

A. Leschen and Sons Rope Co. Vs. Broderick and Bascom Co.

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Court : US Supreme Court

Decided On : Mar-19-1906

Appeal No. : 201 U.S. 166

Appellant : A. Leschen and Sons Rope Co.

Respondent : Broderick and Bascom Co.

Judgement :

A. Leschen & Sons Rope Co. v. Broderick & Bascom Co. - 201 U.S. 166 (1906)
U.S. Supreme Court A. Leschen & Sons Rope Co. v. Broderick & Bascom Co.,
201 U.S. 166 (1906)

A. Leschen & Sons Rope Company v.

Broderick & Bascom Rope Company

No. 187

Argued March 1, 1906

Decided March 19, 1906

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APPEAL FROM THE CIRCUIT COURT OF

SYLLABUS

A trademark for wire rope of a red or other distinctively colored streak applied to or woven in the rope is too wide and too indefinite.

Where color is made the essential feature of a trademark, it must be so

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defined or connected with some symbol or design that other manufacturers may know what they can safely do.

A trademark not limited to a particular color must stand or fall in its entirety, and if the description is too broad, it cannot be sustained by proof that only a particular color is used.

Quaere whether mere color not impressed in a particular design can constitute a valid trademark.

In an equity action between citizens of the same state for infringement of trademark, the jurisdiction of the federal court depends solely on whether plaintiff's registered trademark is valid, and if it is not valid, jurisdiction cannot be assumed of the case as one where defendant has used plaintiff's device for the purpose of fraudulently palming off his goods as those of the plaintiff.

This was a bill in equity brought in the Circuit Court for the Eastern District of Missouri by the appellant, a Missouri corporation, against the appellee, another Missouri corporation, for the infringement of a trademark for wire rope, registered under the act of Congress of March 3, 1881, 21 Stat. 502.

The bill alleged that the plaintiff, the A. Leschen & Sons Rope Company, in 1888 had

"adopted for its use as a trademark for its highest and best grade of wire rope, a strand of a different color from the other strands of the rope, the said trademark then and now being effected by your orator by painting one of the strands of the rope so as to make it distinctly unlike the other strands of the rope;"

that it had continuously used the trademark to the present day; that it had been extensively advertised; that its sale had been very great, and that the company had obtained, December 4, 1900, a registration of such trademark in the office of the Commissioner of Patents.

The bill further averred that, early in the year 1900, the defendant company "commenced to paint one of the strands of its wire rope so as to make it of a distinctly different color from the other strands of the rope;" that, on October 31, 1900, it applied to the Commissioner of Patents for a registration; that the Commissioner declared an interference with the plaintiff, upon which proofs were taken, the case fully

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argued, and plaintiff was declared to be the first to adopt the trademark; that notwithstanding this, defendant continued its unlawful use of this trademark with the intent to defraud plaintiff, to deceive the public, and to take unfair advantage of the demand for plaintiff's wire ropes, and that said mark is being used by said defendant to make sales of rope upon the strength of plaintiff's reputation. The bill further alleged the use of the trademark by both parties in commerce between the United States and foreign countries.

Defendant demurred on the ground that the trademark set up in the bill was not a lawful and valid trademark. The demurrer was sustained, the bill dismissed (123 F. 149), and the decree of the circuit court affirmed by the circuit court of appeals. 134 F. 571.

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MR. JUSTICE BROWN delivered the opinion of the Court.

As both parties are citizens of the State of Missouri, the jurisdiction of the circuit court can only be sustained upon the theory that the case is one arising under the Constitution and laws of the United States.

By an Act of Congress of July 8, 1870, 16 Stat.198-210, 77, to revise the statutes relating to patents and copyrights, Rev.Stat. 4937, permission was given citizens of the United States and some others, "who are entitled to the exclusive use of any lawful trademark, or who intend to adopt and use any trademark for exclusive use within the United States," to obtain registration of such trademark in the Patent Office, and by Act of August 14, 1876, 19 Stat. 141, a punishment was provided for a fraudulent use of such trademarks by others. But in the *Trademark Cases*, [100 U. S. 82](#) , this legislation was declared to be unconstitutional upon the ground that it was intended to embrace all commerce, including that between citizens of the same state, and it was held that, if the power of Congress extended to the registration of trademarks at all, it must be limited to their use in commerce with foreign nations and between the several states and with the Indian tribes.

Apparently in consequence of this decision, Congress, by Act of March 3, 1881, 21 Stat. 502, passed a new act, declaring that the

"owners of trademarks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall

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be domiciled in the United States, or located in any foreign country, or tribes, which by treaty, convention, or law affords similar privileges to citizens of the United States, may obtain registration of such trademarks . . . by causing to be recorded in the Patent Office a statement specifying name, domicil, location, and citizenship of the party applying; . . . a description of the trademark itself with facsimiles thereof, and a statement of the mode in which the same is applied and affixed to goods,"

etc.

The registration of the trademark in question contains the following description:

"The trademark consists of a red or other distinctively colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color any body of the rope."

"The essential feature of the trademark is the streak of distinctive color produced in or applied to a wire rope."

"This mark is usually applied by painting one strand of the wire rope a distinctive color, usually red."

image:a

It is true that the drawing annexed to the registration, a copy of which is here given, as well as the exhibits furnished,

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show one of the strands colored red, and if the trademark were restricted to a strand thus colored, perhaps it might be sustained; but the description of a colored streak, which would be answered by a streak of any color painted spirally with the strand, longitudinally across the strands, or by a circular streak around the rope, was held by both courts, and we think properly, too indefinite to be the subject of a valid trademark. Certainly a trademark could not be claimed of a rope the entire

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surface of which was colored, and if color be made the essential feature, it should be so defined, or connected with some symbol or design, that other manufacturers may know what they may safely do. Upon the plaintiff's theory, a wire rope containing a streak of any description or of any color would be an infringement, and a manufacturer honestly desiring to distinguish his wire rope from that of the plaintiff's by difference in color might, by adopting a white streak running along the length of the rope across the strands, find himself an infringer, when his real object may have been to obtain a mark which would distinguish his manufacture from

that of the plaintiff's. Even if it were conceded that a person might claim a wire rope colored red or white, or any other color, it would clearly be too broad to embrace all colors. So, although it might be possible to claim the imprint of a colored figure on a wire rope, the figure should be so described that other manufacturers would know how to avoid it. If the trademark be a colored streak, it should be at least described, and a statement of the mode in which the same is applied and affixed to the rope, and a trademark which may be infringed by a streak of any color, however applied, is manifestly too broad.

It would not aid plaintiff's case even if it were shown that it made use of a colored strand, and that defendant made use of a strand similarly colored, since the trademark must stand or fall in its entirety, and if the description therein be too broad, it cannot be sustained by showing that defendant imitated its color and its method of applying it. Perhaps, however, the defendant might be liable under a bill framed upon the theory that it was endeavoring to dispose of its goods as those of the plaintiff.

Whether mere color can constitute a valid trademark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this. In the case of *Handon's Trademark*, 37 Ch.Div. 112, in which a trademark was claimed for a red, white, and blue label, in imitation

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of the French tri-color, for French coffee, it was held not entitled to registration under the English statute, which requires a trademark to be distinctive in order to be valid. The court remarked as follows:

"It is the plain intention of the act that, where the distinction of the mark depends upon color, that will not do. You may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because practically, under the terms of the act, that would give you a monopoly of

all the colors of the rainbow."

It is unnecessary to express an opinion whether, if the trademark had been restricted to a strand of rope distinctively colored, it would have been valid. As already observed, the claim is much broader than this. Nor can we assume jurisdiction of this case as one wherein the defendant had made use of plaintiff's device for the purpose of defrauding the plaintiff and palming off its goods upon the public as of the plaintiff's manufacture. Our jurisdiction depends solely upon the question whether plaintiff has a registered trademark, valid under the act of Congress, and, for the reasons above given, we think it has not.

Affirmed.

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