



58TH CONGRESS, }
3^D SESSION. } **H. R. 16560.**

[Report No. 3147.]

A BILL

To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

By Mr. BONYNGE.

DECEMBER 14, 1904.—Referred to the Committee on Patents and ordered to be printed.
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H. R. 16560.

IN THE SENATE OF THE UNITED STATES.

JANUARY 16, 1905.

Read twice and referred to the Committee on Patents.

AN ACT

To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*
3 That the owner of a trade-mark used in commerce with foreign
4 nations, or among the several States, or with Indian tribes,
5 provided such owner shall be domiciled within the territory
6 of the United States, or resides in or is located in any foreign
7 country which, by treaty, convention, or law, affords similar
8 privileges to the citizens of the United States, may obtain
9 registration for such trade-mark by complying with the follow-
10 ing requirements: First, by filing in the Patent Office an ap-
11 plication therefor, in writing, addressed to the Commissioner of
12 Patents, signed by the applicant, specifying his name, domicile,
13 location, and citizenship; the class of merchandise and the par-



1 ticular description of goods comprised in such class to which the
2 trade-mark is appropriated; a description of the trade-mark
3 itself, and a statement of the mode in which the same is applied
4 and affixed to goods, and the length of time during which the
5 trade-mark has been used. With this statement shall be filed a
6 drawing of the trade-mark, signed by the applicant, or his
7 attorney, and such number of specimens of the trade-mark,
8 as actually used, as may be required by the Commissioner of
9 Patents. Second, by paying into the Treasury of the United
10 States the sum of ten dollars, and otherwise complying with
11 the requirements of this Act and such regulations as may be
12 prescribed by the Commissioner of Patents.

13 SEC. 2. That the application prescribed in the foregoing
14 section, in order to create any right whatever in favor of the
15 party filing it, must be accompanied by a written declaration
16 verified by the applicant, or by a member of the firm or an offi-
17 cer of the corporation or association applying, to the effect that
18 the applicant believes himself or the firm, corporation, or
19 association in whose behalf he makes the application to be the
20 owner of the trade-mark sought to be registered, and that
21 no other person, firm, corporation, or association, to the
22 best of the applicant's knowledge and belief, has the
23 right to such use, either in the identical form or in such
24 near resemblance thereto as might be calculated to deceive;



1 that such trade-mark is used in commerce among the sev-
2 eral States, or with foreign nations, or with Indian tribes,
3 and that the description and facsimile presented truly repre-
4 sent the trade-mark sought to be registered. If the appli-
5 cant resides or is located in a foreign country, the state-
6 ment required shall, in addition to the foregoing, set forth that
7 the trade-mark has been registered by the applicant, or that
8 an application for the registration thereof has been filed by
9 him in the foreign country in which he resides or is located,
10 and shall give the date of such registration, or the application
11 therefor, as the case may be, except that in the application
12 in such cases it shall not be necessary to state that the mark
13 has been used in commerce with the United States or among
14 the States thereof. The verification required by this section
15 may be made before any person within the United States
16 authorized by law to administer oaths, or, when the applicant
17 resides in a foreign country, before any minister, chargé
18 d'affaires, consul, or commercial agent holding commission
19 under the Government of the United States, or before any
20 notary public, judge, or magistrate having an official seal
21 and authorized to administer oaths in the foreign country in
22 which the applicant may be whose authority shall be proved
23 by a certificate of a diplomatic or consular officer of the
24 United States.

25 SEC. 3. That every applicant for registration of a trade-

1 mark, or for renewal of registration of a trade-mark, who is
2 not domiciled within the United States, shall, before the issu-
3 ance of the certificate of registration, as hereinafter provided
4 for, designate, by a notice in writing, filed in the Patent Office,
5 some person residing within the United States on whom proc-
6 ess or notice of proceedings affecting the right of ownership
7 of the trade-mark of which such applicant may claim to be
8 the owner, brought under the provisions of this Act or under
9 other laws of the United States, may be served, with the
10 same force and effect as if served upon the applicant or reg-
11 istrant in person. For the purposes of this Act it shall be
12 deemed sufficient to serve such notice upon such applicant,
13 registrant, or representative by leaving a copy of such process
14 or notice addressed to him at the last address of which the
15 Commissioner of Patents has been notified.

16 SEC. 4. That an application for registration of a trade-
17 mark filed in this country by any person who has previously
18 regularly filed in any foreign country which, by treaty, con-
19 vention, or law, affords similar privileges to citizens of the
20 United States an application for registration of the same
21 trade-mark shall be accorded the same force and effect as
22 would be accorded to the same application if filed in this
23 country on the date on which application for registration of
24 the same trade-mark was first filed in such foreign country:
25 *Provided*, That such application is filed in this country



1 within four months from the date on which the application
2 was first filed in such foreign country: *And provided*, That
3 certificate of registration shall not be issued for any mark for
4 registration of which application has been filed by an appli-
5 cant located in a foreign country until such mark has been
6 actually registered by the applicant in the country in which
7 he is located.

8 SEC. 5. That no mark by which the goods of the owner
9 of the mark may be distinguished from other goods of the
10 same class shall be refused registration as a trade-mark on
11 account of the nature of such mark unless such mark—

12 (a) Consists of or comprises immoral or scandalous
13 matter;

14 (b) Consists of or comprises the flag or coat of arms or
15 other insignia of the United States, or any simulation thereof,
16 or of any State or municipality, or of any foreign nation:

17 *Provided*, That trade-marks which are identical with a reg-
18 istered or known trade-mark owned and in use by another,
19 and appropriated to merchandise of the same descriptive prop-
20 erties, or which so nearly resemble a registered or known
21 trade-mark owned and in use by another, and appropriated to
22 merchandise of the same descriptive properties, as to be
23 likely to cause confusion or mistake in the mind of
24 the public, or to deceive purchasers, shall not be reg-
25 istered: *Provided*, That no mark which consists merely in



1 the name of an individual, firm, corporation, or association,
2 not written, printed, impressed, or woven in some particular
3 or distinctive manner or in association with a portrait of
4 the individual, or merely in words or devices which are
5 descriptive of the goods with which they are used, or of
6 the character or quality of such goods, or merely a geograph-
7 ical name or term, shall be registered under the terms of this
8 Act: *Provided further*, That no portrait of a living individ-
9 ual may be registered as a trade-mark, except by the consent
10 of such individual, evidenced by an instrument in writing:
11 *And provided further*, That nothing herein shall prevent the
12 registration of any trade-mark used by the applicant or his
13 predecessors, or by those from whom title to the trade-mark
14 is derived, in commerce with foreign nations or among the
15 several States, or with Indian tribes, which was in actual and
16 lawful use as a trade-mark of the applicant or his predeces-
17 sors from whom he derived title for ten years prior to the
18 passage of this Act.

19 SEC. 6. That on the filing of an application for regis-
20 tration of a trade-mark which complies with the requirements
21 of this Act, and the payment of the fees herein provided for,
22 the Commissioner of Patents shall cause an examination
23 thereof to be made; and if on such examination it shall
24 appear that the applicant is entitled to have his trade-mark
25 registered under the provisions of this Act, the Commissioner



1 shall cause the mark to be published at least once in the
2 Official Gazette of the Patent Office. Any person who
3 believes he would be damaged by the registration of a mark
4 may oppose the same by filing notice of opposition, stating
5 the grounds therefor, in the Patent Office within thirty days
6 after the publication of the mark sought to be registered,
7 which said notice of opposition shall be verified by the per-
8 son filing the same before one of the officers mentioned in
9 section two of this Act. If no notice of opposition is filed
10 within said time the Commissioner shall issue a certificate of
11 registration therefor, as hereinafter provided for. If on ex-
12 amination an application is refused, the Commissioner shall
13 notify the applicant, giving him his reasons therefor.

14 SEC. 7. That in all cases where notice of opposition has
15 been filed the Commissioner of Patents shall notify the ap-
16 plicant thereof and the grounds therefor.

17 Whenever application is made for the registration of a
18 trade-mark which is substantially identical with a trade-mark
19 appropriated to goods of the same descriptive properties, for
20 which a certificate of registration has been previously issued
21 to another, or for registration of which another has previously
22 made application, or which so nearly resembles such trade-
23 mark, or a known trade-mark owned and used by another,
24 as, in the opinion of the Commissioner, to be likely to be
25 mistaken therefor by the public, he may declare that an



1 interference exists as to such trade-mark, and in every case of
2 interference or opposition to registration he shall direct the
3 examiner in charge of interferences to determine the question
4 of the right of registration to such trade-mark, and of the
5 sufficiency of objections to registration, in such manner and
6 upon such notice to those interested as the Commissioner may
7 by rules prescribe.

8 The Commissioner may refuse to register the mark
9 against the registration of which objection is filed, or may re-
10 fuse to register both of two interfering marks, or may register
11 the mark, as a trade-mark, for the person first to adopt and
12 use the mark, if otherwise entitled to register the same, un-
13 less an appeal is taken, as hereinafter provided for, from his
14 decision, by a party interested in the proceeding, within such
15 time (not less than twenty days) as the Commissioner may
16 prescribe.

17 SEC. 8. That every applicant for the registration of a
18 trade-mark, or for the renewal of the registration of a trade-
19 mark, which application is refused, or a party to an inter-
20 ference against whom a decision has been rendered, or a
21 party who has filed a notice of opposition as to a trade-mark,
22 may appeal from the decision of the examiner in charge of
23 trade-marks, or the examiner in charge of interferences, as the
24 case may be, to the Commissioner in person, having once
25 paid the fee for such appeal.



1 SEC. 9. That if an applicant for registration of a trade-
2 mark, or a party to an interference as to a trade-mark, or a
3 party who has filed opposition to the registration of a trade-
4 mark, or party to an application for the cancellation of the
5 registration of a trade-mark, is dissatisfied with the decision
6 of the Commissioner of Patents, he may appeal to the court
7 of appeals of the District of Columbia, on complying with the
8 conditions required in case of an appeal from the decision of
9 the Commissioner by an applicant for patent, or a party to an
10 interference as to an invention, and the same rules of practice
11 and procedure shall govern in every stage of such proceedings,
12 as far as the same may be applicable.

13 SEC. 10. That every registered trade-mark, and every
14 mark for the registration of which application has been made,
15 together with the application for registration of the same, shall
16 be assignable in connection with the good will of the business
17 in which the mark is used. Such assignment must be by an
18 instrument in writing and duly acknowledged according to the
19 laws of the country or State in which the same is executed;
20 any such assignment shall be void as against any subsequent
21 purchaser for a valuable consideration, without notice, unless
22 it is recorded in the Patent Office within three months from
23 date thereof. The Commissioner shall keep a record of such
24 assignments.

1 SEC. 11. That certificates of registration of trade-marks
2 shall be issued in the name of the United States of America,
3 under the seal of the Patent Office, and shall be signed by
4 the Commissioner of Patents, and a record thereof, together
5 with printed copies of the drawing and statement of the
6 applicant, shall be kept in books for that purpose. The cer-
7 tificate shall state the date on which the application for regis-
8 tration was received in the Patent Office. Certificates of
9 registration of trade-marks may be issued to the assignee of
10 the applicant, but the assignment must first be entered of
11 record in the Patent Office.

12 Written or printed copies of any records, books, papers,
13 or drawings relating to trade-marks belonging to the Patent
14 Office, and of certificates of registration, authenticated by the
15 seal of the Patent Office and certified by the Commissioner
16 thereof, shall be evidence in all cases wherein the originals
17 could be evidence; and any person making application there-
18 for and paying the fee required by law shall have certified
19 copies thereof.

20 SEC. 12. That a certificate of registration shall remain
21 in force for twenty years, except that in the case of trade-
22 marks previously registered in a foreign country such certifi-
23 cates shall cease to be in force on the day on which the
24 trade-mark ceases to be protected in such foreign country,
25 and shall in no case remain in force more than twenty years,



1 unless renewed. Certificates of registration may be, from
2 time to time, renewed for like periods on payment of the
3 renewal fees required by this Act, upon request by the regis-
4 trant, his legal representatives, or transferees of record in the
5 Patent Office, and such request may be made at any time not
6 more than six months prior to the expiration of the period for
7 which the certificates of registration were issued or renewed.
8 Certificates of registration in force at the date at which this
9 Act takes effect shall remain in force for the period for which
10 they were issued, but shall be renewable on the same condi-
11 tions and for the same periods as certificates issued under the
12 provisions of this Act, and when so renewed shall have the
13 same force and effect as certificates issued under this Act.

14 SEC. 13. That whenever any person shall deem himself
15 injured by the registration of a trade-mark in the Patent
16 Office he may at any time apply to the Commissioner of
17 Patents to cancel the registration thereof. The Commissioner
18 shall refer such application to the examiner in charge of inter-
19 ferences, who is empowered to hear and determine this question
20 and who shall give notice thereof to the registrant. If it
21 appear after a hearing before the examiner that the regis-
22 trant was not entitled to the use of the mark at the date of
23 his application for registration thereof, or that the mark is not
24 used by the registrant, or has been abandoned, and the exam-
25 iner shall so decide, the Commissioner shall cancel the regis-

1 tration. Appeal may be taken to the Commissioner in person
2 from the decision of examiner of interferences.

3 SEC. 14. That the following shall be the rates for trade-
4 mark fees:

5 On filing each original application for registration of a
6 trade-mark, ten dollars: *Provided*, That an application for reg-
7 istration of a trade-mark pending at the date of the passage of
8 this Act, and on which certificate of registration shall not
9 have issued at such date, may, at the option of the applicant,
10 be proceeded with and registered under the provisions of this
11 Act without the payment of further fee.

12 On filing each application for renewal of the registration
13 of a trade-mark, five dollars.

14 On filing notice of opposition to the registration of a
15 trade-mark, ten dollars.

16 On an appeal from the examiner in charge of trade-marks
17 to the Commissioner of Patents, fifteen dollars.

18 On an appeal from the decision of the examiner in charge
19 of interferences, awarding ownership of a trade-mark or can-
20 celing the registration of a trade-mark, to the Commissioner
21 of Patents, fifteen dollars.

22 For certified and uncertified copies of certificates of reg-
23 istration and other papers, and for recording transfers and
24 other papers, the same fees as required by law for such

1 copies of patents and for recording assignments and other
2 papers relating to patents.

3 SEC. 15. That sections forty-nine hundred and thirty-
4 five and forty-nine hundred and thirty-six of the Revised
5 Statutes, relating to the payment of patent fees and to the re-
6 payment of fees paid by mistake, are hereby made applicable
7 to trade-mark fees.

8 SEC. 16. That the registration of a trade-mark under
9 the provisions of this Act shall be prima facie evidence of
10 ownership. Any person who shall, without the consent of
11 the owner thereof, reproduce, counterfeit, copy, or colorably
12 imitate any such trade-mark and affix the same to merchan-
13 dise of substantially the same descriptive properties as those
14 set forth in the registration, or to labels, signs, prints, pack-
15 ages, wrappers, or receptacles intended to be used upon or in
16 connection with the sale of merchandise of substantially the
17 same descriptive properties as those set forth in such registra-
18 tion, and shall use, or shall have used, such reproduction,
19 counterfeit, copy, or colorable imitation in commerce among
20 the several States, or with a foreign nation, or with the
21 Indian tribes, shall be liable to an action for damages therefor
22 at the suit of the owner thereof; and whenever in any such
23 action a verdict is rendered for the plaintiff, the court may
24 enter judgment therein for any sum above the amount found
25 by the verdict as the actual damages, according to the circum-

1 stances of the case, not exceeding three times the amount of
2 such verdict, together with the costs.

3 SEC. 17. That the circuit and territorial courts of the
4 United States and the supreme court of the District of Co-
5 lumbia shall have original jurisdiction, and the circuit courts
6 of appeal of the United States and the court of appeals of
7 the District of Columbia shall have appellate jurisdiction of
8 all suits at law or in equity respecting trade-marks registered
9 in accordance with the provisions of this Act, arising under
10 the present Act, without regard to the amount in controversy.

11 SEC. 18. That writs of certiorari may be granted by the
12 Supreme Court of the United States for the review of cases
13 arising under this Act in the same manner as provided for
14 patent cases by the Act creating the circuit court of appeals.

15 SEC. 19. That the several courts vested with jurisdic-
16 tion of cases arising under the present Act shall have power
17 to grant injunctions, according to the course and principles of
18 equity, to prevent the violation of any right of the owner of
19 a trade-mark registered under this Act, on such terms as the
20 court may deem reasonable; and upon a decree being rendered
21 in any such case for wrongful use of a trade-mark the com-
22 plainant shall be entitled to recover, in addition to the profits
23 to be accounted for by the defendant, the damages the com-
24 plainant has sustained thereby, and the court shall assess the
25 same or cause the same to be assessed under its direction. The



1 court shall have the same power to increase such damages, in
2 its discretion, as is given by section sixteen of this Act for
3 increasing damages found by verdict in actions at law; and
4 in assessing profits the plaintiff shall be required to prove
5 defendant's sales only; defendant must prove all elements of
6 cost which are claimed.

7 SEC. 20. That in any case involving the right to a trade-
8 mark registered in accordance with the provisions of this Act,
9 in which the verdict has been found for the plaintiff, or an
10 injunction issued, the court may order that all labels, signs,
11 prints, packages, wrappers, or receptacles in the possession of
12 the defendant, bearing the trade-mark of the plaintiff or com-
13 plainant, or any reproduction, counterfeit, copy, or colorable
14 imitation thereof, shall be delivered up and destroyed. Any
15 injunction that may be granted upon hearing, after notice to
16 the defendant, to prevent the violation of any right of the
17 owner of a trade-mark registered in accordance with the pro-
18 visions of this Act, by any circuit court of the United States
19 or by a judge thereof, may be served on the parties against
20 whom such injunction may be granted anywhere in the
21 United States where they may be found, and shall be opera-
22 tive, and may be enforced by proceedings to punish for con-
23 tempt, or otherwise, by the court by which such injunction
24 was granted, or by any other circuit court, or judge thereof,
25 in the United States, or by the supreme court of the District

1 of Columbia, or a judge thereof. The said courts, or judges
2 thereof, shall have jurisdiction to enforce said injunction, as
3 herein provided, as fully as if the injunction had been granted
4 by the circuit court in which it is sought to be enforced. The
5 clerk of the court or judge granting the injunction shall, when
6 required to do so by the court before which application to en-
7 force said injunction is made, transfer without delay to said
8 court a certified copy of all the papers on which the said in-
9 junction was granted that are on file in his office.

10 SEC. 21. That no action or suit shall be maintained un-
11 der the provisions of this Act in any case when the trade-
12 mark is used in unlawful business, or upon any article injuri-
13 ous in itself, or which mark has been used with the design of
14 deceiving the public in the purchase of merchandise, or has
15 been abandoned, or upon any certificate of registration fraud-
16 ulently obtained.

17 SEC. 22. That whenever there are interfering registered
18 trade-marks, any person interested in any one of them may
19 have relief against the interfering registrant, and all persons
20 interested under him, by suit in equity against the said reg-
21 istrant; and the court, on notice to adverse parties and other
22 due proceedings had according to the course of equity, may
23 adjudge and declare either of the registrations void in whole
24 or in part according to the interest of the parties in the trade-
25 mark, and may order the certificate of registration to be
26 delivered up to the Commissioner of Patents for cancellation.



1 SEC. 23. That nothing in this Act shall prevent, lessen,
2 impeach, or avoid any remedy at law or in equity which any
3 party aggrieved by any wrongful use of any trade-mark
4 might have had if the provisions of this Act had not been
5 passed.

6 SEC. 24. That all applications for registration pending
7 in the office of the Commissioner of Patents at the time of
8 the passage of this Act may be amended with a view to
9 bringing them, and the certificate issued upon such applica-
10 tions, under its provisions, and the prosecution of such appli-
11 cations may be proceeded with under the provisions of this
12 Act.

13 SEC. 25. That any person who shall procure registra-
14 tion of a trade-mark, or entry thereof, in the office of the
15 Commissioner of Patents by a false or fraudulent declaration
16 or representation, oral or in writing, or by any false means,
17 shall be liable to pay any damages sustained in consequence
18 thereof to the injured party, to be recovered by an action on
19 the case.

20 SEC. 26. That the Commissioner of Patents is author-
21 ized to make rules and regulations, not inconsistent with law,
22 for the conduct of proceedings in reference to the registra-
23 tion of trade-marks provided for by this Act.

24 SEC. 27. That no article of imported merchandise which
25 shall copy or simulate the name of any domestic manufacture

1 or manufacturer or trader, or of any manufacturer or trader
2 located in any foreign country which, by treaty, convention,
3 or law affords similar privileges to citizens of the United
4 States, or which shall copy or simulate a trade-mark regis-
5 tered in accordance with the provisions of this Act, or shall
6 bear a name or mark calculated to induce the public to believe
7 that the article is manufactured in the United States, or that
8 it is manufactured in any foreign country or locality other
9 than the country or locality in which it is in fact manufactured,
10 shall be admitted to entry at any custom-house of the United
11 States; and, in order to aid the officers of the customs in
12 enforcing this prohibition, any domestic manufacturer or trader,
13 and any foreign manufacturer or trader, who is entitled under
14 the provisions of a treaty, convention, declaration, or agree-
15 ment between the United States and any foreign country to
16 the advantages afforded by law to citizens of the United States
17 in respect to trade-marks and commercial names, may require
18 his name and residence, and the name of the locality
19 in which his goods are manufactured, and a copy of the cer-
20 tificate of registration of his trade-mark, issued in accordance
21 with the provisions of this Act, to be recorded in books which
22 shall be kept for this purpose in the Department of the Treas-
23 ury, under such regulations as the Secretary of the Treasury
24 shall prescribe, and may furnish to the Department facsimiles
25 of his name, the name of the locality in which his goods



1 are manufactured, or of his registered trade-mark; and
2 thereupon the Secretary of the Treasury shall cause one or
3 more copies of the same to be transmitted to each collector or
4 other proper officer of customs.

5 SEC. 28. That it shall be the duty of the registrant to
6 give notice to the public that a trade-mark is registered,
7 either by affixing thereon the words "Registered in U. S.
8 Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.,"
9 or when, from the character or size of the trade-mark, or
10 from its manner of attachment to the article to which it is
11 appropriated, this can not be done, then by affixing a label
12 containing a like notice to the package or receptacle wherein
13 the article or articles are inclosed; and in any suit for in-
14 fringement by a party failing so to give notice of registration
15 no damages shall be recovered, except on proof that the
16 defendant was duly notified of infringement, and continued
17 the same after such notice.

18 SEC. 29. That in construing this Act the following rules
19 must be observed, except where the contrary intent is plainly
20 apparent from the context thereof: The United States includes
21 and embraces all territory which is under the jurisdiction and
22 control of the United States. The word "States" includes
23 and embraces the District of Columbia, the Territories of the
24 United States, and such other territory as shall be under the
25 jurisdiction and control of the United States. The terms "per-
26 son" and "owner," and any other word or term used to des-



1 ignate the applicant or other entitled to a benefit or privilege
2 or rendered liable under the provisions of this Act, include a
3 firm, corporation, or association as well as a natural person.
4 The term “applicant” and “registrant” embrace the successors
5 and assigns of such applicant or registrant. The term “trade-
6 mark” includes any mark which is entitled to registration
7 under the terms of this Act and whether registered or not
8 and a trade-mark shall be deemed to be “affixed” to an article
9 when it is placed in any manner in or upon either the article
10 itself or the receptacle or package or upon the envelope or
11 other thing in, by, or with which the goods are packed or
12 inclosed or otherwise prepared for sale or distribution.

13 SEC. 30. That this Act shall be in force and take effect
14 upon its passage. All Acts and parts of Acts inconsistent
15 with this Act are hereby repealed except so far as the same
16 may apply to certificates of registration issued under the
17 Act of Congress approved March third, eighteen hundred and
18 eighty-one, entitled “An Act to authorize the registration of
19 trade-marks and protect the same,” or under the Act approved
20 August fifth, eighteen hundred and eighty-two, entitled “An
21 Act relating to the registration of trade-marks.”

Passed the House of Representatives January 14, 1905.

Attest:

A. McDOWELL,

Clerk.