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IN THE SENATE OF THE UNITED STATES.

JANUARY 8, 1904.

Mr. KITTREDGE introduced the following bill; which was read twice and referred to the Committee on Patents.

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**A BILL**

To revise the laws of the United States relating to trade-marks.

1 *Be it enacted by the Senate and House of Representa-*

2 *tives of the United States of America in Congress assembled,*

3 That any person claiming to be the owner of a trade-mark

4 used in commerce among the several States or in commerce

5 with foreign nations or with the Indian tribes, provided such

6 person is domiciled within the territory of the United States,

7 and any person claiming to be the owner of a trade-mark,

8 who is located in any foreign country which, by treaty, con-

9 vention, or law, affords similar privileges to citizens of the

10 United States, may, upon payment of the prescribed fees, and

11 otherwise complying with the requirements of this Act, ob-

12 tain registration therefor.

13 SEC. 2. That before any owner of a trade-mark shall be

14 entitled to registration thereof he shall make application there-

15 for in writing to the Commissioner of Patents and shall file



1 in the Patent Office a statement signed by him, specifying his  
2 name, domicile, and citizenship, and the location of his indus-  
3 trial or commercial establishment, the class of merchandise,  
4 and the particular description of goods comprised in such class  
5 to which the particular trade-mark has been appropriated; a  
6 description of the trade-mark itself, if considered necessary by  
7 the applicant or required by the Commissioner in the partic-  
8 ular case; a statement of the mode in which the trade-mark  
9 is applied to goods, and a statement of the length of time  
10 during which it has been used. With this statement shall be  
11 filed a facsimile drawing of the trade-mark, signed by the  
12 applicant or his attorney in fact, and such number of speci-  
13 mens of the trade-mark as actually used as may be required  
14 by the Commissioner of Patents.

15       SEC. 3. That the application required by section two of  
16 this Act, if made by an owner of a trade-mark domiciled  
17 within the territory of the United States, shall be accom-  
18 panied by a written declaration, verified by the applicant,  
19 that he believes himself to be the owner of the trade-mark  
20 sought to be registered, and that no other person, firm, cor-  
21 poration, or association has a right to use such trade-mark,  
22 either in the identical form or in any such near resem-  
23 blance thereto as might be calculated to deceive; that such  
24 trade-mark is used in commerce among the several States  
25 or in commerce with foreign nations, or with the Indian



1 tribes, and that the facsimile drawing and specimens, if any,  
2 truly represent the trade-mark sought to be registered. The  
3 application, if made by an owner of a trade-mark located  
4 in a foreign country, shall be accompanied by a written  
5 declaration, verified by the applicant, that he believes himself  
6 to be the owner of the trade-mark sought to be registered;  
7 that he has registered the same or has regularly filed an  
8 application for registration thereof in the foreign country  
9 in which he is located, of which registration or applica-  
10 tion, as the case may be, he shall state the date; that no  
11 other person, firm, corporation, or association has the  
12 right to use such trade-mark either in the identical form or in  
13 any such near resemblance thereto as might be calculated to  
14 deceive, and that the facsimile drawing and specimens, if any,  
15 truly represent the trade-mark sought to be registered.

16 In case the owner of the trade-mark is a firm, corpora-  
17 tion, association, State, or municipality, the declaration may be  
18 made by a member of the firm or an officer of the corpora-  
19 tion, association, State, or municipality.

20 The declaration required by this section may be made  
21 before any person within the United States authorized by law  
22 to administer oaths, or, when the applicant resides in a foreign  
23 country, before any minister, chargé d'affaires, consul, or com-  
24 mercial agent holding commission under the Government of  
25 the United States, or before any notary public, judge, or



1 magistrate having an official seal of the foreign country in  
2 which the applicant may be.

3       SEC. 4. That every applicant for the registration of a  
4 trade-mark not domiciled in the United States shall, before  
5 the issuance of the certificate of registration, designate, by a  
6 notice in writing filed in the Patent Office, some person re-  
7 siding within the United States on whom process or notice of  
8 proceedings affecting the right of ownership in the trade-  
9 mark of which they may claim to be the owner, brought  
10 under the provisions of this Act or under other laws of the  
11 United States, may be served with the same force and effect  
12 as if served upon the applicant or registrant in person.

13       SEC. 5. That no mark by which the goods of the per-  
14 son claiming to be the owner of the mark may be distin-  
15 guished from other goods of the same class shall be refused  
16 registration as a trade-mark on account of the nature of such  
17 mark, unless such mark

18       (a) Consists of or comprises immoral or scandalous  
19 matter;

20       (b) Consists of or comprises the flag or coat of arms or  
21 other insignia of the United States or any simulation thereof,  
22 or of any State or municipality, or of any foreign nation:  
23 *Provided*, That marks which are identical with a registered  
24 or known trade-mark owned and in use by another and appro-  
25 priate to the same class of merchandise, or which so  
26 nearly resemble a registered or known trade-mark owned and



1 in use by another, and appropriate to the same class of mer-  
2 chandise, as to be likely to cause confusion or mistake in the  
3 mind of the public, or to deceive purchasers, shall not be  
4 registered: *And provided*, That marks which consist merely  
5 in the name of an individual, firm, corporation, or association,  
6 not written, printed, impressed or woven in some particular  
7 or distinctive manner, or which consist merely in words or  
8 devices which are descriptive of the goods with which they  
9 are used, or of the character or quality of such goods, or  
10 which consist of the name of a locality, shall not be registered  
11 unless the applicant for registration states in his application  
12 that he makes no claim to the exclusive use of such mark  
13 as against others who may use the same without fraudulent  
14 or deceptive intent.

15       SEC. 6. That any application for registration of a trade-  
16 mark filed in this country by any person who has previously  
17 regularly filed in any foreign country, which by treaty, con-  
18 vention, or law affords similar privileges to citizens of the  
19 United States, an application for registration of the same trade-  
20 mark shall be accorded the same force and effect as would be  
21 accorded to the same application if filed in this country on the  
22 date on which application for registration of the same trade-  
23 mark was first filed in such foreign country: *Provided*, That  
24 such application is filed in this country within four months



1 from the date on which the application was first filed in such  
2 foreign country.

3       SEC. 7. That on the filing of any application for regis-  
4 tration of a trade-mark which complies with the requirements  
5 of sections two and three of this Act, and the payment of  
6 the fees required by this Act, the Commissioner of Patents  
7 shall cause an examination thereof to be made; and if on  
8 such examination it shall appear that the applicant is entitled  
9 to registration under the provisions of this Act, the Commis-  
10 sioner shall issue a certificate of registration therefor.

11       SEC. 8. That whenever on examination an application  
12 for registration of a trade-mark is refused, the Commissioner  
13 shall notify the applicant thereof, giving him briefly the rea-  
14 sons for such refusal, together with such information and  
15 references as may be useful in judging of the propriety of  
16 persisting in, modifying, or abandoning his application; and  
17 if after receiving such notice the applicant persists in his  
18 claim of right to registration, either with or without modify-  
19 ing his application, his application shall be reexamined.

20       SEC. 9. That upon failure of the applicant to complete his  
21 application for registration within one year after the filing of  
22 any part thereof, or upon his failure to prosecute his applica-  
23 tion within one year after any action therein, of which notice  
24 shall have been given to the applicant, such application shall  
25 be regarded as abandoned, unless it be shown to the satisfac-



1 tion of the Commissioner that such delay was unavoidable  
2 but the abandonment of such application shall not be construed  
3 to be an abandonment of any right to the trade-mark for the  
4 registration of which such application was made.

5       SEC. 10. That whenever application is made for the  
6 registration of a trade-mark which is substantially identical  
7 with a trade-mark appropriated to the same class of goods  
8 for which a certificate of registration has been previously  
9 issued to another and is still in force, or for registration of  
10 which another has previously made application, or which so  
11 nearly resembles such trade-mark as, in the opinion of the  
12 Commissioner, to be likely to be mistaken therefor by the  
13 public, and the applicant shall show to the satisfaction of the  
14 Commissioner that he used the trade-mark of his applica-  
15 tion prior to the date of filing of the application on which  
16 such previous registration was granted, or the date of filing  
17 of such prior application, as the case may be, or shall show to  
18 the satisfaction of the Commissioner that the registrant or prior  
19 applicant has abandoned the use of such trade-mark, the Com-  
20 missioner shall suspend such latter application and give notice  
21 thereof to the registrant or prior applicant, as the case may be.  
22 If within such time, not less than thirty days from such notice, as  
23 the Commissioner shall prescribe, the registrant or prior appli-  
24 cant files in the Patent Office notice of opposition to the grant  
25 of such application, stating the reasons thereof, the Commis-

1 sioner shall declare that an interference exists as to such  
2 trade-mark and shall direct the examiner in charge of inter-  
3 ferences to determine the question of ownership of such trade-  
4 mark. And the Commissioner may issue a certificate of  
5 registration to the party who is adjudged to be the owner of  
6 the trade-mark, unless the adverse party appeals from the  
7 decision of the examiner in charge of interferences within  
8 such time, not less than twenty days, as the Commissioner  
9 shall prescribe. If the registrant or prior applicant, after due  
10 notice, shall fail to file notice of opposition within thirty days,  
11 the Commissioner may issue a certificate of registration to  
12 the later applicant.

13       SEC. 11. That every applicant for the registration of a  
14 trade-mark, or for the renewal of the registration of a trade-  
15 mark, whose application has been twice refused, and every  
16 party to an interference as to a trade-mark, may appeal from  
17 the decision of the examiner in charge of trade-marks, or of  
18 the examiner in charge of interferences, as the case may be,  
19 to the Commissioner in person, having once paid the fee for  
20 such appeal.

21       SEC. 12. That if an applicant for registration of a trade-  
22 mark or such party to an interference as to a trade-mark is  
23 dissatisfied with the decision of the Commissioner of Patents,  
24 he may appeal to the court of appeals of the District of  
25 Columbia on complying with the conditions required in case



1 of an appeal from the decision of the Commissioner by an  
2 applicant for patent or a party to an interference as to an  
3 invention.

4       SEC. 13. That the Commissioner of Patents is authorized  
5 to record in the Patent Office the transfer of the property  
6 right in any registered trade-mark or in any trade-mark for  
7 which application for registration has been made. But no  
8 such transfer of a trade-mark shall be recorded unless it shall  
9 appear that such transfer was made with or as a part of a  
10 transfer of the good will of the business in which such trade-  
11 mark is used. Any transfer of the good will of the business  
12 in which a particular trade-mark is used shall be deemed a  
13 transfer of such trade-mark and shall be so recorded unless  
14 the parties thereto expressly stipulate to the contrary.

15       SEC. 14. That certificates of registration of trade-  
16 marks shall be issued in the name of the United States of  
17 America under the seal of the Patent Office, and shall  
18 be signed by the Commissioner of Patents, and a record  
19 thereof, together with printed copies of the drawing, state-  
20 ment of the applicant, and description, if any, shall be kept  
21 in books for that purpose. The certificate shall state the  
22 date on which the application for registration was deposited  
23 in the Patent Office. Certificates of registration of trade-  
24 marks may be issued to the assignee of the appli-



1 cant, but the assignment must first be entered of record in  
2 the Patent Office. Written or printed copies of any records,  
3 books, papers, or drawings relating to trade-marks, belong-  
4 ing to the Patent Office, and of certificates of registration,  
5 authenticated by the seal of the Patent Office and certified by  
6 the Commissioner or Acting Commissioner thereof, shall be  
7 evidence in all cases wherein the originals should be evidence,  
8 and any person making application therefor and paying the  
9 fee required by law shall have certified copies thereof.

10 SEC. 15. That a certificate of registration shall remain  
11 in force for ten years, except that in the case of trade-marks  
12 previously registered in a foreign country such certificates  
13 shall cease to be in force on the date on which the trade-  
14 mark ceases to be protected in such foreign country, and  
15 shall in no case remain in force more than ten years unless  
16 renewed. Certificates of registration may be from time to  
17 time renewed for like periods on payment of the renewal  
18 fees required by this Act upon request by the registrant,  
19 his legal representatives, or transferees of record in the  
20 Patent Office, provided such request is made prior to the  
21 expiration of the term for which the certificates of regis-  
22 tration were issued or renewed. Certificates of registration  
23 in force at the date at which this Act takes effect shall re-  
24 main in force for the term for which they were issued, but  
25 shall be renewable on the same conditions and for the same



1 periods as certificates issued under the provisions of this Act,  
2 and when so renewed shall have the same force and effect as  
3 certificates issued under this Act.

4       SEC. 16. That the following shall be the rates for trade-  
5 mark fees:

6       On filing each original application for registration of a  
7 trade-mark, ten dollars.

8       On filing each application for renewal of registration of a  
9 trade-mark, five dollars.

10       On an appeal for the first time from the examiner in  
11 charge of trade-marks to the Commissioner of Patents, ten  
12 dollars.

13       On an appeal for the first time from the decision of the  
14 examiner in charge of interferences, awarding ownership of a  
15 trade-mark, to the Commissioner of Patents, fifteen dollars.

16       For filed and uncertified copies of certificates of regis-  
17 tration and other papers, and for recording transfers and other  
18 papers, the same fees as required by law for such copies of  
19 patents and for recording assignments and other papers relat-  
20 ing to patents.

21       SEC. 17. That sections forty-nine hundred and thirty-  
22 five and forty-nine hundred and thirty-six, relating to the pay-  
23 ment of patent fees and to the repayment of fees paid by  
24 mistake, are hereby made applicable to trade-mark fees.

25       SEC. 18. That the Commissioner of Patents may from



1 time to time establish regulations not inconsistent with law  
2 for the conduct of proceedings in reference to the registration  
3 of trade-marks provided for by this Act.

4       SEC. 19. That registration of a trade-mark shall be  
5 legal notice of claim of ownership therein by the registrant.  
6 Any person who shall reproduce, counterfeit, copy, or color-  
7 ably imitate any trade-mark registered under this Act and  
8 affix the same to merchandise of substantially the same  
9 descriptive properties as those described in the registra-  
10 tion, or shall sell or expose for sale, or have in possession  
11 for purposes of sale, merchandise of substantially the same  
12 descriptive properties as those described in the registration  
13 bearing, without authority from the owner thereof, a repro-  
14 duction, counterfeit, copy, or colorable imitation of any such  
15 trade-mark, shall be liable to an action on the case for damages  
16 for the wrongful use of said trade-mark at the suit of the  
17 owner thereof; and whenever in any such action a verdict is  
18 rendered for the plaintiff the court may enter judgment  
19 thereon for any sum above the amount found by the verdict  
20 as the actual damages sustained, according to the circum-  
21 stances of the case, not exceeding three times the amount of  
22 such verdict, together with the costs.

23       SEC. 20. That the circuit courts of the United States  
24 shall have original jurisdiction, and the circuit courts of ap-  
25 peal of the United States, the court of appeals of the Dis-



1    trict of Columbia, and the Supreme Court shall have appel-  
2    late jurisdiction of all suits at law or in equity respecting  
3    trade-marks registered in accordance with the provisions  
4    of this Act, arising under the present Act, or under any  
5    laws of the United States in reference to trade-marks, with-  
6    out regard to the amount in controversy, except that such  
7    courts shall not have jurisdiction of such suits between citi-  
8    zens of the same State, unless it appears that the defendant  
9    uses the registered trade-mark involved in the suit on mer-  
10   chandise intended to be transported to another State or  
11   beyond the boundaries of the State of which the parties are  
12   citizens.

13        SEC. 21. That the several courts vested with jurisdiction  
14   of cases arising under the present Act, or under any laws of  
15   the United States in reference to trade-marks, shall have  
16   power to grant injunctions according to the course and prin-  
17   ciples of equity to prevent the violation of any right of the  
18   owner of a trade-mark registered under this Act on such  
19   terms as the court may deem reasonable; and upon a decree  
20   being rendered in any such case for wrongful use of a trade-  
21   mark the complainant shall be entitled to recover, in addi-  
22   tion to the profits to be accounted for by the defendant, the  
23   damages the complainant has sustained thereby, and the  
24   court shall assess the same or cause the same to be assessed  
25   under its direction; and the court shall have the same



1 power to increase such damages, in its discretion, as is given  
2 to increase the damages found by verdicts in actions in the  
3 nature of actions of trespass upon the case.

4       SEC. 22. That in any case involving the right to a trade-  
5 mark registered in accordance with the provisions of this Act,  
6 in which a verdict has been found for the plaintiff or an  
7 injunction issued, the court may order that all labels,  
8 prints, packages, wrappers, or receptacles in the possession  
9 of the defendant bearing the trade-mark of the plaintiff or  
10 complainant, or any reproduction, counterfeit, or colorable  
11 imitation thereof, shall be delivered up and destroyed. Any  
12 injunction that may be granted upon hearing, after notice to  
13 the defendant, to prevent the violation of any right to the  
14 owner of a trade-mark registered in accordance with the pro-  
15 visions of this Act, by any circuit court of the United States  
16 or by a judge thereof, may be served on the parties against  
17 whom such injunction may be granted anywhere in the United  
18 States, and shall be operative and may be enforced, by pro-  
19 ceedings to punish for contempt or otherwise, by the circuit  
20 court by which such injunction was granted or by any other  
21 circuit court or judge thereof in the United States. The cir-  
22 cuit courts or judges thereof shall have jurisdiction to enforce  
23 said injunction, as herein provided, as fully as if the injunction  
24 had been granted in the circuit in which it is sought to be  
25 enforced.



1           The clerk of the court or judge granting the injunction  
2 shall, when required to do so by the court before which appli-  
3 cation to enforce said injunction is made, transmit, without  
4 delay, to said court a certified copy of all the papers on which  
5 the said injunction was granted that are on file in his office.

6           SEC. 23. That no action or suit shall be maintained under  
7 the provisions of this Act in any case when the trade-mark is  
8 used in any unlawful business or upon any article injurious in  
9 itself, or which mark has been used with the design of deceiv-  
10 ing the public in the purchase of merchandise, or under any  
11 certificate of registration fraudulently obtained.

12           SEC. 24. That nothing in this Act shall prevent, lessen,  
13 impeach, or avoid any remedy at law or in equity which any  
14 party aggrieved by any wrongful use of any trade or other  
15 mark, commercial name, or indication of locality of origin  
16 might have had if the provisions of this Act had not been  
17 passed.

18           SEC. 25. That nothing contained in this Act shall pre-  
19 vent the registration as a trade-mark of any word or words,  
20 letter, figure, or combination of letters or figures used as a  
21 trade-mark in commerce among the several States or in com-  
22 merce with foreign nations or with the Indian tribes before  
23 the third day of March, eighteen hundred and eighty-one,  
24 and which has distinguished the goods of the applicant or his  
25 predecessor in business.



1        SEC. 26. That no article of imported merchandise which  
2 shall copy or simulate the name of any domestic manufacture  
3 or manufacturer or trader, or of any manufacturer or trader  
4 located in any foreign country which by treaty, convention,  
5 or law affords similar privileges to citizens of the United  
6 States, or which shall copy or simulate a trade-mark  
7 registered in accordance with the provisions of this Act  
8 or shall bear a name or mark calculated to induce the  
9 public to believe that the article is manufactured in the  
10 United States, or that it is manufactured in any foreign  
11 country or locality other than the country in which it is in  
12 fact manufactured, shall be admitted to entry at any custom-  
13 house of the United States. And, in order to aid the officers  
14 of the customs in enforcing this prohibition, any domestic  
15 manufacturer or trader, and any foreign manufacturer or  
16 trader who is entitled under the provisions of a treaty, con-  
17 vention, declaration, or agreement between the United States  
18 and any foreign country to the advantages accorded by law  
19 to citizens of the United States in respect to trade or  
20 commercial marks and commercial names, may require his  
21 name and residence and name or mark of the locality  
22 in which his goods are manufactured, and a copy of the  
23 certificate of registration of his trade-mark issued in accord-  
24 ance with the provisions of this Act, to be recorded in books  
25 which shall be kept for this purpose in the Department of





1 the Treasury, under such regulations as the Secretary of the  
2 Treasury shall prescribe, and may furnish to the Department  
3 facsimiles of his name, the name or mark of the locality in  
4 which his goods are manufactured, or of his registered trade-  
5 mark; and thereupon the Secretary of the Treasury shall  
6 cause one or more copies of the same to be transmitted to  
7 each collector or other proper officer of the customs.

8       SEC. 27. That for the purposes of this Act the United  
9 States shall be held to include and embrace all territory which  
10 is under the jurisdiction and control of the United States;  
11 and the word "States" as used in this Act shall be held and  
12 construed to include and embrace the District of Columbia,  
13 the Territories of the United States, and such other territory  
14 as shall be under the jurisdiction and control of the United  
15 States.

16       SEC. 28. That this Act shall take effect upon its passage.  
17 All Acts and parts of Acts inconsistent with this Act are  
18 hereby repealed, except so far as the same may apply to cer-  
19 tificates of registration issued or applied for under the Act of  
20 Congress approved March third, eighteen hundred and eighty-  
21 one, entitled "An Act to authorize the registration of trade-  
22 marks and protect the same," or under the Act approved  
23 August fifth, eighteen hundred and eighty-two, entitled "An  
24 Act relating to the registration of trade-marks."



58<sup>TH</sup> CONGRESS, }  
2<sup>D</sup> SESSION.

**S. 3219.**

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By **Mr. KITTRIDGE.**

JANUARY 8, 1904.—Read twice and referred to the Com-  
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