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A TREATISE

ON THE

LAW OF TRADE MARKS,

HENRY MATIER & CO. BELFAST

WITH A

DIGEST AND REVIEW

OF THE

ENGLISH AND AMERICAN AUTHORITIES.

BY

FRANCIS H. UPTON, L. L. B.

Justitia est constans et perpetua voluntas jus suum cuique tribuendi.
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PREFACE.

THE subject of this Treatise has assumed an interest and importance, within the past quarter of a century, not inferior to that attached to any branch of the law connected with the affairs of trade and commerce.

The instruments by which the manufacturer or the merchant, is enabled to designate the merchandise that he makes, or sells, so that its identity in the marts of commerce shall be faithfully preserved, are often valuable beyond estimation, for the reason that the merchandise itself, without these, would become comparatively valueless.

The manner in which property in these instruments may be acquired; by whom it may be possessed; of what such instruments must consist in order to entitle him who adopts and uses them, to protection in their exclusive use as property; what is in law, a violation of such exclusive right; and what are the remedies by which such violation may be prevented or redressed; are questions, the answers to which constitute the law of Trade Marks.

These answers are only to be found distributed through the books of reports of judicial decisions of the courts of

England and the United States, and no attempt has ever yet been made to collate or digest them.

The great inconvenience arising from the want of a work in which has been performed the labor of gathering together these scattered authorities, and extracting from them the principles, and doctrines, and rules, which they are found to establish, has been often and seriously felt by the author, in the performance of his professional duties, and is made a subject of complaint by his brethren, both of the bench and bar, whenever a trade mark controversy arises for investigation, discussion or determination.

These considerations, to which may be added the very vague and imperfect notions which confessedly exist in relation to this interesting branch of the law, as well in the profession itself, as among laymen, and those whose business interests require some familiarity with its principles, have induced the present undertaking.

If it shall be found to have been performed in a manner sufficient to remove, or even to diminish, the inconveniences heretofore experienced—especially, if it have the effect, however partial and limited, of causing juster ideas to prevail concerning the peculiar character of property of which it treats, and of inducing a more extended familiarity with the principles upon which its recognition and protection are based, the author will have the satisfaction of having discharged a portion, small though it be, of that debt which my Lord Bacon justly holds to be due, from every man to his profession.

NEW YORK, *June*, 1860.

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THE

LAW OF TRADE MARKS.

CHAPTER I.

Of the Nature and Character of Property in Trade Marks.

A TRADE MARK is the name, symbol, figure, letter, form or device, adopted and used, by a manufacturer, or merchant, in order to designate the goods that he manufactures, or sells, and distinguish them from those manufactured or sold by another; to the end that they may be known in the market, as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise.

The necessity for the use of such distinguishing marks for articles of merchandise, must have arisen

with the dawn of manufacturing and mercantile competition.

Such is the similarity in external appearance, upon a casual, or even a careful inspection, of different articles of manufacture, of the same general nature, but of essentially different quality and value, that, without the aid of distinguishing marks, the purchaser would be unable to determine the origin of the goods he was purchasing, and so would be deprived of that assurance of the quality of the merchandise, and that pledge of the integrity of the manufacturer or vendor, which the trade mark expresses or implies.

We accordingly find, that property in trade marks, exclusive and absolute, has existed and been recognized as a legal possession, which may be bought, and sold, and transmitted, from the earliest days of our recorded jurisprudence.

It has been often said, that the doctrine of exclusive property in trade marks, has prevailed from the time of the Year Books. This may be so—but on an examination of the record referred to, it is very doubtful if it can be regarded as justifying this ancient recognition of the doctrine. The recital in Cro. Jac. is as follows:

"A clothier of Gloucestershire made very
"good cloth; so that, in London, if they saw

"any cloth *of his mark*, they would buy it,
"without searching thereof; and another, who
"made ill cloth, put his mark upon it, without
"his privity—and an action upon the case was
"brought, *by him who bought the cloth*, for this
"deceit, and adjudged maintainable."

In *Southern* vs. *How*, Popham, 144, a somewhat different version is given of what is, no doubt, the same case—although it is there said to have taken place in 22 *Eliz.*, and in Cro. Jac., it is referred to the 33 *Eliz.*

In Comyn's Digest "*Action on the case for deceit*" A. g. the case is thus recited:

"So" (i. e. an action will lie) "if a clothier
"sell bad cloths upon which he put *the mark*
'of *another* who made good cloths."

Comyn does not say *by whom* the action may be maintained, but, as he cites Cro. Jac. only, it may be inferred that he considered the case as establishing the right in the *purchaser*, which it certainly would, if that report be correct. In *Southern* vs. *How*, in Popham, the case is certainly cited as a distinct affirmance of the right of a manufacturer to maintain an action for an unauthorized use of his trade mark—Lord ROLLE, however, expressly states that "Doderidge did not *say* whether the action was brought by the clothier or by the

vendee," but he adds—"*semble que gist pur le vendee*"—2 Roll., 28.

At whatever early date property in trade marks may have been recognized, it is only since a comparatively recent period, that the jurisdiction of Courts of Equity has been exercised for its protection. And it is only since, and as a consequence of, the learned discussions and decisions in these courts, that its nature, and character, and extent, have been clearly defined.

Prior to the time of Lord HARDWICKE, a party claiming to be the owner of a trade mark, was left to establish his right, and obtain his remedy at law. That learned chancellor said—that he "knew of "no instance of granting an injunction to restrain "one trader from using the trade mark of another." *Blanchard* vs. *Hill*, 2 Atk., 484—"and" he adds—"in my opinion it would be of mischievous consequence to do so."

It is certain, that in a case like that before Lord HARDWICKE, no Court of Equity of the present day, either in England or America, would hesitate to grant an injunction to restrain the violation of rights now universally conceded to be just and salutary.

It is not easy to understand upon what grounds any reasonable apprehension of "mischievous con-

sequences," could have been entertained, from such an exercise of the powers of a Court of Equity—but whatever they may have been, they have long since been discarded.

As the true interests of manufactures and commerce have been more perfectly developed, and more fully understood and appreciated, it has been found, that an exclusive property in trade marks, and its adequate protection by Courts of Equity, not only imposes no restraint upon the freedom of trade, but that its direct and inevitable tendency is, to promote and encourage that laudable competition, in which lies the true interest of the public—that competition which stimulates effort, and leads to excellence, because of the certainty of protection in the attainment of its adequate reward.

It is now, therefore, the well established doctrine, that the exclusive property of the manufacturer, or merchant, in his trade marks, is of that nature and character, that its adequate security and protection, by the exercise of the highest power of the courts, is an imperative duty, as well for the safety of the interests of the public, as for the promotion of individual justice—and a duty which cannot be evaded or denied, without a violation of those principles upon which a large portion of equity

jurisdiction is founded—and its most important functions are exercised.

When we come to consider the character and extent of the wrong that is committed by an invasion of the right of property in a trade mark, the just and rational grounds upon which this doctrine has now become firmly established, will be made perfectly apparent.

The right of property in trade marks does not partake in any degree of the nature and character of a patent or copyright, to which it has sometimes been referred—nor is it safe to reason from any supposed analogies existing between them.

The exclusive right of multiplying copies of original productions of the mind, whether in the form of books, maps, engravings, designs or other of the manifold emanations of human thought, expressed by words or symbols—bears no appreciable resemblance to a right of property in a mere name, figure, letter, mark, device or symbol—when used as a designation of a thing.

The former, which is copyright property, is granted by express statute—and, whatever may have been its origin, is controlled by the limitations and conditions of the law of its being; it is a property in the thing itself—the words—letters,

designs or symbols, which are the signs of things, and the forms and embodiment of thought. The latter is a property, not in the words, letters, designs or symbols, as things—as signs of thought—as productions of mind—but, simply and solely, as a means of designating things—the things thus designated being productions of human skill, or industry, whether of the mind or the hands, or a combination of both: and this property has no existence apart from the thing designated—or separable from its actual use, in accomplishing the present and immediate purpose of its being. It is a right of property, neither created nor controlled by any legislative enactment, but existing at common law, independent of all statute provisions, which, [recognizing its existence and the great importance of its protection beyond that afforded it by courts of civil jurisdiction], inflict the penalties of a misdemeanor upon its violation.*

During the current century, which, beyond all others, has been characterized by a wonderfully increased activity in the multiplication of all conceivable productions to supply the material needs or wants of man—natural or artificial—the right of property in trade marks, has grown to be of

* Vide note at the end of this chapter.

immense and incalculable value to the manufacturer—the merchant—and the public.

It is the means, and in many instances, the only means, by which the former are enabled to inspire and retain public confidence in the quality and integrity of things made and sold—and thereby secure for them a permanent and reliable demand—which is the life of manufacturing and mercantile operations.

And it is also, in the like instances, the only means, by which the public is protected against the frauds and impositions of the crafty and designing, who are ever on the alert to appropriate to themselves the fruits of the well earned reputation of others, regardless of individual rights or the public interests.

As this peculiar character of property has increased in value and estimation, so, it has become more and more important, that the principles of law should be clearly defined and well understood, which lie at the foundation of its existence—which indicate its true nature and character—which prescribe rules for its acquisition, preservation and transmission—and which define its violation, and provide the means for its protection, as well in the form of preventive, as of retributive justice.

These principles are to be gathered from the

discussions and judicial decisions of the courts of England and the United States, and the ensuing chapters of this work will be devoted to the task of extracting and faithfully setting forth those principles, which are considered justly deducible from all the authorities, upon their careful digest and review.

NOTE.—The peculiar phraseology of the Patent Laws of the United States which grant to the inventor or producer of a *new* and original *design* the exclusive right of multiplying copies of the same, have, to some extent, led to the practice, of availing of its provisions to secure what is supposed to be an equivalent to trade mark property.

The act of 1842, is in the following words:

"Any citizen or citizens, alien or aliens, having resided one "year in the United States, and taken the oath of his or their "intention to become a citizen or citizens, who by his, her, "or their, own industry, genius, efforts, and expense, may "have invented or produced any new and original *design* for "a manufacture, whether of metal or other material or mate- "rials; or any new and original design for the printing of "woolen, silk, cotton or other fabrics; or any new and original "design for a bust, statue or bas relief, or composition in "alto or basso relievo, or any new and original impression or "ornament; or to be placed on any article of manufacture, "the same being formed in marble or other material—or *any* "*new and useful pattern*, or *print or picture*, to be either "*worked into* or *worked on*, or *printed* or *painted* or *cast*, or "*otherwise fixed* on *any article* of *manufacture*—or any new "and original shape or configuration of any article of manu- "facture, not known or used by others, before his, her or their "invention or production thereof, and prior to the time of "his, her or their application for a patent therefor, and who "shall desire to obtain an exclusive right or property therein, "to make, use and sell and vend the same, or copies of the "same to others by them to be made, used and sold, may

"make application, in writing, to the commissioner of Patents, "expressing such desire, and the commissioner, on due pro- "ceeding had, may grant a patent therefor."

The words which we have italicised, are those relied upon, in this law, as conferring a right, available for obtaining, by patent, an exclusive privilege that can be made to serve the purpose of designating articles of merchandise.

It is quite obvious that such was not the purpose of the law, but, on the contrary, it was manifestly intended, that the *design*, for which such protection was provided—should constitute a portion of the manufactured article, either as an ornamental adjunct, or as controlling its figure or proportions—by no means, as a mere name or designation, by which to identify or distinguish the article.

But, we are informed that a very literal construction has been placed upon the phraseology of the law—and that under it, patents are granted, upon the application of manufactures or merchants—for devices to be used as mere designations of their merchandise, to be affixed, either to the article itself—or to the package containing it.

Whatever right may be thus acquired, is, of course, subject to the conditions of the statute—and, although made subservient to the uses of designating trade marks—is, in no sense, analogous to trade mark property.

No higher or better exclusive right to the use of such mark or device can be acquired by such a patent—than may be acquired by its adoption and appropriation by the manufacturer or merchant to designate the articles to which it is affixed, as his production—and it may well be doubted whether such a construction of the statute would have been suggested or sought—but for the privilege, which such a government grant confers, or may be supposed to confer, of affixing the word "patent" or "patented" to the article, in connection with which, the right

to a *design* has been secured — and this, to serve the purpose of inducing the public to believe that a patent exists for the thing itself — not for the mere device or mark attached to it.

The policy of continuing such an unwarrantable construction of the law — resorted to for the accomplishment of such a purpose — is, to say the least, very questionable.

CHAPTER II.

By whom Property in Trade Marks may be acquired.

No person, who is, in law, capable of acquiring and possessing any species of property, is excluded from the acquisition of property in trade marks.

In its adequate protection by the courts, there is no difference between citizens and aliens — nor, can it be made a subject of inquiry, how far the courts of the country of the alien complainant, afford to the citizens of the country of his temporary domicil, that protection which he there seeks. Such an inquiry, it has been truly said, would be derogatory to the dignity of the courts and the country, and of the just boast of all free and enlightened communities, that equal and exact justice is admin-

istered to all who invoke it. The honor of a nation, and the character of its jurisprudence, as well as every dictate of enlightened wisdom, especially in a commercial community, require that the foreigner shall be protected in this character of property, equally with the citizen. Even though other nations were justly chargeable with the wrong and injustice of withholding this protection to aliens, it affords no reason for an imitation of such an example.

"Retaliation in a course of injustice, is not "a salutary principle to enforce, in the admin- "istration of justice." (*Taylor* vs. *Carpenter*, 3 Story's Reports, 450, and imperfectly reported in 7 Law Reporter, 437—also *Taylor* vs. *Carpenter*, in 2 Woodbury and Minot, 1—and 4 Barbour's Abstract of Chancellor's decisions, 68—and fully reported in 2 Sand. Ch. R., 603.)

In each of these cases—the former, in the Circuit Court of the United States, in Massachusetts, before Justices STORY and WOODBURY—and the latter, in the Court of Chancery of New York, and subsequently on appeal in the Court of Errors —the plaintiff was a subject of the Queen of Great Britain—and an attempt was made by the defendant's counsel, to show, that the protection claimed, should be granted only to citizens, and that the policy of denying such protection to the foreigner

complainant, a citizen of the United States, had been adopted by the English courts.

In the refusal of the courts, in these cases, to recognize such a doctrine, it was by no means conceded, that the case cited and relied upon by the defendant's counsel, justified the deduction drawn from it.

The case referred to, is *Delondre et al.* vs. *Shaw*, 2 Simons, 237, and it will be found, on examination, that the denial of protection by the learned Vice-Chancellor, was limited to the "copyright of a foreigner."

More recently, and in one of the latest decisions of the English Court of Chancery, the very question arose which was made in *Taylor* vs. *Carpenter*.

In the case of *The Collins Co.* vs. *Brown*, 3 Kay and Johnson, 423—and *The Collins Co.* vs. *Cowen*, 3 Kay and Johns., 428, the plaintiffs were citizens of the United States, and manufacturers of edge tools at Hartford, in Connecticut. Upon the objection of alienage being made, the doctrine supposed to have been adopted in *Delondre* vs. *Shaw*, was repudiated by the learned Vice-Chancellor (WOOD), in language quite as strong and indignant as that used by Mr. Justice STORY—or the Chancellor or either of the learned Senators in the Court of

Errors of New York—and it was not only held that foreigners were equally entitled to protection with citizens, but that it was very doubtful if it should be withheld even from alien enemies.

A consideration of the correct legal definition of a trade mark—of the necessity in which its use originated, and of the justice as well as policy of protecting it as property, serves to indicate that class of persons in a mercantile community who become possessed of this species of property and entitled to protection in its enjoyment—for, while, as we have seen, no one is excluded from the right to acquire, on the other hand, such only do acquire the right, whose position brings them within the true policy and just intendment of the law.

It is not the abstract right to the exclusive use of a certain name, letters, mark, device or symbols, which can be acquired and possessed.

It is such use only, in connection with, and as a designation of, the particular property to which it is affixed. It follows, therefore, that the exclusive right to the trade mark, can exist in him only, who, in some form, and to some extent, possesses an exclusive right in the property to which it is appended.

The fundamental policy of the law is, to protect the manufacturer, who by his skill and industry,

has produced an article of merchandise, that has found favor with the public, and which he has designated by a particular name or mark. We accordingly find, that in nearly all the reported cases in which the right has been recognized, the complainants have been manufacturers, and, as such, possessed of an exclusive right in the designated commodity.

It is not doubted that the merchant, who imports and sells the article, may acquire the right, and be alike entitled to protection—but he must acquire it by virtue of his relationship to the manufacturer, which has vested in him an exclusive right to sell.

If A., the manufacturer, should sell his productions to B., and also to C., and B. should adopt for it a distinguishing mark, indicating its origin, it would hardly be contended that he could acquire an exclusive property in such mark, and be entitled to its protection, as against B., or any one else, who had an equal right to sell the identical article, by virtue of his purchase from the same manufacturer.

It seems, therefore, to be the established doctrine, that property in trade marks—so far, at least, as they consist in the proper name of the things designated, or, by long use, have become known by that name, can exist only in those who have the exclusive right to manufacture or to sell the spe-

cific article. And so far as they consist in anything other than the proper name of the thing, which is susceptible of becoming a legitimate trade mark, can exist only in the manufacturer or in those entitled to represent the manufacturer.

In the case of *Singleton* vs. *Bolton*, 3 Doug., 393, which is one of the earliest reported cases in the law of trade marks, it appeared that one "Dr. Johnson," had invented a certain medicine which he called "Dr. Johnson's Yellow Ointment." By long use, that had become the name, by which alone the medicine was known.

Without acquiring any rights from the inventor, who had long been deceased, the plaintiff, and his father before him, had, for many years, compounded and sold this medicine, under that name.

The defendant commenced to make and sell the same ointment, under the same name, and for such supposed invasion of his exclusive right, the plaintiff brought his action. He was nonsuited, and the nonsuit was affirmed by the Court of King's Bench, upon the ground, as stated by Lord MANSFIELD, that the plaintiff had no *exclusive right* in the medicine itself—and *therefore*, the defendant had an equal right to prepare and sell it under the same name that the plaintiff used—that, having become the proper name of the thing.

In the case of *Canham* vs. *Jones*, 2 Ves. & Beams, 218, the same principle was asserted.

The bill was filed to restrain the defendant from compounding and selling a certain medicine, called "Velno's Vegetable Syrup," the plaintiff averring that he had acquired an exclusive right in the medicine itself, and therefore in the use of the name under which it was known and sold.

The evidence, however, not sustaining the averment of the plaintiff's exclusive right in the medicine, his alleged right to protection in the use of the name, was urged upon the ground of prior adoption and long use—but the bill was dismissed, "because," in the language of the learned Vice-Chancellor (SIR THOMAS PLUMER), "as the plaintiff had no *exclusive right* in the medicine, it was a necessary consequence that he could have none in the *use of its name.* The foundation of the bill, is the exclusive right asserted in the plaintiff—that failing—all consequential relief falls with it."

This is, unquestionably, the established doctrine—and although, in the discussion of particular cases, judges have sometimes held language which would seem to convey the idea of a property in the trade mark itself—not connected with any merchandise that it designates, a property which, once acquired, becomes vested in him who adopts it, so that he

may, for any time, lay it aside, and then resume its use as an exclusive right—such a doctrine has never been directly asserted, nor could it be maintained, without a departure from the obvious purpose and policy of the law.

In the late case, already cited (*Collins* vs. *Cowen*, 3 Kay and Johns., 428), the learned Vice-Chancellor declares it to be well settled, that there is no such thing as property in a trade mark, except in connection with its use to identify the goods and wares as those of the manufacturer who uses it.

> "It is," he says, "in fact, a right, which can "be said to exist only, and can be tested only, "by its violation. It is a right which any per- "son designating his wares or commodities by "a particular trade mark, as it is called, has, "to prevent others from selling wares which "are not his, marked with that trade mark."

While, therefore, it may be perfectly true, that a trade mark may be made the subject of sale and transfer, so as to confer upon the purchaser the rights of the vendor—yet, it must not be supposed that this can be done, apart from a transfer of the right to manufacture or sell the particular merchandise, which it had been used, by the vendor, to designate.

If a manufacturer, who has adopted and used a particular mark or symbol to designate his goods,

and thereby has acquired a right to protection in its exclusive use, should abandon his business, without transferring it to another, he can no longer be held to possess any exclusive right to the use of the name, entitling him to transfer it to another manufacturer who makes the same or a similar article.

The right to the exclusive use of the name, may, perhaps, upon such abandonment, be acquired by another, by adoption and use—but the transfer, of itself, can confer no right.

It would seem, that a trade mark may become so identified with the particular *place* of manufacture, as to confer upon the person, having, for the time being, the exclusive right to manufacture at that particular place, the exclusive right to use the trade mark upon his goods there manufactured.

Such a doctrine was suggested by Lord COTTENHAM, in *Motley* vs. *Downman*, 3 Myln. & Cr., 1.

In that case, tin plates were made at Carmarthen, for a long series of years, marked "M. C.," and, under that mark, became universally known as the plates made at the Carmarthen works. S. became a lessee of the factory, and used the mark. He abandoned his lease, and set up a tin plate factory forty miles distant from Carmarthen, and there used the same mark upon his plates. For a num-

ber of years thereafter the Carmarthen works remained unoccupied. At length D. took a lease of them, and commenced the business of manufacturing tin plates, and used the same brand "M. C." S. obtained an injunction to restrain D. in the use of this trade mark—but, upon the hearing, it was dissolved, with liberty to bring an action at law.

The learned Chancellor says:

> "The question is, whether the plaintiff "acquired the right to prevent subsequent ten- "ants of the works at Carmarthen, from using a "mark, which it is clear, was originally derived "from those works. It is a question of con- "siderable nicety, and has never risen in any "of the cases cited, and therefore, the court "should be very sure before it concludes the "right, by injunction—particularly without "providing for the trial of the legal right."

It may well be doubted, whether the doctrine, apparently countenanced by this decision, would be sustained upon mature consideration—for it would certainly appear to be at variance with the principles upon which the jurisdiction in equity, for the protection of property in trade marks, has always been held to rest.

That jurisdiction is exercised for a twofold purpose:

First. To protect the public against the frauds and impositions of unprincipled vendors, who may

seek to pass off their spurious wares, as those of approved quality and established reputation, under the name or guise of the genuine commodity; and

Second. To secure to the skilful and industrious manufacturer, the legitimate fruits of his skill and industry.

To hold, that a particular trade mark, may, under any circumstances, be an appurtenant to a particular place, where the goods marked are made, could scarcely be rendered subservient to either purpose.

To hold that an honest, skilful and industrious manufacturer, who has adopted as his trade mark, a name or sign, that had been used by him at his former place of manufacture, at a time when all manufacturing operations had ceased at that place, and has continued the use of that name or sign for a series of years—so that, under that name, the article became known, and favorably known, as his—may be suddenly deprived of his trade mark, by which alone his merchandise is identified in the market, and the exclusive right to its use become vested in another, because that other has become the lessee of the old place of manufacture, at which the trade mark was originally adopted, and long before used—would certainly seem to be subversive of each purpose of the law—for the manu-

facturer, would thereby be effectually deprived of the just reward of his skill and industry—and another party 'sailing under his colors' would be placed in a situation, enabling him, with impunity, to mislead the public, and pass off an inferior article upon the consumer.

There is manifest danger, if not positive certainty, of such a result, whenever the judicial mind, in the determination of controversies concerning this peculiar character of property—is induced, by the nature of the circumstances attending any given case, or from any other cause, to lose sight, for a moment, of those fundamental principles, which, we have seen, are the sufficient and only foundation of that equity, jurisdiction, which is exercised for its protection.

As it is the supposed skill and industry of the manufacturer, which confers upon him, or those representing him, the right to protection in the exclusive use of the trade mark which he has adopted, to designate his productions—such a right can only be acquired by the *honest* manufacturer.

When a person seeks, by representations which are untrue (whether forming a portion of the trade mark that he has adopted for his wares, or not), to mislead the public into a belief that his commodi-

ties have an origin other than the true one, or that they are compounded or produced, in a manner not in accordance with the truth, and thus, endeavors to establish a reputation for his goods, upon another basis than his skill and industry in their production, he places himself beyond the pale of the protection of the law — and — acquiring no exclusive right to the trade mark that he uses, is entitled to no relief against any one who may see fit to appropriate it.

A careful review of the authorities illustrating this important doctrine, cannot fail to be instructive.

In the case of *Pidding* vs. *How*, 8 Simons, 477, the complainant filed his bill, to restrain the use by the defendant, of his trade mark, on a certain tea — made by a peculiar mixture of different kinds and qualities, called "Howqua's Mixture."

It appeared, however, that the complainant had made false representations to the public, in relation to the method of procuring and making his mixture, and upon this ground, the injunction was denied.

> "It is a clear rule" says the Vice-Chancellor in his decision — "laid down by courts of "equity, not to extend their protection to per-"sons whose case is not founded in truth."

In *Perry* vs. *Trufitt*, 6 Bea., 66, the doctrine of *Pidding* vs. *How*, was approved and followed.

It appeared, in this case, that in 1836, one Leathart invented a certain mixture for the hair, and sold the secret and recipe for his compound to the complainant Perry—who called it "Perry's Medicated Mexican Balm."

But it also appeared, that the complainant, in his advertisements to the public, had falsely set forth that his compound was prepared from an original receipt of the learned and distinguished "Von Blumenback"—and for this reason, with others, (to be referred to hereafter in another connection) Lord LANGDALE, Master of the Rolls, denied the injunction prayed for, to restrain the defendant from selling his compound, under the name of "Trufitt's Medicated Mexican Balm."

The decision in the subsequent case of *Holloway* vs. *Holloway*, 13 Bea., 213, would seem to involve a relaxation of this salutary doctrine—but, as no reference is made in the opinion of the court, to either of the preceding cases, it cannot be regarded as overruling the doctrine which they had established.

In *Flavel* vs. *Harrison*, 19 Eng. Law and Eq. Rep., 15—the doctrine of *Pidding* vs. *How*, was again maintained and rigidly enforced.

The plaintiff in this case, had contrived a grate, which he manufactured and sold extensively, and profitably, under the name of "Flavel's Patent Kitchener." It was thus stamped and marked, and by that name had become known. In fact, the plaintiff had never obtained any patent for his invention or improvement. The name, therefore, adopted by the plaintiff, declared an untruth.

The defendant, Harrison, had been employed by the plaintiff, and, availing of his situation, had surreptitiously procured copies of the plaintiff's list ot customers, and of his plans. Leaving his employment, he commenced business on his own account, by the manufacture and sale of the same article, and stamped it with the identical name used by the plaintiff.

Notwithstanding the dishonest practices of the defendant, the court refused to interfere by injunction, solely upon the ground that the plaintiff had himself been guilty of a fraudulent misrepresentation, in the trade mark adopted by him, namely, that the thing to which it was applied, had been patented, when in truth it had not.

(It may be well to state, in this connection, that the use of the word "patent," or words signifying that letters patent of the government have been granted, or that a copyright has been secured by compliance with the statute provisions, by stamping, or in any manner marking or printing the same, upon any article of manufacture, or upon anything which is the subject of copyright—to which, in truth, no patent has been granted or copyright secured—is prohibited by penal enactments, both in England and the United States. But the decision in *Flavel* vs. *Harrison* proceeds upon the false representation alone, not upon the statute prohibition.)

In the courts of the United States, the question of the right of a complainant to protection, in the exclusive use of his trade mark, who has himself been guilty of a fraudulent imposition upon the public, in the manufacture or business for which he seeks protection, has undergone elaborate discussion.

The subject came directly under consideration in the case of *Patridge* vs. *Menck*, in the Court of Appeals of New York. (How. Appeal Cases, 547.)

In the Court of Chancery, from which the case was taken by appeal, the question does not seem to have arisen—2 Sand. Ch. R., 622—but in the

Court of Appeals, the case was determined upon an application of the English doctrine.

The plaintiff was a manufacturer of friction matches, and caused a label to be affixed to his boxes, having upon it the words, "A. Golsh's Friction Matches."

The defendant was also a match manufacturer, and used the same trade mark upon the labels affixed to his boxes.

A. Golsh, it appeared, was the original manufacturer, but the plaintiff had acquired no exclusive right to use his name or trade mark, although he had purchased his secret, and therefore might be regarded as licensed in some manner, to use his name. The court, however, considered that by its use, he was fraudulently representing to the public that Golsh was the manufacturer of the matches made and sold by him—and this manifest intention to mislead or deceive the public, was held to be, of itself, a sufficient reason for denying to the plaintiff the protection which he claimed,

Mr. Justice GARDINER, in his opinion upon this point, briefly and significantly says:

> "The privilege of deceiving the public even "for their own benefit, is not a legitimate sub- "ject of commerce—and, at all events, if the "maxim, that he who asks equity must come

"with pure hands, is not altogether obsolete,
"the complainant has no right to invoke the
"extraordinary jurisdiction of a court of equity
"in favor of such a monopoly."

In the case of *Fetridge* vs. *Wells*, 4 Abb. Pr. R., 144—this doctrine was ably and most elaborately discussed by the late Chief Justice DUER, in the Superior Court of the city of New York.

The great importance of the principle, as imposing the condition of truthfulness and integrity in the manufacturer, as a *sine qua non* to his right to protection in the trade marks for his merchandise, as well as the very thorough and instructive manner in which it is elucidated by this learned judge —which will be found to be characteristic of his disquisitions upon every branch of the law of trade marks that he had occasion to consider—requires something more than a mere passing notice, or brief statement of the conclusions of the court in this case.

The plaintiff, it appeared, had purchased a recipe for compounding a certain cosmetic, which he had long used, under the name of "The Balm of a Thousand Flowers."

The defendants commenced the manufacture and sale of a similar article, which they designated, "The Balm of *Ten* Thousand Flowers."

The plaintiff claimed property in the name used by him as his trade mark—and brought suit for protection, by injunction, against the alleged violation of his right by the defendant.

A temporary injunction was granted by a judge of the court, at Chambers, and the cause came before Mr. Justice DUER, on a motion to dissolve the injunction, upon the pleadings and proofs.

Several questions were involved in the case, and are discussed at much length and with great learning and ability. These, we shall have occasion to notice hereafter, when reviewing the authorities upon another branch of the subject. Upon the doctrine now under consideration, the result of the facts in proof in the case, is thus stated by the court:

> "The proof is complete that the name was "given, and is used, to deceive the public—to "attract and impose upon purchasers—that, in "the sense that the plaintiff means it shall con- "vey, it is a representation to the public, that "he finds to be useful, and knows to be false.
>
> "Let it not be said that it is of little conse- "quence whether this representation be true "or false.
>
> "No representation can be more material, "than that of the ingredients of a compound, "which is recommended and sold as a medicine. "There is none that is so likely to induce con- "fidence in the approbation and use of the

"compound, and none that, when false, will,
"more probably, be attended with injurious,
"and perhaps, fatal consequences. Nor is it
"possible to excuse or palliate the proceedings
"of the plaintiff by saying that there is no rea-
"son to believe that the deception which he
"has practised, has been successful—for that
"it has been eminently successful, I cannot
"doubt. Of the extent to which the public
"has been deceived, the immense sales, which,
"it is stated, have been made, the value which
"the plaintiff attaches to the name, "Balm of
"a Thousand Flowers"—and his anxiety and
"determination, if possible, to retain its exclu-
"sive use, seem alone a conclusive proof. He
"has spent, it is said, and profitably spent,
"more than one hundred thousand dollars, in
"advertising his compound for sale—; but
"had he dropped its fictitious and deceptive
"name, and advertised it by its true name of
"'Liquid Soap,' and had made known to pur-
"chasers, that its main ingredients, were those
"blossoms of health, oil, ashes and alcohol, I
"apprehend that this large sum would not have
"been expended at all, or would have been
"expended in vain. Strip his compound of
"its false and borrowed name, its imaginary
"blossoms, reduce it from a balm into a soap,
"and its sales will be those of a soap, not of a
"quack medicine, held forth to the world as
"curing nearly all the diseases that flesh is
"heir to."

"It has been insisted that the very extrava-
"gance of the plaintiff's pretensions, is proof
"that they are harmless, and rather fitted to pro-
"voke mirth, than criticism and censure. And,

"it must be admitted, that it would be difficult
"for a judge, even of the most approved and
"habitual gravity, to read the plaintiff's paper
"of directions without a smile. But we cease
"to smile, when we remember that these
"falsehoods, for such they are, are printed and
"circulated with the intent that they shall be
"believed, and in fact, that there are thousands
"upon thousands, who read them and believe.
"We cease to smile, when we remember,
"that the plaintiff, who boldly claims the aid of
"a court of equity, is filling his pockets, by
"abusing the credulity of the young, the
"inexperienced, the weak and the ignorant,
"and that he resorts to misrepresentations and
"falsehood, to induce those to purchase, who
"would not otherwise buy — and those who
"buy, to give a higher price than they would
"otherwise pay — if this is not deceiving and
"defrauding the public — what is?"

Upon these facts, the learned judge thus states his conclusions of law:

"Even upon the supposition that all the
"material allegations in the complaint are true,
"the conduct and proceedings of the plaintiff,
"have been such, as justly to preclude him
"from any relief in a court of equity." "It
"may be true that the defendants, if permitted
"to use in their contemplated sales, a trade
"mark, apparently the same as that of the
"plaintiff, would commit a fraud upon the
"plaintiff and upon the public — but if the
"plaintiff is himself engaged in a systematic

"plan for deceiving the public—if he has been,
"and is, endeavoring, constantly and daily, to
"multiply his sales, and swell his profits,
"by false representations of the composition,
"qualities and uses of the liquid compound,
"which he invites the public to buy—a court
"of equity would violate its princ ples, and
"abuse its powers, by consenting to aid him, by
"an injunction or otherwise, in accomplishing
"his designs."

"Those who come into a court of equity,
"seeking equity, must come with pure hands
"and a pure conscience. If they claim relief
"against the fraud of others, they must them-
"selves be free from the imputation. If the
"sales made by the plaintiff, are effected, or
"sought to be, by misrepresentation and false-
"hood, he cannot be listened to, when he com-
"plains that by the fraudulent rivalry of others,
"his own fraudulent profits are diminished."

"An exclusive privilege for deceiving the
"public, is assuredly not one that a court of
"equity can be required to aid or sanction. To
"do so, would be to forfeit its name and
"character."

The learned judge then briefly reviews the preceding authorities, upon the doctrine—which are hereinbefore cited—but thus premises his review:

"I have seldom deemed it necessary to cite
"authorities, when there is a clear, plain, firm
"ground of principle, to stand upon—and I
"know that I stand upon this ground, in hold-
"ing that this injunction ought to be dissolved."

This doctrine may now be considered as so firmly established, as to admit of no doubt or discussion.

It is true, that in another case, occurring in the same court, at about the same time, in which the same plaintiff was seeking the same relief against another defendant, (*Fetridge* v. *Merchant*, 4 Abb. Pr. R., 156,) Mr. Justice HOFFMAN intimated a different conclusion, upon the same question, and says, that in his views,

> "The question should be judged of solely
> "as between the immediate parties, and the
> "public be left to its own guardianship,"
> "but," he adds "I abstain from urging the
> "reasons of my opinion in this particular,
> "which the different views of other judges,
> "and especially of Mr. Justice DUER, in the
> "case of *Fetridge* v. *Wells*, just decided, instruct
> "me may be wholly wrong, because my con-
> "clusion in this case, will turn upon another
> "point."

That point, we shall have occasion to advert to hereafter, in another connection.

As it is the aim of this work to present a digest of all the reported cases, upon the subject of which it treats—we ought not to omit to state, that in the case of *Stewart* v. *Smithson*, 1 Hilton, 119—the Court of Common Pleas of New York city, does

not seem to have recognized this salutary doctrine we are now considering.

In that case, the trade marks alleged to have been fraudulently imitated, were, "Hall & Moody's patent thread, Barnsley," and "Grant & Wood's patent thread, Berwick."

The question arose on a motion, on the part of the defendant, for leave to amend his answer, by insertions of the averments that "the alleged trade marks of the plaintiff were and are fraudulent trade marks, adopted and used by the plaintiff, with intent to deceive and defraud, and that the thread in the packages upon which said marks were affixed, was not a patented article — that no patent had ever existed for the same, that the said thread, was not, in fact, manufactured by "Hall & Moody" or by "Grant & Wood" nor was the same manufactured at "Barnsley" or at "Berwick."

The motion for leave thus to amend the answer, was denied, and the order denying the motion, was affirmed by the full bench of the Common Pleas Court expressly upon the ground, that "the proposed amendment set up no legal defence to the claim of the plaintiff."

If, by this, is intended, that proof of the facts set up in the proposed amendment, would not operate as a bar to the relief claimed by the plain-

tiff, the case is at variance with the settled doctrine. It may be, however, (though no such intimation appears in the report of the case) that the question was disposed of, as one of pleading simply—that although a defendant could not be allowed to plead the alleged fraud of the plaintiff, as an answer to his own alleged fraud—yet, that upon the hearing, such fraud being made to appear, the court, in the exercise of its equity powers, would be bound to take notice of it, by a denial of the relief sought.

There is too much reason to believe that fraudulent and deceptive trade marks are in common use among a class of manufacturers and dealers, who have heretofore claimed and received the protection of the courts of England and the United States, and whose respectable business position, extensive business connection, and large reputed wealth, should place them above all suspicion of resorting to deceptive devices to enhance their gains.

But recent disclosures have revealed the startling fact, that the *representations of quantity*, upon the spools of manufacturers of cotton thread, the cases and packages of various kinds of cloths, silks, velvet, calico, linen, merinoes, braids, ribbons, and indeed of almost everything sold in the shops or

even the factories—representations which form a prominent part of the trade mark of the manufacturer or merchant, are, in almost every instance, materially false, representing the package to contain a quantity, larger, and in many cases, much larger, than it does.

This false representation, it seems, is usually perfectly well understood, between the manufacturer and the wholesale purchaser, and is made with intent to deceive and defraud the petty trader and the consumer.

Upon this large class of the community, whose protection from wrong and imposition, it is the primary province of the law of trade marks to secure; upon this class, the vast aggregate of whose individual petty means, constitutes the wealth and power of a commercial nation, this systematic fraud and deception falls with a crushing weight.

The extent to which it is carried is enormous. The gains resulting from it, are almost incredible. The wrong and injury which it inflicts are incalculable.

There is not a thing that we eat, or drink or wear, which is pure and genuine.

Good things become condemned by the foul imitations which men sell for them—and the

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cheatery of the multitude robs the honest man of his due repute. Instead of standing out in bright singularity, he is confounded in the mass of rogues. Short measure, false weights — diminished numbers, forged tickets and labels — fictitious representations — adulterated goods and worthless fabrications — are the things upon which the once honest manufacturer and trader now thrives.

It seems to be the spirit of the age — and to pervade all, save the most uncivilized regions, of the world.

It is not easy to devise a method by which an evil, so deeply rooted, of such long, secret continuance, and producing such gigantic fortunes to the guilty parties, may be speedily eradicated.

Among other means, by which such a result may be reasonably hoped for, must be included, the dissemination, in all ways — so that the knowledge of the fact may become universal — that such fraudulent manufacturers and dealers, are beyond the pale of the law's protection — that they have no property, whatever, in any valuable sense, in the trade marks which they employ — that one may manufacture goods in imitation of theirs, sign them with their signs, and expose them for sale in the market, in such guise that it is wholly impossible to distinguish them from the genuine — and thus destroy

their reputation, and appropriate what might be their lawful gains—and they are wholly without redress. They may seek relief in our courts of equity, but, no sooner have they crossed the threshold, than the impurity of their hands is pointed at, and they are bidden to depart.

Such a severely practical teaching of the great truth that "honesty is the best policy," may surely contribute, at least, to bring about an abandonment of this wide spread evil, and great commercial fraud, and have some influence in effecting a sorely needed reform in the morals of trade.

CHAPTER III.

Of the manner in which Property in Trade Marks may be acquired.

Property in trade marks—by which, is always intended, the right to protection in their exclusive use—is primarily acquired, by an original adoption, appropriation and actual use, by the manufac-

turer or other person, possessed of an exclusive right in the thing designated.

It must not be supposed that this character of property holds any such analogy to that of the author in the productions of his mind, for which he may secure a copyright, or of the inventor in the subject of his invention, and for which he may secure a patent, that the marks, names, letters, signs, devices or symbols, *originally* adopted, must be such as have "never before been known or used."

It is not in such a sense, that the adoption or appropriation is required to be original.

If the name or marks adopted, were not, at or near the time of their adoption, in actual use to designate the same or similar articles of manufacture, the adoption, it is presumed, would be held to be sufficiently original to comply with the legal requisition, even though the same name or marks had been used in like manner, at some previous period. The sole purpose being, that the marks adopted shall be such as will identify the thing named, as that of the person naming it, and distinguish it from all others, this purpose is accomplished, if the name be not then in like use, or had not been, within a period so recent as would be likely to defeat the primary purpose of distinctive designation.

Undoubtedly, if the name adopted, had before been in such common use to designate the same or similar articles, as to lose its identifying or distinguishing capacity, no exclusive right to its use could be acquired, by adoption, even though it could not be made to appear, that it was in such use, at the precise time of its adoption.

The distinguishing capacities of a name or trade mark adopted, may, in fact, become impaired by its common previous use, or its then present employment, as a designation for articles of an entirely dissimilar general character from those to which it is sought to be appropriated—though the general rule is understood to be, that the name adopted should not then be, or have been before, used as a designation for articles of the same or a similar nature.

Having in view the true policy of the law, in extending its protection to the exclusive right to the use of adopted trade marks, it cannot be supposed that any different or greater extent of originality, in him who makes the appropriation, would be required, than such as has been here stated—but the subject of the precise nature and extent of the prior use of a trade mark, as operating to defeat a claim of exclusive property, has not been definitively determined by any reported decision.

In the case of *Fetridge* vs. *Merchant* — 4 Abb., 157, Mr. Justice HOFFMAN, upon the hearing, dissolved the preliminary injunction that had been allowed, upon the ground that the evidence left the question of priority of appropriation so doubtful, that a court of equity ought not to conclude the issue, by an injunction, before a trial at law had determined the point.

We are not aware of any reported case, other than this, in which the conclusion of the court was rested upon the question of originality of adoption, — in the sense of priority of appropriation,—of the trade mark in question.

We therefore quote at length, the language of the learned judge, in discussing this question, in connection with the evidence, in that case. He says:

> "This brings me to a point of most difficulty "in the case. Did the plaintiff first appropri- "ate the term so as to give him a prior right? "Dr. Fontaine was the first person who used it "in the United States, and the plaintiff derived "his title from Fontaine, by purchase of his "secret and recipe. This was in 1846. He "manufactured an article which he called "'Fontaine's Balm of Thousand Flowers'— "and he says that the same name was used for "cosmetics, in Europe, in different languages.
>
> "A large number of witnesses depose to the "following effect — I use the language of one

"of them — Bazin, a perfumer of fifteen "years: 'That to his knowledge the terms "'Balm' and 'Thousand Flowers' and 'Balm "of Thousand Flowers,' have been in common "use in this country, and in foreign countries, "in their respective languages, for more than "ten years, as applied to numerous kinds of "cosmetics and fancy soaps.' Similar state- "ments are made by other witnesses. One says "that it has been so constantly used and applied "to cosmetics, for twenty years, in this country, "and elsewhere, that he has come to consider it "a descriptive name of a cosmetic.

"These affidavits are met by counter state- "ments of numerous dealers, to the effect, that "they have never met with, or heard of, a cos- "metic under that name, except those in ques- "tion, in this case. They have had more or "less opportunities of acquiring such know- "ledge — and it is urged, and with much force, "that the defendants have not proven one "instance of its use, except what may be "traced to Fontaine — to the plaintiff, or the "defendant.

"One new question might arise upon the "facts, which the weight of evidence seems to "establish, whether, if the name was first used "in this country by Fontaine, in 1846, and was "acquired from him by the plaintiff, its general "use in other countries, in their several lan- "guages, would justify the employment by "others.

"Fontaine says, that he first found it in a "French writer. It was commonly adopted "elsewhere. It may be, that one would have "a right to use it merely translating it.

"My conclusion upon this leading point of the "case, is, that the title of the plaintiff to appro- "priate the term to himself, is not made out."

It is language like the foregoing, of Mr. Justice HOFFMAN, and the terms "priority of use," "priority of adoption," "original designation," and the like, so frequently employed by other learned judges, when stating the legal pre-requisites to the existence of an exclusive right, that renders it necessary to guard against the impression which such language might produce, that the right may in any sense, be predicated upon the inventive faculty of the manufacturer or merchant, in devising a new name or mark, to designate his merchandise.

Such a doctrine, which carries with it the idea of ownership in the abstract name, thus devised, is nowhere decided—and would certainly be in conflict with the well established principles upon which trade marks are recognized and protected as property.

If, indeed, a manufacturer invent a name for his merchandise, which possesses the other characteristics requisite to form a distinguishing trade mark, entitling him to protection in its exclusive use—it will be more likely to possess that quality which is absolutely essential, namely, that of *identifying as his*, and *distinguishing from all others*, the article to

which it is applied — for the reason that it is his invention — and therefore was never before known or used — but not, *for that reason*, is his right to protection in its exclusive use, made in any manner stronger or better.

Property in trade marks, may be obtained by transfer from him who has made the primary acquisition.

Here, again, it should be remembered, that, as no one can acquire or possess the mere right to the exclusive use of a name, unconnected with anything to which it is applied, so, of course, no such right can be transferred by contract.

It is, therefore, essential to the acquisition of the property, in this manner, that the transferee should be possessed of the right either to manufacture or to sell the merchandise to which the trade mark has been attached.

The case in the Supreme Court of New York of *Samuel et al.* vs. *Burger et al.*, 4 Abb. Pr. R., 88, fully illustrates this doctrine.

In this case, it was averred that one Brindle, a watchmaker, had acquired a reputation as such — and that all watches manufactured by him, were

stamped with his name. That Sylvester S. Samuel purchased from Brindle, the right to stamp his, (Brindle's,) name, on watches manufactured by Samuel—and that Samuel had assigned to the plaintiffs, the right to stamp Brindle's name on watches made by them. The defendants kept on hand for sale, watches actually manufactured by Brindle, and stamped with his name, and the suit was for an injunction to restrain them from so doing.

The court decided that the right to use the name, without the thing, could not be transferred.

> "If," says the learned judge, "the right of "the plaintiffs to use the name of Brindle as a "trade mark, were clear, and the defendants "were seeking to make sale of watches made "by themselves, as those manufactured by "Brindle, then, an injunction should go—but "the plaintiffs cannot call on this court to aid "them in passing off watches made by them, as "those manufactured by Brindle."

There can be no doubt that a contract, by which a manufacturer disposes absolutely of his business, and vests in another the right to manufacture the goods which he has before produced, and which have become known in the market by a distin-

guishing trade mark, though it were silent upon the subject of such trade mark, by necessary implication, vests in the purchaser the exclusive right to its use as it was before used.

It may be, that an express provision in such contract, that the vendee should not use the trade mark before used by the vendor, might be enforced in law—but, if so, certainly not upon the ground that the right in the mere name was retained or reserved in the vendor, or that he could convey such right to another, after parting with that which was the essential condition of his own possession of the right.

Whether a transfer of a manufacturing establishment, which includes in express terms the "good will" that it has acquired,—by which is intended, the probability that the customers who are in the habit of dealing there, will continue to do so—the transferor covenanting not to embark in the like business, in the same town, carries with it, by implication, the right to use the name under which the establishment has become known, and acquired its celebrity—where that name consists in whole, or in part, of the proper name of the vendor, is a question of no little interest.

It may not, perhaps, be within the strict purview of the law of trade marks—but, in some respects, it presents such analogies to questions relating to that character of property, as to involve the consideration of analogous principles in its discussion.

In the case of *Howe* v. *Searing*, 10 Abb. Pr. R., 264, this question has lately undergone elaborate investigation in the Superior Court of the city of New York, and a full review of the facts, and the opinions of the learned judges in that case, will be found to be instructive, as illustrating this branch of our subject—namely the conventional transfer of trade marks.

In this case, the plaintiff sold to the defendant's assignor, his bakery establishment, situated upon Broadway, in the city of New York—and long known and celebrated under the name of "Howe's Bakery."

The sale included all the personal effects connected with or appertaining to the establishment—and, in express terms, included the "*good will.*"

The vendor covenanted not to carry on the like business within the city of New York, as a condition of the transfer.

The vendee entered upon the possession of the property, continued the business at the same place, retaining the old signs, and using the name "Howe's

Bakery," upon circulars, bills, tickets, wagons, and in every way in which it had been before used by the vendor. This use was continued by the vendee or his assigns for some seven or eight years, without any judicial question of the right by the vendor.

Not long before the action was brought, the plaintiff, Howe, desiring again to return to the baking business, made an agreement with his vendee, by which he acquired the right to resume the business, within certain limits in the city of New York, and at No. 850 Broadway—being about a half a mile from the old locality.

By this agreement, it was expressly stipulated, that "he was not in any manner to interfere with the business, carried on at No. 432 Broadway, *known as 'Howe's Bakery.'*"

Under this agreement, he resumed the business at No. 850 Broadway, and shortly thereafter, [his vendee having sold and transferred to the defendant,] brought this action, to restrain the defendant from using the words or name "Howe's Bakery," as his sign or designation, or in any manner connected with his business.

It was in proof, at the trial, and conceded that the use of the name, in the manner in which it was used by the defendant, induced persons to deal with the defendant, at the old establishment

No. 432 Broadway, in the supposition, that they were dealing with Howe, the plaintiff, who would otherwise transfer their custom to the plaintiff's new establishment.

Under these facts, the judgment of the court below, granting the injunction prayed for, was affirmed on appeal. The opinion of the court was given by Mr. Justice HOFFMAN, and a decided dissenting opinion was pronounced by Mr. Justice MONCRIEF.

The questions involved in the case are of much interest and importance, in a commercial community, where the custom has long prevailed, to no inconsiderable extent, of continuing the use of the name or style of a partnership, or commercial firm, long after the original parties, whose names compose it, have deceased, or have dissolved their connection with the business.

It was conceded, by the learned judge, who gave the opinion of the majority of the court—that the covenant of the vendor, contained in his contract of sale of the bakery establishment, not to carry on the like business within the city of New York, was not an invalid covenant, as in restraint of trade. It follows, therefore, that, but for the subsequent agreement, by which the plaintiff obtained the privilege of resuming the business at a particular

locality—(viz.: 850 Broadway) the plaintiff could have had no standing in court, because the sole ground of his complaint, was, that the ~~plaintiff~~, by the use of the name "Howe's Bakery," induced persons to deal with him at the old establishment, who would otherwise deal with the plaintiff at his new one.

But, the very condition upon which the limited privilege was granted to the plaintiff, of resuming the business at 850 Broadway, was, that he should "not in any manner interfere with the business carried on at No. 432 Broadway, known as 'Howe's Bakery.'"

It is not quite apparent, how the institution of this suit, for the avowed purpose of securing to the plaintiff the customers of the old establishment, and depriving the defendant of rights which he had enjoyed for years, as a part of the "good will" of the concern, could be otherwise regarded than as an "interference with the business carried on at 432 Broadway, known as Howe's Bakery,"—and therefore a direct violation of the condition of the restricted grant to the plaintiff.

No allusion is made to this objection to the plaintiff's claim in the reported opinion of the majority of the court—perhaps for the reason that the grounds upon which the decision was finally rested,

rendered a consideration of this question unnecessary.

An unlawful encroachment upon the *good will* of a business, is sometimes the essence of the wrong involved in the violation of a trade mark. What is intended, therefore, by the "good will" of a business, becomes a question important to be determined.

It has been defined, in brief, to be "the probability that the old customers will resort to the old place." A more full and satisfactory definition is given by Mr. Justice STORY—who describes it as:

> "The advantage or benefit which is acquired
> " by an establishment, beyond the mere value
> " of the capital stock, funds or property belong-
> " ing therein—in consequence of the general
> " public patronage, which it receives from con-
> " stant or habitual customers, on account of its
> " local position, or common celebrity or repu-
> " tation for skill, or affluence, or punctuality,
> " or from accidental circumstances, or even
> " from ancient partialities or prejudices."
> "Story's Eq., § 99.

This definition of the "good will" of an establishment, is adopted as a correct one, by the learned court in this case.

The question, whether the "good will" of a

partnership establishment, upon the decease of one of the partners, becomes the property of the survivor, or is to be disposed of as any other of the partnership property, is next elaborately discussed by the learned judge, and the authorities reviewed at much length.

Upon this point, the court determines that the weight of authority is in favor of the principle, that the "good will" of a partnership business, in the absence of proof to the contrary, must be presumed to have been the result of the joint skill, capital and industry—when built up by the parties themselves—or by a joint purchase, when it has been reared by a predecessor—and, as the acquisition was joint, the value must be shared.

The only case that conflicts with this doctrine, is, *Douglas* vs. *Hammond*, 5 Ves. R., 539. There, it is explicitly held, that the "good will" of a partnership establishment, belongs to the surviving partner, that its sale cannot be compelled by the representatives of a deceased partner—that it is not partnership stock of which the executor may require and enforce a division—but belongs of right to the survivor.

The cases on the other side are numerous—*vide Crawshay* vs. *Collins*, 15 Ves., 227; *Cantwell* not

vs. *Lye*, 17 Ves., 335; *Cormick* vs. *McCubben*, 1 Shaw & Ballantyne, 540; *Chissam* vs. *Dewes*, 5 Russel R., 29; *McDonald* vs. *Richardson*, 1 Geff. R., 81; *Hitchcock* vs. *Cohen*, 1 Ad. & El., 438; *Elves* vs. *Crofts*, 10 Com. Bench R., 241; *Lewis* vs. *Langdon*, 7 Simons, 421; *Dougherty* vs. *Van Nostrand*, 1 Hoff. Ch. R., 68; *Williams* vs. *Wilson*, 4 Sand. Ch. R., 379; 2 Bell's Com., 645.

The court next proceeds to the discussion of the doctrine, which it regards as well settled, that, upon the dissolution of a partnership or upon the sale of the business of an establishment, in the absence of any express stipulation—there is no implied obligation upon the vendor, or the outgoing partners, to refrain from setting up the same trade or business, and forming a new establishment for carrying it on, even at the next door to the very place where the former business was established, and is continued.

In support of this doctrine the following authorities are cited:—*Davies* vs. *Hodgson*, 25 Bea., 177; *Cook* vs. *Collingridge*, Jacobs R., 623; *Lewis* vs. *Langdon*, 7 Simons, 421; *Clinton* vs. *Douglass*, 1 H. R. V. Johns., 176.

In the case last cited the learned Vice-Chancellor (Sir R. PAGE WOOD), discusses the question

at much length, and maintains the correctness of the doctrine by much learned argument.

[Though either partner may be at liberty, in the absence of any express stipulation to the contrary, upon a sale or dissolution, to establish the same kind of business wherever he please—yet neither party has a right to retain and use the old signs containing the names of the former partners, or the style of the late firm.

Upon this question, the doctrine laid down in the case of *Peterson* vs. *Humphrey*, 4 Abb., 394, is declared to be analogous to that upon which property in trade marks is protected—namely—the false representation, as the basis of a fictitious credit, made by him who adopts or retains the use of the old partnership sign, after it has ceased to designate an actual existence.

Peterson & Humphrey were partners in New York city, and failed. By composition with their creditors, they were enabled to resume business—and did so—each on his own account. Humphrey, by transfer, became the owner of all the debts of the old firm, and resumed business at the store previously occupied by the partnership. Peterson established a like business in another street. Humphrey retained one of the old partnership signs

upon the store, and at the suit of Peterson, an injunction was ordered, restraining the use of the sign. The court says:

"The rule as to the liability of a third per-
"son for a false representation as to the credit
"of another, although originating in the com-
"mon law courts, contains the true elements of
"the liability for false signs or trade marks,
"with, perhaps, a slight modification.

"The sign or mark must be false in fact,
"and be so known to the party using it, and
"have been used with the intention to deceive,
"and be of such character as would mislead a
"person of ordinary caution. The injunction
"may be proper, without any other proof of
"the knowledge of the falsity or of the inten-
"tion to deceive, than that which arises from
"the fact that there is falsity, and that the
"effect will necessarily be to deceive."

In this case, it appeared, that upon one of the old signs of the firm, Humphrey had caused to be painted above the firm name, "Peterson & Humphrey," the words "Humphrey & Co., formerly," so that the sign read, "Humphrey & Co., formerly Peterson & Humphrey." The added words, say the court, were "so large and distinct that nobody could be deceived." This language sufficiently indicates the character of those signs that so frequently meet the eye in a commercial city, in which the added name and the words "formerly"

or "successors to" are so small and indistinct as to escape observation, unless upon careful inspection—leaving the name or names upon the old sign, the prominent designation.

In the large majority of such cases, the signs are fraudulent, and their use would be prohibited by injunction.]

The several questions discussed by the learned court in the case of *Howe* vs. *Searing*, are of great general interest—and the able manner in which the authorities upon either side are reviewed, renders the case of singular value—and the space we assign to its exposition, needs no apology.

The novelty, as well as interest, of many of the inquiries, makes us willing to forget that they seem to have, at best, but a remote connection with the real question in controversy in the case.

That question was simply this: whether the name of a firm, or the style under which a business is conducted, constitutes part of the "good will" of the business, and passes, with a sale of the business by a contract which expressly includes the "good will."

In the case of *Clinton* vs. *Douglas*, the learned vice-chancellor expressly holds that it does. He says:

"The name of a firm is a very important "part of 'the good will' of the business, car- "ried on by the firm.

"A person says, 'I have always bought good "articles at such a place of business—I know "it by that name, and I send to the house of "business identified by that name for that pur- "pose.' That the name is an important part of "the 'good will' of a business, is obvious, "when we consider that there are, at this "moment, large banking houses, and brewing "firms, and others, in this metropolis, which "do not contain a single member of the indi- "vidual name exposed in the firm."

Indeed, if, as is conceded, the "good will" of an establishment includes all those incidents and appurtenances which enhance the probability that the old customers will continue to resort to the old place, and the name and style of the old place, is that which best serves to preserve its character and identity in the minds of those habituated to deal there, but for which, they would be led elsewhere, there can be no escape from the conclusion, that the name of the establishment is not only a component part of the "good will"—but, oftentimes, far the most prominent part, and of the greatest value, and therefore, that the transfer of the "good will" *eo nomine*, necessarily includes the name of the establishment.

The correctness of this doctrine, considered apart

from its character in the light of what may be called "mercantile morality," is not understood to be impugned by the court—although the authority of the vice-chancellor in the case of *Lewis* v. *Langdon*, is spoken of as the only direct authority in its support.

The conclusions upon which the final decision of the case is rested, refer to public policy and the requisitions of commercial probity, as indicated by the provisions of the *Code de Commerce* of France, and a statute of New York, passed, "to prevent persons from transacting business under fictitious names."

By the 21st article of the Commercial Code of France, it is provided that "the name of the associates can alone constitute the firm name" and it is declared that this is intended,

> "To forbid persons, who succeed to the
> "business of a deceased merchant, to continue
> "it under his name.
>
> "Credit is altogether personal. It does not
> "transmit itself by cession or inheritance. It
> "is won by actions and capacity. It is not
> "right, then, that a successor should avail him-
> "self of a fallacious credit, in appropriating a
> "firm's name extinguished by the death of
> "those who gave it value."

And M. Troplong, in his commentaries upon the civil law, alluding to the subject, says:

> "One is astonished that such a contrary "doctrine prevailed formerly in France, and "exists in England. It is a source of fraud "upon a confiding public. The retirement "or decease of one of the associates effaces "the firm name—another must be created "(Troplong *sur le Droit Civile*, Tom. 12, 372.)

The statutes of the State of New York, cited as exponents of the doctrine and policy, which controlled the final decision of the court—were passed in 1833, and 1854. (*Vide* Sess. Laws of 1833, chap. 281, and of 1854, chap. 400.) By the former act, it is provided, that,

> "No person shall hereafter transact business "in the name of a partner (qu. person), not "interested in his firm—and where the desig- "nation 'and company' or 'co.,' is used, it "shall represent an actual partner or partners."

The act of 1854 provides that a partnership name of firms having business relations with foreign countries, may be continued by some or any of the co-partners, their assignees or appointees, provided, a certificate of the fact is filed in the office of the county clerk, and publication of the same be made, as prescribed.

The learned court considers that the principle and purpose of these statutes, in accordance with the provisions of the French law "involve or war-

rant the proposition that the naked sale of the "good will" of a business does not transfer a right to the use of the vendor's name or trade mark," and the injunction is ordered against the defendant, in affirmance of the judgment below.

The learned judge who gave the dissenting opinion in this case, considers the name "Howe's Bakery" as a trade mark simply—and that, as such, it passed by the assignment and transfer of the "good will" it being "if not the thing itself, an integral part of the thing." That the statute invoked by the majority of the court, was inapplicable to the case—the purpose of that, being "to prevent the mischief resulting from the fraudulent use of a fictitious designation—or the word 'Co.' with no physical existence to represent it." That the name "Howe" had a physical existence to represent it—and was therefore not fictitious. That, as a trade mark, it was wholly immaterial whether it represented a real person, or was entirely fictitious and fanciful—and that, even if the statute were applicable, the plaintiff, by his agreement, had placed it out of his power to avail of it, and did not attempt to do so at the trial.

To this last suggestion of the dissenting judge, it may undoubtedly be answered, that it is not competent for a party, by agreement, to prevent the

operation of a general prohibitory statute—and that, if the provisions of such statute be indeed applicable, it is the duty of a court of equity to enforce them by its decision, whether parties see fit to disregard them, or not, in their pleadings or arguments.

When the learned judge speaks of the sign in question "Howe's Bakery"—as a trade mark—he undoubtedly intends, that it has this essential feature of a trade mark—that it is not used to give a *personal credit*—but as the designation merely of an establishment.

In this sense, it bears such an analogy to a trade mark, (which is a designation of a thing, under which it is bought and sold in the market,) as tends to show the inapplicability of the statute provisions to the use of such a name, in the manner in which it was used by the defendant.

But, it seems to us, that the entire inapplicability of the provisions of the statute, to the case in question, results—not from regarding the name used, as a trade mark—or analogous to a trade mark—but from a consideration of the true and only policy of the statute itself.

That policy, obviously, is, to prevent parties from obtaining a personal pecuniary credit upon a false basis—or fictitious representation. To pre-

vent A. who has no partner in business, from obtaining that additional pecuniary credit which might result from his having a partner, by the use of the words "& company," or "Co."—and to prevent parties from using the names of any persons, as partners in their business, who have no connection with it—whether fictitious or real, and whether alive or dead, and thus falsely represent that the pecuniary credit and responsibility of another, is embarked in, and pledged for, the obligations of the concern.

Had the defendant in this action used the name of Howe, the plaintiff, for any such purpose, or if its use by the defendant, as he used it, could have involved any such result, then, the provisions of the statute would be applicable, wholly regardless of any agreement of the parties.

An express agreement by the plaintiff, that the defendant might use his name, as that of a person connected with his business—for the purpose of enlarging his pecuniary credit in its operations—would be void, as within the terms of the statute prohibition. But, it certainly does not appear from the case, that the defendant used the name or sign "Howe's Bakery" for any such purpose—or for any other purpose than to impart a credit or value to the things sold by him in, or from, his establish-

ment, called by that name—a reputation for his bread and cream cakes—which bears no resemblance whatever to that pecuniary credit that enables him to buy flour and sugar. This personal credit, when reared upon a fictitious basis, operates as an imposition upon the public. It is invisible and intangible;—but the credit which is attached to the thing—because sold under a certain name, especially when the thing is of such a nature that its merits or demerits are patent—and daily appealing to the senses of the public, cannot, as we think, be properly regarded as coming within the policy of the statute provisions. The public, certainly, needs no protection against attempts of parties to establish such a credit by the use of any name whatever.

It is not within the original design of this treatise to review the decisions in the law of trade marks of any other courts than those of England and the United States.

But a departure from this design, in a single instance, is suggested by the citation made by the

learned court in the preceding case of *Howe* vs. *Searing*, of the 21st article of the *Code de Commerce*, of France, and the commentaries upon the Civil Law—by M. Troplong—as containing an exposition of the policy, based upon a high mercantile morality, which, it was conceived, the statute of New York was designed to enforce—and which controled the decision of the court in that case.

The case of *Compere* vs. *Bajou et als*—came before the "Tribunal of Commerce" of Paris, and on appeal from that court, before the learned judges of the "Imperial Court of Appeals of Paris" in the year 1854—and is case 3th in vol. 140 of the Court of Appeals Decisions, registered at Paris—June 16th, 1854. m

The circumstances of this case, are, in many respects, so strikingly analogous to those of the case of *Howe* vs. *Searing*, and the case is, in itself, so interesting in character and suggestiveness, that we are induced to give a translation of the judgments of the respective courts in full.

In view of the conclusions in this case, it is manifest that the learned judges in France, cannot consider the prohibition contained in the 21st article of the Commercial Code, or the commentaries of M. Troplong upon the policy of that

prohibition—as at all applicable to a case like that of *Howe* vs. *Searing*.

No previous recital of the facts is necessary, as they are sufficiently set forth in the judgments of the Courts.

> " *Ernest Compere, Glovemaker, of Paris,* vs. *Bajou,*
> " *landholder—late glovemaker, of Grenoble—*
> " *upon the claim for the suppression of the manu-*
> " *facturer's mark.*"

Judgment of the Tribunal of Commerce made February 6th, 1854.

> " *Whereas,* In April, 1841—the defendant,
> " Bajou, assigned to the defendant, Morel, for a
> " price agreed upon, and paid, his business as a
> " glovemaker—and comprised in that assign-
> " ment, not only the fabrication and the
> " accessories used in carrying on the said
> " business, but also the *good will* thereto
> " attached.
>
> " That for such purpose, Morel was autho-
> " rized by Bajou to adopt, exclusively of every
> " other person, the description of successor to
> " Bajou, and to use, as the mark for his gloves,
> " the stamp employed by him as the manufac-
> " turer's mark—being the *fac simile* of his
> " signature.
>
> " It was also agreed that Bajou should not
> " have the right to establish, to purchase, or be
> " a partner in, any manufacture of this nature,
> " either at Paris or any other town in France,
> " with the exception of Grenoble—and, more-

" ever, that he might, in Grenoble, only deal in
" gloves called 'Grenoble manufacture,' and
" marked with the stamp of that town.

" *Whereas*, In November, 1850, after carry-
" ing on the business about 10 years, Morel
" assigned the business to the plaintiff, Com-
" pere, with the same provisions of transfer, as
" had been entered into with him, and for a
" much more considerable price than that
" which he had paid to Bajou, the business, in
" the meanwhile, having become much more
" important and extensive.

" *Whereas*, Since Compere has become owner,
" Bajou, wishing to exercise the right reserved
" to him in his transfer to Morel, manufactured,
" or caused to be manufactured, by the defend-
" ant, Francoz—at Grenoble, a certain quantity
" of gloves, upon which he thought he might
" stamp his signature, his former manufacturer's
" mark.

" *Whereas*, It is not denied that the gloves,
" thus marked, have been sent to, and sold in,
" New York, that being a city which has always
" been, and is still at this day, a market for the
" productions and manufacture in question.

" That it is shown, moreover, that advertise-
" ments have been inserted in a certain number
" of American journals, recommending to the
" public, the name of Bajou as being the cele-
" brated glovemaker, who has re-commenced
" his business, and that these advertisements
" are the acts of Bajou or his agents.

" *Whereas*, Compere, at the same time recog-
" nizing Bajou's right to deal in gloves, called
" 'Grenoble manufacture,' and at Grenoble,
" denies that of affixing his former manufac-

"turer's mark upon them, and of selling them
"by virtue of this mark.

"That it imports therefore to determine, what
"was the mutual intention of the parties to the
"assignment from Bajou to Morel—and the
"value of the reservation made by the latter
"to deal in gloves, called 'Grenoble manu-
"facture,' and stamped with the stamp of that
"town.

"*Whereas*, It results from information col-
"lected by the Tribunal, that the manufacturer's
"mark for this species of industry—the mark
"being advantageously known—is an indis-
"pensable auxiliary for insuring a sale—more
"especially in America—that besides, it is not
"the custom at Grenoble, to mark with one's
"name, the gloves that are manufactured there.

"*Whereas*, In assigning for a certain sum his
"*good will* to Morel, Bajou *really assigned all his*
"*right to the manufacturer's mark*, in which the
"true value of the business consisted—since
"it is upon the mark that the custom depended.

"That it is in vain for Bajou now to pretend
"that he has the right to apply to his present
"manufacture, the manufacturer's mark which
"he had assigned to Morel, and of which Com-
"pere has become the owner.

"That he would, thereby, not only seek to
"resume that which he had assigned, and of
"which he has received the price, but also,
"would endeavor to apply for his own benefit
"the increased custom procured by Morel.

"That it is, in effect, proved, that the annual
"average of Bajou's business was 10,300 dozen,
"and that of Morel had risen to 20,000 dozen."

DAMAGES.

"*Whereas*, Actual injury has been done to "Compere, not only through the sales made by "Bajou, under the manufacturer's mark, which "he had no right to take, but also from the "advertisements in the newspapers, above men- "tioned—that the Tribunal possesses sufficient "grounds for estimating the injury, and it fixes "the same at 6,000 francs."

FRANCOZ.

"*Whereas*, It is shown that Francoz has "only acted by the order, and for the account, "of Bajou, and that nothing forbade him to "fulfil these orders, that therefore, Compere's "claim for damage against Francoz is un- "founded, and Francoz is entitled to be paid "his costs."

MOREL.

"*Whereas*, Morel sold to Compere in good "faith, that which he had bought from Bajou, "that the act whereof the latter is accused, is "entirely foreign to Morel, from whence it fol- "lows, that Compere has no right, as against "him—and he is entitled to be paid his costs."

"On these grounds, the Tribunal, judging "in the first instance, prohibits Bajou from "employing, in future, his name, as a manu- "facturer's mark, upon his gloves, and adjudges "him, by all legal means, even by arrest, con- "formably to the laws of April 17th, 1832, "and December 13th, 1848—to pay to Com- "pere the sum of 6,000 francs, and also the

"expenses—and Compere is to pay the ex-
"penses of Francoz and Morel, because his
"claim as to them is unfounded."

"*Decree of the First Chamber of the Imperial Court of*
"*Appeals of Paris—in the case of* COMPERE *vs.*
"BAJOU *et als.—made and delivered in the*
"*Imperial Court, of Paris, Saturday, June 3d,*
"1854, *at the Public Audience of the First Cham-*
"*ber—when were present and sitting:*

M. DELANGLE, *First President.*

M. DE VERGES, *President.*

Messrs. ESPIVANT,
TRY,
PERRAT,
DE CHEVELLES, *the Elder,*
BERGAGNE,
MOURRE,
NOEL DE PAYRAT,
DURANTON,
BARBOU, and
LENAIN,
} *Counsellors.*

"On appeal—after hearing the conclusions
"and pleadings of Paillet, Counsel for Bajou,
"assisted by Dangin, his Attorney,—Etienne
"Blanc, Counsel for Compere, assisted by
"Arnault, his Attorney, and Blot Lequesne,
"Counsel for Morel, assisted by Drelon, his
"Attorney, and having deliberated thereon,
"according to law,—the court, seeing the simi-
"larity, unites the appeal in chief and the
"incidental appeals by Bajou and Compere,

"from the judgment of the Tribunal of Com-
"merce, of Paris, of February 6th, 1854, and
"allows the same."

"*As regards the appeal in chief*—Adopting the
"grounds of the previous judges, and consid-
"ering, besides, that in the mutual intention
"of the parties, at the time of the agreement of
"the 1st of April, 1841, the right of placing
"upon the gloves which might be manufac-
"tured in the future, the stamp till then em-
"ployed by Bajou, was one of the essential
"ingredients of the contract.

"That the stamp, being the only means of
"establishing the source of the goods, and of
"retaining the custom depending upon it, has
"become, by force of the circumstances, an
"accessory to the business transferred to Morel
"—that it can, consequently, be a matter of
"assignment to a second purchaser.

"That the arrangements adopted by Bajou,
"to make known abroad the trade that he had
"commenced carrying on again, have no other
"object than to take from the actual owners of
"the business, a part of the benefits insured
"to them."

"*As regards the incidental appeal*—Consid-
"ering that agreements between merchants
"ought to be faithfully executed, that the sum
"allowed Compere for damages is not sufficient
"to repair the injury which he has sustained,
"That it behooves, moreover, to take measures,
"fitting to prevent the injury in the future,
"has made and makes void the appeal and the
"subject thereof—and as the damages have
"only been fixed at 6,000 francs, and as inser-

"tion has not been ordered—amending as to
"the same, adjudge Bajou by all legal means
"to pay to Compere the sum of 10,000 francs
"for damages—orders, that the judgment and
"this decree be inserted at the expense of
"Bajou in two French and two American
"papers, at the choice of Compere. The
"judgment as to the rest to take effect.
"Orders the restitution of the amount depo-
"sited on the incidental appeal—adjudges
"Compere in the amount deposited on his
"appeal.

"Adjudges Bajou in the amount deposited
"on his appeal, and the expenses towards all
"the parties, of which the settled expenses are
"as follows: Those caused by Compere 152
"francs 17c. Those caused by Morel 75 francs
"75c.—and this not comprising fees for quali-
"fying, registration of original costs, and
"service of the first decree—award is made to
"each as concerns him to the attorneys who
"have required it, affirming that they have
"advanced the same."

There seems to be no doubt, that a right acquired by transfer, to the exclusive use of trade marks by which articles of manufacture have been designated,

and under which they have been bought and sold, must be predicated upon a transfer of the right to manufacture or sell the article so designated.

If the plaintiff in *Singleton* vs. *Bolton*, could have proved an exclusive right to the medicine that he compounded, by transfer from Dr. Johnson, the original inventor, it is obvious, from the language of Lord MANSFIELD, that he would have been held entitled to protection in the exclusive use of the name "Dr. Johnson's Yellow Ointment." And in the later case of *Perry* vs. *Truffit*, if the complainant, who was, in fact, the possessor of the right to manufacture his compound, by purchase of the secret and recipe from Leathart, the inventor, had not resorted to false representations as to its origin, and no other objections had existed to his right, it is clear that Lord LANGDALE would not have denied the injunction.

The right to protection in the exclusive use of trade marks may be acquired by operation of law, as well as by an express transfer of the right to manufacture or sell.

Upon the decease or bankruptcy of the party possessed of the right, he who, thereafter, becomes lawfully entitled to carry on and continue the business, becomes thereby, vested of the right to the exclusive use of the trade marks of the business.

In the case of *Lewis* vs. *Langdon*, 7 Simons, 421, the trade mark in question consisted of the name of the partnership firm. The partnership had been dissolved by the death of one of the two partners, and the business was continued by the survivor, with a new partner—and they continued the use of the old partnership name as a portion of their trade mark for their merchandise. One of the executors of the deceased partner, thereupon commenced the same business, and also used the name of the old firm as a trade mark.

On a bill filed by the survivor, with the new partner, the Vice-Chancellor (SHADWELL) restrained the executor, by injunction, from the further use of the trade mark.

In *Croft* vs. *Day*—7 Beav., 84—the facts were as follows: Two persons, the one named Day, and the other, Martin, manufactured an article of blacking, put up in bottles, to which was affixed a label with their partnership name ("Day & Martin,") and their place of manufacture, ("97 High

Holborn.") This was their trade mark, under which the article became extensively and favorably known. One of the partners died, and the business was continued by the survivor, who continued the use of the same trade mark. The surviving partner, in his turn, died—and the business was continued, with the use of the same trade mark, by his executor. Thereafterwards, a nephew of the testator, the defendant in the suit, whose name was Day, associated with him, in partnership, a person named Martin, and established a blacking manufactory, using the old firm name as a portion of their trade mark—and also, imitating the labels of the old firm in such a manner, as to the represented place of manufacture, as to produce the impression that the new concern was connected with the old manufacture.

Lord LANGDALE, upon these facts, ordered an injunction to issue.

In *Hine* vs. *Lart*, 10 Lond. Jur. Rep., 106, the complainant claimed a right to the exclusive use of the word "Ethiopian," with certain additions, as a trade mark—as having been acquired by themselves and a former partner deceased—as a designation for black cotton stockings of their manufacture. Objection was made, among other things,

that the personal representatives of the deceased partner, should have joined in the suit.

But the Vice-Chancellor (SHADWELL) said:

> "Although it may be true that the personal
> "representatives of the deceased partner have
> "a right to use the same mark, yet the com-
> "plainants have sufficient right to bring for-
> "ward the case, whether the title is in them
> "alone, or jointly with the representative."

In the case of *Edlestone* vs. *Vick*, 23 Eng. Law and Eq. R., 51, it appeared that one T. had procured a patent for a method of making a solid-headed pin—and thereafterwards manufactured and sold the patented article, until the year 1838.

Upon his packages he used a peculiar kind of pink and green label, containing the words "Patented Pins, exclusively manufactured by T. & Co.," and he had procured engraved plates and blocks to be prepared, for multiplying copies of his label for use. In 1838, T. assigned his patent, together with the good will of his business, to S., who, after carrying on the business, using the same trade mark, and the same character of labels, until 1839, became bankrupt. The assignees in bankruptcy continued the business, in like manner, until 1841, when they made a sale and transfer to *Edlestone* the complainant—and thereafterwards, he con-

tinued the business, using the same label and marks.

The defendant, *Vick*, set up a manufactory of the same article, and used an exact copy, or imitation of the complainant's label and marks.

It was held that the exclusive right was legally vested in the complainant, by virtue of the several assignments, and of the rights lawfully possessed by the assignees in bankruptcy, by operation of the bankrupt law — and the defendant was restrained by injunction.

In the case of *Edlestone* vs. *Vick*, another point arose, and was decided, which may properly be stated here, although the principle involved in it, is more directly connected with that branch of the subject before considered, relating to the legal consequences of a false representation contained in the manufacturer's trade mark.

In the case before cited, of *Flavel* vs. *Harrison*, as we have seen, the court refused to extend its protection to the plaintiff, against the manifestly fraudulent practices of the defendant, because the plaintiff's trade mark, which had been invaded, contained the false representation that the thing designated was patented.

In the case of *Edlestone* vs. *Vick*, at the time of the commencement of the suit, the patent which

had been obtained for the improved method of making solid-headed pins, had expired, so that the label used, was no longer literally true.

But the court held, that inasmuch as a patent had existed for the article, it was not such a fraudulent representation as deprived the complainant of his exclusive right to the trade mark, and his claim for protection against its invasion was not thereby forfeited.

CHAPTER IV.

OF THE REQUISITE COMPONENTS OF TRADE MARKS, TO ENTITLE THE MANUFACTURER OR MERCHANT BY WHOM THEY ARE ADOPTED AND APPROPRIATED, TO PROTECTION IN THEIR EXCLUSIVE USE AS PROPERTY.

The general principles resulting from almost all the cases, in which the question of the requisite characteristics of a trade mark, has been considered, are, perhaps, nowhere more clearly or fully stated, than by the learned judge in the leading American case of *The Amoskeag Manufacturing Company* vs. *Spear*—2 Sand. S. C. R., 599.

"Every manufacturer and every merchant "for whom goods are manufactured, has an "unquestionable right to distinguish the goods "that he manufactures or sells, by a peculiar "mark or device—*in order that they may be* "*known as his*—in the market for which he "intends them, and that he may thus secure "the profits that their superior repute, *as his*, "may be the means of gaining.

"The owner of an original trade mark, has "an undoubted right to be protected in the "exclusive use of all the marks, forms or sym- "bols, that were appropriated, *as designating* "*the true origin or ownership of the article or* "*fabric to which they are affixed*—but he has *no* "*right* to an exclusive use of any words, letters, "figures or symbols, *which have no relation to* "*the origin or ownership* of the goods, but are "only meant *to indicate their name or quality.* "He has *no right* to appropriate a sign or sym- "bol, which from the nature of the fact which "it is used to signify, others may employ with "equal truth, and therefore have an equal right "to employ for the same purpose."

And again, in the previously cited case of *Fetridge* v. *Wells*, the same learned judge, says:

"A name can only be protected as a trade "mark, *when it is used merely as indicating the* "*true origin and ownership of the articles offered* "*for sale.* Never—where it is used to *designate* "*the article itself*, and has become by *adoption* "*and use*, its *proper appellation.*

In the case of *Stokes* v. *Landgraff*, 17 Barb., 608, the Supreme Court of the State of New York, affirms the same general principles, in the following language:

> "The principle is well settled, that a manu-
> "facturer, may, by priority of appropriation,
> "of names, letters, marks or symbols of kind,
> "*to distinguish his manufactures*, acquire a pro-
> "perty therein as a trade mark.
>
> "In all cases where names, signs, marks,
> "brands, labels, words or devices, of any
> "kind, can be *advantageously* used to *designate*
> "*the goods or property*, or *particular place of*
> "*business*, of a *manufacturer* or a *person* engaged
> "in trade, he may adopt and use such as he
> "pleases, *which are adapted to that end*, and have
> "not been before appropriated."
>
> "In respect to words, marks or devices which
> "*do not denote the goods, or property, or particular*
> "*place of business*, of a *person*, but only the
> "*kind or quality* of the article in which he
> "deals, a different rule prevails. No property
> "in such words or devices can be acquired."

Upon a careful review of all the authorities, it will be found that the principles thus stated, have been so often expressly affirmed or tacitly recognized by the courts, in England and America, that they should be regarded as established elementary principles in the law of trade marks.

In the application of these principles to particu-

lar cases, no little difficulty has oftentimes arisen—and it is this, which has elicited more elaborate and learned discussion in the courts, than any other branch of the subject we are considering.

If the reasons which lie at the foundation of these principles, and which constitute the true policy and purpose of the law, in its recognition and protection of property in trade marks, are perfectly appreciated and always kept in view, it cannot be, but that much, if not all, of the apparent embarrassment, in their application to actual controversies, would, of necessity, be avoided. It may not, therefore, be unprofitable, before proceeding to consider the several doctrines which have been engrafted upon those fundamental principles—and the cases in which they have been discussed and determined, to attempt a brief statement of those reasons and a review of that policy.

A right to do anything, or to use anything, connected with trade and commerce—*to the exclusion of all others*, is in the nature of a monoply—and, whatever may be the character of the right, its *exclusive* enjoyment, would seem to be in restraint

of that perfect freedom, which is the life of trade.

Prior to the exercise of the extraordinary powers of courts of equity, for the protection of exclusive property in trade marks, such were undoubtedly the views that were taken of these asserted rights.

In 1754, Lord HARDWICKE, as we have seen, in *Blanchard* vs. *Hill*, while stating that he knew of no instance in which a trader had been restrained by injunction, from using the marks of another, declared, that such an assertion and maintenance of exclusive right, would, in his opinion, be of "mischievous consequence."

It is not a little singular that Lord HARDWICKE, in enforcing his views, states what he obviously regards as an extreme case, but which serves as a complete illustration of the different policy which was very soon after adopted, and has ever since prevailed. He says:

> "An objection has been made that the defen-
> "dant in using this mark, prejudices the plain-
> "tiff, by taking away his customers—but there
> "is no more weight in this than there would
> "be in an objection to *one inn-keeper's selling*
> "*up the same sign with another.*"

Nor is there. But the policy of the law as now

established, resting upon reasons strictly analogous to those which lie at the foundation of the right of property in trade marks, would undoubtedly protect an inn-keeper who had given a name to his house, by which it had become known to travelers, from the assumption of the same name in the same town by another.

In the case of *Howard* vs. *Henriques*, 3 Sand. S. C. R., 725—this precise question arose in the Superior Court of the city of New York, and that very protection was unhesitatingly accorded to the plaintiff by the court, predicated upon his possession of exclusive rights, which Lord HARDWICKE deprecated as a mischievous restraint upon legitimate and honest competition.

The reasons given by the learned court in *Howard* vs. *Henriques*, for protecting the inn-keeper in the exclusive right to the use of the name adopted for his hotel, bear so close an analogy to those, upon which exclusive property in a manufacturer's trade marks is recognized and protected—that we give the language of the opinion:

"Every man," says the court, "may, and ought "to be permitted, to pursue a lawful calling "in his own way, provided he does not encroach "upon the rights of his neighbors, or the pub- "lic good. But he must not, by any deceitful "or other practice, impose upon the public—

"and he must not, by dressing himself in
"another man's garments, and by assuming
"another man's name, endeavor to deprive
"that man of his own individuality, and thus
"despoil him of the gains, to which, by his
"industry and skill, he is fairly entitled. To
"make the application. If a man has, by close
"attention to the comfort of his guests, and by
"superior energy, made his hotel desirable for
"the traveler, and caused its name to become
"popular throughout the land, another man
"ought not to be permitted to assume the
"same name, in the same town—and thus
"deprive him who first appropriated the name,
"of some portion of the fruits of that good
"will, which honestly belong to him alone."

The case of *Marsh* vs. *Billings*, 7 Cushing, 322, is analogous in principle to that of *Howard* vs. *Henriques*.

In the case of *Marsh* vs. *Billings*, decided in the Supreme Court of Massachusetts, the plaintiff had entered into a contract with Paran Stevens, the proprietor of a public hotel in the city of Boston, called the "Revere House," by which the plaintiff agreed to keep good horses and carriages at the several railroad stations, on the arrival of certain trains of cars, for the carriage of passengers with their baggage to the "Revere House"—and in consideration of his doing this, Stevens agreed that the plaintiff's carriages, should be employed in

transporting travelers from the "Revere House" to such stations or elsewhere.

By this contract, the plaintiff was authorized to put the name "Revere House" upon his carriages—and also a badge or label, containing that name, upon the caps of his drivers and porters.

A similar agreement had previously been made between Stevens and the defendant Billings—but had been terminated by mutual consent,—notwithstanding which, the defendant continued the use of the words "Revere House" on his coaches, and on the badges upon his drivers' caps—and caused his drivers to call "Revere House" on the arrival of a passenger train of cars at the stations, and thus divert passengers from the plaintiff's coaches to his.

It was held, upon these facts, that by virtue of his subsisting agreement with the proprietors of the hotel, the plaintiff had an exclusive right to use the name "Revere House," upon his coaches, and upon the caps and persons of his drivers—for the purpose of indicating that he possessed the confidence, and was entitled to the patronage, of the house, and that the use of that name by the defendant, was a violation of the plaintiff's rights, by fraudulently holding himself out to be possessed of that confidence, and entitled to that patronage

—and that an action would lie in such case, without proof of any special damage.

The same question, upon substantially similar facts, in relation to a hotel in the city of New York, known as the "New York Hotel," came before the Superior Court, of that city, and was in like manner disposed of by that court.

No appeal, in this case, was taken from the order allowing the injunction prayed for—and the case is not reported.

Upon the same grounds, similar protection has been extended to the proprietors of places of public amusement—*Christy* vs. *Murphy*, 12 How. Pr. R., 77—and to the publishers of newspapers and magazines.

In the case of *Hogg* vs. *Kirby*, 2 Ves., 226, Lord ELDON did *not doubt* that the publication, by the defendant, of what, upon its face, purported to be a continuation of the magazine of the plaintiff, was such a fraud upon the good will of that periodical work, as to call for the interference of a Court of Chancery.

The same doctrine was held by Vice-Chancellor SANDFORD in *Snowden* vs. *Noah*, Hopkins, 347,—and by Chancellor WALWORTH, in *Bell* vs. *Locke*, 8 Paige, 74. 75

Although, in the last two cases, the injunction prayed for was denied—it was upon the ground that, to entitle a complainant, the publisher of a newspaper, the name of which has been assumed by another, to the interposition of a Court of Chancery, it must appear, beyond reasonable doubt, that the name of the paper is used in such a manner, as is calculated to deceive or mislead the public, and to induce them to suppose that the paper printed by the defendant, is the same as that which was previously being published by the complainant, and thus to injure its circulation and patronage.

(See also, *Spottiswood* vs. *Clark*, 10 Lond: Jur. Rep., 1043·—"The Family Pictorial Almanac case"—decided by Lord COTTENHAM.)

In the case of *Knott* vs. *Morgan*, 2 Keen's Rep., 213—the like protection was accorded by the Master of the Rolls, to the proprietors of a line of omnibuses, to restrain the defendants from running omnibuses upon the same route, having, painted upon them, the like names, words and devices, in the like colors, as those used by the plaintiffs, upon their omnibuses, with the manifest intention of obtaining a portion of the patronage which the plaintiffs had acquired--and thus by a deception

of the public—invading the good will of the plaintiff's business.

The decision of the master of the Rolls (Lord LANGDALE), was affirmed by the Chancellor (Lord COTTENHAM), on appeal.

No just reason can be assigned why, upon similar grounds, this salutary protection should not be extended, in like manner, to every business and occupation that is not positively immoral in its character, or vicious in its tendency.

Thus, we perceive—that the modern doctrine, altogether repudiating the rigid rule of the old law, which withheld protection to property in trade marks, in the apprehension of mischievous consequences resulting from a restraint upon the freedom of trade, is founded upon the assertion that such protection directly produces and encourages that salutary competition, by which the best interests of the public are insured—by the stimulation of efforts for the attainment of excellence, in the certainty of their being met by an adequate remuneration.

Firmly established as is the doctrine which recognizes and protects property in trade marks, and resting, as it does, upon the soundest principles of public policy, and a just appreciation of individual

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right—it should, nevertheless, be borne in mind, that it is a doctrine which maintains the existence of a right in one, to the exclusion of all others—and therefore, is a doctrine, which, from its very nature, should be applied with the extremest caution, so that its application shall never involve a violation of, or departure from, the principles upon which it is founded.

An incautious application of the doctrine, by which, is intended, such an application as departs from the precise purpose of the law, and the true policy which has induced its provisions—must directly and inevitably lead to a transgression of those limits prescribed by a just regard to personal rights and public interests—and to the creation of monopolies which are alike injurious to individuals. and prejudicial to the community.

Throughout the judicial discussions, in the numerous cases that are reported, and which may be said to constitute the body of the law of trade marks, whatever may have been the differences of conclusion, upon questions of application, a most perfect uniformity of sentiment will be found to prevail as to the true purpose and fundamental policy of the law.

It is invariably declared that the law recog-

nizes and protects an exclusive right in the use of trade marks, as property.

First—That the honest, skilful and industrious manufacturer, or enterprising merchant—who has produced or brought into the market, an article of use, or consumption, that has found favor with the public—and who, by affixing to it some name, mark, device or symbol which serves to designate it *as his*—and to distinguish it from all others, has furnished his individual guaranty and assurance of the quality and integrity of his manufacture—shall receive the just reward of his honesty, skill, industry or enterprise—and shall in no manner, and to no extent, be deprived of the same, by another—who, to that end, appropriates and applies to his productions, the same, or a colorable imitation of the same name, mark, device or symbol—so that the public are, or may be, deceived or misled, *into* the purchase of the productions of the one, supposing them to be those of the other.

Second—That the public may be possessed of that assurance, as to the character and quality of the goods that they purchase, and that pledge or guaranty of integrity in the manufacture and the manufacturer, which, in its relation to the public, it is the duty and office of the trade mark to provide, and in no manner and to no extent, be deprived of that assurance, pledge and guaranty, by the assumption, or colorable imitation, of such trade mark by another.

Whenever the question arises, whether any particular name, mark, letters, device or symbol can be appropriated as property—or, rather, whether one who adopts such name, mark, letters, device or symbol, as a trade mark for his productions, is entitled to the protection of the law in its exclusive use—it is obvious that the appropriate answer must depend upon the determination of the question—whether such name, mark, letter, device or symbol, as used to designate—and does in fact, designate the article to which it is affixed, as the production of the manufacturer who has adopted it—thereby serving to identify and distinguish it from all others, as well as to furnish to the public that assurance of origin and ownership of the article, and that pledge of integrity in its manufacture, which such a trade mark necessarily carries with it—or whether—on the contrary, the name, mark, letter, device or symbol, is used to denote, and does in fact, denote, nothing more than the kind, character, or quality of the article, or its name simply, or is a mere offspring of the fancy—suggesting to the mind no idea with reference to the article to which it is affixed.

In the former case, it is a trade mark, which he who adopts it as such, is entitled to treat as property, and to be secured in its exclusive use.

In the latter case, it is a name, mark, letter, device or symbol, which, neither declaring the origin or ownership of the article, nor serving, in any manner, to distinguish it as the production of any particular manufacturer—one may use with equal truth and propriety as another—and therefore, such as all must have an equal right to use,—a right that no prior appropriation can limit or impair.

It follows, therefore, that a name, mark, letter, device or symbol, adopted as a designation for merchandise, must contain within itself, in some form, a distinct declaration to the public, that he who adopts it, is the manufacturer, or lawful representative of the manufacturer of the thing designated—as a fundamental condition to the protection of the law in its exclusive use, as a trade mark.

Were any other name (or whatsoever constitutes the designation) than such as complies with this condition, recognized as a legitimate trade mark—and protected as exclusive property, the apprehensions of Lord MANSFIELD might be realized, and the operation of the law become as injurious, as it is now conceded to be beneficent. Such recognition and protection, would almost inevitably lead to the creation of unjust monopolies in the sale of

particular articles of manufacture—as exclusive, as if secured by a patent,—and more extensive, because subject to no limitation of time.

The paramount importance of this branch of the subject, demands the fullest and most careful consideration.

In the case of *The Collins Co.* vs. *Cowen* (before cited), the learned Vice-Chancellor (WOOD) showing the nicest apprehension of the true character of trade mark property—says—after repudiating the doctrine of property in an abstract name, used as a designation:

> "The rights of property in trade marks,
> "can be said to exist only, and can be tested
> "only, by its violation."

And what is its violation?

When A. adopts or imitates, and applies to articles of his manufacture, the name or mark previously used by B. as a designation for his productions—the wrong consists, in the sale by A. of his goods, as and for the goods of B. But if the name or mark used by B. in no manner serves to indicate the origin or ownership of his productions—and does not expressly or impliedly declare them to be his—it is obvious that A. in imitating such name upon his productions, does not represent them to be those of B.—and therefore, whatever

may be the moral turpitude of the act of A., he has yet committed no wrong of which B. has any right to complain—for it is only to the extent to which A. has falsely represented, either directly or indirectly, that the goods which he sells are those of B. that B. is entitled to redress in damages in a court of law—or the protection by injunction of a court of equity.

When, under a certain name, mark or symbol, which fails altogether to indicate the manufacturer, certain merchandise has acquired a favorable reputation in the market—it is the reputation of the goods—not of the manufacturer—and one who copies or imitates such a name, thereby, falsely represents that his goods are those which have acquired such reputation—not that they are those of any particular manufacturer.

He does not assail the reputation of him who originally adopted the name, because, by refusing to adopt such a name as designates the merchandise as his, he has declined to connect his reputation with it.

He does not deprive him of his lawful gains—because such gains, predicated upon the trade mark, can be justly claimed by him alone, who has given to the public an assurance and guaranty of the quality and continued integrity of his manu-

facture, by a trade mark which discloses its true origin and ownership.

Where the trade mark fails to do this, the public is as much exposed to imposition from the sale of a spurious and inferior article by the original manufacturer, as by another who has copied or imitated the name.

These considerations, connected with the universally conceded purpose and policy of the law, disclose the principles upon which the jurisdiction of the court is rested, in the protection of property in trade marks. A thorough and just appreciation of these principles is essential to their salutary application, in the exercise of such jurisdiction, within the limits prescribed by that purpose and policy.

The simplest case of a trade mark fulfilling the condition of the law, and thereby entitling him who adopts it, to protection in its exclusive use, is, *the name and address* of the manufacturer.

It is precisely to the extent that any name, device or symbol, adopted as a designation for merchandise, is effectual in performing the office of the name and address of the manufacturer, that it complies with the essential requisite to the acquisition of an exclusive right to its use.

In the large majority of the reported cases of

controversies concerning trade marks, the name of the manufacturer or originator of the trade mark in question, has entered into its composition. In such cases, and so far as relates to that portion of the trade mark—and in all cases in which the manufacturer's name and address constitute the entire designation, no question as to the right to exclusive use can arise—except in those rare instances, in which, even such name has been deceptively and fraudulently adopted—or in those still rarer cases, in which the name of the manufacturer of the article, has, by long use, become the actual name of the thing itself—by which alone it is known—and has therefore altogether ceased to perform the office of designating the manufacturer.

These rare exceptions of either character, serve to elucidate and enforce the rule.

The case of *Sykes* vs. *Sykes*, 3 B. & C., 541, is an instance of the fraudulent use by a manufacturer, of his own name.

The plaintiff was a manufacturer of a peculiar character of shot belt and powder flask—for which he had attempted to obtain a patent, but failed by reason of some defect in his specification or claim. As a distinguishing mark for his productions, he

adopted and used his surname, with the word "patent" added—thus, "Sykes' Patent."

Under this name the article became favorably known in the market, and large profits resulted from an extensive sale.

(The objection, which, we have seen, was fatal to the claim of the plaintiff, in the case of *Flavel* vs. *Harrison*—namely, that the trade mark adopted, implied a false representation that the article designated had been patented, seems not to have been taken in this case—though, from the report of the case, it may be inferred that the contrivance of the plaintiff was original and meritorious, and only not patented because of some formal error in the application.)

The name of the defendant was the same as that of the plaintiff, and he established a manufactory of the same articles, made in the same manner, and adopted his own name as a trade mark, by which he commenced their sale.

As the plaintiff had no exclusive right, by patent, to make and sell the article, of course, the defendant could not be restrained from doing the same—but the action was sustained, for the plaintiff's redress, by reason of the fraudulent designation adopted by the defendant.

"Where a man," says the learned judge—(ABBOTT, C. J.,)—"has adopted a particular "mark for his goods, *in order to denote that they* "*are manufactured by him*, an action on the case "will lie, against another, who adopts the same "mark for his goods (even though that mark "be the proper name alike of both parties), if "it be adopted for the purpose of denoting that "the goods of the defendant are manufactured "by the plaintiff—and therefore, for the pur-"pose of selling them, as and for the goods of "the plaintiff."

The case of *Rodgers* vs. *Nowill*, 5 Man. Gr. & Scott, 109, presents another instance, of still more manifest fraud, in the use of the manufacturer's proper name as a designation for his productions.

The plaintiffs were the well known manufacturers of cutlery, at Sheffield, and among other articles of their manufacture, was a superior kind of pen and pocket knife, that had attained a just and extended celebrity.

Upon the blade of these knives, near the handle, they caused a stamp or mark to be impressed, representing the figure of a crown, with the letters V. and R. upon either side of it, and beneath, the words, "J. Rodgers and Sons." By this stamp or trade mark, these knives became known, and were sold in the market.

The defendants were cutlers, in Sheffield, and

had; in their employment, a man named William Rodgers, whose father's name was John—and this William had two brothers in Sheffield, who were also cutlers. The defendants employed William, to manufacture an article of pen and pocket knife, similar in external appearance, to those made by the plaintiffs, and caused the same stamp or mark to be impressed upon them with the addition only of the word "Sheffield," to the words "J. Rodgers & Sons."

It being manifest that the design of the defendants, was, to sell their goods, as and for the goods of the plaintiffs, it was held that the plaintiffs were not the less entitled to redress for, and protection against, such a wrong—because it was attempted through the instrumentality of the proper names of those who were the manufacturers of the simulated article.

To the same effect is the case before cited, of *Croft* vs. *Day*—the plaintiff having succeeded to the exclusive rights of the original "Day & Martin"—and the defendant being a descendant or relative of Day, of that firm, and having associated with him a person of the name of Martin, for the purpose, by the use of the actual proper names of the parties, as a designation for the blacking made

by them to cause it to be believed that their manufacture was that of the original establishment.

In this case, the fraudulent intent was made still more manifest by an imitation upon the label, affixed to the defendant's bottles, of the place of the original manufacturer—"97 High Holborn," which always appeared upon the original "Day & Martin" label.

The case of *Burgess* vs. *Burgess*, 17 Eng. Law & Eq. R., 257—is an illustration of the rule we are considering—in which the circumstances were deemed to be of that character as to require a modification or limitation of the injunction granted, so as to allow the defendant the use of his own name as a portion of his trade mark.

For more than forty years, it appeared, that John Burgess, the father of the defendant, Wm. Robert Burgess, had been engaged in business as an "Italian Warehouseman" at 107 Strand. In 1800 he took his son, the plaintiff, into partnership—and they continued in business, as partners, at the same place, under the firm of "John Burgess & Son," until 1820, when the father died. One chief article of their manufacture, was a certain fish sauce, which they called "Essence of Anchovies," and it was sold and known in the market as "Bur-

gess' Essence of Anchovies"—and those words, as their trade mark, were printed on the labels which were attached to the bottles and packages containing the article.

The defendant, Wm. Harding Burgess, was a son of the plaintiff, and for many years was employed on a salary, upon the business premises of his father—107 Strand.

In 1851, he left the employment of his father, and commenced business on his own account, at No. 36 King William street—and manufactured and sold a fish sauce of anchovies, which he put up and marked "Burgess' Essence of Anchovies."

Over his door he caused to be placed a printed sign, containing the words—"W. H. Burgess, late of 107 Strand"—and on each side of his door he caused to be placed a metal plate, with the following words cut or engraved thereon, "Burgess' Fish Sauce Warehouse—late of 107 Strand."

Upon these facts—the learned Vice-Chancellor—(Sir R. T. KINDERSLEY) ordered an injunction restraining the defendant from using the words "late of 107 Strand"—and also the words "Burgess' Fish Sauce Warehouse, late of 107 Strand"—but refused the injunction prayed for, to restrain the defendant from using the words "Burgess' Essence of Anchovies."

The plaintiff appealed from that portion of the Vice-Chancellor's order, which denied the injunction to restrain the use of the name "Burgess" as a portion of the defendant's trade mark, and on the appeal, the Vice-Chancellor's decree was affirmed. Lord Justice TURNER, in giving the opinion of the court, says:

> "It is clear, no man can have any right to "represent his goods as those of another— "but in all cases of this kind, it must be made "out that the defendant is selling his goods "as the goods of another.
>
> "When a person is selling goods under his "own name, and another person, not having "that name, is using it, it is clear that he is so "using it to represent the goods sold by him- "self as the goods of another.
>
> "But when two persons have the same name, "it does not follow, that because the defendant "sells goods under his own name, and it "happens, that the plaintiff has the same "name, he is selling his goods as the goods of "the plaintiff."

The case of *Thomson* vs. *Winchester*, 19 Pick., 214—is a singular instance, illustrating the principle upon which a manufacturer is protected in the exclusive use of his own name as a designating trade mark for his productions, by the exception of the case, in which the name, from whatever

cause, has ceased to be a designation, identifying the article as his manufacture.

In the cases before cited, of *Singleton* vs. *Bolton*, and *Canham* vs. *Jones*—we have seen that the names, "Dr. Johnson's Yellow Ointment," and "Velno's Vegetable Syrup," were held to be no longer trade marks, to which any one could claim an exclusive right, although the proper names of the original discoverers or compounders of the articles, constituted a portion of the designation—and this, for the reason that these names had ceased to designate the manufacturers—and by long use had become the proper generic name of the articles themselves. But "Dr. Johnson" and "Velno" had then long been deceased, and no one had succeeded to any exclusive rights which they might once have had.

The case of *Thomson* vs. *Winchester* presents a singular instance of the loss of the designating or distinguishing property of the manufacturer's own name, to indicate the origin and ownership of the article, during the lifetime and business operations of the manufacturer himself.

The plaintiff was the alleged discoverer of a method of preparing or compounding certain medicines, possessing certain distinctive qualities and properties—which he denominated "Thomsonian

Medicines." They were thus marked and labeled, upon the packages in which he caused them to be put up and sold in the market.

They acquired a great celebrity, were adopted by a certain class of medical practitioners, and for many years had been very extensively sold and used.

They became universally known, where used, simply as "Thomsonian Medicines."

That became their proper appellation—and they had no other.

No exclusive right by patent was ever obtained by Thomson, the plaintiff—so that the right to manufacture his particular preparations or compounds, was open to the public.

The defendant prepared, and put upon the market, the same character of medicines—(though alleged to be inferior in quality to those of the plaintiff)—and in designating them, used the same name, "Thomsonian Medicines," upon the labels attached to the packages in which they were contained.

The action was brought to recover damages, and to try the title to the name.

It was alleged, that by the use of this name, the defendant sold his medicines as and for the genuine "Thomsonian Medicines" of the plaintiff—but

there was no other proof of this averment than such as arose from the use of the name itself.

Upon these facts, it was held by the learned Chief Justice of the Supreme Court of Massachusetts, (SHAW)—that the jury, who rendered a verdict for the defendant in the court below, were correctly instructed—that, inasmuch as the plaintiff possessed no exclusive right by patent, to manufacture and sell the particular medicines in question—the defendant was at liberty to manufacture and sell the same character of compound—and that if the term "Thomsonian" had acquired a generic meaning, descriptive of a general kind, quality or class of medicines, and the defendant used it as such generic term, descriptive of the kind, quality and class of medicines that he prepared, he had a right so to do, notwithstanding it was the name of the plaintiff, and originally adopted by him to designate the medicines by him first prepared—provided, he did not sell his medicines, as and for those prepared by the plaintiff.

The learned judge says:

> "In a case like this, if the plaintiff makes a "superior article, and desires to secure the "benefit of it, he must be careful so to desig- "nate and identify himself therewith, as to "save himself and the public from mistake "and imposition."

These several cases of exceptions to the general rule--for the reasons which make them exceptional cases—serve to illustrate the character of the principle, upon which the general rule is based.

Certainly, no name, or mark, or symbol, that can be devised, more faithfully fulfills the condition of designating the origin and ownership of the manufactured article—than the name and address of the manufacturer. But where this precise name has been previously adopted, and has become known as the brand or trade mark, for his productions, of the particular person whose name it is—if it be used by another person, who happens to have the same name, as a designation for his productions of a similar character—it is obvious, that by reason of its previous adoption and notoriety, it altogether fails to distinguish and identify the manufacture of the second party—and, on the contrary, that such use must necessarily operate, (as, in such cases, no doubt was the design,) to produce the belief on the part of the public, that they are the productions of the first manufacturer, with whose goods it has become identified.

So too, when the name of the manufacturer, by long use, and the force of circumstances, becomes the real name of the article, not only its proper and generic, but its exclusive appellation, it ceases

to possess that designating quality, which is the fundamental condition of property in the name, as a trade mark.

By far the greater number of reported cases of trade mark controversies, are those in which the designation in question, is composed, in part only, of the name and address of the manufacturer, the remaining portion, consisting of words, letters, forms, figures, names, symbols or devices, which, of themselves, in no manner indicate the origin or ownership of the article, and were not designed to do so—but are expressive of the character, kind or quality of the thing, or, it may be, the name of the thing itself, given it by the inventor or discoverer, as a new thing—or that by which it was previously known—and in these cases, although such names, letters, figures or devices, forms or colors, do not, of themselves, point out the proprietor, yet they may serve as auxiliaries to that portion of the trade mark which performs this office, and become, as it were, so intimately connected with the trade mark, strictly so called, by

mental association, that an imitation of such names, letters, figures, colors, forms or devices, may be quite sufficient to enable the imitator to sell his goods as and for those of the owner of the trade mark, without any use or imitation of the name or address of the proprietor, or of that which serves the like purpose.

In these cases, the application of the principles which must control the determination of the question, to what extent protection can be accorded the manufacturer or merchant, in the exclusive use of such trade mark—becomes a matter of no little difficulty and embarrassment.

It is, accordingly, in these cases, that the law of trade marks has been the most elaborately discussed, its true principles developed, and its purpose and policy defined and declared.

A careful review of these authorities, properly included within that chapter of this work which treats of "the requisite components of trade marks to entitle the manufacturer to protection in their exclusive use," embraces the most important part of the labor of this treatise, and will necessarily extend this subdivision of the general subject to a much greater length than that of any other.

In this review, it will be found, that the doctrines established by the authorities, are generally in

perfect harmony with the settled principles which rest upon, and are referred to, the true purpose and policy of the law.

Some of these cases have already been cited, in other connections. It will now be necessary to consider them in more detail, and at greater length.

THE ENGLISH CASES.

In *Singleton* vs. *Bolton*, 3 Doug., 293—the name claimed by the plaintiff, as against the defendant, who used it, was, "Dr. Johnson's Yellow Ointment."

Although Dr. Johnson was the original compounder of the article, and when first used by him, therefore, the name truly designated its origin and ownership—he had not transmitted or transferred his right, and by long use, it had become the proper name of the medicine.

As to either party to the action, the name designated the article merely—which neither had an exclusive right to make and sell—and did not

denote that it was made by either the one or the other, and, there being no evidence that the defendant sold his compound as and for that of the plaintiff, the claim of the plaintiff to an exclusive right to the use of the name, although it was in proof that he and his father before him, had used it, exclusively, for years prior to its appropriation by the defendant—was denied by a nonsuit, and the nonsuit was affirmed by the Court of King's Bench, Lord MANSFIELD giving the opinion.

In the case of *Canham* vs. *Jones*, 2 Ves. & Bea., 218—the name in question was—"Velno's Vegetable Syrup."

Neither party claimed any right from Velno—who first compounded and named the medicine—but for a long time, the plaintiff had been the sole manufacturer and vendor of the article, by that name.

Like the name, in the case of *Singleton* vs. *Bolton*, it had become by long use, the proper appellation of the medicine, and had ceased to indicate its origin or ownership—but the plaintiff contended, that his prior occupation, entitled him to the exclusive right to use the name, and this was the sole ground of the equity set up in the bill—a demurrer to the bill was sustained, on the same

principle which governed the King's Bench, in the case in Douglas.

In the case of *Perry* vs. *Truffit*, 6 Beav., 66—the name used in common, by the parties, was "Medicated Mexican Balm," but each party used his own surname, as a prefix to the common appellation. The rights claimed by the plaintiff, as we have seen, at the previous citation of the case, were denied, upon proof of fraudulent representations on his part—but, in the opinion given by the master of the rolls, it was manifestly the conviction of the court, that no exclusive right could be acquired to the use of the words in question, upon the basis of a prior adoption or appropriation—and that, unless it could be proved, *aliunde*, that the defendant had sold his "Medicated Mexican Balm," as and for that prepared by the plaintiff, he had invaded no right of the plaintiff—that those words, just as truly described the medicine of the one party, as they did that of the other. That "Balm" was the general, and "Mexican Balm" the specific name, and the word "Medicated" was a denotement of its quality merely.

In the case of *Millington* vs. *Fox*, 3 Myl. & Cr., 313—it appeared that the defendant was a manu-

facturer of steel, which he caused to be stamped with the words "Crawley Millington" in the supposition that those words were descriptive of that particular kind or quality of steel, and had become the proper name of the article.

Had such been the fact, it is manifest from the language of Lord COTTENHAM, that the case would have been disposed of, upon the principle which controlled the decisions in *Douglas* and *Vesey & Beames*. But it appeared, at the hearing, that the name was that of the plaintiff, and indicated him, as the original manufacturer of the kind or quality of steel, upon which it was stamped—and a perpetual injunction was therefore granted against the defendant.

In *Morrison* vs. *Salmon*, 2 Man. & Gr., 385, the plaintiff claimed that he had prepared and sold for many years a certain medicine, put up in boxes and marked and labeled "Morrison's Universal Medicine," and that under this name the medicine had acquired a great reputation, with the public—and that the name identified and distinguished it, as his manufacture.

The defendant prepared and sold a medicine, which he put up and marked and labeled in a similar manner—using the same name.

The name had not become generic—and the manifest intent of the defendant was to pass off his medicine, as that prepared by the plaintiff.

A motion in arrest of judgment, upon a verdict for the plaintiff, was denied.

The case of *Day* vs. *Binning*, 1 Coop. Ch. R., 489, was another case, growing out of the alleged exclusive right of the plaintiff to the use of the words or name "Day & Martin," and "97 High Holborn" as a designation for the article of blacking.

It was disposed of, by an application of the principles recognized in the preceding cases—as was also the case of *Croft* vs. *Day*, 7 Bea., 84, brought to maintain the same alleged exclusive rights, and before cited.

In the case of *Gout* vs. *Aleplogu*, 6 Bea., 69, and 1 Chitty's Gen. Pr., 721—it appeared, that the plaintiff, Gout, was the manufacturer of watches, which he sent to the Turkish market, where they had acquired a high reputation.

They had become known by the names and devices which he caused to be engraved upon them. These consisted of the name of Gout, in Turkish characters—and the Turkish word *Pessendede*,

which signifies *warranted* or *approved.* In addition to these were the plaintiff's initials *R. G.*, and a crescent in relief—as also a sprig and crescent.

The defendant procured one Parkinson, to manufacture watches for him, and caused to be engraved upon them, in the same place where the marks of the plaintiff were engraved upon his watches, the words—*Ralph Gout*—and *Pessendede*, in Turkish characters, and consigned them to Constantinople—where they were sold as and for the watches of the plaintiff. An injunction was granted by the Vice-Chancellor, (SHADWELL,) restraining Aleplogu from causing to be made, and consigned to Constantinople, and Parkinson from manufacturing, watches—with the name of the plaintiff upon them, in any form—or any of the words or devices used by him upon his watches.

Of a similar character is the case of *Ransome* vs. *Bentall*, 3 Law Jour. Rep., N. S., 161.

The parties were manufacturers of ploughs—and those of the plaintiff having acquired celebrity, and being distinguished as his, by the stamp of his name, and other marks, upon them, the defendant stamped an imitation of the plaintiff's marks upon his plows, with the design to pass them off as the manufacture of the plaintiff.

He was restrained by injunction.

To the same effect, were the recent cases of *The Collins Co.* vs. *Brown* and *The Collins Co.* vs. *Cowen*—3 Kay and Johns., 423 and 428—the plaintiffs being manufacturers of edge tools at Hartford in the State of Connecticut, upon which they stamped their firm name with other marks of designation—and sent them for sale in the English and other European markets. The defendants manufactured the same character of edge tools in England—and stamped them with the same name and mark—and sent them to the same markets in which the productions of the plaintiff had acquired celebrity.

The Vice-Chancellor (Wood), in an opinion to which we have already alluded, and to which we shall have occasion again to refer, ordered an injunction to issue, against the defendants.

See also—*Welch* vs. *Knott*—4 Kay & Johns., 747; *Crawshay* vs. *Thompson*—4 Man & Gr., 367; *Pierce* vs. *Franks*—10 Lond. Ju. Rep., 25; *Hine* vs. *Lart*—10 Lond. Ju. Rep., 106; *Blofield* vs. *Paine*—4 Barn. & Adol., 410.

THE AMERICAN CASES.

A review of the American authorities, in which the question has arisen, as to what may be lawfully appropriated to exclusive use, as a trade mark, and as such, become entitled to protection, demands a large space in the pages of a treatise which is designed as an analysis and digest of the law.

The reports of the judicial discussions in these cases, are full and elaborate—and the student who seeks to become acquainted with the principles and policy of the law of trade marks, will freely acknowledge his paramount indebtedness to the learned disquisitions of the American judges—and chiefly to those of the State of New York, in whose courts, the most important cases have arisen.

We are not aware that any case in the American books, will be found, of an earlier date than 1844. In that year, the controversy arose, growing out of the alleged piracies committed by various parties in the United States, upon the rights of John and William Taylor, manufacturers, in England, of a kind of thread, which they denominated "Taylor's Persian Thread," and for the sale of which, to

wholesale dealers, they had established agencies at New York, Boston, Philadelphia and New Orleans.

We have already had occasion to cite the several cases in this litigation, in the Court of Chancery—and in the Court of Errors of New York—and in the Circuit Court of the United States in Massachusetts.

In these cases, the general and fundamental principles of the law, are fully considered and maintained—but they did not involve the particular question, of what may, and what may not, be appropriated as a trade mark—or, what must be the characteristics of a designation for merchandise, to entitle the manufacturer to protection in its exclusive use.

The same may be said of the case of *Coates* vs. *Holbrook*—2 Sand. Ch. R., 586—which occurred in the succeeding year. This also was a spool cotton thread case, the plaintiffs being manufacturers at Paisley, in Scotland, and the defendants, agents of one Malcolm McGregor, of Newark, in New Jersey, who manufactured a simulated article of cotton thread, and passed it off as the manufacture of the plaintiffs, by an imitation, or rather an exact copy, of their trade mark, in a manner (to use the language of the Vice-Chancellor) "too barefaced to be questioned."

The profession is greatly indebted to the learned Vice-Chancellor (SANDFORD) for an elaborate note appended to his report of this case—which is thus introduced:

> "The great importance of the subject of trade "marks and symbols, and the growing interest "which it has excited, have induced the author "to collect, in a note, at the end of this case, "the recent authorities relative to this branch "of the law, both here and in England. Since "the decision of *Coates* vs. *Holbrook*, the case "of *Taylor* vs. *Carpenter*, cited in the opinion "of the Court, has been decided, on an appeal "from the Chancellor's decree, in our court of "last resort, so that several of the propositions "held in the case of Coates, are now definitively "settled in this state."
>
> "The great interest felt in these questions, "by the manufacturing and commercial world, "is illustrated by the fact, that the judgment "of the Assistant Vice-Chancellor, in *Coates* vs. "*Holbrook*, was noticed at some length, in the "London Times, soon after it was pronounced, "and was stated at large, in the Liverpool "newspapers."

The only American case, besides that of *Taylor* vs. *Carpenter*, included in the note of the learned Assistant Vice-Chancellor—or which had then arisen—is that of *Partridge* vs. *Menck*—which we have before cited.

The subsequent cases—we must now proceed to review—and that review will comprise, of necessity, the greater portion of our remaining pages.

The first and leading case, and that which deserves the most careful consideration, is—*The Amoskeag Manufacturing Company* vs. *Spear*, 2 Sand. Sup. Ct. R., 599.

The plaintiffs were a corporation, engaged in the manufacture of cotton goods—at Amoskeag Falls, in the State of New Hampshire.

The principal article made by them, was a kind of cloth, called "tickings," and by much care and skill, and at great expense, they had brought this article to such a state of perfection, that the best quality had obtained a high reputation throughout the country.

For many years prior to the commencement of the action, they had used a printed label, affixed to the outside of each piece of ticking of the first quality made by them, for the purpose of designating it as such—and this label, contained the separate letters, in large conspicuous capitals, A. C. A.—so that this quality of tickings, of their manufacture, became commonly known in the trade, as the "A. C. A. tickings." The entire label, consisted of the following words, and letters, and thus stamped—

"AMOSKEAG MANUFACTURING COMPANY.
Power Loom.
Yds.—
A. C. A.
Amoskeag Falls, N. H."

The words were printed in red colors—the label had a fancy border—square externally and elliptical within—and the words contained in the upper and lower lines of the label, were printed in a line corresponding with the interior curve of the border.

It was averred by the plaintiffs that the letters "A. C. A." were intended to denote, as follows—"A. C," Amoskeag Company—and "A" first quality.

The defendants were extensive dealers in domestic goods, and among others, in an article of ticking, manufactured at Lowell, in Massachusetts. To this, they caused to be affixed, a label, and the same had been used by them for five years before the action was brought, corresponding with that of the plaintiffs in size, color, fancy border, position, general arrangement and size of the letters—and also, containing in large capitals—the letters "A. C. A."

The words of the defendants were, as follows, and thus arranged.

"LOWELL PREMIUM TICKINGS.
Power Loom.
Yds.—
A. C. A.
Warranted Indigo Blue."

It was averred, that notwithstanding the difference in the words of the defendants' label—its imitation of the plaintiffs was so close, and its general resemblance so perfect—that, by means of their label, the defendants had sold, and were then selling, their tickings, as and for the genuine tickings of the plaintiffs' manufacture—to the great injury of the plaintiffs' reputation, as well as to their pecuniary damage.

A preliminary injunction was granted, restraining the defendants, according to the prayer of the complaint, from using on their tickings, any label, such as that which they had used—or any label, similar to the plaintiffs, or an imitation of it—*or having thereon, the letters "A. C. A."*

The answer of the defendants denied that the letters "A. C. A." in the plaintiffs' label, were used to denote, or were understood by the trade, to denote, "Amoskeag Company" and "first quality"—but that they referred, altogether, to the quality of the tickings—and it denied that the plaintiffs' tickings were known as the "A. C. A. tickings," without the addition of the name or place of manufacture,—but that they were known as the "Amoskeag A. C. A. tickings,"—and that they were known as the "Amoskeag A. C. A. tickings,"—in

like manner as their own were known as the "Lowell Premium, A. C. A. tickings."

The answer also averred, that all manufacturers of tickings, used letters to denote the different qualities, and that, in every case, the name of the maker, or place of manufacture, was added, to enable the public to distinguish between articles of similar quality, made by different manufacturers.

The answer also denied that the use of the defendants' label was intended to enable them to sell their tickings, as those manufactured by the plaintiffs—or that it had produced that result,—and admitting that they had sold their tickings, as the genuine "A. C. A. tickings," they averred, that it was always with the designation that they were "Lowell," and not "Amoskeag," tickings.

Upon these facts and averments, two questions arose:

First. As to the defendants' imitation of the plaintiffs' trade mark, otherwise than by the use of the letters "A. C. A." and

Second. As to the use of those letters.

In relation to the first question, the following is stated as the conclusion of law of the court:

> "That an injunction ought to be granted,
> "whenever the design of a person who imitates
> "a trade mark—his design, either apparent or

" proved,—is to impose his own goods upon the
" public, as those of the owner of the mark—
" and the imitation is such that the success of
" the design is a probable or even a possible
" consequence — and that an injunction must
" be granted whenever the public is in fact
" misled, whether intentionally or otherwise,
" by the imitation or adoption of marks, forms
" or symbols, *which the party who first employed*
" *them, had a right to appropriate.*"

Enforcing the great importance of the qualification of this proposition, contained in the last words, italicised—the court directly proceeds to say:

" It must not, however, be inferred from
" these remarks, that an injunction ought to be
" granted whenever there exists such a resem-
" blance between trade marks, as may induce
" a belief in the mind of the public, that they
" belong to, and designate the goods of, the
" same trader or manufacturer."

" It is not enough that the public may be
" misled, or has been misled,—as already inti-
" mated, the resemblance must arise from the
" imitation or adoption, of those words, marks
" or signs, which the person who first employed
" them, had a right to appropriate, as indicating
" the true origin or ownership of the article or
" fabric to which they are attached — and the
" resemblance, where it induces error, and
" gives a title to relief, must amount to a false
" representation, express or implied, designed
" or accidental — of the same fact. A trade
" mark is frequently designed to convey infor-

" mation as to several distinct and independent
" facts—and therefore, contains separate words,
" marks or signs, applicable to each—thus
" indicating, not only the origin or ownership
" of the article or fabric to which it is attached,
" but also its appropriate name, the mode or
" process of its manufacture, and its peculiar or
" relative quality.

" It is certain, however, that the use, by
" another manufacturer, of the words or signs,
" indicative only of these circumstances, may
" yet have the effect of misleading the public,
" as to the true origin of the goods. But it
" would be unreasonable to suppose that he is
" therefore precluded from using them, as an
" expression of the facts which they really
" signify, and which may be just as true in
" relation to his goods, as to those of another.

" Purchasers may be deceived. They may
" buy the goods of one person as those of ano-
" ther; but they are not deceived by a false
" representation. They are deceived because
" certain words or signs suggest a meaning to
" their minds, which they do not in reality bear,
" and were not intended to convey."

Applying these principles to the facts of the case, as presented, the question was—whether the defendants had imitated that portion of the plaintiffs' trade mark, which they had a right to appropriate, for the purpose of securing their title as manufacturers, namely, those parts that served to indicate the true origin and ownership of the

fabric—being all of the label, excepting the letters "A. C. A."

Upon this the court says:

> "Upon comparing the original trade mark "of the plaintiffs, with that used by the "defendants, I find it impossible to doubt— "that the latter is a designed, elaborate, imita- "tion of the former. They are the same in "form, size and color. It is only on a very "close inspection, that the ornamental border "can be at all distinguished.
>
> "The variations in the words, scarcely impair- "ing, are quite insufficient to destroy, a general "resemblance, that was calculated to deceive "the public, and by which, the evidence is "abundant and conclusive, *to* show that many "dealers have been, in fact, deceived.
>
> "I cannot escape from the conviction, that the "real motive of the defendants, was, an "expectation of the benefits to result to them- "selves, from the error of purchasers, and from "the imposition upon purchasers, that subordi- "nate dealers would be tempted and enabled "to practise."

It was urged by the defendants, that the substitution in their label of the words—"Lowell Premium Tickings" for those of "Amoskeag Manufacturing Company" in that of the plaintiffs, provided an effectual security against the imposition of dealers and the mistakes of purchasers—but the court says:

LAW SCHOOL

"I cannot think so—I cannot think that
"this security is provided—for, not only may
"the substituted words, as is proved to have
"been the case, from their position, wholly
"escape the attention of the purchasers, but
"when read, they may not have the effect of
"altering the belief that the general resemblance
"of the labels is calculated to produce. The
"words are exceedingly ambiguous. They are
"not a declaration that the tickings are not
"manufactured by the plaintiffs, but are
"entirely consistent with the supposition that
"they are."

Thus the first question is disposed of by the court—and the injunction is retained as to every portion of the defendant's label—*except as to the letters "A. C. A." or a colorable imitation thereof.*

The second question, namely, that of the alleged right of the plaintiffs to appropriate those letters in their trade mark, so as to entitle them to protection in their exclusive use,—was, practically—the important question in the case.

Applying the principles before enunciated, to the consideration of the question, its determination as the court says,

"Must depend upon the fact, whether the
"plaintiffs have shown an exclusive right to
"the use of these letters, upon their own
"tickings—as *declaratory of their right as man-*
"*ufacturers.* If they have, the prohibition must

" be retained—but if the letters "A. C. A.,"
" are merely indicative of the relative quality
" of their tickings, it must be expunged. As
" the plaintiffs could not have acquired by
" their prior occupation, an exclusive right in
" the use of the words "first quality" or "super-
" fine," they cannot have acquired a right by
" similar means to an exclusive use of any
" letters, marks or other signs, which are
" merely a substitute for the words, and
" intended to convey the same meaning. It is
" immaterial whether words, letters or figures,
" or any other signs, are used, if the single
" fact which they are used to indicate or
" declare, is a truth that other manufacturers
" or dealers have an equal right to express and
" communicate."

Upon this question of fact, the Court then proceeds to review the evidence, and arrives at the conclusion, the correctness of which cannot be doubted, that the letters "A. C. A." were used to designate the best quality of tickings—that it was such purpose which they answered, and no other.

The Court then says:

" It is doubtless true, as stated in the com-
" plaint, and sworn in many of the affidavits,
" that the tickings of the plaintiff, to which
" the letters "A. C. A." in their label, are
" attached—have, for many years, been known
" in the market as the "A. C. A. tickings"—
" but this fact, neither alters the meaning of
" the letters, nor takes from others the right to

> " employ them. If the letters designate only " the quality of the goods, and not their origin " or ownership—the tickings of the defendants, " if the best quality of those which they " sell—are, as truly "A. C. A. tickings" as " those of the plaintiffs."

And the court thereupon dissolved that portion of the injunction which restrained the defendants from using the letters "A. C. A." in their labels.

The principles laid down by the learned court in this case, may be regarded as established.

It is true that a partial dissent from some of the conclusions, has been expressed by a learned judge of the same court, in a subsequent case, to which we shall have occasion to refer—yet they have been repeatedly recognized and affirmed in subsequent decisions, of the same, of co-ordinate, and of appellate tribunals—and have never, as we are aware, been contravened or departed from, in any case, involving circumstances requiring their rejection or application.

Portions of the language made use of by the learned judge, in his elaborate disquisition, have been criticised, as inconsistent with some of the conclusions—but we believe it will be found, upon a more careful study of the phraseology, that such appearance of inconsistency, results from an inattention to, or an imperfect appreciation of, the

force and significancy of the qualifying terms, with which the language in question is always connected.

The principles which we consider justly deducible from this leading authority, may thus be stated:

First—That a trade mark, adopted by a manufacturer or merchant, for his goods, to be clothed with the attributes of property, entitling the appropriator to protection in its exclusive use, must, by word, letter, sign, figure or symbol, designate the true origin or ownership of the goods.

Second—That where a trade mark is violated, the essence of the wrong done, consists in the sale of the goods of one manufacturer, as and for the goods of another — and therefore, that such violation can only be predicated of a copy or imitation of a trade mark, or those portions of a trade mark which truly designate the origin or ownership of the goods.

Third—That a similarity between two trade marks, used by different manufacturers for their goods, although of such a character as to induce a belief in the mind of the public, that they belong to, and designate the goods of the same manufacturer or trader—is not, of itself, sufficient ground for a prohibition of the use of such trade mark, by him who did not first adopt it. That similarity, to entitle the originator to the protection of the law, must be such as to amount to a false representation, not alone, that

the two articles have the same origin, but that the goods to which the simulated mark is attached, are the manufacture of him who first appropriated the trade mark.

Fourth—That although, by the long continued use of certain words, letters, marks or symbols, which do not, of themselves, and were not designed to indicate the origin or ownership of the goods to which they are affixed—the goods so marked, and because so marked, have become known as those of the manufacturer who first used them, such fact cannot alter the original meaning of the words or symbols, or the intent with which they were first used, as denoting the name of the thing, or its general or relative quality, or take from others, the right to employ them in the same sense.

Fifth—That a violation of a trade mark, consisting of a false declaration, by a copy or imitation of those parts of the trade mark imitated, which indicate the true origin or manufacture of the goods—it is not essential to the interposition of judicial restraint, that the imitation should be exact or perfect. Though a limited and partial imitation, containing variations, that a comparison with the original would instantly disclose—it may yet be manifest, that a resemblance exists, which was designed to mislead, and which has actually misled, the public, or probably, or even possibly, may do so, in that particular which constitutes the wrong.

Sixth—That the name and address of the manufacturer, used by him as a trade mark, may have

added to, and connected with it, some peculiar device, vignette, emblem, symbols, forms or figures, adopted as auxiliaries to the name and address, in declaring the true origin and ownership of the merchandize—and a wrongful violation of such a trade mark, may be accomplished, even though the name of the original manufacturer be omitted, and that of the imitator be substituted—by such an imitation of the peculiar device, vignette, emblem, symbol, form, color or figure, alone, as indicates a design, and is calculated to, mislead and deceive the public, as to the true origin and ownership of the goods.

Seventh—That a silent acquiescence by the manufacturer, though for five years' continuance, in an unlawful violation of his trade mark, by another, cannot operate as a surrender of his exclusive rights.

That although the consent of the manufacturer may be inferred, from his knowledge and silence, yet that such consent, whether express or implied, when purely gratuitous, may be, at any time withdrawn—and when implied by silence, terminates when the silence terminates—it being no more, in fact, than a license, revocable at will.

[The statement that the principles of law deducible from the case of *The Amoskeag Manufacturing Company* vs. *Spear*, have been recognized and affirmed by subsequent American decisions, should have been qualified, by the exception of the seventh and last conclusion of law, in the order in which are above stated. We are not aware that the principle involved in that conclusion has arisen in any other American case, and it is certainly not in accordance with the English authorities.

A silent acquiescence in the use or imitation of his trade mark by another—even for a period of three or four months, his knowledge being proved or conceded, was deemed by the Chancellor, in the case of *Flavel* vs. *Harrison*, (19 Eng. Law and Eq. Rep., 15)—sufficient ground for withholding equitable relief to the manufacturer, until the establishment of his legal title.

It is quite manifest, that the long acquiescent use by a manufacturer, of the trade mark of another, may, and indeed must, inevitably result in utterly depriving the trade mark in question, of its office of designating the merchandise as that of the original manufacturer. When it ceases to serve this purpose, surely he who was at first a wrongful

simulator, cannot be said to be longer guilty of the wrong, which consists in passing off his goods as and for those of the original owner of the trade mark—and this being the sole ground upon which a claim of right to exclusive use can be maintained, to allow such claim, after such acquiescence, with such consequent result, would seem to be inconsistent with the purpose and policy of the law.]

In the case of *Stokes* vs. *Landgraff*, 17 Barb., 608, decided at a special term of the Supreme Court of New York, and subsequently affirmed by a full bench, the leading principles involved in the case of *The Amoskeag Manufacturing Company* vs. *Spear*, came directly under consideration—and the decision was, in all respects an affirmance of, and in accordance with, those principles.

The plaintiffs were glass manufacturers, at *Clyde* village, in the town of *Galen*, and county of *Wayne*, in the State of *New York*. The defendants were glass manufacturers at Cleveland, in the county of Oswego.

Upon the boxes and packages containing the glass, manufactured by the plaintiffs, they branded

or stamped, in addition to their name and place of manufacture, one of the several words, following: "Galen," "Lake," "Clyde," "Cylinder," "Wayne," "New York,"—and the plaintiffs averred in their complaint, that these words were adopted and used, by their predecessors and by themselves, to designate the several qualities of the glass manufactured by them—(that is to say, "Galen," to denote the first quality, "Lake," the second, "Cylinder," the third, "Wayne," the fourth, &c.,) *and to distinguish the glass, manufactured by the plaintiffs, from that manufactured by other persons, or at other manufactories.*

The complaint further averred, that the defendants manufactured window glass of an inferior quality and value to that manufactured by the plaintiffs, and caused the same to be put up in boxes and packages, which they marked or branded with one or other of the same words used by the plaintiffs, and "with intent to cause it to be believed by purchasers, builders and the public, that such glass was manufactured at the glass works belonging to the plaintiffs, and to enable the defendants to sell their glass as and for the manufacture of the plaintiffs."

The answer of the defendants, while admitting the use by them, upon their boxes and packages

of glass, of the same words used by the plaintiffs, denied that those words were used by the plaintiffs, "*to distinguish the glass manufactured by them, from that manufactured by other persons, or at other manufactories*" and averred that they were used by the plaintiffs and defendants alike, solely to distinguish the several qualities of their glass.

Annexed to the answer, were copies of the several marks and brands used by the plaintiffs and defendants—from which, it appeared that the entire label or mark in each, consisted of—1st, the name of the manufacturer, 2d, the place of manufacture, 3d, the name or word denoting the relative quality, 4th, the size and 5th, the quantity of glass contained in the box or package.

Thus, the plaintiff's—"Stokes—Clyde, Cylinder 8×12—50 feet" or "Stokes, Clyde, Galen—8×12 50 feet"—and

Thus, the defendant's—"Landgraffs—Galen, 8×12, 50 feet" or Landgraffs, Cylinder, 8×12, 50 feet.

It appeared by the evidence, at the hearing, that it was the practise of manufacturers of glass, to designate the several qualities by names similar to those used by the parties in this case, and not by words, or figures, expressing, in terms, the relative qualities.

Upon the material issue made by the averment of the complaint and denial of the answer, that the words in question were used to designate the particular manufacture of the plaintiffs, and to distinguish it from all others, the conclusion of fact upon the evidence, is thus stated by the court—that,

> "The employment of those words is simply
> "to denote quality, and that dealers in glass
> "must so understand it."

The conclusions of law as presented in the case of "*The Amoskeag Manufacturing Company in Spear*" and the other cases cited by the court, are then affirmed, as applicable to the facts, and are thus clearly stated:

> "The principle is well settled, that a manu-
> "facturer may, by priority of appropriation of
> "names, letters, marks or symbols of any kind,
> "*to distinguish his manfacture*, acquire a pro-
> "perty therein, as a trade mark—for the inva-
> "sion of which an action for damages will lie,
> "and in the exclusive use of which, he may
> "have protection, when necessary, by injunc-
> "tion.
>
> "The wrong, in such a case, for which those
> "remedies are given, consists in misrepresenting
> "to the public, by the use of that trade mark,
> "goods or wares of another person, as having
> "been manufactured by the *true proprietor of*
> "*that mark*—and thereby depriving him, to a

"greater or less extent, of the benefit of the "good will of his establishment, and the repu- "tation of his articles. The same principle "extends to all branches of business, where the "like reason for its application exists.

"In all cases, where names, signs, marks, "brands, labels, words or devices, of any kind, "can be advantageously used, to *designate the* "*goods or property, or particular place of busines* "*of a person*, engaged in trade or manufacture, "or any similar business, he may adopt and "use such as he pleases, *which are adapted to* "*that end*, and have not been before appropri- "ated, and no other person, can lawfully "imitate them, and by *that means*, sell his own "goods or property, or carry on his business, "as the goods, property or business of the "former.

"In respect to words, marks or devices, "which *do not denote the goods or property, or* "*particular place of business of a person*, but "only the nature, kind or quality, of the article "in which he deals, a different rule prevails— "no property in such words marks or devices "can be acquired. There is, obviously, no "good reason why one person should have "any better right to use them than another. "They may be used by many different persons, "at the same time, in their brands, marks or "labels, on their respective goods, with perfect "truth and fairness. They signify nothing, "when fairly interpreted, by which any dealer "in a similar article could be defrauded. It is "possible that consumers of glass may, to some "extent, be led to believe, by the use of the "words in the defendant's marks or brands,

"that the boxes or packages upon which those "marks or brands appear, contain glass, manu- "factured at the plaintiff's factory—but a "similar deception might be produced, by the "use by both parties—of any words, repre- "senting quality merely.

"If an impression is derived from the words "which was not intended to be made by them, "and different from their natural meaning, and "injury thereby results, it must be attributed, "solely, to the practise referred to, in designat- "ing qualities, by which the true qualities "must necessarily, to a considerable extent, be "concealed from the consumers."

Upon those conclusions of fact and of law—the injunction against the defendants was dissolved.

The case of *Clark* vs. *Clark*, 25 Barb., 76, illustrates the principle that an imitation solely, of the devices and their arrangement, which are used in connection with the name and address of the manufacturer—where the proper name and address of the imitating manufacturer are substituted for those contained in the original trade mark, may yet be such a fraudulent representation that the goods of the one are in fact the manufacture of the other, as to amount to an invasion of the right of pro-

perty in the original proprietor, and demand the protection of the law.

The plaintiffs were manufacturers of cotton thread at Glasgow, Scotland.

This thread was wound upon wooden spools, on the ends of which they affixed their labels. This label was adopted by them as their trade mark and had been so used since 1843.

The label consisted of four concentric circles—the inner one of gold—the next of silver—the third, black with gold letters, and the fourth, of silver—and the whole was encircled by two concentric black lines.

In the inner circle, was the number of the cotton—in the next, were the name, and address, of the manufacturers—thus, "J. Clark, Jr., & Co., Mile End, Glasgow," the name being at the top, and the address being at the bottom. In the next circle, were the words "Six Cord Cabled Thread —warr'd 200 yards"—and, in the outer circle, were the words "Sole Agent, Wm. Wheelright, New York."

The defendants were manufacturers of the same article at Seed Hill, Paisley, in Scotland—under the firm of J. & J. Clark & Co., and George Clark, one of the defendants, was their agent in New York. The label used by them, on their spools of

cotton thread, consisted of the same number of concentric circles, in the same colors, arranged in the same order, with the same letters in black and gold—the same number for the inner circle—their own name and address in the next circle, thus,—"Clark & Co., Seed Hill, Paisley." The name at the top, and the address, below—the same words, "Six Cord Cabled Thread—warr'd 200 yards" in the next circle, precisely as in the plaintiffs—black ground with gold letters—and in the next circle the words—"Sole Agent, George Clark, New York."

Upon these facts, the court say, that it was the evident design of the defendants so to prepare their trade mark, that all but the most cautious customers would be misled—and even such as knew that Wheelright had been the agent of the plaintiffs, might naturally suppose that George Clark had been substituted in his place; that the firm name of the original manufacturers had been changed, and that they either had two places of manufacture, or had removed from Glasgow to Paisley.

> "Ownership in his trade mark is allowed to
> "the manufacturer," say the court, "that he
> "may have the exclusive benefit of the repu-
> "tation which his skill has given, to articles
> "made by him—and that no other person may

" be able *to sell to the public as his, that which is* " *not his.*"

" An imitation of his mark, with partial " differences, such as the public would not " observe, does him the same harm as the entire " counterfeit.

" If the wholesale purchaser most conversant " with the marks, is not misled, but the small " retailer or consumer is, the injury is the same " in law, and differing only in degree.

" A right of action must exist for the last, as " well as for the first.

" If all consumers do not discriminate, it " would be indifferent, even to the wholesale " buyers, from which of the two they bought — " and thus, the *extent*, also, of the injury, would " be as great as if they, also, were deceived."

In accordance with these conclusions, an injunction was ordered—and the decree of the special term was affirmed, on appeal, by the full bench.

The case of *The Brooklyn White Lead Company* vs. *Masury*, 25 Barb., 416—decided in the same court—illustrates the principle applied to the case of a fraudulent imitation of a trade mark, accomplished by a false representation of the name of the imitating manufacturer.

The plaintiffs were, and had been for more than twenty years, manufacturers of white lead, at Brooklyn, in the State of New York. They had a store in the city of New York.

As a mark or brand upon the kegs containing the white lead of their manufacture, they used their name, "Brooklyn White Lead Company," with the additional words, "premium lead, warranted pure."

The defendant was a manufacturer of white lead, also, at Brooklyn, and having a store in New York city. He first used as his mark or brand upon his kegs, the words, "Brooklyn White Lead, pure, 100 lbs"—without connecting his name with the brand. To this, no objection was made by the plaintiffs, for the reason, that as each party made white lead—and each made it, also, at Brooklyn, they had an equal right to declare these facts by the use of the words, "Brooklyn White Lead," in their trade mark. After some time, however, the defendant added the word "Company" to the words before used, when, in fact, the lead of his manufacture was not made by a "Company," and there was no other "Company" in Brooklyn, for the manufacture of white lead, than that of the plaintiffs—which was properly designated by the name used in their trade mark, "Brooklyn White Lead Company."

This, with extrinsic evidence, rendered it quite manifest, that the defendant had added the word "Company" to his trade mark, for the sole purpose of misleading purchasers, and inducing the belief that the lead contained in his kegs, was manufactured by the plaintiffs — the "Brooklyn White Lead Company." The court says:

> "With any, but the most cautious pur-
> "chasers, such would be the effect of the use
> "of that word in the defendant's trade mark.
> "The law of trade marks protects manufac-
> "turers, in their exclusive right to sell their
> "goods, as well to incautious as to cautious
> "purchasers — and any *false name*, assumed in
> "imitation of that of the original manufacturer,
> "is a violation of his exclusive right, and its
> "use should be restrained by injunction."

An injunction was accordingly ordered, restraining the use, by the defendant, of the words "Company," or the abbreviation "Co.," in the trade mark used by him, upon the kegs containing white lead of his manufacture.

The case of *Fetridge* vs. *Wells*, 4 Abb., 144, also reported in 13 How. Pr. R., 385—and to which we have already had occasion to refer, as illustrating the doctrine upon which the protection of the law is withheld from a fraudulent manufacturer, even against the deceptive and manifestly wrongful contrivances of another—is also significant, as an authority enforcing the principles now under consideration.

In this case, a preliminary injunction was granted, by which the defendants were restrained from

> "Selling or offering for sale, directly or
> "indirectly, any preparation or compound,
> "manufactured by them, or by either of them,
> "or by any other person than the plaintiff—
> "under the name of 'Balm of Thousand
> "Flowers'—or selling, or offering for sale any
> "preparation, or compound, having printed,
> "painted, written or stamped, on the bottles,
> "containing the same, the words 'Balm of
> "Thousand Flowers,' or having or using, any
> "label or wrapper, printing or device, in such
> "manner as to be a colorable imitation of those
> "used by the plaintiffs."

On the motion to dissolve the injunction, the case came before the same learned judge (afterwards

Chief Justice) DUER—of the Superior Court of the city of New York, to whose valuable analysis and elaborate elucidation of the elementary principles in the law of trade marks, in the case of "*The Amoskeag Manufacturing Company* vs. *Spear*," the profession is so largely indebted.

Upon the question of fact, as to the imitation by the defendants, of the plaintiffs' trade mark, the learned judge, says,

> "Without rejecting the evidence of my "senses, I cannot doubt that the label or trade "mark which the defendants admit that they "use, from its general resemblance to that of "the plaintiff, and his firm, is well calculated "to mislead the public, by inducing the belief "that the articles to which it is affixed, are, in "reality, prepared or manufactured by the "plaintiffs' firm—nor, can I doubt, that the "label was framed, with this design, since the "imitation is so close, minute and exact, as in "my opinion, to exclude the supposition of "any other motive.
>
> "It is true, that the name of R. H. Rice, as "the proprietor, is printed on the label, but it "is so printed, as not to attract, but almost "certainly to elude, observation. A variation "must be regarded as immaterial which it "requires a close inspection to detect—and "which, can be scarcely said to diminish the "effect of the *fac simile*, which the simulated "label, in all other respects, is found to "exhibit.

"Hence, were this the only question in the
"case, I should have no difficulty in holding,
"that the injunction which is sought to be dis-
"solved, must be retained and enforced—
"but, it is proper to add, that upon no suppo-
"sition, would I consent to retain it, for all the
"purposes for which it has been granted, and
"for which its continuance has been asked."

The learned judge then proceeds to the application of the principle of law, established by the preceding authorities, to the claim made by the plaintiffs, to an exclusive right to the use of the words in their label—"Balm of Thousand Flowers"—and says:

"The position so strenuously insisted on that
"the plaintiffs' firm have an exclusive property
"in the words, 'Balm of Thousand Flowers,'
"or, which is the same thing, an exclusive
"right to use those words, in a trade mark,
"I wholly reject."

"It is not necessary to deny, that a name
"may, in some cases, be rightfully used and
"protected as a trade mark—but this is only
"true, when the name is used merely as indi-
"cating the true origin and ownership of the
"article offered for sale—never, where it is
"used to designate the article itself, and has
"become, by adoption, and use, its proper
"appellation.

"When a new preparation or compound is
"offered for sale, a distinctive and specific
"name, must necessarily be given it."

"The name thus given to it, no matter "when, or by whom imposed, becomes by "use, its proper appellation—and passes, as "such, into our common language. Hence, "all who have an equal right to manufacture, "and sell the article, have an equal right to "designate and sell it by its appropriate name, "the name by which, alone, it is distinguished "and known—provided each person is careful "to sell the article, as prepared and manufac- "tured by himself, and not by another.

"When this caution is used, there is no "deception, of which a rival manufacturer, "not even the manufacturer by whom the "distinctive name was first invented or adopted, "can justly complain—and so far from there "being any imposition on the public, it is the "use of the distinctive name, which gives to "purchasers, the very information which they "are entitled to have."

"In short, an exclusive right to use on a "label, or other trade mark, the appropriate "name of a manufactured article, exists only "in those who have an exclusive property in "the article itself—and it is not pretended, "that the plaintiff, or his firm, have any "exclusive property in the preparation or com- "pound, to which the well sounding name, "'Balm of Thousand Flowers' has been "given.

"It is only the seductive name that they "claim, as their exclusive property—and, "doubtless, from their experience of its value "in the extension of their sales.

"This, however, is a species of property, "that, in my opinion, is unknown to the law,

"and that can only be given to one, by "infringement of the rights of all.

"My views on the general question, of an "exclusive right to sell an article by its dis- "tinctive name, were fully expressed in the "case of '*The Amoskeag Manufacturing Com-* "*pany* vs. *Spear*,'" &c.

Thus, upon this ground, the injunction would have been dissolved, so far as it prohibited the use of the particular words, claimed as the exclusive property of the plaintiffs, had not the learned judge, as we have already seen—adopted the conclusion, upon another and distinct ground, that it was the duty of the court to deny to the plaintiff all relief, and to withhold from him any protection whatever.

In reviewing this case, in its application to another branch of our subject, we have seen that Mr. Justice DUER denied the relief asked for by the plaintiffs, upon the ground that the trade mark claimed by them, was a tissue of false and fraudulent declarations, designed and calculated to impose upon a credulous public.

Mr. Justice HOFFMAN, by whom the preliminary

injunction was granted, expressed dissenting views upon this point.

So, also, upon the question, as to what may be appropriated by a manufacturer as his trade mark, and as such, used to the exclusion of others, that learned judge, in the case of *Fetridge* vs. *Merchant*, 4 Abb., 136—has stated his decided dissent from the opinion of Mr. Justice DUER. This dissent did not affect the result of the litigation, for the reason that the same conclusion was reached by Mr. Justice HOFFMAN, in this case, as by Mr. Justice DUER, in the preceding one—but upon the distinct ground, that the evidence did not clearly establish the plaintiff's title, by priority of appropriation.

In the case of *Fetridge* vs. *Merchant*, the same plaintiff sought the same relief and protection against another defendant, for the same alleged violation of his trade mark.

The learned judge, in relation to the principle we are now considering—says:

> "Another proposition is, that a name or
> "appellation may be appropriated as a trade
> "mark—That this may be given to a com-
> "pound, or article, every ingredient or portion
> "of which, is open to the use of every one,
> "but the sale of which, under that appellation
> "is not lawful to any other person.
>
> "It would scarcely be going too far to say,
> "that the further removed, such an appellation

"is, from actually representing the article in "question, the more exclusive and decided, "becomes the right to it.

"Medicated Mexican Balm," had nothing in "its composition peculiar to the land of Mon- "tezuma (6 Bea., 66,) and "Chinese Liniment" "was, in all its ingredients, a stranger to the "Celestial Empire—4 McLean, 516."

"It appears to me that the term 'Balm of "Thousand Flowers' is of this character.

"The article is a liquid soap, or perfumed "liquid soap.

"That name would be the name of the arti- "cle, because it would indicate its nature— "The ingredients are palm oil, potash, sugar "or honey, alcohol, and some strong scents.

"The connection from the use of honey, if "employed by the plaintiffs, is remote and "fanciful.

"The term is, in my opinion, extrinsic, and "not indicative."

"I am compelled then, to differ, in this par- "ticular from the learned judge in the case of "*Fetridge* vs. *Rice*, in Boston. He treats the "phrase as 'the proper name and appellation "of the article.'"

[Such, also as we have seen, was the conclusion of Mr. Justice DUER in the case of *Fetridge* vs. *Wells*.]

The learned judge, having determined to rest his decision of the case before him, upon the ground of insufficient proof of prior appropriation, by the plaintiffs, merely states his conclusions upon the

questions now in review, without undertaking to urge, or express, his reasons, for adopting those conclusions.

This is to be regretted—for these conclusions are not only at variance with those of other learned judges, and especially with those of the learned judge, who had then just decided the case of *Fetridge* vs. *Wells*, but also seem to be irreconcileable with the established principles, upon which the jurisdiction in equity has been rested for the protection of property in trade marks.

If the name devised and given to an article of merchandise, by the manufacturer, (who possesses no exclusive right to manufacture or sell the article itself,) was not designed to declare the origin or ownership of the article, the manufacturer, or place of manufacture—and can, by no possibility perform that office, and if the name, or whatever may constitute the trade mark, that *does*, directly or indirectly, perform that office, is alone entitled to be recognized and protected, as property, for the reason that the imitation of such trade mark only, can accomplish the wrong for which alone the law provides a remedy, namely—the selling of the merchandise of the wrongdoer as and for that of the original appropriator of the trade mark—then, it is not easy to perceive, why, or upon what

ground, there should, or can be, any difference between a name that is extrinsic, and one that is indicative.

If the name does not pretend to indicate the properties or constituents of the manufactured article, but is a name of fancy, merely, removed as far from any actual representation of the thing, as the "Medicated Mexican Balm" was from the land of Montezuma, does it, for that reason, approach a shade nearer the essential condition of a trade mark, of which the right of property can be predicated,—namely, a denotement that the article, thus denominated, was manufactured, or is for sale, by A. B.?

But the case in 4 McLean, cited by the learned judge, as an authority apposite to the doctrine of his opinion, is certainly very far from affording it the smallest support.

The plaintiff in that case (*Coffeen* vs. *Brunton*, 4 McLean, 516,) made no claim whatever to the exclusive use of the words or name "Chinese Liniment"—nor did the defendant use the same, or any colorable imitation of the same words—and if such a claim had been made by the plaintiff, and the defendant had copied or imitated that name,—it is manifest from the language of Mr. Justice McLean—that he would not have sustained such

a claim. What the defendant in that case did, and was restrained from doing, by the injunction of the court, was simply, this. He so prepared the label for his medicine, that he called "Ohio Liniment"—in all its general features—and in the language of the printed directions for its use, which formed a part of it—"as to produce an impression on the purchaser and the public, that the liniment sold by the defendant, contained the same ingredients as the 'Chinese Liniment'—and was, in effect, the same medicine."

In the case also, of *Perry* vs. *Truffit*, to which the learned judge refers, (not more fortunately than to that of *Coffeen* vs. *Brunton*) the exclusive right claimed by the plaintiff in the use of the words, "Medicated Mexican Balm," was denied by the Master of the Rolls—and his opinion manifestly was, as Mr. Justice DUER declares, in his review of that case, (vide 2 Sand. S. C. R., 612) that—

> "As the words "Medicated Mexican Balm"
> "might be just as true a description of the
> "medicine of the defendant, as that of the
> "plaintiff, the former had an equal right to
> "use them with the latter."

In other words—the name, being one of fancy merely, or, at most, indicating the mere quality or character of the article, could not become the

exclusive property of any one, who had not an exclusive right to manufacture and sell the article itself.

This is certainly the principle resulting from the decision in the case in 6 Beavan—which the learned judge in *Fetridge* vs. *Merchant*, intimates as an authority, justifying the views which he there expresses—and, as we have before said, it seems to us, that a departure from this great, leading fundamental principle, would be to launch upon a sea of uncertainty, but whose currents unerringly tend towards those shoals and breakers, which foreshadow the "mischievous consequences"—so earnestly deprecated by Lord MANSFIELD—who, in *Blanchard* vs. *Hill*, resisted the first attempts to obtain a legal recognition of property in trade marks.

The principles laid down in the case of "*The Amoskeag Manufacturing Company* vs. *Spear*," have been recognized as established law by the full bench of the same court, in the case of *Williams* vs. *Johnson*, 2 Bosworth, 1.

In that case, it appeared, that the plaintiff, Williams, was a manufacturer, at Manchester, in Connecticut, of a particular kind of soap, to which he gave the name of "Genuine Yankee Soap." Each cake of his soap was covered with tin foil, and on

the top was affixed an octagonal, pink colored label, containing these words: "Genuine Yankee Soap, manufactured at Manchester, Connecticut, by Williams & Bro., Chemists and Apothecaries. To prevent counterfeits, their name will be on each cake."

On one side of each cake, was an octagonal, pink colored label, containing these words: "The Genuine Yankee Soap is warranted superior to any foreign compound for shaving and the toilet—affording a copious and heavy lather, which does not dry on the face, leaving the skin soft and smooth." On the other side of each cake, was another pink colored label, containing the name of the manufacturers or plaintiffs' firm, in imitation of writing—as a *fac simile* of their signature—"Williams & Bro."

The cakes of soap, being thus carefully prepared, and labeled, were put up in boxes, each containing one dozen, which boxes were thus marked: "One dozen Genuine Yankee Soap, warranted superior to any foreign compound for shaving and the toilet—manufactured at Manchester, Connecticut, by Williams & Bro., Chemists and Apothecaries. To prevent counterfeits, their name will be on each cake."

In this, was employed a peculiar and fanciful

style of printing, form of letters, and arrangement of lines.

Thus prepared, and labeled, and packed—the soap was brought into the market, was favorably received, and its sale became very extensive, resulting in large profits to the manufacturer.

The defendant established a manufactory of soap in New York—prepared the same in cakes, of the same shape and size as the plaintiffs'—covered each cake with tin foil—and affixed pink colored, octagonal labels, on the top and sides—each label containing the precise words used by the plaintiffs on their labels—with the exception that the name (purporting to be that of the manufacturer, but which was falsely assumed by the defendant) was "L. Williams & Co.," and the place of manufacture, "New York."

The defendant's soap was packed in boxes, each containing a dozen cakes, and each marked "One Dozen Genuine Yankee Soap, warranted superior to any foreign compound, for shaving and the toilet—manufactured by L. Williams & Co., New York. To prevent counterfeits, their signature will be on each cake."

In their mark or label, for the package or box—the arrangement of the lines, the peculiarity of the letters, the style of the printing, were, in every

part, an almost exact copy of that of the plaintiffs.

The learned judge, who gave the opinion of the court, in this case, (Mr. Justice WOODRUFF) characterizes the conduct of the defendant as:

> "A gross and palpable endeavor, by an "imitation of the plaintiffs' marks and labels, to "deceive the public, and obtain the patronage, "of right belonging to the plaintiffs."
>
> "The plaintiffs had employed their skill in "the compounding of well known ingredients "for the manufacture of soap, and in all the "benefits resulting from that skill, were entitled "to protection."
>
> "What marks or devices," (say the court) "are employed by the plaintiffs, to *denote that* "*the soap is made by them*, and is combined by "the skill that was employed in the making of "soap, heretofore made and sold by them, "bearing the same mark, are entitled to "protection."
>
> "As, for example. If the plaintiffs had "chosen to stamp their soap with some impres- "sion having no other meaning than to distin- "guish their manufacture, from that of others, "and have given it out as their mark, and, by "this description, soap of their manufacture "had acquired a reputation and sale, they "would be entitled to protection."
>
> "The marks and labels which they have "adopted, *for this purpose*, the defendant has "copied — and even the single variation in the "change of name, imports a falsehood, and

" tends to create, rather than destroy the
" impression, that the soap was manufactured
" by the plaintiffs."

Quoting from Senator LOTT, in the case of *Taylor* vs. *Carpenter*, the court says :

" Honest competition relies only on the in-
" trinsic merit of the article brought into
" market, and does not require a resort to false
" or fraudulent device or token. That, cer-
" tainly, cannot deserve the appellation, which
" studiously gives to the product of pretended
" superior skill, the name and external resem-
" blance and imitation of the article, with
" which it professes to compete."

And again, quoting from Vice-Chancellor SANDFORD, in the case of *Coates* vs. *Holbrook*.

" A man is not to sell the goods or manu-
" facture of B. under the show or pretence,
" that they are the goods or manufacture of A.
" who, by superior skill or industry, has estab-
" lished the reputation of his articles in the
" market. The law will not permit a person
" to practise a deception of that kind, or to
" use the means which contribute to effect it.
" He has no right, and he will not be allowed,
" to use the names, letters, marks or other
" symbols, by which he may palm off upon
" buyers, as the manufacturer of another, the
" article he is selling—and thereby attract to
" himself the patronage, that, without such
" deceptive use of such names, &c., would

> " have enured to the benefit of that other per-
> " son, who first got up, or was alone accustomed
> " to use, such names, marks, letters or symbols."

And again, quoting from Mr. Justice DUER, in the case of *The Amoskeag Manufacturing Company* vs. *Spear*.

> " In order to convey a false impression to
> " the mind of the public, as to the true origin
> " and ownership of goods, it is not necessary
> " that the imitation of an original trade mark,
> " should be exact and perfect. It may be
> " limited, and partial. It may embrace varia-
> " tions, that a comparison with the original,
> " would instantly disclose—yet, a resemblance
> " may exist, that was designed to mislead the
> " public—and the effect intended, may have
> " been produced, nor can it be doubted, that
> " when this design is apparent, and this effect
> " has followed, an injunction may rightfully be
> " issued, and ought to be issued."

But the point in which this case especially recognizes the authority of that of *The Amoskeag Manufacturing Company* vs. *Spear*, and the doctrine there laid down, from which the learned judge dissented, in the case of *Fetridge* vs. *Merchant*, relates to the right claimed to the exclusive use by the plaintiffs, upon their labels, of the words "Genuine Yankee Soap."

Upon this point the court says:

"Whether, upon taking proofs, it would "appear that the words 'Genuine Yankee "Soap' are to be deemed descriptive of this "kind of soap, which any one may make and "sell by its proper name, or are terms properly "designating the plaintiffs' manufacture, and "so, descriptive of their skill and industry, in "making an article, already in common use, "by its proper and generic name of soap, is "perhaps not free from doubt.

"It is quite clear, that so far as it indicates "the place of manufacture, it is a fraud on the "part of the defendants to use it. Still, the "case referred to—(*The Amoskeag Manufactur-*"*ing Compang* vs. *Spear*,) decides—that, "though it be, in this particular, a fraud on the "part of the defendant, the plaintiffs cannot "have an injunction, unless it shall appear, that "*it designates their own manufacture*, and that "its use by the defendant, operates to the "prejudice of a right acquired by them."

And, accordingly, the injunction granted in this case, was "made to conform" to that, in the case decided by Mr. Justice DUER.

In that, the prohibition upon the defendants, did not include the letters "A. C. A."

In this, it did not include the words "Genuine Yankee Soap."

The case of *Udolpho Wolfe* vs. *Emile Goulard*, 18 How. Pr. R., 64, recently decided by Mr. Justice INGRAHAM, in the Supreme Court of New York—in some of its features, is much to the point, upon the branch of the subject embraced in this chapter.

The plaintiff in this action, claimed to be the manufacturer and vendor of a certain kind of gin, which he denominated "Aromatic Scheidam Schnapps."

He charged the defendant, in his bill, with an imitation of his marks and labels, *by the use of those words*, upon an article of gin sold by him.

In the case, as presented by the pleadings, or by concessions at the hearing, it appeared that the object of the action was, to restrain the defendant from the use of those particular words, "Aromatic Scheidam Schnapps,"—and, if we correctly understand it, all question as to the defendant's violation of the plaintiff's rights, by endeavoring to sell his gin, as that of the plaintiff, through the instrumentality of an imitation of the form, size and color of the wrapper and labels, and of the words printed thereon, and their peculiar arrangement, were excluded from the consideration of the court, upon

the motion for an injunction—and the inquiry was limited to the question, whether the plaintiff had such a right to the use of the words "Scheidam Schnapps," to designate his gin, as to entitle him to an injunction, restraining the defendant from using them.

After a review of the evidence, disclosed by the affidavits, in relation to the proper and accepted signification of the words in question, which tended strongly to the conclusion, as matter of fact, that the word "Schnapps" was in common use in "Scheidam," to designate gin, and that the words were, therefore, simply the proper name of the article, the court proceeds to a consideration of the question of law, and says:

> "When a person forms a new word, to
> "designate an article made by him, which has
> "never been used before, he may obtain such
> "a right to that name as to entitle him to the
> "sole use of it, as against others, who attempt
> "to use it for a similar article. But such an
> "exclusive right can never be successfully
> "claimed, of words in common use previously,
> "as applicable to similar articles."

The court then proceeds to a consideration of the several authorities upon the question of what may be appropriated as a trade mark, entitling the owner to protection in its exclusive use, and quotes,

as authoritative expressions of the established principles, the language of Mr. Justice DUER, in the several cases decided by him—as also that of the Supreme Court, in the cases of "*Stokes* vs. *Landgraff*," "*Clark* vs. *Clark*," and "*The Brooklyn White Lead Company* vs. *Masury*," already referred to—and, in accordance with these principles, the injunction prayed for against the defendant, was dissolved.

Whatever may be the rights of the plaintiff in this action, to restrain the fraudulent and colorable imitation of his labels and trade mark, by the defendant, by which he is enabled to pass off his gin as the plaintiff's—we are at a loss to understand how the litigation can terminate otherwise than in accordance with the decision of Mr. Justice INGRAHAM, if the sole relief sought at the trial, be that to which the claim of the plaintiff was limited, on the motion for an injunction—namely, to restrain the defendants from the use of the particular words, "Scheidam Schnapps,"—and if it be conceded that the words do not, of themselves, tend to indicate the plaintiff, as the manufacturer, or vendor, of the article, we are unable to perceive how any evidence whatever, of priority of appropriation, by the plaintiff, can be held to vest in him an exclusive right to their use, without a

departure from those established principles, upon which such exclusive right can alone be rested.

At about the same time that the case of *Wolfe* vs. *Goulard* was decided in the Supreme Court of New York, that of *Burnett* vs. *Phalon* was under consideration in the Superior Court of the city of New York.

This case, in some of its features, is of a novel character—and by reason of the peculiarity of some of the views presented by the learned judge, before whom the hearing was had, on the motion for an injunction (Mr. Justice PIERREPONT,) it is worthy of more than a passing notice.

The plaintiff was a chemist, residing in Boston,—and in 1856, it appeared, compounded from cocoa-nut oil and other ingredients, a mixture for the hair—and as a designation for his compound, devised a name never before used, and unknown to the language—namely, "*Cocoaine*"—and immediately published in all his circulars, and in the principal newspapers throughout the country, and especially in nearly every newspaper in the city of New York, which was the residence of the

defendant, that he had adopted that name as his trade mark—to designate the article as his manufacture—and to secure the public, and himself, against imposition, and that all unauthorized use of that name or trade mark, would be promptly prosecuted. It appeared that he had expended in his advertisements, some ten thousand dollars, before the alleged invasion of his rights by the defendant, and it was not pretended, that the defendants were not fully cognizant of his advertisements and notifications, as to this alleged trade mark.

The compound met with a rapid sale—which was attended with no inconsiderable profit.

Upon each bottle, containing the plaintiff's mixture, he affixed a label, with the following words printed thereon, and somewhat thus arranged:

"A
Perfect
Hair Dressing,
A Promoter
of the
Growth of Hair,
A preparation
Free from irritating matter.
Burnett's
Cocoaine,
For preserving and beautifying
the Hair, and rendering
it dark and glossy."

To this, was added a description of the properties of the compound, and its peculiar qualities, together

with directions for its use—the whole terminating with these words:

"Prepared only by
Joseph Burnett & Co.,
Boston."

And the certificate of entry in the office of the Clerk of the District Court of the United States, for the District of Massachusetts—to secure a copyright in the label, under the act of Congress.

After the compound of the plaintiff's had been upon the market about two years, the defendants commenced a preparation of a mixture for the hair, a principal ingredient of which was alleged to be, cocoa-nut oil.

It was put up by them in bottles, "not very unlike those of the plaintiffs'."

The label affixed by the defendants upon their bottles, contained—first, the certificate of entry in the office of the Clerk of the District Court of the United States for the Southern District of New York, to secure a copyright in their label, under the act of Congress—and then, the following words, thus arranged:

"Phalon & Son's
Cocoine
For the Hair,
Prepared
From highly purified
Cocoa Oil."

To this was added a description of the properties of the compound, directions for its use and application—and the whole terminating with the words,

"Phalon & Sons,
Perfumers,
Nos. 197, 497, and 517
Broadway,
New York."

Upon these facts, the plaintiffs claimed that the defendants had violated their trade mark, and claimed damages, and relief by injunction.

The defendants, in their answer, averred that the plaintiffs' compound was an imposition—and that theirs was a superior article—and further, that the plaintiffs could have no property in the word "Cocoaine"—and if they could, that the word "Cocoine," adopted by them, was a different name, correctly compounded from the French, and not calculated to mislead the public.

At the hearing, no evidence was offered, tending to show any imposition on the part of the plaintiffs—and the court, in accordance with the well settled doctrine,—where the proceedings are in equity,—which we shall have occasion to consider hereafter, refused to allow any evidence as to the relative qualities of the two mixtures.

The evidence did not show such a similarity between the defendants' and the plaintiffs' label or

trade mark, *in its general features*, as to induce the belief that the defendants' was contrived to mislead the public, and enable them to sell their mixture, as and for that, manufactured by the plaintiffs.

The sole imitation, and that which, it was contended, accomplished this result—and manifested this design, was in the use by the defendants, of the word, "Cocoine." The question, therefore, at issue in the case, is thus stated by the court:

> "If the plaintiffs cannot acquire any property
> "or exclusive use in this name, word or device
> "(namely, 'Cocoaine') thus contrived and
> "adopted as their trade mark, then, there is no
> "ground for this action—and if the defendants
> "have adopted a device or name, so differing
> "from that adopted by the plaintiffs, as in no
> "wise to deceive the public or do injury to the
> "plaintiffs—then the defendants are not liable
> "in this suit."

The court then proceeds to a consideration of some of the leading authorities, and cites, with approbation, the following language of Lord LANGDALE, in *Croft* vs. *Day*, 7 Bea., 84, as a correct statement of the principle upon which a right of property in trade marks is recognized.

> "No man has a right to dress himself in
> "colors, or adopt and bear symbols, to which
> "he has no peculiar or exclusive right—and
> "*thereby personate another person*, for the pur-

"pose of inducing the public to suppose,
"either that he is *that other person*, or *that he* is
"*connected with*, and *selling the manufacture of*
"*that other person*, while he is really selling his
"own."

And again,

"The defendant's (Day's) contrivances, were
"calculated to mislead the bulk of the unwary
"public, into the impression that the *new con-*
"*cern was connected with the old manufactory*,
"and thus to benefit the defendants, to injure
"the plaintiffs, and to deceive the public."

The learned judge, having thus clearly recognized the leading, fundamental principle, upon which a manufacturer is entitled to protection, in the exclusive use of his trade mark, proceeds to the application as follows:

"In the case before us, Burnett contrived a
"name, *unknown to any language*, and sold his
"mixture, under that appropriated designation,
"for two years—*advertising during the entire*
"*time*, and in nearly every important journal,
"in the city of New York, that *he had adopted*
"*that word or name as his 'trade mark.'*"

"Every man has a right to the reward of
"his skill, his energy and his honest enter-
"prize, and when he has appropriated as his
"trade mark, letters combined into a word
"*before unknown*, and has used that word, and
"*long published* it to the world, as *his adopted*
"*trade mark*, he has acquired rights in it which
"the courts will protect."

And still further to impress this doctrine, by a statement of that which is conceived to be *not* susceptible of appropriation, the learned judge, proceeds:

> "No one can appropriate a word in general
> "use, as his trade mark—and restrain others
> "from using that word. Burnett cannot acquire
> "property in the words 'Gin,' 'Wine,' 'Brandy'
> "or 'Ale,' or in any other word *known to the*
> "*language*, and in common use, to designate
> "things, or the qualities of things. But the
> "word appropriated by the plaintiff, is not of
> "that character," &c.

The doctrine thus inculcated by the learned judge, seems somewhat novel in its character. It cannot be deduced from any preceding authority, and does not, as it appears to us, harmonize with the principles previously recognized by the court, as controlling and defining the conditions upon which property in trade marks can be acquired.

Because a manufacturer has *coined* a *word before unknown to any language*—and applied that, as a name for his production, he does not thereby *designate* and *distinguish* that production *as his*, any better than if he had used words, known to the language, but never before applied to such a production? A newly coined word, consisting of an original combination of letters, does not, because

it is new, serve in the slightest degree, to point out the true origin or ownership of the article so named, or connect it with the person who contrived the new word?

If the plaintiffs, in this case, had simply used the word "Cocoaine" in their label, without addition of their name or address, and merely adding to it a description of the properties of the "Cocoaine" and directions for its use, could any one thereby have received the slightest intimation, as to the origin or ownership of the mixture—who was the manufacturer—or by whom it was sold?

And yet, if anything can be regarded as settled, in the law of trade marks—it is this—that an essential condition, an imperative *sine qua non* to their recognition, as property, entitling the owner to protection in their exclusive use, is, that they shall, in some mode, clearly and truly, designate the origin and ownership of the article—that they shall be a substantial declaration to the public by him who adopts them, that he is the manufacturer—because, in the first place, no wrong against the individual, can be committed, by the invasion of a trade mark, otherwise than by the sale of the goods of the wrong doer, as and for the goods of the owner of the trade mark—and this can only be done by a copy or imitation of that, which

serves to designate the goods as the manufacture of the owner of the trade mark imitated—and because too, in the next place—so far as the public is concerned, such a designation in a trade mark, as shall denote the true origin and ownership of the manufacture, affords the best and safest, if not the only pledge and guaranty against fraud and imposition.

It certainly does not seem apparent, that this condition can be, at all fulfilled, simply by the adoption and use of a newly coined word.

Again—That the published declarations of a manufacturer, that he has adopted a certain word as his trade mark, can lay the foundation, or even aid in laying the foundation of a right of property in the word, can scarcely be reconciled with the principles, heretofore recognized, upon which such property can be acquired—or with the policy of the law in recognizing and protecting the acquisition.

It is the *actual use* of the trade mark, affixed to the merchandise of the manufacturer, and this alone, which can impart to it, the elements of property. The mere declaration of a person, however long, and however extensively published, that he claims property in a word, as his trade mark, cannot even tend to make it his property. The law, alone, does that—and if a manufacturer

advertises to the world, that a certain name is his trade mark, which name the law declares to be incapable of appropriation, as exclusive property, and which, not denoting the origin or ownership of the goods, cannot be used by one, to the exclusion of another—his advertisements are vain.

The conclusions of the learned judge, in this case, may well be sustained upon the facts—though, as it seems to us, not upon the principles invoked to justify them.

Adopting the language of Lord LANGDALE, in *Croft* vs. *Day*, the court asks, as to the defendant's use of the word "Cocoine:"

> "Was this contrivance calculated to mislead
> "the bulk of the unwary purchasers, and thus
> "to benefit the defendants—to injure the
> "plaintiff, and to deceive the public?"

And to this question, the court says:

> "I have no doubt that an honest answer
> would be in the affirmative."

But, in the case of *Croft* vs. *Day*, the contrivances to mislead, adopted by the defendants, were *imitations* of *those portions* of the plaintiffs' label, which consisted of *their name and address*—and therefore were calculated to produce the impression, that the new concern was connected with the old manufactory.

Such can never be the case, assuredly, where the contrivance consists altogether in an imitation of a mere name, which constitutes the entire trade mark—and does not, in any manner, supply the place or perform the office of the name or address, in indicating the origin or ownership of the manufacture.

It seems to us, that in this case, the trade mark of the plaintiff, notwithstanding his declarations, and claims, and advertisements, and notifications, was, by no means, simply the word "Cocoaine,"—or even that the word "Cocoaine" constituted a principal portion of that which was, strictly, the trade mark.

The compound was not called "Cocoaine," but "Burnett's Cocoaine," and every label contained, not only the name, but the address of the plaintiffs—and also the distinct declaration that they were the manufacturers of the compound.

These constituted the trade mark, in the only strictly legal sense of that term—because they alone designated the true origin and ownership of the mixture.

The word "Cocoaine" was devised as a name for the article itself, not altogether inappropriate, because somewhat indicative of its properties. Being added to the name and address of the manu-

facturer, it might be regarded as an auxiliary, in serving to identify and distinguish.

It may be, therefore, that the word "Cocoaine," having been devised and adopted by the plaintiffs, and by them, for a long while, and extensively, used, in connection with their name, upon their bottles, labels and packages, became so inseparably associated, with the plaintiffs themselves, that no one could use the same word in his labels, affixed to bottles containing a similar compound, (for the word "Cocoine" is, to all intents, the same,) even though his own name and address were substituted for those of the plaintiff, without actually misleading the bulk of unwary purchasers, and inducing the belief that his compound was, in truth, the manufacture of the plaintiffs.

In other words, the bulk of unwary purchasers, who had been in the habit of buying "Burnett's Cocoaine"—seeing what appeared to be the same name upon a bottle or package—would take it for granted that it was the same article which they had before purchased, namely "Burnett's Cocoaine," and would not be likely to discover their error, by a close examination of the label, which would reveal the name and address of the defendants—"Phalon & Sons."

In this sense, and in no other, as it seems to us,

could the defendants, by the use of the word, "Cocoaine" without anything else in common with, or in imitation of, the plaintiff's trade mark, be regarded as attempting to personate the plaintiffs, and to induce the bulk of unwary purchasers to believe, that the compound contained in the bottles, on which that word was used, was the manufacture of the plaintiffs.

If this were so, as matter of fact, that is, if the mere use of the word in the label, induced the belief that the defendants' bottles contained the plaintiffs' compound, then, the rights of the plaintiffs would be invaded by the use of this word, in like manner,—(though indirectly, and not, perhaps, to the like extent—) as if their name and address had been copied or imitated and:

> "Whenever the design of a person who
> "imitates a trade mark, either apparent or
> "proved, is, to impose his own goods upon the
> "public, as those of the owner of the mark,
> "and the imitation is such, that the success of
> "the design is a probable, or even possible,
> "consequence, an injunction ought to be
> "granted."

We have not been able to avoid the conclusion, that the doctrines inculcated in the cases of *Burnett* vs. *Phalon*—and *Fetridge* vs. *Merchant*—in the reported opinions of the learned judges, by

whom they were respectively heard, on motions to dissolve the preliminary injunctions, involve a departure from the principles established by the decisions of the same court, in *The Amoskeag Manufacturing Company* vs. *Spear*, and *Williams* vs. *Johnson*, and so repeatedly recognized and affirmed by other tribunals.

If it be not altogether a groundless apprehension, that a departure from these principles, necessitates a sacrifice of what has been justly deemed the true policy of the law—and inevitably leads, by sure, though stealthy steps, to those "mischievous consequences" which always result from the imposition of fetters upon the freedom of trade, and an oppressive restraint upon fairly directed enterprise and honest competition, by the creation of exclusive privileges, and arbitrary and unjust monopolies,—then the strictures we have ventured upon the doctrines involved in these decisions, are not without justification.

It is not always easy to look beyond what appears to be a palpable invasion of individual rights, to the possible sacrifice of general interests, which may be involved in the inculcation of that doctrine, which is essential to the particular individual relief.

In view of this, perhaps that would not be

unwise legislation, which,—following the example of the legislature of the State of Massachusetts—should prescribe the boundaries of the equitable jurisdiction of the courts, over the subject of trade marks, by providing, that it shall be exercised only, to restrain by injunction the "fraudulent use of such trade marks or devices, as are employed for the purpose of falsely representing any article to be manufactured by a person or firm who did not in fact make it."

The case of *Ames* vs. *King*, 2 Gray, 379, illustrates the effect of such an enactment, in restraining the judicial determination of issues, made by the pleadings, between parties in trade mark controversies—unsustained by *extrinsic* evidence, upon either side.

The plaintiffs were manufacturers of shovels, and in order to denote that they were their manufacture, and to distinguish them from the like article made by any other manufactures, they branded them with the name of their firm—"O. Ames & Sons." They became known in the market as "Ames' shovels"—and acquired much celebrity and extensive sale.

The defendant was also a manufacturer of shovels, and branded his productions, with the name "Ames"—as the plaintiffs' averred, in vio-

lation of their trade mark—in fraud of them, and "for the purpose of falsely representing the article to be the manufacture of the plaintiffs."

The answer of the defendant denied the averments of the bill—denied the intent to deceive and defraud—and—admitting that he had used the name "Ames," upon 200 dozen shovels of his manufacture, denied that the plaintiffs had any exclusive right to the use of that name, and also denied, that he had employed that word "for the purpose of falsely representing the article to be the manufacture of the plaintiffs," but, on the contrary, averred, that he had received an order for 200 dozen shovels, from a person whose name was "Ames," and that he was desired by the person who gave to him the order, to brand or stamp them by that name, solely for the purpose of denoting that they were kept for sale by him—and he did so, accordingly.

The answer to the bill was under oath, a hearing was had upon the bill and answer—and the court held that under the limitations of the statute, they were not at liberty to consider the circumstances, which otherwise might have been regarded, by a court of equity, as tending to an impeachment of the veracity and good faith of the defendant—and upon this ground the bill was dismissed.

We have just been furnished with a manuscript copy of the opinion of the Superior Court of the city of New York, in the case of *William S. Corwin et al.* vs. *William H. Daly et al.*, pronounced by a full bench of that court, on the 30th of June, 1860.

The case was an important one,—involving many questions of interest in the law of trade marks—but of peculiar importance—as presenting for determination, the distinct question, as to the right to the exclusive use, as a trade mark,—of an abstract name, or of words not indicating the origin, or ownership; or manufacture, of the article designated,—by the manufacturer or merchant, who first adopted, appropriated or applied such designation.

The question is discussed with much learning and ability—and the opinion of the court, (given by Mr. Justice ROBERTSON,)—reviews with great clearness and discriminating fidelity, the prominent authorities bearing upon the question, as well in the English as the American reports.

We are glad to have received our report of this decision, while the sheets of this work are yet in press—and in season for incorporation into its

pages—for, we are not aware of any case, in which the fundamental principles in the law of trade marks, are more fully recognized—more clearly elucidated—or more faithfully applied.

The plaintiffs were importers of an article of gin—manufactured at Rotterdam in Holland. The manufacturers of this gin, in 1850, agreed to sell the same for importation and sale in the United States to a Mr. William S. Campbell—and to brand the casks, in which it should be shipped, with the name "Club House" and the initials of Campbell's name, "W. S. C."

This they did; and when the gin arrived in the United States, it was prepared for sale, by being drawn from the casks—and put into square bottles —which were packed in green painted cases, each containing twelve flasks. Upon one side of these green painted boxes were painted in white, the letters "W. S. C.," and beneath them, the words, "Club House Gin." The flasks or bottles were blown, with the same initials, and the same name, in the side or the shoulder—and to each flask was

also affixed a label, with a black ground and gold letters—containing the same name and the same initials—with other words, indicating the place of manufacture, (Rotterdam) and the name and address of the importer.

The plaintiffs claimed their exclusive rights, by virtue of a transfer of the business, expressly including the trade mark in question, executed to them in 1857, by W. S. Campbell—the initials of whose name corresponded with those of the principal plaintiff.

The defendants were importers of an article of gin from Holland—which they put into square bottles like those used by the plaintiffs—with the name "Club House" and the full name of one of the defendants, "J. T. Daly"—blcwn in the side—(This peculiar preparation of the bottle, it seems, was first adopted by the defendants.) These flasks were put into unpainted cases, similar, in size, to those used by the plaintiff, upon which, in black letters, were printed the words—"Old London Club House Gin"—and the name of the other defendant—"Wm. H. Daly." To each flask was affixed a label—with a white ground and black letters, containing the words "London Club House Gin"—and the name and address of "Wm. H. Daly—in *fac simile*—as the "sole importer."

The flasks of the defendants were sealed with a green seal, plain—those of the plaintiffs, were provided with a metallic covering over the cork—with the initials "W. S. C.," impressed in the centre—and the words "Club House Gin" around the edge.

Neither the assignor of the plaintiffs, nor the plaintiffs, prior to the commencement of this action had shipped their gin to, or sold it in, any other market, than that of New York.

The plaintiffs had shipped their gin to California—and had never sold it in any other market.

The bill of complaint contained the usual averments of piracy and colorable imitation by the defendants, of the plaintiffs' trade mark—and that they were thereby selling their gin as and for the gin of the plaintiffs—and inducing merchants and dealers to purchase of them—who would otherwise have purchased from the plaintiffs.

No evidence was offered, tending to sustain these averments—and indeed, it appeared, quite conclusively, as well from the actual course of business of the defendants, as from the testimony of many witnesses connected with the trade—not only that the gin of the defendants never had been sold, as and for that of the plaintiffs—and that no one ever had been induced to purchase, or had actually

purchased, the defendants' gin, supposing it to be that of the plaintiffs—but that—there was no point of similarity between the labels—flasks and cases of the respective parties—which could serve to mislead or deceive—even an unwary customer—and inuuce him to purchase the defendants' gin—under the impression that it was the plaintiffs'.

It appears, therefore, to have been conceded at the trial, that the claim of the plaintiffs to protection—was limited to the exclusive use of the words "Club House" as a designation for gin. It was contended that the plaintiffs' assignor, was the first to adopt and appropriate these words for this purpose—and that their use by the defendants, though in a different combination, and connected with words, names or devices, so entirely dissimilar as to preclude the idea of deception, was, nevertheless, such an invasion of the exclusive right of the plaintiffs in the abstract name, as to entitle them to the relief prayed for.

Thus was presented, in the language of the court—the question:

> "Whether the manufacturer or vendor of an
> "article, can acquire a right to the exclusive
> "employment of a word or words, having an
> "established meaning, to qualify the name of

"such article, so as to deprive every other per-
"son of the right of using such words, to
"designate any other article, apparently simi-
"lar—the words, of course—being such as
"to have no reference to the origin, ownership
"or manufacture of such articles."

"This bald question," adds the court—
"although often disposed of, perpetually recurs,
"apparently only from an expectation of im-
"portuning courts into extending the doctrine
"of protecting trade marks to the verge of
"granting a monopoly, and creating a judicial
"copyright—far more durable than that granted
"by statute."

This preliminary statement of the question, sufficiently foreshadows the manner of its final disposal by the court—but we cannot refrain from extending our quotations from the instructive discussion of principle and authority contained in the elaborate opinion of the court.

"The protection of trade marks, as they are
"called, originated simply with—as it is to
"be resolved into—the common law doctrine,
"that he who sold his own ware as another's,
"was responsible both to the party whose
"custom he had fraudulently obtained, and to
"him from whom he drew it away—and it
"was immaterial in what way he carried on
"the imposition, whether by verbal represen-
"tations, or simulations of marks, used to
"designate the wares, or other indicia of
"ownership."

The court then briefly reviews the earlier cases, at law—in Popham, Atkins and Douglas, the decisions of Mr. Justice DODDRIDGE, Lord HARDWICKE and Lord MANSFIELD—and adds:

> "The practice, however, grew up, of protecting trade marks against piracy—in a court of equity, by its more efficient powers,—out of which, a vast body of law has grown up, and a mass of elaborate decisions rendered, extending or limiting, the application of the principle—and converting the wrong doer into a trustee for the injured party, and it will be necessary to pursue its course through that mass, in order to dispose of the claim in this case."

Preliminary to this review of the decisions of the learned Chancellors of England and of the United States—the learned court states as deductions from these authorities, the following:

> "There are two principles steadily adhered to, in all the cases in equity—so far as we have been able to perceive.
>
> "*First*—That the intent to pass off the goods of the defendant as those of the plaintiff, must exist—although names may be used, equally with other devices, as instruments of such fraud."
>
> "*Second*—That the mere use of the name alone, not indicating any ownership, origin or man-

" ufacture of the article sold, and therefore, by
" itself, not instrumental in representing to a
" purchaser, that the goods bought by him, of
" the supposed pirate, were those of the com-
" plaining party; and only designating or
" exaggerating the materials, kind, quality,
" destined use, or class of customers, of the
" articles sold, was not to be protected — with-
" out proof of fraudulent intent by others, in
" such use."

The court then adds:

" The variety of cases which have arisen in
" respect to trade marks, grows simply out of
" the various ingenious means used by dealers
" in similar articles, to defraud each other,
" and actually to represent, without appearing
" to do so, that the wares sold or articles dealt
" in by one, are actually those of another —
" these, of course, are, almost, as various, as
" the instruments used by dealers as badges of
" their ownership or manufacture of articles
" sold."

" It is a curious fact, that an article, by a
" species of loss of individuality, gains more
" notoriety, if described by a name, having no
" reference to its ownership, than by one,
" which does — particularly if its merits are
" not of the highest order — although, at the
" same time, it more readily loses its celebrity,
" by the competition of new rivals for public
" favor, — manufactured articles, designated
" only by the name of the manufacturer, rise
" more slowly into notice, but as they can

"rise only by their merits, they last much
"longer in the public esteem."

"If courts were to consult the public good
"only, they should lend their aid less cheer-
"fully, to the protection of fancy names, than
"to those pointing out ownership—but they
"have placed their judgments entirely on the
"ground of relief for a private wrong."

"In England—Lord LANGDALE, the able
"master of the rolls, has repeatedly, in a series
of cases, laid down the true principles in
"various forms, so that it would seem strange,
"that he should have deemed it necessary to
"repeat it so often, were it not for the pertina-
"city of suitors, to carry the doctrine beyond
"its legitimate bounds—and acquire a judicial
"copyright in a name."

The learned court then proceeds to a careful and thorough review of the leading English and American cases, citing the language of the judges as establishing the principles laid down—and showing, very clearly, that even those cases, relied upon as countenancing a different doctrine, will be found upon examination "to contain other ingredients"—and, so far from repudiating the general principle, serve only to illustrate its correctness.

After this review and discussion of authority the court proceeds:

"It has long since been settled, that the
"common law gave no copyright in anything.
"The principle that the mere use of a name to

" designate an article, would give to those so
" employing it, the exclusive right to designate
" such article by such name, would be giving
" a copyright of the most odious kind, without
" reference to the utility of the application or
" the length of the title—it would be perpetual,
"—the words used, would be taken from the
" mass of the language, and dedicated to the
" gratification of a barbarous taste, a capricious
" whim, or an attempt to impose upon the
" public, high sounding words and rhodomon-
" tade—for real merit and lasting reputation—
" and if the invention of those who appropri-
" ated these names, was only equal to their
" love of imposition, the whole language might
" be laid under embargo, and no tradesman
" would hardly dare to call his wares by
" any descriptive language, lest he might inno-
" cently invade some person's appropriation
" and expose himself to an action for an
" account, for all the profits of his business.
" Courts ought not to be forward so to cramp
" the energetic competition of commerce, and
" give to a dull invention of an epithet, the
" rewards of successful enterprise."

Applying the established principle to the case before the court, the conclusion is stated, that the

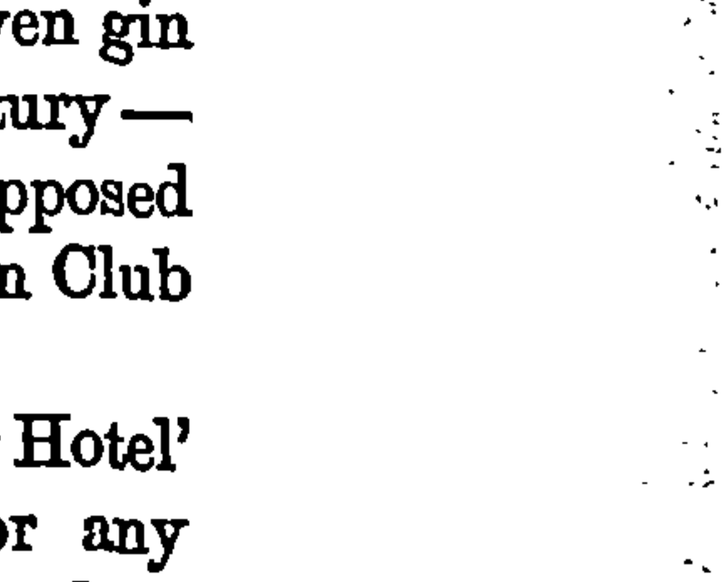
" Use of the words 'Club House' to desig-
" nate gin, cannot be confined to the plaintiffs,
" unless they indicate its origin, of which there
" is no evidence."

The court adds:

"But this term 'Club House,' not only does "not indicate origin, including in that word, "ownership and place of manufacture—or any "other means of designating that the commodity "was that sold by the plaintiffs,—but it does "indicate some other attribute or quality, such "as nature, kind, grade, destined use, or class "of customers, which has nothing to do with "origin, and the cases already cited, confine the "exclusive use of known words in a language, "to those which indicate the origin or owner- "ship of the article,—otherwise—selling by "the same title, would not tend to represent "them to be the same goods."

"The idea seems to have originated with "the existence of a Club House at the place "where the article was made, in which the "best articles of the kind, were really, or, at „ least, were believed to be, consumed—and "it was done, undoubtedly, to indicate the "quality of the article. Without recurring to "conjecture, the evidence establishes the con- "stant application of this epithet to indicate "articles of a superior quality, and even gin "itself, for nearly a quarter of a century— "a very natural result from the supposed "high standard of articles consumed in Club "Houses.

"Such an epithet does no more than 'Hotel' "'Royal,' 'Imperial' or 'Princes,' or any "other high sounding title would do—and no "one would be bound to suspect that there "lurked beneath those words, the indication of "a particular ownership or manufacture."



"It seems to be assumed that the rule is,
"that every existing word can be appropriated
"as a trade mark, and that the exceptions are
"those, expressing mere quality or kind—
"whereas, the true rule is—that no words can
"be used by themselves, without other devices
"as a trade mark—except such as point out
"ownership or origin—and those which have
"no reference, in any possible way, to any other
"attribute of the article."

"The words in question, come directly within
"the definition of Chief Justice DUER, in the
"'*Amoskeag Manufacturing Company* vs. *Spear*,'
"before cited—they are a symbol, which, from
"the nature of the fact they are used to signify,
"'others might employ with equal truth—and
"therefore have an equal right to employ,
"for the same purpose'—and no better test
"could be applied.

"If a person abandons the simple mode of
"indicating ownership, by the use of his own
"name, he ought, at least, to be required, not
"to appropriate as a trade mark, words not
"indicating ownership—but some other attri-
"bute of the article manufactured—and there-
"by forever exclude others from using the
"same name, to mean the same thing—and
"thus subject innocent persons, to the risk of
"being made liable for infringing on a right
"entirely unknown to them.

"Impositions upon the public in regard to
"such trade marks, deprive the inventors of
"any protection. Why should not traps laid
"for innocent dealers, be equally under the
"ban of courts."

Upon the subject of the supposed acquisition of property in trade marks by mere priority of appropriation—having premised that it is not easy to understand how priority of invention or use can confer such right—the learned court adds the following instructive considerations:

> "The right does not become established, "until the trade mark be so often used, and so "long employed, exclusively and uninter- "ruptedly, as to create the presumption that "everybody would know and acknowledge, "that it was the distinctive badge of the plain- "tiff's ownership, and that the use of it by any "one, must have been intended to deceive pur- "chasers. If other persons had used it previ- "ously—but its use had been discontinued so "long as to give room for the inference, that it "had been abandoned, as an ordinary designa- "tion of any similar articles—and it was then "taken up by a person dealing in the article— "and used exclusively and uninterruptedly, "so long as to give rise to the presumption "that it was universally recognized as the "indicia of his ownership, his right should be "protected as much as though it had then been "used for the first time. But the evidence in "this case, does not come up even to these "requisitions."

After a review of the evidence in the case, both as to the originality of appropriation, and exclusiveness of use, of the words claimed by the plain-

tiffs as their trade mark, and determining that it falls far short of that which is required, upon either point, and in any view of those questions—the court then proceeds:

> "Laying out of view, however, all question
> "as to the invention or application of the term
> "in question, as a trade mark by the plain-
> "tiffs—or to its character as being incapable
> "of appropriation as such—the question still
> "remains—have the defendants so employed
> "the term as a designation for the gin sold by
> "them, as to establish an intention to deprive
> "the plaintiffs of their customers for the article
> "in question?"

After a review of the evidence upon this point, the court says:

> "I do not see how the defendants could have
> "taken more precautions to guard against any
> "inference that they were selling the plain-
> "tiffs' commodity. They omit the plaintiffs'
> "initials, and add their own names. That cer-
> "tainly looks like claiming it as their own—
> "not the plaintiffs'. They also prefix the
> "words, 'Old London,' which proves that they
> "did not intend it should be mistaken for
> "Rotterdam Gin—and they pack the flasks
> "in unpainted boxes—while the plaintiffs put
> "theirs in painted ones."

But the conclusive character of the evidence upon this point, resulting from the course of busi-

ness of the defendants, in connection with that of the plaintiffs—is thus alluded to by the court—with reference to the principle established in the case of *Howard* vs. *Henriquez*, in which the defendant was enjoined from calling his hotel by the same name, as that established by the plaintiff, in the same town.

> " There is also another distinction between
> " this case and that of *Howard* vs. *Henriquez*,
> " which is therein recognized.
> " The defendants' goods are intended for, are
> " shipped to, and circulate only in, the Califor-
> " nia Market, as appears by the ninth and
> " tenth findings of fact—where the plaintiffs
> " carry on no trade—and though the invention
> " and application of the term 'Club House' in
> " Rotterdam, to a gin manufactured there, may
> " cross the Atlantic, with it—and be estab-
> " lished entirely in the exclusive possession of
> " the plaintiffs, in the New York market—it
> " cannot cross the Isthmus, double the Cape, or
> " traverse the desert to reach a country where
> " the plaintiffs' products are not known—and
> " where the inhabitants—if they have such
> " institutions as Clubs, may innocently believe,
> " that an article sold by that designation, is
> " thereby meant to be designated as of a higher
> " quality—and not that sold by the plaintiffs."

The decree of the court, in this case, in conformity with the principles, which it declares to be as well based upon sound reason, as sustained by

the entire current authority, is, that the complaint of the plaintiffs be dismissed—with costs.

CHAPTER V.

Of the violation of Trade Marks and of the remedy for such violation.

The discussion of the subjects of the preceding chapters, has, of necessity, to a great extent, involved, or required, the consideration of the question, as to what constitutes in law a violation of a trade mark, as well as the appropriate remedy for such violation.

The learned Vice-Chancellor, in the case of *The Collins Company* vs. *Cowen*, 3 Kay & Johns., 428, declares that a violation of an alleged trade mark constitutes the true and only test by which the right of property in it can be determined.

In the application, therefore, of this test, for the purpose of the inquiry into the constituent requisites of a legitimate trade mark—and its precise

nature and character, as property, entitling the owner to protection, in its exclusive use, that which constitutes a violation of such right, to be restrained by injunction or to be atoned for, in damages, has been so far considered already—that much that may be said under this division, will appear to be little else than a recapitulation.

There are, however, some questions, directly connected with that of the wrong and the remedy, to which no allusion has heretofore been made.

In general terms, a violation of a trade mark, consists in the false representation, that the merchandise manufactured or sold by the wrong doer, is the merchandise manufactured or sold by another person—effected, by the copying imitation, or colorable imitation, by the wrong doer, upon his goods, of the trade mark used to designate and distinguish the goods of the other, as his goods—so that dealers, or consumers, are, or may be, deceived by the representation, and induced to purchase the goods of the wrong doer, supposing them to be those of the owner of the trade mark.

Thus, it will be perceived, there are three conditions which must exist in combination, to constitute a violation of the right of property in a trade mark, entitling its owner to equitable relief, in the

form of preventive justice, to make more effectual his legal right—or to remuneration in damages for its invasion.

First—There must be a false representation;

Second—There must be a false representation effected in a certain manner; and

Third—This false representation, thus effected, must be designed or calculated to produce a certain result.

FIRST—To constitute such a wrongful invasion of the rights of another, it is not essential that the false representation should be fraudulent, and made with the intent to defraud and deceive.

Such an intent will be presumed to have existed upon proof of the facts.

In the vast majority of cases, the facts furnish such abundant evidence of a fraudulent intent, as to be wholly irreconcilable with innocence.

The case of *Millington* vs. *Fox*, 3 Myl. & Cr., 338, affords an instance, however, where the absence of a fraudulent intention was abundantly proved—although, in that case, the wrong complained of, consisted in the use by the defendant, of the name of the original manufacturer, the plaintiff himself, which he had stamped upon his steel.

It was, in this case, held by the Chancellor (Lord COTTENHAM) that to authorize an injunction, the deception need not be intentional.

> "That a man, though not intending an "injury to another, shall not be allowed to "adopt the marks by which the goods of "another are designated, if the effect of adopt-"ing them, would be to prejudice the trade of "such other person."

In the subsequent case of *Perry* vs. *Trufit*, 6 Bea., 66— Lord LANGDALE says, that he is "not aware that any previous case had carried the principle to that extent."

This must be for the reason, that no previous case had presented such a state of facts, as to invoke the application of the principle—surely not—as the language of the learned Master of the Rolls would seem to imply, because the principle itself, is at all strained or doubtful.

It is not easy to perceive upon what ground its justice can be questioned—and we are not aware that it has been questioned, in any subsequent decision.

The essence of the wrong, is, the selling of the merchandise of him who commits it, as and for that of him against whom the wrong is committed.

If A. manufactures a certain quality of steel,

upon which he stamps his name—and B. not knowing that the name thus stamped upon the steel, is the name of the manufacturer, but believing it to be a name simply descriptive of the particular kind or quality of the steel, stamps the same name upon the steel of like kind and quality, of his manufacture, which he sells in the market—it is obvious that he sells his manufacture, as and for that of A., just as effectually, as if he had known that he was violating a legitimate trade mark.

In the case of *Crawshay* vs. *Thompson*, 4 Man. & Gr., 357—this doctrine was distinctly affirmed.

There, it was held by Mr. Justice MAULE, that the declaration of the plaintiff would have been good, without the express allegation of the *scienter*, which it contained.

In the American cases of *Coates* vs. *Holbrook*, 2 Sand. Ch. R., 586—*Taylor* vs. *Carpenter*, Id., 603—*The Amoskeag Manufacturing Company* vs. *Spear*, 2 Sand. S. C. R., 608—and in *Coffeen* vs. *Brunton*, 4 McLean, 516—the principle laid down by Lord COTTENHAM, in *Millington* vs. *Fox*, is cited with approval.

In the case of *Coffeen* vs. *Brunton*, Mr. Justice MCLEAN says, alluding to the case of *Millington* vs. *Fox*:

"From the above, it would seem that an "intentional fraud is not necessary to entitle "the plaintiff to protection — but that, where "the same mark or label is used, which recom- "mends the article to the public by the estab- "lished reputation of another, who sells a "similar article, and the spurious article cannot "be distinguished from the genuine one, an "injunction will be granted, although there "was no intentional fraud. And I am inclined "to think that this is a correct view of the "principle — for the injury will be neither the "greater nor less by the knowledge of the "party.

"If he has adopted the same mark, which "will cause his article to be taken for another, "in the market where it is known and approved, "it is an injury which the law will redress."

The good faith, or fraudulent intent, of one who copies or imitates the trade mark of another, becomes material, with reference to the question of costs — and also, it may be, in the determination of the question of the amount of damages, in an action at law, where they are not susceptible of actual measurement, but must be left to the decision of a jury.

In the case of *Millington* vs. *Fox*, although the defendant was restrained, by the perpetual injunction of the court, he was relieved from the costs of the suit, expressly upon the ground that the facts acquitted him of the charge of fraudulent design.

in the case of *Crawshay* vs. *Thompson*, which was an action on the case, in which the defendant had a verdict—it was held that it was properly left to the jury, under the pleadings, and upon the question of damage, to say:

> "Whether the defendant used the mark,
> "with the fraudulent intention of supplanting
> "the plaintiff—or whether it was done in the
> "ordinary course of his business, and without
> "any such intent."

SECOND—The false representation must be made by copying or imitating those names, letters, marks, symbols or devices, which are used by another, upon goods manufactured or sold by him, and which he had a right to appropriate, to designate them as his—and to distinguish them from goods manufactured or sold by others.

We have already fully considered the paramount importance of requiring the strictest proof of this, as the essential element of a wrongful invasion of property in a trade mark.

We have seen that a violation of the property of another, in a trade mark, cannot be predicated of the copying or imitation merely of such names, marks, letters, symbols or devices, as do not designate the origin or ownership of the goods—but

are simply descriptive of the thing itself—or indicative of its kind, character or quality.

No person can, in any manner, acquire an exclusive right to the use of such names, signs, marks, letters, symbols or devices, who has not, at the same time, the exclusive right to manufacture or sell the article to which they are applied.

As simply denoting the article or its character, or relative or positive quality, such names, marks or devices, may, with equal truth and justice, be applied to the goods of one manufacturer as those of another—and therefore, no priority of appropriation—no originality of conception—no public declaration or long continued use, can avail as the foundation of an exclusive right of property.

But, as we have seen, such names, signs, marks, letters, devices or symbols—may be effectively used, as an auxiliary to the name and address of the manufacturer, or to such names, letters, marks or signs as *do* indicate the true origin or ownership of the goods, in effecting such designation, and, *in such case*, the use, or colorable imitation even, of such names, words or marks, only, as cannot be appropriated as property, may be as much a violation of right, as if the name and address of the manufacturer had been used or imitated, because

made with the same intent, and calculated to produce the like result.

By way of illustration of what is conceived to be the established principle, justly deducible from all the authorities—and resting upon the true policy and purpose of the law—and in order to a still further exposition of our views of the pre-eminent importance of this principle—as one necessarily involved in almost every trade mark controversy that can arise—we will state a case:

A. B. is the manufacturer or vendor of a certain kind of gin. It is distilled at Scheidam. He calls it "Club House" gin—and this name was never before used, as a designation for gin, or any other article of merchandise.

He puts it into bottles of a certain size and form—each bottle is provided with a stiff yellow paper covering—on the side is a label, with a pink ground, containing the words, "A. B's Club House Gin," in vermillion letters, fancifully arranged—and on the same label, in blue letters, several lines, peculiarly arranged, containing a description of the nutritious and health-restoring qualities of the contents of the bottles—ending with the statement that it is manufactured at Scheidam.

The gin of A. B., thus put up, marked and labeled, is sold in the market as "A. B's Club House Gin." By that name it becomes known to dealers and the public. So that—whenever 'Club House Gin" is alluded to, or called for, the name of A. B. is connected with it, by association.

By long use, the name, "Club House," in itself possessing no such property, has become suggestive of the origin or ownership of the article.

C. D. is also a manufacturer, or vendor, of gin. It is distilled at Rotterdam. Regarding his gin as an article of such quality, as fits it to be used at Club Houses, where none but the choicest productions are supposed to be consumed, he calls it—"Club House Gin." He puts it into bottles of the size and form, known as the gin bottle. This bottle is provided with no covering or wrapper—but on one side is fixed a label, with a black ground, containing in gilt letters, plainly, but not fancifully printed, the words, "C. D's Club House Gin, Rotterdam," without addition—thus, taking every precaution that the gin that he manufactures or sells—shall be sold as his, and not as and for that of A. B.—so that there can be no deception, even of the most unwary.

Now, according to settled principles, and the

uniform current of authority—this is no violation of the trade mark of A. B.

It is a mere use by C. D. of the words "Club House," upon his gin, which word, he had just as much right to use as A. B. had—notwithstanding that A. B. devised and first used the word—and proclaimed that it was his trade mark—and for a long time has employed it as such—*provided*, that in its use, C. D. is careful that there be no such similitude, otherwise, between his trade mark or label and that of A. B. as can mislead any one, or enable him to sell his gin, to the most unwary customer, as and for that of C. D.

To apply the language of the learned judge, in one of the leading cases.

> "If the mere use of the words ['Club
> "House,'] by reason of their long association
> "with A. B., should have the effect of mislead-
> "ing the public, as to the true origin of the
> "gin, it would be unreasonable to suppose,
> "that he is therefore precluded from using
> "them, as an expressing of the facts which
> "they really signify, and which may be just
> "as true, in relation to his gin, as to that of
> "A. B. or another. Purchasers may be
> "deceived. They may buy the gin of C. D.
> "as that of A. B.—but they are not deceived
> "by a false representation. They are deceived,
> "because certain words suggest a meaning to

"their minds, which they do not, in reality,
"bear, and were not designed to convey."

Again, a third manufacturer of gin is E. F. His gin is distilled at Amsterdam. He puts it into bottles, of the size and form, used by A. B. He provides each bottle with a wrapper or covering, of stiff yellow paper, and on one side affixes a label of pink paper, on which, in vermillion and blue letters, in the same fanciful arrangement—in the like form, and of the same size, the precise words are printed, which are contained in the label of A. B.—except—that he *neither* copies nor imitates the proper name of A. B. but carefully substitutes his own name therefor—and calls his gin, "E. F's Club House Gin."

Now, in such a case, in accordance with the well established principles, and the uniform current of authority, E. F. has been guilty of a fraudulent invasion of the right of property of A. B. in his trade mark—notwithstanding that he has not used in his label, any words, letters or marks—which, by themselves, he had not as perfect a right to use, as A. B. had.

But these words, letters or marks, have been *so used* by E. F.—with such an exact similitude, in all respects, to the manner of their use by A. B.—as to divert the attention of the purchaser, from

the single point of variation, namely, the name and address of A. B.—which E. F. had no right to use, in any manner—and to produce the impression that the Club House Gin of E. F. is in truth, the Club House Gin of A. B.

This being so, the variation in the label, by the substitution of the name and address of E. F. for that of A. B., becomes wholly immaterial—for the sole purpose of that variation, when regarded in connection with the elaborate simulation in every other respect—was, not to communicate a truth, but to escape the penalty of a falsehood.

> "A fraud was designed" (to use the language of the same learned judge) "an "attempt was made to realize an unlawful "gain, but it was apparent that the variation "in the label was made, in the delusive belief "or hope, that thereby, an injunction might be "avoided, and a claim for profits, or damages, "might be repelled."

But, this is a violation of the right of property in a trade mark, which, upon the principles established as the basis of the protection which the law extends to such property, will be suppressed, by the extraordinary powers of a court of equity, and its fruits intercepted and restored.

THIRD—A violation of property in a trade mark, consists, not only in a false representation—and a

false representation by a copy or imitation of those letters, words, marks, signs, symbols or devices, which another has appropriated, and had a right to appropriate, as designating his manufacture, and distinguishing the same from all others—but, in the third place, it must be such a false representation, and such a copying, imitation, or colorable imitation, as is calculated to mislead and deceive, and induce the belief that the goods to which the simulated trade mark is affixed, are the goods of the true owner of the trade mark.

Upon this point—the question which first presents itself, is—who are the persons to be misled, by the false representations and the deceptive imitations? Are they dealers in the article? Persons who purchase to sell again? Are they consumers, the public generally? Are they persons who exercise caution, prudence and intelligence in their business affairs—and are not likely to be easly misled—or are they the incautious—the ignorant and unwary?

There does not seem to be any question as to the true principle here involved.

The injury, threatened or committed, by the violation of the right of property in a trade mark, is the unlawful appropriation of the profits, which, of right, and in justice, belong to him, who by his

superior skill, industry, energy or enterprize, has established a reputation for his goods, and caused them to be known and sought for, under a particular designation—and also, the injury, threatened or committed, (where, as in most cases, the goods of the imitator are of an inferior value or quality,) to the established reputation of the original manufacturer, the inferior article, being mistaken for his.

Now, it seems to us, obvious, that the question, who are the persons to be misled or deceived—has reference altogether to the *extent* of the injury threatened or inflicted. It cannot be any the less a wrong—because very few persons, in a comparatively unimportant class, can be, or are at all likely to become, subjects of the deception.

If the copying or imitation of the trade mark of another, be made, in such a manner as to be manifestly designed and calculated, to deceive any one, it matters not if he be the most unwary, careless or illiterate purchaser, precisely to that extent, it is a wrong, demanding the interposition of the law, in its redress.

Such has often been declared to be the true principle, upon which the jurisdiction of the courts is invoked, for the protection of property in trade marks.

In the application of this principle it will be

found, that the authorities are not entirely harmonious.

Precisely as learned judges are disposed to regard with favor and encouragement, this peculiar character of property—or, on the contrary, are inclined to consider it an encroachment upon natural rights, and an obstacle to honest competition, do we find them granting or withholding equitable relief, by their views of the nature and extent of the deception, which the alleged simulated trade mark discloses.

In *Croft* vs. *Day*, 7 Bea., 84—Lord LANGDALE declares the test to be:

> "Whether the contrivances of the defend-
> "ants were calculated to mislead the bulk of
> "the unwary public."

And in *Crawshay* vs. *Thompson*, 4 Man. & Gr., 357—substantially the same test is laid down by Mr. Justice MAULE, thus:

> "The question was, whether the defendants'
> "marks have so close a resemblance to the
> "plaintiff's, as to be calculated to deceive the
> "unwary, and to injure the sale of the plain-
> "tiff's goods."

In *Welch* vs. *Knott*, 4 Kay & Johns., 747—the plaintiff was a manufacturer and vendor of soda water in bottles—labeled,

"Schweppe & Co., 51 Berners St.,
Oxford St—Genuine Superior
Aerated Waters."

The labels were colored and pasted over corks—, Connected with the above words was a *fac simile* signature—"J. Schweppe & Co."—with the addition—"By special appointment," and upon the label was the figure of a crown, &c.

The defendant sold soda water in bottles—stamped like the plaintiff's. A label of a similar color, was pasted over the cork. On this label was printed, instead of "J. Schweppe & Co.," the words "Soda Water," in characters similar to those in which the signature was printed on the plaintiff's label—a similar crown—with the other devices, were on the defendants' label.

The resemblance was so close, as to deceive the eye upon a casual observation—but a close inspection would disclose the dissimilarities.

Yet, upon these facts, the learned Chancellor, (CRANWORTH) refused the injunction prayed for, in the absence of extrinsic proof.

> "That the defendants had used the label on
> "their bottles, with the intent—or so as in
> "fact, to mislead the public."

In the case of *Partridge* vs. *Menck*, 2 Sand. Ch. R., 622, the facts as they are reported, in relation

to the imitation by the defendant, of the plaintiff's label, upon his boxes of matches, were even stronger, as evincing a manifest design to mislead and deceive, than in the case of *Welch* vs. *Knott*.

Certainly, nothing but such a design, could have induced the copying by the defendant, upon his label, among other things, of the figure of a *bee-hive*—which was a prominent feature in the label of the plaintiffs. Yet, upon careful examination, and especially on the removal of the lid or cover of the box, containing the matches, dissimilarities were discoverable.

The learned Vice-Chancellor (SANDFORD) denied the injunction, and in doing so—uses the following language:

> "Although the court will hold any imitation,
> "colorable, which requires a careful inspection,
> "to distinguish its marks and appearances,
> "from those of the manufacture imitated, it
> "is certainly not bound to interfere, where
> "ordinary attention, will enable a purchaser
> "to discriminate.
>
> "It does not suffice, to show that persons
> "incapable of reading the labels, might be
> "deceived by the resemblance.
>
> "It must appear that the ordinary mass of
> "purchasers, paying that attention, which such
> "persons usually give, when buying the article
> "in question, would probably be deceived."

This decision was sustained by the Chancellor, [WALWORTH,] on appeal—and the language of the learned Vice-Chancellor has been often quoted, with approval, in subsequent American decisions.

In the case of *The Merrimac Manufacturing Company* vs. *Garner*, 4 E. D. Smith, 387—the decision of the majority of the Court of Common Pleas of the city of New York, in accordance with, and based upon, that of *Partridge* vs. *Menck*, denied the injunction prayed for, where the facts seemed to warrant the conclusion that the defendants had deliberately contrived their trade marks, upon the goods of their manufacture, with the fraudulent design of passing them off as the goods of the plaintiffs' manufacture.

> "Courts are not bound to interfere,"—says the learned judge, in giving the opinion of the majority of the court—"Where ordinary "attention, will enable a purchaser to discrimi- "nate."

An injunction in that case had been granted in the first instance, by Mr. Justice WOODRUFF (now of the Superior Court of the city of New York) and his very able opinion given on the hearing before him, was adopted as his dissenting opinion, on the appeal to the full bench.

The current of authority upon this point—as

have seen by the cases heretofore reviewed, cannot be regarded as sustaining the views expressed by Vice-Chancellor SANDFORD—and affirmed in the cases we have cited—and it certainly would seem, upon a careful consideration, that such views, however they may at first appear reasonable and just, are not altogether consonant with the liberal and benignant policy of the law, in protecting property in trade marks.

Why should courts withhold their protection, or refuse to interfere, "where ordinary attention will enable a purchaser to discriminate?"

Upon an examination of the numerous reported cases of alleged violation of property in trade marks, both in the English and American books, it will be found that, in the large majority of instances, the studied design of the fraudulent trade mark imitator, has been, so to contrive his similitudes as to be enabled to say:

> "Had you been but ordinarily attentive, as
> "a prudent man always should be, you would
> "have discovered the dissimilarities, and have
> "escaped deception;"—

at the same time that his cunning simulations, have all the while been contrived and ingeniously designed, and directed, to accomplish the precise purpose, of diverting all attention from the discrim-

inating dissimilarities—and administering a fatal narcotic to ordinary prudence.

The fraudulent imitator is perfectly willing to hazard the detection, which his half concealed marks of dissimilarity, may enable those to make, who are not thrown off their guard by his skilful simulations, for the sake of the profits which he reaps from those whose attention he succeeds in diverting, and whose prudence he lulls to sleep.

It certainly seems to us, that a rigid application of the doctrine of the case of *Partridge* vs. *Menck*, would result in a denial of all effectual relief in the large majority of cases of piracy upon trade mark property.

The better doctrine—that which harmonizes with the true policy of the law, and is sustained by the weight of authority, is—that, wherever, upon the face of a label or trade mark, it appears to have been the manifest design, to effect a similitude, with an original label or trade mark—so that deception *may result*, and the goods of the imitator be *thereby sold as and for those of the true owner of the trade mark*—whether such deception might or might not be avoided, by the exercise of ordinary attention and prudence—an injunction should issue.

Upon any other doctrine, the pirate upon trade mark property, is enabled to base his claim to

impunity, upon those very weaknesses of a credulous public, to avail of which, were the precise purpose and calculated result of his fraudulent contrivances.

Should it come to be understood, that, without fear of the law's restraint or redress, one might appropriate to himself, the gains and profits to which another is justly entitled, by the simulation of his trade mark, upon the spurious goods of the wrong doer's manufacture—provided that the simulation be so ingeniously modified, or palliated, as to contain some points of dissimilarity, which may be detected, and enable the purchaser to discriminate between the true and the false, by the exercise of common prudence and ordinary attention—property in trade marks will no longer be protected—for then, every simulation will be thus characterized, as nearly every one is at the present time.

If it be, that the doctrine of the cases of *Partridge* vs. *Menck*, and *The Merrimack Manufacturing Company* vs. *Garner*, was adopted from a supposed application of the rule of *caveat emptor*, the error lies in an incorrect discrimination of the person, against whom the wrong is committed, in the violation of trade mark property.

It has never been doubted that an action will

lie at the suit of the purchaser of goods of a spurious character, or inferior quality, against the fraudulent imitator of an original trade mark, who by his colorable imitations, has inveigled him into the purchase, on the supposition, that he was buying the well known goods of the genuine manufacturer.

Such was, undoubtedly the early case in the Year Books, of the Gloucestershire Cloth Merchant —reported in Cro. Jac.

But even in such an action, the rule of *caveat emptor*, however rigidly it may be enforced, in cases where it may be applied without a violation of the first principles of justice—could not be invoked for the protection of him, whose fraud consists in ingenious and successful contrivances, to the end, that the purchaser shall *not take care*.

By way of illustration,—take the facts of the case of *Partridge* vs. *Menck*—and suppose that a purchaser of the spurious matches of Menck, believing them to be the genuine matches of "Golsh," should bring his action on the case to recover damages for the deceit practised upon him by Menck.

The defendant says—"True it is, that the label upon the boxes containing the spurious matches that I sold to the plaintiff, was made to imitate that, upon the boxes of matches which he had previously purchased as those of 'Golsh.'"

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It contained the beehive, and the other devices, arranged in the same manner as in the original label. It also contained in large letters, of the same character, the name "A. Golsh"—but if the plaintiff had but raised the covering upon my boxes, he would have found over the words "A. Golsh" the words—"manufactured by Menck, late chemist for"—and, although in smaller type than the words "A. Golsh," yet, "perfectly plain and distinct, and printed in type only a trifle smaller than the capitals used in our recent published reports." To be sure, I intended to deceive the plaintiff—but he should not have been deceived. I designed that he should not take care—but he should have taken care. My contrivances were calculated to lull suspicion, to divert attention,—but he should have suspected—ordinary attention and common prudence would have enabled him to detect my contrivances, and avoid the deception—but such attention and prudence has not been exercised, and I invoke, on my behalf, that rule which declares that the law will not take care of him who refuses to take care of himself."

Without any very violent presumption, a person capable of committing such a fraud, may be supposed to be possessed of the requisite effrontery to seek impunity for the offence, at the hands of a

court of justice, upon such grounds as these—but we should unwillingly believe that he would be able to find any respectable counselor of the court, willing to hazard his professional repute by the serious interposition of such a defense.

If, then, the doctrine of *caveat emptor*, be wholly inapplicable, in such a case, even at the suit of the purchaser himself—how much less applicable is it—where redress for the wrong is sought by him who could not have avoided the injury, by any care, prudence or attention on his part—and whose damage, by reason of the wrong, is, by many degrees greater, than that of the misled purchaser.

If the wrong doer may not defend the wrong, as against the purchaser whom he has deceived, by saying, "If you had exercised ordinary attention, you would have escaped the deception"—still less should he be able to do so, as against the owner of the trade mark—whose profits he has appropriated, and whose reputation he has injured, by saying, "If this party, this careless purchaser, whom you did not know, and could not control, had been a man of common prudence and sagacity, and had exercised ordinary attention, I should not have succeeded in my contrivances to pass off upon him my inferior and spurious goods, as and for your manufacture, and you would then have escaped the

injury, which my fraud was designed to inflict upon you."

If these views be not altogether illusory — then, the administration of justice in the protection of trade mark property, in accordance with the true policy of the law, can be predicated only of a strict adherence to the doctrine which declares that:

> "Whenever, upon the face of a label or
> "trade mark, it appears to have been the
> "manifest design, to effect a resemblance to
> "the label or trade mark of another, so that
> "deception may result, not as a probability
> "merely — but as a possibility — and the goods
> "of the imitator may be thereby sold, as and for
> "those of the true owner of the trade mark —
> "an injunction ought to issue — whether the
> "deception that has produced or might pro-
> "duce this result might or might not be, or
> "have been, avoided, by the exercise of ordi-
> "nary attention and prudence."

What, under the circumstances of any particular case — should be considered and held to be sufficient evidence of "ordinary attention" or "common prudence" — would open a wide door for discussion, and the adoption of such a test, as the basis of the equitable jurisdiction of the court — would remove all limit to the exercise of an arbitrary judicial discretion.

But, whether a particular trade mark, alleged to be a fraudulent imitation of another, discloses upon its face, any of the badges of simulation, or whether it be an honest designation, indicating that he who has adopted it, relies only upon the intrinsic merits of his goods, for his success in their sale, is—ordinarily of easy determination.

Whenever an imitation is apparent, of any portion of the trade mark of another, which has been used by him to designate the merchandise to which it is affixed, as his manufacture, it is perfectly safe to say—that such an imitation has not been made with an honest object.

The honest competitor, who relies solely upon his own skill and industry and enterprise, does not require a resort to simulated devices, or names or marks.

His aim and purpose is, so to present his merchandise in the market, that it shall be known as his, and never, by any chance, be supposed to be that of another, and thus the public be left free to choose between articles avowedly of different origin.

The right of property in trade marks, may be violated—by the printer, engraver or other mechanic, who prepares the forged or simulated label, brand or mark—as well as by the fraudulent manufacturer or dealer, who causes it to be prepared, or adopts and uses it upon his merchandise, and such violation may in like manner be prevented or redressed, by proceedings in equity or at law.

The recent case of *Farina* vs. *Silverlock*, 4 Kay & Johns., 650,—is in point, as illustrative of this salutary doctrine.

The defendant was a printer, and as such, prepared certain labels, in colorable imitation of those used by the plaintiff, upon his bottles, containing the celebrated liquid, known as "Farina's Cologne."

These labels were sold by the defendant, to any person applying for them, although it was pretended that they had been purchased in good faith by persons, for the purpose of being applied to the bottles containing the plaintiff's own manufacture, from which the labels had been lost.

But the learned Lord Chancellor ordered an injunction to issue, notwithstanding the possibility that some of the labels might have been purchased, *bona fide*—and says:

"The ground of this equity is—that the "defendant, by knowingly printing labels, in "imitation of the plaintiff's trade mark, and "selling them to any one who asked for them— "was *supplying the means of committing, and* "*was thus a party to, frauds, which courts of* "*equity, will interfere to stop at their source.*"

The injury inflicted by the invasion of trade mark property, is by no means limited to the wrongful appropriation by the fraudulent manufacturer or dealer, of the pecuniary profits which of right appertain to the true owner of the trade mark, whose merchandise the purchaser believed himself to be buying.

In many cases, by far the greater injury which ensues, results from the loss of that good name and reputation, which the original manufacturer had acquired for his merchandise, by his superior skill and industry, as well as by his integrity—a reputation which is, in one sense, the good will of his business—inspiring and retaining the public confidence, and thereby securing a constant demand, and ready sale, for his productions.

The fraud, and falsehood, and forgery, of him who copies or imitates his trade mark, and, placing it upon a spurious or inferior article, induces a public belief that the spurious article is the manufacture of him in whom they had theretofore

reposed so much confidence, is, in effect, a robbery of his reputation, which, unchecked, must end in the withdrawal of public confidence, and the consequent destruction of his established business.

It is undoubtedly true, that in some instances, the article to which the simulated trade mark is attached, may be equal in quality and value, to that of the established manufacture—the purpose in such case, being, to avail of a reputation already acquired, to facilitate sales, and the more speedily to realize profits.

It is obviously quite immaterial to the determination of the question whether an injunction should or not issue, in a case of alleged invasion of trade mark property—to ascertain the relative merits of the respective articles of merchandise.

Wherever it is made to appear, by inspection or extrinsic proof, that the trade marks of a manufacturer or dealer, have been copied or imitated, upon the merchandise or manufacture of another, the law presumes it to have been done, with the fraudulent intent and purpose, of inducing the public, or those dealing in the article, to believe that the goods falsely designated, are those of the original manufacturer, and of thereby supplanting him in the good will of his trade or business.

No proof, that the merchandise to which the

simulated trade mark is attached, is equal, or even superior, in quality and value, to that of the true owner of the designating brand, can tend to rebut, or diminish the force of this presumption.

We therefore find, that courts of equity, uniformly refuse to consider the question of superior or inferior quality—or to allow ary evidence to be given upon the subject.

Where, however, redress for the wrong inflicted, is sought at law, in the form of pecuniary damage, the question of the true character of the article which has been passed off as that of the plaintiff, by means of the fraudulent trade mark, may become of vital consequence.

It is not doubted, that a jury, in determining the amount of their verdict, to which a party plaintiff in a trade mark action, may be entitled, by way of indemnity for the wrong inflicted, not only have a right, but are in duty bound, to take into consideration the natural and probable consequences of the wrong, as affecting the good name and reputation, and therefore the good will, of the plaintiff's business—and to this end, proof of the spurious or inferior character of the merchandise that has been fraudulently represented as his—may be pertinent and material.

Actions at law, for the recovery of damages, as indemnity for an invasion of trade mark property, are comparatively of rare occurence.

The most appropriate, as well as the most efficient remedy, in the large majority of cases, is that relief, which it is the peculiar province ot courts of equity to afford, (in the language of Vice-Chancellor, Sir W. PAGE WOOD) "in the form of preventive justice, in order to make more effectual a legal right."

> "The legal right is that which any person,
> "designating his wares or commodities by a
> "particular trade mark, as it is called—has—
> "to prevent others from selling wares which
> "are not his—marked with that trade mark—
> "in order to mislead the public—and so inci-
> "dently, to injure the person who is the owner
> "of the trade mark."

The remedy in equity for a violation of trade mark property, is not only effectual—as operating to restrain by injunction the continuance of the wrong—but, jurisdiction being once assumed, to this end, it will be exercised to make the remedy complete, and to avoid a multiplicity of suits—by a final decree of pecuniary indemnity—the amount

of which it will determine, if need be, by ordering a discovery of the evidence in the defendant's possession, contained in books of account, or otherwise—by compelling the rendition of a full and true account by the defendant, of all the sales of the merchandise made by him, marked with the trade mark of the plaintiff, or a colorable imitation thereof—or by reference to a master, or other person, on the application of the plaintiff, to ascertain and report the amount of his damages (*vide* *Knott* vs. *Morgan*, 2 Keen, 213; *Millington* vs. *Fox*, 3 Myl. & C., 338; *Bailey* vs. *Taylor*, 1 Rus. & M., 73; *Whittington* vs. *Wooler*, 2 Swanst., 428; *Delondre* vs. *Shaw*, 2 Sim., 237; *Bramhall* vs. *Halcomb*, 3 Myl. & C., 737; *Clement* vs. *Maddicks*, 22 Law Rep., 428; *Stern* vs. *Carlan*, 13 Law Rep., 360; *Bell* vs. *Locke*, 8 Paige, 275; *Taylor* vs. *Carpenter*, 2 Sand. Ch. R., 611, 612).

That the extraordinary powers of courts of equity, in restraining by injunction the disposition of articles of commerce, under particular designations, should be exercised with great caution—so as neither to jeopardize general or individual interests—nor to invade the principles and policy of the law, upon which the right of protection is based—will not be denied.

But, while on the one hand, such caution should

be at all times observed—on the other—it should never be allowed to degenerate into that timidity, which may end, in regarding all cases as invested with circumstances of doubt, sufficient to require the establishment of the legal right in a court of law—before restraint by injunction should be granted.

We have already had occasion to consider this subject at some length, in connection with a review of the opinion of the court in the case of *Partridge* vs. *Menck*, when before the Vice-Chancellor, and on appeal to the Chancellor of New York.

It is an important subject—involving, as we conceive, the whole question of the effectual administration of preventive justice—in the protection of the right of property in trade marks.

The subject here again arises, as a natural incident to that we are now considering, namely: the remedy for a violation of trade mark property.

Having referred to the American case of *Partridge* vs. *Menck*, as inculcating doctrines, which, if once established, we apprehend would operate as a fatal barrier to the only available and effectual relief in cases of trade mark piracy, in this connection, we refer to the English case of *Spottiswoode* vs. *Clark*—10 Lond. Jur. Rep., 1043—as illustra-

tive of what we cannot avoid regarding in this respect, as containing an expression of conclusions which can hardly fail to lead to, and terminate in, a like result.

The plaintiff in the case of *Spottiswoode* vs. *Clark*, was the proprietor of a publication called "The Pictorial Almanac," for 1847, having been prepared, and being about to be issued, for that year, in continuation of a series, of the like publication, prepared and issued for the preceding years—each having the like external appearance. The cover was decorated with a pictorial representation of the Greenwich Observatory. The title was printed upon the cover, together with words descriptive of the character and contents of the publication—and in size, color and arrangement, the almanac of each year bore an exact resemblance to that of the preceding year—with the exception only of the figures forming the date.

The defendant had prepared an almanac for the year 1847, and was about to issue the same, which he called "Old Moore's Family Pictorial Almanac." The contents of the respective almanacs were dissimilar—but the cover prepared for that of the defendant, was almost an exact resemblance of that of the plaintiff—having the same pictorial representation of the Observatory at Greenwich, the

same title and description of contents, in the same words, and printed in the same style.

This imitation, it was averred, was intentionally adopted to deceive the public, by inducing the belief that the defendant's almanac was the true continuation of the plaintiff's series—and thus to injure the sale of the plaintiff's publication, by a wrongful appropriation of his patronage.

The Vice-Chancellor of England, upon these facts, granted an injunction to restrain the defendant,

> "From selling any almanacs, bound in paper "wrappers, or covers, or other wrappers, or "covers, with the title, 'Pictorial Almanac,' "printed thereon, or having any other title "printed thereon, so as, by colorable represen- "tation, or otherwise, to represent the almanacs "printed and sold by the defendant, to be the "same as those printed and sold by the plain- "tiff, for the year 1847."

On a hearing, upon the pleadings and proofs, the Vice-Chancellor denied a motion to dissolve the injunction—and an appeal was taken before the Lord Chancellor.

Upon the appeal, and without calling for a reply to the argument in favor of the injunction, and for the affirmance of the Vice-Chancellor's decree, the Chancellor (Lord COTTENHAM,) dissolved the injunction.

His opinion and reasons for this conclusion, are substantially as follows:

> "These cases depend so much on their own "circumstances, that all that the court can do, "is, to lay down principles under which such "cases may fall.
>
> "I have, before this, had occasion to express "an opinion, that unless the case be very clear, "it is the duty of the court to see that the legal "right is ascertained, before it exercises its "equitable jurisdiction. For this there are "good reasons.
>
> "The title to relief depends on a legal right, "and the court only exercises its jurisdiction "on the ground that the legal right is estab- "lished."

This is, unquestionably, the established doctrine. It is as distinctly laid down by the same learned Chancellor in the earlier case of *Motley* vs. *Downman*, 3 Myl. & C., 1—and has since been repeatedly recognized and affirmed, both in English and American decisions.

But, was not the legal right of the plaintiff *Spottiswoode* clear and undeniable?

Is there any doubt, that a proprietor of a periodical publication, has a legal right to prevent another publisher, from issuing a publication of the like general character, so prepared in external appearance, as to be an exact resemblance of that

of the original proprietor, and to induce the public belief, that it is the true and genuine publication, in continuation of the series?

This was expressly held in the case of *Hogg* vs. *Kirby*, 2 Ves., 226, in which Lord ELDON declared, that "the publication by the defendant, of what purported upon its face, to be, or bore the external semblance of being, a continuation of the magazine of the plaintiff—was such a fraud upon the good will and patronage of the plaintiff's periodical work, as to call for the interference of a Court of Chancery."

In the American cases of *Snowden* vs. *Noah*, Hopkins, 347—and *Bell* vs. *Locke*, 8 Paige, 74—the same doctrine was distinctly affirmed,—so that, in a case like that of *Spottiswoode* vs. *Clark*, there would seem to be no doubt as to the plaintiff's legal right.

The learned Chancellor proceeds:

> "One objection to granting an injunction in "the first instance, is, that it promotes after "litigation—the order either grants an injunc- "tion, and compels the plaintiff to bring his "action—or suspends the injunction, with "liberty to the plaintiff to bring an action.
>
> "If you compel him to go to a court of law, "you promote litigation, and this course is "forced upon parties, at a time when their

" feelings are deeply engaged in prosecuting
" their imaginary rights."

If the effect of granting an injunction in the first instance, were, to promote after litigation, it would indeed be a very serious objection—but surely, the experience of courts of equity, in controversies of this nature, abundantly proves the truth of the converse of this proposition. Why is the plaintiff compelled to bring his action at law, as a consequence of granting the injunction? This, to be sure, is all that he can do, if an injunction be denied him, and he determine upon a further prosecution of his rights, but if an injunction be granted, in the great majority of trade mark controversies, the protection which that restraint affords, is all the remedy, and the entire relief, that is desired. The efforts of the defendant are directed towards procuring a dissolution of the injunction. To this end, he brings to his aid all the facts and circumstances, which he could invoke in his behalf—in the defense of an action at law —and failing to accomplish this object, the litigation, as a general consequence, there terminates.

In the case before the Lord Chancellor, an injunction would have been the plaintiff's adequate and complete relief—and the necessity of any after litigation at all. could only have been the

consequence of a denial of the injunction, thereby enabling the defendant to commit the alleged wrong—and compelling the plaintiff to seek redress in damages.

The Lord Chancellor proceeds:

> "There is another objection, which is, that "the court expresses a strong opinion, (and it "ought to be a strong opinion,) and then sends "the right to be tried. I think it better that "the court should refrain from expressing such "an opinion."

It is obvious that this objection must apply to all cases, alike, and with the like force—if, in truth, there be any force in the objection.

But we cannot, we confess, perceive the necessity—in the event that the defendant persists in the trial of the legal right, notwithstanding the granting of the injunction by one court, and the refusal to dissolve the injunction by another, and an appellate tribunal—of such decision, exercising the slightest influence in the determination of the right, on the trial of the action at law.

But suppose that such decision could properly and legitimately be brought before the court and jury upon the trial, to influence their determination—is it not obvious, if the injunction prayed for is denied, or is dissolved after a hearing, in

which the plaintiff presents all the evidence that his case allows—that the court, by such decision, expresses an opinion adverse to the right, just as strong, and calculated in like manner, to influence the determination of the issues in the trial of the legal right—against the plaintiff's claim?

It certainly seems to us, that if an objection of this nature, be allowed to have any weight at all—precisely to that extent, it must paralyze the arm, in whose strength rests the strong hope of succor and protection, against fraudulent invasions of property in trade marks.

> "But, after all," says the Lord Chancellor again, "the chief objection is, that the court "runs the risk of doing the greatest possible "injustice. Consider what would be the result "in this case. If this publication is not per- "mitted to be issued within the next month, "the principal sale will be lost. This is clear. "It is an almanac for 1847—and therefore, to "restrain the defendant till after the Spring "Assizes—what use would it then be to him, "if he was found to be in the right? You "would take money out of his pocket, and "give it to nobody, and at the same time, a "great and irremediable injustice might be "committed."

The answer to all this, is obvious, and is simply this—The plaintiff did not seek to restrain the

defendant's publication, at all, but only to prevent his sending it forth, with such a cover or wrapper upon it, as would inevitably accomplish the fraudulent purpose manifestly intended—namely, to induce the public to believe that it was the plaintiff's almanac—and therefore purchase it, as such.

And such—and such only, was the Vice-Chancellor's injunction, which the learned Chancellor dissolved.

To prevent the plaintiff from using a cover for his almanac containing a pictorial representation of the Greenwich Observatory, with title, printing and devices, in substantial resemblance to that used by the plaintiff, was surely no restraint upon the defendant's publication—nor could it be regarded as any hardship upon the defendant, that he should be compelled to adopt a different cover—so that his publication should rest upon its own merits—and not be allowed to depend upon false tokens or misleading representations.

> "As to the particular facts of the case," the Lord Chancellor says: "If the parties "separately sat down to invent a wrapper, "there is certainly a remarkable coincidence "in what they have produced. Both covers "represent a portion of Greenwich Observa- "tory, and profess the work to be, for all sorts

> " of persons. It is difficult to believe that all
> " this is accidental."

In other words, the Lord Chancellor did not believe that the defendant's cover bore an accidental resemblance to that of the plaintiff—but on the contrary, that it was an intentional imitation—if an intentional imitation, then the dishonest and fraudulent purpose is a legal presumption—and this being so, and the right of the plaintiff being unquestionable—it seems to us that this was precisely the case in which the injunction, to the extent for which it was granted by the Vice-Chancellor, should have been unhesitatingly sustained.

In actions at law for the violation of the right of property in trade marks, where redress is sought in damages—what should be the measure of damages, or the rule by which the amount as adequate indemnity should be determined, in the event that the plaintiff's right is established, is open to discussion.

We are not aware of any case in which the question has arisen and been expressly determined.

In *Blofield* vs. *Payne*, 4 Barn. & Adol., 410, the court held, that wherever the plaintiff has a verdict, he is entitled to some damages, even in the absence of any proof of actual damage.

The order usually made by Courts of Chancery, that the defendant keep an account of the sales made by him, of the merchandise bearing the alleged simulated trade mark—to the end, that he pay over to the plaintiff the profits resulting from such sales—would seem to indicate a rule of damage.

But, in many—and indeed in most cases—such a rule would be an imperfect one—because the damage actually sustained, as the result of an infringement of a trade mark—(we mean, of course, where the loss of reputation does not enter into the account—by reason of the simulated article being of a spurious and inferior quality)—is rather, the loss of the profits which the plaintiff would have realized, by the sale of his merchandise, and which he has been prevented from making, by the fraudulent acts of the defendant, than the amount of the profits actually realized by the defendant.

It would, unquestionably, be more easy to ascertain the precise sum of the defendant's profits, than to determine that of which the plaintiff has been deprived.

The extent to which the defendant's wrongful acts has actually diminished the demand for, and the sale of, the plaintiff's productions, would, in most instances, be merely conjectural, and quite beyond the scope of positive proof.

But, wherever that extent can be ascertained by evidence—or wherever a reasonable approximation to it can be had—the plaintiff's indemnity would be better assured by the application of such a rule of damage.

The rule of Courts of Chancery, by which a fraudulent defendant is compelled to account for, and pay over to, the plaintiff, the profits which have resulted from his sales, is doubtless predicated upon the idea that such profits represent the gains which the plaintiff would have realized but for the defendant's wrongful acts. But in many, probably in most cases, such an idea would be exceedingly fallacious.

The civil remedies for the violation of property in trade marks, whether at law or in equity, afford but little protection to the public against the frauds

and impositions of those who dress their spurious goods in the guise and habiliments of the honest manufacturer, in order to pass them off upon the unsuspicious consumer.

The easily won profits that flow from such an appropriation of the reputation of another, present too powerful a temptation to the unscrupulous, to be overcome by the apprehended possibility of being stripped of their disguises, and compelled to relinquish their ill-gotten gains, as the consequence of a costly litigation.

Hence it is, and to mark with the strongest terms of reprobation, the turpitude of an act of invasion upon the trade marks of a manufacturer, that legislative enactments, like that of the State of New York, (R. S., part IV., title 6, chap. 1, sec. 49,) declare it to be a misdemeanor, punishable by fine and imprisonment, "to forge or counterfeit, or cause to be forged or counterfeited, any representation, likeness or similitude, copy or imitation of the private stamp, wrapper or label usually affixed by any mechanic or manufacturer on his goods, wares or merchandise, or in the sale thereof, with intent to deceive or defraud the purchaser, or manufacturer, of any goods, wares or merchandise whatever."

We do not remember to have seen a report of

any prosecution under this or any similar penal statute, but, the policy of such enactments, and the necessity of their rigid enforcement, in all proper cases, cannot fail to be fully acknowledged by all who have a just appreciation of the great importance to the public interests as well as to individual rights, of maintaining inviolate, that peculiar property which serves to designate and identify the goods, and wares, and merchandise of the artisan, the manufacturer, and the merchant, which minister to the constant necessities of all, and which furnish the sole assurance and guaranty of their genuineness, purity and integrity.

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