Case No. 12,902.

SINGER MANUF'G CO. v. LARSEN.

{3 Ban. & A. 246;[1] 8 Biss. 151; 13 Chi. Leg. News, 59.}

Circuit Court, N. D. Illinois. Feb., 1878.

TRADE NAME—DESIGNATING MECHANISM—INTENT TO DECEIVE.

1. If a sewing-machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine.

{Cited in Singer Manuf'g Co. v. June Manuf'g Co., 41 Fed. 212.}

2. There can be no trade-mark for the name "Singer Sewing-Machine."

{Cited in Brill v. Singer Manuf'g Co., 41 Ohio St. 131.}

3. Although a person not connected with the Singer Manufacturing Company would have the right, after the patents have expired, to make a. Singer sewing-machine and call it by that name, still, he would not be permitted to do any act, the necessary effect of which would be to intimate, or make any one believe, that the machine which he constructs and sells is manufactured by that company.

{Cited in Waterman v. Shipman, 130 N. Y. 311, 29 N. E. 111.}

{This was a bill in equity by the Singer Manufacturing Company against Nels Larsen.}

William H. King, for complainant.

W. B. Scates, for defendant.

DRUMMOND, Circuit Judge. Under the evidence in this case, I think there can be no doubt that the plaintiff cannot claim the exclusive right to manufacture the "Singer Sewing-Machine." All that it can claim is to make a machine of its own peculiar manufacture, with a device in the nature of a trade-mark. Otherwise, after a patent has expired which has

established the nomenclature of a sewing-machine, as the Howe patent, or the Wilson patent, the patentee might go on and have the benefit of the patent indefinitely.

On a machine called the "Singer Sewing-Machine;" there were various patents. These patents have all expired, and nothing can, therefore, be claimed under them. Other persons cannot be prevented from manufacturing a machine like the Singer sewing-machine, and which may be called, to distinguish it from other machines, "Singer's Sewing-Machine." If a sewing-machine has acquired a name which designates a mechanism or a peculiar construction, parts of which are protected by patents, other persons, after the expiration of the patents, have the right to construct the machine and call it by that name, because that only expresses the kind and quality of the machine. I have read the reports of the case of the Singer Manuf'g Co. v. Wilson {Case No. 12,901}, originally decided by the master of the rolls in England, and afterward on appeal, in the chancery division of the high court of justice, and again, on appeal from the latter court to the house of lords, and I do not think it is necessary to controvert the general rule there laid down—that there must be something to indicate that the thing manufactured is not the same as that of the complainant, in other words, to show it is not manufactured by the plaintiff. That is, it is a question of manufacture, not of name. A person could not claim a right to construct a peculiar form of barrel as to dimensions and capacity merely, irrespective of any marks or brands impressed upon it. That of itself could not be a lawful trade-mark. The same rule would be applicable to the construction of a wagon or carriage, which, owing to some peculiarity, might possess a particular name, as that of the manufacturer. A man might construct a wagon or carriage precisely like it, and he would not be liable if he did not claim in some

form that it was constructed by the manufacturer. The only principle upon which an action can be sustained under such circumstances, as I understand, is through a trade-mark. If there were a valid trade-mark called a "Singer Machine," then there would be some force in the plaintiff's claim. Here the plaintiff and the defendant have a trade-mark somewhat similar, and if there is on the machine manufactured by the plaintiff a valid trade-mark to indicate that it is of the plaintiff's manufacture, no one else ought to be permitted to put anything on his machine to show that it has been manufactured by the plaintiff; that is, to use the same trade-mark. It may be the defendant has made his machine to imitate the plaintiff's, and to induce people to believe that it is the same. But, as I have said, I do not think, under the circumstances of this case, there can be a trade-mark for the name "Singer Sewing-Machine."

An illustration is furnished in the opinion of the lord chancellor in the house of lords, in the case already referred to. A carriage called a "brougham" had been in very general use for many years. If that were devised by a man of the same name, so that, from its peculiarity of construction, it was generally known by that name, it certainly cannot be claimed that the man who devised it, or his assignees, would have a sole right to construct a "brougham" for all time to come. If no patent existed upon it or any of its parts, any one who has the requisite skill could construct just such a "brougham" as was originally constructed. There could in such a case be no trade-mark which the law would protect in the name "brougham;" and I therefore do not think that the opinion of the house of lords can be construed to mean what is claimed by the counsel of the plaintiff in this case. So that, while I hold that the defendant is not 220 prevented from constructing a "Singer Sewing-Machine," still, he cannot be permitted to do any act, the necessary effect

of which will be to intimate, or to make any one believe, that the machine which he constructs and sells is manufactured by the plaintiff. Neither has he the right to use any device which may be properly considered a trade-mark, so as to induce the public to believe that his machine has been manufactured by the plaintiff, and, therefore. I shall modify the injunction in this case by simply requiring the defendant to refrain from selling any Singer sewing-machines manufactured by any person or company other than the plaintiff, without indicating in some distinct manner that the said machines were not manufactured by the Singer Manufacturing Company.

[1] {Reported by Hubert A. Banning, Esq., and Henry Arden, Esq., and here reprinted by permission.}