212 U.S. 285 (1909)

E.C. ATKINS & COMPANY
v.
MOORE, COMMISSIONER OF PATENTS.

No. 86.

Supreme Court of United States.

Argued January 22, 1909.
Decided February 23, 1909.

APPEAL FROM AND IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

Mr. Chester Bradford, with whom *Mr. Arthur M. Hood* and *Mr. E.W. Bradford* were on the brief, for appellant and plaintiff in error.

Mr. Assistant Attorney General Fowler for appellee and defendant in error.

MR. CHIEF JUSTICE FULLER, after making the foregoing statement, delivered the opinion of the court.

In *Frasch* v. *Moore,* 211 U.S. 1, it was held that decisions in the Court of Appeals of the District of Columbia in appeals from the Commissioner of Patents under § 9 of the act of February 9, 1893, c. 74, 27 Stat. 434, were interlocutory and not final, and not reviewable by this court under § 8 of that act, because not final judgments or decrees within the meaning of that section. When certified to the Commissioner of Patents, they "govern the further proceedings in the case," (Revised Statutes, § 4914), but are not final judgments or decrees at law or in equity within the purview of § 8.

In *Gaines & Company* v. *Knecht & Son, post,* p. 561, we applied the same rule to a writ of error to the decision of the Court of Appeals, rendered on appeal to that court from a decision of the Commissioner of Patents in proceedings arising under an application for a trade-mark, contenting ourselves with this memorandum, announced December 14, 1908:

"Writ of error dismissed for want of jurisdiction. *Frasch* v. *Moore,* 211 U.S. 1; see Act of February 20, 1905, for the registration of trade-marks, 33 Stat. 724, c. 592, sections 9, 16, 17, 18 *et passim.*"

Section 9, there referred to, provides:

"That if an applicant for registration of a trade-mark . . . is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for a patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings as far as the same may be applicable."

Gaines v. *Knecht* was a case of opposition to the registration of a trade-mark under §§ 6 and 7 of the act of February 20, 1905, the objections being that the act was unconstitutional, and also that the applicant's mark was so similar to the mark of opponent that it would be likely to lead to confusion, and enable applicant to perpetrate a fraud on the public. The examiner of interferences dismissed the opposition, and from his decision the case was appealed to the Commissioner, who affirmed the decision. An appeal was then taken to the Court of Appeals, and that court affirmed the Commissioner, and "ordered that this decision and the proceedings in this court be certified to the Commissioner of Patents, as required by law." The court said, among other things, that the appeal was "an appeal from the decision of an officer of the executive department performing a ministerial act. He has treated the statute as valid, and so he ought to have treated it until it is otherwise determined by the courts. . . . It may be true that the Commissioner acts in a judicial capacity in determining whether the applicant is the owner of the trade-mark, and whether it is one of those marks the registration of which is prohibited, but when he has determined these in favor of the applicant the act to be performed by him is ministerial merely, and that is the act which it is claimed he should have refused to perform, on the ground that the statute is unconstitutional. Such judicial proceedings as there are issue and culminate in a purely ministerial act — the mere registration of a mark which, if the statute is void, cannot possibly prejudice the right of the opponent or of any one else. It is not as if the culminating act interfered with the person or property of others. We sit to review the action of the officer from the same standpoint which he was bound to take. Although the case is now before a court, the case itself is not changed, nor are the rules changed by which it should be decided. It is for this court to say merely whether his decision was right or wrong. We think he did not err in treating the act as valid. When some case shall arise in which rights of person or property must be affected by the decision it will become necessary to consider the question now attempted to be raised; but to pass upon it now would be to decide a question of theory alone, and this is not the province of a court." 27 App. D.C. 530, 532.

In the light of the various details of the act of February 20, 1905, and of the specific provisions of § 9, we were of opinion that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case.

Under § 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes "any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question," and by § 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the act of February 20, 1905.

Appeal and writ of error dismissed.