201 U.S. 166 (1906)

A. LESCHEN & SONS ROPE COMPANY
v.
BRODERICK & BASCOM ROPE COMPANY.

No. 187.

Supreme Court of United States.

Argued March 1, 1906.
Decided March 19, 1906.
APPEAL FROM THE CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

Mr. Melville Church, with whom *Mr. Hervey S. Knight, Mr. J.C. Jones* and *Mr. George H. Knight* were on the brief, for appellant.

There was no appearance for appellee.

MR. JUSTICE BROWN, after making the foregoing statement, 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 trade-mark, or intend to adopt and use any trade-mark for exclusive use within the United States," to obtain registration of such trade-mark in the Patent Office; and by act of August 14, 1876, 19 Stat. 141, a punishment was provided for a fraudulent use of such trade-marks by others. But in the *Trade-mark 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 trade-marks 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 the act of March 3, 1881, 21 Stat. 502, passed a new act, declaring that the "owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall 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 trade-marks . . . by causing to be recorded at the Patent Office a statement specifying name, domicil, location, and citizenship of the party applying; . . . a description of the trade-mark itself with fac similes thereof, and a statement of the mode in which the same is applied and affixed to goods," etc.

The registration of the trade-mark in question contains the following description:

"The trade-mark 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 and body of the rope.

"The essential feature of the trade-mark 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."

It is true that the drawing annexed to the registration, a copy of which is here given, as well as the exhibits furnished, shows one of the strands colored red; and if the trade-mark 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 trade-mark. Certainly a trade-mark could not be claimed of a rope, the entire 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 figures should be so described that other manufacturers would know how to avoid it. If the trade-mark 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 trade-mark 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 trade-mark 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 trade-mark 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 Trade-mark,* 37 Chan. Div. 112, in which a trade-mark was claimed for a red, white and blue label, in imitation of the French tri-color, for French coffee, it was held not entitled to registration under the

English statute, which requires a trade-mark 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 a 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 trade-mark 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 trade-mark valid under the act of Congress, and, for the reasons above given, we think it has not.

Affirmed.