

commenting on *Snowden v. Noah* and *Bell v. Locke*, treated it as a parallel case.

§ 108. *Stephens v. De Conto*,¹ at a special term of the Superior Court of the City of New York, in 1868, has a somewhat different complexion. The plaintiffs owned and published a newspaper called "La Cronica." The single question in controversy was as to restraining the publication by the defendant of the paper called "El Cronista." Monell, J., discussed some of the general principles of "good-will," and assumed the case to be of that nature, if indeed any right at all existed; and, in delivering his opinion, he wandered off into fields foreign to the real nature of the case presented. He said: "If this case was to be determined solely upon whether the similarity, if it could be established there was any, of the names 'La Cronica' and 'El Cronista' could mislead the public into the belief that they were the same, I should have no difficulty in reaching the conclusion, upon the evidence, that no such effect could or would result. . . . I do not understand that the protection which the law affords to 'trade-marks,' even assuming the name of a newspaper to be a trade-mark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over anything that was the subject of a patent or a copyright, but is confined to appropriations of names designating some particular manufacture or business. There can be no such property in a newspaper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and when given to the public all literary proprietorship in them is lost. And the law of trade-marks, like the law of copyright, cannot be applied to a work of so fluctuating and fugitive a character. *Clayton v. Stone*, 2 Paine, 392. I do not mean to say that a newspaper proprietor cannot appropriate, and, by long use, acquire a property in a name, which the courts will protect against piracy. In this respect the analogy of trade-marks would apply. *Dayton v. Wilkes*, 17 How. Pr. R. 510. And I have no doubt

¹ 4 Abb. Pr. R. (n. s.) 47; 80 N. Y. Superior (7 Robertson), 348.

that the names, so long appropriated and used, of 'The New York Herald,' or 'The Sun,' would be protected as trade-marks, against the assumption of those names by another proprietor. But that I understand to be the extent of the rule, and that any mere assimilation of the name — unless it was clearly to deceive the public — would not be unlawful." The injunction was accordingly dissolved, and the complaint dismissed with costs. This opinion has been quoted a number of times on each side of the question, which is evidence that it has misled. Let us hastily analyze it. What was the point? It was this: Was the use of the name "El Cronista" an infringement upon the exclusive right in the name of another newspaper, "La Cronica"? The general contents of the respective papers had nothing to do with the contest. The judge said the protection given to trade-marks had not been extended over anything that was the subject of a *patent* or a *copyright*. Nothing more true. But the name of a newspaper is not the subject of a patent or of a copyright, as we shall see hereafter in this treatise. But the judge expressly conceded that the long-used names of certain papers would be protected as trade-marks. That is our case, so far as this decision goes. With it our American authorities on this point are exhausted. We look in vain for an English case that exactly touches the present question. *Hogg v. Kirby*¹ was cited in each of the foregoing discussions; but it does not help us in reaching a determination. In no instance have we the opinion of more than one chancellor or judge. Let us think whether the true principle cannot be deduced therefrom.

§ 109. The question recurs, Is the name of a newspaper a trade-mark? If not, upon what principle is it protected? The question arose in the Patent Office upon an application to register the name of a paper. It was suggested that, as the name had been copyrighted, protection must be sought under section 86 of the law in relation to copyrights.² It is there

¹ 2 Ves. 226.

² An Act to revise, consolidate, and amend the statutes relating to patents and copyrights, July 8, 1870. — Rev. Stat., sect. 4948-4971.

provided, that any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, &c., may, upon complying with certain specified conditions, have the sole liberty of printing, publishing, and vending the same, &c. The heading of said paper consisted of an ornamental *engraving* on wood, commonly known as a *wood-cut*. It was also a *print*. Did those literal facts determine the right? We will examine for ourselves. The Librarian of Congress, not being a judicial officer in any sense, was not required to pass upon the legality of copyrighting the thing presented to him for that purpose. The fee was paid: the act was done. But does a mere newspaper heading come within the spirit and meaning of the law? The Constitution¹ gives power to Congress "to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries." We can nowhere else find the power to legislate upon copyrights. The rights of inventors and authors, as long settled in Great Britain, were familiar to the framers of the Constitution; and, as Mr. Justice Story says,² it is doubtless to this knowledge of the common-law and statutable rights of authors and inventors that we are to attribute this constitutional provision, being beneficial to all parties. It was beneficial to authors and inventors, because it maintained their rights to the product of their intellectual labor; and beneficial to the public, as it would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint. In short, the only boon which could be offered to inventors to disclose the secrets of their discoveries would be the exclusive right and profit of them, as a monopoly, for a limited period. A copyright is limited by time: a trade-mark is not. A copyright is limited territorially, but

¹ Art. I. sect. 8, sub-sect. 8.

² Story on the Constitution, vol. ii. § 1152.

a trade-mark acknowledges no boundaries. They are unlike in their natures.¹

§ 110. Literature, invention, and the fine arts needed a fostering hand, and found it. The consideration paid by them for a monopoly was a surrender to the public after a limited time. The consideration was the coin of their brains. Authors! What claim has the adopter of a trade-mark to be considered an author? He may adopt any symbol, the sign of anything in heaven above or in the earth beneath; it may be a representation of a real object, or it may be entirely fabulous. It does not require any genius for one to call a newspaper by the name of sun, moon, or star. The name of a newspaper is a sign to arrest attention, as it catches the eye. It points to something else. The heading is not offered for sale. Its office is simply to inform the public that the paper on which it is printed is the Herald, the Sun, or the Globe, as the case may be. The public care not a straw whether the heading be ornamental or plain; for the advantage in buying it is the intelligence, the editorials, the advertisements. The purchaser does not glance at the heading, the title, the name, except to be assured that he is getting the newspaper of his choice. He takes no delight in gazing upon the name or heading, as a work of art. But the copyrighted article is the thing that is sold. The book, the map, the dramatic composition, the engraving, cut, or photograph, is the thing bought. The name of a newspaper is but the guide to the thing. In the case of the heading of a newspaper, if its owner should elect to abandon it after a certain period, what value would he render to the public? None. If considered as a work of art, what would be the measure of damages for infringement?² As a penal law, the statute must be strictly

¹ *Scoville v. Toland*, 6 West. L. J. 84, U. S. Cir. Ct., Dist. of Ohio, held that labels or marks of commerce could not be protected under the copyright law. So held also in *Osgood v. Allen*, U. S. Cir. Ct., Dist. of Maine, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124. In the latter case, the title of a publication was sustained as a trade-mark. To the same effect is *Coffeen v. Brunton*, U. S. Cir. Ct., Dist. of Ohio, 4 McLean, 516; and *Collender v. Griffith*, U. S. Cir. Ct., S. Dist. of New York, as to an engraving. *Simonds on Design Patents*, p. 51.

² See sect. 100 of copyright law of 1870. Rev. Stat., sect. 4964, 4965.

construed. Again, it would be absurd to suppose that Congress intended to include such a thing, from the requirement of deposit in the mail before publication,¹ a description of the book or article, and within ten days after publication the transmission of two copies to enrich the library of the nation. The heading of the "Herald" as a work of art! We cannot conceive a mere newspaper heading to be a subject for copyright.

§ 111. In *Stephens v. De Conto*, the judge mentioned "the subject of a patent,"—meaning, doubtless, a design-patent. Is such a heading the subject of a patent? Examine: Mr. Upton, in his work on Trade-Marks,² has taken the correct position in the construction of the act of 1842, for patents for designs. The language, "any new and useful *pattern*, or print, or *picture*, to be either worked into or worked on, or printed or painted or cast, or otherwise fixed on any article of manufacture," &c., has been relied on as conferring a right to an exclusive privilege that may be made to serve the purpose of designating articles of merchandise. He says: "It is quite obvious that such was not the purpose of the law; but, on the contrary, it was manifestly intended that the *design* for which such protection was provided should constitute a portion of the manufactured article, either as an ornamental adjunct, or as controlling its figure or proportions, by no means as a mere name or designation by which to identify or distinguish the article." He maintains that the right thus acquired is in no sense a trade-mark property.³ We must agree with him that the construction sometimes given to that act was quite unwarrantable. The design that is patentable is æsthetic. The mark of manufactures or of commerce is not essentially a thing of taste. The abstract symbol has no intrinsic value. The value is in the article to which it is affixed.

§ 112. The Supreme Court of the United States in its first trade-mark case, in 1872, said: "Property in a trade-mark, or rather in the use of a trade-mark or name, has very little

¹ Sect. 90 of copyright law of 1870; Rev. Stat., sect. 4956.

² Albany, N. Y., 1860, pp. 17, 18.

³ See case of Whyte, Commissioner's Decisions, 1871, p. 374.

analogy to that which exists in copyrights, or in patents for inventions.”¹

§ 113. In *Swift v. Dey*,² Robertson, Ch. J., said: “A patented design may be adopted as a trade-mark, by consent of the patentee, and thereby its use by others for the same purpose prevented. There is no rule, however, which makes the test of the infringement of such rights the same in both cases. The defendants may be liable in both the Federal and State courts: in the former, for imitating the design; in the latter, for passing off, by means of such design, spurious wares as being the plaintiff’s: and the cause of action would clearly not be the same.”³

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

§ 115. From the foregoing train of reasoning, we deduce this conclusion. A newspaper, being a vendible article, is as much a matter of merchandise as anything can be. It would not be bought unless it contained or bore an authenticating sign. That sign is its name. Each issue may be ephemeral, and be at once consumed; but the name, its emblem, is permanent and invariable, and is the stamp of genuineness. We see, therefore, that the Office was unquestionably right in admitting the name of a newspaper to registration as a trade-mark.⁵

§ 116. *Trade-Marks on Books.* — Can printed books be protected by trade-marks? Yes, as mere merchandise; no, as literary productions. They are articles of manufacture, and may bear a particular mark to designate their author, or the merchant who sells them. Sometimes they are impressed

¹ *Delaware & Hudson Canal Co. v. Clark*, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279.

² 4 Robertson, 611; R. Cox, 319.

³ In *Re Lee & Shepard*, 23 Off. Gaz. 1271, it was decided that a patented design cannot afterwards be registered as a trade-mark.

⁴ 3 Am. L. T. 288; 2 Brewst. 321.

⁵ F. C. Barksdale, “Our Society,” No. 424.

with a peculiar symbol, to indicate the place of sale: but not so much so as in preceding ages, especially the sixteenth and seventeenth centuries, and the earlier portion of the eighteenth; for then every shop had its emblematic sign, as a dolphin, a lion, the king, &c., and a representation of that sign indicated the place of sale quite as well as could the name of the merchant or publisher. The mark of the dolphin, for example, would satisfy the purchaser, for he would reflect that he had always obtained correct editions of books at that place, — the Dolphin. In Savary's "Dictionnaire Universel de Commerce,"¹ we find that in France, and probably in other European countries, the legalized mark of a bookseller was an image placed by him under the title of a book, or on the first page thereof. This establishes the fact that books were then regarded as proper objects for the reception of trade-marks. So the courts now uniformly hold.²

§ 117. But it must be borne in mind that it is as merchandise merely, and not as intellectual creations, that books are protected by the mark of commerce. Why so? Because a book, as such, has its protection under the copyright law. If printed, ample remedy is afforded by the copyright law of July 8, 1870. That is the security which the Constitution and the statute provide for infringement upon works of literary genius, even though the pirate change the title of the book, and, as it were, hoist a false flag. It is the contents of the book that would be copied, and not its emblem, title, or mark.

§ 118. There seems to be no sufficient reason why the title of a book may not be deemed a valid trade-mark; for example, when, two centuries ago, in England, the five Presbyterian divines (Stephen Marshal, Edward Calamy, Thomas Young,

¹ Copenhagen, 1761, title *Marque*. Under this head may be found much interesting information in regard to the compulsory use of trade-marks in the various branches of manufactures.

² *Kelly v. Hutton*, L. R. 3 Ch. 703; 37 L. J. Ch. 917; 19 L. T. (N. S.) 228; 16 W. R. 1182. *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54. *Clement v. Maddick*, 1 Giff. 98; 5 Jur. (N. S.) 592; 33 L. T. 117. *Ingram v. Stiff*, 5 Jur. (N. S.) 947; 33 L. T. 195. *Osgood v. Allen*, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124. *Estes et al. v. Williams et al.*, 21 Fed. R. 189.

Matthew Newcomen, and William Spurstow) combined the initials of their names, which made the word SMECTYMNU-US, and adopted it as their joint signature, they had a valid trade-mark, if they had chosen to use it as such. It was good for the publication bearing that name, and would be entitled to protection as a trade-mark for any books which the owners of the newly coined word might offer for sale.

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

§ 120. The plaintiff alleged that, in or about the year 1845, he and his brothers were manufacturers of soap at Manchester, Conn., and made a particular kind of soap, to which, in order to identify it as their manufacture, they gave the name of "Genuine Yankee Soap." It was made in cakes of about two inches square, each cake covered with tin-foil; upon one side of each cake was attached an octagonal pink label, with the words printed thereon: "Genuine Yankee Soap, manufactured at Manchester, Conn., by Williams & Brothers, Chemists and Apothecaries. To prevent counterfeits, their signature will be upon each cake." Upon the other side of each cake was attached another octagonal pink label, with the words printed thereon: "The Genuine Yankee Soap is warranted superior to any foreign compound for shaving and the toilet, affording a copious and heavy lather, which does not dry on the face, leaving the skin soft and smooth." And at one end of each cake was attached another pink label, with the words in writing, or in resemblance to writing, "Williams & Bros." The said

¹ 2 Bos. 1.

soap was put up in pasteboard boxes, containing one dozen cakes each, and each box was covered with a brown paper wrapper, with the words thereon: "One dozen Genuine Yankee Soap, warranted superior to any foreign compound for shaving and the toilet. Manufactured at Manchester, Conn., by Williams & Brothers, Chemists and Apothecaries. To prevent counterfeits, their signature will be upon each cake."

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

§ 122. The defendant's answer denied that the plaintiffs had any exclusive right to use the designation "Genuine Yankee Soap," averring that that term described a particular style and quality of soap, and did not identify the person or persons by whom, or the place where, it was manufactured; and that the article known in the market by that name had

been for years manufactured by different manufacturers of soap in different parts of the United States, and sold by that name, and could not be appropriated by the plaintiffs. It further denied that the name L. Williams and Co. was fictitious, or used as a colorable imitation, as simulating the trademark of the plaintiffs, and deduced the title of the defendant to its use from a firm of that name, which had assigned the business and name to the defendant.

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

§ 124. In delivering the opinion of the court *in banc*, Woodruff, J., said: "The defendant is engaged in a gross and palpable endeavor, by imitating the marks and labels used by the plaintiffs, to deceive the public, and obtain patronage which would in all probability be attracted to the plaintiffs. This the defendant is doing, not only by closely imitating the plaintiffs' marks and labels, but by falsely representing his soap as a Yankee manufacture, and made by persons named Williams, when, in truth, it is made in the city of New York by the defendant, William Johnson." After characterizing the acts of the defendant as a fraud upon the plaintiffs, the learned judge said of the latter: "They have adopted, in reference to *their* manufacture (of an article which any and every one may manufacture and sell, if he please), a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior handbill upon the box, and have so arranged the whole as to suggest to any one desiring to purchase their soap, upon an inspection, that the article is theirs, and made by them, like that heretofore made, sold, and known as their manufacture. All this the defendant has copied, with an exact-

ness which is calculated to deceive even the wary, much more to entrap those who are not in the exercise of a rigid scrutiny. It is true that the defendant has put upon his labels New York as the place of manufacture, and L. Williams & Co., instead of Williams & Brothers, as manufacturers. But the latter designation imports a falsehood, and tends rather to create than destroy the impression that the soap is made by the plaintiffs; and the use of the word New York, in its obscure printing, if it be read, falls far short of suggesting to the public that it is not the soap manufactured by the plaintiffs. Whether, upon taking the proofs in the cause, it will appear that the particular words 'Genuine Yankee Soap' are to be deemed descriptive of the kind of soap which any one may make and sell by its proper name, or are terms properly designating the plaintiffs' manufacture, and so to be descriptive of their peculiar skill in making an article already in known and common use by its proper and only generic name, soap, is perhaps not free from doubt. It is quite clear, that, so far as it indicates the place of manufacture, it is a fraud on the part of the defendant to use it. . . . Without deciding whether the defendant may or may not use either of the words 'Genuine' or 'Yankee' in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or handbills, which he is using, nor any other like labels, devices, or handbills used by the plaintiffs, as set forth in the bill of complaint, or any other similar labels, devices, or handbills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap."

§ 125. So far as trade-mark law is involved, the foregoing contains very little instruction. None of the words on the plaintiffs' labels were susceptible of being made a technical mark, except the word "Yankee." The court did not announce the precise nature of the case. It was not necessary to do so, although the matter, as presented, was one of *unfair competition*. The object was not definition, but equitable relief. But the time came when allegations were more

technical, and a court was called on to decide the exact question. In a Circuit Court of the United States, in 1879,¹ Blodgett, J., held, on clear evidence, that the name "Yankee" was a valid trade-mark for soap.

§ 126. In the endeavor to ascertain the true nature of a trade-mark, we will examine the case of *The Leather Cloth Co. v. The American Leather Cloth Co.*² The plaintiffs' alleged trade-mark reads as follows: "Crockett International Leather Cloth Company, Newark, N. J., U. S. A. West Ham, Essex, England," which words form a circle. Within and near the top of that circle is the representation of an American eagle, with outstretched wings, and, over the eagle, the word "Excelsior." Below the eagle are the words: "Crockett & Co. Tanned Leather Cloth. Patented Jany. 24, '56. J. R. & C. P. Crockett, Manufacturers. + 12 Yds. +." Besides that, within the circle are two other similar crosses, and this character from the printer's font: — + —

§ 127. To enable a party to obtain the intervention of a court for an infringement of a trade-mark, he must first establish the fact of his having a trade-mark. He cannot apply that name to anything that he chooses, despite its utter lack of suitability for the purpose. The law will examine and apply the proper term of the thing presented. Now, what is the essential constituent element of this stamp? Is it the eagle, the words, or both? We must not be misled by the application of the term "trade-mark" to the whole stamp, or label, even by a court. In the House of Lords, on appeal from the Lord Chancellor, Lord Cranworth said: "The plaintiffs' trade-mark, if trade-mark it is to be called, is contained in a circle. . . . Each of the trade-marks, it is true, as well that of the plaintiffs as that of the defendants, contains within its periphery an eagle, but not at all resembling each other. The rest of the device, if it is to be called device, consists merely of words intended to indicate the nature or quality of the article, the place of its manufacture, and the names of the manufacturers." Lord Kingsdown, in the same case, uses

¹ *Williams v. Adams*, 8 Biss. 452.

² 11 Jur. (n. s.) 518.

this language: "The plaintiff's trade-mark, or what they call such," &c. It is undeniable that he used the term "trade-mark" to indicate the subject before the court; but it was not necessary to define that particular subject. The term was a convenient one by which to express the collocation of words and the eagle. The real question under consideration was, whether the defendants had been guilty of a fraud upon the public, in selling their goods as the plaintiffs'. The Lord Chancellor, whose decision was in process of affirmation, then rose to speak. His language, as to the matter of defining, relieves us from embarrassment. He saw the necessity of giving the alleged trade-mark its true name. He said: "I am satisfied that I assigned for my decision in the court below a ground narrower than I might have taken, as the basis of that judgment. There were circumstances which induced me to think that it was necessary to consider the case from the particular point of view which I adopted, and having found that the ground was sufficient for the judgment which I gave, I did not enter into the consideration of the wider view of the subject, which has been so forcibly urged by my noble and learned friends. But, in truth, my lords, not only do I concur with them, but I am satisfied that I ought to have regarded this affix to the plaintiffs' goods, which is here denominated a 'trade-mark,' as something which, according to the anterior usage and application of the word 'trade-mark' by no means resembles or comes within the description of anything that has hitherto been properly designated by that name. What is here called by the appellants a 'trade-mark' is, in reality, an advertisement of the character and quality of their goods; and, dropping for a moment all reference to the incorrect and untrue statements contained in that advertisement, I will take only what is called the 'trade-mark' of the plaintiffs and the rival or antagonistic trade-mark of the defendants, and compare them together, taking them as if they were simply — what in reality they are — two advertisements, each affixed, by way of label, to the articles manufactured by the parties respectively. . . . The advertisement is the sole foundation of the plaintiffs' case, and their alle-

gations must be reduced in substance to this: that, having advertised and described their goods in a particular manner, the defendants have borrowed their advertisements, and described their goods in substantially the same manner."

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

§ 129. An abstract right in a symbol has no existence. The subject must be considered in its concrete relation. Herein a trade-mark differs from a patent or a copyright. The former exists the instant it is issued; and the latter as soon as entered. The patentee, or the author, may not choose to immediately avail himself of the benefits of the grant; and still the right exists in full vigor, unless, of course, the invention or the book be dedicated to public use by abandonment. But the registry of a trade-mark does not *ipso facto* make the mark, but merely operates as evidence of adoption, and the right to it is inchoate, and does not become a perfect right until the owner consummate his intention and stamp the symbol upon an article of merchandise which he desires to sell. When that is done, he will have entered into possession of the exclusive right to affix that particular symbol to the class of goods to which it has been appropriated. The symbol and the article for sale are complements of each other; and it would be as illogical to term such symbol a trade-mark before affixing it to goods in trade, as to term one's loose autograph his signature, although it be the exact representation of the signature which he intends to apply to an instrument in writing.¹

§ 130. A trade-mark is nothing more nor less than one's commercial signature to his goods;² and the mark and the

¹ "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract." *Ld. Ch. Westbury, in Hall v. Barrows*, 4 De G., J. & S. 150; 83 L. J. Ch. 204; 10 Jur. (N. S.) 55; 9 L. T. (N. S.) 561; 12 W. R. 322; 3 N. R. 259. By same, *Leather Cloth Co. v. Am. Leather Cloth Co.*, 11 Jur. (N. S.) 518. See also *The Dixon Crucible Co. v. Guggenheim*, and *Candee, Swan, & Co. v. Deere & Co.*, *ubi supra*. All courts agree in this doctrine.

² The court, in *Leidersdorf v. Flint*, 8 Biss. 327, borrowed this phrase.

goods bear the same relation to each other as do the positive and the negative forces of electricity to each other; and in their apposition they mutually uphold and sustain. We must be cautious to discern between things whose natures differ, and assign to each its peculiar and appropriate sign, by words which fit close to the thoughts, or the mind will be confused by a jumble of marks of commerce, of patented designs, of copyrights, of labels, of advertisements, and other matters of incongruous natures. A definition should instantly convey the true idea of the thing, and indicate the precise species of a genus. A trade-mark is in its nature separate and distinct from everything else in the world; and yet we frequently hear of writers, lawyers, judges, by the most heedless use of the term, leading others into error. Things must be called by their right names. A homicide may mean a murderer amenable to criminal law; or he may be one whose action was justifiable as necessary to the preservation of his own life; or a sheriff reluctantly carrying into execution the sentence of a court; or a soldier in the performance of imperious duty. *Astrology*, in its etymological signification, is the science of the stars, and among the ancients it was synonymous with *astronomy*; yet no thoughtful person would confound the two terms at the present day. Before the nice distinctions connected with the law of trade-marks were well understood, learned jurists, who adorned the bench, might have been pardoned for ambiguity of expression, in confounding labels and marks; but the time for palliating such carelessness is past, and the particular symbol of commerce must be carefully distinguished from its analogues.

§ 131. The sciolist asks, Why need we seek the technical name? Cannot justice be applied under one name as well as under another? Rights are rights, says he, whatever name they bear; and the tendency of this utilitarian age is towards simplification, so that one comprehensive term may signify many things. Now, what necessity is there for the loose, indefinite application of a scientific designation, so that it may signify many things, perhaps of natures very unlike? It may be, indeed, that in some cases the paucity of terms of art or

science compels a plurality of uses for one word ; but as regards our present subject, no such necessity exists. We must be exact in specifying the name of any kind of legal right, in order to obtain the remedy that the law prescribes for a given case. Generic terms must be avoided. For example, in a statute to punish horse-stealing, we would not use "horse" and "animal" as convertible terms, for the word "animal" might mean a cow, a sheep, a hog, or a dog. To prevent confusion, we must say exactly what we mean. We would not charge a person with the commission of a crime ; but would specify the exact offence imputed to him.¹ We must seek to ascertain the peculiar physiology of the thing ; then its proper designation is the key that unlocks many of the secret places of the law connected with it.²

§ 132. This question may be asked : If labels, for instance, are not technical trade-marks, why permit evidence of their contents to be introduced, as is done in many cases? For this reason: although labels are not constituent elements of trade-marks, and are but vehicles for the same, all the details may be proved as surrounding facts, *circum stantia*, and should be brought forward as witnesses of a fraudulent intention. It must be conceded that any one may lawfully copy another's signature, or emblem of personality, and may publish it to the world ; but if, in addition to the act of imitating, he use it in a peculiar manner to obtain a false credit, as by applying it to merchandise intended for sale, then his intent may be inferred from all the minor facts. The maxim, *Noscitur a sociis*, is applicable. It is known by its companions : it is discoverable by what precedes and follows.

§ 133. We know that mere labels, notices, advertisements, and business cards, possess none of the essential characteristics

¹ Since this section was first published, events have furnished many demonstrations of the necessity for strict definitions. Uncertainty in this respect may thwart all attempts to gain protection. Nearly all the principal nations now require registration as an indispensable prerequisite to judicial redress ; and registration is applicable only to technical trade-marks. If, by inadvertence or error of judgment, matter that is insufficient in law be admitted to registration, courts will set the registration aside.

² See "Physiology of Contracts," in Anthon's Law Student.

of the common-law symbol of trade, and therefore are not entitled to registration. For that reason, a label reading, "For Sale at Record Office, Topeka";¹ or one with "Gold Medal Clothing," for a legend to be affixed to wearing-apparel;² or "Schenck's Water-proof Tags and Labels";³ or the name of manufacturer, place of business, and description of goods, stencilled, or painted, or labelled on said goods, would be rejected by the Patent Office as not being technical marks of manufactures or commerce. In one case, the applicant, a corporation created by authority of the State of Pennsylvania,⁴ for the purpose of manufacturing and selling "fruit-jars, bottles, and other vessels which are automatically and hermetically sealed when full," claimed the simple name of "Valve Jar," which was the true name of the thing made and sold by them. Those words on a label could not have the magical effect of transmuting the label into a thing of another nature. The application was rejected. So, also, where the proposed mark consisted of the words "Musical Note Paper," and the name and residence of the manufacturers of a certain kind of note-paper.⁵ A few bars of music were printed upon the first page of each sheet, as a fanciful heading. The counsel ingeniously argued that there was nothing descriptive in this designation, as the paper could not truly be termed *musical*, and that the words were not a mere label, but in verity were an arbitrary symbol, — a good trade-mark. Rejected. — The words "Johnson's American Anodyne Liniment" shared the fate of the preceding case, and upon the same grounds.⁶ The answer to the application was, that any person by the name of Johnson has a perfect right to make and vend liniment, anodyne liniment, or American liniment; and, in of-

¹ Ex parte Crane & Byron. Not reported.

² Ex parte Hammerslaugh & Co. The New York Ct. of App. in Taylor v. Gillies et al., 59 N. Y. (14 Sickels,) 881, cited with approbation the rejection of the words "Gold Medal." See case of Batty v. Hill, 1 H. & M. 264; 8 L. T. (N. S.) 791; 11 W. R. 745; 2 N. R. 265. "Prize Medal, 1862," not a valid mark.

³ Ex parte C. S. Schenck; and Ex parte Atlantic White Lead Co. Not reported.

⁴ Ex parte Valve Jar Co. Not reported.

⁵ Ex parte Schmidt & Curtius. Not reported.

⁶ Ex parte J. S. Johnson & Co., 2 Off. Gaz. 315.

fering it for sale, to call it by its proper name. The right to the use of the combination of words not being exclusive, said words could not be a trade-mark, being merely a label or advertisement, and nothing more. — A slight degree of hesitation was felt in rejecting the words “True-fit Shirts,” and “Cable-stitched Kid Gloves”; but upon reflection it was decided that these combinations of words expressed the correct names of the articles to which they were affixed, and were but the use of ordinary language, free to all who sell true-fitting shirts and gloves made with the cable-stitch.¹ — And still more hesitation was experienced when were filed the words “James Hennessy, Cognac,”² as a mark used upon brandy by the applicants or their predecessors in business for fifty-five years. This seemed to be a matter of hardship. Yet for more than half a century the firm had mistaken a mere label for the time-honored, dignified trade-mark. Remedy for its violation must be sought under local laws, or under the general powers of a court of equity for unfair competition in trade. — If one claim titles of firms, or names of manufactures, to which he shows no vested right, he will not be deemed to possess even a label. As an instance of persons seeking their own discomfiture, while swelling the revenue of the Patent Office by one hundred dollars, read these four applications.³ Claims, — the words “Bristol Watch Co., Bristol, Mass.”; “G. M. Wilson, Chicago, Ill.”; “New England Watch Co., Providence, R. I.”; and “Chicago Watch Co., Chicago, Ill.” These names, said the applicants, are used upon watches and watch-movements; and this same petition states that no other person, firm, or corporation has a right to the use of said trade-marks, or of marks substantially the same. Not even substantially the same! Rejected.

§ 134. *Generic Names*, or names merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, are not valid trade-marks.⁴ This is a general doctrine, but it has

¹ Ex parte Two cases, Fisk, Clark, & Flagg. Not reported.

² Ex parte James Hennessy & Co. Not reported.

³ Ex parte Louis Strasburger & Co. Not reported.

⁴ Canal Co. v. Clark, 13 Wall. 311.

its exceptions that will be noticed. Under the general rule, courts will refuse protection to claims for exclusive right of user in names of vendible commodities, that others must use in necessary description. As illustrative of this rule, the following cases may properly be cited. The first dates back to 1783, in the King's Bench, where the plaintiff manufactured and sold, in succession to his father, a medical preparation under the name of "Dr. Johnson's Yellow Ointment," and the defendant did the same thing. Lord Mansfield, C. J., nonsuited the plaintiff, on the ground that the name was property common to all.¹ So, also, "Schiedam Schnapps,"² or "Aromatic Schiedam Schnapps";³ "Club-House Gin";⁴ "Paraffin Oil";⁵ "Night-Blooming Cereus";⁶ "Old London Dock Gin";⁷ "Liebig's Extract of Meat";⁸ "Desiccated Codfish";⁹ "Ferro-phosphorated Elixir of Calisaya Bark";¹⁰ "Lackawanna Coal";¹¹ "Razor-Steel";¹² "Cundurango Ointment, C. O.";¹³ "Macassar Oil";¹⁴ "Lieutenant James' Horse Blister";¹⁵ "Golden Ointment";¹⁶ "Parson's Purgative Pills, P. P. P.," and "Johnson's American Anodyne Lini-ment";¹⁷ "True-fit Shirts," and "Cable-stitched Gloves";¹⁸ "New Manny Harvester";¹⁹ "American Sardines";²⁰ "Chlo-

¹ Singleton v. Bolton, 3 Doug. 203.

² Wolfe v. Goulard, 18 How. Pr. 64.

³ Burke v. Cassin, 45 Cal. 467; 13 Am. R. 204; Wolfe v. Hart, 4 Vict. L. R. Eq. 125, 134.

⁴ Corwin v. Daly, 7 Bos. 222.

⁵ Young v. Macrae, 9 Jur. (N. S.) 322.

⁶ Phalon v. Wright, 5 Phila. 464.

⁷ Binniger v. Wattles, 28 How. Pr. 206.

⁸ The Liebig's Extract of Meat Co. (Limited) v. Hanbury, 17 L. T. (N. S.) 298.

⁹ Town v. Stetson, 5 Abb. Pr. (N. S.) 218; 3 Daly, 53; R. Cox, 514.

¹⁰ Caswell v. Davis, 58 N. Y. 223; 17 Am. R. 233.

¹¹ Canal Co. v. Clark, *supra*.

¹² Re Roberts, Com. Dec., 1871, p. 100.

¹³ Re Blakeslee & Co., Com. Dec., 1871, p. 284.

¹⁴ Rowland v. Breidenbach, 1 Trade Marks, 261.

¹⁵ James v. James, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. (N. S.) 568; 20 W. R. 434.

¹⁶ Green v. Rooke, W. N. 1872, p. 49; L. J. Notes of Cases, 1872, p. 54.

¹⁷ Re Johnson & Co., 2 Off. Gaz. 315.

¹⁸ Re Fisk, Clark, & Flagg. Not reported.

¹⁹ Re Graham, 2 Off. Gaz. 618.

²⁰ Re The American Sardine Co., 3 Off. Gaz. 495.

rodyne";¹ "Nourishing Stout";² "Tasteless";³ "Für Familien Gebrauch" (For Family Use), and "Lawrence Feiner Familien Flannel" (Lawrence Fine Family Flannel);⁴ "Croup Tincture";⁵ "Cough Remedy";⁶ "Crack-Proof";⁷ "Cachemire Milano," in connection with the picture of the Cathedral of Milan, etc.;⁸ "Highly Concentrated Compound Fluid Extract of Buchu";⁹ "Egg Macaroni";¹⁰ "Angostura Bitters";¹¹ "Allcock's Porous Plasters";¹² "Post-Office Directory";¹³ "Rye and Rock";¹⁴ "Sliced Animals," "Sliced Birds," and "Sliced Objects";¹⁵ and "Straight-Cut," as applied to cigarettes.¹⁶ In all these instances, collections of words and letters were adjudged to be merely ordinary language for ordinary purposes. These are names of things necessarily or commonly descriptive of them. To the foregoing citations may be added, sometimes, descriptive geographical names of the same class as "Lackawanna" above cited; as "Moline,"¹⁷ "Durham,"¹⁸ and "Glendon."¹⁹

§ 135. *A Trade-Mark may be valid, although suggestive of Quality.* — Brown, J., in *Burton v. Stratton*, said,²⁰ that if the primary object of the trade-mark be to indicate the origin or

¹ *Browne v. Freeman*, W. N. 1873, p. 178.

² *Raggett v. Findlater*, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. (n. s.) 448; 22 W. R. 53.

³ *Re Dick & Co.*, 9 Off. Gaz. 538.

⁴ *Re Lawrence & Co.*, 10 Off. Gaz. 163.

⁵ *Re Roach*, 10 Off. Gaz. 383.

⁶ *Gilman v. Hunnewell*, 122 Mass. 139.

⁷ *Re The Goodyear Rubber Co.*, 11 Off. Gaz. 1062.

⁸ *Re Warburg & Co.*, 13 Off. Gaz. 44.

⁹ *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453.

¹⁰ *Re Dole Brothers*, 12 Off. Gaz. 939.

¹¹ *Siegert v. Findlater*, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (n. s.) 349; 26 W. R. 459. See also § 104, *infra*.

¹² *Re Brandreth*, 9 Ch. D. 618; 47 L. J. Ch. 816; 27 W. R. 281.

¹³ *Kelly v. Byles*, 40 L. T. 623.

¹⁴ *Van Beil v. Prescott et al.*, 82 N. Y. 630.

¹⁵ *Selchow et al. v. Baker*, 93 N. Y. 50.

¹⁶ *Ginter v. Kinney et al.*, 12 Fed. R. 782.

¹⁷ *Candee, Swan, & Deere v. Deere & Co.*, 54 Ill. 439; 5 Am. R. 125; 4 Am. L. T. 266; 10 Am. L. Reg. (n. s.) 694.

¹⁸ *Blackwell v. Wright*, 73 N. C. 310.

¹⁹ *The Glendon Iron Co. v. Uhler*, 75 Pa. St. 467; 15 Am. R. 599; 13 Am. L. Reg. (n. s.) 543; 6 Off. Gaz. 154.

²⁰ 12 Fed. R. 696.

ownership, the mere fact that the article has attained such a wide sale that the mark has also become indicative of quality is not of itself sufficient to debar the owner of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive right of his trade-mark just at the time when it had become most valuable to him, and stood most in need of protection. Rand, J., in *Sohl v. Geisendorf*,¹ held that the fact that the mark, to some extent, indicated quality, did not disentitle the plaintiffs. Bacon, V. C., in *Ransome v. Graham*,² held that, where a manufacturer placed on his goods a series of combinations of letters as trade-marks, each of which served to indicate to purchasers, (1.) that the goods were made by the person using the mark, and (2.) the quality of the goods, as compared with the goods respectively bearing the other marks in the series, the marks being exclusively used by the manufacturer, such series of letters were valid trade-marks, and might be registered, notwithstanding that they were indicative of the quality of the goods to which they were applied. — Section 66 of the English Trade-Marks Act of 1883 adopts and amplifies this decision. The Earl of Selborne, L. C, in a recent case,³ said: “I do not at all mean to say that it is impossible that a word which is used to describe an article may also, if the proper means are taken at the proper time, be used as a trade-mark; but when any such double use takes place, it is most important to remember the difference between the use of a name as a trade-mark, and the use of it as a descriptive term. If the article itself is *publici juris*, and anybody may make it, the people who make it are at liberty—providing they do so honestly—to describe it by the descriptive term by which it is properly known in the trade, and no right of monopoly to that descriptive term can be acquired otherwise than by using it as a trade-mark.” — The Supreme Court of Pennsylvania, in 1867,⁴ held that the words “Dr. J. M. Lindsey’s Improved

¹ 1 Wilson (Ind.) 60.

² 51 L. J. Ch. 897; 47 L. T. 218.

³ *Re Leonard & Ellis’s Trade-Mark, and Leonard & Ellis v. Wells*, 26 Ch. D. 288.

⁴ *Fulton v. Sellers*, 4 Brewst. 42; *Cox’s Manual*, case 279.

"Blood Searcher" constitute a legitimate trade-mark, although clearly indicative of the medical preparation that their assignor, Lindsey, had originated. So, under similar circumstances, the Supreme Court of Louisiana held "Bocker's Stomach Bitters" to be a valid trade-mark.¹ The words "Family Salve" were held to be a distinctive heading within Section 10 of the English act of 1875;² but it was doubted whether the scientific name of a tree, "Limetta," was so sufficiently a distinctive word as to be capable of registration as an *old* mark in respect of lime-juice.³ In France, as great liberty prevails in this respect of words that are not essentially necessary to a description of articles to which they are applied. Thus the Tribunal of the Seine, in 1875, held that the fancy denomination "Veloutine" affixed to a mixture of powder of rice and bismuth, for the toilet, constituted a valid trade-mark, notwithstanding its suggestion of a velvety appearance of cheeks, on which it might be used.⁴ The Court of Paris, in 1878, considered the words "Savon de Paris" sufficiently arbitrary for the purpose, although used for soap made in Paris.⁵ In the Court of Appeal of Paris,⁶ it appeared that A. was patentee of a process of neutralization and refining of oils. To distinguish his products obtained through the process, he registered, as a trade-mark, the words "Huiles neutres raffinées." Notwithstanding the fact that each of the words, taken separately, belongs to the common language, the union of them forms a denomination which, before the deposit (for registration) had been made by the plaintiff, had never been used in commerce. It specifies in a distinct manner his products under Article 1 of the French law of June 23, 1857. This case goes to an extreme length, even surpassing that wherein, in 1843, the Tribunal of Commerce of Paris, in advance of the statute, held that the words "Siccatif brillant" (brilliant dryer), although indicative of quality, were never-

¹ Funke v. Dreyfus, 34 La. Ann. 80; 44 Am. R. 413.

² Reinhardt v. Spalding, 49 L. J. Ch. 57; 28 W. R. 300.

³ Rose v. Evans, 48 L. J. Ch. 618.

⁴ Fay v. Durand, 20 Annales, 245.

⁵ Michaud et al. v. Lemenu et al., 23 Annales, 59.

⁶ A v. Z, Bulletin Officiel for 1884, p. 278.

theless not a necessary title of the article to which they were affixed, and were therefore a valid trade-mark.¹ The Court of Orleans, in 1882, held that the words "Papier hygiénique" and "Papier Goudron de Norwege," for cigarette-paper, constituted valid trade-marks, although more apt words could not be chosen to indicate that one was health-preserving paper, and the other Norway-tar paper.² In 1879, the Court of Cassation held that, in the phrase "Eau de toilette de Lubin," the name of Lubin, the originator, was a valid trade-mark.³ This decision of the supreme court of France seems to settle the law for that country. It is safe to conclude, in the language of our own Patent Office, that a trade-mark which is merely inferentially or remotely descriptive is valid.⁴

§ 136. *The Line of Demarcation is not always easily drawn.* — A considerable amount of close reasoning upon stated facts is at times demanded, before a court can determine whether or not a name is necessarily descriptive, and therefore not entitled to protection. One cannot wonder that on that point mistakes are made. Infallibility does not belong to this subject. Let us take as illustrations of a contrariety of opinions the case of "Worcestershire," as applied to sauce. The Supreme Court of New York held that the name, being that of the local city of manufacture, could not be protected as a trade-mark.⁵ The Supreme Court of Missouri seemed to hold otherwise, in a criminal case.⁶ Later yet, Jessel, M. R., held that, because the name had long been used by sauce manufacturers other than the plaintiffs, it was not a trade-mark.⁷ Finally, a United States Circuit Court decided it to be a generic term, holding that the former decree in England, not appealed from, was a complete bar to a suit in this country.⁸ There is not much doubt that it was

¹ Re Raphael, Huard, Marques de Fabrique, p. 15.

² Bardou & Son v. Lacroix, 29 Annales, 226.

³ F. Prot & Co. v. Jules Avice et al., 24 Annales, 345.

⁴ Re Heyman, 18 Off. Gaz. 922.

⁵ Lea v. Wolff, 15 Abb. Pr. 1; 46 How. Pr. 157; 1 Am. L. T. (N. S.) 400.

⁶ Missouri v. Gibbs, 56 Mo. 133.

⁷ Lea v. Millar, Seton, 4th ed., 242.

⁸ Lea et al. v. Deakin, 11 Biss. 23.

originally a valid trade-mark; but by tacit abandonment it had become common property to describe a particular kind of sauce. "Yankee" is another term about which lawyers did not at first agree, although a court in the city of New York, in 1857, granted an injunction against its use as an element of an elaborate label.¹ In 1879, a United States Circuit Court, by Blodgett, J., in an able opinion, put all questions at rest.² He said that it is not a geographical term, nor a proper name, but a designation applied by the dwellers in one locality to the dwellers in another; that it is not the name of any certain locality, and the complainants had a right to adopt it as their trade-mark. Further, if it had, since the date of its adoption, by a more general use and definite application, come to designate any certain locality, which was not conceded, such subsequent use cannot affect the complainants' rights. This reasoning seems to be more just than that of the Supreme Court of Pennsylvania, which apparently held that a lawful trade-mark might be extinguished by the fact of incorporation of a borough of the same name.³ "Vienna" was upheld as a trade-mark for bread, in 1881, in New York;⁴ and, in 1883, the St. Louis Court of Appeal said that, "Vienna bread" being a common article, no person can acquire by use an exclusive right to sell it.⁵ That virtually decided that it was not a trade-mark. "Bocker's Stomach Bitters," although the true name of the medicine, was recently, by the Supreme Court of Louisiana, held to be a valid trade-mark;⁶ yet, about the same time, the Supreme Court of Georgia held that the word "Snowflake" could not be a trade-mark for crackers, for the reason that it is a mere descriptive term of the quality of flour.⁷ It is difficult to understand the philosophy of this decision; for

¹ *Ante*, § 119 *et seq.*

² *Williams v. Adams*, 8 Biss. 452.

³ *The Glendon Iron Co. v. Uhler*, 75 Pa. St. 467; 15 Am. R. 599; 18 Am. L. Reg. (N. S.) 543; 6 Off. Gaz. 154.

⁴ *Fleischmann v. Schluckmann*, 62 How. 92; 8 L. Bull. 91; 20 Daily Reg., No. 55.

⁵ *Snodgrass v. Welle*, 11 Mo. App. 590.

⁶ *Funke v. Dreyfus*, 34 La. Ann. 80.

⁷ *Larrabee v. Lewis*, 67 Ga. 561; 44 Am. R. 785.

surely it seems, to the common mind, that that word is not necessarily descriptive, and, if not, it is capable of being used as an arbitrary symbol. It is a general rule that a man has an absolute right to affix his own name to his merchandise;¹ yet the Supreme Court of Iowa lately forbade a man to place his own name, the same as that of his rival, on his manufacture, and held "Shaver Wagon" to be a valid trade-mark for his competitor's wagons.² The rule is against the right of exclusive use of a geographical name;³ yet a court held the name of a place to be a valid trade-mark for the party that originally manufactured there, but who had removed, and against a new-comer who manufactured there. That was the law of the case until a superior court reversed it; but it ceased to be law when the court of last resort, the House of Lords, reversed the decision of the intermediate court, and established "Glenfield" as a legal trade-mark.⁴ So a new name of a medicine was held by one court of New York to be an arbitrary symbol, because not philologically correct;⁵ but the Court of Appeals reversed the case, and said that it was a necessary designation, and therefore not a technical trade-mark.⁶ By this time, the reader will agree with the Federal Judge Brown, who said, in 1882, "There are few classes of cases in the whole domain of the law so difficult to reconcile as those wherein the validity of a trade-mark is discussed."⁷

§ 137. *The Style, or Peculiarity of Package, is not per se a Trade-Mark.* — But the package, case, or vessel, in which the commodity is put, if prepared in a peculiar or novel manner, though in itself not a trade-mark, may very properly be a very important part or adjunct of it.⁸ The following alleged

¹ *Meneely v. Meneely*, 62 N. Y. 467. (See §§ 201–203, 393, as to use of one's own name.)

² *Shaver v. Shaver*, 54 Iowa, 208; 37 Am. R. 194.

³ See § 182 *et seq.*, *infra*.

⁴ *Wotherspoon v. Currie*, Malins. V. C., 22 L. T. (N. S.) 260; 18 W. R. 562. James, L. J., 42 L. J. Ch. 130; 23 L. T. (N. S.) 443; 18 W. R. 492. House of Lords., L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. (N. S.) 393.

⁵ *Caswell v. Davis*, 4 Abb. Pr. (N. S.) 6; 85 How. Pr. 75; R. Cox, 429.

⁶ 58 N. Y. 223; 17 Am. R. 233.

⁷ *Burton v. Stratton*, *ante*, § 135.

⁸ *Cook v Starkweather*, 18 Abb. Pr. (N. S.) 392.

trade-marks were not sustained as such by courts: a whiskey barrel of peculiar dimensions;¹ a small pail of ornamented tin for paper collars;² a package of a certain size, shape, and color, when defendant's label contained his own name in distinct characters;³ a silver-foil paper with a blue band, as a wrapper for soap, the band being carried around the cake lengthwise.⁴ — Yet, in many instances courts have granted injunctions against the use of such things; but it will be found on examination that there generally existed circumstances of fraudulent intent to encroach on a technical trade-mark, without actually imitating it; or, at least, there was evidence of unfair competition. Thus, in England, in 1831, where the plaintiff, in succession to his father, prepared calcined magnesia, and sold it in bottles of a peculiar shape, labelled "Henry's Calcined Magnesia, Manchester," and the defendant began to prepare magnesia, and to sell it in similar bottles, similarly labelled, (although it does not appear that a technical trade-mark was copied,) an injunction was granted against such acts.⁵ — So, also, where it appeared that there was sufficient doubt about the exclusive right of the plaintiff to use the words "Genuine Yankee" in connection with soap, the court granted an injunction, because, having adopted a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior handbill upon the box, so arranged as to indicate their manufacture, the defendant had copied the form, appearance, color, style, and substantial characteristics in all respects, which distinguished the plaintiff's goods.⁶ — In 1872, Lord Romilly, M. R., not only restrained defendants from publishing a book with a title somewhat resembling that of the complainant, but also from imitating the arrangement, binding, &c. in such a way as to deceive.⁷ — In the same year, where

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 *Frese v. Bachof*, 13 Blatch. 234.

⁴ *Enoch Morgan's Sons v. Troxell*, 89 N. Y. 292; 11 Abb. N. C. 86.

⁵ *Henry v. Price*, 1 Leg. Obs. 364.

⁶ *Williams v. Johnson*, 2 Bos. 1.

⁷ *Mack v. Petter*, L. R. 14 Eq. 431; 41 L. J. Ch. 781; 2 W. R. 964.

the plaintiff, being a manufacturer of a preparation for dressing leather, sold his preparation in bottles enclosed in wrappers peculiarly colored and arranged, and the defendant sold a similar preparation in similar bottles, and gradually assimilated his wrappers more and more to those of the plaintiff, an injunction was granted.¹ — A complainant had always used on cigarettes the symbol “ $\frac{1}{2}$ ” in red, and registered that as his trade-mark, and the defendant sold other cigarettes under labels essentially different. *Held*, that a limited injunction should be granted, restraining the use of that symbol in the identical form, style, size, and color, in which the complainant had used and registered it, and that notwithstanding that the defendants had used it on a label which was in other respects quite unlike that of the complainant; and yet the court expressed a doubt as to the validity of the symbol as a technical trade-mark.² — The complainants, a firm of tea-merchants, sold “Hamburg Tea” in a peculiar form of package, the tea being enclosed in long, cylindrical parcels with pink wrappers, and with crimson papers of directions, and yellow ones of warning, tied in, and having a white label with the firm name within a circle pasted across the ends of the string, and another white label with the same and the words “Hamburg Hopfensack, 6” embossed thereon pasted on the package. The defendant at first put up his tea in a precisely similar way, with the firm name and address; but after the commencement of the suit discontinued the use of the firm name and address, and substituted his own. Injunction and account ordered.³ — In the Supreme Court of the United States, in 1877, it was held that, where the defendant had placed his goods in boxes sealed similarly to those of the complainant, and enclosed in wrappers of similar color and appearance, under a name having the same sound as complainant’s, it was not necessary to prove infringement of a specific trade-mark, if the defendant had acted with a fraudulent intention.⁴ —

¹ *Brown v. Mercer*, 37 N. Y. Superior Ct. 265.

² *Kinney v. Allen*, 1 Hughes, 106; 4 Am. L. T. (N. S.) 258.

³ *Frese v. Bachof*, 13 Off. Gaz. 635.

⁴ *McLean v. Fleming*, 96 U. S. 245; 13 Off. Gaz. 913.

Although an alleged trade-mark, the name "Aromatic Schiedam Schnapps," was held to be descriptive and incapable of appropriation, an injunction was granted, as the bottles and wrappers used by the defendant were intended and calculated to deceive; and on appeal to the full court the decree was affirmed. Per Stawell, C. J.: "We are to consider whether the infringement of the plaintiff's rights has been proved, not by taking particular isolated points, but by looking at the general resemblance of the packages, labels, bottles, and other points."¹ — A complainant alleged that, to individualize and identify his bluing, he adopted a peculiar and original form and style of package, consisting of the blue cylinder having a red top, by which they were known. He also set forth that his method of packing, including the size, shape, and color of his large packages, was original with him, and had never been varied. All the leading incidents and characteristics thereof had been imitated by the defendant. It was one element of defence that there was not any technical trade-mark in the case. 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."² — In a case in the Court of Appeals of Kentucky, in 1883,³ both parties were manufacturers of ploughs. The defendants dismantled ploughs of the complainants' manufacture, and with great accuracy copied every important and ordinarily noticeable part of them. They branded them substantially in the same manner and style. They copied letters, numerals, and words of caution borne by the genuine ploughs, and stencilled them on the same

¹ *Wolfe v. Hart*, 4 Vict. L. R. Eq. 125, 134.

² *Sawyer v. Horn*, 4 Hughes, 239. — Same principle applied in *Joseph Dixon Crucible Co. v. Benham*, 4 Fed. R. 527.

³ *B. F. Avery & Sons v. Thos. Meikle & Co.*, *supra*, § 43.

corresponding places. They even varnished their ploughs as the genuine ploughs were varnished. They had had a consultation before they attempted the imitations above described, and determined, in the language of one of the members of their firm, "come what may, to take the bull by the horns." About their intention there was no doubt.¹ Yet, in the face of all these facts, the court below decided against the complainants. They appealed. The appellate court conceded the fact that the trade-mark proper had not been imitated in the slightest degree. The purpose of all the crafty cunning was to neutralize and in effect destroy its efficiency. Injunction and account for resulting profits. — A case in the Tribunal Civil of Bordeaux, in 1875,² is to the same effect as that of the Avery case. It was held that, where distinctive complex signs consist in the denomination, the style of package, special form and color, and particular mode of corkage, it is a fraudulent act to imitate the general aspect and principal distinctive signs, although the infringer should use a completely different denomination, the details being such as would escape the attention of the illiterate. In that case, the defendant had carefully avoided an imitation of the trade-mark proper, the fanciful name "La Benedictine"; but the court said that, in creating the receptacle for his liquor, styled by him "Saint Emilion," the author of the wrong had evidently before his eyes the genuine package. He was accordingly condemned to pay fifteen thousand francs as damages, and costs. Frequently, since the last-cited case, the French and other Continental courts, have considered the principle therein involved, and, where unfair competition has been apparent, the decisions have been parallel. In the Tribunal Civil of Lille, France, in 1883,³ the following state of facts appeared. The plaintiff, a corset-maker, had adopted and registered a label bearing his trade-mark, consisting of the initials "N. T." and a hive surrounded by bees, and also the fanciful denomination "à la Ruche." The firm of Paul Dutoict & Co., of Brussels, Belgium, had

¹ See quotation, *ante*, § 43.

² Legrand aîné *v.* Louit frères, 26 *Annales*, 75.

³ Notelle *v.* Dutoict, Marlin, & Co., and Paul Dutoict & Co., 27 *Annales*, 344.

also registered a label bearing a beehive of a yellow color on an azure ground, with the inscription, "P. D. Bruxelles, Paris." The firm of Dutoict, Martin, & Co. had obtained from P. D. & Co. a license to use the trade-mark in France on similar goods, and they had deposited it in the proper office, in their own name. The plaintiff attacked both firms, demanding that the registrations be annulled, with damages. The point in dispute was as to the defendants' right to use the emblem of a beehive, although it was dissimilar to that of the plaintiff. The plaintiff had attached so little importance to the details of the hive, that, in later registrations, he had the figure, form, and colors completely different from the first, with diverse accompanying attributes; but, despite these notable differences, it was held that the dominant and essential element remained always the same,—the emblem of the hive and the bees. The court said, in substance: Inasmuch as in the escutcheon forming the centre of the vignette of the defendants is found a hive surrounded by bees, it imports little that their escutcheon is accompanied with numerous accessories, for that which forms the object of the emblazonry, of which the surrounding attributes are but the supports, is the beehive of Notelle. That is so much so, that the corsets invested therewith are offered and sold as "Corsets à la Ruche." As to applications external to the products themselves, D., M., & Co. have employed the emblem of the hive on their letter-paper and their envelopes, and such use by a rival merchant of an emblem, the use of which properly belongs to the plaintiff, is of a nature to lead to confusion, so that the latter has a right to redress for the injury resulting to him. Notelle is the exclusive proprietor of the trade-mark, the emblem of the hive, and the denomination "à la Ruche" *together*, and *separate*, and *independent* of all *form*, *color*, and *accessories*. The mark of the defendants is an imitation. They are therefore enjoined from further use of the emblem of a hive in any form or way on products similar to those of the plaintiff, or on prospectuses or papers of correspondence.¹

¹ See *ante*, §.89 *b*, "The mere Form of a Vendible Commodity."

§ 138. *Misconceptions as to the Nature of arbitrary Symbolism.* — A few examples on this point cannot fail to be instructive. An application for registration described the thing as “a label to be used for supplementary dials, by application or transfer of the same on the crystal glasses of watches, clocks, or other timepieces.” The article was a disk of thin paper having the usual gradations, and figures indicating hours, painted on it, as ordinarily in watch-dials, so that when pasted to the inside of a watch-crystal the figures could be read from the outside in their positions.¹ *Rejected*, because, 1. not a label;² 2. because matter that enters into the structure of an article, so as to have a mechanical function, is a part of the article itself, it being a common right to use any mechanical device, unless the use is restricted by patent;³ 3. the identical thing claimed as a mere label was already covered by a mechanical patent to another.⁴ The Examiner also referred to two applications⁵ for registration of dials for calendar-clocks. *Moorman v. Hoge*, in 1871,⁶ is a leading case on this point. The plaintiffs, whiskey manufacturers, sold their product in a barrel of peculiar dimensions and form, which barrel they claimed as a trade-mark, irrespective of the brands on it. Sawyer, J., said that he had found no case where the use of a package of peculiar form and dimensions had been restrained. In *Harrington v. Libby*, in 1877,⁷ the complainant, a manufacturer of paper collars, sold his goods in small pails of ornamented tin. Held, that the form of the pail could not constitute a trade-mark. In *White v. Schlecht*, in 1880,⁸ the device of a drum to contain paper collars was used, having on the outside a representation of a drum, as indicating in the market the “drum collar.” The decision,

¹ Re George J. Carney, case No. 17,933, filed March 26, 1884.

² Ex parte Moodie, Com. Dec., Sept. 22, 1884, adopting Worcester's definition of “label.”

³ Re Gordon, Com. Dec., 1877, p. 108.

⁴ Trenor's Pat., No. 262,513, of Aug. 8, 1882.

⁵ Re Daniel J. Gale, Nos. 15,212 and 15,213, one finally rejected Dec. 8, 1882, and the other June 20, 1883, and neither appealed.

⁶ U. S. Cir. Ct. of Cal., 2 Sawyer, 78; 4 Am. L. T. 217; 6 Am. L. Rev. 865.

⁷ U. S. Cir. Ct., S. D. of N. Y., 12 Off. Gaz. 188.

⁸ 14 Phila. R. 88.

refusing an injunction against its use, was necessarily vague, for the reason that the bill was very indefinite; but at any rate, it does not controvert the doctrine of this section. The Patent Office rejected an application¹ where a barrel, constructed of light and dark staves alternately placed, for packages of flour, constituted the alleged mark; and also where the supposed mark consisted merely of straight lines intersecting one another, as a guide in cutting off any desired quantity of the article.² Many other examples of the same kind of error are referred to in other parts of this book.³ One of the wildest vagaries was manifested as to the supposed validity of a red color for illuminating-oil.⁴ The Commissioner indicated a doubt as to its possessing the essential nature of an arbitrary symbol, but concluded to let it be registered for what it was worth, for the simple reason that there was no appeal from his decision. A person having been indicted for imitating it, the court expressed a strong opinion against its being a trade mark, and the person was acquitted.⁵

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

§ 140. This question came up in the Patent Office, in 1872, in an application for a design-patent for a label with a coupon attached.⁶ The whole value of the label depended upon the peculiar configuration, and was intended to be sold to manufacturers of a certain kind of paper collar, &c. He who bought that label thereby obtained a license to sell that particu-

¹ Re Halliday Bros., 16 Off. Gaz. 500.

² Dousman & D. T. Co. v. Ruffner, 15 Off. Gaz. 559.

³ See §§ 87 *et seq.*

⁴ Re Teter, 17 MS. Com. Dec., p. 120.

⁵ U. S. v. Rider, before Giles, J., published in Baltimore American, Oct. 8, 1878.

⁶ C. C. Morgan, assignor to Union Paper Collar Co. of New York.

lar kind of goods, and at the same time he was furnished with a certificate of good workmanship. Now, what was intended to be sold? It was the label. But the label would have been incomplete without a peculiar mark. Then that peculiar mark could not be considered to be a trade-mark, strictly speaking; for a trade-mark is merely the index to something that is offered for sale. In this case, it was actually incorporated into, and became an essential component part of, the commodity. That answers the requirement of the law in relation to designs. The label was a design, — a matter of configuration of a new and useful article of manufacture; and without the peculiar mark it would have no more served its destined purpose than would a college diploma without signature. After deliberation, the matter was decided to be a design.

§ 141. In the Court of Paris, in 1859, *Lalande et al. v. Appel et al.*,¹ it was decided that tickets or labels, composed and sold by a lithographic printer, could not be considered as trade-marks. The plaintiffs, lithographers, complained that the defendants had counterfeited the designs upon tickets or labels destined to be sold to vendors of liquors and cosmetics, to be placed by them upon flasks or bottles. The defendants, as a point of law, contended that the plaintiffs had no right to recover, for the reason that the designs upon the tickets were neither designs of manufactures nor marks for the same, in the sense of the law of 1793. The reasoning of the court is perfectly convincing. Among other matters, it was held, that the plaintiffs' claim was ill-founded, because the tickets in question were the special objects of their commerce, and therefore could not be regarded as trade-marks; that the trade-mark, regulated by the law of the 25th of June, 1857, is the characteristic sign by means of which commerce distinguishes the products of fabric or objects of commerce; that the mark itself cannot be an object of commerce; that by the use which a merchant makes of a ticket, in applying it to a vase containing the product of his manufacture, it is possible that the ticket may become for him a trade-mark, — subject to the

¹ 5 Annales, 248.

fulfilment of all legal formalities, — for it may be then, as to him, a sign or distinctive seal of his products, without being the very object of his commerce: but, as to the plaintiffs, the tickets can be nothing but the special object of their industry. Judgment for defendants. On appeal, the decision was affirmed.

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

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

¹ Samuel Crump, Cert. No. 637.

² Act of March 3, 1881, sect. 5.

CHAPTER IV.

INDICATION OF ORIGIN OR OWNERSHIP.

- § 144, 145. A phrase not always understood.
 § 146, 147. "Congress Water" a sufficient indication.
 § 148. "Charter Oak" and "Balm of Thousand Flowers."
 § 149-151. Davol Mills, letter "K" case.
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 § 183. "Brooklyn White-Lead" case.
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 § 188. "Akron" case.
 § 189. "Lackawanna" case.
 § 190. "La Valentine" case.
 § 191. Examples of geographical names sustained.
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 § 194. "Angostura Bitters" case.

§ 144. *Indication of "Origin or Ownership."* — This is a phrase that has been the source of much perplexity, simply because not understood in its legal acceptation. In 1871, in the first case ever decided by the Supreme Court of the United States,¹ Mr. Justice Strong, delivering the opinion of the

¹ The Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311 ; 5 Am. L. T. 135 ; 1 Off. Gaz. 279.

court, said, *inter alia*: “The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer.”¹ But that learned jurist did not mean to intimate that the name of the producer must necessarily be an element of the mark, or even accompany it; for he qualified his language by further saying, that “a trade-mark must, either by itself or by association, point distinctively to the origin or ownership. . . . The trade-mark must, therefore, be distinctive in its original signification, pointing to the origin of the article; or it must become such by association.” The foregoing was intended as the enunciation of a settled rule. A purchaser feels assured that he is getting a genuine article, when it bears the same device, emblem, or fanciful denomination that has been borne by genuine articles of the same kind previously bought by him. The language of the Supreme Court

¹ This language is too limited in scope. A trade-mark may not only denote *origin* and *ownership*, but also indicate the *time of manufacture*, as in the case of the marks on fine porcelains of Sèvres. In 1745, a company of eight partners — under the trade-name of Charles Adam — obtained the privilege of manufacturing the said porcelains during a period of thirty years. Their establishment was located in the official building of the commission of Vincennes. In 1752, a decree of Council revoked the privilege, and decided that the pieces of the porcelains should be marked with a double L introduced in the form of a cipher. In the following year, King Louis XV. shared a third of the expenses. To give the mark a chronological value, a letter of the alphabet was added to it, which was changed every year. Changes went on until the L's were supplanted by C's under Charles X.; a different series, including LP in the form of a monogram under Louis Philippe; under the Republic of 1848 the letters RF (*République française*); and under Napoleon III. an N surmounted by the imperial crown between the words *Décoré à Sèvres*. Thus authenticity and chronology were conveniently combined. (See “Chefs-d'Œuvres of Industrial Arts,” edited by W. Chaffers, F. S. A., pp. 156 *et seq.*) Another example of a similar nature may be cited. About the year 1760, a modeller named Kandler executed the principal groups that made Saxony famous, and which are only equalled at Sèvres and Chelsea. To authenticate his productions, the manufacturer began with a monogram of the king, — *Augustus Rex*. A sort of caduceus is the mark of the first period; the crossed swords succeeded it in 1742; and when the swords are accompanied with a star or a dot, they signify extremely delicate and choice workmanship executed about the year 1780. (*Ibid.*, pp. 153, 154.) See *Ex parte the King of Saxony*, before Hall, V. C., in 1878 (1 Trade-Marks, 245). This was a case involving a right to protection of said marks, another person having applied for registration of marks resembling them.

of Connecticut, in 1868,¹ throws some light upon this point: "It may be difficult to give to bare numbers the effect of indicating origin or ownership, and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, and that they have had that effect, it may not be easy to assign a reason why they should not receive the same protection, as trade-marks, as any other symbol or device." This is an opinion that mere numerals may sometimes indicate origin or ownership of the merchandise bearing them. But it was not necessary for the court to positively decide the exact point; for the numerals were associated with the name of the plaintiffs, and the form, color, and general arrangement of the labels; and, by virtue of that connection, said the court, formed an important part of the trade-mark itself. The subject matter of this section will hereinafter be further discussed. It is sufficient for the present to quote the language of the Court of Appeals of New York in 1880, in *Godillot v. Harris et al.*:² "It is not essential to property in a trade-mark that it should indicate any particular person as the maker of the article to which it is attached."

§ 145. The difficulty is this: What does distinctively indicate such origin or ownership? This question can be intelligibly answered only after the examination and collation of many adjudications. Each case necessarily depends to a great extent upon its own peculiar surroundings. What might indicate origin in one matter might not in another. Sometimes the name of a proprietor or of a place is required clearly to convey the indication; again, any simple device may by association with a particular person or place convey all the information required. What impression does the mark of commerce leave upon the vision of the beholder? What associations are called up by the sound of a word? A purchaser usually recognizes a symbol instantly, and buys on its faith, just as one might purchase bonds of the United States upon the most superficial glance. He asks for a 10-40, a 5-20, or a

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

² 81 N. Y. 263.

7-30, and does not think of keenly scrutinizing its various indicia of genuineness. Its origin is clearly indicated. He has not the slightest suspicion that the thing a broker sells to him has been simulated. One buys a barrel of flour or a fancy toilet article with the same apparent carelessness. The true test is confidence. The brand, or the mere name of the article, satisfies him. Good faith is the bond of commerce; and, without it, doubt and hesitation will fetter enterprise and restrain trade.

§ 146. The words "Congress Water" were held by the New York Court of Appeals, in *Congress and Empire Spring Co. v. High Rock Congress Spring Co.*,¹ to appropriately indicate both the origin and the ownership of the water flowing from Congress Spring, to which place the plaintiffs had the sole title. The defendants' counsel argued that the words, as applied to a natural element, were an inexplicit name, expressing no idea of property or origin, and that the said mark lacked the essential elements, being used to designate the article itself by its proper appellation, and was therefore not the subject of exclusive appropriation; that, in fact, it expressed no more than the name of the spring, like "Avon Springs," "Lebanon Springs," "Sharon Springs," and "Cheltenham Springs," being names of particular fountains, indicative only of the place whence they issue. It was also insisted that the doctrine of trade-marks has never been applied, and is not applicable, in letter or in spirit, to the sale of spontaneous natural products of substantially the same nature, being appropriate only to artificial compounds, or products, originated by the science, skill, or diligence of man; and that this water, not being the creation of man's skill or industry, but being the gift of Nature to all, no one could bottle, and name the elements, and claim exclusively the new appellation by which they have become known in the market. It was said by counsel, that one might as well bottle the pure air of the mountain, and prevent another from selling the same air by the same name. A preliminary injunction having been dissolved at special term by Rosekranz, J., the plaintiff

¹ 57 Barb. 526; 4 Am. L. T. R. 168; R. Cox, 624.

appealed to the general term, which affirmed the action of dissolution. James, J., in rendering the opinion of the court *in banc*, said, that he was not aware that the question of the application of the law of trade-marks to names given to spontaneous or natural products had, prior to that time, ever come before the courts for adjudication; and that, in all the cases, the principle of the law is stated and restated, as applicable to protect the skill, industry, and enterprise of mechanics, manufacturers, and inventors, and hence only applicable to artificial products. He seems to have excluded from consideration the idea of commerce, which may deal in commodities with which the skilled industrial classes have nothing to do; and which, although natural products, as coal, marble, or animal deposits, like guano, have distinctive marks entitled to protection. The case went to the highest court. The true principle involved had by that time become clearly apparent.

§ 147. The Court of Appeals considered these two questions: 1. Can the owner of a peculiar product of nature be protected in the exclusive use of a name belonging to it alone, and employed by him as his trade-mark in the sale thereof? 2. Does the name or trade-mark used in the case before us by the plaintiffs indicate the origin, ownership, or place of that product, and is it one in the exclusive use of which the plaintiffs should be protected? The court, by Folger, J., said, *inter alia*, that here is a particular article of which the owners of this spring possess the only source, and which can be had only from them. The violation and the wrong are the same whether the commodity is one which the hand has made, or which Nature has put into the hand of man. Certainly so, if into the hand of but one man it has been put. It is a matter of property, and the profitable use of property. If one use the name of another for the purpose of securing to himself, in the disposition of property, advantages which belong to that other, the fraud is complete, and the remedy ought to be complete. By the application of capital, business sagacity, and enterprise, this spring and its products have become extensively known, and favorably received. When one wishes for the medicinal water which he has used before, he inquires for it by its spe-

cific name. And it is this name, the trade-mark of the plaintiffs, which is the short phrase between buyer and seller which indicates the wish to buy, and the power to sell, water from that origin, that place, of that ownership. This phrase, this device, is the trade-mark of the plaintiffs, and is of value to them, as thus designating the verity of its origin. They have the right to be protected in its exclusive use, for none other can use it with equal truth, and none other has equal right to employ it for the same purpose. *Held*, that the words "Congress Water" are, under the circumstances set forth, a valid trade-mark, indicating origin, and also ownership. The judgment below was reversed, with costs, and a new trial ordered.

§ 148. In *Falkinburg v. Lucy*, before all the justices of the Supreme Court of California, in 1868,¹ the court said that the owner of a mark would be protected in its exclusive use, but only so far as it serves to indicate the origin, or ownership, of the goods to which it is affixed, to the *exclusion* of such symbols, figures, and combinations of words as may be interblended with it, indicating the name, kind, or quality of the article. In this case, the plaintiffs claimed the entire label as their trade-mark, and asked to be protected in the use of it as a whole. The court said: "Only so much of their label as serves to indicate that they are the manufacturers or vendors of the washing-powder can be considered as constituting the legitimate characteristics of a common-law trade-mark." The symbol must tell its own story. It does not serve its intended and true purpose until associated with a certain person or article. In *Filley v. Fassett*, before the Supreme Court of Missouri, *in banc*, in 1869,² it was held that the words "Charter Oak," cast on cooking-stoves, were sufficient to point out the true source and origin of the stoves, and were therefore possessed of the requisite characteristics of a trade-mark. In *Fetridge v. Wells*, in 1857,³ Duer, J., held that the words "The Balm of Thousand Flowers" might suffice for this purpose, unless, of course, they were descriptive or fraudulent. *Boardman v. The Meriden Bri-*

¹ 35 Cal. 52.

² 44 Mo. 173.

³ 4 Abb. Pr. 144; 13 How. Pr. 385.

tannia Co., in the Supreme Court of Connecticut, in 1868,¹ fully recognizes and enunciates this doctrine.

§ 149. As an instance of the disagreement of judicial minds as to what in contemplation of law constitutes indication of origin, we will cite *Ferguson v. The Davol Mills*, in the Common Pleas of Philadelphia, in 1868.² The facts are briefly these. More than thirty years before, the complainants had devised, and ever since used for certain goods, known as silesias, or bleached and dyed cotton twillings, a certain mark, consisting of a circular label with the letter "K" in the centre, which letter is surrounded by plain lines and ornamental tracings, extending outward from the centre, and having nothing on it except the printed letters "No." at the top, and at the bottom of the same space the letters "Yds." By long use this mark had become identified with the said goods, and the goods came to be known in the markets of the world, and to the trade everywhere, by the said mark, and are known and called by the name of the "K" silesias. The defendants manufactured and offered for sale goods similar in appearance, but greatly inferior in quality to the complainants' "K" silesias, put up in wrappers similar to theirs, and a counterfeit of their label and mark. The defendants asserted that the use of the letter "K" and accompanying device, as printed by the complainants and pasted on their goods, did not constitute a trade-mark such as the law will protect. Allison, P. J., said: "The device and letter 'K,' which constitute the alleged trade-mark, have no name, words, signs, marks, by which in any possible manner or degree the origin or ownership of the silesias manufactured by the complainants are indicated, or the place of sale or manufacture pointed out, to distinguish them as the goods manufactured or sold by the complainants. And, failing in this, it follows that this application for an injunction cannot be granted. And this will justify itself when it is remembered that these circular lines and spaces, and intervening ornamental tracings, and letter 'K' in the centre, with elliptical cross lines upon its face, afford no protection to the public against imposition

¹ 85 Conn. 402.

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

by the complainants from the sale of a spurious or inferior article of silesia. They could flood the market with such inferior article, stamped with what they call their trade-mark, and the public would be wholly unable to ascertain who had manufactured and sold the goods. Protection is given only in consideration of the guaranty of the integrity of the manufacturer or merchant, certified by his trade-mark. When the device fails to accomplish this end, it is no trade-mark, and all claims founded thereon must be rejected. The simplest case of a trade-mark is the name and address of the claimant; and it is absolutely requisite that a device or symbol should perform the office of a finger-board, should indicate the name and address of the manufacturer, to invest it with the attributes, and entitle it to the protection, of a trade-mark. The device of the complainants does not contain, within itself, a declaration to the public that Ferguson Brothers are the manufacturers of the silesias stamped with their device: it points to any other person as clearly as to them, and therefore it is obvious that the Davol Mills, or Fales, Wharton, & Co., in imitating this device and placing it on an article of silesias of their own manufacture and sale, have committed no legal wrong of which Ferguson Brothers have any right to complain. The morality of the use by them of the simulated label is another question; for simulated it is, beyond all doubt, — so much like the original as to be scarcely distinguishable from it.” Injunction refused.

§ 150. This decision is *sui generis*. The course of reasoning of the learned judge does not commend itself to any calm, thoughtful intellect. With all due deference to the opinion of Judge Allison, criticism is imperatively demanded; for it is the emanation of a respectable tribunal, and cannot be silently acquiesced in, without positive injury to the cause of justice. It has been quoted in more than one case by counsel driven to desperate shifts, and has been strenuously urged as an authority. He has said that the device of concentric circles enclosing the letter “K” does not in any possible manner or degree indicate origin or ownership. Why not? Because, said he, the place of sale or manufacture is not pointed out; and he

intimated that the device, to be a valid trade-mark, should contain the name and address of the claimant. If so, how could a great number of symbols reported in adjudicated cases have been recognized as perfectly valid, when those symbols were no more expressive than that under discussion? As instances, consider the distinctive names and designations "Excelsior," "Climax," "Empire," "Charter Oak," which were deemed perfectly good trade-marks for stoves;¹ the word "Excelsior," for soap;² "Ethiopian," for stockings;³ "Cocaine," for hair-oil;⁴ and "Champion," for flour.⁵

§ 151. Not one of these cases indicated the name, or even the address, of the manufacturer, or of the merchant. Yet they fully answered the legitimate purposes of a trade-mark. The judge said that the symbol in the Davol Mills case was no protection to the public against imposition by the complainants from the sale of a spurious article; for they could flood the market with an inferior article, and the public would be wholly unable to ascertain who had manufactured the goods. Now, a trade-mark to be worth anything must be recognized by the public, and must be associated with a particular person or firm, so that the purchaser instantly says in his own mind, That is the article I wish: I know it is genuine, because it bears the well-known mark of So-and-so. What is the logical deduction of the judge? The mark is not associated in the mind with anybody, or any place. It has not the slightest intimation of origin. By looking at it, the public cannot possibly guess who made the goods, or where they were made, or who offered them for sale. It promises nothing. No faith is given to it; for it is absolutely meaningless. It is virtually a blank. Well, the public not recognizing the symbol as any man's manufacturing or commercial signature, and perceiving in it no guaranty of the integrity of the manufacturer or merchant, yet bestow upon it the most implicit confidence!

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

² *Braham v. Bustard*, 1 H. & M. 447; 9 L. T. (n. s.) 199; 11 W. R. 1061; 2 N. R. 572.

³ *Hine v. Lart*, 10 Jur. 106; 7 L. T. 41.

⁴ *Burnett v. Phalon*, 3 Keyes, 594.

⁵ *Atlantic Milling Co. v. Robinson et al.*, 20 Fed. R. 217.

Through their infatuation the market is flooded! We answer, if the public buy on the credit of the mark, that is the highest evidence of its validity. Knowing the currency of their mark, its owners strain every nerve to sustain its reputation. To send out spurious goods with its impress upon them, would be to kill the goose that lays the golden egg. We must conclude that his Honor erred. If its thirty-year-old reputation had not made the symbol valuable, it would not have been counterfeited. Yet it was simulated by the defendants, so that their false token was not distinguishable from the genuine. What essential ingredients of a lawful trade-mark did it lack? None.

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

§ 153. The *Amoskeag Manufacturing Co. v. Spear*,² before Duer, J., in the Superior Court of the City of New York, in 1849, and already discussed, is a leading case. The plaintiff averred that the letters "A C A," relied upon as a valid trade-mark, were intended to denote, "A C," Amoskeag Company, and "A," first quality. These letters were affixed to

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

² 2 Sand. S. C. 599.

a kind of cloth called "tickings," which by much care and skill, and at great expense, the plaintiff had brought to such a state of perfection, that the best quality had obtained a high reputation throughout the country. The defendants denied the allegation of the meaning of the said letters, and averred that they referred altogether to the quality of the tickings; and they denied that the plaintiff's goods were known as the "A C A tickings," without the addition of the name or place of manufacture, but that they were known as the "Amoskeag A C A tickings," in like manner as the defendants' goods were known as the "Lowell Premium A C A tickings." The answer also averred that all manufacturers of tickings used letters to denote the different qualities, and that, in every case, the name of the maker or place of manufacture was added, to enable the public to distinguish between articles of similar quality made by different manufacturers. The answer further denied that the defendants had used these letters to enable them to sell their tickings as those manufactured by the plaintiff, or that their use had produced that result; and, admitting that they had sold their goods as the genuine "A C A tickings," it was always with the designation that they were "Lowell," and not "Amoskeag," tickings. The defendants, for five years before the action was brought, had used a label corresponding with that of the plaintiff in size, color, fancy border, position, general arrangement, and size of the letters; and also containing, in large capitals, the letters "A C A." A preliminary injunction was granted, restraining the defendants, according to the prayer of the complaint, from using on their tickings any label such as that which they had used, or any label similar to the plaintiff's, or any imitation of it, or having thereon the letters "A C A." This was a motion to dissolve, or modify, the injunction, which had been granted *ex parte*, on giving security.

§ 154. The legal title of the plaintiff in the present case to the exclusive use of these significant letters, "A C A," was denied. They were said to be but an indication of the quality of goods, and were used merely as all manufacturers use letters to denote the different qualities. If so, it is clear to

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

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

§ 156. This matter came to the Patent Office in 1872, and, a *prima facie* right having been made out, (necessarily on *ex parte* testimony,) registration was allowed.¹ It finally came up in the Supreme Court of the United States, in 1879.² The court said: "It is clear from the history of the adoption of the letters 'A C A,' as narrated by the complainant, and the device within which they are used, that they were only designed to represent the highest quality of ticking which is manufactured by the complainant, and not its origin." The court further said, that as they were used to denote only quality, and that fact was so understood, they could be used

¹ No. 713, dated March 26, 1872.

² Manufacturing Co. v. Trainer, 101 U. S. 51.

by others for a similar purpose, equally with the words "superior," or "superfine," or other words or letters having a like signification.

§ 157. In *Stokes v. Landgraff*, at a special term of the Supreme Court of New York, in 1853,¹ Strong, J., clearly laid down the doctrine of the Amoskeag case. In respect to words, marks, or devices, which do not denote the goods or property or particular place of business of a person, but only the nature, kind, or quality of the articles in which he deals, no property can be acquired. There is obviously no good reason why one person should have any better right to use them than another. They may be used by many different persons at the same time, in their brands, marks, or labels on their respective goods, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article could be defrauded. The plaintiff was a manufacturer of glass, at the village of Clyde, in the town of Galen, in the county of Wayne, State of New York. His complaint alleged that he was entitled to the exclusive use of the words "Galen," "Lake," "Cylinder," "Wayne," and "New York," which had long been used by his predecessors and himself to denote the qualities of glass made at his establishment, and to distinguish the same from that made by others. A temporary injunction was granted, which the defendants applied to have vacated. The question to be determined was whether the words so used by the plaintiff were embraced by the law of trade-marks. Did they indicate origin or ownership? or merely denote quality?

§ 158. In his complaint, the plaintiff alleged that the word "Galen" was used to denote the first quality; the word "Lake," to denote the second quality; the word "Cylinder," to denote the third quality; the word "Wayne," to denote the fourth quality; and the word "New York," to denote the fifth quality of glass manufactured at his works; and that the said marks or brands had ever been, and still were, used to denote and distinguish the respective qualities above mentioned. It was also alleged that the defendants "have manu-

¹ 17 Barb 608; R. Cox, 137

factured for sale large quantities of window-glass, greatly inferior in quality and value to that manufactured by the plaintiff, and caused it to be put up in boxes or packages, and fraudulently caused the said boxes or packages to be branded or marked with the words" mentioned, "in imitation of the several brands or marks used by the plaintiff, and with intent to cause it to be believed by the purchasers, builders, and the public, that such glass was manufactured at the glass-works belonging to the plaintiff, and to enable the defendants to sell the said glass as the manufacture of the plaintiff." The answer denied that the said words were used by the plaintiff to distinguish the glass manufactured by him from that manufactured by other persons, or at other manufactories; and insisted that they were used by both parties to distinguish the several qualities of their glass. They also denied any design to divert the plaintiff's trade, and that they made an inferior article.

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

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

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

¹ 57 Barb. 526, and 4 Am. L. T. R. 168.

² "Akron" case, 49 Barb. 588.

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

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

§ 162. The case of R. W. English, appeal from the Examiner, November 2, 1870, to the Commissioner of Patents,² has been the source of error to all who cited it as an authority. The applicant offered for registration three so-called trade-marks. The first reads thus: "R. W. English's X Brooms. Buffalo, N. Y. Order English's X Brooms." The two others are precisely the same, except that in one the character X X

¹ 39 Cal. 501.

² Com. Dec. for 1870, 142.

and in the other X X X are substituted for the X in the first. "X" was alleged to be the distinguishing feature. The applicant set forth as follows: "Heretofore I have been in the habit of using 'X' to distinguish my brooms, using 'X' for one quality, 'X X' for another quality, and 'X X X' for still another quality, by printing, stamping, or affixing the same to the brooms in any convenient manner." The Examiner rejected the applications. He said: "The label filed has no new or peculiar characteristic to make it a lawful trade-mark. The letters used in printing it are of the ordinary kind, set up in a common way, and the letter X, used to express quality, is commonly used for this purpose by all liquor dealers, particularly for marking the qualities of ale." A late Commissioner, in his decision overruling the officer below, said: "The question, with reference to trade-marks, is not whether the particular mark is new in its application to goods of all kinds, but whether it is new in the special application proposed for it. In the case of this species of property a double use is permissible. The fact that a mark has been used for a bottle is no bar to its use by another for a broom, or by another for dry goods, or by another for an agricultural implement, or for hardware. One man may choose to call his knives 'X L' knives, and another his baskets 'X L' baskets. The use of this mark in no way implies that the baskets were made by the manufacturer of the knives, or *vice versa*." He therefore held that the letter X, when employed to denote a particular article of manufacture, being in no way descriptive, but a mere arbitrary character, which may, when adopted and used, indicate the origin and ownership of the goods to which it is applied, may well constitute a proper trade-mark. He further held that X X and X X X are as distinguishable from X as the latter is from Y or Z, or any other character. He also said that the use of the letter X is not an ordinary mode of indicating quality. The three cases were thereupon registered.¹

§ 163. The general legal proposition, that two men may adopt the same symbol, if to be used upon different classes of goods, requires no comment. The question is this: Did the

¹ Certificates Nos. 86, 87, and 98, Dec. 6, 1870.

letter X, under the circumstances presented, constitute a lawful trade-mark? If used merely to indicate quality, it clearly did not. This point is too well settled to be disputed. What idea is conveyed by the use of the letter X? Has it not from its long association come to be well recognized as a mere indication of quality, as much as the numerals 1, 2, 3? This is a pure question of fact. It was a bare assumption to hold the contrary, in the absence of the slightest evidence. How could any tribunal take judicial note of the fact that it was otherwise? The case before the Office was one where the applicant positively alleged that he used the letter, single, doubled, or trebled, as an indication of the respective qualities of his brooms. The allegation of the specification was conclusive. The fact was there enunciated. The Commissioner travelled out of the record. His opinion, then, as to the doctrine that the letter X does not generally indicate quality, is but an *obiter dictum*, — a wayside opinion, not binding in other cases.

§ 164. There must be some word, sign, or device, other than the generic name, and words descriptive of quality. Under this rule, the proposed trade-mark "Beeswax Oil" was refused registration.¹ The name "oil" is generic. The word "beeswax" is doubtless intended to be more or less descriptive of the quality or nature of the oil. The words "Razor Steel," as applied to the blades of knives, shears, and other cutlery, were rejected.² The word "razor" is purely descriptive, and the word "steel" a generic name, and being limited to neither person nor place, so as to indicate either origin or ownership, they cannot be regarded as constituting a legal trade-mark. "Cundurango Ointment, C. O.,"³ is not a legitimate trade-mark; "ointment" being a generic term, and "Cundurango" the name of a plant extensively known, and the initials "C. O." immaterial, and not likely to be noticed. The applicant in another case sought to register the word "Invisible," to be applied to packages of powder intended for beautifying the complexion. Mr. Commissioner

¹ Re Hauthaway & Sons, Com. Dec. 1871, p. 97.

² Re Roberts, Ibid. 113.

³ Re Blakeslee & Co., Ibid. 284.

Leggett said: "That the word 'invisible' might be used as a lawful trade-mark, I have no doubt. But when used to indicate the character of the thing to which it is attached, it becomes descriptive, and cannot be monopolized. Such, without doubt, is the application of the word 'invisible' in this case. The intention of the applicant in the use of the word evidently is to indicate that the powder, when applied to the skin, is imperceptible or invisible; hence the word is used with its ordinary signification, as in the description of shades of colors, and when so used is, by the rulings of the courts, excluded from the list of devices that may become legitimate trade-marks."¹ In the Supreme Court of California, in 1883, the following case arose.² The plaintiff below was a saloon-keeper in San Francisco, particularly engaged in the sale of beer, known as Philadelphia Beer. His shop sign consisted of a row of beer barrels, painted upon the sign and printed upon the labels so as to show the top head and outline of each barrel, with the letters "P. B.," indicating and standing for Philadelphia Beer, stamped or painted upon the head of each barrel, together with the words "Depot of the Celebrated" over, and the words "Philadelphia Lager Beer" below the row of barrels. The act of the defendant complained of was the erection by him, over his place of business, of a sign similar to that of the plaintiff, the chief difference being the insertion of the letters "F. B.," indicating and standing for "Fredericksburger Beer," in lieu of the letters "P. B.," and the insertion of the word "Fredericksburger" where the word "Philadelphia" appears on the sign and labels of the plaintiff. *Per Curiam* (substantially): The sign indicated that he sold beer; the letters and words, that he sold Philadelphia Beer. Anybody has the same right to sell. The sign and label of the plaintiff relate only to the description of the beverage dealt in by him, and therefore cannot be protected as a trade-mark.³

¹ Re Solon Palmer, Com. Dec., 1871, p. 289.

² Eggers (appellant) v. Hink (respondent), 63 Cal. 445.

³ Sect. 3196 of the Political Code (of California) defines a trade-mark: "Every description of word, letter, device, emblem, stamp, imprint, brand,

§ 165. The courts of France have made a number of decisions upon this point. In the Court of Colmar, in 1857 (*Rian v. Bernheim*¹), it was held that the denomination *toile ménage* is not a special denomination which can become the exclusive property of a manufacturer. The term had by long use become common to commerce. The Tribunal of Commerce of the Seine, in 1858 (*Thibierge v. Dupont et al.*²), for the same reason rejected the words *benzine parfumée*. The Tribunal Civil of the Seine, in 1861 (*Mauprivez v. Buchet et al.*³), had this case. The plaintiff's mint-drops were marked in relief, "Peppermint, London." The defendant, who had imitated the mark upon the same class of goods, for defence argued that the words were but an indication of the nature of the preparation, and therefore could not become private property. But the court held that the union of the two words, placed in relief, and with characteristics determined and distinct, were a particular sign to indicate to the public that they belonged to the inventor thereof. This in effect decided that, by the manner of use, these words had acquired an individuality sufficient for the destined purpose. The same parties appeared before the Court of Paris, in 1864, on appeal.⁴ *Held*: "Peppermint" is but the English appellation, but by long use in France it has become common to commerce. The simple indication of this product, in one language or the other, cannot be protected. The court plainly intimated that a particular form or disposition of letters might make it valid as a personal sign. This would virtually make it a distinctive sign of origin.

§ 166. When a chemical product takes naturally, in certain given conditions, the form of a known object, its denomination cannot become private property. The case of *Barnett v. Kübler*, in the Court of Paris, in 1866,⁵ illustrates this doctrine. Everybody knows, at least by name, the scientific toy called the "Serpent of Pharaoh." It is sold under the form

printed ticket, label, or wrapper, other than any name, word, or expression denoting any goods to be of some particular class or description."

¹ 4 *Annales*, 216.

² *Ibid.*, p. 400.

³ 7 *Id.* 335.

⁴ 10 *Id.* 320.

⁵ 12 *Id.* 144.

of a little cone covered with tin-foil. When set on fire, it acquires an extraordinary development, and, with the movements, takes the form, length, and color of a real serpent. The demandant described its mode of manufacture. He employed the *sulphocyanide of mercury*, obtained by the action of nitrate of mercury on the *sulphocyanide of potassium*. The containing box had upon it a notice of "Poison." The demandant had patented the toy, but the patent had been invalidated, as being for a worthless invention. As inventor, he had given to it the name of "Serpent of Pharaoh." It was sometimes called the "Artificial Serpent" and the "Eggs of Pharaoh." The defendant sold a similar article under the name of "Magic Serpent." An action was brought for infringement of the alleged trade-mark. Among other things, the defence set up that the toy was poisonous, and consequently contrary to law and to the public security; but on that point the court ruled, that, as the attention of the Council of Health had several times been called to the article, and nothing had been done to prohibit the sale of it, the conclusion was warranted that it presented no serious danger, and therefore was not unlawful. The next question was this: Do the words "Serpent of Pharaoh," as used, constitute a trade-mark? If yea, is the use by the defendant of the term "Magic Serpent," for a similar article, an infringement upon that mark, as a colorable imitation? In support of the claim, the counsel, M. Pataille, eminent for learning in the law of the subject, argued thus: The words "eggs" and "serpent," employed to designate the thing which was neither eggs nor a serpent, but which, upon combustion, gave a resemblance more or less removed, are clearly fancy names, belonging to him who first makes use of them. In support of that theory, he cited the decisions of the Court of Paris and the Court of Cassation in the instance of "Pearls of Ether," a title given to ether pills, which, as pharmaceutical products, belong to the public in general, and by their form and silvery envelope resemble pearls, and which words notwithstanding were held to be a trade-mark.¹ *Held*, that the term "serpent"

¹ Clertan *et al.* v. Charpentier, 10 *Annales*, 340.

does not constitute a trade-mark, it being natural and necessary to describe the article.¹ The use of the word "serpent" by the defendant is not piracy. As the case stood, it was not necessary for the court to decide that the words "Serpent of Pharaoh," being a fanciful term, constitute a valid trade-mark. The arbitrary word "Pharaoh" had not been copied.²

§ 167. Since the foregoing was decided, the following case has arisen. A claim was made to the exclusive use of the words "Cable-Twist Tobacco," as a trade-mark for plug chewing-tobacco. The applicants³ set forth that they had used said words for that purpose for about two years last past, i. e. from about the year 1870. The Examiner rejected the application, on the ground that the words "Cable Twist" are purely descriptive of the goods to which they are attached. An interlocutory appeal was thereupon taken to the Commissioner, in person, the main question being this: Are these words the proper denomination of the article of manufacture?

§ 168. Upon the argument, the counsel for the applicants produced a piece of the manufactured tobacco, and a drawing filed in the Office, in an application for a patent for their mechanical process of coiling the tobacco into the exact representation of an ocean-telegraph cable, which thing, said the counsel, had first suggested the name.⁴ The new article of manufacture consists of a strand or rope of tobacco coiled spirally about a "filler" or core, and then pressed flat, or into any other desired form. The object of the invention is alleged by the specification to be to provide a plug-tobacco in such shape, and of such arrangement, that the portion of it desired for use may be severed from it without uncoiling the remainder of the plug. After the coil is wound round the core, the bunch is placed in a mould, and reduced, by hydraulic or other pressure, to the shape of a flat plug. After this

¹ In *Selchow et al. v. Baker et al.*, in 1883, 93 N. Y. 59, the Court of Appeals of New York cited this section from the first edition, and applied its principles.

² In *Barnett v. Leuchars*, 13 L. T. (N. S.) 495; 14 W. R. 166, in England, in 1865, the name "Pharaoh's Serpents" was protected as a trade-mark.

³ Harris, Beebe, & Co.

⁴ As to the *form* of a product not being a trade-mark, see *ante*, § 89 b.

operation, a number of the plugs are placed in a tobacco-caddy and pressed; the process of filling and pressing being repeated until the caddy is full.

§ 169. It was conceded by the counsel that any article's appropriate name, which has become a part of our common language, cannot be registered or recognized as a valid trade-mark; but it was strenuously denied that the words "Cable-Twist," as here used, could be brought within the rule. It was admitted that the words "Cable," "Twist," and "Tobacco" are the common property of the public, and the words "Cable" and "Twist," when combined, are also in general use, designating as they do a kind or class of tobacco; but the counsel denied that such is the case in respect to the combination of the three words. "Cable-Twist Tobacco," it was contended, is a combination quite unknown to the public, except as the mark or symbol of a particular firm, — the kind or class being *twist*, and the word *cable* being purely fanciful. The objection that the word *cable* is descriptive seemed to the counsel to be untenable. The case was instanced of the famous smoking-tobacco put up in green drums, and sealed with green wax, and having applied to it as a trade-mark the words "Green Seal Tobacco."

§ 170. The Examiner said, that the color of the drum and wax was a mere mark or symbol of the merchandise; and as green paint or green wax cannot enter into the composition of tobacco, the color in such case cannot be deemed to be descriptive, any more than the color of wax on bottles, as illustrated in the French case of *Badoit v. André*, in the Court of Appeal of Lyons, in 1851.¹ (In that case the parties both sold the water of Saint Galmier, though each drew from a different spring. They had adopted very dissimilar exterior signs to distinguish their bottles. Badoit used a *green seal*, bearing the inscription, "Mineral Water of Saint Galmier, Badoit Spring," &c. André, who had quite another kind of designation, in 1850, without abandoning his peculiar mode of indication, all at once adopted the *green wax*. The court held that the color of the wax, as thus employed to seal bot-

¹ *Le Technologiste*, tome xiii. p. 213.

bles of mineral water, constituted a trade-mark, and a sign of good-will worthy of protection as the exclusive property of the plaintiff; and the defendant was accordingly enjoined from using for that purpose wax of the same color as that used by the plaintiff.)

§ 171. The counsel further said, *inter alia*, that one might make candy to resemble a cable, and color it, and mould it into an exact representation of the applicants' tobacco, and use the words "Cable-Twist Candy," and enjoy the exclusive right of the employment thereof for that purpose. The words would necessarily be descriptive. The public would come to know the candy as "Cable-Twist Candy." The words might in time become the appropriate name of the article; and still the sole right to use the designation would remain in him who first applied it to candy. That is, that any person might apply the term *cable-twist* to any goods, as a fancy name, and hold the same as a valid trade-mark, although the words might possibly be to some extent descriptive.

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

¹ 3 Am. L. T. R. 288, and 2 Brewst. 321.

Jamaica ginger; and his claim was allowed.¹ The name of the commodity does not constitute any essential part of that mark.

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

§ 174. The counsel then suggested that the words "Snow-Flake Starch" would be a valid trade-mark, although applied to starch manufactured to resemble snowflakes.² (*Denied*, unless the claimant of a right to the exclusive use of the words have also the exclusive right, by virtue of a patent, to make starch of the appearance of snowflakes; which is hardly a supposable case. If a person have a patent to make an article of any peculiar conformation, he may undoubtedly give it its proper descriptive name, and he would be protected therein, unless that name be generic, or broad enough to describe articles which others have an equal right to make and vend.) "Cable-Twist Tobacco," the counsel contended, "although used as a brand, is not yet properly a name, and cannot become a name until the diligence of the applicants make it such. It may doubtless pass into common use, and in time come to be a *quasi* generic term, but at present has nothing more than a fanciful significance. Perhaps every valuable [*word*] trade-mark in existence is more or less generic; and each may in the course of time take its appropriate place as a common noun, and be entered as such in the lexicons of future generations."

§ 175. The Commissioner of Patents affirmed the decision of the Examiner; and held that the words "Cable-Twist Tobacco" are descriptive, notwithstanding the transformation of the ropes or cables into rectangular blocks. He said that the words clearly indicate an article of chewing-tobacco manu-

¹ Frederick Brown, Certificate No. 715.

² In *Larrabee v. Lewis*, 67 Ga. 561; 44 Am. R. 735, in 1881, the Supreme Court of Georgia held that "Snowflake" was not a valid trade-mark for bread or crackers, because descriptive of whiteness, lightness, and purity.

factured in a peculiar manner, by twisting and coiling the plant into the form of a cable, just as hemp and other vegetables are manipulated. A cable continues to be a cable even if pressed out of shape. The idea is conveyed that the article offered for sale is tobacco, manufactured by the twisting or coiling process. No one would attach any other meaning to the term *cable-twist*, as used in connection with tobacco. It describes an article of merchandise that all manufacturers of tobacco have a right to make and sell. The applicants cannot have the monopoly of all tobacco manufactured in the form of a cable, although they have made an application for a patent for a peculiar kind of cable-shaped tobacco pressed flat. They may have the sole right to make it in one way, and somebody else may have quite as good a right to make it in another way. If others have, or may acquire, a right to manufacture any other kind of cable-twist tobacco, they have the legal right to call the thing by its right name. But if the claim of these applicants were allowable, that would not be so. They would to that extent control the use of words in common use.

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

§ 177. The Examiner, in reply, referred to a patent,¹ more than three years old, for another kind of improvement in the manufacture of chewing-tobacco. In that case, as is seen by the specification, the tobacco is spun or twisted together into one continuous "brake" or rope, and then coiled or pressed down into the keg, box, or other package, in which it is to be packed for market. The benefits claimed by the earlier patentees are the same as now set forth, — the convenience afforded to the consumer in breaking off only so much of the weed as he may need at the moment. The article manufactured under that patent is one kind of *cable-twist* tobacco. The public have a right to apply to it that descriptive name. The counsel insisted that the term was not understood by the trade to be descriptive; and asked leave to present evidence to that effect. The response of the Examiner was, that the obvious and legitimate meaning of words in common use cannot be explained away by any possible amount of testimony. The Office must judge for itself. No cause for a rehearing has been shown. Case dismissed.

§ 178. *The Name of a Man may lose all Personality*, and become a mere indication of quality. This point was decided by the Court of Cassation of France, in the case of *Stubs v. Astier et al.*, in 1865.² The plaintiff, a manufacturer in England, brought suit to restrain the use of his name upon articles of merchandise made and sold in France. Under the treaty made in 1860 between the two countries, he had a standing in court. His claim having been refused in the court below, on the ground that the name had attained a generic significance before the treaty of reciprocity had taken effect, the case was appealed to this, the court of last resort. It was contended on one side that the name of Stubs had lost its primary use, which was to indicate certain articles of hardware and cutlery as being his manufacture, and that by long user it had acquired a new attribute, and that to hold otherwise would be to take away rights that had become vested in the French people. On the other side, it was strenuously

¹ No. 85,613, to William and David Rinehart.

² 11 *Annales*, 81.

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

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

¹ 10 Annales, 197.

² 15 Id. 90.

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

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

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

¹ 3 Doug. 293.

of their owners might be in abeyance, but they could not be lost.

§ 182. *Geographical Names.*— Instances are not rare where these have been sustained as technical trade-marks. But in every case of the adoption of the name of a country, nation, region, or place, such name has been used in an arbitrary sense, and not adjectively; except where the owner of the mark was also the sole possessor of the place of origin, or had the monopoly of the vendible product, as, for example, of a mineral spring, or an established place of manufacture. Under circumstances of an exclusive right of sale, such a name cannot be said to be merely geographical. To be such, all or many others than the claimant, should have a right equal to his own to apply the name. A *merely* geographical name cannot be a trade-mark. Yet decisions are sometimes relied on to support a contrary doctrine; but if carefully scrutinized, it will be perceived that they are trade-mark matters in name only, and in reality belong to the domain of good-will. The distinction is important. The following citations illustrate the difference between cases depending for protection on principles of trade-mark law, and others depending on those appertaining to good-will. One of the latter-mentioned kind is *Newman v. Alvord*.¹ The name "Akron" was the subject of the controversy. The plaintiffs were manufacturers of cement, or water-lime, at the village of Akron, in the county of Erie, New York. The defendants were engaged in the same line of business at Syracuse, New York. The court, on appeal, held that this name, although geographical, designated the origin of the article made and dealt in by the plaintiffs, as well as the place of manufacture, and was appropriately used in these respects; for the material used by the plaintiffs was obtained and manufactured into water-lime cement at the village having that name. The doctrine that the name of a locality may be exclusively appropriated was distinctly enunciated; but it was also held that what may be claimed or used alike by all in the said place cannot be exclusively appropriated to advance the interests

¹ 49 Barb. 588; 35 How. Pr. 108; R. Cox, 404.

of one. Daniels, J., delivered the opinion of the general term. After reviewing various authorities bearing upon the question at issue, he said: "In the present case, the term selected to identify and distinguish the plaintiff's manufacture from those of a similar character placed upon the market by others, had never been previously used for any such purpose. The use of it imposed a new attribute or office upon the word, which specially adapted it to indicate and distinguish the origin and place of the plaintiffs' manufacture; and it in no way entrenched upon the previous use or purpose to which the term had been in any way devoted by others. The term was made to bear and perform an entirely new duty or office, which could result in no embarrassment, prejudice, or injury to any other person whatsoever. And from the continued use made of it in that respect, it has become an important and valuable element in promoting and securing the prosperity of the plaintiffs' business, and as such the defendants should be restrained from making a similar use of it." While, for the purposes of that controversy, the court upheld the doctrine that the name of a place does indicate origin, we must not be misled by the broad language of the court. The plaintiffs came into court with clean hands, asking redress for an attempted fraud by the misuse of the word "Akron." What did that case decide? It virtually decided that that word did not, as presented, possess all the ingredients of a lawful trade-mark, for it lacked exclusiveness of the right of user. Mr. Justice Strong, of the Supreme Court of the United States, in the case in that court¹ before cited, said that the decision in the Akron case substantially concedes that the plaintiffs, by their prior appropriation of the name of the town in connection with the words "cement" and "lime," acquired no exclusive right to its use as against any one who could use it with truth. All the inhabitants of the village of Akron had the same right to brand or label their goods with the name as had the plaintiffs; therefore it was not purely a trade-mark in its broadest sense. As against a wrong-doer who had attempted by fraudulent means to divert custom from its legiti-

¹ Delaware and Hudson Canal Co. v. Clark, 13 Wall. 311.

mate channel, it was good. The important word is the name of the place where the cement is made. The article manufactured is taken from the earth. It is a bed or quarry of lime. There is no special art or skill in making it into cement. The cement taken from different beds differs greatly in value, as in quality. The reputation of the plaintiffs' cement arises from the reputation of the bed or quarry from which it is made, — the Akron bed. They speak the truth in using the name. They tell the public by their bills, This is Akron lime. It is made from the Akron beds or quarries. The public have used it for years, and appreciate its qualities. The defendants, at a distance of one hundred and fifty miles, change the name of their quarry, and incorporate the most significant word, used by the plaintiffs for many years, and then prepare bills with this word prominent in them, and bring their article into market in competition with the plaintiffs'. It was not necessary for the purposes of the particular case under discussion for the court to decide, in so many words, that the word "Akron" was a technical trade-mark. The concluding sentence of the decision is sufficient to determine what was really decided. *Held*, that the plaintiffs' right to restrain the defendants from making use of the word "Akron," as their trade-mark, is reasonably plain, and the judgment awarding the injunction should therefore be affirmed. — In the court of last resort, — the Commission of Appeals, — in delivering the affirmance of the foregoing, Earl, Commissioner, said, *inter alia*:¹ "The question is not before us, and it is not necessary for us to determine, whether any other owners of a portion of the same quarries could not manufacture cement, and label it 'Akron Cement.' The whole question to be determined is, whether the plaintiffs, who were the only persons engaged in manufacturing and selling the real 'Akron Cement,' which is known and has a reputation in market as such, can be protected in the use of the word 'Akron' against the defendants, who used it to defraud the plaintiffs, and deceive the public." This decision does not show that "Akron" was a trade-mark; but rather

¹ 51 N. Y. (6 Sickels) 189; 10 Am. R. 588.

that the case was one of unfair competition in business.—As an illustration of the Akron principle we have a decision of the Court of Cassation, of 1880.¹ Sixteen pieces of cloth had, in 1879, been sent from Aix-la-Chapelle to the defendant, a commission merchant in Paris. The cloth of the German manufacturer had embroidered on its ends the indication “Drap de Sedan” on some of the pieces of cloth, the words “Drap de France” on others,—all marked so as to cause belief that they were made in France. All the goods were confiscated.

§ 183. In *The Brooklyn White-Lead Co. v. Masury*,² the general term of the Supreme Court of New York, in 1857, said that it is to protect a man's right of selling his own that the law of trade-marks has been introduced. It must include the right to sell to all,—to the incautious as well as to the cautious. Any false name that is assumed in imitation of a prior true name is in violation of this right, and the use of it should be restrained by injunction. The plaintiffs had been engaged for more than twenty years in the manufacture of white-lead, and had habitually marked their kegs with their name; adding the words, “Premium lead, warranted pure.” Both parties manufactured in the city of Brooklyn. As they both dealt in the same article, they had the same right to describe it as Brooklyn White-Lead; and it was shown that many other companies had used the same designation. The defendant changed his mark, and assumed one to which he had no title, in imitation of the plaintiffs', with only a colorable difference, that of “Brooklyn White-Lead and Zinc Company.” He had no such company; and that part of his new title seems to have been adopted to imitate the plaintiffs', and to make his paint pass as theirs. This was a fraud. *Held*, that the defendant should be enjoined from the use of the word “Company,” or “Co.” He may continue to use the title, “Brooklyn White-Lead and Zinc,” only omitting the word “Company.”

¹ Cunin-Gridaine and other manufacturers of Sedan v. Crocius, 25 Annales, 179. These cases came under Art. 423 of the Penal Code, against affixing to a manufacture a name other than that of fabrication.

² 25 Barb. 410.

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

¹ 10 Jur. (N. S.) 550.

² 8 Annales, 238.

³ 22 L. T. (N. S.) 260; 18 W. R. 562.

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

§ 185. This case came up on appeal before Lord Justice
James, on a motion by the defendant to dissolve the injunc-
tion.¹ Lord Justice James said: "I am of opinion that the
injunction in this case cannot be sustained. The word 'Glen-
field' is not a fancy name, like the 'Victoria,' or the 'Albert,'
or the 'Excelsior,' and various names of that kind, which
were fancy names, actually constituting a trade-mark in them-
selves; but Glenfield, although it is not a place as big as
London, Glasgow, or Paisley, and is not even a post-town, or
a market-town, or village, is a place which has an actual
existence as the site of some manufactory, is yet a place con-
taining some few houses, and is a place at which the plain-
tiff's starch was manufactured. The defendant, no doubt
moved by the great reputation which the plaintiff's 'Glen-
field Starch' had acquired, was minded to establish works at

¹ 42 L. J. Ch. 130; 23 L. T. (N. S.) 443; 18 W. R. 942.

Glenfield. That was what any one might do. Although the works of the plaintiff had been removed from Glenfield, Glenfield was not, as it seems to me, tabooed to all the world as a place or site for the manufacture of starch." The act of the defendant was legitimate; for there are two classes of buyers, said the court. One is the class who can read, and the other is the class who cannot read. They who can read cannot be misled, if the language differs. To the persons who cannot read, the packets are dissimilar, and could not deceive. — But, on appeal to the House of Lords,¹ an injunction was granted to restrain the defendant from using the word "Glenfield" in connection with his starch, notwithstanding that his own name had also been placed on his packets.

§ 186. In *Colladay v. Baird*,² 1860, the complainant alleged that he was the manufacturer of a certain style of goods known in the market as "Aramingo Check." That, in 1854, he had devised a certain trade-mark, or name, to wit, the words "Aramingo Mills," which mark became identified with the goods manufactured by him, although his name did not appear upon the label as manufacturer; and that the defendant, intending to deprive him of the exclusive use and benefit of his trade-mark, cunningly devised a label upon which the words "Aramingo Mills" appeared; and thus, by a colorable artifice, succeeded in defrauding him of a portion of his well-earned reputation and profit. It appeared that both parties manufactured their checks at the same establishment, the defendant being in fact the lessor of the complainant. The defendant asserted his perfect right to use the words. The labels were of different sizes and colors, so that the most ignorant could not fail to detect the differences in their general appearance; and the court said that there was not a colorable imitation, device, or artifice. The court refused a special injunction, leaving the complainant to maintain his title as best he could in an action at law.

§ 187. In the Tribunal Civil of Havre, in 1859 (*Levigoureux et al. v. Léon Lecompte & Co.*³), this matter came up. Both

¹ L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. (N. S.) 393.

² 4 Phila. 139.

³ 5 Annales, 279.

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

§ 188. *Newman v. Alvord*² resembles the last case. There it appeared that the complainants had been manufacturers of cement or water-lime at Akron for about thirteen years, and that they had always designated and sold their products as "Akron Cement," and "Akron Water-lime." The defendants commenced a similar business twelve years later, at a place far distant from Akron, and called their product "Onondaga Akron Cement or Water-lime." It was a fraud upon the complainants and upon the public. Consequently, an injunction was granted. The court substantially conceded that the complainants had not acquired an exclusive right to the name as against one who could use it with truth; and that, as no one had the exclusive right to the name, it was not a trade-mark.

§ 189. The question of the appropriation of the name of a region, to the exclusion of others who produce, or who sell, a similar product of the same region, may be considered as definitively settled. The case of *The Delaware and Hudson Canal Co. v. Clark*, already referred to, was well presented and argued in the Supreme Court of the United States, in 1872. The leading question was whether the complainants had an exclusive right to the use of the words

¹ 5 Annales, 216.

² 49 Barb. 588; 35 How. Pr. 108; R. Cox, 404.

“Lackawanna Coal,” as a distinctive name or trade-mark for the coal mined and sold by them. The word “Lackawanna” was not devised by the complainants. They found it a settled and known appellative of the district in which their coal deposits, and those of others, were situated. The defendant invaded no right in employing the name, for he made no false representation. All the coal taken from that region is known in trade, and rated in public statistics, as “Lackawanna coal.”

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

¹ 9 Annales, 328.

§ 191. As to the use of a geographical name as a trade-mark, Earl, Commissioner, in the "Akron" case,¹ expressed a settled rule. He said: "I can perceive no reason why it may not be the name of a place. Suppose one owns the only coal mine situated in a town, or near a city, and he names his coal after the town or city, and it becomes known as such in the market, why may not such name become his trade-mark? The same name could not be truly applied to coal obtained from any other place." — This is the principle of the "Congress Spring" case.² In that it was shown that the plaintiff had the sole title of the source of the medical waters, to the receptacles of which the name as a trade-mark was affixed. — So also of the "Bethesda" case.³ The court held that a natural product, such as mineral water, which has become private property, and is vended to the public, may be the subject of a trade-mark consisting of the name. And so, in the "Hunyadi-Janos" case, in the Court of Cassation of France, in 1883.⁴ *Held*, that, inasmuch as F. sold, under the name of a natural mineral-water of Hunyadi-Janos, an artificial water contained in bottles, he was guilty of infringement of a trade-mark. — The same principle is applicable to a place of manufacture, the exclusive right to which belongs to one who uses it as his trade-mark; as, "The Oscar Pepper Distillery";⁵ and the "Taper Pulley Sleeve Works."⁶ Plaintiffs being, by agreement with the owners of the Apollinaris Spring, in Germany, the exclusive importers into England of "Apollinaris Water," the name was repeatedly sustained as a trade-mark.⁷ — In *Radde v. Norman*,⁸ the doctrine that the name of a place of origin may become a technical trade-mark was fully recognized. The plaintiff had the exclusive

¹ *Supra*, §§ 182, 188.

² *Supra*, §§ 146, 147.

³ *Dunbar v. Glenn*, 42 Wis. 118.

⁴ *Bulletin Officiel*, No. 2, p. 26. The name of the spring was borrowed from that of a Hungarian hero, born at Hunyad in Transylvania in 1387.

⁵ *Pepper v. Labrot et al.*, 8 Fed. R. 29.

⁶ *Gray et al. v. Taper-Sleeve Pulley Works*, 16 Fed. R. 436.

⁷ *The Apollinaris Co. (Limited) v. Norrish*, 33 L. T. (N. S.) 242; also *Same v. Edwards, Seton*, 4th ed. 237; also *Same v. Moore, Cox's Man.*, case 675.

⁸ L. R. 14 Eq. Cas. 348.

right to import over seas the article found at Leopoldshall, in the Duchy of Anhalt. — Cases of the same class as those of Anatolia and Mount Carmel¹ may be cited. In *Hirst v. Denham*,² the plaintiff being a manufacturer of woollen cloths, who had invented and adopted certain new fancy patterns and named them respectively “Turin,” “Sefton,” “Leopold,” “Liverpool,” was protected in the geographical names. — The name “Dublin” was admitted to registration as a trade-mark for soap, on the ground that, the place of manufacture not being in Ireland, but in this country, the word was not used in its ordinary descriptive geographical sense, but as an arbitrary fancy designation.³ — So the word “German” was registered as a trade-mark for syrup, on the ground that, not being descriptive of a German product, it was a purely arbitrary term.⁴ — That was also the ground of decision in regard to the word “Vienna.”⁵ The plaintiff was the first who applied the word to baked bread and other articles. His business was in the city of New York. — An almanac had for many years been published at Hagerstown, in the State of Maryland; yet the Court of Appeals sustained the name “Hagerstown Almanac” as a valid mark.⁶ — Soap was manufactured at Paris; and that was held to be no reason why the name “Savon de Paris” should not be protected.⁷ — There are other names that are, in one sense, geographical, but which have been sustained as denominations of fancy. “Hoosier” is such a one. Webster’s Unabridged Dictionary defines the word to mean “a citizen of the State of Indiana.” Yet the Supreme Court of that State held it to be a valid trade-mark for an article manufactured therein.⁸ “Yankee” is a word applied to citizens of several States, in a rather indefinite way; and in a foreign country it is sometimes used to designate all the

¹ *Ante*, § 184.

² L. R. 14 Eq. 542; 41 L. J. Ch. 752; 27 L. T. (N. S.) 56.

³ *Re Cornwall & Co.* 12 Off. Gaz. 312.

⁴ *Re Green*, 8 Id. 729.

⁵ *Fleischmann v. Schuckmann*, 62 How. 92; 3 L. Bull. 91; 20 Daily Reg. No. 55.

⁶ *Robertson v. Berry*, 50 Md. 591; 33 Am. R. 328.

⁷ *Michaud et al. v. Lemenu et al.*, 23 Annales, 59.

⁸ *Julian v. The Hoosier Drill Co. et al.*, 78 Ind. 408.

people of this country.¹ It was properly decided to be a technical trade-mark. — All the cases in this section proceeded on the ground, that, when such names are used in a sense that is not *necessarily* geographical, they may, by adoption, publicity, and recognition, become arbitrary symbols.

§ 192. *When is a name merely Geographical?* — This question is sometimes of very considerable importance, and it is one that demands nice discrimination. A perusal of the case of *Armistead v. Blackwell*² (in the chapter on Interferences) will show how judicial officers disagreed as to the signification of the word "Durham." A name may be deemed merely geographical, or a denomination of fancy, according to circumstances. When used as a common or necessary name of a country, region, or place, not in the exclusive possession of the claimant of the name as an arbitrary symbol, there is no difficulty, and it must be decided to be used in a merely geographical sense. Such an instance is the "Lackawanna" case.³ This is the name of a region of country from which others besides the plaintiffs drew their supplies of coal. "Worcestershire," as applied to sauce, is governed by the same principle;⁴ and so is the "Moline" case;⁵ for that word is only indicative of the place of manufacture, and all the inhabitants of the town there manufacturing ploughs had a right to use the name. A serious aspect of the subject is when a name that was originally valid and exclusive has, without the owner's fault, been perverted and destroyed as a technical trade-mark. It is a grave question whether one can be so despoiled of property. — The case of the *Glendon Iron Co. v. Uhler et al.*, in the Supreme Court of Pennsylvania, in 1874,⁶ was as follows. The plaintiff had

¹ *Williams v. Adams*, 8 Biss. 452.

² *Infra*, §§ 653-660.

³ *Delaware and Hudson Canal Co. v. Clark*, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279.

⁴ *Lea v. Wolff*, 13 Abb. Pr. (n. s.) 389; 15 Id. 1; 46 How. Pr. 157; 1 Am. L. T. (n. s.) 400. *Lea et al. v. Deakin*, 11 Biss., and *Lea v. Millar*, Seton on Decrees, 4th ed. 242, held the term to be merely generic.

⁵ *Candee, Swan, & Co. v. Deere & Co.*, 54 Ill. 439; 5 Am. R. 125; 4 Am. L. T. 266; 10 Am. L. Reg. (n. s.) 694.

⁶ 75 Pa. St. 467; 15 Am. R. 509; 13 Am. L. Reg. (n. s.) 543; 6 Off. Gaz. 154; 1 Am. L. T. 147.

long stamped the word "Glendon" on iron, manufactured before the incorporation of the borough of that name. The defendants set up in business at the same place, and began to stamp the name "Glendon" on their iron. *Held*, that the name of a town or borough cannot be used as a trade-mark by one of its residents to the exclusion of other residents of such town or borough, even if the name were adopted prior to the act of incorporation. The adoption of the name as a geographical designation gives it a public character, which makes it the common property of the public for all legitimate purposes. Mercur, J., in delivering the opinion of the court, said, *inter alia*: "The appellees put upon their pigs the initials of their firm and the name of the town. That name was Glendon to the whole world. It cannot be that the previous appropriation by the appellants of the word, which now is the name of the town, prevents any other manufacturer of pig-iron within its limits from using the same word. If it be so now, it may continue through all coming time. The boundaries of the town may be enlarged; the borough may grow into a city; the manufactories of pig-iron may be multiplied; yet the word most expressive to indicate their locations must be denied to all but one." — Let us pause to consider and analyze. Of the correctness of the general proposition of law, there can be no cavil or doubt. Is it not, however, more than possible, that, by indefinite generalization, the learned judge has let error creep in unawares? Are his words chosen with so exquisite a precision as to leave no loophole for a sophist to creep through, to wrest and pervert the meaning? The judge said, that, by the act of incorporation, "The rights thereby given to the public become common to all citizens dwelling therein." Granted. All have a legitimate right to sell manufactures bearing their names and places of business. But that is not the point. The fallacy lies in stopping short of a full enunciation of the doctrine of equity. The first adopters of the name acquired the exclusive right to stamp it on their iron *in a peculiar manner*. Rivals have not a right to impress the mark in a manner so nearly like

it as to deceive purchasers. In the "Anatolia" case,¹ any importer of licorice had a perfect right to label his goods "Anatolia Licorice"; but he had not a right to stamp the word "Anatolia" on a stick of licorice in imitation of the stamp that gained currency for McAndrew's article. Probably Judge Mercur meant to say as much. We may reasonably infer that, from the fact found by the court. The defendants showed that they used the mark thus: "U. F. Glendon," to indicate the names of the partners. Probably the court regarded the differentiation as sufficient to avoid confusion. The latter part of the opinion runs thus: "We are unable to discover satisfactory proof that the appellees adopted their trade-mark with the design of imitating the one used by the appellants." This is the key to the true sense of the opinion.—It is obvious that the name "Raleigh" cannot be a trade-mark for tobacco, when tobacco is one of the staple products of the region of country in which the city of Raleigh is situated.² But the same name probably might be a valid mark for petroleum, or writing-paper, or some other article, the production or manufacture of which is no more associated with the place than with Sir Walter Raleigh. "French" cannot be a technical emblem for bronze paints, because deceptive.³ In the Tribunal of Commerce of the Seine, in 1883,⁴ the plaintiff claimed, as a trade-mark for biscuits, the words "Véritables Biscuits de Montbozon, Haute Saône." *Held*, that the name of a locality cannot be a valid mark.—The French Court of Cassation, in 1840,⁵ held that every manufacturer of lime, who drew his material from one of the cantons of Doué had a right to sell it under the name of "Doué" hydraulic lime. The first adopter of the designation had no exclusive right.—In 1875, there were cross suits by two rival firms of distillers at Glasgow. One firm called their establishment "The Loch Katrine Distillery," and the other named their product "Loch Katrine Whis-

¹ *Supra*, § 184.

² *Re Oliver*, 18 Off. Gaz. 923.

³ *Re J. Marsching & Co.*, 15 Id. 294.

⁴ *Longchamp v. Veuve Potin et al.*, 29 *Annales*, 157.

⁵ *Delaleu v. Grignon, Blanc*, 732.

key.” *Held*, that any one who used Loch Katrine water in the manufacture of his whiskey was at liberty to use the name.¹ Probably the foregoing cases answer the question at the head of this section.

§ 193. This question frequently comes up in the Patent Office; and the rule for answering it is well settled. If the word is not intended to be geographical, and is not taken to be such by the public, it is not such. It will have become, as an arbitrary symbol, as good an index as any other symbol could be. Thus the word “Marieland,” although intended for a mark for merchandise manufactured in Maryland, is free from objection.² The change in the spelling, and slight difference of sound, are sufficient to distinguish it from the usual and proper designation of the original *Terra Mariæ*, named for Henriette Marie, the queen of Charles I. of England. And no reasonable person would think that the use of the name “Monticello,” for whiskey, was intended to intimate that the article was distilled or sold at the home of the venerated “Sage of Monticello”;³ or that the term “Kentucky Pioneer”⁴ necessarily meant that it was made in Kentucky by the pioneer Daniel Boone; or that “Bay State” meant to imply Massachusetts.⁵ At first it was thought that the words “Vieille Montagne” were open to the objection of being a mere geographical designation, just as “Old Mountain” might be if the French were translated; but, upon reflection, it was concluded that the words could not, without straining their meaning, be taken to import that the green paint to which it was intended they should be affixed, was manufactured at a place of that name.⁶ So “Wisconsin Wood-Chopper” could not mislead any reflecting mind into supposing that the axe bearing that mark was peculiar to, or made in, any particular State.⁷ The word “Scioto” is the name of the county, as Sciotoville is the name of the town, where the applicants make fire-brick, tiles, &c.; wherefore

¹ Bulloch, Lade, & Co. v. Gray, 19 Journal of Jurisprudence, 218.

² Malcolm Crichton, No. 925.

⁴ Adams & Taylor, No. 692.

⁶ Walter & Fielding, No. 494.

³ Malcolm Crichton, No. 877.

⁵ Bay State Iron Co., No. 875.

⁷ Biddle Hardware Co., No. 923.

the Examiner rejected the application, as a geographical term, which any one in the county had a right to use. The Commissioner took another view of the matter, regarding it as an arbitrary symbol which no one else would be likely to impress on brick. Passed.¹ It is not understood upon what principle this decision in the Scioto case could possibly be sustained. It may be that it never will be brought in controversy in a judicial proceeding. If others have an equal right to use the name upon the same kind of wares, then it cannot be a trade-mark, for the essential element of exclusive right is lacking. We can understand how, if one not in a place of that name should fraudulently usurp the word as a mark, a court of equity would be called on to enjoin the wrong-doer, as in the Akron case, as an ordinary case of fraud,—not for violation of a trade-mark.²

§ 194. As an illustrative case, we will take the application for the word “Angostura,” to be used in combination with bitters. The Examiner answered the claim thus: The article called “Angostura Bitters” is well known as such, to the commercial public at least. A tincture of Angostura Bitters is officinal in the Pharmacopœia of some European countries. Ure’s Dictionary of Arts, &c. mentions the article among other bitter substances used in art and medicine, as quassia, wormwood, orange, gentian, tansy, coffee, &c. He also stated that he was credibly informed by experts, that a favorite drink called a “cocktail” is composed in part of said bitters. The principal point was whether the word “Angostura” was not a geographical name; and it was held not to be, for the reason that the word “Angostura” had first been used by Dr. Siegert, under whom the applicant claimed. It had become a fancy name; and as the claimant proved his claim to the exclusive use of it, as the denomination of an article of which he was sole vendor, it was admitted to registration.³—

¹ McConnell, Porter, & Co., No. 510. *Vide Newman v. Alvord, ubi supra.*

² The following recent authorities recognize the Akron principle: *Wheeler v. Johnston*, 3 L. R. (Ireland) Ch. D. 284; *Lochgelly Iron & Coal Co. v. Lumphinnans Iron Co.*, 6 Sess. Cas., 4th Ser. 482; *Dunnachie v. Young & Sons*, 10 Id. 874.

³ *Re W. H. Knoepfel*, Cert. No. 580.

Thus stood the matter on *ex parte* testimony two years, until 1874, when it became involved in a controversy in the Supreme Court of Trinidad. That case, however, turned on the general appearance of the wrapper bearing the name.¹ — In 1878 the same matter came up in the Chancery Division in England.² *Held*, by Fry, J., that no one was entitled to the exclusive use of the words “Angostura Bitters,” since they had become the name of an unpatented article, which any one who could discover the secret receipt might make and call by its name, although it had hitherto been made by one firm only, because they alone knew the secret. That plainly decided the name “Angostura” to be merely descriptive, and not arbitrary. Any manufacturer of bitters at Angostura could lawfully so inform the public, — *provided* he should do it in a lawful manner: just as in the Glendon case any manufacturer of iron could truthfully stamp his merchandise in a way and form that could not mislead. The manner is the indication of fair dealing. Notwithstanding Judge Fry decided the name not to be exclusive property, he granted an injunction against the use of the word “Angostura,” or the words “Angostura Bitters,” in such a way as to be calculated to deceive.

¹ *Siegert v. Ehlers*, cited 7 Ch. D. 803; 38 L. T. (N. S.) 357.

² *Siegert v. Findlater*, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (N. S.) 349; 26 W. R. 459.

CHAPTER V.

EXAMPLES OF TRADE-MARKS.

- § 195. One's own name, — to what extent protected.
- § 196. What is merely a name ?
- § 197. One's own name not an essential element.
- § 198. Allusive devices standing for names.
- § 199. Own name combined with words.
- § 200. Own name used fraudulently.
- § 201, 202. Name borrowed for purpose of fraud.
- § 203. Derivative from one's name, — when not protected.
- § 204. One's autograph a good trade-mark.
- § 205. One's name, — when common.
- § 206. One's mere name not a trade-mark.
- § 207-211. Fac-similes of autograph.
- § 212. Designation composed of simple initials.
- § 213-215. Pseudonyms.
- § 216-218. Fancy names of men.
- § 219. New words.
- § 220. Necessary name of product.
- § 220 *a.* "Singer," as designation for sewing-machine.
- § 220 *b.* Name tending to mislead, — "Trommer" case.
- § 221. Name of machine or product, — patent expired.
- § 222, 223. Word of warranty in foreign language.
- § 224. Fancy name protected.
- § 225-231. Numerals as marks.
- § 232. Numerals disguised.
- § 233. Conclusion, — mere numerals not a mark.
- § 234. Letters as marks.
- § 235. "A C A" case.
- § 236. Fancy names.
- § 237-239. "Cocaine" case.
- § 240. Discrimination as to fancy names.
- § 241-244. "Balm of Thousand Flowers" case.
- § 245. "The Excelsior White Soft Soap" case.
- § 246-248. Mere descriptive names not valid marks.
- § 249. Descriptive names, — distinguished.
- § 250. Suggestive marks may be valid.
- § 251. "Chemical Paint" case discussed.
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- § 253. Name of object of merchandise.
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- § 255-259. A picture as a trade-mark.
 § 260. Trade-marks frequently borrowed from heraldry.
 § 261. National arms may sometimes be element in mark.
 § 262. Monograms and ciphers, as authenticating marks.
 § 263. Is color ever essential element?
 § 264. Disadvantage of reliance on color.
 § 265, 266. Color may be essential.
 § 267. Color, — a circumstance in infringement.
 § 268. Colored threads as trade-marks.
 § 269, 270. Form is implied by the term *Mark*.
 § 271, 272. "Payson's Indelible Ink" case.
 § 273-275. Examples, — words as trade-marks.
 § 276, 277. *Rejected*, — as indicative of quality.

§ 195. *One's own Name.* — To what extent will a person's name be protected as a trade-mark for himself? This question has its difficulty. The act of Congress of July 8, 1870, sect. 79,¹ prohibited the registration of a proposed trade-mark "which is merely the name of a person, firm, or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons." That meant only the name of the person, &c., applying for registration. The act of Congress of March 3, 1881, sect. 3,² uses the words "merely the name of the applicant." But the former act provided that that should "not prevent the registry of any lawful trade-mark rightfully used" at the time of the passage thereof. The act of August 5, 1882, contains substantially the same provision. The proviso opens the door to evidence that such name had previously become a "lawful trade-mark." It all depends on the full import of the words "merely" and "rightfully." We must be guided by judicial decisions. One case might be sustained and another not. Circumstances control the result.

§ 196. What is merely a name? An investigation that can enable this question to be intelligently answered should not be thought pedantic or far-fetched. It has been well settled that a middle name or an initial letter is not part of a person's name. The law knows of but one Christian name.³ The addition of "senior," or "junior," is a mere matter of

¹ Rev. Stat., sects. 4937-4947.

² Supplement to Rev. Stat., vol. i. chap. 138.

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

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

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

² See Matter of Snook, 2 Hilton, 566. — In 1878, in *England v. The New York Publishing Co.*, 8 Daly, 375, the court reaffirmed the principle of the Snook case, "nothing in the law prohibiting a man to take another name if he desire to do so, . . . no consequence growing out of it, except so far as it might lead to the confounding of his own identity." So held also in *Doe v. Yates*, 4 Barn. & Ald. 544, where one changed his name by his voluntary act, in order to take an estate devised to him on that condition. — "There is no law to prevent a man assuming any name he likes." James, L. J., in *Thorley's Cattle-Food Co. v. Massam*, 42 L. T. R. (n. s.) 851; 14 Ch. D. 748.

³ Trench, Study of Words.

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

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

another place, the name may have been translated. The use of the Latin language in the Middle Ages led to the frequent translation of names; and in the seventeenth century the English poet, Payne Fisher, turned his into *Paganus Piscator*. The French was also changed into English equivalents, having at times similar sounds, with the slightest reference to the original signification. Who, for instance, now associates the well-known Mortimer with the forgotten exploit of an ancestor in the Crusades, — a “De Mortuo Mari” with the Dead Sea?

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

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

§ 200. Here is a case which shows how a man may, by the use of his true name, attempt to conceal a fraudulent conception. In the Tribunal Civil of the Seine, in 1863,² Eugène Bernard sued the Emonds, father and son. The plaintiff, a French armorer established at Liège, in Belgium, had registered his trade-mark in France, under a treaty made in 1861. The mark was, “E. Bernard, Canonnier de Paris,” with his initials, “E. B.,” which he stamped upon the arms. The defendants had imitated that mark on the same class of mer-

¹ 44 L. J. R. 252.

² 10 Annales, 375.

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

§ 201. In *Curtis v. Bryan*,¹ before the general term of the Court of Common Pleas of the City of New York, in 1868, the following facts appeared. Previous to the year 1844, Mrs. Charlotte N. Winslow prepared a composition for children teething, which she used with success. In 1844, she gave the recipe to her son-in-law, Jeremiah Curtis, one of the plaintiffs, who continued to manufacture and sell it under the name of "Mrs. Winslow's Soothing Syrup"; and, with the approval of Mrs. Winslow, he made that his trade-mark. The defendant, in 1867, began the manufacture of a preparation, in color and appearance resembling that of the plaintiffs, under the name of "Mrs. H. M. Winslow's Soothing Syrup," and with a label of the same size, color, and style as that of the plaintiffs. The imitation was close in other respects, and was evidently intended to mislead the public. To justify the use by him of the name of "Winslow," the defendant claimed that a variety of soothing syrups had been made and sold by John M. Winslow, a certain druggist; that he had purchased the formula of his remedy from said Winslow, who had invented it as early as 1842. The court held the claim of the defendant to be fraudulent, and the injunction granted was sustained, with costs. We must remember that this was a case of fraud, in a court of equity. The right of the plaintiffs to this remedy did not depend upon the fact that the words mentioned con-

¹ 2 Daly, 212, and 36 How. Pr. 33; R. Cox, 434.

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

¹ 50 Barb. 236; R. Cox, 421.

of either of these licensees to adopt and appropriate a trade-mark, even as against Elias Howe, Jr., as a manufacturer of sewing-machines." The judge cited *Sykes v. Sykes*,¹ where the manufacture simulated was shot-belts and powder-flasks, stamped "Sykes' Patent"; and also *Croft v. Day*,² which is as follows. A blacking manufactory had long been carried on under the firm of Day & Martin, at 97 High Holborn. The executors of the survivor continued the business under the same name. A person of the name of Day, having obtained the authority of one Martin to use his name, set up the same trade at 90½ Holborn Hill, and sold the blacking as of the manufacture of Day & Martin, 90½ Holborn Hill, in bottles and with labels having a general resemblance to those of the original firm. He was restrained.

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

¹ 3 Barn. & Cres. 541; 5 D. & R. 292; 3 L. J. K. B. 46.

² 7 Beav. 84.

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

§ 204. *One's Autograph* is good for this purpose. It is the emblem or symbol of himself. It is not merely his name. If another of the same name have the same signature for the same purpose, the coincidence may be embarrassing, and raise a question of fact for a jury to weigh and settle. The similarity may be fortuitous, and without fraudulent intent. Unless a man can invent a peculiar flourish, or other characteristic sign-manual, he had better adopt something else with it.² The same may be said of the name of a firm, or of a corporation. "Doe & Roe," or "The Smith Manufacturing Company," might possibly lead to a confusion of persons; for the public cannot be assumed to know which firm or corporation shall have affixed its name to merchandise. This is a general rule; but it has its exceptions in all countries, and even the act of Congress before cited³ provides for exceptional cases.

§ 205. In *Ainsworth v. Walmesley*,⁴ in 1865, Vice-Chancellor Wood ably discussed this question. He said that if Mr. Jones,

¹ 19 Pick. 214.

² By the use of a *paraphe*, such as is in vogue in France, Spain, and many other countries, a signature might easily be made so peculiar and distinctive as to arrest attention.

³ *Ante*, § 195.

⁴ 44 L. J. R. 252; L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. (n. s.) 205; 14 L. T. (n. s.) 220; 14 W. R. 363.

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

§ 206. The rule is, that a man cannot turn his mere name into a trade-mark. Any other rule would lead to most absurd consequences. There are several *dicta* the other way; but they must be attributed to a loose habit of speech, or a want of acquaintance with the indispensable requisites of the technical mark. No wise man in these days would for an instant rely upon such an insecure tenure of title. If one man's name may be a trade-mark, so may any other man's name be also. John Smith is a man's name: therefore John Smith is a valid trade-mark. That would be absurd.¹

§ 207. *Fac-simile of Autograph.* — This is just as valid for

¹ Cited and approved in *Meneely v. Meneely*, 1 Hun (N. Y. Sup. Ct.), 663.

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

§ 208. In these cases, there could be no question as to the apparent right of the several claimants to make those copies essential elements of trade-marks; for they clearly deduced their titles from their ancestors or predecessors in business, and have such distinct labels and notices as cannot fail to enlighten the public as to their true position. But there have been instances of applications for copies of autographs which seemed to have been adopted for the sole design of deceiving the public into the belief that the original manufacturer still continued in business, and that the article to which the fac-simile was to be attached was made by him. Superior excellence must have been attributed to such original manufacturer; and the purchaser must base a preference upon the fact of the thing being the fabric of the inventor, the compounder, or why would his name be used? It is done to gain credit. The article would not command a market without that peculiar mark. Fraud may lurk in such a case. Therefore, when a fac-simile of an autograph is offered for regis-

¹ Cochran Fleming, No. 756.

² Fred. Brown, No. 715.

³ Arthur Gillender & Co., No. 767.

tration, unless accompanied by indubitable evidence of good faith, or under circumstances which create the presumption of a rightful use, the claim will be rejected, lest a false credit be thereby tolerated.

§ 209. The case of *Compère v. Bajou et al.*,¹ decided in the Tribunal of Commerce of Paris, in 1854, and affirmed on appeal, is one that is apt to stagger the judgment of a student. It appeared that the defendant, Bajou, had assigned his business as a glove-maker, and the good-will thereto attached. The assignee was authorized by Bajou to adopt, exclusively of every other person, the description of successor to Bajou, and to use, as the mark for his gloves, the stamp employed by him as the manufacturer's mark, being the fac-simile of his signature. It was also agreed that Bajou should not have the right to establish, to purchase, or to be a partner in any manufacture of this nature, either at Paris, or any other town in France with the exception of Grenoble; and, moreover, that he might in Grenoble deal only in gloves called "Grenoble manufacture," and marked with the stamp of that town. Bajou disregarded his agreement, and stamped a certain quantity of gloves with his manufacturer's mark, the fac-simile of his signature. He sent the gloves thus marked to New York. The tribunal said that the manufacturer's mark for this species of industry—the mark being advantageously known—is an indispensable auxiliary for insuring a sale, more especially in America; and that, besides, it is not the custom at Grenoble to mark with one's name the gloves manufactured there. It was also held, that, in assigning for a certain sum his good-will, Bajou really assigned all his right to the manufacturer's mark, in which the true value of the business consisted, since it was upon the mark that the custom depended. Further, that it was in vain for Bajou to pretend that he had the right to apply to his new manufacture the manufacturer's mark which he had assigned; for that would be not only to seek to resume that which he had assigned, and of which he had received the price, but also to endeavor to apply for his own benefit the increased custom of the

¹ Copied in full in Upton, p. 73.

assignee. He was, therefore, prohibited from employing in the future his name as a manufacturer's mark upon his gloves, and heavily fined.

§ 210. To the casual observer, this might seem like an authority to commit a fraud upon the public, and upon purchasers in foreign countries, by the means of a misrepresentation, to wit, that Bajou himself had made the gloves. That was not the meaning of the judgment of the tribunal of first instance, nor of the Imperial Court of Appeals of Paris, which affirmed the decision. The latter held that the exclusive title to the mark had passed to the assignee, the right to the use of the stamp till then employed by Bajou being one of the essential ingredients of the contract; that the stamp, being the only means of establishing the source of the goods, and of retaining the custom depending on it, had become, by force of circumstances, an accessory of the good-will transferred; and that the arrangements adopted by Bajou, to make known abroad that he had recommenced trade, had no other object than to take from the actual owners of the business a part of the benefits insured to them. This was as much as to say that the case is essentially one of good-will, and that the mark is an incident to it. It is a matter of unlawful competition in trade. It did not mean that the *mere* fac-simile of Bajou's signature could be used by the assignee; for that were to encourage fraud. The law of France is opposed to any such idea. The rule of commercial morality is far more stringent there than in many other countries. The twenty-first article of the Code of Commerce is, that "the name of the associates can alone constitute the firm name" (*la raison sociale*). This is intended to forbid persons who succeed to the business of another from continuing it under his name. Credit is altogether personal.¹ What, then, did the court mean?

§ 211. If we look back, we shall see that Bajou authorized his assignee to adopt, exclusively of every other person, the description of *successor*. The law of France requires the words "successor of" to appear in such case. The public

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

could not be misled, and the assignee of the mark would thereby be enabled to secure custom, as the successor of a reputable manufacturer; as the one who had availed himself of all the appliances and means of attaining excellence that the other had possessed.

§ 212. A designation may become a lawful trade-mark, although originally composed of simple initials. It may be accepted in commerce as indicating a name other than that of the manufacturer who claims it. It thus virtually becomes a pseudonym, or, more properly speaking, a fancy symbol. In the Tribunal of Commerce of the Seine, in 1857, came up the following case. Jean Bardou, the plaintiff, a manufacturer of cigarette-paper, had been in the habit of marking his products with his initials, "J. B.," separated by a lozenge, so that the mark seemed to be composed of the word "JOB." The public soon became accustomed to the mark, but, mistaking its component parts, asked for "Job" paper. Lassausée, the defendant, who was engaged in the same kind of business, took an associate named Job, and without hesitation took also the mark "JOB." His defence to the suit was, that he had a perfect right to use the genuine name of his partner. The court scouted so shallow a pretence, and punished him severely.¹

§ 213. *Pseudonyms.* — During the Middle Ages it was rather the rule for an author not to publish under his real name, either from prudential motives or because of excessive modesty. When all serious works were written in Latin, Teutonic, and even Gallic, names had an awkward appearance among Ciceronian adjectives. They were therefore softened by Latinizing or Hellenizing them. When the name was significant, it might be literally translated. The great reformer of Germany, Philip Schwartzerd, not admiring an uncouth cognomen, signifying black earth, changed it into the mellifluous Greek; and it has come floating down to us through three centuries as Melanchthon. England has furnished another conspicuous example in her "Nominis Umbra," as Byron calls him.² We need be at no loss for instances of feigned names

¹ 3 Annales, 125.

² Junius.

among authors of our own century. Mr. Herbert takes as his *nom de plume* "Frank Forrester," Mrs. Judson took "Fanny Forrester," Dr. Holland figures as "Timothy Titcomb," Miss Dodge as "Gail Hamilton"; and many similar cases are as familiar as household words. In England, a writer whose initials are H. N. B. recently put forth a novel purporting to have been written by "Mr. Aitchenbee."¹ All such names would be protected as lawful proprietary marks. In 1838, Felix Tournachon took the pseudonym of "Nadar," which he affixed to all his productions, as an artistic and literary mark of the fruit of his toils. It was held by the Court of Paris, in *Tournachon v. Tournachon*,² that this feigned name was a valid trade-mark; and that decision was affirmed by the highest court. So, in the Tribunal of Commerce of the Seine, in 1867, in the case of *Gravelet (dit Blondin) v. Arnault*,³ it was decided that a pseudonym can become property in him who has given celebrity to it, and as well in the arts as in mechanical industries. *Per Curiam*: Gravelet took, many years ago, the pseudonym of Blondin, under which he is generally known, and in various countries as an acrobat had gained a notoriety for his name. With the object of competi-

¹ Pen-names may be divided into three classes: First, *pseudonyms*, as "George Eliot" (Mrs. Cross), "Georges Sand" (Madame Dudevant), "Christopher Crowfield" (Harriet Beecher Stowe), "Fernan Caballero" (Doña Felicia Arrom, the Spanish novelist), "Arthur Dudley" (Countess of Bury), "Howard Glyndon" (Laura C. R. Searing), "Peter Parley" (Samuel G. Goodrich), "Peter Plymley" (Sydney Smith), "Mark Twain" (Samuel L. Clemens), "Acton Bell," "Curren Bell," and "Ellis Bell" (three Brontë sisters), "Hosea Biglow" (James R. Lowell, for his political satires), "Boz" (Charles Dickens), "Sam Slick" (Judge Haliburton), "Jack Downing" (Seba Smith), "U. Donough Outis" (Richard Grant White). There are *anagrammatic pseudonyms*, as "Alcofribus Nasier" (François Rabelais, the French satirist), "Barry Cornwall, poet" (good though imperfect anagrammatic pseudonym of Bryan Waller Procter), "Benauly" (the trio, Benjamin, Austin, and Lyman Abbott, who once wrote in a sort of literary partnership). Second, *anonyms*, as "By a Layman," "L. E. L." (Letitia Elizabeth Landon), "A L O E" (a lady of England, Miss Charlotte Tucker). Third, *acrostics*, as "Talvi" (Therese Albertina Louise von Jakob), "E. D. E. N." (Emma D. E. Nevitte, Mrs. Southworth).

It was in the days of Cosmo de' Medici that a goldsmith of Florence, named Tomaso Bigordo, accepted as his definite title the nickname of "Ghirlandajo," — maker of garlands, — to which nickname he owed his subsequent success.

² 4 *Annales*, 83.

³ 13 *Annales*, 303.

tion, Arnault, director of the Hippodrome, announced a spectacle in which should appear an acrobat to whom he gave the name of Blondin, and announced him as the veritable Blondin. *Held*, to be an infringement. Enjoined. Damages, 500 francs. Publication in the newspapers at defendant's expense.

§ 214. There have been instances in the Patent Office of persons using sobriquets of themselves for trade-marks. One person, a manufacturer of clothing, uses the term "Little Jake," and has had it registered.¹ It is not very doubtful that the political editor known as "Brick Pomeroy" could claim the exclusive right to that classical title; for there is but one person in creation who could be meant thereby.

§ 215. In the reign of Chin-tsong in China, in the sixteenth century, lived a celebrated artist of the name of Ou, who withdrew from the world. He produced, in secret, porcelain remarkable alike for its quality and the beauty of its colors. Under the foot of his vases he engraved in the paste his peculiar mark, that by which his workmanship was identified. The translation of it is, "The old man Ou, who lives in solitude."² Whether regarded as a mere denomination of fancy, as a pseudonym, or as his genuine signature, this mark denoted origin and ownership, and carried with it a guaranty of excellence.

§ 216. *Fancy Names of Men.* — We have many instances of such names becoming valid trade-marks. In the case of *Barrows v. Knight*,³ in the Supreme Court of Rhode Island, before all the justices, it was *held*, that "Roger Williams," though the name of a famous person, long since dead, is, as applied to cotton cloth, a fancy name, as would be, so applied, the name of Washington, Greene, Perry, or any other hero, living or dead. Said Ames, C. J., in delivering the opinion of the court: "It is quite as peculiar and significant, in such an application, as Persian Thread, Mexican Balm for Hair, Vegetable Pain-Killer, Houqua's Mixture, for tea, or Ethiopian, for

¹ Jacob Seligman, No. 828. See *Grow v. Seligman*, 47 Mich. 607.

² Marryat's Pottery and Porcelain. London, 1857.

³ 6 R. I. 484; R. Cox, 238.

stockings, or the numerous other fanciful names which have been treated as appropriate trade-marks." In *Messerole v. Tynberg*,¹ the plaintiffs claimed an exclusive right to use the word "Bismarck," in its application to paper collars. The court held, that the plaintiffs had the right to appropriate said name, in common with others, for a new purpose; and, having done so, are entitled to avail themselves of all the advantages of their superior diligence and industry. In the Court of Paris (*Dalbanne & Petit v. Coleuille & Co.*²), where both parties used the name "Lamartine" for a certain elixir, the court said, on appeal: There is no doubt that proper names, other than those of the manufacturer, can be employed like any other sign, as a distinct mark of industrial products, and thus become veritable property, not as a title or mode of appellation, but as a commercial mark. In the case of *Wedgwood et al. v. Smith et al.*, before the Vice-Chancellor of England, in the year 1848, the defendants were restrained from using the name of "Wedgwood," or "Wedgewood," on their wares, it having been shown that the name "Wedgwood" had been used as a trade-mark by the family of the Wedgwoods for centuries.³ The Court of Paris, in 1867 (case of *Sargent v. Romeu*⁴), sustained the right of the plaintiff to the words "Royal Victoria."

§ 217. The applicant, at times, by an addition to his patronymic, or a variation thereof, makes a convenient and peculiar mark. Thus the terms "Mayoline,"⁵ "Edgerline,"⁶ and "Rosebaume,"⁷ have come into existence. Although perhaps suggestive of the names of their appropriators, they are sufficiently distinctive to serve their true purpose.

§ 218. Again, the name of some defunct person, or of some one whose creation sprang from the brain of the poet or novelist, is found to be serviceable. If understood by the public to be nothing more than a mere fancy designation,—one which has lost its original character and become an un-

¹ 4 Abb. Pr. (N. S.) 410; 36 How. Pr. 14.

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

⁵ U. K. Mayo, No. 904.

⁶ H. B. Edgerley, No. 610.

² 7 Annales, 414.

⁴ 13 Annales, 21.

⁷ J. Rose, No. 807.

meaning symbol, — then it may be entitled to recognition as the veritable mark of commerce. When we see “Dolly Varden”¹ upon fancy paper, we do not think of the charming daughter of the London locksmith, Gabriel Varden by name, as portrayed by Charles Dickens, but we associate the name Dolly Varden with a certain manufacture of goods. Thus, in or about the year 1871, the public recognized what were then known as “Cretonnes” as the make of a certain inspired *modiste*, who had the name transformed into a mark. Chintzes, and other dry goods, now bear the title; and for each class of merchandise it is a mark that the law will protect, and secure the exclusive use of it to the first adopter thereof. “Paul Jones,” the name of a somewhat famous naval hero in the early history of our nation, has been impressed into the service as a brand for whiskey.² So has the traditional “Young America”³ been placed upon writing-ink for the use of the scions symbolized by that appellation. “Apollo”⁴ indicates a certain species of gin; “Rip Van Winkle,”⁵ a brand of whiskey; “Falstaff,”⁶ “Gulliver,”⁷ “Uncle Bob Lee,”⁸ “Our Fritz,”⁹ “Brown Dick,”¹⁰ “Lone Jack,”¹¹ and “Phil Sheridan”¹² authenticate particular manufactures of cigars, or of chewing or smoking tobacco.

§ 219. *New Words.* — The coiner of a new word, employed by him to designate an article made or on sale by him, may obtain such a right to that name as to entitle him to the sole use of it, as against any others who attempt to use it for the sale of a similar article. The Court of Appeals of New York said:¹³ “Our conclusion is, that where a man has invented a new name, consisting either of a new word or a word in common use, which he has applied for the first time to his own

¹ Bergen & Bainbridge, No. 833.

² Walsh, Brooks, & Kellogg, No. 702.

³ Adams & Fay, No. 912.

⁵ A. W. Balch & Co., No. 601.

⁷ David Hirsch, No. 24.

⁹ J. W. Carroll, No. 156.

¹¹ J. W. Carroll, No. 158.

¹³ Selchow *et al.* v. Baker *et al.*, 93 N. Y. 59.

⁴ Gill & Lootz, No. 531.

⁶ David Hirsch, No. 23.

⁸ Winfree & Lyon, No. 402.

¹⁰ J. W. Carroll, No. 157.

¹² Smith, Crosby, & Co., No. 244.

manufacture, or to an article manufactured for him, to distinguish it from those manufactured and sold by others, and the name thus adopted is not generic or descriptive of the article, its quality, ingredients, or characteristics, but is arbitrary, or fanciful, and is not used merely to denote grade or quality, he is entitled to be protected in the use of the name, notwithstanding that it has become so generally known that it has been adopted by the public as the ordinary appellation of the article." Of course the court did not mean to limit the use to an article of *manufacture*. The introducer of a word, or words, into the language may, by a parity of reasoning, acquire the same right on the same terms. He is virtually a coiner of a word who first applies it, as an arbitrary symbol, to express the origin of the article of merchandise to which it is affixed. Thus, the Greek word "Eureka" has been judicially recognized as possessing all the essential characteristics of a trade-mark.¹ — "Tod," in Arabic characters, was held to be a valid mark in England.² — The Latin "Ne Plus Ultra"³ was held not to be a trade-mark, solely because proved to be common to the trade; and the Latin word "Excelsior" was held to be arbitrary, and therefore valid.⁴ — The highest court in France (Cassation), in 1873,⁵ held that even the translation into a foreign language of a term already *publici juris* in France should be upheld as a valid trade-mark. It was contended for the infringer, that the Spanish words "Agua divina" could not be regarded as constituting an arbitrary symbol, for the reason that they were only a translation of the French words "Eau divine," long before fallen into the public domain, and commonly used in trade. The court said that it was an exception to the general rule, as the foreign words had not before been usually employed, and had not, in any respect, fallen into the public domain. — In the Court of Paris, in 1874,⁶ the foreign word "Paragon" was sustained

¹ Ford *v.* Foster, L. R. 17 Ch. App. 611; English Reports (Moak's notes), vol. iii. p. 538; also The Alleghany Fertilizer Co. *v.* Woodside, 1 Hughes, 115.

² Re Rotherham's trade-mark, 14 Ch. D. 585.

³ Beard *v.* Turner, 13 L. T. (N. S.) 746.

⁴ *Infra*, § 245.

⁵ Coudray *v.* Monpelas, 19 Annales, 31.

⁶ Fox *v.* Meurgey *et al.*, Ibid. 327.

as a trade-mark. — The Tribunal of Commerce of the Seine, in 1878,¹ in the analogous case of a shop sign, sustained a foreign name, “Bodega,” which is only the Spanish for *boutique*, shop. We need not strain a point to inquire as to the possible coincidence of a supposed neologism with a word or term used in some language other than our own. Is it new in its *present* application?

§ 220. *The Necessary Name of a Product.* — Such a name is not the subject of exclusive appropriation. This may be regarded as the settled law of commerce, everywhere. It is necessarily so. While it is true that one may coin and adopt a word intending it to serve as a trade-mark, and a means of attesting the genuineness of manufacture, he must beware of making it the indispensable designation of the same. Among the many illustrative examples, a few may here be cited, viz.: “Chlordine”;² “Charbon de Paris”;³ “Linoleum”;⁴ “Charter Oak”;⁵ “Lucilene.”⁶ All these were made necessary descriptive names. But in opposition to the *necessary* designation, the *arbitrary* designation is that which springs from neither the nature nor kind of object designated, so that a product or establishment might be as well recognized under another name.⁷ One of the oldest examples in France is that of “l’Encre de la petite vertu,” in the Royal Court of Paris, in 1835.⁸ The word *encre* is a necessary description; for it must be used readily to express the object, ink, and all may freely use that name. But the accompanying words are an accessory of fancy, which none but the first appropriator may employ. — A leading American case is that of *Caswell v. Davis*, in the Court of Appeals of New York.⁹ The alleged trade-mark consisted of the name affixed by the plaintiffs to the medi-

¹ *Lavery & Co. v. Fajardo*, 24 *Annales*, 71.

² *Browne v. Freeman*, W. N. 1873, p. 178.

³ *Brousse, Perdonnet, & Co.*, 20 *Annales*, 91.

⁴ *Linoleum Manufacturing Co. v. Nairn*, 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. (N. S.) 448; 26 W. R. 463; 1 *Trade Marks*, 291.

⁵ *Ubi supra*.

⁶ See § 252.

⁷ *Blanc sur Contrefaçon*, 70.

⁸ *Larénaudière v. Perine-Guyot*, *Ibid.*

⁹ 58 N. Y. 223; 17 Am. R. 233.

cine, which was first compounded by them in 1861, — “Ferro-phosphorated Elixir of Calisaya Bark.” They based their claim on priority of adoption. The plaintiffs did not seek to enjoin the defendant from manufacturing and selling his compound, or any other mixture composed of any elements; but insisted that he should not sell it with a label bearing upon it the name above given. There was some evidence tending to show that similar preparations, in some of the essential elements, had been made and were in use before the plaintiffs experimented on or produced their article; but it was not established that any mixture composed of all the ingredients used by the plaintiffs, or having a name in all respects similar to that adopted and applied by them, was in use or known to the public before the plaintiffs introduced their medicine. The Elixir of Calisaya, or Peruvian Bark, was in use, and perhaps in solution with iron in some form. But this case shows that this composition, with its peculiar and specific substances, was first introduced by the plaintiffs under its peculiar name, “Ferro-phosphorated Elixir of Calisaya Bark,” and that they first applied the specific word “ferro-phosphorated” to any medicine. The article compounded by the plaintiffs, as a whole, was original with them. In the condition in which it was presented to the public it was new. As it was a recent composition, it would, of necessity, require a characteristic name, if its elements were to be indicated in its appellation. Compounded of substances known principally in chemistry, which science has a nomenclature peculiar to itself, the words to distinguish it would be in a language familiar to chemists, and that limited class of persons who deal in drugs and chemicals. It is true that the meaning of the words, singly, which mark the compound in question, is known to a large class of persons other than those designated; but, so far as the word “ferro-phosphorated” is concerned, it cannot be said that it is in common or general use, or that it is even understood by the great number of persons who take the remedy, on the advice of physicians, as indicating the true nature and character of the mixture. They may, and doubtless do, in most cases, understand that the medicine prescribed

contains Peruvian bark and iron; but as they read the label on the bottle they do not learn from it what the article really is, although its elements generally are indicated by the words used. They are not like words in common use, in any true sense, — words which carry to the mind of all classes of persons, the instant the eye lights on them, the true character of the contents of the package upon which they are placed. All understand what mean the words “tobacco,” “gin,” “brandy,” “cotton yarn”; but the words “Ferro-phosphorated Elixir of Calisaya Bark” would be unintelligible to most persons. Such is nearly the precise language of Van Vorst, J., in the court below.¹ In discussing the novelty of the term employed by the plaintiffs, he further said: “‘Ferrum,’ of which ‘ferro’ is a form, is a common word in the Latin; and ‘phosphorated’ is recognized by Webster as an English word. But I am of the opinion that no such word as ‘ferro’ and ‘phosphorated’ in combination is to be found in any language, except the forming of it by the plaintiffs has had the effect to introduce it; and if so, plaintiffs are entitled to the credit and use of it. The combined word, I am satisfied, is philologically incorrect. I do not suggest that the word is meaningless, or that its elements do not indicate in a general way some of the ingredients of the preparation; but it does not do so chemically, or in an exact sense, and was doubtless arbitrarily arranged and invented by plaintiffs.” There was a fact, also, which had some influence on the mind of the court. Several physicians testified that they had used this remedy for years; and that when they prescribed “Ferro-phosphorated Elixir of Calisaya Bark” they intended the medicine of that name manufactured and sold by the plaintiffs. Another fact appeared. The defendant was in the employment of the plaintiffs when the experiments were made which resulted in the production of the article. He availed himself of the information gained while in a confidential relationship. The court decided that the plaintiffs were entitled to the exclusive use of the word “Ferro-phosphorated,” whether alone or in combination with other words. But the Court of

¹ 4 Abb. Pr. (N. S.) 6; 35 How. Pr. 76; R. Cox, 429.

Appeals held that the word was descriptive of the composition of the medicine, and reversed the decision appealed from. — In a United States Circuit Court,¹ Wallace, J., correctly said: “When a new article is made, a name must be given to it, and that name becomes by common acceptation the appropriate descriptive term by which it is known, and therefore becomes public property. If this were not so, any person could acquire the exclusive right to a formula by giving a name to the compound produced, not only when the compound has not been patented, but when it might not be the subject of a patent. All who have the right to manufacture and sell the preparation have the right to designate and sell it by the name by which alone it is known, provided care is observed to sell the preparation as the manufacture of the seller, and not as the preparation made by another. The same rule applies in the case of a natural product to which one has given a name, which name becomes designatory of the natural product, and may be generally used; and even so during the continuance of a patent, if a new means of getting at the natural product is discovered, which does not infringe the patent.” — It will readily be understood that by the term *necessary* is meant that which is the true and descriptive name. In a case where a preparation made from infusorial earth for commercial purposes was called “Electro-Silicon,” those words were held to have been coined for the purpose of creating and establishing a trade-mark; that they were not descriptive of the article, although it contains some silicon; that silicon is not, and from its nature cannot be, a commercial article, because it exists in such minute quantities, and is an elementary body closely allied to carbon and existing as a dark brown powder or steel-gray mass, according to circumstances, and is never found in nature in an uncombined state, but only exists as a component part of compounds resembling it in no respect, from which it has been separated so as to exist by itself only in a small quantity, and to furnish only specimens to cabinets.²

¹ *Hostetter et al. v. Fries et al.*, 17 Fed. R. 626.

² *Electro-Silicon Co. v. Hazard*, 29 Hun, 369.

§ 220 a. "*Singer*," as a *Designation for Sewing-Machines*.—Is this name merely generic, as applied to a class of machines, the patents on which have expired? To enable one to give a satisfactory answer to this question, it is necessary to examine the course of litigation as to the use of this name as a mere adjective. This has ably been done in a recent case in the Supreme Court of Ohio.¹ Although this is not strictly a trade-mark case, but rather belongs to the domain of good-will, it illustrates a principle applicable to trade-marks. The Singer Manufacturing Company, a corporation organized under the laws of the State of New Jersey, in 1880, brought an action, in the Superior Court of Cincinnati, under the code of the State of Ohio, for an injunction and an account. Plaintiff alleged that it was engaged in the manufacture and sale of sewing-machines, which machines were known by the name or designation "*Singer*," and that the defendant had violated its rights by selling machines of similar appearance under the name of "*English Singer Sewing-Machines*." From the pleadings and proofs, it appears that in 1850 letters patent were granted to one Howe, the inventor, (who transferred his rights to Isaac M. Singer, to whose rights the corporation plaintiff had succeeded,) for an improvement in sewing-machines. The name "*Singer*" was then given to the machine, and the machine introduced to the public, and afterwards, and through all subsequent changes, it was termed, and known to the public as, the "*Singer Sewing-Machine*." It was in this way that the machine was distinguished from other patented sewing-machines, identified and known by the name of the respective inventors and makers, as "*Wheeler & Wilson*," "*Grover & Baker*," "*Florence*," "*Wilson*," "*Davis*," etc. The public thereby became informed that any such designations meant machines for which patents had been granted, machines constructed upon the principles, and in the mechanical modes, and operating in the ways, described in the respective patents. The plaintiff contended that the word "*Singer*" was and had been

¹ The Singer Manufacturing Co. v. Brill, 41 Ohio St. See decision of the Superior Court of Cincinnati in this case, Cox's Manual, No. 672.

understood in the trade to signify machines of the manufacture of the plaintiff, and no others. The plaintiff was the proprietor of, or was interested in, several patents for improvements upon the machines manufactured and sold by it, each improvement being distinguished from all others, and a distinctive name given to it. The "Singer Family Machine" was the one sold by the defendant. The patents thereon had expired a long time before the acts complained of were done. It appeared that the name "Singer" had, by means of a brass plate or label, been affixed to all machines sold by the plaintiff, and its predecessors, said I. M. Singer and a New York corporation; but the word "Singer" had not been affixed to any machines sold by the defendant, but in all his cards, circulars, and newspaper advertisements he represents them to be "English Singer Sewing-Machines, manufactured by the Williams Manufacturing Company, Montreal, Canada." The Superior Court — Foraker, J. — properly treated the matter as one of *trade-name* and not as a *trade-mark* case. The judge regarded the advertisements, etc. of the defendant as likely to mislead the public, and gave judgment for the corporation plaintiff. The case was taken to the District Court, in 1881, but was not heard there, but reserved to the Supreme Court of the State, where, on June 3, 1884, the decision below was reversed, for the reason that, where a patented machine became known to the public by a distinctive name during the existence of the patent, any one, at the expiration of the patent, may make and vend the machine, and use such name; and no one, by incorporating such name into his trade-mark, can take away from the public the right of so using it. — The foregoing is one of several suits brought by the same corporation for alleged wrongful use of the name "Singer," claimed as its exclusive property. The Court of Session, in Scotland, in 1873,¹ regarded the use of the name (although the defendants placed their own names on their machines) as an unfair assumption, and granted an interdict. — In 1877, in England, Jessel, Master of the Rolls, and the

¹ The Singer Manufacturing Co. v. Kimball and Morton, 11 Ct. of Sess. Cas., 3d series, 267; 10 Scot. L. R. 173.

Court of Appeal, upon the plaintiff's evidence alone, held, that although where a trade-mark proper is imitated on goods, it is not necessary, to constitute an infringement, for actual fraud to be proved; yet where a trade-name (Singer) is used in respect of an article, but is not placed upon it, actual fraud must be proved to establish infringement. No actual fraud having been shown, an injunction was refused.¹ The plaintiff's evidence only was before the courts. It showed that the defendant, who manufactured sewing-machines on the principles of a variety of expired patents, used among others the patents formerly owned by the plaintiff and its predecessors in business, and described such machines as "Our Singer Machines," and placed on them his trade-mark, consisting of a brass plate representing St. George and the Dragon within the words "Newton, Wilson, & Co., Manufacturers, 144 High Holborn," arranged in a circle; and he alleged that the name "Singer" was indicative of machines made on the principles of construction which he asserted to run through all the plaintiff's patents, though they varied in minor particulars, and not of an article made by the plaintiff. *Held*, by the House of Lords,² that, the plaintiff's evidence only being before their lordships, they were not in a position to decide finally whether the name "Singer" or "Singer's" was really indicative of the plaintiff's manufacture, or of a principle of construction, or whether the defendant had acted in a way to deceive, and that therefore the case should be remitted to the court below for decision upon the whole of the evidence. But that action was fated to be fruitless, for Wilson, the defendant, ceased to be in a condition to further contest the matter. The plaintiff company then brought suit against the London agent of a Berlin firm.³ Vice-Ch. Bacon decided in favor of the plaintiff; but the Court of Appeal reversed his decision.⁴ The House of Lords finally

¹ 2 Ch. D. 434; 45 L. J. Ch. 491; 34 L. T. (N. S.) 858; 24 W. R. 1023. — Ct. of Appeal: 2 Ch. D. 448; 45 L. J. Ch. 490; 34 L. T. (N. S.) 863; 24 W. R. 1026.

² 3 App. Cas. 376; 47 L. J. Ch. 481; 38 L. T. (N. S.) 303; 26 W. R. 664.

³ *The Singer Manufacturing Co. v. Loog*, 11 Ch. D. 656; 48 L. T. (N. S.) 3; Boston L. Rep. 1883, p. 533.

⁴ 18 Ch. D. 365.

settled the question, on the fifth anniversary of its former decision, in the language of the Lord Chancellor holding that the phrase "Singer system" of sewing-machines, whether scientific or not, whether exact or loose, is used commonly by the sewing-machine trade to describe a fact, and that, while other manufacturers have no right to invade the reputation of the company as manufacturers, so neither has the company, now that its patents have expired, any right to claim a monopoly of a particular pattern of machinery, or the reputation acquired by it. The result is, that one who chooses to adopt the manufacture of machines having the same principle of working, and the same internal arrangement of parts, as those described in the Singer patents, is at perfect liberty to say that he manufactures them on the Singer system.¹—Several suits on the same subject matter have been brought in Circuit Courts of the United States, with substantially the same result. In the Northern District of Illinois, in 1878,² Drummond, J., said, *inter alia*: "On a machine called 'The Singer Sewing-Machine' there were various patents. These patents have all expired, and nothing can therefore be claimed under them. Other persons cannot be prevented from manufacturing a machine like the Singer sewing-machine, and which may be called, to distinguish it from other machines, 'Singer's Sewing-Machine.' If a sewing-machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine. . . . I do not think, under the circumstances of this case, there can be a trade-mark for the name 'Singer Sewing-Machine.'"—In the Eastern District of Missouri, in 1881,³ Treat, J., said: "If the patentees, or their

¹ 48 L. T. (N. S.) 3.

² *Singer Manufacturing Co. v. Larsen*, Chicago Leg. News, Nov. 6, 1880; 8 Biss. 151.

³ *Singer Manufacturing Co. v. Stanage*, 6 Fed. R. 279. The same judge in 1884, in *Goodyear Rubber Co. v. Day et al.*, 22 Fed. R. 44, reasserted this doctrine.

assignees, could assert successfully an exclusive right to the name 'Singer,' as a trade-mark, they would practically extend the patents indefinitely. The peculiar machine which had become known to the public under that name during the life of the patents, was so known as a specified article of manufacture, and at the expiration of the patents would still be known on the market by that designation, irrespective of the name of the special manufacturer. No one has an exclusive right to the generic name. If one wished to acquire a trade-mark in connection therewith, he could do so, distinctively. The plaintiff accordingly adopted specific devices, including its own name, whereby its products could be distinguished. The defendant adopted a different device, with the name of his manufacturer 'Stewart,' and advertised the sale sometimes of the 'Stewart' machines, and sometimes of the 'Stewart-Singer' machines, attaching his name as 'late General Manager of the Singer Manufacturing Co.' . . . A review of the many cases cited leads to the following conclusions:— First. That when a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every person, at the expiration of the patent, has a right to manufacture and vend the same under the designation thereof by which it was known to the public. Second. That the original patentee, or his assignees, have no right to the exclusive use of said designation as a trade-mark. Their rights were under the patent, and expired with it. Third. If a corporation or person wished to establish a trade-mark or name, indicative of its own special manufacture of such a machine or product, the right must grow up, just as all other rights of the kind are established, by use and acquiescence. Thus, as every one, at the expiration of the patent, had a clear right to manufacture and vend what was known as the 'Singer' sewing-machine, the plaintiff could acquire no exclusive right to the name 'Singer,' but could, by proper trade-mark, appropriate to itself names or devices indicating its own manufacture of such machines."— The judge went on to say that the parties to the suit had each adopted a distinctive trade-mark, with different devices

and names, so that there was no probability that the machine made by one would be mistaken for the manufacture of the other; and that, inasmuch as the word "Singer" indicates a machine of peculiar mechanism, and every one has a right to make such a machine, the word "Singer" attached to such a machine is common property. He continued, that it is important to remark that the plaintiff is seeking, after the expiration of patents, to perpetuate a monopoly, under the guise of a trade-mark. He further remarked, that the propositions involved have undergone much judicial investigation in Transatlantic and Cisatlantic courts, and all the cases would show, if properly analyzed, that the general rule is the same as above laid down. — In 1882, in the Circuit Court of the United States for the Western District of Tennessee,¹ the same matter was considered, and a preliminary injunction denied. Hammond, J., fully concurred in the conclusions of the Stange case, and said: "It is a part of the history of our inventions, known to the courts as well as others, that the names of inventors are used to distinguish their inventions, and there have been 'Howe,' 'Singer,' 'Grover & Baker,' 'Wheeler & Wilson,' &c., to indicate the different kinds of patented sewing-machines."

§ 220 b. The propriety of using a man's name as a trade-mark, when it might tend to mislead, was considered in the Supreme Court Commission of the State of Ohio, in 1884.² The defendants in error had claimed the name "Trommer" as one of the essential elements of a trade-mark upon bottles of malt-extract. The facts, as they appeared in the bill of exceptions, were as follows. The article sold by the defendants in error was made by one Gessner, and in accordance with a formula prepared by him. Many years before that time, Dr. Felix von Niemeyer, a German physician of some note, published a "Text-Book of Practical Medicine," the third American edition of which was printed in 1870. The book was a standard work, and became authority with physicians and students of medicine. In that book Dr. Niemeyer

¹ *Singer Manufacturing Co. v. Riley et al.*, 11 Fed. R. 706.

² *Buckland et al. v. Rice et al.*, 40 Ohio St. 526.

stated that in late years he had obtained very good effects from an extract of malt prepared by Trommer. He also in general terms described Trommer's malt-extract. Ziemssen, in his "Cyclopædia of the Practice of Medicine," a standard medical authority, also speaks of a malt-extract prepared from Trommer's receipt. Gessner did not know Trommer's receipt, and it is not claimed that the defendants in error prepared this malt-extract sold by them in accordance with Trommer's method, or that their malt-extract was like that of Trommer. When they put their extract upon the market, they adopted the word "Trommer" to be used as a trade-mark. The court said, *inter alia*: "What was their object in doing this? Why was the name of Gessner, the real author of the extract, concealed, and 'Trommer' put forward as the catchword? There could have been but one motive, and that was that the public should be led to believe that the defendants in error were making an extract of malt like that made by Trommer and mentioned by Niemeyer and Ziemssen. This was a deception, and to the extent that the District Court, by its order, protected them in the use of the word Trommer, it erred. There are, however, other distinctive features of the trade-marks, labels, and circulars of the defendants in error, which are not subject to the objection urged herein to the use of the word Trommer, which the courts below were asked to and did protect by their decrees in this case. Some of these devices the plaintiffs in error wrongfully made use of, and in rendering the judgment which the District Court should have rendered, we make our decree the same as that of the court below, except wherein it protects the defendants in the use of the word Trommer." ¹

¹ The author, as one of the counsel for the defendants in error, contended that it was an infringement, on the part of the plaintiffs in error, to use the word-symbol "Trommer," either directly or by colorable variations, in the nominative case or in the possessive; that the disguise assumed by them was based on the coincidence of "Trommer" with the surname of a man who then, or once, lived in Germany; and that the evidence of their unlawful intention was found in the similarity of the labels, circulars, wrappers, advertisements, bottles, and packages, the priority of adoption by the defendants in error having been beyond dispute. In a circular, the plaintiffs in error had said: "We were among the pioneer manufacturers of this inestimable remedy, having

§ 221. *The Name of a Machine, or Product, the Patent for which has expired.* — Such a name, indicating peculiar mechanism, cannot be protected as a trade-mark. James, V. C., in 1869, held that no injunction could be granted to restrain the use of the name “Wheeler & Wilson,” that being merely indicative of a machine manufactured on certain principles, whether by the plaintiffs or others. He said that a man cannot prolong his monopoly by saying, “I have got a trade-mark in the name of a thing which was the subject of the patent.”¹ — In the Patent Office, in 1873, an application was made for the registration as a trade-mark of the words “A. Richardson’s Patent Union Leather-Splitting Machine.”² It was refused on the ground that, the patent having expired, the continued use of the word “patent” was deceptive; and as to the remainder, on the ground that the name, having been applied to a patented article during the existence of the patent, had become descriptive of the article, and open to the use of the public on the expiration of the patent. — In 1875, in a case in a United States Circuit Court, the complainant, manufacturing the “Tucker Spring-Bed” under an expired patent, had registered as a trade-mark a picture of the bed, the monogram “T. M. Co.,” and the name “Tucker Spring-Bed.”³ The defendant manufactured a similar bed, and used a label containing a picture of it, and the identical name. Blodgett, J., refused an injunction, on the ground that the right to use the name and represent the bed had become common property on the expiration of the patent. — In the Court of Appeal in England, in 1877, it appeared that the

been connected with the Trommer Extract of Malt Co. of this city from its infancy.” Under oath they had said that the only “Trommer’s method” known to them was that which was originated and operated by the defendants in error. While all the plaintiffs and defendants in error were copartners, they had under oath registered the name “Trommer” as one of the essential features of their trade-mark; therefore, they were by their own act estopped. In short, it was argued that, whether a technical trade-mark or not, the fancy name “Trommer” as an affix to malt-extract was entitled to protection. The courts below concurred in this opinion.

¹ *The Wheeler & Wilson Manufacturing Co. v. Shakespear*, 39 L. J. Ch. 36.

² *Re Richardson*, 8 Off. Gaz. 120.

³ *The Tucker Manufacturing Co. v. Boyington*, 9 Off. Gaz. 455.

plaintiff, G. Cheavin, manufactured filters on a principle patented by his father, S. Cheavin, in 1862, (but the patent for which lapsed in 1865,) and placed on his filters a tablet with the words, "G. Cheavin's Improved Patent Gold Medal Self-Cleaning Rapid Water Filter, Boston, England," beneath a medallion with the royal arms and the words "By Her Majesty's Royal Letters Patent." The defendants manufactured filters on the principle of the same patent, and placed on them a tablet with the words "S. Cheavin's Patent Prize Medal Self-Cleaning Rapid Water Filter, Improved and Manufactured by Walker, Brightman, & Co., Boston, England." Held by the Court of Appeal, (1.) that the alleged trade-mark was a mere inscription, and not a trade-mark; and (2.) that the defendants had merely stated the principle on which the filter was manufactured by them. *Per Curiam*, James, L. J.: "It is impossible to allow a man to prolong his monopoly by trying to turn a description of the article into a trade-mark. Whatever is mere description is open to all the world."¹ In 1877, the assignees of certain patents for screw-neck bottles and jars, granted to J. L. Mason, applied for registration in the United States Patent Office, of the name "Mason" as an alleged trade-mark in use by them for many years. The application was refused, inasmuch as it was the name of the inventor, and although the applicants had the sole right to make the articles, and therefore to designate them by that name, on expiration of the patents all makers would be entitled to describe them by the appropriate descriptive name.² — In 1879, in *Filley v. Child*, the evidence satisfactorily showed that the complainant, Giles F. Filley, during the entire duration of his patent, — twenty-one years, including the term of extension, — knew of and acquiesced in the manufacture and sale by M. L. Filley, and those under whom he claimed, of cooking-stoves containing the patented improvements, with the name "Charter Oak" upon them. M. L. Filley made the stoves complained of in the suit. He had built up a business through the acquiescence of the complainant,

¹ *Cheavin v. Walker*, 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. (n. s.) 988.

² *Re Consolidated Fruit Jar Co.*, 14 Off. Gaz. 269.

and, as the court said, had the right to make stoves containing such improvements, and therefore could not be prevented from calling them by their proper name, "Charter Oak," so long as he did not represent them as being made by G. F. Filley, or induce others to believe that they were made by him.¹ — In 1883, in England, the question was as to the vitality of the term "Home-washer" as a trade-mark on a machine, the patent for which had expired. Pearson, J., said, *inter alia*, that the "Home-washer" no doubt during the existence of the patent described the machine which was made under the patent. He cited with approbation the decision in the "Linoleum" case,² and concurred with Lord Justice Fry that it was impossible for the court so to construe the Trade-Mark Act as to do away with what has been the law of the land, from the time of King James downward, as to the expiration of the monopoly with the ending of the patent.³ — In *Re J. B. Palmer's Trade-Mark*, in 1882, Chitty, J., said that he considered it plain that a man can have a patent for a new manufacture, and at the same time have a trade-mark in the name used to designate the goods, though they are made under the patent. Therefore he argued that the words "Braided Fixed Stars," for matches, were not merely descriptive, as in the "Linoleum" case, but might have been valid as a trade-mark before the Trade Marks Act of 1876 (which excludes mere words, subsequently adopted, from the category of technical trade-marks); but the plaintiff had not so used them, and therefore had lost his claim to them. It was held, on appeal, that the words were only properly descriptive of the patented article. Bagallay, L. J., said that he understood the words "Fixed Stars" to mean cigar-lights, and the word "Braided" to indicate their having been prepared in a particular way. They were manufactured under a patent which was for the purpose of braiding the stems of cigar-lights, i. e. passing round them by means of an ordinary braiding-machine a net-

¹ 16 Blatch. 376.

² *Linoleum Manufacturing Co. v. Nairn*, 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. (N. S.) 448; 26 W. R. 463.

³ *Re Ralph's Trade-Mark*, and *Ralph v. Taylor*, 25 Ch. D. 194.

work of fine wire. It was therefore to be seen at once that the words were used to describe articles manufactured under the patent. Cotton, L. J., concurred with him. The words had been used during the existence of a patent, and fairly described the article patented. He said that they did not point to claimants, independently of its being a patented article. If used by others during the existence of the patent, it would have been a false representation. "In one sense, therefore, the name of the article might be called a trade-mark." Lindley, L. J., said that it was plain to demonstration, on the evidence, that the expression meant a patented article which was indeed made by the plaintiffs, but that it was not intended to denote them as distinct from other manufacturers; and the case was therefore brought within the authority of the "Linoleum" case. He said, further, that he did not mean that the manufacturer of a patented article cannot have a trade-mark not descriptive of the patented article, so as to be entitled to the exclusive use of the mark after the patent has expired; for instance, if he impressed a griffin, or some other device; but if his only mark be a word or set of words descriptive of the patented article, it appears to be impossible to make out that that mark denotes him as the maker, as distinguished from other makers.¹ — European Continental courts have made several interesting decisions. In the Tribunal of Commerce of the Seine, in 1872, the manufacturer of a sort of charcoal (called by him "Charbon Agglomérée") had patented the product, and the patent had expired; but it was held that, nevertheless, he retained as his trade-mark the exclusive right to the special denomination under which he had delivered it to commerce, for the reason that that name was not a necessary appellation, and had become in fact a veritable mark for his product.² Plaintiff's article from the beginning of the trade therein had been sold under the name of "Charbon de Paris." For that very reason, the Court of Cassation, in 1875, reversed the decision as follows: The fabricant who has given to the product of his ingenuity a new and fanciful denomination, as "Charbon de

¹ 24 Ch. D. 504.

² *Brousse v. Pernolet & Co.*, 18 *Annales*, 248.

Paris," cannot claim exclusive right to it when he has thus let it fall into the public domain; and especially so when, by long usage, and without opposition on his part, it has become the general designation of that kind of product.¹ But the Court of Paris, in 1874, held that, even if the product to which the name of fancy had been applied should have originally been the object of a patent, if, independent of the patent, it was not the necessary designation of the product, it was a valid trade-mark.² — In the Court of Brussels, in 1876, it appeared in evidence that, in 1809, Claude Bully had patented preliminarily a vinegar that he called *aromatique et antiméphitique*, and in 1814 he obtained for his invention a complete patent. After his decease, his son and successor very largely extended the manufacture and sale of the product, to which he gave his proper name of *Jean Vincent Bully*. It obtained a great reputation, which was enjoyed by the plaintiffs, who acquired the establishment in 1833. On appeal, it was held that, when a patented product is known in commerce under the name of the inventor, the expiration of the patent which causes the article to become public property causes the name of the inventor also to fall into the public domain. It is as much so when, instead of indicating the prænomens of the original inventor, those of his son and successor may have been employed, if it be established that under the surname and first name of the latter the product is known to the public. This decision of the Belgian court seems to be quite correct in principle, and its philosophy does not conflict with a decision of the Court of Agen, of the previous year, in *A. and M. Landon v. Pons*.³ The French court said that Claude Bully never manifested an intention to bind his name by an indissoluble tie to the product of his invention; that he did not cede to any person the right to attach it thereto; that, besides, it could not become the essential element of all aromatic and antimephitic vinegar, even if manufactured after the name had become common by expiration of the patent; and that the name had not been alienated by Claude, but

¹ 22 Annales, 91.

² *Fox v. Meurgey et al.*, 19 Annales, 327.

³ 23 Annales, 234.

remained the exclusive property of his son and heir. The Court of Cassation affirmed this decision, but rested it on the terms of the law of July 28, 1824, wherein it is forbidden to affix on manufactured articles the name of a manufacturer other than that of him who was the first inventor; and that although the thing patented with the expiration of the patent fell into the public domain, it was not so with his patronymic. The learned reporters say, what is unquestionably so, that this is the settled law of France.¹ — But observe the following decision in the same court of last resort on the very next day. The Tribunal of the Seine, having decided in favor of the plaintiff, and the Court of Paris having reversed the decision, the case was appealed to the Court of Cassation, which spake thus: “Although in principle the patronymic name of an inventor remains his exclusive property until the expiration of his patent, and all other manufacturers are prohibited from using it until then, yet it is always quite otherwise in a case where, *by long usage or in consequence of consent*, whether express or tacit, of the inventor, his name has become the only designation usually applied to the product. . . . It is especially so of medicines fallen into the public domain of pharmacy, and every pharmacist has the right to announce and sell under its designation which has become usual, at the charge of taking necessary precautions not to lead the public into error as to the origin of the product.”² The Court of Cassation reasserted the same doctrine, in 1881, in almost the same language, viz.: “The name with the patent only falls into the public domain when the name has become, either by long notoriety, or by consent of the inventor, the necessary designation of the product.”³

§ 222. Many authors, judges, and lawyers have cited *Gout v. Aleploglu*,⁴ to show that an ordinary word in a foreign language, meaning *warranted* or *approved*, may be a trade-mark. They err in so doing. This case, heard in 1833 in England, seems to have been as follows. The plaintiff, Gout, had long manufactured watches for the Turkish market. These watches

¹ 23 Annales, 235.

³ Landon v. Leroux, 27 Annales, 183.

² Torchon v. Pauliac, Id. 243.

⁴ 6 Beav. 69.

had acquired great repute in Turkey, and were known by certain marks engraved thereon. These marks consisted of words in Turkish characters, viz. the name of the maker and the word "Pessendede," which in the Turkish signifies *warranted* or *approved*. There were also other marks: "R. G." and a crescent put in relief, and a sprig and crescent. Now it would be folly to say that the word "Pessendede," which had no use except in the market to which the watches were sent, and which was of no use elsewhere, could be exclusively appropriated. The word might with truth be used by many fair dealers for its legitimate purpose; and, being a common word expressing quality, no one could claim it to the exclusion of all others. We must look closer, and ascertain the facts.

§ 223. In 1831, the defendant applied to the plaintiff to manufacture watches to be consigned to Constantinople; but conceiving that he might thereby injure his agent there, the plaintiff refused to execute the order. Subsequently, the defendant got the Messrs. Parkinson to manufacture watches for him. On these were engraved, in Turkish characters, the words "Ralph Gout" and "Pessendede," on the same parts of the watches as the plaintiff used for that purpose. The defendant then sent them to Constantinople, and sold them, to the injury of the plaintiff's trade. We see that he simulated the name of the plaintiff, in addition to copying a word that had doubtless become associated with the article. It was a *part* imitation of the plaintiff's lawful commercial sign. The initials R. G., the crescent in relief, and the sprig and crescent, were omitted by the pirate, but he took enough of the plaintiff's mark to enable him to accomplish his object, which was to divert another man's trade into his own channel. The Vice-Chancellor granted an injunction, restraining the defendant from sending or permitting to go to Turkey, or to any other place, and from selling and disposing of, any watches with the name of the plaintiff thereon in Turkish characters, or the word "Pessendede" in Turkish characters, or any watches in imitation of the plaintiff's watches; and also restraining Aleploglu and the Messrs. Parkinson from manufacturing or vending such watches. In non-legal language this

means just this, and no more. The defendant must discontinue his piratical tricks. He has imposed upon the public, and by his fraudulent acts has damaged the plaintiff by a part imitation of his commercial marks. He cannot escape by mere evasion. But the court did *not* decide that the Turkish word "Pessendede" was a trade-mark.

§ 224. In the Tribunal of Commerce of the Seine, in 1861 (*Abadie & Co. v. Proudhon & Co.*¹), the plaintiffs showed that they made in a particular manner cigarette-paper, called by them "Papier de Riz." This paper they put into the market enclosed in an envelope of salmon-colored paper. They claimed the name as their trade-mark, the same having been duly deposited or registered as such, and brought suit for an infringement of the same. *Per Curiam*: Even if the plaintiffs have not an exclusive property in the paper, they have at least the right to sell it by the title which they have duly deposited and employed to indicate to commerce the cigarette-paper of their manufacture. The defendants have sold a similar paper in a roll covered with the same colored paper, and bearing the name of "Papier Crème de Riz." Even if the use of salmon-colored paper is common as a wrapper for all kinds of products, its employment, joined to the indication "Crème de Riz," reveals an intentional imitation, susceptible of creating confusion with the products of the plaintiffs. Judgment accordingly for the plaintiffs.

§ 225. *Numerals as Marks.* — Among all the dubious signs suggested for recognition as trade-marks, the most untrustworthy are mere numerals. If a man adopt 1, 2, 3, or 123, or any other combination of these common figures, how can he reasonably look for protection in the exclusive use of them? Let us apply a test. A. has adopted "123" as his arbitrary mark. To him it is meaningless, except as a symbol to affix to his goods. B. is charmed to see the success that A. has achieved in selling his merchandise bearing this mystic symbol. He begins the manufacture and sale of the same class of goods, but of an inferior quality. The figures have a reputation, because all the articles bearing them have up to this time

¹ 7 Annales, 95.

been found to be superior in quality. Now the mind of the public has become confused, for a worthless article is discovered to be stamped with the same numerals. If the inmost recesses of B.'s heart were explored, lurking roguery would there be found; but his outward semblance, like that of his trashy merchandise, bears no evidence of fraud. He keeps his own counsel; and in a suit for infringement of A.'s mark, "123," he does not assist his adversary by any admissions. He feigns astonishment that his right should be disputed. He asserts a perfect right to stamp his candy or other articles with the figures "123," for that is the number of his shop; or he means thereby to warrant 123 lozenges to the pound; or each bale contains 123 pounds; or a thousand other variations, plausible and non-combatable. These numerals may truthfully import a myriad things. Any one has the right to speak the truth: *ergo*, the numerals aforesaid cannot be exclusively appropriated. A. replies that, although ordinarily a mere numeral cannot become a valid mark of origin or ownership, and at common law would be disregarded, in this particular instance it would be perfectly valid for the reason that he had duly registered it, and thus had given constructive notice to the world of his exclusive appropriation. But the registry act did not create trade-marks, nor did it pretend to. It protects only valid marks. If it has no legal force at common law, the alleged mark has not attained legality by the fact of registration. Even long user and notoriety cannot cure the inherent lack of stamina. "*Quod ab initio non valet in tractu temporis non convalescit.*"¹ Any person may lawfully stamp on his goods any numerals that shall express the truth. But he could not so use them if another person, in the same line of business, had such numerals as his mark for merchandise. Mere numerals cannot be turned into arbitrary symbols. There must be collateral matters to invest them with such characteristics. There may be some such striking peculiarity of form, ornamentation, coloring, or combination, as to make them distinctive, and so take them out of the category of mere numerals. Why was it thought by many, that numerals

¹ Broom's Legal Maxims, [*132].

alone might become technical trade-marks? By reason of a judicial decision not fully understood. Here it is.

§ 226. *Gillott v. Esterbrook*,¹ before a general term of the Supreme Court of New York, in 1867, has been relied on to support the doctrine that mere numerals constitute a lawful trade-mark. The facts in that case were substantially as follows. The plaintiff had been a manufacturer of steel pens in Birmingham, England, ever since 1825, and for more than twenty years had an agency in the city of New York. He manufactured, and sent to the United States, steel pens of various descriptions; and among them, as early as the year 1839, was a flexible bronzed double-grooved, extra-fine-pointed slip pen on which was impressed the arbitrarily-selected numeral "303," and the words "Joseph Gillott, Extra Fine." Said pen became deservedly popular, was in great demand, and the most prominent pen in the market, producing large sales at high prices. This pen became known to stationers and other dealers by its number, 303, which distinguished it from other pens of the plaintiff's make. These figures did not express quality or size; and no other pen was then known to have numerals upon it. The defendant manufactured and sold a pen, which in size, shape, color, pattern, flexibility, and fineness of point, so closely resembled the plaintiff's pen as to require an expert or adept to distinguish them in these respects. The defendant also impressed upon his pen, in the same place as the plaintiff did, the number 303, and the name of defendant's firm, "Esterbrook & Co.," and the same words, "Extra Fine." The pen was put up in boxes of the same size as the plaintiff's, with a similar fancy-paper label; and in other respects was cunningly adapted to mislead as to the origin of the pen.

§ 227. What should a court do under such a state of facts? Would it not have been a mockery of justice to dismiss the complaint? This is what was said by Leonard, J., in delivering the opinion of the court: "The design to defraud by manufacturing and packing pens in all respects similar to the plaintiff's, excepting only in the use of the name, appears

¹ 47 Barb. 455; R. Cox, 340.

very plainly. I cannot reason so artificially as to disguise this conclusion from myself." The judgment obtained by the plaintiff was affirmed by two judges. Ingraham, J., dissented. He doubted the validity of the numbers as a trade-mark. He said that it was in evidence that in all the boxes of plaintiff's pens, sold during more than twenty years, had been placed a notice stating that "other makers had adopted the above number (303) by which the original Gillott's Victoria pen is known." He considered this long user by others as having deprived the plaintiff of exclusive right to said figures, his silence being an acquiescence, even if he could be considered as having a right to it. He further said, that "there was error in holding that the plaintiff, by the use of this number, became entitled to the exclusive use thereof and to the profits thereof, and that he is entitled to an injunction restraining the defendants from the use thereof."

§ 228. What did this judgment decide? That the numerals 303, as used, constituted a trade-mark? Not at all. An examination of the whole case will help us to a clear solution. Judge Potter, at special term, regarded them as being merely a *part* of a mark. He said: "These symbols or figures do not, of themselves, indicate any appropriate name of the pen, nor any mode or process by which it is manufactured. They do not indicate the quality of the pen; but, connected as they are with the plaintiff's name, they indicate the origin or ownership of the pen, and were intended by him, with the addition of the words 'Extra Fine' impressed thereon, to designate the pattern of this pen as distinguished from other pens of his manufacture represented by other numerals, and also to distinguish it as the pen of his manufacture by those peculiar marks or devices. The marks last named, except, perhaps, the words 'Extra Fine,' seem to be within the rule that allows a device to become a trade-mark. . . . It is true that the imitation is but partial. . . . It is not necessary for the plaintiff, in order to receive the protection of the court, that he show that his whole trade-mark has been pirated or simulated. A false impression can as well be conveyed to the mind of the public, and especially to the memory, by a partial

as by a total counterfeit. The design to defraud may be as apparent, and is generally more injurious, in the partial than in the entire imitation." The learned judge evidently regarded the figures as but an ingredient of the compound trade-mark. It was upon that theory that the case was discussed throughout. The question before the court was practically this: Did the defendants by unlawful means usurp any portion of the plaintiff's trade? This question was answered in the affirmative. How was the unlawful act accomplished? By the imitation of the pen itself, the box containing it, the label that enclosed it, and other means, one of which was the simulation of a part of his mark. That was the act that decided the matter. That made manifest the intention. Why copy this number 303 unless it had already obtained a good report? The conclusion was irresistible: the defendants sold their merchandise as that of the plaintiff's manufacture. In 1872 this case was heard by the Commission of Appeal.¹ The judgment was affirmed, and justly so. The point is, whether it was decided that the said numerals constituted, by themselves, a technical trade-mark. It was not necessary to decide that exact point. There had been unfair competition in business. In rendering the decision, Chief Commissioner Lott said that the facts showed that the numerals "303" had been selected and used by the plaintiff as his trade-mark, to indicate, in connection with his name, the origin and ownership of the pens manufactured by him, and not to designate their quality merely. The case did not demand a precise definition.

§ 229. Since the time of *Gillott v. Esterbrook*, several decisions have been made that have a tendency to limit the use of such a perplexing symbol, while sustaining numerals according to circumstances. The difficulty in regard to the recognition of numerals is that they generally indicate size or quality. For this reason, nations of Continental Europe have generally excluded numerals from the list of technical trade-marks. It will be found that, when sustained, it is because they are combined with other symbols that are essential, or

¹ 48 N. Y. 374; 8 Am. R. 553.

cases have been determined on principles appertaining to the protection of good-will. *Unfair competition* is suppressed by the courts, irrespective of questions of technical trade-marks. — *Kinney v. Basch*, in 1877, is an instance,¹ the numerals being but a portion of a compound mark. — So, also, in *Carver v. Bowker*, in England, in the same year, in which numerals were combined with certain specially-colored stripes, and the defendant, who carried on a similar business, used similar combinations.² — In *India-Rubber Co. v. Rubber Comb, &c. Co.*, in 1879,³ the numerals 2, 101, and 32 were said to be trade-marks. — In *Lawrence Manufacturing Co. v. Lowell Hosiery Mills*, in the Supreme Court of Massachusetts, in 1880,⁴ the plaintiffs used on a certain grade of hosiery a certain device with the figures 523 under it. These goods were known and called for as “523’s.” The defendants afterwards used as a trade-mark a device somewhat resembling that of the plaintiffs, and the figures 523 printed in the same kind of type, and placed on the other parts of the device in the same relative position as the plaintiffs’. The case came under the statute of the Commonwealth,⁵ which protects peculiar names, letters, marks, devices, and *figures*, used to distinguish articles of manufacture. The court said of the plaintiffs: “Their claim is, that the purpose of using those figures in connection with the other parts of their trade-mark was to aid the buyer in distinguishing their goods from similar goods made and sold by others.” It was not pretended that the numerals *alone* were a technical trade-mark. The court cited *Boardman v. The Meriden Britannia Co.* (commented on in the next section) as authority,⁶ and said: “The numbers in that case, however, were held, by virtue of their connection, to form an important part of the trade-mark itself.” — In *Shaw Stocking Co. v. Mack et al.*, in 1882,⁷ Coxe, J., said that, when

¹ N. Y. Supreme Ct., 16 Am. L. Reg. (N. S.) 596.

² Lancaster, Chanc., Little, V.-C., 1 Trade Marks, 252; Cox’s Manual, case 581.

³ 13 N. Y. Superior, 258.

⁴ 129 Mass. 325; Cox’s Manual, case 673; 37 Am. R. 362.

⁵ Gen. Stat., c. 56, § 1.

⁶ 35 Conn. 402; R. Cox, 490.

⁷ 16 West. Jur. 560; 12 Fed. R. 707; 21 Blatch. 1.

courts have refused protection to alleged trade-marks so composed, it has been because, on the facts of each case, it was determined that they were intended solely to indicate quality.— In that same year, in *Humphrey's Specific Homœopathic Medicine Co. v. Wenz*,¹ Nixon, J., held that the numbers constitute a lawful trade-mark when they indicate origin or proprietorship, and are used in combination with words and other numerals.— In the Supreme Court of Kentucky, in 1883,² the defendant had imitated certain non-essentials, but in doing so had been guilty of unfair competition, and that was distinctly avowed to be the ground of the decision against the imitators. The learned Chief Justice Hargis said, on behalf of the court, that “Arabic numerals are to man, in conveying his thoughts, feelings, and the truth, what air, light, and water are to him in the enjoyment of his physical being. Neither can be taken from him. They are the common property of mankind. . . . And the appellants, having drawn from the common fountain, . . . cannot claim an exclusive right to them or their use.”

§ 230. In *Boardman v. The Meriden Britannia Company*,³ before the Supreme Court of Connecticut, in 1868, both parties seem to have regarded the use of numbers as giving rise to the most important and most material question in the cause. The petitioner relied upon them as the most prominent, valuable, and distinctive feature in their trade-mark. The respondent claimed that, if in any case numbers can be legally appropriated as trade-marks, they were not so appropriated in this case; and that, so far as they tend to indicate ownership, it is only so by an association of ideas, and by giving to them a meaning which they were not originally designed to have. The court said: “If this be so, or if the numbers were used solely to indicate the different patterns, styles, or sizes, it is clear, from the view we have taken of the law, that the respondent ought not to be restrained from their use. Whether in any case numbers alone may be legiti-

¹ 14 Fed. R. 250.

² *Avery & Sons v. Meikle & Co.*, Kent. L. R. & Jour., April, 1883.

³ 35 Conn. 402; R. Cox, 490.

mately appropriated as trade-marks, is a question not necessarily involved in the case. It may be difficult to give to bare numbers the effect of indicating origin or ownership; and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, it may not be easy to assign a reason why they should not receive the same protection, as trade-marks, as any other symbol or device. But in this case the numbers were associated with the name of the petitioner, and the form, color, and general arrangement of the labels; and, by virtue of that connection, form an important part of the trade-mark itself." It appeared that the goods of the petitioner contained labels with his name and the numbers thereon; that under these labels and numbers the goods had become known in market, and had obtained a good reputation; that they were known by their respective numbers, and were generally ordered, bought, and sold by the numbers on the labels. The most prominent feature of the label, and the one most likely to attract attention, would be the number. So said the court.

§ 231. We see that this case does not solve the question whether a bare numeral can be turned into a trade-mark. The counsel for the respondent took the proper view, which is that a trade-mark conveys the idea of the maker. It is designed to represent the maker in such a way that the moment a man looks at it he shall know who made the article. It is intended to designate the origin of the article on which it is placed. All the authorities agree upon this. But there is nothing either in the common paper box or in the labels used by the petitioner, except the name, "L. Boardman," to indicate the origin of the goods. Take the name from the label, and there is nothing left to indicate to any one who was the maker. There is much plausibility in the counsel's argument that the numbers were used to indicate the different patterns; that they had reference to the patterns, not to the manufacturer; and that the petitioner adopted the numbers 12, 20, &c. for the same purpose that any other maker does, — to indicate different classes of goods.

§ 232. As matter of history, we find that numerals have been used for this purpose; but they were not the plain figures that have but one function, — that is, as mere numbers. Thus, in Worcester, in England, the early specimens of china-ware, which generally had the Chinese and Japanese marks, in imitation of the genuine, bore a series of numerals from 1 to 9. These were disguised by flourishes, doubtless well understood by the wholesale dealers, but which were meant to deceive the general purchaser into the belief that they were Chinese and Japanese characters.¹ Anybody may so use the same numerals, provided he turn them into arbitrary symbols. They then cease to be mere numerals. If in any manner the numbers indicate the origin or ownership of the goods, it is by an association of ideas. Certain figures suggest a meaning to the mind which the figures do not in reality bear, and were not designed to convey. A man has no right to appropriate words or figures in common use for the purpose of indicating ownership, and if he do, or if by the association of figures with his name they serve that purpose, that circumstance cannot prevent another person from using the same figures to indicate the pattern or size of goods made by him.

§ 233. Conclusion. It is believed that no court, in any country, has ever solemnly decided that a naked numeral can constitute a trade-mark; and it is confidently believed that no court upon calm deliberation would so decide.

§ 234. *Letters as Marks.* — In one case, the applicant sought to have registered, as a trade-mark, the “letter D, encompassed by the figure of a lozenge.” The Examiner rejected the application, on the ground that the proposed mark had no feature that indicates “origin or ownership.” This action was based upon the decision of Allison, P. J., in *Ferguson v. Davol Mills*,² in which the mark consisted of the letter K within two concentric circles, &c. The object of rejecting the application was that the question might be considered by the chief officer of the Patent Office, and, so far as it is concerned, be definitively settled. The Commissioner

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

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

held, *inter alia*, that the very fact of the mark bearing evidence of being the manufacturer's or dealer's private mark, by means of which his goods are distinguished in the market, is sufficient indication of origin to warn against copying by competing dealers, and this answers the public demand. He further said, that the applicant's device is not a generic one: it is not indicative of quality. It does not consist of words or devices that others in the same trade would be likely to select for a similar purpose, and no valid reason could be seen against admitting it to registry.¹ On the authority of this decision, the soundness of which is indisputable, the letter S, within a circle, was held to be a valid trade-mark, although being the initial of the surname of the principal member of the firm applying for registration.²

§ 235. The application for the registration of the letters "A C A" seemed to come within the principle of the foregoing cases; and yet there was cause for hesitation, as the simple letters were claimed without any enclosing line. The letters were used upon an elaborate label, substantially that described in the case of the *Amoskeag Manufacturing Co. v. Spear*.³ The ruling of the eminent jurist, Mr. Justice Duer, in that controversy, did not assist the determination of the question whether those letters, without adjuncts, constituted a good trade-mark at common law. He had taken cognizance of the matter as a chancellor, under circumstances of fraudulent misrepresentations. He was not called upon to say, in so many words, that "A C A" could be a valid mark of trade. Those letters had been employed by the applicant for the same purpose — i. e. as a mark for tickings and cotton fabrics — ever since the year 1836, a period of thirty-six years. The mark is well known to the trade, and is generally respected. A *prima facie* right to its exclusive use having been made out, it was registered.⁴

§ 236. *Fancy Names*. — The Court of Cassation, in 1864, in *Clertan et al. v. Charpentier*,⁵ held that the denomination

¹ *Dutcher Temple Co.*, Com. Dec., 1871, p 248.

² *H. D. Smith & Co.*, No. 521.

⁴ *Amoskeag Manuf. Co.*, No. 713.

³ 2 Sand. (S. C.) 599.

⁵ 10 Annales, 340.

given by a manufacturer to a product of his industry, unless such denomination became an element usual and necessary for the designation of the product, becomes a legitimate mode of signifying to the public his industrial product. This mode should be protected, and as much in pharmacy as in other kinds of industries. Therefore the fancy name of “Perles d’Ether,” applied to a certain pharmaceutical product, not being a generic term, is a legal trade-mark. It was apparent that this name could not be the true designation, for no sane person could think that pearls entered into the composition. It was purely fanciful. The Tribunal Correctionnel of the Seine, in 1865, in *Nestor Michel v. Stremier*,¹ held that a designation of fancy as “Trappistine,” as applied to liquor, was valid. The community of religious Trappists of the *Abbey de la Grace-Dieu* made and sold a *liqueur* with the new name “Trappistine.” The Tribunal of Commerce of Rouen, in 1867, in *Levy v. Bizet*,² held the words “Crème d’Argent” (Cream of Silver), applied to a chemical product, to be valid. The Court of Paris, in 1859, in *Gourbeyre v. Bodevin*,³ held the same of “Poudre Brésilienne” (Brazilian Powder). The Tribunal Correctionnel of the Seine, in 1858, in *Guerineau v. Mignon*,⁴ held that the words “Café des Gourmets” was a good mark for packages of roasted coffee.

§ 237. *Burnett v. Phalon*,⁵ in the Court of Appeals of New York, in 1867, is a leading case upon the subject of fancy names. In 1857, the plaintiffs began the manufacture and sale of an article of hair-oil, compounded of various ingredients, of which the essential element was cocoa-nut oil. It was supposed by them to be a new article; and they alleged that they invented for it a new name, which was “Cocaine”; and that as soon as they began the sale of the article they gave notice through the newspapers, and by their circulars, that they had adopted that word as their trade-mark. Phalon, one of the defendants, had, ever since 1840, sold

¹ 11 Annales, 284.

² 14 Id. 105.

³ 5 Id. 250.

⁴ 4 Id. 157.

⁵ 3 Keyes, 594. Same case below in 9 Bos. 192, and 5 Abb. Pr. (N. S.) 212.

a similar preparation of cocoa-nut oil. In 1858, the defendants began the manufacture and sale of such preparation, under the name of "Cocoïne." The plaintiffs brought this action to restrain the defendants from using the word "Cocoïne" in the sale of their article, claiming that the use of that word was an infringement of the exclusive right of the plaintiffs to the use of the word "Cocoaine." They also claimed damages for the injuries which they alleged they had sustained. The action was tried at a special term of the Superior Court of the City of New York, in 1859, before Mr. Justice Pierrepont; and the plaintiffs had a judgment perpetually restraining the defendants from using the word "Cocoïne." The defendants thereupon appealed to the court *in banc*. The judgment was there affirmed.

§ 238. Bosworth, C. J., in delivering the opinion of the court, said, *inter alia*: "The defendants, according to their own testimony, had been selling, since 1840, substantially the same article as they, in 1858, denominated 'Cocoïne,' and had been selling it as 'a preparation of cocoa-nut oil.' Why, after transacting this item of their business for some eighteen years, do they resort to the means employed in 1858 to bring it before the public under the designation of 'Cocoïne'? The answer is found in the reputation and extensive and largely increasing sales of Cocoaine. . . . It was a simple matter to get up a label, and impress on it, and on the bottles containing their compound, the word 'Cocoïne,' omitting one letter only. But no plausible or rational explanation, except an intent to defraud, could be given of a transaction so bold as that would be Burnett, by great outlay and effort, had succeeded in creating an extensive demand for his own manufacture, known as 'Cocoaine.' The defendants, in 1858, with the intent and for the purpose stated in the fifth finding of facts, impressed on the bottles and labels containing and covering their compound, the close imitation, 'Cocoïne.' . . . I think the judgment should be affirmed." Robertson, J., dissented, and entered upon a philological disquisition as to the meaning of the word 'Cocoïne.' He deduced it from the French adjective *cocoiné*. The accent upon the final letter

renders the word different from that of the defendants, to say nothing of the diæresis ; but still he held that the word is a proper term in chemistry, and would mean the finest part of the cocoa-nut oil ; and that after such name had become public property as the true designation of the article, the plaintiffs could not rely upon a word so near it as “Cocoaine” to protect themselves against the danger of confusion of two articles. His argument is not convincing. The case then travelled to the court of last resort.

§ 239. In the Court of Appeals, Davies, C. J., in delivering the opinion of the court, in which all the judges concurred, said : “ Upon the facts found by the court, the right of the plaintiffs to the relief granted is clear and indisputable. The plaintiffs have adopted, appropriated, and used a certain trade-mark. This has become their property, and, for its protection from invasion or use by others, the plaintiffs are entitled to invoke the aid of courts of justice. We have the ascertained facts before us, that the defendants are using a spurious and unlawful imitation of the plaintiffs’ trade-mark.” The judgment was affirmed with costs.

§ 240. It requires nice discrimination to determine what falls within the category of fancy names. When a new preparation or compound is offered for sale, a distinctive and specific name must necessarily be given to it ; and that name, no matter when or by whom imposed, becomes by use its proper appellation, and passes as such into our common language. Hence, all who have an equal right to make and sell the article have an equal right to designate and sell it by its proper name, the name by which alone it is distinguished and known, provided each person is careful to sell the article as prepared or made by himself, and not by another. When this caution is used, there is no deception of which a rival manufacturer, not even he by whom the distinctive name was first invented or adopted, can justly complain. So far from there being any imposition upon the public thereby, it is the use of the distinctive name that gives to purchasers the very information which they are entitled to have. In short, an exclusive right to use on a label the appropriate name of a

manufactured article exists only in him who has an exclusive property in the article itself.

§ 241. In *Fetridge v. Wells*,¹ Duer, J., admitted that the name "Balm of Thousand Flowers" is in one sense a fancy name, but not in the sense for which the plaintiffs' counsel contended. It was not pretended that the plaintiffs or their firm had any exclusive property in the compound bearing the well-sounding name, which was used to convey to the minds of purchasers the assurance that the highly-scented liquid was in truth an extract or distillation from flowers, which was not true. He said that it was only the seductive name that they claim as their exclusive property, and doubtless from their experience of its value in the extension of their sales.

§ 242. What decided that it was not a fancy name? The judge's reasoning upon this point is convincing and indisputable. It was not a mere denomination of fancy, because it involved the idea of fraud. Around every bottle sold by the plaintiffs was a printed paper, ascribing manifold and almost miraculous virtues to the "Balm of Thousand Flowers." It said: "It is an innocent, safe, and efficacious compound, of purely vegetable, medicinal, and powerful substances, and *the very balm and extract of healing blossoms.*" These words, said the judge, "put an end to the refuge of a fancy name as an escape from the charge of an intention to deceive. . . . It appears, then, that this pretended balm is produced by a mixture, in certain fixed proportions, of palm-oil, ley or potashes, alcohol, and sugar; and that when this mixture has, by the operation of fire, been fully compounded and prepared, it is rendered fragrant, doubtless to favor the deceit of its name, by the addition of some strong perfume, such as lemon or bergamot, lavender or musk. The result is, that this 'Balm of Thousand Flowers,' extracted from blossoms, redolent of health, is a soap, — a liquid soap, — highly scented it is true, and, it may be, as a soap, useful and valuable, but still a soap, possessing the usual and known qualities of soap, and nothing more. . . . The proof is therefore complete that the name was given, and is used, to deceive the public; to attract and

¹ 4 Abb. Pr. 144, and 13 How. Pr. 385.

impose upon purchasers; that, in the sense that the plaintiffs mean it shall convey, it is a representation to the public that they find to be useful, and know to be false." Another action had grown out of the same state of facts which gave rise to the case of *Fetridge v. Wells*. The two cases should be read together. The other case, which was also in the Superior Court of the City of New York, was, like the preceding, on a motion to dissolve a preliminary injunction granted by Mr. Justice Hoffman.¹ The latter differed materially with his associate judge. He said: "It is constantly insisted, and the position is sanctioned by some judges, that when the article in question is innocuous, or in some degree useful, no absurd panegyric or extravagant price is a reason for denying the interference. In short, as counsel once said before me, if a man should compound tallow with some high scent and beautiful coloring matter, and term it 'The Ointment of Immortality,' he has a right to appropriate so much of public credulity as he can in this designation. On the other side, it is well settled that when the deception consists in palming upon the public articles of the party's own manufacture or composition for those of another who has obtained celebrity or notoriety, the court will not remain inactive."

§ 243. He very truthfully remarked, as a general principle, that the farther removed an appellation is from actually representing the article in question, the more exclusive and decided becomes the right to it; and he cited the case of the "Medicated Mexican Balm,"² which had nothing in its composition peculiar to the land of Montezuma; and the case of "Chinese Liniment,"³ which was in all its ingredients a stranger to the Celestial Empire. It seemed to him, that the term "Balm of Thousand Flowers" was of the same character. The article is a soap, or perfumed liquid soap. That name would be the name of the article, because it would indicate its nature. The term was, in his opinion, extrinsic and not indicative.

§ 244. The foregoing cases of *Fetridge v. Wells* and *Fetridge v. Merchant* have shown how, under a similar state of facts,

¹ *Fetridge v. Merchant*, 4 Abb. Pr. 156.

² 6 Beav. 66.

³ 4 McLean, 516.

two judges of the same court, and both men of high integrity and of acknowledged ability as jurists, may differ in legal conclusions.

§ 245. When A. introduces into the market an article which, although previously known to exist, is new as an article of commerce, and has acquired a reputation therefrom in the market by a name not merely descriptive of the article, B. will not be permitted to sell a similar article under the same name; and this, although the peculiarity of the name has long been in common use as applied to goods of a different kind.¹ Plaintiffs, soap manufacturers in London, introduced into the market a superior kind of white soft soap, which they sold under the name of "The Excelsior White Soft Soap." Vice-Chancellor Wood said, *inter alia*: "But though it is true that the court will not, if it can avoid it, be made the medium of a mere puffing advertisement; still, if, as here, the plaintiffs have a right of sufficient value to induce others to attempt a fraudulent violation of it, the court will intervene to prevent them from being cheated. . . . The defendants urge that 'Excelsior' is merely a mark of quality, like 'Superfine,' or 'Superior'; but there seems to me to be a double answer for this. In the first place, the plaintiffs do not sell two or three qualities of soap, calling one of them 'Excelsior,' and the others by some other name; but they have only one quality, which they denominate 'The Excelsior White Soft Soap,' and there is nothing except itself with which to compare it. But, in the second place, the manner in which, as has been proved, this name is generally used in the market, shows that it is more like such names as 'Victoria,' 'Albert,' 'Eureka,' &c., which are not names of quality, but simply designations for sake of distinction." Injunction granted.

§ 246. The combination of words, "Mrs. Marple's Salve," is not in itself sufficient to warrant recognition, being merely descriptive of an article that any one might make and vend, unless it be protected by a patent. It was claimed by the daughter and successor of the inventor, but even in her hands

¹ *Braham v. Bustard*, 1 Hem. & M. 447; 11 W. R. 1031; 9 L. T. (N. S.) 199.

the Office declined to admit it to registration. When, by an amendment, it was enclosed in a cruciform figure, in each external re-entering angle of which appears the representation of a hand, with the index-finger pointing to the name, all objection was instantly removed.¹

§ 247. "Willow Spring Ice" could not be deemed a valid trade-mark, unless there were but one Willow Spring, and the applicant had the sole title thereto;² for there may be several places bearing the same name, and many persons entitled to take ice from them for the purpose of sale. Yet the applicants made a point of having the words placed upon a trade-mark. This was readily done by making a representation of a pair of ice-tongs grasping a cake of ice, upon which appear the name of the firm, and the words "Willow Spring Ice." It was suggested that another firm in the same place had gone into earnest competition with the claimants for the exclusive use of the name and a consequent monopoly. The mark as amended was registered.³

§ 248. The simple designation, "Thompson Pure Rye Whiskey," would be just as objectionable; but when the mark is an exact representation of the handwriting of a proprietor, it becomes distinctive, and could not be imitated by another in the same trade without the clearest proof of a fraudulent intent. It is then an arbitrary symbol.⁴

§ 249. We know that the word *Damascus*, as applied to steel, implies a fine quality of steel originally made at Damascus, the ancient capital of Cœlesyria, and formerly much valued for sword-blades, from its great flexibility and tenacity; but the application of the words "Damascus Blade" to scythes made in the United States could not possibly convey any false idea of origin, nor could they be considered to be descriptive.⁵

§ 250. As a peculiar mark, one indicating origin and at the same time suggesting the character of the goods, the fol-

¹ Mary A. Paullin, No. 857.

² See Congress & Empire Spring Co. case, 57 Barb. 526.

³ Swett & Crouch, No. 798.

⁴ Charles S. Ross & Co., No. 839.

⁵ Dunn Edge Tool Co., No. 563.

lowing was proposed as a mark for fish: the representation of two fishes crossed in the form of the letter X. Any one seeing this sign could not fail to understand that the tin case hermetically sealed contained fish; for the label would tell the story without words. The Examiner rejected the proposed mark as purely descriptive. On appeal, it was allowed, the Commissioner regarding the emblem as being virtually the letter X made more complex by being constituted of two fishes.¹ An analogous case is that of the words "Hughes and Kimber Lithomachine." The applicant showed that he was the sole agent in this country of certain machines made in England for lithographic printing. The objection was, that the firm name could not be an essential element of a trade-mark, and *Lithomachine* is generic. The application was amended, an arrow being placed back of the words, running the entire length of the line of letters, and connecting them into a single symbol. It was then registered.²

§ 251. Probably the most troublesome question that has arisen in connection with the right to registration was that of the words "Chemical Paint." These words form the main, special, and prominent feature of the mark claimed, the object of which is to produce a distinctive name by which to designate a specific kind of paint, known as the "Averill Chemical Paints," as distinguished from paints prepared in the ordinary mode. The paints manufactured and introduced under this name are produced, in the process of manufacture, by bringing together a part of all the materials in the form of solutions, which act upon each other chemically by interchange of bases and acids, in the manner well understood by chemists. Are not these words purely descriptive? Is not *chemical paint* a generic term? Can such words indicate origin and ownership, or either? The applicant based the claim to a right to an exclusive use of those words upon the fact of being owner of certain patents for making the compound designated. It was asserted that chemical paints had never been known to the arts or to trade, until invented by the person from whom the applicant deduced title. The

¹ J. H. Doxsee, No. 853.

² V. E. Mauger, No. 886.

sole right of making chemical paint, as distinguished from all mechanically mixed oleaginous paints, was shown to be vested in the applicant. If the applicant had the sole right to manufacture the article, why not accord to it (an incorporated company) the sole right to use that name as a trade-mark? Could any one else truthfully employ that designation? The right of the applicant to recognition seemed manifest, unless one point upset all claim. The patents must expire at the end of a certain number of years. The invention would then become public property; and all persons might then manufacture and sell the article called chemical paint. The term would then be generic; and a generic term cannot be a valid trade-mark. But in the use of the word *generic* we must take one thing into consideration. As employed in the discussion of trade-mark law, it means something more than *very comprehensive*. When we speak of a genus, we employ the term as distinct from species; and the idea is conveyed that the articles of the genus are indefinite, and the claim to exclusive right in them quite as indefinite. At the expiration of the life of the patents, all persons may make and sell chemical paints, and the term *chemical paint* may come to mean all paints made by the patentee's process, or by any other mode. The term "chemical paint" is *now* specific, meaning no paint except that manufactured by the applicant. The application was therefore allowed, and the words registered as a trade-mark.¹

§ 252. *A Fancy Name may become Generic.*—The Court of Paris, on appeal, in *Cohen & Co. v. Maris & la Veuve Robert*, in 1863,² considered this proposition. It appeared, in the court below, that petroleum is daily sold in England and in France under the name "Lucilene." The court held that the said denomination had fallen into the public domain, and that the defendants could sell petroleum without committing an unlawful act; and that said name could not be considered a trade-mark applied to a new fabric, being merely the true denomination of a natural product, which any one has the right to sell. The plaintiff had established the fact

¹ Averill Chemical Paint Co., No. 130.

² 10 Annales, 105.

that he was the first who had employed the name, which was to designate mineral oil purified by him. The appellate court affirmed the judgment against the plaintiffs, adopting the views of the lower tribunal, but based its decision somewhat on the ground that the term had become attached to the article before the plaintiffs had taken steps to secure their exclusive title thereto. It was said that the sale of petroleum belongs to commerce in general, under the various names it has conventionally received. This case seems to teach that, as the originators of the name, so applied, had in effect abandoned it to the public, they could not subsequently by any formal acts recover the right to its exclusive use. — Wood, V. C., in 1864,¹ held: Although the word “Chlorodine” might originally have been protected as a fancy name, the complainant abandoned all claim to an exclusive right in it by dismissing the suit begun by him to restrain the use of it; and, in 1873, the Lords Justices² refused to restrain the defendant from using the words “True and Original Chlorodine,” on the ground that they had become the name of the article.³

§ 253. *Name of Object of Merchandise.* — In *Denis & Mounier v. Vignier Dodart & Co.*,⁴ which came before the Court of Bordeaux in 1865, on appeal, we find an interesting decision. The plaintiffs had duly registered, as a distinctive mark for the brandies which they sold in bottles, the device of a grape-leaf, in the middle of which was printed or stamped these words: “G. Denis. H. Mounier et Ce. Cognac, Eau-de-vie vieille,” or “Eau-de-vie très-vieille,” or else “Old Brandy.” The label containing the mark was lithographed in divers colors, but particularly with a ground of gold or silver, with the inscription in white letters. The

¹ *Browne v. Freeman*, 12 W. R. 305; 4 N. R. 476.

² Same parties, W. N. 1873, 178.

³ In 1871, Lord Romilly, M. R., granted an injunction against the use of the words “The Original Reading Sauce,” saying that the word “original” meant that the article was made by the first inventor, the complainant. *Cocks v. Chandler*, L. R. 11 Eq. 446; 40 L. J. Ch. 575; 24 L. T. (N. S.) 379, 19 W. R. 593.

⁴ 12 *Annales*, 430.

defendants marked their bottled brandies with a grape-leaf in gold or silver, on which their names were inscribed in white letters, "Very Old Brandy," and certain ornamentation. The case was well argued before a highly intelligent tribunal, versed in the consideration of questions of a commercial character, and this undoubtedly sound judgment was the result. *Per Curiam*: Property in marks and labels of commerce, guaranteed by law and jurisprudence, upon the fulfilment of determined conditions, should always be restricted to the speciality of the deposited mark; thus, if it consist in a generic object of which the common type is furnished by nature, or by the work of man, that cannot interdict other merchants from employing the same for things of the same genus, provided there exist differences in form, details, or ornamentation.¹ All that is necessary for the preservation of all legitimate rights is, that the differences shall be sufficiently striking to the least attentive eye, that confusion, and consequent prejudice, be rendered impossible. An interdiction more ample, especially when acting upon marks signifying the nature of the product, would transcend the object of the law, and trammel all the interests of commerce. The mark of the plaintiffs consists of a simple leaf of a grape-vine, either in gold, silver, or color, and in which is inscribed the nature of the product, and the name of the commercial house. The mark used by the defendants consists also of a leaf of a grape-vine, which, if not a complete copy of the plaintiffs', at least has a strong resemblance to it; yet it has differences, with different names inscribed thereon, and additional ornamentation; and by its size, details, color, signification, forcibly attracts the eye, and affords no possibility of mistake. Therefore, the use of the grape-leaf by Vignier & Co., under such conditions, cannot work a prejudice to the plaintiffs; and thus their action is unfounded.

§ 254. The foundation of this decision is in the fact that the grape-leaf is in its nature too indefinite and uncertain. One leaf may easily be mistaken for another, for the outlines of leaves of plants of a quite different species, or even genus,

¹ As to general type of objects, see *ante*, § 89 *d*.

bear some resemblance to one another. In addition, the leaf, if recognized as a grape-leaf, is descriptive of the product, or at least suggestive. If in this instance it had been enclosed in a geometrical figure, it would not have been an ordinary imitation of a common object in nature. When representations of plants and flowers were employed in heraldry, they were placed on shields, seals, or flags. We could not well misunderstand the purpose of the rose, the lily, the thistle, or the shamrock, when displayed on armorial bearings, or banners and flags. Such objects, so placed, speak an unmistakable language. They mark, distinguish, identify. We know the knight in armor by the mark upon his shield, although his face is concealed. Is not this the very purpose of a mark of commerce? We observe a clearly defined object stamped, printed, painted, or impressed upon an article of merchandise. We have before this time purchased an article with that exact symbol upon it, and found it suited to our taste, at least, if not of unequalled excellence. But unless the symbol be recognized as, or mistaken for, that which we obtained before, we are in doubt. When there is reasonable ground for doubt, the mark has failed to accomplish its purpose, and is void for uncertainty. Suppose that on the day of a battle or a joust a mediæval knight had met an exact counterpart of himself. Each must have had distinct insignia, so that when he closed his visor he could be distinguished in the fray. The marks on goods, in the strife for pre-eminence, must be as recognizable as the device upon the knightly shield. Broom-corn is not a peculiarly striking object, and the representation of a sprig of it would not attract much attention unless found upon heraldic equipments; but then we should recognize in it the *Planta genista*, which gave to the Plantagenets their name. It had been adopted for a specific, well-understood purpose. So was the *fleur-de-lis*, and so were an infinite number of other natural objects, which by their figurative imagery concentrated a wide range of thought within the narrow compass of an escutcheon.

§ 255. *A Picture as a Trade-Mark.*— Can such be? Some judges have said to the contrary. We are left in doubt, until

a full examination shall have elucidated the matter. A passing remark, or a careless syllabus, may mislead. We will be cautious. An elaborate picture, made up of many different objects in nature and art, is, to say the least, a very uncertain indication of exclusive proprietorship. Another picture may be composed of objects of quite a different nature, dissimilar in all the *minutiæ*, yet having the same general groupings, lights and shades, and general effect. There is a possibility of such a representation becoming so well known as to be a veritable mark for merchandise; but that possibility is remote. In the case of *Wolkinburg v. Lucy*,¹ in the Supreme Court of California, in 1868, it was doubted whether a picture could be made such mark. The plaintiffs' label has "a highly colored picture, representing a washing-room, with tubs, baskets, clothes-lines, &c. There are two tubs painted yellow, at each of which stands a female of remarkably muscular development, with arms uncovered, and clad in a red dress which is tucked up at the sides, exposing to view a red petticoat with three black stripes running around it near the lower extremity. Each is apparently actively engaged in washing; and clouds of steam are gracefully rolling up from the tubs, and dispersing along the ceiling. In the background is extended across the room a clothes-line, upon which are suspended stockings and other under-garments, which have evidently just been put to use in testing the cleansing properties of the plaintiffs' washing-powder. To the left of the washerwoman stands a lady in a yellow bonnet, red dress, green congress gaiters, and hoops of ample circumference: upon her left arm is suspended a yellow basket, and in her left hand is held a red parasol; while the other hand, which is encased in a green glove, is gracefully extended toward the nearest washerwoman in an attitude of earnest entreaty. In the immediate foreground is a yellow and green clothes-basket full of dirty linen, and a yellow and green soap packing-box upon which are printed, in small capitals, the words 'Standard Co.'s Soap.' Each wash-tub is supported by a four-legged stool, — some of the legs being yellow, some red, some

¹ 35 Cal. 52.

green, and some all three. The floor of the room, as to color, is in part of a yellowish green, and in part of a greenish red, while the walls are of a grayish blue. This is but an imperfect description of the picture with which the plaintiffs' label is adorned. The design is good, for it is eminently suggestive of the character of the plaintiffs' goods."

§ 256. So said Sanderson, J., in delivering the opinion of the court. Yet it was only for the sake of argument that he conceded that it could be a trade-mark at common law. In support of his doubt, the judge cited *Partridge v. Menck*,¹ in which case both labels were embellished with wood-cuts of a bee-hive, yet the preliminary injunction was dissolved. When we examine for ourselves, we find that the plaintiff in that instance failed because his label contained upon its face a misrepresentation of fact. He claimed the exclusive right to impose upon the public friction matches made by himself, as if made by A. Golsh. He had not come into court with clean hands. The judge also cited *The Merrimack Manufacturing Co. v. Garner*.² Attached to the complaint in this case were specimens of the tickets of both parties. They were of nearly the same size, each being about six inches long by four wide, and in the shape of a parallelogram scalloped at the corners. Both were printed on straw-colored paper, of almost precisely the same shade. Each had a border line with corner ornaments, an oval wreath of flowers within the border, and an inscription within the oval wreath. The border lines were almost precisely the same. The corner ornaments differed considerably. In the plaintiff's label there were light lines whose tendrils extended beyond each side of the parallelogram toward the opposite corner, with considerable space between. The defendant's corner ornaments were different, being much heavier, and the arms of each extended and met those of its neighbor in the opposite corner, so that the four together formed a continuous border around the label. The design of the oval wreath of flowers— which was the most conspicuous ornament in the plaintiff's label — was almost

¹ 2 Sand. Ch. R. 622; 2 Barb. Ch. R. 101; and 1 How. App. Cases, 558.

² 2 Abb. Pr. 318, and 4 E. D. Smith, 387.

precisely the same in both tickets, but it was much more nicely executed in the plaintiff's label than in the defendant's. At the foot of each wreath was a blank space, left for the insertion of the number of yards in the piece. This number, in the plaintiff's label, was printed: in the defendant's it was written with a pen. The inscription in the plaintiff's label consisted of two lines curving with the sides of the wreath, and a sort of ornamental scroll between them. The upper lines contained the words "Merrimack Prints," the lower line the words "Fast Colors, * Lowell, Mass." The inscription in the defendant's label consisted of three lines, the upper and lower of which were curved like the lines in the plaintiff's inscription, and the middle one occupied the place of the scroll used by the plaintiff. The words were: "English Free Trade. Merrimack Style. Warranted Fast Colors." All the judges regarded the pictorial part of the label as of little consequence, basing their decision upon the use of the words.

§ 257. In *Spottiswoode v. Clarke*,¹ an English case, the Lord Chancellor dissolved an injunction which the Vice-Chancellor had granted, with liberty to the plaintiff to bring an action at law, where the plaintiff was the owner of a publication called "The Pictorial Almanac," and the defendant of one called "Old Moore Family Pictorial Almanac," although the corners of each book were somewhat similar; both being decorated with a pictorial representation of the Observatory at Greenwich, and in the title, as printed on the cover, making use of nearly the same expressions. But that case does not throw much light upon this point.

§ 258. Here comes a French case that may help us. In the Court of Riom, in 1852 (*Bru v. Larband*²), it appeared that the plaintiff, a pharmacist of Vichy, had adopted as his mark for his pharmaceutical product (a mineral salt of Vichy) a printed representation of the thermal establishment there situated. The defendant having imitated the said mark, the plaintiff sued. The court said that it mattered not that the vignette used by the plaintiff represented a public establish-

¹ 10 Jur. 1043.

² Journal du Palais, 1855, p. 244.

ment belonging to the state, and one that before then had been used on scientific publications; and that it is allowable for any person to use such picture as his designation of commerce, provided he is the first to appropriate it to a particular class of goods.—This decision, it must be confessed, goes to an extreme length. But it is sufficient to show that a mere picture may be a trade-mark.

§ 259. A picture made up of many objects in various colors may be a trade-mark. The Patent Office has, almost daily, passed upon the question. It is not, of course, every picture that will be registered; for many that have been presented have been refused, because either merely descriptive of the class of goods to which they were intended to be affixed, or not adapted to the purpose. The first trade-mark registered under the act of 1870 was one of the Averill Chemical Paint Company. This consists of an elaborate pictorial representation. In the foreground is a rock with the word "Chemistry" upon it; on the rock is an eagle, holding in his beak a paint-pot or canister and brush, and a ribbon or streamer on which are the words, "Economical, Beautiful, Durable." There is water, and upon it are a steamer and other vessels. In the background is a bridge, and a train of railway cars, and buildings of various kinds. Who could mistake such a picture for a mere specimen of artistical taste? It speaks plainly. It says, "I am a trade-mark." This very picture was soon afterwards imitated in its general effect, and the imitation presented for registration by one in the same line of business. Accident could not possibly have made the two marks so much alike. Both, at the distance of a few feet, would make the same impression upon the eye; and any but the most cautious purchaser might take one for the other; but, upon close inspection, it appeared quite a different thing. The simulation was too evident. The second case was accordingly rejected.

§ 260. Trade-marks not unfrequently are borrowed from the mediæval heraldry of Europe, rich in a symbolical language, in which figures, devices, and colors were employed instead of letters. Caution must be observed in appropriat-

ing time-honored heraldic compositions, for each of these has its own definite and complete signification, conveyed through its direct connection with some particular individual, family, dignity, or office, and held by express right and title. As a mark of commerce should be good for the purpose all over the world, it would be well for him who purposes to adopt the crest of some ancient family to designate his wares, to inquire whether a foreign court might not set it aside.¹

§ 261. In the Tribunal Civil of the Seine, in 1870, in the case of *Christy v. Dande*,² the following was *held*: Although the national arms are not susceptible of private appropriation, they can concur with other distinctive signs (for example, the name of the merchant) to constitute an industrial mark. The trade-mark claimed by the plaintiff consisted of the arms of England, with a circular inscription on the ribbon of the garter, and the words "Christy's London." The defendant, for the same class of merchandise as that sold by the plaintiff, took the same design of the arms, but on the ribbon substituted for "Christy's London" the words "Quality Superfine London." This was held to be an infringement. — In 1875, Monell, C. J., held that a copy of the arms of the city of Paris might be an essential element of a trade-mark.³ But nearly all nations now refuse to include public arms as trade-marks. One of the latest instances is the regulation of the Empire of Japan, of June 7, 1884, which expressly forbids the use of national arms, either foreign or domestic, for such purpose.

§ 262. Monograms and ciphers have been used as proprietary or trade-marks for many centuries, especially by painters and engravers. Many great masters seldom or never signed

¹ One's family crest may be an essential element of his trade-mark (*Beard v. Turner*, 13 L. T. (N. S.) 746; *Hargreaves v. Smith*, Cox's Man., case 338; *Steinthal v. Samson*, Id., case 546; *Re Brook*, 26 W. R. 791); except when it conflicts with another symbol previously adopted for the same purpose (*Standish v. Whitwell*, 14 W. R. 512; *Hargreaves v. Smith*, *supra*); and so may family arms, on the same condition (*Re Farina*, 26 W. R. 261; *Re Rosing*, Ct. of App., 1 Trade Marks, 371).

² *Le Technologiste*, No. 365, p. 286.

³ *Godillot v. Hazard*, 49 How. Pr. 5.

their works in any other way. Michael Angelo and Raffaele were examples. Although in a painting such a designation is no certain sign of authenticity, — for every master has his imitators, — in an engraving of old times it is generally trustworthy. Some of them employed singular or fanciful marks, as birds, animals, houses, usually having some reference or allusion to the name of the artist. Thus Jerome Cock marked his plates with two cocks fighting; H. C. Bles, with an owl on a branch, or in a cage; Hans Adam, with a naked figure under a tree, with his initials; Hans Schaufflin, with a small shovel, or two shovels crossed, with his initials, — his name signifying, in German, *small shovel*; Martin, with a little bird of that name; Leech, with a bottle containing a leech.¹

§ 263. *Is Color ever an Essential Element of a Trade-Mark?* — Yes. It may serve as the groundwork of a mark, or the mark may at the pleasure of its owner be made in any color, or in all colors. Nearly always in practice the mark is in black, which is not a color, except in heraldry. One trader may adopt a red cross as his symbol, and another may choose a black cross to designate the same class of goods. A large proportion of the marks of manufactures and commerce are borrowed from heraldry. Among the earliest shields and banners, most of them remarkable for simplicity, many are found to be without any device whatever, their distinction consisting in some peculiarity of coloring. The renowned banner of the Knights Templars, by them called *Beauseant*, is black above and white below, to denote that, while fierce to their foes, they were gracious to their friends. In English heraldry five colors were used, — blue, red, black, green, and purple.² When so used, one could not well be mistaken for the other; but this cannot always be said of small labels bearing the symbols of trade. The emblem of the *Blue Bear* might easily be confounded with that of the *Black Bear*. The impression left upon the retina of the eye is of an animal of a certain kind and physical conformation. If, by simply changing the hue, one man could take the same sign that

¹ Spooner's Dictionary of the Fine Arts.

² Boutell's English Heraldry, p. 13.

a rival in trade has taken, there would not be much safety. The sign which was originally black might, by exposure to the atmosphere, become blue or gray; and a blue might darken into a black.

§ 264. The disadvantages of a reliance upon color alone are so apparent, that preference is usually given to the device that is its vehicle. Black and white, which are accidental to each other, are not confounded. Red and blue in juxtaposition borrow from each other, and assume a purple hue when seen at some distance. Colors may be arranged so as to neutralize each other. The *death* of a color takes place when the primary colors come together in equal proportions. Two persons may not see the same colors alike. To give an eye for color is no more possible than to give an ear for sound. The defective vision called "color-blindness" confounds a color with its accidental one. It is said that, in England, one man in every seven hundred and fifty is unable to distinguish a certain color from another, as red from green. To some the soldier's red coat and the grass of a field are alike.¹ This is probably as true of our own country as of any other. We have doubtless all known of such cases.

§ 265. Yet color may be of the essence of a mark of manufacture or commerce, known as a trade-mark. National flags are sometimes blended with other objects to catch the eye. They are admirably adapted to all purposes of heraldic display; and their rich glowing colors appeal to feelings of patriotism, and win purchasers of the merchandise to which they are affixed, albeit the while the wily vendor may laugh in his sleeve. One flag printed in green may catch the eye of the son of the Emerald Isle, who would turn with indifference from a flag of the same size and shape printed in red; another flag, with stars on a blue field and stripes of alternate red and white, may secure a preference for the commodity upon which it is stamped.

§ 266. A particular color may be made an essential feature of a mark, at the option of its adopter; but it is taken subject to some risks. If one select a red cross as his symbol, he is

¹ Wilkinson on Color and Taste. London, 1858.

concluded by his choice, and cannot complain if another in the same line of business adopt the blue cross. It must be definite and certain. Caution should be observed in selecting an arbitrary color, which would conclude by its own limitation. For this reason, the delineation of the emblem is relied upon rather than the chromatic effect. A rose is a rose; for on a label stamped with fugitive colors the *red* rose of Lancaster might soon turn into the *white* rose of York.¹

§ 267. Color is frequently an important circumstance in determining the question of infringement. The fact that one trader has exactly imitated the tints of another's label may be conclusive, when there would otherwise be doubt. In practice, we find that such is oftentimes the case. The technical mark may be but partly simulated, and seem to be but an accidental coincidence. Then the use of the same colors in the same manner will advance and tell a tale of guilt. Look at a United States bank-note, printed mainly in one color, — that which has given it the name of "greenback." We may regard the red seal printed on the face of the note as one of the trade-marks of our government. Suppose that an action were brought for an infringement. The general features of the print may be identical, so far as mere design is concerned. But the seal is printed in green, the back in red, and that which is black in the genuine in blue. Who could pronounce the copy of the figured lines a counterfeit? If not calculated to deceive, it would not be such.

§ 268. In the Court of Paris, in 1861,² the question of color came up. To distinguish their manufacture from that of others, the plaintiffs had adopted, for the drillings made by them, a bordering composed of *four rose-colored* threads at the end of each piece. The defendants adopted as their mark for the same class of goods a bordering composed of *two red* threads. For this supposed infringement suit was brought. The court said that the *red* mark had an almost complete

¹ Sect. 67 of the British Trade Marks Act of 1883 contains a new and important provision in respect to *color*, no notice of which as an essential had been taken in the act of 1875-76. The defect therein was much discussed in *Re Worthington & Co.'s Trade-Mark*, 14 Ch. D. 8.

² *Ricque et al. v. Forges*, 8 Annales, 25.

similarity with the *rose-colored* mark, — a similarity which was augmented or diminished according to the color of the texture; but the similarity was sufficient, when the textures of the two parties were not brought close together, to deceive consumers, and lead them into error as to the origin of the products; and that the choice of a mark which, according to the disposition of the threads and the color of the tissue, can approach or remove in aspect from that of the plaintiffs, constitutes on the part of the defendants a precaution which reveals a fraudulent intention, especially as they did not make choice of a *red* thread until the success of the plaintiffs' drillings had become well established. — In the Court of Nîmes, in 1877, the plaintiffs had deposited as a trade-mark a thread dyed blue, in the centre of a miner's match manufactured by them.¹ The court said: "Color by itself may sometimes be insufficient to constitute a trade-mark, that is when the color, being isolated from all combination, may with difficulty serve as a distinctive sign. Thus it has been adjudged, that, as a natural tint given by the fabrication of a product cannot constitute a color-mark, and as an artificial color, extending throughout a product, constitutes less a distinctive color than a commercial quality of the merchandise, therefore under these conditions color cannot lead (except in case of a patent) to a right of user to the exclusion of other manufacturers. But the moment that a color, whether by adoption of special dispositions, or by the application of the color itself to certain parts of the product, whatever otherwise might be the simplicity of said combinations, succeeds in constituting a distinctive sign, susceptible of striking the purchaser's eye, it enters into the category of signs not enumerated by Article 1 of the law of June 23, 1857, that may serve as marks of manufacture."² — In the Court of Douai, in 1881,³ the facts were as follows. Certain thread manufacturers had adopted various colors combined in certain ways, to indicate different kinds of thread. The

¹ Davey, Bickford, Watson, & Co. v. Nier, 26 Annales, 81.

² See French law, in Appendix.

³ Ph. Vrau & Co. v. Pouillier-Loughaye *et al.*, 26 Annales, 92.

plaintiff's marks consisted of four endings (*lisérés*), to wit, Solferino-red, blue, black, and *écru* (a sort of straw-color). *Held*, on appeal, that every one of the borderings, by its disposition and apposition of colors, by the places that they occupy, by the aspect that they give to the complete combination, embraces all the elements of the mark protected by said Article 1 of the law of 1857. That if a color by itself, independent of all form, of all substance, and of all particular disposition, cannot suffice to constitute a mark, it is otherwise when this color, localized according to certain dispositions by intentional combination, and apposition to other colors environing, gives a design of color or a determinate form. It is vain to object, that thereby, colors being limited, is created a monopoly contrary to the liberty of commerce. Besides, nothing obliges manufacturers to use a bordering of color as a distinctive mark, nor, above all, of a bordering combined so as to lead to confusion between their products and those of rivals. — The same kind of a case came up in England, in 1880, in *Mitchell v. Henry*.¹ The trade-mark for worsted goods, upon which the argument turned, was described in the Trade Marks Journal of January 13, 1877, as follows: "A white selvage on each side of the piece having a red and white mottled thread interwoven the full length of the selvage between the edge of the piece and the edge of the selvage." Jessel, M. R., said that he had registered the trade-marks (seven in all) very unwillingly, and that, if the registration were good for anything, it was because the colors make the distinctive device. All the seven registered marks were alike with this distinction, that the interwoven thread varied in color. The first was a blue and white mottled thread, the second a red and white mottled thread (which is the one under consideration), the third a yellow and white mottled thread, the fourth a violet and white mottled thread, the fifth a brown and white mottled thread, the sixth a green and white mottled thread, and the seventh a black and white mottled thread. The defendant put in another device with three colors, to use the language of the court, "white, if it is

¹ 15 Ch. D. 181.

white, and red and yellow. The only difference between the seven is that you put yellow instead of red. If you add yellow to the red, there is a double variation. Instead of having two colors, you have three, and one of them is a different color, and so different that the applicants consider it makes a new mark, and they change yellow for red, or violet for blue, or whatever the color is." He confessed himself to be quite nonplussed in regard to distinguishing the colors; for the dye had affected the yellow and red very much in the case of both plaintiff and defendant, and said that he was asked to disbelieve the evidence of his own eyes. On appeal, Thesiger, L. J., said: "I cannot say by the evidence of my own eyes whether the threefold thread used by the defendant might not, even to the eyes of an expert, be a colorable imitation of the twofold thread used by the plaintiff. It appears to me that that must be a matter of evidence, and evidence of experts." It was, accordingly, directed to stand over until the conflict of evidence could be decided.

§ 269. *Form* is necessary to make *color* an essential feature of a trade-mark. In other words, color alone cannot legally be deemed to be an arbitrary symbol. That form may be a geometrical figure, or the representation of an object having a fixed, definite shape, and being susceptible of description: thus, a circle, a square, a triangle; or an arrow, or an anchor, or a monogram; or any of an infinite variety of objects in nature or art, which may be easily described, and readily apprehended. But nothing short of this requirement could be sufficient. Who could impart or receive a precise idea of a tree, a cloud, or even a human being? A trade-mark must be something that can impress its peculiarity of configuration upon the memory, as plainly as it is impressed on goods. We can describe and recognize a Maltese cross, a diamond within a circle, a five-pointed star, a flag of fixed proportions having a certain number of stripes and stars, or national emblems. Then color may well be a valid essential constituent; but it is hardly within the range of possibility to convey an adequate idea of a thing that has no fixed invariable limits. In the

Court of Douai, in 1881,¹ it appeared that the plaintiff had duly registered, as a trade-mark for sewing-thread, an envelope of a blue color (fancifully called by him a *capsule*, although not such in reality), combined with other matters. One of the points of defence was that the blue color could not be an essential element. *Held*: As to the blue color of the capsule, although it is true that a color in itself cannot, independently of all form, of all substance, and of all peculiar dispositions, suffice to constitute a trade-mark, it is otherwise when such color is, as in the envelope of Crespel & Descamps, applied to an object of a determinate form, put in apposition with other colors, placed in special lines and particular designs, and by the agency of different elements constituting a clearly characterized whole.

§ 270. This matter may seem like the veriest enunciation of truisms. Why waste ink and paper in such incontrovertible statements? Let censure be deferred. All sorts of visionary conceptions are uttered in this world of fancies. In 1884, notwithstanding the light that published opinions of courts had shed upon this very subject, it was insisted on that a bag for seeds, a bag of no particular shape, having no peculiarity or striking feature, might be a trade-mark, provided its color were red.² The following is an instance of a false conception as to the function of mere colors.³

§ 271. The applicant for registration of a supposed trade-mark for indelible ink thus described his mark: "My trade-mark consists of a bright yellow-covered wrapper enveloping the metallic case holding the bottle of indelible ink, and forming the ground upon which is pasted or glued a bright red label, upon which is inscribed the words, 'Payson's Indelible Ink, for marking Linen, Silk, and Cotton with a Common Pen without a Preparation. Price 37½ cts.'" Below this label, and upon the wrapper paper, is a caution against spurious and worthless imitations, with the fac-simile of the

¹ Crespel & Descamps v. Dayez fils aîné & Co., 29 Annales, 335.

² See Case of Oliver Landreth, ante, § 89 d.

³ In Harrington v. Libby, in 1877, in the U. S. Circuit Court, the court approvingly cited the two sections following this. 12 Off. Gaz. 188.