

Corbln Vs. Gould

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Court : US Supreme Court

Decided On : Feb-03-1890

Appeal No. : 133 U.S. 308

Appellant : Corbin

Respondent : Gould

Judgement :

Corbin v. Gould - 133 U.S. 308 (1890)

U.S. Supreme Court Corbin v. Gould, 133 U.S. 308 (1890)

Corbin v. Gould

No. 131

Argued November 22, 1889

Decided February 3, 1890

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*APPEAL FROM THE CIRCUIT COURT OF THE UNITED
STATES FOR THE EASTERN DISTRICT OF MICHIGAN*

SYLLABUS

The trademark for tea (No. 9952) registered in the Patent Office by Ingraham, Corbin & May December 27, 1881, was for the combination of the figure of a diamond and the words "The Tycoon Tea" enclosed in it, and its registration conferred no exclusive right to the use of the word "Tycoon" considered by itself.

This is a suit in equity brought in the court below by Calvin R. Corbin and Horatio N. May, co-partners, as Corbin, May & Co., doing business in Chicago, against Walter J. Gould, Edward Telfer, David D. Cady, and L. F. Thompson, co-partners as W. J. Gould & Co., doing business in Detroit, for the alleged infringement of a trademark.

The bill, filed on the 24th of September, 1885, alleged substantially as follows: that for over six years, complainants had been engaged in manufacturing, preparing, and shipping to the United States, and selling in the United States and elsewhere, a particular quality of tea, of which their immediate predecessors in business, Ingraham, Corbin & May, were the first and exclusive manufacturers, importers, and wholesale dealers in this country; that during this period, they had imported large quantities of such tea, which, by reason of its superior quality and because of the advertising they gave it, became well and favorably known, and was sold extensively in the chief cities and towns of the United States, particularly in Michigan; that said particular tea was known as "Tycoon Tea," the word "Tycoon" being properly attached to the cases and coverings in which the tea was imported; that this name "Tycoon" was given by them to their tea in 1879, in order to more clearly identify it, and had since been used as their adopted trademark for it; that having complied with the act of Congress in such case made and provided, and with

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the regulations prescribed by the Commissioner of Patents, they procured the registration and recording of said trademark in the Patent Office on the 27th of December, 1881, and received from the Commissioner of Patents a certificate

showing such record, that since the word "Tycoon" was first applied by them as a trademark, and since the date of such registration, the defendants, confederating with divers other persons in different parts of the United States, with full knowledge of complainants' rights under and by virtue of their trademark, in violation thereof, without complainants' consent, and with the intent fraudulently to divert to themselves complainants' trade in such tea, put upon the market in Detroit and elsewhere large quantities of tea in packages or cases of the same size and general appearance as those used by complainants, with the word "Tycoon" stamped thereon, in imitation of complainants' trademark, all of which was intended to deceive and mislead the public into buying defendants' tea, which is of an inferior quality, greatly to the injury of the reputation of complainant's tea; that, by reason of such fraudulent acts and practices on the part of defendants, complainants had been deprived of great gains and profits in the sale of their tea, and had been damaged more than \$10,000, and that defendants were still using the aforesaid facings or labels, with the word "Tycoon" stamped thereon, upon tea, and threaten to continue to do so, to the great injury and damage of plaintiffs. The bill prayed for an injunction to restrain the defendants and their agents from the further use of complainants' trademark, for an accounting, and for damages.

Upon the filing of this bill, supported by a number of affidavits corroborating its allegations, the court issued a temporary restraining order as prayed for, and the defendants thereupon filed their answer, denying specifically all the material allegations of the bill. The answer further alleged that the word "Tycoon" could not have been lawfully adopted and used as a trademark, because it had been a word in common use in trade, as a brand or name for various kinds of tea imported from Japan, for many years prior to the time when complainants

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claim to have adopted it as a trademark. It further set forth that the defendants had been using the word "Tycoon" on the facings or labels of their tea in connection with the word "Chop," but it denied that these labels bore any more similarity to those of complainants than is usually the case with tea labels, and alleged that, except in the word "Tycoon," there was no resemblance whatever between them.

It therefore prayed that the bill be dismissed. Considerable testimony was taken in the case, and the court below, on the 14th of June, 1886, rendered a decree dismissing the bill, without delivering any opinion. An appeal from that decree brings the case here.

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MR. JUSTICE LAMAR delivered the opinion of the Court.

We are of opinion that the decree below must be affirmed. The material allegations of the bill are not sustained by the evidence, and the one which presents the entire foundation for the claim of relief is disproved by the exhibit which the complainants append to their bill. After alleging that complainants had adopted as their trademark the word "Tycoon," and stamped it upon packages of a particular kind of tea manufactured and imported by themselves alone into the American market in 1879, and that the said word "Tycoon," having never before been adopted as a trademark, had become known to the trade as exclusively designating a particular kind of tea dealt in by the complainants, the bill states that, for the purpose

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of obtaining protection for their exclusive right to the said word "Tycoon" as a trademark, they deposited it, as above described, in the Patent Office at Washington, and that in 1881 the same was registered and recorded by the Commissioner of Patents of the United States, and a certificate was issued therefor securing to the complainants protection for the said trademark. The exhibits A and B, appended to the bill, and other exhibits attached to Corbin's deposition, show that the trademark adopted by the complainants, deposited and registered in the Patent Office, is not the word "Tycoon," as stated in the bill, but a transverse, diamond-shaped symbol, enclosing the word "The" at the top and "Tea" at the bottom, between which, lengthwise the diamond, is the word "Tycoon." A facsimile is as follows:

image:a

The claim of the complainants, filed in the Patent Office for the registration of the trademark in question, is in these words:

"Our trademark consists of the letters and words and arbitrary symbols, 'The Tycoon Tea, I., C. & M., C., Japan Tea,' ornamental scroll border, transverse diamond shape. . . . The letters or words, 'I., C. & M., C., Japan Tea,' may be omitted, or they may be partly omitted and partly changed as to their position within the square, without materially altering the character of our trademark, *the essential features of which are* the symbol of a diamond and the arbitrarily selected word 'Tycoon.'"

It is not pretended that this combination, claimed and registered as the trademark of complainants, has ever been used by the defendants either in the identical form or in a form having such resemblance thereto as might be calculated to deceive. A comparison of the label of defendants with that of the complainants, as given in the exhibit to the bill, shows many striking points of difference, and but few, if any, points of

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similarity except that the word "Tycoon" is found in both. In the complainant's label, the diamond figure, the words, "The Tycoon Tea," "Choicest," and "spring Leaf," are printed in blue ink, and the other words are printed in black ink, all in different kinds of ornamental letters -- the whole surrounded by an ornamental black scroll border. The defendant's label is water-marked in red and pink colors, surrounded by a heavy blue border with black decorations. The words are printed in various styles of letters of different colors; the words, "Tycoon Chop," for instance, being in large, white letters with red facings, on a solid black ground, and "Japan Tea" in large black letters, some of which are plain and some ornamental. On the complainants' label, the proprietorship of the tea is indicated by the letters, "I., C. & M.," representing Ingraham, Corbin & May, the predecessors of the present firm, while on the defendants' label the name of their firm, and their place of business appear prominently near the bottom of it. These labels are so entirely dissimilar that it is difficult to perceive how they could be mistaken the one for the other. A

mere glance is sufficient to distinguish them. There are certainly no more points of similarity between them than are to be found ordinarily between tea labels or facings, and were it not for the fact that the word "Tycoon" is found in both of them, there would be no semblance of a case of infringement. With respect to the word "Tycoon," the evidence shows beyond question that it has been used as a name or brand for Japan tea for many years. Invoices of "Tycoon tea" were received at the custom house in San Francisco as early as May 15, 1873, as shown by a copy of the official records of that office filed in this case, and the evidence of dealers and merchants of California is all to the effect that the word was in common use as a brand for Japan tea for several years prior to that date. It is unnecessary to go into this evidence in detail, but it is conclusive as to the long use of the word prior to the alleged adoption of it as a part of the trademark of the complainants.

The authorities cited by complainants' counsel to show that the prior use of a word as a trademark by another party, who

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had abandoned it, is not sufficient to debar the present owner of it from protection, do not apply this case. At the time complainants claim to have adopted the word "Tycoon" as their trademark for the particular species of tea dealt in by them, it was not an abandoned trademark previously used by some other person or firm to designate a particular quality of tea, but it was and had been for many years in general and common use as a term descriptive of a class of teas introduced into the American market -- a term which all men engaged in the tea business had an equal right to use and which belonged to no one individual either as a trademark or a trade label. It belonged to the public as the common property of the trade, and therefore was not subject to appropriation by anyone person. The following language, used in *Amoskeag Manufacturing Company v. Spear*, 2 Sandford 599, quoted with approval by this Court in [Canal Company v. Clark](#), 13 Wall. 311, [80 U. S. 324](#) , is applicable to the claim of the complainant in this case:

"He has no right to appropriate a sign, or a symbol, [or a name,] which, from the nature of the fact which it is used to signify, others may employ with equal truth,

and therefore have an equal right to employ for the same purpose."

See also Goodyear Co. v. Goodyear Rubber Co., [128 U. S. 598](#) ; *Liggett & Myers Tobacco Co. v. Finzer*, [128 U. S. 182](#) ; *Stachelberg v. Ponce*, [128 U. S. 686](#) ; *Menendez v. Holt*, [128 U. S. 514](#) . Even conceding that the complainants may claim a trademark for the combination of the diamond and the words enclosed in it, as described in their application to the Patent Office, there was, upon the authorities above cited, clearly no trademark in the word "Tycoon," considered by itself.

The decree of the court below dismissing the bill should be, and it hereby is,

Affirmed.

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