

use more than ordinary caution, and make him believe he has before him the same thing which he has before seen on the plaintiffs' bottle, and expects to find on the bottle he is looking at. The differences which he would see on having his attention called to them are not of such a character as to overcome the resemblances to the eye of a person expecting to see only the plaintiffs' bottle and labels, and having no knowledge of another. * * * The plaintiffs have no exclusive right to make the bitters. Their trade-mark is not in the words, 'Celebrated Stomach Bitters,' nor have they any exclusive right to a bottle of the size, shape, and color of the one which they use. But the entire style of their bottle and label, of which those words form a part, is, in connection with the other particulars above mentioned, in which the defendant's bottle and label are like theirs, the mark of their trade."¹⁸⁰

§ 269. **Bottle Stamped with Complainant's Label or Name.**

A manufacturer will be restrained from using, for the sale of his product, the old bottles of another dealer, used for a similar article, having such other dealer's name upon them.

Where it appeared that the defendant manufactured an article resembling Hostetter's Bitters manufactured by the complainant in color and in other particulars, and sold the same to retail dealers under the name "Host-Style Bitters," in large demijohns without labels, and it was shown that in several instances the defendant had given to a purchaser of his bitters an empty bottle which bore all the complainant's labels, it was held that although it appeared that the purchaser from the defendant was not deceived, the defendant had furnished the means of deceiving the public, and should be enjoined from selling Host-Style Bitters, and at the same

¹⁸⁰ Hostetter v. Adams (1882) 10 Fed. 838.

time, in connection, giving to the public empty Hostetter bottles.¹⁹⁰

Both parties were dealers in lime juice, and the contention was that defendants had no right to sell lime juice in bottles bearing complainant's name. The court said: "I am aware that the name is on the bottom of the bottle, and that it is not very prominent; but while the defendant may buy in the market these bottles, and sell them again filled with anything but lime juice, I do not think he should be permitted to put his own lime juice into a bottle stamped with the complainants' name, and sell it. This may be said to be calculated to lead the public to believe they are buying the complainants' lime juice, when in point of fact they are buying some other person's."¹⁹¹

§ 270. Exclusive Right to Box.

The fact that the plaintiff was the first to put up a particular kind of merchandise in boxes does not give him an exclusive right to their use for that purpose, and he is therefore not entitled to a preliminary injunction against the use of a similar box by another manufacturer, unless it is clearly shown that the similarity is such as likely to mislead and impose upon ordinary purchasers exercising such care only as is commonly used in purchasing such articles. In a recent case in the federal court¹⁹² it was said: "I substantially quote a portion of the court's opinion in *Van Camp Packing Co. v. Cruikshanks Bros. Co.*¹⁹³ when I say of the present case that the defendants' use of boxes similar to the

¹⁹⁰ *Hostetter Co. v. Becker* (1896) 73 Fed. 297. See chapter 4, § 200.

¹⁹¹ *Evans v. Von Laer* (1887) 32 Fed. 153, citing *Rose v. Loftus* (1878) 38 Law T. (N. S.) 409; *Richards v. Williamson* (1874) 30 Law T. (N. S.) 746.

¹⁹² *Pfeiffer v. Wilde* (1900) 102 Fed. 658. See chapter 3, § 79.

¹⁹³ (1898) 33 C. C. A. 280, 90 Fed. 814.

plaintiffs', without more, could not be complained of. It is a common way of packing various articles of merchandise, and, even if the plaintiffs were the first to apply it to packing 'Coffee Essence,' they have not thereby obtained a monopoly of its use for that purpose. The boxes and their markings are readily distinguishable from the plaintiffs' by intelligent persons, and, with care, ordinary purchasers would probably distinguish them. The question, however, is, did they bear such similarity as is likely to impose on ordinary purchasers, exercising such care only as is commonly used in purchasing such articles? This question cannot be answered with certainty or safety from the evidence before me. There is no proof that any one has been so misled. In this state of uncertainty, a preliminary injunction should not be awarded. To justify a preliminary injunction, the plaintiffs' case must be clear in all respects."¹⁹⁴

§ 271. Every-Day Soap Case.

The soap manufactured by complainant was sold in packages with a yellow wrapper, on the side of which was printed in black letters the words "Every-Day Soap," together with the name and location of the maker. There was a small circular figure containing a representation of the moon and stars on a black ground. The defendant sold its soap in packages of a similar size and shape, with a yellow wrapper. On one face of it was a black ground, showing only the

¹⁹⁴ See, also, *Lare v. Harper & Bros.* (1898) 30 C. C. A. 373, 86 Fed. 481. In *Centaur Co. v. Hughes Bros. Mfg. Co.* (1898) 34 C. C. A. 127, 91 Fed. 901, the lower court refused a preliminary injunction and the judgment reversing this decree was that of a divided court. *Franck v. Frank Chicory Co.* (1899) 95 Fed. 818, was not decided upon a motion for a preliminary injunction, but on a final hearing, and it was manifest from the undisputed testimony that the defendants entered the field with an intention which was both calculated to and which did deceive purchasers.

words "Every-Day Soap," in letters formed by the yellow paper of the wrapper showing through the black field of the label. The other figures displayed on the sides and back of the label bore no resemblance to anything on complainant's, and the name and location of the maker were conspicuously shown on one side of the package. Upon this showing, an injunction was refused.¹⁹⁵

§ 272. **Baker's Breakfast Cocoa Case.**

The complainant used for its powdered cocoa a tin case of peculiar shape and size, with the words "Walter Baker & Co.'s Breakfast Cocoa" stamped on the lid end of the can, * * * and on one side of the can a picture of "La Belle Chocolatiere," * * * and the defendant, for the same goods, used a tin can of the same shape and size as that of the complainant's, with the words "W. H. Baker & Co.'s Breakfast Cocoa" stamped on the lid end of the can. On one of its sides was a picture of the bust of a girl, and the words "Baker's Cocoa" in large capitals. Defendants were enjoined from using cans of the same shape as those of the complainant, and from using the words "Breakfast Cocoa" in connection with the word "Baker," and from using, on the side of the can where there appeared the bust of the girl, the words "Baker's Cocoa."¹⁹⁶

§ 273. **Moxie Case.**

It appeared that the complainants, who were engaged in the sale of a certain beverage, used a trade-mark which consisted of the word "Moxie," with a label containing a picture and descriptive words. They also used a champagne

¹⁹⁵ Proctor & Gamble Co. v. Globe Refining Co. (1899) 34 C. C. A. 405, 92 Fed. 357.

¹⁹⁶ Walter Baker & Co. v. Baker (1896) 77 Fed. 131.

bottle, wrapped in a peculiar light-brown paper, with the words "Moxie Nerve Food" printed prominently thereon. After complainants had carried on business for some time, and acquired a large business, the defendants began the manufacture of a preparation similar in color, taste, and flavor to that of the complainants', and similarly put up in champagne bottles, with a label and wrapper sufficiently resembling that of the complainants to deceive the general public. It bore the words, "Standard Nerve Food," under which appeared the words "Genuine. Beach & Claridge," written across the label. The defendants were enjoined from putting on the market for sale any packages or bottles of the style of champagne bottles in use by the complainants, containing a liquid resembling that sold by the complainants as "Moxie Nerve Food" in taste, flavor, or appearance, and from using the words "Nerve Food," either alone or with other words, upon the outside or upon the wrapper of any package containing such fluid.¹⁹⁷

§ 274. **Mumm's Extra Dry Case.**

As early as 1866, the plaintiffs, at Rheims, originated a champagne wine having a "dry" flavor, which was extensively sold in the United States as "G. H. Mumm & Co.'s Extra Dry," and was distinctively known by the words "Extra Dry." They adopted a new and characteristic metal capsule of a peculiar rose color, never before used, and on top of it was stamped in blue an imperial mantle, bearing the trade-mark. The words "G. H. Mumm & Co." ran perpendicularly below the capsule. Just below the capsule was a small label, on which the trade-mark was also imprinted. The principal label of the bottle also bore this trade-mark on its upper field. The defendants sold aerated American wine in

¹⁹⁷ Moxie Nerve Food Co. v. Baumbach (1887) 32 Fed. 205.

ordinary champagne bottles, and on the upper part of the principal label they put the words "Extra Dry," and also a colorable imitation of the Mumm trade-mark. Just below the capsule they placed a small label bearing a similar imitation of the trade-mark and mantle, and the words "Extra Dry." The metal capsule was of the peculiar color used by Mumm & Co., and on its top was stamped in blue an imitation of the trade-mark and mantle, while the words "Extra Dry" were stamped perpendicularly thereon in the same manner as on that of the plaintiffs. As a matter of fact, the defendants' wine had no "dry" quality, and the court found from the testimony that the words "Extra Dry" were used to mislead, and that their bottles were dressed up so as to enable them to be sold as the goods of the plaintiff. Upon this showing, the defendants were enjoined (1) from further dressing up their product in this manner, or from using any combination of marks, labels, or capsules described; (2) from using any colorable imitation of the plaintiff's trade-mark; (3) from placing the words "Extra Dry" on any bottle of their product of the character described, either in combination or otherwise; and (4) from surrounding any cork of any bottle of the form generally used for champagne, and containing their product, with a rose-colored metal capsule, whether stamped as stated or otherwise.¹⁰⁸ It was held that one who puts into the hands of retail dealers any article made by him, and so dressed up as to enable such dealers to deceive the ultimate purchaser into the belief that he is purchasing goods of a third person, may be enjoined by the latter. "No man is permitted to use any mark, sign or symbol, device, or other means whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false represen-

¹⁰⁸ Von Mumm v. Frash (1893) 56 Fed. 830.

tation to somebody else who is the ultimate purchaser.¹⁹⁹

* * * In this case it has been made plain that the defendants dress up their manufacture in a manner well calculated to deceive an intending purchaser not initiated, and induce him to believe that the article purchased is the wine of the complainants, known as 'G. H. Mumm & Co.'s Extra Dry.' This dress the defendants adopt for the purpose of enabling such a fraud to be practiced. No other reason has been suggested, and none exists. The fact that an article such as the defendants make is dressed up by them as they dress it proves the existence of knaves willing to use the defendants' article for the purpose of deceit, and also the existence of persons not initiated capable of being deceived into buying the defendants' manufacture as 'G. H. Mumm & Co.'s Extra Dry.' If there were no such persons, the defendants never would have gone to the expense of dressing up their product as they do. But it is said that the defendants are guiltless, because they have never stated anything but the truth in regard to their manufacture. The earnestness with which this ground of defense has been pressed upon the court justifies some further comment upon the character of the act of the defendants in dressing up their article as they do. What the defendants do is this: They make and put in the hands of other persons the means of fraud, knowing that these means can be, and probably will be, employed for the purpose of fraud, and to the injury of the complainants. The defendants make and sell, knowingly, the tools for fraud; and they, and the knaves who buy the tools of them, intending to use them for the fraudulent purpose for which they were constructed, are co-conspirators, each guilty of the fraud perpetrated in pursuance of the intention with which the tools

¹⁹⁹ Singer Mfg. Co. v. Loog (1880) 18 Ch. Div. 395, 412. See section 235, supra.

were made, and this although the particular person intended to be defrauded is not agreed upon between them.”

§ 275. **Silicon Case.**

The plaintiff had adopted and used the word “Silicon” on a round wooden box, with a yellow paper cover, with border and printing thereon for the top and sides of the box,—all three elements in combination. The defendant, although not using the same associate words, imitated plaintiff’s combined use of these elements so as to inflict an injury upon plaintiff, and in a way well calculated to deceive purchasers. Although plaintiff was not entitled to the exclusive use of the word, it was held that defendant should be restrained from using it in such connection.²⁰⁰

§ 276. **Sapolio Case.**

The plaintiffs for many years had manufactured Sapolio, and the article had acquired an established reputation. The defendants, after ascertaining how the article was manufactured, began making an article similar in character, color, and appearance, which it called “Saphia.” It was admitted that this was a fanciful name, of no particular derivation or signification. The cakes of Saphia were inclosed in wrappers which also closely resembled, in their external and internal appearance, as to color, size, and partially as to description and directions for use, those of the plaintiffs. The court being satisfied that the wrapper as used by defendant was calculated to deceive the general public, and that the ordinary purchaser was in fact deceived by the similar dress in which the soaps were put on the market, it was held that the plaintiffs were entitled to an injunction restraining him from selling Saphia in the blue packages in which it was sold. The

²⁰⁰ *Electro-Silicon Co. v. Levy* (1880) 59 How. Pr. (N. Y.) 469.

defendant, however, was entitled to manufacture and sell the article under the name of "Saphia" so long as he abstained from dressing his goods in wrappers which so closely resembled plaintiffs' as to enable him to deceive the public, and thus perpetrate a fraud.²⁰¹

In another case it appeared that for many years plaintiff had sold polishing soap put up in cakes wrapped in paper coated with tinfoil, and having around the edge of each cake a blue paper band, with gilt letters printed thereon. Each cake was stamped with the words, "Enoch Morgan's Sons' Sapolio." Thereafter defendants prepared and sold soap which they put up in cakes wrapped in tinfoil, having a blue paper band around them similar to that used by the plaintiff, upon which was stamped "Troxell's Pride of the Kitchen Soap." It appeared that the defendants sold and delivered soap to grocers with the intent that it should be, and the same was, as a matter of fact, sold as Sapolio. Upon this evidence, defendants were enjoined from so preparing and selling the said soap.²⁰²

§ 277. Hostetter's Bitters Case.

For many years plaintiff had sold Hostetter's Bitters in bottles of a peculiar form and size, and had established a large business therein. The defendant sold spurious bitters, which closely resembled the real article, in demijohns, labeled "Histetter's Bitters," with intent that they should be sold by the drink at bars as "Hostetter's Bitters." The court said: "Complainant is entitled to protection against the appropriation of its trade-mark by any and all unfair and dishonorable means, and a court of equity has power to grant such pro-

²⁰¹ Enoch Morgan's Sons' Co. v. Schwachhofer (1878) 55 How. Pr. (N. Y.) 37.

²⁰² Enoch Morgan's Sons' Co. v. Troxell (1881) 23 Hun (N. Y.) 632.
(491)

tection whenever it is satisfied that an attempt has been made, by ingenious subterfuges, to invade the rights of an owner of a trade-mark, either by a conspiracy with others to deprive him of such rights, or by misrepresentation in the sale of a spurious article so manufactured as to deceive the public."²⁰³

§ 278. **Black Package Tea Case.**

In this case it was held ^{203a} that there could be no exclusive right to a trade-mark which represents an idea, nor an exclusive appropriation of that which is descriptive of the articles to which they are attached, or which indicates their ingredients, mode of composition, characteristic qualities, properties, or nature, and that, in order to have the right of a trade-mark, it must be some arbitrary figure or term not suggestive of the nature of the article. This action was brought to restrain the defendant from an alleged infringement of plaintiffs' wrappers, labels, and packages used in the sale of tea, and of their alleged trade-name of "Black Package Tea." The referee found that plaintiffs' tea was put up in packages of a peculiar form with black wrappers, having thereon three scenes in white, a certain yellow, also a silver, circular label, and a white diamond-shaped one. This tea became known in the market as "Black Package Tea," and was known to Russians as "Russian Caravan Tea," which words appeared in Russian on the packages. After plaintiffs' tea became well known in the market, the defendant adopted and used, in the sale of tea not of the plaintiff's importation, wrappers similar in color, and with similar labels and devices, with the words "Genuine Russian Tea," in Russian. The tea was put up in packages of a shape similar to that used by the plaintiffs. An interlocutory judgment was entered, which provided that the plain-

²⁰³ *Hostetter Co. v. Sommers* (1897) 84 Fed. 333.

^{203a} *Citing Koehler v. Sanders* (1890) 122 N. Y. 65, 72.

tiffs were entitled, as against defendant, to the exclusive use of the style of wrappers adopted by them, the circular yellow and silver and the white diamond shaped labels, and the peculiar form of package, and the defendant was restrained from using any imitation thereof, and also from using the words "Black Package Tea" in connection with the sale of tea not of the plaintiffs' importation. On final hearing it was held that this judgment was too broad, and that plaintiffs had no separate proprietary right to the form of package, or the name "Black Package Tea," or the circular or diamond shaped label, or the Russian words; but that, while there was no single point of resemblance which of itself would authorize equitable relief, and each one of these distinguishing marks might be separately used by the defendant, it was not entitled to combine all or a part of them in a single package, so arranged as likely to deceive a purchaser of ordinary intelligence, and to produce a false impression that the tea offered for sale therein was the plaintiffs' tea. To this extent the plaintiffs were entitled to protection by injunction. That part of the interlocutory judgment which provided for the destruction of the defendant's labels was error, as they might be used for lawful purposes.²⁰⁴

²⁰⁴ *Fischer v. Blank* (1893) 138 N. Y. 244. The court further said: "It must be admitted that there is no single point of resemblance or imitation which would of itself be regarded as adequate grounds for the grant of equitable relief. Form alone would not be sufficient; nor size; nor color; nor the general decoration of the panels; nor disks of the same size and color arranged in the same way; nor a label of the same shape and color attached to the same part; nor the use of the same name to designate the kind or quality of tea. Each one of these distinguishing features might be separately used, and no harm result; but when all or a number of them are combined in a single package, and so arranged and exhibited that, when they strike the eye of the intending purchaser, possessed of ordinary intelligence and judgment, the false impression is likely to be produced that the goods of the plaintiffs are offered, it is the province

§ 279. *Cuticura Case.*

Plaintiff was the proprietor of the word "Cuticura" as a trade-mark for toilet soap. The defendant put up for sale, and placed upon the market, a toilet soap under the name of "Cuticle" soap. The circulars which the defendant inclosed in the wrappers with each package of soap copied some of the reading matter from the circulars which plaintiff inclosed with its packages, and the style of letters used in printing the name "Cuticle" was also somewhat similar to those in which the name "Cuticura" was printed by the plaintiff. It was held that such facts did not establish unfair competition, where defendant's soap itself was of a different color from complainant's, and the wrappers inclosing each cake, and the box in which a number of cakes were inclosed, were so entirely dissimilar in color and general appearance that no purchaser of ordinary observation would be deceived thereby. "It is not obvious," said the court, "how any person of usual eyesight or observation could be misled or confused respecting these articles by the appearance of the articles, by the wrapping immediately about the same, by the exterior wrapping, or by the exterior surroundings. In other words, what a purchaser would ordinarily and necessarily see in selecting the article could in no instance lead him into error in making

of equity to interfere for the protection of the purchasing public, as well as of the plaintiffs, and for the suppression of unfair and dishonest competition. The true test, we think, is whether the resemblance is such that it is calculated to deceive, and does in fact deceive, the ordinary buyer making his purchases under the ordinary conditions which prevail in the conduct of the particular traffic to which the controversy relates. *Franks v. Weaver* (1847) 10 Beav. 297; *Amoskeag Mfg. Co. v. Spear* (1849) 2 Sandf. (N. Y.) 599; *Colman v. Crump* (1877) 70 N. Y. 573; *McLean v. Fleming* (1877) 96 U. S. 245; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537. No inflexible rule can be laid down,—each case must in a measure be a law unto itself."

his purchase. The contents of the inner circulars, however, show greater similarity, although there is absolute dissimilarity in appearance."²⁰⁵

§ 280. **Liebig's Beef Extract Case.**

For many years the Liebig Extract of Meat Co., Limited, had sold its product in the markets of the United States, and obtained a wide reputation. The defendant thereupon entered the market with a similar extract, distinctively dressed, but he subsequently sent out goods in a package so similar to that of the complainant in color and general appearance as to show that deception was intended, and so liable to result in the sale of the goods to the ultimate purchaser. He also used on the name of such packages, as the name of the manufacturer, the fictitious title of "Liebig's Fluid Beef Co." He was held guilty of unfair competition, the court saying:²⁰⁶ "The manufacture of the beef extracts in question is open to all the world, and the manufacture in accordance with the Liebig formula is equally open to defendants, under that name, 'subject, however, to the condition that the name must be so used as not to deprive others of their rights, or to deceive the public, and therefore that the name must be accompanied with such indication that the thing manufactured is the work of the one making it, as will unmistakably inform the public of that fact.'²⁰⁷ The complainant has possessed, in the United States, a trade in its products for more than thirty years, and for many years its trade has been of great extent, aided by large expenditures for advertising. The defendant entered the market with an extract which was

²⁰⁵ Potter Drug & Chemical Corp. v. Pasfield Soap Co. (1900) 102 Fed. 490.

²⁰⁶ Liebig's Extract of Meat Co. v. Libby (1900) 103 Fed. 87.

²⁰⁷ Citing Singer Mfg. Co. v. June Mfg. Co. (1896) 163 U. S. 169, 16 S. Ct. 1002.

well distinguished in the marking and the color of the package, but subsequently, in the Walker transaction at least, adopted a dress for the goods which clearly simulated that of the complainant, and was calculated to deceive. He assumed, as the name of the producer, the fictitious title of 'Liebig Fluid Beef Co.,' with the label stamped in blue, 'J. Walker,' and the color and general appearance of the package closely resembled that of complainant. It is true that 'Union Stock Yards, Chicago, U. S. A.,' appears on this label, but, taking all the circumstances, it is evident that deception was both intended and liable to arise in palming off the goods upon ultimate purchasers as those of complainant. The other exhibits, which bear the same color and fictitious title, taken with the shape and general appearance, although without blue signature, are deemed obnoxious and inexcusable under all the circumstances."²⁰⁸

§ 281. "Franck Chicory" Case.

For a half a century the firm of Heinrich Franck Soehne, of Germany, were extensive and well-known manufacturers from chicory of a substitute for coffee, having several factories in Europe. Their product was known and sent to all parts of the world as "Franck Kaffee," and afterwards as "Franck Chicory." For upwards of thirty-five years they had a large trade in this product in the United States, and in 1895 established at Flushing, Long Island, a branch firm under the name of "Heinrich Franck Soehne & Co.," who were the complainants in this action. In their business they had used the names "Franck Chicory" and "Genuine Franck," or "Echter Franck" (the German equivalent). The packages had been made, for upwards of twenty-five years,

²⁰⁸ Citing *Charles E. Hires Co. v. Consumers' Co.* (1900) 41 C. C. A. 71, 100 Fed. 809.

in cylindrical form, inclosed in red paper, and were familiarly known as "Franck's Red Roll Chicory." Under the name of "Franck," and in such livery, their product obtained some degree of popularity among the Germans of Wisconsin, and especially at and in the vicinity of Milwaukee, including Cedarburg, where the defendants' business was established. In 1892, the Frank Chicory Company, deriving its name from one Frank, a chicory raiser and small stockholder, was organized at Cedarburg, and entered upon the manufacture of chicory under that name in packages which were clearly a colorable imitation of the complainant's production. Thereafter, when the question of infringement was raised, the defendants changed the label of a portion of their production to read "Cedarburg Chicory Co.," instead of "Frank Chicory Co.," but reserved the same general appearance, form, and color, and the earlier labels were not discontinued in actual use. "As it is manifest," said the court, "from the undisputed testimony, that the defendants entered the field with the imitation which was both calculated to and did deceive purchasers who were familiar with the complainants' goods, and thus captured the trade of the latter, and the substituted label is a continuation of that deception in its appearance as a whole, I am of opinion that the defendants must be enjoined from the use of either label, and from using on the label the name 'Franck' or 'Frank' to designate their goods, or to use a label which is so identical in color as to preserve the deception. * * * Under the circumstances shown, however, there can be no just relief from the unfair competition without a change in color as well."²⁰⁹

§ 282. "Velvet" Candy Wrapper Case.

A. manufactured molasses candy, which he wrapped in pa-

²⁰⁹ Franck v. Frank Chicory Co. (1899) 95 Fed. 818.

per with twisted ends, with the word "Velvet" printed in red script letters upon the middle and ends of the wrappers. Others had sold molasses candy of the same size and shape, and wrapped the pieces in the same way, so that the combination was not original with A. The defendant company used the same combination and size and shape of candy, and the same kind and size of paper and manner of wrapping, all of which it had a right to do; but to this it added, printed in Roman letters instead of script, the word "McDonald" in red ink upon the middle of the wrapper, but not at the ends. It appeared that the public was in fact deceived into the belief that defendant's goods were plaintiff's goods, and that the resemblance was not accidental. Upon this showing, the court held that the plaintiff was entitled to an injunction restraining defendant "from printing or causing to be printed in red upon yellow wrappers, adapted to be used in putting up molasses candy, substantially in the size, shape, and manner in which said plaintiff * * * puts up and offers for sale the molasses candy made by him, the name McDonald, or any other name, word, mark or device whereby any candy sold or offered for sale by the defendant shall be caused to resemble, in its dress and appearance, said candy of the plaintiff, and also from putting up, offering for sale, or selling any molasses candy, or candy similar thereto, put up in yellow wrappers, with the red printing thereon substantially like the method employed by the plaintiff."²¹⁰

§ 283. **Old Coon Smoking Tobacco Case.**

In 1883 plaintiffs began putting up their "Old Coon Smoking Tobacco" in cloth bags containing a label which they had previously used on paper bags, in which they had been accustomed to put up the same tobacco. Soon afterwards,

²¹⁰ Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16.

in the fall of 1883, the defendant began putting up his "Old Bachelor Smoking Tobacco" in cloth bags of the same size. At the same time he changed his label, which previously had borne no colorable resemblance to that of the plaintiffs, to a label of a form, size, and color substantially like that of the plaintiffs, with the exception of the words "Not Old Coon." The court said: "Leaving out of view the fact that the defendant began putting up his tobacco in cloth bags soon after the plaintiffs began putting up their tobacco in the same kind of packages, which the defendant explains by stating that smoking tobacco could no longer be sold in paper packages, we find that there are no less than six distinct points of resemblance between the two labels: (1) The general form; (2) the oval vignette; (3) the lettering on the white field on the left-hand side; (4) the lettering on the white field on the right-hand side; (5) the size; (6) the general color. In view of these points of resemblance, it is scarcely probable that, when the defendant designed this label, he did not have in his mind the distinct purpose of making as close an imitation of the plaintiffs' label as he felt it safe to do. Now, as he admits in his testimony that, since he adopted this label, his trade has increased, and does not state any facts which lead to the inference that this increase has been due to any other cause than his success in making this colorable imitation of the plaintiffs' label, we think it a fair conclusion that he had the purpose in view of banking, so to speak, on the plaintiffs' reputation, and that he has measurably succeeded in so doing. We do not think that the printing of the words, 'Not Old Coon,' upon the defendant's label, affords a sufficient reparation of the wrong."²¹¹

§ 284. **Simmons' Liver Medicine Case.**

Where it appeared that the defendant put on the market

²¹¹ McCann v. Anthony (1886) 21 Mo. App. 83.

packages of medicine labeled "Dr. Simmons Liver Medicine," in packages so substantially similar to those in which the complainant's "Simmons Liver Medicine" had been previously sold as to deceive the public, and that this was done with the purpose of selling it in the place of the complainant's medicine, the latter was granted an injunction to restrain the use of such labels and packages by defendant.²¹²

§ 285. **Awl Package Case.**

A manufacturer put up awls in a distinctive package, consisting of a bronze colored box, having a brown label on the top and one side with printed inscriptions, and tied with an orange string. Ten years after he began the use of this package, which use, although small at first, had increased largely during the last two years, another manufacturer of awls began the use of a package indistinguishable in every particular, even to the words of the inscription and the size and shape of the type, except that at the bottom, in letters and arrangement as nearly like the plaintiff's as possible, instead of "Manufactured and Warranted by the New England Awl & Needle Co.," in a certain town, the label read, "Manufactured for the United States Awl & Needle Co.," in a certain city. It was held that plaintiff was entitled to an injunction.²¹³

²¹² C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84, 23 S. W. 165.

²¹³ New England Awl & Needle Co. v. Marlborough Awl & Needle Co. (1897) 168 Mass. 154. The court said: "The principles upon which the rights of the parties are to be determined are similar to those which are well known to govern trade-marks, although the combination of elements is more complex than in devices which commonly go by that name. Hildreth v. D. S. McDonald Co. (1895) 164 Mass. 16; Chadwick v. Covell (1896) 151 Mass. 190, 194; Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598, 604; McLean v. Fleming (1877) 96 U. S. 245, 253, 254; Taend- (500)

sticksfabriks Aktiebolaget Vulcan v. Myers (1893) 139 N. Y. 364; Hall v. Barrows (1863) 4 De Gex, J. & S. 150, 159; Singer Machine Mfrs. v. Wilson (1877) 3 App. Cas. 376, 389; Turton v. Turton (1889) 42 Ch. Div. 128, 141; Kerly, Trade Marks, 13-15. The report states that it did not appear whether or not any purchaser of awls had learned to recognize the plaintiff's awls by the appearance of the packages. This cannot mean more than that there was no direct testimony to that effect. But the fact that the plaintiff had used the combination since 1885, and largely since 1893, is enough to raise a presumption in its favor. McAndrew v. Bassett (1864) 4 De Gex, J. & S. 380, 384, 385. * * * The plaintiff did not claim the exclusive right to brown labels for awls, but it claimed the exclusive use of the brown color in the combination which we have described. If the only other element besides the color had been a box of a certain size and a label of a certain shape, the case might be different (Enoch Morgan's Sons Co. v. Troxell [1882] 89 N. Y. 292), but when there is added an inscription which, both in its pictorial aspect of black marks, and in its meaning, was calculated to confuse, if not to deceive, the plaintiff's claim seems to us moderate (Frese v. Bachof [1878] 14 Blatchf. 432, Fed. Cas. No. 5,110; Sawyer v. Horn [1880] 4 Hughes, 239, 253, 1 Fed. 24; Carbolie Soap Co. v. Thompson [1885] 25 Fed. 625; Jennings v. Johnson [1889] 37 Fed. 364; Wellman & Dwire Tobacco Co. v. Ware Tobacco Works [1891] 46 Fed. 289; N. K. Fairbank Co. v. R. W. Bell Mfg. Co. [1896] 23 C. C. A. 554, 77 Fed. 867)."

CHAPTER XI.

COURTS AND PARTIES.

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

§ 286. Jurisdiction of United States Courts.

The United States courts have jurisdiction of suits brought for the infringement of trade-marks registered under the laws of the United States, irrespective of the amount in controversy, and irrespective of the citizenship of the parties, where the mark claimed to be an infringement is used by the defendant upon goods intended to be transported to a foreign country,¹ and suit is brought upon the trade-mark as a registered trade-mark. The proprietor of a registered trade-mark may ignore his registration, and sue upon his mark as a common-law trade-mark, in which case a United States court will not have jurisdiction unless the requisite diversity of citizenship exists. In all other cases involving trade-marks, in all cases involving trade-names, and in all cases to restrain unfair competition, the United States courts have jurisdiction concurrently with the courts of the several states, provided the amount in controversy exceeds \$2,000 in value, and provided, also, the controversy is between citizens of different states, or between citizens of a state and foreign states, citizens, or subjects.² Unless the

¹ 21 Stat. 502 (March 3, 1881); *Luyties v. Hollender* (1884) 21 Fed. 281; *Schumacher v. Schwencke* (1886) 26 Fed. 818.

² 24 U. S. Stat. 552 (March 3, 1887); 25 U. S. Stat. 434 (Aug. 13, (502)

complainant's trade-mark is used on goods intended to be transported to a foreign country, a United States court can take no cognizance of the wrong in a suit between citizens of the same state. If it is so used, the court will not be concluded by the result of an inquiry whether it is used with an intent to mislead purchasers in the country where the goods are to be ultimately sold, because the goods may be sold in this country or in some country other than the one where they are to be ultimately sold, and the act of congress contemplates a complete protection to the right which it creates.³

When complainant and defendant are citizens of the same state, a federal court can take jurisdiction only of the question whether the registered trade-mark declared upon is valid and has been infringed. If there is no valid trade-mark, or if there has been no infringement, the suit must be dismissed, notwithstanding the fact that the complaint may disclose a cause of action based upon unfair competition.⁴ While it is the rule that, where a federal question is involved, a court is justified in adjudicating all questions growing out of the matter in controversy, if the trade-mark is invalid, or there is no infringement of a registered trade-mark, there is no federal question involved, even though the bill of complaint alleges infringement of a registered trade-mark. In determining the jurisdiction of the court, the amount in controversy is the value of the trade-mark to be protected, and not

1888); *Battle v. Finlay* (1892) 50 Fed. 106; *Hennessy v. Braunschweiger & Co.* (1898) 89 Fed. 664.

³ *Glen Cove Mfg. Co. v. Ludeling* (1885) 22 Fed. 823; *Graveley v. Graveley* (1890) 42 Fed. 265; *Ryder v. Holt* (1888) 128 U. S. 525; *Elgin Nat. Watch Case Co. v. Illinois Watch Case Co.* (1901) 179 U. S. 665; *Luyties v. Hollender* (1884) 21 Fed. 281, (1887) 30 Fed. 632; *Graveley v. Graveley* (1890) 42 Fed. 265; *Prince's Metallic Paint Co. v. Prince Mfg. Co.* (1892) 53 Fed. 493.

⁴ *Goldstein v. Whelan* (1894) 62 Fed. 124; *Burt v. Smith* (1895) 71 Fed. 161.

the amount of damages that have been sustained, or the amount of profits to be recovered.⁵

Actions in the United States courts, when the jurisdiction is founded upon a registered trade-mark, can be brought only in the district of which the defendant is an inhabitant.⁶ When the jurisdiction is founded on the fact that the parties are citizens of different states, the suit may be brought in the district of which either party is an inhabitant.⁷ If suit is brought in the district of which the plaintiff is an inhabitant, proper service on the defendant must be had, unless the defendant, by entering a general appearance in a suit brought against him in a district of which he is not an inhabitant, waives the right to object that it is brought in the wrong district.⁸ A suit against a corporation founded upon a trade-mark registered under the act of 1881 must be brought in the state in which the corporation is created.⁹ A suit against a corporation, where the jurisdiction is founded upon diversity of citizenship, can be brought in a state other than that in which it is incorporated by a person who is a resident of the district in which the suit is brought,¹⁰ but not by a person who is a nonresident of such district.

§ 287. Jurisdiction of State Courts.

The courts of the several states have jurisdiction in all

⁵ *Symonds v. Greene* (1886) 28 Fed. 834; *Hennessy v. Herrmann* (1898) 89 Fed. 669.

⁶ 24 U. S. Stat. 552 (March 3, 1887).

⁷ 25 U. S. Stat. 434 (Aug. 13, 1888).

⁸ 25 U. S. Stat. 434 (Aug. 13, 1888); *Interior Construction & Improvement Co. v. Gibney* (1895) 160 U. S. 217.

⁹ *In re Keasbey & Mattison Co.* (1895) 160 U. S. 221.

¹⁰ *In re Keasbey & Mattison Co.* (1895) 160 U. S. 221; *McCormick Harvesting Mach. Co. v. Walthers* (1890) 134 U. S. 41; *Shaw v. Quincy Min. Co.* (1892) 145 U. S. 444; *Southern Pac. Co. v. Denton* (1892) 146 U. S. 202.

cases involving trade-marks, trade-names, and unfair competition in business, except where a trade-mark registered under the United States laws is involved, and the suit is brought to enforce the rights secured by the United States statutes.¹¹

§ 288. Parties Plaintiff.

As a trade-mark may be acquired and held by any person, firm, or corporation, it follows that any person, firm, or corporation may be the plaintiff in an action to restrain the further infringement of a trade-mark, or to recover damages for its past infringement. The same rule applies as to parties plaintiff in cases involving trade-names or unfair competition. Where suit is brought in a United States court upon a registered trade-mark as such, the residence of the plaintiff is immaterial. He may be a resident of the same state as the defendant, and he may be either an alien or a citizen. An alien who has sold his goods and used his trade-mark in the United States enjoys all of the rights of a citizen, both as to common-law rights and under the registration statutes.¹² As said by Judge Wallace, of the United States circuit court: "The fact that complainant is an alien does not affect his right of property in a trade-mark; but that fact, as it establishes the requisite diversity of citizenship between the parties to confer jurisdiction upon this court, is indispensable to the cause of action alleged."¹³ A foreigner who has never introduced his goods or conducted

¹¹ *Small v. Sanders* (1889) 118 Ind. 105.

¹² *Davis v. Kennedy* (1867) 13 Grant Ch. (Can.) 523; *Taylor v. Carpenter* (1846) 2 Woodb. & M. 1, Fed. Cas. No. 13,785; *Taylor v. Carpenter* (1844) 3 Story, 458, Fed. Cas. No. 13,784; *Taylor v. Carpenter* (1844) 11 Paige (N. Y.) 292, 42 Am. Dec. 114, (1846) 2 Sandf. Ch. 603; *Collins Co. v. Reeves* (1858) 28 Law J. Ch. 56, 4 Jur. (N. S.) 865; *Collins Co. v. Brown* (1857) 3 Kay & J. 423, 3 Jur. (N. S.) 929, 29 Law T. 245.

¹³ *La Croix v. May* (1883) 15 Fed. 236.

trade in the United States or used his trade-mark rights in connection therewith, no matter how extensive his trade-mark rights or the extent of his trade abroad, has no trade-mark rights in the United States except so far as these rights may be secured by the international convention.¹⁴

In a case of unfair competition in business, where one person or corporation is entitled to relief, two or more persons or corporations, having a common interest in preventing the fraud, may unite to maintain a suit in equity.¹⁵ An injunction will not be issued to restrain infringement of a trade-mark on a bill to which an exclusive licensee is not a party.¹⁶ Where a distiller granted the sole and exclusive control of his bottled goods for a period of years, and agreed not to permit others to use his trade labels, a bill by the licensee to enjoin infringement of the trade-marks, which did not make the distiller a complainant, or state any reason for not doing so, was held defective.¹⁷

§ 289. Parties Defendant.

The manufacturer of an article bearing a spurious trade-mark, every one who sells the article, whether knowing of the infringement or not, and every one who contributes directly or indirectly to the infringement, as by printing the infringing labels, may be made a defendant in an action to restrain the infringement of a trade-mark.¹⁸ "Ordinarily the infringer cannot escape responsibility by showing that he was acting for another. In torts of misfeasance, like the violation of a trade-mark, agents and servants are personally liable to the injured party. All persons procuring or assisting in the

¹⁴ 26 Am. & Eng. Enc. Law (1st Ed.) 485.

¹⁵ Pillsbury-Washburn Flour Mills Co. v. Eagle (1898) 86 Fed. 608.

¹⁶ Wallach v. Wigmore (1898) 87 Fed. 469.

¹⁷ Krauss v. Joseph R. Peebles' Sons Co. (1893) 58 Fed. 585.

¹⁸ Low v. Hart (1882) 90 N. Y. 457; Coats v. Holbrook (1845) 2 Sandf. Ch. (N. Y.) 586.

commission of a trespass are principals in the transaction, and both the master who commands and the servant who does the act of trespass may be made responsible as principals, and may be sued jointly or severally for damages, as the injured party may elect. A joint action will lie against the principal and agent. If separate actions are brought against several joint trespassers, the plaintiff may proceed to judgment in all; and the judgment against one is not a bar to a trial and recovery against the others, although there can be but one satisfaction.¹⁹ Persons who ignorantly sell articles bearing the spurious trade-mark will usually not be protected by that fact against injunction. If, however, an innocent vendor ceases infringement at once, upon being notified, he will not be subjected to costs or damages.²⁰ The same rules apply in cases involving trade-names. In cases of unfair competition, an action will not lie against an innocent or ignorant vendor, as fraud lies at the foundation of the action, and a person who is an innocent infringer cannot be guilty of fraud. If, however, he continues to sell the article complained of after notice he is no longer an innocent vendor, but is to be considered as guilty of participating in the deception of the public, and may be restrained and subjected to an accounting and to costs.²¹

¹⁹ *Estes v. Worthington* (1887) 30 Fed. 465, citing *Maltby v. Bobo* (1876) 14 Blatchf. 53, Fed. Cas. No. 8,998; *Steiger v. Heidelberger* (1880) 4 Fed. 455; *Bell v. Josselyn* (1855) 3 Gray (Mass.) 309; *Richardson v. Kimball* (1849) 28 Me. 463; *Mitchell v. Harmony* (1851) 13 How. (U. S.) 115; *Phelps v. Wait* (1864) 30 N. Y. 78; *Lightner v. Brooks* (1864) 2 Cliff. 287, Fed. Cas. No. 8,344; *Wright v. Wilcox* (1838) 19 Wend. (N. Y.) 343; *Livingston v. Bishop* (1806) 1 Johns. (N. Y.) 289.

²⁰ *Moet v. Couston* (1864) 10 Law T. (N. S.) 395.

²¹ *Carson v. Ury* (1889) 39 Fed. 777; *De Kuyper v. Witteman* (1885) 23 Fed. 871; *People v. Molins* (1888) 7 N. Y. Cr. R. 51, 10 N. Y. Supp. 130; *Colman v. Crump* (1877) 70 N. Y. 573; *Farina v. Silverlock* (1855) 1 Kay & J. 509, 3 Eq. Rep. 883, 24 Law J. Ch. 632, Cox, Man. Trademark Cas. 130.

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.

§ 290. Introductory.

In cases involving trade-marks, trade-names, and unfair competition in business, the pleadings and practice are practically the same as in other cases of tort. The equitable action is usually resorted to. In the federal courts this action is still distinct in form, and the pleadings are governed by special rules. In nearly all of the states but a single form of action is now allowed, although the difference between actions that are equitable in their nature and those that are purely legal is recognized.¹ As an injunction is

¹ In *Bonesteel v. Bonesteel* (1871) 28 Wis. 245, 250, Lyon, J.:
"There are certain essential and inherent distinctions between ac-
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the most efficacious remedy for infringement of trade-mark rights, and as this can only be obtained in an equitable action, this character of action is generally employed where it is desired to prohibit the continuance of the infringement.

§ 291. Bill in Equity.

In the federal courts, the form of the bill in equity is prescribed by the equity rules.² The essential parts of the

tions at law and in equity, to abolish which is beyond the power of legislative enactment. The legislature may abolish the old forms of actions, and has done so, but the essential principles of equitable actions and equitable relief, as distinguished from legal actions and remedies, are as vital now, and as clearly marked and defined, as before the enactment of the Code. They are indestructible elements in our system of jurisprudence, and the courts are constantly required to recognize and apply them."

In *Stevens v. City of New York* (1881) 84 N. Y. 296, 304, Danforth, J.: "The names of actions no longer exist, but we retain in fact the action at law and the suit in equity. The pleader need not declare that his complaint is in either. It is only necessary that it should contain facts constituting a cause of action, and, if these facts are such as, at the common-law, his client would have been entitled to judgment, he will, under the Code, obtain it. If, on the other hand, they establish a title to some equitable interposition or aid from the court, it will be given by judgment in the same manner as it would formerly have been granted by decree."

In *White v. Lyons* (1871) 42 Cal. 279, 282, Crockett, J.: "Under the Code there is but one form of action in this state, and, if the complaint states facts which entitle the plaintiff to relief, either legal or equitable, it is not demurrable on the ground that it does not state facts sufficient to constitute a cause of action. If the facts stated are such as address themselves to the equity side of the court, the appropriate relief will be granted by the court, sitting as a court of equity. On the other hand, if the facts alleged are purely cognizable in a court of law, the proper relief will be administered in that form of proceeding. But a complaint which states a sufficient cause of action, either at law or in equity, is not demurrable as not stating facts sufficient to constitute a cause of action." See, also, *Guernsey v. American Ins. Co.* (1871) 17 Minn. 104 (Gil. 83); *Erie Ry. Co. v. Ramsey* (1871) 45 N. Y. 637.

² Equity Rules xx-xxv.

bill are: (1) The address; (2) the introduction; (3) the stating part; (4) the prayer for relief; (5) the prayer for process. Formerly it was customary to include the confederating part, the charging part, the jurisdictional clause, and the interrogatory part. The confederating part and the charging part are now seldom used. Their use is made optional in the federal courts.³ The jurisdictional clause is unnecessary, for, if the case made is not of equitable jurisdiction, the bill will be dismissed, notwithstanding it contains an averment that the acts complained of are contrary to equity, and tend to the injury of the complainant, and that he has no adequate remedy at law.⁴ The stating part of the bill is the most important. It must set forth all of the facts essential to the complainant's case. It should set forth nothing more. It must be carefully framed, so as to state fully and accurately every material fact.⁵

There are a few special requirements in cases involving trade-marks, trade-names, and unfair competition. The value of the trade-mark or right invaded must be stated to be not less than \$2,000, if the action is brought upon a common-law trade-mark in a United States circuit court.⁶ The amount in controversy is the value of the trade-mark, trade-name, or the right infringed, and not the amount of damage suffered by the complainant.⁷ Where suit is brought to restrain the infringement of a registered trade-mark, if both parties reside in the same state, the bill must allege that the complainant uses the trade-mark in commerce with foreign nations or Indian tribes,⁸ and that the defend-

³ Equity Rule xvi.

⁴ Equity Rule xxi; Story, Eq. Pl. (10th Ed.) § 34.

⁵ Story, Eq. Pl. (10th Ed.) §§ 27, 28.

⁶ 24 U. S. Stat. 552 (March 3, 1887).

⁷ Symonds v. Greene (1886) 28 Fed. 834.

⁸ Ryder v. Holt (1888) 128 U. S. 525.

ant has applied the trade-mark to goods intended for commerce with foreign nations or Indian tribes.⁹ The complainant's trade-mark, wrapper, or label must be accurately described, and, whenever possible, a *fac simile* should be attached to the bill as an exhibit. In cases of unfair competition, the facts relied upon as constituting unfair competition should be fully set forth, and it should be averred that the acts complained of have been done fraudulently, and with intent to palm off upon the public the defendant's goods as and for those of the complainant.¹⁰ It is not sufficient to allege in a bill for an injunction that irreparable injury or damage will result to the complainant by the acts or threats of the defendant, but such facts must be set forth as will enable the court to determine for itself from the facts whether that result will follow or is likely to follow.¹¹ A bill in equity to restrain the doing of certain acts, which does not allege that the defendant was continuing to do such acts when the bill was filed, shows no ground for an injunction.¹² And a bill for infringement of a trade-mark cannot be sustained as a bill to restrain unfair competition, when it does not allege that defendants have attempted or intend to practice any deceit for the purpose of selling defendant's goods as the goods of complainant.¹³

§ 292. Answer in Equity.

It is an elementary rule of equity pleading that he who submits to answer must answer fully. He must admit or deny all the facts stated in the bill, with all their material

⁹ *Graveley v. Graveley* (1890) 42 Fed. 265.

¹⁰ *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537.

¹¹ *Chicago City Ry. Co. v. General Electric Co.* (1898) 74 Ill. App. 465.

¹² *Holbrook v. Nesbitt* (1895) 163 Mass. 120.

¹³ *Lamont v. Leedy* (1898) 88 Fed. 72.

circumstances, without any special interrogatory for that purpose.¹⁴

In the following chapter, the defenses that may be made to an action involving a trade-mark, trade-name, or unfair competition in business are discussed. Any of these defenses may be made in an answer to a bill in equity. If suit is brought on a trade-mark registered under the United States statute, defendant may plead that complainant is not using the mark in commerce with foreign nations or Indian tribes, or that defendant is not applying the mark to goods intended for use in such commerce.¹⁵ These allegations are especially important when complainant and defendant are both citizens of the same state. For the purpose of avoiding costs, defendant may allege that, when notified of the infringement, he immediately ceased using the infringing mark. This defense will not usually avoid an injunction, but, if established by the proofs, it may compel the complainant to pay the costs of the suit, which may be an important consideration.¹⁶ The defense of laches may also be insufficient to prevent an injunction, although it may avoid the necessity of an accounting, or the payment of costs by the defendant.¹⁷ As, in an action to restrain unfair competition, it is not necessary for the complainant to show an exclusive right to the marks, labels, or dress of the packages alleged to have been imitated by the defendant, the essential allegations of the answer are denials of any acts constituting a palming off, or an attempted palming off, of defendant's goods as those of the complainant. Facts tending to show that defendant is selling his goods on his own reputation should be fully stated, due

¹⁴ Story, Eq. Pl. (10th Ed.) § 852.

¹⁵ Rev. St. U. S. § 4937.

¹⁶ Bass, Ratcliff & Gretton v. Guggenheimer (1895) 69 Fed. 271.

¹⁷ McLean v. Fleming (1877) 96 U. S. 245; Menendez v. Holt (1888) 128 U. S. 514.

regard being had to the rule that evidence need not be pleaded.

§ 293. Plea in Equity.

It being provided by the equity rules that "the defendant shall be entitled in all cases, by answer, to insist upon all matters of defense (not being matters of abatement, or to the character of the parties, or matters of form) in bar of or to the merits of the bill, of which he may be entitled to avail himself by a plea in bar,"¹⁸ the plea in equity has generally fallen into disuse. It may still be used to set up "a defense which reduces the cause, or some part of it, to a single point."¹⁹ Under the equity rules, no plea is allowed to be filed to any bill unless upon certificate of counsel that, in his opinion, it is well founded in point of law, supported by the affidavit of the defendant that it is not interposed for delay, and that it is true in point of fact.²⁰

¹⁸ Equity Rule xxxix.

¹⁹ Beach, Eq. Pr. § 293.

²⁰ Equity Rule xxxi.

Hostetter Co. v. E. G. Lyons Co. (1900) 99 Fed. 734, Morrow, J.: "The office of a plea, in equity practice, is to present a single issue of fact as a defense, which operates as a bar to the complainant's right of recovery. A demurrer, on the other hand, raises a question of law, and is directed to the sufficiency of the complaint. It is manifest that these two defenses cannot be combined in one pleading, and this is the fatal objection to the present plea. It presents two separate and distinct defenses; the first being that the bill of complaint is inadequate and insufficient to entitle the complainant to relief, in that it does not appear from the bill that the complainant has the exclusive right to the trade-name of 'Hostetter's Bitters.' If this objection is well founded, it discloses a defect in complainant's case as stated in the bill, but this objection is one that cannot be raised by a plea. A defect upon the face of a bill is to be met, not by a plea, but by a demurrer. In *Farley v. Kittson* (1887) 120 U. S. 303, 314, 7 Sup. Ct. 534, 30 L. Ed. 684, the court said: 'But the proper office of a plea is not, like an answer, to meet

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§ 294. Demurrer in Equity.

As a demurrer to a bill in equity admits all facts which are well pleaded in the bill to be true, it follows that such pleading can be used with safety by a defendant only in case the complainant alleges that the defendant has used or colorably imitated the complainant's trade-mark, without alleging fraud or any intention to deceive in the use of the mark.²¹ If the bill alleges fraud or an intention to deceive in the use of the mark, a demurrer admitting such allegations will admit the essence of the complaint, and, where fraud and an intention to deceive are admitted, but slight imitation of the complainant's mark will be required to sustain the action.²²

§ 295. Declaration or Complaint at Law.

If an action at law is brought in a federal court against all the allegations of a bill, nor, like a demurrer admitting those allegations, to deny the equity of the bill; but it is to present some distinct fact which of itself creates a bar to the suit, or to the part to which the plea applies, and thus to avoid the necessity of making the discovery asked for, and the expense of going into the evidence at large. Mitford, Eq. Pl. (4th Ed.) 14, 219, 295; Story, Eq. Pl. pars. 649, 652.' It is very certain that a question of law as to the sufficiency of the bill cannot be raised by a plea, and that the first defense set up by respondent cannot be maintained as a plea in bar."

²¹ Collins Chemical & Mfg. Co. v. Capitol City Mfg. Co. (1890) 42 Fed. 64; Desmond's Appeal (1883) 103 Pa. 126.

²² Enoch Morgan's Sons Co. v. Hunkele (1879) 16 O. G. 1092, Fed. Cas. No. 4,493; Leidersdorf v. Flint (1880) 50 Wis. 401; Mrs. G. B. Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18; Plant Seed Co. v. Michel Plant & Seed Co. (1886) 23 Mo. App. 579; El Modello Cigar Mfg. Co. v. Gato (1889) 25 Fla. 886; Merriam v. Holloway Pub. Co. (1890) 43 Fed. 450; Thedford Medicine Co. v. Curry (1895) 96 Ga. 89; Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651; Block v. Standard Distilling & Distributing Co. (1899) 95 Fed. 978; La Croix v. May (1883) 15 Fed. 236; Ellis v. Zeilin (1871) 42 Ga. 91; Barrows v. Knight (1860) 6 R. I. 434; Putnam Nail Co. v. Bennett (1890) 43 Fed. 800.

an alleged infringer of a registered trade-mark, and the registration is relied upon to give the court jurisdiction, the form of action must be that prescribed by the act of congress of March 3, 1881,—trespass on the case.²³ If, however, the parties are citizens of different states, and the mark is claimed as a common-law trade-mark, and a suit at law is brought upon it as such, the practice and pleadings should conform, as near as may be, to the practice and pleadings existing at the time in like causes in the courts of record of the state within which the court is held.²⁴

In a declaration upon a registered trade-mark, or a complaint upon a common-law trade-mark, as in a bill in equity, all the facts relied upon to give the court jurisdiction must be pleaded.²⁵ If the action is upon a registered trade-mark, it must be alleged in the declaration (if the parties are citizens of the same state) that both complainant and defendant use the mark upon goods, wares, or merchandise intended for commerce with foreign nations or the Indian tribes.²⁶ If the action is based upon a common-law trade-mark, and diversity of citizenship is relied upon to give the court jurisdiction, the complaint must allege the value of the trade-mark to be not less than \$2,000.²⁷ Damages only can be recovered in an action at law, and hence a basis for such recovery must be laid in the declaration or complaint, by alleging an injury to plaintiff resulting from the infringement.²⁸

²³ Act March 3, 1881 (21 Stat. 502, § 7).

²⁴ Rev. St. U. S. § 914.

²⁵ *Symonds v. Greene* (1886) 28 Fed. 834; *Glottin v. Oswald* (1894) 65 Fed. 151; *Hennessy v. Herrmann* (1898) 89 Fed. 669.

²⁶ *Luyties v. Hollender* (1884) 22 Blatchf. 413, 21 Fed. 281; *Schumacher v. Schwencke* (1886) 26 Fed. 818; *Ryder v. Holt* (1888) 128 U. S. 525; *Graveley v. Graveley* (1890) 42 Fed. 265; *Prince's Metallic Paint Co. v. Prince Mfg. Co.* (1892) 53 Fed. 493.

²⁷ *Symonds v. Greene* (1886) 28 Fed. 834.

²⁸ *Singer Mfg. Co. v. Loog* (1882) 8 App. Cas. 15.

It must also be alleged that the infringement was committed with a fraudulent intention.²⁹

§ 296. **Answer at Law.**

The answer in an action at law in a federal court must state all the material facts necessary to constitute the defense to the action. The common-law form of answer in an action of trespass on the case should be employed when the action is based upon a registered trade-mark, and this form of action is resorted to by the plaintiff.³⁰ The form of answer employed in the pleadings in courts of record of the state in which the court is held should be used when the action is based upon a common-law trade-mark, and the complaint conforms to complaints used in like causes in the state courts.³¹

§ 297. **Demurrer at Law.**

As it is necessary, in an action at law, to aver that the infringement was committed willfully and with fraudulent intent on the part of the defendant, a demurrer in such an action, where the declaration or complaint is properly drawn, cannot safely be resorted to, as it admits the fraudulent intent upon the part of the defendant, and, with such an admission, a slight resemblance between the marks will be sufficient to entitle the plaintiff to judgment.³²

²⁹ *Blanchard v. Hill* (1742) 2 Atk. 484, Cox, Man. Trademark Cas. 2; *Singleton v. Bolton* (1783) 3 Doug. 293, Cox, Man. Trademark Cas. 4; *Crawshay v. Thompson* (1842) 4 Man. & G. 357, 11 Law J. C. P. 301, Cox, Man. Trademark Cas. 72; *Rodgers v. Nowill* (1847) 17 Law J. C. P. 52, Cox, Man. Trademark Cas. 82; *Edelsten v. Edelsten* (1863) 7 Law T. (N. S.) 768, 1 De Gex, J. & S. 185, Cox, Man. Trademark Cas. 213.

³⁰ Act March 3, 1881 (21 Stat. 502, § 7).

³¹ Rev. St. U. S. § 914.

³² *Theford Medicine Co. v. Curry* (1895) 96 Ga. 89; Mrs. G. B. (516)

§ 298. Pleadings in the State Courts.

Many suits involving common-law trade-marks, trade names, or acts constituting unfair competition in business are prosecuted in the state courts. In such actions the pleadings are governed by the state statutes. A discussion of the pleadings in such actions is not within the scope of this work. An examination of the foregoing sections relating to pleadings in the federal courts will, however, assist the practitioner in framing the pleadings in actions in the state courts, the material allegations in pleadings in both courts being the same, except in actions involving registered trademarks.

§ 299. Joinder of Causes of Actions.

A cause of action for infringement of a patent, and a cause of action for infringement of a trade-mark, may be joined in a single action, where the trade-mark and the patent were both infringed together.³³ Causes of action arising from infringement of a trade-mark and a trade-name may be joined,³⁴ or either or both of these may be joined with a cause of action arising from acts constituting unfair competition in business,³⁵ where the infringements arise from the same acts on the part of the defendant. Where a bill in equity is filed to enjoin the infringement of a technical trade-mark or trade-name, and also to enjoin unfair competition, if the complainant fails to establish his right to the trade-mark or trade-name, the bill may be maintained

Miller & Co. Tobacco Manufactory v. Commerce (1883) 45 N. J. Law, 18.

³³ Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co. (1894) 60 Fed. 622.

³⁴ Celluloid Mfg. Co. v. Cellonite Mfg. Co. (1887) 32 Fed. 94.

³⁵ Dennison Mfg. Co. v. Thomas Mfg. Co. (1899) 94 Fed. 651.

for the purpose of prohibiting the unfair competition.³⁶ It is therefore advisable to include, wherever possible, in the complaint in any trade-mark or trade-name action, allegations of unfair competition.

§ 300. Multifariousness.

To sustain the objection of multifariousness, the matters sought to be joined must be of such distinct natures, or the forms of proceeding in relation to such several matters must be so distinct, that it would be improper, or very inconvenient, to litigate the same in one suit.³⁷ A bill of complaint setting up a claim for damages under the anti-trust law of July 2, 1890, and also asking for an injunction restraining the defendant from using the complainant's trade-mark and trade-name, is multifarious, as joining two distinct causes of action, having no connection with each other, and the action for damages is triable at law, while the action for an injunction is of equitable cognizance.³⁸

§ 301. Preliminary Injunctions—Granted.

It has been said that "the purpose of a preliminary injunction is to prevent irremediable injury to some of the parties to the suit during its pendency, and before their claims can be investigated and adjudicated. The burden is on the moving party to show that such an injury is threatened, and will probably be inflicted, before the case can be finally decided, unless the injunction issues. The granting or withholding such a temporary injunction rests largely in the sound judicial discretion of the court, and much latitude is,

³⁶ *City of Carlsbad v. Tibbetts* (1892) 51 Fed. 852.

³⁷ *Newland v. Rogers* (1848) 3 Barb. Ch. (N. Y.) 432; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (1899) 94 Fed. 651.

³⁸ *Block v. Standard Distilling & Distributing Co.* (1899) 95 Fed. 978.

and ought to be, allowed for the exercise of that discretion, in view of the fact that the personal acquaintance with and observation of the parties at the hearing which the trial court enjoys are of great assistance in reaching a just conclusion.³⁹ There are many considerations that may be conclusive without reference to the merits of the question at issue.⁴⁰ In an action upon a trade-mark or trade-name, the plaintiff must show, in order to entitle him to a preliminary injunction, that he is the owner of the trade-mark or trade-name, and is entitled to its exclusive use.⁴¹ The right to the injunction must be clearly established by the evidence.⁴² In a trade-mark or trade-name case the intention of the defendant is not material.⁴³ Even though the infringement be honest and innocent, equity will, in a clear case, restrain its continuance, unless there are special circumstances which take the case out of the general rule.⁴⁴ Nor is it necessary to show that actual damage or loss has accrued to the plaintiff.⁴⁵ Where the court sees that the plaintiff's trade-marks are simulated in such manner as to deceive his customers or

³⁹ *Centaur Co. v. Marshall* (1899) 38 C. C. A. 413, 97 Fed. 785. See, also, *Gebbie v. Stitt* (1894) 82 Hun (N. Y.) 93; *Whitley Grocery Co. v. McCaw Mfg. Co.* (1898) 105 Ga. 839.

⁴⁰ *Garrett v. T. H. Garrett & Co.* (1896) 24 C. C. A. 173, 78 Fed. 472.

⁴¹ *Rorke v. Societe des Huiles d'Olive de Nice* (1897) 14 App. Div. (N. Y.) 173.

⁴² *Ball v. Siegel* (1886) 116 Ill. 137; *Coffeen v. Brunton* (1851) 5 McLean, 256, Fed. Cas. No. 2,947; *Ellis v. Zeilin* (1871) 42 Ga. 91; *McLoughlin v. Singer* (1898) 33 App. Div. (N. Y.) 185; *Hagen v. Beth* (1897) 118 Cal. 330; *Postal Tel. Cable Co. v. Netter* (1900) 102 Fed. 691.

⁴³ *Clinton Metallic Paint Co. v. New York Metallic Paint Co.* (1898) 23 Misc. Rep. (N. Y.) 66.

⁴⁴ *G. G. White Co. v. Miller* (1892) 50 Fed. 277.

⁴⁵ *Reeves v. Denicke* (1871) 12 Abb. Pr. (N. S.; N. Y.) 92.

the patrons of his trade or business, the piracy will be checked at once by injunction.⁴⁶

Any evasion on the part of a defendant in responding to the charges of the bill, or any extreme improbability in the statement of the defendant, will be an inducement to the court to grant or retain an injunction.⁴⁷ Upon a motion for an injunction the court will hear affidavits of both parties, and consider the answer of the defendant an affidavit.⁴⁸ A preliminary injunction, when granted, is always until answer or until further order of the court.⁴⁹ It has been held that an injunctive order forbidding the use of certain words on a medicine bottle label equally forbids use of those words in a certificate attached to the bottle.⁵⁰

Circumstances that strongly appeal to a court of equity in passing upon a motion for a preliminary injunction are found in those cases where the plaintiff has an established trade under the mark or name in question, and the defendant has recently begun the use of the mark or name, and can have acquired no established trade thereunder. As said by Cotton, L. J., in a leading English case:⁵¹ "As to the question of convenience or inconvenience in granting the injunction, I

⁴⁶ Partridge v. Menck (1847) 2 Sandf. Ch. (N. Y.) 622. See, also, Price Baking Powder Co. v. Fyfe (1891) 45 Fed. 799; Symonds v. Greene (1886) 28 Fed. 834; Hill v. Lockwood (1885) 62 Wis. 507; Robertson v. Berry (1879) 50 Md. 591; Enoch Morgan's Sons' Co. v. Hunkele (1879) 16 Off. Gaz. 1092, Fed. Cas. No. 4,493, Price & S. Amer. Trade Mark Cas. No. 31; Frese v. Bachof (1876) 13 Blatchf. 234, Fed. Cas. No. 5,109; Lee v. Haley (1869) 5 Ch. App. 155.

⁴⁷ American Grocer Pub. Ass'n v. Grocer Pub. Co. (1876) 51 How. Pr. (N. Y.) 402.

⁴⁸ Gillis v. Hall (1870) 7 Phila. (Pa.) 422.

⁴⁹ White v. Schlect (1880) 14 Phila. (Pa.) 88; Walton v. Crowley (1856) 3 Blatchf. 440, Fed. Cas. No. 17,133.

⁵⁰ Alexander v. Morse (1883) 14 R. I. 153.

⁵¹ Read v. Richardson (1881) 45 Law T. (N. S.) 54.

have no hesitation in coming to the conclusion that, if there is a *prima facie* case made out by the plaintiffs, although it is not as fully made out as it possibly might have been, we ought to grant the injunction. The plaintiffs, in obtaining an injunction upon an interlocutory application, must give an undertaking as to damages. If there is no injunction granted, and they are in the right, the trade-name, which they say is valuable to them, and which they come to protect, will be absolutely gone before they can ascertain their rights. * * * Therefore, if the plaintiffs have made out a *prima facie* case, the strong balance of convenience and inconvenience is in favor of granting the injunction." And the same principle is recognized in a case decided in the United States circuit court for the Eastern district of Pennsylvania, in which Judge Butler said:⁵² "He [defendant] knew it to be the recognized designation of the plaintiff's tobacco, which had become popular with consumers and the trade. Did he not expect the public to be influenced thereby, and his business increased? An affirmative answer cannot well be avoided. If he did not, however, the injunction will do him no harm, for he has not yet had time to establish a reputation of his own under this name."

While, in considering a motion for a preliminary injunction in a trade-mark or trade-name case, the intention of the defendant in using the infringing mark or name is not material, the intention of the defendant is material in considering a motion for such an injunction in a case of unfair competition. As "relief in such cases is granted only where the defendant, by his marks, signs, labels, or in other ways, represents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacture, to the in-

⁵² Carroll v. Ertheiler (1880) 1 Fed. 688.

jury of the plaintiff,"⁵³ and as "the deceitful representation or perfidious dealing must be made out or be clearly inferable from the circumstances,"⁵⁴ it follows that the intention of the defendant in cases of unfair competition is of the very essence of the action, and of the right to a preliminary injunction. In such cases a fraudulent intention must be made out, or such facts must be shown as will compel the court to infer such intention. And it is sufficient to justify the interference by injunction by a court of equity to show that there is a fraudulent intention on the part of the defendant to palm off his goods as those of the plaintiff, and that such intention is being carried into execution.⁵⁵

The purpose to be effected by an injunction is not primarily to protect the purchaser, but to secure to the manufacturer the profit to be derived from the sale of his goods to all who may desire and intend to purchase them.⁵⁶ Where it appears that the party infringing a trade-mark intends to continue the wrong, an injunction against such continuance is the sole adequate remedy.⁵⁷

§ 302. Preliminary Injunction—Refused.

In cases involving trade-marks, trade-names, and unfair competition, it is by no means of course to grant preliminary injunctions.⁵⁸ Where it is doubtful whether the complaint

⁵³ *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.* (1888) 128 U. S. 598.

⁵⁴ *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537.

⁵⁵ *Enoch Morgan's Sons' Co. v. Troxell* (1881) 23 Hun (N. Y.) 632.

⁵⁶ *Williams v. Brooks* (1882) 50 Conn. 278.

⁵⁷ *Bradley v. Norton* (1865) 33 Conn. 157.

⁵⁸ *Fairbanks v. Jacobus* (1877) 14 Blatchf. 337, Fed. Cas. No. 4,608.

shows a cause of action,⁵⁹ or whether what has been done by the defendant amounts to an unlawful representation, an injunction will be refused.⁶⁰ The practice is not to grant injunctions in actions of this kind except in very clear cases.⁶¹ The purpose of an injunction is to protect the plaintiff in the exercise of a clear legal right, for the infringement of which the law does not afford an adequate remedy. If, therefore, the right of the plaintiff is doubtful, equity will withhold its aid.⁶² Courts of equity have always recognized

⁵⁹ *Selchow v. Baker* (1883) 93 N. Y. 59; *McHenry v. Jewett* (1882) 90 N. Y. 58; *Stirling Silk Mfg. Co. v. Sterling Silk Co.* (1900) 59 N. J. Eq. 394.

⁶⁰ *Green v. Rooke* (1872) 7 Law J. Notes Cas. 54; *Brown v. Doscher* (1892) 66 Hun, 626, 20 N. Y. Supp. 900.

⁶¹ *McLoughlin v. Singer* (1898) 33 App. Div. (N. Y.) 185; *Fetridge v. Wells* (1857) 4 Abb. Pr. (N. Y.) 144; *Fetridge v. Merchant* (1857) 4 Abb. Pr. (N. Y.) 156; *Merrimack Mfg. Co. v. Garner* (1855) 2 Abb. Pr. (N. Y.) 318, 4 E. D. Smith, 387; *Samuel v. Berger* (1856) 4 Abb. Pr. (N. Y.) 88, 24 Barb. 163, 13 How. Pr. 342; *Partridge v. Menck* (1847) 2 Barb. Ch. (N. Y.) 101, affirmed 3 Denio, 610; *Seltzer v. Powell* (1871) 8 Phila. (Pa.) 296; *Hygeia Distilled Water Co. v. Hygeia Ice Co.* (1898) 70 Conn. 516; *W. J. Johnston Co. v. Electric Age Pub. Co.* (1891) 60 Hun, 578, 14 N. Y. Supp. 803; *Lies v. Daniel* (1887) 82 Ga. 272; *Foster v. Blood Balm Co.* (1887) 77 Ga. 216; *Hagen v. Beth* (1897) 118 Cal. 330.

⁶² *McVey v. Brendel* (1891) 144 Pa. 235; *New York Asbestos Mfg. Co. v. New York Fire Proof Covering Co.* (1899) 62 N. Y. Supp. 339; *Vitascope Co. v. United States Phonograph Co.* (1897) 83 Fed. 30; *Van Camp Packing Co. v. Cruikshanks Bros. Co.* (1898) 33 C. C. A. 280, 90 Fed. 814; *Spottiswoode v. Clark* (1846) 2 Sandf. Ch. (N. Y.) 628; *Wolfe v. Goulard* (1859) 18 How. Pr. (N. Y.) 64; *Witthaus v. Braun* (1875) 44 Md. 303; *American Grocer Pub. Ass'n v. Grocer Pub. Co.* (1876) 51 How. Pr. (N. Y.) 402; *Decker v. Decker* (1876) 52 How. Pr. (N. Y.) 218; *Marshall v. Pinkham* (1881) 52 Wis. 572; *Leclancha Battery Co. v. Western Electric Co.* (1884) 21 Fed. 538; *Portuondo v. Monne* (1886) 28 Fed. 16; *French v. Alter* (1896) 74 Fed. 788; *Davis v. Davis* (1886) 27 Fed. 490; *Celuloid Mfg. Co. v. Cellonite Mfg. Co.* (1887) 32 Fed. 94; *Charles*

the fact that the granting of a preliminary injunction is an exercise of a very far-reaching power, never to be exercised except in a case clearly demanding it.⁶³ As said by the United States circuit court of appeals for the Third circuit: "It is a wholesome doctrine that equity will restrain unfair competition in trade, but it should be applied with caution, lest, through possible misapplication, healthful and honorable competition be defeated."⁶⁴ And by the United States circuit court of appeals for the Seventh circuit: "An interlocutory injunction operates somewhat in the nature of judgment and execution before trial. Without question, it is at times an appropriate remedy in the prevention of great wrong, but to authorize its issuance there must exist a pressing necessity. The right to it must be clear, and the apprehended injury must be grievous, and, generally, where the injury may be measured in money, the alleged wrongdoer should be shown to be unable pecuniarily to respond."⁶⁵ Where defendants had abandoned the use of certain wrap-

E. Hires Co. v. Consumers' Co. (1900) 41 C. C. A. 71, 100 Fed. 809; *Goldstein v. Whelan* (1894) 62 Fed. 124.

In *Keasbey v. Brooklyn Chemical Works* (1891) 61 Hun, 627, 16 N. Y. Supp. 318, where the affidavits filed by plaintiff and defendant left in doubt the following questions, viz.: (1) Were the plaintiffs the originators of the manufactured article (a compound) to which the trade-mark was applied? (2) Was the trade-mark (two words) descriptive of the ingredients in the compound? (3) Was the dissimilarity between the bottles and labels of plaintiff and of defendant sufficient to prevent the public from buying the latter for the former,—it was held that a preliminary injunction was properly denied.

⁶³ *New York Asbestos Mfg. Co. v. Ambler Asbestos Air-Cell Covering Co.* (1900) 43 C. C. A. 46, 102 Fed. 890, affirming 99 Fed. 85.

⁶⁴ *Lare v. Harper* (1898) 30 C. C. A. 373, 86 Fed. 481.

⁶⁵ *American Cereal Co. v. Eli Pettijohn Cereal Co.* (1896) 22 C. C. A. 236, 76 Fed. 372, affirming 72 Fed. 903. See *Foster v. Blood Balm Co.* (1887) 77 Ga. 216.

pers before the hearing of a motion for a preliminary injunction, and, at the hearing, agreed in writing to cease using a certain advertisement, an injunction was refused,⁶⁶ and, upon appeal, this order was affirmed.⁶⁷ In an English case, where there was a conflict of testimony as to whether the defendants' goods were calculated to be mistaken for the plaintiff's, and the court was unable, from an inspection of the goods, to arrive at a satisfactory conclusion, it was held that the motion for a preliminary injunction should stand over to the hearing, the defendants being put on an undertaking to keep an account.⁶⁸

Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, apparently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a lawsuit, and delayed legal proceeding until his patience was exhausted.⁶⁹ When 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.⁷⁰

Where a temporary injunction was issued in favor of plaintiff, and afterwards dissolved as erroneously granted, it was held that the defendant, whose answer did not entitle him to

⁶⁶ *Centaur Co. v. Marshall* (1899) 92 Fed. 605.

⁶⁷ *Centaur Co. v. Marshall* (1899) 97 Fed. 785.

⁶⁸ *Mitchell v. Henry* (1880) 15 Ch. Div. 181. See *Goodyear Rubber Co. v. Day* (1884) 22 Fed. 44.

⁶⁹ *Bovill v. Crate* (1865) L. R. 1 Eq. 388; *C. O. Burns Co. v. W. F. Burns Co.* (1902) 118 Fed. 944.

⁷⁰ *Estes v. Worthington* (1885) 22 Fed. 822; *White v. Schlect* (1880) 14 Phila. (Pa.) 88.

affirmative relief, was entitled, as a matter of course, to the appointment of a referee to ascertain and report what damages he had sustained by reason of the issuing of the injunction.⁷¹

A complainant who had refused to acknowledge the rights of the original foreign proprietor of a trade-mark until he thought it would be more profitable to purchase his rights in this country, and thus obtain a monopoly, reserving the right to annul the contract at discretion, was refused a preliminary injunction against alleged infringers of the trade-mark, and was left to establish his rights at final hearing.⁷²

§ 303. Permanent Injunctions.

In cases involving trade-marks, injunctions will be granted when plaintiff establishes at the trial his exclusive right to the trade-mark in question, and it is shown that the defendant is using upon the same class of goods the same mark, or one so closely imitating it as to deceive, or to be calculated to deceive, purchasers, and cause them to mistake one article for the other.⁷³

A permanent injunction was granted in one case where it appeared that at the time suit was brought the defendant

⁷¹ *Glen & Hall Mfg. Co. v. Hall* (1871) 6 *Lans.* (N. Y.) 158.

⁷² *Estes v. Worthington* (1885) 22 *Fed.* 822.

⁷³ *Millington v. Fox* (1838) 3 *Mylne & C.* 338; *Johnston v. Ewing* (1882) 7 *App. Cas.* 219; *Read v. Richardson* (1881) 45 *Law T.* (N. S.) 54; *Siegert v. Findlater* (1878) 7 *Ch. Div.* 801; *Apollinaris Co. v. Norrish* (1875) 33 *Law T.* (N. S.) 242; *Ford v. Foster* (1872) 7 *Ch. App.* 611; *Seixo v. Provezende* (1866) 1 *Ch. App.* 192; *McLean v. Fleming* (1877) 96 *U. S.* 245; *Menendez v. Holt* (1888) 128 *U. S.* 514; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.* (1871) 45 *N. Y.* 291; *Rowley v. Houghton* (1868) 7 *Phila. (Pa.)* 39; *Smail v. Sanders* (1889) 118 *Ind.* 105; *Amoskeag Mfg. Co. v. Spear* (1849) 2 *Sandf.* (N. Y.) 608; *Cuervo v. Landauer* (1894) 63 *Fed.* 1003; *Manitowoc Pea-Packing Co. v. Numsen* (1899) 35 *C. C. A.* 267, 93 *Fed.* 196.

was infringing the right of the complainant to the exclusive use of the trade-marks, although at the time of the final hearing such practices had ceased, and although the defendant had promised a perpetual cessation of the infringement.⁷⁴ That the infringer of a trade-mark, on being notified of his infringement, told his customers to erase the trade-marks from their goods, and had since gone out of business, are not grounds for denying an injunction to the owner of the trade-mark, where every step of the suit for an injunction and an accounting has been contested by the infringer, and he has put the complainants to the expense of proving every fact necessary to establish their right and his infringement.⁷⁵ In cases involving trade-names, permanent injunctions will be granted where plaintiff establishes his exclusive right to the trade-name, and it is shown that defendant is using the same name, or one closely resembling it, so as to cause confusion between the business or business establishment of plaintiff and the business or business establishment of defendant.⁷⁶ Where plaintiff has no technical trade-mark or trade-name, a permanent injunction will be granted where the dress of goods, the wrappers, labels, packages, bottles, seals, signatures, and other *indicia*, or the names, signs, titles, or business methods used by the plaintiff, are so imitated as to enable a dishonest defendant to sell his goods as and for those of the plaintiff, or so as to induce the public to do business

⁷⁴ Clark Thread Co. v. William Clark Co. (1897) 55 N. J. Eq. 658.

⁷⁵ Hutchinson v. Blumberg (1892) 51 Fed. 829.

⁷⁶ Knott v. Morgan (1836) 2 Keen, 219; Myers v. Kalamazoo Buggy Co. (1884) 54 Mich. 223; Hendriks v. Montagu (1881) 17 Ch. Div. 638; Lee v. Haley (1869) 5 Ch. App. 155; New York Cab Co. v. Mooney (1884) 15 Abb. N. C. (N. Y.) 152; Tuerk Hydraulic Power Co. v. Tuerk (1895) 92 Hun (N. Y.) 65; Weinstock, Lubin & Co. v. Marks (1895) 109 Cal. 529; Cady v. Schultz (1895) 19 R. I. 193. See chapter 8, and cases there cited.

with the defendant in the belief that they are doing business with the plaintiff.⁷⁷

§ 304. **Violation of Injunction.**

Where an injunctive order served on a defendant is definite and peremptory, the defendant must obey it, or at once procure an alteration or dissolution of it. If he does neither, an attachment for contempt will issue against him.⁷⁸ An injunction forbidding the members of a partnership, charged with infringing a trade-mark, from preparing, putting up, selling, or offering for sale the article in question under the trade-mark in question, makes it a contempt for them to do these acts, not only in their own behalf, but as agents or servants of others, who attempt to carry on the infringing business.⁷⁹ An injunction forbidding the defendants and their "agents, servants," etc., from doing specified acts, binds the agents only while acting as such for the defendants, and not in their personal capacity after they have ceased to be defendants' agents or servants, or have become agents or servants of some one else.⁸⁰ Where an injunction prohibited defendants from affixing or applying certain words "to any plasters manufactured, sold, shipped, or supplied by them, or to the boxes in which the same are put up," it was held that defendants did not violate the injunction by using

⁷⁷ *Sawyer v. Horn* (1880) 4 Hughes, 239, 1 Fed. 24; *Farina v. Silverlock* (1855) 1 Kay & J. 509; *Singer Mfg. Co. v. June Mfg. Co.* (1896) 163 U. S. 169; *Vitascope Co. v. United States Phonograph Co.* (1897) 83 Fed. 30. The following are a few of the instances in which permanent injunctions were refused: *Lawrence Mfg. Co. v. Tennessee Mfg. Co.* (1891) 138 U. S. 537; *Brennan v. Emery-Bird-Thayer Dry-Goods Co.* (1900) 99 Fed. 971; *Stetson v. Brennen* (1897) 21 App. Div. (N. Y.) 552; *New Haven Patent Rolling Spring Bed Co. v. Farren* (1883) 51 Conn. 324.

⁷⁸ *McCardel v. Peck* (1864) 28 How. Pr. (N. Y.) 120.

⁷⁹ *Dadirrian v. Gullian* (1897) 79 Fed. 784.

⁸⁰ *Dadirrian v. Gullian* (1897) 79 Fed. 784.

the prohibited words in advertisements in newspapers, cards, circulars, catalogues,⁸¹ etc.

For the purpose of sustaining a motion to punish for a contempt in violating an injunction as to trade-marks, it should appear clearly that the ordinary mass of customers, paying that attention which such persons usually do in purchasing, would be easily deceived by the mark used by defendant.⁸²

§ 305. Parties—Who Entitled to Injunction.

Any one singly or two or more jointly of two or more persons or corporations having a common interest of the same quality or kind, though differing in degree, on proving fraud or irreparable injury, may maintain an action in equity to obtain the desired relief.⁸³

The fraudulent use of marks or labels for the purpose of deceiving the public will not be enjoined at the instance of one who does not show that he is himself the manufacturer or owner or dealer in the articles which are fraudulently represented by counterfeited labels to be his; hence the fact that persons are officers or members of an association which has adopted the label to show that the articles bearing it are manufactured by its members does not of itself entitle them to maintain a bill to enjoin the fraudulent use of such label. In a case in Massachusetts, the court, after stating the general rule and citing well-known cases, said: "We have no occasion to question this principle, or the authorities by which it has been sustained. It will be found that where, under such circumstances, an injunction has been granted or an action maintained, it has been at the instance of one who

⁸¹ *Porous Plaster Co. of Village of Sing Sing v. Seabury* (1888) 48 Hun, 620, 1 N. Y. Supp. 134.

⁸² *Swift v. Dey* (1865) 4 Rob. (N. Y.) 611.

⁸³ *Pillsbury-Washburn Flour Mills Co. v. Eagle* (1898) 30 C. C. A. 386, 86 Fed. 608, and cases there cited.

was himself a manufacturer, dealer in, or owner of the articles which were fraudulently represented by the counterfeited labels, wrappers, or advertisements to be his. In such case the fraud complained of would have a natural and inevitable tendency to lessen the sales, affect the reputation of the articles manufactured or dealt in, and injure the business of the complainant, and would thus afford him a ground for relief by reason of the special and peculiar damage which he would sustain, or to which he might be exposed. The plaintiffs show by their bill that they have a right to use the label in question, and that it is a valuable privilege; but although they aver that they have suffered loss by the use of it by the defendant, they do not show that any business which they pursue has been affected, or that they can have sustained any definite loss, or any injury except that which must be extremely remote and purely speculative."⁸⁴

In a recent case it was held that the only basis for a private suit for an injunction against unfair competition is injury to property rights of the complainant. The fact that the defendant deceives the public as to the goods by fraudulent means, while an important factor in such suit, does not give a right to an action unless it results in the sale of such goods as those of the complainant.⁸⁵

⁸⁴ *Weener v. Brayton* (1890) 152 Mass. 101, 8 L. R. A. 640.

⁸⁵ *American Washboard Co. v. Saginaw Mfg. Co.* (1900) 43 C. C. A. 233, 103 Fed. 281. In this case the court said: "There are numerous cases in the reports upon the subject of unfair competition in trade. From the general principle running through them all, it may be said that when one has established a trade or business in which he has used a particular device, symbol, or name, so that it has become known in trade as a designation of such person's goods, equity will protect him in the use thereof. Such person has a right to complain when another adopts this symbol or manner of marking his goods so as to mislead the public into purchasing the same as and for the goods of complainant. Plain-

§ 306. Practice — Propriety of Approval by Court of New Label.

After a case has been tried, and it has been found that the defendant has been guilty of unfair competition by deliberately and designedly imitating packages and labels of the business of a competitor, it is improper for a court to give its approval in advance to a changed form proposed to be adopted by the defendant to avoid future liability. It should restrain the use of the infringing device, leaving to the defendant the responsibility of deciding for himself, at his own risk, what changes are necessary to avoid infringement. Where the lower court approved a proposed form, the court of appeals said: "The court below, upon holding that the changed label of the defendant infringed the complainant's right, caused to be submitted for its approval another form of label which it approved, and authorized the defendant to use upon bottles of the same form as those used by the complainant. We greatly doubt the propriety of such action. When an infringement has been found, it should be restrained. A court of equity does not sit as an arbiter to determine in advance upon other and changed labels which the infringer may adopt to avoid the condemnation of the court. Whether such changed forms do in fact infringe is matter of fact to be determined by the court in its usual course of procedure upon complaint lodged by the party damaged. The duty of the court below was to determine whether the labels complained of in the bill infringed the complainant's right. That duty was fully performed when the court had so determined. It is not called upon to decide whether a new label proposed for adoption would infringe.

tiff comes into a court of equity in such cases for the protection of his property rights. The private action is given, not for the benefit of the public, although that may be its incidental effect, but because of the invasion by defendant of that which is the exclusive property of complainant."

This is especially so here, where the infringement was deliberate and designed. In such case the court ought not to say how near the infringer may lawfully approximate the label of the complainant, but should cast the burden upon the guilty party of deciding for himself how near he may with safety drive to the edge of the precipice, and whether it be not better for him to keep as far from it as possible."⁸⁰

⁸⁰ Charles E. Hires Co. v. Consumers' Co. (1900) 41 C. C. A. 71, 100 Fed. 809.

In *Stirling Remedy Co. v. Spermine Medical Co.* (1901) 50 C. C. A. 657, 112 Fed. 1000, Jenkins, J., said: "We have held in *Charles E. Hires Co. v. Consumers' Co.*, 41 C. C. A. 71, 100 Fed. 809, and in *Mitchell v. Williams*, 45 C. C. A. 265, 106 Fed. 168, that it is not proper, where unfair competition has been found, for a court of equity to give its approval in advance to a changed form proposed to be adopted to avoid future liability, but should, in such cases, restrain the use of the infringing devices, leaving to the defendant the responsibility of deciding for himself, and at his own risk, what changes are necessary to avoid infringement."

In *Weber Medical Tea Co. v. Weber* (1900) 102 Fed. 156, the rights of the parties to the use of certain trade-names and labels had been adjudicated, and defendants thereafter submitted to counsel for complainants a proposed new form of label, which was by them approved as unobjectionable. It was held that thereafter another court would not grant a preliminary injunction against the use of such label by defendants on the application of the complainant. The court said: "Complainant's assignors, on August 29, 1899, obtained in the supreme court of the state of New York a judgment which, as to the rights determined therein, is an estoppel upon the defendants herein. After such judgment, the present defendants, with a view of complying therewith, submitted to the counsel for the present complainant the label which is the subject of the present controversy, and such counsel stated that he saw no objection to it, and the defendants thereupon adopted the label, and for such adoption they are accused by the complainant in the present action. It was the impression of the court, upon the hearing of the motion for a preliminary injunction, that a label which seemed unobjectionable when submitted to the skilled and advised counsel for the complainant should not be deemed a violation of the complainant's rights within the limits of examination

§ 307. Power of Court on Appeal.

The granting or refusing of a preliminary injunction is largely discretionary, but the provision of the act creating the United States circuit court of appeals, allowing appeals from such orders, is for the purpose of having such discretion reviewed, and errors in its exercise corrected. When the court below has found a defendant guilty of unfair competition practiced deliberately and designedly, and has granted an injunction for the protection of the complainant's rights as it found them, but fell short in its judgment as to the extent of such rights, its error will be corrected on appeal, and its injunction broadened to afford the full measure of relief to which complainant is entitled.⁸⁷

observed upon applications of this nature. The impression is not diminished after an examination of the briefs, and, upon that ground alone, the motion for a preliminary injunction is denied. The position apparently taken by the defendants that their tea is now known as 'Weber's Tea' may enter into the ultimate decision, but for the purposes of a preliminary injunction the consent above discussed must have the greater influence."

In *Bass, Ratcliff & Gretton v. Feigenspan* (1899) 96 Fed. 206, it was said: "He who applies the false mark has no just cause of complaint if he be prevented from further violating the exclusive right of the lawful employer of the genuine symbol, and he certainly should not be allowed, at the peril of the latter, fraudulently to experiment in the use of such false mark, with accessories of varying character, with the double purpose of filching the custom of a business rival, and at the same time shielding himself from the consequences of infringement."

⁸⁷ *Charles E. Hires Co. v. Consumers' Co.* (1900) 41 C. C. A. 71, 100 Fed. 809. See *Selchow v. Baker* (1883) 93 N. Y. 59; *O'Kane v. West End Dry Goods Store* (1897) 72 Ill. App. 297.

CHAPTER XIII.

DEFENSES.

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- 313. Noninfringement.
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- 319. False Statements as to Place of Manufacture.
- 320. False Statements as to Materials Used.
- 321. False Statements as to Letters Patent.
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§ 308. In General.

There are a number of defenses that may be made to an action for infringement of a technical trade-mark or trade-name, or to an action to restrain unfair competition in business, or to an action that contains both a claim of infringement of a technical trade-mark or trade-name and a claim of unfair competition in business. There are several defenses that are applicable only to cases involving technical trade-marks and trade-names, and a few that are applicable only to cases of unfair competition. The majority of defenses are, however, applicable both to trade-mark and trade-name cases, and to cases of unfair competition. The following defenses may be made to cases involving technical

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trade-marks and trade-names: First, that complainant has no exclusive right to the trade-mark or trade-name in suit; second, that defendant has acquired a license to use such trade-mark or trade-name; third, that complainant has abandoned the trade-mark or trade-name; fourth, that the trade-mark is used by defendant on a class of goods different from that on which it is used by complainant; fifth, noninfringement; sixth, that complainant has been guilty of laches to such an extent as to disentitle him to relief; seventh, false and fraudulent representations on the part of complainant. The fifth, sixth, and seventh of the above-named defenses are equally applicable in actions to restrain unfair competition in business.

§ 309. No Exclusive Right in Claimant.

In an action to restrain the use of a technical trade-mark or trade-name, the defense that complainant has no exclusive right to the trade-mark or trade-name in question is, if sustained by the proofs, an absolute bar to the action. Thus it has been held by the United States supreme court that, as the designation "Goodyear Rubber Company" is not subject to exclusive appropriation, any use of terms of similar import, or any abbreviation of them, is free to all persons.¹ If a complainant has no exclusive right to an alleged trade-mark or trade-name, he cannot maintain an action for its infringement by others.

§ 310. License.

If a defendant, in an action to restrain the use of a trade-

¹ Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (1888) 128 U. S. 598; Manufacturing Co. v. Trainer (1879) 101 U. S. 51; Brennan v. Emery-Bird-Thayer Dry-Goods Co. (1901) 108 Fed. 624; J. R. Watkins Medical Co. v. Sands (1901) 83 Minn. 326; Asbestos & Asbestic Co. v. William Sclater Co. (1901) 10 Rap. Jud. Que. B. R. 165.

mark or trade-name, proves a license from a person or persons having authority to give it, a defense to the action is made out. A license of this kind, to be effectual, however, must come from the actual owner of the trade-mark or trade-name, and, if of a revocable character, must be shown to be still in force.² It must also appear that the trade-mark or trade-name is of such character that a licensee can use it without fraud upon the public.³

§ 311. Abandonment.

That complainant has abandoned the trade-mark or trade-name alleged to have been infringed is necessarily a good defense. The subject of abandonment has been fully discussed in previous chapters of this work.⁴

§ 312. Use on Different Class of Goods.

That defendant uses the trade-mark on a different class of goods from that on which it is used by complainant is a defense to an action for infringement; but it is not a defense that defendant uses the trade-mark on a different species of goods from that on which it is used by complainant, where both species belong to the same general class.⁵

§ 313. Noninfringement.

The defense of noninfringement will usually be determined by the court by a comparison of the two trade-marks in a

² *Stetson v. Winsor* (1872) 9 Phila. (Pa.) 513, Cox, Man. Trademark Cas. 396; *McCardel v. Peck* (1864) 28 How. Pr. (N. Y.) 120, Cox, Man. Trademark Cas. 233; *Deiz v. Lamb* (1866) 6 Rob. (N. Y.) 537, Cox, Man. Trademark Cas. 266.

³ *Blois v. Bloomer* (1857) 23 Barb. (N. Y.) 604; *Samuel v. Berger* (1856) 24 Barb. (N. Y.) 163; *Oldham v. James* (1862) 13 Ir. Ch. 393, (1863) 14 Ir. Ch. 81.

⁴ See chapter 5, §§ 101-105.

⁵ See chapter 4, § 96; chapter 9, § 202.

case involving only a technical trade-mark, or by a comparison of the labels or wrappers in a case of unfair competition. The rules that govern in determining the question of infringement have been stated in previous chapters.⁶

§ 314. Laches.

Laches will not usually deprive a complainant, in a case involving a trade-mark, a trade-name, or unfair competition in business, of the remedy by injunction, but will frequently deprive him of an accounting and costs. This subject has been fully discussed in a preceding chapter.⁷

§ 315. Deception Practiced by Claimant.

One of the most effective defenses that can be made to an action in equity, where it is sought to restrain the infringement of a trade-mark or trade-name, or to restrain unfair competition in business, is that the complainant has been guilty of false and fraudulent representations in connection with the particular business in which the marks, names, labels, or packages are used. The basis of this defense is found in the old and settled rule of equity that "he who comes into a court of equity must come with clean hands and a pure conscience." If this defense is made and is substantiated, a court of equity will not inquire whether the complainant has a valid trade-mark or trade-name, or whether the defendant has been guilty of unfair competition, but the action will be dismissed, even though it be apparent that the defendant has been guilty of the most flagrant piracy. The following statement of the rule from the opinion of Chief Justice Duer in *Fetridge v. Wells*⁸ was quoted with approval

⁶ See chapters 9 and 10.

⁷ See chapter 5, §§ 106-109.

⁸ (1857) 4 Abb. Pr. (N. Y.) 144.

by Justice Field in delivering the opinion of the supreme court of the United States in the leading case of *Manhattan Medicine Co. v. Wood*:⁹ “Those who come into a court of equity, seeking equity, must come with clean hands and a pure conscience. If they claim relief against the fraud of others, they must themselves be free from the imputation. If the sales made by the plaintiff and his firm are effected, or sought to be, by misrepresentation and falsehood, they cannot be listened to when they complain, that, by the fraudulent rivalry of others, their own fraudulent profits are diminished. An exclusive privilege for deceiving the public is assuredly not one that a court of equity can be required to aid or sanction. To do so would be to forfeit its name and character.” In the same case Justice Field also quoted the following with approval from the English case of *Leather Cloth Co. v. American Leather Cloth Co.*:¹⁰ “When the

⁹ (1883) 108 U. S. 218. See chapter 10, §§ 212-213.

¹⁰ (1863) 4 De Gex, J. & S. 137, (1865) 11 H. L. Cas. 523. See, also, *Pidding v. How* (1837) 8 Sim. 477; *Perry v. Truefitt* (1842) 6 Beav. 66; *Seabury v. Grosvenor* (1877) 14 Blatchf. 262, Fed. Cas. No. 12,576; *Hobbs v. Francais* (1860) 19 How. Pr. (N. Y.) 567; *Connell v. Reed* (1880) 128 Mass. 477; *Fowle v. Spear* (1847) Cox, Man. Trademark Cas. 90, Fed. Cas. No. 4,996; *Blackwell v. Armistead* (1872) 3 Hughes, 163, Fed. Cas. No. 1,474; *Phalon v. Wright* (1864) 5 Phila. (Pa.) 464; *Swift v. Dey* (1865) 4 Rob. (N. Y.) 611; *Heath v. Wright* (1855) 3 Wall. Jr. 141, Fed. Cas. No. 6,310; *Smith v. Woodruff* (1867) 48 Barb. (N. Y.) 438; *Curtis v. Bryan* (1867) 36 How. Pr. (N. Y.) 33; *Palmer v. Harris* (1869) 60 Pa. 156; *Joseph Dixon Crucible Co. v. Guggenheim* (1869) 2 Brewst. (Pa.) 321; *Laird v. Wilder* (1872) 9 Bush (Ky.) 131; *Wolfe v. Burke* (1874) 56 N. Y. 115; *McNair v. Cleave* (1874) 10 Phila. (Pa.) 155; *Hennessy v. Wheeler* (1876) 51 How. Pr. (N. Y.) 457; *Carmichel v. Latimer* (1876) 11 R. I. 395; *Helmbold v. Henry T. Helmbold Mfg. Co.* (1877) 53 How. Pr. (N. Y.) 453; *Prince Mfg. Co. v. Prince's Metallic Paint Co.* (1892) 135 N. Y. 24; *Prince's Metallic Paint Co. v. Prince Mfg. Co.* (1893) 57 Fed. 938; *Krauss v. Joseph R. Peebles' Sons Co.* (1893) 58 Fed. 585; *Kohler Mfg. Co. v. Beeshore* (1893) 59 Fed. 572; *Royal Baking Powder Co. v. Raymond* (1895) 70 Fed. 376; *New York Consolidated Card Co.* (538)

owner of the trade-mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connection with the property he seeks to protect, he loses, and very justly, his right to claim the assistance of a court of equity;" and added: "The doctrine enunciated in all these cases is founded in honesty and good sense; it rebukes fraud, and encourages fair dealing with the public." It has been held, however, that "the maxim that one must come into equity with clean hands is confined to misconduct in regard to, or at all events connected with, the matter in litigation, so that it has in some measure affected the equitable relations subsisting between the two parties, and arising out of the transaction. It does not extend to any misconduct, however gross, which is unconnected with the matter in litigation, and with which the opposite party has no concern."¹¹

There is considerable conflict in the decisions of the courts as to the character of representations that will disentitle a plaintiff to relief. It is not every exaggerated statement,

v. Union Playing Card Co. (1886) 39 Hun (N. Y.) 611; Metcalfe v. Brand (1887) 86 Ky. 331; Koehler v. Sanders (1890) 122 N. Y. 65; C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84; Millbrae Co. v. Taylor (1894) (Cal.) 37 Pac. 235; Siegert v. Abbott (1893) 72 Hun (N. Y.) 243; Siegert v. Abbott (1883) 61 Md. 276; Buckland v. Rice (1884) 40 Ohio St. 526; Kenny v. Gillet (1889) 70 Md. 574; Van Horn v. Coogan (1894) 52 N. J. Eq. 380; Joseph v. Macowsky (1892) 96 Cal. 518; Alden v. Gross (1887) 25 Mo. App. 123; Parlett v. Guggenheimer (1887) 67 Md. 542. But see Fetridge v. Merchant (1857) 4 Abb. Pr. (N. Y.) 156; Stewart v. Smithson (1856) 1 Hilt. (N. Y.) 119; Comstock v. White (1860) 18 How. Pr. (N. Y.) 421; Ellis v. Zeilin (1871) 42 Ga. 91.

¹¹ Mossler v. Jacobs (1896) 66 Ill. App. 571.

every puff of one's goods, that is to be regarded as a false representation. In some instances the courts have gone to an extreme in holding exaggerated statements to be evidence of deceit on the part of a plaintiff sufficient to disentitle him to relief. Thus, where a firm had adopted the name "Galaxy Publishing Company," it was held that this name falsely implied that plaintiffs were a corporation, and an injunction restraining an imitation of the name was refused.¹² In one case a trade-mark was refused protection because used upon bottles represented as being pint and quart bottles, and containing considerably less.¹³ In another case, however, where complainant's preparation was advertised as "Sold only in quart bottles," while the bottles, though known among druggists as quart bottles, held substantially less than a quart, it was held that this fact was immaterial.¹⁴ Moreover, it is not necessary, in order that this defense should prevail, that the plaintiff should have deliberately designed to deceive. If what is stated on the label is naturally calculated to deceive, and must and does inevitably deceive, the false statement has the same effect as if willfully made.¹⁵

§ 316. False Statements on Packages.

The false statements that ordinarily deprive the plaintiff, in an action in equity against an alleged infringer, of the right to relief, are generally found upon the package itself. Such statements usually relate to the person by whom the article is manufactured, to the place where it is manufactured, to the materials used, the results to be derived therefrom, or to the existence of a patent or copyright thereon.¹⁶

¹² *McNair v. Cleave* (1874) 10 Phila. (Pa.) 155.

¹³ *Hennessy v. Wheeler* (1876) 51 How. Pr. (N. Y.) 457.

¹⁴ *Alexander v. Morse* (1884) 14 R. I. 153.

¹⁵ *Kenny v. Gillet* (1889) 70 Md. 574.

¹⁶ *Manhattan Medicine Co. v. Wood* (1883) 108 U. S. 218.

§ 317. False Statements in Advertisements.

False representations in advertisements are as fatal to the right of the proprietor of a trade-mark or trade-name to restrain its infringement, or to the right of a user of a label, or particular style of package, to restrain unfair competition, as similar statements are when made directly in the trade-mark or trade-name, or on the label itself.¹⁷ Even where

¹⁷ *Manhattan Medicine Co. v. Wood* (1883) 108 U. S. 218; *Leather Cloth Co. v. American Leather Cloth Co.* (1863) 4 De Gex, J. & S. 137, (1865) 11 H. L. Cas. 523; *Fetridge v. Wells* (1857) 4 Abb. Pr. (N. Y.) 144; *Pidding v. How* (1837) 8 Sim. 477; *Perry v. Truefitt* (1842) 6 Beav. 66; *Preservaline Mfg. Co. v. Heller Chemical Co.* (1902) 118 Fed. 103; *Phalon v. Wright* (1864) 5 Phila. (Pa.) 464; *Siegert v. Abbott* (1893) 72 Hun (N. Y.) 243. See, contra, *Curtis v. Bryan* (1867) 36 How. Pr. (N. Y.) 33.

Stirling Silk Mfg. Co. v. Sterling Silk Co. (1900) 59 N. J. Eq. 400, 401: "Another reason not pressed by counsel weighs with me against granting a preliminary injunction in this case, and should be called to counsel's attention now. Complainant, in October, 1899, advertised that its method of marking on the selvedge of silks was patented, and that its right to so mark was exclusive, and not only a legal, but a moral, right. It does not appear that the advertisement or claim has been withdrawn. No such patent right existed, nor, if my views above expressed be correct, can any patented right exist, and the representation that the marking of 'guarantied' was patented was therefore false. It was, moreover, a falsehood publicly made by advertisements for the apparent purpose of influencing dealers who were adopting the method of having their names woven on the goods by manufacturers to deal with complainant only, under penalty of infringement of patent, and it may possibly have had this effect. If this false statement that the mark 'guarantied' was patented had appeared in connection with the trade mark or name itself on the goods, there could be no question, I think, that the complainant could have had no relief, even on final hearing, for the protection by injunction is not given in favor of falsehood. *Kerr*, Inj. 412, and cases cited. The serious question is whether a false statement that the mark was 'patented,' made, not in the trade-mark itself, but by way of collateral misrepresentation, as by advertisements, etc., is a bar to relief. Upon this point judges differ. The leading case is *Ford v. Foster*, L. R. 7 Ch. App.

the trade-mark or trade-name would in itself be protected, or a clear case of unfair competition is made out, relief will be refused if material false statements have been resorted to

Cas. 611. In this case Vice-Chancellor Bacon held that the misrepresentation in invoices and advertisements that a shirt called 'Ford's Eureka Shirt' was patented, when it was not, deprived complainant of right to relief on final hearing. He says (at page 619) that he is not disposed to fritter away the wholesome doctrine of the court that, if a man invokes its aid for the protection of a legal right, he is bound to show that he dealt honestly with that right, and that there was no honesty in complainant's holding himself out as being patentee when he had no such right. On appeal, all of the justices admitted the correctness of the principle of the effect of misrepresentation in the trade-mark itself, but held that collateral misrepresentations that the article was patented were not fatal to protection on final hearing, if the misrepresentations would not have been a defense to an action at law for violating the trade-mark, or sufficient basis for enjoining a suit at law. These rules were made the test of whether a court of equity was bound to aid by injunction in the protection of the legal rights. Lord Justice Mellish, at pages 632, 633. This case was cited in a late case in the house of lords (*Cochrane v. MacNish* [1896] App. Cas. 225, 226. and the question stated, but it was not directly passed on. My present view is that there is much to be said in favor of the rule as stated by Vice-Chancellor Bacon, especially in view of the fact that in many cases our courts of equity have adopted a rule in relation to the protection of legal rights different from that laid down by the justices on appeal in *Ford v. Foster*. Our courts hold in many cases that complainant must come into a court of equity with a cause essentially equitable. *Minzesheimer v. Doolittle* (N. J. Err. & App.; March, 1900), 45 Atl. 611, and cases cited at page 612. This rule, if applicable to the present case, and in the absence of a satisfactory explanation of the representation or of its continuance, might prevent complainant obtaining a final decree. The doubt or question as to the legal effect of the misrepresentation upon the right to a decree at final hearing is therefore an additional ground for refusing to interfere by preliminary injunction, where the necessity for such interference is not absolutely imperative, in order to protect complainant, if ultimately successful." See, also, *Preservaline Mfg. Co. v. Heller Chemical Co.* (1902) 118 Fed. 103.

in placing an article, in connection with which the mark or name is used, on the market.¹⁸

§ 318. False Statements as to Person by Whom Article is Manufactured.

False statements as to the person by whom the article, upon which a trade-mark is used, is manufactured, will deprive the complainant in an action in equity of any relief, where it appears that this is a material circumstance in guiding the purchaser in making a selection of the article. In the majority of cases in which this rule has been applied, the articles have originally been manufactured by the assignor of the complainant, and the complainant has continued to manufacture and sell the article, after acquiring the business, under the original label, thus representing to the public that the article was still being manufactured by the original proprietor. The supreme court of the United States has said: "A court of equity will extend no aid to sustain a claim to a trade-mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article."¹⁹ The reason for this, as stated by the court, is: "If one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess, in the estimation of purchasers." Hence, where a trade-mark is a mark of special qualities, due to the superior material, processes, skill, and care exercised by the originator thereof, an assignee of the business, who continues to use labels which contain the false statement

¹⁸ *Hennessy v. Wheeler* (1876) 51 How. Pr. (N. Y.) 457.

¹⁹ *Manhattan Medicine Co. v. Wood* (1883) 108 U. S. 218.

that the goods are prepared by the originator, is not entitled to relief against an infringer.²⁰ An assignee or purchaser of a trade-mark from the original proprietor must, in the use of the mark, indicate that he is the assignee or purchaser, or he will not be entitled to protection in the use of the mark assigned.²¹ Where a plaintiff in an action in equity sold a compound under the name and trade-mark of the original proprietor, and which such original proprietor, at that time, claimed to use under and through a corporation with which he was then connected, and the plaintiff also represented that the original proprietor superintended personally the manufacture of the compound, and by his own signature certified to the genuineness of each bottle, it was held that the plaintiff was entitled to no protection.²² It must appear, however, that there is a material false representation in the use of the mark by the complainant; that he cannot honestly use it in the manner in which he is doing, and that, in order to protect the public, it is essential to show that the assignee, and not the original proprietor, is manufacturing the article and using the mark. If the complainant can fairly continue the original mark or label without deceiving the public, a court of equity will protect him in doing so.²³ Thus, where the business of manufacturing flour had

²⁰ *Alaska Packers' Ass'n v. Alaska Improvement Co.* (1894) 60 Fed. 103.

²¹ *Stachelberg v. Ponce* (1885) 23 Fed. 430; *Stachelberg v. Ponce* (1888) 128 U. S. 686; *Hoxie v. Chaney* (1887) 143 Mass. 592; *People v. Molins* (1888) 7 N. Y. Cr. R. 51, 10 N. Y. Supp. 130; *New York Consolidated Card Co. v. Union Playing Card Co.* (1886) 39 Hun (N. Y.) 611; *Hazard v. Caswell* (1883) 93 N. Y. 259; *Krauss v. Joseph R. Peebles' Sons Co.* (1893) 58 Fed. 585; *Siegert v. Abbott* (1884) 61 Md. 276.

²² *Helmbold v. Henry T. Helmbold Mfg. Co.* (1877) 53 How. Fr. (N. Y.) 453.

²³ *Feder v. Benkert* (1895) 70 Fed. 613.

been conducted by a firm, and one of the partners had from the first controlled it, and under his management the product of the mills had acquired its high reputation, and where the business was afterwards incorporated with the same partner as managing director, the United States court of appeals for the Seventh circuit questioned whether continuing to sell the flour under the original brands could be fittingly characterized as misrepresentation and falsehood, preventing relief in equity, and said: "Under such circumstances, it may well be said that the trade-name continued to assert the truth in its spirit and essence, and gave truthful assurance to the public that the flour was the genuine product of the Minneapolis mills operated and controlled by Mr. Pillsbury, notwithstanding the legal and technical change in ownership wrought by the incorporation."²⁴ In another case, where it appeared that the complainant, twenty-one years before, succeeded to the business of a firm manufacturing baking powder, and that it had continued ever since to manufacture and sell the article under its own name, it was held that the failure to show on its labels the alleged assignment was immaterial. The court said: "This omission, under the circumstances here shown, involved no fraud or false representation. Complainant made the baking powder in its cans, and its label contained no representation to the contrary. When one person buys from another, for instance, a patent medicine business, abandons the old place of manufacture, and proceeds, himself, to make the medicine at another place, but represents on his labels that it is made at the old place, and by the original compounder, he fails in a court of chancery against an alleged infringer. Nothing at all parallel to this is found here. There was, so far as I can make out, no

²⁴ Pillsbury v. Pillsbury-Washburn Flour Mill Co. (1894) 64 Fed. 841.

false representation or imposition on the public in the labels of the complainant."²⁵

§ 319. False Statements as to Place of Manufacture.

Misrepresentations as to the place of production of an article are equally fatal to the right to maintain an action in equity with similar statements as to the manufacturer, and for the same reason. The locality of production may be a material circumstance in aiding a purchaser to make a selection, and false statements in relation thereto will mislead and deceive him. A person making such statements is guilty of fraud, and can receive no aid from a court of equity.²⁶

§ 320. False Statements as to Materials Used.

Courts of equity have always been very strict in refusing aid to a complainant who has made misstatements as to the ingredients of which his article is composed, and especially

²⁵ *Royal Baking Powder Co. v. Raymond* (1895) 70 Fed. 376, affirmed (1898) 85 Fed. 231. See, also, *Witthaus v. Braun* (1876) 44 M.A. 303; *Jennings v. Johnson* (1888) 37 Fed. 364; *Ransom v. Ball* (1889) 7 N. Y. Supp. 238; *Societe Anonyme v. Western Distilling Co.* (1890) 43 Fed. 416; *Prince Mfg. Co. v. Prince's Metallic Paint Co.* (1891) 60 Hun. 583, 15 N. Y. Supp. 249; *Clark Thread Co. v. Armitage* (1896) 74 Fed. 936; *The Fair v. Jose Morales & Co.* (1899) 82 Ill. App. 499; *Petrolia Mfg. Co. v. Bell & Bogart Soap Co.* (1899) 97 Fed. 781; *Block v. Standard Distilling & Distributing Co.* (1899) 95 Fed. 978.

²⁶ *Manhattan Medicine Co. v. Wood* (1883) 108 U. S. 218; *Raymond v. Royal Baking-Powder Co.* (1898) 85 Fed. 231; *Palmer v. Harris* (1869) 60 Pa. 156; *Coleman, Burden & Warthen Co. v. Dannenberg Co.* (1898) 103 Ga. 784; *Prince Mfg. Co. v. Prince's Metallic Paint Co.* (1892) 135 N. Y. 24; *Connell v. Reed* (1880) 128 Mass. 477; *Millbrae Co. v. Taylor* (1894) (Cal.) 37 Pac. 235; *American Cereal Co. v. Eli Pettijohn Cereal Co.* (1896) 72 Fed. 903; *Hegeman & Co. v. Hegeman* (1880) 8 Daly (N. Y.) 1; *Siegert v. Abbott* (1883) 61 Md. 276. But see *Cleveland Stone Co. v. Wallace* (1892) 52 Fed. 431; *Fischer v. Blank* (1892) 64 Hun. 635, 19 N. Y. Supp. 65.

where the article is one designed for human consumption. In an early case, decided by Judge Duer, it was said: "I am fully convinced that the name 'Balm of Thousand Flowers' was invented, and is now used, to convey to the minds of purchasers the assurance that the highly-scented liquid to which the name is given is, in truth, an extract or distillation from flowers, and therefore not merely an innocent, but a pleasant and salutary, preparation. Not only is this the meaning that the words used naturally suggest, but in my opinion it is that which they actually and plainly express, and were designed to convey. * * * Let it not be said that it is of little consequence whether this representation be true or false. No representation can be more material than that of the ingredients of a compound which is recommended and sold as a medicine. There is none that is so likely to induce confidence in the application and use of the compound, and none that, when false, will more probably be attended with injurious, and perhaps fatal, consequences."²⁷

Where a complainant claimed a trade-mark in the word "Puddine," in connection with the words "Rose" and "Vanilla," the court said: "The complainant himself is engaged in deceiving the very public whom he claims to protect from the deception of others. He calls his preparation 'fruit' puddine. In nine different places on his package this word 'fruit' is repeated, as descriptive of the article, and a dish of fruit (pears, grapes, etc.) is most prominently depicted on one face of each package. His packages plainly suggest that fruit of some kind enters in some shape into his compound. A chemical analysis produced by defendant, the substantial accuracy of which is not disputed, discloses the fact that his 'Puddine' is composed exclusively of corn-starch, a small amount of saccharine matter, and a flavor-

²⁷ *Fetridge v. Wells* (1857) 13 How. Pr. (N. Y.) 385.

ing extract, with a little carmine added to give it color. It contains no fruit in any form. Under these circumstances, complainant's rights are not sufficiently clear to warrant the granting of a preliminary injunction."²⁸ In another case, where a trade-mark was claimed in the words "Fruit-Vinegar," the court said: "The vinegar thus branded was not manufactured out of 'fruit,' in the plain, ordinary, usual sense of that term, but out of low wines distilled from cereals, and fruit enters into its composition only to a very insignificant extent. * * * It would be a novel application of the rule governing the subject of trade-marks if one who manufactures vinegar out of cereals could appropriate for the article thus manufactured the word 'fruit,' and thereby exclude another from using the word as descriptive of an article which is, in point of fact, manufactured out of fruit. * * * But whether the word 'fruit,' in this connection, is purely indicative of the character or quality of the article or not, the plaintiffs' exclusive claim to it must fail on the further ground that the use of the word, in that connection, is clearly deceptive."²⁹ Where the word "Capcine" was claimed as a trade-mark, Judge Blatchford placed his refusal to sustain it on the following grounds: "Courts of equity refuse to interfere in behalf of persons who claim property in a trade-mark acquired by advertising their wares under such representations as those above cited, if they are false. It is shown that there is no such article as Capcine known in chemistry or medicine, or otherwise. The authorities are clear that, in a case of this description, a plaintiff loses his right to claim the assistance of a court of equity."³⁰ Where

²⁸ Clotworthy v. Schepp (1890) 42 Fed. 62.

²⁹ Alden v. Gross (1887) 25 Mo. App. 123.

³⁰ Seabury v. Grosvenor (1877) 14 Blatchf. 262, Fed. Cas. No. 12,576.

the subject of the claimed trade-mark was "Extract of Night-Blooming Cereus," and it was admitted that the name was a deception, that the perfume was not an extract from the flower, the trade-mark being in that respect a pure invention, the bill was dismissed.³¹ Where a trade-mark was claimed in the words "Syrup of Figs," and the leading representation on the labels, packages, and in the advertisements was that the preparation was a laxative fruit syrup made from the juice of the California fig, the bill of complaint was dismissed by Judge Putnam in the United States circuit court for the district of Massachusetts. The court used the following language: "The popularity of this medicine arises from the belief in the mind of the ordinary purchaser that he is buying a laxative compound, the essential ingredient of which is the California fig, whereas, in fact, he is buying a medicine the active property of which is senna. The ethical principle on which the law of trade-marks is based will not permit of any such deception. It may be true, as a scientific fact known to physicians and pharmacists, that the syrup of figs has little or no laxative property; but this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig, which is false. This is not an immaterial representation, the effect of which is harmless, but it is a representation which goes to the very essence of the plaintiff's right to a trade-mark in these words."³² This case was affirmed on appeal,³³ and has been followed in several other cases.³⁴

³¹ Phalon v. Wright (1864) 5 Phila. (Pa.) 464.

³² California Fig-Syrup Co. v. Putnam (1895) 66 Fed. 750.

³³ California Fig-Syrup Co. v. Putnam (1895) 16 C. C. A. 376, 69 Fed. 740.

³⁴ California Fig-Syrup Co. v. Stearns (1895) 67 Fed. 1008; California Fig-Syrup Co. v. Frederick Stearns & Co. (1896) 20 C. C. A. 22,

§ 321. False Statements as to Letters Patent.

When the proprietor of a trade-mark used upon or in connection with a commercial article represents the article as protected by a patent, when in fact it is not, he loses his right to protection of such trade-mark, and the same rule applies whether there never was a patent on the article, or a patent granted therefor has been declared by the courts invalid, or has expired by limitation.³⁵ In some cases it

73 Fed. 812. But see *California Fig-Syrup Co. v. Improved Fig-Syrup Co.* (1892) 51 Fed. 296; *Improved Fig-Syrup Co. v. California Fig-Syrup Co.* (1893) 4 C. C. A. 264, 54 Fed. 175; *California Fig-Syrup Co. v. Worden* (1899) 95 Fed. 132.

³⁵ *Leather Cloth Co. v. American Leather Cloth Co.* (1863) 4 De Gex, J. & S. 137, (1865) 11 H. L. Cas. 523; *Flavel v. Harrison* (1853) 10 Hare, 467, 22 Law J. Ch. 866, Cox, Man. Trademark Cas. 116; *Morgan v. McAdam* (1866) 36 Law J. Ch. 228, Cox, Man. Trademark Cas. 267; *Lamplough v. Balmer* (1867) W. N. 1867, p. 293, Cox, Man. Trademark Cas. 288; *Leather Cloth Co. v. Lorsont* (1869) L. R. 9 Eq. 345, Cox, Man. Trademark Cas. 324; *Consolidated Fruit-Jar Co. v. Dorflinger* (1874) 2 Amer. Law T. Rep. (N. S.) 511, Fed. Cas. No. 3,129; *Cheavin v. Walker* (1877) 46 Law J. Ch. 686, 5 Ch. Div. 850, Cox, Man. Trademark Cas. 528; *Morse v. Worrell* (1874) 10 Phila. (Pa.) 168; *Brown v. Doscher* (1892) 66 Hun (N. Y.) 626. See, also, *Fleischmann v. Schuckmann* (1881) 62 How. Pr. (N. Y.) 92; *Fleischmann v. Fleischmann* (1896) 7 App. Div. (N. Y.) 280; *Lauferty v. Wheeler* (1882) 11 Daly (N. Y.) 194; *C. F. Simmons Medicine Co. v. Mansfield Drug Co.* (1893) 93 Tenn. 84.

In *New York Consolidated Card Co. v. Union Playing Card Co.* (1886) 39 Hun (N. Y.) 611, Daniels, J.: "The point has been taken, in support of the appeal, that the use of the words 'patent' and 'patented,' in the manufacture and sale of the plaintiff's cards, was merely collateral to the device itself, which was made use of as the plaintiff's trade-mark, and, when used in that manner, even though it should be a misrepresentation, the fact would not deprive the plaintiff of an injunction restraining the use of a trade-mark by a competing dealer. That view of the law, but upon a different state of facts, was adopted and supported in *Ford v. Foster* (1872) 7 Ch. App. 611, and *Millington v. Fox* (1838) 3 Mylne & C. 338. But this was not a collateral misrepresentation, within the rule supported by these and other cases, for the fact misrepresented accompanied each

has been held that the proprietor of a trade-mark may lawfully mark his article "Patented," if he has registered a

sale of the article which was made. It was impressed upon one of the cards, and it was conspicuously placed and repeated upon each of the wrappers, so that it was impossible for a person to buy either a single pack or a dozen packs of the cards without being immediately confronted with the representation that the article was manufactured and sold as a patented article. This representation was immediately connected with the article itself which was sold, and did not, as it did in the cases to which reference has been made, consist of an advertisement or a mere accompanying invoice. It was held in *Leather Cloth Co. v. American Leather Cloth Co.* (1863) 1 Hem. & M. 271, 292, 293, that a representation of this description would not deprive the plaintiff of the right to an injunction, where a patent had been issued for the invention, which at the time had ceased to exist. The case was distinguished, by these circumstances, from one where no patent had ever been issued, and where the representation that the article was patented was held sufficient to deprive the plaintiff of the right to an injunction. *Flavel v. Harrison* (1853) 10 Hare. 467, 19 Eng. Law & Eq. 15. And a like distinction was drawn in another action in favor of the same plaintiff against *Hirschfeld* (1863) 1 Hem. & M. 295. And as liberal a ruling was made concerning the use of a fictitious name in *Dale v. Smithson* (1861) 12 Abb. Pr. (N. Y.) 237, and *Stewart v. Smithson* (1856) 1 Hill. (N. Y.) 119. But this distinction was deemed to be unsound when the decision of the vice-chancellor in the case of the *Leather Cloth Company* was appealed to the chancellor, for he held that the previous existence of an expired patent would not sanction the representation, afterwards made, that the article was patented. *Leather Cloth Co. v. American Leather Cloth Co.* (1863) 33 Law J. Ch. 199, 4 De Gex, J. & S. 137. And this decision was afterwards affirmed on appeal to the house of lords. (1865) 11 H. L. Cas. 522. And the legal principle sustained by it was afterwards commended and approved in *Manhattan Medicine Co. v. Wood* (1883) 108 U. S. 218. Upon the same subject, in *Selchow v. Baker* (1883) 93 N. Y. 59, 67, it was said by Judge Rapallo, in the opinion of the court, that 'the patentee relies for his protection upon his patent, and cannot, by calling the name of his patent a trade-mark, protect his monopoly after the patent has expired, or where it has no force.' And the same view of the law was taken and followed in *Cheavin v. Walker* (1876) 5 Ch. Div. 850."

trade-mark therefor;³⁶ in another case the opposite has been held.³⁷

§ 322. Immaterial Misrepresentations.

In order to justify refusal of an injunction to restrain the infringement of a trade-mark, the misrepresentation must be of a material fact in respect of the property sought to be

³⁶ *Insurance Oil Tank Co. v. Scott* (1881) 33 La. Ann. 946; *Cahn v. Gottschalk* (1888) 14 Daly (N. Y.) 542. See, also, *Morse v. Worrell* (1874) 10 Phila. (Pa.) 168.

³⁷ *New York Consolidated Card Co. v. Union Playing Card Co.* (1886) 39 Hun (N. Y.) 611.

In *Insurance Oil Tank Co. v. Scott* (1881) 33 La. Ann. 946, Fenner, J.: "Defendant urges that the use of the abbreviation 'Pat.,' meaning patented, in the trade-mark, is a fraud on the public, and a violation of law, which deprives plaintiff of the right to redress. It is undoubtedly true that the affixing of the word 'patent' to an unpatented article, 'for the purpose of deceiving the public,' is prohibited, under penalties, by the laws of the United States (Rev. St. U. S. § 4901), and that a representation in a trade-mark that an unpatented article is protected by a patent 'prima facie amounts to a misrepresentation of an important fact, which would disentitle the owner of the mark to relief in a court of equity, as against a pirate.' Browne, *Trade-Marks*, § 572; Coddington, *Dig. Trade-Mark Cas.* § 548; (1872) 39 Conn. 450. But, to have such effect, the use of the word 'patented' must be 'with the purpose of deceiving the public,' and, if such fraudulent intention does not exist, and the use of the word may be explained in any reasonable sense consistent with truth and honesty, the party will not be prejudiced. High, *Inj.* § 674; Coddington, *Dig.* §§ 570, 571. The plaintiff avers that the use of the word 'patented' in its label or brand was intended to refer, not to the article, *Insurance Oil*, but to the word 'Trade-Mark,' placed on the top of the label. Had the words, 'Registered in Patent Office,' been used, no question could have arisen; but the use of the word 'patented,' as applied to a trade-mark so registered, is so common that we are referred to an example where so learned a jurist as Judge Cooley uses the language: 'In the United States, trade-marks may be patented,' etc. Cooley, *Torts*, p. 261, note. Under such circumstances, we consider the explanation of plaintiff as sufficient to maintain its honesty of intention."

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protected.³⁸ Statements, which are not strictly true, but are entirely immaterial, are not such false representations as will disentitle a manufacturer to an injunction against infringers.³⁹ Where a trade-mark disclosed truly the place of manufacture and sale of the goods and substantially the true ownership of them, the fact that the name on the label was not the exact name of the manufacturers, owing to changes after the manufacture was commenced, it was held, did not deprive the plaintiffs of their right of injunction.⁴⁰ The fact that in one year, eight years before bringing suit, and forty years after the business was established, complainant issued a circular misrepresenting the character of the article sold by him, did not prevent his obtaining relief against infringement of the trade-mark borne by such article.⁴¹ A misrepresentation not made until after the commencement of an action does not affect the plaintiff's title to relief.⁴² Dates being commonly immaterial and often misapplied in business transactions, an incorrect date, upon envelopes and cards used in business, fixing the establishment of an enterprise earlier than the true date, it has been held, will impugn the *bona fides* of the party so using it, but its prompt correction, so far as possible, will, in the absence of proof of original design, rebut any charge of fraud which might otherwise be justified by it.⁴³ Where a trade-mark contained the words "Pure Old Rye Whiskey," it was held that the falsity of such

³⁸ Lloyd v. William S. Merrill Chemical Co. (1891) (Super. Ct. Cin.) 25 Ohio Law J. (Weekly Law Bul.) 319. See chapter 10, § 212.

³⁹ Tarrant v. Hoff (1896) 76 Fed. 959.

⁴⁰ Joseph Dixon Crucible Co. v. Guggenheim (1869) 2 Brewst. (Pa.) 321.

⁴¹ C. F. Simmons Medicine Co. v. Mansfield Drug Co. (1893) 93 Tenn. 84.

⁴² Siegert v. Findlater (1878) 7 Ch. Div. 801.

⁴³ Blackwell v. Armistead (1872) 3 Hughes, 163, Fed. Cas. No. 1,474.

statement was not proven by the facts that whiskey which was sold under such trade-mark was mixed or blended, and that it was diluted with water, it not appearing that commercially "pure" whiskey is understood to be whiskey of the strength indicated by the government test.⁴⁴

The mere fact that a trade-mark bears a fictitious name as the name of the manufacturer of the article, it has been held, does not affect the owner's right to protection, where it is shown that it is not used with any fraudulent intent, and does not in fact deceive the public.⁴⁵ Where the word "Magnetic" was used on wrappers in the name of a medicine, and it was not pretended that the liquid possessed any of the properties of "magnetism," in the scientific sense of the word, and the evidence did not show that the use of the word in the title was intended to deceive the public, it was held that these facts did not deprive the plaintiff of the right to the protection of the law.⁴⁶ Where the term "Coal Oil Johnny's Petroleum Soap" was used as a trade-mark for soap, and it was admitted by the demurrer that petroleum was one of the ingredients used in making soap, it was held that this term did not necessarily indicate that that was the largest ingredient in the soap, and that plaintiff was not guilty of such misrepresentations as would disentitle it to equity.⁴⁷

⁴⁴ *Cahn v. Gottschalk* (1888) 14 Daly (N. Y.) 542.

⁴⁵ *Dale v. Smithson* (1861) 12 Abb. Pr. (N. Y.) 237.

⁴⁶ *Ransom v. Ball* (1889) 7 N. Y. Supp. 238.

⁴⁷ *Petrolia Mfg. Co. v. Bell & Bogart Soap Co.* (1899) 97 Fed. 781. See, also, *City of Carlsbad v. Kutnow* (1895) 71 Fed. 167; *Cochrane v. McNish* (1896) 65 Law J. P. C. 20; *Clark Thread Co. v. Armitage* (1895) 67 Fed. 896, affirmed (1896) 21 C. C. A. 178, 74 Fed. 936; *Lichtenstein v. Goldsmith* (1889) 37 Fed. 359; *A. F. Pike Mfg. Co. v. Cleveland Stone Co.* (1888) 35 Fed. 896; *Funke v. Dreyfus* (1882) 34 La. Ann. 80; *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277; *Meriden Britannia Co. v. Parker* (1872) 39 Conn. 450.

In Solis Cigar Co. v. Pozo (1891) 16 Colo. 388, 395, Bissell, C.: (554)

"The other branch of the question—deceit of the public—is not so free from difficulty. If it be conceded that the trade-mark tended to deceive the public in any material particular, the relief must be denied. Below the picture of the tobacco plant, it will be remembered, were the words, 'Habana,' 'Copyrighted.' They were words of definite meaning to the trade, and probably of equally certain significance to the public. They were not, however, as is clear from the evidence, of the same import to each class. The word 'Copyrighted' meant the same to everybody. It implied that the protection of the statute applicable to such matters had been secured. This was probably believed to be true, but was without foundation. The misrepresentation, however, was unimportant. It did not tend to deceive the public in respect to any of those matters with which the law concerns itself. The public might buy with the same reliance on all the representations as to the place of production and ownership, whether the marks were protected by the statute, or guarded only by the appropriation and user of its owner. This element would neither be considered nor depended on by the purchaser, whether he was in or out of the trade. With regard to the word 'Habana,' the case is not so easy of settlement. This was expressive of a quality, and an absolute representation of the material of which the cigars were made. Some sorts of deception may be practiced without loss of right to the legal protection usually given this species of property. It is possible for the proof to show that the public received an erroneous impression, which would not of itself be sufficient to destroy the validity of the trade-mark. Neither need the deception be of such a character as to work a positive injury to the purchasers to deprive the user of his exclusive privilege. In the first case it must not concern any of the essential particulars which the trade-mark protects, and in the latter it must not be absolutely false as to any of its leading elements."

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.

§ 323. Redress at Law or in Equity.

In the United States and in England the plaintiff or complainant in actions for infringement of a trade-mark or trade-name may seek redress at law or in equity,¹ and upon his

¹ In *Singer Mfg. Co. v. Wilson* (1876) 2 Ch. Div. 434, 453, Mellish, L. J.: "Originally, I apprehend, the right to bring an action in respect of the improper use of a trade-mark arose out of the common-law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect: that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade-mark, the common-law courts noticed that the false representation which is made by putting another man's trade-mark, or the trade-name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade-mark is imitated, and therefore the common-law courts held that such a manufacturer had a right of action for the improper use of his trade-mark. Then the common-law courts extended that doctrine one step further,—first, if I recollect rightly, in the case of *Sykes v. Sykes* (1824) 3 Barn. & C. 541, 543. There it was held that, although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer

selection between these two methods will depend the character of the relief accorded him. In cases of unfair competition, the complainant must seek his remedy in a court of equity.

§ 324. Damages at Law.

If the method selected be at law, the plaintiff's recovery will be limited to the loss or damage incurred by him, and will not be measured by the gain or profit made by the de-

of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person, yet, if the trade-mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade-mark properly belonged, then that was equally a deception,—a selling of goods with a false representation,—which would give the original user of the trade-mark a right of action. That was the common-law right. Then, in *Millington v. Fox* (1838) 3 Mylne & C. 338, the court of chancery extended the right still further. To give a right of action at common law, the thing must have been done fraudulently; it must have been intended to deceive. But the courts of equity said: "If you have purchased goods with another man's trade-mark upon them, although you may have done it perfectly honestly, not knowing that it was another man's trade-mark, or if you have manufactured goods for somebody else, who has ordered you to manufacture them with a certain trade-mark upon them, and you have manufactured the goods with that trade-mark upon them, perfectly honestly, and not knowing that you were doing anything wrong in putting that trade-mark upon them, yet, nevertheless, you cannot be allowed to put the goods into the market with that trade-mark upon them, because the effect of it will be that the goods will pass from hand to hand as being goods manufactured by the person whose trade-mark it is, and therefore you shall be restrained from doing that. The courts of equity having taken that step, trade-marks began to be considered as property, and no doubt there is, in a certain sense, a property in a trade-mark, and equally in a trade-name, because a trade-name may be used, and is very commonly used, as a trade-mark, properly so called,—that is, a mark put upon the goods themselves."

fendant;² and the recovery may be nominal,³ compensatory⁴ (actual), or exemplary⁵ (vindictive or punitive) damages, or both of the last two mentioned. A case may occur in which

² *Seymour v. McCormick* (1853) 16 How. (U. S.) 480; *Peltz v. Eichele* (1876) 62 Mo. 171, 180. In *Addington v. Cullinane* (1887) 28 Mo. App. 238, 241, 242, Lewis, P. J.: "In 3 *Sutherland on Damages*, pp. 630, 631, the law is explained with numerous citations of authorities, thus: 'The compensation to the owner of a trade-mark for the injury he suffers from a wrongful and unauthorized use of it by another is ascertained and computed on substantially the same principles as damages for infringements of patents and copyrights. * * * But at law only damages can be recovered, and they will be measured by the plaintiff's loss, and not by the defendant's gain. The profits are there held not to be the measure of damages, nor an element of them, where there is any other method of ascertaining and measuring them. * * * Nor will the proof of the defendant's profits warrant a legal presumption that the plaintiff's loss is a corresponding amount.' Another elementary writer says, in the same connection: 'But the damages must be proved from the evidence. A mere possible injury furnishes no ground of damages. * * * The patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not. In trade-mark cases the rule is much the same.' *Browne, Trade-Marks*, §§ 505, 507. In *Leather Cloth Co. v. Hirschfield* (1865) L. R. 1 Eq. 299, 302, it was held that the law would not presume that the plaintiffs would have sold the amount of goods sold by the defendant; but the burden of proof was on the plaintiffs to show special damage by loss of custom, or otherwise. *Peltz v. Eichele* (1876) 62 Mo. 171, 180, was a suit for the defendant's breach of his covenant that he would not engage in the manufacture of matches for a stipulated time. The principles which controlled the decision were closely analogous to those involved in the present case. Said the court: 'What the plaintiffs have lost by the defendant's breach of covenant, and not what the defendant has gained thereby, 'is the legal measure of damages in this case. It was there in proof that the plaintiffs' sales had been reduced about one-half after the defendant embarked in the business, in violation of his covenant.'

³ *Sykes v. Sykes* (1824) 3 Barn. & C. 541, 543; *Blofeld v. Payne* (1833) 4 Barn. & Adol. 410-412; *Thomson v. Winchester* (1837) 19 Pick. (Mass.) 214, 216; *Morison v. Salmon* (1841) 2 Man & G. (558)

both nominal and exemplary damages are recoverable;⁶ but usually the evidence warranting the recovery of exemplary will furnish grounds for compensatory damages. Proof of fraud or of fraudulent intent on the part of defendant,⁷ and of an injury actually done,⁸ is necessary to recovery at law.

385, 387, 389; *Coffeen v. Brunton* (1849) 4 McLean, 516, 520, Fed. Cas. No. 2,946; *Marsh v. Billings* (1851) 7 Cush. (Mass.) 322, 332; *Lemoine v. Gauton* (1854) 2 E. D. Smith (N. Y.) 343, 348; *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277, 285; *Addington v. Cullinane* (1887) 28 Mo. App. 238, 243; *El Modello Cigar Mfg. Co. v. Gato* (1889) 25 Fla. 886, 915; *Le Page Co. v. Russia Cement Co.* (1892) 51 Fed. 941, 949.

⁴ *Marsh v. Billings* (1851) 7 Cush. (Mass.) 322, 327, 332, 333, and cases, English and American, cited; *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277, 280, 285; *Alexander v. Henry* (1895) 12 R. P. C. 360.

⁵ *The Amiable Nancy* (1818) 3 Wheat. (U. S.) 546, 556; *Day v. Woodworth* (1851) 13 How. (U. S.) 363, 370, 371; *Philadelphia, W. & B. R. Co. v. Quigley* (1858) 21 How. (U. S.) 202, 213, 214; *Emblen v. Myers* (1860) 6 Hurl. & N. 54, 60, note; *Bell v. Midland Ry. Co.* (1861) 10 C. B. (N. S.) 287, 307, 308; *Milwaukee & St. P. Ry. Co. v. Arms* (1875) 91 U. S. 489, 492, 493; *Voltz v. Blackmar* (1876) 64 N. Y. 440, 444; *Warner v. Roehr* (1884) Fed. Cas. No. 17,189a; *Missouri Pac. Ry. Co. v. Humes* (1885) 115 U. S. 512, 521; *Barry v. Edmunds* (1886) 116 U. S. 550, 562-566; *Denver & R. G. Ry. v. Harris* (1887) 122 U. S. 597, 609, 610; *Fotheringham v. Adams Express Co.* (1888) 36 Fed. 252-254; *Press Pub. Co. v. Monroe* (1896) 73 Fed. 196, 201.

⁶ *Press Pub. Co. v. Monroe* (1896) 73 Fed. 196, 201.

⁷ *Thomson v. Winchester* (1837) 19 Pick. (Mass.) 214, 216; *Crawshay v. Thompson* (1842) 4 Man. & G. 357, 5 Scott N. R. 562; *Rodgers v. Nowill* (1847) 6 Hare, 325, 5 C. B. 109, 124; *Marsh v. Billings* (1851) 7 Cush. (Mass.) 322, 332; *Lawson v. Bank of London* (1856) 18 C. B. 84, 2 Jur. (N. S.) 716; *Edelsten v. Edelsten* (1863) 1 De Gex, J. & S. 185, 189; *Hargreaves v. Smith* (1870) Cox, Man. Trade-Mark Cas. 338; *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277, 285; *Warner v. Roehr* (1884) Fed. Cas. No. 17,189a.

⁸ *Singer Mfg. Co. v. Loog* (1882) 8 App. Cas. 15, 30. But see *Embrey v. Owen* (1851) 15 Jur. 633, 637; *Marsh v. Billings* (1851) 7 Cush. (Mass.) 322, 332; *Conrad v. Joseph Uhrig Brewing Co.* (1880) 8 Mo. App. 277, 285.

Upon the question of damages, plaintiff may show his loss of custom concurrently with the infringement⁹ and defendant's fraudulent sales.¹⁰ But defendant's profits from such sales are not recoverable at law;¹¹ and as such profits may, and often do, exceed the loss or damage, susceptible of proof, incurred by the plaintiff by reason of the infringement, the defendant may be encouraged to continue his wrongdoing, notwithstanding the action at law, and particularly so in those cases in which the evidence does not warrant the recovery of exemplary damages. These facts, taken in connection with the further fact that the proceeding in equity may be commenced with an order restraining the continuance of the wrongdoing on the part of the defendant, to obtain which order it is only necessary to show that the defendant threatens to do or continue, and will, if not prevented, do or continue, an injury,¹² account, in a measure, at least, for the more frequent resort in these causes to the action in equity, rather than to the action at law.

§ 325. Recovery in Equity—English Rule.

In England the complainant or plaintiff, when he succeeds in getting an injunction, or in establishing his right to relief, is entitled and required to elect between damages and profits,¹³ and may refuse the offer by the court of a decree for

⁹ *Shaw v. Pilling* (1896) 175 Pa. 78, 84.

¹⁰ *Le Page Co. v. Russia Cement Co.* (1892) 51 Fed. 941, 949.

¹¹ *Peltz v. Eichele* (1876) 62 Mo. 171, 180; *Addington v. Cullinane* (1887) 28 Mo. App. 238. See quotations from this case ante, note 2.

¹² *McLean v. Fleming* (1877) 96 U. S. 245, 253, 254.

¹³ In *Leather Cloth Co. v. Hirschfeld* (1865) L. R. 1 Eq. 299, 301, Wood, V. C.: "The plaintiffs had their election to have taken an account of profits or of what damages had accrued, and preferred the latter alternative."

In *Lever v. Goodwin* (1887) 36 Ch. Div. 1, 7, Cotton, L. J.: "It is well known that, both in trade-mark cases and patent cases, the
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an account of the latter¹⁴ as his compensation for the wrong done by or because of the unfair competition or the infringement of his trade-mark or trade-name. If he elects the former, the chancery court will usually order an inquiry as to the damages by a special or common jury at law,¹⁵ but it may be made by such jury before the chancery court itself,¹⁶ or by such court without a jury,¹⁷ or by the judge at chambers, or by a referee in chancery.¹⁸ If he elects the latter, or should not make any election, the chancery court will award him an account of profits by a proceeding in chancery.¹⁹

§ 326. Recovery in Equity—United States Rule.

In the United States, an equity court, having once obtained full jurisdiction, both of the subject-matter and the parties, will administer full redress, including "damages and profits," technically so called, through a master in chancery, who will be instructed by the court, not only to take an account of all profits made by the defendant, but also to make an inquiry as to all damages incurred by the complainant from or be-

plaintiff is entitled, if he succeeds in getting an injunction, to take either of two forms of relief. He may either say, 'I claim from you the damage I have sustained from your wrongful act,' or 'I claim from you the profit which you have made by your wrongful act.'

Fennessy v. Rabbits (1887) 56 Law T. (N. S.) 138; *Fennessy v. Clark* (1887) 37 Ch. Div. 184, 187; *Saxlehner v. Apollinaris Co.* (1897) 66 Law J. Ch. Div. 533, 540, 541.

¹⁴ *Leather Cloth Co. v. Hirschfield* (1865) L. R. 1 Eq. 299.

¹⁵ 21 & 22 Vict. (1858) c. 27, §§ 2, 6; 25 & 26 Vict. (1862) c. 42, § 3.

¹⁶ 21 & 22 Vict. (1858) c. 27, §§ 2-4; *Sayers v. Collyer* (1881) 28 Ch. Div. 103, 107; *Dreyfus v. Peruvian Guano Co.* (1889) 42 Ch. Div. 66, 73.

¹⁷ 21 & 22 Vict. (1858) c. 27, §§ 2, 5; 25 & 26 Vict. (1862) c. 42, § 3.

¹⁸ 36 & 37 Vict. (1873) c. 66, § 56.

¹⁹ *Hills v. Evans* (1862) 8 Jur. (N. S.) 525, 531; *Cartier v. Carlile* (1862) 31 Beav. 292, 298; *Lever v. Goodwin* (1887) 36 Ch. Div. 1, 3, 7, 8; *Saxlehner v. Apollinaris Co.* (1897) 66 Law J. Ch. Div. 533, 540, 541.

cause of the wrongdoing by defendant,²⁰ the law holding the latter to be a trustee for the benefit of the former to the ex-

²⁰ Taylor v. Carpenter (1844) 11 Paige (N. Y.) 292; Burnett v. Phalon (1862) 9 Bosw. (N. Y.) 192, 206; Gillott v. Esterbrook (1867) 47 Barb. (N. Y.) 455, 471, 480; Stonebraker v. Stonebraker (1870) 33 Md. 252, 264, 269, 270; Hostetter v. Vowinkle (1871) 1 Dill. 329, 831, Fed. Cas. No. 6,714.

In Graham v. Plate (1871) 40 Cal. 593, 598, Crockett, J.: "It is evident that the profit realized by the wrongdoer is not the only measure of damages. The spurious article may have injured the credit of the genuine one, and the profits of the owner of the trade-mark may have been greatly reduced, whilst the wrongdoer has made little or no profit. But whilst the profit made by the latter does not limit the recovery, the owner of the trade-mark is entitled to all the profit which was in fact realized. In sales made under a simulated trade-mark it is impossible to decide how much of the profit resulted from the intrinsic value of the commodity in the market, and how much from the credit given to it by the trade-mark. In the very nature of the case it would be impossible to ascertain to what extent he could have effected sales, and at what prices, except for the use of the trade-mark. No one will deny that, on every principle of reason and justice, the owner of the trade-mark is entitled to so much of the profit as resulted from the use of the trade-mark. The difficulty lies in ascertaining what proportion of the profit is due to the trade-mark, and what to the intrinsic value of the commodity; and, as this cannot be ascertained with any reasonable certainty, it is more consonant with reason and justice that the owner of the trade-mark should have the whole profit than that he should be deprived of any part of it by the fraudulent act of the defendant. It is the same principle which is applicable to a confusion of goods. If one wrongfully mixes his own goods with those of another, so that they cannot be distinguished and separated, he shall lose the whole, for the reason that the fault is his, and it is but just that he should suffer the loss, rather than an innocent party, who in no degree contributed to the wrong. I think, therefore, there was no error in awarding to the plaintiff the whole profit made by the defendant. This view of the law appears to be supported by the following authorities: Coats v. Holbrook (1845) 2 Sandf. Ch. (N. Y.) 611; Upton, Trade-Marks, 245; Spottiswood v. Clark (1846) 8 L. T. 230; Cox, Man. Trade-Mark Cas. 85. But if there were no authorities on the point, every consideration of reason, justice, and sound policy demands that one who fraudulently

tent of all such profits,²¹ and, when the unlawful business is carried on in connection with the defendant's regular busi-

nesses the trade-mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade-mark, on the plea that it is impossible to determine how much of the profit is due to the trade-mark, and how much to the intrinsic value of the commodity. The fact that it is impossible to apportion the profit renders it just that he should lose the whole."

In *Sawyer v. Kellogg* (1881) 9 Fed. 601, Nixon, D. J.: "This is a motion to strike from the decree entered in the above case the clauses which direct an accounting and the payment of costs. * * * As to the accounting. The counsel for the defendant rests his application to strike out on two grounds: First. Because the proofs show that the defendant is not the person liable to account to the complainant. The evidence is that the defendant was largely engaged in packing blues on his own account and for others in the trade; that all the blues covered by the infringing trade-mark were put up by him for the firm of James S. Barron & Co., dealers in wooden ware, rope, and cordage in New York, who placed the same upon the market; that he made no sales to anyone of the articles thus packed, but received pay from his employers solely for the work and labor of packing. The bill of complaint prays for an injunction, and for profits and damages. Having been adjudged an infringer of the trade-mark of the complainant, an injunction has been issued against him. Under the above state of facts, should he be compelled to account for profits and damages? We have no doubt about the propriety of the reference, or of the liability of the defendant, if it can be shown on the accounting that profits were made by his work and labor, or that damages resulted to the complainant therefrom. If he did not sell, the profits on the sales are not chargeable to him; but if any profits came to him for preparing the article for those who did sell, they belong to the complainant, and the object of the accounting is to ascertain that fact, and, if the defendant has damaged the complainant by the unlawful use of his trade-mark, the nature and extent of the damage is a proper subject of inquiry."

In *Collins Co. v. Oliver Ames & Sons Corp.* (1832) 18 Fed. 561, 571, Blatchford, J.: "The plaintiff is entitled to a decree for a per-

²¹ *Sawyer v. Kellogg* (1881) 9 Fed. 601, 602; *Avery v. Meikle* (1887) 85 Ky. 435, 451.

ness, the same agencies being employed for both, no expenses will be deducted by the master in estimating such profits;²²

petual injunction [against the use of plaintiff's trade-mark] as prayed in the bill, and for an accounting before a master as to profits and damages, and for the costs of the suit."

In *Frazer v. Frazer Lubricator Co.* (1886) 18 Ill. App. 450, 464, Moran, J.: "The court below had jurisdiction to enter a decree for the damages. In this class of [trade-mark] cases, where the main relief sought is to restrain defendants, and protect complainants in the rights granted by the contract, the ascertaining of the profits made by the wrongdoer, or the damage done to the complainants, is treated as incidental, and it is the practice to decree the profits or damages to the complainants. *Hostetter v. Vowinkle* (1871) 1 Dill. 329, Fed. Cas. No. 6,714; *Atlantic Milling Co. v. Robinson* (1884) 20 Fed. 217. Here the damages were ascertained by agreement, and it would have been idle to send them to the law side to enter the judgment. Equity, having jurisdiction for one purpose, will administer complete relief. *Savage v. Berry* (1840) 2 Scam. (Ill.) 545; *Wade v. Bunn* (1876) 84 Ill. 120." In this last-cited case, Walker, J.: "It is one of the oldest and most familiar rules in chancery practice that when a court of equity acquires jurisdiction for one purpose, and has all parties in interest before it, the chancellor will proceed to do complete justice to all parties." *Estes v. Leslie* (1886) 27 Fed. 22, 24; *Atlantic Milling Co. v. Rowland* (1886) 27 Fed. 24, 25.

In *Avery v. Meikle* (1887) 85 Ky. 435, 442, 444, Pryor, C. J.: "The appellants maintain, as this court had determined that the simulation was intentional, the wrongful appropriation of this property right of the appellants was consummated when their plows were sold by the appellees or their agents, and the profits realized constituted the criterion of damages in equity, when no special damage was alleged or claimed by the appellants; while, on the other hand, the appellees insist that it was a mere tort, and the inquiry [as to compensation to appellants] is limited to cases where the appellees have, in selling their plows, represented them in fact to be the plows of Avery. This is the real and only issue involved in the appeal. * * * While the profits made by the wrongdoer are not, in a technical legal sense, to be termed 'damages,' still many of the text books, as well as some of the reported cases, in fixing the measure of damages in a court of equity in a case like this, say that the plain-

²² *Societe Anonyme v. Western Distilling Co.* (1891) 46 Fed. 921, 922.

and as, in any case, it cannot be ascertained with any reasonable certainty how much of the profit is due to the trade-mark, and how much to the intrinsic value of the commodity,

tiff is entitled to the profits; but not so at law,—he may there recover more or he may recover less than the profits realized. The fraud does not prevent a recovery of the profits in equity, as the plaintiff may not ask for more, or be satisfied with less.

In *Benkert v. Feder* (1888) 34 Fed. 534, 535. Sawyer, J.: "One who deliberately and knowingly uses another's trade-mark commits a palpable and unmitigated fraud, for which there is no possible excuse. He seeks to avail himself of the good reputation of another's goods, and puts his own goods—usually, if not always, of an inferior quality—upon the market, thereby not only fraudulently cutting off the market from the party who has, by years of labor, and at great expense, established a reputation for his wares, but, in addition to this injury, destroys or injures largely that reputation which is the foundation of the owner's business, by selling inferior goods under his trade-mark, thereby leading the world to believe that the inferior goods are his. To adopt as the measure of compensation for such injuries the difference between the price for which the spurious goods would sell without the trade-mark and for which they will sell with it imprinted thereon would be a mockery of justice. In my judgment the infringer should at least account for the entire profits made upon the goods wrongfully sold with the trade-mark impressed thereon. And this is the rule established, after mature consideration, in *Graham v. Plate* (1871) 40 Cal. 598; *Sawyer v. Kellogg* (1881) 9 Fed. 601. There may also be damages beyond the mere profits resulting to the owner of the trade-mark infringed, which he may recover. * * * The infringer fraudulently attaching another man's property to his own occasions only a confusion of property, with a view of taking advantage of that other's property. The trade-mark sells the whole article, however inferior or injurious in that particular, and prevents the sale of the owner's goods of equal amount. At least that is the fraudulent purpose, and the natural tendency, whether always accomplished or not; and the injured party should have at least the whole profit resulting from the wrongful act, and such I understand and hold the rule to be. The damage may be much more arising from destroying the reputation of the owner's goods."

In *Clark Thread Co. v. William Clark Co.* (1898) 56 N. J. Eq. 789, 790. Dixon, J.: "It appears in the case that the Clark Mile-End

the whole will be awarded to the plaintiff,²³ and profits recoverable in equity for unfair competition are governed by the same rule as in cases for infringement of trade-marks, and are not limited to such as accrue from sales in which it is shown that the customer is actually deceived, but include all made on the goods sold in the simulated dress or package,

Spool Cotton Company, as well as the complainant, had the right to call its product 'Clark's Thread,' and to use the word 'Clark' upon its labels, and that this right may have been violated by some of the acts of the defendant which infringed the complainant's right. In this condition of things it seems to us inequitable to hold the defendant responsible to the complainant for all the profits realized by the defendant from its wrongful conduct. Its responsibility to the complainant should be confined to such profits as were diverted from the complainant, and such damages as the complainant otherwise sustained, leaving the defendant answerable to the Mile-End company for the profits unlawfully diverted from it."

In *Worden v. California Fig Syrup Co.* (1900) 102 Fed. 334, 337, Gilbert, Cir. J.: "It is contended further that the portion of the decree which awards an accounting is erroneous, for the reason that, in a suit on a common-law trade-mark, the complainant is not entitled to recover the defendant's profits, but only his own damages, and for the further reason that in the present case the bill contains no allegation that the defendants realized any profits. The action of the court in so decreeing an accounting of the profits is not assigned as error, and we do not consider it such plain error as to require our consideration, in the absence of such assignment."

In *Williams v. Mitchell* (1901) 106 Fed. 168, 172, Per Curiam: "The complainants also assert error in that the decree denied them compensation for past unfair competition. In this respect, also, we think the court was in error. The decree declares that the defendants, by their imitation of the complainants' advertisements, had been guilty of deceiving purchasers and the public into believing that the game boards of their make were the game boards made by the complainants. It declares an invasion of the complainants' rights, and the complainants are entitled, upon proper proof, to compensation to the extent of the invasion."

²³ *Graham v. Plate* (1871) 40 Cal. 593, 598.

and in violation of the rights of the original proprietor.²⁴ Where an article put up and sold in packages simulating those of another manufacturer was manufactured by a defendant in the course of its ordinary business, and, so far as appeared, without increasing the expenses of such business, it was held that the defendant was not entitled, in an accounting for profits wrongfully obtained from the unfair competition, to an allowance for the estimated cost of manufacture as a separate business.²⁵ The foregoing applies more particularly to the federal courts and the courts of the few states which have not yet adopted codes of practice providing but one form of action—a “civil action”—for all civil remedies. By this “civil action,” however, in those states (the majority in the Union) which have adopted that practice, law and equity are administered in the same action, but separately, or distinctly,—the former with the aid of a jury, if required by either party, and the latter by the court alone, and the court in such causes will follow the rule in equity of the federal courts, and administer full redress, including damages and profits; but the duties of the “master in chancery” in the federal courts are usually performed in the state courts by a “referee” appointed by the court, and generally a special one for the particular cause at bar.²⁶ In both the federal and state courts, in such cases, the profits will be regarded as one

²⁴ *N. K. Fairbank Co. v. Windsor* (1902) 118 Fed. 96; *Lever v. Goodwin* (1887) 4 R. P. C. 507, 36 Ch. Div. 1.

²⁵ *N. K. Fairbank Co. v. Windsor* (1902) 118 Fed. 96; *Lever v. Goodwin* (1887) 4 R. P. C. 507, 36 Ch. Div. 1.

²⁶ *De Witt v. Hays* (1852) 2 Cal. 463; *New York Cent. Ins. Co. v. National Protection Ins. Co.* (1856) 14 N. Y. 85; *Phillips v. Gorham* (1858) 17 N. Y. 270; *Cole v. Reynolds* (1858) 18 N. Y. 74, 76; *Wiggins v. McDonald* (1861) 18 Cal. 126; *New York Ice Co. v. Northwestern Ins. Co. of Oswego* (1861) 23 N. Y. 357, 360; *Barlow v. Scott* (1861) 24 N. Y. 40, 45; *Bowen v. Aubrey* (1863) 22 Cal. 566, 569; *Lattin v. McCarty* (1869) 41 N. Y. 107; *Troost v. Davis* (1869) 31 Ind. 34.

element making up the final decree or (under the Code) judgment for damages.²⁷

In equity, exemplary (vindictive or punitive) damages will never be awarded or decreed. This rule was stated by Circuit Judge Morrow in a recent case as follows: "There does not appear to be any example of a case in equity in which a master, upon an accounting, has acted as a jury in a case at law, and awarded punitive damages. The complainants in the case at bar might have chosen to prosecute their rights by an action at law; but they have decided to apply for relief to a court of equity. The functions of a master on an accounting do not include the imposing of exemplary damages by way of punishment. They are confined to the estimation of the profits realized by the infringer, on the one hand, and of such damage as has been suffered by complainants, on the other, for the purpose of giving him compensation therefor. Complainants are not entitled to an award of punitive damages."²⁸ In some cases, though the complainant may obtain an injunction, neither damages nor profits will be awarded him.²⁹

²⁷ *Hostetter v. Vowinkle* (1871) 1 Dill. 329, 331, 332, Fed. Cas. No. 6,714; *Avery v. Meikle* (1887) 85 Ky. 435, 446; *El Modello Cigar Mfg. Co. v. Gato* (1889) 25 Fla. 886.

²⁸ *Hennessy v. Wilmerding-Loewe Co.* (1900) 103 Fed. 90, 95, 96.

²⁹ *McLean v. Fleming* (1877) 96 U. S. 245, 257; *Harrison v. Taylor* (1865) 11 Jur. (N. S.) 408; *Moet v. Couston* (1864) 33 Beav. 578; *Edelsten v. Edelsten* (1863) 1 De Gex, J. & S. 185; *Millington v. Fox* (1838) 3 Mylne & C. 338; *Wyeth v. Stone* (1840) 1 Story, 273, Fed. Cas. No. 18,107; *Beard v. Turner* (1866) 13 Law T. (N. S.) 747; *Estcourt v. Estcourt Hop Essence Co.* (1875) 10 Ch. App. 276, cited with approval in *McLean v. Fleming*, supra; *Low v. Fels* (1888) 35 Fed. 361; *Menendez v. Holt* (1888) 128 U. S. 514, 528; *Drummond Tobacco Co. v. Addison Tinsley Tobacco Co.* (1892) 52 Mo. App. 10, 31; *Stagg v. Taylor* (1894) 95 Ky. 651, 669; *Buchanan v. Carpenter* (1896) 19 R. I. 337, 338; *S. Howes Co. v. Howes Grain Cleaner Co.* (1898) 24 Misc. Rep. (N. Y.) 83, 85; *Clark Thread Co. v. William* (568)

§ 327. **Costs.**

In litigation concerning unfair competition, or the infringement of a trade-mark or trade-name, the ordinary rule in regard to costs is the same as that in other litigation, viz., the party successful in the main object of the litigation will recover, and the one unsuccessful therein will lose, all the costs thereof;³⁰ and this general rule is alike in the United States and England.³¹

Clark Co. (1898) 56 N. J. Eq. 789, 790; *La Republique Francaise v. Schultz* (1900) 102 Fed. 153, 156; *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.* (1901) 106 Fed. 498.

³⁰ *Millington v. Fox* (1838) 3 Mylne & C. 338; *Volger v. Force* (1901) 63 App. Div. (N. Y.) 122, 125; *Taylor v. Carpenter* (1846) 2 Sandf. Ch. (N. Y.) 611, 612; *Pierce v. Franks* (1846) 15 Law J. Ch. 122; *Partridge v. Menck* (1847) 2 Sandf. Ch. (N. Y.) 622, 627; *Chappell v. Davidson* (1855) 2 Kay & J. 123, Cox, Man. Trade-Mark Cas. 136; *Burgess v. Hatley* (1858) 26 Beav. 249, 251; *Burgess v. Hills* (1858) 26 Beav. 244, 249; *Collins Co. v. Walker* (1859) 7 Wkly. Rep. 222, Cox, Man. Trade-Mark Cas. 171; *Nicholls v. Kimpton* (1887) 3 Times Law R. 674; *Burnett v. Phalon* (1861) 21 How. Pr. (N. Y.) 100, 103; *Jurgensen v. Alexander* (1862) 24 How. Pr. (N. Y.) 269, 271; *Edelsten v. Edelsten* (1863) 1 De Gex, J. & S. 185, 204.

In *Coats v. Holbrook* (1845) 2 Sandf. Ch. (N. Y.) 586, 598, Sandford, Asst. V. C.: "The question of costs remains to be disposed of. There was no occasion for the complainants to apply to the defendants before filing their bill. They found the latter participating in a gross violation of their rights, under circumstances where it was not supposable that the defendants were ignorant of the wrong. The same consideration shows that the litigation cannot be deemed to have been unnecessary. The costs subsequent to the bill and injunction stand upon a somewhat different footing from the others. The defendants had disclosed the manufacturer to the complainants' agent, and offered to give up their profits on the sale, to pay the costs up to that time, and to stipulate in writing not to sell any more of the spurious thread. If it had turned out that they were ignorant of the spuriousness of the thread which they sold, the case would have been within the opinion expressed by Lord Cottenham in *Millington v. Fox* [(1838) 3 Mylne & C. 338, 352], and I

³¹ See citations under note 1, supra.

But it has many exceptions in both countries, which, in each case, and without regard to the success or failure of the main

think they would have been relieved from the subsequent costs. But the offer was not made until about the time the answer was due; in fact, it was on the day the answer was filed. It was not accompanied with a proffer of a perpetual injunction, to which the complainants were entitled, and for which the proposed stipulation was not a reasonable substitute, but it required the bill to be dismissed. And finally it turns out by the answer that the defendants were not guiltless of abetting McGregor's fraud. I cannot, under these circumstances, relieve them from any part of the costs."

In *McAndrew v. Bassett* (1864) 10 Jur. (N. S.) 492, 495, Wood, V. C.: "Then the only question that remains is the question of costs. Undoubtedly, I should not have given any costs at all if the defendants had simply said, in the first instance, coupled with the letter they wrote: 'You have filed this bill, and we will submit at once. We will put an end to the litigation, and pay the costs up to this time;' or, if they had told the whole history, as they did frankly in that letter, though it did not reach the plaintiffs for some time afterwards, as it happened, also, singularly enough, in *Millington v. Fox*, and had accompanied that letter either with an offer to pay the little trifling expenses which had then been incurred, or had said, 'We ask you to let this case now be argued before the court upon the question of costs, we giving you everything else you want,' although they could not have compelled the plaintiffs to accept that offer. I think the court would have stopped the costs from that time up to the hearing. But the case has been brought to a hearing, and I think the party who has taken the chance of the argument, and who loses, must pay the costs." *Field v. Lewis* (1867) Cox, Man. Trade-Mark Cas. 280, Seton (4th Ed.) 237; *Tonge v. Ward* (1869) 21 Law T. (N. S.) 480.

In *Bass v. Dawber* (1869) 19 Law T. (N. S.) 626, 627, Lord Romilly: "There was a certain degree of general resemblance which made me desirous of looking into the pleadings and evidence for the purpose of seeing whether the defendants had done what could be reasonably required of them to make the distinction complete; because, if not, and if the court suspected their bona fides,—as if a man should imitate another person's label or trade-mark, and sail so near the wind as just to avoid an injunction, and do so intentionally, —though the court does not grant the injunction, it would not willingly give him any costs of the proceedings. At the same time it must be borne in mind that if a person has bona fide taken a label

object thereof, grow out of and depend upon—First, the conduct of the successful party, which may lose him a part or the

or trade-mark which does resemble the label of another person, and this is not done with the intention to deceive, the court will not require him to change it completely, because a change in a trade-mark is a serious thing. * * * Therefore I think the plaintiffs must pay the defendants their costs of the suit, and accordingly I dismiss the bill, with costs." *Wheeler & Wilson Mfg. Co. v. Shakespear* (1870) 39 Law J. Ch. 36, 41; *Upmann v. Elkan* (1871) 7 Ch. App. 130, 133, 134; *Neilson v. Betts* (1871) L. R. 5 H. L. 1, 27.

In *Weed v. Peterson* (1872) 12 Abb. Pr. (N. S.; N. Y.) 178, 180, Learned, J.: "I think, therefore, that the plaintiffs should have a permanent injunction, as prayed for, and that they should recover costs; but I do not think that they are entitled to any damages, and in that respect the prayer of the complaint is denied." *Moet v. Pickering* (1878) 8 Ch. Div. 372, 375.

In *Sawyer v. Kellogg* (1881) 9 Fed. 601, 602, Nixon, J.: "This is a motion to strike from the decree entered in the above case the clauses which direct an accounting and the payment of costs. * * * As to the matter of costs. We find nothing in this case to take it out of the ordinary rule that a decree for an infringement and an injunction carries costs. The only reason suggested by the counsel for the defendant was that no demand was made before suit that the defendant should cease to use the label. We have never understood that, in such cases, a demand was necessary, nor that an infringer, who stoutly contests the suit to the end, should be relieved from the payment of the costs which have been incurred in consequence of his wrongdoing and his litigation. The motion to strike out is overruled, but, under the circumstances, without costs, on the motion, to the complainants." *Upmann v. Forester* (1883) 24 Ch. Div. 231, 237; *Collins Co. v. Oliver Ames & Sons Corp.* (1882) 18 Fed. 561, 571; *In re Kuhn & Co.'s Trade-Marks* (1878) 53 Law J. Ch. 238; *Fennessy v. Day* (1886) 55 Law T. (N. S.) 161; *Putnam Nail Co. v. Dulaney* (1891) 149 Pa. 205, 213; *Hennessey v. Budde* (1897) 82 Fed. 541, 542.

In *Woolf v. Woolf* (1899) 68 Law J. Ch. Div. 82, 83, Kekewich, J.: "There is something, to my mind, inconsistent with strict law and common fairness in saying that you may pronounce a decree against an infant, but cannot follow it by ordering him to pay the costs. The question is whether I am prevented in law from doing that which I think common fairness dictates to be right. I have here a case of a man endeavoring to pass off goods as those of the plaintiff. There are cases which show that an infant has been ordered

whole of the costs;³² second, the conduct of the unsuccessful party, which may save him a part or the whole of the costs;³³

to pay costs." The court cites and discusses *Chubb v. Griffiths* (1865) 35 *Beav.* 127; *Lempriere v. Lange* (1879) 12 *Ch. Div.* 675; *Cory v. Gertcken* (1816) 2 *Madd.* 40; *In re Jones* (1881) 50 *Law J. Ch.* 673, 18 *Ch. Div.* 109.

In *Hennessy v. Wilmerding-Loewe Co.* (1900) 103 *Fed.* 90, 96, *Morrow, Cir. J.*: "Respondent contends that it ought not to be compelled to pay the costs of the accounting, upon the ground that its infringement was inadvertent, and that it discontinued such infringement directly it was notified by complainants. The alleged inadvertence of the infringement has been completely disposed of by the report of the master adversely to respondent's contention. * * * There has been no formal submission on the part of the respondent, accompanied by an offer to pay the accrued costs, and the facts do not warrant any departure from the ordinary rule that the losing party pays all costs. The report of the master will therefore be confirmed, and the costs on accounting will be taxed in favor of complainants."

³² *Rodgers v. Nowill* (1847) 6 *Hare*, 325, 338, 339; *Burnett v. Phalon* (1861) 12 *Abb. Pr. (N. Y.)* 186; *Upmann v. Elkan* (1871) 7 *Ch. App.* 130, 133, 134; *Tallcot v. Moore* (1875) 6 *Hun (N. Y.)* 106, 109; *McLean v. Fleming* (1877) 96 *U. S.* 245, 258; *Hostetter Co. v. Van Vorst* (1894) 62 *Fed.* 600; *Saxlehner v. Apollinaris Co.* (1897) 66 *Law J. Ch. Div.* 533, 539, 541.

In *Millington v. Fox* (1838) 3 *Mylne & C.* 338, 352, 354, *Lord Cottenham*: "In short, it does not appear to me that there was any fraudulent intention in the use [by defendants] of the marks. That circumstance, however, does not deprive the plaintiffs of their right to the exclusive use of those names: and therefore I stated that the case is so made out as to entitle the plaintiffs to have the injunction made perpetual. * * * The question remains, what is to be done as to the costs? Now, the question of costs in chancery is left to the discretion of the court. That discretion ought to be exercised, as far as possible, according to some principle: and I am very much disposed, as a general rule, to make the costs follow the result, because, however doubtful the title may be, or however proper it may be to dispute it, it is but fair that the party who really has the right should be reimbursed, as far as giving him the costs of the suit can reimburse him. But then there is another object which the court must keep in view, namely, to repress unnecessary litigation, (572)

third, the conduct of both parties, which may divide, in some proportion, the costs between them, or prevent the allowance of costs to either.³⁴

and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights. * * * The [defendants'] letter, therefore, was an entire abandonment of that which constituted the plaintiffs' demand; and it also states that, as to what had passed,—ignorantly as they say,—they were willing to make compensation for any injury which the plaintiffs might have sustained through the use of the marks in question by the defendants. It therefore gave the plaintiffs everything which they did or could ask for by the suit which they had instituted when the letter was received, but which they had not instituted when the letter was sent. * * * Now, I say that, having received that letter, it was not proper for the plaintiffs to apply *ex parte* for the injunction; or, if they had obtained an order for it, they should not have drawn up the order. That letter made it, as to costs, at least, incumbent upon the plaintiffs to put to the test whether the defendants were sincere in their offer, and not to go on with the suit unless they found that they were insincere. The injunction was obtained, and has not been displaced. No attempt has been made by the defendants to displace it. That is quite consistent with what is stated in their answer, and in the letter to which I have referred. For what purpose, then, was the suit prosecuted? Why, simply and only for the sake of the account, which is so small that the plaintiffs abandon it at the hearing. Here, then, has been a very expensive suit, with no possible object but the account, which, when the cause comes on for hearing, the plaintiffs' counsel very properly abandons. Now, under these circumstances, I think that a great deal of very useless litigation has been carried on, and that a great deal of very improper expense has been incurred. It strikes me, therefore, that this is exactly a case in which the court is repressing useless litigation by refusing the plaintiffs the costs of the cause. They waive the account. They must have a perpetual injunction against the use of the marks in question, but without the costs of the cause."

³⁴ *Millington v. Fox* (1838) 3 Mylne & C. 338; *McAndrew v. Bassett* (1864) 10 Jur. (N. S.) 492; *Barnett v. Leuchars* (1865) 13 Law T. (N. S.) 495, 496; *Devlin v. Devlin* (1877) 69 N. Y. 212, 215; *Wharton v. Thurber* (1879) Cox. Man. Trade-Mark Cas. 663; *American Tobacco Co. v. Guest* [1892] 1 Ch. 630, 633; *Saxlehner v. Eisner* (1898) 88 Fed. 61, 70.

In *Lever Bros. v. Smith* (1902) 112 Fed. 998, 1000. Townsend.

In adjudications with regard to costs, particularly in these exceptional cases, by the chancery courts of England, the

D. J.: "An order may be entered for an injunction restraining the defendant. * * * In view, however, of the fact that, prior to this suit, defendant had discontinued the use of the more objectionable labels, and, further, in view of the limited amount of the present infringement, no costs should be allowed against defendant."

³⁴ *Heighington v. Grant* (1839) 1 Beav. 228, 231.

In *Fetridge v. Wells* (1857) 4 Abb. Pr. (N. Y.) 144, 156, Duer, J.: "The motion for its [the injunction's] dissolution is, however, granted without costs, since, although the plaintiff might be justly required to pay costs, the defendants have certainly no title to receive them. They represent Rice, whose conduct and proceedings have been just as blamable as those of the plaintiff,—there is not a shade of difference between them."

Farina v. Silverlock (1858) 4 Kay & J. 650, 651; *Moet v. Couston* (1864) 33 Beav. 578, 581; *Nunn v. D'Albuquerque* (1865) 34 Beav. 595, 597; *Hudson v. Bennett* (1866) 12 Jur. (N. S.) 519, 520; *De Vitre v. Betts* (1873) L. R. 6 H. L. 319, 327; *Estcourt v. Estcourt Hop Essence Co.* (1875) 10 Ch. App. 276, 281; *Compagnie Laferme v. Hendrickx* (1876) Cox, Man. Trade-Mark Cas. 512; *Loveridge v. Larned* (1881) 7 Fed. 294; *Newman v. Pinto* (1887) 4 R. P. C. 508, 57 Law T. (N. S.) 31; *American Box Mach. Co. v. Crosman* (1893) 57 Fed. 1029, 1030.

In *Bass, Ratcliff & Gretton v. Guggenheimer* (1895) 69 Fed. 271, Morris, D. J.: "By this prompt acquiescence in the complainant's demands, and the offer at once to surrender the lithographic stone, and the promise to respect the complainant's rights, the complainant obtained all it was entitled to obtain by an injunction. The complainant, for reasons of its own, has preferred, notwithstanding, to file a bill and obtain an injunction, and to have the lithographic stone given up under order of the court. It is a sound rule, for the prevention of unnecessary litigation, and to encourage parties who have ignorantly, and without bad faith, infringed a trade-mark, to promptly desist, without suit, upon being notified, that where a complainant had already obtained, before entering suit, by the prompt acquiescence of the defendant, all that an injunction can give him, he should not recover costs. I think the present is a case proper for the application of this rule. The decree will provide that each party shall pay their own costs." *Willis v. Terry* (1899) 98 Fed. 8.

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question of costs in chancery being left to their discretion,³⁵ more strictness is exercised than in the United States in the direction, and evidently for the purpose, of discouraging unnecessary litigation.³⁶

In the United States, the courts have discretion as to costs in equity.³⁷

Upon the question of nonallowance of costs in cases where the court decides adversely to its jurisdiction, the rule varies in different states, and in the federal courts, ordinarily, costs are not allowed; but exceptions are found even there.³⁸ As

³⁵ *Millington v. Fox* (1838) 3 Mylne & C. 338.

³⁶ *Millington v. Fox* (1838) 3 Mylne & C. 338; *Burgess v. Hately* (1858) 26 Beav. 249, 251; *Burgess v. Hills* (1858) 26 Beav. 244, 246, 248, 249; *Saxlehner v. Apollinaris Co.* (1897) 66 Law J. Ch. Div. 533, 539, 541.

³⁷ *Du Bois v. Kirk* (1895) 158 U. S. 58; *Pennsylvania Co. for Ins. on Lives & Granting Annuities v. Jacksonville, T. & K. W. Ry. Co.* (1895) 66 Fed. 421, 422; *Supreme Council, L. H., v. Nidelet* (1900) 85 Mo. App. 283, 284.

In *Guernsey v. Phinizy* (1901) 113 Ga. 898, 901, *Simmons, C. J.*: "In cases in equity it is the duty of the judge to determine which party shall pay the costs, or whether he shall divide them between the parties. Civ. Code, § 4850. It is a matter within his discretion." *Roussel v. Mathews* (1901) 62 App. Div. (N. Y.) 1, 7, 8; *Pruitt v. Pruitt* (1901) 59 S. C. 509, 38 S. E. 213, 216.

³⁸ *Burnham v. Rangeley* (1847) 2 Woodb. & M. 417, Fed. Cas. No. 2,177; *Mansfield, C. & L. M. Ry. Co. v. Swan* (1884) 111 U. S. 379; *Peper v. Fordyce* (1886) 119 U. S. 469; *Blacklock v. Small* (1888) 127 U. S. 97.

In *Day v. Sun Ins. Office* (1899) 40 App. Div. (N. Y.) 305, 307, *Rumsey, J.*: "Although the courts have no jurisdiction to entertain this action, yet they have the power, where the question of the jurisdiction of the subject-matter has been presented to them, to award costs, even when they decide that they have no jurisdiction of the action. *Thiem v. Madden* (1882) 27 Hun (N. Y.) 371. Where a party brings into court a case over which the court has no jurisdiction, and the suit is dismissed for lack of jurisdiction, costs may be awarded against him, for he, by bringing his action, has submitted himself to the jurisdiction of the court. *Simmons v. Sim-*

stated by Mr. Justice Matthews in delivering the decision of the supreme court in a leading case: "Ordinarily, by the long-established practice and universally recognized rule of the common law, in actions at law, the prevailing party is entitled to recover a judgment for costs, the exception being that, where there is no jurisdiction in the court to determine the litigation, the cause must be dismissed for that reason, and, as the court can render no judgment for or against either party, it cannot render a judgment even for costs."³⁹

mons (1884) 32 Hun (N. Y.) 551. The affirmance, therefore, must be with costs against the plaintiff." Affirmed (1901) 167 N. Y. 543.

³⁹ Mansfield, C. & L. M. Ry. Co. v. Swan (1884) 111 U. S. 379, 387. (576)

CHAPTER XV.

TRADE-MARK LEGISLATION.

- § 328. The Federal Act of 1870.
- 329. The Federal Act of 1876.
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§ 328. The Federal Act of 1870.

The first law relating to trade-marks passed by congress was the act of July 8, 1870, and was entitled, "An act to revise, consolidate, and amend the statutes relating to patents and copyrights."¹ This law provided that any person

¹ Act July 8, 1870 (U. S. Stat. 198); U. S. Rev. St. 4937-4947. See Appendix, L., p. 603.

or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any state or territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty afforded similar privileges to the citizens of the United States, and who were entitled to the exclusive use of any lawful trade-mark, or who intended to adopt and use any trade-mark for exclusive use within the United States, might obtain protection for such lawful trade-mark by complying with the requirements of the statute.

§ 329. The Federal Act of 1876.

Six years later congress passed the act of August 14, 1876,² punishing by fine and imprisonment the fraudulent use, sale, and counterfeiting of trade-marks registered in pursuance of the statutes of the United States,—that is, trade-marks registered in pursuance of the act of July 8, 1870.

§ 330. The Act of 1870 Unconstitutional.

The title of the act of 1870 shows that congress regarded its enactment as an exercise of the power found in the clause of the constitution authorizing congress “to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.” The federal courts did not agree as to the validity of the statute. In one case the law was held constitutional, and was sustained.³ In another the contrary was held.⁴ In the Trade-Mark Cases⁵

² Act Aug. 14, 1876 (19 Stat. 141). See Appendix I., p. 607.

³ *Duwel v. Bohmer* (1878) 14 Off. Gaz. 270. Cox, Manual Trademark Cas. 613, Fed. Cas. No. 4,213.

⁴ *Leidersdorf v. Flint* (1878) 8 Biss. 327, Cox, Manual Trademark (578)

the question came before the supreme court, and the statute was declared unconstitutional and void. The court said that "any attempt to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties." The court was unable to find any authority in this clause of the constitution authorizing congress to legislate upon the subject of trade-marks. The court further held that the statute could not be sustained under the clause of the constitution authorizing congress to regulate commerce, as the statute provided for the registration of trade-marks generally, without reference to the species of commerce in which they were used, while the constitutional provision was limited to "commerce with foreign nations, and among the several states and with the Indian tribes." The court expressed no opinion as to whether the act would have been valid if it had provided only for the registration of trade-marks, used only in such commerce as congress was empowered to regulate.

§ 331. Act of 1876 Fell with Act of 1870.

The criminal offenses described in the act of 1876 were by express terms limited to frauds, counterfeits, and the unlawful use of trade-marks which were registered under the provisions of the former statute. As that statute was unconstitutional, so that registration under it conferred no lawful right, it followed that the criminal statute intended to protect that right must necessarily fall with it, and it was so held by the supreme court. When the act of 1881

Cas. 629, Fed. Cas. No. 8,219; *Day v. Wells* (1878) 35 Leg. Int. 468, Fed. Cas. No. 3,692.

⁵ *United States v. Steffens* ("The Trade-Mark Cases;" 1879) 100 U. S. 82.

was passed, the position was taken by some members of the bar that the act of 1876 was revived, and that its provisions would then apply to trade-marks registered under the new statute,⁶ but this contention was finally laid to rest by a decision of Justice Brewer, sitting in the circuit court.⁷ In the opinion filed in that case it is said: "When the act of 1881 was passed, if congress had intended that penalty should be imposed for a trespass upon the rights conferred by that statute, or if it had intended that the act of 1876 should be revived and operate upon the act of 1881, it was very easy to say so. Its silence in this respect is cogent evidence that it did not understand or intend that the penal statute should be considered a part of present and valid law; and that assumption is strengthened by the fact that it had before it for consideration this passage from the opinion of the supreme court, in which it is broadly stated that the act of 1876 had fallen with the act of 1870. Whatever may be true as to the full meaning of that decision, or as to the general power of congress to impose penalties for trespasses upon rights having no existence, it had before it the general affirmance by the court that the law of 1876 had fallen; and it must be assumed that, if it meant that it should stand and be revived, or that any penalties should be imposed for violations of the law of 1881, it would have so stated. These considerations convince me very strongly that the act of 1876 has, as the supreme court said, fallen with the act of 1870, and it is as much a dead letter as the act of 1870, and was not revived or given operative force by the act of 1881."

⁶ Browne, Trade-Marks, § 271.

⁷ United States v. Koch (1889) 40 Fed. 250. See United States v. Braun and United States v. Sohn (1889) 39 Fed. 775; Elgin Nat. Watch Co. v. Illinois Watch Case Co. (1901) 179 U. S. 665. See 26 (580)

§ 332. The Federal Act of 1881—The Present Law.

After the decision of the supreme court in the Trade-Mark Cases, congress passed the act of 1881, which permits registration by "owners of trade-marks used in commerce with foreign nations or with the Indian tribes."⁸ This act has ever since been treated as valid.⁹ In the Elgin Watch Case,¹⁰ however, in the United States circuit court of appeals for the Seventh circuit, Judge Jenkins said: "There has been no ruling upon the constitutionality of this act, and it need only be said that its validity is fairly doubtful." It has also been said that "registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trade-mark, or in cases where it is necessary to give jurisdiction to the United States courts."¹¹

§ 333. Duty of Commissioner of Patents.

The statute does not make the patent office merely a registration office, and compel the commissioner to register a trade-mark presented for registry without permitting him to pass upon its lawfulness as a trade-mark,¹² but it is the duty of the commissioner, in considering an application for regis-

Am. & Eng. Enc. Law, 484, note 1, for an argument that the courts erred in holding that the act of 1876 fell with the act of 1870.

⁸ Act March 3d, 1881 (21 Stat. 502). See Appendix I, p. 610.

⁹ *Hennessy v. Braunschweiger* (1898) 89 Fed. 666; *South Carolina v. Seymour* (1894) 153 U. S. 353; *Luyties v. Hollender* (1884) 21 Fed. 281; *Schumacher v. Schwencke* (1886) 26 Fed. 818.

¹⁰ *Illinois Watch Case Co. v. Elgin Nat. Watch Co.* (1899) 35 C. C. A. 237, 94 Fed. 667.

¹¹ *Hennessy v. Braunschweiger* (1898) 89 Fed. 668; *Einstein v. Sawhill* (1893) 2 App. D. C. 10, 65 Off. Gaz. 1918.

¹² *Ex parte Buffalo Pitts Co.* (1899) 89 Off. Gaz. 2069; *United States ex rel. Buffalo Pitts Co. v. Duell* (1900) 93 Off. Gaz. 1491; *United States ex rel. Bronson Co. v. Duell* (1900) 93 Off. Gaz. 1491; *United States v. Seymour* (1894) 66 Off. Gaz. 1167.

tration, to determine whether or not the mark presented is a lawful trade-mark, and the performance of this duty involves discretion.¹³

§ 334. Owners of Trade-Marks.

The registry of a trade-mark under the act of 1881 confers no property rights similar to those acquired under the patent or copyright laws, which are grants by the United States, but merely brings pre-existing rights, which the proprietor of a trade-mark may have at common law, within the cognizance of federal courts in cases wherein it is alleged in the pleadings that such trade-mark is used in connection with commerce with foreign nations or Indian tribes.¹⁴ The act in terms gives the right of registration only to "owners of trade-marks." It adds nothing to the right of ownership therein, and it takes nothing from such ownership. As said by the court of appeals of the District of Columbia: "The owners of trade-marks who, by the first section [of the act of 1881], are permitted to obtain registration of the same, are those that, in the manner and under the conditions prescribed, shall have used such words and symbols only as at common law are susceptible of exclusive appropriation as trade-marks."¹⁵ It is essential, therefore, that the applicant for registration possess the legal title to that for which registration is sought, and also that it be a "trade-mark."¹⁶

¹³ United States v. Duell (1901) 95 Off. Gaz. 229.

¹⁴ Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 93 Fed. 624; Schumacher v. Schwencke (1886) 26 Fed. 818; Graveley v. Graveley (1890) 42 Fed. 265.

¹⁵ United States v. Duell (1901) 95 Off. Gaz. 229. See, also, *Ex parte Buffalo Pitts Co.* (1899) 89 Off. Gaz. 2069; *United States ex rel. Buffalo Pitts Co. v. Duell* (1900) 93 Off. Gaz. 1491; *United States ex rel. Bronson Co. v. Duell* (1900) 93 Off. Gaz. 1491.

¹⁶ *Ex parte Bronson Co.* (1899) 87 Off. Gaz. 1782; *Ex parte Buffalo Pitts Co.* (1899) 89 Off. Gaz. 2069; *Brower v. Boulton* (1892) 53 Fed. (582)

The statute does not define the term "trade-mark," or say of what it shall consist. The term is used as though its signification was already known to the law. It speaks of it as an already existing thing, and protects it as such.¹⁷ As said by the supreme court in the *Elgin Watch Case*:¹⁸ "Trade-marks are not defined by the act, which assumes their existence and ownership, and provides for a verified declaration by applicants for registration that they have the exclusive right to the particular trade-mark sought to be registered." Hence, where all the parties to a suit were residents of the same state, and the mark registered (the geographical word "Elgin") was not a lawful trade-mark, it was held that a United States circuit court did not have jurisdiction. The right to a trade-mark is a common-law right, and the patent office, under the act of 1881, is only given authority to register lawful trade-marks under the restrictions imposed by the statute.¹⁹ An association or league of flour manufacturers, all members of which apply a certain mark to their product to indicate that the product is made by a member of the association, is not the owner of a trade-mark, and hence not entitled to register such mark.²⁰ In deciding this case the commissioner of patents said: "I can find no authority in the trade-mark act permitting

389; *La Croix v. May* (1883) 15 Fed. 236; *United States v. Roche* (1879) 1 McCrary, 385, Fed. Cas. No. 16,180; *Oakes v. St. Louis Candy Co.* (1898) 146 Mo. 391; *Hennessy v. Braunschweiger* (1898) 89 Fed. 664.

¹⁷ *Moorman v. Hoge* (1871) 2 Sawy. 78, Fed. Cas. No. 9,783. This case was decided under the act of 1870, but the language used in the decision is equally applicable to the act of 1881.

¹⁸ *Elgin Nat. Watch Co. v. Illinois Watch Case Co.* (1901) 179 U. S. 665, 21 Sup. Ct. 271. See chapter 1, § 1.

¹⁹ *Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co.* (1898) 85 Off. Gaz. 1905.

²⁰ *Ex parte Anti-Adulteration League* (1899) 86 Off. Gaz. 1803.

this office to register a trade-mark, the right to use which is farmed out, and which is not actually used by the would-be registrant." A union of workingmen, such as the Cigar Makers' International Union, which neither makes nor sells goods, but which seeks to promote the mental, moral, and physical welfare of its members, cannot be the owner of a trade-mark. Registration of a union label, adopted by it and placed upon goods to indicate that they were made by members of the union, is not authorized by the act of congress of 1881, and, if such registration is granted, it confers no title and gives no standing ground in a court of equity.²¹

§ 335. Commerce with Foreign Nations and Indian Tribes.

The only trade-marks that can be registered under the act of 1881 are those used in two classes of commerce,—(1) commerce with foreign nations, and (2) commerce with the Indian tribes. There is no provision for registration of trade-marks used in state or inter-state commerce. A trade-mark that has been in undisputed use for years in domestic trade, and invested with all the characteristics of a trade-mark at common law, is, nevertheless, not a trade-mark in the sense of this statute, unless it has been lawfully used in commerce with foreign nations or the Indian tribes,²² and the registration of a trade-mark in the patent office does not affect those not engaged in commerce with foreign nations or Indian tribes with notice thereof.²³

²¹ *McVey v. Brendel* (1891) 144 Pa. 235. See chapter 4, § 85.

²² *Ex parte State of South Carolina* (1893) 64 Off. Gaz. 1395; *Seymour v. United States* (1894) 2 App. D. C. 240, 66 Off. Gaz. 1167; *Ryder v. Holt* (1888) 128 U. S. 525; *Sarrazin v. W. R. Irby Cigar & Tobacco Co.* (1899) 35 C. C. A. 496, 93 Fed. 624; *Glen Cove Mfg. Co. v. Ludeling* (1885) 22 Fed. 823.

²³ *Brennan v. Emery-Bird-Thayer Dry Goods Co.* (1900) 99 Fed. 971.

§ 336. Domicile of Owner.

To be entitled to registration under the statute, the owner of the mark must either be domiciled in the United States or located in a foreign country or tribe, which by treaty, convention, or law affords similar privileges to citizens of the United States.²⁴

§ 337. Name of Applicant.

The statute prohibits the registration of a mark "which is merely the name of the applicant." Under the later decisions of the patent office, this prohibition is construed to extend to a word which forms a part of the name of the applicant; thus, where *Adriance, Platt & Co.* sought to register as a trade-mark the word "Adriance," registration was refused, although the name was used together with a symbolic representation.²⁵ Where the *F. H. Gilson Company* sought to register the word "Gilson," registration was refused, the commissioner saying: "The trade-mark act under which registry is sought distinctly states that no trade-mark shall be registered which is merely the name of the applicant. This would seem to be controlling, for the trade-mark here sought to be registered is the essential feature of applicant's name. The fact that the word 'Gilson' is not the full name of the corporation, but only a portion of it, is to my mind immaterial."²⁶ Many other decisions of the commissioner of patents are to the same effect.²⁷

²⁴ See Appendix, I., p. 610.

²⁵ *Ex parte Adriance* (1881) 20 Off. Gaz. 1820.

²⁶ *Ex parte F. H. Gilson Co.* (1898) 83 Off. Gaz. 1992.

²⁷ *Ex parte Dalsimer* (1898) 85 Off. Gaz. 149; *Ex parte Gale Mfg. Co.* (1898) 85 Off. Gaz. 1907; *Ex parte A. Featherstone* (1899) 86 Off. Gaz. 1497; *Ex parte Guenther Milling Co.* (1899) 86 Off. Gaz. 1986; *Ex parte Buffalo Pitts Co.* (1899) 89 Off. Gaz. 2069; *Ex parte Tabor* (1901) 96 Off. Gaz. 1036; *Ex parte Edwin C. Burt Co.* (1901) 96 Off. Gaz. 1450.

§ 338. Identity with Registered or Known Trade-Mark.

The statute also prohibits the registration of a trade-mark "which is identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers." It is made the duty of the commissioner to decide the presumptive lawfulness of claim to an alleged trade-mark. Under this section of the statute there has been little uniformity in the decisions of the patent office. The degree of resemblance permitted to a registered or known trade-mark has varied according to the views of the examiner and the commissioner. According to the later practice in a borderline case, the benefit of the doubt is given to the owner of the registered mark, and the later applicant is refused registration.²⁸

§ 339. Application of Mark.

The statute requires the applicant for registration of a trade-mark to file "a statement of the mode in which the same is applied and affixed to goods." Under this provision of the statute it has been held by the commissioner of patents that it is not an essential and important prerequisite that a mark should be affixed or attached to the goods with which it is used to make it a valid trade-mark, and that it is sufficient if the mark is so associated with the goods as to distinguish them by the particular mark.²⁹ In his de-

²⁸ Ex parte Flint & Walling Mfg. Co. (1898) 85 Off. Gaz. 148; Ex parte Lefebvre (1901) 96 Off. Gaz. 841; Sherwood v. Horton (1898) 84 Off. Gaz. 2018. See Ex parte Meriwether (1898) 83 Off. Gaz. 1513; Ex parte Foley (1899) 87 Off. Gaz. 1957; Ex parte Corning (1893) 65 Off. Gaz. 751; Ex parte Woolwine (1901) 97 Off. Gaz. 1373.

²⁹ Hay & Todd Mfg. Co. v. Querns (1899) 86 Off. Gaz. 1323. See chapter 4, § 99.

cision the commissioner said: "A person acquires the right to a trade-mark by putting his merchandise upon the market marked or distinguished by his particular mark. Manifestly it is impossible to 'affix' a mark to many vendible commodities,—such, for example, as wines and liquors. It is inconvenient to affix the mark to many other articles, such as cigars and cigarettes, and the common practice is to attach the mark to the package containing the articles. In many cases, and this is one of them, it would be unjust to deprive the first to adopt and use a certain mark in connection with his merchandise of his rights thereto because he had not actually 'affixed' or 'attached' the mark to such merchandise." In this instance the mark was used in various kinds of advertisements, and representations of it were put in the boxes with the goods.

§ 340. Class of Merchandise.

While an applicant may not register a mark that is identical with or closely resembles a mark already registered by another for the same class of merchandise, there is no such prohibition as to marks used for different classes of merchandise. It becomes important, therefore, to determine what goods are to be considered as belonging to the same class. The same question also arises where it is desired to register a single mark used upon a number of articles. But little information is to be obtained upon either of these questions from the decisions of the patent office, owing to the fact that the different commissioners have held such divergent views thereon. It has been held, for instance, that the following articles are not in the same class: Cigars and cigarettes;³⁰ breakfast foods made from wheat, and flour;³¹

³⁰ Ex parte Egyptian Tobacco Co. (1898) 85 Off. Gaz. 1741.

³¹ Ex parte Cream of Wheat Co., 62 MS. Dec. Pat. Off. 329.

steamed hominy and prepared flour;³² bicycles and pneumatic tires for bicycles.³³ In other instances articles much more widely separated have been held to belong to the same class. Nor have the decisions of the courts been uniform where similar questions have arisen in connection with common-law trade-marks.³⁴ No uniform rule can therefore be drawn from the decided cases, and each instance that arises must be determined upon general principles. As said by Judge Bradford in a case involving a technical trade-mark: "Courts should not be astute to recognize in favor of an infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrongdoer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol."³⁵ The courts have held that the following articles belong to the same class: Pale ale and "half-and-half";³⁶ smoking tobacco and cigarettes;³⁷ prints and other kinds of cotton goods;³⁸ "straight" whiskey and "blended" whiskey;³⁹ but that the following articles belong to different classes: Prints of the kind known as "heliotypes," and prints of other descriptive properties;⁴⁰ paint composed of a white oxide of zinc ground in oil and white oxide of zinc.⁴¹

³² Ex parte Western New York Preserving & Manufacturing Co. (1896) 59 MS. Dec. Pat. Off.

³³ Ex parte Consolidated Rubber Works (1897) 62 MS. Dec. Pat. Off. See Diamond Ink Co. v. Day (1896) 60 MS. Dec. Pat. Off.

³⁴ See chapter 4, § 96, and chapter 9, § 202.

³⁵ Bass, Ratcliff & Gretton v. Feigenspan (1899) 96 Fed. 206.

³⁶ Bass, Ratcliff & Gretton v. Feigenspan (1899) 96 Fed. 206.

³⁷ Carroll v. Ertheiler (1880) 1 Fed. 688.

³⁸ Amoskeag Mfg. Co. v. Garner (1876) 54 How. Pr. (N. Y.) 297.

³⁹ White v. Miller (1892) 50 Fed. 277.

⁴⁰ Osgood v. Rockwood (1873) 11 Blatchf. 310, Fed. Cas. No. 10,605.

⁴¹ La Societe Anonyme des Mines v. Baxter (1877) 14 Blatchf. 261, Fed. Cas. No. 8,099. See ex parte Faxon (1903) 103 Off. Gaz. 891.

§ 341. Descriptive Words not Registrable.

On the ground that they cannot be lawful trade-marks at common law, descriptive words are refused registration by the patent office.⁴² Words, however, that are merely suggestive of some quality or characteristic of the article to which they are applied may be common-law trade-marks, and are therefore entitled to registration.⁴³ Descriptive words not otherwise registrable do not become so by misspelling them and misplacing capitals;⁴⁴ or when produced in Hebrew characters;⁴⁵ or by being rearranged;⁴⁶ or by being combined with other nonregistrable words.⁴⁷

§ 342. Geographical Words not Registrable.

It being the duty of the patent office to register only marks that are, at common law, lawful trade-marks, and, under the decisions of the courts, geographical words being incapable of appropriation as trade-marks, it follows that such words are not entitled to registration under the statute, even when

⁴² Ex parte Spayd (Bromo Soda Mint; 1898) 86 Off. Gaz. 631; Ex parte G. F. Heublein (Apple and Honey; 1899) 87 Off. Gaz. 179; Ex parte Bronson Co. (Ever-Ready; 1899) 87 Off. Gaz. 1782; Ex parte Krusius (Barber's Model; 1898) 82 Off. Gaz. 1687; Ex parte Capital City Dairy Co. (Purity; 1898) 83 Off. Gaz. 295; Ex parte Ervin A. Rice Co. (Better Than Mother's; 1898) 83 Off. Gaz. 1207.

⁴³ Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co. (Kofflo; 1898) 85 Off. Gaz. 1905; Ex parte Peek (Waukeasy; 1901) 96 Off. Gaz. 425.

⁴⁴ Ex parte Henderson (Kid-Nee-Kure; 1898) 85 Off. Gaz. 453; Ex parte Miller (Fitmeeasy; 1901) 95 Off. Gaz. 1452; Ex parte Seager (Kas-K-Rilla; 1901) 97 Off. Gaz. 749.

⁴⁵ Ex parte Stuhmer (Gold Label; 1898) 86 Off. Gaz. 181.

⁴⁶ Ex parte Hance (Chill Stop; 1899) 87 Off. Gaz. 698; Ex parte Evans (Pain-Ease; 1901) 96 Off. Gaz. 425; Ex parte Crescent Mfg. Co. (No-Rip; 1901) 97 Off. Gaz. 750.

⁴⁷ Ex parte Guenther Milling Co. (Guenther's Best; 1899) 86 Off. Gaz. 1896; Ex parte Pittsburgh Pump Co. (1898) 84 Off. Gaz. 309.

used in commerce with foreign nations and Indian tribes.⁴⁸ The rule, however, is not without some exceptions. Where, in its primary meaning, a word is not geographical, it is not rendered incapable of registration by the mere fact that it has been adopted as the name of a post office, a railway station, or even a town or village.⁴⁹ A word, however, that is used to designate a locality or section of country, whether or not that be the primary sense of the word, cannot be appropriated as a trade-mark, and should not be registered,⁵⁰ but a word symbol, to be refused registration because of its geographical character, must refer to some specific locality.⁵¹ A geographical word, not in itself registrable, will not be made registrable by printing it in any particular form of letters, by separating the letters by hyphens, or by associating with it other words which are of a descriptive character.⁵²

⁴⁸ *Elgin Nat. Watch Co. v. Illinois Watch Case Co.* (1901) 179 U. S. 665.

⁴⁹ *Ex parte Hendley* (1895) 72 Off. Gaz. 1654; *Ex parte Manogue-Pidgeon Iron Co.* (1901) 97 Off. Gaz. 2084.

⁵⁰ *Ex parte Little* (1898) 85 Off. Gaz. 1221.

⁵¹ *Ex parte Tietgens* (1899) 87 Off. Gaz. 2117.

⁵² *Ex parte Pittsburgh Pump Co.* (1898) 84 Off. Gaz. 309. The following words have in recent years been refused registration on the ground of being geographical: "Yucatan," for leather and leather goods (*Ex parte Weil* [1898] 83 Off. Gaz. 1802); "Aurora," for boots and shoes (*Ex parte Little* [1898] 85 Off. Gaz. 1221); "Gibraltar," for lamp chimneys (*Ex parte Nave & McCord Mercantile Co.* [1899] 86 Off. Gaz. 1985); "The Roman," for knit underwear (*Ex parte Rome Textile Co.* [1900] 91 Off. Gaz. 820); "St. Johnsbury," for crackers (*Ex parte Cross* [1901] 96 Off. Gaz. 643); "Yale," for belt-supporters (*Ex parte Peats* [1901] 96 Off. Gaz. 1649); "Mobile," for playing cards (*Ex parte United States Playing Card Co.* [1901] 96 Off. Gaz. 1855). The following words, refused registration by the examiner on the ground that they were geographical, have been admitted to registration by the commissioner: "Hansa," for lard, etc. (*Ex parte Tietgens* [1899] 87 Off. (590))

§ 343. Trade-Mark Used on Patented Article.

Since the decision of the supreme court in the Singer Case, the patent office has held that a trade-mark used upon a patented article cannot be registered, for the reason that the trade-mark would become public property upon expiration of the patent, and, as a patent has a shorter term than a trade-mark certificate, the registering of the mark for thirty years would be a fraud upon the public. In one case the commissioner said: "In view of the fact that, under the trade-mark act of 1881, a certificate of registry remains in force for thirty years from its date (with certain exceptions, unnecessary to be here considered), I do not think that this office should register trade-marks which, though lawful trade-marks at the date when registry is sought, will become public property before the expiration of the thirty years. By so doing, the patent office would be placed in the light of attempting to aid in prolonging a monopoly, which manifestly, under the decisions of the courts, is unwarranted."⁵³ And in another case it was said by the same commissioner: "I apprehend that, in order to bring the case within the authority of *Singer Mfg. Co. v. June Mfg. Co.*, it is not necessary that the patents should be owned by the party putting out the article under the identifying or genuine name, but that it is sufficient if such name is given to the patented article with the consent, either express or tacit, of

Gaz. 2117); "Delta," for hardware (Ex parte Manogue-Pidgeon Iron Co. [1901] 97 Off. Gaz. 2084); "Dover," for egg beaters (Ex parte Dover Stamping Co. [1890] 51 Off. Gaz. 1784); "Vienna," for flour (Ex parte Jenkins [1890] 53 Off. Gaz. 759); "Florentine," for glass (Ex parte Mississippi Glass Co. [1893] 64 Off. Gaz. 713); "Waverley," for bicycles (Ex parte Indiana Bicycle Co. [1895] 72 Off. Gaz. 1654); "Menlo Park," for watch movements (Ex parte Hampden Watch Co. [1897] 81 Off. Gaz. 1282).

⁵³ Ex parte Velvrii Co. (1898) 84 Off. Gaz. 807. See also, Ex parte F. H. Gilson Co. (1898) 83 Off. Gaz. 1992.

the inventor."⁵⁴ It is to be doubted whether this position is sound. As the registration of a trade-mark is a mere act of record, and as, in the case of a trade-mark used to designate a patented article, the trade-mark is valid at least until the expiration of the patent, there would seem to be no good reason for refusing registration at any time before the expiration of the patent. The certificate of registration is not a grant for thirty years, or for any period, and the fact that the trade-mark will become dedicated to the public by expiration of the patent is not, it is believed, a valid ground for refusing registration.

§ 344. Construction of Application.

Where an application for registration of a trade-mark stated that the trade-mark consisted essentially of the illustration of a boy suffering from cramps, with the words "Cramp cure" arranged below the illustration, and forming part of the phrase, "Cramp cure for every ache or pain," and the application also stated that the descriptive matter might be altered or omitted at pleasure without affecting the character of the trade-mark, it was held that the trade-mark consisted in the design of the suffering boy, and that the words "Cramp cure" formed no part thereof.⁵⁵ And where the essential feature of a trade-mark was described as the representation of a red anchor in an oval space, it was held that the registration was not proof of an intention to adopt as a trade-mark the word "Anchor," and the symbol of an anchor, irrespective of color and surroundings.⁵⁶ A per-

⁵⁴ *Ex parte Horlick's Food Co.* (1898) 84 Off. Gaz. 1870.

⁵⁵ *L. H. Harris Drug Co. v. Stucky* (1891) 46 Fed. 624.

⁵⁶ *Richter v. Anchor Remedy Co.* (1892) 52 Fed. 455, affirmed *Richter v. Reynolds* (1893) 8 C. C. A. 220, 59 Fed. 577. See *Kohler Mfg. Co. v. Beshore* (1892) 53 Fed. 262; affirmed (1893) 8 C. C. A. 215, 59 Fed. 572. See, also, chapter 1, § 21.

son who, in his application to the United States patent office for registration of his trade-mark, alleged that he first used it on a certain date, cannot maintain an action for an injunction and damages against one who adopted and used the same mark prior to such date.⁵⁷

§ 345. Infringing Use of Registered Trade-Mark.

The use of a registered trade-mark upon any goods except those intended for transportation to a foreign country or for commerce with the Indian tribes is not an infringement of the rights secured to the registrant by the statute.⁵⁸

§ 346. Registration only Prima Facie Evidence of Ownership.

Under the act of 1881, the registration of a trade-mark is only *prima facie* evidence of ownership, and is not conclusive or binding on the courts as to the right of the registrant to its exclusive use.⁵⁹

§ 347. Interferences.

The commissioner is authorized to decide the presumptive lawfulness of claim to a trade-mark, and, in case of dispute between an applicant and a previous registrant, or between registrants, he is directed to follow, as far as the same may be applicable, the practice of courts of equity of the United States in analogous cases. Under this section of the statute the commissioner is authorized to declare interferences

⁵⁷ Hyman v. Solis Cigar Co. (1894) 4 Colo. App. 475, 36 Pac. 444.

⁵⁸ Brennan v. Emery-Bird-Thayer Dry Goods Co. (1900) 99 Fed. 971; Luyties v. Hollender (1884) 21 Fed. 281; Schumacher v. Schwencke (1886) 26 Fed. 818; Graveley v. Graveley (1890) 42 Fed. 265; Sarrazin v. W. R. Irby Cigar & Tobacco Co. (1899) 93 Fed. 624.

⁵⁹ Glen Cove Mfg. Co. v. Ludeling (1885) 22 Fed. 823; Hennessy v. Braunschweiger (1898) 89 Fed. 664. See United States v. Braun (1889) 39 Fed. 775.

between an applicant and a registrant, or between two or more applicants, claiming the same mark for the same class of goods.⁶⁰ The result of registration between two interfering applicants, or between an applicant and a registrant, belongs to the one who, if a party to a suit in equity, would be adjudged the owner of the trade-mark.⁶¹

There is no authority in the statute for the patent office to give consideration, in a trade-mark interference, to the claim that, by reason of false and fraudulent representations, an applicant is not entitled to register a trade-mark, because, while a court may refuse to grant relief to the owner of a mark on account of false representations, it would not on that account hold that an alleged trade-mark was unlawful.⁶²

Where an interference is declared between a registrant and an applicant, the latter being the last to adopt and use the trade-mark in the United States, although having adopted and used it in a foreign country prior to the adoption and use by the registrant in the United States, priority of adoption and use must be awarded to the registrant, in the absence of any proof of fraud on his part.⁶³

It was held in one case in the patent office that a party to an interference is bound by the statement in his application as to the date of adoption and use, and cannot prove adoption and use, prior to the date set up therein, either by himself or by others from whom he may have derived title;⁶⁴

⁶⁰ See Appendix, I., p. 612.

⁶¹ *Manitowoc Mfg. Co. v. Dickerman* (1891) 57 Off. Gaz. 1721.

⁶² *Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co.* (1898) 85 Off. Gaz. 1905.

⁶³ *Leprince v. Her* (1900) 92 Off. Gaz. 189; *Farmers' Mfg. Co. v. Harrison* (1901) 96 Off. Gaz. 2062.

⁶⁴ *Empire Cycle Co. v. Monarch Cycle Mfg. Co. v. Meacham Arms Co.* (1898) 82 Off. Gaz. 1689. See *Stuart Medicine Co. v. Goldaine* (1893) 64 Off. Gaz. 1005.

but in another and later case it was held that testimony adduced on behalf of a registrant, showing an earlier adoption and use of the trade-mark by their predecessors than that set forth in the original statement, may be considered and given such weight as may be proper under the circumstances of the case.⁶⁵

§ 348. The Federal Act of 1882.

On August 5, 1882, congress passed an act amendatory of the act of 1881, and providing that nothing contained in the act of 1881 "shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act."⁶⁶ This statute does not seem to add anything to the act of 1881. All trade-marks registrable since the passage of this act were registrable before its passage.⁶⁷

§ 349. The Print and Label Act of 1874.

In 1874 congress passed an act relating to copyrights, and the third section of the act provided for registration in the patent office of prints and labels designed to be used in connection with articles of manufacture.⁶⁸ This statute is a part of the copyright law, and the authority for its enactment is found in the clause of the constitution authorizing congress to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.⁶⁹ The word "print" as used in this act is defined by the patent

⁶⁵ *Sherwood v. Horton* (1898) 84 Off. Gaz. 2018. See *Stewart v. Einstein v. Sawhill* (1892) 61 Off. Gaz. 287.

⁶⁶ See Appendix, I., p. 614.

⁶⁷ *Ex parte Gale Mfg. Co.* (1898) 85 Off. Gaz. 1907.

⁶⁸ Act June 18, 1874 (18 Stat. 78). See Appendix, I., p. 616.

⁶⁹ See Appendix, I., p. 615.

office as “an artistic and intellectual production designed to be used for an article of manufacture, and in some fashion pertaining thereto, but not borne by it,—such, for instance, as an advertisement thereof.”⁷⁰ The word “label” as used in this act is similarly defined as “an artistic and intellectual production impressed or stamped directly upon the article of manufacture, or upon a slip or piece of paper or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the article of manufacture.”⁷¹

In the leading case upon this subject the supreme court considered this statute, and said: “The clause of the constitution under which congress is authorized to legislate for the protection of authors and inventors * * * has reference only to such writings and discoveries as are the result of intellectual labor. * * * ‘While the word “writings” may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are original and are founded in the creative powers of the mind.’ It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, and no possible influence upon science or the useful arts. A label on a box of fruit, giving its name as ‘grapes,’ even with the addition of adjectives characterizing their quality, as ‘black,’ or ‘white,’ or ‘sweet,’ or indicating the place of their growth, as ‘Malaga,’ or ‘California,’ does not come within the object of the clause. The use of such labels upon those articles has no connection with the progress of science and the useful arts. So, a label designating ink in a bottle as ‘black,’ ‘blue,’ or ‘red,’ or ‘indelible’ or ‘insoluble,’

⁷⁰ Rule 30, Appendix, I., p. 641.

⁷¹ Rule 31, Appendix, I., p. 641.

or as possessing any other quality, has nothing to do with such progress. It cannot, therefore, be held, by any reasonable argument, that the protection of mere labels is within the purpose of the clause in question. To be entitled to a copyright, the article must have, by itself, some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached."⁷²

The supreme court also held, in the same case, that in order to maintain an action for infringement the registrant must give notice of the copyright by inscribing upon the print or label the word "copyright," with the year it was entered. It is also apparent that registration under this act must conform to the provisions of the general copyright law, and must take place before publication or use of the print or label. It has been held by the patent office that "a print," as the term is used in the act, "not being applied to an article of manufacture, is not in any sense a trade-mark, nor can it become a trade-mark. It cannot be an infringement of a trade-mark, even though it may bear a device which is a trade-mark in use by and owned by a person other than the owner of the print, or even though the print may be a mere representation of such trade-mark."⁷³ It has also been held that the words, "for any article of manufacture," in the statute, have reference to the subject-matter of the print itself, and that, if that subject-matter does not suggest or in some

⁷² Higgins v. Keuffel (1891) 140 U. S. 428. See Marsh v. Warren (1877) 14 Blatchf. 263, Fed. Cas. No. 9,121; Werckmeister v. Pierce & Bushnell Mfg. Co. (1894) 63 Fed. 445; Ex parte Wickert (1899) 90 Off. Gaz. 1157; Ex parte New England Gas & Coke Co. (1899) 90 Off. Gaz. 1365; Ex parte Miller (1901) 96 Off. Gaz. 1855; Ex parte Bowles (1901) 97 Off. Gaz. 2308; Ex parte American Wire Weavers' Protective Ass'n (1901) 94 Off. Gaz. 586.

⁷³ Ex parte United States Playing Card Co. (1898) 82 Off. Gaz. 1209.

manner indicate some other article of manufacture, the print is not registrable in the patent office.⁷⁴

The patent office formerly required, in case a label presented for registration under this act contained matter capable of sequestration as a trade-mark, that the trade-mark matter should first be registered as a trade-mark; but as a label must be registered, if at all, before use, and a trade-mark cannot be registered till after use, it was manifestly impossible to comply with both requirements. It was held, however, in 1898, that there was no authority of law for requiring the registration of the trade-mark matter contained in a label as a condition precedent to the registration of the label; that the label law was designed to give protection to the mark of a new creation possessing artistic merit, and that one cannot be deprived of this protection merely because it is possible that some device contained in it might be protected in a different manner, under a different law and different clause of the constitution.⁷⁵

§ 350. State Statutes.

Many of the states of the Union have adopted laws for the protection of trade-marks. These laws vary in many particulars. Some of them provide for the registration of trade-marks, labels, or forms of advertisement by any person or association or union of workingmen, and for the punishment of infringers by fine and imprisonment; others provide only for such registration by associations or unions of workingmen. It is beyond the scope of this work to review the provisions of these statutes. The text of the statutes will be found in Appendix III.

⁷⁴ Ex parte Barnhart (1899) 87 Off. Gaz. 2118.

⁷⁵ Ex parte Mahn (1898) 82 Off. Gaz. 1210.

§ 351. Treaties and the International Convention.

Numerous treaties have been entered into between the United States and foreign countries for the protection of trade-marks, and in 1883 several countries joined in adopting an international convention, to which the United States afterwards acceded. The purpose of this convention was "to secure by mutual agreement complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guaranty for the rights of inventors, and for the loyalty of commercial transactions." The second article of the convention provides that the subjects or citizens of each of the contracting states shall enjoy, in all of the other states of the Union, for the protection of industrial property, so far as concerns trade or commercial marks and the commercial name, the advantages which the respective laws thereof at present accord, or shall afterwards accord, to subjects or citizens, and that they shall have the same protection and the same legal recourse against all infringements of their rights upon complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each state. A final protocol, ratified at the same time as the convention, provides that no trade or commercial mark shall be excluded from protection, in one of the states of the Union, by the mere fact that it may not satisfy in respect to the signs composing it, provided that it does not satisfy, in this regard, the laws of the country of origin, and that it has been in this latter country duly deposited.⁷⁶ Congress has passed no law for the

⁷⁶ For the text of international convention, and final protocol and summary of the treaties between the United States and other nations, see Appendix, IV., p. 826. For a discussion of the amendments of the United States trade-mark laws required to give full effect to the international convention, and for the text of the treaties between

execution of this treaty, and in an opinion rendered by the attorney general of the United States it is stated:⁷⁷ "Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects or citizens. It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws." While this may be true so far as the provisions of the convention and the patent laws of the United States are concerned, in which there are one or more discriminations in favor of the citizens of the United States, it does not seem to be applicable to trade-marks, as no distinction is made in the act of 1881 between citizens of the United States and citizens or subjects of other members of the industrial property union. The trade-mark laws of the United States are reciprocal and fulfill the requirements of the convention so far as they go. The United States circuit courts have in two instances recognized this convention as in force between the United States and the other contracting nations, and has given to citizens of other members of the union the advantages secured to them by the convention.⁷⁸

the United States and other countries, see "Report of the commissioners appointed to revise the laws relating to patents, trade-marks and trade-names with reference to existing conventions and treaties," Government Printing Office, 1900. For a full discussion of foreign trade-mark laws, international conventions, and existing treaties, see Greeley, *Foreign Patent & Trade-Mark Laws*, p. 129 et seq., Washington, 1901.

⁷⁷ 19 Op. Attys. Gen. 278; Browne, *Trade-Marks*, Preface to Supplement, page v.

⁷⁸ In *Kerry v. Toupin* (1894) 60 Fed. 272, it was held that citizens of Canada engaged in the manufacture of trade-marked articles, and having a place of business in the state of New York, where they

(600)

make and ship articles for sale in the United States, are within the international convention of March 20, 1883, for the protection of industrial property. In *La Republique Francaise v. Schultz* (1893) 57 Fed. 37, it was held that the word "Vichy," used in connection with mineral waters, and derived from the locality in France where the waters are obtained, is a trade-name, or "nom commercial," within the meaning of the industrial property treaty with France of 1883, art. 6 (25 Stat. 1376), and as such is entitled to protection in the United States, though it has not been deposited as required by the treaty in the case of trade-marks; the treaty especially providing (article 8) that the "commercial name shall be protected in all the countries of the union, without obligation of deposit, whether it forms part or not of a trade or commercial mark."

In *Richter v. Reynolds* (1893) 59 Fed. 577, it was held that the treaty of 1871 between the United States and Germany (17 Stat. 931, art. 17), which provides that, with regard to the marks or labels of goods, or of their packages, the citizens of Germany shall enjoy in the United States the same protection as native citizens, does not give to a citizen of Germany, who has acquired the right to a trade-mark in that country, a similar right to the trade-mark in the United States.

APPENDIX I.

FEDERAL LEGISLATION.

THE LAW OF TRADE-MARKS.

ACT OF CONGRESS OF JULY 8, 1870.

Section 77. And be it further enacted, that any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any state or territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to the citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark, for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to wit:

First. By causing to be recorded in the patent office the names of the parties, and their residence and place of business, who desire the protection of the trade-mark.

Second. The class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated.

Third. A description of the trade-mark itself, with *fac similes* thereof, and the mode in which it has been or is intended to be applied and used.

Fourth. The length of time, if any, during which the trade-mark has been used.

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

Sixth. The compliance with such regulations as may be prescribed by the commissioner of patents.

Seventh. The filing of a declaration, under the oath of the person or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has the right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive, and that the description and *fac similes* presented for record are true copies of the trade-mark sought to be protected.

Section 78. And be it further enacted, that such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act, at the same time that it becomes of no effect elsewhere, and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods: provided that six months prior to the expiration of the said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the commissioner of patents, and the fee for such renewal shall be

the same as for the original registration; certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force for a further term of thirty years: and provided further, that nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

Section 79. And be it further enacted, that any person or corporation who shall reproduce, copy, counterfeit, or imitate any such recorded trade-mark, and affix the same to goods of substantially the same description, properties and qualities as those referred to in the registration, shall be liable to an action on the case for damages for such unlawful use of such trade-mark at the suit of the owner thereof in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use. The commissioner of patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons, or which is identical with the trade-mark appropriated to the same class of merchandise, and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public: provided, that this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act.

Section 80. And be it further enacted, that the time of the receipt of any trade-mark at the patent office for registration shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the patent office, certified by the commissioner, shall be evidence in any suit in which such trade-mark shall be brought into controversy.

Section 81. And be it further enacted, that the commissioner of patents is authorized to make rules and regulations and to prescribe forms for the transfer of the right to use such trade-marks, conforming as nearly as practicable to the requirements of the law respecting the transfer and transmission of copyrights.

Section 82. And be it further enacted, that any person who shall procure the registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark, in the patent office under this act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case in any court of competent jurisdiction within the United States.

Section 83. And be it further enacted, that nothing in this act shall prevent, lessen, impeach or avoid, any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if this act had not been passed.

Section 84. And be it further enacted, that no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been

formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

PENAL ACT OF AUGUST 14, 1876 (19 STATUTES AT LARGE, 141).

Be it enacted by the senate and house of representatives of the United States of America in congress assembled :

Section 1. That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the statutes of the United States, to which or to the package in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by a fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

Section 2. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

Section 3. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation

thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

Section 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, molds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving or mold of any private label, brand, stamp, wrapper, engraving on paper or other substances or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

Section 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully make, forge or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

Section 6. That any person who shall, with intent to injure or defraud the owner of any trade-mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated, without substantial injury to such box or other thing afore-

said, any trade-mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

Section 7. That if the owner of any trade-mark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal or other substance, or molds, of his said registered trade-mark, are in the possession of any person with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States, and the commissioners of the circuit courts, may, within their respective jurisdictions, proceed under the law relating to search warrants, and may issue a search warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and said empty boxes, envelopes, wrappers, cases, bottles or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance,

molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purpose of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

Section 8. That any person who shall, with intent to defraud any person or persons, knowingly and willfully aid or abet in the violation of any of the provisions of this act, shall, upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.

ACT OF MARCH 3, 1881.

An act to authorize the registration of trade marks and protect the same.

Sec. 1. Be it enacted by the senate and house of representatives of the United States in congress assembled, that the owners of trade marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade marks by complying with the following requirements:

First. By causing to be recorded in the patent office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise, and the par-

ticular description of goods comprised in such class to which the particular trade mark has been appropriated; a description of the trade mark itself, with *fac similes* thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade mark has been used.

Second. By paying into the treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the commissioner of patents.

Sec. 2. That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and *fac similes* presented for registry truly represent the trade mark sought to be registered.

Sec. 3. That the time of the receipt of any such application shall be noted and recorded. But no alleged trade mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some

other person's lawful trade mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the commissioner of patents shall decide the presumptive lawfulness of claim to the alleged trade mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

Sec. 4. That certificates of registry of trade marks shall be issued in the name of the United States of America, under the seal of the department of the interior, and shall be signed by the commissioner of patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed shall be evidence in any suit in which such trade marks shall be brought into controversy.

Sec. 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trade mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time such trade mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

Sec. 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the treasury of the United States with intent to procure protection for the same trade mark.

Sec. 7. That registration of a trade mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

Sec. 8. That no action or suit shall be maintained under the provisions of this act in any case when the trade mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

Sec. 9. That any person who shall procure the registry of a trade mark, or of himself as the owner of a trade mark, or an entry respecting a trade mark, in the office of the commissioner of patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

Sec. 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade mark might have had if the provisions of this act had not been passed.

Sec. 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trade mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

Sec. 12. That the commissioner of patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade marks and for recording such transfers in his office.

Sec. 13. That citizens and residents of this country wishing the protection of trade marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade marks for that purpose as is above allowed to foreigners, and have certificate thereof from the patent office.

Approved March 3, 1881.

ACT OF AUGUST 5, 1882.

An act relating to the registration of trade marks.

Be it enacted by the senate and house of representatives of the United States of America in congress assembled, that nothing contained in the law entitled "An act to authorize the registration of trade marks and protect the same," approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.

Approved August 5, 1882.

ACT JULY 24, 1897, (U. S. ST. AT LARGE, 1ST SESS., 55TH CONG., P. 207).

Section 11. That no article of imported merchandise which shall copy or simulate the name or trade mark of any domestic manufacture or manufacturer, or which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom-house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade marks may require his name and residence and a description of his trade marks, to be recorded in books which shall be kept for that purpose in the department of the treasury, under such regulations as the secretary of the treasury shall prescribe, and may furnish to the department fac similes of such trade marks; and thereupon the secretary of the treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs.

THE LAW OF PRINTS AND LABELS.

CONSTITUTION, 1787.

Art. I, sec. 8.—The congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

REVISED STATUTES.

Sec. 4952. The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition,

engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such persons shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors or their assigns shall have exclusive right to dramatize or translate any of their works, for which copyright shall have been obtained under the laws of the United States.

Sec. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

Sec. 4954. The author, inventor, or designer, if he be still living, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

STATUTE RELATING TO REGISTRATION OF PRINTS AND LABELS.

Sections 3, 4, and 5 of the act of congress relating to patents, trade-marks, and copyrights, approved June 18, 1874 (18 Stat. L. p. 78), are as follows:

Sec. 3. That in the construction of this act the words "engraving, cut and print," shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the commissioner of patents, to the party entering the same.

Sec. 4. That all laws and parts of laws inconsistent with the foregoing provisions be, and the same are hereby, repealed.

Sec. 5. That this act shall take effect on and after the first day of August, eighteen hundred and seventy-four.

APPENDIX II.

RULES OF THE UNITED STATES PATENT OFFICE FOR REGISTRATION OF TRADE-MARKS.

CORRESPONDENCE.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the commissioner, and only returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by postal order, check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Complaints against the examiner of trade-marks, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to registered trade-marks should refer to the name of registrant, number and date of certificate, and the class of merchandise to which the trade-mark is applied.

6. The personal attendance of applicants at the patent office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, cannot generally be allowed.

9. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain trade-marks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express charges, freight, postage, and all other charges on matter sent to the patent office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office cannot aid in the selection of any attorney. An applicant may be represented by any person who is registered under the provisions of rule 17 of the rules of practice of the patent office to prosecute applications for patents.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or co-partnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the secretary of the interior.

WHO MAY REGISTER A TRADE-MARK.

16. A trade-mark may be registered by any person, firm, or corporation domiciled in the United States or located in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States,¹ and

¹ For list of the countries having treaties with the United States at this time see Appendix IV. p. 826.

who is entitled to the exclusive use of any trade-mark and uses the same in commerce with foreign nations or with Indian tribes.

Also, by any citizen or resident of this country wishing the protection of his trade-mark in any foreign country the laws of which require registration in the United States as a condition precedent upon the payment of the fee required by law and other due proceedings had.

17. Owners of trade-marks for which protection has been sought by registering them in the patent office under the act of July 8, 1870 (declared unconstitutional by the supreme court of the United States,—100 U. S. 82), may register the same for the same goods, without fee. With each application of this character a specific reference to the date and number of the former certificate is required.

18. Applicants whose cases were filed under the act of 1870, either prior to or since the decision of the supreme court declaring it unconstitutional, which are now pending before the office, must prepare their applications in conformity with the present law and rules. On the receipt of such an application, referring to the date of the one formerly filed, all fees paid thereon will be duly applied. Those who have paid only \$10 as a first fee are advised that the law does not provide for a division of the legal fee of \$25, and that the remainder of the entire fee is required before the application can be examined.

19. No trade-mark will be registered unless it shall be made to appear that the same is used as such by the applicant in commerce between the United States and some foreign nation or Indian tribe, or is within the provisions of a treaty, convention, or declaration with a foreign power, or which is merely the name of the applicant, or which is identical with a known or registered trade-mark owned by another and ap-

propriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion in the mind of the public or to deceive purchasers, or which is merely descriptive in its nature, or which is primarily geographical.²

THE APPLICATION.

20. An application for the registration of a trade-mark must be made to the commissioner of patents and must be signed by the owner of the trade-mark.

21. A complete application comprises—

(a) A brief letter of advice requesting registration, signed by the applicant. (See form 1, on page 630.)

(b) A statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used, and if the applicant be a corporation it must set forth under the laws of what state or nation incorporated.

(c) A declaration or oath complying with section 2 of the statute on page ——. (See forms 3, 5, and 7, on pages 631-634.)

² "That if the device, mark, or symbol was adopted or placed upon the article for the purpose of identifying its class, grade, style, or quality, or for any purpose other than a reference to or indication of its ownership, it cannot be sustained as a valid trade-mark." *Columbia Mill Company v. Alcorn et al.*, 65 O. G. 1916; C. D. 1893, 672.

(d) A *facsimile* or drawing of the mark. (See rules 27 and 28.)

(e) A fee of twenty-five dollars.

22. The letter of advice, the statement, and the declaration must be in the English language and written on one side of the paper only.

23. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a trade-mark by any person, or the subject-matter thereof, unless it shall, in the opinion of the commissioner, be necessary to the proper conduct of business before the office.

DECLARATION OR OATH.

24. The declaration or oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *charge d'affaires*, consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be, who is authorized by the laws of said country to administer oaths, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

25. The declaration cannot be amended. If that filed with the application is faulty or defective, a substitute declaration must be filed.

FACSIMILE OR DRAWING.

26. If for any reason a drawing does not constitute a satisfactory *fac simile* of the trade-mark, two copies of the trade-mark as actually used must be deposited in addition to the required drawing, to be preserved in the office for reference.

27. (1) The drawing must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than $1\frac{1}{4}$ inches is to be left blank for the heading of title, name, number, and date.

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

(4) The name of the proprietor of the trade-mark signed by himself or his attorney of record must be placed at the lower right-hand corner of the sheet and the signatures of the witnesses at the lower left-hand corner, all within the marginal line, but in no instance should they encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side, and the heading will be placed at the right and the signatures at the left, occupying

the same space and position as in an upright view, and being horizontal when the sheet is held in an upright position.

(6) Drawings should be rolled for transmission to the office—not folded.

An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

28. The office, at the request of applicants, will furnish the drawings at cost.

EXAMINATION OF APPLICATIONS.

29. All applications for registration are considered in the first instance by the trade-mark examiner. Whenever, on examination of an application, registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application.

30. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

AMENDMENTS.

31. The statement may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination, but no amendments will be admitted unless warranted by something in the statement or *facsimile* as originally filed.

32. In every amendment the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. (See form S, on page 634.) All such

amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant.

33. When an amendatory clause is amended, it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be rewritten.

34. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the commissioner.

Amendments not affecting the merits may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the commissioner without withdrawing the case from issue.

35. After the completion of the application the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms.

INTERFERENCES.

36. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have an opportunity to prove priority of use, and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents.

APPEALS OR PETITIONS.

37. From an adverse decision of the examiner of trade-marks upon an applicant's right to register a trade-mark, or upon any interlocutory matter, or from a decision of the examiner of interferences, the case will be reviewed by the commissioner, on petition or appeal, without fee.

ISSUE, DATE, AND DURATION OF CERTIFICATE.

38. When the requirements of the law and the rules have been complied with, and the office has adjudged a trade-mark lawfully registrable, a certificate will be issued by the commissioner, under seal of the interior department, to the effect that applicant has complied with the law, and that he is entitled to the protection of his trade-mark in such case made and provided. Attached to the certificate will be a *facsimile* of the trade-mark and a printed copy of the statement and declaration.

39. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

40. A certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property elsewhere.

At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

ASSIGNMENTS.

41. The right to the use of any trade-mark is assignable

by an instrument in writing, and provision is made for recording such instrument in the patent office. But no such instrument or conveyance will be recorded unless it is in the English language, and unless an application for the registration of a trade-mark shall have first been filed in the patent office, and such instrument must identify the application by date of filing, or, where the mark has been registered, by its certificate number and the date thereof. No particular form of instrument is prescribed.

COPIES AND PUBLICATIONS.

42. After a trade-mark has been registered, printed copies of the statement and declaration in each case, with a *facsimile* of the trade-mark, can be furnished by the office upon the payment of the fee.

43. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor; otherwise an extra charge will be made for the time consumed in making any search for such assignment.

44. The Official Gazette of the patent office will contain a list of all trade-marks registered, with the name and address of the registrant in each case, an illustration of the trade-mark, a brief description of the trade-mark itself, and the particular description of goods to which it is applied.

FEEES.

45. On filing an application for registration of a trade-mark	\$25.00
For manuscript copies, for every 100 words or fraction thereof10
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less	1.00
For recording every assignment, agreement, power	

of attorney, or other paper of more than 300 words and less than 1,000 words	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words	3.00
For abstracts of title:	
For the certificate of search	1.00
For each brief from the digest of assignments.	.20
For assistance to attorneys and others in the exam- ination of records, one hour or less50
Each additional hour or fraction thereof50
For single printed copy of statement, declaration, and <i>facsimile</i>05
If certified, for the grant, additional50
For the certificate25

46. Money required for office fees may be paid to the commissioner, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the secretary of the treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the patent office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders, drafts, and checks should be made payable to the "Commissioner of Patents."

47. All money sent by mail, either to or from the patent office, will be at the risk of the sender. All payments to the office must be made in specie, treasury notes, national-bank notes, certificates of deposit, money orders, or certified checks.

REPAYMENT OF MONEY.

48. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misin-

formation on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, will not entitle a party to demand such a return.

FORMS FOR REGISTRATION OF TRADE-MARKS.

The following forms illustrate the manner of preparing papers for applications for registration of trade-marks. Applicants will find their business facilitated by following them closely.

(1) *Letters of Advice.*

To the Commissioner of Patents: The undersigned presents herewith a *facsimile* of his lawful trade-mark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States patent office in accordance with the law in such cases made and provided.

Dated ———, 19—.

A. B.

(2) *Statement by an Individual.*

To All Whom It may Concern: Be it known that I, A. B., a citizen [or subject, as the case may be] of the ———, residing at ———, ———, and doing business at No.———, ——— street, in said city, have adopted for my use a trade-mark for molasses, of which the following is a description: As shown in the accompanying *facsimile*, my trade-mark consists of the representation of a flying dove, associated with the word "Dove." This trade-mark has been continuously used in my business since ——— —, 1———. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods

comprised in said class upon which I use the said trade-mark is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

A. B.

Witnesses:

C. D.

E. F.

(3) *Declaration for an Individual.*

State of _____, }
 County of _____. } ss.:

A. B., being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that he has at this time a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that it is used by him in commerce between the United States and foreign nations or Indian tribes, and particularly with _____ [here name one or more foreign nations or Indian tribes, or both, as the case may be]; and that the description and *facsimiles* presented for record truly represent the trade-mark sought to be registered.

A. B.

Sworn and subscribed before me, a _____, this _____ day of _____, 19—.

[L. S.]

G. H.

(4) *Statement by a Firm.*

To All Whom It may Concern: Be it known that we, C. D. & Co., a firm domiciled in _____, county of _____,

state of _____, and doing business at No. _____, _____ street, in said city, and composed of the following members, _____, _____, _____, citizens of [or, subjects, as the case may be] _____, have adopted for our use a trade-mark for molasses, of which the following is a description:

As shown in the accompanying *facsimile*, our trade-mark consists of the representation of a flying dove associated with the word "Dove." This trade-mark has been continuously used in our business since _____, 1_____. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which we use the said trade-mark is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

C. D. & Co.,

By C. D., a Member of the Firm.

Witnesses:

E. F.

G. H.

(5) *Declaration for a Firm.*

State of _____,

ss.:

County of _____.

C. D., being duly sworn, deposes and says that he is a member of the firm of C. D. & Co., the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said firm at this time has a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the

trade-mark is used by the said firm in commerce between the United States and foreign nations or Indian tribes, and particularly with ——— [here name one or more foreign nations or Indian tribes, or both, as the case may be]; and that the description and *facsimiles* presented for record truly represent the trade-mark sought to be registered.

C. D.

Sworn and subscribed before me, a ———, this ——— day of ———, 19—.

[L. S.]

E. F.

(6) *Statement by a Corporation.*

To All Whom It may Concern: Be it known that the E. & F. Company, a corporation duly organized under the laws of the state of ———, and located in the city of ———, county of ———, in said state, and doing business in said city of ———, has adopted for its use a trade-mark for molasses, of which the following is a description: As shown in the accompanying *facsimile*, the trade-mark consists of the representation of a flying dove associated with the word "Dove." This trade-mark has been continuously used in the business of the said corporation since ——— —, 1——. The class of merchandise to which this trade-mark is appropriated is groceries, and the particular description of goods comprised in said class upon which the said trade-mark is used is molasses. It is usually displayed on heads of barrels or packages, and on cans containing the goods, by placing thereon a printed label on which the described trade-mark is shown.

The E. & F. Company,
By G. H., Secretary.

Witnesses:

I. J.

K. L.

(7) *Declaration for a Corporation.*

State of _____, }
 County of _____. } ss. :

G. H., being duly sworn, deposes and says that he is secretary [or other officer] of the corporation the E. & F. Company, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation at this time has a right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the trade-mark is used by the said corporation in commerce between the United States and foreign nations or Indian tribes, and particularly with _____ [here name one or more foreign nations or Indian tribes, or both, as the case may be], and that the description and *facsimiles* presented for record truly represent the trade-mark sought to be registered.

G. H., Secretary³ [or other officer].

Sworn and subscribed before me, a _____, this _____ day of _____, 19—.

[L. S.]

I. J.

(8) *Amendment.*

To the Commissioner of Patents: In the matter of my application for the registration of trade-mark for molasses, No. _____, filed _____, 19—, I hereby amend my statement as follows:

Page _____, line _____, cancel the words "The Dove

³ If the corporation have a seal, it may be used to authenticate the signature of the officer.

Brand,” and insert in place thereof the following: “Dove” and the representation of a dove.

Same page, line ———, erase the words “about ten years,” and insert since ——— —, 1——.

Dated ———, 19——.

A. B.,

By J. K., His Attorney.

RULES OF THE UNITED STATES PATENT OFFICE FOR REGISTRATION OF PRINTS AND LABELS.

CORRESPONDENCE.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the commissioner, and only returned by his direct order.

3. All letters should be addressed to “The Commissioner of Patents;” and all remittances by postal order, check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Complaints against the examiner, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relat-

ing to registered prints and labels should refer to the name of registrant and number and date of certificate.

6. The personal attendance of applicants at the patent office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, cannot generally be allowed.

9. The office cannot undertake to respond to inquiries propounded with a view to ascertain whether certain prints and labels have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express charges, freight, postage, and all other charges on matter sent to the patent office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office cannot aid in the selection of any attorney. An applicant may be represented by any person who is registered under the provisions of rule 17 of the rules of practice of the patent office to prosecute applications for patents.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or co-

partnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the secretary of the interior.

WHO MAY REGISTER A PRINT OR LABEL.

16. The author of any print or label, who is a citizen or resident of the United States, or who is a subject or citizen of any country to whose subjects or citizens the United States has extended the benefits of copyright, is privileged to obtain registration in the United States.

Any person to whom an author who has the privilege of copyright in the United States has transferred his copyright can apply for and obtain a copyright entry as a proprietor.

17. By the act of March 3, 1891, which went into effect on July 1 of the same year, the United States congress, by amendment of the then existing copyright law, removed the limitation of the privilege of copyright to citizens of the United States and made it possible for foreign authors to

obtain copyright in the United States upon the same terms as native authors. The last section of this statute limits its application as follows:

That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as (to) its own citizens, and when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the president of the United States by proclamation made from time to time as the purposes of this act may require.

Under the operation of this provision, the privileges of copyright in the United States have been extended by presidential proclamations to the authors of Belgium, Chile, Costa Rica, Denmark, France, Germany, Great Britain and her possessions (Australia, Canada, India, etc.), Italy, Mexico, Netherlands (Holland) and possessions, Portugal, Spain, and Switzerland.

The authors of the countries named, therefore, and their assigns, as copyright proprietors, can obtain copyright protection for their prints and labels in the United States upon the same conditions as American authors.

Under the authority of the opinions of the attorney general, dated December 2, 1898, and February 19, 1902, residents of Cuba, Hawaii, and Porto Rico are entitled to the benefits of the copyright laws relating to the registration of prints and labels.

THE APPLICATION.

18. To entitle the author or proprietor of any such print or label to register the same in the patent office, the application for registration thereof must be made to the commis-

sioner of patents, and the said application should be signed by the author or proprietor, or for the author or proprietor by a duly authorized agent.

19. A complete application comprises—

(a) A statement addressed to the commissioner of patents, disclosing applicant's name, nationality, and place of doing business; whether author or proprietor, and, if proprietor, a disclosure of the nationality of the author; the title of the print or label, and the name of the article of manufacture for which the print or label is to be used.

(b) Ten copies of the print or label, one of which, when the print or label is registered, shall be certified under the seal of the commissioner of patents and returned to the author or proprietor.

(c) A statement of its nonpublication prior to date of filing.

(d) A fee of \$6.

20. The title of the print or label must appear on the copies filed.

21. The deposit of the 10 copies required should be made before the publication of the print or label, the law providing that no person shall be entitled to a copyright unless he shall also, not later than the date of publication thereof, in this or any foreign country, deliver the required copies of the print or label in the office of registry.

22. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a print or label by any person, or the subject-matter thereof, unless it shall, in the opinion of the commissioner, be necessary to the proper conduct of business before the office.

EXAMINATION OF APPLICATIONS.

23. The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

24. All applications for registration are considered in the first instance by the examiner. Whenever on examination of an application registration is refused for any reason whatever the applicant will be notified thereof. The reasons for such rejection will be stated, and such information will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

25. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

AMENDMENTS.

26. The application may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination, and if the copies of the prints or labels furnished are for any reason not registrable under the copyright law, the applicant may substitute copies which conform to the requirements of said law.

27. In every amendment the exact word or words to be stricken out or inserted must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

28. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the commissioner.

Amendments may be made after the allowance of an application on the recommendation of the examiner, approved by the commissioner, without withdrawing the case from issue.

29. After the completion of the application, the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms. (See rule 42).

SUBJECT-MATTER OF APPLICATION.

30. The word "print," as used in section 3 of the copyright act, so far as it relates to registration in the patent office, is defined as an artistic and intellectual production designed to be used for an article of manufacture, and in some fashion pertaining thereto but not borne by it; such, for instance, as an advertisement thereof.

31. The word "label," as used in this act, so far as it relates to registration in the patent office, is defined as an artistic and intellectual production impressed or stamped directly upon the article of manufacture, or upon a slip or piece of paper or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the article of manufacture.

32. No print or label can be registered unless it properly belongs to an article of manufacture, and is descriptive thereof, and is as above defined, and unless the application is filed before publication thereof.

APPEALS.

33. An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the commissioner in person, on appeal, without fee.

ISSUE, DATE, AND DURATION OF CERTIFICATE.

34. When the requirements of the law and of the rules have been complied with, and the office has adjudged a print or label registrable, a certificate will be issued by the commissioner under his seal, to the effect that the applicant has complied with the law, and that he is entitled to the protection of his print or label in such case made and provided. Attached to the certificate will be a copy of the print or label.

35. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

36. A certificate of registry shall remain in force for twenty-eight years from its date.

37. The certificate may be continued for a further term of fourteen years upon filing a second application within six months before the expiration of the term of the original certificate and complying with all other regulations with regard to original applications. Within two months from the date of said renewal the applicant must cause a copy of the record thereof to be published for four weeks in one or more newspapers printed in the United States.

ASSIGNMENTS.

38. Prints and labels are assignable in law by an instrument in writing. This should state the names of the assignee and assignor, the title of the print or label assigned; the date of filing the application, or, if registered, the date and number of the certificate, a statement of a "valuable consideration," and should be dated and signed.

Every assignment must be recorded in the patent office within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.

COPIES AND PUBLICATIONS.

39. After a print or label has been registered, copies thereof can be furnished, when authorized by the commissioner, upon the payment of the fee.

40. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor; otherwise an extra charge will be made for the time consumed in making the search for such assignment.

41. The Official Gazette of the patent office will contain a list of all the prints and labels registered, with the name and address of the registrant in each case, the title of the print or label, and a statement of the particular goods to which it is to be applied, together with the date of filing the application.

FEES.

42. On filing an application for registration of a print or label	\$6.00
For manuscript copies for every 100 words or fraction thereof10
For recording every assignment, agreement, power of attorney, or other paper of 300 words or less	1.60
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words	3.00
For abstracts of title:	
For the certificate of search	1.00
For each brief from the digests of assignments20
For assistance to attorneys and others in the examination of records, one hour or less50
Each additional hour or fraction thereof50

For single printed copy, when authorized by the commissioner05
If certified, for the grant50
For the certificate25

43. The fee for registration of a print or label is to be paid to the commissioner of patents, or to the treasurer or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the secretary of the treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the patent office. When this cannot be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders and checks should be made payable to the "Commissioner of Patents."

44. All money sent by mail, either to or from the patent office, will be at the risk of the sender. All payments to the office must be made in specie, treasury notes, national-bank notes, certified checks, or money orders.

REPAYMENT OF MONEY.

45. Upon refusal of the commissioner to register the print or label, and on application by the applicant, or his duly authorized agent, the fee may be returned.

NOTICE OF COPYRIGHT.

46. It is necessary, in order to maintain an action for infringement of a copyright, that the claim of copyright be printed on each copy of the article protected. The wording of the notice is determined by the copyright statute, section 4962, and should be as follows: Copyright, 19—, by (inserting full name of author or proprietor).

FORMS OF APPLICATION FOR REGISTRATION OF PRINTS.

(1) For an Individual.

To the Commissioner of Patents: The undersigned, A. B., a citizen [or, subject, as the case may be] of the _____, residing at _____, _____, and doing business at No. _____, _____ street, in said city, hereby applies as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated] for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is _____, and it is used for advertising purposes for _____.

Dated this _____ day of _____, 190—.

A. B., Author or Proprietor.

(2) For a Firm.

To the Commissioner of Patents: The undersigned, C. D. & Co., a firm domiciled in the city of _____, county of _____, state of _____, and doing business at No. _____, _____ street, in said city, and composed of the following members _____, _____, citizens of [or, subjects, as the case may be] _____, hereby apply as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated] for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is _____, and it is used for advertising purposes for _____.

Dated this _____ day of _____, 190—.

C. D. & Co., Author or Proprietor,

By C. D., a Member of the Firm.

(3) For a Corporation.

To the Commissioner of Patents: The applicant, the E. & F. Company, a corporation duly created by authority of the laws of the state of ——— [or other authority, as the case may be], located in the city of ———, county of ———, in said state, and doing business at No. ———, ——— street, in said city, hereby applies as proprietor [the nationality of the author from whom title is derived should be stated] for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ———, and it is used for advertising purposes for ———.

Dated this ——— day of ———, 190—.

The E. & F. Company,
By G. H., the President [or other officer].

FORMS OF APPLICATION FOR REGISTRATION OF LABELS.

(1) For an Individual.

To the Commissioner of Patents: The undersigned, A. B., a citizen [or, subject, as the case may be], of the ———, residing at ———, ———, and doing business at No. ———, ——— street, in said city, hereby applies as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated] for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

Dated this ——— day of ———, 190—.

A. B., Author or Proprietor.

(2) For a Firm.

To the Commissioner of Patents: The undersigned, C. D. & Co., a firm domiciled in the city of ———, county of

_____, state of _____, and doing business at No. _____, _____ street, in said city, and composed of the following members, _____, _____, citizens of [or, subjects, as the case may be] _____, hereby apply, as author [or, proprietor, as the case may be; if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated], for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is _____, and it is to be used on _____.

Dated this _____ day of _____, 190—.

C. D. & Co., Author or Proprietor,

By C. D., a Member of the Firm.

(§) For a Corporation.

To the Commissioner of Patents: The applicant, the E. & F. Company, a corporation duly created by authority of the laws of the state of _____ [or other authority, as the case may be], located in the city of _____, county of _____, in said state, and doing business at No. _____, _____ street, in said city, hereby applies as proprietor [the nationality of the author from whom title is derived should be stated] for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is _____, and it is to be used on _____.

Dated this _____ day of _____, 190—.

The E. & F. Company,

By G. H., the President [or other officer].

APPENDIX III.

STATE AND TERRITORIAL LEGISLATION.

ALABAMA.

Article 8, c. 196, Code 1896, affords protection to manufacturers, bottlers, and vendors of soda water and other beverages against the unauthorized use of or defacement of the names, marks, etc., upon their bottles, siphons, kegs, etc., by other parties.

No general trade-mark law.

An act approved March 1, 1901, provides for the protection of labels, adopted by labor unions, from counterfeits of such labels, and punishes the unlawful use of such labels.

ALASKA.

PAGE 18, CARTER'S ANNOTATED ALASKA CODES.

Sec. 84. Knowingly Using or Counterfeiting Trade-marks, etc. That if any person shall willfully and knowingly use or cause to be used any private brands, label, stamp, or trade-mark of another, either by counterfeiting the same or using any impression or copy thereof made or prepared by the proprietor thereof, or shall willfully and knowingly use or cause to be used any colorable imitation of such brand, label, stamp, or trade-mark, with intent to deceive any one, such person, upon conviction thereof, shall be punished by imprisonment in the county jail not less than one month nor more than six months, or by fine not less than twenty nor more than three hundred dollars. [Laws Oreg. Oct. 19, 1864; Hill's Ann. Laws, § 1804.]

ARIZONA.

SESS. LAWS 1899.

An act concerning the protection of trade marks and labels and providing a penalty for the imitation of the same.

Section 1. Whenever any corporation, association or union of workmen have adopted or shall hereafter adopt for its or their protection any label, trade mark, or form of advertisement announcing that goods to which such label, trade mark, or form of advertisement shall be attached, were manufactured by it or by a member or members of such union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark or form of advertisement; every person violating this section shall, upon conviction, be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or by fine and imprisonment.

Sec. 2. Any person who shall use any counterfeit or imitation of any label, trade mark or form of advertisement of any such corporation, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a term of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or by both.

Sec. 3. Every such association, union or corporation that has heretofore adopted or shall hereafter adopt a label, trade mark or form of advertisement, as aforesaid, shall file the same in the office of the secretary of the territory, by leaving two copies, counterparts or fac similes thereof with the secretary of the territory; said secretary shall deliver to such corporation, association or union so filing the same, a duly attested certificate of the record of the same, for which he

shall receive a fee of three dollars; such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of said union, corporation or association, to adopt the same.

Sec. 4. Every person who shall use or display the genuine label, trade mark or form of advertisement of any such association, corporation or union in any manner not authorized by such association, corporation or union, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both.

Sec. 5. Any person or persons who shall in any way use the name or seal of any such association, corporation or union, or officer thereof, in and about the sale of goods, or otherwise not being authorized to use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both.

Sec. 6. It shall be the duty of the secretary of the territory to see that all associations, unions, or corporations enjoying the benefits of labels, trade marks, or forms of advertisements herein described shall comply with the foregoing provisions in all respects.

Sec. 7. This act shall take effect and be in force from and after its passage.

Approved March 6, 1899.

ARKANSAS.

SAND. & H. DIG. ST. 1894, CH. 150.

Section 7347. Any person or firm in this state, or any of the United States or territories thereof, and any corporation

created by the authority of this state, or the United States, or any of the states or territories thereof, and any person, firm or corporation resident, or located in any foreign country, which, by treaty or convention, affords similar privileges to citizens of the United States, and who may be entitled to the exclusive use of any lawful trade mark or device, or who may intend to adopt and use any trade mark or device for exclusive use in this state, may obtain protection for such lawful trade mark or device by complying with the following requisites and requirements.

First—By making out and filing in the office of the secretary of state of this state, to be there registered or recorded, a statement specifying the names of the parties and their residence and place of business who desire the protection of the trade mark, the class of merchandise, and particular description of goods comprised in such class, by which or to which the trade mark has been or is intended to be appropriated; a description of the trade mark itself or device, or combination of words, letters or figures or characters used or intended to be used as such, and the mode in which it has been or is intended to be applied and used, and the length of time, if any, during which the trade mark has been in use.

Second—By making payment to the secretary of state, for the use of the state, of a fee of not less than twenty-five nor more than one hundred dollars, to be determined by the secretary according to a schedule of fees arranged with reference to the number of words, figures, characters, etc., contained in such statement, which schedule it is made the duty of the secretary to make and keep posted up in his office.

Sec. 7348. The certificate prescribed in the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declara-

tion, verified by the person or by some member of the firm or officer of the corporation by whom it is filed, to the effect that the party claiming the protection for the trade mark has a right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, and that the fac similes presented for record are true copies of the trade mark sought to be protected.

Sec. 7349. The secretary shall not receive and record any proposed trade mark which is not and can not become a lawful trade mark, or which is merely the name of a person, firm or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade mark appropriated to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade mark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trade mark rightfully in use on the first day of May, 1883.

Sec. 7350. The time of the receipt of any trade mark at the office of the secretary of state, for registration or record, shall be noted and recorded. Copies of the trade mark, and of the date of receipt thereof, and of the statement filed therewith, under the seal of the secretary of state shall be furnished by the secretary to any person who may apply therefor, and pay the fee therefor fixed by the secretary, not exceeding the fee required for the original registration thereof, and such copies shall be evidence in any suit or proceeding in which such trade mark shall be brought in controversy.

Sec. 7351. A trade mark registered as above prescribed shall remain in force for twenty-five years from the date of

such registration, except in case where such trade mark is claimed for, and applied to, articles not manufactured in this state, and in which it receives protection under the laws of some other state, territory or foreign country for a shorter period, in which case it shall cease to have any force in this state, by virtue of this act, at the same time that it becomes of no effect elsewhere.

Sec. 7352. Such trade mark, during the period it remains in force, shall entitle the person, firm or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath, as aforesaid, and no other party shall lawfully use the same trade mark, or substantially the same or so nearly resembling it as to be calculated to deceive, on substantially the same description of goods, or obtain, use or employ any article or thing whatever upon which such trade mark, or substantially the same, or one so nearly resembling it as to be calculated to deceive, has been printed, painted, stamped, woven, branded, or in any manner put or placed, for the purpose of putting up, shipping, selling, or otherwise disposing of substantially the same description of goods as those to which the same has been appropriated by the party rightfully entitled to the use of such trade mark; and any person or member of any firm, or agent, or officer of any corporation, not entitled so to do, who shall knowingly use such trade mark, or obtain, use or employ, as aforesaid, any such article or thing, or shall reproduce, counterfeit, copy or imitate any recorded trade mark, and affix the same to, or, for the purpose of having the same used or disposed of, to affix to goods of substantially the same descriptive properties and qualities as those referred to in the registration, or who shall, with intent to defraud, deal in or sell, or keep, or offer for sale, or cause or procure the sale of, any goods of substantially the same

descriptive properties as those referred to in the registration of any trade mark registered in pursuance of this act, to which, or to the package in which the same are put up, is fraudulently affixed said trade mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine article, or goods referred to in said registration, shall be deemed guilty of a high misdemeanor, and upon conviction thereof, shall be punished by a fine not exceeding one thousand dollars, or imprisonment not exceeding one year, or both such fine and imprisonment, and such person, and also the firm of which he is a member, or the corporation of which he is an agent or officer, and which may have countenanced or connived at his act, shall moreover be liable to an action for damages for such wrongful act, at the suit of the owner of such trade mark, and the party aggrieved shall also have his remedy according to the course of equity, to enjoin the wrongful use of his trade mark, and to recover compensation therefor in any court of competent jurisdiction, and in any such action or suit such owner or aggrieved party shall be entitled to recover a reasonable amount for attorney's fees, to be paid by the party or parties held liable therein.

Sec. 7353. No action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

Sec. 7354. Any person who shall procure the registry of any trade mark, or of himself as the owner of a trade mark, by making false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means,

shall be liable to pay any damages sustained in consequence thereof to the person injured thereby.

Sec. 7355. Nothing in this act shall prevent, lessen, impeach or avoid any remedy at law, or in equity, which any party aggrieved by any wrongful use of any trade mark might have, if the provisions of this act had not been enacted, and nothing in this act contained shall be construed by any court as abridging, or in any manner affecting unfavorably, the claim of any person to any trade mark after the expiration of the term for which such trade mark was registered.

Act March 31, 1883.

Act 149 of the Acts of 1895 affords protection to manufacturers and dealers in mineral water and other beverages, also to manufacturers of medicines or other compounds, against the unauthorized use of, or injury to or defacement of marks upon, their bottles, boxes, casks, kegs, etc.

CALIFORNIA.

POMEROY'S CIVIL CODE, 1901.

Sec. 655. There may be ownership of * * * the goodwill of a business, trade-marks and signs, and of rights created or granted by statute.

Sec. 991. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trade mark, any form, symbol or name, which has not been so appropriated by another, to designate the origin or ownership thereof, but he cannot exclusively appropriate any designation, or part of a designation, which relates only to the name, quality or the description of the thing or business, or the place where the thing is produced or the business is carried on.

Sec. 1772. One who sells or agrees to sell any article to

which there is affixed or attached a trade mark thereby warrants that mark to be genuine and lawfully used.

Sec. 1773. One who sells or agrees to sell any article to which there is affixed or attached a statement or mark to express the quantity or quality thereof, or the place where it was, in whole or in part, produced, manufactured, or prepared, thereby warrants the truth thereof.

POMEROY'S PENAL CODE, 1901.

Sec. 349a. Any person engaged in the production, manufacture, or sale of any article of merchandise made in whole or in part in this state, who, by any imprint, label, trade mark, tag, stamp, or other inscription or device, placed or impressed upon such article, or upon the cask, box, case, or package containing the same, misrepresents or falsely states the kind, character, or nature of the labor employed or used, or the extent of the labor employed or used, or the number or kind of persons exclusively employed or used, or that a particular or distinctive class or character of laborers was wholly and exclusively used or employed, when, in fact, another class or character or distinction of laborers was used or employed, either jointly or in any wise supplementary to such exclusive class, character, or distinction of laborers, in the production or manufacture of the article to which such imprint, label, trade mark, tag, stamp, or other inscription or device is affixed, or upon the cask, box, case, or package containing the same, is guilty of a misdemeanor, and punishable by a fine of not less than fifty nor more than five hundred dollars, or by imprisonment in the county jail for not less than twenty nor more than ninety days, or both.

Section 350. Every person who willfully reproduces, copies, imitates, forges, or counterfeits, or procures to be reproduced, copied, imitated, forged, or counterfeited, any trade mark usually affixed by any person to his goods, which has

Trade-Marks—42.

been duly recorded in the office of the secretary of state, or with the commissioner of patents in the United States patent office, or any label or brand, composed in whole or in part of a reproduction of said trade mark, or who affixes the same to goods of essentially the same descriptive properties and qualities as those referred to in the registration of such trade mark, with intent to pass off, or to assist other persons to pass off, any goods to which such reproduced, copied, imitated, forged or counterfeited trade mark, or label or brand is affixed, or intended to be affixed, as the goods of the person, firm, company, or corporation owning the said trade mark, is guilty of a misdemeanor. [As amended March 27, 1897.]

Sec. 351. Every person who sells, or keeps for sale, or manufactures or prepares, for the purpose of sale, any goods upon or to which any reproduced, copied, imitated, forged, or counterfeited trade mark or label, or brand composed in whole or in part of such a reproduced, copied, imitated, forged, or counterfeited trade mark, has been affixed, after such trade mark has been recorded in the office of the secretary of state, or with the commissioner of patents in the United States patent office, intending to represent such goods as the genuine goods of the person, firm, company, or corporation owning the said trade mark, knowing the same to be reproduced, copied, imitated, forged, or counterfeited, is guilty of a misdemeanor. [As amended March 27, 1897.]

Sec. 352. The phrases "forged trade mark" and "counterfeited trade mark," or their equivalents, as used in this chapter, include every alteration or imitation of any trade mark so resembling the original as to be likely to deceive.

Sec. 353. The phrase "trade mark," as used in the three preceding sections, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper usually affixed by any mechanic, manufac-

urer, druggist, merchant, or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

Sec. 354. Every person who has in his possession, or who uses any cask, bottle, vessel, case, cover, label, brand, or other thing bearing, or having in any way connected with it, the trade mark of another, which has been duly recorded in the office of the secretary of state, or with the commissioner of patents in the United States patent office, or the trade name of another, for the purpose of disposing of any article other than that which such cask, bottle, vessel, case, cover, label, brand, or other thing originally contained, or is connected with by the owner of such trade mark or trade name, with intent to deceive or defraud, is guilty of a misdemeanor. [As amended March 27, 1897.]

Sec. 354a. Every person who willfully sells, or traffics in any cask, keg, bottle, vessel, siphon, can, case, or other package bearing the duly filed trade mark or name of another, printed, branded, stamped, engraved, etched, blown or otherwise attached or produced thereon, or refills any such cask, keg, bottle, vessel, siphon, can, case, or other package with intent to defraud the owner thereof, without the consent of the owner thereof, or unless the same shall have been purchased from the owner thereof, is guilty of a misdemeanor. [New section added March 14, 1899.]

Sec. 354b. Every person who shall willfully deface, erase, obliterate, cover up, or otherwise remove, destroy, or conceal the duly filed trade mark, or name of another, printed, branded, stamped, engraved, etched, blown, impressed, or otherwise attached to, or produced upon any cask, keg, bottle, vessel, siphon, can, case, or other package, for the purpose of selling, or trafficking in such cask, keg, bottle, ves-

sel, siphon, can, case, or other package, or refilling such cask, keg, bottle, vessel, siphon, can, case, or other package, with intent to defraud the owner thereof, without the consent of the owner, or unless the same shall have been purchased from the owner, is guilty of a misdemeanor. [New section added March 9, 1899.]

Sec. 1524-4 provides for search-warrant where a cask, keg, bottle, etc., bearing duly filed trade-name, etc., is in possession of any one except the owner thereof, with fraudulent intent.

DEERING'S POLITICAL CODE, 1886.

Section 3196. The phrase "trade mark" as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Sec. 3197. Any person may record any trade mark or name by filing with the secretary of state his claim to the same, and a copy or description of such trade mark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he (or the firm or corporation of which he is a member) is the exclusive owner, or agent of the owner, of such trade mark or name.

Sec. 3198. The secretary of state must keep for public examination a record of all trade marks or names filed in his office, with the date when filed and the name of claimant; and must at the time of filing collect from such claimant

a fee of three dollars in gold coin to be paid into the state library fund.

Sec. 3199. Any person who has first adopted and used a trade mark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain, by injunction, any use of trade marks or names in violation of this chapter.

By act of March 17, 1887, two sections (3200, 3201, Deering's Supplement 1889) were added which relate especially to the trade marks of labor unions and associations.

Chapter 154, p. 217, St. 1891, affords protection to manufacturers, bottlers, and vendors of soda water, mineral water, ale, porter, beer, and other beverages, in the use of their bottles, siphons, boxes, and kegs, and provides penalties for the unauthorized use of, or the defacement of, names, marks, etc., upon such bottles, boxes, siphons, and kegs, by other parties.

COLORADO.

LAW 1899, CH. 154.

An act to confer exclusive rights to the use of labels, trade marks, terms, designs, devices or forms of advertisement, and provide for the recording of the same, to provide a remedy for the violation of such right, and the penalty for the unlawful use of labels, trade marks, terms, designs, devices and forms of advertising, and to repeal all acts and parts of acts inconsistent herewith.

Section 1. Whenever any person, or any association or union of workmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods,

wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workmen, or by a member or members of such association or union. it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed shall be punished by a fine of not more than five hundred dollars (\$500) or by imprisonment for not more than three months or by both such fine and imprisonment.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement as provided in section 1 of this act, may file the

same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right of such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association, any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association. But the said secretary shall file and record under this act any label, trade mark, term, design, device or form of advertisement, which may have been previously filed by any person, or any association

or union of workmen, provided the person, association or union seeking to file and record under this act is the same person, association or union that previously filed or recorded the same label, trade mark, term, design, device or form of advertisement.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations, or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding five hundred dollars (\$500) or by imprisonment not exceeding three months, or by both such fine and imprisonment.

Sec. 5. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit for damages to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunction to restrain such manufacture, use, display or sale and award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendant to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 6. Every person who shall use or display the gen-

nine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars (\$500). In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than five hundred dollars (\$500).

Sec. 8. In case the plaintiff is successful in maintaining his action either for damages or for permanent relief by injunction, or for nominal damages only, he shall be entitled to recover a reasonable attorney's fee, to be taxed by the court as a part of the costs, and merged in the judgment.

Sec. 9. All acts and parts of acts inconsistent herewith are hereby repealed; provided, that this act shall not be construed as impairing any rights heretofore accrued, nor as affecting the remedies therefor heretofore existing.

Approved April 10, 1899.

Sections 2985a-2985f, Mills' Ann. St. 1891-1896, covered largely the same ground as the above act. Sections 2985g-2985k, inclusive, protect manufacturers, bottlers, and vendors of mineral water and other beverages, medical and other preparations, against the unauthorized use of or injury to their barrels, kegs, casks, boxes, fountains, bottles, jugs, siphons, etc., by other parties.

CONNECTICUT.**GENERAL STATUTES OF CONNECTICUT—REVISION OF 1902.**

§ 4899. Every person entitled to the exclusive use of any trade mark, or who intends to adopt and use any trade mark not previously adopted or used by another, may file for record in the office of the secretary of the state, a certificate, setting forth his name, residence, and place of business; the class of merchandise, and the particular description of goods comprised in such class, to which such trade mark has been or is to be appropriated; a description of such trade mark, and of the mode in which it is to be applied and used; the date when such trade mark was first used or adopted; that he has a right to the use of it; and that no other person has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive. A fac-simile of such trade mark shall be incorporated in or annexed to such certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record book, if practicable. Such certificate shall be signed by the person in whose behalf it is filed, or by his agent, and the person so signing it shall make oath or affirm that all the statements therein contained are true, to the best of his knowledge and belief.

§ 4900. Every person who shall willfully swear or affirm falsely, in any such affirmation or affidavit, as to any matter therein required to be set forth, shall be guilty of perjury, and shall pay treble damages to every party injured thereby.

§ 4901. If the secretary of the state has reason to apprehend, on the filing of any such certificate, that the statements therein contained, or any of them, are untrue, he may decline to record the same, unless the party filing it shall obtain a writ of mandamus to compel such recording. Such

writ may be granted, but without costs to the secretary, by any proper court, on due proof that all the statements in such certificate are true, but no final hearing on the application therefor shall be had until such notice thereof as the said court may order has been advertised in one or more newspapers published in the county where the party filing said certificate resides. And any persons who desire may appear and intervene as parties defendant and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

§ 4902. Every person having the lawful right to make and file such a certificate and affidavit, upon the recording of the same in said office, shall be entitled to the exclusive use of the trade mark therein described for so long as he or his assigns shall continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right shall be assignable in writing; but all assignments thereof shall be good only against the assignor and his personal representatives until lodged for record in said office.

§ 4903. The secretary shall retain all such certificates on file, and cause the same and all assignments of trade-mark rights to be recorded at length in his office. Copies of the record of any such certificate, attested by him under the seal of the state, shall be *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trade mark therein described for the periods limited in § 4902.

§ 4904. Every person who shall reproduce, copy, counterfeit, or imitate any such recorded trade mark, knowing the same to have been recorded, and affix such reproduction, copy, counterfeit, or imitation to goods resembling or designed to resemble those to which such trade mark is so appropriated, shall pay to the owner of such trade mark double

damages, and also such sum, not more than five hundred dollars, as the court before which the action is brought may order to be added to the damages found by the verdict or judgment.

§ 4905. The provisions of this chapter shall not abridge any rights to any trade marks, existing on the twenty-second day of April, 1880, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trade marks.

§ 4906. Every person who fraudulently and with intent to deceive, affixes any trade mark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle, or package similar in descriptive properties to those to which such trade mark is appropriated; or who fraudulently and with intent to deceive places in any receptacle or package to which is lawfully affixed a recorded trade mark, goods other than those which said trade mark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trade mark fraudulently affixed as above described in this section, or any goods contained in any package or receptacle having a lawful trade mark, which are not such goods as said trade mark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

LABELS OF TRADE UNIONS.*

§ 4907. Whenever any person, association or union of workmen has adopted for his or its protection any label, trade-mark, or form of advertisement, announcing that goods

*While the title of this act refers only to labels and trade-marks of trades unions, the body of the act covers also labels and trade-marks of "persons."

to which such label, trade-mark, or form of advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade-mark, or form of advertisement. Every person violating any provision of this section shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both.

§ 4908. Every person who shall use any counterfeit or imitation of any label, trade-mark, or form of advertisement of any such person, union or association, knowing the same to be a counterfeit or an imitation, shall be guilty of a misdemeanor, and shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both.

§ 4909. Every such person, association, or union that has heretofore adopted, or shall adopt a label, trade-mark, or form of advertisement as aforesaid, may file the same for record in the office of the secretary of state by leaving two copies, counterparts, or fac-similes thereof, with the secretary of the state. Said secretary shall deliver to such person, association, or union so filing the same a duly attested certificate of the record of the same. Such certificate of record shall in all suits and prosecutions under §§ 4907, 4908, 4910, 4911, and 4912 be sufficient proof of the adoption of such label, trade-mark, or form of advertisement, and of the right of said person, association, or union to adopt the same. No label shall be recorded that would probably be mistaken for a label already of record.

§ 4910. Every such person, association, or union adopting a label, trade-mark, or form of advertisement, as aforesaid, may enjoin the manufacture, use, display or sale of any counterfeit or imitation thereof; and all courts having jurisdiction thereof shall grant injunctions to restrain such

manufacture, use, display, or sale, and shall award the complainant in such suit, such damages, resulting from such wrongful manufacture, use, display or sale, as may, by said court, be deemed just and reasonable, and require the defendants to pay to such person, association, or union the profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court or to the complainant to be destroyed.

§ 4911. Every person who shall use or display the genuine label, trade-mark, or form of advertisement of any such person, association, or union, in any manner not authorized by such person, union, or association, knowing that such use or display is not so authorized, shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both. In all cases where such association or union is not incorporated, suits under §§ 4907, 4908, 4910, 4912, and this section may be commenced and prosecuted by any officer or member of such association or union, in behalf of and for the use of such association or union.

§ 4912. Every person who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, and knowing that such use is unauthorized, shall be fined not less than one hundred nor more than two hundred dollars, or imprisoned not less than three months nor more than one year, or both.

Approved May 25, 1893.

Sections 4913-4918, inclusive, protect manufacturers of soda and mineral waters, porter, beer, etc., in use of bottles, boxes, or siphons having his name or other marks or devices branded, stamped, etc., thereon, upon certain conditions.

DELAWARE.

CODE 1893, PAGE 552.

An act to protect associations and unions of workmen and persons in their labels, trade marks and forms of advertising.

Section 1. Whenever any person, association or union of workmen have adopted, or shall hereafter adopt for their protection, any label, trade mark or form of advertisement announcing that goods to which such label, trade mark or form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark, or form of advertisement. Every person violating this section shall, upon conviction, be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars (\$100) or both.

Sec. 2. Every person who shall use any counterfeit or imitation of any label, trade mark, or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more [than] one hundred dollars (\$100) or both.

Sec. 3. Every person, association or union, that has heretofore adopted, or shall hereafter adopt, a label, trade mark or form of advertisement as aforesaid, may file the same in the office of the secretary of state, by leaving two copies, counterparts or fac similes thereof with the secretary of state; said secretary shall deliver to such person, association or union so filing the same a duly attested certificate, for which he shall receive one dollar. Such certificate of filing shall

in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of such person, association or union to adopt the same. No label shall be received and filed by the secretary of state that probably would [be] mistaken for a label already filed.

Sec. 4. Every such person, association or union adopting a label, trade mark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display, or sale, and shall award the complainant in such suit such damages, resulting from such wrongful manufacture, use, display or sale as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession, or under the control, of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. Every person who shall use or display the genuine label, trade mark, or form of advertisement of any such person, association, or union in any manner not authorized by such person, union, or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any member or officer of such association or union on behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use

the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars, or both.

Sec. 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complainant shall so elect, and in case of conviction before such justice of the peace the offender shall stand committed to the county jail until the fine and costs are fully paid.

Sec. 8. This shall be deemed and taken to be a public act.
Passed at Dover, March 29, 1893.

Chapter 92, vol. 16, Laws of Delaware (Code 1893, p. 551), affords protection to manufacturers and vendors of mineral water, porter, ale, or other beverages against the unauthorized use of or injury to their bottles by other persons.

Chapter 226, p. 435, of the Laws of Delaware of 1898-1899, provides for the protection of any labor organization, association, or society having headquarters in Delaware, whether an independent body or branch of a national or international one, in the adoption, use, and record of a label or seal.

FLORIDA.

Rev. St. 1892.

2481. Whoever, knowingly and wilfully, forges or counterfeits or causes or procures to be forged or counterfeited upon any goods, wares or merchandise, the private label, stamps or trade marks of any mechanic or manufacturer, knowing the same to be forged or counterfeited, without disclosing the fact to the purchaser, shall be punished by imprisonment not exceeding twelve months, or by fine not exceeding one hundred dollars.

2482. Whoever vends any goods, wares or merchandise,
Trade-Marks—43.

having thereon a forged or counterfeit stamp, label, or trade mark of any mechanic or manufacturer, knowing the same to be forged or counterfeited, without disclosing the fact to the purchaser, shall be punished by imprisonment not exceeding six months, or by fine not exceeding fifty dollars.

Acts 1897, Ch. 4584 (No. 70).

An act to protect the owners of bottles, boxes, siphons, fountains, tins or kegs used in the sale of soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages, or medicines, medical preparations, perfumery, oils, compounds or mixtures.

Section 1. Any and all persons and corporations engaged in manufacturing bottling or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicines, medical preparations, perfumery, oils, compounds or mixtures, in bottles, siphons, fountains, tins or kegs, with his, her, its or their name or names, or other marks or devices branded, stamped, engraved, etched, blown, impressed or otherwise produced upon such bottles, siphons, fountains, tins or kegs, or the boxes used by him, her, it or them, may file in the office of the clerk of the county in which his, her, its or their principal place of business is situated, or if such person, persons, corporation or corporations shall manufacture or bottle out of this state then in any county in this state, and also in the office of the secretary of state, a description of the name or names, marks or devices so used by him, her, it or them, respectively, and cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed as aforesaid.

Sec. 2. It is hereby declared to be unlawful for any per-

son or persons, corporation or corporations, to fill with soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or with medicine, medical preparations, perfumery, oils, compounds or mixtures, any bottle, box, siphon, fountain, tin or keg, so marked or distinguished as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section 1 of this act, or to deface, erase, obliterate, cover up or otherwise remove or conceal any such name, mark or device thereon, or to sell, buy, give, take or otherwise dispose of, or wantonly destroy, or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or persons, corporation or corporations, whose mark or device shall be or shall have been in or upon the bottle, box, siphon, fountain, tin or keg so filled, trafficked in, used or handled as aforesaid. Any person or persons or corporation or corporations, offending against the provisions of this section shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment not less than ten days nor more than one year, or by a fine of fifty cents for each and every such bottle, box, siphon, fountain, tin or keg so filled, sold, used, disposed of, bought or wantonly destroyed, or trafficked in, or by both such fine and imprisonment, and for each subsequent offense by imprisonment not less than twenty days nor more than one year, or by a fine of not less than one dollar nor more than five dollars for each and every bottle, box, siphon, fountain, tin or keg so filled, sold, used, disposed of, bought or wantonly destroyed, or trafficked in, or by both such fine and imprisonment, in the discretion of the court before whom the offense shall be tried.

Sec. 3. The use by any other person than the person or persons, corporation or corporations, whose device, name or mark shall be or shall have been upon the same without such

written consent or purchase as aforesaid, of any such marked or distinguished bottle, box, siphon, fountain, tin or keg, a description of the name, mark or device, whereon shall have been filed and published, as herein provided, for the sale therein of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer, or other beverages, or any article of merchandise, medicines, medical preparations, perfumery, oils, compounds, mixtures or preparations, or for the furnishing of such or similar beverages to customer, or the buying, selling, using, disposing of or trafficking in any such bottles, boxes, siphons, fountains, tins or kegs by any person other than said persons or corporations having a name, mark or device thereon of such owner without such written consent, or the having by any junk dealer or dealers in second-hand articles possession of any such bottles, boxes, siphons, fountains, tins or kegs, a description of the marks, names or devices whereon shall have been so filed and published as aforesaid, without such written consent, shall, and is hereby declared to be presumptive evidence of the said unlawful use, purchase and traffic in of such bottles, boxes, siphons, fountains, tins or kegs.

Sec. 4. Whenever any person, persons or corporation mentioned in section 1 of this act, or his, her, its or their agent shall make oath before any justice of the peace in the district where the offense is committed that he, she, or it has reason to believe, and does believe, that any of his, her, its or their bottles, boxes, siphons, fountains, tins or kegs, a description of the names, marks or devices whereon has been so filed and published as aforesaid, are being unlawfully used or filled or had by any person or corporation manufacturing or selling soda, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicine, medical preparations, perfumery, oils, compounds or mixtures, or that any junk dealer or

dealer in second-hand articles, vendor of bottles, or other person or corporation has any such bottles, boxes, siphons, fountains, tins or kegs in his, her or its possession or secreted in any place, the said justice of the peace must thereupon issue a search warrant to discover and obtain the same, and shall also cause to be brought before him the person in whose possession such bottles, boxes, siphons, fountains, tins or kegs may be found, and shall then inquire into the circumstances of such possession, and if such justice of the peace, upon trial and conviction had, finds that such person has been guilty of a violation of section 2 of this act, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof; provided, that in any counties where criminal courts of record exist the said justice of the peace shall act only as a committing magistrate as in other cases in so far as trying the offender and imposing the said punishment are concerned.

Sec. 5. The requiring, taking or accepting of any deposit, for any purpose, upon any bottle, box, siphon, fountain, tin or keg shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this act.

Sec. 6. All laws and parts of laws inconsistent herewith are, for the purpose of this act, hereby repealed.

Sec. 7. This act shall take effect immediately upon its passage and approval by the governor.

Approved June 5, 1897.

Acts 1901, Ch. 4974 [No.] 90.

An act to authorize any person, association, or union of workmen to adopt and use a label or trade-mark, to protect the same by law, to provide for its record, to prevent counterfeiting the same, or using the original or any package containing the same; and to prevent using

the name or seal thereof without authority, and fixing penalties for violations thereof.

Be it enacted by the legislature of the state of Florida:

Section 1. Whenever any person or any association of workmen has heretofore adopted or used, or shall hereafter adopt or use, and has filed as hereinafter provided, any label, trade-mark, term, wording, design, device, color or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed, or put on sale by such person or association or union of workmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade-mark, term, wording, design, device, color or form of advertisement, or knowingly to use, sell, or offer for sale, or in any other way utter or circulate any counterfeit or imitation of any such label, trade-mark, term, wording, design, device, color or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade-mark, term, wording, design, device, color or form of advertisement, or knowingly sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trade-mark, term, wording, design, device, color or form of advertisement; or knowingly purchases and keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly purchases with intent to sell or dispose of any goods, wares, merchandise or other product of labor contained in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, stamped or impressed; or having knowingly purchased, keeps

or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than five hundred dollars, or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade-mark, term, wording, design, device, color or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade-mark, term, wording, design, device, color or form of advertisement shall be filed, the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trade-mark, term, wording, design, device, color or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union or corporation has the right to (such) use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of two dollars. Said secretary shall deliver to such person, association, or union so filing or causing to be filed any such label, trade-mark, term, wording, design, device, color or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which the secretary shall receive a fee of one dollar. Any such

certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade-mark, term, wording, design, device, color or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade-mark, term, wording, design, device, color or form of advertisement that would probably be mistaken for any label, trade-mark, term, wording, design, device, color or form of advertisement heretofore filed by or on behalf of any other person, union or association.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade-mark, term, wording, design, device, color or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars, or by imprisonment not exceeding three months.

Sec. 5. Every such person, association or union adopting or using a label, trade-mark, term, wording, design, device, color or form of advertisement or aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit damages resulting from any such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display or sale:

and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainants, to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trade-mark, term, wording, design, device, color or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. Any person using the trade-mark so adopted and used by any other person, or any imitation of such trade-mark or any counterfeit thereof; or who shall in any manner mutilate, deface, destroy or remove such trade-mark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second-hand package, which has contained the same or been used therefor, with the intention of using such empty or second-hand package, or of the same being used to contain goods, wares, merchandise, article or articles of the same general character as those for which they were first

used; and any person who shall use any such empty or second-hand package for the purpose aforesaid, without the consent in writing of the person whose trade-mark was first applied thereto or placed thereon, shall, upon conviction thereof, be fined in any sum not less than five hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles contained in such second-hand package or packages shall be forfeited to the original user of such package or packages whose trade-mark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular article or package shall be held to be a separate offense.

Sec. 9. The word "person" in this act shall be construed to include a person, copartnership, corporation, association or union of workmen.

Sec. 10. This act shall take effect immediately upon its passage and approval by the governor.

Approved May 29, 1901.

GEORGIA.

Code 1895, Vol. 1.

Section 1736. Whenever any person, association or union of workmen have adopted, or shall hereafter adopt for their protection, any label, trade mark, or form of advertisement announcing that goods to which such label, trade mark, and forms or advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade mark, or form of advertisement with intent to use the same for the purpose of deceiving the public in the sale of the goods.

Sec. 1737. Every person who shall use any counterfeit or imitation of any label, trade mark, or form of advertisement of any such person, union, or association, knowing the same

to be counterfeit or imitation, shall be guilty of a misdemeanor.

Sec. 1738. Every person, association, or union of workmen that has adopted or shall hereafter adopt a label, trade mark, or form of advertisement, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with the secretary of state. Said secretary shall deliver to such person, association, or union, a duly attested certificate of the record of the same, for which he shall receive the fee of one dollar; such certificate of record shall, in all suits under this chapter, be sufficient proof of the adoption of such label, trade mark, or form of advertisement, and of the right of said person, association, or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

Sec. 1739. Every such person, association, or union adopting a label, trade mark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunction to restrain such manufacture, use, display or sale, and shall award the complainant in such suits such damages resulting from such wrongful manufacture, use, display, or sale as may by said courts be deemed just and reasonable, and shall require the defendant to pay such person, association, or union the profit derived from such wrongful manufacture, use, display, or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 1740. In all cases where such associations or unions are not incorporated, suits may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 1741. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, knowing that such use is unauthorized, with the intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor.

CODE 1895, VOL. 2.

Section 4035. Any attempt to encroach upon the business of a trader, or other person, by the use of similar trade marks, names or devices, with the intention of deceiving and misleading the public, is a fraud for which equity grants relief.

SUPPLEMENT TO THE CODE OF GEORGIA, 1901 (VOL. 4 OF CODE.) .

§ 6676. Whenever any person, firm, corporation or association shall adopt and use in their business, for their protection, any label, trade mark, trade name or form of advertisement, it shall be unlawful for any person, firm, corporation or association to counterfeit or imitate such label, trade mark, trade name or form of advertisement, with intent to use the same for the purpose of deceiving the public in the sale of goods. Every person violating this section shall be guilty of a misdemeanor and punished therefor.

§ 6677. Every person, firm, corporation or association who shall use any counterfeit or imitation of any label, trade mark, trade name or form of advertisement of any person, firm, corporation or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor and punished therefor.

§ 6678. Every person, firm, corporation or association who shall use or display the genuine label, trade mark, trade name or form of advertisement of any person, firm, corporation or association, in any manner not authorized by law, such per-

son, firm, corporation or association, knowing that such use is not authorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and be punished therefor.

§ 6679. Any firm, person, corporation or association who shall use the name or seal of any other person, firm, corporation or association, in and about the sale of goods or otherwise, not being authorized to use the same, knowing that such use is unauthorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and punished therefor.

§ 6680. Any person, firm, corporation or association that shall be found guilty of violating the provisions of this act, or any of them as aforesaid, shall be punished as prescribed in section 1039 of the Penal Code.

By section 1039, vol. 3, Code 1895, the punishment for a misdemeanor is a fine not exceeding \$1,000, or imprisonment not exceeding six months, or work in the chain gang not exceeding twelve months, either or all, at the discretion of the judge.

The provisions of sections 252 to 255 of volume 3 of the Code of 1895 appear to be substantially included in the sections and act above quoted, and are therefore not reproduced. Sections 2 and 4 of the act of 1898 are very similar to sections 1737 and 1741 of volume 1 of the Code of 1895, above quoted.

IDAHO.

POLITICAL CODE OF 1901.

Sec. 635. Whenever any person or any association or union of workmen has heretofore adopted or used, or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement, for the purpose of designating, making known or distinguishing any goods, wares, merchandise, or other products of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, or association, or union of workmen, or by a mem-

ber or members of such association, or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 636. Every such person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section 635, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or fac similes thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trade mark, term,

design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association; and any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this subdivision, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction.

Sec. 637. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture and may award the complainant in any such damage resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such persons, association, or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed; and in all cases where such association or union is not incorporated, suits may be commenced and prosecuted by an officer or members of such association or union, on behalf of, and for the use of such association or union.

PENAL CODE OF 1901.

Sec. 4950. Whoever counterfeits or imitates any label, trade mark, term, design, device or form of advertisement, described in section 635 of the Political Code, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be guilty of a misdemeanor and be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

Sec. 4951. The phrases "forged trade mark" and "counterfeit trade marks," or their equivalents, as used in this chapter, includes every alteration or imitation of any trade mark so resembling the original as to be likely to deceive.

Sec. 4952. The phrase "trade mark," as used in section 4950, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be goods im-

ported, manufactured, produced, compounded, or sold by him other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Section 4999. Any person who shall for himself or on behalf of any other person, association, or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state, by making any false or fraudulent representations or declarations, verbally, or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by, or on behalf of, the party injured thereby in any court having jurisdiction, and shall be guilty of a misdemeanor and be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months.

Section 5000. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union, in any manner not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months, or by fine of not more than one hundred dollars.

Section 5001. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sections 6862, 6863. Rev. St. 1887, make the counterfeiting or forgery of trade marks, or the sale of goods with counterfeit trade marks thereon, a misdemeanor. Sections 6864 and 6865 give definitions of the phrases "trade mark," "forged trade mark." and "counterfeited trade mark," as used in the chapter.

ILLINOIS.

STARR & C. ST. 1896, VOL. 3, PAGES 3955-3957.

An act to protect associations, unions of workmen and persons in their labels, trade marks and forms of advertising.

Par. 6, § 1. Whenever any person or any association or union of workmen has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Par. 7, § 2. Whoever counterfeits or imitates any such label, trade-mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters, or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement, or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells, or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or keeps or has in his possession with intent

that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not less than one hundred (100) dollars, nor more than two hundred (200) dollars, or by imprisonment for not less than three (3) months nor more than one (1) year, or by both such fine and imprisonment.

Par. 8, § 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section one (1) of this act, shall file the same for record in the office of the secretary of state, by leaving two (2) copies, counterparts or *fac similes* thereof with said secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trade mark, term, design, device or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writ-

ing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding two hundred (200) dollars or by imprisonment not exceeding one (1) year or both such fine and imprisonment. The secretary of state shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one (1) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

Par. 9, § 4. Every such person, association or union adopting a label, trade mark, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations; and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages, resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant to be destroyed.

Par. 10, § 5. Every person who shall use or display the genuine label, trade mark, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Par. 11, § 6. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both.

JONES & ADDINGTON'S SUPPLEMENT 1902 (VOL. 4, STARR
& C. ST.)

Paragraph 1, § 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complaining shall so elect, and in case of conviction before such justice of the peace the offender shall stand committed to the county jail until the fine and costs are fully paid, under the provisions of section 8, article IX, of an act to revise the law in regard to criminal jurisprudence, in force July 1, 1874, or otherwise. The first process under this section in all prosecutions for the recovery only of the fines, shall be a summons: provided, however, that a warrant for the arrest of the offender, as in other cases when justices of the peace have

original criminal jurisdiction, may issue upon the affidavit of any person that any of the provisions of this act have been violated, and that the person making the complaint has just and reasonable grounds to believe the party charged is guilty thereof. [Section as amended by act approved April 22, 1899. See vol. 3, p. 3957, paragraph 12.]

The act approved May 2, 1873 (paragraphs 1-5, inclusive, chapter 140, Starr & C. St. 1896), provides for the protection of manufacturers, bottlers, and sellers of ale, porter, beer, mineral water, and other beverages against the unauthorized use or willful destruction of their bottles, boxes, casks, kegs, etc., by other persons.

See, also, an act to prevent and punish the unlawful buying, selling, keeping for sale, using, filling or trafficking, in cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, cartons, tanks, fountains, vessels or containers; to provide for the registration of the names, brands, designs, trade-marks, devices, and other marks of ownership in connection with such articles, and to protect the owners thereof. Approved May 11, 1901. In force July 9, 1901. Laws 1901, p. 316; Jones & Addington's Supplement 1902 (vol. 4, Starr & C. St.), c. 140, pars. 2-7, pp. 1261-1264, inclusive.

INDIANA.

BURNS' ANNOTATED INDIANA STATUTES, REVISION OF 1901.

8681. That any firm, person, corporation or voluntary association that are citizens of the state of Indiana, except foreign corporations, and who are entitled to the exclusive use of any lawful trade mark, label, brand, stamp or wrapper, may obtain protection for such lawful trade mark, label, brand, stamp or wrapper by complying with the following requirements: First, by causing to be filed with the secretary of state a statement specifying the names of the parties, and the residences and places of business, who desire the protection of the trade mark, label, brand, stamp or wrapper, the class of merchandise and the particular description of goods comprised in such class, by which the trade mark, label, brand, stamp or wrapper has been, or is intended to be pro-

ected. A description of trade mark, label, brand, stamp or wrapper, with *fac simile* thereof, showing the mode in which it has been and is intended to be applied and used, and the length of time, if any, during which the trade mark, label, brand, stamp or wrapper has been in use. Second, by making a payment of a fee of two dollars to the secretary of state, whose duty it will be to file and record said statement in a book kept for the purpose to be procured by him as other books in his office of like nature are procured.

8682. Any certificate or statement prescribed in the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or some member of the firm or officer of the corporation or voluntary association by whom it is filed, to the effect that the party claiming the protection for the trade mark, label, brand, stamp or wrapper, has a right to the same and that no other person, firm, corporation or voluntary association has the right to such use either in the identical form or in any such near resemblance as might be calculated to deceive; and that the description and *fac simile* presented for record are true copies of the trade mark, label, brand, stamp or wrapper sought to be protected.

8683. The time of the receipt of any trade marks, label, brand, stamp or wrapper at the office of the secretary of state for registration shall be noted and recorded. Certified copies of the trade mark, label, brand, stamp or wrapper, and the date of the receipt thereof, and of the statement and affidavit filed therewith shall be *prima facie* evidence of the facts and statements and affidavit record in any suit in which such trade mark, label, brand, stamp or wrapper shall be brought into controversy.

8684. A trade mark, label, brand, stamp or wrapper shall remain in force so long as it is used continuously: after a disuse of six months, it shall be deemed out of existence. Such

trade mark, label, brand, stamp or wrapper may be sold or assigned, or pass to personal representatives by will, or become assets of an estate. In any case where ownership changes of such trade mark, label, brand, stamp or wrapper, before it can be used by the successor in title, a statement of such change of ownership shall be filed with the secretary of state, and he shall record the same in the book kept for the purpose of recording trade marks, labels, brands, stamps and wrappers, and such secretary shall receive two dollars for recording such statement; and it shall be unlawful to use such trade mark, label, brand, stamp or wrapper till such change of ownership has been filed as aforesaid.

8685. Such trade mark, label, brand, stamp or wrapper shall entitle the person, firm, corporation, or voluntary association registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person, firm, corporation or voluntary association can lawfully use the same trade mark, label, brand, stamp or wrapper, or substantially the same, or so nearly resembling it as to be calculated to deceive upon substantially the same description of goods.

8686. For a violation of any rights created by this act, the person, firm, corporation or voluntary association aggrieved, shall have all common law remedies and actions for damages, and shall be entitled to an injunction to prevent further use of any trade mark, label, brand, stamp or wrapper by this act secured to the injured person, firm, corporation, or voluntary association; and, if an injunction is made final and perpetual, the injured person, firm, corporation or voluntary association shall recover reasonable attorney's fees.

8687. Any owner of a trade mark, label, brand, stamp or wrapper, who has complied with the provisions of this act, shall have the right to grant to others the authority to use

such trade mark, label, brand, stamp or wrapper; but such authority to so use must be in writing, signed by the owner of such trade mark, label, brand, stamp or wrapper, with two witnesses to such signature, and no one but the owner shall have the right to use such trade mark, label, brand, stamp or wrapper, unless such written authority has been given.

8688. If it becomes necessary for any voluntary association to assert any right to any trade mark, label, brand, stamp or wrapper, it shall be sufficient to use the name of president or chief officer of such association either in action at law, suit in equity, or indictment for the violation of the provisions of this act.

8689. This act shall not be construed to lessen, impair or abridge any rights or remedies that have heretofore existed in favor of any one owning or rightfully claiming a trade mark, label, brand, stamp or wrapper.

8690. That any person or persons, who shall knowingly or willfully cast or engrave, or manufacture, or have in his, her or their possession, or buy, sell or offer for sale, or deal in any die or dies, plate or plates, brand or brands, engraving or engravings on wood, stone, metal or other substances, molds or any false representations, likeness, copy or colorable imitation of any die, plate, brand or mold of any private trade mark, label, brand, stamp, wrapper, engraving on paper or other substance, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for not less than one year, or more than two years, or be fined in a sum not less than one thousand dollars, or more than two thousand dollars.

8691. That any person or persons [who shall] knowingly and willfully make, forge or counterfeit, or have in his, her or their possession, or buy, sell, offer for sale or deal in any representation, likeness, similitude, copy or colorable imitation of any private label, brand, stamp, wrapper, engrav-

ing, mold or trade mark, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for a period of years not more than two nor less than one, or be fined in any sum not less than one thousand dollars nor more than two thousand dollars.

8692. It shall be unlawful for any person, firm, corporation or voluntary association doing business in this state to have in his or its possession, or to sell, or offer for sale or trade, any goods, wares, merchandise or other article upon which he or it knows is placed or affixed a false, forged or spurious trade mark, label, brand, stamp, or wrapper in likeness or imitation of some trade mark, label, brand, stamp, or wrapper registered as provided for in this act; and any such person, firm, corporation or voluntary association so having in his or its possession or selling, or offering for sale or trade, any goods, wares or merchandise upon which he or it knows is placed or affixed a false, forged or spurious trade mark, label, brand, stamp or wrapper in likeness or imitation of some trade mark, label, brand, stamp or wrapper registered as aforesaid shall, upon conviction thereof, be punished by fine in a sum of not less than fifty dollars (\$50.00) nor more than two hundred dollars (\$200.00), or imprisoned in the county jail six months, or both.

Sections 8678-8680c, inclusive, are designed to protect manufacturers, bottlers, and sellers of mineral water, cider, ale, beer, ginger pop, soda water, distilled water, ginger ale, seltzer water, fermented liquors, and other beverages against the unauthorized use of or injury to their bottles or syphons by other parties.

Sections 8693-8703, inclusive, protect labor unions and associations in the use of their labels, names, stamps, etc.

IOWA.

CODE 1897, CH. 13, TIT. 24.

Section 5049. Every person or association or union of

working men or others that has adopted or shall adopt for their protection any label, trade mark or form of advertisement, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof with the secretary of state. Said secretary shall thereupon deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all actions and prosecutions under the following six sections be sufficient proof of the adoption of such label, trade mark or form of advertisement, and the right of said person, association or union to adopt the same.

Sec. 5050. Every person, association or union adopting a label, trade mark or form of advertisement, as specified in the preceding section, may proceed by action to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof; and all courts having jurisdiction of such actions shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant therein such damages resulting from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and shall require the defendant to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court to be destroyed. Such actions may be prosecuted for the benefit of any association or union by any officer or member thereof.

Sec. 5051. It shall be unlawful for any person or corporation to imitate any label, trade mark or form of advertisement adopted as provided in the second preceding section, or

to knowingly use any counterfeit or imitation thereof, or to use or display such genuine label, trade mark or form of advertisement, or the name or seal of such person, union or association, or of any officer thereof, unless authorized so to do, or in any manner not authorized by him or it. Any person violating any provision of this section shall be imprisoned in the county jail not more than thirty days, or be fined not less than twenty-five nor more than one hundred dollars.

Sec. 5052, Supplement (to Code) 1902, protects persons engaged in manufacturing, bottling, or selling soda water or other beverages against the unauthorized use of their bottles, barrels, kegs, etc.

KANSAS.

GENERAL STATUTES 1901.

§ 7850. If any person or persons shall willfully change, alter, deface, destroy, counterfeit, cut out or dispose of any trade mark, brand, impression or device used by a person, company or corporation within this state, to designate a particular description of goods, wares, merchandise, cask, barrel, half-barrel, keg, bottle, package, or the contents thereof, he or they shall forfeit and pay to the owner or owners thereof, for each offense, not exceeding the sum of twenty-five dollars, to be recovered in any court proper to try the same, or before a justice of the peace having jurisdiction of the same.

§ 7851. If any person shall change, shift and place any brand, mark or device, used or intended to be used for the purpose aforesaid, to or upon any piece of goods, wares, merchandise, cask, barrel, half-barrel, keg, bottle or package, or shall intermix, take out, change or shift any article, liquid or commodity whatever, into a branded cask, barrel, half-barrel, keg, bottle or package, and thereby avail him or themselves of another person or persons' brand, mark, or device, he or

they shall forfeit for every such offense the sum of twenty-five dollars, to be recovered as aforesaid.

Sections 7852-7857, inclusive, protects labor unions in the use of their labels and trade marks.

KENTUCKY.

Chapter 130. Gen. St. 1899, protects labor unions and associations in the use of their labels, marks, brands, etc.

Sections 1279 and 1279a, Gen. St. 1899, protect manufacturers, bottlers, and sellers of soda water and other beverages, medicines, medical preparations, perfumery, oils, compounds, or mixtures in bottles, siphons, tins or kegs against the unauthorized use of or injury to their bottles, siphons, tins, kegs, etc., by other parties.

No general trade-mark law.

LOUISIANA.

Acts 1898, No. 49.

An act to protect labels, trade marks, terms, designs, devices or forms of advertisement, and to provide a penalty for violation thereof.

Section 1. Whenever any person, or any association or union of workmen, has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label,

trade mark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other products of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association,

union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device or form of advertisement heretofore filed by or on behalf of any other person, union or association.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design, device or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damage sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

Sec. 5. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of

advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. This act shall take effect and be in force from and after its passage.

Approved July 8, 1898.

Act 120 of 1896 (Wolff's Rev. Laws, p. 204) affords protection to manufacturers, bottlers, and sellers of seltzer and mineral waters against the unauthorized use of or injury to their bottles and siphons by other parties.

MAINE.

EXTRACT FROM CHAPTER 39, REV. ST. 1883.

Section 37. Any person entitled to the exclusive use of any trade mark, or who intends to adopt and use any trade mark not previously adopted or used by another, may file for record in the office of the secretary of state a certificate setting forth his name, residence and place of business; the class of merchandise and the particular description of goods comprised in such class to which such trade mark has been or is to be appropriated; a description thereof, and of the mode in which it is to be applied and used; the date when it was first used or adopted; that he has a right to the use of it; and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as is calculated to deceive. A *fac simile* of such trade mark shall be incorporated in or annexed to said certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record book, if practicable. Such certificate shall be signed and sworn to by such person, or his agent.

Sec. 38. Whoever willfully swears or affirms falsely to any such certificate, is guilty of perjury, and shall pay treble damages to every party injured thereby. If the secretary of state has reason to apprehend, on the filing of such certificate, that any statement therein contained is untrue, he may decline to record the same, unless the party filing it obtains a writ of mandamus to compel him. Such writ may be granted, but without costs to the secretary, by any proper court, on proof that all the statements in such certificate are true, but no

final hearing on the application therefor, shall be had until such notice thereof as said court orders has been advertised in one or more newspapers published in the county where the party filing said certificate resides; and any persons who desire may appear and intervene as parties defendant, and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

Sec. 39. Every party entitled to make and file such certificate and affidavit, upon recording the same in said office, becomes entitled to the exclusive use of the trade mark therein described, so long as he or his assigns continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right is assignable in writing; but all assignments thereof are good only against the assignor and his personal representatives, until lodged for record in said office.

Sec. 40. The secretary of state shall retain all such certificates on file, and cause the same and all assignments of trade mark rights to be recorded at length in his office, and is entitled to a fee of three dollars for each certificate, and one dollar for each assignment so filed and recorded. Copies of the record of any such certificate, attested by him under the seal of the state, are *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trade mark therein described for the periods limited in the preceding section.

Sec. 41. Whoever reproduces, copies, counterfeits, or imitates any such recorded trade mark, knowing the same to have been recorded, and affixes such reproduction, copy, counterfeit, or imitation to goods resembling or designed to resemble those to which such trade mark is so appropriated, shall pay to the owner of such trade mark double damages, besides such sum, not exceeding five hundred dollars, as the court before

which the action is brought orders to be added to the damages found by the verdict or judgment.

Sec. 42. Whoever fraudulently and with intent to deceive, affixes any trade mark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle or package similar in descriptive properties to those to which such trade mark is appropriated, or who fraudulently and with intent to deceive, places in any receptacle or package to which is lawfully affixed a recorded trade mark, goods other than those which said trade mark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trade mark fraudulently affixed as above described, or any goods contained in any package or receptacle having a lawful trade mark, but not being such goods as said trade mark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

Sec. 43. This chapter does not abridge rights to any existing trade marks, whether the same are hereafter recorded or not, nor any remedies or rights of action otherwise or heretofore existing in favor of owners of trade marks.

Laws 1893, Ch. 276.

An act to protect persons, associations and unions of workmen and others in their labels, trade marks, devices and forms of advertising.

Section 1. Whenever any person, or any association, or union of workmen has adopted and used, or shall hereafter adopt and use any label, trade mark, device, or form of advertisement to indicate that goods to which such label, trade mark, device or form of advertisement, shall be attached or affixed, or on which the same shall be printed, painted, stamped or impressed, were manufactured or produced, pack-

ed or put on sale by such person or by such association or union, or by a member or members thereof, which was not, before such adoption and use, lawfully adopted, owned and used by another as a label, trade mark, device or form of advertisement, from whom no right or authority to use and adopt the same had been acquired by such person, or by such association or union, or by such member or members thereof, nor a counterfeit, imitation or semblance thereof, it shall be unlawful to counterfeit or imitate such label, trade mark, device or form of advertisement, or use the same without the consent or authority of the person, association or union so having adopted and used it.

Sec. 2. Whoever knowingly, and with intent to mislead or deceive, counterfeits or imitates any such label, trade mark, device or form of advertisement, or knowingly uses or sells any such counterfeit or imitation of any such label, trade mark, device or form of advertisement, or knowingly sells or disposes of, or keeps, or has in his possession with intent that the same shall be sold, any goods to which any such counterfeit or imitation of such label, trade mark, device or form of advertisement is attached or affixed, or on which the same is printed, painted, stamped or impressed, shall, for the first offense be punished by fine not exceeding one hundred dollars, or by imprisonment for less than one year, and for the second and every subsequent offense, he shall be punished by fine not less than one hundred, nor more than five hundred dollars, or by imprisonment not less than sixty days, nor more than three years.

Sec. 3. Every such person, association or union that has heretofore adopted or shall hereafter adopt, a label, trade mark, device or form of advertisement as aforesaid shall file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state, together with a statement, in writing,

signed and sworn to by such person or by some person for and in behalf of such association or union, stating when and by whom so far as he knows and believes, said label, trade mark, device or form of advertisement was adopted or used, in what manner and for what purpose the same is to be used and by what right he claims the same, and such other particulars as shall serve to identify the same, said secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of two dollars. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, device, or form of advertisement. No label, trade mark, device or form of advertisement shall be recorded that so nearly resembles one already recorded as to be liable to be mistaken for such label, trade mark, device or form of advertisement and when in the judgment of the secretary of state, such resemblance exists he shall refuse to record such label, trade mark, device or form of advertisement.

Sec. 4. Every such person, association or union that has adopted and uses a label, trade mark, device or form of advertisement, as aforesaid, and which has been recorded in the office of the secretary of state as hereinbefore provided, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations, or of any goods to which such counterfeits or imitations shall be affixed or attached, or on which the same shall be printed, painted or impressed, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages resulting from such wrongful manufacture, use, display or sale as may by said court be deemed reasonable, and shall require the defendants to pay such person, association or union the profits derived from such wrongful manufacture,

use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case, be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. Every person who shall willfully use or display the genuine label, trade mark, device, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not more than six months, or by a fine not exceeding one hundred dollars, or both; and upon conviction for a second offense, shall be punished by imprisonment not less than thirty days nor more than one year, or by a fine not less than fifty nor more than three hundred dollars, or both.

Sec. 6. Any person or persons who shall in any way willfully use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not more than six months, or by a fine not exceeding one hundred dollars, or both; and upon conviction for a second offense shall be punished by imprisonment not less than thirty days nor more than one year, or by a fine not less than fifty nor more than three hundred dollars, or both.

Sec. 7. In all cases where the association or union mentioned in this act is not incorporated, suits and proceedings under this act may be commenced and prosecuted by an officer or member of such association or union, for and in behalf of and for the benefit of such association or union.

Approved March 28, 1893.

Sections 35-36, c. 39, Revised Statutes of 1883, as amended and another section added thereto by chapter 125, Gen. Laws 1891, afford protection to persons and corporations engaged in the man-

ufacture or sale of mineral water, soda water, ginger ale, and other similar beverages in the use of their bottles, and provide penalties for the unauthorized use of, or the defacement of names and marks upon, such bottles by other parties.

MARYLAND.

ACTS 1892, CH. 357.

An act to protect associations and unions of workingmen and persons in their labels, trade marks and forms of advertising and to punish offenders for a violation of the same.

Section 1. That whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection any label, trade mark or form of advertisement announcing and denoting that goods to which such label, trade mark or form of advertisement shall or may be attached, were manufactured by such person or by a member or members of such association or union, it shall not be lawful for any person or corporation to counterfeit or imitate such label, trade mark or form of advertisement. Every person violating this section shall be deemed guilty of a misdemeanor, and shall, upon conviction by any court having criminal jurisdiction, be punished by imprisonment in the city or county jail for not less than three months nor more than one year or by a fine of not less than one hundred dollars nor more than five hundred dollars, or both, in the discretion of the court.

Sec. 2. That every person, corporation or association who shall use any counterfeit or imitation of any label, trade mark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation shall be guilty of a misdemeanor and shall, on conviction by any court having criminal jurisdiction, be punished by imprisonment in the city or county jail for a term of not less

than one month nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both, in the discretion of the court, and the burden of proving that the defendant did not know the true character of the said label, trade mark or form of advertisement, and that he used the same in good faith shall be on the defendant.

Sec. 3. That every such person, association or union that has heretofore adopted, or shall hereafter adopt, a label, trade mark or form of advertisement as aforesaid, may file the same for record, in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state and said secretary shall deliver to such person, association or union so filing the same duly attested certificate of the record of the same for which he shall receive a fee of one dollar; such certificate of record shall be in all suits and prosecutions under this act sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of said person, association or union to adopt the same; no label shall be recorded that probably would be mistaken for a label already of record, of which question the said secretary shall be the judge.

Sec. 4. That every such person, association or union adopting a label, trade mark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeit, or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit such damage resulting from such wrongful manufacture, use, display or sale as may by said court be deemed just and reasonable, according to the evidence in the case, and shall require the defendants to pay such persons, associations, or unions the profits derived from such wrongful manufacture, use, display or sale, and in addi-

tion to court costs, such reasonable attorneys' fees as the court may allow, and said court shall also order that all such counterfeit or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. That every person who shall use or display the genuine label, trade mark or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall on conviction be punished by imprisonment in the city or county jail not less than one month nor more than one year, or by a fine of not less than fifty dollars or more than two hundred dollars, or both, in the discretion of the court.

Sec. 6. That any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable on conviction by imprisonment in the city or county jail for a term of not less than three months or more than one year, or by a fine of not less than fifty dollars nor more than three hundred dollars, or both, in the discretion of the court.

Sec. 7. That all the acts and parts of acts inconsistent with this act are hereby repealed.

Sec. 8. That this act shall take effect from the date of its passage.

Approved April 4, 1892.

Sections 201 to 206, inclusive, of article 27 of the Public General Laws, as amended by chapter 262 of the Acts of 1892, afford protection to manufacturers, bottlers, and dealers in mineral water and other beverages against the unauthorized use, refilling, or sale of their bottles, jugs, kegs, etc., by other persons.

MASSACHUSETTS.

REVISED LAWS (IN FORCE JANUARY 1, 1902), CHAPTER 72.

Definitions.

Section 1. The following words shall, in addition to their ordinary meaning, have the meaning herein given:

The word "name" or "names" in sections two, three, six, ten, twelve, fourteen, fifteen, sixteen, eighteen, nineteen and twenty-one of this chapter includes "letters," "marks," "devices" and "figures."

The word "person" or "persons" in sections two, seven, nine, fourteen to twenty, inclusive, and twenty-three, includes "firm," "association," "union" and "corporation."

The word "boots" in section four includes "half boots," "shoes," "pumps," "sandals," "slippers" and "overshoes."

The word "label" or "labels" in sections six to twelve, inclusive, includes "trade mark" "stamp" or "form of advertisement."

The word "beverage" or "beverages" in sections fifteen to eighteen, inclusive, includes also "milk," "cream," "soda water," "mineral" or "aerated waters," "ale," "beer," "ginger ale" or "similar beverages."

The word "vessel" or "vessels" in sections fifteen to eighteen, inclusive, includes "cans," "bottles," "siphons," "fountains" and "boxes."

The word "can" or "cans" in sections nineteen to twenty-three, inclusive, includes "jugs," "bottles" and "jars."

Labels and Trade Marks.

Section 2. When a person uses any peculiar name upon or connected with an article manufactured or sold by him to designate it as an article of a peculiar kind or quality, or as manufactured by him, no other person shall without his

consent use the same or any similar name for the purpose of falsely representing an article to have been manufactured by or to be of the same kind or quality as those manufactured or sold by the person rightfully using such name.

Section 3. Whoever violates the provisions of the preceding section, and whoever knowingly sells or exposes for sale an article having a name upon or connected with it in violation of the provisions of the preceding section, shall be liable in an action of tort to any party aggrieved thereby for all damages actually incurred.

Section 4. Every manufacturer of leather or boots shall have the exclusive right of stamping the articles manufactured by him with his name and the name of the place of manufacture; and such stamping shall be considered as a warranty that the article stamped is merchantable, made of good materials and well manufactured; and such article shall not be considered merchantable unless so stamped.

Section 5. A person who carries on business in this commonwealth shall not assume or continue to use in his business the name of a person formerly connected with him in partnership or the name of any other person, either alone or in connection with his own or with any other name or designation, without the consent in writing of such person or of his legal representatives.

Section 6. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the use of names or labels in violation of the provisions of this chapter.

Section 7. Any person may adopt a label, not previously owned or adopted by any other person, and file such label for record, by depositing two copies or *fac-similes* thereof in the office of the secretary of the commonwealth, one of which copies or *fac-similes* shall be attached by the secretary of the commonwealth to the certificate of record hereinafter referred to. The applicant shall file with the label a certificate spec-

ifying the name of the person so filing such label, his residence, situation or place of business, the kind of merchandise to which such label has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. If such label has not been and is not intended to be used in connection with merchandise, the particular purpose or use for which it has been or is intended shall be stated in the certificate. Such certificate shall be accompanied by a written declaration, verified under oath by the person, or by a member of the firm or by an officer of the association, union or corporation, by which it is filed, that the party so filing such label has a right to use the same, and that no other person has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the copies or *fac-similes* filed therewith are true. The secretary of the commonwealth shall issue to the person depositing such label a certificate of record, under the seal of the commonwealth, and the secretary shall cause the certificate to be recorded in his office. Such certificate of record or a certified copy of its record in the office of the secretary of the commonwealth, shall in all suits and prosecutions under the provisions of this section and of sections eight to fourteen, inclusive, be sufficient proof of the recording of such label and of the existence of the person named in the certificate. The fee for filing the certificate and declaration and issuing the certificate of record shall be two dollars. No label shall be recorded which could reasonably be mistaken for a label already on record.

Section 8. The secretary of the commonwealth is authorized to make regulations, and prescribe forms for the filing of labels, under the provisions of the preceding section.

Section 9. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the manufacture, use or sale of counterfeits or imitations of a label, recorded

as provided in section seven, shall award damages resulting from such wrongful manufacture, use or sale and shall require the defendant to pay the owner of such label the profits derived from such wrongful manufacture, use or sale; and may also order that all such counterfeits or imitations in his possession or control be delivered to an officer of the court, or to the complainant to be destroyed. If the complainant is not incorporated, suits under the provisions of sections seven, eight and ten to fourteen, inclusive, may be commenced and prosecuted by an officer thereof, on behalf of and for the use of the complainant. Every member of a complainant firm, association or union shall be liable for costs in any such proceeding.

Section 10. Whoever knowingly makes or uses any counterfeit or imitation of any lawful name or label or causes the same to be made or used, or sells, offers for sale, deals in or has in his possession with intent to use, sell, offer for sale or deal in the same, or affixes, impresses or uses such counterfeit or imitation upon any goods, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Section 11. Whoever, with intent to defraud, knowingly casts, engraves or manufactures, or has in his possession, or buys, sells, offers for sale, or deals in, a die, plate, brand, mould, or engraving on wood, stone, metal or other substance, of a label recorded pursuant to the statutes of this commonwealth, or a printing press, or types or other tools, machines or materials provided or prepared for making a counterfeit or imitation of such label, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Section 12. Whoever knowingly sells or exposes for sale goods upon which any lawful name or label or any counter-

feit or imitation thereof is unlawfully affixed, impressed, or used shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Section 13. Whoever, with intent to defraud, knowingly aids or abets in the violation of any of the provisions of the seven preceding sections shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than six months, or by both such fine and imprisonment.

Section 14. In any suit or prosecution under the provisions of the five preceding sections, the defendant may show that he was the owner of such name or label prior to its being filed under the provisions of section seven, and that it has been wrongfully filed by some other person.

Sections 1 (particularly clause "Fifth") to 8, inclusive, of chapter 217 of Revised Laws of Massachusetts (in force January 1, 1902), provide for a search warrant in regard to "counterfeits or imitations of a label, trade mark, stamp or form of advertisement recorded pursuant to the statutes of this commonwealth"; and for the results thereof, whether rightfully or wrongfully issued.

Sections 15 to 18, inclusive, taken in connection with section 1 of chapter 72 of Revised Laws of Massachusetts (in force January 1, 1902), afford protection to manufacturers, bottlers, and vendors of milk, cream, soda water, mineral water, ale, beer, and other beverages in the use of their cans, bottles, siphons, fountains, and boxes, and provides penalties for the unauthorized use of, or the defacement of names and marks upon, such cans, bottles, siphons, fountains, or boxes by other parties.

Sections 19 to 23, inclusive, taken in connection with section 1, of said chapter 72, afford protection to "persons engaged in buying, selling or dealing in milk or cream in cans" in the use of such cans, and provides penalties for the unauthorized use of, or the defacement of names and marks upon, or befouling, such cans.

MICHIGAN.

COMP. LAWS 1897, VOL. 3, PAGE 3473 (ACT 41 OF 1891, AS AMENDED BY ACT 206 OF 1895).

An act to provide for the protection of associations and unions

of workmen and artisans, or other persons, in their labels, trade marks, and forms of advertisement, and to punish the counterfeiting and fraudulent uses of such labels, trade marks and forms of advertisement.

(11681) Section 1. That whenever any person or any association or union of workmen has heretofore adopted or used, or shall hereafter adopt or use, any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such labels, trade mark, term, design, device or form of advertisement.

(11682) Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent

that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association; or who shall in any way use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be deemed guilty of a misdemeanor, and shall be punished as hereinafter provided. In suits or proceedings for damage, or for equitable relief by or on behalf of any such person, association or union, on account of the violation of any provision of this act, it shall not be necessary to prove that such violation was knowingly or willfully committed.

(11683) Sec. 3. Any person, whether a member of a firm or corporation, or otherwise, who shall violate any of the provisions of section one of this act, or who shall knowingly or willfully violate any provision of section two of this act, shall be deemed to have committed a misdemeanor thereby, and on conviction thereof shall be punished by a fine of not less than ten nor more than one hundred dollars, or by imprisonment in the county jail for a period not exceeding ninety days, or by both such fine and imprisonment, in the discretion of the court.

(11684) Sec. 4. In actions at law or proceedings in equity brought on behalf of any such association or union which is not incorporated, the same may be brought in the name of any member of such association or union, who has been duly authorized so to do by such association or union, but for the use and benefit of all of the members of such association or union: provided, that before commencing such action or proceeding

the member so authorized shall file with the justice or clerk of such court a certificate of the president and secretary of such association or union, showing that such authority has been granted. Any criminal proceeding brought for a violation of any provision of this act, may be prosecuted by the authorized attorney of such association or union, in the court where originally commenced, but in such case the fees and compensation of such attorney shall be borne and paid exclusively by such association or union: provided, that nothing herein shall be deemed to prevent the prosecuting attorney from conducting any such prosecution, or the said authorized attorney of such association or union from deputizing a duly qualified attorney at law to appear in his stead.

(11685) Sec. 5. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section one of this act, shall file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with said secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any

label, trade mark, term, design, device or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months or by both such fine and imprisonment. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be *prima facie* proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association, any label, trade mark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

(11686) Sec. 6. In no case shall the certificate from the secretary of state, obtained in conformity with the fifth section of this act, be assignable by the party to whom the same is issued.

Sec. 7. All acts and parts of acts inconsistent with the provisions of this act are hereby repealed.

Sections (11677)-(11680), vol. 3, p. 3472, also provide punishment for the counterfeiting and fraudulent use of trade marks.

Sections (5676)-(5680), vol. 2, p. 1781, protect manufacturers, bottlers, and vendors of soda water, mineral water, ale, porter, beer, and

other beverages against the unauthorized use of, or the defacement of names and marks upon, their bottles, fountains, siphons, and kegs by other persons.

MINNESOTA.

GEN. LAWS 1893, CH. 24, AS AMENDED BY GEN. LAWS 1895,
CH. 122.

Section 1. Whenever any person, or any association or union of workmen has heretofore adopted or used or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person, or association or union of workmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trade mark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in

his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; shall be punished by a fine of not more than one hundred (100) dollars or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used or shall hereafter adopt or use a label, trade mark, term, design, device, or form of advertisement, as provided in section one (1) of this act may file the same for record in the office of the secretary of state by leaving two copies, counterparts or *fac simile* thereof with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated; stating that the party so filing or on whose behalf such label, trade mark, term, design, device or form of advertisement shall be filed has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in con-

sequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred (100) dollars, or by imprisonment not exceeding three (3) months. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one (1) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof to the adoption of such label, trade mark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trade mark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

Sec. 4. Every such person, association or union adopting or using a label, trade mark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union, all profits derived from such wrongful manufacture, use, display or sale, and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed.

Sec. 5. Every person who shall use or display the genuine

label, trade mark, term, design, device or form of advertisement of any such person, association or union in any manner not authorized by such person, union, or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not less than three (3) months, or by a fine of not more than one hundred (100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three (3) months, or for a fine of not more than one hundred (100) dollars.

Sec. 7. This act shall take effect and be in force from and after its passage.

Approved February 23, 1895.

While section 7 of the act of 1893 is not expressly amended or repealed by the act of 1895, its provisions appear to be embodied in section 4 of the above act.

GEN. ST. 1894.

Section 6908. Any person or persons who shall knowingly and willfully forge or counterfeit, procure to be forged or counterfeited, any representation, likeness, similitude, copy or imitation of the private stamps, brands, wrapper, label or trade mark, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to and upon the goods, wares, merchandise or preparation of said mechanic, manufacturer, druggist, merchant or tradesman, with intent to pass off any work, goods, manufacture, compound or prepara-

tion, to which such forged or counterfeited representation, likeness, similitude, copy or imitation is affixed, or intended to be affixed, as the work, goods, manufacture, compound or preparation of such mechanic, manufacturer, druggist, merchant or tradesman, shall, upon conviction thereof, be deemed guilty of a misdemeanor, upon conviction thereof, and shall be punished by imprisonment in the county jail for a period [of] not less than six months, nor more than twelve months, or fined not more than five thousand dollars.

Sec. 6909. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, have in his or their possession any die or dies, plate or plates, brand or brands, engraving or engravings or printed labels, stamps, imprints, wrapper or trade marks, or any representation, likeness, similitude, copy or imitation of the private stamps, imprint, brand, wrapper, label or trade mark usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to or upon articles made, manufactured, prepared or compounded by him or them, for the purpose of making impressions, or selling the same when made, or using the same upon any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, manufactures, preparations or compounds of any other person or persons, body corporate or politic, or who shall wrongfully and fraudulently sell or use the genuine stamp, brand, imprint, wrapper, label or trade mark, with intent to pass off any goods, wares, merchandise, mixtures, compounds or other articles not the manufacture of the person or persons, body corporate or politic, to whom such stamp, brand, imprint, wrappers, label or trade mark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six months, nor more than twelve months, or be fined not more than five thousand dollars.

Sec. 6910. Any person who shall vend or keep for sale any goods, wares, merchandise, mixture or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels or trade marks shall be placed or affixed, and intended to represent the said goods, wares, merchandise, mixture or preparation as the genuine goods, wares, merchandise, mixture or preparation of any other person or persons, knowing the same to be counterfeit, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by a fine not exceeding five hundred dollars in each case so offending, and shall also be liable in a civil action to the person or persons whose goods, wares, merchandise, mixture or preparation is counterfeited or imitated, or whose stamps, brands, imprints, wrappers, labels, or trade marks are forged, counterfeited, placed or affixed, for all damages such person or persons may or shall sustain by reason of any of the acts in this section mentioned, and may be restrained or enjoined by any court of competent jurisdiction from doing or performing any of the acts above mentioned.

Sec. 6911. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, knowingly affix or cause to be affixed to or upon any bottle, case, box or package containing any goods, manufacture, mixture, preparation or compound, any stamp, brand, label, wrapper, imprint or trade mark, which shall designate such goods, manufacture, mixture, preparation or compound, either wholly or in part, the same to the eye, or in sound to the ear, as the word or words, or some of the words, used by any other person or persons for designating any goods, manufacture, mixture, preparation or compound manufactured or prepared by or for such other person or persons, or who shall knowingly sell or expose, or offer for sale, any such bottle, case, box or package, with any such stamp, brand, label, wrapper, imprint or mark affixed to or upon it, shall, provided such per-

son or persons so affixing or causing to be affixed any such stamp, brand, label, wrapper, imprint or mark, or so selling or exposing, or offering for sale, any such bottle, case, box or package, shall not have been the first to employ or use such words, to designate, wholly or in part, any goods, manufacture, mixture, preparations or compound, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six nor more than twelve months, or be fined not more than five thousand dollars, and shall also be liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

Sec. 6912. Any person or persons who, with intent to defraud, or to enable another to defraud, any person, shall manufacture or knowingly sell, or cause to be manufactured or sold, any article or articles, marked, stamped or branded, or incased or inclosed in any box, bottle or wrapper having thereon any engraving or engravings, or printed labels, stamps, imprints, marks, or trade marks, which article or articles are not the manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving or engravings, printed labels, stamps, imprints, marks or trade marks, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and for such offense shall forfeit and pay a fine of two hundred dollars, to be recovered, with costs, in a civil action to be prosecuted by the county attorney, of any county in the state, in the name of the county in which said action shall be commenced, and the one-half of such recovery shall be paid to the informer, and the residue shall be applied to the support of the poor in the county where such recovery is had.

Sec. 6913. A "trade mark" is a mark used to indicate the maker, owner or seller of any goods, wares, merchandise, mix-

ture, preparation or compound, and includes, among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label, or other mark lawfully adopted by him and usually affixed to any goods, merchandise, mixture, preparation or compound to denote the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him.

Sec. 6914. A trade mark is deemed to be affixed to any goods, wares, merchandise, mixture, preparation or compound when it is placed in any manner in or upon either—

(1) The article itself; or

(2) A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing, in, by, or with which the goods are packed, inclosed, or otherwise prepared for sale or disposition.

Sec. 6915. An imitation of a trade mark, stamp, brand, wrapper, or label is that which so far resembles the genuine trade mark, stamp, brand, wrapper or label as to be likely to induce the belief that it is genuine, either by the use of words or letters similar in appearance or in sound, or by any sign, device, or the names whatsoever.

Sec. 6916. No testimony or evidence given by any person in any civil action to which such person may be a party, or by any other witness in such action, or on any reference or proceeding which may be had in such action, nor' any evidence or testimony derived from the books or papers of such party or witness, produced by him as a witness, or otherwise, in such action, or on any reference or other proceedings which may be had therein, can or shall be used in any criminal prosecution against such party or witness, under any of the provisions of this act; nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this act.

For the law protecting manufacturers, bottlers and vendors of soda water and other beverages, milk, cream, ice cream, and butter, in the use of their bottles, barrels, kegs, casks, etc., against the unauthorized use of, or the defacement of names and marks upon, such bottles, barrels, casks, kegs, etc., by other parties, see chapters 143 and 144, Laws 1895, and chapter 306, Laws 1899.

Sections 6917 to 6922, inclusive, Gen. St. 1894, relate to the labels, etc., of labor unions and associations.

Sections 6923 to 6929, inclusive, are substantially embodied in chapter 122, Laws 1895.

MISSISSIPPI.

ANN. CODE 1892.

Section 1306. Every person who shall knowingly and willfully forge or counterfeit, or cause or procure to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrappers, or labels usually affixed by any mechanic or manufacturer to, and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares, or merchandise whatsoever, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by a fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

Sec. 1307. Every person who shall have in his possession any die, plate, engraving, or printed label, stamp, or wrapper, or any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label usually affixed by any mechanic or manufacturer to, and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares or merchandise, with intent to use or sell the said die, plate or engraving, or printed stamp, label, or wrapper, for the purpose of aiding or assisting in any way whatever in vending any goods, wares, or merchandise in imitation of, or intended to resemble and be sold for the goods, wares, or merchandise of such mechanic or manufacturer, shall be

guilty of a misdemeanor, and, upon conviction, be punished by fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

Sec. 1308. Every person who shall vend any goods, wares, or merchandise having thereon any forged or counterfeit stamp or label, imitating, resembling, or purporting to be the stamp or label of any mechanic or manufacturer, knowing the same to be forged or counterfeited, and resembling or purporting to be imitations of the stamps or labels of such mechanic or manufacturer, without disclosing the fact to the purchaser thereof, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by imprisonment in the county jail not exceeding three months, or by a fine not less than fifty nor more than five hundred dollars, or both.

MISSOURI.

REV. ST. 1899, CH. 169.

Section 10365. If any mechanic, manufacturer, association or union of workingmen, or other person, shall wish to adopt any particular name, term, design or device as his or their trade mark, to designate, make known or distinguish any goods, wares or merchandise by him or them manufactured or prepared, he or they may write out a description of such name, term, design or device, describing the same accurately, and sign and acknowledge the same before some officer competent to take the acknowledgment of deeds, and file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state; said secretary shall deliver to such mechanic, manufacturer, association or union of workingmen, or other person, so filing the same, a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar; such certificate shall, in all suits and prosecu-

tions under this chapter, be sufficient proof of the adoption of such label, trade mark or form of advertisement, and of the right of such mechanic, manufacturer, association or union of workingmen, or other person, to adopt the same. No label, trade mark or form of advertisement shall be recorded that in any way resembles or would probably be mistaken for a label or trade mark already of record.

Sec. 10366. Any person or persons, association or union of workingmen, who shall knowingly and willfully make, forge or counterfeit any representation, likeness, similitude, copy or imitation of the private label, brand, stamp, wrapper, engraving, mould or trade mark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, person or body corporate, association or union of workingmen, or [body] politic, to, upon or used in connection with the goods, wares, merchandise, compound or preparation of such manufacturer, mechanic, merchant, tradesman, druggist, person, association or union of workingmen, or body corporate or politic, with intent to pass off any goods, wares, merchandise, compound or preparation, to which said forged [or] counterfeit representation, likeness, similitude, copy or imitation is affixed, or in connection with which the same may be used or intended to be so affixed or used, as the work, goods, wares, implements, merchandise, compound or preparation of such manufacturer, mechanic, merchant, druggist, tradesman, person, association, or union of workingmen, or body corporate or politic, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period of not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment.

Sec. 10367. Any person or persons, association or union of workingmen, who shall, with intent to defraud any person