

## Legal Notes.

**AN IMPORTANT QUESTION OF PATENT OFFICE PRACTICE.**—In the case *United States ex rel. Steinmetz v. Allen*, Commissioner of Patents, published in 109 O. G. 549, the Supreme Court has rendered a decision of far-reaching effect on Patent Office practice. That part of the decision with which we have at present to deal is in substance, first, that an art or process and an apparatus for carrying it into effect may be of such interdependent nature as to be joined together in a single valid patent, and that rule 41 of the Patent Office Rules of Practice being repugnant to this principle is invalid; and second, that a repeated requirement by a primary examiner in the Patent Office, for the division of an application for patent into two or more separate applications, is a final action and is appealable to the Board of Examiners in Chief.

The question of the joinder of inventions and the division of applications has recently become a serious one for inventors and patent attorneys. It is well settled that two or more inventions may be made the subject of a single patent, provided they are dependent or correlated. Until a few years ago, the Patent Office followed this principle, a little more strictly than the courts, but nevertheless to such an extent as to allow a single patent to embrace two or more inventions if they were actually dependent upon each other. The practice in this respect, however, has been gradually contracted, until in its present form a great burden of expense and delay is placed upon the inventor by numerous requirements for division, and it may be seriously questioned whether the law gives authority for the actions of the Patent Office in many cases. Rule 41, referred to in the decision mentioned, requires among other things that processes and their machines be invariably presented in separate applications. Divisions in other subjects of invention are required with equal strictness. In a case recently under our observation, a patent was asked on an agricultural apparatus, and it was required by the Patent Office to divide the case into seven distinct applications. This condition of affairs in many cases makes the cost of protecting an invention prohibitive. Many inventors are poor, and have enough to bear without an extra expense in the Patent Office.

By the recent decision of the Supreme Court some relief may be afforded. From the fact that appeal may be taken to the Board of Examiners in Chief on questions of division, it follows that this question can be brought before the Court of Appeals of the District of Columbia; and if the Patent Office authorities continue to construe the rule of joinder of inventions so strictly, it is possible that their practice may be modified by the Court of Appeals. In the interest of the inventor and of the correctness of Patent Office practice, it would seem to be the duty of attorneys to push the question to a settled, and if possible more liberal, practice on the subject. It has been urged on behalf of the present system, that the exigencies of the classification of inventions demand this extreme division. With this view of the matter we cannot wholly agree. The classification is most important, but its integrity can be preserved by a proper system of cross references to the several classes, and consequently without resorting to a practice the authority for which is questionable, and which beyond doubt places too heavy an expense upon the inventor. If it be that Congress does not provide for a force sufficient to permit of properly classifying the subjects of invention without resorting to extreme requirements of division, then it is the plain duty of all friends of our great patent system to urge upon Congress the necessity of some action in the matter.

**AN UNFAIR COMPETITION CASE DECIDED BY THE SUPREME COURT.**—The French Republic as owner, and La Compagnie Fermière de l'Établissement Thermo de Vichy as lessee of the springs of Vichy, France, brought an action against the Saratoga Vichy Spring Company for the unlawful use of the word "Vichy," claimed by the plaintiffs as a commercial name or trade mark and appropriated for waters of defendant, which are drawn from a certain natural spring at Saratoga, N. Y. The defendants set up that for fifty years mineral waters had been sold throughout the world under the name "Vichy," and that such name has come to denote a certain type of water and does not stand for the water of any one spring; that Saratoga "Vichy" has never been sold as the Vichy of plaintiffs, but has been so labeled that all might know that it came from the springs of Saratoga. The bill was dismissed by the Circuit Court on the ground that the plaintiffs had no exclusive right to the word "Vichy," and that defendant had never been guilty of an attempt to palm off its waters as the imported article. On appeal the Court of Appeals reversed the decision of the Circuit Court and granted an injunction against the use of one particular label or "any other label in which the place of the origin of the water is

not as plainly and prominently made known as the fact that it is named "Vichy." A writ of certiorari was applied for and granted. The Supreme Court affirmed the decree of the Court of Appeals in an interesting opinion, of which the following is a digest:

"The title of the French Republic to the springs of Vichy, a commune of France, is clearly established. Known for their medicinal qualities since the time of the Roman Empire, and originally belonging to the feudal lord of Vichy, they were sold by him in 1444, together with the castle and its dependencies, to Pierre, Duke of Bourbon, in whose family they remained until 1531, when, for the treason of the Constable of Bourbon, they were confiscated by Francis I, and became the property of the crown, in whose possession they remained until 1790, when they were united to the public domain, and afterward passed to the French Republic and its successors, and were operated directly by the officers of the state until June, 1853, when they were leased for a fixed rental to a firm of which the Vichy company is the successor. The bottling and exportation of the waters was commenced before 1716, and in 1853 they began to be exported directly to this country, the shipments in 1893 amounting to about 300,000 bottles. For many years they have been bottled and sold all over the world.

"The rights of the defendant originated from a spring discovered in 1872 in the township of Saratoga Springs, New York, the waters of which, though differing from the waters of the Vichy spring both in ingredients and taste, have a certain resemblance to them which suggested the use of the word 'Vichy.' The water began to be bottled and sold in 1873 by the owners of the spring, and in 1876 became the property of the defendant which has since sold the water, using various bottles, circulars, and labels, containing more or less conspicuously displayed the word 'Vichy.'"

"As the waters of Vichy had been known for centuries under that name, the court thought there is reason for saying the plaintiffs had, in 1872, acquired an exclusive right to the use of the word 'Vichy' as against every one whose waters were not drawn from the springs of Vichy, or at least, as observed by a French court, 'from the same hydrographical region which may be called generally the basin of Vichy.'"

"True the name is geographical; but geographical names often acquire a secondary signification indicative not only of the place of manufacture or production, but of the name of the manufacturer or producer and the excellence of the thing manufactured or produced, which enables the owner to assert an exclusive right to such name as against every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced, or of palming off the productions of one person as those of another.

"In a French case arising in this connection, and brought by the Vichy company against a rival company owning two springs in the same neighborhood, complaining that, by the composition of its name and the arrangement of its labels, as well as by the tenor of its different appeals to the public, the company owning these springs had created a damaging confusion between the two companies and their product, it was held that, while the rival company had a right to the use of the word 'Vichy,' it was bound to state the name of its springs, the place where they were located, as 'near Vichy,' in letters identical in height and thickness as those of the word Vichy in their advertisements and labels, and also the name of their springs in letters at least half their size; in other words, it was bound to adopt such precautions as would fully apprise the public that it was not purporting to sell the waters of the original Vichy company, though, being in the same basin, they were entitled to use that designation."

"A serious difficulty in the way of enforcing an exclusive right on the part of the plaintiffs to the use of the word Vichy was their apparent acquiescence in such use by others. For thirty years the defendant, the Saratoga Vichy Company, has been openly and notoriously bottling and selling its waters under the name of the "Saratoga Vichy" until its competition has become an extremely serious matter to the plaintiffs, whose importations began in 1853 with only 316 bottles, which by the year 1893 had increased to 298,500 bottles. The entire shipment of the Vichy company amounted in 1896 to nearly ten millions of bottles. Under such circumstances, and in view of the further facts that other waters were openly manufactured and sold in this country under the name of Vichy, and that a manufactured water was dealt out by the glass under that name in innumerable soda-water fountains throughout the country, it was impossible to suppose that the plaintiffs were not aware of these infringements upon their exclusive rights. "It argues much more than ordinary indifference and inattention to suppose that the large amount of this rival water could be advertised and sold all over the country without the knowledge of their agents, who would naturally be active in the protection of their own interests, if not the interests of their principals. In fact, they had allowed the name to become generic

and indicative of the character of the water. With all these facts before them, and with the yearly increasing sales and competition of the defendant company, no move was made against them for twenty-five years, and until 1898, when this bill was filed. A clearer case of laches could hardly exist."

"The plaintiffs, then, were put in this dilemma: If the Republic was a necessary party, as it sued in its private and proprietary capacity, the defense of laches was available against it. Upon the other hand, if it was an unnecessary party, the defense of laches might certainly be set up against the Vichy company, its co-plaintiff."

The court did not think the position of the plaintiffs in this connection affected or strengthened by the eighth article of the treaty of June 11, 1887, with France and other nations, known as the Industrial Property Treaty (Comp. of Treaties, 684), which declares that "the commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not of a trade or commercial mark." [25 Stat. at L. at p. 1376.] That article was evidently designed merely to protect the citizens of other countries in their right to a trademark or commercial name, and their right to sue in the courts of this country, as if they were citizens of the United States. It could never have been intended to put them on a more favorable footing than our own citizens, or to exempt them from the ordinary defenses that might be made by the party prosecuted.

Conceding that the defense of laches would not be available in a case of actual fraud, or an attempt to foist upon the public the waters of the defendant as those of the original Vichy spring, the court found but little evidence of such purpose. The two waters not only differ in their ingredients and taste, but the French Vichy is a still, and the Saratoga Vichy, as well as the other American Vichies, an effervescing water. There was no attempt made whatever by the defendant to simulate the label of the plaintiffs upon the body of the bottle. "The word Vichy is never used by the defendant alone, but always in connection with Saratoga. The two labels not only differ wholly in their design and contents, but even in their language—that of the plaintiffs being wholly in French. Plaintiffs' label contains the word Vichy prominently displayed, with a picture of the thermal establishment where it is bottled and the name of the particular spring."

It was said by the Supreme Court in *Delaware & H. Canal Co. v. Clark*, 13 Wall. 322, 20 L. ed. 533, "In all cases where rights to the exclusive use of a trademark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another; and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief." Applying this doctrine to the case under consideration the court was clearly of opinion "that there is no such similarity in the labels as at present used, and that there is no such fraud shown in the conduct of the defendant, as would authorize us to say that plaintiffs are entitled to relief."

**AN AMERICAN INVENTION BEFORE AN ENGLISH COURT.**—There recently came up for adjudication in the Chancery Division of the High Court of Justice, the case of *Fuller vs. Handy*, which involved the validity of a patent granted to Ida May Fuller for "means or apparatus for effecting the simulation of flames of fire for spectacular purposes." The defendant, Emilie Diana Handy, alleged want of novelty in the plaintiff's invention by reason of publication of prior specifications; secondly, prior user; and thirdly, want of subject matter in view of the state of the art.

Put shortly, plaintiff's apparatus is of this nature. Under the stage is a platform, upon which are mounted fans having their axes converging toward one another; above that is an opening in the stage; below, are means for lighting through the hole in the stage. On the top is a box-shaped construction with a wirework lid. To the wirework are fastened separate strips of transparent material in the form of flames. When the apparatus is in operation, the light is directed upwardly to the opening, and a draft is created by means of a fan below. The strips of material ascend, and give the appearance of flickering flames.

The defendant's appliance did not suffer essentially from plaintiff's invention. It seems that certain phases of the plaintiff's invention had long been known to stage managers. As to prior specifications the court did not find the whole combination of plaintiff's elements in any of them; but they did show, in the court's opinion, a great deal of common knowledge with reference to the art, and most of the elements comprising the plaintiff's invention. The use of fans is old; the use of strips illuminated by beams of light was old; the wirework or gridiron to which the strips were attached was old. To use the terms of American patent lawyers, the plaintiff had simply invented a new combination of old elements without producing any new result. The action failed and was dismissed.