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A TREATISE

ON THE

LAW OF TRADE-MARKS

AND ANALOGOUS SUBJECTS,

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

BY

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

SECOND EDITION,

REVISED AND ENLARGED.

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PREFACE

TO THE SECOND EDITION.

THE first edition of this book sprang from the author's desire to bring order out of chaos. There was need for a collation of authorities on the Law of Trade-Marks and kindred matters; and that need was felt, not only by owners of applied symbols of manufacture and commerce, but also by bench and bar alike. No comprehensive treatise on those matters could be found in any tongue. Judicial rulings of many countries had to be consulted, and general principles of world-wide interest to be deduced therefrom. Wonder not, therefore, that much of the matter was crude, and sometimes merely theoretical.

It is probable that no other branch of legal science has had a more rapid growth during the twelve years since the first edition appeared. For that reason, this book had, for the greater part, to be rewritten. Within that time, nearly all civilized nations have shown a due appreciation of the importance of the subject. Their interest has been manifested by scores of treaties and numerous acts of legislation. A single fact speaks a volume. In 1883, at Paris, more than twenty governments, including that of our own nation, were in conference to form a union for the protection of industrial property, including rights in trade-marks. The result

is a treaty in vigorous operation. The purpose thereof is practically to efface mere territorial limits, as effectually as does the Postal Union, or the work of the late International Prime-Meridian Conference. True, our Senate has thus far declined to confirm the treaty; but that is only because the subject of trade-marks had complicated with it that of patents for inventions, and it was thought too great concessions were demanded. For the present, our citizens rely on special treaties for protection in foreign countries. Interest in the matter is not abated, but rather increases with the progress of commerce. Because of that interest, the jurisprudence of the subject has necessarily become more settled, harmonious, and refined.

Our first national legislation in regard to trade-marks was in 1870. For lack of apt words, limiting the operation of the registration act to the commerce over which Congress has control, that act was a nullity. The Supreme Court having pointed out the error, Congress, in 1881, corrected it; and ever since registration and its beneficial consequences have run smoothly along.

A few words as to the literature of emblems of commerce, etc. In the United States, Mr. Upton published his work in 1860. As a pioneer, he did good service; but explorations had then only begun. In 1871 appeared a volume of nearly eight hundred pages, entitled "American Trade-Mark Cases," gathered by Mr. Rowland Cox. The collection is convenient and valuable, inasmuch as it contains in full the principal opinions of courts of the various States of our Union; and, in an Appendix, decisions of English courts. In 1881, Mr. Cox also published "A Manual of Trade-Mark Cases," comprising Sebastian's (English) digest of cases

down to 1879, besides some later ones. Several other digests were published in or before the former year, including that of Mr. Coddington. All are useful, if they do no more than point the direction to full and explicit enunciations of legal principles.—In England, in 1861, Mr. Lloyd put forth an excellent little treatise of about eighty pages duodecimo, and a second edition in 1865. Later followed Adams's, and other books and essays relating to trade-marks. The British legislation of 1875–76 gave an impetus to writers of books of local practice. As a consequence of the legislation of 1883, a number of books issued from the press, by Messrs. Aston, Lawson, Bousfield, Terrell, and others. They are mostly commentaries on the British statute of that year, with rules of practice in registration matters. They therefore do not immediately concern general readers or practitioners in this country, especially those who are in quest of general principles.

In France, in 1855, was published the "Code International de la Propriété Industrielle, Artistique et Littéraire," by MM. Pataille and Huguet, to which an "Appendice" was published in 1865 by the gentleman first named. 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, as a book of reference. In 1855, those gentlemen also began the issue of a periodical entitled "Annales de la Propriété Industrielle, Artistique et Littéraire," principally composed of opinions and decisions of the tribunals of commerce and courts of France, and sometimes of other European countries. This still goes on under the supervision of a corps of learned members of the French

bar, although the eminent writer M. Pataille died in 1881. This work, now in its thirtieth volume, contains a mine of wealth, not only in terse logical decisions of judicial courts, but also in able essays and careful annotations. In 1855 was published a good book, "Traité de la Contrefaçon," by Blanc. Space will not permit anything more than a mere reference to Pouillet, Clunet, and many other excellent authors. In 1884 was begun a publication entitled "Journal Officiel," which contains Trade-Mark decisions; but reference to cases is somewhat hindered, from the omission of names of parties litigant.

In other European countries there are publications on the same subject, especially in Belgium, Germany, and Austria, but they relate almost exclusively to matters of mere local interest.

The latest obtainable decisions of courts of various nations have been consulted and cited in the following pages.

With the hope that this volume — the result of careful revision of the first edition and analysis of judicial opinions since then evolved — may be serviceable to his brethren of the legal profession, and the public in general, this work is submitted by

W. H. B.

WASHINGTON, D. C., August, 1885.

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A. J.	Australian Jurist.
Abb. N. C.	Abbott's New Cases. (New York.)
Abb. Pr.	Abbott's Practice Reports. (New York.)
Ad. & E.	Adolphus & Ellis's Eng. King's Bench Reports.
Alb. L. J.	Albany Law Journal.
Am. L. Reg.	American Law Register.
Am. L. Rev.	American Law Review.
Am. L. T.	American Law Times.
Am. R.	American Reports.
Annales	Annales de la Propriété Industrielle, Artistique et Littéraire. (Paris.)
Atk.	Atkyns's Reports. (English Chancery.)
B. & Ad.	Barnewell & Adolphus, King's Bench Reports.
B. & Cr.	Barnewell & Cresswell, King's Bench Reports.
Bac. Abr.	Bacon's Abridgment.
Barb. Ch.	Barbour's Chancery Reports. (New York.)
Barb. S. C., or Barb.	Barbour's Supreme Court Reports. (New York.)
Beav.	Beavan's Reports. (Rolls Court.)
Beng. L. R. App.	Bengal Law Reports, Appendix.
Bing. N. C.	Bingham's New Cases. (Eng. Common Pleas.)
Bing. N. R.	Bingham's New Reports. Do.
Biss.	Bissell. (U. S. Circuit Court.)
Blanc	Blanc sur la Contrefaçon.
Bl. Com.	Blackstone's Commentaries.
Blatch.	Blatchford's Reports. (U. S. Circuit Court.)
Bos.	Bosworth's Reports. (Superior Ct. N. Y. City.)
Brewst.	Brewster's Reports. (Pennsylvania.)
Burr.	Burrow. (English King's Bench.)
C. B.	Common Bench Reports.
C. C. C. Pap.	Central Criminal Court Sessions Papers. .
Cal.	California Reports.
Ch. D.	Law Reports, Chancery Division.
Codd. Dig.	Coddington's Digest.
Co. Litt.	Coke on Littleton.

Com. Dec.	Commissioner's Decisions. (U. S. Patent Office.)
Conn.	Connecticut Reports.
Coop.	Cooper. (English Chancery Reports.)
Cox's Man.	A Manual of Trade-Marks, etc. (Rowland Cox.)
Cranch	Cranch's Reports. (U. S. Sup. Ct.)
Cro. Jac.	Croke's Reports. (King's Bench, <i>temp.</i> James I.)
Ct. of App.	Court of Appeal. (England.)
Ct. of Sess. Cas.	Court of Sessions Cases. (Scotch.)
Cush.	Cushing's Reports. (Massachusetts.)
D. & B.	Deersly & Bell's English Crown Cases.
D. & R.	Dowling & Ryland's English King's Bench Reports.
Daily Reg.	New York Daily Register.
Daly	Daly's Reports. (New York Common Pleas.)
Deady	Deady's Reports. (U. S. Circuit Court.)
De G., F. & J.	De Gex, Fisher, & Jones's Eng. Chancery Reports.
De G. & J.	De Gex & Jones's Eng. Chancery Reports.
De G., J. & S.	De Gex, Jones, & Smith's Eng. Chancery Reports.
De G., M. & G.	De Gex, Macnaghten, & Gordon's Eng. Chan. Rep.
Dill.	Dillon's Reports. (U. S. Circuit Court.)
Doug.	Douglas's Reports. (English King's Bench.)
Drew. & S.	Drewry & Smale's Eng. Vice-Chancellor's Rep.
Eden on Inj.	Eden on Injunctions.
E. D. Smith	E. Delafield Smith's Reports. (N. Y. Common Pleas.)
Ex.	Exchequer Reports.
Fed. R.	The Federal Reporter.
Fish.	Fisher's U. S. Patent Cases.
Ga.	Georgia Reports.
Giff.	Giffard. (Eng. Vice-Chancellor's Reports.)
Gray	Gray's Massachusetts Reports.
Greenl. Ev.	Greenleaf on Evidence.
H. L. C.	House of Lords Cases.
H. & M.	Hemming & Miller. (Eng. Vice-Chancellor's Rep.)
H. & W.	Harrison & Wollaston. (Eng. King's Bench Rep.)
Hare	Hare's English Vice-Chancellor's Reports.
Hilt.	Hilton's Reports. (N. Y. Com. Pleas.)
Hoff. Ch.	Hoffman's Chancery Reports. (New York.)
Holmes	Holmes's Reports. (U. S. Circuit Court.)
Hopkins	Hopkins's Chancery Reports. (New York.)
How. App. Cas.	Howard's Appeal Cases. (New York.)
How. Pr.	Howard's Practice Reports. (New York.)

Hughes	Hughes's Reports. (U. S. Circuit Court.)
Hun	Hun's New York Supreme Court Reports.
Ill.	Illinois Reports.
Ind.	Indiana Reports.
J. & W.	Jacob & Walker's English Chancery Reports.
Johns.	Johnson's Reports. (New York.)
Journ. du Palais	Journal du Palais. (Paris.)
Jur.	The Jurist.
K. & J.	Kay & Johnson's English Vice-Chancellor's Reports.
Keen	Keen's English Rolls Court Reports.
Kent. L. R. and J.	Kentucky Law Reporter and Journal.
Keyes	Keyes's New York Reports.
La. Ann.	Louisiana Annual Reports.
Leg. Int.	Legal Intelligencer.
Leg. Obs.	Legal Observer.
L. J. Ch.	Law Journal, Chancery.
L. J. C. P.	Law Journal, Common Pleas.
L. J. Ex.	Law Journal, Exchequer.
L. J. K. B.	Law Journal, King's Bench.
L. J. M. C.	Law Journal, Magistrates' Cases.
L. J. Notes of Cas.	Law Journal, Notes of Cases.
L. R. (Ireland) Ch. D.	Law Reports (Ireland), Chancery Division.
L. T. R.	Law Times Reports.
Lloyd	Lloyd on Trade Marks. (London.)
M. & C.	Mylne & Craig's English Chancery Reports.
Mackey	Mackey's Reports. (Supreme Court of F. C.)
Madd.	Maddock's English Chancery Reports.
Man. & Gr.	Manning & Granger's English Common Pleas Reports.
Man., Gr. & S.	Manning, Granger, & Scott's do.
Mason	Mason's Reports. (U. S. Circuit Court.)
Mass.	Massachusetts Reports.
McLean	McLean's Reports. (U. S. Circuit Court.)
Md.	Maryland Reports.
Mer.	Merivale's English Chancery Reports.
Mich.	Michigan Reports.
Mo.	Missouri Reports.
Mo. App.	Missouri Appeals Reports.
Mod.	Modern Reports, English King's Bench.
Mont., D. & DeG.	Montagu, Deacon, & De Gex's Reports. (Lord Chancellor, etc.)
Monthly L. R.	Monthly Law Reporter.

N. C.	North Carolina Reports.
N. & M.	Neville & Manning's English King's Bench Reports.
N. R.	The New Reports. (English.)
(N. S.)	New Series.
N. W. Reporter.	Northwestern Reporter.
N. Y. Leg. Obs.	New York Legal Observer.
Off. Gaz.	Official Gazette of the United States Patent Office.
Ohio S.	Ohio State Reports.
Oreg.	Oregon Reports.
Pacific Coast L. J.	Pacific Coast Law Journal.
Pa. L. J.	Pennsylvania Law Journal.
Pemberton	Pemberton on Judgments.
Penn. L. J.	Pennsylvania Law Journal, Reports.
Penn. St.	Pennsylvania State Reports.
Pet.	Peters's Reports. (U. S. Supreme Court.)
Phil.	Phillips's English Chancery Reports.
Phila.	Philadelphia Reports.
Pick.	Pickering's Reports. (Massachusetts.)
Pop.	Popham's English King's Bench Reports.
Poth. des Ob.	Pothier on the Law of Obligations.
R. Cox.	American Trade-Mark Cases. (Rowland Cox)
Rep.	The Reporter.
Rev. Stats.	Revised Statutes of the United States.
R. I.	Rhode Island Reports.
Robertson	Robertson's Reports. (New York Superior Court.)
Rose	Rose's Reports, English Bankruptcy.
S. & S.	Simons & Stuart's Reports, English Chancery.
Sandf. Ch.	Sandford's Chancery Reports. (New York.)
Sandf. S. C.	Sandford's Supreme Court Reports. (New York.)
Scot. L. Rep.	Scottish Law Reporter.
Seld.	Selden's Reports. (New York.)
Seton	Seton's Forms of Decrees in Equity.
Sim.	Simons's English Vice-Chancellor's Reports.
Supp. Rev. Stats.	Supplement to Revised Statutes of United States.
Swanst.	Swanston's English Chancery Reports.
T. R.	Term Reports.
Trade Marks	British and Foreign Journal of Commerce, Trade Marks, and International Exhibitions.
U. S.	Reports of the Supreme Court of the United States,
Upton	Upton's Trade-Marks.

V. & B.	Vesey & Beames's English Chancery Reports.
V. R. (W. W. & A'B.)	Wyatt, Webb, & A'Beckett's Victoria Reports. (Equity.)
Ves.	Vesey's English Chancery Reports.
Vict. L. R. Eq.	Victoria Law Reports. (New Series.) Equity.
W. N.	Weekly Notes of Cases.
W. R.	Weekly Reporter, London.
Wall.	Wallace's Reports. (U. S. Supreme Court.)
Wall. Jr.	Wallace, Jr. (U. S. Circuit Court.)
Watts & Serg.	Watts & Sergeant's Pennsylvania Reports.
Wend.	Wendell's Reports. (New York.)
West. Jur.	Western Jurist.
West. L. J.	Western Law Journal.
Wilson (Ind.)	Wilson's Indiana Superior Court Reports.
Wis.	Wisconsin Reports.
Wood. & M.	Woodbury & Minot. (U. S. Circuit Court.)
Woods	Woods's Reports. (U. S. Circuit Court.)

LAW OF TRADE-MARKS.

CHAPTER I.

INTRODUCTION.

- § 1. Antiquity of the subject.
- § 2. Emblems of ownership coeval with birth of traffic.
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- § 4. Seals, — most sacred proprietary marks.
- § 5. Trade-marks borrowed from heraldry.
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- § 7. Water-marks on paper.
- § 8. Stamps on ancient bricks, tiles, &c.
- § 9. Various kinds of circulating mediums.
- § 10. Stamping of precious metals.
- § 11. In all ages, symbolical expressions in favor.
- § 12. Hieroglyphics required by commerce.
- § 13. Chinese marks on fictile manufactures.
- § 14. Use of emblems on books.
- § 15. Proprietary marks of printers, painters, sculptors, &c.
- § 16. Swan-marks in England.
- § 17. Marks on clay pipes.
- § 18. Trade-marks are generally optional.
- § 19. Hall-marks, &c., in various countries.

§ 1. *Antiquity of the Subject.* — The main subject of this treatise — the symbolism of Commerce — may well be deemed to be as old as commerce itself. The most important part of that symbolism is comprehended in the brief conventional term “Trade-mark.”¹ As the love of gain is inborn, it must

¹ In this age, when steam and electricity have nearly annihilated space, and brought all parts of the world together, it is surprising that the term

be assumed that in even the rudest ages of the world men obeyed the instinct of adding to gains, and therefore guarded against losses incident to keen and perhaps unscrupulous rivalry. By labor or traffic they had things to sell. He who sold and he who bought had alike to deal in faith. The faith had to rest on some mark on goods, some peculiar emblem that gave a quick but emphatic signal. All had to deal on trust, as all do now, and take as proof the representation of the affixed symbol, whether that symbol were the trade-mark of a nation on its coin, or the rude device of an unlettered artisan or trader. A glance of the eye sufficed. The first law of nature — self-preservation — was as potent in the protection of the means of livelihood as of life itself. History proves this.

§ 2. *Seals and other 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 im-

"trade-mark" is misunderstood. In the greater number of standard dictionaries of English there are definitions that do not define. Examine dictionaries.

Worcester, ed. of 1860: "A particular mark, sign, device, writing, or ticket put by a manufacturer upon his goods, to distinguish them from those of others." On the authority of *Bouvier* (*Law Dictionary*).

Webster, ed. of 1883, substantially the same, also limited to a *manufacturer*, on the authority of *Simmonds*.

Imperial Dictionary (by *Ogilvie*), 1883, also so limited.

Dictionary of Commerce and Manufactures, De Colange, 1881, substantially so limited.

Abbott's Law Dictionary properly defines.

Knight's American Mechanical Dictionary, vol. iii., 1876, contains the following, from the pen of the present writer: — "*Trade-Mark*. An arbitrary symbol affixed by a manufacturer or merchant to a vendible commodity. The principal purpose of a trade-mark is to guarantee the genuineness of a product. It is, in fact, the commercial substitute for one's autograph. In all ages it has been used to denote origin, and thus to protect the purchaser as well as the vendor. All countries protect the integrity of trade-marks, and nearly all civilized nations have treaties and conventions securing reciprocity of protection." As *tests*, it also recites the essential characteristics, substantially as in § 143, *infra*. This is a proper definition, in the light of authorities, as late as the year 1885.

pressed 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*;¹ 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 incipiency of commercial spirit. What more natural than to affix a mark of identity to anything 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 — who, in the first age of the world, was “an instructor of every artificer in brass and iron” — was wont to impress upon 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

¹ As to the technical meaning of these words, as defined by the courts, see Chapter IV., “Indication of Origin or Ownership.”

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 to inanimate property, 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 that the symbol of ownership might as well be applied to one kind of personal property as to 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.¹ 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";² and St. John tells of the mighty host who were sealed in their foreheads.³ We speak of the seal of baptism, the seal of holy communion,

¹ See Gen. xxxviii. 18; Exod. xxviii. 11.

² 2 Tim. ii. 19.

³ Rev. vii. 3.

the seal of matrimony, and, most solemn of all, the seal of death.¹

§ 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, on the field of which 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, inasmuch as it possesses a system, a classification, and a language, of its own, — which language speaks forth in many 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, signifying *to burn*) is a sign 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, seals are regarded as precious jewels 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 Aventinus "insigne paternum" upon his shield, — his hereditary device, derived by him from his father.² Badges are likewise proprietary marks: "Might I but know thee by thy household badge,"³ says Shakespeare; and again he says,

¹ See "seal," 1 Kings xxi. 8; Nehem. ix. 38; and "sealed," Esther iii. 12. As to engraving, see Exod. xxviii. 2, "engraven in stone"; Job xix. 24, "graven with an iron pen and lead"; Jer. xvii. 1, "with a pen of iron, and with a point of a diamond: it is graven."

² Æneid, vii.

³ Henry VI., Part II., Act 5.

“For sufferance is the badge of all our tribe.”¹ The label, another heraldic term, is connected with trade-marks only as far as being a groundwork for figures or other devices.²

§ 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 less eager than their successors in the great bazaar 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. Among 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 driving 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 checkers. 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-emblem 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 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

¹ Merchant of Venice, Act 1.

² The signs belonging to tradesmen in the Middle Ages were heirlooms, but were gradually disused, until, from the development of international commerce, a “sign” on goods for sale became a necessity. Piracy on such marks became a trade with inferior tradesmen. The Globe Encyclopædia, *Trade-marks*.

acquirement with the commonalty; and consequently to write the trader's or owner's name would be of little avail. Those who 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 inn-keeper to emblazon on his signboard the family crest of the lord of the estate whereon he lived! Luther was generally represented by the symbol of a swan; and hence "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? Who can tell?

§ 7. *Water-marks* on paper are used as proprietary signs. Temporary or accidental emblems have sometimes become permanent associations, as in the case of the kind of paper termed foolscap. In the reign of Charles I., all English paper bore in water-marks the royal arms. Cromwell's Parliament, to cast indignity upon the memory of the unhappy monarch, substituted the fool's cap and bells. Although in the course of events these symbols were discontinued, the name sticks. A notable instance of a sort of water-mark is that shown in obligations and other securities issued by the United States, in which threads of various-colored floss-silk are distributed through the paper in the process of manufacture. Such threads constitute a proprietary mark of the government; and it is a highly penal offence for any person to have such paper in his control or possession.¹ It may not seem irrelevant to allude to an interesting law case, which was decided by means of a water-mark on paper. There was produced a forged will, so cunningly executed that, although believed to be false, legal evidence of the fact of falsity was lacking. As the counsel of the rightful heir sat studying over the case at night, he chanced to hold the paper between his eyes and a candle.

¹ Revised Statutes of United States, sect. 5430.

He thus discovered in water-marks the figures of the year in which the paper was made. It was a period of years *after* the date of pretended execution.

§ 8. If one class of workmen might profitably employ peculiar marks to indicate origin, as well might any other class. The mechanics in the quarries, making ready the stones for the temple of Solomon, availed themselves of this mode of proving their claims to wages. Recent discoveries confirm tradition. The cinders of burnt Jerusalem have been cut through, and turned up to the light. While the seal of Haggai, in ancient Hebrew characters, has been picked up out of the siftings of the rich moulds deposited with the ruins of the treasures of Jewish pride, the first course of stones deposited by Phœnician builders has been reached. Quarry-marks put on in vermilion have been copied, — known to be quarry-marks by the trickled drops of the paint, still visible; only they are above the letters, showing that when they were affixed the stones lay with the under side uppermost.¹ The same practice continues to this very day, where many men are employed. The engineer and the architect know every mark, and thus can instantly fix the origin of the work. Our own artisans do not stop to think whether they are not pursuing the practice of forerunners of several thousand years ago. The tile-maker stamps his products with his private mark; and sometimes common building-brick is impressed with its maker's seal, rude though it be. The most ancient bricks, recovered from the ruins of temples of Nineveh and of Egypt, also bear many marks of origin. It was the rule of Nebuchadnezzar to have his name stamped on every brick that was used during his reign in erecting his colossal palaces. Sir Henry Rawlinson discovered on each brick in the walls of the modern city of Bagdad, on the borders of the Tigris, clear traces of that royal signature.² Fragments of pottery, having peculiar marks of workmen are everywhere found in the ancient cities of the East; pottery, as

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

² Müller's Science of Language. Also, Knight's Mechanical Dictionary, title "Brick."

Brongniart has remarked, affording the best records of the early ages of man, as bones do of the earth.¹

§ 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. 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 nine²) 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 having failed to receive full confidence, it was supplanted by actual coinage, which many authorities date from about seven centuries before the beginning of the Christian era.³ Homer, 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

¹ See lecture by Prof. J. Forbes Boyle, F. R. S., on Arts and Manufactures of India; History of the Ceramic Art, from the French of Albert Jacquemart, London, 1873; and “Marks and Monograms on Pottery and Porcelain,” &c., by William Chaffers, 4th ed., 1874, with 3,000 potters’ marks and illustrations.

² Gillies’s Ancient Greece, vol. i. p. 11.

³ Snowden’s Mint Manual of All Nations.

heroes. It was probably about the time that Daniel was cast into the lion's 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 engraved, 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 Maccabee. The first money coined in England was under the Romans at Colchester.

§ 10. There must have been an interval of over a 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 referred 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 have. 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

¹ Gen. xxiii. 14-16.

in the arts both of use and beauty. All these peoples 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 distinguishing 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. *Commerce required its hieroglyphics*, and commerce was world-wide. The situation of Babylon, at the head of the Persian Gulf, was admirably adapted for trading purposes; and, 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, — all sorts of serviceable commodities, — were floated on the Euphrates and the Tigris, or brought in caravans of camels to the grand central mart, every 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 claim to possess an exact chronology from the remotest antiquity to the present 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 Porcelain of China had sixteen hundred years' priority of invention over that of Europe ; and 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, indicates the author of a vase, the place of manufacture, or the destination of the article, as for the use of the Emperor or other dignitary. On a piece of pure white china of great antiquity there was found stamped a factory-mark.

§ 14. The makers of books found it convenient to use arbitrary signs to authenticate their works. 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 half of all 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 " Spiegelmakers " (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 Estienne, a bookseller and printer, whose firm for several generations continued to be the leading publishers and printers in Paris. The booksellers generally had wood-cuts of their signs for colophons of their books, so that their shops might become known by

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

² Histoire et Fabrication de la Porcelaine Chinoise. Translated from the Chinese, by Julian. Paris, 1856. — An interesting book is " The Old Derby China Factory," &c., by John Haslem. London, 1876. (Fac-similes of old marks.)

the inspection of the cuts. 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's *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 Cramoisy; 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

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

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 Bruliot, published at Munich in 1832-34, and to be found in the Astor Library in the city of New York, and also 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 they were to be perfectly distinct from those used by other gentlemen. For instance, the company of the vintners had two nicks on the bills of their shows. 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.¹

¹ Care must be taken not to confound mere proprietary marks and technical trade-marks. For examples of the former kind, see the act of the legislature of Canada, of May 12, 1870, (33 Victoria, c. 36,) respecting the marking of timber. It enacts that every person engaged in the business of lumbering or getting out timber, and floating or rafting the same on the inland waters of Canada within the provinces of Ontario and Quebec, shall, (under certain penalties for failure or neglect so to do,) within one month after he shall engage therein, select a mark, or marks, and, having caused the same to be registered as therein provided, shall put the same in a conspicuous place on each log or piece of timber so floated or rafted. These marks are *proprietary* and not *trade marks*. — The Indian Penal Code (Calcutta, 1861), Act No. XLV. of 1860, sect. 479, provides that a mark used for denoting that movable property belongs to a particular person shall be known as a *property-mark*, as contradistinguished from a trade-mark.

In various countries, and in our individual States, there are legislative provisions for marks or brands for cattle, or ear-marks for swine, or paint-marks for sheep. Such are simply means of identifying and proving property. Of course, all such marks may be made to serve a secondary purpose, by being adopted and known as symbols of commerce.

§ 17. The case of *Southron v. Reynolds*,¹ in England, in 1865, was in regard to a violation of a trade-mark used on clay pipes made at Broseley. "Brosley" is a household word with thousands who use the thing while wholly ignorant of its derivation, 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, no 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 ninety 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, France, and several other European countries, as well as in countries on our own continent; but there are exceptions in connection with various kinds of business. Thus, 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

¹ 12 L. T. R. (N. S.) 75.

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 then dealt in the precious and useful wares, as they do now.

§ 19. *Hall-marks* are among obligatory emblems. The first instance on record, in England, 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. In 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. In 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 century. In France there are standard and assay stamps required by the law of April 7, 1838. That country has also found it expedient to adopt a system of stamps analogous to the English Hall-marks, although they are not obligatory. A law of November 26, 1873, provides for a stamp or special sign to be affixed to marks of commerce or manufacture, as a guaranty thereof. Under its provisions

every proprietor of a mark duly registered conformably to the law of June 23, 1857,¹ shall be allowed, on his written request, to have affixed by the state, either on his paper labels, bands, or envelopes, or on his metallic labels, or stamps, a special stamp or punch to authenticate his mark. The duty to be paid therefor is from a centime to a franc. For affixing the punch directly to merchandise, the duty is from five centimes to five francs. A penalty is prescribed for counterfeiting or falsifying a special stamp or punch.² The government of Switzerland has recently recognized the necessity for obligatory marking of gold and silver watch-cases and jewelry. From the beginning of the year 1882, all watch-cases of gold of 18 carats, or 750 thousandths, and above, were required to be officially stamped with the designated figure of the head of a woman facing the left-hand side; and those of 14 carats, or 583 thousandths, must be stamped with the representation of a squirrel erect, facing the right-hand side. Silver cases of 875 thousandths, and above, must be stamped with the figure of a lion rampant, looking to the left-hand side; and if of 800 thousandths, with that of an arbitrary heraldic fowl running towards the right-hand side. The part to be stamped is also prescribed. The marking is obligatory, i. e. the article must bear the federal assay-mark. For other gold and silver ware, the marking is optional; but none such must bear any untrue indication of standard. For the infraction of that law, whether in manufacturing, selling, or offering for sale, severe civil and criminal penalties are prescribed.³

¹ See Law, in Appendix.

² See *Journal Officiel*, of Dec. 2, 1873; and 19 *Annales*, &c., 193.

³ *Horological Journal*, London, 1882, vol. xxiv. p. 129. — See William Chaffer's interesting book (5th ed., London, 1874), entitled "Hall-Marks on Gold and Silver Plate," &c.

CHAPTER II.

PROTECTION OF TRADE-MARK PROPERTY.

- § 20. RIGHT TO PROTECTION, — gradual recognition of.
- § 21. Alien friends, — protected the same as citizens.
- § 22. Comity of nations requires protection.
- § 23. Natural right of foreigners to protection.
- § 24. Mutual confidence a bond among nations.
- § 25. Progress of protection.
- § 26. Legislation of various nations, — detail of.
- § 27. Time come for equal protection.
- § 28. Constantly increasing importance of trade-marks.
- § 29. Limitation of right of protection to symbols.
- § 30. Mere imposition on public not ground of private suit.
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- § 38. Question of fraud judged of as between immediate parties.
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- § 40. Protection a powerful incitement to integrity in trade.
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§ 20. *Right to Protection.* — The right of protection to trade-marks and their analogues, i. e. signs not technical marks, has come to be recognized throughout the domain of civilization. It was not always so, even after arbitrary symbols were recognized in commerce as exclusive property. As was said by a writer in 1874,¹ the law for the protection of this species of property is almost exclusively the growth of the last seventy or eighty years, and affords an interesting illustration of the process by which a few principles, at first doubtful and disputed, may be expanded into a complete system of jurisprudence. In 1742, Lord Hardwicke, C.,² used language that at the present day could not be countenanced in any tribunal of equity in the known world. He said: "Every particular trader has some particular mark or stamp; but I do not know of any instance of granting an injunction here to restrain one trader from using the same mark with another, and I think it would be of mischievous consequence to do it." He, accordingly, for want of precedent, refused an

¹ Adams on Trade-Marks, London.

² *Blanchard v. Hill*, 2 Atk. 484.

injunction to restrain the use of the Great Mogul stamp on cards, no suggestion being made as to the validity of that fanciful name as a trade-mark. His attention was called to an action on the case for deceit,¹ in which Doderidge, J., cited a decision of the same court in the reign of Queen Elizabeth, that an action on the case for deceit would lie against a clothier who had applied another's mark to his own inferior cloth. But that case is somewhat in the mist. Popham says, that the action was brought by the defrauded clothier, and Croke says, by the purchaser; but Rolle states that this was not specified, and conjectures that it was by the purchaser. — In 1783, Lord Mansfield, C. J., said plainly:² “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.” — It seems that no courts of equity favored such proprietary rights until Lord Eldon, C., in 1803,³ granted an injunction to restrain the wrongful use of the name of a publication, such name being of the nature of a trade-mark. — The right to protection in the Federal or State courts of the United States was never contingent on registration, or even publication. It might be thought otherwise, if the words of Mr. Justice Clifford in the Supreme Court of the United States were taken too literally.⁴ He said: “Protection for lawful trade-marks may be obtained by individuals, firms, or corporations, entitled to the same, if they comply with the requirements prescribed by the act of Congress.” Of course, he did not mean that there is no protection irrespective of a statute, for in his judicial practice he had had occasion to rule otherwise. Many of the States of this Union have enacted laws, both of a civil and penal nature, for the protection of marks of trade and commerce; but probably in no one of them would it be deemed that a compliance with registration acts is a condition precedent to a suit for vindication. We know that in Great Britain, France, and in other

¹ *Southern v. How*, temp. Jac. I., Common Pleas, Popham, 144; Cro. Jac. 471; 2 Rolle, 28; R. Cox, 633.

² *Singleton v. Bolton*, 3 Doug. 393.

³ *Hogg v. Kirby*, 8 Ves. 215.

⁴ *McLean v. Fleming*, 96 U. S. 248.

countries, it is absolutely necessary for the proprietor of a trade-mark to comply with registry laws before asking for judicial redress.¹ When the reader shall come to Chapters VI. and VII. of this treatise, he will see that registration is in aid of common law and equity, and is not subversive of pre-existing rights and remedies. The registration act of Congress, referred to by Mr. Justice Clifford, contained the words "may obtain protection"; but the act of March 3, 1881, which takes the place thereof, has studiously avoided the use of such misleading language. Certain and great advantages are given to him who registers thereunder; but if our courts can entertain jurisdiction on general grounds, a lack of registry will not defeat.²

§ 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. And this does not depend upon reciprocity. "The cannibal of the Fejees may sue here in a penal action though having no courts at home for us to resort to. . . . 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."³ 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."⁴ What is thus said is equally the rule of the individual States of this country. It is the law of England. In 1857 Vice-Chancellor Wood said, that any fraud may be redressed in the country in which it is committed, whatever may be the country of the person who is defrauded.⁵ In the same year, the same learned jurist said as to the same attempted defence: "I apprehend

¹ See Statutes, in Appendix.

² Registration Act of March 3, 1881, sect. 10.

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

⁴ *Taylor v. Carpenter*, 2 Wood. & M. 1.

⁵ *The Collins Co. v. Brown*, 8 K. & J. 428; 3 Jur. (n. s.) 929; 29 L. T. 245; 8 L. T. 62.

that every subject of every country, not being an alien enemy, — and even to an alien enemy the court has extended relief in cases of fraud, — has a right to apply to this court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right, a right recognized, I imagine, everywhere in the world, or at least in every civilized community, of saying, ‘We, being the manufacturers of certain goods, claim that another man shall not manufacture goods, and put upon them our trade-mark, and then pass them off as manufactured by us.’” — So, also, in 1858, Vice-Chancellor Stuart said of the plaintiffs: “Though they are aliens, they are entitled to sue in this court against any fraudulent invasion of their right, and that notwithstanding that the tools stamped with the marks, the fraudulent use of which is complained of, are not usually sold by them in this country.”¹ And one is entitled to such protection, although at the time that the cause of complaint arose he was an alien enemy. In the German Imperial Court of Colmar, in 1873,² the defence in a case of piracy of a trade-mark was, that, by reason of the war between France and Germany, the treaties of commerce between the two countries had been suspended. In Germany, merchants in various wines imitated the trade-marks and labels of the French houses at Rheims, Epernay, and other places. They relied for impunity upon the fact that others had at the same time pirated on tobacco-marks. It was a mixed case. The counsel for the appellants (defendants below) spoke in German; the respondents’ counsel spoke in French; the court, in German. But there was no confusion of tongues, nor of moral ideas. *Held*, that the state of war did not tolerate dishonesty.

§ 22. The comity of nations makes new concessions and demands in regard to the protection of commercial and industrial property, whatever may be the nationality of the suppliant for justice. The national sense of right, blunted by the long-prevailing feudal rule, that might makes right, is becom-

¹ *The Collins Co. v. Reeves*, 28 L. J. Ch. 56; 4 Jur. (N. S.) 865; 33 L. T. 101; 6 W. R. 717.

² *Say v. Durringer et al.*, 18 Annales, 148.

ing more acute. Countries that have heretofore been honest from policy are simultaneously rising to a high plane of morality. Laws like that of Luxembourg,¹ which denied to foreigners, not domiciliated, redress for usurpation of marks and names, and similar laws of other European countries, are gradually fading out. The prevailing spirit is that displayed in the Tribunal of Commerce of Geneva, in 1859.² It was there substantially held that the name of a manufacturer, and his mark, are his property under the law of nations. This doctrine has long been maintained by eminent jurists of England, France, and Germany; and as the nations find it to be as much to their interest as to their glory to throw down barriers, this doctrine is fast approaching world-wide acknowledgment. For proof, let us look at the treaty agreed upon in Paris, March 20, 1883, by the International Conference for the Protection of Industrial Property, at which twenty nations were represented.³ It provides that subjects or citizens of each of the contracting states shall enjoy in all other states of the union, in that which relates to patents of inventions, industrial drawings or models, trade or business marks, and commercial titles, the advantages which the respective laws accord now or shall accord hereafter to their own citizens. Accordingly they shall have the same protection as such citizens, and the same legal remedy for every infringement of their rights, under the reserve of conformity with the formalities, and upon the conditions imposed upon citizens by the interior legislation of each state. (Art. 2.) The subjects of states not belonging to the union, who are residents of, or have industrial or commercial establishments within any of the states of the union, are assimilated to the subjects or citizens of the contracting states.

¹ Müller v. Haymann, 5 Annales, 62.

² Christoffe & Co. v. Deleiderrier, 6 Annales, 29.

³ Art. 1 reads: "Austria, Hungary, the Argentine Confederation, Belgium, Brazil, the United States of America, France, Great Britain and Ireland, Guatemala, Italy, Holland, Portugal, Russia, Sweden and Norway, Salvador, Switzerland, Turkey, Uruguay, and the United States of Venezuela, have entered into a union for the protection of industrial property." In 1885, our Senate postponed its consideration.

(Art. 3.) — But we are now considering only the distinctive emblem of one's individuality, i. e. his signature or mark upon his fabrics or merchandise, the existence of which depends solely on his own will. He created it: it is his property. Artificial rights, such as those pertaining to patents for inventions, have heretofore been the subjects of authorized plunder in even so enlightened a nation as the United Kingdom of Great Britain and Ireland; and to the present time, in our own country, the devouring of the children of the brain of foreign authors has perfect freedom. But the laws of commerce have always been governed by the maxim, *Debitum et contractus sunt nullius loci*, and a trade-mark belongs to commerce, and rules and maxims of debt and contract are applied to it; for the symbol has no vitality unless affixed in some physical way to something that is the subject of barter and sale. During all ages, in all parts of the commercial world, he who counterfeited or simulated, either by design or accident, that emblem of manufacture or traffic tersely designated a *trade-mark*, was deemed guilty of a tort. For such tort there should be ample redress by local laws. As was well said by Brady, J., in 1883,¹ in regard to protection, the ultimate object of the courts has been in all the cases of trade-mark adjudication, not only to protect and encourage honest competition, as a matter of public policy, but to condemn anything like dishonest traffic, or fraudulent or unjust attempts to invade existing rights.

§ 23. The natural right of foreigners to exclusive ownership of this arbitrary symbol for goods, while expressly or tacitly admitted by the jurisprudence of all civilized nations, has harshly been refused protection in default of specific treaty stipulations to that effect. Legislatures and judicial tribunals of even European states have so transgressed against conceded rights, and refused all remedies. 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.

¹ *Electro-Silicon Co. v. Hazard*, 29 Hun, 368.

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 they were aliens to France.¹ But such a state of affairs is rapidly obsolescent. The shortest way out of the difficulty has been taken, and treaties, conventions, and arrangements, scores in number, have been made to secure such rights of foreigners.

§ 24. Mutual confidence is the bond of union among nations and peoples. It follows, therefore, that whoever weakens such confidence by forgery, counterfeiting, or any other fraud, and begets distrust in mercantile dealings, is an enemy to all mankind. He becomes a pirate; and whether preying directly upon commerce on the high seas, or practising knavery and trickery on 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. Chief Justice Hargis, of the Kentucky Court of Appeals, in 1883, truly said:² “The trade-mark and the trade-reputation pirate always undertakes the difficult task of sailing between the Charybdis and Scylla of the law, but he should never be allowed a successful voyage. If, on the one hand, he escapes the rock by not infringing through the instrumentality of the trade-mark itself, he will not, on the other, if courts of equity are true to the principles of their own existence, be allowed a safe passage by the use of any means of deceit or false representation known to the inventive brain of man.” We know that a general declaration of war against such spoliators is about to be proclaimed. Mutual reliance must be the rule. Every act of trade, by which operations to an almost boundless extent are daily transacted, is essentially founded on confidence. By the simple delivery of bits of paper bearing certain signs, millions of dollars are hourly transferred; and contracts of the greatest magnitude are

¹ 1 Annales, 36. (The matter has since been cured by a treaty between Great Britain and France.)

² *Avery & Sons v. Meikle & Co.*, Kent. L. Rep. and Journal, April, 1883, 23 Alb. L. J. 203.

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 weaker; 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 their 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 the heart of Jobard. France itself has made more than forty treaties and conventions on the subject 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

¹ Jobard, *Organon de la Propriété Intellectuelle*.

activity, and behold the breaking down of the barriers of suicidal proscription.¹

§ 26. *Legislation of Various Nations.* — It may be profitable to glance at the course of legislation of various nations on this subject. Perhaps France may be considered as the pioneer in general provisions for protecting marks of manufacture and trade. M. Treitt, of the French government, in an official letter to Lord Lyons, British Minister, said: The origin of trade-marks is as old as commerce itself. From the Middle Ages we find laws and regulations concerning such marks. But all those provisions were heterogeneous, unequal, and sometimes contradictory.² Special manufactures were favored, and the laws intended to protect their marks were sometimes very severe. A French writer tells us that these early laws, much anterior to industrial emancipation, were characterized with the rigor and penal exaggerations which always mark the essays of legislators. He says that a trace of this is found in the statute of 1666, relating to the fabrication of cloth of Carcassonne. The penalty for counterfeiting a trade-mark was six hours in the *carcan*,³ and that was not changed until 1745. There were a number of other subsequent French laws on the subject, for special protection. The law of July 18, 1824, for the protection of property in commercial names, is the one anterior to 1857 that most concerns us; for, as M. Treitt says, recent judicial decisions have held that commercial names of foreigners (coming within the conditions of international treaties) are as implicitly protected in his country as are the names of French houses, — absolutely as fully as trade-marks are. On the 23d of June, 1857, France enacted her present excellent trade-mark registration law; and, to a greater or less extent, it has been imitated by divers

¹ In the Tribunal of First Instance of Ismailia, Egypt, in 1876, it was *held*: In the absence of a special law in Egypt for the protection of industrial rights, &c., natural law and equity shall be invoked. Hippolyte Arnoux *v.* Spiridione Antippa and Georges Zanghaki. On appeal, this doctrine was affirmed. Reports of Legislation in Foreign Countries, &c., Part II. p. 20.

² Reports of Legislation in Foreign Countries, p. 31.

³ An iron collar by which the condemned was fixed to a post. The punishment was entirely suppressed in 1832. See Littré's Dictionary; also Blanc, *Traité de la Contrefaçon*, 773.

other nations. The matter had so carefully been considered by statesmen and legislators that its original text remains unchanged. — In the edition of 1857 of the Code of Civil Laws of Russia is found the law relative to the imposition of marks on products of Russian mills and manufactures. Austria enacted her registration law in 1858. In 1862, the British Parliament passed “An Act to amend the law relating to the fraudulent marking of merchandise.” This is a penal statute directed against the forgery or counterfeiting of trade-marks, or the false application to goods, or to a vessel, case, wrapper, &c., of a false mark; the selling of articles by such false mark; or the false indication by description or statement, or respecting number, quantity, measure, or weight, of a chattel or article, or the sale of articles bearing the same. This statute did not affect the pre-existing common law and equity rights of action or suit by the aggrieved owners of the mark infringed on. The Kingdom of Italy passed a registration act in 1868; Turkey, in 1872; France, in 1873 (special-guaranty stamps, etc.);¹ the German Empire, and Chili, in 1875; the Argentine Republic, in 1876; Belgium, Switzerland, Roumania, Dominion of Canada, in 1879; Denmark and the Netherlands, in 1880. — In this country, nothing was done by the national legislature until the registration act of July 8, 1870, was passed. The promoters of the bill had very little knowledge of the general common law of the matter, and not the slightest regard to the Constitution. Indeed, it was not perceived what part of the Constitution was applicable to it. By a very great blunder, it was classed with inventions and authorship, and sandwiched in between the patent law and the copyright law in the same chapter. The writer of this book was the first officer who had to construe and apply its provisions. He had been selected from a belief that he possessed some knowledge of the principles of the matter. Soon seeing its more gross faults, he drafted bills and presented them to Congress. Committees did not wish to act until the courts had expressed an opinion as to validity. In 1871, an act was passed to prevent the importa-

¹ *Ante*, § 19.

tion of watches, or parts of watches, bearing the counterfeit marks of manufacturers in this country.¹ In 1876 was passed "An Act to punish the counterfeiting of trade-mark goods, and the sale or dealing in counterfeit trade-mark goods."² This act is still in force and effect, although, it must be admitted, it has for years been in a semi-comatose condition. The cause of that condition is, that it has seldom been roused into action, owing to misunderstanding as to its validity. An explanation is demanded. Briefly, the facts are as follows. In three cases, persons had been indicted for counterfeiting trade-marks. It will be noticed that that penal act referred only to trade-marks registered "pursuant to the statutes of the United States." The prisoners demurred to the several indictments. That compelled an examination into the question of the validity of the registration act of July 8, 1870; for that was the fulcrum of the lever. On a division of opinion in the courts below, the Supreme Court of the United States had to decide the question. That act was declared to be unconstitutional. Why? Because there had been a blundering looseness of phraseology, in not confining the provisions of the act to the kind of commerce over which Congress has control; viz. that with foreign nations, among the several States, and with the Indian tribes. Said Mr. Justice Miller, in delivering the opinion of the court:³ "If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it." That is to say, the penal act of 1876 was inoperative in the cases before the court. It was never intended to be declared unconstitutional *per se*. That act was virtually re-adopted by Congress in passing the Supplement to the Revised Statutes, on June 7, 1880. The court having authoritatively indicated the errors that had been committed for lack of artificial language, the writer prepared a new bill. After much mutilation, and some admixture of absurdities in the first and last sections, it became the regis-

¹ Revised Statutes, sect. 2496; amended in 1883 to include *any other* articles.

² Supplement to Revised Statutes, vol. i. ch. 274.

³ Trade-Mark Cases, 100 U. S. 99.

tration act of March 3, 1881.¹ It was amended in a slight particular, August 5, 1882.² As intelligence develops, it will no doubt be amended and perfected. It does not require a very keen intellectual vision to perceive that the penal act of 1876 immediately thereupon started into full vigor, and is operative in conjunction with the civil registration law.³— In 1883, the Grand Duchy of Luxembourg passed a general registration act, and, in the same year, Great Britain amended the acts of 1875–76. — By Imperial decree, dated June 7, 1884, very excellent trade-mark regulations were promulgated in Japan, with elaborate by-laws for registration purposes. — From these citations, it is manifest that the sentiments of nearly all nations are in harmony.

§ 27. Said an able writer in France, in 1855 :⁴ “The moment has now come for each state to prescribe in its legislation, that the names and marks of manufactures 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 the annihilation of distances by the agencies of steam and electricity, a noble and enlightened competition has been established, and promises to exert a sway over the whole earth. Commerce and industry are constantly becoming less centralized, and the laws thereof are becoming assimilated. Verily, the trade-mark has become a symbol of importance. The mightiest monarchs respect it. The recognition of it is world-wide, for it spurns the thralldom of territorial limits. All peoples might adopt the ideas of Professor Leone Levi, 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

¹ See Chapters VI. and VII. of this book.

² Providing that nothing contained in the act of 1881 “shall prevent the registry of any lawful trade-mark rightfully used by the applicant at the time of the passage of said act.”

³ See Appendix.

⁴ 1 Annales, 33

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, everywhere accredited, that the coin is of a specific weight and fineness. Why should it not be now as in former times, when the mark was not simply the signature of the merchant or the manufacturer, but also a certificate of quantity, given by public authority, touching the quality of the produce, its origin, weight, &c. ? ¹

§ 28. With the constantly increasing importance of the trade-mark, so much greater is the eagerness to ascertain and apply the principle upon which its security depends. It has the good wishes of honest industry and commerce. It incurs the ill-will of nobody, for it has not the least taint of odious monopoly or of restriction of trade. Competition is left free to all. The counterfeiter pays it a tribute of respect by his wrongful imitations. The principle on which relief and protection depend has been enunciated in a long train of decisions of learned judges. It is, that a man is not to sell his own goods under the pretence that they are the goods of another man: he cannot be permitted to practice such a deception, nor to use the means which contribute to that end.² You may express the same principle in a different form, and say that no man has a right to dress himself in colors, or adopt and bear symbols, to which he has no peculiar or exclusive right, and thereby personate another person, for the purpose of inducing the public to suppose, either that he is that other person, or that he is connected with and selling the manufactures of such other person, while he is really sell-

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

² Perry v. Truefitt, 6 Beav. 66; 1 L. T. 384.

ing his own. It is perfectly manifest that to do these things is to commit a fraud, and a very gross fraud;¹ and the effect of false representations, thus held out, is to deprive the owners thereof of the profits of their skill and industry. One is only required to depend for success upon his own character and fame.² 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 trade-mark, indicating to those who wish to give him their patronage that the article is manufactured or sold by him, or by his authority, he is entitled to protection against a defendant who attempts to pirate upon the good-will of the complainant's friends or customers, or the patrons of his trade or business, by sailing under his flag without his authority or consent.³ The manufacturer's trade-mark is an assurance to the public of the quality of the goods, and a pledge of his own integrity in their manufacture or 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 the individual, require that the necessary protection shall be given.⁴ If an article by representation be so assimilated as to be taken in the market for an established manufacture or compound of another, the injured person is entitled to an injunction.⁵ The owner of the mark has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking exactly like it, but that they shall not sell it in such a way as to steal (so to call it) his trade-mark, and make purchasers believe that it is the manufacture to which that trade-mark was originally applied.⁶

§ 29. But when we speak of protection to a symbol of any

¹ *Croft v. Day*, 7 Beav. 84.

² *Taylor v. Carpenter*, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45.

³ *Partridge v. Menck*, 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72.

⁴ *The Amoskeag Manufacturing Co. v. Spear*, 2 Sandf. S. C. 590; R. Cox, 87.

⁵ *Coffeen v. Brunton*, 5 McLean, 256; R. Cox, 132.

⁶ *Farina v. Silverlock*, 6 De G., M. & G. 217; 26 L. J. Ch. 11; 2 Jur. (n. s.) 1008; 27 L. T. 277; 4 W. R. 731.

kind claimed as a trade-mark, we must understand that there is a limitation to the right. The trade-mark which is entitled to protection must be such as will identify the article to which it is affixed as that of the person adopting it, and distinguish it from others.¹ For example: if a trade-mark consist of words, as it may, such words must be specific and distinctive in their meaning;² and words and names that may be claimed and used by all cannot be exclusively appropriated to advance the interest of any one person.³ There is no principle more firmly settled in the law of trade-marks, than that words and phrases, which have been in common use, and which indicate the character, kind, quality, and composition of the thing, may not be appropriated by one to his exclusive use.⁴ No one can claim protection for the exclusive use of a trade-mark which would practically give him a monopoly in the sale of any goods.⁵ The foregoing remarks, which are mostly in the exact words of judges, are examples of the sayings of modern courts in an unbroken current of decisions. We see that — subject to necessary limitations against usurpation of the rights of the public at large — one may have in a mere emblem affixed to his goods something more valuable than artificial property, such as a patent for invention or a copyright, to neither of which has a trade-mark any relationship. Sometimes it is the sole means of protection, although its life is limited only with that of the business of which it is the index. 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,

¹ *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340; N. Y. Com. of App., 48 N. Y. 374; 8 Am. R. 553.

² *Fulton v. Sellers*, 4 Brewst. 42.

³ *Newman v. Alvord*, 49 Barb. 588; 35 How. Pr. 108; R. Cox, 404; 51 N. Y. 189; 10 Am. R. 588.

⁴ *Caswell v. Davis*, 58 N. Y. 223; 17 Am. R. 233.

⁵ *Delaware & Hudson Co. v. Clark*, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 79.

and indeed was more efficacious than any patent could be, unless we consider that he did possess an indefeasible 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. A very recent case in England may serve as an illustration. It appeared that iron manufactured in Sweden by Baron de Geer had ever since 1643 been branded (in compliance with Swedish law) with a device consisting of a hoop and the letter L, which device was registered in Sweden as a trade-mark as far back as 1718, and he was protected against imitators.¹

§ 30. *Mere Imposition on the Public*, by the fact of 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 consideration until sure that we comprehend the scope of this brief enunciation. The point is, not the case of the purchaser who has his action for deceit, but of the owner of a peculiar symbol used as a trade-mark which has been encroached on by a rival, or a pirate, and who has a right, in the words of Lord Cranworth, C., to prevent others from selling wares which are not his, marked with that trade-mark, in order to mislead the public, and so, incidentally, to injure the person who is the owner of the trade-mark.² Lord Westbury, C., said that "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property."³ Substantially the same thing was said by the Lord Chancellor in another case.⁴ But the object or purpose of the law in protecting trade-marks as property, says Carpenter, J., is twofold: first,

¹ *Re Heaton's Trade-Mark*, *The Weekly Notes*, July 5, 1884, p. 158.

² *Farina v. Silverlock*, 6 De G., M. & G. 217.

³ *Hall v. Barrows*, 4 De G., J. & S. 150; 33 L. J. Ch. 204; 10 Jur. (n. s.) 55.

⁴ *The Leather Cloth Co. case*, 4 De G., J. & S. 141.

to secure to him who has been instrumental in bringing into market a superior article of merchandise, the fruit of his industry and skill; and secondly, to protect the community from imposition, and furnish some guaranty that an article purchased as the manufacture of one who has appropriated to his own use a certain name, symbol, or device as a trade-mark, is genuine.¹ Bynum, J., said, in substance, that this rule is grounded upon a twofold reason: first, that the public may be protected from being imposed upon by a spurious or inferior article, as an imitation or counterfeit almost always is; and secondly, that the owner may have the exclusive benefit of his reputation.² Brady, J., 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 a manner as may deceive them, by inducing the purchase of one thing for another.³ Van Brunt, J., said that it is the duty of the court to protect the public from fraud, even at the suit of a plaintiff who has not the exclusive right to the use of words, numerals, or symbols, used by him;⁴ but Hargis, Ch. J., in 1883, dissented from this opinion, saying, more properly, that the protection of the public alone is not sufficient ground for the jurisdiction. "However," he said, "it is an element which enters, and ought to enter, into every case. . . . If the plaintiff cannot show that his rights or interests are injured, or taken from him, he can have no standing in court, for strictly he represents the public no more than any one else."⁵ This is the doctrine that is sanctioned by the current of decisions.

§ 31. The Lord Chancellor, in *Spottiswoode v. Clark*,⁶ in 1846, said: "These cases depend so much upon their own

¹ Boardman v. The Meriden Britannia Co., 35 Conn. 402; R. Cox, 490.

² Blackwell v. Wright, 73 N. C. 310.

³ Matsell v. Flanagan, 2 Abb. Pr. R. (N. S.) 459; R. Cox, 367.

⁴ Kinney v. Basch, 16 Am. L. Reg. (N. S.) 596.

⁵ Avery v. Meikle, § 43, *infra*.

⁶ 10 Jur. 1043; 8 L. T. 230-271; 2 Ph. 154; 1 Coop. 254.

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 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 he 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 Without unnecessarily multiplying examples, the subject may be comprehended in this one saying, — that every man has a right to the reward of his skill, his energy, and his honest enterprise; and when he has appropriated, as his trade-mark, even letters combined with a word before unknown, and has used that word and has published it to the world as his adopted trade-mark, he has acquired rights in it which the courts will protect;² and he may use as his trade-mark any symbol or emblem, however unmeaning in itself; and if such symbol or emblem come 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.³

§ 33. *Colorable Variation.* — It is frequently difficult to determine, as fact, what is infringement. Two marks that are supposed to conflict may resemble each other, and yet differ in striking particulars. This question then arises: Is the difference only colorable? But no general or fixed rule can be laid down as to what may or may not be 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.⁴ To constitute an infringement of a trade-mark, exact similitude is not required, but an infringement is committed when ordinary purchasers, buying with ordinary caution, are likely to be misled;⁵ it being enough to show that the representations bear such a resemblance to the plaintiff's mark as to be calculated to mislead the public generally, who are purchasers of the article bearing it.⁶ That means persons of ordinary intelligence, who adopt ordinary precaution against imposition and fraud,⁷ and use such reason-

¹ Partridge v. Menck, 1 How. App. Cas. 558.

² Burnett v. Phalon, 9 Bos. 193; R. Cox, 356. See the same case in the N. Y. Ct. of App., 3 Keyes, 594; R. Cox, 397.

³ The Leather Cloth Co., *supra*, in the House of Lords, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. (N. S.) 513; 12 L. T. (N. S.) 742; 13 W. R. 873.

⁴ Lord Cranworth, in Leather Cloth case, 11 H. L. C. 533; N. Y. Ct of App., Popham v. Wilcox, 66 N. Y. 69.

⁵ Sup. Ct. of U. S., McLean v. Fleming, 96 U. S. 245.

⁶ Walton v. Crowley, 3 Blatch. 440.

⁷ Blackwell v. Wright, 78 N. C. 310.

able care and observation as the public generally are capable of using and may be expected to exercise.¹ It is sometimes the case that the names of articles are of a character to mislead and deceive, they being *idem sonans* in the usual pronunciation; or the form of the package, general appearance of the wrapper, color of label, wax impressions on the top of the box containing the goods, are well suited to divert the attention of the unsuspecting buyer from any critical examination,² and the courts do not require a critical examination. It was well said by Wood, V. C., in 1854, that in every case the court must ascertain whether the differences are made *bona fide* in order to distinguish the one article from the other, whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are merely colorable, and the resemblances are such as are obviously intended to deceive the purchaser of the one article into the belief of its being the manufacture of another person. Resemblance is a circumstance of primary importance for the court to consider, because if the court finds, as it almost invariably does find in such cases, that there is no reason for the resemblance except for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading.³ Such is the reasoning of all the courts. Probably Vice-Chancellor Shadwell did not go too far, in 1847, when he said that, "If a thing contains twenty-five parts, and but one is taken, an imitation of that one will be sufficient to contribute to a deception, and the law will hold those responsible who have contributed to the fraud."⁴ In this place it is convenient to give examples, the more fully to illustrate the foregoing doctrines. Thus, the name "Wedgwood" was held to have been infringed by "Wedgewood";⁵ "Perry Davis' Pain Killer," by "Perry's Vegetable Pain-Killer,"⁶ and "The Great Home Remedy, Kennedy's Pain-Killer," but with quite different labels;⁷ "Shrimpton &

¹ *Gilman v. Hunnewell*, 122 Mass. 139.

² *McLean v. Fleming*, *supra*.

³ *Taylor v. Taylor*, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271.

⁴ *Guinness v. Ullmer*, 10 L. T. 127.

⁵ *Cox's Man.*, case 96.

⁶ *Davis v. Kendall*, 2 R. I. 566.

⁷ *Davis v. Kennedy*, Codd. Dig. 236.

Hooper," by "Shrimpton Turvey";¹ "Taylor's Persian Thread," by same name except that defendant had inserted "Sam" instead of "J. W." before the name;² "Bell's Life in London," by "The Penny Bell's Life and Sporting News";³ "The London Journal," by "The London Daily Journal";⁴ a cross and letters "C B," by a cross and letters "C S";⁵ an anchor on a metal label (from which plaintiff's wire had acquired the name of "Anchor Brand Wire"), by an anchor and small crown (from which the defendant's wire was called the "Crown and Anchor Wire");⁶ "Govan*" (from which plaintiff's goods had acquired the name of star-iron), by "Coats*";⁷ "Stephens'," by "Steelpen's," for bottles of ink;⁸ "Jülicks," by "Josephs";⁹ "Cocaine," by "Cocoïne";¹⁰ "Schweitzer's Cocoatina," by "Otto Schweitzer, Atkins & Co.'s Cocoatine";¹¹ "The Hero," by "The Heroine";¹² "Charter Oak" and a sprig of oak-leaves, by the name, omitting the oak-leaves;¹³ "Bovilene," by "Bovina";¹⁴ "Tonge's," by "Tung's";¹⁵ "Stark," by "Star";¹⁶ "Hostetter & Smith," by "Holsteter & Smyte";¹⁷ the figure of a milkmaid, by the figure of a milkman;¹⁸ "1847, Rogers & Bros., A. 1," by "C. Rogers Bros., A. 1," and "C. Rogers & Bros., A. 1";¹⁹ "Our Young Folks, an Illustrated Magazine for Boys and Girls," by "Our Young Folks' Illustrated Paper";²⁰ "Wolfe's

¹ *Shrimpton v. Laight*, 18 Beav. 164.

² *Taylor v. Taylor*, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271.

³ *Clement v. Maddick*, 1 Giff. 98; 5 Jur. (N. S.) 592; 33 L. T. 117.

⁴ *Ingram v. Stiff*, 5 Jur. (N. S.) 947; 33 L. T. 105.

⁵ *Cartier v. Carlile*, 3 Beav. 292; 8 Jur. (N. S.) 188.

⁶ *Edelsten v. Edelsten*, 9 Jur. (N. S.) 479; 7 L. T. (N. S.) 768; 11 W. R. 328.

⁷ *Dixon v. Jackson*, 5 Ct. of Sess. Cas., 3d series, 326; 2 Scot. L. R. 188.

⁸ *Stephens v. Peel*, 16 L. T. (N. S.) 145.

⁹ *Farina v. Cathery*, L. J., Notes of Cases, 1867, p. 134.

¹⁰ *Burnett v. Phalon*, 3 Keyes, 594.

¹¹ *Schweitzer v. Atkins*, 37 L. J. Ch. 847; 19 L. T. (N. S.) 6; 16 W. R. 1080.

¹² *Rowley v. Houghton*, 2 Brewst. 803; 7 Phil. 39; R. Cox, 486.

¹³ *Filley v. Fassett*, 44 Mo. 173; R. Cox, 530.

¹⁴ *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555.

¹⁵ *Tonge v. Ward*, 21 L. T. (N. S.) 480.

¹⁶ *Gardner v. Bailey*, Codd. Dig. 131.

¹⁷ *Hostetter v. Vowinkle*, 1 Dill. 329.

¹⁸ *The Anglo-Swiss Condensed Milk Co. case*, Weekly Notes, 1871, p. 163.

¹⁹ *The Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Am. R. 401.

²⁰ *Osgood v. Allen*, 1 Holmes, 185; 6 Am. L. T. 20; 8 Off. Gaz. 124.

Aromatic Schiedam Schnapps," by "Von Wolf's" or "Van Wolf's Aromatic Schiedam Schnapps";¹ "Rising Sun Stove Polish," by "Rising Moon Stove Polish";² "Apollinaris Water," by "London Apollinaris Water" (an artificial compound, containing the same chemical constituents as the natural water, but in a different kind of bottles, and differently labelled);³ "Bethesda Mineral Water," by "Glenn-Bethesda Mineral Water";⁴ "Tamar Indien," by "American Tamar";⁵ "Lacto-Peptide," by "Lacto-Pepsine";⁶ "Hemy's Modern Royal Tutor for the Pianoforte," by "Hemy's New and Revised Edition of Jousse's Royal Standard Pianoforte Tutor" (the defendant having employed Hemy to prepare a new edition of an obsolete work, "Hemy's" being in large and conspicuous letters);⁷ "Mottled German Soap," with a device of a circle containing a moon and thirteen stars, by "S. W. McBride's German Mottled Soap," in combination with a crescent, within which was a single star;⁸ "Robert's Parabola Needles," by "William Clark & Sons' Parabola Needles";⁹ "The American Grocer," by "The Grocer";¹⁰ "National System of Penmanship," by "Independent National System of Penmanship."¹¹ — A case in England, in 1880, has some peculiarities. From one of the essential features of the plaintiffs' trade-mark ticket, their goods had become known as "two-elephant" yarn. The trade-mark was complex, — a golden crown, on each side of which was a golden elephant, with its head turned away from the crown, and suspended from the elephants was a golden banner, which nearly filled the space between the crown and the apex of the triangle (the shape of

¹ *Burke v. Cassin*, 45 Cal. 467; 13 Am. R. 204.

² *Morse v. Worrell*, 9 Am. L. Rev. 368; Codd. Dig. 242.

³ 38 L. T. (N. S.) 242.

⁴ *Dunbar v. Glenn*, 42 Wis. 118; 24 Am. R. 395.

⁵ *Grillon v. Guénin*, Weekly Notes, 1877, p. 14.

⁶ *Carrick v. Morson*, L. J., Notes of Cases, 1877, p. 71; *Chemist and Druggist*, 1877, p. 161.

⁷ *Metzler v. Wood*, 8 Ch. D. 208; 47 L. J. Ch. 625; 38 L. T. (N. S.) 541; 26 W. R. 577.

⁸ *Procter & Gamble v. McBride et al.*, 18 Off. Gaz. 1278; 8 Biss. 398.

⁹ *Roberts v. Sheldon*, 8 Biss. 398.

¹⁰ *Am. Grocer Publishing Co. v. Grocer Publishing Co.*, 25 Hun, 398.

¹¹ *Potter et al. (respondents) v. McPherson et al. (appellants)*, 21 Hun, 159.

the green ticket used). On the defendants' yarn was a rectangular ticket of a red color and a sitting figure with an elephant's head. The ticket complained of was placed on the main wrapper. It was of a similar shape and color to the plaintiffs' two-elephant ticket (that having a shape and a color commonly used in the trade), and it had also two golden elephants and a golden banner upon it. But although it differed in several respects from that of the plaintiffs, it was held to be an infringement.¹ Courts of justice of continental countries of Europe have very frequently had this class of cases to consider. In the following citations, trade-marks have been held to be infringed by attempted evasions, viz.: the fanciful name "JOB," by "Guerre à Job,"² by "J. H. B.," by "JOC,"³ and by "JOP";⁴ "Liqueur du Mont Carmel," by "Carmeline";⁵ "Eau de toilette de Lubin," by "Eau de toilette aux fruits et fleurs Lupin";⁶ "Eau de mélisse des Carmes," by "Eau de mélisse des Carmes Saint-Jacques";⁷ "Chartreuse," by "Chartreuse de Saint-Hugon";⁸ "Figaro," by "Petit Figaro,"⁹ and by "Nouveau Figaro";¹⁰ "C P" followed by the words "à la Sirène," by the words "None genuine except stamped C. P. and labelled à la Sirène," and "E P" substituting "Sarazène" for "Sirène";¹¹ "Byrrh," by "Bhyr,"¹² and "Byrrh Vital au Malvoisie";¹³ "Abricotine," by "Abricotain" (and other circumstances);¹⁴ "Tapioca des familles," by "Tapioca des familles brésiliennes";¹⁵ "Savons des Princes brésiliens" by "Savon aux parfums brésiliens."¹⁶

¹ Orr Ewing & Co. v. Johnston & Co., 13 Ch. D. 463.

² See § 308, *infra*.

³ Bardou v. Berha *et al.*, 18 Annales, 65.

⁴ 22 Annales, 139.

⁵ Faivre v. Boulan *et al.*, 19 Annales, 378.

⁶ F. Prot & Co. v. Cabrideus *et al.*, 20 Annales, 369.

⁷ A. Boyer v. C. Boyer *et al.*, 21 Annales, 25.

⁸ Grézier v. Rivoire, 23 Annales, 191. See also §§ 410, 582, *infra*.

⁹ De Villemessant v. N. Estibal *et al.*, 23 Annales, 269.

¹⁰ Le Figaro v. Le Petit Figaro, 25 Annales, 174. See also § 547 *et seq.*, for other cases of publications.

¹¹ Farcy *et al.* v. Epailly *et al.*, 24 Annales, 123.

¹² Violet Frères v. Thomas, 24 Annales, 125.

¹³ Violet Frères v. Vital, Liautaud, & Co., 27 Annales, 307.

¹⁴ Garnier v. Richard, 25 Annales, 353.

¹⁵ Chapu v. Legrand *et al.*, 27 Annales, 201.

¹⁶ Décressonnière v. Celisse *et al.*, 27 Annales, 349.

§ 34. *Principles on which Infringement is prohibited.* — Lord Langdale, M. R., said, in 1842, that the principle on which both courts of law and equity proceed in granting relief and protection is well understood; viz. that a man is not to sell his own goods under the pretence that they are the goods of another man.¹ He subsequently expressed the same principle in a different form of words.² — In 1846, the court of last resort in New York said substantially, that, while one is at liberty to manufacture and vend the same kind of goods as his rival, he is required to depend for success upon his own character and fame, and is only required not to pirate upon the rights of others.³ In 1848, Walworth, C., said, that the question in such cases is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he puts his trade-mark, nor whether the article made and sold by the defendant under the complainant's trade-mark is an article of the same quality and value, but whether he is entitled to protection against a defendant who attempts to pirate upon the good will of the complainant's friends or customers, or the patrons of his trade and business, by sailing under his flag without his authority or consent.⁴ In 1849, in a leading case, Duer, J., said that an injunction ought to be granted wherever the design of a person who imitates a trade-mark, be his design apparent or proved, is to impose his own goods upon the public as those of the owner of the mark, and the imitation is such that the success of the design is a probable or even possible consequence;⁵ and it is not essential that the article of the defendant be inferior in quality, or that he should fraudulently represent it so as to impose upon the public; but if it be so assimilated to the genuine mark as to be taken in the market for the merchandise of another, the original person is entitled to an

¹ *Perry v. Truefitt*, 6 Beav. 66; 1 L. T. 384.

² *Croft v. Day*, 7 Beav. 84.

³ *Taylor v. Carpenter*, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45.

⁴ *Partridge v. Menck*, 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72.

⁵ *The Amoskeag Manufacturing Co. v. Spear*, 2 Sandf. S. C. 599; R. Cox, 87.

injunction.¹ The Supreme Court of Connecticut, in 1870, said that the ground on which courts of equity afford relief in that class of cases is the injury to the party aggrieved, and the imposition upon the public, by causing them to believe that the goods of one man or firm are the production of another.²

§ 35. *Quality of Goods, and Invention of Article or Mark.* — The question of comparative quality is not necessarily an element, either at law or in equity. Yet it is sometimes well to establish the fact that the infringer has not only usurped trade, but by attaching the mark to inferior goods he has also damaged the reputation of the goods of the owner of the mark. In 1833, in *Blofield v. Payne*, an action on the case, it was held by Lord Denman, C. J., that although no specific damage was proved, and the jury found the defendant's article to be not inferior to the plaintiff's, the plaintiff was still entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendant.³ So it was also held in another action on the case, in 1846, in a United States Circuit Court.⁴ No *law* case is found, where a doctrine to the contrary prevailed. Courts of *equity* have as uniformly so held.⁵ As to original invention, Walworth, C., said, in *Partridge v. Menck*: "The question in such cases 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." Federal courts so rule. Nor is the origin of the mark borne by the merchandise of moment, provided the claimant shows title in himself. The Patent Office so holds. Indeed no authority appears to the contrary.

§ 36. *The Public should be protected.* — It is frequently necessary for courts of justice to consider the ground on

¹ *Coffeen v. Brunton*, 5 McLean, 256; R. Cox, 132.

² *Holmes, Booth, & Haydens v. The Holmes, Booth, & Atwood Manufacturing Co.*, 37 Conn. 278; 9 Am. Rep. 324.

³ 4 B. & Ad. 410; 1 N. & M. 353; 2 L. J. K. B. (n. s.) 68.

⁴ *Taylor v. Carpenter*, 2 Wood. & M. 1; R. Cox, 32; 9 L. T. 514.

⁵ *Taylor v. Carpenter*, 2 Sandf. Ch. 603; 11 Paige, 292; R. Cox, 45; *Partridge v. Menck*, *supra*; *Coffeen v. Brunton*, *supra*; *Edelsten v. Edelsten*, 1 De G., J. & S. 185; 9 Jur. (n. s.) 479; 7 L. T. (n. s.) 768; 11 W. R. 328.

which a party bases his demand for redress. In 1791, Lord Chancellor Thurlow held, that a possible fraud on the public gave no claim for an injunction.¹ This ruling has been followed in numerous instances in England and in this country. It means, doubtless, that something more than a general wrong must be alleged and proved to warrant the stretching forth of the judicial arm. While few courts have gone so far as to discard the fact of injury to the public as an element of damage to the one whose mark of authenticity has been infringed, yet, even as late as 1879, a court, in discussing the principle of protection, has used expressions seemingly as limited as that of Lord Thurlow. Lord Justice James, in *Levy v. Walker*, in the Court of Appeal, said: "The court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything."² Mr. Justice Duer, in 1849, in his very able opinion in the case of the *Amoskeag Manuf. Co. v. Spear*,³ 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 1867, in *Matsell v. Flanagan*,⁴ 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

¹ *Webster v. Webster*, 3 Swanst. 490.

² 10 Ch. D. 436; 48 L. J. Ch. 273; 39 L. T. (N. S.) 656.

³ The *Amoskeag Manufacturing Co. case*, *supra*.

⁴ 2 Abb. Pr. R. (N. S.) 459.

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 1865, in *Swift v. Dey*,¹ — which was a controversy in regard to a trade-mark on match-boxes, — said, substantially, that it is eminently a question of fact, to be submitted to the practical experience of a jury, whether, in a particular case, a resemblance is 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 1854, in *Gillott v. Kettle*,² 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

¹ 4 Robertson, 611; R. Cox, 319.

² 3 Duer, 624; R. Cox, 148.

reputation that he had successfully labored to earn. In such a case, there is a fraud¹ 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* case. Fraud and damage resulting therefrom always entitle the injured party to relief; provided, of course, that he comes 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, to protect the trade-mark, and the interests of the public as well as of the individual purchasers require that it should 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 1845, in *Coats v. Holbrook*,¹ 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 1844, in *Taylor v. Carpenter*,² was no less emphatic; and Sandford, Ch., in 1825, in *Snowden v. Noah*,³ 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.

¹ 2 Sandf. Ch. R. 586; 3 N. Y. Leg. Obs. 404; R. Cox, 20.

² 3 Story, 458; R. Cox, 14.

³ Hopkins Ch. R. 347; R. Cox, 1.

§ 37. In the case of *Dixon Crucible Co. v. Guggenheim*,¹ Paxson, J., in 1870, 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.”

§ 38. In *Comstock v. White*,² in 1860, 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*,³ in 1857, 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.*,⁴ 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 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.

¹ 7 Phila. 408; 2 Brewst. 321; 8 Am. T. 288; R. Cox, 559.

² 18 How. Pr. R. 421; R. Cox, 232.

³ 4 Abb. Pr. R. 156; R. Cox, 194.

⁴ 57 Barb. 526; 4 Am. L. T. R. 168; 45 N. Y. 291; 10 Abb. Pr. R. (N. S.) 348; 6 Am. Rep. 82; R. Cox, 624.

§ 40. An able French writer¹ 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 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,² 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

¹ 4 *Annales*, 19, 20.

² *The Leather Cloth Co. v. The American Leather Cloth Co.*, 11 Jur. (n. s.) 513; 11 H. L. Cas. 528.

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 injustice that is in direct transgression of that command of the Decalogue: "Thou shalt not covet . . . anything that is thy neighbor's." The most detestable kind of fraud underlies the filching of another's good name in connection with trafficking. The injury is not merely to the individuals who are cheated in buying, nor to the owner of the mark, but to commerce in general. Public faith is shaken. The wrong can be checked only by systematic protection. Modern nations have acted wisely in studying the ways of China in this matter. 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. Everything 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 every one recognized its 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. — 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: "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."¹ He might have further said, that the wrong nearly always is a witness against its author.

§ 43. *Unfair Competition in Business.* — In examining cases classified in digests and books of reports as those of trade-marks, the reader is sometimes puzzled. In the absence of the slightest evidence that technical trade-marks have been infringed, courts of equity have granted full and complete redress for an improper use of labels, wrappers, bill-heads, signs, or other things that are essentially *publici juris*. The difficulty is, that wrong names are used. French-speaking nations have a standard name for this kind of wrong. The term used is *concurrency déloyale*. This term may fairly be Anglicized as a dishonest, treacherous, perfidious rivalry in trade. In the German Imperial Court of Colmar, in 1873,² the court said that current jurisprudence understands by *concurrency déloyale* all manœuvres that cause prejudice to the name of a property, to the renown of a merchandise, or in lessening the custom due to rivals in business. The euphemism employed as a head to this section will answer the present purpose. It implies a fraudulent intention, while on the contrary an enjoinable infringement of a technical trade-mark may be the result of accident, or misunderstanding, without actual fraud being an element.³ At law, special damage, unless damage is necessarily presumed, deceit, or fraudulent intent, must be proved in all cases to warrant a recovery. This is not always so in equity;⁴ but it is common both in law and equity where the infringement is perpetrated by other modes and means

¹ Taylor v. Carpenter, 11 Paige, 292; 2 Sandf. Ch. 608.

² Say v. Durringer, 18 Annales, 148.

³ See Chapter XII., for examples.

⁴ Leather Cloth Co. case, referred to in various sections.

than the use of any part of a trade-mark itself;¹ and whether a trade-mark is shown to have been imitated or not, if the goods of one have been intentionally and fraudulently sold as the goods of another, and the latter has sustained damage, or the former threatens to continue acts tending to that end, a court of equity will restrain the further commission of them. This subject belongs properly to the class of good-will cases; but, nevertheless, it is necessarily an ingredient in a great majority of trade-mark cases. As an illustration, take *Croft v. Day*,² in 1843, which is not a technical trade-mark case. In that, Lord Langdale, M. R., granted an injunction to restrain the defendant from using labels or show-cards calculated to mislead the public, saying that the right which any person may have to the protection of the court does not depend upon any exclusive right to a particular name of a man, or to a particular form of words. His right, said he, is to be protected against fraud, and fraud may be practised by means of a name, though the person using it have a perfect right to use that name, provided he do not accompany the use of it with other circumstances to effect fraud. — The Supreme Court of the United States has embodied what is now a well-established doctrine, in the following language:³ “Nor is it necessary, in order to give a right to an injunction, that a specific trade-mark should be infringed; but it is sufficient that the court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist.” — The broad rule was laid down by Lord Langdale, M. R., in *Perry v. Truefitt*, in 1842,⁴ when he said that one cannot be permitted to practise deception in the sale of his goods as those of another, “nor to use the means which contribute to that end.” — The Court of Appeals of Kentucky, in 1883,⁵ in a case that furnished an excellent illustration, main-

¹ *B. F. Avery & Sons v. Thomas Meikle & Co.*, Kent L. Rep. and Journ., April, 1883, 17 Western Jurist, 292, wherein Ch. J. Hargis has ably discussed this point.

² 7 Beav. 84.

³ *McLean v. Fleming*, 96 U. S. 245; 18 Off. Gaz. 913.

⁴ 6 Beav. 66; 1 L. T. 884.

⁵ *Avery case*, *supra*.

tained the doctrine, that all fraudulent misrepresentations, "whether oral, by signs, symbols, trade-marks, labels, words, or figures," should be prevented by a court of equity. Chief Justice Hargis, in delivering the opinion of the court, spoke as follows: "The fraud is most frequently accomplished by the illegal use of names, forms, words, and numerals, which ordinarily belong to the common stock, and are not the subject of exclusive appropriation. Instead of employing them in their proper sphere to designate number, size, elements, quality, description, or give direction or caution, they are selected because of the known innocent purposes they generally serve, and combined so as not to represent quality, or other particles within the scope of their lawfully prescribed functions, but to cause the goods or articles to which they are attached to be purchased by the public as the make or manufacture of another, thus violating that great generic rule which lies at the foundation of all law, that a man must so use his own property as not to injure the property of another. . . . The law says you may use anything which is the common property of all, or that cannot be exclusively appropriated, but you must use it to convey the ideas which it commonly expresses, and of which it is the accepted sign. You must use it to tell the truth, the whole truth, and nothing but the truth. You cannot, under pretence of exercising a common right of use, . . . by the seeming fairness which follows the selection of a legal or innocent instrument or means, escape the consequences of an illegal use thereof. This would be stealing the livery of heaven to serve the devil in. This would be perverting the privileges and uses of our language, under the pretence of describing one's own, to take another's from him. . . . The appellees selected the same letters, the same words, the same numerals, and put them in the same colors, and upon the same places on their ploughs, as was used by appellants on their ploughs. For what? To represent size and quality alone? Who could believe it? Why not take type from a different font? Why not take other numerals that would serve the same purpose better? Why adopt as a number '½,' '1,' '2,' '3,' '8'? Why 'AO,' 'BO,' 'CO,'

‘PO’? No answer can be given, except that a man intends the natural consequences of his own act, and the consequences of this act are to take appellants’ trade, built up on their reputation, and transfer it to appellees, by using that reputation to sell appellees’ ploughs. The appellees have not used a single letter, figure, or word that belongs to appellants’ trade-mark proper, yet by the exact simulation of the plough in every perceivable point exposed to an ordinary observer and purchaser, and the use of the same coloring and staining, the same relative position of the letters and figures as employed and used by the appellants, avoiding the literal appropriation of any part of their trade-mark, the appellees have obscured their own and appellants’ trade-mark, but at the same time sought to avoid detection and responsibility in doing so. . . . Thus by skilful combination of legal particles, taken one at a time and in the aggregate, leaving the mere trade-mark untouched, they have so confused its force and effect as to destroy its office and real efficiency to distinguish the appellants’ ploughs from others.”— In *Sawyer v. Horn*, in 1880,¹ the court said: “What we decide is, that whether the complainant has a trade-mark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labelled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color, and label, no person has the right to use the complainant’s form of package, color, or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant.”— The foregoing cases illustrate the principle on which courts of equity generally act.

§ 44. A *seemingly* exceptional case is found in a decision of the New York Court of Appeals, in 1882; but a careful examination shows that it is not so.² That decision was one of *fact*, and not of *law*. It is true that the learned judge who delivered the opinion of the court used this extraordinary language: “Where there is a simulation of a trade-mark, and the intent

¹ 4 Hughes, 439 (U. S. Circuit Court, Dist. of Maryland).

² *Enoch Morgan’s Sons v. Troxell et al.*, 89 N. Y. 292 (reversing 23 Hun, 632).

becomes a subject of inquiry, the form, color, and general appearance of the packages may be material; but to sustain an action¹ there must be an imitation of something that can legally be appropriated as a trade-mark." On looking into the record, it clearly appears that the matter was properly one of "unfair competition in business," and not a trade-mark case. In the court of last resort, the judges, as well as the counsel on each side, treated it as a trade-mark case. So does the syllabus. If it had really been such, then the language above quoted might demand criticism. But the opinion starts out with the postulate that there was no imitation of any trade-mark. It says that there was no fraudulent representation, and no device to palm off goods as those of appellees; and that there was too great a dissimilarity between the labels, etc. of the parties to sustain the judgment below. The decision properly ends there. The sentence that intimates that no action can be sustained unless a technical trade-mark shall have been infringed, has no force, and may be regarded as surplusage. In all probability, the judge could not have meant it to apply to any other than an alleged infringement of an arbitrary symbol. If possibly he were thinking of *unfair competition*, it does not apply thereto; for it had already been declared that no element of unfairness appeared.

§ 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 both. The subject matter is not the symbol, but the exclusive privilege of continually using the same to impress or other-

¹ It must be remembered that, under the New York Code, the term "action" is as applicable to a suit in equity, as this case was, as to a common-law action on the case.

wise 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 mark one's name on a piece of personal property is a natural right; so, therefore, must be the right to use, as its substitute, any other emblem. This right is founded upon possession: and 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 controlled 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, i. e. his 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 in any other kind of personal property, may be admitted; but possibly foreign courts are shut to him as an alien, non-domiciliated. In this illiberal spirit, some

¹ 29 Cal. 292; R. Cox, 324.

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 benefits of the actions which it organizes. The same court, the next year, recognized the same doctrine, in *Stubs v. Astier et al.*; 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 only.²

§ 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 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.⁴ 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*,⁵ 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.*⁶), 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 pro-

¹ 11 Annales, 344.

² 10 Annales, 212.

³ 10 Annales, 193.

⁴ By the term "deposit," used in the French cases, is meant a filing for registration. A right may exist to a trade-mark, but in nearly all European countries this right cannot be enforced without previous registration; and a right to registration depends on treaties of reciprocity.

⁵ 13 Annales, 21.

⁶ 14 Annales, 167.

ducts became known under the name *aciens 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 three hundred 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 permitted to conflict with one that had 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 proved 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. 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, he argued, Lendenberg & Co. had a right to invoke the protection of the French laws, the same as if they were French themselves; and that, by the law of 1857, 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*

¹ 6 Annales, 29.

² 1 Annales, 45.

v. *Bassett*,¹ the right of the plaintiff was disputed because of his recent appropriation of the symbol to stamp his licorice, 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 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 facts of such user, notoriety, and public reputation have been proved. 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

¹ 4 De G., J. & S. 380; 33 L. J. Ch. 566; 10 Jur. (n. s.) 550; 10 L. T. (n. s.) 442; 12 W. R. 777; 4 N. R. 123.

trade-mark, for the law inhibits him from engaging in secular pursuits of a mercantile nature. A corporation is an artificial person, and under the former 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.¹ 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. — This matter has recently been discussed in several European judicial tribunals, especially in suits brought by the Carthusians² for the protection of trade-mark rights. In the Tribunal Correctionnel of the Seine, in 1879,³ the defendant raised the point that the prosecutor, being a religious corporation, could not own a trade-mark. *Held*, that the members of a religious community (although the same is not recognized by law, nor authorized) enjoy individually civil rights in France, and may maintain personal actions to repress trespassing on their rights. — In the Court of Brussels, in 1883,⁴ it was held, that, in Belgium, religious corporations or orders are regarded as mere aggregations of individuals enjoying *ut singuli* all civil rights. Monastic vows are no bar to personally acquiring and possessing in their own proper names titles to trade-marks. They are presumed to act in their individual capacity. The Court of Appeal of Brussels affirmed the decision. It was there objected that Grézier

¹ The registration act now in operation — that of March 3, 1881 — recognizes the right of a corporation, the same as of any other *owner*.

² “A religious order instituted by St. Bruno in 1086, and named from La Chartreuse, near Grenoble, Vienne, whither the saint retired with six companions to spend a life of pious solitude and austere severity. . . . The C. have still two of the finest convents in the world, viz. *La Grande Chartreuse*, on the site of their original home in the desolate valley near Grenoble, and *Certosa*, near Pavia.” — The Globe Encyclopædia.

³ Grézier *v.* Detang *et al.*, 24 *Annales*, 313.

⁴ Grézier *v.* Caumontal, 29 *Annales*, 183.

sued as agent of the convent of the *Grande Chartreuse*, but the court said that that title belonged to him hierarchically in the convent life, and that France and Belgium had placed all religious bodies under the protection of the common law.

§ 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. *Title to a Trade-Mark by Assignment.* — The right to the exclusive use of a symbol as a trade-mark being property, as property, it is susceptible of being assigned, with certain exceptions which hereinafter appear ; and an assignee has the good-will of the trade, and stands in the same relation to a defendant as would the original appropriator of the symbol.¹ If the assignor imposes no limitation of place or time, the right to use is deemed co-extensive with the whole country.² As the Supreme Court of Pennsylvania said, in 1867, assignees are entitled to relief, even though in the use of a trade-mark they have not designated themselves as assignees, or that they were not the original owners of it. A trade-mark, like the good-will of a shop or manufacturing establishment, is a subject of commerce, and it has many times been held to be entitled to protection at a suit of the vendees ;³ and the title to it may pass under a creditors' deed to trustees for the creditors of the firm owning it.⁴ The sale of a business is a sale of the good-will ; but it is not necessary that the term "good-will" be specifically mentioned. In such sale, the title to trade-marks passes, whether they be specifically mentioned or not.⁵ The Supreme Court of the United States said that, when the trade-mark is affixed to articles manufactured at a particular establishment, and acquires a specific reputation in

¹ *Walton v. Crowley*, 3 Blatch. 440 ; *R. Cox*, 166.

² *Kidd v. Johnson*, 100 U. S. 617.

³ *Fulton v. Sellers*, 4 Brewst. 42.

⁴ *Bury v. Bedford*, 4 De G., J. & S. 352 ; 33 L. J. Ch. 465 ; 10 Jur. (n. s.) 503 ; 10 L. T. (n. s.) 470 ; 12 W. R. 726 ; 4 N. R. 180 ; *Hudson v. Osborne*, 39 L. J. Ch. 79 ; 21 L. T. (n. s.) 386 ; *Helmbold v. The Henry T. Helmbold Manufacturing Co.*, 53 How. Pr. 453 ; *Ex parte Young*, and *Re Lemon Hart & Son*, *Cox's Manual*, case 537.

⁵ *Shipwright v. Clements*, 19 W. R. 599.

connection with the place of manufacture, and that establishment is transferred to others, either by contract or operation of law, the right to the use of the trade-mark may be lawfully transferred with it.¹ The title may pass by an assignment in bankruptcy,² or to the assignee in insolvency of the owner.³ It has been held to be settled law, that the right of user in a trade-mark is not a mere personal privilege, but within certain limits may be transferred as other property. But there are exceptions to the susceptibility of emblems used as trade-marks being transferred to others as such. The court said, as to a trade-mark consisting of a man's name, that it is a difficult question to decide how far it is capable of assignment. "We think the answer to this question depends upon the effect which the use of the name, in each particular instance, is shown to have upon the minds of the public. If it leads the public to believe the particular goods are in fact made by the person whose name is thus stamped upon them, whereas they are in fact made by another person, then such a use of the name will not be protected by the courts, for to do so would be to protect the perpetration of a fraud upon the people."⁴ By reference to another case,⁵ it is seen that the court said: "By the dissolution of the firm, and Oakes's sale to Probasco, the latter acquired the rights of the firm to the name. Oakes could so sell his name as to deprive himself of the right to use it for his own manufacture, and give the right to another." The matter was again judicially considered in a United States Circuit Court,⁶ in which it was said by Bruce, J.: "If there was anything in the nature of the business of candy-making, any art or incommunicable secret known only to the man Oakes, it might be said that he [the assignee] did not carry on the same business, and manufacture the same goods, as did the firm of Probasco & Oakes." — In such supposed case, there could not have been a valid assignment. The right to manufacture or sell the

¹ *Kidd v. Johnson, supra.*

² *Ex parte Young, supra.*

³ *Warren v. Warren Thread Co., 134 Mass. 247.*

⁴ *Skinner & Co. v. Oakes et al., 10 Mo. App. 45.*

⁵ *Probasco v. Bouyon et al., 1 Mo. App. 241.*

⁶ *Oakes v. Tonsmierre, 4 Woods, 555 (June term, 1883).*

merchandise to which the trade-mark is attached is essential to property therein; ¹ for the right cannot be so enjoyed by an assignee that he shall have the right to affix the mark to the goods different in character or species from the article to which it was originally attached.² In some of the cases, said the Supreme Court of Rhode Island, in 1876, the question has been between partners, or there has been a sale of a business, to be continued by a vendee, and more or less connected with a place and the good-will of the business, in many of which cases the sale of a trade-mark would be upheld. But where the reputation of the goods and of the name has grown out of excellence of manufacture depending on the honesty and skill of the maker, it is more difficult to hold that it can be sold to a stranger, or that it is generally assignable.³ As to partners it has been held that the title to a trade-mark does not pass to any member of the firm by mere implication, but each member may use it in a manner not to deceive the public.⁴

§ 58. *Who is an Infringer?* — He who uses on merchandise the peculiar mark to which another has the right of exclusive use for substantially the same class of goods; or, under some circumstances, he who has falsely fabricated such mark, although he has not actually affixed it to goods. A false fabrication of the symbol, as an instrument of fraud, is constructively an infringement.⁵ One may be an infringer, although he took no part in imitating or affixing the simulated mark. The

¹ The Congress and Empire Spring Co. case, 45 N. Y. 291; 10 Abb. Pr. (n. s.) 348; 6 Am. R. 82; 4 Am. L. T. 168; R. Cox, 624.

² *Filkins v. Blackman*, 13 Blatchf. 440.

³ *Carmichel v. Latimer*, 11 R. I. 395; 23 Am. Rep. 481; 16 Alb. L. J. 73.

⁴ *Young v. Jones Bros. & Co.*, 3 Hughes, 274. (See §§ 522 *et seq.*, on Good-Will.)

⁵ The act of Congress of August 14, 1876, punishes with fine and imprisonment any person or persons who shall, with intent to defraud, "knowingly and wilfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, or offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mould, of any private label, brand, stamp, wrapper, engraving on paper, or other substance, or trade-mark," etc. See Appendix.

fact of selling, or offering for sale, goods falsely marked, is sufficient to charge him, and any semblance is deemed an infringement if calculated to mislead ignorant or careless purchasers. The infringer may be either the pirate himself, or an innocent vendor of the falsely marked goods. It matters not how many hands they may have passed through. Courts will arrest the wrong at any stage of its journey. A counterfeit is not valid even in the possession of one quite ignorant of its vicious character, although he may plead his good faith. The New York Court of Appeals said,¹ where the defendant, who was a label-printer, sold labels bearing an imitation, that it was not necessary to establish a guilty knowledge or fraudulent intent on the part of the wrong-doer. It is sufficient that the proprietary right of the party and its actual infringement are shown. In England, in 1847, *Shadwell, V. C.*, enjoined certain engravers from making or disposing of labels or plates in imitation of those from which the plaintiff's labels were printed;² and, in 1852, *Parker, V. C.*, enjoined a printer, under similar circumstances, he giving up all the false labels and paying £50 costs.³ *Wood, V. C.*, held that the plaintiff was entitled to an injunction to restrain the defendant, a printer, from "scattering over the world the means of enabling parties to commit frauds upon the plaintiff."⁴ — The courts of France have frequently had occasion to consider this point. The Court of Bordeaux, in 1871,⁵ held a lithographer liable for imitating labels, as well as the owners' rival, who had given the order to do the work. The Tribunal Correctionnel of the Seine, in 1875,⁶ held a printer to be guilty, who executed imitations at the command of a third person, when he might have ascertained who was the true

¹ *Colman v. Crump*, 70 N. Y. (25 Sickels) 573; 16 Alb. L. J. 352; Cox's Manual, case 570.

² *Guinness v. Ullmer*, 10 L. T. 127; Cox's Manual, case 89.

³ *Farina v. Shaw*, cited 3 Eq. R. 886, 887; 1 K. & J. 514; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532.

⁴ *Farina v. Silverlock*, 1 K. & J. 509; 3 Eq. R. 883; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532.

⁵ *Martell & Co. v. Martell et al.*, 18 Annales, 263.

⁶ *Blancard v. Gutton et al.*, 20 Annales, 86.

owner. The same court, in the same year,¹ convicted a lithographer under the following circumstances. At the order of others he had made two thousand labels bearing the words "Liqueur Grande Chartreuse," a well-known trade-mark. It was held that he could not plead ignorance of the fact that he was dealing with counterfeiters; and that he was guilty, although he had not delivered the false labels, for the non-delivery was owing to a circumstance foreign to himself.²—The Court of Paris, in 1878,³ held that engravers or founders who execute, on order, moulds or matrices intended to reproduce the essential and characteristic parts of a trade-mark, cannot be permitted to plead good faith. In the Court of Lyons, in 1879,⁴ a lithographer, having counterfeited on stones the plaintiff's trade-mark, the *plaintiff*, through an intermediary, ordered a number of the false labels printed therefrom. The Tribunal Civil of Lyons had dismissed the plaintiff's case on that ground. *Held*, on appeal, that no law or principle of law prohibits an owner from obtaining, by such means, proof of wrong-doing. The Court of Paris, in 1883,⁵ held that such an imitator will in vain pretend that he does not deceive purchasers when he vends *not to the public directly*, but to merchants or agents, who buy at their own risk and peril. It suffices that he knows that the products that bear the false marks are destined for the public at large. In his mind, as in contemplation of law, they are the true recipients of the falsified marks. Nor can one shield himself from even a criminal prosecution by the plea that he is a mere agent or consignee. So the highest judicial tribunal in France—the Court of Cassation—held, in 1882.⁶ The defendant was, at Paris, the sole agent of his princi-

¹ Grézier *v.* Jouhate, 20 *Annales*, 92.

² In this case, M. Pataille, for the prosecution, cited two cases in the Court of Paris, in 1866 and 1868, where it had been adjudged that the sole fact of fabrication, even in the absence of delivery, is sufficient evidence against a lithographer to warrant condemnation of spurious labels.

³ Michaud *et al. v.* Lemenu *et al.*, 23 *Annales*, 59.

⁴ Portallier *v.* Balay, 25 *Annales*, 384.

⁵ Blancard & Co. *v.* Faucher, 38 *Annales*, 288.

⁶ Hayem *v.* Brisac, 27 *Annales*, 114.

pals in Berlin. He solicited orders in Paris, and his principals sent to him goods with the simulated marks of the plaintiff upon them. It appeared in evidence that the plaintiff had a prosperous trade with foreign countries, especially Brazil. The attempt was to divert that trade by sending abroad falsely marked goods. He was therefore held to have been properly convicted.

§ 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 modern genius. 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 exclusively to 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, paints, 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 will 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 steal the fruits of intellectual skill. *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 those of 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 Comyns'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." Comyns does not say *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 be 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." 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 Companies,³ — "Vigilantibus, non dormientibus leges subveniunt," — is not

¹ Cited by Upton, p. 10.

² Popham, 144; *Cro. Jac.* 471; 2 Rolle, 28; R. Cox, 633.

³ 11 Jur. (N. S.) p. 513; 11 H. L. C. 523; 35 L. J. Ch. 53; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209.

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 ; and 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 desert? In trade-mark 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

¹ See opinion of Kindersley, V. C., in *Glenny v. Smith*, 11 Jur. (n. s.) 964 ; 13 L. T. (n. s.) 11 ; 13 W. R. 1032 ; 6 N. R. 363.

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 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

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

² 7 Bos. 222.

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

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.¹

§ 66. *Class of Goods.* — Protection will not be given unless in connection with the class of goods to which the mark has been appropriated. It is sometimes difficult to define the term *class*, as the mark may have been affixed to but a small portion of a class, in which case, as a general rule, only that small portion can be protected. But there are instances where courts stretch the rule to cover obvious infringements, and expand a species into a genus. Lord Chancellor Westbury said, in 1863:² "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract; thus, an iron-founder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed in cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity, and such exclusive right is property." Vice-Chancellor Wood, in 1866,³ used the same ideas, saying that one has no property in the mark *per se*, any more than in any other fanciful denomination assumed for his private use, otherwise than with 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 caused his goods to circulate with this mark upon them, no one is at liberty to defraud that man by using that mark. — Lord Chancellor Westbury held that property in a word (*Anatolia*) cannot exist;⁴ but when applied by way of stamp upon a

¹ *Christy v. Murphy*, 12 How. Pr. R. 77.

² *Hall v. Barrows*, 4 De G., J. & S. 150; 33 L. J. Ch. 204; 10 Jur. (n. s.) 55; 9 L. T. (n. s.) 561; 12 W. R. 822; 3 N. R. 259.

³ *Ainsworth v. Walmesley*, L. R. 1 Eq. 518; 85 L. J. Ch. 352; 12 Jur. (n. s.) 205; 14 L. T. (n. s.) 220; 14 W. R. 363.

⁴ *McAndrew v. Bassett*, 4 De G., J. & S. 380; 33 L. J. Ch. 566; 10 Jur. (n. s.) 550; 10 L. T. (n. s.) 442; 12 W. R. 777; 4 N. R. 123.

particular vendible article, as a stick of licorice, it does exist the moment the article goes into the market so stamped, and there obtains acceptance and reputation, whereby the stamps get currency from superior quality of goods or other circumstance. — Where registration is relied on to establish ownership of a trade-mark, care must be taken that the description of class be not too broad. It has been twice held that, while a registration for the class of *paints* might be sufficiently specific without further description of the particular goods, a prior use by the defendant of the device on *white-lead* defeated the registration, which, being bad in respect to part of the class that it purported to cover, was bad altogether.¹ — The Patent Office has permitted the term “alcoholic spirits” to include bourbon, wheat, and rye whiskeys, wines, brandies, and gins, but excluded the term “bitters,” as not being properly included within the class.² — Federal Courts have made very nice distinctions in regard to the matter of class of goods. Thus, where the complainants, holding American patents of a class of prints known as “heliotypes,” had registered the word “Heliotype,” as a trade-mark affixed to them, and the defendant used the same word, or “Heilotype,” on prints not produced by the patented process, it was held that the goods of the parties were not substantially the same.³ So, where, the complainant being manufacturer of the dry white oxide of zinc, the defendant sold white oxide of zinc ground in oil, under the same symbol used as a trade-mark, it was held that the articles were different.⁴ But a defendant vainly sought to make a distinction in his favor in the case of the arbitrary symbol “Lone Jack,” under which a certain smoking-tobacco long since obtained a high reputation. That tobacco had been put up in bales of a pound each, or halves or quarters. The defendant had adopted a label for cigarettes, which label was entirely unlike that of the complainant, with the exception

¹ *Smith v. Reynolds*, 10 Blatch. 100; 3 Off. Gaz. 214; 13 Blatch. 458.

² *Re Boehm & Co.*, 8 Off. Gaz. 319.

³ *Osgood v. Rockwood*, 11 Blatch. 310.

⁴ *Société Anonyme des Mines et Fonderies de Zinc de la Vieille Montagne v. Baxter*, 14 Off. Gaz. 679.

of that word-symbol, and he had registered in the Patent Office his *Lone Jack cigarette-label*. The examiner had assented to the proposition that smoking-tobacco, and cigarettes made of long-cut tobacco, were articles of different classes. That was the defence, on application for an injunction, supported by over fifty witnesses in the tobacco trade. The internal revenue classification was also invoked, to the same end. The case was elaborately and ingeniously argued by counsel for the defendant. The writer and other counsel for the complainant argued substantially thus. The complainant manufactures and sells "Lone Jack" smoking-tobacco. The bags containing the granulated article may be ripped, and some of the article poured out. It may be put into a meerschaum pipe, a common clay pipe, or a corn-cob pipe; or, for lack of any pipe, it may be poured into little pieces of thin paper, and rolled up, in the form known as cigarettes. The tobacco may have been granulated, or, as in the case of the defendant's goods, it may have been cut into long fibres. That does not affect the essential quality of the tobacco. What should a consumer of the complainant's article, in either shape, answer to the question, What are you smoking? He must truthfully say, "Lone Jack," meaning this particular kind of carefully selected and peculiarly cured tobacco that had acquired a world-wide reputation. Why had the defendant adopted that peculiar word-symbol? Was it not that he might thereby usurp the complainant's trade? Butler, J. (after consulting with his associate, McKennon, J.) dissolved the defence in smoke, thus: "While the revenue laws, for purposes of taxation, distinguish between smoking-tobacco and cigarettes, there is, we believe, no substantial difference. Cigarettes consist of smoking-tobacco similar in all material respects to that used in pipes. The circumstance that a longer 'cut' than that commonly used in pipes is most convenient for cigarettes is not important; nor that the tobacco is smoked in paper instead of pipes. It may all be used for either purpose, and is all embraced in the term smoking-tobacco."¹ But where the fancy term "Iron-clad" is affixed as a trade-mark to *India-rubber*

¹ *Carroll v. Ertheiler*, 1 Fed. R. 688.

boots, it is no infringement for another to use the same term as a trade-mark for *leather* boots, for the reason that they belong to distinct classes.¹

§ 67. *The term "Class" will not be so strictly limited as to defeat substantial justice. While it is true that the first adopter of a trade-mark acquires an exclusive right only in a specific class, protection may possibly be granted, although in fact his mark may not have been affixed to every article in that class. Boni judicis est ampliare jurisdictionem, is a maxim that is well illustrated by a case in 1882.*² The facts are as follows, from the opinion. The complainant, a corporation, had the right to make all articles of metal. It was the successor of "Collins & Co.," and always stamped that name upon its productions as a trade-mark. In 1856, the firm of Oliver Ames & Sons began to put the stamp and label "Collins & Co." on shovels made by it and sent to Australia. The complainant had not up to that time made shovels, but it had a market in Australia for the articles it made, and stamped "Collins & Co." The object of Oliver Ames & Sons in putting that stamp on the shovels was to avail themselves of the credit and reputation and market which the complainant had established for itself for articles thus stamped. The complainant, at the time of bringing this suit, had not sent nor sold any shovels to Australia. The defendant, successor to Oliver Ames and Sons, continued to do what the latter so began in 1856. *Held*, by Blatchford, J., that the acts of Oliver Ames & Sons and of the defendant were always unlawful. The complainant having, from 1843, the right to make any article of iron, steel, or other metal, and having gone on from that time, both before and after 1856, extending its manufacture beyond edge-tools into digging-tools, such as picks and hoes, and having put the mark "Collins & Co." on its best quality of articles, the fact that it did not before 1856 make a digging-tool, such as the shovels on which Ames & Sons put the mark "Collins & Co.," does not warrant the conclusion that that mark was not in 1856 the mark of the complainant's

¹ Hecht v. Porter, 9 Pacific Coast L. J. 589.

² The Collins Company v. Oliver Ames & Sons' Corporation, 20 Blatch. 542.

trade in respect to such shovels. This decision of the learned judge must commend itself as an act of equitable justice. The only question to be raised is this: Is it, strictly speaking, a trade-mark case? Tested by the severe technical rules that a symbol cannot be a trade-mark unless actually affixed to a vendible article, it may be thought not. But whether so or not, it needs no defence. If not strictly a case of trade-mark infringement, the facts furnish all the essential ingredients of a case of unfair competition in business. — On the same point may be cited a case in a State court, in 1869.¹ The complainants, being *manufacturers* but not *printers* of cotton cloths, had placed the name “Amoskeag” on their cloths; and the defendants, who were printers but not manufacturers of cotton cloths, had placed the same name on their printed cloths. An injunction had been granted; but it was dissolved, on the ground that the trades of the parties were different, and therefore the goods not of the same class. In 1876, this decision was reversed,² the reasoning of Barrett, J., in delivering the opinion of the court, being the same in principle as that of the later case above cited. His hypothesis was this. Suppose that the complainant had received from the legislature the name of “The Amoskeag Baking Company,” and had manufactured almost every variety of bread, roll, muffin, cracker, biscuit, cake, and pie, on which articles of food it had invariably stamped its corporate name, or some abbreviation thereof, but had omitted, or had not yet decided, to make and vend the single variety known as the “crumpet”; and thereupon a rival baker attempts to sell his crumpets as “Amoskeag crumpets,” would not any customer, upon seeing the name thus applied, naturally say that the Amoskeag Baking Company had added crumpets to its other varieties of bread? And would not the rival bakery be restrained upon the plain principle of an unauthorized use of the company’s name? The parallel is not precise, as the printing of calicoes may require some additional machinery. “But the difference,”

¹ *The Amoskeag Co. v. Garner*, 55 Barb. 151; 6 Abb. Pr. (N. S.) 265; R. Cox, 541.

² 4 Am. L. T. (N. S.) 176.

said he, "is only in degree." The remarks made in regard to the preceding case are quite applicable to this. Both are cases of unfair competition in business, and not strictly those of trade-marks.

§ 68. As the first adopter of a mark does not acquire an 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 emblem, or fancy name, to be placed on articles of different classes by different owners. Thus, the fanciful appellation "BISMARCK" may, in compliment to the statesman, be used for cement,¹ notwithstanding the fact that another had previously appropriated it for paper collars.² "STAR" may be used for iron,³ shirts,⁴ lead pencils,⁵ oil,⁶ or soap⁷; "EUREKA," for a fertilizer,⁸ or shirts⁹; "CENTENNIAL," for clothing,¹⁰ or alcoholic spirits¹¹; "ST. JAMES," for a newspaper,¹² or cigarettes.¹³ As has been shown, general classes may be divided; and the name "IRON-CLAD," used on India-rubber boots, is held not to preclude its use on leather boots;¹⁴ and "MAGNOLIA" may properly serve to indicate a certain manufacture of gin for one proprietor,¹⁵ and a certain brand of whiskey for another.¹⁶

§ 69. The importance of a specific mention of the class of merchandise to which a certain emblem is to be attached as

¹ Re Wendt & Rammelsberg, U. S. Registration, No. 585.

² Messerole v. Tynberg, 4 Abb. Pr. (n. s.) 410; 36 How. Pr. 14; R. Cox, 479.

³ Dixon v. Jackson, 2 Scot. L. Rep. 188.

⁴ Morrison v. Case, 9 Blatch. 548; 2 Off. Gaz. 544.

⁵ Faber v. Hovey, Codd. Dig. 79, 249.

⁶ Re The American Lubricating Oil Co., 9 Off. Gaz. 687.

⁷ Re Cornwall, 12 Off. Gaz. 138.

⁸ The Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115.

⁹ Ford v. Foster, L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (n. s.) 219; 20 W. R. 818.

¹⁰ Sternberger v. Thalheimer, 3 Off. Gaz. 120.

¹¹ Re Bush & Co., 10 Off. Gaz. 164.

¹² Gibblett v. Read, 9 Mod. 459; Ex parte Foss, and Re Baldwin, 2 De G. & J. 230; 27 L. J. Bankruptcy, 17; 4 Jur. (n. s.) 522; 81 L. T. 80.

¹³ Kinney v. Basch, 16 Am. L. Reg. (n. s.) 596.

¹⁴ Ante, § 66.

¹⁵ Re C. & W. A. Waters, U. S. Registration, No. 544.

¹⁶ Re Mills, Johnson, & Co., U. S. Registration, No. 241; Kidd & Co. v. Mills, Johnson, & Co., 5 Off. Gaz. 387; Kidd v. Johnson, 100 U. S. 317.

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 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.

§ 70. An American firm, doing business at Evansville, Indiana, 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 world-wide reputation through the English firm of Wostenholm. *Held*, that chopping-axes are not included in the particular class of goods in which the Wostenholms used the mark. Registration allowed.² 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.³ In March, 1872, a manufacturing company in Hartford, Connecticut, filed an application for a mark, newly

¹ First section of registration act of 1881.

² *Re Boetticher, Kellogg, & Co.*, U. S. Registration, No. 83.

³ *Re Wostenholm & Son*, U. S. Registration, No. 666.

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 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.² But these general propositions must be carefully considered in the light of judicial reasoning, lest by misunderstanding we commit a wrong, in hastily concluding a trade-mark to be devoid of truth, and an instrument of fraud, when the reverse is the case. We will first examine cases that illustrate the affirmative of the propositions. Melish, L. J., in *Ford v. Foster*,³ said: "According to the rule, *Ex turpi causa non oritur actio*, if a trade-mark contain a false representation, a representation calculated to mislead the public, a man cannot, by using that which is itself a fraud, obtain an exclusive right, or indeed any right at all." Of the correctness of this doctrine there can be no doubt, involving as it does the matter of misleading by fraud on others. Purchasers have a right to the very thing paid for, no matter what may be its comparative value. Therefore, where a perfume is wrongfully named "Night-Blooming Cereus,"⁴ the name is a misrepresentation that debars the claimant of a right to any protection; so, when one sells an unpatented article as "patent pins,"⁵ or sells oysters under the title of "Anglo-Portugo,"⁶ when they did not come from Portugal, although none the less good for that reason; and even where a complainant had, in his advertisements, made a

¹ Re Greenwoods Scythe Co., U. S. Registration, No. 788.

² See §§ 430-439, as to the fraudulent use of one's own name.

³ L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

⁴ *Phalon v. Wright*, 5 Phila. 464; R. Cox, 307.

⁵ *Morgan v. McAdam*, 85 L. J. Ch. 228; 15 L. T. (N. S.) 348.

⁶ Re Saunion & Co., Cox's Manual, case 625.

number of false representations to the public with respect to the origin, composition, and value of the tea bearing his trade-mark, an injunction was refused until he had established his right at law; Vice-Chancellor Shadwell saying, "It is a clear rule, laid down by courts of equity, not to extend their protection to persons whose case is not founded in truth."¹ The rule applies when one has made misrepresentations in show-cards;² or made false statements as to the qualities and properties of his merchandise, as in selling a medicine misnamed "Balsam of Wild Cherry,"³ or a toilet compound, the labels of which contained untrue statements and exaggerations,⁴ or a cosmetic called "The Balm of Thousand Flowers," though the compound was not derived from flowers,⁵ or "Laird's Bloom of Youth or Liquid Pearl," when the so-called article contained carbonate of lead or other noxious ingredients, although the manufacturers described it as being free from all mineral and poisonous substances;⁶ or improperly represented their "Schnapps" as not merely a spirit, but also a medicinal preparation;⁷ or sold a so-called "Hop Essence" for the purpose of enabling brewers to supply to the public a liquid which they might represent as being made with pure hops, which was not the truth;⁸ or made false representations of the origin and value of the plasters, the word "Capcine" being shown to be quite unknown, and not to imply any such qualities as were described by the plaintiffs;⁹ or falsely represented the place of manufacture, as where the manufacturer of a skin-powder which he called "Meen Fun" falsely represented his American compound to have been made in England, and patronized by the Queen;¹⁰ or

¹ *Pidding v. How*, 8 Sim. 477; 6 L. J. Ch. (n. s.) 345.

² *Perry v. Truefitt*, 6 Beav. 66; 1 L. T. 384.

³ *Fowle v. Spear*, 7 Penn. L. J. 176; R. Cox, 67.

⁴ *Heath v. Wright*, 8 Wall. Jr.; R. Cox, 154.

⁵ *Pettridge v. Wells*, 4 Abb. Pr. 144; 13 How. Pr. 385; R. Cox, 188.

⁶ *Laird v. Wilder*, 2 Bush (Ken.) 181; 15 Am. R. 707.

⁷ *Wolfe v. Burke*, 7 N. Y. Sup. Ct. 151; 56 N. Y. 115; 2 Off. Gaz. 441.

⁸ *Estcourt v. The Estcourt Hop Essence Co.*, 31 L. T. (n. s.) 567; L. R. 10 Ch. 276; 44 L. J. Ch. 223; 32 L. T. (n. s.) 80; 23 W. R. 313.

⁹ *Seabury v. Grosvenor*, 53 How. Pr. 192; 14 Off. Gaz. 679.

¹⁰ *Hobbs v. Français*, 19 How. Pr. 567; R. Cox, 287.

misrepresented his cigars as having been made in Havana;¹ or falsely denoted or indicated to the public, in the title of his merchandise, that the formula for his medicine was prepared in the East Indies;² or untruly represented the place of origin as well as the manufacturer;³ or continued the use of the name of a predecessor after he had ceased to be connected with the business.⁴ But it must be remembered that, in all the above cases, fraud was a predicate. — *Where no actual or constructive fraud is shown, and no intention to harmfully mislead purchasers, manifested by the use of instrumentalities that would naturally tend to that result, the rule does not apply.* The Supreme Court of Connecticut said, in the case of *Meriden Britannia Company v. Parker*,⁵ that the deception need not be of such a character as to work a positive injury to purchasers; nor, on the other hand, can every erroneous impression which the public or a portion of the public may receive, be sufficient to destroy the validity of a trademark. — There are abundant illustrations of this principle. Thus, it has been held that the facts in the following cases did not disentitle the complainant to an injunction: an incorrect statement that a work was “By William Granger, Esq.”;⁶ the assumption of the title of “Professor,” and some exaggerated commendations of medicines;⁷ a statement on the title-page of a song, “Written by George Linley,” he having written the words, though he did not compose the music, though Linley was better known as a composer than as a poet;⁸ a representation that it was the six hundredth edition of the complainant’s work, it being proved to be a custom to style every issue of two hundred and fifty copies a new edition, or by a state-

¹ *Palmer v. Harris*, 60 Penn. 156; 8 Am. L. Reg. (n. s.) 137; R. Cox, 523.

² *Connell v. Reed*, 11 Mass. 477; 85 Am. R. 399.

³ *Manhattan Medicine Co. v. Wood*, 108 U. S. 218; *Siegert et al. v. Abbott*, 61 Md. 276.

⁴ *Partridge v. Menck*, 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72; *Helmbold v. The Henry T. Helmbold Manufacturing Co.*, 53 How. Pr. 453.

⁵ 39 Conn. 450; 12 Am. R. 401; 13 Am. L. Reg. (n. s.) 153.

⁶ *Hogg v. Kirby*, 8 Ves. 215. ⁷ *Holloway v. Holloway*, 13 Beav. 209.

⁸ *Chappell v. Sheard*, 2 K. & J. 117; 1 Jur. (n. s.) 996; 3 W. R. 646; *Chappell v. Davidson*, 2 K. & J. 123; 8 De G., M. & G. 1.

ment that the work was specially revised by the author, the words being properly interpreted to mean that it was a specially revised edition, but not to distinguish it from all previous ones in this respect;¹ a representation by defendant that the name placed on plaintiff's thread was fictitious;² misrepresentation in selling, as quart and pint bottles, bottles that contained less, the deficiency amounting to about $\frac{7}{30}$, there being no evidence that any one had been or was likely to be deceived;³ untruly stating in circulars, advertisements, etc. that they were carrying on the business formerly carried on by the defendant, plaintiffs having in fact purchased the stock in trade, etc. of the business carried on by the defendant from his assignees in bankruptcy.⁴ — A trade-mark will not be defeated by the unwarranted use of the word "imported" in connection with it, unless such use is intended to deceive the public.⁵ Plaintiff, as a trade-mark for oleomargarine, used the word "Alderney," which he stamped on his merchandise. It was held to be merely arbitrary, and not calculated to deceive.⁶ — In *Conrad v. Joseph Uhrig Brewing Company*, the defendant alleged fraud on the part of the plaintiff in his use of "Budweiser Lager-Bier," when in truth his beer was not made in Budweis, in Bohemia, but was made by the Budweiser process. The court did not heed such defence.⁷ In *Clark v. German Mutual Fire Insurance Company*,⁸ it was held that trading under the name of "National Slipper Company" does not necessarily imply a corporation, nor an association of powers, but it may be the trade-name of one man. — The use of the words "Number 10, South Water Street," as indicating the place of business of a manufacturer, has been protected by injunction,

¹ *Metzler v. Wood*, 8 Ch. D. 606; 47 L. J. Ch. 625; 38 L. T. (N. S.) 541; 26 W. R. 577.

² *Stewart v. Smithson*, 1 Hilt. 119; R. Cox, 175; *Dale v. Smithson*, 12 Abb. Pr. 237; R. Cox, 282.

³ *Hennessy v. Wheeler*, 51 How. Pr. 457; 69 N. Y. 271; 15 Alb. L. J. 454; 25 Am. R. 188.

⁴ *Hudson v. Osborne*, 39 L. J. Ch. 79; 21 L. T. (N. S.) 386.

⁵ *Funke v. Dreyfus*, 44 Am. R. 413; 34 La. Ann. 80.

⁶ *Lanferty v. Wheeler*, 11 Abb. N. C. 220.

⁷ 8 Mo. App. 277.

⁸ 7 Mo. App. 77.

the words being a mere arbitrary designation, and not corresponding with any real number.¹—Selling coal under the name of “Wallsend,” though all original collieries of that name had previously been worked out, was not considered a misrepresentation to the public, as purchasers do not attach a definite meaning to the word, but would understand by it any good coal from the Northern districts.²—It was not a harmful misrepresentation to sell a preparation of infusorial earth under the name of “Electro-Silicon,” silicon not being susceptible of being an object of general commerce, for the reason that in nature it exists in such minute quantities.³ It was held that the name “Alderney” was a valid trade-mark for oleomargarine; and yet we can understand that it might possibly have conveyed a wrongful impression.⁴ In that same case, the plaintiff had placed the words “Patent Sept.” upon his goods, and although the patent had been allowed, but had not actually issued, the statement did no harm.—In *Smith v. Sixbury*,⁵ the name “Magnetic Balm” was held to be a valid trade-mark, on the expressed ground that the medicine contained neither magnetism nor electricity, and that it did not contain any fraudulent suggestion.—In the Court of Paris, in 1881,⁶ the following illustration was given. The plaintiff, a tailor in Paris, had assigned to his step-son, Bizet, his place of business, with the right to take the title of “Successeur de Montagne.” Bizet, whose mother had espoused the plaintiff, put up a sign, and printed on his papers, the denomination, “Maison L. Montagne et fils, Bizet, dit Montagne fils, successeur.” In his defence, he insisted that in so doing he only continued a situation created by Montagne, who had always presented him to customers as his own son and partner; that if there had been between them only an apparent association, the business name of the place was nevertheless that of “Montagne et fils.” This

¹ *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 226; 19 Am. R. 278.

² *Lee v. Haley*, 21 L. T. (N. S.) 546; 18 W. R. 181; L. R. 1 Ch. 155; 39 L. J. Ch. 284; 22 L. T. (N. S.) 251; 18 W. R. 242.

³ *Electro-Silicon Co. v. Hazard*, 29 Hun, 369.

⁴ *Lanferty v. Wheeler*, *supra*.

⁵ 25 Hun, 232.

⁶ *Montagne v. Bizet*, 27 Annales, 191.

claim to pass in business as the son of the plaintiff was denied by the latter, who prosecuted him for usurping the false quality of son of his predecessor. The tribunal below had held that, inasmuch, as long prior to the cession by Montagne of his house of commerce to Bizet, the house, although carried on alone by Montagne, bore the name of himself "et fils," the denomination had become the property of Bizet; and although there was a lack of strict truth, it was harmless, and not obnoxious to the charge of deceit. — The question of harmless untruth came up in the French Court of Cassation, in 1882, in *Bardou v. Lacroix*,¹ with the same result as in the foregoing case. The plaintiff and his son, makers of cigarette paper at Perpignan, had given to their product the fanciful name of *papier goudron*, which had acquired great popularity. In the tribunal of first instance, the defendant was victorious, as he was also in the Court of Paris, on appeal; one of the grounds of decision being that the plaintiff was disentitled to redress, by reason of false representation. The court of last resort reversed the action below, and said that the law does not prohibit denominations purely arbitrary and fanciful; and that the plaintiff was not to be defeated under the plea of untruth, it appearing that, while the article was called "tar-paper," not a particle of tar entered into its composition; and that, there being no intention to deceive as to the nature of the merchandise, it could not be regarded as a lying trade-mark. — At this point is needed a reference to a case decided by the Court of Appeals of Maryland, in 1884.² That case takes extreme views, seeming to go to the length of holding that a misrepresentation, although innocent of wrongful intention, and essentially harmless in consequences, vitiates all right to redress for infringement. The bill charged a simulation of a trade-mark and label. Among other things that label read, "Angostura Bitters, prepared by Dr. Siegert, at Angostura, now Port of Spain, Trinidad." The court said, *inter alia*: "It is conceded that Dr. Siegert died in 1870.

¹ 27 Annales, 214.

² *Siegert et al. v. Abbott et al.*, 61 Md. 276 (citing with approbation §§ 71 and 474 *et seq.* of the first edition of this treatise).

The bill so charges. He never lived at Port of Spain. The complainants, his sons and successors in business, removed to Port of Spain after his death. One of the complainants was associated with Dr. Siegert in the business as his partner, and alleges that, as survivor, he succeeded to the business, and subsequently he associated his brothers, the other complainants, with him as partners in the trade. . . . It is true a removal from 'Angostura or Ciudad Bolivar to Port of Spain' is noted on the label; but it is so noted as to leave the impression that Dr. Siegert, the inventor and original proprietor, had so removed, and was continuing his manufacture at Port of Spain; . . . no intimation is to be found in the label that he is dead. . . . It should be remarked that, in the note of warning against counterfeits, at the left hand of the label, it is stated that bottles bear the complainants' signature, which inspection shows to be not theirs, but the original inventor's. We are unable to distinguish this case from the Manhattan Medicine Company's case." The defendants relied on the case of *Siegert v. Findlater*,¹ wherein the same complainants, after the death of their father, were awarded an injunction, although the same point as to misrepresentation was made. The court relied on a particular case as a conclusive precedent.² Let us compare the two by the records. The complainant, a New York corporation, derived all its right, through various mesne assignments, from one Moses Atwood, of Georgetown, Mass. Its bottles bore, blown in the glass, the words, "Atwood's Genuine Physical Jaundice Bitters"; and the labels thereon stated the article to have been manufactured by Moses Atwood, Georgetown, Mass., and sold by his agents. The court said, *inter alia*: "It is admitted that whatever value the medicine possesses was given to it by its original manufacturer, Moses Atwood. He lived in Georgetown, Massachusetts. He manufactured the medicine there. He sold it with the designation that it was his preparation. . . . As the medicine was tried and proved to be useful, it was sought for under that designation, and that purchasers might not be misled,

¹ 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (n. s.) 349; 26 W. R. 459.

² *Manhattan Medicine Co. v. Wood*, 108 U. S. 218.

it was always accompanied with a label showing by whom, and in what place, it was prepared. These statements were deemed important in promoting the use of the article and its sale, . . . yet they could not be used with any honest purpose when both statements had ceased to be true. It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company, in the city of New York." The court, in fixing fraud upon the complainants, cited nine cases as illustrations.¹ All but the first were tainted with fraud. But wherein consisted the fraud in the Maryland case? If Dr. Siegert did not himself prepare the bitters, his sons and survivors, and one of them a former partner of his father, did, and there is not a suggestion that the article differed from their original manufacture, or that any one had been deceived, or was likely to be. The name of "Dr. Siegert" in his lifetime represented more than his individual self. The single name of a man in trade may come to mean many men, his successors in business, not one of them having his surname. The *ratio decidendi* differs in the two cases. The purchasers of Angostura bitters require a specific article. They care not which one of the original firm makes it, nor whether it is made at one place or at another. It was the manufacture of the same concern. Quite the contrary was the truth in the Manhattan case. *Quære*, What rank does the Maryland decision take as an authority?

§ 72. *An Untrue Use of the Word "Patented," or its Equivalent.*—If a trade-mark, or the label bearing it, untruly and fraudulently represents an article as protected by a patent, it is *prima facie* the misrepresentation of an important fact, and the owner of the mark is generally for that cause disentitled to equitable relief against a pirate.² That has been

¹ *Manufacturing Co. v. Trainer*, 101 U. S. 51; *The Leather Cloth Co. case*, 11 H. L. C. 523; *Pidding v. How*, *supra*; *Perry v. Truefitt*, *supra*; *Fetridge v. Wells*, *supra*; *Seabury v. Grosvenor*, *supra*; *Hobbs v. Français*, *supra*; *Connell v. Reed*, *supra*; and *Palmer v. Harris*, *supra*.

² *The Leather Cloth Co. (Limited) v. The American Leather Cloth Co. (Limited)*, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. (N. S.) 513; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209. *Morgan v. McAdam*, 36 L. J. Ch. 228; 15 L. T.

held to be positively so when the pretended patent never existed. Wood, V. C., in *Flavel v. Harrison*,¹ gives a reason therefor; viz. that the use of the word "patent" operates to prevent the public from testing the article bearing it, as they otherwise might; they are dissuaded from examining the article with a view to imitation; and prevented from making that free use of it which every purchaser has a right to make of an unpatented article. The knowledge that there was no patent would enable and encourage others in the trade to take it to pieces, and examine, and make copies and models of all the parts, for the purpose of imitation, if they thought it likely to be useful, which they would not think of doing with regard to a patented article. Mellish, L. J., said, in *Ford v. Foster*,² that the test must be whether the use of the term is still calculated to deceive the public, inducing them to buy goods not made by the original owner of the trade-mark, as if they were his goods. In *Lamplough v. Balmer*,³ the plaintiff's labels contained the words "Royal Letters Patent," he not having taken out any patent, and Wood, V. C., refused an injunction notwithstanding an explanation by the plaintiff that he had used the term in consequence of his having long paid duty as for a patent medicine. In *Edelsten v. Vick*,⁴ Wood, V. C., intimated a doubt whether the rule would be the same if there had originally been a patent, and the statement, being true at first, had been continued after it had ceased to be true; but in *Cheavin v. Walker*,⁵ the Court of Appeal held that the plaintiff was disentitled, by reason of his reference to a lapsed patent being such as to induce the belief that it was still in force. In *Nixey v. Roffey*,⁶ the plaintiff described himself on his labels as "Manufacturer and Patentee," though he had taken out no patent, which was held to be equivalent to describing his article as patented; and his bill was dis-

(N. S.) 348. *The Leather Cloth Co. v. Lhorsont*, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. (N. S.) 661; 18 W. R. 572. *Nixey v. Roffey*, W. N. 1870, 227.

¹ 10 Hare, 467; 22 L. J. Ch. 866; 17 Jur. 368; 1 W. R. 213.

² L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

³ W. N. 1867, 293.

⁴ 11 Hare, 78; 1 Eq. R. 413; 8 Jur. 7.

⁵ 5 Ch. D. 850; 46 L. J. Ch. 686; 35 L. T. (N. S.) 938.

⁶ *Supra*.

missed, with costs. And when a patent had been held to be invalid, it was held by a United States Circuit Court that the complainants were disentitled to relief, by reason of the reference to the invalid patent as if it were valid.¹ In all the foregoing cases, a fraudulent intention, or a tendency to mislead, was the ground of decision. But the untrue use of the word "patent," or an equivalent expression, does not necessarily disentitle to relief. Intent, or a tendency to mislead, is, after all, a question of fact to be determined by the circumstances of each individual case. Thus, in the King's Bench, in 1824, in an action on the case,² the plaintiff having been in the habit of marking his shot-belts, powder-flasks, etc. with the words "Sykes Patent" (though the patent which had been taken out had been held to be invalid), and the defendants having copied this mark on their own goods, the plaintiff was allowed to prevail. Abbott, C. J., said that it was established most clearly that the defendants marked the goods manufactured by them with the words "Sykes Patent" in order to denote that they were of the genuine manufacture of the plaintiff. It has been held by Wood, V. C., that an injunction must be granted, and an inquiry as to damages directed, notwithstanding that the plaintiff's trade-mark label contained the words "tanned leather cloth *patented* June 24th, '56," and that the plaintiff's leather cloth was in fact no longer tanned or patented; since the statement was correct when it was first inserted in the trade-mark.³ In 1856, in a case where the plaintiffs sold thread the labels of which described "patent thread," and the defendants copied the words, it was held that it could not constitute a defence to show that no patent therefor ever existed.⁴ In *Ford v. Foster*,⁵ the plaintiff had in his advertisements called himself "patentee," but the misrepresentation was held not to disentitle, being at most collateral. — Sometimes the word

¹ Consolidated Fruit Jar Co. v. Dorflinger, 2 Am. L. T. (N. S.) 511.

² Sykes v. Sykes, 3 B. & Cr. 541; 5 D. & R. 292; 3 L. J. K. B. 46.

³ The Leather Cloth Co. (Limited) v. Hirschfeld, 1 N. R. 551; and see 1 H. & M. 295.

⁴ Stewart v. Smithson, 1 Hilt. 119; R. Cox, 175.

⁵ L. R. 7 Ch. 611; 41 L. J. Ch. 682; 27 L. T. (N. S.) 219; 20 W. R. 818.

“patent” is used through a misconception of its import, as in *Cave v. Myers*,¹ in 1868, before Gifford, V. C., where it appeared that the plaintiffs had registered a design, but had not a patent, yet had described themselves as patentees, and they prevailed, notwithstanding. In the Supreme Court of Louisiana,² it was held that the use of the word “patented” must be with the purpose of deceiving the public, to be a valid objection; and if a fraudulent intention does not exist, and the use of the word may be explained in any reasonable sense consistent with truth and honesty, the party will not be prejudiced. Had the words “Registered in the Patent Office” been used, no question could have arisen, but the use of the word “patented” as applied to a trade-mark so registered is so common that the court was referred to a case where so learned a jurist as Judge Cooley uses the language, “In the United States, trade-marks may be patented.”³—In the case of *Marshall v. Ross*,⁴ 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.

¹ Seton, 4th ed. 238.

² *Insurance Oil Tank Co. v. Scott*, 33 La. Ann. 946.

³ Cooley on Torts, p. 361, *note*.

⁴ L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. (N. S.) 280; 17 W. R. 1086.

§ 73. The case of *Edelsten 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 particolored labels, in pink and green, in which the pins were described as "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 Edelsten, the plaintiff, who continued the business and the use of the labels. In 1853, Edelsten discovered that Vick, the defendant, was using labels like those of the plaintiff. *Held, first*, That Edelsten was entitled to restrain such palpable imitation. *Secondly*, That Edelsten 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 guard 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

¹ 18 Jur. 7.

the possession of either kind by a private individual is presumptive evidence of felony, as much as the possession of false 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 excite the cupidity of the fraudulent dealer; and therefore Heidsieck champagne, other wines and brandies, Piesse's 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 wines. No nation can

¹ Act of March 3, 1871.

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, nearly twoscore years ago, 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 Nîmes, 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, and 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, which is generally much short of its value as a legal tender, as, for example, the standard United States silver dollar of 412½ grains, the gold value of which in 1885 is 86.18 cents. 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 fab-

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

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

³ *Organon*, etc.

ricated for the purpose of imposing them upon the public as genuine, and gaining the difference of values. 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 piasters 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. Piasters 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 exists 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 Rachat and of Chablis heard that monks in Bordeaux 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 Bordeaux. Here was a case of competition in business by unfair means. Suppose

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

that the pious fathers of Bordeaux 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. Manufacture 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 to-morrow. We must apply a touchstone to anything 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.

- § 80. Necessity for definition.
- § 81. Trade-mark distinguished from its analogues.
- § 82. A clear conception must exist.
- § 83. Label, advertisement, sign of inn, not trade-marks.
- § 84. Convenience of statutory definition.
- § 85. *Marque de Fabrique et de Commerce*.
- § 86. Right to mark founded in immutable law.
- § 87. Of what trade-mark may consist.
- § 88. Mark is emblem of owner.
- § 89. Mark to be valid must be well defined.
- § 89 a. Word-symbols as trade-marks.
- § 89 b. Mere form of commodity not mark.
- § 89 c. Seeming contrary decisions reconciled.
- § 89 d. General type of objects not appropriable.
- § 90. Trade-mark confounded with its analogues.
- § 91. Trade-name distinguished from trade-mark.
- § 92. "What-Cheer House" case.
- § 93, 94. "A C A" case.
- § 95. "Irving House" case.
- § 96. Name of hotel not a trade-mark.
- § 97. "McCardel House" case.
- § 98. "Howe's Bakery" case.
- § 99. Howe's name not a trade-mark.
- § 100. "Antiquarian Book Store" case.
- § 101. Name of hotel and trade-mark not convertible terms.
- § 102. British "Merchandise Marks Act," — definitions.
- § 103. Is name of newspaper a trade-mark?
- § 104. "National Advocate" case.
- § 105. "New Era" case.
- § 106. "Porter's Spirit of the Times" case.
- § 107. "National Police Gazette" case.
- § 108. "La Cronica" case.
- § 109. Copyrights and trade-marks distinguished.
- § 110. Name of newspaper discussed.
- § 111. Meaning of design-patent.
- § 112. Trade-mark, copyright, and patent, — little analogy between.
- § 113. Patented design may be adopted as mark.
- § 114. Judicial opinion as to newspaper name.
- § 115. Name of newspaper a trade-mark.

- § 116. Trade-marks on books.
- § 117. Books regarded as merchandise.
- § 118. Title of book as a trade-mark.
- § 119-125. "Yankee" soap case.
- § 126-128. Leather Cloth case discussed.
- § 129. No abstract right in a symbol.
- § 130. A trade-mark one's commercial signature.
- § 131. Generic terms to be avoided.
- § 132. Why labels are evidence.
- § 133. Matters not sufficiently arbitrary.
- § 134. Generic names not valid marks.
- § 135. Valid trade-marks may suggest quality.
- § 136. Line of demarcation not easily drawn.
- § 137. Style or peculiarity of package not mark *per se*.
- § 138. Misconceptions as to nature of symbolism.
- § 139-142. What is merchandise?
- § 143. Essential characteristics of 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*, &c., we mention things which are analogues of one another, 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 exam-

¹ Logic, Lect. VIII.

ple, 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:¹ "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 contain pure gold, we find but withered leaves. In no unkind spirit, we scan words that should be fortresses of thought, and find a heap of chaff. No one has a 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

¹ Logic, Lect. X.

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 trade-mark 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 Watts, 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 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 anything, 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

¹ *Falkinburg v. Lucy*, 85 Cal. 52.

² *Leather Co. case*, 11 Jur. (n. s.) 518.

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

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

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 lawsuit 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 statutory definition of a trade-mark, which should distinguish, as was done by the old French law, between the *marques de fabrique*, or trade-marks properly so called, consisting of a stamp affixed to or incorporated with a manufactured article, and the use of a name, label, 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,

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

² 2d ed., p. 83.

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 general 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 commerce 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,² where the phrase "trade-marks affixed to merchandise" is rendered in the counterpart *des marques de fabrique apposées dans l'autre sur certaines marchandises*; and see, also, our conventions with Belgium³ and France.⁴ The German term *Fabrikzeichen* is translated into the same words in French.⁵ We find a

¹ Lalande et Liot v. Appel et al., 5 Annales, 248.

² Jan. 27, 1868.

³ Dec. 20, 1868.

⁴ April 16, 1869.

⁵ Technologisches Wörterbuch, in three languages. Paris, 1855.

more comprehensive definition of the term mark of trade, in German.¹

§ 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 that it 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 fully to 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 shall perceive that any arbitrary law — as a treaty, a convention, or a statute — cannot be a 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. *Of what a Trade-Mark may consist.* — The mark may consist in the name of the owner, whether manufacturer or vendor of the merchandise (provided it be written, printed, branded, or stamped in a mode peculiar to itself); in a seal, a letter, a 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.² It may be adhesive or non-adhesive. It

¹ “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.

² The British Trade-Marks Act of 1883, sect. 64, says: “A name of an individual or firm printed, impressed, or woven in some particular and distinctive

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.¹

§ 88. We must not be misled by a sweeping definition.² 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. *To be a valid Trade-Mark a Symbol must be well defined and certain.* — We may readily understand why a non-descript vignette, 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

manner; or a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark."

¹ "A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use." Ibid. See also § 102, *infra*.

The Trade-Mark law of the German Empire, of Nov. 30, 1874, does not attempt an elaborate definition; but it expressly excludes from registration such marks as consist exclusively of figures, numerals, letters, or words, or which contain a public escutcheon or any device tending to cause scandal or offence.

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."

² Standard authorities sometimes make a slip. For example, Webster's Unabr. Dict., ed. of 1883, has the definition of "*Reproduction*. The act or process of reproducing; as, the *reproduction* of plants or animals from cuttings or slips." See also note to § 1.

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. There are, however, arbitrary symbols that require more than a single glance to have their true character understood. It may be that purchasers are required to be specially instructed as to intent and signification; but when once explained in connection with certain merchandise they become reliable exponents. Examples will appear in other parts of this work; but, for present illustrations, the following instances, which have all been approved as valid trade-marks, may be cited.—Exporters of cotton cloths to Turkey and the Levant affixed to their cloths a certain heading, consisting of different-colored threads in combination.¹—A selvage and a single thread in a woven fabric. It was held that by their color, their disposition, and the places occupied, they became a distinctive sign, especially when their distinctive character resulted principally from contrast with the color of the product to which they were attached.²—So of a simple selvage or edging composed of one of several threads woven into the top or border of a stuff.³—A simple band of gilt paper rolled around the lower part of a wax candle.⁴—Inscriptions and emblems, notably medals, in relief in the glass of a flask, when the arrangement is original.⁵—A star, printed on a colored card by itself.⁶—A hidden mark on the part of a cork that is inserted in the bottle.⁷—The union of

¹ Harter v. Souvazoglu, W. N. 1875, p. 11; L. J. Notes of Cas., 1875, p. 20; W. N. 1875, p. 101.

² Ph. Vrau & Co. v. Pouillier-Loughaye et al., 26 Annales, 92.

³ Cuillieron-Policard v. Gadobert, 21 Id. 62.

⁴ Cusimberche v. Debard et al., 27 Id. 304.

⁵ Robert v. Grandjean, 28 Id. 145.

⁶ Lelarge v. Brossom, Journ. du Palais, 1840.

⁷ Ministère Pub. v. Bernard, Id., 1845.

divers emblems that had previously become *publici juris*. The highest court in France, in 1875, held that, the instant the union became of a nature to indicate a product in a distinctive and characteristic manner, it became a valid trade-mark.¹— A peculiarly formed stick, in two pieces fitted together, with the ends of an octagonal shape, upon which carpet was rolled.²— A perfectly formed metallic bell of the height of about an inch, with clapper, a miniature of the great bell at Moscow, and used to be hung by a ribbon to the neck of a bottle containing champagne wine entitled “Bell of Moscow,” was rejected by the Trade-Mark Examiner. On appeal to the Commissioner, on authority of the carpet-stick case, registration was allowed.³ Very recently, a novel style of symbolism has favorably been considered by the Patent Office, as possessing all the essential characteristics of a trade-mark. This species of symbolism is of an ancillary nature, being the groundwork upon which is laid another and distinct trade-mark, and the matter is printed on a wrapper for bars of soap. It was found to be necessary to protection, that the general aspect of the wrapper of a cake of soap should be strictly defined and guarded. One configuration for a wrapper is thus described: “Within a parallelogram, with a triple-ruled border, is a mosaic tessellation, the same being an aggregation of uniform squares, separated from one another by straight lines. Every one of said squares contains four separate triangular figures formed by continuous straight lines, bent so as to form two acute angles and one right angle, yet separate, so as to leave a space between them, thus forming a diagonal cross. Laid upon, and extending across, said parallelogram, is another and smaller parallelogram narrower in proportion.”⁴— Another for a groundwork has a representation of clover leaves, the greater number of which are four-

¹ Fox v. Meurgey *et al.*, 20 Annales, 213.

² Lowell Manuf. Co. v. Larned, in 1873, Codd. Dig. 341; Cox's Man., Case 428. In a note to this case, Mr. Cox expresses his opinion that the said stick was a perfectly good trade-mark. Certainly the device is *sui generis*.

³ Re Charles Narcisse Farre, cert. No. 8,939.

⁴ Re Procter & Gamble, cert. No. 11,927, dated Feb. 10, 1885.

leafed.¹ Another has a complex groundwork, formed by a multiplication of fine curved lines spreading, from a point, in every one of a great number of connected somewhat irregular figures, forming a neutral tint. Interspersed are circular devices, all similar and bearing the representation of a half-moon.²—There are many others of the same owners that are just as peculiar. The designs are novel, and require an inspection of the fac-similes to understand the verbal description.

§ 89 a. *Word-Symbols*³ as *Trade-Marks*.—A combination of words, or a single word, or a collocation of letters of the alphabet not recognized as a word, if non-descriptive of the vendible commodity to which the same is affixed, may be a trade-mark. When so used, words cease to be mere words, and become denominations of fancy. The arbitrary use of a word, a compound phrase, or letters in a certain juxtaposition or arrangement, indicates that the thing is a technical trade-mark. But there is sometimes a conflict of laws in regard to word-symbols; and strange contradictions arise in respect to judicial protection for them. It is possible that a right may exist, and yet protection therefor be in abeyance. Thus, in Great Britain, under the trade-mark act of 1875, a word was not entitled to recognition as a trade-mark unless it had pre-

¹ Same firm, cert. No. 11,959, dated Feb. 17, 1885.

² Same firm, cert. No. 11,962, dated Feb. 17, 1885.

³ The author of this treatise coined the expression "word-symbol," because some new definite term seemed to be necessary. The convenience of the term is recognized in the Patent Office and in practice. "Word" is equivocal; for a word may be merely a vocal sound or a combination of vocal sounds; or a talk, discourse, or language; or it may be a written or printed character. If written or printed, a word may be spelled in several ways. Thus *Anotto* may be spelled in five ways, *Carbineer* in four ways, *Gantlet* and *Palette* each in three ways. (See Webster's Unabr. Dict., ed. 1883, Orthography, pp. lxviii.-lxxi.) The assemblage of letters may be substantially the same, yet be varied to eye and ear. A symbol is a sign by which one knows or infers a thing. It is positive, invariable. A *word-symbol* is therefore understood to mean precisely this: a combination and arrangement of letters that remain in the same relative position, a definite character addressed to the eye. Why not employ the simple noun "word"? Because it has been deprived of its proper office; or, indeed, the emblem formed of letters may not be a recognized word at all, or it may be a word distorted out of all natural shape. See §§ 83, 68, 192, and Index, for examples.

viously been in use as such, so that there might be protection for one man's fancy name when another's would be refused, because he adopted it a day too late. Under the act that went into operation at the beginning of 1884, arbitrary words may be valid marks. — So in France, as well as in this country. But the legislation of some countries positively excludes them from protection. For example, the law of November 30, 1874, of the German Empire, refuses registration to such marks as consist exclusively of words. — An international convention for the formation of a Union for the Protection of Industrial Property was held on March 20, 1883. Many nations have already acceded to the terms of the convention. Article 6 thereof reads thus: "Every mark of manufacture or of commerce, regularly registered in the country of origin, shall be admitted to registration and protection in all the other countries of the Union." In his circular of August 26, 1884, M. Ch. Herisson, Minister of Commerce, properly says: "The legislation of divers nations does not admit as trade-marks certain signs, certain emblems. As to those concerning the states of the Union, the marks of French manufacture and commerce shall be admitted to registration, as they shall have been registered in France."¹ It is intended that all the principal countries shall accede to the terms of the convention, just as they have in regard to postal matters. This strange state of affairs may be possible. An Englishman or a Frenchman may be entitled to registration and protection of his word-symbol in a foreign country, when a citizen of that country would be excluded by local legislation. But, for the purposes of this discussion, arbitrary words shall be regarded as entitled to plenary protection.² In the adoption of a word, or of words, it is not for the adopter to determine its technical validity. That is a judicial question. Yet it is not difficult to reason from authorized rulings. The word "Swing" for a socket of a scythe-snath was

¹ 29 Annales, 289 *et seq.*

² The United States has thus far declined to join the Union, — although represented at the convention, — for the reason that trade-marks had become complicated with patents.

decided not to be sufficiently arbitrary.¹ So of "Masonic."² "Snowflake" was held not to be a valid trade-mark for bread or crackers, because, said the court, "In the common or ordinary sense it is understood to be descriptive of whiteness, lightness, and purity."³ The words "Homœopathic Medicines" were held not to be arbitrary.⁴ "Albany Beef," (slang term for sturgeon) was rejected.⁵ So was "Crystalline" for artificial stones or brilliants.⁶ "Nappes de Famille" (family table-cloths, &c.), applied to all cloths of a certain dimension, of whatever material, could not be exclusively appropriated.⁷ Words in ordinary and common use, such as "Charity" or "Faith," are not susceptible of appropriation as a title or designation for a book, or a play, to treat or symbolize the virtues.⁸

§ 89 b. *The mere Form of a vendible Commodity not a Trade-Mark.*⁹—A demonstration of this doctrine should hardly be necessary; but it is not always remembered that the mark is merely the authenticating sign or emblem. The following are illustrations of misconceptions in this regard. In the year 1844, the Tribunal of Commerce of Morlaix emphasized this rule.¹⁰ In that instance, the plaintiff claimed the form of the article of commerce — a pipe — as a trade-mark, but his claim was rejected. In 1865, the Court of Paris held that the cylindrical shape of a package of cigarette-paper was not a trade-mark.¹¹ In the last-named court, in 1870,¹² the plaintiff, as assignee of one Gibbs, of a mechanical patent and also an *alleged* trade-mark, claimed as a technical trade-mark

¹ Re Thompson, Derby, & Co., 16 Off. Gaz. 137.

² Re Smith, *Ibid.* 764.

³ Larrabee v. Lewis, 67 Ga. 561; 44 Am. R. 735. (A questionable ruling.)

⁴ Humphrey's Specific Homœopathic Medicine Co. v. Wenz, 14 Fed. R. 250.

⁵ Re Ams, 24 Off. Gaz. 344.

⁶ Re Kipling, *Ibid.* 899.

⁷ Chicot & Co. v. Vespierre & Rozé, 25 Annales, 162.

⁸ Isaacs v. Daly, 39 N. Y. Superior Ct. 511.

⁹ See § 137, *infra*: "The style or peculiarity of package is not *per se* a trade-mark."

¹⁰ Fiolet v. Duval, *Traité de la Contrefaçon*, by Etienne Blanc, 763; Huard, *Marques de Fabrique*, 19.

¹¹ Prudhon v. Villaret, 11 Annales, 443.

¹² Willcox v. Aubineau *et al.*, 17 Annales 31.

the form "G," of his sewing-machine arm. In 1867, the plaintiff had registered in France two alleged trade-marks, one the form "G" of the machine and the other the letter "G" embodied therein, and affixed thereto. On appeal the court said: "To accept as a trade-mark the product itself in its particular form, without other sign borne by the product to distinguish it, would be to exceed the intention of the special law of the matter. Such a doctrine would not only recognize the privilege of the inventor, but also the privilege of the very form of the product, that, in effect, by means of the deposit of the product under pretext of its being a mark, the product would become the privilege of the manufacturer to the prejudice of the liberty of trade; and, as by the registration act of 1857 the privilege of the mark is indefinitely renewable, one might acquire thereby the perpetuity of an indefinite privileged property in the form of the product itself, contrary to the principles of patent law. Inasmuch as the mark claimed by Willcox, as a distinctive sign of his sewing-machines, is the design of the manufacture itself, and is not an emblem or detail affixed in any manner whatsoever to the complete machine, if the peculiar form were entitled to any protection it was only by virtue of the patent, and, on the expiration of that, the public had a right to make machines in the form of the *letter*." — The exact point has recently been passed on in a United States Circuit Court with the same result, and probably without any intimation of the foreign decision.¹ A design-patent for the form of the letter "G" had been granted, August 10, 1858, and its re-issue of June 10, 1867, had expired by limitation. The complainant had also, on June 14, 1881, registered the same device in the United States Patent Office, as a trade-mark, claiming title by user back to 1859.² Wheeler, J., said, *inter alia*, that, in the patent, the shape of the frame, the letter "G," was particularly described, and its advantages set forth thus: "Which not only stamps it with a peculiar character, but is also exceedingly use-

¹ Willcox & Gibbs Sewing-Machine Co. v. The Gibbens Frame, 17 Fed. R. 623; 24 Off. Gaz. 1272.

² U. S. registration certificate No. 8,356.

ful, as it affords the greatest possible space for the cloth or material to be sewed of being turned and twisted under the needle and upon the table"; and there was claimed as a part of the patented invention "combining with the vibrating needle-arm a frame shaped substantially like the Roman letter G, as herein shown and described, and for the purposes set forth." *Per Curiam*: "The frames in this form were a part of the manufacture to be identified as to source, and not an identifying mark, merely, of source, indifferent to the main feature. All right acquired under the patents expired with them. . . . All the effect which these frames have in representing machines to be those of the orator appears to be due to the monopoly enjoyed under the patents; and to give the orator the benefit of the effect by calling the frame a trade-mark continues the monopoly indefinitely, when under the law it should cease." — In a United States Circuit Court, in 1871, Sawyer, J., said: "I find no case where the use of a package of peculiar form and dimensions has been restrained, without having impressed upon or connected with it some other word, symbol, letter, or form, adopted as a trade-mark."¹ In that case the claim was for the peculiar form, construction, and capacity of a barrel for whiskey. — So, in 1877, in a United States Circuit Court it was held that the complainant could not legally enjoy the exclusive right to use a decorated tin pail as a box for paper collars, notwithstanding the fact that he was the first to employ it for that purpose, and had registered it as a trade-mark.² — It was correctly held by the Patent Office, in 1875, that "galvanized iron hoops placed on a barrel of a dark color," as a trade-mark in respect to spirituous liquors, could not be such, even if the applicants were the first to use them on barrels of spirits, as they convey no distinctive idea.³ — In 1877, that Office had before it an application for the registration of a strip of leaf-tobacco, intended to be wrapped around the mouth-piece of a cigarette, and to vary with the size of the cigarette, as a trade-mark. The application for

¹ *Moorman v. Hoge*, 2 Sawyer, 78; 4 Am. L. T. 217; 6 Am. L. Rev. 365.

² *Harrington v. Libby*, 12 Off. Gaz. 188.

³ *Re Kane & Co.*, 9 Off. Gaz. 105.

registration was rejected, because it was in fact adopted to serve a mechanical purpose rather than to distinguish the applicant's goods from those of others.¹ — In an analogous case, in 1878, under an indictment for counterfeiting an alleged trade-mark, consisting merely in the color of oil used for illuminating purposes, United States District Judge Giles doubted the possibility of protecting such a matter as a trade-mark, although it had been registered; and the prisoner was acquitted.²

§ 89 c. There are decisions which, at the first glance, seem to hold that the *mere form* of the vendible article may constitute a technical trade-mark. Careful analyses cannot fail to induce the conclusion, that the principles of unfair competition, rather than those appertaining to trade-marks, were the bases of judgment. In the Tribunal of Commerce of the Seine, in 1856,³ it appeared that the plaintiff sold chemical paper enclosed in a maroon-colored pasteboard roll. Injunction and damages. — In the Court of Paris, on appeal, in the same year,⁴ a biscuit manufacturer had for his biscuits four packages of white glazed paper, with a label "At the Biscuits of the Crown" printed thereon in gold, with the representations of medals at each corner, the national arms in the centre, and at the two ends an escutcheon with the words "à la vanille." The defendant wrapped his biscuits in the same kind of paper, with a label printed in gold, and the representations of medals at each angle, with same national arms, and at the corners escutcheons with the words "Glaces à la vanille." No technical trade-mark had been violated; but the court held that the form and color of the package would be likely to cause confusion. — In the Court of Lyons, in 1857,⁵ the plaintiffs were manufacturers of solid laundry-bluing in cakes in the form of sad-irons, having on one side raised figures of women in the act of ironing, and on the other side women washing or placing clothes on lines to dry. The defendant made bluing in same form of sad-

¹ Re Gordon, 12 Off. Gaz. 517.

² U. S. v. Rider, Dist. of Maryland (*reported in newspapers*).

³ Poupier v. Laurençon, 2 Annales, 363.

⁴ Gillout v. Richard, 3 Id. 123.

⁵ Boilley v. Jollivet, 3 Id. 253.

irons, bearing on one side the figure of a woman in the act of washing or of ironing. The tribunal below had dismissed the case because the resemblance of form and figures was not sufficient to deceive, each package bearing the name of the respective manufacturer, and the boxes enclosing the articles being unlike in color and inscriptions, not being a servile imitation. The appellate court reversed the decision, holding that the marks and emblems of the plaintiff had been imitated, and that the change of manufacturers' names was immaterial. It does not appear that a technical trade-mark had been infringed. — In the Tribunal of Commerce of the Seine, in 1858,¹ it was *held* that, although the manufacture of "l'eau de Botot" had become public property, a manufacturer of that water had no right to use the same form of bottles and seals as did the successor in business of Botot, the originator, nor to sell the product as "veritable eau de Botot." The decision was affirmed on appeal. — In the Court of Aix, in 1872,² there was a decision that seems to go a great way in this direction. The plaintiff's peculiar symbolism consisted in the demi-cylindrical form of tablets for chocolate, having six divisions with incrustations of a letter of his surname on the flat face of every division. The court sustained the plaintiff's case; but it is not at all clear that the form of the product was held to be a technical trade-mark.

§ 89 *d.* *A General Type* of objects cannot be exclusively appropriated. — The arbitrary symbol can consist only in specific form; and the representations must be so precise, definite, and certain, as to exclude all reason for doubt of description. A case in the Patent Office, in 1884,³ involved an elaborate discussion of this theme. When stripped of redundant verbiage, the claim was for a cross represented pictorially, or by the word "Cross." Trade-Mark Examiner Seely, in refusing to register the case as presented, reasoned substantially thus: Suppose the alleged trade-mark to consist of the

¹ *Barbier v. Simon*, 4 *Annales*, 191.

² *Menier v. Reanebrun*, 18 *Id.* 29.

³ *Re Hamilton Disinfectant Chemical Works*, Case No. 18,678, filed July 31, 1884. Affirmed on appeal, 27 *Com. Dec.* 842.

representation of an eagle. The species should be shown, since, in the eye of an ordinary observer, all eagles are much alike. It should be shown as sitting, flying, or as the spread-eagle of American coins, or as the double-headed eagle of Austria, etc. — The different forms of crosses, Greek, Maltese, Latin, Egyptian, St. Andrew's, and others, are as distinct from one another as are reciprocally the letters of the alphabet. No one who has used one of the specific forms to distinguish his goods can, by his appropriation of the same, exclude all the rest of the world from a use of any of the other forms, any more than he could by the adoption of the letter A exclude others from using the remainder of the alphabet, from B to Z both inclusive.¹ An attempt to include so many undescribed forms would necessarily result in just what the applicant should avoid, — an annihilation of all distinctiveness in his chosen symbol. If he has adopted a Greek or other particular form of cross, and made it known to the public as a distinguishing mark for his goods, every departure from the clear, sharply outlined figure which he has already employed must destroy its identity, and he ceases to that extent to have a trade-mark. Purchasers accustomed to buy goods distinguished by a peculiar well-defined mark must distrust goods having a mark in some respects similar, but on the whole different. It is not the same. The advantage of the applicant is in adopting a specific form and not departing from it. If the application were admitted, the registration would go for naught. This is a common-sense enunciation of the rule that a broad claim to a common emblem cannot be allowed. — The Court of Appeals of New York, in 1876, had this case.² The plaintiff below was a manufacturer of refined lard, which he sold in vessels stamped with the figure of a fat hog, his name, and "Prime Leaf Lard": the defendants began to sell a similar article in vessels stamped with a globe, a small wild boar, their name, and "Prime Leaf Lard." Monell, J., in the Superior Court of the City of New York, thought that the defendants' mark was likely to attract

¹ He cited § 588, *infra*, which see.

² 66 N. Y. (21 Sickels) 60; 23 Am. R. 22.

to itself the same name as the plaintiff's, namely "the pig brand," and continued an injunction previously granted. The general term of that court dissolved the injunction, it being shown that the pig mark had been used by various other refiners. The court of final resort concurred in the decision in favor of the defendants, on the ground that there was not sufficient resemblance between the marks to be calculated to deceive; and because it was doubtful whether the figure of the animal from which the lard is derived was not descriptive, and therefore incapable of being appropriated. If the plaintiff had prevailed, he might have appropriated to his exclusive use all animals of that genus.—In the Court of Nîmes, in 1876, and the Court of Cassation, in 1877, a case of the same nature came up.¹ *Held*, that where it is established that, from time immemorial, merchants of truffles had employed on the common label, or letter-heads, a representation of a hog seeking truffles, the vendor who adopts and registers a label of this kind, intended to distinguish boxes of truffles put into the market, cannot claim, in a general and absolute manner, the mark of a hog, but only the distinctive configuration. It is, therefore, no infringement when another uses the representation of a hog, the peculiar design, arrangement, color, and bordering of which so completely differ as not to cause confusion in the mind of purchasers.—These two decisions held virtually that there might have been infringement of an arbitrary emblem, if the specific hog had been copied.—In the Patent Office, in 1884,² the gist of an application for registration was as follows: "The essential feature of my trade-mark is the red bag, and I therefore claim the use broadly of a red bag in which pea-seed is packed for the trade." Trade-Mark Examiner Seely, in rejecting the claim, observed that in a similar application, filed at the same time, a *blue* bag was claimed as a trade-mark for spinach-seed. In all other respects, the cases were identical, and a decision in one would conclude the Office upon the other, and upon an entire series

¹ *Bonfils Frères v. Naquet et Fils*, 26 *Annales*, 101.

² *Re Oliver Landreth*, Case No. 17,481. The Office cited §§ 271, 272, *infra*, which were approved by the U. S. Cir. Ct. (S. D. of N. Y.) in *Harrington v. Libby*, 12 *Off. Gaz.* 188.

that, in event of decision in his favor, would be presented by the same applicant, involving the right of use of bags of different colors to distinguish various kinds of seeds from those of other dealers. He said, further, that it was evident, from considering more than one case, that the purpose was to secure the exclusive use of a system of packing seeds, in which the kind of seed should be indicated, and its origin shown, by the color of the package only. He demonstrated the uselessness of such a registration if it were possible, inasmuch as it would be in any one's power, without infringing any so-called trade-mark, to employ a similar system, or any number of systems, within the limits of arithmetical permutation. Except as to the color of the receptacle, there was no limitation in respect to the matter claimed as essential. As to shape and material, they were limited to nothing, except that the receptacle must be of some material that could be made into a bag, — paper, silk, canvas, leather, India-rubber, mosquito-netting, flannel, or any other textile stuff capable of receiving color; and the bag might be of any shape or size, as, for example, a lady's reticule or a gunny sack. He argued further, that, as red-colored materials suitable for being made into bags are commonly on sale and in use, there can be no legal restriction on their use by any person, for any lawful purpose that suits his convenience. If the law were otherwise, other persons might appropriate other colors and shades *ad infinitum*. — Appealed to the Commissioner, who, for the reasons stated above, affirmed the decision. — In an appeal from the trade-mark officer in England, the court held that the symbol of a crown, or of a horse-shoe, being common to the iron trade, could not be private marks.¹ — In the Court of Aix, in 1876,² it appeared in evidence that in 1862 the plaintiff had adopted and deposited at the city of Marseilles, as a trade-mark for soap, a device enclosing the image of the Virgin Mary, her head crowned with an aureole and surrounded with stars, and her fingers emitting rays. It had no denomination. In 1866, the defendant, another soap-

¹ *Re Barrow's Application*, 5 Ch. D. 353; 46 L. J. (N. S.) Ch. 725; 25 W. R. 564.

² *Eydoux v. Morel*, 28 *Annales*, 252.

manufacturer in the same city, adopted as a trade-mark for soap a device also enclosing the image of the Virgin Mary with a crown on her head, and the infant Jesus on her left arm, a vine in her right hand, and with the inscription "La Bonne Mère" in the margin. In 1875, the plaintiff made a new deposit of his trade-mark of 1862, but he added thereto the words "La Vierge," and thereupon sued for infringement. The opinion of the court commends itself by good sense. *Held*: When one adopts as a trade-mark a *general type* susceptible of being represented under different figures and denominations distinct from one another, he has not a vested right of exclusive user, except as to the figure and denomination that he has specially chosen; and this right cannot be extended to the general type of which he has availed himself, and of all the modes of manifestation. Being only an owner of an exterior and visible sign, registered and placed under the eyes of the public, he will not be permitted to complain of the use by a rival in trade of a mark differing from his own in effigy and denomination, nor to allege the identity of type from which the two are borrowed, when no confusion between the two is possible to be seen, and they present to the vision quite different aspects. It is a matter of indifference that confusion may be awakened in the imagination. The property in a trade-mark has not for an object a pure abstraction. It is not permissible for a manufacturer who has taken such an image, to absorb into exclusive property all varieties of forms and appellations in which that image has been comprised and reproduced in the domain of arts, and by the piety of people who have appropriated it.

§ 90. It is not very strange that casual readers, or ordinary observers, should fall into the error of confounding the technical mark of manufactures or commerce with things of quite another nature,—by which is meant rights which are protected on principles analogous to those on 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. — With rare exceptions, this important distinction is observed. Mr. Lloyd, in his treatise on Trade-Marks, 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, 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.

§ 91. *Trade-Name, as contradistinguished from Trade-Mark.* — Care should be observed not to confound these two technical terms. Sometimes, in the discussion of principles, or in reasoning from analogy, learned courts fall into error in using these terms convertibly, when the rules applicable to them

respectively are in their natures mutually antagonistic. The distinction will be readily comprehended, when it is remembered that a trade-mark owes its existence to the fact that it is actually affixed to a vendible commodity.¹ A trade-name is more properly allied to the good-will of a business.² Trade-names may, for the convenience of the present discussion, be divided into distinct classes: 1. Of men, their business, or their pseudonyms; 2. Of places become famed for manufactures, commerce, health, or even luxury; and 3. Of coaches, and other vehicles for the transportation of passengers or merchandise. As illustrations of Class 1 may be taken the name of a firm, which may continue to be a trade-name long after the firm has been dissolved, as "John G. Loring & Co.";³ or the name of a person long deceased, that may represent several persons, as "Perry Davis";⁴ or the title of a corporation, as "Brooklyn White-Lead Company";⁵ or the name of a mere firm, as "The Guinea Coal Company";⁶ or a mere sobriquet, as "Tom Pouce" (Tom Thumb);⁷ or "Little Jake";⁸ or "Twin Brothers";⁹ or "National Slipper Company,"¹⁰ assumed by a single person. As illustrations of Class 2 may be taken names, as "Congress Spring";¹¹ "Old Oscar Pepper Distillery";¹² "Taper Sleeve Pulley Works";¹³ "Grande Chartreuse";¹⁴ or "La Bodega,"¹⁵ for a wine-shop. As illustrations of Class 3 may

¹ See §§ 52, 382, 384.

² §§ 521-536.

³ *Bowman v. Floyd*, 85 Mass. (3 Allen) 76. ✓

⁴ *Davis v. Kendall*, 2 R. I. 568; *R. Cox*, 112. ✓

⁵ *Brooklyn White-Lead Co. v. Masury*, 25 Barb. 416; *R. Cox*, 210. ✓

⁶ *Lee v. Haley*, L. R. 5 Ch. 155; 39 L. J. Ch. 284; 22 L. T. (N. S.) 251; 18 W. R. 242.

⁷ Trib. of Commerce of the Seine, in 1845, *Tom Pouce v. Roqueplan*, Blanc on Counterfeiting, 732.

⁸ *Grow v. Seligman*, 47 Mich. 607. ✓ ⁹ *Burton v. Stratton*, 12 Fed. R. 696. ✓

¹⁰ *Clark v. German Mutual Fire Ins. Co.*, 7 Mo. App. 77. ✓

¹¹ *The Congress and Empire Spring Co. v. The High Rock Congress Spring Co.*, 45 N. Y. (6 Hand) 291; 10 Abb. Pr. (N. S.) 348; 6 Am. R. 82; 4 Am. L. T. 168; *R. Cox*, 624. ✓

¹² *Pepper v. Labrot et al.*, 8 Fed. R. 29.

¹³ *Gray et al. v. Taper Sleeve Pulley Works*, 16 Fed. R. 436. ✓

¹⁴ See *infra*, § 407 *et seq.*

¹⁵ Trib. of Commerce of the Seine, in 1878, *Lavery & Co. v. Fajardo*, 24 Annales, 71.

be taken such names as "Conveyance Company," for an omnibus;¹ or "Revere House," for a passenger-coach.² These are only examples, for the books contain many cases of the various kinds. It is somewhat remarkable that nearly all are improperly spoken of as trade-marks, when, as presented to the courts, they were not *trade-mark* but *trade-name* cases. The distinction rests upon the manner of use; for, as was properly held by the Supreme Court of Massachusetts, in 1861,³ a thing may be a trade-name for one person, as indicating his business, and a trade-mark for another, who has affixed it to his merchandise as such; and, as the House of Lords of England afterwards said, "It is true that a name or the style of a firm may by long usage become a mere trade-mark, and cease to convey any representation as to the fact of the person who makes, or the place of manufacture."⁴ Lord Blackburn, in the House of Lords, in 1882, said that a name may be so appropriated by user as to come to mean the goods of the plaintiffs, though it is not and never was impressed on the goods, or on the packages in which they are contained.⁵ But it must be protected as a trade-name, and not as a trade-mark, as it would be, of course, when the name is stamped on, or otherwise affixed to, goods for sale. But sometimes the error is committed of calling a mere sign of a building a trade-mark, as when a sign "IXL General Merchandise Auction Store" had been registered under a State law as a trade-mark, and the court seems to have treated it as such;⁶ and, in 1883, in the course of a very able opinion, a high court cited "Revere House," "What-Cheer House," and "Irving Hotel" as trade-marks.⁷

§ 92. In the case of *Woodward v. Lazar*,⁸ 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

¹ *Knott v. Morgan*, 2 Keen, 213.

² *Marsh v. Billings*, 7 Cush. 322.

³ *Bowman v. Floyd*, *supra*.

⁴ *The Leather Cloth Co. case*, 11 H. L. C. 523.

⁵ *Singer Manufacturing Co. v. Loog*, 5 L. R. App. Cas. 8.

⁶ *Lichstein v. Mellis*, 8 Oregon, 464; 34 Am. R. 592.

⁷ *Avery v. Meikle*, Kent. L. R., April, 1883; 17 West. Jur. 202.

⁸ 21 Cal 448

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 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 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

¹ 2 Sand. S. C. 599.

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 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 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 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 struck from the injunction. Nothing thereafter remained but words in ordinary use, common to all the manufacturing world. But, as 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 general 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 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, secondly, 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,

¹ 3 Sand. S. C. 725.

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,

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

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 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 "McCARDDEL 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"; and 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 any wise discussed as anything other than what it really

¹ 28 How. Pr. R. 120.

² 10 Abb. Pr. R. 264; 6 Bos. 854; and 19 How. Pr. R. 14.

was,—“the *good-will* of the business of baking.” All the authorities commented upon by the learned Judge Hoffman, who delivered the opinion of the court, are good-will cases. He adopted the language of Vice-Chancellor Wood, in *Churton 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 expression. 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

¹ 28 L. J. Ch. 841; 5 Jur. (n. s.) 887; 33 L. T. 57.

trade-mark; for it would not indicate origin. The purchasers could not tell by the mere name which 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 *Choynski 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 accurately to 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 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 Scotland) any article of trade, manufacture, or merchandise,

¹ 39 Cal. 501; 2 Am. R. 476; R. Cox, 598.

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 *Motley 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 by the courts. 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

¹ 3 M. & C. 1; L. J. Ch. (N. S.) 308.

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

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 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

¹ Hopkins Ch. R. 347; R. Cox, 1.

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 thought 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 the plaintiff, who published the "Democratic Republican New Era." The Chancellor said: "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 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, farther on in his opinion, that "there could be very little excuse for the editor of a new paper who should adopt the precise name

¹ 8 Paige, 75; R. Cox, 11.

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." 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*,¹ 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 farther.

§ 107. *Matsell v. Flanagan*,² 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 plaintiffs' 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 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

¹ 17 How. Pr. R. 510; R. Cox, 224.

² 2 Abb. Pr. R. (N. S.) 459; R. Cox, 367.