TRADE MARKS

TRADE NAMES

FOR THE BUSINESS MAN

MUNN & CO.
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FOREWORD

The purpose of this little book is to present, in the simplest manner, consistent with comprehensiveness, an interpretation of the Federal statutes concerning trade-mark registration and protection.

As the book is intended for business men, we have avoided legal phraseology as much as possible as well as long quotations from court decisions, except where the inclusion of such excerpts was found necessary to a clear understanding of the subject.

Our large trade-mark practice, extending over many years, has developed the conviction in our minds that a great deal of useless labor in devising trade-marks that cannot be registered—to say nothing of vexatious litigation over defective marks—might be obviated by some such publication as this.

We call the attention of those who are interested in trade-marks to the superior facilities of our trade-mark department for handling business of this character.

Our service includes not only registration of trade-marks, and general trade-mark practice before the Patent Office, but also registration of trade-marks in foreign countries and the registration of foreign-owned marks in the United States.

Among our trade-mark clients are many of the largest and most successful business enterprises in America.

MUNN & COMPANY

NEW YORK AND WASHINGTON

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CHAPTER I

The Trade-Mark as a Business Asset

IF you should find in your Santa Claus stocking, next Christmas, a gift for the exclusive right to use the word "Royal" as a name for baking powder, you would be eight million dollars richer than you were the day before.

It is said, on good authority, that the Royal Baking Powder Company considers its trade-mark worth just $1,600,000 a letter. This is, perhaps, the most valuable trade-mark in existence, though it is rivaled in value by "Kodak," "Uneeda," "Ivory" (as applied to soap), "Coca-Cola," the name "Gillette" used in connection with safety razors, and a half dozen others. Each of these trade-marks has become a national institution. To displace them in the public mind would require competition of unheard-of magnitude and energy.

The name "Coca-Cola" is worth at least five million dollars; the Gorham silver-ware mark two millions, at a fair estimate; the trade-marks of the National Biscuit Company, all of which touch the highest standard of distinctiveness, must be the largest asset of that concern; and the name "Kodak"—where would the Eastman Company's business go to if it should hand over the trade-mark "Kodak" to some other concern, and go on making the same goods under the name of Smith's Hand Cameras?



A FIVE-MILLION DOLLAR TRADE-MARK.

When the American Tobacco Company was recently dissolved into separate companies, under the order of the Supreme Court, the trade-marks of the combination were estimated to have a value of $45,000,000, out of total assets of $227,000,000.

The aggregate total value of well-known American trade-marks must be in the hundreds of millions of dollars. But any estimate of the value of a trade-mark, apart from the business to which it applies, is necessarily a mere guess, for a trade-mark is a species of commercial property that cannot be sold by itself. It is inseparably attached to the business from which it emanates, and cannot be transferred without a transfer of the business. There are cases where a concern's trade-mark has become so valuable, through long years of popularity and profit-making, that it entirely overshadows all other assets of the business—in short, the business could not exist without it.

A trade-mark is a symbol of Good-Will—using the words "Good-Will" in the same sense that the bookkeeper uses them. It stands for built-up reputation; it is the link that connects the

ultimate consumer with the manufacturer. It preserves the identity of merchandise, and, in carrying out this function, it is a device of inestimable value to the commercial world.

Sometimes a complex chain of events is best explained by a simple illustration. With this idea in mind, let us put ourselves in the place of a woman who wants a cake of Ivory Soap. She lives in a desert town in Arizona. She cannot go half across the continent to Cincinnati to buy a five-cent cake of soap from Procter & Gamble. In fact, it is a safe bet that she never heard of Procter & Gamble, but she knows that she wants Ivory Soap. So she sends her little girl down to the "general" store, and this lisping messenger asks for "Ivory" Soap—not just plain "soap"—and brings the familiar package with the name on it back to her mother. If the storekeeper sends some other kind of soap the owner of the nickel knows instantly that she did not get what she wanted.



THIS DESIGN OF DUCK AND CLOTHES-LINE IS THE TRADE MARK OF MANUFACTURED PRODUCTS OF THE PROCTER & GAMBLE COMPANY.

By means of the trade-mark "Ivory" the manufacturers in Cincinnati deal with this buyer in Arizona as surely and as expeditiously as if the lived across the street from their factory. Trace this transaction backward, and you will find its trail running unerringly through the retailer, the wholesaler, and the jobber to the manufacturer—and at every stage of its journey the product kept its personality. It left Cincinnati as Ivory Soap, and as Ivory Soap it was put into the consumer's hands.

Selling by trade-mark is one of the miracles of modern merchandising. Its development to a state of high efficiency has taken place during the last hundred years.

Competition is the basis of the modern industrial system. Plainly defined, a competitive system means a system under which every trader, large and small, must be prepared to justify his existence at any time.

In the early centuries of English industrial life, competition in the modern sense was unknown, as Townsend Warner points out in his "Landmarks of Industrial History." For centuries after the Norman conquest of England, all manufactured articles were produced by craftsmen—each master craftsman working in his tiny shop with two or three apprentices.

All craftsmen belonged to gilds, whose status and authority were recognized by the law of the time. These gilds fixed the prices of commodities—a price "fair to the seller and fair to the buyer." A craftsman could not push his trade beyond his own immediate locality, because in that event he would come in

conflict with his brother craftsmen. He made shoes, or harness, or wove rough woolen coats, and sold them to his neighbors at a price that was fair to him and fair to them, and in somnolent old age was gathered to his fathers, without having heard the word "competition" or its equivalent in burly Saxon-French.

With the decay of centuries, the gilds slowly passed away, and upon their ruins arose the modern factory system.

In the new adjustment of things, here and there a craftsman with more energy and a longer financial head than his fellows, began to extend his trade, and employ more journeymen and apprentices.

In 1550 John Winchcombe, "Jack of Newbury," a woolen weaver, had a hundred looms at work in his own house, and Winchcombe woolens were known as far as Antwerp. At the same time, London craftsmen were selling their goods all over England—or, at least, in the larger towns, and there was a growing trade with Flanders.



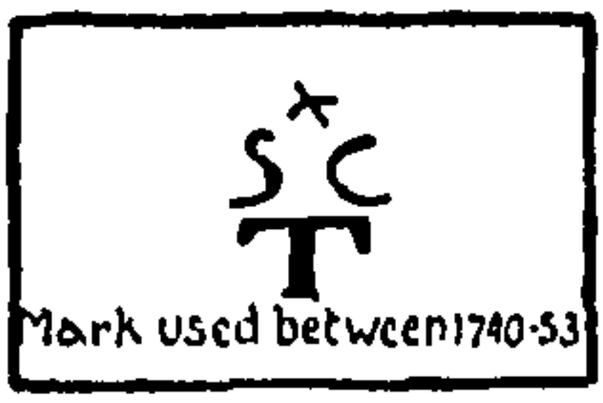
These manufacturers, as the circle of their trade expanded, began to see the desirability of marking their products in some way to identify them, so that purchasers at a distance would be able to distinguish them from similar articles produced by others.

Any device for identifying a commercial product is a trade-mark, in the broad significance of the term.

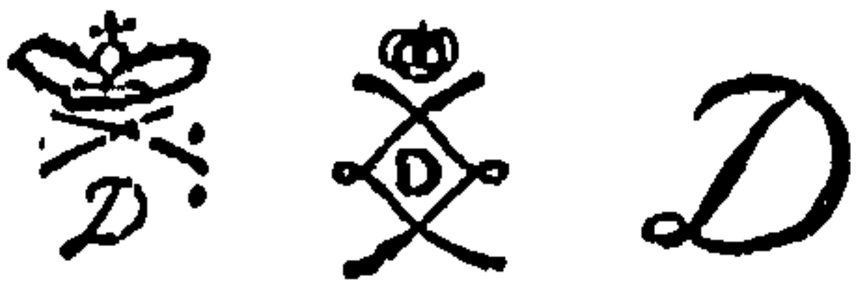
Some of the early trade-marks were rude initials and cryptic designs of interlaced crosses and circles. Others consisted of dragons and winged snakes, and various real and unreal animals.

The craftsmen of the fifteenth and sixteenth centuries were the first users of trade-marks in England.

The flickering torch of the antiquarian throws a dim light on some sort of trade-mark usage current among the Greeks and Romans, and even among more ancient trading peoples, but these researches hold but little of interest to us. Our present purpose is to consider the function of the trade-mark in modern business, and with that thought in mind, it may be taken as an established fact that trade-marks, in the modern sense, have a continuous history of perhaps five hundred years.


Mark used between 1740-53

In the early part of the seventeenth century the gold-beaters of Nuremberg were using trade-marks, and they had systematized their use to such an extent that an official register of gold-beaters' marks was kept and penalties for the misuse or counterfeiting of trade-marks had been established a law. This register has been preserved. Its yellowed pages are decorated with curious devices of serpents and dragons, doves and crosses. Without exception, the marks of the Nuremberg gold-beaters were picture marks.





TYPICAL PORCELAIN TRADE MARKS ORIGINATING ABOUT THE MIDDLE OF THE EIGHTEENTH CENTURY

In the early part of the eighteenth century the use of trade-marks was general, in certain lines of trade, throughout Europe. But the lack of specific legislation for the registration of trade-marks at that time—a lack that persisted until the nineteenth century—leads one to the conclusion that these eighteenth century traders did not attach great importance to the subject. They evidently considered the trade-mark a mere minor accessory of business.

The early decades of the nineteenth century witnessed the rise of three great forces which were destined to accomplish, in a short time the most profound changes in manufacturing and selling methods. These forces were:

1st. The application of steam power to manufacturing in a large and economical way.
2nd. The development of cheap and quick transportation.
3rd. The invention of means for the rapid dissemination of intelligence.

Factories, employing thousands of hands---great industrial monuments to Cheap Power—had inevitably to find distant markets for their products. No longer could the manufacturer sit at home and await the buyer. His product was too large, and its burden was too heavy to carry on a haphazard sales plan. Consequently, the selling departments of all enterprises grew tremendously in importance. Customers were sought across the breadth of a continent. Many a manufacturer's sales area grew, in the span of a generation, from a few hundred square miles to a region that included every degree of climate from the Arctic to the Torrid.

To accomplish this result efficient selling methods, and economical and fast transportation, were required.

As a natural consequence of these conditions trade-marks grew in importance. Manufacturers without trade-marks found that they had no hold on their trade. The consuming public did not know them or their products by name, and they were at the mercy of the jobber, the wholesaler and the retailer. They were supported by a chain of circumstances, of which every link was weak.

"WISHBONE"
Registered Trade Mark

TRADE-MARK FOR COAT HANGERS SHAPED SOMEWHAT LIKE A WISH-BONE

On the other hand, manufacturers whose trade-marks were firmly fixed in the public mind by reputation began to see that

they were, to a large degree, independent of the merchandising chain. The ultimate consumer knew their trade-marked products, and asked for them by name.

Thus, by a process of natural evolution, the trade-mark developed in importance from a workman's tool mark to a symbol of Good-Will—a business asset in a tangible form.

It is an axiom of legal philosophy that when a thing becomes valuable or desirable, legislation concerning its regulation and protection springs into being. Consequently one looks for, and finds, the beginning of specific legislation on the subject of trade-marks around the end of the first quarter of the nineteenth century.

B-B

(Trademark Reg. U. S. Pat. Off.)

THIS TRADE-MARK OF A BUSINESS MOP IS AN EXCELLENT EXAMPLE OF LETTERS USED AS A TRADE

Before the first trade-mark legislation, cases of infringement fell under the common law, and were decided in courts of equity.

H. D. Nims, a well-informed writer on trade-marks, says in his "Law of Trade-Marks and Unfair Trade":

> "It is rarely that one life sees the genesis and maturity of law, yet it has almost seen them of trade-mark law. In the eighteenth century there were a few scattered decisions which turned almost wholly on the question of fraud. With the rise and growth of machine-made merchandise in the earlier part of the last century, the matter of private marks of merchants to distinguish wares going out into the public markets of the world assumed importance and cases multiplied. Trade-mark law is one of the results of machinery. It is safe to say that the great mass of trade-mark and unfair-trade law is the development of the last forty years."

A structure, of which the foundation has been so recently laid, must necessarily be still unsettled. The rulings of both the Patent Office and the courts are, in many cases, contrary to precedent. In some instances, courts in different parts of the country have handed down contradictory decisions bearing on the same question. But, despite these drawbacks, a body of trade-mark law is being slowly formed, and it is only a question of time before our feet will be on firm ground.

Trade-mark cases should be entrusted to lawyers who have specialized in this branch of the law. The legal status of this subject is changing so swiftly that an ordinary lawyer, absorbed in general practice, cannot keep track of it.

A trade-mark has been defined as follows:

> "A trade-mark may be tersely defined to be any sign, mark, symbol, word or words which indicate the origin or ownership of an article as distinguished from its quality, and which others have not the equal right to employ for the same purpose. In its strictest sense, it is applicable only to a vendible article of merchandise to which it is affixed."
>
> (*Ball v. Broadway Bazaar, Court of Appeals, N. Y.*, 87 *N. E.* 674.)

We give this definition because it expresses in the fewest possible number of words the function and limitations of trade-

marks. Also, because there is in the minds of many business men, a confused notion of the difference between a trade-mark and a trade-name. By referring to the definition it will be noted that a trade-mark is "applicable *only to a vendible article of merchandise* to which it is affixed."

On the other hand, a trade-name applies to a business as a whole, although this business may be engaged in the sale of not one vendible article only, but a thousand. For instance, "Wanamaker's" is a trade-name and "Kodak" is a trade-mark.

A trade-mark has no value except that created by the quality, sale, popularity and profit in the article to which it is affixed. No matter how distinctive, or attractive a mark may be, it is worth but little if it is used in connection with an inferior article or with an article sold without profit.



A VERY SUGGESTIVE AND STRONG TRADE-MARK.

But a distinctive and suggestive trade-mark is of immense help in advertising and selling. Consider, for example, the trade-mark of Old Dutch Cleanser. It is full of *human interest*, *motion*, *life*, and *suggestion*. It brings up in the mind the mental picture of dirt fleeing from an energetic Dutch scouring woman. That this mark has been a powerful aid to sales is obvious. Suppose Old Dutch Cleanser had been called Climax Cleaning Powder. Can you imagine anybody acquiring more than the most languid interest in anything with a name so dull? It reminds one of hard and sordid toil.

CHAPTER II

The Federal Trade-Mark Law

THE function of a trade-mark is to denote origin. As we pointed out in the preceding chapter, the necessity for using trade-marks arose as soon as the expanding wave of trade carried a craftsman's goods to customers outside of his own community. The ancient trade-mark was a simple device invented for the purpose of enabling a maker of any commodity to hold his out-of-town customers, so to speak, by enabling them quickly and surely to identify his goods.

Throughout its history the trade-mark has remained true to its ancient antecedents, and its purpose to-day, as it was in the fifteenth century, is specifically to indicate the origin of an article of merchandise.

In this aspect of unchanging purpose, the trade-mark is somewhat an anomaly in commercial history. During the last four hundred years, methods of manufacture, distribution and sale have been revolutionized from top to bottom: banks, which began as mere money-changing offices, have become establishments for keeping and loaning funds; the retailer, who used to sit in a hole in the wall with a handful of goods, all of the same kind, has developed into a merchant selling ten thousand different articles; the craftsman, who once served a long apprenticeship, during which he learned to make every part of a shoe or a carriage, has become a specialized laborer, employed by the day to produce the extreme subdivision of a finished article.

It is strange that, in all this evolution of commercial methods, the trade-mark did not undergo a change in function. It might have become, by a gradual transformation, a merchant's mark, applied indiscriminately to all goods of every description sold by him. Or, it might have evolved into a stamp of merit or high quality, regulated by statute and licensed only to manufacturers who could prove their right to use it.

But none of these changes has taken place, and the trade-mark of the twentieth century has for the beginning and end of its function the purpose of indicating to buyers the association of merchandise with a particular manufacturer or dealer.

The present Federal Trade-Mark law went into effect on April 1, 1905.

The reader should understand clearly that the right to own a trade-mark is not a creation of the statute, for the use of trade-marks, and the recognized right of manufacturers to be protected in their use, far antedate any specific trade-mark legislation.

The intent of the statute is to systematize and codify trade-mark practice. It provides a definite procedure for the registration of trade-marks; lays down rules for validity in marks; puts trade-mark litigation, when registered trade-marks are the subject matter of the litigation, within the jurisdiction of the Federal Courts; and makes every trade-mark registered under the law a part of the public records of the nation. But a trade-mark may be legally sound even if not registered, just as a person may own real estate without recording the title.

The Act of 1905

The ownership of trade-marks, like any other property right, is recognized by the common law. The Supreme Court of the United States has said: "The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity with compensation for past infringements."



THE POMPEIAN WINDOW SCREEN TRADE MARK.

Trade-marks, under the Act of 1905, are registered in the United States Patent Office.

In case of litigation resulting over the right to use any trade-mark, evidence of the registration of the mark by one of the litigants puts the burden of proof upon the other. In other words, the user of the unregistered trade-mark must prove priority of use and ownership. This is often a very difficult thing to do, especially in the case of trade-marks that have been used a long time, for such proof must necessarily rest upon the production of old labels, packages of the goods with the trade-mark affixed, and the testimony of witnesses.

The owner of a registered trade-mark does not need any evidence other than the public records of the Patent Office to establish the date of his first use of the mark.

When a trade-mark is not registered in the Patent Office, litigation concerning it does not come under the jurisdiction of the Federal courts, unless the opposing parties are citizens of different states.

On the other hand, all cases pertaining to registered trade-marks fall within the field of Federal jurisdiction, irrespective of the amount in dispute or the place of residence of the parties. There is an obvious advantage in this, owing to the fact that an injunction secured in one Federal Court will be enforced in all such courts in any state.

The fee charged by the Patent Office, under the law, for registering a trade-mark is ten dollars. This does not include the attorney's fee, which must be paid by the applicant.

A certificate of registration remains in force for twenty years, and it may be renewed, upon expiration, for like periods of twenty years, upon payment of a renewal fee of ten dollars.

An individual or corporation has a right to register a trade-mark under the United States law if the trade-mark for which registration is sought belongs to the applicant and is used by him:

1st. In commerce among the several states:
2nd. Or, in commerce with foreign nations;
3rd. Or, in commerce with the Indian tribes:



A CELEBRATED UNDERWEAR TRADE MARK, COMPOSED OF THE WORDS "POROUS" AND "KNIT." THIS MARK SEEMS ALMOST DESCRIPTIVE, BUT IT DOES NOT "DESCRIBE THE GOODS" IT DESCRIBES THE KNITTING PROCESS ONLY.

provided the owner of the trade-mark resides within the territory of the United States (which includes all territory under United States control), or has a business establishment situated in United States territory, or resides in any foreign country which affords, by treaty, similar privileges to citizens of the United States.

Divested of legal verbiage, the main provisions of the Act, so far as the features governing registration are concerned, may be stated as follows:

A trade-mark is not registrable if it is:

A design or wording identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive qualities, or which so nearly resembles a registered or known trade-mark owned and used by another, and appropriated to merchandise of the same descriptive qualities, as to deceive purchasers, or to be likely to cause confusion in the mind of the public.

The insignia of the American National Red Cross Society.

The flag or coat of arms of any foreign nation.

Any design or picture which has been adopted by a fraternal society as its emblem.

A portrait of a living individual unless the application for registration is accompanied by the written consent of the individual whose portrait is used.

Scandalous or immoral matter of any description.

The flag, or coat of arms, of the United States, or of any state, or of any municipality, or any of the insignia thereof.

Any geographical name or term.

A misrepresentation of the quality, composition, character, origin, or nature of the commodity with which it is used.

Any mark which consists merely in the name of an individual, firm, corporation, or association, unless said name is written, printed, impressed or woven in some particular or distinctive manner, or is used in connection with a portrait of the individual.

Any arrangement of words or devices descriptive of the goods with which they are used, or of the character or quality of such goods. In other words, a trade-mark must not be an advertisement in the ordinary sense of the word.

A trade-mark is registrable if it is:

Unlike any other trade-mark, already in use, and applied to the same class of goods. It must not resemble the trade-mark of a competitor, or of a potential competitor, to such an extent that the buying public is likely to be deceived or confused by the resemblance.

The business name of a person or firm when written, printed, impressed or woven in some distinctive manner, or in association with a portrait, or in an autographic form.

Any trade-mark which has been in continuous and exclusive use by the applicant since February 21, 1905.

An arbitrary symbol, or word, or words, or a combination of a device and wording, not obviously descriptive of the commodity to which it is to be applied.

Used in lawful trade,

Of such a character that it may be affixed, printed upon, woven, sewed, branded or otherwise impressed upon the product with which it is used, or upon the package or container of the product.

The right to register trade-marks is limited to individuals and corporations.

Association trade-marks

Under the United States law an association cannot possess a trade-mark, as *exclusive ownership* and *specific origin* are essential attributes of validity.

The letters "A-A. L," meaning Anti-Adulteration League, were refused registration as a trade-mark for flour on the ground that the mark did not represent origin, but membership in an association. The applicant was a voluntary association of flour manufacturers. It was held that an association cannot be the "owner" of a trade-mark within the meaning of the statute.

Some states have enacted laws prohibiting the unauthorized use of the labels of trade-unions and similar associations. These laws are not trade-mark statutes. They are based on the broader principle of unfair business competition.

It is the general opinion, we believe, of trade-mark authorities that the lack of provision in our law for association trade-marks is a defect that should be remedied as soon as possible. It is a noteworthy fact that most of the other great nations recognize association marks.



THE IRISH NATIONAL TRADE-MARK.

An interesting example of an association trade-mark is that of the Irish Industrial Development Association (reproduced on this page). This association has a membership of about five hundred Irish manufacturers. Its use indicates that the merchandise to which it is affixed is of Irish manufacture; in other words, it is indicative of geographical origin. The Irish trade-mark

has been registered in Great Britain under the British Trade-Mark Act of 1905.



THE OMAHA TRADE-MARK, WHICH WAS CHOSEN FROM 701 DESIGNS SUBMITTED. THE DESIGNER RECEIVED A PRIZE OF $500. THIS MARK WILL BE REPRODUCED ON ALL STATIONERY OF OMAHA MANUFACTURERS AND WILL BE AFFIXED TO ALL OMAHA-MADE GOODS.

An American by the name of D. B. Barrett attempted to register this mark in the United States Patent Office under his own name. This fact came to the attention of the Irish Industrial Development Association, and some correspondence relating to the matter passed between Mr. John Redmond, the leader of the Irish National party in Parliament, and President Taft. As the law now stands this Irish trade-mark cannot obtain in the United States the protection that registration might give.

Within the last few years several American communities have adopted trade-marks, or labels. The Omaha trade-mark is reproduced here as an example of this class of marks.

There is a genuine need for an amendment to the law that would give this class of marks the right of registration.

The Ten Years' Clause

A provision of the Act of 1905 legalized all trade-marks that had been in exclusive use by the applicant for ten years prior to the passage of the act, and this provision applies even to trade-marks of ten years' standing that, because of their character, could not be registered under the act. The wording of the act dealing with this subject is as follows:

"Nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the trade-mark is derived, in commerce with foreign nations or among the several states, or with the Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act."



A TRADE-MARK REGISTERED UNDER THE TEN YEARS' CLAUSE

A manufacturer cannot register a trade-mark and file it away with the intention of using it at some future time. A condition of validity is that the mark must not only belong to the applicant, but must be "used by him in lawful trade." An intention to use a mark is not sufficient. The use in trade must antedate the application for registration. The letter of the law is complied with if a single package of the goods with the trade-mark affixed is sold in interstate or foreign commerce.

Classification of Merchandise

Those who intend to adopt trade-marks should keep in mind that the use of a trade-mark is limited strictly to one class of merchandise, which must be the class for which it has been registered.

For purposes of classification the Patent Office has separated all merchandise into forty-nine general classes, as follows:

1. Raw or partly prepared materials.
2. Receptacles.
3. Baggage, horse equipments, portfolios, and pocketbooks.
4. Abrasive, detergent, and polishing materials.
5. Adhesives.
6. Chemicals, medicines and pharmaceutical preparations.
7. Cordage.
8. Smokers' articles, not including tobacco products.
9. Explosives, firearms, equipments, and projectiles.
10. Fertilizers.
11. Inks and inking materials.
12. Construction materials.
13. Hardware and plumbing and steam-fitting supplies.
14. Metals and metal castings and forgings.
15. Oils and greases.
16. Paints and painters' materials.
17. Tobacco products.
18. Vehicles, not including engines.
19. Linoleum and oiled cloth.
20. Electrical apparatus, machines, and supplies
21. Games, toys, and sporting goods.
22. Cutlery, machinery, and tools, and parts thereof.
23. Laundry appliances and machines.
24. Locks and safes.
25. Measuring and scientific appliances.
26. Horological instruments.
27. Jewelry and precious-metal ware.
28. Brooms, brushes, and dusters.
29. Crockery, earthenware, and porcelain.
30. Filters and refrigerators.
31. Furniture and upholstery.
32. Glassware.
33. Heating, lighting, and ventilating apparatus, not including electrical apparatus.
34. Belting, hose, machinery packing, and non-metallic tires.
35. Musical instruments and supplies.
36. Paper and stationery.
37. Prints and publications.
38. Clothing.
39. Fancy goods, furnishings, and notions.
40. Canes, parasols, and umbrellas.
41. Knitted, netted, and textile fabrics.
42. Thread and yarn.
43. Dental, medical, and surgical appliances.
44. Beverages, non-alcoholic.
45. Foods and ingredients of foods.
46. Wines
47. Malt extracts and liquors.
48. Distilled alcoholic liquors.
49. Merchandise not otherwise classified.

(Note: Class 18 was abolished Feb. 24, 1909.)

An applicant for registration must specify not only the general class of merchandise in connection with which he intends to use his trade-mark, but must state also specifically the articles in that class upon which he has used the trade-mark he seeks to register.

For instance, a manufacturer who might apply for the registration of "Pendennis," as a trade-mark for smoking tobacco—to select a word at random—would find that it would not be satisfactory to the Patent Office to state in his application that the mark was being used in connection with Class 17—"Tobacco products." He would be required to state that his mark was being used on "smoking tobacco." After registration had been granted the Patent Office would not register another "Pendennis" trade-mark in that class of merchandise, to be used on cigars, for instance, for another applicant. Nor would the first registrant be obliged to apply for a new registration if he should desire to extend the use of his trade-mark to cigars, or chewing tobacco, or any



THE TRADE-MARK OF THE GENERAL ELECTRIC COMPANY. AN EXCELLENT USE OF INITIALS AS A TRADE-MARK.

other tobacco product. The law would protect him in the use of the mark for all articles of that class, but the rules of the Patent Office require applicants to give full particulars not only as to class of merchandise, but the specific articles on which the mark has been used.

A result of the principle of trade-mark practice which limits the use of a mark to one class of merchandise is to be seen in the same name being used as a registered mark for unrelated articles. The name "Pompeian," for instance, is used as a trade-mark for a face cream and also for wire netting for window screens; "Republic" is used for automobile tires as well as several other articles in different classes; "Packard" for pianos and automobiles; and there is an "Ideal" hair-brush and an "Ideal" fountain pen.

Registration involves obligation on the part of the registrant

The law directs that the owner of a registered trade-mark affix, print or impress upon such trade-mark wherever it is used, or in close enough proximity to it to be easily seen, the words, "Registered in U. S. Patent Office," or the shorter abbreviated form, viz., "Reg. U. S. Pat. Off." The trade-mark of Baker's Cocoa—the Baker chocolate girl—reproduced on this page, shows how this should be done.



Reg. U.S. Patent Office

If this notification is not used in connection with the trade-mark, the owner of the mark, in infringement proceedings against an unauthorized user, cannot collect damages unless he can prove that he gave the other party formal notice, and that the unauthorized use of the mark was continued after notice.

Affixation

A trade-mark is not merely an advertising symbol. It is an essential of trade-mark validity that the mark be affixed to the goods. A device, or word, or phrase, or picture that is used only in circulars, advertisements, or on signs or letter-heads is not a trade-mark and cannot be protected under the trade-mark laws. (It should be stated here that the unauthorized use of one other than the owner of such a device or wording may sometimes be prosecuted under the common law—the law of unfair business competition.)

A trade-mark may be printed, pasted, written, stamped, stenciled, branded, sewed, or woven upon the article with which it is used. In cases where it is not practicable to affix the mark upon the merchandise itself it must be affixed to the container.

Rules of the Patent Office

We have not the space here to go into a detailed description of the procedure of the Patent Office in considering trade-mark applications. This procedure, especially in cases where there is some doubt as to the validity of the mark, is highly complicated,

and can be followed successfully only by an attorney experienced in trade-mark practice.

The rules of the Patent Office require applications for registration of trade-marks to be made in a certain conventional form. A drawing of the mark, of a certain specified size, must be submitted with the application. Proofs of the mark, as actually used, must also be forwarded as exhibits in the case.

If, on preliminary examination, the mark appears to be entitled to registration, a reproduction of it is printed at least once in the Official Gazette of the Patent Office. This publication must be at least thirty days prior to the date of registration.

The purpose of the publication of the mark in the Official Gazette is to allow opposition from any one who thinks its registration would conflict with his rights. Opposing an application is technically called an "opposition." An opposition serves to delay registration until the examiner in charge of interferences considers the evidence submitted.



THE CELEBRATED TRADE-MARK OF THE VICTOR TALKING MACHINE.

Under certain conditions, rejected applications may, on appeal, be taken up to the Commissioner of Patents.

The number of rejected applications is very large. Under the law of 1905, the total number of applications up to May, 1912, was 62,500.

Number of Rejected Applications

The total number of registrations under the law is around 42,000. This means that more than 20,000 applications have been rejected in seven years. In other words, about two out of every three applications pass the gauntlet of Patent Office scrutiny, interference and opposition, and are registered.

Many of the defective applications fail because of a lack of competent advice in devising the proposed trade-marks, as well as because of inexperience in prosecuting the applications.

CHAPTER III

Analysis of the Requirements for Registration

IN the preceding chapter we traced an outline of the main provisions of the Act of 1905—the Trade-Mark Law. We intend to take up in this chapter each clause of the law applying to registration, and show how it works in actual practice.

Great care should be taken by an applicant for registration of a trade-mark, or his attorney, to avoid conflict with a trade-mark that is already registered or already in use (even if not registered), provided that it is applied to the same class of merchandise as that of the applicant. Lack of caution in this respect has caused interminable annoyance and litigation, with consequent financial loss.

A trade-mark will not be registered if *it is identical* in design or wording with a known *trade-mark* already in use by another and *applied to* goods of the same descriptive qualities, or if it resembles a known trade-mark so closely as to cause confusion

In considering the question of conflicting marks, the Patent Office and the Federal courts hold that the test of similarity is whether the marks are sufficiently alike in appearance or wording, or sound, *to mislead the* average individual.

The word "Autola" as a trade-mark for cigars was held not registrable owing to a prior registration of the word "Auto-do" for the same class of merchandise. In this instance, registration was refused on the basis of resemblance in sound as well as in appearance.

"Lady Lee" having been registered as a trade-mark for shoes, "Lady Like" was refused registration in the same class.

"Certosa" as a mark for a brand of flour sufficiently resembled "Ceresota"—already registered—to cause its rejection.

"Powellton" failed registration as a trade-mark for coal, on the ground that another company's coal already bore the registered mark "Powell's Run."

SNUGTEX

ONE OF THE INNUMERABLE WORDS ENDING IN "TEX." TRADE-MARK USED ON BELTS

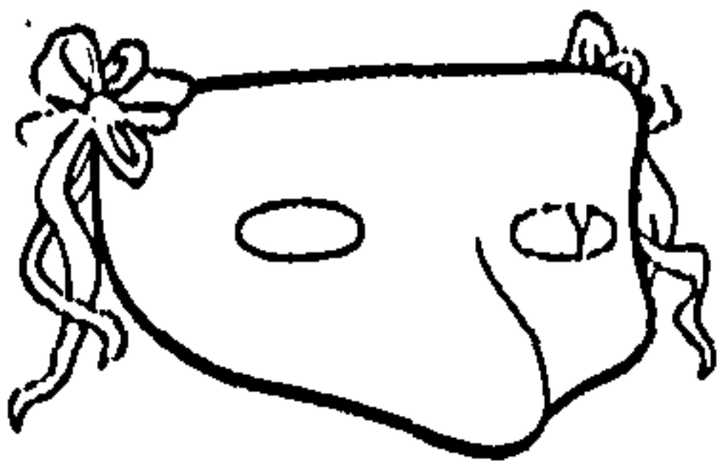
"Sodafoam" was considered close enough in resemblance to "Sea Foam" (already registered in the same class) to cause its rejection.

"Uno" having been registered as a trade-mark for a medicine, an application for the registration of "Ino" in the same class was refused.

Registration is refused a trade-mark when it consists of words describing a symbolic or pictorial device which has already been registered; or *vice versa*, when the wording has been registered first, registration for the symbol is refused. For

instance, the Patent Office has held that a trade-mark consisting of a conventional representation of a bouquet of flowers is identical in meaning with another mark consisting of the word "Bouquet," applied to the same class of merchandise. In either case, the goods would be called "Bouquet Brand."

Agreement among owners of conflicting marks is not recognized by the Patent Office. An interesting example of this occurred in the attempt to register the word "Nayassett." The word "Nassau" had already been registered for the same class of goods and the registration of "Nayassett" was refused on the ground of similarity. Soon afterward, the owner of the "Nayassett" mark made a new application, accompanied by the formal consent of the owners of the "Nassau" mark. The Commissioner of Patents held that the law did not provide for agreement between owners of conflicting marks, and the registration of "Nayassett" was refused accordingly.



THE TRADE-MARK OF CRYSTAL DOMINO SUGAR. NOTE THAT THE REGISTRATION OF A PICTORIAL REPRESENTATION OF A DOMINO, OR MASK, INCLUDES THE EXCLUSIVE USE OF THE WORD "DOMINO."

About two years ago a manufacturer in a Middle Western city became interested in a new metal polish and decided to put it on the market. After long consultation with advertising men and salesmen, a name was selected. This name was suggestive and short, with a snap to it, that made it stand out in the memory. Many thousands of labels were ordered and packages of the article were given to the traveling salesmen of the concern to be used in getting orders from retailers. Booklets and literature had been written and mailed, and the business was beginning to take shape, when, to the surprise of the manufacturer and his associates, his application for trade-mark registration was rejected by the Patent Office for the reason that the mark had already been registered. Then followed a hasty trip to a trade-mark attorney and a search of the Patent Office records was made. Investigation of the register showed that the same name had been registered by an Eastern concern for a metal polish some years ago. About this time a letter arrived from the attorney of the Eastern firm, with a statement to the effect that the owner of the trade-mark considered this unauthorized use of the mark an infringement and intended to take legal action in the matter. A month or two was spent in trying to make some arrangement with the Eastern concern, with the final result that the trade-mark had to be dropped, and something new devised.

In this case a full year was lost, and a considerable amount of money was wasted, by reason of the failure of this manufacturer to have a search made of the Patent Office records. He made the mistake of considering the matter of trade-mark registration a small detail, and trying to attend to it himself. A competent attorney would have saved his fee a thousand times over in this case.

This prohibition is not covered by the trade-mark law, but is one of the provisions of the Act of Congress incorporating the American National Red Cross (approved Jan. 5, 1905). The act of incorporation states that it shall not be lawful for any person or corporation to use in trade, or for purpose of advertisement, "the sign of the Red Cross" or "any insignia colored in imitation thereof," *unless such person or corporation was entitled to the use of such insignia at the time of the passage of the act.*

A trade-mark consisting of the insignia of the American National Red Cross is not registrable

This exception, which was intended to safeguard the interests of those who had long used the Red Cross sign as a trade-mark, covers the Red Cross mark of the well known druggists' specialty house of Johnson & Johnson, the Red Cross labels used on a brand of shoes made by Krohn, Fechheimer & Company of Cincinnati, the Red Cross mattress manufactured by a Boston concern, and a few other users of this device.

TEXACO
MOTOR OIL

ANOTHER EXAMPLE OF A TRADE-MARK ENDING IN "O." THIS IS A COINED WORD, MADE FROM "TEXAS" AND "COMPANY."

The law, as it stands, is rigidly enforced in regard to all new trade-marks containing Red Cross devices.

An unusual argument was made the basis of an application for registration of a label for a cough syrup, on which the emblem of the Red Cross was printed, accompanied by the words "Red Cross." When registration was refused, the applicant sought to amend the label by striking out the Red Cross emblem, while leaving the words intact. He argued that the Red Cross incorporation act prohibited only the use of the "sign of the Red Cross" and not the words. The application was rejected on the ground that it was an attempt to evade the spirit of the law.

A trade-mark is essentially an exclusive possession. When it ceases to be exclusive, it ceases to be a trade-mark, in the true sense. It is apparent, therefore, that an ordinary word, descriptive of the goods with which it is used, cannot be set aside as the exclusive property of any manufacturer, to the detriment of others producing merchandise of the same character. The wording of the law on this point is clear, and the Patent Office is strict in its interpretation. But despite this condition, many applications, destined to be rejected, are made every year for the registration of descriptive marks. We give here a few examples of trade-marks, refused registration on the ground of being descriptive.

Trade-marks that are descriptive of the goods with which they are used, or of the quality or character of the goods, are not registrable

The word "Kantleek" was refused registration as a trade-mark for a hot-water bag. The Patent Office examiner held that the word was composed of "Can't" (misspelled "Kant") and "Leak" (misspelled "Leek"), and that it was intended to convey the idea that this particular bottle could not leak. The

attorney for the applicant presented an argument to the effect that the word was composed of two German words, "Kant" and "Leek," that had meanings quite different from the English words with the same sound. This contention was too subtle for the Patent Office to grasp, and registration was refused.

RUBEROID
(Trade Mark Reg. U.S. Pat. Office)

ALTHOUGH THIS MARK HAS BEEN REGISTERED IT HAS BEEN DECLARED A DESCRIPTIVE WORD BY A FEDERAL COURT, AND THEREFORE NOT PROTECTABLE.

The word "Naphtha," used as a name for a soap with naphtha as an ingredient, was held to be descriptive, and therefore not registrable as a trade-mark, to the exclusion of the goods of other manufacturers, although the owner had advertised it extensively.

"Mello" as a mark for chewing-gum was considered descriptive, being simply a misspelling of the word "mellow."

Many applicants for trade-mark registration seem to think that the mere misspelling of a descriptive word, or some fanciful device in lettering, will remove the word from the descriptive class. This is a belief that has no basis in fact, for no matter how a word is spelled or lettered, it is descriptive if it conveys information of a descriptive character.

For instance, the word "Bestok" was rejected as a misspelling of "Best Stock"; "Unxld" as a misspelling of "Unexcelled"; "Kid Nee Kure" as a misspelling of "Kidney Cure"; and "Pittsburgh Pump," printed with hyphens between the letters—P-I-T-T-S-B-U-R-G-H P-U-M-P—was refused registration as being both descriptive and geographical.

The courts have held that the word "Elastic," used to designate drawers having an elastic seam, is descriptive, but the same word is used in a fanciful sense and is valid as a trade-mark when applied to sectional bookcases.

"Youngfellow" Reg. U.S. Pat. Off. Clothes

A CLOTHING TRADE-MARK. THE MISSPELLING OF THE PHRASE "YOUNG FELLOW" DOES NOT INCREASE ITS VALUE AS A TRADE-MARK ITS ELIGIBILITY FOR REGISTRATION WOULD BE THE SAME IF IT WERE CORRECTLY SPELLED AND PRINTED IN ORDINARY TYPE.

A manufacturer of hooks and eyes applied for registration of the phrase "Rust? Never!" as a trade-mark. Registration was refused, as the mark was held to be descriptive, indicating that the hooks and eyes would never rust.

Arbitrary numbers are obviously registrable as trade-marks, but the applicant must be prepared to establish his contention that the numbers are really arbitrary and meaningless. In certain trades numbers are used to designate grades of a product common to the trade, and, in that case, the grade numbers are descriptive by common usage. A plow manufacturer applied for registration of the symbols "A No. 1," "No. 1" and "A X No. 1," as trade-marks for plows. It was shown, upon

examination, that these symbols are used by many plow makers to designate grades, and they were, therefore, ordinary descriptive trade terms. Registration was refused.

The prohibition against trade-marks descriptive of the character or quality of the product applies with equal force to trade-marks descriptive of the container or package. A flour manufacturer put up his product in barrels of a distinctive character—white and dark staves alternating. He applied for registration of a mark consisting of a pictorial representation of the striped barrel. This mark was considered descriptive, and registration was refused.

A Philadelphia candy manufacturer applied for registration of the word "Fussy," as used in the phrase "A fussy package for fastidious folk." The Patent Office held that the word "fussy," as used in the phrase, was merely a descriptive term—an adjective qualifying "package"—and registration was accordingly refused.

The word "Spearmint," being a descriptive word, was refused registration as a trade-mark for Wrigley's Spearmint chewing gum, but the representation of a spear was considered registrable.

Various applicants have sought registration for trade-marks that, while they are meaningless to English-speaking people, are really descriptive terms taken from foreign languages. Such words are not registrable, for the Patent Office makes no distinction between languages.

The phrase "Lait de Violettes," meaning in French "Milk of Violets," was rejected as a mark for perfumery.



IT IS NOT GENERALLY KNOWN THAT THIS IS AN ARBITRARY WORD, REGISTERED AS A TRADE-MARK.

"Elegancia," the Spanish equivalent of the English word "Elegant," was refused registration as a trade-mark for cigars.

A descriptive word in a language as little known as Esperanto is nevertheless unregistrable. "Saniga" means "Sanitary" in Esperanto, and it has been accordingly refused registration on the ground of being a descriptive term.

In considering the question of descriptive marks, the difference between *description* and *suggestion* should not be overlooked. Suggestiveness is a highly desirable quality in a trade-mark, and many excellent and legally valid marks are suggestive.



A WELL-KNOWN TRADE-MARK. ANOTHER EXAMPLE OF THE LARGE NUMBERS OF MARKS CONSISTING OF WORDS ENDING IN "O"

The name "Hydegrade," a registered trade-mark, applied to a well-known fabric, is suggestive of high quality, but it is not descriptive. It is a coined word, composed of the elements "Hyde" (name of owner) and "Grade."

Another example of an excellent suggestive mark is "Rubdry" applied to towels.

Pictorial marks are often highly suggestive without being descriptive. The Baker Chocolate girl, depicted in the act of serving a cup of cocoa, suggests *daintiness*, *taste*, *beverage*, *quickness in serving*, and *refreshment*.

The word "Ideal," used in connection with a fountain pen, is considered fanciful, and not descriptive. It would seem that a very fine distinction is made here, as this word is an ordinary descriptive word, commonly used to express a state of perfection, as in the expression "An ideal day." It may be said, on the other hand, that nothing ever reaches an ideal condition, and, in that sense, the mark may be considered fanciful.

A geographical name or term is not registrable as a trade-mark

Geographical names, like descriptive terms, are the common property of all who use the language. No one manufacturer can appropriate such a term for his own exclusive use as a trade-mark unless he uses it in an arbitrary or fanciful sense. The only exceptions to this principle are to be found in the case of manufacturers who have adopted geographical terms as their trade-marks and have used them so long, without opposition or protest, that they have acquired a common law right to their exclusive use.

Among the geographical marks rejected by the Patent Office are the following:

"Yale," applied to hosiery; "Cloverdale," for canned fruits and vegetables; "Red River Special" as a mark for agricultural implements; and "Aurora," on shoes—the name "Aurora" being applied to localities in at least twenty states of the Union.



It would seem in the light of common-sense, that in the last-named case (that of "Aurora") the ruling of the Patent Office is on a very narrow basis indeed. The word "Aurora" has no geographical significance to the average person. It calls up a mental image of the dawn. If this case, and some others like it, are considered valid precedents, every applicant for trade-mark registration must be prepared to submit his application to the stern criticism of the Post Office Directory, with its catalogue of fifty thousand or more names. (It is interesting to observe that, in a later case, the Patent Office allowed the registration of "Aurora" as a trade-mark for oils, lard, syrup and honey. *Aspegren & Co., ex parte*, 100 *Official Gazette*, 684.)

"Tabasco" was refused registration as a mark for a sauce on the ground that it is a geographical term, Tabasco being the name of a state in Mexico.

"French" was rejected as a trade-mark for paint. On the other hand, "Celtic" has been registered as a trade-mark for tea

The word "Celtic" has reference to a race, of which the Irish are only one branch. It is not applied to any particular country or section of the globe.

The map of the United States has been refused registration as a trade-mark for sugar.

"American Lady" was refused registration on the ground that the word "American" is geographical.

When a geographical term, applied to merchandise, is used in a fanciful or arbitrary sense—that is, when it conveys no deception in regard to the origin of the merchandise—it may be registered as a valid trade-mark.

"Dublin" is a valid trade-mark for soap, although the soap is made in America. In the case concerning this mark it was shown that it is the practice of soap manufacturers to call their products "Limerick," "Scotch," "Irish," etc., and that the buying public is aware of the fanciful use of these names and is not deceived thereby.



THE TRADE MARK OF THE NEW ENGLAND CONFECTIONERY COMPANY. THIS IS A COINED WORD, MADE UP FROM THE FIRST LETTERS OF EACH WORD IN THE CONCERN'S NAME.

"Vienna," applied to bread, is considered valid. No one expects bread made in Vienna to be sold in America, consequently no one is deceived by this fanciful use of the word.

"Gibraltar" is registered as a trade-mark for belting. It is true that Gibraltar is a geographical name, but its suggestiveness in regard to belting conveys the mental picture of strength, rather than the idea of origin.

The student of trade-mark conditions, having learned how rigorously the Patent Office interprets the section of the law applying to the registration of geographical terms, will perhaps be puzzled by the number of trade-marks of this class which seem to be valid and well-established.

The explanation of that is that many geographical names, which could not have been protected *ab origine* as trade-marks, have acquired a secondary meaning by long and exclusive use by a particular manufacturer. Such marks fall within the protection of the common law.



A GEOGRAPHICAL NAME REGISTERED AS A TRADE-MARK FOR FISHING-TACKLE.

Some of these common law marks are registered under the ten years' clause.

Among well-known geographical trade-marks may be mentioned "Bristol" applied to fishing-rods; "Kalamazoo" applied to stoves; "Manhattan," the name of a brand of shirts; and "Elgin," "Waltham," and "Illinois," the names of watches.

The U. S. Sanitary Manufacturing Co. was refused registration for a trade-mark consisting of the letters "U.S." with a background of a shield similar to that of the conventional United States shield.

A trade-mark must not consist of the flag or coat of arms or other insignia of the United States, or of any state, or municipality, or any simulation thereof

The coat of arms of the United States is not registrable as a trade-mark even under the ten years' clause. It has been held that its use in that connection is opposed to public policy. (*American Glue Company, ex parte*, 120 *Official Gazette*, 324.)

The registration of the coat of arms of the state of Maryland was refused registration, application having been made under the ten years' clause.

In another case, registration of a simulation of the shield of the United States, with alternate red and white stripes, was refused registration.

A trade-mark which consists merely of the name of an individual, firm or corporation can be registered only on certain conditions

It would seem at first consideration that if the object of using a trade-mark is to indicate the origin of a commodity, the most effective mark would be simply the maker's name—"James Brown" for goods made by James Brown, and "William Jones" for goods made by William Jones.

This logic would be indisputable if there were a different family name for every individual. But names are limited in number—there are eleven pages of Smiths in the New York City Directory—and every man has a natural and inalienable right to use his own name. It is obvious that a family name lacks the exclusiveness that is an essential quality of a legitimate trade-mark.

But a personal name may be written, or printed, or stamped in such a way that the peculiarities of writing, or printing, or design, may dominate the name and be the most conspicuous feature of the combination.



THIS TRADE-MARK OF A JELLY POWDER IS A COINED WORD, MADE BY SPELLING THE PROPRIETOR'S NAME "HANSEN" BACKWARDS

The trade-mark Act provides that "no mark (shall be registered) which consists merely in the name of an individual, firm, corporation, or association, not written, impressed or woven in some particular or distinctive manner, or in association with a portrait of the individual." In this clause the framers of the Act have endeavored to put a logical restriction on the injudicious use of personal names as trade-marks and the endless litigation that has always resulted from this practice.



WITHIN THE MEANING OF THE STATUTE THIS WAY OF PRESENTING THE NAME "GILLETTE" IS CONSIDERED DISTINCTIVE. NOTE THAT THE DEVICE DOMINATES THE NAME, AND PUTS IT INTO A POSITION OF RELATIVELY SECONDARY IMPORTANCE.

The names of historical personages (not living) may be registered as trade-marks, but the name of a living person cannot be used without his consent.

The phrase "Gibson Girl" as a mark for shoes was refused registration, as the word "Gibson" obviously referred to Charles Dana Gibson, a living artist.

In case of the registration of names of individuals, firms or corporations the restriction of the law that the name must be shown in some "particular or distinctive manner" has been interpreted to mean a presentation of the name in such a form that the peculiarities of lettering, or writing, or of an accompanying device are so pronounced that they dominate the name and throw it into a position of secondary importance. The meaning of this clause is best shown by means of examples of proper names, registered and used as trade-marks. A number of trade-marks of this character may be found in this book.

Many portraits of living persons are used as trade-marks—notable among them being the face of W. L. Douglas, shoe manufacturer; and the portrait of Thomas A. Edison, used in connection with his facsimile signature, as a trade-mark for Edison phonographs.

A portrait of a living individual is not registrable as a trade-mark unless the application is accompanied by the written consent of the person whose portrait is used

Among historical characters the picture and signature of Robert Burns, the poet, are combined in a trade-mark for cigars; the face of Benjamin Franklin is used as a trade-mark for the Saturday Evening Post, and will be found printed on the editorial page of each issue; Bismarck is a name for collars; Napoleon is used in connection with a brand of flour; and "Bob" Ingersoll is the trade-mark of a cigar.



REG. U. S. PAT. OFF.

THIS PORTRAIT OF BENJAMIN FRANKLIN IS THE TRADE-MARK OF THE SATURDAY EVENING POST.

It is a definite principle of the common law that fraud vitiates any transaction that it touches. A trade-mark that is deceptive and misleading cannot be protected, no matter if its registration should be accomplished.

"Knights of Labor" was refused registration as a trade-mark for whiskey, as the evident intent of the mark was to mislead purchasers into a belief that the whiskey was produced by the Knights of Labor, a labor organization.

A trade-mark is not registrable if it conveys in any way a misrepresentation of the article

A similar case is exhibited in the attempt to register the name "Masonic" as a mark for cigars. Registration was refused.

The name "Malt Myrrh" was refused registration as a trade-mark for malt liquors when it was shown that the liquors did not contain myrrh.

The name "Old Country Soap," used in connection with soap in such a way as to lead purchasers to believe that the soap was manufactured in Europe, was held by the court in the case of *Wrisley v. Iowa Soap Company* to be deceptive, and protection against infringement was refused.

A false representation on a trade-mark to the effect that the article is patented when it is not, is sufficient to vitiate the trade-mark.

A trade-mark registration does not protect when it is used on an article different in character, or composition, or origin, from that for which it was registered. This principle is very important. A manufacturer cannot do as he pleases with his trade-mark without regard to the rights of the public. If the article for which it was registered is changed essentially in composition, or in purpose, the trade mark ceases to be of value. Trade-marks under the United States law are always *specific and associated with a certain definite article*, and not with the proprietor's general business.



AN AUTOMOBILE TRADE-MARK.

In Great Britain and Canada there are *general trade-marks*, which a manufacturer may use on any article he makes, no matter to what diverse classes these articles belong.

A trade-mark which is technically a valid mark, will be refused registration if, in the opinion of the Patent Office, its registration would be opposed to public policy. A few examples will show what we mean. The phrase "Ask the Revenue Officer" was rejected as a mark for whiskey. The Patent Office held that this mark, appearing on bottles or barrels, would lead the public to believe that the contents had the indorsement of officers of the government.

A trade-mark is not registrable if its registration would be against public policy

For a similar reason the word "Government" was refused registration as a mark for loose-leaf binders.

The name of a living Ex-President cannot be registered without his written consent (as in the case of any other living person), and the name of an Ex-President, not living, cannot be registered at all. The use of the name of an Ex-President as a trade-mark is not considered consonant with the high dignity of the Presidential office.

Several applications have been made within the last few years for registration of the names or portraits of Ex-Presidents.

The signature and portrait of Thomas Jefferson, combined in a trade-mark for cigars, was refused registration.

The words "Roosevelt Rose" were rejected on application for registration, the rejection being partly because "Rose" had been registered on a previous application, and partly because Roosevelt is a living person.

A trade-mark cannot be a color, because the number of colors is limited, and it would be manifestly unfair to give the exclusive use of a color to any individual.

Other Restrictions

The use of the flag or coat of arms of any foreign power is prohibited as a trade-mark. This restriction holds even when the foreign power agrees to the use of its insignia. The

Russian government consented to the use of its coat of arms as a trade-mark in the case of an applicant before the United States Patent Office, but registration was refused. The law is mandatory, and is not affected by agreement.

Any design or picture which has been adopted by a fraternal society as its emblem is not registrable as a trade-mark.

For obvious reasons, scandalous or immoral matter is refused registration.

A trade-mark cannot be a shape, or a package, or a container.



A trade-mark cannot be the article of merchandise itself, for the "mark" must necessarily be different from the thing marked.

Proposed Amendment to the Law

As this book goes to press, an amendment to the Act of 1905 is before Congress. This amendment, which will, in all probability, become a law, denies the right of anyone to register as a trade-mark any mark which consists of "any name, distinguishing mark, character, emblem, colors, flag or banner, adopted by any institution, organization, club or society which was incorporated in any state in the United States prior to the date of the adoption and use by the applicant."

This proposed addition to the law is the result of an attempt of certain manufacturers to capitalize the prestige of various well-known clubs and other organizations. A case in point was a recent attempt to register the initials "Y.M.C.A." as a trade-mark. Another flagrant case was the adoption of the emblem of the New York Athletic Club—a winged foot—as a trade-mark by a manufacturer of men's clothing. On formal protest by the New York Athletic Club the registration of this mark was held up.

The Trade-Mark Status of Patented Articles

A patent may be defined as an exclusive monoply in the manufacture and sale of a new and useful invention, granted by law for a term of years to the inventor.

As an offset to this monoply, which is granted to the inventor as his reward from the public, the inventor's exclusive right ceases at the expiration of the patent, and any one may manufacture and sell the invention.

It would be manifestly unfair to the public if the owner of the patent could, at its expiration—still retain the exclusive right to use the name and trade-mark under which the invention had been sold. If this were permitted, the effect would be a partial continuance of the monopoly. The name and the trade-mark belong to the article—not to the individual—and the right to use them goes with the right to manufacture the article.

The Singer Manufacturing Company, when the patents on its sewing machine were about to expire, adopted as a trade-mark the word "Singer" blended with a device. The effect of this action, if the validity of the trade-mark had been sustained, would have been to perpetuate the right to the exclusive use of the word "Singer" as applied to sewing machines. In this event, at the expiration of the patents, any person would have the right to manufacture Singer machines, but only the Singer Manufacturing Company would have had the use of the name "Singer."

JAPALAC

A COINED WORD, MADE FROM THE WORDS "JAPAN" AND "LACQUER."

It was held by the courts that the right to use the name "Singer," as applied to machines of this particular design, became public property when the patents expired. The court said, in the case of *Brill v. Singer Mfg. Co.* (41 Ohio St.):

"A patentee or his assignee, by incorporating into his trade-mark the distinctive name by which a patented machine has become known to the public during the existence of the patent, cannot, after the expiration of the patent, take away from the public the right of using such name. The trade-mark cannot be made a guise for extending the monopoly, or preventing the name from becoming, with the patent, the property of the public."

The Singer case is typical of cases of this character. In the case of *Dover Stamping Co. v. Fellows* (163 *Mass.* 191, 194, 196) the court said:

"When one who has a patented article gives to it and puts upon it a name, and calls it by that name and no other, and it becomes known to the trade and to the public exclusively by the name so given to it by the patentee or person controlling the patent, then certainly it may be said that, as a general rule, the right to the exclusive use of the name ceases with the termination of the exclusive right to make and sell the thing."

CHAPTER IV

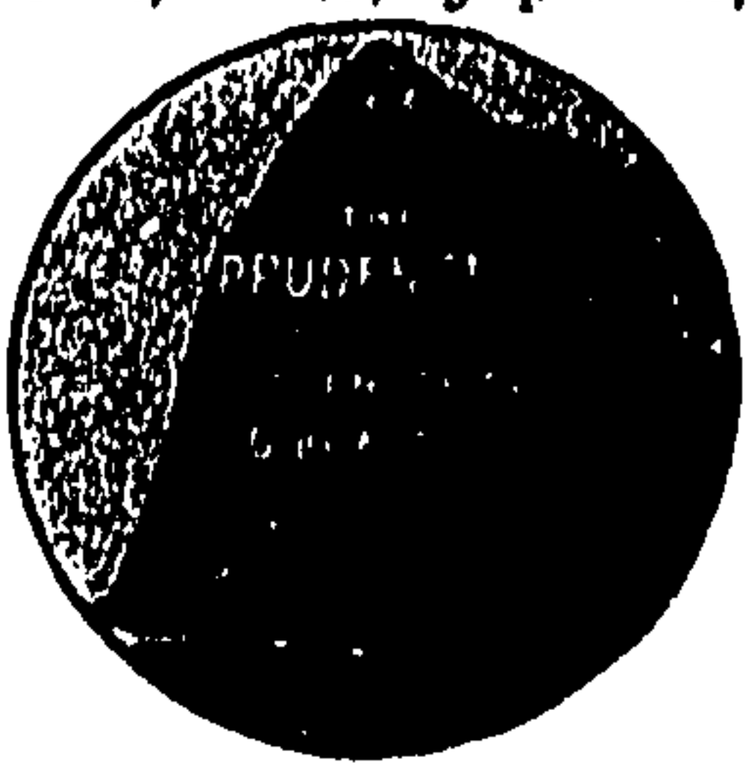
The Elements of a Good Trade-Mark

THE reader who has perused the preceding pages devoted to a discussion of what a trade-mark cannot be, begins to wonder, perhaps, what part of the language is left unrestricted.

It is true that the number of restrictions imposed by the law and the courts is considerable, but the language is virtually inexhaustible, with its infinite possible combinations of letters and words. And to these possibilities of construction must be added the limitless varieties of designs and symbols which are registrable and valid under the law.

A trade-mark may be:

A coined word, like Calox, Coca-Cola, Omo, Jap-a-lac, Criseo, Pebeco, Celluloid, Plexo (a trade-mark for suspenders; also for a toilet preparation), Sapolio, Cravenette, Jell-O, Kodak, Uneeda, Pro-phy-lac-tic, Crex and Quixo.



A symbol, like the Baker chocolate girl; the Prudential Insurance Company's trade-mark, which consists of a picture of the Rock of Gibraltar; the Merrimack duckling; the spear of Spearmint chewing gum; the Puritan painter, used on Bay State brick and cement coating; the Ford automobile mark, consisting of a winged pyramid; or the representation of a mask or domino, used on packages of Crystal Domino sugar; or the painter boy of the National Lead Company.

A combination of a word, or words, and a symbol, like Thomas A. Edison's portrait and signature, used in connection with phonographs; a picture of a black cat and the words "Black Cat," used as a hosiery trade-mark; the trade-mark of the Vacuum Oil Company, consisting of a picture of a gargoyle in connection with the word "Gargoyle"; or a representation of a swan accompanied by the word "Swan," used on fountain pens.



A TRADE MARK OF THE VACUUM OIL COMPANY

A portrait, like Mennen's Talcum Powder mark, which is a picture of Gerhard Mennen; or the portrait of Robert Burns, used on cigars.

A word, or words, used in a fanciful (non-descriptive) sense, like "Cat's Paw," a trade-mark for rubber heels; "Bachelor's Friend," a suggestive trade-mark for hosiery; the word "Ribbon," a mark for a tooth-paste; "Republic," used on automobile tires; "Velvet," a trade-mark for smoking tobacco; "Onyx," the trade-mark of a well-known brand of hosiery; "Ivory," which stands for a famous brand of soap; "Diamond," a name for tires; "Arrow," used on collars; "Blue-Jay," a trade-mark for a corn-plaster; "Big Ben," used on alarm clocks; "Lifebuoy," the name of a soap; or "Occident," the name of a flour.

A historical or mythological character, like Juno, King William, Stonewall Jackson, Cupid, Venus (there is a lead pencil carrying this trade-mark), Samson (applied suggestively to a brand of rope), or Apollo (the name of a piano-player).



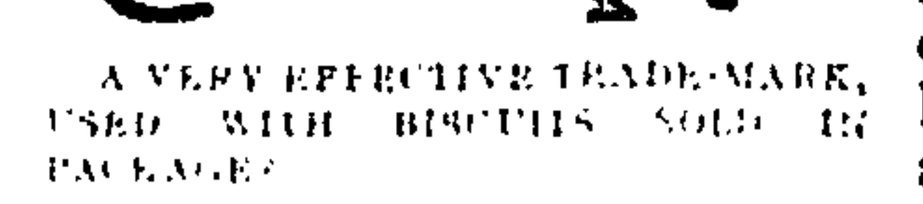
THE TRADE-MARK USED ON HEISEY'S GLASSWARE

Initials or arbitrary numbers, like the "G.E." trade-mark of the General Electric Company; the number "4711," applied to perfumery and toilet articles; "61," a floor varnish; "E-Z," the suggestive trade-mark of jar used in preserving fruits; "O.K.," the name of a clip to hold papers together; "B.V.D.," the trade-mark of a well-known line of underwear; or the big "H" enclosed in a diamond-shaped design, used as a trade-mark on Heisey's glassware.

The business name of person, firm or corporation when written, printed, impressed or woven in a distinctive manner, or in association with a portrait, or in an autographic form. An example of this type of trade-mark is the word "Cross," reproduced here. The name "Gillette," used on safety razors, is enclosed in a diamond and crossed by an arrow. A well-known trade-mark of this character is the name "Stewart Hartshorn," found on most shade-rollers.



Marks that may be technically defective are registrable under the ten years' clause if they have been in exclusive use by the applicant for ten years preceding 1905. The word "Faultless," registered by E. Rosenfeld & Company, of Baltimore, as a trade-mark for garments, belongs to this class. "Faultless" is, of course, descriptive, but it is nevertheless registrable under the ten years' clause. Another mark of the same kind consists of the word "Coward"—a trade-mark for shoes. Coward is the proprietor, and under the Act of 1905 his name has no eligibility as a trade-mark unless it is written or printed in a distinctive manner. But his name has been used as a trade-mark since 1868, and, consequently, falls within the provisions of the ten years' clause.



A VERY EFFECTIVE TRADE-MARK, USED WITH BISCUITS SOLD IN PACKAGES

It is easy enough to devise a trade-mark that will comply with the letter and the spirit of the law. But a trade-mark should be something more than merely registrable and protectable. Think of the immense advertising and selling effort that must be brought to bear to overcome the inertia of a meaningless or unsuitable trade-mark.

The Nine Tests of a Desirable Trade-Mark

A proposed trade-mark should not be adopted until every one of the following questions can be answered affirmatively in regard to it:

1. Is it easy to speak?
2. Is it easy to remember?
3. Is it easy to spell?
4. Is it simple in design?
5. Is it attractive in sound and appearance?
6. Is it suggestive of the good qualities of the merchandise?
7. Is it different from other trade-marks of the same class?
8. Can it be affixed to the goods with which it is to be used?
9. Is it registrable and protectable?

Competent trade-mark experts, such as those on the staff of Munn & Company, never submit a proposed trade-mark until it passes this rigorous examination successfully.

Few trade-marks in commercial use can stand these tests, because most marks have been designed without any clear perspective of the part they were to play in business.

As a matter of interest and instruction, let us take several well-known trade-marks, at random, and put them through the list of test questions.

Opening a current magazine, the first trade-mark we see is "Postum," the name of a substitute for coffee. Postum is easy to say and remember and spell. It is simple, but not particularly attractive in sound. It has no suggestiveness, except the artificial suggestiveness of familiarity. It is distinctive, registrable, and is virtually infringement-proof. If the figure 100 should be set down as denoting a perfect trade-mark, then Postum should be graded at about 80. It wholly lacks suggestiveness, and it is not attractive though not displeasing.



A TRADE-MARK FOR A PUBLICATION.

The next mark that attracts our attention in this magazine is "Siwelelo," a coined word, applied to a flushing device used in connection with bathroom toilets. Siwelco is not easy to pronounce, it is not euphonious, it is not easy to remember or to spell. It is the reverse of attractive in sound, and it carries no suggestiveness. It is registrable and protectable.

The next trade-mark is "O.K.," applied to paper fasteners. This mark possesses every good feature. It is suggestive in the

sense that "O.K." means, in ordinary speech, "all right, satisfactory, good." These fasteners are used in offices. The symbol "O.K." has a distinct meaning in commercial language. We are of the opinion that "O.K." used as a trade-mark for office supplies should be graded 100.

"Cat's Paw," a trade-mark for rubber heels, is the next. It is an example of a word that is suggestive in the wrong way. "Cat's Paw" suggests the soft, quiet tread of a cat—and of rubber heels. At first glance it would seem that "Cat's Paw" is an ideal name. But those who sell rubber heels say that the noiseless tread (or "sneaky walk," as one shoemaker stated it) is the greatest of all drawbacks to the sale of rubber heels. In short, the name is suggestive, but suggests a defect.

The next trade-mark that comes to hand is the Ford automobile mark, reproduced on this page. It should be noted at the start that the mark as it stands, with the phrase "The Universal Car" as a part of it, is not registrable, as it contains a descriptive phrase. The rest of the design is registrable, and, after registration, the descriptive phrase might be imposed upon it without destroying its validity.

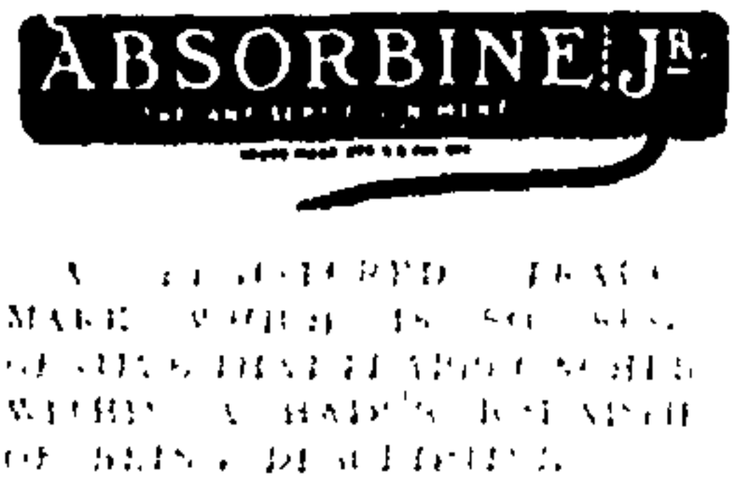


THE FORD AUTOMOBILE TRADE-MARK AS REGISTERED AT WASHINGTON.

In considering this mark the reader should bear in mind that an automobile trade-mark must be of such character that it can be worked out in metal and attached to the front of the radiator. The Ford device is suited to this form of affixation.

This trade-mark shows a pyramid with wings. Its symbolism is the pyramid for *strength and solidity*, and the wings for *speed*. *Speed* and *solidity*—two desirable qualities in an automobile. The symbolism is not apparent until explained, and the mark is rather meaningless to the ordinary observer, but, considering the restrictions that surrounded its creation, we are of the opinion that it is a very good trade-mark.

Next we come to "Ralloc," which is the trade-mark of a collar-retainer. The word is obviously the word "Collar" spelled backward. It is not euphonious, or attractive, or distinctive in any way. This mark is an example of a large class of trade-marks which bears upon them the evidences of only one purpose—and that is, to produce something which will not be rejected by the Patent Office.



A REGISTERED TRADE-MARK WHICH IS SUGGESTIVE OF SOMETHING.

"Crex" is an excellent trade-mark. It is an adaptation of the word "Carex," which is the botanical name of a sedge-like grass which may be woven into a fabric. Dropping the "a," we have "Crex." This name sticks in the memory; it is easy to spell, easy to say, and is quite distinctive. It lacks inherent suggestiveness, but it is the kind of word that may be readily popularized by advertising.

There is a toilet preparation widely advertised and sold under the name "Sempre Giovine," meaning "always young." This trade-mark must be a tremendous drawback to the success of the article with which it is associated. It cannot be pronounced properly except by those who have taken lessons; and it is difficult to remember. To an English-speaking person it conveys no suggestion. Foreign words should be avoided in devising trade-marks. People do not like to ask for things by names which they cannot pronounce.

The trade-mark affixed to the linens sold by McCutcheon, of New York, a store famous for the quality of its fabrics, consists of the picture of an old-fashioned spinning-wheel, without wording. This is a very good trade-mark. It brings up a mental picture of the slowly-wrought hand-woven linens of our grandmothers' time, fabrics that looked good and wore well.

There are trade-marks so admirably adapted to their purpose that they seem to be the work of genius. "Uneeda," applied to crackers in a sealed package, is such a trade-mark. "Rainbow," a trade-mark for dyes, is another happy inspiration. This name makes one think of the fine colors and delicate tones of a rainbow. It stimulates the idea that these dyes emulate a rainbow in beauty. "Skidoo"—a trade-mark used in connection with a small gasoline engine for launches—is another trade-mark that touches the top notch of merit. It suggests agility and lightness, and the ability to get in motion and scurry away.

Special Notice

An enormous waste of mental effort expended by manufacturers and their representatives in devising unsatisfactory trade-marks might be avoided by consultation with us—either personally or by mail—before any work is done in the way of devising a mark.

There are more than 40,000 registered marks in existence, and approximately 100,000 unregistered trade-marks that have been used long enough to be capable of protection under the common law. One can see that the chances are large of a new trade-mark user deciding upon a mark that is already in use. Many marks are sent to us to be registered on which it is evident that much thought has been expended, but which are so nearly like other marks already in existence that their registration and protection are impossible.

KAZOO

TRADE-MARK OWNED BY THE KALAMAZOO SUSPENDER COMPANY. IT IS A COINED WORD, THE ELEMENTS OF WHICH ARE TAKEN FROM THE NAME "KALAMAZOO."

A search of the files, for which we charge only $5.00, generally saves many times its cost in mental work and vexation.

Our staff includes some expert designers of trade-marks, who, living in the trade-mark atmosphere, and knowing the best that is being done in trade-mark construction, are fully prepared to design marks that have every element of distinctiveness, suggestiveness and validity.

For designing a trade-mark our charge is proportioned to the time and labor involved.

CHAPTER V

Trade-Mark Protection

AN owner of a valid trade-mark is protected by law in its exclusive use, as he is in the use of any other property that he may own.

But to obtain this protection his trade-mark must possess all the essentials of validity, and he must be able to prove infringement—in short, the burden of proof is upon the owner of the trade-mark alleged to have been infringed.



TRADE-MARK OF A WALL COATING. IT SUGGESTS THE WHITENESS AND SMOOTHNESS OF ALABASTER.

Infringement of a trade-mark is defined in Hesseltine's "Law of Trade-Marks and Unfair Trade" as: "An imitation such as would be likely to deceive the ordinary customer in the usual course of trade in the purchase of goods of one person as those of another."

The question of the infringement of a registered trade-mark is covered by sections 16, 17, 18 and 19 of the Act of 1905. Section 16 is quoted here:

> SECTION 16 That the registration of a trade-mark under the provisions of this act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy or colorable imitation in commerce among the several tribes, or with foreign nations, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Note that in case of infringement of a registered trade-mark, suit may be brought in a Federal Court, that triple damages may be collected in case the proof of infringement is established, and the defendant will be forbidden to use the offending mark.

Infringement is a specific violation of the trade-mark statutes. It falls under the broader and more general law of unfair business competition, which takes cognizance not only of trade-mark infringement, but also of all other devices of deception by means of which one person trades upon the reputation of another.

Nims, in his excellent book on "Unfair Business Competition," says:

"The use of a special mark in connection with particular goods or a particular business is a representation that those goods or that business are the goods or business of the person to whom the mark belongs; that they belong to the person to whom the mark has become identified. If such representation is false, a case of unfair competition exists. The law of trade-marks, therefore, is merely a specialized branch of the broader doctrine of unfair competition. Relief in trade-mark cases is afforded upon the express ground that every person is entitled to secure such profits as result from a reputation for superior skill, industry, or enterprise, or, in other words, from his good-will. But, as has just been seen, this is the precise principle upon which relief is afforded in cases of unfair competition. The right of action in technical trade-mark cases is based upon the ground that an exclusive property right in the mark is claimed, and that the mere use of a close imitation of it, by another, *ipso facto* creates a cause of action, regardless of the effect of such use or imitation. But the courts in the past have frequently lost sight of the broad general principles of unfair competition, and have sought to decide cases of unfair competition pure and simple, 'upon principles analogous to trade-marks.' The owner of a technical trade-mark claims it as his, regardless of the effect on others. If someone else uses it or imitates it, the owner claims a right of action because the mark is his and his alone."

COLGATE'S
RIBBON DENTAL CREAM

ONLY THE WORD "RIBBON" IS REGISTERED, "COLGATE'S" IS A PERSONAL NAME AND "DENTAL CREAM" IS DESCRIPTIVE.

And further on, in the same volume:

"Unfair competition does not necessarily involve the violation of any exclusive right to use a word, mark or symbol. It may arise from the use of words, marks or symbols which are free for everybody to use and are not subject to exclusive appropriation by anyone. The existence of this right of action depends upon the question of fact, whether what was done in any special case tends to pass off the goods of one man as being those of another, or tends to deprive any one of his rights. This is the only substantial distinction between cases of unfair competition, or passing off actions as they are called in England, and cases of infringement of trade-marks."

YALE

THE WORD YALE IS A TRADE MARK. THIS MARK IS A GRAPHICAL TRADE MARK WHICH HAS ACQUIRED A SECONDARY MEANING AS A TRADE MARK FOR LOCKS AND IS THEREFORE PROTECTED BY THE COMMON LAW.

This subject is so large and far-reaching that we can touch upon it here only in the most general way, and as incidental only to the question of trade-marks.

Unfair competition, so far as trade-marks are concerned, may take various forms, the most common of which are discussed in the following pages.

1st. *There may be a plain, bare-faced adoption by one individual of a trade-mark belonging to another.*

In certain lines of business—notably the liquor, wine and cigar trades, this sort of infringement is quite common, and organizations of houses dealing in these products have been formed to check it.

Many states have enacted laws making the counterfeiting of a label or a trade-mark a penal offense. Under the Federal Law, infringement is not a penal offense, and only civil actions may be brought under this statute.

One of the most interesting cases of the adoption of a trade-name belonging to another that has ever appeared in the Federal courts is that of *Wolf Bros. v. Hamilton Brown Shoe Co.* (165 *Federal Rep.* 413).

Wolf Bros., shoe manufacturers of Cincinnati, had established a common law right to the use of the name "American Girl" as applied to shoes. This mark is not registrable, as it is both geographical and descriptive. The plaintiff has used the mark continuously since 1896. In connection with the wording, there is a lady's head, and the phrase: "A shoe as good as its name." Certain styles are designated by numerals, such as 404, 408 and 397.

Velvet

AN ADMIRABLE TRADE-MARK FOR A SHOESTRING OR TOBACCO.

The defendant, a St. Louis concern, began to use, in 1900, as a trade-mark for shoes, the words "American Lady," with a lady's picture. Later on, they advertised "American Lady" shoes with the phrases "With the character of the woman" and "The shoe deserves its name." The numbers used by the complainant in designating styles were also taken by the defendant.

The defendant, one of the largest shoe manufacturers in the country, advertised the "American Lady" shoe extensively, spending more than one hundred thousand dollars in publicity after suit had been brought by the complainant.



ARBITRARY SYMBOL, WITH LETTERS, USED AS A TRADE-MARK FOR DEAN'S MOTOR GEAR FILLER.

On trial of the complainant's suit for damages, brought before the U. S. Circuit Court, the defendant's treasurer testified that objection to use the name had been formally made by the complainant in 1901, but that he had considered a protest from a source so insignificant as something of a joke, and had paid no attention to it.

It will be noted, upon comparison of the two marks, that the only difference is the use of "Lady" in the defendant's mark instead of "Girl," the two being in all other respects essentially the same.

Judgment was awarded the complainant. The defendant was forbidden to use the "American Lady" mark, and was ordered to turn over to the complainant all the profits realized since the inception of the suit.

The case was prosecuted further, however, and it was subsequently held (192 Federal Rep. 930) that, inasmuch as the shoes sold by the defendant bore in conjunction with the name "American Lady" the name of the defendant, clearly indicating that such shoes were of its manufacture and not of complainant's, there was no unfair competition. There was no evidence to show that plaintiff had been substantially damaged by reason of curtailment of sales, loss of customers or deception, and no attempt by the defendant to palm off its product as the manufacture of complainant. A judgment for nominal damages ($1.00) was awarded to plaintiff. The question involved in this case was one of unfair trade as distinguished from the infringement of a valid trade-mark.

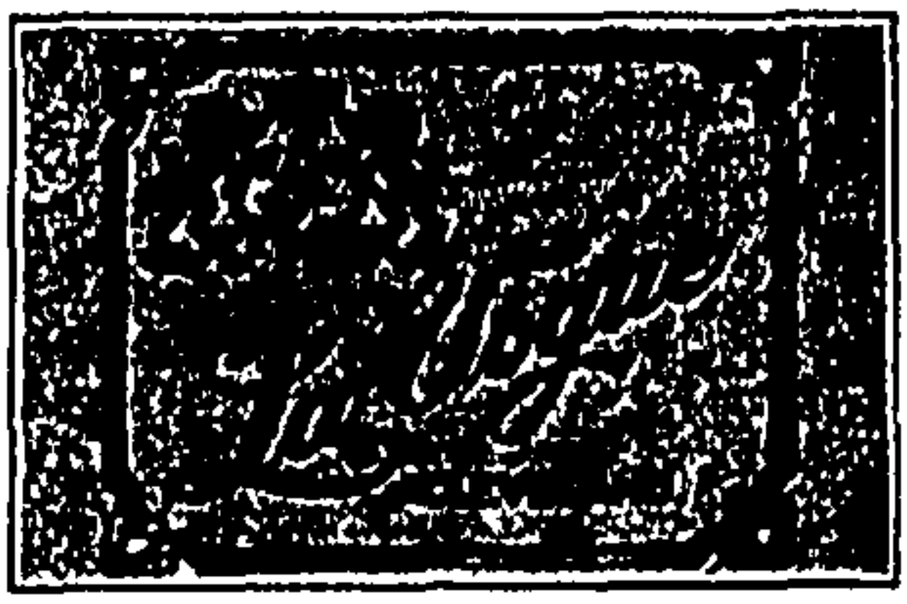
2d. *Another method of infringement is to devise an ingenious similarity of a trade-mark.*

An infringing mark may be so nearly like a well-known and valuable trade-mark that the unwary or careless may be deceived, yet, at the same time, it may be so dissimilar that a show of defense may be made.

The National Biscuit Company has prosecuted more than five hundred infringements of its trade-marks.

"Uneeda" Biscuit has been imitated by "Ulika," "Uwanta," "Iwanta" and dozens of other specious wordings.

The mark "Yusea" used on incandescent gas mantles, was infringed by "U-C-A." In this case there was no similarity whatever in the appearance of the marks, but evidence was produced to show that "Yusea" was pronounced "You see a," and that in sound the marks were precisely the same. Priority of registration of the "Yusea" mark was proved and the use of "U-C-A" was accordingly enjoined.



"LA VOGUE," A TRADE-MARK FOR WOMEN'S GARMENTS, IS AFFIXED TO EACH GARMENT BY MEANS OF A SEWED-ON LABEL

The word "Chasseuse" was held by the court to be an infringement of "Chartreuse," both marks being applied to cordials.

"Grape-Nuts," a cereal food, was not infringed by "Grain-Hearts."

"Old Crow," the name of a whiskey, was not infringed by "Old Jay."

On the other hand, "Colonial Dame," used in connection with perfumery, was infringed by "Colonial."

"Chatter-Box," an annual publication for children, was infringed by "Chatter-Book", used as the name of a publication of the same general appearance and purpose.

3d. Any person has a right to use his own name in business, but not in such a way as to trade on the reputation of someone else bearing the same name.

A typical case of this kind is that of *Royal Baking Powder Co. v. Royal* (122 *Fed.* 337–1903; 58 *C. C. A.* 499–500). An individual by the name of Royal went into the business of manufacturing baking powder. His product was sold in packages of the same general appearance as those containing the product of the Royal Baking Powder Company. The court held that the respondent could use his own name, but "in the least conspicuous manner possible consistent with the right to place his name and address upon the goods made by him."

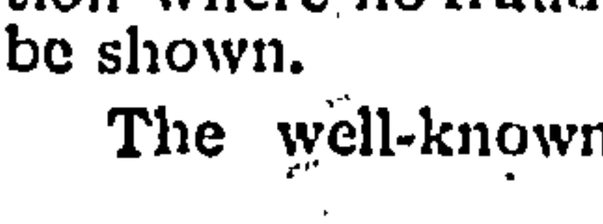


A TRADE-MARK THAT LACKS DISTINCTIVENESS AND IMPRESSIVENESS.

A similar case is that of *Von Faber v. Faber* (124 *Fed. R.* 663). In this case the plaintiff, a manufacturer of lead pencils, was the owner of a business that began in 1761. The pencils made by this firm had always been marked "A. W. Faber." The defendant, also named Faber, began to manufacture pencils in the United States, affixing to his product the mark "Faber." The court held that this was an unfair use of his name, and while he had a right to use his own name, yet he must prefix to it "John E.," "Eberhard" or "John Eberhard."

This decision was subsequently reversed (130 *Fed. Rep.* 257), and it was held that the use of the name "Faber" with the initial "E" prefixed thereto did not constitute unfair competition where no fraudulent intent or deception of the public could be shown.

The well-known chocolate manufacturers of Dorchester, Mass., Walter Baker & Co., have had to contend with many individuals bearing the name of Baker. In each case the decisions of the court have been to the effect that any Baker has a right to manufacture and sell chocolate, and to use his own name on packages of his product, but his name must be accompanied by some statement or distin-



AN EXCELLENT TRADE-MARK FOR A SPARK PLUG.

guishing mark which will clearly differentiate his product from that of Walter Baker & Co.

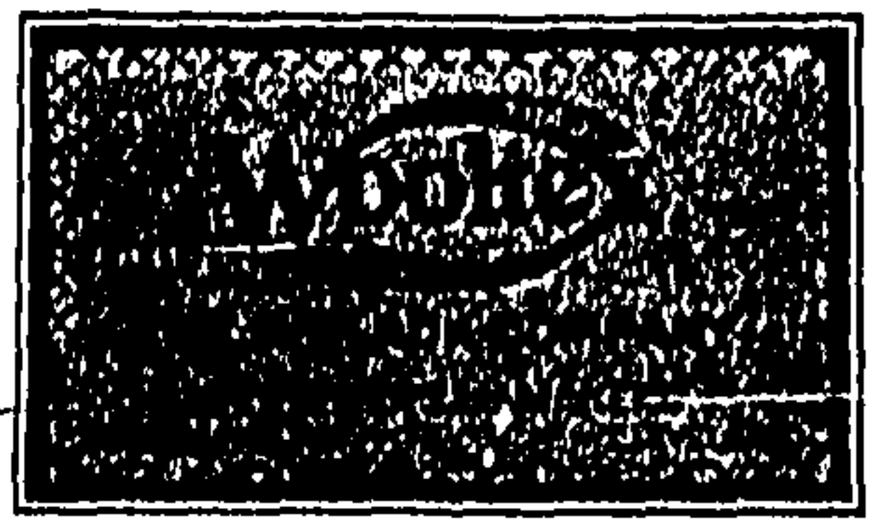
In the case of *Williams v. Mitchell* (*106 Fed. R. 168–171*), the court said: "One may not use his own name for such purpose when it works a fraud. If he uses a descriptive word, or a geograpbical name, or his own name, it must be so used as not to deprive others of their rights, or to deceive the public, and the name must be accompanied with such indications that the thing manufactured is the work of the one making it as would unmistakably inform the public of the fact."

4th. Where the resemblance between two trade-marks is only casual and not sufficiently pronounced to deceive a person of ordinary intelligence, there is no infringement.

A manufacturer of a lantern known as a "Hurricane" lantern claimed that the name of another lantern, called "Tempest," was an infringement. The court held that while there was a resemblance in the names in the underlying idea, they were so different in appearance and sound that any person of average common-sense would not mistake one for the other.

"S. B.," a trade-mark for cough drops, was not infringed by "B. and S."

"Weber," a mark for pianos, was not infringed by "Webster." In this case there is a casual resemblance in appearance in the two words, but no resemblance, or very little, in sound.



MAKERS OF FABRICS SEEM TO HAVE A LEANING TOWARD TRADE-NAMES ENDING IN "TEX." THIS IS ONE OF THE BEST-KNOWN EXAMPLES.

5th. It is a principle of the law of unfair business competition that the plaintiff must come into court with clean hands

The courts will not use their power to perpetuate a fraud. A trade-mark conveying a misrepresentation of the composition, character or quality of the goods with which it is used, cannot be protected against infringement.

CHAPTER VI

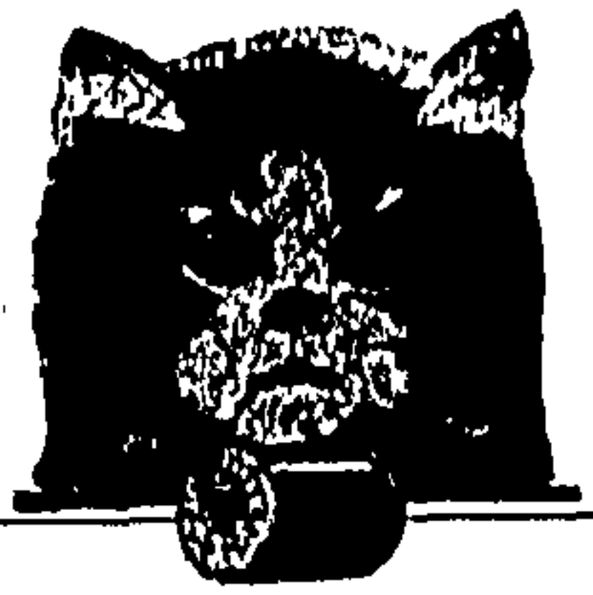
The Trade-Mark Work of Munn & Company

WE began to practice as trade-mark and patent attorneys before the Civil War, and for sixty-five years we have been engaged continuously in this work.

During our two generations of service the law of trade-marks and unfair trade has grown from a thin trickle of judicial decision to a wide stream of statutes and precedents. We have kept track of the formation of this large body of law, and have assisted, in some measure, in shaping it.

Sixty-five years ago there were probably not more than a thousand trade-marks in existence in the United States. To-day, the registered trade-marks alone number above forty thousand.

Knowledge is only accumulated by experience, and we believe that we are justified by the facts in saying that we have had a larger and longer experience in Patent Office work than any other firm of patent attorneys.



THE CORTICELLI SILK TRADE-MARK. THE CAT'S HEAD IS PRINTED ON A LABEL PASTED ON THE END OF EVERY SPOOL.

We are entitled to practice before the Patent Office in cases concerning trade-marks as well as those relating to patents. Our work in this connection includes the designing of trade-marks; preliminary searches of the Patent Office files; registration of marks; and the conducting of opposition, interference and cancellation cases.

Our fees for trade-mark service are:

For registration of a trade-mark (if there is no opposition), $15.00. To this fee should be added the government fee of $10.00 for registration, making the total cost of registering a trade-mark, $25.00.

If the mark includes a special design, an additional fee of $5.00, to cover the expense of preparing the drawing, is charged.

For preparation of a design, or devising a trade-mark, where the idea is our own, we charge a fee based on the time and labor involved.

For search of the Patent Office files our charge is $5.00. This search should always be made before an application for registration is filed.

After an application has been filed for registration, an examination is made by the Patent Office, for the purpose of ascertaining whether or not the application is anticipated. If the Trade-

Mark Examiner in the Patent Office refuses to register a trade-mark, an appeal may be taken to the Commissioner of Patents. If he reaffirms the Examiner's decision, another appeal may be taken to the Court of Appeals of the District of Columbia.

For conducting appeals our fee is based on the circumstances of the case.

It may happen that you have applied for registration of a trade-mark essentially similar to that of another registrant or applicant. In such a case the Commissioner of Patents is authorized to institute what are called "Interference Proceedings," for the purpose of ascertaining who is the rightful owner. If you are dissatisfied with the decision of the Examiner of Interferences, by whom the inquiry is conducted, you may appeal to the Commissioner in person; and from his decision you may appeal further to the Court of Appeals of the District of Columbia. We attend to all such proceedings, and will state terms on application.



Assignment of Trade-Marks

A registered trade-mark can be assigned in connection with the good-will of a business in which the mark is used. The assignment must be recorded in the United States Patent Office within three months of its date; otherwise it is void as against any subsequent innocent purchaser for a valuable consideration. The Commissioner of Patents is required to keep a record of such assignments. Our usual fee for preparing and recording an assignment is $5.00.

Information Needed Before an Application for Registration Can Be Prepared

Delays in registering trade-marks are often caused by the failure of trade-mark owners to supply us readily with all the information necessary to formulate an application for registration in proper form.

If you are contemplating the registration of a mark, note carefully the following data which must be supplied:

1. Name of the owner of the trade-mark.
2. If the owner is a corporation, the State in which it has been incorporated.
3. Residence of the owner.
4. Place of business of the owner.
5. Nationality of the owner.
6. Whether the mark is used in interstate or foreign commerce, or commerce with the Indian tribes.
7. Class of merchandise on which the mark is to be used, and the particular description of the goods comprised in that class. Thus, the applicant must not state merely that a mark is to be used with "Shirts," but should be more specific, and state whether the shirts are outer or under garments, and of what material they are made.
8. A statement of the manner in which the trade-mark is applied to the goods. If by means of labels, six copies of the label should be furnished; if otherwise, six specimens of the mark as usually affixed.
9. As nearly as possible the earliest date on which the mark was used.

10. Whether or not the mark is registered in any foreign country; and, if so, the date of registration or of the application for registration.
11. If the applicant be not a resident of the United States, the name and address of some person residing in the United States upon whom process may be served or notice of proceedings affecting ownership. (If desired, we can appear on the Patent Office records as the representative of a foreign registrant upon whom papers may be served.)

Registration in Foreign Countries

Many American manufacturers and exporters do not realize the importance of registering their trade-marks in the foreign countries to which their goods are sent. Knowing only the trade-mark laws of the United States, where the title is derived from first use and is confirmed by registration, they often wait until it is too late before attempting to comply with the registration laws in other countries.

A fundamental difference between the trade-mark laws of the United States and those of Germany, Austria, Hungary, Argentine Republic, Bolivia, Brazil, Chili, China, Paraguay, Peru, Venezuela, Uruguay, Costa Rica, Guatemala, Denmark, Finland, Norway, Sweden, Spain, Japan and Cuba, is that in the foreign countries named the first to register a trade-mark acquires the property therein, to the exclusion of the rightful owner.

In many other countries the registration is, after a short period, also conclusive proof of ownership. American exporters will therefore see the importance of registering their marks in the foreign countries to which they send their goods.

We are prepared to register American marks in any country that has made provision for the registration of foreign-owned marks. Upon application, we will send a list of fees for registration in each country.

Our Facilities

Our organization is complete in every particular. We have a highly trained staff of trade-mark specialists which we place at the service of our clients. Our branch office in Washington, located just across the street from the Patent Office, gives us unsurpassed facilities for rapid and accurate work. We are always in close touch with new trade-mark developments through being on the ground, and being engaged in daily practice before the Patent Office.

Legal Causes

Munn & Company solicit associate business from other attorneys in patent and trade-mark matters. All opposition, cancellation, and interference proceedings, together with suits for infringement and unfair competition and other legal matters, are handled by Munn & Munn, Attorneys and Counselors at Law, 361 Broadway, who are specialists in patent and trade-mark causes.

Trade-Mark Protective Bureau

Under the present law those applications for the registration of trade-marks which have been passed and allowed are published in the Official Gazette, and, within thirty days after the date of publication, any person who believes he would be damaged by the registration of a mark may oppose its registration by filing

notice of opposition thereto. The opposer need not be the owner of a registered trade-mark, but, if registration is sought by another for a trade-mark so closely resembling one in use by the opposer on goods of the same descriptive properties as to be liable to cause confusion or mistake in the minds of the public or to deceive purchasers, the registration of such mark to the applicant would justify the opposer's belief that he would be damaged thereby.

Notices of opposition to be effective must be filed within thirty days after the date of publication of the mark sought to be registered in the Official Gazette.

Our trade-mark protective bureau is designed to carefully scrutinize the trade-marks published each week in the Official Gazette, and to notify such of our clients as avail themselves of our services of the publication of any trade-mark for which registration is sought which would be liable to conflict with any trade-mark in use by such client, in order that he may interpose opposition to registration if he so elects. We make a nominal charge for these services of $10.00 a year for each mark submitted. The marks submitted are recorded and classified in accordance with the official classification of the Patent Office, so that each week a comparison with those published in the Official Gazette may be readily had and resemblances discovered.

MUNN & COMPANY

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