

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

8 FRAUDULENT REGISTRATION—DAMAGES.

9 SEC. 23. That a person who shall procure the registra-  
 10 tion of a mark, the record of an assignment thereof or of an  
 11 entry respecting a mark in the office of the Commissioner of  
 12 Patents by a false or fraudulent representation or declaration,  
 13 orally or in writing, or by any fraudulent means, shall be lia-  
 14 ble to pay to the injured party the damages sustained in con-  
 15 sequence thereof, to be recovered in action on the case.

16 TRANSFER OF TRADE-MARK.

17 SEC. 24. That every registered trade-mark and every  
 18 mark for the registration of which application has been made,  
 19 together with the application for registration of the same,  
 20 shall be assignable in connection with the good will of the  
 21 business in which the mark is used. Such assignment must be  
 22 by instrument in writing, which shall be filed in the Patent  
 23 Office within three months after it shall take effect, by deliv-  
 24 ery or otherwise, and a notice thereof shall be published in  
 25 the Official Gazette. In default of such filing the application



1 or registration shall lapse at the end of three months after  
2 the assignment shall take effect. Such may be made in the  
3 proper case by a trustee in bankruptcy or by an officer of a  
4 court of the United States or of a State having jurisdiction  
5 over the person of the registrant, provided always that the  
6 good will of the business in which the mark is used is in-  
7 cluded in such assignment.

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

18 REGISTERED TRADE-MARKS MUST BE MARKED AS SUCH.

19 SEC. 25. That it shall be the duty of the registrant to  
20 give notice to the public that the trade-mark is registered,  
21 either by affixing thereon the words "Registered in the United  
22 States," together with the day and year the certificate of reg-  
23 istration was granted at length, or abbreviated thus: "Reg.  
24 U. S. 1, 2, 99," with the day and month or year indicated by  
25 numerals; or when, from the character or size of the trade-



1 mark, or from its manner of attachment to the article to which  
 2 it belongs, this can not be done, then by affixing a label con-  
 3 taining the like notion to the package wherein are inclosed  
 4 one or more of the articles to which the trade-mark is attached ;  
 5 and in any suit for infringement by a party failing so to give  
 6 notice of registration no damages shall be recovered by the  
 7 plaintiff except on proof that the defendant was duly notified  
 8 of the infringement, and continued the same after such notice.

9 PENALTY FOR FALSELY MARKING AN UNREGISTERED  
 10 TRADE-MARK.

11 SEC. 26. That every person who, for the purpose of de-  
 12 ceiving the public, in any manner marks upon or affixes to  
 13 any unregistered mark or trade-mark, or upon the package  
 14 containing articles to which unregistered marks or trade-  
 15 marks are affixed, the words "Registered in the United  
 16 States," or any words importing that the same is registered  
 17 in the United States, shall be liable for every such offense to  
 18 a penalty of not less than one hundred dollars, with costs;  
 19 one-half of said penalty to the person who shall sue for the  
 20 same, and the other half to the use of the United States, to  
 21 be recovered by any person by suit in a circuit court of the  
 22 United States within whose jurisdiction such offense may  
 23 have been committed.

24 ACTIONS FOR INFRINGEMENT—DAMAGES.

25 SEC. 27. That damages for the infringement of any  
 26 registered trade-mark may be recovered by action on the case,



1 in the name of the party interested, whether as registrant or  
 2 assignee. And whenever in any such action a verdict is  
 3 rendered for the plaintiff the court may enter judgment thereon  
 4 for any sum above the amount found by the verdict as the actual  
 5 damage sustained, according to the circumstances of the case,  
 6 not exceeding three times the amount of such verdict, together  
 7 with the costs.

8 PLEADINGS AND PROOFS IN SUCH ACTIONS.

9 SEC. 28. That in any action for infringement of a reg-  
 10 istered trade-mark the defendant may plead the general issue,  
 11 and having given notice in writing to the plaintiff, or his  
 12 attorney, thirty days before, may prove on the trial any one  
 13 or more of the following special matters:

14 First. That, for the purpose of deceiving the public, the  
 15 application for registration contained a false statement; or

16 Second. That the alleged trade-mark is used in an unlaw-  
 17 ful business, or upon an article injurious in itself; or

18 Third. That the said mark is used with design to deceive  
 19 the public in the purchase of merchandise; or

20 Fourth. That the registration has expired because of the  
 21 expiration of the registration of the same mark in the country  
 22 of its origin.

23 And in notices as to proof of false statement the defend-  
 24 ant shall state the names and residences of the persons alleged  
 25 to have knowledge of the facts contained in the statement;  
 26 and if any one of the special matters alleged, shall be found



1 for the defendant, judgment shall be rendered for him, with  
 2 costs; and the like defenses may be pleaded in any suit in  
 3 equity for relief against an alleged infringement; and proofs  
 4 of the same may be given upon like notice in the answer of  
 5 the defendant, with the like effect.

6 POWER OF COURTS TO GRANT INJUNCTIONS AND ASSESS  
 7 DAMAGES—TO IMPANEL JURY.

8 SEC. 29. That the several circuit courts of the United  
 9 States shall have power to grant injunctions according to the  
 10 course and principles of courts of equity, on such terms as the  
 11 court may deem reasonable, to prevent the use by another  
 12 than the registrant or his assignee of a registered trade-mark  
 13 in commerce with foreign nations or among the several States  
 14 or with the Indian tribes, or the violation of any right under  
 15 any such registered trade-mark; and upon a decree being  
 16 rendered in any such case against the defendant the com-  
 17 plainant shall be entitled to recover, in addition to the profits  
 18 to be accounted for by the defendant, the damages the com-  
 19 plainant has sustained by reason of the acts of the defendant;  
 20 and the court shall assess the same or cause the same to be  
 21 assessed under its direction.

22 The court shall have the same power to increase such  
 23 damages, in its discretion, as is given to increase the damages  
 24 found by verdicts in actions in the nature of actions of tres-  
 25 pass on the case. But in any suit or action brought for the



1 infringement of any registered trade-mark there shall be no  
 2 recovery of profits or damages for any infringement committed  
 3 more than six years before the filing of the bill of complaint  
 4 or the issuing of the writ in such suit or action.

5       The said court, when sitting in equity for the trial of such  
 6 causes, may impanel a jury of not less than five and not more  
 7 than twelve persons, subject to such general rules in the prem-  
 8 ises as may, from time to time, be made by the Supreme  
 9 Court, and submit to them such questions of fact arising in  
 10 such cause as such circuit court shall deem expedient. And  
 11 the verdict of such jury shall be treated and proceeded upon  
 12 in the same manner and with the same effect as in the case  
 13 of issues sent from chancery to a court of law and returned  
 14 with findings of fact.

15       AN ACTION CAN NOT BE MAINTAINED, WHEN.

16       SEC. 30. That no action or suit shall be maintained under  
 17 the provisions of this Act for the infringement of a mark used  
 18 by the registrant in an unlawful business or upon any article  
 19 injurious in itself, or of a mark used by him with the design  
 20 of deceiving the public in the purchase of merchandise, or  
 21 under any certificate of registration fraudulently obtained.

22       OFFENSES AGAINST TRADE-MARKS.

23       SEC. 31. That a person who knowingly, for use in com-  
 24 merce with foreign nations, or among the several States, or  
 25 with the Indian tribes:



1 First. Falsely makes or counterfeits a registered trade-  
2 mark; or

3 Second. Affixes to any article of merchandise a false  
4 or counterfeit registered trade-mark, knowing the same to be  
5 false or counterfeit, or the genuine registered trade-mark or  
6 an imitation of the registered trade-mark of another, without  
7 the latter's consent; or

8 Third. Sells or keeps or offers for sale an article of  
9 merchandise to which is affixed a false or counterfeit regis-  
10 tered trade-mark, or the genuine registered trade-mark of  
11 another or an imitation of the registered trade-mark, without  
12 the latter's consent; or

13 Fourth. Has in his possession a counterfeit registered  
14 trade-mark, knowing it to be counterfeit, or a die, plate, brand,  
15 or other thing for the purpose of falsely making or counter-  
16 feiting a registered trade-mark; or

17 Fifth. Makes or sells, or offers to sell or dispose of, or  
18 has in his possession with intent to sell or dispose of, an article  
19 of merchandise with such a mark as to appear to indicate the  
20 quantity, quality, character, place of manufacture or produc-  
21 tion, or persons manufacturing or producing the articles, but  
22 not indicating it truly, shall be deemed guilty of a misde-  
23 meanor, and on conviction thereof shall be punished by a fine



1 of not more than five hundred dollars and by deprivation of  
2 all benefits and privileges under this act.

3 SEIZURE OF GOODS BEARING SIMULATED MARK.

4 SEC. 32. That an article of merchandise to which is  
5 affixed a copy or simulation of the registered trade-mark of  
6 another, or a false or counterfeit registered trade-mark, may  
7 be seized in transit to any foreign country or Indian tribe, or  
8 between the several States, but not in transit in bond over  
9 the United States.

10 Any circuit court of the United States may, upon peti-  
11 tion duly verified by a party aggrieved setting forth the facts,  
12 and upon proper security given, direct the seizure of such  
13 merchandise by any marshal of the United States. The mar-  
14 shal making such seizure shall forthwith serve upon the  
15 owner of such merchandise a copy of such order and of the  
16 petition upon which the order was granted, by delivering  
17 the same to him personally if he can be found with due  
18 diligence, or if he can not be found, then to his agent, if any,  
19 from whose possession the said goods were taken, and if  
20 neither can be found, then by posting the same in a conspicu-  
21 ous place in or upon the building, vessel, car, or other structure  
22 or means of transportation from which the said merchandise  
23 was removed, and in either of the last two cases by mailing  
24 a copy thereof to the owner at his last known address, if any.  
25 Within ten days thereafter the owner of the said mer-





1   chandise may apply upon affidavits to the court by which the  
 2   order was granted for an order to show cause why the original  
 3   order should not be vacated. Upon the return of such  
 4   order to show cause the court shall determine whether  
 5   the facts exist justifying the seizure. If it shall be  
 6   found that these facts do not exist the court shall  
 7   vacate the original order and direct the restoration  
 8   of the goods. If it appear that the facts exist justifying the  
 9   seizure, or if no application for the restoration of the goods  
 10   be made as herein provided, the court shall direct that the  
 11   said goods be sold at public auction, after due advertisement;  
 12   and the proceeds of such sale, after deducting the expenses  
 13   of seizure and sale and the fees of the marshal therefor, shall  
 14   be paid one-half to the Treasurer of the United States and  
 15   the other half to the party aggrieved.

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

20   ARTICLES BEARING SIMULATED TRADE-MARKS FORBIDDEN

21                                   ENTRY.

22       SEC. 33. That no article of imported merchandise to  
 23   which is affixed a copy or simulation of a registered trade-mark,  
 24   or a name calculated to induce the public to believe that the



1 article is manufactured in the United States or that it is  
2 manufactured in any foreign country other than the country  
3 or locality in which it is in fact manufactured, shall be  
4 admitted to entry at any custom-house of the United  
5 States. And to aid the officers of the customs in enforcing  
6 this prohibition any registrant in the United States Patent  
7 Office and any foreign producer, manufacturer, or mer-  
8 chant who employs a trade name and is entitled under the  
9 provisions of a treaty, convention, declaration, or agreement  
10 between the United States and the country in which he is  
11 located, to the advantage accorded by law to citizens of the  
12 United States, may require his name and residence and his  
13 trade name or registered trade-mark to be recorded in the  
14 Department of the Treasury, under such regulations as the  
15 Secretary of the Treasury shall prescribe, and may furnish  
16 to the Department facsimiles of such trade-mark and trade  
17 name; and thereupon the Secretary of the Treasury shall  
18 cause one or more copies of the trade name and of the regis-  
19 tered trade-mark to be transmitted to each collector or other  
20 proper officer of the customs.

21 FEES.

22 SEC. 34. That there shall be paid into the Treasury of  
23 the United States:

24 On filing each original application for registration of a  
25 mark, ten dollars;



1       On filing each application for the renewal of the regis-  
2       tration of a trade-mark, five dollars;

3       On an appeal from the examiner in charge of trade-  
4       marks to the Commissioner of Patents, ten dollars;

5       On an appeal from the Commissioner of Patents to the  
6       court of appeals for the District of Columbia;

7       For certified and uncertified copies of certificates of reg-  
8       istration and other papers, and for recording assignments and  
9       other papers, the same fees as required by law for copies of  
10      patents and for recording assignments and other papers relat-  
11      ing to patents.

12                               SAVING CLAUSE.

13       SEC. 35. That the repeal of a law or any part of it  
14       specified in the annexed schedule shall not affect or impair  
15       any act done or right accruing, accrued, or acquired, or lia-  
16       bility, forfeiture, or penalty incurred, prior to January first,  
17       nineteen hundred and two, under or by virtue of any law so  
18       repealed, but the same may be asserted, enforced, prosecuted  
19       or inflicted as fully and to the same extent as if such law had  
20       not been repealed; and all actions and proceedings, civil or  
21       criminal, commenced under or by virtue of the law so repealed,  
22       and pending on December thirty-first, nineteen hundred and  
23       one, may be prosecuted and defended to final effect in the  
24       same manner as they might under laws then existing, unless  
25       it shall be otherwise specially provided by law.



## CONSTRUCTION OF TERMS.

SEC. 36. That in construing this Act, or an indictment or other pleading in a case provided for by this Act, the following rules must be observed, except when a contrary intent is plainly apparent from the context thereof.

## STATE.

The word "State" includes the Territories, the District of Columbia, and all other territory in the possession or under the jurisdiction or control of the United States.

## PERSON.

The word "person" or any word or term used to designate the applicant or registrant or other entitled to a benefit or privilege thereunder includes a partnership, association, company, corporation, common carrier, municipality, or State as well as a natural person.

## SINGULAR NUMBER—GENDER.

The singular number includes the plural, and the plural includes the singular. The masculine gender includes the feminine and neuter.

## APPLICANT—REGISTRANT.

The words "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant.

## INFRINGEMENT.

The term "infringement" includes every wrongful or unauthorized use in commerce with foreign nations or among



1 the several States or with the Indian tribes, or the reproduc-  
 2 tion or imitation of any registered trade-mark affixed to  
 3 goods of substantially the same class as those described in  
 4 the registration.

5 IMITATION.

6 An “imitation” of a trade-mark is that which so far  
 7 resembles a genuine trade-mark as to be likely to induce the  
 8 belief that it is genuine, whether by the use of words or  
 9 letters similar in appearance or in sound, or by any sign,  
 10 device, or other means whatsoever.

11 AFFIXED.

12 A trade-mark is deemed to be “affixed” to an article of  
 13 merchandise when it is placed in any manner in or upon  
 14 either—

15 First. The article itself; or,

16 Second. A box, bale, barrel, bottle, case, cask, or other  
 17 vessel or package, or a cover, wrapper, stopper, brand, label,  
 18 or other thing, in, by, or with which the goods are packed,  
 19 inclosed, or otherwise prepared for sale or disposition.

20 KNOWINGLY.

21 The term “knowingly” imports a knowledge that the  
 22 facts exist which constitute the act or omission unlawful  
 23 and does not require knowledge of the unlawfulness of the act  
 24 or omission.



## 1 COUNTRY OF ORIGIN.

2 The words "country of origin" refer to the country in  
 3 which the trade-mark was first registered and of which the  
 4 applicant is a citizen or subject, or in which he has a bona  
 5 fide industrial or commercial establishment.

## 6 CONSTRUCTION.

7 SEC. 37. That the provisions of this Act, so far as they  
 8 are substantially the same as those of laws existing on De-  
 9 cember thirty-first, nineteen hundred and one, shall be con-  
 10 strued as a continuation of such laws, modified or amended  
 11 to the language employed in this Act and not as new enact-  
 12 ments; a reference in laws not repealed to provisions of law  
 13 incorporated into this Act and repealed shall be construed as  
 14 applying to the provisions so incorporated.

## 15 PENDING APPLICATIONS.

16 SEC. 38. That all applications for registration pending  
 17 when this Act shall take effect may be proceeded with there-  
 18 under subject to its requirements, and for such purpose the  
 19 applicant shall amend his application to conform to the pro-  
 20 visions of this Act.

21 REGISTRATIONS HERETOFORE MADE—ACT OF EIGHTEEN  
 22 HUNDRED AND SEVENTY.

23 SEC. 39. That all marks registered prior to the third  
 24 day of March, eighteen hundred and eighty-one, shall be



1 deemed abandoned unless application for registration thereof  
 2 as prescribed in this Act be made prior to the first day of May,  
 3 nineteen hundred and two, in default whereof the registrant  
 4 shall not thereafter be entitled to notice from the Commissioner  
 5 of Patents under section eleven.

6 ACT OF EIGHTEEN HUNDRED AND EIGHTY-ONE.

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

15 REGISTRATIONS IN HAWAII.

16 SEC. 40. That citizens of the Territory of Hawaii may  
 17 file applications for registration of marks under this Act with  
 18 the treasurer of the Territory of Hawaii, who shall transmit  
 19 the same to the Commissioner of Patents. The date of filing  
 20 of such applications in the United States Patent Office shall,  
 21 for the purposes of this Act, be deemed to be the same as  
 22 the date of filing with the treasurer of the Territory of  
 23 Hawaii.

24 In proceedings upon applications so filed the time al-



1 lowed within which an act may be done, a notice may be  
2 given, a document may be filed, or an appeal may be taken  
3 shall be double the time elsewhere provided in this Act.

4 INTERNATIONAL REGISTRATION OF TRADE-MARKS.

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

16 AMENDATORY AND REPEALING STATUTES.

17 SEC. 42. That no provision of this Act, or any part  
18 thereof, shall be deemed repealed, altered, or amended by the  
19 passage of any subsequent statute inconsistent therewith  
20 unless such statute shall explicitly refer thereto and directly  
21 repeal, alter, or amend this Act accordingly.

22 REPEAL.

23 SEC. 43. That the laws or parts thereof specified in  
24 the schedule hereto annexed and all other Acts and parts





1 of Acts inconsistent with the provisions of this Act are  
2 repealed.

### 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.
June 22, 1874.	LX	2	4937 to 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 to 84	16	210 to 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. 5, 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.
Aug. 27, 1894.	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.
July 24, 1897.	11	11	30	207	Foreign-made goods bearing domestic marks excluded. Reenactment of chapter 349, August 27, 1894.

3

#### WHEN ACT TO TAKE EFFECT.

4 SEC. 44. That this Act shall take effect January first,  
5 nineteen hundred and two. When construed in connection  
6 with other statutes, it must be deemed to have been enacted



1 on the day of , nineteen hundred and one, so  
2 that any statute enacted after that day is to have the same  
3 effect as if it had been enacted after this statute.

56TH CONGRESS, }  
2D SESSION.

**S. 5027.**

## **A BILL**

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

By Mr. PRITCHARD.

DECEMBER 5, 1900.—Read twice and referred to the Com-  
mittee on Patents.

