

work, device, or design surrounding them, and the maker's name, could not deceive or mislead any purchaser by the dozen packages or bundles. The motion to continue the injunction was accordingly dismissed.

§ 422. The following case of *Howe v. The Howe Machine Co.*,¹ at a general term of the Supreme Court of New York, in 1867, illustrates the same doctrine. The facts sufficiently appear in the following extract from the opinion of Sutherland, J. That Elias Howe, Jr., in 1846, obtained a patent for a certain combination of mechanisms called a sewing-machine; that his brother, the plaintiff, began manufacturing sewing-machines as early as 1854, and continued to manufacture them at least up to the time of the arrangement between him and Elias Howe, Jr., in 1862; and that the plaintiff in his manufacture used the combination of mechanisms patented by Elias Howe, Jr., as his licensee. Elias Howe, Jr. did not license the plaintiff to make sewing-machines, but licensed him to use his patented right or combination in the manufacture of sewing-machines. There is nothing in the case to show that the plaintiff manufactured the machines as agent for Elias Howe, Jr. The fact that he was his licensee, and that he could not have manufactured the machines without his license, does not tend to show the agency. 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, Taylor, the plaintiff's mechanic, suggested the substitution of "Howe" for "A. B. Howe," which suggestion was adopted by the plaintiff, and subsequently every machine manufactured by the plaintiff had the word "Howe" in a conspicuous place on it. 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. It is obvious that the fact that the plaintiff was the licensee of Elias Howe, Jr., and that the plaintiff could not have manufactured his machines without using the patented combination of his brother, and therefore

¹ 50 Barb. 286; R. Cox, 421.

could not have manufactured them without his brother's license, did not and could not interfere with or impair his right to adopt and appropriate a trade-mark, to mark or distinguish the machines manufactured by him from those manufactured by other licensees of his brother. It is equally 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. — This enunciation of the law the judge based upon the cases of *Sykes v. Sykes*, and *Croft v. Day*, especially the conclusion of the opinion of the Master of the Rolls in the latter case. He further said, that the words "The Howe Machine" are descriptive of the trade-mark "Howe," or "Howe, N. Y.," used on the plaintiff's machines.

§ 423. *Commentary.* — This case is apt to mislead the superficial observer, and even for a moment stagger the preconceived notions of one used to critical examination. It has been cited more than once in support of this absurd proposition, to wit: When two men in the same trade have the same surname, one may employ that surname as a trade-mark to the exclusion of any such right by the other. That is, when the two brothers Howe made and sold sewing-machines, the one who first stamped his surname upon a machine was the sole possessor of the right to stamp his workmanship with his true name. This conclusion has no warrant from any authoritative source. In fact, when we again scan the opinion of Mr. Justice Sutherland, we doubt his intention to convey any such fallacious idea as his language seems to import. The question before the court did not require any expression of opinion as to the abstract right of the plaintiff to the name, in the absence of fraud on the part of the defendants; and the good faith of the defendants is manifest from the unanimous decision of the court, denying the demand for an injunction. Leonard, P. J., said: "There is no fraud

upon the plaintiff in the use, by the defendants, of the name of 'Howe,' in designating a machine manufactured by them, which Elias Howe, Jr. had invented, and from whom the defendants derive their right to use the name." We might abandon further investigation into the occult utterance of the judge first cited, if it were not for the impression made by his citation of the two English cases, in support of his proposition that "the plaintiff had a right to adopt and appropriate his surname as a trade-mark," etc. Let us turn to *Sykes v. Sykes*. What were the circumstances of that case? Two men of the same name and trade, one, the plaintiff, with an established business reputation and a patent; the other, the defendant, stamping his shot-belts and powder-flasks with the words "Sykes' Patent," and so falsely representing his goods as manufactured by the plaintiff. We see that there is no analogy between the Sykes case and that of Howe. Now read *Croft v. Day*. A blacking manufactory had long been carried on under the firm of Day & Martin, at No. 97 High Holborn, London. 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 No. 90½ Holborn Hill, and sold their 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. An injunction was granted to restrain the continuance of so palpable a fraud. The Master of the Rolls, an able judge (Lord Langdale), said that "in such cases there must be a great variety of circumstances; and the court must deal with each case according to the nature of its peculiar circumstances. The accusation which is made against this defendant is this: that he is selling goods under forms and symbols of such a nature and character as will induce the public to believe that he is selling the goods which are manufactured at the manufactory which belonged to the testator in this case. . . . My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the name of Day & Martin, but upon the fact of the defendant using those names in connection with cer-

tain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself, to which he is not, in fair and honest dealing, entitled. Such being my opinion, I must grant the injunction restraining the defendant from carrying on that deception. He has a right to carry on the business of a blacking manufacturer honestly and fairly; he has a right to the use of his own name: I will not do anything to debar him from the use of that, or any other name calculated to benefit himself in an honest way; but I must prevent him from using it in such a way as to deceive and defraud the public, and obtain for himself, at the expense of the plaintiffs, an undue and improper advantage." The Howe case lacked the ingredient of fraud, or false suggestion. Howe, the inventor of the mechanical combination, had given it a name: it was "The Howe Sewing-Machine"; and no other designation would have been so appropriate. Whoever had a right to make and vend the article had an equal right to call it by its proper appellation. That being conceded, it necessarily follows that that portion of the syllabus of the case which reads thus: "That the plaintiff had a right to adopt and appropriate the word 'Howe,' as a trade-mark, as against Elias Howe, Jr.," is erroneous in the superlative degree. The mere name of the manufacturer cannot in any case become a technical trade-mark, notwithstanding numerous *dicta* to the contrary. The error on the part of the judge was to use the term "trade-mark" in a vague, indefinite sense. We set out with the idea of demonstrating that *Howe v. The Howe Machine Co.* is not a trade-mark case, and at its worst phase nothing more than a possible case of unfair competition. This has been done.

§ 424. The case of *Derringer v. Plate*,¹ in the Supreme Court of California, in 1865, seems at the first glance to hold that a man's name may at common law be used by him as a trade-mark. Let us see if the court did so decide. This was an appeal from a District Court. The plaintiff averred that he was a resident of Philadelphia, and upwards of thirty years

¹ 29 Cal. 292; R. Cox, 324.

before had invented a pistol, known as "Derringer's pistol," and adopted as a trade-mark for the same the words "Derringer, Philadel.," which ever since had been his trade-mark, and which he had caused to be stamped on the breech of all pistols manufactured and sold by him; and that the defendant, since 1858, had been engaged in the manufacture of pistols, at San Francisco, similar to the plaintiff's, on the breech of which he had stamped plaintiff's trade-mark, etc. Defendant had judgment on demurrer, and plaintiff appealed. The contention made by the respondent in support of the demurrer to the complaint was, that the statute of California in relation to trade-marks had, in effect, repealed the common law; and that the appellant, in order to maintain his action, must show affirmatively that he had complied with the requirements of the act passed April 3, 1853. The response was, that the statute does not take away the remedy at common law; that it is an affirmative statute; and that an action might be maintained both at common law and under the statute. The substance of the rule as laid down in the cases is, that where a party has a remedy at common law for a wrong, and a statute shall have been passed giving a further remedy without a negative of the common-law remedy, expressed or implied, he may, notwithstanding the statute, have his remedy at common law.¹ The Supreme Court, by Rhodes, J., said, *inter alia*: "The only question presented on the appeal is, whether the statute of 1863, concerning trade-marks, repealed or abrogated the remedies afforded by the common law in trade-mark cases. The plaintiff does not allege a compliance with the provisions of the statute. He contends that the remedies given by the statute are cumulative to those which a party was entitled to at common law; and the defendant insists that the statute forms a 'complete scheme' in respect to trade-marks, and thereby repeals the common-law rules relating to the same subject matter." — When we read the case for ourselves, we indeed find that the judge was strictly correct in stating that ques-

¹ *Wheaton v. Hubbard*, 20 Johns. 192; 13 Id. 322; *Almy v. Harris*, 5 Id. 175; *Clark v. Brown*, 18 Wend. 213.

tion to be the only one on appeal. The court was not required to pass upon the validity of a name of a manufacturer as a common-law trade-mark; nor indeed was the mere name presented, for it was coupled with the word "Philadel.;" and even if nothing more than the name of Derringer had been relied on as a mark or emblem, that name may possibly have been stamped on in peculiar characters, as a copy of his autograph, which would have given it a distinctive individuality, and have imparted to it the essential characteristics of the symbol of commerce. We here have the words of the court in awarding judgment: "We do not fully agree with counsel for either party in his construction of the act in respect to its relation to and effect upon the common-law remedies. The remedies provided by the act (at least those applicable to registered trade-marks) are not cumulative to those possessed at common law, but in that respect provision is made by the act for a new case; nor do we think the act forms a 'complete scheme' of itself, in the sense that counsel regards it, as requiring all trade-marks to be registered under the act to entitle them to protection; though it may be regarded as a 'complete scheme' in the respect that it grants certain remedies in cases of registered trade-marks, and expressly reserves to the owners in other cases the usual remedies enjoyed at common law. Judgment reversed, and the cause remanded, with directions to the court below to overrule the demurrer." We must look farther, if we think it possible that any court has solemnly decided otherwise. We rest, therefore, on the proposition, that one cannot use his *mere* name as a trade-mark.

§ 425. The remarks of Paxson, J., in the case of *Gillis v. Hall*,¹ seem to countenance the opinion that a man may turn his surname into a trade-mark; but if we scrutinize the whole record we shall come to an opposite conclusion. It was there alleged, and not denied, that the defendant Hall had begun the manufacture and sale of an article which he designated as "R. P. Hall's Improved Preparation for the Hair," and that upon the wrapper of his bottles were printed these

¹ 8 Phila. 231; 3 Brewster, 509; R. Cox, 536.

words: "R. P. Hall's Improved Preparation for Restoring the Hair. This preparation is entirely different from Hall's Vegetable Sicilian Hair Renewer, but is compounded by the same inventor, R. P. Hall." If we refer to another case by the same title,¹ we find that the plaintiff and the defendant had been partners in business, in making and selling a certain preparation called "Hall's Vegetable Sicilian Hair Renewer." On the 15th of June, 1865, in consideration of the sum of \$30,000, the defendant Hall sold to the plaintiff all his, said Hall's, interest in the firm, in the secret of said preparation, the right to make and vend the same, and the exclusive right to use his name therefor in the future sales thereof. This agreement contained covenants as follows: 1. That he will not use, or allow his name to be used, in the preparation of any similar articles; 2. That he will not engage in the manufacture thereof; 3. That he will not impart to any one the secret or recipe for the manufacture thereof; 4. That he will not engage in the manufacture of any article similar to this; 5. That he will allow the plaintiff the free, uninterrupted, and exclusive use of his name in the manufacture and sale of said preparation;—and a stipulation to forfeit the said sum of \$30,000, if he violated any of said covenants. Upon a violation of the said covenants, Gillis applied for an injunction. Hall denied the right of the plaintiff to equitable relief, for the reasons that those covenants were in restraint of trade, and therefore void. The objection, so far as it applied to a general restraint of trade, was held to be well taken, as against the policy of the law. Said Paxson, J.: "He may manufacture and sell as many articles as he may desire for the preservation of the hair; but he may not manufacture, or sell, any of such articles as and for 'Hall's Vegetable Sicilian Hair Renewer.' The right to make and vend an article with that particular name and trade-mark he has parted with. He has bartered away his name, so far as the right to apply it to this preparation is concerned." Thus we observe what question was before the court. The defendant had broken his agreement, and had gone into unlawful com-

¹ 2 Brewster, 342; 7 Phila. 422; R. Cox, 580.

petition with his former partner. Now, upon a rule to show cause why he should not be punished for contempt, in disregarding the order and decree of the court in the above-mentioned case of injunction, the judge said: "The said defendant has certainly misapprehended the scope of that decree, as well as the meaning of the term 'trade-mark.' He may lawfully make any article known to commerce, which is unpatented, but he may not apply the trade-mark of the plaintiff to any such article. It is also to be observed, that there is a wide distinction between covenants not to engage in trade and covenants to restrain the use of a trade-mark. The former may be void as being against the policy of the law, while the latter, not being obnoxious to any such objection, will be enforced. In this case, the defendant Hall has taken from the plaintiff's trade-mark that which gives it its chief value, viz. the name of 'Hall,' and placed it upon his own. The plaintiff's article is known as 'Hall's Vegetable Sicilian Hair Renewer.' Strike the name of 'Hall' therefrom, and its distinctive characteristic as a trade-mark is gone." The general conclusions of the judge are indisputably correct; and the only error therein consists in the improper use of the term "trade-mark." In the definition of the term, we find that the manufacturer's own name is not an essential part of the mark, although frequently combined with the symbol that constitutes its essence. What was the real trade-mark? Certainly not the words in common use to designate the name of the article, the words "vegetable hair renewer." The word "Sicilian" is the only word that can stand the test as a fancy appellation, an arbitrary symbol; and it would be worthless for the purpose of the law if it were called into requisition to imply that the article of hair preparation was really Sicilian, i. e. made in Sicily. The case is simply thus: the defendant indirectly violated the plaintiff's trade-mark by using the symbol "Sicilian" in a covert manner, calculated to deceive the public and divert custom from his rival in trade; and all the language of his advertisement upon the bottles was calculated to create the impression that he sold the well-known article, or one superior to it. Doubtless

justice was done in every respect, except to language, by the incautious use of technical phraseology.

§ 426. *Curtis v. Bryan*¹ is a case where the defendant simulated the label of the plaintiffs, adopted a stamp similar to the plaintiffs', and fraudulently sold the article under the name of the original inventor, as Mrs. Winslow's Soothing Syrup. The plaintiffs' preparation had been in public use for nearly twenty-five years, and had an established and very valuable reputation. The name of Mrs. Winslow may be said to have lost its primary signification, and to have become a mere emblem, as in the case of the use of the historic name of "Roger Williams."² The equity was clearly with the plaintiffs, and the defendant had, by unfair and dishonorable practices, sought to avail himself of, and turn to his own account, the labor and the expense which the plaintiffs had borne for years, to bring their article into favorable notice and general use. He would have the public believe that the article he was selling was the plaintiffs'. It mattered not, so far as the principles of justice were concerned, whether the name did constitute a fancy denomination or not; for the general statute of the State embraced all cases of the kind, — the imitation of labels, stamps, etc., — and the controversy before the court did not need any nice distinction in terms. We will continue the search.

§ 427. In *Jurgensen v. Alexander*³ it appeared that for twenty years previous to the suit the plaintiff was a manufacturer and vendor of watches in Switzerland and Denmark. It was found by the courts that the trade-mark used by the plaintiff for the purpose of distinguishing and designating the watches manufactured by him was "Jules Jurgensen, Copenhagen," and that said trade-mark was so used and employed by him on all such watches so manufactured or sold by him, being inscribed on the cap or inside back of each watch; and that in the faith and credit of the said mark the watches were bought, sold, and dealt in, and had acquired a

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

² *Barrows v. Knight*, 6 R. I. 434; R. Cox, 238.

³ 24 How. Pr. 269; R. Cox, 298.

wide-spread reputation and extensive sale. It was also found that the defendant, a dealer in watches and other merchandise, had exposed for sale four watches purporting to be manufactured by the plaintiff, and bearing the mark "Jules Jurgensen, Copenhagen," which mark thereon was false, simulated, and spurious. We are not told whether the said words were inscribed in any peculiar manner, or in any uncommon characters. It was a clear case of fraud, whether these words constituted a common-law trade-mark or not. This case, therefore, does not assist in the elucidation of the point under consideration. Nor does that of *Byass v. Sullivan*,¹ where the plaintiff averred that the defendants unlawfully copied and used his trade-mark or label on bottled porter, viz. "Best Stout Porter, from R. B. Byass, London," with a *fac-simile* of his *signature* underwritten; for that copy of a signature itself was a good trade-mark. In *Clark v. Clark*,² it was held that a party will not be restrained by injunction from using his own name, unless the use by him be accompanied by circumstances indicating an intention to mislead the public. In *Ames v. King*,³ the answer denied that the plaintiffs had the sole right to use the word "Ames" upon shovels, and denied that the defendants ever stamped or marked any shovels with the name "Ames" with intent to imitate the plaintiffs' shovels or their mark, or to represent the same to be the manufacture of the plaintiffs, or to injure, defraud, or deceive the public or the plaintiffs; but admitted that he had stamped two hundred dozen shovels for a dealer whose name was Edward B. Ames, and at his request had stamped the same "Ames," but not "O. Ames," and solely to denote that they were sold, or kept for sale, by Edward B. Ames. This alleged infringement was brought before the court under the Massachusetts statute of 1852, entitled "An Act further to protect Trade-Marks." That statute conferred upon the court the power to restrain by injunction the fraudulent use of trade-marks, and *other similar devices*, employed "for the purpose of falsely representing any article to be manufactured by" a person or

¹ 21 How. Pr. 50; R. Cox, 278.

² 25 Barb. 76; R. Cox, 206.

³ 2 Gray, 379.

firm who did not in fact make it. In the case at bar, the bill stated a case clearly within the statute above cited. But the essential averments in the bill of a fraudulent use of the plaintiffs' name by the defendant, for the purpose of falsely representing articles to have been made by them which were in fact manufactured by the defendant, are particularly and fully traversed by the answer. Bill dismissed.¹ This not being a case falling within the principles of the common law, but resting upon a local statute, it cannot avail us in our present investigation.

§ 428. *Rodgers v. Nowill*² is frequently misquoted. The facts of that case are short and simple. The defendants, manufacturers of cutlery at Sheffield, received an order from the Messrs. Lord & Son for a quantity of pen-knives and pocket-knives, to be stamped or marked with the letters V. R., with a crown between them, and the words "J. Rodgers & Sons, Sheffield," below. They accordingly made and marked the knives as ordered. The knives, when made, were, it is said, received by the defendants, accompanied by a bill of parcels describing them as purchased from John Rodgers & Sons. The plaintiffs brought their action; and, having proved the order for knives so marked as to resemble and pass for their manufacture, and its execution by the defendants in the manner stated, the case went to the jury. It was found that the defendants had adopted the plaintiffs' mark. We perceive that the infringement covered the whole of the mark, and not alone the names of the plaintiffs.

§ 429. The case of *Morison v. Salmon*,³ in the Court of Common Pleas, in England, in 1841, appears at the first glance to throw light upon this question, but in reality it does not. The declaration, after stating that the plaintiffs prepared and sold, for profit, a certain medicine called "Morison's Universal Medicine," which they were in the habit of selling in boxes wrapped up in paper, which had these words printed thereon, alleged that the defendant, intending to injure the

¹ See *ante*, § 67, *The Collins Co. v. Oliver Ames & Sons Corporation*.

² 5 Man., Gr. & Sc. 109; 11 Jur. 1039; 17 L. J. C. P. 52.

³ 2 Scott N. R. 449; 2 Man. & G. 385.

plaintiffs in the sale of their said medicines, deceitfully and fraudulently prepared medicines in imitation of the medicines so prepared by the plaintiffs, and wrapped up the same in paper, with the words "Morison's Universal Medicine" printed thereon, in order to denote that such medicine was the genuine medicine prepared and sold by the plaintiffs, etc. *Held*, on a motion to arrest the judgment, that the declaration disclosed a sufficient cause of action. Looking at this as a trade-mark case, where do we locate the essence of the commercial symbol? It does not reside in the generic term "medicine," for that is common property, free to all who use the language; nor is it in the name of the plaintiffs, for any one else bearing the same surname had the same right to stamp it upon the same unpatented articles of merchandise. How could we hesitate to fix upon the word "universal" as the talisman? That word is used here as an arbitrary symbol, or fancy denomination. It does not pretend to intimate that the medicine to which it is affixed is *universal*; for then it would be obnoxious to the charge of quackery, and, even though it might not deceive the most credulous, it would meet the fate of the marks in *Heath v. Wright*,¹ and *Fowle v. Spear*.²

§ 430. In *Holloway v. Holloway*,³ in the Rolls Court in England, in 1850, the plaintiff, Thomas Holloway, complained that his brother, the defendant, Henry Holloway, had begun to sell pills and ointment at 210 Strand, under the description of "H. Holloway's Pills and Ointment." The pill-boxes and pots were similar in form to, and the labels and wrappers were copied from, those used by the plaintiff, whose place of business was at 244 Strand. The plaintiff prayed an injunction to restrain the defendant from selling any pills or ointment described as, or purporting to be, "Holloway's Ointment," or "H. Holloway's Pills," or "H. Holloway's Ointment," in boxes or pots having labels so contrived or expressed as by colorable imitation or otherwise to represent the pills or ointment sold by the defendant to be the same pills or ointment as were sold by the plaintiff.

¹ 3 Wall. Jr. 141; R. Cox, 154.

² 7 Penn. L. J. 176; R. Cox, 67.

³ 13 Beav. 209.

§ 431. The Master of the Rolls (without hearing an answer) said: "This case, upon the evidence before me, is perfectly clear. The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment; and I do not intend to say anything tending to abridge any such right. But he has no right to do so with such additions to his own name as to deceive the public, and make them believe that he is selling the plaintiff's pills and ointment."

§ 432. In *Burgess v. Burgess*,¹ in the English High Court of Chancery, in 1853, it appeared that, for upward of forty years prior to 1800, John Burgess, the father of William R. Burgess, the plaintiff, carried on business on his own account as an Italian warehouseman at No. 107 Strand, London. In 1800, the plaintiff was taken into partnership by his father, and from that time until 1820, when the father died, they continued the partnership business under the style or firm of "John Burgess & Son." The son, as sole executor and residuary legatee, succeeded to the business, and continued it on his own account, but under the same style of "John Burgess & Son," and on the same premises at No. 107 Strand. Among the articles in which the firm originally, and afterward the plaintiff, had been in the habit of dealing, was a fish-sauce called "Essence of Anchovies," which had been originally manufactured by John Burgess, the father of the plaintiff, about forty years prior to 1800, and ever since sold by the firm under the name of "Burgess' Essence of Anchovies." The defendant, William Harding Burgess, the son of the plaintiff, after being for many years employed at a salary by his father in his business at the said place, upon the occasion of a disagreement left his father's service, and began to trade on his own account, at No. 36 King William Street, same city. He caused to be placed over his shop-front the words, "W. H. Burgess, late of 107 Strand," and on each side of the door of his shop fixed a metal plate, with the words, "Burgess' Fish-Sauce Warehouse, late of 107 Strand." The bill complained also that the defendant was

¹ 17 Jur. 292; 22 L. J. Ch. 675; 3 De G., M. & G. 898; 21 L. T. 53.

selling a fish-sauce purporting to be "Burgess' Essence of Anchovies," but at a lower price than that of the article sold by the plaintiff under the same description or title, and that such sauce was offered for sale by the defendant in bottles similar in size and shape to the bottles used by the plaintiff, accompanied with labels, wrappers, and catalogues bearing a general resemblance to those used by the plaintiff in the sale of his essence of anchovies; and in particular, that upon such labels, wrappers, and catalogues he used the title "Burgess' Essence of Anchovies," under which the article sold by the plaintiff was well known, and had long enjoyed a great celebrity in the market. It was alleged, also, that the said words had been used by the defendant with the fraudulent object of deceiving the public, and leading purchasers to believe that they were purchasing the plaintiff's article. Vice-Chancellor Kindersley ordered an injunction restraining the defendant from using the words "late of 107 Strand," and "Burgess' Fish-Sauce Warehouse, late of 107 Strand," but refused to restrain him from using the words "Burgess' Essence of Anchovies." The decision of the Vice-Chancellor was affirmed on appeal.

§ 433. This is so manifestly an instance of unfair competition in trade, and not a trade-mark case, that remark were supererogatory, unless to cite it as an additional illustration of the doctrine that a man's name cannot be transmuted into a technical trade-mark for himself.

§ 434. In the Court of Paris, in 1863, (*Massez v. Joly*,¹) the plaintiff, a shoemaker, had for a mark the name of "Joly," enclosed in an oval. The defendant, Joly, used his own name in the same manner and with the same object. The court ordered that the defendant should modify his mark, either by joining his Christian name, or by omitting the oval form, so as to prevent confusion in the mind of the public. The oval constituted the essence of the symbol. In the *Leather Companies* case, in the House of Lords, in 1865,² both par-

¹ 10 *Annales*, 318.

² 11 H. L. C. 523; 85 L. J. Ch. 53; 11 Jur. (N. S.) 513; 12 L. T. (N. S.) 742; 13 W. R. 873; 6 N. R. 209.

ties made conspicuous use of the surname "Crockett," being that of the inventors of a certain process, and yet the court did not entertain the notion that that name could be an essential part of a trade-mark. Nor does the following case sustain any such idea, although sometimes cited in support thereof.

§ 435. A complainant, Samuel Stonebraker,¹ being engaged in the manufacture of certain medicines and other preparations, adopted and used certain labels to distinguish his preparations from all others. These labels became generally known to the trade and consumers, so that by them the preparations were recognized, distinguished, and bought. The manufacture and sale became a source of profit and emolument to the complainant. Certain persons thereupon fraudulently engaged in the manufacture and sale of medicine and preparations, which they sold, bearing a similar label with only a colorable difference. Two of the defendants had employed in business another, a brother of the complainant, for no other reason than that his name was Stonebraker, and because they believed that by employing a person of that name they could with impunity consummate their intended frauds against the complainant and the public. Pinkney, J., who heard the case, said that the evidence showed beyond all doubt that the agreement between the parties was but a combination to deceive the public, and to enable the parties to it to obtain for their medicines the benefit of the celebrity which those of the complainant had in the market, at the expense of the complainant, and in fraud of his rights. The defendant who had thus loaned his name was himself a medical man, and had a right to compound and vend medicines. His offence was in selling his medicines as those of his brother. The defendants copied the names given by the complainant to his medicines; and on their wrappers and labels the language that he had on his; and, as if to leave no doubt of their fraudulent intent, printed on the wrappers of some of their medicines and preparations the certificates given to the complainant, in recommendation of his medicines, etc. This

¹ Stonebraker v. Stonebraker, 33 Md. 252.

design became a perfect success, so that experienced druggists were deceived.

§ 436. The Circuit Court passed a decree perpetually enjoining and restraining defendant Stonebraker and his partners, their agents, and all persons claiming under them, from manufacturing or imitating any of the medicines, etc. which had been known as "Stonebraker's Medicines or Preparations," and from counterfeiting the labels, marks, etc. The Court of Appeals of Maryland affirmed the decree.

§ 437. A trader is sometimes debarred from using a trade-mark originated by himself; for by his own direct act, or by operation of law, the title to its use may have been alienated from him. In substance, there is no distinction between the sale of a business and good-will by a trader himself, and a sale by his assignees in bankruptcy. Therefore, on a sale by such assignees, the trader has no right, upon setting up a fresh business after his discharge, to use the trade-mark of his old business, or in any other way to represent himself as carrying on the identical business which was sold; although he has a right to set up again in business of the same kind next door to his old place of business.¹ The principle of this ruling of Vice-Chancellor James is plain. A trade-mark is frequently an indication of place, and purchasers look rather to the locality than to the person. If certain goods are associated with the shop bearing the sign of the Crescent, or the Elephant, or any other fanciful emblem, and go forth to the public bearing the stamp of the Crescent, etc., then it is clearly an infringement for any one else in the same line to use the mark. But if the mark be so personal in its character that it is identified with the person, and imports that the goods bearing it are manufactured by him, then the rule would be different; for the law will not lend itself to the perpetration of a fraud.²

§ 438. The employment by a firm of a name identical with that of an old commercial house is not illicit in itself, and the suppression of the name will not be decreed. But when to

¹ *Hudson v. Osborne*, 39 L. J. Ch. 79; 21 L. T. (n. s.) 386.

² See *Bury v. Bedford*, 10 Jur. (n. s.) 503; 4 De G., J. & S. 352; 33 L. J. Ch. 465; 10 L. T. (n. s.) 470; 12 W. R. 726; 4 N. R. 180.

the use of this name are added abusive manœuvres, having for an object to deceive consumers, then it becomes necessary to order that modifications be made in marks and tickets, with the first name of the junior party, and sometimes the date of the formation of the new house. In the case of *Louis Roederer & Co. v. Théophile Roederer*,¹ in the Court of Paris, in 1865, the plaintiffs, the well-known vintners of Rheims, complained of the defendant's use of the surname of the head of their house, to their prejudice. The plaintiffs had adopted a mark called *Carte Blanche* for their finest champagne wines. The Tribunal of Commerce of Rheims found for the plaintiffs, and directed that on the labels, corks, brands, tickets, etc., to be used by the defendant's firm, the name *Théophile* should be placed in letters of the same size, shape, etc. as the name *Roederer*. The plaintiffs, thinking the remedy insufficient, appealed, and produced before the appellate court prospectuses which, both before and after the judgment of the court of first instance, had been circulated, not only in France, but also in Belgium and in England. The following shows the contents of said prospectuses: "Grand Vin de Champagne mousseux. T. Roederer & Co., of Rheims, Carte Blanche, qualité unique, francs: 5. Merchants and consumers are requested not to confound this wine with that of a similar house at Rheims, and to suspect fraudulent imitations. Corresponding depository in Belgium: A. Vernaelde, wine merchant, 29 Ommeganech Street, Antwerp."

"LONDON, October 13, 1864.

"GENTLEMEN, — *In remitting herein enclosed the circular of the MESSRS. TH. ROEDERER & COMPANY, of Rheims, who give us the title of sole agents for the sale of their CELEBRATED CHAMPAGNE-WINE, we request you to forward to us your orders.*

"The mark 'Carte Blanche' of Th. R. & Co. is so well known that there is no need for us to recommend it to you," etc.

Per Curiam: "As to the principal demand tending to the prohibition of the use by the defendants in their firm name, their marks and labels, of the name of *Roederer*, — considering that *Théophile Roederer*, having formed with the brothers

¹ 11 *Annales*, 58.

Bousigue (called Bley) an association under a collective name for the sale of sparkling champagne wines, had a right to dispose of his name for the profit of the partnership, they consequently had a right to use it, as well in the firm title as in their marks, labels, and advertisements, beyond the reach of power to suppress the same, especially as against Roederer himself, if he has created the house on his own account. As touching the subsidiary conclusions, directing that the name of Théophile Roederer take precedence in the firm or title, marks, and labels, — considering that an association under a collective title may borrow from among themselves the name of any one most suitable for their title, marks, and labels, they are not, however, at liberty to take a sign tending to divert to their own profit the good-will of an old house bearing the same name, one already made popular in the same trade; that this good-will should be the result of a free and legitimate competition and not of illicit actions, and that it is an illicit action to cause a coincidence of mercantile names to deceive the consumer; — considering that the judges of the first instance have found as a fact that Théophile Roederer's firm has established and organized for the purpose of appropriating, by means of the name it bears, the favor enjoyed by the house of Louis Roederer; that, in fact, the antecedents of Théophile Roederer, — a stranger in the city of Rheims, and to the commerce of champagne wines, — justify the conclusion that the part he plays in the partnership is solely to lend his name to imitate the labels and vignettes of Louis Roederer, the borrowing of the special designation of 'Carte Blanche,' the resemblance of the sealing-wax for the bottles, the similarity of marks upon the corks, and the announcements, scattered even through Belgium and England, in which the agents of the new concern felicitate themselves upon having received the agency for the celebrated champagne wine, recommending not to confound it with another house of the same name, and retaining but the initial of the name Théophile to make more conspicuous the name of Roederer; — all reveal and characterize an unlawful competition. Considering that to remedy this abuse the judges below

should not have limited themselves simply to directing that the marks, labels, and announcements of this new house should for the future bear the prenomens of Théophile written in full, and in characters of the same dimension as those of the surname Roederer; that that would be an incomplete and inefficacious remedy against confounding in commerce the name of the new house with that of the old, but that the same can be accomplished by diversifying them by exterior signs, without the necessity of modifying the firm title, Théophile Roederer & Co.; that it will suffice for the future to direct that the defendants shall be bound to insert in their marks, labels, announcements, circulars, and bills, the mention following, 'House founded in 1864,' and to inscribe it thereon in characters of the same size and of the same form as those of the name and prenomens of Théophile Roederer;— for these reasons, the judgment appealed from is modified, in that it orders only that the marks, labels, announcements, and bills of the house of Théophile Roederer & Co. shall bear for the future the prenomens Théophile in form and dimension the same as those of the surname. . . . Ordered, that the defendants shall in future insert in their advertisements, bills, and prospectuses, as well as on their marks, labels, and corks, 1st, the prenomens of Théophile; 2d, the mention following: 'House founded in 1864.' Ordered, that said mention shall appear in characters of the same dimension and form as those of the surname Roederer. Ordered, that the present judgment shall be inserted by extract containing the names and qualities of the parties, the reasons and disposition made, in the newspapers of the Department of the Marne, in three newspapers of Paris, and in four foreign newspapers selected by the plaintiffs, and at the expense of the defendants," etc.

§ 439. An Englishman established in Paris the sale of a certain manufacture from farina for food, to which he gave the name "Ervalenta-Warton," compounded from a word of fancy and his surname. Whatever may have been the intrinsic merit of this farina, through dint of advertising, it had obtained in France as well as in England a grand success.

Influenced by the renown gained by Warton for his product, another Englishman, named Klug, began the sale of a somewhat similar article of food, which he decorated with the name of "Revalenta Arabica." For a long time the competitors carried on business side by side without a legal contest; but eventually Warton died, and his widow, succeeding to his affairs, brought an action against Klug for usurpation of the denomination which had been adopted by her husband as a trade-mark. The Court of Paris affirmed the judgment of the court below, which had found the defendant guilty of infringement, in using the thinly veiled expedient of slightly modifying the name of the thing.¹

§ 440. It is a counterfeiting of a trade-mark to affix the symbol to a box or envelope, although the goods themselves, enclosed therein, do not bear the same mark as the genuine. Thus, where a manufacturer of gilt-headed nails had a star for his mark, which mark he impressed upon the boxes containing his products and his invoices, as well as on the goods, and another person placed the same mark on the outside of his boxes, but not upon the goods, it was held to be infringement. Such was the decision of the Court of Paris in 1872, in *Carmoy v. Samson*,² on appeal from a judgment of the Tribunal Civil of the Seine. The lower court had held that a five-pointed star, such as the plaintiff had adopted and the defendant had imitated, is a sign commonly employed in other branches of industry, and when isolated from all other distinctive characters is not susceptible of private appropriation. The defendant, therefore, had not encroached upon an exclusive right, especially as he had not actually stamped the merchandise itself. Judgment was rendered for the defendant, with costs. The appellate court, however, not only regarded the star sufficient as a trade-mark, but found the defendant guilty of counterfeiting, by the external use thereof. His object was to deceive the purchaser, and he did it as effectually as if the star had been impressed upon each nail.

§ 441. As to who is the actual counterfeiter of a trade-mark, the Court of Cassation of Belgium, in 1865, (*Gilbert*

¹ *Warton v. Klug*, 1 *Annales*, 40.

² 17 *Annales*, 231.

Co. v. Benedictus,¹) said: Inasmuch as the prohibition to counterfeit trade-marks has for its object the preservation from outrage of industrial property, it follows therefrom, —

1. That the counterfeiter is not the agent who materially executes the simulated work, but he who causes it to be done with an intent fraudulently to traffic in counterfeited objects;
2. That the wrong is consummated at the place where the counterfeiter carries on the illicit traffic, although the act may have had its inception in a foreign country.

§ 442. As to the question of infringement by the use of numerals, we have a decision made at a general term of the Supreme Court of New York, in 1872.² It was there held, that the use of a number of a street, or that of a building in a street, for part of a person's trade-mark, where other persons have the same right to manufacture the same article in the same street, or at the same number or building, cannot be made exclusive, or the use by another be restrained by injunction. But where a person has the exclusive use of a street number or building, he may very properly use it as a part of his trade-mark.

§ 443. *Perversion of Mark.* — A genuine mark may virtually become a counterfeit by misapplication or transfer. Thus, if a trader sells goods with his mark thereto attached as an evidence of genuineness, and the purchaser adulterates the goods, or uses the same envelope for the purpose of selling a false article, he is a counterfeiter. So where one, having a right to use a genuine mark upon paper bags for seeds, placed therein seeds of an inferior quality, he was guilty in the eye of the law of fraud, just as much as if he transferred a genuine signature from one paper to another.³ Or in a case like the following. A gunmaker, who manufactured rifles that had acquired a great reputation, placed his trade-mark thereon. Some of the old parts were sold as old stores. The defendants bought old parts bearing the plaintiff's mark, and fitted

¹ 12 Annales, 427.

² *Glen & Hall Manuf. Co. v. Hall*, 5 Alb. L. J. 109; 61 N. Y. (16 Sickels) 226; 19 Am. R. 278.

³ *Bloss v. Bloomer*, 23 Barb. 604; *R. Cox*, 200.

them to rifle-barrels not of plaintiff's make. The fraud was enjoined.¹ Or where false representations are made, as in the following cases. The plaintiffs sold their brandy in casks, and also in bottles, the latter being of the better quality, and placed on their bottles certain distinctive labels, etc. The defendants purchased a large quantity of the plaintiff's inferior or cask brandy, and sold it in bottles similar to those of the plaintiffs.² A defendant had bought a considerable number of bottles that had contained the plaintiff's bitters and which bore his marks, and sold them refilled with other bitters of his own make.³ The French courts of justice have had opportunities to discuss this subject. In the Court of Amiens, in 1872, it was held that where receptacles, such as siphons, of gaseous waters bear the mark of a manufacturer, another in the same business has not a right to avail himself thereof for his products, although he founds his claim so to do on the constant practice of the trade, permitting the employment of siphons returned by consumers, in exchange for others sold to them.⁴ In the Tribunal Civil of the Seine, in 1879, it appeared in evidence that the defendant had obtained portions of a genuine famous article, and, supplying the other portions made by himself, he marked the article thus completed with the symbol of the first inventor. He thus succeeded in foisting an inferior article on purchasers, and at the same time damaged the reputation of the owner of the mark. The court said that it was fraud to use the mark even on the genuine portion.⁵ In the Tribunal Correctionnel of Toulouse, in 1881, there was a case of selling in genuine bottles invested with false labels and fluid. The defendant was held to responsibility, under Article 7 of the law of June 23, 1857, and Article 423 of the Penal Code.⁶ In 1884, in the Circuit Court of the United States for the Northern District of Illi-

¹ *Richards v. Williamson*, 30 L. T. 746.

² *Hennessy v. White*, 6 W., W. & A'B. Eq. 221; *Hennessy v. Hogan*, *Ibid.* 225; and *Hennessy v. Kennett*, *Cox's Man.*, case 556.

³ *Hostetter v. Anderson*, 1 V. R. (1 W., W. & A'B.) Eq. 7; 1 *Australian Jur.* 4.

⁴ *Pie v. Poulet*, 20 *Annales*, 46.

⁵ *Gogney v. Delanne*, *Ibid.* 164.

⁶ *Ministère Public and F. Prot & Co. v. Carriès*, 26 *Id.* 185.

nois, there was a similar case. The defendant had bought from old-junk dealers genuine bottles that had contained "Warner's Safe Kidney and Liver Cure," and had filled them with some base concoction, and affixed counterfeits of the label. He was mulcted in damages and costs.¹ This matter will be further discussed in a subsequent section.²

§ 444. This question was discussed in the Corps Législatif of France, when the bill that crystallized into the trade-mark law of 1857 was under consideration. One honorable member (M. Legrand) said that certain products exist on which by reason of their nature the trade-mark could not be immediately applied. These products are placed in an envelope on which is put the mark of the manufacturer; and the products find a sale more or less easy, according to the degree of credit that that particular mark has in the market. He mentioned frauds of frequent occurrence, where certain vendors had made themselves the intermediaries between the manufacturer and the consumer. They address their attentions to the manufacturers the most renowned. In the beginning, to establish confidence, they render to their principals such as they have received; but soon afterwards, when the valuable products have become associated with certain marks, they open the packets and substitute an inferior kind of goods.³

§ 445. M. Levavasseur, in the same debate, said that in nearly all the cities where textile fabrics are made, and notably so in Rouen, there exist commission merchants who buy to sell, generally under a form different from that which the manufacturer has given; thus, they divide the stuffs in pieces, to make them assume new guises suited to the convenience of those to whom the merchandise is sent. These textile fabrics receive at the dressers an entirely new form, and the commission merchant, to assure the sale, thereon places his mark, known only to his principals. It is in this manner that the greater part of the stuffs of Rouen sold in America are dressed and exported.

¹ Warner v. Roehr, reported in Chicago newspapers of March 21, 1884.

² See *infra*, § 473, "Slander of Trade-Mark Property."

³ Moniteur, May 14, 1857.

§ 446. In *Gillott v. Kettle*,¹ at a general term of the Superior Court of the City of New York, the fraud complained of consisted in selling an inferior article of the plaintiff's manufacture as being one of a superior quality. The case came up on appeal from an order enjoining the defendant, as hereinafter stated. The papers on which the injunction was granted showed that the plaintiff had for a long time been extensively engaged in the manufacture of steel pens, at Birmingham, in England; that the pens made by him were well known as such in the market, and were extensively sold, as well in the United States as in England; that large quantities of them were sold in boxes containing one gross each; that each box was labelled in a manner, and with a label having devices upon it, which indicated that the plaintiff was the manufacturer of the pens, and in consequence of which they were bought and sold in the market, as pens made by him; and that the labels had numbers² or marks impressed on them, which indicated, and which were recognized by dealers as indicating, an actual difference in the quality of the pens. The pens in boxes numbered 303 were bought and sold as being extra fine-pointed, and were in fact so. The pens in boxes numbered 753 were of an inferior quality, and were bought and sold as such, the number being understood by dealers to denote their inferior quality. The former were sold by the plaintiff at about seventy-five cents, and the latter at about eighteen cents a gross. From the boxes containing the plaintiff's label or trade-marks, and bearing the number 753, the defendant was in the habit of removing the plaintiff's label, and putting on, in place thereof, labels which he made or caused to be made closely imitating the genuine labels of the plaintiff, which bear the number 303. This act was productive of great injury to the plaintiff, by destroying public confidence in his honesty, and bringing the pens made by him into discredit, by reason of his inferior pens being disposed of as being his best pens.

¹ 3 Duer, 624; R. Cox, 148.

² As to the numbers being trade-marks, see *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340. Com. of App. 48 N. Y. (3 Sickels) 374; 8 Am. R. 558.

§ 447. This case differs from those in which a manufacturer seeks to restrain others from placing his trade-mark upon articles made by themselves, by which goods of his own manufacture are known to be his, and are recognized as such in the market. Here the defendant has not attempted to sell an article made by himself, by fraudulently creating the impression that it was made by the plaintiff; but he has attempted to sell an inferior article — made by the plaintiff to be sold as an inferior one of his own manufacture — by using a label indicating a superior article. The fraud, so far as successful, is twofold. The public is defrauded, by being induced to buy the inferior for the superior article. The plaintiff is defrauded, by an unjust destruction of confidence that his pens are put up for sale and assorted with reference to the quality, indicated by the labels. Unless the fraud were checked by the intervention of a court of equity, the damage to the owner of the mark might be irreparable. The remedy by injunction is invariably granted when the nature of the injury is such that a preventive remedy is indispensable, and should be permanent. The order was affirmed, with costs.

§ 448. The following curious case was submitted to the writer, for his opinion as counsel. C. J. M., a wine and liquor merchant in the city of New York, was threatened with a prosecution for imitating the trade-mark of Bass & Co., of England, upon ale and porter. “Then you do not sell a genuine article?” “O, yes, we sell the very ale and porter that we purchased from the manufacturers themselves.” “Then the labels are imitated by you? that is, false labels are used upon genuine goods?” “Not at all, for the labels also are genuine. The whole story is this: we bought the ales and porter at wholesale for the understood purpose of retailing in England; and also obtained from the agent of the firm of Bass & Co. a supply of their labels containing their trade-marks. Instead of selling in England, we chose to bring the ale and porter to this country, and by retailing here we reap the profits that the manufacturers expected to enure to themselves. *Query*, Have we made ourselves liable in an action for damages, or can we be enjoined?” The answer was, that,

in the absence of any agreement, it could not be perceived how either an action at law or a suit in equity could be maintained. It seemed like a naked question of morality and mercantile faith. It was nothing but a trick in trade. The foreign firm may protect itself in the future by selling only to known confidential retailers.

§ 449. From an examination of the foregoing illustrations, we cannot have failed to gain a general notion of the correct theory of infringements. We observe that encroachments on trade-mark rights usually have less of the characteristics of downright robbery than of mean, dissembling knavery. The craft of the fox is evinced more frequently than is the boldness of the lion. Yet two traders may take the same symbol, each in ignorance that the other uses it, or with an honest doubt as to which has the legal right therein. The conflict of claims may be the result of a difference of opinion as to the alleged imitation. At the first glance, it is not always easy to say what amounts to imitation. In the chapter on Interferences, hereafter, may be seen a remarkable instance of two things entirely unlike in appearance being adjudged to be alike in effect.¹ In that case, it was conceded by the able counsel on each side, and found by the Patent Office, that the picture of a bouquet with elaborate ornamentation, and the simple word "Bouquet," interfered with each other when used upon the same class of goods. If vision were the sole guide, the lack of physical resemblance would have decided that no interference existed. One delineation could not possibly be mistaken for the other. Here is the test: Would the use by different houses of the two things cause confusion? The ear is the medium to mislead a purchaser. He might ask this question, "Have you the Bouquet ham?" and either of the traders could truthfully reply in the affirmative. The picture and the word could not lawfully coexist as marks for rivals dealing in the same class of merchandise. The matter then resolves itself into a question of priority of adoption. We see how one may press closely upon the rights of another without the least thought of fraud, and yet be adjudged to be a wrong-doer.

¹ *Schrauder v. Beresford & Co.*, § 661.

§ 450. Again, the same symbol may be used by two persons having no interests in common, and still furnish no ground for legal conflict. We have heretofore seen that there is no property in an abstract symbol. It must be a mark upon a vendible commodity to entitle it to judicial attention. It does not signify if the emblem used by the different parties be exactly alike, — in fact, be printed from the same plate or impressed by the same brand, — unless it also be affixed to similar goods. Now arises a point of considerable difficulty. How shall we define the term *class*? A class is an order or division of objects, grouped together on account of their common characteristics. We must narrow the limitation, when applying the word to our present purpose. This point has already been discussed in this treatise, and some examples given of the construction of the word *class*. Cutting instruments may be classified generally as cutlery; and yet a chopping-axe, a pocket-knife, and a scythe be said to belong to three distinct classes. Wine, brandy, whiskey, gin, are all alcoholic liquors; but we see that the Patent Office has held that they do not come in the same class.¹ We read the decision in the case of the *Amoskeag Manufacturing Co. v. Garner*,² and learn, if we did not know it before, that *plain* cotton cloths and *printed* cotton cloths belong to different classes. Some latitude must be allowed in determining to what class an article should be assigned. If a manufacturer adopts a mark for a razor, and uses it upon nothing else, can he subsequently claim that he had obtained the exclusive right to its use upon all sharp instruments of steel? Or if he adopts a mark for alcohol, does he thereby exclude every other manufacturer or trader from the use of the same symbol for whiskey or gin? Certainly not. The classification of commerce must be consulted. The *experimentum crucis* is this: What does a buyer ask for? An experienced tippler may say that he is at times unable to distinguish old whiskey from brandy, so much are they alike in taste, and that that circumstance is a good reason why the halo of a trade-mark for one article should be considered

¹ *Ante*, §§ 66-70

² 55 Barb. 151; 6 Abb. Pr. (n. s.) 265.

broad enough to embrace the other. This is a question of evidence rather than one of classifying. If the purchaser asks for brandy, he does not wish for whiskey. What does he believe he is getting? If he is misdirected by a symbol, the proprietor whose mark has been pirated loses a customer, and for the wrong so done him is entitled to legal satisfaction. The class of merchandise of the defendant may not be exactly that of the plaintiff, and yet the deceit be complete. We must apply the doctrine of analogous use. If a defendant show that the class of goods to which he has affixed the mark of the plaintiff is not in all particulars the same as his, shall he thereby be screened from punishment? If there be two distinct classes of goods bearing the same emblem, are they so nearly alike that the public may naturally be misled? If one applies a symbol to corn starch, can another evade it by applying it to a somewhat similar article of farinaceous food? In *Burnett v. Phalon*,¹ the essential element of each party's product was cocoa-nut oil, although in certain particulars the articles were not alike; but when a buyer saw the word "Cocoïne," he thought that he was obtaining the genuine "Cocoaine." So, also, when one asked for the plaintiff's "Eau de la Floride," represented to be a natural water from Florida, he thought his wish was gratified when the defendant delivered a chemical compound marked "Eau de la Fluoride."² The object in each case was to deceive the public by the usurpation of the reputation of another person. It is eminently a question of fact for the practical experience of a jury, whether, in a particular case, a resemblance is likely to deceive the community.³ In the "IXL"⁴ matter, Wostenholm & Son had no right to complain of the application by others of the composition of letters first used by their house; for as those others did not manufacture the same kind of cutting instruments that they, the originators, did, no competition arose, and no custom was lost. The goods are of different classes.

¹ 9 Bos. 192; 5 Abb. Pr. (n. s.) 212; 3 Keyes, 594.

² *Guislain & Co. v. Labrugnère*, *ante*, § 397. See also *ante*, § 33.

³ Per Robertson, C. J., in *Swift v. Dey*, 4 Robertson, 611.

⁴ *Ante*, §§ 68-70.

CHAPTER IX.

REMEDIES, — LAW AND EQUITY.

- § 451. Remedies of different sorts.
- § 452. Remedy at Law.
- § 453. Forgery at common law.
- § 454. Penal statutes of States.
- § 455, 456. Criminal law of Europe.
- § 457. Action on the case. — Federal statutes.
- § 458. Fraud is of essence of injury.
- § 459. Actual damage must be shown.
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- § 461. Representations need not be immediate.
- § 462-466. Remedy in Equity. — Injunction cautiously granted.
- § 467. Preliminary injunction, — when to be granted.
- § 468. Fraud or mistake, both causes for relief.
- § 469. Discovery, Account, and Costs.
- § 470. Inadequacy of legal redress.
- § 471. Innocent vendor not required to pay costs.
- § 472. So of innocent common carrier or bailee.
- § 473. Slander of trade-mark property.

§ 451. *The Remedies against Piracy* (a term broad enough to embrace all infringements, whether atrocious or comparatively innocent) may be said to be threefold, and a single act may incur all three prosecutions. They are as follows: 1. A private action at law. 2. A suit in equity for an injunction and an account of profits. 3. A criminal action for a public wrong. A civil action, sounding in damages, may be brought by the owner of a mark, for injury done to his property therein, an unwarrantable use of the mark, or a colorable imitation thereof; or, as an indirect means of protecting the owner, an action in the nature of deceit may be brought by a purchaser who has been cheated. The remedy at law is sometimes sought under common law; but more frequently by virtue of statutes. Many of the individual States have legislated upon this subject, not only providing civil redress for infringements of trade-marks (used in a comprehensive sense), but

have also passed penal statutes for counterfeiting the same; some of which statutes prescribe severe punishments, in one case the maximum for counterfeiting being imprisonment for twenty years.¹ Chapters VI. and VII. treat of our national legislation on the subject. The civil remedies therein provided are a reaffirmance of pre-existing provisions of law and equity, and novel only in allowing an action on the case for false or fraudulent representations or declarations, whether oral or in writing, made in the Patent Office in regard to a trade-mark.

§ 452. *Remedy at Law.* — Sometimes a criminal prosecution and a civil action for the same wrongful act may proceed simultaneously.² An indictment for the piracy of a trade-mark registered under the act of Congress of March 3, 1881, must of course be found in a Federal court. But cases may arise where it would be preferable to indict under the law of the State where the crime shall have been committed. The reason is this: the act of Congress of August 14, 1876, which is made operative in conjunction with that above mentioned, protects only technical trade-marks; but divers of the indi-

¹ As to the penal statutes, see the following State laws: — California: Penal Code of July 14, 1872, sects. 13,350 to 13,354, Hittel's. Connecticut: Gen. Stats., Revision of 1875, p. 523. Illinois: Acts of May 2, 1873; and March 27, 1874, sects. 115, 116. Indiana: Act of March 16, 1875. Iowa: Code of 1873, sects. 4079, 4080. Kansas: Act (that took effect) May 31, 1866, sects. 1, 2. Kentucky: Gen. Stats., 1873. Maine: Rev. Stats., 1871. Massachusetts: Gen. Stats., ch. 161, sect. 55 (Act of 1850, ch. 90); also Act of June 11, 1870. Michigan: Act of Feb. 22, 1870. Nebraska: Gen. Stats. of 1873, p. 758; Nevada: Act of March 8, 1865. New Jersey: Rev. Stats. (1877), title "Crimes." New York: Act of April 17, 1862, amended 1863, ch. 209; Act of May 14, 1875, ch. 303; also Supplemental Act of June 8, 1878, ch. 401. Ohio: Act of May 5, 1877, ch. 11, sects. 23, 24. Oregon: Crim. Code of 1864, sect. 588. Pennsylvania: Act of March 31, 1860 (Brightley's Dig., 10th ed. 865); Act of 1865; Laws, p. 58; and subsequent local acts. — This list does not pretend to be complete, being here cited as illustrations of State legislation for the punishment of trespasses on trade-mark rights.

² As in Chicago, Ill., in 1884. The case of *The People of the State of Illinois v. Frank Roehr*, for counterfeiting the trade-marks of H. H. Warner, in a State criminal court, and that of *Warner v. Roehr*, an action on the case, in the United States Circuit Court for the Northern District of Illinois, went along *pari passu*. As the criminal offence was against both nation and State, there might also have been a third case, i. e. a criminal prosecution under the act of 1876, as the trade-mark had been registered.

vidual States have greatly expanded the local definition of the term *trade-mark*.¹ There are two heads of crime under which it might be expected that the fraudulent imitation of a trade-mark would be indictable, — as a forgery, or as the obtaining of money under false pretences. The former of these methods was adopted in the case of *Regina v. J. Smith*, in England.² The imitation in this case consisted of a printed label, which was an exact imitation of the labels attached by the prosecutor, George Borwick, to packets of his powder, called “Borwick’s Baking Powder,” with this exception, that the signature, “George Borwick,” was omitted in the counterfeit. It was contended, on the part of the prosecution, that the term *forgery* might be defined as the alteration or making of a false document with intent to defraud; and cases were cited in which the fraudulent imitation of a printed document, such as a diploma of the College of Surgeons, the good-conduct certificate of the master of a ship, and of a clergyman as to the character of a schoolmaster had been held to be forgeries. It was, however, unanimously held by the bench that the conviction was not sustainable; that the issuing of the wrapper or label, without the powder which it enclosed, would be no offence; and that, in the printing of the wrappers, there was no forgery committed by the printer. Bramwell, B., there said: “Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuiue document, and that the one is not so efficacious for all purposes as the other”; that, in the case before him, “one of the documents is as good as the other, — the one asserts what the other does, — the one is as true as the other; but one gets improperly used.” Mr. Lloyd, in his work on Trade Marks, says that he has not been able to find any case in the Reports in which an indictment for obtaining money under false pretences has been sustained in the case

¹ As an example, see sect. 3196 of the Political Code of California. By it the term trade-mark includes “every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman,” etc.

² Dearsley & Bell, 566; 8 Cox, Crim. Cases, 32; 27 L. J., M. C. 225; 4 Jur. (n. s.) 1003; 31 L. T. 135; 6 W. R. 495; 47 C. C. C. Sess. Pap. 269; 48 Id. 8.

of a fraudulent use of a trade-mark, although he had been referred to the cases of *Reg. v. Gray & Gosling*, in which the prisoners were sentenced to twelve months' hard labor for the fraudulent use of the Messrs. Allsop's labels; and to another case of *Regina v. S. Jones*, where a sentence of three years' penal servitude was inflicted. He says that it is clear, however, that the principle is applicable; and, in the case first cited, Willes, J., says: "In cases like the present the remedy is well known: the prosecutor may, if he pleases, file a bill in equity to restrain the defendant from using the wrapper; or he may bring an action at law for damages; or he may indict him for obtaining money for false pretences." This opinion of Mr. Justice Willes was assented to, with more or less positiveness, by the other judges; and it seems strange, says Mr. Lloyd, that this form of indictment should not have come into use by manufacturers for the purpose of protecting their trade-marks. It may, however, be accounted for on the ground that an action at law for damages, if successful, gives a more ample compensation for the violation of their rights.

§ 453. Forgery at common law is defined to be "the fraudulent making or alteration of a writing to the prejudice of another man's right," or as a false making, a making *malo animo*, of any written instrument for the purpose of fraud or deceit. In the case of *Regina v. J. Smith*, above cited, Pollock, C. B., in giving judgment, said, speaking of the labels: "They are merely wrappers, and, in their present shape, I doubt whether they are anything like a document or instrument which is the subject of forgery at common law. To say that they belong to that class of instruments seems to me to be confounding things together as alike, which are essentially different. It might as well be said, that if one tradesman used brown paper for his wrappers, and another tradesman had his brown paper wrappers made in the same way, he could be accused of forging the brown paper." So in *Regina v. Closs*,¹ it was decided that painting an artist's name in the corner of a picture, in order to pass it off as an original pic-

¹ 7 Cox Crim. Cases, 494; D. & B. 460; 27 L. J., M. C. 54; 8 Jur. (n. s.) 309.

ture by that artist, is not a forgery. Cockburn, C. J., in giving judgment, said: "We are all of opinion that there was no forgery. A forgery must be of some document or writing; and this was merely in the nature of a mark put upon the painting with a view of identifying it, and was no more than if the painter put any other arbitrary mark as a recognition of the picture being his." In the course of the argument of this case it was stated by the counsel that "no case had gone the length of holding that to stamp the name of *Manton* on a gun would be forgery"; upon which Crompton, J., said, "That would be forgery of a trade-mark, and not of a name"; and Cockburn, C. J., said, "Stamping a name on a gun would not be a writing; it would be the imitation of a mark, not of a signature." Whether the common law embraced such cases or not, the subject, in England, is made clear; and the following offences are made misdemeanors by Section 2 of the Merchandise Marks Act of 1862: 1. The forging or counterfeiting any trade-mark with intent to defraud. 2. The applying a *genuine* or a forged trade-mark, with intent to defraud, to anything not being the manufacture, etc. of any person denoted or intended to be denoted by such trade-mark, or not being the manufacture, etc. of the person whose trade-mark shall be forged. 3. The applying any *genuine* or forged trade-mark, with intent to defraud, to anything not being the particular or peculiar description of manufacture, etc. denoted or intended to be denoted by such trade-mark; for instance, if a man has two trade-marks, one for a particular description of goods of a superior quality, and another for a different description of goods of an inferior quality, the applying the trade-mark for the goods of superior quality to the goods of inferior quality will be a misdemeanor, if done "with intent to defraud," such intent being an essential ingredient in all such offences.

§ 454. Some of the States of this Union have passed statutes, declaring it to be a misdemeanor punishable by fine and imprisonment to forge or counterfeit, or cause to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label affixed by

any mechanic or manufacturer to his goods, wares, or merchandise, or in the sale thereof, with intent to deceive or defraud the purchaser or manufacturer of any goods, wares, or merchandise whatever. For our present purpose, it is hardly worth while to discuss these comprehensive enactments, which are not confined to technical trade-marks, but embrace wrappers, stamps, and labels. It may, however, be well worth while to have recourse to local statutes when other means are inapplicable, as when, although the technical symbol is not imitated, mischief is done by the ingenious simulation of a label or a wrapper, in color, size, shape, etc. In such cases, of course, a Federal court is not the proper forum; for such court possesses no power except such as both the Constitution and the acts of Congress *concur* in conferring upon them.¹

§ 455. The criminal law of some of the countries of Europe, especially France, is severe upon fraudulent imitators of trade-marks. In the Tribunal Correctionnel of Rheims, in 1863, (*Clicquot v. Roudeau et al.*,²) these facts appeared. In 1863, the London journals contained an advertisement of wines of the house of La Veuve Clicquot, of Rheims, at advantageous prices, at the Victoria Dock. Suspicions were aroused. The boxes and the casks were found to bear counterfeit marks. The Court of Queen's Bench ordered the seizure of the wines. It transpired that an association, composed of Cazin, a wine merchant, Roudeau, his principal agent, and three Englishmen, were operating together, and selling wines under the counterfeited marks of Moët, d'Epernay, and Veuve Clicquot. All were deemed guilty in France (although the acts were consummated in England), and severely punished. So, also, in the Court of Paris, in 1867 (*Heidsieck v. Souris, Dresel, et al.*³). Souris, a commission merchant, and Dresel, of Rheims, in September, 1866, formed a conspiracy with Theodore and George Bayaud, merchants at New York, to imitate and usurp the trade-mark of Charles Heidsieck, manufacturer of champagne wine at Rheims, and to export the wine in large quantities to

¹ *United States v. Hudson & Goodwin*, 7 Cranch, 32.

² 10 *Annales*, 101.

³ 14 *Id.* 95.

America. In pursuance of their plan, Souris caused a mark to be engraved like that of Charles Heidsieck, and to be reproduced on the cork of each bottle, with the sole substitution of the name of Herman for that of Charles, in the same characters, and the accessory ornament representing a comet. Souris then proposed to export wine in baskets, whose covers bore the four red bars, and all the external appearances of those of the house of Charles Heidsieck. Upon their arrival in America, labels were to be affixed to complete the deception. It was shown that one Herman Heidsieck, residing at St. Louis, Mo., and not in the champagne-wine business, had loaned his name to guarantee success. The court said that the nefarious conspiracy had been organized on a vast scale. 10,000 francs damages, costs, etc. were allowed.

§ 456. In the Court of Paris, 1868 (*Martell & Co. v. Badoureau & Patte*¹). The plaintiffs in this case were of Cognac, the products of which place are known in all the markets of Europe and America, and, having been victims of numerous counterfeits, had seized in Badoureau's lithographic establishment in Paris 12,000 labels bearing their name, and entirely similar to those employed by them in their trade. Badoureau set up that he had made the false labels at the order of Patte. *Held*, that the counterfeiting was complete by making, it not being necessary that use should be shown. The lithographer who reproduces the mark or label by order of a third person, without assurance that he is either the proprietor, or the agent of the proprietor of the mark, cannot set up his good faith. Damages against both. The court further ordered that the labels and stone from which they were printed should be destroyed; and that the judgment should be published in public journals to be selected by the plaintiffs.

§ 457. It has been seen, that the form of action adopted in vindication of the right to use a trade-mark is that of an action on the case for deceit; that is, so far as the common-law forms have escaped the renovating inroads of the new school of pleaders; and that action still survives under some other name, or no name, under the simplified forms of pleadings of

¹ 14 Annales, 126.

the codes of procedure. Under the United States statutes, the action remains purely the old action on the case.¹

§ 458. In this action, fraud is of the essence of the injury. There are, therefore, two main points to be proved,—the fraudulent nature of the wrong committed by the defendant, and the nature of the injury suffered by the plaintiff. The nature of the wrong to be proved is well defined by Wilde, C. J., in *Rodgers v. Nowill*.² The action was held not to be maintainable in *Singleton v. Bolton*³; for there no sale was proved to have been made by the defendant of a medicament of his own under the mark of the plaintiff, but both the plaintiff and the defendant used the name of the original inventor (Dr. Johnson), and no evidence was given of the defendant having sold his ointment as if it had been prepared by the plaintiff. So, also, in *Crawshay v. Thompson*,⁴ it was held that the mark used by the defendants was not used with the intention of supplanting the plaintiffs, but that it was applied to certain goods in the ordinary course of business, and in execution of orders. This decision is grounded on the evidence in the case, and turns on the question of what constituted such a fraudulent use. There was no proof of an intention on the part of the defendants to sell their manufacture as and for that of the plaintiffs; but it was contended that their motive in using the mark was immaterial, if the resemblance in fact existed, and they were aware of it. In *Blanchard v. Hill*,⁵ Lord Hardwicke said: “It is not the single act of making use of the mark that was sufficient to maintain the action, but the doing it with a fraudulent design to put off bad cloths by this means, and to draw away customers from the other clothier.” McLean, J., said, in *Coffeen v. Brunton*,⁶ that from the cases theretofore decided it would seem that an intentional fraud is not necessary to entitle the plaintiff to protection, for the injury will be neither greater nor less by the knowledge of the party. “If he has adopted

¹ See Act of March 3, 1881.

² *Ante*, § 356.

³ 3 Doug. 293; R. Cox, 634.

⁴ 4 Man. & Gr. 357; 5 Scott N. R. 562; 11 L. J., C. P. 301.

⁵ 2 Atk. 484; R. Cox, 633.

⁶ 4 McLean, 516; R. Cox, 82.

the same mark which will cause his article to be taken for another in the market, which is known and approved of, it is an injury which the law will redress. In commercial dealings, the utmost good faith should be observed, and no one is permitted to go into the market with a deception of this character, so as to profit by the good faith or established reputation of another." In *Dale v. Smithson*,¹ Hilton, J., held that the right of the plaintiffs to maintain the action did not in any degree depend upon the inquiry as to whether the defendants intended to appropriate to their use a trade-mark or label, known by them to have been devised and employed by the plaintiffs in their business; but that it was enough if it was made to appear that the defendants did the act complained of; and so, although they may have used the mark in ignorance of its being the exclusive property of any one. It must be observed that this case, although nominally an *action* under the Code of Procedure of the State of New York, is not the technical *action on the case*, but was really a suit in equity to restrain an infringement; and equity will restrain independent of motive. This principle has been so uniformly maintained by the courts, that it is almost supererogatory to cite further illustrations; but, to place the question still more clearly before the reader, we will look at other cases. In *Blofield v. Payne*,² the declaration stated that the plaintiff, being the inventor and manufacturer of metallic hones, used certain envelopes for the same, denoting them to be his, and that the defendant wrongfully made other hones, wrapped them in envelopes resembling the plaintiff's, and sold them as his own, whereby the plaintiff was prevented from selling many of his hones, and they were depreciated in value and reputation, those of the defendant being inferior. The court held that the plaintiff was entitled to some damages for the invasion of his right by the fraud of the defendant, though he did not prove that the defendant's hones were inferior, or that he had sustained any specific damage. Where a right is invaded by a fraudulent act, though no specific injury be

¹ 12 Abb. Pr. 237; R. Cox, 282.

² 4 Barn. & Ad. 410; 1 N. & M. 353; 2 L. J., K. B. (N. S.) 68.

proved, some damages, at law, must be given; as when a publisher of a magazine or newspaper assumes the name of one previously published, or represents the new publication as a continuation of the former, when it is not so.¹ In *Marsh v. Billings*,² which was an action on the case, sounding in tort, and governed by the same principle which has been repeatedly recognized and acted on by courts, in reference to the fraudulent use of trade-marks, it was held that the use of the words "Revere House" on coaches was a fraud on the plaintiffs, and a violation of their rights, for which an action would lie, without proof of actual or specific damages. The same rule was observed in *Blofield v. Payne*,³ where it was held that by the defendant's act the plaintiff was entitled to some damages, inasmuch as his right had been fraudulently invaded. So, also, in *Rodgers v. Nowill*.³

§ 459. *To entitle him to recover*, it is necessary for the plaintiff to show that an actual damage has been suffered. But sometimes the law will presume damages, as where the defendant made and sold medicines, calling them "Thomsonian Medicines," as and for the medicines made and prepared by the plaintiff, so that persons purchasing the same supposed and believed that they were purchasing the medicines made and prepared by the plaintiff; for that was a fraud upon the plaintiff for which the law will presume some damage. Such a case, therefore, being proved, the plaintiff will be entitled to recover nominal damages, at least, and something more, if he can make it appear to the satisfaction of a jury that he has sustained more than nominal damage.⁴

§ 460. The nature of the wrong suffered by the trader whose mark is fraudulently used is twofold. It consists in the injury to his reputation where an article of inferior value is palmed off upon the purchaser; or else in the injury done to his trade by general diversion of custom. In *Coffeen v. Brunton*,⁵ the court said, that if the defendant made repre-

¹ *Hogg v. Kirby*, 8 Ves. 215.

² 7 Cush. 322; 14 Monthly L. R. (4 N. S.) 664; R. Cox, 118.

³ *Ubi supra*.

⁴ *Thomson v. Winchester*, 19 Pick. 214; R. Cox, 7.

⁵ 4 McLean, 516; and same case in 5 McLean, 156.

representations that his liniment contained the same ingredients as that of the complainant, while in fact it was not only different from the "Chinese Liniment," but greatly inferior to it, the effect must be to destroy in the market the value of the complainant's liniment; and that would be ground for the equitable interposition of a court of equity. That is an injury for which a court of law cannot give adequate compensation. However valuable the complainant's invention may be, yet if it be discredited by a worthless article, it would be impossible, in any reasonable time, to restore the public confidence in the genuine article. In this consists the injury; and the fraud arises from the false representations that the composition is the same.

§ 461. Nor need the representations be *immediate* in order to give a ground of action, as is shown by the case of *Sykes v. Sykes*.¹ The defence there proved that the sale of the spurious article was made to retail dealers, who were aware of the fraud; but nevertheless it was held that the sale to them for the purpose of a resale to the public, who would be deceived by the printed stamp, was substantially the same thing as a direct fraud by the original vendor.

§ 462. *Remedy in Equity*. — As a general proposition, it is only when the legal title is clear that a court of equity will interfere by injunction to restrain the use, or the colorable infringement, of a trade-mark. In cases of doubt the court should not grant or retain an injunction until the cause shall have been heard upon the pleadings and proofs, or until the complainant shall have established his right by an action at law. Such was the decision of the New York Court of Appeals, in 1848.² So the Lord Chancellor, in *Spottiswoode v. Clark*,³ who said that, unless the case be very clear, it is the duty of the court to see that the legal right is ascertained before it exercises its equitable jurisdiction. And he said that for this there are good reasons: the title to relief depends on

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

² *Partridge v. Menck*, 2 Sand. Ch. 622; 2 Barb. Ch. 101; and 1 How. App. Cases, 558.

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

a legal right, and the court only exercises its jurisdiction on the ground that that legal right is established. The objection to granting an injunction in the first instance is, that it promotes after litigation. The order either grants an injunction and compels the complainant to bring his action, or suspends the injunction, with liberty to the complainant to bring an action. If you compel him to go to a court of law, you promote litigation, and this course is forced upon parties at a time when their feelings are deeply engaged in prosecuting their imaginary rights. There is also, said he, another objection, which is, that the court expresses a strong opinion, and it ought to be a strong opinion, and then sends the right to be tried. It is better that the court should abstain from expressing such an opinion. But, after all, the chief objection is, that the court runs the risk of doing the greatest possible injustice, in case its opinion upon the legal right should turn out to be erroneous. If the plaintiff prove his title by a successful action at law, he is indemnified by the defendant in the account which the court has directed the latter to keep. On the other hand, if the plaintiff fail in his proof at law, there are no means in his power for compensating the defendant for the loss he will have sustained by the suspension of his trade during the operation of the injunction. This is a sufficient reason for withholding that remedy, unless there be a very clear preponderance of proof in favor of the complainant in the first instance, or some conduct be shown on the part of the defendant which renders it unadvisable to permit him to continue his trade upon the footing of an account to be taken.¹ Mr. Justice McLean, in *Coffeen v. Brunton*,² said that the right of the party who claims protection must be clear; for, if it be controverted, chancery will leave the party to his remedy at law; or, at least, to such a proceeding as shall present the whole merits of the controversy, and enable the court to decide it. Mr. Justice Duer, in the case of the *Amoskeag Manufacturing Company v. Spear*,³ said that the rule is fully settled, and is recognized in nearly all the cases,

¹ Lloyd on Trade Marks, p. 17.

² 5 McLean, 256.

³ 2 Sand. S. C. 599.

that, in suits for infringements of trade-marks, an injunction is never to be granted in the first instance, if the exclusive title of the plaintiff is denied, unless the grounds upon which it is denied are mainly frivolous. When the title is disputed, the course is to let the motion for an injunction stand over until the plaintiff has established his legal right in an action at law; and Mr. Justice Duer cited with approval the ruling of Lord Cottenham, in *Motley v. Downman*,¹ who used the strong expression that “he cannot conceive a case in which the court will interfere at once by an injunction, so as to prevent the defendant from disputing the plaintiff’s legal title.” Daly, J., in *The Merrimack Manufacturing Company v. Garner*,² said that courts of equity have not interfered in cases of this kind, except in aid of a legal right; and if the fact of the plaintiff’s property in the trade-mark, or if the defendant’s interference with it has appeared at all doubtful, the plaintiff has been left to establish his case first by an action at law. Where the title of the plaintiff to appropriate a certain mark or name to himself was not made out, or considerable doubt existed respecting it, the court discharged an injunction order, upon the defendants’ entering into an undertaking in a penalty to keep an account of their sales, and render the same when required by a competent court.³

§ 463. The same principle has been applied by courts in the exercise of their jurisdiction in patent and copyright cases, and on the same grounds. In *Stevens v. Keating*,⁴ the learned judge said that, “if the injunction, having been once granted, turns out to be unfounded, you are doing an irreparable injury to the parties restrained, whereas, by withholding it, you may be permitting some injustice, but certainly not an injustice at all equal to that which you are doing by improperly granting it.” In this case, the court went so far as to fix the time within which the plaintiff was to bring his action; and on his failing to proceed to the trial of that action, upon grounds

¹ 3 Myl. & C. 14.

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

³ *Fetridge v. Merchant*. 4 Abb. Pr. 156; also *Spottiswoode v. Clark*, *supra*.

⁴ 2 Ph. 338.

which by the court were considered to be insufficient to justify his delay, and upon a subsequent motion on the part of the defendant, the injunction which had been granted on the merits of the case was dissolved, and the defendant was directed to keep an account of his profits.

§ 464. The rendition of a verdict in a case in favor of plaintiff is *not* conclusive upon the right of such party to an injunction (where it is manifest that error has been done¹); but the considerations which would justify a judge in renewing the discussion of a patentee's title, after solemn hearing and judgment at law, should be such as, if presented to his view after a trial at law, would have induced him to set aside the verdict.² No interlocutory injunction should issue unless complainant's title be clear, or admitted, for the court is not bound to decide doubtful and difficult questions of law, or disputed questions of fact, nor to exercise this high and (if exerted rashly) dangerous power before the alleged offender has had an opportunity for a full and fair hearing. The chief object is to prevent irreparable mischief, not to give complainant means of coercing a compromise on his own terms.³

§ 465. If the defendant shows a belief that he has a just defence, and is not a wilful pirate, then the case should be one of evident mistake of law or fact, or both, in the defence which he sets up, which will justify the *festinum remedium*.⁴

§ 466. The constitutional right of a trial by jury applies only to actions at common law. In suits in equity, an inquiry by the jury depends upon the discretion of the court,⁵ it not being conclusive, but only an aid to the conscience.

§ 467. Upon motions for preliminary injunction, if, after a careful and impartial examination of the case, the court be of opinion that the complainant is entitled by law to the writ, it is a duty to grant it without evasion.⁶

§ 468. In equity, if the defendant, without fraud, use the trade-mark of the complainant, he is still liable. If the right be

¹ *Many v. Sizer*, 1 Fish. 31.

² *Parker v. Brant*, 1 Fish. 58.

³ *Parker v. Sears*, 1 Fish. 93; *Goodyear v. Dunbar*, Ibid. 472.

⁴ Ibid.

⁵ *Ely v. Monson*, 4 Fish. 64.

⁶ *Blanchard v. Reeves*, 1 Fish. 103.

violated, it matters not whether it be by fraud or by mistake. The whole question in such case is whether the defendant's label or mark is calculated to deceive the public, and to lead them to suppose that they are purchasing an article manufactured by the complainant, instead of by the defendant.¹ To entitle a complainant to protection against a false representation, it is not essential that the article should be inferior in quality, or that the individual should fraudulently represent it, so as to impose upon the public; but if, by representation, it be so assimilated as to be taken in the market for an established manufacture, or compound of another, the injured person is entitled to an injunction. The injury is not the less, though the false representations be made without a knowledge of such interference.²

§ 469. *Discovery, Account, and Costs.* — Although it is not within the scope of this treatise to discuss matters which can be found more fully and more ably treated in books devoted to equity jurisprudence, and in books of practice, still this subject is worthy of observation, in its relation to trade-marks. In many cases, the aggrieved party might be at a great disadvantage, unless he had some means of access to his opponent's books and papers. To enable him to fix the amount of injury done by the wrongful conduct of the other, he must look to discovery. How shall he, in the majority of cases, ascertain the amount of sales, unless in this mode? But how shall he proceed?

§ 470. We find a statutory provision³ by which all courts of the United States have power in the trial of actions at law, on motion and due notice thereof being given, to require the parties to produce books or writings in their possession or power, which contain evidence pertinent to the issue, in cases and under circumstances where they might be compelled to produce the same by the ordinary rules of proceeding in chancery. But this may really afford no remedy. On failure, judgment may be given against the defendant by default,

¹ *Millington v. Fox*, 3 Myl. & C. 339; *Davis v. Kendall*, 2 R. I. 566.

² *Coffeen v. Brunton*, 5 McLest., 256; *R. Cox*, 132.

³ Judiciary Act of Sept. 24, 1789; re-enacted, Rev. Stat., sect. 724.

and the plaintiff be left to grope in the dark. He must, then, resort to a court of equity. There the familiar canons of chancery jurisprudence stand in his way, if he seeks discovery to enable him to enforce a forfeiture; for equity does not favor forfeitures. But if he relinquish all claim to a penalty or forfeiture, he may entitle himself to a discovery in aid of an action at law for the recovery of damages.¹

§ 471. As a general rule, the costs of litigation must be paid by the infringer,² even though he be an infant, who acted in ignorance, and who submitted at once.³ But where defendants had innocently bought and sold, as genuine, an article which was in fact spurious, although they were restrained from infringing the complainant's trade-mark, they were not ordered to account for profits, nor compelled to pay the complainant's costs. The Master of the Rolls said, substantially, that the right to an injunction usually carries with it the right to costs; but if complainants ask for costs, and for something more than they are entitled to, they will lose the costs which otherwise they might have received; and if the defendants had offered to submit to the injunction and to pay the costs, and the complainants had afterwards brought the case to a hearing, he would have given the defendants costs subsequent to the offer.⁴ Unfounded allegations in the bill are reasons for granting costs to a defendant, although the complainant otherwise prevailed;⁵ and where a complainant has set up claims as to a copyright, and gone into the internal structure of the defendant's work, but failed on that point, the defendant pays but a half, instead of the whole, of the taxed costs.⁶ So, also, although a perpetual injunction is granted,

¹ See authorities cited in 2 Abb. U. S. Cts. Practice, p. 92.

² *Rodgers v. Nowill*, Wigram, V. C., 6 Hare, 325. *Common Pleas*, 5 C. B. 109; 17 L. J., C. P. 52; 11 Jur. 1039; 10 L. T. 88. *Jurgensen v. Alexander*, 24 How. Pr. 269; R. Cox, 298. *Edelsten v. Edelsten*, 1 De G., J. & S. 185; 9 Jur. (N. S.) 479; 7 L. T. (N. S.) 768; 11 W. R. 328; 1 N. R. 300. *McLean v. Fleming*, 96 U. S. 245.

³ *Chubb v. Griffiths*, 35 Beav. 127.

⁴ *Moet v. Couston*, 83 Beav. 578; 10 L. T. (N. S.) 395; 4 N. R. 86.

⁵ *Pierce v. Franks*, 15 L. J. Ch. 122; 10 Jur. 25. *Rose v. Loftus*, 47 L. J. Ch. 576; 38 L. T. (N. S.) 409. *Compagnie Laferme v. Hendrickx*, Cox's Man., case 512. *McLean v. Fleming*, *supra*.

⁶ *Metzler v. Wood*, 8 Ch. D. 603.

no costs will be given, where the plaintiffs have refused the defendant's offer at their peril in respect of costs.¹ Where defendants offer to print their labels so that they could not be mistaken for the plaintiffs', both injunction and costs were refused, the defendants having acted in good faith.² But defendants were required to pay costs, although they had offered to submit, since they had not offered to pay costs up to the time of the offer.³ Where a case is sufficiently open to doubt, although an injunction has been granted below, an appellate court will not give costs to either party.⁴ Nor will costs be allowed to a successful but disingenuous defendant.⁵ In one case,⁶ although a motion was refused only because of the complainant's laches for fifteen months, the defendant was required to pay all costs of the application; and the prevailing complainant will be allowed costs, although notice was not given before filing the bill.⁷

§ 472. A common carrier, entirely innocent of fraudulent intent, but having certain falsely marked goods in his possession for the purpose of transportation, may be enjoined; but the fact of good faith is ground for refusing costs. This was the ruling in *Upmann v. Elkan*,⁸ in 1871, by Lord Chancellor

¹ *Hudson v. Bennett*, 12 Jur. (n. s.) 519; 14 L. T. (n. s.) 698; 14 W. R. 911. *Millington v. Fox*, 3 Myl. & C. 338. *Burgess v. Hills*, 26 Beav. 244; 28 L. J. Ch. 356; 5 Jur. (n. s.) 233; 32 L. T. 328; 7 W. R. 158. *Moet v. Couston*, *supra*.

² *Bass v. Dawber*, 19 L. T. (n. s.) 626.

³ *McAndrew v. Bassett*, 4 De G., J. & S. 380; 33 L. J. Ch. 566; 10 Jur. (n. s.) 550; 10 L. T. (n. s.) 442; 12 W. R. 777.

⁴ *Devlin v. Devlin*, 69 N. Y. (24 Sickels) 212; 15 Alb. L. J. 290.

⁵ *Ainsworth v. Walmesley*, L. R. 1 Eq. 518; 33 L. J. Ch. 352; 12 Jur. (n. s.) 205. *The Leather Cloth Co. v. Lorsont*, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. (n. s.) 661; 18 W. R. 572. *Rodgers v. Rodgers*, 31 L. T. (n. s.) 285. *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; 44 L. J. Ch. 223; 32 L. T. (n. s.) 80; 23 W. R. 313. *Talcott v. Moore*, 18 N. Y. Sup. Ct. (6 Hun) 106. *Wylam v. Clarke*, W. N. 1876, p. 68; *Robineau v. Charbonnel*, W. N. 1876, p. 160; L. J. Notes of Cas., 1876, p. 104. *Fetridge v. Wells*, 13 How. Pr. 385; 4 Abb. Pr. 144; R. Cox, 188.

⁶ *Cartier v. May*, Lloyd on Trade Marks, 55, 57.

⁷ *Coats v. Holbrook*, 2 Sand. Ch. 586; 3 N. Y. Leg. Obs. 404; R. Cox, 20. *Pierce v. Franks*, *supra*. *Burgess v. Hately*, 26 Beav. 249. *Burgess v. Hills*, *supra*. *The Collins Co. v. Walker*, 7 W. R. 222. *Field v. Lewis*, Seton, 4th ed., 237. *Weed v. Peterson*, 12 Abb. Pr. (n. s.) 178. *Sawyer v. Kellogg*, 9 Fed. R. 601.

⁸ L. R. 7 Chanc. Appeals, 130; 41 L. J. Ch. 246; 25 L. T. (n. s.) 813; 20 W. R. 181.

Hatherly, affirming a decree of the Master of the Rolls. A firm of forwarding agents in London received from correspondents abroad a number of boxes of cigars, being counterfeit brands, to be delivered to several persons in England. On application by the makers, whose brand had been imitated, the agents gave information against the consignors, and offered either to send back the cigars, or to remove the brand. The Lord Chancellor said: "It has been urged that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods which, though fraudulently marked, were not for their own use, nor to be sold for them for their own benefit, but were merely received for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the court with respect to trade-marks. If that argument prevailed, persons being abroad, as was the case in this instance, and inclined to commit frauds upon an English trade-mark, could easily do so by sending their different consignments together to the possession of the defendants (who appear to be reputable agents and warehousemen), thereby committing an injury in a manner most convenient to themselves and very mischievous to the person entitled to the benefit of the trade-mark." In such a case, the agent may be compelled by a court of equity to disclose the names of places to which goods having false marks have been transmitted by him, and all other information that is within his knowledge, or may be gathered from his books, *except* the names of customers, tending to redress the grievance of the complainant.¹—An injunction having been granted to restrain a dock company from parting with wine spuriously marked with the plaintiff's mark, on motion by a third person, who had advanced money on the dock-warrants, in ignorance of the spuriousness of the marks, for the wine to be delivered to him, it was held that he was entitled to have it so delivered, on its being recorked, but that he must pay the costs

¹ *Carver v. Pinto Leite*, appeal, James and Mellish, L. JJ., L. R. 7 Ch. 90; 41 L. J. Ch. 92; 25 L. T. (N. S.) 722; 20 W. R. 134.

of the application. Romilly, M. R., said, "The dock company would have the first charge on the wine for their expenses; Mr. Uzielli the second, for his advances and his costs; and the plaintiffs the third, for their costs of suit."¹ Wharfingers, with whom spurious champagne bearing a counterfeit brand of "Veuve Clicquot, Ponsardin & Co." was warehoused, and who had notice of the injured party's intention to apply for an injunction, refused to deliver up the wine to the indorsee of the dock-warrants. *Held*, that they were justified in so acting.²

§ 473. *Slander of Trade-Mark Property.* — The exclusive right of user of an arbitrary symbol is property. On the faith of it, goods are sold. But if a trader's rival in business bring that symbol into doubt or disrepute, the goods bearing it are not sold. There is no just reason why the owner of the symbol, that has by adoption become a trade-mark, should not be protected. Section 9 of the act of Congress of March 3, 1881, recognizes the justice of redress, by allowing an action on the case for a false representation or declaration, oral or written, in respect to registering a trade-mark in the Patent Office. That is obviously for the reason that any statement in the nature of a libel or slander might cause doubt, confusion, and consequent loss of trade. But for such a wrongful act, there or elsewhere, redress must generally be sought in a law court. To warrant relief by injunction, it is essential that an infringement of some actual property right be shown.³ A court of equity will not, therefore, restrain the utterance of false statements on the ground of protecting a trade-mark, inasmuch as that is not, strictly speaking, an infringement on a property right; and the rule is well established that equity will not enjoin a mere slander or libel, or the utterance of an untruth.⁴ It has been said, that "words, written or oral, which falsely depreciate the

¹ Ponsardin v. Peto, and Ex parte Uzielli, 33 Beav. 642; 33 L. J. Ch. 371; 10 Jur. (N. S.) 6; 9 L. T. (N. S.) 567; 12 W. R. 198.

² Hunt v. Maniere, 34 L. J. Ch. 144; 11 Jur. (N. S.) 73; 11 L. T. (N. S.) 723; 13 W. R. 363; 5 N. R. 295.

³ High on Injunctions, § 1093.

⁴ Singer Manufacturing Co. v. The Domestic Co., 49 Ga. 70.

value of chattel property, may be made the subject of an action, provided that special damage ensue from them. The distinction between a libel or slander on a person in the way of his trade, which is actionable without proof of special damage, and words injuriously reflecting on the quality of his wares or merchandise, is sometimes rather fine.”¹ But few cases are found in the books where written or oral remarks on property have been held actionable under the law of libel or slander;² and even then it has been held that special damage must be alleged and proved.³ On the other hand, it has been held that a statement in a newspaper, that a ship of which the plaintiff was owner and master was not seaworthy, was a libel on the plaintiff in his trade and business, for which he might recover damages without proof of malice, or allegation of special damage.⁴ And it has been held in a recent case, that the imitator of a label not amounting to a trade-mark was liable in an action in the nature of an action on the case; and that specific damage need not be alleged or proved as essential to sustain the action, but the jury might give general damages.⁵—As to *what is slander* in such cases, it may be said that every act of selling inferior goods, with an imitation of another’s trade-mark thereon, is in effect a slander. The Court of Cassation of France, in 1880, held that a registered trade-mark is so far independent of the object to which it is attached that the owner thereof has a right of action against counterfeiters or imitators of that work, even when it shall be intended by the wrong-doers for, or is affixed to, a product the sale of which is forbidden by law (as, for example, a secret remedy).⁶ It may readily be understood that such a use might bring a trade-mark into contempt, or make it infamous. And the slander or libel may be not the less grievous, although the imitator of a trade-mark does not affix it to goods for sale.

¹ Broom Com., 514, 764; 1 Hilliard on Torts, 342.

² See *Lindon v. Graham*, 1 Duer, 670.

³ *Evans v. Harlow*, 5 Ad. & Ell. (n. s.) 624; *Kendall v. Stone*, 1 Seld. 14.

⁴ *Ingram v. Lawson*, 6 Bing. N. R. 212.

⁵ *Conrad v. Uhrig Brewing Co.*, 8 Mo. App. 277.

⁶ *Dunèsme v. Anastay*, 25 Annales, 245.

In the Tribunal Civil of Lille, in 1883,¹ this point was illustrated as follows. A judicial test had been ordered, for the purpose of ascertaining the quality of zincs employed by the defendant, a zinc manufacturer of Lille, in a certain construction. The establishment of the thickness of the zincs was an especial object of investigation, and for that purpose there was a classification of numbers on the tariffs of metallurgic companies. In the course of the testing, to support his pretensions as to the relative thickness of the zincs involved in the examination, the defendant produced a table of comparisons, and exhibited to the architect expert two coins of zinc bearing the stamp of the plaintiff company, "La Vieille Montagne," whose manufactories were in France. The court said: "Inasmuch as in the course of a contest as to the value of works executed by him, Béglim produced, as pieces of comparison with the materials used by him, pieces of zinc bearing an imprint similar to the mark of the plaintiff company, and the words 'Vieille Montagne — Paris,' the number indicating a thickness inferior to the real thickness, although it appeared that the defendant had acted without fraudulent intent, he was liable." The plaintiff was awarded three hundred francs damages and costs. The act of the defendant may be classified as slander.² — The Court of Appeal of England, in 1884,³ held that an oral slander, prejudicial to one's business, may be enjoined. This is probably the first case of the kind.

¹ *Société de la Vieille Montagne v. Béglim*, 29 *Annales*, 62.

² See *ante*, § 443, "Perversion of Mark."

³ *Loog v. Bean*, 20 *Central Law Journal*, 13.

CHAPTER X.

DEFENCES.

- § 474. A defence may be either affirmative or negative.
- § 475. Unlawful business, deceit, etc.
- § 476. Noxious drugs palmed off as medicine.
- § 477, 478. Complainant must come into equity with clean hands.
- § 479. "Medicated Mexican Balm" case.
- § 480. Courts will weigh the effects of misstatements.
- § 481-483. False statement as to place of manufacture.
- § 484. A bill may be dismissed for even harmless deception.
- § 485-488. False statement of intrinsic excellence.
- § 489, 490. Untrue statement as to origin.
- § 491. As to quack medicines.
- § 492. Harmless, false, or exaggerated statement not fatal.
- § 493. Imitator sometimes estopped from alleging complainant's fraud.
- § 494, 495. Fictitious name of manufacturer not necessarily fraud.
- § 496. No defence that spurious article is equal to the genuine.
- § 497. Laches may be a defence.
- § 498. What not deemed laches.

§ 474. *A Defence may be either Affirmative or Negative.*— It may be affirmative, i. e. aggressive in attacking the prior title of the suing party, or an inherent defect in the nature of the matter or thing claimed as a technical mark, or for bad faith, or for some irregularity, or for laches amounting to abandonment. It may be merely a negative defence in taking an intrenched position, asking only to be let alone. In such case, a defendant does not assert a title in himself to the trade-mark claimed by his adversary, but is content with denying the use by him of imitations of the genuine mark; or, if he has used copies of the peculiar symbol alleged to have been infringed, asserts that he did not affix it to the same class of goods, but to another class, as he lawfully might do; or it may be that, by way of mitigation, he pleads his own good faith in the act charged. The most important of the grounds of defence to a bill for infringement is the well-

established rule of equity, that the protection of the court will not be given to one whose case is not founded in truth.¹ That appears to have been first made use of in the case of *Hogg v. Kirby*, in 1803.² The objection taken was that the complainant, who claimed protection for the title-page of his magazine, which professed to be “by William Granger, Esq.,” was in fact guilty of an imposition on the public, it being shown that the name of the alleged author was fictitious. The excuse offered was, that such was in accordance with a custom of the trade. Lord Eldon, C., said that he felt a considerable difficulty as to the question, and that the custom, though it might be very usual, appeared to him very much like a fraud on the public. He nevertheless granted an injunction to restrain the defendant from publishing a magazine with a similar title, and said that the matter of misstatement should be left to form an ingredient in an action for damages.— In *Partridge v. Menck*,³ in 1848, the complainant claimed an exclusive right to impose upon the public matches made by himself as those made by one Golsh; and, although the court decided the cause on the ground of dissimilarity of the labels, a strong opinion was expressed against his alleged right, on account of attempted deception. — So, also, in *Samuel v. Berger*,⁴ where the plaintiffs asked the court to aid them in passing off watches made by them as those made by another watch-maker named Brindle, from whom they had bought authority to use his name, which had acquired a reputation. The defendants sold other watches made by Brindle before the sale to the plaintiff, and stamped with his name. The court refused an injunction, with costs, since to grant it would be to protect the sale of the spurious article, and restrain that of the genuine.

§ 475. When Congress — in the registration act of 1870,⁵ and also in that of 1881⁶ — declared that no action should be maintained under it, by any person claiming an exclusive right to any trade-mark used or claimed in an unlawful busi-

¹ See *ante*, § 71.

² 8 Ves. 215.

³ 2 Sandf. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 158; R. Cox, 72.

⁴ 24 Barb. 163; 13 How. Pr. 342; R. Cox, 178.

⁵ Rev. Stats., sect. 4943.

⁶ 1 Supplement to Rev. Stats., chap. 130, sect. 8.

ness or upon any article injurious in itself, or formed and used with a design to deceive the public, it merely enunciated a well-established rule of law and equity. That had always been so; but possibly it was thought that the ill-disposed might presume on the fact of registry. In a Circuit Court of the United States, in 1847,¹ it was held that the manufacturer of a quack medicine was not entitled to the intervention of a court of equity; for it is not the office of chancery to intervene, by summary process, in controversies connected with such a matter. The refusal of an injunction was on the ground of misrepresentations by the complainant, as to the quality and properties of his medicine. In the same court, in 1855,² a similar ruling was made.— In 1858, the “Bloom of Youth, or Liquid Pearl,” suit was brought to restrain the use of that fancy name. The defence showed that the complainant’s preparation contained carbonate of lead, or other noxious ingredients, whereas he described it as being “free from all mineral and poisonous substances,” and was therefore not entitled to relief. The court below refused an injunction, and dismissed the bill. The Court of Appeals of Kentucky, in 1873, affirmed the decree.³— The New York Court of Appeals, in 1874, in “Wolfe’s Aromatic Schiedam Schnapps” case,⁴ held that the plaintiffs were not entitled to the favorable consideration of a court of equity because (1.) they had endeavored to secure a part of the good-will of the defendants’ business, while avoiding an infringement of their trade-mark; and (2.) that they, as well as the defendants, had improperly represented their article as not merely a spirit, but a medicinal preparation.— But an intention to deceive the public will not always be inferred from the mere fact of untrue statements.⁵— In *Hennessey v. Wheeler*, in 1877,⁶ the New York Court of Common Pleas dismissed a complaint on the ground that the plaintiffs were themselves guilty of misrepresentation in selling, as quart and pint bottles, bottles that contained less, the defi-

¹ *Fowle v. Spear*, 7 Pa. L. J. 176; R. Cox, 67.

² *Heath v. Wright*, 3 Wall. Jr. 141; R. Cox, 154.

³ 2 Bush, 131; 15 Am. R. 707.

⁴ *Wolfe v. Burke*, 56 N. Y. (11 Sickels) 115.

⁵ See *ante*, § 72.

⁶ 51 How. Pr. 457.

ciency amounting to about seven thirtieths. The Court of Appeals, however, took a different view,¹ and *held* that, as the bottles were not sold by the plaintiffs or others as measures of capacity, but were of the ordinary sizes used in the trade, the capacity of which was generally understood; and there being no evidence that any one had been or was likely to be deceived, the plaintiffs were therefore not disentitled to relief. But the principle was conceded, although the facts did not demand its application.

§ 476. The court said, in *Smith v. Woodruff*,² speaking of the allegation that the article pirated on was itself a quack medicine, that the justice and morality of this defence were not very high in that instance, yet the rule must be followed if the case were brought within its application; that it is a defence that ought to be suggested by the court in some cases, and probably would be in all cases where the imposition is flagrant. For instance, where a quack compounds noxious and dangerous drugs, hurtful to the human constitution, and advertises them as a safe and sure remedy for disease; or where some charlatan avails himself of the prejudice, superstition, or ignorance of some portion of the public to palm off a worthless article, even when not injurious, the case falls beneath the dignity of a court of justice to lend its aid for the redress of such a party, who has been interfered with by the imitations of another quack or charlatan. But it has been held that, in a suit to restrain infringement, a defendant cannot, by alleging injurious qualities in the complainant's goods, compel him to disclose the ingredients of which they are composed.³ In one case,⁴ an inquiry on that point was allowed, but only because the complainant had opened the door thereto, in his own testimony.

§ 477. The case of *The Leather Cloth Co. v. The American Leather Cloth Co.*,⁵ in the House of Lords, in 1865, furnishes

¹ 69 N. Y. (24 Sickels) 271; 15 Alb. L. J. 454; 25 Am. R. 188.

² 48 Barb. 438; R. Cox, 373.

³ *Tetlow v. Savournin*, 15 Phila. 170; 38 Leg. Int. 478.

⁴ *Burnett v. Phalon*, 21 How. Pr. 100.

⁵ 11 Jur. (n. s.) 513; 11 H. L. C. 523; 35 L. J. Ch. 53; 12 L. T. (n. s.) 742; 13 W. R. 873; 6 N. R. 200.

instruction upon more than one point, and it is well worthy of the expenditure of time in its perusal in regard to the question of truth in representations.

§ 478. The appellants and the respondents were rival joint-stock companies, engaged in the manufacture of leather cloth. The plaintiffs are an English company, formed in 1857, with limited liability, for the purpose of making and selling an article called leather cloth. They bought the business of an American company, formed for the purpose of carrying on this manufacture in the United States, and at West Ham, in the county of Essex, in England. The name of the company was "The Crockett International Leather Cloth Company." The original inventors and manufacturers of this article, called leather cloth, were a firm of "Crockett & Co." in the United States, who, upon the formation of the International Company, ceased to carry on a separate business, and became shareholders in that company, but resumed business, and were manufacturers of leather cloth in the United States. The International Company obtained, in the month of January, 1856, an English patent for tanning the leather cloth, and devised an elaborate label, to be attached to the goods manufactured by them, which, being circular, had its circumference formed by the words "Crockett International Leather Cloth Company, Newark," with the initials "N. J., U. S. A.," meaning New Jersey, United States of America, and also the words "West Ham, Essex, England." These words and letters formed the periphery or outer rim of the label. Within the circle, at the top, was the word "Excelsior," below which was an eagle with expanded wings, and below the eagle were printed these words: "Crockett & Co.'s Tanned Leather Cloth, Patented Jan. 24, 1856, J. R. & C. P. Crockett, manufacturers." The International Leather Cloth Company carried on business as leather cloth manufacturers, both in the United States and in England, until 1857. They used the stamp or label which has been described, as a trade-mark, affixing it to the goods which they manufactured. In 1857 the plaintiff's company was incorporated; and the International Company sold and assigned to the plaintiffs the

business carried on by them at West Ham, together with the English letters patent, with full power and authority to use all and singular the trade-marks that had been used by the International Company in their business in England. From the time of this sale, the plaintiffs carried on, at West Ham, the manufacture of leather cloth, according to the process originally introduced by Crockett & Co.; and they constantly used the trade-mark described, stamping it on their goods of the first quality. In 1861, the defendants were incorporated for the purpose of the manufacture and sale of leather cloth; and they used as a trade-mark, on goods of the first quality made by them, a stamp or label which appears to have been formed upon the model of the plaintiffs' trade-mark. They did not, however, make use of the word "patented," nor did they call their leather cloth "tanned." All these facts appear in the opinion of the Lord Chancellor, on appeal to him from Vice-Chancellor Sir W. P. Wood. The Lord Chancellor said: "To continue the old style of a firm is a very different thing from making false representations with respect to a vendible commodity, in order to give it greater value, and to create a greater demand for it in the market. The plaintiffs impose upon the public by selling goods which are, in reality, manufactured by themselves at West Ham, as being the goods of the Crockett International Leather Cloth Company, and as having been manufactured by Messrs. Crockett, who were the original inventors and manufacturers; and, further, they described their untanned goods as being tanned, and as being protected by the patent, which had not yet expired. Their request is to be protected, and therefore justified, in continuing to make these untrue statements to the public, in order to secure a monopoly for their commodity. There is a homely phrase, long current in this court, that a plaintiff must come into equity with clean hands: that is not so with the present plaintiffs, whose case is condemned by the principles to which they appeal." He thereupon, without hesitation, reversed the decision of the Vice-Chancellor, and dismissed the bill; but, in disapprobation of the conduct of the defendants, he did so without costs.

§ 479. In *Perry v. Truefitt*,¹ the plaintiff alleged that the name or designation "Medicated Mexican Balm" had become of great value to him as a trade-mark; and prayed an injunction and account. According to his own statement, the plaintiff used a printed show-card, in which he represented the article in question in the following terms: "Medicated Mexican Balm, for restoring, nourishing, strengthening, and beautifying the hair. Perry, 12 and 13 Burlington Arcade, London. It is a highly concentrated extract, from vegetable balsamic productions, of that interesting but little known country, Mexico, and possesses mild astringent properties, which give tone to weak and impoverished hair, and impart a glossy appearance to the naturally dull and harsh. Where there is a tendency to fall off, the Mexican Balm exerts its astringent qualities, and gradually, but infallibly, braces the pores of the cuticle, and arrests the deterioration of the most beautiful ornament of the human frame, — a fine head of hair. This admirable composition is made from an original recipe of the learned J. F. von Blumenbach, and recently presented to the proprietor by a very near relation of that illustrious physiologist." The fact appeared that one Leathart had invented the preparation, and sold the recipe for making it to the plaintiff. The Master of the Rolls did not think it a favorable case for the interposition of the court, there not being the least evidence that the composition was formed of vegetable balsamic productions from Mexico. Yet, as it was a case of some doubt, he let the matter stand over, with liberty to the plaintiff to bring an action.

§ 480. The circumstances in *Pidding v. How*² were less dubious. The plaintiff, in his labels and advertisements, intimated that the tea sold by him as "Howqua's Mixture," was made by Howqua, in Canton, and was purchased from him and imported into England by the plaintiff, in the packages in which it was sold; that the tea which gave it its peculiar flavor was very rare and high-priced, even in China, and was grown in but one province of that country, viz. Kyang Nan; and that it could not be procured in England at any price.

¹ 6 Beav. 66; 1 L. T. 384.

² 8 Sim. 477; 6 L. J. Ch. (n. s.) 345.

On behalf of the defendants, affidavits were made by persons, some of whom had been acquainted with Howqua. They stated that the mixed tea sold by the plaintiff was neither made nor used by Howqua; that it was composed of scented orange pekoe (which gave it its peculiar flavor), and of other black teas of the ordinary kinds; that orange pekoe was not considered, in China, to be one of the best teas; and that what sort of tea had been imported and sold in England for several years, and was generally imported and sold by persons in the tea trade; that no black tea was produced in the province aforesaid; and that the plaintiff purchased and mixed his teas in England. The Vice-Chancellor said, substantially, that, as between the plaintiff and the defendant, the course pursued by the latter had not been a proper one (he having imitated the plaintiff's marks); but that it is a clear rule, laid down by courts of equity, not to extend protection to persons whose case is not founded on truth. "And," said he, "as the plaintiff in this case has thought fit to mix up that which may be true with that which is false, in introducing his tea to the public, my opinion is, that, unless he establish his title at law, the court cannot interfere on his behalf." He accordingly dissolved the injunction, with liberty to the plaintiff to bring an action, reserving the question of costs.—In *Dixon Crucible Co. v. Guggenheim*,¹ the defendant made a point that the wrapper of the plaintiffs averred a falsehood, in stating that the article sold by them is prepared from *pure carburet of iron*. The court replied, that no intention to mislead appeared; that, at best, it is a question of science; that plumbago (graphite) is undoubtedly the proper name of the article, though it was long known to science as carburet of iron; and that it was entirely too nice a question to be decided upon a motion for a special injunction. Another point was made, that the label states that the plaintiffs' article is prepared by Joseph Dixon & Co., whereas the bill avers that it is prepared and sold by a corporation, viz. The Joseph Dixon Crucible Co. The court said that that difference was not of such a character as to destroy

¹ 3 Am. L. T. R. (St.) 288, and 2 Brewster, 321; *ante*, § 396.

the plaintiffs' right to equitable relief, there being nothing to indicate any attempt at deception or imposition, the corporation being the successor of the individuals.

§ 481. In *Palmer v. Harris*,¹ in the Supreme Court of Pennsylvania, in 1869, where an injunction had been refused below by reason of the plaintiff's false representation, the plaintiff claimed immunity from the strictness of the rule, because the falsehoods were in a foreign language, presumed not to be understood. The bill alleged that the plaintiff was a tobacco merchant in New York, and made superior cigars, known as the "Golden Crown," which he sold in large quantities; that in 1858 he devised a trade-mark, to wit, a golden crown, and had labels with that mark lithographed and printed, which, for his protection, he entered, on the 18th of December, 1858, in the office of the District Court of the Southern District of New York, in conformity with the act of Congress respecting copyrights;² and that from that time this trade-mark had been used by him and become identified with the golden crown cigars. The labels were used by placing a larger one inside of the cover of the cigar-box, and a smaller one over the edge of the box where the cover is opened. The defendant, who is a printer, made a great number of counterfeit labels of the plaintiff's trade-mark for persons unknown to the plaintiff, for the purpose of inducing purchasers to believe that they marked the "golden crown" cigars. Upon being notified, the defendant refused to discontinue the printing and sale of the counterfeit labels. The answer of the defendant admitted most of the allegations of the bill, but averred as follows: "It is true, as matter of fact, and I aver it to be so, that complainant's cigars are manufactured and sold in the city of New York, and not at Havana, and that therefore the announcement upon complainant's label, Exhibit A, in the words following: 'Fabrica de Tabacos de las Majores Vegas, de la Vuelta Abajo, Calle del Agua, No. 75, Habana,' is wholly untrue, and both calculated and intended to deceive, and, being so calculated and

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

² This act of entering as a copyright was a nullity in law. See *ante*, § 380.

intended, is not entitled to the aid of a court of equity for its protection."

§ 482. The genuine labels in this case were parallelograms, nearly square; on the smaller was inscribed "Golden Crown," below which was "L. P.," and below that "Habana." The larger was enclosed in an ornamental border. On it were "Golden Crown"; below that the figure of a golden crown; then the Spanish words above quoted; and below all, and outside the border, in very small letters, "Ent. according to Act of Congress, A. D. 1858, by Lorin Palmer, in the Clk's Office in D't'e't of the S. D't of N. Y." There was also a government revenue stamp on the box. The counterfeit was of the larger label, and was very similar to it, but wanting the certificate of the entry of the copyright. The appellant, the plaintiff below, made a point that the taking out of the copyright, and declaring that fact on the label, neutralized the words in Spanish; also, that the internal revenue stamp stated the kind, quantity, and district where manufactured; and that the assertions were innocent in their effect on the public, and that the court should not canvass the motive.

§ 483. The court, by Sharswood, J., said, among other things: "The party who attempts to deceive the public by the use of a trade-mark, which contains on its face a falsehood as to the place where his goods are manufactured, in order to have the benefit of the reputation which such goods have acquired in the market, is guilty of the same fraud of which he complains in the defendant.¹ He certainly can have no claim to the extraordinary interposition of a tribunal constituted to administer equity, for the purpose of securing to him the profits arising from his fraudulent act." As to the notice of the entry as a copyright, the court said: "Apart from the fact that this is in such very small type, and so abbreviated that it would probably escape the observation of every one whose attention was not specially directed to it, a circumstance which rather strengthens the evidence of an intention to mislead the public, what is there in the fact that

¹ See *Manhattan Co. v. Wood*, 108 U. S. 218; *Siegert et al. v. Abbott*, 61 Md. 276; and *ante*, § 71, where this doctrine is discussed.

the design or engraving had been copyrighted in the United States, inconsistent with the declaration that the cigars contained in the box were manufactured in Havana, of Cuban tobacco? But, again, it is said that the United States internal revenue stamp would at once undeceive the purchaser, there being a difference between the stamp used for articles imported and for those of domestic manufacture. Few persons would stop to notice this difference, and, besides, as it is alleged, the trade-mark is pasted on the inside of the lid, and when the box is open, for the purpose of retailing, the trade-mark is brought directly in the view of persons wishing to purchase, and the revenue stamp is not seen unless the lid is turned down, and the box examined on the outside. It is contended further, that the falsehood is in a foreign language, of which it is to be presumed that the plaintiff's customers are ignorant. Yet there is certainly enough to convey to every one who can read, that the cigars are from 'Havana.' . . . It is not necessary that any one person has been actually deceived or defrauded: it is enough that it is a misrepresentation calculated to have that effect on the unwary and unsuspecting." The decree refusing an injunction was affirmed, and the appeal dismissed at the cost of the appellant.

§ 484. In *Phalon v. Wright*,¹ the plaintiff claimed to have compounded a new perfume, and to have invented a name for it, to wit, "Extract of Night-Blooming Cereus." He did not claim any exclusive right in the perfume itself. He had thus chosen the name of a rare, though well-known flower, and claimed in the name alone an exclusive right, as his trade-mark. He admitted that name to be a deception, so far as used to indicate the real character of the compound; and that the perfume was not an extract from the flower, the mark being in that respect a pure invention. As an exhibit, the plaintiff produced an advertising card, used to give publicity to his preparation, upon which card he declared that the new perfume is the extract of the "Night-Blooming Cereus, distilled from this rare and beautiful flower, from which it takes its name." Thompson, J., said: "This is a deception,

¹ 5 Philadelphia, 464; R. Cox, 307.

intended to impose upon the public by exciting curiosity to learn the nature of the rare and beautiful flower. It may be that the deception is harmless. The manufactured perfume may be better than the genuine extract would be ; but still it is a deception, and the plaintiff has no right to expect a court of equity to aid him in carrying it on. . . . Thus the case stands upon the plaintiff's own showing. The defendants, by their affidavits, deny fully that the name upon their labels was used to imitate the plaintiff's labels ; and they show, by the affidavit of the lithographer by whom the label was drawn and prepared, that he did not know of the existence of the plaintiff's label when he designed and drew that of the defendants. The labels are so little alike, and the name of the defendants so distinctly printed upon theirs, that, as has already been said, no one purchasing Wright's Night-Blooming Cereus could suppose he was buying Phalon's. It is very manifest that the defendants did not sell their preparation as that of Phalon ; and they clearly marked it as their own production." The motion for an injunction was dismissed.

§ 485. In *Hobbs v. Français*,¹ the plaintiff moved for an injunction to restrain the defendant from violating his trademark. It appeared that he and another, under the firm name of Fabian & Co., in 1846, began the manufacture and sale in the city of New York of a certain powder "for beautifying the complexion and skin"; that they had adopted as the name of the said article the words "Meen Fun," and devised a label bearing that name, with certain devices upon it, to put upon the boxes and packages containing said article ; and that they had sold said article by the name of "Meen Fun," until 1848, when his partner, Fabian, transferred to the plaintiff his interest in business, and the right to use the firm name, labels, devices, and marks. Further, that after the said article had acquired a reputation, and the sales had become large and profitable, the defendant had made and sold an article of skin-powder, put up in boxes like those of the plaintiff, and had placed on them labels closely imitating the plaintiff's, with the words "Meen Fun" thereon.

¹ 19 How. Pr. 567 ; R. Cox, 287.

§ 486. The plaintiff's label read as follows: "Patronized by Her Majesty, the Queen. 'MEEN FUN,' the Celebrated Chinese Skin Powder for Restoring, Beautifying, and Preserving the Skin and Complexion, Preventing Cutaneous Eruptions, Chapping, and Obviating too Copious Perspiration. Adapted for all Climates. Fabian & Co., Sole Proprietors, 24 Mark Lane, London," etc.

§ 487. *Per Curiam*, Bosworth, C. J.: "The plaintiff's label is calculated to induce the belief, and probably was designed to induce the belief, that the article in the box on which it is pasted is manufactured in London; that the sole proprietors of it have their place of business at 24 Mark Lane, London; that it is intrinsically so excellent as to secure the patronage of her Majesty, the Queen; and that the labels have paid the stamp-duty required by some English statute. The truth is, that it is made in New York, and that her Majesty, the Queen, is probably ignorant of its virtues, or even of its existence. In this respect, there is a manifest intention to deceive and mislead the public. . . . The plaintiff's label, instead of indicating that he is the manufacturer of the article covered by it, represents him to be the sole agent in the United States of the proprietors of it, and that their place of business is in London. It appears by the defendant's affidavit, that it is the prevailing belief in this country that ladies' toilet articles of English or French manufacture are superior to those made in this country, and that the demand for the former is much better than for the latter. The plaintiff's labels, therefore, contain representations believed to be useful, and which must be known to be false; and to secure to the plaintiff by injunction an exclusive use of such a label, and the exclusive privilege of thereby deceiving the public, is an object to which a court of equity will not lend its aid. The court does not refuse its aid in such a case from any regard to the defendant, who is using the same efforts and misrepresentations to deceive the public, but on the principle that it will not interfere to protect a party in the use of trade-marks which are employed to deceive the public, and to deceive them by fraudulent representations contained in the labels and

devices which are claimed to constitute wholly, or in part, such trade-marks. On this ground, the motion for injunction must be denied.”

§ 488. Mr. Justice Duer applied this rule in *Fetridge v. Wells*,¹ — the “Balm of Thousand Flowers” case, — that they who come into a court of equity seeking equity must come with pure hands and a pure conscience. If they claim relief against the fraud of others, they must be free themselves from the imputation. The learned judge said, *inter alia*: “The position so strenuously insisted on, that the plaintiff’s firm have an exclusive property in the words ‘Balm of Thousand Flowers,’ or, which is the same thing, an exclusive right to use those words as a trade-mark, I wholly reject. . . . It may be true that the defendants, if permitted to use in their contemplated sales a trade-mark apparently the same as that of Fetridge & Co., would commit a fraud upon the plaintiff and upon the public; but if the plaintiff and his firm are themselves engaged in the execution of a systematic plan for deceiving the public; if they have been, and are, endeavoring, constantly and daily, to multiply their sales, and swell their profits by false representations of the composition, qualities, and uses of the liquid compound which they invite the public to buy, it is strenuously insisted that a court of equity would violate its principles, and abuse its powers, by consenting to aid them, by an injunction or otherwise, in accomplishing their design; and to this proposition I yield my fullest assent. . . . An exclusive privilege for deceiving the public is assuredly not one that a court of equity can be required to aid or sanction. To do so, would be to forfeit its name and character.” The injunction previously granted was therefore dissolved, but without costs, since, although the plaintiff might justly be required to pay costs, the defendants had certainly no title to receive them, being equally guilty of wrong.

§ 489. In *Partridge v. Menck*,² in the Court of Appeals of New York, in 1848, this question received a full consideration.

¹ 13 How. Pr. 385; 4 Abb. Pr. 144; R. Cox, 188.

² 1 How. App. Cases, 558; 2 Sandf. Ch. 622; R. Cox, 72.

This case came before the Vice-Chancellor of the first circuit on a motion founded on the bill and answer, to dissolve the preliminary injunction granted by an injunction-master, on filing the bill. It appeared by the bill that one Golsh, who formerly resided in the city of New York, began the manufacture of a certain kind of friction matches, usually known as "loco-foco matches," for which he acquired a great patronage. His matches were put up in small paper boxes, usually of brown color, made with a cap or cover, which, when placed on the box, covered about a third of its length; and his trade-mark was a cut representing a straw beehive surrounded by flowers and foliage, with the words "A. Golsh's Friction Matches" above the hive. The cut and the words were printed on a label, which was pasted upon the front of each box. The complainant succeeded Golsh in his business, and continued to manufacture and sell the same kind of matches, using the same mark, the label being sometimes varied. His business had extended so that large quantities of his matches were exported to the West Indies, Mexico, and South America. The bill charged that the defendants, Menck & Backes, had been and were engaged in manufacturing friction matches, purporting to be the Golsh matches. It set forth two labels as being used by the defendants upon the brown-paper boxes in which they put up their matches. One contained the beehive and foliage, over which were printed the words "Menck & Backes' Friction Matches, late chemist for A. Golsh," the words "late chemist for" being in letters smaller than the rest; and under the beehive were printed in two panels the number and street in which their manufactory was situated, etc. The other label was pretty much the same, the words "A. Golsh" being much larger and more prominent than those above them. It was charged that this was a piratical and fraudulent invasion of the complainant's trade-mark. The Vice-Chancellor said that, taking the whole label together as it appeared on a single box of matches when offered for sale, the resemblance of the beehive was qualified by the distinct terms, "late chemist for A. Golsh," so that the article did not purport to emanate from either Golsh or his suc-

cessor. He accordingly dissolved the injunction, placing his decision on the ground of dissimilarity in the labels of the respective parties. The complainant appealed to the Chancellor. He affirmed the decision, and upon the same grounds, not questioning the legal right of the complainant to use the mark set forth in his bill. The complainant thereupon appealed to the court of last resort. The Court of Appeals took a different view of the case, although the result was the same.

§ 490. *Per Curiam*, substantially: If the statements of the bill are analyzed, it will be found that the complainant claims the exclusive right to impose upon the public matches made by himself as those manufactured by A. Golsh. He alleges that "the label heretofore spoken of, which was used by said Golsh, had an imprint of a beehive, and the words 'A. Golsh, Friction Matches, 124 Twelfth Street, between 5th and 6th Avenues, New York,' which label has been and now is used by your orator without variation." In every essential particular, as it respected the complainant, the statement of the label was false. The matches were not Golsh's matches, in the sense in which it was intended that purchasers should understand those terms. Golsh was in Europe, and had no interest or agency in their manufacture. Oral declarations to a purchaser of the same kind, with a view to a sale of this article, it was conceded, would have been fraudulent. That they were made to assume a more permanent form, and one better calculated to impose upon those who relied upon the reputation, personal skill, and integrity of Golsh, can make no difference in the character of the transaction. It is no sufficient answer to this view of the subject, that the complainant obtained from Golsh the secret of the manner in which his matches were prepared, or that he manufactured an article in all respects equal to that offered by the former proprietor. So also did the defendants, if we may trust their answer. Nor does it alter the case that the complainant purchased the right to use the name of A. Golsh. The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce; and at all events, if the maxim that he

who asks equity must come with pure hands is not altogether obsolete, the complainant has no right to invoke the extraordinary jurisdiction of a court of chancery in favor of such a monopoly. The bill is therefore defective for want of equity. The order was affirmed unanimously.

§ 491. In *Fowle v. Spear*,¹ in 1847, the complainant applied for an injunction to restrain the defendant from using wrappers, labels, and bottles resembling those used by the complainant in his business of selling "Wistar's Balsam of Wild Cherry." Kane, J., refused the relief asked for. From his opinion, it appears that on one of the complainant's wrappers, which was made a part of the bill, the balsam was described as "a valuable family medicine for consumption of the lungs, coughs, colds, asthma, bronchitis, croup, whooping-cough, difficulty of breathing, pains in the side or breast, liver complaints, &c.," to which another paper, also among the exhibits, adds "influenza, hoarseness, pains or soreness of the chest, &c." The judge said: "It is not the office of chancery to intervene, by its summary process, in controversies like this. *Non nostrum tantas componere*. Looking at the incongruous group of diseases for which the balsam prescribes itself to public credulity, I must apply the principle of the Vice-Chancellor's decision in *Pidding v. How*, 8 Sim. 477, that a complainant whose business is imposition cannot invoke the aid of equity against a piracy of his trade-mark. The only remedy in such a case is at law." In 1855, the same judge made a similar ruling in the case of *Heath v. Wright*,² where the complainant sought to restrain the defendant from using the word "Kathairon," of assumed prodigious efficacy in many diseases.

§ 492. *A mere False or Exaggerated Statement* in a public advertisement will not deprive the owner of his right to protection.³ In *Curtis v. Bryan*,⁴ the defendant interposed the objection that the plaintiff's medicine was not what by the advertisement it purported to be; and that it was not per-

¹ *Ante*, § 475.

² 3 Wallace, Jr. 141; B. Cox, 154.

³ See *ante*, § 71, on this subject.

⁴ 2 Daly, 212; 36 How. Pr. 33; B. Cox, 484.

fectly safe or harmless, but that, on the other hand, it contained ingredients which are injurious and baneful to children. The court said: "It is difficult to conceive upon what principle of equity this defendant should be heard to raise this objection. His own conduct in regard to the subject matter is an unequivocal concession to the goodness and value of the plaintiff's article. He interposes this objection to avoid an injunction which restrains him from imitating the plaintiff's article. After the plaintiff's preparation had been in use for nearly twenty-five years, its sale having steadily increased during all that time, the defendant appears, and places upon the market an article which, by the practices and arts to which he has had recourse, he would have the public purchase as the plaintiff's article. If the article was not a good one, why should the defendant imitate it? If it was injurious to health, it is not reasonable to suppose that a prudent man would venture to introduce a similar article under the same name, and hope to succeed. . . . Experience is an excellent teacher, and the fair trial of an article will furnish unerring evidence of its worthlessness or value. It is obviously true, that if a medicine can stand the test of twenty years of experimental use, and grow steadily and constantly in favor, its properties cannot be injurious. But, as before observed, the good faith of this defendant, in raising the objection, may reasonably be questioned, and I am satisfied that it does not lie in his mouth to make it. If a man's acts are any indication of his belief, on any subject, the conduct and admissions of the defendant constitute a complete refutation to this objection. A man's faith is shown by his works." The defendant was accordingly restrained, with costs.

§ 493. In *Smith v. Woodruff*,¹ also, the doctrine of estoppel was applied. Admitting, for the sake of argument, that the plaintiffs' preparation was a fraud on the public, the court said that that suggestion comes with a poor grace from one who has, by the imitation, been guilty of the same fraud, if such it happen to be. This case was an appeal from an order dissolving an injunction restraining the defendant from

¹ 48 Barb. 438; R. Cox, 378.

manufacturing and selling a perfume called "Sweet Opopanax of Mexico"; from selling any perfumery with that name; from using the name in connection with any perfumery; from using the plaintiffs' label, or any imitation or counterfeit thereof; and from using the label then employed by the defendant, as set out in the complaint. From the opinion of the court, in reversing the order above mentioned, we learn that the plaintiffs, in connection with their label, put forth a puff, stating that "the opopanax is a native flower from Mexico, of rare and very rich fragrance, from which this extract is distilled," etc. On the part of the defendant, several perfumers made affidavit that they had examined the perfume of the plaintiffs; that they could tell, approximately, its ingredients; that it was not distilled from the flower of opopanax, but was a compound of several well-known tinctures or essential oils, combined with pure spirits. Others stated that there was a resinous *gum* in the market, of a disagreeable odor, but no *flowers* of opopanax. The plaintiffs and their chemists swore that the said opopanax was used in the preparation, distillation, and manufacture of said perfume, and that the perfume was made from it. Several perfumers also made affidavits that it was not possible for any perfumer to tell the ingredients of the plaintiffs' perfume. Under this contradictory state of evidence, the rule was not available to the defendant. The injunction was restored, with costs from defendant.

§ 494. *Fictitious Name of Manufacturer.* — The fact that a trade-mark bears a fictitious name as the name of the manufacturer does not affect the owner's right to protection, where it is shown that it is not used with any fraudulent intent, and does not in fact deceive the public. This point is illustrated by the case of *Dale v. Smithson*,¹ where Thomas Nelson Dale was adjudged to have a lawful right to the exclusive use of the following: "Courtria Flax, Thomas Nelson & Co. Warranted, Fast Colors and 16 oz." The defendants, who had closely imitated the plaintiffs' label (which strictly speaking is not a trade-mark), contended that the plaintiffs could not

¹ 12 Abb. Pr. 237; R. Cox, 282.

acquire an exclusive right to the use of said label, because it did not indicate the true origin or ownership of the thread to which it was affixed, — the name of Thomas Nelson & Co. being that of a fictitious firm; and that, as the plaintiffs were thus practising a deception upon the public, by passing off the thread as being manufactured by persons who had no real existence, a court of equity should not interfere to protect them in their fraud.

§ 495. The court, by Hilton, J., said in reply: “The label is manifestly one not intended to delude the public, by making any representations or asserting anything in respect to its qualities or properties which are untrue; therefore, it cannot be said that, in protecting the plaintiffs in its use, we are assisting in the perpetration of a fraud. It is not contended that the thread to which this label is affixed is an article without merit; while, on the contrary, the testimony at the trial fully established the fact that by its excellence it had acquired a valuable celebrity among dealers, and, besides, has become well known as the thread of the plaintiffs. . . . The use of the name was not with any fraudulent intent, but, as is stated by Mr. Dale, it arose from the fact that his Christian name is Thomas Nelson, and it is quite obvious that it was used for purposes of identification, and with about the same object as if, instead, he had adopted some familiar emblem, figure, or picture, by which the thread might be designated, and become generally known in the market. The public is not in fact deceived, as it is shown that no such firm exists as Thomas Nelson & Co. who are known to be manufacturers of thread; and the label does not pretend to hold out that any particular manner of manufacturing the thread is followed by which this pretended firm is enabled to furnish a better quality than any one else. Apart from the use of this fictitious firm name, it is not claimed that the label is false in any other respect; and, under the circumstances shown in this case, I think it would be a gross injustice to deny the plaintiffs protection in the use of a trade-mark¹ to

¹ This term is improperly used here. See definition of “trade-mark,” §§ 89, *et seq.*

which their title has been so clearly established.” This is the doctrine held by the court in *Stewart v. Smithson*,¹ in the New York Common Pleas Court, *in banc*. After issue joined, the defendants moved to amend their answer by adding the following allegations: “And the defendants, on information and belief, state that the mark claimed by the plaintiffs, and set out in the third section of the complaint, viz. ‘Hall & Moody’s patent thread, Barnsley,’ was and is a false and fraudulent mark, used by the plaintiffs to deceive and defraud, and that the thread containing said mark, sold or kept for sale by the plaintiffs, was not and is not patent, and that no patent for said thread has ever existed; nor was said thread manufactured by Hall & Moody, nor by any person or persons their assignees or successors, nor was said thread manufactured at or brought from Barnsley,—all which the plaintiffs well knew.” There was also another proposed amendment, involving the same point. The motion was denied, on the ground that the proposed amendments contained no defence. The defendants appealed. The court, by Brady, J., said: “The mere fact that names used on a trade-mark are fictitious would not authorize the use of it by strangers. The question to be determined in these cases is, whether the mark used by the party claiming the protection of the court is owned by him, without regard to its form, which such party has a right to design according to his judgment or his fancy. If the defendants had alleged that the firm names used on the marks never existed, that would, for the reason stated, furnish no justification for their use of it, and it would not have presented a defence in this action. They have not done so, however, nor have they alleged that firms whose names do appear on the mark did exist, and that the use of their names by the plaintiffs was wholly unauthorized. If they had alleged this, then, in the application of the maxim, *Potior est conditio defendentis*, the courts might relieve them from any disturbance by the plaintiffs.” — In *McNair v. Cleave*,² it appeared that the plaintiffs were engaged in business without an act of incorporation of any kind, under the name or style of “Ga-

¹ 1 Hilt. 119; R. Cox, 175.

² Leg. Int., July 3, 1874.

laxy Publishing Company.” The defendants took the same name. *Held*, that the plaintiffs were guilty of a fraud on the public in adopting a name calculated to mislead, and had no standing in a court of equity.

§ 496. *No Defence that Spurious Article is equal to Genuine.*—It is no defence to a suit for assuming a trade-mark, that the simulated article is equal in quality to the genuine.¹ Upon this point the following distinctions are made. If a druggist prepares a certain kind of medicine, and designates it by the name of a superior medicine, invented, prepared, and sold by the plaintiff, and sells it *as and for* the medicine prepared by the plaintiff, the plaintiff may maintain an action against him, without proof of special damage. But where certain medicines are designated by the name of the inventor, as a *generic* term, descriptive of a kind or class, the inventor is not entitled to the exclusive right of compounding or vending them, unless he has obtained a patent therefor; and if another person prepare such medicines of an inferior quality, and by this means all medicines of this class be brought into disrepute, such inventor can maintain no action for any loss sustained by him in consequence thereof, unless they are sold *as and for* medicines prepared by him.² Moreover, it is no defence that the marks of the spurious goods, or the words of the jobber who sells them to the retailers, inform those who purchase that the article is spurious or an imitation.³ Such knowledge on the part of the immediate purchaser is no defence.⁴

§ 497. *Laches.*—So if a plaintiff lie by for a long time before filing his bill for an injunction, the while being aware

¹ *Coats v. Holbrook*, 2 Sandf. Ch. 586; *Partridge v. Menck*, *Ibid.* 622; *Taylor v. Carpenter*, 11 Paige, 292.

² *Thomson v. Winchester*, 19 Pick. 214; *R. Cox*, 7.

³ *Coats v. Holbrook*, *supra*.

⁴ *Sykes v. Sykes*, 3 Barn. & Cr. 541; 5 D. & R. 292; 3 L. J. K. B. 46. *Taylor v. Carpenter*, 2 Wood. & M. 1; 9 L. T. 514; *R. Cox*, 32. *Taylor v. Carpenter*, 2 Sandf. Ch. 603; 11 Paige, 292; *R. Cox*, 45. *Chappell v. Davidson*, 2 K. & J. 123; 8 De G., M. & G. 1. *Edelsten v. Edelsten*, 1 De G., J. & S. 185; 9 Jur. (n. s.) 479; 7 L. T. (n. s.) 768; 11 W. R. 328; 1 N. R. 300. *Glenny v. Smith*, 2 Drew. & Sm. 476; 11 Jur. (n. s.) 964; 13 L. T. (n. s.) 11; 13 W. R. 1032. *Barnett v. Leuchars*, 13 L. T. (n. s.) 495; 14 W. R. 166.

of the encroachment, that exhibition of laches will be deemed equivalent to a want of good faith. The case of *Beard v. Turner*,¹ before Vice-Chancellor Wood, in 1866, affords such an instance. There, it seems, the plaintiff for two years before filing his bill saw done the identical thing of which he complained. The court said: "But suppose you wish to profit by the act of which you say you have a right to complain, and shall at some future period complain of, then I apprehend this court will say, You must come here at once, for this reason, that you ask in your bill for an account of the profits made by this gentleman upon the sale of these goods. The plaintiff may say, 'It may answer my purpose to let the defendant go on selling four or five years, and then at the end of that time to say he is my salesman, and I come for an account of profits.' I know of no instance in which the court has given relief with reference to a trade-mark except on a prompt application. By not complaining at the time when you might complain, (I do not say that it is your intention: we must judge of the intention by the necessary result,) you are lying by, the man continuing to use your property, with the hope (and such is the prayer in your bill filed two or three years afterward) of obtaining those profits which you stood by allowing him to make under this designation, without apprising him of your intention to make any such use of it. On that ground it falls within the principle enunciated, . . . in which it is stated that it is a fraud to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief. You will assume, when he allows another wrongfully to use that which, in the plaintiff's judgment, would facilitate a rival in trade, that being so, unless you come quickly, you must make a rival in trade your agent, for the purpose of carrying on that business, and for the purpose of getting an account at the end of four years. . . . It appears to me, therefore, that if I had come to a different conclusion, it might have affected the question of costs, although it would not have affected the question of relief. I could not give a person an opportunity of lying by,

¹ 13 L. T. (N. S.) 747.

and then asking for an account of the profits made by an injury committed." — In *Harrison v. Taylor*,¹ in 1865, the Vice-Chancellor refused an account of profits, on the ground of the plaintiff's delay before beginning suit, although the defendant had persevered in the use of the mark after having been cautioned. — In *The Amoskeag Manufacturing Co. v. Garner*,² before Barnard, J., at special term, in 1869, a delay of nine years in applying for an injunction to restrain the violation of a trade-mark, was held good cause for refusing relief. The plaintiff alleged that the defendants wrongfully used a trade-mark belonging to the plaintiff, and used to stamp cotton cloths. The judge said that the plaintiff had by silence consented to, if it did not encourage the defendants in, the use of the mark in question upon their labels, introducing these prints to the trade generally throughout the country. That, under these circumstances, to deprive the defendants of the use of these labels would work to them great and irreparable injury, wrong, and hardship, and at the same time give to the plaintiff a dishonest and unconscientious advantage as the fruits of the plaintiff's own wrong and negligence. The rule is that the plaintiff must not be guilty of any improper delay in applying for relief.³ He said, further, that the design and object of the plaintiff in enjoining the defendants, at that particular time, from using the said labels, was to produce financial embarrassment by destroying their profitable trade, immediately after the payment by the leading member of the defendants' firm, in pursuance of the terms of his father's will, of the sum of \$3,225,000; that to uphold the injunction upon the papers before him would be grossly inequitable and unjust to the defendants, — would enable the plaintiff to profit largely by its own wrong and negligence, and thus turn the court into an engine to oppress and destroy, when its true office is to relieve a party from hardship and oppression, and to protect him in the enjoyment of his rights, when they are

¹ 11 Jur. (N. S.) 408; 12 L. T. (N. S.) 339.

² 55 Barb. 151; 6 Abb. Pr. (N. S.) 265; R. Cox, 541.

³ There can be acquiescence only where there is knowledge. Malins, V. C., in *Weldon v. Dicks*, 10 Ch. D. 247; 39 L. T. (N. S.) 467. So held, also, by Hall, V. C., in *Re Farina*, 27 W. R. 456.

illegally and wrongfully invaded, or threatened with injury. Injunction dissolved, with costs.¹ — Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction.²

§ 498. *What not deemed Laches.* — When a trader believes that he has good ground for complaining of a colorable imitation of the style of his business, he is justified in waiting until he can collect a sufficient number of cases to show that the alleged attempt has succeeded, before he files his bill; inasmuch as it would not be safe for him to come into court until he could establish actual cases of deception.³

¹ This section was cited and approved by the court in *McLean v. Fleming*, 96 U. S. 258.

² *Wallace, J.*, in 1885, in *Estes et al. v. Worthington*, 22 Fed. R. 822.

³ *Cave v. Myers*, Seton, 4th ed. 238; *Lee v. Haley*, 22 L. T. (n. s.) 251; 5 Ch. 155; 39 L. J. Ch. 284; 18 W. R. 242. See *infra*, § 681, "Intention to abandon"; and also § 684 *et seq.*, "Laches."

CHAPTER XI.

DAMAGES.

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- § 517. Account of sales of merchandise.
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§ 499. *When Damages are Recoverable.* — There must be loss legitimately resulting from the unlawful usurpation of a trade-mark, or the plaintiff cannot recover; for if there be no loss, the injury must go unredressed. It is not sufficient that an act unauthorized by law has been committed; because for *injuria sine damno* there is no compensation. Substantial loss to the plaintiff must have ensued by the mal-appropriation of the mark, the right to the exclusive use of which was in the plaintiff, to entitle him to substantial relief. *De minimis non curat lex.*

§ 500. Thus, it would not be sufficient for the plaintiff to prove that the defendant had threatened to adopt his mark, or that he had actually — through an error as to the scope of the copyright law — filed it with the Librarian of Congress; or, through another blunder, had applied for a patent for the

design; — for these acts could not have worked to the legal injury of the plaintiff. There being no property in the mere representation of the symbol constituting a trade-mark, as has been before stated and proved, no legal harm could have resulted from a mere imitation of the symbol.¹ The wrong consists in affixing the mark to merchandise which the public purchase thereby, erroneously supposing that it is the product of the plaintiff. That is the whole basis of a right to damages in such case.²

§ 501. Damages will be presumed, in some cases. Where one intentionally uses another's trade-mark on goods, — i. e. merchandise of substantially the same class as his, — the law presumes the using to have been done for the fraudulent purpose of inducing the public, or those dealing in such goods, to believe that those sold, or offered for sale, are the genuine goods of the owner of the mark. The act is deemed to be an attempt to supplant the latter in the good-will of his trade. In such a case, nominal damages will be given, although no specific injury shall have been proved, or even alleged.³ It is not even necessary to show guilty knowledge or fraudulent intent to warrant damages.⁴

§ 502. *No Fixed and Certain Rule* for damages can be established, applicable to all cases,⁵ — no inflexible or unyielding guide, — but the rule generally recognized as the true one is to give as damages the amount of profits the defendant shall have made by his infringement.⁶ As in trials at law the jury are the proper judges of damages where there is no certain measure of damages, the court ordinarily will not disturb their verdict, unless on grounds of prejudice, passion, or cor-

¹ But see Act of March 8, 1881, sect. 9, as to an entry in the Patent Office, by means of a false or fraudulent representation, orally or in writing, *ante*, §§ 355 *et seq.*

² *Southern v. How*, 2 Poph. 144; *Blanchard v. Hill*, 2 Atk. 484; *Singleton v. Bolton*, 3 Doug. 293; *Blofield v. Payne*, 4 Barn. & Adol. 410.

³ *Taylor v. Carpenter*, 11 Paige, 292, and 2 Sandf. Ch. 603; *Blofield v. Payne*, *supra*; *Rodgers v. Nowill*, 5 Man., Gr. & Sc. 109; *CoEen v. Brunton*, 4 McLean, 516; *Marsh v. Billings*, 7 Cush. 322; *McLean v. Fleming*, 96 U. S. 245.

⁴ *Colman v. Crump*, 70 N. Y. 573.

⁵ *Ransom v. The Mayor*, 1 Fisher, 252.

⁶ *Bell v. Daniels*, *Ibid.* 372; *Derringer v. Plate*, 29 Cal. 292.

ruption in the jury.¹ In all actions on the case, the question is, What is the amount of damages sustained?² and that is within the especial province of the jury to answer, after weighing all the testimony; but, as a general principle, a party is entitled to damages corresponding with the amount of injury suffered, however small.

§ 503. *Compensatory* damages should be given. The criterion is indemnity;³ and in estimating the actual damage, the rule is to give the value of the use of the thing during the illegal user, or, in other words, the amount of profits,⁴ as was said in analogous cases of patented machines. The proper measure of damages, in case of violation of a trade-mark, is generally the profit realized upon the sales of goods to which the spurious marks were attached. The actual damages for the infringement would seem, as a general rule, to be all that could be reasonably claimed. There may be exceptions. Cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement.⁵ Each case must necessarily depend upon its own circumstances. Thus, where in an action on the case for imitating and using the trade-mark of the plaintiffs, on thread made by the defendant, and selling the same as and for the plaintiffs' thread, a verdict was found for the plaintiffs for eight hundred dollars;⁶ and on a motion for a new trial, the court refused to disturb the verdict. Woodbury, J. (who had not tried the case), said that he had little doubt that there was material enough in the case from which to estimate actual damages, such as the probable extent of sales by the defendant under the marks, and the loss of sales and profits thereon to the plaintiffs; and that the jury would, in a case like that, of a known and deliberate intention, often renewed, and very prejudicial to the plaintiffs, not be very nice in their data and

¹ 2 Greenl. on Ev. § 255.

² *West v. Rice*, 9 Met. 564.

³ *Parker v. Helme*, 1 Fisher, 44.

⁴ *Wintermute v. Redington*, Ibid. 239; *Page v. Ferry*, Ibid. 298; *Taylor v. Carpenter*, 2 Wood. & M. 1. *Buck et al. v. Hermance*, 1 Blatch. 398.

⁵ *Nelson, J.*, in *Guyon v. Sewell*, 1 Blatch. 244. See also *Foote v. Silsbee*, Ibid. 445; and *Seymour v. McCormick*, 16 How. 480.

⁶ *Taylor v. Carpenter*, *supra*.

inferences, but be sure to give enough to cover all losses, and ample indemnity, — not “smart money,” or “vindictive damages,” but full atonement for the wrong done. He said, further, that in a case like that, if in any, no reason exists for giving greater damages than have actually been sustained, or what have been called compensatory;¹ and that there was nothing peculiarly atrocious in the conduct of the defendant to be punished by damages, and in no other way, as a public example. It seems that Judge Sprague, who tried the case, in his charge to the jury, used the term “exemplary damages”; but that language was construed by the superior judge to mean a full indemnity for the individual wrong, in every equitable view, that by example might operate the more effectually in a preventive manner against a repetition of such injuries. He further expressed his opinion, that the jury did not give more than was sufficient to make the plaintiffs whole, but rather less than the amount.

§ 504. *How measured.* — Every trespass on property gives a right, at least, to nominal damages.² All damages must be *the result* of the injury complained of, to wit, the simulation of the trade-mark of the plaintiff, those which *necessarily* result, termed general damages, being shown under the *ad damnum*; for the defendant must be presumed to be aware of the necessary consequences of his conduct, and therefore cannot be taken by surprise in the proof of them. Where the damages, though the *natural* consequences of the act complained of, are not the necessary result of it, they are termed *special damages*, and are not implied by the law. Therefore, in order to prevent a surprise upon the defendant, they must be particularly specified in the declaration, or the plaintiff will not be permitted to give evidence of them. But where the special damage is properly alleged, and is the natural consequence of the wrongful act, the jury may infer it from the principal fact.³ — The Court of Nancy, in France, in 1827,⁴ held

¹ Citing *Tracy v. Swartwout*, 10 Pet. 81.

² *Hilliard on Remedies for Torts*, 404.

³ 2 Greenl. on Ev. § 254.

⁴ *Germain v. Sevène, Huard, Marques de Fabrique*, 47.

that damages should be calculated according to the loss of the plaintiff, and not according to the profits that the infringer had been enabled to make. — The Tribunal of Commerce of the Seine, in 1857,¹ held, that the infringers ought to restore to the complainants, whose property they have usurped, all the illegitimate benefits which they have realized by aid of their fraudulent practices; that they also ought to account for the profits of which they have deprived the complainants, and to repair the wrong which they have caused by the depression of the price of the merchandise manufactured, and the rise of the price of the raw material, usual and almost necessary consequences of an unlawful rivalry; they ought also largely to indemnify complainants for all they have suffered in their credit, sacrifices of all kinds to which they have been obliged to submit, and all the expenses which they have been obliged to sustain to protect their rights. On these conditions only can the great industries which honor the country, and which have too often to fight against the culpable manœuvres of infringers, maintain and defend themselves. — In the Supreme Court of California, in 1871,² was considered a case in which the court below had awarded as damages all profits made by the defendant, by the sale of the spuriously marked goods, and the appellate court held that the damages were not excessive. Crockett, J., in delivering the opinion, said: “Every consideration of reason, justice, and sound policy demands that one who fraudulently uses the trade-mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade-mark, on the plea that it is impossible to determine how much of the profit is due to the trade-mark, and how much to the intrinsic value of the commodity.” — The Supreme Court of New York, in general term, in 1875,³ held that there was no error in an assessment of damages by a referee, in which he found that the damages were equal to the profits which the plaintiff

¹ *Tribouillet v. Monnier*, *Ibid.* 48. (See also *Blanc de la Contrefaçon*, 682.)

² *Graham v. Plate*, 40 Cal. 593; 6 Am. R. 689; 4 Am. L. T. 75.

³ *Faber v. Hovey*, *Codd. Dig.* 79, 249. Mr. Cox, in a note to Case 481 of his *Manual*, says that this case was affirmed in the Court of Appeals by a divided court.

would have made from the manufacture and sale of the same number of articles as the defendant had sold under the spurious mark. — In a Circuit Court of the United States, in 1871,¹ Dillon, J., said: “I am satisfied that the plaintiffs’ sales have been lessened at least to the extent of the two hundred dozen bottles; and that their profits would have been on each case of one dozen bottles the sum of four dollars.” The damages were so measured. — In another Circuit Court of the United States, in 1884,² Wallace, J., held that the damages should be measured by the extent to which the unlawful use of the trade-mark had interfered with sales. — Learned, J., in 1872,³ held that damages are not recoverable against a defendant who is ignorant of the plaintiff’s rights and claims. In that case the defendants had used stamps and labels of an old firm to which they succeeded, and supposed that the use was lawful. Yet a perpetual injunction was allowed. — So also, in equity, where a complainant has been guilty of laches in not enforcing his claim for a long time, he will not be entitled to damages, and may even be compelled to pay costs.⁴ And where a defendant is ordered to account, he cannot be charged with bad debts as profits; and, on the other hand, he cannot charge the plaintiff with the cost of manufacturing the goods in respect of which the bad debts were incurred.⁵ There are decisions in cases analogous to those of trade-marks, that lay down a rule on the point. In a Circuit Court of the United States, in 1880,⁶ McKennon, J., held that the measure of damages for the unauthorized sale of a patented article is the difference between the cost price to the patentee, and the market price, where the sales were made.⁷ The same judge, in 1882, in two cases where the patented designs for a carpet

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

² *Atlantic Milling Co. v. Robinson et al.*, 20 Fed. R. 217.

³ *Weed v. Peterson*, 12 Abb. Pr. (N. S.) 178.

⁴ *McLean v. Fleming*, 96 U. S. 245.

⁵ *Edelsten v. Edelsten*, 10 L. T. (N. S.) 780.

⁶ *American Saw Co. v. Emerson*, 8 Fed. R. 806.

⁷ Affirming the master’s report, which cited the controlling principle in *Rubber Co. v. Goodyear*, 9 Wall. 788; *Cawood Patent*, 94 U. S. 695; *Pitts v. Hall*, 2 Blatch. 229; *Cowing v. Rumsey*, 8 Blatch. 86; and *Hostetter v. Vowinkle*, 1 Dill. 329.

had been so closely imitated that they were exact copies,¹ held: "The damages are measured by the profits which would have accrued to the complainant upon the number of yards sold by the defendant. Such number of yards must, under the circumstances, be presumed to have displaced an equal number of yards of the complainant's carpets." In a case on appeal in New York, in 1884,² substantially the same rule was observed. A cosmetic made and sold through the defendant's agency being an infringement of the plaintiffs' rights, it was held: "The price realized from the defendant's sales, less what it would have cost plaintiffs to make and vend the quantity sold by the defendant, was a measure of damages to which defendant cannot object." But where an intention to infringe is clear beyond doubt, courts will not be over tender with a wrong-doer. In two cases in a Circuit Court of the United States, in 1882,³ for infringing designs patented by the complainants, the copying being as exact as possible, McKennon, J., laid down a proper rule: "Under these circumstances, the respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor, founded upon the alleged inconclusiveness of the complainants' proof of loss. On the other hand, such proof ought to be considered and interpreted most liberally in favor of the complainants, within the limits of an approximately accurate ascertainment of their damages."

§ 505. But the damages must be proved from the evidence, not from mere conjecture, independent of the evidence.⁴ A mere *possible* injury furnishes no ground of damages. In an English case,⁵ where a bill in equity had been filed to restrain the infringement of a trade-mark, the court offered a decree for an account of profits; but the plaintiffs elected an inquiry as to damages. It was held that the law would not presume

¹ *Bigelow Carpet Co. v. Dobson, and Hartford Carpet Co. v. Same*, 10 Fed. R. 385.

² *Champlin et al. v. Stodart*, Gen. Term of Supr. Ct., Fifth Depart., 20 N. Y. Weekly Digest, 223.

³ *Bigelow Carpet Co. v. Dobson, and Hartford Carpet Co. v. Same*, *supra*.

⁴ *Carter v. Baker*, 4 Fisher, 404.

⁵ *Leather, etc. v. Hirschfeld*, L. R. 1 Eq. 299; 13 L. T. (n. s.) 427; 14 W. R. 78.

that the plaintiffs would have sold the amount of goods sold by the defendant; but the burden of proof was on the plaintiffs to show special damage by loss of custom, or otherwise. The remarks of the court have an important bearing on the subject of remote or contingent damages: "How can the court assume that the persons who bought what the plaintiffs aver were inferior articles, at an inferior price, would necessarily, if they had not done so, have bought the superior articles at the higher prices?" In a case¹ where there was evidence that persons were, by false statements of the defendants' agent, induced to leave the plaintiffs' coach, and to go in that of the defendants, it was held to be a fraud on the plaintiffs, and a violation of their rights, for which an action would lie, without proof of actual or specific damages; and that the damages should not be confined to the loss of such passengers as the plaintiffs could prove had actually been diverted from their coaches to those of the defendants; but that the jury would be justified in making such inquiries as to the loss of passengers and injury sustained by the plaintiffs as they might think were warranted by the whole evidence in the case. When it was stated in the declaration, and proved on trial, that the defendants had obtained some of the plaintiff's wrappers, and used them to palm off inferior articles — metallic hones for sharpening razors, etc. — as the manufacture of the plaintiff, Denman, C. J., stated to the jury, that, even if the defendants' hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by the fraudulent acts of the defendants. The jury, having found for the plaintiff, with one farthing damages, stating that they thought the defendants' hones were not inferior to the plaintiff's, it was held, *in banc*, that, the act of the defendants being a fraud upon the plaintiff, even if it occasioned him no specific damage, it was still, to a certain extent, an injury to his right. This case makes it clear and conclusive that a plaintiff may recover without proof of special damage.²

¹ *Marsh v. Billings*, 7 Cush. 322; 14 Monthly L. R. (4 n. s.) 664; R. Cox, 118.

² See *Blofield v. Payne*, *supra*. See also *Rodgers v. Nowill*, *supra*.

§ 506. *Election of Remedies.* — He whose rights are infringed has his election of remedies. He may proceed in equity for an accounting of the profits that the defendant has made, an injunction, etc., or he may sue at law for the loss that he has suffered.

§ 507. In the first case, if the defendant has realized no profit, there can be no recovery; but in the second, he may recover the damage he has sustained, whether the defendant has made any profit or not. In a patent case, he may treat the infringer who illegally appropriates an invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. In such case, the plaintiff may recover those profits, be they more or less; and he can recover no more, however great the damages may be which the alleged interferer has occasioned. If, on an accounting, it should appear that the defendant used the invention so unskillfully that he realized no profit, there could be no recovery. On the other hand, the patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not.¹ In trade-mark cases, the rule is much the same; but in the latter, considerations are involved which do not enter into ordinary patent infringements, as, for example, loss of reputation, so that courts allow greater scope in ascertaining damages. In one case,² where it was impossible to apportion the profits of the defendant, he was required to lose the whole.

§ 508. *Intent.* — A wrongful or malicious intent, express or implied, is an essential and prominent element in determining the amount of damages to be awarded. The general rule is, that it is of no consequence whether the defendant actually intended the injury or not. In civil actions, the law does not so much regard the intent of the actor as the loss or damage of the party suffering.³ Yet in actions for the invasion of patent rights, the intent is generally considered,

¹ Woodruff, J., in *Cowing v. Rumsey et al.*, 4 Fisher, 275.

² *Graham v. Plate*, 40 Cal. 593; 6 Am. R. 639; 4 Am. L. T. 75.

³ Johnson, J., in *Auburn, etc. v. Douglass*, 12 Barb. 557.

as in a case where the maker of a machine appears in truth to be ignorant of the existence of the patent, and does not intend any infringement; and though this will not altogether exonerate him, it will tend to mitigate the damages.¹ So it is in trade-mark cases.²

§ 509. *Special Damages.*— The right to recover special damages, i. e. damages additional to the amount of direct and immediate injury, often depends upon the allegations in the writ. Such damages must be specially alleged, solely for the purpose of giving the defendant notice of the plaintiff's demand with regard to them; while, as before said, he is held to take notice of such damage as is the necessary consequence of his act, without any special allegation, and without any statement of the particular circumstance of aggravation. It is rarely in actions for the violations of trade-marks that the right to such damages can fairly be established.

§ 510. *Plaintiff's Negligence.*— In assessing damages, the direct and immediate consequences of the injurious act are to be regarded, and not remote, speculative, and contingent consequences, which the party injured might easily have avoided by his own act. Suppose a man should enter his neighbor's field unlawfully, and leave the gate open; if, before the owner knows it, cattle enter and destroy the crop, the trespasser is responsible. But if the owner see the gate open and pass it frequently, and wilfully or obstinately, or through gross negligence, leave it open all summer, and cattle get in, it is due to his own folly. So, if one throw a stone and break a window, the cost of repairing the window is the ordinary measure of damages. But if the owner suffer the window to remain unrepaired a great length of time after notice of the fact, and his furniture or pictures, or other valuable articles, sustain damage, or the rain beat in and rot the windows, the damage would be too remote.³

¹ Bryce v. Dorr, 3 McLean, 583; Whittemore v. Cutter, 1 Gallison, 429; Jones v. Pearce, Webster's Pat. Cases, 125; Hogg v. Emerson, 11 How. 587-607. See also Lowell v. Lewis, 1 Mason C. C. 182.

² Rose v. Loftus, 47 L. J. Ch. 576; 38 L. T. (N. S.) 409. Weed v. Peterson, 12 Abb. Pr. (N. S.) 178.

³ Shaw, C. J., in Laker v. Damon, 17 Pick. 284.

§ 511. We may apply the doctrine thus laid down by the eminent jurist to the case of one who stands by and calmly sees another pirate his mark. He may sustain many injuries that by prompt action he might have avoided. Legal relief, at best, is but part indemnity. The law in fact aims not so much at satisfaction as at a division of the loss.

§ 512. After a review of the few cases bearing directly upon the question under discussion, — that is, the true principle for the measuring of damages in trade-mark infringements, — we relapse into uncertainty, and despair of finding any nicely adjusted scheme to solve the problem. The infringement of a mark at one time may be destructive of the trade of the true proprietor; and at another time, and under similar circumstances, it may be comparatively harmless. An article of trade may have an ephemeral popularity which is an immediate fortune to its producer, or it may be a thing of limited sale, yet of continuing demand. All the surrounding facts must therefore be weighed by the jury, referee, or master, as the case may be, and although of as little account singly as the dust in the balance, yet in the aggregate they may cause the scale to kick the beam. Look at such a case as *Gillott v. Esterbrook*,¹ and the power of the grouping of seemingly insignificant minutiae, to make a convincing proof of fraudulent intent, will be plainly perceptible.

§ 513. In many classes of cases of injury to property, the estimate of damage can easily be made, either by the value of an article destroyed or wrongfully converted, or by a previous liquidation. Thus, for the infringement of a copyright, the legislature has laid down certain rules to meet all cases; but when we turn to infringements of patent rights, and attempt to reason from analogy, we find great difficulty. In *Conover v. Rapp*,² Ingersoll, J., said that the plaintiff is entitled to such actual damages as he has sustained; and that the actual damages are the profits which the defendant has made. This was a case of infringement of a patent for a machine for splitting wood; and evidence having been given that the defendant used the machine, and also of the amount of wood split

¹ 47 Barb. 455.

² 4 Fisher, 57.

by him during each day, the plaintiff calculated from that what the actual damages were. The court instructed the jury that a plaintiff is not able, with the utmost accuracy, in cases of that kind, to give the exact amount of damages that he has sustained. It is beyond his power. He does the best that he can. If he is wrong in his calculation, the defendant can put him right. The defendant knows the profit that he has made. Therefore, said he, the jury must take the evidence as it is, and come to the best conclusion they can as to what are the actual damages. The jury having found a verdict for the plaintiff, the defendant moved for a new trial before Mr. Justice Nelson. He delivered the opinion, that there was no error in the charge of the judge, and denied the motion. Sawyer J., said, in *Carter v. Baker*,¹ that the profits made by the defendants are proper to be given as a part of the damages; and that the jury might take into consideration other losses caused by the infringement, beyond those profits actually received by the defendants. In a patent case (*Cowing v. Rumsey et al.*²), Woodruff, J., laid down the rule somewhat more specifically, the true rule being what the plaintiff has lost, and not what the defendant has gained. He said: "In such an action, it is precisely what is lost to the plaintiff, and not what the defendant has gained, which is the legal measure of the damages to be awarded. Under this rule it may often be entirely proper to prove the profits of the ordinary use of the invention, and the demand existing in the market, evidenced by sales made, and so, as an element of consideration, show the profits realized by the defendant, in order to furnish to the jury all proper materials for determining how much the plaintiff has lost. But I apprehend that they are to answer the precise question, How much loss has the plaintiff sustained by reason of the defendant's infringement? . . . There may be cases so peculiar that there are no means of proving the plaintiff's loss without proving the defendant's profits, and such proof becomes clearly admissible; but, even then, the recovery is what the jury shall find to be the plaintiff's loss, not because the defendant realized profits, but because, under

¹ 4 Fisher, 404.

² Ibid. 275.

all the circumstances, the jury infer, as a fact, but for the interference, the plaintiff would have realized those profits. It may be said, with some plausibility, that the plaintiff's damages may sometimes be greater than the profits which the defendants have made, but ought never to be considered less; and that the defendants, having illegally infringed, should always be held to the presumption that the plaintiff would have made as much as they have realized, and should not be permitted to retain any of the fruits of their illegal conduct, by showing that the plaintiff could not have manufactured or used the invention so profitably." This reasoning is lucid and satisfactory, so far as applicable to a patent case, but should not be strictly applied to a trade-mark infringement.

§ 514. A patentee is presumed to have employed genius, or talent at least, and to have expended time and money upon his invention; and in consideration thereof he is allowed, for a limited time, a monopoly of the thing invented. No one else in the country which grants the patent has a right to vend or use the article. All profits from its sale or use belong to the patentee or his assigns. The trade in it is absolutely his during the lifetime of the patent. Not so the traffic in merchandise to which a trade-mark may be attached; for a thousand persons may have a perfect right to manufacture and sell the same class of goods, and of the same quality and value, and yet but one person have a right to impress those goods with a certain peculiar symbol. It may be that the infringer has facilities for selling a hundred times as much as he whose mark is imitated. Would the small dealer be entitled to receive as damages a hundred times as much profit as he could possibly have made? Reason forbids it. Courts would regard such a rule in a trade-mark case as extravagant and mischievous.

§ 515. Trade-mark and patent cases, therefore, cannot be controlled by the same inflexible rule of measurement of damages for infringement. We are unembarrassed in a patent case where the patentee has adopted a patent fee as one mode of remuneration, and in the fee has fixed his own measure of the value of the use of the machine for the entire term, or

until that particular machine shall be worn out, and the computation is readily made;¹ for if the patentee has an established price in the market for his patent right, or what is called a patent fee, that sum with the interest constitutes the measure of damages.² In one case, the plaintiff insisted that he was entitled to recover for the infringement the full amount which he would himself have made on the articles sold, had he manufactured and sold them himself, upon his own established terms. He gave evidence showing the price at which he sold, and the profits realized upon sales at those prices; and the court adopted those profits as the measure of damages, and gave him the benefit of the rule, so far as the damages could be ascertained from the testimony.³ But notwithstanding this will not be applicable to all cases of trade-mark infringements, we can understand perfectly well how the analogy may be of assistance. Let us take an example.

§ 516. The plaintiff has the exclusive right to vend by a fanciful designation a certain article, the secret of the manufacture of which he possesses. It is well settled, as matter of law, that he has no exclusive right of property in the compound itself, it not being patented; consequently, if any one by fair means discover the secret of manufacture, he may go into competition with the inventor himself in obtaining the patronage of the public in the sales of the very article.⁴ But we set out with the fact that the plaintiff has the exclusive title in the name of the article, the said name being an arbitrary symbol, and possessing all the essentials of a lawful trade-mark. The public know the article by that name, and would not buy it under any other. If the defendant sell the identical compound, a knowledge of the ingredients of which he may have obtained by chemical analysis, he may do so without hindrance, provided he do not sell it under the name given to it by the plaintiff; but if he do so sell it, he is

¹ *Spaulding v. Page*, 4 Fisher, 641.

² *Sickles v. Borden*, 3 Blatch. 536.

³ *Spaulding v. Tucker*, 4 Fish. 633, as cited by the court in *Spaulding v. Page*, *supra*.

⁴ *Davis v. Kendall*, 2 R. I. 566; *R. Cox*, 112.

guilty of infringement of the mark. The number of articles sold by the defendant being ascertained, we have a means of measuring the damages, by applying the rule in patent cases. The presumption must be that the plaintiff would have made all the sales, had it not been for the alleged conduct of the defendant.¹

§ 517. Courts of equity seem to indicate a rule for measuring damages, by their practice of ordering the defendant to keep an account of sales of merchandise bearing the simulated mark, to the end that they may be paid as indemnity to the complainant. But that an entry in a defendant's book is an exceedingly fallacious guide in actions at law must be manifest, for many circumstances may conspire to cause injury from the improper use of the mark, and many of such circumstances must be taken into consideration in assessing damages. Unfair competition may cause a loss of reputation and good-will, and depreciation of the class of goods sold by the parties. Sawyer, J., in *Carter v. Baker*,² told the jury that they might take into consideration the fact that the plaintiffs may have sold their articles at a higher price than the defendants had received; but yet that only those damages which directly and immediately flow from the wrongful act can be considered, and that remote consequential damages must be discarded.

§ 518. No wrong-doer can be allowed to apportion or qualify his own wrong. As a loss has actually happened while his wrongful act was in operation and force, and which is attributable to his wrongful act, he cannot set up as an answer to the action the bare possibility of a loss, if his wrongful act had not been done.³ The disposition of the courts, in such case, is to make the wrong-doer liable for injurious consequences flowing from the illegal acts, although they be very remote.

§ 519. *Exemplary Damages.*—In the case of *Day v. Woodworth*, in the Supreme Court of the United States,⁴ Mr Jus-

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

² 4 Fisher, 404.

³ Tindal, C. J., *Davis v. Garrett*, 6 Bing. 716 (19 Eng. C. L. R. 212).

⁴ 13 How. 303.

tice Grier, in delivering the opinion of the court, said: "It is a well-established principle of the common law, that in actions of trespass, and all actions on the case for torts, a jury may inflict what are called exemplary, punitive, or vindictive damages upon a defendant, having in view the enormity of his offence, rather than the measure of compensation to the plaintiff. . . . By the common, as well as by statute law, men are often punished for aggravated conduct or lawless acts by means of a civil action, and the damages inflicted by way of penalty or punishment given to the party injured. . . . And the damages assessed in the circumstances, showing the degree of moral turpitude or atrocity of defendant's conduct, may properly be termed exemplary or vindictive, rather than compensatory."

§ 520. Thus, one who shall counterfeit — a term implying deliberation and intent, as contradistinguished from a casual imitation — will be held to a more grave responsibility than another, who unwittingly may have copied a rival's mark. In a Circuit Court of the United States, in 1884, in an action on the case, for counterfeiting trade-marks, Blodgett, J., instructed the jury that damages are the necessary result of the defendant's wrongful act: "the interference with the plaintiff's business, and injury to the public confidence in the genuineness of the article which the plaintiff deals in, by reason of the fact becoming known to the public that the fraudulent and simulated imitation of this medicine had been placed before the public. These are the elements of damage which you are to consider. . . . In cases of this character, where you are satisfied from the proof and from the admissions in the case, that the fraud — the intention to defraud — is at the bottom of the matter. . . . the jury are not confined to the exact monetary damages shown by the evidence, but may give what are known as vindictive or exemplary damages, for the purpose of deterring others from embarking in the same schemes of fraud or deception. . . . You are to take into consideration what has been told you in reference to the fact that his [plaintiff's] sales were diminished; that he has apparently lost something; that he was obliged to notify the public of the fact

that simulations or imitations of his goods are in the market, and notify them how to detect this simulation ; you are to say what, under the circumstances, will compensate the plaintiff, and act as smart money to deter others from embarking in other similar transactions in the future." The actual damage proved amounted to only about a hundred and fifty dollars ; but the verdict was for twenty-six hundred and fifty dollars. Of course costs were added.¹

¹ Warner *v.* Roehr, reported in Chicago newspapers of March 21, 1884.

CHAPTER XII.

RIGHTS ANALOGOUS TO THOSE OF TRADE-MARKS.

- § 521. Several species of incorporeal property therein embraced.
- § 522, 523. Good-will, generally.
- § 524-527. On dissolution of partnership.
- § 528, 529. Name of inn, hotel, or other place of business.
- § 530. Name of companies, etc., in France.
- § 531. False representations on signs of shops.
- § 532. Prohibition against using names of former employers.
- § 533. Unfair competition in usurping names of commerce.
- § 534. French cases as to business signs.
- § 535, 536. Unfair use of names of products.
- § 537, 538. Labels and wrappers.
- § 539, 540. Property in the name of another.
- § 541. Label cases.
- § 542, 543. Improper use of the word "original."
- § 544. Words in common use.
- § 545. Trade secrets.
- § 546. Title of a book or other publication.
- § 547-553. Examples of titles protected.
- § 554-556. Misuse of another's name.
- § 557. Name of a song.
- § 558, 559. Printed publications as trade-marks.
- § 560, 561. Names and designations on coaches, etc.
- § 562-564. Secret process, breach of faith, etc.

§ 521. SEVERAL species of incorporeal rights are protected on principles similar to those on which rests the ownership of a trade-mark. Indeed, many cases embraced within the meaning of the title of this chapter have masqueraded as cases of veritable trade-marks, while essentially widely differing in nature. Such rights may consist in mere trade-names¹ of persons, places, or manufactures; or in mere labels, wrappers, styles of packages, or other means of representing goods. All such matters may, like technical marks, be intimately connected with the good-will of a business, and may be guarded

¹ See *ante*, § 91, "Trade-Name, as contradistinguished from Trade-Mark."

from invasion through the same general equitable principles.¹ Not infrequently, these various matters intermingle, as circumstances of the same case.² It may be necessary to apply strict definitions; and discomfiture and loss may be the result of inattention to them. Yet there are cases where claimants to a right of exclusive user of symbols have utterly failed in that regard, while the prayers for general relief have been so broad that courts of equity have been able to give ample protection against unlawful interference with business.³ The decision of a Circuit Court of the United States, in 1885,⁴ serves as an illustration of this point. Wallace, J., held that a complainant could not maintain a claim to a right of exclusive use of either the word "Disque" or "Pile-Leclanche" as a trade-mark applied to the batteries of which one or the other was the proper descriptive designation, and cited authorities for the decision that it could not be exclusively appropriated as a trade-mark therefor, even by the inventor himself.⁵ He also cited authorities to show that a man's name alone is not a trade-mark, when it merely designates the kind or description of the thing being sold.⁶ On that ground, the claimant failed; but the prayer of the bill was broad enough for the court to continue as follows: "The defendants have imitated the label of the complainant to the minutest details, except the signature at the bottom. The complainant is entitled to protection against the unlawful competition in trade thus engendered by the simulation of its label; and upon that ground, a decree is ordered in its favor." By the method of classification hereinafter followed, many cases are considered under one general head.

§ 522. *Good-will.* — In 1856, Romilly, M. R., said: "There is considerable difficulty in defining accurately what is included

¹ See *ante*, § 34, "Principles on which Infringement is prohibited."

² See *ante*, § 418, "Blending of Trade-Mark and other Rights."

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

⁴ *Leclanche Battery Co. v. Western Electric Co.*, 23 Fed. R. 276.

⁵ *Hostetter v. Fries*, 17 Fed. R. 620; *Singer Manuf. Co. v. Stanage*, 6 Id. 279. See also *ante*, § 220, "The Necessary Name of a Product," § 220 *a*, and § 221.

⁶ *Singer Manuf. Co. v. Loog*, 15 Reporter, 538; *Wheeler & Wilson Manuf. Co. v. Shakespear*, 39 L. J. Ch. 36; *Young v. Macrae*, 9 Jur. (N. S.) 322; *Canal Co. v. Clark*, 13 Wall. 311. See also *ante*, §§ 178 *et seq.*

under this term good-will. It seems to be that species of connection in trade which induces customers to deal with a particular firm";¹ "or," as Lord Eldon, C., said, in 1810,² "the probability that the old custom will resort to the old place"; or, as Lord Langdale said, in 1842, "It is the chance or probability that custom will be had at a certain place of business, in consequence of the way in which that business has been previously carried on."³ — Judge Story says, quite comprehensively, that it may be described to be the advantage or benefit which is acquired by an establishment, beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position, or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices. Thus, a nursery of trees and shrubs, a favorite fashionable stand, or a newspaper establishment, may and often does enjoy a reputation and command a price beyond the intrinsic value of the property invested therein, from the custom which it has obtained and secured for a long time; and this is commonly called the good-will of an establishment.⁴ — Tindal, C. J., said, in 1837: "The good-will of a trade is a subject of value and price. It may be sold, bequeathed, or become assets in the hands of the personal representative of the trader."⁵ — Pollock, C. B., said, in 1854: "Very frequently the good-will of a business or profession, without any interest in land connected with it, is made the subject of sale, though there is nothing tangible in it; it is merely the advantage of the recommendation of the vendor to his connections, and his agreeing to abstain from all competition with the vendee. Still, it is a valuable thing

¹ *Wedderburn v. Wedderburn*, 22 Beav. 84; 25 L. J. Ch. 710; 2 Jur. (n. s.) 674; 28 L. T. 4.

² *Cruttwell v. Lye*, 17 Ves. 335; 1 Rose, 123.

³ *England v. Downs*, 6 Beav. 269; 12 L. J. Ch. 85; 6 Jur. 1075.

⁴ *Partnership*, § 99.

⁵ 6 Ad. & E. 438-454; 1 N. & P. 796-814; 2 H. & W. 464-471; 6 L. J. Ex. (n. s.) 266-269.

belonging to himself, and which he may sell to another for a pecuniary consideration";¹ and, as Wood, V. C., said, in 1859, "When you are parting with the good-will of a business, you mean to part with all that good disposition which customers entertain toward the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it."² — Said Romilly, M. R., in 1860: "The good-will is a valuable and tangible thing in many cases, but it is never a tangible thing unless it is connected with the business itself, from which it cannot be separated, and I never knew a case in which it has been so treated";³ and at a later date he said, "There may be a particular species of value attached to a particular spot where a business has for a long time been carried on, and which may be an asset of the partnership of very high value."⁴ — "The sale of a business is a sale of the good-will. It is not necessary that the word 'good-will' should be mentioned."⁵ — But it is not every kind of good-will that may be sold; for, as was held, in 1841, the good-will of a bankrupt's trade, so far as it is personal, remains with the bankrupt, although so far as it is local it passes to the assignees in bankruptcy, and owing to peculiar circumstances such assignees may not acquire any interest in the good-will.⁶ The reason of this exception may be readily understood, when it is considered that the whole value of a good-will may be inseparable from personal professional skill, as for example that of a surgeon, such being very different in nature from a commercial matter.⁷ — Lord Chelmsford, C., in 1857, said: "It is very difficult to give any intelligent meaning to the term 'good-will' as applied to the professional

¹ *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147; 23 L. J. Ex. 345; 18 Jur. 778; 23 L. T. 269; 2 W. R. 561.

² *Churton v. Douglas, Johnson*, 174; 28 L. J. Ch. 841; 5 Jur. (n. s.) 887; 33 L. T. 57; 7 W. R. 365.

³ *Robertson v. Quiddington*, 28 Beav. 529.

⁴ *Parsons v. Hayward*, 31 Beav. 109; 31 L. J. Ch. 666; 8 Jur. (n. s.) 474; 6 L. T. (n. s.) 523; 10 W. R. 531.

⁵ *Shipwright v. Clements*, 19 W. R. 599, Malins, V. C.

⁶ *Ex parte Thomas*, Court of Review in Bankruptcy, 2 Mont., D. & DeG. 204; 10 L. J. Bankruptcy, 75; 5 Jur. 967.

⁷ *Farr v. Pearce*, 3 Madd. 74.

practice of a solicitor in this abstract sense. Where a trade is established in a particular place, the 'good-will' of that trade means nothing more than the sum of money which any person would be willing to give, for the chance of being able to keep the trade connected with the place where it has been carried on. . . . But the term 'good-will' seems wholly inapplicable to the business of a solicitor, which has no local existence, but is entirely personal, depending upon the trust and confidence which persons may repose in his integrity and ability to conduct their legal affairs."¹ Said the Lord Ordinary, in the Court of Session of Scotland, in 1878: "There is truly no such thing as good-will in the case of a business carried on by a professional man, such as a physician, surgeon, or law-agent, whose success depends entirely upon his own personal skill. It is quite different in the case of a trade or manufacture, where the employer may have the possession of patents or trade secrets, or may by long exercise of his trade or manufacture in some particular locality have drawn together skilled artisans, and attracted the custom of a district to his establishment. In such a case, it is not the individual skill of the employer, but the reputation which his establishment has acquired, which creates that incorporeal, but frequently valuable, estate known as the 'good-will' of a trade. But there is no such thing in the case of a professional man. His business dies with him, and the man who comes after him in the district must depend for success upon his own exertions. It is quite true that such businesses are occasionally sold; but what is thus sold in the case of a living professional man retiring from business, is truly the personal recommendation which the seller gives to his former clients or patients in favor of his successor, coupled with the predecessor's retirement from business. But when the physician or law-agent is dead, nothing of the kind can take place." The Lord Justice Clerk concurred, and spoke of the distinction between a trade, where the individual skill of a trader has often less to do with the success of the undertaking than other circumstances connected with it, and a profession,

¹ *Austen v. Boys*, 2 De G. & J. 626; 27 L. J. Ch. 714; 4 Jur. (n. s.) 719; 31 L. T. 276; 6 W. R. 729.

which is only carried on with success by means of the brain and other personal qualifications of the person conducting it. Lord Ormidale said that he thought that it would be impossible to hold that a medical man's practice could be transmitted so as to be an asset of his estate. This was the decision of the court, although one of the judges dissented.¹— Yet the Court of Appeals of Maryland, in 1870, held that the goodwill of the practice of a physician could be assigned for a certain district.²

§ 523. The extent to which a good-will is protected is illustrated in *Crutwell v. Lye*,³ as is also its nature. In that case, the good-will consisted in certain premises in Bath and in Bristol, which were sold by the assignees in bankruptcy of one of the defendants, Edward Lye, who had for some years, together with his father, George Lye, carried on the business of a carrier from Bristol through Bath to London; the same parties having also a carrying business from Bristol through Salisbury and Warminster to London. At the sale, the whole of the premises of the Messrs. Lye, and their business as carriers from Bristol through Bath to London, and the good-will of that business, were sold in one lot to the plaintiffs; the carrying business from Bristol through Warminster and Salisbury being put up for sale separately, and eventually bought by friends of E. Lye, the defendant, who then set him up in that business. The question was, whether the defendant, according to the facts stated, was really carrying on his own trade, and not that of the plaintiff. A person having sold a house and stock in trade is, in the absence of any special covenant, at liberty to set up a similar business the very next door to his former shop or warehouse.⁴ That is merely a fair case of competition in trade; but he must not, under color of chalking out a different course of trading, really carry on, for his own benefit, the trade of others.⁵ Lord Eldon considered

¹ *Bain v. Munro*, 5 Ct. of Sess. Cas., 4th series, 416; 15 Scot L. Rep. 260.

² *Warfield v. Booth*, 33 Md. 63.

³ In 1810, Lord Eldon, C., 17 Ves. 335; 1 Rose, 123.

⁴ See also *Bond v. Milbourn*, 20 W. R. 197; *Kennedy v. Lee*, 3 Mer. 441.

⁵ See also *Harrison v. Gardner*, 2 Madd. 198. *Hudson v. Osborne*, 39 L. J. Ch. 79; 21 L. T. (n. s.) 386. *Witt v. Corcoran*, 2 Ch. D. 69; 45 L. J. Ch. 603;

that the facts in that case were not sufficient to prove a fraudulent design on the part of the defendant. He said that they amount to no more than that the defendant asserts a right to set up this trade (the carrying business), *and has set it up as the like, but not the same trade with that sold*, taking only those means that he had a right to take to improve it.

§ 524. *Partnership dissolved.* — Upon a dissolution of partnership frequently comes the question, What shall be done with the good-will? As was said by Wigram, V. C., in 1842, “The whole or substantial part of a trade may consist in good-will, leading to renewals of contracts with old connections. In such a case, it is the identical source of profit which operates both before and after dissolution.”¹ This term good-will has no meaning except in connection with a continuing business, and it may generally be said to be practically worthless except to the former partner desiring to continue the business.² In a case before Romilly, M. R., in 1865, it appeared that the complainant’s husband and the defendant entered into a partnership for fifteen years, under the name of “Banks & Co.” At the end of ten years B. died, and the complainant replaced him in the partnership for four years longer, when the partnership was dissolved, and the assets were divided, but no arrangement was come to with respect to the firm name. The complainant continued in the same town and in the same business, although not on the old premises, and the defendant continued the business on the old premises, each under the old name of “Banks & Co.” The court refused an injunction to restrain the defendant from using the name, saying that the name or style of the old firm was an asset of the partnership, and if the whole concern and the good-will of a business had been sold, that name, as a trade-mark, would have been sold with it. If, by arrangement, one partner take the whole concern, there must be a valuation of the whole,

34 L. T. (N. S.) 550; 24 W. R. 501. *Labouchere v. Dawson*, L. R. 13 Eq. 322; 41 L. J. Ch. 427; 25 L. T. (N. S.) 894; 20 W. R. 809. *Graveley v. Winchester*, Seton, 4th ed. 257. *Burrows v. Foster*, 1 N. R. 156; 32 Beav. 18; Seton, *supra*. *Williams v. Williams*, 2 Swanst. 253; 1 Wils. 473.

¹ *Willett v. Blanford*, 1 Hare, 253; 11 L. J. Ch. 182; 6 Jur. 274.

² *Robertson v. Quiddington*, 28 Beav. 529.

including the name or style of the firm. But if the partners merely divide the other partnership assets, then each is at liberty to use the name, just as they did before.¹ The same judge had held in 1859, that partnership assets, including the title of a publication, must be sold for the benefit of the partners, if it were of any value.² The court said, in *Churton v. Douglas*: "The name of a firm is a very important part of the good-will of the business carried on by the firm. . . . The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from that firm; and it becomes the known firm to which applications are made, just as when a man enters a shop in a particular locality."³ By the authority of that case, the purchaser of the good-will acquires the right, not only to represent himself as the successor of those who formerly carried on the concern, but also to prevent other persons from doing the like.⁴ When a firm is dissolved, and there is no agreement to the contrary, the good-will must be sold for the benefit of the partners, if any of them insist on such sale;⁵ and a court may order it to be sold or disposed of in such a manner as may be deemed most advantageous to the partners, and may permit a partner to retain it upon payment of the value thereof.⁶ This is the modern doctrine, and the ruling of Lord Loughborough, C., in 1800,⁷ that upon a partnership without articles the good-will survives, and that it is not an asset of partnership, is not followed; nor did Lord Eldon, C., in 1808, concur in his opinion.⁸ In a case before Grant, M. R., in 1810, where there

¹ *Banks v. Gibson*, 34 Beav. 566; 34 L. J. Ch. 591; 11 Jur. (N. S.) 680; 13 W. R. 1012; 6 N. R. 373.

² *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54.

³ *Wood, V. C., Johnson*, 174; 28 L. J. Ch. 841; 5 Jur. (N. S.) 887; 33 L. T. 57; 7 W. R. 365.

⁴ See *Lindley on Partnership*, 861.

⁵ *Bradbury v. Dickens*, *supra*; *Fenn v. Bolles*, 7 Abb. Pr. 202; *Smith v. Everett*, 27 Beav. 446; 29 L. J. Ch. 236; 5 Jur. (N. S.) 1332; 34 L. T. 58; 7 W. R. 605; also *Bininger v. Clark*, 10 Abb. Pr. (N. S.) 264.

⁶ *Shepherd v. Boggs*, 2 N. W. Reporter, (N. S.) 370; 9 Neb. 258.

⁷ *Hammond v. Douglas*, 5 Ves. 539.

⁸ *Crawshay v. Collins*, 15 Ves. 218.

were no articles prescribing the terms, it was held that some of the partners could not insist on taking the share of another partner at a valuation, nor retain the benefit of a clandestine renewal to them of the lease of the partnership premises, since that would be to give them the whole benefit of the good-will, but that such renewed lease must be included in the valuation of the partnership property.¹ But it was held, in 1855, that when articles of partnership provided that the surviving or continuing partner should have the option of taking over the share of the deceased or retiring partner in the partnership "property, credits, and effects," and it having been agreed that the partnership should be dissolved, and that the continuing partner should take over the partnership "stock in trade and effects" at a valuation, the good-will was not to be taken into account and valued as being included in the partnership "property, credits, and effects," or "stock in trade and effects";² but in 1878, under articles which provided for the valuation of the partnership "property and effects" on the dissolution, there being no negative stipulation in the articles, it was held by Hall, V. C., that the good-will must be taken into account and valued, as being included in the "property and effects";³ and Jessel, M. R., in a similar case, at the same time held that good-will was included in the "effects and things."⁴ It must be understood that when one partner sells to another a going business, every advantage arising from the fact of the sole ownership of the premises, stock, and establishment, including advantages acquired by the old firm in carrying on its business, whether connected with the old place or the old name, passes to the purchaser; but the vendor will not be prevented from carrying on a similar business, when, where, and with whom he pleases.⁵

§ 525. In *Peterson v. Humphrey*,⁶ it was held that an injunction will lie, at the suit of one against his former copartner,

¹ *Featherstonhaugh v. Fenwick*, 17 Ves. 298.

² *Hall v. Hall*, 20 Beav. 139.

³ *Reynolds v. Bullock*, 47 L. J. Ch. 778; 39 L. T. (N. S.) 443; 26 W. R. 678.

⁴ *Rolt v. Bulmer*, W. N. 1878, p. 119.

⁵ *The McGowan Bros. Pump Machine Co. v. McGowan*, 2 Cincinnati, 313.

⁶ 4 Abb. Pr. 394; R. Cox, 212.

restraining the continuance of the use of the signs containing the old firm name, without sufficient alterations or additions to give distinct notice of a change in the firm. The parties were in business on Broadway, in the city of New York, and failed. Some arrangements were made with their creditors, by which they were enabled to enter into a new business, which each did on his own account, — Humphrey at the former store in Broadway, and Peterson on Canal Street. Before the failure, there was a broad sign above the second story of the store on Broadway, in the name of the firm, “Peterson & Humphrey,” and another over the entrance door. Peterson requested Humphrey to remove those signs, and receiving a refusal, obtained an injunction to prevent the use of them. Before that, the sign on the door had above it the name of the old firm, and the word “formerly,” so as to read “Humphrey & Co., formerly Peterson & Humphrey.” The court said that this last sign was true, and nobody could be deceived by the last words; but the sign above the door might mislead, and the injunction against it should be sustained. — In *Howe v. Searing*,¹ the plaintiff, a baker by trade, sought to restrain the defendant from designating the bakery establishment kept by him at No. 432 Broadway, in the city of New York, as “Howe’s Bakery,” and from otherwise using the name of “Howe” in the business, so as to induce the public to believe that the business carried on at 432 Broadway was conducted by the plaintiff. Upon the trial at special term, it was proved that, eight years before, the plaintiff carried on a large and lucrative business at 432 Broadway, and during all the time he carried on the business the premises had been known as “Howe’s Bakery,” and had gained great celebrity by that name. Howe then sold out his lease of the premises, and all the stock, wagons, and fixtures used by him in the business, together with the “good-will” of the concern. After the sale of the business stand and good-will, Howe, by agreement with his vendee, obtained the privilege of resuming the business at another stand, covenanting not in any manner to interfere with the business carried on at the former stand, known as

¹ 10 Abb. Pr. 264; 19 How. Pr. 14; 6 Bos. 854; R. Cox, 244.

“Howe’s Bakery.” *Held*, that this was no recognition of the vendee’s claim to use the name “Howe.” On appeal from the judgment in the plaintiff’s favor, the decision was affirmed by a majority of the court. Hoffman, J., said that the case was decided upon all the authorities found bearing upon it. The court recognized the principle, as one of public policy, that business must be transacted under the name of the real parties doing it, and not under other names. — This decision fully accords with the law of France in relation to commercial partnerships. By the 21st article of the Code of Commerce, the names of associates only can constitute the firm name (*la raison sociale*). This is intended to prohibit persons who succeed to the business of a deceased merchant from continuing it under his name. “Credit,” said Hoffman, J., in commenting upon that article, “is altogether personal. It does not transmit itself by cession or inheritance. It is won by actions and capacity. It is not right, then, that a successor should avail himself of a fallacious credit in appropriating a firm’s name extinguished by the death of one of those who gave it the value.”¹

§ 526. It has been a question whether the right to use the firm name is a part of the good-will belonging to the partnership, or whether, in case of the dissolution thereof by the death of the partner, it belongs to the survivors. That the right to use the name of a known and celebrated firm in the case of manufactures is often a very valuable possession, is unquestionable; and, therefore, courts of equity will often interpose to protect the right against the abuse of third persons, in using it for their own advantage.² But it has been thought that this right does not fall within the true character and nature of good-will; but that it belongs to the surviving partner. The case of *Lewis v. Langdon*³ illustrates the theory of property in a partnership name, as a species of good-will attached, not to the place of business, but to the name of a

¹ See the case of *Compère v. Bajou et al.*, *ante*, §§ 209-211.

² Story on Partnership, § 100; 2 Story on Eq. Jur., § 951; Eden on Inj., ch. 14; *Motley v. Downman*, 3 Myl. & Cr. 1, 14, 15; *Millington v. Fox*, *Ibid.* 338; *Knott v. Morgan*, 2 Keen, 213, 219; *Webster v. Webster*, 3 Swanst. 490 n.

³ 7 Sim. 421; 4 L. J. Ch. (N. s.) 258.

firm or of a trader. In this case, Vice-Chancellor Shadwell held that a surviving partner had, on the death of his copartner, a right to carry on the business under the designation of the original firm; for that the good-will arising from the use of a particular designation was, during the partnership, the joint property of the firm, and became on the death of one of the partners the sole property of the survivor. He, however, while granting the injunction, directed the plaintiff to bring his action at law. But this opinion does not seem to have been generally acquiesced in. Hoffman, J., in rendering the decision of the court in *Howe v. Searing*,¹ intimates that it is a well-settled rule that the good-will of a partnership business does not survive to a continuing partner; and that it belongs to the firm as much as the ordinary stock in trade. He said that the case of *Lewis v. Langdon*, which seems to assert a different rule, is not the law of the court on this point. He referred to the decision in *Hammond v. Douglas*,² which explicitly asserts a different doctrine, speaking of the good-will generally; and decides that a sale of it cannot be compelled by the representatives of the deceased partner; and that it is not partnership stock of which the executor may compel a division, but belongs of right to the survivor. But in the case of *Dougherty v. Van Nostrand*,³ before him as assistant Vice-Chancellor, he had thought that case could not be supported; and the opinion in the last-mentioned case had been acted on and approved in other cases.⁴ Perhaps, says Lloyd,⁵ *Churton v. Douglas*⁶ approaches more nearly than any other of the numerous cases on good-will to the case of a trade-mark. There, the defendant had, in 1857, received a considerable sum from the plaintiff, upon a dissolution of partnership, for the purchase of "all his known rights and interests in the partnership business and the good-will thereof." The plaintiffs carried on the old business under the name of their new firm, "late John Douglas & Co." Four months afterwards, the defendant again set up his old business, in partnership

¹ See *ante*, § 525.

² 1 Hoffm. Ch. R. 68.

³ Trade Marks, 35.

⁴ 5 Ves. 539.

⁵ *Williams v. Wilson*, 4 Sandf. Ch. R. 379.

⁶ *Johnson*, 174; 7 W. R. 365.

with other persons, under the firm of "John Douglas & Co." The whole question, as in *Crutwell v. Lye*, before referred to, was whether, upon all the circumstances, this was an attempt to set up, not a business similar to the old one, but the identical business; and the court, coming to the conclusion that such was the defendant's intention, granted an injunction, although the defendant's name was John, and the style was genuine.

§ 527. In the Tribunal of Commerce of Paris, in 1857, (*Bautain v. Mercklein*,¹) it appeared that Bautain and wife had sold to Mercklein and wife their establishment as opticians. Among other conditions, it had been stipulated that the defendants, as successors, might avail themselves of the name of Bautain, as found convenient; but the Bautains reserved the right to continue to carry on another place of business which they had established in a different street from that of their former place. The defendants used as a commercial designation the formula, *Maison Bautain, Bautain Opticien*, without the addition of the words *Mercklein, successeur*, whereupon the plaintiffs brought suit for damages for violation of contract in making a false representation. It was held, in the first instance, that the defendants had obtained the right to use the name of Bautain on their signs, cards, etc., and the case was dismissed, plaintiffs to pay the costs. The plaintiffs appealed. The judgment below was reversed, on the ground that it was only in the quality of successors in business that the respondents had the right to use the name of Bautain; but as no appreciable injury had resulted to the appellants, no damages were allowed. To suppress the evil for the future, the court forbade the respondents Mercklein to inscribe the name of Bautain on their invoices, addresses, and signs, otherwise than as successors of the said Bautain and wife, that quality to be expressly mentioned in conjunction with the name of Mercklein. The respondents were adjudged to pay the costs of the trial and the appeal. — In the Tribunal of Commerce of Marseilles, in 1861, (*Laurens v. Laurens*,²) it appeared that the plaintiff, Gustave Laurens, had, ever since

¹ 8 *Annales*, 207.

² 8 *Id.* 221.

1836, carried on the pharmacy founded by his uncle, Joseph Laurens, in 1814, with this sign: "Pharmacie Laurens." The plaintiff signed his name as "G. Laurens," and so was generally known. His cousin, the defendant, Paul Gustave Laurens, established a pharmacy in the vicinity of that of the plaintiff, and had for his sign "G. Laurens." The court ordered that the defendant should qualify his designation, suppressing the name of "Gustave." In the Court of Bordeaux, in 1865, (*Caminade & Co. v. Caminade*,¹) it was held that, although in case of similarity in the names of two merchants, in the same line of business, the later comer is not obliged to suppress the name of his firm on his marks and labels, nevertheless he can be adjudged as an evidence of good faith to add his distinctive designation. The defendant had announced in circulars that he had founded at Cognac a mercantile house, under the name of Ad. Caminade, for the purchase and sale of Cognac brandies. It was shown by him that, in his correspondence with his agents, he had notified them not to confound his house, just commenced, and the ancient house of Caminade, with which he had no connection of either kinship or interest. Good faith was shown. The court held that every person has a perfect right to use his patronymic, in commerce as in anything else, subject, however, to the condition of being distinguished as much as possible from any other in the same trade. It was ordered, that the defendant's full name appear, thus: Adrien Caminade. This was affirmed on appeal, the defendant spontaneously agreeing to add to his labels, etc. the words "Maison fondée en 1864," so as to prevent any possible confusion. — So, also, in the Tribunal of Commerce of the Seine, in 1857, (case of *Pinaud & Amour v. Pineau*,²) where the names, although differently spelled, were *idem sonans*. It appeared that the plaintiffs had carried on a hat-store, founded twenty-five years before at No. 87 Rue Richelieu, in Paris, by Juste Pinaud; and that the defendant quitted another street formerly occupied by him, and established a hat-store at No. 91 Rue Richelieu. It was charged that he did this to profit

¹ 13 Annales, 268.

² 4 Id. 86.

by the similitude of name to draw away the custom of the plaintiffs. The defendant contended that he had a perfect right to remove into the street mentioned, and that the difference in the spelling of the two names was quite sufficient to avoid confusion ; and, as a subsidiary precaution, he offered to prefix his baptismal name of René. *Per curiam* : “ Whereas Pinaud & Amour are proprietors of a hat establishment in Paris, in Rue Richelieu, 87, and known for twenty-five years under the name of ‘ Maison Pinaud ’ ; and whereas Pineau, a hatter previously of the Rue Fossés-Montmartre, has recently established himself at No. 91 of the aforesaid street, and, with the intention of profiting by the similarity of names, he has placed over his store ‘ Maison Pineau ’ ; and whereas he employs for the lining of his hats an escutcheon which is a servile imitation of that adopted by Pinaud & Amour, all which has been done to divert to himself the custom of the old house of Pinaud ; now, although he has an incontestable right to establish himself under his true name, and to place that name upon his place of business, yet he must be interdicted from unlawful competition ; and measures must be taken to prevent confusion in the mind of the public between the two houses. *Ordered*, that the defendant suppress the word *Maison*, which in the usages of commerce indicate an establishment of ancient date and reputation ; also, that he change the escutcheons chosen by him and placed on the lining of his hats ; and, finally, that the name of Pineau shall be preceded by the prenomén René, and that these two names shall be placed over both fronts of his store, and on his invoices and letters of commerce, on the same line, and in the same characters.” This judgment was to be inserted in two newspapers selected by the plaintiffs, the defendant to pay costs of advertisement and suit. The defendant accepted the condemnation, but he executed it in a tardy manner, and in a way indicative of bad faith. He placed his name, René Pineau, on his principal sign ; but on the glass of his entrance door he left the sole name of Pineau. Besides that, his shop having two fronts, the one on the Rue Richelieu and the other on the Rue Saint-Marc, he had placed his surname on

one street, and his baptismal name on the other, so that passengers on the Rue Richelieu, who were more numerous than those on the Rue Saint-Marc, would see but the name of Pineau. He was again brought into court. For his reprehensible subterfuge in attempting to continue his unfair competition to the damage of the plaintiffs, he was condemned to pay them 2,000 francs, and the costs. — In the same court, in 1858, (case of *Bonnet et al. v. Henry Delisle*,¹) it appeared that the sign of “Maison Delisle” belonged for a long time to a house of commerce, to which name the founders and their successors, the plaintiffs, attached a very great importance. The defendant, whose place of business was *not* in the same street with that of the plaintiffs, used the same designation of “Maison Delisle,” without anything to distinguish his establishment from that of the plaintiffs. *Ordered*, that for the future the defendant cease to designate his place of business under the simple denomination of “Maison Delisle”; and that he pay the costs. — And in the same court, in 1857, (case of *Chevet v. Lemasson*,²) it was held that when members of the same family, or merchants bearing the same name, have created rival establishments, the proprietor of the most ancient has the right to preserve the qualification of *Maison*, or *Ancienne Maison*, and, in case of possible confusion, the junior should be compelled to add his quality of successor on his signs and prospectuses. — In the Court of Paris, in 1858, (case of *Ternaux v. Bournhonet*,³) it was held that the successor, however far removed, of a house of commerce, has a right to put on his bills and signs the name under which his house was founded.

§ 528. Courts of equity will protect a party in the use of a name of an inn, hotel, or other place of business, where the sign or the name is simulated so as to deceive, or is calculated to deceive customers. The adjudged cases proceed solely on the ground of a valuable interest acquired in the good-will of the trade or business. At the foundation of the principle is the suggestion of falsehood. If a man creates a reputation for his business, it is as the keeper of some particular house at a

¹ 4 *Annales*, 301.

² *Ibid.* 330.

³ *Ibid.* 331.

known location, and it is piracy to draw off the custom of his friends or customers who have identified him with the name of his house. It is a personal right. By giving a particular name to a building, as a sign of the hotel business, a tenant does not thereby make the name a fixture to the building, and the property of the landlord upon the expiration of the lease, as was decided by the Supreme Court of California, in *Woodward v. Lazar*.¹ One may consent to the employment of his name to designate a place of refreshment; but if such consent be purely gratuitous, or unless there is some valid agreement binding upon the party who gives his consent, he may withdraw it at pleasure, and its further use will be enjoined, as in *McCardel v. Peck*.² And a court of equity will protect by injunction the name of an enterprise undertaken for the amusement of the public, as in *Christy v. Murphy*.³ Even although one's place be designated by two names indiscriminately, a colorable imitation of the title will be enjoined.⁴ — The name "What Cheer," as a sign for a restaurant, was held to be infringed by that of another afterwards established near by, reading, "New and Original What Cheer Restaurant";⁵ as was the sign "Carriage Bazaar," by the change of a rival's sign from "Carriage Repository" to "New Carriage Bazaar."⁶ But the sign "IXL General Merchandise Auction Store" was held not to be infringed by the sign "Great IXL Auction Co.";⁷ nor that of "Station Hotel" by one of "The Royal Station Hotel";⁸ and no exclusive right can exist in a name alleged to be infringed by a sign of "Civil Service Boot Supply."⁹

§ 529. In France this protection is frequently granted. In the Tribunal of Commerce of the Seine, in 1857, (case of *Dorvault v. Hureau*,¹⁰) the plaintiffs had for about twenty-five

¹ 21 Cal. 448. So also in France: *Boudet v. Berdin et al.*, 24 Annales, 67.

² 28 How. Pr. 120.

³ 12 How. Pr. 77.

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

⁵ *Gamble v. Stevenson*, 10 Mo. App. 581.

⁶ *Boulnois v. Peake*, W. N. 1868, 95; 13 Ch. D. 513 n.

⁷ *Lichstein v. Mellis*, 8 Oreg. 464; 34 Am. 592.

⁸ *Charleston v. Campbell*, 4 Sess. Cas., 4th series, 149; 14 Scot. L. Rep. 104.

⁹ *Civil Service Supply Association v. Dean*, 13 Ch. D. 512.

¹⁰ 4 Annales, 125.

years used as a sign, and upon their labels, circulars, and prospectuses, the words "Pharmacie Centrale de France." The defendants had as their sign the words "Pharmacie Rationelle," but added thereto the words "Centrale de France." This fact was recognized by the court as an attempt to create confusion between the two establishments, and the defendants were prohibited from the further use of the latter-mentioned words; as was also done in a case between the same plaintiff and *Teissier & Co.*,¹ the year following. — In the same court, in 1858, came up the case of *Schorthose v. Hogg*,² two Englishmen, cousins-german and pharmacists, and former fellow-students in the office of one Robert. The plaintiff, as successor in business of Mr. Robert, claimed the designation of "London Dispensary," under which his pharmacy was known, and also the title of "Pharmacie de l'Ambassade d'Angleterre." The defendant pretended to have certain rights in Robert's pharmacy, and accordingly used similar names and titles at his store in another street from that in which the plaintiff's was situated. The defendant disclaimed all right to the said name and title; but subsequently he took the designations of "London Dispensary," and of "English Embassy Chemist." This was held to be an infringement, and defendant was forbidden further to use those titles to designate his place of business, and condemned to pay 500 francs damages, and the costs. — In the same court, in 1859, (case of *Lemercier v. Millin*,³) it was shown that Claude Bully had given his name to an aromatic toilet-vinegar, of which he had transmitted the recipe to Jean Vincent Bully. The plaintiffs had purchased from the latter his business and the sign of the inventor. The defendant made and sold a toilet-vinegar under the name of "Bully," with the sign "Au Temple de Flore." Judgment for plaintiffs. — In the Court of Paris, in 1862, (case of *Muller v. Compagnie Immobilière*,⁴) it appeared that the plaintiff had for more than fifteen years carried on a hotel known as the "Hôtel de la Paix," situate at the angle of the Rue de la Paix and the Boulevard des Capucines. The defendants built a hotel on the same boulevard, and gave it the same name as the plaintiff's. The

¹ 4 *Annales*, 298.

² *Ibid.* 255.

³ 5 *Id.* 360.

⁴ 8 *Id.* 265.

court below — the Tribunal of Commerce of the Seine — had declined completely to suppress the name thus assumed by the defendants, but accepted their offer to adjoin the word “Grand,” and ordered that their sign be altered within the period of two months, so that — in letters all of the same size — it should read “Grand Hôtel de la Paix.” On appeal, it was held that the words “Hôtel de la Paix” were indicative and characteristic of the hotel owned by Muller, and that those words could not be employed by others in the same business without violating his rights. A few weeks later, the same parties were again before the court. Muller complained that, notwithstanding the judgment in his favor, the defendants continued to announce in the newspapers their hotel under the interdicted name; and that the napkins and towels for table and toilet, the bills of fare, etc., of the new hotel were thus marked; and the letters “H. P.” — an abridgment of the sign — were engraved upon the glass-ware, the bottles, and the plate. The defendants answered that the initials “H. P.,” and even the words “Hôtel de la Paix” on the linen, all used in the interior of the establishment, could not prejudice the plaintiff, especially the use of the letters “H. P.,” which had no precise sense. They also alleged that the interior arrangements had all been ordered and executed long before the first suit, and argued that the order of the court would not admit of such stringent interpretation as to prevent even the temporary use of the articles mentioned. *Held*, that the letters “H. P.” on the porcelain, glass, vessels, silver, cutlery, and divers utensils placed at the disposition of guests for a purely internal purpose, did not in contemplation of law prejudice the plaintiff. But, although the defendants acted without a fraudulent intent, the use of the words “Hôtel de la Paix” was a damage to the plaintiff. They were accordingly forbidden to let those words appear on objects either on the exterior or in the interior of their new hotel. But in consideration of all the circumstances, and the hardship that would result from instant suppression, the court granted a delay of six months for the removal of the words “de la Paix” from the linen and furnishing-articles, and allowed the plaintiff his costs.

§ 530. There are other French cases that convey instruction on this point of conflicting signs. In the Tribunal of Commerce of the Seine, in 1880, came up a case of two fire-insurance companies, — *La Fraternelle Parisienne v. La Parisienne*.¹ “La Parisienne,” founded in 1837, was united in 1858 with “La Fraternelle,” and the two united companies took the title of “Fraternelle Parisienne.” In 1880, “Le Globe,” a company insuring against hail-storms, changed its name and took the denomination of “La Parisienne.” The use of the same was enjoined, although the risks were different in character. The French sometimes carry their sentiments of good-will protection pretty far, as in a case in the same court, in 1881, *La Nationale v. La Société Nationale*.² The plaintiff was a life and fire insurance company, and the defendant a military insurance company against accidents. They both carried on business in the city of Paris, but their respective establishments were not near each other, and the natures of their transactions were not similar. The demand was that the sign bearing the defendant’s name should be taken down, as likely to cause confusion. It was so adjudged.³ — Variations in names do not always shield the borrower, if the courts can reasonably infer a liability to mislead. In the same court, in 1882, — *Banque du Commerce et de l’Industrie v. Banque Centrale du Commerce et de l’Industrie*,⁴ — it was held that the simple addition of a word was not sufficient to avoid confusion. — In the same court, in the same year, — *Banque Populaire v. Banque Populaire d’Escompte*,⁵ — the same rule was applied. — In the same court, in 1884,⁶ the plaintiff’s sign being “Entrepôt d’Ivry,” the defendant in the same business took for the same purpose “Chantier du Grande Ivry.” The court said that a merchant is not permitted so to designate his establishment, even with a qualification of his residence. To avoid confusion in the mind of the public, the defendant

¹ 29 Annales, 232.

² 24 Id. 190.

³ The late M. Pataille, who was certainly eminent authority in such matters, as an editor dissented from the view taken by the court. 24 Annales, 191.

⁴ 29 Annales, 231.

⁵ Ibid. 234.

⁶ Names of parties not given in the report. 1 Bulletin Officiel, 222.

was ordered to change the sign, the court saying that he could not lawfully make use in his business of invoices of the same color and dimension, nor even of postal cards bearing the same disposition of matter as those of his rival. Indeed, the Imperial Court of Paris, in 1853, — *Lebat v. Partongue*,¹ — held that the color of a sign and its general aspect are considered as sufficiently distinctive to be respected.

§ 531. *False Representations on Signs, etc. of Shops.* — These matters, if calculated to induce the public to believe that the owner is connected in business with a firm of established reputation, will be considered upon the same principles as govern rights in trade-marks. In *Glenny v. Smith*² it appeared that the defendant had been employed by the plaintiffs for three years in their shop, up to April, 1865, and that in May of that year he set up in a like business for himself. The defendant's name, Frank P. Smith, was posted immediately over his shop window, in black letters upon a white ground, while upon the sun-blind and brass plate under the window were the words "From Thresher & Glenny," the word "from" being printed diagonally to the rest, and in smaller letters. On the part of the plaintiffs, the sun-blind and brass plate were produced in court, and photographs of the shop front, from which it appeared that, when the sun-blind was drawn down, the defendant's name was not visible, except to persons passing immediately under the window. They also proved four cases in which persons had actually been misled; and to show that the defendant had some misgivings as to the propriety of his conduct, a conversation between him and one of the plaintiff's assistants was given in evidence. The evidence of the defendant consisted of opinions of persons who had inspected his shop, to the effect that the public were not likely to be misled, and of his directions that nothing should be said to purchasers to induce them to think that Messrs. Thresher & Glenny were connected with his business. An injunction was granted. The same rule was

¹ Blanc, 709.

² 11 Jur. (N. S.) 964; 2 Drew. & Sm. 476; 13 L. T. (N. S.) 11; 18 W. R. 1032; 6 N. R. 363.

applied in England in later cases.¹ In *Boswell v. Mathie*,² in Scotland, in 1884, it appeared that the defender, who had set up in the same business as her former employer, had placed her own name on the blinds of her shop, adding the words "from Boswell." She pulled up the blinds so as to exhibit no part of the inscription except the name "Boswell." On labels, bill-heads, etc., she styled herself "late manager to Boswell." She was interdicted on the ground that her actions were misleading as to the blinds, and untrue as to the labels, etc.

§ 532. In the Tribunal of Commerce of the Seine, in 1857,³ the defendants, who had been employed by M. & P. at No. 3 Boulevard des Capucines, established themselves at No. 11 on the same street. On a sign, they announced themselves as "ex-artists of the house of M. & P., when they had the honor to paint the photographic portraits of their Majesties, the Emperor and the Empress," etc. After suit brought, they abandoned the words "ex-artists of the house of M. & P.," but retained the remainder. They contended that, as they had performed the work, they had a right to say so, as their artistic talent was their own, and they could assert authorship of the portraits, which they had painted in the work-shop of their old employers. Held, that they had no right to use the name of their old employers; and that no artist or employee of a business house could claim a right to preserve his individuality in work so done. The Court of Paris, in 1863,⁴ decided that an apprentice or workman has no right to announce himself as a pupil of his former employer, on establishing a business for himself, except with the consent of his employer. In the same year, the Tribunal of Commerce of the Seine⁵ held, that a purchaser of a business may maintain an action to restrain the former pupils and employees from naming themselves as such on signs or manufactures, even though after the sale the

¹ *Scott v. Scott*, 16 L. T. (n. s.) 143; *Cave v. Myers*, Seton, 4th ed. 238; *Hookham v. Pottage*, L. R. 8 Ch. 93 n.; 26 L. T. (n. s.) 755; 20 W. R. 720; L. R. 8 Ch. 91; 27 L. T. (n. s.) 595; 21 W. R. 47.

² 11 Sess. Cas., 4th series, 1072.

³ *Mayer et al. v. Herlick et al.*, 3 Annales, 63.

⁴ *Rommetin v. Crotte*, 9 Annales, 173.

⁵ *Dubois v. Demoiselles Louise and Lucille*, 10 Id. 187.

former manufacturer authorized them so to do. The same court, in 1864, reasserted that principle.¹

§ 533. Unfair competition in business is sometimes evidenced by usurping a name by which the commerce of a rival is known. If the "Lackawanna" case² could have been maintained, it would have been on the ground of unfair competition, for the name was not actually affixed to the coal. In a case in Scotland, in 1879,³ the following state of facts appeared. Coal from the Lochgelly collieries had for many years been known as "Lochgelly Coal," and was the only coal so known in the market; although there was a seam known as the "Lochgelly Splint Seam," which was not confined to the Lochgelly collieries, but extended under other regions. An interdict was granted against the use of the name "Lochgelly" to designate coal wrought by the respondents, except from their part of the Lochgelly Splint Seam, and then only under the designation of "Lumphinnans Splint Coal, Lochgelly Seam." In principle, this is like the "Akron" case.⁴ — In another Scotch case, in 1883,⁵ the pursuer, Dannachie, had registered the name of his locality, "Glenboig," as his trade-mark for bricks. The respondents, who were located more than two miles from Glenboig, stamped their bricks "Young's Glenboig." They were interdicted. — In the same country, in 1884,⁶ there was another case of the same class as the "Lackawanna." The pursuer and his predecessors, for more than ninety years, at Dalmore, manufactured stones and hones for sharpening edge-tools, and for polishing, under the so-called fancy name of "Water of Ayr Stone." This stone, under that designation, became famous all over the world. It had been registered as a trade-mark. The defenders sold, in the same markets, a similar product, by the same name. They pleaded that their place, like the pursuer's estate of

¹ *Fould v. Honegger*, 10 *Annales*, 323.

² *Delaware & Hudson Canal Co. v. Clark*, 13 *Wall.* 311.

³ *Lochgelly Iron & Coal Co. v. Lumphinnans Iron Co.*, 6 *Sess. Cas.*, 4th series, 482.

⁴ *Ante*, § 182.

⁵ *Dannachie v. Young & Sons*, 10 *Sess. Cas.*, 4th series, 874.

⁶ *Montgomerie v. Donald & Co.*, 11 *Id.* 506.

Dalmore, is bounded by the river Ayr, and only separated from Dalmore by the glebe land of the parish church. The so-called fancy name was held to be merely generic. — In a case in Ireland, in 1879,¹ it was shown, that at Belfast there are numerous springs of pure water, commonly known as “Cromac Springs,” much used in the manufacture of aerated waters. The plaintiffs, who had one of these springs on their premises, had adopted and registered the name “Cromac” as a trade-mark. Whether any right to a trade-mark therein existed or not, the defendant was enjoined against the use in his business of these words: “Please observe the address, The Erin Mineral Water Company, Cromac Springs, Belfast.” The name “Cromac Springs” in the print was in larger type than the rest of the sentence, and therefore likely to deceive. — But it is not always that courts can remedy complaints on this score. In the United States Circuit Court for the Northern District of Illinois, in 1885,² the court was asked to prevent a corporation from unjustly being formed under the name of the complainants, a foreign corporation. Gresham, J., said: “The object of the defendants in causing an Illinois corporation to be created, bearing the same name as the complainant company, is obvious. They hope by this means to secure the benefit of part, at least, of the patronage which the complainant has acquired. Unwilling to engage in open, manly competition with the complainant and others carrying on the same business, the defendants resort to a trick or scheme, whereby they hope to deceive the public, and obtain an unfair advantage of the complainant. Such conduct might be fairly characterized more harshly; and it is with extreme reluctance that I deny the complainant the relief prayed for.” Whether relief could be granted after the creation of the corporation, in fraud of the rights of the complainant, was not determined. Another case of the same kind met the same fate.³ — The following sharply defined ruling, in 1879, was perhaps owing to the technical prayer of the bill. A manu-

¹ *Wheeler et al. v. Johnston*, 3 L. R. (Ireland) Ch. D. 284.

² *Lehigh Valley Coal Co. v. Hamblen*, 28 Fed. R. 225.

³ *Pennsylvania Coal Co. v. Douglas et al.*, *Ibid.* 226.

facturer of stoves and ranges not patented placed upon each of these stoves and ranges a name and a number, and also placed upon such of the separate parts, respectively, as were liable to be worn out rapidly, the initial letter and the number of the stove or range to which it belonged. Every one of these parts was well known, had acquired a high reputation, and was sold under the name of the letters and numbers placed on it. The defendant procured some of these parts, made patterns from them, and cast from the patterns parts of the stoves and ranges, inferior in quality to those of the plaintiff, but having their peculiarities of ornamentation, lettering, and numbering; and advertised these parts for sale as manufactured by himself, describing the parts by the name used by the plaintiff to designate them. At first, the case looks like one in which relief should be granted on the ground of unfair competition. But the Supreme Court of Massachusetts, in 1879, held otherwise; and in refusing an injunction, reasoned thus: "It appears that the numbers were used by the plaintiff and the defendant as they were used by manufacturers generally, to indicate a size or measurement: they form no part of the trade-mark. The letters, in some instances a single letter, in other instances two letters, are in no case the trade-mark which the plaintiff described in the bill, and cannot be regarded as likely, when considered by themselves, to mislead a purchaser into supposing that they were the trade-marks described in the bill."¹ This was therefore decided on fact.

§ 534. In the Tribunal of Commerce of the Seine, in 1867, (*Mondin & Co. v. Sari et al.*,²) it appeared that the plaintiffs had adopted, as a sign to indicate the nature of their business, the words "Agence des Théâtres." It was held that another, in the same line of business, who had adopted as his sign the words "Office des Théâtres," did not infringe upon any right, the words being generic and common. It was no answer, that the words might lead to confusion.—As an example of the judicial suppression of a fancy name upon a shop sign, we

¹ Magee Furnace Co. v. Le Baron, 127 Mass. 115.

² 14 Annales, 352.

have *Chaize v. Fromentelle*,¹ in the Tribunal of Commerce of the Seine, in 1865. The parties were tobacconists, carrying on business in the same neighborhood. The plaintiff's sign read, "La Civette" (civet-cat). He had previously been compelled in defence of his rights to attack a certain Dame Pousse, who had erected a sign reading, "À la Civette de la Rue de Rivoli," and had discomfited her by a judgment of suppression, with 200 francs damages and costs. This time it was the Dame Fromentelle who thought to avail herself of the reputation of the plaintiff's wares by putting up a sign, reading, "A la Nouvelle Civette." As it was plain that her motive was to profit by the justly gained popularity of the establishment of Chaize, a judgment was rendered similar to that in the other case. — In *Regnard v. Perrier*,² in the Court of Paris, in 1879, the same sign seems to have been infringed. The defendant, a retailer of tobacco and liquors in the Avenue de l'Opera, (Bureau No. 226,) took for a sign "À la Civette." The plaintiff, proprietor of the tobacco bureau situated in front of the Théâtre Français and of the Palais Royal, summoned him before the Tribunal of Commerce of the Seine, for the purpose of having the obnoxious sign suppressed, and to obtain damages for the trespass on his rights. The plaintiff prevailed, and the sign was ordered to be removed within a week's time, with damages and costs. On appeal, the decision was affirmed.

§ 535. It is unfair competition to indicate an industrial product under a name very similar to that of another's product, in such manner as to create confusion. In a case³ in the Tribunal Civil of Lyons, in 1865, it appeared that the plaintiff was the patentee of an invention to which he had given the name of "Conformateur du Tailleur." From the name, we may infer that the invention was embodied in an instrument for the shaping of garments to the person. Under this denomination, the machine was indicated in the sign, and in the prospectuses of the plaintiff. The defendant, also a patentee, with the evident intention of causing confusion be-

¹ 11 Annales, 350.

² 26 Id. 110.

³ Berthelon v. Vergé, 11 Id. 349.

tween his machine and that of the plaintiff, placed upon his sign the words "Conformateur pour Hommes et Dames," in characters corresponding with those upon his rival's sign. *Per Tribunal*: This act on the part of Vergé does not constitute a counterfeiting or a usurpation of the trade-mark of the plaintiff, but it is an unlawful competition, and therefore the word "Conformateur" upon the business sign of the defendant must be suppressed, as also upon his circulars and prospectuses. — In the Tribunal Civil of the Seine, in 1875,¹ it appeared that the defendants were proprietors of a ready-made-clothing house in Paris, called "Maison du Pont-Neuf." They placed on sale a certain over-garment called the "Montagnac," for nineteen francs. Among numerous catch-words inserted by them in the Figaro, of Paris, they announced that the bureaux of the Mont-de-Piété were filled by an avalanche of "Pardessus Montagnac," intimating that the garments were pawned for twenty-five francs each, and that measures had been taken to stop the continuation of the traffic. MM. de Montagnac, manufacturers of cloth at Sedan, thought that the use of their surname, honorably known in the fabrication of cloth, prejudiced them, in causing the belief that the common cloth worked up by the defendants issued from their manufactory; and demanded that the name of Montagnac be removed from the hand-bills, and from catch-words employed by the defendants. It was so adjudged, with damages, etc. — In the same court, in 1877, this case came up.² The plaintiff was proprietor of a house of the name "La Maison de l'Aluminium." He engraved the name on the inside cases of watches for sale, and also on all other articles of his manufacture, by way of a trade-mark. The defendant, a watch-maker, sold watches of aluminium quite like those of the plaintiff, and bearing on the inside case the same name. It was held that the words "La Maison de l'Aluminium," being the name of a house of commerce, did not constitute a trade-mark, but merely a sign, even though they were affixed to the goods; but that it was a clear case of unfair competition. — In the Court of Douai, on

¹ *Montagnac v. Halphen & Co.*, 20 *Annales*, 95.

² *Testevuide v. Girault*, 23 *Id.* 45.

appeal, in 1876, there was a cause¹ of the same nature as the "Akron" case.² For more than twenty years, the plaintiff was a manufacturer of cement at Boulogne-sur-Mer, and his product was all the time known as "Ciments Portland de Boulogne-sur-Mer." In 1875, the defendant set up works at Desvres, eighteen kilometres from the plaintiff's place of manufacture. In his labels, prospectuses, and letter-heads, he used the denomination "Ciments de Boulogne-sur-Mer," the geographical name being printed in bold lettering, while the words "Usines de Desvres" were in minute letters. The qualification as to the place of the works, did not save him from a judgment of unfair competition, in both courts. — So also in the Tribunal of Commerce of Nantes, in 1880,³ in a case in which the defendant sought to deceive the public into believing that sardines, put up by them at another place, were those put up at Nantes, where the plaintiff had his business. The boxes were similar to those of the plaintiff. The words "Fabriquées comme à Nantes" were intentionally printed in such small letters as to be almost imperceptible. — In the Tribunal of Commerce of the Seine, in 1881,⁴ it appeared that the plaintiff at Menat manufactured a tripoli, from a product taken from ores (*minières*) of the locality, which he sold under the name of "Minière de Menat." The defendant sold his product under the name of "Tripoli Roses des Minières de Menat," although he did not manufacture the same from material taken from Menat. He was forbidden to use the name, or one like it, under a penalty of 1,000 francs for each infringement; and the plaintiff was awarded 1,000 francs damages and costs. — But to entitle one to claim protection in the use of the name of a place, he must there have his principal place of business. In the Court of Cassation of France, in 1884, on final appeal,⁵ it appeared that the plaintiffs below had their principal place of business at Jarnac, fourteen kilometres from Cognac, and at the latter had merely a cheap, rented place;

¹ Lonquétý v. Fanchon & Co., 21 *Annales*, 317.

² *Ante*, § 182.

³ Pellier *et al.* v. Trottier frères *et al.*, 27 *Annales*, 357.

⁴ Voivet v. Scoppine, 28 *Id.* 47.

⁵ Louis Foucaud & Co. v. Lucien Foucauld & Co., 30 *Id.* 18.

while the defendant was truly located there. Although the plaintiffs had incorporated the name "Cognac" into their signs, labels, etc. as long before as 1862, the continuous use did not serve them.

§ 536. The reflecting reader must perceive that many matters, cited and commented on in foregoing chapters, might properly have been embraced in this chapter; and they would have been so, but for the reason that courts discussed them as trade-marks. It is undeniable that the line of demarcation between technical symbols of merchandise and quasi marks, or mere business indications, is not always clearly distinguishable.¹ But, as is said by an English writer, "All such cases, whether of trade-mark or trade-name, or other unfair use of another's reputation, are concerned with an injurious attack upon the good-will of a rival business; customers are directed from one trader to another, and orders intended for one find their way to the other."²

§ 537. *Labels and Wrappers.*— We will now consider another class of cases, which seem to form a connecting link between those where the good-will of a trade has been protected, and those which may be characterized as relating to trade-marks proper. This is where the advantage in the market (or good-will) is due either to the name of the trader or trading-firm, or to his or their place of business, or to both these causes combined, but not being as a good-will allowed to rest merely *in nubibus*, is embodied in a label or wrapper, and affixed to the article sold. This name becomes then a quasi trade-mark,³ and the good-will of a business embodied in labels and wrappers will be protected on principles applicable to trade-mark infringements.⁴ Even advertisements containing verses used by another in his trade have been suppressed.⁵

§ 538. *Croft v. Day*⁶ is a very important case under this head. The quasi trade-mark there consisted in the name of

¹ See *ante*, § 52 and notes; also *Linde v. Bensel*, 22 Hun, 60.

² *Sebastian's Law of Trade Marks*, p. 12.

³ *Lloyd on Trade Marks*, p. 36.

⁴ *Peitz v. Eichele*, 62 Mo. 171.

⁵ *Sedon v. Senate*, cited 2 V. & B. 220.

⁶ 7 Beav. 84.

Day & Martin, and their address, 97 High Holborn, with other devices on a printed label attached to the bottles of blacking made by the plaintiffs, the executors of the former firm of Day & Martin, and then carrying on the same business. This was so closely imitated by the defendant, as to afford the fair presumption that he intended the public to be deceived into buying his blacking as and for that of the original firm. The Master of the Rolls, in his decree, observed that the act complained of was equivalent to a sale by the defendant of his goods as those of the plaintiffs, and that two things were requisite for the accomplishment of this fraud. First, a general resemblance of the forms, words, symbols, and accompaniments, such as to mislead the public; secondly, a sufficient distinctive individuality was to be preserved, so as to procure for the person himself the benefit of that deception which the general resemblance was calculated to produce. — In *Coffeen v. Brunton*,¹ the defendant, in combination with others, fraudulently issued and sold a preparation called “Ohio Liniment,” having upon the bottles containing it labels with directions exactly similar to that used by the complainant for his “Chinese Liniment”; and he made representations to induce the public to believe that the composition sold by him contained the same ingredients as the “Chinese Liniment.” McLean, J., said that the alteration, being only colorable, showed that the defendant intended to avail himself of the favorable reputation acquired by the “Chinese Liniment.” An injunction was granted to enjoin him from using labels, or directions, or advertisements, or hand-bills, tending to produce a false impression in the public mind that the liniment sold by him contained the same ingredients as the “Chinese Liniment.” (It should be noted that this case is frequently referred to as one of trade-marks, but improperly so. The word “Chinese” was the only symbol capable of exclusive appropriation, and that was not pirated.) — *The Merrimack Manuf. Co. v. Garner*² case belongs to the label class. In that, the plaintiff’s label was, “Merrimack Prints, Fast Colors, * Lowell, Mass.”; and that of the defendant, “English Free Trade, Merrimack Style,

¹ 4 McLean, 516.

² 2 Abb. Pr. 318; 4 E. D. Smith, 387.

warranted Fast Colors." The court, *in banc*, dissolved an injunction which had been granted at special term, and left the parties to try the issue of an actual imitation involving the question of fraudulent intent and actual injury. — So also does the case of *Dale v. Smithson*¹ belong to the label class. The plaintiff affixed to each package of thread sold by him a label, reading as follows: "Courtria Flax. Thomas Nelson & Co. Warranted. Fast Colors & 16 Oz." What word or symbol is here to constitute an exclusive emblem? "Courtria" might possibly, if it were a fancy denomination, and not descriptive. The defendants adopted and used in a similar manner upon their thread a label so closely imitating that of the plaintiff as to leave not the slightest doubt of the intention of fraud. The judgment at special term granting an injunction was, therefore, affirmed at general term. — *Newman v. Alvord*² is no better than a label case. Both parties used the word "Akron," the name of the place where the plaintiff had a manufactory and the defendants had not. The name "Akron," being a mere geographical designation, could not be exclusively appropriated, for the reason that all inhabitants of the place had a perfect right to affix it to their goods. But as there was no room for doubt, in the mind of the court, that the said name was used by the defendants to enable them to avail themselves of the patronage justly belonging to others, an injunction granted at special term was sustained. — *Falkinburg v. Lucy*³ is a label case, although frequently miscalled a trade-mark case. Sawyer, C. J., said: "Can there be any doubt that the verbatim copy of the entire label of plaintiff, except the heading, the name of the maker, and place of manufacture, and adopting it as the label of the defendants, was done for the purpose of inducing the public to believe that the defendants' was precisely the same thing as, and possessed the identical properties of, the compound manufactured and sold by the plaintiff, and for the purpose of availing themselves of the reputation established by the plaintiff?" It was sought to protect an elaborate label under a statute of the State of California.⁴

¹ 12 Abb. Pr. 237.

³ 35 Cal. 52.

² 49 Barb. 588.

⁴ See *ante*, § 452, note 2.

Comprehensive as is the language of that statute, and palpable as was the imitation of the plaintiff's label, the Supreme Court of California held that the label contained no peculiar names, marks, etc., in the sense of the statute, which the defendants had copied; nor was the plaintiff entitled to any protection of the words in common use in our language which composed the profusely worded label. The injunction granted below was accordingly dissolved. Probably the fault lay in the narrowness of the prayer. — The case of *Boardman v. The Meriden Britannia Co.*,¹ in the Supreme Court of Connecticut, in 1868, is a fair illustration of the protection which courts award to a mere label, which has been fraudulently imitated for the purpose of diverting custom from its legitimate channel. The labels used by the respondents were of the same size and color as the labels of the petitioners, and the same numerals were used for the same class of goods. The petitioners' label read thus: "1-2 Gross L. Boardman's No. 2340 Wire Strengthened, French Tipped Teaspoons"; and that of the respondents read: "1-2 Gross Meriden Brita. Co.'s No. 2340 Wire Strength'd, French Tipped, Oval Thread Teaspoons." Both parties seem to have regarded the use of the numerals "2340" as giving rise to the most important and most material question in the cause; but Carpenter, J., in delivering the opinion of the court, said that that was a question not necessarily involved in the case. It is apparent, at a glance, that neither of the labels contained a single essential element of a technical trade-mark, although the court loosely used that convenient term. From the finding of facts, we can judge for ourselves of the class to which the case belongs. It was found that the respondents manufactured "spoons similar in character to those made by the petitioners, though differing somewhat in style and pattern, and prepared labels resembling those of the petitioners, and adopted the same numbers as had been adopted by the petitioners, adapting said numbers to similar kinds of spoons." We can classify the case as one of unfair competition in trade by means of a simulated label. A remedy was due. The court said: "Have the petitioners suffered dam-

¹ §5 Conn. 402.

age? On this point, there is no room for doubt. . . . Their motive is apparent. They may succeed in reaping some advantage from the numbers [2340] as thus used, but it is manifest that it will be at the expense of the petitioners." All the judges concurred in giving judgment for the petitioners.

§ 539. As to the right of property in the name of another, we have a case in the Court of Besançon, in 1861, — *Lorimier & Bovet v. Dubois*.¹ The house of Bovet, of Fleurier, a village of the Canton of Neuchâtel, in Switzerland, manufacturers of watches for exportation, especially to England and China, authorized M. Lorimier, a watchmaker at Besançon, in France, to use the name of "Bovet" as a trade-mark. Lorimier duly deposited the said name as his trade-mark. By authority of his right to use the same, he seized certain watches, then at the custom-house, *in transitu* for China. The Tribunal of Pontarlier rejected the demand for condemnation. Lorimier appealed. The appellate court said: "For more than thirty years Lorimier has manufactured watches for the Bovet firm; from the beginning of his relation with that firm, he has been authorized to engrave upon the watches made by him the name of 'Bovet'; and for more than thirty years he has constantly sold in China watches bearing the mark of 'Bovet,' the same being in Chinese characters. Said mark, considering the relation of the two houses, is as much the property of Lorimier as it is of the Bovet house. The defendant has usurped, by his products of an inferior quality, the confidence and the credit attaching to the merchandise of the plaintiffs. If tolerated, there would be no security for commerce. Two owners may use the same mark when their interests are united. The right to the use of the mark of 'Bovet' in the Chinese is in both plaintiffs." Injunction. Damages, 1,000 francs and costs. — Although this is a matter somewhat in the nature of a trade-mark proper, it should be classed with mere labels, and treated as such. Being the simple name of a manufacturer, it of course could not be treated in any part of the commercial world as the peculiar arbitrary symbol that commerce requires. It serves our

¹ 8 Annales, 297.

purpose as an illustration of the fact that a man may have a qualified right to the use of another's name as a mere sign or trade-name.¹

§ 540. *Colton v. Thomas*² is to the same effect as the foregoing. The complaint charged an improper and fraudulent use of a name or designation of business, placed by the defendant upon cards and in advertisements, and also upon a sign hung out upon the street in front of his dental rooms. The bill alleged that the plaintiff had purchased from Dr. Gardiner Q. Colton the right to use the name of the "Colton Dental Association," in connection with the use of nitrous-oxide gas to alleviate pain in extracting teeth; and that he used the same in all his advertisements, and prominently displayed it on his signs, doors, and windows; that the defendant, who had been in his employment, left him, and opened dental rooms in the same street, and issued cards in form following: "Dr. F. R. Thomas, formerly operator at the Colton Dental Rooms. Teeth extracted without pain by nitrous-oxide gas";—and that he had a sign over his door of the same purport. It was alleged that the words "formerly operator at the," on the cards and sign, were in small letters, illegible except to one near by, while the words "Colton Dental Rooms" were in large, bold type and letters, so as to be seen at a great distance. The plaintiff's right to use the name was not denied; nor did the defendant set up any corresponding right in himself. From the opinion of Allison, P. J., we learn that the signs which hung over the doors of the plaintiff's rooms, No. 737 Walnut Street, and over the defendant's, at No. 1027 of the same street, were in size, shape, and general appearance very like to each other. The material portions of the lettering required a careful inspection for one to notice any difference between them. They hung in the same manner, on the same side of the street, and might readily be mistaken the one for the other, especially by sufferers, impatient for relief. The

¹ *Oakes v. Tonsmierre*, 4 Woods, 547; *Skinner v. Oakes*, 10 Mo. App. 45; *Filkins v. Blackman*, 13 Blatch. 440; *Fulton v. Sellers*, 4 Brewst. 42; *Booth v. Jarrett*, 52 How. Pr. 169.

² 2 Brewst. 308.

same might, to some extent, be said of the cards. An injunction was granted.

§ 541. *The Dixon Crucible Co. v. Guggenheim*¹ is purely a label case, and it need hardly be referred to in this place further than to invite attention to the fact that the protection claimed was embraced in a statute of the State of Pennsylvania, for the protection of private stamps, wrappers, or labels.² The defendant was enjoined against the use of the name "Dixon," to which he had no right or title. It was not pretended that this was a case of a common-law trade-mark. — In *Blofield v. Payne*,³ a law case, the declaration stated that the defendants wrongfully, and without the consent of the plaintiff, caused a quantity of metallic hones to be made and wrapped in envelopes resembling those of the plaintiff, and containing the same words, thereby denoting that they were of his manufacture. On trial before Denman, C. J., it appeared that the defendants had obtained some of the plaintiff's wrappers, and used them as alleged. It was held by the court *in banc*, that, as the defendants had used the plaintiff's envelope, and pretended it was their own, the plaintiff was entitled to recover damages. — In *Holloway v. Holloway*,⁴ the defendant sold pills and ointment with labels and wrappers copied from those of the plaintiff. The Master of the Rolls pronounced the act to be as clear and as plainly avowed a fraud as he ever knew, and granted protection accordingly. — In *Edelsten v. Vick*,⁵ the defendant used labels in palpable imitation of the plaintiff's, and was restrained.

§ 542. The original producer, and persons claiming under him, are exclusively entitled to designate the same as "the original." This principle has been recognized in a number of cases. Thus a defendant was restrained from selling his sauce under the name of "The Original Lazenby's Harvey's Sauce."⁶ — A sauce was invented many years ago by James Cocks, of Reading, and named by him "Reading Sauce,"

¹ 8 Am. L. T. R. (St.) 288; 2 Brewst. 321.

² Act of March 31, 1860, sect. 173.

⁴ 13 Beav. 209.

⁶ *Lazenby v. White*, L. R. 6 Ch. 89; 19 W. R. 291.

³ 4 Barn. & Adol. 410.

⁵ 18 Jur. 7.

under which name it acquired considerable reputation. The success of the manufacture induced others to make and sell what they called "Reading Sauce"; and in order to distinguish the article manufactured by James Cocks and his successor in business, he and they had for many years been in the habit of wrapping the bottles of sauce with labels which always bore the words "The Original Reading Sauce." The plaintiff's label was imitated in part; but he admitted that the only thing to which objection could be taken was the use of the words, "The Original."

§ 543. The defendant alleged that the sauce manufactured by him was from an original recipe, to which the plaintiff had no title, and submitted that his sauce deserved the title of original as much as that of the plaintiff; and he further alleged that the plaintiff's was known to the trade as Cocks's "Reading Sauce," and not as the "Original Reading Sauce." Evidence in support of the last-mentioned allegation was given in his behalf; while, on behalf of the plaintiff, two of the partners in the firm of Crosse & Blackwell, pickle-manufacturers in London, deposed that the use of the word "Original" as part of the title or description of a sauce such as *Reading Sauce*, would lead those in the trade, and the public, to conclude that the sauce so described was the manufacture of James Cocks or his successor. There was no evidence that any one had been misled by the words on defendant's wrappers. Lord Romilly, M. R., said, among other matter: "The question, then, is this. There being abundant evidence to show that there are a great number of persons who make *Reading Sauce*, whether the person who is the owner of the original recipe which gave the name and from which the article called '*Reading Sauce*' acquired its character, is not entitled to say, 'I hold under the original inventor, and the word *original* means that and nothing else.'" He said that the use of the word by the defendant was calculated to deceive. The defendant was accordingly enjoined.¹

¹ *Cocks v. Chandler*, L. R. 11 Eq. 446; 40 L. J. Ch. 575; 24 L. T. (n. s.) 379; 19 W. R. 593. See also, to the same effect, *Fullwood v. Fullwood*, 9 Ch. D. 176; 47 L. J. Ch. 459; 88 L. T. (n. s.) 380; 26 W. R. 435.

§ 544. Labels and cautions composed of words in common use in our language cannot be exclusively appropriated as trade-marks. But those labels and cautions, although not protected by any virtue of their own, become powerful auxiliaries, bringing punishment upon the wrong-doer. Take the case of *Gillott v. Esterbrook*.¹ The selection of boxes, sizes, colors, labels, cautions, and style of lettering, however innocent it may have been under ordinary circumstances, became the most conclusive evidence of the intent to mislead the public, and to commit a fraud upon the plaintiff in relation to his trade-mark; yet merely because all those things can be brought forward as witnesses to complete a chain of testimony of guilt, the mere label does not rise to the dignity of a trade-mark proper.

§ 545. *Trade Secrets*. — These are personal assets, as was held by Lord Hardwicke, C.² The improper use of a secret will be restrained. While an inventor has no exclusive right to his secret, as against the public, especially those who in good faith have acquired a knowledge of the secret, nevertheless he has a good property in it, which a court of equity will protect against one who, in violation of contract and in breach of confidence, tries to apply it to his own use, or to disclose it to others. This is a well-established point.³ A trader may sell a secret of business, as, for example, a mode of dyeing, and restrain himself generally from using that secret;⁴ and after the dissolution of a firm, a partner, who had become acquainted with a secret recipe, through a breach of confidence on the part of a third person, was restrained at the suit of the legatees of the secret;⁵ and he may be restrained if, after lawfully obtaining the secret, and selling the good-will to his co-partners, he sets up in business for himself, and attempts to impart the secret to his workmen.⁶ But under peculiar cir-

¹ 47 Barb. 455.

² *Giblett v. Read*, 9 Mod. 459.

³ *Peabody v. Norfolk*, 98 Mass. 452; 2 Story Eq. § 952. See *infra*, § 562.

⁴ *Bryson v. Whitehead*, 1 S. & S. 74; 1 L. J. Ch. 42.

⁵ *Morison v. Moat*, 21 L. J. Ch. 284; 16 Jur. 321. To the same effect, see *Ansell v. Gaubert*, Seton, 4th ed. 235; *Weston v. Hemmons*, 2 Vict. L. R. Eq. 121.

⁶ *Hagg v. Darley*, 47 L. J. Ch. 567; 38 L. T. (N. S.) 312.

cumstances injunctions will be refused, as where the defendant had been in the service of the complainant, the proprietor of a secret medicine, and began to make and sell an imitation.¹ Lord Eldon, C., once said, “I do not think that the court ought to struggle to protect this sort of secrets in medicine”;² and, at another time, he refused an injunction to restrain the defendant from violating an agreement not to divulge the secret of a medical preparation, on the ground that, if there were a real secret in question, the court could have no means of interfering to enforce its order.³ It is well settled, that whoever can in good faith discover a secret recipe may make and vend the article.⁴

§ 546. *Title of a Book or other Publication.*—There are not a few cases in which the use of some particular title, not amounting to a technical trade-mark,⁵ has been restrained by injunction. While the title of a book, newspaper, or other printed publication for sale, may possess all the essential characteristics of a technical mark, it is frequently otherwise; and yet to prevent an unwarranted or fraudulent interference with the publisher’s good-will right, courts of equity will intervene. Sebastian very properly says,⁶ that, although the term copyright has been inadvertently applied to the right in the title of a publication, — as, for example, by Lord Romilly, M. R., in *Mack v. Petter*,⁷ in which he said, “The plaintiff is entitled to a copyright in the use of the title ‘Birthday Text-Book,’” — there is no copyright therein. Wood, L. J., correctly said:⁸ “It seems to us that there is nothing analogous to copyright in the name of a newspaper, but that the proprietor has a right to prevent any other person from adopting the

¹ *Canham v. Jones*, 2 V. & B. 218.

² *Williams v. Williams*, 2 Mer. 157.

³ *Newberry v. James*, *Ibid.* 446.

⁴ *Hovenden v. Lloyd*, 18 W. R. 1132; *Siegert v. Findlater*, 7 Ch. D. 801; 47 L. J. Ch. 233; 38 L. T. (N. S.) 349; 26 W. R. 459. *Manhattan Co. v. Wood et al.*, 14 Off. Gaz. 519; on appeal, 108 U. S. 218.

⁵ See *ante*, §§ 14, 15, 116 *et seq.*

⁶ *Law of Trade Marks*, p. 171.

⁷ L. R. 14 Eq. 431; 41 L. J. Ch. 781; 20 W. R. 964.

⁸ *Kelly v. Hutton* L. R. 3 Ch. 703; 37 L. J. Ch. 917; 19 L. T. (N. S.) 228; 16 W. R. 1182.

same for any other similar publication." This is now the doctrine of all courts. — The term *title* has its limitation, excluding that which is secondary and merely qualificative, as is illustrated by a case that came up in the Court of Caen, in France, on appeal, in 1878.¹ The court said: "Although the title or denomination of a journal is private property, by *title* or *denomination* of a journal must be understood the same title, etc. under which it is known or designated; that is to say, the words written in very large characters at the head of the first page, and not the qualifications which follow, and are printed in much smaller characters in the second or third line. The plaintiff's journal bears the words 'Le Granvillars,' in very large characters, at the head of the first page, and filling the first line, — that being the sole title under which it is known and designated, though, truly, in the second and third lines are printed in fine type the words, 'Courrier d'Avranches de Constance, et de la Côte,' yet they are no part of the title of the paper, but indicate the radius for which it is established and to which it reports the local news. The defendant, Durand, in entitling his journal 'Le Courrier d'Avranches,' has only availed himself of words that are *publici juris*." The following decisions throw further light on this subject.

§ 547. *Examples of Titles protected.* — "The Real John Bull," infringed by "The Old Real John Bull";² "The Edinburgh Correspondent";³ "The Edinburgh Philosophical Journal";⁴ "The American Grocer";⁵ "Household Words";⁶ "Bell's Life in London," infringed by "The Penny Bell's Life and Sporting News";⁷ "The London Journal," infringed by "The London Daily Journal";⁸ "London Society" magazine, infringed by another styled "English Society";⁹ "The Birth-

¹ Cagnaut v. Durand, 23 Annales, 143. See *ante*, §§ 109, 110.

² Edmonds v. Benbow, Seton, 4th ed. 238.

³ Re The Edinburgh Correspondent Newspaper, 1 Ct. of Sess. Cas., 1st ser., new ed. 407, n.

⁴ Constable & Co. v. Brewster, 3 Ct. of Sess. Cas., 1st ser. 215 (new ed. 152).

⁵ American Grocer Publishing Co. v. Grocer Publishing Co., 51 How. Pr. 402.

⁶ Bradbury v. Dickens, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54.

⁷ Clement v. Maddick, 1 Giff. 98; 5 Jur. (n. s.) 592; 33 L. T. 117.

⁸ Ingram v. Stiff, 5 Jur. (n. s.) 947; 33 L. T. 195.

⁹ Clowes v. Hogg, W. N. 1870, p. 268; L. J. Notes of Cases, 1870, p. 267. — W. N. 1871, p. 40.

day Scripture Text-Book," infringed by "The Children's Birthday Text-Book";¹ "The Iron Trade Circular (Ryland's)," infringed by "The Iron Trade Circular (Edited by Samuel Griffiths)."² — The proprietor of "The Britannia" newspaper incorporated with it another paper, called "The John Bull," and issued the combined paper as "The John Bull and Britannia." The defendant, the former printer and publisher of "The Britannia," began to publish a new paper, under the name of "The True Britannia,"³ and he was enjoined therefrom. But to entitle one to an injunction, there must be such a similarity of designation on the part of the defendant as to be likely to mislead purchasers. Therefore, it was held that "Punch," published at 3*d.*, was not infringed by "Punch and Judy," published at 1*d.*⁴ It was not clear that the title, "Our Young Folks; an Illustrated Magazine for Boys and Girls," was infringed by the use of the title, "Our Young Folks' Illustrated Paper"; so, for that reason, the case was referred to a master to report whether the use thereof by the defendant was deceiving, or was calculated to deceive, the public.⁵ — The Court of Appeal of England refused an injunction to the proprietors of a dramatic and sporting newspaper called "The Era," which had for many years published articles signed "Touchstone," to prevent the publication of a new paper on the same subjects, under the title of "Touchstone, or the New Era."⁶ An injunction was refused, because the complainants were merely contemplating publishing while the defendant had actually published his first number.⁷ So, also, in the "Belgravia" magazine case.⁸

§ 548. In *Hogg v. Kirby*,⁹ the complainant was proprietor

¹ *Mack v. Petter*, *supra*.

² *Corns v. Griffiths*, W. N. 1873, p. 93; Pemberton, 2d ed. 308.

³ *Prowett v. Mortimer*, 2 Jur. (n. s.) 414; 27 L. T. 132; 4 W. R. 519.

⁴ *Bradbury v. Beeton*, 39 L. J. Ch. 57; 21 L. T. (n. s.) 323; 18 W. R. 83.

⁵ *Osgood v. Allen*, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124.

⁶ *Ledger v. Ray*, Cox's Man., case 550.

⁷ *The Correspondent Newspaper Co. v. Saunders*, 11 Jur. (n. s.) 540; 13 W. R. 804.

⁸ *Hogg v. Maxwell*, 12 Jur. (n. s.) 916; 15 L. T. (n. s.) 204; 15 W. R. 84. On appeal, L. R. 2 Ch. 316; 86 L. J. Ch. 437; 16 L. T. (n. s.) 133; 15 W. R. 470.

⁹ 8 Ves. 215.

of a monthly magazine published by the defendant, and sold at his shop on commission. The publication continued during five months; but at the end of that time disputes arose between the parties. It was agreed to discontinue the joint publication, and a final settlement of accounts was had. The complainant then circulated advertisements, stating that the publication under its old title would be continued by him, and that a sixth number of the magazine would be, as it accordingly was, soon afterwards published by him. The defendant at once advertised and published the first number of a periodical work, under a title similar to the plaintiff's, but described as a "New Series, Improved." An injunction was applied for, to restrain him from selling any copies of his publication, and from printing or publishing any, either under the same or any similar appellation, and from borrowing and using the appellation, or copying the ornaments, or any part of the plaintiff's original publication. The court held, that, upon the facts stated, there appeared to be an intention on the part of the defendant to put his work before the world as a continuation of the old magazine. Lord Eldon in that case did not rest his decision so much on the ground of copyright, or of contract, as upon that of fraud. He stated the question to be, not whether the work was the same as the original, but whether the defendant had not represented it to be the same, and whether the injury to the complainant was not as great, and the loss accruing to be regarded upon the same principles between them, as if it were, in fact, the same work. What we may gather from that decision amounts to this: that, by a certain resemblance of form and matter, a publisher may not with impunity put forth to the public a literary work, to be taken for another work of an established reputation, and thus fraudulently reap the advantage enjoyed by the original work; and that this advantage in the market corresponds in some measure with the property created by the Copyright Act, and is protected on analogous grounds.¹

¹ See *Clemens v. Such*, Codd. Dig. 312; *Cox's Man.*, case 429, restraining the use of the name "Mark Twain"; and see also *Jollie v. Jaques*, 1 Blatch. 618, refusing protection to the name "The Serious Family Polka."

§ 549. A case of a similar character is that of *Spottiswoode v. Clarke*.¹ There the plaintiff was the owner of a publication called "The Pictorial Almanac, for 1847"; and the defendant of one called "Old Moore's Family Pictorial Almanac." The plaintiff alleged that the defendant's work was a piracy on his publication, and filed a bill for an injunction. With regard to the substance and internal portion of the two works, there was little or no resemblance; but the covers were, to a certain extent, 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. The bill alleged that this imitation was intentional, and done with a view to deceive the public, to the injury of the plaintiff. The Lord Chancellor said, among other things: "In the course of argument, cases of trade-marks were referred to; but trade-marks have nothing to do with this case. Take a piece of steel: the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article. So it is of blacking, or any other article of manufacture, the particular quality of which is not discernible by the eye. In the present case, if anybody is deceived, it is not by the eye; for anything more different than the two articles in question can hardly be conceived. . . . Both covers represent a portion of Greenwich Observatory, and profess the work to be for all sorts of persons. It is difficult to believe that all this is accidental; but if it is a fraud, it is the most clumsy fraud that I ever saw, for it could deceive no one." He accordingly dissolved the injunction granted below, the defendant undertaking to keep an account, with liberty to the plaintiff to bring an action. The whole gist of the matter lies in this: if no one could be deceived, the plaintiff suffered no injury; but if a casual observer would probably be misled, then the principle laid down in trade-mark cases would be applicable, and the use of a particular name, title, or wrapper would be restrained. This case has been cited and followed.²

¹ 10 Jur. 1043; 2 Ph. 154; 8 L. T. 230.

² *Purser v. Brain*, 17 L. J. Ch. 141. See also *Chappell v. Davidson*, 1 K. & J. 123.

§ 550. In *Snowden v. Noah*,¹ the complainant had purchased from the defendant the right to publish at the city of New York a newspaper called "The National Advocate." The defendant subsequently published at said city "The New York National Advocate." Sandford, Ch., held that there was such a difference as to warrant the court in refusing an injunction to restrain the defendant. — So, in *Bell v. Locke*,² Walworth, Ch., denied an injunction to restrain the defendant from publishing or circulating a newspaper called the "New Era," which was alleged to be an infringement of the rights of the plaintiff, who published the "Democratic Republican New Era." Besides the difference in titles, the defendant's paper, upon its face, purported to be a revival of an old paper, in which he was formerly interested with the complainant, which paper had been voluntarily discontinued by both for more than eighteen months. — In *Matsell v. Flanagan*, the complaint alleged that the plaintiffs were, and long had been, the publishers and proprietors of the "National Police Gazette," which was commonly known to the public as the "Police Gazette"; and it appeared that it was the only "Police Gazette," *eo nomine*, published in the United States, at the time of the publication of this paper. It further appeared that the defendants were engaged in publishing and selling a paper called "The United States Police Gazette," which, from its general character and appearance, was a fraudulent simulation of the plaintiffs' paper. The words "Police Gazette," forming a part of the title, were printed in type similar in character to that employed by the plaintiffs for their print, and a similar imitation characterized the general form, style, type, and device of the paper complained of. It was shown that the public were actually misled into purchasing the defendants' paper for that of the plaintiffs; and the more easily as when "The United States Police Gazette" was folded, and lying upon the newspaper stands, as is usual and customary, the words "United States," which made the difference between the titles of the two papers, would be concealed. The manifest fraud in this case distinguishes it in

¹ Hopkins, Ch. R. 347.

² 8 Paige, 75.

principle from *Snowden v. Noah* and *Bell v. Locke* (*supra*). The injunction was continued. — In *Stephens v. De Conto*,¹ the main question was, whether the name of a newspaper in the Spanish language, called “El Cronista,” published by the defendant, was an infringement upon the name “La Cronica.” Monell, J., held that there was so manifest a dissimilarity in the general appearance of the two titles, both as respects the formation of the words and the character of the type employed in printing, that no Spaniard could mistake. But the case was relieved of all difficulty, as it appeared that the publication of “La Cronica” had ceased. The injunction was dissolved, and the complaint dismissed. — In *Dayton v. Wilkes*,² the good-will of a newspaper — that is, the celebrity which it had acquired under the name of “Porter’s Spirit of the Times” — was fully recognized as a valuable property. — And in *Clement v. Maddick*,³ where an injunction was granted to restrain the defendant from using the name “Bell’s Life” for his newspaper, the court characterized the suit as “an application to support a right to property.”

§ 551. In the court of Paris, in 1858, (case of *Estibal v. Petit-Demenge*,⁴) an appeal from a judgment forbidding the defendant from using the name of a journal — the “Charivari” — on card-covers for the same, to be used in coffee-houses, lecture-rooms, etc., it was held that such use did not constitute a case of illicit competition or infringement. The appellate court said that the gilt advertising-cards of the defendant were but covers for the “Charivari,” which could not create confusion in the public mind with the paper itself; and although, in enclosing the “Charivari” in the covers, the defendant addressed the readers of the journal, that fact in itself did not make him responsible in damages. The defendant offered to alter his cards so that they should read, “Cover for the ‘Charivari,’” which the court thereon directed to be done.

§ 552. In the Tribunal of the Seine, in 1855, (*Castille v. Dennery*,⁵) it appeared that the plaintiff had published, in

¹ 4 Abb. Pr. (N. S.) 47; 7 Robertson, 843.

² 17 How. Pr. 510.

³ 5 Jur. (N. S.) 592.

⁴ 4 Annales, 334.

⁵ 2 Id. 27.

1847, a romance entitled "Les Oiseaux de Proie" (The Birds of Prey). The defendant brought out a drama under the same title, which was thought by M. Castille to be an infringement upon the name he had selected. *Held*: "Considering that for a long time the words *Oiseaux de Proie* have been metaphorically employed to designate certain men; that those men offer types so varied that they are the objects of observations, of studies, and diverse paintings, to each of which the said words are as applicable as to a romance by Castille; and that there is no invention in the title, — the demand of the plaintiff must be refused."

§ 553. An author or a publisher has, either in the title of his work, or in the application of his name to that work, or in the particular external marks which distinguish it, just such a species of property as a trader has in his trade-mark. He may, therefore, equally claim the protection of a court of equity against such a use or such an imitation of that name or mark as is likely, in the opinion of the court, to be a cause of damage to him in respect of that property.¹ Upon this principle rests the case of *Thunot-Duvotenay v. Degorce-Cadot*, in the Court of Paris, in 1869. Madame Michaud, widow of the historian of the Crusades, had married M. Thunot-Duvotenay, and conjointly with him and others in interest had brought suit to prevent the further publication of a "History of the Crusades," which had been brought out by the defendant. The defendant had, in 1868, by means of circulars and notices, profusely scattered about, announced for sale the "Histoire populaire et nationale des Croisades," by Michaud. Four numbers of this book were published. Having been duly warned by process to cease the publication, he had recourse to subterfuge to give to the complainants a seeming satisfaction. In the fifth number, he ceased to edit the text of the "History of the Crusades," by Michaud, and substituted therefor the "Jerusalem Delivered," of Tasso. The substitution deceived a portion of the public, who believed that the "Jerusalem Delivered" was a legend of the "History of the Crusades," which latter title continued to figure at the head of

¹ Lloyd on Trade Marks, 2d ed., p. 42.

each page. These combinations and manœuvres constituted a manifest fraud. The Tribunal of Commerce of the Seine, which had original cognizance of the case, held that it had jurisdiction of the matter as a commercial act, the parties appearing in the character of merchants. Judgment for complainants. Upon appeal, the defendant invoked his good faith to repel the presumption of tort. He fared no better than in the forum below. The court said, *inter alia*: "Considering that Michaud is a contemporary author; that his History of the Crusades has a merit and renown that the defendant was among the first to recognize; that the defendant is a bookseller and editor in Paris, where divers editions of this book have been published; that under these circumstances he cannot pretend ignorance of the fact that the name has not become public property, but belongs to the heir and assignees, or, if he had a doubt thereon, the most simple effort would have dissipated the doubt; that he cannot pretend that he prepared and commenced the publication in good faith, but has manifested his bad faith by his acts; therefore he is guilty of counterfeiting, and the judgment must be affirmed, with costs."¹

§ 554. In the remarkable case of *Lord Byron v. Johnstone*,² in 1816, the defendant, a publisher, advertised for sale certain poems, which he represented by the advertisement to be the work of Lord Byron, on whose behalf a bill was (during his lordship's absence abroad) filed to restrain the publication under the title described in the advertisement. There appears to have been some doubt at the time of the original publication whether or not the poems were Lord Byron's; but when the defendant, at the hearing, declined to swear as to his belief that the poems in question were actually the work of Lord Byron, the court granted the motion for an injunction until answer or further order. This seems like recognizing a proprietary right in a mere name. At least, it goes so far as to grant relief against damage arising from

¹ This section was cited with approbation by the Maryland Court of Appeals in 1878, in *Robertson v. Berry et al.*, 50 Md. 591.

² 2 Mer. 29.

the use of a particular name in conjunction with a particular article offered for sale; it being impossible for the purchaser to ascertain, on mere inspection, the truth or falsehood of the representation on the faith of which he buys the article.

§ 555. It is difficult to reconcile the principle of the decision in this case with that of the decision in *Clark v. Freeman*,¹ in which the eminent physician, Sir James Clark, applied for an injunction to restrain a chemist from publishing and selling a quack medicine under the name of "Sir James Clark's Consumption Pills"; but the court refused to interfere, because it did not appear that Sir James Clark had sustained any pecuniary injury. The only distinction between the principle of the two cases seems to be this: that in the former the author must be held to have a species of property in his name, consisting in the recommendation to the public which the use of that name gives to the sale of a literary work, while it did not appear that Sir James Clark was in the habit of selling medicines, or of deriving a profit from the sale of medicines, and therefore it could not be argued that he had suffered injury in trade; and the court could not recognize an injury done to his reputation, which it treated as an illusory damage. It must, therefore, have held in the former case that the author has a species of interest in his name, quite similar to that of a trader in his mark affixed to the articles manufactured by him.

§ 556. Yet there does seem to be natural justice in protecting one's name from contempt or unpleasant notoriety, which may amount to infamy. Could not the eminent physician have been seriously damaged in his practice by the usurpation of his name by a quack? and was he not in all probability injured in his professional reputation by the conduct complained of? If this decision be sound, may not any man's name be blasted by the brazen villany of another who chooses to borrow his name? In France, a different doctrine is maintained, as is evident by the judgment of the Tribunal Civil of the Seine, in 1869 (*Charles de Bussy v. Charles Marchal*.²) The defendant, well known in the literary world

¹ 11 Beav. 112; 17 L. J. R. (n. s.) Ch. 142.

² 15 Annales, 143.

under the pseudonym of Charles de Bussy, is the author of numerous publications which have appeared under the assumed name. Among them is a *brochure* entitled "Les Impurs de Figaro," and another entitled "Le Cas de M. Rochefort." The plaintiff, an engineer of Paris, who aspired neither to immodest notoriety nor the imputation of embroiling himself in political affairs, obtained an injunction against the further misuse of his name, with 50 francs damages, and costs. — But it is sometimes lawful to use one's name or pseudonym, without his consent and to his prejudice, without legal liability for the act. "Mark Twain" is a trade-mark for some publications, and is not entitled to any protection in others. In a United States Circuit Court, in 1883, Blodgett, J., said: "An author cannot, by the adoption of a *nom de plume*, be allowed to defeat the well-settled rules of the common law in force in this country, that the publication of a literary work, without a copyright, is a dedication to the public, after which any one may republish it. No pseudonym, however ingenious, novel, or quaint, can give an author any more rights than he would have under his own name."¹ Even the good-will was extinguished by such prior publication.

§ 557. *The Name of a Song.* — Certain music publishers having adapted original words to an old American air, which was rearranged for them, gave to the song so composed the name of "Minnie," and procured it to be sung by Madam Anna Thillon, a popular singer, at M. Julien's concerts in London; and when it had by that means become a favorite song, they published it, with a title-page containing a picture of the singer who had brought the song into notice, the name "Minnie," etc. *Held*, that the publishers had by these means obtained a right of property in that name and description of their song, which a court of equity would restrain any person from infringing.² Another party infringed upon the same by using the words "Minnie, dear Minnie," and was restrained by an interlocutory injunction, without imposing

¹ Clemens v. Belford, 11 Biss. 459.

² Chappell v. Sheard, 2 Kay & J. 117; 1 Jur. (n. s.) 996.

upon the parties the necessity of trying the right at law.¹— But where, the plaintiff being a writer and composer of songs and music under the name of “Claribel,” the defendants published and sold certain songs, of which the plaintiff had written the words but not composed the music, with the words “Song written by Claribel” on the title-page, an injunction was refused.²

§ 558. *The Titles of Printed Publications* are sometimes registered, as trade-marks, and they may legitimately be so registered, provided they have such a distinctive individuality as shall preclude the probability of confusion with the titles of other publications. “Our Society,”³ and “Insurance Monitor,”⁴ seem to be free from any such objection, as applied to periodicals. The same may be said of most of those mentioned in § 547.

§ 559. *The Right to Exclusive Use must be Definite*, to entitle the claimant to relief. In England, it has been held that a newspaper is not within the Copyright Act, 5 & 6 Vict. c. 45, and therefore requires no registration under that act; but the proprietor of a newspaper has, without registration, such a property in all its contents as will entitle him to sue in respect of a piracy.⁵ But there must be something definite and certain in the thing sought to be protected. When the proprietor of a newspaper sought to restrain the piracy of a “List of Hounds,” the court was of opinion, that, although the piracy might be established, the list was liable to such frequent changes, and a correct list was so easily obtained, it was not a case for an interlocutory injunction.⁶

§ 560. *Names and Designations on Coaches, et.:*— A court of equity will restrain a defendant from fraudulently using the same words and devices on an omnibus that the complainant may have previously appropriated to designate his. In *Knott*

¹ *Chappell v. Davidson*, 2 Kay & J. 123.

² *Re Barnard v. Pillow*, W. N. 1868, p. 94.

³ *Re F. C. Barksdale*, Cert. No. 424.

⁴ *Re Charles C. Hine*, Cert. No. 903.

⁵ *Cox v. Land and Water Journal Co.*, 9 L. R. Eq. 324; 39 L. J. Ch. 152. (V. C. Malin's court.)

⁶ *Ibid.*

v. Morgan,¹ in 1836, in the Rolls Court of England, the defendant was restrained from using upon an omnibus the names "London Conveyance," and "London Conveyance Company," or either of such names, or any colorable imitation of them, or either of them, painted, stamped, printed, or written thereon, or in any manner affixed thereto. — *Stone v. Carlan*,² in 1850, is a similar case, the defendants having been restrained from improperly using the name "Irving Hotel," "Irving House," or "Irving," upon coaches, and upon certain badges worn by the defendants upon their arms and hats. — *Deiz v. Lamb*,³ in 1866, the "Prescott House" case, is another of the same kind. — The same principle was applied in *Winsor v. Clyde and Stetson v. Winsor*, in regard to the name "The Keystone Line," for steamships.⁴ — In the late case of *The New York Cab Co. v. Mooney*, the defendant was perpetually enjoined from using cabs painted and lettered to create the impression that they belonged to the plaintiff.⁵

§ 561. An action of trespass on the case may be maintained under similar circumstances. Thus, in *Marsh v. Billings*,⁶ where the plaintiffs claimed and established the exclusive right to use the name of a hotel, "Revere House," upon coaches, to indicate the fact that they had the countenance of the lessee of that house for the purpose of transporting passengers between that house and the railroads. For this privilege they paid an equivalent in the obligations into which they entered. The ground of action against the defendants was not that they carried passengers to the Revere House, or that they had the words "Revere House" on the coaches and on the caps of the drivers merely, but that they falsely and fraudulently held themselves out as being in the employment, or as having the patronage and confidence, of the lessee of the Revere House, in violation of the rights of the plaintiffs. The

¹ 2 Keen, 213.

² 13 Monthly L. R. 360; R. Cox, 115. See also same matter in *Howard v. Henriques*, 3 Sandf. S. C. 725; R. Cox, 129.

³ 20 N. Y. Superior Court, (6 Robertson,) 537.

⁴ 9 Philad. 513.

⁵ Reported in New York Tribune, Sept. 25, 1884.

⁶ 7 Cush. 322; 14 Monthly L. R. (4 n. s.) 664; R. Cox, 118.

Supreme Court of Massachusetts held, on appeal, in this case, that the plaintiffs would be entitled to such damages as the jury, upon the whole evidence, should be satisfied they had sustained; and that the damage should not be confined to the loss of such passengers as the plaintiffs could prove had actually been diverted from their coaches to those of the defendants, but that the jury would be justified in making such inferences, as to the loss of passengers and injury sustained by the plaintiffs, as they might think were warranted by the whole evidence in the case.

§ 562. *Secret Process, Breach of Faith, etc.*— There are also cases involving a breach of trust, in disclosing a secret process, a knowledge of which has been gained through confidential relations of the parties. The earliest of these cases, *Newberry v. James*,¹ in 1817, shows the difficulties that have been felt in dealing with questions of this sort. The complainant claimed to be entitled, under the provisions of certain agreements entered into by the ancestors of himself and the defendants, respectively, to the exclusive right of selling certain powders and pills, well known as “James’ Powders,” and “Analeptic Pills,” as agent of the defendants, and prayed a decree for specific performance of agreements. The pills and powders were made up by the defendants from an alleged secret recipe; and it was sought to restrain them from communicating this recipe to any other person without the plaintiff’s permission. The court does not seem to have looked upon this secret recipe in the light of property,—the subject of certain agreements as to the manner of enjoyment,—and as clearly liable to injury from divulgation. Had this been done, there probably would not have been serious difficulty in framing an injunction in restraint of such a contemplated injury, even though the court might not have been able to decree the specific performance of the agreement. On this head, the Lord Chancellor said that either it was a secret, or it was not. If a secret, what means did the court possess for enforcing its own orders? If not a secret, there was no ground for interfering. If the art and method of preparing the Analeptic

¹ 2 Mer. 447.

Pills, for which no patent had been procured, were a secret, what signified an injunction, the court possessing no means of determining on any occasion whether it had or had not been violated? The only way in which a specific performance could be effected would be by a perpetual injunction; but this would be of no avail, unless a disclosure were made to enable the court to ascertain whether it was or was not infringed; and in complaining of a breach of an injunction, it would be necessary first to show that the injunction had been violated. The injunction was therefore dissolved. — In *Williams v. Williams*,¹ it was said that the court would not struggle to protect secrets in medicine of that sort; but that it was different in the case of a patent, because there the patentee was a purchaser from the public, and bound to communicate his secret at the expiration of the patent. — This point has been settled with tolerable distinctness in *Dietrichsen v. Cabburn*.² Lord Cottingham virtually decided that, where there is such an infirmity in an agreement that it cannot be performed in all its parts, the court will not by injunction compel a defendant to perform the one part, it being at the same time unable to compel the plaintiff to perform reciprocally the other, namely, that which was positive in the agreement, if its aid should be appealed to by the defendant in order to procure for him the benefit of the contract or agreement. — We find, however, that in *Youatt v. Winyard*,³ the defendant, who had been employed as the plaintiff's assistant under an agreement by which he was to have a salary, and be instructed in the general knowledge of the business, but not in the secret of manufacturing the medicines sold, was restrained from divulging those recipes to which he had surreptitiously gained access; and from making up and selling the medicines compounded from the recipes, with certain printed instructions, almost literally copied from the plaintiff's. In this case, the decree proceeded on the ground of trust. — So, also, in *Green v. Folgham*,⁴ where the defendant was held to be the trustee of the secret of compounding "The Golden Ointment," under the trusts of a certain

¹ 3 Mer. 157.³ 1 J. & W. 394.² 2 Phillips, 52.⁴ 1 S. & S. 398.

settlement, and was ordered to account for certain mesne profits made by him in the sale of the ointment; the court even going so far as to direct the valuation of the secret to be made for the purpose of administering the trust property. — In *Tippling v. Clarke*,¹ a case arising out of a dispute between two merchants, in the course of which the defendant, in a letter to the plaintiff, stated that he had acquired a knowledge of his books and accounts, and that he intended to make a public exhibition of them, we have a recognition of the same doctrines. — In *Morison v. Moat*,² it appeared that the plaintiff and the defendant had for some years carried on in partnership the business of making and selling “Morison’s Universal Medicine.” On the dissolution of the partnership, the defendant, who had retired, set up for himself, and made and sold the original medicine under its former name as prepared by him. The complainant, in praying for an injunction, put forward the ground of fraud or misuse of his labels and trade-marks by the defendant; but he relied on this only in aid of the principal head, — that of breach of faith and contract; and it is on this ground that the decision rests.³ — In France, the law recognizes the secrets of manufacturers as property, and article 418 of the Penal Code severely punishes clerks or workmen who divulge the secrets of manufacture of their employers.

§ 563. On the other hand, where no charge of breach of trust is involved, courts will not protect the proprietors of secret medicines or other compounds not patented; and any one possessing himself of another’s secret by fair means may make and vend the same, provided he sell it as his own manufacture, and not as that of a party complaining. Thus, in *Davis v. Kendall*,⁴ where the plaintiff had no patent, and therefore no exclusive property in a medical compound invented and sold by him, and known as the “Pain Killer,” the court said that all were entitled to make and vend the compound. — The

¹ 2 Hare, 383.

² 9 Id. 241.

³ As to authorities on this matter of secrets of trade, see 2 Story Eq. Jur. § 954; 3 Daniell’s Chancery Pleading and Practice, 1755.

⁴ 2 R. I. 566.

same doctrine was recognized in *Comstock v. White*.¹ The defendants, after dissolving their connection with the plaintiffs as partners, began to use the name or designation "Dr. Morse's Indian Root Pills," to which neither party had any exclusive right. The court held that, while an injunction should not be granted against an innocent defendant, yet where it appeared that the defendants, in having connected themselves with the plaintiff in selling the medicine by a particular name or designation, and having induced the plaintiffs to expend large sums of money in advertising, etc. the medicine manufactured, and then suddenly and without notice, in an unjustifiable manner and apparently from improper motives, severed their connection with the plaintiff, and set up the same business for themselves, an injunction should be granted.

§ 564. As an instance of reparation for a wrong done, we will take a case tried in the Court of Paris, in 1861, — *Galy v. Mauchien & Co.*² Galy was the inventor of certain pharmaceutical products, which he sold under the denominations of "Sirop iodhydrique, Iodhydrate de Fer," of "Bonbons iodhydriques," and of "Pâte pectorale de réglisse Iodhydrique." He made the defendants the exclusive agents for the sale of his said products, upon the condition that they should use upon flasks, boxes, and prospectuses the above-mentioned names, and also the name of Galy as inventor. They omitted his name, wherefore he sued. The court took into consideration the publicity which the defendants had given to the spurious labels, and said that, as the defendants had committed the wrong by means of announcements made by the Société Hygiophile, in the journals "Le Siècle," "La Presse," "Les Débats," "La Patrie," "Le Constitutionnel," "Le Pays," and in the journal called "La France médicale et pharmaceutique," it was just that the order of the court should receive the same publicity, at the expense of the defendants. In addition to costs, etc., the publication was ordered to be made showing the judgment for the plaintiff.

¹ 18 How. Pr. 421.

² 8 Annales, 374.

CHAPTER XIII.

PRACTICE IN THE PATENT OFFICE.

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§ 565. *Preliminaries to Application for Registration.*—

When the owner¹ of a trade-mark wishes to avail himself of the advantages of registration, he should reflect how his object can best be accomplished. He prepares his case with carefulness and thought. This he may do himself, and generally with an assurance of safety, provided he possess that rare quality known as "common sense." But he may not always feel perfectly safe in drawing up a few simple statements of fact, for if he be a person really possessed of the rare quality mentioned, in the majority of instances he will mistrust his own powers, remembering that experience is the mother of science. No man is wise at all times. The very simplicity of the procedure is puzzling to him. Many men deem it to be a simple matter to string a few sentences together in the form of a will and testament. We know that the memory of the man who drew his own will is always venerated as the lawyer's best friend. Words are sometimes used in a wrong or loose sense even by astute jurists and writers; what, then, may be expected when a layman—however expert he may be with ledgers and invoices—hastily pens an application for the registration of his mark? That mark may be worth a fortune to him, although a mere "abracadabra" when disconnected from a particular species of goods. The meaningless, arbitrary symbol becomes a talisman. How, then, shall it best be protected?²

¹ He must be "owner." One cannot own a trade-mark for carpets in his hands as a cleaner, for as to him they are not merchandise. (Re Hankinson, 8 Off. Gaz. 89.) A packer and vendor of fish, being also official inspector of fish, has no private property in the official brand. (Chase v. Mayo, 121 Mass. 343.) Indeed, the brand could not be a trade-mark for the public authorities, they not being traders. (See *ante*, §§ 139 *et seq.*, as to definition of "Merchandise," and § 284, as to meaning of the term "Owner.")

² "La marque employée honorablement peut et doit être maintenant une source de fortune, puisqu'on est sûr désormais qu'une protection efficace empêchera qui que ce soit d'usurper le signe caractéristique dont on a fait le pavillon de sa marchandise pour soi et ses successeurs."—*Marques de Fabrique*, by M. Émile Barrault.

§ 566. The Rules of Practice of the Patent Office (17-23) furnish good advice upon this subject. The remarks made in regard to a patent are also applicable to a trade-mark. The value of either depends largely upon the careful preparation of specifications and claims, and "the assistance of competent counsel will, in most cases, be of advantage to the applicant; but the value of their services will be proportionate to their skill and honesty, and too much care cannot be exercised in their selection." But how shall a selection of counsel be made from the multitudes of aspirants for forensic honors? Rule 17 says: "The Office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making selections. It will, however, be unsafe to trust those who pretend to the possession of any facilities except capacity and diligence for procuring patents in a shorter time or with broader claims than others." Making the necessary changes in words, we may apply this caution to trade-mark matters.

§ 567. It is not every experienced counsel in patent cases who is qualified to conduct, or advise upon, a question of law applicable to trade-marks. It has frequently been made manifest that one who has devoted himself exclusively to patent practice is at a disadvantage, when dealing with rights in a symbol of trade and commerce. His thoughts—habituated to run in a groove—confound one thing with another of a very dissimilar nature. The mischief of mistaking a certificate of registration for a patent, or anything in the nature thereof, has been demonstrated in several places in this book. Yet miscalled patent lawyers make this mistake every day. It would therefore be judicious for the applicant to select one who is not a *mere* patent agent as his legal adviser in dealing with this question, involving so much commercial law. Forewarned, forearmed. The language of the papers may be the foundation of all right to protection.

§ 568. *Necessity for Forms.*—It has been well said that well-constructed *forms* are the consummate excellence in every department of legal practice. As conveyancing is nothing without forms, so is pleading nothing without them. Forms are the only contrivances to secure precision, certainty,

and facility.¹ *Form* is of incalculable advantage to the practitioner who draws the papers, for a case never fully reveals itself until put into a definite form; it is an eminent auxiliary in the analysis of the application in the Patent Office; and is almost indispensable in the distraction and flurry of the trial of a cause in court. Perhaps your case may never get into court. That is more probable than otherwise, if your case is believed to be impregnable, free from ambiguities, with a title clear. Why come to the Office for registration of a trade-mark, but with the view of arming for the conflict? You thereby apply the maxim, that the surest way to avoid war is always to be prepared for it. You do not come to the Patent Office for a trade-mark, for, as has repeatedly been said in this treatise, no power resides in the government to grant one;² but you do come to record the fact of your adoption of a mark, and bear away with you the evidence of your assertion of title to the sole use of a peculiar symbol.³ You can have an adjudication upon the question whether your supposed trade-mark is valid or not, and that adjudication may be the means of closing the door to all strife. Your purpose is best subserved by adherence to form.

§ 569. The Office does not stickle for mere *technical form*, i. e. form independent of the merits. It looks rather to substance; and a high degree of artificiality is not desired. But we must remember that there is in legal contemplation no such thing as *form* without substance, or *substance* without form. We know, by experience, that the precedents enable us to embody all necessary allegations with ease and perspicuity. Thus are evolved upon the record questions of law and of fact, so that they may all be exactly and intelligently met.

§ 570. The system of examination is this. The papers are inspected, to ascertain whether they are written in the English language, in a fair and legible hand, on but one side of a sheet, with all interlineations and erasures clearly marked

¹ Tyler's Rules of Pleading, 50.

² See remarks of Wallace, J., in *La Croix v. May et al.*, 15 Fed. R. 236.

³ See section 2 of the Registration Act of 1881.

in a marginal note on the same sheet, and also to see that they contain all indispensable allegations. The scrutiny may disclose some fault susceptible of amendment. If so, it is pointed out, so that the paper may be perfected.

§ 571. The case is then taken up on its merits. Sometimes a course of special pleading is pursued, until the essential questions are met. The application papers serve as a declaration, in lack of a defence to which the claim is passed for issue. Although the forms are few and simple, and the Office affords every reasonable facility for the curing of defects, a considerable degree of accuracy is quite necessary. He who has made himself familiar with the science of special pleading at common law, — little studied nowadays for practical use, — as an aid to mental discipline, and as a system of logical devolution of the issues of a strictly legal controversy, will have an advantage over him who is slovenly in thought.

§ 572. The Office may plead in abatement, as for want of some material allegation. That having been cured by amendment, the case proceeds upon the law thereof. Admitting all the facts alleged by the *prima facie* case, the Examiner takes exception to the legal right of the claimant; for it may be that, — 1. His record discloses the fact that the applicant is not one of the persons, natural or artificial, included within the provisions of the act of Congress of March 3, 1881; 2. Or, that the proposed trade-mark is not sufficient in law, being merely indicative of quality, or consists of words common to the language, to which no one can claim an exclusive right of use,¹ because not indicating origin or ownership;² 3. Or, that the same symbol has already been appropriated by another person for the same class of goods, as is shown by records, or otherwise is known; 4. Or, that the right to claim protection by virtue of the act has expired by limitation, in the case provided for in section 5 of the act; 5. Or, that the proposed mark is calculated to deceive the public; 6. Or, that it is intended for use in an unlawful business; 7. Or, that the regis-

¹ See *ante*, § 134, "Generic Names," etc.

² See *ante*, §§ 144 *et seq.*, "Indication of Origin or Ownership."

tration would be contrary to public policy, etc.; — all which matters may be necessarily inferable from the language of the applicant. While it is not probable that he would set a trap to catch himself, he may, in telling all the truth, blunder into difficulties from which he cannot be extricated. He is estopped by his recitals. He has, perhaps, admitted too much, as will appear in suppositive cases hereafter.

§ 573. As the application papers have the same purpose as a declaration in an action, the Office must *demur* or *plead* thereto. In not one of the cases given can it plead either by way of *traverse*, or of *confession and avoidance*; for there is nothing to take issue upon. The Examiner then demurs for insufficiency in *substance* and in *form*. The cases commented upon are *essentially insufficient*. They are also stated in an inartificial manner. The insufficiency may be excepted to in general terms, without showing specifically more than one insuperable objection. A single bullet may be as efficacious as a shower of missiles. But when the refusal to register amounts to nothing more than a plea in abatement, the Examiner aids the applicant by specifying the grounds of objection, and gives as many hints and facilities for amending as can reasonably be expected. But as the peculiar province of this officer is at times misunderstood, it must be stated in this place that he is not obliged to furnish advice to any applicant.

§ 574. No. 14 of the Rules of Practice of the Patent Office is as applicable to a trade-mark as to a patent case. It is there provided that the Office cannot respond to inquiries as to novelty, in advance of an application, nor to inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether the same claim had been passed on, and, if so, in whose favor; nor can it act as an expounder of the law, nor as counsellor for individuals, except as to questions arising within the Office. These questions arising within the Office are those which legitimately spring from a case actually under consideration. The functions of the Examiner of Trade-Marks are judicial in their nature. He is neither advocate nor counsel.

§ 575. The applicant may join issue with the Office, and argue the law question raised, and produce judicial decisions as to the law; or he may introduce new evidence to sustain his title, and show that the decision was based on a mistake of fact. For example, if his claim be rejected on the ground that he belongs to a country that does not allow similar privileges to citizens of the United States, he may suggest that there is a treaty or convention between his country and this, and the Office will take cognizance of any such fact that by accident may not have come to light; or he may take issue on the question of novelty; or admit that another person once had title, but aver that he had lost it by abandonment; or that the mark already registered is for a different class of goods; or that the foreign protection has not expired, as provided for in section 5 aforesaid; or he may, as best he can, meet any other objection. Of course it would be entirely impossible to suggest the multiplicity of points that may arise in the prosecution of a claim to the recognition of an exclusive right in an emblem. Man is not a mere machine, but is a being of mind.

§ 576. *Drawing and Filing of Application.*—It is to be presumed that the applicant has a valid claim to the exclusive use of a symbol as his trade-mark, before he comes to the Patent Office. He consults the law as to the employment of descriptive or generic terms, and satisfies himself that he has a right to a certain definite emblem, by priority of adoption in his particular business. If he follow the dictates of common sense, his case may be clear enough. He takes approved forms, and modifies them, telling a plain, unvarnished tale, in as concise language as may express his meaning. Having signed each paper, with two witnesses to the specification and the drawing or mounted fac-simile, and verified the declaration, the case is ready to be presented. If the specification be accompanied by an original drawing, — on a sheet ten by fifteen inches, having a light and simple single-line border one inch from the edge, leaving the “sight” exactly eight by thirteen inches, — there need not be other fac-similes; for copies will be made therefrom