

may not use the color that another has selected as a distinguishing mark of his goods, or use the same arrangement of letters and of marks, when such use is with the design to market his goods as the goods of another." *Enoch Morgan's Sons Co. v. Whittier-Coburn Co.*, 118 Fed. R. 657, 661.

Party not allowed to use blue wrappers on washing compound called Saphia, in imitation of blue wrappers on Sapolio. *Enoch Morgan's Sons Co. v. Schwachofer*, 5 Abb. Pr. n. cas. 265.

"There are decisions to the effect that color alone cannot become a valid trade-mark, and that a red label on a yellow wrapper, or a white label on a red box, cannot be registered. But where, for the purpose of presenting his goods to the public, a manufacturer has adopted a particular combination of features, in part old and in part new, he may be entitled to protection against a palpable imitation." *Hildreth v. D. S. McDonald Co.*, 164 Mass. 16.

"Color, undoubtedly, is a most important element in all package combinations; but there are other elements as well, which go to make up the entire combination. Because a total change of color would so change the general appearance as to destroy resemblance to another package, it by no means follows that color alone would be sufficient to produce a general appearance resembling another package. It would not be giving the complainant a monopoly of yellow to restrain the sale of a particular yellow package, where, in addition to the color, a number of other elements, each differing more or less from its analogue in complainant's package, had been so collocated together as to produce a general appearance calculated to delude the unwary purchaser." *N. K. Fairbank Co. v. R. W. Bell Mfg. Co.*, 77 Fed. R. 869.

"They must also, upon the same grounds, be prohibited from surrounding the neck and cork of a bottle of the form generally used to contain champagne wine, which contains their product as herein described, a rose-colored capsule of metal, whether stamped with the words 'Extra Dry,' and an imitation of the complainant's trade-marks, as in the exhibit before the court, or otherwise." *Von Mumm v. Frash*, 56 Fed. R. 830.

But see: Complainant not entitled to a decree enjoining the sale merely of a rose-colored capsule, unembossed, or even with the words "Extra Dry" impressed thereon, as such capsules may well be used in such a manner as not to deceive. *Von Mumm v. Witteman*, 91 Fed. R. 126; affirming 85 Fed. R. 966.

F. A style of dressing or marking goods.

See XI. 14. 270. *Proctor & Gamble Co. v. Globe Refining Co.*, 92 Fed. R. 357.

See XI. 1, 239, 2, 242, 4, 245.

Respondent held to have infringed rights of complainant in use of bottles of precisely same size and form for Morse's "Yellow Dock Compound," and in blowing in the glass in precisely the same manner the words "Dr. Morse's Celebrated Syrup." *Alexander v. Morse*, 14 R. I. 153.

Imitation of boxes for fireworks with labels enjoined. *Barnett v. Leuchars*, 13 L. T. N. S. 495.

Similarity of phrases on boxes of gall cure, and of size and color held to justify an injunction on ground of unfair trade. *Bickmore Gall Cure Co. v. Karns*, 134 Fed. R. 833; reversing 126 Fed. R. 573.

Inventor and manufacturer of metallic hones for sharpening razors wrapped them in special envelopes to distinguish them; defendant procured envelopes, and wrapped them on his own hones; plaintiff entitled to recover, although defendant's hones were as good as plaintiff's. *Blofeld v. Payne*, 4 Barn. & Adol. 410.

"The imitative devices used upon the stoves and ranges manufactured by the defendants are alleged to be employed by them for the purpose and with the result of deceiving the public, and thereby diverting the trade of the complainant to the defendants. This they have neither the moral nor the legal right to do." *Buck's Stove & Range Co. v. Kiechle*, 76 Fed. R. 758.

"Complainants ought in equity and good conscience to be protected from the imitation of their packages, so far as they are peculiarly designed and shaped, for the purpose of distinguishing complainant's goods, and from the imitation in color, design, style, and lettering combined of the labels used to make said packages, when put on the market; and complainants ought to be protected, as against the present defendants, from the introduction and sale of all such goods as are put up in such imitated packages and marked with such deceptive labels." *Carbolic Soap Co. v. Thompson*, 25 Fed. R. 625.

Imitation of bottles and labels of "Castoria" so as to deceive enjoined. *Centaur Co. v. Hughes Bros. Mfg. Co.*, 91 Fed. R. 901.

While the word "Castoria" has become public property at expiration of patent, respondent is obliged to plainly distinguish

his goods and not use similar bottles and labels to those used by complainant during twenty years previously. *Centaur Co. v. Neathery*, 91 Fed. R. 891.

Complainants had long made thread and sold it under a special label of their own design. Respondents fraudulently imitated it. Injunction. *Coots v. Holbrook*, 2 Sandf. Ch. 586.

Where preparation was put up as "Ohio Liniment," in bottles with labels and directions in similar language so as to imitate "Chinese Liniment," injunction issued. *Coffeen v. Brunton*, 4 McLean, 516.

A barrel with red rim and glazed surface, bearing letters "AAA" and a Maltese cross, protected against a similar barrel with letters XXX and a crown. *Cook v. Starkweather*, 13 Abb. Pr. n. s. 392.

Preparations put up in glass bottles of a certain size, with labels, and bearing name "Mrs. Winslow's Soothing Syrup" imitated as to bottles, labels, and name; held infringement, and injunction. *Curtis v. Bryan*, 36 How. Pr. 33.

Cards used by the respondent for hooks and eyes were substantially like those of complainants as to size, color, and form, and made to simulate mode of fastening eyes to cards. Injunction. *De Long Hook & Eye Co. v. Francis Hook & Eye Fastener Co.*, 139 Fed. R. 146.

"The defendant had an equal right with the complainant to manufacture and sell the same sizes and style of labels, but not intentionally and fraudulently to dress them by such a mode of packing and numbering as to cause, or be likely to cause, purchasers to mistake them for those produced by the complainant." *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651.

System of numbering to designate style and size of stationers' supplies, and style of dressing goods with labels, etc., imitated by defendant; relief on ground of unfair trade. *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651.

Although "Toothache Gum" on medicinal preparation is descriptive, yet respondent is enjoined from using the name on labels of same or similar color as that used by complainant and in connection with style of similar type. *Devlin v. McLeod*, 135 Fed. R. 164.

Respondent enjoined from using name "Toothache Gum" on medicinal preparation on labels of similar type and color to those of complainant. *Devlin v. Peek*, 135 Fed. R. 167.

An emollient paper dressing for corns put up under name

"French Tissue" by complainant was sold by respondent under same name, in such shape, and in envelopes and advertising circulars so closely resembling those under which complainant had achieved reputation, that there was likelihood of deception. Held injunction should issue. *Draper v. Skerrett*, 116 Fed. R. 206.

Complainants had acquired reputation in putting up a beverage of a certain color, in certain kind of bottles, with certain capsules and a label bearing among other words "Limetta" and address of proprietors; the respondent infringed by putting up beverage of similar color, in similar bottles, with similar capsules, with a label of different shape and without address, but with word "Limetta" in similar lettering of gold and red on the label. Held infringement. *Drewry v. Wood*, 127 Fed. R. 887.

An imitation of packages, labels, and manner of dressing goods will be restrained where party has combined these things so as to invade plaintiff's prior right by adoption and in a way calculated to deceive. *Electro Silicon Co. v. Levy*, 59 How. Pr. 469.

Complainant entitled to injunction on ground of unfair trade against respondent who put up its soap in form, color, and imitation of package so like those of complainant as to be easily mistaken; where it is further shown that complainant, under its style of dressing goods had acquired great reputation, and that respondent was not acting in good faith. *Enoch Morgan's Sons Co. v. Whittier-Coburn Co.*, 118 Fed. R. 657.

Defendant restrained from dressing up a soap called "saphia," and selling it in blue packages resembling those enclosing "sapolio."

"I do intend that he shall abstain from dressing his goods in wrappers so closely resembling the plaintiff's as to enable him to deceive the public and perpetrate a fraud." *Enoch Morgan's Sons Co. v. Schwacher*, 55 How. Pr. 37.

"Probably no mere form of a package would ever alone amount to a representation capable of indicating that the wares contained in it were those of any particular make. But when the form of the packages, the color of the wrappers, and the papers done up with them and the form and color of the labels are considered all together, it is quite apparent that when they have been so long used by the orator's firm for holding this particular compound when offered for sale, the mere appearance of the package would amount to a representation that they contained that article of manufacture." Cylindrical packages with pink wrappers (yellow and crimson papers inside) with white label embossed with

words "Hamburg Hoppensack Co." on tea, protected. *Frese v. Bachof*, 14 Blatchf. 432; 13 O. G. 635.

Injunction granted to restrain a party from making and sending to Turkey watches having the plaintiff's name and customary marks which had become known in Turkey, and word "Jessen-dede" in Turkish characters, in imitation of plaintiff's watches. *Gout v. Aleploglu*, 6 Beav. 69.

Respondent enjoined from imitating labels, capsules, and bands on bottles of whiskey resembling those of complainant sold as "Canadian Club Whiskey." *Hiram Walker & Sons, Ltd., v. Hockstaeder*, 85 Fed. R. 776.

Respondent enjoined from imitating labels, bands, capsules, of complainant and using "Canadian Rye Whiskey," in imitation of "Canadian Club Whiskey." Respondent's whiskey not made in Canada. *Hiram Walker & Sons, Ltd., v. Mikolas*, 79 Fed. R. 955.

A bottle of dark glass, four equal rectangular sides with an engraved label on one side with certain printing and design, infringed by similar bottles and labels and printing. Many of the respondent's bottles were those of complainant with name Hostetter blown in them, "Hostetter's Celebrated Stomach Bitters" not trade-mark, but protection extended to bottles and labels. *Hostetter v. Adams*, 20 Blatchf. 326; 10 Fed. R. 838.

"But the size of the labels and the devices, the appearance, the directions for the use, the size and shape of the bottles, mode of packing, etc., were in exact imitation of the plaintiff's, and the boxes or cases intended for sale were marked 'Dr. Hostetter's Bitters,' the same as the genuine." *Hostetter v. Vowinkle*, 1 Dill. 329.

"Johnson's Anodyne Liniment," put up by defendant in bottles bearing same name, and in imitation of bottles and wrappers, held infringement. Name alone not passed on. *Jennings v. Johnson*, 37 Fed. R. 364.

Wrappers of stove polish, of blue paper with black ink used for a number of years, and under which party has built up a business, protected. *Dixon Crucible Co. v. Benham*, 4 Fed. R. 527.

Edouard Pinaud had long been in the perfumery business in Paris, France, and achieved a great reputation. His business and trade-marks had passed to complainant, who carried it on and manufactured two preparations, known as "Extract Végétal" and "Eau de Quinine." Respondent was formerly in his employ, but on leaving began to put up similar goods, similarly labelled,

and with French words so designed as to lead one to believe that they were the product of the French firm, although they were made in New York. Unfair trade, and injunction. *Klotz v. Hecht*, 73 Fed. R. 822.

Complainant and predecessors had for many years bottled and sold mineral waters from Germany, which it had put up in green bottles with blue labels of distinctive characteristics, and the water became known as "Blue Label Mineral Water." Defendant adopted and used for its mineral water bottles and labels of same shape, size, and color, but bearing thereon different words. Held, that while there were differences, yet the general effect was such as to deceive, and injunction should issue. *Kronthal Waters v. Becker*, 137 Fed. R. 649.

A firm put pills into wooden boxes of uniform size, shape, and appearance, each box containing twenty-two pills, with the name of the original invention stamped in red wax on the cover of each box, around which they placed the red label or wrapper. That label, with its devices and the red seal on the box, constituted a trade-mark.

A party is entitled to all advantages of celebrity which he has gained in manufacture.

When, therefore, a party has been in the habit of stamping his goods with a particular mark or brand, so that the purchasers of the goods having that mark or brand know by them to be of his manufacture, no other manufacturer has a right to adopt the same stamp, because, by so doing, he would be substantially representing the goods to be the manufacture of the person who first adopted the stamp, and so would, or might, be depriving him of the profit he might make by the sale of the goods which the purchaser intended to buy.

It is not necessary that a specific trade-mark be infringed, but that the court is satisfied that there is an intent to deceitfully palm off goods as those of another. *McLean v. Fleming*, 96 U. S. 245.

Plaintiff prepared smoking tobacco as "Mrs. G. B. Miller & Co.'s Best Smoking Tobacco"; defendant prepared tobacco as "The Mrs. C. B. Müller & Co.'s Best Smoking Tobacco, 437½ Grove Street, Jersey City," in packages of same size, shape, and color, stamped as aforesaid. It was a fraud; demurrer to declaration overruled. *Miller Tobacco Manufactory v. Commerce*, 16 N. J. L. 18.

"A champagne bottle, for instance, is a thing long and well

known by the public, and any person, under ordinary circumstances, may lawfully use the same in putting up any preparation therein. But when a manufacturer of a hitherto unknown fluid or beverage, as an article of commerce, has a trade-mark therefor, and introduces such article of commerce to the public in a champagne bottle, with a particular kind of label or trade-mark affixed thereto, and the public becomes acquainted with it and recognizes it in that form and style, and thereafter another party or manufacturer, finding such article to be in great demand, introduces an article of like taste, color, and appearance, claiming to be for similar use or purpose, and with a label sufficiently like the former, and of a character calculated to mislead the public, why, then in such case I think that he might be and ought to be enjoined from embarrassing his neighbor and misleading the public by using a champagne bottle in putting up his preparation similar in taste, flavor and appearance and with similar designation of use or quality of article." *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. R. 205, 213.

Preliminary injunction against use of labels, bottles, and wrappers resembling those of complainant, and marked "Nerve Food" in imitation of "Moxie Nerve Food." The exclusive right to "Nerve Food" alone not passed upon. *Moxie Nerve Food Co. v. Beach*, 33 Fed. R. 248.

"The shape and color of the bottle, the shield, and the general appearance of the label, are well and designedly adapted to deceive the ordinary purchaser, in the ordinary course of purchasing the article in a small quantity for immediate use." *Myers v. Theller*, 38 Fed. R. 607, 610.

A., a manufacturer, put up awls in a distinctive package consisting of a bronze-colored box having a brown label on the top, and on one side printed inscriptions, and tied with an orange string. Ten years after A. began the use of this package, which use, though small at first, increased largely the last two years, B., a manufacturer of awls, began to use a box indistinguishable in every particular, even to the words of the inscription, and the size and shape of type; except that at the bottom, in letters and arrangement as nearly like A.'s as possible, instead of "Manufactured & Warranted by New England Awl & Needle Co., West Medway, Mass.," the label read, "Manufactured for United States Awl & Needle Co., New York." Held, A. could maintain bill to restrain B. And this, although the judge below found that defendant did not intend to deceive, for an inspection of

the boxes makes it plain that the public would not distinguish them. *N. E. Aul & Needle Co. v. Marlborough Aul & Needle Co.*, 168 Mass. 154.

Respondent on appeal enjoined from using a red label with clipped corners, bearing on the face in white two circles with intersecting lines, and words "Factory Seal," substantially like label of complainant, of same shade of red, clipped corners, bearing an ellipse with intersecting lines and words "In-er Seal" in white, used on cracker boxes of same size. *Ohio Baking Co. v. Natl. Biscuit Co.*, 127 Fed. R. 116; affirming 127 Fed. R. 160.

Style of putting up bluing in a cylindrical box with a cover to be perforated, with labels of a certain arrangement of words and style of printing, so copied by respondent as to deceive the public; injunction issued, although there was no trade-mark, on ground of unfair trade. *Sawyer v. Horn*, 1 Fed. R. 24.

Plaintiff had acquired reputation for his bluing sold in bottles with a bright metallic cap of tin, extending down over about one-half of the rim at the mouth of the bottle, the cap having six perforations; held, that the defendant should be enjoined by preliminary injunction from using a bright metallic top on a bottle of the same shape and appearance as that used by complainant. *Sawyer Crystal Blue Co. v. Hubbard*, 32 Fed. R. 388.

Complainants had for many years manufactured drawers with elastic seams, stamped "Scriven's Elastic Seam" and number "50," and they had become so known. Respondents manufactured similar drawers, designated "Standard Stretchy Seam," and marked "50," and advertised as "Elastic Seam Drawers." Held, that such facts showed deliberate intention to deceive, and justified injunction. *Scriven v. North*, 134 Fed. R. 366; modifying 124 Fed. R. 894.

Bottles of ink with label in white capital letters of large type, "Stephen's Blue Black," infringed by similar bottles bearing labels in similar type of "Steelpens Blue Black." *Stephens v. Peck*, 16 L. T. N. S. 145.

Injunction against use by defendant of form and color of tablets and shape of box, style of label, and use of words "Candy Cathartic," so nearly like dress of complainant's goods that it was a fraud. Defendant under decree would have to judge for itself how near he could go to the line. *Sterling Remedy Co. v. Spermic Medical Co.*, 112 Fed. Rep. 1000.

Complainants in England manufactured thread and sold it in United States as "Taylor's Persian Thread." Defendants sold

thread prepared in exact imitation, put on similar spools and so colored, stamped, and labelled as to resemble them exactly, or as nearly as could be done. Injunction. *Taylor v. Carpenter*, 2 Sandf. 603.

(1) A combination of well-known elements of color, size, shape, lettering, words, etc., each one of which may be old, adopted and used by a party and under which he has gained a reputation may be protected as a combination in cases of fraud.

See VIII. 1 E. 172. *Hildreth* and *Fairbank* cases.

See VIII. 1 F. 173.

“True, some of the elements may have been old, but it is not required that the separate details must have been original with the complainant seeking relief from infringement. The question is whether the adoption of the collocated features of the complainant’s card and style of dress disclosed a differentiation from that previously adopted, and by which the public has come to recognize the product of the complainant.” *De Long Hook & Eye Co. v. Francis Hook & Eye Fastener Co.*, 139 Fed. R. 146, 149.

Others before the plaintiff had made molasses candy of the same size and shape, and wrapped the pieces in the same kind and size of paper, with twisted ends. But the plaintiff to this old combination added printed words “Velvet,” in red script in middle and on ends of wrappers. The defendant company adopted the old combination and added in Roman type in red ink on middle of wrapper, but not on ends, the word “McDonald.” As a fact the public was deceived. An injunction was properly issued restraining the defendant from printing in red letters upon yellow wrappers for candy of substantially the same size and shape the name “McDonald” or any other word likely to deceive. *Hildreth v. D. S. McDonald Co.*, 164 Mass. 16.

Complainant had for two or three years put up yellow washing powder in yellow packages marked “Gold Dust,” and “Washing Powder” with certain indicia, and at great expense built up considerable business. Defendant then changed its style of goods and put up a yellow washing powder in packages of same size, shape, and color with similar indicia, marked “Buffalo Soap Powder,” with address of manufacturer. Held that the combination was such that injunction should issue against putting up and selling or offering for sale “the particular form of package which has been referred to in the bill and put in evidence as ‘Defendant’s Second Package,’ or any other form of package

which shall, by reason of the collocation of size, shape, colors, lettering, spacing, and ornamentation, present a general appearance as closely resembling the 'Complainant's Package' referred to in the bill and marked in evidence, as does the said 'Defendant's Second Package.'" To which should be added, "This injunction shall not be construed as restraining defendant from selling packages of the size, weight, and shape of complainant's package, nor from using the designation 'Buffalo Soap Powder,' nor from making a powder having the appearance of complainant's 'Gold Dust,' nor from using paper of a yellow color as wrappers for its packages, provided such packages are so differentiated in general appearance from said 'Complainant's Package' that they are not calculated to deceive the ordinary purchaser." *N. K. Fairbank Co. v. R. W. Bell Mfg. Co.* 77 Fed. R. 869.

G. A label or advertisement.

See XI. 1, 239, 2, 242, 4 A. 245.

Injunction granted against infringement of label in distinguishing features on ground that it was a trade-mark; but not against letters "A C A" on ground that they were descriptive, although for many years of a known and recognized reputation. *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C. 599.

NOTE — This case might have been decided on the principles of unfair trade.

A distinctive label for beer used for two years and during that time having acquired a reputation, consisting of a diagonal red band with the name of beer in white letters on band, protected by preliminary injunction. *Anheuser-Busch Brewing Ass'n v. Clarke*, 26 Fed. R. 410.

A court of equity will enjoin unlawful competition in trade by means of labels of peculiar design or colors, or packages of distinctive shapes, intended to enable the defendant to pass his goods off as those of the plaintiff. *Brown Chemical Co. v. Stearns*, 37 Fed. R. 360.

Labels of "Wolfe Aromatic Schiedam Schnapps," although not trade-marks imitated as to size, color, and words protected. *Burke v. Cassin*, 45 Calif. 467.

"A label is not a trade-mark, as recognized at common law, though it may, in fact, contain no words, figures, etc., except those which constitute the trade-mark. On principle, a person

is as fully entitled to be protected in the use of his label as his trade-mark, and the authorities fully sustain this position." *Burke v. Cassin*, 45 Cal. 467.

Labels with letters "CB" and words "A Broder à la Croix," on cross cotton protected against similar labels. *Cartier v. Carlile*, 8 Jur. N. S. 183.

Label on "Cauffman's Ginger Brandy," imitated in size, shape, color, and printed matter by that of respondent, although there were some differences and the word "Imperial" was substituted for "Cauffman," protected by injunction. *Cauffman v. Schuler*, 123 Fed. R. 205.

"It is truly said, that if any one takes upon himself to study these two labels, he will find several marks of distinction. On the other hand, the colors are of the same nature, the labels are exactly of the same size, the letters are arranged precisely in the same mode, and the very same name appears on the face of the jars or bottles in which the blacking is put. It appears therefore to me that there is quite sufficient to mislead the ordinary run of persons." *Croft v. Day*, 7 Beav. 84.

Respondent enjoined the second time from simulation of label for cigars. *Cuervo v. Owl Cigar Co.*, 68 Fed. R. 541.

Where a person has no exclusive right in a trade-mark he may be entitled to protection in a label where another label is so like his as to mislead the public. *Davis v. Kendall*, 2 R. I. 566.

"The wrappers and label, and the arrangement of the printed characters, and the language of the wrappers and labels, have become a well-known trade-mark." *Dixon Crucible Co. v. Benham*, 4 Fed. R. 527.

The defendant was restrained from using a label for washing powder similar to that of the plaintiff, embodying plaintiff's trade-mark and other features. *Falkinburg v. Lucy*, 35 Calif. 52.

A label for medicine with name and address of proprietor, name of medicine, and the letter B nine times repeated in three vertical columns may be protected, where its imitation would be likely to deceive the public. *Foster v. Blood Balm Co.*, 77 Ga. 216.

Plaintiff made pens on whose boxes he affixed labels showing that he was the manufacturer, and on first quality label he had "303"; on second quality "753"; defendant removed from boxes "753" label and put on one closely resembling "303" label with that number. Held fraud; injunction issued. *Gillott v. Kettle*, 3 Duer, 624.

Labels on an article used for making "Julienne" soup, fancy in style, protected as trade-marks; device consisted of words "conserves alimentaires" under which was coat of arms of city of Paris, upon either side monogram "A. G." in a circle, and underneath words "Paris," "Julienne." *Godillot v. Hazard*, 81 N. Y. 263.

Labels bearing name of Hennessy on French brandy protected. *Hennessy v. Wilmerding-Loewe Co.* 103 Fed. R. 90.

Real estate auctioneer using an advertising flag with stars on upper and lower border entitled to injunction against another auctioneer using a similar flag in the same locality. *Johnson v. Hitchcock*, 3 N. Y. Supp. 680.

Complainant entitled to temporary injunction where it appeared that it had at great expense acquired a reputation for drawing-paper and materials which sold in labels, which labels the respondent had simulated by labels almost identical in size, shape, coloring, and lettering, so that mind of purchaser would be readily deceived. *Keuffel & Esser Co. v. H. S. Crocker Co.*, 118 Fed. R. 187.

Injunction against use of label on beer almost identical in general appearance with that of complainant, with same colors and same arrangement of letters, scrolls, and landscape. While there are differences the resemblances are such that the consumer is likely to be misled. *Kostering v. Seattle Brewing & Malting Co.*, 116 Fed. R. 620.

"An injunction, *pendente lite*, will issue, restraining the defendant from placing on the bags used by him in putting his peas on the market a label or inscription resembling in design, form, and arrangement, or collocation of identical words, the label or inscription of the complainants, as does the label now used by the defendant."

Defendant's label was a palpable imitation of complainant's, in color of ink, arrangement of words, and in general style. *Landreth v. Landreth*, 22 Fed. R. 41.

Although names "Disque," and "Pile-Leclanche," on patented electric batteries were descriptive and not protected as trade-marks, complainant was protected from simulation of labels. *Leclanche Battery Co. v. Western Electric Co.*, 23 Fed. R. 276.

Complainant sold Liebig's Extract of Meat in two-ounce jars, with wrapper, neck label, and metallic capsule. Label had printed "Liebig's Extract of Meat" and facsimile signature of

“J. V. Liebig.” Defendant enjoined from using a label like complainant’s in color and general appearance and bearing words “Liebig’s Fluid Beef Co.,” which were fictitious. But “Liebig” had become generic and its use would not be enjoined. *Liebig’s Extract of Meat Co. v. Walker*, 115 Fed. R. 822.

Infringement of label, imitating the plaintiff’s and using same type, with word “Bovina” instead of “Boviline.” Injunction. *Lockwood v. Bostwick*, 2 Daly, 521.

A blue wrapper pasted around a small bottle of bluing containing in separate compartments various inscriptions in letters of silver and bronze, infringed by label of same size, color, type, and same general appearance; injunction on ground of unfair trade. *Sawyer v. Kellogg*, 7 Fed. R. 720.

A statement on a label of prepared chicory root that it is from the factory of “E. B. Muller & Co., in Rouleus (Belgium)” when only the raw chicory root is from Belgium, and it is prepared in New York, is false, and on that ground, as well as on account of similarity of labels, an injunction will issue. *Scheuer v. Muller*, 74 Fed. R. 225.

Defendants enjoined from using numerals “830” to designate mottled drab hose not made by complainant, and from using on their labels the word “Seamless” printed in script, with the flourish underneath in imitation of the word “Seamless” as used by complainant. *Shaw Stocking Co. v. Muck*, 21 Blatchf. 1; 12 Fed. R. 707.

Preliminary injunction granted against use of labels on needles so like those of complainant as to be likely to deceive. *Walton v. Crowley*, 3 Blatchf. 440.

“Without deciding whether the defendant may or may not use either of the words ‘Genuine’ or ‘Yankee,’ in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or handbills which he is using, nor any other like labels, devices, or handbills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap.” *Williams v. Johnson*, 2 Bosw. 1.

“They are of exactly the same size, their colors throughout are the same, the words descriptive of the goods are the same, and they are arranged in precisely the same manner, printed with letters of the same form and size, and in ink of the same colors.” *Wirtz v. Eagle Bottling Co.*, 50 N. J. Eq. 164.

2. A sign, to be protected on the ground of unfair trade, must have first acquired a reputation, and have been imitated with fraudulent intent.

See XV. 3 B. 306. *N. K. Fairbank Co. v. Windsor*, 124 Fed. R. 200.

“But, while the idea of fraud or imposition lies at the foundation of the law of technical trade-marks as well as the law of unfair competition, it must be borne in mind that fraud may rest in actual intent shown by the evidence, or may be inferred from the circumstances, or may be conclusively presumed from the act itself. In the case of unfair competition, the fraudulent intent must be shown by the evidence, or be inferable from the circumstances, while, in the case of the use by one trader of the trade-mark or trade-symbol of a rival trader, fraud will be presumed from its wrongful use. It is commonly said that there is a right of property in a technical trade-mark, and an infringement of it is spoken of as a violation of a property right. Whether this view be correct or not is quite immaterial, because it is universally agreed that some of the rights which are incident to property do inhere in a technical trade-mark. The cases all agree that no one has a right to use another’s trade-mark in connection with similar goods; and if he does so use it, and persists therein after being requested to desist, the fraud and imposition which constitute the essence of the injury will be presumed to exist, and relief will be granted without further proof.” *Church & Dwight Co. v. Russ*, 99 Fed. R. 276, 279.

“If the plaintiffs had been the first and only ones to make use of this label, another person seizing upon and appropriating a black and gold label of the same size, and for the same purpose, might be held guilty of infringement, when, if the plaintiffs had no exclusive right thereto, and defendants had done only what others had done before, they would not be considered.” *Couts v. Merrick Thread Co.*, 149 U. S. 562-569; affirming 36 Fed. R. 324.

Where party did not have trade-mark he is not entitled to claim protection for the manner of dressing his goods till he has shown that he has first acquired a reputation under that dressing. *Colgan v. Danheiser*, 35 Fed. R. 150.

Where words “standard” and “computing,” descriptive marks, have not acquired a secondary meaning designating scales of

complainant, court will not enjoin their use by another. *Computing Scale Co. v. Standard Computing Scale Co.*, 118 Fed. R. 965.

“It has long been settled that in cases of unfair competition the action is based upon deception, unfairness, and fraud, and that this fraud should be generally proved, and not left to inferential evidence alone. This rule is far more strictly followed in cases of unfair competition than in cases involving a technical trade-mark, where fraud will be presumed from the wrongful use of the trade-mark, without regard to the intent. The United States courts have repeatedly held the intent to deceive the public an indispensable element in the fraud charged in unfair competition, and that ‘this intent and the fraud in which it inheres may be, and generally must be, proved, by circumstances, by facts, by sales, by a course of action.’” *Daviess County Distilling Co. v. Martinoni*, 117 Fed. R. 186, 188.

“Undoubtedly courts of equity have granted injunctions to restrain the fraudulent use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any exclusive right of the plaintiffs.” *Farnum, ex parte*, 18 O. G. 412.

“Where the ground for relief by injunction is fraud, it is necessary that the fraud should be made to appear by positive averments, founded on complainant’s own knowledge, or that of some person cognizant of the facts. It is a general rule that whatever is essential to the rights of the complainant, and is necessarily within his knowledge, ought to be alleged positively and with precision.” *Gaines & Co. v. Sproufe*, 117 Fed. R. 965, 967.

“Relief in such cases is granted only where the defendant by his marks, signs, labels, or in other ways, represents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacturer, to the injury of the plaintiff.” *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598, 604.

“To justify a court of equity in interfering in an alleged case of unfair competition, there must be something more than the mere duplication by the one party of the other’s trade-name, and that this was to be found in the deceptive use of imitative methods of display, or other device by which the public are led into buying the infringer’s goods when they intended to buy those of the original producer; the fraud so perpetrated being a

legitimate ground for equitable interference and the practical basis of it." Diamond-shaped label of "Liquorice Pastilles" marked "H. H." not infringed. *Heide v. Wallace*, 129 Fed. R. 649, 650.

"The action is based upon deception, unfairness, and fraud, and when these are established the court should not hesitate to act. Fraud should be clearly proved; it should not be inferred from remote and trivial similarities. Judicial paternalism should be avoided; there should be no officious meddling by the court with the petty details of trade; but, on the other hand, its process should be promptly used to prevent an honest business from being destroyed or invaded by dishonest means." *Hilson Co. v. Foster*, 80 Fed. R. 896, 897.

"It seems, however, to be contended that plaintiff was entitled at least to an injunction, upon the principles applicable to cases analogous to trade-mark, that is to say, on the ground of fraud on the public, and on the plaintiff, perpetrated by defendant by intentionally and fraudulently selling its goods as those of the plaintiff. Undoubtedly an unfair and fraudulent competition against the business of the plaintiff—conduct with intent, on the part of the defendant, to avail itself of the reputation of the plaintiff to palm off its goods as plaintiff's—would, in a proper case, constitute ground for relief." *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537, 549.

"Not until a feature had been used long enough to be known as a mark of the orator's machines, could the employment of it by others be a representation that their machines were the orator's." *Wilcox & Gibbs Sewing Mach. Co. v. The Gibbens Frame*, 17 Fed. R. 623, 624.

A. But imitation of distinguishing features beyond the probability of chance, or with full knowledge of the imitation, will be good evidence of fraud.

"Nothing is shown by the affidavits to repel the suspicion which naturally arises that the subsequent adoption of such a very similar label by one of the two rivals in the same city could not be accidental, but must have been for the purpose of confusion." *Anheuser-Busch Brewing Ass'n v. Clarke*, 26 Fed. R. 410.

Where respondent must have known of the high reputation and standing of the ploughs marked "Bissell" and the value of

the name, its assumption by it, to the loss and detriment of the complainant, will be enjoined on the ground of unfair trade. *Bissell Chilled Plow Works v. T. M. Bissell Plow Co.*, 121 Fed. R. 357.

“The presumption of a designed imitation, arising from the similarity of the spoons, the resemblance of the labels, and the identity of the numbers, would be very strong if all these circumstances were found to exist in reference to only one kind; but when the case finds, as it does, that they do exist in respect to several different kinds, the presumption is vastly strengthened.” *Boardman v. Meriden Britannia Co.*, 35 Conn. 402, 417.

“It will readily be seen upon a comparison of the labels of the plaintiff with those of the defendants, that they are in many respects different, but in other respects there is a marked-resemblance. The similarity could not have been accidental. The design on the part of the defendants to imitate the plaintiff's labels is unmistakable. The labels are nearly of the same dimensions, the paper and ink are respectively of the same colors.” *Burke v. Cassin*, 45 Calif. 467, 480.

“Nor do these courts require specific proof of purchases by individuals actually deceived, when the labels themselves show an attempt at deception which appears to be well calculated to deceive. . . . Inspection of the labels must carry conviction to any unbiased and intelligent mind that the later label was prepared by someone who had seen the earlier one, and that it was designed, not to differentiate the goods to which it was affixed, but to simulate a resemblance to complainant's goods sufficiently strong to mislead the consumer, although containing variations sufficient to argue about should the designer be brought into court. This is the usual artifice of the unfair trader.” *Collinsplatt v. Finlayson*, 88 Fed. R. 693.

Imitation evidence of fraud.

In the present case it appeared that the respondent had deliberately adopted in a number of instances the same style of boxes, manner of marking and lettering, even to the arbitrary numbers in use by the complainant, in fact had even gone so far as to imitate the system of the complainant.

“It is in the highest degree unreasonable to assume that after the complainant had adopted the numbers ‘223,’ ‘2004,’ ‘209,’ and ‘201,’ in connection with certain trade-dress for certain sizes and styles of labels to which they were applied, the defend-

ant's use of the same numbers and in connection with the same sizes and styles of labels, was an accidental coincidence." *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651, 664.

"Accidental coincidence is out of the question so far as the numbers, the names, and the sizes on these samples, in their sequence are concerned. In these particulars the defendant's samples are manifestly a studied imitation of those of the complainant." *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651, 666.

"In the present case the evidence shows that the goods of the defendant have been mistaken by purchasers for those of the complainant, probably by the design of the dealer. And, though there is no evidence connecting such dishonest dealing with the defendant in any way, the fact that it so dresses its goods as to give an easy opportunity to the unscrupulous dealer to delude the consuming purchaser is very persuasive evidence that an intention existed to enter into competition with the manufacturer whose goods were already well established, and to carry on such competition in a manner which courts of equity hold to be unfair." *Enoch Morgan's Sons Co. v. Whittier-Coburn Co.*, 118 Fed. R. 657, 661.

"It is elementary law that, when the simulation of well-known and distinctive features is so close, the court will assume that the defendant intended the result they have accomplished, and will find an intent to appropriate the trade of their competitor, even though in their instructions to their own selling agents they may caution against oral misrepresentations as to the manufacture of the goods." *Enterprise Mfg. Co. v. Landers*, 131 Fed. R. 240, 241.

"Without rejecting the evidence of my senses, I cannot doubt that the label or trade-mark which the defendants admit that they propose to use, from its general resemblance to that of the plaintiff and his firm, is well calculated to mislead the public, by inducing the belief that the articles to which it is affixed are in reality prepared or manufactured by the plaintiff's firm. Nor can I doubt that the label was framed with this design, since the imitation is so close, minute, and exact, as in my opinion to exclude the supposition of any other motive." *Fetridge v. Wells*, 4 Abb. Pr. 144, 145.

"The intention of the defendant to imitate the plaintiff's label and the success of his effort is apparent. . . . In purchasing articles of so common use as bread, labels are not expected to be

critically examined, and persons who cannot read, as well as those who do, are obliged to buy." *Fleischman v. Schuckmann*, 62 How. Pr. 92.

"It was not necessary for the complainant to attempt to discover whether a purchaser had been actually deceived, for a manifest liability to deception exists. Although the intent of the defendant's principal when it commenced to use the name 'Health Food' may have been innocent, the continuance, after it had learned of the complainant's prior use, indicates its deliberate intention to use the name without reference to the complainant's possible prior rights." *Fuller v. Huff*, 104 Fed. R. 141, 145.

Where packages are so similar that the court cannot escape the conviction that infringement was intended, and it is highly improbable that there was no design, an affidavit that no imitation was intended will not avail on motion for preliminary injunction. *Hansen v. Siegel-Cooper*, 106 Fed. R. 691.

"It is plain that it is a copy from the plaintiff's by design. Variations are made of such a character as to be capable of discernment and description. But the general effect to the eye of an ordinary person, acquainted with the plaintiff's bottle and label, and never having seen the defendant's label and not expecting to see it, must be, on seeing the defendant's, to be misled into thinking it what he has known as the plaintiff's. The size, color, and shape of the bottle . . . the general effect of the horse and his rider . . . give an affirmative resemblance calculated to deceive an ordinary observer and purchaser, having no cause to use more than ordinary caution, and make him believe he has before him the same thing which he has before seen on the plaintiff's bottle and expects to find on the bottle he is looking at. The differences which he would see, on having his attention called to them, are not of such a character as to overcome the resemblances to the eye of a person expecting to see only the plaintiff's bottle and label, and having no knowledge of another." *Hostetter v. Adams*, 10 Fed. R. 838, 842.

"It is difficult to believe that there was no intention to deceive in this case, although the defendant swears that adopting the same numbers which Humphrey has used was purely accidental. . . . The defendant has printed his list with the same diseases or complaints designated by precisely the same numbers. If this was accidental and not intentional, it is one of the most remarkable coincidences that has occurred, and is a serious tax upon

human credulity." *Humphrey's Homeopathic Med. Co. v. Wenz*, 14 Fed. R. 250, 254.

Complainant had for several years used on granite, iron, and steel ware a rectangular label of a certain size printed in dark blue on light blue paper. Respondent after having for many years used a different label, suddenly changed to use of one like that of the complainant; held to justify inference of fraud and preliminary injunction issued. *Lalace & Grosjean Mfg. Co. v. Natl. Enameling & Stamping Co.*, 109 Fed. R. 317.

"It is difficult to understand how any intelligent and unprejudiced mind can contemplate these contrasted exhibits, and reach any other conclusion than that the change was made with the intention of suggesting complainant's label to the retail purchaser. No amount of affidavits made by interested parties would be persuasive to the contrary. No necessity for any change at all is suggested, and, change being once decided on, it was so easy to make a change which would preserve the old lozenge, and still tend to differentiate between complainant's and defendant's goods, that a contrary course must be assumed to be designed to accomplish its natural result." *Lalace & Grosjean Mfg. Co. v. Natl. Enameling & Stamping Co.*, 109 Fed. R. 317, 318.

Although letters "L. L." on cotton goods were descriptive, yet they would be protected in case of fraudulent imitation. "But the deceitful representation or perfidious dealing must be made out or be clearly inferable from the circumstances." In this case there was not considered to be a fraudulent imitation. *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 31 Fed. R. 776.

"The color of the paper, the words used, and the general appearance of the labels when used, show an evident design to give a representation of those used by the plaintiff, and the directions for using are an exact copy of those used by the plaintiff." *Lea v. Wolf*, 13 Abb. Pr. n. s. 389; 15 Abb. Pr. n. s. 1; 46 How. Pr. 157.

"The plaintiff in error submits that, in order to maintain this suit, it is necessary to show that it knew of the existence of a trade-mark, that it intended to palm off its goods as those of the Russia Cement Company, and that the public was deceived thereby. This might be true if the only case shown by the proofs was that of an actual purpose to mislead the public to the injury of the Russia Cement Company; but, as we place the case on the proposition that, under the circumstances, the use of the words 'Manufactured by The Le Page Company,' in connec-

tion with the word 'glue,' is necessarily a wrongful injury to the Russia Cement Company, which ought to have been foreseen by Le Page and the Le Page Company, we have not deemed it necessary to go into the controverted question of actual fraudulent intent or artifice, or to weigh the evidence on that point. Positive proof of fraudulent intent is not required where the proof of infringement is clear, as the liability of the infringer arises from the fact that he is enabled to sell a simulated article as and for the one which is genuine." *Le Page Co. v. Russia Cement Co.*, 51 Fed. R. 941.

"Nor is it necessary, in order to give a right to an injunction that a specific trade-mark should be infringed; but it is sufficient that the court is satisfied that there was an intent on the part of the respondent to palm off his goods as the goods of the complainant, and that he persists in so doing after being requested to desist." *Mc Lean v. Fleming*, 96 U. S. 245, 254.

"Positive proof of fraudulent intent is not required where the infringement is clear, as the liability of the infringer arises from the fact that he is enabled, through the unwarranted use of the trade-mark to sell a simulated article as and for that which is genuine." (Although word "trade-mark" is used it is a case of unfair trade.) *Mc Lean v. Fleming*, 96 U. S. 245, 253.

"There are also, as is usual, a number of minor differences between the form and the dress of the two packages, which are expatiated upon in the affidavits and the brief; but no one can look at both packages without perceiving that there are strong resemblances, which could easily have been avoided had there been an honest effort to give defendant's goods a distinctive dress." *National Biscuit Co. v. Baker*, 95 Fed. R. 135.

"They had the right to use the background used by the complainant; they had the right to use clipped corners and the word 'Seal'; they had the right to use any color that the complainant used for cartons; and they had the right to use packages of the size used by the complainant. But when they used all these things in combination, the object is too apparent to admit of argument." *National Biscuit Co. v. Ohio Baking Co.*, 127 Fed. R. 160, 161.

Where an inspection of boxes and styles of wrapping make it plain that the public would not be likely to distinguish between them, court will not be bound by a decision of lower court that defendant did not intend to deceive. *N. E. Awl & Needle Co. v. Marlborough Awl & Needle Co.*, 168 Mass. 154.

"The law is well settled that in suits of this character the intention of the respondent in adopting the style of package or choosing a name for a similar product is to a certain extent immaterial. It is not essential to right of complainant to injunction to show absolute fraud or wilful intent on the part of the respondent. Upon familiar principles, it will be presumed that the respondent contemplates the natural consequences of its own acts." *N. K. Fairbank Co. v. Luckel, King, & Cake Soap Co.*, 102 Fed. R. 327, 330.

"When there are found strong resemblances, the natural inquiry for the court is, why do they exist? If no sufficient answer appears, the inference is that they exist for the purpose of misleading." *Paris Medicine Co. v. W. H. Hill Co.*, 102 Fed. R. 148, 151.

"That the defendant's label is a designed imitation of the complainant's scarcely admits of a doubt. Such perfect similarity could hardly have been the result of chance. We do not mean to say that it would be a justification if it were accidental. But it is apparent that it was designed." *Sawyer v. Kellogg*, 7 Fed. R. 720, 721.

"The respondent, in his answer and in his testimony, avers that he had no intention of infringing on the rights of the complainant. He has taken the testimony of a number of witnesses to prove his high character as a citizen and business man. In the argument great stress is laid upon this testimony by respondent's counsel, as negating the idea of a fraudulent purpose on the part of the respondent in dressing up his goods in imitation of the complainant's. The court cannot give to this evidence the weight to which counsel insist it is entitled. It must in this case, as in every case where intent is the subject of investigation, deduce the intent from the acts of the respondent. These constitute the proof as to the purpose of the respondent, and by them the court must be guided." *Walter Baker & Co. v. Baker*, 77 Fed. R. 181, 184.

"The methodical imitation of the wrappers and style of labels appear to be intentional, and not accidental." *Wellman & Divire Tobacco Co. v. Ware Tobacco Works*, 46 Fed. R. 289.

"The law, in civil cases, does not attempt to penetrate the secret motive which induced the act brought in judgment, but judges of its legal quality solely by the consequences which have naturally and necessarily proceeded from it. It is no less a dictate of justice than of sound reason that every person must be

understood to have intended to do just what is the natural consequence of his act deliberately done. The aggrieved person, in cases of this class, is not required to show intentional fraud, but he makes a sufficient case to give him a right to protection when he shows that the defendant is using his label, or one so nearly like it as to render deception of the public and injury to himself probable." *Wirtz v. Eagle Bottling Co.*, 50 N. J. Eq. 164, 167.

3. The substitution on goods of different grades of the same origin, of signs, labels, or styles of dressing goods adopted by a proprietor, is a fraud enjoined on the ground of unfair trade.

See VIII. 1 G. 182. *Gillott v. Kettle*, 3 Duer, 624.

"If a brandy different from that which the manufacturer bottled is put into bottles and sold as the manufacturer's bottled brandy, the fact that it is the manufacturer's bulk brandy does not make the sale less an imposition." *Hennessy v. White*, 6 W. W. & A'B. Eq. 216, 221.

"It is manifest that the sale of merchandise in bulk by a manufacturer does not justify the vendee in using on his retail packages the label which the manufacturer uses upon the same merchandise only when prepared by himself on smaller packages for the retail trade." *Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. R. 585, 592.

Complainant entitled to exclusive use of word "Le Page" on glue, put up two grades, the first called "Le Page's Liquid Glue," the second grade called "Le Page's Fish Head Glue." Respondent purchased a lot of second grade and put it up and labelled it "Le Page's Liquid Glue." Held, a deception which should be enjoined. *Russia Cement Co. v. Katzenstein*, 109 Fed. R. 314.

4. A party re-filling boxes, barrels, or receptacles which have already acquired by familiar use a reputation in the public mind as containing the goods of another, with the intention thereby of diverting trade and deceiving the public, is guilty of unfair trade, and will be enjoined on the ground of fraud.

Defendant had no right to take lime-juice bottles with name of complainant blown in them, fill them with lime juice and resell them. *Evans v. Von Laer*, 32 Fed. R. 153.

Respondent sold bitters closely resembling those of complainant, put up in jugs marked "H. Bitters," and in some instances sold them in Hostetter's bottles. Complainant alone possessed secret of making the bitters. Held to constitute a case of unfair trade. *Hostetter v. Martinoni*, 110 Fed. R. 524.

Complainant has right to injunction against respondent, who refilled his empty whiskey barrels bearing his trade-mark "Golden Wedding." *Pontefecat v. Isenberger*, 106 Fed. R. 499.

"I lay it down as a general rule, that it is not justifiable for a trader to fill bottles, or casks, or anything else bearing a known name, so as to induce the public to believe that the thing contained in those vessels is the production of the man whose name they bear; because by doing that he puts it in the power of the person selling these goods to impose on the public." *Rose v. Loftus*, 47 L. J. Ch. 576; 38 L. T. n. s. 409.

Respondent enjoined from refilling bottles of complainant for gins, of dark glass of distinctive size and shape, having firm's name, address, and monogram blown into the glass. *Van Hoboken v. Mohus*, 112 Fed. R. 528.

5. A fraudulent course of conduct by oral or written misrepresentations tending to injure another in his established business constitutes unfair trade.

Complainant had trade-mark in word "Sapolio," to designate particular kind of soap. Defendant's salesmen, when asked for "Sapolio," would hand out a soap in a different wrapper marked "Pride of the Kitchen." Held to constitute infringement.

"Any act or thing done to induce the belief that the one article is in fact the other is unfair, and indeed unlawful; and this is the true meaning and intent of the acts of the defendant's salesmen complained of. The case falls clearly within the principle that equity should prevent a party from fraudulently availing himself of the trade-mark of another, which has already obtained currency and value in the market, by whatever means he may devise for that purpose. The defendant had no right to represent, by word of mouth or by act, directly or indirectly, that 'Pride of the Kitchen' was 'Sapolio,' and yet this is what the acts of their agents amount to. Such acts should be restrained." *Enoch Morgan's Sons Co. v. Wendover*, 42 Fed. R. 420, 422.

The writing of a single letter threatening suit for infringement of patent is not such an interference with customers as would

of itself constitute unfair trade. *George Frost Co. v. Kora Co.*, 136 Fed. R. 487.

A publication of a garbled letter written to the public by complainant, in which he denied having any business connection with a certain "Life of McKinley," but that he was engaged in writing a new life, in which publication the reference to the new life was omitted, and the public confused according to the plan of the respondent, is unfair trade which the court will enjoin. *Hulstead v. Houston*, 111 Fed. R. 376.

Defendant did not counterfeit labels on bottles, but manufactured an article similar to "Hostetter Bitters," and sold it to customers, advising them to buy "Hostetter Bitters" bottles, refill them, and resell the article as genuine "Hostetter Bitters." "The fact that it has advised its customers to perpetrate a fraud of that description, and that it has furnished them the spurious article, and that some of its customers have probably acted on the suggestion, is sufficient to render them liable to an injunction. *Hostetter Co. v. Brueggeman-Reinert Distilling Co.*, 46 Fed. R. 188.

Respondent manufactured bitters as nearly like Hostetter's as possible in taste and color, the complainants by a secret process having sole right to make these bitters, and did it for the purpose of palming off their bitters as Hostetter's, and it was in evidence that he advised his customers to put them into empty Hostetter bottles. Held, to justify a decree on ground of unfair competition. *Hostetter v. Conron*, 111 Fed. R. 737.

Respondent, by its secretary and treasurer, sold to representative of complainant bitters billed as "Aromatic Bitters," but represented to be "Hostetter Bitters," and at request of representative furnished him with an empty Hostetter bottle. Injunction. *Hostetter Co. v. William Schneider Wholesale Wine and Liquor Co.*, 107 Fed. R. 705.

Respondent reprinted edition of Webster's Dictionary of 1847, on which copyright had expired, advertised that it was the "Famous Reprint Edition," the same as sold previously for \$12 to \$15, then offered for \$1.45, using same form, size, and shape of book as complainant, publishing under copyrighted edition of 1864, with symbol of book and "Webster's Dictionary." Held, that form, size, symbol, "Webster's Dictionary" were not trade-marks, but that the advertisement was such as to deceive people into believing that it was edition of 1864, and should be enjoined. *Merriam v. Famous Shoe & Clothing Co.*, 47 Fed. R. 411.

Respondent reprinted obsolete edition of 1847 Webster's Dictionary, worth about \$2, and stated in advertisements that it was "Latest Edition," hitherto sold for \$10, and offered now for \$8. There was evidence of persons' being deceived. Held, that there was no trade-mark in "Webster's Dictionary," or in form or size of volume, but that the advertisements were calculated to deceive, and that the respondent should be enjoined from such advertisements at the suit of complainant, owner of later copyrighted editions, and that it should insert in the book a statement that it was old edition of 1847. *Merriam v. Texas Siftings Publ. Co.*, 49 Fed. R. 944.

It is unfair trade for a grocer to put up a soap powder called "Buffalo" as and for a superior article well known and recognized as "Gold Dust," which is a valid trade-mark. *N. K. Fairbank Co. v. Dunn*, 126 Fed. R. 227.

Testimony that two parties employed by complainant went to respondent's store, asked for Hostetter Bitters, that he sold them bitters resembling Hostetter's, sold from barrels marked "H. Bitters," and furnished empty Hostetter bottle with the labels, would warrant inference that he was in the business of selling a preparation like Hostetter's for the purpose of its being used with Hostetter bottles and labels, and of palming it off as Hostetter's. The fact that witnesses were not real customers no defence. Injunction. *Samuel Bros. & Co. v. Hostetter Co.*, 118 Fed. R. 257.

After a prior adjudication allowing party right to use of name "F. G. Weber & Co." on packages of tea, the court would enjoin oral representation that the tea is "Weber's Tea," on the ground that it would lead to confusion and be unfair trade. *Weber Medical Tea Co. v. Kirschtein*, 101 Fed. R. 580.

A. But there is no unfair trade unless there is a violation of some contractual right or some course of conduct likely to deceive the public to the injury of another party.

It is not unfair competition for one employed by another in work under a patent to subsequently obtain a patent in an improvement in manufacture of a similar article and engage in manufacture and sale of such article under his own patent. *American Coat Pad Co. of Baltimore City v. Phoenix Pad Co.*, 113 Fed. R. 629.

It is not fraud for a cigar dealer to register as a trade-mark

the word "She" used on labels for cigars sold by printers in New York to cigar dealers throughout the country who are not supposed to be conflicting in trade; but such word cannot become by registration a trade-mark for the registrant, because being on stock labels it lacks originality of application; it may be protected on the ground of unfair trade. *Sartor v. Schuden*, 125 Iowa, 696.

6. A fraudulent imitation of the distinguishing outlines and features of goods which are not structural but ornamental, may constitute unfair trade.

But see: VIII. 1 F. 179. *Scriven v. North*, 124 Fed. R. 894.

Complainant had for many years manufactured stoves and ranges with white enamel on the inside of doors, and these stoves had achieved considerable reputation as "White Enamel." Held, whether the method of using enamel was a trade-mark or not, the respondent should not be allowed fraudulently to use the same means of dressing his stoves. *Buck's Stove & Range Co. v. Kiechle*, 76 Fed. R. 758.

Complaint was that respondent had infringed by use of words "standard" and "computing," and by copying outlines of complainant's scales. Held, that the words were descriptive and not secondary in meaning, and that there were marked mechanical differences in the scales which could not but be noted by one familiar with scales even in slightest degree. Injunction refused. *Computing Scale Co. v. Standard Computing Scale Co.*, 118 Fed. R. 965.

Complainant had for many years made coffee-mills of certain shape, design, and color, and achieved great reputation. Respondent undertook the manufacture of exactly same style of coffee-mills, except in numbers, which were, however, simulated. Held, that the imitation was such as to show fraud, and that the respondent should be enjoined. *Enterprise Mfg. Co. v. Landers, Frary & Clark*, 124 Fed. R. 923. Aff'd 131 Fed. R. 240.

"The injunction should be broad enough so that, while not interfering with the inherent right of the defendant to make coffee-mills of such design, shape, and dress as it may please to employ, it will prevent said defendant from marketing a mill, not only such as it now markets and threatens to market, but any mill which, by reason of its shape, design, and arrangement of color and number, shall so resemble the coffee-mills of the plaintiff as

to be likely to create a misapprehension in the minds of the purchasing public of average intelligence, and to tend to lead the ordinary consumer to mistake the mills of the defendant for the mills of the plaintiff." *Enterprise Mfg. Co. v. Landers, Frary, & Clark*, 124 Fed. R. 923, 928. Aff'd 131 Fed. R. 240.

For many years complainant had made box letter files under the names "Eureka" and "Leader," and an emblem of a globe. The court did not pass on the question as to whether these were trade-marks, but as the respondent had so imitated the style, color, marking, and names of the complainant's boxes as to cause unfair competition, injunction was granted.

"This particular file (one of many made by appellant) came to be known to the trade, not by the word or emblem merely, but by its appearance as a whole, which had been uniformly maintained, of which the word and emblem were but two of very many features. The decree to be directed will protect appellant fully in its 'Leader' file as made, and we will not undertake to say in advance that appellee is likely to use the word or the emblem upon files which in other respects bear no resemblance to appellant's." *Globe-Wernicke Co. v. Brown*, 121 Fed. R. 90, 92.

But see: Complaint that the appellee is making and selling sectional bookcases in imitation, not only of the "system" which the appellant employs, but also of the sizes, styles, material, and finish of those of appellant, with intent to deceive the public. It was not claimed that appellee was representing by any sign its bookcases to be those of the appellant. Held, that since complainant did not have any monopoly in that style of bookcases, and had not by that form and style obtained a reputation rather than skill of workmanship and elegance of materials, there was no unfair trade. *Globe-Wernicke Co. v. Fred Macey Co.*, 119 Fed. R. 696.

"It is impossible to admit the claim of the appellant to the extent of its pretensions, which would amount to a monopoly of such proportions as would practically engross the business. Without doubt, a party may adopt distinguishing marks to denote the origin of production as being his own, or he may adopt some other peculiar method of distinguishing his own goods, and thus retain the benefit of the good reputation which he has acquired for them. But the very idea of distinguishing them implies that it cannot be done by such universal characteristics as belong to other goods of the kind, and which the general public have the undoubted right to use. . . Nor is it competent for one person

to appropriate to his own purposes any common and general characteristics of the goods he manufactures to such an extent that another shall be impeded or embarrassed in his free right to use such characteristics in his own business." *Globe-Wernicke Co. v. Fred Macey Co.*, 119 Fed. R. 696, 704.

Same principles of law involved as in *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169; and many imitations the same; similar decree and accounting. *Singer Mfg. Co. v. Bent*, 163 U. S. 205; reversing 41 Fed. R. 214.

"But it does not follow, as a consequence of a dedication, that the general power, vested in the public, to make the machine and use the name, imports that there is no duty imposed on the one using it, to adopt such precautions as will protect the property of others and prevent injury to the public interest, if by doing so no substantial restriction is imposed on the right of freedom of use. . . It is obvious that if the name dedicated to the public, either as a consequence of the monopoly or by the voluntary act of the party, has a twofold significance, one generic, and the other pointing to the origin of manufacture, and the name is availed of by another without clearly indicating that the machine, upon which the name is marked, is made by him, then the right to use the name, because of its generic signification, would imply a power to destroy any good-will which belonged to the original maker. It would import not only this, but also the unrestrained right to deceive and defraud the public by so using the name as to delude them into believing that the machine made by one person was made by another." *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 186, 187.

Complainant had for many years built up an extensive business with great reputation in sewing-machines under patents, some fundamental, some accessory, and applied name "Singer," in a descriptive sense. At expiration of some patents the respondent began to construct machines of a similar pattern, using the name "Singer," and adopting certain forms in the machine which were employed by the complainant for distinguishing purposes and not for structural, such as a distinctive oval plate with certain marks; a screw protected by patent in complainant's machines serving a mechanical purpose was imitated by a dummy screw in respondent's. The numbers, running up into millions on complainant's machines, were copied on respondent's as if they came from an old established concern. Held, that while the complainant, after expiration of patent, had no right to the

name "Singer" or to form of machines, yet the respondents were in their copies of unessential details, etc., guilty of fraud. Injunction. "First, from using the word 'Singer' or any equivalent thereto in advertisements in relation to sewing-machines, without clearly and unmistakably stating in all said advertisements that the machines are made by the defendant, as distinguished by the sewing-machines made by the Singer Manufacturing Company: second, also perpetually enjoining the defendant from marking upon sewing-machines, or upon any plate or device connected therewith and attached thereto the word 'Singer,' or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer, and therefore not the product of the Singer Manufacturing Company. And the decree so to be entered must also contain a direction for an accounting by the defendant as to any profits which may have been realized by it, because of the wrongful acts by it committed." *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169; reversing 41 Fed. R. 208.

Complainant entitled to injunction against party who imitated its disk records in color, lettering, and grooves, and used same numbers thereon as it used for designation to the public. *Victor Talking Machine Co. v. Armstrong*, 132 Fed. R. 711.

A. But similar features or designs which are structurally essential or are in common use do not constitute a case for unfair trade.

It is not unfair competition for respondent to use a tin tag of similar size and color to that of complainant on its plug tobacco where such use is common to the trade, especially where the different lettering is easily distinguishable. *Continental Tobacco Co. v. Larus & Bro. Co.*, 133 Fed. R. 727.

Unfair competition is not established by proof of similarity in form, dimensions, or general appearance alone. Where such similarity consists in constructions common to or characteristic of the articles in question, and especially where it appears to result from an effort to comply with the physical requirements essential to commercial success, and not to be designed to misrepresent its origin of such articles, the doctrine of unfair competition cannot be successfully invoked to abridge the freedom of trade competition. *Marvel Co. v. Pearl*, 133 Fed. R. 160.

7. A party who has acquired, in good faith, a reputation under a mark by use during the same period in which it is used by another party, may be protected in its use, although the other party may have the rights of a trade-mark therein.

See VIII. 1 B (2). 157. *City of Carlsbad v. Schultz*, 78 Fed. R. 469.

See IV. 9 B. 112. *Corwin v. Daly*, 7 Bosw. 222.

See IV. 8 A. 111.

See XVI. 2. 334. *Leprince v. Iler & Morris*, 92 O. G. 189.

A. A name registered and claimed as a trade-mark, which may not be a valid trade-mark, may be protected within geographical limits on the ground of unfair trade.

See VIII. 5 A. 197. *Sartor v. Schaden*, 125 Iowa, 696.

The name "Keystone," for cigars, registered and claimed as a trade-mark, while it might not be a valid trade-mark on account of prior use and geographical meaning, might be protected in New England on the ground of unfair trade. *Cohen v. Nagel*, Mass. Feb. 1906.

IX. TRADE-NAMES.

1. A trade-name used by a proprietor to designate (A) the personality and the character, (B) or the locality of his business, not affixed to the goods, is protected by the courts from infringement as against all others not having an equal right to use it.

A. (1) *Business enterprises.*

“Colton Dental Rooms,” sign protected. Where infringer formerly working for plaintiff hung out sign similar in form to that of plaintiff’s, with small letters (after his own name) “late operator at the,” and “Colton Dental Rooms” prominently displayed. Held, infringement. *Colton v. Thomas*, 2 Brewst., 308.

“Established 1780,” or “Established A. D. 1780,” as part of trade-name protected. *Hazard v. Caswell*, 57 How. Pr. 1.

Plaintiffs operated line of omnibuses known as “London Conveyance Company”; defendant used on his line such words as “Conveyance Company.” Injunction. *Knott v. Morgan*, 2 Keen, 213.

A party who has built up at Taunton a large business at considerable expense under the name “Manufacturers’ Outlet Company,” which name was registered as a trade-mark, is entitled to relief against a party who fraudulently for the purpose of diverting business, establishes himself under the name of the “Taunton Outlet Company.” *Samuels v. Spitzer*, 177 Mass. 226.

The plaintiff carried on business in the city of L., having for his sign a figure of a gilt lion, and designating his place of business “The Golden Lion.” The defendant had for some years had the conduct of the business, and beginning on his own account opened a shop, in front of which he placed a figure somewhat similar to that of plaintiff; the court restrained the defendant from using as a sign this or any similar figure. *Walker v. Alley*, 13 Grant Ch. 366.

(2) *Hotel.*

“We think that the principle of the rule is the same to whatever subject it may be applied, and that a party will be protected in the use of a name which he has appropriated and by his skill

rendered valuable, whether the same is upon articles of personal property which he may manufacture, or applied to a hotel where he has built up a prosperous business." *Howard v. Henriques*, 3 Sandf. S. C. 725.

"Irving House," protected as trade-name for hotel. *Howard v. Henriques*, 3 Sandf. S. C. 725.

Plaintiffs by agreement with proprietors of "Revere House," used name on busses (and on caps of drivers) to convey passengers to and from hotel and a railroad station. Defendant used same name likewise. Held, in a court on the case plaintiffs had right to recover "such damages as the jury, upon the whole evidence, should be satisfied they had sustained; that the damages would 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." *Marsh v. Billings*, 7 Cush. 322.

McCardel allowed party to use his name on hotel in which he, McCardel, was employed. McCardel left hotel and got no benefit from it; party sold hotel to defendant. McCardel's wife who succeeded him in restaurant business under name of "McCardel House," had right to restrain defendant from using name "McCardel House" on his hotel. No express agreement or license existed for use of McCardel's name. *McCardel v. Peck*, 28 How. Pr. 120.

Plaintiffs agreed with A, proprietor of certain hotel, "Irving House," to have exclusive use of his name on busses (and badges) to and from his hotel. Held entitled to injunction v. third parties using name likewise. *Stone v. Carlan*, 13 Mo. L. R. 360; Cox Manual, 104.

"Columbia," as applied to hotel, good trade-mark. (See *idem*. III 2 E. 73.) *Whitefield v. Loveless*, 64 O. G. 442.

Name of hotel "What Cheer House," protected. A. built hotel "What Cheer," on leased land, then bought adjoining lot and built there a hotel called "What Cheer House." At expiration of lease the lessor had no right to designate the hotel "What Cheer House." *Woodward v. Luzar*, 21 Calif. 448.

(3) Orchestra, etc.

Party has right to trade-name on minstrels. Christy had in 1842 at some labor and expense established "Christy's Minstrels," and given shows till fall of 1854. He suspended, went to California and after several months returned. Performers in old troupe without license started "Christy's Minstrels." He had not resumed, but announced intention to do so. Injunction. *Christy v. Murphy*, 12 How. Pr. 77

(4) Newspaper, periodical, or publication.

See XI. 11. 265.

(a) But there is no exclusive right to a trade-name on a publication which has been dedicated to the public without copyright or on which a copyright has expired.

"The bill rests, then, upon the single proposition: Is the complainant entitled to invoke the aid of this court to prevent the defendant from using the complainant's assumed name of 'Mark Twain,' in connection with the publication of sketches and writings which complainant has heretofore published under that name, and which have not been copyrighted by him? . . . The invention of a *nom de plume* gives the writer no increase of right over another who uses his own name; . . . but 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 copyright is a dedication to the public, after which any one may republish it."

But the complainant would have had the right to enjoin use of his *nom de plume* on matter which he did not write. *Clemens v. Belford*, 14 Fed. R. 728, 731.

"The title or name is an appendage to the book or piece of music for which the copyright is taken out, and if the latter fails to be protected, the title goes with it, as certainly as the principal carries with it the incident." *Jollie v. Jaques*, 1 Blatchf. 618, 627.

"I have no doubt that defendant is entitled to use the words 'Webster's Dictionary,' to describe the work that it is engaged in publishing and selling. Those words were used to describe Webster's Dictionary of the edition of 1847, and, as the copyright on that edition has expired, it has now become public property. Any one may reprint that edition of the work, and entitle the re-

print 'Webster's Dictionary.' The latter words, which appeared on the title-page and on the outer cover of books of the edition of 1847, have become public property, as well as other parts of the work. . . . In my judgment, no person engaged in publishing and selling a book or books can acquire an exclusive right to use the device of a book on letter-heads and bill-heads, or on wrappers or boxes containing books. The device in question, when used in that connection or relation, is not sufficiently arbitrary to constitute a valid trade-mark." *Merriam v. Famous Shoe and Clothing Co.*, 47 Fed. R. 411, 413.

The copyright on Webster's Dictionary having expired, no one has any special property in the title. *Merriam v. Holloway Pub. Co.*, 43 Fed. R. 450.

"The plaintiffs are not entitled to an exclusive use of the name 'Webster's Dictionary' upon copies of editions, the copyrights of which have expired, for the name is not a trade-mark. Mere copies of the edition 1847 and 1859 can be reproduced by a publisher, over his own name, provided he makes no misrepresentations to induce the public to believe that it is another book, the right to publish which is the exclusive property of the plaintiff. The mere form or size of the volume in which Webster's Dictionary has ordinarily appeared, does not, in the mind of the public, connect the plaintiffs with the manufacture of the dictionary, and there is no characteristic of a trade-mark in such ordinary form or size." *Merriam v. Texas Siftings Pub. Co.*, 49 Fed. R. 944, 947.

B. The locality of his business.

See X. 4. 231; X. 7. 237.

A party with consent of owner of building erected sign over his store "Tower Palace," owner paying half expense; after he moved the new lessee continued name. Held, that he could not be enjoined by former proprietor, as name went with the building.

"Here the name 'Tower Palace' was intended to describe and designate the place, and not the particular business, nor the person carrying it on. It never was used as a trade-mark by appellant, but simply to indicate the particular place on Market Street where he did business, and consequently he never acquired the exclusive right to use that name, except as applicable to and while he occupied that building." *Armstrong v. Kleinhans*, 82 Ky. 303.

Party and his predecessor had for many years been doing busi-

ness at No. 10 South Water St., and had used trade-name "The Old Joseph Hall Agricultural Works, No. 10 South Water St., Rochester, N. Y.," so that the place had come to be known as "No 10 South Water St." Held, entitled to relief against party who established himself on same street and used, "No. 10 South Water St." *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226.

"It would follow from these principles that if a person had established a business at a particular place, from which he has derived or may derive, profit, and has attached to that business a name indicating to the public where and in what manner it is carried on, he has acquired a property in the name, which will be protected from invasion by a court of equity, on principles analogous to those which are applied in case of the invasion of a trade-mark." *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226, 231.

2. Under the same rules as apply to trade-marks courts will not, in the absence of fraud, protect a party in the exclusive use of (A) a descriptive, (B) a geographical, (C) an appellative, (D) or a deceptive trade-name.

A. Descriptive.

"Svenska Snesmagasinet," meaning, "Swedish Snuff Store," descriptive trade-name, not protected.

"If a phrase or words in common use are selected, which are indicative of the character, nature, kind, quality, virtue or composition of the thing to which they relate, the law will not protect their use as a trade-mark, and the same is true in respect of trade-name or designation." *Bolander v. Peterson*, 136 Ill. 215.

"Antiquarian Book Store," not good exclusive trade-name. *Choynski v. Cohen*, 39 Calif. 501.

"Civil Service," in a trade-name cannot be granted exclusive protection. *Civil Service Supply Association v. Dean*, 13 Ch. D. 512.

Plaintiff could not enjoin defendant from use of its name, "Colonial" being descriptive of kind of business carried on. *Colonial Life Assurance Co. v. Howe Colonial Assurance Co.*, 33 Beav. 548.

The complainant not entitled to enjoin respondent in use of its name, as the words "employers' liability," as applied to insurance

had become descriptive and no one had exclusive right to use of name. *Employers' Liability Assurance Corporation v. Employers' Liability Insurance Co. of the United States*, 24 Abb. N. Cas. 368. Aff'd 61 Hun, 552.

"But the name of 'Goodyear Rubber Company,' is not one capable of exclusive appropriation. 'Goodyear Rubber' are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one." *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598.

"International Banking Company" tried to restrain defendants from using name "International Bank," both having same business of foreign bonds; name not protected. *Kochler v. Sanders*, 122 N. Y. 65; 48 Hun, 48.

Letters "IXL," not protected as part of a trade-name over a store.

"It is claimed that the letters 'IXL' could not be used by the respondent after being appropriated by the appellant. The letters have been used by many manufacturers to denote their wares, as on cutlery and on bitters, and were not the invention of the plaintiffs, but taken by them from former proprietors and inventors thereof and do not by themselves make a trade-mark, any more than the word 'excelsior,' which is often used with other words to make a trade-mark or sign." *Lichtenstein v. Mellis*, 8 Oregon, 464.

No exclusive right to use word "Pictorial," as applied to almanac; action to be tried first at law. *Spottiswoode v. Clark*, 10 Jurist, 1043.

B. Geographical.

"Swedish Snuff Store," descriptive, and party not entitled to its exclusive use. *Bolander v. Peterson*, 136 Ill. 215.

"Further than this, we think that the word 'Continental,' a geographical adjective, meaning pertaining to or relating to a continent, is a word in common use, more or less descriptive of extent, region, and character, and like the words 'Columbian,' 'International,' 'East Indian,' and some other geographical adjectives, it cannot be exclusively appropriated as a trade-mark or trade-name." *Continental Ins. Co. v. Continental Fire Ass'n*, 101 Fed. R. 255, 257; affirming 96 Fed. R. 846.

Defendant could not be enjoined from using its trade-name, it not appearing that it had not creameries in the town, and was not rightfully carrying on the creamery or butter business there. *Elgin Butter Co. v. Elgin Creamery Co.*, 51 Ill. App. 231; 155 Ill. 127.

C. Appellative.

See III. 3. 73. *Brown Chemical Co. v. Myer*, 31 Fed. R. 453; 139 U. S. 540.

D. Deceptive.

The same general principles apply as in the case of deceptive trade-marks, etc.

3. A. A party may be entitled to the use of a certain distinguishing feature in a trade-name, but may not have equal rights to the same feature in a mark on the goods.

Defendant could use the designation "Brooklyn White Lead" on his product, it being descriptive; but could not use the trade-name "Brooklyn White Lead Co." *Brooklyn White Lead Co. v. Mosury*, 25 Barb. 416.

The defendant company had manufactured corsets and shoes in a limited way, according to certain hygienic principles, to which it had applied the name "Delsarte" in a descriptive way; the plaintiff had built up a large trade in good faith under that name as a fancy name on shoes; held that defendant could use its corporate name, but could not use name "Delsarte" as a trade-mark. *Mellor & Holmes Shoe Co. v. Delsarte Mnfgy. Co.*, 46 Atl 1089.

B. A party may be entitled to use certain distinguishing features on his goods, but not to embody the same in his trade-name so as to deceive the public.

Complainant assigned rights to sell under a patent "taper sleeve pulleys" west of the Mississippi River, but did not assign his trade-name "Taper-Sleeve Pulley Works." Held that respondent could use the name of "taper-sleeve pulleys" to designate his goods, but could not use the trade-name. *Gray v. Taper-Sleeve Pulley Works*, 16 Fed. R. 436.

4. Where a party has in good faith built up a business under a descriptive or personal trade-name courts will compel a new rival, who originally would have been entitled to use the same name, to plainly distinguish his business.

See VIII. 1 C. (2). 165.

A party by the name of Bissell manufactured at South Bend, Ind., ploughs called "Bissell Plows." Afterwards he formed a corporation, "Bissell Chilled Plow Works." He subsequently retired and formed a corporation under name "T. M. Bissell Plow Co." using name "Bissell" on ploughs. After his death business was discontinued and then certain parties of another name at Eaton Rapids, Mich., purchased stock, patterns, corporate name, etc., of the company and began to manufacture ploughs there, marking them by name of "T. M. Bissell," showing by circulars his picture, and claiming him as original inventor, formerly of South Bend. The original process and patent was owned by the complainant company. Held, that it was a case for injunction against use of name "Bissell" as trade-mark or trade-name. *Bissell Chilled Plow Works v. T. M. Bissell Plow Co.*, 121 Fed. R. 357.

"It is not to be said that the plaintiffs have any exclusive right to the words 'Conveyance Company,' or 'London Conveyance Company,' or any other words; but they have a right to call upon this court to restrain the defendant from fraudulently using precisely the same words and devices which they have taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business, by attracting custom on the false representation that carriages, really the defendant's, belong to, and are under the management of the plaintiffs." *Knott v. Morgan*, 2 Keen, 213.

Where defendant had been manager for plaintiff, who for years had carried on business in Pall Mall under name of "Pall Mall Guinea Coal Co.," he had no right on leaving, to use same name, although he did business on Pall Mall, and although there were other guinea coal companies in London. *Lee v. Haley*, L. R. 5 Ch. App. 155.

5. It is a fraud for a company to use the name of a person, not on account of his skill or ability, but for the purpose of obtaining advantage of the reputation of another of the same name in a similar business.

A blacking manufactory had long been carried on under name of "Day & Martin," and executors of survivors continued the business under same name. A person by name of Day, having obtained the authority of one Martin to use his name, set up the same trade under name "Day & Martin," in bottles and labels having a general resemblance to those of plaintiffs. Injunction. *Croft v. Day*, 7 Beav. 84.

Complainant had acquired great reputation in the snuff business and his snuff had become known as "Garrett's Snuff." The respondent corporation was formed with three hundred and fifty shares, of which T. H. Garrett subscribed for only two and one-half, and was an employé in a subordinate position. The corporation put out inferior snuff, and by using the name "Garrett" created great confusion. Held, that on appeal for preliminary injunction, although the court in its discretion did not grant injunction against use of proper name, the case was so clear that as to that part the decree should be reversed and that injunction should issue against use of "T. H. Garrett," or of name "Garrett" as part of corporate name. *Garrett v. T. H. Garrett & Co.*, 78 Fed. R. 472.

Complainant's predecessors as "Rogers Bros." had acquired great reputation in cutlery. Respondent corporation, formed by two incorporators named "Rodgers," without especial skill in cutlery, undertook to manufacture table ware, and stamped it "Rodgers Bros. Cutlery Co." Held unfair trade. *International Silver Co. v. Rodgers Bros. Cutlery Co.*, 136 Fed. R. 1019.

About forty years ago three Rogers brothers in Hartford had started business of plating silver ware, and acquired great reputation, using marks "Rogers," and "1847, Rogers Bros." Complainant was their successor. In 1890 Simeon L. and George H. Rogers, sons of one of the original Rogers, but who had not previously been engaged in the silver-ware business, were instrumental in forming a new corporation of nominal capital stock of \$200,000, but they owned only one-eighth of stock, and the prominent stockholders' names were not used. This corporation soon changed its name to "S. L. & G. H. Rogers Co.," and marked its

silver ware "Rogers" and "Rogers Bros." in various forms, also representing that they were "only real Rogers Bros." Preliminary injunction against such use of "Rogers" and "Rogers Bros." *International Silver Co. v. Simeon L. & George H. Rogers Co.*, 110 Fed. R. 955.

Complainant as successor of "Wm. Rogers Mnfg. Co.," was engaged in manufacturing silver-plated ware, with a right to the use of the trade-mark "Wm. Rogers Mnfg. Co." Defendants organized a corporation under the name of "Wm. G. Rogers Company," using trade-mark "Wm. G. Rogers." W. G. R., its president, was a bank clerk, had never engaged in that or similar business of manufacturing, his only efforts having been to sell some silver ware of a concern supplied by complainant. He had only five of one hundred shares of stock, two other stockholders holding eighty-five shares, they having formerly manufactured silver ware for genuine "Wm. Rogers Mnfg. Co.," and had organized this company to continue in business. Held to conclusively show want of good faith on part of defendant, and preliminary injunction allowed against use of name "Wm. G. Rogers," or any other mark of which the words "Wm. Rogers" are a characteristic part on the goods, but not from use of its corporate name. *International Silver Co. v. Wm. G. Rogers Co.*, 113 Fed. R. 526. Aff'd 118 Fed. R. 133.

William H. Rogers, a bicycle machinist, without knowledge of silver-plating, used his name first individually, then in forming a partnership, and later a corporation to get the benefit of his name on silverware made for him by others. Complainant was entitled to trade-name "Wm. Rogers & Sons," "Wm. Rogers," and "Wm. Rogers Manufacturing Company" on silverware, and entitled to injunction. *International Silver Co. v. William H. Rogers Corp.*, 66 N. J. Eq. R. 119.

Complainant and predecessors had been engaged in thread business in England and in United States since 1840, and built up a reputation under its name so that its thread was called for as "Coats'" thread. Respondent was incorporated to make thread and deliberately to deceive the public, took the name of an incorporator, Coates, not because he knew of thread business, but because of similarity to complainant's name. Although the packages of thread were otherwise not calculated to deceive, yet there was ground for injunction. *J. & P. Coats, Ltd., v. John Coates Thread Co.*, 135 Fed. R. 177.

Respondent Rogers had been selling silver ware in New York

for a number of years manufactured for him and labelled "Brunswick" or "Belmont" with his own name "Wm. A. Rogers." Evidence showed that he was trading on the name of the well-known complainant manufacturing company. Injunction against use of the name on silver-plated ware "Wm. A. Rogers." *Rogers v. Wm. Rogers Mfg. Co.*, 70 Fed. R. 1019.

Complainant was successor of partner, who for many years had used the name "Rogers" on its table ware, and under it had built up a great reputation. The respondent corporation was formed for the purpose of enabling a man by the name of Strickland to use the name "Rogers," and a salesman by that name was given a quarter interest in the concern. Respondent enjoined from using mark "R. W. Rogers Co." *R. W. Rogers Co. v. Wm. Rogers Mfg. Co.*, 70 Fed. R. 1017; affirming 66 Fed. R. 56.

"I place my concurrence in the judgment in this cause upon the broad ground that a body of associates who organize a corporation for manufacturing and selling a particular product, are not lawfully entitled to employ as their corporate name in that business the name of one of their number, when it appears that such name has been intentionally selected in order to compete with an established concern of the same name, engaged in similar business, and divert the latter's trade to themselves by confusing the identity of the products of both, and leading purchasers to buy those of one for those of another." *R. W. Rogers v. Wm. Rogers Mfg. Co.*, 70 Fed. R. 1017, 1019.

J. W. Thorley took eighteen shares in a company called after him, "J. W. Thorley's Cattle Food Co.," and was employed as manager in making food for cattle, which was intended to divert trade from a celebrated preparation known as "Thorley's Food for Cattle." Held a fraud; injunction issued. *Thorley's Cattle Food Co. v. Massam*, 42 L. T. R. N. S. 851.

"Rogers & Son" used continuously by father and son and their successors in plating silver ware, protected as trade-name although there were not as formerly a Rogers & Son.

Spurr, in Greenfield, formed the corporation and paid a small royalty to D. C. and Geo. E. Rogers, father and son, who never learned or practised the silver-ware business, but lent their name for the purpose of deceiving the public. *William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. R. 495.

"This royalty is paid for a falsehood. The names of these Rogerses is not of the slightest value in the silver-plating business, which they never learned or practised; nor were they ever

partners, as I read the evidence, except in hiring out this trade-mark. It is impossible that this royalty can be paid for anything but the chance of purchasers supposing it to represent some other Rogers. A court of equity cannot be expected to look with much favor upon a trade-mark thus acquired and thus used." *William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. R. 498.

6. A. The use of a corporate name by a corporation infringing on the trade-mark of a party, or trade-name of another to his injury in unfair trade, may be enjoined by the courts.

See VIII. 1 B (2). 158. *Nesne v. Sundett*, 93 Minn. 299.

See X. 1 A. (2). 222. *Le Page Company v. Russia Cement Co.*

"The fact that both are corporate names is of no consequence in this connection. They are the business names by which the parties are known, and are to be dealt with precisely as if they were the names of private firms or partnerships. The defendant's name was of its own choosing, and if an unlawful imitation of the complainant's is subject to the same rules of law as if it were the name of an unincorporated firm or company."

Use of corporate name "Cellonite Manufacturing Company," or any name infringing "Celluloid" enjoined. *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. R. 94, 97.

Corporate name "Landlords' Protective Department" will be enjoined as conflicting with prior corporate name "Chicago Landlords' Protective Bureau." *Chicago Landlords' Protective Bureau v. Koebel*, 112 Ill. App. 21.

A corporation cannot use, so as to deceive, the name of a private individual who has already given his name to a former corporation which he has assisted in forming. *Dodge Stationery Co. v. Dodge*, 145 Calif. 380.

"Upon the record, we are constrained to believe that the Pastor Kneipp Medicine Company, the appellee, was 'conceived in sin and brought forth in iniquity,' that wrong attended at its birth, and that fraud stood sponsor at its christening, imposing upon the corporate child a name to which it was not entitled, and which it had no right to bear. The name of an eminent philanthropist was taken without his consent and against his protest. This assumption of name was a wrong which we cannot doubt a court of equity would, upon his application, have restrained, even if the purpose of the corporation had been wholly innocent and

praiseworthy; but here, it is clear, the name, the portrait, and the fac-simile signature of Rev. Sebastian Kneipp were employed, not only without his consent and against his will, but were so assumed with a view to deceive the public, and to induce the belief that the product marketed and sold was prepared under his supervision, and offered to the public with his sanction." *Kathreiner's Malz Kaffee Fab. v. Pastor Kneipp Med. Co.*, 82 Fed. R. 321, 324.

"The act of sovereignty allowing incorporation is permissive, not mandatory. It sanctions the act of incorporation under the name and for the business proposed, if that name and that business be otherwise lawful. The sovereign by the act of incorporation adjudges neither the legality of the business proposed, nor of the name assumed. That is matter for judicial determination by a court having jurisdiction of the subject when the legality of the business or of the name is called in question. If one may not use the name imposed upon him *in invitum* so that it shall work wrong to another, by what token may he become incorporated under a name selected by himself to effect like wrong? And how is the sovereignty of a great state impugned by the denial to incorporators of a right to perpetrate such a wrong? Is it possible that a sovereignty of a state can be thus invoked to perpetrate a fraud? If it may be, then indeed will that sovereignty stand for oppression, and not for justice." *Peck Brothers & Company v. Peck Bros. Co.*, 113 Fed. R. 291, 300.

See *idem*, VIII. 1 C. (1). 163.

The complainant was a Pennsylvania corporation, known familiarly as "The Philadelphia Trust Co.," and generally so called. Held, that a preliminary injunction should issue against the respondent, a Delaware corporation, chartered to do a trust business in any part of the world. *Philadelphia Trust Safe Deposit & Ins. Co. v. Philadelphia Trust Co.*, 123 Fed. R. 534.

But see: The complainant, a New York corporation, doing business in the State of Texas by virtue of a license, cannot enjoin a Texas corporation from use of the word "Continental," as complainant "is without standing to question the right of the defendant to use in its business the name granted and authorized by the State of Texas." *Continental Ins. Co. v. Continental Fire Ass'n*, 101 Fed. R. 255; affirming 96 Fed. R. 846.

But see: A United States circuit court cannot interfere by injunction at the instance of a corporation organized under the laws of another State, and prevent individuals, acting under a license

of the Secretary of that State, from taking necessary legal steps to form a corporation bearing the same name as the foreign corporation.

But after the formation of the corporation it is not said what the court might do to prevent interference with complainant's business. *Lehigh Valley Coal Co. v. Hamblen*, 23 Fed. R. 225.

B. But a descriptive corporate name will not give one an exclusive right to a name which others might properly use in their business.

See IX. 2 A. 207.

“Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word ‘Company’ only indicates that parties have formed an association or partnership to deal in such goods, either to produce or sell them. . . . Names of such articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.” The word “Goodyear” was descriptive of rubber made by a certain process, and the name “Goodyear Rubber Company,” or “Goodyear Rubber Manufacturing Company” was not capable of exclusive appropriation. *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598, 602; reversing 22 Blatch. 421; 21 Fed. R. 276.

7. A trade-name, by affixation, may also become a trade-mark.

“Is not a man's name as strong an instance of trade-mark as can be suggested? — subject only to this inconvenience, that if a Mr. Jones or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name.” *Ainsworth v. Walsmsley*, L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. n. s. 205; 14 L. T. n. s. 220; 14 W. R. 363.

“A name, though originally the name of the first maker, may in time become a mere trade-mark or sign of quality and cease to denote or be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues to be used for generations after the death of the

individual who first affixed it. *Hall v. Barrows*, 4 De G. J. & S. 150 etc.

“It is true that a name or the style of a firm may by long usage become a mere trade-mark.” *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137, 144.

“The Courts of Equity having taken that step, trade-marks began to be considered as property, and no doubt there is in a certain sense a property in a trade-mark, and equally in a trade-name, because a trade-name may be used and is very commonly used, as a trade-mark properly so called — that is, a mark put upon the goods themselves. Then both a trade-mark and a trade-name were allowed to be sold as part of the good-will of a business.” *Singer Mfg. Co. v. Wilson*, 2 Ch. D. 434, 454.

X. ASSIGNMENT.

1. A. (1) **A trade-mark (2) or a trade-name representing the good-will of a business may pass by assignment or conveyance of the business.**

(1) *A trade-mark.*

“And inasmuch as the court protects the owner of the mark, he is entitled to authorize another, when he hands over his business to him, to place that mark on his goods. That is a right which, being protected by this court, may be disposed of for value, may be bought and sold, and is, therefore, in that sense of the word, property.” *Ainsworth v. Walmsley*, L. R. 1 Eq. 518, 525.

Trade-mark “Celluloid” passed by assignment together with rights, business and good-will. *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. R. 94.

M. A. Thedford was engaged with others in manufacturing “Simmons’ Liver Medicine;” he sold out his interest, agreeing not to enter into the sale of the medicine. He afterward began business with others and put out what was called “M. A. Thedford & Co’s Original and Only Genuine Liver Medicine, or Black Draught,” in packages and labels calculated to deceive. Held, that, although he had dropped the word “Simmons,” the agreement was sufficiently broad to call for injunction. *Chattanooga Medicine Co. v. Thedford*, 66 Fed. R. 544; reversing 58 Fed. R. 347; 49 Fed. R. 949.

The name “Congress,” as a valid trade-mark on water of a particular spring, passed with the purchase of the spring without special mention of good-will or trade-mark. *Congress & Empire Spring Co. v. The High Rock Congress Spring Co.*, 45 N. Y. 291; reversing 57 Barb. 526.

Where a manager of a business subsequently becomes a partner and then sole owner, the fact that he was not the original designer or owner of a trade-mark is no ground for refusing injunction for infringement. *Cuervo v. Landauer*, 63 Fed. R. 1003.

“The mere fact that each and all of the ‘Fishes’ withdrew from that business, did not prevent the words mentioned from continuing to point to the old place of business and the old firm of ‘Fish

Bros.' and 'Fish Bros. & Co.,' at Racine, as the true source and origin of their particular make and style of wagon and vehicle to which the plaintiff company succeeded, and continued to manufacture at Racine. It is true that one of the functions of a trade-mark is to point out the true ownership of the goods or articles to which it is applied, and that the words 'Fish Bros.' and 'Fish Bros. & Co.,' partially ceased to perform that office when Mr. Case became the ostensible owner or mortgagee, and still more so when the legal title passed to the receivers respectively, and finally became extinct when the property and assets became vested in the plaintiff; but such extinction did not prevent those words from performing the two other functions of a trade-mark mentioned." *Fish Bros. Wagon Co. v. La Belle Wagon Works*, 82 Wis. 546, 560.

Trade-mark in "N. S." used on label to indicate cigars made for a certain dealer exclusively can be assigned with the business and thereafter can be continued by the assignee using them as his predecessors, and he can enjoin one using "N. & S." on cigar labels. *Frank v. Sleeper*, 150 Mass. 583.

Business of threshing-machines at establishment known as "Number 10 South Water Street" passed by purchase from executors of former proprietor to party who was entitled on continuing business to restrain one using same trade-name "Number 10 South Water Street." *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226.

An instrument which grants, licenses, assigns and sets over to a party the absolute and exclusive use of certain trade-marks and all benefits and advantages to be derived therefrom held to constitute an assignment. *Griggs, Cooper & Co. v. Erie Preserving Co.*, 131 Fed. R. 359.

Trade-marks "A. N. Hoxie's Mineral Soap" and "A. N. Hoxie's Pumice Soap" passed with assignment of good-will and assets of the firm. Bill of sale: "The following goods and chattels, namely, all my right, title, and interest in and to all and singular the partnership property belonging to the firm, meaning hereby to sell and convey all my interests in the entire assets of the firm." *Hoxie v. Chaney*, 143 Mass. 592.

"As to the right of Pike to dispose of his trade-mark in connection with the establishment where the liquor was manufactured, we do not think there can be any reasonable doubt. It is true, the primary object of a trade-mark is to indicate by its meaning or association the origin of the article to which it is

affixed. As a distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of a trade-mark may be lawfully transferred with it. Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place and are of the same character as those to which the mark was attached by its original designer." *Kidd v. Johnson*, 100 U. S. 617, 620.

"S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio," enclosed in a circle, good trade-mark. The right to use the trade-mark was assigned, with sale of the manufacturing establishment. *Kidd v. Johnson*, 100 U. S. 617. *Contra: Kidd v. Mills*, 5 O. G. 337, *infra*.

"There is no reason why a trade-mark cannot be conveyed with the property with which it is associated. As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public. In this respect it differs from a patent or a copyright; but in connection with the article produced, it may be bought and sold like other property. It constitutes a part of partnership assets, and is property sold with the firm property." *Morgan v. Rogers*, 19 Fed. Rep. 596.

Assignment of a trade-mark and the business of making soap by originator and owner to a corporation is valid; and the assignee who places on the product his own name is not acting in bad faith. *Petrolia Mfg. Co. v. Bell & Bogart Soap Co.*, 97 Fed. R. 781.

The portrait of the original proprietor of a medicinal preparation used as a trade-mark may be assigned, although it bears also his own name. *Richmond Nervine Co. v. Richmond*, 159 U. S. 293.

"It is hence settled law that the right to use a trade-mark is not a mere personal privilege, but that, within certain limits it is capable of being bought and sold as other property." *Skinner v. Oakes*, 10 Mo. App. 45, 56.

A trade-mark does not necessarily attach to a manufacture at a certain place. A party might sell factory and go elsewhere. *Solier v. Johnson*, 111 Mass. 238.

“Whatever may be the law as to a trade-mark which is strictly personal, it is the settled law that the right to use a trade-mark in connection with the business in which it has been used is property which will be protected by the courts, and which may be sold and transferred.” *Warren v. Warren Thread Co.*, 134 Mass. 247.

Contra: On substantially the same facts as 100 U. S. 617 the Commissioner of Patents found that the trade-mark did not pass on transfer of factory in Cincinnati.

S. N. Pike had trade-mark on whiskey. He took in two clerks and used trade-mark. Afterward he sold factory in Cincinnati which belonged to him individually to respondents in this Patent Office interference case, but which had been used for the partnership business. The U. S. case says that transfer in terms extends use of trade-mark to said respondent. The O. G. case says that there is nothing to indicate transfer of good-will or trade-mark, but in fact there was a paper giving to the said respondents the use of all brands; but the commissioner said it was a license, and given after the sale. He holds that Pike individually did not have the right to the trade-mark but that it belonged to the firm. The U. S. case says that paper was contemporaneous with assignment; by using the trade-mark the firm did not acquire any title to it; it remained in Pike as much as real estate, and firm acknowledged right of said respondents to it. *Kidd v. Mills*, 5 O. G. 337. *Contra*: *Kidd v. Johnson*, 100 U. S. 617.

(2) *A trade-name.*

See X. 4. 231. *Booth v. Jarrett*, 52 How. Pr. 169.

See X. 4. 231. *Churton v. Douglas*, 28 L. J. Ch. 841.

See X. 4. 231. *Hudson v. Osborne*, 39 L. J. Ch. 79.

See VIII. 1 C (2). 168. *Natl. Starch Mfg. Co. v. Duryea*, 101 Fed. R. 117; affirming 79 Feb. R. 651.

See VIII. 1 C (1). 165. *Kathreiner's Malz Kaffee Fab. v. Pastor Kneipp Med. Co.*, 82 Fed. R. 321.

Brown could legally assign the use of his name with his business of medicinal preparations where the business was not of a personal nature. *Brown Chemical Co. v. Meyer*, 139 U. S. 540.

“But the cases are numerous in which it has been held that a party may lawfully assign and sell, not only a trade-mark indicative of origin in himself, but even the right to use his own name in connection with a particular business.”

Stratton sold out his interest in the yeast business and good

will, which had been acquired under name "Twin Brothers," to complainant. *Burton v. Stratton*, 12 Fed. R. 696, 704.

Lessee of a mill has the right to use the proper name attached to the mill, and old firm having by inheritance same proper name with no one in it of same name cannot enjoin its use. *Carmichel v. Latimer*, 11 R. I. 395.

"The defence that the distillers' brand was not a subject of sale and transfer, and therefore formed no consideration for the alleged agreement, because the use thereof by another than F. M. Head & Co. was deceptive, is not valid; for it is well settled that a trade-mark affixed to articles manufactured at a particular place may be lawfully sold and transferred with the establishment." *Dant v. Head*, 90 Ky. 255, 261.

Johnston party in England could assign right to Estes in United States to name "Chatterbox" on juvenile publications sufficient to enable him in case of infringement to bring bill in equity. *Estes v. Williams*, 22 Blatch. 364.

"The principle seems to be well settled, that where a party sells out an established business, and with it his own name, to be used in connection with such business, he cannot afterwards resume it in carrying on the same business." *Frazer v. Frazer Lubricator Co.*, 121 Ill. 147, 157.

"On February 28th, 1890, the plaintiff purchased the stock in trade and goodwill of Francis Draper & Co., including the possession of their factory, of which they were tenants at will, and took a covenant from the members of the firm not to engage in the manufacture of oil cans for ten years. . . . We infer that Draper & Co. acquired a right to be protected to the usual extent in the use of the word 'Draper,' and we see no sufficient reason to doubt that, in view of the continuity of the business, the name was capable of assignment by Draper & Co. to the plaintiff." *H. A. Williams Mfg. Co. v. Noera*, 158 Mass. 110, 111.

A party named Pancoast took out a patent on ventilators and assigned to complainant the said patent with exclusive use of his name thereon. Held, that the complainant could enjoin respondent from use of the name "Pancoast" on a similar article, and it was not necessary to allege in bill actual use and manufacture by the complainant of the patented article. *Janney v. Pan-Coast Ventilator & Mfg. Co.*, 128 Fed. R. 121.

Le Page established and carried on business of making glues known as "Le Page's Glue." He organized and was treasurer of Russia Cement Co., a corporation to which was transferred all his

rights, assets, good-will, and trade-marks. Held, that neither he nor a corporation with which he was associated could sell glue under the designation, "Manufactured by the Le Page Company." *Le Page Co. v. Russia Cement Co.*, 51 Fed. R. 941.

Peter Oakes formed partnership with Probasco, and made and sold candies called "Oakes' Candies." Later Oakes sold out all interest and trade-mark to Probasco, who, after continuing some time and employing Oakes, who subsequently quit him, then conveyed his interest to respondent. Held, that although as between Oakes and Probasco the latter had no right to convey the trade-mark "Oakes," yet the assignee, being a bona fide purchaser, had right to use the name, but could not use "Peter Oakes," and although the infringement of that name was unintentional, yet the case should go to a master for account of profits. *Oakes v. Tonsmierre*, 49 Fed. R. 447.

"The case falls within another principle, which is, that a name may be used as a mere adjective of description or quality, which the public do not understand as any warranty that the person whose name is used is the maker of the article; and in these cases the right to use the name may be sold with the right to manufacture and vend the goods without reference to the question as to what person or persons actually manufacture them." *Oakes v. Tonsmierre*, 49 Fed. R. 447, 451.

The trade-name "Old Oscar Pepper Distillery" passed under sale of the Distillery so that its owner could use it, and the original Pepper could not enjoin its use. *Pepper v. Labrot*, 8 Fed. R. 29.

Rochus Heinisch acquired great reputation in manufacture of shears, and sold his business to his three sons, who stamped the goods "R. Heinisch," and they became known as "Heinisch shears." One of the partners, H. C. Heinisch, retired from the firm, became its sole agent, and assigned his rights in the agency to defendants. He had assigned to the firm on retirement all his right, title, and interest to it. At termination of agency the complainant, assignee of the firm, entered into a contract with defendants for an exclusive agency, in which they recognized sole right of complainant in trade-mark. At termination of contract H. C. Heinisch conveyed his interest in trade-name to defendants, and they began to make shears marked "H. C. Heinisch," so as to deceive customers. H. C. Heinisch had never done more than convey abstractly his trade-name. Held, that defendants should be enjoined from marking their shears "Heinisch," or "H. C. Heinisch." *R. Heinisch's Sons Co. v. Boker*, 86 Fed. R. 765.

F., J., R., & T., copartners, began business of manufacturing machinery at Worcester in 1852, under the name of "F. & Co.;" and F., J., R., & C., copartners, began a like business in Cincinnati in 1853, under the same name, using it as the style of the firm and as a trade-mark. F. died in 1854. Ever since his death J., R., & C., copartners, continued the business at Cincinnati, with all the rights as to the use of the name of "T. & Co.," which the Cincinnati firm had originally; and J., R., and T., copartners, continued the business at Worcester under the name of "F. & Co.," with the assent of F.'s representatives, until 1861, when their firm was dissolved and its orders, correspondence, and good-will were sold to T., who thereafter pursued the business of buying and selling, but not of manufacturing, machinery. Held, that J., R., & C. could not maintain a bill in equity to enjoin T. from using the name of "F. & Co." in his business and attaching it to machinery which he sells made by others than themselves. *Rogers v. Tintor*, 97 Mass. 291.

"While the plaintiff has not sought to prevent the defendant from manufacturing glue, we add, in order to avoid misunderstanding, that while the defendant cannot use the words adopted as a trade name for the article manufactured by him, we do not decide that he may not use the words 'Liquid Glue,' or other appropriate words, to describe his product, or to state in that connection that he is himself the manufacturer of it." *Russia Cement Co. v. Le Page*, 147 Fed. R. 206, 211.

NOTE. — The decision in *Le Page Co. v. Russia Cement Co.* went further than this.

A manufacturing firm calling its product "Le Page's Liquid Glue," after the name of a partner with his consent, sold the right to use "the trade-marks belonging to or in use by said copartnership" to a corporation of which that partner became an officer, and which continued to make the glue under the same name. Afterwards he left the corporation and began to do business as "Le Page Liquid Glue Company," and make and sell "Le Page's Improved Liquid Glue." Held, "We are of opinion, therefore, that the defendant should be enjoined from using the words 'Le Page's Improved Liquid Glue,' or 'Le Page's Liquid Glue,' to describe the article manufactured by him, and from describing the company under whose name he conducts his business as 'Le Page's Liquid Glue Company,' whether with or without any addition thereto." *Russia Cement Co. v. Le Page*, 147 Mass. 206.

Plaintiff A. Thynne sold his bakery business and good-will thereof to defendant, who also bought his stock in trade, including cards bearing name "A. Thynne, Baker." The assignment called for "all the beneficial interest and good will of the said Arthur Thynne" in the said trade or business, but contained no express assignment of right to use plaintiff's name.

Held, defendant could use name of plaintiff to show business was formerly carried on by him, but not so as to expose him to any liability. *Thynne v. Shove*, 45 Ch. D. 577.

B. Or it may descend to successors or legatees.

Charles Emerson, a maker of razor strops, which bore a label stating that they were made by "Charles Emerson, Emerson Place," taught his business to his five nephews (he having no children, and they being among his heirs-at-law). After his death, intestate, they continued the business in different places, and one of them, of the same name as the uncle, carried it on at Emerson Place, and used a label precisely similar to that formerly used by the uncle. Held, no infringement of this nephew's rights for the son of another nephew to use a label on similar strops which he manufactured, stating that he was the son of a successor of the original "Charles Emerson, Emerson Place." In this case court found that business and trade-mark were not disposed of by will or otherwise, or by administrator. *Emerson v. Badger*, 101 Mass. 82.

"B. B. H.," surmounted by a crown, began to be used by a firm in 1836 in the iron business as a trade-mark; there were several changes in partners, but the same mark was continued, and in 1863, on death of one of the partners, the trade-mark constituted an asset of the partnership. *Hall v. Barrows*, 4 De G. J. & S. 150.

"The plaintiff in this case is the owner of a remedy known as 'Johnson's Anodyne Liniment,' and this suit is brought to enjoin the defendant from putting up and offering for sale a liniment of his own manufacture, in a form so closely resembling that of the plaintiff's article that the public are liable to be deceived thereby, and a portion of the plaintiff's business unlawfully taken away. The liniment was first prepared by Abner Johnson, about the year 1810. In 1846 he took his son, Thomas Johnson, into partnership. In 1848 the business was conducted by Thomas Johnson and his brother, I. S. Johnson, the father having died that year. In 1849, Thomas Johnson died, and the business was then carried

on by I. S. Johnson until 1866, when he sold a part of his interest to the complainant. This continued until 1876, when the complainant bought out the entire interest of I. S. Johnson, and became the sole proprietor of the business. Upon the evidence, I think the complainant has shown such a proprietary right to this business, and to the use of the bottles, labels, and wrappers with which this medicine has been associated and identified, as entitles him to maintain this action against this defendant, and therefore the first defence of want of title in the complainant falls to the ground." *Jennings v. Johnson*, 37 Fed. R. 364.

Business of Thorley, in "Thorley's Cattle Food," descended to his executors, who carried on business and were protected in use of his name. *Thorley's Cattle Food Co. v. Massam*, 42 L. T. n. s. 851.

"It is equally clear that any of the Marshall children, or any other person by the name of Marshall, having acquired a knowledge of the compound, had a perfect right to manufacture and sell it, by himself or others, in his own name, even against the protest of old Samuel Marshall, provided he did not do it in any such way as to be likely to mislead ordinary purchasers, proceeding with ordinary caution, into the belief that they were purchasing the liniment manufactured and sold by old Samuel Marshall himself." *Marshall v. Pinkham*, 52 Wis. 572, 587; 38 Am. R. 756.

Trade-marks "Crowley," used on steel since early in the eighteenth century, and "Crowley Millington" since 1782, descended to plaintiff with a steel business, and he was entitled to injunction against their use in 1838. *Millington v. Fox*, 3 My. & Cr. 338.

Grandfather and father of plaintiffs, who were sons of latter, carried on dairy farm and sold butter with trade-mark of symbol of cornucopia, under which name it became known. Sons succeeded to business without letters of administration, and afterwards separated. Held, that they had right to mark as against stranger. *Pratt's Appeal*, 117 Penn. St. 401.

2. A. A trade-mark or trade-name may pass under an assignment in bankruptcy or for benefit of creditors to the trustees.

See VIII. 1 C (1). 165. *Peck Brothers & Company v. Peck Bros. Co.*, 113 Fed. R. 291.

See X. 1 A (1). 219. *Fish Bros. Wagon Co. v. La Belle Wagon Works*, 82 Wis. 546.

The trade-mark passed to trustees under creditor's deed. *Bury v. Bedford*, 33 L. J. n. s. Ch. 465.

Trade-marks passed under assignment in bankruptcy, and a subsequent assignee had clearly established his right after eleven years' user. *Edelston v. Vick*, 23 Eng. L. & Eq. 51.

"A trade-mark, or a designation of one's trade, may thus be sold by order of the court, whether it be attached to a new business or to one long existing. In such case, 'good-will' and trade-marks are governed by similar rules." *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226; 19 Am. R. 278.

"I take it that in substance there is no distinction between a sale by a man himself of his business and the good-will of it, and the sale by the assignees in bankruptcy of all a bankrupt's assets of every kind." *Hudson v. Osborne*, 39 L. J. Ch. 79.

A trade-mark is such property that can be reached and disposed of by creditors, and therefore it can pass under assignment for their benefit. *Milliken v. Dart*, 26 Hun, 24.

"The complainant having, upon his own petition, been declared a bankrupt, filed the required schedule of his assets and liabilities, in which he described the tract of land inherited from his brother as including the 'Old Oscar Pepper Distillery;' and as such it was known at the time the title became vested in the defendants (who purchased from the assignee in bankruptcy). . . . Neither by its own meaning, nor by association, does it indicate the personal origin or ownership of the article to which it is affixed." "Old Oscar Pepper," a trade-mark for whiskey, which passed to defendant through assignee in bankruptcy. *Pepper v. Labrot*, 8 Fed. R. 29.

Trade-mark on a medicinal preparation owned by a company was reached by creditors, who avoided through the courts a fraudulent sale and assignment for benefit of creditors. *Richmond Nervine Co. v. Richmond*, 159 U. S. 293.

A trade-mark may be assigned with business, and under insolvency or bankruptcy it passes to assignee or trustee. This is unless it is something personal. "King Bee," on tobacco does not show a trade-mark requiring skill of particular individual in manufacture or selection. *Sarrasin v. W. R. Irby Cigar & Tobacco Co.*, 93 Fed. R. 624.

A trade-mark not of a personal nature, and not in any peculiar personal skill, but designating place or extent where thread is manufactured, passes under assignment in insolvency. *Warren v. Warren Thread Co.*, 134 Mass. 241.

B. (1) But if it be of a personal nature or the bankrupt's own name, (2) or if it be not availed of by creditors, it may be resumed by bankrupt.

(1) Personal trade-mark.

See X. 3. 229. *Cotton v. Gillard*, 44 L. J. Ch. 90.

Fish brothers formed partnership for manufacture of wagons and obtained a trade-mark; later the partnership became financially embarrassed and receiver was appointed. The partnership assets were subsequently turned over to the corporation complainant, in the formation of which Fish Brothers joined. Later they left and began manufacturing wagons as "Fish Wagons," and using name "Fish Bros. & Co." The Federal court followed a Wisconsin decision that the right to the trade-mark in the corporation was not exclusive, and that the respondent assignee of Fish Brothers had the right to so use the name "Fish." *Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co.*, 87 Fed. R. 203. But see *Russia Cement Co. v. Le Page*, 147 Mass. 206; X. 1, A. 2. 224.

"It is not denied that Henry T. Helmbold could, by voluntary sale and assignment, transfer the right to use his knowledge and name, but it is not seen how the right to use his own knowledge and name can be taken from him by any judicial proceeding whatever. If they can be, then the merchant who has become unfortunate, but who has still a knowledge and a name with which to begin business anew, must, if he has been adjudged a bankrupt, be content to leave with his assets his brains and his character." *Helmbold v. Henry T. Helmbold Mfg. Co.*, 53 How. Pr. 453.

"Between the time of the sale of the distillery by Stone to Mattingly & Lancaster and the making of the contract of March 10th, 1882, Stone became a bankrupt. It is therefore urged that, if the right to use his name, as a part of the whiskey brand, did not pass with the sale of the distillery, then it passed to his assignee in bankruptcy, and there was, therefore, no consideration for the contract of March 10th, 1882. It will be noticed that the words composing the brand, save the name of the appellee, are those of common use; and the right of using his name merely was a personal one to the appellee, and did not, therefore, pass to his assignee, any more than would the skill acquired by a merchant from experience in his business." *Mattingly v. Stone*, 12 S. W. Rep. 467.

Bemis, with partner Downer, under firm name of Downer, Bemis & Co., had a partner's interest in brand "Downer, Bemis & Co." for ales. Held, that the interest was too intangible for creditors of Bemis to reach it through the courts. *Taylor v. Bemis*, 4 Biss. 406.

(2) Not availed of by creditors.

Assignment in insolvency for benefit of creditors without mentioning trade-mark, and it not being mentioned by trustees or claimed by creditors did not pass trade-mark. *Bradley v. Norton*, 33 Conn. 157.

3. A trade-mark cannot be assigned apart from the business or good-will to which it is attached.

See XI. A (1). 220. *Morgan v. Rogers*, 19 Fed. R. 596.

See IV. 2. 88.

The name with the representation of a white swan upon water formerly used as a trade-mark in the flour business cannot be transferred as a trade-mark apart from the business.

"A trade-mark is analogous to the good-will of a business. Whoever heard of a good-will being sold to one while the original owner continues the business as before; the good-will is inseparable from the business itself." *Bulte v. Igleheart Bros.*, 137 Fed. R. 492, 498, 499.

Trustee in bankruptcy purported to sell the trade-mark "Licensed Victuallers' Relish," used on a sauce the composition of which was a secret. Held, that apart from the business of making the sauce there could be no valid assignment. *Cotton v. Gillard*, 44 L. J. Ch. 90.

"As a mere abstract right, having no reference to any particular person or property, it is conceded that it cannot exist, and so cannot pass by an assignment, or descend to a man's legal representatives." *Dixon Crucible Co. v. Guggenheim*, 2 Brew. 321, 339.

Lichtenstein Bros. & Co., a corporation, was a manufacturer of cigars using "El Falcon" as a trade-mark on a brand. On 31st Oct., 1898, it went out of business and assigned to plaintiffs the right to the trade-mark in question, but no business or good-will. The plaintiffs subsequently used the mark in their own business. Held, that in the absence of fraud the assignee could not enjoin

another party from using "El Falco" on a brand of cigars. *Falk v. American West Indies Trading Co.*, 180 N. Y. 445.

Where registration of a trade-mark is claimed under an assignment which does not purport to assign the business in which said mark was employed, it will be refused. *Frazee v. Merchants' Coffee Co.*, 106 O. G. 2292.

It is not necessary to have a separate instrument in writing transferring a trade-mark, for the right to use it goes with the business. *J. R. Newberry Co. v. Joseph J. O'Donohue's Sons*, 111 O. G. 299.

"There is no case that can be found, none cited by counsel at all, which in any manner supports the proposition that a bare trade-mark, aside from the property, can be assigned, sold, or a good title given to it." The name "Buck" for cigars could not pass without the business. *McVeagh v. Valencia Cigar Factory*, 32 O. G. 1124, 1126.

"A trade-mark cannot be assigned or its use licensed, except as incidental to a transfer of the business as property in connection with which it has been used. An assignment or license without such a transfer is totally irreconcilable with the theory upon which the value of a trade-mark depends, and its appropriation by an individual is permitted." *Macmahon Pharmacal Co. v. Denver Chemical Mfg. Co.*, 113 Fed. R. 468, 474.

Where Mrs. Pepper did not succeed to any business of her husband to which the alleged trade-mark "Pepper's Signal Oil" belonged, she had no right to assign that trade-mark. "Her husband left no such business, and there is no such thing as a trade-mark in 'gross,' to use that term by analogy. It must be appendant of some particular business in which it is actually used upon or in regard to specific articles." *Weston v. Ketchum* 51 How. Pr. 455.

"The mere sale of a trade-mark apart from the article to which it has been affixed confers no right of ownership, because no one can claim the right to sell his goods as goods manufactured by another. To permit this to be done would be a fraud upon the public." *Whitthaus v. Braun*, 44 Md. 303, 306.

4. No special form or words are required for an assignment of a trade-mark, but it will pass by the assignment of a business indicated by the mark, unless it is of a personal nature.

See cases under X. 1 A. (1), 218 and X. 3, 229.

“Such a trade-mark would seem to be an incident to the business of the place or establishment to which it owes its origin, and without which it can have no independent existence. It should be deemed to pass with a transfer of the business because such an implication is consistent with the character of the transaction and the presumable intention of the parties.” *Atlantic Milling Co. v. Robinson*, 20 Fed. R. 217, 218.

Booth had built a theatre and called it “Booth’s Theatre.” A lease of the building conveyed the right to use that name. *Booth v. Jarrett*, 52 How. Pr. 169.

Sale of business in yeast under trade-mark “Twin Brothers,” although not in writing, held to include trade-mark and good-will. Fact that consideration was far in excess of material assets and admission of respondent that he had sold interest in trade-mark, good evidence. *Burton v. Stratton*, 12 Fed. R. 696.

The name “John Douglas & Co.” passed with assignment of good-will of the business. *Churton v. Douglas*, 28 L. J. Ch. 841; 33 L. T. 57.

An agreement acquiring right to manufacture and sell a medicinal compound known as “J. M. Lindsay’s Blood Searcher,” held to include by implication also the right to use the name. *Fulton v. Sellers*, 4 Brew. 42.

“My conclusion in this case is, . . . that those who have acquired through the sale under the assignee, and by subsequent conveyances, all that remained of the assets, interests, rights or property of the insolvent firm of Hegeman & Co., have the right to use that business and the trade-mark with it, if they so use it as to express the fact that they are successors to, and not the original firm.” *Hegeman v. Hegeman*, 8 Daly, 1, 22.

“If one has made of his own name a trade-mark, and then transfers to another his business, in which his name has been so used, the right to continue such use of the name will doubtless follow the business as often as it may be transferred.” *Horton Mfg. Co. v. Horton Mfg. Co.*, 18 Fed. R. 816, 819.

A party who has sold the “Osborne House” and the business

which went with it has no right to resume it again, for such resumption must be for the purpose of deceiving the public. *Hudson v. Osborne*, 39 L. J. Ch. 79.

The exclusive right to use certain brands on galvanized iron passed to plaintiff by virtue of written papers signed at the time of the dissolution of partnership. *Merry v. Hoopes*, 111 N. Y. 415.

J. Miller & Sons executed to complainant a chattel mortgage of business as follows: "The entire property, stock, furniture and fixtures, and other articles, now in and upon said premises, together with all debts and book accounts, assets and effects of every kind and nature, belonging to said firm of J. Miller & Sons." Mortgagee took possession of business under the mortgage. Subsequently Miller & Sons conveyed trade-mark and right to sell medicinal compounds in business. Held, that mortgagee had title to trade-mark as against the subsequent assignees. *Morgan v. Rogers*, 19 Fed. R. 596.

"The name of the particular hotel would therefore be of value as connected with the good-will of the business carried on therein, and that passed to the respondents to the extent of the appellant's right to possession as tenant, which was only for two years." *Mossop v. Mason*, 18 Grant Ch. 453, 463.

"Draper," passed under assignment of good-will, business etc., of manufacturing of cilers, and protected in equity. *Noera v. H. A. Williams Mfg. Co.*, 158 Mass. 110.

"It is a fair inference from these authorities that when, as in the present case, the trade-mark consists merely in the name of the establishment itself, where the manufacture is carried on, and becomes attached to the manufactured article only as the product of that particular establishment, a sale of the establishment will carry with it to the purchaser the exclusive right to use the name it had previously acquired, in connection with his own manufacture at the same place of a similar article, by operation of law." *Pepper v. Labrot*, 8 Fed. R. 29, 43.

"Labels, trade-marks, particular words and phrases devised or used to distinguish or identify the product of the plant, and associated with such products in the public mind, are in like manner usually transferred with the plant, and are regarded as valuable acquisitions for the purchasers." *Symonds v. Jones*, 82 Me. 302, 313.

5. There can be no valid assignment of a trade-mark or trade-name which is of such a personal nature that its use by another in the business would be likely to deceive the public.

“When, however, the whole pecuniary value of the name, in its connection with an article of merchandise, or a manufacture, or a business, is derived solely from the personal qualities of the one to whom the name belongs, such as his skill, special knowledge and experience, or from the fact that the article is produced under his personal supervision, which imparts to it an especial value, — then the right to the name is not transmissible.” *Hegeman v. Hegeman*, 8 Daly, 1, 5.

“There may no doubt be cases where the personal skill of an artist or artisan may so far enter into the value of the product that a trade-mark bearing his name would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases, it would be a fraud upon the public if the trade-mark should be used by other persons, and for this reason such a trade-mark would be held to be unassignable. It is in any case a question whether the use of the trade-mark would give to the public or to purchasers a false idea as to who made the article; and a court of equity would not lend any active aid to sustain a claim to a trade-mark which should contain a misrepresentation to the public. . . . But, on the other hand, the usages of trade may be such that no such inference would naturally be drawn from the use of a trade-mark, which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trade-mark are of a certain standard kind or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is in the trade-mark.” *Hoxie v. Chaney*, 143 Mass. 592, 593; 58 Am. R. 149.

“If an artist or an artisan has acquired, by his personal skill and ability, a reputation which gives to his works in the market a higher value than those of other artists or artisans, he cannot give any other persons the right to affix his name or mark to their goods, because he cannot give to them the right to practise a fraud upon the public.” *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. Cas. 523, 545.

“It seems to me that the question whether ‘good-will’ does ordinarily include the right to use the name of a living person should receive one general answer, viz., that it does not.” *Levy v. Walker*, 10 Ch. D. 436, 443.

“Now the question here is, whether or not the trade-mark in question owes its value to the personal skill of Mr Darst as a manufacturer. If it does, it does not pass by assignment, for the public must not be deceived into buying goods which, though bearing his trade-mark, are not the product of his peculiar skill.” *Swezey, in re*, 62 How. Pr. 215, 219.

A. organized an orchestra, giving it name of Fadettes and hired and paid members. He afterward sold to B. all his right, title, and interest in and to organization “together with all rights acquired in and to the establishment, name, and trade-mark in the words,” composing the name, and then ceased to have any connection with it. The other members of the orchestra were not parties to the contract and did not agree and were not bound to continue to play under the new management of B. but subsequently withdrew from the organization and formed a corporation under name of “Fadettes.” Held that name was not assignable; opinion by Knowlton and dissent by Lathrop. *Messer v. The Fadettes*, 168 Mass. 140.

“But where the trade-mark consists of a name, how far it is capable of assignment is a more difficult question. We think that the answer to this question depends upon the effect which the use of the name in each particular instance is shown to have upon the minds of the public. If it leads the public to believe that the particular goods are, in fact, made by the person whose name is thus stamped upon them, or in whose name they are advertised, whereas they are, in fact, made by another person, then such a use of the name will not be protected by the courts; for to do so would be to protect the perpetuation of a fraud upon the public.” *Skinner v. Oakes*, 10 Mo. App. 45, 56.

6. A. An assignee or successor of a trade-mark might be obliged to so indicate to the public the fact that he is assignee that they may not be misled.

See. V 1. 116.

Complainant was assignee of “Aleutian Islands Fishing & Mining Co.” and used on a label the following statement: “Packed at Karluk, Kodiak Island, Alaska, by the Aleutian

Islands Fishing & Mining Company, San Francisco, California"; such statement being false, the complainant was not entitled to relief, although the statement was corrected by additional label on top of can after suit was brought. *Alaska Packers' Ass'n v. Alaska Imp. Co.*, 60 Fed. R. 103.

"To correct the misstatement of the label, complainant, since the commencement of the action, has attached a circular label to the top of the can, stating that the salmon is packed by it as assignee of the Aleutian Islands Fishing & Mining Company. I do not think this cures the defect of the original label. It is the facts which existed before the suit was brought which make the cause of action and entitle to relief." *Alaska Packers' Ass'n v. Alaska Imp. Co.*, 60 Fed. R. 103.

"The complainant, Stachelberg, obtained, by assignment from one Asher Bijur, of New York, the exclusive right to use this trade-mark ('La Normandi,' for cigars), and he subsequently conveyed the right to the firm of Stachelberg & Co., the complainants. . . . Whatever may be thought of the remaining defences, there is one point which we think is well taken, and therefore fatal to any relief prayed for in the bill. In the use of the trade-mark the complainants do not state that it was obtained by assignment or purchase from A. Bijur. Bijur originated the trade-mark, and it thus became a sign of the quality of the article he sold, and an assurance to the public that it was the genuine product of his manufacture. . . . Now, in order that the public may not be deceived, it is essential that an assignee or purchaser of the original proprietor should indicate in the use of the trade-mark that he is assignee or purchaser—otherwise the public are misled into purchasing the goods of another manufacturer or vendor as those of the original proprietor. . . . And so these complainants, in failing to give notice that they are the purchasers and assignees of the trade-mark from A. Bijur are practising the same deception toward the public which they charge against the defendant. The fact that the name, 'M. Stachelberg,' is attached to the trade-mark, can no more relieve the complainants of the charge of misrepresentation as to the public than the use of the name 'E. Ponce,' or 'E. P.' can relieve the defendant of such a charge. It is the use of the fanciful words, 'La Normandi,' or words of substantial similarity, that is calculated to mislead." *Stachelberg v. Ponce*, 23 Fed. R. 430.

"We think, however, it is the duty of the complainants to the

respondent, as well as to the public, to refrain from using the labels in such manner and form as might lead the public to suppose that the goods packed by them were packed by the respondent. They should strike from their letter heads, circulars, and labels any words indicating that the goods were prepared by John Winslow Jones, and, if they use his name, should add such words as clearly indicate that the goods are not prepared by him, but by them as his successors." *Symonds v. Jones*, 82 Me. 302.

B. But this is necessary only when its use otherwise would be deceptive.

See IV. 7. 107. *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137.

See X. 1 A (1). 219. *Kidd v. Johnson*, 100 U. S. 617.

See X. 1 A (2). 222. *Carmichel v. Latimer*, 11 R. I. 395.

See X. 5. 233. *Hoxie v. Chaney*, 143 Mass. 592.

"Benedictine," name for cordial passed by assignment to complainant. It was not necessary to designate fact of assignment as the product had been manufactured for 400 years. *Bauer & Co. v. La. Soc. Anon. de la Distillerie de la Liqueur Benedictine de l'Abbaye de Fecamp*, 120 Fed. R. 74.

"The difference between 'Joseph Dixon & Co.,' as printed on the labels, and 'The Joseph Dixon Crucible Co.' is not of such a character as to destroy the plaintiff's right to equitable relief. Joseph Dixon & Co. is the name of the firm that has been for many years lawfully engaged in the manufacture of Dixon's stove polish. Since the formation of the new company and the death of Mr. Dixon in 1868, the name on the wrapper has not been changed. There is nothing here to indicate any attempt at deception or imposition. The trade-mark designates the place truly where the goods are put up and sold, and with sufficient certainty the ownership thereof." *Dixon Crucible Co. v. Guggenheim*, 2 Brew. 321, 341.

"But then it is said that the use of this label by the plaintiff is a fraud . . . because it holds out that the article is manufactured by Taylor, when it is, in point of fact, manufactured by the plaintiff, Taylor having ceased to have anything to do with the business. But to take the last point first, the firm of Taylor & Co. having originally made this article, and it being now made by the persons who have *bona fide* acquired the business, they

are quite justified in using the name of the old firm. It would be going too far to say that this is a misrepresentation by the plaintiff, when he only uses the name which he has bought the right to use." *Edelston v. Vick*, 23 Eng. L. & Eq. 51, 56.

"Nor do we think the position tenable that the complainants are not entitled to relief because they are only assignees of the trade-mark, and use it without designating themselves assignees. We do not perceive how their using the mark after they bought it without giving notice that they are not the original owners of it, can be a fraud upon the public, of which the defendant can avail himself." *Fulton v. Sellers*, 4 Brew. 42, 48.

"The plaintiff, Jennings, was one of the firm I. S. Johnson & Co. In stating on the label that the liniment is prepared by I. S. Johnson & Co., he merely retains the name of the firm of which he was a member. I cannot see how the public are deceived or injuriously affected by such a course. It is not uncommon, under such circumstances, to retain the old firm name." *Jennings v. Johnson*, 37 Fed. R. 364.

"All that the public or the trade cared to know was that the goods were the production of their (Rogers Bros.), skill and experience. That fact, as it seems to us, clearly appears. The further fact that the petitioners furnished capital and machinery, employed and paid laborers, and sold the goods, is entitled to but little weight so far as this question is concerned; although it shows that, in another sense, the petitioners were the manufacturers of the goods." *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 458; 12 Am. R. 401.

"On the contrary, it is but common experience that articles bearing a particular name are not regarded by the public as being the actual manufacture of the person whose name they bear." *Oukes v. Tonsmierre*, 49 Fed. R. 447, 451.

7. A trade-mark or trade-name may have come to designate a particular locality, and a transfer of that locality, by lease or otherwise, may carry with it right to use the mark or name.

See IX. 1 B. 206; X. 4. 231.

"It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment, rather than of the

proprietor. A trade-mark of this description is of no value to the original proprietor because he could not use it without deception, and therefore would not be protected in its exclusive enjoyment." *Atlantic Milling Co. v. Robinson*, 20 Fed. R. 217, 218.

XI. INFRINGEMENT.

1. An infringement of a trade-mark is an imitation such as would be likely to deceive the ordinary customer in the usual course of trade in the purchase of goods of one person as those of another.

See VIII. 1. 151; cases cited.

See VIII. 2 A. 187.

See XI. 4 A. 245.

“Two trade-marks are substantially the same in legal contemplation, if the resemblance is such as to deceive an ordinary purchaser, giving such attention to the same as such purchaser usually gives and to cause him to purchase the one supposing it to be the other. . . . For the purpose of establishing a case of infringement, it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the articles sold by the party to whom the right to use the trade-mark belongs.” *Amoskeag Mnf. Co. v. Trainer*, 101 U. S. 51, 63, 66.

“We may say, generally, that a similarity which would be likely to deceive or mislead an ordinary unsuspecting customer, is obnoxious to the law. Judged by this standard, it seems to me that, considering the nature and circumstances of this case, the name ‘Cellonite Manufacturing Company’ is sufficiently similar to that of ‘Celluloid Manufacturing Company’ to amount to an infringement of the complainants’ trade-name.” *Celluloid Mnf. Co. v. Cellonite Mnf. Co.*, 32 Fed R. 94, 97.

“Now, an intending purchaser is not bound to be careful. Even if he has the opportunity of comparing the labels and wrappings, he is not bound to do so. And, indeed, where an article that costs but a few cents is offered upon the market, it is a matter of common knowledge, of which the court will take notice, that an intending purchaser pays little or no attention to it.” *Centaur Co. v. Robinson*, 91 Fed. R. 889, 891.

“Even in the case of a valid trade-mark the similarity of brands must be such as to mislead the ordinary observer.” *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, 467.

“The infringement of trade-marks is the violation by one person of an exclusive right of another person in the use of a word, mark, or symbol.” *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651, 659.

“The rule is well settled that to enable the proprietor of a trade-mark to relief against an illegal appropriation, it is not necessary that the imitation should be so close as to deceive persons seeing the two marks side by side; it is sufficient if there is such a degree of resemblance that ordinary purchasers, using ordinary caution, are likely to be deceived.” *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. R. 823, 826; 23 Blatchf. 46.

“Taking this as the true rule, and applying it in this case, I am forced to the conclusion that the ordinary mass of purchasers would be deceived, after paying ordinary attention when purchasing, into the belief that they were buying the tobacco of complainant, when in fact they were getting the tobacco of the defendant. Ordinary care in this connection, means the care that men ordinarily exercise when buying chewing tobacco.”

The marks were stars of different size and color. *Liggett & Myer Tobacco Co. v. Hynes*, 20 Fed. R. 883, 886.

“The ease with which thoughtless purchasers are misled by the nomenclature of trade, adopted to convey false and misleading impressions to eye and ear, induces the courts to be diligent and zealous in protecting such purchasers from deception, and honest traders from dishonest competition.” *Little v. Kellam*, 100 Fed. R. 353, 354.

“What degree of resemblance is necessary to constitute an infringement is incapable of exact definition as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers buying with ordinary caution are likely to be misled.” *McLean v. Fleming*, 96 U. S. 245, 251.

Court does not consider whether dealer will be confused, but whether consumer will be. *National Biscuit Co. v. Baker*, 95 Fed. R. 135.

“The trade-name differs from the trade-mark in this: that one appeals to the ear more than to the eye. The advertisements of the name were for the purpose of having the intended purchaser

ask for 'Gold Dust,' without his having any knowledge of the character of the label on the package he was to receive, and in this sense the fact that the infringer of the name used different devices and symbols would have no great force. *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.*, 102 Fed. R. 327, 331.

"A specific article of approved excellence comes to be known by certain catchwords easily retained in memory, or by a certain picture which the eye readily recognizes. The purchaser is required only to use that care which persons ordinarily exercise under like circumstances. He is not bound to study or reflect; he acts upon the moment. He is without the opportunity of comparison. It is only when the difference is so gross that no sensible man acting on the instant would be deceived, that it can be said that the purchaser ought not to be protected from imposition. Indeed, some cases have gone to the length of declaring that the purchaser has a right to be careless, and that his want of caution in inspecting brands of goods with which he supposes himself to be familiar ought not to be allowed to uphold a simulation of a brand that is designed to work fraud upon the public." *Pillsbury v. Flour-Mills Co.*, 64 Fed. R. 841, 847.

"The imitation of a man's trade-mark, in a manner liable to mislead the unwary, cannot be justified by showing, either that the device or inscription upon the imitated mark is ambiguous and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might be misled." *Singer Mfg. Co. v. Loog*, 8 App. Cas. 15, 18.

"The complainant is entitled to relief if the brand used by the defendants sufficiently resembles the complainant's brand to be mistaken for it, and the defendants adopted their brand for the purpose of selling their kegs as the kegs of the complainant, or for the purpose of enabling retail dealers to do so, and the complainant has been injured by this fraud or is likely to be injured by it." *Southern White Lead Co. v. Cary*, 25 Fed. R. 125, 126.

"The proper question should be, not differences, but points of resemblance; not the utmost vigilance of purchasers, but ordinary observation." *Swift v. Dey*, 4 Robertson, 611, 612.

"A tradesman, to bring his privilege of using a particular mark under the protection of Equity, is not bound to prove that it has been copied in every particular by another. It is enough for him to show that the representations employed bear such a resemblance to his as to be calculated to mislead the public gener-

ally who are purchasers of the article, and to make it pass with them for the one sold by him. *Walton v. Crowley*, 3 Blatchf. 440, 447.

The similarity in sound as well as of appearance of trade-marks may constitute infringement. "Yusea," on incandescent lights infringed by "U-C-A." *Welsbach Light Co. v. Adam*, 107 Fed. R. 463.

2. Although there may be some difference in the two marks, yet if the general characteristics are such as are likely to deceive the ordinary purchaser there is an infringement.

See XI. 1. 239.

"When the entire trade-mark is copied, the case is free of difficulty, as the rule is universal that the infringer is liable; but the question is, when may it be said that a trade-mark has been taken by another? Answers to that question are found in several cases, of which no one is more satisfactory than that given by the Master of the Rolls in a recent case. He says that a trade-mark to be taken need not be exactly copied, nor need it be copied with slight variations, but it must be a substantial portion of the trade-mark; to which he adds that it has sometimes been called the material portion, but that, as he states, means the same thing, and he then remarks that it means the essential portion of the trade-mark, and finally concludes the subject by saying that 'what the court has to satisfy itself of is that there has been an essential portion of the trade-mark used to designate goods of a similar description.'" *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 65. (From dissenting opinion of Clifford, J.).

"No one who has counterfeited a legitimate trade-mark and applied the spurious symbol in competition with the genuine can avoid the charge of infringement by showing that the false mark has in practice been so accompanied, on labels, capsules, or otherwise, by trade-names, designations, descriptions, or other accessories, not forming part of it, as to render it unlikely that the public has been deceived. Such a showing, while it may affect the nature or measure of the relief to be granted, cannot defeat a suit for infringement." *Bass, Ratcliffe & Gretton, Ltd., v. Feigenspan*, 96 Fed. R. 206, 212.

"While there is a difference between the two, there is still such similarity as we think would lead many purchasers — the

consumer, though not likely the general trade-dealer—to purchase one for the other. It is against the probability of such impositions upon the consuming class of the public that courts will extend their protection.” *Improved Fig Syrup Co. v. California Fig Syrup Co.*, 54 Fed. R. 175, 178.

Use of name of proprietor on trade-mark does not avoid infringement. *Leonard v. White's Golden Lubricator Co.*, 38 Fed. R. 922.

“To constitute an infringement exact similarity is not required; there may be an infringement without it. . . . Nor need the resemblance be such as would deceive persons seeing the two trade-marks placed side by side. . . . The plaintiff is entitled to protection if the trade-mark of defendant would deceive the ordinary purchaser, purchasing as such persons ordinarily do.” *Liggett & Myer Tobacco Co. v. Hynes*, 20 Fed. R. 883, 884.

“I am well satisfied that a technical trade-mark, although not a fac-simile of another, may, nevertheless, be so used by a rival manufacturer as to imitate another's trade-mark, and when such use actually deceives the public a court of equity will afford relief.” *National Biscuit Co. v. Swick*, 121 Fed. R. 1007, 1011.

“It has been said that it is the resemblances that should be looked at, rather than the differences. But the existence of the latter negatives the former, and it is necessary to take both into view, in order to get a correct picture of the whole.” *Proctor & Gamble Co. v. Globe Refining Co.*, 92 Fed. R. 357, 364.

There is an infringement although one uses his own name in connection with trade-mark.

“Roberts Parabola Needles,” infringed by “William Clark & Sons Parabola Needles.” *Roberts v. Sheldon*, 8 Biss. 398.

Singer made a sewing-machine to which he gave his own name; it became known by that name. He afterwards took other persons into partnership with him for the sale of the machines known as the “Singer” sewing-machines, and which were made in great variety with many modifications, but though not protected by patents were established in public favor under that name. Wilson sold sewing-machines and advertised among others “Singer” sewing machines, but used his own trade-mark on the machines and expressly stated in his advertisements that the machines sold by him were manufactured by himself. Held, that this nevertheless constituted a wrongful invasion of rights of Singer, and Wilson could be restrained by injunction. *Singer Machine Manufacturers v. Wilson*, 3 App. Cas. 376; reversing 2 Ch. D. 434.

Although defendant used his own name after word "Glenfield" on starch which he had no right to use, injunction on ground of unfair trade. *Wotherspoon v. Currie*, L. R. 5 H. L. 508.

In line with the last three cases see XI.15, 273, *Battle v. Finlay*, 50 Fed. R. 106; *Menendez v. Holt*, 126 U. S. 514, 277.

3. There is no infringement of a trade-mark where there is only a general resemblance not calculated to deceive the ordinary purchaser.

See XI. 4 A. 250. *Royal Baking Powder Co. v. Davis*, 26 Fed. R. 293

"The law is not made for the protection of degenerates and paranoiacs, but for the general public composed of men with ordinary common sense and with faculties unimpaired. The task of the court, therefore, will be accomplished if it confines its attention to those similarities which are likely to deceive the ordinary purchaser." *Hilson Co. v. Foster*, 80 Fed. R. 896, 898.

"I do not regard the words 'tempest' and 'hurricane' as so similar as to warrant the conclusion that the public is liable to be misled into believing the lamps are of the same manufacture." *Hurricane Patent Lantern Co. v. Miller*, 56 How. Pr. 234, 235.

"It does not suffice to show that persons incapable of reading the labels might be deceived by the resemblance. It must appear that the ordinary mass of purchasers, paying that attention which such persons generally do in buying the article in question, would probably be deceived." *Partridge v. Menck*, 2 Sandf. Ch. 622, 625; 2 Barb. Ch. 101.

The complainant by virtue of a trade-mark of a conventional shaped diamond figure on a brand of crushed steel is not entitled to the exclusive right to the word "diamond"; and such trade-mark is not infringed by figure of a radiant diamond gem. *Pittsburg Crushed Steel Co. v. Diamond Steel Co.*, 85 Fed. R. 637.

"The question is this, as in every other case, whether there is such a resemblance between the two as to deceive a purchaser using ordinary caution. The difference is so palpable here that no one can be deceived. . . . The court is not bound to interfere where ordinary attention will enable purchasers to discriminate between the trade-marks used by different parties." *Popham v. Cole*, 66 N. Y. 69, 75; reversing 14 Abb. Pr. n. s. 206.

Where complainant has right to use "Hygeia" on its mineral water, and respondent had right to use it in the combination "Waukesha Hygeia Mineral Springs," it was no infringement for

the respondent to make the word "Hygeia" more conspicuous than the other words. *Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co.*, 63 Fed. R. 443.

4. A. In order to obtain protection on the ground of unfair trade the imitation should be such as would be likely to deceive the ordinary purchaser in the ordinary course of business, although there may not be exact similitude.

See XI. 1, 239, 2, 242, and 3, 244.

See VIII. 1 F. 173, and G. 181.

"Benedictine," a cordial, was made for three hundred years at monastery at Fecamp, Normandy. After Revolution complainant's predecessor, who had rightfully acquired receipts, manufactured the liqueur and formed the present corporation. The liqueur was put up in peculiar bottles, with distinctive labelling and wording. Respondent in Chicago put up a similar preparation, calling it "Liqueur de St. Benedict," in similar bottles and labels. Injunction on ground of unfair trade. *Bauer & Co. v. La Soc. Anon. de la Distillerie de la Liqueur Benedictine de l'Abbaye de Fécamp*, 120 Fed. R. 74.

Respondent appellant in Chicago enjoined from imitating labels, bottles, and printing of complainant from their liqueur "Chartreuse," making minor changes and substituting word "Chasseuse" for "Chartreuse." Case of unfair trade. *Bauer & Co. v. Order of Carthusian Monks*, 120 Fed. R. 78.

Respondent appellant enjoined from imitating bottles, labels and printing of complainant for its bitters called "Angostura," and from using the word "Angostura." *Bauer & Co. v. Siegert*, 120 Fed. R. 81.

"It is alleged that the word 'Angostura' is not the subject of a trade-mark or a trade-name. We cannot sustain the contention. For upwards of half a century no town has existed by that name; and even if the old town of Angostura were still known by that name, the appellant would not be permitted by fraudulent imitation to deceive the public and wrong the appellees by palming off its goods as their goods." *Bauer & Co. v. Siegert*, 120 Fed. R. 81, 84.

"Conformity of one label to another sufficiently to attract and deceive is not excused by ability to analyze the offending label and point out differences which, if known and recognized, would avoid confusion. The ensemble does the mischief; the usual

purchaser neither abstracts nor analyzes for the purpose of differentiation and judgment." *Cantrelli & Cochrane, Ltd., v. Butler*, 124 Fed. R. 290, 291.

"It is not necessary that the resemblance should be such as would deceive first or intelligent purchasers. It is sufficient if it be calculated to deceive the unwary, the incautious, or the ignorant purchaser. Neither need the resemblance be so great that one would be deceived who should see the labels placed side by side. If an ordinary purchaser, looking at the article offered to him, would naturally be led, from the label attached to it, to suppose it to be the product of a rival manufacturer, and would purchase it in that belief, the court will enjoin the use of such article as fraudulent." *Cauffman v. Schuler*, 123 Fed. R. 205, 206.

Where complainant's packages and labels for Castoria are not exactly imitated, but the resemblance is so great as to be likely to deceive, an injunction will issue. "While it is true that, upon an actual comparison of the wrappers side by side, substantial differences will be found, and that no one with knowledge would, after such examination, be deceived, still it will be perceived at once by a mere inspection of the packages of the complainant and defendant that they are so much alike in general appearance that the one is apt to be mistaken for the other, and that a close inspection is necessary to distinguish them. If we look at the two wrappers we find that the color of the paper is the same; that there is a similarity in the type used and their general arrangement, and that their size and peculiar characteristics are changed at similar intervals of space; that upon each wrapper there is affixed a signature in script; and that at the bottom of each there is a dark band, upon which words are printed in white letters." *Centaur Co. v. Killenberger*, 87 Fed. R. 725, 726.

Where party adopts a label with name "Castoria," it having by expiration of patent become public property, he will be enjoined from use of words "New Label," as it might lead the public to believe that the old proprietor had adopted a new label. *Centaur Co. v. Marshall*, 92 Fed. R. 605.

"The embellishments of the label are of the same character, and they are arranged in the same form and printed in the same Gothic type as the labels of the Plaintiffs. The same colors are, moreover, used, and there is a similar scroll or border. To the general eye, therefore, they resemble the plaintiffs' labels, al-

though upon a minute examination differences may be detected." *Edelston v. Vick*, 11 Hare 78, 84.

"The true test, we think, is whether the resemblance is such as that it is calculated to deceive, and does, in fact, deceive the ordinary buyer, making his purchases under the ordinary conditions which prevail in the conduct of the particular traffic to which the controversy relates. No inflexible rule can be laid down. Each case must in a measure be a law unto itself." *Fischer v. Blank*, 138 N. Y. 244, 252.

Complainant had put up for years a chicory substitute for coffee in cylindrical packages of red paper labelled "Frank Chicory"; respondent entered market with same class of goods, similarly packed, and using name "Frank"; held infringement. *Franck v. Frank Chicory Co.*, 95 Fed. R. 818.

"Where the trade-mark consists of a picture or symbol, or in any peculiarity in the appearance of the label, the imitation must be such as to amount to a false representation, liable to deceive the public and enable the imitator to pass off his goods as those of the person whose trade-mark is imitated. And when there is such an absence of resemblance that ordinary attention would enable customers to discriminate between the trade-marks of different parties, the court will not interfere." *Hier v. Abrahams*, 82 N. Y. 519, 523; 37 Am. Rep. 589.

Complainant purchased distillery conducted under name of "West End Distillery Co.," also certain valuable brands as "Ky.'s Criterion" and "Honeymoon." Respondents, sons of vendor, began business, labelling their brands "East End Distillery Co.," and using brands "Ky.'s Criterion," and "Honeycomb." Preliminary injunction issued against use of brands "Ky.'s Criterion," and "Honeycomb." *Kentucky Distilleries & Warehouse Co. v. Wathen*, 110 Fed. R. 641.

"A casual or inattentive observer, as most purchasers are, would be very likely to accept one in place of the other. . . . It is by this peculiar form, combination, and location of the words, rendering one label a close resemblance of the other, that deception and injury would be caused. And when that is the nature of the device resorted to, although the defendant may employ the words he has a legal right to select and use, yet he violates the right of the plaintiff by so printing, placing, and arranging them as to produce the conclusion that the manufacture is that of the other party." *Kinney Tobacco Co. v. Maller*, 53 Hun (N. Y.), 340, 343.

“Elaborate descriptions of the points of resemblance or those of difference are, taken by themselves alone, always unsatisfactory. The eye, at a glance, takes in the whole of one exhibit and the whole of another, and the comparison thus made of the two is the surest and the only satisfactory way of satisfying the judgment as to the existence of the alleged deceptive imitation. *Lorillard Co. v. Piper*, 86 Fed. 956. With an exhibit of a bottle both of the complainant and defendant before me, dressed up in the style used by both, ready for sale, I can, of course, easily distinguish one from the other; but the resemblance between the two is so close that the consumer, without close attention, could easily be deceived into accepting the mineral water of the defendant when he intended to purchase that of the complainant.” *Kronthal Waters v. Becker*, 137 Fed. R. 649, 653.

“It is true that the defendants have substituted their name as the manufacturers, but that alone will not relieve the defendants from the charge of an attempted imitation of the labels and wrappers of the plaintiff for the purpose of misleading purchasers.” *Lea v. Wolf*, 13 Abb. Pr. n. s. 389, 391.

“What is called the general ‘get-up,’ which is an expression used by some of the witnesses, is so similar that obviously the one might easily be mistaken for the other. Of course in all these cases, there are differences as well as resemblances, and the question, so far as the packages are concerned, must always be decided by contrasting the striking resemblances with the striking differences. Now the only difference which strikes me is this: That Goodwin has substituted the word ‘Goodwin’ in large letters for ‘Sunlight.’ That is the whole difference which catches the eye. Then look at the resemblances; look at the paper; look at the printing; look at the blank space and the catch words; look at the whole thing, and it is impossible not to arrive at the conclusion, not only that one was intended to pass for the other, but that that intention has been realized.” *Lever v. Goodwin*, 36 Ch. D. 1, 8.

“Argument to show that the name of the pills, as given in the trade-mark of the respondent, was of a character to mislead and deceive, is scarcely necessary as they are *idem sonans* in the usual pronunciation; nor can it be doubted that the form of the box containing the pills, and the general appearance of the wrapper which surrounded it, were calculated to have that effect.” *McLean v. Fleming*, 96 U. S. 245.

“Much must depend, in every case, upon the appearance and

special characteristics of the entire device ; but it is safe to declare, as a general rule, that exact similitude is not required to constitute an infringement, or to entitle the complaining party to protection. If the form, marks, contents, words, or the special arrangement of the same, or the general appearance of the alleged infringer's device, is such as would be likely to mislead one in the ordinary course of purchasing the goods, and induce him to suppose he was purchasing the genuine article, then the similitude is such as entitles the injured party to equitable protection, if he takes reasonable measures to assert his rights and prevent their continued invasion." *McLean v. Fleming*, 96 U. S. 245, 253.

"Difficulty frequently arises in determining the question of infringement, but it is clear that exact similarity is not required, as that requirement would always enable the wrong-doer to evade responsibility for his wrongful acts. Colorable imitation, which requires careful inspection to distinguish the spurious trade-mark from the genuine, is sufficient to maintain the issue; but a court of equity will not interfere, when ordinary attention by the purchaser of the article would enable him at once to discriminate the one from the other. Where the similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary purchaser in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right to redress, if he has been guilty of no laches. *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C. 599; *Coddington Dig.*, 109; *McAndrew v. Bassett*, 4 De G. J. & S. 380." *McLean v. Fleming*, 7 L. T. R. n. s. 768; 96 U. S. 245, 255.

"Two trade-marks are substantially the same in legal contemplation if its resemblance is such as to deceive an ordinary purchaser, giving such attention to the same as such a purchaser usually gives, and to cause him to purchase the one supposing it to be the other. *Gorham Company v. White*, 14 Wall. 511." *McLean v. Fleming*, 7 L. T. R. n. s. 768; 96 U. S. 245, 256.

"Defendant is a manufacturer, and sells only to the trade. By its salesman it offers its soap powder in competition with complainant's, as an article equal or superior thereto, and at a less price. Undoubtedly, no one who bought from defendant was ever deceived. No effort was ever made to delude the trade into the belief that defendant's salesman were selling complainant's goods. But equity regards the consumer as well as the middleman. It is to him, more than to the jobber or wholesale pur-

chaser, that the various indicia of origin with which merchants dress up their goods appeal; and courts will not tolerate a deception devised to delude the consuming purchaser by simulating some well-known and popular style of package." *N. K. Fairbank Co. v. R. W. Bell Mfg. Co.*, 77 Fed. R. 869, 875.

"In regard to the last point made, that by reason of the defendants using their own name on the wrapper or envelope, the public are not deceived, it would, perhaps, be enough to say, that when goods acquire a specific name, the purchaser rarely looks to see who has manufactured goods by that name." *Roberts v. Sheldon*, 8 Biss. 398, 401.

"I do not think the use of the words 'Coral Baking Powder' is in itself an infringement of plaintiff's trade-mark, 'The Royal Baking Powder.' The difficulty is with the similarity of the labels upon which the words are used. The general arrangement of the words being the same, the devices upon the cans being very much alike, and the labels of the same color and general appearance, I think purchasers might be very easily deceived into buying the one for the other." *Royal Baking Powder Co. v. Davis*, 26 Fed. R. 293.

"A competing business firm is bound to deal fairly in placing its rival article upon the market, and if it clearly appears that the defendants have closely imitated the plaintiff's labels and style, and have done obvious damage to the latter's business through the unlawful business methods employed, the plaintiffs are entitled to relief upon the ground of fraud. . . . The only material difference between the two labels in design and appearance exists in the colors, and this is no defence." *Schmidt v. Brieg*, 100 Calif. 672, 680.

Complainants in Angostura, Venezuela, making bitters, cannot enjoin defendants using "Angostura" on bitters for two reasons:

1st, the complainants fraudulently represent on advertising circulars, by alleged statements of chemists, that their bitters are free from intoxicating ingredients, — when, in fact, they contain forty per cent of alcohol.

2d, the bitters sold by defendants are made of a bark common in Venezuela, called Angostura bark; Angostura is name of a city in that country. It was registered as a trade-mark in 1877, by the firm of C. W. Abbott & Co., who made these bitters, and had carried on the business in Baltimore for fifty years. Moreover, on their labels and circulars the firm called especial attention to the fact that these bitters were sold by them, so that the

public would not be likely to be deceived into thinking that they were made by Siegert. *Siegert v. Garofoli*, 139 Fed. R. 917.

Respondent enjoined from putting up laxative tablets in size, shape, and style, and manner of lettering and labelling with words "Candy Cathartic," and "Cascara," instead of "Cascarets," so nearly like those of complainant as to lead to deception. There were differences, but the resemblances were too marked. Held, also, "Candy Cathartics" a fancy name. *Sterling Remedy Co. v. Gorey*, 110 Fed. R. 372.

Packages of soap marked "Old Mill Soap," "Made by Swift & Co., Chicago," with picture of old mill, infringed by package marked "Old Stone Mill Soap," and "Made by Crown Mfg. Co.," with picture of old mill, there being similarity in type, letters and appearance of package. *Swift v. Brenner*, 125 Fed. R. 826.

"The proper question should be, not differences, but points of resemblance; not the utmost vigilance of purchasers, but ordinary observation. The value of the goods to be sold, and the intelligence of the persons dealing in and consuming them, besides other circumstances, are also to be taken into account in determining the adaptability of a simulated trade-mark to deceive purchasers. . . . The great principle laid down and applied in all the cases of trade-marks is, that if persons of ordinary understanding purchasing the article would be placed on their guard, and would be led to inquire whether they were being deceived by the article they were purchasing, that fact is sufficient for the court to refuse its interference." *Swift v. Dey*, 4 Robt. 611, 612, 615.

Complainant had on his packages a shield with words "Smoke and Chew" in alternate red and yellow lettering, and name "Sweet Lotus." Defendant had on his packages a shield of the same curvature, words "Smoke and Chew," with same style of colors in lettering, and name "Peach Blossom"; a preliminary injunction granted. *Wellman & Dwire Tobacco Co. v. Ware Tobacco Works*, 46 Fed. R. 289.

"The entire wrappers and labels so closely resemble each other that dealers and purchasers would be readily misled and deceived. The differences, on critical examination, are capable of discernment and description, but to the eye of an ordinary person who knew the complainant's packages of tobacco, and never had seen the defendant's, labelled as they are, and not knowing of any such kind of tobacco in the market, would be misled." *Wellman & Dwire Tobacco Co. v. Ware Tobacco Works*, 46 Fed. R. 289.

B. There is no infringement on ground of unfair trade where there is only a general resemblance not calculated to deceive, or where there is some sign or name distinguishing the origin of the goods.

See XI. 4 A. 245.

“Notwithstanding plaintiff has no real or legal trade-mark, if the defendants had intentionally simulated the particular device or symbol employed by plaintiff on his labels, and such simulation was calculated to deceive ordinarily prudent persons, and did deceive such persons, the plaintiff would be entitled to protection against the consequences of such deception, not because of his device or symbol being a trade-mark, in the legal sense of that term, but because of the fraud and deception practised by the defendants upon the plaintiff and the public. In this case, however, the labels used by the plaintiff and defendants respectively are so entirely dissimilar that we do not think it possible for any person of ordinary prudence and caution to have been deceived by the defendants’ label, and thereby induced to buy their remedy, when the purchaser desired and intended to buy the plaintiff’s remedy.” *Alff v. Radam*, 77 Tex. 530, 541.

“The plaintiff had established a large and lucrative trade in a superior brand of soap which it called and marked ‘Old Country Soap.’ The defendant made and sold a soap which it called and branded ‘Our Country’s Soap.’ The packages of the two manufacturers were of the same size and shape, but the dress of the defendant’s product bore the defendant’s name and its place of manufacture, and was so unlike that of the plaintiff that it was not likely to deceive a common purchaser who exercised ordinary care. Held, the use of the term ‘Our Country’ as a brand or name for the soap under these circumstances did not constitute unfair competition.” Syllabus by court. *Allen B. Wrisley Co. v. Iowa Soap Co.*, 122 Fed. R. 796.

A plain red triangle on an elliptical figure, with black border and red lace-work design, bearing the words “Bass & Co.” and “Pale Ale,” not infringed by circular label bearing figure of strap and buckle stamped with red triangle having large white “Z” thereon. *Bass, Ratcliffe & Gretton, Ltd., v. Henry Jettner Brewing Co.*, 87 Fed. R. 468.

The label of respondent on “Castoria” was so unlike that of complainant that court did not issue injunction.

“The conclusion is irresistibly forced upon the mind that such

a buyer cannot be deceived by it into the purchase of the product of the appellees for that made by the appellant, and that there was no error in the refusal of the court to enjoin its use before the final hearing of the case." *Centaur Co. v. Marshall*, 97 Fed. R. 785; affirming 92 Fed. R. 605.

Circular paper label, with black letters on gilt ground, words "J. & P. Coats, Best Six Cord" in gilt band around border and in centre symbol "200 yds," and number of thread, on spool of thread, not infringed by label similar in shape with words "Merrick Thread Co.," number of thread in gilt band upon the border, and in centre words "Best Six Cord" enclosing a star. *Coats v. Merrick Thread Co.*, 147 U. S. 562; affirming 36 Fed. R. 324.

Where a party plainly and conspicuously places his name on a label although there may be a general resemblance to that of a complainant such as to deceive a careless purchaser, the court is not likely to grant injunction. *Coats v. Merrick Thread Co.*, 149 U. S. 562.

"The differences are less conspicuous than the general resemblance between the two. At the same time, they are such as could not fail to impress themselves upon a person who examined them with a view to ascertain who was the real manufacturer of the thread." *Coats v. Merrick Thread Co.*, 149 U. S. 562, 567.

"Defendant's affidavits tend to show that an ordinary buyer purchasing in the usual manner is not deceived by any simulation in defendant's manner of dressing its goods into believing that he is buying the goods of complainant. The similarities pointed out by the complainant in view of the employment of the trade-mark itself as a distinctive identification is no deception upon the public, if proper consideration be given upon this motion to the opposing affidavits. It does not appear that any ordinary purchaser has been misled. It is not clear, from the large number of exhibited cards with hooks and eyes attached, many of them apparently like complainant's cards, but without its trade-mark, or any simulation thereof, that defendant's article is a fraud upon the complainant." Temporary injunction denied. *De Long Hook & Eye Co. v. Francis Hook & Eye Fastener Co.*, 118 Fed. R. 938, 940. Injunction on final hearing. 139 Fed. R. 146.

A cigar band had some similarities to claimant's claimed as trade-mark, but held not to be unfair trade.

"It is likely enough that a near-sighted man, or a man with impaired vision, unaided by glasses, or a man in so much of a hurry as to be unwilling to stop for a careful look, might mistake one band for the other, but these classes may be disregarded in applying the test of similarity. Certainly an ordinarily intelligent man, able to see and to read, and willing to take a few seconds' time to examine the two bands, would inevitably discover that one of the banded cigars was made by the complainant and the other by the defendant." *E. Regensburg & Sons v. Juan F. Portuando Cigar Mfg. Co.*, 136 Fed. R. 866, 869.

Where packages of tobacco were so dissimilar that it did not appear to court that there was improper imitation, preliminary injunction refused. *Gail v. Wacherbath*, 28 Fed. R. 286.

The label on a lubricating oil, printed in black, bearing letters "Three in One" above a large red figure 1 enclosing in white the figure 3 and word "on," is not infringed by a label of different size on similar oil, printed with words differently arranged, partly in red and partly in black, headed "Big Four," with figure 4 prominently displayed in black on red background, and words "lubricator," "big," and "rust preventive," running across it. *G. W. Cole Co. v. American Cement & Oil Co.*, 130 Fed. R. 703.

Respondent not enjoined from selling confectionery, called "liquorice pastilles," in diamond shape, similar in size and shape to that of complainants, and put up in boxes of similar size but differently marked, and the candy stamped "W" instead of "H. H." The general similarity was not such as to deceive, and the shapes were common in the trade. *Heide v. Wallace*, 135 Fed. R. 346; affirming 129 Fed. R. 649.

"It is not enough that there may be a possibility of deception. The offending label must be such that it is likely to deceive persons of ordinary intelligence. . . . In trade-marks, in order to entitle the plaintiff to relief by injunction, the resemblance must be such that ordinary purchasers dealing with ordinary caution are likely to be misled. . . . The court is not bound to interfere where ordinary attention will enable the purchaser to discriminate. . . . In that part of plaintiff's trade-mark, which he is entitled to claim as such, there is no resemblance whatever. They differ in style, color, and device." *Heinz v. Lutz*, 146 Pa. St. 592, 608.

A label of red and black letters on white background of "Elastic Starch," with large and prominent cut of flatiron, and name and address of proprietor, not infringed by label of white, yel-

low, and black letters on red background of "E's New Process Starch," with picture of colored woman holding up freshly ironed shirt, and flatiron on table, and address of proprietor. *J. C. Hubinger Bros. Co. v. Eddy*, 74 Fed. R. 551.

Bars of soap of respondent like those of complainant, and on both were words "a base de Glycerine," but on other side of bars of complainant were words "La Parisienne," and on respondent's "Rose de France." Held no infringement. *Kropf v. Furst*, 94 Fed. R. 150.

Where complainant had trade-mark "Welcome" for soap on which it had expended large sums of money, court would not enjoin respondent from using his name, "Welcome A. Smith," on soap of different size and shape, and different style of wrappers; but would only enjoin such prominent use of it as would be likely to mislead people in thinking it was "Welcome Soap." *Lever Bros., Ltd., v. Smith*, 112 Fed. R. 998.

There is no unfair competition in representing on a package or boxes the picture of a patented article (a syringe) substantially like that on boxes sold by complainant, where both parties have right to sell under patent. *Marvel Co. v. Trellar Co.*, 125 Fed. R. 829.

Use of a rose-colored capsule on bottles of champagne is not an infringement of complainant's right to use same colored capsule where the respondent's labels are so different that no mistake is likely to arise.

"A man of average intelligence, exercising ordinary care, could readily ascertain the difference." *Mumm v. Kirk*; 40 Fed. R. 589.

Preliminary injunction not granted where the complainant has not shown that his method of putting up coffee essences in tin boxes, with certain labels, had been imitated by respondent so as to deceive the public, and that the public has been in fact deceived. The right of complainant should be clear. *Pfeiffer v. Wilde*, 107 Fed. R. 456; affirming 102 Fed. R. 658.

Complainant put up hair-crimpers in red boxes, white label, with black border and bust of woman, with words "Madame Louie, Common Sense Hair Crimper"; defendant put up hair crimpers of different size and weight in similar boxes, with white label and bust of woman with words "The Langtry Elegantes. One gross, No. 1 Black, Hair Crimpers." Defendant had prior use of white label with central vignette. Otherwise labels, boxes, wrappers, and lettering were so different that no one

could reasonably be expected to be deceived. No injunction. *Philadelphia Novelty Mfg. Co. v. Rouss*, 40 Fed. R. 585.

A bright red box with white label and black border, for hair crimpers, on label "Madame Louie Common Sense Hair Crimpers," with bust of woman with curled hair, not imitated by bright red box with white label bearing words "The Langtry Elegantes," with different lettering and head of woman, curled hair, insufficient for injunction. Bill dismissed. *Philadelphia Novelty Co. v. Blakesley Novelty Co.*, 40 Fed. R. 588; affirming 37 Fed. R. 365.

The letters and words on respondent's label were arranged in the same manner as on complainant's; but the words were different, and the size, form, and color of letters, as well as size of label. Held, that there was not sufficient resemblance to justify injunction. *P. Lorillard Co. v. Peper*, 86 Fed. R. 956.

A label for cereal food bearing name "Grape-Nuts," not infringed by one dissimilar in color, arrangement of printed matter, and having certain marked differences, although there is a certain resemblance in size and color of background.

"But there are certain distinctive marks which are peculiarly suggestive to the eye, which, in our judgment, so stamp these labels and indicate such marked dissimilarity that we think that the purchaser who, relying upon his knowledge of the character of the brand he wished, should mistake the one for the other, would be stupid indeed." *Postum-Cereal Co., Ltd., v. American Health Food Co.*, 119 Fed. R. 848; affirming 109 Fed. R. 898.

Although both parties used the words "Healing Springs" on their mineral waters, yet other wording was so different that there was no infringement; the words "Rubino" and "Lithia Water" differentiated the labels. *Virginia Hot Springs Co. v. Heyeman*, 138 Fed. R. 855.

5. An infringement of a trade-name is an imitation such as would deceive a purchaser in the ordinary course of business.

See XI. 1, 239, 2, 242, 3, 244.

"He has no such company, and that part of his new title seems to have been adopted to imitate the plaintiffs', and to make his paint pass as theirs. Such would be its effect with any but the most cautious. . . . Any false name that is assumed in imitation of a prior true name is in violation of this right, and the

use of it should be restrained by injunction." *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416, 418.

"This case we think is clearly within the rule of prohibition. It is difficult to believe that the words 'late operator,' and 'formerly operator,' being in letters and type so much smaller than the other letters upon the cards and sign of the defendant, have not been thus placed with a purpose to mislead and to create an impression that his rooms are the Colton Dental Rooms, or rooms of the Colton Dental Association. But whether intended to produce this result or not, no one can doubt that they are calculated to mislead the majority of unwary persons, and even of the most wary and cautious, when suffering from acute pains and seeking for immediate relief." *Colton v. Thomas*, 2 Brews. 308. 313.

In a bill brought by plaintiffs doing business under firm name of "Devlin & Co." to restrain defendant from using firm name of plaintiffs', an injunction was granted restraining said defendant from displaying upon signs, etc., said firm name and confining him to the use of his own proper Christian and surname without devices which might tend to mislead and induce the public to believe or suppose that he is the plaintiffs. Defendant then put out sign upon which was "Devlin's Clothing"; over the word "Devlin" were defendant's initials "J. S.," with number of his store, "826," on each side of the initials. Held, facts justified finding of deception, and that the words and letters were so arranged as to deceive, and were so intended; order of contempt proper. *Devlin (Jeremiah D.) v. Devlin (John S.)* 69 N. Y. 212.

"In my opinion there is not sufficient similarity in the two names, as above, necessarily to lead to the inference that there was an intention to deceive." *Merchant Banking Co. v. Merchants' Joint Stock Bank*, 47 L. J. Ch. 828, 830.

"To justify an injunction in such a case, it should appear that the resemblance between the two trade-marks or trade-names is sufficiently close to raise a probability of mistake on the part of the public or to show a design to mislead and deceive on the part of the defendant. . . . The evidence further shows that such mistakes actually occurred. It further satisfies us that the defendant intended that they should occur." *Sanders v. Jacobs*, 20 Mo. App. 96, 98.

6. The act of the infringement may consist in using the mark so as to deceive, although it may be used differently from the manner of the original proprietor.

The plaintiff had a trade-mark for furs consisting of a figure of a lady and a bear; the defendant used a similar figure not as a trade-mark, but on a circular sent to customers; held an infringement. *Jay v. Ladler*, 40 Ch. D. 649.

A trade-mark used by a distiller on bottled goods is infringed if used by a retailer on his goods bottled from barrels sold by the distiller. *Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. R. 585.

“But it surely cannot be said, that a person having a valid trade-mark, which he uses upon one form of package, another person can adopt the same mark upon the same form of package, and is justified in its use because he also puts it upon another form of package. Nor is it very material whether the barrels have one or two stamps upon them, or whether one kind of whiskey is straight and the other blended, or the price of one is a little greater or less than the other.” *G. G. White Co. v. Miller*, 50 Fed. R. 277, 278.

7. A. In order to claim relief or damages for the infringement of a trade-mark, it is not necessary to show fraudulent intent,

See IV. 3. 92.

See X. 1 A 2. 223. *Oakes v. Tonsmierre*, 49 Fed. R. 447.

See VIII. 2. 185. *Church & Dwight Co. v. Russ*, 99 Fed. R. 276.

See VIII. 2. 186. *Daviess County Distilling Co. v. Martinoni*, 117 Fed. R. 186.

“But the practice in equity has long been settled otherwise, the rule now being that the injury the owner of the trade-mark suffers by the offering for sale in the market of other goods, side by side with his, bearing the same trade-mark, entitles the real owner of the trade-mark to protection in equity, irrespective of the intent of the wrongdoer, it being held that the injury done to the complainant in his trade by loss of custom is sufficient to support his title to relief. Neither will the complainant be deprived of remedy in equity, even if it be shown by the respondent that all the persons who bought goods from him bearing the trade-mark of the real owner were well aware that

they were not of the complainant's manufacture." *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 63.

"Even where no fraud can be justly imputed, where the use of the name or style originated in mistake and not in design, although the party may be exempted from damages and costs, the continuance of the use may be justly restrained, since it involves a violation of the right of property, that if persisted in with a knowledge of the fact would be fraudulent." *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C. 599.

"From the above it would seem that an intentional fraud is not necessary to entitle the plaintiff to protection, but that where the same mark or label is used, which recommends the article to the public by the established reputation of another, who sells a similar article, and the spurious article cannot be distinguished from the genuine one, an injunction will be granted although there was no intentional fraud." *Coffeen v. Brunton*, 4 McLean, 516, 519.

"And it is not an answer to an application for an injunction to restrain the user thereof by another person, for such other person to say and prove that he adopted the trade-mark without knowing that it already belonged to the plaintiff." *Cope v. Evans*, L. R. 18 Eq. 138, 143.

Imitation of cigar labels with trade-mark thereon was so close as to be fairly assumed to be intentional. "That the defendants did not know that the labels, which they bought, as they aver, from a cigar-box maker, were infringements, is no reason for refusing the relief prayed for. The owner of a trade-mark is entitled to protection against ignorant as well as against malicious infringers. Nor is the fact that no actual sale is shown material. It is manifest on the papers that defendants bought the boxes thus labelled to sell with their cigars, and that, but for the complainant's appeal to the courts, they would have offered them for sale." *Cuervo v. Landauer*, 63 Fed. R. 1003.

"If the defendant, without fraud, use the trade-mark of the plaintiff, he is still liable. If the right be violated it matters not whether it be by fraud or by mistake." *Davis v. Kendall*, 2 R. I. 566, 570.

"The jurisdiction to restrain the use of a trade-mark rests upon the ground of the plaintiff's property in it and of the defendant's unlawful use thereof. *Boston Diatite Co. v. Florence Mfg. Co.*, 114 Mass. 69. If the absolute right belonged to the plaintiff, then, if an infringement were clearly shown, the fraudulent intent

would be inferred and . . . the further violation of the right of property would nevertheless be restrained." *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537.

"If the effect of the simulated trade-mark is to deceive the public into the belief that the article upon which it is placed is the article of some other manufacturer, then it is deception, whether it was the actual intention of the person using the simulated trade-mark to deceive or not, as the principle of law applies that persons are held to have intended the necessary, natural and probable consequences of their acts." *Liggett Tobacco Co. v. Hynes*, 20 Fed. R. 883.

An imitation close enough to deceive, whether intended or not, is an infringement to be restrained. *Lorillard v. Wight*, 15 Fed. R. 383.

"Positive proof of fraudulent intent is not required where the proof of infringement is clear." *McLean v. Fleming*, 96 U. S. 245, 253.

"In short, it does not appear to me that there was any fraudulent intention in the use of the marks. That circumstance, however, does not deprive the plaintiffs of their right to the exclusive use of those names." *Millington v. Fox*, 3 My. & C. 338, 352.

"I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark. . . . A man may take the trade-mark of another ignorantly, not knowing it was the trade-mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade-mark of his neighbor, and intending and desiring to injure his neighbor by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the Plaintiff is just the same." *Singer Mfg. Co. v. Wilson*, 3 App. Cas. 376, 391.

"Now one man may adopt or imitate the label or trade-mark of another with the most innocent intention possible, but the law is settled that if his imitation is such as is calculated to mislead purchasers into the belief that he is selling an article manufactured by that other, this court will interfere." *Wotherspoon v. Currie*, 22 L. T. n. s. 260.

Intent not an element in the question of infringement when there is interference with legal rights causing loss and injury. *Van Hoboken v. Mohus*, 112 Fed. R. 528.

B. nor that persons have actually been deceived,

“Nor is it necessary, in order to entitle the party to relief, that proof should be given of persons having been actually deceived, or that they bought goods in the belief that they were of the manufacture of the complainant, provided that the court is satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other.” *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 63.

“It is of no moment that the proof fails to show deception, confusion or injury to any marked extent. Such proof is unnecessary where infringement of a valid trade-mark is clearly established. The defendant is using the complainant’s property and, as he is acting without color of right, the complainant is entitled to have that use discontinued. If the defendant’s contention be correct that actual damage must be proved before an injunction can issue, it follows that if to-morrow a new infringer should commence the publication of a paper with a Chinese copy of the complainant’s trade-name on its title-page, the court would be powerless to grant relief until the infringement had been carried on long enough to cause actual, provable damage. Equity is not so helpless and impotent. It is the policy of the law to arrest the pirate before he actually makes off with the plunder.” *Gannert v. Rupert*, 127 Fed. R. 962, 964.

“Wrongs which are the probable result of given means should be prevented, not awaited. The infringement of a trade-mark implies injury.” *Lanahan v. John Kissel & Son*, 135 Fed. R. 899, 903.

“As has been often pointed out before, it makes no difference that dealers in the article are not deceived. No one expects that they will be. It is the probable experience of the consumer that the court considers.” *National Biscuit Co. v. Baker*, 95 Fed. R. 135.

“It was not necessary for the complainant to attempt to discover whether a purchaser had been actually deceived, for a manifest liability to deception exists.” *Fuller v. Huff*, 104 Fed. R. 141.

“In a case like the present it would be too much to require the complainants to prove instances of such deception. It is not likely that the knave who perpetrates the fraud upon the ultimate consumer will disclose himself to the complainants; and the ultimate consumer, if cognizant of the fraud practised upon him,

could not, unless by mere accident, be known to the defendants. Such testimony is unnecessary when, as here, the proofs warrant the conclusion that the only reason for the dress adopted by the defendants for their product is that it can be successfully used to defraud the ultimate consumer." *Von Mumm v. Frash*, 56 Fed. R. 830, 837.

"Neither is he required to prove that persons have actually been deceived, and that his adversary's goods have been purchased under the belief that they were his. If it appears that the resemblance between the two labels is such that it is probable, in the sale of the goods of the parties, the one will be mistaken for the other, enough is shown to make it the duty of the court to interfere." *Wirtz v. Eagle Bottling Co.*, 50 N. J. Eq. 164, 168.

C. nor that the other goods are inferior.

See VIII. 1 F. 173. *Blofield v. Payne*, 4 Barn. & Adol. 410.

"In this view the excellence of the counterfeit intensifies the wrong done to the plaintiff, and is a cogent argument for his right to reparation, although the public have suffered no actual injury." *Cleveland Stone Co. v. Wallace*, 52 Fed. R. 431, 437.

"To entitle a complainant to protection against a false representation it is not essential that the article should be inferior in quality, and 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." *Coffeen v. Brunton*, 5 McLean, 256, 260.

The question is not whether the article made and sold by the defendant under complainant's trade-mark is an article of the same quality or value, but whether the defendant is attempting to pirate on the complainant's good-will. *Partridge v. Menck*, 2 Sandf. Ch. 622.

Fact that article sold under pirated trade-mark is not inferior, no defence for suit for damages for loss of sales; might be for injury to character of the thread. *Taylor v. Carpenter*, 2 Wood. & M. 1.

3. In order to claim relief or damages for the infringement on the ground of unfair trade where no legal trademark is involved, it is necessary to prove fraud.

A. But imitation of distinguishing features beyond the probability of chance will be good evidence of fraud.

See VIII. 2. 185; VIII. 2 A. 187.

B. And unnecessary marks which would result in deception of the public and injury to an established business will be enjoined as unfair trade.

Complainants had since 1828 in Holland and since 1889 in United States manufactured and sold a fine grade of cocoa known as "Van Houten's Cocoa." The defendant company with Hooton as president and large stockholder, skilled in the business began the preparation in 1897 of a similar article but not in packages likely to deceive. Later Hooton left the concern. Confusion was shown in the public mind, and as he was no longer in the business the court decreed that the name Hooton should not be used so as to deceive. *Van Houten v. Hooton Cocoa & Chocolate Co.*, 130 Fed. R. 600.

9. The appropriation of a word in one combination of words may not be infringed by its use in other combinations which are not likely to mislead.

"Samaritan's Gift," and "Samaritan's Root and Herb Juices," on medicines, not infringed by "Samaritan's Nervine." "Samaritan" in one combination of words does not prevent its being used in all other combinations." *Desmond's Appeal*, 103 Penn. St. 126.

"Pratt's Astral Oil" not infringed by "Standard White Astral Oil."

"Then, in the second place, the appropriation in the word 'Astral' in one combination of words, does not preclude its use in all other combinations." *Pratt Mfg. Co. v. Astral Refining Co.*, 27 Fed. R. 492, 494.

10. Courts of equity have two objects in granting injunctions: first, to protect the individual in the profits of his skill; second, to protect the public from imposition.

But see: V. 3 A. 125.

See VIII. 1 A (3) (a). 154. *American Washboard Co. v. Suginaw Mfg. Co.*, 103 Fed. R. 281.

See VIII. 3 A. 194.

“At present it is sufficient to say that in all cases where a trade-mark is imitated, the essence of the wrong consists in the sale of goods of one manufacturer or vender as those of another; and it is only when this false representation is directly or indirectly made, and only *to the extent in which it is made*, that the party who appeals to the justice of the court can have a title to relief.” *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. 599, 607.

“Where a trade-mark is infringed the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and it is on this ground that a court of equity protects trade-marks.” *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651, 656.

“No man has a right to use names, symbols, signs, or marks which are intended, or calculated, to represent that his business is that of another. No man should in this way be permitted to appropriate the fruits of another’s industry, or impose his goods upon the public by inducing it to believe that they are the goods of some one else.” *Hilson Co. v. Foster*, 80 Fed. R. 896, 897.

“Courts of equity have two objects in view in granting injunctions against their imitation: 1. To secure to the individual adopting one the profits of his skill, industry, and enterprise. 2. To protect the public against fraud.” *Humphrey’s Specific Homeopathic Med. Co. v. Wenz*, 14 Fed. R. 250, 252.

Probability of damage to complainant true ground of relief in equity, not that public may be deceived. *Kentucky Distilleries & Warehouse Co. v. Wathen*, 110 Fed. R. 641.

“Its object is twofold: First, to protect the party using it from competition with inferior articles; and second, to protect the public from imposition.” *Shaw Stocking Co. v. Shaw*, 12 Fed. R. 707, 710.

“It imports that the article is made by the original proprietor, and therefore genuine, and the law protects the original proprie-

tor, not only as a matter of justice, but to prevent imposition on the public." *Stachelberg v. Ponce*, 23 Fed. R. 430, 431.

11. Infringement of the trade-mark or trade name of a newspaper or periodical may be restrained, and in such cases the courts frequently consider the size and shape of the paper, and the general appearance of the type.

See IV. 6 B. 103. *Estes v. Worthington*, 31 Fed. R. 154.

See II. 3 A. 23. *Kipling v. G. P. Putnam's Sons*, 120 Fed. R. 631.

Held, name "New Era," on newspaper, not so like "Democratic Republican New Era," type and other incidents being dissimilar, as to entitle plaintiff to injunction. *Bell v. Locke*, 8 Paige, 75.

"But in such case (*i. e.*, absence of fraud), the title of the defendant's paper must so closely simulate that of the plaintiff's that an infringement may be declared by the court as a matter of law, or else the simulation must be proven as a fact." *Duniway Pub. Co. v. Northwest Printing, etc., Co.*, 11 Oregon, 322.

Name "Chatterbox" on juvenile publication enjoined on same principles as in *Estes v. Williams*, name and binding being imitated. *Estes v. Leslie*, 23 Blatch. 476; 27 Fed. R. 22.

"The name 'Chatter-book,' as printed upon the cover of the defendant's books, is, in my opinion, an imitation of the name 'Chatter-box,' which, by association, when used upon books of a juvenile character, points 'distinctively to the origin or ownership' of the books to which it is applied; and the use by the defendants of the name 'Chatter-book' upon the books which are represented by the exhibits in the case, the same being books of a juvenile character, of the general appearance, style, and manner of cover of complainant's books, should be enjoined *pendente lite*." *Estes v. Leslie*, 29 Fed. R. 91.

Name "Chatterbox" on juvenile publications enjoined; same principles involved as in *Estes v. Williams* and *Estes v. Leslie*. *Estes v. Worthington*, 24 Blatchf. 371.

"Chatterbox" on series of juvenile publications of uniform appearance and in a style of peculiar attractiveness, there being no copyright, protected against books of same name and so similar in appearance as to lead purchasers to think that they are the same. *Estes v. Williams*, 22 Blatchf. 364; 21 Fed. R. 189.

Complainant for fifteen years acquired a reputation for a magazine published under name "Comfort." The respondent started

a magazine called "Home Comfort," of a different size, price, style, arrangement and printed matter, with no proof of fraud or injury. Held, that "Comfort" was an arbitrary word, and that it was infringed by use of "Home Comfort." The respondent's paper circulated in part at least of territory of complainant's. Injunction should issue. *Garnert v. Rupert*, 127 Fed. R. 962; reversing 119 Fed. R. 221.

The complainant published in Massachusetts, New York, and Pennsylvania, a financial paper called "United States Investor," which became well known in the East and in some foreign countries. The respondent later published in California a paper called "The Investor," but having thereon in conspicuous place the words, "A Financial Guide to Southern California," and other distinguishing differences. Held, that the difference in the localities, and the difference in the appearance of the papers was such as not likely to cause confusion, and injunction denied. *Investor Publishing Co. of Mass. v. Dobinson*, 82 Fed. R. 56; 72 Fed. R. 603.

"Now it appears 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 adopting the same name for any other similar publication; and that this right is a chattel interest capable of assignment was held in *Longman v. Tripp*, 2 Bos. & P. W. R. 67 and *Foss, ex parte*, 2 De G. & J. 230." *Kelly v. Hutton*, L. R. 3 Ch. 703, 708.

"National Police Gazette" entitled to preliminary injunction against "United States Police Gazette," printed in a way actually to deceive purchasers and readers. *Matsell v. Flanagan*, 2 Abb. Pr. N. S. 459.

Title of a copyrighted publication separate from the publication which it is used to designate, is not within the protection of copyright, but may be protected on ground of infringement of trade-mark or trade-name.

Case sent to master to determine whether name "Our Young Folks" on publication in Boston was infringed by "Our Young Folks' Illustrated Paper" in Augusta, type and contents being different. Each issue of complainant's magazine duly copyrighted. *Osgood v. Allen*, 1 Holmes, 185.

"By publishing, in accordance with the requirements of the copyright law, a book under the title of the life of any distinguished statesman, jurist, or author, the publisher could not prevent any other author from publishing an entirely different and

original biography under the same title. When the title itself is original and the product of the author's own mind, and is appropriated by the infringement, as well as the whole, or a part of the literary composition itself, in protecting the other portions of the literary composition, courts would also probably protect the title. But no case can be found, either in England or this country, in which, under the law of copyright, courts have protected the title alone, separate from the book which it is used to designate." *Idem*, 192-193.

"The Good 'Things of Life' not infringed by the "Spice of Life," there being marked dissimilarities. "It is not sufficient to maintain the action that purchasers inattentively might accept the defendant's publication in place of the plaintiff's. But it is necessary to maintain their action that the defendants should have employed this word 'life' with the same significance, in whole or in part, as it has been employed by the plaintiffs." *Stokes v. Allen*, 56 Hun, 526.

12. Infringement of a distinguishing feature of a publication which would be liable to deceive may be enjoined.

See VIII. 5. 197. *Merriam v. Texas Siftings Pub. Co.*, 49 Fed. R. 944.

See IX. 1 A (4) (a). 206, ditto.

Plaintiff, author of law books, sold copyright and edited second edition, but refused to edit third edition. Publisher put out a third edition bearing name of author, as if he had edited third edition. Third edition contained errors which were prejudicial to author. Injunction granted to restrain publisher from issuing third edition with any statement which would lead public to suppose that it was edited by author. *Archbold v. Sweet*, 1 M. & Rob. 162.

"The principle is clear that you cannot adopt a trade-mark or use a name calculated to mislead or deceive persons as to an article, already appropriated, into the belief that they are purchasing one thing when they are purchasing another. On the whole, I come to the conclusion that this publication is not calculated to mislead the ordinary run of mankind, who are alone to be considered. The court does not legislate for the careless class, who know not what they are purchasing. The word 'Punch' is well known, and it is impossible that an ordinary person can be misled." *Bradbury v. Beeton*, 21 L. T. s. s. 323, 325.

Complainant had for many years published Bibles, using thereon the name "Oxford," by which name the Bibles had become known. Respondent, having no connection with the place, enjoined from using that name on its Bibles, and defence that it was a geographical name did not avail. *Chancellor, etc., of Oxford University v. Wilmore-Andrews Pub. Co.*, 101 Fed. R. 443.

"The principle is that there must be an adaptation of plaintiff's title, either exact or to an extent sufficient to show an appropriation of words producing similtude in the titles themselves, or from well-established popular designation." *Forney v. Engineering News Pub. Co.*, 10 N. Y. Supp. 814.

Complainant published book, "Farthest North, Nansen." Respondent published book, "The 'Fram' Expedition. Nansen in the Frozen World. Including Earlier Arctic Explorations." There was substantially the same literary matter, and many of the same illustrations, but there was such dissimilarity in titles, title-page, and cover that one of ordinary intelligence would not be deceived. In absence of fraud, injunction denied. *Harper & Bros. v. Lare*, 103 Fed. R. 203; affirming 93 Fed. R. 989.

An author does not succeed in making out a case of unfair trade where a later edition is so unlike an earlier one that a purchaser is not likely to be deceived, where there is no proof that one was deceived, where no fraud is shown, and where the two editions are unlike in size, shape, binding, color, arrangement, and typography. *Kipling v. G. P. Putnam's Sons*, 120 Fed. R. 631.

Where complainant alleged that defendant, in advertisements, circulars, letter-heads, etc., made a similar use of symbol of open book, used in same relation to publication of "Webster's Dictionary," and used date of publication 1890 on title-page when it was a reprint of edition of 1847, held, that there might be such evidence of fraudulent intent that court would overrule defendant's demurrer. *Merriam v. Holloway Pub. Co.*, 43 Fed. R. 450.

"Social Register," as applied to a book compiled with care, of residents of New York City and Orange, N. J., is a valid trade-mark, and preliminary injunction should issue against respondent, who published "Howard's Social Register" in Orange. *Social Register Ass'n v. Howard*, 60 Fed. R. 270.

13. Infringement is not shown where a party conducting a legitimate business without intent to defraud is entrapped, or forced, through lack of good faith of another, into a technical imitation of complainant's marks or labels where no fraud is shown and the public is not likely to suffer by deceit.

Parties as agents for a corporation dealing in Edison phonographs had a sign "Edison Phonograph Agency." After termination of agency they still maintained the sign dealing in Edison phonographs. Held, that the sign was not deceitful, and that Edison, a stockholder of a corporation which manufactured and sold phonographs, could not enjoin them, he having no pecuniary interest. *Edison v. Hawthorne*, 108 Fed. R. 839, affirming 106 Fed. R. 172.

Defendant was engaged in the legitimate business of renewing burned-out electric lamps, making a saving by a new process of about five or eight cents on each lamp. Prior to 1890 it always removed the label of the complainant. After that time the complainants so affixed their trade-mark "G. E." on the inside of the leading-in tube that it could not be removed without great expense. The defendant, however, apparently acted in good faith and pasted on the outside their labels "Malden" and "Perfection" known to the trade. On a motion by complainant for preliminary injunction the court said that there was no apparent fraud on the part of the defendant, that it was not a case similar to the re-use of bottles with the mark of original proprietor blown therein as there were many kinds of bottles in public use, while there was not the same opportunity for choice in the case of electric lamps, and it was a question how far the complainant was acting in good faith in so affixing its trade-mark that it could not be removed without disproportionate expense in the legitimate business of renewal. The defendant was held to the best of good faith in affixing its own labels so as to distinguish its product. Motion for preliminary injunction denied." *General Electric Co. v. Re-New Lamp Co.*, 121 Fed. R. 164. *But see*: 128 Fed. R. 154 *infra*.

On final hearing the court decided that there was not such difficulty and expense in removing the initials "G. E." from the complainant's burned-out lamps as to allow respondent to renew them with the initials remaining. *General Electric Co. v. Re-New Lamp Co.*, 128 Fed. R. 154.

Infringement by the respondents is not shown by proof that agents without knowledge of principal twice sold bitters falsely represented to be Hostetter Bitters and advised use of Hostetter bottles, if the acts were disavowed by the principal and there is no course of wrong-doing shown. *Hostetter Co. v. Brunn*, 107 Fed. R. 707.

Selling imitation "Hostetter" bitters as such imitation, without encouragement that they be sold as and for original, is no infringement. *Hostetter v. Van Vorst*, 62 Fed. R. 600.

Simulation of signature on complainant's label under a special order given by the complainant's agents or detectives is not so far an infringement as to warrant issuing an injunction. *Liebig's Extract of Meat Co., Ltd., v. Libby*, 103 Fed. R. 87.

14. Examples of non-infringement.

"Adams Sappota Tolu Chewing Gum," on chewing gum, by "Heisel's Elastic Tolu." *Adams v. Heisel*, 31 Fed. R. 279.

"Old Country," soap, by "Our Country." *Allen B. Wrisley Co. v. George E. Rouse Soap Co.*, 87 Fed. R. 589.

"Old Country," soap, by "Our Country." *Allen B. Wrisley Co. v. Iowa Soap Co.*, 104 Fed. R. 548.

"Magic," cleaning compound, by "Magico." *American Chemical Co., ex parte*, 62 O. G. 588.

"Brown's Iron Bitters," drugs, by "Brown's Iron Tonic," Brown acting in good faith and bottles, labels, etc., being different. *Brown Chemical Co. v. Myer*, 31 Fed. R. 453.

"S. B." cough drops, by "B. & S." *Burt v. Smith*, 71 Fed. R. 161.

"Henderson," on whiskey, not anticipated by "Anderson." *Buchanan-Anderson-Nelson v. Breen & Kennedy*, 120 O. G. 2125.

Figure of a star, soap, by figure of star and a crescent. *Cornwall's Appeal*, 12 O. G. 138.

"Samsoncalf," shoes, by picture and words "Our Little Samson." *F. M. Hoyt Shoe Company, ex parte*, 113 O. G. 1970.

"Weber, New York," pianos, by "Webster, New York." *Foster v. Webster Piano Co.*, 13 N. Y. Supp. 338.

"Old Crow," with picture of a crow, not infringed by "Old Jay," with figure of a jay, on whiskey. *Gaines & Co. v. Carlton Importation Co.*, 120 O. G. 902.

"Old Crow," with figure of crow not infringed by "Raven

Valley, with picture of three ravens, on whiskey." *Gaines & Co. v. Knecht & Son*, 120 O. G. 1163.

"Electrene," by "Griserin," for medical preparations. *Griserin-Werke Paul Camphausen, ex parte*, 120 O. G. 327.

"Remington," typewriters, by "Remington-Sholes." *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118; reversing 110 Fed. R. 520 and 122 Fed. R. 348.

"Royal Irish Linen," writing paper and envelopes, by "Royal Vellum." *Hurd & Co., ex parte*, 59 O. G. 1763.

"Golden Charm," over large fanciful monogram of letters, "F. G. S. & Co." on flour not infringed by "Charm" and a shield containing capital letter I.

"The whole question in cases of this kind is not whether persons are entitled to combine in one device independent devices that have been separately used as trade-marks; but whether after such combination has been made, there is a probability of the public being misled or deceived thereby. If not, and the distinctiveness of the new combination is quite apparent to ordinary intelligence, no objection should be made to its registration, if the other requisites of the law are complied with." *Imbs, in re*, 10 O. G. 463.

Symbol of sun representing a human face, surrounded by rays with words sometimes used "Warmth of Life," on underwear, not infringed by indistinct outline of sun's rays with monogram of respondents in circle, and "Beach Mfg. Co., Hartford, Conn." prominently displayed. *Jaros Hygienic Underwear Co. v. Simons*, 49 Fed. R. 276.

"Blue Jay," on whiskey, not infringed by "Old J" or "Old Jay Rye" with representation of a blue jay. *Jones v. Carlton Importation Co.*, 120 O. G. 2444.

Complainant had used a conventional figure of a diamond shape or lozenge on an abradant composed of particles of steel used for polishing, under name of "Crushed Steel." The word "diamond" had never been associated with it. Subsequently respondents sold a similar article under name of "Diamond Steel," with figure of radiant diamond. Held no infringement. *Kann v. Diamond Steel Co.*, 89 Fed. R. 706.

"West End Distillery Co.," Whiskey, by "East End Distillery Co." *Kentucky Distilleries & Warehouse Co. v. Wathen*, 110 Fed. R. 641.

"Electric," flour, by "Electric Light." *Kirby v. McLaughlin & Co. v. Johnston*, 72 O. G. 1785.

“Dermacura,” skin ointment, by “Dermakola.” *Laxakola Co., ex parte*, 100 O. G. 451.

“Uneeda,” biscuits, by “Otaka.” *Lorenz, ex parte*, 89 O. G. 2067.

“Walkeasy,” and “Walk-a-way,” shoes, by “Waulkwell.” *Parker, Holmes & Co., ex parte*, 100 O. G. 1111.

“Grape-Nuts,” cereal food, by “Grain-Hearts.” *Postum Cereal Co. v. American Health Food Co.*, 119 Fed. R. 848.

“Cuticura,” not infringed by “Cuticle” for toilet soap where the boxes, wrappers, and lettering of package were different; although there was little doubt that defendants had selected name the first five letters of which were the same as plaintiff’s to get the benefit of its advertising. No proof of actual deception. *Potter Drug & Chemical Co. v. Parsfield Soap Co.*, 106 Fed. R. 914; affirming 102 Fed. R. 490.

A yellow wrapper bearing “Every Day Soap,” in black letters with name and location of maker and small circular figure of moon and stars, not infringed in package of similar size and shape of yellow wrapper with words in yellow on black ground “Everybody’s Soap,” the print and figures in the two bearing no resemblance and name and location of respondent plainly appearing. *Proctor & Gamble Co. v. Globe Refining Co.*, 92 Fed. R. 357.

“Royal,” baking powder, by “Coral.” *Royal Baking Powder Co. v. Davis*, 26 Fed. R. 293.

“Social Register, Newport,” directory, by “Newport Social Index.” *Social Register Ass’n v. Murphy*, 128 Fed. R. 116.

“No-To-Bac,” medicine to cure Tobacco habit, by “Baco-Curo.” *Sterling Remedy Co. v. Eureka Chemical Mfg. Co.*, 80 Fed. R. 105, affirming 70 Fed. R. 704.

“Rough on Rats,” medicinal preparations, etc., by “Rough on Skeeters.” *Wells v. Ceylon Perfume Co.*, 105 Fed. R. 621.

“Ma-Le-Na,” by “Man-a-Lin,” on medicines.” *York v. Hartman*, 119 O. G. 1921.

15. Examples of infringement.

See VIII. 1 A. 152. *Fuller v. Huff*, 104 Fed. R. 141.

See X. 1 A. (1). 219. *Frank v. Sleeper*, 150 Mass. 583.

See VIII. 1 F. 173.

See VIII. 1 F. (1). 180.

See VIII. 1 G. 181.

See XI. 4 A. 245.

"Chartreuse," liqueur, by "Chasseurs." *Bauer & Co. v. Order of Carthusian Monks*, 120 Fed. R. 78.

"Sap Maple Syrup," with representation of a maple leaf, for syrup, by a cluster of maple leaves. *A. R. Gregoire & Co., ex parte*, 102 O. G. 1293.

"Willoughby Lake," on scythe-stones, by "Willoughby Ridge."

"Black Diamond," ditto, "Diamond Gem." *A. F. Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. R. 896.

"Colonial Dame," perfumery, by "Colonial." *Allen B. Wrisley Co. v. Buck*, 95 O. G. 2483.

"Mormaja," coffee, by "Mojava." *American Grocery Co. v. Sloan*, 68 Fed. R. 539.

Figure of a star, lubricating oil, by word "star." *American Lubricating Oil Co.*, 9 O. G. 687.

Label of bow and arrow with word "Apollinis," on mineral water bottles, by label with anchor and word "Apollinaris." *Apollinaris Brunnen v. Somborn*, 14 Blatchf. 380.

Figure of owl, and words "We Never Sleep," on ladies' and children's shoes, by figure of head and upper part of owl and words, "Owl Shoe" on men's and boys' shoes. *B. A. Corbin & Son Co. v. Miller, Kohlhepp, Giese & Co.*, 98 O. G. 1485.

Complainants' trade-mark for pale ale consisting of an equilateral triangular figure red in color, infringed by a nearly equilateral triangle of red on pale ale and half and half with a narrow gold border and a monogram of the letters "C." and "F." in the middle, with some fine scroll ornamentation in the corner. *Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. R. 206.

The unauthorized use by respondent of the name "Bromidia" is not the less an infringement although accompanied by the name of respondent. *Menendez v. Holt*, 128 U. S. 521, says, "That is an aggravation and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the true proprietor." *Battle v. Finlay*, 50 Fed. R. 106.

"Nitro," on firearms, by "nitro-hunter." *Belknap & Co., ex parte*, 105 O. G. 745.

"Cyco," on carpet sweepers, by "Cyco Prize." *Bissell Carpet Sweeper Co., ex parte*, 104 O. G. 2148.

Trade-name "Standard Distilling Co." by "Standard Distilling & Distributing Co." and the fact that the complainants were as individuals using the former name, not a fraud. *Block v. Standard Distilling & Distributing Co.*, 95 Fed. R. 978.

"Cocaine," hair oil, by "Cocoïne." *Burnett v. Phalon*, 9 Bosw. 192. Aff'd 5 Abb. Pr. n. s. 212.

"Swan," gin, by "Black Swan." *Caire, ex parte*, 15 O. G. 248.

"Ribbons," plug tobacco, by red ribbon. *Calvert & Brother, ex parte*, 85 O. G. 288.

"National," sewing machines, by "New National." *Carey v. New Home Sewing Machine Co.*, 96 O. G. 1429.

Where party has acquired reputation for tobacco under name "Lone Jack" with a device, it is an infringement to take that name although with a different device. *Carroll v. Ertheiler*, 1 Fed. R. 688.

Cross with letters "C. B." infringed by a similar mark with distinguishing difference of letters "C. S." instead of "C. B." *Cartier v. Carlile*, 8 Jur. n. s. 183.

"Celluloid," chemical compound, by "Cellonite." *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. R. 94.

Trade-name "Chicago Landlords' Protective Bureau" infringed by "Landlords' Protective Department." *Chicago Landlords' Protective Bureau v. Koebel*, 112 Ill. App. 21.

Shield with eagle thereon, and an eagle bearing a shield, cuffs, collars, and shirts, by a shield and "Shield Brand." *Coon, ex parte*, 58 O. G. 946.

"Monarch Distilling Co.," whiskey, by "M. V. Monarch."

(The merchandise in either case would probably be known as Monarch whiskey). *Corning & Co., ex parte*, 65 O. G. 751.

Picture of greyhound enclosed in circle with word "Run-Lite," for lubricants, refused registration in view of prior registered mark of picture, of greyhound with words "Greyhound Brand. Amber A. A. Machinery Oil." *Crescent Oil Co, ex parte*, 115 O. G. 2137.

"Perry Davis Vegetable Painkiller," on medicine, by "The Great Home Remedy, Kennedy's Painkiller." *Davis v. Kennedy*, 13 Grant Ch. U. C. 523.

Representation of diamond- or lozenge-shaped figure with word "Diamond," inks, by diamond-shaped figure and words "Black Diamond." *Diamond Ink Co., ex parte*, 98 O. G. 1483.

"Liveraid," or "Liverine," on medical compound, by "Liveroid." *Dr. Parker Medicine Co., ex parte*, 106 O. G. 1779.

Emblem of anchor on wire, infringed by emblem of anchor surmounted by crown. *Edelsten v. Edelsten*, 7 L. T. R. n. s. 768.

"Sapolio," soap, by "Sapho." *Enoch Morgan's Sons Co. v. Whittier Coburn Co.*, 118 Fed. R. 657.

"Chatter-box," on juvenile books of same general appearance, style, and manner of cover, by "Chatter-book." *Estes v. Leslie*, 29 Fed. R. 91.

"U. S. Star," with figure of star, on windmills and tanks, by figure of a star with windmill in the centre. *Flint & Walling Mfg. Co., ex parte*, 85 O. G. 148.

"Dyspepticure," medicinal preparation, by "dyspepticide." *Foley & Co., ex parte*, 87 O. G. 1957.

A five-pointed star, on oil, by a six-pointed or similarly pointed, star. *Galena Oil Co. v. W. P. Fuller & Co.*, 101 O. G. 1611.

A picture of a chicken cock standing upright within a circle, with names "Old Bourbon Whiskey, Bourbon County, Ky." and "From J. A. Miller, Paris," known as "Chicken Cock Whiskey," infringed by a like picture with "Miller's Game Cock Rye," the complainant having used its mark on barrels, and respondents on both barrels and bottles. *G. G. White Co. v. Miller*, 50 Fed. R. 277.

Initials "G. F.," on velvet ribbons, by "G. & F." *Giron v. Gartner*, 47 Fed. R. 467.

"Maizena," with allegorical picture of Indian preparing corn and corn flour, by "Maizharina," with picture of man carrying maize. *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. R. 823.

"Home Brand," canned goods, by "Home Comfort." *Griggs, Cooper & Co. v. Erie Preserving Co.*, 131 Fed. R. 359.

"Floridena," perfumes, by "Floradora." *Grossmith, ex parte*, 100 O. G. 2175.

A representation of a sea monster enthroned about a vertical anchor as trade-mark for flour, anticipated by symbol and word "Anchor" across it. *Gwin Bros. & Co., ex parte*, 120 O. G. 2755.

"Optine," for medicine, anticipated by "Optal." *Holbert, ex parte*, 115 O. G. 2136.

Figure of an ox, on mustard, infringed by figure of ox and word "ox." *Harrison v. Taylor*, 12 L. T. N. S. 339.

"Lightning Hay Knives," hay knives (lightning being trade-mark), by "Lightning Pattern Hay Knives." *Hiram Holt Co. v. Wadsworth*, 41 Fed. R. 34.

"Canadian Club Whiskey," whiskey, by "Canadian Rye Whiskey." *Hiram Walker & Sons v. Mikolas*, 79 Fed. R. 955.

"Hostetter Bitters," bitters, by Host-Style Bitters." *Hostetter Co. v. Becker*, 73 Fed. R. 297.

Word "star" with symbol of star, underwear, infringed by

word "star" with symbol of star and crescent. *Hutchinson v. Blumberg*, 51 Fed. R. 829.

"Star" and symbol of a star, shirts, by "Lone Star" and symbol of star. *Hutchinson v. Covert*, 51 Fed. R. 832.

"Syrup of Figs," medical preparation, by "Improved Syrup of Figs" similar bottles, wrappers and devices. *Improved Fig Syrup Co. v. California Fig Syrup Co.*, 54 Fed. R. 175.

"Uno," medical compounds, by "Ino." *Ino Medicine Co., ex parte*, 101 O. G. 887.

Ostermoor's mark No. 34,063, 23 Jan. 1900, infringed by a mark representing a felt mattress with lining and cover removed so as to expose the layers spread apart. *J. C. Hirschman Co., ex parte*, 120 O. G. 690.

A plain red Greek cross long used and well known on surgical plasters, by use of a Greek cross of a slightly different pattern and having in a red circle in the centre the letters "B. & B." *Johnson & Johnson v. Bauer & Black*, 82 Fed. R. 662; reversing 79 Fed. R. 954.

Crouching cat with words "Old Tom," on gin, by cat in standing position with words "Old Tom." *Kaufmann v. Blache, ex parte*, 84 O. G. 145.

"Honeymoon," whiskey, by "Honey-comb." *Kentucky Distilleries & Warehouse Co. v. Wathen*, 110 Fed. R. 641.

"Syrup of Red Spruce Gum," with picture of Indian with background of waterfall and spruce trees, on medicinal preparation, protected from infringement with imitation of bottles and labels so close as to lead to belief that it was intentional. *Kerry v. Toupin*, 60 Fed. R. 272.

"Autogirdle," interfered with, by "Auto-Garter" for corsets. *Kops Bros. v. Royal Worcester Corset Co.*, 119 O. G. 1584.

"Hunter," on whiskey, is a valid trade-mark, and the use by defendants of the words "White Label Hunter Whiskey, Bottled by ——" is an infringement which will be enjoined. *Lanahan v. Kissel*, 135 Fed. R. 899.

"Sunlight," soap, by "American Sunlight." *Lever Bros. v. Pasfield*, 88 Fed. R. 484.

"Soroasis," shoes, by "Sartoris." *Little v. Kellam*, 100 Fed. R. 353.

"Capital," coffee, by "Capitol." *Lown v. Ohio Coffee & Spice Co.*, 73 O. G. 1136.

"Chewso," chewing candy, by "Chewies." *McInnerney, ex parte*, 85 O. G. 148.

“Holt & Co. having then acquired the exclusive right to the words ‘La Favorita’ as applied to this particular vendible commodity, it is no answer to their action to say that there was no invasion of that right because the name of ‘S. O. Ryder’ accompanied the brand upon flour sold by appellants, instead of the name of ‘Holt & Co.’ That is an aggravation and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the true proprietor.” *Mendez v. Holt*, 128 U. S. 514, 521.

“Peach,” plug tobacco, by “Peach Greenville.” *Meriwether & Co., ex parte*, 83 O. G. 1513.

“Tiger,” with picture of two tigers pulling wearing apparel in opposite directions, by “Teareabout” with same illustration. *Morris v. Robinson*, 101 O. G. 2570.

“Hostetter’s Stomach Bitters,” medicine, by “Thellers’ celebrated Stomach Bitters” with similarity of details on label, and same peculiar form and color of round-shouldered, short-necked bottles. *Myers v. Theller*, 38 Fed. R. 607.

“Uneda,” biscuits, by “Iwanta.” *National Biscuit Co. v. Baker*, 95 Fed. R. 135.

Geometrical design with word “In-er-seal,” on bakery products, by similar geometrical design on a label of similar size, shape, and color with words “Factory Seal.” *National Biscuit Co. v. Swick*, 121 Fed. R. 1007.

“Satinola,” for cosmetics, refused registration in view of prior registered marks “Satin,” “Satin Skin,” and “Satin Scent,” for substantially same class of goods. *National Toilet Co., ex parte*, 116 O. G. 593.

“Home,” on sewing machines, by “Home Delight.” *New Home Sewing Machine Co. v. Bloomingdale*, 59 Fed. R. 284.

“Cottolene,” substitute for lard composed of cotton-seed oil, by “Cottoleo.” *N. K. Fairbank Co. v. Central Lard Co.*, 64 Fed. R. 133.

“Gold Dust,” washing powder, by “Gold Drop.” *N. K. Fairbank Co. v. Luckel, King, etc., Soap Co.*, 102 Fed. R. 327; reversing, 88 Fed. R. 694.

“Vitae-Ore” and “V. O.” medicinal preparation by “Vitalizing Ore.” *Noel v. Ellis*, 89 Fed. R. 978.

“In the first place I must look at the tickets and inquire whether a large part of that which impresses the eye has been taken, and I must answer that it has. I find that the two elephants in the two top corners of the Plaintiff’s ticket are repeated

in the two top corners of the Defendant's ticket. It is quite true that the elephants are in a different position, the Defendant's elephants have howdahs upon them, and the Plaintiff's have not, and the trunks are turned in different directions, but still in each corner there is an elephant; that impresses the eye with a considerable amount of similarity." *Orr Ewing v. Johnston*, L. R. 13 Ch. D. 434, 445.

"German Sweet Chocolate," by "Sweet German Chocolate," wrappers and labels similar. *Pierce v. Guittard*, 68 Calif. 68.

"Cuticura," toilet soap, by "Curative." *Potter Drug & Chemical Corp. v. Miller*, 75 Fed. 656.

"Rex," on dyspepsia tablets, by "Rexall." *Regis v. Jaynes*, 185 Mass. 458.

"Grenadine," "Grenade," syrup, by "Grenade." *Rillet v. Carlier*, 61 Barb. 435.

"Le Page Liquid Glue," glue, by "Le Page Improved Liquid Glue." *Russia Cement Co. v. Le Page*, 147 Mass. 206.

"California," soap, by "A. S. California Family Soap." *Smith, ex parte*, 16 O. G. 679.

A Maltese cross with monogram and other inscriptions infringed by a Maltese cross without inscription and monogram for boots and shoes. *Smith-Briscoe Shoe Co., ex parte*, 117 O. G. 1491.

"Seafoam," on baking powder, by "Sodafoam." *Sodafoam Baking Powder Co.*, 96 O. G. 1239.

Figure of a boat surrounded by a diamond-shaped border and an exterior diamond-shaped outline, not interfered with by representation of a flag, a diamond-shaped figure thereon, a rhomboid within the diamond-shaped figure, for varnishes. *Standard Varnish Works v. David B. Crockett Co.*, 119 O. G. 961.

"Pep-Kola," on tonics and stimulating beverages by "Pepko." *Sutton, ex parte*, 108 O. G. 291.

Star enclosing letter "G" (which latter may be omitted), engine oil, by red star (word or symbol). *Swan & Finch Co., ex parte*, 100 O. G. 682.

"Diamond dust," refused registration for cereals in view of prior registration of "diamond" and "diamond mills." *Snyder, ex parte*, 115 O. G. 1849.

"Silver Leaf," with group of three maple leaves, lard, by "Maple Leaf," with two maple leaves. *Vogel & Son, ex parte*, 99 O. G. 2321.

Complainants' trade-mark of full-length figure of waitress, called "La Belle Chocolatiere" registered 16 October, 1883, and

advertised in United States and Canada at enormous expense, infringed by full-length picture of woman in Puritan costume, differently colored and differently faced, with rock to the left and with the name of the defendant. *Walter Baker & Co. Ltd. v. Puritan Pure Food Co.*, 139 Fed. R. 680.

"Yusea," incandescent lights, by "U-C-A." *Welsbach Light Co. v. Adam*, 107 Fed. R. 463.

"Shooting Star," on wines, by shooting star with figure 1 above and figure 2 below. *Werner & Co., ex parte*, 85 O. G. 775.

"Velvet-Skin," and "Velveo-Silvo," on soap, by "Velva." *Willard Chemical Co., ex parte*, 107 O. G. 1972.

"Satin Skin," or "Satin," on toilet preparations, by "Satinette." *Wood v. Hinchman*, 110 O. G. 600.

"Donkey," soaps, by figure of bridled and saddled donkey. *Woolwine, ex parte*, 97 O. G. 1373.

"Charter Oak," "Old Charter," and "Royal Charter," all properly in conflict and involved in interference proceedings. *Wright & Bluthenthal v. Mayer & Cushman*, 119 O. G. 2234.

XII. LICENSE.

1. **A. A proprietor may grant to another the right to use his trade-mark or trade-name in a business which is not merely personal, provided that the use by the licensee is not upon goods of a different origin or likely to deceive the public.**

See X. 5. 233; X. 6 A. 234.

See VI. 2 A. 136. *Batcheller v. Thomson*, 93 Fed. R. 660.

See XV. 7. 319. *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. R. 205; *Wallach v. Wigmore*, 87 Fed. R. 469.

Proprietor of whiskey distillery allowed a dealer to use his trade-mark on bottled whiskey made from the distillery, but the license being in the nature of a contract should be strictly limited to goods in that form specified. *Krauss v. Jos. R. Peeble's Sons Co.*, 58 Fed. R. 585.

B. It may be granted in connection with the hotel business.

Plaintiff by agreement with proprietor of "Revere House," used name on busses to convey passengers to and from hotel, having exclusive right to name. Held, that he could recover damages against a third party without right using said name on busses for similar purpose. *Marsh v. Billings*, 7 Cush. 322.

"The ground of action against the defendants is 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." *Marsh v. Billings*, 7 Cush. 332.

"It has never been held that a mere consent or acquiescence in the use of a name or trade-mark conferred an absolute and an irrevocable right which could not be annulled. While it may temporarily transfer or impart a right, it by no means follows that such a right is so fixed and determined that the original owner is forever afterwards debarred from revoking a permission already given." *McCardel v. Peck*, 28 How. Pr. 120.

Plaintiffs under agreement with a proprietor of a hotel, "Irving House," acquired exclusive use of name for busses to and from hotel. Held, entitled to injunction against third parties using name likewise. *Stone v. Carlan*, Cox's Manual 104.

C. Or under a patent.

A. B. Howe, as licensee of patent of his brother to make sewing-machines, acquired right to use "Howe" on the machines so that his brother could not use his surname in such a way as to deceive the public as to the sewing-machines. *Howe v. Howe Machine Co.*, 50 Barb. 236.

While a license to manufacture under a patented machine may carry with it the right to use a trade-mark on the goods manufactured, yet where it appears that a former license has been revoked, decree will be for complainant. *Martha Washington Creamery Buttered Flour Co. v. Martien*, 37 Fed. R. 797; 44 Fed. R. 473.

D. But license to use a trade-mark apart from the proprietor's business and on goods of a different origin is a fraud, and courts will recognize no contractual rights under it.

Plaintiff had previously acquired considerable reputation in manufacture and sale of sewing-machines under the trade-mark "National." He licensed the defendant to use that name on machines of its own make for a stipulated fee. Held, that such an agreement was invalid and fraudulent, so that the plaintiff could not recover under it.

"It was a license to use a stamp, dissociated and stripped of truth and of its former significance, for the purpose of falsely inducing purchasers to believe that what it meant when used by the plaintiff it meant when used by the defendant." *Lea v. New Home Sewing-Machine Co.*, 139 Fed. R. 732, 733.

2. Acquiescence in unauthorized or authorized use of a trade-mark or trade-name has been termed to amount to a revocable license.

See XIII. 1 A. 282. *Amoskeag Mnf. Co. v. Spear*, 2 Sandf. S. C. 599.

XIII. LACHES.

1. A. Mere delay in bringing suit for infringement of trade-mark will not defeat the right of a party legally entitled to the mark to an injunction.

See XIV. 1 A (2). 299.

A delay of from 9 to 3 years according to vague evidence, while sufficient to debar claim for profit, did not disentitle proprietor to right to injunction against "Amoskeag" on prints and calicoes. *Amoskeag Mnfq. Co. v. Garner*, 54 How. Pr. 297; 55 Barb. 151.

"The consent of a manufacturer to the use or imitation of his trade-mark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent whether expressed or implied, when purely gratuitous may certainly be withdrawn; and when implied it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license. The existence of the fact may be a proper subject of inquiry in taking an account of profits if such an account shall hereafter be decreed; but even the admission of the fact would furnish no reason for refusing an injunction." Five years' delay. *Amoskeag Mnfq. Co. v. Spear*, 2 Sandf. S. C. 599.

Mere delay for 6 years in bringing bill to enjoin improper use of name "Bissell" on ploughs, not laches, but it might preclude recovery of profits. *Bissell Chilled Plow Works v. T. M. Bissell Plow Co.*, 121 Fed. R. 357.

It is no defence on ground of laches that defendant has for 23 years used words "Old Crow" and symbol of a crow on its whiskey, infringing trade-mark of the complainant, unless knowledge was brought home to the complainant. *Gaines v. Whyte Grocery Co.*, 107 Mo. App. 507.

Plaintiff had for many years manufactured a pen stamped and known as "303." Defendant infringed on the number as applied to his pens. The fact that there had been infringements by others in New York and in England for 15 or 20 years, which may have been generally known to the plaintiff, although he may not have known of any particular individual infringing, not laches on

his part to prevent an injunction. *Gillott v. Esterbrook*, 47 Barb. 455; 48 N. Y. 374.

“Unreasonable delay in bringing a suit is always a serious objection to relief in equity; but cases arise in litigations of the kind before the court where the complainant may be entitled to an injunction to restrain the future use of a trade-mark, even when it becomes the duty of the court to deny the prayer of the bill of complainant for an account of past gains and profits. . . . Equity courts will not, in general, refuse an injunction on account of delay in seeking relief, where the proof of infringement is clear, even though the delay may be such as to preclude the party from any right to an account for past profits.” *McLeun v. Fleming*, 96 U. S. 245, 251, 253.

“The intentional use of another’s trade-mark is a fraud; and when the excuse is that the owner permitted such use, that excuse is disposed of by affirmative action to put a stop to it. . . . Mere delay or acquiescence cannot defeat the remedy by injunction in support of a legal right, unless it has been continued so long and under such circumstances as to defeat the right itself.” *Menendez v. Holt*, 128 U. S. 514, 523.

Plaintiff’s acquiescence in defendant’s use of name “Nolan Bros.” for 10 years in a wholesale shoe business does not preclude it from objecting to its use in a retail shoe business, since mere use of trade-name in one business does not give the right to use it in another business. *Nolan Bros. Shoe Co. v. Nolan*, 63 Pacif. 480; 131 Calif. 271.

Mere delay of 7 years where respondent’s sales were not many, not laches in bringing bill for infringement. *Rahtjen’s American Comp. Co. v. Holzappel’s Comp. Co.*, 101 Fed. R. 257.

“The complainant’s label, which he alleges that the defendant has wrongfully imitated, had been in use substantially in the same form for a dozen or more years prior to the bringing of the suit. . . . It is further suggested that the complainant has lain by for several years, whilst the defendant has been publicly using his own label, and has thus acquiesced in its use. To this suggestion it may be proper to reply that the complainant had a patent for the article of bluing, which he was prosecuting and endeavoring to substantiate, but in which he finally failed. His failure to establish his patent (which would have covered all rights), ought not to preclude him from falling back on his right to the trade-mark. No essential delay has occurred since the termination of the proceedings on the patent. But, at any rate,

an acquiescence in Kellogg's use of his own label was no acquiescence in his use of the new and altered label having Sawin's name in the caption." *Sawyer v. Kellogg*, 7 Fed. R. 720, 721.

"In England the rule is stringent in trade-mark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trade-mark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrongdoer to an account for profits and damages. This rule, however, applies only to those where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant. Such is not the present case. Although the defendant began the packing of bluing in the packages complained of early in the year 1878, there is no evidence that the complainant knew it until a short time before the suit was brought." Bill brought in 1881. *Sawyer v. Kellogg*, 9 Fed. R. 601, 602.

"But I do not understand the rule to be, that if a party infringes upon another's trade-mark there is any fixed time in which he must bring suit in order to save his rights." *Williams v. Adams*, 8 Biss. 452.

B. But unreasonable delay with knowledge of facts may defeat the right to recover profits or damages.

"Upon the question of laches, however, I am constrained to say that the complainant's conduct has been such that the relief granted must be limited to an injunction. Ryder commenced using the brand in 1869, and has used it continuously since. That the complainants knew of this, certainly as early as 1871, is not disputed. That they protested at all is denied. Certainly there was no vigor or courage shown by them until just prior to the commencement of this suit in 1882. That they did not consent is true, but it is equally true that for men who believed their rights invaded, their course was inconsistent and misleading. Ryder might well have imagined that they did not intend to call him to an account. The circumstances were such as to justify the belief on his part that he was licensed, by silence, to use the trade-mark. It would be inequitable to compel him to pay for its use during the long years that the complainants slept upon their rights." *Holt v. Menendez*, 23 Fed. R. 869, 871.

When complainant delayed suit for infringement of trade-name on silverware from summer of 1898 to 7 June, 1902, it was laches not entitling it to account for profits. *International Silver Co. v. William H. Rogers Corp.*, 66 N. J. Eq. R. 119, 140.

“The complainants are not entitled to an account. For nearly four years prior to the date of suit they had notice that their trade-mark was in common use by dealers in soaps in this country, and did nothing to prevent it until about the time of filing this bill. . . . There is no evidence of fraud on the respondent's part. He did not even know of the complainants' existence, or of the existence of the rights they set up. To hold him liable to account for his past sales, and damages to the complainants, in view of such laches, would be unjust.” *Low v. Fels*, 35 Fed. R. 361, 362.

“Equity will not decree for an account of past gains and profits where there has been laches in bringing the suit, and long acquiescence in the use of the trade-mark by others, and especially not where the acquiescence covers a period of fourteen years.” *Manhattan Medicine Co. v. Wood*, 4 Cliff. 461, 488.

Acquiescence of long standing is proved in this case, and inexcusable laches in seeking redress, which show beyond all doubt that the complainant was not entitled to an account nor to a decree for gains or profits. *McLean v. Fleming*, 96 U. S. 245.

“It is idle to talk of acquiescence, in view of these facts. Delay in bringing suit there was, and such delay as to preclude recovery of damages for prior infringement; but there was neither conduct nor negligence which could be held to destroy the right to prevention of further injury.” *Menendez v. Holt*, 128 U. S. 514, 525.

Laches in bringing bill while it might entitle party to injunction will not allow him to recover for profits. *N. K. Fairbank Co. v. Luckel King & Cake Soap Co.*, 116 Fed. R. 332; affirming 106 Fed. R. 498, and 88 Fed. R. 694.

“The rightful owner of the trade-mark, by giving to the other person notice of his right, could place the latter in the wrong in respect to anything *thereafter* done in violation of the owner's rights. But as to all previous acts, it could not be said that there was any ‘imitation,’ or ‘adoption,’ or ‘colorable resemblance.’ There would have been, previous to such notice, none of that intent to palm off the manufactures of one man for those of another which appears in all cases on this subject. The case is still stronger where the defendants not only are ignorant of the plain-

tiff's claim, but have been induced, by a previous litigation, to acknowledge a similar claim made to the same trade-mark by a third party. I think, therefore, that the plaintiffs should have a permanent injunction, as prayed for, and that they should recover costs; but I do not think that they are entitled to any damages, and in that respect the prayer of the complaint is denied." *Weed v. Peterson*, 12 Abb. Pr. n. s. 178, 180.

But see: Although a party has used a name in infringement of a trade-mark for many years, yet if it is not known to complainant, and use has not been with knowledge and acquiescence of complainant, he is not debarred from recovery of profits by any laches. *Gilka v. Mihalovitch*, 50 Fed. R. 427.

C. And may be ground for refusing preliminary injunction.

See XIII. 2. 287.

"Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, apparently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a law-suit, and delayed legal proceedings until his patience was exhausted. When delay of the owner of a patent or trade-mark to prosecute infringers has been of a tendency to mislead the public or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing." *Estes v. Worthington*, 22 Fed. R. 822, 823.

Where alleged infringement of the word "Fairbanks" on scales has continued for 18 years with the knowledge of complainant, preliminary injunction will not be granted, but the case left to a final hearing on the merits. *E. T. Fairbanks & Co. v. Des Moines Scale & Mfg. Co.*, 96 Fed. R. 972.

D. In England the rule is that lack of diligence in suing deprives the complainant in equity of the right to an injunction or an account. English cases cited.

"I know of no instance in which the court has given relief with reference to a trade-mark except on a prompt application." Delay of two years. *Beard v. Turner*, 13 L. T. n. s. 746, 750.

"The principles laid down are well known; first if you induce

another to lay out money by keeping back a right, which you intend at some future time to assert, you may induce him to incur serious expenditure." *Beard v. Turner*, 13 L. T. N. S. 746, 749.

"Where persons come and object, in whatever form, to the use of a trade-mark which has been used for a great number of years, it does not follow as a matter of course that the use for a great number of years is an absolute bar to obtaining an injunction; but most certainly it throws on those who object to the use the *onus* of proving that it was originally a fraudulent use, and that it is calculated to deceive; and very much stronger evidence is required in such a case where there has been a long user than would be required in another case." *Heaton's Trade-Mark, in re*, 27 Ch. D. 570, 576.

Delay in filing bill from end of August to 25 November not laches, for plaintiff should wait until he collected evidence that persons had been actually deceived. *Lee v. Haley*, L. R. 5 Ch. App. 155.

"I do not think as a matter of law the mere fact that it (the mark) has been used for a great number of years, necessarily affords a defence. If it was clearly made out that it was originally used for the purpose of fraud, that it was continued for the purpose of fraud, and that it has the practical effect of deceiving the public, I do not think that the lapse of years would prevent the plaintiffs having a remedy." *Rodgers v. Rodgers*, 31 L. T. N. S. 285, 287.

"We have before shown that there is no legal principle to bar such a suit, unless the delay to prosecute is equal to the time fixed in the Statute of Limitations, or as in patents the inventor permits a public use so long as by express statutory provision to be estopped." *Taylor v. Carpenter*, 2 Wood. & M. 1, 19.

2. When there has been delay in prosecuting open and notorious infringement of a trade-mark, or when there has been a long-standing acquiescence, so that another party has been allowed in good faith to build up under it a valuable business, the original proprietor may not be allowed to enjoin the continued use by that party.

See IV. 8 A. 111.

See VIII. 7. 202.

See XIV. 1 B. 293.

See XIII. 1 D. 286. *Beard v. Turner*, 13 L. T. N. S. 746.

See XIII. 1 C. 286. *Estes v. Worthington*, 22 Fed. R. 822.

Where party has for 21 years and during the life of a patent known of and acquiesced in use by defendant of name "Charter Oak" on stoves who has under it built up a large business, he can not after expiration of patent complain of infringement. *Pilley v. Child*, 16 Batch. 376.

"So far as the act complained of is completed, acquiescence may defeat the remedy on the principle applicable when action is taken on the strength of encouragement to do it, but so far as the act is in progress and lies in the future, the right to the intervention of equity is not generally lost by previous delay in respect to which the elements of an estoppel could rarely arise. At the same time as it is in the exercise of discretionary jurisdiction that the doctrine of reasonable diligence is applied, and those who seek equity must do it, a court might hesitate as to the measure of relief, where the use by others, for a long period, under assumed permission of the owner, had largely enhanced the reputation of a particular brand." *Menendez v. Holt*, 128 U. S. 514, 524.

Acquiescence in an open and extensive use for eight years, with full knowledge thereof, by a party of a trade-mark "Prince's Metallic Paint" on paint, under a claim of right, estops a party from maintaining suit for injunction. *Prince's Metallic Paint Co. v. Prince Manfy. Co.*, 57 Fed. R. 938; affirming 53 Fed. R. 493.

The name "Hunyadi" applied to mineral waters became generic in Hungary 1873-1895 by action of the government although S. had first adopted it. In 1895 he succeeded in making good his title in Hungary but meanwhile the name had become generic in United States. From 1873-1897 S. did nothing in United States to maintain his exclusive right to the word, although he made active efforts in Hungary both by petitions to government, by registration, and by suits. He must have known of infringements in United States. Held, that although he had not abandoned name "Hunyadi" by laches he had lost exclusive right to word as trade-mark in United States. This principle of laches did not, however, apply to bottles with short necks, labels with 3 rectangular panels of red and white, and a metal capsule for which protection was granted. *Saulehner v. Eisner & Mendelson Co.* 179 U. S. 19; reversing 91 Fed. R. 536; 88 Fed. R. 61.

But see: Where a party in United States begins to make an artificial water by secret process and uses the word "Hunyadi"

thereon, which word is a valid trade-mark in Hungary on waters exported to this country and which is being actively protected in our courts, it is no defence that as against others the owner has been guilty of laches so as to be precluded from enjoining them. *Thackery v. Saxlehner*, 125 Fed. R. 911.

The respondent for 30 years was openly and notoriously bottling and selling its waters, under the name "Vichy," and that name was being used not only by respondent but by others so that the complainant must have known of it. Moreover, the respondent was, under that name, with implied knowledge of complainant, building up a valuable business.

"With all these facts before them, and with the yearly increasing sales and competition of the defendant company, no move was made against them for 25 years and until 1898 when this bill was filed. A clearer case of laches could hardly exist. *Saxlehner v. Eisner*, 179 U. S. 19, 36."

As the respondent was not guilty of fraud, and as the waters differed, it was held that, while not allowing to the complainant the exclusive use of the name "Vichy," the respondent should not use the name "Vichy" on its labels so as to deceive. (La) *République Française v. Saratoga Vichy Spring Co.*, 191 U. S. 427.

When complainant saw the respondent busy in spending money and developing its springs in 1895, 1896, and 1897, while it remained comparatively idle, it is too late in 1903 to object to use of distinguishing marks, as "Healing Springs," which the respondent has been using on his labels. *Virginia Hot Springs v. Hege-man*, 138 Fed. R. 855.

XIV. ABANDONMENT.

1. A trade-mark is abandoned (A) when the proprietor, by some act or by laches, is held to have intended to permanently discontinue its use; (B) when the sign, after discontinuance, has lost its signification of any business reputation or good-will.

A. When the proprietor, by some act or by laches, is held to have intended to permanently discontinue its use.

See VI. 3. 138.

See IV. 6 B. 103.

“The right to the exclusive use of a word or symbol as a trade-mark is inseparable from the right to make and sell the commodity which it has been appropriated to designate as the production or article of the proprietor. It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment, rather than of the proprietor.” *Atlantic Milling Co. v. Robinson*, 20 Fed. R. 217, 218.

“Besides, the defendant’s paper upon its face purports to be a revival of an old publication, in which he was formerly interested with complainant, which publication had been voluntarily discontinued by both for more than eighteen months.

“The particular name, therefore, which he had assumed had been so long derelict, except in its subsequent democratic connection, that even an opposition editor might lawfully have seized upon it and appropriated it to the use of his political friends, without any danger of deceiving the public, or drawing off the patronage of those who really wished to read the complainant’s paper.” *Bell v. Locke*, 8 Paige, 75, 77.

“It cannot be denied that it is abundantly proven in this cause that the manufacture of Morris & Wright, and of those who suc-

ceeded them at Durham, was known, called, and distinguished in the market as 'Durham' smoking tobacco. It is on this notorious fact in the cause that the able and ingenious argument has been raised that the public, by its voice, may appropriate and consecrate to an individual property in a designation by which he may choose to denote any product of his industry. But I can find no warrant for such proposition in the law on this subject. On the contrary, it is distinctly laid down by the authorities that it is only *the actual use* of the mark, device, or symbol by the dealer which entitles him to it, and gives him the right to be protected in the enjoyment of it." *Blackwell v. Armistead*, 3 Hughes, C. Ct. 163, 167.

Complainants had under word "Durham" built up extensive business of tobacco at Durham, N. C., since 1865. Respondents, under claim of having used word on tobacco at Durham in 1861, after a non-user of eight years, used word on tobacco at Richmond, Va. It meanwhile had acquired a new and valuable reputation under complainants, who had assumed it innocently in 1865-66. Held, to have been abandoned by respondents, if they had ever had rights in it.

"The label and trade-mark of complainants was established in 1865 by J. R. Green. His business and that of his successors built up the insignificant and obscure place, Durham's Station, into the flourishing town 'Durham.' The town grew up during the first four or five years of the use of the label, and owed its growth in chief part to the business indicated by the label. . . . The use of the principal characteristics of this trade-mark by manufacturers not conducting their business at Durham is a deception put upon the public, and may be enjoined on that ground alone, irrespectively of the trade-mark right." *Blackwell v. Dibrrell*, 3 Hughes, 151, 162.

"The use of these words by the plaintiff's predecessor in 1873 does not seem to have been sufficient in extent and time to make them indicate with definiteness that flour on which they might be placed came from him, and whatever rights in that respect had begun to accrue to him by that use were lost in the abandonment of the use long before the defendants began using them in 1884." *Brower v. Boulton*, 53 Fed. R. 389, 390. Aff'd 58 Fed. R. 888.

A brought bill against B to restrain him from using word "Chlorodyne," as applied to a medicine. He dismissed bill with costs and then used words "original Chlorodyne." B used those

words and on bill to restrain him, held, that, although he had lost right to exclusive use of word "Chlorodyne" by abandonment in dismissing former bill, yet he might prevail on "original Chlorodyne" by showing persons had been deceived into purchasing B's medicines for his. *Browne v. Freeman*, 12. W. R. 305.

"What is the test by which a decision is to be arrived at whether a word which was originally a trade-mark has become *publici juris*? I think the test must be, whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone." *Ford v. Foster*, L. R. 7 Ch. App. 611, 628.

"Emollio" was used as trade-mark on perfumery previous to, but not after, 1867, and in 1870 labels were destroyed. Held, abandonment, not only by cessation of user, but also by destruction of labels, showing intention to abandon. *Grossmith's Trade-Mark, in re*, 60 L. T. n. s. 612.

Sale of right to use a certain trade-mark in connection with certain articles in the same class as another class may indicate intention to abandon its use as to those articles, although the sale may be invalid. *Macmahan Pharmacal Co. v. Denver Chemical Mfg. Co.*, 113 Fed. R. 468.

"Evidence was given to the effect that from 1857 to 1860 the words 'La Favorita' were occasionally used in St. Louis by Sears & Co., then manufacturing in that city, as designating a particular flour; but the witnesses were not able to testify that any had been on sale there under that brand (unless it were that of Holt & Co.) for upwards of twenty years. The use thus proven was so casual and such little importance apparently attached to it, that it is doubtful whether Sears & Co. could at any time have successfully claimed the words as a trade-mark, and, at all events, such use was discontinued before Holt & Co. appropriated the words to

identify their own flour, and there was no attempt to resume it." *Menendez v. Holt*, 128 U. S. 514, 521.

"If the trade-mark be abandoned, or the use of it intentionally discontinued by the original proprietor, it may be readopted and appropriated by another, provided it has not become a mere description of quality or kind of product." *O'Rourke v. Central City Soap Co.*, 26 Fed. R. 576, 578.

Failure to register a feature in an alleged trade-mark amounts to an abandonment of it. *Pittsburgh Crushed Steel Co. v. Diamond Steel Co.*, 85 Fed. R. 637.

"Eureka" on steam packing of a certain kind used by complainant from 1875 to 1886; respondents had used it in a limited way on another kind of packing from 1872 to 1874. Injunction against respondent to protect complainant's use. *Symonds v. Greene*, 28 Fed. R. 834.

"This is a motion for a preliminary injunction to restrain the use of the word 'Eureka' in trade, in connection with steam and hydraulic packing. There is no question but that the orator commenced using that name for packing made by him in 1875, and has continued that use since that time, nor but that the defendants use that name in connection with that kind of packing, not of the orator's make, in trade; nor but that a firm known as Sellers Bros. gave that name to a kind of steam packing patented by William Beschke in 1872, . . . and used it in connection with that packing until early in 1874. . . . The use of that name by Sellers Bros. was so long ago, and so limited, that it cannot fairly be considered to now have any effect upon the indication by it of the source of goods to which it has for so many years been applied [1886]. When the orator first began to use it, it might have indicated that the goods were Sellers Bros., and might not, but now it would not indicate to any one in the trade that the goods were Sellers Bros., nor would the fact of their former use of it now confuse its signification." *Symonds v. Greene*, 28 Fed. R. 834.

B. When the sign, after discontinuance, has lost its signification of any business reputation or good-will.

In 1881 plaintiffs began to use trade-mark "Brazilian Silver" on spoons and forks, and continued its use under a constantly increasing business till 1897. Defendant had used same name on similar goods in 1886, but his sales fell off and practically ceased

in 1887, and between 1887 and 1894 there were very few sales by him. After that defendant asserted his right to use it. Held, that he had abandoned name and could not afterwards resume it to another man's detriment. *Daniel v. Whitehouse*, L. R. 1 Ch. (1898) 685.

"Although I do not find any case precisely like this case, because there was a time at which both these people were making goods in the same way (though it does not seem to have been proved that they were made of precisely the same alloy), yet still it seems to me that if a trade drops out of the use of a party, as it has done in this case out of the defendant's use, and while that state of things prevails another gains the reputation in the trade for goods made under the particular name, and his name is associated with the mark, and the mark associated with his name, so that everybody who deals in the goods considers that when they see the mark they see goods made by that particular maker, then the original position of the competitor using the same mark has practically disappeared." *Daniel v. Whitehouse*, L. R. 1 Ch. 689, 690.

Ralph, the respondent, was dangerously ill and out of business for the space of one year and nine months, but the Court decided that this was a sufficient length of time for his interest in the trade-mark to have ceased, and even stated that one year would be a sufficient length of time. *Ralph v. Taylor*, L. R. 25 Ch. D. 194.

"It is said that Mr. Ralph does not come within it [33d rule] for this reason, that since February, 1882, he has been prevented by illness and other causes, but principally by illness, from doing that which he is minded to do, if he can carry into effect certain treaties that he is engaged in at the present moment either to manufacture by himself or other persons this machine; and really the only question I have to determine is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the 33d rule, and is not a person engaged in any business concerning the goods, within the same class as the goods, with respect to which this trade-mark is registered. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the *Companies Act*, you may wind up a company if it has ceased to carry on business for a year. The Legislature in that has shown by its enactment when

a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." *Ralph v. Taylor*, L. R. 25 Ch. D. 194, 198.

"In Allan's Law of Good Will (p. 26) it is said that 'a trade-mark cannot exist apart from the good-will of a business, since what is known as the good-will may persist for a time after such business has in fact ceased. A manufacturing establishment, for instance, may, with all its machinery, and appliances and its store of products, be destroyed by fire, and a year or two may pass before such manufactory is rebuilt, and the business started again; but, when started, the old customers, in part at least, will resume trade connections. Here the business stops for a time, but the good-will involving the trade-marks remains a property more or less valuable during the interval of cessation. I can conceive such a stoppage of business by accident or design, even for a series of years, where the good-will, including the trade-marks, may still be found extant: that is to say, valuable upon resumption. But when it is not shown in some satisfactory way that the trade reputation of a suspended business continues to have value, — can be exchanged or sold, for instance, for a price, — a court cannot say that a good-will remains; in other words, that there still attaches to the old proprietor any dominion over, or property right in, a mark which may once have had, but which no longer has, significance for him in the world of trade.'" *Royal Baking Powder Co. v. Raymond*, 70 Fed. R. 376, 380. Aff'd 85 Fed. R. 231.

Defendant was proprietor of a business which ceased in 1871. As a minor feature thereof he compounded and sold baking-powder, and marked the word "Royal" on his cans. It was not shown that the good-will of his business remained extant or of value for any time after the cessation of said business in 1871, or that the word "Royal" retained for any time in the trade any significance as a mark for the article once compounded by the defendant. In 1894 defendant recommenced the baking-powder business and the use of the said word as a mark. Held, that the earlier use by defendant does not strengthen the later, as against a competitor whose use of said word as a mark for baking powder has been continuous and exclusive since 1873; and this regardless of what the intent of defendant with respect to said word may have been during the twenty-three years from 1871 to 1894. *Royal Baking Powder Co. v. Raymond*, 70 Fed. R. 376. Aff'd 85 Fed. R. 231.

“The appellant, after abandoning for nearly a quarter of a century the manufacture and sale in the city of New York of baking powder, and the use of the fraudulent label, recommenced business in the city of Chicago in the year 1894, using labels which were clearly adapted and intended to, and which clearly would, impose upon the public the article he made and sold as the article manufactured and sold by the appellee. This fraud was more bald and more injurious than that he had previously indulged, for here there was not only imposition upon the public, but invasion of the right of the appellee to the business which it had established.” *Raymond v. Royal Baking Powder Co.*, 85 Fed. R. 231, 235.

But see: Word “anti-washboard,” applied to soap used as trade-mark by defendant’s predecessors 1872–1875, when business ceased and firm dissolved. In 1884, after suit had begun, a member of original firm assigned right to defendant, and that was his only right claimed to trade-mark. It did not appear in the case that at time of assignment assignor had any business in which word was used. Plaintiff’s predecessor had used mark since 1875, supposing that the original firm had gone out of business, which they did soon after. In 1883 he registered the mark at Washington, and assigned right to plaintiff. Held, plaintiff could not enjoin defendant, as when his predecessor started to use it, although innocently, he was in fact a trespasser on rights of others. *O’Rourke v. Central City Soap Co.*, 26 Fed. R. 576.

A. (1) *But where, sufficient time has not elapsed to amount to abandonment at law, the fact of intention should be shown, and a mere discontinuance does not show intention.*

See XV. 3 B. 304.

See XIII. 1 A. 282.

“It is no answer to his complaint against any particular person who has so used it to say that such person is not the only one who has done so, for a trespasser cannot justify upon the ground that others have committed like trespasses. Therefore the appropriation by the appellee of the appellant’s box and labels is not excused by showing merely that others had similarly appropriated them. It is essential that it should also appear that the appellant had, by its acquiescence, abandoned its exclusive right, and, ‘to establish a defence of abandonment, it is

necessary to show, not only acts indicating a practical abandonment, but an actual intent to abandon.'” *Actiengesellschaft Vereinigte Ultramarine-Fabriken v. Amberg*, 109 Fed. R. 151; reversing 102 Fed. R. 551.

Party has right to trade-name for a minstrel troupe. Christy had in 1842 at some labor and expense established “Christy’s Minstrels,” and gave shows till fall of 1854. He suspended, went to California, and after several months returned. Performers in old troupe without license started “Christy’s Minstrels.” He had not resumed, but announced intention of doing so. Injunction. *Christy v. Murphy*, 12 How. Pr. 77.

“A trade-mark, whether it consists of a symbol or a descriptive name, may be abandoned; and, if it is, it may then be appropriated by any one, who, by doing so, adopts it as his own; or after it is abandoned it may be resumed by the original proprietor and readopted by him, if in the meantime it has not been taken possession of by another, or by the community in general, or become, as a name or device, by general user, a mere designation of the kind of article or product, when its quality as an exclusive trade-mark is gone; the criterion or test being, was there an *intention* to abandon, which will depend upon the special circumstances of the particular case.” *Hegeman v. Hegeman*, 8 Daly, 1, 7.

Joseph Ingels had from 1857 to 20 March, 1876 manufactured grain drills under letters patent, using trade-mark “Hoosier.” He then discontinued business and 27 February, 1877, assigned the letters patent and trade-mark to complainant. Respondent took up trade-mark “Hoosier,” and it was held that the suspension from business was not of sufficient length to show an intention to abandon, which must be proved. *Julian v. Hoosier Drill Co.*, 78 Ind. 408, 412.

“The question of abandonment is one of intention, and the burden of establishing it lies upon the party who affirms it. . . . In view of these facts, it cannot be inferred, from less than a year’s suspension of the business by Ingels, that he intended to abandon either the business or his right to said trade-mark. The suspension must be, presumptively at least, attributed to indisposition or inability, rather than to an intention to abandon valuable rights. . . . We think the delay, under the circumstances, will not preclude her from this relief. She did not intend to abandon, and therefore has not abandoned, her right, as to the future, to the exclusive use of her property in the trade-mark.

Inability may prevent the use of the mark, but it will not confer upon others the right to use it, or constitute an abandonment." *Julian v. Hoosier Drill Co.*, 78 Ind. 408, 412.

Action for damages. Verdict six cents. Trade-mark on leather.

"The fact that the plaintiff had discontinued the use of this trade-mark for three years, would not deprive him of a right of action against the defendant for selling leather which was not manufactured by the plaintiff, but stamped in the same manner in which the plaintiff had formerly designated the leather manufactured by him, thus purporting to be of his manufacture and declared by the defendant at the time of the sale to be the genuine Lemoine calfskins. That credit and reputation which a man acquires by his care or skill in the manufacture of a particular article, is a species of property which the law recognizes and protects, and where, as a means of extending his reputation and finding purchasers, he affixes some mark or symbol to designate that the article is of his manufacture, he is injured by the sale of an article manufactured by another, with his peculiar symbol or trade-mark affixed to it. If the article is inferior to his own, he is injured in reputation, and even if it be of a similar quality and kind, its sale goes so far to diminish the sale of his own article, and thus works a pecuniary damage." *Lemoine v. Ganton*, 2 E. D. Smith, 343, 347.

"But it appears to me that Mr. Boehm has established, first, that he did acquire a trade-mark, which became his property in connection with toilet soap, and then the question arises on whether he ever abandoned it. . . . Now, on the question of abandonment, it appears to me that intention to abandon must be shown. There are some analogous cases in law, such as the case of an easement. Mere non-user of an easement, like a right to foul a stream, for a considerable period of years, would not be sufficient to prove an intention to abandon it. . . . In substance, therefore, the question of abandonment is one of intention to be inferred from the facts of this particular case." *Mouson v. Boehm*, 26 Ch. D. 398, 404.

"A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose he lost his trade-mark by not putting more goods on the market when it was glutted." *Mouson v. Boehm*, L. R. 26 Ch. D. 398, 406.

To constitute abandonment, an intention to abandon must be

shown. Mere non-user of a trade-mark could no more be said to constitute abandonment than the mere non-user of the right to foul a stream belonging to a mill as an easement, could be said to constitute an abandonment of the easement. Boehm, however, had neither broken up his moulds nor erased this trade-mark from his books and lists. On the contrary, he had continued to issue the mark in the trade-list of his firm. *Idem*.

Defendant's predecessor had prior right to use of white label with head of woman with hair curled over the words "Hair Crimpers." Business misfortunes necessitated the discontinuance of this label for two or three years, but, in a legal sense, it was never abandoned. *Philadelphia Novelty Mfg. Co. v. Rouss*, 40 Fed. R. 585.

"To establish the defence of abandonment it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon. Acts which unexplained would be sufficient to establish an abandonment may be answered by showing that there never was an intention to give up and relinquish the right claimed. And in a recent English case this doctrine has been applied to a case of trade-marks." *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, 31.

See *idem* XIII. 2. 288.

(2) But abandonment is not shown by numerous infringements not known or acquiesced in by the owner.

See XIII. 1 A. 282.

Defence of abandonment of particular style of dressing goods is not shown where it appears that complainant was first to adopt such style, that it has been used continuously for forty years but others meanwhile have used it, unless it is shown that the use has been with consent of complainant, or there has been an intention to abandon. In this case there was an active assertion of rights. *Actiengesellschaft Vereinigte Ultramarine-Fabriken v. Amberg*, 109 Fed. R. 151; reversing 102 Fed. R. 551.

The fact that a certain label for use on cigar boxes has been sold by numerous lithographers and frequently used, is no defence to bill for injunction if such use was not with knowledge of complainant. *Cuervo v. Jacob Henkell Co.*, 50 Fed. R. 471.

Abandonment of trade-mark is not made out by showing numerous infringements not acquiesced in by owner. *Williams v. Adams*, 8 Biss. 452.

"I do not understand the rule to be, that if a party infringes

upon another's trade-mark, there is any fixed time in which he must bring suit in order to save his rights. Certainly there is no such neglect on the part of the complainants proved here, as would show an intention to abandon their trade-mark." *Williams v. Adams*, 8 Biss. 452, 454.

XV. PRACTICE AND PLEADING.

1. United States Courts.

The jurisdiction of the United States Courts in cases involving infringement of trade-marks registered in the Patent Office at Washington depends on the Act of February 20, 1905, given herewith.

In cases of unfair trade and of trade-marks not registered at Washington, the jurisdiction depends on the diversity of citizenship and damages claimed to the amount of \$2000 under the Revised Statutes.

Federal courts have no jurisdiction in cases of unfair competition between citizens of the same state; and this case depending on a trade-mark, the trade-mark being invalid, bill is dismissed for want of jurisdiction. *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 134 Fed. R. 571; affirming 123 Fed. R. 149.

Federal court does not have jurisdiction of cases of unfair trade between citizens of the same State. *Burt v. Smith*, 71 Fed. R. 161.

If owing to non-compliance with the provisions of an act the registration of a trade-mark is void, yet the trade-mark may be good at common law and protected in United States courts where there is diversity of citizenship and requisite jurisdictional amount in controversy. *Edison v. Thomas A. Edison, Jr. Chemical Co.*, 128 Fed. R. 1013.

Where there is an allegation in bill to restrain infringement of trade-mark in suit between citizens of different States that the amount in controversy exceeds the sum of \$2,000, although the amount of damage is not stated, the United States court has jurisdiction. *Griggs, Cooper & Co. v. Erie Preserving Co.*, 131 Fed. R. 359.

A suit cannot be maintained in the United States to enforce a Missouri State statute on trade-marks outside of that State, although there is diversity of citizenship, and the amount involved is in excess of \$2,000. *Rehbein v. Weaver*, 133 Fed. R. 607.

Under Act of 1881 jurisdiction of the United States Court

arose only in cases where the alleged infringement of a trade-mark was in Indian or foreign commerce. *Warner v. Searle & Hereth Co.*, 101 U. S. 195.

It is not sufficient allegation of jurisdictional amount to state that trade name is worth in excess of \$5,000; and that defendant's acts are calculated to mislead intending purchasers to "its great loss, injury, and damage," as the damage may still be less than \$2,000. *Winchester Repeating Arms Co. v. Butler Bros.*, 128 Fed. R. 976.

2. State Courts.

Suits for infringement of trade-marks and unfair trade may be brought in the State Courts, subject to removal on Federal questions, to the United States Courts.

3. Relief in Equity.

"Chancery protects trade-marks upon the ground that a party shall not be permitted to sell his own goods as the goods of another, and, therefore, he will not be allowed to use the names, marks, letters, and other *indicia* of another, by which he may pass off his own goods to purchasers as the manufacture of another. *Croft v. Day*, 7 Beav. 84; *Perry v. Truefit*, 6 Beav. 66; *Newman v. Alvord*, 51 N. Y. 192." *McLean v. Fleming*, 69 U. S. 245, 255.

A. Principles.

See IX. 6 A. 214.

See IV. 6 B. 105. *Lery v. Waitt*, 61 Fed. R. 1008.

See IV. 6 B. 105. *Macmahon Pharmaceutical Co. v. Denver Chemical Mfg. Co.*, 113 Fed. R. 468, 471.

Plaintiff ordered to give bond to defendant to pay damages if plaintiff was not entitled to injunction. *Apollinaris Brunnen v. Somborn*, 14 Blatchf. 380.

"Courts of equity proceed 'on the principle of protecting property alone and the promotion of honesty and fair dealing. The protection of the public alone' is not a sufficient ground for the jurisdiction. However, it is an element which enters, and ought to enter, into every case." *Avery v. Meikle*, 81 Ky. 73, 90.

Not necessary but advisable to demand discontinuance of alleged

infringement, as the court would look with much more favor on an honest attempt to adjust matters outside of court before bringing bill. *Brennan v. Emery-Bird-Thayer Dry-Goods Co.*, 99 Fed. R. 971.

“ ‘A court of equity does not sit as an arbiter to determine in advance upon other and changed labels which the infringer may adopt to avoid the condemnation of the court,’ and that ‘the court ought not to say how near the infringement may lawfully approximate the label of the complainant, but should cast the burden upon the guilty party of deciding for himself how near he may with safety drive to the edge of the precipice, and whether it be not better for him to keep as far from it as possible.’ ” *Charles E. Hires Co. v. Consumers’ Co.*, 100 Fed. R. 809, 813.

The court appended the label which respondent might use on his mineral water, designating it “Artificial Carlsbad,” he having with propriety acquired an equitable right in the word “Carlsbad.” *City of Carlsbad v. Schultz*, 78 Fed. R. 469.

Where respondent inadvertently and through mistake of agents used the word “patent” on an unpatented device in violation of rights of complainant, but when attention was called to it discontinued it, and there was no ground to believe it would be used in the future, there is no ground for a bill in equity; as it was a single trespass, no apprehension of future injury and damages could be recovered at law. *Globe-Wernicke Co. v. Brown*, 121 Fed. R. 185.

Plaintiffs having right to use name “Dr. J. Hostetter’s Stomach Bitters,” cannot enjoin defendants, who simply make and prepare an extract, without any false representation, showing how it can be made into “Hostetter’s Bitters,” although their customers compound it and sell it in complainants’ bottles marked with their (complainants’) labels, purchased second-hand. The name “Hostetter” had become descriptive of the contents. *Hostetter v. Fries*, 21 Blatchf. 339; 17 Fed. R. 620.

“The law is well settled that a party who has appropriated a particular trade-mark to distinguish his goods from other similar goods, has a right or property in it which entitles him to its exclusive use. This right is of such a nature that equity will protect it by injunction from invasion, and if it has been invaded, the wrongdoer is liable for the damage he has thereby caused the party whose trade-mark he has adopted or illegally imitated; which damage will ordinarily be the loss of profits caused by the

illegal or fraudulent infringement." *Hostetter v. Fowinkle*, 1 Dill. 329, 331.

"Suits for violations of trade-marks or for unfair competition, when an intent accompanies the act, involve a fraud upon the public and on him whose property right is directly impaired." *N. K. Fairbank Co. v. Windsor*, 118 Fed. R. 96.

A foreigner who registers in this country a trade-mark consisting of 'a red anchor, in a white oval space or field,' in connection with particular words, cannot afterwards enlarge his rights, as against persons having in good faith an established business under the symbol of an anchor, by a new registration, claiming broadly the use of the picture of an anchor. *Richter v. Anchor Remedy Co.*, 52 Fed. R. 455.

Court will not issue an injunction against use of a label already approved by complainant's counsel. *Weber Medical Tea Co. v. Weber*, 102 Fed. R. 156.

B. Damages and profits.

Respondents found by master to have made profit of twenty-five cents each on 900 barrels of flour by infringement of trade-mark "Champion." Evidence did not show that orator would have made this profit if respondent had not. 'This might have been true. "If the defendants made profits by their invasion of the orator's rights, the orator is entitled to them whether the same profits would have been made by the orator or not, and not to any more if they would, for the same profits could not be made by both." Report confirmed. *Atlantic Milling Co. v. Rowland*, 27 Fed. R. 24.'

Court sustained a master's report that complainant was entitled only to nominal damages for use of name by respondent of W. H. Baker (William H. Baker), complainant's initials being "W. H.", and he having acquired reputation as "W. H. Baker." Evidence failed to disclose that complainant was entitled to any recovery except for nominal damages, or that any person had been deceived in the purchase. *Baker v. Baker*, 115 Fed. R. 297.

"The owner is entitled to recover of the infringer of a trade-mark the profits arising from the sale of the spurious goods with the trade-mark impressed upon them. He is not limited to the difference between the price for which the spurious goods would sell without, and the price of the same goods with, the trade-mark impressed upon them."

Syllabus by the court. *Benkert v. Feder*, 34 Fed. R. 534.

There being an infringement, profits allowed for six years past, although defendant did not know of infringement.

“If the principle established by these cases was not followed, a man might imitate the mark of another person, of great value, taking care not to know anything about it himself or to whom it belonged, and he would not be liable to any injunction or to account for the profits arising from the use of the mark.” *Cartier v. Carlile*, 8 Jur. n. s. 183.

No account as to profits allowed except as to user after knowledge of plaintiff's right to trade-mark. *Edelsten v. Edelsten*, 1 De G. J. & S. 185.

“A party whose trade-mark has been violated is entitled to recover all profits realized by the wrongdoer from sales of the spurious article, and also damages resulting from such violation. . . . The owner of a trade-mark is entitled to nominal damages for the violation of his trade-mark, although it is not shown that he has sustained actual damages, and although the defendant's articles are not inferior in quality to his own.” *El Modelo Cigar Mfg. Co. v. Gato*, 25 Fla. 886, 915.

“It is evident that the profit realized by the wrongdoer is not the *only* measure of damages. The spurious article may have injured the credit of the genuine one, and the profits of the owner of the trade-mark may have been greatly reduced, whilst the wrongdoer has made little or no profit.” *Graham v. Plate*, 40 Cal. 593.

“The functions of a master on an accounting do not include the imposing of exemplary damages by way of punishment. They are confined to the estimation of the profits realized by the infringer on the one hand, and of such damage as has been suffered by the complainants on the other, for the purpose of giving him compensation therefor. Complainants are not entitled to an award of punitive damages.” *Hennessy v. Wilmerding-Loewe Co.*, 103 Fed. R. 90, 96.

“If a man manufactures goods himself and puts upon them the trade-mark of another, though he may not know to whom that trade-mark belongs, he must at least know that he has himself no right to the mark. That knowledge makes him liable to account for the profits he may have realized by his conduct. But if a man buys goods from a third party, believing them to be genuine, while in fact they are spurious, it is not until he has been told that they are so, that he can be considered to be guilty of any fraud, or

to be liable to render any account. In the present case the plaintiffs have failed to establish any such knowledge on the part of the defendants, and if, on the filing of the bill, the defendants had offered the plaintiffs their costs, and the plaintiffs had persevered with their suit." *Moet v. Couston*, 10 L. T. n. s. 395, 396.

Where a party using cartons so like those of complainant as to deceive, discontinued their use on learning of the wrong, there might be an injunction against use; but since no intentional fraud is shown under unfair trade, there should be no decree for damages. (Reversing on question of damages 118 Fed. R. 96.) *N. K. Fairbank Co. v. Windsor*, 124 Fed. R. 200.

"If he [defendant] did not sell, the profits on the sales are not chargeable to him; but if any profits came to him for preparing the article for those who did sell, they belong to the complainant, and the object of the accounting is to ascertain that fact. And if the defendant has damaged the complainant by the unlawful use of his trade-mark, the nature and extent of the damage is a proper subject of inquiry." *Sawyer v. Kellogg*, 9 Fed. R. 601, 602.

In a suit for accounting on ground of unfair trade in use of red and blue label on Hunyadi mineral water which was an infringement, the complainant is not obliged to show the proportion of profits attributable to the label alone as distinguished from the name "Hunyadi," the capsule and size of the bottle; nor should the respondent be allowed to charge out of the profits the traveling expenses and salaries of salesmen engaged in selling such water where there is no separate account, and where such expenses are paid out of a general account of which the water is only a part. *Saxlehner v. Eisner & Mendelson Co.*, 138 Fed. R. 22.

"The chief contention in this case arises over the refusal of the master to make allowance for certain expenses, in his computation of the profits realized by the defendant by imitating complainant's labels, brands, trade-marks, etc. . . . While it is customary in the computation of profits in this class of cases to make allowance for expenses, yet the expenses so allowed must be expenses necessarily incurred in the unlawful venture, which would not have been incurred but for engaging in such venture. When an unlawful business is carried on in connection with the defendant's regular business, and the same agencies are employed in doing that which is lawful and that which is unlawful, no rule of law of which I am aware requires any deduction for expenses in estimating the profits of the unlawful business. In this case the

defendant was a distilling company. It has a place of business, a license for doing business, travelling salesmen, etc. The proof does not convince me that any additional expenses were incurred by the defendant in the manufacture and sale of Benedictine, other than such as the master has allowed. The manufacture of Benedictine was carried on in connection with its ordinary business by the usual number of employés. The unlawful venture increased the gross profits without swelling the gross expenses." *Société Anonyme v. Western Distilling Co.*, 46 Fed. R. 921.

In suit to recover profits made by the defendant in sales of unfair trade the net profits should be ascertained by a deduction from gross profits of expenses of sale. *Walter Baker & Co., Ltd., v. Slack*, 130 Fed. R. 514.

Where there has been an invasion of party's right by unfair trade, he is entitled on proper proofs to compensation to the extent of the invasion. A case of simulation of advertisements. *Williams v. Mitchell*, 106 Fed. R. 168.

C. Injunction.

(1) Preliminary injunction.

See IX. 5, 211. *Garrett v. T. H. Garrett & Co.*, 78 Fed. R. 472.

"An interlocutory injunction operates somewhat in the nature of judgment and execution before trial. Without question it is at times an appropriate remedy in the prevention of great wrong but to authorize its issuance there must exist a pressing necessity. The right to it must be clear, and the apprehended injury must be grievous, and generally, where the injury may be measured in money, the alleged wrongdoer should be shown to be unable pecuniarily to respond." Exclusive right to name "Pettijohn" affixed to cereal foods being doubtful, preliminary injunction denied. *American Cereal Co. v. Eli Pettijohn Cereal Co.*, 76 Fed. R. 372; affirming 72 Fed. R. 903.

Where date of origination of combination of color and form is not clear, preliminary injunction will not be granted. *Cantrell & Cochrane, Ltd., v. Witteman*, 109 Fed. R. 82.

"He knew it to be the recognized designation of the plaintiff's tobacco, which had become popular with consumers and the trade. Did he not expect the public to be influenced thereby and his business increased? An affirmative answer cannot well be avoided. If he did not, however, the injunction will do him no

harm, for he has not yet had time to establish a reputation of his own under this name. . . . A preliminary injunction as prayed for will be granted." *Carroll v. Ertheiler*, 1 Fed. R. 688, 691.

Preliminary injunction will not be granted where complainant has long delayed bringing bill, so that if it had acted at once a final hearing on the merits might have been had, and where no pecuniary damages have resulted. *C. O. Burns Co. v. W. F. Burns Co.*, 118 Fed. R. 944.

Complainant entitled to continuing of preliminary injunction in view of the frequency of respondents' acts of infringements. *Cravenette Co. v. Benjamin*, 105 Fed. R. 621.

Where title to trade-mark "Crescent" is doubtful, no preliminary injunction should issue. *Diamond Match Co. v. Safe Harbor Match Co.*, 109 Fed. R. 154.

Where it clearly appears by proof and comparison that there is such a simulation of packages by the respondent as to show fraud, complainant will be entitled to preliminary injunction. *Draper v. Skerrett*, 94 Fed. R. 912.

When delay of the owner of a patent or trade-mark to prosecute infringers has been of a tendency to mislead the public, or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing. Various publishers had used word "Chatterbox" on publications from 1876 to 1885. *Estes v. Worthington*, 22 Fed. R. 822.

"In trade-mark cases, it is by no means of course to grant preliminary injunctions, even where the plaintiff's case seems to be made out; and I shall, therefore, leave the further consideration of the case to the final hearing, when the question as to the defendant's claim of right to the use of the words 'Fairbanks' patent' and the other questions of fact just referred to, and the unexplained circumstances and terms of the writing claimed to have extinguished the right of Chamberlain, can, if necessary, be further considered. The motion for an injunction must be denied, and the order heretofore made, granting an injunction till the decision of the motion, must be vacated." *Fairbanks v. Jacobus*, 14 Blatchf. 337, 341.

"We are, however, satisfied that in this case, the injunction, if to be granted at all, ought to await the result of a trial upon the merits. It is a grave matter to petrify in an instant a living

business by a mere interlocutory order." *Foster v. Blood Balm Co.*, 77 Ga. 216, 226.

Where respondent's affidavits on motion for preliminary injunction indicate a prior use by another, injunction will not issue. *French v. Alter & Julian Co.*, 74 Fed. R. 788.

"To a preliminary injunction the plaintiffs are not, on this branch of the case entitled. Neither party has any exclusive right in the article known as Hamburg tea, which appears to be a compound known in the German books of medicine; nor do the plaintiffs at present appear to have any special right in respect to the form, size, and color of the packages, the labels upon which are sufficient to distinguish, even to a careless observer, the one from the other. A preliminary injunction must issue against the defendant, restraining him from the use of the name of 'J. C. Frese & Co.,' and from that of the trade-mark, or label, 'J. C. Frese & Co., Hopfensack, 6 Hamburg,' on packages of Hamburg tea, and the residue of an injunction asked for is denied." *Frese v. Bachof*, 13 Blatchf. 234, 236.

"A glance at the two marks shows that the defendants have taken bodily the picture or representation which forms the complainants' trade-mark, and appropriated it to their own use. To my mind the infringement is so clear that it requires no further discussion; and, if there is any defence to this motion, it must rest upon some other ground. . . . In a case of this character, if the court has no doubt on the question of infringement, an injunction should be granted at this stage of proceedings, unless there are special circumstances which take the case out of the general rule. I do not find any such special circumstances in this case. The defendants contend that it would work irretrievable injury to them to grant this motion, but this position is not supported by the proofs." *G. G. White Co. v. Miller*, 50 Fed. R. 277, 278.

On application for preliminary injunction for infringement of registered trade-mark "Napoleon" on cigars it appeared that the mark had been anticipated, but there was evidence of unfair trade; held, that injunction would not issue till it clearly appeared that a Federal question was involved." *Goldstein v. Whelan*, 62 Fed. R. 124.

"The learned counsel for the defendant invokes the rule that 'it is only when the legal title is clear that a court of equity will interfere by injunction to restrain the use or colorable infringement of a trade-mark.' We are of the opinion that the allegations of the complaint show a clear legal right in the plain-

tiff to the exclusive use of the trade name 'Clysmic,' and hence that the injunction was properly allowed in the first instance." *Hill v. Lockwood*, 32 Fed. R. 389.

Where priority of right and evidence of fraudulent intent are doubtful, and question of laches is raised, complainant is not entitled to preliminary injunction against responsible respondent in case of alleged infringement of trade-mark. *H. Mueller Mfg. Co. v. A. Y. McDonaly & Morrison Mfg. Co.*, 132 Fed. R. 585.

Court obliged complainant to give bond of \$10,000 to respondent on application for preliminary injunction in case of unfair trade. *Kentucky Distilleries & Warehouse Co. v. Wathen*, 110 Fed. R. 641.

"The orator seeks by motion for a preliminary injunction to have the defendant restrained from using the words 'Pile Leclanche' and 'Disque,' and the orator's style of label, upon batteries of the defendant's manufacture. . . . As the medals were awarded to the patented batteries, the representation of them upon the labels would be indicative of the reputation of these batteries rather than of their origin. Under these circumstances and authorities, the question whether these things all together amount to an unlawful representation of the source of the batteries is so doubtful that the granting of a preliminary injunction does not appear to be warranted." *Leclanche Battery Co. v. Western Electric Co.*, 21 Fed. R. 538.

Complainant may be compelled to give a bond with sureties on granting of preliminary injunction. *Leonard v. White's Golden Lubricator Co.*, 38 Fed. R. 922.

The question of fact, whether the cigar boxes held for sale and being sold by the defendant, with the marks, devices, and designs thereon, are such colorable imitation of the complainant's goods as to be likely to deceive or mislead purchasers to the injury of complainants, being for the jury on final hearing of the bill, and irreparable damage not being probable, there being no charge that the defendant is insolvent, there was no error in denying an interlocutory injunction. Injunctions in restraint of trade should be sparingly granted before final decree. *Lies v. Daniel*, 82 Ga. 272.

"The granting of a preliminary injunction is an exercise of a very far-reaching power, never to be indulged in except in a case clearly demanding it, and the decision of a court of first instance, refusing such an injunction, will not, except for very strong

reasons, be reversed by this court." *New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co.*, 102 Fed. R. 890, 891.

A mere similarity in packing merchandise does not justify preliminary injunction. "To justify a preliminary injunction, the plaintiff's case must be clear in all respects." *Pfeiffer v. Wilde*, 102 Fed. R. 658.

"The plaintiff shows that he has used the symbols mentioned in his bill of complaint to designate cigars made by him; and that the defendants make use of the same. But the affidavits of defendants show that the same symbols were used by others upon cigar boxes before, or about the time the plaintiff began to use them. These affidavits make it doubtful whether the plaintiff has so had the exclusive use of the symbols that the use of them by the defendant serves to pass their cigars as those of the plaintiff. This question cannot safely be determined upon the affidavits, but should be established by evidence regularly taken in due course. The plaintiff does not appear to be entitled to a preliminary injunction. Motion denied." *Portuondo v. Monne*, 28 Fed. R. 16.

To justify preliminary injunction plaintiff's case must be clear in all respects. *Postal Tel. Cable Co. v. Netter*, 102 Fed. R. 691.

"A motion is made for a preliminary injunction to restrain the use of the word 'Cream' in connection with the words 'Baking Powder,' which is manufactured and put upon the market by the defendant, and, as is alleged, in packages having labels and wrappers similar in design to those upon the goods of complainant, and exact enough to deceive. . . . The complainant is certainly entitled to protection in the use of this word, in connection with the baking-powder it manufactures, unless it is adopted and used as descriptive of the article, its ingredients or characteristics. . . . It is unnecessary to consider the other ground urged, that the form in which the article manufactured by the defendant is put upon the market, its wrappers and labels and other devices, are of a similitude exact enough to warrant the relief asked. Motion granted, with leave to defendant to move to dissolve the injunction at the next June term of this court after the answer is filed." *Price Baking Powder Co. v. Fyfe*, 45 Fed. R. 799.

"This is a motion for a preliminary injunction to restrain the use of the word 'Eureka' in trade in connection with steam and hydraulic packing. There is no question but that the orator com-

menced using that name for packing made by him in 1875, and has continued that use since that time; nor but that the defendants use that name in connection with that kind of packing, not of the orator's make, in trade; nor but that a firm known as Sellers Bros. gave that name to a kind of steam-packing patented by William Beschke in 1872, at Philadelphia, and used it in connection with that packing until early in 1874; nor but that the profits on the sales of defendants are much less than \$500. . . . On the whole case as it now stands, the orator appears to be entitled to the injunction asked. Motion granted." *Symonds v. Greene*, 28 Fed. R. 834.

Where purchasers might be readily deceived in the style and get up of cham pagne bottles, yet if he defendant has publicly adopted the same style for many years, a preliminary injunction will not be granted. *Von Mumm v. Steinmetz*, 137 Fed. R. 168.

Where imitation of boxes and stamps is not such as likely to deceive, and there is no evidence that one has been deceived, preliminary injunction will not issue. *Van Camp Packing Co. v. Cruikshanks Bros. Co.*, 90 Fed. R. 814.

(2) *Perpetual injunction.*

"An injunction is granted accordingly, restraining the defendants, their servants or agents, from selling, etc., any mineral or other waters not being the genuine 'Apollinaris Water,' under the name of 'Apollinaris Water' or 'London Apollinaris Water,' or under any other name of which the word 'Apollinaris' so forms part as to be calculated to deceive the public." *Apollinaris Co. v. Norrish*, 33 L. T. R. s. 242, 244.

Although a party on notice discontinues infringement of a trade-mark, yet if he persists in fighting every step in proceedings for injunction, an injunction should issue against him. *Hutchinson v. Blumberg*, 51 Fed. R. 829.

4. Relief in Law.

At law the proper remedy is by an action on the case, and proof of fraudulent user is the essence of the action, but to sustain a bill in this court, it is not necessary to prove fraud, or that the credit of the plaintiff was injured by sale of inferior article; the injury done to plaintiff by loss of custom is sufficient to support his title to relief. *Edelsten v. Edelsten*, 7 L. T. R. n. s. 768.

A. Damages.

“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. We are aware that the propriety of this doctrine has been questioned by some writers, but if repeated judicial decisions for more than a century are to be received as the best exposition of what the law is, the question will not admit of argument. By the common as well as by statute law, men are often punished for aggravated misconduct or lawless acts by means of a civil action, and the damages, inflicted by way of penalty or punishment, given to the party injured. In many civil actions, such as libel, slander, seduction, etc., the wrong done to the plaintiff is incapable of being measured by a money standard; and the damages assessed depend on the circumstances, showing the degree of moral turpitude or atrocity of the defendant’s conduct, and may properly be termed exemplary, or vindictive rather than compensatory.

“In actions of trespass where the injury has been wanton and malicious, or gross and outrageous, courts permit juries to add to the measured compensation of the plaintiff which he would have been entitled to recover had the injury been inflicted without design or intention, something further by way of punishment or example, which has sometimes been called ‘smart money.’ This has always been left to the discretion of the jury, as the degree of punishment to be thus inflicted must depend on the peculiar circumstances of each case.” *Day v. Woodworth*, 13 How. Pr. 363, 371.

Now, in trespass with the allegation of a *continuando*, or “*diversis diebus*,” if the plaintiff insists upon proving repeated acts of trespass, he will not be allowed to give evidence thereof, unless committed within the time specified. In truth, the usual mode of declaring in actions for infringement of a patent is, to allege that the defendant on such a day, (naming it) “and on divers other days and times between that day and the day of the commencement of the suit (or exhibiting the bill), did unlawfully, etc., make and sell, and use, etc.” *Eastman v. Bodfish*, 1 Story, 528.

Where party alleges: “Since the 1st day of November, 1888,

knowingly, wilfully, and fraudulently, offered for sale, and is now selling, glue in packages," etc., there is no *continuando* with reference to matter of selling, and at common law the plaintiff could prove only one sale. Verdict for damages of \$8,000 reversed. *Le Page Co. v. Russia Cement Co.*, 51 Fed. R. 941.

"In a case like this (an action of trespass on the case for trade-mark infringement), if in any, no reason exists for giving greater damages than have actually been sustained, or what have been called compensatory. There is nothing peculiarly atrocious in the conduct of the defendant, to be punished by damages, and in no other way, as a public example, considering the blamable usages which exist on this subject." *Taylor v. Carpenter*, 2 Wood & M. 122; Fed. Case No. 13785.

"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, 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 and deception." *Warner v. Roehr*, Fed. Case No. 17189 a.

5. Costs.

See XIII. 1 B. 286. *Weed v. Peterson*, 12 Abb. Pr. n. s. 178.

"If a man should imitate another person's label or trade-mark, and sail so near the wind as just to avoid an injunction, and do so intentionally, though the court does not grant the injunction, it would not willingly give him any costs of the proceedings." *Bass v. Dawber*, 19 L. T. n. s. 626.

Where offer to disclose manufacturer and surrender profits, and sell no more thread and pay costs to that time was not made till time of filing answer, subsequent costs allowed, the infringers not being ignorant of spuriousness of thread. *Coats v. Holbrook*, 2 Sandf. Ch. R. 586.

Where complainant succeeded only in part on bill for unfair trade it was not allowed costs. *Clark Thread Co. v. Armitage*, 67 Fed. R. 896.

A decree for complainant in contested suit for infringement of trade-mark carries costs except under exceptional circumstances. *Hennessy v. Wilmerding-Loew Co.*, 103 Fed. R. 90.

Where respondent before suit has discontinued objectionable

labels, no costs will be allowed complainant. *Lever Bros. v. Smith*, 112 Fed. R. 998.

Where there has been unnecessary delay on part of the respondents in presenting objections to master's report to the court, while the court would not sustain the master's finding on damages in unfair trade, yet would allow costs of court and master's fees. *N. K. Fairbank Co. v. Windsor*, 124 Fed. R. 200.

"As to the matter of costs, we find nothing in this case to take it out of the ordinary rule that a decree for an infringement and an injunction carries costs. The only reason suggested by the counsel for the defendant was, that no demand was made before suit that the defendant should cease to use the label. We have never understood that in such cases a demand was necessary, nor that an infringer, who stoutly contests the suit to the end, should be relieved from the payment of the costs, which have been incurred in consequence of his wrong-doing and his litigation." *Sawyer v. Kellogg*, 9 Fed. R. 601, 602.

"It is his (the defendant's) duty at once to give all the information required, and to undertake that the goods shall not be removed or dealt with until the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose. If, after that, the person injured files a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from such defendant the costs of the suit, and he may have to pay them." *Upmann v. Elkan*, L. R. 12 Eq. 140, 145.

6. Criminal Remedy.

There are criminal statutes against the illegal use of registered trade-marks under the laws of various States.

7. Parties.

See XV. 3 B. 305. *Moet v. Couston*, 10 L. T. N. S. 395.

"I think that this is not the kind of action which ought to be encouraged. If the owner of a trade-mark finds that it is being pirated, surely it is not the small retailer who ought to be punished, but an endeavor ought to be made to prosecute those who placed the spurious goods on the market; and although I agree that the plaintiffs are entitled to an injunction, yet I cannot think it is the duty of the court in every case in which a small retail

dealer who has innocently (and I think that the defendants in this case have acted innocently) happened to purchase a small quantity of the spurious goods, to say that he ought to be fixed with the costs of the action." *American Tobacco Co. v. Guest*, L. R. (1892) 1 Ch. D. 630, 632.

Complainant had from owner of mineral spring in Hungary sole right to export mineral water under his trade-mark "Hunyadi Janos," to United States, but that gave him no right to protection against one who under same name exported to United States bottles of the water bought in the general market and not sold by the owner of the spring for the purpose of export. *Apollinaris Co. v. Scherer*, 27 Fed. R. 18.

"The plaintiffs have brought their bill against the defendants named, and are met by a demurrer. . . . A ground of demurrer is that the directors of the defendant corporation are joined as parties defendant, which, it is insisted, is a misjoinder. . . . The current of authority in this country seems clearly to justify the plaintiff's action in joining the directors. In the case of *Poppenhausen v. Falke*, it was held that, where persons were acting in concert in infringing a patent, although they act merely as employés of a corporation, they are liable to be sued therefor jointly in one suit. It is true that there is a class of agents — such as mere workmen in the employ of a manufacturer — against whom there can be no recovery, although they may have participated in the acts of infringement. But ordinarily the infringer cannot escape the responsibility by showing that he was acting for another." *Armstrong v. Savannah Soap Works*, 53 Fed. R. 124, 125.

Where labels are so alike that attempt at deceit is evident, the court will issue an injunction against a party who is only a dealer, having purchased the goods from the original imitator with the intent to resell them, and the fact that since suit has begun he has voluntarily ceased to deal in goods is no bar to injunction. *Burnett v. Hahn*, 88 Fed. R. 694.

"Respondent urges that there is a misjoinder of parties defendant. I do not think so. The bill alleges that the respondents, Bishop et al., are using the corporation but as a means of infringement; that they are substantially the corporation. In the case of *Nerve Food Co. v. Baumbach*, the Star Bottling Works, a corporation, was joined with the respondent Baumbach, under the same circumstances, the corporation, namely, belonging to him." *California Fig Syrup Co. v. Improved Fig Syrup Co.*, 51 Fed. R. 296, 298.

“ It is true that the bill does not show that the defendants have affixed any of the spurious labels to cigars of their own manufacture, or that they have sold any cigars bearing the counterfeit certificates or labels. But this is not important. From the fact that they have made and sold spurious labels and advertised them for sale, the court must presume that defendants intend that they shall be used on cigar boxes by the persons who buy them, and that they manufacture and sell them for that purpose. The conduct of the defendants is equally as culpable as that of the manufacturers of cigars who buy and use the spurious labels, and the loss which complainant sustains by the use of the same on cigar boxes is directly attributable to the persons who make and sell the counterfeit labels as to the dealers in cigars who buy and use them.” *Carson v. Ury*, 39 Fed. R. 777, 780.

Not only the user but the engraver of a trade-mark may be held liable for infringement. *C. A. Yale Cigar Mfg. Co. v. C. A. Yale*, 30 O. G. 1183.

Alien protected in our courts in trade-mark cases. *Couts v. Holbrook*, 2 Sandf. Ch. 586.

“ Nor is there anything to the suggestion that injunction will not lie against defendants, because they do not themselves make, pack, or sell the fraudulent cigars. No doubt they may make the boxes without objection. There is no trade-mark, so far as appears, in the style, size, or shape of a cigar box. But they do much more. They procure labels counterfeiting the complainant's, and assemble these labels with their boxes, with the obvious purpose of enabling others by the use of the labels to palm off their goods upon the public as the goods of the complainant. Complainant is clearly entitled to an injunction against all who knowingly combine together to accomplish that purpose.” *Cuervo v. Jacob Henkell Co.*, 50 Fed. R. 471, 472.

An injunction against principals binds them subsequently so that they cannot as agents of others do the acts enjoined; but an injunction against principals, their servants and agents does not bind the servants and agents when they cease to become so and act as principals. *Dadirrian v. Gullian*, 79 Fed. R. 784.

“ Upon the allegations of the bill, the defendants are actively engaged in assisting third persons to use the complainants' trade-mark in violation of their rights. The mere act of printing and selling labels in imitation of the complainants' might be innocent, and without evidence of an illicit purpose, would not be a violation of the complainants' rights. It is otherwise, however, when

this is done with the obvious purpose of enabling others by the use of the labels to palm off their goods upon the public as the goods of the complainants." *De Kuyper v. Witteman*, 23 Fed. R. 871.

In a suit to enjoin certain individuals from unfair competition, the corporation of which they are officers is not an indispensable party. *Elgin Natl. Watch Co. v. Loveland*, 132 Fed. R. 41.

"The infringement of a trade-mark is a trespass upon the rights of the owner by using it as a false representation that the wares of the infringer are those of the owner, for which an action of trespass on the case would lie at common law, in which all participating would be principals and proper defendants." *Estes v. Belford*, 30 O. G. 99.

"No person should be made a party who has no interest in the suit, and against whom no decree can be had at the hearing; and for this reason a person who is a mere agent for another in the transactions in controversy ought not generally to be made a party defendant, unless his presence is necessary for the purposes of discovery. And it has been held in suits for infringements of patents that there is a class of agents, such as mere workmen in the employ of a manufacturer, against whom there can be no recovery, although they may have participated somewhat in the acts of infringement. But ordinarily the infringer cannot escape responsibility by showing that he was acting for another. In torts of misfeasance, like the violation of a trade-mark, agents and servants are personally liable to the injured party. All persons procuring or assisting in the commission of a trespass are principals in the transaction, and both the master who commands and the servant who does the act of trespass may be made responsible as principals, and may be sued jointly or severally for damages, as the injured party may elect. A joint action will lie against the principal and agent. . . . It follows that the defendants, although they were only the agents or servants of Richard Worthington, in doing the wrongful acts sought to be restrained and for which damages are claimed, are responsible to the complainant and the complainant has the right to pursue them." *Estes v. Worthington*, 30 Fed. R. 465.

If a party has caused to be sold to dealers counterfeit labels with the intent that they be used in fraud it is an infringement, and it is not necessary to further allege that the party has manufactured the labels. *Hennessy v. Herrman*, 89 Fed. R. 669.

“Under these circumstances, I think the complainant is entitled to an injunction restraining the defendant from selling a spurious article of bitters as and for Hostetter’s Bitters. Customers of defendant, who have thus been advised and induced to use genuine bottles and labels in the manner above mentioned, are clearly guilty of a wrongful act which a court of equity will enjoin; and a person who counsels and advises another to perpetrate a fraud, and who also furnishes him the means of consummating the same, is himself a wrongdoer, and, as such, is liable for the injury inflicted. The defendant cannot shield itself from an injunction by the plea that it has not itself sold a spurious article in a false dress. *Hostetter Co. v. Brueggeman-Reinert Distilling Co.*, 46 Fed. 188, 189.

Parties who have an actual, though not an equal interest, in trade-marks and labels may be joined as plaintiffs in one suit. *Jewish Colonization Ass’n v. Solomon*, 125 Fed. R. 994.

A distiller granted for five years sole and exclusive control of his bottled product of whiskey and agreed not to allow any other party to use his trade-mark. Held, that where a third party infringed the trade-mark on bottled goods, the distiller should be made a party complainant as he had a valuable interest in the trade-mark, unless it is shown that he was requested and refused to join. *Krauss v. Jos. R. Peebles’ Sons Co.*, 58 Fed. R. 585.

Fact that complainant is an alien does not affect his right of property in a trade-mark at common law, independent of statute of registration. *La Croix v. May*, 15 Fed. R. 236.

Owner of a trade-mark is not estopped from bringing suit to enjoin an infringement of it by the fact that he has made a third party his licensee for the territory in which the defendant carries on his business as to which infringement is charged. *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. R. 205.

“All who are concerned in the commission of a tort are alike amenable to the party injured.” *Sawyer v. Kellogg*, 7 Fed. R. 720, 722.

“But in the courts of the United States, under the Constitution and Laws, they are entitled, being alien friends, to the same protection of their rights as citizens. There is no pretence to say, that if a similar false imitation and use of the labels of a citizen, put upon his own manufactured articles, had been designedly and fraudulently perpetrated and acted upon, it would not have been an invasion of his rights, for which our law would have granted ample redress. There is no difference between the

case of a citizen and that of an alien friend, where his rights are openly violated." *Taylor v. Carpenter*, 3 Story, 458, 463.

Where there is an exclusive licensee of a trade-name and a patent the licensor cannot maintain suit for infringement in his own name without joining the licensee. *Wallach v. Wigmore*, 87 Fed. R. 469.

8. Pleadings.

"The declaration further alleges, in substance, that the defendant, well knowing the plaintiff's said mark, and for the purpose and with the effect of such deception, did stamp the words 'Roger Williams' upon cotton cloth not manufactured by the plaintiff, and to his serious injury. Certainly, under the rule, so well settled, that a partial imitation of a trade-mark, if calculated to deceive, will support an action, this is a sufficient allegation of an invasion of the plaintiff's rights. The court cannot, as a matter of law, decide that such partial use of the designation of his goods appropriated by the plaintiff was not designed, calculated, and effectual to carry out the fraud charged, and must leave that, as well as the prior allegation, to be settled upon the evidence by the jury. The demurrer is therefore overruled; but under the agreement of the parties, suggested at the argument, the defendant has leave to withdraw his demurrer without costs, and to plead over to the merits." *Barrows v. Knight*, 6 R. I. 434, 439.

Allegation of following facts held on demurrer to constitute a cause of suit.

"The complainants and the defendant are competitors in the same line of business. The defendant has assumed a trade-name similar to, and in imitation of, complainants' trade-name, and the public has been deceived thereby, and great confusion and injury has resulted to complainants' business therefrom. The incorporators of the defendant corporation, before its organization, knew of the existence and character of the complainants' business, and the trade-name under which it was being carried on; and, notwithstanding its attention has since been called to the injury which it has done to the complainants' business, it refuses to desist from the use of the name so wrongfully used." *Block v. Standard Distilling & Distributing Co.*, 95 Fed. R. 978, 980.

Where in suit for infringement of a trade-mark exhibits of the devices are used by both complainant and defendant accompany-

ing the bill, the court will sustain a demurrer to the bill where the exhibits show that there is no infringement. *Collins Chemical & Mfg. Co. v. Capitol City Mfg. Co.*, 42 Fed. R. 64.

“The pendency of a similar action in the State court seems to present no bar to the relief asked for.” Motion for preliminary injunction on fraudulent imitation of labels. *Collinsplatt v. Finlayson*, 88 Fed. R. 693.

A bill alleging different acts and kinds of infringement of style of dressing of goods, and manner of lettering and wording not multifarious as it is not necessary to bring separate bills. *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. R. 651.

“The defendant insists that there are such differences in his mode of using and combining the colors on the wrapper that no careful purchaser need be deceived, if he exercise ordinary care and prudence. This may be true and in the absence of fraud, and upon the merits the court may not be willing to hold that an infringement has been shown. But the fraud has been confessed by the demurrer, and such confession entitles the complainant to an injunction. The demurrer is overruled and twenty days’ time is given to the defendant to answer the complainant’s bill on its merits.” *Enoch Morgan’s Sons’ Co. v. Hunkele*, 16 O. G. 1092, 1093.

A plea in abatement averring that there is another suit pending in which the co-defendants are merely the servants or agents of W. is not good, as servants and agents are liable jointly and severally with the masters. *Estes v. Worthington*, 30 Fed. R. 465. See *idem*, XV. 7, 318.

“The allegations of the bill upon information and belief are insufficient. Whatever is essential to the rights of the complainant, and is necessarily within its knowledge, ought to be alleged.” *Gaines & Co. v. Sproufe*, 117 Fed. R. 965, 966.

A bill in equity should contain a specific allegation of fraud, and when it does not the word “fraudulent” adds nothing to the averments of fact, and is demurrable. *Garst v. Hull & Lyon Co.*, 179 Mass. 588.

Bill for unfair competition in use of word “Webster’s” on dictionaries. “Because the denials in the plea do not fully meet the averments in the bill of evidential facts which should be either traversed or admitted, the objections to the plea are well taken.” *G. & C. Merriam Co. v. Straus*, 136 Fed. R. 41.

Equity is without jurisdiction of a suit for infringement of patent where it appears by plea set down for argument. f as

admitting truth) that on learning of infringement, and before commencement of suit, respondent finally and in good faith abandoned making and selling of patented articles and does not intend to further infringe. *General Electric Co. v. N. E. Electric Mfg. Co.*, 123 Fed. R. 310.

A bill alleging that respondent wrongfully prints and furnishes wrappers to business competitors similar to those used by complainant and by unlawful imitation directly contributes to wrongful and unlawful diversion of trade, whereby goods of competitors are sold as and for goods of complainant, is not demurrable for failure to allege that there was unlawful use in sale of goods of specific kind as those of complainant. *Hildreth v. Sparks Mfg. Co.*, 99 Fed. R. 484.

Two separate and distinct defences cannot be raised by plea, and a defect on the face of the bill, viz., that there is no allegation of exclusive right in complainant, must be raised by demurrer. *Hostetter Co. v. E. G. Lyons Co.*, 99 Fed. R. 734.

Complaints for infringement of trade-marks and of labels may be made in one bill.

Defence that a trade-mark is invalid because geographical should not be raised by demurrer. *Jewish Colonization Ass'n v. Solomon*, 125 Fed. R. 994.

“The theory of the demurrer is that the complainant’s statutory title upon allegations of the bill is invalid. It is not necessary to decide the questions raised, because, as the demurrer is to the whole bill, the bill is sufficient if all the allegations concerning a registration of the trade-mark were eliminated.” *La Croix v. May*, 15 Fed. R. 236, 237.

A bill for infringement of a trade-mark cannot, on failure to prove a valid trade-mark, be sustained on the ground of unfair trade where it is not charged that respondent has injured or intended to injure complainant by deceitfully misrepresenting and marketing his product as the product sold by the complainant under a certain name. *Lamont v. Leedy*, 88 Fed. R. 72.

A bill alleging that defendants have imitated complainant’s peculiar style of bronzing horse-shoe nails, with fraudulent intention of deceiving the public, is not bad on demurrer, as the court will not decide on the pleadings whether or not there may be fraud entitling the complainant to relief. *Putnam Nail Co. v. Bennett*, 43 Fed. R. 800.

An answer under oath called for by bill that respondent had a prior use of a certain alleged trade-mark “Parker,” on whiskey,

is, although in nature avoidance, so far responsive to allegations of bill that it is evidence for respondent, to be overcome by complainant. *Uri v. Hirsch*, 123 Fed. R. 568.

"The proper practice, when objection is made to the form of a plea, is to file exceptions thereto. When a plea is set down for argument no exception can be taken to its regularity or form. The objection to the form of the plea must be overruled, and the plea in that respect taken to be good." *Vacuum Oil Co. v. Eagle Oil Co.*, 122 Fed. R. 105, 106.

A bill alleging that a mail order company advertises "Winchester Model Single Shot Take Down Rifles," and fills order for said rifles with rifles of an inferior grade not made by the complainant, thus deceiving the purchasers and injuring complainant's business, is demurrable where it does not allege that it sells other rifles as and for complainants' rifles and that parties have been deceived thereby. No cause of complaint alleged. *Winchester Repeating Arms Co. v. Butler Bros.*, 128 Fed. R. 976.

9. Appeal.

When it clearly appears that the court below would in not granting to the complainant a preliminary injunction against use of peculiar shaped bottles for root beer employed by the respondent with fraudulent intent, on appeal the court will correct the error and issue preliminary injunction. *Charles E. Hires Co. v. Consumers' Co.*, 100 Fed. R. 809.

"When the trial court has considered conflicting evidence, and made its finding and decree thereon, they must be taken as presumptively correct, unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the consideration of the evidence." *Gorham Mfg. Co. v. Emery-Bird-Thayer Dry-Goods Co.*, 104 Fed. R. 243, 244; affirming 92 Fed. R. 774.

"An examination of the decree rendered by the court below shows that, while it adjudges the validity of the patent sued on and directs an injunction termed 'perpetual' against the defendants as infringers, it refers the matter to a master for taking an account. It is well settled that such a decree is not a final decree from which an appeal could be taken, or of which this court would have jurisdiction, under the sixth section of the judiciary act of 1891. . . . We are, however, of the opinion that it is an interlocutory decree granting an injunction, from which an appeal

would lie under the seventh section of the said judiciary act. . . . An allowance of an appeal from an interlocutory order or decree, granting or continuing an injunction in an equity cause under the seventh section of the judiciary act of 1891, is a new feature of the practice in the United States courts. Being of a highly remedial nature, it ought to be construed so as to give full force to the intention of the lawmaker. The mischief to be remedied by the act was that injunctions which deprived parties of the possession and control of property, or compelled enforced action in the use of property, were, under the practice of the courts, frequently rendered long before the final hearing in the case, and operated, to a great extent, in the nature of execution before judgment. This mischief was as great in patent cases, where parties on hearings, preliminary to the final decree, were enjoined, pending long and tedious examinations in the matter solely of accounting, as in any other cases of preliminary injunction. The case of *Richmond v. Atwood*, decided in the first circuit, and reported in 48 Fed. Rep. 910, was a case on all fours with the present one, and therein the court took and exercised jurisdiction, apparently without question. The suit was one for an infringement of letters patent wherein an appeal was taken from a decree sustaining the patent, holding the defendant to be an infringer, awarding an injunction, and ordering an account. . . . The order of the court is that the motion to vacate the proceedings in this cause, and to dismiss the appeal for want of jurisdiction, be denied; that our former decree, remanding the cause, with directions to dismiss the bill, with costs, be, and the same is, modified so as to direct the cause to be remanded to the circuit court, with instructions to dissolve and dismiss the injunction granted in said court; and that appellee pay the costs, and that the rehearing applied for be denied." *Jones v. Munger Improved Cotton Mach. Mfgy. Co.*, 50 Fed. R. 785.

An appeal on an order denying a preliminary injunction is not like an appeal on the merits, and the order will not be reviewed unless clearly wrong. *Paris Medicine Co. v. W. H. Hill Co.*, 102 Fed. R. 148.

"It will be observed, from an examination of the cases in the Supreme Court of the United States, that a decree in patent cases, declaring the patent in question valid, and that it has been infringed, and for an injunction and an accounting, has uniformly been referred to as an interlocutory decree, and the cases are numerous, like *Barnard v. Conrad*, 7 How. 650; *Forgay v.*

Conrad, 6 How. 201; *Humiston v. Stainthorp*, 2 Wall. 106; *Milwaukee, etc., R. Co. v. Soutter*, 2 Wall. 510, 521; *Beebe v. Russell*, 71 How. 283; *Keystone Manganese and Iron Co. v. Martin*, 132 U. S. 91, where, upon an appeal from a decree determining the general property right granting an injunction, and an order for an accounting before a master, it has been held that the decree was not final or appealable. It is true, that the cases in the supreme court are based upon a different statute, and in unmistakable language deny the right of appeal from interlocutory decrees. But they are for that reason none the less significant, as showing what has been understood as the line between interlocutory and final decrees. We must assume that Congress used the term 'interlocutory order or decree,' in this connection in its common and well-understood sense, and as intending the line of distinction accepted and interpreted by the federal courts; and it follows that all injunction orders and decrees which were interlocutory, and not final, within the meaning of the old statute, and for that reason not appealable, are interlocutory under the new statute, and therefore, by the same logic and upon the same reasoning, are appealable. . . . It is quite probable — indeed, quite clear — that a distinction would be made between injunctions granted preliminarily as a matter of discretion, and a decree for an injunction granted upon the final determination of a particular right; and the general rule that an appellate court interferes reluctantly with injunctions granted *in limine* as a matter of discretion should not, in our view, apply to an appeal under the statute from an interlocutory decree for a perpetual injunction based upon a final determination of the substantial property right in a patent cause." *Richmond v. Atwood*, 52 Fed. R. 10, 21.

10. Evidence.

See XV. 8, 320. *Collins Chem. & Mfg. Co. v. Capitol City Mfg. Co.*, 42 Fed. R. 64.

"This court has held that one of the plaintiffs offering himself as a witness, and testifying on behalf of the plaintiffs, and having been asked and answered on his direct examination the question, 'What profits have been realized by your firm on each dozen of the article sold?' was bound upon the cross-examination to have answered the question, 'In making up your estimate of profits as you have given, what materials do you calculate the cost upon?'" *Burnett v. Phalon*, 21 How. Pr. 100.

A party defendant may be excused under a statute from answering questions which would tend to incriminate him of the criminal offence of counterfeiting trade-marks and labels. *Byass v. Sullivan*, 21 How. Pr. 50.

Preparation of affidavits similar in language and printed without seeing the witnesses, and sent out over the country, is not a method of obtaining testimony to be encouraged. *Carroll v. Ertheiler*, 1 Fed. R. 688.

"Nor do these courts require specific proof of purchases by individuals actually deceived, when the labels themselves show an attempt at deception which appears to be well calculated to deceive." *Collinsplatt v. Finlayson*, 88 Fed. R. 693.

Where a former decree has established the right to certain parties to use the words "Fish Bros," and "Fish Bros. & Co." with the picture of a fish on wagons such parties might assign their right, and in a suit brought against assignee to restrain such use the prior decision serves as *res judicata*. *Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co.*, 95 Fed. R. 457.

Where the only act of infringement is shown to be a marking of bill of sale of silver ware as "Gorham," after a clear statement that it was not "Gorham," and at the especial request of complainant's agent, where no one appears ever to have been deceived, there is not sufficient ground for injunction. *Gorham Mfg. Co. v. Emery-Bird-Thayer Dry-Goods Co.*, 92 Fed. R. 774. Aff'd 104 Fed. R. 243.

Evidence of witnesses procured by the complainant for the purposes of a case of unfair trade against a party is not disinterested and should be carefully weighed and scrutinized. *Hostetter Co. v. Bower*, 74 Fed. R. 235.

Where bill charges that respondents refilled with bogus bitters Hostetter bottles, the burden is on the complainant to show that the bitters are bogus, and where there is no chemical analysis and the case rests on parties who not knowing the formula have only had experience in sampling, injunction will not issue branding respondents as frauds and cheats. *Hostetter Co. v. Comerford*, 97 Fed. R. 585.

A misrepresentation of a saleswoman that two kinds of soap were made by the same firm, calling attention to different marks, one "La Parisienne," the other "Rose de France," to an agent of complainant who was not deceived, not sufficient to justify preliminary injunction. *Kroppf v. Furst*, 94 Fed. R. 150.

Proof of single sale to complainant's agent together with other

proof may justify an injunction. *Lever v. Pasfield*, 88 Fed. R. 484.

Evidence as to title of complainant's trade-mark and how the title is derived from predecessors, where such facts are in issue, should be clear and not merely inferential. *P. Lorillard Co. v. Peper*, 65 Fed. R. 597.

Certified copy of complainant's charter supplemented by parol evidence sufficient to show incorporation under answer on information and belief. *Samuel Bros. & Co. v. Hostetter Co.*, 118 Fed. R. 257.

Under allegation in complaint that the proprietor of a trade-mark has built up a large and profitable business by his skill, quality of goods, and extensive advertising, evidence is open without a special plea of the facts by the respondent that the goods are not as represented and that the trade-mark is deceitful. *Uri v. Hirsch*, 123 Fed. R. 568.

XVI. REGISTRATION.

1. Property right in a trade-mark exists at common law, and is independent of the statutes regulating registration. Under United States Statutes certificate of registration is *prima facie* evidence of ownership; but this evidence may be contradicted in court, and the mark held to be invalid.

See XVI. 3, 339. *Goldsmith v. United Shirt Vest Co.*, 119 O. G. 1261.

See II. 5 A. 29.

“A trade-mark registration is not a grant, neither is it a contract. It is a mere record permitted to an owner of a trade-mark, that has been used in commerce with foreign nations or Indian tribes, who is domiciled in the United States, or located in some foreign country which affords similar privilege to our own citizens, of which record a certificate is given by the commissioner of patents. It is true that the registration is *prima facie* evidence of ownership, but in this it is only like any other record.” *C. A. Yale Cigar Mfg. Co. Ltd., v. C. A. Yale*, 30 O. G. 1183.

“The inquiry is therefore always open as to the validity of the title to a trade-mark evidenced by the registration. The registration could not confer a title to the trade-mark upon the complainant if some other corporation or individual had acquired a prior right by adoption and use; nor could it vest defendant with a title as against the complainant’s common-law title. In this view the only office of a registration is to confer jurisdiction upon the court to protect a trade-mark when the proprietor has obtained the statutory evidence of title, and the only function of the commissioner of patents is to determine whether an applicant has a presumptive right to the trade-mark.” *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. R. 823, 826.

A party who invented a game of cards, calling it “Flinch” and selling it under that name, has acquired a common-law trade-mark, although it was never registered or copyrighted, and the game was never patented. *H. B. Chaffee Mfg. Co. v. Selchow*, 131 Fed. R. 543.

“Registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States courts.” *Hennessey v. Braunschweiger & Co.*, 89 Fed. R. 664, 668.

“Remington,” registered as a trade mark for typewriters held to be invalid as being an ordinary surname. *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118.

Property in trade-marks does not derive its existence from an act of congress. *La Croix v. May*, 15 Fed. R. 236.

While the act of 1881 does not include in the list of limitations of right to register trade-marks descriptive words, it does not by implication allow descriptive trade-marks, as rights and remedies exist independent of statutes. *L. H. Harris Drug Co. v. Stucky*, 46 Fed. R. 624.

“The right to be protected in the exclusive use of a trade-mark is not dependent on the federal statute authorizing the registration of certain trade-marks. It has been long recognized by the common law and enforced by the chancery courts of England and this country.” *Ohio Baking Co. v. Natl. Biscuit Co.*, 127 Fed. R. 116, 120.

“It is a property right, for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for part infringement. The exclusive right was not created by Act of Congress and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.” *Trade-Mark Cases*, 100 U. S. 82, 92.

A certificate of registration of trade-mark is merely *prima facie* evidence of ownership, and indictments to punish counterfeiting of registered trade-marks should aver facts showing alleged owners had acquired exclusive property therein. *United States v. Braun*, 39 Fed. R. 775.

Registration of trade-mark under invalid act of 1870 is not *prima facie* evidence of ownership as that act did not require use as condition precedent to registration. *Vanden Bergh & Co. v. Belmont Distillery Co.*, 99 O. G. 1624.

The registered trade-mark “U-C-A,” on incandescent lights, temporarily enjoined, as registration is only *prima facie* proof. *Welsbach Light Co. v. Adam*, 107 Fed. R. 463.

2. Decisions of Patent Office on Practice.

Word "squirrel" and figure of squirrel, used conjointly or separately, cannot be covered under one application where the picture is "capable of such a variety of modifications that two of the modifications might appear to be substantially different things to an ordinary purchaser." *Adam Roth Grocery Co., ex parte*, 62 O. G. 315.

Refusal to allow amendment of application under act of 1881 so as to bring it under act of 1905 is a final decision and appealable. *American Separator Co., ex parte*, 119 O. G. 339.

A label stated in application to be for wire cloth but bearing words "all goods bearing this label are guaranteed Union Made," and not signifying the purpose of its application, although having some artistic merit, not registrable. *American Wire Weaver's Protective Ass'n, ex parte*, 94 O. G. 586.

"Porto Rico," considered to be a Territory of the United States entitling citizens to register trade-marks in United States. Cuba, under laws in February, 1902, a foreign country but her citizens entitled to register trade-marks in United States. The Philippine Islands considered to be a foreign country. *Attorney General's Opinion*, 98 O. G. 2175.

A label entitled "Ayres Medicinal Wonder," with descriptive matter and directions for use, containing nothing original, and not the result of intellectual labor, not registrable. *Baldwin, ex parte*, 98 O. G. 1706.

An artistic print entitled "White Eagle Reformation," consisting of simulations of United States flag, seal, and currency, claimed to be used for advertising purposes for books, not registrable for two reasons:

1st. It does not identify the article upon which it is to be used.

2d. It is against public policy to use United States flag and seal for advertising purposes. *Bull, ex parte*, 98 O. G. 2366.

Certificate of registration will not be issued to assignee of applicant though assignment may have been previously recorded. The Patent Office cannot determine whether business has passed; and under the statute the owner should apply. *Bassett, ex parte*, 55 O. G. 997.

But see overruling case, *infra*, *Frank v. Macwilliam*, 114 O. G. 542, 338.

A foreigner seeking registration here on ground of foreign reg-

istration should produce the certificate. *Beckett, ex parte*, 119 O. G. 340

Where a registrant is decided not to be the true owner of a mark in interference proceedings, he may be allowed to cancel the mark. *Bloomington Canning Co., ex parte*, 119 O. G. 2235.

Where signature to statement is "Boston Fountain Pen Co.," and to drawing is "Boston Fountain Pen Company," there is a variance which should be corrected. *Boston Fountain Pen Co., ex parte*, 116 O. G. 2531.

There is no appeal from examiner's decision allowing registration of trade-mark except in clear case. *Broderick & Bascom Rope Co. v. Leschen & Sons Rope Co.*, 96 O. G. 1647.

The words "Satin Polish" are so far a genuine if imperfect attempt to describe merchandise that they may be retained as part of a label for registration. *Brigham, ex parte*, 20 O. G. 891.

"Junior" and "Jr.," not necessarily following a name, are not true alternatives and cannot be registered as one trade-mark. *Bryant Electric Co., ex parte*, 119 O. G. 2522.

Application for registration of the words "Centennial Isidor Bush & Co., St. Louis, Mo., in combination with registered trade-mark and obverse and reverse of the centennial medal. On Appeal.

"I do not, however, think it a safe practice to permit the registration of a compound trade-mark, one of whose distinguishing features has already been appropriated and registered by another as applied to the same class of merchandise." One feature resembles another trade-mark. *Bush & Co., in re*, 10 O. G. 164.

An application should include a description as accurate as possible and a drawing. *Carborundum Co., ex parte*, 118 O. G. 2250.

It is not a matter for interference proceedings that some third party has used the mark at issue. *Carey v. New Home Sewing Machine*, 101 O. G. 448.

Application for trade-mark described as the word "circle" or representation of a circle, not sustained by a facsimile disclosing two concentric circles with words "Circle Polish" in space between them, and in the field within the inner circle the letters "C. P." arranged as a monogram. It does not show alternative marks by use of word "circle" or representation of circle alone. *Circle Manufacturing Company, ex parte*, 98 O. G. 2365.

A label with words "Cast Steel Cement for Perfecting Iron & Steel Castings," and monogram "C. S.," without artistic merit

and merely calling for skill in type-setting, not registrable. *Clark Cast Steel Cement Co., ex parte*, 99 O. G. 2968.

Registration for good grounds may be refused even after publication, although there is no notice of opposition. *Cluett, Peabody & Co., ex parte*, 120 O. G. 902.

Applicant cannot register a symbol of a cross as a trade-mark for boots and shoes without describing it more particularly as a cross of certain style, as the designation of the figure by word "cross" is too generic. It should be noticed also that applicant's name is Cross. *Cross, ex parte*, 107 O. G. 2236.

A mark should be registered only as used.

Where application showed word "Tunnel," with pictorial representation of miner's cap, lamp, tools, the statement that word "Tunnel" alone might be used showed a variation. *Crowley, ex parte*, 99 O. G. 228.

Where applicant for registration of trade-mark has incorrectly stated its place of incorporation, the error is of no consequence, and does not affect validity of registration. *Crucible Steel Co. of America, ex parte*, 107 O. G. 270.

The description of a trade-mark should include all the features material thereto shown in the drawing. *Dr. Peter Fahrney & Sons Co., ex parte*, 119 O. G. 1924.

A drawing and description should agree so that a mark said to be Moss Back should not appear drawn as Moss-Back. *E. C. Atkins & Co., ex parte*, 119 O. G. 2236.

The background of a word in drawing consisting of vertical lines is not part of the trade-mark, and the word alone is registrable. *Eli Lilly Co., ex parte*, 119 O. G. 2234.

Single shipment of goods to Mexico with mark concealed and instructions to keep it secret, even if a *bona fide* sale, not such a public use of the mark in this country as to indicate intention to use it, and does not justify registration. *Farmers Mfg. Co. v. Harrison*, 96 O. G. 2062.

On all doubtful cases as to infringement the benefit of the doubt should be given to the prior registrant. *Flint & Walling Mfg. Co.*, 85 O. G. 148.

Affidavits, being *ex parte*, in an interference proceeding do not constitute proper evidence upon which to found a judgment contrary to the allegation of an application for a trade-mark. *Frank v. Macwilliam*, 108 O. G. 291.

A mark consisting of a horizontal row of billiard balls between billiard cues (which alone is registrable) conjoined with the de-

scriptive word "rubber back" as applied to billiard cloth, is not registrable, as the word is descriptive. *Goodman-Leavitt-Yatter Co., ex parte*, 107 O. G. 834.

Failure to prosecute application for trade-mark for a year is such laches as would amount to an abandonment, so that the application would be considered as no longer pending. *Griser-Werke Paul Camphausen, ex parte*, 120 O. G. 327.

Where a foreign citizen is located in a foreign country other than that in which he is a citizen, application will be governed by existing treaty with the country of location rather than citizenship. *Haggenmacher, ex parte*, 60 O. G. 438.

A fac-simile showing a lozenge-shaped figure and word "Indurine" does not conform to application claiming a trade-mark the essential feature of which was lozenge-shaped figure. There is a variation between fac-simile and application. *Hall, ex parte*, 98 O. G., 2174.

Requirement for division of application is final judgment and appealable. *Hamilton, ex parte*, 118 O. G. 269; *Harris, ex parte*, 117 O. G. 903.

A drawing of single ivy leaf held to justify registration under application of arbitrary word "Ivy" or the representation as trade-mark on cutlery. *Hecht, ex parte*, 96 O. G. 1648.

A label entitled "Dr. Houghton's Rheumalgine" with arrangement of printed matter naming and describing medicine and giving directions for use, with no artistic merit, is not entitled to registration. *Houghton, ex parte*, 99 O. G. 1623.

A party who has used words "American Volunteer" on boots and shoes, entitled to registration, as against one who has since used the word "Volunteer" for overshoes. *Joseph Banigan Rubber Co. v. Bloomfield*, 89 O. G. 1670.

"Meats," is not a sufficiently definite description of a particular class of goods to justify registration of a mark. *Kingan Packing Association, ex parte*, 119 O. G. 2234.

"Meats," is not sufficiently definite in designation of "particular goods" required under the statute, as it is a class. *Kingan Packing Ass'n*, 120 O. G. 1165.

The essential feature of a mark is not necessarily what it is stated to be in the application, but what the fac-simile shows it to be. *Kingan & Co., Ltd., ex parte*, 97 O. G. 2085.

The word "Rosebud" and the representation of one, are true alternatives and can be registered under one application for trade-mark of salmon. *Kinney, ex parte*, 72 O. G. 1349.

There can be no assignment of trade-mark recorded in Patent Office unless there is sufficient identification of application and registration. *Laundry Blue Co., in re*, 109 O. G. 806.

“Crescent,” and crescent-shaped figure not true alternatives, and cannot be granted registration under one application. *Lazarus, ex parte*, 64 O. G. 1396.

The office having given a design patent to a party for a certain book cover cannot afterward register the same design as a trade-mark for another party. *Lee & Shepard, ex parte*, 24 O. G. 1271.

Where a new mark is likely to deceive purchasers on account of resemblance to one already registered, it should be rejected as the benefit of the doubt should be in favor of owner of registered mark. *Lefebvre, ex parte*, 96 O. G. 841.

Trade-mark “cascarine,” on medicine, registered 14 July, 1885, on application in good faith by Iler & Morris of 2 June, 1885. Although Leprince had used it prior to that time in Europe, but not in this country, such use did not give him any rights here in anticipation of registrants. *Leprince v. Iler & Morris*, 92 O. G. 189. *But see: Luyties v. Hollander*, 30 Fed. R. 632, 110.

“Fancy Goods” too general in its designation of class of goods to allow registration of trade-mark. *Lisner's Appeal*, 13 O. G. 455.

Specimens of mark should correspond to drawings. *Listman Mill Co., ex parte*, 119 O. G. 340.

Where it is shown that a mark has been abandoned, a new mark which otherwise would have infringed may be allowed registration. *MacDonald, ex parte*, 85 O. G. 150.

The word “Ceroleum” with words “Dirt Proof Floor Dressing” printed across the face of it, involving only expert skill in type-setting, not registrable on a label, not being artistic. *Miller, ex parte*, 96 O. G. 1855.

An alternative trade-mark may be allowed where the word and the picture are true alternatives, and not otherwise. The words “American Beauty” and a picture of a rose which does not clearly appear to belong to that species not true alternatives in application for registration of trade-mark for corsets. *Muir, ex parte*, 87 O. G. 357.

A refusal of examiner to enter judgment of priority is not appealable, as such a decision does not amount to final judgment. *Mulligan v. Tempest Salre Co.*, 119 O. G. 1924.

“Arrangement of two panels, one in red and one in blue, each bearing a shield and other symbolical devices” is not subject of

registration as a label, but might be as a trade-mark. *National United States Stamp Delivery Co.*, 60 O. G. 893.

"Pictorial representation descriptive of the hammock to which the label applies," proper subject of registration for a label. *Palmer, ex parte*, 58 O. G. 383.

When applicant sought to register as trade-mark for shoes the representation of a shoe and the words "The Greatest Value for the Money" the words are not the essential feature of the mark and should not be registered. *Parker Holmes & Co.*, 85 O. G. 287.

"Peerless" refused registration on malt extract, as being descriptive. *Paragon Malt Extract Co., ex parte*, 121 O. G. 690.

An application for alternative trade-mark "Corn" and representation of a kernel of corn, must be accompanied by *fac-simile* of both word and representation. *Peper, ex parte*, 16 O. G. 678.

Refusal to register one mark for "leather" is a final decision and appealable. *Pfister & Vogel Leather Co., ex parte*, 118 O. G. 2250.

Registration allowed a German citizen of a word under provisions of Article XVII of the Convention of December 11, 1871, according mutual privileges to citizens of the two countries. *Portland Cement Co., ex parte*, 64 O. G. 858.

"Iron-stone," on drain pipe arranged in a curved line, descriptive, and not registrable.

"I do not concede the general proposition that geometric figures can always be registered. Simple circles, ellipses, scrolls, borders, and the like, marked in plain outline, are commonly employed in the trade as enclosures for trade or descriptive names and for terms designating quality, place of manufacture, and other information appropriate to particular classes of goods." *Ruder & Co.*, 13 O. G. 596.

A label to be registrable under the act "must not only possess artistic merit, but it must be descriptive of the article for which it is used.

"The alleged label in this case is said by the applicant to be for music-boxes; but the label itself does not indicate this. It is merely an arbitrary ornamental design having the word 'Regina' thereon, and might very appropriately be used as a trade-mark for various articles." *Regina Music Box Co., ex parte*, 100 O. G. 1112.

Registration of a mark is evidence of what a party claimed as a trade-mark, and representation of red anchor in an oval space

is not same as the word "anchor" and symbol of anchor on proprietary medicines. *Richter v. Reynolds*, 59 Fed. R. 577; affirming 52 Fed. R. 445.

Where one assigns all his rights in a new means for treating diseases which he claims to have discovered to a corporation, and thereafter assents to the use of the trade-mark applied to the instrument called "Electropoise," he is held, in a contest between him and the corporation, to have surrendered all his rights. *Sanche v. Electrolibation Co.*, 60 O. G. 1189.

An applicant for registration, relying on commerce with Indian tribes, must specify on oath the tribe or tribes. *Schotten & Co., ex parte*, 60 O. G. 576.

Mandamus will not lie to compel the Commissioner of Patents to register a trade-mark which he considers invalid. *Seymour v. So. Carolina*, 66 O. G. 1167; *Bronson Company v. Duell*, 93 O. G. 1491; *Buffalo Pitts Co. v. Duell*, 93 O. G. 1491.

The applicant is not barred from showing a date of adoption prior to that alleged in statement, and the office can consider it in view of the circumstances of the case. *Sherwood v. Horton Cato & Co.*, 84 O. G. 2018.

No appeal lies from a decision of Examiner of Trade-marks holding that a party is entitled to registration of a trade-mark. *Sibley Soap Co. v. Lambert Pharmacal Co.*, 103 O. G. 2172.

"Pearlicross," allowed registration, but the applicant must not state what changes may be made in the mark without destroying its identity, as it is superfluous and usurps the function of courts. *Small, ex parte*, 101 O. G. 219.

Where party claimed right under registration to mark of a crown as to paints as a class of merchandise, when others had acquired that right as to certain kinds of paints, his claim as a whole was invalid.

"The plaintiffs have not restricted themselves to any particular description of goods comprised in such class. Their registration must stand or fall as a whole, for that to which they declare, in their registration, they intend to appropriate it. There is no provision in regard to trade-marks, such as there has been and is in regard to patents for inventions, that a suit may be maintained where the grant is valid as to a part, but not as to the whole. It follows, therefore, that the registration of this trade-mark, in the form in which it was made, conferred no right on the plaintiffs, in respect to anything purporting to be covered by it." *Smith v. Reynolds*, 10 Blatchf. 100, 108.

But see: Smith v. Reynolds, 13 Blatchf. 458; IV. 4, 95.

A flag of the United States with a diagonal band bearing word "Standard," stars distributed about the flag, the whole enclosed by two concentric circles between which appear words "Standard Fashion Company, New York," not registrable as trade-mark for patterns for garments. The words and circles not being essential features should be stricken out. *Standard Fashion Co., ex parte*, 89 O. G. 189.

"Eclipse," alone as a trade-mark for paints will not be registered where it appears that the word has been actually used in conjunction with a picture of the sun in eclipse, and is only one feature of the mark. *Standard Underground Cable Co., ex parte*, 119 O. G. 1925.

Registration under act of 1881 not invalidated by act of 1905, and is still *prima facie* evidence. An anticipating mark under that act will bar a subsequent applicant under the new law. "Star," for whiskey, anticipated. *Star Distillery Co., ex parte*, 119 O. G. 964.

The descriptive word "Lotion" cannot be registered as part of a trade-mark associated with arbitrary symbols. *Star Lotion Remedy Co., ex parte*, 100 O. G. 2603.

Fac-simile signature of deceased physician and his picture cannot be adopted by a druggist after his death who had only filled his prescriptions, but a partner who had been engaged in business of dispensing medicines with him might be entitled to them. *Stewart v. Einstein v. Sawhill*, 64 O. G. 1533.

Registration of the word symbol "rabbit," or representation of a rabbit allowed under drawing of a head of a rabbit for fabrics. *Taylor & Lockett, ex parte*, 93 O. G. 2531.

Registration refused the word "Velvрил," as it is descriptive of a nitro-cellulose compound protected by a patent, and would become public property at expiration of patent long before the 30 years allowed under registration. *Velvрил Co., ex parte*, 84 O. G. 807.

Where there is erroneous publication of a trade-mark in Official Gazette there should be a republication. *Weil-Haskell Co. v. Griffon Co.*, 119 O. G. 649.

Where owner of trade-mark "Velvet Skin," on laundry soap assents in writing to registration of "Velva," on toilet soap, the office still will refuse registration.

"The right to registration cannot be conferred by a license from the real owner, since the law authorizes registration by

the owner alone. *Willard Chemical Co., ex parte*, 107 O. G. 1972.

3. Interference.

Testimony may be offered at interference proceedings to show an adoption prior to date set out in declaration at time of application.

An amendment will not be allowed pending interference proceedings. *Broderick & Bascom Rope Co. v. Leschen & Sons Rope Co.*, 100 O. G. 3011.

In interference proceedings the *prima facie* case of a registrant without witnesses is overcome by evidence of applicant by several witnesses, that the mark in issue was extensively used long before the date set out in certificate of registration. *Canepa v. Boehm*, 117 O. G. 2089.

A party defeated in interference proceedings in case of a trade-mark, has not the right to be subsequently heard on an allegation that same mark has been used by a third party. Patent law in reference to two years' prior use not applicable, as prior use by public may not give right of trade-mark to public, and as any individual injured may interfere. *Dietz, in re*, 104 O. G. 852.

A party is bound in an interference proceeding by the statement in a trade-mark application as to date of adoption and use, and cannot prove adoption and use prior to that date. *Empire Cycle Co. v. Monarch Cycle Mfg. Co. v. Meacham Arms Co.*, 82 O. G. 1689.

Rights under a registered trade-mark may be assigned and an assignee notified according to rule 103 in patent applications may, on proper request, come in and take charge in interference proceedings. It is not necessary for the assignee to re-register mark in his own name. Same practice should be followed in assignments as in patent cases. (Earlier cases overruled.) *Frank v. Macwilliam*, 114 O. G. 542.

No preliminary statements are required in trade-mark interferences, as statements in application for trade-marks are sufficient.

While a party in interference proceedings can prove an earlier date than that set out in the application, such proof must be clear and convincing. *Gem Cutlery Co. v. Leach*, 114 O. G. 2089.

Burden of proof in interference proceeding is on applicant as

against registrant in trade-mark cases. An applicant must establish his own title, and not seek to merely impeach title of registrant. *Giles Remedy Co. v. Giles*, 117 O. G. 2634.

In interference proceedings the subsequent applicant has the burden of proof as against a prior registrant. If he cannot show priority of use, he must show abandonment, and that is not met by cessation of business for a few months due to strikes and there is intention to resume. *Goldsmith v. United Shirt Vest Co.*, 119 O. G. 1261.

There can be no interference proceeding between trade-marks both of which arose under Act of 1881. The applications should be amended under Sect. 24 of Act of 1905 so as to bring them within the scope of the latter act. *Graham v. Norddeutsche Wollkammereind Kammgarnspinnerei*, 116 O. G. 1735.

Newly discovered evidence as ground for remanding a case in an interference for taking testimony largely a matter of discretion. *Igleheart Bros. v. Houston, Meeks & Co.*, 86 O. G. 631; *Igleheart Bros. v. Land*, 86 O. G. 632.

A refusal of a witness to answer certain material questions in an interference proceeding will be considered and given its due weight at final hearing. *Independent Baking Powder Co. v. Fidelity Mnf. Co.*, 94 O. G. 222.

Where it appears in interference proceedings that two persons are entitled to use of a mark as a trade-mark, registration will be granted to neither. *Langdon & Batcheller, ex parte*, 61 O. G. 286.

In an interference between the applicant and registrant of a trade-mark, the burden of proof is on applicant to overcome *prima facie* evidence of ownership. *Manitowac Mnf. Co. v. Dickerman*, 57 O. G. 1721.

Notice of opposition to registration of trade-mark must be signed and sworn to by the party injured, not by the attorney, and the signature and oath of attorney cannot be subsequently ratified after the thirty days. *Martin v. Martin & Bowne Co.*, 119 O. G. 962.

Motions for dissolution of interferences should be heard by the Examiner of Trade-marks. *Robert Smith Ale Brewing Co. v. Beadleston*, 119 O. G. 341.

A party to a trade-mark interference is not restricted to the date of adoption and use set up in the application, but he may introduce testimony to show a date of adoption and use prior thereto. *Sibley Soap Co. v. Lambert Pharmacal Co.*, 103 O. G. 2172.

Proceedings on interference under act of 1881 should be finally decided under act of 1905 passed during their pendency. *Silver Lake Co. v. Samson Cordage Works*, 116 O. G. 2010.

Priority of use, not necessarily ownership, entitles a party to registration in question of interference. The question of right by ownership may afterwards be settled by *ex parte* proceedings. *Sroufe & Co. v. Crown Distilleries Co.*, 97 O. G. 1836.

Date of adoption and use of trade-mark alleged in interfering applications for the registration of a trade-mark is not conclusive; it is to be determined according to the facts and not according to what applicant considers to be the fact. "Adoption and use" of a trade-mark necessarily depend upon the extent to which merchandise with the said trade-mark affixed thereon has been actually sold. (See *Schneider v. Williams*, C. D. 1888, 606; *Proctor & Gamble v. Columbia Mnfy. Co.*, 44 Ms. Dec. 300.) *Stewart v. Einstein v. Sawhill*, 61 O. G. 287.

No appeal lies from Examiner who dissolves an interference on the ground that respective parties have no right to make the claims. *Story v. Criswell*, 100 O. G. 683.

Rule 13 stating "each applicant and registrant will be held to the date of adoption alleged in the statement filed with his application" is not inconsistent with law and has force of a statute. *Stuart Medicine Co. v. Goldaine*, 64 O. G. 1005.

Payment of fee necessary in filing notice of opposition. Where fee is paid after thirty days after publication it is too late and the Commissioner has no authority to extend the time. *Wagner & Sons v. Thixton Millet & Co.*, 121 O. G. 690.

Publication of a mark should precede interference proceedings. *Walter Baker & Co. Ltd. v. Hawley*, 119 O. G. 653.

No appeal lies on action of Examiner in overruling exceptions to respondent's answer on interference proceedings in trade-marks. *Whittingham v. Automatic Switch Co.*, 120 O. G. 659.

The Office cannot entertain notice of opposition 30 days after publication of mark. *Winand v. P. J. Drury Co.*, 120 O. G. 2126.

An interference proceeding will not be dissolved where parties agree, if the Office considers that the marks are substantially the same. *Wright v. Blumenthal v. Mayer v. Cushman*, 119 O. G. 2234.

ADDENDA.

A diamond-shaped pattern formed by intersecting diagonal lines on horse shoes held not a trade-mark where not shown to be adopted for the purpose of indicating origin, and not to have come to indicate it by association. Evidence that the nails were never called "Check Mark Nails," that packages were marked with complainant's real trade-mark, name, and address, and that complainant's witness testified that the mark was adopted for betterment of appearance as well as to show origin, all material. Protection refused. *Capewell Horse Nail Co. v. Putnam Nail Co.*, 140 Fed. R. 670.

"In Curve" corsets. *Kops Brothers, ex parte*, 121 O. G. 1675.

"Auburn-Lynn," although composed of name of city "Auburn," and of manufacturer "Lynn," is nevertheless good trade-mark, and Lynn has no right to form another corporation with that name. *W. R. Lynn Shoe Co. v. Auburn-Lynn Shoe Co.*, 62 Atl. R. 499.

An interference will be dissolved on proof that the mark in issue was registered by a third party over 30 years ago, in 1871, under the unconstitutional act of 1870, and the remedy would be to show by affidavits that the registrant is not still owner. *Schneider v. Union Distilling Co.*, 121 O. G. 1676.

Where it is apparent that an interference exists, it will not be dissolved even by agreement of parties. *Windsor Milling & Elevator Co. v. Brunner*, 121 O. G. 1676.

APPENDIX

TRADE-MARK LAW OF THE UNITED STATES.

AN ACT To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a description of the trade-mark itself, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. With this statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark, as actually used, as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents.

SEC. 2. That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application to be the owner of the

trade-mark sought to be registered, and that no other person, firm, corporation, or association, to the best of the applicant's knowledge and belief, has the right to such use, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered. If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trade-mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application therefor, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof. The verification required by this section may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States.

SEC. 3. That every applicant for registration of a trade-mark, or for renewal of registration of a trade-mark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, as hereinafter provided for, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trade-mark of which such applicant may claim to be the owner, brought under the provisions of this Act or under other laws of the United States, may be served, with the same force and effect as if served upon the applicant or registrant in person. For the purposes of this Act it shall be deemed sufficient to serve such notice upon such applicant, registrant, or representative by leaving a copy of such process or notice addressed to him at the last address of which the Commissioner of Patents has been notified.

SEC. 4. That an application for registration of a trade-mark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States an application for registration of the same trade-mark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trade-mark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country: *And provided*, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

SEC. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark —

- (a) Consists of or comprises immoral or scandalous matter;
- (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words, or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent

the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act.

SEC. 6. That on the filing of an application for registration of a trade-mark which complies with the requirements of this Act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this Act, the Commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this Act. If no notice of opposition is filed within said time the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for. If on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor.

SEC. 7. That in all cases where notice of opposition has been filed the Commissioner of Patents shall notify the applicant thereof and the grounds therefor.

Whenever application is made for the registration of a trade-mark which is substantially identical with a trade-mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another has previously made application, or which so nearly resembles such trade-mark, or a known trade-mark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trade-mark, and in every case of interference or opposition to registration he shall direct the examiner in charge of interferences to determine the question of the right of registration to such trade-mark, and of the sufficiency of objections to registration, in such manner

and upon such notice to those interested as the Commissioner may by rules prescribe.

The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trade-mark, for the person first to adopt and use the mark, if otherwise entitled to register the same, unless an appeal is taken, as hereinafter provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the Commissioner may prescribe.

SEC. 8. That every applicant for the registration of a trade-mark, or for the renewal of the registration of a trade-mark, which application is refused, or a party to an interference against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trade-mark, may appeal from the decision of the examiner in charge of trade-marks, or the examiner in charge of interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

SEC. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

SEC. 10. That every registered trade-mark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The Commissioner shall keep a record of such assignments.

SEC. 11. That certificates of registration of trade-marks shall be issued in the name of the United States of America, under

the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose. The certificate shall state the date on which the application for registration was received in the Patent Office. Certificates of registration of trade-marks may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

Written or printed copies of any records, books, papers, or drawings relating to trade-marks belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof.

SEC. 12. That a certificate of registration shall remain in force for twenty years, except that in the case of trade-marks previously registered in a foreign country such certificates shall cease to be in force on the day on which the trade-mark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed. Certificates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this Act, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this Act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of this Act, and when so renewed shall have the same force and effect as certificates issued under this Act.

SEC. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration

thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of examiner of interferences.

SEC. 14. That the following shall be the rates for trade-mark fees:

On filing each original application for registration of a trade-mark, ten dollars: *Provided*, That an application for registration of a trade-mark pending at the date of the passage of this Act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this Act without the payment of further fee.

On filing each application for renewal of the registration of a trade-mark, ten dollars.

On filing notice of opposition to the registration of a trade-mark, ten dollars.

On an appeal from the examiner in charge of trade-marks to the Commissioner of Patents, fifteen dollars.

On an appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade-mark or canceling the registration of a trade-mark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents and for recording assignments and other papers relating to patents.

SEC. 15. That sections forty-nine hundred and thirty-five and forty-nine hundred and thirty-six of the Revised Statutes, relating to the payment of patent fees and to the repayment of fees paid by mistake, are hereby made applicable to trade-mark fees.

SEC. 16. That the registration of a trade-mark under the provisions of this Act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise

of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SEC. 17. That the circuit and territorial courts of the United States and the supreme court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the court of appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this Act, arising under the present Act, without regard to the amount in controversy.

SEC. 18. That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for patent cases by the Act creating the circuit court of appeals.

SEC. 19. That the several courts vested with jurisdiction of cases arising under the present Act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this Act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this Act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

SEC. 20. That in any case involving the right to a trade-mark registered in accordance with the provisions of this Act, in which the verdict has been found for the plaintiff, or an injunction

issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trade-mark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. . Any injunction that may be granted upon hearing, after notice to the defendant, to prevent the violation of any right of the owner of a trade-mark registered in accordance with the provisions of this Act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other circuit court, or judge thereof, in the United States, or by the supreme court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the circuit court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

SEC. 21. That no action or suit shall be maintained under the provisions of this Act in any case when the trade-mark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

SEC. 22. That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

SEC. 23. That nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party

aggrieved by any wrongful use of any trade-mark might have had if the provisions of this Act had not been passed.

SEC. 24. That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this Act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this Act.

SEC. 25. That any person who shall procure registration of a trade-mark, or entry thereof, in the office of the Commissioner of Patents by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered by an action on the case.

SEC. 26. That the Commissioner of Patents is authorized to make rules and regulations, not inconsistent with law, for the conduct of proceedings in reference to the registration of trade-marks provided for by this Act.

SEC. 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the

Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

SEC. 28. That it shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

SEC. 29. That in construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the District of Columbia, the Territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States. The terms "person" and "owner," and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act, include a firm, corporation, or association as well as a natural person. The term "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant. The term "trade-mark" includes any mark which is entitled to registration under the terms of this Act and whether registered or not, and a trade-mark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution.

SEC. 30. That this Act shall be in force and take effect April first, nineteen hundred and five. All Acts and parts of Acts inconsistent with this Act are hereby repealed except so far as the same may apply to certificates of registration issued under

the Act of Congress approved March third, eighteen hundred and eighty-one, entitled "An Act to authorize the registration of trade-marks and protect the same," or under the Act approved August fifth, eighteen hundred and eighty-two, entitled "An Act relating to the registration of trade-marks."

Approved, February 20, 1905.

AN ACT TO AMEND THE LAWS OF THE UNITED STATES RELATING TO THE REGISTRATION OF TRADE-MARKS

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section one of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States, or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five, be, and is hereby, amended by inserting after the words "description of the trade-mark itself," the words "only when needed to express colors not shown in the drawing," so that the section, as amended, shall read as follows:

"That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States or resides in or is located in any foreign country which, by treaty, convention, or law affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a description of the trade-mark itself, only when needed to express colors not shown in the drawing, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. With this statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark as actually used as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents."

SEC. 2. That the Commissioner of Patents shall establish classes of merchandise for the purpose of trade-mark registration, and shall determine the particular descriptions of goods comprised in each class. On a single application for registration of a trade-mark the trade-mark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated.

SEC. 3. That any owner of a trade-mark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trade-marks used on the products of such establishment are concerned, the same rights and privileges that are accorded to owners of trade-marks domiciled within the territory of the United States by the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five.

SEC. 4. That this Act shall take effect July first, nineteen hundred and six.

Approved, May 4, 1906.

**RULES GOVERNING THE REGISTRATION OF
TRADE-MARKS UNDER THE ACT APPROVED
FEBRUARY 20, 1905, TO TAKE EFFECT
APRIL 1, 1905.**

**UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., April 1, 1905.**

The following rules, designed to be in strict accordance with the provisions of the act approved February 20, 1905, for the registration of trade-marks, are published for gratuitous distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance of the forms on pages [371-376].

FREDERICK I. ALLEN,
Commissioner of Patents.

CORRESPONDENCE.

1. All business with the Office should be transacted in writing. Unless by the consent of all parties, the action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the Office with decorum and courtesy. Papers presented in violation of this requirement will be returned; but all such papers will first be submitted to the Commissioner, and only be returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by money order, check, or draft should be to his order.

4. A separate letter should, in every case, be written in relation to each distinct subject of inquiry or application. Complaints against the examiner in charge of trade-marks, assignments for record, fees, and orders for copies or abstracts must be sent to the Office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant, the serial number of the application, and the date of filing. Letters relating to registered trade-marks should refer to the name of the registrant, the number and date of the certificate, and the merchandise to which the trade-mark is applied.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, can not generally be allowed.

9. The Office can not undertake to respond to inquiries propounded with a view to ascertain whether certain trade-marks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The Office can not aid in the selection of any attorney.

A register of attorneys is kept in this Office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office. The names of persons in the following classes will, upon their written request, be entered on this register:

(a) Any person who, on June 18, 1897, was engaged as attorney or agent in the active prosecution of applications for patent before this Office, or had been so engaged at any time within five years prior thereto and is not disbarred, or is or was during such period a member of a firm so engaged and not disbarred, provided that such person shall, if required, furnish information as to one or more applications for patents so prosecuted by him.

(b) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(c) Any person who has been regularly recognized as an attorney or agent to represent claimants before the Department of the Interior, or any bureau thereof, and is in good standing, provided that such person shall furnish a statement of the date of his admission to practice as such attorney or agent, and shall further show, if required by the Commissioner, that he is possessed of the necessary qualifications to render applicants valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(d) Any person not an attorney at law who shall file a certificate from a judge of a United States, State, or Territorial court, duly

authenticated under the seal of the court, that such person is of good moral character and of good repute and possessed of the necessary qualifications to enable him to render applicants valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(e) Any firm which, on June 18, 1897, was engaged in the active prosecution, as attorneys or agents, of applications for patents before the Patent Office, or had been so engaged at any time within five years prior thereto, provided such firm or any member thereof is not disbarred, provided the names of the individuals composing the firm are stated, and provided also, that such firm shall, if required, furnish information as to one or more applications prosecuted before the Patent Office by them.

(f) Any firm, not entitled to registration under the preceding sections, which shall show that the individuals composing the firm are each and all recognized as patent attorneys or agents, or are each and all entitled to be so recognized under the preceding sections of this rule.

The Commissioner may demand additional proof of qualifications, and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.

Any person or firm, not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally, may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent any certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.

No person, not registered as above provided, will be permitted to prosecute, as attorney, applications before the Patent Office.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. General powers given by a principal to an associate can not be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association may be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and, when so revoked, the Office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct, the Commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

WHO MAY REGISTER A TRADE-MARK.

16. A trade-mark may be registered by any person, firm, corporation, or association domiciled within the territory of the United States or residing in or located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, and who is entitled to the use of any trade-mark and uses the same in commerce with foreign nations, or among the several States, or with Indian tribes, upon payment of the fee required by law and other due proceedings had. (See Rules 17 and 19.)

Act of Feb. 20,
1905, sec. 1.

17. No trade-mark will be registered to an applicant residing or located in a foreign country unless such country by treaty, convention, or law, affords similar privileges to the citizens of the United States, nor unless the trade-mark has been registered by the applicant in the foreign country in which he resides or is located. In such cases it is not necessary that the trade-mark shall have been used in commerce with the United States or among the States thereof. (See Rule 31.)

Act of Feb. 20,
1905, secs. 1, 2,
and 4.

WHAT MAY BE REGISTERED AS A TRADE-MARK.

18. No trade-mark will be registered to an owner domiciled within the territory of the United States unless it shall be made to appear that the same is used as such by said owner in commerce among the several States, or between the United States and some foreign nation or Indian tribe: no trade-mark will be registered to an owner residing in or located in a foreign country unless said country by treaty, convention, or law affords similar privileges to the citizens of the United States: no trade-mark will be registered which consists of or comprises immoral or scandalous matter, or which consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation, or which is identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resembles a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; or which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are

Act of Feb. 20,
1905, secs. 1,
5, and 21.

descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term: no portrait of a living individual will be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: and no trade-mark will be registered which is used in unlawful business, or upon any article injurious in itself, or which has been used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

19. Any mark used in commerce with foreign nations or among the several States or with Indian tribes may be registered if it has been in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of the act of February 20, 1905. (See Rule 30.)

Act of Feb. 20,
1905, sec. 5.

THE APPLICATION.

20. An application for the registration of a trade-mark must be made to the Commissioner of Patents and must be signed by the applicant.

Act of Feb. 20,
1905, sec. 1.

21. A complete application comprises:

(a) A petition, requesting registration, signed by the applicant. (See Form 1, p. 31.)

Act of Feb. 20,
1905, sec. 1.

(b) A statement specifying the name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class, to which the trade-mark is appropriated; a description of the trade-mark itself, and a statement of the mode in which the same is applied and affixed to the goods, and of the length of time during which the trade-mark has been used, and, if the applicant be a corporation or association, it must be set forth under the laws of what State or nation organized. (See sec. 29 of the statute, and Forms 2, 4, and 6, pp. 31, 32, and 33.)

(c) A declaration, complying with section 2 of the statute. (See Forms 3, 5, 7, 8, and 9, pp. 31, 32, 33, and 34.)

(d) A drawing of the trade-mark, which shall be a facsimile of the same as actually used upon the goods. (See Rules 34 and 35 and Form between pages 32 and 33.)

(e) Five specimens (or facsimiles, when, from the mode of applying or affixing the trade-mark to the goods, specimens can not be furnished) of the trade-mark as actually used upon the goods.

(f) A fee of ten dollars.

22. The petition, the statement, and the declaration must be in the English language and written on one side of the paper only.

23. The name of the applicant will appear in the certificate of registration precisely as it is signed to the statement of the application, and, therefore, the signature to the statement must be the correct signature of the applicant, and the name of the applicant wherever it appears in

the papers of the application must agree with the name as signed to the statement.

24. No information will be given without authority of the applicant respecting the filing of an application for the registration of a trade-mark by any person, or the subject-matter thereof, unless it shall, in the opinion of the Commissioner, be necessary to the proper conduct of business before the Office.

25. All applications for registration pending in the Patent Office at the time of the passage of the act of February 20, 1905, may be amended with a view to bringing them and the certificates issued under such applications under the provisions of said act, and the prosecution of such applications may be proceeded with under its provisions without the payment of further fee. When such an application is amended to bring it under the act of February 20, 1905, it will be given a serial number and date of filing under said act.

Act of Feb. 20,
1905, secs. 14
and 24.

A trade-mark registered under the act of March 3, 1881, may be registered under the act of February 20, 1905, but the application for such registration will be subject to examination in the same manner as other applications filed under said act of February 20, 1905.

26. An application for registration of a trade-mark, filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law affords similar privileges to the citizens of the United States an application for registration of the same trade-mark, shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trade-mark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country.

Act of Feb. 20,
1905, sec. 4.

27. Every applicant for registration of a trade-mark, or for renewal of registration of a trade-mark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trade-mark of which such applicant may claim to be the owner may be served. This notice shall be indorsed upon the file wrapper of the application.

Act of Feb. 20,
1905, sec. 3.

28. In proceedings relating to an application or a registration under the act of February 20, 1905, it shall be deemed sufficient to serve notice upon the applicant, registrant, or representative by leaving a copy of the process or notice of proceedings addressed to him at the last address of which the Commissioner of Patents has been notified.

Act of Feb. 20,
1905, sec. 3.

DECLARATION.

29. The application must be accompanied by a written declaration verified by the applicant, or by a member of the firm, or by an officer of the corporation or association applying, to the effect that he believes himself, or the firm, corporation, or association in whose behalf he makes the declaration, to be the owner of the trade-mark sought to be registered, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use the trade-mark, either in the identical form or any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description, drawing, and specimens (*or facsimiles*) truly represent the trade-mark sought to be registered. (See Rule 17 and Forms 3, 5, 7, 8, and 9, pp. 31, 32, 33, and 34.)

30. Where application is made under section 5 of the act of February 20, 1905, on the ground that the mark has been in actual and exclusive use as a trade-mark by the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of said act, the applicant shall, in addition to the requirements of section 2 of said act, make oath to facts showing such actual use for the period specified, and that, to the best of his knowledge and belief, such use has been exclusive for the period specified, and that the mark is now and has been continuously used by the applicant, or his predecessors, or by those from whom title to the same is derived, as a trade-mark. (See Form 8, page 33.)

31. If the applicant resides or is located in a foreign country, the declaration required shall also set forth that the trade-mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration or of the application therefor, as the case may be. In such cases, it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof. (See Form 9, page 34.)

32. The declaration may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States. the declaration being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the same is made.

33. Amendment of the declaration will not be permitted. If that filed with the application be faulty or defective, a substitute declaration must be filed.

DRAWING.

34. (1) The drawing must be made upon pure white paper of a thickness corresponding to two-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges, a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin, all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than $1\frac{1}{4}$ inches is to be left blank for the heading of title, name, number, and date. (See specimen of drawing between pages 32 and 33.)

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

(4) The name of the proprietor of the trade-mark, signed by himself or his attorney of record, must be placed at the lower right-hand corner of the sheet within the marginal line, but in no instance should it encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side, and the heading should be placed at the right and the signature at the left, occupying the same space and position as in an upright view, and being horizontal when the sheet is held in an upright position.

(6) Drawings should be rolled for transmission to the Office — not folded.

An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

35. The Office, at the request of applicants, will furnish the drawings at cost.

EXAMINATION OF APPLICATIONS.

36. All complete applications for registration are considered, in the first instance, by the examiner in charge of trade-marks. Whenever, on examination of an application, registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such refusal will be stated, and such infor-

Act of Feb. 20,
1905, sec. 6.

mation and references will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

37. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

38. If, on examination of an application for the registration of a trade-mark, it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of the law, the mark will be published in the Official Gazette at least once. Such publication shall be at least thirty days prior to the date of registration.

Act of Feb. 20,
1905, sec. 6.

If no notice of opposition be filed within thirty days after such publication, the applicant or his attorney will be duly notified of the allowance of his application, and a certificate of registration will be issued as provided in Rule 52.

The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

AMENDMENTS.

39. The statement may be amended to correct informalities, or to avoid objections made by the Office, or for other reasons arising in the course of examination, but no amendments to the description or drawing of the trade-mark will be permitted unless warranted by something in the specimens (*or facsimiles*) as originally filed.

40. In every amendment, the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant or attorney.

41. When an amendatory clause is amended, it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be rewritten.

42. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the Commissioner.

Amendments may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the Commissioner, without withdrawing the case from issue.

43. After the completion of the application, the Office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the Office will furnish them on the usual terms.

INTERFERENCE, OPPOSITION, AND CANCELLATION.

44. In case of conflicting applications for registration of a trade-mark, or in any dispute as to the right to use the same, which may arise between an applicant and a registrant, the Office will declare an interference, in order that the parties may have an opportunity to prove priority of use, and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences between applications for patents.

Act of Feb. 20,
1905, sec. 7.

45. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing, in duplicate, a written notice of opposition (see Form 10, page 34), stating the grounds therefor, within thirty days after the publication (see Rule 38) of the mark sought to be registered, which notice of opposition shall be accompanied by the fee required by law, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. (See Rule 32.)

Act of Feb. 20,
1905, sec. 6
and 14.

46. Any person deeming himself to be injured by the registration of a trade-mark in the Patent Office, may at any time make application (see Form 11, page 35) to the Commissioner to cancel the registration thereof. Such application shall be filed in duplicate, shall state the grounds for cancellation, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. (See Rule 32.)

Act of Feb. 20,
1905, sec. 13.

47. If it appear, after a hearing before the examiner of interferences, that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner in charge of interferences shall so decide, the Commissioner shall cancel the registration of the mark, unless appeal be taken within the limit fixed.

Act of Feb. 20,
1905, sec. 13.

48. In cases of opposition and of applications for cancellation, the examiner in charge of trade-marks shall forward the files and papers to the examiner in charge of interferences, who shall give notice thereof to the applicant or registrant. The applicant or registrant must make answer at such time, not less than thirty days from the date of the notice, as shall be fixed by the examiner in charge of interferences.

49. The proceedings on oppositions and on applications for cancellation shall follow, as nearly as practicable, the practice in interferences between applications for patents.

APPEALS.

50. From an adverse decision of the examiner in charge of trade-marks upon an applicant's right to register a trade-mark, or to renew the

registration of a trade-mark, or from a decision of the examiner in charge of interferences, an appeal may be taken to the Commissioner in person, upon payment of the fee required by law.

Act of Feb. 20,
1905, sec. 8
and 14.

51. From the adverse decision of the Commissioner of Patents upon the right of an applicant to register a trade-mark, or to renew the registration of a trade-mark, or from the decision of the Commissioner in cases of interference, opposition, or cancellation, an appeal may be taken to the court of appeals of the District of Columbia in the manner prescribed by the rules of that court.

Act of Feb. 20,
1905, sec. 9.

ISSUE, DATE, AND DURATION OF CERTIFICATES.

52. When the requirements of the law and the rules have been complied with, and the Office has adjudged a trade-mark registrable, a certificate will be issued, signed by the Commissioner, under the seal of the Patent Office, to the effect that the applicant has complied with the law and that he is entitled to registration of his trade-mark. The certificate shall state the date on which the application for registration was received in the Patent Office. Attached to the certificate will be a photolithographed copy of the drawing of the trade-mark and a printed copy of the statement and the declaration.

Act of Feb. 20,
1905, sec. 11.

53. A certificate of registration shall remain in force twenty years from its date, except that, in case a trade-mark be previously registered in a foreign country, such certificate shall cease to be in force on the day on which the trade-mark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed.

Act of Feb. 20,
1905, sec. 12.

54. A certificate of registration may be, from time to time, renewed for like periods on payment of the renewal fees required, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificate of registration was issued or renewed.

Act of Feb. 20,
1905, sec. 12
and 14.

55. Certificates of registration in force on the 1st day of April, 1905, shall remain in force for the period for which they were issued, and shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of the act of February 20, 1905, and, when so renewed, shall have the same force and effect as certificates issued thereunder.

Act of Feb. 20,
1905, sec. 12.

56. A certificate of registration shall not be issued to an applicant located in a foreign country for any trade-mark for registration of which he has filed an application in such foreign country, until such mark has been actually registered by him in the country in which he is located.

Act of Feb. 20,
1905, sec. 4.

ASSIGNMENTS.

57. Every registered trade-mark and every mark for the registration of which application has been made, together with the application for registration thereof, shall be assignable in connection with the good-will of the business in which the mark is used.

Act of Feb. 20,
1905, sec. 10.

Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed. Provision is made for recording such assignments in the Patent Office; but no such assignment will be recorded unless it is in the English language, nor unless an application for the registration of the mark shall have been first filed in the Patent Office, and such assignment must identify the application by serial number and date of filing, or, when the mark has been registered, by the certificate number and the date thereof. No particular form of assignment is prescribed.

58. An assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it be recorded in the Patent Office within three months from the date thereof.

Act of Feb. 20,
1905, sec. 10.

59. The certificate of registration may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

Act of Feb. 20,
1905, sec. 11.

COPIES AND PUBLICATIONS.

60. After a trade-mark has been registered, printed copies of the statement and declaration in each case, with a photolithographed copy of the drawing of the trade-mark, may be furnished by the Office upon the payment of the fee. (See Rule 63.)

Act of Feb. 20,
1905, secs. 11
and 14.

61. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the applicant; otherwise an extra charge will be made for the time consumed in making a search for such assignment.

62. The Official Gazette of the Patent Office will contain a list of all trade-marks registered, with the name and address of the registrant in each case, an illustration of the trade-mark, a description of the trade-mark itself, and a recitation of the particular description of goods to which it is applied.

FEES.

63. On filing each original application for the registration of a trade-mark \$10.00
On filing each application for renewal of the registration of a trade-mark 10.00

Rev. Stat. 4893;
act of Feb. 20,
1905, sec. 14.

On filing notice of opposition to the registration of a trade-mark	\$10.00
On appeal from the examiner in charge of trade-marks to the Commissioner of Patents	15.00
On appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade-mark or canceling the registration of a trade-mark, to the Commissioner of Patents . .	15.00
For manuscript copies, for every 100 words or fraction thereof .	.10
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less	1.00
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words .	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words	3.00
For abstracts of title:	
For the certificate of search	1.00
For each brief from the digest of assignments20
For searching titles or records, one hour or less50
Each additional hour or fraction thereof50
For a single printed copy of statement, declaration, and drawing	.05
If certified, for the grant, additional50
For the certificate25

64. Money required for Office fees may be paid to the Commissioner of Patents, or to the Treasurer, or to any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, and such officer shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders, drafts, and checks should be made payable to the "Commissioner of Patents."

65. All money sent by mail, to the Patent Office, will be at the risk of the sender. All payments to the Office must be made in specie, Treasury notes, national-bank notes, certificates of deposit, money orders, or certified checks.

REPAYMENT OF MONEY.

66. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the Office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, or to withdraw an appeal, will not entitle a party to demand such a return.

NOTICE OF REGISTRATION.

67. It shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or "Reg. U. S. Pat. Off.," or, when from the character and size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; otherwise, on a suit for infringement, no damages shall be recovered except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

Act of Feb. 20,
1905, sec. 28.

AMENDMENTS OF THE RULES.

68. All amendments of the foregoing rules will be published in the Official Gazette.

QUESTIONS NOT SPECIFICALLY PROVIDED FOR.

69. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

FREDERICK I. ALLEN,
Commissioner of Patents.

DEPARTMENT OF THE INTERIOR.

Approved, to take effect April 1, 1905.

E. A. HITCHCOCK,
Secretary.

FORMS.

The following forms illustrate the manner of preparing papers for applications for registration of trade-marks. Applicants will find their business facilitated by following them closely:

(1) PETITION.

To the Commissioner of Patents:

The undersigned presents herewith a drawing and five specimens (or facsimiles) of his trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

(Signature)

Dated , 19 .

(2) STATEMENT FOR AN INDIVIDUAL.

To all whom it may concern:

Be it known that I, , a citizen (or subject, as the case may be) of the , residing at , , and doing business at No. , street, in said city, have adopted for my use a trade-mark of which the following is a description:

My trade-mark consists of .

The trade-mark has been continuously used in my business since .

The class of merchandise to which the trade-mark is appropriated is , and the particular description of goods comprised in said class upon which I use said trade-mark is .

The trade-mark is usually displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown [or state other modes of application].

(Signature)

(3) DECLARATION FOR AN INDIVIDUAL.

STATE OF , COUNTY OF , ss:

 , being duly sworn, deposes and says, that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has

the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by him in commerce among the several States of the United States and particularly between [*here name the States*] and (*or*) between the United States and foreign nations or Indian tribes, and particularly with [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; and that the description, drawing, and specimens (*or facsimiles*) presented truly represent the trade-mark sought to be registered.

(Signature)

Subscribed and sworn to before me, a _____, this _____ day
of _____, 19 _____.

[L. S.]

(Signature)

[*Official character.*]

(4) STATEMENT FOR A FIRM.

To all whom it may concern :

Be it known that we, _____, a firm domiciled in _____, county of _____, State of _____, and doing business at No. _____, street, in said city, and composed of the following members, _____, _____, citizens of (*or subjects, as the case may be*), have adopted for our use a trade-mark, of which the following is a description:

Our trade-mark consists of _____.

The trade-mark has been continuously used in our business since _____.

The class of merchandise to which the trade-mark is appropriated is _____, and the particular description of goods comprised in said class upon which said trade-mark is used is _____.

The trade-mark is usually displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown [*or state other modes of application*].

(Signature)

By _____,

A member of the firm.

(5) DECLARATION FOR A FIRM.

STATE OF _____, COUNTY OF _____, ss :

_____, being duly sworn, deposes and says, that he is a member of the firm, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said firm is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said firm

in commerce among the several States of the United States and particularly between [*here name the States*] and (or) between the United States and foreign nations or Indian tribes, and particularly with [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; and that the description, drawing, and specimens (or facsimiles) presented truly represent the trade-mark sought to be registered.

(Signature)

Subscribed and sworn to before me, a _____, this _____ day
of _____, 19 ____ .

[L. s.] (Signature) _____
[Official character.]

(6) STATEMENT FOR A CORPORATION OR ASSOCIATION.

To all whom it may concern :

Be it known that _____, a corporation (or association) duly organized under the laws of the State of _____ (or country), and located in the city of _____, county of _____, in said State (or country), and doing business at No. _____, street, in said city of _____, has adopted for its use a trade-mark of which the following is a description :

The trade-mark consists of _____

The trade-mark has been continuously used in our business since _____

The class of merchandise to which the trade-mark is appropriated is _____, and the particular description of goods comprised in said class upon which said trade-mark is used is _____

The trade-mark is usually displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown [*or state other modes of application*].

(Signature) _____,

By _____,
Secretary (or other officer).

(7) DECLARATION FOR A CORPORATION OR ASSOCIATION.

STATE OF _____, COUNTY OF _____, ss :

_____, being duly sworn, deposes and says that he is the secretary (or other officer) of the corporation (or association), the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation (or association) is the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trade-mark is used by said corporation (or association) in com-

merce among the several States of the United States, and particularly between [*here name the States*] and (*or*) between the United States and foreign nations or Indian tribes, and particularly with [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; and that the description, drawing, and specimens (*or facsimiles*) presented truly represent the trade-mark sought to be registered.

(Signature)

Subscribed and sworn to before me, a _____, this _____ day
of _____, 19 _____.

[L. S.]

(Signature)

(Official character.)

(8) DECLARATION FOR APPLICANTS UNDER THE TEN-YEAR SECTION.

STATE OF _____, COUNTY OF _____, ss:

_____, being duly sworn, deposes and says, that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said mark is used by him in commerce among the several States of the United States, and particularly between [*here name the States*] and (*or*) between the United States and foreign nations or Indian tribes, and particularly with [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; that the description, drawing, and specimens (*or facsimiles*) presented truly represent the mark sought to be registered; and that the mark has been in actual use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of the act of February 20, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.^a

(Signature)

Subscribed and sworn to before me, a _____, this _____ day
of _____, 19 _____.

[L. S.]

(Signature)

(Official character.)

(9) DECLARATION FOR FOREIGNERS.

STATE OF _____, COUNTY OF _____, ss:

_____, being duly sworn, deposes and says, that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trade-mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right

STATE OF _____, COUNTY OF _____, ss:

On this _____ day of _____, 19____, before me, a _____, in and for _____, personally appeared _____, the above-named party, who, being duly sworn, deposes and says that, to the best of his knowledge and belief, the facts above stated are true.

[L. s.]

(Signature)

,
(Official character.)

a In case the applicant is a firm, corporation, or association, the declaration should be modified accordingly.

CLASSIFICATION OF REGISTERED TRADE-MARKS.

<p>Agricultural Machines and Imple- ments. Baking Powder and Yeast. Beltings, Hose, and Packings. Beverages. Blackings and Leather Dressings. Boots, Shoes, and Lasts. Brooms and Brushes. Buttons. Canned Goods. Carpets, etc. Cement, Plaster, and Bricks. Cleaning and Polishing Preparations. Coffee and Tea. Conductors and Insulators. Confectionery. Corsets. Cured Meats. Dairy Machines and Products. Dentistry. Drugs and Chemicals. Dry Goods. Electrical Apparatus and Supplies. Fancy Goods. Fertilizers. Firearms, Ammunition, and Ex- plosives. Fire Extinguishers. Flour. Foods and Relishes. Fuel. Furniture. Games and Toys. Glassware. Gloves. Headware. Household Articles. Inks.</p>	<p>Jewelry and Plated Ware. Lamps, Lanterns, etc. Lard and Tallow. Laundry Machines and Articles. Leather and Saddlery. Locks and Hardware. Lumber and Manufactures. Machines and Devices. Malt Liquors. Matches. Medical Compounds. Metals and Manufactures. Miscellaneous. Musical Instruments. Needles and Pins. Oils and Lubricants. Optics and Measuring Instruments. Paints and Painters' Supplies. Paper and Envelopes. Poisons for Animals. Publications. Receptacles. Rope, Cord, and Twine. Rubber Goods. Seeds, Plants, and Trees. Sewing Machines and Attachments. Sewing Silk, Cotton, and Thread. Shirts, Collars, and Cuffs. Soap. Spices, Mustard, and Salt. Spirituous Liquors. Starch, Cornstarch, and Products. Stationery Miscellany. Steam and Plumbing Supplies. Stoves and Furnaces. Sugar, Sirup, and Molasses. Surgical Instruments and Appli- ances.</p>
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Tailoring and Clothing.
Time-keeping Instruments.
Tobacco and Tobacco Products.
Toilet Articles and Preparations.
Tools and Cutting Instruments.

Umbrellas, Parasols, and Canes.
Underwear and Furnishings.
Vehicles.
Wines.

INDEX

INDEX

[REFERENCES ARE TO PAGES]

A.

ABANDONMENT, 290.

proved by some act or laches, 290.

good-will lost, 293.

intention should be shown, 296.

not shown by numerous infringements, 299.

ACT OF 20TH FEBRUARY, 1905, 345-356.

ADVERTISEMENTS.

not valid trade-marks, 84.

in unfair trade, 181.

AFFIXATION, 20.

ANGOSTURA CASES, 47, 66, 116, 118, 129, 132, 154, 250.

ANIMALS, 16, 52.

APPEAL.

in courts, 323.

in Patent Office, 366.

ARBITRARY SIGN, 6.

may have become descriptive, 47.

valid trade-mark although descriptive, 58.

although become descriptive may be valid trade-mark, 59.

ASSIGNMENT, 218.

of partnership trade-mark, 136.

of trade-mark, 218.

of trade-name, 221.

in bankruptcy, 226-228.

apart from business, 229.

no special form required, 231.

personal trade-mark, 233.

assignee should indicate, 234.

but not necessarily, 236.

local trade-mark passes with locality, 237.

in Patent Office, 368.

ASSOCIATION, 24.

B.

BAKER CHOCOLATE CASES, 100, 169, 170, 193, 278, 307, 340.

BANKRUPTCY.

trade-mark may pass in, 226.

BOOKS, 267.

see NEWSPAPERS, etc.

Chatterbox, 103.

C.

CARLSBAD MINERAL SPRING, 26, 131, 157, 202, 303.

“CASHMERE BOUQUET,” 70.

CLASS OF GOODS.

property rights in trade-marks limited, 92.

what is same class, 95.

classification in Patent Office, 377.

COLOR.

not valid trade-mark, 81.

in unfair trade, 171.

in combination, 180.

COMBINATION OF COLOR, SIZE, ETC.

protected in unfair trade, 180.

COMBINATION OF WORDS, 14.

CORPORATION.

trade-name, 211, 214, 216.

D.

DAMAGES.

in equity, 301.

at law, 313.

DEFINITIONS, 1.

DESCRIPTIVE MARKS, 31.

examples, 31.

words, 31.

compound words, 40.

combination of words, 40.

symbols, 45.

by laches, 48.

without bequest, 49.

series of marks, 52.

incidentally, may be valid trade-mark, 56.

may be arbitrary if not deceptive, 58.

subsequently descriptive may be valid, 59.

trade-mark, 59.

DESCRIPTIVE MARKS — *continued.*

- may be protected on ground of unfair trade, 151.
- series of descriptive marks protected, 153.
- secret descriptive mark, protected, 151.
- descriptive trade-name, 209.

E.**ELGIN CASES, 63, 64, 161, 209, 318.****EQUITY.**

- object of relief, 264.
- principals, 302.

EVIDENCE, 325.**EXAMPLES.**

- valid trade-marks, 8.
- invalid, 31.
- of non-infringement, 270.
- of infringement, 272.

F.**FIGURE, 16.**

- descriptive, 43.

FLOWERS, 15, 52.**FORM.**

- not valid trade-mark, 79.
- protected in unfair trade, 171.

FORMS FOR PATENT OFFICE, 371-376.**FRAUD (see also GOOD FAITH).**

- need not be proven in infringement of trade-marks, 92.
- deceit as to character, 116.
- deceit as to geographical locality, 119.
- deceit as to origin, 121.
- deceit as to true maker, 123.
- courts will not enjoin deceitful use by true owner, 125.
- no trade-mark contrary to good morals, 126.
- collateral fraud prevents relief, 127.
- quack medicines may be protected, 129.
- court liberal in construing representations, 130.
- name of jobber on trade-mark not deceitful, 133.
- as to representation of patent, 146, 147.
- untrue representation as to patent not necessarily fraud, 148.
- fraud to be proved in unfair trade, 185, 187.
- in trade-name, 209, 211.
- fraudulent intent not necessary to show infringement of trade-mark, 258.
- fraud necessary in infringement in unfair trade, 263.

G.

GEOGRAPHICAL MARKS.

- not valid trade-marks, 61.
- name of a people invalid trade-mark, 67.
- nickname of a people may be valid trade-mark, 67.
- may become descriptive, 68.
- when exclusive may be valid trade-mark, 68.
- arbitrarily used, may be valid trade-mark, 69.
- deceit as to locality, 119.
- of resident protected, 155.
- fraudulently used, 157.
- exclusive use protected, 160.
- fraudulent use as against non-resident, 163.
- geographical trade-name not protected, 203.

GOOD FAITH (see also FRAUD), 116.

- trade-mark should be certificate of genuineness, 123.

GOOD-WILL.

- trade-mark sign of good-will, 88.
- what is, 90.

H.

HOSTETTER CASES, 42, 164, 167, 170, 190, 196, 197, 270, 275, 303, 319, 326.

HOTEL LICENSE, 280.

I.

INFRINGEMENT, 239.

- what is, 239.
- although there are differences, 242.
- not where resemblance is not calculated to deceive, 244.
- in unfair trade, 245, 252.
- of trade-name, 256.
- what is act of, 258.
- fraudulent intent not necessary in case of a trade-mark, 258.
- nor proof of deceit, 261.
- nor that other goods are inferior, 262.
- fraud necessary in unfair trade, 263.
- in combinations, 263.
- newspapers, 265.
- publication, 267.
- through trick, 269.
- examples of non-infringement, 270.
- examples of infringement, 272.

INITIALS, 14.**INJUNCTION.**

- laches ground for refusing preliminary injunction, 286.
- refused after laches, 287.
- preliminary, 307.
- perpetual, 312.

INTENTION.

- to claim trade-mark, 28.
- to infringe trade-mark, 258.
- to abandon should be shown, 296.

INTERFERENCE, 338, 366.**J.****JURISDICTION.**

- of U. S. Courts, 301.
- of State Courts, 302.

L.**LABELS.**

- not valid trade-marks, 81.
- in unfair trade, 181.

LACHES, 282.

- words descriptive by, 48.
- trade-marks may be lost by, 108.
- mere delay not always laches, 282.
- but unreasonable delay, 284.
- ground for refusing preliminary injunction, 286.
- rule in England, 286.
- injunction refused, 287.

LANGUAGE.

- foreign language, 20, 49, 50, 51.

LAW.

- remedy in, 312.

LETTERS, 14.

- descriptive, 43.
- descriptive letters in unfair trade, 153.

LICENSE, 280.

- hotel, 280.
- under patent, 281.
- fraudulent license, 281.
- revocable license, 281.

M.

MARKS.

series of, invalid trade-marks, 52.

MEDICINES.

how courts consider them, 120.

MERCHANDISE, 26.

MINERAL SPRINGS, 26, 157, 158, 159, 162, 289 (see also VICHY, CARLSBAD, and HUNYADI).

MOXIE CASES, 177, 178, 280, 319.

N.

NAME, 15.

proper name of historical personage, 15.

fictitious, 15, 127.

of flower, 15.

of animal, 15.

in foreign language, 49.

descriptive of flower, 52.

descriptive of animal, 52.

of proprietor, significance of, 55.

proper name of private party, 73.

of living celebrity, not allowed registration, 78.

proper name used arbitrarily, valid, 78.

proper name protected in unfair trade, 163.

similar names to be distinguished, 165.

name of mechanism may not be protected, 170.

in trade-name, 209, 211.

NEWSPAPERS, ETC., 205.

infringement, 265.

NUMBER, 16.

O.

ORIGIN, 18.

deceit as to, 121.

deceit as to true maker, 123.

P.

PARTIES, 315.

PARTNERSHIP, 134.

dissolution of, 134.

equal rights of former partners, 135.

PARTNERSHIP — *continued.*

- creditors of partnership, 136.
- assignment, 136.
- ownership of single partner, 136.
- trade-mark of one may be partnership property, 137.
- retiring partner held to have abandoned, 138.

PATENT OFFICE. (See RULES AND FORMS.)**PATENTS,** 139.

- trade-mark expires with patent, 140.
- descriptive mark not trade-mark on void patent, 144.
- trade-mark may exist on patented article, 145.
- an earlier trade-mark not invalidated by expiration of patent, 146.
- collateral false representation as to patent, 146.
- false representation on trade-mark, 147.
- not necessarily fraud, 148.
- license under, 281.

PRIORITY.

- of use necessary, 109.

PRACTICE AND PLEADING, 301.

- jurisdiction of U. S. courts, 301.
- of State courts, 302.
- principles of equitable relief, 302.
- damages in equity, 304.
- preliminary injunction, 307.
- perpetual, 312.
- law, relief under, 312.
- damages, 313.
- costs, 314.
- criminal remedy, 315.
- parties, 315.
- pleadings, 320.
- appeal, 323.
- evidence, 325.

PROPERTY RIGHTS.

- in trade-marks, 86.
- no abstract right of property in trade-mark apart from business, 88.
- protected, in trade-marks, irrespective of fraud or intent, 92.
- confined to special classes of goods, 92.
- protected so long as existent, 106.
- may be lost by laches, 108.
- priority necessary, 109.
- use in good faith may be protected, 111.
- territorial extent, 111.
- limited in area, 112.
- limited by common law, 112.
- in several trade-marks, 114.

PROPRIETOR, 22.

name of, significance of, 55.

name of jobber on trade-mark not deceitful, 133.

who may register, 360.

PUBLICI JURIS, 48.

sign may become by laches, 108.

R.**REGISTRATION, 328.**

evidence of intention to claim trade-mark, 29.

patent-office decisions, 330.

interference, 338.

RULES OF PATENT OFFICE, 357-370.

correspondence, 357.

attorneys, 358.

who may register, 360.

what may be registered, 360.

the application, 361.

drawing, 361.

examination of applications, 361.

amendments, 365.

interference, etc., 366.

appeals, 366.

issue, dates, etc., 367.

assignments, 368.

copies, 368.

fees, 368.

repayment, 369.

notice of registration, 370.

amendments of rules, 370.

RUSSIA CEMENT CO. CASES, 76, 113, 194, 224, 228, 278.**S.**

"SCHIEDAM SCHNAPPS," 41, 49, 64, 67, 156, 181, 188, 191, 248.

STYLE OF DRESSING GOODS.

not valid trade-mark, 83.

SYMBOL, 16.

descriptive, 45.

T.**TITLE.**

public official or licensee, 25.

TERRITORIAL EXTENT OF TRADE-MARK, 111.

limited area, 112.

TRADE-MARKS, 6.

- invalid, 31.
- acquisition of, 100.
- casual use not sufficient, 103.
- several, 114.
- what may be registered, 360.

TRADE-NAME, 203.

- business enterprises, 203.
- hotel, 203.
- orchestra, 205.
- newspaper, etc., 205.
- locality of business, 206.
- descriptive not protected, 207.
- geographical not protected, 208.
- proper name, 209.
- as contrasted with trade-mark, 209.
- similar, to be distinguished, 210.
- fraud to imitate, 211.
- corporate name, 214.
- descriptive corporate name, 216.
- may be trade-mark, 216.
- infringement, 256.

U.**UNFAIR TRADE, 151.**

- descriptive sign may be protected, 151.
- descriptive letters protected, 153.
- series of descriptive marks protected, 153.
- deterioration of general merchandise not unfair trade, 154.
- geographical name of resident protected, 155.
- fraudulently used protected, 157.
- exclusive use of geographical name, 160.
- fraudulent use by resident, 163.
- proper name protected, 163.
- similar names to be distinguished, 165.
- name of mechanism not protected, 170.
- form in unfair trade, 171.
- color protected, 171.
- style of dressing, 173.
- certain combinations protected, 180.
- labels and advertisements, 181.
- acquired reputation necessary, 185.
- proof of fraud, 187.
- substitution of signs, 194.
- refilling of boxes, 194.

UNFAIR TRADE — *continued.*

- oral or written misrepresentations, 195.
- violation of contractual right, 197.
- ornamental not structural features, 198.
- essential structural features, 201.
- concurrent rights, 202.
- infringement, 245, 252.
- fraud necessary in case of infringement, 293.
- fraud necessary in infringement, 263.

USE, 30.

- casual use not sufficient, 103.
- prior use necessary, 109.
- in good faith, may be protected, 111.

V.

VICHY, 4, 66, 158, 159, 289.

W.

WALTHAM WATCH CASES, 160, 161.

WORD, 6.

- compound, 13.
- combination of words, 14.
- in foreign language, 20.
- descriptive words, 40.
- descriptive combination of words, 40.
- in foreign language, 50.
- in uncommon foreign language, 51.
- in dead language, 51.