

Case No. 8,154.

LEA ET AL. V. DEAKIN.

{11 Biss. 23;<sup>1</sup> 18 Am. Law Reg. (U. S.) 322; 7 Reporter, 261; 11 Chi. Leg. News, 152.}

Circuit Court, N. D. Illinois.

Jan., 1879.

TRADE MARKS—"WORDCESTERSHIRE SAUCE" A GENERIC TERM—RES JUDICATA—FORMER DECREE IN ENGLAND.

1. The term "Worcestershire Sauce" has become generic as applied to a certain kind of table sauce, and cannot be exclusively appropriated by the complainants simply because they reside in Worcestershire, England.
2. A decree rendered by the master of the rolls in England, refusing an injunction and dismissing a bill in equity to restrain the infringement of an alleged trade mark, and which was not appealed from, is a complete bar to a suit brought in this country for the same purpose by the same complainants against the agent of the defendant in the English suit.

{Cited in *Faust v. Baumgartner*, 113 Ind. 141, 15 N. E. 337.}

{This was a bill in equity by Charles W. Lea and others against Frank Deakin for the infringement of an alleged trade-mark.}

Rogers & Appleton and Henry M. Collyer, for complainants.

Charles E. Pope and George C. Christian, for defendant.

DRUMMOND, Circuit Judge. This case has been ably and fully argued by the counsel of the respective parties, and as it has been pending for a long time, although I have not had, from other engagements, the opportunity of considering it so thoroughly as I could wish, I may state now the conclusions at which I have arrived, without going into any special detail of the reasons leading to such conclusions. The plaintiffs are, and have been for a long time, the manufacturers of what has been called "Worcestershire Sauce," in Worcestershire, England. It is at present, and has been for some time, known as "Lea & Perrins' Worcestershire Sauce." The defendant is a resident of Wisconsin, and has been in the habit of receiving from England a sauce somewhat similar to that of the plaintiffs which is called the "Improved Worcestershire Sauce," prepared by Richard Millar & Co., of London. The defendant is their agent for the sale of this latter sauce in this part of the country. I think the proof establishes that there has long been known in the market a certain kind of sauce used for the table, on fish and meats of various kinds, as "Worcestershire Sauce;" that it is a sort of generic term given to this kind of sauce from the fact that it was originally manufactured in Worcestershire, England. It seems to have been manufactured also in other places, and the term "Worcestershire Sauce" seems to have been applied to that species of sauce: "Under the circumstances, therefore, it can hardly be claimed that the plaintiffs, simply because they reside in Worcestershire, and manufacture a sauce which they call "Worcestershire Sauce," have the sole right to the application of the term to that species of sauce. I think that the proof also shows that the

plaintiffs have been cognizant for many years of the fact that there was this kind of sauce manufactured to which the term was applied; that for many years they took no steps to prevent the parties from manufacturing the sauce; and that, therefore, there may be said to have been something in the nature of an acquiescence in the manufacture of the sauce.

The proof also shows that the plaintiffs filed a bill in chancery in England against the principal of the defendant, Millar, of London, on the ground that he or his company were manufacturing the very species of sauce which is the subject of controversy in this case, asking for an injunction to restrain him from such manufacture, and from using the term "Worcestershire Sauce," they claiming that they had the right to it as a trade-mark, and that no one else could use it without their consent, and also asking for an accounting from the defendant. The case was heard by the master of the rolls, Sir George Jessel, and fully considered by him in 1876, and the injunction was refused and the bill dismissed. See *Sebast. Trade-Marks*, 305; *Seton*, Dec. (4th Ed.) 242. There was no appeal from this decree; on the contrary, it seems to have been acquiesced in by the plaintiffs. I see nothing in the record to raise a doubt that the case was decided on its merits. I think, therefore, that case is a bar to the action of the plaintiffs. They brought the suit against Millar, the principal of the defendant in this case, on the very subject-matter of controversy here; they asked for an injunction for the same reasons that the injunction is asked here, and for substantially the same general relief. It was refused by the master of the rolls, and the bill dismissed. Deakin, the defendant here, has acted for Millar, the defendant in that case. It would be an anomaly if it were true that Millar could manufacture and sell his sauce in England, and at the same time Deakin, who sells it here, and obtains it from him, could be restrained here at the instance of the plaintiffs from selling it.

By agreement between the parties, and the order of the court, many of the questions on the admissibility of evidence were submitted to the master, and he made his report thereon to the court, and exceptions have been taken to his report. It is unnecessary for me to consider these various exceptions. It is sufficient to say, I think, there is evidence in the case which ought to be admitted, and from which these conclusions can be deduced. The result will be, therefore, that the bill will be dismissed.

NOTE. A name which has become generic in meaning cannot be appropriated as a trademark. *Canal Co. v. Clark*, 13 Wall. [80 U. S.] 311, 323; *Thomson v. Winchester*, 19 Pick. 214; *Wolfe v. Goulard*, 18 How. Pr. 64; *Sherwood*

v. Andrews [unreported]; Candee v. Deere, 54 Ill. 439; Singer Manuf'g Co. v. Wilson, 2 Ch. Div. 434; Cocks v. Chandler, L. R. 11 Eq. 446; Ford v. Foster, 7 Ch. App. 611; Burke v. Cassin, 45 Cal. 467; Burnett v. Phalon, 9 Bosw. 192; Bininger v. Wattles, 28 How. Pr. 206; Singleton v. Bolton, 3 Doug. 293; Canham v. Jones, 2 Ves. & B. 218. But see Newman v. Alvord, 49 Barb. 588; Congress & E. Spring Co. v. High Rock C. Spring Co., 45 N. Y. 291; Dunbar v. Glenn, 42 Wis. 118; Wotherspoon v. Currie. L. R. 5 H. L. 508. There can be no trademark in the name "Singer Sewing Machine." Singer Manuf'g Co. v. Larsen [Case No. 12,902]. The word "Parabola" used as the name of needles, not being descriptive of any peculiar quality of the needles, is a valid trademark. Roberts v. Sheldon [Id. 11,916]. So the term "Yankee," applied as the name or label upon soap, is a valid trademark. Williams v. Adams [Id. 17,711].

{For other cases involving this litigation, see Cases Nos. 3,695, 3,696, and 3 Fed. 435, and 13 Fed. 514.}

<sup>1</sup> [Reported by Josiah H. Bissell, Esq., and here reprinted by permission.]