

1 operative or invalid for any reason, the party in interest
 2 may, on the surrender of the original certificate, apply anew,
 3 in the same form or in an amended form, for the registration
 4 of the alleged trade-mark, in which case the same proceed-
 5 ings shall be had as on an original application for registration,
 6 but a new certificate of registration shall be issued only for
 7 the unexpired part of the original term of registration. Such
 8 new registration shall take effect upon the issue of the new
 9 certificate.

10 FRAUDULENT REGISTRATION—DAMAGES.

11 SEC. 23. A person who shall procure the registration
 12 of a mark, the record of an assignment thereof or of an
 13 entry respecting a mark in the office of the Commissioner of
 14 Patents by a false or fraudulent representation or declaration,
 15 orally or in writing, or by any fraudulent means, shall be lia-
 16 ble to pay to the injured party the damages sustained in con-
 17 sequence thereof, to be recovered in an action on the case in
 18 a circuit court of the United States.

19 TRANSFER OF TRADE-MARK.

20 SEC. 24. Every registered trade-mark and every mark
 21 for the registration of which application has been made,
 22 together with the application for registration of the same,
 23 shall be assignable in connection with the good will of the
 24 business in which the mark is used. Such assignment must be
 25 by instrument in writing, which shall be filed in the Patent



1 Office within three months after it shall take effect by deliv-
 2 ery or otherwise, and a notice thereof shall be published in
 3 the Official Gazette. In default of such filing, the application
 4 or registration shall lapse at the end of three months after the
 5 assignment shall take effect. Such assignment may be made in
 6 a proper case by a trustee in bankruptcy or by an officer of a
 7 court of the United States or of a State having jurisdiction
 8 over the person of the registrant, provided always that the
 9 good will of the business in which the trade-mark is used is
 10 included in such assignment.

11 If any such assignment shall be acknowledged before
 12 any notary public of the several States or Territories or of the
 13 District of Columbia, or any commissioner of the United
 14 States circuit court, or before any secretary of legation or
 15 consular officer authorized to administer oaths or perform
 16 notarial acts under section seventeen hundred and fifty of the
 17 Revised Statutes, the certificate of such acknowledgment,
 18 under the hand and official seal of such notary or other
 19 officer, shall be prima facie evidence of the execution of such
 20 assignment.

21 REGISTERED TRADE-MARKS MUST BE MARKED AS SUCH.

22 SEC. 25. It shall be the duty of the registrant to give
 23 notice to the public that the trade-mark is registered, either
 24 by affixing thereon the words "Registered in the United
 25 States," together with the day and year the certificate of reg-





12 PENALTY FOR FALSELY MARKING AN UNREGISTERED
13 MARK.

SEC. 26. Every person who, for the purpose of deceiving the public, in any manner marks upon or affixes to any unregistered mark, or upon the package containing articles to which unregistered marks are affixed, the words "Registered in the United States," or any words importing that the same is registered in the United States, shall be liable for every such offense to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other half to the use of the United States, to be recovered by any person by suit in a circuit court of the United States within whose jurisdiction such offense may have been committed.

1 ACTIONS FOR INFRINGEMENT—DAMAGES.

2 SEC. 27. Damages for the infringement of any regis-
3 tered trade-mark may be recovered by action on the case
4 in a circuit court of the United States in the name of the
5 party interested, whether as registrant or assignee. And
6 whenever in any such action a verdict is rendered for the
7 plaintiff, the court may enter judgment thereon for any sum
8 above the amount found by the verdict as the actual damage
9 sustained, according to the circumstances of the case, not ex-
10 ceeding three times the amount of such verdict, together with
11 the costs.

12 PLEADINGS AND PROOFS IN SUCH ACTION.

13 SEC. 28. In any action for infringement of a registered
14 trade-mark, the defendant may plead the general issue, and
15 having given notice in writing to the plaintiff or his attorney
16 thirty days before, may prove on the trial any one or more
17 of the following special matters:

- 18 1. That the registered trade-mark was not properly reg-
19 istrable under this act; or
- 20 2. That, for the purpose of deceiving the public, the
21 application for registration, or the oath annexed
22 thereto, or the drawing filed therewith contained a
23 false statement; or
- 24 3. That the registered trade-mark is used in an unlaw-
25 ful business, or upon an article injurious in itself; or



1 4. That the registered trade-mark is used with design to
 2 deceive the public in the purchase of merchan-
 3 dise; or

4 5. That the registration has expired because the regis-
 5 tration of the same mark in the country of origin
 6 has expired or become void.

7 And in notices as to proof of want of registrability or of
 8 false statement, the defendant shall state the names and resi-
 9 dences of the persons alleged to have knowledge of the facts
 10 showing that the trade-mark was not properly registrable or
 11 of the falsity of the statement; and if any one of the special
 12 matters alleged shall be found for the defendant, judgment
 13 shall be rendered for him, with costs; and the like defenses
 14 may be pleaded in any suit in equity for relief against an
 15 alleged infringement; and proofs of the same may be given
 16 upon like notice in the answer of the defendant, with the like
 17 effect.

18 POWER OF COURTS TO GRANT INJUNCTIONS AND ASSESS
 19 DAMAGES—TO IMPANEL JURY.

20 SEC. 29. The several circuit courts of the United States
 21 shall have power to grant injunctions according to the
 22 course and principles of courts of equity, on such terms as the
 23 court may deem reasonable, to prevent the use by another
 24 than the registrant or his assignee of a registered trade-mark
 25 in commerce with foreign nations or among the several States



1 or with the Indian tribes or in the territory of the United
2 States, or the violation of any right under any such registered
3 trade-mark; and upon a decree being rendered in any such
4 case against the defendant, the complainant shall be entitled
5 to recover, in addition to the profits to be accounted for by
6 the defendant, the damages the complainant has sustained by
7 reason of the acts of the defendant; and the court shall assess
8 the same or cause the same to be assessed under its direction.

9 The court shall have the same power to increase such
10 damages, in its discretion, as is given by section twenty-seven
11 of this Act. But, in any suit or action brought for the
12 infringement of any registered trade-mark, there shall be no
13 recovery of profits or damages for any infringement committed
14 more than six years before the filing of the bill of complaint
15 or the issuing of the writ in such suit or action.

16 The said court, when sitting in equity for the trial of such
17 causes, may impanel a jury of not less than five and not more
18 than twelve persons, subject to such general rules in the prem-
19 ises as may, from time to time, be made by the Supreme
20 Court, and submit to them such questions of fact arising in
21 such cause as such circuit court shall deem expedient. And
22 the verdict of such jury shall be treated and proceeded upon
23 in the same manner and with the same effect as in the case
24 of issues sent from chancery to a court of law and returned
25 with findings of fact.



1 APPLICATION FOR REGISTRATION EQUIVALENT TO USE.

2 SEC. 30. Application for the registration of a mark
3 referred to in section five of this Act shall be deemed to be
4 equivalent to the public use of the mark.

5 OFFENSES AGAINST TRADE-MARKS.

6 SEC. 31. A person who knowingly, for use in commerce
7 with foreign nations, or among the several States, or with
8 the Indian tribes, or in the territory of the United States—

- 9 1. Falsely makes or counterfeits a registered trade-
10 mark; or
- 11 2. Affixes to any article of merchandise a false or
12 counterfeit registered trade-mark, knowing the
13 same to be false or counterfeit, or the genuine
14 registered trade-mark or an imitation of the regis-
15 tered trade-mark of another, without the latter's
16 consent; or
- 17 3. Sells or keeps or offers for sale an article of mer-
18 chandise to which is affixed a false or counterfeit
19 registered trade-mark, or the genuine registered
20 trade-mark or an imitation of the registered trade-
21 mark of another, without the latter's consent; or
- 22 4. Has in his possession a counterfeit registered trade-
23 mark, knowing it to be counterfeit, or a die, plate,
24 brand or other thing for the purpose of falsely mak-
25 ing or counterfeiting a registered trade-mark; or



1 5. Makes or sells, or offers to sell or dispose of, or has in
2 his possession with intent to sell or dispose of, an
3 article of merchandise with such a mark as to
4 appear to indicate the quantity, quality, character,
5 place of manufacture or production, or persons
6 manufacturing or producing the articles, or inspec-
7 tion under the laws of the United States or of any
8 foreign government, but not indicating it truly
9 shall be deemed guilty of a misdemeanor, and on
10 conviction thereof shall be punished by a fine of
11 not more than five hundred dollars and by depriva-
12 tion of all benefits and privileges under this act.

13 SEIZURE OF ARTICLES BEARING AN IMITATION OF A
14 REGISTERED TRADE-MARK OR OF A COMMERCIAL NAME.

15 SEC. 32. An article of merchandise to which is affixed
16 an imitation of a registered trade-mark or of a commercial
17 name, or a false or counterfeit registered trade-mark, may
18 be seized in transit to or from a foreign nation or Indian
19 tribe, or among the several States, or over the territory of
20 the United States, but not in transit in bond.

21 Any circuit court of the United States may, upon peti-
22 tion duly verified by a party injured setting forth the facts,
23 and upon proper security given, direct the seizure of such
24 merchandise by any marshal of the United States. The mar-
25 shal making such seizure shall forthwith serve upon the



1 owner of such merchandise a copy of such order and of the
2 petition upon which the order was granted, by delivering
3 the same to him personally if he can be found with due
4 diligence, or if he can not be found, then to his agent, if any,
5 from whose possession the said goods were taken, and if
6 neither can be found, then by posting the same in a conspicu-
7 ous place in or upon the building, vessel, car, or other structure
8 or means of transportation from which the said merchandise
9 was removed, and in either of the last two cases by mailing
10 a copy thereof to the owner at his last known address.
11 Within ten days thereafter the owner of the said mer-
12 chandise may apply upon affidavits to the court by which the
13 order was granted for an order to show cause why the original
14 order should not be vacated. Upon the return of such
15 order to show cause the court shall determine whether
16 the facts exist justifying the seizure. If it shall be
17 found that these facts do not exist the court shall
18 vacate the original order and direct the restoration of the
19 merchandise. If it appear that the facts exist justifying the
20 seizure, or if no application for the restoration of the merchan-
21 dise be made as herein provided, the court shall direct that the
22 same be sold at public auction, after removal of the imitation
23 mark and due advertisement; and the proceeds of such sale,
24 after deducting the expenses of seizure and sale and the fees
25 of the marshal therefor, shall be paid one-half to the Treas-



1 urer of the United States and the other half to the party
2 injured.

3 In any action to recover damages for wrongful seizure
4 or sale under this section the sureties upon the bond of the
5 petitioner may be made parties defendant, and judgment may
6 be rendered against them in said action.

7 ARTICLES BEARING IMITATIONS OF A REGISTERED TRADE-
8 MARK OR OF A COMMERCIAL NAME FORBIDDEN
9 ENTRY.

10 SEC. 33. No article of imported merchandise to which is
11 affixed—

- 12 1. An imitation of a registered trade-mark; or
- 13 2. An imitation of the commercial name of a resident of
14 the United States or of a citizen or subject of a gov-
15 ernment which by treaty or convention affords simi-
16 lar privileges to citizens of the United States, or of
17 a person who has a bona fide industrial or commercial
18 establishment in the territory of such government; or
- 19 3. A name calculated to induce the public to believe
20 that the article is manufactured or produced in the
21 United States or in a foreign country or a place
22 other than the country or place in which it
23 was in fact manufactured or produced shall be
24 admitted to entry at any custom-house of the
25 United States.





24 SEC. 35. The repeal of a law or any part of it speci-
25 fied in the annexed schedule shall not affect or impair

1 any act done or right accruing, accrued, or acquired, or lia-
 2 bility, forfeiture, or penalty incurred, prior to January first,
 3 nineteen hundred and five, under or by virtue of any law so
 4 repealed, but the same may be asserted, enforced, prosecuted
 5 or inflicted as fully and to the same extent as if such law had
 6 not been repealed; and all actions and proceedings, civil or
 7 criminal, commenced under or by virtue of the law so repealed,
 8 and pending on December thirty-first, nineteen hundred and
 9 four, may be prosecuted and defended to final effect in the
 10 same manner as they might under laws then existing, unless
 11 it shall be otherwise specially provided by law.

12 CONSTRUCTION OF TERMS.

13 SEC. 36. In construing this Act, or an indictment or
 14 other pleading in a case provided for by this Act, the fol-
 15 lowing rules must be observed, except when a contrary
 16 intent is plainly apparent from the context thereof.

17 TERRITORY.—The term “territory” includes the Terri-
 18 tories, the District of Columbia, and all other territory in the
 19 possession or under the jurisdiction or control of the United
 20 States not included within a State.

21 PERSON.—The term “person” or any word or term used
 22 to designate the applicant or registrant or other entitled to a
 23 benefit or privilege under this Act includes a partnership,
 24 association, company, corporation, public or private, commu-
 25 nity, union of persons, or State, as well as a natural person.



1 NUMBER—GENDER.—The singular number includes the
2 plural, and the plural includes the singular. The masculine
3 gender includes the feminine and neuter.

4 APPLICANT—REGISTRANT.—The terms “applicant”
5 and “registrant” embrace the successors and assigns of such
6 applicant or registrant.

7 INFRINGEMENT.—The term “infringement” includes
8 every wrongful or unauthorized use in commerce with foreign
9 nations or among the several States or with the Indian tribes,
10 or in the territory of the United States, or the reproduction
11 or imitation of any registered trade-mark affixed to goods
12 of substantially the same class as those described in the
13 certificate of registration.

14 IMITATION.—An “imitation” of a trade-mark is that
15 which so far resembles a genuine trade-mark as to be likely
16 to induce the belief that it is genuine, whether by the use of
17 words or letters similar in appearance or in sound, or by any
18 sign, device, or other means whatsoever.

19 AFFIXED.—A trade-mark is deemed to be “affixed” to
20 an article of merchandise when it is placed in any manner in
21 or upon either—

22 First. The article itself; or,

23 Second. A box, bale, barrel, bottle, case, cask, or other
24 vessel or package, or a cover, wrapper, stopper, brand, label,



1 or other thing, in, by, or with which the goods are packed,
2 inclosed, or otherwise prepared for sale or disposition.

3 KNOWINGLY.—The term “knowingly” imports a knowl-
4 edge that the facts exist which constitute the act or omission
5 unlawful and does not require knowledge of the unlawfulness
6 of the act or omission.

7 COUNTRY OF ORIGIN.—The words “country of origin”
8 as applied to trade-marks refer to the country in which the
9 trade-mark was first registered and of which the applicant is
10 a citizen or subject, or in which he has a bona fide industrial or
11 commercial establishment.

12 MARK.—The term “mark” includes marks, trade-marks,
13 and symbols.

14 CONSTRUCTION OF ACT.

15 SEC. 37. The provisions of this Act, so far as they
16 are substantially the same as those of laws existing on De-
17 cember thirty-first, nineteen hundred and four, shall be con-
18 strued as a continuation of such laws, modified or amended
19 to the language employed in this Act and not as new enact-
20 ments; a reference in laws not repealed to provisions of law
21 incorporated into this Act and repealed shall be construed as
22 applying to the provisions so incorporated.

23 PENDING APPLICATIONS.

24 SEC. 38. All applications for registration pending when
25 this Act shall take effect may be proceeded with there-
26 under subject to its requirements, and for such purpose the



1 applicant shall amend his application to conform to the pro-
 2 visions of this Act.

3 REGISTRATIONS HERETOFORE MADE—ACT OF EIGHTEEN
 4 HUNDRED AND SEVENTY.

5 SEC. 39. All trade-marks registered prior to the third
 6 day of March, eighteen hundred and eighty-one, shall be
 7 deemed abandoned unless application for registration thereof
 8 as prescribed in this Act be made prior to the first day of May,
 9 nineteen hundred and three, in default whereof the registrant
 10 shall not thereafter be entitled to notice from the Commissioner
 11 of Patents under section eleven of this Act.

12 ACT OF EIGHTEEN HUNDRED AND EIGHTY-ONE.

13 All registrations made after the third day of March,
 14 eighteen hundred and eighty-one, and prior to the first day of
 15 January, nineteen hundred and three, shall remain in full force
 16 and effect to the end of the term for which originally granted,
 17 unless surrendered and reregistered; but the registrants shall
 18 be entitled to institute proceedings for infringement provided
 19 herein only when such infringement takes place in commerce
 20 with foreign nations or with the Indian tribes.

21 REGISTRATION BY RESIDENTS OF HAWAII.

22 SEC. 40. Residents of the Territory of Hawaii, if quali-
 23 fied under section five, may file applications for registration
 24 of marks under this Act with the treasurer of the Territory of
 25 Hawaii, who shall transmit the same to the Commissioner of



1 Patents. The date of filing of such applications in the United
 2 States Patent Office shall, for the purposes of this Act, be
 3 deemed to be the same as the date of filing with the treasurer
 4 of the Territory of Hawaii.

5 In proceedings upon applications so filed the time al-
 6 lowed within which an act may be done, a notice may be
 7 given, a document may be filed, or an appeal may be taken,
 8 shall be double the time elsewhere provided in this Act.

9 INTERNATIONAL REGISTRATION OF TRADE-MARKS.

10 SEC. 41. Upon and after the adhesion of the United
 11 States to the agreement for the international registra-
 12 tion of trade-marks concluded at Madrid April fourteenth,
 13 eighteen hundred and ninety-one, all correspondence with the
 14 International Bureau at Berne in regard to marks to be reg-
 15 istered under such agreement by citizens of the United States or
 16 aliens entitled to the advantages of citizens under such agree-
 17 ment shall be conducted by the Commissioner of Patents,
 18 and all necessary rules, forms, and orders as to procedure and
 19 for carrying this Act into effect shall be prescribed and may
 20 be amended by him from time to time.

21 AMENDATORY AND REPEALING STATUTES.

22 SEC. 42. No provision of this Act, or any part thereof,
 23 shall be deemed repealed, altered, or amended by the passage
 24 of any subsequent statute inconsistent therewith unless such



1 statute shall explicitly refer thereto and directly repeal, alter,
 2 or amend this Act accordingly.

3 REPEAL.

4 SEC. 43. The laws or parts thereof specified in the
 5 schedule hereto annexed and all other Acts and parts of Acts
 6 inconsistent with the provisions of this Act are repealed.

7 SCHEDULE OF LAWS REPEALED.

REVISED STATUTES.

Date.	Title.	Chapter.	Section.	Subject.
June 22, 1874	XXXIII	2496	Prohibition upon importation of simulated watch movements, etc. Reenactment of chapter 125, March 3, 1871.
Do	LX	2	4937-4947	Registration of trade-marks, etc. Reenactment of chapter 230, sections 77 to 84, July 8, 1870.

STATUTES AT LARGE.

Date.	Chapter.	Section.	Volume.	Page.	Subject.
July 8, 1870	230	77-84	16	210-212	Registration of trade-marks, etc.
Mar. 3, 1871	125	16	580	Prohibition upon importation of simulated watch movements.
Aug. 14, 1876	274	All.	19	141	To punish the counterfeiting of trade-marks, etc.
Mar. 3, 1881	138	All.	21	502	Registration of trade-marks, etc.
Aug. 4, 1882	393	All.	22	298	Registration of marks used prior to March 3, 1881.
Aug. 27, 1894	349	5	28	547	Marks on foreign-made goods.
Do	349	6	28	547	Foreign-made goods bearing domestic marks excluded.
July 24, 1897	11	8	30	205	Marks on foreign-made goods. Reenactment of chapter 349, August 27, 1894.
Do	11	11	30	207	Foreign-made goods bearing domestic marks excluded. Reenactment of chapter 349, August 27, 1894.



WHEN ACT TO TAKE EFFECT.

1
2 SEC. 44. This Act shall take effect January first, nine-
3 teen hundred and five. When construed in connection with
4 other statutes it must be deemed to have been enacted on
5 the day of , nineteen hundred and four, so
6 that any statute enacted after that day is to have the same
7 effect as if it had been enacted after this statute.

58TH CONGRESS, }
2D SESSION.

S. 3220.

A BILL

To regulate and protect marks, trade-marks, commercial names, and symbols used in commerce, and to enforce treaties regarding the same.

By Mr. KITTREDGE.

JANUARY 8, 1904.—Read twice and referred to the Committee on Patents.

