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OPINION OF THE SOLICITOR OF THE DEPARTMENT OF THE INTERIOR

Construction of the Trade-Mark Act of March 19, 1920

DEPARTMENT OF THE INTERIOR, OFFICE OF THE SOLICITOR

Washington, D. C., July 13, 1920.

The Honorable, the Secretary of the Interior.

Dear Mr. Secretary: By letter of June 17, 1920, the Commissioner of Patents requested my opinion respecting certain questions arising under the recent Act of March 19, 1920 (Public No. 163), entitled "An Act to Give Effect to Certain Provisions of the Convention for the Protection of Trade-Marks and Commercial Names, Made and Signed in the City of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other Purposes."

Section 1 of said Act provides:

"That the Commissioner of Patents shall keep a register of (*a*) all marks communicated to him by the international bureaus provided for by the Convention for the Protection of Trade-Marks and Commercial Names, made and signed in the City of Beunos Aires, in the Argentine Republic August 20, 1910, in connection with which the fee of $50 gold for the international registration established by article 2 of that Convention has been paid, which register shall show a facsimile of the mark; the name and residence of the registrant; the number, date and place of the first registration of the mark, including the date on which application for such registration was filed and the term of such registration, a list of goods to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark."

"(*b*) All other marks not registerable under the Act of February 20, 1905, as amended, except those specified in paragraphs (*a*) and (*b*) of section 5 of that Act, but which have been in *bona fide* use for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes by the proprietor thereof, upon or in connection with any goods of such proprietor upon which a fee of $10 has been paid to the Commissioner of Patents and such formalities as required by the said Commissioner have been complied with: *Provided,* That trade-marks which are identical with a known trade-mark owned and used in interstate or foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive qualities as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register."

The questions asked are, in effect, as follows:

(1) Whether marks registerable under the Act of February 20, 1905, can be registered under section (*b*) of the Act of March 20, 1920?

(2) What is the scope or limitation of paragraph (*b*) of the Act of March 19, 1920?

(3) Whether the filing fee of ten dollars paid in connection with an application under the Act of February 20, 1905, may be transferred to an application for registration under the Act of March 19, 1920, or must a new fee be required?

(4) Must a trade-mark be "identical" with a known trade-mark to be subject to rejection, or need it be only so nearly similar to a registered or known trade-mark to justify rejection?

Section 5 of the said Act of February 20, 1905, has been amended by the following acts: March 2, 1907 (34 Stat. 1251); February 18, 1911 (36 Stat. 918); January 8, 1913 (37 Stat. 649), and section 9 of the recent Act, now under consideration.

My answer to the first question is in the negative, as no reason has been called to my attention, and I see none, for ignoring the express provision of this law that the (*b*) register shall be kept for—

"all other marks *not* registerable under the Act of February 20, 1905, as amended, except those specified in paragraphs (*a*) and (*b*) of section 5 of that Act, etc."

The doubt pertaining to the second question is expressed by the Commissioner as follows:

"Paragraph (*b*) after referring to State, national, or society insignia, goes on to specify what marks shall not be registered as well as some that may be registered. Hence the Act is not clear as to what is referred to in paragraph (*b*)."

In my opinion the recent Act of March 19, 1920, as applied to register (*b*) therein provided should be construed as if it more specifically read as follows:

"All other marks not registerable under the Act of February 20, 1905, as amended, except those specified *as not registerable* in paragraphs or schedules (*a*) and (*b*) of section 5 of that Act, etc."

This is the plain meaning of the law, as it was undoubtedly the intention to continue to deny registration to those marks prohibited registration by paragraphs or schedules (*a*) and (*b*) of section 5 of the Act of February 20, 1905. In other words, my view is that register (*b*) provided by the recent Act is not intended

for any trade-mark registerable under any part of the Act of February 20, 1905, nor for registration of any mark not registrable as specified in paragraphs or schedules (*a*) and (*b*) of section 5 of that Act. The doubt will be relieved and a rational construction of the law will be subserved by considering the reference in the recent Act to "paragraphs (*a*) and (*b*)" of section 5 of the amended Act of February 20, 1905, as meaning *schedules a* and *b*, rather than paragraphs strictly, and as comprising the following matters specified as not registerable, *viz.*:

"(*a*) consists of or comprises immoral or scandalous matter.

"(*b*) Consists of or comprises the flag or coat-of-arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, color, flag, or banner, adopted by any institution, organization, club, or society, which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided,* That said name, distinguishing mark, character, emblem, colors, flag, or banner, was adopted and publicly used by said institution, organization, club, or society, prior to the date of adoption and use by the applicant."

This was the evident intention, as shown by the congressional hearings on the recent Act, and with such construction a field will exist for the operation of the new law; otherwise none would remain.

Replying to question 3, I can see no objection to applying the fee paid in connection with the application under the old law to an application under the new law. The amount of the fee is the same in either case, and it would seem it could be applied in perfecting the registration even though the applicable law be other than that originally invoked. If it be necessary to amend the application, that will be merely a detail of procedure.

The fourth question arises from the language of the proviso to section 1 of the recent Act above quoted. The word "identical" in its strictest sense means "exactly alike" or "the same in all respects." It is apparent that the word cannot properly be used in this sense as applied to two different objects, because it is axiomatic that no two things are exactly alike; but the word is sometimes used more loosely to mean "very similar" or "the same

in essential characteristics." I have no doubt that it is so understood in this case. The language of the said proviso would perhaps justify the conclusion that a comparative term, such as "so nearly" was intended to accompany the positive term "identical" so as to harmonize with the further expression "as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers." This view is strongly supported by a similar provision contained in the Act of 1905, which prohibits registration of names identical or which so nearly resemble a registered or known trademark as to be likely to cause confusion, etc.

Cordially yours,

(Sgd.) CHARLES D. MAHAFFIE,
Solicitor.

HEDMAN MFG. CO. ET AL. v. TODD PROTECTOGRAPH CO.

(265 Fed. Rep. 273)

United States Circuit Court of Appeals, Seventh Circuit

March 16, 1920

1. UNFAIR COMPETITION—DEFENSE OF "UNCLEAN HANDS"—UNFAIR PRACTICES BY PLAINTIFF'S AGENT.
   Unfair business practices on the part of an agent, unknown to and unauthorized by the principal, for which the principal might be liable in damages and which he might be restrained from continuing, will not under the doctrine of "unclean hands," prevent the principal from obtaining equitable relief for unfair practices on the part of the person whom the agent has injured.
2. UNFAIR COMPETITION—BAR TO RELIEF—INFRINGEMENT OF PATENT.
   Where appellants had been found guilty of infringing appellee's patent, the court could not afford appellants protection in continuing on the ground of appellee's unfair competition or otherwise.

From a decree of the District Court of the United States for the Eastern Division of the Northern District of Illinois in favor of the complainant, the defendants appeal. Affirmed.

For the opinion below, see 9 T. M. Rep. 247.

(The case involved primarily the question of the infringement of a patent. We report here only that part of the opinion which relates to the subject of unfair competition.)

Patents Nos. 1,558,449 to 1,559,535.

THE

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ADJUDICATED PATENTS.

(C. C. A. Ill.) The Bruegmann patent, No. 983,675, for improved printer's register hook, *Held* not infringed. *Printing Utilities Co.* v. *International Harvester Co.*, 6 F. (2d) 461.

(C. C. A. Pa.) The Honigmann patent, No. 1,074,720, for automatic feeding device for printing presses, claims 1, 2, 10, 21, and 22 *Held* subsequent in date of invention to claims 13–17 of the Wells and Hunter patent, No. 1,363,200. *Miehle Printing Press & Mfg. Co.* v. *Miller Saw Trimmer Co.*, 6 F. (2d) 417.

(C. C. A. N. Y.) The Alberti patents, Nos. 1,234,109 and 1,234,711, for bottle closure and process of making, *Held* valid and infringed. *International Cork Co.* v. *New Process Cork Co.*, 6 F. (2d) 420.

(C. C. A. Wis.) The Schneider patent, No. 1,263,351, for electric heater, *Held* not infringed. *Cutler-Hammer Mfg. Co.* v. *General Electric Co. et al.*, 6 F. (2d) 376.

(C. C. A. Pa.) The Wells and Hunter patent, No. 1,363,200, for automatic printing-press feeder, claims 13–17 *Held* prior in invention to claims 1, 2, 10, 21, and 22 of the Honigmann patent, No. 1,074,720. *Miehle Printing Press & Mfg. Co.* v. *Miller Saw Trimmer Co.*, 6 F. (2d) 417.

(C. C. A. Wis.) The Abbott patent, No. 1,367,341, for electric heating element, *Held* valid and infringed. *Cutler-Hammer Mfg. Co.* v. *General Electric Co.*, 6 F. (2d) 376.

NOTICE TO ATTORNEYS.

A circular letter reading as follows has been placed in the mail addressed to each attorney on the roster:

"Your name appears on the roster of those registered to practice before the United States Patent Office. We are preparing to revise the roster to eliminate the names of those who are dead or who have retired from practice before this Office.

"You are reminded that the rules provide that attorneys registered in this Office should keep the Office advised of any change of address. To this end will you please fill out the form below and return this letter immediately.

"Your failure to fill out and return this letter will be considered your authorization to remove your name from the roster."

Attorneys who have not received this circular and who wish their names to be retained on the roster should immediately write the Commissioner of Patents to that effect and give him their full names and business addresses, together with their registration numbers and the names of any firms of which they are members or with which they are associated.

Applicant cites the well-known "Holeproof" hosiery cases, 172 F. 859 and 190 F. 606, and the "Wearever" case, 226 F. 815. It is true in those cases that the court discusses secondary meaning as applied to a registered trade-mark, but the discussion there seems to be obiter, since the cases were wholly decided on a question of unfair competition.

[1] The following cases indicate the proper attitude of the Office to be a refusal to register under the act of 1905 a trade-mark which is descriptive: *Standard Paint Co.* v. *Trinidad Asphalt Mfg. Co.*, 165 O. G. 971; 1911 C. D. 530; 220 U. S., 446; *In re Toledo Scale Co.*, 303 O. G. 399; 1922 C. D. 136; *In re Packard Motor Car Co.*, 243 O. G. 1311; 1917 C. D. 206; 46 App. D. C. 555; *In re Alvah Bushnell Co.*, 270 O. G. 189; 1920 C. D. 112; 49 App. D. C. 133; 261 Fed. Rep. 1013; *In re B. F. Goodrich Co.*, 313 O. G. 663; 1923 C. D. 260; 285 Fed. Rep. 995; *In re Reid Bros.*, 287 O. G. 408; 1921 C. D. 198; 51 App. D. C. 6; 273 Fed. Rep. 368, as well as the Hercules Powder case above cited.

[2] The recent attitude of the court of appeals is indicated in the Goodrich and Reid Brothers cases cited, and this is a reasonable attitude at least since the passage of the act of 1920, which act makes it possible for an applicant to register its trade-mark even though it is descriptive. *Dunlap & Co.* v. *Jackson & Gutman Co.*, 326 O. G. 439; 1924 C. D. 38; 13 T. M. Rep. 66. The presence on the statute books of the act of 1920 makes it unnecessary for this Office to put a strained interpretation upon the act of 1905 and also makes it unnecessary for this Office to do the very dangerous thing of allowing registration on the ground of secondary meaning shown entirely by ex parte affidavits.

The Examiner of Trade-Marks is affirmed.

EX PARTE CALUMET STEEL COMPANY.

Decided September 15, 1925.

1. TRADE-MARKS—TWO-COLORED FENCE POST.
   Arbitrarily coloring the lower or base portion of a fence post black and arbitrarily coloring the upper portion of the post green does not constitute a trade-mark.
2. SAME—ACT OF 1920—DEVICES OTHER THAN TRADE-MARKS NOT REGISTRABLE.
   Under the act of 1920, as under the act of 1905, a device in order to be registrable must be a trade-mark.
3. SAME—CHARACTERISTIC OF A TRADE-MARK.
   A thing in common use which includes no name, symbol, or assertion of origin or ownership is not a trade-mark.

ON PETITION.

Application for registration of trade-mark under act of March 19, 1920, filed April 24, 1924, Serial No. 196,049.

METALLIC FENCE POSTS.

Mr. Eugene C. Wann for the applicant.

FENNING, *Assistant Commissioner:*

Applicant petitions from the action of the Examiner of Trade-Marks refusing registration of his trade-mark under the act of March 19, 1920, substantially on the ground that what applicant is endeavoring to register is not a trade-mark.

I have carefully considered the act of 1920, but am unable to find in it any authority for registering anything which is not a trade-mark. This legislation appears to have originated with Senate bill 4783, introduced June 27, 1918. This bill amended sections 2, 4, and 13 and added a new section 16 (*a*) to the Trade-Mark Act of February 20, 1905. A hearing was had July 3 and 5, 1918, before the Committee on Commerce of the Senate and the proceedings printed.

Another bill (S. 4889) was introduced on August 20, 1918, apparently to take the place of Senate 4783. It appears that this bill 4889 was passed by the Senate without amendments and reported favorably by the Committee on Patents of the House (Report No. 1090) February 18, 1919, but failed of passage by the House.

On July 5, 1918, there was introduced in the House H. R. 7157 to amend section 5 of the Trade-Mark Act of February 20, 1905. This bill extended the ten-year clause of the act of February 20, 1905, to include other articles not manufactured by the applicant for ten years next preceding February 20, 1905. This bill was favorably reported with slight amendments by the Committee on Patents of the House February 6, 1920, after hearings had on January 21 and 22, 1920. The hearings and the report were printed.

A new bill (H. R. 9023) was introduced into the House some time in 1919. A hearing on this bill was held before the House Committee on Patents October 15, 1919, and the bill was reported to the House favorably October 24, 1919. It appears that this bill (H. R. 9023) was identical with Senate bill 4889, previously passed by the Senate. H. R. 9023 was then sent to the Senate and a report was made February 21, 1920, by the Committee on Patents, and this report recommended that the bill pass with certain amendments. Apparently this bill passed the Senate in the amended form as reported by the committee of the Senate.

After passage by the Senate it appears that the Senate amendments were not agreed to by the House and a conference was authorized (see Congressional Record of March 20, 1920, p. 4463). The conference report was submitted to the Senate March 11, 1920 (see Congressional Record for that date, p. 4488). The conference report recommended that the House recede from its disagreement of the Senate amendments, one of said amendments by the Senate being further amended by the conferees and agreed to by them. The conference report with all amendments was agreed to by the Senate March 11, 1920 (see p. 4488, Congressional Record), and reported to the House and discussed March 13, 1920 (see Congressional Record for that date, pp. 4603–4604), and the conference report was agreed to.

It should be noted that one of the amendments to the bill made by the Senate—namely, section 9—authorized the incorporation into the bill of H. R. 7157.

I have carefully examined the proceedings which led up to the passage of the act, but am unable to find anything which leads to the conclusion that we should register something which is not a trade-mark. *Ex parte Standard Oil Company (New Jersey)*, 1924 C. D. 110; 328 O. G. 785; *Ex parte H. K. H. Silk Co.*, 1924 C. D. 150; 329 O. G. 266; *Ex parte Keyless Auto Clock Co.*, 1923 C. D. 25; 309 O. G. 223; *Ex parte Mme. V. V. Maginley*, 1924 C. D. 145; 329 O. G. 264.

[1] I am clearly of the opinion that the Examiner of Trade-Marks was right and that what applicant at present proposes to register is not a trade-mark. Applicant has presented affidavits of dealers indicating that the dress of his goods is recognizable; but those affidavits cannot establish that the dress is in law a mark.

The application as amended sets out that:

The trade mark consists in arbitrarily coloring the lower or base portion of a fence post black and arbitrarily coloring the upper portion of the post green as indicated by the shading in the accompanying drawing.

The drawing shows a metal fence post colored black to a little above the ground line and colored green from there to the top of the post.

This application was involved in opposition No. 5694, in which on February 6, 1925, I refused registration. 146 MS. Dec. 371. The applicant at that time said:

The trade mark consists in coloring the entire post one color, as for instance green as indicated by the shading in the accompanying drawing, and then coloring the base of the post, from a point at or just above the ground line down, with a contrasting color, as with a heavy extra coat of tough, rust-resisting black asphaltum, thus making the post have a double coated base.

The trade mark is applied or affixed directly to the goods by painting or coloring the same in the manner above described.

We must take judicial notice of the fact that it has been common for many years to paint lower portions of fence posts which go into the ground with a black asphaltum paint for the purpose of protecting the fence post. We must also take official notice of the fact that it is not at all uncommon to have the portion of the fence post which appears above the ground painted green. In fact, green is one of the most usual colors used in paint for fences.

As pointed out in *Ames Shovel and Tool Company* v. *Baldwin Tool Works*, 335 O. G.. 831:

No one may adopt a trade mark which will exclude the rest of the trade from using the usual ordinary manufacturing practice established in the trade.

See also *Checker Cab Mfg. Co.* v. *Yellow Cab Co.*, 339 O. G. 762.

[2] Applicant has objected to the citation of decided cases on the ground that he is applying for registration under the act of 1920, and the decided cases were decided under the act of 1905. It is clear, however, that under the act of 1920, as under the act of 1905, a device in order to be registrable must be a trade-mark. In *Goodyear Tire & Rubber Co.* v. *The Firestone Tire & Rubber Co.*, 1917 C. D. 49; 240 O. G. 641, registration was refused of an automobile tire consisting of a black tread and red side walls. After very careful consideration and argument, most of which is clearly applicable here, it was held that that mark was not a trade-mark.

In *In re American Circular Loom Company*, 1907 C. D. 452; 126 O. G. 2191; 28 App. D. C. 450, the Court of Appeals of the District of Columbia refused registration of "flakes of mica impressed or otherwise applied to the external surface of an insulating tube" on the ground that it was merely "an ingenious attempt to obtain a trade mark of which color, unconnected with some symbol or design, is the essential feature." The court there cited with approval the holding of the Commissioner that:

The surface effect which the applicant calls his trade mark is not so clearly distinct from the article upon which it appears as to be readily recognized as an arbitrary symbol for this purpose.

[3] That this is not a new doctrine is clearly established by the case of *Harrington* v. *Libby*, Fed. Cases 6107, decided in 1877, where the court held that a peculiarly-marked pail was not a trade-mark for collars packed in the pail. The court held that a thing which was in common use and which included no name, no symbol, no assertion of origin or ownership, was not a trade-mark.

The Examiner was right in refusing registration.

The petition is denied.

CHECKER CAB MANUFACTURING CORPORATION *v.* YELLOW CAB MANUFACTURING CO.

Decided September 24, 1924.

1. TRADE-MARKS—NOT PRIMARILY FOR ORNAMENT.
   A trade-mark may be ornamental. It may add to the beauty of a device and still be a trade-mark; but the purpose of a trade-mark is not primarily for ornament.
2. SAME—PORTIONS OF STRUCTURES.
   The courts generally hold portions of structures not trade-marks.
3. SAME—OPPOSITION—REPRESENTATION OF A SHUTTER EMBOSSED IN THE SIDE OF AN AUTOMOBILE BODY.
   Where it was common to apply an ornament to the side of a carriage or automobile body behind the window, and one of the best-known ornaments was the representation of the slats of a blind or shutter, opposition to the registration of an alleged mark comprising an embossed representation of a shutter in the same location was sustained.

Opposition No. 4,735.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR AUTOMOBILE TAXICABS.

Application of Yellow Cab Manufacturing Co. filed February 15, 1923, No. 176,105, published June 5, 1923.

Messrs. Brown, Boettcher & Dienner for Checker Cab Manufacturing Corporation.

Messrs. Rummler & Rummler for Yellow Cab Manufacturing Co.

FENNING, *Assistant Commissioner:*

The Yellow Cab Manufacturing Co. appeals from the action of the Examiner of Interferences sustaining an opposition brought by the Checker Cab Manufacturing Corporation against its application to register as a trade-mark for "Motor Driven Passenger Vehicles — Namely, Automobile Taxicabs" what applicant aptly defines in its brief thus:

The trade mark involved in this proceeding is an emblem, consisting of a panel having the appearance of a plurality of parallel slats arranged within a border

NOLAN, John Ignatius

1874 – 1922

5 US Congresses Served

63rd – 67th (1913 – 1922)

House Years of Service

1913 – 1922

State / Territory

California

Position

Representative

Party

Republican

Biography

NOLAN, John Ignatius, (husband of **Mae Ella Nolan**), a Representative from California; born in San Francisco, Calif., January 14, 1874; attended the public schools; was an iron molder; member of the board of supervisors of the city and county of San Francisco in 1911; secretary of the San Francisco Labor Council in 1912; elected as a Republican to the Sixty-third and to the four succeeding Congresses and served from March 4, 1913, until his death; chairman, Committee on Patents (Sixty-sixth Congress), Committee on Labor (Sixty-seventh Congress); had been reelected in 1922 to the Sixty-eighth Congress; died in San Francisco, Calif., November 18, 1922; interment in Holy Cross Cemetery.

Congresses

CONGRESS	POSITION	PARTY	STATE	SWORN	START	DEPARTURE
63	Representative	Republican	California	04/07/1913	03/04/1913	
64	Representative	Republican	California	12/06/1915	03/04/1915	
65	Representative	Republican	California	04/02/1917	03/04/1917	
66	Representative	Republican	California	05/19/1919	03/04/1919	
67	Representative	Republican	California	04/11/1921	03/04/1921	11/18/1922

The 63rd United States Congress +

The 64th United States Congress +

The 65th United States Congress +

The 66th United States Congress +

The 67th United States Congress +

Bibliography

There are currently no bibliographies for this profile. Please contact the U.S. House of Representatives (archives@mail.house.gov) or U.S. Senate (historian@sec.senate.gov) with any questions or suggestions.

Research Collections

University of California −

The Bancroft Library
Berkeley, California

Papers:
In the Arthur M. Arlett Papers, 1912-1921, 6 boxes.
Other authors include John Ignatius Nolan.