

H. R. 15803.

IN THE HOUSE OF REPRESENTATIVES.

DECEMBER 6, 1904.

Mr. BONYNGE introduced the following bill; which was referred to the Committee on Patents and ordered to be printed.

A BILL

To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by causing to be recorded in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship;



1 the class of merchandise and the particular description of
2 goods comprised in such class to which the mark is appro-
3 priated; a description of the trade-mark itself, and a state-
4 ment of the mode in which the same is applied and affixed
5 to goods, and the length of time during which the trade-
6 mark has been used. With this statement shall be filed a
7 drawing of the trade-mark, signed by the applicant, or his
8 attorney, and such number of specimens of the trade-mark,
9 as actually used, as may be required by the Commissioner of
10 Patents. Second, by paying into the Treasury of the United
11 States the sum of ten dollars, and otherwise complying with
12 the requirements of this Act and such regulations as may be
13 prescribed by the Commissioner of Patents.

14 SEC. 2. That the application prescribed in the foregoing
15 section, in order to create any right whatever in favor of the
16 party filing it, must be accompanied by a written declaration
17 verified by the applicant, or by a member of the firm or an
18 officer of the corporation applying, to the effect that the
19 applicant believes himself or the firm or corporation in whose
20 behalf he makes the application to be the owner of the trade-
21 mark sought to be registered, and that no other person, firm,
22 or corporation, to the best of the applicant's knowledge and
23 belief, has the right to such use, either in the identical form
24 or in such near resemblance thereto as might be calculated to
25 deceive; that such trade-mark is used in commerce between



1 the several States, or with foreign nations, or with Indian
2 tribes, and that the description and facsimile presented fully
3 represent the trade-mark sought to be registered. If the
4 applicant be located in a foreign country, the statement
5 required shall, in addition to the foregoing, set forth that the
6 trade-mark has been registered by the applicant, or that an
7 application for the registration thereof has been filed by him
8 in the foreign country in which he is located, and shall give
9 the date of such registration, or the application therefor, as
10 the case may be. The verification required by this section
11 may be made before any person within the United States
12 authorized by law to administer oaths, or, when the applicant
13 resides in a foreign country, before any minister, chargé
14 d'affaires, consul, or commercial agent holding commission
15 under the Government of the United States, or before any
16 notary public, judge, or magistrate having an official seal of
17 the foreign country in which the applicant may be.

18 SEC. 3. That every applicant for registration of a trade-
19 mark, or for renewal of registration of a trade-mark, who is
20 not domiciled within the United States, shall, before the issu-
21 ance of the certificate of registration, as hereinafter provided
22 for, designate, by a notice in writing, filed in the Patent Office,
23 some person residing within the United States on whom proc-
24 ess or notice of proceedings affecting the right of ownership
25 of the trade-mark of which such person may claim to be the

1 owner, brought under the provisions of this Act or under
2 other laws of the United States, may be served, with the
3 same force and effect as if served upon the applicant or reg-
4 istrant in person. For the purposes of this Act it shall be
5 deemed sufficient to serve such notice upon such applicant or
6 registrant by leaving a copy of such process or notice
7 addressed to him at the last address of which the Commis-
8 sioner of Patents has been notified.

9 SEC. 4. That an application for registration of a trade-
10 mark filed in this country by any person who has previously
11 regularly filed in any foreign country which, by treaty, con-
12 vention, or law, affords similar privileges to citizens of the
13 United States an application for registration of the same
14 trade-mark shall be accorded the same force and effect as
15 would be accorded to the same application if filed in this
16 country on the date on which application for registration of
17 the same trade-mark was first filed in such foreign country:
18 *Provided*, That such application is filed in this country
19 within four months from the date on which the application
20 was first filed in such foreign country: *And provided*, That
21 certificate of registration shall not be issued for any mark for
22 registration of which application has been filed by an appli-
23 cant located in a foreign country until such mark has been
24 actually registered by the applicant in the country in which
25 he is located.



1 SEC. 5. That no mark by which the goods of the per-
2 son claiming to be the owner of the mark may be distin-
3 guished from other goods of the same class shall be refused
4 registration as a trade-mark on account of the nature of such
5 mark unless such mark—

6 (a) Consists of or comprises immoral or scandalous
7 matter;

8 (b) Consists of or comprises the flag or coat of arms, or
9 other insignia of the United States, or any simulation thereof,
10 or of any State or municipality, or of any foreign nation:
11 *Provided*, That trade-marks which are identical with a reg-
12 istered or known trade-mark owned and in use by another,
13 and appropriated to the same class of merchandise, or which
14 so nearly resemble a registered or known trade-mark owned
15 and in use by another, and appropriated to the same class of
16 merchandise as to be likely to cause confusion or mistake in
17 the mind of the public, or to deceive purchasers, shall not be
18 registered: *Provided*, That no mark which consists merely
19 in the name of an individual, firm, corporation, or association,
20 not written, printed, impressed, or woven in some particular
21 or distinctive manner, or merely in words or devices which
22 are descriptive of the goods with which they are used, or of
23 the character or quality of such goods, or merely a geograph-
24 ical name or term, shall be registered under the terms of this
25 Act.

1 SEC. 6. That on the filing of an application for regis-
2 tration of a trade-mark which complies with the requirements
3 of this Act, and the payment of the fees herein provided for,
4 the Commissioner of Patents shall cause an examination
5 thereof to be made; and if on such examination it shall
6 appear that the applicant is entitled to have his trade-mark
7 registered under the provisions of this Act, the Commissioner
8 shall cause the mark to be published at least once in the
9 Official Gazette of the Patent Office. Any person who
10 believes he would be damaged by the registration of a mark
11 may oppose the same by filing notice of opposition, stating
12 the grounds therefor in the Patent Office within thirty days
13 after the publication of the mark sought to be registered,
14 which said notice of opposition shall be verified by the per-
15 son filing the same before one of the officers mentioned in
16 section two of this Act. If no notice of opposition is filed
17 within said time the Commissioner shall issue a certificate of
18 registration therefor, as hereinafter provided for. If on ex-
19 amination an application is refused the Commissioner shall
20 notify the applicant, giving him his reasons therefor.

21 SEC. 7. That in all cases where notice of opposition has
22 been filed, the Commissioner of Patents shall notify the ap-
23 plicant thereof and the grounds therefor.

24 Whenever application is made for the registration of a
25 trade-mark which is substantially identical with a trade-mark



1 appropriated to goods of the same descriptive properties, for
2 which a certificate of registration has been previously issued
3 to another, or for registration of which another has previously
4 made application, or which so nearly resembles such trade-
5 mark, or a known trade-mark owned and used by another,
6 as, in the opinion of the Commissioner, to be likely to be
7 mistaken therefor by the public, he shall declare that an inter-
8 ference exists as to such trade-mark, and in every case of
9 interference or opposition to registration he shall direct the
10 examiner in charge of interferences to determine the question
11 of the right of registration to such trade-mark, and of the
12 sufficiency of objections to registration, in such manner and
13 upon such notice to those interested as the Commissioner may
14 by rules prescribe.

15 The Commissioner may refuse to register the mark
16 against the registration of which objection is filed, or may re-
17 fuse to register both of two interfering marks, or may register
18 the mark, as a trade-mark, for the person first to adopt and
19 use the mark, if otherwise entitled to register the same, un-
20 less an appeal is taken, as hereinafter provided for, from his
21 decision, by a party interested in the proceeding, within such
22 time (not less than twenty days) as the Commissioner may
23 prescribe.

24 SEC. 8. That every applicant for the registration of a
25 trade-mark, or for the renewal of the registration of a trade-



1 mark, which application is refused, or either party to an in-
2 terference, or a party who has filed a notice of opposition as
3 to a trade-mark, may appeal from the decision of the exami-
4 ner in charge of trade-marks, or the examiner in charge of
5 interferences, as the case may be, to the Commissioner in
6 person, having once paid the fee for such appeal.

7 SEC. 9. That if an applicant for registration of a trade-
8 mark, or a party to an interference as to a trade-mark, or a
9 party who has filed opposition to the registration of a trade-
10 mark, is dissatisfied with the decision of the Commissioner of
11 Patents, he may appeal to the court of appeals of the Dis-
12 trict of Columbia, on complying with the conditions required
13 in case of an appeal from the decision of the Commissioner
14 by an applicant for patent, or a party to an interference as to
15 an invention, and the same rules of practice and procedure
16 shall govern in every stage of such proceedings, as far as the
17 same may be applicable.

18 SEC. 10. That every registered trade-mark, and every
19 mark for the registration of which application has been made,
20 together with the application for registration of the same, shall
21 be assignable in connection with the good will of the business
22 in which the mark is used. Such assignment must be by an
23 instrument in writing and duly acknowledged according to
24 the laws of the country or State in which the same is executed.

25 SEC. 11. That certificates of registration of trade-marks



1 shall be issued in the name of the United States of America,
2 under the seal of the Patent Office, and shall be signed by
3 the Commissioner of Patents, and a record thereof, together
4 with printed copies of the drawing and statement of the
5 applicant, shall be kept in books for that purpose. The cer-
6 tificate shall state the date on which the application for regis-
7 tration was received in the Patent Office. Certificates of
8 registration of trade-marks may be issued to the assignee of
9 the applicant, but the assignment must first be entered of
10 record in the Patent Office.

11 Written or printed copies of any records, books, papers,
12 or drawings relating to trade-marks belonging to the Patent
13 Office, and of certificates of registration, authenticated by the
1 seal of the Patent Office and certified by the Commissioner
15 thereof, shall be evidence in all cases wherein the originals
16 could be evidence; and any person making application there-
17 for and paying the fee required by law shall have certified
18 copies thereof.

19 SEC. 12. That a certificate of registration shall remain
20 in force for twenty years, except that in the case of trade-
21 marks previously registered in a foreign country such certifi-
22 cates shall cease to be in force on the day on which the
23 trade-mark ceases to be protected in such foreign country,
24 and shall in no case remain in force more than twenty years,

1 unless renewed. Certificates of registration may be, from
2 time to time, renewed for like periods on payment of the
3 renewal fees required by this Act, upon request by the regis-
4 trant, his legal representatives, or transferees of record in the
5 Patent Office, and such request may be made at any time not
6 more than six months prior to the expiration of the period for
7 which the certificates of registration were issued or renewed.
8 Certificates of registration in force at the date at which this
9 Act takes effect shall remain in force for the period for which
10 they were issued, but shall be renewable on the same condi-
11 tions and for the same periods as certificates issued under the
12 provisions of this Act, and when so renewed shall have the
13 same force and effect as certificates issued under this Act.

14 SEC. 13. That whenever any person shall deem himself
15 injured by the registration of a trade-mark in the Patent
16 Office he may at any time apply to the Commissioner of
17 Patents to cancel the registration thereof. The Commissioner
18 shall refer such application to the examiner in charge of inter-
19 ferences and give notice thereof to the registrant. If it
20 appear after a hearing before the examiner that the regis-
21 trant was not entitled to the use of the mark at the date of
22 his application for registration thereof, or that the mark is not
23 used by the registrant, or has been abandoned, and the exam-
24 iner shall so decide, and no appeal be taken from his decision,
25 the Commissioner shall cancel the registration.



1 SEC. 14. That the following shall be the rates for trade-
2 mark fees:

3 On filing each original application for registration of a
4 trade-mark, ten dollars; provided that an application for reg-
5 istration of a trade-mark pending at the date of the passage of
6 this Act, and on which certificate of registration shall not
7 have issued at such date, may, at the option of the applicant,
8 be proceeded with and registered under the provisions of this
9 Act without the payment of further fee.

10 On an appeal from the examiner in charge of trade-marks
11 to the Commissioner of Patents, fifteen dollars.

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

15 For certified and uncertified copies of certificates of reg-
16 istration and other papers, and for recording transfers and
17 other papers, the same fees as required by law for such
18 copies of patents and for recording assignments and other
19 papers relating to patents.

20 SEC. 15. That sections forty-nine hundred and twenty-
21 five and forty-nine hundred and thirty-six of the Revised Stat-
22 utes, relating to the payment of patent fees and to the repay-
23 ment of fees paid by mistake, are hereby made applicable to
24 trade-mark fees.

25 SEC. 16. That the registration of a trade-mark under

1 the provisions of this Act shall be prima facie evidence of
2 ownership. Any person who shall, without the consent of
3 the owner thereof, reproduce, counterfeit, copy, or colorably
4 imitate any such trade-mark and affix the same to merchan-
5 dise of substantially the same descriptive properties as those
6 set forth in the registration, or to labels, signs, prints, pack-
7 ages, wrappers, or receptacles intended to be used upon or in
8 connection with the sale of merchandise of substantially the
9 same descriptive properties as those set forth in such registra-
10 tion, and shall use, or shall have used, such reproduction,
11 counterfeit, copy, or colorable imitation in commerce among
12 the several States, or with a foreign nation, or with the
13 Indian tribes, shall be liable to an action for damages therefor
14 at the suit of the owner thereof; and whenever in any such
15 action a verdict is rendered for the plaintiff, the court may
16 enter judgment therein for any sum above the amount found
17 by the verdict as the actual damages, according to the circum-
18 stances of the case, not exceeding three times the amount of
19 such verdict, together with the costs.

20 SEC. 17. That the circuit and territorial courts of the
21 United States and the supreme court of the District of Co-
22 lumbia shall have original jurisdiction, and the circuit courts
23 of appeal of the United States and the court of appeals of
24 the District of Columbia shall have appellate jurisdiction of
25 all suits at law or in equity respecting trade-marks registered

1 in accordance with the provisions of this Act, arising under
2 the present Act, without regard to the amount in controversy.

3 SEC. 18. That writs of certiorari may be granted by the
4 Supreme Court of the United States for the review of cases
5 arising under this Act in the same manner as provided for
6 patent cases by the Act creating the circuit court of appeals.

7 SEC. 19. That the several courts vested with jurisdic-
8 tion of cases arising under the present Act shall have power
9 to grant injunctions, according to the course and principles of
10 equity, to prevent the violation of any right of the owner of
11 a trade-mark registered under this Act, on such terms as the
12 court may deem reasonable; and upon a decree being rendered
13 in any such case for wrongful use of a trade-mark the com-
14 plainant shall be entitled to recover, in addition to the profits
15 to be accounted for by the defendant, the damages the com-
16 plainant has sustained thereby, and the court shall assess the
17 same or cause the same to be assessed under its direction. The
18 court shall have the same power to increase such damages, in
19 its discretion, as is given by section eighteen of this Act for
20 increasing damages found by verdict in actions at law; and in
21 assessing profits the plaintiff shall be required to prove defend-
22 ant's sales only; defendant must prove all elements of costs
23 which are claimed.

24 SEC. 20. That in any case involving the right to a trade-
25 mark registered in accordance with the provisions of this Act,
26 in which the verdict has been found for the plaintiff, or an

1 injunction issued, the court may order that all labels, signs,
2 prints, packages, wrappers, or receptacles in the possession of
3 the defendant, bearing the trade-mark of the plaintiff or com-
4 plainant, or any reproduction, counterfeit, copy, or colorable
5 imitation thereof, shall be delivered up and destroyed. Any
6 injunction that may be granted upon hearing, after notice to
7 the defendant, to prevent the violation of any right of the
8 owner of a trade-mark registered in accordance with the pro-
9 visions of this Act, by any circuit court of the United States,
10 or by a judge thereof, may be served on the parties against
11 whom such injunction may be granted anywhere in the
12 United States where they may be found, and shall be opera-
13 tive, and may be enforced by proceedings to punish for con-
14 tempt, or otherwise, by the court by which such injunction
15 was granted, or by any other circuit court, or judge thereof,
16 in the United States, or by the supreme court of the District
17 of Columbia, or a judge thereof. The said courts, or judges
18 thereof, shall have jurisdiction to enforce said injunction, as
19 herein provided, as fully as if the injunction had been granted
20 by the circuit court in which it is sought to be enforced.

21 The clerk of the court or judge granting the injunction
22 shall, when required to do so by the court before which appli-
23 cation to enforce said injunction is made, transfer without
24 delay to said court a certified copy of all the papers on which
25 the said injunction was granted that are on file in his office.



1 SEC. 21. That no action or suit shall be maintained un-
2 der the provisions of this Act in any case when the trade-
3 mark is used in unlawful business, or upon any article injuri-
4 ous in itself, or which mark has been used with the design of
5 deceiving the public in the purchase of merchandise, or has
6 been abandoned, or upon any certificate of registration fraud-
7 ulently obtained.

8 SEC. 22: That whenever there are interfering registered
9 trade-marks, any person interested in any one of them may
10 have relief against the interfering registrant, and all persons
11 interested under him, by suit in equity against the said reg-
12 istrant; and the court, on notice to adverse parties and other
13 due proceedings had according to the course of equity, may
14 adjudge and declare either of the registrations void in whole
15 or in part according to the interest of the parties in the trade-
16 mark, and may order the certificate of registration to be
17 delivered up to the Commissioner of Patents for cancellation.

18 SEC. 23. That nothing in this Act shall prevent, lessen,
19 impeach, or avoid any remedy at law or in equity which any
20 party aggrieved by any wrongful use of any trade-mark
21 might have had if the provisions of this Act had not been
22 passed.

23 SEC. 24. That all applications for registration pending
24 in the office of the Commissioner of Patents at the time of
25 the passage of this Act may be amended with a view to

1 bringing them, and the certificate issued upon such applica-
2 tions, under its provisions, and the prosecution of such appli-
3 cations may be proceeded with under the provisions of this
4 Act.

5 SEC. 25. That any person who shall procure registra-
6 tion of a trade-mark, or entry thereof, in the office of the
7 Commissioner of Patents by a false or fraudulent declaration
8 or representation, oral or in writing, or by any false means,
9 shall be liable to pay any damages sustained in consequence
10 thereof to the injured party, to be recovered by an action on
11 the case.

12 SEC. 26. That the Commissioner of Patents is author-
13 ized to make rules and regulations, not inconsistent with law,
14 for the conduct of proceedings in reference to the registra-
15 tion of trade-marks provided for by this Act.

16 Sec. 27. That no article of imported merchandise which
17 shall copy or simulate the name of any domestic manufacture,
18 or manufacturer or trader, or of any manufacturer or trader
19 located in any foreign country which, by treaty, convention,
20 or law, affords similar privileges to citizens of the United
21 States, or which shall copy or simulate a trade-mark regis-
22 tered in accordance with the provisions of this Act, or shall
23 bear a name or mark calculated to induce the public to believe
24 that the article is manufactured in the United States, or that
25 it is manufactured in any foreign country or locality other



1 than the country or locality in which it is in fact manufactured,
2 shall be admitted to entry at any custom-house of the United
3 States; and, in order to aid the officers of the customs in
4 enforcing this prohibition, any domestic manufacturer or trader,
5 and any foreign manufacturer or trader, who is entitled under
6 the provisions of a treaty, convention, declaration, or agree-
7 ment between the United States and any foreign country to
8 the advantages afforded by law to citizens of the United States
9 in respect to trade-marks and commercial names, may require
10 his name and residence, and the name or mark of the locality
11 in which his goods are manufactured, and a copy of the cer-
12 tificate of registration of his trade-mark, issued in accordance
13 with the provisions of this Act, to be recorded in books which
14 shall be kept for this purpose in the Department of the Treas-
15 ury, under such regulations as the Secretary of the Treasury
16 shall prescribe, and may furnish to the Department facsimiles
17 of his name, the name or mark of the locality in which his
18 goods are manufactured, or of his registered trade-mark; and
19 thereupon the Secretary of the Treasury shall cause one or
20 more copies of the same to be transmitted to each collector or
21 other proper officer of customs.

22 SEC. 28. That it shall be the duty of the registrant to
23 give notice to the public that a trade-mark is registered,
24 either by affixing thereon the words "Registered in U. S.

1 Patent Office,” or abbreviated thus, “Reg. U. S. Pat. Off.,”
2 or when, from the character or size of the trade-mark, or
3 from its manner of attachment to the article to which it is
4 appropriated, this can not be done, then by affixing a label,
5 containing a like notice, to the package or receptacle wherein
6 the article, or articles, are inclosed; and in any suit for in-
7 fringement by a party failing so to give notice of registration
8 no damages shall be recovered, except on proof that the
9 defendant was duly notified of infringement, and continued
10 the same after such notice.

11 SEC. 29. That in construing this Act the following rules
12 must be observed, except where the contrary intent is plainly
13 apparent from the context thereof: The United States includes
14 and embraces all territory which is under the jurisdiction and
15 control of the United States. The word “States” includes
16 and embraces the District of Columbia, the Territories of the
17 United States, and such other territory as shall be under the
18 jurisdiction and control of the United States. The terms “per-
19 son” and “owner” and any other word or term used to des-
20 ignate the applicant or other entitled to a benefit or privilege
21 or rendered liable under the provisions of this Act include a
22 firm, corporation, or association as well as a natural person.
23 The term “applicant” and “registrant” embrace the successors
24 and assigns of such applicant or registrant. The term “trade-
25 mark” includes any mark which is entitled to registration



1 under the terms of this Act and whether registered or not,
2 and a trade-mark shall be deemed to be “affixed” to an article
3 when it is placed in any manner in or upon either the article
4 itself or the box, bale, barrel, bottle, case, cask, or other vessel
5 or package or upon the cover, wrapper, stopper, brand, label,
6 sign, print, or other thing in, by, or with which the goods
7 are packed or inclosed or otherwise prepared for sale or
8 distribution.

9 SEC. 30. That this Act shall be in force and take effect
10 upon its passage. All Acts and parts of Acts inconsistent
11 with this Act are hereby repealed except so far as the same
12 may apply to certificates of registration issued under the
13 Act of Congress approved March third, eighteen hundred and
14 eighty-one, entitled “An Act to authorize the registration of
15 trade-marks and protect the same,” or under the Act approved
16 August fifth, eighteen hundred and eighty-two, entitled “An
17 Act relating to the registration of trade-marks.”





58TH CONGRESS, }
3^D Session. } **H. R. 15803.**

A BILL

To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

By Mr. BONYNGE.

DECEMBER 6, 1904.—Referred to the Committee on Patents and ordered to be printed.