

## IN THE HOUSE OF REPRESENTATIVES.

MARCH 1, 1904.

Mr. SOUTHWICK (by request) introduced the following bill; which was referred to the Committee on Patents and ordered to be printed.

# A BILL

To provide for the registration and protection of trade-marks.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*

That the owners of trade-marks used in commerce with foreign nations, or among the several States, or with Indian tribes, or with the insular or other possessions of the United States, provided such owners shall be domiciled in the United States or insular or other possessions or territory thereof, or located in any foreign country or tribes, which, by treaty, convention, or law, affords similar privileges to the 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 applicant; the class of merchandise and the particular description of goods comprised in such class, to which the



1 mark is appropriated; a description of the mark, with fac-  
2 simile thereof, and a statement of the manner of applying the  
3 same to the goods and the length of time during which the  
4 trade-mark has been used.

5 Second. By paying into the Treasury of the United  
6 States the sum of fifteen dollars and complying with such  
7 regulations as may be prescribed by the Commissioner of  
8 Patents.

9 SEC. 2. That the application must be accompanied by a  
10 written declaration verified by the person, or by a member of  
11 a firm, or by an officer of a corporation applying, to the effect  
12 that such party has at the time a right to the use of the trade-  
13 mark sought to be registered, and that no other person, firm,  
14 or corporation has the right to such use either in the identical  
15 form or in any such near resemblance thereto as might be calcu-  
16 lated to deceive; that such trade-mark is used in commerce  
17 between the several States, or with foreign nations, or with  
18 Indian tribes, or with the insular or other possessions of the  
19 United States, and that the description and facsimile presented  
20 truly represent the trade-mark sought to be registered.

21 SEC. 3. That the filing date of any such application shall  
22 be noted and recorded, but no alleged trade-mark shall be  
23 registered unless the same appear to be lawfully used in a  
24 lawful business by the applicant, in the commerce above  
25 indicated, or is within the province of a treaty, convention,



1 or declaration with a foreign power; nor which is identical  
2 with a registered trade-mark owned by another and appro-  
3 priated to the same class of merchandise, or which so nearly  
4 resembles some other person's registered trade-mark as to be  
5 likely to cause confusion or mistake in the mind of the public  
6 as to deceive purchasers. In an application for registration  
7 the Commissioner of Patents shall decide the presumptive  
8 lawfulness of claim to the alleged mark, and in any dispute  
9 between an applicant and a previous registrant, or between  
10 applicants, he shall follow as far as the same may be applicable  
11 the practice of courts of equity of the United States in analogous  
12 cases.

13       SEC. 4. That certificates of registration under this Act  
14 shall be issued in the name of the United States of America,  
15 under the seal of the Department of the Interior, and shall be  
16 signed by the Commissioner of Patents or the acting com-  
17 missioner, and a record thereof, together with printed copies  
18 of the specifications or drawings or facsimile shall be kept by  
19 the Commissioner of Patents. Copies of trade-marks and of  
20 statements and declarations filed therewith, and certificates of  
21 registration so signed and sealed shall be evidence in any  
22 suit in which such trade-marks shall be brought into contro-  
23 versy.

24       SEC. 5. That the certificate of registry shall remain in  
25 force for thirty years from its date, except in cases where the



1 trade-mark is claimed for and applied to articles not manu-  
 2 factured in this country, and in which it receives protection  
 3 under the laws of a foreign country for a shorter period, in  
 4 which case it shall cease to have any force in this country by  
 5 virtue of this Act at the time that such trade-mark ceases to  
 6 be exclusive property elsewhere. At any time during the  
 7 six months prior to the expiration of the term of thirty years  
 8 such registration may be renewed from time to time on the  
 9 same terms and for a like period.

10 SEC. 6. That registration of a trade-mark shall be prima  
 11 facie evidence of ownership. Any person who shall repro-  
 12 duce, counterfeit, copy, or colorably imitate any trade-mark  
 13 registered under this Act and affix the same to merchandise  
 14 of substantially the same descriptive properties as those de-  
 15 scribed in the registration shall be liable to an action on the  
 16 case for damages for the wrongful use of said trade-mark at  
 17 the suit of the owner thereof; and the party aggrieved shall  
 18 also have his remedy according to the course of equity to enjoin  
 19 the wrongful use of such trade-mark used in commerce with  
 20 foreign nations, or among the several States, or with the Indian  
 21 tribes, or with the insular or other possessions of the United  
 22 States, as aforesaid, and to recover compensation therefor in  
 23 any court having jurisdiction over the person guilty of such  
 24 wrongful act; and the courts of the United States shall have



1 original and appellate jurisdiction in such cases, without  
2 regard to the amount in controversy.

3 SEC. 7. That no action or suit shall be maintained under  
4 the provisions of this Act when the trade-mark is used in any  
5 unlawful business or upon any article injurious in itself, or  
6 upon any article in connection with which false representa-  
7 tions are made, or which mark has been used with the design  
8 of deceiving the public in the purchase of merchandise, or  
9 under any certificate of registration fraudulently obtained.

10 SEC. 8. That any distinctive name, word, phrase, or  
11 symbol, or the name of a deceased person or character famous  
12 in history, fiction, or literature, or the name of a living cele-  
13 brity with the consent of such person, by which the origin or  
14 ownership of goods can be distinguished, shall be considered  
15 proper subject-matter for trade-mark registration under this  
16 Act: *Provided*, That no merely descriptive word or phrase,  
17 or merely the name of the applicant (unless such name be in  
18 a distinctive shape, or consist in the written signature in  
19 original or facsimile of the applicant), or a merely geograph-  
20 ical name or term shall prima facie constitute a trade-mark  
21 which may be exclusively appropriated under this Act: *Pro-*  
22 *vided further*, That no public arms or decorations, including  
23 the national flag, shall be registerable under the provisions of  
24 this Act.

25 SEC. 9. That every applicant for registration of a trade-



1 mark, not domiciled in the United States, shall, before the  
2 issuance of the certificate of registration, designate by a notice  
3 in writing filed in the Patent Office, some person residing  
4 within the United States on whom process or notice of pro-  
5 ceedings affecting the right of ownership in the trade-mark  
6 of which they may claim to be the owner, brought under the  
7 provisions of this Act, or under other laws of the United  
8 States, may be served with the same force and effect as if  
9 served upon the applicant or registrant in person.

10 SEC. 10. That every person who, for the purpose of de-  
11 ceiving the public, in any manner marks an unregistered mark,  
12 or a package containing articles to which the unregistered marks  
13 are affixed, with words indicating that the mark is registered  
14 in the United States, shall be liable for every such offense to  
15 a penalty of not less than one hundred dollars with costs, one  
16 half of said penalty to the person who shall sue for the same  
17 and the other half to the use of the United States, to be re-  
18 covered by any person by suit in the circuit court of the  
19 United States within whose jurisdiction such offense may have  
20 been committed.

21 SEC. 11. That any person who, knowingly and with in-  
22 tention to deceive, for use in the commerce indicated in this  
23 Act, falsely makes or counterfeits a registered trade-mark or  
24 a colorable imitation thereof, or affixes or causes to be affixed  
25 such counterfeit marks to any article of merchandise, knowing



1 the same to be false or counterfeit, or falsely affixes the genu-  
2 ine registered trade-mark without the lawful owner's consent;  
3 or sells or keeps or offers for sale articles or packages in which  
4 they are contained, shall be deemed guilty of a misdemeanor,  
5 and on conviction thereof shall be punished by a fine of not  
6 less than five hundred dollars nor more than one thousand  
7 dollars for each and every offense, at the discretion of the  
8 court.

9       SEC. 12. That any person who shall procure registration  
10 of a trade-mark or entry thereof in the Office of the Commis-  
11 sioner of Patents, by a false or fraudulent declaration or repre-  
12 sentation orally or in writing, or by any fraudulent means,  
13 shall be liable to pay any damages sustained in consequence  
14 thereof to the injured party, to be recovered in an action on  
15 the case.

16       SEC. 13. That nothing in this Act shall prevent, lessen,  
17 impeach, or avoid any remedy at law or in equity, which any  
18 party aggrieved by any wrongful use of any trade-mark  
19 might have had if the provisions of this Act had not been  
20 passed.

21       SEC. 14. That all applications for registration pending  
22 in the Office of the Commissioner of Patents at the time of  
23 the passage of this Act, may be amended with a view of  
24 bringing them and the certificates issued upon such applica-  
25 tions under the provisions of this Act, and the prosecutions of



1 said applications may be proceeded with under the provisions  
2 of this Act.

3     . SEC. 15. That should an application for registration  
4 under this Act be rejected upon a trade-mark registered  
5 under the trade-mark Act of July eighth, eighteen hundred  
6 and seventy, and not reregistered under the Act of March  
7 third, eighteen hundred and eighty-one, the Commissioner of  
8 Patents shall, upon request of the applicant, suspend action  
9 and notify such registrant under the Act of eighteen hundred  
10 and seventy, to file an application under the provisions of  
11 this Act within sixty days from the date of said notice, and  
12 upon the failure of such registrant to file his application, the  
13 mark upon which the rejection is based shall be presumed to  
14 be abandoned and no bar to the registry of the mark of the  
15 applicant.

16     SEC. 16. That all trade-marks registered under the Act  
17 approved March third, eighteen hundred and eighty-one, en-  
18 titled, "An Act to authorize the registration of trade-marks  
19 and protect the same," shall be reregistered under the pro-  
20 visions of this Act, for the same goods, upon the application  
21 in due form above prescribed, by the original applicant or his  
22 successors or assigns, upon the payment into the United States  
23 Treasury of five dollars in each and every case, provided that  
24 no adverse decision is of record in the Patent Office affecting





1 the right of ownership of the mark for which registration is  
2 sought.

3 SEC. 17. That nothing in this Act shall be construed as  
4 unfavorably affecting a claim to a trade-mark after the term  
5 of registration shall have expired; nor to give cognizance to  
6 any court of the United States in an action or suit between  
7 citizens of the same State, unless the trade-mark in contro-  
8 versy is used on goods intended to be transported to a foreign  
9 country or in lawful commercial intercourse with an Indian  
10 tribe, or in commerce among the several States, or with the  
11 insular or other possessions of the United States.

12 SEC. 18. That the Commissioner of Patents is authorized  
13 to make rules and regulations and prescribe forms for the  
14 transfer of the right to use trade-marks and for recording such  
15 transfers in his Office.

16 SEC. 19. That citizens and residents of this country or  
17 residents of the insular or other possessions of the United  
18 States wishing the protection of trade-marks in any foreign  
19 country, the laws of which require registration here as a con-  
20 dition precedent to getting such protection there, may register  
21 their trade-marks for that purpose and have certificates thereof  
22 from the Patent Office.

23 SEC. 20. That this Act shall take effect upon its pas-  
24 sage. All Acts and parts of Acts inconsistent herewith are  
25 hereby repealed.





58<sup>TH</sup> CONGRESS, }  
2<sup>D</sup> SESSION. } **H. R. 13297.**

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By Mr. SOUTHWICK.

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