

U.S. Supreme Court

McLean v. Fleming, 96 U.S. 245 (1877)

McLean v. Fleming

96 U.S. 245

Syllabus

1. Where a manufacturer has habitually stamped his goods with a particular mark or brand, a court of equity will restrain another party from adopting it for the same kind of goods.
2. Positive proof of fraudulent intent on the part of the infringer is not required where the infringement is clearly shown.
3. Although no precise rule applicable to all cases can be laid down as to the degree of resemblance necessary to constitute an infringement of a trademark, an injunction will be granted where the imitation is so close that by the form, marks, contents, words, or their special arrangement, or by the general appearance of the infringing device, purchasers exercising ordinary caution are likely to be misled into buying the article bearing it for the genuine one.
4. It is not necessary, to entitle a party to an injunction, that a specific trademark has been infringed. It is sufficient to satisfy the court that the respondent intended to represent to the public that his goods were those of the complainant.
5. In this case, the Court holds that the appellant has infringed the trademark of the appellee, but that the latter, by his long continued acquiescence therein, and his unreasonable delay in seeking relief, has been guilty of inexcusable laches, and is not entitled to an account for profits. The decree below is therefore affirmed, so far as it awards an injunction, but reversed as to damages, and costs in this court are allowed to the appellant.

The bill in this case was filed June 1, 1872, by Cochrane Fleming, to restrain the alleged infringement of his trademark for liver pills, by James H. McLean.

As early as 1834, Dr. Charles McLane, of Morgantown, Va., made and sold liver pills, putting them up in wooden boxes,

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labeled "Dr. McLane's Liver Pills." In June, 1844, Jonathan Kidd, having purchased the exclusive right from him, began, at Pittsburg, Penn., to make and sell them. In 1845, Kidd formed a partnership with John Fleming under the name of Jonathan Kidd & Co.

Kidd died in 1853, and Fleming, the surviving partner, and one Cochrane Fleming, having purchased from Kidd's executors all his interest in the business, entered into partnership, under the name of Fleming Brothers. That firm continued until 1865, when Cochrane retired. John carried on the business in the firm name until his death, in November, 1870, whereupon Cochrane succeeded under his will to all his rights in the business.

Up to August, 1847, the pills in question were wrapped in an ordinary printed label. In that year, Kidd & Co. commenced putting them up in wooden boxes, on the cover of each of which were stamped in red wax the words "McLane's Liver Pill," and on the wrapper, in a narrow border of scalloped pattern surrounding a panel, with a background of wave-line engraving, was printed in red ink a label bearing the words "Dr. C. McLane's Celebrated Liver Pills." In 1855, Fleming Bros. changed the color of the label to black, and made certain other changes, as follows: the groundwork of the engraved wrapper on the top of the box being composed of fine lines, crossing the box diagonally, and at right angles with each other, and bearing the words, in white, "Dr. C. McLane's Celebrated Liver Pills," "Celebrated Liver Pills" being upon a scroll similar to a double ogee in form with a black background. On the wrapper were also in white letters the words, "Prepared only by Fleming Bros., successors to Jon. Kidd & Co.," and a facsimile of their signature and that of C. McLane, in black. This label, which is referred to in the opinion of the court as "Exhibit F," was used until October 1871, when another change was made, and the label mentioned in the decree below, and in the opinion of the court as "Exhibit H," was adopted. In it, the groundwork has shaded curved lines cutting and crossing each other in such a way as to produce the effect of alternate light and shade, crossing the top of the box diagonally in place of the straight lines in "Exhibit F." In this label, the words "successors to Jon. Kidd & Co." are omitted.

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In 1849, James H. McLean commenced, at St. Louis, Mo., to manufacture his proprietary medicines, and, in 1851, to manufacture and sell liver pills, under the name of "Dr. McLean's Universal Pills," using first a type-printed label in red letters, which he, in 1852, changed to a lithographed red label, called in the decree "Exhibit L."

This label is printed in ink of a light red color, with the words, "Dr. McLean's Universal Pills," in white letters shaded by red lines running parallel with the length of the label. He used this label until 1866, having in 1863 inserted therein the initials (J. H.) of his name. In 1866, he changed his label to that referred to in the decree as "Exhibit K." In this label, the lines of the background, which is black, cross the top of the box diagonally and at right angles to each other, with the words "Dr. J. H. McLean's Universal Pills or Vegetable Liver Pills" thereon, in white letters. The use of this label he continued until May, 1872, when he adopted a new one, in the use of which no infringement of the complainant's label was found. He also used a stamp in red wax on his goods.

The court below decreed that the respondent, his agents, employees, and servants, be perpetually enjoined and restrained from using, or causing to be used, the words, "D'r J.

H. McLean's Universal Pills or Vegetable Liver Pills," or "D'r McLean's Universal Pills," or "D'r J. H. McLean's Universal Pills," upon any label or wrapper for boxes or other packages of pills, resembling or in imitation of the labels or wrappers or trademark of the complainant, described as Exhibit H, whether in style of engraving, printing, or lettering; and from vending or exposing for sale, or causing to be vended or exposed for sale, any article of pills having upon the boxes or other packages thereof any such labels or wrappers so made in imitation of or resemblance to the said labels or wrappers of the complainant, but did not enjoin or restrain him from using them on any other labels or wrappers for pills than those described. It also referred the cause to a master, to take and state an account of the damages resulting to the complainant since Nov. 9, 1870, from the violation of his rights.

The master reported the complainant's damages at \$7,399.35. The respondent excepted. His exception having been overruled,

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the report confirmed, and a final decree entered, he appealed to this Court.