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THE LAW
 OF
TRADE-MARKS
 INCLUDING
TRADE-NAMES
 AND
UNFAIR COMPETITION

BY

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 OF THE MINNEAPOLIS BAR.

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PREFACE.

The effort of the author has been to produce a practical work for the practitioner of trade-mark law. The state and federal decisions on the subject have been exhaustively collated. The trade-mark statutes of the several states compiled and brought down to date will be found in the appendix. No attention has been paid to the trade-mark laws of foreign countries.

The writer desires to acknowledge his obligation to Honorable Charles B. Elliott, Judge of the District Court of this District, for material assistance and many valuable suggestions.

AMASA C. PAUL.

Minneapolis, Minn., April 25, 1903.

TABLE OF CONTENTS.

CHAPTER I.

DEFINITION AND NATURE OF TRADE-MARKS.

- § 1. Definition of Trade-Mark.
- 2. Office of Trade-Mark.
- 3. Indication of Origin or Ownership may be Direct, or by Association of the Mark with the Article.
- 4. Association may be Acquired Only after Long Use.
- 5. The Trade-Mark Brings Seller and Buyer Together.
- 6. Object of the Law in Protecting Trade-Marks.
- 7. Origin of Trade-Mark Law.
- 8. Principle upon Which All Cases Unite.
- 9. Leading Principle that Proprietor shall be Protected.
- 10. Enforcement of Doctrine does not Depend Entirely on Individual Rights.
- 11. Adoption of Trade-Mark Gives no Exclusive Right to Production of Article.
- 12. Proprietor Has Valuable Interest in Goodwill of His Trade or Business.
- 13. Protection of Trade-Marks Promotes Honesty and Fair Dealing.
- 14. Earliest Trade-Mark Case.
- 15. Development of English Trade-Mark Law.
- 16. Development of American Trade-Mark Law.
- 17. Right to Use a Trade-Mark is Property.
- 18. No Abstract Property Right in a Trade-Mark.
- 19. Principle upon Which Courts of Equity Proceed.
- 20. Trade-Mark of Common-Law Origin.
- 21. Statutory Registration may Limit Common-Law Trade-Mark.
- 22. Distinction between Cases Involving Trade-Marks, Trade-Names, and Unfair Competition.
- 23. Underlying Principle of Cases Involving Trade-Marks and Unfair Competition the Same.
- 24. Comparison between Cases of Trade-Marks and Unfair Competition.

CHAPTER II.**WHAT CAN BE APPROPRIATED.**

- § 25. General Rule.
- 26. Devices Held to be Trade-Marks.
- 27. Purpose for Which Mark Adopted may Determine Whether Valid Trade-Mark.
- 28. Test of Trade-Mark.
- 29. Trade-Mark may Secondarily Denote Grade or Quality.
- 30. Trade-Mark may Operate as Assurance of Quality.
- 31. Classes of Trade-Marks.
- 32. Characteristics of Local Trade-Marks.
- 33. Majority of Trade-Marks Impersonal.
- 34. Words in Common Use as Trade-Marks.
- 35. General Rule as to Common Words.
- 36. Instances of Common Words as Trade-Marks.
- 37. Application of Word to Article must be Arbitrary or Fanciful.
- 38. Word may be Valid Trade-Mark, Although Article Has Acquired Wide Sale, and Mark Becomes Indicative of Quality.
- 39. Word may be Valid Trade-Mark, Although It Has Become Ordinary Appellation of Article.
- 40. Trade-Mark may Consist of Common Words, Combined with Other Features.
- 41. Personal Names as Trade-Marks.
- 42. A Person cannot Make a Trade-Mark of His Own Name, and Debar Another, Having the Same Name, from Using It.
- 43. Second User may be Restrained When Fraud Appears.
- 44. Rule does not Apply to Corporations.
- 45. Personal Name Protected Only When It Truthfully Indicates Origin or Ownership.
- 46. Court of Equity will Direct and Control the Use of a Personal Name.
- 47. Instances of Personal Names as Parts of Trade-Marks.
- 48. Names of Places of Business as Trade-Marks.
- 49. Newly-Coined Words as Trade-Marks.
- 50. Instances of Coined Words as Trade-Marks.
- 51. Fanciful Names and Phrases as Trade-Marks.
- 52. Letters as Trade-Marks.
- 53. Instances of Letters as Trade-Marks.
- 54. Numerals as Trade-Marks.
- 55. Instances of Numerals Held to be Valid Trade-Marks.
- 56. Pictures as Trade-Marks.
- 57. Instances of Pictures or Symbols as Trade-Marks.

- 58. Names of Newspapers and Periodicals as Trade-Marks.
- 59. Descriptive or Geographical Words that Have Acquired Secondary Meanings.

CHAPTER III.

WHAT CANNOT BE APPROPRIATED.

- § 60. General Rules.
- 61. Device not Distinctive in Character.
- 62. Mark that Does not Primarily Indicate Origin or Ownership.
- 63. Descriptive Words.
- 64. Instances of Descriptive Words Held Invalid as Trade-Marks.
- 65. Descriptive Words Deceptively Applied.
- 66. Words or Symbols Previously Used as Marks for Like Goods.
- 67. Geographical Names.
- 68. Personal Names.
- 69. Pseudonym or Nom-de-Plume.
- 70. Legislative Incorporation of Personal Name.
- 71. Use of Personal Name as Trade-Mark for Contract Term.
- 72. Personal Name may Become Generic.
- 73. Personal Name Descriptive of Medical Preparation.
- 74. Mere Use of Like Personal Name by Competing Owners.
- 75. Letters or Numerals Used for Certain Purposes.
- 76. Mere Color of Advertisements, Labels, and Manufactured Articles.
- 77. Material.
- 78. Parts of Mark Designed to Indicate Facts Other than Origin or Ownership.
- 79. Color, Form, Material, or Mode of Construction of Package, Article Manufactured, etc.

CHAPTER IV.

APPROPRIATION AND APPLICATION OF TRADE-MARKS.

- § 80. By Whom Trade-Marks may be Acquired and Held.
- 81. Trade-Mark Acquired by Importer of Manufactured Article.
- 82. Trade-Mark Acquired by Selector of Commercial Article.
- 83. Trade-Mark Acquired by Manufacturer in Limited Sense.
- 84. No Trade-Mark Acquired by Manufacturer Who Applies Mark at Request of Purchaser.

TABLE OF CONTENTS.

- 85. No Trade-Mark Acquired by Association Whose Members Apply Union Labels.
- 86. No Trade-Mark Acquired by Inventor of System.
- 87. Priority of Adoption.
- 88. Mere Fact that Trade-Mark not in Use in Particular Locality Gives No One Right to Appropriate It.
- 89. Right of Prior Domestic User.
- 90. How Trade-Mark may be Acquired and Held.
- 91. Use Necessary to Support Claim to Trade-Mark.
- 92. Use, not Invention, of Trade-Mark that Creates Right.
- 93. Use must be Sufficient to Point Out Origin of Claimant's Goods.
- 94. Declaration of Claimant cannot Lay Foundation of Right.
- 95. Voice of Public cannot Appropriate Trade-Mark to Individual.
- 96. Use by One Claimant will not Prevent Adoption by Another for Different Article.
- 97. Trade-Marks Also Acquired by Transfer.
- 98. To What Trade-Marks may be Applied.
- 99. How Trade-Marks may be Applied.

CHAPTER V.
LOSS OF TRADE-MARK RIGHTS.

- § 100. General Rule.
- 101. Abandonment.
- 102. Intent to Abandon must be Shown.
- 103. Registration as Affecting Question of Abandonment.
- 104. Circumstances of Each Case must be Considered.
- 105. Abandonment by Nonuser.
- 106. Laches.
- 107. Rule Where Use is Justified.
- 108. Rule Where Fraud Appears.
- 109. Other Cases Considered.
- 110. Dedication to Public by Expiration of Patent.
- 111. Dedication to Public by Expiration of Copyright.
- 112. Other Forms of Dedication to Public.
- 113. Acquiescence of Original User Necessary.
- 114. General Use of Name does not Dedicate It to Public.
- 115. Whether Name Has Become Generic is Question of Fact.

CHAPTER VI.

TRANSFER OF TRADE-MARKS.

- § 116. Trade-Marks Generally Assignable with Business in Which Used.
117. As an Abstract Right, Trade-Mark not Assignable.
118. Assignee Acquires All Rights of Assignor.
119. Assignee Has no Better Title than Assignor.
120. One may Assign His Own Name so as to Deprive Himself of Its Further Use.
121. Trade-Mark Assignable with Letters Patent.
122. Partnership Generally Acquires Trade-Mark of Individual Partners.
123. Firm may Have License from Individual Partner, Which Will Revert to Owner on Dissolution of Partnership.
124. Firm or Corporation Succeeding to Business Acquires Trade-Mark.
125. Partners Remaining in Firm Entitled to Firm Trade-Marks.
126. All Partners Entitled to Use Trade-Mark on Dissolution of Firm: Hazard v. Caswell.
127. Same Rule: Huwer v. Dannenhoffer.
128. Cases of Hazard v. Caswell and Huwer v. Dannenhoffer Compared with Menendez v. Holt.
129. Successor may Acquire Right to Use Name from Others.
130. Successor to Original Proprietor may Appropriate Trade-Mark.
131. One Who Acquires Manufactory may Acquire Right to Use Trade-Mark.
132. Proprietor may Use Name of Mill.
133. No Exclusive Right to Trade-Mark Acquired by Mortgage of Lands and Mill.
134. Personal Name not Transferable.
135. Whether Trade-Mark Assignable Depends upon Effect Produced by Use Thereof.
136. Trade-Mark Inseparable from Thing Which Gives It Value.
137. Name of Man cannot be Segregated from the Man Himself, and from His Business.
138. Trade-Mark Consisting of Name of Individual no Guaranty that Articles Made by Individual Personally.
139. Names Held not Personal.
140. Personal Trade-Mark Held Assignable Where Original Proprietors Supervise Manufacture.
141. Question of Assignability Depends upon Circumstances.
142. Purchasers of Trade-Marks should Indicate Change.
143. Trade-Mark not Assignable Where Its Use Would Deceive Public.

- 144. Transfer of Trade-Mark Apart from Business Confers no Title on Transferee.
- 145. Leading English Case of Leather Cloth Co. v. American Leather Cloth Co.
- 146. Sale of Wood-Cuts does not Transfer Trade-Mark.
- 147. Assignment of Invalid Registered Mark Insufficient to Support Injunction.
- 148. Assignment in Bankruptcy Carries Trade-Mark.
- 149. Assignment to Trustee of All Assets Carries Trade-Mark.
- 150. Instance of General Assignment not Passing Trade-Mark.
- 151. No Distinction between Sale by Proprietor and Sale by Assignee.
- 152. Right to Use Name and Knowledge cannot be Taken by Judicial Proceeding.
- 153. Administrator of Assignee Has no Title to Trade-Mark.
- 154. Trade-Mark cannot be Levied upon by Execution.

CHAPTER VII.

JOINT OWNERSHIP OF TRADE-MARKS.

- § 155. In General.
- 156. Arising by Agreement.
- 157. Arising by Transfer.
- 158. Arising by Succession to Business.
- 159. Arising by Dissolution of Partnership.

CHAPTER VIII.

TRADE OR COMMERCIAL NAMES.

- § 160. Definition.
- 161. Individual Names.
- 162. Impersonal Name Used by Individual.
- 163. Firm Names.
- 164. License to Use Individual Name.
- 165. Presumption as to Individual Name Appearing in Firm Name.
- 166. Rule Where Firm Name is Impersonal.
- 167. Corporate Names.
- 168. Conflicting Corporate Names.

169. Corporation may Acquire Trade-Name Different from Corporate Name.
170. Corporation may not be Entitled to use Abbreviated Name.
171. Estoppel Arising from Assent to Adoption of Corporate Name.
172. Individual Name Used as Principal Part of Corporate Name.
173. Descriptive Names cannot be Exclusively Appropriated.
174. Injunctions Refused.
175. Where Corporation is not of Commercial or Trading Character.
176. Organization of Corporation with Name Conflicting with Name of Prior Corporation.
177. Names of Places of Business.
178. Miscellaneous Trade-Names.
179. Trade-Name Usually Follows the Business.
180. Trade-Name Affixed to Particular Building or Locality.
181. Trade-Name Personal to an Individual.
182. Elements of Unfair Competition Usually Present in Trade-Name Cases.

CHAPTER IX.

INFRINGEMENT.

- § 183. Classes of Infringement.
184. Infringements of the First Class.
185. Infringements of the Second Class.
186. Infringements of the Third Class, or Unfair Competition.
187. General Rule as to Infringement.
188. Resemblance Necessary to Constitute Infringement.
189. Cases Holding Similarity must Amount to False Representation.
190. Caution Required on Part of Purchasers.
191. Not Necessary that Any One has Actually been Deceived.
192. Infringement may Appear from Accessories.
193. May be Determined by Inspection.
194. Expert Evidence may be Admissible.
195. Other Evidence may be Required.
196. Intent to Infringe Unnecessary.
197. Immaterial that Purchasing Dealer not Deceived.
198. Infringement not Excused by Custom of Trade.
199. Infringement by Manufacturer of Labels or Brands.
200. Refilling Packages Bearing Genuine Mark.

- 201. Sale of Low-Grade for High-Grade Goods of Same Manufacturer.
- 202. Infringing Use must be on Same Class of Goods.
- 203. Infringement not Avoided by Use of Infringer's Name.
- 204. Infringement not Avoided by Change of Accessories.
- 205. Instances of Infringement.
- 206. Instances of Noninfringement.

CHAPTER X.

UNFAIR COMPETITION IN TRADE.

- § 207. In General.
- 208. Distinguished from Technical Trade-Marks.

I. GENERAL PRINCIPLES.

- § 209. Basis of the Rule.
- 210. Fraudulent Intent.
- 211. No Exclusive Right in Complainant.
- 212. Fraud of Complainant.
- 213. Misrepresentation as to Articles not Involved in Suit.
- 214. Laches of Complainant.
- 215. Parties Misled.

II. ILLUSTRATIONS AND CONDITIONS UNDER WHICH RELIEF IS GRANTED.

- § 216. Use of Corporate Name.
- 217. Disclosure of Trade Secrets.
- 218. Ex-Partner—Use of Information by.
- 219. Advertising as "Late With"—"Successor to."
- 220. Oral Statements.
- 221. Monopoly of Material.
- 222. Selling Inferior Goods under Similar Name.
- 223. Imitation of Signs.
- 224. Substitution of Goods.
- 225. Methods of Advertising.
- 226. Place of Advertisement as Affecting Fraud.
- 227. Expiration of Patent.
- 228. Expiration of Patent—Generic Name—Secondary Meaning of Word.
- 229. Imitating Name of Newspaper.
- 230. Fraudulent Imitation of Book Titles.
- 231. Unpatented Medicinal Preparations.
- 232. Acts Induced by Plaintiff.

III. USE OF PERSONAL NAME.

- § 233. In General.
234. Limitations—Where Name Indicates Source of Manufacture.
235. The Singer Case.
236. Illustrations.
237. Family Name—Relationship to Original Manufacturer of Article.
238. Personal Name as Part of Corporate Name.
239. Incorporation under Personal Name.
240. Personal Name as Part of Label.

IV. GEOGRAPHICAL NAMES.

- § 241. The General Rule.
242. Name of Place.
243. Same—Illustrations.
244. Stone Ale Case.
245. Glenfield Starch Case.
246. The Yorkshire Relish Case.
247. Old Country Soap Case.
248. "Oxford," as Denoting Bibles.

V. USE OF DESCRIPTIVE WORDS.

- § 249. General Statement.
250. Nondescriptive Trade-Name—Confusion of Sources of Production.
251. Words Descriptive of Origin—Use of Word "Vichy."
252. Descriptive Words—Secondary Meaning—"Camel-Hair Belting."

VI. IMITATION OF LABELS.

- § 253. In General.
254. Dissimilarity.
255. Sale of Labels to Plaintiff's Competitors.
256. Game of District Messenger Boy Case.
257. Canadian Rye Whiskey Case.
258. Royal Baking Powder Case.
259. Saponifire Case.
260. P. Lorillard's Tuberosse Case.
261. Morse's Syrup of Yellow Dock Case.
262. No-To-Bac Case.
263. Clark's Thread Case.
264. Hoff's Malt Extract Case.
265. Sarsaparilla and Iron Case.

VII. IMITATION OF DRESS OR FORM OF PACKAGE.

- § 266. In General.

- 267. Color of Wrappers.
- 268. Form of Bottle.
- 269. Bottle Stamped with Complainant's Name.
- 270. Exclusive Right to Box.
- 271. Every-Day Soap Case.
- 272. Baker's Breakfast Cocoa Case.
- 273. Moxie Case.
- 274. Mumm's Extra Dry Case.
- 275. Silicon Case.
- 276. Sapolio Case.
- 277. Hostetter's Bitters Case.
- 278. Black Package Tea Case.
- 279. Cuticura Case.
- 280. Liebig's Beef Extract Case.
- 281. "Franck Chicory" Case.
- 282. "Velvet" Candy Wrapper Case.
- 283. Old Coon Smoking Tobacco Case.
- 284. Simmons' Liver Medicine Case.
- 285. Awl Package Case.

CHAPTER XI.

COURTS AND PARTIES.

- § 286. Jurisdiction of United States Courts.
- 287. Jurisdiction of State Courts.
- 288. Parties Plaintiff.
- 289. Parties Defendant.

CHAPTER XII.

PLEADING AND PRACTICE.

- § 290. Introductory.
- 291. Bill in Equity.
- 292. Answer in Equity.
- 293. Plea in Equity.
- 294. Demurrer in Equity.
- 295. Declaration or Complaint at Law.
- 296. Answer at Law.
- 297. Demurrer at Law.

- 298. Pleadings in the State Courts.
- 299. Joinder of Causes of Actions.
- 300. Multifariousness.
- 301. Preliminary Injunctions—Granted.
- 302. Preliminary Injunctions—Refused.
- 303. Permanent Injunctions.
- 304. Violation of Injunction.
- 305. Parties—Who Entitled to Injunction.
- 306. Practice—Propriety of Approval by Court of New Label.
- 307. Power of Court on Appeal.

CHAPTER XIII.

DEFENSES.

- § 308. In General.
- 309. No Exclusive Right in Claimant.
- 310. License.
- 311. Abandonment.
- 312. Use on Different Class of Goods.
- 313. Noninfringement.
- 314. Laches.
- 315. Deception Practiced by Claimant.
- 316. False Statements on Packages.
- 317. False Statements in Advertisements.
- 318. False Statements as to Person by Whom Article is Manufactured.
- 319. False Statements as to Place of Manufacture.
- 320. False Statements as to Materials Used.
- 321. False Statements as to Letters Patent.
- 322. Immaterial Misrepresentations.

CHAPTER XIV.

DAMAGES, PROFITS, COSTS.

- § 323. Redress at Law or in Equity.
- 324. Damages at Law.
- 325. Recovery in Equity—English Rule.
- 326. Recovery in Equity—United States Rule.
- 327. Costs.

CHAPTER XV.

TRADE-MARK LEGISLATION.

- § 328. The Federal Act of 1870.
- 329. The Federal Act of 1876.
- 330. The Act of 1870 Unconstitutional.
- 331. Act of 1876 Fell with Act of 1870.
- 332. The Federal Act of 1881—The Present Law.
- 333. Duty of Commissioner of Patents.
- 334. Owners of Trade-Marks.
- 335. Commerce with Foreign Nations and Indian Tribes.
- 336. Domicile of Owner.
- 337. Name of Applicant.
- 338. Identity with Registered or Known Trade-Mark.
- 339. Application of Mark.
- 340. Class of Merchandise.
- 341. Descriptive Words not Registrable.
- 342. Geographical Words not Registrable.
- 343. Trade-Mark Used on Patented Article.
- 344. Construction of Application.
- 345. Infringing Use of Registered Trade-Mark.
- 346. Registration only Prima Facie Evidence of Ownership.
- 347. Interferences.
- 348. The Federal Act of 1882.
- 349. The Print and Label Act of 1874.
- 350. State Statutes.
- 351. Treaties and the International Convention.

THE LAW OF TRADE-MARKS.

CHAPTER I.

DEFINITION AND NATURE OF TRADE-MARKS.

- § 1. Definition of Trade-Mark.
2. Office of Trade-Mark.
3. Indication of Origin or Ownership may be Direct, or by Association of the Mark with the Article.
4. Association may be Acquired Only after Long Use.
5. The Trade-Mark Brings Seller and Buyer Together.
6. Object of the Law in Protecting Trade-Marks.
7. Origin of Trade-Mark Law.
8. Principle upon Which All Cases Unite.
9. Leading Principle that Proprietor shall be Protected.
10. Enforcement of Doctrine does not Depend Entirely on Individual Rights.
11. Adoption of Trade-Mark Gives no Exclusive Right to Production of Article.
12. Proprietor Has Valuable Interest in Goodwill of His Trade or Business.
13. Protection of Trade-Marks Promotes Honesty and Fair Dealing.
14. Earliest Trade-Mark Case.
15. Development of English Trade-Mark Law.
16. Development of American Trade-Mark Law.
17. Right to Use a Trade-Mark is Property.
18. No Abstract Property Right in a Trade-Mark.
19. Principle upon Which Courts of Equity Proceed.
20. Trade-Mark of Common-Law Origin.
21. Statutory Registration may Limit Common-Law Trade-Mark.
22. Distinction between Cases Involving Trade-Marks, Trade-Names, and Unfair Competition.
- 23. Underlying Principle of Cases Involving Trade-Marks and Unfair Competition the Same.
24. Comparison between Cases of Trade-Marks and Unfair Competition.

§ 1. Definition of trade-mark.

A trade-mark is a sign, symbol, mark, figure, picture, device, numeral, letter, word, name, or combination of any or all of these, used by a manufacturer, producer, or vendor of a commercial article, and indicating primarily, either by its own meaning or by association, the origin, ownership, or place of manufacture, production, or sale of the article to which it is applied.¹ It is a notice indicating origin. It cannot exist—that is, be the subject of ownership—apart

¹ Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311-323; McLean v. Fleming (1877) 96 U. S. 245; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Menendez v. Holt (1888) 128 U. S. 514; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Hostetter v. Fries (1883) 17 Fed. 620; Atlantic Milling Co. v. Robinson (1884) 20 Fed. 217; Adams v. Heisel (1887) 31 Fed. 279; Royal Baking Powder Co. v. Raymond (1895) 70 Fed. 376; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Taylor v. Carpenter (1846) 2 Sandf. Ch. (N. Y.) 603; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Phalon v. Wright (1864) 5 Phila. (Pa.) 434; Derringer v. Plate (1865) 29 Cal. 292; Falkinburg v. Lucy (1868) 35 Cal. 52; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Willey v. Fassett (1869) 44 Mo. 168; Candee v. Deere (1870) 54 Ill. 439; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 10 Abb. Pr. (N. S.; N. Y.) 348; Gillott v. Esterbrook (1872) 48 N. Y. 374; Wolfe v. Barnett (1872) 24 La. Ann. 97; Burke v. Cassin (1873) 45 Cal. 467; Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5; Dunbar v. Glenn (1877) 42 Wis. 118; Gilman v. Hunnewell (1877) 122 Mass. 139; Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453; Shaver v. Shaver (1880) 54 Iowa, 208; Hier v. Abrahams (1880) 82 N. Y. 519; Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946; Avery v. Meikle (1883) 81 Ky. 73; Selchow v. Baker (1883) 93 N. Y. 59; Smith v. Walker (1885) 57 Mich. 456; American Solid Leather Button Co. v. Anthony (1886) 15 R. I. 338; Cady v. Schultz (1895) 19 R. I. 193; Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutillier (1888) 47 Hun (N. Y.) 521; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1891) 137 Ill. 231; Hoyt v. Hoyt (1891) 143 Pa. 623; Metcalfe v. Brand (1887) 86 Ky. 331; Weener

from a business, or the goodwill thereof.² It must be so clear and well defined as to give notice to others of the origin

v. *Brayton* (1890) 152 Mass. 101, 8 L. R. A. 640; *Cigar-Makers' Protective Union v. Conhalm* (1889) 40 Minn. 243, 3 L. R. A. 125.

The following are some of the definitions of a trade-mark, to be found in the decisions of the courts:

In *Shaw Stocking Co. v. Mack* (1882) 12 Fed. 707, 710, Coxe, J.: "A trade-mark is a mark by which the wares of the owner are known in trade."

In *Adams v. Heisel* (1887) 31 Fed. 279, 280, Welker, J.: "What is a trade-mark? A 'mark' means to make a visible sign upon something; to affix a significant mark to; to draw, cut, fasten, brand; a token upon, indicating or intimating something; to affix an indication to; to attach one's name or initials to. *Webst. Dict.* A trade-mark, therefore, consists of the use in trade of such a mark, placed upon goods manufactured by a particular person, and placed in market, with such marks, for sale and trade."

In *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314, 317, Allison, P. J.: "A trade-mark * * * is * * * a name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from the goods of another."

In *Candee v. Deere* (1870) 54 Ill. 439, 456, Breese, J.: "A trade-mark is the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry, or enterprise."

In *Burke v. Cassin* (1873) 45 Cal. 467, 478, Rhodes, J.: "A trade-mark is a word, symbol, figure, form, or device, or a combination thereof, adopted or devised and used by a manufacturer or vendor of goods to designate the origin or ownership of his goods, and is used by him to distinguish his goods from those which are manufactured or sold by others."

In *Cady v. Schultz* (1895) 19 R. I. 193, 195, Douglas, J.: "A trade-mark is a symbol arbitrarily selected by a manufacturer or

²*Royal Baking Powder Co. v. Raymond* (1895) 70 Fed. 376; *Cigar-Makers' Protective Union v. Conhalm* (1889) 40 Minn. 243, 3 L. R. A. 125.

or ownership of the article to which it is applied, and it cannot be materially changed or deviated from.³ It is a right

dealer, and attached to his wares to indicate that they are his wares. * * * When it has become generally known in the trade that this symbol or word has been taken by one dealer or manufacturer to indicate his goods, he acquires a title to it for that purpose, and no one else can use it, even innocently."

In *Avery v. Meikle* (1883) 81 Ky. 73, 84, Hargis, C. J.: "A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral, or combination or arrangement of any or all of these, which would serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth."

In *Dr. Jeager's Sanitary Woolen System Co. v. Le Bouteiller* (1888) 47 Hun (N. Y.) 521, 523, Van Brunt, F. J.: "A trade-mark * * * is a mark or device attached by the manufacturer and seller of goods to the merchandise produced by him, in order to distinguish it from a like class of merchandise produced by others; and the right to the exclusive use of such mark accrues, not because he was the originator of the same, but because he has applied it to goods of his manufacture, and they have acquired a reputation in connection with such mark."

In *Shaver v. Shaver* (1880) 54 Iowa, 208, 210, Beck, J.: "A trade-mark is a name, sign, symbol, mark, brand, or device of any kind used to designate the goods manufactured or sold, or the place of business of the manufacturer or dealer in such goods. The exclusive right in a trade-mark is acquired by its use, which the law does not require shall be continued for any prescribed time."

In *Wecner v. Brayton* (1890) 152 Mass. 101, 102, 8 L. R. A. 640, 642. Devens, J.: "A trade-mark is a peculiar name or device, by which a person dealing in an article designates it as of a peculiar kind, character, or quality, or as manufactured by or for him, or dealt in by him, and of which he is entitled to the exclusive use."

In *Leidersdorf v. Flint* (1878) 8 Biss. 327, 330, Fed. Cas. No. 8,219, Dyer, J.: "A trade-mark has been very well defined as one's commercial signature to his goods. It may consist of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer

³ *Candee v. Deere* (1870) 54 Ill. 439; *Metcalf v. Brand* (1887) 86 Ky. 331.

which can only be tested by its violation.⁴ It acknowledges no territorial boundaries, and is not limited in time. It is a right that must be exclusive in the proprietor, either individually or jointly with others.⁵ It has been well defined as one's commercial signature.⁶

or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, so that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity."

In *Leather Cloth Co. v. American Leather Cloth Co.* (1865) 35 Law J. Ch. 53, 61, Lord Cranworth: "The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where, or by whom, or at what manufactory, the article to which it is affixed was manufactured."

In *Larrabee v. Lewis* (1881) 67 Ga. 561, 563, Crawford, J.: "A trade-mark is defined to be the name, symbol, figure, letter, form, or device used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and to secure such profits as result from a reputation for superior skill, industry, or enterprise."

In *Humphreys' Specific Homeopathic Medicine Co. v. Wenz* (1882) 14 Fed. 250, 252, Nixon, Dist. J.: "A trade-mark is any proper mark by which goods and wares of the owner or manufacturer are known in the trade."

In *Hostetter v. Fries* (1883) 17 Fed. 620, 622, Wallace, J.: "A trade-mark consists of a word, mark, or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article."

In *Davis v. Davis* (1886) 27 Fed. 490, 491, Carpenter, J.: "A trade-mark is some arbitrary or representative device attached to or sold with merchandise, and serving to designate the origin or manufacture of that merchandise."

⁴ *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314; *Collins v. Cowen* (1857) 3 Kay & J. 428; *Farina v. Silverlock* (1856) 6 De Gex, M. & G. 214; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 N. Y. 291.

⁵ *Delaware & H. Canal Co. v. Clark* (1871) 13 Wall. (U. S.) 311; *Siegert v. Abbott* (1893) 72 Hun (N. Y.) 243.

⁶ *Leidersdorf v. Flint* (1878) 8 Biss. 327, Fed. Cas. No. 8,219.

§ 2. Office of trade-mark.

The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed or applied. Unless it does this, neither can he who first adopted the trade-mark be injured by any appropriation or imitation of it by others, nor can the public be deceived. "The first appropriator of a name or device pointing to his ownership, or which, by being associated with his articles of trade, has acquired an understood reference to him as the originator or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is in effect representing falsely that the productions of the latter are those of the former. Thus, the custom and advantages to which the enterprise and skill of the first appropriator had given him a just right are abstracted for another's use, and this is done by deceiving the public, by inducing the public to purchase the goods and manufactures of one person, supposing them to be those of another. The trade-mark must, therefore, be distinctive in its original signification, pointing to the origin of the article, or it must have become so by association."⁷

⁷ Delaware & H. Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Kidd v. Johnson (1879) 100 U. S. 617; Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51; Larrabee v. Lewis (1881) 67 Ga. 561; Denison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651; Cigar-Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125; Marshall v. Pinkham (1881) 52 Wis. 572; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Symonds v. Jones (1890) 82 Me. 302; Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 Sup. Ct. 151; Laughman's Appeal (1889) 128 Pa. 1; Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117; Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391; Royal Baking Powder Co. v. Sherrill (1883) 93 N. Y. 331; Handy v. Commander (1897) 49 La. Ann. 1119.

In Amoskeag Mfg. Co. v. Trainer (1879) 101 U. S. 51, 54, Field, J.: "The object of the trade-mark is to indicate, either by its own
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§ 3. Indication of origin or ownership may be direct, or by association of the mark with the article.

While the trade-mark must indicate the "true origin or ownership" of the article to which it is applied, it need not

mean by itself, or by association, the origin or ownership of the article to which it is applied. If it did not, it would serve no useful purpose either to the manufacturer or to the public. It would afford no protection to either against the sale of a spurious in place of the genuine article."

In *Kidd v. Johnson* (1879) 100 U. S. 617, 620, Field, J.: "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."

In *Columbia Mill Co. v. Alcorn* (1893) 150 U. S. 460, 463, Jackson, J.: "To acquire the right to the exclusive use of a name, device, or symbol as a trade-mark, it must appear that it was adopted for the purpose of identifying the origin or ownership of the article to which it is attached, or that such trade-mark must point distinctively, either by itself or by association, to the origin, manufacture, or ownership of the article on which it is stamped. It must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity, and to distinguish it from like articles manufactured by others."

In *Royal Baking Powder Co. v. Sherrell* (1883) 93 N. Y. 331, 334, Rapallo, J.: "The right to use a word or name as a trade-mark is the right which a person has to use a certain mark or name for articles which he has manufactured, so that he may prevent another person from using it, because the mark or name denotes that articles so marked or named were manufactured by a certain person, and no one can have the right to put the same name or mark upon his goods, and thus represent them to have been manufactured by the person whose mark it is."

In *Waterman v. Shipman* (1891) 130 N. Y. 301, 311, Vann, J.: "The function of a trade-mark is to point out the maker of the article to which it is attached. It individualizes the particular make of one who adopted the name for that purpose and with that effect. The defendants claim that the use by them of the name in question did not point out the maker, but the inventor, but we think it indicated both. 'Waterman's Fountain Pen,' with the date of the patent following, pointed out the inventor, while the insertion of the word 'Ideal,' together with the use made of it, pointed out the maker. * * * As the name was also used to indicate

give such indication directly or by its own meaning. It is sufficient if it indicate the ownership or origin by association of the particular mark with the particular article. For instance, if an arbitrary or fanciful mark or device is applied as a trade-mark to an article, there need be nothing more than this mark or device on the article. The manufacturer's or dealer's name and address may be wholly want-

the patented article, it performed the double function of identifying, not only fountain pens as made by Mr. Waterman, but also as patented by him. Can this fact take anything from his rights, or add anything to those of the defendants? Cannot a patentee adopt the same name to designate his workmanship, as well as his invention? Assuming that, upon the expiration of the patent, any one may use the name, until that time arrives, why should the inventor be deprived of a right which, without question, would be his if he had not taken out a patent for his invention?"

In *Cigar-Makers' Protective Union v. Conhalm* (1889) 40 Minn. 243, 245, Gilfillan, C. J.: "It is essential that the symbol or device shall be adopted to distinguish the productions of the manufacturer or vendor from those of others, and it must so distinguish them."

In *Symonds v. Jones* (1890) 82 Me. 302, 310, Emery, J.: "Such words and marks, however, as by their own meaning, or by association in the public mind, indicate not the quality of an article, but its origin or ownership,—the person by whom or the factory in which it was produced,—become appropriated in their use exclusively to the originator or owner of such articles. No other person can lawfully use them to designate other similar articles of different origin or ownership."

In *Laughman's Appeal* (1889) 128 Pa. 1, 19, Clark, J.: "The object of a trade-mark is that the article to which it is attached or belongs may be distinguished from articles of a similar kind, and thus be known and identified in the market. Its purpose is to indicate the personal origin of the article to which it is applied, or the source from which it comes."

In *Marshall v. Pinkham* (1881) 52 Wis. 572, 578, Cassoday, J.: "It seems to be the office of a trade-mark to point out the true source, origin, or ownership of the goods to which the mark is applied, or to point out and designate a dealer's place of business, distinguishing it from the business locality of other dealers."

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ing, and the indication of origin or ownership may be the consequence of such continued and uniform use of marks, devices, or, in some instances, of words, by a manufacturer or dealer, as to create, in the mind of the public, an association between the marks, devices, or words and the article to which they are attached, on the one hand, and the manufacturer or dealer, or place of manufacture, on the other; so that mere marks, devices, or words which, upon their face, impart no reference to or connection with the manufacturer of, or dealer in, the article to which they are constantly affixed, nor any index to its origin, may, because of such customary use upon such article, come to indicate clearly its origin or ownership. The trade-mark will then indicate origin or ownership wholly by association.⁸

In the case of *Ferguson v. Davol Mills*,⁹ the court held that the letter "K," surrounded by a circle, did not constitute a trade-mark, as it did not indicate the name and address of the manufacturer, and, in deciding the case, Allison, P. J., said: "The simplest case of a trade-mark is the name and address of the claimant, and it is absolutely requisite that a device or symbol should perform the office of a finger board,—should indicate the name and address of the manufacturer, to invest it with the attribute, and entitle it to the protection, of a trade-mark."

In the later case of *White v. Schlect*,¹⁰ Judge Allison ad-

⁸ *Delaware & H. Canal Co. v. Clark* (1871) 13 Wall. (U. S.) 311; *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51; *Kidd v. Johnson* (1879) 100 U. S. 617; *Powell v. Birmingham Vinegar Brewery Co.* (1896) 65 Law J. Ch. Div. 563; *Scott v. Standard Oil Co.* (1894) 106 Ala. 475; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651; *Pearrung v. Compton* (1892) 6 Ohio Cir. Ct. R. 483; *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338; *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 91 Fed. 376.

⁹ (1869) 7 Phila. (Pa.) 253; (1868) 2 Brewst. (Pa.) 314.

¹⁰ (1880) 14 Phila. (Pa.) 88.

hered to the rule laid down by him in *Ferguson v. Davol Mills*. This position, however, is not sound. It loses sight of the rule that a trade-mark may indicate origin or ownership by association, as well as by its own meaning. Judge Allison's decision has not been followed in later cases.¹¹

In *Sheppard v. Stuart*,¹² Judge Finletter discusses the case of *Ferguson v. Davol Mills*, and, after pointing out that the cases cited by the learned judge in that case do not support his position, says: "How is a mark or device to indicate 'true origin or ownership,' or to indicate the name and address of the manufacturer? In and by itself alone, this is impossible. It is only by use as the device of him who distinguishes his goods by it in order that they may be known as his that it can ever indicate 'true origin or ownership.' * * * In other words, the evidence must show the first appropriation of the device by the claimant, its application by him to his goods or business, and that the trade or public recognize the article or business by that device, as made or sold by him, or belonging to him. In no other way can a mark or device indicate 'true origin or ownership.'"

§ 4. Association may be acquired only after long use.

The association of the trade-mark with the origin of the goods may be acquired only after long use. The effect as well as the value of the trade-mark is the work of time and experience. It is sufficient for all purposes if, at the time when the question of the validity of the trade-mark is raised,

¹¹ *Godillott v. Harris* (1880) 81 N. Y. 263; *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338 (see note to this case in 26 Am. Law Reg. [N. S.] 176); *Meriden Britannia Co. v. Parker* (1872) 39 Conn. 450; *Sheppard v. Stuart* (1879) 13 Phila. (Pa.) 117; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹² (1879) 13 Phila. (Pa.) 117.

it is well understood by the trade that articles bearing the mark are made or sold by a particular manufacturer or vendor.¹³ The original use of the trade-mark may have been begun and continued for any length of time without any thought or intention on the part of the proprietor of the device of its being or becoming a trade-mark. As stated by the supreme court of the United States: "The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident, rather than design."¹⁴ It is for this reason that a descriptive or geographical term may sometimes become a valid trade-mark. When first employed, such term may have been used only in its primary descriptive sense, but, after long use, it may acquire a new or secondary meaning, and may come, when thus used, to designate to the mind of the purchasing public the particular article as made or sold by a particular manufacturer or vendor, instead of indicating that the article possesses certain qualities, or is to be obtained from a particular locality.¹⁵

§ 5. The trade-mark brings seller and buyer together.

It has been said that the province of a trade-mark is to bring seller and buyer together, that the one may sell his merchandise, and the other obtain the particular goods the reputation of which has won his confidence, and that, when this is done, the office and object of the trade-mark is accom-

¹³ Meriden Britannia Co. v. Parker (1872) 39 Conn. 450.

¹⁴ Trade-Mark Cases (1879) 100 U. S. 82.

¹⁵ American Waltham Watch Co. v. United States Watch Co. (1899) 173 Mass. 85; American Waltham Watch Co. v. Sandman (1899) 96 Fed. 330; Wotherspoon v. Currie (1872) 42 Law J. Ch. 130, L. R. 5 H. L. 508.

plished.¹⁶ By this is meant that, when the trade-mark has guided the article from the purchaser to the consumer, it has done its work. It has brought to the consumer the article that he wishes to purchase. It has guaranteed to him the genuineness of that article. If the case or package bearing such trade-mark is now used for a totally different purpose, or if the trade-mark is removed or obliterated, no one is deceived or misled, and no injury is done either to the seller or buyer.

§ 6. Object of the law in protecting trade-marks.

The object or purpose of the law in protecting trade-marks is two-fold: First, it secures to him who has been instrumental in bringing into the market a superior article of merchandise the fruit of his industry and skill; second, it protects the community from imposition, and furnishes a guaranty that an article, purchased as the manufacture or selection of one who has appropriated to his own use a certain trade-mark, is genuine. The law thus prevents fraud upon the manufacturer, and imposition upon the public.¹⁷ As said by the supreme court of the United States in a leading case, any one has an unquestionable right to affix to articles manufactured by him a mark or device not previously appropriated to distinguish his from articles of the same general character manufactured or sold by others. He may

¹⁶ Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

¹⁷ Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Newman v. Alvord (1867) 49 Barb. (N. Y.) 588; Wolfe v. Burke (1873) 7 Lans. (N. Y.) 151; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 45 N. Y. 291; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Skinner v. Oakes (1881) 10 Mo. App. 45; Avery v. Meikle (1883) 81 Ky. 73; De Long v. De Long Hook & Eye Co. (1894) 10 Misc. Rep. (N. Y.) 577.

thus notify the public of the origin of the article, and secure to himself the benefit of any particular excellence it may possess from the manner or materials of its manufacture. His trade-mark is both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture. It thus often becomes of great value to him, and, in its exclusive use, the court will protect him against attempts of others to pass off their products upon the public as his. This protection is afforded, not only as a matter of justice to him, but to prevent imposition upon the public.¹⁸

§ 7. Origin of trade-mark law.

The trade-mark law grew out of the philosophy of the general rule that every man should so use his own property and rights as not to injure the property and rights of another, unless some priority of right or emergency exists to justify a necessarily different manner of use. The intermediate instrument of prevention which the law protects in its office is called a "trade-mark," which an owner of goods may adopt and use to indicate their origin or ownership, and to distinguish them from goods of a similar nature produced by somebody else.¹⁹

§ 8. Principle upon which all cases unite.

The principle upon which all the cases on the subject of trade-marks unite is that one man will not be permitted, by imitating the distinctive name or mark already in use by another person to designate the articles of the latter's manufacture, to impose articles of his own manufacture upon the public as the articles of the latter. The cases so holding

¹⁸ *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51.

¹⁹ *Avery v. Meikle* (1883) 81 Ky. 73.

rest upon the considerations already stated: First, that it would be a fraud upon the rights of the first user thus to permit his trade-mark to be imitated; second, that it would be a fraud on the public.²⁰

§ 9. Leading principle that proprietor shall be protected.

It is the leading principle of the law of trade-marks that the manufacturer or merchant who has produced or brought into market an article of use or consumption that has found favor with the public, and who, by affixing to it some name, device, or symbol which serves to distinguish it from all others, has furnished his individual guaranty of its value, shall receive the reward of his skill, and shall not be deprived thereof by infringement or imitation.²¹

§ 10. Enforcement of doctrine does not depend entirely on individual rights.

The enforcement of the doctrine that trade-marks shall

²⁰ McLean v. Fleming (1877) 96 U. S. 245, 251; Gilman v. Hunnewell (1877) 122 Mass. 139; Colman v. Crump (1877) 70 N. Y. 573; Fairbanks v. Jacobus (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608; Devlin v. Devlin (1875) 67 Barb. (N. Y.) 290; Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297; Curtis v. Bryan (1868) 2 Daly (N. Y.) 312, (1867) 36 How. Pr. (N. Y.) 33; Amoskeag Mfg. Co. v. Spear (1849) 2 Sandf. (N. Y.) 599; Howe v. Howe Machine Co. (1867) 50 Barb. (N. Y.) 236; Sykes v. Sykes (1824) 3 Barn. & C. 541; Burgess v. Burgess (1853) 3 De Gex, M. & G. 896, 904; Burke v. Cassin (1873) 45 Cal. 467; Ellis v. Zeilin (1871) 42 Ga. 91; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523, 538; Perry v. Truefitt (1842) 6 Beav. 66; Walton v. Crowley (1856) 3 Blatchf. 440, 448, Fed. Cas. No. 17,133; Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321; Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322.

²¹ Wolfe v. Barnett (1872) 24 La. Ann. 97; Duniway Pub. Co. v. Northwest Printing & Pub. Co. (1884) 11 Or. 322; Marshall v. Pinkham (1881) 52 Wis. 572; Clark v. Clark (1857) 25 Barb. (N. Y.) 76.

not be simulated does not depend entirely upon the alleged invasion of individual rights, but as well upon the broad principle that the public are entitled to protection from the use of previously appropriated names and symbols, in such manner as may deceive them by inducing or leading to the purchase of one thing for another. It is not necessary, therefore, to the exercise of judicial powers, that the plaintiff should have any other property in the name or mark used, as a mere name or mark, than that possessed by any other person.²² Thus, no one can claim that he has any property in any word or mark, as such. Every person has an equal right to the mere use of words or marks. But it is the right to use words or marks in a specific manner, or for a specific purpose, that may be exclusively claimed, and, under proper conditions, enforced.

§ 11. Adoption of trade-mark gives no exclusive right to production of article.

The adoption of a trade-mark to indicate the manufacture or origin of a certain article does not give any right to the exclusive production of the article so marked. An article of manufacture, unless it be protected by a patent, may be made or sold by any person. Any person who possesses the requisite skill may copy or imitate any unpatented article. There is no such thing as an exclusive right to any particular branch of industry. The only restriction is that each party shall stand upon his own merits, and none shall be permitted, by the use of marks or symbols, to pretend that the goods offered by him are the products of another.²³

²² *Matsell v. Flanagan* (1867) 2 Abb. Pr. (N. S.; N. Y.) 459; *Reviewed Electro-Silicon Co. v. Hazard* (1883) 29 Hun (N. Y.) 374.

²³ *Phalon v. Wright* (1864) 5 Phila. (Pa.) 464; *Godillot v. Hazard* (1875) 49 How. Pr. (N. Y.) 5, affirmed (1879) 44 N. Y. Super. Ct. 427; *Powell v. Birmingham Vinegar Brewery Co.* (1896) 65 Law J.

§ 12. Proprietor has valuable interest in goodwill of his trade or business.

In trade-mark cases, the question is not whether the complainant was the original inventor or proprietor of the article made by him, and upon which he now puts his trade-mark, nor whether the article made and sold under his trade-mark by the defendant is equal to his own in quality or value. But the court proceeds on the ground that the complainant has a valuable interest in the goodwill of his trade or business, and, having appropriated to himself a particular trade-mark, indicating to his customers that the article is made or sold by him or by his authority, he is entitled to protection against one who attempts to pirate upon the goodwill of his friends or customers, or the patrons of his trade or business, by using such trade-mark without his consent or authority.²⁴ It is to protect this right of one's selling his own that the law of trade-marks has been introduced. The right must include the privilege of selling to all,—to the incautious as well as to the cautious.²⁵

§ 13. Protection of trade-marks promotes honesty and fair dealing.

The protection of trade-marks is therefore among the highest incentives to ingenuity, exertion, and fidelity, and one of the greatest securities to the public against imposition,²⁶ and the ground upon which equity proceeds is the promotion of honesty and fair dealing. No one has a right to sell his own goods as the goods of another.²⁷

Ch. Div. 563; *Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutilier* (1893) 24 N. Y. Supp. 890, 5 Misc. Rep. 78.

²⁴ *Partridge v. Menck* (1847) 2 Sandf. Ch. (N. Y.) 622, 2 Barb. Ch. (N. Y.) 101.

²⁵ *Brooklyn White Lead Co. v. Masury* (1857) 25 Barb. (N. Y.) 416.

²⁶ *Taylor v. Carpenter* (1846) 2 Sandf. Ch. (N. Y.) 603.

²⁷ *Palmer v. Harris* (1869) 60 Pa. 156.

§ 14. Earliest trade-mark case.

The earliest trade-mark case of which there is any record appears to have been decided during the reign of Queen Elizabeth (1590), and, while there is no report of the case, it was cited by Doderidge, Justice, in the case of *Southern v. How*.²⁸ In one report of this case the reference is as follows: "Doderidge cited a case to be adjudged (33 Eliz.) in the common pleas: A clothier of Gloucestershire sold very good cloth, so that, in London, if they saw any cloth of his mark, they would buy it without searching thereof, and another, who made ill cloth, put his mark upon it without his privity, and an action upon the case was brought by him who bought the cloth for this deceit, and adjudged maintainable." In another report of *Southern v. How*,²⁹ the reference to this case is as follows: "Doderidge said that (22 Eliz.) an action upon the case was brought in the common pleas by a clothier; that, whereas he had gained great reputation for his making of his cloth, by reason whereof he had great utterance to his great benefit and profit, and that he used to set his mark to his cloth, whereby it should be known to be his cloth, and another clothier, perceiving it, used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie." According to the first report of this case, the action was brought by the defrauded purchaser, and the action was, therefore, an ordinary action of deceit. According to the other report, the action was brought by the owner of the mark, and, if this is correct, this was undoubtedly the first action for the infringement of a trade-mark.³⁰

²⁸ Cro. Jac. 471.

²⁹ Popham, 144.

³⁰ Kerly, Trade-Marks, p. 2.

The following appears in a note to *Crawshay v. Thompson* (1842)

§ 15. Development of English trade-mark law.

The English trade-mark law is a development of the nineteenth century, and has been said to afford an interesting illustration of the process by which a few principles, at first doubtful and disputed, may be expanded into a complete system of jurisprudence.³¹ Reference to a few of the earlier cases will be of interest:

In *Blanchard v. Hill*,³² a motion was made on behalf of the plaintiff for an injunction to restrain the defendant from making use of the Great Mogul as a stamp upon his cards, to the prejudice of the plaintiff, upon the suggestion that the plaintiff had the sole right to this stamp, having appropriated it to himself, conformable to the charter granted to the Card-Makers' Company by King Charles I. Lord Chancellor Hardwicke denied the injunction. A part of the decision is as follows: "In the first place, the motion is to restrain the defendant from making cards with the same mark which the plaintiff has appropriated to himself, and, in this respect,

4 Man. & G. 386: "In *Popham*, this decision is said to have taken place in 22 Eliz., and in *Cro. Jac.* in 33 Eliz., but it is clearly the same case. In *Com. Dig.*, 'Action on the Case for Deceit' (A9), the case is thus referred to: 'So (i. e., an action will lie), if a clothier sell bad cloths, upon which he put the mark of another who made good cloths.' *Comyns* does not say by whom the action may be maintained, but, as he cites from *Cro. Jac.* only, it may be inferred that he considered the case as establishing the right of action in the purchaser, which it certainly would, supposing that report to be accurate. The report in *Popham* would appear more likely to be a true version of *Doderidge's* statement, since the case, as represented by *Croke*, would not have been very apposite to that of *Southern v. How*, in which it was cited by the learned judge. Lord Rolle, however, expressly states that *Doderidge* did not say whether the former action was brought by the clothier or by the vendee, but adds, 'Semble que gist pur le vendee.' 2 Rolle, Rep. 28."

³¹ *Browne, Trade-Marks*, p. 19.

³² (1742) 2 Atk. 484.

there is no foundation for this court to grant such an injunction. Every particular trader has some particular mark or stamp; but I do not know any instance of granting an injunction here to restrain one trader from using the same mark with another, and I think it would be of mischievous consequence to do it. Mr. Attorney General has mentioned a case where an action at law was brought by a cloth worker against another of the same trade for using the same mark, and a judgment was given that the action would lie. Popham, 151. But it was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away customers from the other clothier. And there is no difference between a tradesman's putting up the same sign and making use of the same mark with another of the same trade. * * * An objection has been made that the defendant, in using this mark, prejudices the plaintiff by taking away his customers; but there is no more weight in this than there would be in an objection to one innkeeper setting up the same sign with another. * * * Upon the whole, there are no grounds in this case to grant an injunction against the defendant till the hearing of the cause."

In *Singleton v. Bolton*,³³ Lord Mansfield, discharging a rule for a new trial in a case in which the plaintiff was nonsuited, said "that, if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie."

In *Hogg v. Kirby*,³⁴ Lord Chancellor Eldon granted an injunction to restrain publishing a magazine, as a continuance of the plaintiff's magazine, in numbers. The injunc-

³³ (1783) 3 Doug. 293.

³⁴ (1803) 8 Ves. 215.

tion did not prevent the publication of an original work of the same nature and under a similar title. The injunction was granted to restrain the defendant from publishing a work under a fraudulent representation that such work was that of the plaintiff, and was really to restrain what, at the present time, would be designated as unfair competition. This clearly appears from the following statement in the opinion: "In this case, protesting against the argument that a man is not at liberty to do anything which can affect the sale of another work of this kind, and that, because the sale is affected, therefore there is an injury (for, if there is a fair competition by another original work, really new, be the loss what it may, there is no damage or injury), I shall state the question to be, not whether this work is the same, but, in a question between these parties, whether the defendant has not represented it to be the same, and whether the injury to the plaintiff is not as great, and the loss accruing ought not to be regarded in equity upon the same principles between them, as if it was in fact the same work."

In 1813, a demurrer to a bill in equity was allowed by Vice-Chancellor Plumer with the following statement: "The violation of right with which the defendant is charged does not fall within the cases in which the court has restrained a fraudulent attempt by one man to invade another's property; to appropriate the benefit of a valuable interest, in the nature of goodwill, consisting in the character of his trade or production, established by individual merit, the other representing himself to be the same person, and his trade or production the same, as in *Hogg v. Kirby*, combining imposition on the public with injury to the individual."³⁵

In 1816, an injunction was granted to restrain a manufacturer from using, upon blacking, labels in imitation of

³⁵ *Canham v. Jones* (1813) 2 Ves. & B. 218.

those employed by the plaintiff.³⁶ This has been said to be the earliest reported case in which the infringement of a trade-mark was restrained. The first reported case for the infringement of trade-marks in the common-law courts is *Sykes v. Sykes*,³⁷ in 1824. In this case, the declaration stated that the plaintiff was a manufacturer of shot belts and powder flasks, which he was accustomed to mark with the words "Sykes' Patent," and that the defendants made shot belts and powder flasks which they also marked "Sykes' Patent," in imitation of the marks used by the plaintiff, and sold the articles so made and marked as and for shot belts and powder flasks of the manufacture of the plaintiff. At the trial, before Mr. Justice Bayley, it appeared that the plaintiff's father obtained a patent for the manufacture of the articles in question, which patent, however, had been held to be invalid, in consequence of a defect in the specification, but that the patentee, and afterwards the plaintiff, continued to mark the articles with the words "Sykes' Patent." It appeared, also, that the mark used by the defendant resembled, as nearly as possible, that adopted by the plaintiff. Mr. Justice Bayley held that the defendant had no right so to mark his goods, as and for goods manufactured by the plaintiff, and he left it to the jury to say whether the defendants adopted the mark in question for the purpose of inducing the public to suppose that the articles were manufactured, not by them, but by the plaintiff. The jury found a verdict for the plaintiff. Upon motion for a new trial, Abbott, C. J., delivered the judgment of the court, and said: "I think that the substance of the declaration was proved. It was established most clearly that the defendants marked

³⁶ *Day v. Day* (1816) Eden, Inj. (1st Am. Ed.) 226; Cod. Dig. 138.

³⁷ (1824) 3 Barn. & C. 541, 3 Law J. K. B. (O. S.) 46.

the goods manufactured by them with the words 'Sykes' Patent' in order to denote that they were of the genuine manufacture of the plaintiff; and although they did not themselves sell them as goods of the plaintiff's manufacture, yet they sold them to retail dealers for the express purpose of being resold as goods of the plaintiff's manufacture. I think that is substantially the same thing, and that we ought not to disturb the verdict."

In *Blofeld v. Payne*³⁸ it was held, in a case in the court of king's bench, that it was unnecessary for a plaintiff, in an action for damages at common law, to prove that the goods sold by the infringer were inferior to those manufactured and sold by the plaintiff to which the mark in controversy was applied, or to prove any special damage resulting from the defendant's acts.

In 1838 came the important case of *Millington v. Fox*,³⁹ in which it was held by Lord Cottenham that a court of equity will grant a perpetual injunction against the use, by one tradesman, of the trade-mark of another, although such marks have been so used in ignorance of their being any person's property, and under the belief that they were merely technical terms. It has been said that this was the first case in which an English court held that the owner of a trade-mark was entitled to injunction against the use of a mark by those who used it without fraudulent intent,—in other words, recognized the right to the exclusive use of a trade-mark as a property right.⁴⁰ The growth of commerce and increase in the facilities of communication and transportation had widened the markets of all manufacturers, and it became necessary for the courts to protect the manufacturers

³⁸ (1833) 4 Barn. & Adol. 410, 2 Law J. K. B. 68.

³⁹ (1838) 3 Mylne & C. 338.

⁴⁰ Greeley, Report to Revise Patent and Trade-Mark Laws (1900).

and dealers in the use of their marks, and also to protect the purchasing public from imposition and fraud. The rule that a trade-mark is property was not, however, finally established by the case of *Millington v. Fox*, and, as late as 1857, Vice-Chancellor Sir W. Page Wood said: "It is now settled law that there is no property whatever in a trade-mark, but that a person may acquire a right of using a particular trade-mark for articles which he has manufactured, so that he may be able to prevent any other person from using it, because the mark denotes that articles so marked were manufactured by a certain person."⁴¹ The jurisdiction of the courts to grant relief in trade-mark cases is now held not to rest alone on fraud, but upon property in the trade-mark, and upon the fact that an injunction is the only mode of protecting it. The earlier cases, to the effect that there is no property in a trade-mark, must be deemed in that respect overruled.⁴²

§ 16. Development of American trade-mark law.

The earliest reported case in the United States relating to the subject of trade-marks is that of *Thomson v. Winchester*,⁴³ in the supreme court of Massachusetts, in which the opinion is by Chief Justice Shaw. In this case it was held that, if the defendant made and prepared medicines, calling them "Thomsonian Medicines," and sold them, or placed them in the hands of others to sell, as and for the medicines made and prepared by the plaintiff, so that persons purchasing the same supposed and believed that they were purchasing the medicines made and prepared by the plaintiff, it was a fraud upon the plaintiff, and an injury to his rights, for

⁴¹ *Collins Co. v. Brown* (1857) 3 Kay & J. 426.

⁴² *Perry v. Truefitt* (1842) 6 Beav. 66; *Corwin v. Daly* (1860) 7 Bosw. (N. Y.) 222.

⁴³ (1837) 19 Pick. (Mass.) 214.

which the law will presume some damages. It was further held, however, "that, without obtaining a patent, the plaintiff had no exclusive right or privilege to compound or vend the medicines called 'Thomsonian,' although he was the original inventor, and that he had no more right than the plaintiff to make and vend these medicines, or to call them 'Thomsonian,' if this term had acquired a generic meaning descriptive of a general kind, quality, and class of medicines, as, for instance, James' powders or Turlington's balsam, and if they were not sold to consumers, or consigned or sold to others, to be sold to consumers, as and for medicines made and prepared by the plaintiff."

The earliest case to come before a federal court was that of *Taylor v. Carpenter*,⁴⁴ which was decided by Justice Story in 1844. In this case it appeared that the plaintiffs were manufacturers in England of "Taylor's Persian Thread," and the defendant, in America, imitated their names, trademarks, envelopes, and labels, and placed them on thread of a different manufacture. It was held that it was a fraudulent infringement by the defendant of the rights of the plaintiffs, for which equity would grant relief, and that it was immaterial whether other persons had or had not done the same. The learned justice said: "I have not the slightest doubt, in the present case, that a perpetual injunction ought to be granted. The case presented is one of unmitigated and designed infringement of the rights of the plaintiffs, for the purpose of defrauding the public, and taking from the plaintiffs the fair earnings of their skill, labor and enterprise."

In 1857, the case of *Clark v. Clark*⁴⁵ was decided by the

⁴⁴ (1844) 3 Story, 458, Fed. Cas. No. 13,784. See, also, *Taylor v. Carpenter* (1844) 11 Paige (N. Y.) 292.

⁴⁵ (1857) 25 Barb. (N. Y.) 76.

supreme court of New York. The trade-mark involved was used upon spool cotton, and an injunction was granted, although defendants were not prohibited from using their own name, the court saying: "Both parties deal in spool cotton, and, as both are of the same name, each is entitled to have his called by the name of 'Clark's Spool Cotton.'" The court further said: "The law of trade-marks is of recent origin, and may be comprehended in the proposition that a dealer 'has a property in his trade-mark.' The ownership is allowed to him that he may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public as his that which is not his. An imitation of his mark, with partial differences, such as the public would not observe, does him the same harm as an entire counterfeit. If the wholesale buyer, who is most conversant with the marks, is not misled, but the small retailer or consumer is, the injury is the same in law, and differs only in degree. The right of action must exist for the last as well as the first. If all consumers do not discriminate in the end, it would be indifferent, even to the wholesale buyers, from which of the two they bought, and thus the extent, also, of the injury would be as great as if they also were deceived. It would follow that the defendants in this case should be enjoined from using the mark which they now use, and from any imitation of it with only colorable differences; but the injunction should not be as broad as it was originally granted. It should be so expressed that the defendants might distinctly understand what is prohibited. Their firm name is J. & J. Clark & Co. They manufacture six-cord cabled thread. They have George Clark as their agent in New York. All this they may express, as well as the number of their thread; but they should express it so as not to appear to imitate the plaintiffs."

These cases, at the present day, would all be considered as cases of unfair competition, as no one of them involved any technical trade-mark. The term "Taylor's Persian Thread" might, possibly, be considered a technical trade-mark, but as the defendant had imitated not only the name, but the envelopes and labels as well, the question as to whether these words constituted a technical trade-mark did not arise.

In *Phalon v. Wright*,⁴⁶ decided by the court of common pleas of Philadelphia in 1864, a very clear statement of the main principles of trade-mark law is found. The court said: "It is somewhat strange that, in the state of Pennsylvania, whose people are so largely engaged in manufactures, the subject of 'trade-marks' should not have been more frequently presented to our courts for decision. The case of *Colladay v. Baird*, reported in 4 Phila. (Pa.) 139, decided in this court, in which my Brother Ludlow delivered an elaborate and well-considered opinion, seems to be the only reported decision in this state upon the subject. In New York the subject of trade-marks has been frequently presented for judicial consideration, and in the decisions of the courts of that state and of the English tribunals, with one or two from other states, we find the sources of the information required for the investigation of the case before us. It is well settled that a court of equity will exercise its powers for the protection of the owner of a trade-mark in the exclusive enjoyment of that device or symbol chosen by him to designate his goods or manufactures, and to distinguish them from those of others. Every man has a right to the products of his own labor, and is entitled so to distinguish them that persons dealing in or purchasing his commodities may be readily able to recognize them as his. The maker may therefore, either

⁴⁶ (1864) 5 Phila. (Pa.) 464.

with or without the use of his name, adopt a word, title, symbol, or figure to designate the ownership or manufacture of the goods. In the use of such 'trade-mark' he is to be protected from the efforts of others who would take advantage of his enterprise or skill, and, by imitation, endeavor to impose upon the public, and to deprive him of the just reward of his industry. The adoption of a trade-mark or device to indicate the manufacture or origin of a certain article does not give any right to the exclusive production of the article so marked. Any article of manufacture, unless it be protected by a patent, may be made and sold by any person. There is no such thing as an exclusive right to any particular branch of industry. The only restriction is that each party shall stand upon his own merits, and none shall be permitted, by the use of marks or symbols, to pretend that the goods offered by him are the products of another. *Perry v. Truefitt*, 6 Beav. 72; *Coffeen v. Brunton*, 4 McLean, 516 [Fed. Cas. No. 2,946]. This rule has even been applied to cases where there was no intentional deception; as where the manufacturer of steel was prohibited from stamping upon his manufacture certain words which he supposed were descriptive of a particular quality of steel, but which were, in fact, the name of the original manufacturer, and indicated his ownership. *Millington v. Fox*, 3 Mylne & C. 338. The 'trade-mark,' to be capable of an exclusive use, must be such as will identify the article to which it is affixed as that of the person naming it, and distinguish it from others. A word which is the name of the article, or indicates its quality, cannot be so appropriated. Every one has the right to manufacture the same article, and to call it by its name or descriptive character. In doing so there is no violation of propriety or of truth,—nothing which intrudes upon the distinctive province of others. *Singleton v. Bolton*, 3 Doug.

293; *Canham v. Jones*, 2 Ves. & B. 218; *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. (N. Y.) 599; *Stokes v. Landgraff*, 17 Barb. (N. Y.) 608. Were it otherwise, monopolies might be created which would be destructive of the freedom of trade, and restrictive of the free exercise of talent.”

In *Joseph Dixon Crucible Co. v. Guggenheim*,⁴⁷ decided in 1869, Judge Paxson, referring to the growth of the trade-mark law, said: “There is no doubt but that property in trade-marks has been recognized for a long time by the profession and by the court, but it has only been within a comparatively short time that its importance has come to be fully understood. In a rude age, when manufactures were few, and those of only useful and indispensable articles, trade-marks were but little known, and seldom, if ever, violated. It was when wealth and luxury increased, and manufactures multiplied accordingly, that the use and value of a trade-mark became distinctly recognized. In the present age, with the vast extension of the manufacturing interest, the law upon this subject is, of necessity, frequently invoked, and it is settling down into a consistent theory.”

§ 17. Right to use a trade-mark is property.

Upon whatever idea the courts proceeded, as soon as their decisions established in a particular individual a right, exclusive as against the world, to use a particular label or mark whereby trade was attracted to him, that right at once became a thing of value, and hence property, in a sense more strict than that in which many other incorporeal rights, such as the elective franchise or the right of presentation to a vacant benefice, have been regarded as property. Moreover, the courts of chancery were appealed to, successfully, to enjoin the infringement of trade-marks in cases where no

⁴⁷ (1869) 2 Brewst. (Pa.) 326.

fraud was intended, and where the relief could hence be granted only on the idea of property in the user of the mark. Accordingly, it has become a settled doctrine of the English and American courts that trade-marks are protected, not exclusively on the ground of fraud, but also on the ground of property. 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 property, capable of being bought and sold, and for the invasion of which an action for damages will lie, and the exclusive use of which will be protected, when necessary, by injunction.⁴⁸

§ 18. No abstract property right in a trade-mark.

While the exclusive right to use a trade-mark is property,

⁴⁸ Godillot v. Hazard (1875) 49 How. Pr. (N. Y.) 5; Avery v. Meikle (1883) 81 Ky. 73; Skinner v. Oakes (1881) 10 Mo. App. 45; Cigar-Makers' Protective Union v. Conhaim (1889) 40 Minn. 243, 3 L. R. A. 125; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Peltz v. Eichele (1876) 62 Mo. 171; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Filley v. Fassett (1869) 44 Mo. 168, 177; Glen & Hall Mfg. Co. v. Hall (1874) 61 N. Y. 226; Gilman v. Hunnewell (1877) 122 Mass. 139; Maxwell v. Hogg (1867) 2 Ch. App. 307, 314; Hall v. Barrows (1863) 4 De Gex, J. & S. 150, 158; Bury v. Bedford (1864) 33 Law J. Ch. 465, 4 De Gex, J. & S. 352; Canal Co. v. Clark (1871) 13 Wall. (U. S.) 311; Trade-Mark Cases (1879) 100 U. S. 82; Kidd v. Johnson (1879) 100 U. S. 617; Manhattan Medicine Co. v. Wood (1883) 108 U. S. 218; Lawrence Mfg. Co. v. Tennessee Mfg. Co. (1891) 138 U. S. 537; Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169; Mrs. G. B. Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; Bradley v. Norton (1865) 33 Conn. 157; Stonebraker v. Stonebraker (1870) 33 Md. 252; Clark v. Clark (1857) 25 Barb. (N. Y.) 76; Schneider v. Williams (1888) 44 N. J. Eq. 391; Leather Cloth Co. v. American Leather Cloth Co. (1863) 4 De Gex, J. & S. 137, 141; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Handy v. Commander (1897) 49 La. Ann. 1119; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1890) 20 N. Y. Supp. 462; Prince Mfg. Co. v. Prince's Metallic Paint Co. (1892) 135 N. Y. 24; Electro Silicon Co. v. Hazard (1883) 29 Hun (N. Y.) 369; Laughman's Appeal (1889) 128 Pa. 1.

there is no abstract property right in a trade-mark. It is property only when appropriated and used to indicate the origin or ownership of a commercial article.⁴⁹ The trade-mark has no separate, abstract existence, but is appurtenant to the goods designated.⁵⁰ It does not partake of the character or nature of a patent or copyright.⁵¹ The owner's right of property in the use of the trade-mark is as complete as that which he possesses in the goods to which he attaches it, and the law protects him in the enjoyment of the one as fully as of the other.⁵² The real value of the trade-mark consists in the confidence and patronage of the public, secured through its instrumentality in acquainting them with the origin of an article, which thus gains reputation for its superior qualities. Of this reputation its owner cannot be deprived, without his consent, either by use of forbidden means, or the illegal employment of things otherwise lawful.⁵³ The property really consists in the exclusive right of a manufacturer or vendor to sell his products or goods as his own, and in being protected in the exercise of that right by the exclusion of all others from its enjoyment, either by selling theirs for his, or causing others to do so.⁵⁴ The credit and reputation a person acquires by his care or skill

⁴⁹ *Cigar Makers' Protective Union v. Conhaim* (1889) 40 Minn. 243, 3 L. R. A. 125; *Avery v. Meikle* (1883) 81 Ky. 73; *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 N. Y. 291; *Dixon Crucible Co. v. Guggenheim* (1869) 2 Brewst. (Pa.) 321; *McVeagh v. Valencia Cigar Factory* (1885) 32 Official Gazette, 1124; *Price & S. Am. Trade-Mark Cas.* 970; *Chadwick v. Covell* (1890) 151 Mass. 190.

⁵⁰ *Derringer v. Plate* (1865) 29 Cal. 292.

⁵¹ *Taylor v. Carpenter* (1846) 2 Sandf. Ch. (N. Y.) 603; *Royal Baking Powder Co. v. Raymond* (1895) 70 Fed. 376.

⁵² *Derringer v. Plate* (1865) 29 Cal. 292.

⁵³ *Avery v. Meikle* (1883) 81 Ky. 73.

⁵⁴ *Avery v. Meikle* (1883) 81 Ky. 73.

in the manufacture of a particular article is a species of property which the law recognizes and protects; and when an article, not of his manufacture, is sold with the mark or symbol affixed which he has devised to designate his own goods, an injury results to him in the effect upon the reputation of his goods, provided the article so sold is inferior thereto, and in the diminution of the demand for his goods, in case such article is equal or superior in quality.⁵⁵

§ 19. Principle upon which courts of equity proceed.

Courts of equity proceed on the principle of protecting property and the promotion of honesty and fair dealing. The protection of the public alone is not sufficient for the jurisdiction. However, it is an element that enters, and ought to enter, into every case.⁵⁶ Where a manufacturer has, by skill, care, and fidelity, manufactured a good article, it becomes of the utmost importance to him that its origin and ownership should be known, and the law points out to him what means he may adopt, and how he may appropriate them, to indicate this important fact; and when he adopts and uses them, and his reputation is thereby built up, it is to him the most valuable of property rights. Sound policy, which dictates the protection of the public from imposition, the security of the fruits of labor to the laborer, the encouragement of skillful industry, and, above everything, the inculcation of truth and honor in the conduct of trade and commerce, and the requirement that all the contractual relations of life, natural, abstract, and relative, shall be honestly observed, demands that such a reputation so gained be accorded the safest and best remedy for redress known to the courts of equity.⁵⁷

⁵⁵ *Lemoine v. Gauton* (1854) 2 E. D. Smith (N. Y.) 343.

⁵⁶ *Avery v. Meikle* (1883) 81 Ky. 73; *Weener v. Brayton* (1890) 152 Mass. 101, 8 L. R. A. 640.

⁵⁷ *Avery v. Meikle* (1883) 81 Ky. 73.

Where the trade-mark itself, in whole or in part, has been appropriated, it is not necessary to a recovery in equity to prove fraud or an inferior quality of the article of the defendant. This principle is based on the ground that a trade-mark, when in use, is property itself.⁵⁸ It was the deficiency in the remedy at law that caused the courts of equity to take jurisdiction of this class of cases, and extend protection to this great right of property, in whose exercise the public are deeply interested, and in whose maintenance the commercial honor and trade integrity of the state are profoundly concerned.⁵⁹ It is apparent that the right to a trade-mark is one which can be tested only by its violation. So long as no one imitates the trade-mark, the proprietor has no means of testing its validity. It is only when a supposed piracy occurs that the questions of the validity of the trade-mark and the proprietor's exclusive right thereto can be determined. The right to a trade-mark is one which any person designating his wares and commodities by it has to prevent others from selling wares which are not his, but are marked with his mark.⁶⁰

§ 20. Trade-mark of common-law origin.

The right of property in a trade-mark, being recognized by the common law, does not in any manner depend for its inceptive existence or support upon statutory law, although its exercise may be limited or controlled by statute. The right to adopt or use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been

⁵⁸ *Edelsten v. Edelsten* (1863) 1 De Gex, J. & S. 185; *Avery v. Meikle* (1883) 81 Ky. 73; *Miller Tobacco Manufactory v. Commerce* (1883) 45 N. J. Law 18.

⁵⁹ *Avery v. Meikle* (1883) 81 Ky. 72.

⁶⁰ *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314.

long recognized by the common-law and the chancery courts of England and of this country, and by the statutes of some of the states. 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 past infringement. This exclusive right was not conferred by act of congress, and does not now depend upon statutes for its enforcement. The whole system of trade-mark property, and the civil remedies for its protection, existed long prior to any legislation by congress, and have remained in full force since such legislation.⁶¹ Being a common-law right, it is limited only by the period of its use.⁶² The right of property in a trade-mark is not limited in its enjoyment by territorial bounds, but may be asserted and maintained wherever the common law affords remedies for wrongs, subject only to such statutory regulations as may properly be made concerning the use and enjoyment of other property.⁶³ By the common law, every manufacturer, and every merchant for whom goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the markets for which he intends them, that he may thus secure the profits their superior repute as his may be the means of gaining.⁶⁴

⁶¹ *Derringer v. Plate* (1865) 29 Cal. 292; *Trade-Mark Cases* (1879) 100 U. S. 82; *Reeder v. Brodt* (1897) 6 Ohio Com. Pl. & Super. Dec. 248; *Chadwick v. Covell* (1890) 151 Mass. 190.

⁶² *Leidersdorf v. Flint* (1878) 8 Biss. 327, Fed. Cas. No. 8,219.

⁶³ *Derringer v. Plate* (1865) 29 Cal. 292; *Leidersdorf v. Flint* (1878) 8 Biss. 327, Fed. Cas. No. 8,219; *Bush v. Hanson* (1888) 2 Can. Exch. 557; *Kidd v. Johnson* (1879) 100 U. S. 617.

⁶⁴ *Smith v. Walker* (1885) 57 Mich. 156.

§ 21. Statutory registration may limit common-law trade-mark.

While the trade-mark does not owe its origin to statutes, and exists entirely independent thereof, and infringements thereof may be redressed as a common-law right, it has been held, in a suit to restrain infringement of a common-law trade-mark, that the registry of the trade-mark under the act of congress of March 3, 1881, may be evidence to show what the complainant really claimed as his trade-mark,⁶⁵ and the time when use began,⁶⁶ and whether the trade-mark was personal, and hence whether it passed by insolvency proceedings.⁶⁷

§ 22. Distinction between cases involving trade-marks, trade-names, and unfair competition.

It will be seen from the foregoing sections defining trade-marks, and pointing out their office and characteristics, that there are many things that have been loosely called "trade-marks" by the courts that are not properly so designated, and in many instances the courts have properly granted injunctions where no technical trade-marks were involved. A manufacturer or vendor may have no trade-mark, and yet may be entitled to restrain another from imitating the form, color, or general appearance of his labels, packages, or articles, the manner of arranging the directions, or other *indicia* thereon, or from in any way dressing up goods so as to cause them to be mistaken for his, or from resorting to any trick or artifice whereby another's goods are palmed off on

⁶⁵ Richter v. Reynolds (1893) 59 Fed. 577. See, also, Kohler Mfg. Co. v. Beeshore (1892) 53 Fed. 262.

⁶⁶ Kohler Mfg. Co. v. Beeshore (1893) 8 C. C. A. 215, 59 Fed. 572; Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444.

⁶⁷ Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 35 C. C. A. 496, 93 Fed. 624.

the public as his. Cases of this kind are not strictly trade-mark cases, and do not involve strict trade-mark rights.⁶⁸ They are cases of unfair competition in trade, and, being analogous to trade-mark cases, are treated under a separate chapter of this work.⁶⁹ Other analogous cases involve the names of places of business, or the names of individuals, firms, or corporations, not applied to commercial articles. These also are not strictly trade-mark cases, and they are treated under the chapter on trade-names. No sharp or distinct line can be drawn between these three classes of cases, and the facts and circumstances belonging to all may be found mingled in a single cause of action. The following may, however, be laid down as characteristics of a technical trade-mark: First, it must point distinctively, either by its own meaning or by association, to the origin or ownership of the article to which it is affixed; second, it must be affixed or applied to a commercial article; third, it must be of such nature that it can be rightfully appropriated by one person, to the exclusion of all others.⁷⁰ In many instances, the courts have restrained the use of words, marks, or devices not falling under these heads. In those instances, however, the complainant did not have a technical trade-mark, but the injunction issued for the purpose of restraining unfair or fraudulent competition, and such competition must have been shown in order to entitle the complainant to the injunction. Relief in such cases is granted only where the defendant, by his marks, signs, labels, or in other ways, rep-

⁶⁸ *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1888) 128 U. S. 598; *McLean v. Fleming* (1877) 96 U. S. 245; *Sawyer v. Horn* (1880) 4 Hughes, 239, 1 Fed. 24; *Perry v. Truefitt* (1842) 6 Beav. 66; *Croft v. Day* (1843) 7 Beav. 84; *Singer Mfg. Co. v. June Mfg. Co.* (1896) 163 U. S. 169.

⁶⁹ See chapter 10.

⁷⁰ *Weener v. Brayton* (1890) 152 Mass. 101; *Schneider v. Williams* (1888) 44 N. J. Eq. 391.

resents 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 manufacture, to the injury of the plaintiff.⁷¹ But where a technical trade-mark right is involved, it is unnecessary to show fraud on the part of the defendant, or that he even knew of the complainant's trade-mark.⁷²

§ 23. Underlying principle of cases involving trade-marks and unfair competition the same.

The underlying principle of cases of technical trade-marks and unfair competition is the same, namely, the prevention of that which, in its operation and results, and usually in intention, is a fraud upon the public, and an injury to the rival trader.⁷³ In *Delaware & H. Canal Co. v. Clark*, the United States supreme court said: "This will be manifest when it is considered that, in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief. This is the doctrine of all the authorities."⁷⁴ Fraud which lies at the foundation of the law of

⁷¹ *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1883) 128 U. S. 598.

⁷² *McLean v. Fleming* (1877) 96 U. S. 245; *Electro-Silicon Co. v. Hazard* (1883) 29 Hun (N. Y.) 369; *Cady v. Schultz* (1895) 19 R. I. 193; *Miller Tobacco Manufactory v. Commerce* (1883) 45 N. J. Law, 18; *State v. Berlinsheimer* (1895) 62 Mo. App. 168; *Edelsten v. Edelsten* (1863) 1 De Gex, J. & S. 185; *Avery v. Meikle* (1883) 81 Ky. 73; *Messerole v. Tymberg* (1868) 4 Abb. Pr. (N. S.; N. Y.) 410; *Reviewed Electro-Silicon Co. v. Hazard* (1883) 29 Hun (N. Y.) 374.

⁷³ *Church v. Russ* (1900) 99 Fed. 276.

⁷⁴ (1871) 13 Wall. (U. S.) 311-322.

trade-marks, as well as the law of unfair competition, 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 cases of unfair competition, the fraudulent intent must be shown by the evidence, or be inferable from the circumstances, while, in trade-mark cases, fraud will be presumed. If one person use another's trade-mark in connection with similar goods, 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. In strict trade-mark cases, a fraudulent intent to injure the complainant, or an actual misleading of the public, need not be proved, as it will be presumed. As said by the supreme court in a leading case: "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. If the absolute right belonged to the plaintiff, then, if an infringement were clearly shown, the fraudulent intent would be inferred, and, if allowed to be rebutted in exemption of damages, the further violation of the right of property would nevertheless be restrained."⁷⁵

§ 24. Comparison between cases of trade-marks and unfair competition.

In the case of *C. F. Simmons Medicine Co. v. Mansfield Drug Co.*⁷⁶ the supreme court of Tennessee has discussed these two classes of cases as follows: "It is only within recent years that a distinction has been taken in the authorities between this class of controversies (unfair com-

⁷⁵ *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537-548.

⁷⁶ (1893) 93 Tenn. 84, 23 S. W. 165.

petition) and technical trade-mark cases. In the earlier reported decisions, infringements of trade-marks and simulations of labels and packages are all intermingled under the general designation of 'trade-marks,' or treated as in substance the same thing, if not the same in exact definition. Latterly, however, especially in this country, the tendency has been to a narrowing of the use of the term 'trade-mark' to its proper signification, as an arbitrary symbol affixed by a manufacturer or merchant to a vendible commodity, and to exclude from use as such symbol words merely descriptive or generic, or merely expressive of quality, and also to exclude from designation as such labels, advertisements, signs, and the form, size, and general appearance of packages of merchandise. The new classification, while useful, seems to lack something of logical accuracy, inasmuch as the imitation of another's trade-mark, if intentional, and done with the purpose of pirating his trade thereby, is as truly an instance of unfair competition in business as any other fraudulent device adopted for that purpose, so that the effect is, in the main, only the attainment of a more correct and accurate use of the term 'trade-mark,' while the cases falling under the new classification are subject to most of the principles that govern technical trade-marks, but not to all. Moreover, the principles that are common to trade-mark law as thus narrowed, and to the subject of unfair competition in business, are also applicable to competition in other kinds of business besides the sale of articles of merchandise, leaving, however, a residuum of peculiar rules applicable only to technical trade-marks. The correspondences between the two classes of cases are more numerous than their differences. As in cases of trade-mark, so in cases of unfair competition in business, imposition upon the public is a necessary constituent of the plaintiff's title to sue, but only in the fact that

it is the test of the invasion of the plaintiff's rights by the defendant. As in one, so in the other, the object and purpose of the law is, first, to secure to him who has been instrumental in bringing into market a superior article of merchandise the fruit of his industry and skill, and, secondly, to protect the community from imposition. As in one, so in the other, the underlying principle is that one man is not to sell his own goods under pretense that they are the goods of another; and, as in one, so in the other, the violator of another's rights pirates upon the goodwill of that other's friends and customers, or the patrons of his trade and business, by sailing under his flag without his authority or consent. There is this difference, however: the law of trade-marks is designed to protect primarily a property right, and, as incidental thereto, gives redress for the injuries resulting from invasions of that right, a distinct, technical trade-mark being in itself evidence, when wrongfully used, of an illegal act, while the jurisdiction exercised over cases of unfair competition in business is grounded in the prevention of fraud. Fraudulent intention is not a necessary ingredient of a pure trade-mark case, as an invasion of another's trade-mark may be the result of accident or of a misunderstanding, although it may be and probably is true that in the majority of cases fraud is an element of trade-mark cases in awarding damages and costs."

CHAPTER II.

WHAT CAN BE APPROPRIATED.

- § 25. **General Rule.**
26. **Devices Held to be Trade-Marks.**
27. **Purpose for Which Mark Adopted may Determine Whether Valid Trade-Mark.**
28. **Test of Trade-Mark.**
29. **Trade-Mark may Secondarily Denote Grade or Quality.**
30. **Trade-Mark may Operate as Assurance of Quality.**
31. **Classes of Trade-Marks.**
32. **Characteristics of Local Trade-Marks.**
33. **Majority of Trade-Marks Impersonal.**
34. **Words in Common Use as Trade-Marks.**
35. **General Rule as to Common Words.**
36. **Instances of Common Words as Trade-Marks.**
37. **Application of Word to Article must be Arbitrary or Fanciful.**
38. **Word may be Valid Trade-Mark, Although Article has Acquired Wide Sale, and Mark Becomes Indicative of Quality.**
39. **Word may be Valid Trade-Mark, Although It has Become Ordinary Appellation of Article.**
40. **Trade-Mark may Consist of Common Words, Combined with Other Features.**
41. **Personal Names as Trade-Marks.**
42. **A Person cannot Make a Trade-Mark of His Own Name, and Debar Another, Having the Same Name, from Using It.**
43. **Second User may be Restrained When Fraud Appears.**
44. **Rule does not Apply to Corporations.**
45. **Personal Name Protected Only When It Truthfully Indicates Origin or Ownership.**
46. **Court of Equity will Direct and Control the Use of a Personal Name.**
47. **Instances of Personal Names as Parts of Trade-Marks.**
48. **Names of Places of Business as Trade-Marks.**
49. **Newly-Coined Words as Trade-Marks.**
50. **Instances of Coined Words as Trade-Marks.**

51. Fanciful Names and Phrases as Trade-Marks.
52. Letters as Trade-Marks.
53. Instances of Letters as Trade-Marks.
54. Numerals as Trade-Marks.
55. Instances of Numerals Held to be Valid Trade-Marks.
56. Pictures as Trade-Marks.
57. Instances of Pictures or Symbols as Trade-Marks.
58. Names of Newspapers and Periodicals as Trade-Marks.
59. Descriptive or Geographical Words that have Acquired Secondary Meanings.

§ 25. General rule.

A common-law trade-mark may consist, with certain limitations, of any mark, symbol, device, or word, or any combination thereof, that is affixed to a commercial article, and used to indicate, primarily, the origin or ownership of such article.¹ The essential requisite of a trade-mark is that it shall indicate the origin or ownership of the article to which it is applied. Anything that is distinctive and will do this, and which others may not use with equal truth, may be appropriated. With the proviso, therefore, that the mark must indicate origin or ownership, either by its own meaning or by association with the article to which it is applied, and that the mark is not one that others may use with equal truth, there are few limitations as to what may be adopted as a trade-mark.²

¹ See chapter 1, § 1; *Newman v. Alvord* (1867) 49 Barb. (N. Y.) 588; *Phalon v. Wright* (1864) 5 Phila. (Pa.) 464; *Derringer v. Plate* (1865) 29 Cal. 293; *Fulton v. Sellers* (1867) 4 Brewst. (Pa.) 42; *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314; *Filley v. Fassett* (1869) 44 Mo. 168; *Gillott v. Esterbrook* (1872) 48 N. Y. 374; *Wolfe v. Barnett* (1872) 24 La. Ann. 97; *Godilott v. Hazard* (1875) 49 How. Pr. (N. Y.) 5; *Dunbar v. Glenn* (1877) 42 Wis. 118; *Helmbold v. Helmbold Mfg. Co.* (1877) 53 How. Pr. (N. Y.) 453; *Gilman v. Hunnewell* (1877) 122 Mass. 139.

² *Hegeman v. Hegeman* (1880) 8 Daly (N. Y.) 1; *Potter v. McPherson* (1880) 21 Hun (N. Y.) 559; *Hier v. Abrahams* (1880) 82

§ 26. Devices held to be trade-marks.

Thus it has been held that an octagonal, hollow, wooden stick, upon which carpets were rolled, so that the stick pre-

N. Y. 519; Morgan's Sons Co. v. Troxell (1881) 23 Hun (N. Y.) 632; Thornton v. Crowley (1881) 47 N. Y. Super. Ct. 527; Shaw Stocking Co. v. Mack (1882) 12 Fed. 707; Avery v. Meikle (1883) 81 Ky. 73; Smith v. Walker (1885) 57 Mich. 456; Leidersdorf v. Flint (1878) 8 Biss. 327, Fed. Cas. No. 8,219; McLean v. Fleming (1877) 96 U. S. 245; Kidd v. Johnson (1879) 100 U. S. 617; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523; Hall v. Barrows (1863) 33 Law J. Ch. 204, 4 De Gex, J. & S. 150; Ainsworth v. Walmsley (1866) L. R. 1 Eq. 518; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Russia Cement Co. v. Le Page (1888) 147 Mass. 206; Clinton Metallic Paint Co. v. New York Metallic Paint Co. (1898) 23 Misc. Rep. 66; The Solis Cigar Co. v. Pozo (1891) 16 Colo. 388; Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co. (1890) 104 Mo. 53; Parkland Hills Blue Lick Water Co. v. Hawkins (1894) 95 Ky. 502, 26 S. W. 389; Munro v. Smith (1890) 55 Hun (N. Y.) 419; Lafean v. Weeks (1896) 177 Pa. 412; Dr. Jaeger's Co. v. Le Boutillier (1893) 5 Misc. Rep. 78, 24 N. Y. Supp. 890; American Solid Leather Button Co. v. Anthony (1886) 15 K. I. 338; Metcalfe v. Brand (1887) 86 Ky. 331; Stokes v. Allen (1890) 56 Hun (N. Y.) 526.

"The 'trade-mark,' to be capable of an exclusive use, must be such as will identify the article to which it is affixed as that of the person naming it, and distinguish it from others." Phalon v. Wright (1864) 5 Phila. (Pa.) 464.

"Any name, symbol, letter, figure, or device adopted by the persons manufacturing or selling goods, and used and put upon such goods to distinguish them from those manufactured or sold by others, and employed so often and for such length of time as to raise the presumption that the public would know that it was used to indicate ownership of the goods in the person manufacturing or selling them, constitutes his trade-mark." Derringer v. Plate (1865) 29 Cal. 292.

A trade-mark may consist of words, but they must be specific and distinctive, and must point to the articles, and to nothing else. Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42.

"In all cases where names, signs, marks, labels, words, or devices of any kind can be advantageously used to designate the goods or property or particular place of business of a manufacturer or

sented, at the ends of the roll of carpet, the appearance of two octagonal wooden rings, constituted a valid trade-mark.³ It has also been held by the English court of appeal that

a person engaged in trade, he may adopt and use such as he pleases, which are adapted to that end, and have not been before appropriated." *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314.

"Any contrivance, design, device, name, symbol, or other thing may be employed as a trade-mark, which is adapted to point out the true source and origin of the goods to which said mark is applied, or even to point out and designate a dealer's place of business, distinguishing it from the business locality of other dealers; but the mark must point out the source and origin of the goods, and not be merely descriptive of the style, quality, or character of the goods themselves; and the fact that the name of a trade-mark, with the combined device, are neither descriptions nor suggestive of the style, character, or qualities of the article manufactured, is one of their virtues as a trade-mark." *Filley v. Fassett* (1869) 44 Mo. 168.

"A manufacturer has the right to distinguish the goods manufactured by him by any peculiar mark or device he may select or adopt, by which they may be known as his in the market, and thereby secure to himself the profits arising from the fact that they are his manufacture, and he is entitled to the protection of a court of equity in the exclusive use of the peculiar marks or symbols appropriated by him, designating or indicating the true origin or ownership of the article to which they are affixed, against the adoption or imitation thereof by another so as to mislead the public as to such origin or ownership, and thus effect the sale of his goods as those of the party whose trade-mark is so adopted or imitated." *Gillott v. Esterbrook* (1872) 48 N. Y. 374.

"A trade-mark may consist of a name, or a device, or a peculiar arrangement of words, lines, or figures in the form of a label, which has been adopted and used by a person in his business to designate goods of a particular kind manufactured by him, and which no other person has an equal right to use. The right in a trade-mark, so applied, is recognized as property, which a court of chancery will protect by injunction." *Gilman v. Hunnewell* (1877) 122 Mass. 139.

³ *Lowell Mfg. Co. v. Larned* (1873) Cox, Man. Trade-Mark Cas. No. 428, 15 Fed. Cas. No. 8,570.

a white selvage on each side of a piece of worsted goods, having a red and white mottled thread interwoven the full length of the selvage between the edge of the piece and the

"A trade-mark may consist of anything—marks, forms, symbols—which designate the true origin or ownership of the article. It cannot consist of anything which merely denotes the name or quality. There can be no right to the use of mere generic words." *Godillot v. Hazard* (1875) 49 How. Pr. (N. Y.) 5.

"The law in relation to trade-marks has frequently been the subject of discussion in the courts; and it seems to be well settled that the owner of any original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that he may appropriate as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to appropriate a sign or mark which indicates the name or quality of the goods, and which others may employ with equal truth for the same purpose." *Dunbar v. Glenn* (1877) 42 Wis. 118.

"A trade-mark must, * * * as the terms import, be one consisting of a word, an expression, a device, or a mark, invented or adopted by the owner, which designates and distinguishes his production from the general manufacture of the same article, and it cannot be the appropriation of words belonging to the general public which describes truly a known product." *Helmbold v. Helmbold Mfg. Co.* (1877) 53 How. Pr. N. Y. 453.

"The law * * * will protect the party whose wares, commodities, or publications have become identified in the market under any appropriate symbol, words, phrases, or devices from the appropriation and use of them by other and competing dealers, in the same description of property." *Potter v. McPherson* (1880) 21 Hun (N. Y.) 559.

"Trade-marks are of two kinds. They may consist of pictures or symbols of a peculiar form and fashion of label, or simply of a word or words which, in whatever form printed or represented, continue to be the distinguishing mark of the manufacturer who has appropriated it or them, and the name by which his products are known and dealt in. This distinction is recognized in the statutes for the protection of trade-marks, as well as in the cases." *Hier v. Abrahams* (1880) 82 N. Y. 519.

"A trade-mark is not necessarily limited to a device or name, but may consist of any marks, forms, or symbols which serve to

edge of the selvage, constituted a valid trade-mark.⁴ Similar devices have also been held by the French courts to con-

designate the true origin or ownership of the article." *Morgan's Sons Co. v. Troxell* (1881) 23 Hun (N. Y.) 632.

"The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used. Why not numerals united?" *Shaw Stocking Co. v. Mack* (1882) 12 Fed. 707.

"Fancy names, whether invented or arbitrary, the names of places, words, where applied to a new process by the inventor, the name of an article which alone designates its origin or ownership, letters and numerals combined in unusual and peculiar forms, or with other parts composing trade-marks, have been held, under the particular circumstances of the various cases, where their exclusive appropriation and use are in question, to be trade-marks or component elements thereof." *Avery v. Meikle* (1883) 81 Ky. 73.

In general, a man may adopt for a trade-mark whatever he chooses; but when he asserts and seeks to enforce exclusive right therein, it becomes necessary to ascertain whether it is just to others that this be permitted. If the name, device, or description is purely arbitrary or fanciful, and has been first brought into use by him, his right to the exclusive use of it is unquestionable. *Smith v. Walker* (1885) 57 Mich. 456.

"A person has the right to affix to his goods any device, symbol, or name which he may invent, to distinguish such goods from those made by other people. When the symbol becomes known, in connection with his name, it serves as a sign and pledge of the origin of his goods. People do not often stop to read all that may be printed on a label; nor do they always know the changes that are made in firms or business names. Hence it is that the right of a familiar symbol, inducing one to purchase goods to which the symbol does not properly belong, to the injury of him who devised it to mark his own goods, is the gravamen of the law of trade-marks." *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338.

A trade-mark may consist of a name, or a device, or a peculiar arrangement of words, lines, or figures, or, indeed, any peculiar mark or symbol, not theretofore in use, adopted and used by a manufacturer, or a merchant for whom goods may be manufactured,

⁴ *Mitchell v. Henry* (1880) 15 Ch. Div. 181.

stitute trade-marks.⁵ In the case of *Cook v. Starkweather*,⁶ it was said by the New York supreme court: "The package, case, or vessel in which the commodity is put, if prepared in a peculiar or novel manner, although in itself, perhaps, not a trade-mark, may very properly be a very important part of it; and where a peculiar device is applied to a box or barrel which has been especially prepared to receive and give prominence to the design, such specially prepared box or barrel constitutes a part of the trade-mark, and may participate in the protection which will be given to the trade-mark itself."

to designate them as those which he manufactures or sells. It may be put either upon the article itself, or its case, covering, or wrapper. *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51.

"A trade-mark has been defined to be a symbol, emblem, or mark which the tradesman puts upon or wraps or attaches in some way to the articles he manufactures, or causes to be manufactured, for the purpose of distinguishing them from the productions of other manufacturers." *Munro v. Smith* (1890) 55 Hun (N. Y.) 419.

"Any contrivance, design, device, name, or symbol may be used as a trade-mark for the purpose of pointing out the true source and origin of the goods to which it is affixed. Under some circumstances, the name of a place may be used as a trade-mark." *Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co.* (1890) 104 Mo. 53.

"A trade-mark may be a name adopted and used by a merchant or dealer in order to designate the goods that he sells, and distinguish them from those sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from the celebrity of his wares, or a reputation for superior skill, industry, or enterprise in handling the article put on the market. Any name may be so used that he may deem appropriate in designating the true origin or ownership of the article to which it is affixed, though he may not appropriate a name indicative of the quality of his goods which others may employ with equal truth for the same purpose." *Parkland Hills Blue Lick Water Co. v. Hawkins* (1894) 95 Ky. 502, 26 S. W. 389.

⁵ *Browne, Trade-Marks*, § 268.

⁶ (1872) 13 Abb. Pr. (N. S.; N. Y.) 392.

§ 27. Purpose for which mark adopted may determine whether valid trade-mark.

The purpose for which the mark is adopted may determine whether it is a valid trade-mark or not. The primary object in using a trade-mark must be to indicate origin or ownership. If the primary object in using the mark is to express grade, quality, or the kind or class to which the article belongs, it does not become a good trade-mark. A word or mark which, if used merely to designate one of several grades of a manufactured article, would not be subject to appropriation as a trade-mark because it then expressed grade or quality only, would be subject to such appropriation if used primarily to designate the origin or ownership of the article, instead of its grade or quality, because then it would be an arbitrary designation for the sake of distinction, and express origin primarily.⁷

§ 28. Test of trade-mark.

Hence, the same mark, if applied to one article, may be a valid trade-mark, and, if applied to another, even by the same manufacturer or producer, may be invalid. No exact statement of what a trade-mark may consist of can therefore be made. The true test is, was the mark adopted, or has it come by use, to indicate primarily the origin or ownership of the article to which it is applied? Can others, with equal truth, use it for the same or a like article? If the first of these questions must be answered in the affirmative, and the second in the negative, and the mark is distinctive in its character, it is a valid trade-mark, no matter of what it may consist. While some confusion exists upon this point in the decided cases, and a few may be found that do not respond to

⁷ Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331. See, also, Raymond v. Royal Baking Powder Co., 85 Fed. 236.

the test here laid down, it will be found that, in the majority of cases, the courts have sought to determine the question in accordance with the principles above stated. There are many cases, however, where injunctions have been granted, and the courts have applied the term "trade-mark" to some word involved which did not constitute a trade-mark, and where the injunction was, in fact, granted on grounds applicable solely to cases of unfair competition. A notable instance of this is the case of *Newman v. Alvord*,⁸ in which the defendant was restrained from using the word "Akron" as applied to cement, and the court referred to this name, designating locality of origin, as a trade-mark, which it clearly was not. The decision of the court in the case was correct, but should have been based upon the ground of unfair competition on the part of the defendant in fraudulently using the term "Akron" for cement not produced at that place, and not on the ground that the plaintiff had a trade-mark right in the name "Akron."

§ 29. Trade-mark may secondarily denote grade or quality.

While a trade-mark must primarily indicate origin or ownership, it is no objection that the mark had originally, or has come to have, a secondary significance, denoting grade or quality.⁹ The word "quality" is used in different senses in the cases. It is employed in some to denote the grade, ingredients, or properties of an article, and in others to indicate, generally, the merit or excellence of an article as associated with or coming from a certain source. While there

⁸ (1867) 49 Barb. (N. Y.) 588. See *Delaware & H. Canal Co. v. Clark* (1871) 13 Wall. (U. S.) 311; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537; *Pillsbury-Washburn Flour Mills Co. v. Eagle* (1897) 82 Fed. 816, reversed (1898) 30 C. C. A. 386, 86 Fed. 608.

⁹ *Burton v. Stratton* (1882) 12 Fed. 696.

can be no valid trade-mark as denoting quality when used merely in the former sense, there may be a valid trade-mark as indicating quality when used in the latter sense.¹⁰ A manufacturer or producer may use a certain trade-mark upon goods of the highest quality, and these goods may acquire a great reputation in the market. The trade-mark then not only indicates the origin or ownership of the goods, but it becomes, also, as said by the United States supreme court in *Manhattan Medicine Co. v. Wood*,¹¹ "both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture." A proprietor of trade-marks may also manufacture or sell several different grades or qualities of the same general kind of goods, and may adopt a separate mark for each quality or grade. If the primary function of each mark is to denote origin or ownership of the article with the proprietor, each mark will constitute a valid trade-mark, even though, as a secondary function, each mark distinguishes goods of the proprietor to which it is applied from other of his goods marked with other marks, or not marked at all.¹²

§ 30. Trade-mark may operate as assurance of quality.

It frequently happens that words used for the purposes of a trade-mark, and which, either in themselves as originally used, denote only origin or ownership, or which, by use, come, in the public mind, to indicate origin or ownership, though intrinsically denoting nothing of the kind, acquire finally a sort of adjective or descriptive significance in re-

¹⁰ *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹¹ (1883) 108 U. S. 218; *Cahn v. Gottschalk* (1888) 14 Daly (N. Y.) 542.

¹² *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338; *Scott v. Standard Oil Co.* (1894) 106 Ala. 475.

spect to the wares upon which they appear, and become an assurance that the commodity possesses certain virtues and qualities. But this is not because the words themselves are descriptive of the thing, but because they point to an origin or ownership known by experience to be the source of goods of certain qualities. The words do not describe the thing, but they indicate who made it. This knowledge of the maker involves an assurance of the quality, through the reputation which articles manufactured by him and put on the market under his mark have acquired. This reflex descriptive quality in words, which, dissociated from their use in connection with the article, are not descriptive of it at all, constitutes the chief value of trade-marks composed of them, both to the manufacturer or dealer and the public. Such words are not strictly descriptive, and that they, in this indirect way, show quality, is no objection to their employment in trade-marks, since their exclusive use by one would not deprive another of the full vocabulary of primarily descriptive words, to which the public are entitled, and to which these do not belong.¹³

§ 31. Classes of trade-marks.

Trade-marks were classified by Lord Romilly into personal and local.¹⁴ Mr. Tudor suggests¹⁵ as additional classes,—third, symbolical, as figures of animals, etc.; fourth, where a fancy name is used; and, fifth, where the claim is to a trade-mark compounded more or less of the others.¹⁶ The proper division of trade-marks seems to be into (1) personal and (2) impersonal. Personal trade-marks are those which

¹³ *Scott v. Standard Oil Co.* (1894) 106 Ala. 475.

¹⁴ *Hall v. Barrows* (1863) 11 Wkly. Rep. 525.

¹⁵ 2 Tudor, *Lead. Cas.* (2d Ed.) p. 573.

¹⁶ *Carmichel v. Latimer* (1876) 11 R. I. 395.

indicate to the public that some particular person has given his special skill to the production or selection of the articles to which they are applied.¹⁷ Impersonal trade-marks, even when they consist, in whole or in part, of the name of the manufacturer, do not indicate that the goods are the product of his personal skill, but rather point to him as the owner or proprietor of the manufactory or business in which they are produced, or through which they are put on the market. A trade-mark that is originally personal, and indicates that the article to which it is applied is the product of a particular person, may, by usage, come to indicate simply that the article is the product of a manufactory with which the person whose name appears in the mark was originally connected.¹⁸ Many trade-marks which are personal in form have been held by the courts to be merely impersonal marks, transferable with a business, and usable in their original form by a successor in business. Examples of these are found in "Dr. C. McLane's Liver Pills";¹⁹ "S. N. Pike's Magnolia Whiskey, Cincinnati, Ohio";²⁰ "Dr. J. Blackman's Genuine Healing Balsam";²¹ "Oakes' Candies";²² "A. N. Hoxie's Pumice Soap"; "A. N. Hoxie's Mineral Soap";²³ "Collins & Co."²⁴

¹⁷ *Leather Cloth Co. v. American Leather Cloth Co.* (1865) 11 H. L. Cas. 523-544; *Electro-Silicon Co. v. Hazard* (1883) 29 Hun (N. Y.) 369; *Hill v. Lockwood* (1887) 32 Fed. 389-393; *Davis v. Kendall* (1850) 2 R. I. 566.

¹⁸ *Oakes v. Tonsmierre* (1883) 4 Woods, 547; *Atlantic Milling Co. v. Robinson* (1884) 20 Fed. 217.

¹⁹ *McLean v. Fleming* (1877) 96 U. S. 245.

²⁰ *Kidd v. Johnson* (1879) 100 U. S. 617.

²¹ *Filkins v. Blackman* (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786.

²² *Oakes v. Tonsmierre* (1883) 49 Fed. 447.

²³ *Chaney v. Hoxie* (1887) 143 Mass. 592.

²⁴ *Collins Co. v. Oliver Ames & Sons Corp.* (1882) 18 Fed. 561.

§ 32. Characteristics of local trade-marks.

Some impersonal trade-marks are originally strictly local, or become so by usage, and indicate origin at a certain place of production, or manufactory, without reference to the owner or proprietor thereof. Such trade-marks, as already pointed out, pass, whether specifically mentioned or not, with a transfer of the manufactory or place of production. They are inseparable from the manufactory or place of production. Instances of such purely local trade-marks are found in the names "Congress Water" and "Bethesda Water," applied to the waters from certain springs;²⁵ "Old Oscar Pepper Distillery," applied to the whiskey produced at a certain distillery;²⁶ "M. C.," applied to tin plates produced at a certain manufactory;²⁷ "Stillman Mill," applied to woolens manufactured at a certain mill.²⁸ In these cases, a person acquiring the original manufactory or place of production is entitled to the trade-mark, although he has no derivative title from the original proprietor, and has not succeeded to the business in which the trade-mark originated and acquired its value. A trade-mark of this kind becomes so identified with the place or establishment where the article to which it is applied is produced as to designate or 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 after he parts with his ownership of the original manufactory or place of production, because he could not use it without deception, and therefore would not be protected in its exclusive

²⁵ Congress & Empire Spring Co. v. High Rock Congress Spring Co. (1871) 10 Abb. Pr. (N. S.; N. Y.) 348; Dunbar v. Glenn (1877) 42 Wis. 118.

²⁶ Pepper v. Labrot (1881) 8 Fed. 29.

²⁷ Motley v. Downman (1837) 3 Mylne & C. 1.

²⁸ Carmichel v. Latimer (1876) 11 R. I. 395.

enjoyment. Such a trade-mark is 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.²⁹

§ 33. Majority of trade-marks impersonal.

The great majority of trade-marks are impersonal, but not local. They indicate origin or ownership of the articles to which they are applied with a certain business establishment, and, whether personal or impersonal in form, they constitute a part of the goodwill and assets of the business, and pass as an incident of the business to any successor to the original proprietor.

§ 34. Words in common use as trade-marks.

In *Delaware & H. Canal Co. v. Clark*,³⁰ Mr. Justice Strong, in stating what may be appropriated as a trade-mark, says: "Words in common use, with some exceptions, may be adopted, if, at the time of their adoption, they were not employed to designate the same or like articles of production;" and in *McLean v. Fleming*,³¹ Mr. Justice Clifford states the rule as follows: "Phrases or even words in common use may be adopted for the purpose, if, at the time of their adoption, they were not employed by another to designate the same or similar articles of production or sale." The exceptions to the adoption of words in common use as trade-marks are also stated by Justice Strong in the case of *Delaware & H. Canal Co. v. Clark*. His language upon this point is as follows: "But though it is not necessary that the word adopted as a trade-mark should be a new creation, never before

²⁹ See, also, *Glenn & Hall Mfg. Co. v. Hall* (1874) 61 N. Y. 226; *Atlantic Milling Co. v. Robinson* (1884) 20 Fed. 217, 218; *in re Swezey* (1881) 62 How. Pr. (N. Y.) 215-219.

³⁰ (1871) 13 Wall. (U. S.) 311.

³¹ (1878) 96 U. S. 245.

known or used, there are some limits to the right of selection. This will be manifest when it is considered that in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief." These rules have been repeated by the supreme court of the United States in a number of later decisions, notably *Columbia Mill Co. v. Alcorn*,³² and they have been applied in many instances by the lower federal and the state courts of this country.³³

§ 35. General rule as to common words.

From these decisions we are able to deduce a general rule as to the appropriation of words in common use, as follows: Words in common use may be appropriated as trade-marks if they are adopted originally, or by usage have come, to indicate primarily the origin or ownership of a commercial article to which they are applied, and if they are not geographical, in the sense of being the names of localities of production, or not the generic name of the article, or merely descriptive of it, or of its qualities, ingredients, or character-

³² (1893) 150 U. S. 460; *McLean v. Fleming* (1877) 96 U. S. 245; *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51; *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1888) 128 U. S. 598; *Corbin v. Gould* (1890) 133 U. S. 308; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537; *Brown Chemical Co. v. Meyer* (1891) 139 U. S. 540.

³³ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Koehler v. Sanders* (1890) 122 N. Y. 65; *Burton v. Stratton* (1882) 12 Fed. 696; *Roberts v. Sheldon* (1879) 8 Biss. 398, Fed. Cas. No. 11,916; *Le Clanche Battery Co. v. Western Electric Co.* (1885) 23 Fed. 276; *Alleghany Fertilizer Co. v. Woodside* (1871) 1 Hughes. 115, Fed. Cas. No. 206.

istics. Another well-recognized rule is that a trade-mark must not be deceptive. Hence, common words, when employed as trade-marks, must not give a false impression as to the qualities, ingredients, or characteristics of the article. In numerous instances, claimants of trade-marks, consisting of words in common use, when met with the objection that the words were descriptive, have attempted to show that the articles did not contain the ingredients or possess the qualities attributed to them by the words employed, and have had their marks held invalid by the courts on the ground that they were deceptive. Subject to the limitations pointed out, words in common use may be appropriated as trade-marks, and the exclusive right to their use, for the specific articles to which they are applied, may be maintained.

§ 36. Instances of common words as trade-marks.

The following are instances of common words that have been held valid trade-marks under applications of the rules above stated: The word "Eureka," for fertilizers,³⁴ and also for a steam packing;³⁵ "Congress," for water from a certain spring;³⁶ "Mottled German," in connection with a circle having a moon and several stars within it, for soap;³⁷ "Warren Hose Supporter," in connection with a cut of a hose supporter engaged with a stocking, for a hose supporter;³⁸ "Excelsior," for ranges;³⁹ "Bismarck," for paper col-

³⁴ Alleghany Fertilizer Co. v. Woodside (1871) 1 Hughes, 115. Fed. Cas. No. 206.

³⁵ Symonds v. Greene (1886) 28 Fed. 834.

³⁶ Spring Co. v. Spring Co. (1871) 4 Brewst. (Pa.) 398.

³⁷ Proctor v. McBride (1875) Cox, Man. Trade-Mark Cas. No. 657, Fed. Cas. No. 11,441.

³⁸ Frost v. Rindskopf (1890) 42 Fed. 408.

³⁹ Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

lars;⁴⁰ "Pain-Killer," for a medical compound;⁴¹ "Sunlight," for soap;⁴² "Kaiser," for beer;⁴³ "Anti-Washboard," for soap;⁴⁴ "Twin Brothers," for yeast;⁴⁵ "Parabola," for needles;⁴⁶ "Grenade Syrup," for syrup made from pomegranates;⁴⁷ "National System of Penmanship," for copy books;⁴⁸ "Pride," for cigars;⁴⁹ "Magnetic Balm," for a medical compound;⁵⁰ "Hoosier," for grain drills;⁵¹ "Sliced Animals," "Sliced Birds," and "Sliced Objects," for games or puzzles;⁵² "Cough Cherries," for a confection;⁵³ "Lightning," for hay knives;⁵⁴ "Cream," for baking powder;⁵⁵ "Home," for sewing machines;⁵⁶ "Star," and a symbol of a star, for shirts, waists, underwear, and furnishing goods;⁵⁷ "Fibre Chamois," for a dress-lining fabric;⁵⁸ "Royal," for baking powder;⁵⁹

⁴⁰ *Merserole v. Tynberg* (1868) 36 How. Pr. (N. Y.) 14.

⁴¹ *Davis v. Kendall* (1850) 2 R. I. 566.

⁴² *Lever Bros. v. Pasfield* (1898) 88 Fed. 484.

⁴³ *J. & P. Baltz Brewing Co. v. Kaiserbrauerie, Beck & Co.* (1896) 74 Fed. 222.

⁴⁴ *O'Hourke v. Central City Soap Co.* (1885) 26 Fed. 576.

⁴⁵ *Burton v. Stratton* (1882) 12 Fed. 696.

⁴⁶ *Roberts v. Sheldon* (1879) 8 Biss. 398, Fed. Cas. No. 11,916.

⁴⁷ *Rillett v. Carlier* (1870) 11 Abb. Pr. (N. S.; N. Y.) 186.

⁴⁸ *Potter v. McPherson* (1880) 21 Hun (N. Y.) 559.

⁴⁹ *Hier v. Abrahams* (1880) 82 N. Y. 519.

⁵⁰ *Smith v. Sixbury* (1881) 25 Hun (N. Y.) 232.

⁵¹ *Julian v. Hoosier Drill Co.* (1881) 78 Ind. 408.

⁵² *Selchow v. Baker* (1882) 64 How. Pr. (N. Y.) 212.

⁵³ *Stoughton v. Woodard* (1889) 39 Fed. 902.

⁵⁴ *Hiram Holt Co. v. Wadsworth* (1889) 41 Fed. 34.

⁵⁵ *Price Baking Powder Co. v. Fyfe* (1891) 45 Fed. 799.

⁵⁶ *New Home Sewing Machine Co. v. Bloomingdale* (1893) 59 Fed. 284.

⁵⁷ *Hutchinson v. Blumberg* (1892) 51 Fed. 829.

⁵⁸ *American Fibre Chamois Co. v. De Lee* (1895) 67 Fed. 329.

⁵⁹ *Royal Baking Powder Co. v. Raymond* (1895) 70 Fed. 376; *Raymond v. Royal Baking Powder Co.* (1898) 29 C. C. A. 245, 85 Fed. 231.

“Swan Down,” for a complexion powder;⁶⁰ “Ideal,” for fountain pens;⁶¹ “Maryland Club,” for whiskey;⁶² “Sleuth” or “Old Sleuth,” for publications;⁶³ “The Akron Dental Rubber,” for dental articles;⁶⁴ “Champion,” for flour;⁶⁵ “Genuine Yankee” and “Yankee,” for soap;⁶⁶ “Marvel,” for flour;⁶⁷ “Established 1780,” for drugs;⁶⁸ “Old Crow,” for whiskey.⁶⁹

§ 37. Application of word to article must be arbitrary or fanciful.

In all of these cases, the application of the word to the article has been held to be arbitrary or fanciful, and not descriptive. It is to be noted that a word may be a valid trade-mark, even though it be suggestive of the qualities or characteristics of the article, or of the advantages supposed to arise from its use. In *Roberts v. Sheldon*,⁷⁰ Judge Blodgett says: “It is frequently the case that, by close analysis and ingenuity, you can find in almost any trade-mark a designation of some quality connected with the goods.” In *O'Rourke v. Central City Soap Co.*,⁷¹ Judge Brown says: “There is, however, a class of words which, though not de-

⁶⁰ *Tetlow v. Tappan* (1898) 85 Fed. 774.

⁶¹ *Waterman v. Shipman* (1891) 130 N. Y. 301.

⁶² *Cahn v. Gottschalk* (1888) 14 Daly (N. Y.) 542.

⁶³ *Munro v. Beadle* (1890) 55 Hun (N. Y.) 312; *Munro v. Tousey* (1891) 129 N. Y. 38.

⁶⁴ *Keller v. B. F. Goodrich Co.* (1888) 117 Ind. 556.

⁶⁵ *Atlantic Milling Co. v. Robinson* (1884) 20 Fed. 217.

⁶⁶ *Williams v. Johnson* (1857) 2 Bosw. (N. Y.) 1; *Williams v. Spence* (1863) 25 How. Pr. (N. Y.) 366; *Williams v. Adams* (1879) 8 Biss. 452, Fed. Cas. No. 17,711.

⁶⁷ *Listman Mill Co. v. Listman Milling Co.* (1894) 88 Wis. 334.

⁶⁸ *Hazard v. Caswell* (1878) 57 How. Pr. (N. Y.) 1.

⁶⁹ *Gaines v. Leslie* (1898) 25 Misc. Rep. (N. Y.) 20.

⁷⁰ (1879) 8 Biss. 398, Fed. Cas. No. 11,916.

⁷¹ (1885) 26 Fed. 576.

scriptive of the article, are suggestive of some supposed advantage to be derived from using it, or some effect produced by its use. These have been ordinarily, though not always, upheld as valid trade-marks.”

§ 38. Word may be valid trade-mark, although article has acquired wide sale, and mark becomes indicative of quality.

Nor is a word to be held invalid as a trade-mark because the article to which it is applied has attained such widespread sale that the mark has also become indicative of quality. If the primary object of the trade-mark be to indicate ownership, the mark does not become the common property of the trade, nor is the owner debarred from protection merely because the sale of the article under the mark has been so great and so widespread that the mark has also become indicative of quality.

§ 39. Word may be valid trade-mark, although it has become ordinary appellation of article.

Nor is a word invalid as a trade-mark because it has become so generally known in connection with the article that it has been adopted as the ordinary appellation of the article. In *Selchow v. Baker*,⁷² Judge Rapallo, in pronouncing the decision of the New York court of appeals, says: “It cannot be true, as a general proposition, as contended on the part of the defendants, that, when a manufacturer has given to his products a new name invented by himself for the purpose of distinguishing them as his, and the article becomes generally known to the trade and to the public by that name, the name becomes public property, and every one has a right to use it. That proposition can be sustained only in respect

⁷² (1883) 93 N. Y. 59.

to names which are descriptive of the article, and incapable of being appropriated as trade-marks. The value of a trade-mark consists in its becoming known to the trade as the mark of the manufacturer who has invented or adopted it, and in being known to the public as the name of an article which has met with popular favor. It cannot be that the very circumstances which give it value operate at the same time to destroy it." In *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*,⁷³ Mr. Justice Bradley quotes with approval from *Selchow v. Baker*, and says: "When the word ["celluloid"] was coined and adopted, it was clearly a good trade-mark. The question is whether the subsequent use of it by the public as a common appellation of the substance manufactured can take away the complainant's right. It seems to me that it cannot." The last case cited involved a newly-coined word, but the rule must be the same as to a word in common use. If the word was a good trade-mark when adopted, it remains a good trade-mark, no matter how extensively used, and even if it has acquired, by such extensive use, a secondary descriptive meaning, unless the owner, by his conduct, has lost his exclusive right thereto. If the word was merely descriptive when adopted, subsequent use cannot make it a valid trade-mark unless, by such use, it has acquired a predominating secondary meaning, in connection with the particular article on which it is used, that causes it to indicate origin or ownership, rather than the qualities or characteristics of the article.⁷⁴

§ 40. Trade-mark may consist of common words, combined with other features.

A combination of common words, not in themselves the

⁷³ (1887) 32 Fed. 94.

⁷⁴ *Schendel v. Silver* (1892) 63 Hun (N. Y.) 330.

subject of appropriation as a trade-mark, with other distinctive features or devices, may be adopted as a trade-mark, and the proprietor thereof will be entitled to protection against such an imitation as will deceive the public, and cause it to purchase goods bearing the simulated mark, in the belief that they are the goods of the original proprietor. It is immaterial that no one feature of the trade-mark is in itself distinctive or capable of appropriation. In such instance it is the combination or arrangement of words or devices, or words and devices, that constitutes the trade-mark.⁷⁵

⁷⁵ "The words which compose a trade-mark need not each be new. If the combination thereof be new and be descriptive of the origin of the goods and their ownership by the manufacturer who devises the mark, it will be unlawful for any other person to filch the combination, or any important part thereof." *Wolfe v. Barnett* (1872) 24 La. Ann. 97.

"A combination of words and figures or symbols may constitute a trade-mark, although some or each of the parts, standing alone, would not do so, and could be used without infringement; and in such a case it is the entire combination and setting which makes the trade-mark." *Clinton Metallic Paint Co. v. New York Metallic Paint Co.* (1898) 23 Misc. Rep. (N. Y.) 66.

"A trade-mark may consist of a name, a device, or a peculiar arrangement of words, or of words with some device of greater or less novelty. Words and devices of common use in a particular trade, as 'Fabrica Tabacos' in the tobacco trade, are not of themselves the subject of a trade-mark, but, used in connection with other words or devices, the whole may constitute a valid trade-mark, which will be entitled to legal protection as property." *Solis Cigar Co. v. Pozo* (1891) 16 Colo. 388.

"Where words and names are in common use, no one person can claim a special appropriation of them to his peculiar use; but where words and the allocation of words have, by long use, become known as designating the article of a particular manufacturer, he acquires a right to them, as a trade-mark, which competing dealers cannot fraudulently invade. The essence of the wrong is the false representation and deceit. When the improper design is apparent, an injunction should be issued. In such cases, injunctions have been sustained, though the name of the place, or of a celebrated person,

§ 41. Personal names as trade-marks.

There is considerable conflict in the decisions of the courts upon the question whether a personal name may be used as a trade-mark. Some of the courts have held that it can; others that it cannot. A personal name does not respond to the tests for a technical trade-mark, for the reason that no one can have the exclusive right to such a name against another person having the same name, and using it in good faith; but there would seem to be no reason against appropriating a trade-mark consisting of a personal name used in some peculiar or distinctive design or form. In this instance, any one would have a right to use the name, in good faith, in any form except that already appropriated.

In *Ainsworth v. Walmsley*,⁷⁶ Vice-Chancellor Wood said: "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."

were within the trade-mark protected by the injunction." *Lea v. Wolff* (1873) 1 *Thomp. & C.* (N. Y.) 626, 15 *Abb. Pr.* (N. S.; N. Y.) 1, 46 *How. Pr.* (N. Y.) 157.

When a commercial name, not the subject of appropriation as a trade-mark, is combined with other distinctive features, including the manufacturer's name, the whole may be adopted by him as a trade-mark, and he will be entitled to protection against such a fraudulent imitation of his wrappers and labels, bearing such trade-mark, as will enable the defendants to deceive the public and injure his business. Hence, when plaintiff adopted a trade-mark consisting, as a whole, of printed copies of the medals awarded him by the United States Centennial Commission, in 1876, and the French Republic at the Exposition Universelle Nationale, held at Paris in 1878, with the words "Dreydoppel's Borax Soap" printed underneath, and used it upon his wrappers and labels, he is entitled to the exclusive use of such trade-mark, and to protection against infringement of it. *Dreydoppel v. Young* (1880) 14 *Phila. (Pa.)* 226.

⁷⁶ (1866) L. R. 1 Eq. 518.

In *Dunnachie v. Young*,⁷⁷ Lord Craighill said: "The name of a person may be a trade-mark; but there may be other manufacturers of goods of the same description, and the latter are not precluded from placing their own names on their own goods by reason of the fact that this name has already become the trade-mark of another manufacturer. The only condition they must fulfill is that the name as used by them shall be accompanied by something which shall be a distinction, if the bare name would lead to the deception of the public, and the injury of the trader on whose goods the name first appeared as a trade-mark."

In *El Modello Cigar Mfg. Co. v. Gato*,⁷⁸ Mitchell, J., said: "It is now well established that a man may acquire the right of a trade-mark in his own name, or in the name of any person, but a man cannot acquire the right of a trade-mark in the use of his own name, to the exclusion of the right of another person by the same name, and whose place of business is in the same place."

In *Hegeman v. Hegeman*,⁷⁹ it is said: "It [a trade-mark] may exist where the name of the article and of the proprietor are so blended together that the right to the use of the name is indispensable to the use of the trade-mark, or may consist of the name alone of the manufacturer or proprietor."

In *McLean v. Fleming*,⁸⁰ Justice Clifford said: "It is doubtless correct to say that a person may have a right in his own name as a trade-mark as against a trader or dealer of a

⁷⁷ (1883) 10 Scot. Ct. Sess. Cas. (4th Ser.) 874.

⁷⁸ (1890) 25 Fla. 886, 6 L. R. A. 823.

⁷⁹ (1880) 8 Daly (N. Y.) 1.

⁸⁰ (1877) 96 U. S. 245. See, also, *Burke v. Cassin* (1873) 45 Cal. 467; *Meneely v. Meneely* (1875) 62 N. Y. 427; *Wedgwood v. Smith* (1848) Cox, Man. Trade-Mark Cas. No. 96.

In 26 Am. & Eng. Enc. Law (1st Ed.) 260, it is said: "The name of an inventor or maker is the best guaranty of the genuineness of the goods which bear the name, and will, as a general rule, be

(62)

different name; but the better opinion is that such a party is not, in general, entitled to the exclusive use of a name, merely as such, without more."

While these authorities would seem sufficient to establish the rule that a personal name may be a trade-mark as against

protected as an exclusive trade-mark if used in a way which is free from misrepresentation or fraud."

In *Williams v. Farrand* (1891) 88 Mich. 473, it was held that a surname may become impersonal when it is attached to an article of manufacture, and becomes the name by which such article is known in the market, and the right to use the name may, in consequence, follow a grant of the right to manufacture that article, or a sale of the business of manufacturing such article; and where the right to manufacture is exclusive, the right to the use of the name as applied to that article becomes likewise exclusive.

The following excerpts from judicial decisions are in point:

"A surname may become impersonal when it is attached to an article of manufacture, and becomes the name by which such article is known in the market." *Vonderbank v. Schmidt* (1892) 44 La. Ann. 264.

"It is true that a name or the style of a firm may, by long usage, become a mere trade-mark, and cease to convey any representation as to the fact of the person who makes, or the place of manufacture." *Carmichel v. Latimer* (1877) 11 R. I. 395.

"But the right of a corporation to the use of its name can be no greater or different in principle than that of an individual, and, although an individual may acquire the right to use his name as a trade-mark, he may be enjoined from doing so if some other person, having the same name, has previously acquired the right to use it as a trade-mark upon his goods." *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1891) 137 Ill. 231.

"A trade-mark may, and often does, consist in the name of a person or partnership firm, and the exclusive use of such trade-mark is upheld, with this limitation: that another person of the same name is not to be prevented from using his name in the same way, provided there are no special circumstances which make it inequitable for him to do so." *Skinner v. Oakes* (1881) 10 Mo. App. 45.

"The simplest case of a trade-mark is the name and address of the claimant, and it is absolutely requisite that a device or symbol should perform the office of a fingerboard,—should indicate the

any person of a different name, it will be found, upon examination, that each case would, under the later authorities, be regarded as a case of unfair competition, rather than one involving a technical trade-mark, and the correct rule seems to be that a personal name alone cannot constitute a technical trade-mark, though it may serve as the basis of an action to prevent unfair competition.

§ 42. A person cannot make a trade-mark of his own name, and debar another, having the same name, from using it.

Whether a person may make a trade-mark of his own name or not, as against a person having a different name, it is clear that he cannot, as against another person of the same name, so as to prevent him from using it in his business, if he does so honestly, and without any intention to appropriate wrongfully the goodwill of a business already established by others of the name. Every one has the absolute right to use his own name honestly in his own business for the purpose of advertising it, even though he may thereby incidentally interfere with and injure the business of another having the same

name and address of the manufacturer,—to invest it with the attributes, and entitle it to the protection, of a trade-mark.” *Ferguson v. Davol Mills* (1868) 2 Brewst (Pa.) 314.

“The name of the manufacturer or seller of goods may be used as a trade-mark, and the adoption of the same name as a trade-mark for goods of the same kind, by a person of a different name, is ‘piracy of a trade-mark.’” *Burke v. Cassin* (1873) 45 Cal. 467.

“The name of a manufacturer, or a system of numbers adopted and used by him in order to designate goods of his make, may be the subject of the same protection in equity as an ordinary trade-mark.” *Ainsworth v. Walmsley* (1866) L. R. 1 Eq. 518.

A person cannot have a right to his own name as a trade-mark, “as against another person of the same name, unless the defendant uses a form of stamp or label so like that used by the plaintiff as to represent that the defendant’s goods are of the plaintiff’s manufacture.” *Gilman v. Hunnewell* (1877) 122 Mass. 139.

name. In such case, the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But although a person may thus use his name, he cannot resort to any artifice or do any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name.⁸¹

⁸¹ *Russia Cement Co. v. Le Page* (1888) 147 Mass. 206, 17 N. E. 304; *Brown Chemical Co. v. Meyer* (1891) 139 U. S. 540-542; *Meneely v. Meneely* (1875) 62 N. Y. 427; *Holloway v. Holloway* (1850) 13 Beav. 209; *Gilman v. Hunnewell* (1877) 122 Mass. 139; *Rogers v. Rogers* (1885) 53 Conn. 121; *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1891) 137 Ill. 231; *Turton v. Turton* (1888) 42 Ch. Div. 128; *Robinson v. Storm* (1899) 103 Tenn. 40; *William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.* (1882) 11 Fed. 495; *Faber v. Faber* (1867) 49 Barb. (N. Y.) 357; *Carmichel v. Latimer* (1877) 11 R. I. 395; *William Rogers Mfg. Co. v. Simpson* (1887) 54 Conn. 527; *Cutter v. Gudebrod Bros. Co.* (1899) 36 App. Div. (N. Y.) 362; *Elgin Butter Co. v. Elgin Creamery Co.* (1895) 155 Ill. 127-137; *Rock Springs Distillery Co. v. Monarch* (1893) 15 Ky. Law Rep. 866, 22 S. W. 1028; *Monarch v. Rosenfeld* (1897) 19 Ky. Law Rep. 14, 39 S. W. 236; *De Long v. De Long Hook & Eye Co.* (1895) 89 Hun (N. Y.) 399; *N. K. Fairbank Co. v. Swift & Co.* (1896) 64 Ill. App. 477; *De Youngs v. Jung* (1893) 25 N. Y. Supp. 479; *Decker v. Decker* (1876) 52 How. Pr. (N. Y.) 218.

“A man may use his own name, because he cannot truthfully do business under any other, and the law protects that right ordinarily, even when such use is injurious to another who has established a prior business of the same kind, and gained a reputation which goes with the name. Even then the courts require that the name shall be honestly used [by him], and will permit no deceit calculated to mislead the public into purchasing his goods under the belief that they are the manufacture of another.” *De Long v. De Long Hook & Eye Co.* (1895) 89 Hun (N. Y.) 399.

“No person is bound to accept his patronymic as a surname, and he may engage in business under whatever name he sees fit, provided, however, that the assumption of any particular name for such purposes is unaccompanied by design to perpetrate a fraud upon others. If so, the use of the assumed name should be restrained.

§ 43. Second user may be restrained when fraud appears.

Where two persons have the same name, and use it to distinguish an article or commodity produced by them of like

* * * The use of a person's patronymic or other properly acquired name under circumstances which are calculated to deceive the public, and to convey the impression that the business products of the one sought to be restrained are those of another of the same name, who, by the use of such name in connection with particular devices which have been appropriated by the former, has acquired a trade-mark therein, may be restrained." *De Youngs v. Jung* (1893) 25 N. Y. Supp. 479.

"A defendant will not be restrained by injunction from the use of his own name, which he has caused to be registered and recorded as a trade-mark in the patent office, on motion of a plaintiff by the same name, and engaged in the same business, unless it plainly appears that it was obtained for the purpose of deception, or with a view to mislead the public or injure the plaintiff." *Decker v. Decker* (1876) 52 How. Pr. (N. Y.) 218.

"It would seem that the same rule should apply to corporations in this regard that obtains in respect to natural persons, and, in the absence of any fraudulent or wrongful intention or act, or any contract to prohibit it, every natural person has the absolute right to use his own name in his own business." *Elgin Butter Co. v. Elgin Creamery Co.* (1895) 155 Ill. 127.

"A man may not use his own name for the purpose of deception, and such fraudulent use will be enjoined. Fair competition in business is legitimate, and promotes the public good, but an unfair appropriation of another's business by using his name or trade-mark, or an imitation thereof, calculated to deceive the public, is not permissible, and will be enjoined by a court of equity." *N. K. Fairbank Co. v. Swift & Co.* (1896) 64 Ill. App. 477.

"An examination of the * * * cases wherein the use of a person's name has been regulated will show that, in most instances, conscious, intentional fraudulent misrepresentation on the part of the defendant has been resorted to. In others, there was such a combined use of the name with other marks, characters, figures, or form and arrangement of circulars, advertisements, etc., as to amount to a false representation, and the combination only was enjoined. No instance can be found where the use of the name only in good faith has been stopped." *Rogers v. Rogers* (1885) 53 Conn. 121.

"Upon the other hand, there has been, from the first to the pres-

character, and it is clearly shown that the later user does so for the purpose of imposing his own article upon purchasers for the prior user's article, which has become known and well established, it is, on the part of the later user, alike an imposition upon the public and an attempt to secure to himself, by this dishonest means, what rightfully belongs to another, and he will be restrained from so using his own name.⁸²

ent time, a general consensus of judicial opinion that the use of a personal name in a fair, honest, and ordinary business manner could not be prevented even if damage resulted therefrom." *Rogers v. Rogers* (1885) 53 Conn. 121.

"A manufacturer has the right to use his own name as a mark upon his goods, although it be the same name with that of another manufacturer of the same goods, who makes the name a part of his own trade-mark, where there is no false representation in such use." *Rogers v. Rogers* (1885) 53 Conn. 121.

⁸² *England v. New York Pub. Co.* (1878) 8 Daly (N. Y.) 375; *William Rogers Mfg. Co. v. R. W. Rogers Co.* (1895) 66 Fed. 56; *Arnheim v. Arnheim* (1899) 28 Misc. Rep. (N. Y.) 399; *Allegretti v. Allegretti Chocolate Cream Co.* (1898) 177 Ill. 129; *Young Women's Christian Ass'n v. International Committee, Y. W. C. A.* (1900) 86 Ill. App. 607; *Penberthy Injector Co. v. Lee* (1899) 120 Mich. 174, 78 N. W. 1074.

"A man, and no less a corporation, may not be entirely prohibited from using his or its proper name in any lawful business or occupation, but he [or it] may properly be restrained from so using it [such name] in such a manner as to perpetrate a fraud upon the public, and an injury to another of the same name." *Young Women's Christian Ass'n v. International Committee, Y. W. C. A.* (1900) 86 Ill. App. 607.

Where two parties have the same name, and use it as a trade-mark to distinguish an article or commodity produced by them of like character, and it is clearly shown from the facts that the later user does so for the purpose of imposing his own articles upon purchasers for the prior user's article, which has become known and well established, it is, on the part of the later user, alike an imposition upon the public, and an attempt to secure to himself, by this dishonest means, what rightfully belongs to another, and he will be restrained thereafter from so using his own name. *England v. New York Pub. Co.* (1878) 8 Daly (N. Y.) 375.

"A person may legally name himself, or change his name, or ac-

§ 44. Rule does not apply to corporations.

“Although the use of a personal name as a trade-mark will not be protected against its use in good faith by a defendant who has the same name, the reason of the rule ceases, and the rule no longer applies, where the defendant, as in case of a corporation, selects its own name, especially where it appears that such name is selected with an intention to mislead.”⁸³

§ 45. Personal name protected only when it truthfully indicates origin or ownership.

In order that a manufacturer or vendor may be protected in the use of a personal name, used on a commercial article, whether it be considered a technical trade-mark or not, it is necessary that such name indicate origin or ownership of such article, and this must be truthfully done.⁸⁴

§ 46. Court of equity will direct and control the use of a personal name.

A court of equity will direct and control the use of a man's name. “A man cannot acquire a right to the use of his name by reputation, general usage, and habit.” *England v. New York Pub. Co.* (1878) 8 Daly (N. Y.) 375.

“No person can, merely by adoption or use, acquire an exclusive right to the use of the name of another. A person cannot make a trade-mark of his own name, and thus obtain a monopoly of it, which will debar all other persons of the same name from using their own names in their own business.” *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1891) 40 Ill. App. 430.

⁸³ *William Rogers Mfg. Co. v. R. W. Rogers Co.* (1895) 66 Fed. 56.

⁸⁴ “But the primary function of a trade-mark is to indicate ownership and origin, and, unless this is truthfully done, it becomes a means of fraud upon the public, and will not be protected; and if a trade-mark is a personal one, designating a particular person, and his reputation and skill, it cannot truthfully be used by any other person, and consequently cannot be assigned.” *Mayer v. Flanagan* (1896) 12 Tex. Civ. App. 405, 34 S. W. 785.

name, either by himself or by himself associated with others, in his or their business, so it shall not be used to work an injury to the business of another person having the same name, or to perpetrate an imposition or a fraud upon the public.⁸⁵

§ 47. Instances of personal names as parts of trade-marks.

The following are a few instances of trade-marks involving personal names that have been recognized as valid by the courts: "Roger Williams' Long Cloth";⁸⁶ "Dr. J. M. Lindsey's Improved Blood Searcher";⁸⁷ "Oakes' Candies";⁸⁸ "Dr. McLane's Liver Pills";⁸⁹ "Taylor's Persian Thread";⁹⁰ "Ainsworth's Thread";⁹¹ "Storm's Liver Regulator";⁹² the name and portrait of Dr. Richmond.⁹³

§ 48. Names of places of business as trade-marks.

The name of a place of business may constitute a valid trade-mark if it is applied or affixed to a commercial article for the purpose of indicating the origin or ownership of such article. It is not a trade-mark unless it is thus applied or affixed to a commercial article for the purpose stated. It

⁸⁵ *Allegretti Chocolate Cream Co. v. Rubel* (1900) 86 Ill. App. 600; *Rubel v. Allegretti Chocolate Cream Co.* (1898) 76 Ill. App. 581; *Allegretti v. Allegretti Chocolate Cream Co.* (1898) 177 Ill. App. 129; *Allegretti Chocolate Cream Co. v. Keller* (1898) 85 Fed. 643; *Walter Baker & Co. v. Sanders* (1897) 80 Fed. 889.

⁸⁶ *Barrows v. Knight* (1860) 6 R. I. 434.

⁸⁷ *Fulton v. Sellers* (1867) 4 Brewst. (Pa.) 42.

⁸⁸ *Probasco v. Bouyon* (1876) 1 Mo. App. 241.

⁸⁹ *McLean v. Fleming* (1877) 96 U. S. 245.

⁹⁰ *Taylor v. Taylor* (1854) 23 Eng. Law & Eq. 281.

⁹¹ *Ainsworth v. Walmsley* (1866) L. R. 1 Eq. 518.

⁹² *Robinson v. Storm* (1899) 103 Tenn. 40.

⁹³ *Dr. S. A. Richmond Nervine Co. v. Richmond* (1895) 159 U. S. 293.

may, however, if not applied or affixed to such article, be entitled to protection as a trade or commercial name.⁹⁴

§ 49. Newly-coined words as trade-marks.

A newly-coined word constitutes one of the strongest trade-marks. The reason for this is obvious. Such a word, being usually meaningless, cannot be either descriptive or deceptive. All question as to the arbitrary character of the mark is therefore removed, and to entitle the originator thereof to hold such word as a valid trade-mark it is only necessary to show that it has been affixed or applied to a commercial article or vendible commodity for the purpose of indicating the origin or ownership thereof. It is no objection to a newly-coined word as a trade-mark that it is suggestive of the quality of the article to which it is applied, or of the purposes for which it is employed, or the mode of use thereof.⁹⁵

§ 50. Instances of coined words as trade-marks.

The following instances of coined words that have been held valid trade-marks illustrate the rule above stated: "Co-coaine," as a trade-mark for a hair wash;⁹⁶ "Sapolio," as a trade-mark for a cleaning compound;⁹⁷ "Electro-Silicon," as a trade-mark for a polishing powder;⁹⁸ "Chatterbox," as a trade-mark for a publication;⁹⁹ "Celluloid," as a trade-mark

⁹⁴ *Glen & Hall Mfg. Co. v. Hall* (1874) 61 N. Y. 226.

⁹⁵ *Leonard v. White's Golden Lubricator Co.* (1889) 38 Fed. 922; *N. K. Fairbank Co. v. Central Lard Co.* (1894) 64 Fed. 133; *American Grocery Co. v. Sloan* (1895) 68 Fed. 539; *Wolfe v. Goulard* (1859) 18 How. Pr. (N. Y.) 64.

⁹⁶ *Burnett v. Phalon* (1862) 9 Bosw. (N. Y.) 192, affirmed (1867) 1 Abb. Dec. (N. Y.) 267.

⁹⁷ *Morgan v. Schwachhofer* (1878) 55 How. Pr. (N. Y.) 37.

⁹⁸ *Electro-Silicon Co. v. Hazard* (1883) 29 Hun (N. Y.) 369.

⁹⁹ *Estes v. Worthington* (1887) 31 Fed. 154.

for compounds of pyroxyline;¹⁰⁰ "Bromidia," as a trade-mark for a medicinal compound;¹⁰¹ "Mojaja," as a trade-mark for a blend of coffee;¹⁰² "Saponifier," as a trade-mark for concentrated lye;¹⁰³ "Valvoline," as a trade-mark for lubricating oils;¹⁰⁴ "Cottolene," as a trade-mark for a substitute for lard;¹⁰⁵ "Cuticura," as a trade-mark for a toilet soap;¹⁰⁶ "Vitae-Ore," as a trade-mark for a medicinal preparation;¹⁰⁷ "No-To-Bac," as a trade-mark for a medicine designed to cure the tobacco habit;¹⁰⁸ "Asepsin," as a trade-mark for an antiseptic compound;¹⁰⁹ "Bromo-Caffeine," as a trade-mark for a medicinal preparation;¹¹⁰ "Uneeda," as a trade-mark for biscuit;¹¹¹ "Filo-Floss," as a trade-mark for a fabric;¹¹² "Hygieniques," as a trade-mark for suspenders;¹¹³ "Roach Sault," as a trade-mark for an insecticide;¹¹⁴ "Maizena," as a trade-mark for corn flour.¹¹⁵

§ 51. Fanciful names and phrases as trade-marks.

There is another class of words and phrases that may often

¹⁰⁰ Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94; Celluloid Mfg. Co. v. Read (1891) 47 Fed. 712.

¹⁰¹ Battle v. Finlay (1891) 45 Fed. 796.

¹⁰² American Grocery Co. v. Sloan (1895) 68 Fed. 539.

¹⁰³ Pennsylvania Salt Mfg. Co. v. Myers (1897) 79 Fed. 87.

¹⁰⁴ Leonard v. White's Golden Lubricator Co. (1889) 38 Fed. 922.

¹⁰⁵ N. K. Fairbank Co. v. Central Lard Co. (1894) 64 Fed. 123.

¹⁰⁶ Potter Drug & Chemical Corp. v. Miller (1896) 75 Fed. 656.

¹⁰⁷ Noel v. Ellis (1896) 89 Fed. 978.

¹⁰⁸ Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 80 Fed. 105.

¹⁰⁹ Lloyd v. William S. Merrill Chemical Co., 25 Ohio Law J. 319.

¹¹⁰ Keasbey v. Brooklyn Chemical Works (1894) 142 N. Y. 467.

¹¹¹ National Biscuit Co. v. Baker (1899) 95 Fed. 135.

¹¹² Rawlinson v. Brainard & Armstrong Co. (1899) 28 Misc. Rep. (N. Y.) 287.

¹¹³ Bailly v. Nashawannuck Mfg. Co. (1890) 10 N. Y. Supp. 224.

¹¹⁴ Stern v. Barrett Chemical Co. (1899) 29 Misc. Rep. (N. Y.) 609.

¹¹⁵ Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823.

be exclusively appropriated as trade-marks. These are words and phrases that are hardly to be considered as words in common use, and yet do not come under the class of newly-coined words. Instances of these are found in the phrase "Coal Oil Johnnie's Petroleum Soap";¹¹⁶ in "La Favorita," as a brand for flour;¹¹⁷ "Sorosis," for ladies' shoes;¹¹⁸ "Nickel-In" and "El Destino" for cigars;¹¹⁹ "Pharaoh's Serpents," for fireworks;¹²⁰ "Lone Jack" and "El Cabio," for tobacco;¹²¹ "Sappota Tolu," for chewing gum.¹²² Such purely fanciful words or phrases may be exclusively appropriated as trade-marks.

§ 52. Letters as trade-marks.

Letters, or even a single letter, when adopted and used primarily to indicate origin or ownership of a commercial article, may constitute a valid trade-mark. It is essential, however, in such case, that the primary object in using such letter or letters be to indicate origin or ownership, and not the grade or quality of the article. If the primary object is to indicate origin or ownership, then the letter or letters may constitute a valid trade-mark, even though they may secondarily indicate quality; but if the letter or letters indicate quality or size primarily, and indicate origin or ownership only secondarily, then such letter or letters do not constitute a valid trade-mark. There are instances in which marks

¹¹⁶ *Petrolia Mfg. Co. v. Bell & Bogart Soap Co.* (1899) 97 Fed. 781.

¹¹⁷ *Menendez v. Holt* (1888) 128 U. S. 514.

¹¹⁸ *Little v. Kellam* (1900) 100 Fed. 353.

¹¹⁹ *Schendel v. Silver* (1892) 63 Hun (N. Y.) 330; *Pinto v. Badman* (1891) 8 R. P. C. 181.

¹²⁰ *Barnett v. Leuchars* (1865) 13 Law T. (N. S.) 495, 14 Wkly. Rep. 166.

¹²¹ *Carroll v. Ertheiler* (1880) Cox, Man. Trade-Mark Cas. No. 669; *Solis Cigar Co. v. Pozo* (1891) 16 Colo. 388.

¹²² *Adams v. Heisel* (1887) 31 Fed. 279.

consisting of letters alone or combined with other features have been sustained by the courts, and there are other instances in which such letters have been held to be invalid as trade-marks. It will be found, on an examination of these cases, that, where the marks have been sustained, the primary purpose in using them was to indicate origin or ownership, and, where they have been held invalid, the primary object in using them was to denote size, grade, or quality.¹²³

§ 53. Instances of letters as trade-marks.

In the following cases, marks composed in whole or in part of letters have been sustained:

In *Godillot v. Harris*,¹²⁴ a monogram formed of the letters "A G," in connection with other devices, was held to be a valid trade-mark, and relief was granted to the plaintiff against a defendant who used a similar package, having thereon a monogram formed of the letters "F G."

In *Foster v. Blood Balm Co.*,¹²⁵ the principal feature of the plaintiff's device consisted of the letter "B," nine times repeated, the repetitions being arranged in three vertical columns, separated by lines or bars so as to form three groups of three B's ("B, B, B"), and, when applied to the goods, each of three sides of the package presented to the eye one of these triple combinations of B in conspicuous type. The court refused a preliminary injunction, holding that the case should await the result of a trial upon the merits, expressed some doubt as to whether the design was sufficiently fanciful

¹²³ *Godillot v. Harris* (1880) 81 N. Y. 263; *Foster v. Blood Balm Co.* (1887) 77 Ga. 216; *Frank v. Sleeper* (1890) 150 Mass. 583; *Giron v. Gartner* (1891) 47 Fed. 467; *George T. Stagg Co. v. Taylor* (1894) 95 Ky. 651, 27 S. W. 247; *Godillot v. American Grocery Co.* (1896) 71 Fed. 873; *Lafean v. Weeks* (1896) 177 Pa. 412; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹²⁴ (1880) 81 N. Y. 263.

¹²⁵ (1887) 77 Ga. 216.

and arbitrary to constitute a technical trade-mark, and stated that, whether the design would suffice or not for a technical trade-mark, there could be no reasonable doubt but that it was sufficient for a label.

In *Frank v. Sleeper*,¹²⁶ the supreme court of Massachusetts held that the letters "N S" constituted a valid trade-mark for cigars, and that the trade-mark was infringed by the use of the letters "N & S."

In *George T. Stag; Co. v. Taylor*,¹²⁷ the court of appeals of Kentucky held that the letters "O. F. C." constituted a trade-mark for whiskey.

In *Godillot v. American Grocery Co.*,¹²⁸ a monogram composed of the letters "A" and "G" was held to be a trade-mark, and the defendant was enjoined from using a similar monogram, although composed of letters forming the initials of the two principal words of defendant's name.

In *Giron v. Gartner*,¹²⁹ the complainant's trade-mark consisted of the letters "G F," and was held to be infringed by the mark "G & F," in the form in which it was used by the defendant, unless the ampersand was made of equal prominence with the initials.

§ 54. Numerals as trade-marks.

An arbitrarily selected numeral or combination of numerals used primarily for the purpose of indicating origin or ownership may constitute a valid trade-mark. It is essential, however, as in the case of other trade-marks, that the primary object in using the mark be to indicate origin or ownership, and not grade or quality. Such numerals may be used either by themselves or in conjunction with other

¹²⁶ (1890) 150 Mass. 583.

¹²⁷ (1894) 95 Ky. 651, 27 S. W. 247.

¹²⁸ (1896) 71 Fed. 873.

¹²⁹ (1891) 47 Fed. 467.

devices, or with words. In such case it must appear that the primary object in using the mark is to indicate origin or ownership. If the mark has acquired a secondary or subordinate signification, indicating grade or quality, it will not interfere with its validity as a trade-mark. If, however, the primary object in using the trade-mark is to indicate grade or quality, it will not constitute a valid trade-mark, even though it has acquired a secondary signification, indicating origin or ownership. The test in each case is, what is the primary object in using the mark? If this object is to point to a particular person as the maker of the goods, the numeral or combination of numerals, either with or without other devices, will constitute a valid trade-mark. If the primary object is to indicate grade or quality, or to distinguish one grade or quality from another, then the mark will not constitute a valid trade-mark. Again, if the numerals adopted have acquired, prior to such adoption, a well-understood meaning in the trade, indicative of grade or quality, they cannot be appropriated as trade-marks.¹³⁰

§ 55. Instances of numerals held to be valid trade-marks.

In *Gillott v. Esterbrook*¹³¹ it appeared that the plaintiff, a

¹³⁰ *Gillott v. Esterbrook* (1867) 47 Barb. (N. Y.) 455; *Boardman v. Meriden Britannia Co.* (1868) 35 Conn. 402; *Gillott v. Esterbrook* (1872) 48 N. Y. 374; *India Rubber Co. v. Rubber Comb & Jewelry Co.* (1879) 45 N. Y. Super. Ct. 258; *Kinney v. Allen* (1877) 1 Hughes, 106, Fed. Cas. No. 7,826; *Collins v. Reynolds Card Mfg. Co.* (1879) 7 Abb. N. C. (N. Y.) 17; *Lawrence Mfg. Co. v. Lowell Hosiery Mills* (1880) 129 Mass. 325; *Shaw Stocking Co. v. Mack* (1882) 12 Fed. 707; *Humphreys' Specific Homeopathic Medicine Co. v. Wenz* (1882) 14 Fed. 250; *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338; *Smith & Davis Mfg. Co. v. Smith* (1898) 89 Fed. 486. See *Humphreys' Homeopathic Medicine Co. v. Hilton* (1894) 60 Fed. 756.

¹³¹ (1867) 47 Barb. (N. Y.) 455, affirmed (1872) 48 N. Y. 374.

manufacturer of steel pens, had for many years manufactured a peculiar pattern, on which was impressed the figures "303," and the words "Joseph Gillott, Extra Fine." The pens were put up in paper boxes, with a label on top, containing the same name and numeral. The pens were known and ordered by dealers as "303" pens. Such figures did not express any quality or size of the pen, but were selected arbitrarily by plaintiff to distinguish the pattern or character of pens to which they were applied. Defendants began the manufacture and sale of a steel pen closely resembling plaintiff's pen in every particular, on which were stamped "303" and "Esterbrook & Co." and "Extra Fine." The pens were put up in boxes of the same size and similar to those of plaintiff, with a label containing the same words and figures, except "Esterbrook & Co.," instead of "Joseph Gillott." In an action brought by plaintiff to restrain the defendants from using the number "303," it was held by the New York supreme court that plaintiff had acquired the right to the exclusive use of those figures as a trade-mark, and was entitled to the relief sought. The judgment of the supreme court was affirmed on appeal, and in the opinion affirming the court below it is said: "The preceding statement of facts clearly shows that the said number was selected and used by the plaintiff as his trade-mark to indicate, in connection with his name, the origin and ownership of the said pens so manufactured by him, and not to designate their quality merely, and that the defendants, by the adoption thereof, have done it in fraud of his rights, and the plaintiff, upon all the facts found by the judge, was entitled to the injunction granted to him."

In *Boardman v. Meriden Britannia Co.*,¹³² a trade-mark consisting of numbers associated with the name of the peti-

¹³² (1868) 35 Conn. 402.

tioner, and certain words indicating the manner of manufacture of the teaspoons, upon the boxes of which the trademark was applied, was involved. The defendant used the same numbers and words indicating manner of manufacture upon a similar label, but substituted his own name for the name of the petitioner. Judgment was granted for the petitioner, and in its opinion the Connecticut supreme court said: "Both parties seem to regard the use of numbers as giving rise to the most important and most material question in the cause. The petitioners rely upon them as the most prominent, valuable, and distinctive feature in their trade-marks. The respondents claim that if, in any case, numbers can be legally appropriated as trade-marks, they were not so appropriated in this case, and that, so far as they tend to indicate ownership, it is only so by an association of ideas, and by giving to them a meaning which they were not originally designed to have. If this be so, or if the numbers were used solely to indicate the different patterns, styles, or sizes, it is clear, from the view we have taken of the law, that the respondents ought not to be restrained from their use. Whether, in any case, numbers alone may be legitimately appropriated as trade-marks, is a question not necessarily involved in the case. It may be difficult to give to bare numbers the effect of indicating origin or ownership, and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, and that they have had that effect, it may not be easy to assign a reason why they should not receive the same protection, as trade-marks, as any other symbol or device."

In *India Rubber Co. v. Rubber Comb & Jewelry Co.*,¹³³ the defendant was enjoined from using the numbers "2,"

¹³³ (1879) 45 N. Y. Super. Ct. 258.

“101,” and “32” upon gutta-percha combs. Referring to these numbers, the court, by Judge Sedgwick, said: “I am not able to see that the principles of *Gillott v. Esterbrook* [48 N. Y. 375] should not be applied. In that case and in this, the numbers were used to distinguish one pattern or character of goods from other patterns. In this case, the defendant’s labels prove that the numbers were useful in the market to designate these patterns. The numbers were selected arbitrarily, and of themselves expressed no size or quality.”

In *Collins v. Reynolds Card Mfg. Co.*,¹³⁴ it appeared that plaintiffs manufactured most of the cards used for photographic mounts in this country. Their cards of various sizes and kinds were boxed, each kind by itself, in a paper box, with a label on one end of the box. The cards themselves were perfectly plain in appearance, and the boxes and labels were not marked with the manufacturer’s name, or with any peculiar device, except that, upon the labels, numbers running from 1 to upward of 50 were printed, a different number being employed for each kind of cards. The numbers were purely arbitrary, and were used by the plaintiffs for the double purpose of distinguishing the different kinds of their cards as among themselves, and also of designating to the trade cards of their manufacture, and of distinguishing them from cards of all other manufacturers. The numbers were first selected by the plaintiffs, and had been exclusively used by them for this purpose, and with this effect in the photographic card trade, until certain of them were adopted by the defendant. The plaintiffs’ cards were generally ordered, in the trade, simply by numbers. The court stated that the case could not be distinguished in principle from that of *Gillott v. Esterbrook*, and said: “In the case at bar, the labels do not contain the name of the plaintiffs as makers, but the evi-

¹³⁴ (1879) 7 Abb. N. C. (N. Y.) 17.

dence satisfies me, beyond doubt, that the figures '35' were known to and recognized by dealers when employed as designating *carte de visite* mounts, as referring to the particular kind of card which was manufactured by the plaintiffs. And under the authorities, I am of the opinion that the plaintiffs have a trade-mark in those figures, and are entitled to be protected from its infringement by a court of equity."

In *Lawrence Mfg. Co. v. Lowell Hosiery Mills*,¹³⁵ the trade-mark of the plaintiff consisted of the figure of an eagle, surmounting a wreath formed of the branches of the cotton plant. The wreath inclosed the words, "Lawrence Manufacturing Company," printed in a circle, having underneath it the word "Trade-Mark," and, below all, the figures "523," printed in large hollow block numerals. This device had been stamped for many years on hosiery of a certain grade, and was known and recognized as indicating that the goods so marked were of the plaintiff's manufacture. Before this, the plaintiff had used an eagle and scroll in combination with other numerals as a trade-mark, upon the same grade of hosiery, and the wreath and eagle of the present device, without the numerals "523," or any other numerals, had been previously used on other grades of goods. The stamp adopted by the defendant consisted of an eagle surmounting a double circle or garter, on which were printed the words, "Extra finish iron frame," and beneath which were the figures "523," printed in large hollow block numerals, of the size and description used by the plaintiff, and occupying the same position with reference to other parts of the device. This stamp the defendant had placed upon hosiery goods made by it, for the purpose of imitating the plaintiff's stamps, and in order that such goods might be supposed to be of the plaintiff's manufacture, and it was found by the court that the

¹³⁵ (1886) 129 Mass. 325.

plaintiff's customers had been misled and deceived thereby. The eagle and garter had been used by the defendant before the trade-mark of the plaintiff was adopted, and the plaintiff made no claim to the exclusive use of them when not combined with the numerals "523." It was held by the court that the plaintiff adopted and used the numerals "523" as part of its trade-mark; that these figures were selected arbitrarily; that they were of unusual and distinctive form; that they were added to the original device, consisting of the eagle, the wreath, and the plaintiff's name, at the time when the word "Trade-Mark" was also added; that the whole, so composed, had been used as one trade-mark ever since; that this mark was recognized and known as the plaintiff's mark, and goods so marked were described and called for as "523's." It was also held that the plaintiff was entitled to a decree.

In *American Solid Leather Button Co. v. Anthony*,¹³⁸ the complainant was the manufacturer of buttons and nails with solid leather heads. In order to distinguish the different styles which it manufactured, it had assigned certain numerals, arbitrarily chosen, *e. g.*, 30, 40, 60, 70, 111, etc., to designate each style of head, on its advertising cards and packing boxes. The several styles made by the complainant had become associated with and known by these numerals in the trade, and the numerals were commonly made use of in orders and other designations of a style desired to be referred to. In deciding the case in favor of the complainant, the court said: "Within limits, which are well defined, a combination of letters or figures, arranged for convenience or to attract attention, may serve the purpose of a trade-mark as well as a device invented or arbitrarily selected. So a person may have different symbols for different grades of goods, which, in the same way, will indicate both quality and or-

¹³⁸ (1887) 15 R. I. 338.

igin, with respect to the goods so marked. A manufacturer may adopt such symbols, not simply to mark 'a' style or quality, but 'his' style and 'his' quality, as well. He is entitled to have 'his' style and 'his' quality protected from misrepresentation, and to have the benefit of any favorable reputation they may have gained. * * * We think these numbers indicate origin as well as style. The fact that orders for goods refer to numbers, which have become associated with a particular style of nail only by the complainant's association of the number with the style, raises a natural inference that persons ordering by that number suppose they are ordering both goods and style of complainant's make. We therefore think that, in the use of these numbers, * * * the complainant is entitled to protection according to the prayer of the bill."

In *Kinney v. Allen*¹³⁷ it appeared that the complainant used, with other devices, on certain classes of the packages and boxes in which he put cigarettes manufactured by him upon the market, the numerical symbol "1/2," printed in bold characters, in red color, with the bar between the two figures oblique, and nearly upright, with the figure "1" elevated on the left, the figure "2" depressed on the right, the symbol, as a whole, being of such size that the circumference of a circle having a radius of five-eighths of an inch would just include all its points. In discussing this mark Judge Hughes said: "It would seem that the original idea of the complainant in using this character '1/2' on certain of his wares was to indicate that the cigarettes stamped with it were made up of two kinds of tobacco, in the proportion of half-and-half. The numerical character does not express such an idea. It is not the term which a person accustomed to the use of accurate language would employ for the pur-

¹³⁷ (1877) 1 Hughes, 106, Fed. Cas. No 7,826.

pose of expressing it, but yet it must be admitted that it does, in some sort, indicate the idea, and is not an absolutely arbitrary symbol. It is only because of the fact that the character does indicate the idea of half-and-half, but does not express it, that any confusion attends this case. If the use by the complainant of the numerical character '1/2' was absolutely arbitrary, there could be no question of his exclusive right to use it stamped in any form upon his goods. But where, on the other hand, a character or word is the one in general use for describing the quality or kind of goods on which it is placed, the books are full of authorities showing that such character or word ordinarily used cannot be appropriated by any one manufacturer, and that the most he can acquire by long usage, or by statutory registration, is the right of using the character or word printed or painted in some special form not in ordinary use." It was held that the use of the numeral character "1/2" by the complainant, being in a critical sense merely arbitrary, as only indicating, but not expressing, the idea of half-and-half, but not absolutely arbitrary in a popular sense, the complainant was not entitled to an injunction prohibiting the use by others of the character in any form on wares similar to his own, but that he was entitled to its exclusive use in the form, size, color, and style in which he had used it.

In *Shaw Stocking Co. v. Mack*,¹³⁸ the principal contention was as to whether the complainant had an exclusive right to the number "830" to designate and distinguish its hose of a particular variety. In holding that this combination of figures constituted a valid trade-mark, Judge Coxe said: "Broadly defined, a trade-mark is a mark by which the wares of the owner are known in trade. Its object is two-fold,—first, to protect the party using it from competi-

¹³⁸ (1882) 12 Fed. 707.

tion with inferior articles, and, second, to protect the public from imposition. There is hardly a limit to the devices that may be thus employed. The whole material universe is open to the enterprising merchant or manufacturer. Anything which can serve to distinguish one man's productions from those of another may be used. The trade-mark brands the goods as genuine, just as the signature to a letter stamps it as authentic. The trade-mark may consist of a token, letter, sign, or seal. Names, ciphers, monograms, pictures, and figures may be used. Why not numerals united? What consistency is there in allowing it in a combination of letters, but denying it in a combination of figures? A careful examination of the authorities cited by the learned counsel for the defendants leads to the conclusion that, where the courts have refused protection to alleged trade-marks composed of letters or numerals, it has been because, on the facts of each case, it was determined that the figures or letters were intended solely to indicate quality, etc., and not because figures and letters in arbitrary combination are incapable of being used as trade-marks. It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3, and 4, or the letters A, B, C, and D, to distinguish the first, second, third, and fourth quality of his goods, respectively. Why? Because the general signification and common use of these letters and figures are such that no man is permitted to assign a personal and private meaning to that which has, by long usage and universal acceptance, acquired a public and generic meaning. It is equally clear, however, that if, for a long period of time, he had used the same figures in combination, as '3214,' to distinguish his own goods from those of others, so that the public had come to know them by these numerals, he would be protected. The courts of last resort in Connecticut, in Massachusetts, and in New York have distinctly held that doctrine."

In *Humphreys' Specific Homeopathic Medicine Co. v. Wenz*¹³⁹ it was held that a series of numbers employed to designate homeopathic specifics constituted a valid trade-mark, and the defendant was enjoined from applying the same system of numbers to another set of specifics, although such numbers were used in connection with the words "Humphreys' Homeopathic Specifics" by the complainant, and in connection with the words "Reeves' Improved Homeopathic Specifics" by the defendant. In this instance the defendant had used the same numbers that had been previously used by the complainant for the same specific. In the later case of *Humphreys' Homeopathic Medicine Co. v. Hilton*¹⁴⁰ it appeared that the different numbers did not stand for the same remedies in the defendant's system as in the complainant's system. In dismissing the bill, Judge Wallace said: "It may be that numerals which are arbitrarily selected, without any purpose of identifying the article to which they are affixed from other articles of a similar class, may become the subject of a trade-mark; but the use of numerals as a short method of identifying the several members of a class, and distinguishing one of them from another, is as old as the use of written words. When so used, they are, in substance and effect, descriptive terms,—the number conveys to the reader details which otherwise would have to be amplified in words. Hence it is that the practice is so common, with manufacturers and dealers, of numbering the varieties so as to indicate, by reference to advertisements, photographs, or other descriptive mediums, the size, grade, or peculiar characteristics of each for their own convenience and that of their customers. No one can acquire an exclusive right to appropriate them for such a purpose. No one has the right to ap-

¹³⁹ (1882) 14 Fed. 250.

¹⁴⁰ (1894) 60 Fed. 756.

propriate to his exclusive use a sign or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. It is because of this principle that a trade-mark cannot be acquired by the adoption of a word which is merely descriptive of the quality, ingredients, or characteristics of a commodity. * * * As used by the complainant and its predecessors, the numbers merely are not a valid trade-mark.”

§ 56. Pictures as trade-marks.

Pictures, used alone or in combination with other devices, may constitute valid trade-marks. Such devices are not open to the objection of being either descriptive or deceptive. It is usually then only necessary for the plaintiff to show prior adoption and use of the picture in question for the class of goods upon which it is used in order to establish his exclusive right thereto.

§ 57. Instances of pictures or symbols as trade-marks.

In *Colman v. Crump*¹⁴¹ it was held that the plaintiffs were entitled to the exclusive use of the picture of a bull's head as a trade-mark for mustard, although, prior to the adoption of such use by plaintiff, it had been used by others casually and occasionally, and as an ornament, rather than as a distinguishing mark of the mustard manufactured and sold; and the fact that the same device was used upon other articles of merchandise did not take from the plaintiffs their right to its exclusive use on this one article of their manufacture.

In *Pratt's Appeal*,¹⁴² the supreme court of Pennsylvania

¹⁴¹ (1877) 70 N. Y. 573.

¹⁴² (1888) 117 Pa. 401.

held that a representation of a cornucopia printed upon cakes of butter constituted a valid trade-mark.

In *Lichtenstein v. Goldsmith*,¹⁴³ the principal feature of the trade-mark involved was a picture of the head of an elk, together with the word "Elk" printed in large letters, upon the face of labels used upon boxes of cigars.

In *G. G. White Co. v. Miller*,¹⁴⁴ the trade-mark consisted of the representation or picture of a chicken cock standing upright within a circle, surrounded by the words, "Old Bourbon Whiskey, Bourbon Co., Ky.," and within these encircling words, and below the representation or picture, were the words "From J. A. Miller, Paris." This trade-mark was used upon the barrels containing the whiskey, and this whiskey, for more than thirty years, had always been known in the trade as "Miller's Chicken Cock Whiskey," or "Chicken Cock Whiskey," and it had been noted for its high grade and uniform excellence, and this mark had been stamped upon every barrel or package of whiskey made or sold by Miller or his successor in business. The defendant used a mark that the court held to be in all essential characteristics almost identical with that of the plaintiff, and was enjoined, the court saying: "The main feature of the mark in each case is the representation of a cock standing upright."

In *Kerry v. Toupin*¹⁴⁵ it appeared that complainants manufactured a medicinal compound under the name of "Syrup of Red Spruce Gum," and for some twenty years or more that name was placed conspicuously on the packages in which the compound was sold, and in connection therewith appeared a cut of an Indian against the background of spruce

¹⁴³ (1889) 37 Fed. 359.

¹⁴⁴ (1892) 50 Fed. 277.

¹⁴⁵ (1894) 60 Fed. 272. See, also, *Manitowoc Pea-Packing Co. v. William Numsen & Sons* (1899) 93 Fed. 196; *Ruhstrat v. People* (1900) 185 Ill. 133.

trees and a waterfall. It was held that the adoption and continuous use of this distinctive name and device entitled the complainants to claim it as a trade-mark, and to be protected against its infringement by persons making similar goods. The court said: "The complainants' name, 'Syrup of Red Spruce Gum,' adopted and continued in the manner shown, is a trade-name, and the device embodying the name and the cut, as printed on the blue wrapper, has become a distinctive mark in the trade, as applied to their cough mixture, and, as such, is entitled to protection."

§ 58. Names of newspapers and periodicals as trade-marks.

Newspapers and periodicals are commercial articles. The names thereon or titles thereof indicate origin or ownership. Such names may therefore constitute valid trade-marks, under the rules and subject to the exceptions and restrictions hereinbefore stated. There are many instances in which the courts have granted injunctions prohibiting the use of names constituting the titles of newspapers or periodicals, without discussing the question whether such titles constituted trade-marks. In some instances, the cases have been considered as involving merely questions of goodwill. In several of the later cases, however, the courts have recognized that the titles of newspapers and periodicals are usually trade-marks.¹⁴⁶

¹⁴⁶ *Bradbury v. Dickens* (1859) 28 Law J. Ch. 667; *Clement v. Maddick* (1859) 33 Law T. 117; *Ingram v. Stiff* (1859) 33 Law T. 195; *Hogg v. Kirby* (1803) 8 Ves. 215; *Longman v. Winchester* (1809) 16 Ves. 269; *Edmonds v. Benbow*, *Seton* (3d Ed.) 905; *Id.* (4th Ed.) 238; *A. Constable & Co. v. Brewster* (1824) 3 Scot. Ct. Sess. Cas. (1st Ser.) 215; *Prowett v. Mortimer* (1856) 27 Law T. 132; *Chance v. Sheppard* (1869) Cox, Man. Trade-Mark Cas. No. 317; *Clowes v. Hogg* (1871) Cox, Man. Trade-Mark Cas. No. 345; *Mack v. Petter* (1872) 41 Law J. Ch. 781; *Corns v. Griffiths* (1873) Cox, Man. Trade-Mark Cas. No. 420; *Metzler v. Wood* (1878) 38 Law T. (N. S.) 541.

§ 59. Descriptive or geographical words that have acquired secondary meanings.

While it is the general rule that neither descriptive words nor geographical terms may be appropriated as trade-marks, it has been held, in a number of cases, that such words or

8 Ch. Div. 606; *Weldon v. Dicks* (1879) 39 Law T. (N. S.) 467, (1878) 10 Ch. Div. 247; *American Grocer Pub. Ass'n v. Grocer Pub. Co.* (1881) 25 Hun (N. Y.) 398; *Kelly v. Hutton* (1868) 19 Law T. (N. S.) 228; *Snowden v. Noah* (1825) Hopk. Ch. (N. Y.) 396; *Bell v. Locke* (1840) 8 Paige (N. Y.) 75; *Dayton v. Wilkes* (1859) 17 How. Pr. (N. Y.) 510; *Matsell v. Flanagan* (1867) 2 Abb. Pr. (N. S.; N. Y.) 459. See, also, *Stephens v. De Como* (1868) 4 Abb. Pr. (N. S.; N. Y.) 47; *New York Polyclinic Medical School v. King* (1899) 27 Misc. Rep. (N. Y.) 250; *Osgood v. Allen* (1872) Holmes, 185, Fed. Cas. No. 10,603, Cox, Man. Trade-Mark Cas. No. 410, note.

In *Matsell v. Flanagan* (1867) 2 Abb. Pr. (N. S.; N. Y.) 459, 462, Brady, J.: "A newspaper establishment is not excluded from the advantage of these rules. It is a species of property, and the rights which appertain to it, so far as they are private and exclusive, are entitled to the protection of the laws. *Snowden v. Noah*, Hopk. Ch. (N. Y.) 351; *Bell v. Locke*, 8 Paige (N. Y.) 75. The title of a newspaper may be a purely original one, and the proprietor, for that reason, entitled to its exclusive use. He may create a word, or combination of words, for the particular designation of his paper, and in that way acquire an exclusive right to the use of the name employed. He may combine, as the plaintiffs have, well-known English words, in common use, to designate his paper, and its contents may in many respects be multiplied by publications in other prints, but the paper will, nevertheless, be original in some, if not in many, respects. The individualities of editorial life are as rarely duplicated as those displayed in other pursuits, and the intellectual vigor distinguishing the character and value of different prints, though equal in power, will be essentially different in thought,—in the principles announced and advocated, and in the reasoning by which the same theories are advanced and sought to be established. A newspaper, in its commanding elements, is the result of mental labor, and should be protected to the same extent, at least in the use of symbols, names, and marks, as any other property."

In *Stephens v. De Couto* (1868) 7 Rob. (N. Y.) 343, 348, Monell, J.: "I do not understand that the protection which the law affords to 'trade-marks,' even assuming the name of a newspaper to be a

terms may acquire a secondary meaning in the trade from having been long used as the designation of a particular manufactured article, and thereby to have lost, so far as such ar-

trade-mark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over anything that was the subject of a patent or a copyright, but is confined to appropriations of names designating some particular manufacture or business. There can be no such property in a newspaper, except, perhaps, in the name or title of the paper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and, when given to the public, all literary proprietorship in them is lost; and the law of trade-marks, like the law of copyright, cannot be applied to a work of so fluctuating and fugitive a character. *Clayton v. Stone*, 2 Paine, 392, Fed. Cas. No. 2,872.

"I do not mean to say that a newspaper proprietor cannot appropriate, and, by long use, acquire a property, in a name, which the courts will protect against piracy. In this respect, the analogy of the rules of trade-mark would apply. *Dayton v. Wilkes*, 17 How. Pr. (N. Y.) 510. And I have no doubt that the names, so long appropriated and used, of the *New York Herald*, or the *Sun*, would be protected, as trade-marks, against the assumption of those names by another proprietor. But that I understand to be the extent of the rule, and that any more assimilation of the name, unless it was very clearly calculated to deceive the public, would not be unlawful."

In *Joseph Dixon Crucible Co. v. Guggenheim* (1869) 2 Brewst. (Pa.) 321, 339, Paxson, J.: "The name of a newspaper is a trade-mark,—as much so as a label stamped upon a bale of muslin."

In *American Grocer Pub. Ass'n v. Grocer Pub. Co.*, 25 Hun (N. Y.) 398, it was held by the New York supreme court (reversing 51 How. Pr. [N. Y.] 402) that where the plaintiff had for many years published in the state of New York a paper called the "*American Grocer*," and one Price, who had theretofore edited plaintiff's paper, started for the defendant a new paper called "*The Grocer*," even if the evidence failed to show an intention on the part of Price to encroach upon the plaintiff's business, yet the plaintiff was entitled to an injunction restraining the defendant from the publication of any paper called "*The Grocer*" or "*The American Grocer*," as plaintiff had acquired a proprietary right in that name.

In *Clement v. Maddiek*, 5 Jur. (N. S.) 592, the proprietor of "*Bell's*"

ticle is concerned, their primary descriptive or geographical significance. Thus it has been held that the name "Waltham" on watches, while originally used in a geographical sense, had, by continued use, acquired a secondary meaning as a designation of watches of a particular class, and that purchasers had come to understand that watches stamped with the name "Waltham" are watches made by the American Waltham Watch Company.¹⁴⁷ In the English case of *Wotherpoon v. Currie*¹⁴⁸ it was held by the house of lords that the word "Glenfield," as applied to starch, had acquired a secondary meaning, and denoted to the public starch made by the appellants, and an injunction was granted "restraining the respondent, his servants and agents, from using the word 'Glenfield' in or upon any labels affixed to packets of starch manufactured by or for him, and from in any other way representing the starch manufactured by or for him to be 'Glenfield Starch,' and from selling or causing the same to be sold as 'Glenfield Starch,' and from doing any act or thing to induce the belief that starch manufactured by or for him, the respondent, is 'Glenfield Starch,' or starch manufactured by the appellants." It appeared, moreover, that, while the appellants' starch had originally been manufactured at Glenfield,

Life in London and Sporting Chronicle" obtained an injunction restraining the proprietors of "The Penny Bell's Life and Sporting News" from using any title which included "Bell's Life," by which name the plaintiff's paper was known familiarly.

In *Ingram v. Stiff*, 5 Jur. (N. S.) 947, the proprietor of a weekly publication called "The London Journal" obtained an injunction restraining the defendant from printing, publishing, or selling any newspaper or other periodical under the name of "The Daily London Journal," or any other name or style of which the words "London Journal" should form part.

¹⁴⁷ *American Waltham Watch Co. v. United States Watch Co.* (1899) 173 Mass. 85; *American Waltham Watch Co. v. Sandman* (1899) 96 Fed. 330.

¹⁴⁸ (1872) 42 Law J. Ch. 130, L. R. 5 H. L. 508.

their factory had been moved, prior to the time when suit was brought, to another place, and that the respondent had set up his manufactory at Glenfield, and was actually manufacturing starch at that place, and in part of the same building where the original manufacture of Glenfield starch had been carried on. Glenfield was not a parish, nor a hamlet, nor a district of any special character, but it was merely an estate of that name, upon which some people had erected some houses or manufactories, and upon which some sixty people were then living. There was, therefore, nothing whatever to give particular celebrity to the name of Glenfield, so connected with the starch manufactory, beyond the fact that the appellants had manufactured an article having a very large sale under that name. In stating his opinion in the house of lords, Lord Westbury said: "I take it to be clear, from the evidence, that, long antecedently to the operations of the respondent, the word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture,—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and, in connection with starch, had acquired that peculiar secondary signification to which I have referred. The word 'Glenfield,' therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch." In the case of *Montgomery v. Thompson*,¹⁴⁰ also decided by the house of lords, it appeared that the respondents had carried on business as brewers at Stone, a town of 6,000 or 7,000 inhabitants, for upwards of a century. The ales manufactured by them had gained a high reputation, and had become known to the market, and to the public, under the terms "Stone Ales," or "Stone Ale," the latter being exclusively ap-

¹⁴⁰ (1891) 60 Law J. Ch. Div. 757, [1891] App. Cas. 217.

plied to a particular quality of beer, and any one asking for "Stone Ale" or "Stone Ales" would desire to be supplied, and expect to be supplied, with the ale manufactured by the respondents. The appellant had recently established a brewery at Stone. The courts below came to the conclusion that he intended to use the terms "Stone Ale" and "Stone Ales" in connection with liquor of his own manufacture, with a view of leading to the belief that the ales he sold were those which had become known to the market and to the public, and thus obtaining advantage of the reputation which the respondents' ales had acquired. An injunction was accordingly granted on the application of the respondents, restraining the appellant from "carrying on the business of a brewer at Stone under the title 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling or causing to be sold any ale or beer, not of the plaintiffs' manufacture, under the term 'Stone Ales' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade-marks, or any of them." In the case of *Reddaway v. Banham & Co.*,¹⁵⁰ decided by the house of lords in 1896, it was found that the appellant Frank Reddaway had been for many years a manufacturer of machine belting. About the year 1879 he commenced calling the belting which he manufactured "Camel-Hair Belting," for the purpose of distinguishing it from belting of other manufacturers. A large proportion of his trade had been with India, the Colonies, and foreign countries. The belting consigned to these countries was stamped with a "Camel," or with the word "Camel" or "Camel Hair," and sometimes with both. The yarn of which the appellants'

¹⁵⁰ (1896) 65 Law J. Q. B. Div. 381.

belting consisted chiefly was, for the most part, made of camel hair, and while this yarn was commonly called "Camel-Hair," it was not generally known that it really consisted of the hair of a camel. The respondent Banham, who was formerly in the employ of the appellant, ceased to be so employed in the year 1889, and commenced manufacturing belting on his own account. He made belting from yarn of the same description as that used by the appellants, which he sold and advertised as Arabian belting. In 1891 the respondent company was formed, and commenced calling their belting "Camel-Hair Belting," these words, and these words only, being in most cases stamped on the belting. Suit having been brought, a special jury found that the term "Camel-Hair Belting" meant belting made by the plaintiffs, as distinguished from belting made by other manufacturers. Upon the findings of the jury, the court entered judgment for the plaintiffs. On appeal, this judgment was reversed, and judgment entered for the defendants. In the opinion of the court of appeal, inasmuch as the words "Camel-Hair Belting" were descriptive of the article sold, the words "Camel-Hair" indicating the material of which it was made, the defendants were entitled to use the same language with reference to the belting which they sold, and the plaintiffs could have no right to restrain them from doing so, even though, as the jury had found, the words "Camel-Hair Belting" would be understood to mean belting manufactured by the plaintiffs, and purchasers of the belting would be deceived into the belief that they were obtaining goods of the plaintiffs' manufacture. On appeal to the house of lords, the decision of the court of appeal was reversed. In stating his opinion in the house of lords, Lord Herschell, referring to the statement that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting, said: "I think the

fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification, differing from its primary one, and that, if it is used to persons in the trade who will understand it, and be known and intended to understand it, in its secondary sense, it will none the less be a falsehood that in its primary sense it may be true. A man who uses language which will convey to persons reading or hearing it a particular idea which is false, and who knows and intends this to be the case, is not surely to be absolved from a charge of falsehood because in another sense, which will not be conveyed, and is not intended to be conveyed, it is true. In the present case, the jury have found, and in my opinion there was ample evidence to justify it, that the words 'Camel Hair' had, in the trade, acquired a secondary signification in connection with belting; that they did not convey to persons dealing in belting the idea that it was made of camel's hair, but that it was belting manufactured by the plaintiffs. They have found that the effect of using the words in the manner in which they were used by the defendants would be to lead purchasers to believe that they were obtaining goods manufactured by the plaintiffs, and thus both to deceive them and to injure the plaintiff. On authority, as well as on principle, I think the plaintiffs are, on these facts, entitled to relief."

While in all of these cases elements of unfair competition were present, and while in none of them except the Glenfield starch case was it held that the plaintiff had a property right in the name or term in question, the same result was reached as if the plaintiff had acquired a technical trade-mark in the words or terms employed. The correct rule in reference to such terms has been stated by the court of appeals of Kentucky, in the case of *Metealfe v. Brand*,¹⁵¹ as follows: "While one who sells a product of a particular region of

¹⁵¹ (1887) 86 Ky. 331.

country cannot appropriate the name of that region to indicate the article he sells, to the exclusion of others who produce or sell a similar product of the same region, yet a geographical name, as applied to a manufactured article, in connection with which the manufacturer was the first to use it, may acquire a secondary meaning, and thus become a valid trademark, but such a right will not be declared or protected unless clearly shown." The same rule should doubtless be applied in reference to descriptive words.¹⁵²

¹⁵² See, also, *Gage-Downs Co. v. Featherbone Corset Co.* (1897) 83 Fed. 213; *Levy v. Waitt* (1894) 10 C. C. A. 227, 61 Fed. 1008; *Birmingham Vinegar Brewery Co. v. Powell* (1897) 66 Law J. Ch. 763; *Siegert v. Findlater* (1878) 7 Ch. Div. 801, 47 Law J. Ch. 233; *Seixo v. Provezende* (1866) 1 Ch. App. 192; *Newman v. Alvord* (1867) 49 Barb. (N. Y.) 588, affirmed 51 N. Y. 189.

In *Metcalf v. Brand* (1887) 86 Ky. 331, 345, Holt, J.: "If a geographical name be used as such, it cannot be protected as a trademark. Clearly, all persons living in a town or city may use its name as an address, and, of course, many persons may make the same article in the same town, and show that it is so manufactured, by having the name of the place stamped upon it, or printed upon the label or covering, as their address or place of business. * * * The general qualities of a natural product are indicated by the name of the region from whence it comes. All have a right to sell it, and, in doing so, to call it by the name of the section where it is produced, and from whence it originally came, as that, in effect, describes the article. Such a name indicates the quality, and not the producer or the ownership. All may use it with equal truth. * * * For these reasons, such phrases as 'Sea Island Cotton,' 'Hungarian Grass,' 'Kentucky Hemp,' or 'Virginia Tobacco' will not be protected as trade-marks. This is not so, however, of a manufactured article. The name of the place where it is made serves in no way to indicate its quality or composition; and where the manufacturer has given it a geographical name, which he was the first to use in connection with the article, it seems to us that it may, from long use in such connection, acquire a secondary meaning, and, instead of designating the place where the article is made, indicate its origin, or that it is the product of a particular manufacturer, or

made according to his method. When this is the case, it becomes, in our opinion, a valid trade-mark."

In *Parkland Hills Blue Lick Water Co. v. Hawkins* (1894) 95 Ky. 502, 505, Hazelrigg, J.: "The Blue Licks, the upper and lower, have been known since the early settlement of the state,—indeed, years before the formation of the state. It was at the lower springs that, in 1782, the memorable and sanguinary battle occurred between the whites and the Indians, making the spot historically renowned. Buffalo and other wild animals had well beaten 'traces' to and from this spring, which they frequented to lick the deposits from the water; hence the first name was 'The Licks.' The commercial value of the water was early recognized, and years ago the predecessors of the appellees adopted the name 'Blue Lick Water' as their trade-mark. * * * There is no conceivable reason why the name of a place may not be selected as a trade-mark, or the natural product of a spring be the subject of the protection afforded by it. * * * In the case under consideration, the name adopted by the appellees and their predecessors for the water from the Blue Lick Springs indicated the origin and ownership or place of the product, and is one in the exclusive use of which the appellees should be protected."

In *Hegeman & Co. v. Hegeman* (1880) 8 Daly (N. Y.) 1-4, Daly, C. J.: "A person may acquire the right known as the 'goodwill' in a business from its being established in a particular place, from which he has derived, or may derive, profit, and where there is attached to the business a name indicating to the public where, or in what manner, it is carried on; and this is a right which will be protected in a court of equity, even where he removes the business to another place. *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 232; *Harper v. Pearson*, 3 Law T. (N. S.) 547; *Howard v. Henriques*, 3 Sandf. (N. Y.) 725; *Christy v. Murphy*, 12 How. Pr. (N. Y.) 77."

In *El Modello Cigar Mfg. Co. v. Gato* (1889) 25 Fla. 886, 909, Mitchell, J.: "A man may establish his right to a trade-mark in the name of a place, city, or town, and it is well established that, when a man manufactures his goods at a particular place, and uses the name of that place in combination with other words as a trade-mark to distinguish the origin or ownership of his goods, no other person will be permitted to use the name of the same place upon goods manufactured by him at another and different place. *Delaware & H. Canal Co. v. Clark*, 13 Wall. (U. S.) 325; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y. 291; *Newman v. Alvord*, 51 N. Y. 189; *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226; *Sawyer v. Horn*, 1 Fed. 24; *Gilman v. Hunnewell*, 122 Mass. 139; *Robertson v. Berry*, 33 Am. Rep. 337, note 1. Under these de-

cl :ions, it will be seen that defendants [who manufactured at Jacksonville, and the complainants at Key West (page 889)] clearly had no right to use the name of the place,—Key West,—* * * either alone or in combination with the other words as alleged in the bill to have been used by them."

In *City of Carlsbad v. Thackery* (1891) 57 Fed. 18-20, Blodgett, Dist. J.: "Complainants charge that the city of Carlsbad, situated in Bohemia, in the empire of Austria, is the sole owner of the celebrated mineral springs of said city, and has for many years been engaged in the business of evaporating the waters of said springs, and thereby producing the essential salts contained in them, * * * and has put said salts upon the market under the names of 'Carlsbad Sprudel,' 'Carlsbad Salts,' and 'Carlsbad Sprudel Salts.' * * * That defendant has engaged in the business of making artificial salts, and putting them upon the market, and offering them for sale, by the names and designations of 'Carlsbad Sprudel,' and 'Carlsbad Sprudel (Artificial).' * * * An injunction is prayed, restraining defendant from making and selling any artificial salts as 'Carlsbad Salts,' or as 'Carlsbad Sprudel,' and from using the word 'Carlsbad' as the designation of the defendant's salts. * * * The term 'Carlsbad Sprudel Salts' means more than a mere combination, in certain proportions, of certain chemical elements. They mean an article produced by the complainant from the Carlsbad waters. Nor does the addition of the word 'artificial' by the defendant to its label enable the defendant to escape from the charge of wrongfully availing itself of complainants' name and reputation. * * * An injunction will be ordered as prayed."

In *City of Carlsbad v. Kutnow* (1895) 68 Fed. 794-796, Wheeler, Dist. J.: "The Carlsbad Springs appear to be owned by, and wholly within the control of, the city of Carlsbad, in Bohemia, and the waters of them, for many years, to have been evaporated into salts of highly medicinal qualities, in crystals and powder, well known for their curative properties, everywhere, as 'Carlsbad Sprudel Salz.' This bill is brought to restrain the defendants, who are dealers in drugs and medicines in New York, from further using the words 'Improved Effervescent Carlsbad Powder' in selling other salts of similar appearance and properties. * * * As the case stands here, the defendants appear to be using the name 'Carlsbad' upon artificial salts having no connection with that name, and to be using it only because of its connection with the genuine Carlsbad Sprudel Salts. Carlsbad, with its springs, is far away. * * * Allusion has been made to this word being the name of the city, to which ordinarily an exclusive right cannot be acquired; but it is also the

name of these peculiar springs, and gives the name to their products. Decree for the plaintiffs for an injunction and account." Affirmed (1895) in 18 C. C. A. 24, 71 Fed. 167, Lacombe, C. J.

In *Sanders v. Utt* (1884) 16 Mo. App. 322-327, Lewis, P. J.: "The plaintiff is a dentist, practicing his profession in the city of St. Louis. His petition states that for about twelve years past he has kept over the entrance to his place of business a sign bearing the words 'New York Dental Rooms,' and adds other particulars of fact which are sufficient to vest in him a proprietary right to those words, as descriptive of the place where his business is carried on, if the words themselves are capable of being held in such a right. * * * The grounds of objection chiefly relied on seem to be that, the words 'New York' being a mere geographical designation, and the word 'Dental' only a generic term of description applying to a business or occupation, there can be no proprietary right in either, and no infringement in any use of them by a person other than the plaintiff. * * * To say that a geographical name can never be used in proprietary right as a trade-mark states the rule far too broadly. When such a name is employed in connection with the place of manufacture or production, no person manufacturing or producing at that place can monopolize it against other persons manufacturing or producing at the same place. * * * But in *Newman v. Alvord*, 49 Barb. (N. Y.) 588, the controversy was about the word 'Akron,' which was the name of the village in New York where the plaintiffs manufactured a cement. * * * It was held that the plaintiffs had an exclusive right to use the word 'Akron,' except as against any person manufacturing at the same place. The defendants were therefore restrained from using the word, although it was a geographical name, because they had no factory at Akron. There is another class of cases, in which proprietary rights may be acquired in a geographical name. This occurs where the name is used, not for the purpose of indicating a particular locality, as in any way connected with the business, but only as a fancy designation, adopted for the sole purpose of distinguishing the factory, or its business, or the particular persons engaged therein, from all other institutions or persons identified with the same pursuit. * * * We think, therefore, that the petition sufficiently shows a proprietary right in the plaintiff to the title 'New York,' as descriptive of his professional abode, and an unlawful infringement of his right by the defendant. To this extent, therefore, the demurrer should have been overruled."

In *Amoskeag Mfg. Co. v. Garner* (1876) 54 How. Pr. (N. Y.) 297, 301, Barrett, J.: "It is not disputed that, so far as the word 'Amos-

keag' has been applied by plaintiff to cotton goods actually manufactured and sold by it, the use of such word is its exclusive right. The claim is that, as to any description of cotton goods which the plaintiff has not yet produced, the word 'Amoskeag' is common property, and that therefore the defendants were at liberty to apply it as their trade-mark, even as against the plaintiff, to prints or calicoes. This claim rests upon the assumption that the word 'Amoskeag' is simply the plaintiff's trade-mark,—that is, a geographical name, in which the plaintiff can have no exclusive property except so far as it has been actually applied. It ignores the fact that the word stands for and is, in reality, the distinctive part of the plaintiff's corporate name. * * * The manufacturer of cement, for instance, might apply the word 'Amoskeag' to that article, because, when stamped upon cement, it would not stand for 'The Amoskeag Manufacturing Company.' In that connection, it would be a mere geographical designation, in which, per se, no one has an exclusive right until applied, and not, in effect, the plaintiff's name. Its use, consequently, would deceive no one, because it would not convey the idea, and therefore would not represent that the cement was the plaintiff's production."

In *St. Louis Carbonating & Mfg. Co. v. Eclipse Carbonating Co.* (1894) 58 Mo. App. 411, 416, Bond, J.: "The question arising for decision is whether or not there was such a prior use of the terms 'New Orleans Mead,' at the time of their adoption as a trade-mark by plaintiff's assignors, as to render them *publici juris*, and therefore not subject to appropriation as a trade-mark. In considering this question, we shall concede that the fact that New Orleans is the name of a place is not an objection to its adoption as a trade-mark or trade label, when it is not employed in a geographical sense, but is only used as a term of fancy to designate the origin or ownership of an article. *Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co.*, 104 Mo. 53; *Sanders v. Utt*, 16 Mo. App. 322."

In *Dunbar v. Glenn* (1877) 42 Wis. 118, 137, Cole, J.: "It will avail little to resort to the original meaning of the word 'Bethesda,' as defined by biblical writers. It is sufficient to say that the word, as used by the plaintiff, does not describe any quality of the water. It seems to have been adopted to indicate origin or ownership, and to have a name by which the water could be distinguished when bought and sold in the market. The plaintiff has a right to the exclusive use of the word, when employed as a trade-mark, for such purpose. The cases cited on the brief of defendants' counsel clearly recognize such a right. Where the trade-mark, in its original signification or association distinctively points to the origin or ownership

of the article to which it is applied, it will be protected; but where it is a generic or geographical name, designating a city or district of country, or is merely descriptive of the article manufactured, and can be employed with truth by other manufacturers, it is not entitled to legal protection as a trade-mark. *Delaware & H. Canal Co. v. Clark*, 13 Wall. (U. S.) 311; *Brooklyn White Lead Co. v. Masury*, 25 Barb. (N. Y.) 416; *Wolfe v. Goulard*, 18 How. Pr. (N. Y.) 64; *Burke v. Cassin*, 45 Cal. 468; *Stokes v. Landgraff*, 17 Barb. (N. Y.) 608; *Corwin v. Daly*, 7 Bosw. (N. Y.) 222; *Caswell v. Davis*, 58 N. Y. 223; *Taylor v. Gillies*, 59 N. Y. 331; *Choynski v. Cohen*, 39 Cal. 501; *Perry v. Truefitt*, 6 Beav. 66. But this case does not fall within any of the exceptions stated to the rule in the above cases. Here the plaintiff adopted and applied the name 'Bethesda' to her spring, to mark or distinguish the waters thereof in the market, and she has the right to its exclusive use. It is not intended to, nor does it, indicate the quality or constituents of the water, but rather its origin or ownership."

In *Lea v. Wolf* (1873) 15 Abb. Pr. (N. S.; N. Y.) 1, 5, Fancher, J.: "Where words or names are in common use, no one person can claim a special appropriation of them to his peculiar use; but where words, and the allocation of words, have, by long use, become known as designating the article of a particular manufacturer, he acquires a right to them as a trade-mark, which competing dealers cannot fraudulently invade. The essence of the wrong is the false representation and deceit. When the improper design is apparent, an injunction should be issued. In such cases, injunctions have been sustained, though the name of a place, or of a celebrated person, were within the trade-mark protected by the injunction. *Messerole v. Tynberg*, 4 Abb. Pr. (N. S.; N. Y.) 410; *Matsell v. Flanagan*, 2 Abb. Pr. (N. S.; N. Y.) 457; *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. (N. Y.) 599; *Caswell v. Davis*, 4 Abb. Pr. (N. S.; N. Y.) 6; *Newman v. Alvord*, 49 Barb. (N. Y.) 588, affirmed 51 N. Y. 189; *Wotherspoon v. Currie*, 27 Law T. (N. S.) 393. * * * As a general rule, geographical names cannot be appropriated as trade-marks, but the rule has its exception where the intention in the adoption of the descriptive word is not so much to indicate the place of manufacture as to intrench upon the previous use and popularity of another's trade-mark. The order appealed from (13 Abb. Pr. [N. S.; N. Y.] 389) should be modified, and the injunction extended so as to prohibit the use of the words 'Worcestershire Sauce' on the bills, labels, and wrappers of defendants."

CHAPTER III.

WHAT CANNOT BE APPROPRIATED.

- § 60. General Rules.
- 61. Device not Distinctive in Character.
- 62. Mark That does not Primarily Indicate Origin or Ownership.
- 63. Descriptive Words.
- 64. Instances of Descriptive Words Held Invalid as Trade-Marks.
- 65. Descriptive Words Deceptively Applied.
- 66. Words or Symbols Previously Used as Marks for Like Goods.
- 67. Geographical Names.
- 68. Personal Names.
- 69. Pseudonym or Nom-de-Plume.
- 70. Legislative Incorporation of Personal Name.
- 71. Use of Personal Name as Trade-Mark for Contract Term.
- 72. Personal Name may Become Generic.
- 73. Personal Name Descriptive of Medical Preparation.
- 74. Mere Use of Like Personal Name by Competing Owners.
- 75. Letters or Numerals Used for Certain Purposes.
- 76. Mere Color of Advertisements, Labels, and Manufactured Articles.
- 77. Material.
- 78. Parts of Mark Designed to Indicate Facts Other than Origin or Ownership.
- 79. Color, Form, Material, or Mode of Construction of Package, Article Manufactured, etc.

§ 60. General rules.

The general rules as to what cannot be appropriated as trade-marks have been stated by the supreme court of the United States in the leading case of *Delaware & H. Canal Co. v. Clark*, as follows: "No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could,

the public would be injured, rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark, and the exclusive use of it be entitled to legal protection. As was said in the well-considered case of *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. (N. Y.) 599: 'The owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed, but he has no right to the exclusive use of any words, letters, figures, or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their names or quality. He has no right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.' And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and; could they be appropriated exclusively, the appropriation would result in mischievous monopolies. Could such phrases as 'Pennsylvania wheat,' 'Kentucky hemp,' 'Virginia tobacco,' or 'Sea Island cotton' be protected as trade-marks,—could any one prevent all others from using them, or from selling articles produced in the districts they describe under those appella-

(102)

tions,—it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common right of many. It can be permitted only when the reasons that lie at the foundation of the protection given to trade-marks are entirely overlooked. It cannot be said that there is any attempt to deceive the public when one sells as Kentucky hemp or as Lehigh coal that which in truth is such, or that there is any attempt to appropriate the enterprise or business reputation of another who may have previously sold his goods with the same description. It is not selling one man's goods as and for those of another. Nothing is more common than that a manufacturer sends his products to market, designating them by the name of the place where they were made; but we think no case can be found in which other producers of similar products in the same place have been restrained from the use of the same name in describing their goods.”¹

From the foregoing quotation it will be seen that two classes of words are here designated as incapable of appropriation as trade-marks. These are, first, descriptive words; second, geographical names designating districts of country. To these may be added, third, personal names, which cannot be generally appropriated against others bearing the same names, and using them in good faith, but which may be appropriated in any peculiar or fanciful form, even against others bearing the same names. It is thus apparent that nothing can be legally appropriated by any one as a trade-mark which, aside from superiority in excellence, popularity, or cheapness

¹ (1871) 13 Wall. (U. S.) 311. See, also, *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51; *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1888) 128 U. S. 598; *Brown Chemical Co. v. Meyer* (1891) 139 U. S. 540; *Columbia Mill Co. v. Alcorn* (1893) 150 U. S. 460; *Caswell v. Davis* (1874) 58 N. Y. 231; *Thomson v. Winchester* (1837) 19 Pick. (Mass.) 214; *Raggett v. Findlater* (1873) L. R. 17 Eq. 29; (1849) 2 Sandf. (N. Y.) 599.

of the article bearing it, would practically confer on him a monopoly in the production or sale of like articles.² The supreme court of Rhode Island has stated the rules which must be followed in selecting a trade-mark as follows: "A trade-mark is a symbol, arbitrarily selected by a manufacturer or dealer, and attached to his wares to indicate that they are his wares. In selecting such a device, he must avoid words merely descriptive of the article or its qualities, or such as have become so by use in connection with well-known articles of commerce. He must also avoid words, *e. g.*, geographical names, which are descriptive of the local origin of the goods, if other persons have the right to deal in goods of a similar origin."³

§ 61. Device not distinctive in character.

From the definition of a trade-mark heretofore given, it is apparent that, unless a mark or device is distinctive in character, pointing unmistakably, either by its own meaning or by association, to the origin or ownership of the article to which it is affixed, it cannot be a valid trade-mark. In *Candee v. Deere*,⁴ it is said by the supreme court of Illinois: "All [courts] concur in saying that the mark must be so clear and well defined as to give notice to others, and must not be deviated from at the suggestion of whim or caprice." Where a series of books were published, on the first of which appeared, as a frontispiece, a representation of a figure in a particular dress, and, as a frontispiece to the subsequent books, other figures, each bearing some slight resemblance to each other and to the first figure, but in different attitudes, with

² *Brown Chemical Co. v. Meyer* (1891) 139 U. S. 540; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

³ *Cady v. Schultz* (1895) 19 R. I. 193.

⁴ (1870) 54 Ill. 439-457.

different surroundings, and each conveying an entirely different impression, it was held that such pictures did not constitute a distinctive device, and could not be held as a trademark.⁵ In *Candee v. Deere*, and also in *Foster v. Blood Balm Co.*,⁶ it is questioned whether a person can appropriate two or more trade-marks for the same goods in the same commerce. In a late case decided by the circuit court for the eastern district of Wisconsin it appeared that a manufacturer of toilet paper used a large number of different brands for the same article, and in the bill filed the complainant sought to enjoin the use by the defendant of thirteen different trade-marks. The court found that the brands were used to designate in some cases the quality, and in other cases the size of the sheets. Upon the question whether these different brands could all constitute trade-marks for the same article, the court said: "The principal question which is suggested by the bill and the evidence is whether the manufacturer of a single article has the right to use, and to be protected in the use of, more than one trade-mark for that article. I find little authority upon the subject, and have given to the question much consideration. Upon principle, I think that he cannot. A trade-mark must denote origin. * * * How can that purpose be accomplished if a manufacturer dealing in a single article used a thousand different trade-marks to designate the article and its origin? Such use necessarily produces confusion, and fails of the single purpose of the trade-mark,—to designate with certainty the origin of the product."⁷ It would seem, however, to be settled by competent authority, that the rule above stated does not prevent a manufacturer or

⁵ *Munro v. Smith* (1890) 55 Hun (N. Y.) 419.

⁶ (1887) 77 Ga. 216.

⁷ *Albany Perforated Wrapping-Paper Co. v. John Hoberg Co.* (1900) 102 Fed. 157.

dealer from appropriating different trade-marks for different grades of goods of the same general kind, or different species of goods of the same genus.⁸ Each case is to be tested by considering the primary function of the mark adopted. If the primary function is to denote origin or ownership, and the mark is distinctive, it is a valid trade-mark. If the primary function is to indicate grade or quality, the mark is invalid for the purposes of a trade-mark.

§ 62. Mark that does not primarily indicate origin or ownership.

To constitute a trade-mark, the mark or symbol used must be designed, as its primary purpose, to distinguish each of the articles to which it is affixed from like articles produced by others. If it is originally adopted for some other purpose, such as to designate the size, shape, and capacity of the article, so that any office it may perform as a designation of origin is merely incidental, no trade-mark right is acquired. There can be no valid trade-mark in a device or word which is placed upon an article, not for the purpose of indicating origin, manufacture, or ownership, but merely as designating quality, class, grade, or style.⁹ Hence, where it appeared that letters and numerals claimed as a trade-

⁸ *Cahn v. Gottschalk* (1888) 14 Daly (N. Y.) 542; *American Solid Leather Button Co. v. Anthony* (1886) 15 R. I. 338; *Scott v. Standard Oil Co.* (1894) 105 Ala. 475.

⁹ *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 33 C. C. A. 558, 91 Fed. 376; *Columbia Mill Co. v. Alcorn* (1893) 150 U. S. 460; *New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co.* (1900) 99 Fed. 85; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537; *Humphreys Homeopathic Medicine Co. v. Hilton* (1894) 60 Fed. 756; *Smith & Davis Mfg. Co. v. Smith* (1898) 89 Fed. 486; *Beadleston v. Cook Brewing Co.* (1896) 20 C. C. A. 405, 74 Fed. 229; *Royal Baking Powder Co. v. Sherrell* (1883) 93 N. Y. 321.

mark were adopted to denote or indicate origin or ownership, as well as the shape, size, style, and quality of the complainant's goods, but it did not appear clearly whether such letters or figures were adopted primarily for the purpose of indicating this origin or ownership of the goods, and on the face of the bill and exhibits there was a serious question whether it did not appear that the letters and figures only secondarily pointed to origin or ownership, it was held that the bill could not be sustained.¹⁰ Terms which are descriptive of products, and identify the manufactured article to which they are applied, rather than the manufacturer, cannot be appropriated as trade-marks.¹¹

§ 63. Descriptive words.

The general proposition is therefore well established that words which are merely descriptive of the character, qualities, or composition of an article cannot be monopolized as trade-marks.¹² If, however, the primary object of the mark

¹⁰ *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹¹ *Leclanche Battery Co. v. Western Electric Co.* (1885) 23 Fed. 276; *Proctor & Gamble Co. v. Globe Refining Co.* (1899) 34 C. C. A. 405, 92 Fed. 357; *Thomas G. Plant Co. v. May Co.* (1900) 100 Fed. 72; *Ferguson v. Davol Mills* (1868) 2 Brewst. (Pa.) 314; *Marcus Ward & Co. v. Ward* (1891) 61 Hun, 625, 15 N. Y. Supp. 913; *Fetridge v. Wells* (1857) 4 Abb. Pr. (N. Y.) 144; *Wolfe v. Burke* (1873) 7 Lans. (N. Y.) 151; *Merriam v. Famous Shoe & Clothing Co.* (1891) 47 Fed. 411; *Wilcox & Gibbs Sewing Mach. Co. v. The Gibbens Frame* (1883) 17 Fed. 623; *Hostetter v. Fries* (1883) 17 Fed. 620; *Smith v. Walker* (1885) 57 Mich. 456.

¹² *Ayer v. Rushton* (1877) 7 Daly (N. Y.) 9; *Newman v. Alvord* (1867) 49 Barb. (N. Y.) 588; *Alden v. Gross* (1887) 25 Mo. App. 123; *Chadwick v. Covell* (1890) 151 Mass. 190; *Alff & Co. v. Radam* (1890) 77 Tex. 530; *Siegert v. Abbott* (1893) 72 Hun (N. Y.) 243; *Schmidt v. Brieg* (1893) 100 Cal. 672; *Nokes v. Mueller* (1897) 72 Ill. App. 431; *Clinton Metallic Paint Co. v. New York Metallic Paint Co.* (1898) 23 Misc. Rep. (N. Y.) 66; *Scott v. Standard Oil Co.* (1894) 106 Ala. 475; *Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco*

be to indicate origin or ownership, the mere fact that, after the adoption of the mark, the article has obtained such a wide sale that the mark has also become indicative of quality, is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. It is no objection to a word used as a trade-mark that it is suggestive of the qualities or grade of the article upon which it is used, if not actually descriptive thereof. Words of common use may be so employed as to acquire a limited additional significance by way of designating a particular article of manufacture or production, and in that sense may be entitled to the protection of the court against an infringement upon such use by others; but when the words signify a fact which others may, by the use of them, express with equal truth, such others

Co. (1890) 104 Mo. 53; Wolfe v. Goulard (1859) 18 How. Pr. (N. Y.) 64; Comstock v. Moore (1860) 18 How. Pr. (N. Y.) 421; Corwin v. Daly (1860) 7 Bosw. (N. Y.) 222; Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192; Phalon v. Wright (1864) 5 Phila. (Pa.) 464; Fulton v. Sellers (1867) 4 Brewst. (Pa.) 42; Falkinburg v. Lucy (1868) 35 Cal. 52; Boardman v. Meriden Britannia Co. (1868) 35 Conn. 402; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Choynski v. Cohen (1870) 39 Cal. 501; Wolfe v. Burke (1873) 7 Lans. (N. Y.) 151; Burke v. Cassin (1873) 45 Cal. 467; Chase v. Mayo (1876) 121 Mass. 343; Carmichel v. Latimer (1876) 11 R. I. 395; Helmbold v. Helmbold Mfg. Co. (1877) 53 How. Pr. (N. Y.) 453; Gilman v. Hunnewell (1877) 122 Mass. 139; Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Val Beil v. Prescott (1880) 82 N. Y. 630; Marshall v. Pinkham (1881) 52 Wis. 572; Larrabee v. Lewis (1881) 67 Ga. 561; Royal Baking Powder Co. v. Sherrell (1883) 93 N. Y. 331; Leclanche Battery Co. v. Western Electric Co. (1885) 23 Fed. 276; American Shield Leather Button Co. v. Anthony (1886) 15 R. I. 338; Metcalfe v. Brand (1887) 86 Ky. 331; In re Pratt's Appeal (1888) 117 Pa. 401; Putnam Nail Co. v. Dulaney (1891) 140 Pa. 205; Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1900) 99 Fed. 971; Thomas G. Plant Co. v. May Co. (1900) 100 Fed. 72; Koehler v. Sanders (1890) 122 N. Y. 65; Oakes v. St. Louis Candy Co. (1898) 146 Mo. 391; Babbitt v. Brown (1893) 68 Hun (N. Y.) 515; Enoch Morgan's Sons Co. v. Troxell (1882) 89 N. Y. 292.

have an equal right to use them for that purpose.¹³ The supreme court of Canada has stated the rule upon this point as follows: "Property can not be acquired in marks, etc., known to a particular trade as designating quality merely, and not, in themselves, indicating that the goods to which they are affixed are the manufacture of a particular person. Nor can property be acquired in an ordinary English word expressive of quality merely, though it might be in a foreign word or word of a dead language."¹⁴

§ 64. Instances of descriptive words held invalid as trade-marks.

There are numerous instances in the reported cases of descriptive words that have been held invalid as trade-marks. There are many other instances of words that have been held merely suggestive of the qualities of the article upon which they were used, and hence capable of appropriation as trade-marks. Thus, the word "Cream"¹⁵ has been held capable of appropriation as a trade-mark for baking powder, which decision would seem to be sound, while the word "Snowflake"¹⁶ has been held incapable of appropriation as a trade-mark for bread or crackers, on the ground of being "descriptive of whiteness, lightness, and purity." It would seem, however, that this word is suggestive of such qualities, rather than descriptive of them, and that it should have been held capable of appropriation. Other instances of descriptive words incapable of appropriation as trade-marks are as follows: "Iron Bitters,"¹⁷ for a medicinal preparation; "Goodyear

¹³ *Stokes v. Allen* (1890) 56 Hun (N. Y.) 526.

¹⁴ *Partlo v. Todd* (1888) 17 Can. Sup. Ct. 196.

¹⁵ *Price Baking Powder Co. v. Fyfe* (1891) 45 Fed. 799.

¹⁶ *Larrabee v. Lewis* (1881) 67 Ga. 562.

¹⁷ *Brown Chemical Co. v. Meyer* (1891) 139 U. S. 540.

Rubber,"¹⁸ for rubber articles; "Dr. Johnson's Yellow Ointment";¹⁹ "Velno's Vegetable Syrup,"²⁰ and "Perry's Medicated Mexican Balm,"²¹ each used for a medicine; "Nourishing Stout,"²² for beer; "Thomsonian Medicines";²³ "Dessicated Codfish";²⁴ "Julienne Soup";²⁵ "Paraffin Oil";²⁶ "Ferro-Phosphorated Elixir of Calisaya Bark";²⁷ "Microbe Killer";²⁸ "Sarsaparilla and Iron,"²⁹ for a medicinal compound or beverage, including sarsaparilla and iron as ingredients; "Compressed Yeast";³⁰ "Aluminum,"³¹ applied to an article of manufacture composed in part of that metal; "Sweet Caporal,"³² applied to cigarettes; "Fruit,"³³ applied to vinegar; "Fire-Proof Oil,"³⁴ for an illuminating oil; "Liver Medicine";³⁵ "Headache Wafers";³⁶ "Steel Clad,"³⁷ for

¹⁸ *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1888) 128 U. S. 598.

¹⁹ *Singleton v. Bolton* (1783) 3 Dougl. 293.

²⁰ *Canham v. Jones* (1813) 2 Ves. & B. 218.

²¹ *Perry v. Truefitt* (1842) 6 Beav. 66.

²² *Raggett v. Findlater* (1873) L. R. 17 Eq. 29.

²³ *Thomson v. Winchester* (1837) 19 Pick. (Mass.) 214.

²⁴ *Town v. Stetson* (1868) 5 Abb. Pr. (N. S.; N. Y.) 218.

²⁵ *Godillot v. Harris* (1880) 81 N. Y. 263.

²⁶ *Young v. Macrae* (1862) 9 Jur. (N. S.) 322.

²⁷ *Caswell v. Davis* (1874) 58 N. Y. 223.

²⁸ *Alff & Co. v. Radam* (1899) 77 Tex. 530; *Radam v. Capitol Microbe Destroyer Co.*, 81 Tex. 122.

²⁹ *Schmidt v. Brieg* (1893) 100 Cal. 672.

³⁰ *Fleischmann v. Newman* (1888) 16 N. Y. St. Rep. 794, 2 N. Y. Supp. 608.

³¹ *American Washboard Co. v. Saginaw Mfg. Co.* (1900) 43 C. C. A. 233, 103 Fed. 281.

³² *Hornbostel v. Kinney* (1885) 20 Jones & S. (N. Y.) 41.

³³ *Alden v. Gross* (1887) 25 Mo. App. 123.

³⁴ *Scott v. Standard Oil Co.* (1894) 106 Ala. 475.

³⁵ *C. F. Simmons Medicine Co. v. Mansfield Drug Co.* (1893) 93 Tenn. 84.

³⁶ *Gessler v. Grieb* (1891) 80 Wis. 21.

³⁷ *Brennan v. Emery-Bird-Thayer Dry-Goods Co.* (1900) 99 Fed. 976; affirmed (1901) 47 C. C. A. 532, 108 Fed. 624.

shoes; "Trademark—Best Soap";³⁸ "What is it?" for candy;³⁹ "Syrup of Figs" or "Fig Syrup," held descriptive in one case, and not descriptive in another (the first decision⁴⁰ was by the circuit court of appeals for the sixth circuit, and the other⁴¹ by the circuit court of appeals for the ninth circuit); "Instantaneous,"⁴² for a preparation of tapioca; "Taffy Tolu,"⁴³ applied to chewing gum; "Air Brush,"⁴⁴ for an instrument designed for the distribution of pigments by means of an air blast to produce pictures; "Acid Phosphate,"⁴⁵ applied to a medicinal preparation; "Straight Cut,"⁴⁶ as a trade-mark for cigarettes or smoking tobacco; "Cramp Cure,"⁴⁷ applied to a medicine; "Hygienic,"⁴⁸ applied to underwear; "Cresylic,"⁴⁹ for a compound made from cresylic acid; "Matzoon,"⁵⁰ for an article which has been made for centuries in Armenia from sterilized and fermented milk; "Crystallized Egg,"⁵¹ for preserved egg meat; "Indurated Fibre,"⁵² applied to wares made of wood pulp; "Patent Roof-

³⁸ *Babbitt v. Brown* (1893) 68 Hun (N. Y.) 515.

³⁹ *Oakes v. St. Louis Candy Co.* (1898) 146 Mo. 391.

⁴⁰ *California Fig Syrup Co. v. Frederick Stearns & Co.* (1896) 20 C. C. A. 22, 73 Fed. 812.

⁴¹ *Worden v. California Fig Syrup Co.* (1900) 42 C. C. A. 382, 162 Fed. 334.

⁴² *Bennett v. McKinley* (1895) 13 C. C. A. 25, 65 Fed. 505.

⁴³ *Colgan v. Dörzheiser* (1888) 35 Fed. 150.

⁴⁴ *Air-Brush Mfg. Co. v. Thayer* (1897) 84 Fed. 640.

⁴⁵ *Rumford Chemical Works v. Muth* (1888) 35 Fed. 524.

⁴⁶ *Ginter v. Kinney Tobacco Co.* (1882) 12 Fed. 782.

⁴⁷ *L. H. Harris Drug Co. v. Stucky* (1891) 46 Fed. 624.

⁴⁸ *Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co.* (1894) 65 Fed. 424.

⁴⁹ *Carbolic Soap Co. v. Thompson* (1885) 25 Fed. 625.

⁵⁰ *Dadirrian v. Yacubian* (1900) 37 C. C. A. 321, 98 Fed. 872.

⁵¹ *Lamont v. Leedy* (1898) 88 Fed. 72.

⁵² *Indurated Fibre Co. v. Amoskeag Indurated Fibre Co.* (1889) 37 Fed. 695.

ing";⁵³ "Health Preserving,"⁵⁴ for a corset; "Selected Shore Mackerel";⁵⁵ "Best Six Cord" and "200 yds.";⁵⁶ a sign placed over a man's place of business, with a row of beer barrels painted on it, the letters "P B" stamped or printed on the head of each barrel, the words "Depot of the Celebrated" placed above, and the words "Philadelphia Beer" placed below;⁵⁷ "Imperial,"⁵⁸ for beer; "Centennial,"⁵⁹ for medals; "One Night Cough Cure" and "One Night Corn Cure";⁶⁰ "Rye and Rock,"⁶¹ for a mixture of rye whiskey and rock candy; "Borax Soap";⁶² "Cherry Pectoral,"⁶³ for a medicine; "Gold Medal";⁶⁴ "Aromatic Schiedam Schnapps,"⁶⁵ for gin; "Club House,"⁶⁶ for gin; "Old London Dock Gin";⁶⁷ "Air-Cell" and "Fire Board";⁶⁸ "Clinton Hematite Red" and "Metallic Clinton Paint";⁶⁹ "Webster's Dictionary,"⁷⁰ for a publication; "Night-Blooming Cereus,"⁷¹ for a perfume.

⁵³ *Fay's Adm'rs v. Fay* (1886) 4 Cent. Rep. 241.

⁵⁴ *Ball v. Siegel* (1886) 116 Ill. 137.

⁵⁵ *Trask Fish Co. v. Wooster* (1888) 28 Mo. App. 408.

⁵⁶ *Coats v. Merrick Thread Co.* (1893) 149 U. S. 562.

⁵⁷ *Eggers v. Hink* (1883) 63 Cal. 445.

⁵⁸ *Beadleston v. Cook Brewing Co.* (1896) 20 C. C. A. 405, 74 Fed. 229.

⁵⁹ *Hartell v. Viney* (1876) 2 Wkly. Notes Cas. 602, Fed. Cas. No. 6,158.

⁶⁰ *Kohler Mfg. Co. v. Beeshore* (1892) 53 Fed. 262.

⁶¹ *Van Beil v. Prescott* (1880) 82 N. Y. 630.

⁶² *Dreydoppel v. Young* (1880) 14 Phila. (Pa.) 226.

⁶³ *Ayer v. Rushton* (1877) 7 Daly (N. Y.) 9.

⁶⁴ *Taylor v. Gillies* (1874) 59 N. Y. 331.

⁶⁵ *Burke v. Cassin* (1873) 45 Cal. 467.

⁶⁶ *Corwin v. Daly* (1860) 7 Bosw. (N. Y.) 222.

⁶⁷ *Bininger v. Wattles* (1865) 28 How. Pr. (N. Y.) 206.

⁶⁸ *New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co.* (1900) 99 Fed. 85.

⁶⁹ *Clinton Metallic Paint Co. v. New York Metallic Paint Co.* (1898) 23 Misc. Rep. (N. Y.) 66.

⁷⁰ *Merriam v. Famous Shoe & Clothing Co.* (1891) 47 Fed. 411; *Merriam v. Texas Siftings Pub. Co.* (1892) 49 Fed. 944.

§ 65. Descriptive words deceptively applied.

It has frequently occurred that a person claiming a descriptive word as a trade-mark has sought to avoid the claim that the word was merely descriptive of the character, qualities, or composition of the article upon which it is used, by showing that such word was not in fact descriptive of such character, qualities, or composition. This, however, brings such word under another and equally fatal rule,—that a court of equity will not lend its aid to sustain a trade-mark when misrepresentations as to the nature or origin of articles are made in, or in connection with, the trade-mark by the aid of which the articles seek a market.⁷² “If the word or words are properly applicable to the article, and may be truly used with respect to it, they are descriptive. * * * If they may be read as stating something with respect to the article which is untrue, they are deceptive, * * * so that *quacunq̄ue via* the application must fail.”⁷³ This rule is more fully discussed in a subsequent chapter.⁷⁴

§ 66. Words or symbols previously used as marks for like goods.

A valid trade-mark cannot be acquired in a word which has been previously appropriated and used by other parties as a brand for like goods. Thus, where the word “Columbia” was shown to have been in use as a brand upon sacks or barrels of flour long before its appropriation by complainant, it

⁷¹ Phalon v. Wright (1864) 5 Phila. (Pa.) 464.

⁷² Church v. Proctor (1895) 13 C. C. A. 426, 66 Fed. 240; Manhattan Medicine Co. v. Wood (1882) 108 U. S. 218; Dadirrian v. Yachbian (1900) 39 C. C. A. 321, 98 Fed. 872, 876; California Fig Syrup Co. v. Putnam (1895) 16 C. C. A. 376, 69 Fed. 740; Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H. L. Cas. 523; Koehler v. Sanders (1890) 122 N. Y. 65.

⁷³ Seb. Trade-Marks (4th Ed.) 351.

⁷⁴ Chapter 11.

was held that complainant could have no exclusive right there-to.⁷⁵ Where an oil-burning lamp, called the "Astral-Lamp," had been long well known and in common use, the court was of opinion that the word "Astral" was without the range of lawful appropriation as a trade-mark for refined petroleum.⁷⁶ Where the word "Matzoon" had been in use in Armenia to designate an article of food made of fermented milk, it was held that such word could not be appropriated as a trade-mark by the manufacturer who first introduced both the name and the article into the United States.⁷⁷ Where plaintiffs had invented and prepared a medicine for chest diseases, to which they gave the name of "Cherry Pectoral," and which was extensively sold as "Ayer's Cherry Pectoral," and one of the ingredients was extract of wild cherry, and the word "Pectoral" had been, before the invention of plaintiffs' medicine, applied to medicines for chest diseases, it was held that plaintiffs could not claim the exclusive use of the words "Cherry Pectoral" as a trade-mark.⁷⁸ Where the word "Club House" was proven to have been long in use as designating a superior kind of gin used in such establishments, it was held that no one could appropriate such words as a trade-mark.⁷⁹ And it was doubted whether plaintiff could appropriate to his own use, as a trade-mark, the picture of an animal, from which not only his own, but the lard of all other dealers and manufacturers, is derived, particularly when the same symbol had been used indiscriminately by dealers in lard and other products of the slaughtered animal.⁸⁰ Where A. had adopted, in 1878, and registered in the patent office in 1883, the

⁷⁵ *Columbia Mill Co. v. Alcorn* (1893) 150 U. S. 460.

⁷⁶ *Pratt Mfg. Co. v. Astral Refining Co.* (1886) 27 Fed. 492.

⁷⁷ *Dadirrian v. Yacubian* (1896) 72 Fed. 1010; (1898) 90 Fed. 812.

⁷⁸ *Ayer v. Rushton* (1877) 7 Daly (N. Y.) 9.

⁷⁹ *Corwin v. Daly* (1860) 7 Bosw. (N. Y.) 222.

⁸⁰ *Popham v. Cole* (1876) 66 N. Y. 69.

name "Kaiser" as a trade-mark for natural mineral water, and used it in foreign commerce, selling the water in bottles labeled "Kaiser Natural Mineral Water," with the words "Kaiser Water, Schwalheim," blown in the glass, and it appeared that mineral water known as "Kaiserquelle" or "Kaiserbrunnen," which in English mean "Kaiser Spring," "Kaiser Fountain," had been sold in various places in Europe, with the addition of the name of the place where the spring from which the water was obtained was located, it was held that the word "Kaiser" was not a valid trade-mark, as other parties had acquired and exercised the right to use it.⁸¹

§ 67. Geographical names.

The rule laid down in *Delaware & H. Canal Co. v. Clark*⁸² has been repeated in many later cases. In that case it was held that the word "Lackawanna," which is the name of a region of country in Pennsylvania, could not, in combination with the word "Coal," constitute a trade-mark, because every one who mines coal in the valley of Lackawanna had a right to represent his coal as Lackawanna coal. Speaking for the court, Mr. Justice Strong said: "The word 'Lackawanna' was not devised by the complainants. They found it a settled and known appellative of the district in which their coal deposits, and those of others, were situated. At the time when they began to use it, it was a recognized description of the region, and of course of the earths and minerals in the region. * * * And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation

⁸¹ *Luyties v. Hollendeer* (1887) 30 Fed. 632. See, also, *Corbin v. Gould* (1890) 133 U. S. 308; *Hoyt v. Hoyt* (1891) 143 Pa. 623.

⁸² (1871) 13 Wall. (U. S.) 311-327.

of geographical names, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and, could they be appropriated exclusively, the appropriation would result in mischievous monopolies. * * * It must be then considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation." And in *Columbia Mill Co. v. Alcorn*,⁸³ Mr. Justice Jackson, in delivering the opinion of the court, said: "The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade-mark than he would have been to the use of the word 'America,' or 'United States,' or 'Minnesota,' or 'Minneapolis.' These merely geographical names cannot be appropriated and made the subject of an exclusive property. They do not, in and of themselves, indicate anything in the nature of origin, manufacture, or ownership, and in the present case the word 'Columbia' gives no information on the subject of origin, production, or ownership." It has also been held that the words "East Indian," in connection with "Remedy," placed upon bottles of medicine, were not the subject of a trade-mark. Chief Justice Gray, delivering the opinion of the court in that case, said: "That it is at least doubtful whether words in common use as designating a vast region of country and its products can be appropriated by any one as his exclusive trade-mark, separately from his own or some other name, in which he has a peculiar right."⁸⁴ So, where a manufacturer of plows at Moline had

⁸³ (1893) 150 U. S. 460.

⁸⁴ *Connell v. Reed* (1880) 128 Mass. 477.

been accustomed to brand or stencil upon the beams of his plows, under his name, the words "Moline, Ill.," and subsequently another manufacturer of plows in the same place branded plows which he manufactured there under his own name with the same words, "Moline, Ill.," it was held there was no violation of any right in the former, because he could not acquire any property in those words which only indicated the place at which the plows were made.⁸⁵ So, also, where a limited partnership built a furnace called the "Glendon Iron Works," and the same year used the word "Glendon" for stamping their pigs of iron, and a successor corporation continued the business, and adopted and used the mark "Glendon," and finally became the "Glendon Iron Works," and twenty-three years after the invention and adoption of the mark, the locality of and surrounding the works of said corporation was incorporated as a borough, named "Glendon," it was held by the supreme court of Pennsylvania that the incorporation of said borough by that name deprived the corporation of the exclusive right to the use of the mark "Glendon," and that another corporate manufacturer of iron within said borough could lawfully use said name as a mark for its product.⁸⁶ In *Clinton Metallic Paint Co. v. New York Metallic Paint Co.*⁸⁷ the supreme court of New York said that the name of a place or country cannot be exclusively appropriated as a trade-mark for a product or ware of such place or country, as against one offering for sale a similar product or ware of the same place or country, and is only good against one using it for a product or ware not of such place or country. If it be used arbitrarily or fancifully, it is only good against one using it in the same way, and not against one using it truthfully, namely, in its actual meaning. In a case

⁸⁵ *Candee v. Deere* (1870) 54 Ill. 439.

⁸⁶ *Glendon Iron Co. v. Uhler* (1874) 75 Pa. 467.

⁸⁷ (1898) 23 Misc. Rep. (N. Y.) 66.

of the kind here referred to, however, such a word should not be considered "good" as a technical trade-mark, even "against one using it for a product or ware not of the same place or country," but relief should be granted on the principle and for the purpose of preventing unfair competition.⁸⁸

⁸⁸ See, also, the "Worcestershire Sauce" cases: *Lea v. Wolf* (1872) 13 Abb. Pr. (N. S.; N. Y.) 389, (1873) 15 Abb. Pr. (N. S.; N. Y.) 1; *Lea v. Miller, Seton* (4th Ed.) 242; *Lea v. Deakin* (1879) 11 Biss. 23, Fed. Cas. No. 8,154. See, also: *Blackwell v. Wright* (1875) 73 N. C. 310; *Dunbar v. Glenn* (1877) 42 Wis. 118; *Electro-Silicon Co. v. Hazard* (1883) 29 Hun (N. Y.) 369; *Evans v. Von Laer* (1887) 32 Fed. 153; *Metcalf v. Brand* (1887) 86 Ky. 331; *Columbia Mill Co. v. Alcorn* (1889) 40 Fed. 676; *Langham's Appeal* (1889) 28 Pa. 1; *New York & Rosendale Cement Co. v. Coplay Cement Co.* (1890) 44 Fed. 277; *Hoyt v. J. T. Lovett Co.* (1895) 17 C. C. A. 652, 71 Fed. 174; *Genessee Salt Co. v. Burnap* (1895) 67 Fed. 534; *Elgin Butter Co. v. Elgin Creamery Co.* (1893) 51 Ill. App. 231, (1895) 155 Ill. 127; *Cady v. Schultz* (1895) 19 R. I. 193; *Gabriel v. Sicilian Asphalt Pav. Co.* (1898) 23 Misc. Rep. (N. Y.) 534; *Morgan Envelope Co. v. Walton* (1897) 82 Fed. 469, (1898) 30 C. C. A. 383, 86 Fed. 605; *Elgin Nat. Watch Co. v. Illinois Watch-Case Co.* (1898) 89 Fed. 487; *Illinois Watch-Case Co. v. Elgin Nat. Watch Co.* (1899) 35 C. C. A. 237, 94 Fed. 667; *Atwater v. Castner* (1898) 32 C. C. A. 77, 88 Fed. 642; *Coffman v. Castner* (1898) 31 C. C. A. 55, 87 Fed. 457; *Castner v. Coffman* (1899) 178 U. S. 168.

In *Lea v. Deakin* (1879) 11 Biss. 23, 24, Fed. Cas. No. 8,154, Drummond, J.: "I think the proof establishes that there has long been known in the market a certain kind of sauce, used for the table on fish and meats of various kinds, as 'Worcestershire Sauce'; that it is a sort of generic term given to this kind of sauce from the fact that it was originally manufactured in Worcestershire, England. It seems to have been manufactured also in other places, and the term 'Worcestershire Sauce' seems to have been applied to that species of sauce. Under the circumstances, therefore, it can hardly be claimed that the plaintiffs, simply because they reside in Worcestershire, and manufacture a sauce which they call 'Worcestershire Sauce,' have the sole right to the application of the term to that species of sauce. I think that the proof also shows that the plaintiffs have been cognizant for many years of the fact that there was this kind of sauce manufactured to which the term was applied; that for many years they took no steps to prevent the parties

§ 68. Personal names.

A person cannot make a trade-mark of his own name, and thus obtain a monopoly of it, so as to debar any other person

from manufacturing the sauce; and that, therefore, there may be said to have been something in the nature of an acquiescence in the manufacture of the sauce."

In *Genessee Salt Co. v. Burnap* (1895) 67 Fed. 534, 535, Ricks, D. J.: "The facts in this case show that defendants are manufacturing their salt in the Genessee valley, and to prevent them from using the word 'Genessee' as descriptive of their salt would be to give the plaintiff a monopoly of that word, which the law does not intend to give. * * * Injunction denied beyond restraining defendants from combining the words 'Genessee,' 'Salt,' 'Co.,' and 'Factory Filled,' to resemble plaintiff's combination. Defendants are entitled to use the name 'Genessee,' representing the locality of the manufacture of the salt, but not to use it in any color, style, or form of letters or in combination, so as to imitate plaintiff's combination."

In *Hoyt v. J. T. Lovett Co.* (1895) 71 Fed. 173, 177, Wales, D. J.: "The words 'Green Mountain,' being used to denote the place of origin of the article to which they were affixed, and the fact that this article is a natural product, bring the present case within the rule laid down in *Delaware & H. Canal Co. v. Clark* [13 Wall. (U. S.) 311] and *Columbia Mill Co. v. Alcorn* [150 U. S. 460], already cited. * * * The name ['Green Mountain'] given to the vine and to the grape is geographical, designating a particular district or country, and cannot be employed by the complainants to the exclusion of others who deal in similar articles originating in the same locality."

In *Siegert v. Abbott* (1893) 72 Hun (N. Y.) 243, 245, Follett, J.: "To constitute a valid trade-mark, the designation or term applied to the article must be one which the claimant has the exclusive right to use. *Delaware & H. Canal Co. v. Clark*, 13 Wall. (U. S.) 311. It is apparent on principle, and it is well settled by authority, that no one can acquire the exclusive right to use a geographical name or a term which denotes the nature of the article to which it is applied. *Caswell v. Davis*, 58 N. Y. 223; *Keasbey v. Brooklyn Chemical Works*, 50 N. Y. St. Rep. 483, 21 N. Y. Supp. 696."

In *Evans v. Von Laer* (1887) 32 Fed. 153, 154, Colt, J.: "The complainants by their bill claim, as against the defendant, the exclusive use of the word 'Montserrat' as a designation for lime juice. Montserrat is the name of a small island in the West Indies, and

of the same name from using his own name in his business, even though both pursue the same kind of business; and no

the complainants, who reside in Liverpool, are the consignees of the Montserrat Company, Limited, a corporation having large plantations on the island. The defendant lives in Boston, and is a dealer in lemon and lime-fruit juice. * * * The evidence is that the defendant, or Von Laer & Co., bought lime juice on the island and had it shipped to this country. * * * In the absence of fraud, the complainants cannot enjoin the defendant from the use of a geographical name. This was settled in the case of Delaware & H. Canal Co. v. Clark, 13 Wall. (U. S.) 311, where the court refused to enjoin the defendant against calling their coal 'Lackawanna Coal,' and where it was held that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation."

In Laughman's Appeal (1889) 128 Pa. 1, 22, Clark, J.: "These lands, for many years prior to the time [1874] that the plaintiffs adopted their trade-name ['Sonman,' for their coal], were, as we have seen, known as the 'Sonman Survey.' Its boundaries were marked and defined upon the map of Cambria county. The village erected thereon was Sonman; the post office was Sonman; the railroad station was Sonman; the telegraph office was Sonman; the coal taken from the mines was shipped as Sonman coal, and, by this description, was known in the market. Can it be doubted that the term 'Sonman,' in the year 1874, was a name descriptive of a locality? If it was, the name, when applied to its own natural products, must be taken in its geographical sense. We do not say that a geographical name may not in some cases or under some circumstances, be applied as a trade-name, but we do say that, when the article to which it is applied is a product of the place named, the term cannot be used as a trade-name by one, to the exclusion of others, owners of like products of the same place. This is the doctrine of all the cases."

In Elgin Butter Co. v. Elgin Creamery Co. (1893) 51 Ill. App. 231, 232, Gary, J.: "In effect, the plaintiff claims an exclusive right to the name of Elgin in connection with the butter business, unless, at least, if used by another corporation, that corporation has its factory actually within the township [congressional township including the city of Elgin]. This is too broad a claim. Without inquiry whether the plaintiff might not be entitled to some kind of

priority, duration, or publicity of use, or combination thereof, in any such case, will create any claim or right to such monopoly.⁸⁹

relief, having no aid of counsel in such inquiry, we hold that the demurrer to the bill was rightly sustained, upon the principle stated in *Candee v. Deere*, 54 Ill. 439, and *Bolander v. Peterson*, 136 Ill. 215, 35 Ill. App. 551, that the name of a place cannot be, by one

⁸⁹ In *Wolfe v. Burke* (1873) 7 Lans. (N. Y.) 151, 156, Gilbert, J.: "A man cannot make a trade-mark of his name, to the exclusion of a like use of it by another, who bears the same name, if the use by the latter is fair, and unaccompanied by any contrivance to deceive."

In *Meneely v. Meneely* (1875) 62 N. Y. 427, 432, Rapallo, J.: "A person cannot make a trade-mark of his own name, and thus obtain a monopoly of it which will debar all other persons of the same name from using their own names in their own business."

In *England v. New York Pub. Co.* (1878) 8 Daly (N. Y.) 375, 377, Charles P. Daly, C. J.: "It is well settled, as a general proposition, that a person has the legal right to use his own name to designate an article produced and sold by him, although another person of the same name has previously manufactured and sold the like article with the same designation. *Burgess v. Burgess*, 17 Jur. 292, 22 L. J. Ch. 675, 17 Eng. Law & Eq. 257; *Meneely v. Meneely*, 1 Hun (N. Y.) 367; *Wolfe v. Burke*, 7 Lans. (N. Y.) 156; *Faber v. Faber*, 49 Barb. (N. Y.) 359; *Browne*, Trade-Marks, §§ 206, 423."

In *Pratt's Appeal* (1888) 117 Pa. 401, 411, Paxson, J.: "The mere name of a person or of a place cannot, as a general rule, be appropriated as a trade-mark; at least not in the sense of preventing another person having the same name, or residing in the same place, from using it."

In *American Cereal Co. v. Eli Pettijohn Cereal Co.* (1896) 72 Fed. 903, 907, Showalter, Cir. J.: "But William A. Pettijohn and his assigns could not, by extensively advertising the name 'Pettijohn,' prevent Eli Pettijohn, who has for nearly twenty years been making or selling the same product, from selling or manufacturing in any part of the United States under the name 'Eli Pettijohn.'" See, also, *Faber v. Faber* (1867) 49 Barb. (N. Y.) 357, 358; *Helmhold v. Henry T. Helmhold Mfg. Co.* (1877) 53 How. Pr. (N. Y.) 453, 459; *Marshall v. Pinkham* (1881) 52 Wis. 572, 585; *Williams v. Farrand* (1891) 88 Mich. 473, 493-498; *Bingham School v. Gray* (1898) 122 N. C. 699, 707.

§ 69. Pseudonym or nom-de-plume.

An author cannot, by the adoption of a *nom-de-plume*, be allowed to defeat the well-settled rules of the common law

to the exclusion of others, appropriated as a trade-name." Affirmed (1895) 155 Ill. 127.

In *Elgin Butter Co. v. Elgin Creamery Co.* (1895) 155 Ill. 127, 135, Baker, J.: "The bill proceeds upon the theory that the name 'The Elgin Butter Company,' and the claimed addition thereto of the words 'Proprietor of the Elgin Creamery,' are the trade-name and trade-mark of complainant, and that it has the exclusive right and property in both said corporate name and said addition, and that no other person or corporation has a legal right to combine the word 'Elgin' with either the word 'butter' or the word 'creamery,' in conducting his or its business. * * * It cannot be admitted that complainant, by using upon its letter heads, price lists, and other stationery, in connection with its corporate name of 'The Elgin Butter Company,' the additional words 'Proprietor of the Elgin Creamery,' has acquired such a property in and monopoly of the words 'Elgin,' 'butter,' and 'creamery' as that no one else can lawfully use the first of said words in connection with either of the other two,—even when they can truthfully be so used. Nor can it be conceded that farmers in and around the city of Elgin cannot sell the butter that they make as 'Elgin butter,' nor are they precluded from truthfully designating the places where they severally make their butter as creameries at Elgin. And no more can such a concession be allowed as against the right of any other person or corporation engaged in the business of manufacturing, dealing in, or selling butter made at a creamery in Elgin, and out of milk and dairy supplies produced in Elgin. As was said by the supreme court of the United States in *Delaware & H. Canal Co. v. Clark*, 13 Wall. (U. S.) 311: 'It must, then, be considered as sound doctrine, that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from using the same designation.' Like doctrine has been announced by this court, and in equally emphatic language. *Candee v. Deere*, 54 Ill. 439; *Bolander v. Peterson*, 136 Ill. 215. And to the same effect are the cases of *Glendon Iron Co. v. Uhler*, 75 Pa. 467; *Laughman's Appeal*, 128 Pa. 1, and *Brown Chemical Co. v. Meyer*, 139 U. S. 540. * * * The judgment of the appellate court [51 Ill. App. 231] is affirmed."

In *Brooklyn White Lead Co. v. Masury* (1857) 25 Barb. (N. Y.) (122)

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. No pseudonym, however ingenious, novel, or quaint, can give an author any more rights than he would have under his own name.⁹⁰

§ 70. Legislative incorporation of personal name.

In a comparatively recent case, the court of last resort of North Carolina declared: "The incorporation of the Bingham School at Asheville, N. C., has only the usual effect of a charter, *i. e.*, to confer the corporate rights of perpetual succession, suing and being sued, exemption from personal liability of stockholders, and the like. It did not have the effect of creating a trade-mark of the Bingham name, and of conferring the exclusive right to use it, in connection with school purposes, upon that corporation, nor is it a prohibition upon all others named Bingham, whether of that family or of any other of the same name, using it in connection with any school they might establish. Such an idea was foreign to the legislative mind, and it is beyond the scope of the powers of the state legislature to establish a monopoly in a family name, or to confer a patent right in its use."⁹¹

§ 71. Use of personal name as trade-mark for contract term.

In a recent case in the United States circuit court of ap-

416, Mitchell, P. J.: "As they [plaintiff and defendant] both dealt in the same article, and both manufactured it at Brooklyn, each had the same right to describe it as Brooklyn white lead, and it is shown that many other companies had used the same designation."

In *Blackwell v. Wright* (1875) 73 N. C. 310, 314, Bynum, J.: "Nor can the word 'Durham,' the name of the town where both parties are doing business, be exclusively appropriated as a trade-mark."

⁹⁰ *Clemens v. Belford* (1883) 14 Fed. 728, 732.

⁹¹ *Bingham School v. Gray* (1898) 122 N. C. 699, 709.

peals, second circuit, it appeared that one Hiram Duryea was for many years the president and a stockholder of a corporation which made and sold starch in packages having thereon the name "Duryea's Starch" in prominent letters, and also a picture of the manufacturing buildings, and the name of the company. After the starch had thus been sold for many years, and had become identified with the company, the latter sold its business, trade-marks, and goodwill to another corporation, which continued the use of the package containing the name and picture, with its own name as manufacturer, Duryea agreeing not to go into the starch business for five years. At the expiration of this time, Duryea furnished capital to his sons, who, with others, formed a partnership as "Duryea & Co.," and procured other starch to be made for them under their direction and superintendence as to manufacture and improvement thereof, and sold it as "Starch Prepared by Duryea & Co.," but used strikingly different labels and packages, and it was held that this was a proper use by Hiram Duryea and sons of their own name, and could not be enjoined.⁹²

§ 72. Personal name may become generic.

A personal name may be so used in connection with an article of manufacture as to become generic, and hence incapable of exclusive use as to the designation of such article. An instance of this is found in a recent case in the United States circuit court for the northern district of Illinois, in which it appeared that one Baron Liebig, an eminent German chemist, had published in 1847 a formula by which an extract of meat was obtained free from gelatine and fat. This extract was manufactured by the Royal pharmacy in Munich, and was designated as "Liebig's Extract of Meat," with the per-

⁹² National Starch Mfg. Co. v. Duryea (1900) 101 Fed. 117, 119.

mission of Baron Liebig. Later a corporation was organized to manufacture the extract in South America on a large scale, and it was succeeded by the complainant corporation. The court held that the name had become generic on account of its use by the Royal pharmacy with Baron Liebig's consent, and that the complainant, having entered the markets of the United States after the name had become generic, could not maintain any exclusive trade-mark right thereto.⁹³

§ 73. Personal name descriptive of medical preparation.

It has been held that the words "Liver Medicine" are purely descriptive, and cannot be appropriated by the complainant to indicate its preparation alone, nor can the word "Simmons," in connection with the words "Liver Medicine," be appropriated by the complainants to its preparation alone; that name under the proof having become merely descriptive of medicine prepared under the formula of old Dr. Simmons, and used by many people in connection with medicines prepared under that formula.⁹⁴

§ 74. Mere use of like personal name by competing owners.

Where two persons, of the same name or surname, are competitors in business, and either uses such personal name or surname as a trade-mark or trade-name in his business, any injury resulting to one from such mere use by the other is without legal remedy.⁹⁵

⁹³ Liebig's Extract of Meat Co. v. Libby (1900) 103 Fed. 87-89.

⁹⁴ C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84, 119; citing, for support of the rule, Marshall v. Pinkham (1881) 52 Wis. 572, 587, 588.

⁹⁵ In Faber v. Faber (1867) 49 Barb. (N. Y.) 357, 358, Sutherland, J.: "But the defendant, Faber, has a right to put or stamp his own name in gold, gilt, or other letters on his pencils, and on the hands, wrappers, or covers in which they are put up, as described in the complaint. And any injury which the plaintiff [Faber] has

§ 75. Letters or numerals used for certain purposes.

Letters or numerals, one or more of each, or combined together, cannot be appropriated as a trade-mark for a vendible article to which attached, when used for the purpose merely of indicating the name⁹⁶ of such article; or its mode or process of manufacture;⁹⁷ or its nature;⁹⁸ or its kind;⁹⁹ or its quality;¹⁰⁰ or its grade;¹⁰¹ or its size;¹⁰² or its meas-

sured, or may suffer, by such use of the defendant Faber's name merely, must be viewed as an injury without a remedy."

In *Meneely v. Meneely* (1875) 62 N. Y. 427, 431, Rapallo, J.: "The manner of using the name is all that would be enjoined, not the simple use of it, for every man has the absolute right to use his own name in his own business, even though he may thereby interfere with or injure the business of another person bearing the same name. * * * Where the only confusion created is that which results from the similarity of the names, the courts will not interfere." See, also, *Marshall v. Pinkham* (1881) 52 Wis. 572, 585; *Williams v. Farrand* (1891) 88 Mich. 473, 494.

⁹⁶ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599, 600, 610-612. Citing in support of positions held: *Singleton v. Bolton* (1783) 3 Dougl. 293; *Canham v. Jones* (1813) 2 Ves. & B. 218; *Perry v. Truefitt* (1842) 6 Beav. 66; *Lafean v. Weeks* (1896) 177 Pa. 412.

⁹⁷ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599.

⁹⁸ *Candee v. Deere* (1870) 54 Ill. 439.

⁹⁹ *Candee v. Deere* (1870) 54 Ill. 439.

¹⁰⁰ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Candee v. Deere* (1870) 54 Ill. 439; *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51; *Royal Baking Powder Co. v. Sherrell* (1883) 93 N. Y. 331; *Avery v. Meikle* (1883) 81 Ky. 73; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537, 11 Sup. Ct. 396; *Smith & Davis Mfg. Co. v. Smith* (1898) 89 Fed. 486; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹⁰¹ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Amoskeag Mfg. Co. v. Trainer* (1879) 101 U. S. 51; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1887) 31 Fed. 776; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537, 11 Sup. Ct. 396; *Smith & Davis Mfg. Co. v. Smith* (1898) 89 Fed. 486.

¹⁰² *Candee v. Deere* (1870) 54 Ill. 439; *Magee Furnace Co. v. Le Barron* (1879) 127 Mass. 115; *Avery v. Meikle* (1883) 81 Ky. 73; *Marcus Ward & Co. v. Ward* (1891) 15 N. Y. Supp. 913; *Deering* (126)

urement;¹⁰³ or its dimensions;¹⁰⁴ or its place in a machine;¹⁰⁵ or its capacity or capability;¹⁰⁶ or its shape;¹⁰⁷ or its style;¹⁰⁸ or its class;¹⁰⁹ or its membership in a class.¹¹⁰ And although, from long use for any one or more of the purposes aforesaid, such letters or figures, or combinations thereof, come to indicate the origin or ownership of the vendible article to which attached, such fact cannot entitle them to appropriation as a trade-mark, where they are primarily used for another purpose.¹¹¹ And if primarily adopted and designed to indicate origin or ownership, their subsequent use for any one or more of the purposes aforesaid will not deprive them of the characteristics of a trade-mark.¹¹²

Harvester Co. v. Whitman & Barnes Mfg. Co. (1898) 91 Fed. 376; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651,—citing in support, *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537.

¹⁰³ *Magee Furnace Co. v. Le Barron* (1879) 127 Mass. 115.

¹⁰⁴ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Marcus Ward & Co. v. Ward* (1891) 15 N. Y. Supp. 913.

¹⁰⁵ *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1897) 86 Fed. 764; *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 91 Fed. 376.

¹⁰⁶ *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 91 Fed. 376.

¹⁰⁷ *Candee v. Deere* (1870) 54 Ill. 439; *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 91 Fed. 376; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹⁰⁸ *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537, 11 Sup. Ct. 396; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

¹⁰⁹ *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1887) 31 Fed. 776; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537, 11 Sup. Ct. 396.

¹¹⁰ *Humphreys Homeopathic Medicine Co. v. Hilton* (1894) 60 Fed. 756; *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 91 Fed. 376.

¹¹¹ *Avery v. Meikle* (1883) 81 Ky. 73; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537, 11 Sup. Ct. 396; *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.* (1898) 91 Fed. 376.

¹¹² *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S.

§ 76. Mere color of advertisements, labels, and manufactured articles.

In a recent case, the supreme court of New York said: "The plaintiff has adopted green as the distinctive color of its advertisement and labels, and the liniment itself is green. * * * The defendants have put upon the market a soap which they term 'Omega Oil Medicated Soap,' and claim it to be useful for skin and scalp troubles. The soap is green in color, as are likewise the paper wrapper in which each cake is inclosed, and the box in which the cakes are packed. * * * If the words [Omega Oil] constituting plaintiff's trade-mark be omitted from the soap, the mere use of the green color in the soap or on the wrapper or box cannot be enjoined."¹¹⁴

§ 77. Material.

The rule in reference to the use of materials has been stated by the United States circuit court for the northern district of Illinois as follows: "But the claim of this bill is that no person other than complainants has a right to use upon plug tobacco a piece of tin, of any shape or color, or with any legend or mark or sign upon it, as a manufacturer's or deal-

537. 11 Sup. Ct. 396; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

In *Avery v. Melkle* (1883) 81 Ky. 73, Hargis, Ch. J.: "The alphabet, English vocabulary, and Arabic numerals are to man, in conveying his thoughts, feelings, and the truth, what air, light, and water are to him in the enjoyment of his physical being. Neither can be taken from him. They are the common property of mankind, in which all have an equal share and character of interest. From these fountains, whoever will may drink, but an exclusive right to do so cannot be acquired by any. And the appellants, having drawn from the common fountain the letters and numerals named, cannot claim an exclusive right to them or their use."

¹¹⁴ *Omega Oil Co. v. Weschler* (1901) 35 Misc. Rep. (N. Y.) 441-443.

er's mark, or designation of the origin of the goods. * * *
A person may appropriate any word, figure, or emblem as a trade-mark, but that does not give an exclusive right to the use of the well-known material substances upon which the word, figure, or emblem may be impressed or engraved."¹¹⁵

§ 78. Parts of mark designed to indicate facts other than origin or ownership.

A trade-mark is frequently designed to convey information as to several distinct and independent facts, and therefore contains separate words, marks, or signs applicable to each, thus indicating not only the origin or ownership of the article or fabric to which it is attached, but its appropriate name, the mode or process of its manufacture, and its peculiar or relative quality. It is certain, however, that the use by another manufacturer of the words or signs indicative of these circumstances may yet have the effect of misleading the public as to the true origin of the goods; but it would be unreasonable to suppose that he is therefore precluded from using them as an expression of the facts which they really signify, and which may be just as true in relation to his goods as to those of another. Purchasers may be deceived; they may buy the goods of one person as those of another, but they are not deceived by a false representation: they are deceived because certain words or signs suggest a meaning to their minds which they do not in reality bear, and were not designed to convey.¹¹⁶

§ 79. Color, form, material, or mode of construction of package, article manufactured, etc.

As incapable of appropriation as trade-marks have been

¹¹⁵ *Lorillard v. Pride* (1886) 28 Fed. 434, 438-440.

¹¹⁶ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599, 609, 610.

held the following: A particular colored paper, or kind of paper, for covering or inclosing lead pencils by the gross in a book form, or any particular form.¹¹⁷ A package of peculiar form and dimensions, or a bottle, or vessel, or package, without having imprinted upon or connected with it some other symbol, word, letter, or form.¹¹⁸ A label of given material, dimensions, and color. 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.¹¹⁹ A tin pail with a bail or handle to it, the tin ornamented with a geometrical pattern, and used to contain paper collars for sale, and sold with the collars.¹²⁰ A longitudinal straight line, crossed at right angles by equidistant straight lines, upon plug tobacco, along and by which to cut the plug in equal parts.¹²¹ A package with a blue band and gold lettering, the package being of a form appropriate and usual for putting up small cakes of soap.¹²² "The

¹¹⁷ *Faber v. Faber* (1867) 49 Barb. (N. Y.) 357.

¹¹⁸ *Moorman v. Hoge* (1871) 2 Sawy. 78, 89, Fed. Cas. No. 9,783.

In *Clinton Metallic Paint Co. v. New York Metallic Paint Co.* (1898) 23 Misc. Rep. (N. Y.) 66, 69, Gaynor, J.: "Actual barrels, boxes, and the like may not be appropriated for trade-marks, for their particular size, style, or shape, but this has reference only to the physical objects themselves, and not to pictures or devices of them for labels or brands. *Moorman v. Hoge*, 2 Sawy. 78, Fed. Cas. No. 9,783; *Enoch Morgan's Sons Co. v. Troxell*, 89 N. Y. 292; *Fischer v. Blank*, 138 N. Y. 244; *Brown*, Trade-Marks, § 138. The cases sometimes cited to the contrary are not so, in fact, covering, as they do, combinations of package, color, and label. *Cox*, Man. Trade-Mark Cas., Index, 'Packages.'"

¹¹⁹ *Burke v. Cassin* (1873) 45 Cal. 467, 481; *Falkenburg v. Lucy* (1868) 35 Cal. 52.

¹²⁰ *Harrington v. Libby* (1877) 14 Blatchf. 128, Fed. Cas. No. 6,107.

¹²¹ *Dausman & Drummond Tobacco Co. v. Ruffner* (1878) 15 Official Gazette, 559, Fed. Cas. No. 3,585.

¹²² *Enoch Morgan's Sons Co. v. Troxell* (1882) 89 N. Y. 292, 297.

shape and construction of the plows, * * * further than their subjection to the use of the mark to indicate their origin and make, is necessary to render the trade-mark property."¹²³ The color of a label, apart from any name, figure, or device with which it may be connected; the form of a package.¹²⁴ Directions, advertisements, notices, etc.; the form, appearances, or finish of goods; the form or color of a package or box.¹²⁵ The merchandise itself; the arrangement of differently colored packages (of soap) in the box.¹²⁶ The form of the sticks of chewing gum manufactured; the peculiar form and decoration of the boxes therefor; the manner in which the gum might be placed in the box.¹²⁷ Packages of peculiar form and color, unaccompanied by any distinguishing symbol, letter, sign, or seal.¹²⁸ A particular color, unaccompanied by any mark or symbol.¹²⁹ The article manufactured, a bronzed horseshoe nail.¹³⁰ The name of the book published and sold, "Webster's Dictionary;" a certain form or size of the book published; the device of a book with the name thereof, "Webster's Dictionary," printed thereon, used on circulars, bill heads, etc.¹³¹ The size or shape or mode of construction of

¹²³ *Avery v. Meikle* (1883) 81 Ky. 73, 87; *Candee v. Deere* (1870) 54 Ill. 439, 461.

¹²⁴ *Fleischmann v. Starkey* (1885) 25 Fed. 127, 128.

¹²⁵ *Ball v. Siegel* (1886) 116 Ill. 137, 143.

¹²⁶ *Davis v. Davis* (1886) 27 Fed. 490, 492.

¹²⁷ *Adams v. Heisel* (1887) 31 Fed. 279, 280.

¹²⁸ *Philadelphia Novelty Mfg. Co. v. Rouss* (1889) 40 Fed. 585, 587; *Fairbanks v. Jacobus* (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608; *Wilcox & Gibbs Sewing Mach. Co. v. The Gibbens Frame* (1883) 17 Fed. 623; *Brown Chemical Co. v. Stearns* (1889) 37 Fed. 360.

¹²⁹ *Philadelphia Novelty Mfg. Co. v. Blakesley Novelty Co.* (1889) 40 Fed. 588.

¹³⁰ *Putnam Nail Co. v. Dulaney* (1891) 140 Pa. 205, 212, 213.

¹³¹ *Merriam v. Famous Shoe & Clothing Co.* (1891) 47 Fed. 411, 413; *Merriam v. Texas Siftings Pub. Co.* (1892) 49 Fed. 944, 947, 948.

a box, barrel, bottle, or package in which goods may be put.¹³² Color alone; a red label on a yellow wrapper; a white label; a red box.¹³³ The form of package and fashion of label.¹³⁴ Package boxes of particular shape and of uniform size and general appearance; mathematical lines; styles of printing or colors.¹³⁵ A tobacco box of the ordinary form in common use in many localities.¹³⁶

¹³² Hoyt v. Hoyt (1891) 143 Pa. 623, 638, 639.

¹³³ Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16, 17; In re Hanson's Trade-Mark (1887) 37 Ch. Div. 112.

¹³⁴ Brown v. Doscher (1895) 147 N. Y. 647, 651.

¹³⁵ Lafean v. Weeks (1896) 177 Pa. 412, 422-432.

¹³⁶ Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (1897) 80 Fed. 105, 107.

CHAPTER IV.

APPROPRIATION AND APPLICATION OF TRADE-MARKS.

- § 80. By Whom Trade-Marks may be Acquired and Held.
- 81. Trade-Mark Acquired by Importer of Manufactured Article.
- 82. Trade-Mark Acquired by Selector of Commercial Article.
- 83. Trade-Mark Acquired by Manufacturer in Limited Sense.
- 84. No Trade-Mark Acquired by Manufacturer Who Applies Mark at Request of Purchaser.
- 85. No Trade-Mark Acquired by Association Whose Members Apply Union Labels.
- 86. No Trade-Mark Acquired by Inventor of System.
- 87. Priority of Adoption.
- 88. Mere Fact that Trade-Mark not in Use in Particular Locality Gives No One Right to appropriate It.
- 89. Right of Prior Domestic User.
- 90. How Trade-Mark may be Acquired and Held.
- 91. Use Necessary to Support Claim to Trade-Mark.
- 92. Use, not Invention, of Trade-Mark that Creates Right.
- 93. Use must be Sufficient to Point Out Origin of Claimant's Goods.
- 94. Declaration of Claimant cannot Lay Foundation of Right.
- 95. Voice of Public cannot appropriate Trade-Mark to Individual.
- 96. Use by One Claimant will not Prevent Adoption by Another for Different Article.
- 97. Trade-Marks Also Acquired by Transfer.
- 98. To What Trade-Marks may be Applied.
- 99. How Trade-Marks may be Applied.

§ 80. By whom trade-marks may be acquired and held.

A common-law trade-mark may be acquired by any person, firm, or corporation.¹ The same rights are accorded by the courts of this country, in this respect, to aliens and citizens.²

¹ Insurance Oil Tank Co. v. Scott (1881) 33 La. Ann. 946.

² Taylor v. Carpenter (1844) 3 Story, 458, Fed. Cas. No. 15,784;

A trade-mark may be acquired by the manufacturer, producer, or vendor of a commercial article.³ Usually such trade-marks are appropriated and applied by the manufacturer, but a vendor who has established a particular trade-mark which he uses to distinguish an article sold by him is entitled to be protected in its use, although he does not manufacture the goods.⁴

Derringer v. Plate (1865) 29 Cal. 292, 296; *Kerry v. Toupin* (1894) 60 Fed. 272. See, also, *Collins v. Brown* (1857) 3 Kay & J. 423.

³ *Taylor v. Carpenter* (1846) 2 Sandf. Ch. (N. Y.) 603, affirmed (1844) 11 Paige (N. Y.) 292 (1846) 2 Sandf. Ch. (N. Y.) 611.

⁴ *Godillot v. Hazard* (1875) 49 How. Pr. (N. Y.) 5; *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Walton v. Crowley* (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277; *Insurance Oil Tank Co. v. Scott* (1881) 33 La. Ann. 946; *Holt v. Menendez* (1885) 23 Fed. 869; *Menendez v. Holt* (1888) 128 U. S. 514, 9 Sup. Ct. 143; *Societe des Huiles d'Olive de Nice v. Rorke* (1896) 5 App. Div. (N. Y.) 175; *McLean v. Fleming* (1877) 96 U. S. 245.

In *McLean v. Fleming* (1877) 96 U. S. 245-253, Clifford, J.: "Everywhere courts of justice proceed upon the ground that a party has a valuable interest in the goodwill of his trade, and in the labels or trade-mark which he adopts to enlarge and perpetuate it. Hence it is held that he, as proprietor, is entitled to protection as against one who attempts to deprive him of the benefits resulting from the same, by using his labels and trade-mark without his consent and authority. * * * Such a proprietor, if he owns or controls the goods which he exposes to sale, is entitled to the exclusive use of any trade-mark adopted and applied by him to the goods, to distinguish them as being of a particular manufacture and quality, even though he is not the manufacturer, and the name of the real manufacturer is part of the device. *Walton v. Crowley*, 3 Blatchf. 440, Fed. Cas. No. 17,133; *Emerson v. Badger*, 101 Mass. 82."

In *Falkinburg v. Lucy* (1868) 35 Cal. 52, 64, Sanderson, J.: "By the common law, the manufacturer of goods, or the vendor of goods for whom they have been manufactured, has a right to designate them by some peculiar name, symbol, figure, letter, form, or device, whereby they may be known in the market as his, and be distinguished from other like goods manufactured or sold by other persons. The owner of such peculiar marks, provided they are original with him, will be protected in their exclusive use by the courts.

§ 81. Trade-mark acquired by importer of manufactured article.

Thus, in the case of *Godillot v. Harris*,⁵ where plaintiff had devised the ingredients of a vegetable compound, which was manufactured and put up in Paris for him, was imported

but only so far as such marks serve to designate the true origin or ownership of the goods to which they are attached. He will not be protected in the use of figures or symbols or combinations of words which serve merely to indicate the name, kind, or quality of the goods to which they are attached, notwithstanding they may be interblended with others which indicate origin and ownership. *Fetridge v. Wells*, 4 Abb. Pr. (N. Y.) 144; *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. (N. Y.) 599; *Stokes v. Landgraff*, 17 Barb. (N. Y.) 608."

In *Insurance Oil Tank Co. v. Scott* (1881) 33 La. Ann. 946, 952. Fenner, J.: "A corporation is entitled to have its trade-mark, as well as a private individual, and may sue for its infringement. * * * The objection that the oil is not directly manufactured by plaintiff, but only manufactured by others under plaintiff's orders and directions, is of no force. The authorities are clear that, in such case, the seller is as much entitled to protection in his trade-mark as if he were the manufacturer."

In *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277, 283, Bakewell, J.: "The owner of goods which he exposes to sale in market in his own right is entitled to the exclusive use of any trade-mark devised and applied by him to distinguish them as being of a particular manufacture or quality, although he is not himself the manufacturer. *Walton v. Crowley*, 3 Blatchf. 440, Fed. Cas. No. 17,133."

In *Godillot v. Hazard* (1875) 49 How. Pr. (N. Y.) 5-8, Monell, C. J.: "The right to protection is not exclusively in the manufacturer. The person for whom the goods are manufactured (*Amoskeag Mfg. Co. v. Spear*, 2 Sandf. [N. Y.] 599; *Walton v. Crowley*, 3 Blatchf. 440, Fed. Cas. No. 17,133), and the vendor who sells, and who may have no direct relation to the manufacturer, has such right (*Partridge v. Menck*, 2 Barb. Ch. [N. Y.] 103; *Taylor v. Car-*

⁵ *Godillot v. Harris* (1880) 81 N. Y. 263, 266, Danforth, J.: "It is not essential to property in a trade-mark that it should indicate any particular person as the maker of the article to which it is attached. It may represent to the purchaser the quality of the

by him, and sales were made in the names of third persons, but he was interested in the result, and, to designate the article, plaintiff had prepared and had engraved and printed

penter, 2 Sandf. Ch. [N. Y.] 614). * * * And Beardsley, J., says, in *Taylor v. Carpenter* (*supra*): 'It is immaterial that the complainants were not admitted to be the manufacturers of the article. It was conceded that they were the vendors, and engaged in the sale of it.' In *Lee v. Haley* (39 Law J. 284), the plaintiffs were dealers in coal, a natural product in the general reach of all dealers, yet the court protected the goodwill of a business represented by a particular style of address. It sufficiently appears from the evidence that the plaintiff is in a position to entitle him to adopt a trade-mark to designate the goods in question. They were manufactured exclusively for him, and, within the authorities I have cited, he, as the vendor, had a right to establish a reputation for the quality of the article he sold, and perpetuate it by a device which would denote its origin and ownership. If he had done so, he should be protected in its exclusive use."

In *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1891) 137 Ill. 231, 233, Scholfield, C. J.: "A trade-mark is not a franchise. It is not a privilege emanating from the sovereign power of the state, owing its existence to a grant, but it is, on the contrary, the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, and distinguish them from those manufactured or sold by another. Upt. Trade-Marks, c. 1, p. 9; *Candee v. Deere*, 54 Ill. 439."

In *Smith v. Walker* (1885) 57 Mich. 456, 473, Sherwood, J.: "By the common law, 'every manufacturer, and every merchant for whom goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the markets for which he intends them, that he may thus secure the profits that their superior repute, as his, may be the means of gaining.'"

In *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599, 605, Duer, J.: "Every manufacturer, and every merchant for whom

thing offered for sale, and in that case is of value to any person interested in putting the commodity to which it is applied upon the market. This was the plaintiff's position. He was not the actual manufacturer of the 'Julienne,' but the trial court found, and there is evidence to sustain the finding, 'that it was manufactured and put up in Paris expressly for him.' He devised the ingredients, and

(136)

a label containing words designating the origin of the article itself, which he attached to the packages as a trade-mark, and where defendant, after a market had been established for the article, prepared and offered for sale substantially the same kind of goods, placing upon the packages a label so nearly like that of plaintiff's that a buyer would be easily deceived, it was held that plaintiff had acquired the right to the use of the trade-mark by its prior use and application, although the goods were manufactured for and not by him.

§ 82. Trade-mark acquired by selector of commercial article.

In *Menendez v. Holt*,⁶ Chief Justice Fuller, in delivering the opinion of the United States supreme court, said: "The fact that Holt & Co. were not the actual manufacturers of the flour upon which they had for years placed the brand in question does not deprive them of the right to be protected in the use of that brand as a trade-mark. They used the words 'La Favorita' to designate flour selected by them, in the exercise of their best judgment, as equal to a certain

goods are manufactured, has an unquestionable right to distinguish the goods that he manufactures or sells by a peculiar mark or device, in order that they may be known as his in the market for which he intends them, and that he may thus secure the profits that their superior repute, as his, may be the means of gaining."

became the importer of the prepared article. To designate the substance, when so prepared for sale, he designed and had engraved and printed a label, which he attached to the packages containing it. He was interested in the result of sales, and, although these were made in the names of third persons, and not his own, his legal right to protection is the same."

⁶ (1888) 128 U. S. 514. See, also, *Mayer v. Flanagan* (1896) 12 Tex. Civ. App. 405, 34 S. W. 785.

In *Walton v. Crowley* (1856) 3 Blatchf. 440, 448, Fed. Cas. No. 17,133, Betts, J.: "The person for whom goods are manufactured has the same legal right to affix and maintain a special trade-mark as the manufacturer himself. *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. (N. Y.) 599; *Taylor v. Carpenter*, 2 Sandf. Ch. (N. Y.) 614."

standard. The brand did not indicate by whom the flour was manufactured, but it did indicate the origin of its selection and classification. It was equivalent to the signature of Holt & Co. to a certificate that the flour was the genuine article, which had been determined by them to possess a certain degree of excellence. It did not, of course, in itself indicate quality, for it was merely a fancy name, and in a foreign language, but it evidenced that the skill, knowledge, and judgment of Holt & Co. had been exercised in ascertaining that the particular flour so marked was possessed of a merit rendered definite by their examination, and of a uniformity rendered certain by their selection."

§ 83. Trade-mark acquired by manufacturer in limited sense.

A person who is a manufacturer only in a limited sense may acquire a trade-mark which thus indicates the origin of the goods with him. Thus, in *Meriden Britannia Co. v. Parker*⁷ it appeared that three brothers, of the name of Rogers, were engaged for many years in the manufacture of plated spoons and forks, in which they had superior skill, sometimes as partners under the name of "Rogers Brothers," and sometimes as stockholders in joint-stock corporations. The goods manufactured by such partnerships and corporations were stamped with various devices, each of which contained the name "Rogers." In 1862, all such partnerships and corporations, with one exception, had ceased to do business, and the three brothers then entered into a contract with the petitioners, by which, and by subsequent contracts, the petitioners acquired the right to manufacture and sell plated spoons and forks with the name "Rogers" stamped thereon as a component part of a trade-mark, and also became en-

⁷ (1872) 39 Conn. 450. See, also, *William Rogers Mfg. Co. v. Simpson* (1887) 54 Conn. 527.

titled to have, and did in fact have, the benefit of the skill and experience of the three brothers in that department of the business. The goods so manufactured were stamped "1847, Rogers Bros. A 1," which stamp differed somewhat from any stamp previously used. The petitioners furnished all capital, power, and machinery, employed and paid laborers, and controlled the sale and disposition of the goods manufactured, while the Rogers brothers superintended the manufacture, directed as to their style and quality, and had general supervision of the manufacture and sale thereof. It was held that the right to use the name "Rogers" previously existing in the partnerships and corporations that had ceased to do business thereupon reverted to the Rogers brothers; that the petitioners were in one sense the manufacturers; that such trade-mark had come, by the work of time and experience, to indicate the origin and ownership of such goods with the petitioners, and they were entitled to protection in the use of it.

§ 84. No trade-mark acquired by manufacturer who applies mark at request of purchaser.

But the manufacturer who makes goods for another, and applies a particular trade-mark thereto at the request of the purchaser, acquires no right to such trade-mark. In *Levy v. Waitt*⁸ it was shown that there are two classes of labels recognized by cigar manufacturers—"factory brands" and "customers' brands," the latter originating with a customer, and used only on goods manufactured for him. A cigar merchant ordered a lot of cigars, of a certain size and quality, under the name of "Blackstone," which he originated. This

⁸ (1893) 56 Fed. 1016. See, also, *Gravel Roofers' Exchange v. Turnbull* (1894) 8 Nat. Corp. Rep. 490; *Miles Corson Co. v. Young* (1891) 29 Wkly. Notes Cas. (Pa.) 256.

order the manufacturer filled, but the cigars were not taken by the merchant, and were sold to other parties, and it was held that the manufacturer acquired no right to the word as a trade-mark. So, also, in an action brought to restrain the defendant from selling imitations of the olive oil of the plaintiff, and from using a certain trade-mark, it appeared that the manufacturer of the oil in question had appointed Dwyer & Co. his agents to sell the oil for five years, agreeing that during this time he would not sell, give, or dispose of his oils for shipment to or for sale or use in the United States or Canada. Thereafter the plaintiff corporation was organized, and the manufacturer transferred his contract with Dwyer & Co. to it. At the same time Dwyer & Co. agreed that they would not sell any oils except those of the plaintiff, and under the brand of Dwyer & Co. After the plaintiff corporation was organized, the manufacturer sold oil to it, and plaintiff sold to Dwyer & Co. The label in question was invented by Dwyer & Co. while agents for the manufacturer, and was sent to the manufacturer, who used it on the bottles. Subsequently the manufacturer and the plaintiff caused these labels, which did not mention the name of either of them, to be made, and charged Dwyer & Co. for such of them as they used on bottles shipped to Dwyer & Co. It was not shown that plaintiff sold, or that Dwyer & Co. advertised, any oil under this label as being the plaintiff's own oil, or that it became known to the public as such. It was held that, on the termination of the contract between the plaintiff and Dwyer & Co., the label or trade-mark would belong to Dwyer & Co., and not to plaintiff, and consequently was not plaintiff's trade-mark.⁹

⁹ *Societe des Huiles d'Olive de Nice v. Rorke* (1896) 5 App. Div. (N. Y.) 175.

§ 85. No trade-mark acquired by association whose members apply union labels.

Nor can an association or union of workmen, which does not own, manufacture, or deal in goods, acquire a trade-mark in a label adopted by such body, and used only to designate goods made by its individual members.¹⁰ But the in-

¹⁰ In *Cigar Makers' Protective Union v. Conhaim* (1889) 40 Minn. 243, 247, Gilfillan, J.: "In these particulars the device is wanting in the essential characteristics of a legal trade-mark: First. It is not adopted nor used to indicate by what person the articles were made, but merely to indicate membership of a certain association. Second. Its use is not enjoyed as an incident to any business, and the right to use it cannot be transferred, even with the transfer of the business in which it may have been employed; the right to use it can be acquired only by becoming a member of one of the unions, or employing those who are members, and lost only by ceasing to be a member or to employ members. Third. There is no exclusiveness in the use, or right to use, which is necessary to a legal trade-mark. Browne, *Trade-Marks*, §§ 143, 309, 324. Any one of many thousands of persons, no way connected in business, and perhaps unknown to each other, has an equal right to its use."

In *Carson v. Ury* (1889) 39 Fed. 777, 779, Thayer, J.: "It is no doubt true that the union label does not answer to the definition ordinarily given of a technical trade-mark, because it does not indicate with any degree of certainty by what particular person or firm the cigars to which it may be affixed were manufactured, or serve to distinguish the goods of one cigar manufacturer from the goods of another manufacturer, and because the complainant appears to have no vendible interest in the label, but merely a right to use it on cigars of his own make, so long, and only so long, as he remains a member of the union. In each of these respects the label lacks the characteristics of a valid trade-mark. The court cannot interfere in this instance, as in ordinary trade-mark cases."

In *Weener v. Brayton* (1890) 152 Mass. 101-107, Devens, J.: "For similar reasons, we are of opinion that the label alleged by the bill in the case at bar to have been counterfeited cannot be treated as a trade-mark. * * * It wants every essential element of such a mark. It does not indicate by what person articles were made, but only membership in a certain association. There is no exclusive use of it, but many persons, not connected in business, and unknown to each other, may use it. Its rightful use is not connected with

dividual member who, by the use of such label upon goods manufactured by himself, has built up a profitable trade, is entitled to protection in such use under circumstances

any business; it cannot be transferred with any business, but such use is dependent only on membership in the association. * * * Where an association such as the Cigar Makers' Union, embracing many members and many divisions as subordinate unions, has adopted a symbol or device to be used on boxes of cigars made by its members, such device or symbol not indicating by whom the cigars are made, but only that they are made by some of the members of the union, and where the right to use the device or symbol belongs equally to all the members, and continues only while they are members, a bill cannot be maintained by individual members or officers of such association to restrain others wrongfully and fraudulently using such device or symbol from so doing."

In *McVey v. Brendel* (1891) 144 Pa. 235-246, Williams, J.: "But we are not disposed to impale their case upon what may be thought to be a technical point. On the other hand, we will consider whether the International Cigar Makers' Union is a trader; whether the label in question is a trade-mark. * * * The first question is disposed of by the learned master upon the pleadings. The organization that devised, registered, and owns the label is neither a manufacturer nor dealer, and has no trade in which a trade-mark can be used. The second question would seem to go with the first. * * * Now, if the Cigar Makers' International Union was a business organization engaged in making cigars for sale, it could adopt and use a trade-mark in its business, and acquire property in it. But it is not a business organization. It neither makes nor sells cigars, but directs its attention to cigar makers, and seeks 'to promote the mental, moral, and physical welfare of its members.' These are worthy objects. * * * It is obvious, however, that they are personal and social objects, not commercial ones. They do not look towards the production or sale of any class or quality of cigars or tobacco, but towards the personal elevation and comfort of cigar makers. I conclude, therefore, that the Cigar Makers' International Union of America is neither a 'trader,' within the meaning of the common law, nor within the purview of the act of congress. Not being a trader in any sense, it can have no distinctive trade-mark. Registration, under such circumstances, is not authorized by the act of congress, and, if made, confers no title, and gives no standing ground in a court of law or equity."

In *State v. Berlinsheimer* (1895) 62 Mo. App. 168-174, Bond, J.:
(142)

showing unlawful competition.¹¹ Although holding such labels not to be technical common-law trade-marks, some

"The conclusion follows that the statutes, supra, only embrace trade-mark cases. * * * Hence it is necessary to inquire whether the label adopted by the Cigar Makers' Union was a trade-mark. In this inquiry it must be borne in mind that the recording of the label has no effect in giving it the quality of a trade-mark, if it was not such according to the law applicable to the subject. *United States v. Braun*, 39 Fed. 775. It is one of the indispensable prerequisites to a valid trade-mark that it should point out the true origin or ownership of a vendible commodity to which it is affixed. That the label in the present case does not have this property appears from the conceded facts, since these show that the 'association or union of workingmen' claiming it does not own or manufacture any goods to which it is attached. It is true the individual members of that order are engaged, either for themselves or others, in the manufacture of such goods, but this does not meet the requirement of the law that the owner of the trade-mark must affix it to his goods as a designation. As the 'association or union of workingmen' adopted the said label as a trade-mark, without owning or dealing in any goods to which it must be attached, no title to it as a trade-mark accrued. *Schneider v. Williams*, 44 N. J. Eq. 391; *Cigar Makers' Protective Union v. Conhaim*, 40 Minn. 243; *Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co.*, 104 Mo. 53. For this reason, the conviction of defendant for counterfeiting a recorded trade-mark cannot be sustained."

In *State v. Bishop* (1895) 128 Mo. 373-381, Burgess, J.: "The first contention is that the label of the Cigar Makers' International Union of America is not a trade-mark. * * * It may be conceded that the label is not what is generally understood by law writers to be a technical trade-mark, because it does not pretend or intimate that the cigars are owned, prepared, or manufactured by the union as an organization, or that, as such union, it has any interest or property therein, nor by what particular firm or person the cigars to which it may be attached were manufactured."

In *Hetterman Bros. & Co. v. Powers* (1897) 102 Ky. 133, 138, Hazelrigg, J.: "And, first, we may admit that the label [of the Cigar Makers' International Union] is not used as a 'trade-mark,' in the ordinary sense of that word. It is not a brand put on the goods of the owner to separate or distinguish them from the goods of others."

¹¹ In *Carson v. Ury* (1839) 39 Fed. 777, 781, Thayer, J.: "The

courts have protected them when not contrary to good morals or public opinion, and others have further recognized in them a property right, belonging to the individual member as an employe and skilled workman, which entitles him to protection against the unauthorized or fraudulent use of the label.¹²

case at bar differs from those cases [Cigar Makers' Protective Union v. Conhaim, 40 Minn. 243, and Schneider v. Williams, 44 N. J. Eq. 391], however, in the respect before mentioned, that complainant is himself a manufacturer of cigars, and, according to the averments of the bill, has built up a profitable trade by the use [to which he was entitled] of the union label, which trade has been damaged, and is liable to be further damaged, by the fraudulent acts of the defendants. I think he is entitled to relief on the facts stated in the amended bill, and accordingly overrule the demurrer."

In *Weener v. Brayton* (1890) 152 Mass. 101, 107, Devens, J.: "Whether, if the bill had contained allegations similar to those found in the case of *Carson v. Ury* (39 Fed. 777), it might have been maintained, we have no occasion now to consider. Bill dismissed."

In *State v. Berlinsheimer* (1895) 62 Mo. App. 168, 174, Bond, J.: "We by no means hold that the members of said union who are engaged in manufacturing cigars may not have a proprietary interest in said label, as identifying and giving value to their goods, which would entitle them to enjoin an appropriation of it by the defendant under circumstances showing unlawful competition. *Carson v. Ury*, 39 Fed. 777."

¹² In *Strasser v. Moonellis* (1888) 23 Jones & S. (N. Y.) 197-208. Dugro, J.: "The question to which I refer is that raised by the defendant in his contention that the plaintiffs are not owners or manufacturers of cigars, but merely laborers employed to convert the material provided into the article of trade. The defendant's counsel, on the argument and in his brief, lays great stress on the fact that the label [of the Cigar Makers' International Union] presented in this case does not come within the settled definition of a trade-mark, as he claims it to be. It is needless to discuss this phase of the case, for the right to the exclusive use of this label may be sustained, although it fail to be a trade-mark, in the precise definition of the term as heretofore used. For whether we call the property right, which I believe the plaintiffs have in the label, a trade-mark, or by another name, is a matter of slight import. It is a right entitled to the protection of a court of equity on the

Many of the states have already adopted, and others are yearly adopting, statutes providing for the creation and protection of such property right in such labels, along the line of the decisions last referred to, and which statutes tend to

same principle as that upon which courts have based their right to protect trade-marks and goodwill. * * * It needs no deep study to perceive that the laborer has the same valuable interest in the goodwill of his labor as a manufacturer has in the goodwill of his trade. * * * The plaintiffs are entitled to be protected in the use and value of their property, and, as in this case it can be adequately protected only by an injunction, an injunction pendente lite will issue."

On appeal, Sedgwick, J.: "I am of opinion that the plaintiffs, being members of the Cigar Makers' International Union, had an interest in the proper use of the labels of the union which might, upon sufficient grounds, be protected by injunction against the inequitable use of those labels."

In *Cohn v. People* (1894) 149 Ill. 486, 494, Shope, J.: "We need not extend this discussion. We are of opinion that the label adopted by the Cigar Makers' International Union of America is neither immoral nor against public opinion, and might lawfully be adopted by that body."

In *Perkins v. Heert* (1896) 5 App. Div. (N. Y.) 335-341, Patterson, J.: "As this case is presented to us, it is not necessary to consider whether the label, the subject of this action, may be protected under the general rules of law applicable to trade-marks. * * * It is said that the statements in the label respecting the goods of the members of the international union, not being 'inferior rat-shop, coolie, prison, or filthy tenement-house workmanship,' are libelous, and that, therefore, the label should not be protected. It is before the court that, in the present form of the label, those words are not used, but they are not libelous anyway. * * * They libel nothing and nobody, but, not being in the amended label, the words are altogether immaterial now. * * * We think the judgment below [awarding a perpetual injunction] was right, and should be affirmed, with costs." Affirmed (1899) 158 N. Y. 306, all concurring.

In *Hetterman Bros. & Co. v. Powers* (1897) 102 Ky. 133-143, Hazelrigg, J.: "Moreover, it is urged that the plaintiffs do not come into court with clean hands; * * * that the label [of the Cigar Makers' International Union] itself cannot be approved, either in

(145)

“the growth and expansion, and perhaps the creation, of legal remedies unknown to ancient trade-mark law.”¹³

§ 86. No trade-mark acquired by inventor of system.

In *Jaeger's Sanitary Woolen System Co. v. Le Boutil-*

law or morals, as it denounces cigars other than union-made ones as inferior and unwholesome, and the product of filthy tenement houses, or made by coolies and convicts. And, first, we may admit that the label is not used as a trade-mark, in the ordinary sense of that word. It is not a brand put on the goods of the owner to separate or distinguish them from the goods of others, but we cannot agree, on that account, that it does not represent a valuable right which may be the subject of legal protection. Why may not those engaged in skillful employment so designate the result of their labor as to entitle them to the fruits of their skill, where it is admittedly a source of pecuniary property to them? And this, though they may not own the property itself? They are not, it is true, ‘in business’ for themselves, in the ordinary sense, but they have property rights nevertheless. They may not select a label and be protected in its use apart from its connection with some commodity, but they not only select it in this instance, they apply to the property, and it does not at all matter that the tangible property is that of another. * * * The man who is employed for wages is as much a business man as his employer, in that larger sense in which the word ‘business’ has come to be used by statesmen and legislators. * * * The learned chancellor below, in an exhaustive opinion reviewing all the authorities, among other things said, and we can say it no more clearly, that * * * hence it is indisputable that the employe whose skilled labor, in the production of a particular commodity, creates a demand for the same, that secures for him higher remunerative wages, has as definite a property right to the exclusive use of a particular label, sign, symbol, brand, or device, adopted by him to distinguish and characterize said commodity as the product of his skilled labor, as the merchant or owner has to the exclusive use of his adopted trade-mark on his goods. * * * On the whole case, therefore, we are of opinion that the law may be justly invoked by organized labor to protect from piracy and intrusion the fruits of its skill and handiwork, and that brain and muscle may be the subject of trade-law rules, as well as tangible property.”

¹³ In *Hetterman Bros. Co. v. Powers* (1897) 102 Ky. 133, 139, Hazel-

lier,¹⁴ it appeared that Professor Jaeger had conceded to the complainant the exclusive right to use the words "Normal" and "System Professor Jaeger." The New York supreme court held that, as Prof. Jaeger was not engaged in trade, he could not acquire any proprietary right in a trade-mark. In the opinion of the court it is stated: "In the case at bar, the plaintiff claims its right to the use of this so-called trade-mark because of a concession made by Prof. Jaeger in May, 1886. The difficulty, however, which the plaintiff necessarily encounters, is the fact that there is nothing to show that Prof. Jaeger had ever acquired a proprietary right in the words the use of which was sought to be enjoined as trade-marks. It does not appear that he had ever manufactured any of these goods; neither does it appear that he has been the vendor of such goods having attached thereto these words. But it seems to be assumed that, because he is the inventor of the system, he has, therefore, the right to make concessions of the use of the words which he has employed to designate his particular system. Such a condition of affairs in

rigg. J.: "In a number of the states, laws have been enacted giving protection to the men engaged in the business of working for wages, and their right of organizing and selecting appropriate symbols to designate the results of their handiwork is recognized and ordained to be the subject of lawful protection by the courts. Thus, in this state [Kentucky], in April, 1890, a law was enacted by the general assembly providing that 'every union or association of working men or women adopting a label, * * * etc.' This suit was filed before the adoption of this statute, but it indicates the policy of the law, the growth and expansion and perhaps the creation of legal remedies hardly known to ancient trade-mark law."

See chapter xvi. Also, *Bloete v. Simon* (1887) 19 Abb. N. C. (N. Y.) 88; *Cohn v. People* (1894) 149 Ill. 486; *State v. Bishop* (1895) 128 Mo. 373; *Perkins v. Heert* (1896) 5 App. Div. (N. Y.) 335; *Id.* (1899) 158 N. Y. 306.

¹⁴ (1888) 47 Hun (N. Y.) 521; (1892) 5 Misc. Rep. 78, 24 N. Y. Supp. 890.

no way conferred upon Prof. Jaeger any proprietary right. as he has not been engaged in trade, and has, therefore, been unable to acquire any proprietary right in a trade-mark.”

§ 87. Priority of adoption.

Where two or more persons claim the same trade-mark for the same commercial article, it must be awarded to him who shows the prior *bona fide* appropriation thereof, supplemented by a continuous use. A mere intention to adopt a trade-mark, or a declaration that one has adopted, or a mere casual use, will not be sufficient to confer title.¹⁵ As trade-marks have increased in importance with increase of commerce, and as the markets of the world have been brought nearer together by the adoption of modern inventions and business methods, the possibility of different persons having the same trade-mark in different localities has lessened. Formerly one person might have a trade-mark in one market, and a second have the same trade-mark in another, and the two never come in conflict; and while this may still be possible to a limited extent, it is not probable with trade-marks that possess any considerable commercial value.

The test in all cases of conflict as to priority of adoption is, which claimant was first to so use the mark as to fix in the market a conviction that goods so marked had their origin with him? Thus it has been held that the first use of the trade-mark “Epicure” by a complainant as a brand for pack-

¹⁵ Columbia Mill Co. v. Alcorn (1893) 150 U. S. 460, 14 Sup. Ct. 151; Stokes v. Landgraff (1853) 17 Barb. (N. Y.) 608; Maxwell v. Hogg (1867) 2 Ch. App. 307; Civil Service Supply Ass'n v. Dean (1879) 13 Ch. Div. 512; Candee v. Deere (1870) 54 Ill. 439; Munro v. Beadle (1890) 55 Hun (N. Y.) 312; Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444; Wagner v. Daly (1893) 67 Hun (N. Y.) 477; Whitfield v. Loveless (1893) 64 Off. Gaz. Pat. Off. 442; American Washboard Co. v. Saginaw Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

ed salmon, and the establishment of a business thereunder, entitled him to protection against the use of it by another for salmon, though that other had previously used it as a trade-mark for canned fruits and vegetables.¹⁶ It has also been held that the fact that a defendant had used the word "Royal" in connection with a grade of mustard made by him gives no right to use it to designate a flavoring extract, after the complainant had first distinctly appropriated the word for such other production.¹⁷

§ 88. Mere fact that trade-mark not in use in particular locality gives no one right to appropriate it.

The mere fact, however, that an established trade-mark is not at the time in use in a particular locality, gives no one

¹⁶ *George v. Smith* (1892) 52 Fed. 830.

¹⁷ *Royal Baking Powder Co. v. Sherrill* (1880) 59 How. Pr. (N. Y.)

17. See, also, *Royal Baking Powder Co. v. Raymond* (1895) 70 Fed. 376.

In *Columbia Mill Co. v. Alcorn* (1893) 150 U. S. 460, 463, Jackson, J.: "That the exclusive right to the use of the mark or device claimed as a trade-mark is founded on priority of appropriation; that is to say, the claimant of the trade-mark must have been the first to use or employ the same on like articles of production."

In *Stokes v. Landgraff* (1853) 17 Barb. (N. Y.) 608, T. R. Strong, J.: "The principle is well settled that a manufacturer may, by priority of appropriation of names, letters, marks, or symbols of any kind to distinguish his manufactures, acquire a property therein as a trade-mark, for the invasion of which an action for damages will lie, and in the exclusive use of which he may have protection, when necessary, by injunction."

In *Hyman v. Solis Cigar Co.* (1894) 4 Colo. App. 475, 477, 36 Pac. 444, 445, Reed, J.: "A trade-mark becomes the exclusive property of one only where he has, prior to any one else, appropriated and used it to indicate the ownership, origin, and quality of an article to which it is attached. *Stokes v. Landgraff*, 17 Barb. (N. Y.) 608; *Van Bell v. Prescott*, 82 N. Y. 630; *Morgan's Sons v. Troxell*, 89 N. Y. 297; *Taylor v. Carpenter*, 11 Paige (N. Y.) 292; *Ex parte Lyon*, Price & S. Am. Trade-Mark Cas. 911."

the right to appropriate it. If a manufacturer or vendor could secure a claim to a trade-mark on the ground alone that it was not in use, prior to the time when he adopted it, in the special locality in which he proposed to use it, the law for the protection of trade-marks would be shorn of most of its strength, for, on the same principle, other persons would be at liberty to adopt it in any locality in which it happened at the time not to be in use.¹⁸

§ 89. Right of prior domestic user.

It has been held that a foreigner engaged in manufacturing and selling goods in his own country under a registered trade-mark has no common-law right to such trade-mark in the United States, such as will enable him to claim the same, on establishing a branch business here, as against a domestic firm which had an established business under a similar trade-mark adopted in good faith, before the foreign manufacturer had sold any goods in this country.¹⁹

§ 90. How trade-mark may be acquired and held.

A trade-mark may be originally acquired only by adoption and use,²⁰ and it can be held only so long as the use continues.²¹

¹⁸ *Burke v. Cassin* (1873) 45 Cal. 467.

¹⁹ *Richter v. Anchor Remedy Co.* (1892) 52 Fed. 455, affirmed in *Richter v. Reynolds* (1893) 8 C. C. A. 220, 59 Fed. 577.

In *Richter v. Reynolds* (1893) 8 C. C. A. 220, 222, 59 Fed. 577, 579, Dallas, Cir. J.: "The complainant * * * has not shown sales of his medicines in this country prior to defendants' use, nor any importations, except to a limited extent upon special orders, to supply particular customers. This is not enough. It does not amount to use 'in such circumstances, as to publicity and length of use, as to show an intention to adopt it as a trade-mark for a specific article.' It indicates no intention to acquire title, and therefore none was acquired."

²⁰ *Hyman v. Solis Cigar Co.* (1894) 4 Colo. App. 475, 36 Pac. 444;

§ 91. Use necessary to support claim to trade-mark.

While the law does not require that the use of the trade-mark shall have been long continued,²² or that the article on which it is used should be widely known, or should have attained great reputation,²³ it does require that it shall be

Wagner v. Daly (1893) 67 Hun (N. Y.) 477; Columbia Mill Co. v. Alcorn (1893) 159 U. S. 469, 14 Sup. Ct. 151; Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192; Derringer v. Plate (1865) 29 Cal. 292; Ferguson v. Davol Mills (1868) 2 Brewst. (Pa.) 314; Messerole v. Tynberg (1868) 4 Abb. Pr. (N. S.; N. Y.) 410, 36 How. Pr. (N. Y.) 14; Hegeman v. Hegeman (1880) 8 Daly (N. Y.) 1; Shaver v. Shaver (1880) 54 Iowa, 208; Selchow v. Baker (1883) 93 N. Y. 59; Seltzer v. Powell (1871) 8 Phila. (Pa.) 296; Handy v. Commander (1897) 49 La. Ann. 1119; American Wash-Board Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

²¹ Trade-Mark Cases (1879) 100 U. S. 82; Caswell v. Hazard (1890) 121 N. Y. 484.

In Caswell v. Hazard (1890) 121 N. Y. 484, 494, Ruger, Ch. J.: "The right to a trade-mark is derived from its appropriation and continual user, and becomes the property of those who first employ it and give it a name and reputation. Devlin v. Devlin, 69 N. Y. 212; Colman v. Crump, 70 N. Y. 578."

In Messerole v. Tynberg (1868) 36 How. Pr. (N. Y.) 14, 18, Brady, J.: "All the essential requisites to the plaintiff's right to protection flow from the prior use of a term, symbol, or word which has created for his manufacture a celebrity or value; and the burden of showing that the claim of priority is unfounded, or the absence of any injury resulting from its imitation, rests upon the defendant."

²² Shaver v. Shaver (1880) 54 Iowa, 208; Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kniepp Medicine Co. (1897) 27 C. C. A. 351, 82 Fed. 321.

²³ Kathreiner's Malzkaffee Fabriken, etc., v. Pastor Kniepp Medicine Co. (1897) 27 C. C. A. 351, 82 Fed. 321; American Wash-Board Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281.

In Smith v. Walker (1885) 57 Mich. 456, 474, Sherwood, J.: "It is well settled that a manufacturer or vendor may, by a priority of appropriation and adoption of names, marks, letters, or other proper and appropriate symbols, so distinguish his manufactures from others as to acquire a property therein as a trade-mark, but not, however, until he has given it out and published it to the community

for such length of time and under such circumstances as to publicity as to show an intention to adopt it as a trade-mark

as his, and that he has adopted it as an original thing, or has in some way become the lawful owner thereof. *Stokes v. Landgraff*, 17 Barl. (N. Y.) 608; *Williams v. Johnson*, 2 Bosw. (N. Y.) 6; *Amoskeag Mfg. Co. v. Spear*, 2 Sandf. (N. Y.) 599."

In *Kathreiner's Malzkaffee Fabriken Mit Beschränkter Haftung v. Pastor Kneipp Medicine Co.* (1897) 27 C. C. A. 351, 356, 32 Fed. 321, 326, *Jenkins*, Cir. J.: "It is enough, we think, if the article with the adopted brand upon it is actually a vendible article in the market, with intent by the proprietor to continue its production and sale. It is not essential that its use has been long continued, or that the article should be widely known, or should have attained great reputation. The wrong done by piracy of the trade-mark is the same in such case as in that of an article of high and general reputation, and of long-continued use. The difference is but one of degree, and in the quantum of injury. A proprietor is entitled to protection from the time of commencing the user of the trade-mark. *McAndrew v. Bassett*, 4 De Gex, J. & S. 380; *Jackson v. Napper*, 4 Rep. Pat. Cas. 45; *Cope v. Evans*, L. R. 18 Eq. 138; *Hall v. Barrows*, 32 Law J. Ch. 548."

In *Kohler Mfg. Co. v. Beeshore* (1893) 8 C. C. A. 215, 219, 59 Fed. 572, 576, *Shiras*, Cir. J.: "A merely casual use, interrupted, or for a brief period, would not support a claim to a trade-mark. *Menendez v. Holt*, 128 U. S. 514, 9 Sup. Ct. 143. Nor will a court of equity recognize by injunction a proprietary right in a phrase or name, unless it has been used in such circumstances, as to publicity and length of use, as to show an intention to adopt it as a trade-mark for a specific article."

In *Levy v. Waitt* (1894) 10 C. C. A. 227, 61 Fed. 1008, 1011, *Putnam*, Cir. J.: "The right to a trade-mark at common law must not be confused, as it too frequently is, with the prima facie right existing under registration statutes. It arises to such a limited extent, from the mere matter of selection or discovery of the name or symbol used, that this may be of trivial consequence. A singular illustration of this fact is found in *Siegert v. Findlater*, 7 Ch. Div. 801, where, as applied to Dr. Siegert's bitters, the word 'Angostura,' indicating the place of their origin, was not selected by him as his trade-mark, but, instead thereof, the words 'Aromatic Bitters,' to which he added a statement that the bitters were prepared by him at Angostura. The public, however, applied to them the words 'Angostura Bitters,' so that, by the act of the public, those words be-

for a specific article. A mere casual use, interrupted, or for a brief period, will not support a claim to a trade-mark. Importation by a foreign manufacturer of goods, to a limited extent, upon special orders to supply particular customers in this country, does not amount to such use as will support a claim to a trade-mark.²⁴ The application of a mark to an article by a manufacturer at the request of a customer does not amount to such use as will sustain a claim to the mark, even against a manufacturer who adopts the mark at a later date.²⁵

§ 92. Use, not invention, of trade-mark that creates right.

It is the use of a trade-mark, and not its invention, that creates the right.²⁶ It has sometimes been assumed that the common-law right to a trade-mark comes more from selection or discovery than from actual use of the mark;²⁷ but this is not the law. The right to a trade-mark at common law must not be confused, as it too frequently is, with the *prima facie* right existing under registration statutes.²⁸ It arises to such a limited extent from mere matter of selection or discovery of the name or symbol used that this may be of trivial consequence. The ordinary trade-mark has no

came the usual designation of the article, which the court protected in the case referred to."

²⁴ Kohler Mfg. Co. v. Beeshore (1893) 8 C. C. A. 215, 59 Fed. 572; Richter v. Reynolds (1893) 8 C. C. A. 220, 59 Fed. 577, affirming 52 Fed. 455; Smith v. Walker (1885) 57 Mich. 456.

²⁵ Levy v. Waitt (1893) 56 Fed. 1016, affirmed (1894) 10 C. C. A. 227, 61 Fed. 1008.

²⁶ Rowley v. Houghton (1868) 7 Phila. (Pa.) 39; American Wash-Board Co. v. Saginaw Mfg. Co. (1900) 43 C. C. A. 233, 103 Fed. 281; Schneider v. Williams (1888) 44 N. J. Eq. 391; Dr. Jaeger's Sanitary Woolen System Co. v. Le Boutillier (1888) 47 Hun (N. Y.) 521; George v. Smith (1892) 52 Fed. 830.

²⁷ Brown, Trade-Marks, § 52.

²⁸ Levy v. Waitt (1894) 10 C. C. A. 227, 61 Fed. 1008.

necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident, rather than design.²⁹ The simple question in these cases is, has the claimant, by the appropriation of a peculiar mark, fixed, in the market where his goods are sold, a conviction that the goods so marked are manufactured by him? and, if so, and if no one else has been in the habit of using that mark, another has not the right to use that mark, so as to commit the fraudulent act of palming off his goods as being the goods of the person who is known to have been in the habit of using it.³⁰

²⁹ Trade-Mark Cases (1879) 100 U. S. 82-94; Rowley v. Houghton (1868) 7 Phila. (Pa.) 39.

³⁰ Collins Co. v. Brown (1857) 3 Kay & J. 423.

In Handy v. Commander (1897) 49 La. Ann. 1119-1129, Watkins, J.: "The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law, the exclusive right to it grows out of its use, and not its mere adoption. * * * But it does not depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination; no genius nor laborious thought. It is simply founded on priority of appropriation. [Trade-Mark Cases, 100 U. S. 82.] * * * Every one is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of same general nature manufactured or sold by others. * * * The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and are assurance that they are the genuine article of the original producer. * * * It becomes his trade-mark, and the courts will protect him in its exclusive use." Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51.

In Schneider v. Williams (1888) 44 N. J. Eq. 391-396, Van Fleet, V. C.: "How may property in a trade-mark, or a right to a trade-mark, be acquired? It would seem to be settled, beyond question, that there can be no such thing as a trade-mark distinct from and unconnected with a vendible commodity. As the words themselves import, to make the thing selected or adopted answer the purposes of a trade-mark, it must be so used as to mark or distinguish some-

§ 93. Use must be sufficient to point out origin of claimant's goods.

As the exclusive right to the use of a trade-mark rests, not on invention, but on such use as makes it point out the origin of the claimant's goods, it must begin early enough, and be separate enough for the purpose; but absolute priority of invention is not required. Use by another before, at the

thing which is the subject of traffic,—something which is bought and sold. * * * It would appear to be entirely clear that a person who desires to acquire a right to a trade-mark must do three things, each of which is indispensably requisite to the acquisition of the right: First, he must select or adopt some mark or sign not in use to distinguish goods of the same class or kind already on the market, belonging to another trader; second, he must apply his mark to some article of traffic; and, third, he must put his article, marked with his mark, on the market. Mere adoption of a mark or sign, and a public declaration, by advertisement or otherwise, that a person will, at a subsequent time, put a particular thing on the market, marked or distinguished in a certain way, create no right. Until the thing is actually on the market, marked by the particular mark of the person intending to acquire a title, no property right in the mark arises. *Lawson v. Bank of London*, 18 C. B. 84; *Maxwell v. Hogg*, 2 Ch. App. 307, 314."

In *Rowley v. Houghton* (1868) 7 Phila. (Pa.) 39, 40, Ludlow, J.: "The defendant is driven to the position that he is entitled to his peculiar trade-mark because he suggested the name to the complainant. The law as settled will, however, hardly sustain the claim of the defendant. It was demonstrated in *Colladay v. Baird*, and the cases there cited (see 4 Phila. [Pa.] 139), that no right can be absolute in a name as a name merely; it is only when the name is printed or stamped upon a particular label or jar, and thus becomes identified with a particular style and quality of goods, that it becomes a trade-mark. In this instance, the complainant has used the name, as such, has established for it a reputation and value, has doubtless expended large sums of money in introducing it to the trade. * * * If the defendant had not only suggested, but had also legally used, this trade-mark, he would doubtless have a concurrent right with the plaintiff, but, under the evidence before us, he has not, in any just and legal sense, done this, but simply proposes to do it."

same place, or near enough to start a similar right, would prevent the use from showing such origin. The other use might be so far away, or so small, as to have no effect upon the use in question, to prevent it becoming a representation of origin.³¹ While there is nothing to prevent the same person from having two or more trade-marks for the same article, if he seeks to appropriate one to himself, he must do it by no uncertain use.³²

§ 94. Declaration of claimant cannot lay foundation of right.

That the published declarations of a manufacturer that he has adopted a certain word as his trade-mark can lay the foundation, or even aid in laying the foundation, of a right of property in the word, cannot be reconciled with recognized principles, upon which such property can be acquired, or with the policy of the law in recognizing and protecting the acquisition. It is the actual use of the trade-mark affixed to the merchandise of the manufacturer, and this alone, which can impart to it the element of property. The mere declaration of a person, however long, and however extensively published, that he claims property in a word as his trade-mark, cannot even tend to make it his property. No title arises until the thing is actually on the market, marked with the particular mark.³³

³¹ Tetlow v. Tappan (1898) 85 Fed. 774; Menendez v. Holt (1888) 128 U. S. 514.

³² Metcalfe v. Brand (1887) 86 Ky. 331.

³³ Candee v. Deere (1870) 54 Ill. 439; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (1892) 142 Ill. 494; Schneider v. Williams (1888) 44 N. J. Eq. 391.

In *Civil Service Supply Ass'n v. Dean* (1879) 13 Ch. Div. 512, 516, Malins, V. C.: "Now, Mr. Rogers [of counsel for plaintiffs] argued that, although the association had no place where they sold boots and shoes when these words were put in the window, there was an intimation that they were going to do so. I drew his at-

(156)

§ 95. Voice of public cannot appropriate trade-mark to individual.

Nor can the public, by its voice, appropriate and consecrate to an individual property in a designation by which he may choose to denote any product of his industry, but which he does not actually apply to his goods.³⁴

tention to the rule laid down in *Maxwell v. Hogg* (2 Ch. App. 307), that the intention to issue a publication confers no property. So, too, in this case, an intimation by the association that they intended to open a shop for a particular purpose can give them no right to restrain anything which any other person may think fit to do."

In *Maxwell v. Hogg* (1867) 2 Ch. App. 307, 315, Sir H. M. Cairns, L. J.: "I am prepared to hold, without any hesitation, that the mere intention, and the declaration of intention, to use a name, will not create any property in that name, and to hold also that there can be no protection in this court for the intended name during the course of manufacture of the article which is to bear that name."

³⁴ *Blackwell v. Armistead* (1872) 3 Hughes, 163, Fed. Cas. No. 1,474. See *Goodyear Rubber Co. v. Goodyear's Rubber Mfg. Co.* (1884) 21 Fed. 276. *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1888) 128 U. S. 598; *Geo. T. Stagg Co. v. Taylor* (1894) 95 Ky. 651, 27 S. W. 247.

In *Blackwell v. Armistead* (1872) 3 Hughes, 163, 167, Fed. Cas. No. 1,474, Rives, J.: "It cannot be denied that it is abundantly proven in this cause that the manufacture of Morris & Wright, and of those who succeeded them at Durham [the defendant claiming under Wright], 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."

In *Goodyear Rubber Co. v. Goodyear's Rubber Mfg. Co.* (1884) 21 Fed. 276, 278, Wallace, J.: "Concisely stated, the question would seem to be whether the defendant can appropriate to itself the vari-

§ 96. Use by one claimant will not prevent adoption by another for different article.

The use of a trade-mark by one manufacturer or vendor will not ordinarily prevent another from adopting the same trade-mark for a different article.³⁵ He cannot prevent its use when the use is entirely innocent, and represents nothing in regard to the plaintiff's connection with the goods, and does not impose on the public.³⁶ Where the word "Celluloid" was used in connection with starch to make an attractive name, and suggest that the starch produced the glossy appearance of celluloid, it was held that the distinctive portion of the complainant's corporate name had been used against its will by the defendant, and that its trade-mark had been likewise used, but that it did not affirmatively appear that said name and said trade-mark had been used in a way to induce the public to believe or create the impression that the starch which bore the name was connected with the complainant, or was the product, in part, of its manufacture. The prospect that the complainant would

ous misnomers applied to it by the carelessness or inaccuracy of a comparatively small number of its customers during a period of ten or eleven years, notwithstanding the zealous and active measures of its managers to repress the practice, and their success in preventing it from ripening into a general usage. It would hardly be contended that an individual could found a claim of possessory right to any species of property upon the unauthorized conduct of other persons, or maintain that he had adopted a name symbolizing his products, or identifying his personalty with his business, by protesting against its use, and of course a corporation does not occupy a different position. The proofs show that there was no general recognition of the defendant among its customers by any other than its corporate name, and no adoption by the defendant of a different name, and it must be held that the occasional or persistent use of the misnomer by a few of the defendant's customers gave no privilege to the defendant to a monopoly in the use of the name."

³⁵ Sheppard v. Stuart (1879) 13 Phila. (Pa.) 117.

³⁶ Colman v. Crump (1877) 70 N. Y. 573.

in future want to manufacture starch, or some article which has the use of or simulates starch, was held to be too shadowy to base an injunction upon.³⁷ It was also held that a dealer in dry white oxide of zinc has no remedy against another who uses the same trade-mark to distinguish the oxide when ground in oil. In this case Judge Blatchford said: "The defendants have not sold the dry white oxide in that state. It is not shown that the plaintiffs have sold such oxide ground in oil. It is true that the oxide is intended to be ground with oil for a paint. So, flour is intended to be made into bread; but if a baker should falsely stamp his bread with the mark of a particular brand of flour, the maker of such brand, if having a trade-mark therefor, could not claim that the baker had violated his trade-mark. And so of any other raw material which enters as an ingredient into a compound or article of manufacture."³⁸ But where the trade-mark was of a personal character, and its use by a second manufacturer, on a different article belonging to the same general class of goods, was calculated to lead purchasers to believe that the goods made by the second manufacturer were in fact made by the first manufacturer, the use of the trade-mark by the second manufacturer was held to be an unlawful appropriation of it, and was enjoined.³⁹ And where the plaintiff had used its trade-mark upon baking soda and saleratus only, and not upon baking powder, the defendant was enjoined from using the same mark upon baking powder, the court holding that baking powder and baking soda are in the same class. The court said: "Goods are in the same class whenever the use of a given trade-mark or

³⁷ Celluloid Mfg. Co. v. Read (1891) 47 Fed. 712-715.

³⁸ La Societe Anonyme Des Mines v. Baxter (1877) 14 Blatchf. 261, Fed. Cas. No. 8,099. See, also, Osgood v. Rockwood (1873) 11 Blatchf. 310, Fed. Cas. No. 10,605.

³⁹ Collins Co. v. Oliver Ames & Sons Corp. (1882) 18 Fed. 561.

symbol on both would enable an unscrupulous dealer readily to palm off on the unsuspecting purchaser the goods of the infringer as the goods made by the owner of the trade-mark, or with his authority and consent. The fact that the complainant has not used its trade-mark upon packages of baking powder constitutes no ground of defense. It has the right to manufacture or sell baking powder, and to use its trade-mark in connection with such manufacture or sale. The right to use its own trade-mark upon baking powder manufactured or sold by it would be valueless if all others were at liberty to use the same trade-mark on baking powder manufactured or sold by them."⁴⁰

The case of *Amoskeag Mfg. Co. v. Garner*⁴¹ came before the supreme court of New York at special term in May, 1869, on a motion to dissolve an injunction *pendente lite* previously granted restraining the defendant from applying the word "Amoskeag" as a trade-mark to prints or calicoes. The court held that, as the plaintiffs had never applied the word "Amoskeag" as a trade-mark to prints or calicoes, but only to unprinted cotton cloth, it could not restrain the defendant from applying the same word to prints or calicoes. Seven years later, the same case came before the same court on final hearing, and the court,⁴² while holding that the injunction *pendente lite* had been properly refused, granted a permanent injunction restraining the defendant from applying the word "Amoskeag" to prints or calicoes. In the course of its opinion, the court used the following illustration: "But now suppose the plaintiff had received from the legislature of New Hampshire the name of 'The Amos-

⁴⁰ *Church v. Russ* (1900) 99 Fed. 276-280; *Godillot v. American Grocery Co.* (1896) 71 Fed. 873; *Carroll v. Ertheller* (1880) 1 Fed. 688.

⁴¹ (1869) 6 Abb. Pr. (N. S.; N. Y.) 265.

⁴² *Amoskeag Mfg. Co. v. Garner* (1876) 54 How. Pr. (N. Y.) 297.

keag Baking Company,' and for forty years had been engaged in the humbler, though hardly less useful, avocation of 'manufacturing' almost every variety of bread, roll, muffin, cracker, biscuit, cake, and pie, on which articles of food it had invariably stamped its corporate name, or some abbreviation thereof, such as 'Amoskeag B. Co.,' or 'Am. Baking Co.," or 'Am. B. Co.," or 'Amoskeag.' Suppose, however, that the plaintiff had omitted or had not yet decided to make and vend the single variety known as 'crumpets,' and thereupon a rival baker attempted to sell his crumpets as 'Amoskeag Crumpets,' would not any customer, upon seeing the name thus applied, naturally say that the Amoskeag Baking Company had added crumpets to its other varieties of bread? And would not the rival bakery be restrained, upon the plain principle of an unauthorized use of the company's name? The parallel is not precise, as the printing of calicoes may require some additional machinery, but the difference is only in degree."

In a recent case in New York it appeared that the plaintiff manufactured and sold a liniment under the name "Omega Oil." The defendants put on the market an "Omega Oil Soap." In the opinion of the court granting an injunction it is said: "That the plaintiff has a valid trade-mark in the name 'Omega Oil' is beyond dispute, and it does not seem to be questioned by defendants, but it is claimed the exclusive use of this name is limited to an article of the same class as that to which it has been applied by plaintiff, *i. e.*, a liniment, and that a soap is of a different class, and that, therefore, plaintiff's trade-mark does not extend to the use of the words as adopted by defendants and applied to a soap. It was conceded, upon the argument hereof by defendants' counsel, that defendants had adopted the words 'Omega Oil' because they had become well known to the public. The equities of the

case are clearly with the plaintiff. I am satisfied from the proof here submitted that the articles, *i. e.*, liniment and soap, are not of such a different character as will permit the defendants the use of the name created and made valuable by plaintiff. The liniment may have a much broader application than the soap, but it also possesses to a certain extent the qualities of the soap, and is used for many of the same purposes."⁴³

§ 97. Trade-marks also acquired by transfer.

Trade-marks may also be acquired by purchase or inheritance;⁴⁴ but as a trade-mark cannot exist by itself, it follows that it can be acquired, other than by original appropriation, only as appurtenant to an established business, or the goodwill thereof, and it can be held by the transferee, the same as by an original proprietor, only so long as its use is continued, upon or in connection with an article of the character or species to which it was originally attached.⁴⁵

§ 98. To what trade-marks may be applied.

In the law of trade-marks there is no distinction between artificial or manufactured products and those which are natural and spontaneous. The rules laid down in respect to an artificial or manufactured article are said to apply to the proprietorship of any peculiar natural product which a party may have acquired with the avails of his industry, sagacity,

⁴³ *Omega Oil Co. v. Weschler* (1901) 35 Misc. Rep. (N. Y.) 441, 442.

In *Colman v. Crump* (1877) 70 N. Y. 573, 580, Allen, J.: "The fact that the same device is used upon other articles of merchandise does not take from the plaintiffs their right to its exclusive use on this one article of their manufacture."

⁴⁴ See chapter vi., "Transfer of Trade-Marks."

⁴⁵ *Walton v. Crowley* (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; *Filkins v. Blackman* (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786.

and enterprise; the owner or vendor of the one, equally with the owner or vendor of the other, having a right to the exclusive use of the mark employed in connection with the sale of the article. It is very obvious that this must be so if the reason for the interference of the court is founded upon the injury to the owner when his trade-mark is invaded, or the fraud upon the public; for whether the commercial article be natural or artificial, the purchaser has imposed upon him an article that he never meant to buy, and the owner "is robbed of the fruits of the reputation that he had successfully labored to earn." Hence a trade-mark may be applied to any commercial article, natural or artificial.⁴⁶ Thus it has been held that the words "Congress Water" and "Congress Spring Water" appropriately indicated the origin of the water flowing from the spring in question, and that the proprietors of the spring had an exclusive right to the use of the word "Congress" as a trade-mark in connection with such water.⁴⁷ A similar ruling has been made as to the word "Bethesda," applied to the water from a certain spring, and the defendant was enjoined from applying the same name to water from another spring, located only twelve hundred feet from the former, and alleged to have exactly the same composition and curative qualities.⁴⁸ In the case of *Hoyt v. J. T. Lovett Co.*⁴⁹ it was held that the protection of a trade-mark

⁴⁶ *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 N. Y. 291; *Dunbar v. Glenn* (1877) 42 Wis. 118.

⁴⁷ *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 N. Y. 291.

⁴⁸ *Dunbar v. Glenn* (1877) 42 Wis. 118; *Parkland Hills Blue Lick Water Co. v. Hawkins* (1894) 95 Ky. 502.

⁴⁹ (1895) 71 Fed. 173.

In *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 N. Y. 291-299, Folger, J.: "The questions involved in this appeal are two: First. Can the owner of a peculiar product of nature be protected in the exclusive use of a name belonging

cannot be obtained for an organic article, such as a species of grape vine, which, by the law of its nature, is reproductive, and derives its innate vital powers independent of the care or ingenuity of man.

to it alone, and employed by him as his trade-mark in his sale thereof? Second. Does the name or trade-mark used in the case before us by the plaintiffs indicate the origin, ownership, or place of that product, and is it one in the exclusive use of which the plaintiffs should be protected? * * * The court interferes to protect the plaintiff, who has an exclusive right to use any particular mark or symbol in connection with the sale of some commodity. It is because it is his property for the purpose of such application. For the benefit of the vendor, the application of the mark or symbol may be as well to a vendible commodity natural as to one artificial, and thus the vendor of the one, equally with the vendor of the other, have a right in his mark. In *Amoskeag Mfg. Co. v. Spear* [in 2 Sandf. (N. Y.) 599], it is said that 'every merchant for whom goods are manufactured has an unquestionable right to distinguish the goods he sells by a peculiar mark or device.' He has used his capital to buy the exclusive right to vend for his own profit the peculiar product of another's skill. He has devoted and is giving his time, energy, and sagacity to extending the sale of it, with the hope and expectation of that profit. No reason presents itself why he is entitled to protection in the exclusive use of the symbol which designates that product of another's skill, more than one who, with equal capital, energy, and sagacity, has purchased the sole place of origin of a peculiar product of nature, and is engaged in the sale of it for profit. Both are so entitled. * * * There is but one Congress spring, and but that one spring from which does flow Congress water, exclusively possessed of these peculiar curative medicinal qualities, and there can be no question but that these proprietary marks, adopted and used by the plaintiffs and their predecessors, do indicate the true origin and ownership of this water, and that they have been and are now appropriated as designating the true origin and ownership of the article to which they are affixed."

In *Parkland Hills Blue Lick Water Co. v. Hawkins* (1894) 95 Ky. 502-505, Hazelrigg, J.: "It was said [in *Dunbar v. Glenn*, 42 Wis. 118] the law in relation to trade-mark applied, whether the vendible commodity be natural or artificial. * * * So, also, in *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y. 291, it was held that the owner of a peculiar product of nature, such

§ 99. How trade-marks may be applied.

It is essential to the idea of a trade-mark that it be affixed in some way, as by stamping, printing, carving, or engraving, to the commercial article to which it is applied, or to the packages or receptacles containing and sold with such articles, and so as to be reasonably durable and visible.⁵⁰ The mere declaration of a person that he claims property in a word or symbol not actually used on the article, or the package or receptacle inclosing it, does not make it his property.⁵¹ It has been held in a French case that the trade-mark may be applied to that part of a cork stopper that is inserted in the bottle neck, when in use, so that the mark is hidden until the cork is removed.⁵² It has also been held in a recent case before the patent office that the trade-mark may be printed or otherwise placed on a paper sheet or strip, and placed loosely in the receptacle with the article for which it is a trade-mark.⁵³

as mineral water, will be protected in the exclusive use of a name given to it and employed as a trade-mark. The word 'Congress' in the phrases 'Congress Water' and 'Congress Spring Water' was held to be a legitimate trade-mark."

⁵⁰ *Candee v. Deere* (1870) 54 Ill. 439; *St. Louis Piano Mfg. Co. v. Merkel* (1876) 1 Mo. App. 305; *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1892) 142 Ill. 494; *Oakes v. St. Louis Candy Co.* (1898) 146 Mo. 391; *Rowley v. Houghton* (1868) 2 Brewst. (Pa.) 303.

⁵¹ *Candee v. Deere* (1870) 54 Ill. 439.

⁵² *Ministere Pub. v. Bernard*, Journ. du Palais, 1845; *Browne, Trade-Marks*, § 89.

⁵³ *Hay & Todd Mfg. Co. v. Querns* (1899) 86 Official Gazette, 1323.

CHAPTER V.

LOSS OF TRADE-MARK RIGHTS.

- § 100. General Rule.
- 101. Abandonment.
- 102. Intent to Abandon must be Shown.
- 103. Registration as Affecting Question of Abandonment.
- 104. Circumstances of Each Case must be Considered.
- 105. Abandonment by Nonuser.
- 106. Laches.
- 107. Rule Where Use is Justified.
- 108. Rule Where Fraud Appears.
- 109. Other Cases Considered.
- 110. Dedication to Public by Expiration of Patent.
- 111. Dedication to Public by Expiration of Copyright.
- 112. Other Forms of Dedication to Public.
- 113. Acquiescence of Original User Necessary.
- 114. General Use of Name does not Dedicate It to Public.
- 115. Whether Name has Become Generic is Question of Fact.

§ 100. General rule.

Trade-mark rights, once acquired, are perpetual unless lost by some act or omission of the proprietor, or by operation of law. Such loss of trade-mark rights may be partial or total, and the right to individual appropriation, once lost, is gone forever. While such loss usually arises from some act or omission on the part of the proprietor, it may arise, without his consent and against his will, from operation of law upon a state of facts over which the proprietor has no control. When the exclusive right to use a trade-mark terminates, no corresponding benefits result to the public. Its value is gone when it ceases to be exclusive, and becomes the property of the public.¹

¹ *Leidersdorf v. Flint* (1878) 8 Biss. 327, Fed. Cas. No. 8,219.

§ 101. Abandonment.

A trade-mark, whether it consists of a symbol or a name, may be abandoned, and, if it is, it may then be appropriated by any one, who, by so doing, 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 of test being, was there an intention to abandon? which will depend upon the circumstances of the particular case.²

§ 102. Intent to abandon must be shown.

In the case of *Saxlehner v. Eisner & Mendelson Co.*³ the supreme court of the United States, in considering the defense of abandonment of a trade-mark, said: "To establish the defense 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." In that case, the court held that the defense of abandonment was not made out where there was but very slight evidence on the part of the original proprietor or his successor in interest to abandon the use of the word in question, or to dedicate the same to the public, and none at all of an intent to abandon the peculiar bottles and labels in connection with which the proprietor sold his waters, and where, in fact, the original proprietor's whole

² *Hegeman v. Hegeman* (1880) 8 Daly (N. Y.) 1; *O'Rourke v. Central City Soap Co.* (1885) 26 Fed. 576.

³ (1900) 179 U. S. 19, 21 Sup. Ct. 7.

life was a constant protest against the use by others of the name involved. Upon this point the court said: "The evidence shows that these Hungarian bitter waters were largely known in this country as 'Hunyadi Waters,' and that, in a certain sense, 'Hunyadi' had become a generic word for them. Of course, if it became such with the assent and acquiescence of Saxlehner, he could not thereafter assert his right to its exclusive use; but as this appropriation was made against his constant protest, and as he apparently made every effort in his power to put a stop to the use of it, it ought not to be charged up against his claim that the word had become generic." In deciding this case in the circuit court, Judge Shipman found actual abandonment from the fact that the Apollinaris Company, after it had acquired the exclusive right to sell "Hunyadi Janos" water in this country, and after it had in fact, for several years, sold large quantities here, and after the owner of the wells failed to suppress in Europe "Hunyadi" as prefixed to the names of other competing waters, and partly in consequence thereof, certain suits instituted in this country for infringement were voluntarily dismissed, and the use of the name became common by competitors, published notices stating that "Hunyadi" had become a general name for bitter Hungarian waters, and that it would henceforth distinguish its "Janos" water by a red diamond on the label, which was done for several years, and until the termination of the contract.⁴

§ 103. Registration as affecting question of abandonment.

It was also held, in the case cited in the last preceding section, that the registration of the words "Hunyadi Janos" did not estop the proprietor from subsequently claiming a

⁴ Saxlehner v. Eisner & Mendelson Co. (1898) 88 Fed. 61. See, also, (1899) 33 C. C. A. 291, 91 Fed. 536.

trade-mark in the word "Hunyadi" alone. In the case of *Richter v. Anchor Remedy Co.*⁵ it was held that the registration in the United States patent office of "a red anchor in the oval space or field" was an abandonment of any broad claim in the exclusive use of the word "anchor" and its symbol. This case was affirmed by the circuit court of appeals for the third circuit,⁶ and was followed by the circuit court for the eastern district of Missouri in the case of *Pittsburgh Crushed-Steel Co. v. Diamond Steel Co.*⁷

§ 104. **Circumstances of each case must be considered.**

The circumstances of each case must be considered in determining the question of abandonment. Acts that, under certain circumstances, will be held to constitute abandonment in other cases, will not have this effect. For example, it has been held that an admission in a complaint or evidence before the court of plaintiff's acquiescence in, while cognizant of, defendant's use of the trade-mark in question, would not establish abandonment by plaintiff of such trade-mark, but it would be sufficient answer to any claim for damages for such use.⁸ The consent of a manufacturer to the use or imitation of his trade-mark by another may be inferred from his knowledge and silence; but such consent, whether expressed or implied, when purely gratuitous, may be withdrawn, and, when implied, it lasts no longer than the silence from which it springs. It amounts to 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 should be decreed, but even the admission of the

⁵ (1892) 52 Fed. 455.

⁶ (1893) 8 C. C. A. 215, 59 Fed. 572.

⁷ (1898) 85 Fed. 637. See, also, *Hennessy v. Braunschweiger* (1898) 89 Fed. 664.

⁸ *Julian v. Hoosier Drill Co.* (1881) 78 Ind. 408.

fact would furnish no reason for refusing an injunction.⁹ The fact that different parties have wrongfully used, at various times, some word, letter, or character which composed plaintiff's entire mark, is not sufficient to establish an abandonment of the mark by plaintiff.¹⁰ And where the long and successful use of a trade-mark is clearly established, the fact that the owner has recognized and permitted the limited use thereof by another, which does not appear to have misled anybody, is not sufficient to defeat the owner's right to prevent others from using it.¹¹ And it has been held that the fact that the plaintiff had issued a notice or "caution" to the public against the fraudulent use of his device, showing that he knew that others had used the same combination of numerals as his own, for the purpose of defrauding him, will not be deemed an acquiescence in the use by such others of the particular arrangement of numerals upon steel pens and packing boxes which the plaintiff had first adopted and used.¹² Where an infringer invoked prescription for one year, the supreme court of Louisiana held it not tenable, and concurred with counsel for plaintiff and the authorities cited by him that the infringer who illegally appropriates a trade-mark to his own use, making profit thereby, may be treated as the owner's trustee in respect of such profits, and may be compelled to account therefor in equity. In this case, the defendant also contended that, from long use by others, he was justified in imitating the trade-mark, and in supposing acquiescence on the part of the owner. Upon this point, the court quoted from the opinion of Woodbury, J., in the case of *Taylor v. Carpenter*, as follows: "There is some-

⁹ *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Amoskeag Mfg. Co. v. Garner* (1876) 54 How. Pr. (N. Y.) 297.

¹⁰ *Sohl v. Geisendorf* (1871) 1 Wils. (Ind.) 60.

¹¹ *Tetlow v. Tappan* (1898) 85 Fed. 774.

¹² *Gillott v. Esterbrook* (1867) 47 Barb. (N. Y.) 455.

thing very abhorrent in allowing such a defense to a wrong, which consists in counterfeiting others' marks or stamps, defrauding others of what had been gained by their industry and skill, and robbing them of the fruits of their 'good name,' merely because they have shown forbearance and kindness. It is rather an aggravation to the plaintiffs that many others have injured them."¹³ It has also been held that permission to one who is merely a dealer to place his name on articles bearing the trade-mark of a manufacturer is no indication of an abandonment of the trade-mark by the manufacturer, especially if such permission was in accordance with the custom of the trade.¹⁴ In *Filley v. Child* it appeared that the plaintiff, during the entire twenty-one years' duration of his patent, knew of and acquiesced in the manufacture and sale by the defendant, and those under whom he claimed, of cooking stoves containing the patented improvements with the name "Charter Oak" upon them, and, as the defendant had built up a business through such acquiescence in the manufacture and sale of such cooking stoves with such name, the plaintiff could not, after the expiration of the patent, and when the defendant had a right to make stoves containing said improvements, prevent him from calling them by the name "Charter Oak," so long as he did not represent them as made by the plaintiff, or induce others to believe that they were made by the plaintiff.¹⁵ It was held by the supreme court of Michigan that a trade-mark, when adopted, may be lost by being suffered, without objection, to come into common use in the trade, and that rights under it may be

¹³ *Funke v. Dreyfus* (1882) 34 La. Ann. 80; *Taylor v. Carpenter* (1846) 2 Woodb. & M. 1, Fed. Cas. No. 13,784.

¹⁴ *Sheppard v. Stuart* (1879) 13 Phila. (Pa.) 117.

¹⁵ *Filley v. Child* (1879) 16 Blatchf. 376, Fed. Cas. No. 4,787.

waived as against those using it with the knowledge of the owners, and without objection, though such use has not become general.¹⁶

§ 105. Abandonment by nonuser.

A complete disuse of a trade-mark may result in an abandonment thereof, and render the same capable of appropriation by others. Such disuse must, however, be for such period of time, and be accompanied by such circumstances, as to show an intention to abandon. In the case of *Blackwell v. Dibrell*¹⁷ it was held that, where a mark was disused for eight years, and the proprietor, during that time, stood by and allowed a peculiar commercial and local signification to attach to the mark, an abandonment was made out. It was further held that where, during the period of its disuse, another had devised an equivalent mark, and had thereafter used it, having no knowledge of the first mark, such second appropriator acquired a right of exclusive use in such mark, and could enjoin the original user from resuming it. Where plaintiff's predecessor in business, goodwill, and trade-marks used the words "La Venzolana" on five shipments of flour in 1873, on three in 1885, one in 1886, several in 1887, and several more before his death, in 1888, and where another predecessor appeared to have used them on similar shipments in 1889, and before his death, in 1890, and the plaintiff used them on similar shipments, and caused them to be registered as his trade-mark in 1891, and where the defendant had used the words much more continuously and extensively on flour in shipments since October, 1884, it was held that whatever rights had begun to accrue to plaintiff's predecessor in 1873 by that use were lost by abandonment of the use

¹⁶ *Smith v. Walker* (1885) 57 Mich. 456.

¹⁷ (1878) 2 Hughes, 151, Fed. Cas. No. 1475.

long before the defendants began using them in 1884, and that after that date, if either acquired any right to the exclusive use of these words for that purpose, the defendants appear to have done so.¹⁸ In *Raymond v. Royal Baking Powder Co.*¹⁹ the United States circuit court of appeals for the seventh circuit held that one who, after using an alleged trade-mark for a short time, abandons it for nearly a quarter of a century, has no right to resume its use after it has been long employed by another, who has built up under it a large and successful business. On the other hand, it was said in the case of *Glen & Hall Mfg. Co. v. Hall*,²⁰ that: "The neglect to carry on the business for a number of years does not prevent a party from resuming his trade mark or sign of the goodwill, nor entitle another to use it." This, however, was not strictly a trade-mark case, but was an action to restrain the use of the designation of a place of business. In this instance, the name properly went with the place of business, and a successor to the original proprietor, who resumed business in the original building, had the right to resume the original designation for that place of business. In the English case of *Mouson v. Boehm*,²¹ it was held that, in order to deprive a manufacturer of his right to a trade-mark, the use of which had been practically given up for a period of five years, mere discontinuance of user for lack of demand, though coupled with nonregistration and nonassertion of any right, was not enough. In this case the trade-mark was for a particular kind of soap, and while the manufacture and sale of the soap thus marked had fallen off for a number of years, until it had practically ceased, and the proprietor had forgotten the existence of this par-

¹⁸ *Brower v. Boulton* (1892) 53 Fed. 389.

¹⁹ (1898) 29 C. C. A. 245, 85 Fed. 231.

²⁰ (1874) 61 N. Y. 234.

²¹ (1884) 26 Ch. Div. 398.

ticular mark, it appeared that the manufacturer had not ceased to carry on his business, had not broken up the mold in which the soap was made, and a number indicating the soap thus marked was retained on the price list. The court said: "Here it appears to me there was no absolute non-user for any sufficient time, taken in connection with all the circumstances, to show an intention to abandon. 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. There was some user, and the result, therefore, is that Boehm had not abandoned his trade-mark." The court further said that "the question of abandonment is one of intention, to be inferred from the facts in the particular case." It has also been held that, while property in a trade-mark may be abandoned, and thereby lost, a complaint for infringement, which shows nonuser for a year, does not disclose an intention to abandon; that, without such intention, there is no abandonment by mere nonuser; that such nonuser might imply a gratuitous license to others to use the mark for the time being, and thereby preclude the recovery of damages, but that this license is revocable, and does not preclude the remedy by injunction for the future.²²

§ 106. Laches.

A trade-mark may be lost completely by laches, or the proprietor may lose simply the right to an account of gains or profits. Where the person who infringes a trade-mark does so with a show of right and justification, inexcusable laches on the part of a proprietor will work a forfeiture of the trade-mark, and disentitle him to any relief whatever;

²² Julian v. Hoosier Drill Co. (1881) 78 Ind. 408.

but where the infringer has appropriated the trade-mark without any show of justification, and in fraud of the proprietor's rights, laches on the part of the proprietor will usually disentitle him to an account of gains and profits, but will not defeat the remedy by injunction.

§ 107. Rule where use is justified.

In considering the defense of laches in the Hunyadi Case,²³ the United States supreme court said: "The defense of laches depends upon somewhat different considerations, and, so far as it applies to the use of the word 'Hunyadi,' we think it is established. It appears that, after the decision of the minister of agriculture in 1873, sustaining the claim of Markus to the trade-mark 'Hunyadi Matyas,' other springs were opened, whose waters were bottled under different trade-marks, in all of which the word 'Hunyadi' was a component, and as early as 1886 these waters found their way to the United States, and were put on sale here with the knowledge of the Apollinaris Company. There is no evidence that Saxlehner had personal knowledge of these infringements, and, while something may be said in his favor in view of his persistent efforts to establish his rights in Hungary, he was bound to know the law in this country, and to take steps within a reasonable time to vindicate his rights. The infringers were making use of their trade-marks under licenses from the Hungarian government, and we see no reason to doubt that they were proceeding in good faith to dispose of their waters under the trade-marks registered in Hungary. Under these circumstances, if Saxlehner had intended to assert his rights, under the laws of this country, to the exclusive use of the word 'Hunyadi,' he was bound to act with rea-

²³ Saxlehner v. Eisner & Mendelson Co. (1900) 179 U. S. 19, 21 Sup. Ct. 7.

sonable promptness. It is true that he may have supposed the Apollinaris Company would assert his rights in that particular for their own benefit; but if, as we have already held, he was not bound by their admissions, he is in no position to take advantage of their inaction, and, as against traders who were selling bitter waters under trade-marks legalized by the Hungarian government, he should not have waited until the name 'Hunyadi' had become generic in this country, and indicative of this whole class of medicinal waters." The court then considers the effect of the treaty between this country and the Austro-Hungarian empire upon the trade-mark in question, and then says: "If, upon the other hand, we assume that the case can be decided without reference to the law of Hungary, or the decisions of its officers and courts, the plaintiff is still at a disadvantage by reason of not instituting her suits more promptly. Saxlehner knew, as a matter of fact, that the minister of agriculture had overruled his protest, and that the word 'Hunyadi' had become public property in the kingdom of Hungary. He knew that a large number of dealers would appropriate the word, and that he was himself selling a large quantity of bitter water in the United States. He must also have known, or at least had good reason to know, that his competitors were doing the same thing. Under such circumstances, he should have instituted inquiries upon his own account, and, regardless of his contract with the Apollinaris Company, have seen to it that his own interests were protected. If the Apollinaris Company were not his agent for the protection of his rights in the United States, then it was incumbent upon him to assert such rights personally, or through some other recognized medium. In now invoking our laws, his successor is bound to show that she has complied with our requirements of diligence and promptness in instituting suit. She has (176)

failed in this particular. By twenty years of inaction she has permitted the use of the word by numerous other importers, and it is now too late to resuscitate her original title." It is clear from this decision that, where an alleged infringer has proceeded in good faith and with a show or justification of right, laches on the part of the proprietor may result in a complete loss of trade-mark right.

§ 108. Rule where fraud appears.

When, however, the court came to consider in the Hunyadi Case²⁴ the question of the appropriation of the complainant's bottles and peculiar labels by the defendant, which it appeared had been appropriated in fraud of the complainant's rights, a different rule was applied. Upon this point the court said: "This argument, however, has but a limited application to the appropriation of the bottles and red and blue labels covering them, which appear to have been seized upon by the proprietors of the Matyas Spring, as well as by others, without a shadow of justification, and in fraud of plaintiff's rights. * * * Indeed, we find no authority whatever for the appropriation of this label by any of Saxlehner's competitors, and nothing to show that it was not a case of undisguised piracy. The only justification for its appropriation now insisted upon is the fact that, by general use in this country for the past ten years, it has come to be recognized as a kind of generic label applicable to all Hungarian bitter waters, and, if Saxlehner had originally an exclusive right to make use of it, that right has been lost by his acquiescence and that of the Apollinaris Company in its general use by other importers. But in cases of actual fraud, as we have repeatedly held, notably in the recent case of *McIntire v. Pryor*, 173 U. S. 38, the principle of laches

²⁴ *Saxlehner v. Eisner & Mendelson Co.* (1900) 179 U. S. 19, 21 Sup. Ct. 7.

has but an imperfect application, and delay even greater than that permitted by the statute of limitations is not fatal to plaintiff's claim. We have only to refer to the cases analyzed in that opinion for this distinguishing principle: that, where actual fraud is proven, the court will look with much indulgence upon the circumstances tending to excuse the plaintiff from a prompt assertion of his rights. Indeed, in a case of an active and continuing fraud like this, we should be satisfied with no evidence of laches that did not amount to proof of assent or acquiescence."

§ 109. Other cases considered.

In *McLean v. Fleming*²⁵ there had been apparently a delay of about thirty years in instituting proceedings, but the court, citing *Rodgers v. Rodgers*, 31 Law T. 285, and *Blackwell v. Crabb*, 36 Law J. Ch. 504, said: "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 be such as to preclude the party from any right to an account for past profits."

In the case of *Menendez v. Holt*,²⁶ the rule laid down in *McLean v. Fleming* was adhered to, and, in the opinion by Chief Justice Fuller, this question is discussed as follows: "Counsel, in conclusion, earnestly contends that whatever rights appellees may have had were lost by laches; and the desire is intimated that we should reconsider *McLean v. Fleming*, 96 U. S. 245, so far as it was therein stated that, even though a complainant were guilty of such delay in seeking relief upon infringement as to preclude him from obtaining an account of gains and profits, yet, if he were otherwise so entitled, an injunction against future infringement

²⁵ (1877) 96 U. S. 245.

²⁶ (1888) 123 U. S. 514.

might properly be awarded. We see no reason to modify this general proposition, and we do not find in the facts as disclosed by the record before us anything to justify us in treating this case as an exception. 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. Persistence, then, in the use, is not innocent, and the wrong is a continuing one, demanding restraint by judicial interposition when properly invoked. Mere delay or acquiescence cannot defeat the remedy by injunction in support of the legal right, unless it has been continued so long, and under such circumstances, as to defeat the right itself. Hence, upon an application to stay waste, relief will not be refused on the ground that, as the defendant has been allowed to cut down half of the trees upon the complainant's land, he had acquired by that negligence the right to cut down the remainder. *Attorney General v. Eastlake*.²⁷ Nor will the issue of an injunction against the infringement of a trade-mark be denied on the ground that mere procrastination in seeking redress for depredations had deprived the true proprietor of his legal right. *Fullwood v. Fullwood*.²⁸ Acquiescence, to avail, must be such as to create a new right in the defendant. *Rodgers v. Nowill*.²⁹ Where consent by the owner to the use of his trade-mark by another is to be inferred from his knowledge and silence merely, 'it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license.' *Duer, J., Amoskeag Mfg. Co. v. Spear*;³⁰ *Julian v. Hoosier Drill Co.*;³¹ *Taylor v. Carpenter*.³² So far as the act com-

²⁷ (1853) 11 Hare, 205.

²⁸ (1878) 9 Ch. Div. 176.

²⁹ (1853) 3 De Gex, M. & G. 614.

³⁰ (1849) 2 Sandf. (N. Y.) 599.

³¹ (1881) 78 Ind. 408.

³² (1846) 2 Woodb. & M. 1, Fed. Cas. No. 13,785.

plained 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."

In *Estes v. Worthington*³³ it was held that, when the delay of the owner of a 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. It has also been held that one does not necessarily lose his right to a trade-mark by his forbearance for three years to sue one unlawfully using it.³⁴ Where a defendant claimed a delay of nine years to commence proceedings to enjoin an alleged infringement of a trade-mark, and the court found the proof on this head too vague and unconvincing to justify a court of equity in refusing any relief, the injunction was allowed, but without damages, account of profits, or costs, because of the degree of inactivity exhibited by the plaintiff, as shown by the whole evidence.³⁵ In *Low v. Fels*,³⁶ an injunction was granted, although for nearly four years prior to the date of the suit complainants had notice that their trade-mark was in common use by dealers in this country, and did nothing to prevent it until the time of filing the bill, and such use had been practiced by all the principal dealers in soap in this country for nearly twenty years prior to the date of suit, and complainants,

³³ (1885) 22 Fed. 822.

³⁴ *Blackwell's Durham Tobacco Co. v. McElwee* (1888) 100 N. C. 150.

³⁵ *Amoskeag Mfg. Co. v. Garner* (1876) 54 How. Pr. (N. Y.) 297.

³⁶ (1888) 35 Fed. 361.

dealing in the markets of this country, should be presumed to have had knowledge of this fact. It was held that, if complainants had no such knowledge, it was because of indifference to their interests or lack of vigilance, and that there was no evidence of fraud on the defendant's part, and he did not even know of complainants' existence, or of the existence of the rights which they set up. This action, if it had arisen subsequent to the decision of the Hunyadi Case³⁷ by the supreme court of the United States, would probably have been decided the other way. As there was no fraud on the part of defendant, and no willful infringement, there was a complete justification for his using the trade-mark. Under these circumstances, inexcusable laches on the part of the complainant under the rule laid down in the Hunyadi Case should have disentitled them to any relief whatever.

In *O'Rourke v. Central City Soap Co.*³⁸ it was held that a person cannot appropriate a trade-mark belonging to another without his consent, and afterwards acquire a good title by the abandonment thereof by the first proprietor. In this case the court said: "In the case under consideration, however, the question is presented whether a person may appropriate a trade-mark belonging to another, and subsequently acquire a good title thereto by the abandonment thereof by the first proprietor. The testimony shows, and it is not disputed, that when Winger began manufacturing soap at Sturgis, under the name of 'Winger's Anti-Washboard Soap,' the firm of Clark & Benefiel was manufacturing soap at Mattoon, Ill., under the same name, and continued so to do for nearly a year after Winger commenced business. During this time he was an admitted trespasser upon

³⁷ *Saxlehner v. Eisner & Mendelson Co.* (1900) 179 U. S. 19, 21 Sup. Ct. 7.

³⁸ (1885) 26 Fed. 576.

their rights. The fact that he supposed the Ohio firm had gone out of business is no defense if in fact they had an exclusive right to the trade-mark. * * * There is no evidence in this case that his competition interfered with the business of Clark & Benefiel, or Stephens, their successor, or that he was the cause of the subsequent abandonment of the business by them; but if it be once conceded that a person may acquire a good title to a trade-mark by appropriation, without the consent of the lawful owner, it would enable a manufacturer, by the use of large capital or superior energy, to drive competitors out of business, by seizing their trade-marks, and using them for that very purpose, provided the lawful owner is unable or unwilling to assert his rights by resort to the courts. We think that no court would hesitate to pronounce against a title so obtained. We find it difficult to distinguish such a case, in principle, from the one under consideration, as it might be impossible to prove that the lawful owner was compelled to discontinue by reason of such competition."

From an examination of the statement of facts accompanying the opinion in the case last cited, it appears that the plaintiff's only title to the trade-mark was derived through a naked assignment of the mark from Winger, the person who had appropriated it prior to its abandonment by the original proprietor, and the bill of complaint might have been dismissed on the ground that the plaintiff could acquire no title to the trade-mark through a mere naked assignment. It is hardly seen why an infringer of a trade-mark cannot, upon the abandonment of it by another, begin to acquire, from the date of such abandonment, the right to use the trade-mark. If, upon the abandonment of the trade-mark, any person has a right to appropriate it, it would seem that a trespasser upon the rights of the former proprietor might

equally with any one else have the right to appropriate such mark.

In the case of *Gilka v. Mihalovitch*,³⁹ which was brought to restrain the infringement of plaintiffs' mixture or cordial trade-mark, "Gilka-Kummel," and for an account of profits, defendants filed a plea alleging that they and their predecessors had used the trade-mark for twenty years, and that, during the entire twenty years, there were manufactured and sold in the open market, and in the business and trade of the defendants and of the complainants, bottles, labels, packages, and other signs and devices similar to those set forth and described in the bill, and that their use of such bottles and labels was without knowledge of any special or exclusive right to such labels and bottles, as then claimed by the complainants, and without any intention or design of infringing upon or injuring any special or exclusive right complainants had to the use of the same, and that, immediately on learning of such right, they had desisted from such use. It appearing that the only circumstance relied upon to charge the plaintiffs with constructive notice was that they were represented by agents located at the city of New York, nearly eight hundred miles distant from the defendants' place of business, it was held that the plea presented no sufficient defense, and must be overruled.

In the case of *Tygert-Allen Fertilizer Co. v. J. E. Tygert Co.*,⁴⁰ decided by the supreme court of Pennsylvania, it appeared that two competing firms had entered into a contract for the purpose of consolidating their business interests. The corporation formed was called "The Tygert-Allen Fertilizer Co.," and the only use made of the name "Tygert" was as a part of this compound corporate title. The seven-

³⁹ (1892) 50 Fed. 427.

⁴⁰ (1899) 191 Pa. 336.

teen different articles made and sold were all advertised and sold under the name "Allen"; this word being, in each instance, used as a part of the trade-mark or brand. The name "Tygert" was never used by the corporation to designate any article manufactured or sold by it, and no request was ever made for a transfer of the right to its use as provided for by the contract. The corporation defendant was organized July 2, 1891, and its business had since been conducted within sixty feet of the plaintiff's office. It had used the name "Tygert" in connection with the various brands under which its goods were advertised and sold, and had built up an extensive business. The bill was filed January 12, 1894. The court said: "Aside from all questions as to the right of the plaintiff to enforce a covenant not made with it, but between third persons not parties to the bill, we think that the delay of the plaintiff has been such that, under the circumstances, it is not entitled to the relief sought. The merchandise owned by the firms was to be inventoried and sold to the plaintiff at its market value. The 'goodwill, brands, trade-mark, including the exclusive use of their names, so far as they shall hereafter apply or become necessary to be used in the manufacture and sale or purchase of fertilizers,' etc., were to be transferred for a nominal consideration. No transfer was ever asked for, and no use of the name 'Tygert' was made to designate the plaintiff's goods. Whatever right, if any, it acquired to the exclusive use of the name, it apparently abandoned. No value was given to the name by it as the designation of an article of merchandise. Its use by the defendant does not mislead the public, and it injures the plaintiff only as any other open and fair competition would do so. The plaintiff stood by for two years and a half without objection of any kind, while the defendant expended large sums of money, and built up

(184)

a business, the life of which depends upon the use of this name. The covenant to transfer the use of the name was not an unconditional one, but only as it should 'apply or become necessary to be used.' By the option of the plaintiff, it never has applied or become necessary for its use. In July, 1891, when the defendant was incorporated, it might well have been inferred that the plaintiff made no claim to the use of the name 'Tygert,' as all its goods had been put upon the market under another name. If the plaintiff intended to assert its right to its exclusive use, that was the time to speak. Its silence for two years and a half was more than mere laches,—it was, under the circumstances, such evidence of acquiescence as to bar its remedy for equitable relief."

It was also held, in the case of *Cahn v. Gottschalk*,⁴¹ that where the plaintiff, after having knowledge by his agent of the infringement of his trade-mark, delayed for five years to bring his action for an injunction and for an accounting of profits, he was barred by his laches from recovering profits, though not from his right to an injunction.

In *Sanders v. Jacob*,⁴² the St. Louis court of appeals, in considering the defense of laches in an action to restrain the infringement of a trade-mark, said: "The question of laches would be a serious one if there were no element of fraud in the case on the part of the defendant; * * * but where the element of fraud supervenes, lapse of time does not purge the defendant's conduct of this taint. The wrong is a continuing one. The injury done to the plaintiff, and the deception practiced upon the public, both of which the law takes into consideration in these cases, accumulate. Then, if the defendant, at a recent period of time, aggravates the wrong, as he is shown to have done in this case, by moving

⁴¹ (1888) 14 Daly (N. Y.) 542.

⁴² (1885) 20 Mo. App. 96.

his place of business still nearer to that of the plaintiff, and by there erecting signs similar in appearance to those of the plaintiff, it makes, we think, a plain case for equitable interposition." This rule was followed in the same court in the case of *Plant Seed Co. v. Michel Plant & Seed Co.*,⁴³ and by the supreme court of Florida in the case of *El Modello Cigar Mfg. Co. v. Gato*.⁴⁴ In the last case the court said: "The rule in England, in trade-mark cases, is more stringent than in this country, and a lack of diligence there in suing deprives complainant in equity of the right to an injunction or on account. But 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 account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant. * * * Nor will the acquiescence of any person in the wrongful use of his name estop him from asserting his rights in equity unless he has notice, during such acquiescence, of the facts rendering the use of his name wrongful. * * * And the laches of the complainant will not avail as a defense in a proceeding to restrain the use of a trade-name, when the defendant adopted the name with a fraudulent intent."

Where plaintiffs had acquired, by long use, sanctioned by decision of the courts, the right to use the words "Blue Lick" as a trade-mark for mineral water, it was held that the use and attempted appropriation of the same trade-mark by defendant in advertising and selling water from an artesian

⁴³ (1886) 23 Mo. App. 579.

⁴⁴ (1889) 25 Fla. 886.

well was illegal and fraudulent, and that no presumption of acquiescence in the wrongful appropriation of the trade-mark could arise so as to estop plaintiffs from exercising their right to restrain its use, and whatever money might have been spent by the defendant in the purchase of and in putting improvements on the well, with the purpose of using the trade-mark in the sale of water therefrom, was done at his own risk. In this case the defendant claimed that he and his predecessors had for a period of fifteen years used the words "Kentucky Blue Lick Water" in connection with sale of water from the artesian well, and this statement, for the purpose of trying the general demurrer to the answer, was taken by the court as true. The court said, however: "But he does not allege they had so used the words under a claim of right, or that they had either acquired or undertook to convey to him a title to the trade-mark. On the contrary, their appropriation and use of the trade-mark being unlawful and fraudulent, it must be presumed whatever right they acquired thereto, if any, was abandoned when they transferred the well to appellant [defendant]; and as it was not conveyed, or attempted to be conveyed, to him, his use and attempted appropriation must be treated as illegal and fraudulent, and a distinct cause of action which accrued against him in favor of appellant [appellees] in 1893, when he first commenced to so appropriate and use their trade-mark." It does not appear from the report when or how soon after 1893 this action was brought, but the case was decided by the court of appeals in May, 1897 ⁴⁵

In *Sawyer v. Kellogg*⁴⁶ it was contended that the complainant had lain by for several years while the defendant had been publicly using his own label, and had thus acquiesced

⁴⁵ *Northcutt v. Turney* (1897) 101 Ky. 314.

⁴⁶ (1881) 7 Fed. 720.

in its use. The court found, however, that the complainant had a patent for the article—bluing—which he had been prosecuting and endeavoring to substantiate, but in which he finally failed, and that his failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back upon his rightful trade-mark.

And where plaintiffs sued defendants for infringement of a trade-mark, and manufacturing and selling an article in imitation of one sold by plaintiffs, and for an injunction about two years after they discovered the imitation, and plaintiffs had before brought suit against other infringers, and defendants had changed their label on account of a decision therein, it was held that plaintiffs should not be denied damages because of delay in bringing suit.⁴⁷ It has also been held that the fact that defendant put his packages on the market a year before complainant filed his bill to restrain such competition did not deprive plaintiff of the right to an accounting.⁴⁸ And where the imitation by defendants was begun in November, 1878, but not completed until 1879, and action was commenced fourteen months after the beginning of the imitation, and five or six months after its completion, it was held that there was no such laches by the plaintiffs as to deprive them of the right of an accounting of profits, and that there would have been none had the simulation been complete in November, 1878.⁴⁹ And where it appeared that the defendant had used the imitation complained of in various shapes and forms for many years, and for part of the time without active objection on the part of the complainant, and, during the use, different changes in the shape and general appearance of the packages were introduced in the

⁴⁷ Schmidt v. Brieg (1893) 100 Cal. 672.

⁴⁸ Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84.

⁴⁹ Avery v. Meikle (1887) 85 Ky. 435.

course of attempts at an amicable adjustment between the parties, and, by reason of these matters, proper accounting was rendered difficult, the court denied the accounting prayed for by the plaintiff without prejudice of his right to proceed at law for damages.⁵⁰

In *Blackwell's Durham Tobacco Co. v. McElwee*,⁵¹ it was held that, as between adverse claimants of an invention and sole ownership of a trade-mark, no greater force is to be given to the fact that one of the parties used the trade-mark for several years without being molested therein by the other, than that of evidence tending to disprove the claim of the other. Such forbearance on the part of the true owner, beyond its weight in disproving his title, cannot have the effect of extinguishing his rights; but such an indulgence is an assent to the use of the trade-mark, and the owner will not be entitled to demand damages for its intermediate use.

In the case of *Williams v. Adams*,⁵² the proof showed that the complainants entered upon the manufacture of a class of soap, and adopted the word "Yankee" as a mark of distinction of their goods, and that they had used it from the time of its adoption to the time of suit. It was claimed by the defendants that the complainants had abandoned the use of this word as their trade-mark; that they had allowed other manufacturers to infringe upon it by putting their soaps on the market under the designation of "Yankee," as, for instance, "Yankee Jim," "Yankee Sam," and other labels, in which the word "Yankee" was the controlling or leading term, whereby complainants' exclusive claim of right to the

⁵⁰ *Drummond Tobacco Co. v. Tinsley Tobacco Co.* (1892) 52 Mo. App. 10.

⁵¹ (1888) 100 N. C. 150.

⁵² (1879) 8 Biss. 452, Fed. Cas. No. 17,711.

use of the word "Yankee" had been infringed, and that complainants had so acquiesced in this infringement as to abandon their exclusive right to the use of the word "Yankee." Judge Blodgett, in deciding the case for the complainants, said: "I do not find this position sustained by the testimony. The complainants seem to have been diligent in prosecuting all persons who infringed upon their rights within a reasonable time after they became aware of such infringement. It is true that the proof shows that quite a large number of manufacturers are putting shaving soaps upon the market under the term or description of 'Yankee,' such as 'Yankee Sam Soap,' 'Yankee Jim Soap,' and the 'Yankee Soap,' which last is precisely like the complainants', and there are various other imitations of the complainants' goods, shown in the proofs. 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. Certainly, there is no such neglect on the part of the complainants proved here as would show an intention to abandon their trade-mark."

In *Prince's Metallic Paint Co. v. Prince Mfg. Co.*⁵³ it was held by the circuit court of appeals for the third circuit that where the purchaser, on foreclosure, of a property and business which had long been conducted in connection with a trade-mark, uses the trade-mark under claim and color of title, with the full knowledge of the former owner, for eight years without objection, this amounts to an acquiescence which will estop the latter, and a subsequent purchaser of the trade-mark from him at sheriff's sale, from afterwards maintaining a suit to restrain such usage. The court stated the general rule to be that, where the plaintiff's title to a trade-mark is clear, mere delay, unaccompanied by anything

⁵³ (1893) 6 C. C. A. 647, 57 Fed. 938.

else, will not ordinarily bar a suit for injunction against a naked infringement, but it held that this rule was not applicable to the case before it, and affirmed the decree of dismissal entered by the court below.

In *White v. Miller*,⁵⁴ which was a suit involving a trademark for whiskey, and in which it appeared that the complainant's distillery was located in Kentucky, and the defendant was located in Boston, the court held that the complainant had not been guilty of laches, where complainant had no knowledge of the defendant's infringement prior to 1889, and the suit was brought in 1890. The court took into consideration the distance from Boston to the point where complainant's distillery was located, and the fact that none of the proprietors of the complainant company had any knowledge of the infringement prior to 1889.

In *Rahtjen's American Composition Co. v. Holzappel's Composition Co.*⁵⁵ it appeared that there had been a delay of eight years before commencing suit to enjoin infringement, and the defendant insisted that the complainant's laches should prevent any decree in its favor. Upon this point, the court said: "It is true that the defendant has sold its manufacture of 'Rahtjen's Composition' to a certain extent since 1890, but the sales have been comparatively small, and did not interfere with the complainant's business to any marked extent until the defendant obtained a contract with the naval department of the United States government, in answer to a call for offers of 'Rahtjen's Composition,' when suit was promptly commenced. The defendant's chief brand of paint is the 'International Composition,' and it has been their endeavor to sell that brand, if they could, and, failing that, 'Rahtjen's Composition.'" The defense

⁵⁴ (1892) 50 Fed. 277.

⁵⁵ (1900) 101 Fed. 257.

of laches is nominal, rather than real, for the defendant's interference with the property rights of the plaintiff was for many years inconsiderable, and under no decision merits a refusal of a decree of injunction. Under all the circumstances of the case, we are not inclined to direct a decree for an accounting."

In *Old Times Distillery Co. v. Casey*⁵⁶ it appeared that both parties claimed original adoption of the brand "Kentucky Comfort" as a trade-mark for whiskey, and there was, in fact, but a few days' difference between the dates of actual application of the words by the two claimants. Each party clearly acted in good faith in the selection of the words, and there was no intention on the part of either to wrongfully appropriate the invention or the property of the other. In considering the defense of laches the court said: "As a matter of fact, the parties for ten years have acted on the theory that their geographical position made it unimportant to put to the test the question who was technically entitled to this trade-mark. The appellees have stood still too many years with knowledge of the fact that appellant has been expending large sums of money in extending the use of, and demand for, this brand of whiskey, and ought not to be permitted now to reap the benefit of the appellant's industry and enterprise. This is not a case where one who is clearly the owner of a trade-mark is seeking to withdraw his permission for its further piratical use." And in *E. T. Fairbanks & Co. v. Des Moines Scale & Mfg. Co.*,⁵⁷ where it appeared that the complainant had knowledge of the alleged infringement of its rights by defendant for many years before suit was brought, and where the case made by the bill was fully met by the answer, and no showing of defendant's insolvency

⁵⁶ (1898) 104 Ky. 616, 42 L. R. A. 466.

⁵⁷ (1899) 96 Fed. 972.

was made, a preliminary injunction was refused. In *La Republique Francaise v. Schultz*⁵⁸ it appeared that the defendant had sold artificial mineral waters for thirty years under the same labels, which implied that the water was from a well-known natural spring, before the proprietors of such spring took any steps to secure an injunction. The court held that the proprietors were not entitled to an accounting for gains and profits made during the time prior to beginning of suit. It was also claimed in that case by the complainant that there could be no imputation of laches against the owner of the springs, the republic of France being a sovereign power. The court held, however, that the lessee of the springs was the actual party in interest who would profit by a decree for accounting; that, while the republic of France was the owner of the springs, and a party to the suit, the lessee was the one beneficially interested in the gains and profits which might result from a decree, and that the principle that laches are not imputable to the government of a nation was not applicable in this case.

§ 110. Dedication to public by expiration of patent.

Where a name is used in connection with a patented article, and the article is sold under that name during the life of the patent, upon the expiration of the patent the name becomes dedicated to the public, whether the name be an arbitrary one, or be the surname of the patentee or original manufacturer. The leading case upon this point is *Singer Mfg. Co. v. June Mfg. Co.*,⁵⁹ in which the opinion of the court was delivered by Mr. Justice White. The doctrine of

⁵⁸ (1900) 102 Fed. 153. See, also, *O'Rourke v. Central City Soap Co.* (1885) 26 Fed. 576; *Simmons Medicine Co. v. Mansfield Drug Co.* (1893) 93 Tenn. 84; *Bank of Tomah v. Warren* (1896) 94 Wis. 151; *Sanders v. Jacob* (1885) 20 Mo. App. 96.

⁵⁹ (1896) 163 U. S. 169.

dedication of the name of the patented article by expiration of the patent is clearly set forth in the opinion of the court as follows: "It is self-evident that, on the expiration of a patent, the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that, on the termination of the patent, there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss, without further comment, the complaint as to the form in which the defendant made his machines. It equally follows from the cessation of the monopoly, and the falling of the patented device into the domain of things public, that, along with the public ownership of the device, there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly in consequence of the designation having been acquiesced in by the owner, either tacitly, by accepting the benefits of the monopoly, or expressly, by his having so connected the name with the machine as to lend countenance to the resulting dedication. To say otherwise would be to hold that, although the public had acquired the device covered by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name, which was essentially necessary to vest the public with the full enjoyment of that which had become theirs by the disappearance of the monopoly; in other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that, at its termination, the monopoly should cease, and yet, when the end was reached, disregard the public dedication, and practically perpetuate indefinitely an exclusive right. The public having the right, on the expiration of the patent,

(194)

to make the patented article, and to use its generic name, to restrict this use, either by preventing its being placed upon the articles when manufactured, or by using it in advertisements or circulars, would be to admit the right, and at the same time destroy it. It follows, then, that the right to use the name in every form passes to the public with the dedication resulting from the expiration of the patent. Nor is this right governed by different principles, where the name which has become generic, instead of being an arbitrary one, is the surname of the patentee or original manufacturer. It is elementary that there is a right of property in a name which the courts will protect; but this right, like the right to an arbitrary mark, or any other, may become public property by dedication or abandonment."

An examination of the numerous cases that have been decided in this and other countries, many of which are cited in the opinion of the court in the case of *Singer Mfg. Co. v. June Mfg. Co.*, shows that it is immaterial whether the name given to the patented article, and which becomes dedicated to the public by the expiration of the patent, is one that is capable of appropriation as a technical trade-mark or not. In the earlier case of *Coats v. Merrick Thread Co.*,⁶⁰ the supreme court said: "Plaintiffs' right to the use of the embossed periphery expired with their patent, and the public had the same right to make use of it as if it had never been patented. Without deciding whether, if the embossed periphery had contained a word which was capable of being appropriated as a trade-mark, defendants could have appropriated the same upon the expiration of their patent, it is clear that no such monopoly could be claimed of mere numerals used descriptively, and therefore not capable of exclusive appropriation because they represent the number of the

⁶⁰ (1893) 149 U. S. 562.

thread, and are therefore of value as information to the public. * * * Clearly the plaintiffs cannot, as patentees, claim a monopoly of these numerals beyond the life of the patent, and it is equally clear that, where used for the purpose of imparting information, they are not susceptible of exclusive appropriation as a trade-mark, but are the common property of all mankind. The patent being not simply for the embossed number, but for embossing the same upon the periphery of the spool head, defendants were entitled, upon the expiration of such patent, to use them for a like purpose.”

There are numerous other cases in which the word “Singer” was involved, and in each of which an effort was made to hold this word as a trade-mark, after the expiration of the Singer patents. In *Singer Mfg. Co. v. Larsen*,⁶¹ Judge Drummond held that there could be no trade-mark in the name “Singer Sewing-Machine,” and said: “On a machine called ‘The Singer Sewing-Machine’ there were various patents. These patents have all expired, and nothing can therefore be claimed under them. Other persons cannot be prevented from manufacturing a machine like the Singer sewing-machine, and which may be called, to distinguish it from other machines, ‘Singer Sewing-Machine.’ If a sewing-machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine, and call it by that name, because that only expresses the kind and quality of the machine.” Judge Treat, in *Singer Mfg. Co. v. Stange*,⁶² said: “The plaintiff and its predecessors had, in connection with others, through patents, a monopoly as to cer-

⁶¹ (1878) 8 Biss. 151, Fed. Cas. No. 12,902.

⁶² (1881) 6 Fed. 279.

tain sewing-machines, known as the 'Singer' machines. When these patents expired, every one had an equal right to make and vend such machines. If the patentees or their assignees could assert successfully an exclusive right to the name 'Singer' as a trade-mark, they would practically extend the patent indefinitely. The peculiar machine which had become known to the public under that name during the life of the patents was so known as a specified article of manufacture, and at the expiration of the patent would still be known on the market by that designation, irrespective of the name of the special manufacturer. No one had an exclusive right to the use of the generic name. If one wished to acquire a trade-mark in connection therewith, he could do so distinctively. * * * A review of the many cases cited leads to the following conclusions: First. That when a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every person, at the expiration of the patent, has a right to manufacture and vend the same under the designation thereof by which it was known to the public. Second. That the original patentee or his assignees have no right to the exclusive use of said designation as a trade-mark. Their rights were under the patent, and expired with it. Third. If a corporation or person wished to establish a trade mark or name indicative of its own special manufacture of such a machine or product, the right must grow up, just as all other rights of the kind are established, by use and acquiescence. Thus, as every one, at the expiration of the patent, had a clear right to manufacture and vend what was known as the 'Singer' sewing-machine, the plaintiff could acquire no exclusive right to the name 'Singer,' but could, by proper trade-mark, appropriate to itself names or devices indicating its own manufacture of such machines."

In *Singer Mfg. Co. v. Riley*,⁶³ where suit was brought to restrain the defendant's use of the word "Singer" in connection with sewing-machines, a preliminary injunction was refused, following the decision of the *Stange Case*.

In *Brill v. Singer Mfg. Co.*⁶⁴ it was held by the Ohio supreme court commission that, as Singer machines had been protected by patents, and during the existence of such patents had become known and identified in the trade by their shape, external appearance, or ornamentation, the patentee could not, after the expiration of the patent, prevent others from using the same mode of identification in machines of the same kind, manufactured and sold by them. It was also held that, where a patented machine becomes known to the public by a distinctive name during the existence of the patent, any one, at the expiration of the patent, may make and vend such machines, and use such name, and no one, by incorporating such name in his trade-mark, could take away from the public the right of using it.

In *Fairbanks v. Jacobus*⁶⁵ it was sought to restrain the defendant from making or selling an imitation of Fairbanks' scales, and from casting the words "Fairbanks' Patent" upon scales so made, in imitation of scales of the manufacture of the complainant. The court held that, by reason of the expiration of the patent under which plaintiff manufactured his scale, there was not, in the acts complained of, any invasion of the plaintiff's rights.

In the English case of *Wheeler & Wilson Mfg. Co. v. Shakespear*⁶⁶ it was sought to restrain the defendants from using the words "Wheeler & Wilson" as descriptive of any sewing-machine manufactured by the plaintiffs. The court

⁶³ (1882) 11 Fed. 706.

⁶⁴ (1884) 41 Ohio St. 127.

⁶⁵ (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608.

⁶⁶ (1869) 39 Law J. Ch. 36.

held that the name "Wheeler & Wilson" on sewing-machines had come to signify the thing manufactured according to the principle of the plaintiffs' patent, and, that being so, it could not restrain anybody, after the expiration of the patent, from representing his article as being the article which was so patented. The court observed: "A man cannot prolong his monopoly by saying, 'I have got a trade-mark in the name of a thing which was the subject of the patent.'"

In the English case of *Linoleum Mfg. Co. v. Nairn*,⁶⁷ the plaintiffs claimed the exclusive right to the use of the word "Linoleum" as a trade-mark for a substance which had been covered by patents which, prior to the time of the suit, had expired. The inventor of the new substance had given to it the name "Linoleum," and it had always been sold under that name during the life of the patent. The court said: "It appears that the defendants are now minded to make, as it is admitted they may make, that substance. I want to know what they are to call it. That is a question I have asked, but I have received no answer, and for this simple reason: that no answer could be given except that they must invent a new name. I do not take that to be the law. I think that, if 'Linoleum' means a substance which may be made by the defendants, the defendants may sell it by the name which that substance bears. * * * In my opinion, it would be extremely difficult for a person who has been, by right of some monopoly, the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone, after his competitors are at liberty to make the same article."

In the case of *Powell v. Birmingham Vinegar Brewery Co.*,⁶⁸ in the English court of appeal, Lindley, L. J., in dis-

⁶⁷ (1878) 7 Ch. Div. 834.

⁶⁸ [1896] 2 Ch. 54, 65 Law J. Ch. Div. 563.

cussing the question of dedication of names to the public, says: "Again, if a person makes or sells an article and calls it by a particular name, the use of that particular name by others for the same sort of goods is not necessarily an infringement of his rights, even if the name is not obviously descriptive. If the article is a patented article, sold by the patentee under the name in question, then, when the patent expires, any one is at liberty to make and sell the article, and to sell it under the name by which it has become known in the market, and, if nothing more is done, the patentee has no redress. This was decided in *Cheavin v. Walker*, [5 Ch. Div. 850] and *Linoleum Mfg. Co. v. Nairn* [7 Ch. Div. 834]."

The same rule was followed in the several *Castoria Cases*. An effort was made in one of these cases to distinguish it from the *Singer Case*, on the ground that, in the *Singer Case*, controversy arose immediately upon the expiration of the patent, while in the *Castoria Case* the plaintiff continued in the exclusive manufacture of *Castoria* for some ten years after the expiration of the patent, and hence it was insisted that, during the time when the right to manufacture and sell was common, the plaintiff had acquired a trade-mark in the name. The court held, however, that this matter of time made no difference; that the word had become known as the name of the thing, and as such it could not be appropriated as a trade-mark.⁶⁹

In the case of *Dover Stamping Co. v. Fellows*,⁷⁰ decided by the supreme court of Massachusetts, it appeared that the plaintiff had for many years manufactured an egg beater

⁶⁹ *Centaur Co. v. Heinsfurter* (1898) 28 C. C. A. 581, 84 Fed. 955; *Centaur Co. v. Neathery* (1898) 34 C. C. A. 118, 91 Fed. 891; *Centaur Co. v. Reinecke* (1898) 34 C. C. A. 684, 91 Fed. 1001; *Centaur Co. v. Marshall* (1899) 92 Fed. 605.

⁷⁰ (1895) 163 Mass. 191.

under a patent granted to one Williams. These egg beaters were stamped with the words and figures "Dover Egg Beater, Pat'd May 31st, 1870." Suit was brought to restrain the defendants from using the word "Dover," as applied to egg beaters, after the expiration of the Williams patent. The plaintiff contended that the word "Dover," as applied to egg beaters, was a trade-mark, and that it was entitled to be protected in the exclusive use of that word. The court, without deciding whether the word "Dover" could, under any circumstances, be a trade-mark, held that the plaintiff could not hold it as a trade-mark under the particular circumstances of the case. In the opinion of the court, the following statement is made: "A word which might become a valid trade-mark when applied to an unpatented article may not be so when applied to an article which has the protection of letters patent. In the latter case, the letters patent indicate the ownership and origin of the article, and it is more readily to be inferred that the word is used as a name merely to identify the article. Usually the protection given by a patent is far greater, though of less duration in time, than that obtained by the use of a trade-mark, because, if an article is patented, nobody but the owner of the patent can, without his consent, make or sell anything embodying the same principles or elements, while a trade-mark only secures one in the use of the name or emblem adopted by him, and applied to the article. * * * One may choose to rely on the name alone, and, if so, he may establish or create a trade-mark which will be permanent, but if he seeks and obtains the protection afforded by a patent, he is bound to yield up his monopoly with all that belongs to it at the end of the term, and the right to the exclusive use of the name given to his goods, which might otherwise become a trade-mark, will ordinarily fall with the patent itself. * * *

the expiration of a patent, the public is entitled to make and use the patented article, free from restrictions, and this right carries with it whatever is necessary for its full enjoyment."

In the case of *Wilcox & Gibbs Sewing-Machine Co. v. Gibbens Frame*,⁷¹ and *Wilcox & Gibbs Sewing-Machine Co. v. Kruse & Murphy Mfg. Co.*,⁷² it was held that, where frames for sewing-machines in the form of the letter "G" had been so extensively manufactured and sold during the time they were protected by patents that the machines containing this feature came to be known in the trade thereby, the patentee could not after the expiration of the patents, by claiming such form or shape as a trade-mark, prevent others from using such frames in sewing-machines manufactured and sold by them.

In *Lorillard v. Pride*⁷³ it appeared that the complainants had procured a patent upon a mode of marking or distinguishing their plug tobacco by imbedding into the surface a metal tag or label; and for several years complainants insisted upon the validity of this patent, and asserted their exclusive right, by virtue of this patent, to mark their tobacco with tin tags, and thereby indicate its origin. It also appeared that the use of the tin tag, and the designation of complainants' goods by the words "Tin Tag," originated from the attempt of complainants to enforce their exclusive right to the use of a metal tag under this patent, and not to the adoption of tin or the words "Tin Tag" as a trade-mark. The patent was declared void, and thereafter complainants registered in the office of the commissioner of patents a trade-mark consisting of a bright, metallic tag, preferably of circular form, and firmly affixed to one of the sides or faces of

⁷¹ (1883) 17 Fed. 623.

⁷² (1887) 14 Daly (N. Y.) 116.

⁷³ (1886) 28 Fed. 434.

plugs of tobacco. The court held that the owner could not perpetuate the monopoly which he had attempted to hold under the patent by falling back upon a popular name given the goods by the public in consequence of the use of the patent, and claiming such name as a trade-mark.

In the case of *St. Louis Stamping Co. v. Piper*,⁷⁴ it appeared that the plaintiff commenced the manufacture of gray mottled enameled ironware in 1874; that, in 1876, a patent was issued for the process of making this enamel. The plaintiff applied to these goods the name "Granite Ironware," and under that name they became known to the public throughout the country. The defendants, having purchased goods from another manufacturer, advertised them for sale as "Granite Ware," and thereupon this motion was made to enjoin the use of the name in connection with the ware, the plaintiff claiming a common-law trade-mark in the name. The motion was denied, and Beach, J., in denying the motion, observed: "The term 'granite' was, doubtless, susceptible of use by the plaintiffs as an appropriate common-law trade-mark for goods of their manufacture. The difficulty, however, in the way of granting the injunction prayed for *pendente lite*, arises from the fact of their having so designated the ware for many years of manufacture by them under the protection of letters patent, which expired in 1893. Then the designation of 'granite' became public property, as well as the ware covered by the patent. That they may have taken out other letters still unexpired, in my opinion, does not prolong the monopoly of the name, but only gives protection as to the specific parts of the manufactured article covered by them."

It has also been held that the name "Tucker Spring Bed,"⁷⁵

⁷⁴ (1895) 12 Misc. Rep. (N. Y.) 270.

⁷⁵ *Tucker Mfg. Co. v. Boyington* (1875) 9 Official Gaz. 455, Fed. Cas. No. 14,229.

applied to a bed, the name "Goodyear,"⁷⁶ applied to rubber goods, the name "Universal,"⁷⁷ applied to a printing press, the name "Weymouth's Patent,"⁷⁸ applied to hay knives, each became public property upon the expiration of the patent upon the article to which the name was applied. Where, however, a trade-mark right was acquired in England two and one-half years before the issue of a patent in the United States for the same article, and the trade-mark was used upon the entire product both in England and the United States, including part of the product made under the patent, and the trade-mark, not the patent, gave value to the article, it was held that the trade-mark did not become dedicated to the public upon the expiration of the patent.⁷⁹ In a case⁸⁰ recently decided by the circuit court of appeals for the second circuit, it appeared that a composition paint for use on the hulls of vessels was originally made and sold in Germany, prior to 1865, by Rahtjen & Sons, and acquired a high reputation under the name of "Rahtjen's Composition." In 1869 it was introduced into this country, and since that time was sold here continuously by the authorized agents of the original manufacturers, or their English licensees, under the trade-name of "Rahtjen's Composition." In 1873, the paint was patented in England, and the patent lapsed in 1880 for nonpayment of dues. In 1883, defendant commenced the manufacture of the same paint in England, using the name of "Rahtjen's Composition," and since 1890 had sold its production in the United States, and it was held that the expiration of the English patent did not affect the rights of

⁷⁶ Goodyear Rubber Co. v. Day (1884) 22 Fed. 44.

⁷⁷ Gally v. Colt's Patent Fire-Arms Mfg. Co. (1887) 30 Fed. 118.

⁷⁸ Holt Co. v. Wadsworth (1889) 41 Fed. 34.

⁷⁹ Thomson v. Batcheller (1899) 35 C. C. A. 532, 93 Fed. 660.

⁸⁰ Rahtjen's American Composition Co. v. Holzapfel's Composition Co. (1900) 41 C. C. A. 329, 101 Fed. 257.

the original makers to protection in this country in the exclusive use of the name, which had, since its introduction here, constituted the trade-name of their product. The circuit court⁸¹ had held that the name had become *publici juris* by the expiration of the English patent. The decision of the circuit court was reversed by the court of appeals, Judge Wallace, however, dissenting, and expressing the opinion that the alleged trade-mark had become public property, first, because the name was the generic description of the patented article, and passed to the public at the expiration of the patent, and, secondly, because the name had long ceased to denote the source of the manufacture of the article. The supreme court of the United States reversed the decision of the circuit court of appeals, and affirmed the decision of the circuit court.⁸² The grounds of the decision are stated in the following quotation: "We are of the opinion that no valid trade-mark was proved on the part of the Rahtjens, in connection with the paint sent by them from Germany to their agents in the United States prior to 1873, when they procured a patent in England for their composition. It appears from the record that from 1870 to 1879, or late in 1878, the paint was manufactured in Germany by Rahtjen, and sent to the United States in casks or packages marked 'Rahtjen's Patent Composition Paint.' Prior to November, 1873, the article was not patented anywhere, and a description of it as a patented article had no basis in fact, and was a false statement, tending to deceive a purchaser of the article. No right to a trade-mark which includes the word 'patent,' and which describes the article as 'patented,' can arise when there is and has been no patent; nor is the claim a valid one for

⁸¹ Rahtjen's American Composition Co. v. Holzapfel's Composition Co. (1899) 97 Fed. 949.

⁸² Holzapfel's Composition Co. v. Rahtjen's American Composition Co. (1901) 183 U. S. 1, 22 Sup. Ct. 6.

the other words used, where it is based upon their use in connection with that word. A symbol or label claimed as a trade-mark, so constituted or worded as to make or contain a distinct assertion which is false, will not be recognized, nor can any right to its exclusive use be maintained. *Manhattan Medicine Co. v. Wood*, 108 U. S. 218, 225, 27 L. Ed. 706, 708, 2 Sup. Ct. 436; *Allan B. Wrisley Co. v. Iowa Soap Co.*, 104 Fed. 548. In 1873, an English patent had been obtained, and from that time to 1878, when the Rahtjens assigned the exclusive right of sale in the United States to Suter, Hartmann & Co., the words 'Rahtjen's Patent Composition' were used on casks containing the paint sent by the Rahtjens to the United States, and must have referred to the English patent, as there was no other, and the right to use those words depended upon the existence of the patent, although, up to 1878, the article sent to the United States was manufactured in Germany. As the right to use the word depended upon the English patent, the right to so designate the composition fell with the expiration of that patent, and from that time (1880) until 1883, when the trade-mark was obtained by Suter, Hartmann & Co., there can be no claim made of an exclusive right to designate the composition as 'Rahtjen's Composition,' because, from 1880, that right became public as a description of the article, and not of the name of the manufacturer. During its whole existence, the name had been given to the article, and that was the only name by which it was possible to describe it."

§ 111. Dedication to public by expiration of copyright.

Attempts have been made, after the expiration of a copyright upon a book, to hold the title of the book as a trade-mark. It is very questionable whether the title of a book is ever a valid trade-mark. In this particular instance, however, the court did not find it necessary to pass upon that

question, but contented itself with holding that there was no valid trade-mark in the name of the book in the instance before the court. In *Merriam v. Holloway Pub. Co.*,⁸³ which involved the right of defendants to use the words "Webster's Dictionary" in connection with a reprint of the 1847 edition of that work, upon which the copyright had expired, Mr. Justice Miller, in the opinion delivered by him, said: "I want to say, however, with reference to the main issue in the case, that it occurs to me that this proceeding is an attempt to establish the doctrine that a party who has had the copyright of a book until it has expired may continue that monopoly indefinitely, under the pretense that it is protected by a trade-mark, or something of that sort. I do not believe in any such doctrine, nor do my associates. When a man takes out a copyright for any of his writings or works, he impliedly agrees that, at the expiration of that copyright, such writings or works shall go to the public, and become public property. I may be the first to announce that doctrine, but I announce it without any hesitation. If a man is entitled to an extension of his copyright, he may obtain it by the mode pointed out by law. The law provides a method of obtaining such extension. The copyright law gives an author or proprietor a monopoly of the sale of his writings for a definite period, but the grant of a monopoly implies that, after the monopoly has expired, the public shall be entitled ever afterwards to the unrestricted use of the book." And the justice further observed: "The contention that complainants have any special property in 'Webster's Dictionary' is all nonsense, since the copyright has expired. What do they mean by the expression 'their book,' when they speak of Webster's Dictionary? It may be their book if they have bought it, as a copy of Webster's Dictionary is my book

⁸³ (1890) 43 Fed. 450.

if I have bought it; but in no other sense than that last indicated can the complainants say of Webster's Dictionary that it is their book." Although the right to use the words was thus adjudged, the duty not to deceive by the method of their employment was upheld and enforced, the court saying: "Now, taking all of these allegations together, there may be some evidence of a fraudulent intent on defendants' part to get the benefit of the reputation of the edition of Webster's Dictionary which the complainants are publishing, and it may possibly be that, in consequence of the facts averred, the public are deceived, and that the complainants are damaged to some extent. We think, therefore, that this is one of those cases where, as the facts are stated in the complaint, the interests of justice would be best subserved by requiring the defendants to answer, so that there may be a full and fair investigation of the law and facts upon a final hearing."

In *Merriam v. Famous Shoe & Clothing Co.*,⁸⁴ a ruling similar to that announced by Mr. Justice Miller was made; but although the right to use the words "Webster's Dictionary" was sustained, the obligation to so use as not to mislead was again stated. Judge Thayer said: "It is unnecessary at this time to determine what form of relief should be administered if the allegations of the bill are proven on final hearing. It may be that some change in the form of defendant's circulars and advertisements will be all the relief that the circumstances of the case fairly warrant; or it may be that the proof will warrant an order that the defendant place a notice in their book that it is a reprint of the edition of 1847 of Webster's Dictionary, with such additions as they may have made to it. This is a matter, however, to be considered on final hearing, when the exact nature of the injury and the causes that mislead the public are ascertained. It

⁸⁴ (1891) 47 Fed. 411.

is sufficient to say at present that, on the showing made, the complainants are entitled to relief, and the demurrer to the bill is accordingly overruled.”

§ 112. Other forms of dedication to public.

A trade-mark right may be lost by any form of abandonment or dedication to the public. It has already been pointed out that, where the proprietor of a trade-mark is guilty of laches, he may, under certain circumstances, lose his trade-mark rights altogether, although in most instances he will lose only his right to damages and costs, but not the right to an injunction. Whenever a word becomes the generic name of an article, it becomes dedicated to the public to such an extent that it cannot thereafter be appropriated as a trade-mark, or, if it had been previously appropriated, it can no longer be held. The test for determining whether a word which was once a trade-mark has become *publici juris* is given by Mellish, L. J., in *Ford v. Foster*,⁸⁶ as follows: “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, and 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 the 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.”

⁸⁶ (1872) 7 Ch. App. 611, 41 L. J. Ch. 682.

In *Powell v. Birmingham Vinegar Brewery Co.*,⁸⁶ in the English court of appeal, it was said by Lindley, L. J.: "Again, if a person makes an article not patented, and gives it a certain name, by which the article comes to be known in the market, any one who can make the same kind of article can call it by the name by which it is known, if he can in fact do so without passing off his goods for those of the original makers."

In the early English case of *Singleton v. Bolton*⁸⁷ it was shown that one Dr. Johnson had invented a medicine which he called "Dr. Johnson's Yellow Ointment." The medicine had by long use become known by this name alone. The court held that no action would lie to prevent the defendant from using the same name for the medicine. Lord Mansfield said that both the plaintiff and defendant used the name of the original inventor, and no evidence was given of the defendant having sold the medicine as if prepared by the plaintiff. It would seem that the name had become the proper name of the medicine, and that any one had a right to use it. So, in the case of *Canham v. Jones*,⁸⁸ a demurrer to a bill was allowed where the plaintiff sought to restrain the defendant from using the name "Velo's Vegetable Syrup" in connection with a medicine. Vice-Chancellor Plumer said: "The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him, but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this bill, therefore,—the exclu-

⁸⁶ [1896] 2 Ch. 54, 65 Law J. Ch. Div. 563.

⁸⁷ (1783) 3 Dougl. 293.

⁸⁸ (1813) 2 Ves. & B. 218, 13 Rev. Rep. 70.

sive right asserted by the plaintiff,—failing, all the consequential relief falls with it.”

In the case of *Thomson v. Winchester*,⁸⁹ the declaration alleged that the plaintiff had discovered valuable medicinal properties in various vegetable substances, and the best manner of compounding the same for medical purposes, to which substance, so compounded, he had given the name of “Thomsonian Medicines.” Chief Justice Shaw, in delivering the opinion of the court, said: “The court are also of opinion that the rule laid down is correct; that without obtaining a patent, the plaintiff had no exclusive right or privilege to compound or vend the medicines called ‘Thomsonian,’ although he was the original inventor; and that he had no more right than the plaintiff to make and vend these medicines, or to call them ‘Thomsonian,’ if this term had acquired a generic meaning, descriptive of a general kind, quality, and class of medicines, as, for instance, James’ powders, or Turlington’s balsam, and if they were not sold to consumers, or consigned or sold to others to be sold to consumers, as and for medicines made and prepared by the plaintiff. If the defendant made and sold medicines, calling them ‘Thomsonian,’ as a generic term designating their general character, but did not offer and sell them, nor consign them to others to sell, as and for medicines made and prepared by the plaintiff, and if he made and compounded such medicines of bad materials with inadequate skill, by means whereof the credit and character of all Thomsonian medicines were brought into disrepute, the plaintiff can recover no damage.”

In *Hostetter v. Fries*⁹⁰ it was sought to enjoin defendants from using the name “Dr. J. Hostetter’s Stomach Bitters.” Judge Wallace, in denying the motion for preliminary in-

⁸⁹ (1837) 19 Pick. (Mass.) 214.

⁹⁰ (1883) 17 Fed. 620.

junction, said: "The complainants have neither the exclusive right to make bitters compounded after the formula of Dr. Hostetter, nor the exclusive right to sell bitters by the name of 'Hostetter's Bitters.' The preparation never had any name until it was offered to the public, and christened. When a new article is made, a name must be given to it, and this name becomes, by common acceptation, the appropriate descriptive term by which it is known, and therefore becomes public property. If this were not so, any person could acquire the exclusive right to a formula by giving a name to the compound produced, not only when the compound has not been patented, but when it might not be the subject of a patent. All who have the right to manufacture and sell the preparation have the right to designate and sell it by the name by which alone it is known, provided care is observed to sell the preparation as the manufacture of the seller, and not the preparation made by another."

In *Leclanche Battery Co. v. Western Electric Co.*⁹¹ it was held that the complainants could not maintain their claim to the exclusive right to use either the word "Disque" or "Pile-Leclanche" as a trade-mark when applied to the batteries manufactured and sold by them. Judge Wallace, in deciding this case, said: "As owners of the right to manufacture and sell the Leclanche batteries until the expiration of the patent granted to the assignee of Leclanche, they have been accustomed to use the word 'Disque' on the labels pasted on the glass jar which forms part of the battery, and the word 'Pile-Leclanche' blown in the glass. Neither of these words are arbitrary names, selected to denote the article as the production of a particular proprietor. They are appropriate, and are intended to indicate that the batteries are of a specified form, and are made according to the patent of Leclanche.

⁹¹ (1885) 23 Fed. 276.

'Disque' describes the form of the battery, and is used to distinguish it from the prism and other forms of porous-cup batteries. 'Pile' is synonymous with battery, and 'Pile-Leclanche' is the designation in French of Leclanche's battery. When an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in, and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable.

* * * As soon as Leclanche invented his battery in France, it was necessarily given the name 'Pile-Leclanche,' and that name could never again be appropriated exclusively as a trade-mark, even by the inventor himself. A name alone is not a trade-mark when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing which is being sold." And it was held by the court of New South Wales⁹² that, where a word had been used by the inventor in connection with a particular class of goods, but had not been registered as a trade-mark, and it was made use of by another, not with any fraudulent intention of counterfeiting the goods of the inventor, but to denote the quality and character of the article sold, and the word had come to be so understood, it had become *publici juris*, and could not thereafter be registered as a trade-mark. And where an unpatented medicinal preparation had come to be popularly known by the name of a person, another person lawfully engaging in the manufacture of it has no right to appropriate that name to his own exclusive use as a proprietary trade-mark or trade-name.

§ 113. Acquiescence of original user necessary.

The later cases establish the rule that a word or mark

⁹² National Starch Mfg. Co. v. Munn's Pat. Maizena & Starch Co. (1894) 6 Reports P. C. 462.

rightfully adopted as a trade-mark does not become the generic name of an article, and thus lost to the original user without his consent, except in case of expiration of a patent upon the article, or, possibly, under other exceptional circumstances.

In *Powell v. Birmingham Vinegar Brewery Co.*⁹³ it is said: "There is another way in which a name originally a good trade-name may lose its character and become *publici juris, i. e.*, where the first person using the name does not claim the right to prevent others from using it, and allows other persons to use it without complaint. The name then comes to denote the article, and nothing more. The name becomes *publici juris*, and any one who is at liberty to make the article can call it by the name by which it is usually known." The fact that a name adopted as a trade-mark to indicate the origin or ownership has become the general name of the article is not, under later decisions, any reason for holding that the name has become the generic name of the article, and has become dedicated to the public. This rule, while apparently in conflict with the earlier cases, is not so in fact. In the *Johnson Ointment Case*,⁹⁴ in the *Velno Syrup Case*,⁹⁵ and in the *Ward Liniment Case*,⁹⁶ it appeared that these terms had been permitted to become the usual and generic names of the articles, and it was appropriately held in each instance that a later user could not appropriate such generic name of the article to his exclusive use. If, however, the original manufacturer of Dr. Johnson's liniment or Velno's syrup or Ward's liniment had continued to manufacture such articles, claiming an exclusive right to the name thereon as a trade-mark, no matter how extensively the ar-

⁹³ [1896] 2 Ch. 54, 65 Law J. Ch. Div. 563.

⁹⁴ *Singleton v. Bolton* (1782) 3 Dougl. 293.

⁹⁵ *Canham v. Jones* (1813) 2 Ves. & B. 218, 13 Rev. Rep. 70.

⁹⁶ *Watkins v. Laudon* (1893) 52 Minn. 389.

article was sold, even if it were in universal use, and were exclusively known by such name, such name would not become dedicated to the public, so that any one would have a right to use it without the consent of the original proprietor.

§ 114. **General use of name does not dedicate it to public.**

The mere fact that a name, lawfully adopted as a trade-mark, has been extensively or generally used as the name of the article, will not dedicate it to the public, and deprive the original proprietor of his exclusive rights. This doctrine is laid down clearly in a number of recent cases. Thus, in *Burton v. Stratton*⁹⁷ it is said: "If the primary object of the trade-mark be to indicate origin or ownership, the mere fact that the article has obtained such a widespread sale that the mark has also become indicative of quality is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his trade-mark just at the time when it had become most valuable to him, and stood most in need of protection. But if the name be suffered to come into general use without objection from the proprietor, it may become merely generic or indicative of quality." And in *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*,⁹⁸ Mr. Justice Bradley said: "It is undoubtedly true, as a general rule, that a word merely descriptive of the article to which it is applied cannot be used as a trade-mark. Everybody has a right to use the common appellatives of the language, and to apply them to the things denoted by them. A dealer in flour cannot adopt the word 'flour' as his trade-mark, and prevent others from applying it to their packages of flour. I am satisfied from the evidence adduced before me that the

⁹⁷ (1882) 12 Fed. 696.

⁹⁸ (1887) 32 Fed. 94.

word 'celluloid' has become the most commonly-used name of the substance which both parties manufacture, and, if the rule referred to were of universal application, the position of the defendant would be unassailable. But the special case before me is this: The complainant's assignors, the Hyatts, coined and adopted the word when it was unknown, and made it their trade-mark, and the complainant is assignee of all the rights of the Hyatts. When the word was coined and adopted, it was clearly a good trade-mark. The question is whether the subsequent use of it by the public, as a common appellative of the substance manufactured, can take away the complainant's right. It seems to me that it cannot. As a common appellative, the public has the right to use the word for all purposes for designating the article or product except one,—it cannot use it as a trade-mark, or in the way that a trade-mark is used, by applying it to and stamping it upon the articles. The complainant alone can do this, and any other person doing it will infringe the complainant's right. Perhaps the defendant would have a right to advertise that it manufactures celluloid, but this use of the word is very different from using it as a trade-mark stamped upon its goods. It is the latter use which the complainant claims to have an exclusive right in, and, if it has such right (which it seems to me it has), then such a use by the defendant of the word 'celluloid' itself, or of any colorable imitation of it, would be an invasion of the complainant's rights."

In the case of *Schendel v. Silver*⁹⁹ it was held by the New York supreme court that where the manufacturer has invented a new name, consisting either of a new word or words in common use, applied for the first time to distinguish his manufactures, if the name be not generic or descriptive of

⁹⁹ (1892) 63 Hun (N. Y.) 330.

the article, and not used to denote grade or quality, but is arbitrary and fanciful, he is entitled to be protected in its use, even though it has become so generally known as to be adopted by the public as descriptive of the article.

In the well-considered case of *Selchow v. Baker*,¹⁰⁰ the court of appeals of the state of New York, in an opinion delivered by Judge Rapallo, in discussing this question, said: "It cannot be true, as a general proposition, as contended on the part of the defendants, that, when a manufacturer has given to his products a new name invented by himself for the purpose of distinguishing them as his, and the article becomes generally known to the trade and to the public by that name, the name becomes public property, and every one has a right to use it. That proposition can be sustained only in respect to names which are descriptive of the article, and incapable of being appropriated as trade-marks. The value of a trade-mark consists in its becoming known to the trade as the mark of the manufacturer who has invented or adopted it, and in being known to the public as the name of an article which has met with popular favor. It cannot be that the very circumstances which give it value operate at the same time to destroy it. * * * Our conclusion is that, where a manufacturer has invented a new name, consisting either of a new word, or a word or words in common use, which he has applied for the first time to his own manufacture or to an article manufactured for him, to distinguish it from those manufactured and sold by others, and the name thus adopted is not generic or descriptive of the article, its qualities, ingredients, or characteristics, but is arbitrary or fanciful, and is not used merely to denote grade or quality, he is entitled to be protected in the use of that name, notwithstanding that it has become so generally known that it has

¹⁰⁰ (1883) 93 N. Y. 59.

been adopted by the public as the ordinary appellation of the article.”

§ 115. Whether name has become generic is question of fact.

Whether a name that had once been a valid trade-mark has become the generic name of the article to which it is applied, and hence has become dedicated to the public, is, in every case, purely a question of fact to be determined by the court on the evidence before it.¹⁰¹

¹⁰¹ *Noera v. Williams Mfg. Co.* (1893) 158 Mass. 110.

CHAPTER VI.

TRANSFER OF TRADE-MARKS.

- § 116. Trade-Marks Generally Assignable with Business in Which Used.
- 117. As an Abstract Right, Trade-Mark not Assignable.
- 118. Assignee Acquires All Rights of Assignor.
- 119. Assignee Has no Better Title than Assignor.
- 120. One may Assign His Own Name so as to Deprive Himself of Its Further Use.
- 121. Trade-Mark Assignable with Letters Patent.
- 122. Partnership Generally Acquires Trade-Mark of Individual Partners.
- 123. Firm may Have License from Individual Partner, Which Will Revert to Owner on Dissolution of Partnership.
- 124. Firm or Corporation Succeeding to Business Acquires Trade-Mark.
- 125. Partners Remaining in Firm Entitled to Firm Trade-Marks.
- 126. All Partners Entitled to Use Trade-Mark on Dissolution of Firm: Hazard v. Caswell.
- 127. Same Rule: Huwer v. Dannenhoffer.
- 128. Cases of Hazard v. Caswell and Huwer v. Dannenhoffer Compared with Menendez v. Holt.
- 129. Successor may Acquire Right to Use Name from Others.
- 130. Successor to Original Proprietor may appropriate Trade-Mark.
- 131. One Who Acquires Manufactory may Acquire Right to Use Trade-Mark.
- 132. Proprietor may Use Name of Mill.
- 133. No Exclusive Right to Trade-Mark Acquired by Mortgage of Lands and Mill.
- 134. Personal Name not Transferable.
- 135. Whether Trade-Mark Assignable Depends upon Effect Produced by Use Thereof.
- 136. Trade-Mark Inseparable from Thing Which Gives It Value.
- 137. Name of Man cannot be Segregated from the Man Himself, and from His Business.

- 138. Trade-Mark Consisting of Name of Individual no Guaranty that Articles made by Individual Personally.
- 139. Names Held not Personal.
- 140. Personal Trade-Mark Held Assignable Where Original Proprietors Supervise Manufacture.
- 141. Question of Assignability Depends upon Circumstances.
- 142. Purchasers of Trade-Marks should Indicate Change.
- 143. Trade-Mark not Assignable Where Its Use would Deceive Public.
- 144. Transfer of Trade-Mark Apart from Business Confers no Title on Transferee.
- 145. Leading English Case of Leather Cloth Co. v. American Leather Cloth Co.
- 146. Sale of Woodcuts does not Transfer Trade-Mark.
- 147. Assignment of Invalid Registered Mark Insufficient to Support Injunction.
- 148. Assignment in Bankruptcy Carries Trade-Mark.
- 149. Assignment to Trustee of All Assets Carries Trade-Mark.
- 150. Instance of General Assignment not Passing Trade-Mark.
- 151. No Distinction Between Sale by Proprietor and Sale by Assignee.
- 152. Right to Use Name and Knowledge cannot be Taken by Judicial Proceeding.
- 153. Administrator of Assignee has no Title to Trade-Mark.
- 154. Trade-Mark cannot be Levied upon by Execution.

§ 116. Trade-marks generally assignable with business in which used.

Where a trade-mark is applied to a commercial article to indicate its origin at a particular manufactory or place of production, or its origin or ownership with a particular manufacturer or dealer, and not to indicate that such article is produced by the peculiar skill of any particular individual, the trade-mark is transferable, and will pass with the manufactory or place of production, or with the business in which it is used, to a successor to the original proprietor.¹ Trade-

¹ Kidd v. Johnson (1879) 100 U. S. 617; Brown Chemical Co. v. Meyer (1891) 139 U. S. 540; Richmond Nervine Co. v. Richmond (1895) 159 U. S. 233; Pepper v. Labrot (1881) 8 Fed. 29; Prince's Metallic Paint Co. v. Prince Mfg. Co. (1893) 6 C. C. A. 647, 57 Fed.

marks of this character constitute a part of the assets of an individual, firm, or corporation, and pass under a sale of the assets and goodwill of the business, whether specifically men-

938: *Witthaus v. Mattfeldt* (1876) 44 Md. 303; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 10 Abb. Pr. (N. S.; N. Y.) 348. *Id.*, 45 N. Y. 291; *Dixon Crucible Co. v. Guggenheim* (1869) 2 Brewst. (Pa.) 321; *Hegeman v. Hegeman* (1880) 8 Daly (N. Y.) 1; *Oakes v. Tonsmierre* (1883) 49 Fed. 447; *Walton v. Crowley* (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; *Le Page Co. v. Russia Cement Co.* (1892) 2 C. C. A. 555, 51 Fed. 941; *Cuervo v. Lundauer* (1894) 63 Fed. 1003; *Chattanooga Medicine Co. v. Thedford* (1894) 14 C. C. A. 101, 66 Fed. 544; *Jennings v. Johnson* (1888) 37 Fed. 364; *Lockwood v. Bostwick* (1869) 2 Daly (N. Y.) 521; *Sohl v. Geisendorf* (1871) 1 Wils. (Ind.) 60; *Glen & Hall Mfg. Co. v. Hall* (1874) 61 N. Y. 226; *Gillis v. Hall* (1870) 7 Phila. (Pa.) 422; *Burton v. Stratton* (1882) 12 Fed. 696; *Huwer v. Dauenhoffer* (1880) 82 N. Y. 499; *Fish Bros. Wagon Co. v. La Belle Wagon Works* (1892) 82 Wis. 546; *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1891) 49 Ill. App. 430, (1892) 142 Ill. 494; *Wilmer v. Thomas* (1891) 74 Md. 485; *Mattingly Co. v. Mattingly* (1894) 96 Ky. 430; *Weener v. Brayton* (1890) 152 Mass. 101; *Dant v. Head* (1890) 90 Ky. 255; *Metcalf v. Brand* (1887) 86 Ky. 331; *Symonds v. Jones* (1890) 82 Me. 302; *Laughman's Appeal* (1889) 128 Pa. 1; *Kinney Tobacco Co. v. Maller* (1889) 53 Hun (N. Y.) 340; *Frank v. Sleeper* (1890) 150 Mass. 583; *Noera v. Williams Mfg. Co.* (1893) 158 Mass. 110; *Merry v. Hoopes* (1888) 111 N. Y. 415; *Hall v. Barrows* (1863) 4 De Gex, J. & S. 150; *Leather Cloth Co. v. American Leather Cloth Co.* (1863) 4 De Gex, J. & S. 137; *Edleston v. Vick* (1853) 23 Eng. Law & Eq. 51, 18 Jur. 7; *Warren v. Warren Thread Co.* (1882) 134 Mass. 247.

In *Kidd v. Johnson* (1879) 100 U. S. 617, 620, Field, J.: "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 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 the trade-mark may be lawfully transferred with it. Its subsequent use by the

tioned or not.² The transfer of the trade-mark may be by a separate instrument, extending to the vendee and his suc-

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. Such is the purport of the language of Lord Cranworth in the case of *Leather Cloth Co. v. American Leather Cloth Co.*, reported in 11 Jur. 513. See, also, *Ainsworth v. Walmesley*, 35 L. J. Ch. 355, and *Hall v. Barrows*, 10 Jur. 55. The present case falls within this rule."

In *Fish Bros. Wagon Co. v. Fish Bros Mfg. Co.* (1899) 37 C. C. A. 146, 95 Fed. 457, 461, Sanborn, Cir. J.: "The appellant contends that this rule is inapplicable to the case at bar because the right of Titus G. Fish and Edwin B. Fish to the use of the words and devices in question * * * was not subject to sale as distinct property, separate from the articles manufactured and the business of manufacturing, so that, as it claims, the appellee acquired no right to their use under its assignment from the Fishes. But this position is untenable, because the evidence is clear, not only that the assignment of the right to use these words and devices contained a conveyance of the goodwill of the business of the Fishes in Wisconsin, but also that it was a part of a single transaction by which they transferred to the appellee, at Clinton, Iowa, all the machinery, patterns, business, goodwill, and the right to the use of the trade-names which they owned and used in the business of manufacturing wagons at South Superior, Wis., and of selling them throughout the country. The assignment was not invalid because it was not accompanied with a transfer of the business and machinery. * * * Restraints upon alienation are not favored by the law. The modern rule is that one may do what he will with his own, unless prohibited by a positive statute, or restrained by manifest public policy. The principal value of property inheres in the right to sell it, and

² *Johnson v. Schenck* (1877) 1 Cin. Law Bul. 374, Fed. Cas. No. 7,412; *Morgan v. Rogers* (1884) 19 Fed. 596; *Shipwright v. Clements* (1871) 19 Wkly. Rep. 599; *Frese v. Bachof* (1878) 14 Blatchf. 432, Fed. Cas. No. 5,110; *Le Page Co. v. Russia Cement Co.* (1892) 51 Fed. 941; *Adams v. Adams* (1879) 7 Abb. N. C. (N. Y.) 292; *Hoxie v. Chaney* (1887) 143 Mass. 592; *Listman Mill Co. v. Listman Milling Co.* (1894) 88 Wis. 334; *Allegretti v. Allegretti Chocolate Cream Co.* (1898) 177 Ill. 129; *Rubel v. Allegretti Chocolate Cream Co.* (1898) 76 Ill. App. 581.

cessors the use of all brands formerly used by the vendor in such manufactory, and the right to use such brands will be deemed coextensive with the whole country, and exclusive in such vendee and his successors.³ There are a few cases in-

all property is presumed to be salable and assignable unless its sale or assignment is clearly forbidden. *Barnes v. Poirier*, 27 U. S. App. 500, 501, 12 C. C. A. 9, 10, 64 Fed. 14, 15."

In *Dant v. Head* (1890) 90 Ky. 255, 261, Lewis, C. J.: "The defense that the distiller's 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 with the establishment."

In *J. C. Mattingly Co. v. Mattingly* (1895) 96 Ky. 430, 437, Lewis, J.: "And that a trade-mark or trade-name, such as the two described, affixed to an article manufactured at a particular place, may be lawfully sold and transferred with the establishment, is no longer an open question in this state. *Dant v. Head*, 90 Ky. 255."

In *Symonds v. Jones* (1890) 82 Me. 302, 312, Emery, J.: "What is known as the goodwill of the business is recognized by the law as a proper subject of sale or contract, in connection with a transfer of the business plant. An established business, with plants and products well known to the trade, has a money value often far above that of its mere plant, and this is often the controlling motive for the purchase. Labels, trade-marks, particular words and phrases devised or used to distinguish or identify the products 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. They are, equally with the goodwill, proper subjects of such sale and contract. The name or initials of the originator or owner of the business, when used on labels and as trade-marks in the business, may thereby have a value, and so may be included in a sale of the business, so far, at least, as to prevent the vendor afterwards using them in like manner, on other similar products, to the detriment of his vendee."

In *Laughman's Appeal* (1889) 128 Pa. 1, 18, Clark, J.: "Trade-marks are the proper subject of assignment, to the extent, at least, that, unless reserved, they pass with an assignment of business (Se-

³ *Kidd v. Johnson* (1879) 100 U. S. 617.

dicating that the mere right to use a name is not assignable,⁴ but none that it may not be assigned to an outgoing partner

ba.tian, Trade-Marks, 236); and the assignment by one partner of all his interest in a firm to his co-partners will carry with it the exclusive use of the trade-mark of the firm (Menendez v. Holt, 128 U. S. 514). 'As 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 the trade-mark may be lawfully transferred with it.' "

In *Morgan v. Rogers* (1884) 19 Fed. 596, 597, Colt, J.: "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 properly sold with the firm property."

In *Skinner v. Oakes* (1881) 10 Mo. App. 45, 55, Thompson, J.: "There are some quasi proprietary rights, such as the elective franchise, which are incapable of assignment; but it would be obviously unjust so to restrict the right to use a trade-mark. The advantages which accrue from the use of a particular trade-mark or advertising device are often the result of a lifetime of integrity, skill, perseverance, and business capacity. Ought it to be held that a right so valuable should die with the person who created it, it being incapable of assignment, when, by reason of age or other considerations, he might desire to cease using it? The custom of trade, which solves many questions in advance of the courts, has declared that this should not be; and the courts, in adopting the view that the right to use a trade-mark is assignable, did no more than declare a result which followed from the concession that it was property, for the *jus disponendi* is embodied in the very idea of property. 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

⁴ *Chadwick v. Covell* (1890) 151 Mass. 190; *Skinner v. Oakes* (1881) 10 Mo. App. 45.

or to a successor in business, as an incident to its goodwill.⁵ And even where the trade-mark was not designed until after

of being bought and sold as other property. 'A trade-mark,' says Strong, J., 'like the goodwill of a store or manufacturing establishment, is a subject of commerce, and it has been many times held entitled to protection at the suit of vendees.' *Fulton v. Sellers*, 4 Brewst. (Pa.) 42. See, also, *Bury v. Bedford*, 33 L. J. Ch. 465; *Hall v. Barrows*, 33 L. J. Ch. 204; *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226; *Peltz v. Eichele*, 62 Mo. 171." Continuing, Thompson, J., said: "But there are many cases where the courts uphold the use of a name as a trade-mark, trade-name, or advertising engaged in the trade, and although, in order to do so, it is necessary to enjoin the person whose name is so used from a similar use of the name. 'These cases, so far as I have been enabled to discover and classify them, are two-fold: First. Where the business is sold, together with the goodwill thereof, in which case, either by the usages of trade or the express contract of the parties, the name passes with the business to the assignee. In such cases, in view of the courts, no deception is, in fact, practiced upon the public, since, in conformity with the usages of trade, the names used in the style of a business firm are not understood by the public as necessarily implying that persons of that name are actually members of the firm. Such was the case of *Churton v. Douglas*, Johns. Eng. Ch. 174, where John Douglas, of the firm of John Douglas & Co., having sold out his interest in the property and goodwill of the firm, was enjoined from taking in other partners and setting up a similar business near the old place, under the same firm name of John Douglas & Co. Such, also, was *Dixon Crucible Co. v. Guggenheim*, 2 Brewst. (Pa.) 321; * * * and such was this case, as it stood between *Probasco and Oakes*, as will be seen by reference to *Probasco v. Bouyon*, 1 Mo. App. 241. Some courts, indeed, have gone so far as to assimilate a trade-mark to the species of property known as 'goodwill,' insomuch as to hold that it is not vendible except as a part of the establishment or business with which it was originally connected. *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. Cas. 523, 534, 544; *Witthaus v. Mattfeldt*, 44 Md. 303, 306."

In *Petrolia Mfg. Co. v. Bell & Bogart Soap Co.* (1899) 97 Fed. 781, 783, Townsend, Dist. J.: "The bill alleges that Jenkins was the inventor of the trade-mark, and a producer of, and dealer in, said

⁵ *Ainsworth v. Walmsley* (1866) L. R. 1 Eq. 518; *Richmond Nervine Co. v. Richmond* (1835) 159 U. S. 293.

the transfer of the business, and there was no formal transfer of the trade-mark, the successor becomes the owner of the trade-mark where it appears that it was designed and adopted for use in the business previously transferred. And the

soap, or who had caused said soap to be manufactured or produced for him, and that he 'organized a corporation, under the laws of the state of New Jersey, named the "Coal Oil Johnny Soap Company," for the purpose of manufacturing and selling said soap,' and assigned said trade-mark to said company, subject to a certain condition subsequent. This is not a sale of a trade-mark, as distinct property separate from the article or the manufacturer, but a transfer by the producer of the right to use the trade-name in connection with the corporation and place of business which he has organized and established to manufacture and deal in the article."

In *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 N. Y. 291, 302, Folger, J.: "A property in trade-mark may be obtained by transfer from him, who has made the primary acquisition, though it is essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade-mark has been attached. Upton, *Trade-Marks*, 52. And it may also pass, by operation of law, to any one who, at the same time, takes that right. *Dixon Crucible Co. v. Guggenheim*, 2 Brewst. (Pa) 335. And see *Banks v. Gibson*, 34 Beav. 566. The plaintiffs purchased of the former proprietors the spring. They took the whole property in it. They thus obtained that which was the prime value of it,—the exclusive right to preserve its water in bottles, as an article of merchandise, and the exclusive right to sell it when bottled. Thus, they acquired the business of their predecessors, for, the plaintiffs owning the spring, no one else could carry on the business; and, under the rules above stated, they acquired, by assignment or operation of law, the right to the trade-mark before that in use to designate the article upon which this business was carried on. See, also, *Hall v. Burrows*, 10 Jur. 55."

In *Allegretti v. Allegretti Chocolate Cream Co.* (1898) 177 Ill. 129, 132. Wilkin, J.: "The transfer of the property and effects of a business carries with it the exclusive right to use such trade-marks or trade-names as have been used in such business. *Snyder Mfg. Co. v. Snyder*, 54 Ohio St. 86; *Williams v. Farrand*, 88 Mich. 473; *Fish Bros. Wagon Co. v. La Belle Wagon Works*, 82 Wis. 546; *Merry v. Hoopes*, 111 N. Y. 415; *Feder v. Benkert*, 70 Fed. 613, 18 C. C. A. 549."

trade-mark is not rendered unassignable from the fact that it bears the designer's own name and portrait,⁶ or that it consists simply of the name of the vendor, or of a surname which has become impersonal, by being attached to an article of manufacture, and becoming the name by which such article is known on the market.⁷

⁶ Richmond Nervine Co. v. Richmond (1895) 159 U. S. 293.

⁷ Dant v. Head (1890) 90 Ky. 255; Vonderbank v. Schmidt (1892) 44 La. Ann. 264; Fish Bros. Wagon Co. v. La Belle Wagon Works (1892) 82 Wis. 546.

In *Rubel v. Allegretti Chocolate Cream Co.* (1898) 76 Ill. App. 581-588, Horton, J.: "There is no testimony showing that Allegretti Bros. executed and delivered to appellee any formal assignment or transfer of the right claimed; but no such formal transfer is necessary * * * if such right existed in Allegretti Bros. In *Snyder Mfg. Co. v. Snyder*, 54 Ohio St. 86, 97, the supreme court, quoting from *Horton Mfg. Co. v. Horton Mfg. Co.*, 18 Fed. 816, states the rule thus: '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.' In *Williams v. Farrand*, 88 Mich. 473, 480, it is held 'that an assignment of all the stock, property, and effects of a business * * * carries with it the exclusive right to use * * * such trade-marks and trade-names as have been in use in such business. These incidents attach to the business or right of manufacture, and pass with it. Courts have uniformly held that a trade-mark has no separate existence; that there is no property in words, as detached from the thing to which they are applied; and that a conveyance of the thing to which it is attached carries with it the name.' In the case of *Fish Bros. Wagon Co. v. La Belle Wagon Works*, 82 Wis. 546, the business of the firm of Fish Bros., wagon manufacturers at Racine, together with all the property and assets, passed to Fish Bros. & Co., agents; thence into the hands of a receiver; thence to the Fish Bros. Wagon Co., a corporation. The Fish brothers remained in the business through the successive changes. * * * Several years after the organization of the corporation, the Fish brothers withdrew therefrom, and formed a partnership to manufacture and deal in wagons in another place, under the name of Fish Bros. & Co. In an action against them by the corporation, it is held that the latter had acquired the goodwill of the original business, and the

§ 117. As an abstract right, trade-mark not assignable.

As a mere abstract right, having no reference to any particular person or property, a trade-mark cannot pass by assignment or descend to a man's legal representatives. The reason for this is that, as an abstract right, apart from the business in which it is used, a trade-mark has no existence. To permit a trade-mark to be transferred apart from the business in which it is used would be productive of fraud upon the public. Moreover, the trade-mark must be assigned for continued use upon the same article or class of articles upon which it was used by the assignor.⁸

right to use the said names ['Fish Bros.' etc.] and pictures [a fish on which were the words 'Bros.' etc.] as trade-marks, although the same were not specifically mentioned in any of the transfers of the business to the corporation. In the case of *Merry v. Hoopes*, 111 N. Y. 415, it is held that where, upon the dissolution of a firm, one of the partners purchases and succeeds to the business of the firm, the exclusive right to use trade-marks belonging to the firm passes to the purchaser, although no express mention is made of them in the deed of assignment. There was no express assignment in *Feder v. Benkert*, 18 C. C. A. 549, 70 Fed. 613, yet it was there held that the trade-mark passed to the several successors, although no one originally connected with the firm had any longer any interest therein."

In *Wilmer v. Thomas* (1891) 74 Md. 485, 488, Alvey, C. J.: "That the goodwill of an established business, as also the brands or trade-marks used to distinguish and specially denote the product of manufacture of the establishment, are property, and form the subjects of contract and sale, is a principle too well settled to need the citation of authorities for its support. * * * And so important a contribution to the value of the establishment are these elements or accessories of the business that, in the sale or assignment of such manufactory or business establishment, to be continued as formerly, the sale or transfer of such an establishment ordinarily carries with it, by reasonable intendment or implication, the right to such goodwill and trade-mark."

⁸ *Morgan v. Rogers* (1884) 19 Fed. 596; *Filkins v. Blackman* (1876) 13 Blatchf. 440, Fed. Cas. No. 4,786; *Dixon Crucible Co. v. Guggenheim* (1869) 2 Brewst. (Pa.) 321; *Witthaus v. Mattfeldt* (1875) 44

§ 118. Assignee acquires all rights of assignor.

The assignee of the original proprietor of a trade-mark, and of the goodwill of the trade, stands in the same relation

Md. 303; *Skinner v. Oakes* (1881) 10 Mo. App. 45; *Weston v. Ketcham* (1876) 51 How. Pr. (N. Y.) 455; *Weener v. Brayton* (1890) 152 Mass. 101; *Fair v. Jose Morales & Co.* (1899) 82 Ill. App. 499; *McVeagh v. Valencia Cigar Factory* (1885) 32 Pat. Off. Gaz. 1124; *Cotton v. Gillard* (1874) 44 L. J. Ch. 90.

In *Weener v. Brayton* (1890) 152 Mass. 101, 103, Devens, J.: "The right to a trade-mark cannot exist as a mere abstract right, independent of and disconnected from a business. It is not property, as distinct from, but only as incident to, the business. It cannot be transferred except with the business, may be sold with it, and ordinarily passes with it. *Cigar-Makers' Protective Union v. Conhaim*, 40 Minn. 243."

In *Weston v. Ketcham* (1876) 51 How. Pr. (N. Y.) 455, 456, Sedgwick, J.: "Mrs. Pepper did not succeed to any business of her husband's, which continuing, a trade-mark belonging to it might continue. 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. And she is in no way disclosed by the evidence—and I do not see how any could possibly exist—become possessed of the right to transfer to any one the right to use her deceased husband's name."

In *Witthaus v. Mattfeldt* (1875) 44 Md. 303, 306, Robinson, J.: "The mere sale of a trade-mark apart from the article to which it is 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."

In *Dixon Crucible Co. v. Guggenheim* (1869) 2 Brewst. (Pa.) 321, 339, Paxson, J.: "The true rule to be deduced from these cases would appear to be this: That the property or right to a trade-mark may pass by an assignment or by operation of law to any one who takes, at the same time, the right to manufacture or sell the particular merchandise to which said trade-mark has been attached. 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."

In *The Fair v. Jose Morales & Co.* (1899) 82 Ill. App. 499, 505, Sears, J.: "That trade-marks cannot be thus conveyed in gross by in-

to the trade-mark as his assignor would, and whatever privilege the law accorded to his assignor in the possession and

dependent transfer, without also conveying the business to which the trade-mark attaches, is established by many decisions of different jurisdictions, among which are *Dixon Crucible Co. v. Guggenheim*, 2 Brewst. (Pa.) 321, and *Witthaus v. Mattfeldt*, 44 Md. 303."

In *Skinner v. Oakes* (1881) 10 Mo. App. 45, 59, Thompson, J.: "So, in the case before us, if we could gather from the record that the plaintiffs are the successors in business of Probasco & Oakes; that they had become the assignees, not merely of the trade-marks and tokens, but also of the establishment and the business, so that they are really carrying on the same business and manufacturing and selling the same goods as Probasco & Oakes,—we should have no difficulty in holding that they are entitled to the relief which the court below awarded them. But, so far as we can gather from the record, they stand before us as the naked assignees of certain trade-marks and tokens which were used by the originators of them in the sale of candies, and they claim the general right to sell candies by means of these trade-marks and tokens. This claim can only be supported by alleging and proving that these marks and tokens were originally devised and used to designate goods of a certain quality or description, and that they are, in fact, using them to designate goods of substantially the same quality or description. *Filkins v. Blackman*, 13 Blatchf. 440, Fed. Cas. No. 4,786."

In *Corwin v. Daly* (1860) 7 Bosw. (N. Y.) 222, 234, Robertson, J.: "But it is doubtful if the right of using a mere trade-mark, by itself, can be transferred like a copyright, so as to make wares, not yet in existence, the subject of them, and the injury to an assignee of it greater or less by the use of it by others. The imitation of a trade-mark is entirely a personal injury. It is merely passing off the wares of the imitator as being those of the party injured. I do not see how his borrowing, or purchasing the supposed right to use a certain mark to designate his wares can make the offense greater or less. Still less do I see how the relinquishment by the assignor of his trade-mark, and the dealing in particular wares, although in favor of a certain person, can prevent the rest of the world from using that trade-mark to distinguish their wares. On the other hand, although a name has been used by any one as a trade-mark, and is susceptible of being used as such, its previous employment by him, when abandoned, does not prevent any one else from employing it to designate their wares. It is wholly immaterial how long or how much a word has been employed as a trade

use of the trade-mark passes to such assignee under the assignment.⁹

mark. The employer of it can neither give any special right to another, nor abandon it to the community, so as to forever take away the right of employing it to designate his wares. If he can, the first use of a trade-mark gives a common-law perpetual copyright in it. If that exist in this case, it must be in the tradesman in London and Dublin, who applied the term 'Club House' to superior articles, and particularly to those who applied it to gin, as testified to by the witnesses."

⁹ *Walton v. Crowley* (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133; *Glen & Hall Mfg. Co. v. Hall* (1874) 61 N. Y. 226; *Fulton v. Sellers* (1867) 4 Brewst. (Pa.) 42; *Cuervo v. Landauer* (1894) 63 Fed. 1003; *Sohl v. Geisendorf* (1871) 1 Wils. (Ind.) 60; *Solis Cigar Co. v. Pozo* (1891) 16 Colo. 388.

In *Fulton v. Sellers* (1867) 4 Brewst. (Pa.) 42, 48, Strong, J.: "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 as 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. A trade-mark, like the goodwill of a store or manufacturing establishment, is a subject of commerce, and it has been many times held entitled to protection at the suit of vendees. Pirating the trade-mark of another is an infringement upon that other's right, and the use which he may make of that right cannot be in issue when a court is asked to stay the piracy."

In *Solis Cigar Co. v. Pozo* (1891) 16 Colo. 388, 395, Bissell, C.: "It was manifest that the original trade-mark had been adopted by R. Solis. He had devised and applied it to the El Cablo brand of cigars. The Solis Company, however, by transfer and succession, came into the right to use the brand. After the organization of the company, by the consent and procurement of the original owner, who was the largest individual stockholder of the concern, they continued the use of the mark. It is true that there was no formal transfer of the right, but the circumstances clearly manifest the intention of the parties, and the case becomes one of a continuing trade-mark in the possession of a corporation which succeeded to all the rights, goodwill and trade of the former owner. In such a case, the corporation would be treated as the equitable owner. At any rate, the respondent could not be heard to complain, and the plaintiff would not be denied relief on that ground."

§ 119. Assignee has no better title than assignor.

The assignee of a trade-mark can, of course, obtain no better title to the trade-mark than is held by his assignor. So it was held that, where the plaintiff's assignor had no exclusive right to adopt the words "New Orleans Mead" at the time he adopted them as a trade-mark, he acquired no rights by their subsequent use which the law will protect on that ground.¹⁰

§ 120. One may assign his own name so as to deprive himself of its further use.

A person 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, and the assignee will thereby become entitled to the exclusive use of the name, even as against the assignor. A person has the right to use his own name in conducting his business, either by himself or in connection with others, if done in a proper or legitimate way, and this right is a valuable one, especially when he is the discoverer of a valuable article of trade then being manufactured and sold on the market.

¹⁰ St. Louis Carbonating & Mfg. Co. v. Eclipse Carbonating Co. (1894) 58 Mo. App. 411.

In *Skinner v. Oakes* (1881) 10 Mo. App. 45, 53, Thompson, J.: "A point is made, in behalf of the defendant, Annie Oakes, that, before the plaintiffs acquired the alleged right to use the name of Oakes in the manufacture of candies, she, by marrying with Oakes, had acquired a right to use his name in the same connection, of which the plaintiffs cannot lawfully deprive her. There is nothing in this point except novelty. Peter Oakes could not confer upon Annie McLaughlin, by marrying her, any higher rights in the use of his own name than he himself had. A son cannot acquire from his father the right to use his father's name as a trade-mark, if the father had parted with the right by contract (*Filkins v. Blackman*, 13 Blatchf. 440, Fed. Cas. No. 4,786), and we do not see how a wife could stand in a better position as to the name of her husband."

This right, like most other property rights, is the subject of sale and transfer; and a person who has carried on business under a trade-name, or manufactured and sold a particular article in such manner as, by use of his name as a distinguishing feature of his trade-name or trade-mark, to cause the business or article to become known and established in favor under such trade-name or trade-mark, can sell or assign such trade-name or trade-mark when he sells the business, and by such sale or assignment deprive himself of the further use thereof.¹¹

¹¹ *Burton v. Stratton* (1882) 12 Fed. 696; *Hoxie v. Chaney* (1887) 143 Mass. 592; *Listman Mill Co. v. Listman Milling Co.* (1894) 88 Wis. 334; *Spieker v. Lash* (1894) 102 Cal. 38; *Le Page Co. v. Russia Cement Co.* (1892) 2 C. C. A. 555, 51 Fed. 941; *Gillis v. Hall* (1870) 7 Phila. (Pa.) 422; *Frazer v. Frazer Lubricator Co.* (1887) 121 Ill. 147, (1886) 18 Ill. App. 450; *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1892) 142 Ill. 494; *Kennedy Corporation v. Kennedy* (1899) 36 App. Div. (N. Y.) 599; *Russia Cement Co. v. Le Page* (1888) 147 Mass. 206; *Rubel v. Allegretti Chocolate Cream Co.* (1898) 76 Ill. App. 581; *Mattingly v. Mattingly* (1894) 96 Ky. 430; *Symonds v. Jones* (1890) 82 Me. 302; *Kramer v. Old* (1896) 119 N. C. 1.

In *Hazelton Boiler Co. v. Hazelton Tripod Boiler Co.* (1892) 142 Ill. 494, 507, *Bailey, C. J.*: "It is undoubtedly true, as was held in *Frazer v. Frazer Lubricating Co.*, 121 Ill. 147, that where a party sells out an established business, and with it his own name, to be used in connection with such business, his vendee will acquire a right to the use of the name, and the vendor cannot afterwards assume it in carrying on the same business. * * * The right of a man to use his own name in connection with his own business is so fundamental that an intention to entirely divest himself of such right, and transfer it to another, will not readily be presumed, but must be clearly shown. Where it is so shown, the transaction will be upheld."

In *Symonds v. Jones* (1890) 82 Me. 302-313, *Emery, J.*: "The respondent further urges that the words 'John Winslow Jones' constitute his name, and that the letters 'J. W. J.' are the initials of his name, and were intended to represent his name and initials, and that no one else can acquire the right to use them, or to prevent

§ 121. Trade-mark assignable with letters patent.

It has been held that a trade-mark used to designate goods manufactured under letters patent is assignable with the letters patent.¹² In this case, Morris, C., said: "This assignment and transfer carried with it to the assignee the exclusive right to manufacture and sell the grain drill specified in the letters patent, and to carry on the business of making and selling the same. It was a transfer to appellant of the right to carry on the business in which Joseph Ingels had been engaged, and in connection with which he had used said trade-mark. As incident to the right thus transferred

his using them. * * * The name or initials of the originator or owner of the business, when used on labels and as trade-marks in the business, may thereby have a value, and so may be included in a sale of the business, so far, at least, as to prevent the vendor afterwards using them in like manner on other similar products, to the detriment of his vendee."

In *Kramer v. Old* (1896) 119 N. C. 1, 7, Avery, J.: "The modern doctrine is founded on the basic principle that one who, by his skill and industry, builds up a business, acquires a property at least in the goodwill of his patrons which is the product of his own efforts (*Cowan v. Fairbrother*, 118 N. C. 406), and has the fundamental right to dispose of the fruits of his own labor, subject only to such restrictions as are imposed for the protection of society either by express enactments of law or by public policy. *Hughes v. Hodges*, 102 N. C. 239; *Bruce v. Strickland*, 81 N. C. 267. But the property which one thus creates by skill or talent and industry is not marketable, unless the owner is at liberty to sell his right of competition to the full extent of the field from which he derives his profit, and for a reasonable length of time. *Cowan v. Fairbrother*, supra; 2 High, Inj. § 1174; *Leather Cloth Co. v. Lorsont*, 39 Law J. Ch. 86; *Rousillon v. Rousillon*, 14 Ch. Div. 351; *Clark*, Cont. p. 451. To the extent that the assignor of this species of property is left at liberty to come into competition with the assignee, the market value of what is sold must fall below that of the untrammelled right to freedom from competition in the whole field from which the former derived the support of his business."

¹² *Julian v. Hoosier Drill Co.* (1881) 78 Ind. 408.