

In addition to the cases above mentioned, which cite and follow *Crosby's* and other similar cases, there are a few early ones which, though also in accord with the English doctrine, do not cite any of these cases, but seem to have been decided on general principles of law. Such is *State v. White*, Charlton 123 (1807), which was a commitment for contempt by an inferior court of record, and on habeas corpus in the Supreme Court, it held that the lower court had power to inflict punishment, at discretion, for all contempts of their authority; that the Supreme Court would not, therefore, discharge such persons, and especially it would not discharge nor admit to bail such persons, if officers of such courts. See, also, *Gist v. Bowman*, 2 Bay 182, in the Supreme Court of South Carolina. Recent decisions in Georgia and South Carolina, commented, *infra*, have modified the law in those states.

Ex parte Martin, 5 Yerger 456 (1830), was an appeal from a county court to the circuit court, and a writ of error on the judgment of the latter court, from the Supreme Court, which held that in a case of contempt no writ of error or appeal will lie, each court being its own exclusive judge of what is a contempt. The recent Code of Tennessee has changed this: *Sanders v. Metcalf*, 1 Tenn. Ch. 419; *State v. Woodfin*, 5 Ired. 199; *Ex parte Summers*, Id. 149.

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(To be continued.)

TRADE-MARKS.

THE recent decision of the Supreme Court of the United States in *In re United States v. Steffens*, delivered in last October Term 1879, has created an agitation which has ever since disturbed the public mind. That case has resolved that a trade-mark is not an invention or discovery, within the meaning of the clause of the constitution empowering Congress to secure to authors and inventors the exclusive right to their inventions and discoveries: *Leidersdorf v. Flint*, 18 Am. Law Reg. (N. S.) 37, and 7 Cent. Law Jour. 405. In *Duvel v. Bohmer*, at the April Term (1878) of the United States Circuit Court of the Southern District of Ohio, the directly

opposite view to that enunciated in *Leidersdorf v. Flint* was held. A further case in the Eastern District of Pennsylvania, viz., *Day et al. v. Walls*, 35 Legal Intelligencer 468, was dismissed upon demurrer for want of jurisdiction, the parties being all citizens of Pennsylvania; the opinion of DYER, J., in *Leidersdorf v. Flint*, being acted upon by CADWALADER, J.

It was therefore high time that the opinion of the United States Supreme Court should be taken; but notwithstanding the decision just rendered by that tribunal the question at issue remains practically unsettled.

It should be observed that all that the court was called upon to decide was as to the validity of the Registration Act of 1870, (sects. 4937-4947 R. S.), and its auxiliary of 1876 (an act to punish the counterfeiting of trade-marks), under which indictments had been found against two different parties, Emil Steffens and Adolph Witteman, in the United States Circuit Court of the Southern District of New York, and an information filed against W. W. Johnson and others in the United States Circuit Court of the Southern District of Ohio. In each court the judges disagreed, and hence the appeal to the Supreme Court of the United States.

An effort was made by the attorney-general to maintain the validity of the Registration Act, as being comprised within the clause of the constitution which authorizes Congress to "regulate commerce with foreign nations, and among the several states, and with the Indian tribes." But the United States Supreme Court has decided, hypothetically, it must be admitted, that *if* trade-marks are within congressional control *at all*, under the power to regulate commerce, the existing statutes for their protection are invalid because not limited in operation to the use of trade-marks in those classes of commerce over which Congress is given control, viz., commerce with foreign nations, among the several states, and with the Indian tribes.

This hypothesis is unfortunate, as it leaves the question at issue still in legal doubt.

Further, in the opinion delivered by the court it is said, that the Act of 1870 "is so framed that it is impossible to separate that which has reference to commerce within its control and that which has not; and as Congress certainly did not intend to pass the limited registration law which such a construction would imply, the whole

legislation must fall, as being void for want of constitutional authority."

From the scope of this decision it would appear that the Registration Act of 1870 is void for want of precise words defining its limitation, so as not to infringe the rights of the respective states, and, unfortunately, as a consequence it is void as an international as well as an inter-state piece of legislation.

It should be borne in mind that the Supreme Court, in rendering its decision on November 18th 1879, had to construe a penal act, that of August 14th 1876, which depended for its validity upon the Registration Act of July 8th 1870, and the rule that all penal acts must be construed strictly had to be applied. All that the court had to decide was the validity of these two acts conjunctively.

Even *if* Congress possessed the power contended for, it should have expressed it in a proper manner, and *if* these acts can only be valid as regulating commerce they must be limited, and should have been so expressed, to foreign and inter-state commerce, and commerce with the Indian tribes, and if not so limited in express words, they exceed the power of Congress as an interference with state rights.

The questions involved in the decision as to the property in trade-marks by merchants, manufacturers and traders (no matter of what nationality), and the legal protection to which they may be entitled in maintenance of their civil rights, are wholly irrespective of the right to institute criminal proceedings under the Registration Act in conjunction with the Act of 1876. The right to, and property in, a trade-mark attach at common law, and are not dependent on any statute or act of Congress, neither must they be confounded with the patent or copyright privileges which are creatures of statute and regulated by acts of Congress. "The power given to Congress," said DYER, J., in *Leidersdorf v. Flint*, "to promote the progress of science and useful arts is restricted to the rights of *authors* and *inventors*, and further, their rights are only to be secured for a *limited time*: *Livingston v. Van Ingen*, 9 Johns. 566. This limitation in time is imposed by the constitutional provision itself. But the right to a trade-mark is of common-law origin, and as a common-law right is limited only by the period of its use, and ceases only with its abandonment. Property in inventions and discoveries did not exist at common law, and for

their protection we have to look wholly to the constitutional provision on the subject."

Mr. Browne, in his treatise on trade-marks, says, quoting Story, "A copyright is limited by time; a trade-mark is not. A copyright is limited *territorially*; but a trade-mark acknowledges no boundaries. They are unlike in their natures."

"Property in a trade-mark," says Mr. Justice DYER, in the *Leidersdorf Case*, "exists independently of statute. It is otherwise with inventions and discoveries. They, as is said by the court in *Rodgers et al. v. Philip et al.*, 1 Off. Gaz. 31, are protected only in consequence of the constitutional provision on the subject, which does not apply to trade-marks."

"Among commercial nations," says Mr. Browne, in his work above quoted, "there is a growing tendency to universal recognition of the emblems of commerce known as trade marks:" sect. 302.

Even *if* trade-marks are under the constitutional control of Congress *at all*, the statutes involved in the Supreme Court decision cannot, according to that case, be supported to the extent of the use of trade-marks because their language is general in its operation; and Congress might have been unwilling to have passed laws only partial in their operation; and in such cases it is impossible to separate the constitutional and unconstitutional parts of the statutes. Every nation and every state has within its own peculiar jurisdiction an inherent power to deal civilly and criminally with any infraction of the rights of property, but as between state and state, nation and nation, or Indian tribes, the international element must be regulated either by congresses, conventions or declarations of nations, or, as far as relates to the United States alone, by the National Congress or Federal power within the limits of the constitution itself; and an act of Congress that is not specific in confining within such limits its enactments, which affects too general language in its operation, is naturally jealously regarded, and where it assumes the nature of penal legislation is, very properly, carefully scanned and strictly construed. But the invalidity of such carelessly contrived acts by no means impairs the rights, remedies and even penalties, whether at common law or imposed by state statutes, which protect the property of every individual, be he citizen or alien, from invasion, infringement or other interference.

"We find," says Mr. Upton, in his Treatise on the Law of Trade-marks, "that property in trade-marks, exclusive and absolute, has

existed and been recognised as a legal possession, which may be bought and sold, and transmitted, from the earliest days of our recorded jurisprudence:" Upton, p. 10.

It is said that the doctrine of exclusive property in trade-marks, has prevailed from the time of the Year Books, but however that may be, and it is somewhat doubtful, it has certainly been acknowledged from the time of James I.

In the power of acquiring and possessing this species of property there is no difference between citizens and aliens. In *Taylor v. Carpenter*, 3 Story's Rep. 458, and 7 Law Reporter 437; also *Taylor v. Carpenter*, 2 Woodbury & Minot 1, and 4 Barbour's Abstract of Chancellors' Decisions 68, and fully reported in 2 Saund. Ch. Rep. 603—the former case in the Circuit Court of the United States, in Massachusetts, before Justices STORY and WOODBURY, and the latter in the Court of Chancery in New York, and subsequently on appeal in the Court of Errors—the plaintiff was a subject of Great Britain, and the courts in these cases refused to recognise the doctrine that the protection claimed should be granted only to citizens. The case relied upon in the argument by the defendant's counsel was that of *Delronde et al. v. Shaw*, 2 Simons 237, where it was claimed that such protection to a foreigner, a citizen of the United States, had been denied by the English courts. But upon referring to that case it will be found that the denial was limited to the "copyright of a foreigner." Subsequent English cases have confirmed this view. In *The Collins Co. v. Brown*, 3 Kay & Johnson 423, upon the objection of alienage being made, it was 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. Whatever doubt or misconstruction may have been supposed to attach to the English decision in *Delronde v. Shaw* has long since been dispelled, and now under the enactment of sect. 2 of 33 & 34 Vict., c. 14, "real and personal property of every description may be taken, acquired, held and disposed of by an alien in the same manner in all respects as by a natural born British subject."

As Mr. Upton truly observes, "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. * * * 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. * * * The latter is a right of property, neither created nor controlled by any legislative enactment, but existing at *common law*, independent of all statute provisions, which (recognising 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 :” pp. 14 and 15.

The *patent* theory has led to much misconception, at least among the public laity, and confounded the new and original *design* for a manufacture, which, according to the Act of 1842, might have been patented, with the mere designation of the manufactured article. The mischief has arisen through granting patents for devices to be used as mere designations of merchandise, to be affixed either to the article itself, or to the package containing it. But it is obvious that no better or exclusive right to the use of such mark 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. “The right to a trade-mark is limited only by the period of its use, and ceases only with its abandonment :” per DYER, J., in *Leidersdorf v. Flint*. This right for an unlimited period has a positive advantage over a patent, which secures rights for only a *limited* period, but the privilege, formerly permitted, of affixing the word “patent” or “patented” to the article, in connection with which the right to a *design* has been secured, for the mere device or mark attached to it, the public being induced to believe that a patent exists for the thing itself, has been disallowed by the Registration Act, and very properly repudiated. The word *design*, mentioned in the Patent Act, was obviously intended to constitute a portion of the manufactured article—either as an ornamental adjunct or as controlling its figure or proportions—not as a mere name or designation by which to distinguish or identify the article: *In re Parker*. (Nov. 13th 1877), U. S. Pat. Off., Doolittle, Ass’t Com.; 13 U. S. Pat. Gaz. 323. *Held*, that a design not intended to be attached to an article as a distinguishing feature, but being

itself the article, application should have been made to patent it as a design, and the registration of it as a trade-mark was refused.

The registration of a trade-mark is the best evidence of the intention of the trader to adopt it as the designation of his goods, but it gives him no better right to its exclusive property than he possessed before registration. His common-law right, enforceable both in law and equity, may be further supplemented by any penal consequences that the statutes of respective states may enact, or, as in the English Registration Act, the registration itself may constitute *prima facie* evidence of his right to the exclusive use of such trade-mark, and shall, after the expiration of five years from the date of such registration, be *conclusive* evidence of his right to its exclusive use; or further, his common-law rights may be subordinated to statutory provisions, not of an *ex post facto* character, making registration indispensable, in the case of all trade-marks assumed or adopted subsequent to the passing of the act. All this is matter for state legislation, whether as between citizens of the same state or even aliens; but Congressional legislation is limited to inter-state commerce, foreign commerce and commerce with the Indian tribes, and *quære*, whether trade-marks are comprised within such definitions.

But even the American Registration Act (1870) did not assume to make registration obligatory, and therefore the decreed unconstitutionality of that act has not effected such confusion in that respect as might be expected. In *Rogers v. Philip*, decided in 1871 (WYLLIE, J.), it was held, *inter alia*, that the plaintiffs, English manufacturers, were not disentitled to protection, by reason of not having registered their trade-marks in America, under the U. S. Statute of 1870, since registration was not made obligatory: Columbia S. Ct., 1 U. S. Pat. Gaz. 29. At this time no registration act existed in England, neither had any declaration of reciprocity between the two countries been entered into. The plaintiffs were remitted to their common-law rights in America, as being identical with those in England. Indeed, no act of Congress can destroy those common-law rights, they being state rights and not national rights. Congress may, perhaps, supplement them and afford facilities for their exercise in the cause of foreign commerce, but can neither abridge nor supersede them. Mr. Bishop, in his work on Criminal Law, says, "It is an established doctrine of our courts that we have no national common law:" *Wheaton v. Peters*,

8 Pet. 591-658; *Lorman v. Clarke*, 2 McLean 568; *Dawson v. Shaver*, 1 Blackf. 204, 205. "There is no clause in the United States Constitution, nor any act of Congress adopting the common law as a national system:" Vol. 1, sect. 18. "We can have no national common law, unless one has been introduced either by the Constitution itself, or by acts of Congress made in pursuance of the same constitutional authority: Vol. 1, § 16. "In the language of MARSHALL, C. J.," says the same authority, "when a common-law right is asserted, we must look to the state in which the controversy originated:" *Wheaton v. Peters*, *supra*.

It is feared that the Declaration of Reciprocity, on the subject of trade-marks, between Great Britain and the United States, can never be such *in pari passu*, because Great Britain, being but one state and having but one legislature, enacts one act for the whole country, and can dispense with, modify or supersede the common law—Parliament being all powerful in that respect—whereas the United States has no power to legislate for the respective states, and, there being no national common law, the law of the respective states must prevail, and this law somewhat varies in the different states; for instance, in some of the older states, a few of the English statutes, passed subsequently to the settlement, were adopted, and thus made of force by general consent: *Com. v. Chapman*, 13 Met. 68; *Pemble v. Clifford*, 2 McCord 31; *State v. Rollins*, 8 N. H. 550; *Sibley v. Williams*, 3 Gill & J. 52. In the younger states such statutory modifications do not exist. In England, an alien's rights are protected (see *Collins & Co. v. Cowen*, 3 K. & J. 428), the same as in the United States: *Taylor v. Carpenter*, before referred to. The right to the exclusive use of a trade-mark, first asserted in England, in *Gout v. Aleplogln*, 5 Leg. Obs. 496, and *Millington v. Fox*, 3 Myl. & Cr. 338, and after much discussion, settled by the chancery judges, is now given by statute. The original statute (Act of 1875, sect. 1) made failure to register fatal, whether the use of trade-mark was old or new; but by the Act of 1876, where the mark was used before the original act, but not coming within the definition prescribed by the act, has been refused registration, the owner is, in default of registration and upon obtaining a certificate to that effect, only remitted to his rights as they stood before that act: per Sir R. MALINS, V.-C., *In re Barrows*, Law Rep., 5 Ch. Div. 353-59 (March 1st and April 26th 1877.)

Thus any state in the United States can vary or qualify its common law, but it is not within the power of Congress so to do. It appears to the writer (and he submits his opinion with great deference), that no act of Congress can supersede the common law on the subject of trade-marks, by making registration obligatory or subsidiary to the assertion of those rights, whether by citizen or alien, and he submits he is fortified in this view by the hypothetical form of the opinion delivered by the Supreme Court of the United States itself: "If trade-marks are within congressional control *at all*, under the power to regulate commerce," &c. (a question left undecided by the court).

Happily the right at common law seems to be universally admitted, at least as between Great Britain and the United States, and that common law is enforceable in the respective states themselves, without the necessity of any registration statute. Even in the most modern states, the common law prevails, and is in force in those territories which have been incorporated into states since the Union: *Stout v. Keyes*, 2 Doug. (Mich.) 184; *Fuller v. The State*, 1 Blackf. 63; *State v. Cawood*, 2 Stew. 360, 362. Even if there be an exception to this rule of the prevalence of the common law, as, perhaps, in the states obtained since the Union by purchase or conquest from foreign nations, the question still remains whether, in any case, trade-marks are within congressional control at all, under the constitutional power to "regulate commerce among the several states." The decision of the Supreme Court of the United States, declaring the unconstitutionality of the acts of Congress, virtually annuls the treaties, conventions and declarations between the United States and foreign nations, on this subject. Such existed between this country and Russia, Belgium, France, Austria, The German Empire and Great Britain; and this, at first sight, appears a most serious consequence and likely to entail most unhappy complications and possible individual injury. Being reciprocity treaties, the United States can no longer, in a national sense, fulfil her stipulated part, and cannot of course expect the foreign countries to fulfil theirs.

So far as Great Britain is concerned, the fear on either side is rather theoretical than practical. The treaty or declaration with that country, agreed upon so recently as 1877, is, after all, little more than an expression or enunciation of the law, which had long since been acknowledged by both countries, and which still

survives, irrespective of all treaties, in undiminished force. The words of the declaration are, that "Subjects or citizens of each of the contracting parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects and citizens, or as are now granted or may hereafter be granted to the subjects and citizens of the most favored nation, in everything relating to property in trade-marks and trade-labels." "It is understood, that any person who desires to obtain the aforesaid protection must fulfil the formalities required by the laws of the respective countries."

Bearing in mind the cases before cited, that aliens' rights were protected alike in England and the United States before the existence of the Registration Act in either country, and without the necessity of any treaty or declaration, but solely by force of the common law as acknowledged to exist in both countries, citizens of the United States will be but remitted to their original common-law rights in England, and subjects of Great Britain to their like rights in America, just as where the owners of a trade-mark in England, if his mark was used before the original Registration Act, is, in default of registration through no fault of his own, only remitted to his rights as they stood before the act (Per Sir R. MALINS, V. C., *In re Barrows*, Law Rep., 5 Ch. Div. 353-59, March 1st and April 26th 1877), so an owner who has no formalities to fulfil in his own country, and upon whom such formalities, even when they were enjoined, were not even then obligatory (*Rodgers v. Philips, supra*), is, in defect of any provided registration or formality, only remitted to his original common-law rights. This may be different in other countries, as for instance France, where prior to the revolution of 1789 no property in trade-marks existed at all by the common-law of that country, and everything since has been defined by code. The same want of common-law recognition of the rights of aliens in all probability prevails throughout continental Europe, but on this point we do not feel ourselves competent to express any opinion.

We will conclude with a few references having a general bearing on the nature of the property in trade-marks and the peculiar character of that property.

The following California decision appears to commend itself for its precision and perspicuity: "The right in a trade-mark is not limited in its enjoyment by territorial bounds, but may be asserted

and maintained wherever the common law affords remedies for wrongs, subject only to such statutory regulations as may properly be made concerning the use and enjoyment of other property:” Supreme Court, California, *Derringer v. Plate*, 29 Cal. 292; Coddington’s Digest of Trade-marks, sect. 18.

“The *fundamental* rule,” said Lord KINGSDOWN, “is that one man has no right to put off his goods as the goods of a rival trader, and he cannot, therefore, in the language of Lord LANGDALE in the case of *Perry v. Truefitt*, ‘be allowed to use names, marks, letters or other *indicia*, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person:’” *In re American Cloth Co.* And the same rule would apply to tradesmen not being manufacturers: (1865) V.-C. KINDERSLEY, *Glenny v. Smith*, 2 Dr. & Sm. 476; s. c. 11 Jurist N. S. 964; s. c. 13 L. T. R. (N. S.) 11; s. c. 6 New R. 363.

But yet the right to the use of a trade-mark is not an abstract right to which title can be acquired. It is only when such use is attached to or connected with some particular thing, to which it is affixed as a designation of individual right in particular property, that the law will interpose to restrain its use by another: (1869) Philadelphia Court of Common Pleas, *Ferguson v. Davol Mills*, 7 Phila. R. 253; s. c. 2 Brewst. 314, and see sects. 126, 127, 148, 149, 152; Coddington’s Dig. of Trade-marks, sect. 23.

“An action on the case for deceit, at common law, may be brought not only by the person who has been induced to purchase goods manufactured by one maker in the faith that they have been manufactured by another, but also by the maker of whose manufacture the goods in question have falsely been represented to be. “It seems at least probable,” says Mr. Sebastian, “that this principle was recognised as early as the reign of Queen Elizabeth. In *Southern v. Howe*, Cro. Car. 471; Poph. 144; 2 Rolle 28, a case was quoted by DODERIDGE, J., to that effect:” Sebastian on Trade-marks, p. 94.

But an action of this nature must be founded on false representations, made fraudulently, and originally arose out of the common-law right to bring an action for a false representation made fraudulently: Per MELLISH, L. J., in *Singer Manufacturing Co. v. Wilson*, Law Rep., 2 Ch. Div. 434-53. It differs from an ordinary action of that nature inasmuch as the common-law courts

extended the doctrine of false representation in the case of trade-marks by giving the original user of the trade-mark, or manufacturer whose mark was imitated, as well as the person or persons deceived, a right of action against the person thus assuming the mark; and indeed whether any one was deceived or not, it is sufficient that the counterfeiter was thus enabled to deceive others. "Such," adds MELLISH, L. J., "was the common-law right;" referring to *Sykes v. Sykes*, 3 B. & Cr. 541.

"The remedy," said Mr. Justice WILLES, "is well known. The prosecutor may file a bill in equity to restrain, or he may bring an action at law for damages, or he may indict the defendant for obtaining money under false pretences; *R. v. John Smith*, D. & B. 566; 8 Cox 32. But at common law the imitation is not a forgery. Per COCKBURN, C. J., *In re R. v. Closs*, D. & B. 460, 7 Cox 494. Also the same opinion was expressed *In re J. Smith, supra*, by POLLOCK, C. B., WILLES and BYLES, JJ. and BRAMWELL and CHANNELL, BB., in the Court of Crown Cases Reserved. Every facility is afforded, independent of statutes, for the protection of trade-marks. In the case of an alleged infringement of a true trade-mark, the plaintiff "has nothing more to do than to show that the trade-mark has been taken." Per Sir G. JESSEL, M. R., in the *Singer Manufacturing Co. v. Wilson*, Law Rep., 2 Ch. Div. 434-442; while in a case of false representation which does not amount to the infringement of a trade-mark proper; "there, as in every case of fraud, for it must be fraud, the case must be proved." S. C.

In the United States all former rights, both at law and in equity, are preserved by sect. 4945, tit. LX., Rev. Stat., c. 2, p. 963, and as we have seen, in England, they are by no means abridged by recent ruling of the court, and lest there should be any lingering doubt on the subject of the common-law right of aliens to protection, Rule 5 under the Trade-Mark Registration Act (1875) provides for the registration of his trade-mark by any person, whether a British subject or an alien.

Space will not allow us to cite the very many cases distinguishing the difference between trade-marks and copyrights or patents, but the cases, which are numerous, may be found collected and collated in Upton, Coddington and Sebastian on Trade-Marks. The latter author, referring to two English cases, *Maxwell v. Hogg*, Law Rep., 2 Ch. 307, and *Kelly v. Hutton*, Law Rep., 3 Ch. 708,