

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-

