section shall not prevent the registry of any lawful trade-mark, rightfully used at the time of the passage of this act."

§ 205. In *Ainsworth v. Walmesley*,¹ in 1865, Vice-Chancellor Wood ably discussed this question. He said that if Mr. Jones, or Mr. Brown, relies on his name, he may find his name a very inadequate security, because there are several persons of the same name, it may be, *bonâ fide* carrying on the same trade. But he had not in evidence before him that any other person than the plaintiff has ever been heard of as manufacturing Ainsworth's thread; and therefore "Ainsworth's Thread" is as good a mark as "Anchor Thread," or "Lion Thread," or any other thread which may be described by a particular name. The fraud of the defendant, in palming off his thread as that of the plaintiff, had been clearly established, and justified the decision in favor of the plaintiff. It was contended on behalf of the defendant that the case was not one of trade-mark at all; that no trade-mark was used, or was alleged to have been used, there being nothing but a simple representation that the thread was sold by the defendant as Ainsworth's; that, it was argued, was not a case in which, if the representation had been innocently made, complaint could properly be urged in this court, because a trade-mark depends upon property; that, a trade-mark being property, the use of a man's name was a simple fraud of another description requiring the *scienter* in order to constitute a wrong in respect to which the court will relieve. But the Vice-Chancellor replied that a man's name is still stronger than any which can

¹ 44 L. J. R. 252.

well be devised, subject only to this inconvenience which a name has, and a trade-mark has not, that two people may be of the same name.

§ 206. The rule is that a man cannot turn his name into a trade-mark. Any other rule would lead to most absurd consequences. There are several *dicta* the other way; but they must be attributed to a loose habit of speech, or a want of acquaintance with the indispensable requisites of the technical mark. No wise man in these days would for an instant rely upon such an insecure tenure of title. If one man's name may be a trade-mark, so may any other man's name be also; John Smith is a man's name: therefore John Smith is a valid trade-mark. Syllogistic absurdity!

§ 207. **Fac-simile of Autograph.** — This is just as valid for the purposes of a trade-mark as is the original signature. A person may place his handwriting to each article he makes or sells, or he may make any other kind of a sign to identify it; and a copy of his autograph is therefore admirably adapted to the purpose. The national currency, Gillott's pen-boxes, and many other familiar objects may be brought forward as evidence of the practice. The Patent Office has in a number of instances accepted copies of signatures as legitimate marks. Thus, as a mark for a certain medicine, the secret of compounding of which the applicant derived from another, with the right to the use of the imitation of the signature upon an elaborate label;¹ as a mark for Jamaica Ginger, which for many years had enjoyed a reputation, the applicant's right to the fac-simile of his father, and predecessor in business, was recognized;² and the well-known firm signature of John Anderson & Co., upon chewing-tobacco, was registered for the claimants' successors in business of the original members of the partnership.³

§ 208. In these cases there could be no question as to the apparent right of the several claimants to make those copies

¹ Cochran Fleming, No. 756.

² Fred. Brown, No. 715.

³ Arthur Gillender & Co., No. 767.

essential elements of trade-marks; for they clearly deduced their titles from their ancestors or predecessors in business, and have such distinct labels and notices as cannot fail to enlighten the public as to their true position. But there have been instances of applications for copies of autographs which seemed to have been adopted for the sole design of deceiving the public into the belief that the original manufacturer still continued in business, and that the articles to which the fac-simile was to be attached was made by him. Superior excellence must have been attributed to such original manufacturer; and the purchaser must base a preference upon the fact of the thing being the fabric of the inventor, the compounder, or why would his name be used? It is done to gain credit. The article would not command a market without that peculiar mark. Fraud may lurk in such a case. Therefore, when a fac-simile of an autograph is offered for registration, unless accompanied by indubitable evidence of good faith, or under circumstances which create the presumption of a rightful use, the claim will be rejected, lest a false credit be thereby tolerated.

§ 209. The case of *Compere v. Bajou et als.*,¹ decided in the Tribunal of Commerce of Paris, in 1854, and affirmed on appeal, is one that is apt to stagger the judgment of a student. It appeared that the defendant, Bajou, had assigned his business as a glove-maker, and the good-will thereto attached. The assignee was authorized by Bajou to adopt, exclusively of every other person, the description of successor to Bajou, and to use, as the mark for his gloves, the stamp employed by him as the manufacturer's mark, being the fac-simile of his signature. It was also agreed that Bajou should not have the right to establish, to purchase, or be a partner in, any manufacture of this nature, either at Paris, or any other town in France, with the exception of Grenoble; and, moreover, that he might in Grenoble only deal in gloves called "Grenoble manufacture,"

¹ Copied in full in Upton, p. 73.

and marked with the stamp of that town. Bajou disregarded his agreement, and stamped a certain quantity of gloves with his manufacturer's mark, the fac-simile of his signature. He sent the gloves thus marked to New York. The tribunal said that the manufacturer's mark for this species of industry — the mark being advantageously known — is an indispensable auxiliary for insuring a sale, more especially in America; and that, besides, it is not the custom at Grenoble to mark with one's name the gloves manufactured there. It was also held, that in assigning for a certain sum his *good-will*, Bajou *really assigned all his right to the manufacturer's mark*, in which the true value of the business consisted, since it is upon the mark that the custom depended. Further, that it was in vain for Bajou to pretend that he had the right to apply to his new manufacture the manufacturer's mark which he had assigned; for that would be not only to seek to resume that which he had assigned, and of which he had received the price, but also to endeavor to apply for his own benefit the increased custom of the assignee. He was, therefore, prohibited from employing in the future his name as a manufacturer's mark upon his gloves, and heavily fined.

§ 210. To the casual observer, this might seem like an authority to commit a fraud upon the public, and upon purchasers in foreign countries, by the means of a misrepresentation, to wit, that Bajou himself had made the gloves. That was not the meaning of the judgment of the tribunal of first instance, nor of the Imperial Court of Appeals of Paris, which affirmed the decision. The latter held that the exclusive title to the mark had passed to the assignee, the right to the use of the stamp till then employed by Bajou being one of the essential ingredients of the contract; that the stamp, being the only means of establishing the source of the goods, and of retaining the custom depending on it, had become, by force of circumstances, an accessory of the good-will transferred; and that the arrangements adopted by Bajou, to make known abroad that he had

recommenced trade, had no other object than to take from the actual owners of the business a part of the benefits insured to them. This was as much as to say that the case is essentially one of good-will, and that the mark is an incident to it. It is a matter of unlawful competition in trade. It did not mean that the *mere* fac-simile of Bajou's signature could be used by the assignee; for that were to encourage fraud. The law of France is opposed to any such idea. The rule of commercial morality is far more stringent there than in many other countries. The 21st article of the Code of Commerce is, that "the name of the associates can alone constitute the firm name" (*la raison sociale*). This is intended to forbid persons who succeed to the business of another from continuing it under his name. Credit is altogether personal.¹ What, then, did the court mean?

§ 211. If we look back, we will see that Bajou authorized his assignee to adopt, exclusively of every other person, the description of *successor*. The law of France requires the words "successor of" to appear in such case. The public could not be misled, and the assignee of the mark would thereby be enabled to secure custom, as the successor of a reputable manufacturer; as the one who had availed himself of all the appliances and means of attaining excellence that the other had possessed.

§ 212. A designation may become a lawful trade-mark, although originally composed of simple initials. It may be accepted in commerce as indicating a name other than that of the manufacturer who claims it. It thus virtually becomes a pseudonym, or, more properly speaking, a fancy symbol. In the Tribunal of Commerce of the Seine, in 1857, came up the following case: Jean Bardou, the plaintiff, a manufacturer of cigarette-paper, has been in the habit of marking his products with his initials, "J. B.," separated by a lozenge, so that the

¹ See remarks of Hoffman, J., in *Howe v. Searing*, 10 Abb. Pr. R. 264; 6 Bos. 354; and 19 How. Pr. R. 14.

mark seemed to be composed of the word "JOB." The public soon became accustomed to the mark, but mistaking its component parts, asked for "*Job*" paper. Lassausée, the defendant, who was engaged in the same kind of business, took an associate named Job, and without hesitation took also the mark "JOB." His defence to the suit was that he had a perfect right to use the genuine name of his partner. The court scouted so shallow a pretence, and punished him severely.¹

§ 213. Pseudonyms. — During the Middle Ages it was rather the rule for an author not to publish under his real name, either from prudential motives or because of excessive modesty. When all serious works were written in Latin, Teutonic, and even Gallic, names had an awkward appearance among Ciceronian adjectives. They were therefore softened by Latinizing or Hellenizing them. When the name was significant, it might be literally translated. The great reformer of Germany, Philip Schwartzerde, not admiring an uncouth cognomen, signifying black-earth, changed it into the mellifluous Greek; and it has come floating down to us through three centuries, as Melancthon. England has furnished another conspicuous example in her "*Nominis Umbra*," as Byron calls him.² We need be at no loss for instances of feigned names among authors of our own century. Mr. Herbert takes as his *nom de plume* "Frank Forrester," Mrs. Judson took "Fanny Forrester," Dr. Holland figures as "Timothy Titecomb," Miss Dodge as "Gail Hamilton;" and many similar cases are familiar as household words. In England, a writer whose initials are H. N. B. recently put forth a novel purporting to have been written by "Mr. Aitchenbee." All such names would be protected as lawful proprietary marks. In 1838, Felix Tournachon took the pseudonym of "NADAR," which he affixed to all his productions, as an artistic and literary mark to the fruit of his toils. It was held by the Court of Paris, in *Tournachon v. Tournachon*,³ that this feigned name was a valid trade-mark; and

¹ *Annales de la Prop.*, tome iii. p. 125.

² Junius.

³ *Annales de la Prop.*, tome iv. 83.

that decision was affirmed by the highest court. So, in the Tribunal of Commerce of the Seine, in 1867, in the case of *Gravelet (dit Blondin) v. Arnault*,¹ it was decided that a pseudonym can become property in him who has given celebrity to it, and as well in the arts as in mechanical industries. PER CUR.: Gravelet took, many years since, the pseudonym of Blondin, under which he is generally known, and in various countries as an acrobat had gained a notoriety for his name. With the object of competition, Arnault, director of the Hippodrome, announced a spectacle in which should appear an acrobat to whom he gave the name of Blondin, and announced as the veritable Blondin. *Held*, to be an infringement. Enjoined. Damages, 500 francs. Publication in the newspapers at defendant's expense.

§ 214. There have been instances in the Patent Office of persons using sobriquets of themselves for trade-marks. One person, a manufacturer of clothing, uses the term "LITTLE JAKE," and has had it registered.² It is not very doubtful that the political editor known as "BRICK POMEROY" could claim the exclusive right to that classical title; for there is but one person in the whole of creation who could be meant thereby.

§ 215. In the reign of Chin-tsong in China, in the sixteenth century, lived a celebrated artist of the name of Ou, who withdrew from the world. He produced, in secret, porcelain remarkable alike for its quality and the beauty of its colors. Under the foot of his vases he engraved in the paste his peculiar mark, that by which his workmanship was identified. The translation of it is — "The old man Ou, who lives in solitude."³ Whether regarded as a mere denomination of fancy, as a pseudonym, or as his genuine signature, this mark denoted origin and ownership, and carried with it a guaranty of excellence.

§ 216. **Fancy Names of Men.** — We have many instances of such names becoming valid trade-marks. In the case of *Barrows v. Knight*,⁴ in the Supreme Court of Rhode Island, before all the

¹ Annales de la Prop., tome xiii. p. 303. ² Jacob Seligman, No. 828.

³ Marryat's Pottery and Porcelain. London, 1857. ⁴ 6 R. I. 434.

justices, it was *held*, that "Roger Williams," though the name of a famous person, long since dead, is, as applied to cotton cloth, a fancy name, as would be, so applied, the names of Washington, Greene, Perry, or of any other heroes, living or dead. Said Ames, C. J., in delivering the opinion of the court: "It is quite as peculiar and significant, in such an application as Persian Thread, Mexican Balm for Hair, Vegetable Pain Killer, Houqua's Mixture, for tea, or Ethiopian, for stockings, or the numerous other fanciful names which have been treated as appropriate trade-marks." In *Messerole v. Tynberg*,¹ the plaintiffs claimed an exclusive right to use the word "BISMARCK," in its application to paper collars. The court *held*, that the plaintiffs had the right to appropriate said name, in common with others, for a new purpose; and having done so, are entitled to avail themselves of all the advantages of their superior diligence and industry. In the Court of Paris (*Dalbann & Petit v. Colville & Co.*²), where both parties used the name "LAMARTINE" for a certain elixir, the court said, on appeal: There is no doubt that proper names, other than those of the manufacturer, can be employed like any other sign, as a distinct mark of industrial products, and thus become veritable property, not as a title or mode of appellation, but as a commercial mark. In the case of *Wedgwood et als. v. Smith et als.*, before the Vice-Chancellor of England, in the year 1848, the defendants were restrained from using the name of "Wedgwood," or "Wedgewood," on their wares, it having been shown that the name "Wedgwood" had been used as a trade-mark by the family of the Wedgwoods for centuries.³ The Court of Paris, in 1867 (case of *Sargent v. Romeu*⁴), sustained the right of plaintiff to the words "ROYAL VICTORIA."

§ 217. The applicant, at times, by an addition to his patronymic, or variation thereof, makes a convenient and peculiar

¹ 4 Abb. Pr. Rep. (n.s.) 410; 36 How. Pr. Rep. 14.

² Annales de la Prop., tome vii. p. 414.

³ Jewitt's Life of Josiah Wedgwood, p. 385.

⁴ Annales de la Prop., tome xiii. p. 21.

mark. Thus "MAYOLINE,"¹ "EDGERLINE,"² and "ROSEBAUME"³ have come into existence. Although perhaps suggestive of the names of their appropriators, they are sufficiently distinctive to serve their true purpose.

§ 218. Again, the name of some defunct person, or of some one whose creation sprang from the brain of the poet or novelist, is found to be serviceable. If understood by the public to be nothing more than a mere fancy designation,—one which has lost its original character and become an unmeaning symbol,—then it may be entitled to recognition as the veritable mark of commerce. When we see "DOLLY VARDEN"⁴ upon fancy paper, we do not think of the charming daughter of the London locksmith, Gabriel Varden by name, who lived in the reign of George III., but we associate the name with a certain manufacture of goods. Thus, in or about the year 1871, the public recognized what were then known as "cretannes" as the make of a certain inspired *modiste*, who had the name transformed into a mark. Silks, chintzes, and other dry-goods, now bear the title; and for each class of merchandise it is a mark that the law will protect, and secure the exclusive use of it to the first adoptor thereof. "PAUL JONES," the name of a somewhat famous naval hero in the early history of our nation, has been impressed into the service as a brand for whiskey.⁵ So has the traditional "YOUNG AMERICA"⁶ been placed upon writing-ink for the use of the scions symbolized by that appellation. "APOLLO"⁷ indicates a certain species of gin; "RIP VAN WINKLE,"⁸ a brand of whiskey; "FALLSTAFF,"⁹ "GULLIVER,"¹⁰ "UNCLE BOB LEE,"¹¹ "OUR FRITZ,"¹² "BROWN DICK,"¹³ "LONE

¹ U. K. Mayo, No. 904.

³ J. Rose, No. 807.

⁵ Walsh, Brooks, & Kellogg, No. 702.

⁶ Adams & Fay, No. 912.

⁸ A. W. Balch & Co., No. 601.

¹¹ David Hirsch, No. 24.

¹² J. W. Carroll, No. 156.

² H. B. Edgerley, No. 610.

⁴ Bergen & Bainbridge, No. 833.

⁷ Gill & Lootz, No. 531.

⁹ David Hirsch, No. 23.

¹¹ Winfree & Lyon, No. 402.

¹³ J. W. Carroll, No. 157.

JACK,"¹ and "PHIL SHERIDAN"² authenticate particular manufacture of cigars, or of chewing or smoking tobacco.

§ 219. **New Words.**—The coiner of a new word, employed by him to designate an article made or sold by him, may obtain such a right to that name as to entitle him to the sole use of it, as against others who attempt its use for the sale of a similar article. The introducer of a new word, or of new words into a language, may by a parity of reasoning acquire the same right, on the same terms. He is virtually a coiner of a word who first applies it as an arbitrary symbol, to express the origin of the article of merchandise to which it is affixed. We need not strain a point to inquire into the question of the possible coincidence of a supposed neologism with a word or term used in some language other than our own. Is it new in its present application? Has it ever been used before as applicable to similar articles? Does the word proposed to be adopted denote only the nature, kind, or quality of the goods bearing it? If so, it cannot be exclusively appropriated, lest the whole language should gradually be laid under prohibition. Is it the necessary name of the article, — the term by which it is known to commerce in general? Yea. Then it cannot be made a private mark. The present nomenclature of chemistry is a remarkable instance of the formation of new words; yet no one would pretend that when a new term has been struck into definite form, by the rules laid down for the combination of scientific terms, that because he was perchance the first who used it, he could interdict all others from its use. If that could be done, the slightest modification of a word would vest in somebody an exclusive title, and fetter the common language, until it would not be safe to add a particle, or inflect a syllable. Has the claimant the exclusive right to make and vend the new article? If yes, he may coin for it a new name, and, so long as he continues to possess the monopoly, he has

¹ J. W. Carroll, No. 158.

² Smith, Crosby, & Co., No. 244.

the sole title to the name. The following case will illustrate this well-settled doctrine.

§ 220. In *Caswell v. Davis*,¹ at a special term of the New York Common Pleas, in 1867, the plaintiffs claimed the name affixed by them to the medicine which was first compounded by them in 1861, — “ FERRO-PHOSPHORATED ELIXIR OF CALISAYA BARK,” — as a trade-mark. They based their claim on priority of adoption. The plaintiffs did not seek to enjoin the defendant from manufacturing and selling his compound, or any other mixture composed of any elements ; but insisted that he should not sell it with a label bearing upon it the name above given. There was some evidence tending to show that similar preparations, in some of the essential elements, had been made and were in use before the plaintiffs experimented on, or produced their article ; but it was not established that any mixture composed of all the ingredients used by the plaintiffs, or having a name in all respects similar to that adopted and applied by them, was in use or known to the public before the plaintiffs introduced their medicine. The Elixir of Calisaya, or Peruvian Bark, was in use, and perhaps in solution with iron in some form. But this case shows that this composition, with its peculiar and specific substances, was first introduced by the plaintiffs under its peculiar name, “ Ferro-phosphorated Elixir of Calisaya Bark,” and that they first applied the specific word “ ferro-phosphorated ” to any medicine. The article compounded by the plaintiffs, as a whole, was original with them. In the condition in which it was presented to the public it was new. As it was a recent composition, it would, of necessity, require a characteristic name, if its elements were to be indicated in its appellation. Compounded of substances known principally in chemistry, which science has a nomenclature peculiar to itself, the words to distinguish it would be in a language familiar to chemists, and that limited class of persons who deal in drugs and chemicals. It is true that the meaning of the

¹ 4 Abb. Pr. R. (N.S.) 6, and 35 How. Pr. R. 75.

words, singly, which mark the compound in question, is known to a large class of persons other than those designated ; but, so far as the word “ferro-phosphorated” is concerned, it cannot be said that it is in common or general use, or that it is even understood by the great number of persons who take the remedy on the advice of physicians, as indicating the true nature and character of the mixture. They may, and doubtless do, in most cases, understand that the medicine prescribed contains Peruvian bark and iron ; but as they read the label on the bottle they do not learn from it what the article really is, although its elements generally are indicated by the words used. They are not like words in common use, in any true sense, words which carry to the mind of all classes of persons, the instant the eye lights on them, the true character of the contents of the package upon which they are placed. All understand what mean the words “tobacco,” “gin,” “brandy,” “cotton yarn ;” but the words “Ferro-phosphorated Elixir of Calisaya Bark” would be unintelligible to most persons. Such is nearly the precise language of Van Vorst, J. In discussing the novelty of the term employed by the plaintiffs, he further said: “‘Ferrum,’ of which ‘ferro’ is a form, is a common word in the Latin ; and ‘phosphorated’ is recognized by Webster as an English word. But I am of the opinion that no such word as ‘ferro’ and ‘phosphorated’ in combination is to be found in any language, except the forming of it by the plaintiffs has had the effect to introduce it ; and if so, plaintiffs are entitled to the credit and use of it. The combined word, I am satisfied, is philologically incorrect. I do not suggest that the word is meaningless, or that its elements do not indicate in a general way some of the ingredients of the preparation ; but it does not do so chemically, or in an exact sense, and was doubtless arbitrarily arranged and invented by plaintiffs.” There was a fact, also, which had some influence on the mind of the court. Several physicians testified that they had used this remedy for years ; and that when they prescribed “Ferro-phosphorated Elixir of Calisaya Bark” they intended

the medicine of that name manufactured and sold by the plaintiffs. Another fact appeared. The defendant was in the employment of the plaintiffs when the experiments were made which resulted in the production of the article. He availed himself of the information gained while in a confidential relation. *Held*, that the plaintiffs are entitled to the exclusive use of the word "ferro-phosphorated" alone or in combination with any other words, and that their label to that extent is a proper subject of a trade-mark.

§ 221. If the compound word thus protected by the court had been philologically correct, and were necessary to denote the article to which it was affixed, it could not have been sustained as a mark of commerce. It was a newly-coined arbitrary term, and a symbol not understood, unless by its association with a particular article of merchandise.

§ 222. Many authors, judges, and lawyers have cited *Gout v. Aleploglu*,¹ to show that an ordinary word in a foreign language, meaning *warranted* or *approved*, may be a trade-mark. They err in so doing. This case, heard in 1833 in England, seems to have been as follows: The plaintiff, Gout, had long manufactured watches for the Turkish market. These watches had acquired great repute in Turkey, and were known by certain marks engraved thereon. These marks consisted of words in Turkish characters, viz., the name of the maker, and the name "*Pessendede*," which in the Turkish signifies *warranted* or *approved*. There were also other marks: "R. G." and a crescent put in relief, and a sprig and crescent. Now it would be folly to say that the word *Pessendede*, which had no use except in the market to which the watches were sent, and which was of no use elsewhere, could be exclusively appropriated. The word might with truth be used by many fair dealers for its legitimate purpose; and, being a common word expressing quality, no one could claim it to the exclusion of all others. We must look closer, and ascertain the facts.

¹ 6 Beav. 69.