

Mr. PARKER. No; not in that case, because there would be a violation of the rights of the man who first used the mark in the United States.

Mr. BABKA. As far as the United States is concerned.

Mr. PARKER. If you apply a trade-mark to goods in the United States for the export trade, you are just as much infringing a man's rights acquired by user as though you apply it on sale in this country. There is no question about that.

The CHAIRMAN. This thing specifically limits the extension of the trade-mark law to any beneficiaries under the law of 1905, and I have a doubt in my mind as to whether we ought to give any special mark protection.

Mr. DAVIS. Assuming, for the sake of argument, that goods which have no protection in the United States, would it be a protection in foreign countries against other American manufacturers of similar or other articles?

Mr. PARKER. It might do that against other manufacturers of the same article who had previously commenced the use of a trade-mark.

The CHAIRMAN. We will resume the hearing to-morrow at 10 o'clock.

(Thereupon, at 11.45 o'clock p. m., the committee adjourned to meet again at 10 o'clock a. m., Thursday, January 22, 1920.)

COMMITTEE ON PATENTS,

HOUSE OF REPRESENTATIVES,

Washington, D. C., Thursday, January 22, 1920.

The committee met at 10.30 o'clock a. m., Hon. John C. McMillan (chairman) presiding.

The CHAIRMAN. Mr. Commissioner, we will be glad to hear from you on H. R. 7157, introduced by Mr. Merritt, an amendment to section 5 of the trade-mark act of February 20, 1905.

STATEMENT OF HON. JAMES T. NEWTON, COMMISSIONER OF PATENTS.

Mr. NEWTON. Mr. Chairman and gentlemen, I went over there last night, which was the first time I had seen it, and my objection was that it was rather revolutionary in this respect, that it required any use of the mark at all for registration. Our present trade-mark law is based on use. Otherwise, I am favorable to the bill and object of the bill and see no objection to it. Under the present trade-mark statute, we give a man who has had exclusive use of a mark for 10 years the right to register whether it is registered or not.

The CHAIRMAN. You do that now?

Mr. NEWTON. Yes, sir; that is in the 1905 statute and that is a step further and allows him to register the mark that he has used so long on things that he has not used; at least, it does not require that he has used the mark on. I think if the bill was amended so that these marks might be registered after the trade-mark was used on them there would be no objection at all to the bill.



The CHAIRMAN. What length of time would you specify that it had to be used in?

Mr. NEWTON. That is something that you might say you can put an arbitrary limit on. There is no reason why it should be two, three, or four years that I know of, and following the English statute that they have just passed, that specified two years' use of the mark where it is not registered otherwise, I suppose that would be about right, the object being to let the people of the country know that the mark was being used, so if they objected to it they could come in and ask the cancellation of it or oppose it, and it would take it probably two or three years before it might be known as such outside of its immediate territory. But I would not suggest any specific time. I do not see why the mark specified in this bill should not be registered as soon after the beginning of the use as possible because the mark itself is not the exclusive possession of the man that wants to register it, anyhow. As I understand it, this bill is intended to cover such cases as those where, for instance, the Winchester Co. has had the use of the word "Winchester" on guns for a number of years and they want to extend their goods to knives or something of that sort. We would not register Winchester now in the Patent Office because it is geographical, but this bill proposes that, since it has already been used and registered for 1905.

The CHAIRMAN. You say because it is geographical. How do you arrive at that?

Mr. NEWTON. Winchester is the name of a whole lot of places.

The CHAIRMAN. It is a family name also.

Mr. NEWTON. It might be objected to as a family name also. It might be both of these objections, so we would not register it at all on knives if the Winchester Co. had never used it on knives until recently. This bill proposes that this word be registered for the Winchester Co. because they have had use of it so long on a similar or another article of commerce, and I see no objection to that.

Mr. BABKA. You say you would not register it on knives.

Mr. NEWTON. No, sir.

Mr. BABKA. What good would this bill do?

Mr. NEWTON. This bill proposes that for all those marks that have been in use, that "any person or corporation shall have so registered a mark upon the ground of said use for ten years preceding February 20, 1905," etc.

I do not know why you should fix that date. I would say ten years from the date he applied for registration.

The CHAIRMAN. It confers upon beneficiaries of that law of February 20, 1905, due to the fact that they had been actively using a mark, certain benefits under this bill.

Mr. NEWTON. Yes.

The CHAIRMAN. I brought up that proposition yesterday, and it was one of the reasons we wanted you here to-day, to get your opinion on this bill. If there is going to be any general legislation amending trade-mark laws, and if we have any abuses in our present laws, it seems to me we ought to make it general rather than have it apply only in certain specific instances.

Mr. NEWTON. I am coming to that in a moment, Mr. Nolan. I have a bill that we worked on last night to submit to meet the committee's views on the fact that this bill only covered a certain class of people or a certain number of people, and you wanted the bill to be



more general in its character, and we have drawn up a bill to be general in its character as an amendment to the Pan-American that passed the House yesterday.

The CHAIRMAN. As an amendment to that bill?

Mr. NEWTON. Yes sir.

The CHAIRMAN. Your idea being to offer that in the S committee?

Mr. NEWTON. Yes. To come back to this bill, I think probably the gentlemen ought to understand just exactly what these people are driving at. Take the Du Pont Co. or the Winchester Co., one of those companies that have had their names in use for years, have gotten considerable reputation, when they go out into foreign business.

The CHAIRMAN. I do not think there is any doubt in the mind of the committee as to what they are aiming at. Mr. Seymour explained that, as well as other gentlemen yesterday. We know what the Du Pont people have been doing for several years, that they have plants at Hopewell and other places, and that they intend to go into certain definite lines. Their name, they figure, is a guarantee to the people in these new lines just as well as before in the old lines, and they want to be protected as well in the new lines as they have been in the old through their commercial name and their trade-mark. Is the purpose of this bill, is it not?

Mr. NEWTON. Not quite. That is what I am coming to. I want to get foreign registration.

The CHAIRMAN. I understand that, but they want this in general. They want this general protection.

Mr. NEWTON. This bill really does not give them any general protection. It simply puts their name on the register, and when that is done, that the foreign countries will register those marks and they will do it until we do. Registration, you must keep in mind, really does not help a man's trade-mark very much, if any.

Mr. MERRITT. In this country?

Mr. NEWTON. In this country. Our entire trade-mark law is based on use. A man has got to rely on his use and on that alone, whether it is registered or not. Of course, I do not mind saying at all that registration does not amount to anything.

Mr. BABKA. But it does amount to something when they apply in foreign countries.

Mr. NEWTON. That is the point.

Mr. BABKA. They must have it registered here before the foreign country will register.

Mr. NEWTON. That is all the good these gentlemen will get out of this bill.

Mr. BABKA. Take certain people manufacturing axes in this country who had been using the word "Winchester." Suppose under the new act, the Winchester Co. applies for a trade-mark and has it registered here. Will that not give the Winchester Co. an advantage over those people who have been using that name as applied to axes here for a number of years?

Mr. NEWTON. Undoubtedly.

Mr. BABKA. Do you think that is fair? Should not the people who have been using that trade mark in respect to the axes have an advantage in the foreign country? Why should the Winchester Co. be given this advantage?



Mr. NEWTON. There would be equities on both sides.

Mr. BABKA. It seems to me that if those people have been manufacturing axes and using that term, that it should apply to them, if anyone should have the advantage of the name, they are the people. They have built it up in respect to that commodity.

Mr. MERRITT. Answering the Congressman, I think there is a provision in the Nolan bill, that if it appears that somebody else on the particular article has properly been using a mark, there is a provision for taking off the register any mark illegally registered.

The CHAIRMAN. But that only applies to that trade mark convention.

Mr. MERRITT. That has to do with foreign marks.

The CHAIRMAN. That only applies to certain countries that are signatories to that convention.

Mr. JOHNSTON. Will you register more than one trade-mark of the same character to the same name?

Mr. NEWTON. You mean to put them all on the same register?

Mr. JOHNSTON. Yes.

Mr. NEWTON. That is another point that we discussed last night quite exceedingly. We propose to have two registers, one for marks that we would not put on the present register. You passed the Havana bill yesterday. We proposed to register all the marks that were sent from Havana irrespective of whether they were registerable or not under the present statute, but we propose to put these marks on a separate register.

Mr. JOHNSTON. What would be the value of putting them on a separate register?

Mr. NEWTON. Nothing except for the foreign registry.

Mr. JOHNSTON. Take this case that Mr. Babka referred to, this axe situation, a corporation or individual has been building up a business largely known and designated by the name of Winchester. Would this bill permit another company known as the Winchester Rifle Co., or whatever it is, to get exclusive control of that name?

Mr. NEWTON. No; it would not. This bill would allow him to register it provided nobody else laid claim to it. The present trade mark statute provides that if anybody else objects to registration of that name and has a better right to it than the man who proposes to register under this bill, he may oppose it and cancel that registration and then that would be a subject of litigation. The office and the courts would determine then who was entitled to that word "Winchester."

Mr. BABKA. How are these people notified that application has been made for registering a certain name?

Mr. NEWTON. They need not be notified. They would see it in the trade or if they came to the office to have their mark registered then they would be notified.

Mr. BABKA. That would be after it had already been registered.

Mr. NEWTON. Yes. There would be no harm done because we can take a name off the register just as easily as we put it on.

Mr. BABKA. But in the meantime, take the Winchester case, for instance, they might have that applied in a foreign country and get their registry there.

Mr. NEWTON. They might have if they slipped in without the other people knowing it. I do not believe you will find any way of keeping these names out.



The CHAIRMAN. The bill we passed yesterday in section 2 contains a provision that applied to the trade-mark convention:

That whenever any person shall deem himself injured by the inclusion of a mark on this register, he may at any time apply to the Commissioner of Patents to cancel the registration thereof, etc.

Mr. BABKA. That could cancel it also in a foreign country.

The CHAIRMAN. I presume if they had their registration taken off this list here in this country it would automatically deprive them of whatever rights they might get under the convention. They have some protection in the particular country in which they entered their trade-marks. Under their laws I doubt very much whether they would be entitled to the protection of that treaty.

Mr. NEWTON. I think your objection would be applicable to the registration. Take a mark that is registered under the present statute. If somebody else slips in here and registers it without the true owner of it knowing anything about it he can then go off and get his foreign registration and you can not hurt him with his present registration, but the true owner of the trade-mark can then come in and have the trade-mark here stricken from the register.

Mr. JOHNSTON. Your register now, in this Winchester in which that Mr. Babka cited, would contain the Winchester as applied to the Winchester Axe Co. and it probably contains Winchester applied to the Winchester Rifle Co. Is that true?

Mr. NEWTON. Yes, sir.

Mr. JOHNSTON. The Winchester Rifle Co. may come in and get the registration of its name, Winchester, because it intends to extend its business and not confine it only to the rifle business but to get into the axe business.

Mr. NEWTON. Yes, sir.

Mr. JOHNSTON. Do you not think that would work a very great hardship on the Winchester Axe Co.?

Mr. MERRITT. Not under the proposed bill.

Mr. NEWTON. I do not think so.

Mr. MERRITT. We proposed to meet that point in this way. We proposed to meet an objection which is fundamental and which the Committee has made, that this bill as drawn rather ripped up the fundamental principle of the trade mark that the trade mark must be used first in order to be registered at all. So we propose to put on the end of this provision that it shall be registered after such trade mark has been used on said articles in interstate or foreign commerce. You can put in one year or two years or any time you like about that, but of course, after it has been used one year or two years, if there was a thing as the Winchester Axe Co. they would naturally see that they would have a chance to object, and tell them to stop it.

Mr. JOHNSTON. They would then have to come in before the Commissioner of Patents and protest against this name being registered.

Mr. MERRITT. Yes.

The CHAIRMAN. Or if it had been registered they could come in and ask that it be stricken from the register.

Mr. JOHNSTON. That gives them a contest in subsequent litigation but does not give them a right.

Mr. MERRITT. Nobody has anything without a contest.

Mr. JOHNSTON. If they have any rights here, let us define them in the bill.

Mr. MERRITT. The only way of establishing a man's right is in court. If I owe you \$10 you can not get it out of me if I do not want to pay unless you sue me.

Mr. JOHNSTON. That is true but that is not an analagous case to this. We can provide for it here in this proposed bill by an amendment which will guarantee it to the original man.

Mr. MERRITT. He has got it now.

Mr. JOHNSTON. We can provide a value in this name that he will not be denied this right or have it taken from him just because another company is using a similar name or a similar trade-mark as applied to a different commodity. That, I think, might meet the situation.

Mr. NEWTON. I do not quite see how you could, Mr. Johnston. You would have to finally get to a place where it would be questionable who does own this mark, who has a real right to it.

Mr. JOHNSTON. Both of them might have an equal right to the trade name or trade-mark, but one could have it to apply exclusively to rifles and the other exclusively to axes, but now you are going to create a situation by this proposed bill so that this rifle company may also apply that name to axes as against the company which originally was in the ax business and has a trade value in that name.

Mr. NEWTON. But very frequently we find that two people have been using the same trade-mark on identically the same goods.

Mr. BABKA. I think if we amend the bill so as to make it compulsory that they use it for a certain definite time before they can register it that would do away with that objection.

The CHAIRMAN. The fact of the matter is that you touch there on the right of somebody else to come in and claim interference. I had a case up with the commissioner a short time ago—at least, I called it to his attention—where a man had made application for trade-mark out in my section and he employed a firm of attorneys in St. Louis to look after his interests. Somebody down in Boston in the shoe business figured that was a pretty good trade-mark. They did not have a leg to stand on, and, in fact, wanted to compromise after the thing was going, but that did not protect him. He had to employ an attorney in St. Louis to represent him and go through with this case. There is no way in which you can stop that.

Mr. NEWTON. You can not quite provide against contests, and the present statute provides for cancellation of these marks where registration was granted to one not the proper owner of them.

The CHAIRMAN. He got his trade-mark granted, but they held him up for months and tried to compromise with him to get the right to use that trade-mark in their territory.

Mr. CAMPBELL. You mentioned yesterday about the use of the word "Winchester" in axes, Mr. Seymour. Now, why do you think they used the name Winchester to borrow the reputation of the Winchester Arms Co. to give a standing for their products?

Mr. SEYMOUR. For no other reason. There is no company known as the Winchester Ax Co. There is a company, I think, located in Philadelphia, making a variety of goods, and I believe the name is Biddle, and they put out a line of axes. One of their axes they brand as the Winchester, and another as the Acme. The reason that



they brand that ax as Winchester is simply because they desire to graft on the prestige of the name Winchester.

Mr. BABKA. Of course, that would not be true in the case the chairman cited yesterday in respect to the harness manufacturer.

Mr. SEYMOUR. Certainly not; there can be no possible question.

The CHAIRMAN. That was a family name that was built up.

Mr. SEYMOUR. There can be no question of the right to the legitimate use of the name Winchester, either geographic or as a surname. I would not for a moment say that a man by the name of Winchester, engaged in the ax business or engaged in the rifle business, if anybody in this country wants to go into the rifle business and bears the name of Winchester he can go into that business and can call his rifles Winchester rifles with such additional descriptive matter as will provide for the notification of the public so that the two classes may be distinguished between. Now, as to this question of notice, an application for registration is filed in the Patent Office, and this application is printed in the back part of the Patent Office Gazette. Everybody throughout the country, all business men, all patent and trade-mark people, take the Patent Office Gazette. The first thing we do is to look and see what applications for trade-marks have been made. Our clients do the same thing, and if an application has been made for a trade-mark which is going to interfere with us or which we think the applicant is not entitled to, the question should be fought out by the machinery provided by the Patent Office. We file an opposition.

Our clients call on us on the telephone, "Look at page 521 of the last issue of the Gazette. Here is a man who wants to register black as a color for cartridges. How about that?" We made black cartridges a great many years ago and we have got lots of them still on our old exhibit cards. This happens to be an actual case. We file our opposition and the commissioner sets the machinery in motion and we take our testimony and we argue the case, but the public at large and everybody interested in the subject has already been advised by the publication which precedes actual registration. This is weekly notice to everybody in the United States who is at all interested in that subject. So on the score of notice everybody is informed. I am very glad that this question was asked because there is no Winchester Axe Co. and there is no desire at all to control the name Winchester for products allied to ours except where a person not entitled to the name wants to graft on our prestige by producing goods which would be sold in the same way with our goods, sold in the same line of shops and by the same people.

Mr. CAMPBELL. Could we not go further than that and insure the public when they buy an article which has a trade-mark of a reputable concern that they are getting that, and would it not be a protection to the public?

Mr. SEYMOUR. A great protection to the public.

Mr. CAMPBELL. That is what I think we should do here in addition to protecting the manufacturer or firm we ought to protect the public against substitution of an article not of the same quality, sold on the prestige of an established trade-mark.

Mr. SEYMOUR. Some concern, for instance, puts out a bicycle and calls that the Winchester bicycle, because the name Winchester has already been advertised so enormously all over the country and means so much to the general public on the score of quality. A man



can float a new article with an old name of great prestige very much easier than he can an article under an unknown name and the public are to that extent deceived. You saw in one of the books I gave you yesterday, if I brought it here, the name in the catalogue occurring on opposite pages. Here is a Winchester telescope sight which this dealer buys from the Winchester Co. That is the real thing. That is made by the Winchester Co. and stamped Winchester by the Winchester Co. and participates in the prestige of the Winchester Co.'s goods. On the opposite page is another article, a small rifle for use by boys. God knows who makes that other article but is it called a gun of the Winchester type. Now, the word Winchester is applied to the other article on the opposite side of the page which contains the true article, for no other earthly reason than to induce the purchaser to buy the article under the supposition that somehow or other it participates in the same quality.

We expect that the public will be protected by the provisions of a bill like this and we have no intention of squeezing out anybody who legitimately can use the word Winchester, not for a moment.

The CHAIRMAN. Mr. Commissioner, what substantial advantage is there to the people of the country in having a restriction such as we have at the present time on the issuance of a trade-mark of a commercial name? What protection do we afford the public, and after all, the public is the most interested party and they are the people we are seeking to protect by limiting the issuance of the trade-marks, so that they can not be issued where the name is descriptive of an article or where it is geographical. In other words, if an institution desires to go into the business of manufacturing something and their trade name is descriptive of it or they have a geographic name, if they are willing to invest their money and go along and build up a business, what is the reason, the fundamental reason, for imposing all these restrictions upon them? Why would it not be right for them to come in? Why do we want to limit it? The proposition of having use is probably all right; it is a question of time on that. But why do we throw these restrictions around it and have so much controversy over the trade-mark?

Mr. NEWTON. It is simply this. It is different for different words. Take Winchester, for example. The common-law status is that everybody in the town of Winchester or in the section of country known as Winchester has a right to say that their goods are made at Winchester. You can not keep them from saying that and ought not to keep them from saying it. That is the reason we refuse to register geographical terms. We could not allow a man to monopolize the word "Boston" for shoes.

The CHAIRMAN. That is all right for that point.

Mr. NEWTON. That is the geographic objection. As to the descriptive word, we say that everybody has a right to say what their goods are. For instance, the Du Ponts want to say that they have made black dyes. We can not let them monopolize the word "black" for dyes. We could not register the word "black" in dyes.

The CHAIRMAN. That is true.

Mr. NEWTON. It is for the protection of the trade in the use of ordinary English words, and we ought not to cut them off from it. Consequently we refuse to register descriptive words or geographic words, and in regard to a name the supposition was that anybody



named Smith would be allowed to do business under the name of Smith. We could not register the word Smith as a trade-mark and give exclusive use of it to any one Smith.

The CHAIRMAN. That is a family name, but take something that is descriptive of an article.

Mr. NEWTON. Take black for dyes. Suppose a man comes to me and wants to register the word black. We could not register the word black for dyes.

The CHAIRMAN. No.

Mr. NEWTON. We could not register any descriptive word for dyes; green, for example. We have a case in New York; appealed it up there to the court of appeals upon the word "infallible" for powder, which the Du Pont Co. has. We refused "infallible" for powder because it is descriptive. It means that your powder will always explode even though damp or off color.

The CHAIRMAN. That would be a case, I should say. Why should there be any limitation on that?

Mr. NEWTON. Because we say it is descriptive. Anybody else has a right to say their powder is infallible. Therefore we will not let them monopolize it by registering it. We can not keep them from it.

The CHAIRMAN. That is so.

Mr. NEWTON. But the 10 years provided under the present statute, supposing a man had use.

The CHAIRMAN. This is really the first hearing we have had for a long time on trade-marks to go into that question at all. That is one reason I would like to have the record show it.

Mr. NEWTON. The supposition of the legislature in passing the 1905 statute, giving us the right to register any word which is in use for 10 years, is sometimes these trade-marks get to have what is called secondary significance—that is, even though it is descriptive, even though it may be geographical, it is known so well in the country that everybody knows it as a mark of a certain man, and under that supposition we allowed them to register it under that 10-year clause of the statute. It has been in use so long that everybody knew who was the maker of it, and even though it could not be registered, even though it was descriptive or geographic we have registered it.

The CHAIRMAN. Have you quite a large registry of automobile names?

Mr. NEWTON. Oh, yes; a very large one. They are nearly all registered.

The CHAIRMAN. I notice there is an Oakland automobile. Has that ever been registered?

Mr. NEWTON. Yes, sir; Oakland is registered.

The CHAIRMAN. Still there are a lot of Oaklands in this country.

Mr. NEWTON. I know there are. We registered it on the ground that the word Oakland had reached a point where everybody knew the Oakland automobile, and it had a secondary meaning that was so much greater than the geographic meaning that it ought to be registered.

The CHAIRMAN. You have had to take into consideration the facts as to the name.

Mr. NEWTON. Yes.

Mr. MERRITT. That is under the 10-year clause.

The CHAIRMAN. I knew that.



Mr. NEWTON. It is quite true that some trade-marks after an extensive use get a secondary signification so much greater than the name of the little town that it happened to stand for. The court of appeals, however, has gone to the extreme in registering geographic terms. They have refused to register Orange Grove (?). There was only one of them in this country and that had two houses in it.

The CHAIRMAN. You say that you have something you have drawn up as an amendment to this bill.

Mr. NEWTON. Yes.

Mr. JOHNSON. What I had in mind was an instance such as this. The Aetna name is applied now to the Aetna Explosive Co. Assume that there is an Aetna dye company which has been in existence for 10 years or upwards. Recently there has become known an Aetna Explosive Co. Now, the Aetna Explosive Co. has determined no longer to manufacture explosives. It intends to use its plant and manufacturing establishments to go into the dye business. Now, if the original Aetna dye company is registered as a trade name, will you permit the Aetna Explosive Co. to use the word "Aetna" on dyes which it may make?

Mr. NEWTON. It was the successor of the other Aetna company, was it?

Mr. JOHNSON. It was not the successor of the original Aetna company but it is the Aetna Explosive Co. which no longer is going to make explosives.

Mr. NEWTON. The same organization?

Mr. JOHNSON. No, sir; a separate and distinct company.

Mr. NEWTON. No; I would not let them, in view of the adverse interests of the other party. The other party, in other words, could come in and oppose their registration and we would adjudge them to be the owner of the mark if they first used it. This does not give a man the right to register irrespective of whether anybody else has registered or not. This is only an amendment to the 1905 statute, which provides for settling all questions of controversy where the real right of the mark exists. This statute will only apply to those people who have no adverse rights, no superior adverse rights, but it will give us the right to register these words whereas now we can not register them, so that these people can get their marks registered.

I understood yesterday that your objection to this bill was that it was too restrictive—it was only applied to a very small class of people.

The CHAIRMAN. I wanted to get that other thing fixed in my mind. You say it would not in this case; about the case of the Aetna Powder Co.?

Mr. NEWTON. Let me understand the facts of Mr. Johnston's case.

Mr. JOHNSON. I will state it as briefly as I can. For a number of years past, upward of ten, there has been a dye manufacturing company known as the Aetna Dye Co., and its dyes have been stamped with the trade-mark Aetna, and recently or, at least, during the war period there has sprung up a large corporation known as the Aetna Explosive Co., which is a separate and distinctly entity from the Dye company, in fact, a new corporation. That company has gone into the hands of the receiver, as it develops, and receivers have been operating, and as there is no occasion for manufacturing explosives on the extensive scale that they have been doing during the war the



receivers are trying to conclude what is the best way of employing that plant. It is assumed they determined to go into the dye business. They have been using the word Aetna explosives for four or five years now. If they want to go into the dye business, can they register that word Aetna and stamp it on dyes?

Mr. NEWTON. Not at all, if the other company had previously used it on dyes.

The CHAIRMAN. What is there in this bill 7157 to prevent them from doing so?

Mr. NEWTON. This bill is only a part of the main trade-mark bill, which provides whenever there is a conflict——

The CHAIRMAN (interposing). I know; but this bill is an amendment to that.

Mr. NEWTON. It is an amendment to a part of that bill. It does not repeal the contest clause of that bill. It provides that wherever there is a contest between two parties as to who owns the mark, the office shall proceed to take testimony.

The CHAIRMAN. This is the latest word in legislation; it is hereby amended by adding the following words thereto:

And if any person or corporation shall have so registered a mark upon the ground of said use for 10 years preceding February 20, 1905, as to certain articles or classes of articles to which said mark shall have been applied for said period, and shall have thereafter and subsequently extended his business so as to include other articles not manufactured by said applicant for ten years next preceding February 20, 1905, nothing herein shall prevent the registration of said trade-mark in the additional classes to which said new and additional articles manufactured by said person or corporation shall apply.

Mr. NEWTON. That is rather broad. It probably ought to be explained by saying that unless there are adverse interests, it shall be settled in accordance with other articles in this bill.

The CHAIRMAN. That is the point.

Mr. MERRITT. I have here this section 5 to which this is an amendment, and the following provision covers the point under discussion:

Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers shall not be registered.

That is in the third paragraph.

Mr. NEWTON. I assume that that paragraph would apply to this amendment. It may be that it ought to be amended.

The CHAIRMAN. I have to again remind you of the fact that I am not a lawyer.

Mr. NEWTON. I am glad you brought that out. I think that ought to be understood. The way the law has been amended before in several of these statutes is to amend it so as to read as follows, and we could do that here in the same manner.

We have this condition as regards the proposed amendment that Mr. Parker and I went over last night and agreed on, that if this proposed bill be made a part of the present trade-mark bill, this proposition has nothing to do with it, because I proposed to put this in as an amendment to the Pan-American bill, and thus to bring out something that was discussed in this committee yesterday. I saw the typewritten copy of the discussion, and you asked, Mr.



Chairman, and, I believe, some of the other gentlemen discussed it, why should not we register these marks that are of doubtful validity and let them go on and get their foreign registration; put them on the register—put everything on the register that anybody wants to register without any examination—and, to tell you the truth, I do not know why that has not been done. It has been talked of for years in the office and among trade-mark people. There are a great many trade-marks that we will not register. Take some of the automobile trade-marks, perfectly good trade-marks, and the trade respects them, but we will not register them; for instance, the Detroit Electric. We would not register that, or the Cadillac, we would not register that. Detroit is a name of a town where all these things are made, and we say that anybody who makes an automobile in Detroit has a right to say he makes it in Detroit, and we can not give any man an exclusive right to use that. Still, the man ought to be able to get his foreign registrations, and for that reason I propose an amendment to the bill which was passed by the House yesterday, and I thought I would mention it to this committee.

The CHAIRMAN. Is it your purpose to draft an amendment to the bill that passed the House yesterday and offer it in the Senate or let it go on his bill here?

Mr. NEWTON. It would cover this bill to some extent, but in a general way.

The CHAIRMAN. Could it all be included?

Mr. NEWTON. There was some difficulty in including it all. It was not thought to include it all. The case that Mr. Merritt's bill proposes to cover is that of these long used names. That ought to go under the present trade-mark statute because they ought to be protected if there is any protection, because the present trade-mark law says that registration is prima facie evidence of ownership.

The CHAIRMAN. If you could make it general, applying throughout the world, instead of confining it to parties that signed that convention, why could you not include something that would bring them in?

Mr. NEWTON. This is a register that they make it from. It is an indication of ownership.

Mr. MERRITT. That only applies to South America.

Mr. NEWTON. The only reason they want this registration is to allow them to register abroad.

The CHAIRMAN. That bill that passed yesterday only applied to Central or South America, perhaps, and Cuba.

Mr. NEWTON. That is true, and they allowed the registration of any article.

The CHAIRMAN. As far as that convention was concerned, do you intend to amend that?

Mr. NEWTON. We propose an amendment to the trade-mark bill which passed yesterday to allow registration in this country whether it was registered abroad or not.

The CHAIRMAN. Covering the world?

Mr. NEWTON. So anybody could come in here and register any mark they wanted to.

The CHAIRMAN. If you are going to offer an amendment of that general character, why not include the provisions of this?

Mr. NEWTON. There is no reason why they should not have prima facie right to these marks and this bill does not give it to them.



The CHAIRMAN. Could you not put it on as an additional section?

Mr. NEWTON. No, sir; because the bill you passed yesterday would put these names on the register and not give them any prima facie evidence of ownership.

The CHAIRMAN. Of course, a new section could be attached to it in the Senate.

Mr. NEWTON. Yes. The amendment we propose is this:

All other marks not registerable under the act of February 20, 1905 (as amended), but which for not less than two years have been bona fide used in interstate or foreign commerce, or commerce with Indian tribes, by the proprietor thereof, upon or in connection with any goods of such proprietor and upon which the fee of \$10 has been paid and such formalities as are prescribed by the Commissioner of Patents have been complied with, may be registered.

Anything may be registered. That is an amendment to the bill that was passed yesterday. That bill does not give prima facie validity to the mark that is registered, the bill that passed yesterday, and this amendment does not give it. That is the reason we put this proposed amendment into the bill. But Mr. Merritt's bill wants to give them prima facie evidence of ownership, so we put that under the 1905 statute where it naturally belongs.

The CHAIRMAN. You probably do not get my idea. It seems to me an amendment similar to that could be attached to that particular measure, if you are going to make it of general character instead of confining it to signatories of the trade-mark convention.

Mr. NEWTON. The only reason we did that was that Mr. Merritt's bill wants prima facie protection which is already given in section 5 of the 1905 statute.

Mr. MERRITT. The chairman is now talking about a general amendment to my bill.

The CHAIRMAN. Figuring that we want to get action on these things with the legislative situation here. The Patents Committee may not be called for a long time again, and unless you are going to get it under suspension of the rules or by unanimous consent, this is likely to fall by the wayside. I am looking at the matter of expediency.

STATEMENT OF MR. F. S. BRIGHT, COLORADO BUILDING, WASHINGTON, D. C.

Mr. BRIGHT. I suggest this, that what you have just said is absolutely correct. It would be a very great service if this committee could report Mr. Merritt's bill and then permit those of us who are interested in it to take it to the Senate, as you have suggested. When the Senate committee begins the consideration of the bill that was passed yesterday, then ask the Senate committee to add to that bill as an additional section Mr. Merritt's bill. It would then carry the approval of this committee, if the committee sees fit to approve it, and then we will have a vehicle through which it can get through Congress. When the bill that passes the Senate with your amendment to it be sent over to the House, the only thing that is necessary is for the chairman of this committee to concur in the Senate amendment, because it has already the approval of this committee.



The CHAIRMAN. I just offered that as a suggestion, not that we would not proceed with the consideration of the bill upon its merits, inasmuch as you intend to offer something as an amendment to the Senate committee.

Mr. NEWTON. I thought it would be courtesy to this committee to tell them that I would ask the Senate committee to consider that.

The CHAIRMAN. What sort of an amendment would you suggest to this bill of Mr. Merritt's regarding the issue of time?

Mr. NEWTON. Mr. Merritt has written that in there, in accordance with my suggestion, at the end of his bill, as follows: "After said trade-mark has been used on said article in interstate or foreign commerce."

The CHAIRMAN. No time is specified?

Mr. MERRITT. I did not put in the time. The committee can put that in.

Mr. CAMPBELL. What would be your judgment on that, Mr. Commissioner, as to time?

Mr. NEWTON. It is thoroughly arbitrary. The English have put two years on their bill, and when we came to special privileges of our trade-mark bill we require 10 years.

Mr. CAMPBELL. That seems unusually long.

Mr. MERRITT. For foreign commerce the shorter the better. If you are going to shut out the pirates, do not give them too long. I should think in looking out for a trade-mark one year's notice would be proper.

Mr. NEWTON. I would say one year would be sufficient with the amount of notice we have given them now, published in the Gazette. They have notice of the fact that the things have gone into commerce. They would generally catch onto it within a year or two years, at the outside.

Mr. CAMPBELL. Was this thing submitted to you also, Mr. Merritt, to offer this as an amendment to the bill passed yesterday? Do you think it would work in that direction?

Mr. MERRITT. I think it would have to be adapted to that bill. The theory on which Mr. Bright spoke was if the committee saw fit to report this bill favorably, then we could go to the Senate and say this is a bill which has been reported.

(Thereupon, at 11.45 o'clock p. m., the committee adjourned.)

