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IN THE SENATE OF THE UNITED STATES.

APRIL 5, 1904.

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

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**A BILL**

To provide for the registration and protection of 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 with foreign nations, or among the several  
5       States, or with Indian tribes, or with the insular or other  
6       possessions of the United States, provided such owners shall  
7       be domiciled in the United States or insular or other posses-  
8       sions or territory thereof, or located in any foreign country  
9       or tribes, which, by treaty, convention, or law, affords simi-  
10      lar privileges to the citizens of the United States, may obtain  
11      registration of such trade-mark by complying with the fol-  
12      lowing requirements:

13       First. By causing to be recorded in the Patent Office a  
14      statement specifying name, domicile, location, and citizenship  
15      of applicant; the class of merchandise and the particular de-



1 description of goods comprised in such class to which the mark  
2 is appropriated; a description of the mark with facsimile  
3 thereof, and a statement of the manner of applying the same  
4 to the goods, and the length of time during which the trade-  
5 mark has been used.

6       Second. By paying into the Treasury of the United  
7 States the sum of ten dollars and complying with such regu-  
8 lations as may be prescribed by the Commissioner of Patents.

9       SEC. 2. That the application must be accompanied by  
10 a written declaration verified by the person, or by a member  
11 of a firm, or by an officer of a corporation applying, to the  
12 effect that such party has at the time a right to the use of  
13 the trade-mark sought to be registered, and that no other per-  
14 son, firm, or corporation has the right to such use either in  
15 the identical form or in any such near resemblance thereto as  
16 might be calculated to deceive; that such trade-mark is used  
17 in commerce between the several States, or with foreign  
18 nations, or with Indian tribes, or with the insular or other  
19 possessions of the United States, and that the description and  
20 facsimile presented truly represent the trade-mark sought to  
21 be registered.

22       SEC. 3. That the filing date of any such application  
23 shall be noted and recorded, but no alleged trade-mark shall  
24 be registered unless the same appear to be lawfully used in a  
25 lawful business by the applicant in the commerce above indi-

1 cated, or is within the province of a treaty, convention, or  
2 declaration with a foreign power, nor which is identical with  
3 a registered or known trade-mark owned by another and  
4 appropriated to the same class of merchandise, or which so  
5 nearly resembles some other person's registered trade-mark  
6 as to be likely to cause confusion or mistake in the mind of  
7 the public as to deceive purchasers. In an application for  
8 registration the Commissioner of Patents shall decide the pre-  
9 sumptive lawfulness of claim to the alleged mark, and in any  
10 dispute between an applicant and a previous registrant, or  
11 between applicants, he shall follow as far as the same may be  
12 applicable the practice of courts of equity of the United States  
13 in analogous cases.

14       SEC. 4. That certificates of registration under this Act  
15 shall be issued in the name of the United States of America,  
16 under the seal of the Department of the Interior, and shall  
17 be signed by the Commissioner of Patents or the acting Com-  
18 missioner, and a record thereof, together with printed copies  
19 of the specifications or drawings or facsimile, shall be kept by  
20 the Commissioner of Patents. Copies of trade-marks and of  
21 statements and declarations filed therewith, and certificates of  
22 registration so signed and sealed shall be evidence in any suit  
23 in which such trade-mark shall be brought into controversy.

24       SEC. 5. That the certificate of registry shall remain in  
25 force for thirty years from its date, except in cases where the



1 trade-mark is claimed for and applied to articles not manu-  
2 factured in this country, and in which it receives protection  
3 under the laws of a foreign country for a shorter period, in  
4 which case it shall cease to have any force in this country by  
5 virtue of this Act at the time that such trade-mark ceases to  
6 be exclusive property elsewhere. At any time during the  
7 six months prior to the expiration of the term of thirty years  
8 such registration may be renewed from time to time on the  
9 same terms and for a like period.

10 SEC. 6. That the registration of a trade-mark shall be  
11 prima facie evidence of ownership. Any person who shall  
12 reproduce, counterfeit, copy, or colorably imitate any trade-  
13 mark registered under this Act and affix the same to mer-  
14 chandise of substantially the same descriptive properties as  
15 those described in the registration shall be liable to an action  
16 on the case for damages for the wrongful use of said trade-  
17 mark at the suit of the owner thereof; and the party  
18 aggrieved shall also have his remedy according to the course  
19 of equity to enjoin the wrongful use of such trade-mark used  
20 in commerce with foreign nations, or among the several States,  
21 or with the Indian tribes, or with the insular or other posses-  
22 sions of the United States, as aforesaid, and to recover com-  
23 pensation therefor in any court having jurisdiction over the  
24 person guilty of such wrongful act; and the courts of the



1 United States shall have original and appellant jurisdiction in  
2 such cases, without regard to the amount in controversy.

3 SEC. 7. That no action or suit shall be maintained under  
4 the provisions of this Act when the trade-mark is used in any  
5 unlawful business, or upon any article injurious in itself, or  
6 upon any article in connection with which false representa-  
7 tions are made, or which mark has been used with the design  
8 of deceiving the public in the purchase of merchandise, or  
9 under any certificate of registration fraudulently obtained.

10 SEC. 8. That any distinctive name, word, phrase, sym-  
11 bol, or device, or the name of a deceased person or character,  
12 famous in history, fiction, or literature, or the name of a living  
13 celebrity with the consent of such person, by which the  
14 origin or ownership of goods can be distinguished, shall be  
15 considered proper subject-matter for trade-mark registration  
16 under this Act: *Provided*, That no merely descriptive word  
17 or phrase, or merely the name of the applicant (unless such  
18 name be in a distinctive shape, or consist in a written signa-  
19 ture in original or facsimile of the applicant), or a merely geo-  
20 graphical name or term shall prima facie constitute a trade-  
21 mark which may be exclusively appropriated under this Act;  
22 *Provided further*, That no public arms or decorations, in-  
23 cluding the national flag, shall be registerable under the  
24 provisions of this Act.



1           SEC. 9. 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.

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

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

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

12           SEC. 10. That whenever application is made for the  
13 registration of a trade-mark which is substantially identical  
14 with a trade-mark appropriated to the same class of goods for  
15 which a certificate of registration has been previously issued  
16 to another, or for registration of which another has previously  
17 made application, or which so nearly resembles such trade-mark  
18 as, in the opinion of the Commissioner, to be likely to be mis-  
19 taken therefor by the public, and the applicant shall show to  
20 the satisfaction of the Commissioner that he used the trade-  
21 mark of his application prior to the date of filing of the applica-  
22 tion on which such previous registration was granted, or the  
23 date of filing of such prior application, as the case may be, or  
24 shall show to the satisfaction of the Commissioner that the reg-  
25 istrant or prior applicant has abandoned the use of such trade-



1 mark, the Commissioner shall suspend such latter application  
2 and give notice thereof to the registrant or prior applicant,  
3 as the case may be. If within such time, not less than thirty  
4 days from such notice, as the Commissioner shall prescribe,  
5 the registrant or prior applicant files in the Patent Office  
6 notice of opposition to the grant of such application, stating  
7 the reasons thereof, the Commissioner shall declare that an  
8 interference exists as to such trade-mark, and shall direct the  
9 examiner in charge of interferences to determine the question  
10 of ownership of such trade-mark. And the Commissioner  
11 may issue a certificate of registration to the party who is ad-  
12 judged to be the owner of the trade-mark, unless the adverse  
13 party appeals from the decision of the examiner in charge of  
14 interferences within such time, not less than twenty days, as  
15 the Commissioner shall prescribe. If the registrant or prior  
16 applicant, after due notice, shall fail to file notice of opposi-  
17 tion within thirty days, the Commissioner may issue a certifi-  
18 cate of registration to the later applicant.

19       SEC. 11. That every applicant for registration of a trade-  
20 mark not domiciled in the United States shall, before the issu-  
21 ance of the certificate of registration, designate by a notice in  
22 writing, filed in the Patent Office, some person residing  
23 within the United States on whom process or notice of pro-  
24 ceedings affecting the right of ownership the trade-mark of  
25 which such person may claim to be the owner, brought under



1 the provisions of this Act, or under other laws of the United  
2 States, may be served with the same force and effect as if  
3 served upon the applicant or registrant in person.

4 SEC. 12. That any person who shall procure registration  
5 of a trade-mark or entry thereof in the office of the Commis-  
6 sioner of Patents by a false or fraudulent declaration or rep-  
7 resentation orally or in writing, or by any fraudulent means,  
8 shall be liable to pay any damages sustained in consequence  
9 thereof to the injured party, to be recovered in an action on  
10 the case.

11 SEC. 13. That nothing in this Act shall prevent, lessen,  
12 impeach, or avoid any remedy at law or in equity which any  
13 party aggrieved by any wrongful use of any trade-mark might  
14 have had if the provisions of this Act had not been passed.

15 SEC. 14. That all applications for registration pending  
16 in the office of the Commissioner of Patents at the time of  
17 the passage of this Act, may be amended with a view of  
18 bringing them and the certificates issued upon such applica-  
19 tions under its provisions, and the prosecutions of said appli-  
20 cations may be proceeded with under the provisions of this  
21 Act.

22 SEC. 15. That all trade-marks registered under the Act  
23 approved March third, eighteen hundred and eighty-one, en-  
24 titled "An Act to authorize the registration of trade-marks  
25 and protect the same," shall be registered under the provisions



1 of this Act, for the same goods, upon the application in due  
2 form above prescribed by the original applicant or his succes-  
3 sors or assigns, upon the payment into the United States  
4 Treasury of five dollars in each and every case: *Provided,*  
5 That no adverse decision is of record in the Patent Office  
6 affecting the right of ownership of the mark for which regis-  
7 tration is sought.

8       SEC. 16. That nothing in this Act shall be construed as  
9 unfavorably affecting a claim to a trade-mark after the term  
10 of registration shall have expired, nor to give cognizance to  
11 any court of the United States in an action or suit between  
12 citizens of the same State, unless the trade-mark in contro-  
13 versy is used on goods intended to be transported to a foreign  
14 country or in lawful commercial intercourse with an Indian  
15 tribe, or in commerce among the several States, or with the  
16 insular or other possessions of the United States.

17       SEC. 17. That the Commissioner of Patents is authorized  
18 to make rules and regulations and prescribe forms for the  
19 transfer of the right to use trade-marks and for recording  
20 such transfers in his Office.

21       SEC. 18. That no article of imported merchandise which  
22 shall copy or simulate the name of any domestic manufacture or  
23 manufacturer or trader, or of any manufacturer or trader located  
24 in any foreign country which by treaty, convention, or law af-



1 fords similar privileges to citizens of the United States, or which  
2 shall copy or simulate a trade-mark registered in accordance  
3 with the provisions of this Act, or shall bear a name or mark  
4 calculated to induce the public to believe that the article is manu-  
5 factured in the United States or that it is manufactured in any  
6 foreign country or locality other than the country in which it  
7 is in fact manufactured, shall be admitted to entry at any  
8 custom-house of the United States. And in order to aid the  
9 officers of the customs in enforcing this prohibition, any  
10 domestic manufacturer or trader and any foreign manufacturer  
11 or trader who is entitled under the provisions of a treaty, con-  
12 vention, declaration, or agreement between the United States  
13 and any foreign country to the advantages accorded by law  
14 to citizens of the United States in respect to trade or com-  
15 mercial marks and commercial names, may require his name  
16 and residence and name or mark of the locality in which his  
17 goods are manufactured, and a copy of the certificate of regis-  
18 tration of his trade-mark issued in accordance with the pro-  
19 visions of this Act, to be recorded in books which shall be  
20 kept for this purpose in the Department of the Treasury, un-  
21 der such regulations as the Secretary of the Treasury shall  
22 prescribe, and may furnish to the Department facsimiles of  
23 his name, the name or mark of the locality in which his goods  
24 are manufactured, or of his registered trade-mark; and there-  
25 upon the Secretary of the Treasury shall cause one or more



1 copies of the same to be transmitted to each collector or other  
2 proper officer of the customs.

3       SEC. 19. That this Act shall take effect upon its passage.

4 All Acts and parts of Acts inconsistent herewith are hereby  
5 repealed.





58<sup>TH</sup> CONGRESS, }  
2<sup>D</sup> SESSION. } **S. 5398.**

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